



O.A.Nos.694 to 696 of 2023 and A.No.6332 of 2023
in C.S.No.197 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Orders Reserved on : 05.06.2024

Orders Pronounced on : 02.07.2024

Coram:

THE HONOURABLE MR.JUSTICE P.VELMLURUGAN

O.A.Nos.694 to 696 of 2023 and A.No.6332 of 2023
in
C.S.No.197 of 2023

M/s.Kaleesuwari Refinery Private Limited,
Represented by its Manager (Legal)
Mr.A.Saravanan

.. Applicant in O.A.Nos.694 to 696 of 2023

Vs.

Chetan Kothari
Trading as Raman Traders

.. Respondent in O.A.Nos.694 to 696 of 2023

Chetan Kothari
Trading as Raman Traders

.. Applicant in A.No.6332 of 2023

Vs.

M/s.Kaleesuwari Refinery Private Limited,
Represented by its Manager (Legal)
Mr.A.Saravanan

.. Respondent in A.No.6332 of 2023

M/s.Kaleesuwari Refinery Private Limited,
Represented by its Manager (Legal)
Mr.A.Saravanan

.. Plaintiff in C.S.No.197 of 2023

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Vs.

Chetan Kothari
Trading as Raman Traders

.. Defendant in C.S.No.197 of 2023

Plaint filed under Order IV Rule 1 of the Original Side Rules of this Court, read with Order VII Rule 1 of the Code of Civil Procedure, read with Sections 134 and 135 of the Trade Marks Act, 1999, read with Sections 11 and 22 of the Designs Act, 2000, and suit numbered as C.S.(Comm.Div).No.197 of 2023 praying to pass judgment and decree:

(i) for a permanent injunction restraining the respondent/defendant, their men, agents, associates and/or assignees or any person claiming rights from them from infringing the plaintiff's reputed and well known registered trade mark "DHEEPAM" by using the offending trade mark "SHREE DEEPAM OIL" or any mark or word deceptively similar to the aforesaid trade mark of the plaintiff for edible oil marketed by the defendant, their men, agents, associates and/or assignees or any person claiming rights from the defendant.

(ii) for a permanent injunction restraining the defendant, its men, agents, associates and/or assignees or any person claiming rights from therein from passing-off their inferior product, as that of the plaintiff's DHEEPAM lamp oil by using the offending words 'SHREE DEEPAM OIL' or any other words or mark and offending packing material/pouch/bottles deceptively similar to the plaintiff's trade mark DHEEPAM and trade dress for DHEEPAM..

(iii) for a permanent injunction restraining the defendant, their men, agents, assignees, dealers and/or retailers from using the bottle for their product SHREE DEEPAM OIL by resorting to fraudulent imitation of the plaintiff's registered Design No.245127, dated 07.05.2012 in respect of the



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container/bottle used by the plaintiff for marketing/selling "DHEEPAM" lamp oil.

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(iv) for preliminary decree directing the defendant to render true account of profits made by the defendant by using the aforesaid offending mark/label of SHREE DEEPAM OIL.

(v) for erasure, removal or obliteration from all infringing goods, materials or articles in the possession or control of the defendant with the offending mark/labels and pouches deceptively similar to the plaintiff's DHEEPAM, and

(vi) to pay costs of the suit.

Original Application No.694 of 2023 - Judge's Summons issued under Order XIV Rule 8 of the Original Side Rules of this Court, read with Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, and praying to grant an order of interim injunction restraining the respondent/defendant, their men, agents, associates and/or assignees or any person claiming rights from them from infringing the applicant/plaintiff's reputed and well known registered trade mark "DHEEPAM" by using the offending trade mark "SHREE DEEPAM OIL" or any mark or word deceptively similar to the aforesaid trade mark of the applicant/plaintiff for lamp oil marketed by the respondent/defendant, their men, agents, associates and/or assignees or any person claiming rights from the respondent/defendant, pending disposal of the suit.

Original Application No.695 of 2023 - Judge's Summons issued under Order XIV Rule 8 of the Original Side Rules of this Court, read with Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, and praying to grant an order of interim injunction restraining the respondent/defendant, its men, agents, associates and/or assignees or any person claiming rights from therein from passing-off their inferior product, as that of the applicant/plaintiff's DHEEPAM



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lamp oil by using the offending words 'SHREE DEEPAM OIL" or any other words or mark and offending packing material and pouch deceptively similar to the applicant/plaintiff's trade mark DHEEPAM, pending disposal of the suit.

