



IN THE HIGH COURT OF JUDICATURE AT MADRAS

(ORDINARY ORIGINAL CIVIL JURISDICTION)

MONDAY THE 26<sup>th</sup> DAY OF APRIL 2021

THE HON'BLE MR. JUSTICE C.V.KARTHIKEYAN

C.S.No. 164 of 2017

M/s. S.N.R. DHALL MILL

A registered partnership firm

represented by its Managing Partner (\*) **Mr.S.Vijayakumar**

**S/o. R.Surendran**

No.2/4, Vaidyanatha Mudali Street,

Tondiarpet,

Chennai – 600 081, Tamilnadu

**(\*) Amended as per order dated 04.11.2020 in  
A.No. 2066/2020.**

... Plaintiff

**Vs**

M/s. Kaleesuwari Refinery Private Limited

#, Rajasekaran Street,

Opp. Kalyani Hospital, Radhakrishnan Salai

Chennai – 600 004, Tamil Nadu.

... Defendant

Civil suit praying that this Hon'ble Court be pleased to grant a  
decree and judgment on the following terms:-

**(a)** a permanent injunction restraining the defendant, its directors,  
all their principal officers, staff, men, agent, servants, successors, assigns in  
business, representatives and any other person from infringing the  
trademark by using the words “GOLD WINNER” together or any other



word/words/device that are identical or deceptively similar to the said registered Trademark of the plaintiff having Registration No. 1232740 in class 30 in respect of dhal varieties and thereby restraining them from claiming any right through or under the defendant from in any manner infringing the registered trademark and passing off its products as that of the plaintiff's under trademark "GOLD WINNER";

(b) the defendant be ordered and directed to pay to plaintiff a sum of Rs.10,00,000/- (Rupees Ten Lakhs only) by way of damages;

(c) a preliminary decree be passed in favour of the plaintiff directing the defendant to render a true and faithful accounts of all profit made by them, using the plaintiff's said Trademark in particular the word "GOLD WINNER" and a final decree be passed in favour of the plaintiff for the amount of profit thus found to have been made by the defendant, together with interest, after the defendant has rendered accounts;

(d) the defendant be directed to deliver-up to the plaintiff for destruction, all labels, all other print materials, stickers, signage, visiting cards, letter heads, catalogues, pamphlets, brochures, all other advertising and promotional material, all stationary, and such other material used for infringing and passing off; and

(e) for the costs of the suit.



Mr.Ravikumar Paul, Senior Counsel for Mr.Ramesh Ganapthy for M/s. Mission Legal, Advocates for the Plaintiff herein and Mr.P.S.Raman, Senior Counsel for Mr.G.Kalyan Jhabakh for M/s. Surana and Surana, Advocates for the defendant herein and upon reading the plaint filed herein and the other exhibits therein referred to and upon perusing the evidence adduced therein, and having stood over for consideration till this date and coming on this day before this court for orders in the presence of the said advocates for the parties hereto, and this court having observed that the usage or subsequent adoption of the mark from winner to Gold Winner by the plaintiff is tainted with an underlying object to ride on the reputation already built by the defendant and they did not adopt the trademark Gold Winner (Label) before the defendant's Mark Gold Winner had already earned a reputation in the market, and the plaintiff is the registered proprietor of the trade mark gold winner, but the plaintiff cannot exercise right since the words Gold Winner is only a part of the whole of their registered trademark, and the plaintiff had not proved the actual use of the registered trademark Gold Winner (Label) and the image in MO1, 5 kg bag is not consistent with the registered trademark Gold Winner (Label) and the plaintiff has not established continuous presence in the retail market, they have also not established their turnover in the retail market and the invoices have not been proved by the plaintiff in manner known to law and the plaintiff has not proved their expenses towards advertisement with respect to Toor Dhalls marketed under the trademark Gold Winner (Label) and reiterating the right of the defendant over the registered artistic work and this court holds that the act of the defendant is selling their Toor Dhall products in the name Gold Winner, would neither amount to infringement of trademark of the plaintiff nor can be categorised as passing off their products as if there are the products of the plaintiff and the distribution channels and class of



customers are totally difference and that the packagings are different and that the marks are both represented in a totally different manner, both with the respect to the writings and also with respect to the colour combination, that therefore, there cannot be any cause for confusion, **it is ordered as follows:-**

That the suit in C.S.No.164 of 2017 be and is hereby dismissed.

2. That the defendant herein be and is hereby entitled to the fees and expenses of the witness, the legal fees and expenses incurred and for any other expenses incurred in connection with the judicial proceedings, as and when taxed by the taxing officer of this court, and noted in the margin thereof.

WITNESS THE HON'BLE MR. JUSTICE SANJIB BANERJEE,  
CHIEF JUSTICE, HIGH COURT AT MADRAS AFORESAID, THIS THE  
26<sup>th</sup> DAY OF APRIL 2021.

Sd./-

ASSISTANT REGISTRAR (COMM.CASES)

//Certified to be true copy//

Dated at Madras this the       day of       2021.

COURT OFFICER(O.S.)

From 25th Day of September 2008 the Registry is issuing certified copies of the Orders/Judgments/Decrees in this format.



SK-06.05.2021

WEB COPY

C.S. No.164 of 2017

ORDER :-

DATED : 26.04.2021

THE HON'BLE MR. JUSTICE  
C.V.KARTHIKEYAN

FOR APPROVAL: 14.07.2021

APPROVED ON: 20.07.2021



WEB COPY

6

IN THE HIGH COURT OF JUDICATURE AT MADRAS

**RESERVED ON: 10.02.2021**

**PRONOUNCED ON: 26.04.2021**

CORAM:

**THE HONOURABLE MR.JUSTICE C.V.KARTHIKEYAN**

**C.S.No. 164 of 2017**

M/s. S.N.R. DHALL MILL

A registered partnership firm

represented by its Managing Partner (\*) **Mr.S.Vijayakumar**

**S/o. R.Surendran**

No.2/4, Vaidyanatha Mudali Street,

Tondiarpet,

Chennai – 600 081, Tamilnadu

**(\*) Amended as per order dated 04.11.2020 in**

**A.No. 2066/2020.**

... Plaintiff

**Vs**

M/s. Kaleesuwari Refinery Private Limited

#, Rajasekaran Street,

Opp. Kalyani Hospital, Radhakrishnan Salai

Chennai – 600 004, Tamil Nadu.

... Defendant

**PRAYER:-** This Civil Suit is filed under Order VII Rule 1 of the Civil Procedure Code read with Order IV Rule 1 of the O.S. Rules read with Sections 28, 29, 134 & 135 of the Trademarks Act, 1999, for a Judgment and Decree against the defendant for the following reliefs:

**(a)** a permanent injunction restraining the defendant, its directors,



all their principal officers, staff, men, agent, servants, successors, assigns in business, representatives and any other person from infringing the trademark by using the words “GOLD WINNER” together or any other word/words/device that are identical or deceptively similar to the said registered Trademark of the plaintiff having Registration No. 1232740 in class 30 in respect of dhall varieties and thereby restraining them from claiming any right through or under the defendant from in any manner infringing the registered trademark and passing off its products as that of the plaintiff's under trademark “GOLD WINNER”;

**(b)** the defendant be ordered and directed to pay to plaintiff a sum of Rs.10,00,000/- (Rupees Ten Lakhs only) by way of damages;

**(c)** a preliminary decree be passed in favour of the plaintiff directing the defendant to render a true and faithful accounts of all profit made by them, using the plaintiff's said Trademark in particular the word “GOLD WINNER” and a final decree be passed in favour of the plaintiff for the amount of profit thus found to have been made by the defendant, together with interest, after the defendant has rendered accounts;

**(d)** the defendant be directed to deliver-up to the plaintiff for destruction, all labels, all other print materials, stickers, signage, visiting cards, letter heads, catalogues, pamphlets, brochures, all other advertising and promotional material, all stationary, and such other material used for infringing and passing off; and

**(e)** for the costs of the suit.



WEB COPY

For plaintiff :Mr. Ravikumar Paul, Senior Counsel,  
for M/s. Mission Legal,  
Mr. Ramesh Ganapathy.

