

M/S.Mrf Limited vs Powermax Rubber Factory on 1 April, 2024

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Bench: Abdul Quddhose

C.S.No.75

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 18.03.2024

Pronounced on : 01.04.2024

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

C.S.No.75 of 2021

M/s.MRF Limited,
Having Regd. Office at
No.114, Greams Road,
Chennai 600 006, Rep. by its
Senior Manager - Sales Planning,
Mr.George Samuel

... Plaintiff

vs.

1.POWERMAX Rubber Factory,
No.38/10, Thandavarayan Street,
Royapettah, Chennai - 600 014.

2.POWERMAX Tyre,
No.38/10, Thandavarayan Street,
Royapettah, Chennai - 600 014.

... Defendant

PRAYER: Plaint under Order IV Rule 1 Original Side Rules, Sections 28, 29, 134 and 135 of the Trade Marks Act, 1999 and Sections 51, 52 and 62 of the Copyright Act, 1957 and Section 7 of the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, No.4 of 2016 for the following reliefs:

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

C.S.

a. A perpetual injunction restraining the Defendants, its distributors, stockists, servants, agents, retailers, representatives or any other

claiming under/through them, from in any manner infringing the Plaintiff's Registered Trade Marks 'Muscleman Device', MRF CHEETAH, MRF SAHARA, MRF SAFARI, PAHALWAN by the Defendant's by using the Impugned Muscleman logo and the trademarks CHEETAH, SAHARA, SAFARI or any other mark identical with and/ or deceptively similar to the plaintiff's Trademarks/Artistic Works and Muscleman Device, PAHALWAN, MRF CHEETAH, SAHARA, SAFARI in connection with the defendant's goods/services and/or business or in other manner whatsoever;

b. A perpetual injunction restraining the Defendants, their distributors, stockists, servants, agents, retailers, representatives or any other person claiming under/through them from in any manner using the trademarks 'SAHARA', 'CHEETAH', 'SAFARI' and Impugned Muscleman Device, and/or any other mark which is identical with or deceptively similar to the Plaintiff's registered Trademarks/Artistic Works Muscleman Device, PAHALWAN, MRF CHEETAH, MRF SAHARA, SAFARI so as to pass off the Defendant's goods or services or business or website as that of the Plaintiff and/or wrongfully associate themselves with the Plaintiff's business or in any other manner whatsoever,

c. A perpetual injunction restraining the Defendants, his distributors, stockists, servants, agents, retailers, representatives or any other person claiming under/through him from in any manner infringing the Plaintiff's

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

Copyright in the 'MUSCLEMAN DEVICE' filed as Plaintiff Document No.1 by using the infringing mark/logo as shown in Plaintiff Document No. 6 or any other mark/ device/ artistic work which is identical with/ deceptively similar or any substantial reproduction of the MUSCLEMAN DEVICE' on or in connection with the business of the Defendants, or in any manner whatsoever.

d. The Defendants be ordered to remove all painted displays, and other display material being used by the Defendants containing Plaintiff's Trademarks/Artistic Works, 'MUSCLEMAN Device or any other mark which is deceptively similar and/or is a substantial reproduction of the Plaintiff's Trademarks/Artistic Works and surrender to Plaintiff the glow sign board, all goods, labels, catalogues, dyes, blocks, moulds, screen prints, packing materials, vouchers, literature, publicity material, letterheads, invoices, cheques, visiting cards, job cards, delivery notes, rate list, sign boards, blow ups and all reprographic materials and other materials bearing the Plaintiff's trade marks or artistic works of the Plaintiff.

e. A preliminary decree be passed in favour of the Plaintiff directing the Defendants to render account of profits made by use of trademarks

'SAHARA', 'CHEETAH', 'SAFARI', PAHALWAN and/or Impugned MUSCLEMAN DEVICE', and a final decree be passed in favour of the Plaintiff for the amount of profits thus found to have been made by Defendants after the latter have rendered accounts;

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

C.S.

- f. The Defendants be ordered and decreed to pay to the Plaintiffs a of Rs. 25,01,000/- as special damages for acts of Passing Off and infringement of Trade Mark & infringement of copyright committed by the Defendants
- g. For costs of the suit.

For Plaintiff : Mr.Madhan Babu

For Defendants : Mr.G.N.Shukumar

JUDGMENT

The suit has been filed for infringement, passing off and for damages in respect of the registered trademarks "Muscleman Device", MRF CHEETAH, MRF SAHARA and MRF SAFARI and PAHALWAN. In so far as MRF CHEETAH, MRF SAHARA and MRF SAFARI which were earlier used by the defendants are concerned, there is no necessity for this Court to adjudicate on the said infringement since it is an admitted fact that the defendants have stopped using the trademark CHEETAH, SAHARA and SAFARI on receipt of the cease and desist notice and before filing of the suit.

2. This Court will now have to decide only with regard to the alleged infringement of the Muscleman Device and the trademark <https://www.mhc.tn.gov.in/judis> PAHALWAN by the defendants. This Court will also have to decide as to whether the plaintiff is entitled for damages as prayed for in the suit. The plaintiff claims that they have been using the trademark PAHALWAN and have been using the logo "Muscleman Device" for a long number of years. They claim that by the long and continuous usage, they have obtained reputation and goodwill on their own in the tyre segment market. According to them, the trademark MRF PAHALWAN and logo Muscleman Device is exclusively associated only with them. They claim that their trademarks which the defendants were earlier illegally using viz., CHEETAH, SAHARA and SAFARI are also associated only with the plaintiff and no one else.

3. According to the plaintiff, prior to the filing of the suit, they came to know that the defendants, apart from using the plaintiff's registered trademarks CHEETAH, SAHARA and SAFARI, which they have stopped using now, was also adopting illegally the device of body builder which is deceptively

similar to the plaintiff's logo and the said usage by the defendants is not bonafide and is dishonest. The plaintiff having obtained trademark registrations for their trademarks and they having been put to use by the plaintiff for a long number of years right <https://www.mhc.tn.gov.in/judis> from 1961 onwards, claim that the defendants' adoption of the impugned device of the body builder is not bonafide and is dishonest and is an act of violation / infringement of the plaintiff's trademark / device since the defendants have stopped using the trademarks CHEETAH, SAHARA and SAFARI. The plaintiff continues to prosecute the suit for act of passing off committed by the defendants for adoption of a deceptively similar logo / device of body builder, which according to the plaintiff, is not bonafide and is dishonest. The plaintiff claims that there has been an unexplained disproportionate jump in the turnover of the defendants after they started using the body builder device which is deceptively similar to the plaintiff's device for the manufacture and sale of their tyres. According to the plaintiff, the arrow found in the defendants' body builder logo has also been copied and is not the original idea of the defendants. The plaintiff has also disclosed its sales turnover in the plaint for the past several years prior to the filing of the suit and they claim that they have a huge sales turnover. They also claim that they have incurred huge amount of money towards advertisement cost for advertising their products under the registered trademark and device and any infringement / passing off committed by any of the offenders like that of the defendants will cause huge loss to them. Under the aforementioned <https://www.mhc.tn.gov.in/judis> circumstances, the suit has been filed by the plaintiff.

4. On the other hand, the defendants contend as follows:

- a) There can be no copyright in an idea and copyright violation is confined to the form, manner and alignment and expression of idea by the author of the copyrighted work;
- b) In case of tyre products, strength of tyre is more important.

Therefore, every tyre manufacturer while advertising, will indicate the strength of tyre by expressing in their logo / device. According to the defendants, only to show the strength of their tyres, they have created their body builder logo. According to the defendants, there is no deceptive similarity between the plaintiff's device mark and that of the defendants.

5. According to the defendants, their artist has created the POWERMAX logo but without the picture of tyre by drawing half size body builder with robo head. They would categorically contend that the POWERMAX logo is not deceptively similar to that of the plaintiff's device mark / logo.

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

6. According to the defendants, it is always open to any person to chose an idea as a subject matter and develop it in their own manner and give an expression to the said idea by drawing it differently from others. According to them, similarities are bound to occur because a central idea for both the plaintiff and the defendants are one and the same but such similarities by themselves cannot lead to an irresistible inference of piracy.

