

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 25.01.2018

CORAM

THE HON'BLE MR.JUSTICE M.SUNDAR

C.S.No.361 of 2000

M/s.N.Ranga Rao & Sons Private Limited,
PB No.52, Vani Vilas Road,
Mysore-570 004
and also at
25-B, Industrial Estate,
Chennai-600 097
represented by its Director
Mr.Vishnu Das Ranga

.. Plaintiff

Vs.

M/s.Balarama's Incense Pvt. Ltd.,
I Floor, No.10, Herekempa Halli,
Opp. 9th A Cross, Wilson Garden
Hosur Road, Bangalore-560 027.

.. Defendant

This Civil Suit is preferred, under Order IV Rule 1 of Original Side Rules read with Order VII Rule 1 of CPC and Section 105 and 106 of the Trade and Merchandise Marks Act, 1958 seeking judgment and decree by granting permanent injunction restraining the defendants by themselves, their servants or agents or anyone claiming through them from in any manner infringing the plaintiff's registered trademark WOODS by using the offending trademark WOOD or any other mark or marks which are in any way identical with or colourable imitation of the plaintiff's registered trademark WOODS; also granting permanent injunction restraining defendants by themselves, their servants or agents of any one claiming through them from in any manner passing off their agarbathies bearing offending trademark 'WOOD' as and for the celebrated agarbathies of the plaintiff bearing the registered trademark

WOODS either by manufacturing or selling or offering for sale or in any manner advertising the same; directing defendants to surrender to plaintiff the entire stock of unused offending WOOD agarbathi cartons together with blocks and dyes for destruction; directing defendants to render a true and faithful account of the profits earned by it through the sale of the offending agarbathies bearing offending trademark WOOD and directing payment of such profits to plaintiffs for the passing off committed by defendants and directing the defendants to pay to the plaintiff the cost of the suit.

For Plaintiff : Mr.S.Diwarhar

For Defendants : set exparte

JUDGMENT

This is a suit complaining of infringement of a registered trade mark and passing off.

2 The nucleus of this suit is a registered trademark. The registered trademark is 'WOODS'. To be noted, this is a word mark. This word mark 'WOODS' has been registered vide Trademark No.432777 and its Proprietor is N.Rangarao and Sons Private Limited, which is the plaintiff company in this suit. The date of registration is 24.01.1985. The registration has been renewed from time to time and last such renewal was on 24.1.2016. This registration is valid upto 24.01.2026. In other words, the registration of the registered trademark, i.e., the word mark 'WOODS' is subsisting as of today. To be noted, the registration is in Class 3 and the goods are Agarbathies and Dhoop (Incense). This registered trademark, i.e., Trademark

No.432777, the details of which have been set out herein, is hereinafter referred to as 'said trademark' for the sake of brevity, convenience and clarity.

3 As would be evident from the details of the registration set out supra, the said trademark pertains to Agarbathies and Dhoop (Incense). The said trademark is being used by the plaintiff for the aforesaid product. The complaint in this suit by plaintiff is that a similar and deceptive trademark 'WOOD' is being used by the sole defendant, for the same product, i.e., Agarbathies and Dhoop (Incense). In this background, I deem it appropriate to refer to the product as 'Incense sticks' for the sake of convenience and clarity.

4 At the risk of repetition, for the sake of abundant clarity, it is made clear that the nucleus of this suit is the 'said trademark' and product which is the epicentre of this suit is 'Incense sticks'.

5 The plaintiff was originally a partnership firm in the name and style M/s.N.Ranga Rao & Sons. Subsequently, I am informed that all partners of this firm formed a company in the name and style 'N.Ranga Rao & Sons Private Limited' and I am also informed that the said company was incorporated on 23.12.2014. To be noted, as mentioned supra, N.Ranga Rao & Sons Private Limited is the plaintiff herein. Post incorporation of plaintiff company on 23.12.2014 as aforesaid, I am informed that there was a business succession agreement dated 18.3.2015, wherein and whereby the business of the aforesaid firm, i.e., M/s.N.Ranga Rao & Sons was transferred to the plaintiff company. The transfer of business, to be noted, includes transfer of all rights in the said trademark. Further to be noted, even as per

the certificate of registration for the said trademark, the Proprietor is plaintiff company.

6 It is submitted by Mr.S.Diwahar, learned counsel for plaintiff that post business succession certificate as aforesaid, change of proprietor's name was also incorporated and recorded in the trademark registration certificate for the said trademark.

