



**O.A.Nos.720 and 721 of 2023
in
C.S.(Comm. Div.)No.205 of 2023**

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ABDUL QUDDHOSE.J.,

This suit has been filed for infringement and passing off. The plaintiff also sought for damages in the suit.

2. The plaintiff claims to be the proprietor of the registered trademark VGN. They are into the real estate and construction business. They claim that their mark VGN is in use ever since 1942. They claim that they have obtained trademark registration under various classes for the trademark VGN from 2009 onwards. They have also disclosed in the plaint the advertisement costs incurred by them for promoting their projects under the trademark VGN. They have also disclosed their sales turnover from the year 2009 - 10 to 2021. According to them, due to the long and continuous usage of the trademark VGN, the trademark VGN has acquired a distinctive identity of its own and the general public associate VGN only with the plaintiff and no one else.



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plaintiff's claim. Thereafter, the present suit has been filed by the plaintiff.

Pending the suit, the instant interlocutory applications have been filed seeking for interim injunction to restrain the respondents / defendants from infringing the plaintiff's registered trademark VGN and also from passing off.

5. A counter affidavit has been filed by the respondents / defendants denying the contentions of the applicant / plaintiff. In the counter affidavit, they claim that they have been using the mark VGK since 2002. They also state that they have obtained device mark registration for VGK under class 36 in the year 2014. They have also stated that they had also applied for trademark registration under three applications under classes 37, 17 and 36 which are still pending. They have also stated that the plaintiff has filed opposition petitions, opposing the defendants' applications for trademark registrations and the plaintiff has also filed a rectification application seeking for rectification of the plaintiff's registered trademark in the year 2014 itself.



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6. According to the defendants, they have been continuously using the mark VGK ever since 2002 and even after the opposition petitions were filed by the plaintiff, opposing the defendants' trademark registration in the year 2014 and therefore, they have pleaded that on the ground of acquiescence, the plaintiff is not entitled for the interim injunction sought for in these applications. They have also taken the plea of limitation under the Companies Act, 2013. They have also stated that their Company was incorporated in the year 2012-13 itself and they have successfully completed various real estate projects using the name VGK and therefore, on that account, they have stated that the balance of convenience is only in their favour and therefore, no interim injunction can be granted as prayed for in these applications.

7. The defendants have also stated in the counter affidavit as to how they have coined the name VGK. They claim that the name VGK was coined from their predecessor in interest viz., V.G.Krishnan. They have also categorically pleaded in the counter affidavit that their mark VGK is not deceptively similar to that of the plaintiff's mark VGN and that they are honest users of the mark VGK.



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8. The learned senior counsel appearing for the plaintiff drew the attention of this Court to the various statements made by the plaintiff in the plaint. He would reiterate the contents of the plaint and would submit as follows:

- a) The plaintiff has been using the mark VGN ever since 1942;
- b) The plaintiff has obtained Trademark registrations under various classes for its trademark VGN from 2007 onwards;
- c) The plaintiff's turnover as seen from the plaint averments is huge;
- d) The plaintiff has incurred huge amount of expenditure towards advertisement cost for promoting their projects under the registered trademark VGN;
- e) The plaintiff has also achieved various awards due to its reputation;
- f) The turnover of the defendant when compared to the turnover of the plaintiff is phenomenally low;
- g) The defendants, adaptation and usage of a deceptively similar mark in respect of the identical service are likely to create misrepresentation in the minds of trade and common public;
- h) The defendants adaptation and use of deceptively similar mark



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VGK for an identical service would inevitably lead to confusion and deception amongst the public and members of trade;

i) It is incomprehensible for the defendants to state that they are unaware of the plaintiff's reputation in the market and therefore, they are not entitled to adapt a deceptively similar trademark to that of the plaintiff;

j) The defendants' adaption of the mark VGK is dishonest and by the dishonest adoption, the defendants would derive monetary benefits from the goodwill and reputation associated with the plaintiff's distinctive trademark VGN;

k) The defendants are seeking to acquire benefit by passing off of their services as that of the services of the plaintiff.

