

Application Nos.1164 & 1165 of 2019

in

C.S.No.725 of 2011

KRISHNAN RAMASAMY, J.,

The sole plaintiff is the applicant is the aforesaid Applications.

2. The suit has been filed by the applicant/plaintiff for the following reliefs:

(a) permanent injunction restraining the defendants, by itself, its partners, men, servants, agents, representatives or any one claiming through them from in any manner infringing the plaintiff's registered trademark "KG" under No.1267985 in class 37 by using the trademark "KG5" or any other mark deceptively similar to the plaintiff's trademark "KG" or in any other manner whatsoever;

(b) permanent injunction restraining the defendants, by itself, its partners, men, servants, agents, representatives or any one claiming through them form in any manner passing off and/or enabling others to pass off the defendants' services of construction and real estate activities as and for the plaintiffs' services by using, selling, or offering to sell, distributing, displaying, printing, advertising their services bearing the trademark "KG5" or any other mark deceptively similar to the plaintiff's trademark "KG" or in any other manner whatsoever;

(c) the defendants be ordered to surrender to plaintiff for destruction of all products, labels, dyes, blocks, moulds, screen, prints, packing materials, and other materials bearing the trademark "KG5" deceptively similar to plaintiff's trademark KG;

(d) a preliminary decree be passed in favour of the plaintiff directing the defendants to render account of profits made by use of trademark "KG" with respect to construction activities and a final decree be passed in favour of the plaintiffs for the amount of profits thus found to have been made by the defendants after the latter have rendered accounts;

(e) the defendants be ordered and decreed to pay to the plaintiffs a sum of Rs.10,00,000/- as damages for acts of infringement of trademarks and passing off committed by the defendants by using the trademark "KG5".

3. Pending disposal of the suit, the applicant/plaintiff has filed the present ApplicationS for the following reliefs:

S.Nos.	Application Nos.	Reliefs
1	Application No.1164 of 2019	To stay all proceedings of the instant suit till the disposal of the rectification petitions to be filed before the Hon'ble Intellectual Property Appellate Board.
2	Application No.1165 of 2011	To frame an issue as to whether the plaintiff's registration of trademark KG under Nos.2224503 in Class 37, 2224504 in Class 37 and 2224505 in Class 36 in Class is valid in view of the plaintiffs claim of prior user of the trade mark KG.

4. The learned counsel appearing for the applicant submitted that the applicant/plaintiff filed the suit in C.S.No.725 of 2011 for infringement of their registered trademark KG and passing off of the defendants' services under the trademark 'KG5', which is deceptively similar to that of the applicant's trademark 'KG'. He would also submit that in the above suit, the defendants filed the written statement, in which, they had stated that they have registered three trademarks under Nos.2224505 in Class 36 for KG realtors; 2224504 in Class 37 for KG realtors and 2224503 in Class 37 for the trademark KG.

5. He further contended that the applicant has been using the trademark 'KG' much before the use of respondents trademark 'KG5' and therefore, the subsequent registration of the respondents trademark 'KG5' deserves to be rectified/cancelled. He would further contend that in the suit, the trial is yet to commence and the defendants are seeking to rely upon the registration certificate of their trademark KG5. Therefore, he stated that the suit is ought to be stayed by virtue of Section 124 of the Trademarks Act, 1999 and an issue has to be framed by this Court.

6. The learned counsel appearing for the respondents submits that the Court may pass appropriate orders, as prayed.

7. Considering the submission of the learned counsel appearing for the applicant and the respondents and having been satisfied with the reasons stated in the affidavit filed in support of these Applications and this Court is inclined to allow these Applications. Accordingly, in A.No.1164 of 2019, there shall be an interim stay of the instant suit till 14.10.2019, so as to enable the applicant to file appropriate Application for rectification and this Court frames the following additional issue in Application No.1165 of 2019:-

"(a) Whether the defendants' registration of trademark KG under Nos.2224503 is Class 37, 2224504 in Class 37 and 2224505 in Class 36 in Class is valid in view of the plaintiff's claim of prior user of the trademark KG?"

8. Post the matter before this Commercial Division on 14.10.2019.

9. The learned counsel for respondents submitted that in the prayer in Application No.1165 of 2019, the plaintiff has wrongly mentioned that whether the **plaintiff's** registration of trademark KG under Nos.2224503 is Class 37, 2224504 in Class 37 and 2224505 in Class 36 in Class is valid in view of the plaintiff's claim of prior user of the trademark KG. Therefore, the word 'plaintiff'

in the prayer may be read as whether the **defendants'** registration of trademark KG under Nos.2224503 is Class 37, 2224504 in Class 37 and 2224505 in Class 36 in Class is valid in view of the plaintiff's claim of prior user of the trademark KG?

10. Registry is directed to carry out the aforesaid correction in the prayer in Application No.1165 of 2019.

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06.06.2019



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KRISHNAN RAMASAMY, J.,

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