

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 21.02.2018

CORAM

THE HONOURABLE MR.JUSTICE M.SUNDAR

Civil Suit No.160 of 2014
and
A.No.1742 of 2014
O.A.Nos.185 and 186 of 2014

1.Castrol Limited
Wakefield House, Pipers Way, Swindon
Wiltshire, SN3 1RE, United Kingdom
Rep by Constituted Attorney
Mr.Murlidhar Balasubramanian

2.Castrol India Limited
781-785 Rayala Towers, V Floor
Anna Salai, Chennai - 600 002
Rep by Constituted Attorney
Mr.Murlidhar Balasubramanian

...Plaintiffs

Vs.

1.Washim Khan
No.19-4-280/C/S/M/A
Shaik Complex, Ansari Road
Mirlam Tank, Hyderabad-500 052.

2.Shree Siddhi Auto Centre
S.No.11-6-380/7&14
Goods Shed Road, Nampally
Hyderabad - 500 004.

...Defendants

This Civil Suit is preferred, under Order VII Rule 1 CPC and under Order IV Rule 1 of O.S.Rules read with Sections 27, 28, 29, 134 and 135 of the Trade Marks Act, 1999 and prays for a judgment and decree; a perpetual injunction restraining the defendants by themselves, their proprietor/partners,

heirs, legal representatives, successors-in-business, assigns, servants, agents dealers, retailers, distributors, stockists, representatives, assigns or any of them from and in any manner infringing the plaintiffs' copyright in Castrol 2T oil label with distinctive colour scheme of green, red and white with black/red/white lettering, get-up, layout, artistically written words and literary, graphic and diagrammatic contents by use of New Super Fast 2T oil labels, by making a substantial reproduction thereof or an imitation thereof or in any other manner whatsoever; a perpetual injunction restraining the defendants by themselves, their proprietor/partners, heirs, legal representatives, successors-in-business, assigns, servants, agents dealers, retailers, distributors, stockists, representatives, assigns or any of them from and in any manner passing off or enabling others to pass off the defendants' lubricants, oils, greases and such other cognate/allied goods as and for plaintiffs' goods by use of label which is deceptively similar, slavish imitation and substantial reproduction of the colour scheme, get up, lay out, placement of features, positioning, arrangement of features, literary contents on the rear side and affixed in a container/packaging /label constituting the plaintiffs' exclusive trade dress in CASTROL 2T oil label and by use of identical trade dress or in any other manner whatsoever; the defendants be ordered to surrender to plaintiffs for destruction all goods, containers, cartons, labels, dyes, blocks, screen prints, cylinders and other materials bearing the marks "New Super Fast" and labels containing colour scheme similar to that of plaintiffs' CASTROL 2T oil label and /or any other variants deceptively similar to the plaintiffs marks, labels and trade dress whatsoever; the defendants be directed to pay to the plaintiffs as compensatory and punitive damages a sum of Rs.10,00,000/- in respect of acts of infringement of copyright and passing off committed by them; a preliminary decree be passed in favour of the plaintiffs directing the defendants to render account of profits made by use of the offending trade dress, imitative labels, infringing trademarks for marketing their offending products and a final decree be passed in favour of the plaintiffs for the amount of profits thus found to have been made by the

defendants after the latter have rendered accounts; for costs of the suit and pass such further or other orders as this Hon'ble Court may deem fit and necessary in the circumstances of the case and thus render justice.

For Plaintiffs : Mr.C.Karthick
For Mr.Arun C. Mohan

For Defendants : Mr.U.Karunakaran (For D2)

JUDGMENT

Mr.C.Karthick, learned counsel representing Mr.Arun C.Mohan learned counsel on record for the plaintiffs is before this Commercial Division. To be noted, there are two plaintiffs.

2. Crux and gravamen of the plaint is a complaint of infringement of copyright in label in a pouch / sachet and passing off qua trade dress. The products are automobile oils and lubricants. Before proceeding further with the merits of the matter, it is necessary to set out the trajectory of this litigation.

3. There are two defendants. First defendant is an individual and the constitution of the second defendant was not known to the plaintiffs at the time of institution of the suit. Second defendant goes by the name 'Shree Siddhi Auto Centre'.

4. Both defendants were duly served with suit summons, but both defendants did not enter appearance through counsel to resist the suit before this Commercial Division.

