

IN THE HIGH COURT OF JUDICATURE AT MADRAS

JUDGMENT RESERVED ON:07.08.2017
JUDGMENT PRONOUNCED ON: 22.08.2017

CORAM:

THE HONOURABLE MR.JUSTICE R.SUBRAMANIAN

CMA.No.2180 of 2017
and CMP No.11527 of 2017

M/s.Sri Kanishk Collection,
Rep.by its partner Mr.L.R.Jagadeesh
Business at No.72, Anna Salai,
Opposite Bus Stand, Arcot,
Vellore District 632 503. Appellant/Respondent/Defendant

Vs

M/s. SKC Readymades,
Rep. by its Partner Sr. T.Anugusamy,
Business at No.2, Iyer Lane,
Swarnapuri, Salem 636 004. Respondent/Petitioner/Plaintiff

Prayer: This appeal is filed under Order XLIII Rule 1(R) of C.P.C., to set aside the order and decretal order passed by Hon'ble II Additional District Judge, Salem in I.A.No.244 of 2017 in O.S.No.128/2017 dated 03.07.2017.

For Appellant : Mr.K.M.Vijayan,
Sr.Counsel
for M/s.Vijayan Associates

For Respondent : Mr.P.S.Raman,
Sr. Counsel
for M/s.Rajesh Ramanathan

J U D G E M E N T

By consent of both the counsels, the appeal itself is taken up for final hearing. The appeal arises out of interlocutory proceedings in OS. No.128 of 2017 launched by the respondent complaining infringement of its trademark by the appellant.

2. The suit in OS.No.128 of 2017 has been filed by the respondent seeking permanent injunction restraining the defendant from in any manner infringing the copyright in SKC in English and/or Tamil trademark/logo of the plaintiff by use of the expression SKC in English and/or Tamil with/without a logo

or in any other manner whatsoever, the perpetual injunction restraining the defendant from infringing the plaintiff's registered trade mark comprising the expression SKC, more particularly by the use of the trade mark SKC either in English or in Tamil, in any way, that is similar or deceptively same registered to the trade mark of the plaintiff and other reliefs.

3. The case of the plaintiff is that it is a partnership firm carrying on business Readymades and silks in Dindigul and Salem. It owns registered trade mark in Registration No.1513383 as "SKC Readymades" and Registration No.1513384 as "SKC'S Textiles". The said registered trademarks are honestly adopted by the plaintiff's sister concern in Dindigul and in Salem. According to the plaintiff, it has earned reputation of its own and the word SKC is the most prominent and memorable part of the trading style of the business. It is also claimed that the plaintiff incurred several lakh of Rupees as advertisement charges for popularizing the trademark 'SKC' and 'SKC's' before the consumers as well as the public.

4. According to the plaintiff, the defendant attempted to commence a business using the same trademark namely SKC and titled the same as SKC textiles and readymades and attempted to open a shop at Arcot in Vellore District. Both the English and Tamil fonts used by the plaintiff in its registered trade mark were used by the defendant/appellant. Therefore the plaintiff was forced to issue a notice complaining of infringement and the requiring the defendant to desist from using the registered trade marks of the plaintiff. The defendant sent a reply on 29.05.2017 claiming that there was no attempt on its part to use the trademark of the plaintiff. It is further claimed that the actual trade name of the defendant is 'Sri Kanishk Collection' and Kanishka being the name of the daughter of one of the partners of the defendant firm, it is a bona fide user of the name. It is also contended that the plaintiff is having no business interest in Arcot Town and cannot prevent the defendant from using the abbreviation of its name, namely 'Sri Kanishka collection' as 'SKC'. Faced with such reply, the plaintiff is forced to file the above suit for injunction.

5. The defendant entered appearance through counsel and resisted the suit. After hearing the parties and analysing the evidence on record, the learned II Additional District Judge, Salem concluded that there has been an attempt on the part of the defendant who has infringed the trade mark of the plaintiff. Once the infringement is established the plaintiff

would be entitled to an order of injunction without any further proof. Holding so, the learned II Additional District Judge, Salem, granted an order of injunction as prayed for in IA.No.244 of 2017. Aggrieved the defendant is on appeal before this Court.

6. I have heard Mr.K.M.Vijayan, learned Senior Counsel appearing for M/s.K.M.Vijayan and Associates, for the appellant and Mr.P.S.Raman, learned Senior Counsel appearing for Mr.G.Rajesh Ramanathan, learned counsel for the respondent.

