

O.A.Nos.530 to 535 of 2020
in
C.S.No.285 of 2020

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on :19.04.2021

Pronounced on :23.04.2021

Coram:

THE HONOURABLE DR. JUSTICE G. JAYACHANDRAN

O.A.Nos.530 to 535 of 2020

in

C.S.No.285 of 2020

O.A.No.530 of 2020:

M/s V.N.C. Electrodes,
No.3, Industrial Estate,
S.Vellalapatti, Karur 639 004, T.N.,
Administrative Office at 11/4,
MRC Nagar, Raja Annamalaipuram,
Chennai, Tamil Nadu 600 028,
A Registered Partnership
Firm represented by its
Managing Partner C.Basker

..Applicant/Plaintiff

/versus/

M/s Royal Welding Wires Private Limited
No.2, Uthiramerur Road,
Malaiyapalayam P.O. 603 303,
Mathuranthagam Taluk,
Kanchipuram District.

.. Respondent/Defendant

Prayer: Application has been filed under Order XIV, Rule 8 of O.S. Rules read with Order XXXIX, Rules 1 & 2 of C.P.C., read with the Commerical Courts, Commercial Division and Commerical Appellate Division of High Courts Act, 2015, praying to grant an interim injunction restraining the respondent/defendant, its men, relatives, servants, agents or anyone claiming through or under them from, in any manner from infringing the copyright pertaining to the artistic work comprised in the carton filed as material object No.2 or any other colour combination/essential features which are similar to or in any way deceptively similar or the colourable imitation of the applicant/plaintiff's carton pending disposal of the suit.

For Applicant :M/s Ram and Rajan and Associates
Mr.T.K.Ramkumar

For Respondent :Mr.M.S.Bharath

A.No.531 of 2020:

M/s V.N.C. Electrodes,
No.3, Industrial Estate,
S.Vellalapatti, Karur 639 004, T.N.,
Administrative Office at 11/4,
MRC Nagar, Raja Annamalaipuram,
Chennai, Tamil Nadu 600 028,
A Registered Partnership
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/versus/

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.. Respondent/Defendant

Prayer: Application has been filed under Order XIV, Rule 8 of O.S. Rules read with Order XXXIX, Rules 1 & 2 of C.P.C., read with the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015, praying to grant of an interim injunction restraining the respondent/defendant from either by manufacturing or selling or offering for sale or in any manner advertising the applicant/plaintiff's trade marks on welding electrodes, arc welding electrodes, automatic and semi-automatic welding equipment being the goods covered by the applicant/plaintiff's registration and also being the goods manufactured and sold by the defendant pending disposal of the suit.

For Applicant :M/s Ram and Rajan and Associates
Mr.T.K.Ramkumar

For Respondent :Mr.M.S.Bharath

A.No.532 of 2020:

M/s V.N.C. Electrodes,
No.3, Industrial Estate,
S.Vellalapatti, Karur 639 004, T.N.,
Administrative Office at 11/4,
MRC Nagar, Raja Annamalaipuram,
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A Registered Partnership

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O.A.Nos.530 to 535 of 2020
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..Applicant/Plaintiff

/versus/

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For Applicant

:M/s Ram and Rajan and Associates
Mr.T.K.Ramkumar

For Respondent

:Mr.M.S.Bharath

A.No.533 of 2020:

M/s V.N.C. Electrodes,
No.3, Industrial Estate,
S.Vellalapatti, Karur 639 004, T.N.,
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..Applicant/Plaintiff

/versus/

M/s Royal Welding Wires Private Limited
No.2, Uthiramerur Road,
Malaiyapalayam P.O. 603 303,
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Kanchipuram District.

