

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated : 22.11.2019

CORAM

THE HON`BLE MR.JUSTICE N.SATHISH KUMAR

C.S.No.699 of 2013 &

O.A.Nos.801 & 802 of 2013

M/s.Everest Stabilizers Pvt. Ltd.,
Rep. by its Managing Director,
J.Samson Devanandh
No.3, Kamaraj Salai,
Teynampet, Chennai – 600 002.

... Plaintiff

Vs.

Mr.P.Suresh Kumar,
Proprietor,
M/s.Neverest Marketing,
No.62, Bharathiyar Street,
Vivekananda Nagar,
M.K.B.Nagar, Chennai – 600 039.

.. Defendant

Civil Suit filed under Order IV Rule 1 of O. S. Rules read with Section 62

of the Copyright Act for the following reliefs :

[a] Granting a Permanent Injunction restraining the defendant by himself, his servants, licensees, agents, and distributors or any one claiming through him

in any manner from committing 'infringement of copyright' in the artistic work of the plaintiff's label 'EVEREST' by publishing, distributing, printing the infringed artistic work of defendant's deceptive label 'NEVEREST';

[b] Granting a Permanent injunction restraining the defendant by himself, his servants, agents, distributors or any one claiming through him in any manner from committing 'passing off' his goods 'Stabilizer' and other consumer electronic goods as and for being connected with the business of the plaintiff's mark 'EVEREST' by using the deceptively similar mark 'NEVEREST';

[c] Directing the defendant to surrender to the plaintiff all the unsold 'NEVEREST' stabilizer containing or consisting of the offending packages together with the blocks of dyes used for the purpose of printing the same for destruction;

[d] Directing the defendant to pay the plaintiff the cost of the suit.

For Plaintiff : Mr.R.Satish kumar

For defendant : Mr.K.V.Sundararajan

J U D G M E N T

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This suit has been filed for permanent injunctions restraining the defendant and their men from infringing the registered trademark of the plaintiff

and from 'passing off' of the products of the defendant as that of the plaintiff and direct the defendant to surrender to the plaintiff all the unsold 'NEVEREST' stabilizers containing or consisting of the offending packages together with the blocks or dyes used for the purpose of printing the same for destruction and for costs.

2. The brief facts of the case of the plaintiff is as follows :

It is the case of the plaintiff that the plaintiff are manufacturing and marketing stabilizer and other electrical and electronic products under the brand name 'EVEREST' from the year 1995. The plaintiff company was incorporated as EVEREST STABILIZER PVT LTD in the year 1999. The plaintiff has also filed an application for registration of the trademark in No.941894 in Class 09 claiming user from the year 1995. Thereby, the proprietary rights in the trademark 'EVEREST' in relation to goods stabilizer is now vested with the plaintiff by virtue of continuous user by the plaintiff during the last 18 years. The plaintiff has gained reputation and goodwill and increased his business. The plaintiff has also advertised in various newspapers and periodicals and also it has been advertising during the T.V. Channel programmes. While so, the plaintiff recently came to know that the defendant has introduced a stabilizer under one deceptive mark 'NEVEREST' as like that of the plaintiff's well

established trademark 'EVEREST'. The defendant has filed an application in No.2537995 for his deceptive mark 'NEVEREST' in respect of goods Stabilizer by claiming user from 5th October 2012. The adoption of the deceptively similar mark 'NEVEREST' for the goods Stabilizer in order to look like that of the plaintiff's 'EVEREST' by the defendant proves the reputation and popularity of the plaintiff. Besides the plaintiff also claim copyright infringement. Hence, the suit.

3. The case of the defendant is that the plaintiff has not obtained trademark registration in respect of the trademark 'EVEREST'. Hence, the suit is premature. There are difference between both the plaintiff's and the defendant's mark. The intention of coining the word "NEVEREST" is found in Blue 'Labour Statue' which is in black and the word 'NEVEREST' is found in blue and red combination. There will be no confusion in the mind of buyers . There is also no similarity either phonetically or otherwise between the plaintiff's label and the defendant's label. Further the logo 'EVEREST' is a computer system generated font called 'Algerian' and widely used by general public. Hence, prayed for dismissal of the suit.

