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IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on :23.03.2021
Pronounced on :30.03.2021

Coram:

THE HONOURABLE DR. JUSTICE G. JAYACHANDRAN

Appeal Suit No.499 of 2005

Indcon Structurals Pvt. Ltd.,
Represented by its Director D.P.Devnath,
No.161, Greams Road,
Chennai 600 006.

...Appellant/Plaintiff

/versus/

1.Beton Tile Company,
No.7-A, Laxman Road,
Kandanchavady,
Chennai 600 096.

2.Iqbal

3.Nazmuddin

4.Mr.Huzaiffa Zueb

5.Mrs.Bani Mufaddal

6.Mr.Kuzema Zainuddin

7.Indian Ceramic Company,
93, Kutchery Road,
Mylapore, Chennai 600 004.

8.Ali Akbar

...Respondents/Defendants

Prayer: Appeal Suit has been filed under Section 96 of the Code of Civil Procedure, 1908, to set aside the judgment and decree dated 31.03.2003 made by the Additional District and Sessions Judge(Fast Track Court No.II), Chennai in O.S.No.895 of 1998 and allow this appeal.

For Appellant :Mr.K.Ashok Kumar for
Mr.J.Viswananthan



For Respondents: No appearance

JUDGMENT

(The case has been heard through Video Conferencing)

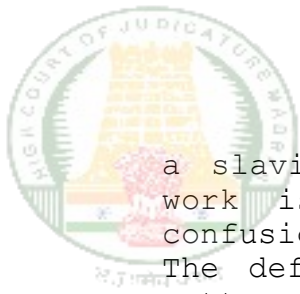
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This appeal is by the plaintiff, who lost the suit filed for permanent injunction restraining the defendants from any manner passing off the product by name 'Diana' with butch work on pre-polished cement concrete wall tiles and for rendition of account.

2.The plaint averments are as below:-

The plaintiff is the largest manufacturer of prepolished cement concrete tiles in India and they are carrying on business since 1984. They are manufacturing and marketing different types of tiles under the trade mark "EUROCON". It is a registered trade mark under Act. The plaintiff company is a pioneer in semi indoor and outdoor applications and external wall claddings and having turn over for more than Rs.565 lakhs during the year 1996-1997 and for publicity it has spent substantial money for the past five years and its expenditure on publicity for the financial year 1996-1997 alone is Rs.126.3 lakhs. In the course of its business, the plaintiff had developed a particular variety of tile, which is manufactured and marketed under the trade name/trade mark 'MONALISA' from 1993. This variety is being used widely for lobby walls of hotels, corporate offices, restaurants, board rooms, conference halls and exteriors of highrise buildings. The uniqueness and speciality of this tile stems from the craft of butch work, which has been done to the tiles. Traditionally butch work was done by chiseling manually on natural stones manually like, marble and sand stone. The plaintiff company invented the manufacture of tiles with butch work in pre-polished cement concrete wall tiles instead of artificial stone. These tiles have a unique and distinctive appearance. The plaintiff company manufacture these tiles in a particular pattern using vibration technique in pre cast concrete. The plaintiff company was first to introduce pre-polished cement concrete tiles with butch work in Indian market, after spending huge amount in inventing the technique. The butch work in pre-polished cement concrete manufactured and marketed by the plaintiff company has been identified with the plaintiff company exclusively.

3.While so, they came across the cement concrete tiles with butch work which are an exact imitation of the plaintiff company's unique tiles with butch work. On enquiry, the plaintiff came to understand that the same is being manufactured by the first defendant and marketed by the seventh defendant. The said action of the defendants in manufacturing and marketing



a slavish imitation of cement concrete wall tiles with butch work is illegal and amounts to passing off by creating confusion in the minds of the trade and the consuming public. The defendants have slavishly and religiously copied the four patterns in the plaintiff company's tiles 'MONALISA' which will clearly show the dishonest intention and motive of the defendants. Hence, the suit filed for the following relief granting permanent injunction:-

"(a)granting a permanent injunction restraining the defendants their men, servants, agents or anyone acting or claiming under them from in any manner passing off their inferior quality prepolished cement concrete wall their tiles with butch work under the trade mark/name 'Diana' or any other trade mark/name as and for the unique prepolished cement concrete wall tiles with butch work manufactured for and marketed by the plaintiff under the trade mark 'Eurocon Monalisa' either by manufacturing or by marketing or selling or offering for sale or in any manner advertising the same.

