

C.S. No.9 of 2021

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 28.06.2024

Coram:

THE HONOURABLE MR. JUSTICE P.VELMURUGAN

C.S. No.9 of 2021

M/s.Carborundum Universal Limited

Parry House,

No.43, Moore Street

Chennai - 600 001

Represented by its Deputy General Manager-legal

Mr.A.Narayanan

... Plaintiff

Vs.

Mr.Kailash Jain

Proprietor

Divya Diamond Tools,

Nagdevi Commerce Chambers

No.44, Nagdevi Cross Lane,

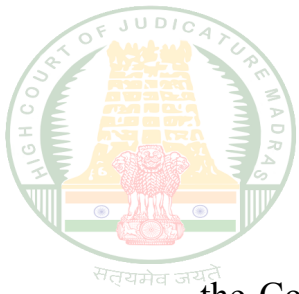
3rd Floor, Room No.29,

Mumbai - 400 003

maharashtra, India

... Defendant

Prayer: The plaint is filed under Order IV Rule 1 of Original Side Rules and Order VII Rule 1 of Code of Civil Procedure read with Sections 27, 134 and 135 of the Trademarks Act, 1999 & Proviso 1 to Section 7 of

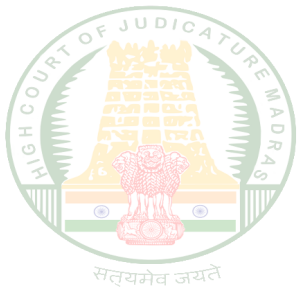


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the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015, praying to pass a judgment and decree against the defendant on the following terms:-

a. A permanent injunction restraining the defendant their/partners, men, servants, agents, distributors, stockists, successors in business, retailers, legal representatives, heirs, assigns or any other person claiming through or under them, from providing, offering, selling and marketing, advertising by use of deceptively similar trademark SPEED as that of the plaintiffs registered trademark SPEED amounting to infringement or any mark similar to the plaintiffs registered trademark SPEED or in any other manner for promoting its products whatsoever,

(b). A perpetual injunction restraining the defendant, by themselves, its proprietor, servants, heirs, successors, agents, distributors, stockists, advertisers, retailers, representatives or any of them from in any manner passing off and enabling others to pass off their diamond cutting and polishing tools and



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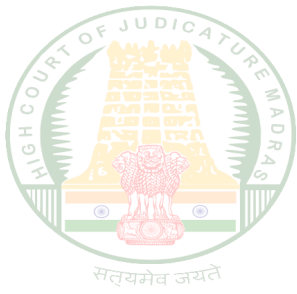
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for the plaintiff's products by use of identical trademark SPEED or any other mark similar thereto in respect of their products or business any other trademark/label deceptively similar to the plaintiffs trademark SPEED or in any other manner whatsoever;

(c). Damages to the tune of Rs. 10,00,000/- for the loss of sale and revenue or such higher amount as may be claimed by the plaintiff at a later date and as may be determined by this court upon enquiry.

(d). The defendant be ordered to surrender to the plaintiff for destruction, diamond cutting and polishing tools, pouches, prints, dies, blocks, screen prints, packing and advertising material and any other material in their possession, which are a substantial reproduction of the plaintiff's trademark SPEED;

(e). A preliminary decree be passed in favour of the plaintiff directing the defendant to render accounts of profits made by them by use of the trademark SPEED which is identical and/or deceptively similar and a final decree be passed in favour of the plaintiff



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for the amount of profits found to have been made by
the defendant after the latter has rendered accounts;

(f). For Cost of the suit.

For Plaintiff : Mr.Arun C.Mohan

Sole Defendant : Mrs.G.S.Dhanalakshmi
for Mr.S.T.Raja
for M/s.OM.Sai Ram

JUDGMENT

This suit has been filed by the plaintiff for permanent injunction to restrain the defendant from infringing the registered trademark of the plaintiff "SPEED" and for perpetual injunction from passing off. Besides, other consequential reliefs including damages.

2. The brief averments made in the plaint is that, the plaintiff is a Company incorporated under the Indian Companies Act. It is a leading constituent of the US\$ 4 Billion worth Murugappa Group of Companies.

