
(2023) 04 DEL CK 0011

In the Delhi High Court

Case No : Civil Suit (COMM) No. 573 Of 2022, I.A. No. 20805 Of 2022

Eduspark International Private Limited

APPELLANT

Vs

Laxmi Publications Private Limited

RESPONDENT

Date of Decision : 10-04-2023

Acts Referred:

Code Of Civil Procedure, 1908 — Order 39 Rule 1, Order 39 Rule 2, Order 39 Rule 2A

Citation : (2023) 04 DEL CK 0011

Hon'ble Judges : Amit Bansal, J

Bench : Single Bench

Advocate : Anju Agrawal, Bikash, Rahul Maratha, Peeyoosh Kalra, Gaurav Kochhar

Judgement

Amit Bansal, J

I.A. 16497/2022 (O-XXXIX R-2A of the CPC)

1. The present application has been filed on behalf of the plaintiff under the provisions of Order XXXIX Rule 2A of the Code of Civil Procedure, 1908 (CPC) against the defendant and its employees for having violated the interim order dated 23rd August, 2022 passed by this Court.

2. It has been submitted on behalf of the plaintiff that despite the interim order passed by this Court on 23rd August, 2022, the books of the defendant bearing the infringing "VIBGYOR" trademarks were still available on third-party websites such as Amazon.in, BuyBooksIndia.com and the like.

3. Counsel for the alleged contemnors submits that immediately upon passing of the interim order by this Court, on 29th August, 2022, the defendant had written emails to its various offices all over India to discontinue selling books bearing the mark "VIBGYOR".

4. I have heard the counsels for the parties.

5. It is an admitted position that as on date, there is no violation of the interim

order dated 23rd August, 2022. Yet, on the basis of the material on record, it cannot be denied that there was delay on the part of the defendant in communicating to the various third-party websites where the books of the defendant were sold, to discontinue selling books under the mark "VIBGYOR". However, during the course of the hearing on 2nd March, 2023, submission of the counsel for the defendant was recorded that the defendant is willing to file an unconditional apology. Affidavits have been filed on behalf of two of the directors as well as the authorized representative of the defendant, tendering an unconditional and unqualified apology to the Court and undertaking not to indulge in any activity that may amount to breach of the orders passed by the Court.

6. In the facts and circumstances of the case, the aforesaid apology is found satisfactory and is therefore, accepted by the Court.

7. In view thereof, no orders are required to be passed on this application, which stands disposed of as such.

I.A. 13138/2022 (O-XXXIX R-1 & 2 of the CPC)

8. The present suit has been filed seeking relief of permanent injunction restraining the defendant from infringing the trademark of the plaintiff, passing off their goods as that of the plaintiff and other ancillary reliefs.

9. Along with the plaint, the plaintiff also filed the present application for grant of interim injunction under Order XXXIX Rules 1 and 2 of the CPC. While issuing summons in the suit on 23rd August, 2022, this Court had granted an ad interim injunction in favour of the plaintiff restraining the defendant from selling products/goods with the trademark "VIBGYOR".

CASE SET UP IN THE PLAINT

10. Briefly stated, the case set-up in the plaint is as under:

10.1. The plaintiff manages schools under the trademark "VIBGYOR". The predecessor of the plaintiff, M/s. Kare Edumin Pvt. Ltd. [hereinafter "Kare Edumin"], set up the first "VIBGYOR" School in the year 2004 in Mumbai.

10.2. Vide order dated 27th April, 2017 passed by the National Company Law Tribunal, Mumbai Bench, a scheme of amalgamation between Kare Edumin and the plaintiff was sanctioned, whereby all properties and assets, including trademarks of Kare Edumin, were transferred to the plaintiff with effect from 1st June, 2017.

10.3. As on date, the plaintiff manages 39 schools all over India under the trademark "VIBGYOR". The plaintiff publishes its own books for its students under the trademark "VIBGYOR".

10.4. The plaintiff has received various awards and accolades from time to time, which are detailed in paragraph 11 of the plaint.

10.5. The plaintiff is the registered proprietor of various trademarks under the name of "VIBGYOR" and its formative marks in classes 16 and 41, the details whereof are given in paragraph 12 of the plaint. The plaintiff has been the registered proprietor of the word mark "VIBGYOR" under class 41 with effect from 16th January, 2012. Plaintiff has filed along with the suit the Legal Proceedings Certificates (LPC) in respect of some of the registered trademarks.

10.6. The plaintiff has given details of its annual sales and advertisements expenses from the year 2008–2009 till 2020–2021 along with the CA certificate.

10.7. In March, 2022, the plaintiff came to know that one Mr. Saurabh Gupta, director of the defendant company, had filed Oppositions on 22nd January, 2020 to the plaintiff's trademark applications in class 41. This was when the plaintiff became aware of the defendant using the mark "VIBGYOR".

10.8. In May, 2022, the plaintiff came to know that the defendant has filed registrations in classes 16 and 41 in respect of the mark "VIBGYOR". The aforesaid applications have been opposed by the plaintiff.