(b)directing the defendants to render a true and faithful account of the profit earned by the sale of the offending prepolished cement concrete wall tiles with butch work and directing payment of the same as damages for the passing off committed by the defendants.

(c)directing the defendants to surrender to the plaintiffs the entire stock of the unused offending tiles together with the moulds, dyes machines etc., used for manufacturing the said tiles for destruction;

(d)directing the defendants to pay the plaintiffs the costs of the suit."

4.The first defendant filed written statement wherein the averments made in the plaint were stoutly denied. The claim of the plaintiff that they are the pioneer in the pre-polished cement concrete tile is denied and it is contended that there is nothing distinctive about the tile marketed under the name and style 'MONA LISA'. Even assuming that butch work by a semi-automatic machine production procedure was introduced by the plaintiff, the same is not a process, that has been patented by the plaintiff. It is also not possible to patent the process any longer as several companies in India and abroad are adopting this manufacturing process. The plaintiff is not entitled to



claim monopoly over the same. The plaintiff cannot acquire any proprietary right over the manufacture of pre-polished concrete tiles with butch work whether the butch work is manual or semi-automatic. The claim of the plaintiff that the cement concrete tiles with butch work have come to be associated exclusively with the plaintiff is false and no company can claim a monopoly over the manufacturing process, which is common to the trade and not the subject matter of a patent. The plaintiff cannot claim any protection in respect of the design which is not the subject matter of the protection under Designs Act.

5.The claim of the plaintiff that their pre-polished cement concrete tiles with butch work has unique shape and unique texture is denied. The first defendant commenced the manufacturing pre-polished cement concrete tiles with butch work in the year 1996. The surface and texture of the tile manufactured by the first defendant is different from the surface and texture of the tile manufactured by the plaintiff. The components of the tiles manufactured by the defendant are different from the components of the tiles manufactured by the plaintiff company. Size and weight of the tiles manufactured by the plaintiff company in the name of 'MONA LISA' is different from the tiles manufactured in the name and style of 'DIANA' by the defendant. The defendant's product varies from that of the plaintiff's product in respect of size, colour, scheme and get up. Therefore, there is no likely hood of deception and there is no intention to deceive by passing off the goods of the first defendant as that of the plaintiff. The products of the defendant are not slavish imitation of the plaintiff's product. The first defendant has etched the name 'BETON' in every tiles in order to identify the trade connection and to avoid any confusion. These products are purchased by well informed customers like Architects, Interior Decorators and Builders. Therefore, the question of deception does not arise.

6.Alleging that the suit is filed by the plaintiff to gain illegal monopoly over the manufacture of pre-polished concrete cement tiles with butch work by eliminating competition, therefore, sought for dismissal of the suit with exemplary costs.

7.This written statement of the first defendant adopted by defendants 2 and 3 and also by defendants 7 and 8.

8.The trial Court, based on the pleadings had formulated the following issues:-

(1)Whether the plaintiff is entitled for permanent injunction as prayed?



(2)What other relief the plaintiff is entitled?

9.One witness on each side were examined. 26 exhibits on the side of the plaintiff and 7 exhibits on the side of the defendants were marked.

10.The trial Court, after considering the evidence, has held that the products of the plaintiff and the defendants are not one and the same. Butch work was done on natural stones earlier and later, done on artificial stone by use of technology. They cannot be exclusive monopoly of butch work. The plaintiff admits that before manufacturing and marketing pre-cast concrete tiles with butch work, natural stones with butch work were marketed. Therefore, the averments of passing off the product of the defendants as that of the plaintiff has not been proved and there is no evidence to hold that the imitation caused confusion in the mind of the trade and consumer.

