

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 08.07.2019

CORAM

THE HONOURABLE MR.JUSTICE KRISHNAN RAMASAMY

C.S.No.202 of 2019
and
A.No.2202 of 2019

M/s.Kaleesuware Refinery Private Limited,
Represented by its Manager (Legal)
A.Saravanan,
No.53, Rajasekaran Street,
Opp: Kalyani Hospital, Radhakrishnan Salai,
Mylapore, Chennai – 600 004. ... Plaintiff

Vs.

M/s.ABI and Co.,
Having Office at No.284,
Semmandampalayam Road,
Vellakovil – 638 111. ... Defendant

Plaint filed under Order VII Rule 1 C.P.C. read with Order IV
Rule 1 of the High Court Original Side Rules praying for:

(a) Permanent injunction to restrain the
defendant, their men, agents, associates and /or
assignees or any person claiming rights from them from
infringing the plaintiff's reputed and well known
registered Trademark "Gold Winner" by using the
offending Trademark "Gold Fresh" or any mark or word
deceptively similar to the aforesaid Trademark of the
plaintiff's for any edible oil marketed by the defendant,

their men, agents, associates and/or assignees or any person claiming rights from the defendant.

ii. 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 Fresh" edible refined sunflower oil by using the offending words "Gold Fresh" or any other words or mark and offending packing Material and pouch deceptively similar to the plaintiff's trade mark "Gold Winner" and Trade dress for "Gold Winner".

iii. Permanent injunction restraining the defendant from violating the plaintiff's registered copyright, A-68242/2005 dated 27.01.2005 in the artistic work used in the plaintiff's packing material/pouches used for packing refined edible sunflower oil and bearing its reputed registered Trademark "Gold Winner" by substituting the Trademark "Gold Winner" with the offending words "Gold Fresh" bearing same trade dress, color scheme and get up deceptively similar to that of the plaintiff's colour scheme and trade dress in the packing material/pouch bearing trade mark "Gold Winner".

iv. For preliminary decree directing the defendant to render true account of profits made by the defendant by using the aforesaid offending label of "Gold Fresh".

v. Directing the defendant, its 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 "Gold Fresh" with distinct color scheme, get up or any other mark visually or phonetically similar to the plaintiff's trademark "Gold Winner" label for destruction by an order of this Court;

vi. To pay for the costs of the suit;

For Plaintiff : Mr.Vijayan Subramanian

For Defendant : Set ex-parte
vide order dated 28.06.2019

J U D G M E N T

The suit has been filed by the plaintiff for the relief of permanent injunction and such other reliefs more fully described in the prayer portion of this judgment.

2. Learned counsel for the plaintiff has submitted that the plaintiff manufactures and packs various edible oils such as sunflower oil, groundnut oil, blended oil (olive + corn combo) etc, with its well known trademark namely "Gold Winner". The plaintiff

has filed an application for the registration of trademark for other edible products. The plaintiff is also in the business of manufacturing, marketing and selling lamp oil, agricultural products, food products, dhalls, dairy products, cosmetic products, etc. The plaintiff is the largest refined sunflower oil manufacturer in India and is ranked among the top 100 FMCG consumer brands in India, being 'Number One' in the edible oils category in South India.

3. The plaintiff has been manufacturing these products since 1993 in its factory at Vengaivasal, Kancheepuram District. The plaintiff also has its factories in Palani, Tamil Nadu and in Tumkur, Karnataka from where also the plaintiff manufactures and markets these products bearing its aforesaid well known and reputed trademark "Gold Winner". The plaintiff has appointed consignment agents in the length and breadth of the country through whom the products are distributed upto the retail market. It is submitted that Vengaivasal factory has also been certified as ISO 9001:2008, HACCP and ISO 2200:2005 Certified Company. The plaintiff adopts good manufacturing practice.

