

**IN THE HIGH COURT AT CALCUTTA
INTELLECTUAL PROPERTY RIGHTS DIVISION
ORIGINAL SIDE**

BEFORE:

The Hon'ble Justice Ravi Krishan Kapur

IA NO. GA-COM/1/2025

IP-COM/18/2025

**EXIDE INDUSTRIES LIMITED
Vs
AMARA RAJA ENERGY AND MOBILITY LIMITED**

For the petitioner	:	Mr. S.N. Mookherjee, Senior Advocate Mr. Ranjan Bachawat, Senior Advocate Mr. Ratnanko Banerji, Senior Advocate Mr. Sayantan Bose, Senior Advocate Mr. Rudraman Bhattacharyya, Senior Advocate Mr. Debnath Ghosh, Senior Advocate Mr. Sayan Roychowdhury, Advocate Mr. Dhruv Chadha, Advocate Mr. Sagnik Bose, Advocate Mr. Paritosh Sinha, Advocate Mr. K. K. Pandey, Advocate Ms. Suhrita Majumdar, Advocate Mr. Kironjit B. Majumder, Advocate Ms. Pooja Sett, Advocate Mr. Dipro Dawn, Advocate Ms. Sayani De, Advocate Ms. Mallika Bothra, Advocate
For the respondent	:	Mr. Jayanta Kumar Mitra, Senior Advocate Mr. Sudipto Sarkar, Senior Advocate Mr. Tilak Bose, Senior Advocate Mr. Subhasis Sengupta, Advocate Mr. Adarsh Ramanujun, Advocate Mr. Rohit Banerjee, Advocate Mr. Subhojit Sengupta, Advocate Mr. Ankit Virmani, Advocate Mr. Sarosij Dasgupta, Advocate Mr. Satyaki Mukherjee, Advocate Mr. Amrita Panja Moulick, Advocate Mr. Ruchika Agarwala, Advocate

Mr. Suryaneel Das, Advocate
Mr. Akash Munshi, Advocate
Mr. Aditya Mondal, Advocate
Ms. Siddhartha Banerjee, Advocate
Mr. D. Kar, Advocate
Mr. Anish Gupta, Advocate
Mr. Chiranjit Pal, Advocate

Reserved on : 14.07.2025

Judgment on : 24.07.2025

Ravi Krishan Kapur, J.:

1. This is a suit for infringement and passing off.
2. The petitioner was originally incorporated as Associated Battery Makers (Eastern) Coal Ltd. (presently Exide Industries Limited) and has been traditionally engaged in the manufacture and marketing of lead acid batteries for use in vehicles. The petitioner is a pioneer in such business and has been selling batteries both in India and abroad under the trademark “EXIDE” since the year 1920.
3. With the passage of time, the petitioner has become one of the largest Power Storage Solutions Company in South-East Asia. The petitioner has manufacturing locations all over India alongwith numerous dealers and distributors. The petitioner has also diversified from its traditional domain of automotive lead acid batteries and ventured into manufacturing of power storage solutions such as industrial batteries, inverter batteries, generator batteries, integrated power backup systems and other such allied products.

4. The petitioner's house mark and the trademark "EXIDE" has also become its flagship brand and forms part of its corporate name. The petitioner has always used a distinctive colour theme which is in predominantly Red and has become linked with its trade dress. The petitioner also uses a distinctive Red and White colour for its products and incidentally uses other colours. The use of the colour Red and the combination of the Red and White by the petitioner is palpable from its products, packaging, advertisements, shop hoardings, social media post pages, annual reports, sponsorship etc. all in a predominantly Red colour. The use of the colour Red on the petitioner's battery trade dress, get up and labels is also evident from several registrations of the various marks which the petitioner has obtained. As a consequence, the colour Red has become intrinsically linked to the business of the petitioner and the petitioner claims proprietary rights due to the long use of the same for more than a century.
5. In addition, the petitioner also enjoys registrations for the trademark "EL" and a "shattered O device" . The trademark EL was adopted by the petitioner as far back as 1987 and the same has been put to use in a wide range of products of the petitioner including storage batteries. Such mark has been openly, extensively and continuously used by the petitioner and was fancifully adopted by the petitioner to distinguish its goods from others.

6. The petitioner has also obtained registrations of various label trademarks comprising the words “EL”. A list of such registrations being enjoyed by the petitioner are set out below:

