

(2012) 10 MAD CK 0246

In the Madras High Court

Case No : Original Application No's. 265 and 266 of 2012 and Application No's. 2202 and 2203 of 2012 and Application No. 1774 of 2012 in C.S. No. 225 of 2012

Glosoft Technologies Private Limited 3rd Floor Dharma Towers
88/150 Nelson Manickam Road Chennai 94

APPELLANT

Vs

M/s. Squadra Education Private Limited 33/272-F Anugraha
Malaparamba Kozhikode and Others

RESPONDENT

Date of Decision : 30-10-2012

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 2 Rule 2
Trade Marks Act, 1999 — Section 134, 17, 2(1)(d), 28(2), 29

Citation : (2012) 8 MLJ 428

Hon'ble Judges : K. Chandru, J

Bench : Single Bench

Final Decision : Dismissed

Judgement

K. Chandru

1. The applicant in the two original applications is the plaintiff. The plaintiff is a registered private limited company. They have been carrying on computer education under the name and style of G-TEC Computer Education and the logo G-TEC and engaged in running computer training centres at various places both within and outside Kerala to promote and advance computer awareness among students and businessmen, executives and members of general public. They commenced their computer education centres during October, 2000 and are using the trade mark for 11 years. Subsequently, they had registered their trade mark on 03.08.2001 with the Trade Mark Registry. The Directors of first respondent company initially had franchise agreement with the applicant. Subsequently, they had registered the defendant company on 17.02.2012 and by minimally altering the logo. They are using the trade name Gi-TEC Computer Education and Gi-TEC and they are using the logo with deceptively similar, colour scheme and phonetically similar trade mark. Thus, they have infringed the trade

mark of the applicant and are passing off the same as if they are carrying on the trade of the applicant. In the plaint filed in support of the suit, similar relief of permanent nature was sought for. In the two original applications, a temporary injunction was sought for restraining the respondents/defendants from in any manner infringing the applicants trade mark G-TEC Computer Education and G-TEC by using the similar or deceptively similar trade mark and passing off the respondents educational services Gi-Tec or Gi-Tec Education.

2. This court by an order dated 04.04.2012 had granted an interim injunction. Aggrieved by the grant of the interim injunction, the respondents/defendants have filed two applications in A. Nos. 2202 and 2203 of 2012 seeking for suspension of the order of interim injunction and vacating the interim injunction granted on 04.04.2012. In the meanwhile, the applicant/plaintiff took out an application in A. No. 1774 of 2012 for appointing an Advocate Commissioner to take an inventory of the stock used or unused offending Gi TEC or Gi TEC Education materials, course study materials, trade marks together with blocks and dyes stationary, brochures, advertisement materials, etc. By an order dated 04.04.2012, this court had appointed an Advocate Commissioner to carry out the said work with police protection. Subsequently, by an order dated 5.6.2012, the Commissioner remuneration was also paid. The Commissioner also sent a report, dated 2.5.2012, to which the respondents have filed an objection statement, dated 16.7.2012.

3. In the two applications, a common counter affidavit, dated 11.6.2012 has also been filed by the applicant/plaintiff. According to the applicant/plaintiff, the defendants' logo was deceptively similar to the logo and trade mark of the applicant/plaintiff. After the letter "G", they have incorporated the word "I" and that the word "TEC" has been retained identically. The logo and the name used by the defendants are identical and similar to the applicant's registered trade mark. The defendants were also using the mark "GiTEC Education" written in a stylistic manner with a letter "G" in bold Red within the letter "i" within the circle of "G" written in blue. The words "GiTEC Education" written in boldy in block. A common man and ordinary consumer with average intelligence and imperfect recollection may tend to confuse the applicant's services and will be deceived by the respondents' services. The applicant had contacted the respondents for an explanation. But they have given a false and misleading information. By the use of the logo and trade name similar to that of the applicant, the respondents are attempting to enrich themselves on the goodwill and reputation earned by the applicant. An application for registration of the trade mark on 31.10.2000 was made by the applicant's predecessor and again on 27.7.2009 claiming user of the trade mark from 3.8.2001 and got the trade mark registered. During February, 2012, the applicant came to know that the respondents are using the trade mark which is an infringement of the applicant's trade mark. Hence they filed the suit.

