

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 26.07.2019

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THE HONOURABLE **MR.JUSTICE KRISHNAN RAMASAMY**

C.S.No.586 of 2011

Value Invest Wealth Management (India)

Private Limited

rep.by its Director N.Krishnan

No.8 and 9, Sindur Plaza 3rd Floor,

42, Montieth Road, Egmore.

...Plaintiff

Vs.

1.Mr.B.G.Kishore Kumar,

2.Prathima Kishor

3.M/s.Rajshree Capital

rep.by its Partner, B.G.Kishor Kumar

...Defendant

This Civil Suit is preferred under Order VII Rule 1 of CPC, 1908 read with Order IV Rule 1 of OS Rules and under Section 142 of the Trade Marks Act, 1999 prays for judgment and decree against the defendants (a) declaration that the threat made by the defendants to the plaintiff company regarding initiation of legal proceedings for alleged infringement of registered trademark viz., Value Invest registered as Trade mark NO.1601369 with effect from 13.09.2007 vide Trade mark registration

certificate no.900861 dated 06.01.2011 issued by the Trade Mark Registry at Chennai, vide two unsigned cease and desist notices both dated 21.07.2011 issued through its law firm which in turn has acted through its lawyers and IP consultants is a groundless threat; (b) grant a consequential permanent injunction restraining the defendants, their men, their servants, agents, assigns or anybody claiming through, or acting through them in any manner from continuing / giving or making any threat of initiation of action or proceedings for infringement of the registered trademark 'Value Invest' by means of circulars, advertisements, further legal notices or otherwise against the plaintiff Company for using the trademark/trade name 'Value Invest' and Value Invest Wealth Management (India) private limited, either alone or in conjunction with any other trademark or word mark either as part of its name or as words to describe its services; D) and pass such further or other order or orders as the Court may deem fit and proper in the facts and circumstances of the case.

For Plaintiff : Mr.K.Ganesan

For Defendant : No appearance

JUDGMENT

The present suit has been filed by the plaintiff under Section 142 of Trade Marks Act 1999 against the groundless threat from the defendants.

The petitioner is a Company incorporated under the provisions of

Companies Act, 1956 on 19.12.2006 in the name and style of 'VI Value Invest Wealth Management Private Limited' and the said Certificate of Incorporation also filed as Ex.P3. Subsequently the plaintiff changed its name into ' Value Invest Wealth Management (India) Private Limited' and the certificate regarding name change dated 24.12.2008 was marked as Ex.P8.

2. The plaintiff's Company is run by professionals with utmost competence and integrity and they are in the business of financial services inter-alia in advising clients in investments, fund management and portfolio investment etc., The plaintiff has won the prestigious CNBC best financial adviser award for South India continuously for 3 consecutive years from its inception. The plaintiff further submits that they are carrying on business even as on date, though they filed the present suit during the year 2011.

3. Under these circumstances, all of a sudden, to the shock and surprise of the plaintiff, received a Cease and desist notice dated 21.07.2011 from the defendants. The defendants sent a Cease and Desist notice through

their layer to the plaintiff herein. In the said notice, the defendant claimed that they are the proprietor of the registered trademark of 'Value Invest' registered in class 36 for the following services (a) Insurance, (b) Financial affairs (c) Monetary affairs (d) real estate affairs (e) Stock Broking (f) financial planning under Trademark No.1601369 / Ex.P7, Trademark Registration Certificate No.900861 and the URL is www.valueinvest.biz. He sent notice as follows that "cease your attempts to sell or provide services or operate the www.valueinvestonline.com URL and stop using the "Value Invest" trademark anywhere in the name of your Company and to provide us with prompt written assurance that you will stop and desist from further unauthorized uses of the "ValueInvest" mark within 30 days from the date of receipt of that notice.

4. After receipt of such notice from the defendants, the plaintiff has also sent suitable reply and the same is marked as Ex.P22. In the said reply, the plaintiff has refuted the allegations of the defendants stating that the words "Value Invest" are purely descriptive of the business/trade/service. It is not a coined or invented word or mark. It is merely a combination of

two dictionary words which are descriptive of the nature of business/trade/service carried on. Inter-alia on the main ground the registration of defendants' consulting law firm's client's mark is liable to be revoked as stated supra. The plaintiff's Company clearly and categorically stated in the said reply that they have reserved its rights to file appropriate revocation application or any other appropriate application before the Trademark Registry and so called other appropriate authority. After receipt of that reply notice, the plaintiff not at all received any reply from the defendants. However, he apprehends that the defendants may initiate any legal action on the basis of the Cease and Desist Notice. Therefore, he approached this Court by filing this suit for appropriate relief under Section 142 of the Trademarks Act, 1999.

