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IN THE HIGH COURT OF JUDICATURE AT MADRAS

(ORDINARY ORIGINAL CIVIL JURISDICTION)

TUESDAY, THE 14TH DAY OF SEPTEMBER 2021

THE HON'BLE DR. JUSTICE G. JAYACHANDRAN

C.S. No. 748 of 2018

Hatsun Agro Product Ltd.,
Having registered office at
No.1/20-A, Rajiv Gandhi Salai (OMR),
Karapakkam, Chennai – 600 097.
and also carrying on its business
at Old No. AD-83/ New No.AD13,
Anna Nagar, Opp.IOB Towers Branch,
Chennai – 600 040.

... Plaintiff

-Vs-

* M/s. Sri Ganapathy Dairy,
A. Partnership Firm,
Represented by its Partners,
Having office at No1,
Thairittery Street,
Kannappa Nagar,
Coimbatore – 641 027.

*** (Amended as per order dated 21.01.2020 in A.No. 9643 of 2019)**

Civil suit praying that this Hon'ble Court be pleased to pass a
Judgment and Decree :

a) For Permanent Injunction restraining the defendant by itself, its
agents, servants or any one claiming through it from in any manner



“ARUN” or any other mark or marks which are in any way identical or deceptively similar or colourable imitation of the Plaintiff's registered trademarks as described in the Schedule to the Plaintiff.

b) For permanent injunction restraining the Defendant by itself, its servants or agents or anyone claiming through it from in any manner passing off its products as that of the Plaintiff by using the offending trademark “ARUN” which are similar, deceptively similar and identical to the Plaintiff's trademark “ARUN” by manufacturing or selling or offering for sale or in any manner advertising the same.

c) Directing the Defendant to surrender to the Plaintiff the entire products with the offending labels, stocks with offending labels together with the blocks and dies, name boards, sign boards etc for destruction.

d) Directing the Defendant to render true and faithful accounts of the profits earned by them through the sale of the offending products bearing the offending trademark label and directing payment of such profits to the Plaintiff.

e) Directing the Defendant to pay to the Plaintiff the cost of the suit.

This Civil Suit having been heard on 06.09.2021 in the presence of

Mr.N.Surya Senthil & Mr.Prashant Alai for M/s. Surana & Surana,

Advocates for the Plaintiff herein and Ms.Elizabeth Seshadri, Advocate 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 said advocates for the parties hereto and this Court having observed that the plaintiff has not proved the case of infringement of its registered trademark “ARUN”, the defendant being the prior user of the mark “ARUN” for the product (GHEE) which is not marketed by the plaintiff under the said name, can have no grievance of dilution of the right since the trademark itself a generic word and nothing novel or inventive in it, the plaintiff trademark “ARUN” had no acquired a secondary meaning among the general public, the word “ARUN” per se is a common word not associated with the plaintiff or its product alone, the adoption of the name “ARUN” by the defendant for the goods “GHEE” attracts any of the categories enumerated under section 29(2) to (4) of the Trademarks Act, Contrarily, the defendant is protected under section 28(3) and section 34 of the Trademarks Act, the class of customers, the channel of Trade are matters relevant to determine passing off, however, in this case, the act of deceptive adoption of the plaintiff's trademark itself not established, the marks are not identical or similar, the goods are not identical or similar, and all the issues and answered against the defendant



That the suit in C.S.No. 748 of 2018 be and is hereby dismissed.

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2. That the plaintiff herein, do pay to the defendant herein, the costs of this suit 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
14TH DAY OF SEPTEMBER 2021.

Sd/-

ASSISTANT REGISTRAR (Comm.Cases)

//Certified to be true copy//

Dated at Madras this the day of 2022.

COURT OFFICER(O.S.)

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



ED
12.05.2022

C.S. No. 748 of 2018

ORDER :

DATED : 14/09/2021

THE HON'BLE DR. JUSTICE
G. JAYACHANDRAN

FOR APPROVAL : 13.05.2022

APPROVED ON : 13.05.2022

**WEB COPY IN THE HIGH COURT OF JUDICATURE AT MADRAS**

Reserved on : 06.09.2021

Pronounced on : 14.09.2021

Coram:

THE HONOURABLE DR. JUSTICE G. JAYACHANDRAN**C.S.No. 748 of 2018**

Hatsun Agro Product Ltd.,
Having registered Office at,
No.1/20-A, Rajiv Gandhi Salai(OMR),
Karapakkam, Chennai – 600 097
and also carrying on its business
at Old No.AD-83/New No.AD13,
Anna Nagar, Opp. IOB Towers Branch,
Chennai – 600 040.

... Plaintiff

/versus/

M/s.Sri Ganapathy Dairy,
A Partnership Firm,
Represented by its partners,
Having Office at No.1, Thair Ittery Street,
Kannapa Nagar,
Coimbatore – 641 027

... Defendant

(Amended as per Order dated 21.01.2020 in A.No.9643 of 2019)

Prayer:- This Suit is filed under Order IV Rule 1 of Original Side Rules and Order VII Rule 1 of C.P.C read with Sections 29 and 134 of the Trade Marks Act, 1999 and Sections 2(1) (c)(viii) and 7 of the Commercial Courts



(a). For Permanent Injunction restraining the defendant by itself, its agents, servants or any one claiming through it from in any manner infringing the Plaintiff's Trade Marks "ARUN" by using the trademark "ARUN" or any other mark or marks which are in any way identical or deceptively similar or colourable imitation of the Plaintiff's registered trademarks as described in the Schedule to the Plaint.

