



O.A. Nos.765 & 766 of 2020
in C.S. (Comm. Div.) No.411 of 2020

N.ANAND VENKATESH,J.,

These applications have been filed seeking for the relief of interim injunction by the applicant/plaintiff on the ground that the respondent/defendant is infringing the applicant's trademark SLAM LIFESTYLE AND FITNESS STUDIO by using the offending trademark GRAND SLAM and is passing off the applicant's trademark and trade stlye.

2.The case of the applicant is that they started the gym and lifestyle and fitness studio in they year 2015 under the name SLAM LIFESTYLE AND FITNESS STUDIO. The applicant has a registered trademark SLAM LIFESTYLE AND FITNESS STUDIO with regard to gym business and it is registered in service Class 41 to run a gym. The applicant claims that there are 32 branches that are actively in operation spread over Tamil Nadu and Bangalore. It is stated that the applicant has earned a goodwill and reputation by using this trademark and trading style. The applicant further claims that they have earned a revenue of Rs.90,88,37,895/- for the period from 2015 to 2020 and they have also spent towards advertisement and promotional expenses a sum of Rs.1,21,75,000/-.



WEB COPY

3.The grievance of the applicant is that the respondent advertised that they are going to launch their gym business under the mark SLAM and according to the applicant, this trademark of the respondent will mislead and cause confusion to the public since it is deceptively similar and resembles the mark of the applicant phonetically and visually.

4.The applicant sent a legal notice dated 28.11.2020 to the respondent requesting them to stop using the registered trademark of the applicant with regard to gym business. A reply notice was issued by the respondent dated 04.12.2020 and the respondent justified their action on the ground that they have been running gym/fitness centre since the year 2010 onwards. This gave raise to a cause of action to file the above suit and pending the suit, these applications have been filed seeking for an order of interim injunction.

5.The respondent has filed a common counter affidavit in both the applications. The respondent has taken a very specific stand that they are prior users of the trademark GRAND SLAM and they have obtained the registration in the year 2007 itself for product Class 28 and they are running gym/fitness centre from the year 2009/2010 onwards under the brand GRAND SLAM and that the applicant who came into the scene only in the



year 2015 does not have any right or authority to stop the respondent from carrying on the gym business by using their registered mark. The further stand taken by the respondent is that they have acquired sufficient goodwill and reputation by using the trademark GRAND SLAM and their sales turnover runs to several crores of rupees. The respondent has taken a further stand that they are having their business in Delhi and the applicant who is only having business at Tamil Nadu and Bangalore, is attempting to illegally stop the respondent from carrying on with their business to which they are entitled to under the trademark GRAND SLAM. The respondent has therefore sought for the dismissal of these applications.

6. Heard the learned counsel for the applicant/plaintiff and the learned counsel appearing on behalf of the respondent/defendant.

7. The admitted case of the applicant is that they started the gym and fitness studio in the year 2015. It was launched on 12.02.2015. Thereafter, they have applied and got a Certificate of Registration from the Registrar of Trademarks for Gymnastic Instruction; Conducting Fitness Classes; Health Club Services [Health and Fitness Training]; Personal Trainer Service[Fitness



WEB COPY



Training] under Class 41 under the trademark . It is further seen from the documents filed along with the plaint that they have obtained necessary license and permission for running the fitness centres at various places. A reading of the plaint shows that the applicant has nearly 32 branches across Tamil Nadu and Bangalore.

8.It is further seen from the documents that the fitness centre run by the applicant has earned sufficient reputation and goodwill. The averments in the plaint also goes to show that the applicant is earning substantial revenue and he is also spending a lot towards promotional expenses.

9.Immediately on coming to know that the respondent is planning to open a gym/fitness studio, the applicant issued a notice dated 28.11.2020 to the respondent and requested the respondent to desist from using the trademark GRAND SLAM FITNESS. On receipt of this notice, the respondent issued a reply notice dated 04.12.2020. In the said notice, the respondent claimed that they are in the business of running gym/fitness centre from the year 2010 onwards and they have every right to open gym/fitness centre in their tradename GRAND SLAM. This reply notice was the trigger for the applicant to institute the above suit.