Original Application No.696 of 2023 - Judge's Summons issued under Order XIV Rule 8 of the Original Side Rules of this Court, read with Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, and praying to grant an order of interim injunction restraining the respondent, their men, agents, assignees, dealers and/or retailers from using the bottle design for their product SHREE DEEPAM OIL by resorting to fraudulent imitation of the applicant/plaintiff's registered Design No.245127, dated 07.05.2012 in respect of the container/bottle used by the applicant/plaintiff for marketing/selling "DHEEPAM" lamp oil, pending disposal of the suit.

A.No.6332 of 2023 : Judge's Summons issued under Order XIV Rule 8 of the Original Side Rules of this Court, read with Section 124(1)(ii) of the Trade Marks Act, 1999: praying to frame a preliminary issue i the present suit regarding the validity of the respondent's registration for the trade mark DEEPAM and consequently grant leave to the applicant to initiate proceedings to rectify/remove/cancel the respondent's registration for trade mark DEEPAM under No.2320404 in Class 4 from the Register of Trade Marks.

For applicant in O.A.Nos.694 to 696 of 2023 and
also for respondent in A.No.6332 of 2023 : Mr.Vijayan Subramanian

For applicant in A.No.6332 of 2023 and
also for respondent in O.A.Nos.694 to 696 of 2023 : Mr.Rajesh Ramanathan



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COMMON ORDER

This Court heard both sides in respect of all these applications and perused the records.

2. For the sake of convenience, the parties are referred to as they are ranked in the suit.

3. The plaintiff has filed the present suit to pass judgment and decree:

(i) for a permanent injunction restraining the respondent/defendant, their men, agents, associates and/or assignees or any person claiming rights from them from infringing the plaintiff's reputed and well known registered trade mark "DHEEPAM" by using the offending trade mark "SHREE DEEPAM OIL" or any mark or word deceptively similar to the aforesaid trade mark of the plaintiff for edible oil marketed by the defendant, their men, agents, associates and/or assignees or any person claiming rights from the defendant.

(ii) for a permanent injunction restraining the defendant, its men, agents, associates and/or assignees or any person claiming rights from therein from passing-off their inferior product, as that of the plaintiff's DHEEPAM lamp oil by using the offending words 'SHREE DEEPAM OIL' or any other words or mark and offending packing material/pouch/bottles deceptively similar to the plaintiff's trade mark DHEEPAM and trade dress for DHEEPAM..

(iii) for a permanent injunction restraining the defendant, their men, agents, assignees, dealers and/or retailers from using the bottle for their product



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SHREE DEEPAM OIL by resorting to fraudulent imitation of the plaintiff's registered Design No.245127, dated 07.05.2012 in respect of the container/bottle used by the plaintiff for marketing/selling "DHEEPAM" lamp oil.

(iv) for preliminary decree directing the defendant to render true account of profits made by the defendant by using the aforesaid offending mark/lable of SHREE DEEPAM OIL.

(v) for erasure, removal or obliteration from all infringing goods, materials or articles in the possession or control of the defendant with the offending mark/labels and pouches deceptively similar to the plaintiff's DHEEPAM, and

(vi) to pay costs of the suit.

4. Pending the above suit, the following applications are filed by the plaintiff:

(a) Original Application No.694 of 2023 - praying to grant an order of interim injunction restraining the defendant, their men, agents, associates and/or assignees or any person claiming rights from them from infringing the applicant/plaintiff's reputed and well known registered trade mark "DHEEPAM" by using the offending trade mark "SHREE DEEPAM OIL" or any mark or word deceptively similar to the aforesaid trade mark of the applicant/plaintiff for lamp oil marketed by the defendant, their men, agents, associates and/or assignees or any person claiming rights from the defendant, pending disposal of the suit.

(b) Original Application No.695 of 2023 - praying to grant an order of interim injunction restraining the defendant, its men, agents, associates and/or assignees or any person claiming rights from therein from passing-off their inferior product, as that of the plaintiff's DHEEPAM lamp oil by using the offending words 'SHREE DEEPAM OIL' or any other words or mark and offending



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packing material and pouch deceptively similar to the plaintiff's trade mark DHEEPAM, pending disposal of the suit.

