

Reserved on : 18.10.2019

Pronounced on : 30.10.2019

IN THE HIGH COURT OF JUDICATURE AT MADRAS

CORAM

THE HONOURABLE MR.JUSTICE N.SATHISH KUMAR

Civil Suit No.942 of 2017

1. N.S.Krishnamoorthy

2. Hearing Aid Centre,
Rep. by its Partner, K.G.Ganesh,
No.29/12, Riaz Garden,
Kodambakkam High Road,
Chennai – 600 034.

... Plaintiffs

Vs

Afru Hearing Aid Centre,
No.B 12 A / C 12A, 1st Floor,
Parsn Commercial Complex,
No.1, Kodambakkam High Road,
Nungambakkam, Chennai – 600 034.

... Defendant

Prayer :- Suit filed under Order IV Rule 1 O.S. Rule Read with Section 134 (1)

(a) & (c) and Section 135 of the Trade Marks Act, 1999 for the following reliefs :

a] to grant a permanent injunction restraining the defendant by themselves, their servants, licensees, agents and distributors or any one claiming through them in any manner from committing infringement of plaintiff's registered trademark or trade name 'Hearing Aid Centre' under Trade Mark

No.852348 by using deceptively similar name Hearing Aid Centre or with any other name or prefix or suffix;

b] to grant a permanent injunction restraining the defendant by themselves, their servants, licensees, agents and distributors or any one claiming through them in any manner from committing 'passing off' plaintiff's goods and services under the deceptive name 'Hearing Aid Centre' in respect of goods Hearing aid and Apparatus and other related services as and for being connected with the business of the plaintiff's trade name Hearing Aid Centre or with any other name or prefix or suffix;

c] to direct the defendant to surrender to the plaintiff all the unsold goods Hearing Aid and Apparatus under the deceptively similar mark 'Hearing Aid Centre' containing or consisting of the offending packages together with the blocks or dyes used for the purpose of printing the same of destruction;

d] to direct the defendant to pay the plaintiff the cost of the suit.

For Plaintiffs : Mr.Sthish Kumar
for Mr.P.C.N.Ragupathy

For Defendant : Mr.M.S.Bharath
Mr.R.Suresh – D2

D3 & D4 already set exparte

JUDGMENT

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This suit has been filed for a permanent injunction restraining the defendants and his men from in any manner infringing the copyright and

trademark of the plaintiff or trade name 'Hearing Aid Centre' and passing off the plaintiff's goods as that of the defendant and for cost.

2. Brief facts of the plaintiff case is as follows :

2.1. The plaintiffs are carrying on business in wholesale and retail trading and marketing of 'Hearing Aids and Apparatus' under the name and style of 'Hearing Aid Centre' with 'HAC' logo for the last 36 years. They have gained reputation and goodwill attached to their trade name and trade mark from the year 1981. The plaintiffs' 'Hearing Aid Centre' [HAC] is a pioneer in the hearing health care industry and has been at the forefront of all this from the day one diagnosis with suitable hearing technology. The plaintiffs have obtained registration of their trade name 'Hearing Aid Centre' with 'HAC' logo under the trade Mark No.85248 and 1523851 in class 10 in respect of goods Hearing Aids and Apparatus in the name of the first plaintiff by claiming user from the year 1981. The first plaintiff is the registered proprietor of the trademark 'Hearing Aid Centre' with 'HAC' logo under trademark No.852348 in class 10 and also 'HAC' logo alone under Trademark No.1523851 in class 10. The first plaintiff also permitted his firm, the second plaintiff herein, to continuously use the said registered trademarks. Thereby the plaintiffs have acquired a right of property in the said trademark. The plaintiffs' sales networks almost covered all major cities

in India having 18 centers in 11 cities including six branches in Chennai. Thereby, the plaintiffs' trademark 'Hearing Aid Centre' is a well known mark and therefore, the plaintiffs' have an exclusive proprietary right over the said mark in respect of said goods and services by virtue of continuous 36 years user of the mark.

2.2. The plaintiffs came to know that the defendant is indulged in retail marketing of Hearing Aids and Apparatus under one deceptively similar name 'Afru Hearing Aid Centre' and it nearly resembles to the plaintiffs' registered trademark 'Hearing Aid Centre'. The defendant's deceptive mark 'Afru Hearing Aid Centre' is likely to deceive and cause confusion among the traders and consuming public of Hearing Aid Apparatus and thereby the defendant is using the deceptively similar mark to their goods and services. The Adoption of deceptively similar name 'Hearing Aid Centre' with prefix of 'Afru' as like that of the plaintiffs by the defendant itself is the proof that what kind of popularity the plaintiffs are enjoying for their registered trademark 'Hearing Aid Centre'. The defendant has adopted the mark 'Afru Hearing Aid Centre' with commercial dishonesty to look like to that of the plaintiffs' registered trademark 'Hearing Aid Centre' with ulterior intention to reap the harvest of goodwill earned by the plaintiffs during the course of their business in the trade 'Hearing Aids and

Apparatus'. Further, the plaintiffs are the prior user of the registered trademark 'Hearing Aid Centre' and the defendant has dishonestly adopted the trademark 'Hearing Aid Centre' but with prefix 'Afru'.

2.3. Priority in adoption and use prevails over priority in registration' emphasized under Section 34 of the Trade Mark Act 1999. The defendant is using the trademark from 1st September, 2013 which is subsequent to the adoption of the 'Hearing Aid Centre' by the plaintiff in the year 1981. Therefore, the conduct of the defendant amount to 'passing off' the goods and services of the defendant as like that of the plaintiffs and also amounts to fraud on the plaintiffs as well as the consumer public because the deceptive mark 'Hearing Aid Centre' with prefix 'Afru' adopted by the defendant is exact reproduction and deceptively similar to the plaintiffs' trade mark by adding the prefix 'Afru' in respect of goods 'Hearing Aids and Apparatus'. Hence, the suit.

