

(2021) 11 DEL CK 0009

In the Delhi High Court

Case No : Civil Suit (COMM) No. 124 Of 2021

Jumeirah Beach Resort LLC

APPELLANT

Vs

Designarch Consultants Pvt Ltd.& Anr

RESPONDENT

Date of Decision : 09-11-2021

Acts Referred:

Code Of Civil Procedure, 1908 — Order 39 Rule 1, Order 39 Rule 2
Trade Marks Act, 1999 — Section 11, 13, 17, 135(2)(c), 142

Citation : (2021) 11 DEL CK 0009

Hon'ble Judges : Jayant Nath, J

Bench : Single Bench

Advocate : Amit Sibal, Anirudh Bakhru, Abhishek Singh, Nageeb Nawab, Himanshu Deora, Raghav Vig, Shashwat Rakshit, Tejaswini Chandrasekhar, Parag P.Tripathi, Shwetassree Majumdar, Diva Arora, Eva Bishwal, Apoorv Tripathi, Mishika Bajpai

Final Decision : Disposed Of

Judgement

Jayant Nath, J

IA No.4212/2021

1. This is an application filed under Order 39 Rules 1 and 2 CPC seeking the following reliefs:

"a) Restraining the Defendants, their directors, partners, principals, employees, agents, distributors, franchisees, representatives, assigns and/ or all those connected with them in their business from providing, marketing, trading, selling and/or using in any manner whatsoever in relation to any services, inter alia, construction services the impugned marks- THE BURJ, BURJ NOIDA/Burj Noida, , , BURJBANGALORE, BURJMUMBAI, BURJDELHI, BURJGURUGRAM, BURJGURGAON or any mark/ label/ sign/ device/ name or domain name, which is identical with and/or deceptively similar to the Plaintiffs well-known, registered and earlier BURJ Marks [including BURJ AL ARAB and] in any manner

whatsoever without the permission, consent, license of the Plaintiff thereby infringing the rights of the Plaintiff in its registered trademarks amounting to infringement thereof;

b) Restraining the Defendants, their directors/ proprietor/ partners, principals, employees, agents, distributors, franchisees, representatives, assigns and all those connected with them in their business from reproducing, communicating or copying in any manner whatsoever, in relation to any goods/ services (inter alia, construction services), the artistic features, including the get-up and/or layout and/or stylization and/ or colour combination and/or arrangement, shape and design of the Plaintiff s distinctive BURJ Logos [including the logos/ devices namely- and and Burj A1 Arab building / in any manner whatsoever without the permission, consent, or license of the Plaintiff, thereby infringing the copyright of the Plaintiff in its artistic work/ creations amounting to infringement thereof;

c) Restraining the Defendants, their directors/ proprietor/ partners, principals, employees, agents, distributors, franchisees, representatives, assigns and all those connected with them in their business from constructing any structure/ building based on the Plaintiffs architectural design drawings in any manner whatsoever, without the permission, consent, or license of the Plaintiff, thereby infringing the copyright of the Plaintiff in its artistic work/creations amounting to infringement of the Plaintiffs Copyright;

d) Restraining the Defendants, their directors, partners, principals, employees, agents, distributors, franchisees, representatives, assigns and/ or all those connected with them in their business from providing, marketing, trading, selling and/or using in any manner whatsoever in relation to any services, inter alia, construction services, the impugned marks- THE BURJ, BURJ NOIDA/ Burj Noida, Noida, , , BURJBANGALORE, BURJMUMBAI, BURJDELHI, BURJGURUGRAM, BURJGURGAON or any mark/ label/ sign/ device/ name/ shape or domain name, which is identical with or deceptively similar to the Plaintiff s well-known and earlier BURJ Marks amounting to passing off their services as and for the services of the Plaintiff, or in any manner whatsoever, using or incorporating the Plaintiff s well-known BURJ Marks or any other mark/ device/ logo/ name/ shape/ domain name, which is deceptively or confusingly similar to the Plaintiff s prior and famous BURJ Marks and from taking benefit of the reputation and goodwill of the Plaintiff in any manner whatsoever; and

e) Restraining the Defendants from disposing of or dealing with its assets including their premises at the addresses mentioned in the Memo of Parties and their stocks-in-trade or any other assets as may be brought to the notice of the Hon'ble Court during the course of the proceedings and/or the Defendants' disclosure thereof and which the Defendants are called upon to disclose and/or on their ascertainment by the Plaintiff as the Plaintiff is not aware of the same, as provided under Section 135(2)(c) of the Trade Marks Act, 1999 as it could adversely affect the Plaintiffs ability to recover the costs and pecuniary reliefs

thereon."

2. It is the case of the plaintiff that this is an international hotel chain and part of Dubai Holding which is a collection of leading Dubai-based businesses and projects. It is stated that success of the plaintiff is evident from the fact that the plaintiff operates 24 properties in eight countries and employees nearly 13,500 people from across 140 nationalities.