(c) Original Application No.696 of 2023 - praying to grant an order of interim injunction restraining the respondent, their men, agents, assignees, dealers and/or retailers from using the bottle design for their product SHREE DEEPAM OIL by resorting to fraudulent imitation of the applicant/plaintiff's registered Design No.245127, dated 07.05.2012 in respect of the container/bottle used by the plaintiff for marketing/selling "DHEEPAM" lamp oil, pending disposal of the suit.

5. Pending the above suit, A.No.6332 of 2023 is filed by the defendant, praying to frame a preliminary issue in the present suit regarding the validity of the respondent's registration for the trade mark DEEPAM and consequently grant leave to the applicant to initiate proceedings to rectify/remove/cancel the respondent's registration for trade mark DEEPAM under No.2320404 in Class 4 from the Register of Trade Marks.

6. The defendant has filed A.No.6332 of 2023 stating as follows:

(a) The defendant has been carrying on an established business in the field of re-packing, marketing and distributing high quality edible oil such as refined sunflower oil, refined palmolein oil, filtered groundnut oil, cold pressed gingelly oil, etc., under the mark GOLD PRIYAM since the year 2008. The defendant is also manufacturing, packing and marketing non-edible oil (Deepam



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Oil for pooja purposes) under the trade mark SHREE. The defendant has various stock-keeping units (SKU) for the products -- both edible and non-edible oil and markets them under the defendant's exclusive brand names all over Tamil Nadu and Puducherry. The defendant states that he has a decent market for his products and though a relatively small player in the oil industry, the defendant has been carrying on his business in an ethical and legal manner. Further, during the course of his business, in the year 2011, the defendant adopted a packaging label for their non-edible oil (Deepam oil for pooja purposes) under the trademark SHREE. The packaging label as adopted by the defendant is unique, distinctive and artistically crafted to exclusively identify the defendant and his product under the mark SHREE.

(b) Due to the defendant's hard work, high quality of the product and strong brand value, the SHREE label has come to be identified by the consuming public with the defendant alone and the mark has become one of the most recognised brands in South India, specifically Tamil Nadu and Puducherry. Given its over-whelming popularity, the SHREE label has transcended from being a trade indicator to a phenomenon of success in branding.

(c) With a view to safeguard his rights, the defendant applied for registration of the SHREE label as a trade mark under No.4412714 in Class 4 on 18.01.2020, claiming use since 03.10.2011. Along with this application, the



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defendant has filed enormous documentary evidence substantiating his use of the mark along with an affidavit affirming their claim of use. After going through the rigorous examination process, the label was advertised in the trade marks journal and consequently granted registration. Thus, the said SHREE label is a registered trade mark and the defendant is the exclusive registered proprietor of the same. Further, the said label, being a creative artistic work, is also capable of being protected under the Copyright Act. Hence, the defendant possesses copyright over the said SHREE label and is also the owner of the copyright in the said label. The mark is distinctive of his business and products alone and nothing else. The defendant's annual turnover for the products sold under the SHREE label runs into several lakhs of Rupees. His products under the mark SHREE are regularly and extensively advertised through various media, including inter-alia, television, newspapers, magazines and point of purchase materials, etc. In view of its quality, the defendant's product under the said SHREE label have gained enormous reputation and goodwill among the members of public. The defendant spent huge sums of money towards advertisement and sales promotion for its products under the mark SHREE label. By virtue of extensive and continuous use for the last more than 11 years, the defendant's SHREE label has acquired enviable reputation and goodwill in the market. The trade and public associate of the said mark only with the defendant and none else. The defendant estimate



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the potential value of his trade mark SHREE to be several lakhs of Rupees.