11.Aggrieved by the above finding, the appeal is filed on the ground that the reason given by the trial Court is erroneous and the trial Court has not properly discussed the rival submission and the contention. The trial Court erred in holding that the butch work has already been existing in natural stone and therefore, the plaintiff is not entitled for the relief. This tantamount is begging the question as it is specific case of the plaintiff that for the first time it brought to market the butch work in pre-polished cement concrete tiles. The butch work effect in pre-polished cement concrete tiles was for the first time introduced by the plaintiff in the Indian market at the rate of 1/3rd cost of the natural stone. The trial Court erred in holding that the customers of pre-polished butch work tiles are informed customers and not ordinary people to be deceived. The reasoning is factually in correct and cannot exonerate the defendants from mischief of passing off. The evidence of PW-1 has not been properly appreciated by the trial Court and the Court has completely ignored and brushed aside the evidence placed before the Court to prove the fact that the defendants had introduced their look a like tile 'DIANA' in the market, much after the plaintiff.

12.The learned counsel appearing for the appellant would submit that the trial Court had not properly appreciated the evidence and the law of passing off, while distinctive case made against the defendants. He would submit that the defendants admits that the butch work on pre-casting tiles was first introduced by the plaintiff in the Indian Market. While so, the slavish imitation by the defendants having proved through the evidence of PW-1. Those exhibits has not been considered by the trial Court. The test for passing off must be from the view of a person with ordinary intelligence and not that of the



professionals. This basic principle, the trial Court has failed to take note and had held that tiles with butch work is purchased only by architects, designer and builders, who are well informed customers.

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13. Point for consideration is that whether marketing the artificial tiles with butch work amounts to passing off the product of the defendants as that of the plaintiff?

14. The test for passing off is where the use of a name or get up which is calculated to cause confusion with the goods of a particular rival trader. The law as to passing off is concerned with unfair competition between the traders. It is an actionable wrong for a trader so to conduct his business as to lead to the belief that his goods, services or business are the goods, services or business of another.

15. As far as the facts involved in the instant case, thrust is on the manufacturing process of the artificial tiles with butch work. As pointed out in the written statement of the defendants, neither manufacturing process is registered under the Patent Law nor the design found on the tiles 'MONOLISA' is registered under the Designs Act.

16. The contention of the plaintiff is that, they have invented manufacturing pre-cast concrete tiles with butch work and started marketing in India since 1993. Therefore, they hold monopoly over the said art and manufacturing patent. Therefore, the defendants cannot use the said technology and sell the product under the name 'DIANA', which will amount to passing off. Contrarily, the defendants, by placing before the Court the samples of their product as well the plaintiff's product, had proved before the Court that their size, scheme and texture are different and they have no intention to sell their product as that of the plaintiff. They have their unique size and texture. Mere use of butch work technology on artificial stone will not amount to passing off. The butch work technology is known universally and applied universally. The material upon which such butch work is applied, is now distinguished by the plaintiff to claim monopoly. Neither the technology nor the process can be monopolised by the plaintiff for a simple reason that the technology and process have now been universally adopted by several manufacturers. Prior user principle will not apply to the case of the plaintiff. More so, when the suit is filed on the ground of passing off and not on infringement of any existing patent right or design right. This Court on considering the pleadings and evidence finds that the trial Court has rightly dismissed the suit and there is no material to interfere with the trial Court judgment in the appeal.



17. Accordingly, this Appeal Suit is dismissed. No order as to costs. The judgment and decree dated 31.03.2003 made by the Additional District and Sessions Judge, (Fast Track Court No.II), Chennai in O.S.No.895 of 1998 is confirmed.

s/d-
Assistant Registrar(CS-I)

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Sub-Assistant Registrar

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To:

The Additional District and Sessions Judge,
Fast Track Court No.II,
Chennai.

Copy to
The Section Officer
VR Section
High Court, Madras 104.

+1 Cc to Mr.J.Viswananthan, Advocate sr 21259.

A.S.No.499 of 2005

BR(CO)
SP(21/10/2021)