

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 4.7.2019

CORAM

THE HONOURABLE DR.JUSTICE VINEET KOTHARI
AND
THE HONOURABLE MR.JUSTICE C.V.KARTHIKEYAN

O.S.A.Nos.158 & 159 of 2019

and

C.M.P.Nos.13942, 13947 & 13955 of 2019

Palson Enterprises,
New No.54, 5th Cross Street,
Trustpuram, Chennai,
Tamil Nadu 600 024.
rep. by its Partner
Mr.P.L.Subramaniam

..Appellant

Versus

Kasi Group of Companies,
No.91/15, East Jones Road,
Saidapet, Chennai 600 093.

..Respondent

Prayer: Original Side Appeal filed under Order XXXVI Rule 1 of O.S. rules read with Section 15 of Letters Patent against the order of this court dated 10.6.2019 in A.Nos.2576 and 2577 of 2019 in O.A.Nos.171 and 172 of 2019 in C.S.No.149 of 2019.

For appellant : Mr.Arun C.Mohan

For Respondent : Ms.S.Suba Shiny for
M/s.Sarvabhauman Associates

COMMON JUDGMENT

(Judgment of the court was made by C.V.KARTHIKEYAN, J.)

The Plaintiff in C.S.No.149 of 2019, aggrieved by the order of the learned Single Judge dated 10.6.2019, vacating the order of interim injunction granted in O.A.Nos.171 and 172 of 2019, is before us in these Original Side Appeals.

2. The entire issue relates to a property called 'Kasi' Theatre which was taken over by the Plaintiff. They then obtained a registered Trade Mark for the name 'Kasi' and

therefore, sought for an order of injunction restraining the defendant, who is running 'Kasi' Talkies in a Mall by name 'Kasi City Park' from using the said name, 'Kasi'.

3. Learned counsel for the Appellant pointed out that the learned Single Judge had vacated the order of interim injunction which was originally granted solely on the ground of delay in approaching the court.

4. The order of the learned Single Judge giving reasons for vacating the injunction as seen from para 17 to 19 are extracted hereunder:-

"17. The present suit has been filed in the year 2019. The Respondent/Plaintiff was aware about the commencement of the theatre business by the Applicant/Defendant in the name of "Kasi Talkies" in July 2018 itself and the Respondent/Plaintiff was also invited to attend the Opening Ceremony of "Kasi Talkies". Though, as stated supra, the mark "Kasi" was not subsequently used by the Applicant/Defendant for theatre business and that he had obtained Form "C" licence and other necessary approval in his name, the same cannot be a ground to allow the interim order of injunction to continue, as, at the threshold the Respondent/Plaintiff did not approach this Court immediately since the inception of "Kasi Talkies" by the Applicant/Defendant and had slept over for more than eight months.

18. Though, it could be interpreted that the public without going to the theatre, may book tickets through online believing that Kasi Theatre and Kasi Talkies are one and the same, the Applicant/Defendant has given a disclaimer that the websites for booking tickets for "Kasi Theatre" and "Kasi Talkies" are different. Ultimately, public is not concerned as to the owner of the theatre and they would like to watch a movie in a comfortable place. Having kept quiet and allowed the mark "Kasi" to be used for years, even in the absence of the transfer of the mark "Kasi", whether it is implied or explicit need to be decided only after trial.

19. Yet again, this Court is of the view that these aspects have to be gone into at the time of final disposal of the Suit in question, after the pleadings are complete and the evidence is let in. Hence, the interim orders of injunction granted by this Court on 19.03.2019 in O.A.Nos.171 and 172 of 2019 are vacated only on

the score that the Respondent/Plaintiff has slept over the matter for eight months and allowed Kasi Talkies to run, despite having knowledge about the commencement of Kasi Talkies for which invitation has been received by him. It is made clear that in case, the Respondent/Plaintiff succeeds in the Suit, it may only entitle him the benefits of using the term "Kasi", but also damages."

5. The learned counsel for the Appellant pointed out that the property was purchased in the year 2002 and the Registration of the trademark 'Kasi' was done during the 2016. However, no explanation was given for that long period taken to register the name 'Kasi'.

6. The learned counsel for the Respondent, Ms.S.Suba Shiny, who entered appearance on caveat, on the other hand, submitted that though the property was sold in the year 2002, the respondent had also independently commenced construction of a Mall under the name 'Kasi City Park' and a theatre, 'Kasi Talkies' without any objection from the appellant. She further submitted that the name 'Kasi' flowed from the name of the father of the Proprietor of the respondent-Group viz., 'Kasi Nadar'. She has also drawn our attention to the fact that the respondent is running various other businesses also under the name 'Kasi'.

