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C.S.(Comm. Div.)No.102 of 2023



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 21.12.2023

CORAM

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

C.S.(Comm. Div.)No.102 of 2023

M/s.Carborundum Universal Limited,
Parry House,
43, Moore Street,
Chennai - 600 001.
Rep. by its Manager - Legal,
Mr.CM Anand.

... Plaintiff

Vs.

Selvam Hardwares,
No.2/23, Seethakathi Salai,
Mogappair East,
Chennai - 600 037.

... Defendants

PRAYER: Complaint filed under Order IV Rule 1 of O.S. Rules and Order VII Rule 1 of CPC read with Sections 27, 29, 134 and 135 of Trade Marks Act, 1999 and Proviso 1 to Section 7 of the Commercial Courts Act, 2015 to pass a judgment and decree against the defendants on the following terms:

a) a permanent injunction restraining the Defendant, their/partners, men, servants, agents, distributors, stockists, successors in business, retailers, legal representatives, heirs, assigns or any other person claiming



through or under them, from providing, offering, selling and marketing, advertising by use of identical trade dress and identical trademark SPEED as that of the Plaintiff's registered trademark SPEED amounting to infringement or any mark similar to the Plaintiff's trade dress and registered trademark SPEED or in any other manner for promoting its products whatsoever;

(b) a perpetual injunction restraining the Defendant, by themselves, its proprietor, servants, heirs, successors, agents, distributors, stockists, advertisers, retailers, representatives or any of them from in any manner passing off and enabling others to pass off their diamond cutting and polishing tools as and for the Plaintiff's products by use of identical trademark SPEED or any other mark similar thereto in respect of their products or business or any other trademark/label deceptively similar to the Plaintiff's trade dress and trademark SPEED or in any other manner whatsoever;

(c) To pass an order of declaration, declaring the Plaintiff's registered trademark SPEED as well-known trademark within the meaning of Section 2(1)(zg) read with Section 11(6) of the Trademarks Act, 1999 along with a direction to the Registrar of Trademarks to notify the mark SPEED on the register of well-known trademarks;

(d) Damages to the tune of Rs. 10,00,000/- for the loss of sale and revenue or such higher amount as may be claimed by the Plaintiff at a later



date and as may be determined by this court upon enquiry.

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(e) The Defendant be ordered to surrender to the Plaintiff for destruction, diamond cutting and polishing tools, pouches, prints, dies, blocks, screen prints, packing and advertising material and any other material in their possession, which are a substantial reproduction of the Plaintiff's trademark SPEED;

(f) A preliminary decree be passed in favour of the Plaintiff directing the Defendant to render accounts of profits made by them by use of the trademark SPEED which is identical and/or deceptively similar and a final decree be passed in favour of the Plaintiff for the amount of profits found to have been made by the Defendant after the latter has rendered accounts;

(g) for costs of the suit.

For Plaintiff : Ms.Shruthi Srinivasan
for Mr.Arun C.Mohan

For Defendant : Mr.D.Gopinathan
Mr.S.Sankara Pandian

JUDGMENT

This suit has been filed seeking for the following reliefs:

a) a permanent injunction restraining the Defendant, their/partners, men, servants, agents, distributors, stockists, successors in business,



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retailers, legal representatives, heirs, assigns or any other person claiming through or under them, from providing, offering, selling and marketing, advertising by use of identical trade dress and identical trademark SPEED as that of the Plaintiff's registered trademark SPEED amounting to infringement or any mark similar to the Plaintiff's trade dress and registered trademark SPEED or in any other manner for promoting its products whatsoever;

(b) a perpetual injunction restraining the Defendant, by themselves, its proprietor, servants, heirs, successors, agents, distributors, stockists, advertisers, retailers, representatives or any of them from in any manner passing off and enabling others to pass off their diamond cutting and polishing tools as and for the Plaintiff's products by use of identical trademark SPEED or any other mark similar thereto in respect of their products or business or any other trademark/label deceptively similar to the Plaintiff's trade dress and trademark SPEED or in any other manner whatsoever;

(c) To pass an order of declaration, declaring the Plaintiff's registered trademark SPEED as a well-known trademark within the meaning of Section 2(1)(zg) read with Section 11(6) of the Trademarks Act, 1999 along



with a direction to the Registrar of Trademarks to notify the mark SPEED on the register of well-known trademarks;

(d) Damages to the tune of Rs. 10,00,000/- for the loss of sale and revenue or such higher amount as may be claimed by the Plaintiff at a later date and as may be determined by this court upon enquiry.