3. The plaintiff's flagship hotel- The Burj Al Arab is said to be a global icon and an architectural landmark. The popularity of the Burj Al Arab is said to be evident from the fact that it has been consistently voted as "The World's Most Luxurious Hotel". It is stated that the said Burj Al Arab's history dates back to 1993 when the famous architect Tom Wright was handed over the challenge of creating this groundbreaking superstructure. From the beginning, the Burj Al Arab was planned and designed to become the icon of Dubai. It is stated that Burj Al Arab stands proud as one of the tallest buildings in the world being taller than the Eiffel Tower, and mere 60 meters shorter than the Empire State Building. At 321 meters above sea level, the Burj Al Arab is the tallest all-suite hotel in the world. It is stated that the Burj Al Arab is one of the most photographed structures in the world and is a well-known figure in popular culture. It is featured in magazines, articles, movies etc.

4. It is stated that the Burj Al Arab is the chosen destination by Indians for vacations, professional events and weddings etc. The details of revenue generated from Indian customers to the plaintiff are projected in para 15 of the plaint.

5. It is stated that the plaintiff is the proprietor and owner of the famous BURJ Marks including but not limited to the inherently distinctive trademarks BURJ, BURJ AL ARAB, and, which were honestly adopted by the plaintiff as early as in the year 1999. In order to protect its rights, the plaintiff has acquired various trademark registrations in different classes in India, the details of which are given in para 20 of the plaint, which include BURJ AL ARAB in class 16 registered on 09.11.2001 and further there are registrations also in classes 35, 36, 39, 41 and 42. The plaintiff is also said to have filed pending applications for the well-known BURJ Marks in India in class 39, 41 and 43 including shape of its Burj Al Arab hotel, represented as follows:

6. Further, it is stated that the plaintiff secured registrations of BURJ Marks in major jurisdictions around the world. The plaintiff also holds copyright for the artistic layout, get up, stylization, colour combination, and design of its Burj Al Arab building as well as BURJ Logos and . Some of the presentations of the plaintiff's copyright work in the Burj Al Arab building are given as follows:

7. The plaint has also provided the details of the revenue generated by the plaintiff and the expenses incurred on the advertisement of the said BURJ Marks.

8. It is stated that in or around the second week of August, 2020, the plaintiff

become aware of defendant No.1's promotional activities undertaken for the upcoming residential project "BURJ NOIDA". The plaintiff was concerned to learn about the activities of defendant No.1 and also the adoption of the impugned marks, THE BURJ, BURJ NOIDA/Burj Noida, by defendant No.1. It is stated that defendant No.1 is claiming to be building a residential project under the impugned marks BURJ NOIDA/Burj Noida. It is stated that the impugned marks of defendant No.1 are identical and/or deceptively similar to the plaintiff's prior and well-known BURJ Marks in each and every aspects. A cease and desist notice was sent on 13.08.2020 to defendant No.1. A reply was received on 27.08.2020. On conducting a public search on the portal of the Trade Marks Registry, the plaintiff learnt that the defendant has a registered mark "BURJ NOIDA" and registered in class 37 for building construction. Other marks were also registered in class 37 for building constructions, repair, installation services. Various other marks which are lying under objection are BURJBANGALORE, BURJMUMBAI, THEBURJ, BURJDELHI, BURJGURUGRAM and BURJGURGAON.

9. It is further stated that on 11.11.2020, the plaintiff was served with the Rectification Petitions filed by defendant No.2 against the plaintiff's registration in classes 35, 36, 39, 41 and 42 for the marks BURJ AL ARAB before the Trade Marks Registry.

10. It is stressed that the impugned registrations of the defendant have been obtained malafidely and by misrepresentation and are in contravention of section 11 of the Trademarks Act, given the prior BURJ Marks existing on the register. It is stated that the defendants' registration for the marks inadvertently did not come to the notice of the plaintiff and the plaintiff could not timely file objections to the said marks. Hence, it is stated that the said registrations are invalid. The plaintiff has filed cancellation/revocation of the said registrations before IPAB on 15.01.2021.

11. Later on, the plaintiff came to know that the defendants have filed a commercial suit against the plaintiff being CS(COMM) 366/2020, titled Designarch Consultants Pvt. Ltd. & Anr. v. Jumeirah Beach Resort LLC under section 142 of the Trade Marks Act, 1999. It is urged that the defendants have mislead the court by suppressing relevant material and were granted an ex-parte ad interim order on 10.09.2020 directing the plaintiff herein to give the defendants 7 days prior notice before initiating any proceedings against the defendants herein and also restrained the plaintiff from extending any threat to the defendants until the next date.

12. It is further stated that the defendants presently claim to be launching the only one project under the impugned marks i.e. BURJ NOIDA. The plaintiff reproduces the comparison of the marks of the plaintiff and the defendants as follows:

Plaintiff's Prior BURJ Marks

Defendants' Impugned Marks

BURJ/Burj Al Arab/BURJ AL ARAB

THEBURJ/BURJNOIDA/Burj

Noida

www.burjalarab.com

www.burjnoida.com

13. It is urged that the defendants have slavishly copied the BURJ Marks of the plaintiff. The malafide of the defendant is further evident from the fact that the defendants have adopted the identical colour combination of black and gold in the impugned marks. Other aspects are also pleaded.

