

IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON: 07.10.2020

PRONOUNCED ON: 4.11.2020

CORAM:

THE HONOURABLE MR.JUSTICE C.V.KARTHIKEYAN

C.S.No. 643 of 2012

Ashique Exports (P) Ltd.,
Represented by its Managing Director,
Mr.P.C. Thahir
“Thai Enclave”
No.57, West Madha Church Road
Royapuram, Chennai – 600 013
... Plaintiff

Vs

1. Suresh K.K.
Trading as M/s. Shastha Industries
Pattimattom P.O., Kizhakkambalam,
Ernakulam, Pin – 683 562,
Kerala.
2. S & B Industries
Represented by its Proprietor,
Suresh K.K.,
Kanninadu – 682 310,
Ernakulam, Kerala
3. Sastha Traders
Represented by its Proprietor, Suresh K.K.,
Pattimattom P.O., Kizhakkambalam,
Ernakulam, Pin – 683 562,
Kerala

Defendants

PRAYER:- This Civil Suit is filed under Order IV Rule 1 of Original Side Rules read with Sections 134 & 135 of Trade Marks Act, 1999 praying for the following reliefs:

(a) granting permanent injunction restraining the defendants by themselves, their servants or agents or anyone claiming through them from in any manner infringing the plaintiff's Trade Mark "SUPER WASH" and "Super Wash – 555" Washing Soap by using the similar or deceptively similar Trade Mark 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 Trade Mark of the plaintiffs on the defendant's products;

(b) granting permanent injunction restraining the defendants by themselves, their servants or agents or anyone claiming through them from in any manner passing off the defendant's washing soap "Super Wash" Washing Soap bearing the offending trade mark with identical and/or deceptively similar colour scheme, get up and write up as and for the celebrated washing soap of the plaintiff bearing the trade mark "Super Wash -555" Washing 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 'Super Wash' to the public;

(c) directing the defendants to surrender to the plaintiff the entire stock of unused offending 'Super Wash' washing soap wrappers together with blocks and dyes for destruction;

(d) 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 'Super Wash' wrapper/carton and directing payment of such profits to the plaintiffs for the infringement and passing off committed by the defendants; and

(e) directing to the defendant to pay the plaintiff the costs of the suit.

For Plaintiff : Mr. Perumbulavil Radhakrishnan

For DD 1 to 3 : Ms. Subha Shiny for
Mr. Raveekumar

JUDGEMENT

The plaintiff M/s. Ashique Exports (P) Ltd., a company incorporated

under the Companies Act 1956 has filed the suit seeking a Judgment and Decree for permanent injunction against the defendants, Suresh K.K., Trading as M/s. Shastha Industries, Ernakulam, Kerala and S&B Industries, represented by its Proprietor Suresh K.K., at Ernakulam, Kerala and Sastha Traders, represented by its Proprietor Suresh K.K., Ernakulam, Kerala, from infringing the trademark of the plaintiff “SUPER WASH” and “Super Wash – 555”, Washing Soap by using a similar and deceptively similar Trademark and for permanent injunction from passing off the products of the defendants Washing Soap 'Super Wash' as if they are the products of the plaintiff and for consequential reliefs and for costs.

2. In the plaint, it had been stated that the plaintiff is a company manufacturing and marketing, among other products, soaps and detergents for several years and had adopted the word “Super Wash – 555” in respect of Washing Soaps manufactured and marketed by them. They had also applied for registration of the Trademark “Super Wash – 555” on 24.03.1997 and Trademark Application No. 749397 had been allocated by the Trademark Registry. The mark was registered by certificate dated 28.03.2008 with effect from 24.03.1997. They also, in the course of their business, adopted the Trademark “Super Wash – 555 Premium Bar Soap”

and commenced manufacturing and marketing the same from 01.01.1997. It had been stated in the plaint that the plaintiff had earned enormous goodwill and reputation. The turnover of the plaintiff in the financial year 2011-2012 was Rs.77,15,673/-. The plaintiff had occasion to approach this Court earlier to protect its Trademark and had filed C.S.No. 665 of 2008. It had been further stated in the plaint that the defendants had commenced using an identical soap wrapper consisting of the words 'Super Wash'. It is stated that the wrapper of the defendants is very identical to that of the plaintiff. It had been stated that the defendants have marketed their washing soap under the very same name 'Super Wash'.

