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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ CS(OS) 889/2014

% ***Judgment dated 18.12.2014***

MITSUBISHI CORPORATION & ANR Plaintiffs

Through : Ms.Vaishali Mittal & Ms.D Neha
Reddy, Advocates

versus

DHARMESH SHAH & ANR Defendants

Through

CORAM:

HON'BLE MR. JUSTICE G.S.SISTANI

G.S.SISTANI, J (ORAL)

1. The plaintiffs have filed the present suit for permanent injunction, restraining infringement of trademarks, passing off, rendition of accounts, delivery up, dilution, damages against the defendants.
2. While issuing summons in the suit and notice in the application for stay on 28.03.2014 this court had restrained the defendants from selling, offering for sale, advertising, directly or indirectly dealing in any manner with respect to any goods in general using the impugned mark

'MISTUBEESHI' and device  or any other deceptively similar mark to the Plaintiff's "MITSUBISHI" trademarks as well as the device
 or doing any other thing so as to infringe the Plaintiff's Trade Marks or device.
3. As none has appeared for the defendants despite service, defendants are proceeded ex-parte.

4. The Plaintiffs who trace their origins back to 1870, have shown that they have a wide spread presence across the world and in India; that there is a great amount of good will and reputation attached to the high quality, efficacy of the products of the Plaintiff.
5. The Plaintiffs have also shown that they are the proprietors and holders of the mark “MITSUBISHI” and device  and have held the mark for 135 years which has earned them the trust and confidence of their customers worldwide.
6. The Plaintiff has submitted the following documents to show their ownership and usage over the mark “MITSUBISHI” and the device ;
 - a. Documents about the origin and history of the Plaintiffs and its usage of the MITSUBISHI mark.
 - b. Documents detailing the activities of MITSUBISHI Corporation, MITSUBISHI Paper Mills Limited and other MITSUBISHI companies.
 - c. Documents detailing the list of the Plaintiffs’ worldwide registrations and copies of some of the registration and renewal certificates.
 - d. Documents showing the Plaintiffs’ registered Trademarks in India with the Registration No. 386868 under Class 16.
 - e. Documents showing the Offices of the Plaintiffs worldwide including in India.
 - f. Copies of advertisements in magazines of paper related products.
 - g. Sales invoices of Mitsubishi Paper in India.

7. The Plaintiffs have shown that they operate an advanced paper manufacturing company which manufactures and sells real-art-paper, which is the highest quality coated paper for printing. Further, the Plaintiffs have shown that they produce and develop not only printing paper, printing plate materials and printing systems supporting offset and other printing, but also supply the media for almost all recording formats, such as pressure-sensitive, thermal, magnetic, electrographic, silver halide photography and inkjet paper.

Comparison of the Plaintiffs’ Trademarks and the Defendants impugned marks

Plaintiff’s trademark		Defendants’ impugned mark	
MITSUBISHI	→ 1 ←	MISTUB <u>EE</u> SHI	
	→ 2 ←		
 MITSUBISHI			

S. No.	Distinctive features of the Plaintiff's MITSUBISHI Trademarks	Defendants' trademark
1.	Deceptively similar trademark with only slight difference in spelling	✓
2.	Identical use of a red three diamond device	✓
3.	Phonetic similarity	✓

8. The Plaintiffs have shown that the Defendants, with respect to their paper rolls business have adopted and are using a deceptively similar mark

‘MISTUBEESHI’ and the three diamond’s device  which is identical to the Plaintiff’s registered MITSUBISHI and  Trade Marks. The Plaintiffs further showed the Defendants mala-fide intention to ride upon the Plaintiff’s goodwill in the MITSUBISHI Trade Marks by the fact that the Defendant has sought to gain proprietorship in the impugned mark ‘MISTUBEESHI’ under application no. 1607490 in class 16 and application no. 1607488 in class 16 for , which are deceptively similar and nearly identical to the Plaintiff’s registered trademarks ‘MITSUBISHI’ and .

