

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated: 01.11.2018

CORAM

THE HON'BLE MR.JUSTICE M.SUNDAR

C.S.No.4 of 2016

Ashique Exports (P) Ltd
Represented by its Manager Legal
Mr.Biju Sukumaran
Touchstone Apartments
No.10, New No.25, Vasu Street
Kilpauk, Chennai - 600 010.

..Plaintiff

Vs.

Golden Wash Enterprises
Represented by its Proprietor Mr.P.Kader
Door No SBP,1/432-P, Poothicaud
Poomala
Sultan Bathery 673 592
Wayanad District, Kerala.

.. Defendant

This Civil Suit is preferred, under Order IV Rule 1 of Madras High Court O.S. Rules read with Sections 55 and 62 of the Copyright Act, 1957 and Sections 134 & 135 of the Trade Marks Act, 1999, praying to

A) Grant permanent injunction restraining the Defendant by themselves, their servants, agents representatives or men, or anyone claiming through them from in any manner infringing the Plaintiff's copyright in the label Trade Mark "Dr.Wash" washing soap by using the similar or deceptively similar artistic work on the wrapper together with any write up or any other representation or words which are in any manner identical to and deceptively similar with the copyright of the plaintiff, on

the defendant's products "Dr.Soapz" washing soap bearing the offending trade mark with identical and/or deceptively similar colour scheme, get up and write-up, which are in any manner identical to and deceptively similar with the copyright in the work of the plaintiff's product "Dr.Wash";

B) grant permanent injunction restraining the defendant by themselves, their servants, agents representatives or men, or anyone claiming through them from in any manner passing off the defendant's washing soap "Dr.Soapz" soap bearing the offending trade mark with identical and/or deceptively similar colour scheme, get up and write-up, together with any write up or any other representation or words which are in any manner identical to and deceptively similar with the Trade Mark of the plaintiffs on the defendant's products, as and for the celebrated washing soap of the plaintiff bearing the trademark "Dr.Wash" soap, with peculiar get-up and write-up either by manufacturing or selling or offering for sale or in any manner advertising the defendant's offending product "Dr.Soapz" with its variants and deceptively similar labels and marks to the public;

C) direct the defendants to surrender to the plaintiffs the entire stock of unused offending 'Dr.Soapz' soap bars and unused wrappers together with blocks and dyes for destruction;

D) and alternatively, in the event of failure to surrender up the offending products and labels and dies, to appoint an advocate commissioner to seize wherever found the offending labels and products and their labels and dies with the mark 'Dr.Soapz' and all deceptively similar and offending labels and destroy them under report to this Honourable Court;

E) direct the defendants to render a true and faithful account of the profits earned by it through the sale of the offending bath soap bearing the offending trade mark 'Dr.Soapz' wrapper/carton and directing payment of

such profits to the plaintiffs for the passing off committed by the defendants; and

F) direct the defendant to pay to the plaintiffs the cost of the suit; and pass such further or other orders as may be deemed fit and proper in the circumstances of the case.

For Plaintiff : Mr.Perumbulavil Radhakrishnan

For Defendant : Set ex-parte

JUDGMENT

Jurisdiction of this Commercial Division qua this suit was determined on 31.01.2018 and the proceedings of this Commercial Division dated 31.01.2018 reads as follows:

'Mr.Perumbulavil Radhakrishnan, counsel on record for the sole plaintiff is before this Commercial Division. With regard to sole defendant though the sole defendant has entered appearance through a counsel, none appears. To be noted, the name of the counsel, who had entered appearance on behalf of the sole defendant has been shown in the cause list.

2. I proceeded to examine jurisdiction of this Commercial Division over this suit.

3. Learned counsel for the sole plaintiff submits that this is a suit for passing off qua trademark, for which, I am informed, Registration is pending and also infringement of copyright in the label. Learned counsel for the sole plaintiff further submits that in the light of the subject matter of this suit, particularly in the light of the prayers in the plaint, Section 134(1) of Trademarks Act, 1999 (hereinafter referred

to as 'TM Act' for brevity) and Section 62 (1) of the Copyright Act, 1957, will operate. As Section 134(1) of TM Act and Section 62(1) of the Copyright Act, 1957 operate, this Commercial Division will have jurisdiction to entertain this suit under first proviso to Section 7 of the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 (4 of 2016) (hereinafter referred to as 'Act 4 of 2016' for brevity) is his further say. It is also the further submission of learned counsel for the sole plaintiff that in the light of Section 134 (1) of TM Act and Section 62(1) of the Copyright Act, 1957, 'specified value' as set out in Section 2(1)(i) read with Section 12 of Act 4 of 2016 is of no relevance.