7. Since the defendants have not reproduced the artistic work of the plaintiff, as seen from the plaintiff's Muscleman Device, they have not committed any infringement / passing off. They also categorically contend that there is no infringement of copyright as well. The defendants also state that, the plaintiff's trademarks CHEETAH, SAHARA and SAFARI which were earlier used by the defendants have now been stopped on receipt of the cease and desist notice and before filing of the suit by the plaintiff. The defendants contend that they were not aware that the plaintiff was the registered proprietor of the trademarks CHEETAH, SAHARA and SAFARI and were the prior user and therefore, there was no deliberate attempt on their part with dishonest intention to use the mark CHEETAH, SAHARA and SAFARI. <https://www.mhc.tn.gov.in/judis>

8. Immediately after receipt of the legal notice from the plaintiff's counsel, prior to the filing of the suit, the defendants claim that they had stopped using the trademarks CHEETAH, SAHARA and SAFARI. Therefore, the question of claiming damages from the defendants, as claimed in the plaint, does not arise.

9. Based on the pleadings of both the parties, the following issues were framed by this Court on 30.09.2021:

"i) Whether the defendant's copy in the Artistic work "a Half size Body Builder with Robo head" is the dishonest adoption of the plaintiff's artistic work?

ii) Whether the label/mark/logo of the defendant "a Half size Body Builder with Robo head" is identical with/deceptively similar to the plaintiff's artistic work "a man holding tyre with lifted hands"?

iii) Whether the use of the label/mark/logo as adopted by the defendant in respect of its goods/service amounts to infringement of the registered trademark of the plaintiff?

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iv) Whether the use of the label/mark/logo as adopted by the defendant in respect of its goods/service amounts to infringement of the copyright of the plaintiff?

v) Whether the use of the label/mark/logo as adopted by the defendant in respect of its goods/service amounts to passing off goods?

vi) Whether the defendant is the proprietor of the label/mark/logo registered as trademark No. 1458006 as assignee and if so, whether the defendant is entitled to claim any right over the same as on date?

vii) Whether the defendant is entitled to use the label/mark/logo by virtue of the alleged assignment of trademark No. 1458006?"

10. Before the learned Additional Master II, the plaintiff's Senior Manager - Sales and Planning, Mr.George Samuel was examined as a witness (PW1) on the side of the plaintiff. The plaintiff's witness George <https://www.mhc.tn.gov.in/judis> Samuel (PW1) has also filed a proof affidavit, reiterating the contents of the plaint and also the subsequent developments, with regard to the trademarks CHEETAH, SAHARA and SAFARI. Through PW1, the following documents were marked as exhibits:

"Ex.P1 is the original authorization letter dated 16.1.2021.

Ex.P2 is the colour print out copy of plaintiffs Muscleman Device.

Ex.P3 is the photocopy of Copies of the Certificate of Legal Use and Registration of the Trade Marks together with the certificates of renewal of the marks of plaintiff (Original seen verified and returned.) Ex.P4 is the photocopies of the certificates of Legal Use and Registration of the Trade Marks together with the certificates of renewal of the marks of plaintiff. (Original seen verified and returned.) Ex.P5 is the original Chartered accountant's certificate showing the sales turnover and expenditure on advertisement for the past few years <https://www.mhc.tn.gov.in/judis> in respect of business of the plaintiff under the plaintiff's trademarks dated 08.09.2020. Ex.P6 is the colour print out copy of Plaintiffs Logo used in connection of MRF Institute of Driver Development.

Ex.P7 is the colour print out copy Defendant's infringing trademark and logo.

Ex.P8 is the colour print out copy of a Screen shot of the defendant's website <http://www.powermaxtyre.com/homepage>. Ex.P9 is the colour print out copy of Defendant's catalogue on its website.

Ex.P10 is the photocopy of Legal notice issued by the plaintiff dated 09.07.2020
Ex.P11 is the photocopy of Reply notice issued by the defendant dated 18.07.2020.

Ex.P12 is the photocopy of legal notice issued by the plaintiff dated 04.08.2020.

<https://www.mhc.tn.gov.in/judis> Ex.P13 is the original of Power of Attorney dated 22.12.2020."

The plaintiff's witness (PW1) was also cross examined by the defendants' counsel.

11. On the side of the defendants, Mr.Rajesh Jain, partner of the first and second defendants was examined as a witness (DW1). He has also filed a proof affidavit, reiterating the contents of the written statement. Through DW1, the following documents were marked as exhibits on the side of the defendants:

"Ex.D1 is the copy of the registered Trade Mark No.1458006 in class 12 for the mark Power max (marked with objection on the ground that the same cannot relied upon in legal proceedings as mentioned in the certificate itself) Ex.D2 is the copy of the partnership deed of the 2nd defendant dated 01.04.2010 (Objected on the ground that no witness has signed) <https://www.mhc.tn.gov.in/judis> Ex.D3 is the copy of the: VAT Registration Certificate in favour of 2nd defendant dated 21.12.2010. (original verified and returned) Ex.D4 is the copy of the Assignment Deed dated 02.04.2012 (original verified and returned) (Objected on the ground that no witness has signed) Ex.D5 is the copy of the partnership deed dated 29.06.2015(Original seen verified and returned) (Objected on the ground that no witness has signed) Ex.D6 is the copy of the Assignment Deed dated 30.05.2016 (Original seen verified and returned) Ex.D7 is the print out copy of the Renewal Certificate dated 18.03.2017 (Affidavit under Section 65B Indian Evidence Act filed). Ex.D8 is the print out copy of the GST Registration Certificate in favour of 1st defendant dated 20.09.2017 (Affidavit under Section 65B Indian Evidence Act filed).

<https://www.mhc.tn.gov.in/judis> Ex.D9 is the print out copy of the GST Registration Certificate in favour of 2nd defendant dated 20.09.2017 (Affidavit under Section 65B Indian Evidence Act filed).

Ex.D10 is the download copy of the Trademark application No.4278170 dated 29.08.2019 (Affidavit under Section 65B Indian Evidence Act filed).

Ex.D11 is the downloaded copy of Search Certificate issued under rule 22(1) Trademarks rules dated 23.10.2020 (Affidavit under Section 65 B Indian Evidence Act filed).

Ex.D12 is the copy of the Sales Turnover Certificate of the 1st defendant dated 05.03.2021 (Original seen verified and returned) Ex.D13 is the copy of the Sales Turnover Certificate of the 2nd defendant dated 05.03.2021 (Original seen verified and returned) <https://www.mhc.tn.gov.in/judis> Ex.D14 is the print out copy of the plaintiffs Logo (Affidavit under Section 65B Indian Evidence Act filed).

Ex.D15 is the print out copy of the defendant's previous Logo (Affidavit under Section 65B Indian Evidence Act filed).

Ex.D16 is the print out copy of the defendant's present Logo (Affidavit under Section 65B Indian Evidence Act filed).

Ex.D17 is the print out copy of Comparative picture of plaintiff's Logo and defendant's logo (Affidavit under Section 65B Indian Evidence Act filed).

Ex.D18 is the original of the present product catalogue of the defendants.

Ex.D19 is the print out copy of present defendant's website page containing product list (Affidavit under Section 65B Indian Evidence Act filed).

<https://www.mhc.tn.gov.in/judis> Ex.D20 is the Digital copy of Copyright Registration Certificate dated 22.10.2021 (Affidavit under Section 65B Indian Evidence Act filed)." The defendants witness was also cross examined by the plaintiff's counsel.

12. Heard, Mr.Madhan Babu, learned counsel for the plaintiff and Mr.G.N.Shukumar, learned counsel for the defendants.

13. Learned counsel for the plaintiff would submit as follows:

a) Eventhough the defendants have stopped using the trademarks CHEETAH, SAHARA and SAFARI after issuance of the cease and desist notice by the plaintiff, prior to the filing of the suit, they have not offered any proper explanation for having adopted the infringed trademarks CHEETAH, SAHARA and SAFARI;

b) The plaintiff is the registered proprietor of the trademarks CHEETAH, SAHARA and SAFARI since 1982, 1982 and 1985 respectively, which is prior to even the incorporation of the defendant's predecessor in 2003. Admittedly, the trademarks CHEETAH, SAHARA <https://www.mhc.tn.gov.in/judis> and SAFARI which were earlier used by the defendants is identical to the registered trademarks of the plaintiff and were used in respect of identical goods viz., tyres.

14. The adoption of the plaintiff's trademarks by the defendants in respect of identical goods is ex-facie dishonest since the plaintiff obtained registration of their trademarks in the early 1980s itself and a search of the trademark register would have certainly revealed their existence. It can therefore be inferred that there has been a deliberate dishonesty on the part of the defendants to use the plaintiff's registered trademarks and therefore, the plaintiff is entitled to claim damages for the said illegal usage.

15. The defendants have also not satisfied the claim protection as they have not satisfied the requirement for claiming such protection under Sections 135 (3) (b) and 135 (3) (c) of the Trade Marks Act, 1999 since their adoption of the plaintiff's trademarks is dishonest.