3. Brief contention of the defendant is as follows :

3.1 It is the case of the defendant that their firm was started in the year 2013 by Mr.Kareem and his wife Mrs.Nussarathunnisa Begum to cater to the growing need for technical expertise in the field of Hearing Aids. The defendant carries on business in wholesale and retail sale of Hearing Aids manufactured by

third party manufacturers from India and overseas under their respective brands and other hearing aid services under the name of M/s.Afru Hearing Aid Centre. The name 'Afru' was coined by the partners as their distinctive trade style along with the words 'Hearing Aid Centre' which is descriptive to denote the type of business being carried out by the firm. The defendant has applied for trademark registration only in respect of the mark 'Afru' and the 'device of ear' logo under Nos.3486356 and 3486357 in Class 44 for the services of Hearing Therapy, Hearing Aid Fitting Services, consultancy relating to hearing tests, medical consultancy relating to hearing loss; Medical Services, veterinary services, hygienic and beauty care for human beings or animals, agriculture, horticulture and forestry services are covered under Class 44. The defendant has tie up with several brands to promote the products and business pertaining to the said brands through their store. The defendant does not market or offer for sale, any product under their brand 'Afru' through their store whereas the defendant offers various kinds of hearing tests and offers personalised hearing solutions for customers apart from sale of hearing aid of various leading brands through their store under the brand 'Afru'.

3.2 The defendant has been honestly, continuously and extensively using the mark 'Afru Hearing Aid Centre' in the trade in respect of the above mentioned

services since 2013. The defendant has spent substantial sums of money in creating awareness and promoting their business under the mark 'Afru'. The plaintiffs have obtained trademark registration under No.852348 in Class 10 for the goods 'Hearing Aids and Apparatus' for the deaf parts fittings for all the aforesaid goods' in the respect of device 'HAC'. Having applied for a composite device mark consisting of several elements containing the 'HAC' logo along with the words 'Hearing Aid Centre', the plaintiffs cannot claim rights exclusively over the words 'Hearing Aid Centre' which a generic term. Having obtained trademark registration under Class 10, the plaintiffs are now attempting to enforce their registration in respect of services falling under Class 35/44 of providing retail store services and/or providing Hearing Therapy, Hearing Aid Fitting Services and Consultancy. The plaintiffs' mark not being a declared well-known mark, its right/use cannot transcend classes and hence, the plaintiff cannot enforce its registration in respect of goods/services provided outside class 10. Therefore, an action for infringement would not lie against the defendant as the plaintiffs do not hold any registration in respect of services in Classes 35 or 44. Admittedly the plaintiffs are not using the mark 'HAC' logo along with 'Hearing Aid Centre' for goods under class 10 and hence the plaintiffs mark is liable to be rectified on the ground of non use.

3.3. Further, a comparison of the plaintiffs' trademark/trade name along with that of the defendant's trademark/trade name would clearly prove that there is no similarity between the marks as the plaintiffs' mark 'HAC' logo along with 'Hearing Aid Centre' and the second trademark of the plaintiffs contains the 'HAC' logo along with the phrase 'Trusted for (y)ears'. Whereas the defendant uses the mark 'Afru' as their trademark along with the device of ear and the term 'Hearing Aid Centre' has been used by the defendant to describe their nature of business to the general public. Therefore, the term 'Hearing Aid Centre' can never be considered as anyone's trademark and the same is bonafidely required in the trade to describe the nature of services provided by the traders. Evidently, the defendant is also not claiming any right over the term 'Hearing Aid Centre' used by them. Moreover the 'Device of ear' and the defendant's mark 'Afru' are prominently displayed and are capable of distinguishing the defendant's services from that of other parties including the plaintiffs.

3.4. The words 'Hearing Aid Centre' taken in the normal course of business is a completely descriptive term indicating a centre/place/location/store which provides Hearing Aids and related goods/services. No extent of use of descriptive terms by any one party would confer exclusive rights upon such descriptive terms to the said party to use the said terms against all others

conducting the same or similar business. Therefore, the claim of the plaintiffs either in common law as a right of usage or under the Trademarks Act, 1999 is invalid and enforceable. The defendant herein is using the term 'Hearing Aid Centre' only to denote the services rendered by them to the general public. Even assuming but not admitting that the plaintiffs herein have a right over the term 'Hearing Aid Centre', the use of the said term by the defendant would not result in infringement under Section 30 of the Trademarks Act, 1999. Further, the advertisements filed by the plaintiffs provide prominence only to the 'HAC' logo along with 'TM' superscript which symbolizes the mark/brand's intention to be protected. This leads the general trade and public to understand and believe that it is the 'HAC' logo which is the brand and Hearing Aid Centre is just a description of the goods offered/services rendered by the plaintiffs. It is further stated that the plaintiffs do not have any right/remedy against the multitude of third parties who use the term 'Hearing Aid Centre' across the world as a descriptive term to indicate their business. More than 31 such parties are suing the term 'Hearing Aid Centre'.

4. Based on the above pleading, the following issues have been framed :

1. Whether the present Suit, as filed is maintainable?

2. Whether the plaintiffs' can claim rights over the term 'Hearing Aid Centre'?

3. Whether the term 'Hearing Aid Centre' is common to trade and is bonafidely required in the trade for others to describe their hearing aid services?

4. Whether the plaintiffs are the prior user of the trademark 'Hearing Aid Centre' and whether the defendant's adoption of the mark 'Afru Hearing Aid Centre' is likely to deceive and/or cause confusion amongst the public?

5. Whether the plaintiffs are entitled to a decree as prayed for in the suit?

6. 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.45 were marked. On side of the defendant, D.W.1 has been examined and Ex.D.1 to Ex.D.17 have been marked.

