

(2017) 12 DEL CK 0131

In the Delhi High Court

Case No : Civil Suit (COMM) No. 1307 Of 2016

M/S. Khushi Ram Behari Lal

APPELLANT

Vs

P.V. Kanakaraj Trading As Kalpatharu Trading Co.

RESPONDENT

Date of Decision : 05-12-2017

Acts Referred:

Code Of Civil Procedure, 1908 — Order 39 Rule 3, Order 39 Rule 4, Order 7 Rule 11
Trade Marks Act, 1999 — Section 135(2)(c)

Citation : (2017) 12 DEL CK 0131

Hon'ble Judges : Manmohan, J

Bench : Single Bench

Advocate : Ajay Amitabh Suman, Kapil Kumar Giri, Pankaj Kumar

Judgement

Manmohan, J

1. Present suit has been filed for permanent injunction restraining infringement of copyright, passing off, delivery up etc. The prayer clause in the suit

is reproduced hereinbelow:-

(a) For a decree of permanent injunction restraining all the defendant by themselves as also through their individual proprietors, partners,

directors, agents, representatives, distributors, assigns, heirs, successors, stockiest and all others acting for and on their behalf from using,

selling, soliciting, exporting, displaying, advertising or by any other mode or manner dealing in or using the impugned trademark TAJ

MAHAL WITH DEVIDE OF TAJ MAHAL and/or any other trademark/label, identical and/or deceptively similar thereto in relation to their

impugned goods and business of rice and related/allied products and from doing any other acts or deeds amounting to or likely to:

(i) Infringe the plaintiff's copyright in the said trademark/label TAJ MAHAL

label (device of TAJ MAHAL)

(ii) Passing off and violation of plaintiff's common law right in the said trademark/label TAJ MAHAL label (device of TAJ MAHAL).

(iii) Dilution of plaintiff's goodwill and reputation to the plaintiff's well known trademark/label said trademark/label TAJ MAHAL

label (device of TAJ MAHAL).

(b) Restraining the defendant from disposing off or dealing with its assets including its shops and premises as mentioned in the memo of

parties of the plant and its stocks-in-trade or any other assets a may be brought to the notice of this Honâble Court during the course of

the proceedings and on the defendant disclosure thereof and which the defendant are called upon to disclose and/or on its ascertainment

by the plaintiff as the plaintiff is not aware of the same as per Section 135 (2) (c) of the Trade Marks Act, 1999 as it could adversely affect

the plaintiff's ability to recover the costs and pecuniary relief(s) thereon.

(c) For an order for delivery up of all the impugned finished and unfinished materials bearing the impugned an violative trademark TAJ

MAHAL with device of TAJ MAHAL or any other deceptively similar trademark/label including its blocks, labels, display boards, sign

boards, trade literatures and goods etc. to the plaintiff for the purposes of destruction and erasure.

(d) For a decree for grant of damages in the sum of Rs.20,01,000/- (Rupees Twenty Lakh and One Thousand only) from the defendants to

the plaintiff.

(e) For an order for cost of proceedings.

(f) For such other and further order as this Honâble Court may deem fit and proper in the facts and circumstances of the present

case.â??

2. On 19th December, 2013, this Court granted an ex parte ad interim injunction in favour of the plaintiff and against the defendant. The relevant

portion of the said order is reproduced hereinbelow:-

â??Accordingly, the defendant is restrained by way of ex parte ad interim injunction from selling or dealing with the product rice or allied

products using the trade mark TAJ MAHAL on the device TAJ MAHAL till further

orders. It is clarified that defendant may sell the products after changing the packaging and without using the impugned trade mark.

Plaintiff shall comply with provisions of Order XXXIX Rule 3 CPC within a period of 3 weeks from today.â??

3. On 16th September, 2016 the defendantâ??s applications being I.A.No.5529/2014 under order VII Rule 11 CPC and I.A.No.8938/2014 under

Order XXXIX Rule 4 CPC were dismissed and the ex parte interim injunction was confirmed. The relevant portion of the said order is reproduced

hereinbelow:-

â??11. At the present stage, when the matter is yet to go to trial, the Court cannot insist that the full particulars of where precisely the

Defendant was found selling its products in Delhi have to be set out in the plaint itself. That would be a matter for evidence. Consequently,

this Court is unable to accept the plea of the Defendant that the averments in the plaint are insufficient for the Court to entertain the action

of passing off of the trademark of the Plaintiff.â??

