

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated: 21.12.2018

CORAM

THE HON'BLE MR.JUSTICE M.SUNDAR

C.S.No.390 of 2014

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A.Nos.3755 and 3757 of 2014

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O.A.Nos.465 to 468 of 2014

M/s.Kaleeswari Refinery Pvt.Ltd.,
Represented by its Director Mr.K.Ashok Kumar,
No.53, Rajasekaran Street,
Opp: Kalyani Hospital, Radhakrishnan Salai,
Mylapore, Chennai - 600 004. .. Plaintiff

Vs.

M/s.Kasthuri Traders,
Represented by its Proprietor Mr.T.V.Murugesan
4/175, Nachinampatty
Salem Main Road,
Harur, Dharmapuri District. .. Defendant

This Civil Suit is preferred, under Order IV Rule 1 of the O.S.Rules R/W. Order VII Rule 1 of Civil Procedure Code, 1908 Rules R/W Sections 134 & 135 of Trade Marks Act, 1999 R/W Sections 61 & 62 of the Copyright Act, 1957; Praying to;

i) For a permanent injunction restrain the Defendant, its men, agents, associates and/or assignees or any person claiming rights from them from infringing the Plaintiff's reputed and well known registered Trade Mark "Gold Winner" registered vide Trade Mark No.605323 dated 27/08/1993, Trade Mark No.1147963 dated 01/11/2002, and Trade Mark No.1399086

dated 16/11/2005 for Sunflower oil and Refined Sunflower oil in class 29 of the IV schedule to the Trademarks Rules 1999 by using the offending Trade Mark "Kasthuri Gold" or any other mark or work deceptively similar to the aforesaid Trade Mark of the Plaintiff's for any eligible oil marketed by the Defendant, its men, agents, associates and/or assignees or any person claiming rights from the Defendant.

ii) For a permanent injunction restraining the Defendant, its men, agents, assignee and/or associates or any person claiming rights from them from using the offending pouch/packing material bearing the offending words "Kasthuri Gold" or any other mark or word and color scheme and get up deceptively similar to that of the Plaintiff packing material/pouch used for their refined edible sunflower oil with distinct color scheme, get up with their reputed and well known trademark "Gold Winner" refined sunflower oil and other oil registered vide Trade Mark No.605323 dated 27/08/1993, Trade Mark No.1147963 dated 01/11/2002 and Trade Mark No.1399086 dated 16/11/2005.

iii) For a permanent injunction restraining the Defendant from violating the Plaintiff's Copyright registered vide Copyright Registration No.A-63205/2003 dated 17/01/2003, Copyright Registration No.A-68243/2005 dated 27/01/2005, Copyright Registration No.A-28244/2005 dated 27/01/2005, Copyright Registration No.78000/2006 dated 29/12/2006, Copyright Registration No.78004/2006 dated 29/12/2006, Copyright Registration No.78063/2007 dated 09/01/2007, in the artistic work used in the Plaintiff's packing material and for pouches for refined edible sunflower oil and other edible products bearing the reputed and well known registered Trademarks "Gold Winner" by using the offending words "Kasthuri Gold" with same color scheme, trade dress and get up in the offending pouches and packing material deceptively similar to that of the Plaintiff's colour scheme, trade dress and get up of the Plaintiff's pouches

and packing with the Trademark “Gold Winner” registered vide the above copyright registration certificates.

iv) For a permanent injunction to restrain the Defendant, its men, agents, associates and/or assignees or any person claiming rights from therein from passing-off their inferior product as that of the Plaintiff’s “Gold Winner” edible refined sunflower oil by using the offending words “Kasthuri Gold” or any other words and offending packing material and pouch deceptively similar to the plaintiff trademark “Gold Winner” and Trade dress for “Gold Winner”.

v) For preliminary decree directing the defendant to render true account of profits made by the Defendant by using the aforesaid offending label of “Kasthuri Gold”.

vi) Directing the Defendant, their men, agents, assignees, dealers and/or retailers, distributors, to surrender to the Plaintiff all offending pouch/packing material, label, advertising materials, hoarding, letter heads, office stationary and all other material containing/bearing offending mark/label “Kasthuri Gold” with distinct color scheme, trade dress, get up or any other mark visually or phonetically similar to the plaintiff’s well-known trademark “Gold Winner” label for destruction by an order of this Court;

vii) For erasure, removal or obliteration from all infringing goods, materials or articles in the possession or control of the Defendant with the offending mark/labels and pouches deceptively similar to the Plaintiff’s “Gold Winner” refined sunflower oil;

viii) to pay for the costs of the suit; and

ix) pass such further or other orders as this Hon’ble Court may deem fit and proper in the facts and circumstances of the case and thus render justice.

