



WEB COPY



C.S. (Comm. Div.) No.170 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 12.06.2024

Coram:

THE HONOURABLE MR. JUSTICE P.VELMURUGAN

C.S. (Comm. Div.) No.170 of 2023

B.Ramesh Kumar

Sole Proprietor of M/s.Bharat Industries

No.9 & 10, 9th Main Road,

Kannadasan Nagar

Chennai - 600 118

... Plaintiff

Vs.

Anekant Jain

Sole Proprietor of M/s.Ashish Steel

24/18/1/1, Mathupur Village

Sonepat, Haryana - 131028

... Defendant

Prayer: The suit filed under Order VII Rule 1 of CPC and Order IV Rule 1 of Original Side Rules read with Sections 27, 28, 29, 34, 135 of the Trademarks Act, 1999 and Section 7 of the Commercial Courts Act, praying to pass a judgment and decree against the Defendant on the following terms:-



WEB COPY



C.S. (Comm. Div.) No.170 of 2023

a. A permanent injunction restraining the Defendants, by itself, its lawful assignees, men, servants, agents, distributors, stockiest, representatives or any one claiming through or under them from in any manner infringing the plaintiff's registered trademarks 'DIAMOND under Nos. 1372188 and 2324908 in Class 21 by manufacturing, marketing, using or in any other manner dealing with House Hold and Kitchen utensils under the trademark ANEKANTS DIAMOND' or in any other manner similar and identical to the Plaintiff's Registered Trade Mark "DIAMOND";

b. A permanent injunction restraining the Defendant, its lawful assignees, men, servants, agents, distributors, stockiest, representatives or any one claiming through or under them from in any manner passing off and/or enabling others to pass off the Defendants products under the trademark ANEKANTS DIAMOND' as and for the plaintiffs' products by manufacturing, selling, or offering to sell, distributing, displaying, printing, stocking, using, advertising their products with a trademark and/or label that is identical in with that of the plaintiff's 'DIAMOND' trademark or in any other manner similar and identical to the Plaintiffs Trade Mark "DIAMOND";

c. The defendants be ordered to pay to the plaintiff a sum of Rs.1,00,000/- as damages for committing acts of infringement against plaintiff's registered trade mark and pass-off its products as and for the plaintiffs' products.



C.S. (Comm. Div.) No.170 of 2023

d. The defendants be ordered to surrender to the plaintiff for destruction of all products, labels, cartons, dyes, blocks, visiting cards, leaflets, promotional materials, moulds, screen prints, packing materials and other materials bearing the trademark 'ANEKANTS DIAMOND' or any mark deceptively similar to plaintiff's trademark 'DIAMOND'.

e. A preliminary decree be passed in favour of the plaintiff directing the defendants to render account of profits made by use of trademark "ANEKANTS DIAMOND" and a final decree be passed in favour of the plaintiff for the amount of profits thus found to have been made by the defendants after the latter have rendered accounts; and

f. for costs of the suit.

For Plaintiff : Mr.Ashok Kumar J.Daga
For Defendant : Set Ex-parte on 15.04.2024

JUDGMENT

This suit is filed by the plaintiff for (a) a permanent injunction restraining the defendant from in any manner infringing the plaintiff's registered trade mark "DIAMOND" (b) a permanent injunction restraining



C.S. (Comm. Div.) No.170 of 2023

the defendant in any manner passing off and/or enabling others to pass off

the defendants products under the trademark “ANEKANTS DIAMOND”

(c) The defendants be ordered to pay to the plaintiff a sum of Rs.1,00,000/-

as damages for committing acts of infringement (d) the defendants be

ordered to surrender to the plaintiff for destruction of all products bearing

the trademark 'ANEKANTS DIAMOND' or any mark deceptively similar

to plaintiff's trademark 'DIAMOND' (e) a preliminary decree be passed in

favour of the plaintiff directing the defendant to render account of profits

made by use of trademark "ANEKANTS DIAMOND" and a final decree

be passed in favour of the plaintiff for the amount of profits thus found to

have been made by the defendants after the latter have rendered accounts;

and for costs of the suit.