4. Learned counsel for the plaintiff has also submitted that among aforementioned various trademarks, the plaintiff is the registered proprietor of the well known trademark "Gold Winner" for Refined Sunflower Oil (RSO), certificate dated 27.08.1993 and allied goods falling under class 29 of IV Schedule to the Trade and Merchandise Rules, 1958 as amended by Trademarks Rules, 2002 vide various Trademarks since 1993. The trademarks are printed on the pouch and packing material.

5. The plaintiff also obtained various other Copyright Registrations for its products and these registrations are also valid and subsisting as on date. The details of Copyright Registrations are as follows:

Sl.No.	Date	Copyright Registration No.	Description
1	17.01.2003	A-63205/2003	Artistic work for "Gold Winner"
2	27.01.2005	A-68242/2005	Artistic work for "Gold Winner" Refined Sunflower Oil (1 ltr) label
3	27.01.2005	A-68243/2005	Artistic work for "Gold Winner" Refined Groundnut Oil (1 ltr) label
4	27.01.2005	A-68244/2005	Artistic work for "Gold Winner" Refined Groundnut

Sl.No.	Date	Copyright Registration No.	Description
			oil (15 Kg) label

6. The present dispute arises on account of unfair adoption of offending trademark "Gold Fresh" and deceptive limitation of plaintiff's Trademark "Gold" with the same font, label, getup, trade dress and colour scheme by the defendant for packing and marketing their inferior sunflower oil with the aforesaid offending trademark and trade dress in violation of the plaintiff's registered trademark, and registered copyrith (A-68242/2005 dated 27.01.2005) in the artistic work in "Gold Winner" pouch, cover and other packing and by passing-off. The plaintiff is the prior user of the trademark "Gold Winner" along with the font and color getup and the plaintiff is the long and continuous user of the said mark without any interruption and the plaintiff is prima facie entitled to passing off relief also.

7. The offensive use of the getup, colour scheme and trade dress of the packet and the unit container by the defendant ought to be restrained by an order of the Court. The plaintiff is thus, entitled

for the relief as prayed for. The plaintiff is unable to quantify the damages it has suffered and therefore reserves its right to initiate separate suit for damages on ascertaining the actual damage suffered by it and the profit made by the defendant or in the alternative undertakes to pay appropriate court fee once the extent of damage is known.

8. Learned counsel for the plaintiff has also submitted that cause of action arises within the jurisdiction of this Hon'ble Court as the plaintiff has its corporate office located within the jurisdiction of this Hon'ble Court in the city of Chennai. When the Trademark Application No.605323 was filed and certificate issued to the plaintiff on 27.08.1993, when the plaintiff Trademark "Gold Winner" Sunflower Oil, having Trademark No.1147963 was registered on 01.11.2002 and subsequently when the mark was renewed till 01.11.2022 and when the plaintiff's Copyright for the pouch with "Gold Winner" was registered under, A-68242/2005 on 27.01.2005. This Hon'ble Court has jurisdiction over the dispute in as much as the plaintiff has its corporate office in Mylapore, Chennai in terms of Section 62 of the Copyright Act, 1957 and in terms of Section 134(2) of the Trademark Act, 1999 as the proprietor of trademark

and copyright, it is entitled to initiate proceedings before this Hon'ble Court. The present suit is being filed within limitation. The cause of action arose on various dates, during September, 2018 when the plaintiff came to know that the defendant is trading in "Gold Fresh" refined sunflower oil with the offending name and label and continues as on date.

9. The learned counsel for the plaintiff submits that the annual turnover for the last three years are as follows:-

Sales Detail of Applicant (in Crores)			
Year	Sales	Advt. & Promotional Expenses	% (Percentage)
2014-15	2345.85	64.57	2.75
2015-16	2223.46	63.96	2.88
2016-17	2230.00	70.24	3.15

10. Learned counsel for the plaintiff further submitted that they have incurred considerable expenses towards the advertisement expenses. Therefore, the learned counsel for the plaintiff submits that the word "Gold Winner" is descriptive in nature and they have obtained trademark right over the same in relation to their business for a period from 1993 and at present they are making turnover of a sum of Rs.2,200 crores. Therefore, no doubt

that they have distinctness of the name "Gold Winner" and they are entitled for the right to use the said trademark. By virtue of Exs.P3 to P5 are as follows:-

Ex.P3 is the photocopy of Extract from the Register of Copyright bearing Registration No.A-68242/2005 of the plaintiff for "Gold Winner" dated 27.01.2005.