.. Respondent/Defendant

Prayer: Application has been filed under Order XIV, Rule 8 of O.S. Rules read with Order XXXIX, Rules 1 & 2 of C.P.C., read with the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015, praying to grant of an interim injunction restraining the respondent/defendant its men, relatives, servants, agents or anyone claiming through or under them from, in any manner, infringing the applicant/plaintiff's trademark "BEST WELD", written in a stylized manner, using such offending trademark or any other mark or marks which are identical/similar or in any way deceptively similar to or a colourable imitation of the applicant/plaintiff's trademark or any other brand

name/mark or otherwise; until such period that the applicant/plaintiff's trademark is valid and subsisting pending disposal of the suit.

For Applicant :M/s Ram and Rajan and Associates
Mr.T.K.Ramkumar

For Respondent :Mr.M.S.Bharath

A.No.534 of 2020:

M/s V.N.C. Electrodes,
No.3, Industrial Estate,
S.Vellalapatti, Karur 639 004, T.N.,
Administrative Office at 11/4,
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/versus/

M/s Royal Welding Wires Private Limited
No.2, Uthiramerur Road,
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Prayer: Application has been filed under Order XIV, Rule 8 of O.S.
Rules read with Order XXXIX, Rules 1 & 2 of C.P.C., read with the

Commerical Courts, Commercial Division and Commerical Appellate Division of High Courts Act, 2015, praying to grant of an interim injunction restraining the respondent/defendant its men, relatives, servants, agents or anyone claiming through or under them from, in any manner, infringing the applicant/plaintiff's trademark "VNC" using such offending trademark or any othe rmark or marks which are similar or in any way deceptively similar to or a colourable imitation of the applicant's/plaintiff's trademark or any other brand name/mark or otherwise; until such period that the applicant's/plaintiff's trademark is valid and subsisting pending disposal of the suit.

For Applicant :M/s Ram and Rajan and Associates
Mr.T.K.Ramkumar
For Respondent :Mr.M.S.Bharath

A.No.535 of 2020:

M/s V.N.C. Electrodes,
No.3, Industrial Estate,
S.Vellalapatti, Karur 639 004, T.N.,
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.. Respondent/Defendant

Prayer: Application has been filed under Order XIV, Rule 8 of O.S. Rules read with Order XXXIX, Rules 1 & 2 of C.P.C., read with the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015, praying to grant of an interim injunction restraining the respondent/defendant its men, relatives, servants, agents or anyone claiming through or under them from, in any manner, passing off of the applicant's/defendant's composite label along with the red and rose colour combination as and for of the applicant's/plaintiff's trade mark label, containing the word "BEST WELD" or "BEST ARC" alone or with the marks in a specialized manner, with an image in between the words "BEST" and "WELD" or "BEST" and "ARC" as the case may be, device of a an with his arms spread out, and an arc drawn from one hand to the other, in colour scheme, get up, font and layout, using the offending trade mark or any other mark which is identical to or deceptively similar to or in any way a colourable imitation of the applicant's/plaintiff's trade marks, either by manufacturing, selling or offering for sale or advertising or in any other manner pending disposal of the suit.

For Applicant

:M/s Ram and Rajan and Associates
Mr.T.K.Ramkumar

For Respondent

:Mr.M.S.Bharath

COMMON ORDER

(The case has been heard through Video Conferencing)

The plaintiff, is a registered partnership firm, carrying business as manufacturer, marketer and distributor of welding electrodes, bending wire, fencing, solutions, Tiscon super links and such other products. They had adopted the trademark “BEST WELD”. They also have a particular red and rose coloured label, containing the trademark of a device letter “O and V”, being representing in a particular manner. Though the plaintiff has adopted the particular trademark of “BEST ARC”, in respect of welding electrodes, the label also consists of a red and rose colour, in combining with the word “BEST ARC” with an image in between the words “BEST and ARC” of a man with his arms spread out, and an arc drawn from one hand to the other. The plaintiff has also established and registered the mark “VNC”.