7. We find that the learned Single Judge had also observed that the Appellant had slept over the matter for about eight months without raising any objection either for the name 'Kasi' or for running 'Kasi Talkies'. We hold that the reasoning given by the learned Single Judge for vacating the order of interim injunction on the ground of delay is well founded.

8. The learned counsel for the Appellant, on the other hand, placed reliance upon Section 34 of the Trade Marks Act 1999 and submitted that there has been a saving of vested right and a Registered User of the trade mark has a right to seek a restraint order of injunction preventing the use of an identical mark. However, section 34 also envisages continuous usage of the said trade mark and also prior usage of the trade mark. In this case, the respondent has been using the name 'Kasi'. Further, the word 'Kasi' being a pronoun and relating back in this case to the name of the father of the Proprietor of the respondent-Group, we hold that the learned Single Judge was right in interfering with the order granting injunction.

9. The issues relating to prior usage and also relating to comparative loss can be adjudicated only during the course of trial. We further hold that the order of the learned Single Judge relegating the parties to trial on the issues raised between them would only be in the interest of both the parties.

They would have ample opportunity to adduce evidence, both oral and documentary, to substantiate their respective stands.

10. Therefore, the present Appeals are disposed of with a direction to the learned Single Judge to bestow attention to expedite the Trial and to ensure that the trial is completed within a reasonable period. No costs. The connected miscellaneous petitions are closed.

ssk.

Sd/-
Assistant Registrar

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Sub Assistant Registrar

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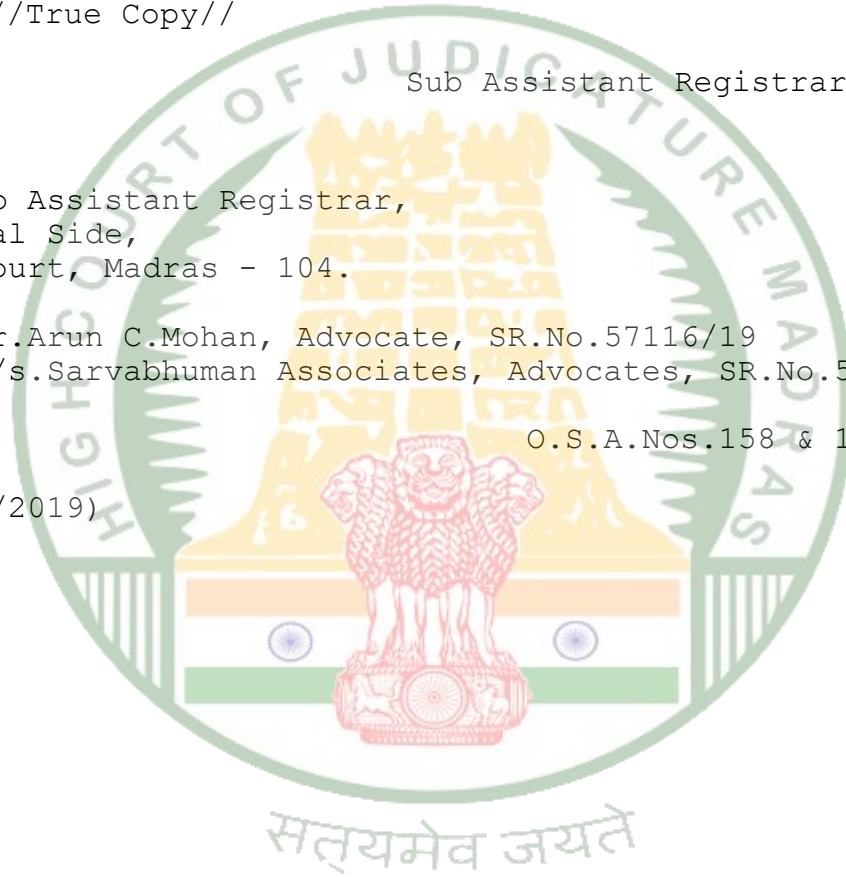
The Sub Assistant Registrar,
Original Side,
High Court, Madras - 104.

+1cc to Mr.Arun C.Mohan, Advocate, SR.No.57116/19

+1cc to M/s.Sarvabhuman Associates, Advocates, SR.No.56640/19

O.S.A.Nos.158 & 159 of 2019

Kak(13/09/2019)



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