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IN THE HIGH COURT OF DELHI AT NEW DELHI

Pronounced on: 19.07.2010

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CS(OS) No. 1366/2008

ASIAN PAINTS LIMITED

.....Plaintiff

Through : Ms. Pratibha Singh and Ms. Archana Sahadev, Advocate.

Vs.

AYUSH PAINTS & CHEMICALS

..... Defendant

Through : Nemo.

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 seeks a decree for permanent injunction to restrain alleged infringement of its trade mark "ASIAN", copyright in the underlying artistic work, passing off etc; other consequential relief, including damages are sought, against the Defendants. The Defendant is a proprietary firm involved in the manufacturing of paints by the name "ASIAN BIRD".

2. By order dated 23.07.2008, an ad interim *ex parte* injunction was by which the Defendant, its principal officers, agents, dealers, distributors etc. and anyone acting for and on its behalf were restrained from manufacturing, selling, offering for sale advertising, distributing or in any other manner dealing with paints or any other allied products under the mark or label "ASIAN BIRD PREMIUM SYNTHETIC ENAMEL" which contained the

word ASIAN or any other word or mark deceptively similar to the Plaintiff's mark ASIAN PAINTS, in cans were are an imitation of the Plaintiff's paint cans and packaging.

3. To establish visual similarity and identity, the plaintiff has produced a photograph, marked as Ex. PW-1/2, at page 687 of the documents. That photograph is reproduced below; the plaintiffs product with its mark, and colour combination are placed on the left; those of the defendant are shown on the right:



4. The Court, by the same order, also appointed a local commissioner, to visit the defendant's premises. The commission was executed on 29.07.2008 and the commissioner's report was filed on 05.09.2008. The report revealed that the Defendant was in possession of infringing material such as finished and unfinished cans of Asian Budget, Asian Glow, Indo Asian, Asian Gold etc.

5. After issuance of summons and making of the *ex parte* injunction order, the Defendant remained unrepresented, despite service of summons; consequently, by order dated 01.10.2008, the court directed the proceedings to be *ex parte*. However, on 22.10.2008 the defendant filed a written statement as well as reply to the injunction application. When the case was listed before the Joint Registrar on 17.12.2008, he noticed that in view of the earlier directions setting the defendant *ex parte*, the defence and the reply filed in the case could not be taken on record. The Plaintiff was, in these circumstances, required to file its *ex parte* evidence.

6. The defendant thereafter preferred an application (IA No. 931/2009) under Order 9, Rule 7, CPC seeking setting aside of the order dated 01.10.2008 by which it was proceeded *ex parte*. When the defendant's application was listed before this Court on 22.01.2009, the Defendant was unrepresented and the said application was dismissed in default.

7. The suit contends that the Plaintiff, since its inception in 1945, has coined, adopted and extensively used the trade mark/trade name ASIAN PAINTS in relation to paints and cognate/allied goods. Thus it claims to be owner, prior user and proprietor of the trademark ASIAN PAINTS in India. In support of this contention, it relies on its Memorandum of Association and Articles of Association produced at Pg. 1-112 of the documents, marked as Ex. PW 1/3; a copy of the Annual Report for the year 2006-07 - (Pg. 113-220 of the documents)-marked as Ex. PW 1/4; original printouts from its website, marked as Ex. PW 1/9 (Colly).

8. The Plaintiff deposes that its sales figures for the year 2007-2008 are ₹ 3889 crores and the corresponding expenditure on advertising is ₹ 164 crores. In support, it relies on copies of sales invoices- marked as Ex. PW 1/6 (colly) and copies of the advertisement invoices-(produced at pages 376-450 of the documents). It also relies on promotional material pertaining to the ASIAN PAINTS mark, in the form of original brochures showing the varied product range of the Plaintiff along with colored copy of the visual identity guidelines of the Plaintiff, produced at pages 501-665 of the documents-and marked as Ex. PW 1/5 (Colly). Copies of advertisement clippings of the Plaintiff in various newspapers along with copies of invoices for booking advertising space in those newspapers are also produced, and relied upon; they are at pages 451-500 of the documents, and marked as Ex. PW 1/8 (Colly).

