

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 16.02.2018

Delivered on : 20.03.2018

CORAM :

The Hon'ble Mr.JUSTICE M.SUNDAR

O.A.No.224 of 2017
in
C.S.No.164 of 2017

M/s.S.N.R.Dhall Mill,
A partnership firm
represented by its Managing Partner R.Surendran,
No.2/4, Vaidyanatha Mudali Street,
Tondiarpet,
Chennai-600 081,
Tamil Nadu .. Applicant

Vs.

M/s.Kaleesuwari Refinery Private Limited,
#53, Rajasekaran Street,
Opp. Kalyani Hospital,
Radhakrishnan Salai,
Chennai-600 004,
Tamil Nadu. .. Respondent

This application has been preferred under Order XIV Rule 8 of O.S. Rules read with Order XXXIX Rules 1 and 2 of CPC seeking an ad interim injunction restraining the respondent / defendant, its directors, all their principal officers, staff, men, agent, servants, successors, assigns in business, representatives and any other person from infringing the trademark by using the words "GOLD WINNER" together, or any other word/words/device that are identical or deceptively similar to the said registered trademark of the applicant having registration No.1232740 in class 30 in relation to manufacturing, packaging, distribution, sale, offering for sale, advertising on any of the respondent/ defendant products or from in any manner dealing with dhall

varieties and thereby restraining them from claiming any right through or under the respondent from in any manner infringing the registered trademark and passing off its products as that of applicant's / plaintiff under trademark "GOLD WINNER" pending disposal of the civil suit.

For Applicant : Mr.Ramesh Ganapathy
for Mission Legal Advocates

For Respondent : Mr.P.S.Raman, SC
for M/s.Surana & Surana
Mr.G.Kalyan Jhabakh

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ORDER

Sole plaintiff in the main suit, i.e., S.N.R. Dhall Mill, a partnership firm, is the lone applicant in this application. Sole defendant in the main suit, i.e., a private limited company, is the lone respondent herein.

2 Parties in this application are referred to by their respective ranks in the main suit for the sake of convenience and clarity. In other words, the applicant in this application is referred to as plaintiff and respondent in this application is referred to as defendant.

3 The nucleus of this entire lis is plaintiff's registered trademark bearing Trademark No.1232740, dated 05.09.2003 registered in class 30. The goods for which this trade mark No.1232740 is registered are Toor Dhall, Dhall varieties, coffee, tea, cocoa, sugar, rice, tapiocak, sago,

coffee substitutes, flour and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, ices, honey, treacle, yeast, baking powder, salt, mustard, pepper, vinergar, sauces, spices and ice. The trademark as contained in the trademark registration certificate is as follows :



This mark is hereinafter referred to as 'said trademark' for the sake of convenience and clarity. A legal use certificate (hereinafter referred to as 'LUC' for brevity) for the said trademark has been placed before me. It is seen from the LUC for the said trademark that trademark type is device and the word mark is GOLD WINNER (LABEL).

4 It is also seen from the LUC that registration of said trademark has been renewed and is valid upto 05.09.2023. In other words, it is subsisting.

5 The defendant has as many as 13 trademark

registrations in India and enumeration of same with details is as follows :

Mark	App#	Class	Dated	Status
Gold Winner	605323	29	27.08.1993	Registered
Gold Winner Groundnut oil label	1073117	29	11.01.2002	Registered
Gold Winner Groundnut oil label	1073118	29	11.01.2002	Registered
Gold Winner label	1147963	29	01.11.2002	Registered
Gold Winner label	1208513	29	23.06.2003	Registered
Gold Winner label	1208514	29	23.06.2003	Registered
Gold Winner label	1399086	29	16.11.2005	Registered
Gold Winner	2320408	29	23.04.2012	Registered
Gold Winner logo	2320409	29	23.04.2012	Registered
Gold Winner label	2320410	29	23.04.2012	Registered
Gold Winner Sree Gold label	1399085	30	16.11.2005	Registered
Gold Winner Sree Gold label	1399087	30	16.11.2005	Registered
Gold Winner Sree Gold label	1399088	30	16.11.2005	Registered

6 The Trade Marks Act, 1999 is hereinafter referred to as 'TM Act' and the Trade Marks Rules, 2002 is hereinafter referred to as 'TM Rules, 2002'. To be noted, enumeration of goods in various classes has been made in Fourth Schedule to TM Rules, 2002.

7 In this regard, before proceeding further with this matter, I deem it appropriate to mention here some details pertaining to the aforesaid Fourth Schedule. As mentioned supra, various classes in which goods and services are classified are adumbrated and set out in the

Fourth Schedule to TM Rules 2002. However, I find that the aforesaid Fourth Schedule was deleted with effect from 8.7.2013. Be that as it may, in supersession of TM Rules 2002, Trade Mark Rules 2017 (hereinafter referred to as 'TM Rules 2017') was brought in and TM Rules 2017 replaced TM Rules 2002 on and with effect from 6.3.2017. Further to be noted, there is no equivalent of Fourth Schedule in TM Rules 2017. In other words, in TM Rules 2017, classification of goods and services under various classes has not been set out. However, Rule 20 of TM Rules 2017 captioned 'Classification of goods and service' deals with this aspect of the matter. I deem it appropriate to extract Rule 20 of TM Rules 2017, which reads as follows :

"20.Classification of goods and service--(1)Classification of goods and service for the purpose of registration of trademark, the goods and services shall be classified as per current edition of "the International Classification of goods and services (NICE classification)" published by the World Intellectual Property Organization (WIPO).

(2)The Registrar shall publish a class wise and an alphabetical index of such goods and services, including goods and services of Indian origin."

8 I am informed that class wise classification of goods and services with an alphabetical index as under sub rule (2) of Rule 20 of TM Rules 2017 is yet to be

published. In this scenario, I am informed that Trademark Registry is continuing to grant trademark registration certificates by following the classification of goods and services as under Fourth Schedule to TM Rules 2002. This throws up a question as to what was the exact position with regard to classification of goods and services during the period between 8.7.2013 and 6.3.2017, i.e., period between deletion of Fourth Schedule in TM Rules 2002 and bringing into force of TM Rules 2017. There is no clarity on this aspect of the matter. Equally it is imperative that the Trade Marks Registrar publishes the list in accordance with sub-section (2) of Section 20 of TM Rules 2017 at the earliest. I deem it appropriate to reserve expression of opinion regarding these two aspects of classes for another case as in the instant case, the LUC is dated 19.9.2005 (certificate No.425162) and the registration date is 5.9.2003 both of which are well before the deletion of Fourth Schedule from TM Rules 2002 on 8.7.2013. I am also informed that 65 countries are parties to NICE agreement and 71 other countries (in addition to 65 countries which are party to NICE agreement) are following the NICE classification. I am also informed that it is 71 countries and 3 organizations. What is of importance is, India is one of the 71 countries which is following NICE classification though it is not a party to NICE agreement.

