

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated : 06.09.2019

Coram

The Honourable Mr.Justice N.SATHISH KUMAR

C.S.No.490 of 2011

1.Mr.T.Chitty Babu

2.M/s.Akshaya Pvt. Ltd.,
No.22, 2nd Street, Nehru Nagar,
Adyar, Chennai – 600 020.

...Plaintiffs

Versus

1.M/s.Sakthivel Builders,
Plot No.10, Door No.5, 1st Floor,
Sriram Nagar, (North),
Mudichur Road, West Tambaram,
Chennai – 600 045.

2.M/s.Lodha Housing Development Ltd.,
Plot No.10, Door No.5, 1st Floor,
Sriram Nagar, (North),
Mudichur Road, West Tambaram,
Chennai – 600 045.

...Defendants

This suit is filed under Order IV Rule 1 of O.S.Rules r/w. Order VII Rule 1 of Code of Civil Procedure Sections 27, 28, 29, 134 & 135 of the Trade Marks Act, 1999 for the following reliefs:

(a) A permanent injunction restraining the defendants, their men, servants, agents, distributors, stockists, successors in business, retailers, legal representatives, assigns or any other person claiming through or under them, from in any manner using or otherwise dealing with the trademark Sakthivel Builders logo or the SB logo amounting to infringement of the 1st plaintiff's registered trademark AH logo under No.1273023 in Class 37 or any mark similar to 1st plaintiff's registered trademark or in any other manner whatsoever;

(b) A permanent injunction restraining the defendants, their men, servants, agents, distributors, stockists, successors in business, retailers, legal representatives, assigns or any other person claiming through or under them, from in any manner using, advertising, promoting in newspapers or in websites or otherwise dealing with the deceptively similar trade mark Sakthivel Builders logo or SB logo thereby passing off their services/business as and for the services/business of the plaintiffs or in any other manner whatsoever;

(c) The defendants be ordered to pay to the plaintiffs, a sum of Rs.1,00,000/- as damages for committing infringement of trademark and passing off its services/business as and for the plaintiffs' services/business under the mark AH logo';

(d) The defendants be ordered to surrender to the plaintiffs for destruction, all name boards, hoardings, invoices/bills, brochures, pamphlets, prints, dies, blocks, moulds and plates, screen prints, packing and advertising material, compact disks, hard disks and/or any other storage devices and any other material in the defendants'

possession, which bears and/or contains the trademark Sakthivel Builders logo or SB logo;

(e) A preliminary decree be passed in favour of the plaintiffs directing the defendants to render account of profits made by use of the almost identical/deceptively similar trademark Sakthivel Builders logo or SB logo amounting to infringement of the 1st plaintiff's registered trademark and/or passing off 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;

(f) For costs of the suit.

For Plaintiffs : Ms.Durga Bhatt

For Defendants : Mr.J.Kalidas

J U D G M E N T

The present suit has been filed by the plaintiffs for the reliefs morefully described in the prayer portion of this judgment.

सत्यमेव जयते

2.1. The brief facts of the case reads as follows:

The first plaintiff is a skilled engineer and a renowned real estate business man involved in the business spaces at various places all over the State of Tamil Nadu. The first plaintiff started his construction concern in the year 1995 under the umbrella mark

AKSHAYA and gained tremendous goodwill and reputation. In the year 2000, the first plaintiff started a proprietary concern under the name and style of AKSHAYA HOMES. Subsequently, in the year 2005, the first plaintiff also started a Private Limited Company under the name and style of Akshaya Pvt. Ltd., the second plaintiff. The first plaintiff is the Chairman & Managing Director of the second plaintiff Company. Both the first plaintiff's proprietary concern and the second plaintiff's Private Limited Company are functioning simultaneously under the mark AKSHAYA.

2.2. The plaintiffs were also conferred with Integrated "ISO 9001:2008", "ISO 14001:2004", "OHSAS 18001:2007" for Management Systems which has been conferred only to 11 companies all over India and their products are constructed, marketed and developed under the brand name AKSHAYA. The plaintiffs' trademark 'AH' logo consisting the following artistic features:

- (a) An orange and black colour combination,
- (b) Letters "A" and "H" are written in artistic manner in Orange and Black colours respectively.

(c) Below the said letters, the words AKSHAYA HOMES is written in black lettering on an orange strip with black bordering at the bottom.