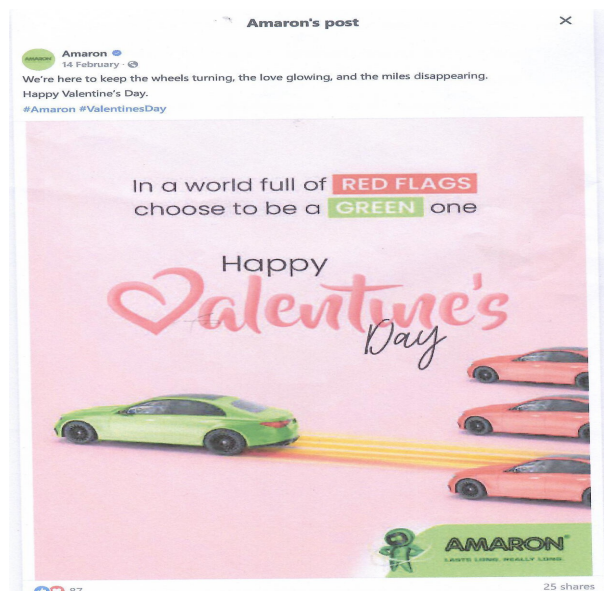
Trademark	Date of Application	Registration no.	Class	Status
EL (word)	21/1/2021	4828708	9	Registered
EXIDE EL TUBULAR	29/10/2003	1246910	9	Registered
	05/05/2004	1282374	9	Registered
	01/04/2010	1944665	9	Registered
EL + PREMIUM TUBULAR	01/04/2010	1944666	9	Registered

7. In respect of a shattered O device , the same was adopted by the petitioner in the year 1973 and has also been in open, continuous and extensive use by the petitioner. The said shattered O device was conceptualized and created by the petitioner and is a unique artistic work which is inherently capable of distinguishing the goods and services of the petitioner from those of others. The petitioner has also obtained copyright registrations of such artistic work which is *per se* exclusive and liable to protection. In this background, the petitioner claims goodwill, reputation and brand value in respect of all of the above and submits that each of them acts as a source identifier of the petitioner and its products. In support of the above contentions, the petitioner relies on

Jones vs Hallworth Reports of Patent, Design and Trademark, Vol XIV, No.8, Cadbury- Schweppes Pty. Ltd. vs The Pub Squash Co Ltd (1981) 26RPC 429, Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73, Colgate Palmolive Company & Another vs Anchor Health and Beauty Care Pvt Ltd 2003 SCC Online Del 1005, Satyam Infoway Ltd. vs Sifynet Solution(P) Ltd (2004) 6 SCC 145, Euro Solo Energy Systems Limited Vs Eveready Industries Limited, 2009 SCC Onlined Cal 1991, Sapat International Private Limited vs Sanwal Chand Babulal and Another, 2016 SCC Online Bom 7712, Societe des Produits Nestle SA vs Cadbury UK Ltd (2017)EWCA Civ 358, Sanjay Soya Private Limited vs Narayani Trading Company, 2021 SCCOnline Bom 407, Qualitex Co vs Jacobson Prods Co, 514 U.S. 159, and Emami Limited vs Hindustan Unilever Limited, 2024 SCCOnline Cal 3579.

8. The respondent is a trade rival and primary competitor of the petitioner also enjoying a significant market share in the storage battery, lead acid battery and automated battery industry both internationally and in the domestic market. The respondent sells its products under the mark “AMARON”. The respondent has since inception, always sold its products in a predominantly green colour. Such predominant green colour has become associated with the respondent and its products. In the three decades of doing business, the respondent has essentially associated itself with the colour green and this would be evident from the colour of their batteries, annual reports, publicity materials, colour of shops, advertisement campaigns etc. In addition, the respondent has in its

advertising campaigns always portrayed itself as a seller of green batteries and has at different points of time targeted the colour Red through advertising. In fact, the respondent has not only denigrated the colour Red but has through innuendo in their advertisements also deprecated the colour Red. In this context, some of the relevant advertisements of the respondent are set out hereinbelow:



9. It is contended that the petitioner has failed to satisfy the test of reputation, deceptive similarity and damage or likelihood thereof which

are the pre-conditions for establishing passing off. There is no distinctiveness in the colour Red or the word “EL” or the so-called shattered O device symbol in connection with automated batteries. As a proposition of law, there can be no monopoly over a single colour. In any event, a colour is incapable of any protection unless it has attained a secondary meaning. In such circumstances, there is no case in respect of the colour Red having attained a secondary meaning or becoming a source identifier of the petitioner. In fact, the colour red is commonly used in the battery industry and a number of rival products i.e. LIVGUARD, XENON, TARZO, MICRO ENERGY, VIGO and VOLTAFUEL all use the colour Red. In addition, the petitioner also uses colours other than Red in selling their products. In any event, no decision to purchase a battery is based purely on colour.

10. In this background, keeping the nature of the goods, nature of customers, degree of care likely to be taken by a customer purchasing automotive batteries, there is no case of confusion or deception which has been made out or exists in favour of orders being passed as prayed for by the petitioner. In view of the above, this application is liable to be dismissed. In support of such contentions, the respondent relies on the following decisions: *Kellogg Company vs. Pravin Kumar*, ILR (1996) II Delhi 11, *Dr. Martens Australia Pty Ltd. vs. Figgins Holdings Pty Ltd.* (1999) FCA 461, *Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd.* (2001) 5 SCC 73, *Colgate Palmolive Company Limited & Anr. Vs. Patel & Anr.* (2005) SCC OnLine Del 1439, *Wal-Mart Stores vs. Samara Bros, Cipla Ltd.*