For Plaintiff : Mr.Sankareswaran

For Defendants : Mr.K.Sivakumar

JUDGMENT

There is a sole plaintiff and a lone defendant.

2. Mr.Sankareswaran, learned counsel representing the counsel on record for sole plaintiff and Mr.K.Sivakumar, learned counsel representing Mr.Mohamed Ibrahim Ali, counsel on record for sole defendant are before this Commercial Division.

3. Read this in conjunction with and in continuation of earlier proceedings of this Commercial Division dated 14.12.2018, which reads as follows:

'There is a sole plaintiff and a lone defendant in the suit. Mr.Sankareswaran, learned counsel representing the counsel on record for sole plaintiff and Mr.Mohamed Ibrahim Ali, learned counsel on record for sole defendant are before this Commercial Division.

2.This suit is listed today under the caption 'REPORTING SETTLEMENT AND MEMORANDUM OF COMPROMISE'.

3.Mr. Mohamed Ibrahim Ali, learned counsel submits that the defendant has been wrongly described. It is his

specific say that the individual carrying on business in the name and style 'Kasthuri Traders' at 4/175, Nachinampathy, Salem Main Road, Harur, Dharmapuri District is not Selvam Kasthuri, but it is her spouse Mr.T.V.Murugesan, (Son of Venkatachalam). Both learned counsel submit that parties have arrived at an amicable settlement and reduced the same to writing by way of a 'Memorandum of Compromise' dated 14.12.2018 ('said MOC' for brevity).

4.In the light of the aforesaid position, learned counsel for plaintiff undertakes to take out an application for amendment by Monday i.e., 17.12.2018. Be that as it may, Mr.A.Saravanan, Manager-Legal of the plaintiff company and aforesaid Mr.T.V.Murugesan, (S/o.Mr.Venkatachalam) are present in Court today and said MOC has been signed by both parties in the presence of one another.

5. As the defendant is in Dharmapuri and has travelled to Chennai only for the purpose of recording said MOC, this Commercial Division enquired with Mr.T.V.Murugesan about said MOC. Mr.T.V.Murugesan submits that he has signed the same after understanding the contents, he submits that they have stopped carrying on business with the offending mark and he requested that the main suit itself may please be disposed of by way of a compromise decree in terms of said MOC in the suit.

6. In view of the aforesaid narrative, presence of Mr.T.V.Murugesan in the ensuing listing, particularly for recording said MOC is dispensed with.

List on Monday i.e., 17.12.2018.'

4. Both learned counsel submit that necessary amendments to the plaint have since been carried out and amended plaint has also been duly served on the defendant.

5. Proceedings of this Commercial Division dated 14.12.2018, which have been extracted and reproduced supra, are reiterated today.

6. Learned counsel for plaintiff submits that legal resource of the plaintiff company is indisposed and he is unable to be present before this Commercial Division today, but points out that he was present before this Commercial Division on 14.12.2018 and seeks to dispense with his presence. Considering the nature of the proceedings on 14.12.2018, the prayer for dispense with, is acceded to.

7. Saying so, both learned counsel, on instructions, request that there be a compromise decree in the main suit itself in terms of Memorandum of Compromise dated 14.12.2018 (hereinafter 'said MOC' for brevity). To be noted, said MOC has been duly signed by both parties to the lis and their respective clients.

8. Defendant has already reiterated the contents of said MOC on 14.12.2018.

9. Said MOC reads as follows:

**'MEMORANDUM OF COMPROMISE ENTERED INTO
BETWEEN THE PLAINTIFF AND DEFENDANT**

The Plaintiff and the Defendant humbly submit as follows:

1. The plaintiff and the defendant jointly submit the present Memo of Compromise to settle the case on the terms and conditions set forth hereinafter.

2. The Plaintiff has filed the above suit against the Defendant on account of the unfair adoption of the offending trade mark "Kasthuri Gold" and deceptive imitation of Plaintiff's well known getup, trade dress and colour scheme in the market by the Defendant for marketing its inferior sunflower oil in violation of the Plaintiff's registered Trade Mark "Gold Winner" and Copyright in the artistic work in the "Gold Winner" packing material. The Plaintiff's and the Defendant's Pouches are enclosed as Annexure I & II, respectively, to this Memo of Compromise.

