*** IN THE HIGH COURT OF DELHI AT NEW DELHI**

% Judgment reserved on: 24.02.2026
Judgment delivered on: 08.04.2026

+ C.O. (COMM.IPD-TM) 392/2021

+ C.O. (COMM.IPD-TM) 393/2021

SHUBHAM GOLDIEE MASALE PVT. LTD .....Petitioner

versus

JAI SHIV OIL INDUSTRIES AND ANR. .....Respondents

Advocates who appeared in this case:

For the Petitioner : Mr. Ajay Amitabh Suman and
Ms. Deasha Mehta, Advocates

For the Respondents : Mr. Nishant Gautam, CGSC with
Mr. Vineet Negi, Ms. Kavya Shukla,
Mr. Naman Sharma and Ms. Theresa, Advocates.

CORAM:
HON'BLE MR. JUSTICE TUSHAR RAO GEDELA

J U D G M E N T

TUSHAR RAO GEDELA, J.

1. The present petitions have been filed under Sections 47, 57 and 125 of the Trade Marks Act, 1999 (hereinafter referred to as *"the Act"*) by the petitioner seeking, *inter alia*, the following prayers:-

In so far as CO(COMM.IPD-TM) 392/2021 is concerned, the prayers are as under:

> *"In view of the abovementioned facts/ statement of case and the abovementioned grounds for revocation/ cancellation/ rectification, it is most respectfully prayed that this Hon'ble Board may kindly be pleased to:*

*(i) remove/ cancel/ expunge/ rectify the entry pertaining to impugned Trade Mark **"GOLDI (LABEL)"** registered under no.945240 in class 29.*

*(ii) Stay the effect and operation of the entry pertaining to impugned Trade Mark **"GOLDI(LABEL)"** registered under no.945240 in class 29 during the pendency of the present proceedings.*

Any other relief(s) which is fit and proper in the facts and circumstances including an order for costs of the proceeding to petitioners."

In so far as CO(COMM.IPD-TM) 393/2021 is concerned, the prayers are as under:

"In view of the abovementioned facts/ statement of case and the abovementioned grounds for revocation/ cancellation/ rectification, it is most respectfully prayed that this Hon'ble Board may kindly be pleased to:
*(i) remove/ cancel/ expunge/ rectify the entry pertaining to impugned Trade Mark **"GOLDI (LABEL)"** registered under no.2023762 in class 31.*

*(ii) Stay the effect and operation of the entry pertaining to impugned Trade Mark **"GOLDI(LABEL)"** registered under no.2023762 in class 31 during the pendency of the present proceedings.*

Any other relief(s) which is fit and proper in the facts and circumstances including an order for costs of the proceeding to petitioners."

2. Since the factual matrix arising in both the petitions are substantially common, the grounds of challenge too are common, therefore, the two petitions are being disposed of *vide* this common judgment.

BACKGROUND FACTS:-

3. Petitioner claims to be a company duly incorporated under the Indian Companies Act, 1956, and has its office in Kanpur, Uttar Pradesh. Petitioner claims to be engaged in the business of manufacturing and marketing food products for human consumption including spices and other allied and related

goods under the name and style of M/s Shubham Goldiee Masale Private Limited.

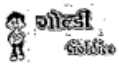
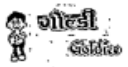
4. Petitioner is the proprietor of the trademark "GOLDIEE" and Goldiee formative marks in relation to the aforesaid goods. The word "GOLDIEE" also forms part of the petitioner's trade name. It is stated that through the predecessors, the petitioner adopted the said trademark in the year 1980, and have been continuously and uninterruptedly using the said trademark till date.

5. By virtue of being the prior and senior adopter and user of the said trademark, petitioner's claim that the said mark has acquired distinctiveness in the market and trade, and identifies the said goods and business as exclusively originating from the petitioner's alone. Petitioner states that on account of their high quality products under the said trademark, the trademark has become source identifier for the petitioner and its goods.

6. Petitioner states that the trademark "GOLDIEE" has acquired a tremendous goodwill reputation in the market and rely upon the sales figures from the year 2000 when its turnover was Rs.43 Crores which reached Rs.297 Crores in the FY 2012-13 under said mark.

7. Petitioner states that the promotion of the said goods and their business under the mark "GOLDIEE" has been extensively achieved through print, audio/visual media, advertisements and publicity in leading newspapers, distribution of trade literature, trade hoardings etc. Petitioner states that they have incurred enormous amounts of money and efforts on such promotional events. Predicated thereon, the petitioner's assert that the mark "GOLDIEE" has acquired a secondary meaning which denotes and relates to the petitioner's exclusively. The petitioner's and its activities are disseminated through their website www.goldiee.com. The petitioner has appended with the

petition, documentary evidence in support of use and dissemination of the mark "GOLDIEE". The oldest registration of the "GOLDIEE" label is of 01.10.1980, and the subsequent trademarks registered by the petitioner are enumerated in the list as under :-

S.No.	Trade Mark	Application No.	Class	Date of Application	Status
1.	 GOLDIEE	773763	3	14/02/1997	Regd.
2.	G O L D I E E (Word Mark)	1687004	29	14/05/2008	Regd.
3.	 GOLDIEE	703444	29	27/03/1996	Regd.
4.	 GOLDIEE	703443	30	27/03/1996	Regd.
5.	 GOLDIEE	703442	30	27/03/1996	Regd.
6.	GOLDIEE (Word Mark)	696960	30	2/2/1996	Regd.
7.	 GOLDIEE LABEL	367000	30	1/10/1980	Regd.
8.	GOLDIEE LABEL 	773762	30	14/02/1997	Regd.

8. It is stated that the products of the petitioner under the mark "GOLDIEE" are available to the consumers all over the country through a network of around 1200 distributors and C & F agents. Petitioner states to have achieved ISO 9001:2000 certification in the year 2005, and in the year 2007 also obtained HACCP certification. Petitioner also has established an in-

house laboratory under the supervision of quality control chemist and food technologist for ensuring and maintaining standards in the quality of the food products it manufactures. It is claimed that the GOLDIEE Group has done sampling of its products to all the participants in the Delhi Marathon Event, 2010, and in the Mumbai Marathon Event, 2011. The petitioner was also conferred various awards by the Government of India for the excellence in the food products manufactured by it.

9. Petitioner also asserts that it has been extremely vigilant in protecting its right in the mark "GOLDIEE" and has been instituting various civil as well as criminal actions against infringers and counterfeiters and has been able to obtain favourable orders on that score.

10. Petitioner claims that it came to know about the impugned adoption and illegal user by the respondent no.1 of the trademark "GOLDI" (label) under the trademark applications bearing nos.945240 and 2023762 in Class 29 and Class 31 respectively only in late August, 2014, wherein the respondent no.1 has falsely urged the user of the impugned trademark from 01.01.2000. Petitioner states that the respondent no.1 has dishonestly, malafidely and by claim fraud upon the Trade Marks Registry obtained the said mark registered in its favour. Petitioner states that the respondent no.1 was fully aware of the petitioner's registered trademark "GOLDIEE" and the associated goodwill, reputation, use and exclusivity even at the time when it applied for registration of its mark. Petitioner claims that the adoption is illegal and *malafide*. The petitioner also states that there is clear deceptive similarity in both the marks in terms of phonetic, visual, structural and conceptual basis. Petitioner asserts that the adoption is tainted and with a view to ride on the coattails of the petitioner's substantial goodwill and reputation. That apart, petitioner asserts

that the continuation of the impugned registration in the name of the respondent no.1 would clearly dilute its own registered mark "GOLDIEE".

