

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 25.01.2020

Pronounced on : 26.02.2021

CORAM

THE HONOURABLE MR. JUSTICE C.V.KARTHIKEYAN

O.A.No.600 of 2020

and

A.Nos.2878 and 2881 of 2020

in

O.A.No.600 of 2020

and

O.A.No.601 of 2020

and

A.Nos.2879 and 2882 of 2020

in

O.A.No.601 of 2020

and

O.A.No.602 of 2020

and

A.Nos.2880 and 2884 of 2020

in

O.A.No.602 of 2020

in

C.S.(Comm.Div.) No.317 of 2020

O.A.Nos.600 to 602 of 2020:-

South India Krishna Oil and Fats Private Limited
Unit No.101, 102A, First Floor,
Realtech Copia Corporate Suites,
Plot No.9, Jasola District Centre,
New Delhi – 110025.

Represented by its Authorized Signatory

Mr.Ramneesh Kumar Aggarwal

... Applicant / Plaintiff
(in all original applications)

Vs.

Sovereign Agrotech Refinery Private Limited
Old-3A, New-8, Second Street,
Srinivasa Nagar,
Koyembedu,
Chennai – 600 107

And also at

New No.6/1, Old No.22/1,
Balaji Avenue, 2nd Street,
T.Nagar, Chennai – 600 017.

...Respondent / Defendant
(in all original applications)

A.Nos.2878, 2879, 2880, 2881, 2882 & 2884 of 2020:-

Sovereign Agrotech Refinery Private Limited
Old-3A, New-8, Second Street,
Srinivasa Nagar,
Koyembedu,
Chennai – 600 107
And also at
New No.6/1, Old No.22/1,
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... Applicant/Respondent/Defendant
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Vs.

South India Krishna Oil and Fats Private Limited
Unit No.101, 102A, First Floor,
Realtech Copia Corporate Suites,
Plot No.9, Jasola District Centre,
New Delhi – 110025.
Represented by its Authorized Signatory
Mr.Ramneesh Kumar Aggarwal

... Respondent/Applicant/Plaintiff
(in all applications)

Prayer in O.A.No.600 of 2020:- This application filed under Order XIV Rule 8 of O.S Rules and Order XXXIX Rules 1 and 2 of C.P.C., prayed to grant an ad-interim injunction, restraining the respondent/defendant, by themselves, their servants, agents, distributors, or anyone claiming through them from reproducing by selling, advertising and or offering for sale both domestic and exports by using the impugned Trademark SURYA PLUS word and device as shown in Document No.14 upon the goods or in any media and use the same in invoices, letter heads and visiting cards or by using any other trademark which is in any way substantially reproduce the applicant's / plaintiff's trademark 'Surya Plus' shown in Document No.13 or in any manner infringing the Applicant's/Plaintiff's trademark under Application No.2430126 and 2276038 in class 29 with respect to edible oil pending disposal of the above suit.

Prayer in O.A.No.601 of 2020:- This application filed under Order XIV Rule 8 of O.S Rules and Order XXXIX Rules 1 and 2 of C.P.C., prayed to grant an ad-interim injunction, restraining the respondent/defendant, by themselves, their servants, agents, distributors, or anyone claiming

through them from reproducing by selling, advertising and or offering for sale both domestic and exports by using the impugned Trademark SURYA PLUS and (pouch) as shown in Document No.14 upon the goods or in any media and use the same in invoices, letter heads and visiting cards or by using any other trademark which is in any way substantially reproduce the applicant's / plaintiff's trademark 'SURYA GOLD' and (pouch) shown in Document No.13 or in any manner passing off the Applicant's/Plaintiff's trademark pending disposal of the above suit.

Prayer in O.A.No.602 of 2020:- This application filed under Order XIV Rule 8 of O.S Rules and Order XXXIX Rules 1 and 2 of C.P.C., prayed to grant an ad-interim injunction, restraining the respondent/defendant, by themselves, their servants, agents, distributors, or anyone claiming through them from reproducing by selling, advertising and or offering for sale both domestic and exports by using the impugned copyright SURYA PLUS (pouch) as shown in Document No.14 upon the goods namely edible oil or in any media and use the same in invoices, letter heads and visiting cards or by using any other copyright which is in any way substantially reproduce the applicant's / plaintiff's copyright SURYA GOLD shown in Document No.1 or in any manner infringement of the applicant's / plaintiff's copyright pending disposal of the above suit.

