

IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON: 14.12.2020

PRONOUNCED ON: 21.12.2020

CORAM:

THE HONOURABLE MR.JUSTICE C.V.KARTHIKEYAN

O.A.Nos. 460 & 461 of 2020

IN

C.S.No.250 of 2020

O.A.Nos. 460 & 461 of 2020:

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

Applicant/Plaintiff in both
Applications

Vs.

M/s. Hema Foods,
No.6, V-Block, Bharathidasan Street,
Chennai – 600 015.

Respondent/Defendant
in both applications

PRAYER IN O.A.No. 460/2020:

This application filed under Order XIV Rule 8 of O.S Rules R/w.
Order XXXIX Rules 1 and 2 of C.P.C., praying to grant an order of interim
injunction restraining the respondent/defendant, their men, agents,

associates and/or assignees or any person claiming rights from them from infringing the Applicant's/Plaintiff's reputed and well known registered Trade Mark "DHEEPAM" by using the offending Trade Mark "NANDHI DHEEPAM OIL" or any mark or word deceptively similar to the aforesaid Trade Mark of the Applicant's/plaintiff's for lamp oil marketed by the respondent/defendant, their men, agents, associates and/or assignees or any person claiming rights from the respondent/defendant, pending disposal of the above suit.

PRAYER IN O.A.No. 461/2020:

This application filed under Order XIV Rule 8 of O.S Rules R/w. Order XXXIX Rules 1 and 2 of C.P.C., praying to grant an order of interim injunction restraining the respondent/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 Applicant's/Plaintiff "DHEEPAM" Lamp oil by using the offending words "NANDHI DHEEPAM OIL" or any other words or mark and offending packing material and pouch deceptively similar to the Applicant's/plaintiff's trade mark "DHEEPAM" pending disposal of the above suit.

For Plaintiff in
both Applications : Mr. Vijayan Subramanian

For Defendant in
both Respondent : Mr. R.Sathish Kumar

COMMON ORDER

Applications filed by the plaintiff seeking protection of their registered Trade Mark “DHEEPAM” and to restrain the defendant from passing off their products as if they are the products of the plaintiff.

2. The plaintiff is a company incorporated under the provisions of the Companies Act 1956 and is in the business of manufacturing and marketing edible oil. In April 2009, they had launched an unique lamp oil with a Blend of 5 oils under the brand name “DHEEPAM”. The plaintiff had also registered the word mark “DHEEPAM” under class 4 in respect of lamp oil, illuminating oil and oil for non-edible purpose under Registration No. 2320404 on 23.04.2012. The plaintiff had also claimed that they have also registered the bottle under which they market the said oil under the Designs Act 2000.

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3. In the plaint, the plaintiff had stated that the defendant has also started to market lamp oil under the name “NANDHI DHEEPAM OIL”. It was claimed that the defendant had copied the get up and colour scheme and trade dress of the plaintiff and also particularly violated the plaintiff's

Trade Mark “DHEEPAM”. It was also stated that the plaintiff had been very diligent in protecting the registered Trade Mark “DHEEPAM”. They had instituted C.S.No. 407 of 2015 when the defendant therein marketed lamp oil under the name “Maha SRI DEEPAM”. They also instituted C.S.No. 852 of 2015 when the defendant therein had marketed “Dheepa Olee”. They had also instituted C.S.No. 520 of 2018 when the defendant therein had marketed “Swasthik Dheepa Oil”. It had been stated that the defendants in those cases had withdrawn the labels similar to that of the plaintiff. The plaintiff claimed that the offending mark of the defendant “NANDHI DHEEPAM OIL” has been adopted only to gain the reputation and goodwill built the plaintiff.

4. It was under these circumstances that the suit had been filed seeking the reliefs under Sections 134 & 135 of Trade Marks Act, 1999 for a permanent injunction restraining the defendant from infringing the Trade Mark “DHEEPAM” and from passing off their products as if they are the products of the plaintiff and also for consequential reliefs including costs.

5. Along with the plaint, the present applications have been filed.

These applications came up for consideration on 30.09.2020 and this Court had granted an order of ex-parte interim injunction, which is still in force. Notice was directed to the defendant. The defendant entered appearance and a counter has been filed.

6. In the counter affidavit, the defendant stated that they are using the Trade Mark “NANDHI” and they market oil meant for lighting lamps or in other words, DHEEPAM OIL. They have stated that the word 'DHEEPAM' in Tamil indicates lamp and it is a generic word and therefore, the plaintiff cannot claim protection, even if the said word had been registered as a Trade Mark. It had been further stated that the defendant had been using the Trade Mark “NANDHI” for sale of DHEEPAM OIL from the year 2010. They had also applied for registration of the Trade Mark “NANDHI” which application is pending.

7. The defendant disputed the claim that the plaintiff is using the Trade Mark from the year 2009. The defendant also stated that the Trade Mark “DHEEPAM” is descriptive and based this statement on the averment made by the plaintiff that lighting a traditional lamp in place of worship is according to Hindu tradition. It was also stated that the blend of

5 oils has been in practice for several years and has been called PANCHADHEEPAM ENNAI. The defendant also denied that the labels are similar. It was stated that the labels of the defendant had a device of Lord NANDHI and a lamp. It also has sun rays. It was stated that it is totally different from that of the plaintiff. It was therefore stated that the injunction granted should be interfered with and the Applications should be dismissed.