9. The Plaintiffs have shown from the affidavit of the investigator that the Defendants being well aware of the Plaintiff’s rights in the mark ‘MITSUBISHI’ as well as in the three diamond device , were not only using the impugned marks with respect to their products, but are also flagrantly expanding their range of products under the impugned marks.

10. The Plaintiffs have shown that as a result of their wide spread presence across the world and in India, there exists great amount of good will and reputation attached to the high quality, efficacy of the products of the Plaintiff and the well known trademarks MITSUBISHI and  in the relevant class of the public in India. Further the Plaintiffs' have shown that the Defendants' unauthorised and intentional use of the deceptively identical and similar trademark amount to passing off the Plaintiff's trademark MITSUBISHI and the device  has caused irreparable injury and huge monetary loses to the Plaintiff.
11. It is the view of this court that it is a settled proposition of law that a well-known and reputed trademark gets diluted when the consumer capacity to associate it with the Plaintiff's products is diminished. Overwhelming goodwill and reputation enjoyed by a particular trademark is worthy and deserving of a wide scope of protection. The stronger the Plaintiff's trademark, the greater the protection it deserves. The blatant and unrestricted use of identical trademarks as those belonging to the Plaintiffs' by the Defendants in relation to their products will inevitably lead to the gradual whittling away and eventual erosion of the uniqueness and exclusivity associated with the Plaintiff's trademarks by reducing their capacity to identify and distinguish the goods of the Plaintiff as originating from a particular source. In the event that the Defendants' activities are not curbed, they will also prompt others to imitate the Plaintiff's well-known trademarks thereby leading to their further dilution.
12. In the case of **Laxmikant V. Patel Vs. Chetanbhat Shah and Anr.** reported at AIR 2002 SC 275 the following observations were made by the Supreme Court with respect to the adoption of deceptively similar marks:

“10. A person may sell his goods or deliver his services such as in case of a profession under a trading name or style. With the lapse of time such business or services associated with a person acquire a reputation or goodwill which becomes a property which is protected by courts. A competitor initiating sale of goods or services in the same name or by imitating that name results in injury to the business of one who has the property in that name. The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that he goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury.”

12. Reliance has also been placed on the case **Ruston & Hornsby Ltd. Vs. The Zamindara Engineering Co.** reported at AIR 1970 SC 1649 where the following observations were made by the Supreme Court:

“6. In an action for infringement where the defendant's trade mark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. But where the alleged infringement consists of using not the exact mark on the Register, but something similar to it, the test of infringement is the same as in an action for passing off. In other words, the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions.

7. In the present case the High Court has found that there is a deceptive resemblance between the word "RUSTON" and the word "RUSTAM" and therefore the use of the bare word

"RUSTAM" constituted infringement of the plaintiff's trade mark "RUSTON". The respondent has not brought an appeal against the judgment of the High Court on this point and it is, therefore, not open to him to challenge that finding. If the respondent's trade mark is deceptively similar to that of the appellant the fact that the word 'INDIA' is added to the respondent's trade mark is of no consequence and the appellant is entitled to succeed in its action for infringement of its trade mark."

13. In Rolex Sa vs. Alex Jewellery Pvt. Ltd. and Ors. reported at 2009(41) PTC 284 (Del), the following was observed by this court:

“16. Yet another provision in the Act, though for the guidance of the Registrar but in relation to well known trademarks is to be found in Section 11(6) of the Act. Upon testing the trademark of the plaintiff on the touchstone of the ingredients of the said provision also, I find the said trademark of the plaintiff to be satisfying the test of a well known trademark. The documents filed by the plaintiff i.e., the advertising done in the media in India since 1947 and particularly in years immediately preceding the suit, registrations obtained show that relevant section of the public in India had knowledge of the trademark ROLEX in relation to the watches. The pleadings of the plaintiff and which are not contested also show that the plaintiff for the last nearly one century has been using the said trademark spread over nearly the entire developed/developing world. The advertisements of the plaintiff had appeared in the magazines in this country even when there were import restrictions. The plaintiff has filed documents to show registration of the trademark in a large number of countries and also to show successful enforcement of its rights with respect to the said trademark.

