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C.S.(Comm.Div) No.8 of 2021

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 16.11.2023

Pronounced on : 29.11.2023

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

C.S.(Comm.Div) No.8 of 2021

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

... Plaintiff

Vs.

Kalasakthi Agro Private Limited,
434/2, Arcot - Tindivanam Road,
Pudupadi Village,
Arcot - 632 503,
Ranipet District.

... Defendant

Prayer: Complaint filed under Order IV Rule 1 of the Original Side Rules and Order VII Rule 1 of the C.P.C. read with Section 27 (2), 29, 134 and 135 of the Trademarks Act, 1999 and Sections 54, 55 and 62 of the Copyright Act, 1957 for

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



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sale edible oil both domestic and exports by using the impugned Trademark ROOBAM upon the goods or in any media and use the same in invoices, letter heads and visiting cards or by using any other Trademark which is in any way substantially reproduce the Plaintiff's Trademark ROOBINI or in any manner infringing the Plaintiff's Trademark (word) 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 ROOBAM (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 for sale edible oil both domestic and exports by using the impugned Copyright ROOBAM (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



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in any way substantially reproduce the Plaintiff's Copyright ROOBINI shown in Document No. 1 or in any manner infringement 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 favor of the Plaintiff, directing the Defendant to render an account of profits made by them by the use of the trademark ROOBAM and by using the same Color Scheme and Get up in the Plaintiff's trademark ROOBINI on the goods referred and for a final decree in favor 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.

For Plaintiff : Ms.Gladys Daniel

For defendant : Mr.K.Shakespeare



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JUDGMENT

WEB COPY This suit has been filed for infringement and passing off.

2. The plaintiff is aggrieved by the usage of the offending trademark “ROOBAM” by the defendant, which, according to the plaintiff, is deceptively similar to that of the plaintiff's registered trademark “ROOBINI”. According to the plaintiff, the colour scheme and getup of the defendant's pouch is identical to that of the plaintiff. The plaintiff also claims that since the suit has been instituted at a place where they are carrying on their business, the suit for infringement and passing off in respect of the trademark and copyright is maintainable before this Court under its Commercial Division as per the provisions of Section 134 of the Trademarks Act, 1999, Section 62 (2) of the Copyright Act, 1957 read with the first proviso to Section 7 of the Commercial Courts Act, 2015. However, it is the case of the defendant that this Court does not have jurisdiction to decide the suit since the principal place of business for the plaintiff is at Kodungaiyur, which is situated outside the jurisdiction of this Court and not Thambu Chetty Street, Chennai, as disclosed in the plaint. Hence, according to them, Section 134 of the Trademarks Act, 1999, as well as Section 62 (2) of the



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Copyright Act, 1957, will not come to the aid of the plaintiff for instituting the suit before this Court. It is also their contention that since the suit has been valued below Rs.3 lakhs, the Commercial Division of this Court does not have pecuniary jurisdiction to decide the suit.

3. The defendant also contends that their trademark ROOBAM is not deceptively similar to the plaintiff's registered trademark ROOBINI. According to them, the word "ROOBINI" and "ROOBAM" are not phonetically and visually similar. Further, it is their case that the distinctive characteristics of the pouches of ROOBINI and ROOBAM are totally different. Further, it is their case that ROOBINI and ROOBAM are universal common names and no one can claim exclusive usage. The defendant also contends that the plaintiff does not have a valid assignment of the trademark ROOBINI in their favour and therefore, not entitled to file this suit.

