

(2018) 12 DEL CK 0301

In the Delhi High Court

Case No : Civil Suits (COMM) 1196 Of 2016

XEROX Corporation & Anr

APPELLANT

Vs

P K Khansaheb & Anr

RESPONDENT

Date of Decision : 03-12-2018

Acts Referred:

Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 — Section 35(3)(d)
Delhi High Court (Original Side) Rules, 2018 — Rule 1, 1(a), 2, 2(ii), 3, 6, 7, 7A, 11, 14, 16
Code of Civil Procedure, 1908 — Order 8 Rule 1A, Order 11 Rule 1, Order 19 Rule 2, Order 18 Rule 3, Order 11 Rule 3, Order 19 Rule 3, Order 18 Rule 4(1), Order 11 Rule 5, Order 7 Rule 14, Order 11 Rule 15

Citation : (2018) 12 DEL CK 0301

Hon'ble Judges : Prathiba M. Singh, J

Bench : Single Bench

Advocate : Shwetasree Majumdar, Eva Bishwal, Ravi Gupta, N.K. Bhardwaj, Bikas Ghorai, Sachin Jain

Judgement

Prathiba M. Singh, J

O.A. 130/2018

1. The present suit was filed in the year 2014 seeking permanent injunction restraining infringement of the trademark XEROX. The allegation in the plaint is that the Defendant - Parle Products Pvt. Ltd. commenced use of the word ZEROX in various television commercials and advertising in a generic manner. Thus, the suit seeks a permanent injunction against the Defendant from using the word ZEROX or any other mark identical or similar to the Plaintiff's registered trademark XEROX. On 13th August, 2014, this Court had granted an interim injunction in the following terms:

"...

I have heard learned senior counsel for the plaintiffs and also perused the plaint,

application and the documents filed along with the plaint. I am satisfied that it is a fit case for grant of ex parte ad interim injunction. Accordingly, till the next date of hearing, defendants, their principal officers. Directors, partners, representatives, franchises, stockists, dealers and agents, or any other person claiming under or through them or acting in concert with them or otherwise are restrained from using the mark ZEROZ or any other trade mark deceptively/ confusingly similar to the plaintiffs' trade mark in any form of advertisement whether in print or visual media, or in any other manner.

Plaintiff shall comply with the provisions of Order XXXIX Rule 3 CPC within four days from today."

2. The Defendant took a plea that the mark XEROX of the Plaintiff is a dictionary word and is not a trademark of the Plaintiff. The defence raised by Defendant - Parle Products Pvt. Ltd., is that Xerox is used as a verb and not as a mark. The following issues were struck in the matter on 16th May, 2017:

"(1) Whether the suit is not filed by an authorised person, as alleged? OPD

(2) Whether the mark has become public juris, as alleged? If so, to what effect? OPD

(3) Whether the plaintiff is a registered proprietor of the mark XEROX under the Trademarks Act, 1999? If so, to what effect? OPP

(4) Whether the plaintiff is the proprietor of the mark XEROX under the common law? If so, to what effect?

OPP

(5) Whether the defendants are guilty of infringing the registered trademark XEROX of the plaintiff? If so, its effect? OPP

(6) Whether the defendant are guilty of unfair trade practices and/or violation of other common law rights of the plaintiff? If so, its effect? OPP

(7) In view of the above whether the plaintiff is entitle to a decree of injunction(s) as prayed? OPP

(8) Whether the plaintiff is entitle to a decree of Rs.25 lakhs for damages, as prayed? OPP

(9) Relief, if any"

3. The Plaintiff filed affidavit-in-evidence of its Executive Director (Legal) - Ms. Deepika Chaudhary. The said witness, attached with her affidavit various exhibits numbered as EX.-PW1/1 to EX.-PW1/23. Out of the said exhibits, EX. PW-1/2 to EX. PW-1/5 were various copies of Powers of Attorney, letters of authority and Board Resolutions, tracing her authority to sign the plaint and to depose. EX. PW-1/7 is a registration certificate accessed from online sources showing registration of the mark in various jurisdictions. EX. PW-1/9 and EX. PW-1/11 are

extracts from the annual reports of the plaintiff for various years including 2010-14 and 2016. EX. PW-1/12 is a copy of the advertisement issued by the Plaintiff from time to time. Finally, EX. PW-1/16 are copies of orders passed by the WIPO Arbitration and Mediation Centre. The said witness appeared before the Joint Registrar on 25th September, 2018 on which date, the Joint Registrar exhibit marked all the documents referred to in the affidavit and adjourned the matter at the request of the Defendant for cross-examination. The Joint Registrar however, noted all the objections raised by the Defendants and observed that the documents are exhibited subject to the objections which shall be decided at the final hearing.