9 Considering the nature of dispute in the instant case, I deem it appropriate to set out enumeration of goods in Classes 29 and 30 of Fourth Schedule to TM Rules, 2002.

Goods in Class 29 are as follows :

"29.Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats."

Goods in Class 30 are as follows :

"30.Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces, (condiments); spices; ice."

10 Besides the aforesaid 13 registered trademarks, it is the case of defendant that their applications for registration of 3 more marks in Class 29 are pending. It is the case of the defendant that they have also secured international trademark registrations and details of overseas registrations as given by the defendant are as follows :

Country	Mark	App#	Class	Status
Singapore	Gold Winner Vanaspati	T0526845F	29	Registered
Singapore	Gold Winner	T0503379C	29	Registered
Singapore	Gold Winner	T0503792F	29	Registered
Singapore	Gold Winner	T0503696I	29	Registered

Malaysia	Gold Winner	05021648	29	Pending
Malaysia	Gold Winner	05020758	29	Pending
International Application under Madrid Protocol	Gold Winner	1234655	29	Registered
US	Gold Winner	4848593	29	Registered
Australia	Gold Winner	1674105	29	Registered

11 Besides trademark registrations, it is the case of defendant that it is the registered owner of copyright in artistic features of the mark 'Gold Winner'. It is the specific case of defendant that it owns exclusive rights qua proprietorship in copyright in the artistic features of the mark 'Gold Winner' by virtue of the copyright registrations in its favour. Defendant has as many as 8 copyright registrations and the details of the same are as follows :

<i>Title</i>	<i>Registration #</i>	<i>Dated</i>	<i>Status</i>
Gold Winner	A-63204/2003	17.01.2003	Registered
Gold Winner	A-63205/2003	17.01.2003	Registered
Gold Winner Refined Sunflower Oil (1 Ltr) Label	A-68242/2005	27.01.2005	Registered
Gold Winner Refined Groundnut Oil (1 Ltr) Label	A-68243/2005	27.01.2005	Registered
Gold Winner Refined Groundnut Oil (15 kg) Label	A-68244/2005	27.01.2005	Registered
Gold Winner Sree Gold Orid Dhall	A-78000/2006	29.12.2006	Registered
Gold Winner Sree Gold Moong Dhall	A-78004/2006	29.12.2006	Registered

Gold Winner Sree Gold Toor Dhall	A-78063/2007	09.01.2007	Registered
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12 Though elaborate pleadings at the interlocutory stage itself have been made, to my mind the issues can be simplified and narrowed down.

13 The narrowed down / simplified facts and issues can be encapsulated without compromising qua capturing the submissions exhaustively, which are as follows :

(a) There are two goods which are subject matter of this entire application. One is Dhall on one side and the other is Oil on the other side.

(b) Dhall is covered in Class 30. Oil is covered in Class 29.

(c) Plaintiff has got one registration in class 30 for Dhall as user from 01.06.1999.

(d) Defendant's earliest registration for Dhall is dated 16.11.2005, but defendant has not produced LUC. Therefore, the user detail is not readily available. However, defendant has admitted that they are using 'Gold Winner' for Dhall only from 2005 and it is also the admitted case of defendant that their use of the said mark from 1993 is only in oil and not in Dhall.

(e) Therefore, the plaintiff is the prior user of the mark 'Gold Winner' as far as Dhall is

concerned.

(f)Plaintiff has no copyright registration, but defendant does have copyright registration, details of which have been set out supra.

(g)One other important aspect is, of the 8 copyright registrations of defendant, only 3 copyright registrations pertain to Dhall. They are Urad Dhall, Moong Dhall and Toor dhall. Registrations are A-78000/2006 dated 29.12.2006; A-78004/2006 dated 29.12.2006 and A-78063/2007 dated 09.01.2007 respectively.

(h)A close examination of the aforesaid 3 copyright registrations show that the first date of publication of the aforesaid 3 copyright registrations pertaining to Dhall is 2005.

(i)To be noted, 2 Copyright registrations for Gold Winner being A-63204/2003 and A-63205/2003 dated 17.1.2003 show the year and country of first publication as 1990 in India, but these copyrights do not talk about Dhall and they talk only about Oil.

(j)Therefore, in terms of Copyright registrations also as far as Dhall is concerned, the earliest use by the defendant is from 2005.

(k)Therefore, with regard to both registered trademarks and registered copyrights, it emerges clearly that plaintiff is the prior user, i.e.,

from 1.6.1999 as far as Dhall is concerned.

(1)Defendant has used the mark 'Gold Winner' prior to 1999, but only in Oil.

14 Thus, in the instant application pertaining to two goods, namely, oil and Dhall, an analysis of the trademark registration certificates and the copyright registration certificates placed before me shows that plaintiff has been using the mark 'Gold Winner' for Dhall from 1.6.1999 and defendant has been using Gold Winner for Dhall only from 2005.

15 In the above backdrop, submissions made by the plaintiff can be summarised as follows :

(a)Said trademark as registered confers on plaintiff exclusive right to use 'Gold Winner' with regard to Dhall.

(b)Plaintiff has been using 'Gold Winner' and the said trademark from 1.6.1999 for Dhall.

(c)Defendant which was using 'Gold Winner' only for Oil from 1993 started expanding / diversifying its business and started using Gold Winner for Dhall also from 2005.

(d)Anti-dissection principle as contained in Section 17 of TM Act and the principle as explained by case laws operates in favour of plaintiff with regard to the use of 'Gold Winner'.

(e)As both oil and Dhall fall under the same common field of food, they are sold in the same shop and cater to the same class of consumers which is causing confusion in the market.

(f)It is incorrect to say that plaintiff is not in the retail market, because they are selling dhall in the retail market in 5 Kgs. bags also.

(g)Defendant filed a rectification petition for rectification of plaintiff's said trademark on 27.2.2006, but has abandoned it and therefore, defendant cannot now be heard to contend that they can dissect the said trademark and use 'Gold Winner' for Dhall.

(h)Defendant was originally using only Shree Gold from 2005, but suddenly switched over to 'Gold Winner' recently which has necessitated filing of the suit.

16 Submissions made on the side of defendant can broadly be classified as follows :

(a)Defendant is a huge entity, which has spent substantial and large sums of money for advertising and popularizing their mark 'Gold Winner'.

(b)The popularity of the mark 'Gold Winner' is only enuring to the benefit of the plaintiff.

(c)The channels of trade are different and it is incorrect to say that both oil and Dhall being food items are sold in the same shops and cater to the same class of consumers which is likely to cause confusion in the market.

(d)Plaintiff is selling Dhall with said trademark wholesale to distributors in 100 kgs., 50 kgs. and 25 kgs. Bags.

(e)It is incorrect to say that the plaintiff is selling Dhall in retail market in 5 Kgs. bags and the receipts in this regard produced by the plaintiff are disputed. According to defendant, the receipts for 5 Kgs. bags have been gotten up for the purpose of the suit.