11. Impugning the registration of the trademark "GOLDI" (label) both under Classes 29 and 31, the present rectification petitions were originally filed before the Intellectual Property Appellate Board (*"IPAB"*), and upon its abolition were transferred to this Court.

CONTENTIONS OF THE PETITIONER

12. Mr. Suman, learned counsel appearing for the petitioner would submit that the present facts would clearly entitled the petitioner in seeking cancellation/rectification of the impugned mark "GOLDI" from the Register of Trade Marks simply on the facts that the petitioner undoubtedly is a prior user since the year 1980 as also being the registered trademark owner of the mark "GOLDIEE" (label) on 01.10.1980, while the respondent no.1 filed its application in the year 2000 in Class 29 in relation to mustard oil (edible oil) and was granted registration only on 16.09.2005. Insofar as the registration of the impugned mark "GOLDI" in Class 31 in relation to foodstuffs (oil cake) for animals is concerned, the registration was granted on 16.03.2012. Thus, according to him, even if one were to consider the challenge on the basis of the admitted dates of user and the actual registration granted, clearly the petitioner would not only be the prior adopter and prior user, but also the prior registrant for the mark "GOLDIEE".

13. Learned counsel next urged that the registered trademark of the petitioner "GOLDIEE" and the impugned mark "GOLDI" of the respondent no.1 on a comparison clearly indicate that the deception and confusion the public could face is apparent. According to learned counsel, both the marks are visually, phonetically, structurally identical or deceptively similar.

Learned counsel would further contend that there is practically no difference in the pronunciation of both the marks. Equally, he would submit that conceptually too, there is no distinction. That apart, he would contend that the trade circle, the distribution channel, the retail outlets as well as the consumers would be common too, since, both the petitioner as also the respondent no.1 are in the business of manufacturing edible oils. In such circumstances, according to him, the consumer base would also be common.

14. He stoutly contended that in the above circumstances it would be clear that an unwary consumer with average intelligence and imperfect recollection would get confused or deceived into believing the goods of the respondent no.1 to be those of the petitioner or associated with the petitioner.

15. He would contend that when all the aforesaid parameters are considered compositely, it would be apparent that both the marks are deceptively similar and since the petitioner is a prior adopter, prior user and a prior registrant of the mark "GOLDIEE", the existence of the impugned mark "GOLDI" registered in favour of the respondent no.1 cannot be permitted to continue to remain in the Register of Trade Marks. To substantiate his contention and to further submit that the petitioner's statutory and common law rights are longstanding and continuous, he relied on the judgment passed by the Coordinate Bench of this Court in ***Fybros Electric (P) Ltd. v. Vasu Dev Gupta Trading as Vasu Electronics, 2023 SCC OnLine Del 3179***.

16. Learned counsel also forcefully stated that the respondent no.1 has tendered no explanation as to how and on what basis did it coin or adopt the word "GOLDI" as its trademark. He would contend that the registration obtained by the respondent no.1 is clearly by playing fraud upon the Registrar of Trade Marks while applying for registration. He further stated that the

respondent no.1 was proceeded *ex-parte*, and has not offered any counter response to the petitions or to the claims made by the petitioner.

17. Learned counsel also contended that the respondent no.1 obtained the registration of the impugned mark fraudulently and by material misstatements as to its user, goodwill and reputation. He would contend that the said fraud and misstatement would disentitle the respondent no.1 from continuing with its mark "GOLDI" in the Register of Trade Marks.

18. Learned counsel also contended that the impugned mark "GOLDI" is not distinctive of the impugned goods either at the time when the application was applied for or at the time when the registrations were obtained, hence, barred by the provisions of Section 9 of the Act.

19. Learned counsel would also contend that the impugned registration is barred under the provisions of Sections 11, 12 and 18 of the Act.

ANALYSIS AND CONCLUSION

20. This Court has heard the arguments of Mr. Amitabh Suman, learned counsel for the petitioner, perused the pleadings on record and closely examined the records of the case.

21. Before proceeding further, it is pertinent to note the history of the proceedings, which is as under:-

a. The present petitions were transferred to this Court and listed before the learned Joint Registrar (Judicial) of this Court on 18.01.2022, consequent to the abolition of the IPAB. Consequently, court notice was issued to both respondent nos.1 and 2 alongwith their counsel on 29.08.2022.

b. Respondent no.2 was duly served through its counsel, as recorded in the order dated 16.12.2022. However, court notice of respondent no.1

was awaited as on that date. Respondent no.2 is a formal party and was recorded as such for the first time in the order dated 12.09.2023.

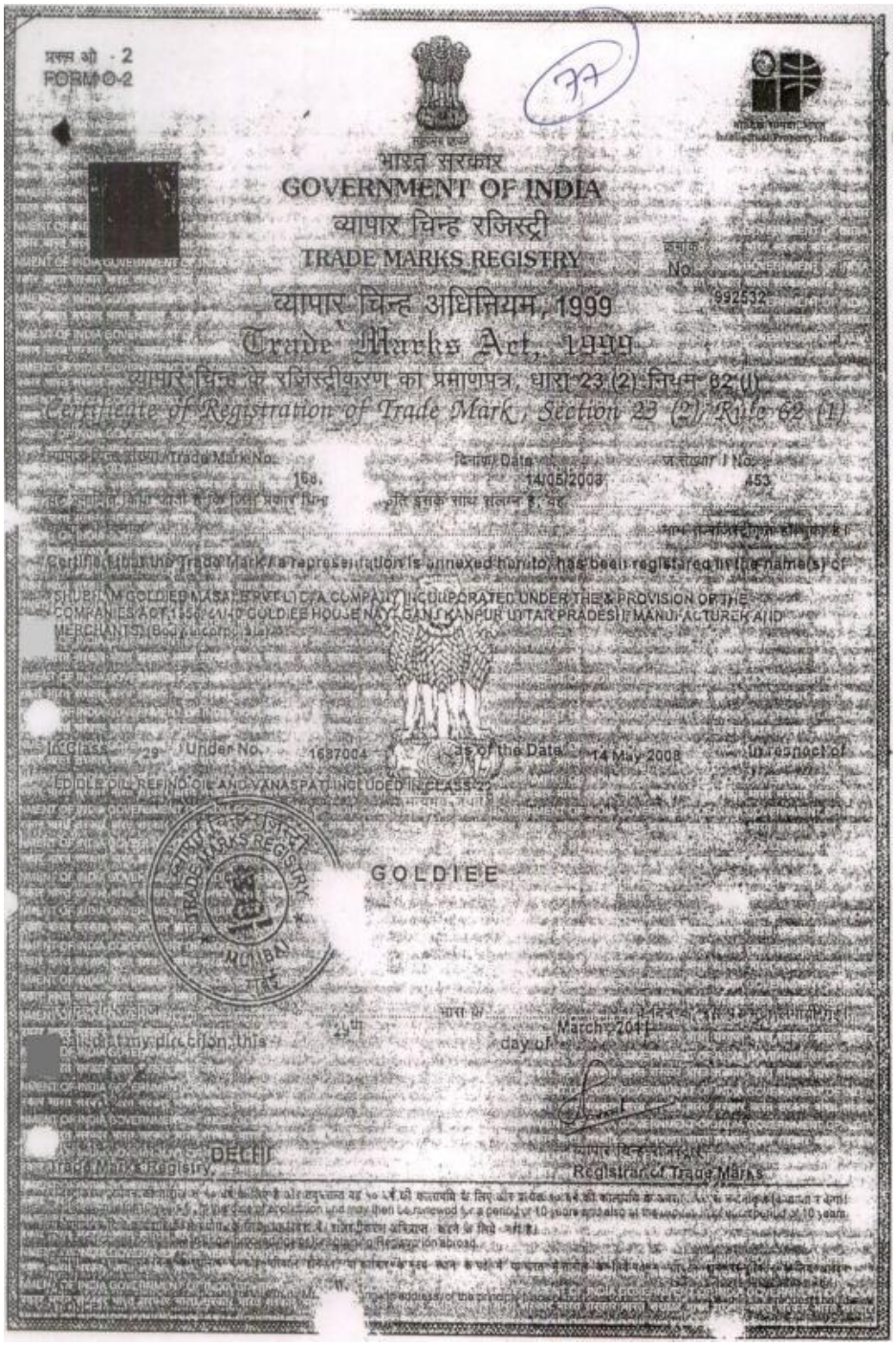
c. Thereafter, the petitioner filed an impleadment application bearing I.A. Nos.9925/2024 in C.O.(COMM-IPD-TM) 392/2021 and 8904/2024 in C.O.(COMM.IPD-TM) 393/2021, seeking to implead respondent no.3 as a party on the ground that the impugned trademark had been assigned by the respondent no.1 *vide* Assignment Deed dated 17.09.2015 to the proposed respondent no.3.