7. Mr.K.M.Vijayan, learned Senior Counsel appearing for the appellant would contend that there is no infringement of the trade mark of the plaintiff as alleged by the respondent/plaintiff. According to him, the letters SKC are used only as abbreviation of the full name namely 'Sri Kanishk Collection' and it is always accompanied by Silks and Readymades as well as the full expansion of the abbreviation 'Sri Kanishk Collection'. Contending that there is no similarity between the trade mark of the plaintiff and that of the defendant, Mr.K.M.Vijayan, learned Senior Counsel would contend that there is no infringement as alleged. Secondly, the learned counsel would contend that the area of business is different, since the plaintiff is admittedly carrying on business at Dindigul and Salem and has no business interest in Vellore District, more particularly, in Arcot Town. There cannot be an injunction restraining the defendant from using the abbreviation SKC at Arcot. Thirdly, the learned senior counsel would submit that Section 35 of the Trade Marks Act specifically authorizes the user of one's own name or an abbreviation thereof and the same would not amount to infringement of a trade mark.

8. In support of his submissions, Mr.K.M.Vijayan, learned Senior Counsel, would rely upon the judgment of the Hon'ble Supreme Court in Cadila Health Care Ltd v. Cadila Pharmaceutical Ltd., reported in 2001 (5) SCC 73, wherein the Supreme Court has considered the question of deceptive similarity and had concluded that the accompanying words should always be considered and if it is shown that there is no deceptive similarity and distinction can be made on the basis of the accompanying words there is no question of any infringement.

9. Per contra, Mr.P.S.Raman, learned Senior Counsel appearing for the respondent would contend that the question of deceptive similarity cannot be a ground in an infringement

action, as opposed to a passing off action. Pointing out that the Judgment of the Supreme Court in Cadila Health Care Ltd v. Cadila Pharmaceutical Ltd., (cited supra), dealt with the passing off action and not a case of an infringement, the learned Senior Counsel would contend the said judgment cannot be made applicable to an infringement action. Deceptive similarity is not a question that is to be considered in an infringement action. In support of his submissions the learned Senior Counsel would rely upon the judgment of this Court in Gangotree Sweets and Snacks Pvt. Ltd. Chennai, v. Shree Gangotree Sweets, Snacks & Savories, Trichy, reported in (2005) 31 PTC 502, wherein Hon'ble Mr. Justice F.M. Ibrahim Kalifulla, (as he then was) had an occasion to consider similar application for an injunction, on the ground that Gangotree Sweets and Snacks Pvt. Ltd. Chennai, was the proprietor of a trade mark Gangotree and by using Shree Gangotree or any other mark similar to the registered trade mark, the respondent therein are infringing upon the trade mark of the applicant, namely Gangotree Sweets and Snacks Pvt. Ltd. Chennai. After referring to the various decisions on the point, the Hon'ble Judge took note of the difference between an infringement and a passing off action and as laid down by the Supreme Court in Huston & Hornby Ltd v. Zamindara Engineering Co. reported in 1969 (2) SCC 727 and held that the right of infringement being a statutory right would depend upon the validity of the registration, subject only to the restrictions imposed under Sections 30, 34 and 35 of the Trade Marks Act and deceptive similarity cannot be gone into in an infringement action. When once it is found that the applicant owns a registered mark any user of the same with a slight modification or otherwise would automatically amount to an infringement. Therefore, the first contention of Mr. K.M. Vijayan, learned Senior Counsel appearing for the appellant cannot be countenanced.

10. Secondly, it is contented by Mr. K.M. Vijayan, learned Senior Counsel appearing for the appellant that the respondent have got business interest only at Dindigul and Salem and therefore, the commencement of a business and user of the abbreviation of SKC by the defendant/appellant at Arcot Town, which is about 400 kilometers away cannot be said to be an infringement. The said question was also answered in the Judgment in Gangotree Sweets and Snacks Pvt. Ltd. Chennai, v. Shree Gangotree Sweets, Snacks & Savories, Trichy, cited supra, wherein it was contended that the plaintiff therein though is a registered proprietor of the trade mark "Gangotree" since it is carrying business only on Chennai and the respondent therein was carrying business only at Trichy, there cannot be said to be any infringement of the trade mark. Answering the said contentions, the Hon'ble Judge has concluded that once a mark

is registered, it will be valid throughout the country and unless it is shown that there are certain geographical limitations as prescribed under Section 30 or 31 of the Trade Marks Act any user of the mark anywhere in India, which is similar to plaintiff's mark would amount to an infringement.