vs MK Pharmaceuticals (2007) SCC OnLine Del 2012, Star Bazaar Pvt. Ltd. vs. Trent Ltd. (2010) SCC OnLine Del 4764, Specsavers International Healthcare Ltd. & Ors. vs. Asda Stores Ltd. (2012) EWCA Civ 24, Britannia Industries Ltd. vs. ITC Ltd. (2017) SCC OnLine Del 7391, Godfrey Phillips India Ltd. vs. P.T.I Pvt Ltd. (2017) SCC OnLine 12509, Khadi and Village Industries Commission vs. Girdhar Industries and Another (2023) SCC OnLine Del 8446 and Brihan Karan Sugar Syndicate Pvt. Ltd. vs. Yashwantrao Mohite Krushna Sahakari Sakhar Karkhana (2024) 2 SCC 577.

11. For convenience, a comparison of the rival products is produced below:

Example of Plaintiff's Product (Battery-front face)	Impugned Product (Battery-front face)
	
Example of Plaintiff's Product (outer box-front face)	Impugned Product (outer box-front face)
	

12. Historically, all trade mark laws have focused on two issues i.e. one is the social practice and understandings relating to the activity of applying marks to goods, the other is a positivist approach of trade mark law. In earlier times, traders applied marks to their goods to indicate ownership. This was referred to as “propriety” or “possessory” rights acknowledging that signs operated as an indication of source. In such circumstances, the Courts held that, if another trader was allowed to use the same sign this would encourage *fraud* to be committed on the public. The underlying logic being that if a trader was already using a sign or mark, the same if allowed to be used by another trader would tantamount to a form of deceit.
13. Ever since the early 19th century, the Chancery Courts have used the action of passing off to protect a trader who had developed reputation or goodwill to use a particular sign or symbol. The object of the law of passing off being to protect some form of *property*. This included innocent misrepresentation. Thus, passing off is primarily a question of fact. Each of the ingredients of the claim requires the necessary facts alongwith the evidence to be established. To this extent, the applicability of previous decisions also requires caution. Since the facts are always distinguishable, reference to other cases may not always of any real assistance except analogically. Moreover, with the passage of time, the age of a cited decision should be borne in mind. As the attributes of the public change so too might the outcome of a particular decision. [*Kerly’s*

Law on Trade Marks and Trade Names 16th Edition Chapter 20]. There is an additional caveat when relying on English decisions inasmuch as one has to keep in mind the Indian customer who may vary from the urban, literate to the illiterate and rustic. [*Cadila Health Care Ltd. (Supra)* @para 33 *Euro Solo Energy Systems Limited (Supra)*].

14. Passing off has always required a trader to establish *misrepresentation*.

In order to succeed in a suit for passing off, the classic trinity test remains that of *reputation, misrepresentation and damage* (*Consorzio del Prosciutto di Parma vs. Marks & Spencer PLC [1991] RPC 351 at 368-369*). Notwithstanding, an expansion in the scope of the tort, the heart of the tort remains anchored in *misrepresentation*. Misrepresentation of the source of goods is equivalent to lying or deception and is simply wrong. This is meant to protect confusion as to the source. In *Reckitt & Colman Products Ltd. vs. Borden [1990] 1 W.L.R 491*, Lord Oliver held that "The law of passing off can be summarised in one short general proposition - no man may pass off his goods as those of another." He went on to say:

"More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying get-up (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the 'get-up' is recognized by the public as distinctive specifically of the plaintiff's goods and none other. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him

are the goods or services of the claimant... Thirdly, he must demonstrate that he suffers or, in a qua timet action, that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as those offered by the plaintiff."

15. In India, passing off has been statutorily recognized in section 27 of the Trade Marks Act 1999 which is as follows:

27. No action for infringement of unregistered trade mark.—

(1) No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark. (2) Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services as the goods of another person or as services provided by another person, or the remedies in respect thereof.

16. In *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceuticals Laboratories*, AIR 1965 SC 980; while distinguishing between infringement of trade mark and passing off, the Supreme Court held as follows:

"While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods" (Vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two causes. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is

likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff".

17. In *Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.*, AIR 2004 SC 3540, it was held as follows:

13. The next question is, would the principles of trade mark law and in particular those relating to passing off apply? An action for passing off, as the phrase "passing off" itself suggests, is to restrain the defendant from passing off its goods or services to the public as that of the plaintiff's. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. The defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive the public into thinking that the defendant's goods or services are the plaintiff's. The action is normally available to the owner of a distinctive trade mark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first? It is not essential for the plaintiff to prove long user to establish reputation in a passing-off action. It would depend upon the volume of sales and extent of advertisement.

