

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Dated : 03.02.2021

CORAM

THE HONOURABLE MR. JUSTICE **C.V.KARTHIKEYAN**

O.A.No.289 of 2020
in
C.S.No.176 of 2020

- 1.Vasanthakumar. H (Deceased)
- 2.Tamilselvi
- 3.Thangamalar
- 4.Vijayakumar
- 5.Vinothkumar ... Applicant / Plaintiff

Applicants 2 to 5 impleaded as legal heirs of the deceased sole applicant as per order dated 03.11.2020 in A.No.2560 of 2020.

Vs.

Manikandan Chandran ... Respondent / Defendant

Prayer:- This original application filed under Order XIV Rule 8 of O.S Rules and Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908, C.P.C., praying to pass an ad interim injunction restraining the Defendant, their men, agents, servants, representatives and any other

person claiming under the Defendant from infringing the registered Trade Mark Nos.2399768, 2399769, 2361438 and 2361439 in Class 35 under the Trade Marks Act, 1999 and/or any other colorable imitations of the same pending disposal of the main suit.

For Applicants / Plaintiffs : Mr.V.A.Ramalingam

For Respondent / Defendant : Mr.M.P.Saravanan

ORDER

This Application has been filed by the plaintiffs in the suit, seeking an order of interim injunction restraining the Defendant from infringing the registered trademark of the Plaintiffs in Trademark Nos. 2399768, 2399769, 2361438 and 2361439. All these trademarks had been registered under Clause 35 of the schedule of the Trade Marks Act, 1999.

2.The Suit had been originally instituted by Mr.H.Vasanthakumar, Proprietor of M/s.Vasanth & Co, under Sections 28, 29, 134 and 135 of the Trade Marks Act, 1999 read with the relevant provisions of the Code of Civil Procedures, 1908, the Original Side Rules and the Commercial Courts Act, 2015, seeking a judgment and decree against the Defendant Mr.Manikandan Chandran, Proprietor of M/s.Vel Vasanth & Co for a

perpetual injunction restraining the Defendant from infringing the registered trademark in favour of the Plaintiffs and for a direction against the Defendant to render accounts of profits and for damages of Rs.50,00,000/- and also for costs.

3.This particular Application came up for consideration originally on 21.08.2020 and on that date, holding that a prima facie case has been made by the Plaintiffs seeking protection in view of the registered trademark and logo in favour of the Plaintiffs and further holding that the name of the Defendant was deceptively similar to that of the Plaintiffs, an ex-parte interim injunction was granted. The said injunction has been extended and till in force.

4.It must also be mentioned pending the suit, the sole proprietor of the Plaintiff, Mr.H.Vasanthakumar unfortunately expired and later, an Application was filed to bring on record his legal representatives, namely, his widow, his daughter and his two sons and subsequently, they were also impleaded as Plaintiffs to prosecute further the suit.

5. Notice was also directed to the Respondent / Defendant. Learned counsel entered appearance and counter affidavit has also been filed.

6. It is the case of the Plaintiffs that H. Vasantha Kumar, the Proprietor of 'Vasanth & Co'. had coined the trade name 'Vasanth & Co'. in the year 2012. They have also obtained registration of the mark in class 35. Several trademarks were also registered both as a word mark and as a device mark, both in English and in Tamil. Copies of these documents have also been filed along with the plaint.

7. The Plaintiffs primarily deal with Retail Electrical, Electronics and Home Appliances. The fact that the Plaintiffs have the benefit of the trademark 'Vasanth & Co' cannot be disputed or denied. The cause of action in the suit arose owing to the fact that the Plaintiffs had found out that the Defendant had been infringing the mark of the Plaintiffs by using the name 'Vel Vasanth & Co'. The Defendant is also in the very same line of business namely, dealing in Retail Electrical, Electronics and Home Appliances. It is therefore evident that the Plaintiffs and the Defendant are in the same line of business and marketing the same nature of products. The complaint is that the outlet of the Defendant would

confuse the general public into believing that it is actually a branch of the Plaintiffs. Hence the suit had been filed seeking the reliefs as stated.

