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## Competing designs need not be identical

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### **Britannia Industries Limited v Sara Lee Bakery India Private Limited**

This is an order passed by the Chennai High Court in the injunction application/s filed by the Plaintiff, Britannia Industries Limited against the Defendant, Sara Lee Bakery India Private Limited. The Plaintiff has filed three applications for injunction, (1) restraining the respondent/defendant from committing the acts of piracy of the Plaintiff's registered design of its biscuits (2) injunction restraining the respondent from reproducing and publishing the biscuit wrapper which is deceptively similar or reproduction of the features of the Plaintiff's biscuit wrapper (3) injunction restraining the respondent from manufacturing or dealing in biscuits having the shape/ design identical with or deceptively similar to the Plaintiff's biscuit shape and passing off.

#### **Facts of the case**

The Plaintiff is a company engaged in the business of manufacturing and marketing various food items, such as bread, biscuits, confectionary, cakes and one of the products manufactured by the Plaintiff is a biscuit in the name "Milk Bikis Milk Cream". The Plaintiff's biscuit is circular in shape with funny face on one side and the other side is plain. In between the two biscuits is a filling -- filled with milk cream, a round nose and the mouth in the shape of a smile with two teeth visible -- the two teeth being filled with cream. The novelty of the biscuit lies in the shape and the configuration of the face on the one side and the plain biscuit on the other side with milk cream filled in between the biscuits. The Plaintiff is the registered proprietor of the said design and also holds the copyright "Britannia Milk Bikis Milk Cream".

The Plaintiff filed the action on noting that the Defendant had introduced the offending product as "Milk Wala" which is similar to the product of the Plaintiff in all respects. Thus, the act of the Defendant is a piracy of the registered design, violation of copyright and passing off goods as that of the Plaintiff, as the design of the biscuits and wrapper is same and similar.

The Defendant filed their reply on the following lines:

The Defendant's parent company, namely, Sara Lee Corporation is a global manufacturer and marketer of high quality brand name products for consumers throughout the world. In order to deal with the business of manufacturing and marketing high quality biscuits, the parent company established Sara Lee Bakery India Private Limited. They also entered into an agreement with Nutrine Group who were using the brand name "Milkawala" and thereby acquired the biscuit business of the said group.

The facial biscuit moulds are common in the biscuit trade and the Defendant has also obtained registration of its biscuit design in respect of its facial design. The Plaintiff is claiming an exclusive right in respect of an entire range of biscuits in the shape of different faces, which is not permissible under law and moreover, the face in the offending design is entirely different from that of the Plaintiff's design.

At the hearing the counsel for the Plaintiff submitted that to determine whether two designs are identical or not, it is not necessary that the two designs should be exactly the same. The main consideration is whether the broad features of shape and the figuration are same or nearly the same. Further, the Defendant cannot raise the ground available for cancellation of a registered design under Section 51A of the Act, as they have not taken any steps to cancel the design under Section 51A.

On the other hand, the counsel for the Defendant submitted that the Design and the wrapper of the rival parties are entirely different and show striking differences between them and consequently the Plaintiff is not entitled to any interim reliefs.

After detailed hearing and comparison of the rival products, the Court held that on looking at the Designs in the eye of the customer, namely, children, it is clear that the main features in both the biscuits are not substantially same and therefore there is no infringement. The court also compared the wrappers of the rival products and held that there are substantial dissimilarities and therefore no copyright infringement is made out.

With regard to passing off, the Court found that the Plaintiff has conspicuously displayed its trademark 'Britannia' on the wrapper of its biscuit, whereas the Defendant has displayed its trademark 'Nitrine' and 'Milkwala' on the wrappers of its biscuits.

The features contained in the design and wrappers in both the products are entirely different and the differences are easily perceivable even by young consumers.

In view of above finding, the Court held that the Plaintiff has failed to make out a case for grant of interim injunction and dismissed the application.

Vatika Towers  
10th Floor Block-B  
Sector-54  
Gurgaon-122002  
National Capital Region (Haryana)  
India

Tel. +91 124 4655999  
Fax. +91 124 4045047  
Email [info@indiaiprights.com](mailto:info@indiaiprights.com)

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