



C.S.No.413 of 2012

WEB COPY IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated : 11.08.2023

CORAM

THE HONOURABLE Ms. JUSTICE P.T. ASHA

C.S.No.413 of 2012

Lotte India Corporation Ltd.,
Second Floor, Murugesan Complex,
84, Greams Road,
Thousand Lights,
Chennai – 600 006
rep. by its Company Secretary
Mr.T.G.Karthikeyan

... plaintiff

Vs.

1.Phan Nguyen Confectionery Corporation
613, Tran Dai Nghia,
Binh Tan District
HCM City
Vietnam

2.Ajanthaa K.T.K Products,
12/23, Govindappa Naichen Street,
Chennai 600 001.

... defendants



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Prayer: Plaintiff filed under Order VII Rule 1 of CPC read with Order IV Rule 1 of the Original Side Rules and Section 27, 28, 29, 134 and 135 of the Trade Marks Act, 1999, for

(a) a permanent injunction restraining the defendants by themselves, their partners, proprietor, legal representatives, successors in business, assigns, servants, agents, transporters, distributors, printers, stockists, wholesalers, dealers, retailers, advertisers, importers, C&F agents, warehouse operators/cold storage facilities, shipping agents or any one claiming through or under them from infringing plaintiffs registered trademark LOTTE CHOCO PIE label/wrapper/carton by importing, stocking, manufacturing, distributing, marketing, selling, offering for sale, advertising or in any other manner dealing in chocolate coated soft cakes or any other product bearing an identical mark CHOCO PIE in conjunction with wrapper, carton, label with colour scheme, getup, layout which are identical to the essential features of plaintiff's registered trade mark



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label/wrapper/carton or in any manner whatsoever;

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(b) a permanent injunction restraining the defendants by themselves, their partners, proprietor, legal representatives, successors in business, assigns, servants, agents, transporters, distributors, printers, stockists, wholesalers, dealers, retailers, advertisers, importers, C&F agents, warehouse operators/cold storage facilities, shipping agents or any one claiming through or under them from committing acts of passing off and enabling others to pass off by manufacturing, importing, distributing, marketing, selling, offering for sale, advertising or in any other manner dealing in chocolate coated soft cakes or any other product bearing an identical mark CHOCO PIE in conjunction with package, wrapper, container, carton, label with colour scheme, getup, layout which are identical/similar to plaintiff's trade dress & get up in CHOCO PIE label/wrapper/carton or in any other manner whatsoever;

(c) The defendants be ordered to surrender to the plaintiff for destruction, all cartons, wrappers, label, containers, pouches, prints,



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dies, blocks, moulds and plates, screen prints, packing and advertising material and any other material in their possession, bearing the mark CHOCO PIE which are a substantial reproduction of the plaintiffs trade dress & get up and copyright in the artistic work CHOCO PIE label/wrapper amounts to infringement of plaintiffs registered trademark and copyright therein and amounts to passing off defendants' goods as and for plaintiff's goods;

(d) a preliminary decree be passed in favour of the Plaintiff directing the Defendants to render account of profits made by use of trademark and artistic work CHOCO PIE label/wrapper/carton and final decree be passed in favour of the Plaintiff for the amount of profits thus found to have been made by the Defendants, after the latter have rendered accounts;

(e) The Defendants be ordered to pay to the Plaintiff a sum of Rs.1,00,000/- as damages for their wrongful and illegal activities by use of trademark CHOCO PIE label and artistic work CHOCO PIE label;



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(g) For such further and other reliefs as this Hon'ble Court may deem fit and proper in the circumstances of the case and thus render Justice.

For Plaintiff : Mr. Arun C. Mohan

For Defendants : Mr. K.Srinivasa Murthy
for M/s. Row and Reddy.

ORDER

The subject matter of the above suit is the trademark LOTTE CHOCO PIE, which the plaintiff alleges has been infringed by the defendants and that the defendants are committing acts of passing off by using the trademark of the plaintiff for their products, besides claiming other relief.



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submit that they had immediately conducted a market survey through their sales force, which revealed that the 2nd defendant is importing the chocolate coated soft cakes manufactured by the 1st defendant under the identical trademark CHOCO PIE with the identical wrapper / label / carton.

4. It is also the plaintiff's case that the product of the 1st defendant was of a sub-standard quality, which could even be hazardous to the consumer. The plaintiff would contend that when the product of the defendants is stacked along side the product of the plaintiff, an unwary consumer would easily be led to believe that they are purchasing the product of the plaintiff. It is the contention of the plaintiff that the defendants have adopted the identical mark with malafide intent and to ride on the good will that the plaintiff has earned over the period of time. Therefore, the plaintiff has come forward with the suit in question.



