

+ **CS(OS) 1428/2009**

versus

% Date of Decision : August 17, 2012

JUDGMENT

2. The plaintiff, established in the year 1917 as a body corporate, is the principal investment holding company of the TATA Group,

which is India's oldest, largest and best-known conglomerate, with a turnover of over ₹ 251,543 Crores (US \$ 62.5 billion) for the financial year 2007-08. Since its inception in 1917, the plaintiff has been continuously and consistently using the trademark and trade name TATA, which is a rare patronymic name possessing the distinctiveness of an invented word, for its own business activities and those of the companies promoted by it. The use of the trademark and trade name TATA by the plaintiff's predecessors in business dates back to 1868. The name TATA has consistently been associated with, and exclusively denotes the conglomeration of the companies forming the TATA Group, colloquially also referred to as the "House of TATA". The House of TATA consists of over 100 companies of which over 50 companies use TATA as a key and essential part of their corporate name.

3. The plaintiff asserts that in addition to the common law rights that have accrued to the plaintiff with respect to the trademark and trade name TATA, it is also the registered proprietor of several TATA-formative trademarks in relation to various goods across various classes. Thus, the plaintiff is the proprietor of several

trademarks comprising or containing the word TATA in Class 28, the relevant class for the purpose of the present suit. The Original Certificates for Use in Legal Proceedings for registered Trade Mark Nos.551865, 585384, 838444, 839745, 839711 and 839779 in Class 28 are placed on record along with the list of *well-known trademarks* issued by the Controller General of Patents, Designs and Trade Marks acknowledging the plaintiff's trademark TATA and the "T within a circle" device as *well-known trademarks*. A list of trademark registrations owned by the plaintiff and its sister concerns for the word mark TATA in India across all classes is also filed by the plaintiff.

4. The defendant Nos.1 and 2 in the suit are stated to be engaged in the business of manufacture, distribution, supply and sale of shuttle cocks. The defendant No.2, M/s. Meerut Shuttle Cocks Industries, is located at Suraj Kund Road, Meerut, Uttar Pradesh. The defendant No.1 is the proprietor of the defendant No.2 concern. In or around the month of April, 2008, the plaintiff received information that the defendants were manufacturing and selling shuttle cocks under the impugned name TATA. The plaintiff accordingly authorised an

investigation of the defendants through a professional investigation agency. In April, 2008 itself, the plaintiff received the investigation report which confirmed the involvement of the defendants in infringing activities. The original report of the investigator dated 9th April, 2008 is filed in the present proceedings. Thereafter, a fresh investigation of the defendants was also carried out. The investigation report of the second investigator dated 19th May, 2009 is also filed in the present proceedings. The investigation conducted by the plaintiff revealed that the defendants have registered the impugned trademark TATA vide application No.260676 in Class 28. The said registration of the defendants, however, appears to have become invalid due to non-renewal of the trademark registration. The plaintiff claims that the adoption and use of the trademark TATA deceptively similar to the plaintiff's *well-known trademark* TATA is a blatantly dishonest and *mala fide* attempt by the defendants to derive unfair advantage by creating an illusion that its products emanate from the plaintiff or have some nexus or association with the plaintiff. The plaintiff asserts that having regard to the fact that the trademark TATA of the plaintiff is a well-known mark enjoying an

expansive reputation and goodwill, and that the TATA companies are engaged in a wide spectrum of activities using the trademark TATA and the said trademark has come to be exclusively recognized as a source indicator of the goods and business of the plaintiff, the use of an identical trademark by the defendants will create confusion and deception in the minds of the purchasing public and members of the trade, who will be misled into purchasing the defendants' products. The defendants will thus be unjustly enriched at the consumers' expense and at the expense of the plaintiff. The damage that has already been inflicted on the plaintiff's business' goodwill and reputation is stated to be incalculable. However, for the purposes of the present suit, the plaintiff estimates that such losses may be to the tune of at least ₹ 20 Lacs till the date of the institution of the suit.