5. Both defendants were set *ex parte* on 14.06.2017 and the suit

recorded on 14.09.2017 by learned Additional Master II. One witness i.e., PW1 was examined and 10 Exhibits, i.e., Ex.P1 to Ex.P10, were marked. Under such circumstances, when the matter was listed before me for arguments, Mr.U.Karunakaran, learned counsel was before this Commercial Division. Learned counsel submitted that he has instructions to represent defendant No.2. Mr.U.Karunakaran very fairly submitted that defendant No.2 has nothing to do with the manufacturing and marketing of the alleged offending pouch/sachet, which is the basis for the suit of infringement of the copyright and passing off qua trade dress.

6.Learned counsel submitted that the second defendant has innocently purchased the product from the market and has used it in his small two wheeler spare parts shop. It was also submitted by the learned counsel that second defendant is willing to swear to an affidavit that he will henceforth not deal with the offending product.

7.Considering the fair submissions made, notwithstanding the said *ex parte* order dated 14.06.2017, I set aside the said order in so far as second defendant is concerned and permitted Mr.U.Karunakaran to file an affidavit to this effect.

8.I also directed the deponent to be present today, i.e., 21.02.2018. Mr.M.Nagesh, son of M.Yellaiah, who is carrying on business as sole proprietor in the name and style 'Shree Siddhi Auto Centre', is before this Commercial Division. An affidavit dated 21.02.2018 sworn by Mr.M.Nagesh, has been placed before this Commercial Division along with a

photocopy of his Aadhar Card, which is self-attested.

9.Mr.M.Nagesh, who is present in this commercial division, re-iterated the contents of the aforesaid affidavit. As I was informed that Mr.Nagesh is conversant in Telugu only, he was accompanied by his brother-in-law, whom I am informed, is a practising Lawyer in Hyderabad, whose assistance was taken for translation. The aforesaid affidavit dated 21.02.2018 along with the photocopy of the Aadhar Card is marked as Exhibit P11 series.

10.Going back to the /is, the pouch /sachet and the label therein over which, the plaintiffs claim copy right, has been marked as Ex. P10 and the same is as follows:-



11.The alleged offending pouch /sachet has been marked as Ex.P8 and the same is as follows:



12.PW1 is one Mr.Murlidhar Balasubramanian, who is the power of Attorney agent of the plaintiffs. The Special Power of Attorney, in this regard, has been marked as Ex. P1. The Board resolution, which is an extract of the Board Meeting on 13.02.2012, in this regard, has been marked as Ex. P2.

13.Plaintiffs also have a trademark registration for the word 'CASTROL' in Class 4 with regard to Oil for heating, lighting and lubricating. This is trademark No.1494.

14.To be noted, this trade mark stands in the name of C.C.Wakefield & Company Limited. This certificate has been marked as Ex.P3. Considering the scope of the *lis*, I am not going into the details of the trade mark. Suffice to say that there is a word mark over which also the plaintiffs claim rights.

15.To be noted, suit pertains to copy right infringement and passing off qua trade dress. One more product of the plaintiffs, which is not a pouch /Sachet, but a plastic container has also been marked as Ex. P5 and the same is as follows:



16.It appears that the plaintiff has been using the label continuously for its product. Plaintiffs has been using it from 1979. The details of turnover of the goods of the second plaintiff bearing the trademark CASTROL sold with the aforesaid mark/ label are articulated in paragraph No.10 of the plaint. The advertisement expenses incurred by the plaintiffs are articulated in Paragraph No.11 of the plaint. I deem it appropriate to extract paragraph Nos.10 and 11 of the same. The same is read as follows:

"10.The annual turnover of the goods sold by the 2nd plaintiff in India bearing the trademark CASTROL with the distinctive artistic work, colour combination, packaging, trade dress, get up and lay out for the following years is given below:-

Year	Approximate turnover (in crores of Rs.)
2009	26,852,300,000
2010	31,387,300,000
2011	34,392,300,000
2012	36,053,800,000

11.The plaintiffs have been advertising extensively their products through various printed media including newspapers, magazines and trade journals, leaflets and other promotional literature depicting, the said trademarks which have been extensively distributed to all the plaintiffs' dealers throughout

the country. The plaintiffs also advertises its products through electronic media which are viewed, listened by substantial number of population throughout the world. The annual expenditure incurred by the 2nd plaintiff in India on advertising and publicity of the products bearing the trademark CASTROL with the distinctive colour scheme, get-up, layout and arrangement of features for the following years is given below:-

Year	Approximate turnover (in crores of Rs.)
2009	1,494,600,000
2010	1,624,000,000
2011	1,271,100,000
2012	1,127,000,000

