

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

% *Order delivered on: 6th November, 2015*

+ **CS(OS) No.1551/2008**

M/S L' OREAL Plaintiff
Through Mr.Ajay Amitabh Suman, Adv. with
Mr. Vinay Kumar Shukla, Adv.

versus

M/S SIGMA ENTERPRISES & ANR. Defendants
Through Defendants are ex-parte.

CORAM:
HON'BLE MR.JUSTICE MANMOHAN SINGH

MANMOHAN SINGH, J.

1. The plaintiff has filed a suit under Section 134 and 135 of Trade Marks Act, 1999, Section 55 of Copyright Act, 1957 for permanent injunction restraining infringement, passing off, delivery up, rendition of accounts etc. against the defendants.
2. The defendants were served by way of publication. They failed to appear before the Court. They have also not filed the written statement. They were proceeded ex-parte by order dated 19th August, 2015.
3. Ex-parte evidence was filed by the plaintiff by way of affidavit of Ms. Surbhi Bansal, Constituted Attorney of the plaintiff. A copy of Power of Attorney in favour of Ms. Surbhi Bansal has been exhibited as Ex. PW-1/1. The suit was initially instituted by Shri Sheel Bansal,

the then Constituted Attorney of the plaintiff. A copy of Power of Attorney in his favour has been placed on record and has been exhibited as Ex. PW1/2.

4. The plaintiff is engaged in the business of manufacture, distribution and sale of a wide range of hair care, skin care, toiletries and beauty products including perfumery preparations, essential oils, cosmetics, preparations for colouring and bleaching the hair, hair dyes and tints, preparations for waving and setting the hair, shampoos, hair sprays, non-medicated preparations for the care and the beauty of the hair, non-medicated preparations for the care and the beauty of the skin, toilet soaps, dentifrices, suntan preparations, personal deodorants and other allied/related products (hereinafter referred to as "the said goods" and "the said business").

5. Ever since its bonafide adoption in about the first decade of 1900, the plaintiff since about 1910-1915 has been using the word/mark L'OREAL word per se, stylized, formative/bearing and labels as a trademark as also as an essential part of its trade name in relation to its said goods and business. In addition to its word per se user, the plaintiff over a period of time has been using its trademark in various stylized and artistic formats and labels and which have been created and are being created over a period of time. The word/mark L'OREAL remains a key and material part thereof. The word/mark L'OREAL has all the trappings of an invented mark and as such is extremely a strong mark. The specimen of plaintiff's said trademark/labels has been exhibited as Ex. PW- 1/3.

6. As of now the plaintiff's said goods under its said trademark/trade name are branded and sold in about 130 countries of the world and across all continents and regions including in India, wherein, in addition the plaintiff also enjoys its trans-border reputations and users. The plaintiff's said goods are sold and traded by the plaintiff directly or through a wide network of its associates, affiliates, subsidiary companies, licensees and through a wide marketing network including through retail as also through internet and e-commerce.

7. The plaintiff's trademarks L'OREAL word and ELVIVE word mark is duly registered in India under the Trade Mark Act, 1999 (hereinafter referred to as 'the Act') as per the following particulars:

(a)	Trade Mark	L'OREAL (word mark)
	Registration No.	165778 in class 3
	Date of Registration	14.9.1954
	Status	Renewed and subsisting till 14.9.2020
	Goods:	Perfumery, soaps, non-medicated toilet preparations, shampoos, toilet preparations for the permanent waving of hair, toilet preparations (coloured and otherwise) for the rinsing of hair, dyes for hair and beards, non-medicated hair lotion.
(b)	Trade Mark	L'OREAL (LABEL)
	Registration No.	473298 in Class 3

Date of Registration	08.06.1987
Status	Renewed, legal, valid and subsisting
Goods:	Perfumery preparations, essential oils, cosmetics, preparations for colouring and bleaching the hair, hair dyes and tints, preparations for waving and setting the hair, shampoos, hair sprays, non-medicated preparations for the care and the beauty of the hair, non-medicated preparation for the care and the beauty of the skin, toilet soaps, dentifrices, sun tan preparations, personal deodorants;
(c) Trade Mark	L'OREAL PROGRESS (word mark)
Registration No.	499858 in Class 3;
Date of Registration	25.10.1988;
Status	Renewed, legal, valid and subsisting
Goods:	Perfumery preparations, essential oils, cosmetics, preparations for colouring and bleaching the hair, hair dyes and tints, preparations for waving and setting the hair, shampoos, hair sprays, non-medicated preparations for the care and the beauty of the skin, toilet soaps, dentifrices, personal deodorants included in Class 3.