For Defendant :Mr. P.S. Raman, Senior Counsel for  
M/s. Surana & Surana,  
Mr. G. Kalyan Jhabakh.

### JUDGEMENT

The suit had been filed by the plaintiff M/s. S.N.R. Dhall Mill, a registered partnership firm represented by its Managing Partner R.Surendran, under Sections 28, 29, 134 & 135 of the Trademarks Act, 1999 read with the relevant provisions of the Code of Civil Procedure and the Original Side Rules of the Madras High Court, seeking a Judgement and Decree against the defendant, M/s. Kaleesuware Refinery Private Limited, a company incorporated under the Companies Act, 1956 in the nature of permanent injunction restraining the defendant from infringing the Trademark of 'Gold Winner' of the plaintiff by using the words “Gold Winner” which is similar to the registered Trademark of the plaintiff in Registration No. 1232740 in class 30 in respect of dhall varieties and restraining the defendant from passing off their products as if they are the products of the plaintiff under the Trademark “Gold Winner” and for a



damages and for consequential reliefs in the nature of a preliminary decree directing the defendant to render accounts of profits and to deliver to the plaintiff for destruction, all materials used for infringing the trademark and for passing off and for costs of the suit.

2. It had been stated that the plaintiff had adopted the Trademark “Gold Winner” in the year 1999 with respect to different varieties of Dhall and flour preparations. The plaintiff claimed to be a leading manufacturer with respect to different varieties of Dhall and flour preparations and have been using the Trademark “Gold Winner” continuously from 1999. The plaintiff is a registered dealer under the Tamil Nadu Value Added Tax Act 2006 and is also registered with the Tamil Nadu Food Safety and Drug Administration Department.

3. The plaintiff claimed they had conceived and adopted the Trademark “Gold Winner” since 01.06.1999. They had also obtained registration for the mark “Gold Winner” (label) under A.No. 1232740 in class 30 wherein the words “Gold Winner” is prominently shown along with a device of a Man. During the registration, a disclaimer was issued from claiming exclusive right for the Device of the Man. The plaintiff claimed that the registration had been renewed and is subsisting. The plaintiff also



claimed that they have gained goodwill and reputation among the trade circle and general public. It is also claimed to be a well established and well known trademark. They have businesses across the country. The plaintiff also stated their annual sales turn over in the plaint and it is seen that in the financial year 2015-2016, they had a turn over of Rs.1,14,26,39,357/-. It had been stated that the plaintiff is the exclusive proprietor of the trademark and is entitled for exclusive right to use the Trademark.

4. It had been further stated that the defendant has been doing business selling Sun Flower Oil and Vanaspathi under the Trademark “Gold Winner” which had been registered in class 29. They however commenced selling Dhall varieties under the Trademark “Shree Gold” from 2005 and the mark was also registered in class 30. After the registration of the plaintiff's Trademark in the year 2005, the defendant filed a rectification petition before the Trademark Registry in Chennai, challenging the registration of the plaintiff's Trademark “Gold Winner”. Submissions were made by both the sides. At that stage, an order had been passed on 30.01.2013 treating the said petition as “withdrawn”.

5. The plaintiff also stated that they came to know that just prior to the institution of the suit, the defendant was manufacturing and



introducing Dhalls varieties in the market in Chennai and in other Cities in India under the name “Gold Winner”. The plaintiff claimed that this led to confusion and was a direct act of violating the plaintiff's prior adopted and registered Trademark. It had been claimed that the defendant had copied the exact words and had used the mark “Gold Winner” and that it is a dishonest usage. It had also been stated that the defendant had also advertised in television channels and in boards mounted on buses, showing the defendant's Dhall products and stating that the name of the registered Trademark “Shree Gold” is now “Gold Winner”.

6. The defendant had not applied for the registration of trademark. It had been claimed that the defendant wants to encroach on the goodwill and reputation built by the plaintiff. It had also been claimed that the defendant wanted to deceive the customers and dealers by making them believe that the defendant is in someway associated with the plaintiff. It had been stated that the defendant had adopted the Trademark “Gold Winner” with intention to make unlawful gain. It had been stated that the usage of the mark “Gold Winner” by the defendant was dishonest. It had been further stated that the usage of a similar Trademark by the defendant has caused irreparable loss and hardship to the plaintiff. It is under these



WEB COPY

7. The defendant filed a written statement. They stated that they are carrying on business in manufacturing and marketing and selling various kinds of edible oils, lamp oils, agricultural products, food products, dhals, dairy products and cosmetic products. They claimed to be the largest sunflower oil manufacturers in India and the brand “Gold Winner” was ranked among the top 100 FMCG consumer brands in India and is 'Number One' in the edible oil category in South India. The defendant had conceived the mark “Gold Winner” in January 1993 and had been using the same continuously till date with respect to various types of edible oils including refined Sun Flower Oil, Vanaspati, dhalls and other goods.

8. The defendant also stated that in January 1993 there was no other entity using the said mark. The defendant therefore claimed that the mark “Gold Winner” has become distinctive and identifiable only with the defendant. It is an arbitrary mark coined and promoted by the defendant. The defendant claimed to be the exclusive proprietor of the mark “Gold Winner”. It was also claimed that the mark is exclusively associated only with the defendant. The mark had been registered in class 29 in Trademark Registration No. 605323 dated 27.08.1993. The defendant is also the registered proprietor of the Trademark “Gold Winner”, “Shree



1399087 and 1399088 in class 30.

WEB COPY

**9.** The defendant had also given the details of their registrations in the written statement. They had also given the details of their international Trademark registrations in the written statement. They had also obtained Copy Right registration, which details had also been given in the written statement.

**10.** The defendant also claimed that their Trademark “Gold Winner” had become a household name. The public also associated the mark “Gold Winner” only with the defendant.

**11.** The defendant launched a range of dhall products in September 2005 under the name “Gold Winner” “Shree Gold”. The defendant came across the plaintiff's Trademark registration in February 2006 and to protect its interests, filed a Rectification Petition before the Trademark Registry at Chennai for removal of the plaintiff's mark. It had been stated that the defendant had rebranded its dhall products in late 2016 from “Gold Winner” “Shree Gold” to “Gold Winner”.

**12.** The defendant claimed that the plaintiff was aware of



the defendant's Trademark “Gold Winner” since it had been widely published and advertised. The defendant had stated that they had established extensive sales of the products under the mark “Gold Winner” including in the dhal segment. They had also expended substantial amounts towards advertising their products. They also claimed that they are the prior user of the Trademark “Gold Winner” which they have been using since 1993. It had also been stated that the plaintiff's registered Trademark is in respect of a label mark consisting of several components such as the words “Gold Winner”, the device of a running man, the text, trade mark, toor dhal and several other parts.

**13.** The defendant claimed that the plaintiff did not have a separate registration for the word mark “Gold Winner” and therefore stated that the plaintiff has no exclusive right over the said word mark “Gold Winner”. It had also been stated that the plaintiff had not produced any document to show the use of the mark in the retail sales of dhalls. It is merely used as a descriptive on the bills. The dhalls manufactured by the plaintiff are sold in plain plastic packets which do not contain the registered label. It had been stated that 'SNR Dhal' was the trade name of the plaintiff and not the words “Gold Winner”.



**14.** The defendant also stated that they had engaged the services of a Private Investigating Agency, who concluded that the plaintiff is selling dhalls under different brand names and the Trademark “Gold Winner” was not mentioned in any of the packets that were lying around in the plaintiff's factory premises and in the shops / trader stores. It had been stated that the 5 kg packaging containing dhalls of the plaintiff has a totally different mark from the registered mark.