(e) The Defendant be ordered to surrender to the Plaintiff for destruction, diamond cutting and polishing tools, pouches, prints, dies, blocks, screen prints, packing and advertising material and any other material in their possession, which are a substantial reproduction of the Plaintiff's trademark SPEED;

(f) A preliminary decree be passed in favour of the Plaintiff directing the Defendant to render accounts of profits made by them by use of the trademark SPEED which is identical and/or deceptively similar and a final decree be passed in favour of the Plaintiff for the amount of profits found to have been made by the Defendant after the later has rendered accounts;

(g) for costs of the suit.

2. Both the parties have now filed a joint memorandum of compromise dated 21.12.2023 which has been signed by the plaintiff as well



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as the defendant and counter signed by their respective counsels. By virtue of the memorandum of compromise, the plaintiff and the defendant have amicably settled the dispute amongst themselves in so far as the prayer Nos.a, b, d, e, f and g are concerned in the plaint. However, the plaintiff has also sought for a declaration to declare the plaintiff's registered trademark "Speed" as a well known trademark within the meaning of Section 2 (1)(zg) read with Section 11(6) of the Trademarks Act, 1999 along with a direction to the Trademarks Registry to notify the trademark "Speed" in its register as a well known trademark. The said relief is claimed in prayer No.C of the plaint which prayer is sought for not against the defendant. Since the plaintiff is seeking the additional relief of declaration that the plaintiff's registered trademark "Speed" is a well known trademark, this Court will have to adjudicate the said relief as well.

3. In the plaint, the plaintiff has disclosed its credentials and its reputation in the market. They claim that they are a leading constituent of the US\$ 4 Billion worth Murugappa Group, the First Asian Business group to have been awarded the prestigious IMD Distinguished Family Business Award by IMD Lausanne, the internationally renowned business school in



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Switzerland, for demonstrating continuity, value creation, social contribution and business management. The Murugappa Business Conglomerate has diversified business interests in Abrasives, Refractories, Ceramics, Engineering, Bicycles, building materials, Sugar, Farm Inputs, Plantations and Financial Services. The Plaintiff's range of business includes, Power Tools, Diamond Cuttings and Polishing tools, Machine tools, Grindstone, Abrasives, Refractories, Electro minerals, and Industrial Ceramics and the Plaintiff is the pioneer in coated abrasives, bonded abrasives and tools for stones in India in addition to the manufacture of super refractories, electro minerals and industrial ceramics and has introduced cutting edge technology to bring their products on par with global standards. They are committed to the highest standards of Corporate Governance in all its activities and processes.

4. The Plaintiff has shown steady growth in its turnover since its inception in the year 1954. Their (Standalone) turnover for the last few years is as follows:

<i>Year</i>	<i>Amount (Rs. in Million)</i>
2002-03	2475
2003-04	2748



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<i>Year</i>	<i>Amount (Rs. in Million)</i>
2004-05	3112
2005-06	3721
2006-07	4646
2007-08	5868
2008-09	6578
2009-10	7381
2010-11	9105
2011-12	11052
2012-13	10800
2013-14	11276
2014-15	11518
2015-16	12735
2016-17	13828
2017-18	15514
2018-19	17519
2019-20	16511
2020-21	16722
2021-22	22152
2022-Till December 2023	18682

5. During the course of their business, the Plaintiff company has adopted various trademarks in respect of their multifarious business activities and products. Few of the noteworthy trademarks of the Plaintiff include CARBORUNDUM, CARBORUNDUM UNIVERSAL, CUMI, CHAMAK, AUTOPAPER, AJAX, SPEED, JAWAN, etc. All the above



mentioned marks are reputed and well received by the trade and public, who associate the said marks only with the Plaintiff and no one else.

