

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 19.07.2021	Pronounced on : 22.07.2021
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Coram:

THE HONOURABLE DR. JUSTICE G.JAYACHANDRAN

A.No.4280 of 2019
in C.S.No.233 of 2018

Kitply Industries Limited,
having its registered office at
Makum Pathar, A.T.Road,
Margherita, Tinsukia, Assam – 786 181,
and its corporate office at
'White House', 119, Park Street,
'A' Block, 4th Floor, Kolkata – 700 016
and a branch office at,
New No.225, Old No.150, Sydenhams Road, Chennai – 600 003.
Represented through its
Commercial Manager and authorised signatory, Mr.M.Kannan

... Applicant

/versus/

1. M/s. Mangalam Enterprises,
No.49, Narasing Perumal Koil Street,
Choolai, Chennai – 600 112.
2. M/s.Ply Co.,
Old No.183/2, New No.305, Sydenhams Road,
Apparao Garden, Choolai, Chennai – 600 112.
3. Mr.V.Veeramuthu,
Old No.49, New No.21/2, Narasingha Perumal Coil Street,
Choolai, Chennai – 600 112.

4. Mr.Rajendra Kumar Nahata,
Old no.183/2, New No.305, Sydenhams Road,
Choolai, Chennai – 600 112.

5. M/s.Kitply Wood Industries,
Solitare Tower, Door Nos. 8 & 9, 1st Floor,
Shop No.F15, Sami Pillai Street,
Choolai, Chennai – 600 112.

6. M/s.Ulteno,
No.86, M.C.Road, Washermenpet,
Chennai – 600 021.

... Respondents

Prayer: Application is filed under Section XIV Rule 8 of the Original Side Rules read with order 13-A of the C.P.C (Amended).

- (a). This Application should not be treated as urgent?
- (b). To issue summary judgment against the respondents/defendants and decree the present suit in terms of the prayers in Paragraph VI of the plaint in favour of the applicant/plaintiff.

For Applicant : Mr.P.V.Balasubramaniam,
for M/s.BFS Legal

For D1, D3 & D5 : Mr.K.V.Karthik Subramanian,
for Mr.K.Arumugam

For D2 & D4 : Mrs.Vandana,
for M/s.Surana & Surana

For D6 : *set exparte*

ORDER

Claiming exclusive right to exploit the marks KIT, KITPLY and its variants, the suit is filed for permanent injunction to i). Restrain the defendants from infringing the plaintiff's registered trademark and Copyright, ii). To restrain them from passing off their goods by deceptively using the plaintiff's marks and iii). for damages and other consequential relief.

2. The plaintiff is a Limited Company registered under the Companies Act involved in the business of manufacture and marketing construction products including plywoods. They are carrying on business under the trademark "KIT PLY".

3. Alleging that, the defendants are manufacture/dealers of plywoods and others related products, are adopting the registered trademark of the plaintiff thereby infringing the trademark and passing off their product as that of the plaintiff's product.

4. According to the plaintiff, the trademark “KIT” and “KITPLY” were adopted by the plaintiff in the year 1982. The trademark KIT and its variant “KITPLY” is used *per se*, as a part of its trading name. Further, claiming exclusiveness over the artistic label ““ a device of a leafy tree placed over the trademark “KITPLY”, the plaintiff claim ownership of the copyright in such artistic labels/work. The plaintiff has obtained registration for the following products.

Registration No.	Date of Application	Registered trade mark	Goods
389626	05/05/1982	KITPLY	Class 19: Commercial plywood, decoration plywood, flush doors, marine, plywood, concrete shuttering plywood
726395	10/10/1996	KITBOARD GOLD	Class 19: Phenol bonded plywood, phenol bonded block board, commercial plywood, commercial block board, concrete shuttering plywood, fine marine plywood, marine plywood, film faced plywood, special white plywood, coated plywood, one side teak decorative plywood, both side teak decorative plywood, one side teak decorative block board, both side teak decorative block board, phenol bonded one side teak decorative plywood, phenol bonded both side teak teak decorative plywood and particle board all being goods included in class 19.
726396	10/10/1996	KITPLY GOLD	Class 19: phenol bonded plywood, phenol bonded block board, commercial plywood, commercial block board, concrete shuttering plywood, fine marine