8.In the counter affidavit, the Respondent / Defendant had stated that they had opened the shop on 10.05.2018 in the name of 'Vel Vasanth & Co'. It is a very small showroom and the Plaintiffs have opened their new showroom in the specific area only on 21.08.2020. It is stated that therefore, the Respondent had been running the shop much prior to the opening of the showroom in the specific area by the Plaintiffs. It is stated that the Defendant was also in the very same line of business, but there is no confusion or deception in the minds of the general public. The Defendant also stated that they are not misleading the customers into thinking that 'Vel Vasanath & Co' is a part of the Plaintiffs' business.

9.It must also be stated that even prior to institution of the suit, the Plaintiffs had issued a notice on 22.01.2019, but which notice had been returned by the Respondent as 'refused'. The Plaintiffs also had given a complaint to the Superintendent of Police, Egmore on 20.02.2019.

10. In the counter affidavit, the Defendant had stated that at the time of delivery of the notice, since the proprietor was not in the shop, the office boy had refused to receive the said notice. It was also stated that based on the police complaint, the Defendant had been threatened to remove the name board of the shop. The Defendant had also shifted the shop to the present address at No.358 MTH Road, Ambattur, Chennai – 600 053 from its original address. The Defendant stated that there is no malafide intention in using the name 'Vel Vasanth & Co'.

11. During the course of arguments, the learned counsel for the Defendant pointed out that the Defendant had changed their name to 'Vel Vasanth Stores'. Photographs to that effect had also been filed as documents by the Defendant.

12. Heard arguments advanced by Mr.V.A.Ramalingam, learned counsel for the Applicant / Plaintiff and by Mr.M.P.Saravanan, learned counsel for the Respondent / Defendant.

13. The suit had been filed on the strength of the registrations of the trademark 'Vasanth & Co Electrical & Electronics' in English in

Registration No.2361439 in class 35 relating to Retail Electrical, Electronics and Home Appliances Showroom and also in Registration No.2361438 again under class 35 for the same word 'வசந்த் & கோ எலெக்ட்ரிகல்ஸ் & எலெக்ட்ரானிக்ஸ்', in Tamil and in Registration No.2399768 also in class 35 for the very same name 'வசந்த் & கோ' in Tamil and also in Registration No.2399769 in class 35 for the very same name "Vasanth & Co' in English.

14.That the Plaintiffs are the proprietors, said registrations cannot be disputed by the Defendant. The documents filed along with the plaint establishes that fact. It has also been very specifically pointed out by the learned counsel for the Plaintiffs that H.Vasanthakumar had coined the name 'Vasanth & Co' which was part of his own name. It had been also been stated that the Plaintiffs have established goodwill and reputation in the market. It was also stated by the learned counsel that the Plaintiffs have nearly 80 showrooms under the name 'Vasanth & Co'. Naturally having built up reputation, the Plaintiffs are diligent in protecting the trademark 'Vasanth & Co'.

15.The Defendant is in the very same nature of business under the name 'Vel Vasanth & Co'. The proprietor of the Defendant is Manikandan Chandran. This fact has been pointed out by the learned counsel for the Plaintiffs who stated that there is no relationship at all between the name of the proprietor and the tradename adopted by the proprietor namely, 'Vel Vasanth & Co' and that the name had been adopted only to give a misleading impression on the general public that it also an another showroom of the Plaintiffs.

16.During the course of arguments, it had been pointed out by the learned counsel for the Defendant that the Defendant had commenced their showroom in the year 2018 itself in that particular area and that the Plaintiffs had opened their showroom only in the year 2020.