5. The 1st defendant had not entered appearance and was therefore set ex parte by orders of this Court dated 12.06.2023.

The 2nd Defendant's case:

6. The 2nd defendant has filed a written statement inter alia contending that they have no connection with the 1st defendant and they have never been marketing the product of the 1st defendant. It is also their case that they are not manufacturers, but only resellers and that the 2nd defendant is engaged in marketing the product of the plaintiff also. The 2nd defendant would contend that they purchase products from the wholesalers and resell the same to the small shop keepers and consumers. Therefore, they have by no stretch of imagination infringed the trademark of the plaintiff particularly when they are selling the plaintiff's products.

7. The 2nd defendant would also plead ignorance about the registration of the trademark in the name of the plaintiff. They would



further submit that they never imported the product from the 1st defendant. On the other hand they are only a semi wholesaler “ie., they purchase from wholesalers, re-sell it to small shop keepers and consumers”. The 2nd defendant has contended that they have only sold the product of the plaintiff and that they have been unnecessarily dragged into the litigation.

Issues:

8. By order dated 12.06.2023, the following issues had been framed by this Court and the parties had gone to Trial:

1. Whether the Defendants are infringing the Plaintiff's trademark LOTTE CHOCO PIE by using a deceptively similar trademark “CHOCO PIE”?

2. Whether the Defendants are passing off the Defendant's “CHOCO PIE” products as and for the Plaintiff's products under the trademark “LOTTE CHOCO PIE”?



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3. *Whether both the marks being phonetically, visually, ocularly and structurally similar is likely to cause confusion and deception to arise among the trade and public in view of the same?*

4. *Whether the Plaintiff is entitled to damages?*

5. *Whether the Plaintiff proves that the first defendant is the manufacturer and the second defendant was his dealer in Chennai?*

6. *Whether the second defendant is the necessary/proper party to the present suit?*

7. *Whether the Plaintiff is entitled to any of the relief as prayed for?"*

9. On 17.07.2023, the learned counsel for the plaintiff was present and he represented that the witness was not available and the matter was adjourned to 19.07.2023. The learned counsel for the 2nd defendant was also present on the said date. On 19.07.2023, once



again there was no representation on the side of the plaintiff either in person or through their counsel till 1 PM and after that the learned counsel for the plaintiff had represented that the parties were settling the matter and had requested the matter to be listed before this Court.

10. Today, when the matter had come up, Mr.K.Srinivasa Murthy, appearing on behalf of the 2nd defendant would submit that they have clearly and categorically contended in their written statement that they had no business connection with the 1st defendant and that they never imported any product of the 1st defendant. On the contrary, they had been marketing the plaintiff's product which also they have now stopped marketing.

11. The 2nd defendant in their written statement have stated as follows:

“8. This Defendant states that they have never imported the products of the 1st Defendant nor distributed



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them as alleged by the Plaintiff. On the other hand they are only a semi-wholesaler i.e. they purchase from wholesalers and re-sell it to small shop keepers and consumers. Infact they have only sold the product of the Applicant which carries MRP. This Defendant has been unnecessary made a party to the suit. The Plaintiff has unnecessarily dragged this Defendant to Court. This Defendant had purchased the Chocopie manufactured by the Plaintiff from M/s. A to Z marketing vide invoice No. 192 dt. 25.02.2012 along with other products and sold the same. Therefore the Suit is liable to be dismissed against this Defendant for the aforesaid reason itself.

9. Without prejudice to the above, after the receipt of the Notice from the Plaintiffs Lawyer, this Defendant stopped purchasing and selling Chocopie. Therefore, even on that score the suit against this defendant is liable



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defendants are available in the city of Chennai within the Jurisdiction of this Hon'ble Court.

The cause of action does not plead the import by the 2nd defendant.

14. The 2nd defendant has filed a written statement in which they have clearly denied this statement and have categorically stated that they have no connection with the 1st defendant and that they have not sold the 1st defendant's product within the jurisdiction of this Court. The document that have been produced on the side of the plaintiff does not go to prove that the 1st defendant is manufacturing the CHOCO PIE and marketed it using identical mark as that of the plaintiff and that the 2nd defendant has marketed the said product.

15. In fact, the plaint is absolutely silent about where the manufacture of CHOCO PIE is taking place, particularly when the 1st defendant is shown as carrying on business at Vietnam. The 1st



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defendant has remained ex parte and no cause of action has been pleaded against the 1st defendant particularly with reference to their place of business etc., and that the alleged infringement is done by the 1st defendant. The undertaking given by the 2nd defendant would be sufficient since the allegation is that the 1st defendant is marketing through the 2nd defendant.

16. Therefore, the suit is decreed partly in terms of paragraph nos.8 and 9 of the written statement filed by the 2nd defendant with reference to reliefs (a) and (b) and dismissed with reference to reliefs (c) to (f) as the plaintiff has failed to prove the infringement by the defendants. No costs .

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Internet : Yes/No
Index : Yes/No
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P.T. ASHA. J,

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