Prayer in A.No.2878 of 2020:- This application filed under Order XIV Rule 8 of O.S Rules and read with Order XXXIX Rule 4 of C.P.C., prayed to vacate the interim injunction order dated 19.11.2020 in O.A.No.600 of 2020 in C.S.No.317 of 2020.

Prayer in A.No.2879 of 2020:- This application filed under Order XIV Rule 8 of O.S Rules and read with Order XXXIX Rule 4 of C.P.C., prayed to vacate the interim injunction order dated 19.11.2020 in O.A.No.601 of 2020 in C.S.No.317 of 2020.

Prayer in A.No.2880 of 2020:- This application filed under Order XIV Rule 8 of O.S Rules and read with Order XXXIX Rule 4 of C.P.C., prayed to vacate the interim injunction order dated 19.11.2020 in O.A.No.602 of 2020 in C.S.No.317 of 2020.

Prayer in A.No.2881 of 2020:- This application filed under Order XIV Rule 8 of O.S Rules and read with Section 151 of C.P.C., prayed to suspend the interim injunction order dated 19.11.2020 in O.A.No.600 of 2020 in C.S.No.317 of 2020.

Prayer in A.No.2882 of 2020:- This application filed under Order XIV Rule 8 of O.S Rules and read with Section 151 of C.P.C., prayed to suspend the interim injunction order dated 19.11.2020 in O.A.No.601 of 2020 in C.S.No.317 of 2020.

Prayer in A.No.2884 of 2020:- This application filed under Order XIV Rule 8 of O.S Rules and read with Section 151 of C.P.C., prayed to suspend the interim injunction order dated 19.11.2020 in O.A.No.602 of 2020 in C.S.No.317 of 2020.

For Plaintiff : Ms.Gladys Daniel

For Defendant : Mr.P.V.Balasubramanian

COMMON ORDER

Original Application No.600 of 2020 had been filed by the plaintiff seeking an ad interim injunction restraining the defendant from infringing the plaintiff's trademark 'SURYA GOLD' under A.Nos.2430126 and 2276038 in class 29 with respect to edible oil.

2.Original Application No.601 of 2020 had also been filed by the plaintiff seeking an ad interim injunction restraining the defendant from passing off their products under the trademark 'SURYA PLUS' which according to the plaintiff was substantially similar to the trademark of the plaintiff 'SURYA GOLD'. सत्यमेव जयते

3.Original Application No.602 of 2020 had been filed by the plaintiff for an ad interim injunction restraining the defendant from infringing the copyright of the plaintiff in the pouches of the defendant while marketing their edible oil under the impugned trademark 'SURYA

PLUS'.

4. These three applications came up for consideration on 19.11.2020 and this Court granted an order of ex-parte ad interim injunction till 03.12.2020. Notice was also directed to the defendant. On receipt of notice, the defendant entered appearance.

5. The defendant filed A.No.2881 of 2020 to suspend the order of interim injunction in O.A.No.600 of 2020 and A.No.2878 of 2020 to vacate the said order of interim injunction. The defendant also filed A.No.2882 of 2020 to suspend the order of interim injunction in O.A.No.601 of 2020 and A.No.2879 of 2020 to vacate the said order of interim injunction. The defendant filed A.No.2884 of 2020 to suspend the order of interim injunction in O.A.No.602 of 2020 and A.No.2880 of 2020 to vacate the said order of interim injunction.

6. The plaintiff, South India Krishna Oil and Fats Private Limited is a Company incorporated under the Companies Act, 1956 with registered office at New Delhi and is a part of the Musim Mas Group head quartered in Singapore. It had been stated that Musim Mas Group is a Multi-National Group, which sells oil products in more than 100

countries and employs about 37,000 people of different nationalities and backgrounds. They have a commercial presence not just in India but also in several other countries, which had been listed in the plaint. It had been stated that they are the market leader in manufacturing, marketing and selling palm oil, soap and margarine and also own one of the largest palm oil refinery networks in the world. The plaintiff is engaged in manufacturing and marketing edible oils, including refined sun flower oil across India under the trademark 'SURYA GOLD'.