9. The plaintiff claims proprietorship of various registered trademarks; they are indicated in a tabular forum, below: Trademark Registration Certificates pertaining to the mark ASIAN:

S.No	Mark	Registration No.	Class	w.e.f
1.	ASIAN PAINTS (label)	904238	2	17.02.2000

2.	ASIAN PAINTS with the Device of GATTU (label)	904237	2	17.02.2000
3.	ASIAN PAINTS TOUCH WOOD	1055648	2	31.10.2001
4.	ASIAN PAINTS MELAMYNE GOLD HARDENER (label)	1055653	2	31.10.2001
5.	ASIAN PAINTS TRACTOR	1154821	2	02.12.2002
6.	ASIAN PAINTS (Luxury enamel water based) (label)	1154822	2	02.12.2002
7.	ASIAN PAINTS INTERIOR WALL FINISH MATT	1154823	2	02.12.2002
8.	ASIAN PAINTS WOOD PRIMER	1154824	2	02.12.2002
9.	ASIAN PAINTS ACRYLIC WALL PUTTY	1154825	2	02.12.2002
10.	ASIAN PAINTS Elastomeric (Hi – Performance Exterior Paint)	1154827	2	02.12.2002
11.	ASIAN PAINTS DECOPRIME (Deivce)	1154828	2	02.12.2002
12.	ASIAN PAINTS ACE	1154829	2	02.12.2002
13.	ASIAN PAINTS DECOPRIME	1154830	2	02.12.2002
14.	ASIAN PAINTS PRIMER SEALER	1154831	2	02.12.2002
15.	ASIAN PAINTS PREMIUM EMULSION	1154832	2	02.12.2002
16.	ASIAN PAINTS APCOLITE PREMIUM GLOSS ENAMEL Label	1154834	2	02.12.2002
17.	ASIAN PAINTS TRACTOR Acrylic Distemper (Label)	1154835	2	02.12.2002
18.	ASIAN PAINTS TRACTOR Synthetic Distemper (Label)	1154836	2	02.12.2002
19.	ASIAN PAINTS Label	1154837	2	02.12.2002
20.	ASIAN PAINTS METAL PRIMER	1154838	2	02.12.2002
21.	ASIAN PAINTS APCOLITE (label)	526706	2	23.03.1990
22.	ASIAN PAINTS APCOLITE (label)	910936	2	21.03.2000
23.	ASIAN PAINTS HOME SOLUTIONS (label)	1011636	2	24.05.2001

Copies of Trade Mark Registration Certificates with their Legal Proceedings Certificate, are produced at pages 74-138 of the evidence, and marked as Ex. PW 1/10 (Colly). In addition to all these materials, the plaintiff has produced copyright certificates, in respect of the artistic work underlying its labels, which are marked as Ex. PW 1/11 (colly).

10. It is urged that the term ASIAN PAINTS apart from being used by the Plaintiff as part of its trade name is also used as a trade mark upon and/or in relation to the goods manufactured, and marketed by it since January 1952. The Plaintiff further avers that it also uses ASIAN in relation to its goods since the year 1965. Owing to continuous use of the trade mark ASIAN PAINTS since more than five and a half decades and of the word ASIAN since more than four decades, the marks have acquired a distinct connotation and have come to be exclusively associated with the Plaintiff's merchandise in the minds of the purchasing public and in the trade. Furthermore in the course of the trade, the Plaintiff is commonly referred to as ASIAN and the goods of the Plaintiff are referred to as ASIAN merchandise. By virtue of priority in adoption and continuous use thereof under the said trademarks, the Plaintiff alone has the exclusive right to use the trade marks ASIAN PAINTS, ASIAN and all the other marks wherein the trade mark ASIAN PAINTS forms a leading and an essential part therein. It is further submitted that the reputation and goodwill of the trade mark ASIAN PAINTS and/or ASIAN extends far and wide and beyond the scope of the actual goods manufactured by the Plaintiff and the very mention of the word ASIAN with or without any additions/suffix would normally be co-related with the goods of the Plaintiff and none else.

