

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 05.02.2018

Date of Decision : 01.03.2018

CORAM

THE HON'BLE MR.JUSTICE M.SUNDAR

C.S.No.1045 of 2010

M/s.Ultra Tile Pvt. Ltd.,
New No.11, Old No.54,
Jawaharlal Nehru Road,
1st Avenue, Ashok Nagar,
Chennai-600 083.

.. Plaintiff

Vs.

Shri Ganesh Tiles & Granites,
678/1581, B.B.Road,
Near Police Station,
Yelahanka,
Bangalore-560 064.

.. Defendant

This Civil Suit is preferred, under Order IV Rule 1 of Original Side Rules read with Order VII Rule 1 of CPC and Sections 134 and 135 of the Trade Marks Act, 1999 seeking permanent injunction restraining the defendant above named by themselves, their servants or agents or anyone claiming through them in any manner infringing the plaintiff's registered trademark 'ULTRA' by using the offending trademark 'ULTRA' or any other marks or marks which are in any way identical, similar or deceptively similar in colourable imitation of the plaintiff's registered trademark "ULTRA"; permanent injunction restraining the defendant by themselves, their servants or agents or anyone claiming through them from in any manner passing off their tiles as that of the plaintiff's by using the offending trademark 'ULTRA' or any other trademark which is similar or deceptively similar to that of plaintiff's

trademark 'ULTRA' either by manufacturing or selling or offering for sale or in any manner advertising the same; directing the defendant to surrender to the plaintiff the entire stock of unused offending trademark 'ULTRA' together with the blocks and dyes, name boards, signboards etc. for destruction; directing the defendant to render a true and faithful account of the profits earned by them through the sale of the offending tiles bearing the offending trademark 'ULTRA' and directing payment of such profits to the plaintiff and directing the defendant to pay to the plaintiff the costs of the suit.

For Plaintiff : Mr.A.Prasanna Venkat
of M/s.APR Associates

For Defendant : set ex parte

JUDGMENT

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

2 The nucleus of this suit are two registered trademarks. The registered trademarks are 'ULTRA' with a logo and word mark 'ULTRA'. The trademark with logo is as follows :



The aforesaid marks have been registered vide Trademark Nos.700620 and 700622 dated 28.03.2002 and 15.03.2002, both in Class 19. Registration of the trademarks have been renewed from time to time, and are valid. In other words, the registration of the registered trademarks are subsisting as of

today. To be noted, the registration is in Class 19 and the goods are Ruffing Tiles, flat tiles, ridges, ceramic tiles, polished terrazo tiles, clading tiles, clay bricks, building materials and all other goods being included in Class 19. Registrations and renewals have been marked as Exs.P.3 to P.6 .

3 As would be evident from the details of the registration set out supra, trademark 'ULTRA' pertains to tiles. The trademark 'ULTRA' is hereinafter referred to as 'said trademark' for the sake of convenience and clarity. 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 'ULTRA' is being used by the sole defendant, for the same product, i.e., Tiles.

4 Mr.A.Prasanna Venkat of M/s.APR Associates, learned counsel, appearing on behalf of the plaintiff submits that the plaintiff is a manufacturer of all kinds of floor, wall, roof and other tiles and slabs made up of cement and other allied products from the year 1994. It is further submitted by plaintiff that there is good demand for their products in the market. The plaintiff has adopted the name 'ULTRA' as their trade name and has been continuously using the same name from 1994. They have registered the said trademark as alluded to supra is his further say.

5 Learned counsel for the plaintiff has further submitted that during the course of business, the plaintiff came to know that the defendant is marketing their product, i.e., Tiles, using plaintiff's said trademark, illegally. Defendant should not use the plaintiff's said trademark either independently or in association with other words, such as 'Ganesh' is his further submission.

6 The suit file placed before me reveals that the sole defendant was duly served and thereafter set ex parte on 12.10.2015.

7 The plaintiff has averred that they have spent considerable amount of money and have put in enormous effort and time for developing the unique design for their product under the said trademark. It is further submitted that the said trademark has become very popular among public. The plaintiff has been maintaining a very good standard for their product. It is the further submission of plaintiff that they have spent considerable amount towards advertisement of their product.

8 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, in the hearing that the product, i.e., Tiles, is same and channel of trade is also same. Further more, the purchasers belong to all strata of society and therefore, deception is inevitable is his say. 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.