5. Despite service of summons on the defendants through substituted service by publication, none appeared on behalf of the defendants and the defendants were proceeded *ex parte* on November 24, 2010. Thereafter, the case was set down for *ex parte* evidence. The plaintiff filed an affidavit by way of evidence of Mr. V.Gurumoorthi PW-1. Mr. V. Gurumoorthi tendered in evidence

his affidavit by way of evidence as Ex.PW1/A and identified his signatures at points “A” and “B” of the said affidavit. He also tendered in evidence the documents Exhibits PW1/1 to PW1/20 and the documents marked as Mark D to Mark P. Mr. V. Gurumoorthi exhibited the certified true copy of the Power of Attorney in his favour as **Ex.PW1/1** and the Board Resolution in his favour from the plaintiff as **Ex.PW1/2**. A certified true copy of the Certificate of Incorporation of the plaintiff Company dated 08.11.1917 was exhibited by him as **Ex.PW1/3**.

6. The Original Certificate for use in Legal Proceedings for registered trademark No.551865 in Class 28 was exhibited as **Ex.PW1/13** and those pertaining to registered trademark Nos.585384, 838444, 839745, 839711 and 839779, also in Class 28, were exhibited as **Ex.PW1/14 (Colly.)**. **Ex.PW1/15** is the printout from the website of Trade Mark Office, wherein the plaintiff’s trademark TATA has been acknowledged and assigned the status of a *well-known trademark*. **Mark O** is the list of trademark registrations in various classes for the word mark TATA in India in favour of the plaintiff.

7. Further, the following documents pertaining to the business activities of the plaintiff Company in New Delhi were filed and exhibited/brought on record along with the evidence by way of affidavit of Mr. V.Gurumoorthi, the Constituted Attorney of the plaintiff Company:-

- (i) **Ex.PW1/4** – Original receipt No.475100 issued by the Municipal Corporation of Delhi in favour of the plaintiff Company on payment of the property tax by the plaintiff Company to the Corporation.
- (ii) **Ex.PW1/5** – Copy of Ledger Book maintained by Tata Services Ltd. located in New Delhi illustrating the financial transactions carried with the plaintiff Company in New Delhi.
- (iii) **Mark D** – Copies of the documents evidencing the business activities of the plaintiff Company carried out in New Delhi (filed along with the plaint).
- (iv) **Mark E** – Copy of a Certificate of details of sharing of expenses of the New Delhi office of Tata Services Ltd. (filed along with the plaint).

- (v) **Mark F** – A copy of the pass book entries indicating existence of plaintiff's bank account in the State Bank of India, Parliament Street, New Delhi (filed along with the plaint).

8. The following documents pertaining to the well-known status, reputation and goodwill enjoyed by the plaintiff's trademark TATA were also exhibited/brought on record by PW1, Mr. V. Gurumoorthi:-

- (a) **Ex.PW1/6** – True copy of the write-up dated 24th May, 2009, titled "T for trust" appearing in the magazine, 'The Week' acknowledging the TATA Group as the world's 11th most reputed company.
- (b) **Mark G** – Copy of the extract from The New Encyclopaedia Britannica Volume 11 on the origin and growth of the TATA Group.
- (c) **Mark H** – Copy of message dated 18th July, 1998 from the then Hon'ble Prime Minister of India, Shri A.B. Vajpayee on the 93rd Birth Anniversary of Late Shri J.R.D. Tata.

- (d) **Mark I** – Copy of pamphlet issued by the Trade Marks Registry showing TATA as a well-known trademark.
- (e) **Mark J (colly.)** – Articles appearing in various newspapers/periodicals/magazines acknowledging the immense goodwill and status enjoyed by the plaintiff's 'well-known' trademark TATA.
- (f) **Mark K** – Copy of the 2009 Global Reputation Pulse, The World's Most Reputable Companies : Global Section (an online study of consumers in 32 countries), ranking TATA eleventh in the Top 50 companies, evidencing the immense goodwill and status enjoyed by the plaintiff's 'well-known' trademark TATA.
- (g) **Mark L** – Copy of the latest brochure on the financial highlights of the plaintiff Company and its sister concerns.
- (h) **Mark M** – Copies of the TATA Brand Equity and Business Promotion Agreement dated 23.12.1999 entered into between the plaintiff Company and Tata Teleservices Ltd. and Board Resolution and Letter

indicating the existence of other such agreements between the plaintiff Company and other companies of the TATA Group.

