

(2014) 05 DEL CK 0326
In the Delhi High Court
Case No : CS (OS) 1120/2012

Jane Norman Limited

APPELLANT

Vs

Jane Norman Retail Pvt. Ltd. and Others

RESPONDENT

Date of Decision : 15-05-2014

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 23 Rule 1, Order 23 Rule 3, Order 39 Rule 1, Order 39 Rule 2

Citation : (2014) 05 DEL CK 0326

Hon'ble Judges : G.S. Sistani, J

Bench : Single Bench

Advocate : Pritish Kapur, Mr. Sahil Yadav and Ms. Sukriti, Advocate for the Appellant

Judgement

G.S. Sistani, J.—Plaintiff has filed the present suit for permanent injunction restraining trade mark and copyright infringement, passing off, dilution, acts of unfair competition, damages/rendition of accounts, freezing of assets, delivery up etc.

2. Summons in the suit and notice in the application under Order XXXIX Rules 1 and 2 were issued on 24.04.2012 when an ex parte ad interim injunction was granted in favour of the plaintiff and against the defendants thereby restraining them from using the trade mark JANE NORMAN in relation to goods which fall in class 14,18, 25 and 35 including clothing, readymade garments, handbags, footwear and other accessories in which the plaintiff is holding registration and also from using the domain name www.janenorman.in and the mark JANE NORMAN as part of their corporate name to pass off their business as that of the plaintiff directly or indirectly.

3. On the next date of hearing, i.e. 22.05.2012, counsel for defendants no. 8 and 9 entered appearance and sought time to file written statement; defendants no. 5 to 7, 10 and 11 were unserved; and since none appeared on behalf of defendants no. 1 to 4 despite service, they were proceeded ex parte. Vide order

dated 22.08.2012 written statement on behalf of defendant no. 8 was taken on record and further time was granted to defendant no. 9 to file his written statement; and fresh summons were directed to be issued to defendants no. 5 to 7 and 10 and 11. Vide order dated 10.04.2013, on an application made by counsel for the plaintiff to abandon its claim against defendants no. 5 to 7 and 10 and 11, the suit qua defendants no. 5 to 7 and 10 and 11 stood dismissed as withdrawn. Vide order dated 04.07.2013, on a joint application filed by plaintiff and defendant no. 8, under Order XXIII Rule 3, which was taken on record, the suit was disposed of qua defendant no. 8 in terms of the settlement arrived at between the plaintiff and defendant no. 8 as set out in paras 1-11 of the application I.A. no. 3779/2013. Similarly, vide order dated 24.01.2014, on an application made by the plaintiff under Order 23 Rule 1, CPC seeking leave to unconditionally withdraw the suit against defendant no. 9, the suit was dismissed qua defendant no. 9. Ex parte evidence of plaintiff was completed on 23.04.2014.

4. Plaintiff has filed affidavit by way of evidence of Mr. Sharad Misra, PW-1, the Constituted Attorney for the plaintiff. PW-1 in his affidavit by way of evidence has deposed that the Plaintiff is an internationally renowned manufacturer and seller of women's clothes, handbags, footwear and other accessories. PW-1 has further deposed that the Plaintiff trades in several countries around the world using the trade name Jane Norman, and the trade marks Jane Norman and (the "Jane Norman Marks").

5. Mr. Sharad Misra, PW-1 has further deposed that the plaintiff has been using the trade name and trade mark Jane Norman continuously since 1952 and that the Jane Norman Marks are instantly recognisable to millions of consumers around the world. It has further been deposed that as the Plaintiff operates stores in prominent locations in major global cities, even individuals not very familiar with fashion brands are acquainted with the Jane Norman Marks and are aware of their reputation. The Plaintiff has registered the Jane Norman Marks in over 50 countries, including the United States of America, all the member-states of the European Union, Switzerland, Russia, China, New Zealand, Kuwait, Saudi Arabia, Oman, Qatar and Turkey. Copies of trademark registration certificates from around the world have been filed and marked as Ex. PW 1/3 Further, a list of worldwide registrations of the Jane Norman Marks duly attested by a notary public is being filed along with this plaint and marked as Ex. PW 1/4 PW-1 has also deposed that in India, the Plaintiffs business predecessor, Jane Norman (Holdings) Limited, applied for the registration of the Jane Norman Mark in November 2006 in classes 14, 18, 25 and 35 and in June, 2007 in class 9 (collectively covering a range of goods and services, including clothing and retail services). Registrations were granted in March 2009 under Registration No. 1509298 and in September 2013 under Registration No. 1572679. A copy of the Plaintiffs trade mark registration certificate in India (in classes 14, 18, 25 and 35) is being filed with this affidavit and marked as Ex. PW 1/5.