7 The suit file placed before me reveals that the sole defendant was duly served and thereafter set ex parte on 10.07.2017.

8 The plaintiff company has averred that they have spent considerable amount of money and have put in enormous effort for promotion of their incense sticks bearing said trademark. It is also the further case of the plaintiff that there has been huge demand for their incense sticks bearing said trademark. The plaint is predicated on the basis that somewhere in the middle of January 2000, the plaintiff company came to know that defendant had commenced using an identical trademark, i.e., 'WOOD' for incense sticks manufactured by defendant. Therefore, this mark, i.e., 'WOOD' used by defendant from January 2000 for incense sticks is hereinafter referred to as 'offending mark' for the sake of convenience and clarity.

9 It is the specific case of the plaintiff that they have registration for the word mark and therefore, the use of similar and highly deceptive offending mark for the same product is a clear case of infringement. It is the further case of the plaintiff as articulated by learned counsel for plaintiff, Mr.Diwahar, in the hearing that the product, i.e., incense sticks, is same and channel of trade is also same. Further more, the purchasers belong to all

strata of society and therefore, deception is inevitable. This according to learned counsel for plaintiff is a indisputable case of passing off and it is submitted that defendant is clearly riding on the popularity of the said trademark of plaintiff company.

10 I now turn to exhibits that have been marked in the instant case.

11 Before looking at the exhibits, it is to be noted that one witness, i.e., P.W.1 was examined on behalf of plaintiff company. That one witness on behalf of plaintiff company is one Mr.V.Ramamoorthy, who is described as Associate Regional Manager, Tamil Nadu of plaintiff company. Four exhibits have been marked on behalf of the plaintiff and all four exhibits have obviously been marked through P.W.1.

12 Ex.P.1 is the letter of authorisation authorising aforesaid P.W.1 to depose and also represent the plaintiff company and do all that is necessary for furthering the instant suit. This letter of authorisation is in turn based on a Board resolution dated 24.12.2014. An extract of the minutes of Board of Directors of plaintiff company held on 24.12.2014 has also been annexed to the letter of authorisation. This much about Ex.P.1 With regard to Ex.P.2, this is the trademark registration certificate for the said trademark, of which the plaintiff company is the Proprietor. I have already set out details of the said trademark including registration details supra. Be that as it may, what requires to be noticed is that the plaintiff has marked the trademark registration certificate given in Form O-2 which in trademark registry parlance is referred to as O2 certificate.