Witnesses examined on the side of the plaintiffs:

P.W.1. - Mr.K.Ganesh

Witnesses examined on the side of the defendant

D.W.1 – Mr.M.Kareem

Exhibits produced on the side of the plaintiffs:

S.No	Date	Description of documents	Exhibit
1.	--	A copy of Sales Tax Registration Certificate for the year 1981	P-1
2.	18.01.2007	A copy of VAT registration	P-2
3.	01.08.1991	A copy of the Income Tax Assessment Notice	P-3
4.	21.06.1982	A copy of the Challan No.11 of Income Tax for plaintiff	P-4
5.	14.09.1984	Copy of payment receipt dated 14.09.1984 by the plaintiff	P-5
6.	13.09.1985	Copy of Challan No.7 of Income Tax Department	P-6
7.	13.09.1985	Copy of Challan No.7 of the Income Tax Department	P-7
8.	28.07.1987	Copy of Challan No.11 of the Income Tax Department	P-8
9.	11.09.1987	Copy of Challan No.7 of the Income Tax Department	P-9
10.	30.11.1988	Copy of Income Tax Assessment Order	P-10
11.	30.08.1988	Copy of Challan No.11 of the Income Tax Department	P-11
12.	30.08.1988	Copy of Challan No.11 of the Income Tax Department	P-12
13.	29.09.1988	Copy of summons under section 131 of Income Tax Act 1961	P-13

S.No	Date	Description of documents	Exhibit
14.	11.09.1989	Copy of the Challan No.7 of the Income Tax Department	P-14
15.	26.10.1991	Copy of Challan No.11 of the Income Tax Department	P-15
16.	13.09.1991	Copy of Challan No.7 of the Income Tax Department	P-16
17.	15.12.1993	Copy of Challan No.7 of the Income Tax Department	P-17
18.	13.12.1995	Copy of the Challan No.7 of the Income Tax Department	P-18
19.	08.03.1995	Copy of the TNGST allotment letter	P-19
20.	16.12.1996	Copy of the Income Tax Receipt	P-20
21.	05.04.1999	Copy of PAN allotment letter	P-21
22.	01.09.2005	Copy of letter by Hon'ble Former President of India Sri R.Venkatraman	P-22
23.	12.09.2005	Copy of letter by Hon'ble Former President of India Sri R.Venkatraman	P-23
24.	25.05.2011	Copy of Commercial Tax Registration Certificate	P-24
25.	--	Copies of the classified advertisement given by the 1 st plaintiff in the news paper "The Hindu" from the year 1981 to 1999.	P-25
26.	01.11.2009	Copy of the Advertisement in the New Paper "The Hindu"	P-26
27.	08.11.2009	Copy of the Advertisement in the News Paper "The Hindu"	P-27
28.	--	Copy of Advertisement in the Yellow Pages	P-28
29.	25.08.2010	Copy of Advertisement in the News Paper "The Hindu"	P-29
30.	15.09.2010	Copy of Advertisement in the News Paper "The Hindu"	P-30
31.	09.09.2010	Copy of Advertisement in the News Paper	P-31

S.No	Date	Description of documents	Exhibit
		"Expresso"	
32.	07.11.2010	Copy of Advertisement in the News Paper "The Hindu"	P-32
33.	10.03.2011	Copy of Advertisement in the News Paper "Dinamalar"	P-33
34.	12.07.2008	Copy of Trademark Registration Certificate No.852348	P-34
35.	31.03.2009	Certified copy of the Trademark Registration No.1523851	P-35
36.	19.01.2011	Copy of Partnership Deed	P-36
37.	--	Copy of the Registration Certificate for Registration of the second plaintiff's firm	P-37
38.	25.05.2011	Copy of VAT registration of the second plaintiff's	P-38
39.	--	Copy of Sales Turnover certificate and Sales Promotion Expenses of the plaintiffs	P-39
40.	--	Copy of plaintiffs Name Board	P-40
41.	--	Copy of the defendant's name board	P-41
42.	--	Copy of the legal notice dated 25.11.2016 from the plaintiffs to the defendant	P-42
43.	19.12.2016	Copy of reply notice sent by the defendant to the plaintiff	P-43
44.	--	Photograph of the plaintiffs' shop	P-44
45.	--	Photograph of the plaintiffs' shop	P-45

Exhibits produced on the side of the defendants:

S.No	Date	Description of documents
1.	--	Photocopy of the entries for the words "Hearing", "Aid", "Centre" from the Chambers Dictionary

S.No	Date	Description of documents
2.	--	Copy of certificate for use in legal proceeding for registration No.852348 in Class-10
3.	--	Copy of the trademark application dated 17.02.2017 for the mark 'Afru' bearing No.3486357 in Class 44 along with current status of the mark as on 27.12.2017
4.	--	Copy of the trademark application dated 17.02.2017 for the mark 'Afru Device' bearing No.3486356 in Class 44 along with current status of the mark as on 27.12.2017
5.	14.11.2013	Copy of Partnership of the defendant's firm
6.	26.12.2013	Copy of VAT Registration Certificate of the defendant
7.	30.12.2013	Copy of Commercial Tax Registration Certificate of the defendant
8.	30.12.2013	Copy of Partnership firm Registration Certificate of the defendant
9.	28.01.2014	Copy of the letter to the Controller of Defense Accounts accepting payment against supplies to Army Units through NEFT
10.	09.09.2015	Copy of Business Loan application applied by the defendant with HDFC Bank
11.	04.02.2016	Copy of the letter issued to the Assistant Commissioner – Commercial Tax regarding change of address of the defendant store
12.	26.06.2017	Copy of GST Provisional Registration Certificate dated 26.06.2017 issued to the defendant
13.	--	Copy of Invoices between 24.12.2013 to 16.12.2017 issued by the defendant to their customers
14.	21.11.2016	Copy of the legal notice issued by the plaintiffs to the defendant
15.	09.12.2016	Copy of reply notice issued by the defendant to the plaintiff
16.	--	The Screenshots of websites/business directories providing use of the term 'Hearing Aid Centre' by various third parties across Chennai, India and across the world

S.No	Date	Description of documents
17.	--	Affidavit filed under Section 65 of the Evidence Act 1872