4. Based on the pleadings of the plaintiff and the defendant in the suit, this Court by its order dated 26.10.2021 had framed the following issues:-



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- “i) Whether this Court has jurisdiction to try the suit as a commercial dispute?*
- ii) Whether the plaintiff is the registered proprietor of the trademark ROOBINI?*
- iii) Whether the defendant has committed infringement of plaintiff's trademark?*
- iv) Whether the defendant's trademark is deceptively similar to the registered trademark of the plaintiff?*
- v) Whether the defendant is guilty of passing off?*
- vi) Whether the plaintiff holds any valid assignment of the copyright in its favour?*
- vii) Whether the plaintiff is entitled for permanent injunction against the defendant?*
- viii) To what other reliefs?”*

5. Before the learned Additional Master - III, High Court, Madras, Mr.G.Chandrasekaran, Executive - HR of the plaintiff's company was examined as a witness (PW1) on behalf of the plaintiff. He had also filed a proof affidavit, reiterating the pleadings made in the plaint. Through PW1, the following documents were marked as exhibits:-



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" Ex.P1 is the board resolution dated 23.12.2021.

Ex.P2 is the plaintiff's website (along with 65B affidavit).

Ex.P3 is the original chartered accountant certificate dated 11.06.2021.

Ex.P4 is the plaintiff's pouch.

Ex.P5 is the defendant's pouch.

Ex.P6 is the legal use certificate of trade mark no.837894 in class 29, dated 22.01.1999 (compared with original).

Ex.P7 is the is the legal use certificate of trade mark no. 1415277 in class 29, dated 20.01.2006 (compared with original).

Ex.P8 is the office copy of the cease and desist legal notice dated 11.03.2020.

Ex.P9 is the office copy of the cease and desist legal notice dated 21.01.2021.

Ex.P10 is the reply notice by the defendant dated 05.02.2021.

Ex.P11 is the original of the sample sale invoices for the year 2008 to 2020.

Ex.P12 is the original of the sample advertisement in newspapers, magazines and invoice for the period of 1999 to 2018."



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6. The plaintiff's witness (PW1) was also cross examined by the defendant's counsel. By consent of the plaintiff, the following documents were marked as exhibits on the side of the defendant, which is confirmed through the affidavit of admission / denial of documents filed by the plaintiff:-

"Ex.D1 is the copy of the Deed of assignment dated 30.12.2007;

Ex.D2 is the copy of the affidavit of Director dated 22.07.2015;

Ex.D3 is the copy of the company master data of the plaintiff company filed by the defendant;

Ex.D4 is the copy of the company profile of the plaintiff company for GST dated 27.07.2021 filed by the defendant."

However, no oral evidence was let in by the defendant.

7. Heard, Ms.Gladys Daniel, learned counsel for the plaintiff, and Mr.K.Shakespeare , learned counsel for the defendant. Both the counsels, after drawing the attention of this Court to the pleadings and the exhibits, reiterated the contentions of their respective clients.



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8. The learned counsel for the plaintiff, in support of the plaintiff's contentions, relied upon the following authorities:

a) A decision of the Honourable Supreme Court in the case of ***Parle Products (P) Ltd. Vs. J.P.and Co., Mysore*** reported in ***AIR 1972 SC 1359***;

b) A decision of the Honourable Supreme Court in the case of ***Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.*** reported in ***AIR 2001 SC 1952***;

c) A single bench decision of the Delhi High Court dated 04.12.1990 in the case of ***Modi Threads Limited Vs. Som Soot Gola Factory and Others*** reported in ***AIR 1992 DELHI 4***;

d) A division bench judgment of the Madras High Court in the case of ***Wipro Limited and Others Vs. Oushadha Chandrika Ayurvedic India (P) Limited and Others*** reported in ***AIR 2008 MAD 165***.