Registration No.	Date of Application	Registered trade mark	Goods
			plywood, marine plywood, film faced plywood, special white plywood, coated plywood, one side teak decorative plywood, both side teak decorative plywood, one side teak decorative block board, both side teak decorative block board, phenol bonded one side teak decorative plywood, phenol bonded both side teak decorative plywood and particle board all being goods included in class 19.
757814	31/07/1997	KITMICA EXOTIC LAMINATES (label)	Class 19: Laminates
757694	21/07/1997	KITSTAR	Class 19: Plywood and allied products
2312041	09/04/2021	KITMICA	Class 19: Laminates

5. Alleging that, the 1st and 2nd defendants claiming to be manufacturer and dealers of plywood, ply board, trading their products in the names 'KIT', 'KITPLY', VISTA, SWASTIK, 'KIT GOLD', 'KIT VISTA', 'KIT PLY SWASTIK', KITPLY MARINE', 'KITPLY', VISTA, SWASTIK owned and used by the applicant, in and around the city of Chennai and the state of Tamil nadu. The said marks 'KIT', 'KITPLY', VISTA, SWASTIK, 'KIT GOLD', 'KIT VISTA', 'KIT PLY SWASTIK', KITPLY MARINE', 'KITPLY ROYAL' and other are deceptively similar to various trademarks owned and used by the plaintiff. Further, it is alleged that the 3rd defendant claims to be the proprietor of the

trademarks comprising of “KIT”, is marketing plyboard products bearing deceptively similar trademark of the plaintiff. The 3rd defendant has business interest in the 1st defendant's Company. Similarly, the 4th defendant is having business interest in the 2nd defendant's Company. The 5th defendant is operating a website www.kitplywood.in, on which marks namely 'KIT', KITPLY', VISTA, SWASTIK, 'KIT GOLD', 'KIT VISTA', 'KIT PLY SWASTIK', KITPLY MARINE', 'KITPLY ROYAL' are being advertised and claims to be using owning a trading name and domain which employees the work “KIT”.

6. Apprehending that, the defendants are active in collaboration with each other going by the similar nature of the labels and marks, being sold and applied for advertised, promoted, displayed by the 6th defendant, the suit is filed for the following relief.

a). Permanent injunction restraining the Defendants whether by themselves, their employees, servants, agents, principal officers, partners, affiliates, franchises, stockiests, persons having interest in the Defendants, sister concerns or any other person claiming under or through them or acting in concert with them or otherwise, howsoever from infringing the registered

trademarks KITPLY (label) (trade mark no.389626), KITBOARD GOLD (trade mark no.726395), KITPLY GOLD (trade mark no.726396), KITMICA EXOTIC LAMINATES (label) (trade mark no.757814), KITSTAR (trade mark no.757694), KITMICA (trade mark no.2312041) of the Plaintiff by using the deceptively similar marks 'KIT', KITPLY', VISTA, SWASTIK, 'KIT GOLD', 'KIT VISTA', 'KIT PLY SWASTIK', KITPLY MARINE', 'KITPLY ROYAL' or any other mark comprising of KIT, KITPLY, VISTA and SWASTIK, or deceptively similar thereto.

b). Permanent injunction restraining the Defendants whether by themselves, by their employees, servants, agents, principal officers, partners, affiliates, franchises, stockiests, persons having interest in the Defendants, sister concerns or any other person claiming under or through them or acting in concert with them or otherwise, howsoever from passing off their goods by using the trademark 'KIT', 'KITPLY', VISTA, SWASTIK, 'KIT GOLD', 'KIT VISTA', 'KIT PLY SWASTIK', KITPLY MARINE', 'KITPLY ROYAL',  or any other mark comprising of KIT, KITPLY, VISTA and SWASTIK or deceptively similar thereto.

(c). Permanent injunction restraining the Defendants whether by themselves, by their employees, servants, agents, principal officers, partners, affiliates, franchises, stockiests, persons having interest in the Defendants, sister concerns or any other person claiming under or through them or acting in concert with them or otherwise howsoever from advertising their business in any manner, which violates the rights of the Plaintiff by using the trademark/trade name KIT', 'KITPLY', VISTA, SWASTIK, 'KIT GOLD', 'KIT VISTA', 'KIT PLY SWASTIK', KITPLY MARINE', 'KITPLY ROYAL' or any other words or letters which so resembles the Plaintiffs trademark KITPLY (label) (Trade mark no.389626), KITBOARD GOLD (Trade mark no.726395), KITPLY GOLD (trade mark no.726396), KITMICA EXOTIC LAMINATES (label) (trade mark no.757814), KITSTAR (trade mark no.757694), KITMICA (trade mark no. 2312041).

