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O.A.Nos.352 and 354 of 2023  
in C.S.(Comm.Div).No.95 of 2023

**O.A.Nos.352 and 354 of 2023**  
**in**  
**C.S.(Comm.Div).No.95 of 2023**

**RESERVED ON : 12 .07.2023**

**DELIVERED ON: 19 .07.2023**

**P.T.ASHA, J.,**

The applicant/plaintiff has filed the above suit seeking reliefs in respect of their trademark word “SHAKTI” with an oval ring around the word. It is the case of the plaintiff that they have been pioneers in the manufacture and export of steel and iron products for over 13 years. Some of the products manufactured by the applicant, which are popular in the market, are GI Earthing Strip, Mild Steel Tub, Galvanised Pipe, MS Pipe, Square Tube, Square Hollow Section Pipe etc., The plaintiff has markets not only within the Country but also in the Maldives, Mauritius, Dubai as well Srikanka. Besides the mark “SHAKTI”, the plaintiff also has several brands. The word “SHAKTI”, which is registered under Class 6 in Trade Mark No.10675572, originally belonged to one M/s.Shakti Tubes Ltd, which was incorporated in the



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year 1985. The brand “SHAKTI” has been in use since 2001. On 28.09.2009, under an assignment deed, M/s.Shakti Tubes assigned the mark to the applicant. The applicant has subsequently got it registered in its name and on 18.12.2021, the registration has been extended by a further period of 10 years.

2.It is the case of the applicant / plaintiff that they have an impressive and prestigious line-up of clientèle both in the private and Public sectors and Government owned Companies. Over a period of time, the turnover of the applicant has been steadfastly growing. They would further submit that they have been aggressively advertising the mark “SHAKTI”, so much so that it has become synonymous with the product. While so, in the month of December 2022, the applicant had come across the fraudulent attempt on the part of the respondent to corner the applicant's mark, for which they had adopted the mark “SHAKTI”, which is visibly similar to the applicant's mark. The respondent is also operating in the same trade field as the plaintiff.



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3.Taking into consideration the fact that the applicant had deliberately adopted the name so as to encroach into the applicant's market, the applicant had issued a legal notice dated 28.12.2022 calling upon the respondent to cease and desist from using the applicant's mark “SHAKTI”. The respondent had sent a reply dated 27.01.2023, in which they had admitted the usage of the mark since 2022, but would contend that the name “SHAKTI” is common in the trading fraternity and therefore, the applicant cannot claim an exclusive right to the same. Therefore, the applicant has instituted the suit for the reliefs stated in the plaint and along with the plaint has filed the following applications, whose reliefs are set out herein below.

**O.A.No.352 of 2023**

*(i) to grant an order of Interim Injunction restraining the Respondent. their assigns, successors-in-interest. licensees, franchisees, sister concerns, representatives, servants, distributors, agents, family members, employees, etc. and/or any person or entity acting on behalf of them, from*



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*passing off their business or goods as or for the goods of the Applicant/Plaintiff by restraining them from using Applicant/Plaintiff's trade mark SHAKTI, impugned branding, or any other mark(s) deceptively similar thereto, including, singularly or in conjunction with any other words or monogram/logo, as a trade mark, service mark, corporate name, trade name, trading style, domain name, website address, electronic mail identity or in any other manner whatsoever; on or in relation to or any product, service business including advertising, business papers, etc. pending disposal of the suit.*

**O.A.No.354 of 2023**

*(ii) to grant an order of Interim Injunction against infringement of applicant's/plaintiff's registered Trademark by restraining the respondent/defendant or their assigns, successors-in-interest, licensees, franchisees, sister concerns, representatives, servants, distributors, agents, family members, employees, etc. and/or any person or entity acting*



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*on behalf of them, from using Applicant/Plaintiff's trademark "SHAKTI" components thereof, or any other mark(s) deceptively similar thereto, including MSSHAKTI singularly or in conjunction with any other words or monogram/logo, as a trademark, service mark, corporate name, trade name, trading style, domain name, website address, electronic mail identity or in any other manner whatsoever; on or in relation to or any product pending disposal of the suit.*