17.I have perused the affidavit of PW1. It is cogent and is a reiteration of the pleadings in the plaint paragraph. Notwithstanding the fact that these are *ex parte* proceedings, I have compared the aforesaid two labels i.e., Exs. P10 and P8. I have compared the aforesaid two marks keeping in mind the Parle Principle set out in the celebrated judgment of Hon'ble Supreme Court in ***Parle Products (P) Ltd. Vs. J.P. and Co., [(1972) 1 SCC 618]***. I deem it appropriate to extract paragraph 9 of the said judgment which reads as follows :

“9.It is, therefore, clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if

there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him. In this case we find that the packets are practically of the same size, the colour scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can easily be mistaken for the other. The essential features of both are that there is a girl with one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word "Gluko Biscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Anyone in our opinion who has a look at one of the packets today may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs' goods, he might easily mistake the defendants' wrapper for the plaintiffs' if shown to him some time after he had seen the plaintiffs'. After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Homes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think it necessary to refer to the decisions referred to at the bar as in our view each case will have to be judged on its own features and it would be of no use to note on how many points there was similarity and in how many others there was absence of it. "

18. In other words, I saw Ex.P10, took it away from the sweep of my eye and little later, I saw Ex.P8. I asked myself the question as to whether a man of average intelligence with imperfect recollection and ordinary prudence will be lulled into the belief that what he is seeing now (Ex.P8) is what he saw earlier (Ex.P10). I have no doubt in my mind that an emphatic yes is the answer. In the light of the aforesaid narrative, I now turn to the affidavit of the second defendant which has been marked as Ex. P11 today. Ex. P11, affidavit of the second defendant reads as follows:

"I, M.Nagesh, S/o.M.Yellaiah, aged about 51 years OCC Business, C/o.Shree Siddi Auto Centre, Nampally, Hyderabad, temporarily come down to Chennai, do hereby solemnly affirm and sincerely state as follows:-

1.I am the 2nd respondent in the above suit and hence, I am aware of the facts stated hereunder.

2.I respectfully state that the plaintiff has filed the above suit for the following reliefs:

A) perpetual injunction restraining the defendants by themselves, their proprietor/partners, heirs, legal representatives, successors in business, assigns, servants, agents, dealers, retailers, distributors, stockiest, representatives, assigns or any of them from and in any manner infringing the plaintiffs copyright in Castrol 2T oil label with distinctive color scheme of green, red and while with black/red and white lettering, getup, layout, artistically returned words and literally, graphic and diagrammatic contents by use of New Super fast 2T oil labels, by making a substantial reproduction thereof or an imitation thereof or in any other manner whatsoever.

B) perpetual injunction restraining the defendants by themselves, their proprietor/ partners, heirs, legal representatives, successors in stockiest, representatives, assigns or any of them from and in any manner pass off the defendant's lubricants, oils, greases and such other cognate/allied goods as and for plaintiffs' goods by use of label which is deceptively similar, slavish imitation and substantial reproduction of the colour scheme, get up, lay out, placement of features, positioning, arrangement of features, literary contents on the rear side and affixed in a container/packaging /label constituting the plaintiffs' exclusive trade dress in CASTROL 2T oil label and by use of identical trade dress or in any other manner whatsoever;

C) The defendants be ordered to surrender to plaintiffs for destruction all goods, containers, cartons, labels, dyes, blocks, screen prints, cylinders and other materials bearing the marks "New Super Fast" and labels containing colour scheme similar to that of plaintiffs' CASTROL 2T oil label and /or any other variants deceptively similar to the plaintiffs marks, labels and trade dress whatsoever.

D)The defendants be directed to pay to the plaintiffs as compensatory and punitive damages a sum of Rs.10,00,000/- in respect of acts of infringement of copyright and passing off committed by them.

D)A preliminary decree be passed in favour of the plaintiffs directing the defendants to render account of profits made by use of the offending trade dress, imitative labels, infringing trademarks for marketing their offending products and a final decree be passed in favour of the plaintiffs for the amount of profits thus found to have been made by the defendants after the latter have rendered accounts.

F)For costs of the suit.

3) I respectfully state that I am running a small retailer Two Wheeler Spare Parts shop at No.11-6-380/7&14, Goods Shed Road, Nampalli, Hyderabad-4. I state that I am not selling the oil with a brand viz., New Super Fast 2T oil as claimed by the plaintiff further I am not in possession of the alleged Super Fast 2T oil in my shop and in any event I hereby alleged products in my shop.

4) I respectfully state that I have no objection to grant the relief of A & B as claimed in the plaint as I am not dealing with the said alleged products. The relief of C,D,E & F may be dismissed as against me as I am not dealing with the alleged product. Further I have no objections to grant reliefs to the plaintiff as against the first defendant as claimed in the plaintiff.