7. In the plaint it had been stated that the plaintiff had adopted in India the mark 'SURYA GOLD' in an honest and bonafide manner from July 2012 and had been continuously using the same for more than seven years with respect to refined sun flower oil. It had also been stated that the plaintiff had acquired goodwill and reputation among the members of the trade / consumer and the public at large. The plaintiff had the benefit of registration of the mark 'SURYA GOLD SUPER OLEIN' in class 29 in A.No.2430126 and also the benefit of the registration of the mark 'GOLD SURYA' in class 29 in A.No.2276038.

8.The plaintiff claimed to be the true and lawful owner of the said registered trademarks. It had also been stated that the plaintiff's products were available throughout India and also in several e-commerce platforms / websites such as www.amazon.in, www.tradeindia.com and www.esuppliersindia.com. Necessary documents with respect to the same had been filed along with the plaint. The registration certificate of the registered mark of the trademark has also been filed along with the plaint. The Plaintiff had also given the details of the variety of edible oils which they market in the name 'SURYA GOLD SUPER OLIEN' and 'SURYA GOLD' in the plaint. They have also stated that they have advertised their products extensively in print and e-media and have also launched promotional campaigns.

9.It had been further stated in the plaint that the defendant, Sovereign Agrotech Refinery Private Limited, a Company also incorporated under Companies Act, 1956, had been involved in business transactions with the plaintiff and had begun to adopt the mark 'SURYA PLUS' in manufacturing and selling of edible refined oil and had adopted the trademark 'SURYA PLUS' which the plaintiff claims is deceptively similar to the plaintiff's trademark 'SURYA GOLD' and other 'SURYA

GOLD' formative trademarks in respect of edible refined oils and other goods covered under class 29 as provided under the Trade Marks Act, 1999.

10.It had been claimed that the adoption by the defendant of the mark 'SURYA PLUS' amounted to infringement of the registered marks of the plaintiff. It had been stated that the adoption of the mark 'SURYA PLUS' by the defendant was a dishonest practice and had been done with intention to encroach upon the goodwill and reputation built by the plaintiff. It had been stated that the defendant had applied for registration of their mark 'SURYA PLUS (label)' in A.No.3413862 in class 29, but the registration was refused by the Trade Marks Registry.

11.It had been stated that the defendant filed another application in A.No.3413863 for registration of the mark 'SURYA PLUS' but in class 35 with respect to wholesale, retail and marketing services connected with the sale of coconut oil, edible oil, palm oil, olive oil, rice brand oil, soybean oil, sunflower oil and vegetable oil for food. It had been stated that however, the defendant has been using the mark with respect to refined sunflower oil falling in class 29 similar to that of

plaintiff. The documents with respect to application for registration by the defendant had also filed along with the plaintiff.

12.The plaintiff had also stated that not only did the defendant infringe upon their trademark 'SURYA GOLD' but that they had also copied the colour scheme and getup in their pouches. It had been stated that this adoption of the mark by the defendant is malafide in nature and therefore, the suit had been filed seeking the reliefs to protect from infringement the registered trademark of the plaintiff and also the copyright of the plaintiff and for consequential reliefs.

13.The pictorial representation of the plaintiff's and the defendant's marks are shown below:-

Plaintiff's Mark:-



Defendant's Mark:-



14.The plaintiff had not filed any pictorial representation of their mark 'GOLD SURYA'.

15.Along with the plaint, the plaintiff filed O.A.Nos.600, 601 and 602 of 2020 seeking interim injunctions as stated above to protect from infringement the trademark 'SURYA GOLD SUPER OLEIN' and 'GOLD SURYA' and to prevent passing off by the defendant their products under the name 'SURYA PLUS' which according to the plaintiff was deceptively similar to their registered marks and to restrain defendant from infringing the copyright, particularly the colour scheme and getup

of the pouches in which the defendant marketed their products 'SURYA PLUS'. These applications came up for consideration before this Court on 19.11.2020 and the Court had granted an ex parte ad interim injunction as stated. In the affidavit filed in support of the said applications, the plaintiff had averred the same facts as stated in the plaint.