3. In the plaint, it had been stated that the first defendant K.K.Suresh was the proprietor of the three defendants and had commenced marketing the products with intention to encroach the goodwill and reputation built by the plaintiff. It was under these circumstances that the suit had been filed seeking the reliefs stated above.

4. In the written statement filed on behalf of the three defendants, it had been stated that the defendants have been manufacturing their product Washing Soap right from 03.12.1997 even prior to the plaintiff. It had

been stated that they are handmade soaps and have built goodwill and reputation among the general public and customers. The allegation of the plaintiff regarding their reputation and goodwill had been denied. The allegation of the plaintiff that they have been in the market for a considerable period of years was also be denied. The defendants claimed that they have been using the mark 'Super Wash' honestly since the defendants had coined the said name for their products. It was stated that the defendants had filed an application for registration of the Trademark in A.No. 1540966. It was stated that since the defendants had applied for registration, they are entitled to use the letters TM within a circle. The defendants denied that they have played a fraud by using the said letters, TM within a circle, even though the mark had not been registered. The defendants denied each and every allegation in the plaint and stated that the suit should be dismissed.

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5. On the basis of the above pleadings, the following issues were framed for trial:-

“1. Whether the plaintiff is prior user of the trademark 'Super Wash – 555' ?;

2. Whether the defendants are passing off the product of the defendants as that of the plaintiff?

3. Whether the plaintiff is entitled to the relief as prayed for?; and

4. To what other reliefs the plaintiff is entitled to?”

6. The parties were then invited to adduce evidence. The plaintiff examined as PW-1 Biju S. Vaidyar, Executive – Legal of the plaintiff company and also marked Exs. P1 to P28. These documents included Ex.P2, the copies of the Trademark Form for registration dated 24.03.1997 Exs. P3 to P19, copies delivery challans / invoices for the years 1997, 1998, 1999, 2000 onwards Exs. 21, the Trademark certificate dated 12.03.2008 Ex.P2o, the annual turn over which had been certified for the year 1997-2012 Exs.P25 & P26, the purchase bills of the defendants' products Exs. P23 & 24; the Trademark application and print outs of E-Register extract of the application of the defendants Ex. P27, the extract of

the plaintiff's label Ex.P28 and the defendants' label (four numbers).

7. The defendants examined as DW.1 K.K.Suresh, the first defendant and proprietor of the second and third defendants. During his examination, he marked Exs. D1 to D9. Ex.D1 is the additional provisional registration certificate dated 24.08.1998; Exs.D4 and D5 are the purchase orders placed on the defendants and Ex.D9 was the sale tax returns filed by the defendants.

8. Heard arguments advanced by Mr.Perumbulavil Radhakrishnan, learned counsel for the plaintiff and Ms. Subha Shiny, learned counsel representing M/s.S. Raveekumar and E.Maharajan, the learned counsel for the defendants.

9. Mr.Perumbulavil Radhakrishnan, learned counsel for the plaintiff stated that the plaintiff had commenced manufacturing of their washing soap under the name 'Super Wash – 555' from 01.01.1997 and had also obtained a Trademark registration for the same with effect from

24.03.1997. The learned counsel stated that the wrapper for the product

'Super Wash – 555' had a distinct getup of colour scheme and artificial work. They had also widely advertised their mark in various Newspapers and advertising mediums. He stated that they had also earned enormous goodwill. The plaintiff had also filed C.S.No. 665 of 2008 against Oriental Extractions (P) Ltd, to protect their registered Trademark. The learned counsel stated that the defendants had commenced using an identical soap wrapper with the name 'Super Wash' in the year 2012. The learned counsel stated that though the mark of the defendant is not registered, they had been using the name TM within a circle to project as if their mark is registered. He stated that since the defendants are a later entrant into the market, they had copied the mark of the plaintiff 'Super Wash' with an intention to infringe the Trademark of the plaintiff and to gain the reputation and goodwill of the plaintiff. The learned counsel therefore stated that the suit should be decreed since the plaintiff's mark is registered; whereas the defendants' mark is not registered and since the plaintiff is the prior user whereas the defendants are a later entrant into the market. The learned counsel also stated that the plaintiff's mark had been copied by the defendants by using the name 'Super Wash' for their identical washing soap products. The learned counsel therefore stated that there was every possibility of there being a confusion among the purchasers as to the

identity of the products purchased and stated that the loss and hardship suffered by the plaintiff would far out weight any consideration shown by the defendants. The learned counsel therefore stated that the suit should be decreed as prayed for with costs.