9. The learned counsel for the defendant, in support of his submissions, relied upon the following authorities:



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<i>Date</i>	<i>Particulars of Reports (Relevant paragraphs)</i>
29.09.1980	AIR1981 PH117- Indian Kanoon Print (6 and 7)
07.11.1985	AIR 1986 Delhi 444-STPL (18, 23, 26-29,37,39,42,43,49,50,52 & 55)
20.07.1990	AIR 1992 Kar 1-DB- STPL Printout (9 & 11)
09.09.1991	AIR 1992 Bom 144- Indian Kanoon (12,13, 14 & 16)
25.11.1992	(1993) 2 MLJ 132-Indian Kanoon (4)
20.05.1994	(1994) 4 SCC 225 STPL Printout (42)
30.07.2001	2001(3) CTC 652-Indian Kanoon (1,3,7,9 and 10)
15.12.2005	AIR 2006 SC 730-STPL (19, 20, 22 23,26,32,37,43,44,46,51 and 52)
05.08.2008	AIR 2008 SC 3261 STPL (20)
15.02.2016	230(2016)DLT377- STPL (13)
30.01.2019	Indian Kanoon-MHC-OSA 291/2018 (5,13 and 14)
04.10.2019	2019 STPL 11111SC (19,24,27,28)

Discussion:

Issue (i):-

i) Whether this Court has jurisdiction to try the suit as a commercial dispute?



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10. An ordinary civil suit is usually instituted before the competent Court in accordance with Section 20 of the Code of Civil Procedure, 1908. Clause (a) and (b) of Section 20 provides that 'a suit can be instituted where the defendants actually and voluntarily resides, or carries on business, or personally works for gain'. This is the general principle with respect to jurisdiction and cause of action in ordinary civil suits. Further, clause (c) of this Section provides that a suit can also be instituted in the jurisdiction of a Court where the cause of action has wholly or in part arisen.

11. Fundamentally, a cause of action is a legal right on which a claimant sues. A cause of action is a substantive legal right to the extent that there are recognized categories of causes of action, such as – breach of contract, negligence, trademark/copyright/design infringement, passing-off, misrepresentation, etc,. In other words, when a factual situation satisfies the elements of the substantive law or basis for interim relief – its "essential ingredients", you have a legal right to sue for a remedy. Therefore, cause of action is the legal basis for liability (substantive law) + facts pleaded in a case.



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12. In *Kusum Ingots & Alloys Ltd., Vs. Union of India* reported in 2004 (6) SCC 254, the Hon'ble Supreme Court interpreted the term 'cause of action' to mean "every fact which should be necessary for the plaintiff to prove, if traversed, in order to support his right to the judgment of that Court". The relevant Sections pertaining to the jurisdiction under various Intellectual Property regimes in India are as under:

<i>Act</i>	<i>Relevant Section</i>
<i>The Trademarks Act, 1999</i>	<i>134</i>
<i>The Copyright Act, 1957</i>	<i>62</i>
<i>The Patents Act, 1970</i>	<i>104</i>
<i>The Designs Act, 2000</i>	<i>22</i>

13. This Court is concerned in this Suit only with regard to the Court's jurisdiction under the Trademarks Act, 1999 and the Copyright Act, 1957. Section 62 (2) of the Copyright Act, 1957 and section 134 (2) of the Trademarks Act, 1999 confers a right on the plaintiff to institute a suit in the jurisdiction of the District Court where the plaintiff actually resides, carries on business or personally works for gain. Admittedly, in the present suit, the plaintiff has instituted the suit before this Court only



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on the basis of Section 134 (2) of the Trademarks Act, 1999 and Section 62 (1) of the Copyright Act, 1957 read with the first proviso to Section 7 of the Commercial Courts Act, 2015, and not based on Section 20 CPC.

14. The first proviso to Section 7 of the Commercial Courts Act, 2015 makes it clear that all suits and applications relating to Commercial disputes, stipulated by an Act to lie in a Court not inferior to a District Court, and filed or pending on the Original Side of the High Court, shall be heard and disposed of by the Commercial Division of the High Court. Admittedly, the instant suit is a commercial dispute. Though the suit has been valued below the specified value, the first proviso to Section 7 of the Commercial Courts Act, 2015 makes it clear that a Trademark infringement suit under Section 134 of the Trademarks Act, 1999 or a Copyright infringement suit under Section 62 of the Copyright Act, 1957 can be filed only before the Madras High Court Original Side, if the plaintiff carries on business in the city of Chennai within the original side jurisdiction of this Court and the disclosure of specified value for the purpose of suit valuation is immaterial for the purpose of deciding jurisdiction. The term "carrying on business" as found in Section 134



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(2) of the Trademarks Act, 1999 and Section 62 (1) of the Copyright Act, 1957 has been interpreted by the Honourable Supreme Court in the case of ***India Performing Rights Society Ltd., Vs. Sanjay Dalia and Another*** reported in ***2015 (10) SCC 161***.

