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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 26.02.2025

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

O.A.Nos.845 & 846 of 2024
in C.S(Comm.Div)No.221 of 2024

In both OAs.

1.B L Bengani

2.Indowud NFC Private Limited,
No.30, First Main Road East,
Shenoy Nagar, Chennai-600 030
Represented by its Director Mr.B.L.Bengani.

... Applicants/Plaintiffs

-VS-

1.M/s.Prabitha Polymers
Nagaramgere Village, Bangalore Road,
Challakere, Chitradurga - 577 522
Karnataka State. Rep. by its Partner Mr.S.Aditya.

2.S.S.Tirupati Enterprises Pvt. Ltd.,
264, Sydenhams Road,
Chennai - 600 112. Rep.by its Director M/s. Sanjay Kumar.

.. Respondents/Defendants



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Prayer in O.A.No.845 of 2024:Original Application filed under Order XIV, Rule 8 of O.S.Rules Read with Order XXXIX Rule 1 & 2 & Section 151 of C.P.C., 1908, praying for an ad interim injunction and temporary injunction restraining the Defendants, their proprietor/partners/directors/successors, servants, agents, representatives, stockist, dealers & distributors, wholesalers and retailers and anyone claim under or through the Defendants from infringing the Plaintiffs' Registered NFC Trade Marks such as NFC That Adds Life, Zerowud NFC, Indowud NFC under Regin.No.3896289, 4330546 and 5134276 all in Class 19 or any mark identical to or deceptively similar thereto pending disposal of the suit.

Prayer in O.A.No.846 of 2024:Original Application filed under Order XIV, Rule 8 of O.S.Rules Read with Order XXXIX Rule 1 & 2 & Section 151 of C.P.C., 1908, praying for an ad interim injunction and temporary injunction restraining the Defendants, their proprietor/partners/directors/successors, servants, agents, representatives, stockist, dealers & distributors, wholesalers and retailers and anyone claim under or through the Defendants



from passing off and/or enabling others to pass off their goods as and for the plaintiffs' goods by use of Plaintiffs' Trade Mark NFC products or any other confusingly similar mark pending disposal of the suit.

In both OAs.

For Applicants : Mr.P.R.Raman, Senior Counsel
for Mr.T.D.Selvan Babu

For Respondents: Ms.Shamilee Rajkumar
Mr.M.Adeeb Mohammed

COMMON ORDER

The short question that arises for consideration in these applications is whether the plaintiffs are entitled to interim relief in relation to the use of the element 'NFC' as part of the trade mark of the defendants. By asserting that the plaintiffs are the registered proprietors of trade marks such as 'NFC-THAT ADDS LIFE', 'ZEROWUD NFC' and 'INDOWUD NFC' in relation to products that qualify as Natural Fibre Composite, the suit was filed for relief in respect of alleged infringement and passing off.

2.The contentions of learned senior counsel, Mr.P.R.Raman, may be summarised as under:



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(i) The plaintiffs produced Natural Fibre Composite boards made of rice husk after considerable research. As the pioneer in introducing these products, the plaintiffs used the abbreviation 'NFC' as part of several trade marks, some of which are registered and others pending registration.

(ii) The defendants purchased raw materials from the plaintiffs to manufacture products. Thereafter, the defendants have piggybacked on the plaintiffs' reputation by unlawfully using the element 'NFC' in their trade mark.

(iii) The plaintiffs have expended about Rs.53.37 lakhs towards promotional and advertising expenses. The sales turnover of the plaintiffs for their products bearing trade marks that contain the element 'NFC' is about Rs.21.80 Crores in financial year 2022-2023.

(iv) The defendants applied for registration of the trade mark 'Natural Fibre Composite'. Therefore, it is not open to the defendants to contend that either Natural Fibre Composite or NFC is not distinctive.

(v) Apart from the plaintiffs, the defendants are the only persons to use 'NFC' as part of their trade mark. The other entities referred to by the defendants are proposing to use Natural Fibre Bio Composite (NFBC) or are



persons selling the products of the defendants.

WEB COPY 3. The contentions of Ms. Shamilee Rajkumar for respondents may be summarised as under:

(i) The trade mark of the defendants is 'WUDSY NFC' and not just 'NFC'.

(ii) Both the 1st plaintiff, Mr. B.L. Bengani and Ms. Priyanka, Head Marketing of the plaintiffs, have used the word 'NFC' as being descriptive of a product category and not as a trade mark. Pages 50, 52, 66, 74 & 75 of the typed set filed by the plaintiffs were referred to in support of this contention.