(b). For permanent injunction restraining the Defendant by itself, its servants or agents or anyone claiming through it from in any manner passing off its products as that of the Plaintiff by using the offending trademark "ARUN" which are similar, deceptively similar and identical to the Plaintiff's trademark "ARUN" or by using any other trademark which is similar, deceptively similar or identical to that of the Plaintiff's trademark "ARUN" by manufacturing or selling or offering for sale or in any manner advertising the same.

(c). Directing the Defendant to surrender to the Plaintiff the entire products with the offending labels, stocks with offending labels together with the blocks and dies, name boards, sign boards etc for destruction.

(d). Directing the Defendant to render true and faithful accounts of the profits earned by them through the sale of the offending products bearing the offending trademark label and directing payment of such profits



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(e). Directing the Defendant to pay to the Plaintiff the cost of the suit

(f). Grant such further or other reliefs as this Hon'ble Court may deem fit and proper under the circumstances of the case.

For Plaintiff : Mr.N.Surya Senthil &
Mr.Prashant Alai
for M/s.Surana & Surana

For Defendant : Ms.Elizabeth Seshadri

J U D G M E N T

This Suit is filed for permanent injunction restraining the defendant from infringing the plaintiff's trademark "ARUN"; from passing off and also as a consequential reliefs to surrender the offending labels, stocks, blocks and dies, name boards, sign board etc., for destruction; to render accounts of profits and payment of profits earned, along with costs.

2. The case of the plaintiff is that, they are the largest Dairy products manufacturers in the Private Sector involved in manufacturing and marketing of various Foods and Dairy products. Their products are known for quality. The business started as a manufacture of ice cream expanding in



production of range of dairy products like dairy whitener, skimmed milk powder, AGMARK certified Ghee, Butter, Cooking Butter, milk varieties of curd, panner and butter milk. The diversified products of the plaintiff is marketed under the various Trademarks to mentioned ARUN, AROKYA, HATSUN and IBACO. These trademarks have attained the status of the well-known trademark. The plaintiff has build up a good reputation and goodwill for all their products over the years. The said trademark are exclusively associated and identified by the trade and public with plaintiff alone and none else. The various trademarks of the plaintiff command high patronage among the public and are in great demand.

3. To substantial the same, the annual sales turn over in respect of annual expenses for the financial year 1994-1995 to 2017-2018 is relied. The list of application applied for and obtained registration in respect of the trademark ARUN is as follows:-

<i>S.No.</i>	<i>Trade Mark</i>	<i>Class</i>	<i>Filing Date</i>	<i>Number</i>	<i>Status</i>
1.	ARUN	30	09-06-1982	391526	Registered
2.	ARUN ICE CREAMS	30	29-05-1997	756404	Registered
3.	ARUN ICE CREAMS (Tamil)	30	20-01-2003	1167736	Registered
4.	ARUN ICE CREAM	30	30-01-2006	1417525	Registered
5.	ARUN ICE CREAMS	30	30-01-2006	1417526	Registered



S.No.	Trade Mark	Class	Filing Date	Number	Status
6.	ARUN	32	30-01-2006	1417527	Registered
7.	ARUN ICE CREAMS	30	30-01-2006	1417528	Registered
8.	ARUN	29	30-01-2006	1417529	Registered
9.	ARUN FAMILY	30	06-06-2006	1459477	Registered
10.	ARUN ICE CREAMS UNLIMITED	42	06-10-2008	1740571	Registered
11.	ARUN ICE CREAMS UNLIMITED	35	06-10-2008	1740572	Registered
12.	ARUN	29	28-01-2013	2467722	Registered
13.	ARUN	30	28-01-2013	2467723	Registered
14.	ARUN	32	28-01-2013	2467725	Registered

4. As a matter of abundant caution, the plaintiff has filed the application for registration of Trademark under all the classes of NICE classification by pointing out to the Trademark Registry that the Trademark ARUN is well-known mark within the meaning of Section 11(6) of the Trademarks Act, 1999.

5. It is also contended in the plaint that the sales turn over and sale promotion expenses incurred in respect of the products, manufactured and marketed by the plaintiff under distinctive Trademark ARUN alone is as under:-



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Financial Year	Annual Turnover (in Lakhs of Rs.)	Promotional Expenses
2017-18	32,352.00	3868.00
2016-17	27,096.00	4119.00
2015-16	18,190.00	1550.00
2014-15	16,593.00	1266.00
2013-14	13,538.17	996.61
2012-13	10,360.24	633.73
2011-12	11,090.51	985.07
2010-11	9,149.61	808.71
2009-10	7,654.15	695.36
2008-09	5,635.95	382.70
2007-08	4,495.38	539.15
2006-07	4,052.89	534.12

6. Further, it is contended that the plaintiff has registered the Trademark “ARUN” in various foreign Countries as below:-

S.No.	Trade Mark	Class	Filing Date	Number	Country
1.	ARUN ICE CREAMS	30	09-04-1997	82863	Sri Lanka
2.	ARUN ICE CREAMS	30	15-04-1997	T97/04507	Singapore
3.	ARUN ICE CREAMS	30	16-04-1997	97004873	Malaysia
4.	ARUN	29	21-12-2006	38387	Brunei
5.	ARUN	29	05-02-2007	87/2007	Seychelles



7. While so, the plaintiff has come across during the month of March -2018, the product of the defendant marketed with identical mark “ARUN” in respect of “Ghee”. The Trademark and goods involved are identical. Therefore, legal notice dated 27.03.2018 was issued to the defendant requesting to desist from using the plaintiff's trademark. In turn, the defendant issued a reply contending that, the two trademarks are not identical and the defendant using the Trademark ever since 1989.

