

\$~R-18 & 19

* IN THE HIGH COURT OF DELHI AT NEW DELHI

+ FAO(OS) 81/2010

RAN INDIA STEELS PVT. LTD. Appellant
Represented by: Mr. Amarjit Singh, Advocate.
versus

RANA STEELS Respondent
Represented by: Mr. Kirti Uppal, Sr. Advocate
instructed by Mr. S.K. Bansal,
Mr. Pankaj Kumar and Mr. Vikas
Khera, Advocates.

+ FAO(OS) 212/2008

RAN INDIA STEELS PVT. LTD. Appellant
Represented by: Mr. Amarjit Singh, Advocate.
versus

RANA STEELS Respondent
Represented by: Mr. Kirti Uppal, Sr. Advocate
instructed by Mr. S.K. Bansal,
Mr. Pankaj Kumar and Mr. Vikas
Khera, Advocates.

CORAM:

HON'BLE MR. JUSTICE PRADEEP NANDRAJOG

HON'BLE MR. JUSTICE SIDDHARTH MRIDUL

ORDER

% 17.05.2012

1. The antagonist is M/s Ran India Steels Pvt. Ltd. The protagonist is M/s Rana Steels.
2. The battle front was opened when M/s Rana Steels filed a suit alleging infringement of its trademark 'RANA' by bringing to the notice of the Court that M/s Ran India Steels

Steels Pvt. Ltd. to sell its products under the trademark 'RANA TOR' or a mark deceptively similar to the trademark 'RANA', issue was re-debated.

9. Vide impugned order dated January 14, 2010, challenged in FAO(OS) No.81/2010, finding returned is that the trademark 'RANINDIA' is deceptively similar to the trademark 'RANA'. The consequence is that M/s Ran India Steels Pvt. Ltd. and its Directors being prima-facie held to be in violation of the order passed restraining them from selling its products under the trademark 'RANA TOR' or a trademark deceptively similar to the trademark 'RANA'.

10. During arguments in the two appeals today, a suggestion emanated from the Court with a request to the learned counsel for the parties to settle the dispute pertaining to M/s Ran India Steels Pvt. Ltd. carrying on its business under the trademark 'RANINDIA'. The response is positive.

11. It is agreed that M/s Ran India Steels Pvt. Ltd. could sell its products under the trademark 'RANINDIA', written as one word without any space between the word 'RAN' and the word 'INDIA'. The word 'RANINDIA' would be written in same font and styling. It is further agreed that in the products sold, the aforesaid trademark would be etched, embossed or printed, as the case may be. But on the publicity material, M/s Ran India Steels Pvt. Ltd. would use the trademark aforementioned in conjunction with a pictorial description of the arm of a human body with muscles, as represented on the Registered Trademark No.1603837 of M/s Ran India Steels

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2. The battle front was opened when M/s Rana Steels filed a suit alleging infringement of its trademark 'RANA' by bringing to the notice of the Court that M/s Ran India Steels

Pvt. Ltd. was marketing similar products under the trademark 'RANA TOR'.

3. Both companies are admittedly selling steel rolled products, such as steel reinforcement bars, girders etc.

4. Application seeking interim injunction pending decision in the suit was considered and decided by the learned Single Judge against M/s Ran India Steels Pvt. Ltd. and it has been held that the trademark adopted by M/s Ran India Steels Pvt. Ltd. i.e. 'RANA TOR' was deceptively similar to the trademark used by M/s Rana Steels i.e. the trademark 'RANA'.

5. Injunction granted is to restrain M/s Ran India Steels Pvt. Ltd. to sell its products using the trademark 'RANA TOR' or any other mark deceptively similar to the trademark 'RANA' of M/s Rana Steels.

6. Highlighting that before the interim injunction application was disposed of on March 25, 2008, M/s Rana Steels had obtained an ex-part ad-interim injunction on August 14, 2007 which had enured till it was confirmed, issue of stock weighing approx. 3000 MT with M/s Ran India Steels Pvt. Ltd. came up for consideration at a subsequent stage, and alleging that M/s Ran India Steels Pvt. Ltd. had sold the aforesaid stock bearing the trademark 'RANA TOR', it was prayed to the Court that action be taken against the Directors of the company for having violated the injunction granted.

7. Another grievance was made. The same related to M/s Ran India Steels Pvt. Ltd. selling its products under the trademark 'RANINDIA'

8. Since the injunction granted restrained M/s Ran India

Steels Pvt. Ltd. to sell its products under the trademark 'RANA TOR' or a mark deceptively similar to the trademark 'RANA', issue was re-debated.

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Pvt. Ltd.

12. It is agreed that both parties shall withdraw the respective cancellation/opposition petitions filed by them which come into conflict from today with the aforesaid settlement between the parties and that M/s Ran India Steels Pvt. Ltd. shall not use the trademark 'RANA TOR'.

13. The appeals stand disposed of in terms of the settlement in so far the dispute relates to the trademark under which Ran India Steels Pvt. Ltd. would carry on business henceforth.