14. It is urged that the plaintiff's prior and registered BURJ Marks are highly distinctive and well-known marks that have a reputation in India and worldwide. The adoption and use of the identical and/or deceptively similar impugned marks THE BURJ, BURJ NOIDA/Burj Noida, BURJBANGALORE, BURJMUMBAI, BURJDELHI, BURJGURUGRAM and BURJGURGAON and the impugned domain name by the defendants is illegal and detrimental to the distinctive character of the plaintiff's well-known, registered and earlier BURJ Marks. Hence, the present application.

15. The defendants have filed their written statement. It is urged that the plaintiff's trademark and copyright claims against the defendant based on the Burj Al Arab etc. marks are not registered or have been applied for in India under the class in which defendants are carrying on business i.e. building construction. The defendant's use of trademark Burj Noida in relation to its business of building construction was registered in Class 37 on 02.02.2011. Defendants also use the logo which is registered in class 37 on 09.03.2019. The plaintiff, it is urged, neither has a registration nor any common law use anywhere in the world of any logo that resembles the defendant's logo. Regarding the word mark Burj Al Arab, it is stated that the plaintiff is not the proprietor of the word Burj in the country of origin i.e. Dubai. There are number of buildings using the prefix Burj including Burj Khalifa. The plaintiff has no legal or factual basis to claim right over the prefix Burj per se in India. Hence, the plaintiff is not permitted to claim infringement of or passing off of its composite mark Burj Al Arab against the defendant who is using an entirely different composite mark Burj Noida by inviting the court to dissect its mark and treat it as conferring rights over Burj per se in the plaintiff's favour.

16. It is stated that the defendants have a stellar reputation in the field of building construction and the work of defendant's Burj Noida commenced in December, 2010. The present proceedings have been commenced after 11 years of defendant's adoption of the trademark. It is stated that plaintiff has concealed that it does not have a registration for the mark Burj Al Arab in class 37 in India i.e. the class in which the defendants have a registration. Further, the plaintiff does not have a registration for its logo mark in India in any class. It is stated

that the defendants have sold / received bookings and third party commitments for almost the complete saleable area of the building and construction is moving at a fast pace. A sum of Rs.110 crores has been spent by the defendant group on Burj Noida tower.

17. It is urged that defendant are leaders in innovative building construction and pioneers of smart housing in India. In order to create a distinctive and unique landmark with Burj Noida the defendant group"s architect drew inspiration from waveforms of dynamic sound waves and was originally conceptualized and sketched in 2011 by Ar. J.K. Jain under the architectural firm, M/s 4th Dimension. It is further urged that the term Burj is of an Arabic / Persian origin and means tower. It is stated that in this country there are several monuments which used the term Burj details of which are given in para 22 of the written statement. It is further urged that defendant No.1 owned 13 copyright registrations in respect of the drawings of its Burj Noida tower which include and not limited to registrations for architectural layout / drawings of the building including shops and sections. Hence, it is prayed that the present application be dismissed.

18. I may note that when this matter came up for hearing on 19.03.2021, learned senior counsel for the defendants had urged that the mark "BURJNOIDA" is a registered mark under Class 37 and has been in use since 2011. Regarding other marks, namely, BURJBANGALORE, BURJMUMBAI, BURJDELHI, BURJGURUGRAM and BURJGURGAON, a statement was made that till the next date, the defendant shall not use these marks.

19. I have heard learned senior counsel for the plaintiff and learned senior counsel for the defendants. I have also perused the written submissions filed by the parties.

20. Learned senior counsel for the plaintiff has strongly urged as follows:-

(i) The plaintiff"s BURJ Marks including BURJ, BURJ AL ARAB, BURJ Collection of marks, etc. were adopted in 1999. The first registration in India is of 2001 in Class 16. The plaintiff has pending applications for the word BURJ and the shape of its "Burj Al Arab Hotel (as 3D mark)".

(ii) It is urged that ever since the adoption, the BURJ Marks have been extensively, continuously and uninterruptedly used on a worldwide basis including in India. Burj Al Arab is one of the most photographed structures in the world and is frequently featured in articles, movies and post cards.

(iii) It is stressed that since inception, the plaintiff has been providing services to Indians. Various invoices are sought to be placed on record starting from 2009. It is urged that the total room revenue from India for the years 2012-2020 was USD 5,562,712 and approximately 3,776 Indian have been served.

(iv) It is also stressed that the plaintiff"s domain names www.burjalarab.com and www.jumeirah.com were registered in 1999. It is urged that Burj Al Arab Hotel has received several awards and has been featured in several Bollywood movies.