8. The suit is filed alleging infringement and passing off on the ground that the plaintiff Trademark “ARUN” have overwhelming reputation, goodwill and gained status of the well-known mark. The defendant has malafidely using the identical mark in their business of manufacturing and marketing “Ghee products”, which is allied and cognate to the plaintiff's use of the mark “ARUN” in respect of its Milk products. The mark of the plaintiff is coined which was used since 1970 without any interruption. It has gained immense popularity, goodwill and reputation. The defendant has no justification whatsoever in adopting the trademark, which is identical to that of the plaintiff's trademarks. The use of the mark “ARUN” by the defendant is likely to lead to deception and confusion in the minds of the general public.



9. On receipt of the summons, the defendant has entered appearance and had filed their written statement, wherein, the defendant has contended that, their firm is duly registered Partnership Firm under the Indian Partnership Act, 1932. The brand name of “ARUN” is derived from the first four letters of the promoter Mr.Arunachalam. The registration of the plaintiff's trademark “ARUN”, the word mark vide Trademark Application No.2467722, is for the goods falling under Class 29 such as “MILK AND DAIRY PRODUCTS, MILK SHAKES AND MILK BEVERAGES, BUTTER, CHEESE, CURDS, YOGHURT, DIARY WHITENER : PRESERVED, DRIED AND COOKED FRUITS AND VEGETABLES. The plaintiff has not obtained registration of the mark “ARUN” for the goods “Ghee”. Moreover, the plaintiff claims use of the mark “ARUN” only from 30th January 2006, for the goods “Ghee”. Whereas, the defendant has honestly adopted the label mark ARUN AGMARK GHEE with cow on the background of the Mountain ever since 1989. Thus, the defendant has bonafidely adopted the label mark as honest and concurrent user since 1989. Therefore, the prior user cannot be enjoined from using the mark by a non-user.

10. The defendant is manufacturing superior quality of “Ghee”

duly recognised by AGMARK and their sales since 1989 is at ascending.



The plaintiff has not used the mark “ARUN” for the goods “Ghee”, though the use of the Mark “ARUN” is only for ice cream. For the “Ghee” manufactured and marketed by the plaintiff, they are using the mark “HATSUN”. Therefore, there is no chance of any confusion for purchasing the defendant product “Ghee” from the retail stores as the plaintiff's product. The mark and label are distinguishable and it will not cause any confusion in the minds of the buyer.

11. The ice cream of the plaintiff is sold in exclusive outlets i.e., the ice cream parlour. Whereas, the product of the defendant “Ghee” is sold in the retail market. The defendant as the prior user entitled to continue their trade using the mark “ARUN” for their product, since under Section 34 of the Trademarks Act, 1999, the right of the prior user is protected.

12. Applying the broad classification theory, though the plaintiff has obtained registered mark under class 29, for milk and milk products, they have not engaged any production of Ghee and therefore, the plaintiff should not be permitted to enjoy monopoly in respect of all articles which comes under class 29, to preclude other traders or manufactures to get registration of separate and distinct goods which may also fall under the board classification.



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13. Even if the goods are similar, the question of probability of deception depends mainly on the degree of resemblance between the marks. The adoption of the mark by the defendant is genuine. It was honestly conceived by the defendant being the name of one of the family members and using it honestly for a long time. The plaintiff cannot object the defendant from using the mark which is not similar. The defendant using the brand name “ARUN” in combination with the image of a white cow showering milk over a Shiva Lingam enclosed in a circle. Whereas, the plaintiff Trademark Arun ice cream which is leading letter “A” capitalised and the remaining letters written in small case in a stylish unique manner in a small case.

14. The claim of the plaintiff that their mark “Arun” is well-known mark is denied. To attain status of the well-known, the plaintiff should fulfil the criteria as stated in Section 11(6) of the Trademarks Act, 1999, and onus of proving the same is on the plaintiff. Even if assuming the plaintiff mark is well-known, the plaintiff can have no right to seek a restrain order against the defendant from using the name ARUN, since the mark of the plaintiff and the defendant are not similar. While comparing two marks same has to be done as a whole.



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15. As far as GHEE is concern, the quality of the defendant's product is rated as superior under the AGMARK certificate as Special Grade. Whereas, the GHEE produced by the plaintiff and marketed in the name of "HATSUN" is of Standard Grade which is inferior in quality, even according to their own certification. Therefore, the averment of the plaintiff that the defendant is passing off the inferior goods by exploiting goodwill and reputation of the plaintiff is un-found. The mark and goods of the plaintiff and the defendant are not same or similar. Therefore, there is no infringement or passing off.