2. The averments made in the plaint in brief as follows;

The Plaintiff has adopted the mark 'DIAMOND' and has been using

the same continuously and uninterruptedly since 1982 in respect of



C.S. (Comm. Div.) No.170 of 2023

Stainless-steel Utensils and House hold products by virtue of their long, continuous, uninterrupted, and extensive use for over 4 decades. The plaintiff has acquired and retained exclusive proprietary rights over the mark 'DIAMOND'. The plaintiff's presence in the business over the last 40 years in itself stands as a testimony to the fact that the plaintiff's products are one of the most-sought after products in the market. From the inception, the goods of the plaintiff were distinguished from the goods of others and were known for their superior quality. The mark 'DIAMOND' has inherent distinctiveness from its usage and quality of products associated to it. The plaintiff continuous efforts have transformed plaintiff to be a pioneer in the business of manufacturing and marketing of Stainless-steel utensils and other Household vessels. The efforts of the Plaintiff's management and employees, coupled with the quality of Stainless- Steel Utensils, Household Vessels, Pressure cooker, Non-stick cookware, and Home Appliances, has not only brought the plaintiff



C.S. (Comm. Div.) No.170 of 2023

tremendous success but has also resulted in the plaintiff acquiring excellent reputation and goodwill from the consumers and the trade circles alike.

(i) The plaintiff's Trade Mark "DIAMOND" has become a household name in India and the general public are extremely satisfied with the products sold by the plaintiff thereunder. Owing to its distinctiveness, popularity, and its endeavor in maintaining consistent superior quality in its products for more than four decades, the consumers exclusively associate the trademark 'DIAMOND' with the plaintiff. In order to safeguard its enormous goodwill and reputation, further to acquire statutory rights and protection, the plaintiff had applied for registration of the trademark 'DIAMOND' in Class 21 before the Trademarks Registry, Chennai and the same has been granted. The registration is valid and subsisting till date. The plaintiff is also the owner of the Copyright Artistic work "DIAMOND LABEL" covered under Registration No.A-89822/2011. The plaintiff has got the exclusive rights to use and adopt



C.S. (Comm. Div.) No.170 of 2023

trade mark "DIAMOND" by the virtue of Registrations being granted to and in favour of the plaintiff in respect of goods falling in Class 21 i.e- Stainless Utensils and Household products. The plaintiff's sister concerns with due consent of the plaintiff have also sought registration of trade mark "DIAMOND" for several other business sectors to expand their area of horizon and commercial activities.

(ii). The Stainless-steel Utensils and other Household products sold under the trade mark "DIAMOND" are sold across India and was one among the most sought and searched brands in respect of Stainless-Steel Utensils and other House hold products industry. The product reputation has increased tremendously by the increase in the orders and repeated purchases by the consumers. The exorbitant demand of the products of the plaintiff showcases the quality of the plaintiffs' products under their Registered Trade Mark "DIAMOND".

(iii). The plaintiff also strives to adhere to the Governmental norms



C.S. (Comm. Div.) No.170 of 2023

and procedures. The Sole proprietor of the plaintiff firm is a law-abiding citizen. The plaintiff's due diligence in all the procedures to be followed has pumped up the plaintiff's goodwill and reputation. The Plaintiff's various certificates including but not restricted to the ISO 9001: 2015, Certificate of Registration issued by the Department of Labour, Government of Tamil Nadu, UDYAM Registration Certificate issued by the Ministry of Micro, Small and Medium Enterprises, Fire Service License issued by the Fire & Rescue Department, Chennai City North District, Permanent Registration Certificate issued by the Government of Tamil Nadu, Directorate of Industries are filed herewith as Plaint Document No. 5 (Series).

(iv). The plaintiff's Turnover in respect Stainless steel utensils and other household products manufactured and traded by them runs to several Crores of rupees. The plaintiff has further established a wide network for its products. The plaintiff's stainless-steel utensils and other household



C.S. (Comm. Div.) No.170 of 2023

products sold under the trade mark "DIAMOND" have witnessed steady increase since the date of the adoption. The plaintiff herewith files the Sales Turnover certificate duly certified by Chartered Accountant as Plaintiff Document No. 6 (series).