Ex.P4 is the photocopy of trademark Registration Certificate issued by Registrar of trademark Singapore for trademark No.T05/03792F in favour of plaintiff dated 23.03.2005.

Ex.P5 is the photocopy of Legal Usage Certificate dated 02.03.2018.

11. Without any other opinion, the plaintiff filed the present suit restraining the defendant from infringing the plaintiff's trademark and copying "Gold Winner". Subsequently, after the admission of the suit, the suit summons was served on the sole defendant on 15.04.2019. In spite of the service of the suit summons, the defendant failed to appear before this Court. Therefore, the sole defendant was set ex-parte vide order dated 28.06.2019 and the suit was directed to be placed before the learned Additional Master for recording ex-parte evidence. Before

the learned Additional Master, on behalf of the plaintiff one Mr.A.Saravanan, Manager – Legal, was examined as P.W.1 and Exs.P1 to P9 were marked.

12. It has already been set out supra that as many as 8 exhibits, namely Exs.P1 to P8 have been marked and the details of the 8 exhibits are as follows:

Sl. No.	Exhibits	Description	Dated
1	Ex.P1	Photocopy of trademark Registration Certificate for plaintiff's "Gold Winner" Sunflower Oil having trademark No.605323.	27.08.1993
2	Ex.P2	Photocopy of trademark Registration Certificate for plaintiff's "Gold Winner" Sunflower Oil having trademark No.605323.	01.11.2002
3	Ex.P3	Photocopy of Extract from the Register of Copyright bearing Registration No.A-68242/2005 of the plaintiff for "Gold Winner".	27.01.2005
4	Ex.P4	Photocopy of trademark Registration Certificate issued by Registrar of trademark Singapore for trademark No.T05/03792F in favour of plaintiff.	23.03.2005
5	Ex.P5	Photocopy of Legal Usage Certificate.	02.03.2018
6	Ex.P6	Photocopy of Legal Notice issued by plaintiff to defendant.	03.10.2018
7	Ex.P7	The photocopy of reply notice issued by defendant to plaintiff.	
8	Ex.P8	The photocopy of Comparison Table showing "GOLD FRESH" Pouch and "GOLD WINNER" Pouch.	
9	Ex.P9	The photocopy of the Board Resolution passed by the plaintiff.	06.07.2018

13. Heard the learned counsel for the plaintiff and also gone

through the averments in the plaint and the proof affidavit and also perused the Exs.P.1 to P.9.

14. On a perusal of the documents, this Court found that trademark of the plaintiff namely "Gold Winner" got registered through Ex.P1 and also it was registered with the Copyright Board by order dated 27.01.2005, which is marked as Ex.P3. The plaintiff has also obtained legal usage certificate, which is marked as Ex.P5. This Court also compared the pouches of both the plaintiff's and the defendant's product, which has been filed at page No.14 of the typed set of papers, which is marked as Ex.P8. On comparison, it is clearly seen that the defendant has imitated not only the plaintiff's trademark but also copying the same trade dress, color scheme and get up.

15. It is made clear that the plaintiff is the registered owner of the trademark "Gold Winner" and the word "Gold Winner" is descriptive in nature and it is associated with the plaintiff product. In view of the exclusive right to use the word, "Gold Winner" by the plaintiff, the adoption of the mark, "Gold Fresh", by the defendant is clearly amounts to infringement of trademark of the plaintiff.