10. Ms. Subha Shiny, learned counsel for the defendants on the other hand pointed out that the exhibits marked on behalf of the plaintiff and stated that all of them were Xerox copies and they have all been marked subject to objections raised by the defendants. The learned counsel stated that permission to mark secondary evidence had not been obtained from the Court and in the absence of any explanation as to why the originals were not produced, the documents, though marked, cannot be looked into by the Court since they were inadmissible in law. The learned counsel also stated that the plaintiff had also not produced the original registration certificate or even a certified copy. The plaintiff had also not produced the renewal certificate. It was stated that the Trademark Registry had stipulated a disclaimer for the words 'Super' and 'Wash'. It was therefore stated that the plaintiff having failed to prove their facts by adducing admissible documentary evidence should suffer an order of dismissal of the suit.

Issue No.1:

11. This issue is whether the plaintiff is a prior user of the Trademark 'Super Wash – 555'.

12. In the plaint, it had been very specifically stated that the plaintiff had applied for registration of the Trademark 'Super Wash – 555' on 24.03.1997 in Trademark application No. 749397. Thereafter the plaintiff also had the benefit of their mark being registered by a certificate being issued on 28.03.2008 which was with effect from 24.03.1997. In order to establish that they have been in the market from the year 1997, the plaintiff had produced Delivery Challans/invoices. The xerox copies of these Delivery Challans have been marked as Exs. P2 to P26. The learned counsel for the defendants however urged that this Court cannot examine any of the exhibits since they are xerox copies and had been marked with objections. The learned counsel stated that there was absence of explanation as to why the primary evidence had not been produced as documents before the Court. When the documents were marked, they were marked subject to the objections raised by the learned counsel for the

defendants.

13. A perusal of the documents which were marked do not indicate the nature of objections raised at the time of marketing. Documents were simply marked by giving exhibits numbers and they were taken on file. While recording evidence and while marking the documents, namely, Exs. P2 to P28. It had been noted as follows:-

“All the xerox documents are marked subject to the objection raised by the learned counsel for the defendant.”

14. Thus all the xerox documents had been marked subject to the objections raised by the learned counsel for the defendants. Very unfortunately, the nature of objection had not been noted down. It is not clear whether the objections were with respect to the fact that xerox copies of the documents were marked as Exhibits or with respect to the relevancy of the documents or with respect to the nature of proof of the documents. It

is also not known whether the objections were on the basis that the xerox copies had been fraudulently prepared and were not exact copies of the originals.

15. During cross examination of PW-1, not even one question had been put that the documents are in admissible since xerox copies had been marked. In his proof affidavit, PW-1 had stated that they have been in the business from 01.01.1997. When questioned regarding this particular date, PW-1 answered as follows:-

“I have not filed articles of Association and Memorandum of Association to show as to when our company was incorporated. It was incorporated in the year 1980. In my plaint, I have stated 01.01.1997 on which my company has started manufacturing of this soap. I have not filed any document to show that our company has manufactured the soap on 01.01.1997. But I have produced the Bill pertaining to 24.12.1997.”

16. The witness was never questioned regarding the nature of the

documents filed. Suggestion was also not put to him that the xerox copies which had been marked are inadmissible in evidence. However, the fact remains that the Trademark of the plaintiff has been registered has not been established by producing legally admissible document. The fact that the defendants have been marketing a similar product namely, washing soap under a similar name, namely, 'Super Wash' can only be inferred.

17. Among the documents filed by the defendants, the earliest document filed by them was dated 24.08.1998, Ex.D1 which is the additional provisional Registration Certificate issued by the Small Scale Industry. The learned counsel for the defendants placed reliance on **(2010) 8 SCC 423 [Shalimar Chemical Works Ltd., Vs. Surendra Oil and Dal Mills (Refiners) & Ors.]**, wherein the Hon'ble Supreme Court had observed as follows in a similar situation wherein xerox copies of documents were marked:-

“On a careful consideration of the whole matter, we feel that serious mistakes were committed in the case at all stages. The trial court should not have "marked" as exhibits the Xerox copies of the certificates of registration

of trade mark in face of the objection raised by the defendants. It should have declined to take them on record as evidence and left the plaintiff to support its case by whatever means it proposed rather than leaving the issue of admissibility of those copies open and hanging, by marking them as exhibits subject to objection of proof and admissibility. The appellant, therefore, had a legitimate grievance in appeal about the way the trial proceeded. ”

18. The Hon'ble Supreme Court had very categorically stated that xerox copies of the documents should not have been taken on record as evidence.