15. The Hon'ble Supreme Court in its decision rendered in ***India Performing Rights Society Ltd., Vs. Sanjay Dalia*** reported in ***2015 (10) SCC 161*** held, after giving due consideration to the language of Section 62 of the Copyright Act and Section 134 of the Trademarks Act, that an additional forum has been provided for trademark infringement and copyright infringement actions to be brought before a District Court within whose limits the plaintiff actually and voluntarily resides, or carries on business, or personally works for gain.

16. The Hon'ble Supreme Court in ***Sanjay Dalia's*** case referred to supra has analyzed and has given its interpretation to the expression "Carries on business" in the context of the plaintiff under Section 134 (2) of the Trademarks Act, 1999 and Section 62 (2) of the Copyright Act, 1957. The Hon'ble Supreme Court has observed that under the



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aforementioned provisions, four situations can be contemplated in the context of the plaintiff, instituting the trademarks and copyright infringement suit:-

a) First of all, it is the situation where the plaintiff has a sole office. In such a case, even if the cause of action has arisen at a different place, the plaintiff can institute a suit at the place of its sole office.

b) Second is the situation, where the plaintiff has a principal office at one place and a subordinate or branch office at another place and the cause of action has arisen at the place of the principal office. In such a case, the plaintiff may sue at the place of the principal office but cannot sue at the place of the subordinate or branch office.

c) The third situation is, where the plaintiff has a principal office at one place and the cause of action has arisen at the place where its subordinate office is located. In this eventuality, the plaintiff would be deemed to carry on business at the place of his subordinate office and not at the place of the principal office.

d) The fourth situation is where the cause of action neither arises at the place of the principal office nor at the place of the subordinate office but at some other place. In this eventuality, the



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plaintiff would be deemed to carry on business at the place of its principal office and not at the place of the subordinate office.

17. In the case on hand, the fourth situation referred to supra applies as no part of cause of action, admittedly, arose within the jurisdiction of this Court, but, the principal place of the plaintiff's business is situated within the jurisdiction of this Court at **Kodungaiyur, Chennai**. Though the plaintiff has pleaded in the plaint for the purpose of cause of action for instituting the suit before this Court that it is carrying on business at No.48/310, Thambu Chetty Street, Chennai - 600 001, the address disclosed by the plaintiff in the plaint is admittedly not its principal place of business, but, it is only its Corporate office. If the Corporate office is taken into consideration for the purpose of deciding the jurisdiction, this Court will not have jurisdiction. However, after verification by this Court from the Registry, it is found that pursuant to the extension of ordinary original civil jurisdiction of Madras High Court through the Madras High Court (jurisdictional limits) Extension Act, 1985, the ordinary original civil jurisdiction of Madras High Court was extended, which included Kodungaiyur, where admittedly the principal



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place of the plaintiff's business is located. The plaintiff has also pleaded in paragraph No.5 of the plaint that the plaintiff had its origin in Chennai in 1971 when late Shri.K.T.Varadaraj Chetty established an oil trading business at Kotwal Market, the first ever retail venture operated in the Kotwal market.

18. The learned counsel for the plaintiff, during the course of her submissions also highlighted the said pleadings and would submit that since Kotwal market is within the jurisdiction of this Court, the present suit filed before this Court is maintainable as this Court is having the jurisdiction to decide the same.