**15.** It had been stated that however the defendant had been using the mark “Gold Winner” for dhalls packaged as 500 gms, 1kg and lesser quantity packs. The plaintiff, on the other hand is not using the mark “Gold Winner” for sales in the retail segment. It had been claimed that the plaintiff was confined to wholesale business which is also reflected in the FSSAI Certificate, which had been filed along with the plaint. It had been claimed that the plaintiff was falsely stating that they have a presence in the retail market. It had been stated that however the products of the defendant are available across India.

**16.** It had also been stated that a comparison of the two marks would show that they are totally different and there is no likelihood of confusion in the minds of customers. The defendant's packaging is in the



same style with respect to font and appearance as that of their earlier packaging “Shree Gold”. It had been stated that the class of consumers are different. The plaintiff's customers are wholesale trades but the defendant's customers are retail purchasers. It had also been claimed that the defendant had been using the mark “Gold Winner” since 1993 and that therefore, they are the prior adopter of the mark. It had been stated that the suit should be dismissed.

17. The defendant also gave parawise denials for the averments made in the plaint.

18. On the basis of the pleadings, the following issues were framed for trial by order dated 26.07.2019:-

*“1. Whether the defendant's act of selling dhall products by changing their existing packaging style, get up & colour combination from "SREE GOLD" to "gold winner" will amount to infringement of registered trademark of the plaintiff and passing off?*

*2. Whether the defendant has any registered trade mark for the mark “gold*



WEB COPY

winner” class 30 in respect of dhall ?

3. Whether the defendant's registration of trademark “gold winner” in class 29 in respect of edible oils will give any right in class 30 in respect of dhall as well ?

4. Whether the defendant's registration of the trademark SREE GOLD” label in class 30 for dhalls will also give any protection to the term “gold winner”?

5. Whether the trademark “GOLD WINNER (LABEL)” has been coined and honestly adopted by plaintiff ?

6. Whether the plaintiff is the registered proprietor of the trademark “GOLD WINNER” ?

7. Whether trademark registration of a device mark grants exclusive rights to the word mark alone when such word mark is only a part of the whole of the registered trademark?



WEB COPY

8. *Whether the plaintiff has proved actual use of the registered trademark "GOLD WINNER (LABEL) "?*

9. *Whether the image of the plaintiff's 5 kg product bag is consistent with the registered trademark "GOLD WINNER (LABEL) " under application NO.1232740?*

10. *Whether the plaintiff adopted the trademark "GOLD WINNER (LABEL) " before the defendant's mark "GOLD WINNER "had already earned a reputation in the market ?*

11. *Whether the plaintiff has sold dhal under the trademark "GOLD WINNER" in the retail market ? If yes, what is the plaintiff's turn over in the retail market ?*

12. *Whether the invoices produced by the plaintiff in respect of its 5 kg " GOLD WINNER (LABEL) " bags are genuine or forged ?*

13. *What are the plaintiff's expenses towards advertisement/ publicity in respect of*



WEB COPY

*dhalls under the trademark “GOLD WINNER (LABEL)” ?*

*14. Whether the copyright registrations done by the defendant will give any right to the defendant to use the trademark “gold winner” for their dhal products ?*

*15. Whether the defendant has estopped their rights over the trademark “GOLD WINNER” in respect of dhal products by withdrawing the rectification/cancellation petition filed by the defendant before the Trademark Registry against the plaintiff's registration of the trademark “GOLD WINNER “in class 30 in respect of dhal products ?”*

19. The parties were then invited to adduce evidence. The plaintiff examined R.Surendaran, Managing Partner as PW-1 and D.Agilesh Kanishkar, as PW-2. He was examined to speak about sales by the plaintiff's dhal in 5 kgs bags. The plaintiff marked Exs. P-1 to P-41. Ex.P-1 is the registration certificate and other related documents of the mark “Gold Winner” dated 19.09.2005, Exs. P-2 to P-8 are the partnership registration certificates and related documents including TIN Certificate and



along with invoices, Ex.P-11 is the image of the defendant's products along with invoices, Ex.P-12 is the order of the Trademark Registry permitted withdrawal of the cancellation petition filed by the defendant. This is dated 30.01.2013, Ex.P-18 were invoices relating to sales of 5 kgs dhal of the plaintiff, Ex.P-21 was the legal user certificate of the plaintiff's registered Trademark, Exs.P-22 to P-34 are the documents relating to the Trademark Registry including application for Trademark, search for Trademark and Online status of Trademark and Trademark registration certificate, Ex.P41 is the document relating to the mark "ELDIA".

**20.** During cross examination of the plaintiff's witness, the defendant marked Exs. D-1 to D-6. Ex.D-1 is a notice sent by Trademark Registry dated 21.05.2018, Exs.D-3, D-4 and D-6 are the photographs produced by the witness.

**21.** The defendant examined A.Saravanan, Manager – Legal and authorised Signatory of the defendant as DW-1.

**22.** The defendant also produced Exs. D-7 to D-52. The Trademark registration Certificate for the mark "GOLD WINNER" by the defendant had been marked as Exs. D-12 to D-35, the Trademark



Registration in Singapore, Malaysia, United States of America and Australia were marked as Exs. D-36 to D-42, the advertisements made by the defendant had been marked as Exs. D-43 and D-44, the Online status of the application of the plaintiff for Trademark Application dated 13.01.2018 in No. 37266 of 2016 in class 30 was marked as Ex.D-45. The proceedings before the Intellectual Property Appellate Board were marked as Exs. D-47 to D-52.

**23.** Heard arguments advanced by Mr. Ravikumar Paul, learned Senior Counsel for the plaintiff and by Mr. P.S. Raman, learned Senior Counsel for the defendant.

**24.** Mr. Ravikumar Paul, learned Senior Counsel took the Court through the pleadings and the documents. He pointed out Ex. P 1 and Ex. 21 the Registration Certificate and the Legal User Certificate with respect to the Trade Mark, Gold Winner, registered in the name of the plaintiff, in Class 30, with specific reference to Toor Dhall. He also pointed out that the plaintiff has no right to claim exclusive proprietorship over the Device of Man and other descriptive matters. However, learned Senior Counsel was emphatic in asserting the right of the plaintiff over the Mark, Gold Winner. Learned Senior Counsel also pointed out the abandoned



challenge launched by the defendant to the mark and the documents, including Ex. P 13 in relation thereto. The defendant withdrew their challenge. He stated that the defendant had a registration, Ex. D 25, for the word Shree Gold under Class 30. He also pointed out Ex. P 30, the Search Report and Ex. P 22, the Online Status of the mark. Learned Senior Counsel also pointed out Exs. P 23, 25, 26, 27 and 28 and asserted the right of the plaintiff. He further stated that it is the case of the defendant, that in later 2006, they had apparently rebranded their products with respect to Dhall items. The defendant, who had a registered mark, Shree Gold, however changed it to Gold Winner, bringing it closer to the mark of the plaintiff. He pointed out the earlier withdrawal of the opposition by the defendant to the plaintiff's mark and its withdrawal, and questioned the bonafide of the defendant in unilaterally adopting the mark Gold Winner even for Dhall items, when they have registration or authority to use the mark for Dhall items, particularly, Toor Dhall.

**25.** Learned Senior Counsel also pointed out that the registered mark of the defendant was Gold Winner Shree Gold. This is apparent in Ex. D 33. However, in Ex. D. 36, only Shree Gold is mentioned.

He seriously disputed the claim of the defendant that they are entitled to use the mark Gold Winner, across classes of goods and services since it is a well



known mark. He pointed out that the defendant had applied for recognition of the mark Gold Winner as a well known mark under Rule 124 of the Trade Mark Rules, only subsequent to the suit on 22.10.2018. He brushed the defence taken by the defendant that they are marketing their Toor Dhall products in the retail sector, while claiming that the plaintiff has a market only in the whole sale sector. Learned Senior Counsel emphasised on the fact that the plaintiff has a registration of the mark, while the defendant does not have registration, in so far as goods falling under Class 30 are concerned. Learned Senior Counsel pointed out the invoices in Ex. P 18 filed by the plaintiff in this regard. With respect to the investigation in this regard said to have been undertaken by the defendant, the learned Senior Counsel urged that Ex. D 46, the Investigation Report should be rejected since a xerox copy had been filed and the named Investigator had not been examined as a witness. He also pointed out that the places mentioned in the invoices were not examined by the investigator.