4. I have perused the plaint and as set out supra, I have also heard the submission of learned counsel for the sole plaintiff. After perusing the plaint averments, I am satisfied that the submissions made by the learned counsel for the sole plaintiff deserves to be accepted. I accept the aforesaid submissions and hold that this Commercial Division shall exercise jurisdiction over this suit in the light of first proviso to Section 7 of Act 4 of 2016. To be noted, this is an expression of intention to exercise jurisdiction by this Commercial Division qua this suit and the jurisdiction is otherwise inherent.

5. Now that this Commercial Division is exercising jurisdiction over this suit, I turn to the stage of the suit.

6. To be noted, there are interlocutory applications that have been taken out by the plaintiff and the sole defendant in the suit is the sole respondent therein. Sole defendant has been duly served in the interlocutory applications on 21.01.2016. The same are being disposed of by

separate orders today.

7. As far as the main suit is concerned, service of suit summons is awaited.

8. After service of suit summons, it is open to the plaintiff's counsel to mention before this Commercial Division to have the matter listed.

Adjourned sine die.'

2. A perusal of the aforesaid proceedings of this Commercial Division dated 31.10.2018, would also show the trajectory of this suit.

3. Thereafter, this Commercial Division is informed that suit summons was served on the sole defendant and as the sole defendant did not enter appearance and file written statement, suit was listed in 'UNDEFENDED BOARD' on 20.09.2018.

4. A perusal of the proceedings of this Commercial Division dated 20.09.2018 reveals that sole defendant was set *ex-parte* on the said date and proceedings of this Commercial Division dated 20.09.2018 reads as follows:

'There is a sole plaintiff and a lone defendant in this suit. This suit is listed in the 'Undefended Board' today i.e., under the caption 'UNDEFENDED BOARD'.

2. Mr.Perumbulavil Radhakrishnan, learned counsel on record for sole plaintiff is before this Commercial Division. There is no representation for defendant.

3. Though obvious (matter was listed in 'Undefended Board') it is brought to the notice of this Court that the sole defendant has not filed written statement.

4. Name of the sole defendant called out aloud thrice in open Court. No response. Sole defendant is set ex-parte.

5. List this matter before learned Additional Master-IV on 27.09.2018 for recording ex-parte evidence. Learned Additional Master-IV is requested to record ex-parte evidence preferably on the same day and in any event on or before 28.09.2018.

6. List this matter under the caption 'FOR ARGUMENTS' before this Commercial Division post ex-parte evidence on 04.10.2018.'

5. Thereafter, this suit was set down before learned Additional Master-IV for recording *ex-parte* evidence and *ex-parte* evidence was recorded. One Biju Sukumaran, who has been described as Manager-Legal of the plaintiff company has deposed as P.W.1 and as many as 45 documents i.e., Exs.P1 to P45 have been marked.

6. The details of 45 exhibits marked are as follows:

Sl.No	Exhibits	Description of Documents	Date
1	Ex.P1	Photocopy of Trade Mark-Form-1 & Addl. Repre. filed for registration plaintiff and Trademark Registry.	02.09.2002
2	Ex.P2	Copy of Trade Mark Registration Certificate from Ministry of Economics U.A.E. to plaintiff	01.04.2015