4. Though the Registry had raised an objection that the respondents/defendants

are entirely located within the State of Kerala and as to how the suit is maintainable before this court in the Original Side, the counsel for the plaintiff made an endorsement that since it is a trade mark infringement, leave to sue is not necessary. Be that as it may, it is now brought to the notice of this court that the applicant has filed a suit before the Sub Court at Kozhicode in O.S. No. 187 of 2012 against the 4th defendant (4th respondent) seeking for an injunction against the defendants from running the computer education centres under the name and style of "Gi TEC Education" in violation of the terms and conditions incorporated in the franchise agreement, dated 04.11.2010.

5. It was stated by the respondents that the applicant has also filed O.S. No. 131 of 2012. The applicant also filed C.S. No. 172 of 2012 against the respondent and his wife and had obtained an interim injunction. The said injunction was suspended. The applicant has no exclusive right over the name G-Tec, which is neither capable of distinction nor the applicant has any statutory protection over the same. The applicant had merely registered a label mark which is a particular and stylized manner of representing G-Tec and has no right to prevent others from using the word G-Tec itself. The word "G-Tech" has been registered as a trade mark by some other persons and it is incapable of being distinguished. Whereas Gi-Tec is completely different and capable of being distinguished. The manner of representation of the mark Gi-Tec also establishes that there is no scope for deception or confusion. Though one of the Directors had franchise agreement, the support from the applicant company was lackluster and none of the promises were kept up.

6. The applicant also filed O.S. No. 2 of 2011 before the District Judge, Kozhikode against one Meharoof Manalody and another restraining them from using the trade mark and trade name of the applicant's company. Since the applicant had already filed a suit in C.S. No. 172 of 2012 before this Court, they cannot file the second suit as it is barred by Order 2 Rule 2 CPC. The present suit is subsequent to the filing of O.S. No. 131 of 2012 and O.S. No. 187 of 2012 and it is barred in law as it arose out of the same cause of action. There is no territorial jurisdiction for entertaining the present suit. Even the registration under Clause 41 in the name of the applicant was only for logo and not for any word and does not grant them any exclusive use of the word G-Tec. As a matter of fact, even under clause 41 itself, there is a registered trade mark in the name GTek registered with a Japanese Company. Even in Clause 9 also, there are other claimants to the mark GTec and its variants. There was no violation of any franchise agreement. The word Tec or Tech refers to technology companies and is widely used by computer institutes and educational institutions and it is generic to the trade. Several universities also offer a bachelor's degree in technology called as B.Tech. The logo used by the respondents are different from the one used by the applicant as even admitted by them. The averment of the applicant that services are available to semi-literate or illiterate is contrary. The applicant has instituted a forum shopping by filing one more suit before this court and had obtained an ex parte injunction.

7. Mr. Perumbulavil Radhakrishnan, learned counsel for the applicant submitted that the registered trade mark is protected even in respect of deceptively similar or confusingly similar marks and it has to be approached from the point of view of a man of average intelligence. A reference was made to the following judgments :

(a) Corn Products Refining Co. Vs. Shangrila Food Products Ltd.,

(b) Parle Products (P) Ltd. Vs. J.P. and Co., Mysore,

8. He also referred to Section 17 of the Trade Mark Act and stated that it will not apply to the facts of the case, since the mark is glaringly deceptively similar and that the applicant/plaintiff is the prior user from the year 2000. Admittedly the defendants are using it only from April, 2012. He referred to the following judgments :

(a) K.R. Chinna Krishna Chettiar Vs. Shri Ambal and Co., Madras and Another,

(b) M/s. L'Oreal Vs. Dushyant Shah in Trade Mark L'Oreal and Institute Torreal (CDJ 2011 DHC 1152)

(c) Ramdev Food Products Pvt. Ltd. Vs. Arvindbhai Rambhai Patel and Others,

9. The defendants/respondents cannot escape from the charge of piracy pleading the defence of Section 17 when a registered composite mark is the subject matter in issue and the learned counsel referred to the judgment of the Supreme Court in K.R. Chinna Krishna Chettiar's case (cited supra).

10. The protection u/s 28(2) is available to the applicant in the event of infringement as set out in Section 29 of the Trade Mark Act. u/s 29(3), the presumption of likelihood of confusion which is calculated to deceive, is protected. The learned counsel referred to the following judgments in support of his submission :

(a) Blue Hill Logistics (P) Ltd. Vs. Ashok Leyland Limited (CDJ 2011 MHC 2803 (DB)).

(b) Ruston and Hornsby Ltd. Vs. The Zamindara Engineering Co.,

11. When infringement is not using the mark exactly on the register but something similar the test for infringement is the same as passing off and the learned counsel referred to the judgment of the Supreme Court in Ruston and Hornby Ltd.'s case (cited supra).