4.The respondent, on entering appearance, had filed a counter, which is more or less identical for both applications, in which they would contend that the respondent-Company is an entity of "MS Agarwal Group", which is located at Mantralayam Kurnool, Andhra Pradesh, and would contend that they are a leading manufacturer in India, producing virgin steel under the brands of AF Star and MS Life for the past 3 decades. It is also their contention that they had decided to adopt the mark "SHAKTI" along with the dominant element MS to be in tune with



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the other brand names. They would submit that the dominant element MS is being used by them in five other products and now they have applied for registration of the word mark “MSSHAKTI” and the device “MSSHAKTI”. They would further submit that the applications for registrations were made in the months of March 2022 and May 2022 respectively. Both of these registrations are pending before the Trademark Registry and in their applications for registration of the trademark, the respondent has clearly stated that the mark was proposed to be used. Though an exclusive and elaborate counter running to about 29 pages with 27 paragraphs had been filed, the sum and substance of the counter is that the word "SHAKTI" is a common word which is being used by other traders as well, and therefore, the plaintiff cannot claim exclusivity to the same. Further, they would further contend that the applicant is one of the prior users of the word “SHAKTI,” as it is seen that the others have been using the word "SHAKTI" much prior to the applicant. The respondent has listed out 10 users who have been using the name "SHAKTI" prior to them. It is the case of the respondent that



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they have not copied or infringed their mark, they have conceived and coined the unique mark having a prefix MS, therefore, it is their contention that the applicant is not entitled to orders of injunction as prayed for.

5.The learned counsel for the applicant would draw the attention of this Court to the fact that the applicant has been using this mark for several years, proof of which has been produced in the form of advertisements. These advertisements would clearly show the word mark and device as contended by the applicant. He would further submit that under the Assignment Deed dated 28.09.2009, the mark has been assigned to the applicant Company by the earlier Company M/s.Shakti Tubes Ltd. The learned counsel would submit that they have produced the audited balance sheet to show how the applicant Company has been increasing its business day by day and therefore, at this juncture, if this respondent is permitted to continue to use the trademark "SHAKTI", it would result in grave prejudice and hardship to the applicant. He would



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further submit that the usage of the word "SHAKTI" by the respondent is admitted in their counter and they have also contended that they have started using the mark only in the year 2022, by which point in time the applicant's trademark has been firmly entrenched in the market and the trade name has become synonymous with that of the applicant's products. The learned counsel would submit that by using a similar name, the respondent is attempting to woo away the applicant's customers, thereby causing a dent in their business. The learned counsel would rely upon an unreported judgment of the Delhi High Court in ***CS(Comm) 850 of 2018 and I.A.Nos.6402 and 16184 of 2018 [New Balance Athletics, INC Vs Apex Shoe Company Pvt.Ltd.]***, where in paragraph 13(b), the learned Judge has observed that even where a registration describes the mark as a device but includes a word mark and consumers identify this word mark de hors the device, then in such cases, the registration is of a composite mark meaning the device as well as the word mark.



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6.Per contra, Ms.Balajanaki, learned counsel on behalf of the respondent would submit that the applicant / plaintiff has not filed any documents to show their earlier usage of the mark. That apart, there are others, who are using a similar mark and therefore, the applicant cannot claim an exclusive right to the same. Further, balance sheets have been filed only from the year 2011. The learned counsel would refer to the trademark certificates issued by the respondent in respect of other marks where the letters MS are seen. She would further submit that by no stretch of the imagination can it be said that the applicant's trademark and the respondent's trademark are similar, and since the applicant has failed to prove the infringement, they are not entitled to any interim order.

7.Heard the learned counsel on either side and perused the materials available on record.

8.The applicant /plaintiff has approached this Court seeking



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interim orders on the basis that the trade name "SHAKTI" with the oval ring is their exclusive mark, which has been in usage since 2001. To prove the above, they have filed the Trademark Certificates issued to the earlier owner of the trademark, M/s.Shakti Tubes Ltd. A perusal of the certificate of registration would indicate that an application for registering the trademark was made on 18.12.2001, this would only go to show that the applicant had conceived the mark in the year 2001 itself and had chosen to have the same registered so as to claim exclusivity with reference to the same. This mark has thereafter been assigned in favour of the applicant under the deed of assignment dated 28.09.2009. The recitals of this assignment would clearly show that the assignor, M/s.Shakti Tubes Ltd was the owner of the trademark SHAKTI (1067572) in Class 6. Further, the applicant has filed several advertisements in the Hindi Dailies where this trademark "SHAKTI" enclosed in an oval ring has been published as belonging to the applicant. The applicant has also been advertising to the general public about their product, and therefore, from the year 2001, the applicant's