16. The answers given by the defendant's witness (DW1) to <https://www.mhc.tn.gov.in/judis> question Nos.32, 34 and 35, during the course of his cross examination, will reveal that the defendant was well aware of the plaintiff's trademarks and its reputation since 2003 when the defendant's predecessor was incorporated.

17. The use of the body builder device by the defendants in respect of its tyre business will certainly amount to the infringement of the plaintiff's registered trademark, infringement of the Copyright in the artistic work contained therein as well as the tort of passing off for the following reasons:

a) The Musclemán Device mark has been used by the plaintiff since 1961 and registered under No.418892 as early as on 09.03.1984 and the said registration is valid and subsisting till date as seen from Ex.P3;

b) The trademarks PAHALWAN has also been used by the plaintiff in respect of its tyres for the last several decades and has been <https://www.mhc.tn.gov.in/judis> registered under No.542604 as early as on 28.12.1990 much prior to even the incorporation of the defendants' predecessor Company in 2003;

c) The said PAHALWAN mark of the plaintiff is also a visual depiction of the plaintiff's trademark Musclemán Device for the purposes of Section 29(9) of the Trade Marks Act, 1999;

d) The body builder device mark used by the defendants is identical / deceptively similar to the plaintiff's Musclemán Device mark ;

e) The use of Musclemán Device or variation thereof by any person will amount to infringement as well as would amount to committing the act of tort of passing off.

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18. The plaintiff's Musclemán (Device) has been put to use by the plaintiff since 1961. The plaintiff has also obtained registration for its Musclemán Device in the year 1989 and is being used till date. The defendants have also admitted that they have put to use the torso of the muscular man holding his hands which is deceptively similar to the plaintiff's Musclemán Device only from the year 2003 as seen from their written statement. From the statement made in the written statement, it is evident that the plaintiff is the prior user and undisputed owner of the logo / device of the Musclemán Device.

19. The logo containing a torso of a muscular man holding his hands up is an essential feature of both the plaintiff and the defendant. Since the defendants have copied the essential feature for its logo viz., the torso of a muscular man holding his hands up, the plaintiff is entitled for the injunction reliefs sought for in the plaint.

20. It is settled position of law, where distinctive elements of registered trademark consist of or included words, the trademark may be infringed by the spoken use of those words as well as by the visual representation attracting- Section 29 (9) of the Trade Marks Act, 1999. <https://www.mhc.tn.gov.in/judis> The word 'PAHALWAN' and the Musclemán logo of the Plaintiff are registered depicting the strength, while the defendants by the use of its Musclemán logo which is similar / identical to that of the plaintiff's device infringes the plaintiff's device / logo/ marks (artistic works). Mere addition of arrow, does not render distinctive features to that of defendants marks.

21. The plaintiff has also popularized its Corporate Trademarks / Artistic Works through advertisements carried out in all types of media, including Television, Radio, Newspapers, Magazines and also through hoardings, participation in trade fairs, motor sports events, by endorsement of their products by various public personalities. The goodwill and reputation enjoyed by the plaintiff's products is evident from the commercial success and the sales turnover.

22. The defendants have failed to defend the suit with clean hands. It is surprising as to how the defendants who came to the tyre manufacturing market in the year 2003 itself, can feign ignorance of the plaintiff's trademarks CHEETAH, SAHARA and SAFARI. They have used the plaintiff's trademarks and device marks with the dishonest <https://www.mhc.tn.gov.in/judis> intention of riding over the reputation and goodwill of the plaintiff and make unlawful gains. The defendants are training every nerve to sustain the dishonest adoption and to continue using the deceptively similar device as that of the plaintiff and the same has to be necessarily curtailed by this Court. The test for deciding as to whether one mark is deceptively similar to another mark, is only a likelihood of confusion and not the actual confusion. The disputed mark / device is an artistic work created by the plaintiff whereas, the impugned body builder device / logo of the defendant is a colour imitation of the plaintiff's device in as much as essential feature of the plaintiff's device has been copied / adopted by the defendants viz., body builder in the particular form of having raised arms on either sides.

23. The defendants are entitled to revisit the use of deceptive similarity between the subjected devices, on the ground of issue estoppel. The defendants have admittedly abandoned its earlier device of <https://www.mhc.tn.gov.in/judis> since 2017. The defendants' impugned device of has been held by this Court while granting an interim injunction in favour of the plaintiff to be deceptively similar to that of the plaintiff's registered device and the said interim order has not been challenged by the defendants and has attained finality.

24. The tests while deciding the deceptive nature of the marks as consistently laid down by the decisions of the Honourable Supreme Court is "likelihood of deception" and "not actual deception" and the approach has to be from the perspective of average illiterate person with imperfect recollection. In the present, Court has applied the said test while deciding <https://www.mhc.tn.gov.in/judis> the interlocutory applications and has already come to the conclusion that the marks are likely to raise confusion and the same has attained finality. No new evidence has been let in by the defendants to disprove the same or revisit the said conclusion.

25. In support of his contentions, the learned counsel for the plaintiff drew the attention of this Court to the following authorities:

a) Kaviraj Pandit Durga Dutt Sharma V. Navaratna Pharmaceutical Laboratories reported in AIR 1965 SC 980;

b) Satyam Infoway Ltd. V. Sifynet Solutions (P) Ltd. reported in (2004) 6 SCC 145;

c) The British India Corpn. Ltd., V. Kharaiti Ram reported in AIR 2000 Delhi 289;

- d) Ayushakthi Ayurveda V. Hindustan Lever reported in [2003] (4) Mh. L.J 915;
- e) Cadila Health Care Ltd., V. Cadila Pharmaceuticals Ltd. reported in (2001) 5 SCC 73;
<https://www.mhc.tn.gov.in/judis>
- f) Parle Products (P) Ltd. V. J.P. And Co., Mysore reported in (1972) 1 SCC 618;
- g) S.Sudhakar and Shri Lakshmi Agro Foods Pvt.
Ltd V. S.S.P. Durairaj (Firm) and Durairaj reported in (2008) 36 PTC 150;
- h) Corn Products Refining Co. V. Shangrila Food Products reported in AIR 1960 SC 142;
- i) Apex Laboratories Limited v. India Pharmaceuticals reported in AIR 2017 Mad 126;
- j) Vst Industries Limited V. Rudra Ventures Private Limited reported in 2022 SCC Online Del 41;
- k) N.R. Dongree v. Whirlpool Corporation reported in (1996) 5 SCC 714;
- l) Kirit Kumar Girdharlal Doshi V. Wimco Limited reported in (1998) 18 PTC 459;
- m) Chimanlal Narsaji Suhan v. Parasmal Mithalal Parmar reported in (1997) 17 PTC 388;
- n) Colgate Palmolive Company V. Anchor Health <https://www.mhc.tn.gov.in/judis> And Beauty Care Pvt. Ltd reported in 2003 (27) PTC 478;
- o) Bade Miya V. Mubin Ahmed Zahurislam reported in (2011) 3 Mah LJ 813;
- p) Midas Hygenic Industries V. Sudhir Bhatia reported in 2004 (3) SCC 90;
- q) ITC Limited v. Golden Tobacco Limited reported in 2018 SCC Online Mad 2437;
- r) Thangam and another V. Navamani Ammal in
- s) Onkar Nath V. The Delhi Administration reported in (1977) 2 SCC 611;
- t) R.Gopalakrishnan V. Venkateswsara Camphot Works reported in 2000 (4) CTC 222;
- u) Baker V. The Master Printers Union of New Jersey reported in 34 F. Supp. 808 (D.N.J.1940);
- v) Boston Athletics Association V. Sullivan reported in U.S.P.Q. 2D 1690;

w) Hamdard National Foundation V. Hussian <https://www.mhc.tn.gov.in/judis> Dalal reported in 2013 (55) PTC 216;

x) R.G. Anand V. M/s. Delux Flims and others reported in 1978 (4) SCC 118;

y) Arjun Singh V. Mohindra Kumar & others reported in AIR 1964 SC 993;

z) Devidayal Rolling Mills V. Prakash Chimanlal reported in 1993 (2) SCC 470;

aa) Hope Plantations V. Taluk Land Board, Peermade reported in 1999 (5) SC 590.