19. However, on the other hand, the learned counsel for the defendant, during the course of his submissions, would reiterate the pleadings as found in the written statement by stating that since the registered office / principal place of business of the plaintiff is at Kodungaiyur, which is outside the jurisdiction of this Court, the plaintiff cannot get the benefit of Section 134 of the Trademarks Act and Section 62 of the Copyright Act, by stating that the plaintiff is carrying on



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business within the jurisdiction of this Court and filing the instant suit before this Court. According to him, the Thambu Chetty Street address given by the plaintiff is not the principal office of the plaintiff and the principal office is situated only in Kodungaiyur, which is the registered office and therefore outside the jurisdiction of this Court. The said argument of the learned counsel for the defendant will no longer hold water in view of the fact that Kodungaiyur falls within the ordinary original civil jurisdiction of the High Court of Madras pursuant to the extension of the jurisdiction as per the Madras High Court (jurisdictional limits) Extension Act, 1985.

20. The defendant has filed the following documents which have been marked as exhibits on their side with the consent of the plaintiff as seen from the affidavit of admission / denial of documents filed by the plaintiff:

- a) A copy of the Deed of assignment dated 30.12.2007 marked as Ex.D1;*
- b) A copy of the affidavit of Director dated 22.07.2015 marked as Ex.D2;*
- c) A copy of the company master data of the plaintiff company filed by the defendant which has*



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been marked as Ex.D3;

d) A copy of the company profile of the plaintiff company for GST dated 27.07.2021 filed by the defendant marked as Ex.D4."

21. As seen from exhibits D1 to D4, which have been allowed to be marked as exhibits with the consent of the plaintiff, it is clear that the principal place of business of the plaintiff is situated at No.7/3, Arul Nagar Salai, Kodungaiyur, Chennai, Tamilnadu 600 118, which is admittedly within the original side jurisdiction of this Court as per the Madras High Court (jurisdictional limits) Extension Act, 1985. Ex.D2 is a copy of the affidavit dated 22.07.2015 submitted by Mr.Babu Bhoopathy, Director of the plaintiff, claiming entitlement of the plaintiff for the usage of the trademark "ROOBINI" by virtue of the Deed of Assignment dated 30.12.2007 (Ex.D1). Ex.D3 is a copy of the company's Master data of the plaintiff company registered with the Registrar of Companies and Ex.D4 is a copy of the company profile of the plaintiff company for GST dated 27.07.2021.



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22. In all the aforesaid exhibits, the only address of the plaintiff disclosed is No.7/3, Arul Nagar Salai, Kodungaiyur, Chennai, Tamilnadu 600 118. Infact, in the copy of the Company profile of the Company for GST dated 27.07.2021, marked as Ex.D4, it reveals that the principal place of business of the plaintiff Company is situated only at No.7/3, Arul Nagar Salai, Kodungaiyur, Chennai, Tamilnadu-600 118.

23. The Hon'ble Supreme Court in *Sanjay Dalia's* case, referred to supra, has given due consideration to the Division Bench Judgment of this Court dated 29.02.2008 in the case of *Wipro Limited and Others Vs. Oushadha Chandrika Ayurvedic India (P) Limited and Others* reported in *AIR 2008 MAD 165* and only after giving due consideration to the same, has interpreted the term "place of business" found in Section 134 (2) of the Trademarks Act, 1999 and in Section 62 (2) of the Copyright Act, 1957, as a place, where the plaintiff is having its principal place of business. Since the plaintiff's principal place of business is at Kodungaiyur, Chennai, which is within the original side jurisdiction of this Court, the present suit filed under Section 134(2) of the Trademarks Act, 1999, and Section 62(2) of the Corporate Act, 1957, read with first



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proviso to the Commercial Courts Act, 2015, is maintainable before this Court, as this Court has got jurisdiction.