14. The second element that must be established by a plaintiff in a passing-off action is misrepresentation by the defendant to the public. The word misrepresentation does not mean that the plaintiff has to prove any mala fide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent

misrepresentation would be relevant only on the question of the ultimate relief which would be granted to the plaintiff [Cadbury Schweppes v. Pub Squash, 1981 RPC 429 : (1981) 1 All ER 213 : (1981) 1 WLR 193 (PC); Erven Warnink v. Townend, 1980 RPC 31 : (1979) 2 All ER 927 : 1979 AC 731 (HL)] . What has to be established is the likelihood of confusion in the minds of the public (the word “public” being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the “imperfect recollection of a person of ordinary memory” [Aristoc v. Rysta, 1945 AC 68 : (1945) 1 All ER 34 (HL)] .

32. Another facet of passing off is the likelihood of confusion with possible injury to the public and consequential loss to the appellant. The similarity in the name may lead an unwary user of the internet of average intelligence and imperfect recollection to assume a business connection between the two. Such user may, while trying to access the information or services provided by the appellant, put in that extra ‘f’ and be disappointed with the result. Documents have been filed by the respondent directed at establishing that the appellant's name Sify was similar to other domain names such as Scifinet, Scifi.com, etc. The exercise has been undertaken by the respondent presumably to show that the word “Sify” is not an original word and that several marks which were phonetically similar to the appellant's trade name are already registered. We are not prepared to deny the appellant's claim merely on the aforesaid basis. For one, none of the alleged previous registrants are before us. For another, the word “sci-fi” is an abbreviation of “science fiction” and is phonetically dissimilar to the word Sify. (See Collins Dictionary of the English Language.)

Other decisions which have reiterated the above principles are *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*, (Supra); *Laxmikant V. Patel v. Chetanbhai Shah*, 2002 (24) PTC 1 (SC); *Ramdev Food Products (P) Ltd. v. Arvinbhai Rambhai Patel*, (2006) 8 SCC 726; and *Brihan Karan Sugar Syndicate (P) Ltd. v. Yashwantrao Mohite Krushna Sahakari Sakhar Karkhana*, (Supra).

18. The crux of the disputes between the parties pertains to the launch of a product “ELITO” by the respondent, in predominantly Red trade dress and also bearing a red and white combination, alongwith a shattered “O” device. It is alleged that the impugned product of the respondent comprises of deceptive similarities in the trade dress and the get up which are exclusively associated with the petitioner. Admittedly, both products are in the same category of goods i.e. automated batteries. Both parties rely on impressive sale figures and advertisement expenses. Both parties also have a tremendous market share in India as well as abroad. Initially, the product “ELITO” was launched with a *blue* trade dress around two years ago. Thereafter, the respondent began to sell “Elito” in a Red trade dress comprising of the mark “Elito”. . In this context, the trade mark application filed by the respondent indicates that the respondent had initially adopted the mark “LIT” with the two device elements including the Greek Alphabet Xi i.e.  which was represented as  in relation to its foreign business and the same was for a blue coloured battery. Significantly, all such applications had been filed before the Trade Marks Registry in the colour grey. It is contended, there has been a significant change in the impugned trade dress without any credible explanation as originally conceptualized by the respondent. The present trade dress is not only in predominantly Red colour as that being used by the petitioner but also comprises of other deceptive similarities

i.e. the words EL and the shattered O device which are strikingly similar to that of the petitioner.

19. Reputation is the level of awareness of a mark or get up on the concerned public. A person may acquire goodwill through particular packaging or get up for their products. The length of time during which the petitioner or its predecessors have been using the mark, get up or any other *indicia* is a relevant factor which must be taken into account. Time has its own role to play in such matters and this fact cannot be discounted. Goodwill is difficult to define. It is composed of a variety of elements. It is the value of attraction to customers which the name or reputation possesses. It has been defined as the “*attractive force which brings in custom*”[*IRC vs. Muller & Co’s Margarine (1901) AC 217 at 223*]. To this extent, both goodwill and reputation are inter-linked. There is no goodwill in a sign or indicium or a prominent feature unless it is known to the public and they distinguish the goods in relation to which it is used.
20. The significance of trade dress and colour combination cannot be undermined in such cases. Get up matters in the commercial world. Marks or *indicia* in general which over a period a time have acquired reputation and goodwill tend to act as a silent salesperson and are entitled to protection. It is not always the colour *per se* but the overall get up alongwith other *indicia* which gives rise to the proprietary right of exclusivity. The substance of the tests in a passing off action appears to be the Court’s perception of the degree of resemblance between the marks. The eye continues to remain the primary test (*Sanjay Soya*

Private Limited vs. Narayani Trading Company, 2021 SCC OnLine Bom 407 @ paras 62, 63 and Three-N-Products Private Limited vs. Emami Limited 2008 SCC OnLine Cal 589).