6. PW-1 has further gone on to depose that although the Plaintiff does not

directly sell its products in India, it has exported products bearing the Jane Norman Marks to India. In this regard, several individuals and companies in India have inquired and expressed interest about the Plaintiffs products and the plaintiffs enormous global reputation and goodwill has also spilled across into India through several other channels, including the internet, television, and various newspapers and magazines. Furthermore, the Plaintiffs website (www.janenorman.co.uk) is accessible to, and is regularly accessed by, internet users in India. It has further been deposed that between March 2011 and March 2012, the Plaintiffs website has registered over 18,000 visits from all over India and that India ranks 22 amongst all the countries from where internet users have visited the Plaintiffs website. Statistics detailing the number of visits by internet users in India to the Plaintiffs website are being filed with this affidavit and marked as Exhibit PW 1/6 PW-1 has further deposed that Indian visitors to nations where the Plaintiff sells its products have also contributed in spreading awareness about the Plaintiff in India and that Indian nationals represent a significant number of overseas visitors who have purchased the Plaintiffs products from its stores in the United Kingdom. He has next deposed that the JANE NORMAN Marks (which have been used uninterruptedly since 1952), are thus instantly recognisable to a large section of the Indian public, and can be described as "well-known trade marks" under the Trademarks Act, 1999.

7. PW-1 has further deposed that The Jane Norman Marks are especially recognisable to the public because of their conspicuous use on the Plaintiffs store fronts and product labels. For the above reasons, a tremendous amount of goodwill in India is attached to the Jane Norman Marks and a large number of Indian consumers instantly and directly associate the Plaintiffs business conducted under the Jane Norman Marks, trading name and get up with the plaintiff. Some instances of global advertising/publicity material in relation to the Jane Norman Mark are being filed along with this affidavit and marked as Ex. PW 1/7.

8. PW-1 has further deposed that in addition to the foregoing, the Plaintiffs mark can be regarded as an original artistic work under the Indian Copyright Act of 1957 and hence, deserves protection.

9. Mr. Sharad Misra, PW-1 has also deposed that the Plaintiff operates the website www.janenorman.co.uk which is extremely popular and is visited by thousands of users from around the world, including India, every month. The website hosts a section titled "Contact Us", which allows visitors to make general enquiries from the Plaintiff. These enquiries are directed to the email address webenquiries@janenorman.co.uk, which is operated by the Plaintiff. PW-1 has further deposed that on March 19, 2011, the Plaintiff received an enquiry through the "Contact us" section from one Mr. Puneet Agarwal, who appears to be a resident of India and Mr. Agarwal informed the Plaintiff of the existence of the Defendant No. 1. Mr. Agarwal wrote that the Defendant No. 1 had told him that it had entered into a joint venture with the Plaintiff, and that it was the

exclusive licensee of the Plaintiff in India. In his enquiry to the Plaintiff, Mr. Agarwal asked whether these claims were true. PW-1 has deposed that these alleged claims are completely untrue and fraudulent and that the Plaintiff does not directly retail its products in India and further that the Plaintiff has no relationship whatsoever with the Defendant No. 1. The Plaintiff has never entered into any agreement with the Defendant No. 1 or any of its agents and representatives. A copy of the message sent by Mr. Agarwal has been filed and marked as Ex. PW 1/8.

10. It has further been deposed by PW-1 that an investigation on receipt of this alarming notice from Mr. Agarwal was conducted by Plaintiffs representatives in India and the investigation report indicated that Defendant No. 1 was a registered company, incorporated on 21 April, 2010, under the Indian Companies Act. A copy of the Certificate of Incorporation, available on Ministry of Corporate Affairs website has been filed and marked as EX. PW 1/9. The investigation further revealed that there are three outlets of Defendant No. 1 at Rajouri Garden, Janakpuri District Center and the head office at Mansarovar Garden. Photographs of the above mentioned stores, merchandise, store fronts, product labels, signboards and invoices have been filed and marked as EX. PW 1/10.