Sl.No	Exhibits	Description of Documents	Date
3	Ex.P3	Photocopy of Delivery Challan/Invoice Plaintiff to Ashique Enterprises	10.10.2002
4	Ex.P4	Photocopy of Delivery Challan/Invoice Plaintiff to Ashique Enterprises	31.10.2002
5	Ex.P5	Photocopy of Delivery Challan/Invoice Plaintiff to Ashique Enterprises	30.11.2002
6	Ex.P6	Photocopy of Delivery Challan/Invoice Plaintiff to Ashique Enterprises	12.12.2002
7	Ex.P7	Photocopy of Delivery Challan/Invoice Plaintiff to Aghin Enterprises	20.01.2004
8	Ex.P8	Photocopy of Delivery Challan/Invoice Plaintiff to Aghin Enterprises	30.01.2004
9	Ex.P9	Photocopy of Delivery Challan/Invoice Plaintiff to Aghin Enterprises	17.02.2004
10	Ex.P10	Photocopy of Delivery Challan/Invoice Plaintiff to Aghin Enterprises	26.02.2004
11	Ex.P11	Photocopy of Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	30.01.2005
12	Ex.P12	Photocopy of Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	05.10.2005
13	Ex.P13	Photocopy of Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	07.11.2005
14	Ex.P14	Photocopy of Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	03.05.2006
15	Ex.P15	Photocopy of Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	01.06.2006
16	Ex.P.16	Photocopy of Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	01.02.2007
17	Ex.P17	Photocopy of Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	01.03.2007
18	Ex.P18	Original Delivery Challan/Invoice	02.04.2008

Sl.N O	Exhibi ts	Description of Documents	Date
		Ashique Chem&Cosmetics to Aghin Enterprises	
19	Ex.P19	Original Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	03.04.2008
20	Ex.P20	Original Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	27.04.2009
21	Ex.P21	Original Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	30.04.2009
22	Ex.P22	Original Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	07.04.2010
23	Ex.P23	Original Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	30.09.2011
24	Ex.P24	Original Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	31.10.2012
25	Ex.P25	Original Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	03.04.2012
26	Ex.P26	Original Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	26.11.2011
27	Ex.P27	Original Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	01.04.2015
28	Ex.P28	Original Delivery Challan/Invoice Ashique Chem&Cosmetics to Aghin Enterprises	02.04.2015
29	Ex.P29	Photo copy of Media Bill Star & Style Film Media to AShique Enterprises	20.09.2007
30	Ex.P30	Photo copy of Media Bill SkyBird to Ashique Enterprises	30.11.2007
31	Ex.P31	Photo copy of Print Media Bill Madhyamam to Ashique Enterprises	14.12.2007

Sl.N O	Exhibit s	Description of Documents	Date
32	Ex.P32	Original Advertisement Copy June 2015 Malabar Chamber of Commerce to Plaintiff	-----
33	Ex.P33	Photo copy of Advertisement Invoice Asianet Comm.Ltd to Ashique Enterprises	28.09.2007
34	Ex.P34	Photo copy of Advertisement Invoice Asianet Comm.Ltd to Ashique Enterprises	07.12.2007
35	Ex.P35	Photo copy of Advertisement Invoice Asianet Comm.Ltd to Ashique Enterprises	25.01.2008
36	Ex.P36	Photo copy of Advertisement Invoice Asianet Comm.Ltd to Ashique Enterprises	04.02.2008
37	Ex.P37	Photo copy of Advertisement Invoice Asianet Comm.Ltd to Ashique Enterprises	08.02.2008
38	Ex.P38	Photo copy of Certified Annual Turnover Chartered account to plaintiff	2002-2015
39	Ex.P39	Photo copy of Purchase bills of Defts infringing Product Malabar Trading Co to Ptiff's Staff	04.01.2016
40	Ex.P40	Photo copy of Purchase bills of Defts infringing Product Malabar Trading Co to Ptiff's Staff	04.01.2016
41	Ex.P41	Copy of Trademark Addl. Repre. for regration Defendant's and Trade Marks Registry	09.12.2015
42	Ex.P42	Portal Extract of Company ROC to Ptiff	04.01.2016
43	Ex.P43	Extract of Board Resolution Plaintiff to Mr.Biju Sukumaran	04.01.2016
44	Ex.P44	Original Plaintiff's Label	---
45	Ex.P45	Original Defendant's Label	---

7. To be noted, Ex.P.43 is extract of the Board Resolution of the

plaintiff company (dated 04.01.2016) wherein and whereby, the aforesaid Biju Sukumaran (P.W.1) has been authorized to represent the plaintiff company in the instant suit.

8. I now proceed to examine this suit.

9. This suit is for passing off qua trademark for which, I am informed registration is pending. The trademark is 'Dr.Wash' and the product is washing soap. Registration has been sought for in class 3.