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(d) To the shock and surprise, the defendant received a cease and desist notice, dated 08.08.2022 from the plaintiff, claiming exclusive rights over the word DHEEPAM and threatened the defendant with legal action against the use of the defendant's SHREE label that contained the words DEEPAM OIL in a relatively small font in a descriptive manner. In the said notice, the plaintiff has alleged that the defendant's SHREE label as mentioned above, is similar to their alleged registered trade mark DHEEPAM and their copyright in artistic work DHEEPAM packing material/trade dress, get up and colour scheme. The plaintiff made false and tall claims as though they sell a product under a packaging label similar to the defendant's SHREE label, but failed to give any details regarding the alleged trade mark or provide a Facsimile of the trade dress / packing material as claimed in the notice. In their notice, the plaintiff objected to the defendant's use of the word DHEEPAM/DEEPAM and has called upon the defendant to desist from using the said word. The plaintiff further claimed that they possess registration for word DHEEPAM as a trade mark and that the word has attained secondary significance in respect of their lamp oil. The respondent/plaintiff alleged that the defendant's use of the word DHEEPAM/DEEPAM amounts to infringement of trade mark, infringement of copyright and passing-off. The defendant had issued a suitable reply dated

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17.08.2022 to the plaintiff's notice and also called for proof in support of their alleged claims of registration and acquired distinctiveness over the word DHEEPAM. Considering the threat issued by the plaintiff, via legal notice, the same is baseless, unwarranted and groundless and the defendant filed C.S.(Comm.Div).No.181 of 2022 under Section 142 of the Trade Marks Act before this Court and after much delay, the plaintiff herein filed the civil suit and the same is pending as on date.

(e) In the present suit, the plaintiff attempts to restrain the defendant's use of a generic, common, dictionary word DHEEPAM/DEEPAM, taking undue advantage of the registration the defendant has in respect of the said mark in Class 04. The word DHEEPAM/DEEPAM is a "Tamil" word, meaning "lamp" and when used in conjunction with oil, would denote and describe the character and quality of the oil, i.e. oil used to light the lamp. The use of the word DEEPAM in conjunction with the word OIL is directly descriptive as it indicates the nature and character of the product, i.e. non-edible oil used to light lamp. It is but common for a product sold in India to use the description in easy language so that the consuming public, which includes illiterates and semi-illiterates from all walks of life would understand. The plaintiff is not entitled to claim monopoly over the word DHEEPAM or its phonetic equivalents, in view of its inherent descriptiveness and incapacity to attain secondary significance in view of its



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generic nature. The word DEEPAM in conjunction with OIL is used in a descriptive sense to indicate the nature and character of the product, i.e. oil meant for lighting the lamp. There are several traders in India using the word DEEPAM/DHEEPAM in respect of the similar product. The word DEEPAM and its phonetic equivalents are therefore common to trade and their use in a descriptive sense, is in accordance with the honest business practices and trade usage. The plaintiff's claim of registration of the trade mark DHEEPAM in the cease and desist notice is invalid, done with the mala-fide intent of monopolising a common, generic and descriptive word that has no distinctiveness whatsoever. The mark is incapable of acquiring any distinctiveness, in view of its generic nature.

(f) The plaintiff has deliberately applied for and obtained registration of the word DHEEPAM in various classes, more particularly in Class 4 under No.2320404, which is specifically in respect of the LAMP OIL, ILLUMINATING OIL FOR NON-EDIBLE PURPOSE. The registration is clearly against the provisions of the Trade Marks Act, especially Section 9 which specifies generic and descriptive nature of mark to be an absolute ground for refusal of its registration. The plaintiff has seemingly obtained registration for the mark DHEEPAM by making false representations before the Trade Marks Registry and has somehow obtained monopoly rights. The word DHEEPAM can never attain distinction or



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secondary significance in respect of the lamp oil or illuminating oil falling under Class 4. Hence, the registration obtained by the plaintiff is liable to be removed and the applicant/defendant shall take appropriate steps to initiate proceedings for rectification/removal of the plaintiff's trade mark registration for DHEEPAM under No.2320404, as the plaintiff is using such registration as a tool of oppression and abuse.

(g) The word DEEPAM or its phonetic equivalent is a common dictionary word, generic expression and is being used all over India for a long time, even much prior to the plaintiff's alleged claim of adoption. Such a generic word ought not to have been granted registration, as the same is devoid of any distinctive character and in view of its generic nature, the mark is also incapable of acquiring any secondary significance with the plaintiff. The registration of a generic word such as DEEPAM, that too in respect of the lamp oil and illuminating oil falling under Class 4 is ex-facie illegal, fraudulent or ought to shock the conscience of this Court. The continued presence of the impugned trade mark in the Register of trademark is already causing irreparable loss, hardship and injury to the defendant, as the registration in favour of the plaintiff of the impugned mark DEEPAM poses an obstacle in the use of the said descriptive and common word in respect of its products. Therefore, the applicant/defendant is a person aggrieved by the impugned mark remaining in



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the Register without sufficient cause.