9. Copies of the orders passed by this Court, the High Court of Sindh at Karachi and by WIPO Arbitration and Mediation Center protecting the *well-known trademark* TATA of the plaintiff and granting damages to the plaintiff were exhibited/marked by PW-1, Mr. V. Gurumoorthi as **Ex.PW1/7** to **Ex.PW1/12** and **Mark N**.

10. The following documents illustrating and confirming the defendants' illegal and infringing activities about which the plaintiff came to know in the month of April, 2008 have also been proved on record by PW-1, Mr. V. Gurumoorthi:-

- (i) **Ex.PW1/16** – Original report dated 9th April, 2008 of the investigator deputed by the plaintiff along with **Mark P**, which is the copy of handwritten bill issued by the defendant No.1 to the said investigator for ₹ 540/- in respect of the impugned products, bearing the name TATA on the product purchased by the investigator.

- (ii) **Ex.PW1/17** – The original investigation report dated 19th May, 2009 of the investigator deputed by the plaintiff along with **Ex.PW1/18**, which is the original cash memo dated 15th May, 2009 as received by the investigator from the defendants against purchase of the infringing product bearing the name TATA.
- (iii) **Ex.PW1/19 (Colly.)** – Photographs of the infringing products of the defendants filed along an affidavit under Section 65B of the Evidence Act, 1872 as well as a supplementary affidavit under Section 65B of the Evidence Act exhibited as **Ex.PW1/20**.

11. Having heard the learned counsel for the plaintiff, perused the evidence of PW-1, Mr. V. Gurumoorthi and the documents exhibited by him, I am satisfied that the trademark TATA of the plaintiff is a well-known mark and immense goodwill and reputation is enjoyed by the plaintiff in respect thereof. The plaintiff has established that TATA companies are engaged in a wide spectrum of activities using the trademark TATA and the said trademark has come to be associated with the plaintiff and recognized as a source indicator of

the goods and business of the plaintiff. The use of an identical trade name by the defendants is bound to create confusion and deception in the minds of the consumers and members of the trade, and thereby adversely affect the plaintiff's goodwill and reputation. The plaintiff Company would suffer irreparable loss, damage and injury to its business' goodwill and reputation, if the defendants are not permanently restrained from carrying on their infringing activities and from blatantly and illegally capitalizing on the world famous trademark/name of the plaintiff for the purpose of their own illegal profit and gain.

12. The suit of the plaintiff is accordingly decreed by passing a decree of permanent injunction restraining the defendants, their partners, proprietors, or as the case may be, their officers, servants and agents from selling, offering for sale, advertising, and directly or indirectly, dealing in shuttle cocks or goods of any description bearing the trademark TATA and/or any mark/s deceptively similar to the plaintiff's trademark TATA, amounting to passing off of the defendants' goods as those of the plaintiff's. The defendants are further directed to destroy the goods bearing the impugned mark,

dyes, blocks, cartons, labels and any other infringing material within ten weeks from today.

13. During the course of arguments, the learned counsel for the plaintiff also pressed for the award of punitive damages against the defendants. Having regard to the loss of business reputation and goodwill of the plaintiff in the market and in view of the fact that the evidence of the plaintiff is unrebutted, I am of the opinion that punitive damages amounting to ₹ 2 lacs on account of loss of reputation and goodwill of the plaintiff in the market would be justified. The defendants are accordingly directed to pay damages in the sum of ₹ 2 lacs to the plaintiff within ten weeks of the passing of this order.

CS(OS) 1428/2009 and IA No.9968/2009 stand disposed of in the above terms.

**REVA KHETRAPAL
(JUDGE)**

August 17, 2012
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