10. As far as the copyright is concerned, copyright is claimed in artistic work in the label in the wrapper in which, plaintiff's product i.e., washing soap or what is otherwise known as washing bar soap/detergent soap is sold.

11. To be noted, I am informed that plaintiff has sought for registration of trade mark of a device as depicted in the label with Dr.Wash being the prominent and dominant word mark of the device mark.

12. Plaintiff has averred that they applied for registration of trademark on 02.09.2002 vide trademark application No.1130214. It is also submitted by plaintiff that they commenced manufacturing and marketing of aforesaid product i.e, washing bar soap/detergent soap with the

aforesaid label from 2002 and the sales turnover figures that have been given by the plaintiff (as certified by a chartered accountant) is as follows:

<i>Financial Year</i>	<i>Value in MRP</i>
2002-2003	Rs.2,92,01,760/-
2003-2004	Rs.2,43,02,880/-
2004-2005	Rs.3,32,55,360/-
2005-2006	Rs.5,35,91,040/-
2006-2007	Rs.9,96,57,600/-
2007-2008	Rs.14,29,53,210/-
2008-2009	Rs.22,18,74,180/-
2009-2010	Rs.25,49,39,040/-
2010-2011	Rs.26,22,55,950/-
2011-2012	Rs.33,98,13,360/-
2012-2013	Rs.43,49,23,824/-
2013-2014	Rs.53,88,35,060/-
2014-2015	Rs.68,51,16,620/-
Total	Rs.312,07,19,884/-

13. This suit has been presented on 08.01.2016 and admitted on 12.01.2016.

14. It is the case of the plaintiff that prior to the filing of this suit, they came to know that sole defendant is passing off their products i.e., the same product (washing bar soap) in a wrapper containing a label which is deceptively similar to that of plaintiffs' wrapper/label. To be noted, plaintiff is complaining of infringement of artistic work in the copy right in

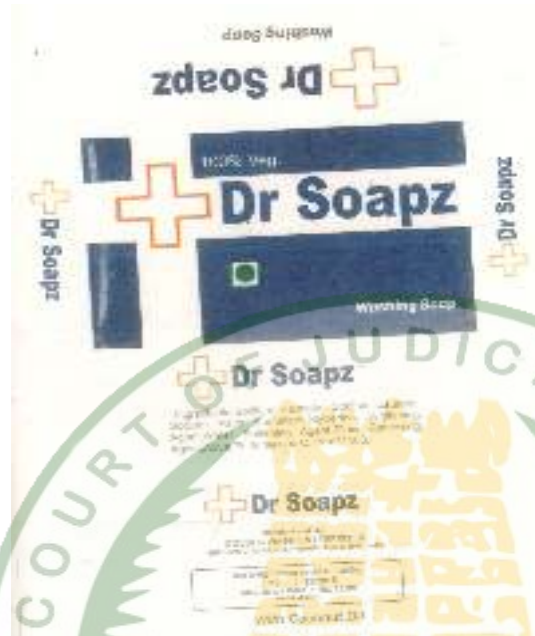
its label in the wrapper.