(f)Defendant did seek rectification of plaintiff's said trademark by filing rectification petition on 27.2.2006, but they abandoned it as they did not find plaintiff's products, particularly 5 Kgs. Bags, in retail market.

(g)Defendant's mark has attained the status of well known trademark and therefore, it is so powerful that it can cut across classes.

17 In the above backdrop, both sides pressed into service case laws.

Case laws pressed into service by plaintiff are as follows :

<i>Sl. No.</i>	<i>Case Law</i>	<i>Court and Bench Strength</i>	<i>Proposition / point for which it was cited (with paragraph numbers)</i>
1	South India Beverages Pvt Ltd Vs. General Mills Marketing Inc and another CDJ 2014 DHC 2287 (hereinafter referred to as 'South India Beverages Pvt. Ltd. case')	Delhi High Court- Division Bench	Paras 19,26, 30-32, 34-36, 38, 39, 46, 56- Phonetic similarity, Anti-dissection rule and dominate part of the mark
2	A.Kumar Milk Foods Pvt Ltd Vs. Vikas Tyagi and Anr C.S. (OS)No.1627 of 2011 dated 04.09.2013 (hereinafter referred to as A.Kumar Milk Foods Pvt. Ltd. case')	Delhi High Court- Single Judge	Para 26 onwards- complaint of infringement of trade mark can only be with regard to goods in same class or in the class in which they are registered.
3	Khoday Distilleries Limited Vs. The Scotch Whiskey Association [Appeal (Civil) No.4179 of 2008, dated 27.05.2008] (hereinafter referred to as 'Khoday Distilleries Limited case')	Supreme Court- 2 Judges	Para 23- Estoppel and Acquiescence under the Trade Mark Act, 1999
4	Rana Steels Vs. Ran India Steels Pvt. Ltd. Dated 25.3.2008 (hereinafter referred to as 'Rana Steels case')	Delhi High Court- Single Judge	Paras 23-27- Goods and services must be similar. Section 30(2)(e) and section 28 of TM Act also analysed.

Case laws pressed into service by defendant are as follows :

Sl. No.	Case Law	Court and Bench Strength	Proposition / point for which it was cited (with paragraph numbers)
1	Nakoda Diary (P) Ltd Vs. M/s Kewal Chand Vinod Kumar (hereinafter referred to as 'Nakoda Diary case') MANU/TN/4324/2011	Madras High Court- Division Bench	Paras 15-18- usage of Trade mark and prior user.
2	Om Prakash Gupta Vs. Parveen Kumar and Anr MANU/DE/1199/2000 (hereinafter referred to as 'Om Prakash Gupta case')	Delhi High Court -Single Judge	Paras 12-14- Concealment of material facts and the disclaimer attached to the registration.
3	The Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd. MANU/SC/0052/1955 : AIR 1955 SC 558 (hereinafter referred to as 'Ashok Chandra Rakhit Ltd. Case')	Supreme Court - 3 Judges Bench	Paras 6,7,16,19 and 20- Registrar's discretion and when the registration is a whole, that will not give a right to use one particular part of the mark.
4	Ultratech Cement Limited Grasim Industries Limited Vs. Dalmia Cement Bharat Limited and Ors MANU/MH/0954/2016 (hereinafter referred to as 'Dalmia Cement case')	Bombay High Court- Single Judge	Paras 9 and 14-19- In Trade Mark, you will have to use it as a whole and, in this case ULTRA could not be monopolised, as it is a descriptive word.

18 South India Beverages Pvt. Ltd.'s case was pressed into service in support of anti-dissection principle, dominant feature of a mark principle and

phonetic similarity rule. A Division Bench of Delhi High Court held that the anti-dissection rule mandates that Courts while dealing with cases of trademark infringement involving composite marks, must consider the composite marks in their entirety as an indivisible whole rather than truncating or dissecting them into its component parts and make comparison with the corresponding parts of a rival mark to determine the likelihood of confusion. In this regard, the disclaimer in the LUC of plaintiff's said trademark assumes significance.

19 The disclaimer in the plaintiff's LUC with regard to the said trademark is captioned 'Condition & Limitation' and the same reads as under :

'Condition & Limitation: Registration of this Trade Mark shall give no right to the exclusive use of the DEVICE OF MAN AND OTHER DESRIPTIVE MATTERS APPEARING IN THE LABEL'

20 Mr.P.S.Raman, learned senior counsel leading Mr.Kalyan Jhabakh, learned counsel of M/s.Surana and Surana, law firm, on record for defendant wanted me to read this disclaimer to mean that the plaintiff has no exclusive right in 'GOLD WINNER'. Per contra, Mr.Ramesh Ganapathy of Mission Legal Advocates, law firm, on behalf of plaintiff drew my attention to plaintiff's LUC, wherein the trademark type has been shown as Device and word mark has been shown as 'GOLD WINNER (LABEL)'. On this basis, it was submitted

that plaintiff's right in the said trademark does not give exclusive right to plaintiff's use of device of man for Toor Dhall which is descriptive of the product.

21 On a plain reading of the LUC, particularly in the light of the trademark type and word mark, I have no difficulty in coming to the conclusion that the disclaimer is only with regard to device of man (which i see as an athlete) and the term Toor Dhall which is descriptive of the product. To my mind, the disclaimer even in plain language means that plaintiff cannot claim any exclusive right over the athlete (running man) and the words Toor Dhall in the said trademark and cannot use these two features of the said trademark in isolation. In other words, plaintiff does have exclusive right with regard to other features and aspects of the said trademark. To be noted, the other features and aspects of the said trademark includes 'GOLD WINNER'.

22 **A.Kumar Milk Foods Pvt. Ltd.**'s case authored by Hon'ble Mr.Justice S.Muralidhar of Delhi High Court and Rana Steels' case of Delhi High Court authored by Hon'ble Mr.Justice Badar Durrez Ahmed, as His Lordship then was, were pressed into service regarding infringement in the same class. To be noted, A.Kumar Milk Foods Pvt. Ltd. relies on Rana Steels case. A dispute where the same mark was registered in two different classes, i.e., classes 6 and 9 and how the same has been dealt with has been elucidatively articulated in paragraphs 26 to 29 of A.Kumar

Milk Foods Pvt. Ltd.'s case and I deem it appropriate to extract the same :

26. The facts of the present case are closer to the facts in Rana Steels v. Ran India Steels Pvt. Ltd., 2008 (102) DRJ 503. The dispute there concerned the use of the Plaintiff's trademark, RANA, registered under Class 6, by the Defendant who had a registered trademark, RANA TOR, under Class 19. While allowing the Plaintiff's prayer for confirmation of an earlier ex parte injunction granted against the Defendant, the Court explained the scope Section 28 of the Act, in para 23, as follows:

"... Section 28 deals with the rights conferred by registration. And, it has already been clarified that the use of a registered mark must be in relation to the goods or services in respect of which the trade mark is registered. It follows that where the goods or services, in respect of which two or more identical or similar (nearly resemble) marks are registered, are different then Section 30(2)(e) does not come into play. The question of infringement would, itself, not arise as the registered marks would be used in respect of different classes of goods or services by their respective proprietors. A couple of examples would further clarify the position:

Example 1: Assume that a trade mark "M" has been registered in favor of Mr "X" as well as in favor of Mr "Y" in

relation to the same goods or services. In such a situation, by virtue of Section 28(3), neither Mr "X" nor Mr "Y" can claim exclusivity against each other for the use of the said mark in relation to the goods or services for which it was registered. If Mr "X" were to bring an action for infringement against Mr "Y", the latter would have a complete defense under Section 30(2)(e).

