

(2019) 02 DEL CK 0118

In the Delhi High Court

Case No : Civil Suits (COMM) 335 Of 2018, Miscellaneous Application No. 10666 Of 2014

Shree Rajmoti Industries

APPELLANT

Vs

Rajmoti Foods Products

RESPONDENT

Date of Decision : 07-02-2019

Acts Referred:

Trade Marks Act, 1999 — Section 2(c), 18, 29, 29(1), 29(2), 29(5), 135(2)(c)

Citation : (2019) 02 DEL CK 0118

Hon'ble Judges : Prathiba M. Singh, J

Bench : Single Bench

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

Judgement

Prathiba M. Singh, J

1. Plaintiff - M/s Shree Rajmoti Industries has filed the present suit seeking permanent injunction restraining infringement of trademark, passing off, delivery up, etc.

2. Plaintiff avers that it adopted the mark "RAJMOTI" in the year 1962 as a trademark, trade name and a prominent part of its trading style. The mark "RAJMOTI" is registered both as a word mark and as a label mark in various classes including classes 29, 31, 32, 35 & 42. The Plaintiff is primarily using the mark "RAJMOTI" in respect of edible oil. The products of the Plaintiff are also advertised and publicised through the website www.rajmoti.com. The Plaintiff also claims to have copyright registrations in "RAJMOTI" label and artistic style of writing. Along with the plaint, the Plaintiff has placed on record the sales figures from 1996 till 2004, which show that the annual sales were more than Rs.200 crores.

3. The Plaintiff came to know of a trademark application filed by the Defendant - M/s Rajmoti Foods Products seeking registration of the mark "RAJMOTI BRAND".

The application of the Defendant bearing no.2322047 in class 30 is based on claim of user since 1st April, 1995 for the following products.

"flour and preparations made from cereals, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces, (condiments); spices; ice."

4. The case of the Plaintiff is that, use of the word "RAJMOTI" both as a trademark and in the logo as also part of the trading style of Defendant, constitutes infringement and passing off. The suit is, accordingly, filed seeking the following reliefs.

"(a) For a decree of permanent injunction restraining the Defendant by itself as also through its individual proprietors, partners, directors, agents, representatives, distributors, assigns, stockiest(s) and all others acting for and on behalf of the Defendant from manufacturing, using, selling, soliciting, exporting, displaying, advertising or by any other mode or manner dealing with or carrying on their impugned goods and business of flour, flour and preparations made from cereals, coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour, bread, pastry and confectionery, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces, (condiments); spices; ice and allied/ cognate goods or any specification of goods and business under the impugned Trademark/Label bearing the word/mark RAJMOTI BRAND or any other Trademark/Label identical with or deceptively similar to the Plaintiffs aforesaid Trademark/Trade Name consisting of the word RAJMOTI or from doing any other acts amounting to or likely to-

(i). Infringing the registered Trademarks of the Plaintiff under No. 289191 in class 29, 791444 in class 29, 1318742 in class 29, 1345896 in class 31, 1380312 in class 32, 1380308 in class 35 and 1380304 in class 42.

(ii). Passing off and violate the Plaintiff's rights in Plaintiffs aforesaid Trademark/ Label RAJMOTI.

(iii). Violating the Plaintiff's rights in Plaintiffs aforesaid Trade name consisting of the word RAJMOTI.

(iv). Violating the Plaintiff's rights in Plaintiffs aforesaid domain name www.rajmoti.com consisting of the word RAJMOTI.

(b). Restraining the Defendant from disposing off or dealing with its assets including its shops and premises at M/s Rajmoti Foods Products, Survey No.167/1, Plot No.1, Opp.-Gate of Shantidham Society, Veraval (Shapar), Tai: Kotda Sangani, Dist. Rajkot, Gujarat, Maharashtra and its stocks-in-trade or any other assets as may be brought to the notice of this Hon'ble Court during the course of the proceedings and on the defendants disclosure thereof and which the defendants 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

Trademarks Act, 1999 as it could adversely effect the Plaintiff's ability to recover the costs and pecuniary relief thereon.

(c) For an order for delivery up of all the impugned finished and unfinished materials bearing the impugned and violative Trademark/Trade Name 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.