(v). The plaintiff has spent enormous amount for advertising products under the trade mark “DIAMOND”. By reasons of extensive sales and publicity, the use of the said trademark “DIAMOND” has gained enormous amount of goodwill and reputation and the trademark has come to be exclusively associated with the plaintiff. The plaintiff after due consultation with the Indian Railways, have caused advertisements and sales promotional activities in various Railway stations. The plaintiff has also advertised through Posters placed behind various Autos, Buses and various other modes of transport and they have also advertised through hoardings, Bill Boards for various wholesales, retailers, stockist and super stockist. Apart from that, the plaintiff has made Mass advertisements of its



C.S. (Comm. Div.) No.170 of 2023

trade mark “DIAMOND” in various newspapers and TV channels including JAYA TV, MURASU TV, NEWS 7 TV etc. Further, the plaintiff has also participated in various Stainless steel trade fairs and exhibitions in various cities such as Chennai, Ahmedabad, Mumbai etc.

(vi). While so, in the month of October 2022, the plaintiff came to know while carrying on a general search on the trade mark website that the defendant deceitfully and spuriously obtained registration of the work mark “ ANEKANT DIAMOND” in Class 21, similar and identical to plaintiffs registered trade mark “DIAMOND”. Further the plaintiff was shocked and surprised to discover that the defendant way back in 2016 applied for registration of the trade mark which is deceptively similar to that of the plaintiff's prior used and prior registered trade mark “DIAMOND” and it was also surprised to note that the defendant in the said application claimed the user since 21.06.2011 which according to the plaintiff to be false and frivolous. The said application was subsequently



C.S. (Comm. Div.) No.170 of 2023

refused by the Trade Mark Registry on the ground that the said trade mark along with the device /logo is similar and identical to plaintiff's trade mark and there exists a likelihood of confusion in the minds of the public. Hence, the defendant figure out on ways as to how to deceitfully procure registration with the trade mark "DIAMOND" being prominent mark. That is when the defendant filed another trade mark application for obtaining registration of trade mark "ANEKANT" on 19.06.2019. Exactly after 6 days, the defendant filed another application for registration of trade mark "ANEKANT DIAMOND" covered under Application No.4214857-a word mark on 24.06.2019 on a proposed to be basis with an association of the earlier application "ANEKANT". The said act of filing applications with a common suffix "DIAMOND" in itself proves the defendant's dishonest and *mala fide* intention to bank upon the plaintiff voluminous goodwill and reputation under the registered trade mark "DIAMOND". The plaintiff upon gaining the knowledge of the defendant's registration on 12.10.2022,



C.S. (Comm. Div.) No.170 of 2023

immediately filed an application for rectification of the registered trade mark “ANEKANT DIAMOND” in Class 21 before the Trade mark Registry, Delhi and the same is pending adjudication. The plaintiff is advised to state that the suit for infringement of trade mark is maintainable even against a registered proprietor of the trade mark.

(vii) The device mark for which the registration is sought is just a replica of the device of the plaintiff's trade mark with some minor changes. The overall impression of defendant's device mark is similar and identical to the plaintiff's trade mark and the existence of defendant mark will cause confusion in the minds of the public and trade. The device mark is designed in such a way showing the prominent mark “DIAMOND” as the main trade mark. The defendant has wantedly and knowingly adopted the colour as that of the plaintiff. The defendant has adopted the impugned trade mark solely for the purpose of exploiting the commercial goodwill of the plaintiff. In the month of January 2023, through its market force, the



C.S. (Comm. Div.) No.170 of 2023

plaintiff discovered that the defendant apart from filing of the trade mark applications, has also started to sell goods/products under the deceptive logo which itself clear that the defendant is passing off his goods /products as that of the plaintiff's goods/products. It is a well calculated attempt to infringe the registered trade mark the plaintiff and pass off the defendant business and goods as that of the plaintiff. Hence, the plaintiff issued a cease-and desist notice to the defendant for which, the defendant had issued a reply through their counsel expressing their intention to refuse to accede and comply to the demand of the plaintiff. Subsequently, a rejoinder to the Cease and Desist notice was sent to the counsel for the defendant for which, no reply was received. Hence, the present suit is filed against the defendant.

3. Even though substituted service of paper publication was effected by the plaintiff, non appeared on behalf of the defendant. Therefore, the defendant was set ex-parte by this Court on 15.04.2024.