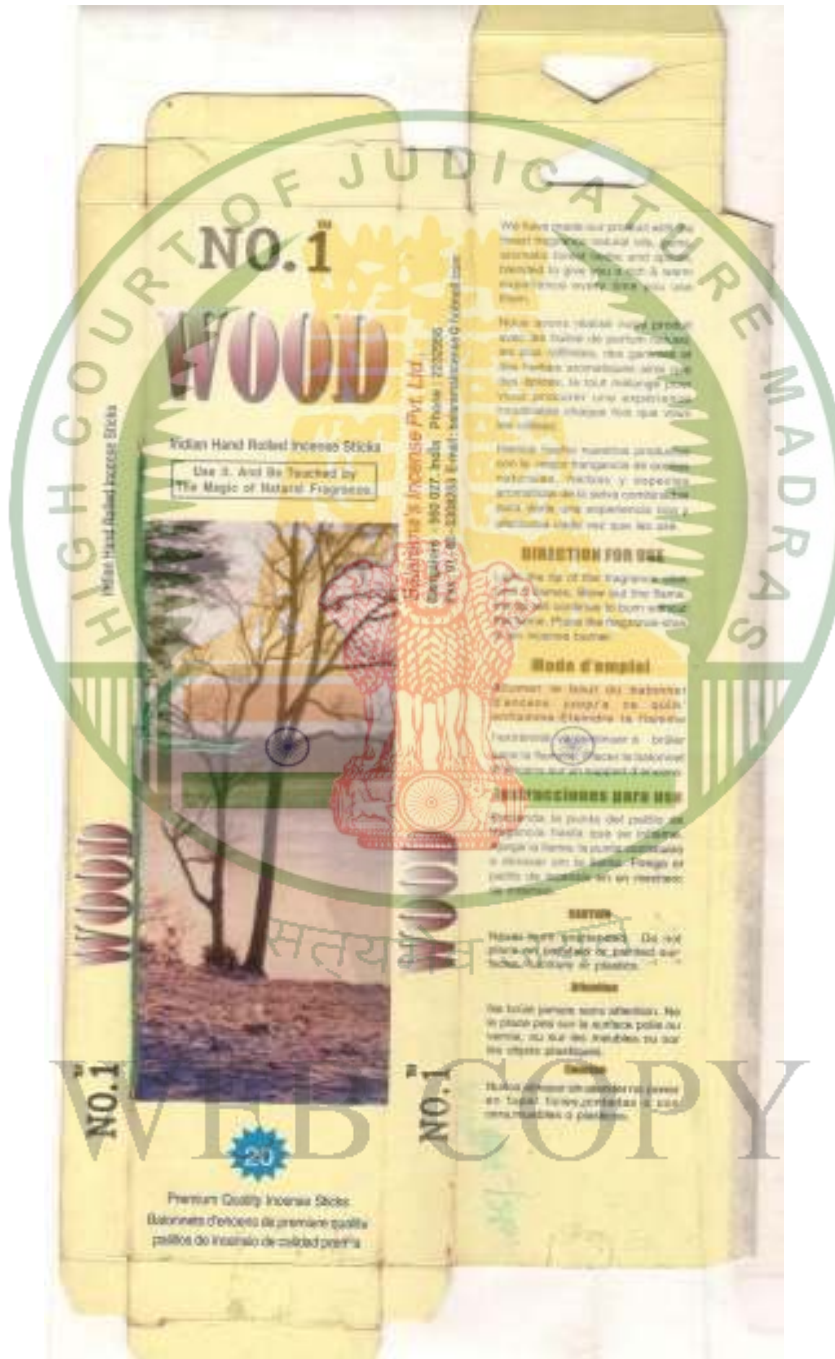
13 To be noted, there are certain restrictions with regard to use of this O2 certificate in legal proceedings. Such restriction is traceable to Rule 62(2) of Trade Mark Rules, 2002. I deem it appropriate to extract the said rule which reads as follows :

“62.Certificate of registration.-- (1) x x x x x x

(2)The certificate of registration referred to in sub-rule (1) shall not be used in legal proceedings or for obtaining registration abroad.”

14 However, there is also a judgment of this court (regarding courts looking into O2 certificate) rendered by a learned Single Judge of this court being **B.Kishore Jain Vs. Navaratna Khazana Jewellers** reported in **2007 (4) MLJ 1022**. I am not delving further into this aspect of the matter as this matter is not contested and also because the plaintiff has filed the legal use certificate also along with the O2 certificate. The legal use certificate is intended to be used for legal proceedings as the name itself suggests. In fact, this certificate goes by a suitable caption too in this regard. At this moment, I do not express any opinion one way or the other on the principle laid down in **Navaratna Khazana Jewellers** and I reserve my views for matter where there is contest. Suffice to say that Ex.P.2 consists of O2 certificate as well as legal use certificate and therefore, I deem it appropriate to refer to Ex.P.2 as Ex.P.2 series. Thereafter, the plaintiff company has marked one of its cartons as Ex.P.3 in which incense sticks are sold, wherein the said trademark 'Woods' is prominently depicted. The said carton is as follows :

15 The plaintiff company has also marked Ex.P.4, a carton, in which according to them the defendant's incense sticks are sold with the offending trade mark, i.e., 'Wood' and the same is as follows :



16 With regard to aforesaid two marks, I am not embarking upon comparison qua essential features, over all similarity, etc., because this is a case of infringement of word mark per se, wherein depiction of mark takes a back seat. In any event, as far as the said trademark is concerned, there is hardly any difference. Both words are written in the same manner. However, to be noted, the said trademark is 'WOODS' and offending trademark is 'WOOD'.

17 What is most important is, the product is same, i.e., incense sticks. More importantly, as alluded to supra, the channel of trade is same.

18 In the light of the discussion and narrative supra, I have applied my mind to the suit file that has been placed before me which includes pleadings, deposition and documents, i.e., Exhibits. I have also given my careful consideration on the submissions made by learned counsel for plaintiff. On a careful analysis of the suit file and submissions made before me, I have no hesitation in coming to the conclusion that this is a clear case of infringement for the reasons set out supra. With regard to passing of action also, which is common law remedy, I have no difficulty in coming to the conclusion that the defendant has in fact committed passing off, as the product is same and channel of trade is same, more so, when end users come from all strata of society.

