

(2017) 12 DEL CK 0090

In the Delhi High Court

Case No : Civil Suit (COMM) No. 1055 Of 2016

Harjeet Singh

APPELLANT

Vs

Satish R Nathani & Ors

RESPONDENT

Date of Decision : 04-12-2017

Acts Referred:

Citation : (2017) 12 DEL CK 0090

Hon'ble Judges : Jayant Nath, J

Bench : Single Bench

Advocate : Mohan Vidhani, Shish Singh, Madan Mohan

Final Decision : Disposed Of

Judgement

Jayant Nath, J

1. This suit is filed by the plaintiff seeking a decree of permanent injunction to restrain the defendants, etc. from manufacturing, selling, offering for sale or dealing in shirts and readymade garments, etc. under the trade mark/label POLICE GUY'S or any other mark identical or deceptively similar to the plaintiff's second trade mark GUY'S DANG. Other connected reliefs are also sought regarding the two trademarks/label POLICE GUY'S and GUY'S DANG.

2. On 15.09.2014, this court noted that the defendants are served. It also noted that learned counsel appearing for defendant No.3 was ready to give an undertaking not to use the trade mark in question in future provided the plaintiff would not press for costs, damages and rendition of accounts. Learned counsel appearing for the plaintiff left the issue to the court. This court then directed defendant No.3 to give an undertaking to be filed within four weeks from that date and also directed that the plaintiff would not press for damages and costs under these circumstances. Defendant No. 3 has filed an undertaking on 02.02.2015. Hence, the suit does not survive against defendant No.3.

3. As far as the other two defendants are concerned, namely, defendants No. 1

and 2, this court on 21.08.2017 proceeded ex parte against them. The said defendants have neither entered appearance nor have they filed their written statement.

4. In the plaint, it is pleaded by the plaintiff that he is the owner being subsequent proprietor of the distinctive trade mark and label POLICE GUY'S in respect of clothing and headgear which trade mark and label are in use since 15.03.2005. The said trade mark/label was initially adopted by the predecessor of the plaintiff, namely, Mr. Trilochan Singh in the year 2005. The predecessor had filed an application for registration of the said trade mark in Class 25 in respect of clothing and headgear. The said application is pending on account of opposition from a third party which is being contested by the plaintiff. The predecessor of the plaintiff assigned the said trade mark in favour of the plaintiff by virtue of an Assignment Deed dated 15.12.2011. Thereafter, the plaintiff has used the trade mark. A request to bring on record the plaintiff as a subsequent proprietor of the said application has also been filed with the office of Registry of Trade Marks. It is also pleaded that the predecessor of the plaintiff also registered the trade mark GUY'S DANG (Label) dated 24.05.2006. The said registration was valid up to 24.05.2016. The said trade mark was also assigned in favour of the plaintiff by virtue of an Assignment Deed dated 02.04.2012. The application for registering the plaintiff as a subsequent proprietor has also been accepted by the Registry of Trade Marks.

5. It is further pleaded that the plaintiff has filed applications for registration of the trademarks POLICE GUY'S (words), POLICE SPORT, POLICE GOLD, LIMITED GUY'S and PETER JEANS. The applications are said to be pending. It is also pleaded that the plaintiff is the owner and proprietor of the registered trademarks in Thailand, namely, POLICE GUY'S (Label), POLICE JEANS GUY'S , etc. as detailed in the plaint.

6. Hence, it is the case of the plaintiff that the trademarks have acquired distinctive character and are capable of distinguishing goods sold and manufactured by the plaintiff. The plaintiff is also said to be the owner of the copyright and artistic labels of the marks mentioned and is the registered owner of the copyright in the label. Hence, it is pleaded that the plaintiff has the sole and exclusive right to use the said trade marks/label/trade dress, etc. Reliance is also placed on various suits filed by the plaintiff which are pending adjudication where interim orders have been passed in favour of the plaintiff.

7. It is pleaded that sometimes in the third week of July 2014, the plaintiff came to know that defendant No.1 and 2 are manufacturing and marketing goods being readymade garments under the identical trade mark POLICE GUY'S written in identical manner with identical colour scheme as that of the plaintiff. Defendants No. 1 and 2 are said to be marketing, selling their goods in Delhi through defendant No.3. It is also stated that the defendants have taken the words GUY'S in the impugned trade mark/label which is a part of the registered trade mark of the plaintiff as detailed above and infringed the trade mark GUY'S

DANG (Label). Hence, the present suit.

8. The plaintiff has filed the evidence of PW-1/Sh.Trilochan Singh who reiterated the submissions as stated in the plaint. He has exhibited the assignment deed dated 15.12.2011 as EX.PW-1/2 and supplementary assignment deed as Ex.PW-1/3. Copies of the applications filed before the Trade marks Registry have been exhibited as PW-1/9 to PW-1/12. The copies of the trade mark registration certificates of the plaintiff in Thailand with their English translation are exhibited as Ex.PW-1/13 to PW-1/22.

9. Even otherwise, the defendants No. 1 and 2 have not filed any written statement. The pleas of the plaintiff are uncontested.

10. The Supreme Court in the case of S.Syed Mohideen vs. P. Sulochana Bai, (2016) 2 SCC 683 on the issue of passing off noted as follows:-

"31.1 Traditionally, passing off in common law is considered to be a right for protection of goodwill in the business against misrepresentation caused in the course of trade and for prevention of resultant damage on account of the said misrepresentation. The three ingredients of passing off are goodwill, misrepresentation and damage. These ingredients are considered to be classical trinity under the law of passing off as per the speech of Lord Oliver laid down in the case of Reckitt & Colman Products Ltd. v. Borden Inc: (1990) 1 All E.R. 873 which is more popularly known as "Jif Lemon" case wherein the Lord Oliver reduced the five guidelines laid out by Lord Diplock in Erven Warnink v. Townend & Sons Ltd. [1979] AC 731, 742 (HL)] (the "Advocate Case") to three elements: (1) Goodwill owned by a trader, (2) Misrepresentation and (3) Damage to goodwill. Thus, the passing off action is essentially an action in deceit where the common law rule is that no person is entitled to carry on his or her business on pretext that the said business is of that of another. This Court has given its imprimatur to the above principle in the case of Laxmikant V. Patel v. Chetanbhat Shah and Anr.: 2002 (2) R.C.R. (Civil) 357 : (2002) 3 SCC 65."

11. It is quite clear that on account of a prior user of the trade mark POLICE GUY'S and the goodwill generated by the plaintiff on account of extensive user, the plaintiff has common law rights in the said trade mark. The action of defendants No.1 and 2 in trying to sell garments, cloth, etc. using the said trade mark is clearly in violation of the rights of the plaintiff. Similarly, the trade mark GUY'S DANG is a registered trade mark and violation of the said trade mark by defendants No. 1 and 2 is in breach of the statutory rights.

12. Accordingly, the suit is decreed in favour of the plaintiff and against defendants No. 1 and 2 in terms of prayer 25(a), (b) and (c) of the plaint. The plaintiff shall also be entitled to costs.

13. The suit stands disposed of.