

(2012) 06 DEL CK 0062
In the Delhi High Court
Case No : CS (OS) No. 1787 of 2012

A.P. Moller - Maersk A/S and Another	APPELLANT
Vs	
Maersk Mining and Exploration Private Limited	RESPONDENT

Date of Decision : 01-06-2012

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 39 Rule 3, 151
Trade Marks Act, 1999 — Section 2, 28, 29(4)

Citation : (2012) 06 DEL CK 0062

Hon'ble Judges : Manmohan Singh, J

Bench : Single Bench

Advocate : Anuradha Salhotra, with Mr. Sumit Wadhwa, for the Appellant;

Judgement

Manmohan Singh, J.

I.A. No. 11246/2012, I.A. No. 11247/2012 & I.A. No. 11248/2012 (u/S 151 CPC for exemption)

These applications have been filed by the plaintiffs u/s 151 of CPC, seeking exemption from filing the original, fair typed copies of the dim documents and documents in legal size and translated copies of the international registration certificates at this stage.

Heard. For the reasons stated in the applications, the same are allowed and eight weeks time is granted to file the same.

The applications are disposed of.

CS(OS) 1787/2012

Let the plaint be registered as a suit. Additional affidavit and documents are taken on record.

Issue summons to the defendant, on filing of process fee and registered AD cover within one week, returnable on 30.07.2012. I.A. No. 11245/2012 (u/O

1. Issue notice for the date fixed. In this application, the plaintiffs are seeking an injunction against the defendant from using the word MAERSK as part of its corporate name and trading style MAERSK MINING AND EXPLORATION PRIVATE LIMITED and also using MAERSK as a service mark in relation to its mining and exploration services u/s 29(4) of the Trade Marks Act, 1999 (hereinafter referred to as the Act). Learned counsel for the plaintiffs is pressing for an ex-parte ad-interim orders in view of facts stated in the plaint and documents placed on record.

2. The case of the plaintiffs is that the mark MAERSK forms essential feature of the plaintiff No. 1 corporate name and the corporate name of its subsidiaries. The earliest registrations for MAERSK is in Denmark dated 1955 in Classes 1 to 42. Now, the MAERSK mark is registered in Algerian Angola, Argentina, Australia, Azerbaijan, Bahamas, Bahrain, Bangladesh, Belarus, Bermuda, Bolivia, Brazil, Bulgaria, Burundi, Cambodia, Canada, Chile, China, Colombia, Croatia, Czech Republic, Democratic Republic of Congo, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, European Community, Finland, France, Gambia, Georgia, Germany, Ghana, Greece, Guatemala, Honduras, Hong Kong, Iceland, India, Indonesia, Iran, Ireland, Israel, Italy, Jamaica, Japan, Jordan, Kazakhstan, Kenya, Kuwait, Latvia, Lebanon, Liberia, Libya, Liechtenstein, Macau, Madagascar, Madrid Protocol, Malawi, Malaya, Malaysia, Mauritius, Mexico, Moldova, Monaco, Montenegro, Morocco, Mozambique, Namibia, Nepal, New Zealand, Nicaragua, Nigeria, Norway, Oman, Pakistan, Panama, Paraguay, Peru, Philippines, Portugal, Puerto Rico, Qatar, Republic of Korea, Russian Federation, Rwanda, Sabah, Sarawak, Saudi Arabia, Serbia, Sierra Leone, Singapore, Slovenia, South Africa, Sri Lanka, Sudan, Suriname, Sweden, Switzerland, Taiwan, Tanganyika, Trinidad & Tobago, Tunisia, Turkey, Turkmenistan, Uganda, Ukraine, United Arab Emirates, Uruguay, USA, Venezuela, Vietnam, Zambia, Zanzibar and Zimbabwe.

3. In India, the plaintiff No. 1 started its operations in the year 1989 when it established the plaintiff No. 2 and also had MAERSK registered in Class 12. In 2003, the plaintiff No. 1 received registration for MAERSK in Class 39. By virtue of these registrations the plaintiff No. 1 has a right to obtain relief in respect of infringement of the said trademark MAERSK.

4. u/s 29 (4) of the Act, a registered trademark is infringed by a person, who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is :

- a. identical with or similar to the registered trademark; and
- b. used in relation to goods or services which are not similar to those which the trademark is registered; and
- c. the registered trademark has a reputation in India and the use of the mark

without due cause takes unfair advantage of or is detrimental to the distinctive character or repute of the registered trademark.

5. The trademark being used by the defendant is identical to plaintiffs' trademark MAERSK. The plaintiffs' trademark MAERSK has a reputation in India and can be stated to be a well-known trade mark in respect of shipping services in India in accordance with Section 2(zg) of the Act for the following reasons :

a. It is used and registered in over 130 countries worldwide including India and has been in use since at least the year 1955.

b. It has a work force of 1,15,000 employees worldwide.

c. Worldwide sales in the year 2006 were 137,267 million Danish Kroner (Rs. 1.28 trillion approx. Sales in India at this time were in excess of Rs. 6 billion.)

d. The mark MAERSK is advertised world wide. Over Rs. 22 million were spent in advertising the mark in India alone in the year 2006.

e. In the year 2007, the MAERSK mark was valued at Euro 6.565 million (Rs. 453.613 million approx)

f. In the year 2011 the brand MAERSK was valued at US\$ 3250 million (Rs. 181.625 billion approx)

6. In India, in the year 2010-2010, the following awards have been won by the plaintiff No. 2 :

In June 2011, Maersk Line won the award for handling highest container traffic at Jawaharlal Nehru Port in the financial year 2010-11.