26. Per contra, learned counsel for the defendants would submit as follows:

a) It is settled principle of law that, there can be no copyright in an idea, subject matter, themes, plots or historical or legendary facts and violation of copyright in such cases is confined to the form, manner and alignments and expression of idea by the author of the copyrighted work;

b) Normally, in case of tyre products, strength of tyre is more important. Therefore, every tyre manufacturer to promote their business will indicate the strength of their tyre in their advertisement. Hence, body <https://www.mhc.tn.gov.in/judis> builder device adopted by the defendants to show the strength of their tyres and its idea which cannot be exclusively claimed by any party.

There are other manufacturers of tyres who are also using a similar body builder device and the plaintiff cannot claim that the body builder device used by the defendants would amount to committing the tort of passing off. Every manufacturer will express their idea of strength in their logo / device for marketing their branded tyre products;

c) Only based on the instructions given to their artist, to promote their idea, a logo was created by the defendants, which is now challenged by the plaintiff without any basis. The artist engaged by the defendants has created POWERMAX logo with the body builder device without the picture of the tyre by drawing a half sized body builder with a robo head which is not deceptively similar to that of the plaintiff's logo / device;

d) It is settled principle of law that, it is always open to any person to choose an idea or subject matter and develop it in their own manner and give expression to the said idea by treating it differently from others. That is the reason why, the two artists draw pictures or logos or devices on the basis of an idea of expressing the strength in their artistic works. Similarities are bound to occur because a central idea is one and the same but, such similarities by themselves cannot lead to influence of piracy. <https://www.mhc.tn.gov.in/judis> The idea of showing the strength of the tyre products in both the artistic works as seen from Ex.P2 and Ex.D16 may be one and the same. But the expression of the idea of drawing defendants' artistic work by the artist was developed in an entirely different manner. The plaintiff has not proved through their oral and documentary evidence that the

defendants have infringed their artistic work MRF logo Musclemann Device. Therefore, the judgments relied upon by the learned counsel for the plaintiff have no bearing to the facts and circumstances of the present case. The burden of proof, to establish that the defendants' artistic works are infringing the plaintiff's artistic work, is on the plaintiff. The plaintiff has through their oral and documentary evidence has miserably failed to prove that the defendants' logo is deceptively similar to that of the plaintiff's logo Musclemann Device;

e) The defendants had inadvertently used the plaintiff's trademark CHEETAH, SAHARA and SAFARI without the knowledge that, the <https://www.mhc.tn.gov.in/judis> plaintiff has already obtained trademark registrations for the said marks. The same has also been recorded in the interim order granted by this Court in favour of the plaintiff in this suit. Therefore, the question of the alleged passing off in respect of the trademarks CHEETAH, SAHARA and SAFARI by the defendants does not arise and therefore, the question of payment of damages as claimed in the plaint also does not arise.

27. Learned counsel for the defendants, in support of his contentions, drew the attention of this Court to the following authorities:

- a) R G Anand Vs. M/s.Delux Films and Others reported in AIR 1978 SC 1613;
- b) Bharat Petroleum Corporation Ltd. and Another Vs. N.R. Vairamani and Another reported in AIR 2004 SC 4778;
- c) Century Traders Vs. Roshan Lal Duggar and Co. and Others reported in AIR 1978 DELHI 250.

Discussion:

28. The suit has been filed for infringement and passing off in respect of the trademarks Musclemann Device, MRF CHEETAH, MRF <https://www.mhc.tn.gov.in/judis> SAHARA and MRF SAFARI and PAHALWAN. The suit has also been filed for infringement of the plaintiff's copyright by the defendants over the plaintiff's Musclemann Device. The plaintiff has also claimed damages from the defendants amounting to Rs.25,01,000/-.

29. The following are the undisputed facts:

- a) Both the plaintiff and the defendants are tyre manufacturers;
- b) The defendants commenced tyre manufacturing business, even according to them, only in the year 2003, whereas the plaintiff is admittedly in the tyre manufacturing business since 1961 by using their mark MRF and ancillary marks;
- c) The plaintiff's sales turnover for the tyres sold by them under the aforesaid marks are huge. The defendants' sales turnover when compared to the plaintiff's sales

turnover is too low and is matchless beyond comparison;

d) The defendants were earlier using the plaintiff's registered trademarks MRF CHEETAH, MRF SAHARA and MRF SAFARI, which they have stopped using, after the plaintiff issued a cease and desist notice to them prior to the filing of the suit;

e) The plaintiff is also having the benefit of interim injunction <https://www.mhc.tn.gov.in/judis> granted by this Court in O.A.Nos.116 to 118 of 2021 by this Court's order dated 12.03.2021 restraining the defendants from using a deceptively similar trademark to that of the plaintiff's trademarks / artistic work and Musclemans Device, PAHALWAN, MRF CHEETAH, SAHARA and SAFARI. Even though interim injunction is working against the defendants in so far as the body builder logo alleged to have been created by the defendants is concerned, which is the subject matter of consideration in this suit, the defendants are still convinced with their contention that they are entitled to use their body builder logo as they claim that it is not deceptively similar to the Musclemans Device of the plaintiff.

30. Before analysing the dispute, this Court sets out below the plaintiff's device mark for its Musclemans Device and alleged body builder device (logo) of the defendants -

Plaintiff's Musclemans Device <https://www.mhc.tn.gov.in/judis> Defendants' body builder device (logo)

31. The plaintiff claims that the body builder logo used by the defendants is identical / deceptively similar to the plaintiff's registered Musclemans Device mark. According to them, by the use of the logo of the torso of muscular man holding up his hand, the defendants have copied the plaintiff's registered device mark as the plaintiff's mark also contains the torso of a muscular man holding his hands up. However, the defendants dispute the said contention of the plaintiff by stating that, there cannot be copyright over an idea and being a tyre manufacturer in order to show the strength of the tyre, any tyre manufacturer will have a similar logo.

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

32. The defendants also contend that there are also other tyre manufacturers who are either using an identical logo or similar ones. Therefore, they contend that there is no deceptive similarity between the plaintiff's Musclemans Device and the defendants' body builder logo. Admittedly, the plaintiff has been using the mark MRF ever since 1961. The muscular man logo has also been used by the plaintiff for its tyre manufacturing business for a long number of years. They have also obtained registration for the Musclemans Device under registration No.418892 as early as on 09.03.1984 which is evidenced by the trademarks registration certificate (Ex.P3). The trademark PAHALWAN has also been used by the plaintiff in respect of its tyres for the last several decades and has been registered under No.542604 as early as on 28.12.1990 as evident from the trademark registration certificate (Ex.P3).

33. Section 29 (9) of the Trade Marks Act, 1999 makes it clear that where the distinct element of a registered trade mark consist of trademark or include the words, the trademark may be infringed by the spoken words of those words as well as by their visual representation. The mark PAHALWAN is also a visual depiction of the plaintiff's trademark. The Musclemen Device of the plaintiff comprises of the torso of a muscular <https://www.mhc.tn.gov.in/judis> man holding his hands up and holding on to a large tyre. The plaintiff's logo is a distinct logo that has been exclusively associated with the plaintiff's tyres. The sales turnover of the plaintiff for the past several years, which have been marked as exhibits also reveals that the plaintiff's goods under the respective trademarks resonate immense goodwill and reputation among their consumers. The Musclemen logo has also been registered by the plaintiff under the Trade Marks Act as early as on 28.12.1990. By their long and continuous usage of their Musclemen Device, their sales turnover for the past several years reveal that the plaintiff has earned reputation and goodwill for its products and its respective trademarks, more particularly, their Musclemen Device mark. The distinct elements of the plaintiff's Musclemen Device as indicated supra are the torso of a muscular man holding his hands up. The word mark PAHALWAN and the Musclemen Device logo of the plaintiff are registered and is contended by the plaintiff that they depict the strength of their tyres which in the considered view of this Court is acceptable. The plaintiff is in the business of manufacturing of tyres since 1961, which is also not disputed by the defendants.

34. On the other hand, even according to the defendants, they <https://www.mhc.tn.gov.in/judis> started manufacturing tyres only in the year 2003. The defendants have also used the logo torso of a muscular man with robotic head holding his hands up. Apart from that in their logo they have an arrow. Admittedly, any consumer who is interested in buying tyres will be acquainted with the plaintiff's tyres sold under the trademark MRF as the plaintiff is in the business for a long number of years.

35. By the long and continuous usage of the Musclemen Device, the consumers will be more familiar with the logo of the plaintiff than with the logo of the defendants who are comparatively a recent entrant to the tyre manufacturing business. As seen from the sales turnover of the defendants when compared to the plaintiff's sales turnover, it is too low and is match-less beyond comparison.