2.It has been further specifically stated that the plaintiff has been using the marks “BEST WELD”, “BEST ARC” and “VNC” with a

particular shade and label, with respect to their welding electrodes since 1998, which are manufactured and sold by the plaintiff. The plaintiff has also the benefit of registration of all the above marks and labels, both under the Trademarks Act, 1999, and under the Copyrights Act, 1957.

3.The defendant, who is also in the very same business appears to have infringed the marks of the plaintiff by marketing their products under the name “BEST WELD” and also using the image of a man with his arms spread out with an arc in between the two hands.

4.This Court, on earlier occasion, after considering the prayer in these applications and the similarity found in the defendant's product religiously imitating the plaintiff's trademark and colour combination, granted interim injunction on 28.10.2020. Thereafter, the said order was vacated on 17.12.2020 for non-compliance of the mandatory provision under Order 39, Rule 3(a) of the C.P.C.

5.Meanwhile, this Court has appointed Advocate Commissioners to make inspection of the respondent's premises as well as one of the shops at Chennai, where the alleged infringed product sold. The Commissioners have filed their respective reports. The reports of the Advocate Commissioners substantially support the case of the applicant/plaintiff.

6.The respondent/defendant had filed a detailed counter in the injunction applications for which the applicant also filed re-joinder.

7.The specific case of the applicant/plaintiff is that being the registered proprietor of the trademark “BEST WELD” with letter “V” inscribed upon letter “O” and the registered proprietor of the trademark “BEST ARC” with letter “V” inscribed on letter “O” for the goods falling under Class 9 (Welding Electrodes, ARC Welding Electrodes, Automatic and Semi-Automatic Welding Equipments in class 9 only). The respondent

sheepishly had adopted the trademark, which is identical in all aspects to the key features of the applicant/plaintiff trademark “BEST WELD” “BEST ARC” and/or “VNC”.

8.The respondent/defendant contested these applications on the ground that there is a suppression of fact on the part of the applicant/plaintiff. The trademark registration was given to the plaintiff with a disclaimer class. The style and lable as a whole alone was registered. The order of the trademark Registrar specifically says that the registration is subject to disclaimer of the letter “V” and the words “BEST WELD” application to be advertised as accepted for registration. The similar disclaimer class was issued for the trademark “BEST ARC”. Infact, the applicant/plaintiff admittedly, not using the trademark “BEST WELD”. Therefore, suppressing the material facts, the applicant/plaintiff has approached this Court without any proof of registration of partnership. Hence, these applications as well as the suit are liable to be dismissed.