(d)	Trade Mark	L'OREAL PLENTITUDE (word mark)
	Registration No.	477223 in Class 3;
	Date of Registration	20.08.1987;
	Status	Renewed, legal, valid and subsisting
	Goods:	Perfumery preparations, essential oils, preparations for colouring and bleaching the hair, hair dyes and tints, preparations for waving and setting the hair, shampoos, hair sprays, non-medicated preparations for the care and the beauty of the hair, non-medicated preparations for the care and the beauty of the skin, toilet soaps, dentifrices, sun tan preparations, personal deodorants;
(e)	Trade Mark	L'OREAL SOLAR EXPERTISE
	Registration No.	1493028 in Class 3;
	Date of Registration	04.10.2006;
	Status	Legal, valid and subsisting.
	Goods:	Perfume, Toilet Water, Gels, Salts for the bath and shower not for medical purposes. Toilet Soaps, Body Deodorants, Cosmetics namely Creams, Milks, Lotions, Gels and Powders for the face, the body and the hands, Sun Care Preparations (Cosmetic Products),

Make up preparations. Shampoos, Gels, Sprays, Mousses and Balms for the Hair styling and Hair Care and Hair Lacquers, Hair Colouring and Hair Decolorant Preparations, Permanent Waving and Curling Preparations, Essential Oils for personal use included in Class 03;

(f) Trade Mark

L'OREAL PREFERENCE

Registration No.

1493024 in Class 3;

Date of Registration

04.10.2006;

Status

Legal, valid and subsisting.

Goods:

Perfume, Toilet Water, Gels, Salts for the bath and shower not for medical purposes. Toilet Soaps, Body Deodorants, Cosmetics namely Creams, Milks, Lotions, Gels and Powders for the face, the body and the hands, Sun Care Preparations (Cosmetic Products), Make up preparations. Shampoos, Gels, Sprays, Mousses and Balms for the Hair styling and Hair Care and Hair Lacquers, Hair Colouring and Hair Decolorant Preparations, Permanent Waving and Curling Preparations, Essential Oils for personal use included in Class 03;

(g) Trade Mark

L'OREAL ULTRA VOLUME
COLLAGEN

Registration No.

1714864 in Class 3;

Date of Registration	28.07.2008;
Status	Legal, valid and subsisting.
Goods:	Perfume, Toilet Water, Gels, Salts for the bath and shower not for medical purposes, Toilet Soaps, Body Deodorants, Cosmetics namely Creams, Milks, Lotions, Gels and Powders for the face, the body and the hands. Sun Care Preparations (Cosmetic Products), Make up preparations. Shampoos, Gels, Sprays, Mousses and Balms for the Hair styling and Hair Care and Hair Lacquers, Hair Colouring and Hair Decolorant Preparations, Permanent Waving and Curling Preparations, Essential Oils for personal use included in Class 03;
(h) Trade Mark	L'OREAL EXTRA VOLUME COLLAGENE
Registration No.	1778491 in Class 3;
Date of Registration	28.01.2009;
Status	Legal, valid and subsisting.
Goods:	Perfume, Toilet Water, Gels, Salts for the bath and shower not for medical purposes, Toilet Soaps, Body Deodorants, Cosmetics namely Creams, Milks, Lotions, Gels and Powders for the face, the body and the hands, Sun Care

Preparations (Cosmetic Products), Make up preparations, Shampoos, Gels, Sprays, Mousses and Balms for the Hair styling and Hair Care and Hair Lacquers, Hair Colouring and Hair Decolorant Preparations, Permanent Waving and Curling Preparations, Essential Oils for personal use included in Class 03;

(i) Trade Mark

L'OREAL STRAIGHT
PERFECT

Registration No.

1832958 in Class 3;

Date of Registration

25.06.2009;

Status

Legal, valid and subsisting.