36. Deceptive similarity has been defined under Section 2 (1) (h) of the Trade Marks Act, 1999 and is re-produced hereunder:

"2 (1) (h) "deceptively similar".—A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion;"

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

37. In Ramdev Food Products (P) Ltd. Vs. Arvindbhai Rambhai Patel and Others reported in 2006 (8) SCC 726 and Bade Miya Vs. Mubin Ahmed Zahurislam reported in (2011) 3 Mah LJ 813 relied upon by the learned counsel for the plaintiff it has been held as follows:

a) There can be only one mark, one source and one proprietor. A person cannot use the mark which would be deceptively similar to that of the registered trademark. Registration of trademark is envisaged to remove any confusion in the minds of the public;

b) The Court will have to consider various factors including the sales turnover pertaining to the plaintiff's business for the purpose of coming to the conclusion as to whether the defendants have committed an act of infringement / passing off or not.

38. In the case on hand, by long and continuous usage of the Musclemann Device mark which uses the torso of a muscular man holding his hands up, which is also used by the defendants admittedly only from 2003 onwards, this Court is of the considered view, after giving due consideration to the plaintiff's reputation and goodwill and its huge <https://www.mhc.tn.gov.in/judis> turnover in respect of its sales in India as well as in abroad that, the public will be deceived if the same Musclemann Device or its equivalent in any other form is allowed to be used by any other tyre manufacturer who has commenced their business much later than the year when the plaintiff commenced its business.

39. The principle of passing off is based on the well settled proposition that, "nobody has the right to represent his goods as the goods of somebody else".

40. To succeed in the suit for passing off, the plaintiff will have to prove the following:

a) Goodwill amongst its customers by the long and continuous usage of the trademark;

b) Misrepresentation by the defendant to make the customers believe that the products sold by them are associated with the plaintiff;

c) In case the plaintiff establishes the goodwill and misrepresentation, the plaintiff is also entitled for special damages.

41. It is also well settled, in a passing off action, what has to be <https://www.mhc.tn.gov.in/judis> established by the plaintiff is the likelihood of confusion in the minds of the public that the goods or services offered by the defendants are the goods or services of the plaintiff. In assessing the likelihood of such confusion, the Courts must follow the "imperfect recollection of a person of ordinary memory" theory. The above principles are fortified in the decisions relied upon by the learned counsel for the plaintiff in Kaviraj Pandit Durga Dutt Sharma vs. Navaratna Pharmaceutical Laboratories reported in AIR 1965 SC 980, Satyam Infoway Ltd. Vs. Sifynet Solutions (P) Ltd. reported in 2004 (6) SCC 145.

42. Admittedly, the plaintiff's Musclemann Device has been in use since 1961 and the plaintiff has also obtained registration for their Musclemann Device under the Trade Marks Act. They have also produced the registration certificates which have been marked as exhibits on their side. The same has also not been disputed by the defendants. Admittedly, plaintiff is the prior user of the

Muscleman Device which is the subject matter of comparison, to that of the defendants' body builder logo in this suit.

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

43. The decisions relied upon by the learned counsel for the plaintiff in Satyam Infoway Ltd. Vs. Siffynet Solutions (P) Ltd. reported in 2004 (6) SCC 145 and N.R. Dongree v. Whirlpool Corporation reported in (1996) 5 SCC 714 it is clear that when it is evident that if the plaintiff is the prior user and undisputed owner of the logo / device of the Muscleman Device and they have been in long and continuous usage and when the defendants' logo is deceptively similar, the plaintiff is entitled for the grant of injunction against the defendants. In the case on hand, the defendants have not disputed the fact that the plaintiff is using the Muscleman Device from the year 1961 and they have obtained registration under the Trade Marks Act for the said device in the year 1984. They have also admitted that their business commenced only in the year 2003. As observed earlier by the long and continuous usage, the plaintiff's logo which depicts a muscular man with two arms stretched has earned a reputation and goodwill on its own and the general public will naturally think that any similar logo containing the torso of the muscular man and two arms stretched is associated only with the plaintiff.

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

44. Being a prior user of the Muscleman Device and having obtained registration under the Trade Marks Act, the plaintiff is certainly entitled for protection from this Court as prayed for in the suit. Further, Section 29 (9) of the Trade Marks Act, 1999 also gives statutory protection for the plaintiff in cases where the distinctive elements of a registered trademark have been copied by the defendants in their visual representation of their logo. Certainly, the distinctive elements of the plaintiff's logo are the torso of the muscular man with two arms and the said distinctive elements have been copied by the defendants, which would amount to misrepresentation, thereby deceiving the public at large that the products sold by the defendants using the said logo are associated with the plaintiff. The plaintiff as seen from the evidence placed on record through the exhibits marked on their side, more particularly, Ex.P5 - Chartered Accountant's certificate showing the sales turnover and expenditure of advertisement for the past few years, the plaintiff has earned tremendous amount of goodwill amongst its customers and they have associated their trademarks MRF with their device marks which includes the Muscleman Device, only with the plaintiff.

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

45. On the other hand, the defendants' sales turnover, as seen from Exs.D12 to D13 is too low when compared to the plaintiff's sales turnover. But it is also noticed that there has been a sudden jump in the defendants' turnover from 2018 - 19 onwards as seen from Exs.D12 and D13. No explanation has been submitted by the defendants through their oral and documentary evidence as to how there has been a steep increase in their sales turnover from the year 2018-19 onwards. The plaintiff categorically contends that only due to the adoption of a deceptively similar logo as that of the plaintiff, the defendants' sales turnover has increased manifold times from the year 2018-19

onwards and the said statement has to be believed by this Court as there is no contra evidence produced by the defendants to disprove the same. Judicial notice can also be taken by this Court to the fact that the plaintiff is in the tyre manufacturing market for long number of years.

46. Goodwill is an attraction which brings in customers. It is the one thing which distinguishes an old established business from a new business. The goodwill of a business must emanate from a particular centre or source. However, widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient <https://www.mhc.tn.gov.in/judis> to bring customers home to the source from which it emanates. Once the novel mark recognized in the market which distinguishes the goods and services from others, the owner has acquired reputation in the market through the use of that mark, it can be construed that the owner is having a goodwill.

47. In the case on hand, as observed earlier, the plaintiff's Muscleman Device is a novel logo which has been well recognized in the market and the said logo has been associated only with the plaintiff and they have also acquired reputation through the usage of the said logo for the manufacture and sale of their tyres. Though the defendants claim that there are other tyre manufacturers in the market, who are using an almost identical logo as that of the plaintiff, they have not produced any evidence in support of their contention. No documentary evidence has also been placed on record by the defendants to prove the said contention. The defendants partner by name, Mr.Rajesh Jain, has been examined as a witness (DW1) on the side of the defendants. During his cross examination, he has admitted that their concern is involved in the tyre manufacturing business only since 2003. DW1 on 26.07.2022 when he was cross examined admits that his age was 27 years in 2003. The <https://www.mhc.tn.gov.in/judis> defendants have also not examined any other witness, who was well aware of the defendants' growth in the tyre manufacturing business since 2003.

48. The defendants' witness (DW1) has also admitted during his cross examination that the defendants have a different pattern for identical purposes. The defendants' witness (DW1) has also pleaded ignorance as seen from answer to question No.18 as to "when such practice has been adopted by the defendants?". When a specific question was put to DW1 that "is it correct to state that such use has been atleast for the last seven years?", the defendants witness (DW1) has answered by stating that he does not remember. The defendants' witness (DW1) has also admitted by answering to question No.32 that the plaintiff is well renowned and a reputed Company.

49. The defendants' witness (DW1) has also given evasive and vague answers as seen from his cross examination. The defendants' witness (DW1) has also answered irresponsibly by stating that "I do not remember to the question as to when and why the defendants started using the marks CHEETAH, SAHARA and SAFARI". As seen from the <https://www.mhc.tn.gov.in/judis> cross examination of DW1, the defendants' witness is not a proper and competent witness to give the true picture with regard to the usage of the body builder logo by the defendants which is deceptively similar to the plaintiff's registered Muscleman Device. In the oft quoted decision rendered by the Honourable Supreme Court in the case of Cadila Health Care Ltd., V. Cadila Pharmaceuticals Ltd. reported in (2001) 5 SCC 73, where similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the Court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. In the

case on hand, the plaintiff is having the benefit of interim injunction from this Court against the defendants restraining the defendants from using the body builder logo which was earlier used by the defendants by this Court's order dated 12.03.2021 in O.A.Nos.116 to 118 of 2021 and the said order is still in force.

