

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 11.02.2020

CORAM

THE HONOURABLE MR. JUSTICE M.M. SUNDRESH
AND
THE HONOURABLE MR. JUSTICE KRISHNAN RAMASAMY

O.S.A.Nos.329 & 330 of 2019

1. Mahendra T.Thakkar

Trading as Prakash Trading Co.,
Pillaiyar Kula, Inamkarisalkulam P.O.,
Srivilliputhur - 626 125

And also at
Jalaram Parkchali, No.1, Jaska Road,
Harij - 384 240, Gujarat.

2. Tribhuvandas V.Thakkar,

Trading as Prakash Kumar Tribhuvandas
Jalaram Parkchali, No.1, Jaska Road,
Harij - 384 240, Gujarat.

... Appellants
in both OSAs

Vs.

N.Ranga Rao & Sons Private Ltd.,
PB No.52, Vani Vilas Road,
Mysore - 570 004

And whose branch office is at
T.S.109, Block No.3, Poomagal,
5th Street, Ekkaduthangal,
Chennai - 600 097.

... Respondent
in both OSAs

PRAYER : Appeals filed under Order XXXVI Rule 1 of O.S. Rules
r/w under Clause 15 of Letters Patent Act against the order
dated 25.10.2019 passed in Appln.Nos.7501 & 7502 of 2018 in
O.A.Nos.470 & 471 of 2018 in C.S.No.294 of 2018.

For Appellants
(in both OSAs) : Mr.K.Rajasekaran

For Respondent
(in both OSAs) : Mr.P.S.Raman, Senior Counsel
for Mr.Rajesh Ramanathan

COMMON JUDGMENT
(Delivered by M.M.SUNDRESH, J)

These appeals are directed against the order dated 25.10.2019 passed in Appln.Nos.7501 & 7502 of 2018 in O.A.Nos.470 & 471 of 2018 in C.S.No.294 of 2018.

2.The appellants are the defendants in the suit. The suit has been laid for infringement and passing off. It is the contention of the respondent/plaintiff that the mark has been registered and they are the prior user.

3. A defence has been taken before the learned Single Judge that the mark has been registered pursuant to the objection made on the premise that the respondent has categorically made a statement in writing that it is only to be used for complimentary purposes. A further plea has been taken that the appellants have been using the mark from the year 2007 onwards.

4. The learned Single Judge granted an order of injunction which has been in force from the year 2018 onwards on the premise that the appellants are trying to ride on the reputation of the respondent. The fact that the earlier registration has been done in the year 1950 for Agarbathi followed by subsequent registration in the year 1992 for Safety Matches, meant to be used as complimentary, cannot be a factor to continue the order of injunction. One has to see the reputation of the respondent as against the appellants. After all, they are indirectly involved in the same market being interconnected with the nature of usage. Accordingly, taking into consideration the prior registration of usage, the order of injunction has been made absolute.

5. The learned counsel appearing for the appellants submitted that the trademark registration has been granted pursuant to the order dated 07.02.2011 on the premise that the respondent is not meant to use the same for the commercial purpose. Therefore, there cannot be an order of injunction when the respondent/plaintiff wants to use it for the commercial purposes.

6. The learned Senior Counsel appearing for the respondent/plaintiff submitted that not only there is prior registration but also prior usage. It is irrelevant to take into consideration the nature of usage. Thus, the order of the learned Single Judge will have to be confirmed as the order has been passed on consideration of the relevant materials, the judgment of the Apex Court in Wander Ltd and another v. Antox India Private Limited reported in (1990) Supp SCC 727 will have to be taken into consideration.

7. We have perused the order of the learned Single Judge and took note of the arguments made.

8. The learned Single Judge has considered the relevant materials and passed a speaking order. A factual finding has been given on the reputation of the respondent's mark. On the question of similarity also, there is no dispute. Therefore, merely on the ground that the mark has been obtained to use the product only as complimentary cannot be a factor for the appellants to infringe it. The trademark is to be used for the complimentary purpose or otherwise has got no rationale with respect to the infringement alleged. We also note that the injunction order has been in force from the month of April 2018, till now. Thus, looking from any perspective, we do not find any reason to interfere with the order of the learned Single Judge.

9. Accordingly, the Original Side Appeal stands dismissed. However, our observation being prima facie in nature, will not have any bearing on the learned Single Judge in deciding the legal issues apart from other factual issues at the time of deciding the suit. Since the suit is a commercial litigation, we request the learned Single Judge dealing with the commercial cases to expedite the process of hearing during the case management. No Costs. Consequently, connected C.M.P.Nos. 27027 & 27031 of 2019 are closed.

Sd/-

सत्यमेव जयते
Assistant Registrar(CS I)

//True Copy//

Sub Assistant Registrar

ssm

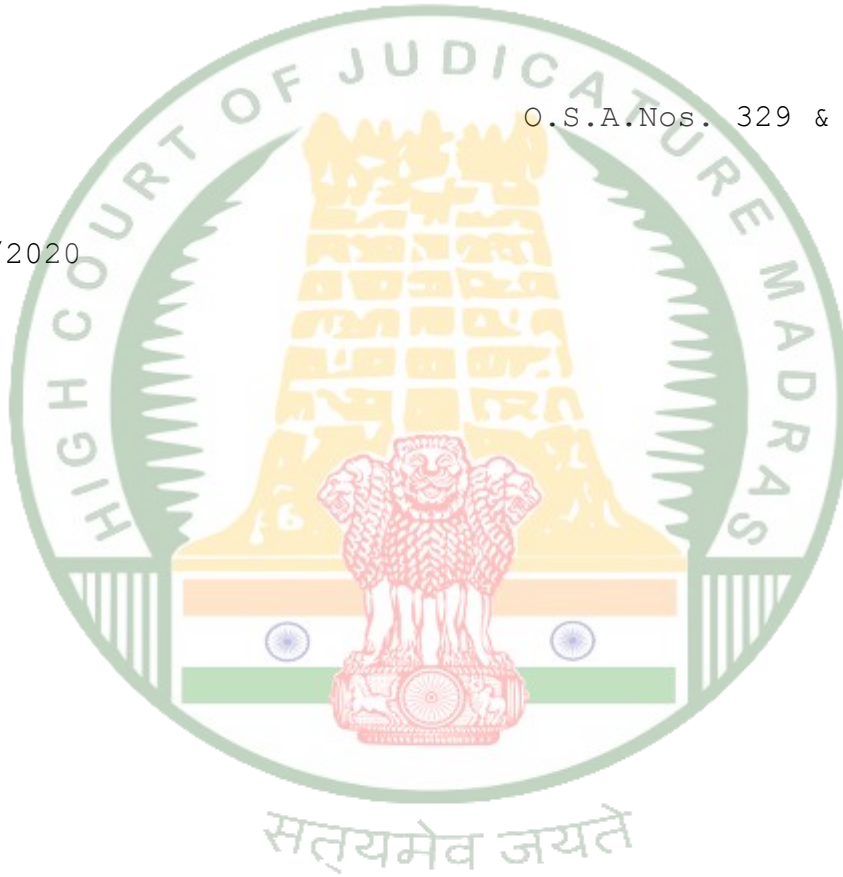
To

The Sub Assistant Registrar
Original Side
High Court, Madras.

+1cc to Mr.Rajesh kamanathan, Advocate, S.R.No.10693
+1cc to Mr.K.Rajasekaran, Advocate, S.R.No.11680

O.S.A.Nos. 329 & 330 of 2019

BS (CO)
KKV/15/06/2020



WEB COPY