15. The plaintiff's label/wrapper is as follows:



16. The defendant's label/wrapper is as follows:

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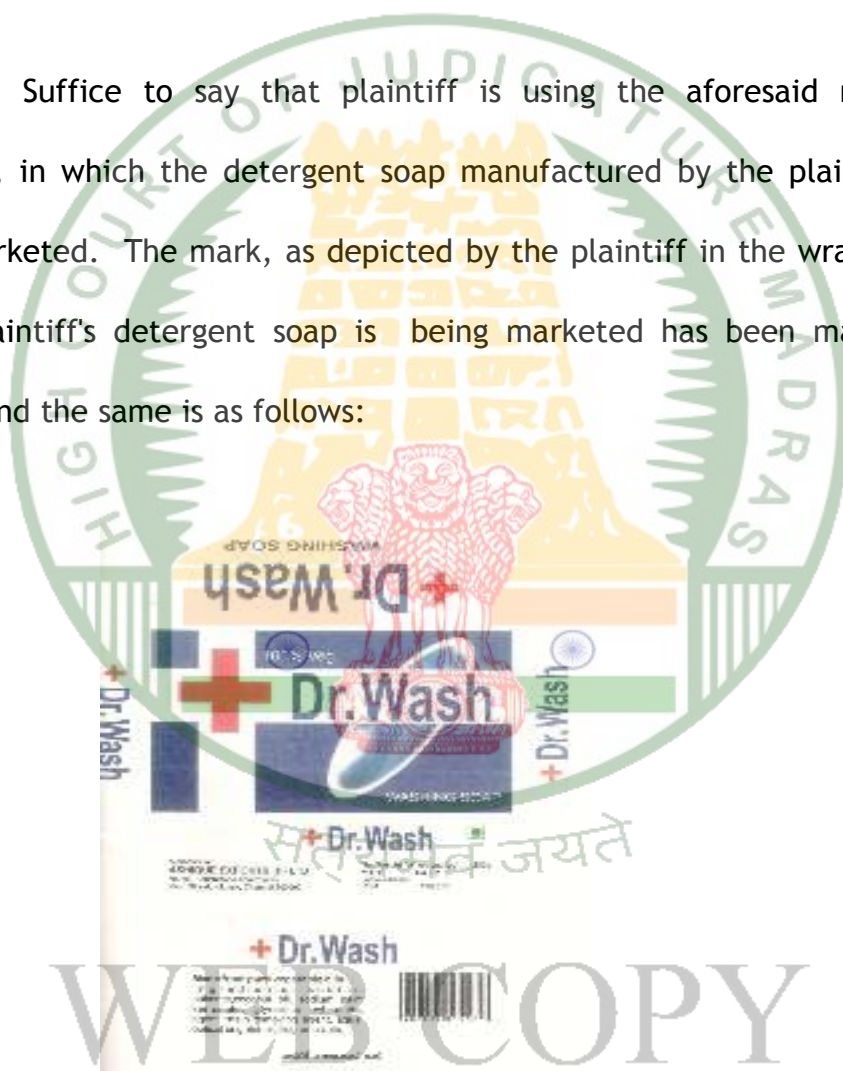


17. In the light of aforesaid pleadings in the plaint, which are reiterated by Mr.Perumbulavil Radhakrishnan, learned counsel on record for sole plaintiff before me today, I perused the deposition of P.W.1. I find that deposition is cogent and convincing. It is synchronized with plaint pleadings. It buttresses and bolsters the pleadings in the plaint.

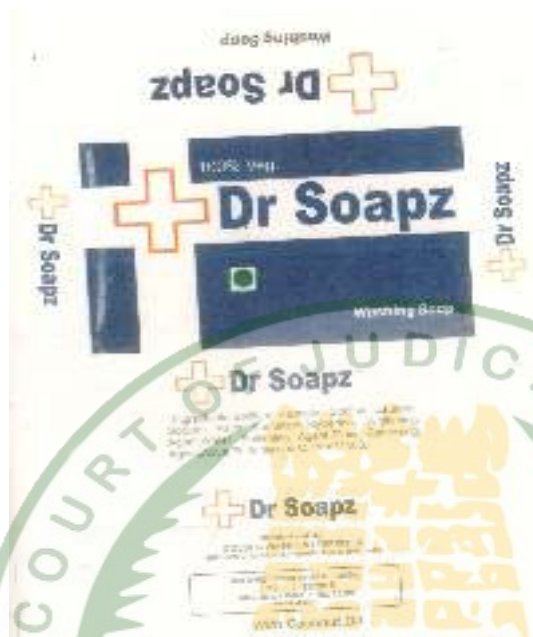
18. As mentioned supra, plaintiff has applied for trademark registration and is yet to get the mark registered and therefore, this suit has been filed for passing off qua trademark. However, with regard to copyright in the plaintiff's mark, an injunctive prayer qua infringement has been sought for.

19. Ex.P.41 is trademark registration certificate and a perusal of the same shows that plaintiff has sought for registration in Class 3 with regard to Soaps, Shampoos etc., however, as this is a suit complaining of passing off, we need not delve much into that aspect of the matter.