d. *Vide* order dated 06.11.2024, the service upon both respondent no.1 and proposed respondent no.3 was completed, and *vide* order dated 19.02.2025, respondent no.3 was arrayed as a party. *Vide* order dated 01.05.2025, right of the respondent nos.1 and 3 to file their replies were closed, and *vide* the order dated 04.08.2025, both the respondents were proceeded *ex-parte.*

22. It is observed from the records and office noting of the case that though the respondent no.1 was served on 04.11.2024, however, has chosen to remain absent throughout. Subsequently, respondent no.3 was impleaded on the ground that it was assigned the impugned mark. It was also served with the notice of the petitions, however chose not to appear or file its reply. Therefore, there is no material or rebuttal either in the form of pleadings or the documents in answer to the allegations contained in the petitions. Though it is trite that in the absence of any opposition, the averments contained in the petitions, and the documents annexed thereto are deemed to be admitted and judgement can be pronounced, however, this Court would still proceed to consider the petitions on its own merits.

23. In the present case, it would be relevant and necessary for this Court to

appreciate the evidence in the form of documents which have not been rebutted. The first line of documents would be the registrations obtained by the petitioner for the mark "GOLDIEE". It would be apposite to extract hereunder the following documents:-



FORM O-2

भारत सरकार
GOVERNMENT OF INDIA
व्यापार चिन्ह रजिस्ट्री
TRADE MARKS REGISTRY
व्यापार चिन्ह अधिनियम, 1999
Trade Marks Act, 1999
व्यापार चिन्ह के रजिस्ट्रीकरण का प्रमाणपत्र, धारा 23 (2) नियम 62 (1)
Certificate of Registration of Trade Mark, Section 23 (2) Rule 62 (1)

Trade Mark No. 168. Date 14/05/2008 No. 453

Certified that the Trade Mark a representation is annexed hereto has been registered in the name(s) of

M/S. GOLDIEE MASALA PRIVATE LIMITED A COMPANY INCORPORATED UNDER THE PROVISION OF THE COMPANIES ACT 1956 24/10 GOLDIEE HOUSE NAYA GANJ KANPUR UTTAR PRADESH MANUFACTURER AND MERCHANTS (Body Incorporate)

In Class 29 Under No. 1637004 as of the Date 14 May 2008 in respect of

EDIBLE OIL, REFINED OIL AND VANASPATI INCLUDED IN CLASS 29

GOLDIEE

Given under my hand and seal of the Office this 29th day of March 2011

DELHI
Trade Marks Registry

Registrar of Trade Marks

- 2
D-2

भारत सरकार
GOVERNMENT OF INDIA
व्यापार चिन्ह रजिस्ट्री
TRADE MARKS REGISTRY

क्रमांक
No. 659148

व्यापार चिन्ह अधिनियम, 1999
Trade Marks Act, 1999

व्यापार चिन्ह के रजिस्ट्रीकरण का प्रमाणपत्र, धारा 23 (2) नियम 62 (1)
rtificate of Registration of Trade Mark, Section 23 (2), Rule 62 (1)

चिन्ह संख्या/ Trade Mark No. 773762 दिनांक/ Date 14-02-1997 ज.संख्या/ J.No. 1357

णित किया जाता है कि जिस प्रकार चिन्ह की रूपाकृति इसके साथ संलग्न है, यह .....
में दिनांक ..... नाम से रजिस्ट्रीकृत हो चुका है।

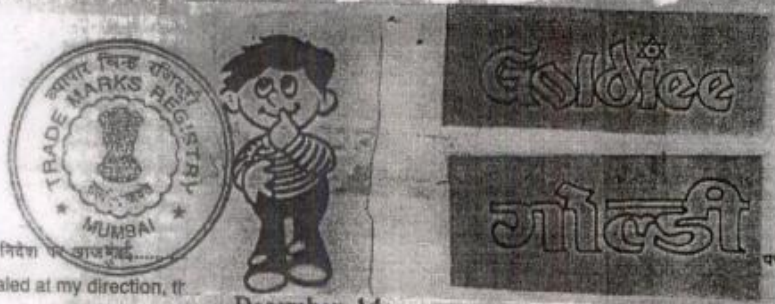
d that the Trade Mark / a representation is annexed hereto, has been registered in the name(s) of

.IAM GOLDEE MASALE PVT. LTD. 51/40, GOLDEE HOUSE, NAYAGANJ, KANPUR - 1. MANUFACTURERS AND HANTS.

ass 30 Under No. 773762 as of the Date 14-Feb-1997 in respect of

ABETIC MASALA INCLUDED IN CLASS 30.

COPY



के निदेश पर आज्ञमेर.....
Sealed at my direction, th December 14, 2000 /
पर मुद्रा लगायी गई।

व्यापार चिन्ह रजिस्ट्री, मुम्बई ।
Trade Marks Registry, Mumbai

व्यापार चिन्ह रजिस्ट्रार
Registrar of Trade Marks

रजिस्ट्रीकरण आवेदन की तारीख से 10 वर्ष के लिए है और तदुपरान्त यह 10 वर्ष की कालावधि के लिए और प्रत्येक 10 वर्ष की कालावधि के अवसान पर भी नवीकृत किया जा सकेगा।
Registration is for 10 years from the date of application and may then be renewed for a period of 10 years and also at the expiration of each period of 10 years.
यह प्रमाणपत्र विधि कार्यवाहियों में प्रयोग के लिये या विदेश में रजिस्ट्रीकरण अभिप्राप्त करने के लिये नहीं है।
This certificate is not for use in Legal proceedings or for obtaining Registration abroad.
टिप्पणी – इस व्यापार चिन्ह के स्वामित्व में कोई परिवर्तन होने पर या कारोबार के मुख्य स्थान के पते में या भारत में सेवाओं के लिये पते में परिवर्तन होने पर परिवर्तन के लिये आवेदन दिया जाना चाहिये।

भारत सरकार
GOVERNMENT OF INDIA

प्ररूप टी०-2
FORM T-2

व्यापार चिह्न रजिस्ट्री
TRADE MARKS REGISTRY

क्रमांक No. 156903

व्यापार और पण्य चिन्ह अधिनियम, 1958
TRADE AND MERCHANDISE MARKS ACT, 1958

व्यापार चिह्न के रजि... का प्रमाणपत्र, धारा 23(2), नियम 65 (1)
Certificate of Regi... of Trade Mark, Section 23(2), Rule 65 (1)

व्यापार चिह्न संख्या/Trade Mark No. 367000B दिनांक/Date 1st October, 1980

यह प्रमाणित किया जाता है कि व्यापार चिह्न की समाकृति इसके साथ उपाबद्ध है, वह.....