24. There is no necessity for this Court to consider the principle of forum convenience as the suit has been filed only before the Court, which is having jurisdiction over the principal place of the plaintiff's business. Further, only after obtaining leave under Clause 12 of the Letters Patent to sue the defendant, the plaintiff had instituted this suit. The question of non-suiting the plaintiff before this Court on the ground of forum non-convenience at the final stage of the suit will not arise and the said request made by the defendant has to be rejected by this Court. Accordingly, for the foregoing reasons, the first issue is answered in favour of the plaintiff by holding that this Court has got jurisdiction to try this suit as a commercial dispute, in view of the judgment rendered by the Hon'ble Supreme Court in *Sanjay Dalia's case (cited supra)*, wherein it has been held that the Court having jurisdiction over the principal place of the plaintiff's business is having the jurisdiction to decide the trademark and copyright infringement suit. The first proviso to Section 7 of the Commercial Courts Act, 2015, also makes it clear that this Court is having the jurisdiction to decide this commercial dispute.



Issue (ii):-

WEB COPY (ii) Whether the plaintiff is the registered proprietor of the trademark “ROOBINI”?

25. With regard to this issue, this Court is of the considered view that the same has not been disputed by the defendant. As seen from the written statement and further from the legal use certificate issued in favour of the plaintiff by the trademark registry, which have been marked as Exs.P6 and P7, it is clear that the plaintiff is the registered proprietor of the trademark “ROOBINI” as they have obtained registration for the said trademark under Class 29, hence, issue (ii) framed by this Court is answered by this Court in favour of the plaintiff.

Issues (iii), (iv) & (v):-

(iii) Whether the defendant has committed infringement of plaintiff's trademark?

(iv) Whether the defendant's trademark is deceptively similar to the registered trademark of the plaintiff?

(v) Whether the defendant is guilty of passing off?



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26. With regard to these issues, the following reasons are given by this Court for coming to the conclusion that the defendant has not committed infringement of the plaintiff's trademark and the defendant's trademark is also not deceptively similar to the registered trademark of the plaintiff.

(a) The color scheme and getup of the defendant's mark "ROOBAM" are different from "ROOBINI", which is the registered trademark of the plaintiff. "ROOBAM" denotes beauty in Sanskrit. The following distinctive characteristics of the mark found in the pouch used by the defendant will clearly reveal that the colour scheme, getup and pronunciation of the name are different from that of the plaintiff's trademark "ROOBINI" and its colour scheme and getup as found in its pouch. The differences are illustrated hereunder:-

Sl. No.	Characteristics	ROOBAM Defendant	ROOBINI Plaintiff
1.	Pronunciation of name (Phonetics)	Entirely different, except for first letters ROO, nothing else is common	
2.	Colour scheme (Getup)	Red	Orange
3.	Description of product	RBD Palmolein Oil	Refined Palm Oil



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Sl. No.	Characteristics	ROOBAM Defendant	ROOBINI Plaintiff
4.	Other words in front	Nil	Fortified with Vitamin A, D. Goodness in every day. Made from imported oil, fruit cherry, pizza, pudding.
5.	Representation picture in front	Vada, Samosa, Uppuma	Fruit Cherry, Pizza, Pudding
6.	Fonts	Gap between alphabets in the name	Alphabets are continuous
7.	Backside	Layout entirely different	

(b) The picture of both the pouches are shown below:-

Plaintiff's pouch:-



Defendant's pouch:-





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27. The defendant had also brought the aforesaid differences to the notice of the plaintiff in its reply dated 05.02.2021 (Ex.P10) to the cease and desist notice dated 21.01.2021 (Ex.P9) sent by the plaintiff. This Court, after comparing the plaintiff's trademark and its pouch and the defendant's trademark and its pouch as a whole, notices that any person of average intelligence and imperfect recollection will not get deceived by both the pouches or by the names "ROOBINI" and "ROOBAM". If it is a reputed trademark involving cooking oil, any person of average intelligence and imperfect recollection will only ask for the correct name and he/she will not have any confusion. The product, which is being sold by the plaintiff as well as the defendant, is cooking oil, which is of regular usage for cooking purpose by any person/family. "ROOBINI" and "ROOBAM" are two different names, though ROOBINI may have acquired secondary meaning identified with the plaintiff, it cannot be said that ROOBAM, which is another universal common name, is also identified with the plaintiff on account of their large turnover in respect of its cooking oil business. The plaintiff cannot also claim that just because the prefix "ROO" is common to "ROOBINI" and "ROOBAM",