3. In the above suit, the Plaintiff prayed for permanent injunction to restrain the Defendant their men, agents, dealers and/or retailers, associates and/or assignees or any person claiming rights from them from infringing Plaintiff's registered Trademark, copyright and passing-off his inferior product under the name and style of the Plaintiff's registered trademark and copyright in the market together with other consequential reliefs. The Prayers in the plaint shall be read as part and parcel to the present Joint Memo of Compromise.

4. During the pendency of the above suit, the Defendant has approached the Plaintiff for an amicable settlement of the dispute without paying any damages to the Plaintiff and the

Plaintiff has also agreed to settle the dispute. Consequently, the present Memorandum of Compromise has been executed between the Plaintiff and the Defendant.

5.The Defendant hereby undertakes as follows:-

i. The Defendant admits that it is guilty of:-

a. infringing the Plaintiff's registered trademark "Gold Winner" by using the offending trademark "Kasthuri Gold";

b. infringing the Plaintiff's registered copyright by deceptively imitating the artistic work of the Plaintiff's "Gold Winner" packing material for the Defendant's inferior product which bears an identical get up, colour scheme and trade dress of the Plaintiff's above said packing material and

c. passing-off their product as that of the Plaintiff's product.

ii. The Defendant has given up the offending trademark "Kasturi Gold" and the offending pouch annexed herewith Annexure -II and undertakes not to use the same in future.

iii. The Defendant undertakes to withdraw the Trademark Applications, if any, to register the offending mark "Kasturi Gold". The Defendant undertakes to withdraw all and any copyright applications seeking to register by deceptively imitating the artistic work of the Plaintiff's "Gold Winner" packing material for the Defendant's inferior product which bears an identical get up, colour scheme and trade dress of the Plaintiff's above said packing material.

iv. The Defendant assures the plaintiff that it shall neither adopt the existing colour scheme, trade dress and/or get up of the "Gold Winner" Refined Sunflower Oil of the Plaintiff nor adopt such modified colour scheme, trade dress and get up which the Plaintiff may adopt for packing and labelling its "Gold Winner" Refined Sunflower Oil for packing or any of it's

brands, in future.

v. The Defendant undertakes to destroy all the packing materials containing the offending mark "Kasturi Gold" available in his hand as stock and also in it's unsold product.

vi. The Defendant undertakes not to adopt a trademark which is identical/similar to the Plaintiff's registered and unregistered trademarks for any of it's products and also not to imitate/copy any trade dress, colour scheme and get up which is similar/identical to any of the Plaintiff's products.

vii. The Defendant undertakes to pay the Plaintiff a sum of Rs.25,00,000/- as damages in case the Defendant violates any of the terms and conditions of this memo of compromise which the Defendant agrees is a reasonable pre-estimate of the damages that the Plaintiff is likely to suffer in case of a breach of this undertaking by the Defendant.

viii. The Defendant assures the Plaintiff that the above undertaking is not only binding on him but also on any person claiming rights through and from the Defendant.

ix. The Plaintiff gives up Prayers in Para Nos.42(v) to 42 (ix) of the plaint against the Defendant in view of the above undertaking given by the Defendant.

It is therefore prayed that this Hon'ble Court may be pleased to record the Joint Memo of Compromise and decree the suit as prayed in Para Nos.42(i) to 42(iv) of the Plaint and pass such further or other order as this Hon'ble Court may deem fit and proper in the circumstance of the case and thus render justice.'