12. In the earlier suit, the issue was with regard to the franchise agreement, the place where the defendant carries on business is the situs. Hence it was instituted before the District Munsif Court. Whereas u/s 134 of the Trade Mark Act, in a suit for infringement and passing off, the place where the plaintiff has its business, that court has jurisdiction to try the suit. There was no forum shopping and the application of Order 2 Rule 2 CPC has no relevance.

13. Per contra, Mr. P.V. Balasubramaniam referred to a division bench judgment of this court in Shanmugavel Vs. Associated Publishers (Madras) Limited and Others, and referred to the following passages found in paragraphs 28 and 30, which reads as follows :

28.A case similar to the present one was considered by the Judicial Committee of the Privy Council in The Coca-Cola Co. of Canada, Ltd. Vs. Pepsi-Cola Co. of Canada, Ltd., 59 H.P.C. 127. The contention that the mark "Pepsi-cola" was an infringement of the registered trade mark Coca-Cola was negatived. Lord Russell of Killowen said:-

If it be viewed simply as a word mark consisting of "Coca" and "Cola" joined by a hyphen, and the fact be borne in mind that Cola is a word in common use in Canada in naming beverages, it is plain that the distinctive feature in this hyphen at word is the first word "Coca" and not "Cola". "Coca" rather than "Cola" is what would remain in the average memory. It is difficult, indeed impossible, to imagine that the mark "Pepsi-Cola" as used by the Defendant, in which the distinctive feature is, for the same reason, the first word "Pepsi" and not "Cola", would lead anyone to confuse it with the registered mark of the Plaintiff. It is viewed as a design mark, the same result follows. The only resemblance lies in the fact that both contain the word "Cola" and neither is written in block letters, but in script with flourishes; but the letters and flourishes in fact differ very considerably, notwithstanding the tendency of words written in script with flourishes to bear a general resemblance to each other. There is no need to specify the differences in detail; it is sufficient to say that, in their Lordships' opinion, the mark used by the Defendant, viewed as a pattern or picture, would not lead a person with an average recollection of the plaintiffs registered mark to confuse it with the pattern or picture represented by that mark.

30. In this case, we have already seen that the registered trade mark of the plaintiff is not a word mark but a design mark. The defendants mark "Trinity MAIL" is in no way similar to the plaintiffs mark. Hence, it follows that it is not deceptively similar to the plaintiff's mark as defined by Section 2(1)(d) of the Trade Marks Act. It is needless to add that our view is a prima facie one based on the materials now on record or rather lack of materials to prove that the defendant's mark will cause confusion. It is certainly open to the plaintiff to adduce evidence in the trial and prove its case.

14. He also referred to an another division bench judgment of this court in Bhanu Construction Co. Pvt. Ltd. and Others Vs. Andhra Bank and State Bank of India, , wherein the court had deprecated the practice of forum shopping. In that case, it was found that the parties have jointly or individually went before the Andhra Pradesh High Court and thereafter they have chosen to move this court. It was held that the forum shopping must be crushed with heavy hand.

15. He also referred to another judgment of the Delhi High Court in Rich Products Corporation and another Vs. Indo Nippon Foods Limited reported in 2007 (35)

PTC 15 (Del) for contending that there is no deceptive similarity. He lastly referred to a judgment of the Bombay High Court in Asian Paints Limited Vs. Home Solutions Retail (India) Limited reported in 2007 (35) PTC 697 (Bom), wherein the court found that the plaintiff cannot have an exclusive right over the generic term and descriptive of services.

16. In the light of the rival contentions, it has to be seen whether the applicant/plaintiff has made out any case for the grant of an injunction sought for. Apart from the fact that the applicant had moved the court in Kerala, in this case the applicant/plaintiff has not made out any prima facie case for either the infringement of trade mark or for passing off. The trade name and logo has clear distinction. In this case, the consumers are persons who are wanting to learn computer education. It is wrong to describe them as semi-literates or illiterates. Since both parties are imparting computer education and persons who seek for admission to the course run by both sides are literates and there will not be any confusion with reference to the name. Further, the two names are quite distinct and dissimilar. The question of any colour code or combination or stylistic writing do not appear to create any confusion in the mind of consumers, who are learning computer education. The balance of convenience is also not in favour for the grant of any interim order.

17. In the light of the above, O.A. Nos. 265 and 266 of 2012 will stand dismissed. A. Nos. 2202 and 2203 of 2012 will stand allowed. In view of the above, A. No. 1774 of 2012 appointing an Advocate Commissioner becomes irrelevant and that application will stand dismissed as infructuous.