6. The learned counsel appearing for the plaintiff submitted that plaintiffs got registration for their business 'Hearing Aid Centre' with logo 'HAC' and they are using the trade name from the year 1981. The defendant had started business in the year 2013 and much later, they had obtained trademark registration certificate. They are using the trademark 'Afru' in small size and 'Hearing Aid Centre' prominently. The adoption of the trademark of the plaintiff by the defendant is nothing but dishonest and the manner in which the word 'Afru' prefixed in small size and the 'Hearing Aid Centre' in large size is also dishonest. The defendant ought to have challenged the trademark. When the registered trade is not challenged, the question of rectification does not arise. Under section 28 of the Trade Marks Act, the registered owner is entitled to protect his trade mark. Both the trademarks are identical and deceptively similar. The plaintiffs' mark 'HAC' is not a stand alone. It is a 'Hearing aid Centre'. The defendant is adopting a similar mark and has opened a shop hardly half a kilometre away from the plaintiffs' shop. The plaintiffs have proved the reputation from various advertisements and also letters sent by then President of India. The defendant being aware that the plaintiffs are having a shop, opened a

shop in the same place with similar name and their intention is nothing but dishonest and clear infringement which amounts to passing off. Ex.P.1 and Ex.P.2 prove that the plaintiffs' are doing business from the year 1981. Ex.P.25 to 33 classified advertisements issued by the plaintiffs. The Income Tax returns filed by the plaintiffs proves turnover of the plaintiffs and also reputation of the plaintiffs. Hence, it is his contention that 'HAC Hearing Aid Centre' is the registered trademark of the plaintiff and they acquired distinctiveness even at the time of applying for the trademark. The prominent feature of the trade mark has been copied in toto by the defendants. Therefore, it is the contention of the plaintiff that Section 17 of the Trademarks Act is not applicable to the facts of the present case. The defendants have not challenged the trade mark. The defendant cannot use the trademark Hearing and Centre as a whole. The defence was that the phrase 'Hearing AID Centre' is descriptive. The expression 'Hearing Aid Centre' as a whole is not descriptive but it is only the expression 'Hearing Aid'.

7. Further the allegation of the defendant that the registration in class 10 is not correct as the plaintiff are dealing only with services and not products as they are using the trademark 'Hearing Aid Centre' in relation to goods offered. Ex.B.17 filed by the defendant is only after suit. The defendant is using an

identical trademark 'Hearing Aid Centre' as that of the plaintiff. Further, under the Trademarks Act, there is a provision to register even a descriptive expression upon the evidence of "acquired distinctiveness". In support of his submission, the learned counsel placed reliance on the following judgments

S.Syed Mohideen Vs. P.Sulochana Bai reported in
2016 (2) SCC 683

**Ramdev Food Products (P) Ltd. Vs. Arvindbhai
Rambhai Patel and others** reported in **2006 (8) SCC 726**

Himalaya Drug Co. Vs. S.B.L. Limited reported in **2013
(53) PTC 1- 'Delhi DB]**

**Pidilite Industries Vs. Jubilant Agri & Consumer
Products Limited** reported in **2014 (57) PTC 617**

**Godfrey Philips Vs.Girnar Food & Beverages Private
Limited** reported in **2004 (5) SCC 257**

8. It is the contention of the defendant that the plaintiffs do not have any cause of action to file the present suit. Admittedly, the plaintiff is only proprietor of the composite mark 'HAC' logo with Hearing Aid Centre" in class 10 whereas the defendant is the proprietor of the mark 'Afru'. The defendant adopted the mark and initiated use of the same in September 2013 whereas the plaintiff filed

the suit only in December 2017. The plaintiffs' registration under Nos.852348 and 1523851 in class 10 are in respect of composite device marks containing several elements. In fact, the plaintiffs' trademark under No.1523851 in Class 10 does not even have the term 'Hearing Aid Centre' within it. Further P.W.1 also admitted in his evidence that trademark applied and obtained only for composite mark with Hearing Aid Centre. Therefore, when the plaintiff is using the same as their trademark, they cannot claim exclusive right over the portion of the trademark as against the trademark and Sub section 2 of Section 17 of the Trademark will squarely apply to the present case. Further, the trademark registration are in respect of composite device marks containing several elements. P.W.1 in his evidence also admitted that the trademark applied for and obtained by the plaintiffs is only in respect of composite mark 'HAC' logo with 'Hearing Aid Centre'.

9. The Income Tax documents filed by the plaintiff will not prove goodwill and reputation. In the advertisements filed by the plaintiffs, the plaintiffs have appended the 'TM' Superscript only next to the 'HAC' logo thereby holding out to the world and educating the consumers that only 'HAC' Logo is the trademark and not the term 'Hearing Aid Centre'. The P.W.1 himself admitted that the distinctive part of the trademark created to distinguish the plaintiff's trademark

from other parties. The plaintiffs have not proved their use of the term 'Hearing Aid Centre'. Ex.B.16 prove the fact that many others are using the term 'Hearing Aid Centre'. Therefore, the plaintiff cannot claim exclusive right over the term and by virtue of their own admission the plaintiffs' trademark ought to be rectified. The documents filed by the plaintiff Ex.P.26 to 33 show that the plaintiff obtained trade mark registration only to 'HAC' logo and not to the term Hearing Aid Centre. The plaintiffs' trade mark is 'HAC' 'Hearing Aid Centre' whereas the defendant's trademark is 'Afru' 'Hearing Aid Centre' and hence, there is no similarity in the trademark of the plaintiff and the defendant. Hence, there is no deception or confusion in the present scenario. Further the plaintiff has not filed any single document for the alleged loss of reputation suffered by them. It is the further contention of the defendant that the plaintiffs' registration is not for Hearing Aid Centre. The plaintiff has not taken any action against the other Hearing Aid Centres. Hence, prayed for dismissal of the suit. In support of his contentions, he relied upon the following judgments :

Horlick's Malted Milk Company Vs. Summerskill –
English Judgment in the House of Lords

Carisberg India Pvt Ltd., Vs. Radico Khaitan Ltd.
reported in **2012 (49) PTC 54 (Del) (DB)**

**Wealth Advisors (India) Pvt. Ltd. Vs. Citibank
N.A./Citygroup Inc. and others** reported in **2017 (72) PTC 501**
[Mad] [DB]

**Asian Paints Limited Vs. Home Solutions Retail
(India) Ltd.** reported in **2007 (35) PTC 697 (Bom.)**

**Bigtree Entertainment Pvt. Ltd. Vs. Brain Seed
Sportainment Pvt. Ltd. & another** reported in **2018 (73) PTC**
115 (del)

**N.Ranga Rao & Sons Vs. Amrutha Aromatics &
Others** reported in **2017 (72) PTC 209 [Mad] [DB]**

Marico Ltd. Vs. Agro Tech Foods Limited reported in
2010 (44) PTC 736 (Del) (DB)