(iii) Abbreviations fall under two categories: distinctive and descriptive. Since the abbreviation 'NFC' stands for Natural Fibre Composite, it is clearly descriptive and not distinctive. By contradistinction, abbreviations such as TVS (standing for T.V. Sundaram Iyengar & Sons) and LG (standing for Lucky Goldstar) are derived from the names of founders and are distinctive. A descriptive trade mark is not entitled to protection unless it acquires secondary meaning. The plaintiffs have failed to produce evidence of secondary meaning.



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(iv) Sections 30(2) and 35 of the Trade Marks Act, 1999 (the TM Act) protect a person against an infringement action, if the mark used by such person is descriptive of the nature of goods or if the usage is descriptive.

(v) In support of these contentions, reliance was placed on the following judgments:

(a) *Bharat Biotech International Ltd. v. Optival Health Solutions Pvt. Ltd. and another*, CDJ 2020 DHC 781;

(b) *Marico Limited v. Agro Tech Foods Limited*, CDJ 2010 DHC 1488;

(c) *Superon Schweissttechnik India Limited v. Modi Hitech India Limited*, CDJ 2018 DHC 2017;

(d) *Nestle India Limited v. Mood Hospitality Private Limited*, CDJ 2010 DHC 571;

(e) *Larsen & Toubro Ltd. (L&T) v. Lachmi Narain Trades & others*, CDJ 2016 DHC 449;

(f) *VIT University, (Vellore Institute of Technology) v. Bagaria Education Trust, rep. by its Chairman and Managing Trutee K.R.Bagaria &*



others, CDJ 2015 MHC 3980;

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4. From the pleading of the plaintiffs, it appears that the plaintiffs have registered about four trade marks containing the element 'NFC'. The said trade marks are as under:

- (i) NFC-THAT ADDS LIFE (T.M.No.3896239);
- (ii) ZEROWUD - NFC (T.M.No.4330546);
- (iii) NFC-GLUE(T.M.No.5091696); and
- (iv) INDOWUD NFC (T.M.No.5134276).

The plaintiffs have also referred to several other marks which are unregistered. Therefore, the request for interim relief for infringement would be limited to the above mentioned four marks. It is noticeable that all four marks contain other elements and are composite marks.

5. Under the Trade and Merchandise Marks Act, 1958, applicants for registration were required to provide a disclaimer in respect of the descriptive element of the mark. The TM Act addresses the issue differently. In sub-section (1) of Section 17, it is stipulated that the registration of a



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mark consisting of several matters (composite mark) confers on the proprietor exclusive rights over the trade mark taken as a whole. Sub-section (2) thereof provides that the registered proprietor of a composite mark is not conferred any exclusive right in matters forming only a part of the composite trade mark. In the case on hand, as noticed above, all four registered trade marks contain other elements. The admitted position is that 'NFC' is an abbreviation of Natural Fibre Composite. Therefore, it is undoubtedly an abbreviation of descriptive words. There is little reason to construe 'NFC' as the prominent or dominant feature of these composite marks. As contended by learned counsel for the defendants, abbreviations may be capable of being registered as trade marks provided they satisfy the requirements of distinctiveness. Even in the context of non descriptive abbreviations, evidence of substantial use may be necessary to satisfy requirements of distinctiveness. In the case of an abbreviation of descriptive words, the onus is clearly much heavier. Put differently, unless the person claiming distinctiveness is able to show evidence that the abbreviation has acquired a secondary meaning, such person cannot succeed.



WEB COPY 6. The record shows that the applications for registration of trade marks containing the element 'NFC' were filed on “proposed to be used” basis. The plaintiffs assert that an application for modification was lodged in the Trade Mark Registry recently. The plaintiffs have placed on record a set of invoices. The earliest of these invoices was issued on 07.05.2018. This invoice relates to the sale of 'NFC' Boards. It appears that the goods were described descriptively and not by the trade mark in the invoice. The subsequent invoices follow the same pattern. In these circumstances, it certainly cannot be said that the element 'NFC', in the plaintiff's trade marks, has acquired secondary meaning as on date.

7. As regards passing off, the plaintiffs can only succeed upon establishing the classical trinity, including misrepresentation. In order to establish misrepresentation, it is necessary for the plaintiffs to show that the defendants have endeavoured to pass off their products as those of the plaintiffs. On examining the defendants' trade mark, it appears that the



defendants have used the element 'WUDSY' as a prominent feature of the trade mark. Therefore, it cannot be concluded at this stage that the defendants are passing off their products as those of the plaintiffs.

8. For reasons set out above, both these applications are dismissed without any order as to costs. For the avoidance of doubt, it is made clear that the observations in this order are tentative and only intended for disposal of these applications.

26.02.2025

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Index : Yes / No

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SENTHILKUMAR RAMAMOORTHY,J

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