2.3. In the course of their regular business, the plaintiffs adopted various trademarks and with a view to get statutory protection, has applied for and/or obtained registration in respect thereof in various classes. A list of trademarks registered in the name of the plaintiffs are mentioned hereinbelow

Trademark	Date	Proprietor	Reg.No.	Class	Goods
AS logo (Akshaya Structurals)	16.03.2004	T.Chitty Babu	1273022	37	Building Construction Services
'AH' logo (Akshaya Homes)	16.03.2004	T.Chitty Babu	1273023	37	Building Construction Services
AF logo (Akshaya Foods)	16.03.2004	T.Chitty Babu	1273024	42	Providing of Foods & Drink included in Class 42
AKSHAYA UNCOMPRO MISE	27.11.2009	Akshaya Pvt. Ltd.,	1889332	37	Providing of Building and Construction Services
AKSHAYA PRIVATE LIMITED	27.11.2009	Akshaya Pvt. Ltd.,	1889333	37	Providing of Building and Construction Services

Trademark	Date	Proprietor	Reg.No.	Class	Goods
AKSHAYA	27.11.2009	Akshaya Pvt. Ltd.,	1889334	37	Providing of Building and Construction Services

2.4. The first plaintiff has allowed the second plaintiff to use the trademarks that were registered in his individual name and as such the second plaintiff is the licensed/permitted user of the trademarks in the name of the first plaintiff.

2.5. The plaintiffs have been openly, continuously, extensively and exclusively using the trademark/brand name AKSHAYA HOMES and the unique and distinctive 'AH' logo since 2000. The plaintiffs' business and their trademark 'AH' logo is well known among the trade and public.

2.6. While so, the plaintiffs came to know that the defendants have entered into construction business with an almost identical/deceptively similar logo as that of the plaintiffs' well-known and registered trademark 'AH' logo. The defendants have adopted the logo under the name and style of Sakthivel Builders. The defendants' logo is almost identical/deceptively similar to that of the

plaintiff's logo. The defendants have not only copied the stylized script adopted by the plaintiffs in respect of their 'AH' logo but also copied the orange and dark blue/black color scheme adopted by the plaintiffs. The manner of writing of the logo by the defendants is with the sole object to project the defendants' logo as if it is the plaintiffs' logo or that the defendants are associated with the plaintiffs in the course of trade. An ordinary person with imperfect memory would not be able to make out difference between the plaintiffs' logo and defendants' logo, especially, as both bear identical colour scheme, identical stylized script and have visual similarity. The defendants have deliberately adopted the identical logo with the identical colour scheme, get up only with a view to pass off their services as and for the plaintiffs' well reputed building services established since the year 1995. Since the plaintiffs and the defendants are involved in the construction business, the logos are prominently displayed in the buildings on the top, a person viewing a logo from a distance is bound to mistake the defendants' logo as and for the plaintiffs' logo.

2.7. The plaintiffs issued a Legal Notice dated 29.06.2011, to the defendants requesting them to stop using the 'SB' logo forthwith in respect of any advertisements and promotions campaigns. However, the defendants have given advertisements in various English Daily Newspapers in respect of a new property that they are jointly developing at Gandhi Nagar under the almost identical/deceptively similar trademark 'SB' logo. Hence, left with no other alternative, the plaintiffs have filed the present suit.

3.1. The defendants have filed their written statement, wherein, they have stated that the defendants' trademark is not identical or similar to that of the plaintiffs' trademark since the name of the defendants being Sakthivel Builders they have adapted the 'SB' logo, and that the said 'SB' logo is entirely different from 'AH' logo of the plaintiffs either in shape or in colour and no ordinary prudent man will be misled by the defendants' logo enabling passing off. The defendants would further contend that the defendants have never come across the trademark of the plaintiff and it is only the maker of the logo who has styled the script of 'SB' logo in a different manner so as to catch the eye of the public. They

would also contend that the plaintiffs' logo is made in such a manner that both the letters 'A' and 'S' have been joined at the bottom, whereas, the defendants' logo 'SB' is separately written in style letters.

3.2. The defendants stated that the defendants have already developed their business even before using their logo 'SB' and that they have constructed only one building in Mudichur Road after getting the 'SB' logo registered. He further submitted that the defendants started using the 'SB' logo only after getting the logo registration No.2175816 (provisional) in Government of India Trade Marks Registry.

4. By order dated 03.02.2015, this Court framed the following issues for trial:

1. *Whether the defendants are liable for acts of infringement of the plaintiff's trademark 'AH' logo?*

2. *Whether the defendants are liable for passing off their services/business as and for the services/business of the plaintiffs' trademark 'AH' logo?*

3. *Whether the plaintiffs are entitled to the relief of damages as prayed for?*

4. *Whether the plaintiffs are entitled to an order of delivery up as prayed for?*

5. *Whether the plaintiffs are entitled for a preliminary decree for rendition of accounts of profits as prayed for?*

6. *To what other relief the plaintiffs are entitled to?*

7. *What order as to costs?*

5. When the matter was listed before the learned Additional Master-II, for trial, on the side of the plaintiffs, P.W.1 was examined & 21 Documents viz., Ex.P1 to Ex.P21 were marked and on the side of the defendants, D.W.1 was examined, however, no document was marked.

