

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

% Decided on: 3rd November, 2017

+ **CS(COMM) 567/2017**

M/S. L'OREAL

..... Plaintiff

Represented by: Mr.Ajay Amitabh Suman,
Mr. Kapil Kumar Giri and
Mr. Vinay Shukla, Advocates.

versus

SHRI YOGESH JETHI & ANOTHER.

.....Defendants

Represented by: None.

CORAM:

HON'BLE MS. JUSTICE MUKTA GUPTA

MUKTA GUPTA, J. (ORAL)

1. As per the plaint, the plaintiff prays for the following reliefs:

- a) *For a decree of permanent injunction restraining all the defendants by themselves as also through their individual proprietors/partners, agents, representatives, distributors, assigns, heirs, successors, stockists and all others acting for and on their behalf from using, selling, soliciting, exporting, displaying, advertising or by any other mode or manner dealing in or using the impugned trade mark L'OREAL with or without the word PARIS or any other word/mark which may be identical with and/or deceptively similar word/mark to the plaintiff's said trade mark/trade name L'OREAL in relation to their impugned goods and business of cosmetics and other related/allied products and from doing any other acts or deeds amounting to or likely to:-*
- i) *infringement of plaintiff's aforesaid registered trademark L'OREAL.*

ii) Passing off and violation of the plaintiff's rights in the plaintiff's said trade mark L'OREAL.

iii) violation of plaintiff's proprietary rights in its trade name i.e., L'OREAL.

iv) Infringement of plaintiff's copyrights in its L'OREAL Label.

b) for an order for delivery up of all the impugned finished and unfinished materials bearing the impugned and violative trade mark L'OREAL or any other word/mark which may be identical with or deceptively similar to the plaintiff's said trade mark/trade name L'OREAL including its blocks, labels, display boards, sign boards, trade literatures and goods etc. to the plaintiff for the purposes of destruction and erasure.

c) for a money decree for grant of damages of ₹40,00,000/- (Rupees Forty Lakh only) from and against the defendants, jointly and severally to the plaintiff.

d) for an order for cost of proceedings.

2. Summons in the suit were issued to the defendants on 7th January, 2009 and an ex-parte interim order was passed in favour of the plaintiff and against defendants from using trade mark 'L'OREAL PARIS'. Defendant No. 1 entered appearance on 13th February, 2009. Since Defendant No. 2 could not be served, he was directed to be served through publication vide order dated 5th February, 2010. Defendant no. 2 entered appearance on 27th October, 2010. However, defendant no. 2 failed to file written statement, thus, he was proceeded ex-parte vide order dated 5th September, 2011.

3. Vide order dated 5th December, 2011, following issues were settled:

i. Whether the suit has been filed by a competent person? OPP

ii. Whether the plaintiff is the owner and proprietor of the trademark 'L'OREAL'? OPP

iii. Whether the defendants are guilty of infringing the registered trademark 'L'OREAL' of the plaintiff? OPP

- iv. *Whether the defendants are passing off their goods as that of plaintiff? OPP*
- v. *Whether defendant no. 1 has never dealt with the goods of the plaintiff at any point of time? OPD-1*
- vi. *Whether the defendants are guilty of infringing the copyright of the plaintiff in the trademark 'L'Oreal'? OPP*
- vii. *Relief.*

4. Defendant no.1 was also proceeded ex-parte vide order dated 18th December, 2014. Thus, the plaintiff led its ex-parte evidence.

5. As per the plaint, plaintiff is a company duly incorporated under the laws of France. 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 and skin, toilet soaps, dentifrices, sun-tan preparations, personal deodorants and other allied/related products.

6. Plaintiff has been using the word/mark 'L'OREAL' in stylized, formative and label as a trade mark since about 1910-1915 in relation to the aforesaid goods and business. Plaintiff's goods under the trademark 'L'OREAL' have acquired goodwill and reputation globally and in India as well. Plaintiff's goods under the aforementioned trademark are sold in about 130 countries across the world including India.

7. Plaintiff's trademark 'L'OREAL' as a word mark was registered in India in class 3 in the year 1954 and was renewed subsequently from time to

time. Apart from the aforesaid registration, plaintiff had filed various other applications for registration of its said mark in India.

8. It is the case of the plaintiff that the art work involved in various 'L'OREAL' stylized, formative/bearing and labels are original artistic works and plaintiff holds copyright therein. The plaintiff had been continuously promoting its distinctive mark/ trade name and the goods and business through extensive advertisements, publicity, promotion and marketing research and the plaintiff has spent enormous amount of money, effort, skill and time thereon. It is the claim of the plaintiff that the plaintiff's trademark has acquired enviable and enduring goodwill, reputation and users. Plaintiff also enjoys trans-border reputation.