16. The defendant entered appearance and filed applications seeking to suspend the orders of ex-parte interim injunction and also to vacate the orders of ex-parte interim injunction. In the affidavit filed in support of the said applications, the defendant stated that the word 'SURYA' is a generic word and common to the trade. It had been stated that the said word has been used by several third parties along with their trademarks. It had therefore been stated that the plaintiff cannot be granted any relief based on the registration of their trademark. It had been further stated that the plaintiff had obtained registration of the word mark 'SURYA GOLD SUPER OLEIN' with a condition that the “*mark to be use and read as whole*”. This was originally opposed by another company from Andhra Pradesh. But later the opposition was abandoned, but still the registration was “*granted with the disclaimer, to be use and read as whole*”.

17.It had been therefore stated that the plaintiff can claim protection from infringement only if the defendant had used the mark of the plaintiff as a whole. However, the defendant's mark is 'SURYA PLUS' and it was claimed that the plaintiff cannot complain that the defendant had infringed upon the mark of the plaintiff particularly when the word 'SURYA' is generic in nature and common to the trade namely, edible sunflower oil and more particularly since the plaintiff has the benefit of registration of the mark with a disclaimer to use it as a whole and not to segregate for any individual words in the said mark.

18.It had also been stated that the plaintiff has the benefit of registration of the mark 'GOLD SURYA' under Trademark No.2276038 which was registered only in the year 2018. It had been stated that both are word marks and the plaintiff cannot seek any protection for the pictorial representations in the pouches. It had been reiterated that even the mark 'GOLD SURYA' of the plaintiff cannot come to the assistance of the plaintiff to obtain an order of injunction against the mark 'SURYA PLUS' of the defendant.

19.It had been further stated that the defendant is using the mark 'SURYA PLUS' as a composite label mark. The colour get up and dressage are entirely different and there can be no possibility of misrepresentation. It had been claimed that there was no similarity between the trademark of the plaintiff and the composite label mark of the defendant. It had been therefore stated that there was no likelihood of confusion. The defendant denied all suggestions of deception. It had also been stated that the defendant was using the mark continuously and exclusively, in view of their registration in Registration No.3413863 under class 35 which is still in force. It had been stated that the defendant is an honest and uninterrupted user of the composite label 'SURYA PLUS'. It had therefore stated that the defendant is not involved either in infringement of the copyright or infringement of trademark or in passing off their products as if they are the products of the plaintiff. It had therefore stated that the order granting injunction should be interfered with.

20.The plaintiff filed a counter to the applications filed by the defendant.

21. In the counter affidavit, the plaintiff claimed that they had adopted the mark in the year 2012 and therefore they are the prior users of the trademark. It had further been denied that the impugned mark is unique in nature and dissimilar to that of the plaintiff's registered trademark. It had again been reiterated that there is every possibility of customers being misled into thinking that they are purchasing the product of the plaintiff. It had been reiterated that the application of the defendant with respect to registration of the mark 'SURYA PLUS' under class 29 had been refused by the Trade Mark Registry and that the defendant has a benefit of registration only under class 35 and was dishonestly using the said mark to market the edible oils. It had again been reiterated that the Court should extend protection to the plaintiff's registered trademark.

22. Heard arguments advanced by Ms. Gladys Daniel learned counsel for the plaintiff and Mr. P. V. Balasubramanian, learned counsel for the defendant.

23. For the sake of convenience, the parties would be referred as

plaintiff and the defendant.

24.The plaintiff, South India Krishna Oil and Fats Private Limited is a Company incorporated under the Companies Act, 1956 with registered office at New Delhi and is a part of the Musim Mas Group head quartered in Singapore. The plaintiff claimed that they have adopted the mark 'SURYA GOLD' since July 2012 and have been using the same for more than seven years with respect to refined sunflower oil. The plaintiff also has the benefit of registration under class 29 of the mark 'SURYA GOLD SUPER OLEIN' under registration No. 2430126 and under class 29 of the mark 'GOLD SURYA' in registration No.2276038. The plaintiff claims to have a presence and are marketing their products across the country and also in e-commerce platforms. The turnover details have also been given in the plaint.