Example 2: Let us now assume that there are two different goods "A" and "B" in respect of which the same trademark "M" has been registered in favor of different persons "X" and "Y", respectively. Here, although the same mark "M" is registered in favor of both Mr "X" and Mr "Y", Mr "X" has exclusive right to use the same in respect of good "A" and Mr "Y" has exclusive right to use the said mark in respect of good "B". Therefore, Section 28(3) is not attracted. Moreover, if Mr "X" were to bring an action of infringement against Mr "Y" alleging that Mr "Y" was using the said mark "M" in relation to good "A", then, the defense of Section 30(2)(e) would not be available to Mr "Y" as he does not have any right to use the mark "M" in relation to good "A", his registration being in relation to good "B".

27. The case on hand is covered on all fours by Example 2 above. Indeed the legislative intent was to extend the protection of the registered mark against infringement in respect of the goods for which the registration was granted. A reading of Section 7 of the TM Act, which provides for classification of goods and services, with Rule 22 of the Trade Marks Rules, 2002 which provides that for the purposes of registration of trademarks, goods and services shall be classified in the manner specified in the Fourth Schedule, shows that registration of trademarks is meant to be for goods or services that have been specified in the Fourth Schedule under different 'Classes'. This explains the rationale behind indicating the particular class of goods for which the registration has been granted.

28. Section 28(3) of the TM Act cannot be interpreted in a manner that would be contrary to the above scheme of the Act and Rules. In other words Section 28(3) of the TM Act should be understood as not permitting an infringement action being brought by one registered proprietor against another only where two conditions are satisfied: one, that the two registered marks "are identical with or nearly resemble each other"; and two, they are in respect of the same class of goods and services. This will be in conformity with the object of Section 28(1) read with Section 29 of the TM Act which seeks to grant protection to the registered proprietor of a mark from

infringement in respect of the goods for which registration is granted.

29. Both in T.T.K. Prestige Ltd. v. Har Parasad Gupta 77 (1999) DLT 357 and Marc Enterprises Pvt. Ltd. v. Five Star Electricals (India) (2008) ILR 2 Delhi 771, the marks in question were registered by the Plaintiff and the Defendant in the same class of goods. In both cases, this Court followed PM Diesels Pvt. Ltd. and declined injunction. As noticed earlier, in the present case the Plaintiff is, unlike the Plaintiff in P.M. Diesels, not at this stage seeking to restrain the Defendants from using the mark SHREEDHAR in respect of the goods for which the Defendants hold the registration i.e. Class 30 goods. The Plaintiff is seeking to protect its own trademark SHRIDHAR, registered in respect of Class 29 goods from infringement, by restraining the Defendants from using SHREEDHAR to describe their Class 29 goods. This is permissible on a reading of Section 28 (1) with Section 28(3) of the TM Act as explained in Rana Steels."

23 In this case, the products dhall and oil are in different classes, i.e., 30 and 29. Plaintiff is prior user in Dhall and defendant is prior user in Oil. Now the dispute is with regard to use of the mark for Dhall.

24 Before proceeding further with discussion of all other case laws that were pressed into service in the course of the hearing, I deem it appropriate to discuss the

classification of goods and services in the TM Act. I have already discussed and alluded to supra classification of goods and services qua TM Rules 2002 and TM Rules 2017 supra.

25 Under TM Act, goods and services are classified into 42 classes. Classes 1 to 34 are goods and the remaining 8 classes, i.e., classes 35 to 42 are services. To be noted, in each class, several goods and several services are set out. In other words, classes are not restricted to one goods or one service. Each class consists of many goods / many services.

26 To my mind, general scheme of the statute, i.e., TM Act, with regard to rights conferred on a registrant and infringement are class driven. Rights conferred on the registrant are contained in Section 28 of TM Act and what constitutes infringement of a registered trademark has been explained in Section 29 of TM Act.

27 A conjoint reading of the aforesaid two provisions, i.e., Sections 28 and 29 of TM Act would reveal that the general scheme of TM Act with regard to two concepts, i.e., (i) 'rights conferred on a registrant' and (ii) 'infringement of registered trademark' are class driven. I deem it appropriate to extract sub-section (1) of section 28 as well as sub-sections (1) and (4) of Section 29 of TM Act for this purpose and they read as follows :

"28.Rights conferred by registration.--(1)

Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

29.Infringement of registered trade marks.--

(1)A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

x x x x x x x x x

(4)A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which--

(a)is identical with or similar to the registered trade mark; and

(b)is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c)the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character

or repute of the registered trade mark.”

(underlining made by me to supply
emphasis and highlight)

28 A plain reading of the aforesaid provisions would show that a registrant of a trademark has an exclusive right qua the registered trademark only 'in relation to goods or services in respect of which the trademark is registered. Equally, infringement of a registered trademark occurs only when a mark which is identical or deceptively similar to a registered trademark, is used 'in relation to goods or services in respect of which the trademark is registered'.

29 Therefore, in the light of the instant discussion, the expression which is of utmost importance is 'in relation to goods or services in respect of which the trade mark is registered'. This expression occurs both in Sections 28 and 29 which deals with rights of registrant and infringement.

30 Therefore, there can be no doubt that in the normal course, a registrant can complain of infringement only when an identical or deceptively similar trademark is used in relation to same goods or same services for which the registrant has got the trademark registered. As would be evident from the extract supra, exception to the above rule is contained in sub-section (4) of section 29. One

more exception to my mind is sub-clause (zg) of sub-section (1) of section 2 of TM Act, which defines 'well-known trademark'. I deem it appropriate to extract Section 2(1)(zg) of TM Act which reads as follows :

“(zg)“well-known trade mark”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.”

31 A close examination of the aforesaid exception to the general scheme of the statute reveals that a registrant can complain of infringement and can claim rights qua the mark with regard to goods and services other than those for which it was registered only when it is either a well known trademark within the meaning of Section 2(1)(zg) or when the mark has a reputation in India which is such that the very use of mark without cause will tantamount to taking unfair advantage and can become detrimental to the distinctive character and reputation of registered trademark.

