

(2014) 04 DEL CK 0215
In the Delhi High Court
Case No : CS(OS) 1712/2005

M/s. S. Oliver Bernd Freier GMBH and CO. KG	APPELLANT
Vs	
M/s. Jaikara Apparels and Another	RESPONDENT

Date of Decision : 22-04-2014

Acts Referred:

Trade Marks Act, 1999 — Section 134, 135, 2(1)(zg), 29

Citation : (2014) 210 DLT 381 : (2014) 59 PTC 334

Hon'ble Judges : Rajiv Sahai Endlaw, J

Bench : Single Bench

Advocate : Pankaj Kumar, Advocate for the Appellant

Judgement

Rajiv Sahai Endlaw, J.—The plaintiff has instituted the present suit u/s 134 & 135 of the Trade Marks Act, 1999 for the relief of permanent injunction to restrain passing off and infringement of its trade mark S. OLIVER, and for ancillary reliefs of delivery up and rendition of accounts, pleading:

(I) that the plaintiff is a company duly organized under the laws of Germany, and engaged in the business of manufacture and trade of a wide range of fashion and lifestyle products which principally include clothing, readymade garments and fashion accessory products;

(II) that the plaintiff, since the year 1979, has been continuously and commercially using the trade mark S. OLIVER in the course of trade as proprietor thereof, in relation to the said goods and business, and has built up a globally valuable goodwill/reputation thereunder;

(III) that the plaintiff's trademark S. OLIVER is duly registered in favor of the plaintiff in India under the Trade Marks Act, 1999 in relation to articles of clothing (Class 25) since 29.12.1989;

(IV) that with the advent of e-commerce, the internet and trade thereunder, the plaintiff has also adopted the said trade mark S. OLIVER as an essential and

material part of its Email ID and Domain Name;

(V) that the plaintiff is the proprietor of the said Trade Mark, Trade Name and Domain Name by virtue of the aforementioned registration under the Trade Marks Act in its favor, as well as under common law;

(VI) that the said Trade Mark, Trade Name and Domain Name are also Well-Known Trade Marks within the meaning of Section 2(1)(zg) of the Trade Marks Act;

(VII) that the plaintiff's said Trade Mark, Trade Name and Domain Name, as well as the goodwill/reputation thereunder, has a strong presence in India, inasmuch as its goods (including through e-commerce) have been available in India from the very beginning and have been retailed in India at least for the last about 10 years (at the time of institution of the suit in 2005);

(VIII) that in or about August 2003, the plaintiff learnt of the impugned adoption, with respect to the same goods, of the trade mark OLIVER by the defendant No. 1 M/s. Jaikara Apparels, the sole proprietorship firm of defendant No. 2 Sh. Vimal Thakral, when the defendants impugned trade mark was advertised under the Trade Mark Journal;

(IX) that the plaintiff accordingly filed a Notice of Opposition to the impugned trade mark of the defendants and which was pending before the Registrar, Trade Marks at the time of institution of the suit; and,

(X) that upon being subsequently advised that injunction and other related reliefs can only be granted in a separate action in a Court of Law, the plaintiff decided to institute the present suit for the aforementioned reliefs.

2. Summons in the suit were issued on 15.12.2005 and a Local Commissioner appointed at the instance of the plaintiff to visit the premises of the defendants and make an inventory of the goods and packages with the impugned trade mark/label.

3. The defendants thereafter filed a written statement whereunder they claim to have adopted the impugned trade mark/label in the year 1992 and assert to have used it continuously on an extensive commercial scale since then, without reference, aid or inspiration from the plaintiff. They have thus defended their use of the impugned trade mark/label on the basis of the law of honest adoption, honest and concurrent user, and special circumstances. The defendants have also accused the plaintiff of delay and laches and alleged that the plaintiff knew about the impugned trade mark/label of the defendants in August, 2002 itself (as opposed to August, 2003 claimed by the plaintiffs in the plaint), when the defendant had filed a Notice of Opposition against an application moved by the plaintiff before the Registrar, Trade Marks. The defendants have further pleaded that the disputes between the parties regarding the impugned trade mark being pending before the Registrar Trade Marks, this Court should stay its hands from granting an injunction with respect thereto. Lastly, the defendants have objected

to the jurisdiction of this Court on the ground that the plaintiff's goods have no presence in India.

4. The plaintiff filed a rejoinder wherein it has clarified that it learnt of the adoption of the impugned trade mark/label of the defendant in August, 2003 only and not in August, 2002 as suggested by the defendants in their written statement. It has otherwise denied all the averments in the written statement and reiterated the pleas taken in the plaint.