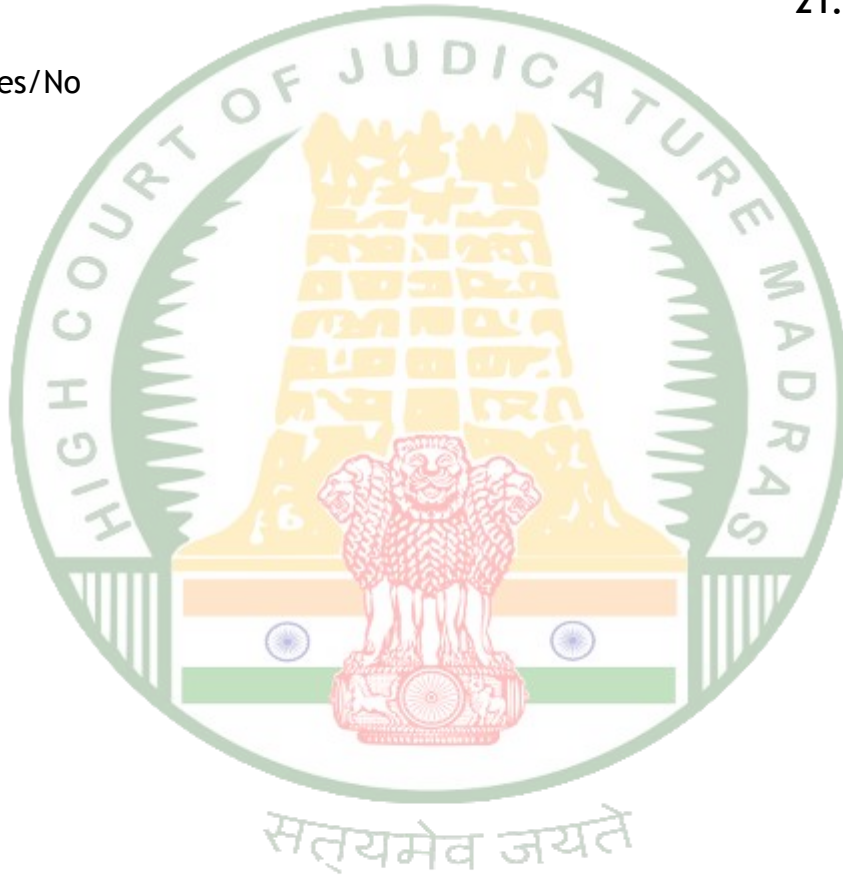
10. In the light of the narrative supra, there shall be a compromise decree in this suit in terms of said MOC. Said MOC shall form part of the compromise decree.

Suit is disposed of on above terms. There shall be no order as to costs. Consequently, connected interlocutory applications are closed.

21.12.2018

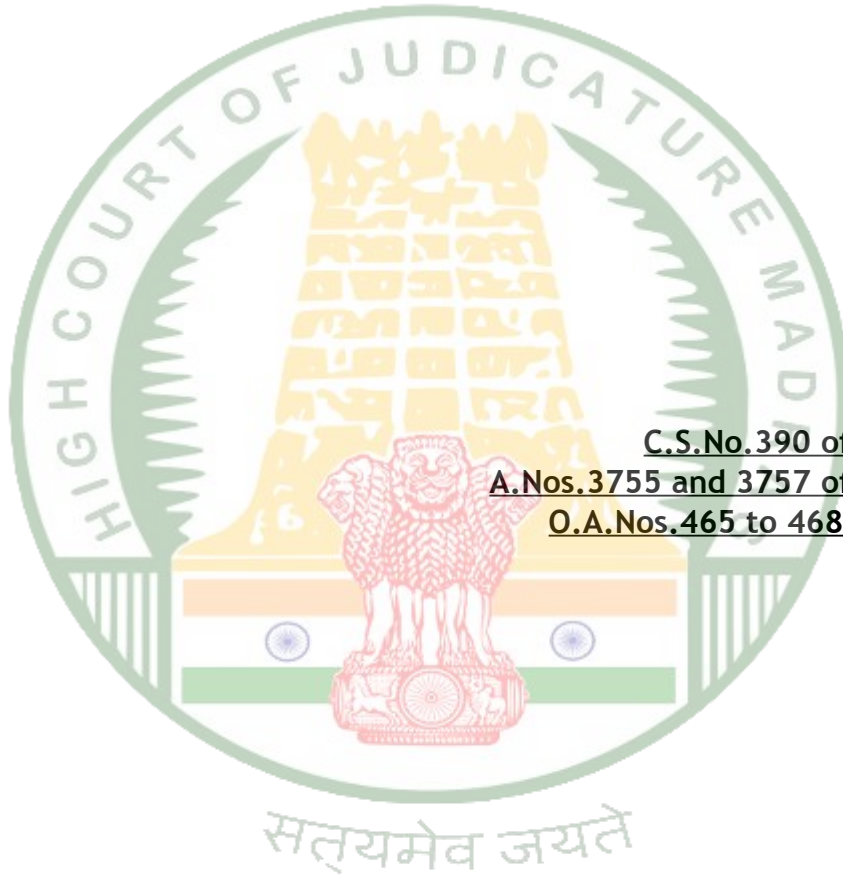
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C.S.No.390 of 2014 &
A.Nos.3755 and 3757 of 2014 &
O.A.Nos.465 to 468 of 2014

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