11. Accordingly, the present suit has been filed on behalf of the plaintiff.

CASE SET UP IN THE WRITTEN STATEMENT

12. The case set up by the defendant in the written statement is as under:

12.1. The defendant has been in the field of publishing books since 1974. The plaintiff is only involved in the business of running schools, whereas the defendant is in the business of publishing and distribution of books.

12.2. The word "VIBGYOR" is a generic word and the plaintiff cannot claim exclusive rights in the same.

12.3. Plaintiff cannot claim rights in mark "VIBGYOR" on the basis of its amalgamation with Kare Edumin.

SUBMISSIONS ADVANCED ON BEHALF OF THE PARTIES

13. Counsel for the plaintiff made the following submissions:

13.1. The earlier registration of the plaintiff in class 16, of the device mark using the word "VIBGYOR", dates back to 18th July, 2006. In the LPC dated 1st July, 2022 filed by the plaintiff, under 'history data', it has been noted that the mark was originally registered in the name of Kare Edumin and subsequently, the plaintiff company was recorded as the proprietor of the said mark in 2018.

13.2. There is no registration granted in favour of the defendant for any of the device marks with the word "VIBGYOR".

13.3. No details have been given by the defendant with regard to use of the aforesaid trademark, nor have any documents been filed in this regard.

13.4. In the notice of opposition filed by the defendant against the trademark

application filed by the plaintiff, it has falsely been stated that the trademark "VIBGYOR (LOGO)" is registered in the name of the defendant.

13.5. In the Notice of Opposition, the defendant has stated that the plaintiff is using the trademark "VIBGYOR RISE (LABEL)" in relation to allied goods. Therefore, now, the defendant cannot contend that the goods of the defendant and the plaintiff are not similar as this would amount to approbation and reprobation.

14. Per contra, the counsel for the defendant made the following submissions:

14.1. Defendant has been in the business of selling books using the trademark "VIBGYOR" since the year 2013.

14.2. The user of the plaintiff is only from the year 2018 and the plaintiff cannot claim the benefit of the prior user by Kare Edumin.

14.3. The products of the defendant, in respect of which it uses the trademark "VIBGYOR", is different from that of the plaintiff. The plaintiff only has a registration of the word mark "VIBGYOR" in class 41 and on the basis of the aforesaid registration, the plaintiff cannot attempt to restrain the defendant from using the mark "VIBGYOR" in respect of its books in class 16.

ANALYSIS AND FINDINGS

15. Plaintiff has a total of 28 registrations in class 16 with the word "VIBGYOR". The earliest registration of the device mark of the plaintiff with the word "VIBGYOR" in class 16 is of 18th July, 2006. The plaintiff is also the registered proprietor of the word mark "VIBGYOR" in Class 41 with effect from 16th January, 2012. Counsel for the plaintiff has pointed out that in the Notice of Opposition filed by the defendant against the trademark registration application of the plaintiff under class 41, it has falsely been stated that the trademark "VIBGYOR (LOGO)" is registered in the name of the defendant. This submission has not been controverted by the counsel for the defendant. It is also clear from the record that there is no registration in favour of the defendant of the mark "VIBGYOR". Therefore, the aforesaid assertion of the defendant appears to be false.

16. It is not in dispute that the word mark "VIBGYOR" has been registered in favour of the plaintiff in class 41 since 16th January, 2012. Even in respect of the device marks, the prominent feature of the marks of plaintiff and defendant is the word "VIBGYOR". Therefore, there is a deceptive similarity between the mark used by the defendant with the registered mark of the plaintiff. In all the notices of opposition filed on behalf of the defendant to the trademark registration application of the plaintiff in respect of the label mark with the word "VIBGYOR" the defendant has stated that the plaintiff's trademark "VIBGYOR RISE (LABEL)" is a mere copy of the defendant's trademark and has therefore, admitted to the similarity between the competing marks. The fact that the defendant itself has applied for registration of a device mark with the word "VIBGYOR" also

demolishes the submission of the defendant that the mark "VIBGYOR" is a generic word and that the plaintiff cannot claim exclusive right in the same.

17. The counsel for the defendant also contended that the products of the defendant for which the defendant uses the trademark "VIBGYOR" are different from those of the plaintiff. In this regard, attention of the Court has been drawn to the Notice of Opposition filed by the defendant (page 506 of the documents filed by the plaintiff), the relevant extracts of which are given below:

"2. The Opponent has adopted the trademark VIBGYOR (LOGO) in the year 2013 in Hindi and English both and is still stands registered, the trademarks to differentiate its products from that of others.

xxx xxx xxx

6. The Applicant's trademark "VIBGYOR RISE (LABEL)" now applied for is in respect of the allied same goods for which the Opponent is having Proprietary right. The trademark applied for is prohibited from being registered under the Act, the mark being deceptive. The Applicant's mark should not be allowed to be registered as it will create confusion in the market of educational field."