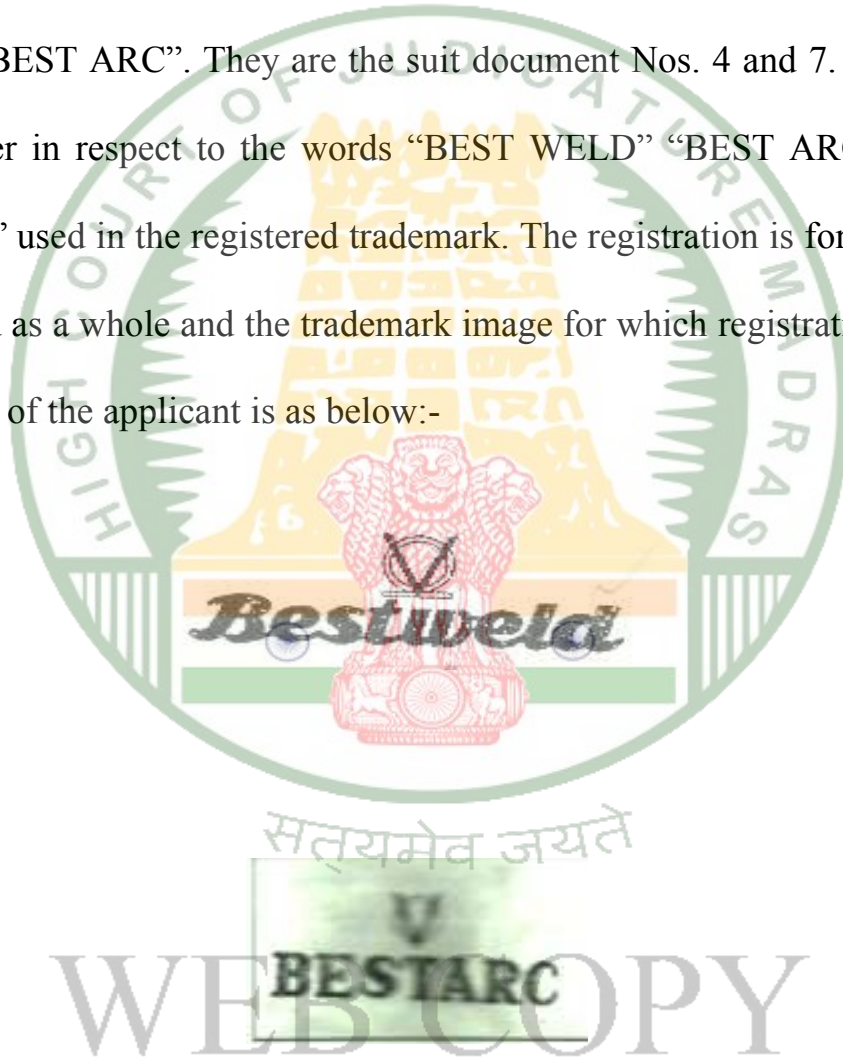
9.As far as the allegation of infringement of trademark, the main contention of the respondent/defendant is that the word “BEST WELD” and “BEST ARC” are descriptive in nature and not subject for registration.

10.Regarding the allegation of passing off, the learned counsel for the respondent/defendant states that the claim of passing off will not arise, unless the applicant proved its reputation and loss of income. By misrepresentation and false statement, the applicant is trying to restrain the respondent/defendant, who has sufficient presence in the market with goodwill since 2007.

11.As far as the claim of the copyright over the alleged label/carton, there is no pleadings regarding the author of the artistic work and the owner of the copy right. Therefore, the applicant/plaintiff can have no exclusive right over the design on the carton.

12.The applicant/plaintiff has not produced any document to prove the use of the mark “BEST WELD”. Therefore, for non use of the registered trademark “BEST WELD”, the registration in favour of the applicant is liable for cancellation. It is further contended that the applicant has not produced any document to prove that it has business operation in Chennai or its products are sold in Chennai within the jurisdiction of this Court. The certificates for use relied by the applicant clearly states that the applicant have no right over the word “BEST ARC” or BEST WELD”. Having abandoned the trademark “BEST WELD”, the applicant has no right to seek a restrain order against the respondent for use of the descriptive word “BEST WELD”. The pamphlet/leaflet relied by the applicant does not carry any date to believe that the applicant had spent for popularising its trademark. Invoices relied on by the applicant is only for its product under the mark “BEST ARC” and not for the product under the mark “BEST WELD”.

13.On considering the rival submissions and perusal of the records, this Court finds that the applicant has obtained trade mark registration for the device “BEST WELD” with letter “V” inscribed upon letter “O” and the device “BEST ARC”. They are the suit document Nos. 4 and 7. There is a disclaimer in respect to the words “BEST WELD” “BEST ARC” and the letter “V” used in the registered trademark. The registration is for the device and word as a whole and the trademark image for which registration granted in favour of the applicant is as below:-



14.The above said mark published in the Trademark Journal, which reads as below:

“532923- July 9, 1990, Mrs.C.Vijay Kumar, Mrs. C.Vairam, Mrs.N.Subha and Mrs.B.Malathi trading as Enveebie Electrodes, No.18, Industrial Estate, Karur 639004, Tamil Nadu Manufacturers and merchants.

Welding electrodes, are welding electrodes, automatic and semi-automatic welding equipment in Class 9 only.