50. Prima facie, this Court was satisfied that the defendants' mark is so close to that of the plaintiff's mark and only thereafter granted an order of interim injunction. As observed earlier, the torso of a muscular <https://www.mhc.tn.gov.in/judis> man with two arms has been copied by the defendants in their logo though a robotic head is also found in the defendants' logo that will not enable the defendants to claim that their logo is completely different from that of the plaintiff's registered Musclemans Device.

51. The torso of a muscular man and the arms are the distinctive elements of the plaintiff's Musclemans Device, which has been registered under the Trade Marks Act. When the essential features of the plaintiff's Musclemans Device has been copied by the defendants and any layman of average intelligence and imperfect recollection will certainly be confused as to whether the defendants' product is also associated with the plaintiff, the ratio laid down in Cadila Health Care Ltd., V. Cadila Pharmaceuticals Ltd. reported in (2001) 5 SCC 73 for testing deceptive similarity has been satisfied by the plaintiff. They have been able to prove beyond reasonable doubt that the defendants' body builder logo is an imitation of the plaintiff's Musclemans Device mark as the defendants' logo also depicts the torso of a muscular man with two arms. Certainly, if the defendant is allowed to continue using the impugned device, the general public having average intelligence and imperfect recollection will <https://www.mhc.tn.gov.in/judis> be deceived as they will have an impression that the product of the defendants is also associated with the plaintiff. The decision rendered in Parle Products (P) Ltd. V. J.P. And Co., Mysore reported in (1972) 1 SCC 618 decision also comes to the aid of the plaintiff. In the said decision, the principle "two marks, when placed side by side may exhibit many and various differences, yet the main idea left on mind by both may be the same" was applied.

52. In the case on hand also the two marks viz., one the "Musclemans Device" of the plaintiff and the other the "body builder" logo of the defendants may have differences but yet the main idea has been copied by the defendants from the plaintiff's Musclemans Device by using the torso of a muscular man and the two arms which has been used in the plaintiff's registered Musclemans Device.

53. The impugned mark bears an overall similarity to the registered mark of the plaintiff and certainly it would mislead a person to think that the defendants' products are also associated with the plaintiff. There is also no flavour of minimum requirement of creativity in the defendants' <https://www.mhc.tn.gov.in/judis> body builder logo which is a requirement as seen from the decision of the Honourable Supreme Court in Eastern Book Company Vs. DB Modak reported in AIR 2008 SC 809. When the main idea for the defendants' logo has been copied from the plaintiff's registered Musclemans Device mark as held by the Honourable Supreme Court in Eastern Book Company Vs. DB Modak, there is "no flavour of minimum requirement of creativity" in the defendants' logo. The presence of an arrow in the defendants' logo which was not found in the plaintiff's Musclemans Device will not protect the defendants' logo as the said arrow has been used by

BATA Company for its POWER brand of shoes. DW1 has given an irresponsible answer to question No.41 where a question was asked "Is it correct to state that BATA is a shoe brand". The answer given was "I do not know" and that DW1 has never bought that shoe brand. "Arrow" is associated only with BATA in respect of its POWER brand and judicial notice can also be taken note of the said fact. The defendants have also not produced any documentary evidence and they have also not pleaded in the written statement as to when their logo was created or by whom it was created. It is also noticed from the Chartered Accountant's certificate produced by the defendants which is marked as Exs.D12 and D13 that <https://www.mhc.tn.gov.in/judis> there has been a sudden jump in the defendants' sales from 2018-19 onwards and the sale has increased manifold. In the decision rendered by the Honourable Supreme Court in the Colgate Palmolive Company V. Anchor Health And Beauty Care Pvt. Ltd reported in 2003 (27) PTC 478 one of the test to be considered while deciding whether there has been infringement or passing off on the part of the defendants is to see whether there is a rise in the sale of the products of the defendants after the defendants have copied the plaintiff's trademark / logo. In the case on hand, as seen from the Chartered Accountant's certificates, marked as Exs.D12 and D13, it is clear that there has been steep increase in the sales turnover from the year 2018 - 19 onwards. In the year 2017-18, the total sale turnover of the defendants was Rs.20,63,07,129.50 and in the year 2018-19, the defendants' total sales turnover suddenly jumped to Rs.45,56,94,881.38. The sudden jump in the sales turnover has also weighed in the mind of this Court for coming to the conclusion that the defendants have dishonestly copied the plaintiff's Muscleman Device mark for the purpose of misrepresenting to the public that the defendants' products are also associated with the plaintiff and for the purpose of making unlawful gains. No proper explanation has also been given by the <https://www.mhc.tn.gov.in/judis> defendants for the sudden jump in their sales from the year 2018-19 onwards.

54. The defendants who are also tyre manufacturers and who claim that they are in the tyre manufacturing business since 2003, as a prudent business concern ought to have made a search with the trademark registry and if they had made such a search it would reveal the existence of the plaintiff's Muscleman Device and the other trademarks viz., CHEETAH, SAHARA and SAFARI. Having not conducted a trademark search, they cannot now claim to be an honest and concurrent user of the deceptively similar device mark. The answers given by DW1 for various questions also does not assist the defendants to contend that they are an honest and concurrent user.

55. In similar cases, where a search was not made in the Trademarks Registry, the Delhi High Court as well as the Bombay High Court in their decisions in the case of The British India Corpn. Ltd., V. Kharaiti Ram reported in AIR 2000 Delhi 289 and Ayushakthi <https://www.mhc.tn.gov.in/judis> Ayurveda V. Hindustan Lveer reported in [2003] (4) Mh. L.J 915 held that the defendant cannot be considered to be an honest and concurrent user. By applying the said decisions to the case on hand, the protection granted to honest and concurrent user under Section 135 (3) (b) and Section 135 (3) (c) of the Trade Marks Act, 1999 cannot also be granted to the defendants as they have not been able to establish through their oral and documentary evidence that

a) They were not aware of the plaintiff's right in the trademark;

b) When the defendants commenced the use of their logo, they were not aware of the existence of the plaintiff's Muscleman Device.

56. It is well settled by the following decisions, also cited by the learned counsel for the plaintiff, that there is no need for placing two marks side by side to find out any differences in the design. It is enough if the impugned mark bears an overall similarity to the registered mark which could possibly mislead a person dealing with the mark:

a) Parle Products (P) Ltd. V. J.P. And Co., Mysore reported in (1972) 1 SCC 618;

b) Apex Laboratories Limited v. India Pharmaceuticals reported <https://www.mhc.tn.gov.in/judis> in AIR 2017 Mad 126;

c) Satyam Infoway Ltd. V. Sifynet Solutions (p) Ltd. reported in (2004) 6 SCC 145;

d) Vst Industries Limited V. Rudra Ventures Private Limited reported in 2022 SCC Online Del 41;

e) Kirit Kumar Girdharlal Doshi V. Wimco Limited reported in (1998) 18 PTC 459;

f) Chimanlal Narsaji Suhan v. Parasmal Mithalal Parmar reported in (1997) 17 PTC 388.

57. It is also settled law while deciding the question of similarity between two marks, the overall similarity should be taken from a perspective of a man with an average intelligence and imperfect recollection.

58. The following two authorities have also laid down the said proposition:

a) Corn Products Refining co, V. Shangrila Food Products <https://www.mhc.tn.gov.in/judis> reported in AIR 1960 SC 142;

b) Aquamatic Case (Harr Reynolds Vs. Laffeaty's) reported in 1958 R.P.C. 387 .

59. Mere publication of a mark does not confer power to the owner to violate the other party's right. The said principle was also held in the decision rendered in S.Sudhakar and Shri Lakshmi Agro Foods Pvt. Ltd V. S.S.P. Durairaj (Firm) and Durairaj reported in (2008) 36 PTC

150. In the oft quoted decision rendered by the Honourable Supreme Court in Colgate Palmolive Company V. Anchor Health And Beauty Care Pvt. Ltd reported in 2003 (27) PTC 478, it has been held that there cannot be dilution and erosion of the uniqueness and distinctiveness of a well known mark. MRF is a well known mark in the field of manufacture of tyres and, certainly if the distinctive feature of Muscleman Device is allowed to be copied, there will be dilution and erosion to their uniqueness and distinctiveness of the trademark. The defendants have certainly copied the

plaintiff's Musclemann Device, which has enabled them to ride over the plaintiff's reputation and goodwill and make unlawful gains as seen from their Chartered Accountant's certificates <https://www.mhc.tn.gov.in/judis> marked as Exs.D12 and D13 which shows a steep increase in their sales from 2018-19 onwards. A device cannot also be made to look almost identical to an existing device at a subsequent stage of registration as held by the Honourable Supreme Court in *Midas Hygenic Industries V. Sudhir Bhatia* reported in 2004 (3) SCC 90.