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6. As stated hereinabove, the Plaintiff in the course of its business, adopted the trademark SPEED in the year 2007 in respect of diamond cutting, polishing tools, machine tools, hand held tools (mechanically operated). They are the registered proprietor of the mark SPEED bearing application no. 2358738 in class 7 for power operated tools namely diamond cutting and polishing tools, abrasives, cutting and polishing tools, high speed steel and carbide cutting tools, machine tools, apparatus machining, hand held tools [mechanically operated], electric cutters, grindstones (as part of machines). The said registration is valid and subsists till date. They have manufactured and sold extensively granite cutting diamond saw under the trademark SPEED for more than a decade. The said mark SPEED is honestly adopted with the bona fide intention to use the mark in respect of goods manufactured / marketed by them. They would submit that the mark SPEED has been openly, extensively and continuously used in respect of diamond cutting and polishing tools since the year 2007 and are extensively renowned throughout the trade and public for its quality



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and durability. Having used the mark SPEED in respect of their goods, they have garnered tremendous goodwill and enviable reputation among trade and public and brand recognition among its consumers is irrefutable throughout the country. They are also the registered proprietor of the mark/label CUMI SPEED WITH POWER BOND bearing no. 2564386 in class 7 and for the mark SPEED in class 3 bearing no. 4393117. The registrations are valid and subsisting till date. The Legal Use Certificates for the registered trademarks of the Plaintiff have been applied for. However, the trademark registration certificates along with their respective journal copies have been filed.

7. The Plaintiff is doing business worth several crores of rupees in respect of the mark SPEED and the same has been increasing steadily all through the years since the inception of the said mark. The sales figures and sales promotional figures of the Plaintiff's goods under the mark SPEED since the year 2007 is as follows:-

<i>Year</i>	<i>Sales figures (Rs. in Lakhs)</i>
2007-08	91
2008-09	212
2009-10	591
2010-11	657



<i>Year</i>	<i>Sales figures (Rs. in Lakhs)</i>
2011-12	1005
2012-13	1400
2013-14	1893
2014-15	1813
2015-16	2349
2016-17	2568
2017-18	2580
2018-19	3533
2019-20	3116
2020-21	2825
2021-22	3975
2022-23	4537

8. The Plaintiff has also invested huge sums of money for advertising their trade mark SPEED in respect of their goods, by advertising the mark through various platforms including magazines, journals, hoardings and glow signs. Through extensive advertisements, the mark SPEED has attained tremendous reputation and goodwill among the trade and public. The sales promotion expenses incurred by the Plaintiff in respect of the mark SPEED since the year 2007-08 to 2022-23 is Rs. 15 Lakhs.

9. By virtue of long, continuous and extensive use, the trademark SPEED for diamond cutting and polishing tools has come to be exclusively



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associated only with the plaintiff. Their trademark SPEED has established tremendous reputation and goodwill in the market by virtue of high quality and durability of the product.

10. The Plaintiff states that the mark SPEED has been openly, extensively and continuously used in respect of diamond cutting and polishing tools since the year 2007 and are extensively renowned throughout the trade and public for its quality and durability. Having used the mark SPEED in respect of their goods, they have garnered tremendous goodwill and enviable reputation among the trade and public and brand recognition among its consumers is irrefutable throughout the country. They have spent considerable amount of time and money in promoting and advertising their products bearing the mark SPEED as mentioned above.

11. In support of the plaintiff's contention, that the trademark "Speed" is a well known trademark, the plaintiff has filed the following documents before the learned Additional Master - II which have been marked as Exs.P1 to P9:

" Ex.P1 is the original board resolution dated



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12.10.2023.

Ex. P2 is the certified copy of the certificate of incorporation dated 21.04.1954.

Ex.P3 is the online printout of the trademark registration certificate along with the Journal Copy for the mark SPEED under no.2358738 in class 7 dated 05.07.2012. (Affidavit under Section 65 B of the Indian Evidence Act filed and recorded)

Ex.P4 is the online printout of the trademark registration certificate along with the Journal Copy for the mark CUMI SPEED WITH POWER BOND under no.2564386 in class 7 dated 15.07.2013. (Affidavit under Section 65 B of the Indian Evidence Act filed and recorded)

Ex.P5 is the online printout of the trademark registration certificate along with the Journal Copy for the mark SPEED under no.4393117 in class 3 dated 30.12.2019. (Affidavit under Section 65 B of the Indian Evidence Act filed and recorded)



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Ex.P6 is the printout of invoice regarding sale of products under the mark SPEED for the period 2012 to 2023.(Affidavit 2023. (A under Section 65 B of the Indian Evidence Act filed and recorded)