16. After receipt of the affidavit of admission and denial from the parties, this Court, on 22.07.2019 based on the pleadings frames the following issues:-

1. Whether the plaintiff has valid registration for its trademark under the Trademarks Act, 1999?

2. Whether prior use in spite of non-registration of the trade name by the defendant entitles protection and supersedes the registration of a trademark of the plaintiff under the Trademarks Act, 1999?

3. Whether the class of consumer determines the effect of infringement and an action of passing off?



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4. *Whether the registered trademark of the plaintiff has acquired a secondary meaning amongst the general public?*

5. *Whether the defendant's use of its label mark 'Arun' since 1989 for sale of ghee amounts to infringement of plaintiff's trademark 'Arun' registered under Class 29 dated 30.01.2006 and 28.01.2013 vide Nos.1417529 and 2467722?*

6. *Whether the plaintiff is entitled to protection by way of permanent injunction in light of their trademarks being registered under the Trademarks Act, 1999?*

7. *Whether the defendant is passing off its products as that of the plaintiff by using the proprietary trademark of the plaintiff?*

8. *Whether the plaintiff is entitled for a direction for the defendant to surrender to the plaintiff the entire products with the offending labels, stocks with offending labels together with the blocks and dies, name boards, sign boards etc., for destruction?*

9. *Whether the plaintiff is entitled for direction for the defendant to render true and faithful accounts of the profits earned by them through the sale of the offending products bearing the offending trademark label and directing payment of such profits to the plaintiff?*

10. *To what other reliefs are the plaintiff entitled to?*



17. On behalf of the plaintiff, Mr.D.R.Rajesh (PW.1) was examined and *33 documents (Ex.P-1 to Ex.P-*33) marked. On behalf of defendant, Mr.A.Shanmugam (D.W.1) was examined and 23 documents (Ex.D.1 to Ex.D.23) marked. The material objects M.O.1 and M.O.*3 were marked.

Issue No.1:-

Ex.P.15 to Ex.P.28 are the certificates for registration of the plaintiff's trademark "ARUN" which are tabulated at paragraph No.3 of the judgment.

Ex.P.15, dated 09.06.1982 indicates that, the plaintiff's Trademark is for the device  in which, the word  written in stylish font. This Trademark is registered under Class 30.

Ex.P.16 is for the device mark "Arun" on the 1st letter written in a stylish manner with  followed by small letter in style and below Arun, the word ICE CREAMS in capital.



Ex.P.17 is for the Tamil word அருண் ஐஸ்க்ரீம்ஸ் in

which, the word அருண் is written in red colour with leafy underscore below



the last letter “ண்” and below the word அருண், the word ஐஸ்க்ரீம்ஸ் is written. This registration is for ICE CREAM, CONFECTIONERY, CHOCLATE, CHOCOLATE BEVERAGES WITH MILK, FRUIT JELLIES, BREAD, CAKES, VINEGAR. This trademark is registered under Class 30.



A similar certificate for the label is granted in Ex.P.18 for  tamil and Ex.P.19 for  English. All these certificates Ex.P.15 to Ex.P.19 pertains to the Trademark ARUN ICECREAMS in Tamil and English and with or without the word  written in stylish capital letter. In none of these certificates, the word Arun is in full capital letters. Except the first letter “A” all the other letters are in stylish small letter font. Particularly the word “A” is unique with an artistic design.

Ex.P.20 is the certificate dated 30.01.2006 for the word “ARUN” under class 32 for the goods such as FRUIT AND MILK SHAKES, BADAM MILK, *FLAVORED MILK BEVERAGES. The registration for the word Arun written in a particular style.





The other certificate in Ex.P.22 dated 30.01.2006 for the word Arun, which is registered under Class 29, for the goods, such as MILK, MILK POWDER, BUTTER, BUTTER MILK, GHEE, CHEESE, YOGURT AND OTHER MILK AND DIARY PRODUCTS.

From these documents relied by the plaintiff, to claim that they have valid registration for the word mark ARUN, this Court finds that except Ex.P.20 & Ex.P.22, the other documents are not for the word ARUN in isolation but for the combination of the words like ARUN ICECREAMS or AIC Arun ICE CREAMS, and all are written in stylish font.

Looking at Ex.P.20 & Ex.P.22, which are for the word mark ARUN under Class 29 & 32, it is clear that the plaintiff has obtained the trademark registration for the word ARUN for its products falls under class 29 which includes GHEE. The said Trademark word *Arun* is on stylish font with “A” capital followed by small letters as below:-

Ex.P.27 is the trademark registration for the word ARUN, which was registered under trade Mark No.2467723 dated 28.01.2013 and for class 30 in respect of ICE CREAMS, DESSERTS AND CONFECTIONERY.



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Ex.P.28 is the registration certificate for the trademark “ARUN” in class 30 in respect of goods such as FRUIT DRINKS, FRUIT JUICES, MINERAL WATER, PACKAGED DRINKING WATER, AERATED WATER AND OTHER NON ALCOHOLIC DRINKS, SYRUPS AND OTHER PREPARATIONS FOR MAKING BEVERAGES. This trademark certificate No.2467725 is dated 28.01.2013.