Registration of this Trade Mark shall give no right to the exclusive use of the letter 'V' and the words 'Bestweld' appearing on the label.”

15.The applicant has obtained renewal of trademark for the lable “BEST WELD” vide application dated 19.01.2010 which is valid upto 19.10.2021 wherein the below trade mark image has been registered in favour of the applicant subject to the condition that the registration of this trademark shall give no right to the exclusive use of all descriptive matters appears on the label. Thus the descriptive word not registered but the combination device and word together been registered and the said combination of the word with device together is to be protected.

16.Now, looking at the product of the respondent/defendant, which could be seen from the photographs filed by the Advocate Commissioners Mr.S.Charles along with Report dated 03.12.2020, this Court finds that identically similar colour and word combination is adopted by the respondent including the man with raised hands holding arch. The respondent/defendant adoption of the said design, word and colour combination is not an innocent adoption. The descriptive words where the disclaimer is made by the applicant, does not mean that the respondent/defendant or any other person can adopt the mark with the same features of the applicant with intention to deceive the public.

17.The comparison of the applicant trade mark of the product with the respondent trade mark of the product and the cartons which is extract below, will go to show that the respondent/defendant has adopted the similar label of the applicant and carry the trademark and display the trademark of the

pass off his product that of the applicant.

e contention of the respondent/defendant
applicant has no presence in Chennai market and inv
the products of the applicant under trademark ‘

the applicant Administrative Office is at Chennai and the Advocate Commissioners have inspected the premises at No.158, Old No.121, Broadway, Chennai-600108 and had found the infringed product manufactured by the respondent in the premises of All India Weld Corporation, which is well within the jurisdiction of this Court, under Section 134(2) and (3) of the Trade Marks Act, the suit is very well maintainable within the jurisdiction of this Court for infringement as well as passing off.

19.The learned counsel appearing for the respondent/defendant submitted that the applicant/plaintiff has not placed any material to show that the plaintiff is the partnership firm and therefore, the suit is not maintainable and the injunction should not be granted.

20.This plea is also unsustainable, since all the document dealing with the Registrar of Trademark and the invoices mentions the plaintiff firm as

registered partnership. That apart, even assuming the plaintiff is an unregistered partnership firm for maintaining the suit under Trade Mark Act, it is not a bar.

21.The Courts in India, time and again had held that the use of label identical to the plaintiff for the trade of its product by the defendant amounts to infringement of the trademark. The use of the colour scheme, size, device and carton which are deceptively similar to that of the applicant, cannot be considered as a matter coincidence.

22.The grievance of the applicant is not the innocuous use of the word “BEST ARC” or “BEST WELD” by the respondent but the deceptive use of the similar design of the word inscription of the man holding arch in between two words “BEST ARC” and “BEST WELD”. Similar words, get up and the design of the applicant label on the carton of the respondent is the offensive material to be restrained from passing off. Once, the applicant

establishes that the design used by the respondent is similar to that of the registered mark of the applicant/plaintiff, even if it is not identical, the mere resemblance of the applicant's/plaintiff's registered trade mark is likely to deceive or cause confusion in relation to the goods in respect of which it is registered. Since the applicant and the respondent dealing with the same product, such deceptive use of the registered trade mark with same get up, style and design has to be prohibited.

23.The respondent can take coverage under the disclaimer class only if he use the word “BEST WELD” without the figure of the man holding arch in between these two words and the colour combination and getup. By adopting the figure of the man holding arch and using the word RWW in the place exactly where the applicant used VNC with same getup and colour combination, all discloses the intention of the respondent to deceptively adopt the registered mark of the applicant to exploit the reputation and goodwill of the applicant.

24. Therefore, this Court holds that there is an intentional use of applicant trademark by the respondent to deceive the trade and the public. The case of infringement of trademark and passing of is clearly made out against the respondent. Hence, the relief sought by the applicant in all these applications are granted. No order as to costs.

23.04.2021

Index:yes
Speaking order/non speaking order
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