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(h) The registration as claimed by the plaintiff over the said word DEEPAM is liable to be cancelled and removed under the provisions of Section 57 of the Trade Marks Act. The question of validity of the plaintiff's registration of impugned mark DEEPAM ought to be raised through the rectification proceedings before this Court, as the same prejudices the defendant's right to use the said mark in the course of their business to describe oil used to light lamp for pooja purposes. The impugned trade mark DEEPAM is wrongly remaining in the Register as the plaintiff is not honest / bona-fide adopter, but attempted to monopolise the word, which in his knowledge is commonly used by trade and public. Hence, this Court ought to give the defendant permission to test the validity of the impugned trade mark before proceeding with the present suit.

7. The plaintiff has filed counter in the above said A.No.6332 of 2023 in C.S.(Comm.Div).No.197 of 2023 stating as follows:

(a) The present application is not maintainable, as the defendant has not made out any ground to satisfy Section 124(1)(ii) of the Trade Marks Act. The conduct of the defendant in the statement made in the counter shows that the defendant has come to Court with unclean hands. It is not disputed by the defendant that the plaintiff is the prior user of the mark DHEEPAM since April



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2009. The defendant has not obtained the registration of the mark DEEPAM.

(b) The plaintiff is the market leader in various edible oil businesses. In April 2009, the plaintiff launched unique lamp oil with the blend of 5 oils, namely refined castor oil, sesame oil, coconut oil, refined mahua oil and refined rice brand oil and the plaintiff has been marketing the said lamp oil with its reputed brand DHEEPAM since 2009 which has now become one of the well-known brands of the plaintiff.

(c) The plaintiff also manufactures and packs various edible oils, such as sunflower oil, groundnut oil, olive blended oil (Olive + Corn combo) etc., with its well-known trade mark, namely Gold Winner, Cardia Life, etc., in respect of which the plaintiff has registration under the Trade Marks Act, 1999. Many manufacturers have copied the trade mark of the plaintiff.

(d) The plaintiff has their factory in Palani, Tamil Nadu, in Tumkur, Karnataka and in Vengaivasal, Kancheepuram District, Tamil Nadu, from where the plaintiff manufactures some of the above products including DHEEPAM lamp oil and markets them throughout the country. The Vengaivasal factory has been certified as ISO 9001:2008, HACCP and ISO 2200:2005 certified company. The plaintiff's artistic work of DHEEPAM lamp oil is with a distinct colour scheme which is unique. The plaintiff has also devised unique bottle/container with different design, shape and configuration for marketing the lamp oil with a striking



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resemblance to a Gopuram (Dome) of Hindu Temples to capture the minds of the consumers so as to associate the use of the aforesaid oil with spirituality and divinity. There is a unique fragrance in the lamp oil to accentuate the feeling of divinity. The plaintiff applied for design registration and later obtained a design Registration No.245127 and the plaintiff applied for trade mark registration of their mark DHEEPAM and the trade mark registered, vide Trade Mark Registration No.2320404 under Class 4 for lamp oil and illuminating oil for non-edible purpose, vide Certificate dated 11.06.2018. The trade dress, colour scheme and get-up of the plaintiff's copyright is unique and the plaintiff registered the copyright in A-139256/2021, dated 29.07.2021 before the appropriate authority. The defendant is guilty of passing-off their product as that of the plaintiff. Various suits were filed before this Court to market their respective products relating to lamp oils in various names, as detailed in the affidavit filed in support of the applications. It is the claim of the plaintiff that they have made a foray into the international markets including American, European, Middle East and other Asian Markets. The defendant using deceptively similar trade mark amounts to unfair trade practice.