4. On the basis of the above pleadings, following issues have been framed :

1. Whether the plaintiff is a 'prior user' of the trademark 'EVEREST' in respect of the goods stabilizers?
2. Whether the defendants label mark 'NEVEREST' is identical with and deceptively similar to the plaintiff's label mark 'EVEREST' in respect of goods stabilizer?
3. Whether the defendant's mark 'NEVEREST' is phonetically similar to the plaintiff's mark 'EVEREST'?
4. Whether the plaintiff is entitled to the relief for 'passing off' action against the defendant?
5. Whether the defendant's copyright in the artistic work of the label 'NEVEREST' is exact reproduction of the plaintiff's artistic work in the label 'EVEREST'?
6. Whether the plaintiff is entitled relief for 'infringement of copyright'?
7. To what other reliefs, the plaintiff is entitled?

5. On the side of the plaintiff, P.W.1 was examined and Ex.P.1 to Ex.P.23 were marked. On the side of the defendant, D.W.1 was examined and no documents have been marked on the side of the defendant.

Witnesses examined on the side of the plaintiff:

P.W.1. - Mr.J.Samson Devandh

Witnesses examined on the side of the defendant :

D.W.1 - Mr.P.Suresh Kumar

Exhibits produced on the side of the plaintiff:

S.No.	Date	Description of the document	Exhibit
1	19.03.1999	Copy of incorporation certificate of the plaintiff company	P-1
2.	12.01.2007	Copy of VAT registration of the plaintiff company	P-2
3.	15.09.2010	Copy of the certificate of quality management	P-3
4.	14.09.2013	The Sales turnover certificate certified by the Chartered Accountant in respect of the plaintiff company and its sister concern	P-4
5.	-	Copy of invoices for sale of EVEREST brand stabilizer by the plaintiff company	P-5
6.	-	Leaflet for EVEREST Stabilizer	P-6
7.	-	Leaflet for EVEREST Water Heater	P-7
8.	-	Leaflet for EVEREST Fan	P-8

S.No.	Date	Description of the document	Exhibit
9.	-	Copy of Advertisement in C&T Directories today	P-9
10.	-	Copy of Bill for Advertisement of EVEREST Stabilizer in Eranakulam Getit yellow pages	P-10
11.	-	Copy of Advertisement in C&T Directories today	P-11
12.	--	Copy of bills for advertisement for EVEREST stabilizer in Jaya TV Channel	P-12
13.	--	Copy of bills for advertisement of EVEREST Stabilizer in Jaya TV Channel	P-13
14.	13/01/2011	Copy of bill for advertisement of EVEREST Stabilizer in Raj TV Channel	P-14
15.	-	Copy of Bill for advertisement of EVEREST Stabilizer in Udaya TV Channe	P-15
16.	04.03.2009	Copy of Advertisement in Bangalore Edition of Daily Thanthi	P-16
17.	08.03.2009	Copy of Advertisement in Bangalore Edition of Daily Thanthi	P-17
18.	14.02.2009	Copy of Advertisement in Bangalore Edition of The Hindu	P-18
19.	08.03.2009	Copy of Advertisement in Bangalore Edition of The Hindu	P-19
20.	24.07.2000	Downloaded copy of trademark A.No.941894 in Clause 09 filed by the plaintiff	P-20
21.	27.05.2013	Downloaded copy of trademark A.No.941894 in Clause 09 filed by the defendant	P-21
22.	-	Copy of plaintiff's packaging EVEREST Stabilizer	P-22
23.	-	Copy of defendant's infringed packaging label 'NEVEREST'	P-23

Exhibits produced on the side of the defendants: Nil

6. Issue Nos.1 to 7 :

The plaintiff has filed the suit for permanent injunction restraining the defendant from infringing the trademark of the plaintiff and for 'passing off' of the products of the defendant as that of the plaintiff with the deceptive trademark. It is not in dispute that the plaintiff and the defendant are dealing with similar products namely Stabilizers. The plaintiff has filed the suit claiming to be prior user of the trademark from the year 1995. The main defence of the defendant is that since the plaintiff has not obtained any registration in respect of their trademark, the suit is not maintainable. Such defence has no legs to stand for the simple reason that even with an unregistered trademark one can maintain a suit. It is also not in dispute that the plaintiff is using the trademark 'EVEREST'. Ex.P.20 has been filed by the plaintiff to show that the plaintiff has filed an application for registration of his trademark 'EVEREST'.