60. Admittedly, the plaintiff has not obtained trademark registration for their logo and they have obtained trademark registration only for the mark POWERMAX, that too only on 26.02.2008 as seen from Ex.D1. Order VIII Rule 3 and 5 of C.P.C. also makes it clear that the facts which are not expressly denied by the defendants shall be taken as admitted facts in so far as the marks CHEETAH, SAHARA and SAFARI are concerned. Except for stating that they have stopped using the said marks on receipt of the cease and desist notice in their written statement, the defendants have not expressly denied that they have not committed the act of infringement in so far as those marks are concerned.

61. Order VIII Rule 3 and 5 of C.P.C. are extracted hereunder:

"3. Denial to be specific.—It shall not be sufficient for a defendant in his written statement to <https://www.mhc.tn.gov.in/judis> deny generally the grounds alleged by the plaintiff, but the defendant must deal specifically with each allegation of fact of which he does not admit the truth, except damages.

*[3A. Denial by the defendant in suits before the Commercial Division of the High Court or the Commercial Court.— (1) Denial shall be in the manner provided in sub-rules (2), (3), (4) and (5) of this Rule.

(2) The defendant in his written statement shall state which of the allegations in the particulars of plaint he denies, which allegations he is unable to admit or deny, but which he requires the plaintiff to prove, and which allegations he admits. (3) Where the defendant denies an allegation of fact in a plaint, he must state his reasons for doing so and if he intends to put forward a different version of events from that given by the plaintiff, he must state his own version.

(4) If the defendant disputes the jurisdiction of the Court he must state the reasons for doing so, and if he is able, give his own statement as to which Court ought to have jurisdiction.

(5) If the defendant disputes the plaintiff's valuation of the suit, he must state his reasons for <https://www.mhc.tn.gov.in/judis> doing so, and if he is able, give his own statement of the value of the suit.] "

" 5. Specific denial.—[(1)] Every allegation of fact in the plaint, if not denied specifically or by necessary implication, or stated to be not admitted in the pleading

of the defendant, shall be taken to be admitted except as against a person under disability:

Provided that the Court may in its discretion require any fact so admitted to be proved otherwise than by such admission:

*[Provided further that every allegation of fact in the plaint, if not denied in the manner provided under Rule 3A of this Order, shall be taken to be admitted except as against a person under disability.] [(2) Where the defendant has not filed a pleading, it shall be lawful for the court to pronounce judgment on the basis of the facts contained in the plaint, except as against a person under a disability, but the Court may, in its discretion, require any such fact to be proved. (3) In exercising its discretion under the proviso to sub-rule (1) or under sub-rule (2), the Court shall have due regard to the fact whether the defendant <https://www.mhc.tn.gov.in/judis> could have, or has, engaged a pleader. (4) Whenever a judgment is pronounced under this rule, a decree shall be drawn up in accordance with such judgment and such decree shall bear the date on which the judgment was pronounced.] "

62. In R.G. Anand V. M/s. Delux Flims and others reported in 1978 (4) SCC 118 relied upon by the learned counsel for the defendants, the test to be applied for ascertaining whether there is infringement of a copyright have been enumerated.

"1. There can be no copyright in an idea, subject matter, themes, narratives, or historical or legendary facts, and copyright infringement in such circumstances is limited to the creator of the copyright work's form, method, arrangement, and presentation of the concept.

2. Where the same concept is developed differently, it is obvious that because the source is shared, parallels are sure to appear. In such a situation, the courts must decide whether the similarities are on basic or significant parts of the style of expression used in the copyrighted work. If the defendant's work is nothing more than a literal limitation of the original work with a few <https://www.mhc.tn.gov.in/judis> alterations here and there, it would be a copyright violation. In other words, for the copy to be actionable, it must be significant and material, leading to the judgement that the defendant is guilty of piracy right away.

3. One of the surest and safest tests to determine whether or not there has been a copyright violation is to see if the reader, spectator, or viewer is clearly of the opinion and gets an unmistakable impression that the subsequent work appears to be a copy of the original after having read or seen both works.

4. There is no concern of copyright violation if the concept is the same but is presented and treated differently such that the succeeding work becomes an entirely new work.

5. Where, however, apart from the similarities appearing in the two works, there are also significant and wide dissimilarities that negate the intention to duplicate the original and the coincidences appearing in the two works are manifestly accidental, no copyright infringement occurs.

6. As a breach of copyright constitutes an act of piracy, it must be proven by clear and convincing <https://www.mhc.tn.gov.in/judis> evidence after applying the relevant case law criteria.

7. When the issue is an infringement of a stage play's copyright by a film producer or director, the plaintiff's task becomes more difficult to show piracy. It is obvious that, unlike a stage play, a film has a much broader perspective, a wider field, and a larger background in which the defendants might add colour and complexion distinct from the method in which the original work has represented the concept by introducing a variety of situations. Even yet, if the audience leaves the film with the idea that it is mostly a replica of the original play, an infringement of the copyright may be deemed proven."

63. The test enumerated supra, is otherwise known as 'lay observers test' and is generally used by Courts to distinguish between ideas and expression in any given cases. As the name suggests, this test is performed by making an average layman of reasonable intellect peruse the contended works of the plaintiff and the defendants. Their opinion on the similarity or dissimilarity of the works is then taken into consideration while deciding a case. One of the test, is that if the defendant's work is <https://www.mhc.tn.gov.in/judis> nothing more than a literal imitation of the original work with a slew of alterations, here and there, it would amount to copyright violation. In the case on hand, except for making some cosmetic changes, the defendants have copied the main idea of the plaintiff by using a torso of muscular man and the two arms which is also used in the plaintiff's registered Musclemans Device.

64. From the foregoing analysis and reasons, it is clear that the plaintiff has proved through their oral and documentary evidence supported by various authorities that the defendants have committed an act of passing off and they have also committed copyright infringement over the plaintiff's registered Musclemans Device.

65. There is no explanation given by the defendants as to how and when they started using the other marks viz., CHEETAH, SAHARA and SAFARI for which the plaintiff has obtained trademark registration. They have also proved through their oral and documentary evidence that those marks are exclusively associated with the plaintiff and no one else. The conduct of the defendants in adopting the marks of the plaintiff's viz., CHEETAH, SAHARA and SAFARI is improper and will go to show their <https://www.mhc.tn.gov.in/judis> dishonest intention of copying the registered trademarks of the plaintiff for making unlawful gains in their identical business viz., tyre manufacturing business. The defendants cannot escape their liability to pay damages to the plaintiff despite the fact that they have stopped using the marks CHEETAH, SAHARA and SAFARI on receipt of the cease and desist notice from the plaintiff prior to the filing of the suit. Certainly, they

would have made profits by using the marks of the plaintiff viz., CHEETAH, SAHARA and SAFARI earlier, for which they cannot be allowed to go scot-free. When the dishonesty on the part of the defendants has been established, necessarily, they will have to pay nominal damages to the plaintiff. Though the plaintiff has claimed a sum of Rs.25,01,000/- as damages from the defendants, there is no evidence available on record to prove that they have suffered such a huge loss. However, in view of the fact that the plaintiff has proved through its oral and documentary evidence that the defendants have committed an act of passing off and have also committed Copyright infringement, necessarily, some amount of nominal damages will have to be awarded in favour of the plaintiff.

66. This Court after giving due consideration to the reputation of <https://www.mhc.tn.gov.in/judis> the plaintiff and after giving due consideration to the improper conduct of the defendants, awards nominal damages to the plaintiff at Rs.5,00,000/-.

67. Accordingly, the issues framed by this Court on 30.09.2021 are being answered in the following manner:

Issue No.i. The defendant's have dishonestly adopted the Artistic work "a Half size Body Builder with Robo Head" from the plaintiff's artistic work found in the "Muscleman Device".

Issue No.ii. The plaintiff has proved beyond reasonable doubt that, the label/mark/logo of the defendant "a Half size Body Builder with Robo Head" is identical with/deceptively similar to their artistic work "a man holding tyre with lifted hands".

Issue No.iii. The use of the label/mark/logo as adopted by the defendant in respect of its goods/service amounts to infringement of the registered trademarks of the plaintiff.

Issue No.iv. The use of the label/mark/logo as adopted by the defendant in respect of its goods/service amounts to infringement of the copyright of the plaintiff.

Issue No.v. The use of the label/mark/logo as adopted by the defendant in respect of its goods/service amounts to passing off of goods. <https://www.mhc.tn.gov.in/judis>

Issue No.vi. The defendants have not obtained registration for their body builder logo. They have trademark registration only for the trademark POWERMAX under registration No.1458006. Hence, they are not entitled to use their body builder logo.