(e) The plaintiff has obtained GST registration to trade and supply its product by paying appropriate taxes including Income Tax. The plaintiff is also complying with the provisions of all the applicable laws including Legal Metrology



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Act of 2009. The defendant has resorted to dubious means of 'passing-off' their product with a view to undermine the plaintiff's proprietary rights over the trade dress, colour scheme, get-up, copyright and label of DHEEPAM.

(f) The plaintiff also sent cease and desist notice, dated 08.08.2022 and requested the defendant to cease and desist from using the mark SHREE DEEPAM OIL and this notice was received by the defendant on 13.08.2022 and sent reply notice to the plaintiff on 17.08.2022.

(g) The plaintiff also has undertaken promotional activities in televisions and media.

(h) If A.No.6332 of 2023 is dismissed, no harm, injury, prejudice or loss would be caused to the defendant and if the application is allowed, it would cause immense harm, loss, damage, injury and prejudice to the plaintiff. The balance of convenience is in favour of the plaintiff.

8. The parties have filed their respective affidavits as above in O.A.Nos.694 to 696 of 2023 also, maintaining their stand in the case.

9. Learned counsel for the plaintiff submitted that the plaintiff has filed suit regarding the trade mark alleged to have been infringed upon and passing-off committed by the defendant, who has filed written statement questioning



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the validity of the trade mark. A.No.6332 of 2023 has been filed by the defendant invoking Section 124 of the Trade Marks Act, stating that he has been carrying on and established his business in marketing and distributing the high quality edible oils, such as refined sunflower oil, etc. The learned counsel for the plaintiff reiterated the averments made in the plaint and other documents in support of his case. The defendant has applied for registration of the mark "SHREE" as a trade mark and also got it registered in Class 4 in No.441714. Along with the application, the defendant has filed documentary evidence in support of his case and after going through the records and the papers, the defendant prays to treat the prayer made in this application to frame a preliminary issue regarding the trade mark in question.

10. Learned counsel for the plaintiff submitted that the defendant has not satisfied the provisions of Section 124 of the Trade Marks Act. The defendant has not made out any ground and has not discharged their onus to prove the prima-facie validity of the plaintiff's trade mark, which is the mandatory requirement to satisfy the ingredients of Section 124 of the Trade Marks Act.

11. The defendant has stated that they have applied for and obtained registration of the mark. The trade mark is generic in nature which shows that



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the defendant has come to Court with unclean hands. The plaintiff is the prior user of the mark "Dheepam" since April 2009 and the defendant has not disputed the same. The defendant is the registered owner of the trade mark "Dheepam" and it is the case of the defendant that they are adopting the mark "Shree" as per their own affidavit filed in the present application and the written statement filed in the suit.

12. The defendant has not obtained the registration of the mark "Deepam" and the plaintiff has been marketing the said lamp oil with reputation brand since 2009, which has now become one of the well-known brand of the plaintiff. The plaintiff also manufactures and produces various edible oils, such as sunflower oil, groundnut oil, etc., with well-known trade mark, namely gold winner oil, cardia life, etc. The plaintiff manufactures some of the above products including Deepam lamp oil and markets them throughout the country and the product has also been awarded ISO certification. Further, the plaintiff has appointed consignment agent through whom the products are distributed and brought in retail market and the plaintiff adopts good manufacturing products and maintaining high standard of quality of the products and the products are being enjoyed by the consumers and the plaintiff has also obtained good reputation in the industry. The applicant's Deepam lamp oil is very stylish and



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captivity artistic work of Deepam lamp oil with distinct colour scheme as unique and has succeeded the respondent in the market, making its leading product in the market in the lamp oil sector. The respondent has also devised unique bottle container with different design shape and configuration for marketing the lamp oil with style and resemblance to the unique Gopuram tomb of Temple to capture the minds of the consumers so as to initiate the user of the aforesaid oil with spiritual divinity. The plaintiff's Deepam lamp oil with a unique containers is inspiration from the Tomb of Hindu Temple allowing all divinity before the Deity in the Temple and the places of worship, according to Hindu tradition with unique progress in the aforesaid oil which is initiated to accentuate the feeling of divinity in the minds of the consumers. Concentrated oil as a lamp oil is inspired from the ancient religious practice followed from time immemorial with the religion. The design of the bottle was made in new shade with alluring features of the Gopuram of the Temple and was adopted by the plaintiff before launching the same, and the plaintiff also applied for definite Registration and later obtained a design with Registration No.245127.