6. The learned counsel for the plaintiffs would contend that Ex.P3, Registration Certificate for the trademark Akshaya Homes ('AH' Logo) under No.1273023 in Class No.37 along with Trademark Journal Advertisement and Renewal dated 16.03.2004, shows that

the plaintiffs are the registered proprietors of the trademark Akshaya Homes and the logo 'AH'. She would further contend that the defendants' logo "SB" is more identical to that of the plaintiffs' logo 'AH', in color scheme, manner of writing and stylized script, moreover, the plaintiffs and the defendants are involved in the construction business which lead to confusion among the public even educated people may be misled by the similar mark using by the defendants. She would also contend that the plaintiffs are entitled to permanent injunction as prayed for and the defendants are liable to pay the cost of Rs.1,00,000/- (Rupees One Lakh only) for damages.

7. The learned counsel appearing for the defendants refuted that the defendants were not infringing the mark of the plaintiffs for a period of eight years. He would further contend that the defendants' 'SB' logo is also not similar to the plaintiffs' 'AH' logo.

8. In the light of the above pleadings, this Court has to answer the aforesaid seven issues.

9.1. The suit has been filed for the infringement of the plaintiffs' registered trademark 'AH' logo by the defendants. The plaintiffs are the registered proprietors of the trademark Akshaya Homes ('AH' Logo) and they registered the same before the Trade Marks Registry, which is clearly evident from a perusal of Ex.P3 (Registration Certificate for the Trademark Akshaya Homes ('AH' Logo) under No.1273023 in Class No.37 along with Trademark Journal Advertisement and Renewal dated 16.03.2004), Ex.P4 (Registration Certificate for the Trademark Akshaya Uncompromise under No.1889332 in Class No.37 dated 27.11.2009), Ex.P5 (Registration Certificate for the Trademark Akshaya Pvt. Ltd., under No.1889333 in Class No.37 dated 27.11.2009) and Ex.P6 (Registration Certificate for the Trademark Akshaya under No.1889334 in Class No.37 dated 27.11.2009) filed by the plaintiffs.

9.2. The main contention of the defendants is that the defendants' logo 'SB' is not similar to that of the plaintiffs' logo 'AH'. It was also pleaded by the defendants that they have got registered the logo 'SB' vide Registration No.2175816 (provisional) in Government of India Trade Marks Registry, but, no document was

filed by the defendants to that effect.

9.3. On comparing the Ex.P12 (Scanned copy of defendants' 'SB' Logo) with Ex.P13 (Scanned copy of plaintiffs' 'AH' Logo), it is seen that the both the logos are almost identical in colour scheme and get up. Apart from that, it is also seen that both the plaintiffs' 'AH' logo and the defendants' 'SB' logo are written in a similar manner of stylized script, however, the plaintiffs' 'AH' logo has a black bordering at the bottom. It is seen that the defendants have adopted the almost identical color scheme, get up and stylized script of the plaintiffs' registered trademark 'AH' logo. The said similarities between the plaintiffs' logo and the defendants' logo may create a confusion among the ordinary people of less prudence, particularly, the people who are not well-versed in English. Ex.P10 (Newspaper Advertisement dated 18.06.2011, given by the defendants in relation to their project under impugned Mark 'SB' logo in English Daily "The Hindu" (Original)) clearly indicates that the defendants have mentioned that the project has developed by Sakthivel Builders and Lodha Housing Private Limited.

9.4. As discussed above, both the plaintiffs' and the defendants' logos having the identical colour scheme, get up and stylized script. Therefore, both the logos are visually similar in nature. It is pertinent to note that the defendants have changed their 'SB' logo from their erstwhile 'SVB' logo, which is evident from Ex.P16 (Scanned copy of defendants' SVB logo). Ex.P14 (Newspaper Advertisement dated 16.07.2011, given by the defendant for their project under the Mark 'SB' Logo in English Daily 'The Hindu') indicates that the defendants are continuously using the trademark 'SB' logo even after it came to the knowledge of them that the plaintiffs are the registered proprietors of the trademark 'AH' logo.