7. The learned counsel for the plaintiff submitted that the plaintiff has clearly established prior user and even the defendant has admitted in his cross examination that the plaintiff is doing the stabilizer business from the year 1995 and the defendant is dealing with stabilizer business from the year 2012. The

same clearly establish that the plaintiff is the prior user of the mark and both the marks are not only visually similar but also phonetically similar to each other. Except the word 'N' prefixed in the plaintiff's mark the trademark of the defendant is similar to that of the plaintiff. Therefore, it is his contention that the plaintiff has clearly established the case for 'passing off'. In support of his submissions, he relied on the judgment in **Aravind Laboratories Vs. V.A.Samy Chemical Works** reported in AIR 1986 Madras 265.

8. The learned counsel for the respondent would submit that the plaintiff has not obtained trademark registration and there is no similarity between the two trade marks. There is no illegality or deception or confusion to the purchasers. Further the logo 'EVEREST' is a computer system generated font called 'Algerian' and widely used by the public. Hence, prayed for dismissal of the suit.

9. On a perusal of Ex.P.20, the same indicate that the plaintiff has filed an application for registration of their trademark 'EVEREST' for the product Stabilizer under class 09, wherein the prior user is claimed from the year 1995. It is also to be noted that the defendant has also filed a similar application under Ex.P.21 claiming prior user from 05.12.2012. The very admission of the parties

before the Trademark Registrar clearly indicate that the defendant is in fact is using the mark 'NEVEREST' from 05.12.2012. He has commenced his business in 2012. Whereas the plaintiff not only in his plaint but also in his evidence has clearly spoken that he is doing business under the trade mark 'EVEREST' from the year 1995. Such pleading is not disputed or denied by the defendant in his written statement. Except denying the allegations in the plaint generally, the allegation of the plaintiff that they were dealing with products from the year 1995 under the trademark 'EVEREST' has not been disputed or denied specifically in the written statement. Such being the position, Order VIII Rule 5 of Code of Civil Procedure comes into play. When the specific facts pleaded in the plaint is not disputed, except as against the person under disability, such pleadings are deemed to be admitted.

10. Be that as it may. From the documents filed by the plaintiff, Ex.P.21 proves the fact that the defendant claims prior use of the mark 'NEVEREST' from 05.12.2012. Whereas the plaintiff's documents, in fact, substantiate the version of the plaintiff that he is using the mark from the year 1995. Ex.P.5 to Ex.P.19 invoices and advertisements given by the plaintiff makes it clear that the plaintiff is dealing with the product under the name of 'EVEREST Stabilizers Private Limited and Ex.P.12 Invoices filed by the plaintiff makes it clear that the invoices

have been raised by the plaintiff as early as on 02.08.2008. Ex.P.12 itself proves the fact that the plaintiff is the prior user of the mark 'EVEREST'. Similarly Ex.P.13 and Ex.P.14 are also of the year 2011. The above documents also prove that the plaintiff is dealing with the mark 'EVEREST' much prior to the user claimed by the defendant in the trademark application Ex.P.21. The advertisements given by the plaintiff makes it clearly that they have issued advertisements not only in Tamilnadu to market their products but also in other places. All these facts proves that the plaintiff is in fact prior user of the mark 'EVEREST'.

11. In the light of the above, now it has to be seen whether the plaintiff's mark 'EVEREST' and the defendant's mark 'NEVEREST' is identically and deceptively similar to that of the defendant's mark has to be seen. It is well settled that to find out the difference in the mark, the Court has to see the similarity in both marks first. On a careful perusal of the plaintiff's mark 'EVEREST' and the defendant's mark 'NEVEREST', this Court can see that the 'EVEREST' mark of the plaintiff has been printed in a square and before that 'N' has been shown in big size. Infact, the manner in which 'EVEREST' was used by the plaintiff is almost copied the word 'EVEREST' was put inside the box. Except the letter 'N', the word 'EVEREST' is almost similar. Though there is little

difference, the colour combination is also one and the same. The fact remains that the mark 'NEVEREST' adopted by the defendant appears to be same as that of the plaintiff and the mark of the defendant is identical and similar to the mark of the plaintiff namely 'EVEREST'. When the mark is so identical and similar, merely except some other letter in the prefix, it may not be said that there is no similarity in the two marks.