20. Over the years and very quickly in recent times, the international boundaries are disappearing. With the advent of the internet in the last over ten years it cannot now be said that a trademark which is very well known elsewhere would not be well known here. The test of a well known trademark in Section 2(zg) is qua the segment of the public which uses

such goods. In my view any one in India, into buying expensive watches, knows of ROLEX watches and ROLEX has a reputation in India. Not only so, to satisfy the needs/demands of consumers in different countries, the well known international brands which were earlier available at prices equivalent to prices in country of origin and which owing to the exchange rate conversion were very high, have adapted to the Indian situation and lowered prices. A large number have set up manufacturing facilities here and taken out several variants. Thus, merely because today the price of a ROLEX watch may be much higher than the price of items of jewellery of the defendants as argued, cannot come in the way of the consumer still believing that the jewellery is from the house of the plaintiff. Also, there can be no ceiling to the price at which the defendants will continue to sell their jewellery. The defendants have claimed to be selling rolled gold jewellery; with the price of gold soaring, there is no certainty that the pieces of artificial jewellery of the defendants would not also be in the same range as the watches of the plaintiff. Even otherwise, the trend in modern times has been towards artificial/semi precious jewellery. In fact, the attraction to gold is confined to this part of the world only. In India also today there are several brands of artificial jewellery/semi precious jewellery whose brand value and/or prices are quite comparable to the gold jewellery of the conventional gold smiths.”

14. The Plaintiffs’ have shown the court that in the present matter it is clear that the Defendants have adopted the impugned trademarks



MISTUBEESHI as well as the device in relation to their products with the sole intention of enjoying the benefits that flow from the tremendous reputation and goodwill that exists in favour of the Plaintiff’s identical trademarks. The Defendants are obviously well aware of the international reputation and goodwill acquired by the Plaintiff in the

trademark MITSUBISHI as well as the device  and have no justification for adopting the said marks.

15. This court is of the view that the Plaintiffs have proved beyond doubt that the plaintiff is the registered proprietor of the trademark MITSUBISHI as well the device  and hence the plaintiffs are entitled to exclusive rights of usage.
16. Taking account the plaint, duly supported by an affidavit and documents on record and comparing the impugned product of the defendants, I am of the view that the defendants have copied the trademarks of the plaintiff with the intention to make their products deceptively similar. The defendants, thus, are guilty of infringing the registered trademarks and passing off their goods as those of the plaintiffs and thus encasing on the Plaintiffs' goodwill and reputation.
17. The plaintiffs have also claimed damages from the defendants on account of illegal activities carried out by the latter.
18. I am of the view that damages in such cases must be awarded and a defendant, who chooses to stay away from the proceedings of the Court, should not be permitted to enjoy the benefits of evasion of court proceedings. R.C. Chopra, J. has very succinctly set out in **Time Incorporated v. Lokesh Srivastava and Anr.**, reported at 2005 (30) PTC 3 (Del) that punitive damages are founded on the philosophy of corrective justice. [Also see ***Hero Honda Motors Ltd. v Rafiq Memon*** reported at 2012 (52) PTC 449 (Del), ***Gora Mal Hari Ram Ltd. v Ashiq Exports*** reported at 2012 (50) PTC 428 (Del.), ***L.T. Overseas Ltd. v Guruji Trading Co.*** reported at 2005 (31) PTC 254 (Del.), ***Relaxo Rubber Ltd. and Anr. v Selection Footwear and Anr.*** reported at AIR 2000 Del 60].
19. For the reasons stated above, the plaintiffs have made out a case for grant of decree as prayed in the plaint. Accordingly, the order dated 18.12.2014

is confirmed and the suit is decreed in favour of the plaintiffs. Plaintiffs are also entitled to the damages to the tune of Rs.1 lakh.

I.A. 5758/2014 & I.A. 12355/2014

20. In view of the order passed in the suit, the present applications stand disposed of.

DECEMBER 18, 2014
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G.S.SISTANI, J