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both the names are deceptively similar. ROOBINI brand of the plaintiff,

if it is a reputable brand, any customer will order for the same only by telling its correct name or if it is kept in a shelf in a supermarket/mall, he/she will pickup correctly from the shelf by seeing the name. Even an illiterate person will not get confused as the pouch of the plaintiff is totally different from the pouch used by the defendant. Though the plaintiff contends that font used by the plaintiff, namely, bubble font, has been copied by the defendant, this Court is of the considered view that even after a very close viewing of both the labels, this Court is unable to accept the plaintiff's contention as the defendant's label and its colour scheme are totally different and there is no possibility for any person of average intelligence and imperfect recollection to get confused.

28. Deceptively similar trademarks are those trademarks which are very similar to an already existing trademark causing confusion among the customers. Section 2(h) of the Trade Marks Act, 1999, defines the concept of deceptive similarity and it means that a mark need not be identical to be called deceptively similar to that of another, but if it so nearly resembles the other mark, there is a high chance that it will



deceive the general public or cause confusion in their minds.

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29. An important factor, while considering a mark to be 'deceptive', is that the public with an average intelligence gets confused regarding the source of the goods or service. There are three main factors, that are considered, while assessing the similarity of marks;

(i) **Visual similarity:** The first factor or component to be considered is the visual similarity of the marks and this would include all visual aspects of the mark, like any common syllables, suffixes, prefixes, shapes, length, etc.;

(ii) **Aural similarity:-** The aural similarity of marks is another component that is considered while deciding the issue of deceptive similarity. Marks are said to be aurally similar when the pronunciation of the marks are identical, that may be based on pronunciation of the marks, enunciation or number of syllables or even on the length of the marks.

(iii) **Conceptual similarity:-** Certain marks may not be visually or aurally similar, rather might be similar with respect to its concept. In that case, the overall message of the mark is to be considered to judge the



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similarity of the marks. There is another type of similarity, which comes under both visual and aural similarity. This is phonetic and visual similarity. This refers to the ear as well as the eye, something which looks similar visually as well as something that sounds similar as well.

30. Dilution of trademark occurs when a famous mark is used by someone else which reduces, tarnishes or blurs the mark or the perspective of the customers regarding the mark. In general terms, it means diminishing the value of the a famous mark with respect to its uniqueness, effectiveness and distinctiveness. Such dilution supplements the confusion as to source, affiliation or connection. Unauthorized use of the mark on the goods in question which are competing goods itself results in dilution. Potential purchasers are bound to be confused as to source, sponsorship, connection or license.

31. When a third party uses or replicates a well-established mark and tries to take benefit of the goodwill of such a mark, it is called as Unfair Competition. Trademarks of well-established marks are protected under the concept of dilution of trademarks in unfair competition



prevention laws. This is so because when a well-known mark is used by a third party, the goodwill of the mark is also being taken benefit of, along with the mark.

32. The Trademarks Act, 1999, does not explain deceptive similarity in detail and it does not lay down specific essentials that would fall under deceptive similarity. The scope of such a concept is very wide, hence, judicial decisions help understand this concept better. The interpretation of Courts of the term “deceptive similarity” helps to give clarity for its meaning. The leading decisions regarding deceptive similarity which has also been cited by both the counsels highlight the following:-

(i) Due to diversified population of the country, confusing marks should be strictly prohibited when manufacturing drugs and pharmaceuticals. Therefore, when manufacturing medical products, proper care and precaution should be taken to ensure that the general public are not deceived by the names.