By long, continuous and extensive use and promotional activities, the plaintiff has acquired enormous goodwill and reputation.

(v) It is stated that the defendants' impugned marks are identical/deceptively similar (phonetically, structurally and visually) to the plaintiff's prior and famous BURJ Marks. It is urged that the dominant part of the trade mark of the plaintiff is infringed and hence, an injunction ought to be granted. Hence, it is stressed that in the present case, BURJ is the dominant part of the plaintiff's registered trade mark "Burj Al Arab". In any case, it is stated that the separate applications for the word BURJ have also been filed and hence, Section 17 of the Trade Marks Act has no application.

(vi) It is stated that the defendants claim to have adopted the impugned marks for "construction services" in Class 37. The services of hotel business, providing temporary accommodation (i.e. Class 43) in which the plaintiff's trademarks are registered and construction of residential apartments (Class 37) have been held to be similar by this court. It is stressed that the actual offending services i.e. selling and advertising the proposed residential project and residential accommodation which are sought to be provided by the defendant under the impugned marks are real estate services falling in Class 36, a class in which the plaintiff is already a registered proprietor of the mark "Burj Al Arab" dated 04.12.2003.

(vii) It is urged that the plea of the defendants that the word BURJ per se is publici juris is misplaced. The defendants have themselves applied for registration of the mark "THEBURJ" twice. In the reply to the examination report of the application for mark "THEBURJ", the defendants have claimed that the mark is highly distinctive and unique. The contention that third parties are also using the mark "BURJ" is irrelevant as the third parties are not using the mark BURJ in a commercial sense/there is no substantial use by such third parties.

(viii) It is further stressed that there is no delay on the part of the plaintiff as it became aware of the offending activities only in August 2020. In any case, the project BURJNOIDA has been launched recently and construction is at an initial stage

(ix) As regards the impugned device mark, it is the defendant's own claim that the said device has been adopted in 2019 and the application for its registration has been filed in 2019 on "proposed to be used" basis. It is hence prayed that an interim injunction be granted for the impugned marks.

21. Learned counsel for the defendants has stressed as follows:-

(i) The plaintiff's registration and use of the composite mark "Burj Al Arab" does not give it a right over the word "BURJ" per se. The defendant owns the composite mark "BURJNOIDA". It is urged that the word BURJ is a prefix and is common to trade. Reference is made to various buildings/land marks including BURJ KHALIFA to contend that "BURJ" prefix is common to trade. It is stressed

that the word "BURJ" is of Arabic/Persian origin which means tower. There are several places/monuments in India where the term BURJ is used. Reliance is placed on Section 17 of the Trade Marks Act and on a judgment of the Supreme Court in the case of Corn Products Refining Co. vs. Shangrila Food Products Ltd., AIR 1960 SC 142.

(ii) It is urged that the plaintiff has no registration in Class 37 nor use in the classes of its registration i.e. 35, 36, etc. Further no evidence is filed of any India-related documents prior to 2009. It is stressed that the plaintiff owns one hotel called "Burj Al Arab" in Dubai and the attempt to claim use and goodwill over part of the mark i.e. the prefix BURJ on Indian soil on the basis of bookings for the said hotel in India is misplaced.

(iii) It is urged that there is significant burden of proof when spill-over reputation is claimed. Reliance is placed on the judgment of the Supreme Court in the case of Toyota Jidosha Kabushiki Kaisha vs. Prius Auto Industries Ltd. & Ors., (2018) 2 SCC 1.

(iv) It is also urged that the plaintiff cannot monopolize services it does not offer. Reliance is placed on the judgment of the Supreme Court in the case of Nandhini Delux vs. Karnataka Cooperative Milk Producers Federation Ltd., (2018) 9 SCC 183.

(v) It is further stated that the balance of convenience is in favour of the defendants. The project BURJNOIDA is of a total value of INR583.56 crores as on 31.07.2020. From 1st April 2020 to 31 March 2021, an amount of Rs.110 crores has been spent by the defendant group on BURJNOIDA tower which has been reported to UP RERA. There is hence delay on the part of the plaintiff as they have waited for 10 years to file the present suit. The defendants have adopted BURJNOIDA and have been using it for a decade.

22. I may first see as to whether the impugned marks of the defendants can be said to be deceptively similar to the marks of the plaintiffs. This court has to see as to whether the similarity between the plaintiff's and the defendants' marks is so close either visually, phonetically or otherwise. In this context reference may be had to the judgment of the Supreme Court in the case of Kaviraj Pandit Durga Dutt Sharma vs. Navaratna Pharmaceutical Laboratories, AIR 1965 SC 980 where the Court held as follows:-

"28.In an action for infringement, the plaintiff must, no doubt, make out that use of the defendant's mark is likely to deceive, but were the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin

different from that of the registered proprietor of the make would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."

