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IN THE HIGH COURT OF DELHI AT NEW DELHI

PRONOUNCED ON: 09.11.2009

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CS (SO) 1946/2008

ASIAN PAINTS LTD.

..... PLAINTIFF

Through : Ms. Archana Sahadeva and Ms. Bitika Sharma, Advocates for
Ms. Pratibha M. Singh, Advocate.

Vs.

M.P. PAINTS & ORS.

..... DEFENDANTS

Through : None

CORAM:

MR. JUSTICE S. RAVINDRA BHAT

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| 1. | Whether the Reporters of local papers may be allowed to see the judgment? | Yes |
| 2. | To be referred to Reporter or not? | Yes |
| 3. | Whether the judgment should be reported in the Digest? | Yes |

MR. JUSTICE S.RAVINDRA BHAT (OPEN COURT)

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1. The plaintiff has filed this suit for permanent injunction, infringement of trademark and copyright, passing off, damages and delivery-up against the defendants who are allegedly involved in the business of manufacturing, selling, offering for sale, advertising, distributing and dealing with paints and other allied products under the marks or labels “EUROASIAN ACRYLIC FINISH DISTEMPER” “SUPASIAN ACRYLIC FINISH DISTEMPER” and “SUPASIAN WATER THINNABLE CEMENT PRIMER”, which contain the word ASIAN and other words or marks deceptively similar to the plaintiff’s mark “ASIANPAINTS”.

2. The plaintiff is a company incorporated and registered and is engaged in the business of manufacturing and marketing of paints, varnishes, enamels and other like products and colour concentrates for the last more than 50 years under its prominent and well-known mark as well as

trade name “ASIAN PAINTS”; the mark has been in continuous use since 1952, till date and is exclusively identified with the plaintiff, as being distinctive plaintiff’s goods and is also a well-known mark under Section 2(1)(zg) of the Trade Marks Act, 1999. Thus, the plaintiff claims to have acquired common law rights therein. It is claimed that the plaintiff’s group companies operate in 20 countries across the world and have manufacturing facilities in each of them. The group operates in five regions across the world viz. South Asia, South East Asia, South Pacific, Middle East and Caribbean Region. As such the plaintiff enjoys extensive international presence. **The plaintiff states being the market leader in its field.** The plaintiff claims that its products are marketed under distinctive brand names in containers and packaging bearing a distinctive trade dress and get-up.

3. It is stated that the plaintiff company has, since its inception in the year 1945, coined and adopted and extensively used the trade mark/name ASIAN PAINTS. By virtue of this, the said trade mark/name has acquired secondary meaning and is instantly associated with the plaintiff. The plaintiff claims to have registered its mark “ASIAN PAINTS” (label) under Class 2 on 17.02.2000. Plaintiff enjoys registration for various other marks under Class 2. Plaintiff also has copyright registrations in its favour for the artistic works involved in the marks ASIAN PAINTS (A-51166/91) and the device of GATTU (A-51167/91). Apart from domestic registrations the plaintiff also claims to have registrations in Sri Lanka, Bangladesh, Bhutan, Kuwait, Qatar, etc.

4. The claimed expenditure on advertisement and gross sales of the plaintiff’s product for the last few years is stated as follows:

Year	Gross Sales (Rs. in Lacs)	Advertisement (Rs. In Lacs)
2001-2002	163525.60	5002.20
2002-2003	185907.40	7076.30
2003 -2004	207985.00	6824.20
2004-2005	223153.20	6991.70
2005-2006	265521.90	9097.30
2007-2008	388920.17	16484.78

5. The suit alludes to the first defendant being a proprietary firm and a member of Indian Small Scale Paint Association (ISSPA). The second defendant is its proprietor. The defendants

are involved in manufacturing paints by the names “EUROASIAN” and “SUPASIAN”. It is alleged that the defendants had even attempted to get their various marks (of which the words ASIAN formed an integral part) registered, but unsuccessfully. The defendants are allegedly manufacturing paint cans under the marks “EUROASIAN ACRYLIC FINISH DISTEMPER” and “SUPASIAN WATER THINNABLE CEMENT PRIMER” which are deceptively similar to its (plaintiff’s) products “ASIAN PAINTS TRACTOR SYNTHETIC DISTEMPER” “ASIAN PAINTS TRACTOR ACRYLIC DISTEMPER” and “ASIAN PAINTS APCOLITE PREMIUM GLOSS ENAMEL”. The defendants are said to have blatantly adopted plaintiff’s portrayal of the said products in such a manner that the differences between the two cannot be brought out upon a bare perusal of the products by the general public and the members of the trade, who could confuse these products as coming from the same source, that is the plaintiff. The plaintiff describes the similarity between the two products as under:

“1. Adoption of the name EUROASIAN and SUPASIAN which is similar to the Plaintiff’s trade mark/trade name ASIAN PAINTS

2. Adoption of similar font and stylized manner of depicting their trademarks: The word ASIAN in the impugned marks is depicted in a font of writing, get-up, lay-out, and artwork which is in a way look-alike and is deceptively similar to the original artistic representation of the word/logo/mark ASIAN and/or ASIAN PAINTS of the Plaintiff. A cursory look at the Defendants’ tin of paints bearing the marks EUROASIAN and SUPASIAN in the above described manner would give one an impression that the same pertains the mark ASIAN and not EUROASIAN or SUPASIAN

3. Adoption of similar trade dress and artwork as that of the Plaintiff’s product.

4. Adoption of the same colour combination as has been used by the Plaintiff on its product.

5. Since both the products are distempers and enamels, the chances of confusion are enhanced.

6. Even the ASIAN PAINTS DRIP, which is unique to the Plaintiff’s product has been copied and has been reproduced in toto on the impugned products by the Defendants.”