(ii) The likelihood to cause confusion in the minds of the general public is the main factor to be considered while deciding whether there is



deceptive similarity or not.

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(iii) For deciding the deceptive similarity, the following three tests

has to be satisfied:-

- (a) The mark as a whole.
- (b) Average intelligence of the general public.
- (c) Imperfect recollection.

33. Each case has to be viewed and interpreted separately based on the features. Therefore, there cannot be any common tests for deceptive similarity and the tests for deciding the deceptive similarity depends upon the facts of each case.

34. In the case on hand, as observed earlier, no person with average intelligence and imperfect recollection will get deceived by the defendant's product "ROOBAM". The essential features as found in their pouch which is being sold in the open market are totally different from the plaintiff's pouch as seen from the differences highlighted in one of the paragraphs supra.



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35. The defendant's trademark “ROOBAM” and its pouch is neither identical nor deceptively similar to that of the plaintiff's trademark “ROOBINI”. Therefore, the defendant has not committed infringement of the plaintiff's registered trademark “ROOBINI” and they have also not committed the act of passing off, as no person with average intelligence and imperfect recollection will get confused between the plaintiff's product and the defendant's product. Therefore, issues (iii), (iv) & (v) framed by this Court are also answered against the plaintiff by holding that the defendant's product and its pouch is not deceptively similar to that of the plaintiff's registered trademark “ROOBINI”.

Issues (vi) & (vii):-

(vi) Whether the plaintiff holds any valid assignment of the copyright in its favour?

(vii) Whether the plaintiff is entitled for permanent injunction against the defendant?

36. Since the defendant's trademark “ROOBAM” and its pouch are



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neither identical nor deceptively similar to that of the plaintiff's trademark "ROOBINI" and its pouch, there is no necessity for this Court to give a finding with regard to issue (vi) referred to supra. However, in view of the finding given by this Court that the defendant has not committed an act of infringement or passing off, issue (vii) referred to supra has to be answered against the plaintiff by holding that the plaintiff is not entitled for permanent injunction as prayed for in the plaint against the defendant.

37. For the foregoing reasons, this Court is of the considered view that there is no merit in the suit filed by the plaintiff and it has to be dismissed. Accordingly, this suit is dismissed. No Costs.

29.11.2023

Index: Yes/ No
Speaking order / Non speaking order
Neutral citation : Yes / No
rkm/ab



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Plaintiff's witness:-

Mr.G.Chandrasekaran - PW1

Documents exhibited by the plaintiff:-

Ex.P1 -- Board resolution dated 23.12.2021.

Ex.P2--The plaintiff's website (along with 65B affidavit)

Ex.P3—The original chartered accountant certificate dated 11.06.2021.

Ex.P4 -- The plaintiff's pouch.

Ex.P5 -- The defendant's pouch.

Ex.P6--The legal use certificate of trade mark no.837894 in class 29, dated 22.01.1999 (compared with original).

Ex.P7 -- The legal use certificate of trade mark no. 1415277 in class 29, dated 20.01.2006 (compared with original).

Ex.P8--A office copy of the cease and desist legal notice dated 11.03.2020.

Ex.P9--A office copy of the cease and desist legal notice dated 21.01.2021.

Ex.P10--A reply notice by the defendant dated 05.02.2021.

Ex.P11--The original of the sample sale invoices for the year 2008 to 2020.



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Ex.P12--The original of the sample advertisement in newspapers, magazines and invoice for the period of 1999 to 2018."

Defendant's Witness:-

Nil

Documents exhibited by the defendant:-

Ex.D1--The copy of the Deed of Assignment dated 30.12.2007;

Ex.D2--The copy of the affidavit of Director dated 22.07.2015;

Ex.D3-- A copy of the company master data of the plaintiff company filed by the defendant; and

Ex.D4--A copy of the company profile of the plaintiff company for GST dated 27.07.2021 filed by the defendant.

AQJ



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ABDUL QUDDHOSE, J.

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Judgment in

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29.11.2023