25.It is the case of the plaintiff that the defendant was involved in business transactions with the plaintiff and therefore knew about the goodwill and reputation established by the plaintiff. It is the further case of the plaintiff that the defendant dishonestly adopted the mark 'SURYA PLUS'. As a matter of fact, the application of the defendant for registration of the mark 'SURYA PLUS' in class 29 had been refused by

the Trade Marks Registry but later the defendant had obtained registration under class 35 which related to services. It had been stated that the defendant is dishonestly using the mark 'SURYA PLUS' even for marketing edible oil which is a similar product as marketed by the plaintiff.

26. However, one fact which had not been stated in the plaint is the assertion of the defendant that the plaintiff had been granted registration of the mark 'SURYA GOLD SUPER OLEIN' to be used and read as a whole. The document to that effect had been filed by the defendant, and it is clear that though the plaintiff had been granted registration in Registration No.2430126 for the mark 'SURYA GOLD SUPER OLEIN' which had also been published in the Trademark Journal No.1717 dated 21.01.2015 with respect to class 29, it had been very specifically stated that the “*mark should be used and read as a whole*”. This is very significant. This fact had not been stated in the plaint. This document had not been filed along with the plaint. The Registered Certificate alone filed along with the plaint, which cannot be used in legal proceedings. The Legal User Certificate has not been filed along with the plaint.

27.The plaintiff also has benefit of the registration of the mark 'GOLD SURYA' in class 29 under Registration No.2276038. Documents with respect to the nature of the said mark or pictorial representation of the said mark had not been filed with the plaint.

28.The defendant's mark is 'SURYA PLUS'. It is the claim of the defendant that the word 'SURYA' is a generic name and associated with the oil which is being sold namely, Sunflower Oil.

29.Section 17 of the Trade Marks Act, 1999 is as follows:

“17. Effect of registration of parts of a mark

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section

(1), when a trademark-

(a) contains any part -

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.”

30. It is clear that the plaintiff has the benefit of the registration of the mark 'SURYA GOLD SUPER OLEIN' as a whole and therefore, it is clear that the plaintiff cannot claim exclusive right over any individual word under the said mark.

31. Dealing with the scope of Section 13 of the Trademark Act, 1940, which is paramateria with Section 17 of the Trade and Merchandise Marks Act, 1958, the Hon'ble Supreme Court in ***Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd (1955) 2 SCR 252: AIR 1955 SC 558***, observed as under in paragraph 6 as follows:- "

“6. .. At the outset it will be noticed that the power of the tribunal to require a disclaimer is conditioned and made dependent upon the existence of one of two things which are set out in clauses (a) and (b) and which have been

called the jurisdictional facts. It is only on the establishment of one of the two jurisdictional facts that the Registrar's jurisdiction regarding imposition of a disclaimer arises. Before, however, he may exercise his discretion he must find and hold that there are parts or matters included in the trade mark to the exclusive use of which the proprietor is not entitled and it is only after this finding is arrived at that the Registrar becomes entitled to exercise his discretion. In course of the argument it was at one time contended that upon the establishment of the requisite jurisdictional fact and upon the finding that the proprietor was not entitled to the exclusive use of any particular part or matter contained in the trade mark the Registrar became entitled, without anything more, to require a disclaimer of that part or matter. This extreme position, however, was not maintained in the end and it was conceded, as indeed it had to be, that the exercise of the power conferred on the Registrar by this section always remained a matter of discretion to be exercised, not capriciously or arbitrarily but, according to sound principles laid down for the exercise of all judicial discretion. (See the observations of

