

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 30.11.2017

CORAM

THE HON'BLE MS.INDIRA BANERJEE, CHIEF JUSTICE
and
THE HON'BLE MR. JUSTICE M.SUNDAR

O.S.A.No.330 of 2017
and C.M.P.No.20726 of 2017

1.C.Murali Kannan
2.M.Srinivasan
3.B.Ramachandran

... Appellants/Respondents

Vs

N.Sathish ... Respondent/Applicant

Appeal filed under Order XXXVI, Rule 9 of Original Side Rules read with Clause 15 of Letters Patent against the order dated 06.11.2017 made in O.A.No.115 of 2017 in C.S.No.73 of 2017 on the file of this Court.

For Appellants .. Mr.A.Thiyagarajan
Senior Counsel
for M/s.D.Senthil Kumar

For Respondent .. Mr.R.Sathish Kumar

JUDGMENT

(Delivered by The Hon'ble Chief Justice)

This appeal is directed against an order dated 6th November, 2017 passed by the learned Single Bench, disposing of an Interlocutory Application for injunction filed by the respondent, hereinafter referred to as respondent plaintiff in C.S.No.73 of 2017, being a suit for passing off, filed by the respondent plaintiff against the appellant defendants seeking inter alia a permanent injunction restraining the appellant defendants by themselves or through their servants, licencees, agents, distributors or anyone claiming through them from passing off their goods i.e., plastic water taps and shower taps and other bathroom fittings in any manner as being connected with the business of the respondent plaintiff's mark 'SIVA' by using the said mark or any deceptively similar mark such as 'MSR SIVA' or 'SIVA'.

2. In the suit, the respondent plaintiff has also sought direction on the defendants i.e., the appellant defendants herein, to surrender to the respondent plaintiff all the unsold goods including plastic water taps and shower taps under the deceptively similar mark 'SIVA' or 'MSR SIVA' and other consequential reliefs.

3. It was the case of the respondent plaintiff before the learned Single Bench that the respondent plaintiff was engaged in the manufacture of plastic taps and bathroom fittings, including water taps, which were being marketed under the trademark 'SIVA'.

4. It was claimed that the trademark 'SIVA' was being continuously used from the year 1994 and the said trademark had gained reputation and goodwill.

5. Claiming proprietorship of the said trademark 'SIVA' by reason of continuous user from the days of predecessors-in-title of the respondent plaintiff, the respondent plaintiff applied for registration of the trademark 'SIVA' in Clause 11. The application is pending.

6. In the affidavit in support of the application for interim injunction, it is pleaded that the sales turnover of plastic water taps bearing the mark 'SIVA' runs into several lakhs of rupees. The appellant defendants were well known to the family of the respondent plaintiff and had, to some extent, participated in the business of the respondent plaintiff's father. From the averments, it is patently clear that there was some kind of business collaboration between the appellant defendants and the respondent plaintiff and it was only in 2015 when the relationship between the respondent plaintiff and the appellant defendants became estranged that the disputes and differences arose.

7. In the order under appeal, it is recorded "what is admitted is that all parties were carrying on one common business and utilising the tradename SIVA since 1994. It was only upon differences arising between them in 2015 that both sides started separate businesses". Learned Single Bench further observed as follows:

"The applicant has also filed copies of two trademark applications for the trademark 'SIVA', one by the respondents claiming to be a Firm and another filed by the third respondent for the mark 'SIVA' on 4.8.2016 claiming user from 5.1.1995. The applications have been opposed by the applicant. Of the various applications placed before me, the earliest in point in time is by the father of the present applicant for

the mark 'SIVA' dated 10.11.2008 claiming user from 16.6.1997. The second has been filed by the concern of which the applicant is the proprietor on 8.1.2015 claiming user from 1.1.1992, the third by the respondents on 3.11.2015 claiming user from 10.5.2013 and the fourth by the 3rd respondent dated 4.8.2016 claiming user from 5.1.1995. Even assuming that the benefit of the registration obtained by Mr.Narendran is unavailable to the applicant, the application filed by the applicant itself, on 08.01.2015 is prior in time to the applications filed by the respondents. The applicants have thus, established a prima facie case as far as prior use of the mark is itself concerned."

8. In view of the factual finding of concurrent user of the trademark 'SIVA' by the respondent plaintiff and the appellant defendants for about two decades, it is doubtful whether any interim injunction ought to have been passed, in effect restraining the appellant defendants from using the mark 'MSR SIVA'.

9. It is well settled that an injunction is granted only when the applicant for injunction approaches the Court at the earliest possible opportunity, immediately when the act of passing off commences. When there has been concurrent user and that is the admitted position, injunction is uncalled for.

10. We modify the order under appeal by setting aside the order of the learned Single Judge to the extent that the appellant defendants have been restrained from using the mark 'SIVA', 'MSR SIVA' and/or any other similar mark.

11. The appeal is accordingly disposed of. No costs. Consequently, CMP.No.20726 of 2017 is closed. Any observation made in this order shall not influence the proceedings before the learned Single Bench and/or the proceedings before the Registrar of Trademarks. The appellant defendants shall maintain separate accounts of all sales of their products using the mark 'SIVA', 'MSR SIVA' or any other deceptively similar mark.

12. We direct the Registrar of Trademarks to complete the proceedings relating to the registration of marks in question filed by the respective applicants in accordance with law expeditiously.

13. We request the learned Single Judge concerned to dispose of the suit within three months. The appellant defendants undertake to file their written statement within two weeks from date.

s/d-
Assistant Registrar (CS VI)

True Copy

Sub-Assistant Registrar

bbr

To

The Sub Assistant Registrar,
Original Side, High Court, Madras.

Copy to:

The Registrar of Trademarks,
Intellectual Property Building,
G.S.T. Road,
Guindy, Chennai-32.

+2 Ccs to Ms.D. Senthil Kumar, Advocate sr 85235

O.S.A.No.330 of 2017

MP (CO)
SP (13/12/2017)

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