

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 27.09.2016

CORAM:

THE HONOURABLE MR. JUSTICE M. M. SUNDRESH

C.S. No. 816 of 2015

and

A.Nos.1094 to 1097 of 2015 & 6774 to 6776 of 2015

M/s. Kaleesuwari Refinery Pvt.Ltd.,
rep. By its Director Mr.K.Ashok Kumar .. Plaintiff

.. Vs ..

M/s. Nellai Agro Food Products
rep. By its Proprietor
Mr.S.V.S. Rajakumar
Old No. 79, New No. 117,
S.N. Chetty Street
Royapuram, Chennai – 13. .. Defendant

The Civil Suit filed under Order IV Rule 1 of the O.S. Rules r/w
Order VII Rule 1 of C.P.C. r/w. Sections 134 & 135 of Trade Marks
Act, 1999 r/w Sections 61 & 62 of the Copyright Act, 1957.

For Plaintiff : Mr. C. Saravanan

For Defendant : Mr. T.K. Ramkumar

for M/s. Ram & Rajan Associates

JUDGMENT

The Plaintiff, being the registered Trade Mark holder of the refined edible sunflower oil "Gold Winner" vide No.1147963, has filed this Suit, *inter alia*, alleging infringement and passing of offending words, pouches etc., by the defendant, seeking for the following relief :-

- i. For a permanent injunction to restrain the Defendant, their men, agents, associates and/or assignees or any person claiming rights from them from infringing the Plaintiff's reputed and well known registered Trade Mark "gold winner" registered vide Trade Mark No.1147963 dated 01.11.2002 and Trade Mark No.1399086 dated 16.11.2005 for Sunflower oil and Refined Sunflower oil in class 29 of the IV schedule to the Trade Marks Rules 1999 by using the offending words registered as a device of "gold o gold" or any mark or words or device deceptively similar to the aforesaid Trade Mark of the Plaintiff's for any edible oil marketed by the Defendant, its men, agents, associates and/or assignees or any person claiming rights from the defendant.
- ii. For a permanent injunction restraining the Defendant, its men, agents, assignees and/or associates or any person claiming rights from them from using the offending pouch/packing

- material bearing the offending words "gold o gold" or any other mark or word and colour scheme and get up deceptively similar to that of the Plaintiff packing material/pouch used for their refined edible sunflower oil with distinct colour scheme, get up with their reputed and well known Trade Mark "gold winner" refined sunflower oil and other oil registered vide Trade Mark No.605323 dated 27/08/1993, Trade Mark No.1147963 dated 01.11.2002 and Trade Mark No.1399086 dated 16.11.2005.
- iii. for a permanent injunction restraining the defendant from violating the Plaintiff's copyright registered vide copyright Registration No.A-68242/2005 dated 27/01/2005 in the artistic work used in the plaintiff's packing material and for pouches for refined edible sunflower oil and other edible products bearing the reputed and well known registered Trademarks "gold winner" by using the offending words "gold o gold" with colour scheme, trade dress and get up in the offending pouches and packing material deceptively similar to that of the plaintiff's colour scheme, trade dress and get up of the plaintiff's pouches and packing with the Trade Mark "gold winner" registered vide the above copyright registration certificates.
- iv. For a permanent injunction to restrain the Defendant, its men,

- agents, associates and/or assignees or any person claiming rights from therein from passing-off their inferior product as that of the Plaintiff's "gold winner" edible refined sunflower oil by using the offending words "gold o gold" or any other words or mark and offending packing material and pouch deceptively similar to the plaintiff's trade mark "gold winner" and trade dress for "gold winner".
- v. For preliminary decree directing the defendant to render true account of profits made by the defendant by using the aforesaid offending lable of "gold o gold".
 - vi. For directing the defendant, its men, agents, assignees, dealers and/or retailers, distributor, to surrender to the Plaintiff all offending pouch/packing material, label, advertising materials, hoarding, letter heads, office stationary and all other material containing/ bearing offending mark/label "gold o gold" with distinct colour scheme, get up and any other mark visually or phonetically similar to the Plaintiff's well-known trademark "gold winner" label for destruction by an order of this Court;
 - vii. For erasure, removal or obliteration from all infringing goods, materials or articles in the possession or control of the defendant with the offending mark/ labels and pouches

deceptively similar to the Plaintiff's "gold winner" refined sunflower oil;

viii. to pay for the costs of the suit and for further orders.

2. The Plaintiff is also the copy right owner, having its Registration No. A-68242/2005. After the suit has been filed, during the intervening period certain new developments have taken place. The defendant company have changed its colour scheme and thus the cause of action that existed originally, does not survive any longer. Suffice it to say, that the defendant no longer uses the original colour scheme and get up.

3. Heard Mr.C. Saravanan, learned counsel for the plaintiff and Mr. T.K. Ramkumar for the respondent. With the consent of both the parties, the matter is taken up for final disposal.

4. In view of the said admitted position, there is no difficulty in closing the suit, since the cause of action does not survive, moreso, the defendant is no longer using the original colour scheme. It is also seen that for the usage of the word "gold o gold" the defendant has got a register type, which stands as of now. It appears that the plaintiff has filed an application, which is still

pending for consideration. Therefore, it is not necessary to go into that issue. Suffice it to say, as of now the defendant is entitled to use the word "gold o gold". Accordingly, the suit stands decreed in the following terms :-

1. The cause of action for the suit does not survive, while the original alleged infringement is the colour;
2. The defendant is not using the original mark, which is exclusive of all the colour scheme;
3. The defendant is entitled to use the word "gold o gold" subject to the orders to be passed in the rectification application filed by the plaintiff.
4. The plaintiff is at liberty to challenge the modified mark of the defendant, which is exclusive of its lay out and colour scheme;
5. The other relief sought for, in the plaint are left open to be raised against the new mark adopted by the defendant.
6. The decree passed in the suit is without prejudice to the right of the parties, including the right of the plaintiff to file a fresh suit, based upon the fresh cause of action, by the changed mark.

5. The suit has been decreed accordingly. Consequently, all the connected Applications are closed.

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Index : Yes

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