Goods:

Perfume, Toilet Water, Gels, Salts for the bath and shower not for medical purposes. Toilet Soaps, Body Deodorants, Cosmetics namely Creams, Milks, Lotions, Gels and Powders for the face, the body and the hands, Sun Care Preparations (Cosmetic Products), Make up preparations. Shampoos, Gels, Sprays, Mousses and Balms for the Hair styling and Hair Care and Hair Lacquers, Hair Colouring and Hair Decolorant Preparations, Permanent Waving and Curling Preparations, Essential Oils for personal use included in Class 03;

(j) Trade Mark

L'OREAL (Label)

Registration No.	1836274 in Class 3;
Date of Registration	03.07.2009;
Status	Legal, valid and subsisting.
Goods:	Perfume, Toilet Water, Gels, Salts for the bath and shower not for medical purposes, Toilet Soaps, Body Deodorants, Cosmetics namely Creams, Milks, Lotions, Gels and Powders for the face, the body and the hands, Sun Care Preparations (Cosmetic Products), Make up preparations. Shampoos, Gels, Sprays, Mousses and Balms for the Hair styling and Hair Care and Hair Lacquers, Hair Colouring and Hair Decolorant Preparations, Permanent Waving and Curling Preparations, Essential Oils for personal use included in Class 03;

(k) Trade Mark L'OREAL 5 PROBLEMS, 1 SOLUTION

Registration No.	1887201 in Class 3;
Date of Registration	20.11.2009;
Status	Legal, valid and subsisting.
Goods:	Perfume, Toilet Water, Gels, Salts for the bath and shower not for medical purposes, Toilet Soaps, Body Deodorants, Cosmetics namely Creams, Milks, Lotions, Gels and Powders for the face, the body

and the hands, Sun Care Preparations (Cosmetic Products), Make up preparations. Shampoos, Gels, Sprays, Mousses and Balms for the Hair styling and Hair Care and Hair Lacquers, Hair Colouring and Hair Decolorant Preparations, Permanent Waving and Curling Preparations, Essential Oils for personal use included in Class 03;

(l)	Trade Mark	L'OREAL
	Registration No.	1832961 in Class 18;
	Date of Registration	25.06.2009;
	Status	Legal, valid and subsisting.
	Goods:	Perfume, Toilet Water, Gels, Salts for the bath and shower not for medical purposes, Toilet Soaps, Body Deodorants, Cosmetics namely Creams, Milks, Lotions, Gels and Powders for the face, the body and the hands, Sun Care Preparations (Cosmetic Products), Make up preparations. Shampoos, Gels, Sprays, Mousses and Balms for the Hair styling and Hair Care and Hair Lacquers, Hair Colouring and Hair Decolorant Preparations, Permanent Waving and Curling Preparations, Essential Oils for personal use included in Class 03;
(m)	Trade Mark	ELVIVE (word mark)

Registration No.	772109 in Class 3;
Date of Registration	22.10.1997;
Status	Legal, valid and subsisting.
Goods:	Perfume, toilet water, gels, salts for the bath and the shower; toilet soaps; body deodorants; cosmetics namely creams, milks, lotions, gels and powders for the face, the body and the hands; sun care preparations; make-up preparations; shampoos; gels, sprays, mousses and balms for the hair styling and hair care; hair lacquers; hair colouring and hair decolorant preparations; permanent waving and curling preparations; essential oils for personal use; dentifrices;

Copy of Certificate of Registration with respect to Trademark No. 165778 in class 3 in favour of the plaintiff along with its advertisement in Trade Marks Journal and its renewal certificates have been exhibited as Ex.PW-1/4 (Colly). Status of the said registered trademarks of the plaintiff as appearing on the web-site of the Trade Mark Registry have been exhibited as Ex.PW-1/5 (Colly.)

8. The plaintiff has been regularly and continuously promoting its said distinctive trademark/trade name and the goods and business thereunder, through various means and modes including through visual, print and electronic media, in leading Newspapers, trade literature and magazines, word of mouth, over the internet etc. and all of which have tremendous reach, availability and circulation world over

including in India. The plaintiff has placed on record various advertisements and other sales promotional literature of the plaintiff as published and circulated in India. The same has been exhibited as Ex.PW-1/9.

9. The plaintiff's said trademark/trade name has acquired enviable and enduring goodwill, reputation and users, and which the plaintiff owns, in the international markets including in India, wherein in addition to the aforesaid the plaintiff also enjoys trans-border reputations and users as extending into India. Downloads from the plaintiff's website have been exhibited as Ex.PW-1/10 (Colly.)

10. It is claimed that the plaintiff's said trademark/trade name are well known trademarks within the meaning of Section 2 (1) (zg) of the Act. A copy of Memorandum and Articles of Association of its subsidiary M/s L'Oreal India Pvt. Ltd, has been exhibited as Ex. PW-1/11.