9.5. It is the contention of the defendants that when the plaintiffs issued a legal notice dated 29.06.2011, to the defendants insisting to stop using the 'SB' logo forthwith and on receipt of the said notice, the defendants tried to meet the plaintiffs, however, the plaintiffs have not come forward to settle the matter. The Newspaper Advertisements given by the defendants has also established the fact that the defendants using the 'SB' logo for their

business purposes. Therefore, the defendants' adoption and usage of the 'SB' logo which is almost identical in colour scheme, get up and stylized script to that of the plaintiffs' registered trademark 'AH' logo, not only amount to infringement of the plaintiffs' registered trademark but also amounts to passing off their services/business as and for the services/business of the plaintiffs' trademark 'AH' logo.

9.6. Apart from that, during Cross Examination, D.W.1 stated that the subject matter 'SB' logo, is used by the defendants for one particular project, in fact, they have used several other logos for each of flats as per their convenience. D.W.1 further stated that the defendants' 'SB' logo was created/designed by some third party and after the receipt of notice from the plaintiffs, the defendants stopped using the said logo.

9.7. As far as damages is concerned, the plaintiffs' counsel vehemently contended that there must pay for the damages which are punitive in nature. However, they failed to prove the actual damage. In support of his contention, she relied on the judgment,

Macleods Pharmaceuticals Ltd., Vs. Procare Laboratories Pvt.

Ltd., reported in **2013 (54) PTC 357**, wherein, the Delhi High Court held as follows:

"11. As regards damage, it was held that damage refers to injury and loss caused to the reputation or trade of the plaintiff and that actual damage need not be proved, possibility of damage is enough."

9.8. Having regard to the above fact, pleadings and evidences of this case, it is crystal clear that the defendants were infringing the plaintiffs' registered trademark, however, now, they stopped using the plaintiffs' trademark. Considering the fact that being the plaintiffs and the defendants are involved in the business of similar nature, the infringement of plaintiffs' registered trademark 'AH' logo and passing off by the defendants are bound to create confusion and deception amongst the customers/general public, this Court is of the view that the plaintiffs proved the suit claim, in respect of prayer (a) & (b) and they are also entitled to the relief of damages. Accordingly, all the issues are answered.

10. In the result, this Civil Suit is decreed as follows:

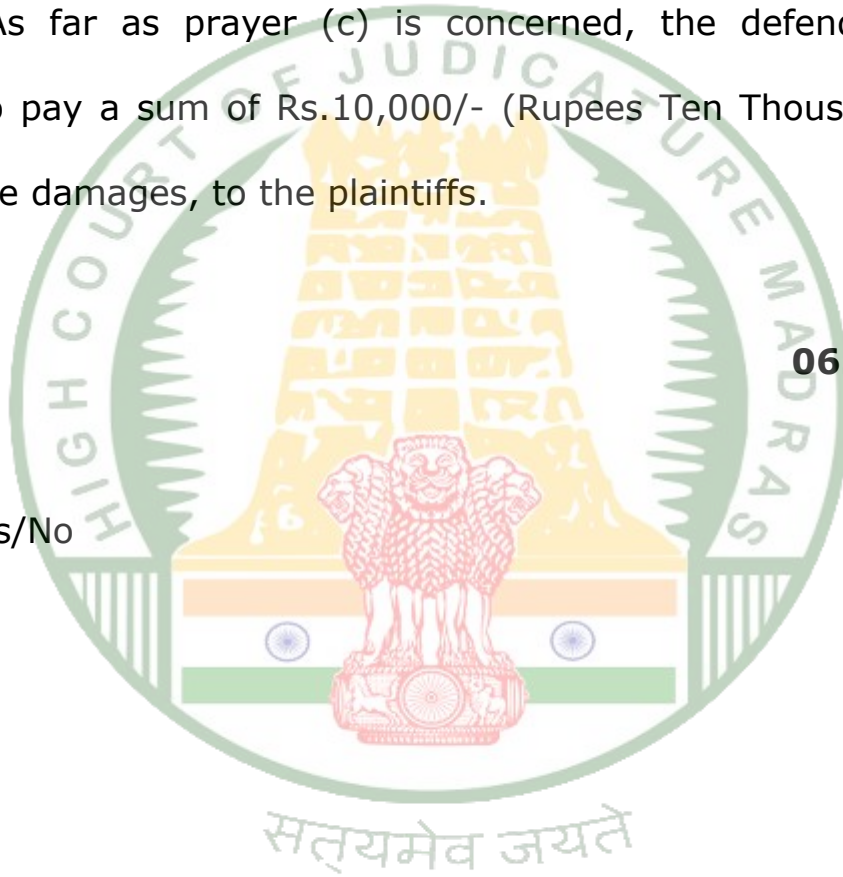
(i) In respect of prayer (a) & (b), this Civil Suit is decreed as prayed for.

(ii) As far as prayer (c) is concerned, the defendants are directed to pay a sum of Rs.10,000/- (Rupees Ten Thousand only) towards the damages, to the plaintiffs.

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