



IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated : 02.02.2022

Coram :

THE HONOURABLE MR.JUSTICE N.ANAND VENKATESH

Civil Suit No.136 of 2021
(Comm.suit)

K.T.V.Health Food Private Limited
Repreented by its Director
Mr.B.Babu
No.48/310, Thambu Chetty Street
Chennai-600 001.

..Plaintiff

.Vs.

M/s.Sri Amman Agro Foods
A Partnership Firm
Mr.K.Selvakumar
Mr.S.Arjunan
Partnership Carrying on business at
No.79, Palanthandalam Village
Thirumudivakkum Main Road,
Chennai 600 044.

..Defendant

Prayer: Civil Suit has been filed under Order IV, Rule 1 of the Original Side Rules and Order VII, Rule 1 of the C.P.C. Read with Sections 27(2), 29, 134 and 135 of the Trade Marks Act, 1999 and Sections 54, 55 r/w Section 62 of the Copyright Act, 1957.



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(a)granting a permanent injunction, restraining the defendant, by themselves, their servants, agents, distributors, or anyone claiming through them from reproducing by selling, advertising and or offering for sale edible oil both domestic and exports by using the impugned Trademark **ROHINI** and the pouch as shown in Document No.2 upon the goods or in any media and use the same in invoices, letter heads and visiting cards or by using any other Trademarks which is in any way substantially reproduce the Plaintiff's Trademark **ROOBINI** or in any manner infringing the Plaintiff's Trademark under Nos.837894 & 1415277 in class 29 with respect to edible oil and vanaspathi.

(b)granting a permanent injunction, restraining the Defendant, by themselves, their servants, agents, distributors, or anyone claiming through them from reproducing by selling, advertising and or offering for sale edible oil both domestic and exports by using the impugned Trademark **ROHINI** (word) and (pouch) as shown in Document No.2 upon the goods namely edible oil and vanaspathi or in any media and use the same in invoices, letter heads and visiting cards or by using any other Trademark which is in any way substantially reproduce the Plaintiff's Trademark **ROOBINI** (word) and (pouch) shown in Document No.1 or in any manner passing off of the Plaintiff's Trademark.

(c) granting a permanent injunction, restraining the Defendant, by themselves, their servants, agents, distributors, or anyone claiming through them from reproducing by selling, advertising and or offering for sale edible oil both domestic and exports by using the impugned Copyright **ROHINI** (pouch) as shown in Document No.2 upon the goods namely edible oil and vanaspathi or in any media and use the same in invoices, letter heads and visiting cards or by using any other



Copyright which is in any way substantially reproduce the Plaintiff's Copyright **ROOBINI** shown in Document No.1 or in any manner passing off of the Plaintiff's Copyright.

(d)directing the defendant to surrender to the Plaintiff all the packing material, cartons, advertisement materials and hoardings, letter-heads, visiting cards, office stationery and all other materials containing/bearing the Color Scheme and Get up in the Plaintiff's trademark **ROOBINI** or other deceptively similar Trade Mark in respect of Oil or any other products

(e)for a preliminary decree in favour of the Plaintiff, directing the Defendant to render an account of profits made by them by the use of the trademark **ROHINI** and by using the same Color Scheme and Get up in the Plaintiff's trademarks **ROOBINI** on the goods referred and for a final decree in favour of the Plaintiff for the amount of the profits found to have been made by the Defendant, after the Defendant has rendered accounts.

(f) directing the defendant to pay to the plaintiff the costs to the suit, and

(g) pass such further order or order, as may be deemed fit and proper in the circumstances of the case and thus render justice.

For Plaintiffs : Mrs.Gladys Ganiel

For Defendant : Set exparte



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J U D G M E N T

The present suit has been filed seeking for the relief of permanent injunction, restraining the defendant, by themselves, their servants, agents, distributors, or anyone claiming through the defendant from reproducing by selling, offering, advertising for sale edible oil both domestic and exports by using the impugned Trademark **ROHINI** and the pouch  upon the goods or in any media, use the same in invoices, letter heads and visiting cards or by using any other trade mark name or any name with a similar sounding expression in any media or by using any other trade mark and/or name which are visually, phonetically or deceptively similar to the plaintiff's registered trade mark **ROOBINI** and in any manner infringing or passing off the plaintiff's registered trademark ROOBINI and copyright  . The Plaintiff has further prayed for a direction to the Defendant to surrender all the materials bearing the infringing trade mark. The Plaintiff has also sought for a direction to the Defendant for rendition of accounts.

Case of the Plaintiff:

2. The case of the plaintiff is with respect to the infringement and passing off of their registered trademark ROOBINI and infringement of copyright for the



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artistic work



. The plaintiff is a company incorporated under the Companies Act, 1956 to carry on the business of packaging and selling refined palm oil. The plaintiff adopted the trademark ROOBINI with respect to edible oils in the year 1995 and the mark is in continuous use since then. The plaintiff states that the trademark ROOBINI is registered under Nos. 837894 and 1415277 in Class29 and has been granted with effect from 22-1-1999. The plaintiff claims that they have adopted a unique packaging for their product under the trademark ROOBINI and that their pouch and carton  are copyrights belonging to the plaintiff as they were created during the course of employment by the employees of the plaintiff and no contract exists to the contrary.