17.However, it is common knowledge that from the year 2012, the Plaintiffs have been opening showrooms under the name 'Vasanth & Co' across the length and breadth of the city of Chennai and also in Tamil Nadu and has acquired reputation and goodwill. Opening of any showroom using even a part of the name 'Vasanth & Co' in any insignificant combination would only give a misleading impression to the

public that it is also a part of the Plaintiffs showroom. It is also to be seen that the Plaintiffs and the Defendant are in the same nature of business. The main thrust of the case of the Plaintiffs is that they have registered the trademark under the name 'Vasanth and Co', both in English and Tamil and that the Defendant has adopted their trade name 'Vel **Vasanth & Co**'. The fact that the Defendant have now changed the name to 'Vel Vasanth Stores' is of no significance, since the complaint is of using the name 'Vasanth' as part of the name of the Defendant.

18. Section 29 (5) of the Trade Marks Act, 1999 is as follows:

“29(5). Infringement of registered trade marks:-

1.

2.

3.

4.

5. *A registered trade mark is infringed by a*

person if he uses such registered trademark, 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.”

19. In the instant case, the Plaintiffs have registered their trademark 'Vasanth & Co' in class 35 which comes under the category of 'Services'. Class 35 relates to Electrical, Electronics and Home Appliances. The Defendant have as their trade name, 'Vel Vasanth & Co' or as they have now changed, 'Vel Vasanth Stores'. They have used as part of their tradename the word 'Vasanth' which is one of the significant marks of the registered trademark of the Plaintiff. The registered trademark of the Plaintiff is 'Vasanth & Co'. The words '& Co' do not signify anything. They are generic terms. The significant word in the registered trademark is the word 'Vasanth'. The Plaintiff traces its origin to the name of the proprietor H.Vasanthakumar. It is also seen that the name has acquired a secondary meaning with that of proprietor H.Vasanthakumar. The name has acquired sufficient goodwill and reputation in the market as dealers in Electrical, Electronics and Home Appliances and such other items. The showrooms are spread across Tamil Nadu and it is stated that there are about 80 showrooms as on date.

20. The fact that the Defendant had started their showroom under the name 'Vel Vasanth & Co' in the year 2018 and in that particular area

the Plaintiffs opened the showroom in the year 2020 would be of no significance, since the Plaintiffs showrooms are spread across the State and starting of a showroom in an area where the Plaintiff does not have an existing showroom would itself be an attempt to infringe on the registered mark of the Plaintiffs and also to encroach on the goodwill and reputation built by the Plaintiffs by misleading the general public in that particular area that it is an actual showroom of the Plaintiffs.

21. In this case, the significant word in the trade name of the Defendant is 'Vasanth'. Even in the photographs produced by the Defendant, the words written in Tamil show that the word 'Vasanth' is more prominently written than the words 'Vel' 'Stores'. In English, the word 'Vasanth' is also very prominent, though it takes the very same space as 'Vel' 'Stores'. It is also seen that Section 29(5) of the Trade Marks Act, 1999, will be attracted, if the business is dealing in the same nature of goods or services for which the trademark was registered. Here the Plaintiff and the Defendant are in the same nature of business. They both sell electronics items and home appliances. Naturally having the benefit of registration, the Plaintiff will be interested in protecting such registration.

22.The learned counsel for the Plaintiffs relied on **2017 SCC OnLine Bom 7237, Pidilite Industries Limited a Company registered under the Companies Act, 1956 and having its registered office at Regent Chambers, 7th Floor, Jamanalal Bajaj Marg, Nariman Point, Mumbai-400 021 -Vs- Poma-Ex Products a firm/concern, having its address at 78 AOLF Gupta Colony, Delhi-110009**, which was with respect to a dispute with the word 'FEVIKWIK' and 'KWIKHEAL'. The Bombay High Court held that the significant word in the trademark was the word 'KWIK' and therefore stated that the usage of the trademark 'KWIKHEAL' should be enjoined from being used.