20. Suffice to say that plaintiff is using the aforesaid mark on wrappers, in which the detergent soap manufactured by the plaintiff are being marketed. The mark, as depicted by the plaintiff in the wrapper, in which plaintiff's detergent soap is being marketed has been marked as Ex.P.44 and the same is as follows:



21. In comparison, the alleged offending mark of the sole defendant which is also being used with regard to the same product i.e., detergent soap has been marked as Ex.P.45 and the same is as follows:



22. Adverting to the aforesaid exhibits viz., Exs.P.44 and P.45, learned counsel for plaintiff submitted that this is a clear case of copyright infringement and passing off.

23. I compared the two marks i.e., Exs.P44 and P.45 by applying the time honoured principle laid down in this regard in the celebrated judgment of Hon'ble Supreme Court in **Parle Products (P) Ltd. Vs. J.P. and Co., [(1972) 1 SCC 618]** and I am convinced that plaintiff has proved his case of infringement of copyright and passing off.

24. To be noted, Parle principle has been subsequently affirmatively referred to by the Supreme Court in **S.M.Dyechen Vs. Cadbury (India)** reported in **(2000) 5 SCC 573**.

25. Relevant paragraph in Parle judgment is paragraph No.9 and the same 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.'

26. With regard to exhibits, while Ex.P.1 is a photocopy of trademark/additional representation and that is not of much relevance, as this is a passing off suit. Ex.P.2 is a Trademark Registration Certificate obtained by the plaintiff from United Arab Emirates. Ex.P.3 to P.40 are exhibits, which are in the form of Challan, Delivery Challan and advertisement invoices to show that plaintiff has been actively using the aforesaid mark and has also been incurring expenditure for advertising and making the same popular.

27. Ex.P.42 is a portal extract of plaintiff company from the Registrar of Companies.

28. I have already alluded to Exs.P.44 and P.45, which are plaintiff's

mark and offending mark respectively. To be noted, I have extracted, scanned and reproduced the offending mark earlier in the factual matrix also. This takes us to the prayer paragraph in the plaint. Prayer paragraph in the plaint is paragraph No.29 and the same reads as follows:

'29. The plaintiff therefore prays that this Honourable Court may be pleased to pass a judgment and decree:

A) Granting permanent injunction restraining the Defendant by themselves, their servants, agents representatives or men, or anyone claiming through them from in any manner infringing the Plaintiff's copyright in the label Trade Mark "Dr.Wash" washing soap by using the similar or deceptively similar artistic work on the wrapper together with any write up or any other representation or words which are in any manner identical to and deceptively similar with the copyright of the plaintiff, on the defendant's products "Dr.Soapz" washing soap bearing the offending trade mark with identical and/or deceptively similar colour scheme, get up and write-up, which are in any manner identical to and deceptively similar with the copyright in the work of the plaintiff's product "Dr.Wash"; सत्यमेव जयते

B) granting permanent injunction restraining the defendant by themselves, their servants, agents representatives or men, or anyone claiming through them from in any manner passing off the defendant's washing soap "Dr.Soapz" soap bearing the offending trade mark with identical and/or deceptively similar colour scheme, get up and write-up, together with any write up or any other representation or words which are in any manner identical to and deceptively similar with the Trade Mark of the plaintiffs on the defendant's products, as and for the celebrated washing

soap of the plaintiff bearing the trademark "Dr.Wash" soap, with peculiar get-up and write-up either by manufacturing or selling of offering for sale or in any manner advertising the defendant's offending product "Dr.Soazp" with its variants and deceptively similar labels and marks to the public;

C) directing the defendants to surrender to the plaintiffs the entire stock of unused offending 'Dr.Soapz' soap bars and unused wrappers together with blocks and dyes for destruction;

D) and alternatively, in the event of failure to surrender up the offending products and labels and dies, to appoint an advocate commissioner to seize wherever found the offending labels and products and their labels and dies with the mark 'Dr.Soapz' and all deceptively similar and offending labels and destroy them under report to this Honourable Court;

E) directing the defendants to render a true and faithful account of the profits earned by it through the sale of the offending bath soap bearing the offending trade mark 'Dr.Soapz' wrapper/carton and directing payment of such profits to the plaintiffs for the passing off committed by the defendants; and

F) directing the defendant to pay to the plaintiffs the cost of the suit; and pass such further or other orders as may be deemed fit and proper in the circumstances of the case.'

29. A perusal of aforementioned (extracted) prayer paragraph reveals that there are six limbs of prayers. Sub-paragraphs (A) and (B) pertain to injunctive relieves pertaining to infringement of copyright and passing off

qua trademark.