19. The witness for the plaintiff had also not given any explanation as to what happened to the original documents and why the originals were not produced for being marked before the Court or atleast for being compared with the copies marked. When the documents filed by the plaintiff are taken away from consideration, the only fact which remains is the averment that the plaintiff has a registration with effect from 24.03.1997. That averment has not been proved in manner known to law

since the original Registration Certificate or even the Legal Usage Certificate have not been produced.

20. On the other hand, the defendants have produced original documents, Ex.D1 is the additional Provisional Registration Certificate issued by the Assistant District Industries Officer for M/s. Sastha Group, V.P. This is dated 24.08.1998. This was for manufacture for Washing Soap. Ex.D2 is the original copy of the bill book for which the earliest date is 21.01.1998 for purchase of 'Super Wash' by M/s. Sree Krishna Agencies, Thodupuzha, for a sum of Rs.3,000/-. The defendants have also produced Ex.D6, an order placed by the Kerala State Civil Supplies Corporation in June 1998 in original for purchase of 'Super Wash' soap. It is thus seen that the defendants have also been in the market atleast from the year 1998.

21. The defining aspect is that the plaintiff has produced only xerox copies of documents; whereas the defendants have produced original documents. Xerox copies are secondary evidence and are admissible in evidence or if only the originals are produced atleast for the sake of comparison or atleast unless explanation is given as to what happened to the originals. The plaintiff for the reason best known to them have not

chosen to adopt any of the said procedures. The learned counsel for the plaintiff had stated that since the documents have been marked and there being no issue with respect to denial of registration, the documents should be taken into consideration. Unfortunately, issue has also not been framed on the basis of registration. As stated the issue itself had been framed regarding determination of the prior user of the product 'Super Wash'. The defendants have established by documentary evidence their usage of the mark 'Super Wash'.

22. It is also seen from the records that the suit had been instituted on 30.10.2013. The Court had not granted any order of interim injunction from the year 2013. The plaintiff and the defendants have been continuing to do their business atleast for the past seven years. During the cross examination of the witness for the defendant, he had reiterated that they are manufacturing soap under the name 'Super Wash' honestly and with bona fide intention.

23. The present case is a perfect illustration of a trial being conducted without adhering to the rules on evidence. The plaintiff has produced xerox copies of documents. They are in admissible. The defendants have done slightly better. It is trite to point out that the

plaintiff will have to stand on their legs and prove their case. The plaintiff has not proved, in manner known to law, that they are the prior user. It may be common knowledge that they have a registration and that the registration was in effect from 24.03.1997. However, admissible proof is required to establish that fact. The plaintiff had failed to produce admissible evidence.