23. Reference may also be had to the judgment of the Division Bench of this court in the case of M/S. South India Beverages Pvt. Ltd. vs. General Mills Marketing INC. & Anr., (2015) 61 PTC 231 where the Division Bench held as follows:-

"34. A Division Bench of this Court in the decision reported as (40) PTC 417 (Del.) (DB) Amar Singh Chawal Wala v. Shree Vardhman Rice & Genl. Mills recognised the relevance of phonetic similarity between the constituent elements comprised in the competing marks. The plaintiff was engaged in selling rice under the registered trademarks 'Golden Qilla' and 'Lal Qilla'.

The defendant, who was also selling the same product, was operating under the trademark 'Hara Qilla', against which the plaintiff sought injunction. The Court held that the essential CS(COMM.)385/2020 Page 13 of 28 feature of the mark is the word 'QILLA', whether it is spelt as QILLA or KILLA, or even written in a different style or colour combination. It was further observed that for a customer who would seek to purchase the QILLA brand rice, both the names would sound phonetically similar. The Court held that since the trademark QILLA was being utilised for the same commodity i.e. rice, there existed every possibility of there being confusion created in the mind of the purchaser of rice that the product being sold by the defendant was in fact a product that had emanated from or had been manufactured by the plaintiff.

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39. It is also a settled proposition of law that where products are virtually identical, as they are in the present case, "the degree of similarity in the marks necessary to support a finding of infringement is less than in the case of dissimilar, non-competing products."

24. Keeping in view the above test, I may now compare the two trade marks in question. The same are reproduced in the plaint as follows:-

Plaintiff's Prior BURJ Marks

Defendants' Impugned Marks

BURJ/Burj Al Arab/BURJ AL ARAB

THEBURJ/BURJNOIDA/Burj

Noida

www.burjalarab.com

www.burjnoida.com

25. Prima facie, it appears that the defendants' trademarks are deceptively similar to the marks of the plaintiff. The essential features of the trade mark of the plaintiff have prima facie been copied.

26. A strong plea was raised by the defendants that no relief should be granted to the plaintiff as the plaintiff cannot expropriate the word BURJ which is used in common language. It is stated that the plaintiff does not have any exclusive right over the word BURJ. Hence, merely because the defendants have used the word BURJNODIA does not amount to infringement of the plaintiff's trade mark.

27. In my opinion, the above plea of the defendants is misconceived. In this context a complete answer to negate the submission of the learned counsel for the defendants is found in the judgment of the Division Bench of this court in the case of M/S. South India Beverages Pvt. Ltd. vs. General Mills Marketing INC. & Anr.(supra), where the Division Bench held as follows:-

"5. It is the case of the appellant - defendant that the respondent -plaintiff enjoys protection for its mark "HAAGEN DAZS" as an indivisible whole and not for the individual elements constituting the same. Reliance has been placed on the principle of "anti-dissection" consistently applied by the Courts since time immemorial while dealing with cases of trademark infringement. It has been further submitted that even if the constituting elements of the mark are considered, "HAAGEN" forms the dominant part of the respondent-plaintiff's trademark and any potential similarity with the non-dominant element "DAZS" in a trademark would not amount to infringement.

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21. The view of the author makes it scintillatingly clear, beyond pale of doubt, that the principle of "anti dissection" does not impose an absolute embargo upon the consideration of the constituent elements of a composite mark. The said elements may be viewed as a preliminary step on the way to an ultimate determination of probable customer reaction to the conflicting composites as a whole. Thus, the principle of "anti dissection" and identification of "dominant mark" are not antithetical to one another and if viewed in a holistic perspective, the said principles rather compliment each other.

22. We may refer to the decision of the United States Court of Appeals for the Federal Circuit reported as 380 F.3d 1340 Re Chatam Int'l, Inc, wherein the Court enunciated the interplay between the principle of "anti dissection" and identification of "dominant mark". The Court, while ascertaining whether the mark "JOSE GASPARD GOLD" was similar to the registered mark "GASPAR'S ALE", held that "GASPAR" was clearly the dominant element in the two marks and resembled the relevant mark enough to cause a likelihood of confusion, to cause a mistake or to deceive. Relevant would it be to note that the defendant in the said case urged that the approach of splitting of the marks was in violation of the anti-dissection rule. The said contention was repelled by the Court and it was pertinently observed that there was no violation of anti-dissection rule because

the marks were any way examined in entirety, and each individual term in the marks were given more or less weightage depending on the overall impression it appeared to create. The Court was of the view that both marks convey the commercial impression that a name, GASPAR, is the source of related alcoholic beverages, tequila or ale. In other words, the commercial significance of ALE in the registered mark "GASPAR'S ALE" and JOSE and GOLD in appellant's mark "JOSE'S GASPAR GOLD" assumed less significance in the opinion of the Court.

23. It is also settled that while a trademark is supposed to be looked at in entirety, yet the consideration of a trademark as a whole does not condone infringement where less than the entire trademark is appropriated. It is therefore not improper to identify elements or features of the marks that are more or less important for purpose of analysis in cases of composite marks.