The certificates produced by the plaintiff for the trademark ARUN, the plaintiff has obtained registration for the goods under Class 30 in respect of goods such as FRUIT DRINKS, FRUIT JUICES, MINERAL WATER, PACKAGED DRINKING WATER, AERATED WATER AND OTHER NON ALCOHOLIC DRINKS, SYRUPS AND OTHER PREPARATIONS FOR MAKING BEVERAGES and class 30 in respect of goods ICE CREAMS, DESSERTS AND CONFECTIONERY. Thus, it is clear from the documents of the plaintiff for the word ARUN, the plaintiff has got registration only on 28.01.2013 for the specified goods under Class 29 & 30.

For the issue No.1, it is held that the plaintiff hold valid registration of trademark is in respect of the marks,





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Arun
ICECREAMS**அருண்**
ஐஸ்கிரீம்ஸ்

and

Arun

. Hence, issue

No.1 is answered above.

Issue No.2:-

The case of the defendant is that, they are the prior user of the mark “ARUN” and they are using this mark since 1989. It is the first four letter of the founder Mr.Arunachalam. It is an honest adoption for the goods entirely different from the goods in which the plaintiff has obtained the Trademark. The mark is neither similar nor identical, the goods is either similar or identical. Further, they are the prior user of the mark “ARUN”. For the said purpose, the defendant rely upon their invoices and the permission granted by the Department of Agricultural Marketing Adviser (Ex.D.13), dated * **08.03.2000** to use the AGMARK Replica to their products ARUN AGMARK “GHEE”. The bills for the advertisement expenditure (Ex.D.14) and the annexures to the AGMARK certificate are marked as Ex.D.13 & Ex.D.*8. The invoices relied by the defendant marked as (Ex.D.16) indicates that, the defendant had been using the name ARUN for the product “GHEE”, atleast from 13.02.1990 particularly the



dated 12.02.1990 addressed to the defendant indicates that, the Department has certified about the quality of “GHEE” manufactured by the defendant and provisionally approved the Trade brand label for the product and authorised to use the AGMARK with “GHEE” as a Special Grade. Even if the other documents like sample invoices, which are dated 29.06.1989 and thereafter are considered as a self-serving documents, the documents from the Office of Agricultural Department have an authenticity and reliability to hold that the defendant had been using the trademark “ARUN” for their product “GHEE” since 1990 and also it may not be out of context to record that the product of the defendant has been certified as a Special Grade, which is the highest quality in grading “GHEE” and this has been candidly admitted in the cross examination of P.W.1.

As far as the plaintiff claims over the Trademark “ARUN” for the goods under class 29 & class 30 they have obtained registration only on 28.01.2013 under Ex.P.26 & Ex.P.27. Again it may not be out of context to record that the plaintiff witness has admitted that though they have obtained registration of Trademark “ARUN” for “GHEE”, as of now, they are marketing their “GHEE” products under the Trademark “HATSUN”



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Q8: What are all the products your company sells under the brand name “Hatsun”?

A: Under the brand name “Hatsun” we sell Ghee, Milk, Curd and Milk Powder.

Q11: What are all the products your Company sells under the brand name “Arun”?

A: Only Ice Cream.

Q13: Have you produced your sales turn over and promotional expenses for Ghee alone?

A: No. We have not produced for Ghee.

Q23: What grade of Ghee does “Hatsun” sell?

A: To the best of my knowledge we sell best grade

Q29: Have you produced any thing to show or suggest that “Arun Ghee” is inferior to “Hatsun Ghee”?

A: No we have not produced.

The justification of the defendant for using the trademark “ARUN” for “GHEE” products are in two folds. First, they claim they are the prior user of the mark “GHEE” and second the plaintiff though have obtained trademark registration for the name “ARUN” to goods under Class 29 in the year 2006 and specifically for “GHEE” in the year 2013, they have not used this mark for their “GHEE”. Therefore, while the defendant is protected as prior user under Section 34 of the Trademark Act. The plaintiff has lost its right over the mark in view of Section 47 of the Trademarks Act,



1999, for not using the mark continuously for period of five years from the date on which the mark is actually entered.

Section 34 of the Trademarks Act, 1999, which reads as below:-

“34. Saving for vested rights:-

Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior—

(a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or

(b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his;

whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first-mentioned trade mark.”

47. Removal from register and imposition of limitations on ground of non-use.—



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(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the Appellate Board by any person aggrieved on the ground either—

(a) that the trade mark was registered without any bonafide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of Section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application; or

(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

Provided that except where the applicant has been permitted under Section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where



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the Tribunal is of opinion that he might properly be permitted so to register such a trade mark, the Tribunal may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to—

(i) goods or services of the same description; or

(ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered.

(2) Where in relation to any goods or services in respect of which a trade mark is registered—

(a) the circumstances referred to in clause (b) of sub-section (1) are shown to exist so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in a particular place in India (otherwise than for export from India), or in relation to goods to be exported to a particular market outside India; or in relation to services for use or available for acceptance in a particular place in India or for use in a particular market outside India; and

(b) a person has been permitted under Section 12 to register an identical or nearly resembling trade mark in respect of those goods, under a registration extending to use in relation to



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goods to be so sold, or otherwise traded in, or in relation to goods to be so exported, or in relation to services for use or available for acceptance in that place or for use in that country, or the Tribunal is of opinion that he might properly be permitted so to register such a trade mark, on application by that person in the prescribed manner to the Appellate Board or to the Registrar, the tribunal may impose on the registration of the first-mentioned trade mark such limitations as it thinks proper for securing that that registration shall cease to extend to such use.

