

**(1998) 11 MAD CK 0029**  
**In the Madras High Court**

Beton Tile Company and Others

APPELLANT

Vs

Indcen Structural (P) Ltd.

RESPONDENT

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**Date of Decision :** 23-11-1998

**Acts Referred:**

**Citation :** (1999) 1 MLJ 580

**Hon'ble Judges :** S.M. Abdul Wahab, J

**Bench :** Division Bench

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**Judgement**

S.M. Abdul Wahab, J.—The appeal has been preferred by the aggrieved respondents in I.A.No. 2142 of 1998 in O.S.No. 895 of 1998, which is for injunction.

2. The respondents filed the suit for injunction restraining the defendants from in any manner passing off their inferior quality prepolished cement

concrete wall tiles with butch work under the trade mark/name "DIANA" or any other trade mark/name as and for the unique prepolished cement

concrete wall tiles with butch work manufactured for and marketed by the plaintiff under the trade mark ""Eurocon Monalisa".

3. According to the respondents, they are the largest manufacturer of prepolished cement concrete tiles in India and they have been carrying on

business since 1984. They are manufacturing and marketing different types of tiles under the trade mark "EUROCON", along with various marks

like Aquarius, Taurus, Regalia, Pisces etc. The trade mark -"EUROCON"" has been registered under the Trade and Merchandise Marks Act with

register No. 437663 and the registration is in force. The plaintiffs have executed many prestigious projects for a wide cross section of clientele.

The turnover of the plaintiff runs to several crores of rupees. The prepolished

concrete tiles of plaintiff have bagged many prestigious order from foreign countries like Singapore, Maldives and Srilanka. In the course of business the plaintiff developed a particular variety of tiles, which is manufactured and marketed under the trade mark ""MONALISA" from 1993. This variety is being used widely for Lobby Walls of Hotels, Corporate Offices, Wall Cladding, Restaurants, Board Rooms, Conference Halls etc. These tiles have a unique and distinct appearance. It is manufactured by a semi automatic machine production procedure by using specialised equipment such as pan type counter flow concrete mixing machine and specialised dynamic table vibrators. In addition to the above, the plaintiff company has also improvised tiles with butch work by providing roughage on the rear side of the tiles, so that it can be embedded firmly in the mortar. Such an advantage did not exist earlier with natural stones. These tiles have a wide overseas market also being regularly exported to Singapore. In September/October, 1997, the plaintiff came across cement concrete tiles with butch work which are an exact imitation of the plaintiff company's unique tiles with butch work and on enquiry the plaintiff came to understand that they were manufactured by the first defendant and marketed by the seventh defendant. The action of the defendants in manufacturing and marketing a slavish imitation of cement concrete wall tiles with butch work is illegal inasmuch as the prepolished cement concrete wall tiles with butch work of the plaintiff have acquired extensive reputation and goodwill and these tiles in the minds of the consuming public are associated with the plaintiff company alone and none else. The defendants have ventured to manufacture and market cement concrete wall tiles with the sole intention of passing off on the wide spread reputation and goodwill enjoyed by the tiles of the plaintiff and to enrich themselves unjustly. The defendants deliberate false representation in the trade circle and to the consuming public that the inferior quality to be manufactured by them originate from the plaintiff, and are passing off the same as and for the high quality tiles of the plaintiff. Therefore, the plaintiff is entitled to an injunction as prayed for.

4. With similar allegations the plaintiff filed I.A. No. 2142 of 1998 in O.S.No. 895 of 1998 and prayed for interim injunction restraining the defendants from in any manner passing of their inferior quality prepolished

cement concrete wall tiles with butch work under the trade mark/ name

DIANA or any other trade mark/name as and for the unique prepolished cement concrete wall tiles with butch work manufactured for and

marketed by the plaintiff under the trade mark "Eurocon Monalisa".

5. The first defendant filed a counter. In the counter it is stated that Beton Tile Company has been producing Cement Concrete tiles and Diana is

an exclusive breath taking tile with texture like natural stone (Butch worked marble effect) prepolished with various colours and widely used for

exteriors and interiors. The Diana tile is a composition of cement, blue metal, aggregates, sand, chemical and pigments. Their tiles have fulfilled all

India IS-1237-1980 standard. Diana is distinctly different from Monalisa. The colour combinations, surface texture, size quality is superior. The

first defendant denied that the plaintiff was first to commence mass production of pre-polished cement concrete wall tiles with butch work. Even it

is assumed that the plaintiff is a pioneer in this regard that does not give the plaintiff any proprietary right over the said tiles. It is admitted by the

plaintiff that the butch work was earlier done by chiselling natural stones manually and there arises no question of any innovation as regards the

design of MONALISA tile and therefore the plaintiff cannot claim any proprietary right. The plaintiff/ petitioner cannot patent its tiles as there is no

anticipation about the product and it is already made public. The defendants DIANA tiles had been introduced in the market in 1996 itself and

from the very beginning it had received good reception and widespread appreciation. The defendants denied that their product has the design,

shape, size and colour scheme were in no way similar to the petitioner's product MONALISA. The manufacture and sale of the cement concrete

wall tile by the respondent company Will not create confusion in the minds of the trade and consuming public. There is no question of the common

man being misled into believing that the respondents' product originated from the petitioner. The tile, DIANA is bought mostly by architects,

interior decorators and builders i.e., people with a thorough knowledge about tiles. The petitioner did not produce a scrap of evidence to prove

deception caused by the respondents among the consumers.