**26.** Learned Senior Counsel placed reliance on Section 29 (2) © of the Trade Marks Act, 1999, and stated that both the marks are the same for the same class of goods, and therefore insisted that the presumption under Section 29 (3) should be drawn.



**27.** Mr. P.S. Raman, learned Senior Counsel for the defendant very seriously disputed the contentions raised and put forth by Mr. Ravikumar Paul.

**28.** Mr. P.S. Raman was emphatic in his submission that the mark, Gold Winner was and is indeed a well known mark identifiable only with defendant right from 1993. He claimed that it was the defendant alone who had coined it, promoted it and established it among the trade circle, He also pointed out that the mark has been recognised as associated only with the defendant and is nationally known. He pointed out the documents filed by the defendant in this regard. He therefore questioned the very usage of the mark by the plaintiff and asserted such usage was not at all bonafide. He pointed out that the words, Gold Winner, are coined words with no connection with each other, when used either in conjunction or separately. The mark is also not generic. It has nothing to do with either Toor Dhalls or even with Edible Oils. He wondered at the coincidence of the plaintiff adopting the said mark, when the defendant have been using it to the knowledge of not only traders but also consumers and the mark had always been identified only with the defendant and never with the plaintiff. He further claimed that the plaintiff had never used the Registered mark in retail business and pointed out the Material Object, a 5 kg gunny bag,



produced. He pointed out that retail business had not been mentioned in the plaint. He also pointed out that the invoices had not been filed along with the plaint.

**29.** Learned Senior Counsel also pointed out the difference in the writing of the words, Gold Winner in the marks of the plaintiff and the defendant and stated that the Division Bench while considering the plaintiff's applications seeking injunctions, had vacated the order of injunction granted with respect to infringement of registered mark, and had confirmed the injunction relating to passing off. He stated that the plaintiff are only in wholesale business, while the defendant is in retail business, and therefore pointed out the improbability of the goods of the defendant being mistaken to be the goods of the plaintiff, since the class of distributors and consumers are different. Learned Senior Counsel pointed out that likelihood of confusion in the minds of the customers must be established, before the defendant can be restricted, on the ground of passing off, from using the mark, Gold Winner.

**30.** In effect, Mr. P.S. Raman encompassed his arguments under five points, namely, the bonafide of the plaintiff for the very usage of the mark, Gold Winner, the doubt whether the plaintiff is actually using the



mark on their products, the fact that the plaintiff is in wholesale market and the defendant is in retail business, whether the plaintiff can take advantage of one part of the registered mark, and seek injunction against the defendant, who also has registration of the same mark, albeit in another class, and the likelihood of confusion among the tradesmen and consumers, since, evidently the distribution channel and the class of consumers are different in both cases.

**31.** Learned Senior Counsel addressed each of the points in much detail with reference to the Exhibits marked and evidence recorded. He stated that the defendant has been using the mark, Gold Winner from 1990 onwards and from 1993 in the unique stylized manner. He pointed out the Registration Certificates, Exs. D 12 to 42, in connection with registrations of trademark, copyright both in India and Overseas, and challenged the plaintiff to disclaim knowledge of such registration or adoption of the mark by the defendant, when the plaintiff first came to use the mark. He based his arguments on the theory of Zone of Expansion, and stated that the defendant has a right to use the mark Gold Winner, which has gained substantial reputation for products in Class 29, even for products in Class 30. He questioned the bonafide of the plaintiff in using the mark,



food market. He reiterated that the plaintiff was marketing their Toor Dhall only in the wholesale market, and justified that as a reason for withdrawal of challenge to usage of the mark. Learned Senior Counsel also questioned the right of the plaintiff to seek injunction, particularly when they claim injunction only with one part of their device mark, and as against a well established mark. Learned Senior Counsel urged that the Court should dismiss the suit.

**32.** I have carefully considered the materials on record and the arguments advanced.

**33.** Even before examining the issues framed for trial, it would be advantageous to illustrate the trademark of the plaintiff and the defendant.

**34.** The Registered trademark of the plaintiff is as follows :



35. The mark of the plaintiff as found in M.O.1, 5 kg bag is as follows :



36. The Registered trademark of the defendant is as follows

:



37. The mark of the defendant complained as an infringement by the plaintiff is as follows :



**Issue No. 5 & 10 :**

38. These issues relate to the adoption of the trademark

<https://hcservices.ecourts.gov.in/hcservices/>

Gold Winner (Label) by the plaintiff. It has been asserted by the defendant



that they had coined the said mark, way back in the year 1990 and have been using it continuously since that time. They also claim that they are using the particularly stylized form from the year 1993. They also have the benefit of registration, albeit, admittedly under Class 29, relating to edible oils.

**39.** It is the contention of the plaintiff that they had however independently and without reference to the existing mark of the defendant, coined the name God Winner for their products falling under Class 30, name Dhalls, and more specifically, Toor Dhalls.

**40.** Issue No. 4 concerns whether adoption of an existing mark in the name of the defendant by the plaintiff is honest and whether the plaintiff coined the words Gold Winner independently, and Issue No. 10, is whether the plaintiff had adopted their trademark before the defendant's mark had earned a reputation in the market.

**41.** That the defendant has a considerable presence in the market using their brand name Gold Winner for edible oils cannot be denied or disputed. They are in retail business, which is all the more reason to presume that if the plaintiff pleads ignorance of the very usage of the mark



Gold Winner, it should be taken with a pinch of salt. Be that as it may, it would be fruitful to examine the evidence on this aspect particularly the cross examination of PW 1 :

**Q5 :** *Who in the plaintiff's family conceptualised the mark Gold Winner ?*

**A :** *All family members.*

....

**Q13 :** *When was the word Gold Winner coined by the plaintiff's firm ?*

**A :** *1999*

....

**Q16 :** *"Gold Winner" was coined by the plaintiff on what basis can you explain ?*

**A :** *We had been selling dhall, pulses and flour in the brand name of Winner since 1993, and with the sale had been improving and with view to give better quality we thought of word like Super Winner etc and then finalized on the word Gold Winner.*



**Q119:** *I put it to you that the Gold Winner have already been coined by the Defendant and you have merely copied the same for dhall.*

*What do you have to say ?*

**A :** *It is not so.*

**Q120:** *Is it true that only from the year 1999, the plaintiff has been using the word "Gold Winner: ?*

**A :** *Yes.*

**42.** It must be emphasised that the witness has admitted that the defendant had also changed their brand name from 'Winner' to 'Gold Winner'. This was in 1999. By 1999, the plaintiff had already established the mark Gold Winner in the market. I am not able to accept to the fact that the plaintiff were totally unaware of the mark Gold Winner, when they adopted the mark in the year 1999. If they had adopted the mark, inspite of the mark being prominently used by the defendant, then the usage or adoption of the mark by the plaintiff cannot be said to be honest. If they claim total ignorance of the existence of the mark in the market, then it can be reasonably presumed that the witness had not disclosed the truth in the witness box. Either way, the plaintiff is a later user of the mark Gold Winner. The dispute in the present lis is with respect to the mark Gold Winner and the right or otherwise of the defendant to use. The defendant is



adopted the mark earlier to the plaintiff. I have no hesitation to hold that the plaintiff cannot proclaim ignorance of a prominent mark in the market.

Therefore, I hold that the usage or subsequent adoption of the mark from Winner to Gold Winner by the plaintiff is tainted with an underlying object to ride on the reputation already built by the defendant.