23.The learned counsel for the Plaintiffs also relied on **2017 SCC OnLine Del 11359, Nokia Corporation & Ors. V. Movieexpress & Ors**, to impress upon the Court that even phonetically similar name should also be enjoined from being used. That was the case with respect to the mark 'Nokia'. The Defendant had also used the same phonetic term 'Nokia' but had adopted different spelling. But still the Delhi High Court held that an injunction should follow.

24.In the instant case, the Defendant had been using very same word 'Vasanth' as a trade name. Naturally, the Plaintiffs who are the proprietors of a registered mark has taken umbrage at such usage.

25.The balance of convenience is certainly in favour of the Plaintiffs. In view of the registrations of the trademark. The Plaintiffs would be put to much loss and hardship, if the Defendant were to continue to use the trade name 'Vel Vasanth & Co' or even 'Vel Vasanth Stores' since the Plaintiffs have built up their business from scratch and had built up substantial goodwill and reputation as dealers in Electrical, Electronics and Home Appliances and similar such other goods.

26.In view of these facts, I hold that the order of interim injunction already granted by this Court on 21.08.2022 should be made absolute and accordingly, it is made absolute till the disposal of the suit. The Original Application is allowed. No order as to costs.

03.02.2021

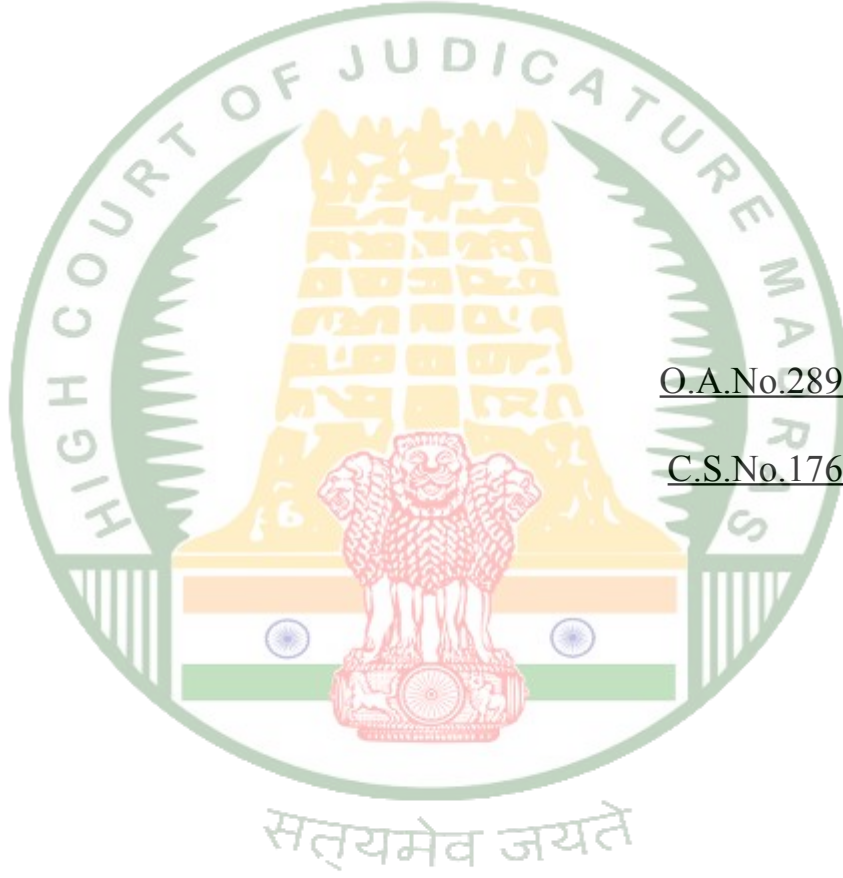
smv

Index : Yes / No

Internet : Yes / No

Speaking order : Yes / No

C.V.KARTHIKEYAN, J.,
smv



O.A.No.289 of 2020
in
C.S.No.176 of 2020

WEB COPY 03.02.2021