21. This is by no stretch of imagination meant to create a monopoly over the colour Red in favour of the petitioner, an argument which the petitioner assiduously steered away from advancing (*Cipla Ltd vs M.K. Pharmaceuticals, 2007 SCC Online Del 2012 @ Paras 7 to 9*). Ordinarily, colour marks *per se* present formidable hurdles in acquiring a secondary meaning because the law frowns upon monopolies (*Wal-Mart Stores Inc vs Samara Bros 120 S. Ct. 1339*). This is because both in theory and practice monopolies are detrimental and interfere with market competition. Nevertheless, the long prior, open, continuous and uninterrupted use of the colour Red for a substantial period of time has *prima facie* created more than a connection or an association of sorts with the petitioner and its products insofar as the automotive battery industry is concerned, without creating a monopoly and this cannot be ignored. To this extent, the decision in *Britannia Industries Ltd. vs. ITC Ltd. 2017 (Supra)* cited by the respondent is distinguishable inasmuch as the concerned product had only been launched in July, 2016 i.e. five months prior to the filing of the suit. Thus, the short period of use of five months alongwith other considerations were found to be insufficient to create any link or goodwill *vis-a-vis* use of the colour blue. Similarly, in *M.L. Brothers LLP vs. Uma Impact Pvt. Ltd. & Anr. (Supra)*, the colour scheme of the plaintiff was not found to be distinctive since the plaintiff

had not used any trade dress continuously nor was the plaintiff able to establish the date of first use of the product. On the contrary, *prima facie*, the colour Red appears to be a prominent, integral and distinctive feature of the petitioner and the public and members of the trade mark perceive Red to be the petitioner's colour and green to be the respondent and at least that is how they have been marketed and also treated by the respondent. In principle, it is always possible to acquire goodwill in the shape, colour product and its packaging such that use of a similar shape or colour or packaging leads to a misrepresentation of trade origin [*Glaxo Wellcome UK Ltd. and Anr. vs. Sandoz Ltd. and Ors. (2019) EWHC 2545*]. *Prima facie*, the manner and mode of use of the distinctive Red colour for a considerable period of time in the particular industry, registration rights of the trade mark EL and the statutorily recognized copyright protection in the shattered O device mark, all contribute in acting as source identifiers and creating goodwill *vis-a-vis* the petitioner and their products.

22. In response to a query from Court, as to why the colour Red, the respondent had retorted that there is no obligation for them to explain why Red. The reply smacked off arrogance not because of any inarticulate premise but because the *law* demanded an answer. "*It is a question which falls to be asked and answered*". [*Sodastream Ltd. vs. Thorn Cascade Co. Ltd. [1982] RPC 459 at 466 per Kerr LJ*]. "*The doubtful explanation given by the respondent for the choice of the word 'Sify' coupled with the reputation of the appellant can rationally lead us to the*

conclusion that the respondent was seeking to cash in on the appellant's reputation". [Satyam Infoway Ltd. vs Sifynet Solution (P) Ltd (2004) 6 SCC 145 @ Para 35]. "There is no explanation as to why they suddenly adopted the blue colour and the adoption appears to be dishonest with an intention."....."Use of the colour blue as the background in the wrapper is the last straw on the camel". [ITC Ltd. vs. Britannia Industries Ltd. 2023 SCC OnLine Mad 6972 (DB) @ Paras 13 and 33]. "There is no conceivable reason for the defendants to have adopted such a label and trade dress, one so visually and structurally, similar to the plaintiffs" [Sapat International Private Limited vs. Sanwal Chand Babulal & Anr. 2016 SCC OnLine Bom 7712]. "Finally, intent of a defendant in adopting his trade dress is a critical factor since if the trade dress were adopted with the intent of deriving benefit from the reputation of the plaintiff that fact alone may be sufficient to justify the inference, confusing similarity"[First Brands Corp. vs. Fred Meyer, Inc., 809 F.2d 1378].

23. Fortunately or unfortunately the affidavit filed by the respondent proffered or at least attempted to explain as to why the change of colour. For convenience, the relevant paragraphs of the Affidavit in Opposition filed by the respondent are reproduced hereinbelow:

18. I state that the defendant launched the brand ELITO first in international markets only as it did not want to disrupt the market of their already established brands AMARON ad POWERZONE in India. However, when the COVID-19 restrictions were getting lifted, there was a rise in demand for automotive batteries and the Defendant decided to tap this opportunity and launch its brand ELITO in India as well.

19. I state that the defendant had received some feedback from its Master Distributor regarding the performance of the blue coloured ELITO products in the international market which inter alia, included that: (a) the E in ELITO without the vertical line is difficult for the customers to understand and they are unable to pronounce the brand name, (b) **the blue colour of batteries was not making it stand out in the clutter** and it was suggested that the brand colour be changed to any other **bright and vibrant colour**. In this regard, a copy of an Affidavit dated 24.03.2025 executed by Mr. Jindal, Chief Marketing Officer of the defendant company is annexed herewith as Annexure "N". (Emphasis added)

24. In this connection, the relevant portion of the above affidavit of the Marketing Officer is set out below:

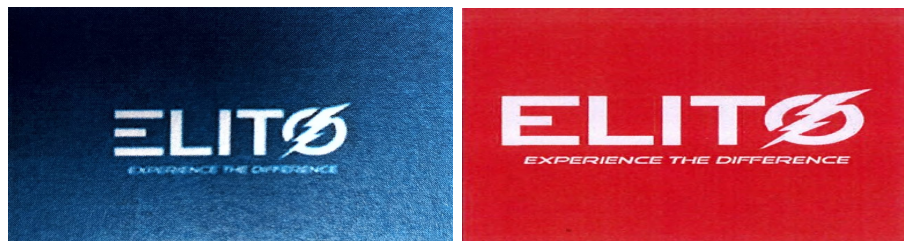
"3. I state that after the launch of brand-ELITO in the year 2020 in the international market, except India, there were various meetings held on the product performance of the brand-ELITO between the Distributor and the Company at the Corporate Office of the Company at Hyderabad, India between December 2021 and September 2022. In these meetings, the Distributor was represented by its Authorised Representative Mr. Ganesh Swaminathan and the Company was represented by me.