6. A reply was also filed by the petitioner/plaintiff. In the reply the distinction and difference in the form of DIANA from MONALISA was denied.

7. The learned II Additional-Judge, City Civil Court, Chennai, after considering the documents and hearing the arguments, made the interim

injunction absolute by allowing the petition for injunction. Hence, the respondents in the Interlocutory Application have preferred this appeal.

8. According to the learned Senior counsel Thiru R. Krishnamurthy, appearing on behalf of the counsel for the appellants, there is no question of

passing off in this case at all. There are several other manufacturers manufacturing and marketing similar tiles. The learned senior counsel further

contended that the lower court has committed serious error apparent on the face of the record and on that basis alone the order cannot be

sustained. The learned senior counsel further contended that none of the principles laid down in the Trade and Merchandise Marks Act, 1958 is

applicable to the present case. The appellants are not infringing the trade mark of the respondents.

9. The learned Counsel for the respondent Mr. M. Sundar on the other hand contended that this is a clear case of passing off since the appellants

have chosen to copy the design and get up. Even in the advertisement including the brochure issued by the appellants, there is an element of

passing off and it will, definitely lead to the deception and confusion among the consumer public.

10. Before we go into the other aspects of the case, as rightly pointed out by the learned senior counsel for the appellants, the lower court has

committed a serious mistake, it can be even said to be a blunder. In paragraph 13, the trial court Judge has observed as follows:

The petitioner had filed their tile under Ex.P-15 while the respondents have filed Ex.R-1 showing their tiles though both the tiles are different in size,

colour scheme, get up but appearance seems to be as that of the petitioner's i.e., to say the respondents tile DIANA, though, different in size from

that of the petitioner's tile MONALISA, as regards colour scheme, size, get up seems to be the same as that of petitioner's.

From the aforesaid statement, it is clear that the learned Judge has compared the tiles marked as Ex,P-15 with Ex.R-1. It is an admitted fact that

again in paragraph 16 also the trial court has stated as follows:

...a comparison of both products under Ex.R-1 and P-15 show that the respondent are passing off the product as that of the petitioner's.

Ex.P-8 is not a tile, it is a magazine published in the name of "Inside and Outside" by the respondent. There is an advertisement of the respondent

at page 3. There is also an advertisement of the appellants at page 26. From the comparison of Ex.P-15 and R-1 there is no possibility to find out

any of the difference in size, colour scheme, get up etc. Ex.R-1 is the tile produced by a third party (ULTRA) and not by the appellants. Similarly.,

Ex.P-15 is the three small tiles produced by the respondent/plaintiff himself. Since Ex.R-1 is the product of someone else the comparison with it is

also unsustainable. After comparison of the tiles of the third party and the plaintiff and with the brochure, the trial court came to the conclusion that

the respondent was entitled for injunction. As there is an error apparent on the face of the record, the order of the trial court cannot be sustained.

11. Further, the learned Counsel for the respondent contended that after comparing the tiles produced before the court, this Court itself can come

to the conclusion that the tiles produced by the appellants are similar and identical and there is a possibility of confusion among the consumer

public.

12. Even if we take the argument of the counsel for the respondent for consideration, in my view, it is difficult to come to the conclusion that the tile

produced by the appellant is identical in so far as the get up, size and other aspects are concerned.

13. When we look at the tiles produced by the appellants and the respondent, it is true that they appear to be tiles of similar nature. But the

question is whether the first respondent is entitled to obtain an injunction restraining the appellants from manufacturing and marketing similar tiles. I

can understand that if the appellants are allowed to manufacture and sell their tiles under a trade mark, which is deceptively similar, the respondent

will be entitled for injunction. But it is an admitted fact that so far they have not obtained any trade mark registration. That apart the trade name of

the appellants as well as the trade name of the respondent is entirely different. The appellants are manufacturing and selling the tiles with the trade

mark BETON. On the other hand, when we look at the tiles of the respondent, they do not contain any name as such. Simply because, the

products are tiles and they appear to be of similar nature and since they are identical and contain similar ingredients can it be said that a person

manufacturing a tile of one kind can prevent the another person from manufacturing similar or such type of tiles. It cannot be said that these tiles are of the out come of the invention of a single individual. But these tiles appear to be of a common articles used by the public.