Further, on comparison of Ex.P8, it is seen that the defendant is not only copying the trademark of the plaintiff 'GOLD WINNER' but also copying the same trade dress, color scheme and get up. Therefore, this Court found that the defendant's copying the plaintiff's trademark 'GOLD WINNER' will amount to infringement of the trademark, as stated in Section 29 of the Trademarks Act. Accordingly, the plaintiff proved the claim. Therefore, the plaintiff is entitled to the decree as prayed for. Hence, the plaintiff is entitled to the decree prayed for.

16. Learned counsel for plaintiff requests this Commercial Division to consider imposing compensatory costs/exemplary costs on defendant in the light of conduct of the defendant which has been referred to supra. Reference to Section 35-A 'The Code of Civil Procedure, 1908' ('C.P.C.' for brevity) as amended by 'The Commercial Courts Act, 2015' ('said Act' for brevity) was also made. Section 35-A provides for compensatory costs in respect of false or vexatious defences. In the considered view of this Commercial Division will qualify as a vexatious defence (within the meaning of Section 35-A of amended CPC as amended by said Act) as it is a vexatious manner of defending a suit. Be that as it may, in the light

of the trajectory and in the light of the defendant's approach to this suit, this Commercial Division is convinced that it is appropriate to impose compensatory costs of Rs.5 lakh (Rupees Five Lakh only) on the defendant.

17. Plaintiff will obviously be entitled to costs as the plaintiff has incurred substantial expenditure in carrying this suit to its logical end.

18. Suit is decreed with costs and compensatory costs as set out supra. Consequently, connected application is closed.

AT

08.07.2019

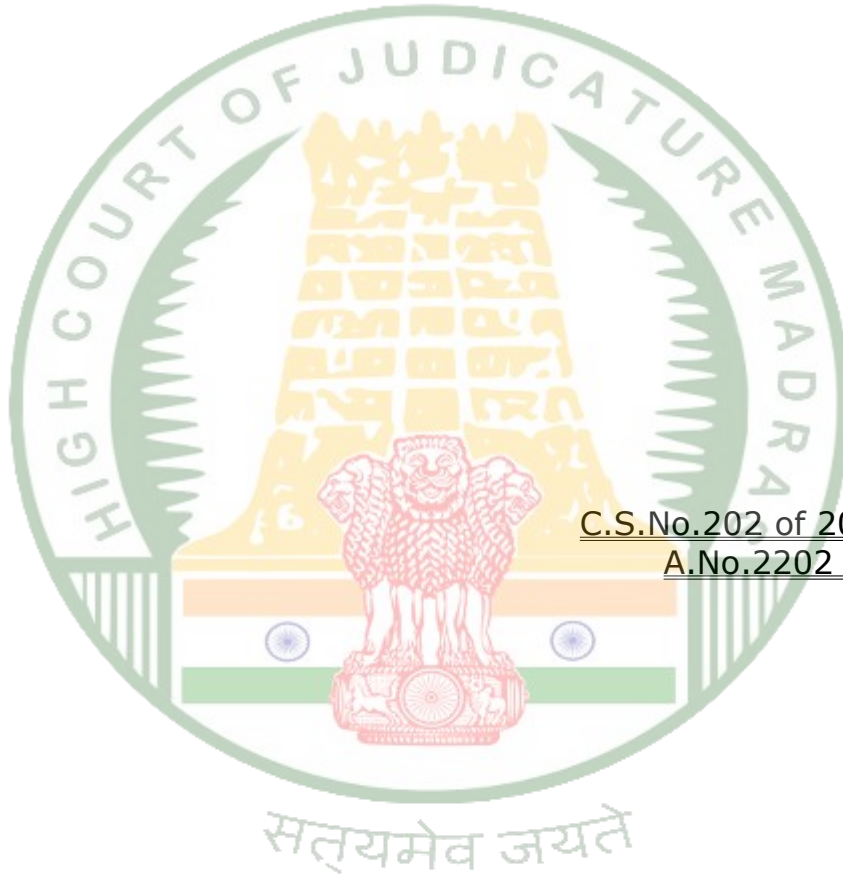
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KRISHNAN RAMASAMY,J.

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