.....

.....

.....

के बारे में दिनांक.....को.....क्रम में रजिस्टर के भाग क (ख) में.....पर.....
.....संख्या से रजिस्ट्रीकृत हो चुका है।

Certified that the Trade Mark, of which a representation is annexed hereto, has been registered in part of A (B) of the register in the name(s) of D.P. Goenka, S.P. Goenka, Smt. R.D. Gupta and R.K. Gupta, trading as Shubham Industries, 23/7, Naya Ganj, Kanpur,

in 30 under No. 367000B as of the Date 1st November, 1980, in respect of Spices.

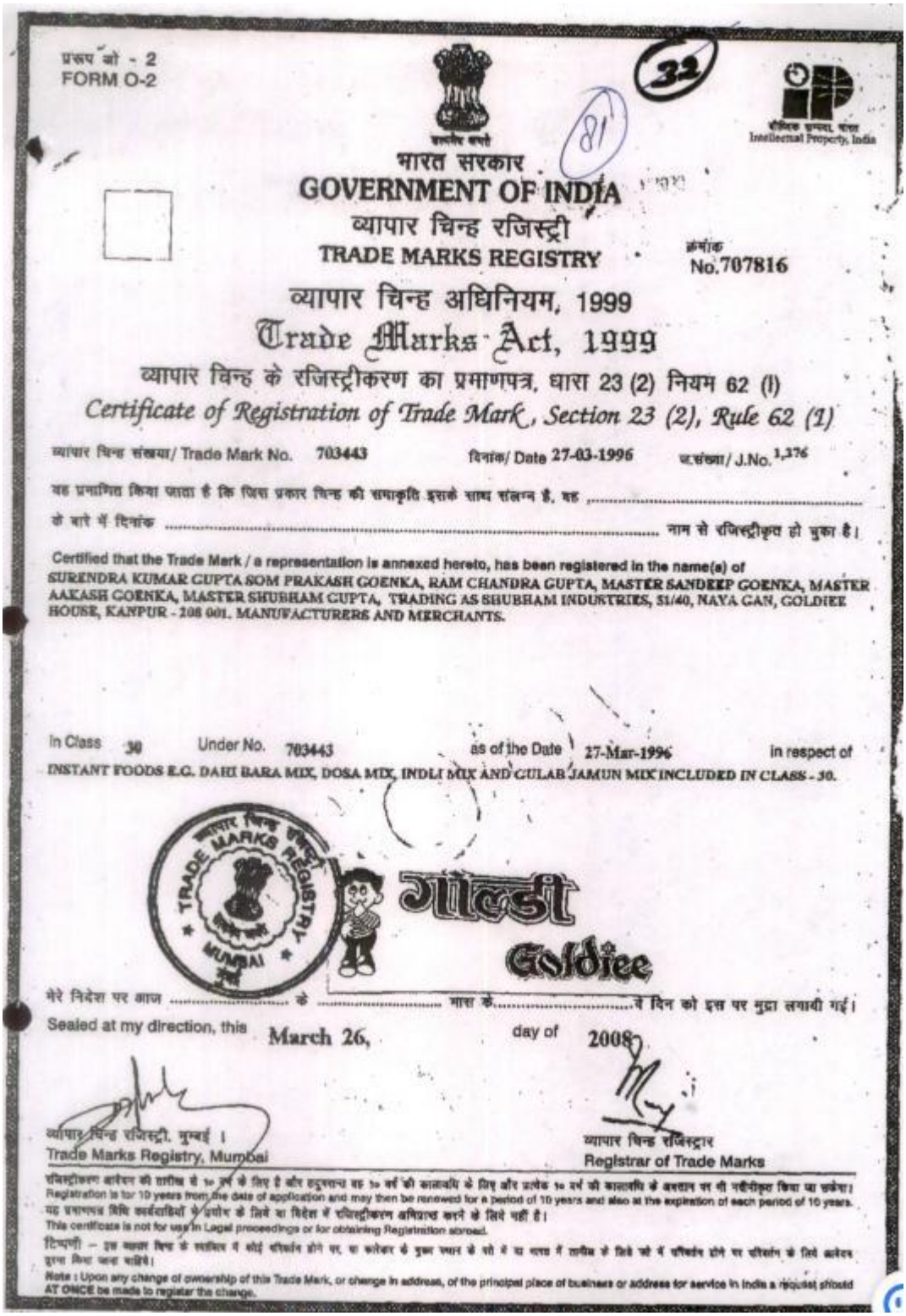


मेरे निदेश पर आज 15.....माह के.....वें दिन को इसपर मुद्रा लगायी गई।
Sealed at my direction, this Fifteenth day of February, 1988.

व्यापार चिह्न रजिस्ट्री, बंबई
Trade Marks Registry, Bombay

व्यापार चिह्न रजिस्ट्रार
Registrar of Trade Marks

शर्तों और सूचनाओं के लिये दूसरी ओर देखिए।
For instructions, please see overleaf.



प्ररूप ओ - 2
FORM O-2

भारत सरकार
GOVERNMENT OF INDIA
व्यापार चिन्ह रजिस्ट्री
TRADE MARKS REGISTRY

क्रमांक
No.707816

व्यापार चिन्ह अधिनियम, 1999
Trade Marks Act, 1999

व्यापार चिन्ह के रजिस्ट्रीकरण का प्रमाणपत्र, धारा 23 (2) नियम 62 (1)
Certificate of Registration of Trade Mark, Section 23 (2), Rule 62 (1)

व्यापार चिन्ह संख्या/ Trade Mark No. 703443 दिनांक/ Date 27-03-1996 ज.सं./ J.No. 1,176

यह प्रमाणित किया जाता है कि जिस प्रकार चिन्ह की छायाकृति इसके साथ संलग्न है, यह .....
के बारे में दिनांक ..... नाम से रजिस्ट्रीकृत हो चुका है।

Certified that the Trade Mark / a representation is annexed hereto, has been registered in the name(s) of SURENDRA KUMAR GUPTA SOM PRAKASH GOENKA, RAM CHANDRA GUPTA, MASTER SANDEEP GOENKA, MASTER AAKASH GOENKA, MASTER SHUBHAM GUPTA, TRADING AS SHUBHAM INDUSTRIES, 51/40, NAYA GAN, GOLDIEE HOUSE, KANPUR - 208 001. MANUFACTURERS AND MERCHANTS.

In Class 30 Under No. 703443 as of the Date 27-Mar-1996 in respect of
INSTANT FOODS E.G. DAHI BARA MIX, DOSA MIX, INDLI MIX AND GULAB JAMUN MIX INCLUDED IN CLASS - 30.