13. The plaintiff has applied for trade mark registration of their mark Deepam and the trade mark registration is No.2320404 in Class 4 for lamp oil illuminating for non-edible purpose and the respondent is a registered Proprietor



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of the well-known trade mark Deepam lamp oil, illuminating.

14. It is further submitted that the present dispute arises on account of the unfair offending of the trade mark of the plaintiff by the defendant with label by imitating the plaintiff's get-up and colour scheme and trades for marking the lamp oil with the aforesaid offending words as trade mark / label in violation of the plaintiff's trade mark "Deepam" and the copyright in the artistic work in the Deepam label and therefore, the present application is liable to be dismissed.

15. Further, it is for the defendant to prove that he has obtained registered trade mark as "Shree Deepam" and he admitted that it is only "Shree" label alone as a trade mark under No.4412714 and it is not as stated by the defendant through Deepam oil. Therefore, the defendant has not made out prima-facie case and the balance of convenience is in favour of the plaintiff.

16. Further, it is a matter of evidence and it does not fall under Order 14 Rule 2 of CPC. The dispute is neither related to jurisdiction of the Court nor bar to the suit created by any law for the time being in force, which requires that the issue related to law on the basis of establishing the facts.



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17. It is settled proposition of law that, only after establishing the facts, and if at all the law is applicable to those facts, the question of considering the preliminary issue, would arise on the facts of the case, and in the absence of the same, it cannot be decided at the preliminary stage, pending the suit.

18. As of now, the applicant has not filed any application under Section 124 of the Trade Marks Act before the Trade Mark Registering Authority and therefore also, according to the plaintiff, the application is liable to be dismissed.

19. The case of the plaintiff is that they are having registered trade mark "Deepam", with trade mark registration Number as 2320404 under Class 4 of the lamp oil and also is a registered proprietor of the trade mark "Deepam" for the lamp oil illuminating. Further, the plaintiff has also obtained registered copyright in Application No.139256/2021, dated 29.07.2021 before appropriate authority. Therefore, as such, the plaintiff has pleaded in their plaint and also in the counter affidavit filed in A.No.6332 of 2023 before this Court that they are registered trade mark user and had also registered the same in the year 2018 and copyrighted it in the year 2021 and they have filed the suit for infringement and also for permanent injunction and also for passing-off.



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20. Now, the defendant has stated that the defendant is also a registered trade mark holder of the word "Shree Deepam" oil label, whereas they have applied and obtained registration for only the mark "Shree" label under the trade mark number 4412714 in Class 4, which shows that the defendant applied for trade mark "Shree" prefixed before the mark "Deepam". Now, the defendant takes a stand against the plaintiff that the trade mark of the plaintiff registered from their description is generic in nature. Therefore, the records produced by the defendant also shows that they have only applied and obtained registration for mark only "Shree" and not "Shree Deepam Lamp Oil". But however, after obtaining the registered trade mark "Shree", the defendant has been using the trade mark as if they have registered it as "Shree Deepam Oil".

21. Therefore, the above facts pleaded are all matters for trial and even the defendant has not so far filed any application before the competent authority by invoking Section 124 of the Trade Marks Act, and therefore, in the above circumstances, the present application for framing of preliminary issue for trying, does not merit consideration and the same is also not acceptable.

22. In order to appreciate effectively the facts of the case, it is useful to extract Order 14 Rule 2(2) of the amended Code of Civil Procedure (CPC) as



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follows:

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Order 14: Settlement of issues and determination of suit
on issues of law or on issues agreed upon:

Rule 2: Court to pronounce judgment on all
issues:-- (1) Notwithstanding that a case may be disposed of on a preliminary issue, the Court shall, subject to the provisions of sub-rule (2), pronounce judgment on all issues.

(2) Where issues both of law and of fact arise in the same suit, and the Court is of opinion that the case or any part thereof may be disposed of on an issue of law only, it may try that issue first if that issue relates to--

(a) the jurisdiction of the Court, or

(b) a bar to the suit created by any law for the time being in force,

and for that purpose may, if it thinks fit, postpone the settlement of the other issues until after that issue has been determined, and may deal with the suit in accordance with the decision on that issue."