5. After filing of this suit, suit summons were served on the defendants on 19.12.2011. After the services of suit summons, the defendants failed to appear before this Court and the defendants have set exparte by this Court vide order dated 03.07.2019. and on 11.07.2019, on behalf of plaintiff P.W.1 was examined and Ex.s P1 to P22 were marked.

6. Heard learned counsel for the plaintiff.

7. This Court has also perused the averments in the plaint and the proof affidavit and also gone through the Exs.P1 to P22.

8. The plaintiff is the Company incorporated under the provisions of Companies Act in the name and style of " Value Invest Wealth Management (India) Private Limited" during the year 2006. Since the date of incorporation, the petitioner is carrying on business till today. The defendants sent Cease and Desist notice during the year 2011. At the time of sending notice, the defendants are well aware of the plaintiff's name that they are carrying on business with the name 'Value Invest'. However till date, the defendants have not taken any action, after the receipt of the reply notice from the plaintiff for the Cease and Desist notice sent by them. Further the word "Value Invest" is descriptive in nature, it is not a coined and invented word. Further even after the receipt of reply from the plaintiff for the Cease and Desist notice sent, the defendants have not taken any

action against the plaintiff. The defendant is well aware of the said trademark "Value Invest" has been used by the plaintiff for the past 8 years. Therefore, the defendants are estopped from taking any action against the plaintiff.

9. In view of the above, this Court is of the view that plaintiff is certainly entitled for the relief as prayed for in the suit. Further the plaintiff has proved his suit claim and therefore, the suit is decreed as prayed for with costs.

26.07.2019

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Index: Yes/No
Internet: Yes/No

List of Witnesses and Exhibits:

Plaintiff's Side Witnesses:

P.W.1 - Mr.B.V.R.Venkatesh Bapu

Plaintiff side Documents:

Ex.P1- Original Board Resolution dated 10.7.2019.

Ex.P2-Copy of the download from website showing registration of the 1st

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website www.valueinvest.in dated 03.10.2006.

Ex.P3-Copy of the certificate of incorporation dated 19.12.2006 (marked after comparing and verifying with the original).

Ex.P4-Copy of Board resolution regarding name change dated 15.07.2007 (marked after comparing and verifying with the original).

Ex.P5-Copy of Download showing registration of 2nd website in the name and style www.valueinvestonline.com dated 19.01.2008.

Ex.P6-Copy of document according sanction for name change dated 25.07.2008.

Ex.P7-Copy of Minutes of the Extraordinary General meeting of the plaintiff company dated 25.08.2008.

Ex.P8-Copy of certificate issued regarding name change dated 24.12.2008 (marked after comparing and verifying with the original).

Ex.P9-Copy of the trademark registration certificate with regard to trademark 'Value Invest' dated 06.01.2011.

Ex.P10-Copy of 1st purported unsigned cease and desist notice dated 21.07.2011 (marked after comparing and verifying with the original)

Ex.P11-Copy of 2nd purported unsigned cease and desist notice dated 21.07.2011.

Ex.P12-Copy of Envelope in which the 1st purported cease and desist notice was received through courier dated 23.07.2011.

Ex.P13- Xerox copy of envelope in which 2nd purported cease and desist notice, also unsigned and also dated 21.07.2011 was received by plaintiff by RPAD dated 26.07.2011.

Ex.P14-Copy of the download from website showing not less than 91 trademarks with the work 'Value'

Ex.P15-copy of Hard copy of the download from the website www.valueinvest.biz showing depiction of defendants' mark in colour (marked after comparing and verifying with the original).

Ex.P16-Copy of the award ceremony for CNBC Award 2009-10.

Ex.P17-Copy of download from website indiamart defendants' give the name of their company as 'Value Invest'.

Ex.P18 Photograph of receiving award in the first year (marked after comparing and verifying with the original).

Ex.P19-Photograph of receiving award in the second year (marked after comparing and verifying with the original).

Ex.P20-Photograph of receiving award in the third year (marked after comparing and verifying with the original).

Ex.P21-copy of the Board Resolution

Ex.P22-Original Reply Notice with acknowledgment card dated 08.08.2011.

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