4. OA No.130/2018 has been filed challenging the said order dated 25th September 2018

5. The main grievance of the Defendant in the appeal is that the Joint Registrar could not have permitted the documents from being exhibited without the Plaintiff seeking leave of the Court under the Delhi High Court (Original Side) Rules, 2018 (hereinafter, "DHC (OS) Rules"). Mr. Ravi Gupta, Senior Counsel submits that the documents ought to have been filed with the pleadings and not with the affidavit-in-evidence. The objections raised by the Defendant ought to have been sent to the Court instead of the Joint Registrar observing that the objections would be decided at the final stage. He relies upon the following decisions:

? Sudhir Engineering Co. v. Nitco Roadways Ltd. 1995 (34) DRJ 86;

? Shail Kumari v. Saraswati Devi 2002 (96) DLT 131;

? Surender Bala v. Sandeep Foam Industries P. Ltd. 2000 (85) DLT 478;

? Exide Industries Ltd. v. Exide Corporation USA & Ors. 2014 (58) PTC 200 (Del); and

? Bipin Shantilal Panchal v. State of Gujarat & Ors. AIR 2001 SC 1158

6. Mr. Gupta further points out to the Court that under Rule 14 of Chapter VII of the Delhi High Court Rules, all documents ought to have been filed with the pleadings itself and it is not permissible for any party to file any documents after completion of pleadings.

7. On the other hand, counsel for the Plaintiff - Ms. Shwetasree Majumdar submits that most of the documents are already referred to in the pleadings and no new case is sought to be introduced by way of the documents. She also relies upon the following decisions:

? Billa Jagan Mohan Reddy and Ors. v. Billa Sanjeeva Reddy and Ors. (1994) 4SCC 659

? Kirpal Chand and Ors. v. Skipper Construction Co. Pvt. Ltd. And Ors. 98(2002) DLT 201

? Kirpal Chand & Others v. Skipper Construction Co. Pvt. Ltd. & Ors 2002(63) DRJ 475

8. This Court has heard the counsel for the parties. It is usual to see in original side suits that documents are annexed/attached with affidavits-in-evidence.

9. As per the DHC (OS) Rules and the CPC, there is no doubt that parties have to file all the documents in their power and possession at the time of filing of the suit. This suit is governed by the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 (hereinafter, "Commercial Courts Act") after it has been enacted. However, at the time of the filing of the suit, the Commercial Courts Act had not yet been enacted.

10. The suit was converted into a commercial suit vide order dated 30th August, 2016. At that stage, the admission/denial of documents was not concluded. The Plaintiff ought to have placed all the documents in its power and possession at that stage itself when the suit was converted into a commercial suit. However, the Plaintiff has chosen to file some documents along with her affidavit-in-evidence. The question that arises is as to whether the documents ought to have been exhibited or should the matter have been placed before the Court before exhibiting of the documents.

11. As per the prescribed procedure, documents ought to be filed with the pleadings or prior to settlement of issues. If documents have to be filed after the settlement of issues, leave of the court has to be sought.

12. It is however noticed that in a large number of affidavits, which are filed and tendered as examination-in-chief, documents are attached with the said affidavits. The said documents, so long as they are within the pleadings or relate to developments subsequent to the filing of the suit or at the stage of admission/denial, ought not to be refused even if filed with the affidavit-in-evidence, in as much as at the time of preparation of evidence, it is usual for witnesses to trace out documents in support of their testimony and attach the same. This happens not just with expert witnesses but also with witnesses who appear on behalf of the parties. The reason for this is not far to seek. The CPC, though prescribes a schedule for filing of documents, the consistent view of the Supreme Court and this Court has been that if the documents are relevant, the same are not rejected. This can be seen from a perusal of the following judgments, Bipin Shantilal Panchal v. State of Gujarat & Ors (supra), where the Supreme Court observed as under:

"13. It is an archaic practice that during the evidence collecting stage, whenever any objection is raised regarding admissibility of any material in evidence the Court does not proceed further without passing order on such objection. But the fall out of the above practice is this: Suppose the trial Court, in a case, upholds a particular objection and excludes the material from being admitted in evidence and then proceeds with the trial and disposes of the case finally. If the Appellate or Revisional Court, when the same question is recanvassed, could take a

different view on the admissibility of that material in such cases the Appellate Court would be deprived of the benefit of that evidence, because that was not put on record by the trial Court. In such a situation the higher Court may have to send the case back to the trial Court for recording that evidence and then to dispose of the case afresh. Why should the trial prolong like that unnecessarily on account of practices created by ourselves? Such practices, when realised through the course of long period to be hindrances which impede steady and swift progress of trial proceedings, must be recast or remoulded to give way for better substitutes which would help acceleration of trial proceedings.

14. When so recast, the practice which can be a better substitute is this: Whenever an objection is raised during evidence taking stage regarding the admissibility of any material or item of oral evidence the trial Court can make a note of such objection and mark the objected document tentatively as an exhibit in the case (or record the objected part of the oral evidence) subject to such objections to be decided "at the last stage in the final judgment. If the Court finds at the final stage that the objection so raised is sustainable the Judge or Magistrate can keep such evidence excluded from consideration. In our view there is no illegality in adopting such a course. (However, we make it-clear that if the objection relates to deficiency of stamp duty of a document the Court has to decide the objection before proceeding further. For all other objections the procedure suggested above can be followed).

15. The above procedure, if followed, will have two advantages. First is that the time in the trial Court, during evidence taking stage, would not be wasted on account of raising such objections and the Court can continue to examine the witnesses. The witnesses need not wait for long hours, if not days. Second is that the superior Court, when the same objection is recanvassed and reconsidered in appeal or revision against the final judgment of the trial Court, can determine the correctness of the view taken by the trial Court regarding that objection, without bothering to remit the case to the trial Court again for fresh disposal. We may also point out that this measure would not cause any prejudice to the parties to the litigation and would not add to their misery of expenses."

13. A Division Bench of this Court in *Exide Industries Ltd. v. Exide Corporation USA & Ors.* 2014 (58) PTC 200 (Del), held as under:

"6. In our opinion, the appeal is premature inasmuch as the question whether the documents should at all be received or accepted as evidence is a matter that can be decided by the learned Single Judge at the time of final hearing of the case. Presently, no serious prejudice is caused to any of the parties if cross-examination of the witness is conducted by the Appellant on the basis of the documents attached to the affidavit by way of evidence. Needless to say that the Local Commissioner would be obliged to record the objections that the Appellant has to the reception of these documents.

7. The issue whether the documents should at all be received and their

admissibility will, of course, be decided by the learned Single Judge at the time of final hearing of the case. We need not express any opinion on this, one way or the other."

14. What is the procedure to be followed in case documents are attached with the affidavit-in-evidence? Is the Joint Registrar required to place the case before the Court before recording the examination-in-chief when the affidavit-in-evidence is filed with documents? As per the procedure, examination-in-chief and exhibit marking is required to be done when the witness is present. The exhibition of documents which are filed with the affidavit-in-evidence is a process which is performed in front of the Joint Registrar/Local Commissioner and if in each and every case where the affidavit is filed with documents, the matter is placed before the Court, it would in effect mean that no evidence can be recorded on the said date. The purpose of recordal of evidence by affidavit and expeditious recordal there to would completely be defeated. With this object in mind, Order XVIII Rule 4(1), provides as under:

"Order XVIII Rule 4. Recording of evidence:- (1) In every case, the examination-in-chief of a witness shall be on affidavit and copier thereof shall be supplied to the opposite party by the party who calls him for evidence.

Provided that where documents are filed and the parties rely upon the documents, the proof and admissibility of such documents which are filed along with affidavit shall be subject to the orders of the Court."