(3) An applicant shall not be entitled to rely for the purpose of clause (b) of sub-section (1) or for the purposes of sub-section (2) on any non-use of a trade mark which is shown to have been due to special circumstances in the trade, which includes restrictions on the use of the trade mark in India imposed by any law or regulation and not to any intention to abandon or not to use the trade mark in relation to the goods or services to which the application relates.

In the light of the evidence and candid admission by the plaintiff, this Court holds that the defendant is the prior user of the word “ARUN” for the GHEE products. Section 34 of the Trademarks Act, protects the prior user who has honestly adopted the name and being using it since 1990, cannot be interfered with or restrained, because of the



subsequent grant of trademark for allied or cognate goods or even for the similar goods. Therefore, this Court holds that the prior user even in case of non-registration of the trademark is entitled for protection, superseding the registration of the Trademark by the plaintiff. Therefore, issue No.2 is answered accordingly.

Issue Nos.4 & 5:-

The evidence before this Court indicates that the defendant is the prior user of the label mark “ARUN” for “GHEE” since 1990. Though, the plaintiff has obtained registration for the Trademark ARUN under Section 29 for the goods including GHEE on 30.01.2006 and exclusively for a goods GHEE on 28.01.2013. The prior user bonafidely for the reason to adopt being the first Four letters of the elder family member of Mr.Arunachalam, will not amount to infringement.

The Learned Counsel for the plaintiff rely upon “NICE classification” Theory. Whereas, the Learned Counsel for the defendant rely upon the “Board Classification” theory. The facts of the case doesn't support the contention of the plaintiff. The plaintiff contends that both “GHEE” and “ICE CREAMS” are milk products sold through same channel

and they are allied and cognate goods. Therefore, their registration of the



name “ARUN” for the goods under Class 29, which includes milk products, will give exclusive right upon the plaintiff to use the word “ARUN”.

Sections 28 and 29 of the Trademarks Act, 1999, explains, when a mark is infringed. The provisions under Section 28 of the Act, is subject to other provisions of this Act. While, Section 28 of the Act, confers exclusive right of registered Trademark on its holder, subject to other provision of this Act, Section 29 of the Trademarks Act, enumerates at what circumstances the trademark is held to be infringed.

The plaintiff case of infringement is based on its claim over the word mark ‘ARUN’ as a well known mark and having valid registration for goods under class 29, their right is protected under the NICE Classification since both ‘ICE CREAM’ and ‘GHEE’ are milk products. Per contra, the defendant's case is the registration mark to be taken as a whole and not in part. As far as the word “ARUN” is not an invented word of the plaintiff. It is a common Indian word to name persons. It means ‘dawn’ or ‘sun’ in Sanskrit. Being a common name, the word “ARUN” can never gain the status of well known mark or secondary meaning. The defendant has adopted the name “ARUN” from the first four letters of their elder family



the name “ARUN” and carrying on business in various goods. The P.W-1 has admitted in his cross examination that, they have not taken any action against them for using the word “ARUN”.

From the evidence placed before this Court, the plaintiff is able to show that they are trading in different Trademarks for different goods. The use of the word “ARUN” in artistic style not been used in isolation but only with other words “ICE CREAMS”. They have not produced any evidence to show there are products sold by them with the word “ARUN” in isolation, more particularly it is an admitted fact that they are not marketing “GHEE” with the word mark “ARUN”. Therefore, their claim that the word mark “ARUN” has gained the status of well known mark within the meaning of Section 2 (zg) of the Trademarks Act,1999, is not substantiated by evidence.

The other limb of argument of the plaintiff is that, due to the extensive advertisement and availability of its products in all shops, departmental stores and malls, the mark “ARUN” has gained secondary meaning to denote and connote the products of the plaintiff alone and the public associates the mark “ARUN” with the plaintiff alone.



The reputation, goodwill and the expenses made for publicity of the products “ARUN”, “ICE CREAMS”, cannot be extended to the work “ARUN”. The dictum laid in *Caterpillar case* and *Benz case* cannot be applied in this case, for multiple reasons. First, the word “ARUN” is neither an invented word or coined word by the plaintiff. Nothing distinct in the word “ARUN” *per se*. Second, the defendant use the word “ARUN” along with a circular logo a cow in a background of a mountain and the words AGMARK “GHEE” is distinct. Whereas, the plaintiff mark is an artistic word “ARUN”. The marks are distinct and no similarity either visually or structurally. Thirdly, the defendant has proved to be the honest prior user of the mark and the quality of its products are not of sub-standard as alleged in the plaint.