**43.** I therefore hold Issue No. 4 against the plaintiff.

**44.** With respect to Issue No. 10, it is clear that by 1999, when the plaintiff first came to use the mark Gold Winner, the plaintiff had already established a significant presence of their mark Gold Winner for edible oils. Thus, I answer this issue also against the plaintiff, holding that they did not adopt the trademark Gold Winner (Label) before the defendant's mark Gold Winner had already earned a reputation in the market.

**Issue Nos. 6 & 7 :**

**45.** These issues relate to whether the plaintiff is the registered proprietor of the trademark, Gold Winner, and whether registration of a device mark would grant exclusive right to the word mark alone when such word mark is only part of the whole of the registered



WEB COPY

46. Ex.P 1 is the Registration Certificate issued by the Trade Mark Registry. The plaintiff had also filed Ex.P 21, the Legal User Certificate. It is seen that the plaintiff's mark is registered under Class 30, Toor Dhall. The Registration Number is 1232740. The registration is for Gold Winner (Label), with the device of a running man. An illustration of the mark had been reproduced supra. It has been registered with a disclaimer against exclusive use of the image of the running man. This is a device mark.

47. That the plaintiff has the benefit of a registered trademark cannot be denied or disputed. But the further fact to be examined is whether such registration would give exclusive right to the plaintiff, particularly, when the defendant has also registered the mark Gold Winner Shree Gold Winner, also in Class 30. An illustration of the said mark has also been reproduced supra.

48. 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*



**SC 558**, observed as under in paragraph 6 as follows:- "

WEB COPY

*“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.”*

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



WEB COPY

*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."*

50. 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.

51. It was further observed by the Supreme Court in the above decision that, merely because the labels were registered subject to the following disclaimer:-



WEB COPY

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

**52.** 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."

**53.** 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:-

WEB COPY

*"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."*



WEB COPY

54. 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."*

55. In *Amritdhara Pharmacy Vs. Satya Deo Gupta, (1963)*

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



WEB COPY

*“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 (Bir- mingham) Ltd. Application*



WEB COPY

*[(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".*

**56. 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*



WEB COPY

*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".*

57. The above precedents had 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.

58. An analysis of the above binding precedents would indicate that the plaintiff, who has registration for the mark Gold Winner



(label) with disclaimers, certainly question the mark Gold Winner used by the defendant, in view of the registration of the mark Gold Winner Shree Gold by the defendant. Moreover PW 1 admitted that they are not using the registered mark in their packagings, particularly even in MO 1 which had been produced by the plaintiff.

**Q132:** *Please refer to Ex P1 and MO 1. Is the plaintiff firm using the registered label mark as seen in Ex P.1 in the alleged packing of 5 kg filed as MO 1 ?*

**A :** *No.*

**59.** As held in ***F.Hoffmann-La Roche &Co.Ltd v. Geoffrey Manner & Co. (P) Ltd., (1969) 2 SCC 716,*** “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.”



60. An analysis of the judgments quoted and the evidence presented would clearly show that the plaintiff can maintain a claim for injunction only when the two marks are compared as wholes. If done so there is no scope of confusion.

61. Section 17(2) of the Trademarks Act is as follows:-

***“section 17(2) in The Trade Marks Act, 1999 ”***

*(2) Notwithstanding anything contained in sub-section (1), when a trade mark—*

*(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.”*



**2011 (4) LW 55**, it had been held that :

WEB COPY

*“Therefore in cases arising under 1958 Act, the exclusive right to the use of a trade mark conferred by Section 28(2), depends upon the question as to whether or not any disclaimer was incorporated in the certificate of registration. On the other hand, if the case arises under the 1999 Act, the exclusive right to the use of the mark, in terms of Section 28(2), is made subject to the limitations incorporated in Section 17(2) itself. In other words, the exclusive right conferred by Section 28(2) was circumscribed under the old Act by man made restrictions (in the form of disclaimer imposed by Registrar). But it is now circumscribed by statutory restrictions under the 1999 Act. Therefore, the strong reliance placed by the learned counsel of the plaintiff upon the decision in Ramdev Food Products is of no use.*

(iii) *Therefore, a registered proprietor of a trade mark cannot succeed in an action for infringement, in respect of that element or part of the trade mark, for which protection is unavailable either on account of a disclaimer incorporated in the Certificate itself or on account of the statutory prescription contained in Section 17 (a)(2)”*



WEB COPY

**63.** I therefore hold with respect to Issue No. 6 that the plaintiff is the registered proprietor of the trade mark Gold Winner, but that, with respect to Issue No. 7 that the plaintiff cannot claim exclusive right since the words Gold Winner is only a part of the whole of their registered trademark. Even though Issue No. 6 is answered in the affirmative in favour of the plaintiff, Issue No. 7 is answered against the plaintiff.

**Issue Nos. 8, 9, 11, 12 & 13 :**

**64.** All these issues are taken up for discussion together, because they require the same deliberations. In effect, they relate to the usage of the trademark Gold Winner (Label) by the plaintiff, and whether they maintain consistency in adopting the mark in all their packagings and whether they have foraged into retail market.

**65.** It is the contention of the plaintiff that they had filed Exs. P 9, P 18 and P 19 in addition to the certificate of registration to establish usage of the mark. They had also filed invoices.

**66.** It is also claimed that if the device of the running man is left out, then the distinct words left in the mark affixed on MO 1 would be



the words, Gold Winner, and other descriptive terms. It is therefore contended that the mark used in MO 1 is consistent with the registered mark.

**67.** With respect to the issue whether the plaintiff is engaged in marketing their products only in the whole sale market and not in the retail market, it is the contention of the plaintiff, that this is a factor which will have no effect on the right of a registered proprietor of a trademark. It is claimed that registration protects both whole sale and retail sales. They again relied on Exs. P 18, P. 19 and MO 1 in this regard.

**68.** It is also claimed that the plaintiff being a traditional partnership firm had never classified their revenue separately for whole sale and retail sales. Reliance is placed on Ex P 9, the Certificate for the Chartered Accountant, in this regard.

**69.** With respect to advertisements, it is claimed that the plaintiff, being in the business for around 3 decades had never spent money on advertisement. It is claimed that advertisements can never be a yardstick for proving the use of a trademark. It had been stated that invoices and bills will project a better picture, and the plaintiff relied on the invoices



produced.

WEB COPY

**70.** The defendant however contends otherwise with respect to all the above issues.

**71.** A simple comparison is invited to examine the registered mark of the plaintiff and the mark as found in MO 1. It is claimed that the plaintiff has not proved consistent usage of the registered mark.

**72.** With respect to sales, it is contended by the defendant, that the invoices produced by the plaintiff, even if accepted, substantially relate only to wholesale sales. It is claimed that the plaintiff had not produced any proof to establish that they are marketing Toor Dhall in 5 kg packets. It is claimed that the invoices, Ex.P 18 have been prepared for the purpose of the case. Reference is drawn to the net weight, namely 25 kgs/50 kgs have been mentioned and the total quantity does not correspond to the actual net weight.

**73.** The explanation given by the plaintiff for not spending on advertisements have been questioned by the defendant.



WEB COPY

74. The evidence will have to be examined.

75. The cross examination of PW 2, a retailer of the plaintiff is quite revealing.

**Q35 :** *Basically, you do wholesale business ?*

**A :** *Wholesale, retail, distributor, stockist.*

**Q36 :** *Can you give me a break up of the wholesellership, retail sales, stockists and distributorship ?*

**A :** *Wholesale and distributorship 70 to 60 % apporximately. Then retail will be around 20 or 25 %.*

**Q63 :** *Have you filed any document before this Hon'ble Court to state that whole sale business is 80 % and retail business is 20 % ?*

**A :** *No.*

**Q118 :** *Have you anywhere in your proof affidavit state that you sell gold winner orid dhall in 500 grams or 1 kg ?*

**A :** *No.*

76. The plaintiff should realise that mere statements are not sufficient. When the witness grazes box with specific knowledge that the plaintiff does atleast 20% business through retail sales, then document to



that effect has to be produced. The statements remain just statements in the absence of proof. The very truth of the statements of PW 2 were seriously put to test during cross examination, with the defendant even suggesting that he is deliberately telling a false statement with respect to carrying on business in the shop mentioned in his proof affidavit. I must hold that the evidence of PW 2 does not inspire confidence at all, and has to be rejected.