4. During the above said meetings, various discussions on product performance were held between the Distributor and the Company in which the Distributor shared the feedbacks received from various dealers and customers in the international market. The feedbacks included:

- (i) The word "E" in Elito without the vertical line is difficult for the customers to understand and they are unable to pronounce the brand name.
- (ii) The blue colour of the batteries was not making it stand out in the clutter and it was suggested to me that the brand colour be changed to any other bright and vibrant colour.
- (iii) The Covid-19 pandemic had impacted the sale of automotive batteries in the international market and the estimated targets for the brand ELITO were not being met.
- (iv) The brand ELITO had to be launched in more countries for global expansion
- (v) The product quality and after sales performance in the international market was also discussed."

25. In brief, the respondent at the interim stage, (keeping in mind that this is a commercial suit), relied on a self-serving affidavit of its own Marketing

Officer to contend that though it had launched “ELITO” in blue colour in 2020, later insofar as feedback received from an overseas dealer, ASEANAFRIC that, *“blue did not stand out in the clutter”* a more *“bright”* and *“vibrant”* colour was desirable. Despite there being no affidavit nor letter of ASEANAFRIC in support of the above suggestion, there is also an inherent contradiction and irreconcilability in the case of the respondent inasmuch as on the one hand it is alleges that colour has no role to play in such matters and on the other hand the respondent has been compelled to bring about a change only on the basis that *“blue did not stand out in the clutter”* and a more *bright* and *vibrant* colour was necessary. Resultantly, the change brought about by the respondent was as follows:



26. Out of all the bright and vibrant colours in the canvas of life, the respondent chooses Red in effecting such change. The very same Red being used by the petitioner for more than a century. Not a shade deeper. Nor a shade lighter. One can be excused for lack of imagination or originality, but can a deliberate, conscious and calculated decision by a trade rival to use such a prominent and distinctive feature of a competitor alongwith other *indicia* to imitate and thereby live so dangerously close to the product of the petitioner be countenanced. [*United Biscuits vs. Asda (1997) RPC 513*]. In causing such changes, the respondent has obviously tried to sail closer to the get up petitioner and there is no justifiable explanation forthcoming by the respondent. There is also no justification as to why the respondent contemporaneously continued with blue batteries insofar as the overseas market is concerned and only adopted Red in India. In determining whether misrepresentation is deceptive or not, a Court can always take into consideration, the intention of the respondent. The decision to change is not merely coincidental but a deliberate attempt with the obvious intent to create confusion and deceive or the likelihood thereof. In this context, the decision in *Forney Indus vs. Daco of Mo., Inc.*, 835 F.3d 1238, cited by the respondent is distinguishable inasmuch as it was held that Forney's packaging has changed significantly over the 20 years. Thus, it was not possible for a consumer to have any kind of association with the particular packaging since there was no consistent shape, pattern and design which could be ascertained from a description of the product.

Prima facie, there is bad faith implicit in the conduct of the respondent. The affidavit filed by the respondent is irreconcilable, self-contradictory and filing of the same was akin to committing *hara-kiri*. The desperate attempt to resile from the above affidavit, by describing the same as “irrelevant” in the Note of Submissions filed by the respondent, was too little, too late. That ship had sailed.

27. Copying is in someways described as the lifeline of competition and is not unlawful. Copying the get up or colour scheme of a label has been used as a method adopted by persons to represent their goods as the goods of another. It is true that there is no tort of copying in law. Nevertheless, within the available remedies, “anything worth copying should also be worth protecting”. At the end, it is a question of degree, extent and intent. (*IP and Other Things – Bloomsbury “Part-V” Robin Jacob*). The fact that an existing competitor in comparison to a new entrant in the market has deliberately, intentionally and in a calculated manner attempted to reap from the cultivated soil of a trade rival is impermissible. In such circumstances, a Court should be astute to say that the respondent cannot succeed in doing “what he is straining every nerve to do” [*Slazenger & Sons vs. Telltham & Co. (1899) 6 RPC 531 at 538 per Lindley, J.*] Such changes are neither accidental nor spontaneous. On the contrary, any decision to change is well deliberated and has to muster approval at different levels of any corporation spanning from marketing, design, sales, advertising and ultimately legal approval before the same is