Reliance Industries Ltd. Vs. Reliance Polycrystalline Ltd.
reported in **1997 (17) PTC 581**

IHHR Hospitality Pvt. Ltd. Vs. Bestech India Pvt. Ltd.
reported in **2012 (50) PTC 535 (Del) (DB)**

**Skyline Educational Institute (I) Private Limited Vs.
S.L. Vaswani & Another** reported in **2010 (42) PTC 217 (SC)**

J.R.Kapoor Vs. Micronix India reported in **1994(14)**
PTC 260 (SC)

10. Issue Nos.1 to 6 :

It is the specific case of the plaintiff that they are carrying on business in wholesale and retail trading and marketing of 'Hearing Aids and Apparatus' under the name and style of 'Hearing Aid Centre' with 'HAC' logo during the last 36 years and have gained reputation and goodwill attached to their trade name from the year 1981. They have obtained registration of their trade name 'Hearing Aid Centre' with 'HAC' logo under the Trade Mark No.852348 and 1523851 in class 10 in respect of goods Hearing Aids and Apparatus in the name of the first plaintiff by claiming user from the year 1981. The defendant started their trade in Hearing Aid Center with similar trade mark 'Afru' 'Hearing Aid Centre'. Therefore, it is the contention of the plaintiff that the trademark of the defendant 'Afru' 'Hearing Aid Centre' is likely to cause confusion among the consumers. Ex.P.34 is the trade mark certificate wherein the plaintiffs had obtained trademark registration for 'HAC' trade mark and 'Hearing Aid Centre' under trademark registration No.852348. Ex.P.35 is the trademark registration certificate under registration No.1523851 dated 31.03.2009 for trademark 'HAC' logo trusted for (y)ears. Both the trademarks have been registered under clause 10. The goods description under clause 10 is Hearing Aids and Parts and Fittings thereof, Hearing Aids for the deaf ["Acoustic" Aids].

11. Ex.P.1 indicate that the plaintiff has been registered as a dealer under the Sales Tax Act. Ex.P.2 is the Certificate of Registration of the plaintiff with the Commercial Tax Department. Ex.P.3 is the Income Tax Assessment Notice sent to the plaintiffs. Ex.P.4 is the Income Tax Challan of the plaintiffs' firm. Ex.P.9 to 21 are the communications from the Income Tax Department to the first plaintiff as proprietor of Hearing Aid Center from the year 1981. These documents are from 1981 to 1999. The above documents clearly indicate that the plaintiffs are carrying on business in the name of 'Hearing Aid Centre'. Ex.P.22 is the letter written by the former President of India requesting the plaintiff to provide hearing aid. Ex.P.23 is also a similar letter sent by the former President of India. Ex.P.25 series indicate that the advertisements are given by the plaintiff from 1991. Ex.P.25 series clearly prove the fact that the plaintiff are using the word Hearing Aid Centre from the date of inception, that is from the year 1981. Ex.P.26 when carefully seen, in one of the advertisements the trademark shown as 'HAC' trusted for (y)ears and Hearing Aid Centre is also shown in the advertisement. Ex.P.27 and Ex.P.29 'HAC' logo and Hearing Aid Centre are shown in the advertisements in the yellow pages in 2010. In Ex.P.29 to Ex.P.31 'HAC' logo and Hearing Aid Centre are shown in the advertisements given in 'The Hindu'. Ex.P.37 registration of firm in the name of the second plaintiff, in which 'Hearing Aid Centre' is also is given as trademark. All these documents,

particularly Ex.P.34 and Ex.P.35 registration certificates indicate that the plaintiff has obtained registration for 'HAC' logo and 'Hearing Aid Centre' and 'HAC' trusted for (y)ears. Further, the documents, particularly the income tax and sales tax correspondences clearly indicate that from the very inception, the plaintiff is continuing the business in the name and style 'Hearing Aid Centre'.

12. The defendant has obtained trademark registration for the mark 'Afru'. It is the contention of the defendant that the Hearing Aid Centre is descriptive in nature and any registration obtained by the plaintiff is only for a composite mark unless registration is applied for each mark, the plaintiff cannot claim exclusive right over the entire mark and the term Hearing Aid Centre is a mark used in the trade. Admittedly registration of the plaintiff is not challenged. No application for rectification of the trademark is made by the defendant. As long as the registration is not challenged, this Court is of the view that the registration of the trademark shall be construed as fully valid. Similarly, the documents filed by the plaintiff proves the fact that the plaintiff is carrying on business under the trademark 'Hearing Aid Centre' as a phrase as a whole. In respect of which they have also obtained registration of the trademark. As long as the registration is not challenged, the registered trade mark shall be taken to be fully valid. The contention of the defendant that the trademark is descriptive in nature cannot be

countenanced for the simple reason that the defendant themselves are using the trademark 'Hearing Aid Centre' prominently and registered trade mark 'Afru' insignificantly. Ex.B.16 has been filed by the defendant to show that many third parties are using the 'Hearing Aid Centre' as a part of their trade name as business description. It is to be noted that this search has been made to get these particulars only after the suit. The specific evidence of the plaintiff in this regard is that though several persons are using their trade mark as 'Hearing Aid Centre' after issuance of notice, they stopped the use of their trade mark. Such being the position, when the defendant asserts that still the trademark 'Hearing Aid Centre' is used by the third parties, the onus lies on him to establish that the trademark 'Hearing Aid Centre', the term 'Hearing Aid Centre' is widely used across the world.

In the judgment in **Horlick's Malted Milk Company Vs. Summerskill** reported in **the House of Lords**, the English Court has held as follows :

“Malted Milk”, brought a passing-off action against the defendant to restrain him from using the words “Malted Milk” in connection with a food preparation which he made and sold under the name of “Hedley's Malted Milk”. The plaintiffs

claimed that by the expression "Malted Mil" the public understood their food only, no one else having used the words until quite recently, and they contended that the words were not descriptive of the article, it not being possible to malt milk. The defendant maintained that it was the natural and ordinary English way of describing a food which contained malt and milk" was a descriptive term which had never lost its original proper descriptive meaning, and had never become distinctive, exclusively or otherwise, of the plaintiff's preparation, and that if there were any obligation on the defendant to distinguish his preparation from the plaintiffs', he had done so by the prefix "Hedleys" The action was dismissed with costs. The plaintiff's appealed. It was held by the Court of Appeal that "Malted Milk" was a correct description of the respondent's preparation and the appeal was dismissed with costs. The plaintiffs appealed to the House of Lords. Held, that the appeal be dismissed with costs."