The plaintiff alleges that the defendants’ conduct is motivated by malafide, only with an intention to trade on its (the plaintiff’s) goodwill and reputation and play a fraud on the unwary customers. The plaintiff submits that by virtue of being the prior user, adopter and the registered proprietor of the said marks and logos (since 1950s in India and globally since 1978) the exclusive right to

exploit them vests solely with it (the plaintiff). The defendants are in no way connected with the plaintiff; it (the plaintiff) has never authorized, assigned or licensed them (the defendants) to use the said marks or any other mark deceptively similar to its own. On the basis of the above averments it is alleged that the conduct of the defendants, thus, constitutes infringement of rights in the registered trademarks and passing off; infringement of copyright; dilution. The defendants are also said to be operating two websites under the domain names www.euroasian.com and www.mppaints.com

6. The defendants in the matter were proceeded *ex-parte* by order, dated 01.12.2008 and the interim order, dated 16.09.2008 was made absolute. The plaintiff filed affidavit in evidence of Mr. Vinay Bhopatkar, its Divisional Manager- North, which is exhibited as Ex. PW-1/A.

7. The Court has considered the pleadings of the plaintiff and the documents in support of its claim. To establish the volume of sales and the expenditure incurred on advertisement the plaintiff has filed copies of its sales and advertisement invoices, which are exhibited as Ex. PW-1/5 (Colly.) and Ex. PE-1/6 (Colly.) Ex. PW-1/7 (Colly.) is the copies of various advertisement clippings of the plaintiff in various newspapers alongwith copies of invoices for booking advertisement space in various newspapers. The plaintiff has also filed copies of its various trademark registration certificates alongwith their respective legal proceedings as Ex. PW-1/8 (Colly.) and the copies of copyright registration certificates are exhibited as Ex. PW-1/9 (Colly.). Copy of list of various domestic and international trademarks of the plaintiff is exhibited as Ex. PW-1/10. The copies of the trademark journal advertisements of the defendants marks EUROASIAN and SUPASIAN are placed as Ex. PW-1/12 and the copies of the oppositions filed by the plaintiff to the trademark registration applications of the defendants for the marks EUROASIAN and SUPASIAN are placed on record as Ex. PW-1/11 (Colly.). Original photographs of the plaintiff's and the defendants' products are placed on record as Ex. PW-1/13. The internet printouts pertaining to the two websites namely, www.euroasian.com and www.mppaints.com are exhibited as Ex. PW-1/15 and PW-1/16, respectively. The plaintiff further places reliance on various decisions in its favour passed in similar proceedings against various other defendants (Ex. PW-1/14 (Colly.)), e.g. *Asian paints (India) Ltd. v. Asia Paints & Ors.*, CS (OS) 4269/1996; *M/s Asian Paints (I)Ltd. v. M/s Yusuf Paints & Pkg.*, CS (OS) 3749/2000; *Asian Paints (I) Ltd. v. Jaikishan Paints & Allied Products*, CS (OS) 3963/2001; *Asian Paints Ltd. v. Balmukund P. Bhatt*, CS (OS) 1612/2006; *Asian Paints Ltd. v. Rambabu*

Agrawal, CS (OS) 474/2008; and interim orders passed in *Asian Paints Limited v. M/s Chandra Paints & Chemicals*, CS (OS) 1365/2008 and *Asian Paints Ltd. v. Ayush Paints & Chemicals*, CS (OS) 1366/2008

8. The report of the Local Commissioner appointed by the Court by order, dated 16.09.2008 discloses that 2 empty buckets of 4 liters and 10 liters SUPASIAN (Water base Cement Primer) 1 small bucket of EROASIAN (Acrylic Finish Distemper) and another 10 liter bucket of SUPASIAN Acrylic Finish Distemper was found at the defendants' premises. As the defendants in the suit were proceeded *ex-parte* and no steps were taken by them against the said order proceeding them *ex-parte*, the pleas taken by the plaintiff remain uncontroverted. The plaintiff has also established its case through the evidence supplied by it. Therefore the plaintiff is entitled to a decree for permanent injunction.

9. The plaintiff has also sought a decree for rendition of accounts and damages. In view that the defendants did not participate in these proceedings there is nothing available on records to establish the volume of sales and profit earned by them by trading in products bearing the marks in question. Yet, the Court cannot be unmindful of the fact that the Local Commissioner appointed to visit the premises did find product containers bearing the marks in question. In these circumstances the plaintiff is entitled to some measure of damages.

10. In view of the above discussion the suit is decreed in terms of para 31 (a), (b), (d) and (e) of the plaint, with costs. A decree for Damages to the tune of Rs. 1,00,000/- is granted in favour of the plaintiff and against the defendants; Counsel's fee is quantified at Rs. 50,000/-.

November 09, 2009

S.RAVINDRA BHAT
(JUDGE)