24. In this regard we may fortify our conclusion by take note of the decision reported as 405 F.Supp. 530 (1975) Eaton Allen Corp. v. Paco Impressions Corp. The facts of the said case reveal that the plaintiff manufactured coated paper under the registered trademark "Super-KoRec-Type". The defendant manufactured and advertised a similar product under the mark "Super Type" and "Super Type-7". The defendant contended that the only similarity between the said marks was use of the words "Super" and "Type", terms which were neither significant parts of the plaintiff's registered trademark nor protectable as a matter of law.

The court held that the consideration of a trademark as a whole does not preclude infringement where less than the entire trademark is appropriated.

25. Therefore, the submission of the appellant-defendant predicated upon the principle of "anti-dissection" that action for infringement would not lie since use of the word "D'DAAZS" does not result in complete appropriation of the respondent plaintiff's mark "HAAGEN DAZS", which is to be viewed as an indivisible whole, is liable to be rejected.

26. Dominant features are significant because they attract attention and consumers are more likely to remember and rely on them for purposes of identification of the product. Usually, the dominant portion of a mark is that which has the greater strength or carries more weight. Descriptive or generic components, having little or no source identifying significance, are generally less significant in the analysis. However, words that are arbitrary and distinct possess greater strength and are thus accorded greater protection.[174 F. Supp. 2d 718, 725 (M.D. Tenn. 2001) Autozone, Inc. v. Tandy Corporation]"

28. Reference may also be had to the judgment of this court in the case of Jagan Nath Prem Nath vs. Bharttya Dhoop Karyalaya, AIR 1975 Del 149 where the court held as follows:-

"6. In James Chadwick & Bros. Ltd. v. The National Sewing Thread Co. Ltd., A.I.R. 1951 Bombay 147 (3) the Court ruled that in an action for infringement

what is important is to find out what was the distinguishing or essential feature of the trade mark already registered and what is the main feature or the main idea underlying the trade mark. In *Parle Products (P) Ltd. v. J.P. & Co. Mysore* : (1972) 1 SCC 618 : A.I.R. 1972 Supreme Court 1359 (4) the Supreme Court took the same view.

7. This being the law, it cannot be disputed that in an action for infringement the plaintiff can succeed not only when he proves that the whole of his registered trade mark has been copied but can also succeed if he shows that the defendant's mark is similar to the plaintiff's mark as it would be remembered by persons possessed of an average memory with its usual imperfections of that its essential particular or the distinguishing or essential feature has been copied."

29. Reference may also be had to the judgment of this court in the case of *IREO Private Ltd. vs. Genesis Infratech Private Ltd.*, 2014 SCC OnLine Del. 1162 where this court has held as follows:-

"26. The second submission of the learned Senior Counsel for the defendant relates to Section 17 of the Trade Marks Act. It is urged that under Section 17 where a Trade Mark consists of several matters, its registration confers exclusive right to use the mark as a whole and the registration does not confer a right on the matter being a part of the trade mark.

27. On the basis of the same it is urged that the registered trade mark of the plaintiff is "IREO SKYON Space Age Living". It is urged that what the plaintiff is complaining of is that the defendant has, as part of its mark, copied the word "SKYON."

Hence the present suit has been filed. It is urged that SKYON being only part of the full registered trade mark of the plaintiff, the plaintiff is entitled to no protection for a part of the trade mark, namely, SKY-ON.

28. Section 17 reads as follows:

"Section 17 - Effect of registration of parts of a mark

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark-

(a) contains any part-

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered."

29. In my view the judgment of this High Court in *Jagan Nath Prem Nath v. Bhartiya Dhoop Karyalaya* would be a complete answer to the above submissions of the learned senior counsel for the defendant. The court held as follows :

"7. This being the law, it cannot be disputed that in an action for infringement the plaintiff can succeed not only when he proves that the whole of his registered trade mark has been copied but can also succeed if he shows that the defendant's mark is similar to the plaintiff's mark as it would be remembered by persons possessed of an average memory with its usual imperfections or that its essential particular or the distinguishing or essential feature has been copied.

...

15. Shri P.C. Khanna, learned counsel for the respondent, argued that where a distinct label is registered as a whole such a registration does not confer any exclusive statutory right on the proprietor to use any particular word or name contained therein, apart from the mark as a whole. Reliance in support of this proposition was placed on the observations in *Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd.* These observations in the cited case were made in the context of exercise of powers conferred on the Registrar by Section 13 of the Trade Marks Act, 1940. This aspect is not at all relevant for the present controversy because the plaintiff can succeed in an action for "infringement" if he proves that an essential particular of his trade mark has been copied : See *Taw Manufacturer Coy. Ltd. v. Notek Engg. Co. Ltd.*"

Hence, the above plea of the defendant cannot be accepted.