(d). Permanent injunction restraining the Defendants whether by themselves, by their employees, servants, agents, officers, partners, affiliates, franchises, stockiests, persons having interest in the Defendants,

sister concerns or any other person claiming under or through them or acting in concert with them or otherwise, howsoever from infringing the Copyright over the KITPLY (labels) owned and used by the Plaintiff.

(e). The Defendant be ordered and decreed by this Hon'ble Court to pay to the Plaintiffs a sum of Rs.25,00,100/- as and by way of damages and losses; or, in the alternative, the Defendant be ordered and decreed to render a true, faithful and accurate account of all the profits earned by them by using the impugned trademark(s) and be further ordered and decreed by this Hon'ble Court to pay such amount as may been found due on such account being taken;

(f). Mandatory injunction directing the Defendant to surrender to the Plaintiff for destruction of all materials, banners, labels, dyes, blocks, moulds, stickers, stamps, promotional material, stationery, packaging material and other material bearing the 'KIT', 'KITPLY', VISTA, SWASTIK, 'KIT GOLD', 'KIT VISTA', 'KIT PLY SWASTIK', KITPLY MARINE', 'KITPLY ROYAL  or any other mark comprising of KIT, KITPLY, VISTA and SWASTIK, or deceptively similar

thereto.

g) Costs of the suit.”

7. Summons were served on the defendants. The 6th defendant remain absent and he was set *exparte* on 13.03.2019. The written statement filed by the 4th defendant is adopted by the 2nd defendant. The written statement filed by the defendants 1 & 3 is adopted by 5th defendant.

8. In the written statement filed by the defendants 1 & 3 as adopted by 5th defendant, use of some of the trademarks mentioned in the suit is admitted and pleaded that the 1st defendant is the Trading name of the sole Proprietor concern of the 3rd defendant, therefore, suit against the 1st defendant is liable to be dismissed. The 3rd defendant has set up a proprietorship concern in the name and style of M/s.Mangalam Enterprises. It is a retail distributor engaged in the trade of plywood and building materials. The 3rd defendant has applied for the Registration of trademark of “KITPLY MARINE”(Application No.3635612 dated 14.09.2017), KIT GOLD (Application No.3717427 dated 02.01.2018), KIT SWASTIK (Application No.3704259 dated 16.12.2017), KIT CLASSIC (Application

No.3768323 dated 02.03.2018), KITCLUB (Application No.3756302 dated 17.02.2018), KIT DIAMOND (Application No.3768325 dated 02.03.2018), KIT MARINE (Application No.3800249 dated 09.04.2018), KIT ROYAL (Application No.3800250 dated 09.04.2018) and KITPLY ROYAL (Application No.3733025 dated 20.01.2018) under class 19. That apart, he also applied for the Registration of Trademark of KIT VISTA (Application No.3649499 dated 04.10.2017) and when the same was advertised in the Trade mark Journal, the plaintiff has raised objections. For the said objections the 3rd defendant had suitably replied.

9. It is claimed by the defendants 1, 3 and 5, the impugned marks are honest adoption by the 3rd defendant and using it continuously and exhaustively. The trademark of the plaintiff is phonetically, structurally and visually different from that of the 3rd defendant's trademark and logo. The 3rd defendant has independently acquired goodwill and reputation on its mark therefore, the plaintiff can at no stretch of imagination claim sole right over the word “KIT” or its variants. .

10. In the written statement filed by the 4th defendant as adopted by

2nd defendant. The maintainability of the suit against the 2nd defendant is questioned. Also the exclusive right over the word “KIT” by the plaintiff is denied. According to these defendants, the common word “KIT” used by several manufacturers in respect of plywood and its allied products cannot be monopolised by the plaintiff. That apart, stating that they are only retailers and not claiming any right over the alleged mark these two defendants plead for dismissal of the suit against them.

11. After completion of pleadings, the case was adjourned for filing the affidavit of admission and denial. At that juncture, the present application to pass summary judgment has been filed by the plaintiff.