23. Therefore, on a combined reading of the affidavit of the defendant and the counter affidavit of the plaintiff and the documents produced by both parties along with their pleadings, and also perusing the above said provision of



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law, it is clear that the relief sought for by the defendant does not fall under Order 14 Rule 2(2) CPC. Therefore, A.No.6332 of 2023 is dismissed, as it depends upon the establishment of the facts of the case and as the pleadings in this application are matters for trial, and in the absence of any specific material in favour of the defendant, the relief sought for in A.No.6332 of 2023 is either a question of jurisdiction, or question of law, which can be decided only after proper establishment of necessary facts and at this stage, the mixed question of facts and law cannot be decided by framing of preliminary issue as prayed for by the defendant in this application.

24. The plaintiff has filed A.Nos.694 to 696 of 2023 in C.S.No.197 of 2023 for the relief of :

(a) Original Application No.694 of 2023 - praying to grant an order of interim injunction restraining the defendant, their men, agents, associates and/or assignees or any person claiming rights from them from infringing the plaintiff's reputed and well known registered trade mark "DHEEPAM" by using the offending trade mark "SHREE DEEPAM OIL" or any mark or word deceptively similar to the aforesaid trade mark of the plaintiff for lamp oil marketed by the defendant, their men, agents, associates and/or assignees or any person claiming rights from the defendant, pending disposal of the suit.



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(b) Original Application No.695 of 2023 - praying to grant an order of interim injunction restraining the defendant, its men, agents, associates and/or assignees or any person claiming rights from therein from passing-off their inferior product, as that of the plaintiff's DHEEPAM lamp oil by using the offending words 'SHREE DEEPAM OIL" or any other words or mark and offending packing material and pouch deceptively similar to the plaintiff's trade mark DHEEPAM, pending disposal of the suit.

(c) Original Application No.696 of 2023 - praying to grant an order of interim injunction restraining the respondent, their men, agents, assignees, dealers and/or retailers from using the bottle design for their product SHREE DEEPAM OIL by resorting to fraudulent imitation of the plaintiff's registered Design No.245127, dated 07.05.2012 in respect of the container/bottle used by the applicant/plaintiff for marketing/selling "DHEEPAM" lamp oil, pending disposal of the suit.

25. The plaintiff in these three applications are registered trade mark of Deepam and has also produced registered mark in the year 2018 and copyright in the year 2021 and designs also. Therefore, at this stage, the applicant has established prima-facie case which had been made out and the balance of convenience is also in favour of the plaintiff in these three applications and if



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interim injunction is not granted, the plaintiff would be put to undue hardship.

Therefore, it is clear that the applicant's trade mark Deepam is a registered mark in Class 4 of the edible oil and also the copyright also. The suit was filed in the year 2023 stating that the defendant infringed the trade mark and therefore, the plaintiff filed the suit for the reliefs stated supra.

26. Though the defendant has taken a stand that the "Deepam" is descriptive and therefore, the plaintiff cannot claim exclusive right for the same mark and even though they wanted to file application before the competent authority by invoking Section 124 of the Trade Marks Act, and as of now, the defendant has not filed any other application. In the above circumstances, on a reading of the affidavit filed in support of these applications, the plaintiff has proved the suit by means of the averments made in these affidavits that they are having prima-facie case, and that the balance of convenience is also in favour of the plaintiff, as pleaded by them. If the defendant in these applications, is not prevented by way of interim injunction as sought for by the plaintiff, the plaintiff would be put to irreparable loss and undue hardship. However whether the plaintiff is entitled to use the trade mark "Deepam", which is descriptive and if the defendant files any application invoking Section 124 of the Trade Marks Act, the competent authority/court will decide the issue in the said application and



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the relief prayed for in the suit cannot be considered at this stage, and they can be decided only after trial and after the proceedings are initiated by the competent authority/court and not at this inception stage of hearing of the suit.

27. Hence, it is clear that the plaintiff in all these three applications, has made out a prima-facie case and balance of convenience is also in their favour. If the interim injunctions as prayed for in these applications, are not granted, the plaintiff would be put to irreparable loss and hardship. Hence, these three interim injunction applications are allowed. There shall be no order as to costs.

02.07.2024

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CS

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Order pronounced on

02.07.2024

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