18. Similar stand has also been taken in the notice of opposition filed at page 522 of the documents of the plaintiff.

19. It has clearly been admitted by the defendant that goods of the plaintiff and the defendant are allied goods. Therefore, now the defendant cannot be allowed to take a contrary stand to the effect that the goods of the plaintiff and the defendant are different. The defendant cannot be permitted to approbate and reprobate.

20. Counsel for the plaintiff has correctly placed reliance on the judgment of a Coordinate Bench of this Court in Anchor Health and Beauty Care Pvt. Ltd. v. Procter & Gamble Manufacturing (Tianjin) Co. Ltd. and Ors., MANU/DE/1156/2014, wherein it was held that where the defendants themselves have applied for registration of a mark, they cannot take a contrary stand that the aforesaid mark is descriptive. The defendant cannot be permitted to approbate and reprobate. In the present case also, once the defendant in the Notice of Opposition has taken a stand that the goods of the plaintiff and defendant are similar or allied, they cannot now be permitted to take a stand that the goods of the plaintiff and the defendant are different.

21. Counsel for the defendant has relied upon the judgement of the Supreme Court of India in Nandhini Deluxe v. Karnataka Co-Operative Milk Producers Federation Ltd., MANU/SC/0779/2018, in support of his contention that the "VIBGYOR" mark is being used in relation to different products. However, this judgement would not come to the aid of the defendant in view of the stand taken by the defendant that the goods of the plaintiff and the defendant are similar and allied. Further, in the present case, there is a similarity between the goods/services of the plaintiff and the defendant, inasmuch as the plaintiff uses the

aforesaid mark in relation to education and educational services, including books to be used in the schools, whereas the defendant uses it in relation to books in the field of education. Therefore, it cannot be said that there is no similarity between the two.

22. It has been further contended on behalf of the defendant that the plaintiff has not filed proof of user of the aforesaid trademark in support of books. Even if that be so, the remedy of the defendant would be to seek rectification of the mark on the ground of non-user. Reference in this regard may be made to the judgment of a Coordinate Bench of this Court in *Vintage Distillers Limited v. Ramesh Chand Parekh*, MANU/DE/4587/2022, wherein it was held that a plaintiff, being the registered proprietor of the mark, had an exclusive right to use the same and the right to sue for infringement was not dependent on the use of the mark by such registered proprietor.

23. Though the defendant claims to be using the "VIBGYOR" mark since the year 2013, no details have been given by the defendant with regard to the use of the aforesaid mark. It may be relevant here to mention that no documents have been filed on behalf of the defendant in support of this assertion.

24. The contention of the defendant that the plaintiff cannot claim benefit of prior user by the predecessor of the plaintiff, is completely misplaced. In this regard, reference may be made to relevant portion of the 'history data' of the LPC dated 31st October, 2022 for the Trademark No.2266974, which is as under:

"PURSUANT TO A REQUEST ON FORM TM-P DATED 15/01/2018 AND ORDER THEREON DATED 22/03/2018 EDUSPARK INTERNATIONAL PRIVATE LIMITED. HAS BEEN BROUGHT ON RECORD AS SUBSEQUENT PROPRIETOR IN RESPECT OF THE SAID REGISTERED TRADE MARK "BY VIDE ORDER PASSED BY THE NATIONAL COMPANY LAW TRIBUNAL, MUMBAI BENCH, ON APRIL 27, 2017 IN COMPANY SCHEME PETITION NOS. 46 AND 47 OF 2017 WITH EFFECT FROM JUNE 1, 2017 AN AFFIDAVIT OF PARESH A. BHATELIA.

REGISTRATION RENEWED FOR A PERIOD OF 10 YEARS FROM 16/01/2022 ADVERTISED IN JOURNAL NO.2037"

25. A perusal of the LPC dated 31st October, 2022 issued in favour of the plaintiff shows that the mark was initially registered in favour of the predecessor of the plaintiff, Kare Edumin, which had been using the mark "VIBGYOR" in relation to its services since the year 2006. In terms of the scheme of amalgamation approved by the NCLT on 27th April, 2017, various properties/assets, including trademarks of Kare Edumin were transferred to the plaintiff. Taking into account the aforesaid, the Registrar has recorded the plaintiff as the proprietor of the "VIBGYOR" mark with effect from 16th January, 2012. Therefore, there is no merit in the submission of the defendant that the plaintiff cannot claim the benefit of prior user.

26. In view of the findings above, a prima facie case is made out on behalf of the

plaintiff. The balance of convenience is in favour of the plaintiff and against the defendant. Irreparable injury would be caused to the plaintiff if the defendant is allowed to use the impugned mark.

27. Accordingly, the present application is allowed and the order dated 23rd August, 2022 granting interim injunction in favour of the plaintiff is confirmed till the final adjudication of the suit.

28. Needless to state, any observations made herein are for the purposes of adjudication of the present application and shall not have a bearing on the final outcome of the suit.

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29. List before the Joint Registrar on 12th July, 2023.