77. The plaintiff produced MO 1, a 5 kg bag. Unfortunately the mark on that bag was substantially different from the registered mark of the plaintiff. Explanations to questions put to PW 1 in this regard were not at all inspiring.

**Q83 :** *Please see MO 1. Does it anywhere state that the FSSAI registration for the dhal packed in similar to MO 1 is in anyway connected to S.N. Rathinaswamy Nadar and Sons ?*

**A :** *No.*

**Q132 :** *Please refer to ExP1 and MO 1. Is the plaintiff firm using the registered label mark as seen in Ex. P 1 in the alleged packing of 5 kg filed as MO 1 ?*

**A :** *No.*

**Q134 :** *Please refer to MO 1. Have you mentioned who are the*



*manufacturer and who the packer is in this alleged packing marked as MO*

WEB COPY I ?

*A : No, not mentioned.*

**78.** I wonder, how the Court can accept MO 1 in the face of the above answers to the questions put to the witness. I am not prepared to uphold the contention and explanation of the plaintiff with respect to the image of the mark in MO 1, 5 kg packet of the plaintiff. It is not consistent with the registered mark.

**79.** The evidence of P.W.2 with respect to retail sales has already been rejected by me. MO 1 has also been rejected. It must be pointed out that when the plaintiff claims that they are in retail business, production of admissible and proved documents to that effect should not have strained them to the extent to which they have evidently put themselves to. Either, they have evidence, or they do not have evidence. They can always claim to be in the wholesale market alone, and still claim protection. However, having taken a stand that they have foraged into the retail market, the burden is heavily on the plaintiff to establish that fact.

They have failed to discharge such burden. Unfortunately, the evidence that

had been adduced actually leads to a lurking suspicion on the very basis of



their case.

WEB COPY

**80.** I am not prepared to give much credence to the investigation said to have been done by the defendant, even though the plaintiff did not challenge or test it during the cross examination of D W 1. It is for the plaintiff to establish their case. They have failed to do so. The witness in box kept shifting knowledge to others, who have not been examined.

**Q21 :** *Who looks after the plaintiff's sales details and how much you are aware ?*

**A :** *I do not know the sales details of the plaintiff's firm. The same is looked after one Mr. Saravana Kumar my brothers son.*

**Q98 :** *In the plaint and/or the documents filed have you specified either in volume or value the dhall sold by the plaintiff in the last 5 years at least under the packing in M O 1?*

**A :** *It is impossible to give such a break up.*

**81.** I can only state that the facts stated in a plaint should not strain the witness who has to speak about the facts pleaded.



**82.** With respect to Ex. P 9, it must again be pointed out that it remains what it is, a mere document. It has not been proved in manner known to law. Supporting documents have not been produced. No credence can be placed on it.

**83.** It is thus seen that the plaintiff had hardly proved the issues under consideration.

**84.** I hold that the plaintiff had not proved the actual use of the registered trademark Gold Winner (Label). Issue No. 8 is answered against the plaintiff.

**85.** I hold that the image in MO 1, 5 kg bag is not consistent with the registered trademark Gold Winner (Label). Issue No. 9 is answered against the plaintiff.

**86.** I hold that the plaintiff has not established continuous presence in the retail market. They have also not established their turnover in the retail market. Issue No. 11 is answered against the plaintiff.

**87.** I am not convinced with the invoices produced. With



respect to Issue No. 12, I hold that the invoices have not been proved by the plaintiff in manner known to law.

**88.** With respect to Issue No. 13, I hold that the plaintiff has not proved their expenses towards advertisement with respect to Toor Dhalls marketed under the trademark Gold Winner (Label).

**Issue No. 14**

**89.** This issue relates to the registrations of the defendant under the Copyright Act, 1958. The defendant has produced 8 Copyright registrations in Exs. D 28 to D 35. Three of them relate to Dhalls. Registration with respect to Toor Dhall is A-78063/2007 dated 09.01.2007. The defendant has a right to seek protection of such registration in case of infringement. However, as discussed above, the trademark of the plaintiff, Gold Winner (Label) is totally different in colour combination, trade dressage and the font in which the words are written. Copyright relates to the artistic work, and the defendant is certainly entitled to seek protection. But that would not give any right to the words as such. However, it had been held that the defendant are neither infringing the registered trademark of the plaintiff, nor are they passing off their products as if they are the products of the plaintiff. The plaintiff has also not laid the suit on the basis of infringement of any copyright. The issue is answered accordingly



reiterating the right of the defendant over the registered artistic work.

WEB COPY

**Issue Nos. 1, 2, 3, 4 & 15 :**

90. The plaintiff had filed the suit on the strength of their registered trade mark, Gold Winner (Label) for Class 30 relating to Toor Dhall. The Registration Certificate had been filed as Ex. P1 and the Legal User Certificate as Ex. P 21. The defendant have Registration Certificates for the trade mark Gold Winner in Class 29, in relation to Edible Oils. They had raised an objection to the registration of the trademark certificate in favour of the defendant, but had withdrawn the same.

91. The defendant however have a registration under Class 30 also, in the name Shree Gold prominently.

92. So long as the defendant were marketing products under Class 30 in the name Shree Gold, the plaintiff had not raised any issue. However, the defendant appear to have rebranded their products and commenced sales of Toor Dhall in retail market under the name Gold Winner. This has been the immediate cause for institution of the suit.

93. Illustrative representations of the marks have been reproduced at the beginning of the discussion.



WEB COPY

94. It has to be examined whether by usage of the mark, Gold Winner, the defendant had encroached on the reputation and goodwill built by the plaintiff particularly in retail sales of Toor Dhall. It has been the claim of the defendant that the plaintiff has not been put to loss since, the plaintiff is only into wholesale business and have not entered into the retail market. That particular stand had been upheld in the foregoing discussions. It had also been held that the registration of the trademark, Gold Winner (Label) by the plaintiff, will give the plaintiff only a restricted right as provided under Section 17 (2) of the Trade Marks Act, 1999. As a matter of fact, in the instant case itself, a Division Bench while examining the issue of infringement of Trademark had interfered with the grant of injunction restraining the defendant from infringing the registered trademark of the plaintiff. That finding is only strengthened on analysis of evidence. Issues in that regard have been answered against the plaintiff.

95. In *Cadiulla Healthcare Limited -vs Cadilla Pharmaceuticals Limited*, reported in (2001) 5 SCC 73, the Hon'ble Supreme Court held that :



*passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered :*

*a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.*

*b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.*

*c) The nature of the goods in respect of which they are used as trade marks*

*d) The similarity in the nature, character and performance of the goods of the rival traders.*

*e) The class of purchasers who are likely to purchase the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.*

*f) The mode of purchasing the goods or placing orders for the goods and*

*g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.”*

**96.** A comparison of the trade of the plaintiff and the

defendant would indicate that the plaintiff is in wholesale business and the



defendant is in retail business. Evidence to the contrary by the plaintiff have been rejected. The plaintiff may remain content with wholesale business. Thus the very nature of the business is different. This would indicate that the distribution channel of the respective products would also be different. Specific orders are placed in wholesale trade and the Toor Dhalls of the plaintiff are supplied directly to those who place such orders. The plaintiff on the other hand is dependent on their sales on customers who purchase products off the shelves in shops and stores. Thus not only are the nature of sales different, but the customers are also different. The two classes of customers can never overlap. I therefore hold there can be cause for confusion either in the minds of the tradesmen or the customers between the products of the plaintiff and the defendant.