TRADE MARKS REGISTRY MUMBAI

गोल्डी
Goldiee

मेरे निदेश पर आज ..... के ..... मास के ..... वें दिन को इस पर मुद्रा लगायी गई।
Sealed at my direction, this March 26, day of 2008

व्यापार चिन्ह रजिस्ट्री, मुम्बई ।
Trade Marks Registry, Mumbai

व्यापार चिन्ह रजिस्ट्रार
Registrar of Trade Marks

रजिस्ट्रीकरण आवेदन की तारीख से १० वर्ष के लिए है और तदुपरान्त यह १० वर्ष की कालावधि के लिए और प्रत्येक १० वर्ष की कालावधि के अवसान पर भी नवीनीकृत किया जा सकेगा।
Registration is for 10 years from the date of application and may then be renewed for a period of 10 years and also at the expiration of each period of 10 years.
यह प्रमाणपत्र विधि कार्यवाहियों में प्रयोग के लिये या विदेश में रजिस्ट्रीकरण अभिप्राप्त करने के लिये नहीं है।
This certificate is not for use in Legal proceedings or for obtaining Registration abroad.
टिप्पणी – इस मामले चिन्ह के स्वामित्व में कोई परिवर्तन होने पर, या कारोबार के मुख्य स्थान के पते में या सेवा में तामील के लिये पते में परिवर्तन होने पर परिवर्तन के लिये आवेदन तुरन्त किया जाना चाहिये।
Note : Upon any change of ownership of this Trade Mark, or change in address, of the principal place of business or address for service in India a request should AT ONCE be made to register the change.

24. In comparison to the aforesaid, it would be appropriate to examine the

trademark application and registration of the respondent no.1 placed on record by the petitioner. The same are reproduced hereunder:-

(66) EXHIBIT-2

(NOT FOR LEGAL USE)

As on Date : 14/10/2014
Status : Registered

View Registration Certificate

View TM Application | View Additional Representation Sheet

17

TM Application No.	945240
Class	29
Date of Application	04/08/2000
Appropriate Office	DELHI
State	UTTAR PRADESH
Country	India
TM Applied For	GOLDI(LABEL)
Trade Mark Type	DEVICE
User Detail	01/01/2000
Certificate Detail	Certificate No. 424222 Dated : 16/09/2005
Valid upto/ Renewed upto	04/08/2020
Proprietor name	(1) RAMESH CHAND RATHORE[601718] Trading As : JAI SHIV OIL INDUSTRIES Partnership Firm Details : DHANVAN SINGH
Proprietor Address	RAJA KHERA ROAD, SHAMSABAD, DISTT. AGRA (U.P.).
Agent name	P. K. ARORA[259]
Agent Address	B-62/4,KESHAV KUNJ PRATAP NAGAR, AGRA-10.
Goods & Service Details	[CLASS : 29] MUSTARD OIL (EDIBLE OIL), INCLUDED IN CLASS - 29.
Conditions	REGISTRATION OF THIS TRADE MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF ALL DESCRIPTIVE MATTERS APPEARING ON THE LABEL.
Publication Details	Published in Journal No. : 1301-2 Dated : 18/08/2003
History/PR Details	REGISTRATION RENEWED FOR A PERIOD OF 10 YEARS FROM 04/08/2010 ADVERTISED IN JOURNAL NO. 1449

Uploaded Documents

Sr No.	Document description	Document Date	
1	TM-12	03/08/2010	View
2	Examination Report	01/06/2011	View
3	Additional Representation Sheet	01/06/2011	View
4	Certificate	01/06/2011	View
5	Correspondence	01/06/2011	View
6	Journal Copy	01/06/2011	View
7	TM-1	01/06/2011	View
8	Correspondence	27/09/2012	View
9	TM-70	26/07/2013	View

Trade Mark Image :



WARNING/DISCLAIMER : THE DATA OF TRADE MARKS REGISTRY IS UNDER THE PROCESS OF DIGITISATION, IF ANY DISCREPANCY IS OBSERVED IN THE DATA PLEASE CONTACT OR SUBMIT AT APPROPRIATE TRADE MARKS REGISTRY ALONGWITH SUPPORTING DOCUMENTS. THIS WILL HELP IN UPDATION OF ELECTRONIC RECORDS.

(NOT FOR LEGAL USE) EXHIBIT- 2

As on Date : 14/10/2014
Status : Registered

View TM Application | View Additional Representation Sheet | View Examination Report

TM Application No.	2023762
Class	31
Date of Application	15/09/2010
Appropriate Office	DELHI
State	UTTAR PRADESH
Country	India
TM Applied For	GOLDI (LOGO)
Trade Mark Type	DEVICE
User Detail	01/01/2000
Certificate Detail	Certificate No. 1044368 Dated : 16/03/2012
Valid upto/ Renewed upto	15/09/2020
Proprietor name	(1) DHANVAN SINGH[1196628] Trading As : JAI SHIV OIL INDUSTRIES Partnership Firm Details : RAMESH CHAND RATHORE
Proprietor Address	RAJA KHERA ROAD, SHAMSABAD, DISTT. AGRA, U.P
Agent name	P. K. ARORA[259]
Agent Address	TAJ TRADE MARKS PVT. LTD, 110 ANAND VRINDAVAN SANJAY PLACE AGRA(U.P)
Goods & Service Details	[CLASS : 31] FOODSTUFFS (OIL CAKE) FOR ANIMALS, BEING INCLUDED IN CLASS-31.
Publication Details	Published in Journal No. : 1500-0 Dated : 05/09/2011

Uploaded Documents

Sr No.	Document description	Document Date	
1	Additional Representation Sheet	15/09/2010	View
2	TM-1	15/09/2010	View
3	TM-48	15/09/2010	View
4	Correspondence	27/09/2012	View
5	TM-46	26/07/2013	View

Trade Mark Image :



WARNING/DISCLAIMER : THE DATA OF TRADE MARKS REGISTRY IS UNDER THE PROCESS OF DIGITISATION, IF ANY DISCREPANCY IS OBSERVED IN THE DATA PLEASE CONTACT OR SUBMIT AT APPROPRIATE TRADE MARKS REGISTRY ALONGWITH SUPPORTING DOCUMENTS. THIS WILL HELP IN UPDATION OF ELECTRONIC RECORDS.

25. On a close scrutiny and examination of both the set of documents, it is

noted that the respondent no.1 applied for a device mark "GOLDI" (label) on 04.08.2000 with a user detail of 01.01.2000 in Class 29 in relation to manufacture of mustard oil (edible oil), and on 15.09.2010 for the device mark "GOLDI" (logo in Hindi) with the user detail of 01.01.2000 in Class 31 in relation to manufacture of foodstuffs (oil cake) for animals. In contrast thereto, the petitioner had applied for the registration of its trademark "GOLDIEE" (label) on 01.10.1980 and for the label mark "GOLDIEE" (in Hindi and English) on 27.03.1996 in Classes 29 and 30.