9. Plaintiff's trademark has become distinctive and has acquired secondary significance with the plaintiff's goods and business. In view of plaintiff's proprietary rights both statutory and common law, its goodwill, reputation and its copyright, the plaintiff has the exclusive right to the use of the trademark.

10. Defendants are engaged in trading of cosmetics, toiletries, hair care products and other allied/related goods. Defendants have adopted and started using the trade mark L'OREAL in relation to its products. Defendants are also using the word 'PARIS' along with the impugned trademark in order to give a false description to its goods.

11. The impugned trade mark L'OREAL 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 trade mark/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 trade mark and is thus infringing the plaintiff's trade mark as also the copyright involved in its trade mark.

12. Defendants are not the proprietor of the impugned trademark and their adoption and use of the trademark violates the plaintiff's trademark and thereby passing off and enabling others to pass off their goods and business as that of the plaintiff as well as diluting the plaintiff's proprietary rights therein.

13. In December, 2007 when the plaintiff came to know that some unknown persons and firms have illegally adopted and are using the impugned trade mark plaintiff filed a complaint under Sections 103/104 of the Trade Marks Act, 1999 before Additional Chief Metropolitan Magistrate, Delhi complaining violation of plaintiff's said trademark and copyrights. Ld. ACMM directed the police to investigate the matter. Consequently FIR No. 55 dated 24th March, 2008 was registered at Police Station Economic Offences Wing under sections 103 and 104 of the Trade Marks Act, 1999 and Section 63 of the Copyright Act, 1957. During the investigation the police on 25th March, 2008 conducted raids at the premises of defendant No. 1, where defendant No. 1 was found to be dealing in impugned goods bearing the impugned trade mark.

14. In May 2008, plaintiff also came to know that defendant No. 2 is also dealing in impugned goods bearing impugned trade mark. Being aggrieved by the acts and conduct of defendant No. 2, plaintiff lodged FIR being FIR No. 125 dated 3rd May, 2008 at Police Station Bhyculla, Mumbai. Consequent to this FIR raids were conducted at the premises of defendant No. 2 on 3rd May, 2008 from where impugned goods bearing impugned

trade mark were seized in large quantities. During investigations, defendant No. 2 disclosed that defendant No. 1 supplies impugned goods bearing impugned trade mark to defendant No. 2.

15. The plaintiff led ex parte evidence and examined Mr. Nirmal Singh as PW-1. He tendered his evidence by way of an affidavit (Ex. PW-1/A) and additional affidavit (Ex. PW-1/A1). Copy of the power of attorney in his favour was exhibited as Ex. PW-1/1. Specimen of plaintiff's trademarks/labels were exhibited as Ex. PW-1/2 to Ex. PW-1/8. Statistics/reports showing plaintiff's sales, growth and economic strength were exhibited as Ex. PW-1/9. Certified copy of the magazines like Cosmopolitan, Star Dust and Filmfare in which various advertisements and sales promotional literature of the plaintiff were published were exhibited as Ex. PW-1/10 (colly). Specimen of defendants trademark/label was exhibited as Ex. PW-1/12 and Ex. PW-1/13. Copy of the FIR No. 55/08 dated 24th March, 2008 registered at Police Station Economic Offences Wing along with search and seizure memo was exhibited as Ex. PW-1/14 (colly). English Translation of FIR No. 125 dated 3rd May, 2008 at Police Station Bhyculla, Mumbai was exhibited as Ex. PW-1/15. Legal Proceeding Certificates of registrations of trade mark L'OREAL were exhibited as Ex. PW-1/X (colly). Affidavit under Section 65B of the Evidence Act with respect to Ex. PW-1/9 was placed on record as Ex. PW-1/20.

16. Specimen of plaintiff's trademark/label is as under:





17. Specimen of defendant's trademark/label is as under:





18. The evidence of the plaintiff has gone unrebutted. On the basis of the documents placed on record, this Court is of the view that the plaintiff has established that plaintiff is the owner of the trademark 'L'OREAL' and is also the copyright owner in the artistic work of the stylized, formative/bearing and label 'L'OREAL'. Plaintiff has also established that it enjoys reputation and goodwill with respect to the aforesaid trademark. Plaintiff has also been successful in demonstrating that the defendants by adopting plaintiff's trademark 'L'OREAL' are infringing the trade mark of the plaintiff, copyright therein and passing off their goods as those of the plaintiff. Thus, plaintiff is entitled to a decree of permanent injunction against the defendants

19. Since the plaintiff has not led evidence with respect to the damages caused to them except for a court fee of ₹21,000/-, prayer (c) of the plaint is allowed partially.

20. Consequently, the suit is decreed in favour of the plaintiff and against the defendants in terms of prayer (a) with a cost of ₹21,000/-.

(MUKTA GUPTA)
JUDGE

NOVEMBER 03, 2017
‘yo’



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