14. As regards action for contempt, noting that the learned Single Judge has prima-facie found M/s Ran India Steels Pvt. Ltd. to be in contempt with reference to it selling its products using the trademark 'RANINDIA', said finding is nullified with consent of learned counsel.

15. However, the dispute: Whether M/s Ran India Steels Pvt. Ltd. liquidated the stock weighing approx. 3000 MT with the trademark 'RANA TOR', evidence would be needed to determine whether M/s Ran India Steels Pvt. Ltd. re-rolled the existing stock and thereafter sold the same, as claimed by it, and not under the trademark 'RANA TOR', but under the trademark 'RANINDIA', would require evidence to be led.

16. The same would be led in the suit and the matter would be considered by the learned Single Judge.

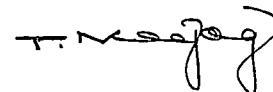
17. Application seeking contempt action against M/s Ran India Steels Pvt. Ltd. i.e. I.A.No.13619/2008 shall be re-decided on the limited issue hereinabove settled for disposal and we direct that the said application stands restored. The

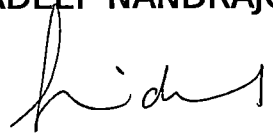
parties are permitted to file such documents on which they rely for purposes of adjudication of I.A.No.13619/2008.

18. It is clarified that the consent aforesaid encompasses that M/s Ran India Steels Pvt. Ltd. would have no objection to M/s Rana Steels selling its products under the trademark 'RANA' or 'RANA TOR'.

19. The appeals stand disposed of.

20. No costs.


PRADEEP NANDRAJOG, J.


SIDDHARTH MRIDUL, J.

MAY 17, 2012
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Fresh CM 10457/12 u/s 15 CPC & 153 CPC on b/o Appellant.

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RAN INDIA STEELS PVT. LTD. Appellant
Represented by: Mr. Amarjit Singh, Advocate and
Ms. Ashna Bhalla, Advocate.

versus

RANA STEELS Respondent
Represented by: Mr. Pankaj Kumar, Advocate.

CORAM:
HON'BLE MR. JUSTICE PRADEEP NANDRAJOG
HON'BLE MR. JUSTICE SIDDHARTH MRIDUL

% ORDER
01.06.2012

CM No.10457/2012

1. The instant appeal as also connected appeal being FAO(OS) No.81/2010 were disposed of by passing a consent order on May 17, 2012, which order reads as under:-

"1. The antagonist is M/s Ran India Steels Pvt. Ltd.
The protagonist is M/s Rana Steels.

2. The battle front was opened when M/s Rana Steels filed a suit alleging infringement of its trademark 'RANA' by bringing to the notice of the Court that M/s Ran India Steels Pvt. Ltd. was marketing similar products under the trademark 'RANA TOR'.

3. Both companies are admittedly selling steel rolled products, such as steel reinforcement bars, girders etc.

4. Application seeking interim injunction pending decision in the suit was considered and decided by the learned Single Judge against M/s Ran India Steels Pvt. Ltd. and it has been held that the

trademark adopted by M/s Ran India Steels Pvt. Ltd. i.e. 'RANA TOR' was deceptively similar to the trademark used by M/s Rana Steels i.e. the trademark 'RANA'.

5. Injunction granted is to restrain M/s Ran India Steels Pvt. Ltd. to sell its products using the trademark 'RANA TOR' or any other mark deceptively similar to the trademark 'RANA' of M/s Rana Steels.

6. Highlighting that before the interim injunction application was disposed of on March 25, 2008, M/s Rana Steels had obtained an ex-parte ad-interim injunction on August 14, 2007 which had enured till it was confirmed, issue of stock weighing approx. 3000 MT with M/s Ran India Steels Pvt. Ltd. came up for consideration at a subsequent stage, and alleging that M/s Ran India Steels Pvt. Ltd. had sold the aforesaid stock bearing the trademark 'RANA TOR', it was prayed to the Court that action be taken against the Directors of the company for having violated the injunction granted.

7. Another grievance was made. The same related to M/s Ran India Steels Pvt. Ltd. selling its products under the trademark 'RANINDIA'

8. Since the injunction granted restrained M/s Ran India Steels Pvt. Ltd. to sell its products under the trademark 'RANA TOR' or a mark deceptively similar to the trademark 'RANA', issue was re-debated.

9. Vide impugned order dated January 14, 2010, challenged in FAO(OS) No.81/2010, finding returned is that the trademark 'RANINDIA' is deceptively similar to the trademark 'RANA'. The consequence is that M/s Ran India Steels Pvt. Ltd. and its Directors being prima-facie held to be in violation of the order passed restraining them from selling its products under the trademark 'RANA TOR' or a trademark deceptively similar to the trademark 'RANA'.

10. During arguments in the two appeals today, a

suggestion emanated from the Court with a request to the learned counsel for the parties to settle the dispute pertaining to M/s Ran India Steels Pvt. Ltd. carrying on its business under the trademark 'RANINDIA'. The response is positive.