24. In view of that, I have no other alternate but to hold the issue against the plaintiff.

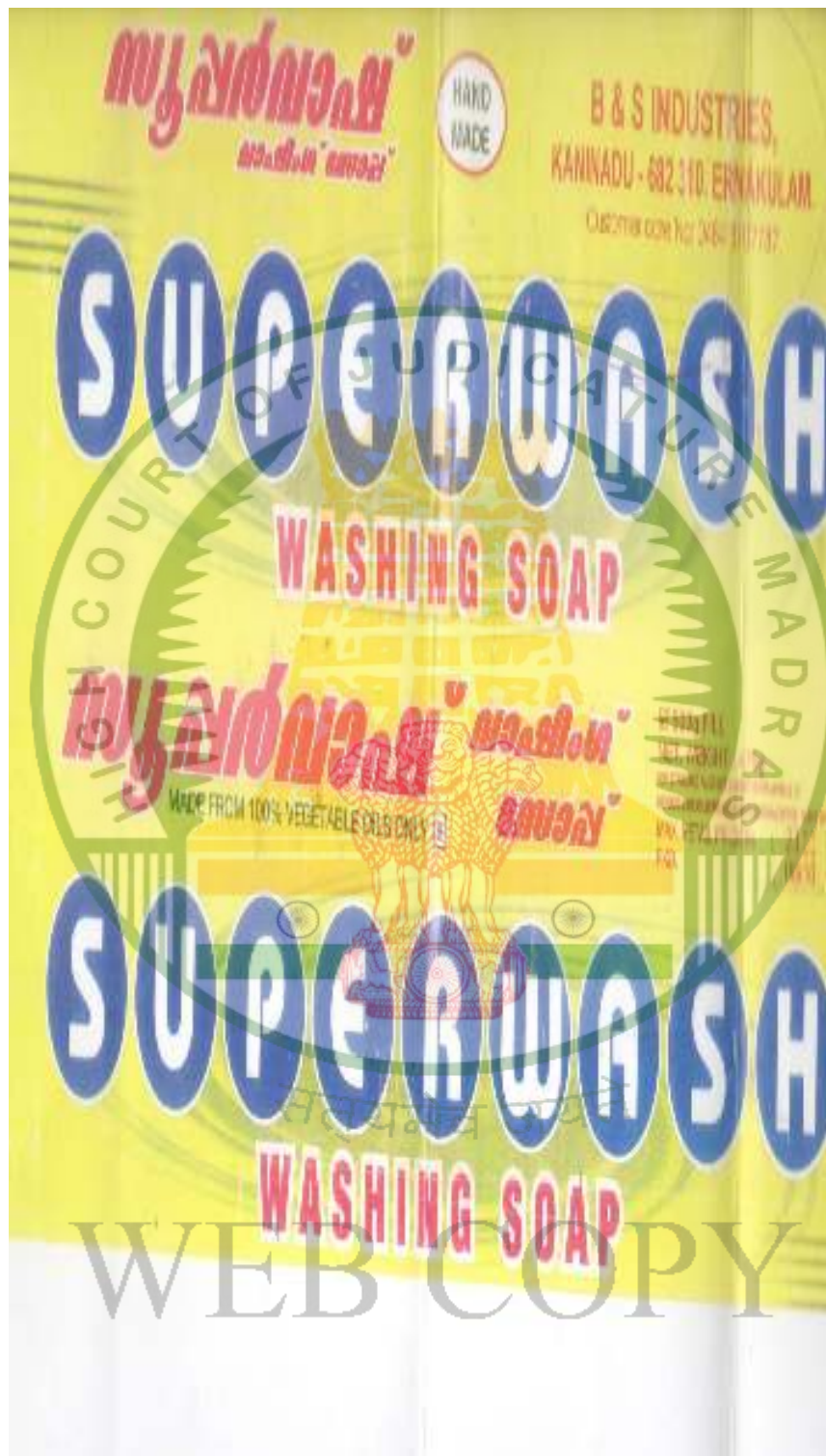
Issue No.2:-

25. The plaintiff had produced as Ex.P26 their original wrappers. A pictorial representation is given below:-

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26. The wrapper of the defendants marked as Ex.27 series are given below:-







27. It is seen that the defendants are using the very same word 'Super Wash'. As a matter of fact, the defendants are using the word 'Super Wash' with the letters TM inside a circle. The witness for the defendant had very categorically stated that they do not have any registration of the mark 'Super Wash'. During cross examination, he stated as follows:-

“I have written TM in a circle in all my documents in Ex.P28. I do not have registration for a Trademark. I do not know that according to Trademark law misrepresenting by writing TM in a circle on the label without having a registration is punishable under the said law. I have given an application for registration of the Trademark. My advocate informed me that I can write TM. If I have obtained registration I should write R in a circle. I have not fled my Trademark application before this Court. I do not know if I have stated that I have filed an application for registration of the Trademark either in the written statement or in the proof affidavit. I do not remember the number but I may be able to retrieve it. I am not able to say when the application was filed.”

28. It is clear that the defendants do not have any registration of their mark. The contention that the mark of the plaintiff had been given with restrictions also cannot be taken into consideration since the registration certificate of the plaintiff itself is a xerox copy and has been rejected by this Court. However, it is clear that the defendants have been using the word 'Super Wash' even without registration of their mark. A comparison of both the mark show that the defendants had been using the very same word 'Super Wash'. The issue whether the plaintiff had proved that they are the prior user had been answered against the plaintiff because inadmissible evidence had been produced by the plaintiff. However one further aspect pointed out during arguments by the learned counsel for the defendants is that it is also an admitted fact that the defendants are not marketing the products within the jurisdiction of this Court. The plaintiff has not obtained any leave to combine the causes of action under Clause 12 of the Letters Patent. The cause of action for passing of had not arisen within the territorial jurisdiction of this Court.