(e) For an order for cost of proceedings,"

5. The suit was first listed on 28th May, 2014 when this Court had issued notice in the interim injunction application and then appointed a Local Commissioner. The local commission was, however, not got executed by the Plaintiff. The summons and notices were also received back on the ground that the premises were found locked. Since the Defendant could not be served, the Plaintiff sought substituted service in the matter and finally publication was carried out by the Plaintiff. On 13th March, 2018, the Defendant was proceeded ex-parte. Affidavit by way ex-parte evidence was directed to be filed. Ld. counsel for Plaintiff relies on various judgments of this Court to submit that in the cases where Defendants do not put in appearance, there is no requirement of filing of evidence.

6. Ld. counsel for the Plaintiff, prays for a permanent injunction on the ground that filing of the trademark application itself is sufficient evidence of an intention to use by the Defendant. Ld. counsel for the Plaintiff submits that filing of the trademark application with a claim of user itself shows that Defendant intends to use the mark and the same constitutes use as per the Trade Mark Act, 1999 (hereinafter "Act"). He relies on the observations in the order passed by this Court in CS (COMM) 365/2016 to the following effect.

"6. It is the settled position that when the Defendant is ex-parte, the formality of filing of evidence can be dispensed with as laid down by this Court in Everstone Capital Advisors Pvt. Ltd. & Anr. v Akansha Sharma & Ors., CS(COMM) 1028/2016, (judgment dated 17th July, 2018). Thereafter, it was recorded by the Joint Registrar that the learned counsel for the Plaintiff wishes to withdraw the suit. However, on the last date, learned counsel for the Plaintiff had sought time to take instructions from the Plaintiff. Learned counsel for the Plaintiff, upon instructions, now submits that since the Defendant had adopted the mark illegally and had used the mark for some time, the interim injunction should be made absolute and a permanent injunction ought to be granted.

7. The plaint and the documents filed clearly reveal that the word "PARAS" has acquired distinctiveness as being associated with the products and business of the Plaintiff. The Plaintiff's mark being well known in the area of milk and milk products, use of the same in respect of edible oil, fats, milk and other products used in the kitchen, results in violation of the Plaintiff's rights and the same would constitute passing off. Edible oil fats, milk and dairy products, vanaspati edible oil are identical as also allied and cognate to milk and milk products. The

Defendant had also claimed user of the mark since 2000 as per the trademark application, which was filed, though, the same has now been abandoned pursuant to the opposition proceedings filed by the Plaintiff. The report of the Local Commissioner also reveals that the Defendant was in fact using the mark until six months prior to the execution of the commission."

7. Plaintiff also relies upon the following other judgments.

1) Analco (India) Pvt. Ltd. v. Navodya Exim Pvt Ltd., 2014 (58) PTC 585 (Del)

2) KRBL Limited v. Ramesh Bansal & Anr., 2009 (41) PTC 114 (Del)

8. This Court has heard Id. counsel for the Plaintiff. The Plaintiff's mark RAJMOTI and the mark applied for by the Defendant are extracted hereinbelow:

9. There is no doubt that the Defendant has applied for registration of the mark "RAJMOTI", which is identical to that of the Plaintiff. A perusal of the Defendant's trademark application shows that the Defendant is not only claiming user of the mark "RAJMOTI" from 1st April, 1995 but is also using the trading style "Rajmoti Foods Products". The products, for which the Defendant has made the application, are in class 30. The trademark "RAJMOTI" is registered in favour of the Plaintiff, both as a label mark and a word mark. The essential and prominent feature of the various labels used by the Plaintiff is the word "RAJMOTI". The Plaintiff has been diligent in protecting its rights, inasmuch, as soon as it acquired the knowledge of the Defendant's mark, it immediately filed objections to the same before the Trademark Registry. Further, in the present suit, steps have been taken for serving the Defendant repeatedly. The service report, which is on record, shows that the Bailiff, who was appointed, has given a report that the factory of the Defendant was closed. The Bailiff, in fact, visited the premises of the Defendant on 25th July, 2014 and 1st August, 2014.