11. As alleged in the plaint, the defendant No.1, M/s Sigma Enterprises, A-804, Madhuban Height, Bhayander, Thane,401106 and defendant No.2 were initially impleaded as My Dollar Store, Phoenix Mill, Mumbai and also at M-1, Main Market, Greater Kallash, New Delhi. The defendants are engaged in trading of cosmetics, toiletries, hair care products, shampoos and other allied/related goods (hereinafter referred to as "the impugned goods" & "impugned business"). Defendant No. 2 is a dealer/agent of defendant No.1 and owner of 'My Dollar Store'. Defendant Nos.1 and 2 are acting in connivance and in unison with each other. The defendants have adopted and started using the trademarks L'OREAL (hereinafter

referred to as the "impugned trade mark") in relation to their impugned goods. The defendants are also using word PARIS and ELVIVE along with the impugned trademark in order to give a false description to its impugned goods. Specimens of defendants' impugned trademark have been exhibited as Ex. PW-1/12.

12. The impugned trademarks L'OREAL along with PARIS and ELVIVE have been adopted and being used by the defendants in relation to their impugned goods and business is identical with and deceptively similar to the plaintiff's said trademark/trade name L'OREAL in each and every respect including phonetically, visually, structurally, in its basic idea and in its essential features. Defendants have also copied the artistic features involved in the plaintiff's trademark and thus, infringing the plaintiff's copyrights involved in its said trademark. The defendants are using all kinds of false description on its impugned goods to wrongly link the impugned goods with the plaintiff and to wrongly convey to the public and customers that the impugned goods are coming from the source and origin of the plaintiff. The impugned goods and business thereunder are also of the same/similar/allied/cognate to that of the plaintiff's.

13. It is stated that the defendants have adopted and started using the impugned trademark/trade name dishonestly, fraudulently and out of positive greed with a view to take advantage and to trade upon the established goodwill, reputation and proprietary rights of the plaintiff in the plaintiff's trademark/trade name. By the defendants' impugned adoption and use, deception and confusion in the market is ensuing or is likely to so ensue. The plaintiff's said trademark/trade name are

otherwise being diluted and eclipsed thereby. Any person not knowing clearly the relationship between the parties to this action is bound to be confused by the defendants' impugned adoption and use and might as well do business with the defendants thinking that he is dealing with the plaintiff or that some strong, vital and subtle links exist between the plaintiff and the defendants.

14. From the averments made in the plaint and the statements made in the affidavit of PW-1 as well as the material placed on record, the plaintiff has been able to prove its case. There is no rebuttal on part of the defendants. The plaintiff's counsel at the time of hearing has made the statement not to press the relief of damages and rendition of accounts.

15. Therefore, the suit of the plaintiff is decreed as per the prayer clause 38 (a) and (b) of the plaint which are reproduced here as under:-

“(a) For a decree of permanent injunction restraining the defendants by themselves as also through its individual proprietors/partners, agents, representatives, distributors, assigns, heirs, successors, stockists and all others acting for and on their behalf from importing into India in any manner or form the products of the plaintiff under the trademark/trade name and label/trade dresses L'OREAL and ELVIVE or deceptively similar thereto and from commercially and in the course of trade, selling, advertising, distributing or in any other manner, mode or from dealing with them or offering services in connection therewith.

(b) Restraining the defendants from disposing off or dealing with its assets including its

shops/workshop/factory and premises at A- 804, Madhuban Heights, Bhayander, Thane - 401106; My Dollar Store, Phoenix Mill, Mumbai and M-1, Main Market, Greater Kailash, New Delhi and its stocks-in-trade or any other assets as may be brought to the knowledge of this Hon'ble Court during the course of the proceedings and on the defendants disclosure thereof and which the defendants are called upon to disclose and/or in its ascertainment by the plaintiff as the plaintiff is not aware of the same as per Section 135(2)(c) of the Trade Marks Act, 1999 as also it could adversely effect the plaintiffs' ability to recover costs and accounts of profits."

16. The other prayers 38 (c), (d) and (e) of the plaint i.e. for delivery up, rendition of accounts and damages are given up.
17. The plaintiff is also entitled for costs.
18. Decree be drawn accordingly.

(MANMOHAN SINGH)
JUDGE

NOVEMBER 06, 2015