26. From the aforesaid examination itself, it appears that not only is the petitioner a prior adopter and a prior user but also a prior registrant of the mark "GOLDIEE" both in Classes 29 and 30. There does not seem to be any plausible reason as to why and wherefrom the respondent no.1 has adopted the impugned mark "GOLDI" for the same class of goods i.e. edible oil and foodstuffs. On a simple and plain comparison of the two words "GOLDIEE" and "GOLDI", this Court has no doubt that both words are phonetically, visually and structurally nearly identical and deceptively similar. Except for the removal of the letters "EE" from the mark "GOLDIEE" of the petitioner, there is no substantial or apparent distinction, inasmuch as the pronunciation would still remain identical and visually both are nearly similar. Moreso, in the Hindi version, there would be no visual or structural distinction and the pronunciation would be identical. Though the comparison of the whole of the labels may have certain distinctions when the other elements of the labels are compared, however, the manner, the font and the structural formation in which the word "GOLDI" is written in Hindi in the mark of the respondent no.1 and that of the petitioner, this Court is of the considered opinion that there is clear deceptive similarity between both. It is to be noted that the mark "GOLDIEE"

in Hindi in both the labels of the parties, particularly the label of the respondent no.1 is the prominent/dominant part of the label. Clearly the confusion is writ large in the sense that even if the impugned mark "GOLDI" in Hindi is stated to be slightly distinct, yet would at least show or indicate its association with the petitioner and not the respondent no.1. This would be impermissible.

27. It has to be kept in mind that both parties are in the similar business i.e., edible oils as also foodstuffs. From the documents on record, it appears that the trade circle, distribution channels as also the retail outlets would be common between both the parties. The consumers who would purchase the product of both parties undoubtedly would be common. Though, so far as manufacture of oil cake for animals by the respondent no.1 may be a distinct category, however, it is asserted by the counsel for the petitioner that the said goods are also available in the same common retail outlets. If that be so, then the confusion and deception between the two rival marks would also get attracted to the oil cake for animals manufactured by the respondent no.1.

28. The petitioner has placed on record documents to establish the substantial growth in the sales figures from the year 2000-01 till 2012-13. The figures clearly established that by the time the respondent no.1 applied for registration of impugned mark "GOLDI" in the year 2000, with the user detail of 01.01.2000, the petitioner was already a well established brand having a turnover of Rs. 43 Crores for the same class of goods. The sales figures noted above and reproduced by the petitioner is extracted hereunder:-

YEAR	TURNOVER
2000-01	434,407,906

2001-02	501,707,005
2002-03	633,808,964
2003-04	736,690,017
2004-05	765,424,470
2005-06	966,847,927
2006-07	1,108,807,668
2007-08	1,347,917,420
2008-09	1,825,379,861
2009-10	2,296,692,374
2010-11	2,806,684,012
2011-12	2,746,753,392
2012-13	2,970,544,597

29. The petitioner has filed voluminous records containing the advertisement and other promotional material published in newspapers from the years 2001 till 2010-11, which indicate that the petitioner had incurred substantial expenditure for promotion and advertisement of its trademark "GOLDIEE", and the products manufactured by it in order to promote the said mark. Some of the promotions and advertisements carried out in the vernacular newspapers is extracted hereunder:-


दिल्ली जागरण

प्लेटफार्म पर आने को ले रहे लोकल टिकट

डीयू में हालात सामान्य होने के आसार नहीं

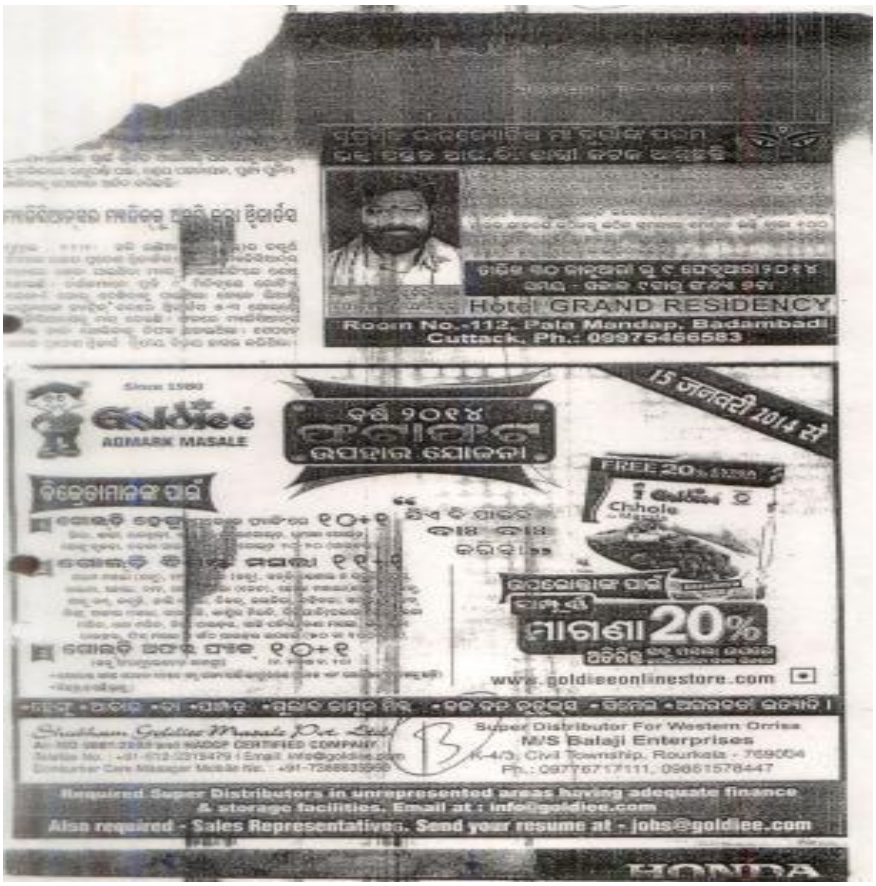
शिक्षकों का समूह मुख्यमंत्री से मिला

गोल्डी उत्पाद के सभी विक्रेताओं उपभोक्ताओं एवं शुभचिन्तकों को दीपावली की हार्दिक शुभकामनायें

गोल्डी

एगमार्क मसाले

"जो भी खायेगा वाह वाह करेगा।"