32 When a registered trademark is granted, the certificate does not indicate that the mark has reputation in India which is such that the mere use of the mark will

give unfair advantage and become detrimental to the distinctive character and reputation of the mark. On the contrary, trademark registration certificates are given only on the basis of aforesaid 42 classes. In fact, the trademark registration clearly specifies the class for which registration of a particular mark is granted. Further to be noted, it does not stop with just the class, but the actual goods contained in a class and the actual service contained in a particular class for which a registration is granted are also set out in the certificate. For example, if there are 10 different goods in one class, the registration may not be for all 10 goods. After specifying the class, the actual goods are also set out and some times it may even be for one, two or three goods in a class which contains several goods. Equally, this applies qua 8 classes containing services also.

33 Further to be noted, sub-section (4) of section 29 of the TM Act which has been extracted supra was not existing in the statute books under the earlier statute, viz., The Trade and Merchandise Marks Act, 1958. However, Section 2(1)(zg) which defines 'well-known trade mark' was introduced into the TM Act only under the 1999 TM Act which came into force on and with effect from 15.9.2003. Also to be noted, under the Trade and Merchandise Marks Act, 1958, there were no service marks. Marks were classified only qua goods. Even with regard to that there were two sets of marks, one in Part A and the other in Part B. However, for

the purpose of discussion in the instant application, whether a mark has attained the kind of reputation envisaged in sub-section (4) of section 29 and whether a mark is 'well known trade mark' within the meaning of section 2(1)(zg) are matters for trial. The question as to whether 'well known trade mark' declaration should be first given by Trade Mark Registry after due publication is also left open for being agitated in the main suit. It is well open to the defendant in the instant case to establish in trial that their mark has attained the kind of reputation and status contained in sub section (4) of section 29, so that it can cut across classes. It assumes great significance in the instant case as the two products, as mentioned supra, are in two different classes. While oil is in class 29, Dhall is in class 30. Therefore, whether defendant's use of the mark from 1993 for the product oil in class 29 will give any right to defendant to object to the use of the mark for another product, i.e., dhall in class 30 will ultimately depend on defendant being able to establish the reputation of its mark in the trial.

34 ***Khoday Distilleries Limited*** case was pressed into service to say that the defendant, owing to abandoning the rectification application, is guilty of laches. To be noted, as alluded to supra, it is the case of the defendant that they abandoned the rectification application as they did not find 5 Kgs bags of the plaintiff in the retail

market. There is serious dispute with regard to the invoice produced in this regard. While the plaintiff asserts that they are in retail trade with 5 kgs bags which are being sold side by side along with oil in pouches (both being food items), the same is seriously disputed by the defendant. This is a matter for trial and this can be tested only in the trial and not at this interlocutory application stage by way of affidavit and counter affidavit.

35 On the side of the defendant, **Nakoda Dairy** case was pressed into service to say that exclusive right under Section 28 of the TM Act is subject to other provisions of TM Act. There is a specific reference to Section 34 of TM Act which makes provision for protecting the rights of a person using the mark from an earlier date. In the light of the undisputed factual position in this case that the plaintiff is using 'Gold Winner' for Dhall prior to defendant (though defendant is using it for Oil earlier), this case law does not help the defendant. Paragraphs 15 to 18 of **Nakoda Dairy** is extracted hereunder :

15. However, the exclusive right under Section 28 is subject to the other provisions of the Act. Section 34 of Trade marks Act makes provision for protecting the rights, so that the proprietor of the registered trade mark cannot interfere with the use of any identical or similar mark, if the said person has been using the mark from an earlier date. Section 34 of Trade Marks Act, 1999 reads as under:-

34. Saving for vested rights. - Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior -

(a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or

(b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his, whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first-mentioned trade mark.

The benefit of Section 34 will thus be available to the Respondents-Defendants to prevent the proprietor or registered user of a registered trade mark to interfere with or restrain the continued usage of an identical mark by the Respondents-Defendants.

16. Learned counsel for Appellant has contended that to claim protection under

Section 34 of the Act, the Respondents-Defendants have to prove continuous user from 1996 and no documents were produced by the Respondents-Defendants to show prior and continuous user of the mark "NAKODA". It was further submitted that the burden lies upon the Respondents-Defendants to prove continuous user and Respondents have not produced any documents to show the volume as well as their turn over to prove the continuous usage and while so, the learned single Judge erred in saying that Respondents-Defendants are the prior user of the mark. In support of his contention, the learned counsel for Appellant has placed reliance upon 2005 (31) PTC 546 (Mad.) (DB) [Sri Balamurugan Modern Rice Mill Vs. Subbulakshmi Modern Rice Mill and Another] and 2008 (36) PTC 688 (Mad.) (DB) [Amaravathi Enterprises Vs. Karaikudi Chettinadu].

17. Holding that the person who is resisting the suit has to prove the continuous usage of the trade name, in Amaravathi Enterprises Vs. Karaikudi Chettinadu (2008 (36) PTC 688 (Mad.) (DB)), the Division Bench of this Court held as under:-

19. When a party is using prior user as a shield in an action for infringement, it is necessary to prove that they have been continuously using the trade mark in respect of the goods manufactured or marketed by them.

20. In the present case, the respondent relies on an unregistered

partnership deed dated 15.09.2000, Nil IT returns for the year 2000-2001 and the licence fee receipt issued by Ambattur Municipality in support of their contention that they are the prior use of the name 'KARAIKUDI CHETTINADU RESTAURANT".

21. When a defence of prior user is taken, burden lies on such trader/manufacturer to prove the continuous usage of the said trade name. Here the volume of sales also assumes significance. Similarly advertisement and other modes adopted for promotional sales also assumes significance. The reason being that the statutory presumption under Section 28 of the Trade Marks Act, 1999 loses its significance once prior user as provided under Section 34 of the Act is established.

22. The documents produced by the respondent even if taken in its face value will not satisfy the test to determine the continuous user. In the income tax returns, what is reported is only trading loss. The other documents are all receipts for payment of fees. Those documents do not show the volume of sales or continuous usage. There is no evidence of any advertisement or sales promotional activities undertaken by the respondent. There is also no prima facie evidence to show the volume of business of the respondent. Therefore

we are convinced that the respondent miserably failed to prove the continuous usage so as to defeat the right conferred on the appellant under Section 28 of the Trade Marks Act.

23. The appellant in this case though obtained the registration in class 42 only on 19.02.2004, there is prima facie material to prove that they are the prior user much before the commencement of partnership business by the respondent. The appellant had also got registration in class 29 on 04.01.1994, the same being cognate to the services rendered by the appellant as per class 42. It is also a prima facie evidence of prior user.
(underlining added)

18. In Sri Balamurugan Modern Rice Mill Vs. Subbulakshmi Modern Rice Mill and Another (2005 (31) PTC 546 (Mad. (DB)), placing reliance upon the judgment of the Supreme Court in 2001 PTC (21) 417(SC) : 2001(5) SCC Pg.95 (Uniply Industries Ltd., Vs. Unicorn Plywood Pvt. Ltd.), the Division Bench of this Court held as follows:

"...The Supreme Court in that judgment held that in considering a case of either granting or not granting an order of interim injunction in a case where there is a complaint of passing off, the party complaining of such action should establish a strong prima

facie case. In that case the parties to the proceeding had a common field of activity in respect of goods and trade marks sought to be used by either are identical. The Supreme Court proceeded to state that inasmuch as the areas of activity and the nature of goods dealt with or the business carried on being identical and the trade marks being of a similar nature, the only question that needs to be decided is as to who is the prior user? In deciding the controversy namely, how far the claim of prior user would have an impact, the Supreme Court went on to say that relevant materials in that regard must be placed before Court. The Supreme Court in that case held that prior small sales of goods with the mark are not sufficient to establish priority and the real test would be to determine continuous prior user and the volume of sale or the degree of familiarity of the public with the mark. The Supreme Court had also indicated that the court has to determine whether the party complained of had also honestly and concurrently used the trade mark or there are other special circumstances arising in the matter."