14. In **F. Hoffmann La Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd.** reported in **1970 (2) SCR 213**, the Supreme Court while considering the two trade marks "Protovit" and "Dropovit" observed as follows :-

"In order that a trade mark may be found deceptively similar to another it is not necessary that it should be intended to deceive or intended to cause confusion. It is its probable effect on the ordinary kind of customers that one has to consider. For this purpose it is necessary to apply both the visual and phonetic tests. It is also important that the marks should be compared as whole. It is not right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in the other case there is no sufficient similarity to cause confusion. The true test is whether the totality of the trade mark is such that it is

likely to cause deception or confusion or mistake in the minds of the persons accustomed to the existing trade mark".

15. Similarly in Lakshmi Narayan Karva V.Stayanarayan Khubchand reported in AIR 1975 Madras 112 the Division Bench of this Court observed as follows :-

"In judging whether a combination mark is distinctive or not it is wrong to dissect the mark and show that each of its component parts is not distinctive in itself and then as a result of this process to conclude that the mark as a whole is not distinctive."

In view of the principles laid down in the above decisions we cannot place the registered trade mark Eyetex along with the defendant's mark "Rani Eyevix" and the figures adopted in the carton side by side and then proceed to ascertain the difference in features and come to the conclusion as to whether there is a possibility of deception. The contention of the defendant that such a procedure should be adopted in this case will have to be negative in view of the principles laid down in the above decisions. What we have to consider is the overall aspects placing ourselves in the place of unwary purchaser. The prefix "Rani" to the defendant's

mark is made in small letters which will not catch the eye of an unwary purchaser. So also the facial lines found in the defendant's mark on the carton will not readily catch the eye of an unwary purchaser. So far as the distinction in the cap by providing a crown will not attract the purchaser because it goes inside the carton. There is a phonetic similarity between "Eyetex" and "Eyevix". The design of the carton and the colours adopted also show that a deception is possible. No doubt there is difference in size of letters and the purchaser is not likely to remember the size of the letters. So far as the difference in the eye brows there is a difference in marks which~ cannot be remembered by the purchaser, If we consider the overall aspects, as pointed out in the above decisions, it is clear that there is a phonetic similarity and other similarities which will likely deceive an unwary purchaser. The dissimilarity pointed out are not likely to be remembered by an unwary purchaser. Under the circumstances I have no hesitation in coming to the conclusion that the defendant's carton "Rani 'Eyevix" is an infringement of the plaintiff's registered trade mark Eyetex."

16. In line with the above judgment, the Single Judge of this Court in Aravind Laboratories Vs. V.A.Samy Chemical Works reported in AIR 1987 Madras 265, has held that when there is similarity between the two marks, injunction can be granted.

17. It is to be noted that the mark 'EVEREST' of the plaintiff is predominantly quoted in the box which in fact will lead to confusion to the ordinary people. Prefixing 'N' will not make any difference and it will lead to deception and confusion to the people of average intelligence. By adopting such mark, particularly 'EVEREST' predominantly inside the box and using the same colour combination, will certainly lead to confusion to ordinary and unwary purchaser. The word 'EVEREST' is adopted for the business and has attained distinctiveness and such a mark is always to be protected. Hence, the contention of the defendant that their trademark 'NEVEREST' is different from that of the plaintiff cannot be countenanced. As far as the contention of the plaintiff that the defendant has infringed the copyright of the artistic work of the plaintiff, this Court is unable to comprehend the same as the plaintiff has not obtained copyright for the artistic work, hence, the relief with respect to infringement of copyright claimed by the plaintiff cannot be granted. The issues

are answered accordingly.

18. In the result, the suit is decreed for prayer 'b' 'passing off' with cost. In respect of prayer 'c', since the plaintiff is also involved in similar business and dealing with the same products, the defendant is directed to destroy the label containing the word 'NEVEREST' within a month. In respect prayer 'a', the suit is dismissed. Consequently, the connected applications are closed.

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Index : Yes/No
Internet : Yes/No

Speaking/Non-Speaking Order



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