13. In the judgment in **Asian Paints Limited Vs. Home Solutions Retail India Limited** reported in **2007 (35) PTC 697 (BOM)**, in the application the

Bombay High Court has refused interim injunction on the mark of the plaintiff 'Asian Paints Home Solutions'. The defendant had adopted the corporate name which is associated with nature of service which is common use in India and Abroad'. The above facts cannot be applied to the facts of the present case.

14. In the judgment in **Bigtree Entertainment Pvt. Ltd. Vs. Brain Seed Sportainment Pvt. Ltd. and another** reported in **2018(73) PTC 115 [Del]**, the Delhi High Court has held that

"13. Turning to the present case, plaintiff's domain www.bookmyshow.com and defendant's domain www.bookmysports.com are not the sole users of the prefix "BOOKMY". In the written statement learned counsel for the defendant has submitted several pages of domain names beginning with "BOOKMY" that have existed both before and subsequent to the plaintiff's website. This gives the first indication that the prefix is a descriptive one.

14. Examination of the market in which the prefix is abundant further gives the impression that the prefix is not invented but a description of the type of business that is being run. The phrase "BOOKMY" is not an arbitrary coupling of two

English words. It is instead an apt description of a business that is involved in the booking of a particular thing for its consumers, whether it is a concert, a movie, or a sports facility. Defendant's adoption and application of this prefix to describe its activities as a sports facility booking domain appears prime facie to be a decision in concert with other players in the booking industry.”

15. Though in the above judgments cited by the learned counsel for the defendants it has been held that the exclusive right in respect of the use of the trade mark should be taken and if the proprietor desires a statutory protection to the exclusive right of any part of the 'trade mark', he has to apply to register the whole and each such part as a separate trademarks. Further, the above judgments are passed at interlocutory application stage. The Courts on seeing prima facie case has held as above. But the fact remains that in this case as indicated above, various documents have been filed by the plaintiff to prove that they are using the trade name 'HAC' logo and 'Hearing Aid Centre' from the year 1981. They have also obtained the registration for their trademark and the registration also not challenged by the defendant. The defendant has obtained the registration for the mark 'Afru'. Infact, it is the case of the plaintiff that 'Afru' is used insignificantly, whereas, 'Hearing Aid Centre' the plaintiff's mark, is used

prominently. It is the evidence of P.W.1 that the defendant had adopted the trademark of the plaintiff prominently and opened the shop within the same area. Such conduct of the defendant certainly amounts dishonest and deception on the part of the defendant. Therefore, the contention of the defendant that Section 30 of the Trade Marks Act comes to his aid cannot be countenanced. Section 30 of the Trade Mark Act can be pressed into services only when there is honest practices in industrial or commercial matters and there is no unfair advantage or detriment to the distinctive character or repute of the Trade Mark, then only section 30 of the Act come to the aid of the defendant. The other contention of the defendant that the plaintiff had obtained registration only in class 10 whereas the defendant has obtained the registration for services dealing with their products under class 44. Therefore, the registration obtained under clause 10 cannot be extended to defendant service.

16. It is to be noted that both the plaintiffs and the defendants are dealing with hearing aids. Whether they are manufacturers or mere sellers to the third parties, but the subject matter of the trade is apparatus and hearing aid. In fact, if two persons are carrying on business in the same name. it will lead to confusion among the consumers. Therefore, the contention of the defendant in this regard cannot be countenanced. Ex.D.13 invoices filed by the defendant

clearly indicate that they are also dealing with Hearing Aid. As per Ex.D.12, the defendant also obtained certificate under GST for 'Afru Hearing Aid Centre'. Ex.D.11 indicate that the defendant had changed their address to some Kodambakkam High Road where the plaintiff is doing business. These facts clearly indicate that the defendant is adopting the same mark despite having obtained registration only for 'Afru' and using 'Hearing Aid Centre' which clearly indicate that the defendant, has in fact, dishonestly adopted the trade name of the plaintiff. Ex.D3 and Ex.D.4 clearly indicate that the trade mark of the defendant is 'Afru'. The logo under Ex.P.4 trade mark is ear logo. They have obtained registration under class 44 and the defendant deal with medical consultancy lead by hearing loss. The plaintiff registration under clause 10 deals with the hearing parts and Therefore, merely because the plaintiff had obtained registration under different clause cannot be said that the nature of business of both the parties are totally different. Per se, the business of both sides is only with regard to hearing aids. In both the cases, consultancy is required. In both the business, consultancy and advice including medical device is required. Such being the position, when the plaintiff has registered their trademark by 'Hearing Aid Centre' and continuously using the same and the registration is not put into challenge and no application has been filed for revocation of the trademark, such

mark, necessarily, has to be protected under section 29 of the Trade Mark Registration Act.

17. Section 29 of the Trade Mark Registration Act reads as follows :

29. Infringement of registered trade marks.—

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

- (a) is identical with or similar to the registered trade mark; and
- (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and
- (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

- (a) affixes it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;
- (c) imports or exports goods under the mark; or
- (d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

- (a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or
- (b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.

A careful perusal of Sub Clause 2 of Section 29 makes it clear that identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark. Sub clause 2 and 4 is squarely applicable to the facts of the case.

18. In **S.Syed Mohideen Vs. P.Sulochana Bai** reported in **2016 (2) SCC 683** the Honourable Supreme Court has held that no one can be permitted to encroach upon the goodwill and reputation of other party, particularly when a specific mark, though may be a descriptive word, has acquired a subsidiary meaning and it is the obligation of the Court not only to protect the goodwill and reputation of the prior user, but also to protect the interest of the consumer.