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

10 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.A.Prabhu, who is described as Accounts Executive of the plaintiff. Nine exhibits have been marked on behalf of the

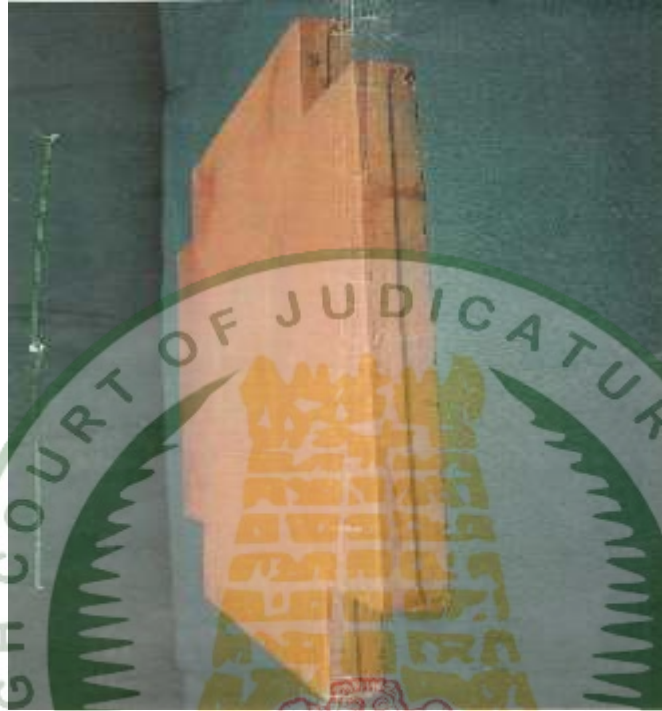
plaintiff and all nine exhibits have obviously been marked through P.W.1. I am informed that plaintiff put one G.Masilamani, Accounts Manager in the witness box but ultimately examined A.Prabhu owing to some internal rearrangement in plaintiff company.

11 Ex.P.1 (series) are the extract of minutes of the resolution passed in the Board Meeting of the company held on 28.11.2015, authorizing Mr.G.Masilamani to represent the company before the Court and letter of authorisation dated 3.6.2016 authorising Mr.A.Prabhu to represent and depose before the Court. To be noted, the aforesaid authorisations have been marked as Ex.P.1 and considering that there are two authorisation letters, Ex.P.1 is referred to in this order as Ex.P.1 (series).

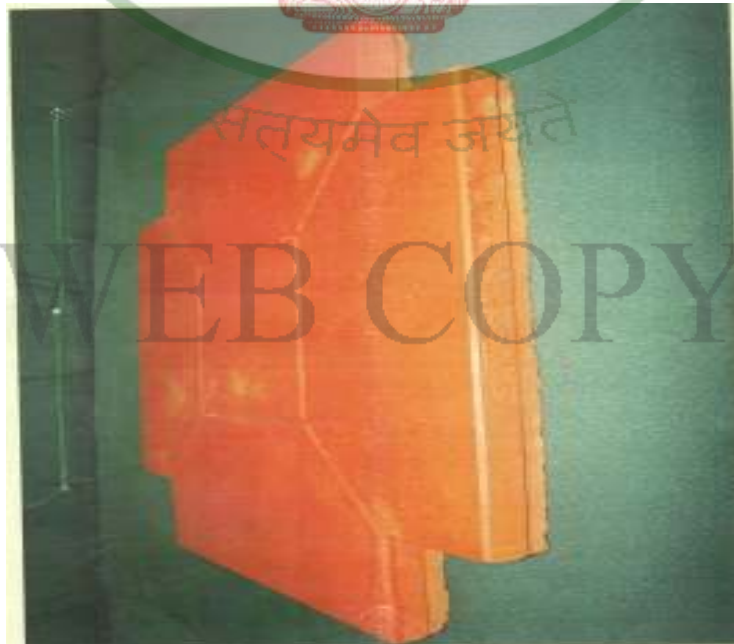
12 Original brochures of plaintiff's company has been marked as Ex.P.2, wherein various tiles of plaintiff's products have been shown. Registration certificate of trademark No.700620 with logo has been marked as Ex.P.3. Renewal of the said trademark has been marked as Ex.P.4. Ex.P.5 is the Certificate of Registration of trademark No.700622 for the word mark 'ULTRA'. The communications dated 16.6.2010 and 10.04.2016 received from the Trade Mark Registry renewing the trademark No.700622 have been marked as Ex.P.6. In other words, the registrations and renewals of the two trade marks have been marked as Ex.P.3 to Ex.P.6 as alluded to supra. A bill dated 23.10.2010 for purchasing defendant's product has been marked as Ex.P.7.

13 Thereafter, the plaintiff company has marked a photograph of one of its tiles carrying their trademark as Ex.P.8, wherein the said trademark

'ULTRA' is prominently depicted. The said photograph is as follows :



14 The plaintiff has also marked Ex.P.9, a photograph of one of the tiles of defendant with the offending trademark and the same is as follows :



15 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 'ULTRA' and offending trademark is 'GANESH ULTRA'.

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

17 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.

18 With regard to deposition of P.W.1 (Mr.A.Prabhu), which is by way of proof affidavit dated 3.6.2016, it is largely a 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.

19 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 limbs of the prayers in the plaint.

20 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 offending trademark 'ULTRA' together with the blocks and dyes, name boards, signboards for destruction. 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.

21 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 blocks, dyes, name boards, signboards, etc., pertaining to offending trademarks 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 a period of seven years, I have no hesitation in holding that the plaintiff is entitled to costs of the suit.