11. PW-1 has next deposed that it was discovered that Defendant No. 1 also operates the website www.janenorman.in. A screen shot of the home page of the website has been filed and marked as EX. PW 1/11. Additionally, when searching for the term "Jane Norman" (without quotes) on Google India, this website shows up prominently as the second search result. The website clearly represents that Defendant No. 1 is a retailer of men's and women's clothing and lists the stores operated by Defendant No. 1 along with the address of the head office and solicits prospective franchisees. Photographs of female and male models, including Caucasian models, wearing assorted clothes are displayed on this website. Screenshots of the website as described above have been filed and marked as EX. PW 1/12. Screenshots of the search result on Google India (mentioned above) have also been filed and marked as EX. PW 1/13.

12. PW-1 has further deposed that the Defendant No. 4 is the Retail Head of Defendant No. 1 and Defendant No. 4's business card that prominently reads "Jane Norman Fashion from London" and "Jane Norman Retail Private Limited" was also discovered during the investigation. A copy of the business card has been filed and marked as EX. PW 1/14. This business card also contains the address of the head office of Defendant No. 1 along with the website address www.janenorman.in.

13. On further investigation, it was revealed that besides the stores in Delhi, several franchisees of Defendant No. 1 also use the Plaintiffs mark on their stores located outside New Delhi. Details of these franchisees are also available on the Defendant's No. 1 website. A screenshot of the Defendant No. 1's website, listing the above mentioned stores has been filed and marked as EX. PW 1/15.

14. It has further been deposed by PW-1 that on September 6, 2010, Defendant No. 1 had filed an application, Application No. 2019112 at the Trade Marks Office under class 25 for women's clothes, hosiery and other kinds of garments. The application presently stands objected at the Registry. The Registrar has rightfully cited two marks, one being the Plaintiffs registration, against the registration of this application on the ground of likelihood of confusion and the other being the subject mark itself. A copy of the extract from the online records of the Trade Mark Registry has been filed and is marked as EX. PW 1/16 A copy of the examination report issued by the Registry addressing the objections raised is filed and marked as EX. PW 1/17.

15. PW-1 further goes on to depose that defendant No. 1 has fraudulently, wrongfully and brazenly misrepresented to the Indian public that it is a licensee/franchisee of the Plaintiff in India, and/or has a bona fide commercial relationship with the Plaintiff. PW-1 has further deposed that sometime in December, 2011 the Plaintiff had received a letter from the High Commission of India in London informing the Plaintiff about one such tortuous act of Defendant No. 1 and Defendant No. 2, wherein they fraudulently misrepresented and falsely claimed association with the Plaintiff. These fraudulent acts cost a large sum of money to Mr. Priyank Goel, an Indian consumer. A copy of the letter sent by the Indian High Commission to the Plaintiff has been filed and marked as EX. PW 1/18. A copy of the Plaintiff's reply to the Indian High Commission has been filed and marked as EX. PW 1/19. This evidence of bad faith and fraudulent conduct on part of the Defendant No. 1 clearly shows that the Defendant No. 1 is indulging in parasitic behaviour and unlawfully free riding on the reputation and goodwill of the Plaintiff.

16. Plaintiff has prayed that the suit be decree as per clause 22(a) to (j) of the plaint.

17. I have heard counsel for the plaintiff and perused the record. Affidavit by way of evidence has been filed which remains un-rebutted. A copy of the Plaintiff's trade mark registration certificate in India (in classes 14, 18, 25 and 35) has been marked as Ex. PW 1/5. Copies of trademark registration certificates of the plaintiff with respect to the impugned mark "Jane Norman", from around the world have been marked as Ex. PW 1/3. Statistics detailing the number of visits by internet users in India to the Plaintiff's website have been marked as Exhibit PW 1/6. Copies of global advertising/publicity material in relation to the Jane Norman Mark have been marked as Ex. PW 1/7.

18. Having regard to the documents placed on record the plaintiff has been able to establish that the plaintiff is the registered proprietor of the trade mark "Jane Norman" not only in India but various other countries across the world. The plaintiff has also been able to establish that it enjoys enormous reputation globally which has also spilled over India through several channels including internet especially by way of its official website by the name of www.janenorman.co.uk. Plaintiff has also been able to prove that its website is

accessed by thousands of users from India which is evident from the statistics filed on record.

19. In view of the above, plaintiff has the exclusive right to use the trademark "Jane Norman" and domain name www.janenorman.co.uk with respect to its goods and services.