29. Even assuming that the defendants are marketing the products, they are not marketing it within the jurisdiction of this Court. The issue of passing off can never be decided when the Court lacks territorial jurisdiction. Even the witness for the plaintiff had admitted that the defendants are not marketing their products at Chennai but are marketing their products only in Kerala.

30. In view of these facts, I hold that the Court cannot pass any decree to prohibiting the defendants from marketing the products or that they are passing off their products as the products of the plaintiff. The issue of passing off, namely, passing off the products of the defendants as if they are the products of the plaintiff is an issue which should have arisen within the jurisdiction of this Court. The defendant is not marketing the products, as repeatedly pointed out even by the witness for the plaintiff, within the jurisdiction of this Court.

31. The suit had been laid in the year 2013 only on the basis that the plaintiff had a registered office within the jurisdiction of this Court but to establish passing off, they must also establish that the defendants are marketing the products within the jurisdiction of this Court.

32. Section 134 of the Trademarks Act grants an additional place to institute the suit but that cannot be taken as permitting expanding the place where the cause of action arose. The cause of action for passing off arises only at the places where the defendant markets the products. In this case, they do not market the products within the jurisdiction of this Court. In view of this reason, I hold that this issue should also be answered against the plaintiff.

Issue Nos. 3 & 4:

33. In view of the above reasons I hold that the plaintiff is not entitled for any relief either for permanent injunction restraining the defendants from infringing the Trademark or for permanent injunction restraining the defendants from passing off the products.

34. The suit is dismissed. No order as to costs.

4.11.2020

Index: Yes/No

Web: Yes/No

vsg

Speaking/Non Speaking Order

1. List of Witnesses Examined on the side of the Plaintiff:-

1. P.W.1 – Mr. Biju S.Vaidyar (Plaintiff)

2. List of Exhibits Marked on the side of the Plaintiff:-

1. Ex.P1 – the Board Resolution dated 16.04.2014;
2. Ex.P2 – the Xerox copy of Trade Mark – Form I dated 24.03.1997 additional registration & E- register extract;
3. Ex.P3 – the Xerox copy of Delivery Challan/Invoice dated 24.12.1997 from plaintiff to Aysha Asso.
4. Ex.P4 – the Xerox copy of Delivery Challan/ Invoice dated 27.10.1998 from plaintiff to Ashique Exports.
5. Ex.P5 – the Xerox copy of Delivery Challan/ Invoice dated 12.10.1999 from plaintiff to Ashique Exports.
6. Ex.P6 – the Xerox copy of Delivery Challan/ Invoice dated 26.09.2000 from plaintiff to Ashique Exports.
7. Ex.P7 – the Xerox copy of Delivery Challan/ Invoice dated 30.05.2001 from plaintiff to Ashique Exports.
8. Ex.P8 – the Xerox copy of Delivery Challan/ Invoice dated 13.02.2002 from plaintiff to Ashique Exports.
9. Ex.P9 – the Xerox copy of Delivery Challan/ Invoice dated 2.12.2003 from plaintiff to Ashique Exports.
- 10.Ex.P10 – the Xerox copy of Delivery Challan/ Invoice dated 2.1.2004 from plaintiff to Ashique Exports.

11. Ex.P11 – the Xerox copy of Delivery Challan/ Invoice dated 20.12.2005 from plaintiff to AEPL.
12. Ex.P12 – the Xerox copy of Delivery Challan/ Invoice dated 12.08.2006 from plaintiff to AEPL.
13. Ex.P13 – the Xerox copy of stock Transfer Invoice dated 10.01.2007 from plaintiff to AEPL.
14. Ex.P14 – the Xerox copy of Invoice dated 3/11/2008 raised by the plaintiff.
15. Ex.P15 – the Xerox copy of Invoice dated 27/03/2009 raised by the plaintiff.
16. Ex.P16 – the Xerox copy of Invoice dated 29/6/2010 raised by the plaintiff.
17. Ex.P17 – the Xerox copy of Invoice dated 30/03/2011 raised by the plaintiff.
18. Ex.P18 – the Xerox copy of Invoice dated 12/5/2011 raised by the plaintiff.
19. Ex.P19 – the Xerox copy of Invoice dated 13/11/2010 raised by the plaintiff.
20. Ex.P20 – the Xerox copy of Annual Turnover from the year 1997 to 2012 certified by the Chartered Accountant.
21. Ex.P21 – the Xerox copy of Trade Mark Certificate dated 12.03.2008.
22. Ex.P22 – the certified copy of Order passed in O.A.Nos. 753, 754/2008 in C.S.No. 665 of 2008 dated 01.08.2008.
23. Ex.P23 – the Xerox copy of Trade Mark – Form I dated