3.The plaintiff states that their oil trading business in Kotwal market dates back to 1971 and was the first ever retail venture operated in Kotwal market. The plaintiff further states that from 1999-2008 the business was carried on as a Partnership Firm and from 2008, the business is carried on by the plaintiff as a Private Limited Company. The plaintiff states that their turnover from the sale of edible oils for the year 2018-2019 was more than 2674 crores. The plaintiff claims that over the years it has grown into one of the leading companies for marketing and



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re-packaging of oils in India by its sheer hard work and high quality of products and the enormous amount of goodwill earned thereto. The plaintiff further claims that it has taken tireless efforts to promote its products under the trademark ROOBINI and its unique label and pouch . The plaintiff states that it has spent substantial amount of money in publicising its trademark and as a result of the same, the members of the trade and public invariably associate the said trademark with the plaintiff's product alone and no one else. Further, the plaintiff claimed that their trademark ROOBINI has become a synonym of quality, reliability and authenticity in respect of the aforesaid goods sold by them.

4. The grievance of the plaintiff is that the defendant by way of an application dated 18-2-2019 has applied for the registration of its trademark ROHINI/  in an identical colour scheme and get up to that of the registered trademark ROOBINI which belongs to the plaintiff under no. 4090922 in Class 29 through Trademark Journal number 1926. The plaintiff states that it has filed its opposition to the said registration under No. 1029217 dated 4-2-2020. The plaintiff claims that the defendant has adopted the word ROHINI in the same manner in which the plaintiff's trademark ROOBINI is displayed. The plaintiff further claims



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that the colour scheme and get up found in the defendant's pouch is a substantial reproduction of the plaintiff's copyright . The plaintiff states that the defendant has deliberately and knowingly adopted an identical trademark ROHINI and has also adopted an almost identical label for their product which clearly shows that they are aware of the plaintiff's product and have deliberately chosen to copy the plaintiff's trademark and copyright in the artistic work. The plaintiff claims that the defendant's trademark is phonetically similar and they have changed the spelling in the trademark ROOBINI but have retained the entire pronunciation with minor modifications to the label, to sail as close as possible to the plaintiff's product ROOBINI and pass off their product ROHINI as that of the plaintiff's. The plaintiff states that the defendant's acts are malafide and as a result, it directly impacts the plaintiff in dilution of the value, goodwill, reputation and proprietary rights, which exist exclusively in favour of the plaintiff.

Discussions and Findings:

5.The defendant was served and the defendant did not choose to defend themselves either in person or through counsel and was called absent and was set ex parte by this court on 28-1-2022.



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6. The only issue that arises for consideration in the present suit is as to whether the defendant, by using the mark 'ROHINI/'  has infringed the plaintiff's registered trademark ROOBINI and their copyright for the artistic work

 in the adoption of their trademark 'ROOBINI' and whether the same is phonetically, visually and structurally identical to the registered trade mark of the plaintiff and as to whether the plaintiff is entitled for the reliefs sought for in this suit.

7. This Court on going through the pleadings and the materials relied upon came to a conclusion that oral evidence is not required in this case and accordingly directed marking of the documents filed along with the plaint and accordingly, Ex. P-1 to Ex. P-11 were marked.

8. Heard M/s. Gladys Daniel, learned counsel for the plaintiff and carefully perused the documents relied upon by the Plaintiff.

9. On carefully going through exhibits P 3 and P4, it can be seen that the Plaintiff is a registered trademark owner of the mark "ROOBINI". It is also seen that the plaintiff is using these trademarks for marketing and re-packaging of oils





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and became registered proprietors of the trademark ROOBINI on 22-1-1999 for which Trademark Nos. 837894 and 1415277(Exhibit P3 and P4) were assigned. Further it can also be seen that the plaintiff is the copyright owner of its unique packaging carton (Exhibit P2) used in the marketing of its trademark. Further the petitioners have been using the trademark continuously since 1995.

10. It can be seen that the mark 'ROOBINI' /  has become a well-known mark for edible oils. The defendant who was aware about the same decided to make use of this mark for selling the same Class of goods. The defendant is passing off on the goodwill and reputation earned by the plaintiff for over more than 25 years by adopting each and every essential feature of the Plaintiff's trademark, colour scheme and getup. The defendant is involved in this act in spite of the fact that the defendant has applied for registration of this trademark ROHINI and the plaintiff has already filed the opposition and it is pending before the concerned authority.

Infringement of Trademark:



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11. A careful scrutiny of the infringed mark of the defendant 'ROHINI' shows that the mark is deceptively and phonetically similar to the plaintiff's registered trade mark 'ROOBINI'. The defendant has adopted this trademark only with a view to exploit the commercial goodwill achieved by the plaintiff.