36 Suffice to say that while there can be no disagreement whatsoever with regard to the principle laid down in **Nakoda Dairy** case, it is nobody's case here that the plaintiff has not used the mark continuously. As alluded to supra, in the instant case, there is no dispute on fact that the plaintiff has used 'Gold Winner' on Dhall prior to defendant. In other words, the plaintiff has used 'Gold Winner' on Dhall from 1999 (from 1.6.1999 to be precise).

37 **Om Prakash Gupta** case was pressed into service with regard to disclaimer point. I have already discussed the disclaimer point in detail supra. I have discussed the disclaimer of plaintiff's LUC with regard to the said trademark. **Om Prakash Gupta** pertains to concealment of disclaimer and therefore, this also does not help the defendant's plea.

38 On the contrary, **Om Prakash Gupta** though cited by the defendant, actually helps the plaintiff. In **Om Prakash Gupta** case, there was, in fact, a disclaimer in the registration of plaintiff's mark, but while filing the suit, plaintiff had concealed the disclaimer. When judgment was delivered, the disclaimer was brought to the notice of the Court (apparently by defendant) and the Court had interpreted the disclaimer. I find that the disclaimer in **Om Prakash Gupta** case is virtually the same disclaimer, which is contained in the plaintiff's LUC in the instant case. The disclaimer in plaintiff's LUC in the instant case

reads as follows:

"Condition & Limitation: Registration of this Trade Mark shall give no right to the exclusive use of the DEVICE OF MAN AND OTHER DESCRIPTIVE MATTERS APPEARING IN THE LABEL."

The disclaimer in **Om Prakash Gupta** case extracted in paragraph 10 of the said judgment reads as follows :

"REGISTRATION OF THIS TRADEMARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF THE DEVICE "SUN" AND THE WORD "SURAJ"."

39 A plain reading of the two disclaimers will make it clear that two disclaimers are virtually the same.

40 I have already interpreted the disclaimer in plaintiff's LUC in the instant case and said that plaintiff will have no exclusive right over athlete device / picture and the term 'Toor Dhall'. Plaintiff will have exclusive right with regard to other features of the mark. The interpretation of aforesaid disclaimer in **Om Prakash Gupta's** case by Delhi High court is also exactly on same lines. Interpreting the aforesaid disclaimer in **Om Prakash Gupta's** case, Delhi High Court held in paragraph 16 as follows :

"16. As seen above, the trademark was registered subject to disclaimer that this registration shall give no right to the exclusive use of the device of 'Sun' and the

word "SURAJ". This means that the word "SURAJ" and the device of Sun do not form part of the registered trademark. And the registered trademark is only "Zafrani Patti".

41 This is the reason why I am of the view that **Om Prakash Gupta** case actually helps the plaintiff and not defendant.

42 With regard to **Ashok Chandra Rakhit Ltd.** Case, the same dealt with the correctness or otherwise of rectification proceedings before the Registrar and therefore, this also does not help advancing the case of the defendant. Paragraphs 14 and 15 of **Ashok Chandra Rakhit Ltd** case are of relevance. I deem it appropriate to extract the same, which reads as follows :

"14. It is true that where a distinctive label is registered as a whole, such registration cannot possibly give any exclusive statutory right to the proprietor of the trade mark to the use of any particular word or name contained therein apart from the mark as a whole. As said by Lord Esher in *Pinto v. Badman* [8 RPC 181 at p 191] :

"The truth is that the label does not consist of each particular part of it, but consists of the combination of them all".

Observations to the same effect will be found also in *In re Apollinaris Company's Trade*

Marks [LR (1891) 2 Ch 186], *In re Smokeless Powder Co.*, *In re Clement and Cie* [LR (1900) 1 Ch 114] and *In re Albert Baker & Company* and finally in the *Tudor* case referred to above which was decided by Sargant, J. This circumstance, however, does not necessarily mean that in such a case disclaimer will always be unnecessary. It is significant that one of the facts which give rise to the jurisdiction of the tribunal to impose disclaimer is that the trade mark contains parts which are not separately registered. It is, therefore, clear that the section itself contemplates that there may be a disclaimer in respect of parts contained in a trade mark registered as a whole although the registration of the mark as a whole does not confer any statutory right with respect to that part.

15. As we have already stated the possibility of the proprietor attempting to expand the operation of his trade mark cannot be ignored or overlooked. It is a thing which must be taken into consideration by the Tribunal be it the Registrar or the Court – in deciding upon the way it should exercise the discretionary power conferred on it. Reference has been made by the High Court to the observations of Eve, J., in the *A.B.C.* Case referred to above and the question has been posed as to whether any good cause had been shown for the necessity of disclaimer in this case. The High Court answers the question immediately by saying that it did not think that any cause had been shown beyond the desirability of having a uniform practice. This, as we have already

stated, is not quite correct, for apart from the practice the Registrar did advert to the other important consideration, namely, that on the evidence before him and the statement of counsel it was quite clear that the reason for resisting the disclaimer in this particular case was that the Company thought, erroneously no doubt but quite seriously, that the registration of the trade mark as a whole would, in the circumstances of this case, give it a right to the exclusive use of the word "Shree" as if separately and by itself it was also its registered trade mark and that it would be easier for it to be successful in an infringement action than in a passing off action. It was precisely the possibility of such an extravagant and untenable claim that called for a disclaimer for the purpose of defining the rights of the respondent company under the registration. This aspect of the matter does not appear to have been pressed before or adverted to by the High Court. "

43 In the instant case, there is a disclaimer in the LUC of the plaintiff. The interpretation of the disclaimer clearly shows that the disclaimer is only with regard to running man (athlete) device and words 'Toor Dhall' which is descriptive of the product. There is no disclaimer with regard to 'Gold Winner'. Therefore, this case law also does not help the defendant while the principles are indisputable. In this regard, I deem it appropriate to contend that the disclaimer is always with limitation and

is never used to exemplify the mark. This would be evident even from the caption used in the disclaimer which says 'Condition & Limitation'.