5. The parties to the suit thereafter took several adjournments in an attempt to settle the matter and as a result, the suit dragged on for nearly seven years after admission/denial of documents was completed on 08.09.2006. Finally, this Court on 09.05.2013, upon there being no appearance on behalf of the defendants despite the matter having been passed over, directed the defendants to be proceeded ex-parte and granted an injunction against the defendants selling their goods under the impugned trade mark/label, till the disposal of the present suit. However, the plaintiff has still not tendered its ex-parte evidence till now and therefore when the matter has been listed today, I have in light of my judgment in *The Indian Performing Right Society Ltd. Vs. Gauhati Town Club and Another*, -wherein I have held that where the defendant is ex parte and the material before the court is sufficient to allow the claim of the plaintiff, the time of the court should not be wasted in directing ex parte evidence to be recorded and which mostly is nothing but a repetition of the contents of the plaint - perused the pleadings and the documents to ascertain whether the plaintiff is entitled to a decree forthwith.

6. The plaintiff has, inter alia, relied upon the following documents in support of its case:

(I) The Label/Trade Mark/Representation of the plaintiff (Annexure - P1);

(II) The Label/Trade Mark of the defendants (Annexure D1). The said document stands admitted by the defendant and has thus been exhibited as Ex P1/D1;

(III) Trade Mark Registration in favor of the plaintiff and Renewal Certificates thereof (Annexure P2);

(IV) Copies of Certificate of Registration of the plaintiff in other parts of the world (Annexure P3);

(V) Sales Figures and Promotional Expenses of the plaintiff (Annexure P4 and Annexure P5 respectively);

(VI) Copy of the Trade Mark Journal in which the defendants application of the trade mark OLIVER was advertised and the Notice of Opposition filed thereto by the plaintiff; and,

(VII) Copies of Bills/Invoices in support of user of plaintiff's trademark S.OLIVER in India.

7. The defendants on the other hand, have inter alia filed copies of its list of dealers, sales figures, sales tax registration certificates, advertisement bills, packing material/stickers and bills/invoices under the trade mark OLIVER since the year 1992.

8. There is also on record the report of the Local Commissioner appointed by this Court vide order dated 15.12.2005. The Local Commissioner in his report has recorded the discovery of several stitched suits, trousers, tags, buttons, labels and other packaging material under the brand name OLIVER in one of the premises of the defendants.

9. I would first deal with the primary relief of restraining the defendants from passing off and/or infringing the trade mark of the plaintiff. A comparison of the labels/trade marks of the plaintiff and the defendant (Annexure P1 and Ex P1/D1 supra respectively) reveals little similarity. However, it cannot be denied that the two trademarks are phonetically nearly identical. In fact, both the trademarks sound the same, barring the prefix "S" to the trademark of the plaintiff, which in any case is highly susceptible to be ignored, neglected or overlooked. Such similarity is all the more deceptive considering that both parties are dealing in the same goods. It may be noted that the Supreme Court in K.R. Chinna Krishna Chettiar Vs. Shri Ambal and Co., Madras and Another, clarified that ocular comparison is not always the decisive test and that the resemblance between two marks must be considered with reference to the ear as well as the eye. There is thus, in my opinion, on account of the close affinity of sound between the two trade marks, a very high likelihood of the public confusing the goods of the defendant as having an association with those of the plaintiff.

10. It is also evident from the documents on record that the registration of the trademark by the plaintiff in 1989 precedes the adoption by the defendant of its trademark in 1992. Further, the plaintiff has also established the presence of its goods in India vide the bills/invoices raised by it on Indian retailers. Once deceptive similarity with respect to a registered trademark is evident, there is also no reason for the Court to refuse injunction merely because the Registrar, Trade Marks is seized of the matter pertaining to the challenge by the plaintiff to the application for registration of the defendant's trademark. I also do not find the plaintiff to be guilty of such delay or laches so as to preclude it from the relief of infringement of trademark within the meaning of Section 29 of the Trade Marks Act. Reference in this regard may also be made to Annul Industries Vs. Shiva Tobacco Company, where this Court, after an extensive review of case law on this subject, concluded that mere delay is not sufficient to defeat grant of injunction in cases of infringement of trademark since delay cannot be a bar to enforce and claim a legal right. Accordingly, a decree in terms of prayer paragraph 31(a)(i) is passed forthwith.

11. However, it has to be kept in mind that the defendant has also been using its trademark continuously on a considerable commercial scale since as far back as 1992 with little similarity in the visual appearance of the label/trademark used

with that of the plaintiff. There is thus a high possibility of the impugned adoption being innocent and without any motive to ride on the goodwill/reputation of the plaintiff. In such circumstances, I do not deem it appropriate to saddle the defendants with damages or rendition of accounts and believe the grant of injunction to be sufficient in the facts of the present case.

12. The suit is accordingly decreed in the aforesaid terms. The plaintiff having not rendered any assistance in the expeditious disposal of the suit; no costs.

Decree sheet be prepared.