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product has been advertised under this mark. The applicant has also produced a statement of accounts relating to their income derived from their business, which includes the sale of their products under the name and style "SHAKTI". These products have also been marketed to various customers which documents have also been filed. The registration of the applicant's trademark has also been renewed for a further period of 10 years, starting from 19.12.2021. The applicant has also produced a certificate of product approval from the Government of Tamil Nadu in respect of their product "SHAKTI". On the contrary, it is seen that the respondent has applied for the mark and device mark only in March and May 2023, respectively. Even in the application, it is stated that they are proposing to use their trademark. As pointed out by the learned counsel for the applicant, it is only in January 2023 that the respondent has been able to show that they have effected supplies in the name and style "MS SHAKTI".

9. That apart, the application for registration of trademark would



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itself show that the respondent was only proposing to use the name.

Therefore, as on March 2022 and May 2022, the applicant had not started using the mark. This is confirmed by the fact that the first invoice showing the mark was issued only in the month of January 2023. Therefore, from the above narration, it is clear that the applicant has not only registered the word mark in the year 2001 but has also been continuously using the same mark for nearly two decades much prior to the respondent.

10.An argument has been made by the learned counsel for the respondent that what has been registered is only the device and not the word mark. This argument is answered by the Delhi High Court in the judgment cited on the part of the applicant. The dispute related to the word mark “NEW BALANCE”, which was the word mark of the applicant / plaintiff and the respondent had adopted the very same name to which the word apex was added. The certificate issued too the plaintiff showed the trademark type as “device” and the word mark as



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“NEW BALANCE”, which is similar to the instance case. The learned

Judge has observed as follows:

*“13.B.....Such a registration, though may be classified as of a device but conveys only the word mark and there is nothing else in the device by which the consumers can identify the same de hors the word mark. The consumers are unlikely to distinguish between the words „NEW BALANCE" placed in a rectangle and the same words without the lines of the rectangle around them. The contention of the counsel for the defendant that the plaintiff cannot claim benefit of the said registration to restrain the defendant from using the word mark “NEW BALANCE" owing to being of a device mark, thus cannot be accepted”*

11.The other point that was canvassed by the respondent is that the word “SHAKTI” is common and the respondent's word mark has a prefix MS which is the dominant element. The word “SHAKTI” has been associated with the applicant's products since 2001. Both parties are



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operating in the same area of manufacturing. In this regard, a useful reference can be made to the judgment of a Division Bench of this Court reported in **2006 (32) PTC 434 (Madras) (DB) Devi Pesticides Pvt.Ltd V. Shiv Agro Chemicals Industries**. In that case, the plaintiff claimed ownership over the trademarks BOOMPLUS and BOOM FLOWER. The defendant's trademark was unregistered. The Bench went on to hold that even if a part of the registered trademark was being used by the defendant, it would amount to infringement. In that case, BOOM was an essential part of the registered mark of the plaintiff, which had been incorporated into the defendant's trademark and the defendant had been enjoined from using the word BOOM. This judgment has also been usefully referred to by the Delhi High Court in a judgment reported in **2007 (35) PTC 95 (Delhi) (DB) [Cadbury India Limited and Others Vs. Neeraj Food Products]**. In a judgment reported in **1965 AIR 980 [Kaviraj Pandit Durga Dutt Sharma vs. Navaratna Pharmaceutical Laboratories]**, where the issue in question was with reference to two



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registered trademarks, the Hon'ble Supreme Court observed as follows:

*“....Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the, plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiffs registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered. ....*

*in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks-the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiffs mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant.”*



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In the instant case, the applicant has established that the word "SHAKTI" has become synonymous with its products through its long usage and the adoption of the said word by the respondent would definitely amount to infringement and therefore, the applicant is entitled to the relief as claimed. Accordingly, there shall be an order of interim injunction as prayed for in O.A.Nos.352 and 353 of 2023 till the disposal of the suit. The two applications are allowed.

19.07.2023

Index : Yes/No  
Speaking order/non-speaking order

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