Issue No.vii. Since issue No.vii is a repetition of issue No.vi, there is no necessity for this Court to give an answer. But, at the same time, this Court once again makes it clear that the defendants are not entitled to use their body builder logo which is deceptively similar to the plaintiff's "Muscleman Device".

68. For the foregoing reasons, the suit is partly decreed as prayed for by granting the following reliefs in favour of the plaintiff:

a. A perpetual injunction restraining the Defendants, its distributors, stockists, servants, agents, retailers, representatives or any other person claiming under/through them, from in any manner infringing the Plaintiff's Registered Trade Marks 'Muscleman Device', MRF CHEETAH, MRF SAHARA, MRF SAFARI, PAHALWAN by the Defendant's by using the Impugned Muscleman logo and the trademarks CHEETAH, SAHARA, SAFARI or any other mark identical with and/ or deceptively similar to the plaintiff's Trademarks/Artistic Works and <https://www.mhc.tn.gov.in/judis> Muscleman Device, PAHALWAN, MRF CHEETAH, MRF SAHARA, MRF SAFARI in connection with the defendant's goods/services and/or business or in any other manner whatsoever;

b. A perpetual injunction restraining the Defendants, their distributors, stockist's, servants, agents, retailers, representatives or any other person claiming under/through them from in any manner using the trademarks 'SAHARA', 'CHEETAH', 'SAFARI' and Impugned Muscleman Device, and/or any other mark which is identical with or deceptively similar to the Plaintiff's registered Trademarks/Artistic Works Muscleman Device, PAHALWAN, MRF CHEETAH, MRF SAHARA, MRF SAFARI so as to pass off the Defendant's goods or services or business or website as that of the Plaintiff and/or wrongfully associate themselves with the Plaintiff's business or in any other manner whatsoever, c. A perpetual injunction restraining the Defendants, his distributors, stockists, servants, agents, retailers, representatives or any other person claiming under/through him from in any manner infringing the Plaintiff's Copyright in the 'MUSCLEMAN DEVICE' filed as Plaint Document No.1 by using the infringing mark/logo as shown in Plaint Document No. 6 or any other mark/ device/ artistic work with is identical with/ deceptively similar or any substantial reproduction of the <https://www.mhc.tn.gov.in/judis> MUSCLEMAN DEVICE' on or in connection with the business of the Defendants, or in any other manner whatsoever;

d. The Defendants be ordered to remove all painted displays, and other display material being used by the Defendants containing Plaintiff's Trademarks/Artistic Works, 'MUSCLEMAN DEVICE' or any other mark which is deceptively similar and/or is a substantial reproduction thereof and surrender to Plaintiff the glow sign board, all goods, labels, catalogues, dyes, blocks, moulds, screen prints, packing materials, bills, vouchers, literature, publicity material, letterheads, invoices, challans, visiting cards, job cards, delivery notes, rate list, sign boards, glow signs, blow ups and all reprographic materials and other materials bearing any of the plaintiff's trade marks or artistic works of the Plaintiff within a period of eight weeks from the date of receipt of a copy of this judgment and decree;

e. The Defendants are directed to pay the Plaintiff a sum of Rs.5,00,000/- as nominal damages for Passing Off and infringement of Trade Mark & infringement of copyright;

f. The defendants are directed to pay the costs of the suit to the plaintiff.

01.04.2024 Index: Yes/ No <https://www.mhc.tn.gov.in/judis> Speaking order / Non speaking order Neutral citation : Yes / No ab <https://www.mhc.tn.gov.in/judis> List of Witness examined on the side of the Plaintiff:

Mr.George Samuel (PW1) List of the Exhibits marked on the side of the Plaintiff:

"Ex.P1 is the original authorization letter dated 16.1.2021.

Ex.P2 is the colour print out copy of plaintiffs Muscleman Device.

Ex.P3 is the photocopy of Copies of the Certificate of Legal Use and Registration of the Trade Marks together with the certificates of renewal of the marks of plaintiff (Original seen verified and returned.) Ex.P4 is the photocopies of the certificates of Legal Use and Registration of the Trade Marks together with the certificates of renewal of the marks of plaintiff. (Original seen verified and returned.) Ex.P5 is the original Chartered accountant's certificate showing the sales turnover and expenditure on advertisement for the past few years <https://www.mhc.tn.gov.in/judis> in respect of business of the plaintiff under the plaintiff's trademarks dated 08.09.2020.

Ex.P6 is the colour print out copy of Plaintiffs Logo used in connection of MRF Institute of Driver Development.

Ex.P7 is the colour print out copy Defendant's infringing trademark and logo.

Ex.P8 is the colour print out copy of A Screen shot of the defendant's website <http://www.powermaxtyre.com/homepage>.

Ex.P9 is the colour print out copy of Defendant's catalogue on its website.

Ex.P10 is the photocopy of Legal notice issued by the plaintiff dated 09.07.2020 Ex.P11 is the photocopy of Reply notice issued by the defendant dated 18.07.2020.

Ex.P12 is the photocopy of legal notice issued by the plaintiff dated 04.08.2020.

<https://www.mhc.tn.gov.in/judis> Ex.P13 is the original of Power of Attorney dated 22.12.2020."

List of Witness examined on the side of the Defendants:

Mr.Rajesh Jain (DW1) List of the Exhibits marked on the side of the Defendants:

"Ex.D1 is the copy of the registered Trade Mar No.1458006 in class 12 for the mark Power max (marked with objection on the ground that the same cannot relied upon in legal proceedings as mentioned in the certificate itself) Ex.D2 is the copy of the partnership deed of the 2nd defendant dated 01.04.2010 (Objected on the ground that no witness has signed) Ex.D3 is the copy of the: VAT Registration Certificate in favour of 2nd defendant dated 21.12.2010. (original verified and returned) Ex.D4 is the copy of the Assignment Deed dated 02.04.2012 (original verified and returned) <https://www.mhc.tn.gov.in/judis> (Objected on the ground that no witness has signed) Ex.D5 is the copy of the partnership deed dated 29.06.2015(Original seen verified and returned) (Objected on the ground that no witness has signed) Ex.D6 is the copy of the Assignment Deed dated 30.05.2016 (Original seen verified and returned) Ex.D7 is the print out copy of the Renewal Certificate dated 18.03.2017 (Affidavit under Section 65 B Indian Evidence Act filed.

Ex.D8 is the print out copy of the GST Registration Certificate in favour of 1 defendant dated 20.09.2017 (Affidavit under Section 65 B Indian Evidence Act filed.

Ex.D9 is the print out copy of the GST Registration Certificate in favour of 2nd defendant dated 20.09.2017 (Affidavit under Section 65 B Indian Evidence Act filed.

<https://www.mhc.tn.gov.in/judis> Ex.D10 is the download copy of the Trademark application No.4278170 dated 29.08.2019 (Affidavit under Section 65 B Indian Evidence Act filed.

Ex.D11 is the downloaded copy of Search Certificate issued under rule 22(1) Trademarks rules dated 23.10.2020 (Affidavit under Section 65 B Indian Evidence Act filed.

Ex.D12 is the copy of the Sales Turnover Certificate of the 1" defendant dated 05.03.2021 (Original seen verified and returned) Ex.D13 is the copy of the Sales Turnover Certificate of the 2nd defendant dated 05.03.2021 (Original seen verified and returned) Ex.D14 is the print out copy of the plaintiffs Logo (Affidavit under Section 65 B Indian Evidence Act filed.

Ex.D15 is the print out copy of the defendant's previous Logo (Affidavit under Section 65 B Indian Evidence Act filed.

<https://www.mhc.tn.gov.in/judis> Ex.D16 is the print out copy of the defendant's present Logo (Affidavit under Section 65 B Indian Evidence Act filed.

Ex.D17 is the print out copy of Comparative picture of plaintiff's Logo and defendant's logo (Affidavit under Section 65 B Indian Evidence Act filed.

Ex.D18 is the original of the present product catalogue of the defendant's Ex.D19 is the print out copy of present defendant's website page containing product list (Affidavit under Section 65 B Indian Evidence Act filed.

Ex.D20 is the Digital copy of Copyright Registration Certificate dated 22.10.2021 (Affidavit under Section 65 B Indian Evidence Act filed."

01.04.2024 ab <https://www.mhc.tn.gov.in/judis> ABDUL QUDDHOSE, J.

ab pre-delivery judgment 01.04.2024 <https://www.mhc.tn.gov.in/judis>