12. In the said application, the trademarks/Labels of the applicant and the mark used by the respondents were compared and summary decree sought on the ground that the defendants has no prospect of success since the wilfull imitation of the applicant's trademark, copyright and also passing off is well established, even according to their one own admission. The applicant being the prior user of the trademark/label and the respondent apparently using the similar

writing style, devices, logo's and colour combination for their products. Lack of explanation for such use amounts to admission, which requires no further oral evidence.

13. In response to the application, the 3rd defendant has filed affidavit which reads as below:-

“2. I have been using the marks 'Kit Vista', 'Kit Gold', 'Kit Swastik', 'Kit Club', 'Kit Classic', 'Kit Diamond', 'Kit Marine', 'Kit Royal', 'Kitply Royal', from 04.10.2017, but immediately stopped using such marks on 16.04.2018, when this Hon'ble Court in O.A.No.353 of 2018 in C.S.No.233 of 2018 was pleased to pass an order of injunction restraining me from effecting sales of the products sold under the marks belonging to the applicant herein.

3. I am the Trademark holder of the products “icare Woodply”, “Matis Prestige”, and “Vista Gold Architect Plywood” and currently sell products only using such names. I am not currently using the mark 'Kitply' with its leafy green image or any of its variants for effecting any sales.

4. I undertake that I shall not in the future use the mark of the applicant, being the combination of the word “Kitply” along with the leafy green image or its associated variants such as “Kit Vista”, “Kit Gold”, “Kit Swastik”, “Kit Club”, “Kit Classic”, “Kit Diamond”, “Kit Marine”, “Kit Royal”, “Kitply Royal”.

14. In view of the certain admissions made in the written statement and in the affidavit of the 3rd defendant dated 11.03.2021, the Learned Counsel for the plaintiff seeks for summary judgment as prayed in the suit.

15. The learned Counsel appearing for the respondent would submit that there is no dishonest adoption by the respondents of the applicant mark. As soon as the right of the applicant over the registered trademark came to the knowledge of the respondents 1, 3 & 5, they have sought using the trademark. They are not using the word “KITPLY” in their products or the leafy green image and its variants as logo. As far as the 2nd & 4th defendant are concerned, their counsels plead that they are only retail distributors and not involved in manufacturing.

16. In view of the substantial admission by the 3rd defendant by way of affidavit dated 11.03.2021, and the declaration that they have stopped using the marks of the plaintiff over which they have valid registration, this Court is of the view that summary judgement in favour of the plaintiff seeking injunction against the defendants from infringing the trademark “Kit Vista”, “Kit Gold”, “Kit Swastik”, “Kit Club”, “Kit Classic”, “Kit Diamond”, “Kit Marine”, “Kit Royal”, “Kitply Royal” shall be granted. These marks alone are admittedly used by the 3rd defendant since 04.10.2017 but stopped using these marks after 16.04.2018 after the order of injunction granted by this Court. As far as the mark “Kitply and the device  the 3rd defendant had given undertaking that they will not use it. For the rest of the trademarks over which the relief of injunction sought, this Court finds no material to show those marks are used by the defendants for the Court to grant the relief of injunction.

17. The Learned Counsel for the 3rd respondent has produced the copy of its recently registered trademark “VISTA GOLD” and submitted that, none of the registered trademark and device are infringed, after receipt of the notice. However, the Learned Counsel for the applicant would submit that the word

“VISTA GOLD” is combination of parts of the plaintiff's “VISTA KITPLY” and “KITPLY GOLD” therefore, it is a deceptive adoption of the registered trademark.

18. This Court, on examining the trademark of the respondent “VISTA GOLD” finds that it neither phonetically or visually similarity of “KIT VISTA or “KIT GOLD”, or any other trademark of the applicant.

19. Regarding the relief of damages, alleged to have caused due to infringement and passing off, Section 135(3) of the Trade Marks Act, 1999, reads as below:-

135. Relief in suits for infringement or for passing off:-

(1) The relief which a court may grant in any suit for infringement or for passing off referred to in Section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

(2).....

(a).....

(b).....

(c).....

(3). Notwithstanding anything contained in sub-section (1), the court shall not grant relief by way of damages (other than nominal damages) or on account of profits in any case.