9. On the contrary, the learned counsel for the respondents / defendants would reiterate the contents of the counter affidavit filed by the respondents / defendants in these applications and would submit as follows:

a) There is no deceptive similarity between the plaintiff's trademark VGN and the defendants' mark VGK;

b) The defendants have been using the mark VGK ever since 2002 as seen from the supporting documents filed along with the counter affidavit;



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10. This Court has given a careful consideration to the pleadings in these applications and the submissions made by both the counsels and observes the following undisputed facts:

a) The defendants have obtained registration for their mark VGK under class 36 in the year 2014 itself. They have also applied for trademark registrations under various other classes as well and three applications are still pending on the file of the Trademark Registry;

b) The plaintiff has opposed the applications filed by the defendants seeking for trademark registration, as stated supra, by filing opposition petitions before the Trademark Registry in the year 2014 itself and the same are still pending on the file of the trademark Registry;

c) The plaintiff has also filed an application seeking for rectification of the registered trademark by filing a rectification application only recently in 2023, though the trademark registration was obtained by the plaintiff in the year 2014 itself.

11. The plaintiff has issued the cease and desist notice to the defendants only recently on 06.01.2023, though they were aware of the fact



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that the defendants were using the mark VGK in the year 2014 itself, though they may contend before this Court that there was no active usage of the mark VGK after the opposition petitions were filed by the plaintiff before the Trademark Registry in the year 2014. They would also contend that subsequent to the opposition petitions filed by the plaintiff in the year 2014, no advertisements were made by the defendants thereafter, till January, 2023 to promote the defendants' projects under the mark VGK.

12. The defendants have also categorically denied in their counter that their mark is deceptively similar to that of the plaintiff. They also claim that they have been using the mark VGK ever since 2002 onwards and they have also filed documents in the form of agreements of sale executed by them in favour of third parties who they claim are their customers and the said documents are from the year 2002 onwards. They have also taken the plea of acquiescence, as according to them, even though the plaintiff was aware that the defendants are using the mark VGK in the year 2014 itself. However, they have chosen to file the suit only now in the year 2023. They have also categorically pleaded that they are honest users of the mark VGK.



13. A party seeking for an interim injunction will have to satisfy the trinity test viz.,

- a) *Prima facie* case;
- b) Balance of convenience; and
- c) Irreparable hardship.

In the instant case, there are several disputed questions of fact involved which can be adjudicated only after trial.

14. The plaintiff has to satisfactorily explain as to why despite the fact that they had chosen to oppose the defendants' application seeking for registration of their mark VGK in the year 2014, they had not filed the suit immediately thereafter but had chosen to file the suit only recently in the year 2023. When the defendants have taken the plea of acquiescence in the counter affidavit as well as in the written statement, that too when it is an admitted fact that the plaintiff was aware of the defendants' mark VGK in the year 2014 itself, the question of granting injunction in the interlocutory stage will not arise as the contentions of the plaintiff that they have properly explained the reasons for not filing the suit immediately after opposition petitions were filed before the Trademark Registry in the year 2014 can be



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adjudicated only after the plaintiff lets in oral and documentary evidence and the defendants are also given the opportunity to cross examine the plaintiff's witness. When the delay in the filing of the suit is glaring at the face of this Court, *prima facie* case has not been made out by the plaintiff which is one of the test required to be satisfied for the grant of interim injunction.

15. The defendants have also pleaded that their Company was incorporated in the year 2012 and they have completed various projects using the name VGK. They have also claimed that they are honest users of the name VGK and they have also claimed that their mark VGK is not deceptively similar to that of the plaintiff's trademark VGN. Admittedly, the defendants' Company was incorporated in the year 2012 itself and they have also completed certain projects using the name VGK. Therefore, the balance of convenience is in favour of the defendants, as any interim injunction granted in these applications will lead to multiplicity of proceedings viz., in the form of claims made by third parties. Irreparable hardship will also be caused to the defendants if the interim injunction is granted in these applications in favour of the plaintiff.



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16. The above observations are made by this Court without going into the merits of the respective contentions. Since the plaintiff has not satisfied the trinity test viz.,

- a) *Prima facie* case;
- b) Balance of convenience; and
- c) Irreparable hardship,

this Court is not inclined to grant the interim injunction as prayed for in these applications.

17. Apart from the findings given by this Court, in these applications, that the plaintiff has not satisfied the trinity test viz.,

- a) *Prima facie* case;
- b) Balance of convenience; and
- c) Irreparable hardship,

this Court has also given due consideration to the fact that the suit being a commercial suit, strict time lines are fixed for the early adjudication of the suit itself. Therefore, this Court, considering the facts and circumstances of the case, is not inclined to entertain these interlocutory applications.



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18. For the foregoing reasons, these applications are dismissed. It is made clear that this Court has not given any finding with regard to the merits of the respective contentions. The views expressed by this Court in these orders are only *prima facie* observations and both the parties are at liberty to produce oral and documentary evidence to prove their respective contentions and any view expressed in this order will not have any impact the decision in the main suit.

27.02.2024

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