Lord Halsbury, L.C., in Sharp v. Wakefield [LR 1891 AC 173 at p 179]). As the law of Trade Marks adopted in our Act merely reproduces the English Law with only slight modifications, a reference to the judicial decisions on the corresponding section of the English Act is apposite and must be helpful. Section 15 of the English Act of 1905 which later on was reproduced in Section 14 of the English Act of 1938 and which corresponds to our Section 13, was considered by the High Court in England in In re Albert Baker Co.'s Application and In re Aerated Bread Company's Application [LR (1908) 2 Ch 86 : 25 RPC 513] which is commonly called the A.B.C. case. In that case Eve, J. found on the evidence that Albert Baker Company were widely known as "A.B.C." or "A.B. & Co." but that the letters "A.B.C." did not exclusively indicate their goods and that those letters being common to the trade they were not entitled to the exclusive use of those letters. Nevertheless the learned Judge did not hold that that finding alone concluded the matter. Said the learned Judge:

"The first observation which it occurs to me to make is that the object of the legislature

was to relieve traders from the necessity of disclaiming, and I think it follows from this that the condition is one for the imposition of which some good reason ought to be established rather than one which ought to be imposed, unless some good reason to the contrary is made out. This conclusion is, I think, fortified by the frame of the section, which is in an enabling form empowering the tribunal to impose the condition — power which, I conclude, the Tribunal would only exercise for good cause shown.” It follows from what has been stated above that the existence of one of the two jurisdictional facts referred to in clauses (a) and (b) of Section 13 and the finding that the trade mark contains parts or matters to the exclusive use of which the proprietor is not entitled does not conclude the matter and it must further be established that some good reason exists for the imposition of a disclaimer and the Tribunal will only exercise the discretionary power for good cause shown.”

32. The Supreme Court in the above decision, explained the functions of the disclaimer as follows:-

“ In short, the disclaimed parts or matters are not within the protection of the statute. That circumstance, however, does not mean that the proprietor's rights, if any, with respect to those parts or matters would not be protected otherwise than under the Act.”

33. The Supreme Court in the above decision, ultimately held that the distinct label registered as a whole cannot possibly give any exclusive statutory right to the proprietor of the trade mark in close any particular word the name contained therein **apart from the mark as a whole**. In the said decision, the Supreme Court referred to the observations of **Lord Esher in Pinto Vs. Badman (8 RPC 181 at p.191)**, **In re Apollinaris Company's Trade Marks (LR (1891) 2 Ch. 186)**, **In re Smokeless Powder Co.. (LR (1892) 1 Ch 590 : 9 RPC 109)**, **In re Clement and Cie (LR (1900) 1 CH 114)** and **In re Albert Baker & Company (LR (1908) 2 Ch. 86 : 25 RPC 513)**. Ultimately, the Supreme Court referred that the truth is that the label does not consist of each particular part of it, but consists of the combination of them all.

34. It was further observed by the Supreme Court in the above

decision that, merely because the labels were registered subject to the following disclaimer:-

“(g) Registration of the Trade Mark shall give no right to the exclusive use of the word "Shree".

35. It is in the context of the above dispute, the Supreme Court, in the above decision, after considering the various decisions held that the Registrar while granting registration has not gone wrong and thus the High Court found it necessary to interfere with the discretion under Section 13 of the Trade Mark Act, 1940. It noted that "The device which, its essential features, was, on the application of the respondent company, registered as its trade mark No. 3815. That mark was and is a device consisting of the word "Shree" written on the top in bold Bengali character, having below it an ornamental figure with the word "Shree" written in the center in small Deva Nagri character."

36. In the said case, the mark in question consisted of a device along with the word “Shree” written on the top in bold Bengali character,

having below it an ornamental figure with the word “Shree” written in the centre in small Deva Nagri character. The Registrar had imposed a disclaimer for the word “Shree” . Answering the question, the Hon’ble Supreme Court observed as under:-

"Considering all the circumstances discussed above, we are not of opinion that the Registrar had gone so wrong as to have made it necessary for the High Court to interfere with his discretion. If it were to be regarded as a matter of exercise of discretion by the High Court as to whether a disclaimer should be imposed or not, it is quite clear that the attention of the High Court was not drawn to an important consideration, namely, the strong possibility of the respondent company claiming a statutory right to the word "Shree" by virtue of the registration of its trade mark and subject others to infringement actions only on the strength of the registration and without proof of facts which it would have otherwise to establish in order to succeed in a passing

off action or a prosecution under the Indian Penal Code and, therefore, the High Court cannot be said to have properly exercised its discretion. The result, therefore, is that this appeal must be allowed and the respondent company must pay the appellant's costs in this Court and in the High Court."