8. Heard arguments advanced by Mr.Vijayan Subramanian, learned counsel for the plaintiff and Mr.R.Sathish Kumar, learned counsel for the defendant.

9. The following facts are admitted:-

(i) The plaintiff has the benefit of registration of the Trade Mark “DHEEPAM” under the Trade Marks Act 1999;

(ii) The plaintiff is marketing lamp oil under the registered Trade Mark DHEEPAM LAMP OIL; and

(iii) The defendant is also marketing lamp oil under the name “NANDHI DEEPAM OIL”.

10. A pictorial representation of the defendant's bottle and the

plaintiff's bottle are shown below:-



11. The contention of the learned counsel for the defendant is that

the word DHEEPAM is generic in nature. It signifies lamp. The oil which the bottles contain is the oil used for lighting a lamp. It is therefore called DHEEPAM OIL. It is the further contention of the defendant that their trade mark is NANDHI.

12. But a look at the two pictorial representations show that the word DHEEPAM is written prominently in the bottle of the defendant. There is every possibility of there being a confusion in the minds of the people as to the distinction between the manufacturers of the two products. The products are the same. The class of customers who would purchase them are the same. The distribution channel of shop keepers and sales persons are the same. The purpose for which the products are used are the same. If a customer seeks to purchase DHEEPAM LAMP OIL, then there is every possibility that the product of the defendant might be handed over to him mistakenly by the shopkeeper/sales person and also mistakenly purchased by the customer with both thinking that they are marketing the product of the plaintiff, when they could very well actually be selling/purchasing the product of the defendant because it is also called DHEEPAM OIL. The word NANDHI pales into insignificance.

13. In *Parle Products (P) Limited., Vs. J.P., and Co., Mysore*

reported in *AIR 1972 SC 1359* the broad and essential features to be

considered have been stated as follows:-

“ 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. Anyone in ,our opinion who has a look at one of the packets to-day 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 Holmes. We have therefore no doubt

that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered.....”

14. Even though at this stage, I am not minutely comparing the two bottles, still, a casual glance would indicate that it is the word DHEEPAM which remains in the mind even after sometime. The word may be indicative of a lamp but so long as the plaintiff has the benefit of a registered Trade Mark, the benefit of protection of such registered Trade Mark will have to be extended by the Court and the parties may relegate their issues before the appropriate authorities.

15. Viewed from that angle, in view of the marked similarity and the manner in which the word DHEEPAM has been prominently written in the bottle of the defendant, I hold that the plaintiff is entitled for orders of injunction and the earlier order does not warrant any interference. The Original Applications are allowed. No costs.

Index: Yes/No

Web: Yes/No

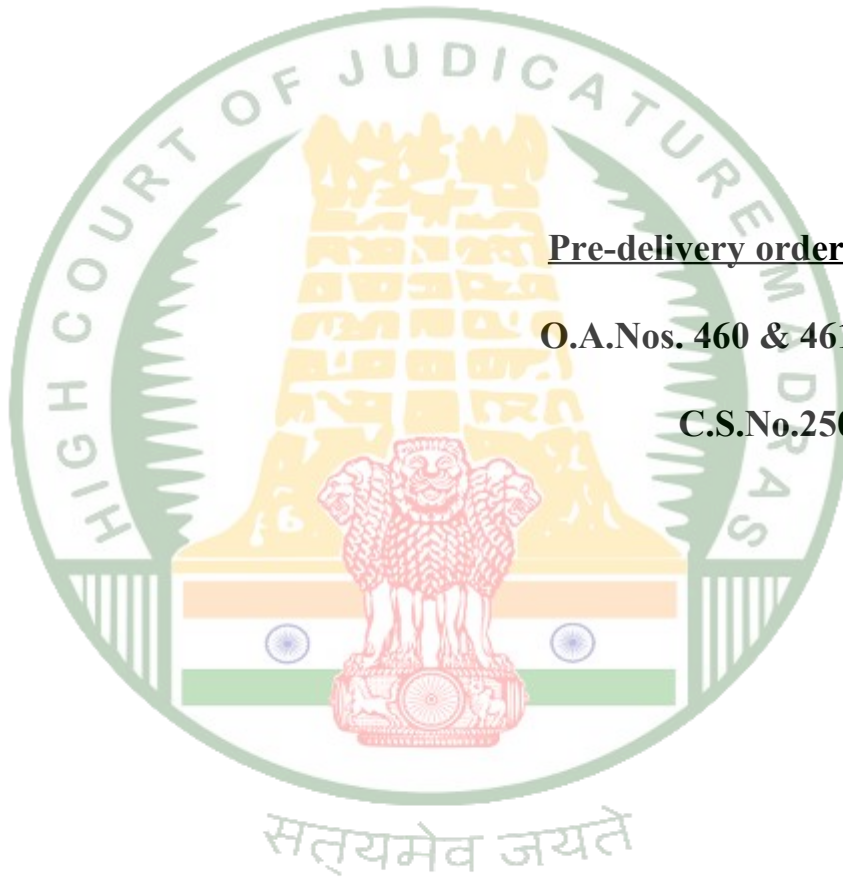
Speaking order : Yes / No

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C.V.KARTHIKEYAN, J.

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Pre-delivery order made in

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