14. At this stage, the learned Counsel for the respondent cited the decision reported in McCain International Limited v. Country Fair Foods

Limited and Anr. (1981) R.P.C. 69. The said case relates to manufacture of oven chips. Even in the said case, the chips were sold as oven chips.

The description of product as ""Oven Chips"" for some years have come to acquire distinctiveness. Only in that circumstances the principle of passing off was made applicable to that case.

15. The learned Counsel also cited another decision reported in Teju Singh Vs. Shanta Devi, . Even in this case, what is stated is that the principle

of passing off are applied in a common law action for ""passing off" the business name. Where a trader adopts a trading name including mere

descriptive words of common use the court will not readily assume that the use of the said word or name by the other is likely to cause confusion.

In such a case the plaintiff has to further prove the name has acquired a distinctive meaning in connection with the business. As we have seen

above, in this case what the respondent wants is that from the identity of goods alone the passing off should be upheld. He can succeed if he gives

a name to it and manufactures and sells their tiles under the name for some years. But as far as the case on hand is concerned, both of them are

new entrants in the field.

16. The learned Counsel for the respondent relied upon the decision reported in F. Hoffmann-la Roche & Company A.G. v. D.D.S.A.

Pharmaceuticals Limited (1972) R.P.C. 1, wherein injunction was granted in favour of the plaintiffs when defendants sought to attack some

plaintiffs" goodwill. In the said case, the plaintiff manufactured and marketed the drug known as Chlordiazepoxide under the trade mark LIBRIUM

in black cap and a green body and are distinctive in appearance. The defendants who were manufacturers of a drug namely, C.D.P. capsules, with

a black cap and green body 10 mg. capsules, which were identical with those of the plaintiff. They bear the letters D.D.S.A. instead of the

plaintiffs" name. In the said case also the emphasis was not on the goods, but

on the colour, particularly combination of two colours black and green. After selling the capsules with such a design by mixing two colours, the plaintiffs' goods acquire some distinction. That is why in the said case, the plaintiff was able to succeed.

17. The learned Counsel cited a Patent Trade Mark Case reported in *M.R.F. Limited v. Metro Tyres Limited* 1990P.T.C. 101. In the said case

also the plaintiffs were using the trade mark NYLOGRIP, MRF AUTOMILER SHAKTI, etc. The defendant adopted rightly similar tread patterns

namely, RADIALGRIP METRO HEAVY DUTY, JAIKISSAN etc. As the products were identical, the plaintiff was able to succeed definitely. It

was not because similar or identical goods with different names sold by the defendant, but because of the peculiar pattern adopted by the plaintiff.

Therefore, the said case is also not helpful to the appellants.

18. Lastly the learned Counsel for the respondent cited the judgment reported in *John Haig and Company Limited v. Forth Blending Company*

*Limited and W.R. Paterson Limited* (1953)7 R.P.D. 259. In the said case ten principles have been enunciated to test whether in a given case there

is a passing off or not. The learned Judge has set out a number of tests. For example, the trade names, trade marks, get up and other

accompaniments etc. The fifth guideline is with reference to the get-up, it instated as follows: The get-up of goods comprises the size and shape of

the package or container, labels and wrappers - the dress in which the goods are offered to the public. Here again, what we find is only the dress

in which the goods is wrapped and not the identity of the goods. Here, admittedly, the Tiles are not covered with any package or anything like that.

There is no get-up or any wrapper on the tiles belonging to both parties. In the circumstances, I do not think that none of the principles enunciated

in the said case is applicable to the present case.

19. The learned Counsel for the respondent at this stage also states that there will be a passing off even if there is identity in the accompaniments

associated with the goods. According to the learned Counsel, the brochure is accompanying the sale. If there is similarity in the two by showing the

pictures of the tiles in a similar fashion the passing off will be attracted. In my view, it is not proved before this Court that both the appellants and

the respondent are selling their goods invariably with the brochure. They may be

using, them to impress upon the purchasers when the purchaser enters into the show-room or the shop of the appellants and the respondent. Therefore, that test in my view cannot be taken as a sound test to find out the passing off.

20. As we have seen above, the tiles are modern articles replacing the earlier tiles and bricks. It is not very rare in this part of the country that people use stones, i.e., black granite stones. Can a person selling black granite stones in a name claim the right of passing off if other person imports black granite and sells it in a different name? These goods are common goods and are now in good demand among the public. Therefore, if we apply the principle of passing off there will be an unjustified restriction on the trade.

21. The trade mark action is entirely different from the action for passing off. These two principles of passing off and trade mark normally and generally apply to the name of the product and not to the product itself. This is the underlying principle. Therefore, in my view, I do not find that the plaintiff has a case for injunction.

22. The above finding is only with reference to the disposal of the injunction petition. The trial court need not take the above finding of facts when it is called upon to try the suit on evidence. In the circumstances, the appeal is allowed. However, there will be no order as to costs. Consequently,

C.M.P.No. 13326 of 1998 is dismissed.