19 With regard to deposition of P.W.1, which is by way of proof affidavit dated 3.8.2017, it is largely reiteration of pleadings as contained in the plaint. However, the deposition remains unchallenged. Notwithstanding the fact that deposition remains unchallenged, I have perused the proof

affidavit and I find that the evidence is cogent, clear and convincing. With regard to exhibits, I have already discussed supra and legal principles also have been discussed supra.

20 In all these perspectives of the matter, the plaintiff is entitled to a decree as prayed for qua infringement of the said trademark and passing off. Now I turn to the other limb of the prayers in the plaint.

21 Besides the prayer for injunction qua infringement of the said trademark and injunction qua passing off, there are four other limbs of the prayer. One limb pertains to a direction to defendant to surrender the entire stock of unused cartons carrying / containing the offending trademark. The 4th limb of the prayer is for rendition of accounts. While the 5th limb of the prayer is for costs, the 6th limb is a residuary prayer.

22 In the light of the discussion and the conclusion supra with regard to first and second limbs of prayer, it follows indisputably as a sequitur that the plaintiff is entitled to a direction for surrendering of offending trademark as well as a direction for rendition of accounts. Considering the trajectory of the suit and considering the fact that the plaintiff company has been constrained to carry this suit through for over one and a half decades, I have no hesitation in holding that the plaintiff company is entitled to costs of the suit.

23 With regard to the residuary limb of the prayer, as I have already acceded to the prayer for rendition of accounts, if the plaintiff pursues the matter further and if the plaintiff decides to claim damages, it is made clear that plaintiff will be entitled to do so based on this decree.

24 To put it in a nutshell, in sum and substance, this suit is decreed with costs.

25.01.2018

Index : Yes

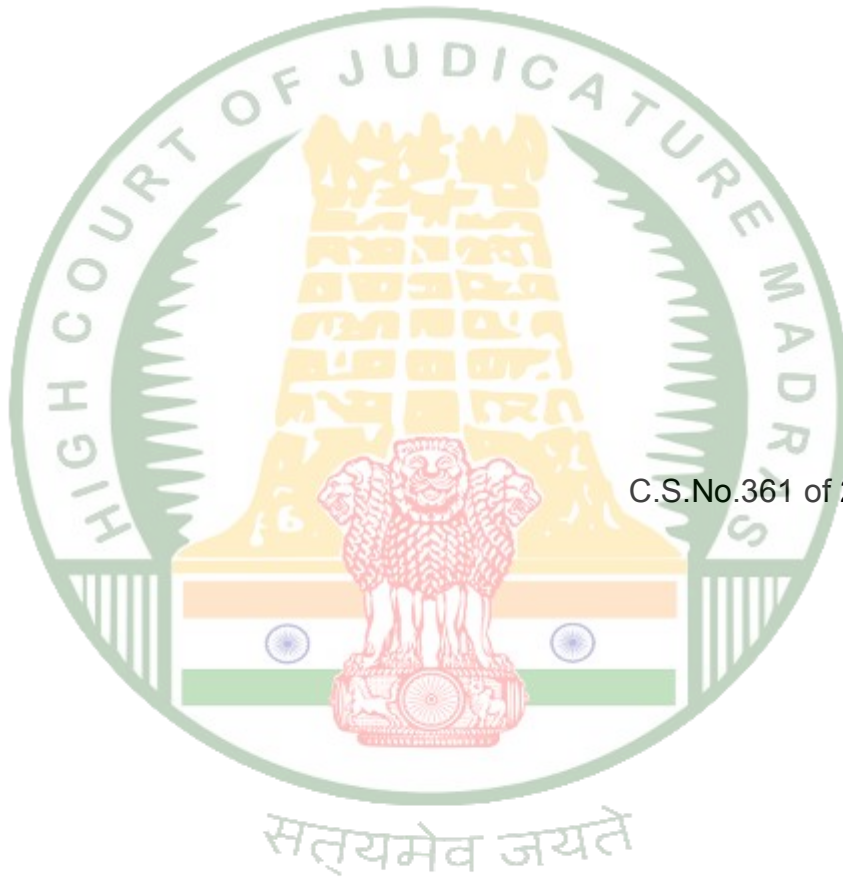
vvk



WEB COPY

M.SUNDAR, J.

vvk



C.S.No.361 of 2000

WEB COPY

25.01.2018