In *Nandhini Deluxe -vs- Karnataka Cooperative Milk Producers Federation Ltd* reported in **2018 (9) SCC 183**, when dispute arose between the plaintiff the marketer in milk and milk products in the trade name “NANDINI” for products under class 29 and class 30; and the defendant running restaurants in the name of “NANDHINI”, the Hon’ble Supreme Court relying upon the dictum laid in *Vishnudas Trading -vs- Wazir Sultan Tobacco Co. Ltd* (Charminar case), held that, the proprietor of a Trademark



he is not using the said trademark in respect of certain goods falling under same class.

Therefore, this Court holds that the plaintiff has not proved the case of infringement of its registered trademark “ARUN”. The defendant being the prior user of the mark “ARUN” for the product (GHEE) which is not marketed by the plaintiff under the said name, can have no grievance of dilution of the right since the trademark itself a generic word and nothing novel or inventive in it.

Issue No.4:- This Court holds that, the plaintiff trademark “ARUN” had not acquired a secondary meaning among the general public. The word “ARUN” *per se* is a common word not associated with the plaintiff or its product alone.

Issue No.5:- The plaintiff by virtue of the registration of the mark “ARUN”, cannot try to have monopoly over the mark cutting across the goods barrier. The defendant has established that the mark “ARUN” is used in good faith for their goods viz., GHEE much prior to the plaintiff. The

registration of mark “ARUN” for “GHEE” has been obtained by the plaintiff



only in the year 2006 and 2013. However, till date, the plaintiffs are not marketing their “GHEE” in the name “ARUN”. Admittedly, they are marketing “GHEE” only in the other registered trademark, “Hatsun”. Therefore, the adoption of the name “ARUN” by the defendant for the goods “GHEE” attracts any of the categories enumerated under section 29(2) to (4) of the Trademarks Act. Contrarily, the defendant is protected under section 28(3) and section 34 of the Trademarks Act.

Issue Nos. 3,6,7,8,9 and 10:-

The class of customers, the channel of Trade are matters relevant to determine passing off. However, in this case, the act of deceptive adoption of the plaintiff’s trademark itself not established. The marks are not identical or similar. The goods are not identical or similar. Therefore, these issues are to be held against the ***Plaintiff**.

18. In the result, all the issues are answered against the ***defendant**. Hence, the *Suit is dismissed*. With costs.

**List of Witness examined on the side of the Plaintiff:-**

Mr.D.R.Rajesh (PW.1)

List of Witness examined on the side of the Defendant :-

Mr.A.Shanmugam (D.W.1)

List of the Exhibits marked on the side of the Plaintiff:-

Sl. Nos.	Exhibits	Dated	Description of documents
1.	Ex.P.1	16.10.2017	Photocopy of Board Resolution of plaintiff Company authorizing Mr.Rajesh D.R.to represent the plaintiff in the suit.
2.	Ex.P.2	---	Photocopy of ISO 22000:2005 certificate issued with respect to the plaintiffs Corporate Office year - 2005.
3.	Ex.P.3	---	Photocopy of ISO 22000:2005 certificate issued with respect to the plaintiffs Plant at Red Hills year 2005.
4.	Ex.P.4	---	Photocopy of ISO 22000:2005 certificate issued with respect to the plaintiffs Plant at Salem year 2005.
5.	Ex.P.5	04.03.1986	Photocopy of Incorporation Certificate of Plaintiff and its predecessor.
6.	Ex.P.6	03.02.2017	Photocopy of Certificate issued by the Food Safety & Standards Authority of India with respect to the Corporate Office of the Plaintiff.
7.	Ex.P.7	06.03.2017	Photocopy of Certificate issued by the Food Safety & Standards Authority of India with respect to imports.
8.	Ex.P.8	14.04.2018	Photocopy of Certificate issued by the Food Safety & Standards Authority of India with respect to Plaintiffs Plant at Thiruvallur.
9.	Ex.P.9	25.05.2018	Photocopy of Certificate issued by the Food Safety & Standards Authority of India with respect to Plaintiffs Plant at Salem.
10.	Ex.P.10	---	Photocopy of List of Distribution Channels of the Plaintiffs product ARUN.
11.	Ex.P.11		Photocopy of Chartered Accountant's Certificate



Sl. Nos.	Exhibits	Dated	Description of documents
			for Sales Turnover and sales promotion of all trademarks of the Plaintiff.
12.	Ex.P.12	02.01.2015	Photocopy of Chartered Accountant's Certificate for Sales Turnover and sales promotion expenses in respect of the mark ARUN.
13.	Ex.P.13	17.03.2016	Photocopy of Chartered Accountant's Certificate for Sales Turnover and sales promotion expenses in respect of the mark ARUN.
14.	Ex.P.14	11.08.2018	Photocopy of Chartered Accountant's Certificate for Sales Turnover and sales promotion of all trademarks of the Plaintiff.
15.	Ex.P.15	09.06.1982	Photocopy of Certificate Registration of the Trademark "ARUN" in Class 30, under No.391526.
16.	Ex.P.16	29.05.1997	Photocopy of Certificate Registration of the Trademark 'ARUN ICE CREAMS' in Class 30 under No.756404.
17.	Ex.P.17	20.01.2003	Photocopy of Certificate Registration of the Trademark 'ARUN ICE CREAMS' (Tamil label) in Class 30 under No.1167736.
18.	Ex.P.18	30.01.2006	Photocopy of Certificate Registration of the Trademark 'ARUN ICE CREAMS' in Class 30 under No.1417525.
19.	Ex.P.19	30.01.2006	Photocopy of Certificate Registration of the Trademark 'ARUN ICE CREAMS' in Class 30 under No.1417526.
20.	Ex.P.20	30.01.2006	Photocopy of Certificate Registration of the Trademark "ARUN" in Class 32 under No.1417527.
21.	Ex.P.21	30.01.2006	Photocopy of Certificate Registration of the Trademark 'ARUN ICE CREAMS' in Class 30 under No.1417528.
22.	Ex.P.22	30.01.2006	Photocopy of Certificate Registration of the Trademark "ARUN" in Class 29 under No.1417529.
23.	Ex.P.23	06.06.2006	Photocopy of Certificate Registration of the Trademark 'ARUN FAMILY' in Class 30 under