44 ***Dalmia Cement*** case was pressed into service in an attempt to say that plaintiff does not get any exclusive right or monopoly over 'Gold Winner'. My attention was drawn to paragraphs 9 and paragraphs 14 to 19. I deem it appropriate to extract the same, which reads as follows :

"9. Let us now see if the registration of their marks containing the word 'ultra' as a part may be said to be giving any monopoly to the Plaintiffs to the use of the part. In the first place, the registered marks contain many features in a combination, the word 'ultra' forming but one such feature. The registered marks are all device/label marks with words such as 'UltraTech Cement', 'UltraTech Cement The Engineer's Choice', 'UltraTech concrete we make good concrete better', 'UltraTech readymix', 'Ultracem', 'UltraTech white cement Pure White Cement', etc. forming part of the device/label. Though the word 'Ultra' does form an important feature of all these marks, it is not used in any of them as a single word, but always as a prefix as in 'Ultratech' or 'Ultracem'. Secondly, even as a prefix the Plaintiffs can hardly claim any monopoly in it. The Plaintiffs' application for registration of the mark 'UltraTech Cement' as part of a device/label mark was objected to by the Registry, which considered the words to be descriptive in nature. Far from joining issues with this objection, what the Plaintiffs appear to have

submitted in justification was (i) that the words 'UltraTech Cement' only formed a part of the mark applied for, (ii) that the words were used in conjunction with Aditya Birla Group Label, (iii) that these words and others in the label were to be considered together and (iv) that when so considered, the mark was capable of distinguishing the Plaintiffs' goods. Satisfied with this explanation, the Registry proceeded to register the mark. The subsequent request of the Plaintiffs to amend the application by deleting Aditya Birla Group Label from the mark was not accepted by the Registry. Thus, the Plaintiffs' application and the Registry's acceptance of that application were on an express footing that the words 'UltraTech Cement' were distinctive only in the combination in which they were being used. No doubt, subsequently the Plaintiffs did manage to get registrations of the marks 'UltraTech Ready Mix', 'UltraTech White Cement', 'UltraTech Concrete' and 'UltraCem' minus the Aditya Birla Logo/Label, but that does not detract from the fact that all registrations were as device/label marks in combination and cannot entitle the Plaintiffs to any monopoly over the word "Ultra". So much for the Plaintiffs' right acquired out of the registrations.

14. In *De Cordova* (supra), the Privy Council particularly held that the word "VapoRub" was a fancy word coined originally to serve as a trade appellation of the respondents' product; there was an inherent likelihood that in a course of time it would come to be used in the market as a distinctive name or one of the distinctive names of that product; and that was

what the evidence in that case showed to have happened in the concerned territory. The Court held that the appellants had infringed the trade mark by selling their ointment under the designation "Karsote Vapour Rub". The Court held the word 'Karsote', which prefaced the words 'Vapour Rub', to be quite insufficient in itself to dissolve the impression that was bound to arise from associating the appellants' goods with a word so distinctive as 'Vapour Rub'. The appellants in that case sought to establish before the Privy Council that the word 'VapoRub' in the respondents' mark was merely descriptive. They compared it to descriptive words such as "sheen", "cellular cloth", "malted milk" and "shredded wheat". The Privy Council held that it would be an abuse of language to place a fancy word such as "VapoRub" in the same descriptive class as such phrases as "malted milk" or "shredded wheat". The Privy Council held that the word might have a descriptive element, it being a compound of two ordinary English words which were chosen for the purpose of suggesting to the reader leading characteristics of the substance sold; but the word itself was no description of the substance. In other words, the Court held that the word "VapoRub" was adopted to distinguish the respondents' goods and that, in the premises, a same or a deceptively similar expression such as Vapour Rub' cannot be used to distinguish the goods of another trader even if the same were prefixed by the word 'Karsote'. The facts of that case are clearly distinguishable from the facts of our case. In our case, it cannot be said by any stretch of imagination that the word 'ultra' is

a fancy word, which evokes an association with the Plaintiffs' goods by reason either of its being part of the Plaintiffs' registered trade marks or of the extensive sales and advertisements of the Plaintiffs' goods. It is a common English word mostly used as a prefix, as I have noted above, and cannot be described as a prominent or essential feature of the Plaintiff's mark, affording the Plaintiffs a monopoly of its use.

15. In Saville Perfumery's case, the offending word 'June', which the plaintiff in that case had used continuously and extensively for a number of years, was part of the plaintiff's trade mark written in characters of a special form across the bar with the garland of flowers depending from the bar. There was a disclaimer of the exclusive right to the floral device. The defendants used the word 'June' as part of their trade mark. The question was whether the mark 'June' used by the defendants so nearly resembled the plaintiff's registered mark as to be likely to cause confusion. The House of Lords came to the conclusion that the essential feature of the plaintiff's mark had been taken by the defendants and used as a mark for the goods of the class for which the plaintiff's mark was registered. The Court came to the conclusion that the defendants' use of the word 'June' as a mark in question on the goods so nearly resembled the plaintiff's mark as to be likely to deceive or cause confusion in the minds of purchasers with a normally imperfect recollection of the picture representing or containing the registered mark. The Court held that the injunction against the

infringement of the trade mark was, therefore, rightly granted. The discussion of House of Lords in Saville Perfumery's case does not apply to the facts of our case. There is nothing distinguishing about the word 'ultra' as used by the Plaintiffs here and it cannot possibly be suggested that any essential or prominent feature of the Plaintiffs' mark is used by the Defendant so as to cause confusion or deception in the minds of the purchasing public or traders.

16. In Taw Manufacturing Coy. Ltd. (supra), the registered trade mark consisted of a pictorial device comprising of a representation of a full-faced view of a cat's head, wherein the eyes were drawn in the form of motor car headlamps, the whole superimposed upon an open body motor car viewed from the front in a manner so as to substitute cat's head for the bonnet and radiator as normally present. The offending mark was a cat's device with a full-faced view of a cat's head and with the eyes drawn as a motor car headlamps, beneath which was the caption "Let Notek be your eyes in fog and darkness". The disposition and lettering selected was such as to lead the leader to take particular notice of the device with the word "Notek" beneath it. The Court particularly held that it would appear unlikely that anyone acquainted generally with the registered trade mark of the plaintiffs would fail to regard as its characteristic feature the substitution of headlamps for eyes in a representation of a cat's head. This was a significant detail which any recollection of the mark would retain. The Court, accordingly, granted injunction against

the defendant and held that the essential part of the registered mark did not consist merely of a cat's head but included headlamp treatment of the eyes and this had been the monopoly of the plaintiffs and that the plaintiffs had accordingly established infringement of their registered trade mark and were entitled to relief against such infringement. Once again, the entire discussion has no bearing on the facts of our case, where the Plaintiffs cannot be said to have monopoly in the word 'utlra' and allowed any injunction against rival traders using the same.