4. Despite entering appearance and having filed the written statement, the defendant stopped appearing after 7th February, 2017. Accordingly, it was

proceeded ex parte vide order dated 3rd August, 2017 and the plaintiff led its ex-parte evidence.

5. Mr. Ajay Amitabh Suman, learned counsel for the plaintiff states that the plaintiff is engaged in the business of processing and marketing Basmati

rice including exports thereof. He states that the plaintiff is the prior adopter and user of the mark TAJ MAHAL along with TAJ MAHAL device in

relation to rice since the year 1978.

6. He further states that the plaintiff has filed an application dated 27 th February, 1989 for registration of the mark TAJ MAHAL claiming user since

1st July, 1978. However, the same is pending consideration on account of objections raised by third parties.

7. Mr. Suman states that the plaintiffâ??s label bears the original artistic feature created by the plaintiff and the same constitutes an original artistic

work within the meaning of the Copyright Act, 1957. He states that since the adoption of the mark TAJ MAHAL along with TAJ MAHAL device,

the plaintiff has been continuously and exclusively using the same to the exclusion of others.

8. Learned counsel for the plaintiff states that the defendant is using the mark/label TAJ MAHAL along with device TAJ MAHAL in relation to same

product i.e. rice dishonestly and fraudulently in order to take advantage of the plaintiff's established reputation and goodwill.

9. He states that the defendant had fraudulently applied for registration of the impugned mark/device on 15th April, 2010 claiming use since 11th January, 2000.

10. Having perused the paper book, this Court is of the opinion that the plea of the mark being public juris raised by the defendant in its written statement cannot be accepted as no evidence in this regard has been led by the defendant.

11. This Court is also of the view that the plaintiff on the basis of the bills/invoices filed by it in support of the present plaint and exhibited as Ex.

PW1/8 (Colly) has been able to establish prior use of the mark TAJ MAHAL with device TAJ MAHAL atleast since 1980.

12. This Court is further of the view that though the defendant in its written statement has claimed use of the mark TAJ MAHAL with device TAJ

MAHAL since 2000, yet it has not filed any document to establish the same and the only document relied upon by the defendant is its application for

registration of the impugned mark/device filed in 2010.

13. This Court is also of the opinion that the defendant's mark TAJ MAHAL with device TAJ MAHAL is bound to cause confusion and

deception among the public at large, consumers, business and trade circles and is likely to suggest that there is some nexus between the plaintiff and

defendant. The mark/device of the plaintiff as well as the defendant is reproduced hereinbelow:

14. In any event, as the averments in the plaint have not been rebutted by the defendant nor did the defendant bother to put forth its stand in spite of

ample opportunities given by this Court, they are deemed to have been admitted.

15. In the opinion of this Court the triple identity test is satisfied as the defendant has made use of a deceptively similar mark i.e. TAJ MAHAL as

well TAJ MAHAL device in relation to identical goods (rice) having identical trade channels (products sold via same trade channels).

16. However, as far as the prayer with regard to the damages is concerned, this Court is of the opinion that since the plaintiff has not led any evidence

with respect to the quantum of damages suffered by the plaintiff, the same cannot be granted in light of the Division Bench judgment of this Court in

Hindustan Unilever Limited Vs. Reckitt Benckiser India Limited, 2014 (57) PTC 495 [Del][DB]. In fact, this Court recently in Super Cassettes

Industries Private Limited Vs. HRCN Cable Network, CS(COMM) 48/2015 dated 09th October, 2017 has held as under:-

“19. However, this Court is not satisfied on the evidence led in the present case that the compensation awarded is inadequate in the

circumstances having regard to the three categories in *Rookes v. Barnard*, [1964] 1 All ER 367 and also the five principles in *Cassell & Co.*

Ltd. v. Broome, 1972 AC 1027. In the event punitive damages are awarded in the present case, it would be an ad-hoc judge centric award

of damages, which the Division Bench specifically prohibited in *Hindustan Unilever Limited* (supra)“

17. Keeping in view the aforesaid facts, mandate of law and the persistent conduct of the defendant in selling products bearing the mark TAJ

MAHAL with device TAJ MAHAL, the suit is decreed in terms of prayers (a) and (e) of the prayer clause along with the actual costs incurred by

the plaintiff. The cost shall amongst others include the lawyers’ fees, local commissioner’s fee as well as the amounts spent on purchasing the

court fees. Registry is directed to prepare a decree sheet accordingly.