Sl. Nos.	Exhibits	Dated	Description of documents
			No.1459477.
24.	Ex.P.24	06.10.2008	Photocopy of Certificate Registration of the Trademark "ARUN ICE CREAMS UNLIMITED" in Class 42 under No.1740571.
25.	Ex.P.25	06.10.2008	Photocopy of Certificate Registration of the Trademark "ARUN ICE CREAMS UNLIMITED" in Class 35 under No.1740572.
26.	Ex.P.26	28.01.2013	Photocopy of Certificate Registration of the Trademark "ARUN" in Class 29 under No.2467722.
27.	Ex.P.27	28.01.2013	Photocopy of Certificate Registration of the Trademark "ARUN" in Class 30 under No.2467723.
28.	Ex.P.28	28.01.2013	Photocopy of Certificate Registration of the Trademark "ARUN" in Class 32 under No.2467725.
29.	Ex.P.29	--	Photocopy of the depiction of the Plaintiffs trademark.
30.	Ex.P.30	--	Photocopy of the Defendant's product packages.
31.	Ex.P.31	27.03.2018	Photocopy of Legal Notice issued by the Plaintiffs with postal receipt.
32.	Ex.P.32	16.04.2018	Photocopy of Reply Notice issued by the Defendant.
33.	Ex.P.33	-	Legal user certificate

Sl. Nos.	Exhibits	Dated	Description of documents
1.	Ex.D.1	---	Aadhaar card, Ration card and Pan card of the former properties.
2.	Ex.D.2	21.08.1964 to 29.08.1965	Book of record sales maintained by M/s.Gnrpathy Stores dt.21.08.1964 to 29.08.1965

Sl. Nos.	Exhibits	Dated	Description of documents
3.	Ex.D.3	30.08.1965 to 30.03.1996	Book of record of sale maintained by M/s.Gnrapathy Stores
4.	Ex.D.4	01.04.1989	Partnership deed.
5.	Ex.D.5	--	Acknowledgement of registration of firm.
6.	Ex.D.6		License fee paid by the defendant to the corporation of coimbatore for butter and ghee selling.
7.	Ex.D.7	---	License from Tamil Nadu food safety and drug administration department to the defendant
8.	Ex.D.8	13.02.1990	Authorization given by Agricultural Marketing adviser, Southern Region Madras in favour of the defendant to grade and mark Ghee under Agmark
9.	Ex.D.9	26.06.2017 & 17.02.2018	Printed copy of GST Provisional Registration Certificate and GST Registration Certificate.
10.	Ex.D.10	16.04.2018	Copy of ISO Certificate issued by Quest Certificate Private Limited.
11.	Ex.D.11	13.02.2019	Copy of HACCP issued by Quest International Certificate in favour of the defendant firm
12.	Ex.D.12	06.06.2018	Certificate of Importer-Exporter Code (IEC) in the name of the defendant firm issued by the ministry of commerce and Industry.
13.	Ex.D.13	08.03.2000	Copy of Approval obtained from Agricultural Officer
14.	Ex.D.14	---	Original Advertisement / expenditure bills of the defendant
15.	Ex.D.15	28.07.2008	Original Advertisement and Promotion Expenditure Bills of the defendant firm.
16.	Ex.D.16 (series)		originals Sample invoices of the defendant to customers.
17.	Ex.D.17	---	Certificate issued by the Chartered Accountant with respect to turnover details of the defendant year 1989 to 2018
18.	Ex.D.18		Originals Arun Ghee labels.
19.	Ex.D.19	---	Printed copy photos of the defendant's Office.



Sl. Nos.	Exhibits	Dated	Description of documents
20.	Ex.D.20	27.03.2018	legal notice
21.	Ex.D.21	16.04.2018	original Reply to the legal notice and acknowledgement.
22.	Ex.D.22	08.10.2018	Copy of Trademark application.
23.	Ex.D.23	27.08.2019	Main page of the E-register of the intellectual property portal reflecting Defendant Trademark.
24.	Ex.D.24	13.12.2019	Receipt No.2389145
25.	Ex.D.25	---	Receipt No.2538747
26.	Ex.D.26	24.10.2019	POA authorization of an agent

*** Amended as per order dated 27/9/2021 in
C.S.No. 748 of 2018.**

**Sd/- (28/12/2021)
ASSISTANT REGISTRAR**

Sd./- G.J.J.
14.09.2021

//Certified to be true copy//
Dated at Madras this the day of 2022.

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