15. Even, the DHC (OS) Rules specifically have a provision in respect of objections to exhibition of documents in Chapter XI Rule 11. The same reads as under:

"Chapter XI Rule 11.

Objections to exhibition of documents. - (i) Objection(s) to exhibiting any document or its production, shall be recorded to be decided at the time of decision of the suit/ other original proceeding or at such time as the Court considers appropriate

(ii) In case, the Registrar/ Commissioner considers that the objection(s) needs to be decided forthwith, he shall place the matter before Court, without delay after recording of reasons for the same."

16. Further, in amendments to the DHC (OS) Rules, that have been introduced w.e.f. 1st November, 2018, the Rule with respect to documents has also been considerably streamlined and copies of documents are sufficient to be filed and originals need not be filed. The purpose of the DHC (OS) Rules and the amendments thereof is to ensure that documents are not objected to just for the sake for doing so, unless there is a serious allegation in respect of the documents or exhibition thereof such as fraud, forgery, fabrication, etc.

17. Documents that are relevant for adjudication of issues usually ought to be

accepted and taken. The purpose of recordal of examination-in-chief by way of evidence ensures that the affidavit along with all the documents is given in advance to the opposite side so that any objection can be recorded at the time of exhibit marking. The view taken by the Supreme Court in *Bipin Shantilal Panchal v. State of Gujarat & Ors.* 2001 (3) SCC 1 and the Division Bench of this Court in *Exide Industries Ltd. v. Exide Corporation USA & Ors.*, is to ensure that repeated objections are not taken against documents so as to increase the inconvenience to witnesses who have to appear before the Court for recordal of evidence. The procedural safeguard that documents should be filed with pleadings is to ensure that the opposite side has notice of all the documents and by attaching the documents with affidavit-in-evidence and supplying advance copies of the same, that purpose is being satisfied. Thus unless there is an allegation of egregious nature against a particular document, usually documents filed by witnesses, which are broadly within pleadings, ought to be either exhibited or marked at the time of when the same are being tendered after recording all the objections raised by the parties. The said objections should not de-rail the trial of the suit in any manner as it has happened in the present case.

18. A perusal of the order dated 25th September, 2018, shows that though the examination-in-chief was recorded on the 25th September, 2018, the cross-examination has not been conducted till date. It is this delay that could have been completely avoided if the objections were recorded and the witness was cross-examined on the same date.

19. The documents annexed in the present case clearly show that nine Exhibits are either Powers of Attorney (Ex.PW1/3), Board Resolutions (Exs.PW1/4 and PW1/5), Letters of Authority (Ex.PW1/2) or copies of advertisements of the Plaintiff (Ex.PW1/12). Registration certificates of trademarks (Ex.PW1/7) are easily verifiable online and have already been pleaded in the plaint. The annual report for the years 2010-14 (Ex.PW1/11) could have been filed at the time at the filing of the suit. However, the annual report of 2016 (Ex.PW1/9(colly)), which the witness considered relevant, could not have been filed with the suit which was instituted in 2014. The orders of WIPO Arbitration and Mediation Centre (Ex.PW1/16) are publicly available documents which are in the nature of judgments/orders. None of the documents are of such a nature that go beyond the pleadings or attempt to set up a new case by the Plaintiff. There has been delay by the Plaintiff in filing of these documents which can be suitably compensated at the final stage, if the Court holds against the Plaintiff. The appeal for the above reasons is rejected. The documents shall stand exhibited subject to the objections raised by the Defendant.

20. A conjoint reading of the provisions of the CPC, the Commercial Courts Act and the DHC (OS) Rules 2018 (as notified w.e.f.1st November 2018) requires parties to broadly adhere to the following procedure in respect of documents, admission/denial, exhibit marking and during recordal of evidence.