37. In *F.Hoffmann-La Roche & Co.Ltd v. Geoffrey Manner & Co. (P) Ltd.*, (1969) 2 SCC 716 at page 720 it was held as follows:-.

"It is also important that the marks must be compared as wholes. It is not right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in the other case there is no sufficient similarity to cause confusion. The true test is whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark. Thus in Layromacase(1). Lord Johnston said: ". ' we are not bound to scan the words as we

would in a question of comparatioliterarum. It is not a matter for microscopic inspection, but to be taken from the general and even casual point of view of a customer walking into a shop."

38. In *Amritdhara Pharmacy Vs. Satya Deo Gupta*, (1963) 2 SCR

484 : AIR 1963 SC 449, it was held as follows:-.

"We agree that the use of the word 'dhara' which literally means 'Current or stream' is not by itself decisive of the matter. What we have to consider here is the overall similarity of the composite words, having regard to the circumstance that the goods bearing the two names are medicinal preparations of the same description.

We are aware that the admission of a mark is not to be refused, because unusually stupid people, "fools or idiots", may be deceived. A critical comparison of the two names may disclose some points of difference. but an unwary purchaser of average

intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name. **The trade mark is the whole thing the whole word has to be considered.** In the case of the application to register 'Erectiks' (opposed by the proprietors of the trade mark 'Erector') Farwell, J. said in *William Bailey (Birmingham) Ltd. Application* [(1935) 52 RPC 137]: "I do not think it is right to take a part of the word and compare it with a part of the other Word; one word must 'be considered as a whole and compared with the other word as a whole..... I think it is a dangerous method to adopt to divide the word up, and seek to distinguish a portion of it from a portion of the other word".

39. In Kaviraj Pandit Durga Dutt Sharma V. Navaratha

Pharmaceuticals Laboratories, (1965) 1 SCR 737 : AIR 1965 SC 980

it was held as follows:-

*“The mark of the respondent which he claims has been in- fringed by the appellant is the mark 'Navaratna Pharmaceutical Laboratories', and the mark of the appellant which the respondent claimed was a colourable imitation of that mark is 'Navaratna Pharmacy. Mr. Agarwala here again stressed the fact that the 'Navaratna' which constituted an essential part or feature of the Registered Trade Mark was a descriptive word in common use and that if the use of this word in the appellant's mark were disregarded, there would not be enough material left for holding that the appellant had used a trade mark which was deceptively similar to that of the respondent. **But this proceeds, in our opinion, on ignoring that the appellant is not, as we have explained earlier, entitled to insist on a disclaimer, in regard to that word by the respondent. In these circumstances, the trade mark to be compared with that used by the appellant is***

the entire registered mark including the word 'Navaratna'. Even otherwise, as stated in a slightly different context:(1) "Where common marks are included in the trade marks to be compared or in one of them, the proper course is to look at the marks as wholes and not to disregard the parts which are common".

The above precedents had also been relied on by a Division Bench of this Court in O.S.A.No. 169 of 2020, M/s. Pathanjali Ayurved limited and another Vs. Arudra Engineers Pvt. Ltd., in Judgment dated 02.02.2021 when they examined the mark "CORONIL-213 SPL' and 'Coronil-92B' with the mark 'Coronil' and refused to grant injunction.

40. Section 30(2)(e) of the Trade Marks Act, 1999 is as follows:

"30. Limits on effect of registered trade mark:-

(1).

.....

(2) A registered trade mark is not infringed where-

.....

.....

(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.”

41. It is clear that a registered trademark is not infringed when the registered trademark is used, in exercise of the right to use that trademark.

42. In this case, the defendant has a registration under class 35 and whether on the basis of that, they should be enjoined or not is a matter of trial. A whole series of issues arise which can be determined only by the parties adducing evidence. The plaintiff will have to establish the nature of the registration of the marks 'SURYA GOLD SUPER OLEIN' and 'GOLD SURYA'. The nature of business relationship which the defendant had with the plaintiff is established.