11. The main defenses of the Defendant in its written statement are:

- a. That the defendant has never manufactured the impugned product;
- b. That it primarily manufactures 20 litre barrel drums and that the same are sold without any label;
- c. That it has never used word ASIAN all through the tenure of its business.

12. It is submitted that the defendant is marketing its products in the same goods, and under substantially similar marks, with a view to deceive the general public, which is causing grave and serious injury to the plaintiff's reputation. Counsel submits that

unchecked, the plaintiff would suffer irreparably as consumers would labour under the impression that the quality of its goods are not what they should be. Reliance is placed on the plaintiff's trademark, contained in the packaging, and the defendant's mark, which are slavish imitations. Counsel for the plaintiff submits that the illegal adoption and usage by the defendant of the deceptively similar trademark and the deceptively similar logo amounts to a dishonest and *mala fide* attempt to cheat and deceive the public at large and ride on the goodwill and reputation of the plaintiff in the market. It is further stated that the dishonest intention of the defendant is apparent from the fact that it is trying to pass off its product as the product of the plaintiff in the market. Based on these submissions, the present suit has been instituted. The plaintiff has, in support of its case, relied on affidavit deposition of PW-1; he has also affirmed the suit averments, and exhibited the documents produced with it.

13. The court has considered the affidavit deposition by way of evidence filed on behalf of the plaintiff and the documents placed on the record. The averments made in the affidavit and the material placed on the record remain unrebutted by the defendants. Consequently, it is held that the plaintiff has established before the Court that it is the owner of the said trademark. On the basis of the evidence proved the plaintiff has also established that the defendants have infringed the registered trademark of the plaintiff in respect of the product in question; this activity does not have any explanation except that the defendant is deliberately and actuated with *malafide* with the intention of exploiting the plaintiff's goodwill and reputation to cause confusion and deception in the minds of the public at large. These materials, as well as the commissioner's report, clearly establish the defendant's use of the ASIAN trademark, in packages, and labels, deceptively similar to the plaintiff's marks and labels. The commissioner's report reveals that 267 cans or were found and seized from the defendant's premises, of varying sizes (5kg to 20 kg) bearing different marks containing prominently, the ASIAN trademark and logo.

14. In view of the unchallenged evidence placed on the record, it is held that the plaintiff is entitled to grant of a decree of permanent injunction in its favour and against the defendant. Accordingly, the defendant, its agents, distributors, dealers, servants,

representatives and assigns are restrained from using the trade mark “ASIAN PAINTS” or ASIAN mark, or device or any other similar or deceptively similar mark and from infringing and passing off their (the plaintiff’s) products. The defendant, its agents, distributors, dealers, servants, representatives and assigns are also restrained from using the logo of the plaintiff or any other logo which is deceptively similar to that of the plaintiff’s logo.

15. Insofar as the relief of rendition of accounts and a consequential decree on the basis of the aforesaid accounts is concerned, since the defendants were proceeded against *ex parte*, there is no material on the record by way of production of books of accounts, ledgers, etc., to establish the volume of sales of the infringing product or the profits earned by it under the said trademarks. In these circumstances, the suit is decreed in favour of the plaintiff and against the defendant in terms of Para 27 (a) and (b) of the suit, with costs of the proceedings; counsel’s fee is quantified at ₹ 55,000/-.

16. The suit is decreed, in the above terms.

(S. RAVINDRA BHAT)
JUDGE

JULY 19, 2010