19. In **Ramdev Food Products (P) Ltd. Vs. Arvinbhai Rambhai Patel & Others** reported in **2006 (8) SCC 726**, the Honourable Supreme Court has held as follows :

In The Modern Law of Trade Marks by Christopher

Morcom, Butterworths 1999, it is stated:

"The concept of distinguishing goods or services of the proprietor from those of others was to be found in the requirements for a mark to be registrable. Essentially, whatever the wording used, a trade mark or a service mark was an indication which enabled the goods or services from a particular source to be identified and thus distinguished from goods or services from other sources. In adopting a definition of 'trade mark' which simply describes the function in terms of capability of 'distinguishing the goods or services of one undertaking from those of other undertakings' the new law is really saying precisely the same thing."

The above makes it clear that the primary function of a trademark is to distinguish their products/services from that of others. The question of whether it is descriptive or distinctive in a trademark sense is relevant only for registration of a trademark. Whereas, the defendant has not challenged the registration of the trademark so far.

20. In Himalaya Drug Co Vs. S.B.L. Limited reported in 2013 (53) PTC 1 [Delhi DB] the Division Bench of Delhi High Court has held that

"45. The learned Single Judge has not considered the voluminous evidence produced by the plaintiff, several orders obtained, notice issued and undertaking obtained from the various parties using the LIV as prefix to their respective trade

marks. The evidence of PW-3 to PW-6 was completely ignored by the learned Single Judge who had approved survey report of the mark LIV. The plaintiff was able to adduce the evidence that it was a fit case of likelihood of confusion and deception and the two marks are deceptively similar.

46. Following the dictum of Cadila (supra) and tests laid down by the Supreme Court from time to time and also the material available on record, it can be said that for the purposes of comparison of the mark Liv.52 and LIV-T, the word LIV represented in a particular form cannot be excluded for the purposes of measuring the deceptive resemblance. This is more so when we have arrived at the finding that there is no sufficient material showing the user of the word LIV written in isolation which establishes the generic nature of the component and there is no also non establishment of material facts leading up to generic nature of the word.”

21. In **Pidilite Industries Limited Vs. Jubilant Agri & Consumer Products Limited** reported **2014 (57) PTC 617 [Bom]**, the Bombay High Court has held that

“16. The Defendant has also relied on **Section 17** of the Act in support of its KPPNair 30 NMSL 1717 of 2013 contention

that the Plaintiff cannot restrain the Defendant in any manner from using the word 'MARINE'. In this context, the arguments of the Defendant are as follows:

(i) [Section 17](#) (1) of the Act prescribes that, in the case of a 'composite mark' (namely a mark consisting of several matters), the exclusive right conferred by registration, is on the trademark taken as a whole;

(ii) [Section 17](#) (2) (b) of the Act expressly prescribes that where a composite mark contains matter which is common to the trade or is otherwise of a non-distinctive character, registration of the composite mark shall not confer any exclusive rights in the matter forming only a part of the whole of the registered mark;

(iii) In other words, the statute does not grant protection (exclusivity) over such parts or constituents of a composite mark, which are 'common to the trade' or of a 'non-distinctive character';

(iv) The word 'MARINE' forms a part or constituent of the composite mark "FEVICOL MARINE". In relation to the goods to which it is applied/used, the word 'MARINE' is common to the trade and/or of a non-distinctive character.

Consequently, by reason of [Section 17](#) (2) (b), the Plaintiff cannot claim any exclusivity;

(v) The Plaintiff's reliance on the fact that the Registrar whilst granting registration, did not impose a condition or limitation (qua the word 'MARINE') is of no assistance, since the provisions relating to "disclaimer" (existing in the 1958 Act) have been deleted in the 1999 Act. The reason for the deletion of the

provisions KPPNair 31 NMSL 1717 of 2013 relating to disclaimer is because [Section 17](#) explicitly clarifies the legal position that there is no exclusivity in respect of descriptive or non-distinctive constituents or parts of a registered mark. Therefore, the requirement of a disclaimer provision is unnecessary. Reliance in this behalf is placed on the Statement of Objects and Reasons of [Section 17](#), which are extracted at page 17 of the Defendant's submissions; and

(vi) If this test is applied, then the marks to be compared are "JIVANJOR MARINE PLUS" and "FEVICOL MARINE". These are not deceptively similar.

16.1 The Defendant has sought to suggest that by reason of the deletion of provisions relating to disclaimer, the Registrar cannot impose any conditions or limitations whilst granting registration. As correctly submitted by the Plaintiff, this suggestion is contrary to the provisions of the 1999 Act i.e. [Sections 18 \(4\), 20 \(1\) and 23](#) of the Act which expressly authorise and empower the Registrar, at the stage of acceptance and advertising of applications, to impose, inter alia conditions or limitations on the mark applied for. The submission relating to disclaimer by the Defendant is therefore of no substance.

16.2 It is true that the registration of a composite mark confers upon the registered proprietor a monopoly over the trademark taken as a whole. It is not the Plaintiff's contention that the registration of a composite mark confers upon the registered proprietor exclusivity over each and every constituent part thereof (no matter how minuscule or insignificant it may be in relation to

the mark considered KPPNair 32 NMSL 1717 of 2013 as a whole). The Court therefore has to examine the mark as a whole. As a part of this evaluation process, the Court is required to determine what is/are the prominent and/or essential features of the mark taken as a whole. The protection and/or exclusivity will be conferred on these features and not on insignificant trivia. This Court has therefore at the outset after considering the relevant factors prima facie come to the conclusion that the word 'MARINE' forms a prominent and/or essential feature of the registered trademark (considered as a whole) . If the Defendant's arguments are accepted, the consequences will be startling. Composite marks will become useless. The same will be infringed with impunity by the simple expedient of using a trademark which has, as its essential or prominent feature(s), the essential and prominent feature of the registered mark with the addition of other matter. The mandate of [Section 17 \(1\)](#) will be totally frustrated.

16.3 Again, in my view, nothing in [Section 17 \(2\)](#) of the Act bars the Plaintiff's entitlement to the relief as claimed. [Section 17 \(2\) \(a\)](#) is plainly not applicable . The defendant does not even claim so. The Defendant's only claim that [Section 17 \(2\) \(b\)](#) of the Act bars the grant of relief in the Plaintiff's favour. The Defendant's claim in this behalf is premised on the assumption that the word 'MARINE' is 'common to the trade' and/or 'of a non-distinctive character'. For this plea to succeed, the Defendant must establish that the word 'MARINE' is either 'common to the trade' or 'of a non-distinctive character'. The onus to do so is

entirely on the Defendant. As set out herein, the Defendant has failed to discharge the burden or onus upon them.