The Plaintiff Company is engaged in manufacturing Power Tools,



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Diamond Cuttings and Polishing Tools, Machine Tools, Grindstone, Abrasives, Refractories, Electro-minerals and Industrial Ceramics. The plaintiff is the pioneer in coated abrasives, bonded abrasives and tools for cutting stones in India. Its turnover for the year 2019- 2020 is about 16231 Million INR. During the course of their business, the plaintiff has adopted various trademarks which includes CARBORUNDUM, CARBORUNDUM UNIVERSAL, CUMI, CHAMAK, AUTOPAPER, AJAX, SPEED, JAWAN etc. All these trademarks are reputed and well received by the trade and public. The trademark "SPEED" was adopted by the plaintiff in the year 2007, in respect of diamond cutting, polishing tools, machine tools, hand held tools (mechanically operated). The plaintiff is the registered proprietor of the mark "SPEED" under class 7. The registration is valid and in force till date. The mark SPEED has been openly, extensively and continuously used in respect of diamond cutting and polishing tools since the year 2007 and extensively renowned



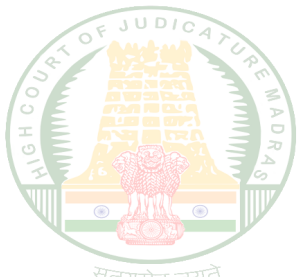
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throughout the trade and public for its quality and durability. The turnover of the products under the trademark "SPEED" steadily increasing since 2007. For the finance year 2019-2020, the sales turnover is Rs.31.16 crores.

2.1. While so, during the month of October-2020, the plaintiff came across the defendant's diamond cutting and polishing tool under the mark "SPEED" in the market. The mark "SPEED" as appearing on the label of the defendant's product is visually, phonetically and structurally similar to the plaintiff's registered trademark "SPEED". Arrangement of features as appearing on the defendant's product and the label is malafide adoption with intent to infringe the right of the plaintiff by use of the mark SPEED. They are identical to that of the plaintiff's mark and label with the intention to mislead and confuse the public.

2.2. The plaintiff, immediately caused cease and desist notice to the defendant, but the defendant did not respond. Hence, the present suit for



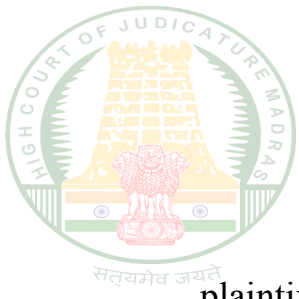
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the relief stated.

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3. Despite service of summons, since the defendant had not appear either personally or through counsel, the sole defendant was set ex-parte and ex-parte decree was also passed by this Court on 07.09.2021. Subsequently, the ex-part decree was set aside vide order dated 10.08.2023 in A.No.4134 of 2023 in C.S.No.9 of 2021. Though the defendant had filed an application in A.No.5090 of 2023 to condone the delay of 901 days in filing the written statement in the present suit, since the delay was beyond 90 days, the said application was dismissed. However, the defendant was permitted to cross examine the plaintiff's witness and submit arguments.

4. In order to substantiate their claim, one Mr.A.Narayanan, the General manager-Legal of the plaintiff company filed his proof affidavit for chief examination reiterating the averments made in the plaint and he was examined as P.W.1 and also marked 9 documents as Ex.P.1 to Ex.P.9 in which, Ex.P.1 is the photocopy of Board resolution granted by the

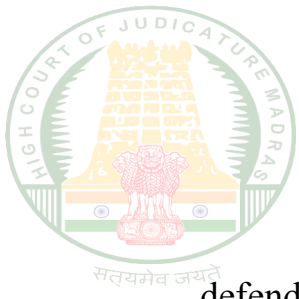


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plaintiff in favour of Mr.A.Narayanan dated 03.08.2016, Ex.P.2 is the photocopy of Certificate of incorporation and certificate of commencement of plaintiff company dated 21.04.1954, Ex.P.3, is the original invoices regarding sale of products under the mark SPEED on 2012-2020, Ex.P.4 is the photocopy of certificate issued by Chartered Accountant showing annual sales figures and sales promotion expenses of plaintiff in respect of the mark SPEED on 2012-2020, Ex.P.5 is the photocopy of certified copy of registration certificate for the mark SPEED under No.2358738 in class 7 dated 05.07.2012, Ex.P.6 is the printout of Advertisements and other sales promotional materials regarding plaintiff's trademark SPEED dated 05.07.2012, Ex.P.7 is the photograph of plaintiff's SPEED label dated 05.07.2012, Ex.P.8 is the photograph of defendant's SPEED label dated 05.07.2012, and Ex.P.9 is the Legal notice issued by the plaintiff's counsel to defendant dated 08.10.2020.