finally implemented. The change to a red and white trade dress. The similar size and shape of the two batteries. The five letter combination of the two batteries. The use of the words “EL” which are registered in the name of the petitioner. The use of the shattered O device are all multiple instances of copying which *prima facie* indicates sufficient nearness notwithstanding any difference to suggest bad faith and a deliberate and calculated strategy to move closer to the product of the petitioner. In contrast, the fact that there may be other smaller companies having an insignificant market share also manufacturing and selling Red batteries in the industry is irrelevant. In *Kellogg Company vs. Pravin Kumar Bhadabhai & Anr. (Supra)*, relied on by the respondent, the particular trade dress was not similar and there were strikingly distinguishing features which were found between the two products. Similarly, in *Star Bazaar Pvt. Ltd. vs. Trent Ltd. and Anr., (2010) SCC OnLine Del 4764*, also cited by the respondent, both the parties were found to be bonafide, coincidental and concurrent users. On the other hand in *Colgate Palmolive Company Limited & Anr. Vs. Patel & Anr. (2005) SCC OnLine Del 1439* the claim for passing off in respect of a chromatic monopoly over the colour Red and White was found tenable.

28. In such circumstances, there ought to be a *special* obligation on the respondent, as an existing and biggest trade rival (minded to use a similar get up or any indicium) to avoid confusion and deception or the likelihood thereof. (*Reckitt & Colman Products Ltd. vs. Borden [1990] 1*

W.L.R 491 at 515 7-g as per Lord Jauncey). Moreso, when the respondent is also a shareholder in the petitioner company. It is true that there is a natural and inherent right in using any colour but the combination of deceptive resemblances in bringing about a change by a trade rival to an existing product to such an extent is what is impermissible. This cannot remotely be even described as a case of honest concurrent use or an endeavour to adopt a sign which is a “safe distance away” [*Specsavers International Healthcare Ltd. & Ors. vs. Asda Stores Ltd.* (Supra)]. In this background, the decision in *Glaxo Wellcome UK Ltd. and Anr. vs. Sandoz Ltd. and Ors.* (2019) *EWHC* 2545, cited by the respondent, is inapposite since this was a case of pharmaceutical drugs where the plaintiff’s own witness did not associate the colour purple with the plaintiff. As such, there was no exclusivity attached with purple insofar as the product of the plaintiff was concerned.

29. Ordinarily, all confusion is damaging as it *dilutes* the mark. If the respondent is found to be taking a *free ride* or is trying to enjoy the goodwill and reputation of a particular mark or even an essential and prominent indicia thereof, the same is liable to be protected. Taking unfair advantage or *parasitism* which may lead to the confusion or deception or the likelihood thereof is simply unacceptable. Such conduct, notwithstanding the branding, especially when done by a competitor, cannot be innocent but rather a deliberate misappropriation of brand equity and calculated commercial strategy squarely designed to create

confusion and deception or the likelihood thereof in the minds of consumers. “*By an inductive process, one may conclude that every one of those perfectly innocent things when combined in a series has produced something which is the reverse of innocent*”. [Jones vs. Hallworth (Supra) @ Pg 234]

30. It is true that it is not a pre-requisite to liability that the plaintiff must be able to show that the defendant *intended* to pass off their goods as that of the plaintiff. It is equally true as argued by the respondent that motive cannot *per se* afford a cause of action. However, ill motive or bad faith can always *tilt* the scale in such matters in establishing the probability of deception. A conscious decision to live so dangerously close to the petitioner is impermissible. In cases where there is intent to deceive, a Court would more readily infer that the object has been achieved i.e. the intent to deceive ripens into actual deceit. This is not the sort of conduct which even at the interlocutory stage is to be disregarded. What was the respondent thinking in effecting such changes? In someways, the entire exercise undertaken by the respondent can best be described as ill-advised, unimaginative and presumptuous. One would not be mistaken to conclude that the respondent had only the petitioner and its product in mind and was solely inspired by the petitioner in causing such changes. To add, the false claim of user from April 2023, false representation made regarding the entity named Unifier, removal of incriminating evidence during the hearing i.e. posts on facebook,

website- www.elitobatteries.com showing blue batteries taken down, the LinkedIn unifieder which though placed at the time of the opening submissions had been taken down during the course of hearing and the self-contradictory statements in the affidavit all suggest bad faith with the ultimate aim to create confusing similarity. Taken as a whole, the respondent as a trade rival has in changing its trade dress miscalculated the degree of resemblances. Keeping the above principles in mind and in balancing the competing interests, the *Rubicon* or *Lakshmanrekha* has been crossed.

31. There exists unexpected and unexplained similarity in the two products which cannot be overlooked. Obviously, there is a deliberate attempt to steer close towards approximation of the petitioner's get up and trade dress. In this context, the decision in *Cadbury Schweppes v. Pub Squash*, 1981 26 RPC 429, cited by the respondent is distinguishable. The disputes between the parties pertained to advertisement campaigns. The appellant admitted that there was no significant deception or confusion and was unable to on evidence substantiate the fact that the public associated yellow cans with its product Solo.
32. Ultimately, it is the *cumulative and wholesome effect of the detailed resemblances* i.e. colour Red, words EL and the shattered O device all of which form to be a prominent, integral and distinctive part of the petitioner's trade dress and get up taken holistically which *prima facie* contribute to a positive case for the grant of protective orders. [R.