12. This Court in the case of **ISSAC ISAAC Mathai vs. Sowkhya Way2health P. Ltd. reported in MANU/TN/2823/2013** held that adding of one or two words in a mark does not make any difference as far as phonetic similarity is concerned. The relevant paragraphs from the judgment are extracted below:

60. It may also be noticed here that act of the defendant/respondent is not bonafide, though they are claiming to use the trademark "SOUKYA WAY2HEALTH", but in all their letter heads and other documents displayed "SOWKHYA" prominently, whereas "WAY2HEALTH" is not that prominent. Besides, e-mail address is also deceptively similar to that of the plaintiffs/applicants, i.e. www.sowkhya.com.

61. It is well settled law that when there is phonetic similarity between the two names, then adding of one or two words does not make it distinct from similarity. It can therefore, be safely said that the defendants/respondents have deliberately infringed the registered trademark of the plaintiffs/applicants.



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Infringement of Copyright:

13.A closer look at the mark ROHINI/  shows that the product carton of the defendant is identical with the copyright of the plaintiff  retaining the following essential features from the plaintiff's artistic work:

- The orange colour pouch, white border and same font.
- The trademark is written in white bordered in red.
- The same style of writing and colour combination for its mark.
- The description of the oil written below the trademark as REFINED PALMOLEIN in white in the same style and font.

This clearly shows that the defendant is aware of the plaintiff's product and has deliberately chosen to copy the plaintiff's copyright in the artistic work to piggy bank on the goodwill and reputation earned by the plaintiff.

14.In the present case, both the parties are involved in Oil trading business. The defendant's mark is phonetically and visually identical to the plaintiff's trade mark and it is bound to cause confusion as both the products will be made available through the same trade channels and to the same Class of consumers.



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15. The above discussion leads to the conclusion that the mark “ROHINI/”
 used by the defendant has infringed the plaintiff's trade mark
‘ROOBINI’ and copyright . That apart, the same is phonetically, visually
and structurally identical to the trade mark of the plaintiff. Accordingly, the plaintiff
is entitled for the reliefs sought for in this suit, except the relief of rendition of
accounts which stands rejected considering the facts and circumstances of the case.
The point for determination is answered accordingly.

16. In fine, there shall be a judgement and decree for ;

- a) Permanent injunction, restraining the defendant, by itself, its partners,
men, servants, agents, distributors, stockiest, representatives or anyone
claiming through or under them from in any manner infringing or passing
off the plaintiff's registered trademark ‘ROOBINI’ under Nos. 837894 and
1415277 inClass29, other registered trademarks by using a deceptively
similar trademark ROHINI/  or any other trademark deceptively
similar to the plaintiff's registered trademark.
- b) Permanent injunction restraining the defendant in any manner
committing acts of copyright infringement by using, in the course of trade,
labels/artistic works which are a substantial reproduction of Plaintiff's



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copyright  and other registered copyrights, in colour scheme, get up and layout  ieir 'ROHINI'/  for any edible oils, etc, in any other manner whatsoever.

- c) There shall be a further direction directing the defendant to surrender all the materials bearing the impugned mark of the defendant, and
- d) The defendant is directed to pay cost of a sum of Rs.25,000/- [Rupees Twenty Five Thousand] to the plaintiff. The suit is allowed in the aforesaid terms.

02.02.2022

Internet: Yes
Index: Yes/No
KP

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



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

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

S.No.	Exhibits	Description of Documents
1.	Ex.P.1	Plaintiff's pouch Roobini - Original
2.	Ex.P-2	Defendant's pouch ROHINI - Photo
3.	Ex.P-3	07.01.0221- Legal use certificate of Trade Mark No.837894 in Class 29, dated 22.01.1999-Photostat copy.
4.	Ex.P-4	07.01.0221- Legal use certificate of Trade Mark No.1415277 in Class 29, dated 20.01.2006 -Photostat copy.
5.	Ex.P-5	2008-2020 - Sample invoices - Photostat copy.
6.	Ex.P-6	1999-2018-Sample Advertisement in Newspapers, Magazines and invoice - Photostat Copy.
7.	Ex.P-7	25.01.2021 - Chartered Accountant certificate - Original.
8.	Ex.P-8	Plaintiff's Website-Print out
9.	Ex.P-9	04.11.2019-Defendant Trade mark Application No.4090922 dt.18.02.2019 in class 29 - Print out.
10.	Ex.P-10	04.02.2020-Notice of Opposition under No.1029217 in Application No.4090922 dt.16.12.2019-printout.
11.	Ex.P-11	29.01.2021-Affidavit of Mr.D.Venkatakrisnan (Under Section 65 B of the Evidence Act, 1872)- Original.

List of the Exhibits marked on the side of the Defendants:- Nil

N.ANAND VENKATESH. J.,

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