It is therefore, prays that this Hon'ble Court may be pleased to record this affidavit and pass a decree in the above CS and thus render Justice."

19.In the light of the Ex. P11, affidavit from the second defendant, the plaintiffs counsel submits that the plaintiffs would give up their prayers contained in the sub-paragraphs (c),(d),(e),(f) and (g) of paragraph No.25 of the plaint against second defendant alone. To be noted paragraph No.25 of the plaint is the prayer paragraph.

20.I deem it appropriate to extract the entire paragraph No.25 of the plaint, which reads as follows:

"(a) a perpetual injunction restraining the defendants by themselves, their proprietor/partners, heirs, legal

representatives, successors-in-business, assigns, servants, agents dealers, retailers, distributors, stockists, representatives, assigns or any of them from and in any manner infringing the plaintiffs' copyright in Castrol 2T oil label with distinctive colour scheme of green, red and white with black/red/white lettering, get-up, layout, artistically written words and literary, graphic and diagrammatic contents by use of New Super Fast 2T oil labels, by making a substantial reproduction thereof or an imitation thereof or in any other manner whatsoever;

(b) a perpetual injunction restraining the defendants by themselves, their proprietor/partners, heirs, legal representatives, successors-in-business, assigns, servants, agents dealers, retailers, distributors, stockists, representatives, assigns or any of them from and in any manner passing off or enabling others to pass off the defendants' lubricants, oils, greases and such other cognate/allied goods as and for plaintiffs' goods by use of label which is deceptively similar, slavish imitation and substantial reproduction of the colour scheme, get up, lay out, placement of features, positioning, arrangement of features, literary contents on the rear side and affixed in a container/packaging /label constituting the plaintiffs' exclusive trade dress in CASTROL 2T oil label and by use of identical trade dress or in any other manner whatsoever;

(c) The defendants be ordered to surrender to plaintiffs for destruction all goods, containers, cartons, labels, dyes, blocks, screen prints, cylinders and other materials bearing the marks "New Super Fast" and labels containing colour scheme similar to that of plaintiffs' CASTROL 2T oil label and /or any other variants deceptively similar to the plaintiffs marks, labels and trade dress whatsoever;

(d) The defendants be directed to pay to the plaintiffs as compensatory and punitive damages a sum of Rs.10,00,000/- in respect of acts of infringement of copyright and passing off committed by them;

(e) A preliminary decree be passed in favour of the plaintiffs directing the defendants to render account of profits made by use of the offending trade dress, imitative labels, infringing trademarks for marketing their offending products and a final decree be passed in favour of the plaintiffs for the amount of profits thus found to have been made by the defendants after the latter have rendered accounts.

(f) For costs of the suit and

(g) Pass such further or other orders as this Hon'ble Court may deem fit and necessary in the circumstances of the case and thus render justice.

21.It is recorded that plaintiff prayers contained in sub-paragraphs (c) to (g) of paragraph No.25 of the plaint are given up and those prayers will stand dismissed as against the second defendant alone. Axiomatically there will be a decree against the second defendant with regard to the plaint paragraph No.25 (a) and (b). In other words, there will be a decree against the second defendant in terms of sub-paragraphs (a)and (b) of paragraph 25 of the plaint.

22.However, in the light of the trajectory of the litigation, which has been alluded to supra as the plaintiffs have proved their claim beyond any spec of doubt, there shall be a decree against the first defendant with regard to all limbs of the suit prayer.

23. When I say all the limbs there shall be a decree in terms of sub-paragraph (a) to (e) of paragraph 25 of the plaint.

24. With regard to costs, as the plaintiffs have been compelled to carry on their litigation for nearly half a decade to its logical end, I deem it appropriate to decree the suit as against the first defendant alone. With regard to the residuary prayer contained in sub-paragraph (g) of paragraph 25 of the plaint, as against the first defendant alone, it will be open to the plaintiffs to seek damages and to sue for appropriate relief after enforcement of the prayers pertaining to accounts and surrender of offending materials, if the damages are quantified beyond Rs.10,00,000/-.

25. To be noted sub-paragraph (d) of the plaint prayer pertains to damages is decreed as against the first defendant alone.

26. Suit is decreed with costs, against first defendant.

27. Suit is decreed against second defendant with regard to sub-paragraph (a) and (b) alone of paragraph 25 of plaint and sub-paragraph (c) to (g) of paragraph 25 have been given up as against second defendant. Consequently, connected applications are closed.

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21.02.2018

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M.SUNDAR, J.

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Civil Suit No.160 of 2014

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Dated : 21.02.2018