*Johnston & Co. vs. Archibald Orr Ewing & Co. (1882) 7 App. Cas. 219 @ 232-233 and ITC Ltd. vs. Britannia Industries Ltd. 2023 SCC OnLine Mad 6972 (DB) @ Paras 27 – 33, Beiersdorf AG vs. R S H Global Private Limited & Anr. (unreported decision of High Court at Delhi in C.S. COMM 48/2021 @ Para 9)]. In this connection, the decision in *Schweppes vs. Gibbens 1905 RPC Vol-XXII no.26 page 601*, cited by the respondent, is distinguishable. In this case the use of the product was for a limited period of six years. The primary question was whether a barman would be deceived by the label. There was no dispute as to the fact that the soda bottles were strikingly identical. However, in view of the name explicitly appearing in the rival bottle, as a matter of fact it was found that there was no question of passing off. This decision may very well require reconsideration in the light of the pronouncements in *Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd. (Supra)* and *Euro Solo Energy Systems Limited Vs Eveready Industries Limited (Supra)* pertaining to the relevance of English decisions in an Indian scenario.*

33. In such cases, the real injury is in the gradual whittling away or dispersion of the identity or indicia associated upon the public mind with the petitioner and their products. In *Emami Limited vs. Hindustan Unilever Limited 2024 SCC OnLine Cal 3579*, this Court had held as follows:

“20. A conscious and deliberate decision by a competitor in adopting a leading, prominent and essential component of a trade rival while seeking to change the name of its existing brand is not something which can be disregarded. In choosing the word “Glow and Handsome”, there

is also an element of taking unfair advantage of a leading, prominent and essential feature of the petitioner's mark which deceives or is likely to deceive. Nobody has any right to represent the goods of somebody else. In doing so, the rival takes a "free ride". There is no line between permissible free riding and impermissible free riding. All "free riding" is unfair. [L'Oréal v. Bellure (No. 2) [2010] EWCA Civ 535]. Any confusion or deception is damaging. It results in diluting the mark. To some, this may be fair competition or aggressive marketing. To others, trading must not only be honest but must not even unintentionally be unfair."

34. In carrying out the above exercise, the Court is also bound to consider *inter alia* the nature of the market in which the goods in question are sold [Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., (Supra)]. Confusion and deception vary from product to product. [Colgate Palmolive Company & Another vs. Anchor Health and Beauty Care Pvt. Ltd. @ Para 57]. One must take customers as they are found including the imprudent and not so educated. It is not only the diligent or literate or conscious customers which matter. Notwithstanding, the fact that batteries are purchased with care and caution, they are also purchased by lorry drivers, truck drivers, taxi drivers, mechanics and other not so educated persons living in remote corners of the country and they cannot be disregarded.

35. Public interest is of course an underlying factor which ought to be weighed in considering whether the consumers are going to be deceived and the *likelihood* of the same. It is not in public interest to encourage *free-riding*, *parasitism* or *filching*. At the end, there must also be an

element of fairness in the actions of any competitor. This principle has been even more broadly stated:

"In the interests of fair trading and in the interest of all who may wish to buy or sell goods the law recognises that certain limitations upon freedom of action are necessary and desirable. In some situations the law has had to resolve what might at first appear to be conflicts between competing rights. In solving the problems which have arisen there has been no need to resort to any abstruse principles but rather... To the straightforward principle that trading must not only be honest but must not even unintentionally be unfair." [*Parker-Knoll vs. Knoll International* (1962) R.P.C 265 at 278].

36. In view of the above, the petitioner has been able to make out a strong case on merits. The balance of convenience is overwhelmingly in favour of the orders being passed as prayed for. *Prima facie*, on an examination of the rival contentions, there is more than an arguable case at this stage which has been made out by the petitioner which deserves consideration. The respondent has launched its product at its own risk and ought to have been fully aware of all consequences. (*Allergan Inc. vs. Milment Oftho Industries*, AIR 1998 Cal 261).
37. Accordingly, there shall be an order in terms of prayers (a) and (b) of the Notice of Motion. Since the respondent is an existing player in the market, the respondent is granted one month from date to take necessary steps to comply with this order.
38. With the above directions, GA/1/2025 in IP-COM/18/2025 stands disposed of. The parties are at liberty to take expeditious steps for early hearing of the suit.

(Ravi Krishan Kapur, J.)

Later:-

After pronouncement of the judgment, Mr. Das, Advocate appearing on behalf of the respondent prays that the time to carry out the order be extended by a period of three months and not one month. This is opposed by the petitioner.

The prayer is considered.

Accordingly, the time to implement this order is extended by a period of two months from date.

(Ravi Krishan Kapur, J.)