19.03.2007 Additional representation for registration.

24. Ex.P24 – the print outs of E-register extract of defendant's application as on 24.08.2012.

25. Ex.P25 – the original purchase bill dated 16.05.2012 of defendant's product.

26. Ex.P26 - the original purchase bill dated 18.06.2012 of defendant's product.

27. Ex.P27 – the original plaintiff product's label.

28. Ex.P28 Series (4 Nos.) are the original defendant product's label.

3. List of Witnesses Examined on the side of the defendant:-

1. D.W.1 – Mr. Suresh K.K.

4. List of Exhibits Marked on the side of the defendant:-

1. Ex.D1 – the Additional Provisional Registration Certificate dated 24.01.1998 issued by SSI;

2. Ex.D2 – the counterfoil of our old Bill Book of the year March;

3. Ex.D3 – the wrapper & Label of our products;

4. Ex.D4 – the purchase order given by the Kerala State Civil Supplies Corporation dated06.1998;

5. Ex.D5 series – the purchase order given by the Kerala Police Canteen dated 27.09.2014;

6. Ex.D6 – the paper publication effected by the Kerala Financing Corporation to bring our properties for auction dated 13.10.2005;

7. Ex.D7 – the original order passed by the Kerala High Court in W.P.No. 11366/2006 dated 25.07.2006;

8. Ex.D8 – the computer generated copy of Online TIN Verification proof. (objected. Marked subject to proof and relevancy.)
9. Ex.D9 – the Sales Tax returns.

4.11.2020

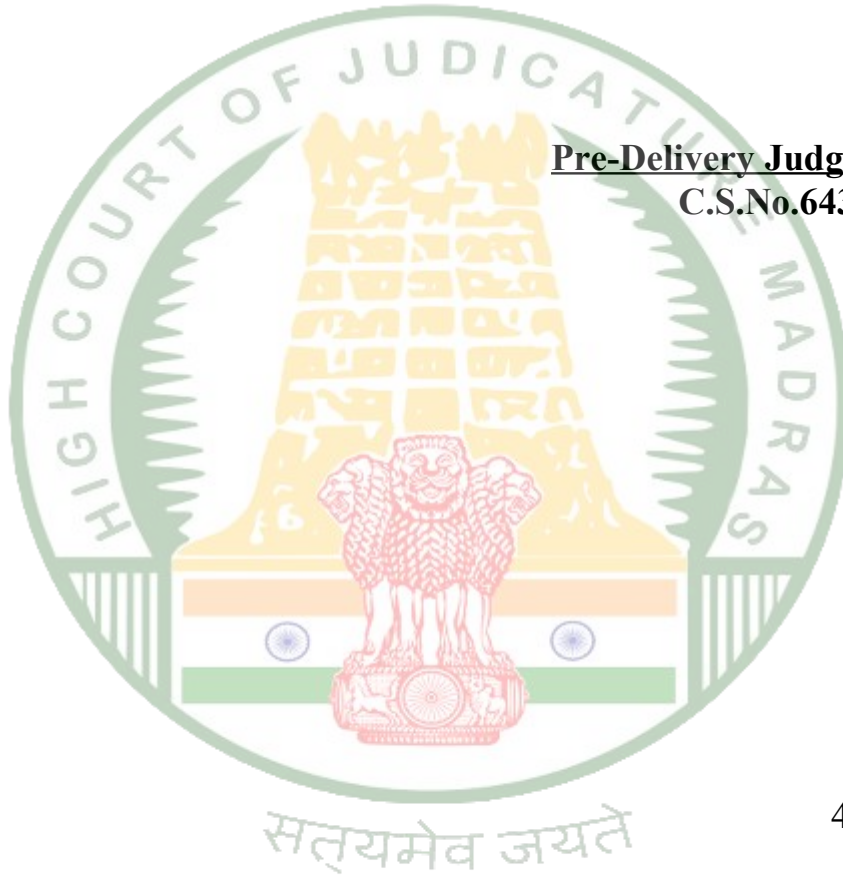
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C.V.KARTHIKEYAN, J.

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Pre-Delivery Judgement in
C.S.No.643 of 2012

4.11.2020

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