20. In the landmark decision of N.R. Dongre and Others Vs. Whirlpool Corporation and Another, , following observations were made by another bench of this court with respect to trans border reputation acquired by a mark:

(15) The knowledge and awareness of a trade mark in respect of the goods of a trader is not necessarily restricted only to the people of the country where such goods are freely available but the knowledge & awareness of the same reaches even the shores of those countries where the goods have not been marketed. When a product is launched and hits the market in one country, the cognizance of the same is also taken by the people in other countries almost at the same time by getting acquainted with it through advertisements in newspapers, magazines, television video films cinema etc. even though there may not be availability of the product in those countries because of import restrictions or other factors. In today's world it cannot be said that a product and the trade mark under which it is sold abroad, does not have a reputation or goodwill in countries where it is not available. The knowledge and awareness of it and its critical evaluation & appraisal travels beyond the confines of the geographical area in which it is sold. This has been made possible by development of communication systems which transmit & disseminate the information as soon as it is sent or beamed from one place to another. Satellite Television is a major contributor of the information explosion. Dissemination of knowledge of a trade mark in respect of a product through advertisement in media amounts to use of the trade mark whether or not the advertisement is coupled with the actual existence of the product in the market.

(Emphasis Supplied)

21. In a recent judgment rendered by another bench of this court, Cadbury U.K. Limited & Anr. v. Lotte India Corporation Ltd. [CS (OS) 1295 of 2013, decided on 24.01.2014] following observations were made:-

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(a) The concept of goodwill is derived from reputation but the reputation need not be necessarily a local reputation. It can even be a spill over in India of the international reputation enjoyed by the Plaintiffs mark.

(b) It is not necessary for the Plaintiff to actually show the presence of or sale of its products in India as long as it is able to establish that it enjoys a spill over reputation in India. In other words, the reputation of a product may precede its introduction and may exist without trade of the product in the country

(c) The proof of reputation can be in the form of advertisements in the media and general awareness which in the modern day context would include advertisements or display on the internet and social media. The reputation must be shown to exist at the time the Defendant enters the market.

(d) A mechanical incantation of reputation is not sufficient. There must be some material that the product is known to the Indian consumer. The material will be scrutinised by the Court from many relevant perspectives, including the class of consumers likely to buy the product (See the decision dated 15th March 2010 of this Court in CS(OS) 626 of 2006 Roca Sanitario S.A. v. Naresh Kumar Gupta).

(e) Although in the internationalization of trade there could be a possible confusion with the domestic trader bona fide adopting business names similar to names legitimately used elsewhere, a dishonest adoption or use of a mark similar to one having a reputation in the market, with a view to causing deception or confusion in the mind of the average consumer, may invite an injunction.

22. In the light of law laid down above, it may be observed that in the present case, although the plaintiff does not have physical stores in India where it sells its products under the trade mark "JANE NORMAN", however, plaintiff definitely enjoys a spill over reputation which is evident from the statistics filed on record proving the huge number of visits that the plaintiffs website receives from Indian users. Another factor that cannot be ignored and would contribute massively to spill over of plaintiffs reputation to India is through purchase of plaintiffs products by Indian visitors to nations where the plaintiff sells its products apart from the fact that plaintiff advertises its products on various media. Therefore, it can be concluded that the plaintiff enjoys trans-border reputation and goodwill which has also spilled over in India and the same deserves to be afforded protection. Moreover, the fact that the defendants claim to have an association with the United Kingdom, from where the plaintiff has actually originated points towards the dishonest use/adoption of the impugned mark by the defendant with a view to causing deception or confusion in the mind of the average consumer.

23. Having regard to the evidence on record and comparing the trade mark of the plaintiff with that of the defendants, photographs of which have been placed on record and exhibited as Ex. PW-1/10, I am of the view that the impugned trade mark of the defendant is identical to that of the plaintiff. The use of the impugned trademark by the defendant, that too in the same line of business i.e. men's and women's clothing amounts to fraudulent, wrongful and brazen misrepresentation to the Indian public that they are licensees/franchisees of the plaintiff in India, and/or have a bonafide commercial relationship with the plaintiff, thus passing off their goods as that of the plaintiff. The use of the impugned mark "Jane Norman" or any deceptively similar variant of the mark or use of the mark in conjunction with non-distinctive pre-fixes or suffixes (such as "Retail Pvt. Ltd." etc.) by the defendants on their products, product labels, store fonts, signboards, invoices etc. is a wilful act of the defendants done in bad faith