5. The learned counsel for the plaintiff submitted that though the



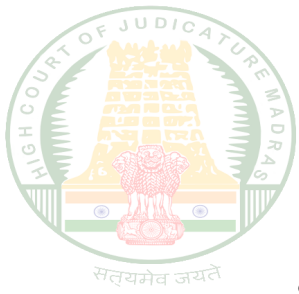
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defendant had infringed the trademark of the plaintiff, subsequently after filing of the present suit, they have stopped and as on date there is no infringement. However, in order to get appropriate orders restraining the defendant from infringing the plaintiff's trademark in future, they continued the suit till date.

6. The learned counsel for the defendant submitted that the plaintiff has not proved the cause of action as alleged in the plaint and the plaintiff is not able to establish as to on which date the infringement took place and also the mode of infringement. Even during cross examination, the plaintiff could not say as to on what date the infringement took place. It is for the plaintiff to prove his case and the plaintiff cannot take advantage of the loop hole left by the defendant. Therefore, the suit has to be dismissed.

7. Heard both sides and perused the averments made in the plaint, the proof affidavit of P.W.1 and also the documents marked on the side of the plaintiff.



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8. Since the defendant was forfeited from filing the written statement, there was no oral evidence and pleadings on the side of the defendant. Therefore, there was no tirable issues. Hence, no isusses were framed. However, mere non filing of the written statement and the forefeiture of the defenant would not entitle the plaintiff to get a decree automatically and the plaintiff has to prove its case.

9. As per the averments made in the plaint and the cause of action, the case of the plaintiff is that the defendant infringed the trademark of the paintiff. However, the learned counsel for the plaintiff himself admitted that subsequent to filing of the present suit, the defendant has stopped infringing the plaintiff's trademark and they seek appropriate orders to restrain the defendant from infringing the plaintiff's trademarks in future.

10. Under these circumstances, the plaintiff is entitled to get the relief of permanent injunction. Accordingly, the defendnat is restrained from using the trademark of the plaintiff.



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11. Insofar as the other reliefs are concerned, the plaintiff has not established its claim for other reliefs including damages. Therefore, the plaintiff is not entitled to other reliefs.

12. Accordingly, this suit is decreed insofar as the relief of permanent injunction alone is concerned. The suit is dismissed with regard to the other reliefs.

13. In the result, the suit is decreed in part. No costs.

28.06.2024

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Witness examined on the side of the plaintiff;

Mr.A.Narayanan - P.W.1

List of exhibits marked on the side of the plaintiff:

S.No.	Exhibits	Description of documents
1	Ex.P.1	The photocopy of Board resolution granted by the plaintiff in favour of Mr.A.Narayanan dated 03.08.2016.
2	Ex.P.2	The photocopy of Certificate of incorporation and certificate of commencement of plaintiff company dated 21.04.1954.



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S.No.	Exhibits	Description of documents
3	Ex.P.3	The original invoices regarding sale of products under the mark SPEED on 2012-2020.
4	Ex.P.4	The photocopy of certificate issued by Chartered Accountant showing annual sales figures and sales promotion expenses of plaintiff in respect of the mark SPEED on 2012-2020.
5	Ex.P.5	The photocopy of certified copy of registration certificate for the mark SPEED under No.2358738 in class 7 dated 05.07.2012.
6	Ex.P.6	The printout of Advertisements and other sales promotional materials regarding plaintiff's trademark SPEED dated 05.07.2012
7	Ex.P.7	The photograph of plaintiff's SPEED label dated 05.07.2012.
8	Ex.P.8	The photograph of defendant's SPEED label dated 05.07.2012.
9	Ex.P.9	The Legal notice issued by the plaintiff's counsel to defendant dated 08.10.2020.

List of witnesses examined on the side of the defendant - **Nil**

List of exhibits marked on the side of the defendant - **Nil**

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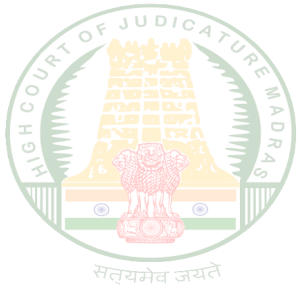
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Index : Yes / No

Speaking Order : Yes / No

Neutral Case Citation : Yes/No

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