11. It is agreed that M/s Ran India Steels Pvt. Ltd. could sell its products under the trademark 'RANINDIA', written as one word without any space between the word 'RAN' and the word 'INDIA'. The word 'RANINDIA' would be written in same font and styling. It is further agreed that in the products sold, the aforesaid trademark would be etched, embossed or printed, as the case may be. But on the publicity material, M/s Ran India Steels Pvt. Ltd. would use the trademark afore-noted in conjunction with a pictorial description of the arm of a human body with muscles, as represented on the Registered Trademark No.1603837 of M/s Ran India Steels Pvt. Ltd.

12. It is agreed that both parties shall withdraw the respective cancellation/opposition petitions filed by them which come into conflict from today with the aforesaid settlement between the parties and that M/s Ran India Steels Pvt. Ltd. shall not use the trademark 'RANA TOR'.

13. The appeals stand disposed of in terms of the settlement in so far the dispute relates to the trademark under which Ran India Steels Pvt. Ltd. would carry on business henceforth.

14. As regards action for contempt, noting that the learned Single Judge has prima-facie found M/s Ran India Steels Pvt. Ltd. to be in contempt with reference to it selling its products using the trademark 'RANINDIA', said finding is nullified with consent of learned counsel.

15. However, the dispute: Whether M/s Ran India Steels Pvt. Ltd. liquidated the stock weighing approx. 3000 MT with the trademark 'RANA TOR', evidence would be needed to determine whether M/s Ran India Steels Pvt. Ltd. re-rolled the existing stock and thereafter sold the same, as claimed by

it, and not under the trademark 'RANA TOR', but under the trademark 'RANINDIA', would require evidence to be led.

16. The same would be led in the suit and the matter would be considered by the learned Single Judge.

17. Application seeking contempt action against M/s Ran India Steels Pvt. Ltd. i.e. I.A.No.13619/2008 shall be re-decided on the limited issue hereinabove settled for disposal and we direct that the said application stands restored. The parties are permitted to file such documents on which they rely for purposes of adjudication of I.A.No.13619/2008.

18. It is clarified that the consent aforesaid encompasses that M/s Ran India Steels Pvt. Ltd. would have no objection to M/s Rana Steels selling its products under the trademark 'RANA' or 'RANA TOR'.

19. The appeals stand disposed of.

20. No costs."

2. It is stated in the application that a perusal of the consent order dated May 17, 2012, would evidence that even the subject matter of the suit i.e. CS(OS) No.1459/2007 stands resolved, requiring it to be recorded that in terms of the settlement even the suit stand disposed of.

3. Learned counsel for the respondent/plaintiff states that the settlement between the parties resolves the principal dispute in the suit i.e. the claim for permanent injunction to restrain appellant from trading under a trademark which would be deceptively similar to the respondent's trademark 'RANA', and for which counsel states it may be recorded that to said extent the suit stands disposed of; but would urge that the remainder claim pertaining to rendition of accounts and

damages in relation to 3000 MT stock has to be litigated upon.

4. With respect to the stand taken by the respondent, paragraphs 15 to 18 of the order dated May 17, 2012 would evidence that there being no consent on the said dispute i.e. whether the appellant sold 3000 MT stock under the offending trademark 'RANA TOR', as alleged by the respondent, or after re-rolling the stock and selling the same under the trademark 'RANINDIA', as alleged by the appellant, the issue being a subject matter of an application initiating contempt action against the appellant under IA No.13619/2008, it was specifically recorded that proceedings in the suit would continue with respect to IA No.13619/2008 and evidence would be led.

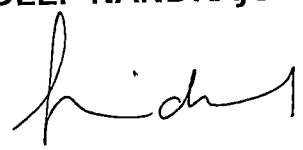
5. Learned counsel for the appellant states that upon a finding being returned in favour of the appellant in IA No.13619/2008, the question of appellant being required to render any accounts would not arise; but would concede that if the finding is against the appellant, then whether by way of purging the contempt or by way of recompense to the respondent, the appellant would be required to make good the loss caused to the respondent on account of appellant trading on its goodwill; and thus counsel urges that the matter pertaining to rendition of accounts would obviously be subsumed in the adjudication of IA No.13619/2008.

6. Noting the stand taken by the appellant, which is a correct reflection of the legal position, we dispose of CM No.10457/2012 specifically recording that the terms of the settlement recorded in the order dated May 17, 2012 would require the suit to be disposed of in said terms by passing an appropriate decree and for which the learned Single Judge is requested to pass a formal order. We clarify that IA

No.13619/2008 would be adjudicated on merits in terms of the consent order dated May 17, 2012 and while so doing, the learned Single Judge would take note of the stand taken by the appellant and as recorded in paragraph 5 above.

7. No costs.


PRADEEP NANDRAJOG, J.


SIDDHARTH MRIDUL, J.

JUNE 01, 2012
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*Fresh cm. 13499/12 u/s 151 r/w s. 152 & 153 CPC on 6/0
res pdt.*