Ex.P7 is the printout of advertisement and other sales promotional material regarding plaintiff trade mark SPEED. (Affidavit under Section 65 B of the Indian Evidence Act filed and recorded)

Ex.P8 is the printout of the photograph of plaintiff's SPEED label. (Affidavit under Section 65 B of the Indian Evidence Act filed and recorded)

Ex.P9 is the printout of the photograph of defendant's SPEED label. (Affidavit under Section 65 B of the Indian Evidence Act filed and recorded)"

12. The plaintiff's authorized representative Mr.C.M.Anand, who is the Manager (Legal) of the plaintiff's company was examined as a witness (PW1) on behalf of the plaintiff. He has also filed a proof affidavit, reiterating the plaint averments.



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13. As seen from the exhibits marked on the side of the plaintiff, the plaintiff has obtained trademark registration for its trademark "Speed" in class-7 on 05.07.2012 and the trademark registration has been marked as Ex.P3. The trade dress of the plaintiff's registered trademark "Speed" has also been registered under the Trademarks Act on 15.07.2013 which has been marked as Ex.P4. Ex.P5 is the online printout of the trademark registration certificate along with the Journal copy for the mark "Speed" registered in class - 3 which is dated 13.12.2019. Ex.P6 are the invoices regarding sale of products made by the plaintiff under the mark "Speed" for the period 2012 - 2023. Ex.P7 is the advertisement and other sales promotional materials made by the plaintiff in respect of the trademark "Speed". Ex.P8 is the photograph of the plaintiff's "Speed" label.

14. As seen from the aforementioned documents, which have been marked as exhibits, it is clear that the plaintiff's Company is having a huge turnover by the usage of the registered trademark "Speed" for diamond cutting, polishing tools, machine tools, grindstone and abrasives (hand held tools and mechanically operated tools) ever since 2007. The sales turnover and the marketing cost and expenditure incurred by the plaintiff has also



been highlighted in the plaint, which is also huge. Judicial notice can also be taken about the reputation of the trademark "Speed".

15. Section 11 (6) of the Trademarks Act gives concurrent powers to both this Court as well as the Trademark Registry to declare a particular trademark as a well known mark. This Court being the competent Court is empowered to declare as to whether the plaintiff trademark is a well known trademark or not.

16. Section 11 (6) of the Trademarks Act, 1999 reads as follows:

"11. (6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including -

(i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;



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(ii) the duration, extent and geographical area of any use of that trade mark;

(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any publication for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark;

(v) the record of successful enforcement of the rights in that trade mark, in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record."

17. The plaintiff has proved through oral and documentary evidence, as well as from its pleadings that the plaintiff is a well known mark.



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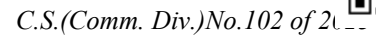


18. The learned counsel for the plaintiff on instructions would submit that the declaration to be granted by this Court can be restricted to diamond cutting, polishing tools, machine tools, grindstone and abrasives (hand held tools and mechanically operated tools) alone in respect of the trademark "Speed". The pleadings, oral and documentary evidence placed on record also supports the submissions of the learned counsel for the plaintiff.

19. Since the trademark Registry is not a party defendant in the suit, a direction to the trademark Registry from this Court to notify in its Register that "Speed" is a well-known mark cannot be granted and therefore, the said direction sought for is rejected by this Court.

20. In the result the suit is partly decreed by granting the following reliefs :

a) The suit claim against the defendant is disposed of in terms of the memorandum of compromise dated 21.12.2023 entered into between the plaintiff and the defendant and the memorandum of compromise shall form part of this Judgment and Decree;



21.12.2023

<https://www.mhc.tn.gov.in/judis>



List of Witness examined on the side of the Plaintiff:-

Mr.C.M.Anand (PW1)

List of the Exhibits marked on the side of the Plaintiff:-

Ex.P1 is the original board resolution dated 12.10.2023.

Ex. P2 is the certified copy of the certificate of incorporation dated 21.04.1954.

Ex.P3 is the online printout of the trademark registration certificate along with the Journal Copy for the mark SPEED under no.2358738 in class 7 dated 05.07.2012. (Affidavit under Section 65 B of the Indian Evidence Act filed and recorded)

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ABDUL QUDDHOSE. J.,

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