C.S. (Comm. Div.) No.170 of 2023

4. In order to substantiate his claim, the plaintiff filed his proof affidavit for chief examination and reiterated the averments made in the plaint in his proof affidavit and also marked 11 documents as Ex.P.1 to Ex.P.11 in which, Ex.P.1 is the Certified copy of the plaintiff registered trade mark No.1372188 dated 19.07.2005 and No.2324908 dated 02.05.2012, Ex.P.2 is the Certified copy of the plaintiff's sales turnover certificate duly certified by chartered accountant dated 22.04.2023, Ex.P.3 is the certified copy of sales invoices of the plaintiff, Ex.P.4 is the Certified copy of the invoices of the advertisement by the plaintiff, Ex.P.5 is the Certified copy of the status of the defendant's application trademark No.4214857 dated 24.04.2019, Ex.P.6 is the certified copy of the status of the defendant's app No.3330331 dated 05.08.2016 along with the examination report dated 18.11.2016 and the refusal order dated 08.01.2021 issued by the Trade Mark Registry, Ex.P.7 is the certified copy of the status of defendant's trade mark application No.4538063 dated



C.S. (Comm. Div.) No.170 of 2023

19.06.2020 along with the order dated 19.03.2024 passed by the Trade Mark Registry, Ex.P.8 is the certified copy of the infringing goods and the promotional materials belonging to the defendant, Ex.P.9 is the certified copy of the cease and desist notice issued by plaintiff along with the xerox copy of postal receipt dated 24.01.2023, Ex.P.10 is the certified copy of the reply to cease and desist notice dated issued by the defendant 07.02.2023, Ex.P.11 is the certified copy of the rejoinder issued by plaintiff to reply to the cease and desist notice along with the copy of postal receipt and tracking details dated 01.03.2023.

5. Despite the plaintiff taken substituted service, none appeared on behalf of the defendant and filed written statement. Therefore, the claim of the plaintiff has not been challenged by the defendant.

6. On a perusal of the averments made in the plaint and proof affidavit filed by P.W.1 and also the documentary evidence marked on the side of the plaintiff, this Court finds that the plaintiff has proved his claim.



C.S. (Comm. Div.) No.170 of 2023

7. Therefore, the suit is decreed as prayed as prayed for with cost.

12.06.2024

(1/2)

List of witnesses examined on the side of the plaintiff – 1 witness

B.Ramesh Kumar – P.W.1

List of exhibits on the side of the plaintiff – 11 Documents

S.No.	Exhibits	Description of documents
1	Ex.P.1	The Certified copy of the plaintiff registered trade mark No.1372188 dated 19.07.2005 and No.2324908 dated 02.05.2012.
2	Ex.P.2	The Certified copy of the plaintiff's sales turnover certificate duly certified by chartered accountant dated 22.04.2023.
3	Ex.P.3	The certified copy of sales invoices of the plaintiff.
4	Ex.P.4	The Certified copy of the invoices of the advertisement by the plaintiff.
5	Ex.P.5	The Certified copy of the status of the defendant's application trademark No.4214857 dated 24.04.2019.
6	Ex.P.6	The certified copy of the status of the defendant's app No.3330331 dated 05.08.2016 along with the examination report dated 18.11.2016 and the refusal order dated 08.01.2021 issued by the Trade Mark Registry.



C.S. (Comm. Div.) No.170 of 2023

S.No.	Exhibits	Description of documents
7	Ex.P.7	The certified copy of the status of defendant's trade mark application No.4538063 dated 19.06.2020 along with the order dated 19.03.2024 passed by the Trade Mark Registry.
8	Ex.P.8	The certified copy of the infringing goods and the promotional materials belonging to the defendant.
9	Ex.P.9	The certified copy of the cease and desist notice issued by plaintiff along with the xerox copy of postal receipt dated 24.01.2023.
10	Ex.P.10	The certified copy of the reply to cease and desist notice dated issued by the defendant 07.02.2023
11	Ex.P.11	The certified copy of the rejoinder issued by plaintiff to reply to the cease and desist notice along with the copy of postal receipt and tracking details dated 01.03.2023.

List of witnesses examined on the side of the defendant - **Nil**

List of exhibits marked on the side of the defendant - **Nil**

12.06.2024

(2/2)

Index : Yes / No

Speaking Order : Yes / No

Neutral Case Citation : Yes/No

Ksa-2



WEB COPY



C.S. (Comm. Div.) No.170 of 2023

P.VELMURUGAN. J.

Ksa-2

C.S. (Comm. Div.) No.170 of 2023

12.06.2024