a) All documents in the power of possession of parties are required to be filed

with the pleadings [Order VII Rule 14 and Order VIII, Rule 1A CPC, Order XI Rule 1 CPC as amended by the Commercial Courts Act, Chapter IV, Rule 1 and Annexure E of the DHC(OS) Rules, 2018, as amended by Notification No.722/Rules/DHC dated 16th October, 2018];

b) Filing of copies is sufficient [Chapter IV Rule 1(a), as amended by Notification No.722/Rules/DHC dated 16th October, 2018];

c) If a party wishes to inspect original documents, notice ought to be given by the counsel and at a mutually convenient date, time and venue, inspection ought to be given within the time stipulated [Order XI Rule 15 & 17 CPC, Order XI Rule 3 CPC as amended by the Commercial Courts Act, Chapter VIII of the DHC (OS) Rules, Chapter VII Rule 2(ii) of the DHC (OS) Rules as amended by Notification No. 722/Rules/DHC dated 16th October, 2018];

d) Affidavits/Statements of admission/denial have to be filed with either the Written Statement or the Replication [Chapter VII Rule 3, Rule 6 and Rule 7 of the DHC (OS) Rules];

e) After inspection is sought and given, a document schedule shall be filed before the Joint registrar, duly endorsed by counsels for all parties [Chapter VII Rule 7A of the DHC (OS) Rules as amended by Notification No.722/Rules/DHC dated 16th October, 2018];

f) Exhibit marking shall be carried out by the Joint Registrar on the basis of the Document Schedule [Chapter VII, Rule 16 of the DHC (OS) Rules as amended by Notification No.722/Rules/DHC dated 16th October, 2018];

g) If any party wishes to file any documents after Issues are struck and the matter has proceeded for evidence, leave has to be sought from the Court [Order XI Rule 5 CPC as amended by the Commercial Courts Act];

h) Affidavits of evidence usually should not have any documents attached to them. Any objections raised in respect of the said documents are to be recorded subject to the orders of the Court.

[Order XVIII Rule 4 (1) CPC, Order XIX Rule 3 CPC as amended by the Commercial Courts Act, Chapter XI Rule 1(ii), Chapter XIX of the DHC (OS) Rules]. However, in respect of such documents attached with the affidavits in evidence, the witness ought to state reasons in the affidavit itself as to why the same were not filed earlier. The said documents have to be within the broad contours of the pleadings and the documents already on record. Advance copies of the same ought to be served.

i) At the time of examination in chief, objections can be raised, which shall be recorded by the Joint Registrar or the Local Commissioner and the trial will continue. No derailment of the trial is permitted, once the witness is present [Order XVIII Rule 4(1) CPC, Chapter XI Rule 11 of the DHC (OS) Rules].

21. Accordingly, the OA stands dismissed.

I.A. 15144/2014 (for stay)

22. The interim order already granted shall subsist during the pendency of the suit. I.A. is disposed of.

I.A. 1185/2015 (u/O XXXIX Rule 2A)

23. In this application, the objection of the Plaintiff is that the Defendants were violating the interim order. The counsel for the Plaintiff submits that after the filing of this application, the Defendants have duly complied with the interim order. Mr. Bhardawaj, Ld. counsel on behalf of the Defendant submits that the interim order shall be complied with and there would be no violation of the same. Accepting the said statement, the I.A. is disposed of.

I.A. 1889/2018

24. This is an application under Order XVIII Rule 2 & 3 seeking clarification that the Plaintiff would be entitled to lead rebuttal evidence in respect of issues on which onus is on the Defendant. The said application is disposed of with the observation that Order XVIII CPC provides for rebuttal evidence to the Plaintiff in respect of issues where onus is on the defendant. Thus, no clarification is required. I.A. is disposed of.

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25. In this matter, mediation was explored earlier. On the last two hearings, i.e. on 16th October, 2018 and 23rd October, 2018, the matter was adjourned in order to enable the Defendant to seek instructions. This was due to the fact that the Plaintiff had made an offer for settlement to the Defendant i.e. that if the Defendant agrees not to re-telecast the television commercial using the word ZEROX or XEROX and withdraw the oppositions filed against the Plaintiff's trade marks, the Plaintiff would be willing to give up its claim for damages and costs. However, the Ld. Counsel for the Defendant has, upon instructions, submitted that the Defendant wishes to contest the matter on merits. The Plaintiff's offer for settlement and the Defendant's stand is being recorded in order to enable the Court to determine costs under Section 35(3)(d) of the Commercial Courts Act as also Chapter XXIII Rule 2 of the DHC (OS) Rules (as amended on 1st November, 2018), in respect of costs of the suit

26. List on the dates already fixed i.e., 17th January, 2019 before the Joint Registrar.