10. The Bailiff had visited the address of Defendant as given in the trademark application i.e. at Rajkot, Gujarat. Clearly, therefore, after filing of the trademark application, at some point the Defendant appears to have either moved its premises or stopped its business altogether.

11. The publication having been affected and the Defendant having not been served, the only question that remains is as to whether the mere filing of a trademark application entitles the Plaintiff for a permanent injunction. This Court has held in Everstone Capital Advisors Pvt Ltd. & Anr. v. Akansha Sharma & Ors. [CS(Comm)1028/2016 decided on 17th July, 2018] that the requirement of leading evidence can be dispensed with if the Defendant chooses not to appear and contest the case. Thus, the Defendant having been proceeded ex-parte and the Plaintiff having filed its evidence by way of affidavit, oral testimony can be dispensed with.

12. The registrations of the Plaintiff for the mark "RAJMOTI" are not in question. The same are part of public record and copies of the registration certificates have been placed on record. The earliest registration of the Plaintiff dates back to

1973. Several orders of this Court have been placed on record wherein the Plaintiff's trade mark "RAJMOTI" has been protected. The same include orders dated 29th September 2004, 14th July 2005, 31st

13. The only question that remains is whether filing of the trade mark application, by itself, is sufficient to maintain a suit for infringement of trade mark. In *Analco (India) Pvt. Ltd. v. Navodya Exim Pvt Ltd.*, 2014 (58) PTC 585 (Del), a Id. Single Judge of this Court has held as under:

"12. It is also settled proposition of law that even filing of application for registration of the trade mark, shows the intention on the part of the person to use the same in due course. The suit for passing of an infringement is maintainable and in anticipation."

14. A similar view was also taken in the context of quia timet actions in the judgment in *KRBL Limited v. Ramesh Bansal & Anr.*, 2009 (41) PTC 114 (Del). The Court observed that a trademark application reflects the intention of the Defendant to use the mark in the course of trade.

15. Under the Trade Marks Act, 1999, a trademark application is filed by any applicant, who wishes to register the mark. The filing of the application means that the person concerned is either already using the mark or intending to use the mark in the course of trade. The application under Section 18 of the Act can be filed only by a person, who claims to be the proprietor of the trademark, either by user or proposed user. Thus, for every trademark application, the person filing, has to do so with the intention of claiming proprietary rights in the mark.

16. In the present case, the trademark application has been filed by the Defendant clearly making a representation that the same is in use from 1995. The question as to whether the claim of user is genuine or not is not to be gone into in this case, inasmuch as, the suit is based only on the basis of the trademark application. The date of application is 25th April, 2012. Thus, on the date when the application is made, the Defendant claims a user of 17 years in the mark "RAJMOTI". There is no reason why this Court should not accept the representation made by the Defendant on its own, in its trademark application. The trademark application being based on use of a mark under Section 2(c) of the Act, use of a mark can be "upon goods or in any physical or in any other relation whatsoever, to such goods." Filing of a trademark application constitutes "use in relation to goods." Thus, the same would constitute infringement under Section 29 of the Act. Moreover, the Defendant has not just adopted the word "RAJMOTI" as a trademark, but has also sought use of the same in the form of its trading style "Rajmoti Foods Products".

17. The filing of the application is clearly an imminent and a grave threat that if the mark is not already in use, it is likely to be used. The Defendant having chosen not to appear in the present case, and having expressed a clear intention to use the mark, by filing an application, the Court has to conclude that the same

is adoption and use of the mark "RAJMOTI". The Plaintiff's trademark "RAJMOTI" has been in use since at least 5 decades. The Plaintiff is the prior user and the prior adopter of the mark. Use of a mark either upon goods or as a trading style would constitute violation of the Plaintiff's rights under Section 29(1), 29(2) and 29 (5) of the Act.

18. Accordingly, the Plaintiff is entitled to a decree of permanent injunction. The suit is decreed and a decree of permanent injunction is granted in favour of the Plaintiff against the Defendant from using the mark "RAJMOTI" either as trademark or as a trade name in relation to food products or any other goods which are cognate and allied to edible oil. Since there is no actual damage or sale of products which has been shown on record, the Plaintiff is not entitled to the remaining reliefs. Decree sheet be drawn up. All pending I.A.s are disposed of.