97. It is also seen that registration of the trademark Gold Winner (Label) had been held to be of no assistance to the plaintiff in injuncting the defendant in adopting the mark Gold Winner, even for Toor Dhalls. Applying the ration in *Cadilla (referred Supra)*, the phonetic similarity is the only similarity between the marks. The products may be the same, but the packagings are totally different. To repeat, the distribution channel, the manner in which the products are marketed and the targeted customers/consumers are all different. The purpose for the the products are



purchased are also different. One is for wholesale consumption, the other is for retail consumption.

**98.** There is also no similarity in the marks per se. The fonts are different. The colour combination is different. The impression on the packet is different. The size of the packaging is different. They both operate in different markets and different spheres. The mode of purchasing the goods and the mode of placing orders for purchase are also different. The customers of both the plaintiff and the defendant belong to different classes. A wholesale purchaser can never get his Toor Dhall from the defendant. A retail purchaser can never get his Toor Dhall from the plaintiff. The quantity of Toor Dhalls in the packaging of both the products are different. The plaintiff would require a gunny bag to pack wholesale quantity of Toor Dhall. The defendant would package their product in smaller sized covers, certainly not in gunny bags.

**99.** Thus with respect to Issue No. 1, I hold that the act of the defendant in selling their Toor Dhall products in the name Godl Winner, would neither amount to infringement of trademark of the plaintiff nor can be categorised as passing off their products as if there are the products of the plaintiff. Issue No. 1 is answered against the plaintiff and in favour of



the defendant.

WEB COPY

**100.** With respect to Issue Nos. 2, 3, 4 & 15 I must hold that though the defendant has no registered trademark in the name Gold Winner under Class 30, and registration under Class 29 can be restricted to Class 29 alone, and whether the defendant is estopped from claiming any right over the mark Gold Winner under Class 30, in view of the withdrawal of their earlier objection, I hold that the matters have moved towards the realm of the Authority where Exs. D 47 and D 52 have been filed and are pending. It would therefore be inappropriate on the part of this Court to dwell deeply into the aspects which are covered under Exs. D 47 and D 52.

**101.** The defendant had a registration of the mark Gold Winner Shree Gold in Class 30. The cause for grievance for the plaintiff is that the defendant had rebranded their mark as Gold Winner.

**102.** It has however been held in the aforesaid discussions that by the act of adopting the mark Gold Winner for products under Class 30, the defendant are neither infringing the registered mark of the plaintiff in view of the restrictions under Section 17(2) of the Trade Marks Act, 1999, nor can it be imputed that they are passing off their products as if they are the products of the plaintiff, in view of the discussions above, where it



are totally different and that the packagings are different and that the marks are both represented in a totally different manner, both with respect to the writings and also with respect to the colour combination, that therefore, there cannot be any cause for confusion.

**103.** The Issues 2, 3.4 & 15 are answered accordingly, in favour of the defendant.

**104.** In the result, the Suit is dismissed with costs.

**105.** With respect to costs, the Registry is directed and delegated by the Court to determine the costs as per the Bill / Memo of Costs submitted by the defendant in accordance with Section 35 of CPC, as amended by the Commercial Courts Act, 2015. The defendant is specifically entitled to the fees and expenses of the witness, the legal fees and expenses incurred and for any other expenses incurred in connection with the judicial proceedings.

Sd./-(C.V.K.J.)  
26.04.2021

//Certified to be true copy//  
Dated at Madras this the      day of      2021.

COURT OFFICER(O.S.)  
From 25th Day of September 2008 the Registry is issuing certified copies of the Orders/Judgments/Decrees in this format.

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



WEB COPY

2. P.W.2 – D. Agilesh Kanishkar

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

Ex.P-1 = Registration Certificate and other related documents,  
dated 19.09.2005;

Ex.P-2 = Partnership Registration Certificate, dated 11.08.2010;

Ex.P-3 = TIN Certificate, dated 11.01.2007;

Ex.P-4 = FSSAI Certificate, dated 06.05.2015;

Ex.P-5 = Partnership Deed, dated 14.09.1985;

Ex.P-6 = Partnership Deed, dated 31.03.2010;

Ex.P-7 = Retirement deed, dated 01.04.2010;

Ex.P-8 = Rectification Deed, dated 09.06.2010;

Ex.P-9 = Chartered Accountant Certificate with Invoices, dated  
20.02.2017;

Ex.P-10 = Income Tax Returns, dated 2007-2017;

Ex.P-11 = Infringing products images along with invoices, dated  
14.02.2017;

Ex.P-12 = Copy of Order by TMO- withdrawal of Cancellation  
Petition, dated 30.01.2013;

Ex.P-13 = Copy of Rectification Petition filed by the defendant,  
dated 27.02.2006;

Ex.P-14 = Copy of counter statement filed by the plaintiff, dated  
12.11.2007;

Ex.P-15 = Search copy – GOLD WINNER in Class – 29, dated



WEB COPY

01.03.2017;

Ex.P-16 = Search Copy – SHREE GOLD in Class – 29, dated 01.03.2017;

Ex.P-17 = Advertisements by defendants in Television and Bus;

Ex.P-18 = Invoices related to sales of 5 kg dhall packed of the plaintiff;

Ex.P-19 = Bag of 5 kg packet of he plaintiff;

Ex.P-20 = Bag of Shree Gold bag sold by the defendant;

Ex.P-21 = Legal User Certificate of the plaintiff's registered trademark, dated 22.02.2017;

Ex.P-22 = Online Status of the trademark application No. 1399087, dated 15.07.2017;

Ex.P-23= Online Status of the trademark application No. 1399088, dated 15.07.2017;

Ex.P-24 = Online Status of the trademark application No. 15.07.2017;

Ex.P-25 = Certified copy of trademark application No.1399085, dated 10.07.2017;

Ex.P-26 = Certified copy of trademark application No. 1399087, dated 10.07.2017;

Ex.P-27 = Certified copy of trademark application No. 1399088, dated 10.07.2017;

Ex.P-28 = Trademark Search for the mark SREE GOLD in class 30, dated 28.02.2017;

Ex.P-29 = Trademark Search for the mark GOLD WINNER in class 30, dated 28.02.2017;

Ex.P-30 = Trademark Search for the mark SREE GOLD in class



WEB COPY

29, dated 21.07.2017;

Ex.P-31 = Online Status of the trademark GOLD WINNER having application No. 922521, dated 22.07.2017;

Ex.P-32 = Covering letter of the applicant's counsel for filing trademark GOLD WINNER, dated 05.09.2003;

Ex.P-33 = Copy of Trademark Registration Certificate for the mark WINNER having Registration No. 606945, dated 16.09.1993;

Ex.P-34 = Copy of online status of the mark WINNER having Registration No. 606945, dated 23.07.2017;

Ex.P-35 = Image of Respondent's product (Gold Winner S.N.R.Dhall), dated 22.07.2017;

Ex.P-36 = Image of the appellant's product (Sree Gold), dated 22.07.2017;

Ex.P-37 = List of Well known Trademarks listed in the trademark office website, dated 20.07.2017;

Ex.P-38 = Letters from our dealers, dated 22.07.2017;

Ex.P-39 = Newspaper article;

Ex.P-40 = Rectification Petition filed by Mr.Raj Kumar; and

Ex.P-41 = Document relating to trademark “ELDIA”.

M.O. 1 = 5 kg bags

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



WEB COPY 4.