16.4 The aforestated reliance on [Section 17](#) of the Act and the submissions made in thereto by the Defendant therefore cannot be accepted and are rejected.

22. In **Godfrey Philips India Ltd. Vs. Girnar Food & Beverages (P) Ltd.** reported in **2004 (5) Supreme Court Cases 257**, the Honourable Supreme Court has held as follows :

4. Without going into the question whether the conclusion arrived at by the Division Bench that the trade mark is descriptive is correct or not, it appears to us, and as is conceded by both parties before us, that the enunciation of principle of law with regard to the protection available even in respect of the descriptive trade mark was wrong. A descriptive trade mark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source. We, therefore, remand the matter back to the Division Bench of the High Court so that it may address its mind to this question without disturbing the other conclusions arrived at this stage. In the event, the Division Bench answers the additional

issue formulated by us against the appellant, it will be open to the appellant to raise all the issues which have already been concluded and which are the subject matter of this appeal in any further appeal as it may be entitled to prefer from the final decision of the Division Bench. The Division Bench is directed to dispose of the appeal as expeditiously as is conveniently possible. It is made clear that the trial of the suit may also be proceeded with and concluded expeditiously without being inhibited either by the pendency of the appeal or by any observation in the orders of the High Court on the interlocutory application.

23. In line with the above judgments, the facts of the present case, infact as discussed above, is very clear that the plaintiff is not only prior user of the logo 'Hearing Aid Centre' but also obtained registration certificate. The documents filed by the plaintiff clearly establish the nature of business of the plaintiffs and income tax returns filed also clearly establish that they have gained reputation and goodwill. The letter of the then President also clearly indicate that the the plaintiffs' 'Hearing Aid Centre' acquired very good reputation. Besides, they are not only prior user of the trade mark but also they got registered the trade mark. When both the trade mark of the plaintiffs and defendant is

compared, in order to come to the conclusion, whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are differences, rather overall similarity has to be judged. While judging the question as to whether the defendant has infringed the trademark or not, the Court has to consider the overall impression of the mark in the minds of the general public and not by merely comparing the dissimilarities in the two marks. In the present case, the defendant is using 'Hearing Aid Centre' prominently whereas its registered trade mark 'Afru' has been used in smaller size. The use of the trade mark of the plaintiff by the defendant is phonetically and visually similar and it would lead to confusion and deception to the persons of average intelligence. Since, both the plaintiffs and the defendant deal with Hearing Aid Centre the same will lead to confusion. The trade mark 'Hearing Aid Centre' is a registered trade mark of the plaintiff and without challenging the trademark, the use of the 'Hearing Aid Centre' the trade mark of the plaintiff, is nothing but infringement of the trademark of the plaintiffs' registered trade mark. The defendant is certainly not entitled to use the trademark 'Hearing Aid Centre'. Further it is for the defendant, if advised, to use some other mark accompanied by suffix examples which are given in the para 10 of the plaint. Accordingly, the issues are answered in favour of the plaintiff.

24. Accordingly, the suit is decreed as prayed for with cost for permanent injunction for prayers a and b. As far as prayer 'c' is concerned, since the defendant is dealing with similar business from the year 2013, the suit is dismissed.

30.10.2019

vrc

Index : Yes/ No

Internet : Yes

Speaking/Non-speaking Order

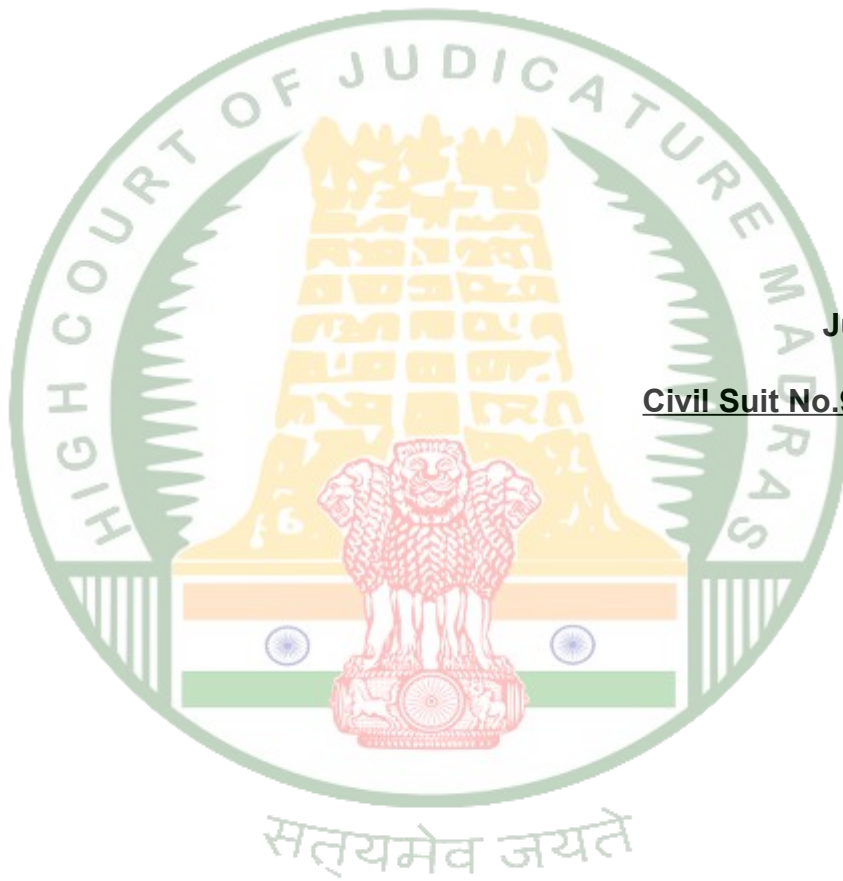


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C.S.No.942 of 2017

N.SATHISH KUMAR, J.

vrc



Judgment in
Civil Suit No.942 of 2017

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30.10.2019