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O.S.A(CAD).Nos.25 & 26 of 2022

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 08.03.2022

CORAM :

THE HONOURABLE MR.JUSTICE M.DURAIWAMY

and

THE HONOURABLE MRS.JUSTICE T.V.THAMILSELVI

O.S.A(CAD).Nos.25 and 26 of 2022

and

C.M.P.Nos.3321 and 3325 of 2022

Grand Slam Fitness Pvt, Ltd.,
having registered office at
E-540, Greater Kailash II,
New Delhi -110 048

... Appellant/Defendant in both OSAs

Vs

M/s.Paulsons Beauty & Fashion Private Limited
rep by the Director,
Dr.Sam Paul Sober Ravi Sounder,
Having office at 12, Halls Road,
Kilpauk,Chennai – 600 010.

... Respondent/Plaintiff in both OSAs

PRAYER in O.S.A(CAD) No.25 of 2022 : Appeal filed under Section 13 of the Commercial Courts Act, to set aside the Common judgment and decree dated 01.12.2021 passed in [O.A.No.765](#) of 2020 in C.S(CD).No.411 of 2020 .



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PRAYER in O.S.A(CAD) No.26 of 2022 : Appeal filed under Section 13 of the Commercial Courts Act, to set aside the Common judgment and decree dated 01.12.2021 passed in [O.A.No.766](#) of 2020 in C.S(CD).No.411 of 2020 .

For Appellant : Mr.R.Sathishkumar
(in both appeal)

For Respondent : Mr.M.S.Bharath
(in both appeal) For Mr.Vijayan Subramanian

COMMON JUDGMENT

(Judgment of the Court was passed by **T.V.THAMILSELVI, J**)

The appellant has filed the above Original Side Appeals against the Common judgment and decree dated 01.12.2021 passed in [O.A.Nos.765 and 766](#) of 2020 in C.S(CD).No.411 of 2020.

2. The respondent/plaintiff has filed [O.A.Nos.765](#) and 766 of 2020 in [C.S\(CD\).No.411](#) of 2020 seeking for temporary injunction restraining the appellant/defendant from infringing the Trade mark and Trading style "SLAM LIFESTYLE AND FITNESS STUDIO" by using the offending



Trade mark and Trading Style "GRAND SLAM" or any other mark or marks which are similar or in any way deceptively similar to or a colourable imitation of the respondent/defendant Trade mark "SLAM LIFESTYLE AND FITNESS STUDIO" pending disposal of the above suit.

3. The brief case of the respondent/plaintiff is as follows:-

(i) According to the respondent/plaintiff, they started the gym and lifestyle fitness studio in the year 2015 under the name SLAM LIFESTYLE AND FITNESS STUDIO with 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. There are 32 branches actively in operation spread over Tamil Nadu and Bangalore. It is stated that the respondent/plaintiff has earned a goodwill and reputation by using this trademark and trading style.

(ii) The grievance of the respondent/plaintiff is that the appellant/defendant advertised that they are going to launch their gym business under the mark "GRAND SLAM" and this trademark of the defendant will mislead and cause confusion to the public, since it is



deceptively similar and resembles the mark of the applicant phonetically and visually.

(iii) The respondent/plaintiff sent a legal notice dated 28.11.2020 to the appellant/defendant to stop using the registered trade mark with regard to gym business. A reply notice dated 04.12.2020 was issued by the appellant/defendant stating that they have been running gym/fitness centre since the year 2010 onwards. In these circumstances, the respondent/plaintiff filed the suit.

4. The case of the appellant/defendant is as follows:-

According to the appellant/defendant, they are prior users of the trademark GRAND SLAM and they registered in the year 2007 itself for product Class 28 and they are running gym/fitness center from the year 2009/2010 onwards under the brand GRAND SLAM and that the plaintiff who came into the scene only in the year 2015 does not have any right or authority to stop the appellant/defendant, from carrying on the gym business by using their registered mark.



5. The learned Single Judge after taking into consideration the case of both sides, allowed the applications by granting interim injunction as prayed for in favour of the respondent/plaintiff.

6. Aggrieved over the order passed by the learned single Judge, the defendant has filed the above appeal.

7. Heard Mr.R.Sathishkumar, learned counsel appearing for the appellant and Mr.M.S.Bharath learned counsel appearing for the respondent.

8. On a careful consideration of the materials available on record and the submissions made by the learned counsel on either side, it could be seen that there is no in dispute that the appellant/defendant started business in the year 2007 and the respondent/plaintiff started business in the year 2015. However, as per trademark Registration Certificate, the appellant had registered Trade mark GRAND SLAM under Class 28 to carry on the business of manufacturing/supplying the trading apparatus, exercise bicycles, joggers, tread mills, exercisers, machines for physical exercise,



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apparatus for gymnastics parts etc of fitness equipments. It is clear from the certificate that the trademark of the appellant was confined to the goods falling under Class 28. This registration was given in favour of the appellant in the year 2005. The specific case of the respondent is that they do not have any objection in the appellant carrying on with the business falling under Class 28 with their trade name and their only objection is that they are attempting to get into gym business which is not covered under the registration granted to them and it will unnecessarily cause confusion in the minds of the customers since the tradename is phonetically, deceptively and visually similar. In short the offending tradename 'GRAND SLAM FITNESS' is likely to mislead and cause confusion to the public. The sales invoices that have been relied upon by the appellant/defendant reflects the fact that the appellant/defendant had supplied equipments and in some cases, have set up a home gym. The appellant placed reliance upon the invoices issued in the name of certain individuals during the year 2009 and 2010.



9. On a careful scrutiny of the documents filed by the appellant/defendant, it is very clear that the appellant 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 respondent/plaintiff 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 appellant was in the process of getting into the gym business and on noticing the same, the respondent has approached this court seeking for appropriate reliefs.

10. The learned Single Judge, while granting interim injunction observed that 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 appellant confines to the business falling under Class 28. The moment the appellant gets into the gym business/fitness studio, the class of customers who frequent a gym will be necessarily mislead. The respondent has a registered trademark for a



service falling under Class 41 and the appellant has registered trademark for goods falling under Class 28. Therefore, the parties will have to confine their operation in line with the class under which they have been given the registered trademark. The problem will start only when they attempt to go beyond the class for which the certificate has been issued. However, the learned Single Judge restrained the appellant to run the business entirely. Moreover, at that time of arguments the learned counsel for the respondent/plaintiff also submitted they have no objection in the appellant carrying on with the business falling under Class 28 with their trade name and their only objection is that they are attempting to get into gym business under the style of Home gym which is not covered under the registration granted to them.

11. In these circumstances, we are inclined to modify the order dated 01.10.2021 made in O.S.Nos. 765 and 766 of 2020 by permitting the appellant to carry on with the business of selling body building equipments, fitness trading apparatus, exercise bicycles, joggers, tread mills, exercisers, machines for physical exercise, apparatus for gymnastics which are confined to the equipments falling under class 28 of the certificate trade



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mark certificate stands in the name of GRAND SLAM and it is made clear that the appellant is not permitted to run gym business more particularly Home gym.

With the above modifications, the Original Side Appeals are partly allowed. No costs. Consequently, connected Miscellaneous Petitions are closed.

[M.D., J.] [T.V.T.S., J.]

08.03.2022

msrm/Rj

M.DURAISWAMY, J.



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