30. Another strong plea raised by the defendant was that the plaintiff cannot monopolise the trade mark for services it does not offer. In this context reference may be had to the judgment of the Supreme Court in the case of *Nandhini Delux vs. Karnataka Cooperative Milk Producers Federation Ltd.*, (supra). In that case the respondent was using the trade mark "Nandini" in respect of its products, namely, milk and milk products since 1985. The plaintiff was in the business of running restaurants and adopted the mark "Nandhini" for its restaurants in 1989. The Supreme Court held as follows:-

"33. We may mention that the aforesaid principle of law while interpreting the provisions of the Trade and Merchandise Marks Act, 1958 is equally applicable as it is unaffected by the Trade Marks Act, 1999 inasmuch as the main object underlying the said principle is that the proprietor of a trade mark cannot enjoy monopoly over the entire class of goods and, particularly, when he is not using the said trade mark in respect of certain goods falling under the same class. In this behalf, we may usefully refer to Section 11 of the Act which prohibits the registration of the mark in respect of the similar goods or different goods but the provisions of this section do not cover the same class of goods."

31. Similarly, a Coordinate Bench of this court in the case of *Keller Williams Realty, Inc. vs. Dingle Buildcons Pvt. Ltd. & Ors.*, 2020 SCC OnLine Del 539 held

as follows:-

"12.

(C) The business of real estate brokerage is very different and distinct from the business of development and construction of real estate. The plaintiff does not claim to be in business of or having reputation and goodwill in the construction and development of real estate. Rather the plaintiff does not even claim to be carrying on business of real estate brokerage. The plaintiff describes itself as a real estate franchisor. The plaintiff itself on 20th May, 2013 while responding to the objections in the examination report of the Trade Mark Registry to the application of the plaintiff for registration of the mark, took a stand that the business of advertising, business management, business administration and offices functions for which the defendant no. 1 had applied for registration of the same mark prior to the plaintiff was very distinct and different from the business of franchising/offering technical assistance in the establishment and/or operation of real estate brokerage for which the plaintiff had applied for registration. The defendants even today are not pleaded to be in the business of franchising or providing technical assistance for real estate brokerage. The position thus remains the same as on 20th May, 2013. When the plaintiff then had not objection to defendants also using the 'KW' marks, there is no reason, why today. From the response dated 20th May, 2013 aforesaid of the plaintiff, it is clear that the plaintiff had no objection to use by the defendants or by others of the same mark as the plaintiff i.e. KW, as long as for businesses other than the business for which the plaintiff intended to use the said mark. The plaintiff cannot be entitled to restrain the defendants without establishing by evidence how today there is a possibility of confusion and deception by the defendants, in the business of real estate development and construction, using the KW formative marks registered in favour of the plaintiff, as part of their device/logo mark. Without the plaintiff establishing the tort, of the defendants, by confusing the customers, passing off the properties developed by the defendants as those from the plaintiff, cannot be entitled to any relief on the ground of passing off.

XXX

33. I have already held above that the mark which is being used by the defendant is deceptively similar to the mark of the plaintiff. The essential features have been copied. Merely because the word SKYON is the only word copied by the defendant, does not change the legal position. The contention of the defendant in this regard has no merits."

32. As is apparent, the plaintiff and the defendants are in different fields. The plaintiff has registration of the trade mark "Burj Al Arab" in Class 16, 35, 36, 39, 41 and 42. The defendant has registration under Class 37.

33. The list of business as given in the plaint reads as follows:-

Trade Mark

Reg. No.

Class

Reg. Date

Journal No.

BURJ AL ARAB

1058203

16

09-11-2001

1340-1 dated 15/03/2006

Goods / Services:

[Class : 16]

Printed matter; printed publications; journals; magazines. Catalogues; paper and articles of paper; cardboard and articles of cardboard; stationery and office requisite; pens pencils; felt pens; propelling pencils, ballpoint pens, paper weights, blotters, memorandum and engagement books, diaries, letter racks, file, index files, writing paper, envelopes, maps and card; playing cards.

BURJ AL ARAB

1253325

35,36,39,41

& 42

04-12-2003

1328-2 dated

14/02/2005

Good/Services:

[Class : 41]

Entertainment service, sporting and recreational facilities and services; amusement park services, educational and training, gymnasiums and health exercise clubs; educational and cultural exhibitions.

[Class : 42]

Hotel and accommodation services, food and beverage services in this class; restaurant, cafe and bar service, health spas, beauty salon, hair dressing salons.

[Class : 39]

Travel agency services, travel arrangement, travel reservations, arranging and promoting and conducting tour and sightseeing, travel escorting, transport reservation, transportation of goods and people.

[Class : 36]

Real estate services, including but not limited to, real estate management, appraisals, leasing, rentals, banking, financial, insurance, investment and brokerage services.

[Class : 35]

Public relations, marketing and advertising business consultancy, business management and advice, business administration; retail services, office and personnel management, establishing databases.

1058204

16

09-11-2001

1349-0

dated 01/08/2016

Goods / Services:

[Class : 16] Printed matter; printed publications; journals; magazines. Catalogues; paper and articles of paper; cardboard and articles of cardboard; stationery and office requisite; pens pencils; felt pens; propelling pencils, ballpoint pens, paper weights, blotters, memorandum and engagement books, diaries, letter racks, file, index files, writing paper, envelopes, maps and card; playing cards.