43. The defendant will have to be given an opportunity to explain the basis on which they had adopted the mark 'SURYA PLUS'. The

plaintiff will also have to explain why they did not state in the plaint that their registration 'SURYA GOLD SUPER OLEIN' had been registered with a disclaimer that it should be used and read as a whole. The non-statement of this fact in the plaint is significant.

44. In view of these facts, the orders of interim injunction granted in O.A.Nos.600, 601 and 602 of 2020 in C.S.No.317 of 2020 are vacated. But however, since the defendant is also a Private Limited Company, it would only be appropriate that they are called upon to file in Court a statement regarding their turnover of their products under the name 'SURYA PLUS', once every quarter. Such statement should be filed in the next succeeding month. If the plaintiff establishes their case, then they can reasonably seek damages and for costs.

45. In the result,

- i). O.A.Nos. 600, 601 and 602 of 2020 are dismissed. No costs.
- ii). A.Nos.2878, 2879 and 2880 of 2020 to vacate the order of interim injunction dated 19.11.2020 is allowed. No costs.
- iii). A.Nos.2881, 2882 and 2884 of 2020 to suspend the order of interim injunction dated 19.11.2020 is disposed of and closed. No costs.

iv) the defendant is directed to file in Court a statement regarding their turnover of their products under the name 'SURYA PLUS', once every quarter. Such statement should be filed in the next succeeding month. Failure to file accounts as directed will be a ground to revisit this order.

26.02.2021

smv/vsg

Index : Yes / No

Internet : Yes / No

Speaking order : Yes / No

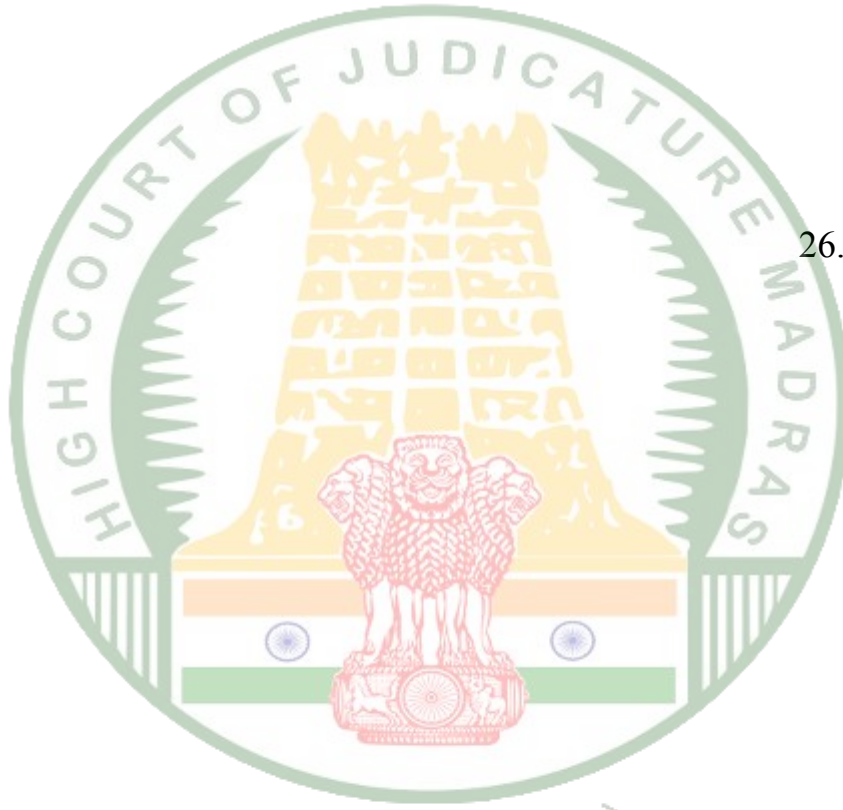
C.V.KARTHIKEYAN, J.,

smv/vsg



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Pre-delivery order made in
O.A.Nos.600, 601 & 602 of 2020
and
A.Nos.2878, 2879, 2880,
2881, 2882 and 2884 of 2020
in
C.S.(Comm.Div.) No.317 of 2020



26.02.2021

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