17. Even in the cases of James Chadwick & Bros. Ltd., Reckitt & Colman of India Ltd. and Hindustan Embroidery, the facts are clearly distinguishable from the facts of our case. In James Chadwick, the registered trade marks bore a legend "Eagely Sewing Machine Thread" with a representation of an eagle in one and a representation of an eagle without any writing in the other. The Court held that the goods sold under this trade mark were well known and commonly asked for as 'Eagley' or 'Eagle' and therefore, the particular feature of the trade marks by which the goods were identified in the minds of the purchaser was the representation of the Eagle appearing on the trade mark. The Court, accordingly, did not permit registration of a rival mark using a representation of a bird of prey which the proprietors had chosen to call during the relevant period 'Eagle Brand'. The Court held that the narrow question which arose in the appeal was whether the trade mark sought to be registered contained a similar or identical distinguishing or essential feature.

"If it does, if the trade mark conveys the idea of an Eagle & if an unwary purchaser is likely to accept the goods of the respondents as ensuring the requisition for Eagle goods, then undoubtedly the trade mark of the respondents is one which would be likely to deceive or cause confusion", held the Court. In other words, what the Court noted was that it was important to find out what was the distinguishing or essential feature of the trade mark already registered and what was the main idea underlying it and if it would find that the trade mark whose registration was sought contained the same distinguishing or essential feature or conveyed the same idea, it should rather refuse registration. Reckitt & Colman was a case where the essential or distinguishing feature of the mark was the device of a "sword". The defendants had also adopted the device of the "sword", which device was identical or deceptively similar to the plaintiff's registered trade mark. The Court held that it was not necessary that the mark complained of should be identical with that of the device registered by the plaintiffs; that a mere look at the mark of the defendants left no manner of doubt that the prominent feature of the mark adopted by the defendants was the 'sword', which was a special or distinguishing feature of the plaintiff's registered trade mark. In our case, the word 'ultra' is neither a distinguishing nor a special feature of the mark, the copying of which may amount to an infringement on the part of the Defendant. Even in Hindustan Embroidery, the word 'Hemla', which was held to be an essential feature of the plaintiffs' registered

trade mark, was a coined and special word and not an ordinary word of common use.

18. Considering the fact that the existence of the word 'Dalmia' as part of the Defendant's mark, which has prima facie been associated with the Defendant's trade name and reputation built over the years, was sufficient to put the traders and purchasing public to notice of the distinctive origin of the Defendant's goods, and the fact that the word 'ultra' appears in the Defendant's trade marks in juxta-position with the word 'Dalmia' displayed prominently, there is no likelihood of anyone being deceived or any confusion ensuing in the minds of any traders or purchasing public as to the origin of the goods on account of the Defendant's use of the word 'ultra'.

19. In the premises, there is no prima facie merit in the Plaintiff's case of infringement. For the same reasons and on the basis that there is no concrete likelihood of any deception or confusion, there is no prima facie merit even in the case of passing off."

This judgment rendered by a learned Single Judge of Bombay High Court also does not help the defendant in the light of disclaimer.

45 In the aforesaid facts scenario, what now remains to be established is whether the plaintiff is in retail trade at all. In other words, whether the plaintiff's product, i.e., Dhall, is being sold in 5 Kgs bags in the retail market along side the defendant's product, i.e., Dhall in the same counters. As stated supra, serious

dispute is being raised regarding invoices produced with regard to 5 Kgs bags.

46 it is the specific and categoric case of defendant that plaintiff is not in the retail market and plaintiff is supplying in 100 kgs., 50 kgs., and 25 kgs. bags to retailers /distributors. It is also the specific case of defendant that bags which are in the nature of sacks of plaintiff do contain the mark 'Gold Winner', but sacks are opened and the product, i.e., dhall is sold in retail in news papers and other such forms which do not contain the mark. This is a matter for trial. This can be clinchingly established one way or the other only in the trial. It is the specific case of the defendant that they have reports of investigators supporting their submission. This means that the investigation reports have to be tested and investigators have to depose and they have to stand the test of cross examination. This may ultimately be another clincher in deciding the main suit as a factual finding on this aspect post trial will also have a direct impact on defendant abandoning their rectification application, as it is defendant's specific case that it so abandoned as it did not find 5 kgs. bags in the retail market. I also find that in the light of this stand, there is no answer to what impelled the defendant to file the rectification application at the first instance.

47 I have absolute clarity in my mind that the

aforesaid aspects cannot be decided in this interlocutory application which is being heard and disposed of on the basis of affidavit and counter affidavit.

48 Considering that the indisputable fact is to the effect that the plaintiff is prior user of 'Gold Winner' in Dhall, I deem it appropriate to hold that the interim order already granted by this court on 10.03.2017 (prior to notification of Commercial Division) which has been extended subsequently and which is now operating deserves to be continued for a further period of one year within which the main suit shall be disposed of as per calendar and time line drawn up and set out infra. To be noted, the interim order was originally granted on 10.3.2017 ex parte at the time of inception of the suit. Thereafter, after the defendant had entered appearance, vide order dated 17.8.2017, defendant was permitted (by consent of both parties) to dispose of the existing stocks within a period of four weeks and it is evident from a reading of the order that this order was passed to avoid deterioration of existing stocks. To be noted, this order dated 17.8.2017 also came to be passed prior to notification of the Commercial Division.

49 From the suit file placed before me, it is seen that the defendant has not filed written statement and pleadings not completed. Exercising powers of this commercial division under proviso to Section 15(4) of the Commercial Courts, Commercial Division and Commercial

Appellate Division of High Courts Act 2015 (hereinafter referred to as 'Act 4 of 2016'), 30 days time is granted to the defendant to file written statement along with all supporting documents with advance copies to the learned counsel for plaintiff. The defendant shall file the written statement within 30 days from the date of delivery of this order. Thereafter, admission and denial of documents as adumbrated in Order XI Rule 4 of Code of Civil Procedure, 1908 ('CPC' for brevity) as introduced by Section 16 Act 4 of 2016 shall be completed within a fortnight therefrom.

50 Immediately after the completion of admission and denial of documents as aforesaid, the suit shall be listed under the caption 'Case Management hearing' under Order XV-A of CPC. In other words, the suit shall be listed for 'Case Management hearing' under Order XV-A of CPC as introduced into the CPC by Act 4 of 2016, six weeks after the delivery of this order.

51 In Case Management, quick and short time lines can be drawn considering the controversy which turns on a narrow compass.

52 Though obvious, it is made clear that all views and opinions expressed in this order are only for the limited purpose of disposal of this interlocutory application and the main suit shall be heard and disposed

of uninfluenced by and untrammelled by anything that has been said in this order.

53 Owing to all that have been stated supra, I deem it appropriate to continue the interim order for a period of one year from the date on which this order is pronounced in open court. If there is serious breach of time lines, it is open to both parties to approach this court regarding continuing the interim order beyond the aforesaid one year period.

54 This application is disposed of on the above terms. No costs.

Sd/.M.S.J
20.03.2018

//Certified to be a true copy//

Dated this the day of 2018

JJ 19/04.2018 COURT OFFICER
From 25.09.2008 the Registry is issuing certified copies of the Order/Judgment Decree in this format.