In January 2010, Maersk Line was awarded the "Best Performer" in Shipping Line category for its outstanding contribution and performance.

Maersk Line won three awards in the "Best Performance by A Shipping Line" at ICD Sabarmati, Ahmedabad, RCT Vadodara, Pipavav at the 14th CONCOR North-West Region Awards.

Maersk Line won the award for the category "Best Mainline Operator" at the South East CEO Conclave and Awards.

Maersk Line won the "Best Container Liner of the Year" Award at the "Annual Indian Maritime Gateway Awards 2010".

Maersk Line won an award for "best integration of sustainability in company strategy" during the 2011 Corporate Social responsibility Awards hosted by the Danish "CSR foundation".

7. The defendant adopted the mark MAERSK in the year 2006. The plaintiffs' trademark was already well-known on this date. Defendant states that MAERSK was adopted from the name MAEHNDRA and the name RASIKA, which are claimed to be the names of the brother and sister of the promoter of the

defendant. Such an explanation was not found to be good in the case of Rolex Sa Vs. Alex Jewellery Pvt. Ltd. and Others, where it was claimed that ROLEX was adopted from the name ALEX and Rolled Gold and an interim order was passed.

8. As per the case of the plaintiffs, the plaintiffs became aware of the use of the mark MAERSK by the defendant in February 2011, while going through the records of the website of Registrar of Companies, www.mca.gov.in.

9. Thereafter, the plaintiffs through attorney issued the Cease & Desist letter dated 10.02.2011 on its registered address in Mumbai but, the same was returned with a note that the defendant is not available at the given address and has shifted. The defendant has not responded to the letters sent to its Directors as well as its head office in Indore. It is alleged that the defendant has no website and is not present on the internet. The plaintiffs have not come across any advertisement or other publicity of their services and accidentally became aware while going through the records of the Registrar of Companies in the year 2011. The only letterhead of the defendant showing use of the MAERSK mark on page 265 of the documents has also been obtained from the site of the Registrar of Companies.

10. Therefore, prima facie it appears that all the requirements of Section 29(4) of the Act stand satisfied. In the case of Ford Motor Company of Canada Limited and Another Vs. Ford Service Centre, this Court has held that the use of a well known trademark as a corporate name and trading style also is an infringement of trademark.

11. It is well established law that in a case for infringement of trademark and exclusive and statutory rights of infringement of trademark cannot be defeated in case there is any delay on the part of the plaintiffs bringing the action before the Court.

12. The learned counsel for the plaintiffs has argued that the question of delay in bringing the action does not arise, as the present suit is a case of infringement of trade mark where the plaintiffs have got exclusive right u/s 28 of the Act and every infringement gives fresh cause of action. He further argued that since the conduct of the defendant is dishonest, therefore, the plaintiffs are entitled to injunction despite delay, if any, in bringing the action. He has referred to the recent decision of the Supreme Court in the case of Midas Hygiene Industries P. Ltd. and Another Vs. Sudhir Bhatia and Others, . Relevant para of the said judgment reads as under:

5. The law on the subject is well settled. In cases of infringement either of Trade Mark or of Copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the Mark was itself dishonest.

13. In the case of Swaran Singh Vs. Usha Industries (India) and Another, it was

observed :

(7) There is then the question of delay. Learned counsel for the respondents had urged that the delay is fatal to the grant of an injunction. We are not so satisfied. A delay in the matter of seeking an injunction may be a ground for refusing an injunction in certain circumstances. In the present case, we are dealing with a statutory right based on the provisions of the Trade and Merchandise Marks Act, 1958. An exclusive right is granted by the registration to the holder of a registered trade mark. We do not think statutory rights can be lost by delay. The effect of a registered mark is so clearly defined in the statute as to be not capable of being misunderstood. Even if there is some delay, the exclusive right cannot be lost. The registered mark cannot be reduced to a nullity. The principles governing other types of injunctions are not to be readily applied to a case like the present. Of course, if it was a case of a similar mark as opposed to the same mark, the concurrent user coupled with delay might be a ground for refusing an injunction. However, when the same mark is being used, in a sense, the public is deceived into purchasing the defendant's goods on the belief that they are the plaintiff's goods, so a registered trade mark is a casualty, it is the duty of the Court to protect the registered mark. That is the whole concept of registration. So, we cannot refuse an injunction even if there is some delay especially when the mark is the same. To refuse the injunction would tantamount to permit a fraud being practiced on unwary customers. This is a matter of principle on which the Court cannot refuse the injunction.

14. In view of the above, it is prima facie clear that the adoption of the mark is not honest, thus, a strong case for grant of interim injunction is made out. In view of facts stated in the plaint and documents placed on record, I am of the view that balance of convenience also lies in favour of the plaintiffs and against the defendant. In case, the defendant is allowed to use the mark MAERSK in relation to its business, the plaintiffs will suffer irreparable loss and business. Therefore, the defendant is restrained from using the word MAERSK as part of its corporate name and trading style MAERSK MINING AND EXPLORATION PRIVATE LIMITED and also using MAERSK as a service mark in relation to its mining and exploration services.

15. The defendant is granted three weeks time from the date of service of interim order to change or amend the name of its corporate name by deleting the mark MAERSK.

16. Compliance of Order XXXIX Rule 3 CPC be made within seven days. Dasti.