Hotel GRAND RESIDENCY

Room No.-112, Pala Mandap, Badambadi

Cuttack, Ph.: 09975466583

Goldiee AGMARK MASALE

15 ଜାନୁୟାରୀ 2014 ସୁଦ୍ଧା

ଉପହାର ଯୋଜନା

FREE 20% EXTRA

ମାଗଣା 20%

www.goldieeonlinestore.com

Super Distributor For Western Orissa

M/S Balaji Enterprises

Ph.: 09776757111, 09861578447

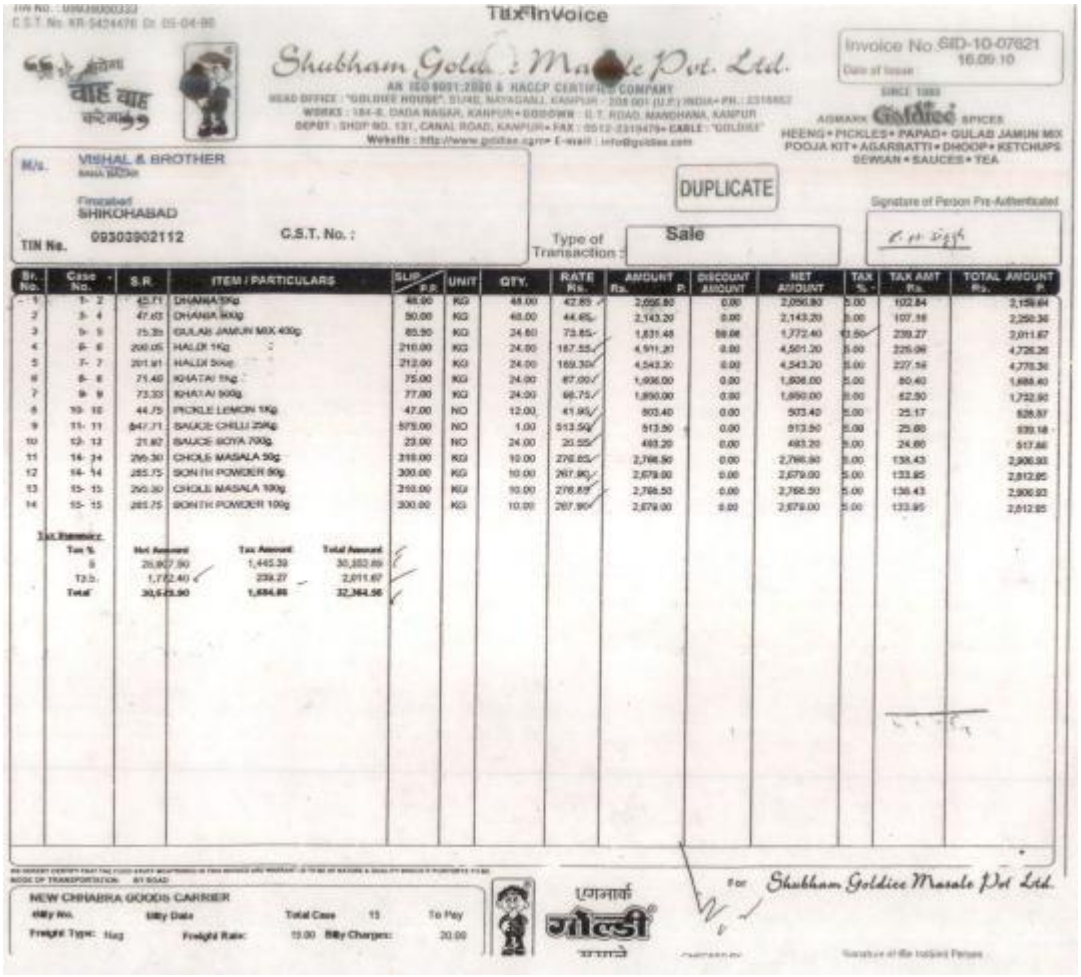
Required Super Distributors in unrepresented areas having adequate finance & storage facilities. Email at : info@goldiee.com

Also required - Sales Representatives. Send your resume at - jobs@goldiee.com

HONDA

The petitioner has also placed on record some sample invoices to

substantiate and support the assertion that the petitioner has been manufacturing and offering for sale products under the registered trademark "GOLDIEE". One of such invoice is extracted hereunder:-



Tax Invoice

Shubham Goldie Masale Pvt. Ltd.

AN ISO 9001:2008 & HACCP CERTIFIED COMPANY

Invoice No. SID-10-07621
Date of Issue 16.09.10

HEENG • PICKLES • PAPAD • GULAB JAMUN MIX
POOJA KIT • AGARBATTI • DHOOP • KETCHUPS
SEWAN • SAUCES • TEA

M/s. VISHAL & BROTHER

Finalabad
SHIKOHABAD

TIN No. 09303902112 C.S.T. No. :

DUPLICATE

Type of Transaction : Sale

Sr. No.	Case No.	S.R.	ITEM / PARTICULARS	SLIP P.P.	UNIT	QTY.	RATE Rs.	AMOUNT Rs. P.	DISCOUNT AMOUNT	NET AMOUNT	TAX %	TAX AMT Rs.	TOTAL AMOUNT Rs. P.
1	1- 2	45.71	DHANIA 1Kg	48.00	KG	48.00	42.85	2,056.80	0.00	2,056.80	5.00	102.84	2,159.64
2	3- 4	47.63	DHANIA 1Kg	50.00	KG	48.00	44.65	2,143.20	0.00	2,143.20	5.00	107.16	2,250.36
3	5- 5	75.35	GULAB JAMUN MIX 400g	80.90	KG	24.60	73.85	1,831.48	59.08	1,772.40	13.50	239.27	2,011.67
4	6- 6	200.05	HALDI 1Kg	210.00	KG	24.00	187.55	4,501.20	0.00	4,501.20	5.00	225.06	4,726.26
5	7- 7	201.91	HALDI 1Kg	212.00	KG	24.00	189.30	4,543.20	0.00	4,543.20	5.00	227.16	4,770.36
6	8- 8	71.40	KHATAI 1Kg	75.00	KG	24.00	67.00	1,608.00	0.00	1,608.00	5.00	80.40	1,688.40
7	9- 9	73.33	KHATAI 500g	77.00	KG	24.00	68.75	1,650.00	0.00	1,650.00	5.00	82.50	1,732.50
8	10- 10	44.75	PICKLE LEMON 1Kg	47.00	NO	12.00	41.95	503.40	0.00	503.40	5.00	25.17	528.57
9	11- 11	647.71	SAUCE CHILLI 25Kg	675.00	NO	1.00	613.50	613.50	0.00	613.50	5.00	25.68	639.18
10	12- 12	21.82	SAUCE SOYA 700g	23.00	NO	24.00	20.55	493.20	0.00	493.20	5.00	24.66	517.86
11	14- 14	265.30	CHOLE MASALA 50g	310.00	KG	10.00	276.65	2,766.50	0.00	2,766.50	5.00	138.43	2,906.93
12	14- 14	285.75	SONTH POWDER 80g	300.00	KG	10.00	267.90	2,679.00	0.00	2,679.00	5.00	133.95	2,812.95
13	15- 15	265.30	CHOLE MASALA 100g	310.00	KG	10.00	276.65	2,766.50	0.00	2,766.50	5.00	138.43	2,906.93
14	15- 15	285.75	SONTH POWDER 100g	300.00	KG	10.00	267.90	2,679.00	0.00	2,679.00	5.00	133.95	2,812.95

Tax Summary

Tax %	Net Amount	Tax Amount	Total Amount
5	29,807.90	1,445.39	30,353.89
13.5	1,772.40	239.27	2,011.67
Total	30,673.90	1,684.66	32,364.56

NEW CHHABRA GOODS CARRIER

LR/Gr No. LR/Gr Date Total Case 15 To Pay

Freight Type: Nug Freight Rate: 10.00 LR/Gr Charges: 20.00

For Shubham Goldiee Masale Pvt. Ltd.

Signature of the Issued Person

30. Learned counsel for the petitioner had relied upon the judgments of this Court in ***Fybros Electric (P) Ltd.*** *(supra)* and ***FDC Limited vs. Docsuggest Healthcare Services Pvt. Ltd., 2017 SCC OnLine Del 6381.*** in support of his contentions. In the aforesaid circumstances, it would be apposite to extract the relevant paragraphs of the judgment in ***Fybros Electric (P) Ltd.,*** *(supra),* which are reproduced hereunder:

> *"**26.** The petitioner's mark is registered in Classes 9 and 11 and the respondent's mark is registered in Class 11. Mr. Mishra sought to*

contend that, even though the petitioner has registration in Class 11, proof of user of the asserted FYBROS mark is only available with respect to goods relatable to Class 9. In other words, he submits, there is no material to indicate user of the asserted FYBROS mark in respect of any other goods, even if the mark is registered for various goods both in Classes 9 and 11.