(a) where in a suit for infringement of a trade mark, the infringement complained of is in relation to a certification trade mark or collective mark; or

(b) where in a suit for infringement the defendant satisfies the court -

(i) that at the time he commenced to use the trade mark complained of in the suit, he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was on the register or that the plaintiff was a registered user using by way of permitted use; and

(ii) that when he became aware of the existence and nature of the plaintiff's right in the trade mark, he forthwith ceased to use the trade mark in relation to goods or services in respect of which it was registered; or

(c). where in a suit for passing off, the defendant satisfies the court—

(i) that at the time he commenced to use the trade mark complained of in the suit he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was in

use; and

(ii) that when he became aware of the existence and nature of the plaintiff's trade mark he forthwith ceased to use the trade mark complained of.

20. This Court find that use of the plaintiff's registered trademark was an honest adoption after applying for registration, unknowing of the plaintiff's right. The defendants have stopped using the mark after knowing about the injunction order passed by this court. Therefore, in the light of section 135(3) of the Trademarks Act, 1999, the relief for damages dismissed.

21. In the result, this Court pass summary judgement as below:

a). Permanent injunction restraining the defendants their men and agents from using the trade marks "kitply", "Kit Vista", "Kit Gold", "Kit Swastik", "Kit Club", "Kit Classic", "Kit Diamond", "Kit Marine", "Kit Royal", "Kitply Royal" and the device  is granted.

b). Permanent injunction restraining the defendants their men and agents from any manner advertising or passing off their products by using similar

or deceptively similar trade marks “kitply”, “Kit Vista”, “Kit Gold”, “Kit Swastik”, “Kit Club”, “Kit Classic”, “Kit Diamond”, “Kit Marine”, “Kit Royal”, “Kitply Royal” and the device is granted.

c). Permanent Injunction restraining the defendants from infringing the copyright of the plaintiff over the label “KITPLY” granted.

d). Relief under prayer (e) and (f) are dismissed. No costs. Consequently all other applications are closed.

22. In the result, summary judgement as above is passed. Suit is Partly Allowed. The parties shall bear their respective costs.

22.07.2021

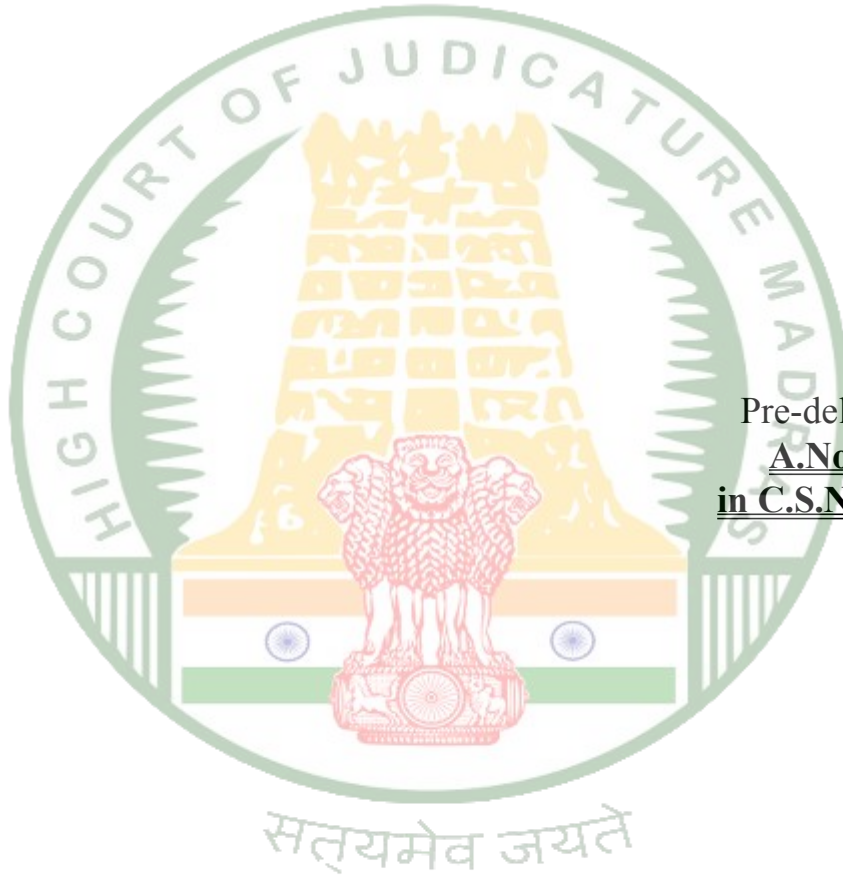
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