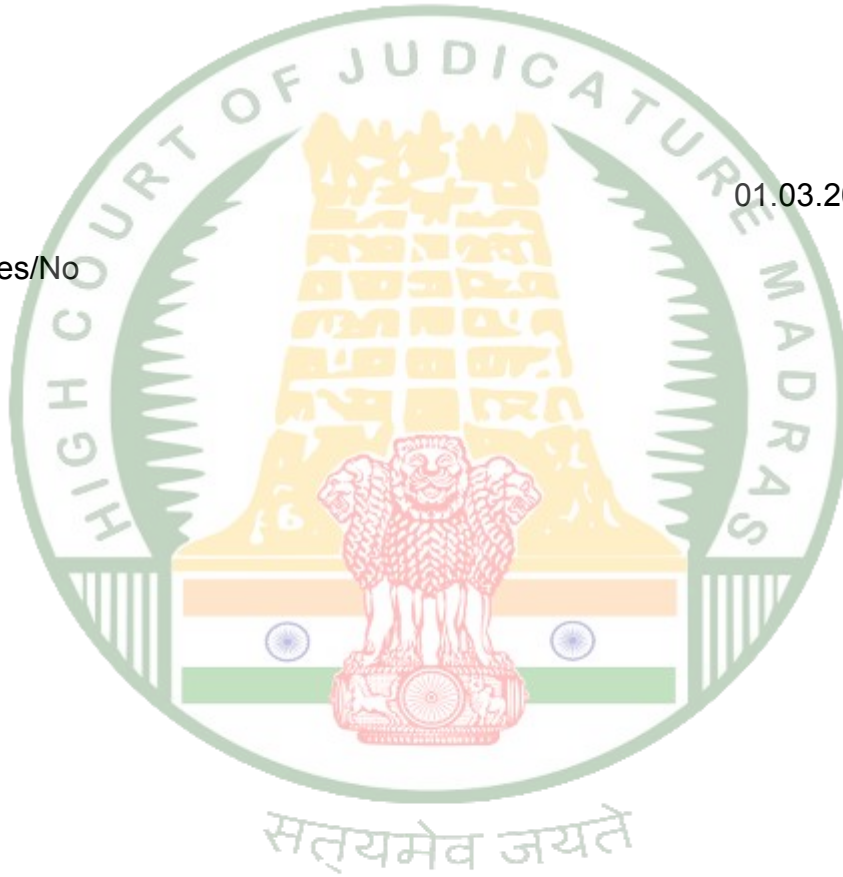
22 With regard to the residuary limb of the prayer, as I have already acceded to the prayer for rendition of accounts, if the plaintiff pursues

the matter further and if the plaintiff decides to claim damages post rendition of accounts and quantification, it is made clear that plaintiff will be entitled to do so based on this decree.

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

Index : Yes/No

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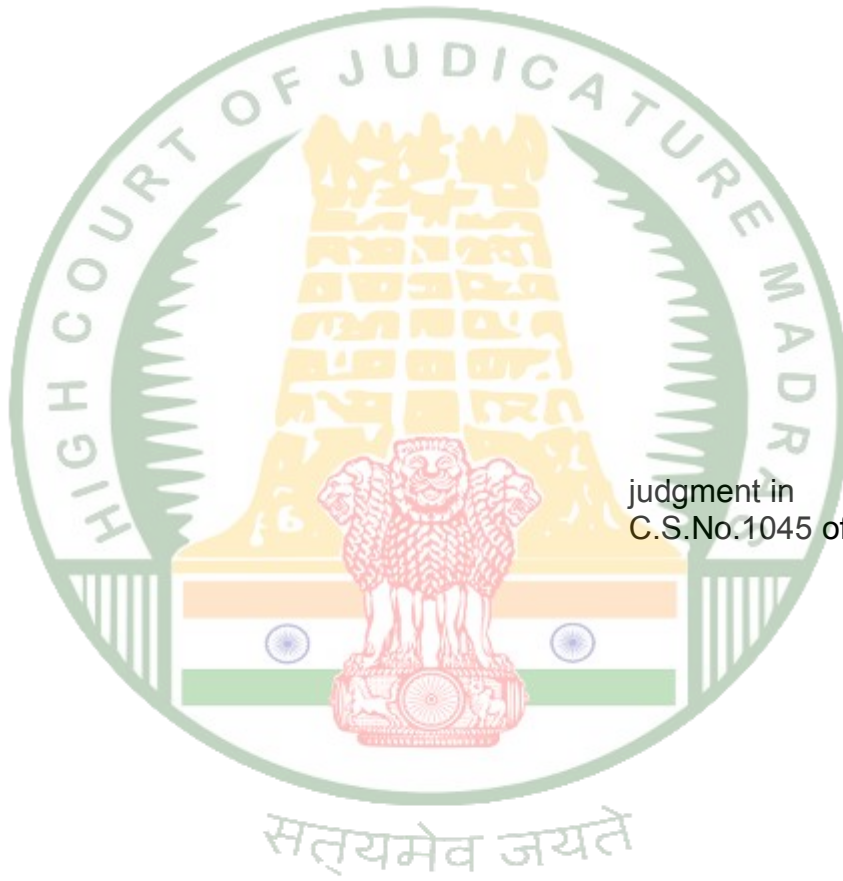


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M.SUNDAR, J.

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