and with malicious intentions of encashing upon the goodwill and reputation of the plaintiff and cannot be said to be merely a matter of coincidence. The above said conclusion is further fortified by the fact that the business card of defendant no. 4 prominently carries the words "Fashion from London" underneath the infringing trade mark "JANE NORMAN" and it cannot be a mere coincidence that the defendant claims to be originating from the same place i.e. UK/London from where the plaintiff company has originated. This evidences the bad faith, mala fide and conscious fraudulent conduct of the defendants and clearly shows their indulgence in parasitic behaviour and their unlawful attempt at free riding on the trans-border goodwill and reputation enjoyed by the plaintiff world over. The conclusion that the defendants have adopted the impugned trade mark with the malafide and fraudulent intension of riding on the goodwill and reputation of the plaintiff's mark is further strengthened by the fact that the Indian Trade Marks Registry has objected to the registration application of the defendants' trade mark on ground of there being likelihood of confusion with the plaintiff's registered trademark. Therefore, in my considered view, the adoption of the impugned mark by the defendants amounts to infringement of the trade mark "Jane Norman" of the plaintiff and passing off their products as that of the plaintiff.

24. The law with respect to application of legal norms to internet domain names have been discussed in the case of Satyam Infoway Ltd. Vs. Sifynet Solutions Pvt. Ltd., . Relevant paras are reproduced below:

12. The original role of a domain name was no doubt to provide an address for computers on the internet. But the internet has developed from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the internet, a domain name is also used as a business identifier. Therefore, the domain name not only serves as an address for internet communication but also identifies the specific internet site.

xxx xxx xxx

16. The use of the same or similar domain name may lead to a diversion of users which could result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically limitless) accessibility to users and potential customers and particularly so in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available under one domain name may be confused if they accidentally arrived at a different but similar website which offers no such services. Such users could well conclude that the first domain-name owner had misrepresented its goods or services through its promotional activities and the first domain-owner would thereby lose its customer. It is apparent, therefore, that a domain name may have all the characteristics of a trade mark and could found an action for passing off.

(Emphasis supplied)

25. Applying the law laid down above, in my view, the use of the domain name www.janenorman.co.in by the defendants to advertise their products on the internet also amounts to passing off by virtue of being deceptively similar to the domain name of the plaintiff i.e. www.janenorman.co.uk. It can be concluded that the defendants have consciously adopted the said domain name in order to deceive the public in general by misleading them and creating an impression in their minds that the defendants are commercially associated with the plaintiff. The malicious intentions of the defendants are further proved and reinforced by the letter from the High Commission of India in London exhibited as Ex. PW-1/18, informing the Plaintiff about one such tortuous act of Defendant No. 1 and Defendant No. 2, wherein they unequivocally and fraudulently misrepresented and falsely claimed association with the Plaintiff.

26. The plaintiff has also claimed damages on account of injury caused to the brand equity, goodwill and reputation of the plaintiff along with rendition of accounts of profits earned by the defendant on account of use of the impugned trade mark.

27. In a recent decision rendered by another bench of this court, *Microsoft Corpn. V Kurapati Venkata Jagdeesh Babu* [CS (OS) 2163/2010 decided on 3.02.2014], wherein the defendant was held guilty of infringement and passing off, a sum of Rs. 2 lacs were granted to the plaintiff as compensatory damages and Rs. 3 lacs as exemplary damages including damage on account of loss of goodwill and reputation.

28. In the case of *Microsoft Corporation Vs. Rajendra Pawar and Another*, , following observations were made with respect to grant of punitive damages:

22. Perhaps it has now become a trend of sorts, especially in matters pertaining to passing off, for the defending party to evade Court proceedings in a systematic attempt to jettison the relief sought by the Plaintiff. Such flagrancy of the Defendant's conduct is strictly deprecatory, and those who recklessly indulge in such shenanigans must do so at their peril, for it is now an inherited wisdom that evasion of Court proceedings does not de facto tantamount to escape from liability. Judicial Process has its own way of bringing to task such erring parties whilst at the same time ensuring that the aggrieved party who has knocked the doors of the Court in anticipation of justice is afforded with adequate relief, both in law and in equity. It is here that the concept of awarding punitive damages comes into perspective.

See also *Time Incorporated Vs. Lokesh Srivastava and Another*, ; *Hero Honda Motors Limited Vs. Rafiq Memon* ; *Gora Mal Hari Ram Ltd Vs. Ashique Exports Pvt. Ltd*, ; *Relaxo Rubber Limited and Another Vs. Selection Footwear and Another*, .

29. For the reasons stated above, the plaintiff has made out a case for grant of decree as prayed in the plaint. Accordingly, the order dated 24.04.2012 is confirmed and the suit is decreed in favour of the plaintiff and against the

defendants no. 1 to 4. Plaintiff is also entitled to damages to the tune of Rs. 2 lakhs.

30. Decree sheet be drawn up accordingly.