27. *The submission is, to my view, misconceived in view of the specific words in which Section 11(1)(b) is couched. Section 11(1)(b) proscribes registration of a trademark if, on account of (i) its similarity to an earlier trademark and (ii) the identity or similarity of the goods or services covered by the trademark, there exists a likelihood of confusion on the part of the public. The expression "covered by the trademark" cannot be equated, in my view, with the words "in respect of which the mark is used". Coverage of a trademark has to be decided on the basis of the certificate of registration which sets out the goods in respect of which the trademark is registered. All such goods would be "covered by the trademark".*

[emphasis supplied]

Thus, the registration of the trademark "GOLDIEE" of the petitioner in Classes 29 and 30 shall preclude the respondent nos.1 and 3 from using identical or deceptively similar trademark "GOLDI". With respect to the registration of the respondent no.1 for the mark "GOLDI" (in Hindi) in Class 31 for foodstuff (oil cake) for animals is concerned, the counsel for the petitioner relied upon the judgment of this Court in ***FDC*** *(supra)*. The relevant paragraph is reproduced hereunder:

*"**51.** There can be no doubt, and it needs no discussion to say that the mark "Zifi" of the plaintiff and "Ziffi" of the defendant are phonetically, structurally and visually similar. In any event, this aspect is also discussed a little later. The prime issue in this case, therefore, is whether the goods of the plaintiff and the services of the defendants are allied/cognate or not. Allied/cognate goods or services, as understood from the material referred to below, are those goods/services which are not identical, but can be said to be related or similar in nature (See **McCarthy on Trademarks and Unfair Competition, Fourth Edition, Vol 5**). The Shorter Oxford English Dictionary on Historical Principles Fifth Edition 2002, Vol. 1. defines the term "Allied" as "connected by nature*

or qualities; having affinity" and the term "Cognate" as "akin in origin, nature or quality". Reference may also be made to New Webster's Dictionary and Thesaurus of the English Language, 1992 which defines "Allied" as "relating in subject or kind" and "Cognate" as "1. adj. having a common ancestor or origin (of languages or words) having a common source or root (of subjects etc.) related, naturally grouped together.". Cognate goods/services can be described, inter alia, as goods or services which have a trade connection - as in glucose and biscuits (See Corn Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142) or which are intended for the same class of customers - as in television picture tubes (parts thereof, video tapes and cassettes and television tuners etc.) and televisions, tuners and T.V. Kits (See Prakash Industries Ltd. v. Rajan Enterprises (1994) 14 PTC 31), or are complementary to each other - as in toothbrushes and toothpaste (See HM Sariya v. Ajanta India Ltd. (2006) 33 PTC 4).

52. *In the present case, the plaintiff is using the registered mark 'Zifi' for goods falling under Class 05 of the Schedule of the Act i.e. pertaining to pharmaceutical preparations. On the other hand, the defendants are using the mark 'Ziffi' for booking of appointments for doctors, diagnostics, spas and salons, and have applied for registration under Class 35 and 42 of the Schedule of the Act. It is the submission of the defendant that goods and services falling under different classes cannot be allied and cognate. I do not find merit in this submission. The classification of goods and services under Section 7 of the Act is not the criterion for deciding the question of similarity in goods/services. Reliance may be placed on K.C. Kailasam/Ramu Vedaraman's Law on Trade Marks & Geographical Indications 1st Edition, 2003 wherein, the learned author on Page 180 has stated as under-*

> *"**Classification of goods given in the rules not the criterion***
>
> *Whether or not two sets of goods or services are of the same description is not be decided on the basis of the classification of goods and services given in the 4th schedule to the Trade Marks Rules, 2002. The description of goods may be narrower or wider than any of the classes according to the circumstances of the case. As was observed by LINDLEY J., in the Australian Wine Importers Trade Mark case [(1889) 6 RPC 311]. "If you come to look at that classification, you will find goods of the same description, in one sense, in different classes; and you will find goods of different description in the same class"."*

[emphasis supplied]

The ratio in ***FDC*** *(supra)* appears to postulate that while the similarity in marks is being examined, the Court may have to consider myriad aspects

like the test of perceiving the goods from a business and commercial point of view; the nature, intended purpose, method of use, competition with each other or the complimentary nature of the goods and services offered; the users and the uses of the goods and services; the trade channels; the distinctive character of a trademark and its reputation, in order to ascertain whether the goods are cognate and/or allied in nature.

31. In the present case, it has been asserted by the petitioner that the goods are similar and/or allied and cognate in nature to that of the class of goods falling within Class 30 (foodstuffs) except that the goods manufactured by the respondent no.1 i.e., oil cake is for animals falling in Class 31. However, he would assert that the said items are available for sale in the same retail outlets as the items manufactured by the petitioner under Class 30 in relation to foodstuffs. It is the assertion of the petitioner that the purchasers who approach the same retail store would have the impression, *albeit* false, that the oil cake of the respondent no.1 is that of the petitioner or that it is associated with the petitioner. Either way according to him, the confusion and deception is most likely.

32. Having heard the counsel for the petitioner, with no rebuttal or contrary assertion by the respondent no.1, coupled with the judgments in ***Fybros Electric Ltd. and FDC*** *(supra)*, this Court is of the considered opinion that the parameters set out in the judgments would be applicable in the present case. Clearly, the aforesaid analysis evidences that the marks are structurally, visually, phonetically and conceptually deceptively similar. The distribution channels, the retail outlets for products manufactured by both parties too are common, and the consumer base is most likely to be common. In such circumstances it is likely that an unwary consumer with average intelligence

and imperfect recollection may tend to get confused or deceived into purchasing the goods of the respondent no.1 as those of the petitioner, and so far as the oil cake for animals is concerned, is most likely to associate the product as either manufactured by the petitioner or at least associated with it.

33. Even otherwise the provisions of Section 47(1)(a) of the Act, in the absence of any opposition, as also in the absence of any evidence as to how and in what manner respondent no.1 adopted the mark "GOLDI" which was registered, support the contention that such adoption is without *bonafide* intention, and in the absence of any evidence on record to establish the use of the said mark three months before the date of application, require removal of such mark from the Register of Trade Marks. Similarly, the provisions of Section 9(2)(a) and Section 11(1)(a) and (b) of the Act, if applied to the aforesaid facts, would bar registration of the mark "GOLDI".

34. On the overall conspectus of the matter, it leaves little doubt in the mind of the Court that not only are the two marks phonetically, visually and structurally nearly identical and deceptively similar, but conceptually too there does not seem to be any distinction. In such circumstances, it is trite that two identical/deceptively similar marks that too in the same Class and in relation to similar/identical goods cannot continue to remain on the Register of Trade Marks. Equally, it is relevant to note that both parties are in the same business of manufacture of mustard oil (edible oil) and foodstuff, which would also include oil cake for animals though stated to be manufactured only by the respondent no.1. The trade circles, the distribution network and the retail outlets too are common and the consumers of the products manufactured by both parties also are common. Under these circumstances, two rival marks of the nature described above cannot continue to remain on the Register of Trade

Marks.

35. In view of the above, in the considered opinion of this Court, the impugned trademark “GOLDI” of the respondent nos.1 and 3 cannot continue to remain on the Register of Trade Marks, and consequently is directed to be cancelled and removed from the Register of Trade Marks.

36. The Registrar of Trade Marks/respondent no.2 shall comply with the aforesaid direction within a period of six weeks from date.

37. The petitions are disposed of alongwith any pending application in above terms, however, no orders as to costs.

TUSHAR RAO GEDELA
(JUDGE)

APRIL 08, 2026/*rl/Sumit/anj*