## List of Exhibits Marked on the side of the defendant:-

Ex.D-1 = Notice sent by Trademark Registry along with the complaints and annexures, dated 21.05.2018;

Ex.D-2 = Document printed from Food Safety and Standards Authority of India Website, document bearing FSSAI No. 12414002003188;

Ex.D-3 = Witness shown photograph of Sekar Stores;

Ex.D-4 = Eight photographs along with the invoice dated 07.09.2019 from Kannan Digital Studio and Videos;

Ex.D-5 = Online Printout taken from GST website containing GST Number;

Ex.D-6 = Three photographs of Sekar Stores produced by the plaintiff witness during cross;

Ex.D-7 = Original Board Resolution of DW-1, dated 03.11.2017;

Ex.D-8 = Company Profile & Product Portfolio of the defendant;

Ex.D-9 = Defendant's brand "GOLD WINNER" ranked 75<sup>th</sup> in India's hundred largest brands by sales' published by Brand Enquity on December 18, 2002, dated 18.12.2002;

Ex.D-10 = Defendant's brand "GOLD WINNER" ranked 63<sup>rd</sup> in India's Top 100 Fast Moving Consumer Goods Brands' published by Brand Equity on April 21, 2004;

Ex.D-11 = Copy of letter from Nielsen (India) Pvt. Ltd., confirming defendant is ranked first in volume sales with 25.7% share in sunflower oil segment, 2017;

Ex.D-12 = Trademark Registration Certificate for TM# 605323 dated 27.08.1993 for the mark "GOLD WINNER" in class 29, dated



27.08.1993;

WEB COPY

Ex.D-13 = Trademark Registration Certificate for TM# 1073117 dated 11.01.2002 for the mark “GOLD WINNER REFINED GROUNDNUT OIL” in class 29, dated 11.01.2002;

Ex.D-14 = Trademark Registration Certificate for TM# 1073118 dated 11.01.2002 for the mark “GOLD WINNER REFINED GROUNDNUT OIL” in class 29, dated 11.01.2002;

Ex.D-15 = Trademark Registration Certificate for TM# 1147963 dated 01.11.2002 for the mark “GOLD WINNER REFINED GROUNDNUT OIL” in class 29, dated 01.11.2002;

Ex.D-16 = Trademark Registration Certificate for TM# 1208513 dated 23.06.2003 for the mark “GOLD WINNER VANASPATI” in class 29, dated 23.06.2003;

Ex.D-17 = Trademark Registration Certificate for TM# 1208514 dated 23.06.2003 for the mark “GOLD WINNER VANASPATI” in class 29, dated 23.06.2003;

Ex.D-18 = Trademark Registration Certificate for TM# 1399086 dated 16.11.2005 for the mark “GOLD WINNER REFINED SUNFLOWER OIL” in class 29, dated 16.11.2005;

Ex.D-19 = Trademark Registration Certificate for TM# 2320408 dated 23.04.2012 for the mark “GOLD WINNER” in class 29, dated 23.04.2012;

Ex.D-20 = Trademark Registration Certificate for TM# 2320409 dated 23.04.2012 for the mark “GOLD WINNER (label)” in class 29, dated 23.04.2012;

Ex.D-21 = Trademark Registration Certificate for TM# 2320410 dated 23.04.2012 for the mark “GOLD WINNER REFINED SUNFLOWER OIL” in class 29, dated 23.04.2012;

Ex.D-22 = Trademark Registration Certificate for TM# 2934030 dated 01.04.2015 for the mark “GOLD WINNER REFINED SUNFLOWER OIL” in class 29, dated 01.04.2015;



Ex.D-23 = Trademark Registration Certificate for TM# 2934031 dated 01.04.2015 for the mark “GOLD WINNER REFINED SUNFLOWER OIL” in class 29, dated 01.04.2015;

Ex.D-24 = Trademark Registration Certificate for TM# 2934032 dated 01.04.2015 for the mark “GOLD WINNER REFINED SUNFLOWER OIL” in class 29, dated 01.04.2015;

Ex.D-25 = Trademark Registration Certificate for TM# 1399085 dated 16.11.2005 for the mark “GOLD WINNER SREE GOLD” in class 30, dated 16.11.2005;

Ex.D-26 = Trademark Registration Certificate for TM# 1399087 dated 16.11.2005 for the mark “GOLD WINNER SREE GOLD” in class 30, dated 16.11.2005;

Ex.D-27 = Trademark Registration Certificate for TM# 1399088 dated 16.11.2005 for the mark “GOLD WINNER SREE GOLD” in class 30, dated 16.11.2005;

Ex.D-28 = Copyright Registration Certificate No.A-63204/2003 dated 17.01.2003 for the artistic work “GOLD WINNER”;

Ex.D-29 = Copyright Registration Certificate No.A-68242/2005 dated 27.01.2005 for the artistic work “GOLD WINNER”;

Ex.D-30= Copyright Registration Certificate No.A-63205/2003 dated 17.01.2003 for the artistic work “GOLD WINNER”;

Ex.D-31 = Copyright Registration Certificate No.A-68243/2005 dated 27.01.2005 for the artistic work “GOLD WINNER Refined Groundnut Oil (1 Ltr) Label”;

Ex.D-32 = Copyright Registration Certificate No.A-68244/2005 dated 27.01.2005 for the artistic work “GOLD WINNER Refined Groundnut Oil (15 kg) Label”;

Ex.D-33 = Copyright Registration Certificate No.A-78000/2006 dated 29.12.2006 for the artistic work “GOLD WINNER SREE GOLD ORID DHALL”;



Ex.D-34 = Copyright Registration Certificate No.A-78004/2006 dated 29.12.2006 for the artistic work “GOLD WINNER SREE GOLD MOONG DHALL”;

Ex.D-35 = Copyright Registration Certificate No.A-78063/2007 dated 09.01.2007 for the artistic work “GOLD WINNER SREE GOLD TOOR DHALL”;

Ex.D-36 = Singapore Trademark Registration No. T0503379C dated 14.03.2005 for “GOLD WINNER” in class 29, dated 14.03.2005.

Ex.D-37 = Singapore Trademark Registration No. T0526845F dated 22.12.2005 for for “GOLD WINNER VANASPATI” in class 29;

Ex.D-38 = Malaysia Trademark Registration No. 05020758 dated 08.12.2005 for “GOLD WINNER” in class 29;

Ex.D-39 = Malaysia Trademark Registration No. 05021648 dated 22.12.2005 for “GOLD WINNER” in class 29;

Ex.D-40 = Certificate of Registration for TM # 1234655 dated 24.10.2014 under the Madrid Protocol, for “GOLD WINNER” in class 29;

Ex.D-41 = US Trademark Registration # 4848593 dated. 24.10.2014 for “GOLD WINNER” in class 29;

Ex.D-42 = Australia Trademark Registration # 1674105 dated 24.10.2014 for “GOLD WINNER” in class 29;

Ex.D-43 = Copy of Advertisements made for promotion of the brand “GOLD WINNER” from the year 1997;

Ex.D-44 = Copy of Advertisements made for promotion of the brand “GOLD WINNER SREE GOLD” from the year 2006;

Ex.D-45 = Printout of Online Status of the plaintiff's trademark application dated 13.01.2018, bearing No. 3726616 in class 30, for the word mark “Gold Winner”, dated 12.04.2018;

Ex.D-46 = Photocopy of EIPR India Pvt Ltd's Investigation Report, dated 05.05.2016;

Ex.D-47 = Receipt issued by IPAB for filing of Rectification of the respondent Trademark from the register by the appellant, dated



18.09.2017;

WEB COPY

Ex.D-48 = Form 1 filed before the Intellectual Property Appellate Board, dated 16.09.2017;

Ex.D-49 = Statement of case filed before the Intellectual Property Appellate Board, dated 16.09.2017;

Ex.D-50 = affidavit filed before the Intellectual Property Appellate Board, dated 17.01.2018;

Ex.D-51 = Notice sent by the Intellectual Property Appellate Board, to the plaintiff and the defendant, dated 15.10.2018;

Ex.D-52 = Covering Letter issued by the Intellectual Property Appellate Board, enclosing the order sheet dated 12<sup>th</sup> November 2018, dated 28.12.2018.

Sd./-(C.V.K.J.,)  
26.04.2021

//Certified to be true copy//

Dated at Madras this the     day of     2021.

COURT OFFICER(O.S.)

From 25th Day of September 2008 the Registry is issuing certified copies of the Orders/Judgments/Decrees in this format.