11. Mr.P.S.Raman, learned Senior Counsel appearing for the respondent would also rely upon the judgment of the Division Bench of this Court in Blue Hill Logistics Private Ltd. v. Ashok Leyland Limited and others reported in 2011 (4) CTC 417, wherein it was held that the plaintiff, therein who was having business interest at Tamil Nadu and Mumbai, can prevent the defendant, who is operating from Bangalore using a phonetically similar name, even though the user of the name may be in a different but connected service. The plaintiff who is leading Automobile manufacturer, and who had named their luxury buses as "LUXURA" in the year 2006 and it registered the said name 'LUXURA' as a trade mark, sought for an injunction restraining the defendant therein who had designed business class buses and named it as 'LUXURIA'. Since the defendant therein namely in Blue Hill Logistics Private Ltd., case cited supra, did not comply with the cease and desist notice issued the plaintiff came forward with a suit for injunction complaining of an infringement. A Single Judge of this Court granted an injunction and the same was confirmed by the Division Bench in the above said judgment.

12. Relying upon the same, Mr.P.S.Raman, learned Senior Counsel would contend that the respondents, can, at any time, commence a business at Arcot with the registered trade mark and therefore the defendant who is an infringer, cannot be heard to contend that they should be allowed to continue the infringement, because the plaintiff does not have any business interest at Arcot as of now. As rightly pointed out by Mr.P.S.Raman, learned Senior Counsel, when once a Trade Mark is registered with Registrar, it has force all over India and it is open to the registered holder to prevent any infringement immaterial of the fact that as to whether it has a business interest or not in the area in which the infringement is alleged to have taken place.

13. Thirdly, it is contend by Mr.K.M.Vijayan, learned Senior Counsel appearing for the appellant that use of the abbreviation by the defendant as SKC which will fall within Section 35 of the Trade Marks Act, 1999 and as such, according to him, there is no infringement of the trade mark. As a user falls within one of the exceptions provided under the Act

itself. Section 35 of the Trade Marks Act, 1999 reads as follows:-

"35. Saving for use of name, address or description of goods or services:-

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character of quality of his goods or services."

14. According to Mr.K.M.Vijayan, learned Senior Counsel, the letters 'SKC' represents an abbreviation for 'Sri Kanishk Collection' and Kanishka being the name of a partner's daughter of the defendant-firm, such user is exempt under Section 35 of the Trade Marks Act, 1999. Therefore, according to him, it does not amount to infringement of the trade mark. In answer to the said submission Mr.P.S.Raman, learned Senior Counsel appearing for the respondent would contend that in order to come within the purview of Section 35, it will have to be established that it should be a bona fide user by a person of his own name. Unless, it is shown that the user by a person is of his own name, Section 35 of the Trade Marks Act, 1999 will not stand attracted. The learned Senior Counsel would rely upon the Judgment of the Delhi High Court in B.K.Engineering Co. v. Ubhi Enterprises (Regd.) & Anr. reported in (1985) ILR 1 Delhi 525, wherein the claim that the alleged infringer was using the name of his mother, was rejected by the Court. He would also rely upon the judgment of this Court in VIT University v. Bagaria Education Trust & Ors., reported in 2016 (67) PTC 120, wherein the claim of Bagaria Education Trust and others that it can use the abbreviation of 'Vivekananda Institute of Technology' as 'VIT' was rejected by this Court because the mark VIT was registered mark belonging to VIT University expanded as Vellore Institute of Technology University, established and run by a Trust namely 'North Arcot Educational and Charitable Trust'. Therefore, the claim of the defendant that the user of the abbreviation 'SKC' would not amount to infringement cannot also be accepted.

15. Apart from the above, I must also point out that an order of injunction is discretionary order and when once the trial Court exercises a discretion and grants an interlocutory order of injunction, the same will not be normally interfered

with by the Appellate Courts, unless it is found that such a discretion has been exercised arbitrarily or capriciously or perversely, or where the Court ignored settled principles of law regarding the grant or refusal of interlocutory injunction. This has been repeatedly pointed out by the Supreme Court in Ramdev Food Products (P) Ltd. v. Arvindhbhai Rambhari Patel and others, [2006 (8) SCC 726]; Wander Ltd v. Antox India (P) Ltd., [1990 Supp SCC 727]; Laxmikand V. Patel v. Chetanbhai Shah, [2002 (3) SCC 65] and Seema Arshad Zaheer v. Municipal Corpn. of Greater Mumbai, [2006 (5) SCC 282].

16. In view of the above discussion, I do not see any reason to interfere with the discretion exercised by the trial Court while granting an injunction in favour of the respondent which is a registered mark holder.

In view of the same, the appeal stands dismissed, confirming the fair and decretal order of the Trial Court. However, in the circumstances of the case, there shall be no order as to costs. Consequently, the connected miscellaneous petition is closed.

-s/d-

Assistant Registrar(CCC)

True Copy

Sub-Assistant Registrar

jv

To

The II Additional District Judge,
Salem.

+1 CC to Mr. Rajesh Ramanathan, advocate sr 60303.

+1 Cc to Mr.K.M. Vijayan Associates, sr 60244.

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RSY(CO)
sp(04/09/2017)