11. This court carefully went through the documents filed on the side of the respondent. It is seen from the Memorandum of Association of the respondent company that there is not a single reference to start a gym



business/ fitness studio either in the main object or in the incidental or ancillary object or the other objects of the company. The Memorandum of Association makes it abundantly clear that the respondent wanted to carry on with the business of manufacturing/supplying fitness equipments and sports goods. The Trademark Registration Certificate given in favour of the respondent under Class 28 once again confirms this fact. The certificates issued by the Government and various other authorities in the name of the respondent clearly shows that they are supplying fitness equipments and sports goods. Even one document issued by the Service Tax Department where reference is made to health club and fitness centre is predicated by the words maintenance or repair service. This only gives an impression that the respondent has undertaken maintenance/repair service for a health club and fitness centre.

12.The sales invoices that have been relied upon by the respondent and which is found at Page Nos.56 to 90 in the typed set of papers clearly reflects the fact that the respondent has supplied equipments and in some cases, have set up a home gym.

13.The learned counsel for the respondent placed heavy reliance upon documents found at Page Nos.91 to 102. These are invoices issued in the



14. Even the advertisements and news reporting that has been relied upon by the respondent and which are found at Page Nos. 166 to 219 pertains to gym equipments and not towards running a gym.



16. On a careful scrutiny of the documents filed by the respondent, it is very clear that the respondent is involved only in the business of supply of gym equipments and sports goods. That is substantiated by the fact that the Trademark Certificate has been issued only under Class 28 which does not cover health and fitness training. Whereas, the applicant has been specifically granted trademark registration under Class 41 which covers Gymnastic Instruction; Conducting Fitness Classes; Health Club Services [Health and Fitness Training]; Personal Trainer Service [Fitness Training]. Obviously, the respondent was in the process of getting into the gym business and on noticing the same, the applicant has approached this court seeking for appropriate reliefs.



17. The next issue that has to be taken into consideration is as to whether the impugned trademark of the respondent namely "GRAND SLAM FITNESS" if adopted in the gym business will infringe upon the trademark of the applicant namely 'SLAM LIFESTYLE AND FITNESS STUDIO' and whether the respondent will be passing off the registered trademark of applicant. The essential feature of the trademark of the applicant is "SLAM". The applicant has used the trademark from the year 2015 onwards and has earned sufficient reputation and goodwill and the same is evident from the sales figures and the huge amounts that are spent on advertisement and promotional events. The registered trademark of the applicant is



and the impugned trademark of the respondent is 'GRAND SLAM'. When it comes to a registered trademark, added matter doctrine will not apply. This court cannot breakdown the mark into distinctive and non-distinctive part. It has to be necessarily considered as a whole. In the present case, the distinctive part is no doubt the word "SLAM". If the respondent is permitted to start their gym business/fitness studio with their trademark GRAND SLAM, it will necessarily mislead and cause confusion to the customers who join in the gym. The nature of the mark is deceptively similar and the degree of resemblance between the marks is phonetically, deceptively and visually similar. This confusion may not arise till the



registered trademark for Class 41. The loss cannot be compensated in terms of damages. This court also finds that the balance of convenience is in favour of the applicant. In the result, the applicant is entitled for injunction as prayed for in the above applications, pending disposal of the suit.

20. Considering the facts and circumstances of the case, this court is not inclined to impose costs on the respondent and these applications are allowed accordingly.

01.12.2021

ssr

(3/4)



WEB COPY



12

N.ANAND VENKATESH,J.,

ssr

O.A. Nos.765 & 766 of 2020
in C.S. (Comm. Div.) No.411 of 2020

01.12.2021
(3/4)