34. While Class 37 i.e. which concerns the defendant pertains to Building construction, repair, installation services.

35. As per the plaint, the plaintiff is majorly into running its international hotel. It also claims to be in the business of luxury brand of residences, restaurants, theme amusement parks, hospitality management, etc. Much stress has been laid on its stated famous hotel BURJ AL ARAB which is stated to be a global icon and an architectural land mark. In contrast, the defendant is into building construction and claims to be building a residential building in Noida.

36. It is clear from the above judgment of the Supreme Court in the case of Nandhini Delux vs. Karnataka Cooperative Milk Producers Federation Ltd., (supra) that prima facie the parties are dealing in different goods and services. The plaintiff prima facie cannot enjoy a monopoly on the trade mark in question over the goods/class of goods in which it is not operating.

37. The plaintiff has stressed that the mark of the plaintiff is a well-know mark

and is required to be protected in India, especially, in view of the registration done. The Coordinate Bench of this court in the case of Keller Williams Realty, Inc. vs. Dingle Buildcons Pvt. Ltd. & Ors.(supra) held as follows:-

"12. I have considered the rival contentions, only for the purposes of the application for interim relief, and am of the opinion that the plaintiff is not entitled to any interim relief for the following reasons:

(A) Though, the Supreme Court in Neon Laboratories Ltd. supra and in Milmet Oftho Industries v. Allergan Inc., (2004) 12 SCC

624 applied the "first in the market" test and held that the mere fact that the plaintiff had not been using the mark in India would be irrelevant if they were first in the world market, but the same, in Milmet Oftho Industries supra was held in the context of drugs and medicinal products and after holding the field of medicine to be of an international character and in Neon Laboratories Ltd., again in the context of drugs and medicinal products, and after finding, the defendant, though to be a prior registrant having not used the mark till after registration and commencement of use of the mark by the plaintiff therein. Thereafter, in Toyota Jidosha Kabushiki Kaisha supra, after noticing the view in Milmet Oftho Industries supra, final decree in a suit for permanent injunction restraining passing off was declined, holding (a) that the plaintiff was first worldwide user of the mark but the defendants were the first user of the mark in India; (b) that the first use by the plaintiff outside India of the mark did not have much reportage in India;

(c) that the territoriality doctrine (a trade mark being recognised as having a separate existence in each sovereign country) holds the field; (d) that prior use of the trade mark in one jurisdiction would not ipso facto entitle its owner or user to claim exclusive rights to the said mark in another dominion; (e) that it is necessary for the plaintiff to establish that its reputation has spilled over the Indian market prior to the commencement of the use of the trade mark by defendants in India and which was not established in that case; (f) the test of possibility/likelihood of confusion would be valid in a qua timet action and not at the stage of final adjudication of the suit, at which stage the test would be one of actual confusion and in which respect no evidence had been led by the plaintiff; (g) that it is essential for the plaintiff in a passing off action, to prove his goodwill, misrepresentation and damages; the test is whether a foreign claimant has a goodwill in India; if there are customers for the product of the foreign claimant in India, then the foreign claimant stands in the same position as a domestic trader; and, (h) else what has to be seen is whether there has been a spill over of the reputation and goodwill of the mark used by the foreign claimant, into India; if goodwill or reputation in India is not established by the plaintiff, no other issue really would need any further examination to determine the extent of plaintiffs right in an action for passing off.

...."

Hence, it would be for the plaintiff to show through evidence that the plaintiff was the first worldwide user of the mark. It is necessary for the plaintiff to establish that its reputation has spilled over the Indian market prior to the commencement of the use of the trade mark by the defendant in India.

38. There is another aspect which I may note. The trade mark of the defendants was registered in 2011. The defendants are also claiming that its project commenced in 2010 and the hoardings showing BURJNOIDA were taken out in 2011. On a query from the court, it is stated that the construction is going on. The fact remains that the defendants claim to have been around for the last 10 years as far as the mark BURJNOIDA is concerned.

39. Given the above noted facts, in my opinion, it would not be, at this stage, appropriate to restrain the defendant from using the trade mark BURJNOIDA for the residential project which is under construction in India for the last ten years. However, as the other projects of the defendant are yet to commence, it would be in the interest of justice that the defendant does not further develop the other projects.

40. An injunction order is passed in favour of the plaintiff and against the defendants, restraining the defendants, etc. from in any manner using the trade mark BURJBANGALORE, BURJMUMBAI, BURJDELHI, BURJGURUGRAM and BURJGURGAON or any other similar trade mark till the pendency of the present suit. The defendants are permitted to use the mark BURJNOIDA only for the present ongoing project. However, periodic accounts shall be filed on affidavit by one of the directors every six months before court. The first set of accounts will be filed within two weeks from today.

41. The application stands disposed of.