30. In the light of the narrative supra, particularly in the light of my finding that plaintiff has proved its case, plaintiff is entitled to a decree with regard to sub-paragraphs (A) and (B).

31. In the light of plaintiff being entitled to a decree in terms of sub-paragraphs (A) and (B), it follows as a sequitur that plaintiff will be entitled to a decree in terms of sub-paragraphs (C), (D) and (E) also, which is for surrender of offending materials and accounts.

32. With regard to sub-paragraph (F), considering the nature of the matter and considering the fact that laboured through this suit, plaintiff is entitled to costs.

33. Sub-paragraph (F) also includes a residuary prayer viz., other orders deemed fit and proper by this Court. Under this residuary limb of the prayer, at the request of learned counsel for plaintiff, I examined the possibility of awarding compensatory costs under Section 35-A of C.P.C. as amended by said Act. Post amendment to Section 35-A of C.P.C., there is no cap/upper limit for compensatory costs. This suit has been presented in this Court on 08.01.2016. As mentioned supra, jurisdiction was determined on 31.01.2018 and defendant did not enter appearance and file written

statement, owing to which it was listed in 'UNDEFENDED BOARD' on 20.09.2018. This has compelled the plaintiff to carry this matter to its logical end over a period of about nearly three years by expending money, energy and effort. This is, notwithstanding interim orders being passed in this suit on 31.01.2018 in O.A.Nos.415 and 416 of 2016. Therefore, I deem it appropriate to impose compensatory costs of Rs.3 lakhs.

34. In the light of the narrative supra, this suit is decreed with costs and compensatory costs as articulated above.

01.11.2018

Speaking order/Non-speaking order

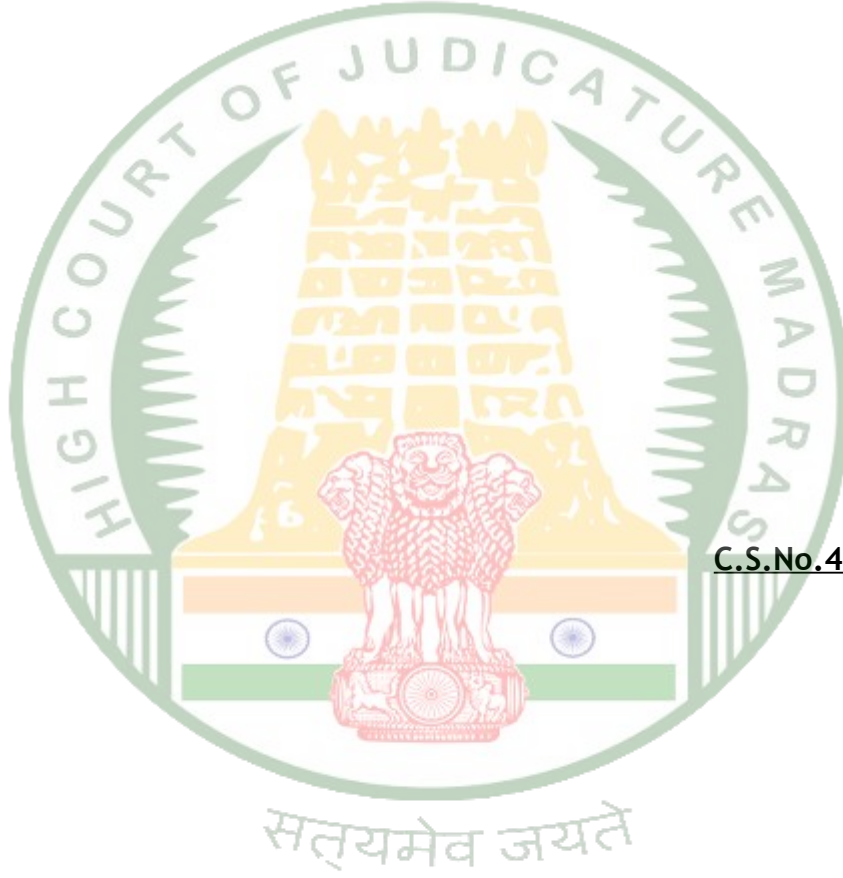
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