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

+ **RFA-IPD 1/2021 & CM APPL. 1129/2013**

VIJAY ABROL

..... Appellant

Through: Mr. Mohan Vidhani and Mr. P.K. Jain,
Advocates.

versus

YOGESH KUMAR RUSTOGI

..... Respondent

Through:

+ **RFA-IPD 5/2021**

VIJAY BAROL

..... Appellant

Through: Mr. Mohan Vidhani and Mr. P.K. Jain,
Advocates.

versus

YOGESH KUMAR RUSTOGI

..... Respondent

Through:

CORAM:

HON'BLE MR. JUSTICE ANISH DAYAL

O R D E R – Judgement Oral

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21.05.2024

1. These Regular First Appeals have been filed assailing the impugned judgment and decree dated 09th November 2012 passed by the Additional District Judge-08, Central, Delhi decreeing the suit filed by respondent/plaintiff, being CS No. 2434/2000 / 254/2010, and dismissing the



counter claim filed by appellant/defendant being No. 254/ 2010.

2. Appeal was admitted on 21st January 2013. Mr. Yogesh Goel, Advocate appeared for respondent/plaintiff till 2016. However, no one appeared for respondent/plaintiff after 2021. Attempts were made on behalf of counsel for appellant/defendant as well, to contact the counsel for respondent/plaintiff. An email communication has been handed up in Court wherein Mr. Yogesh Goel, by an email dated 02nd March, 2024, has responded to the counsel for appellant/defendant, stating that his client has not been in touch and he is not appearing in these matters for the respondent/plaintiff.

3. Subsequently, the appellant/defendant placed additional information before this Court in that they had secured the registration for the trademark



in relation to mathematical instruments, scales, geometry box, stationary goods, falling in Class 16, on 17th October 2022, with effect from 24th February 2010 in trademark application no. 1926805.

4. Further, the respondent/plaintiff's application for trademark bearing no. 962601 for the word mark 'BRITE' is deemed to have been abandoned under Rule 45(2) of the Trade Marks Rules, 2017 on 6th September 2022. Copy of the order and the Status Report has been placed on record by appellant/defendant under index dated 01st March 2024.

5. These documents were sought to be served by appellant/defendant's counsel for respondent/plaintiff itself and were duly dispatched by speed post on 05th March 2024. As per the tracking report filed on record of this Court, the item was returned as no such person was found on the address.



6. In these circumstances, the Court was inclined to hear the appeal on merits, considering that it had been pending before this Court for the last 11 years. The issue in question was a passing off suit filed by the respondent/plaintiff against the appellant/defendant seeking permanent injunction, on the basis that the respondent/plaintiff was a sole proprietor of M/s Radhey Shyam & Sons and M/s. Stationary Syndicate. The respondent/plaintiff claimed that he was an old established business and a manufacturer and merchant of stationary goods including mathematical instruments, foot ruler, clips, all pins, erasers, and other cognate and allied goods since 1988.

7. It was further claimed that in 1990, the respondent/plaintiff conceived and adopted the trademark '**BRITE**' in course of trade and had been extensively using it since 1990.

8. Accordingly, he claimed reputation and goodwill in the market in the trademark '**BRITE**'. The respondent/plaintiff's grievance was against the appellant/defendant who was manufacturing and selling stationary items also under the trademark '**BRITE**' and also adopted the corporate name M/s Brite Stationers and Manufacturers.

9. The respondent/plaintiff claimed that they came to know about the appellant/defendant in the first week of October 2000 when a notice dated 27th September 2000 was received on behalf of the respondent/plaintiff's trademark attorney, accusing the respondent/plaintiff for dishonest adoption of the said mark.

10. A counter claim was filed by appellant /defendant stating that they were manufacturing and marketing mathematical instruments and foot rulers for students since December 1992 and under the trading name and style of M/s



Brite Stationers and Manufactures. They also claimed to be a member of Delhi Stationers Association (Regd.) at Nai Sarak, Delhi- 110006. They claimed to have acquired extensive reputation and good will in the trademark '**BRITE**' for these stationary items. Along with their counter claim, they filed documentation to show extensive sales, advertising and promotional materials to market their brand '**BRITE**'.

11. Issues were framed on 30th September 2002. Aside from procedural issues and others, the issues relevant for this appeal are issues 2 and 3, which are extracted as under:

*“(2) Whether the defendant has been passing off its goods as that of the plaintiff under the trademark **BRITE** and if so, its effect? (OPP)*

*(3) Whether the plaintiff is prior in adoption and use of the trademark **BRITE** and if so, its effect? (OPP)”*

12. In determination of these issues, the Trial Court took note of the sales invoices submitted by the respondent/plaintiff as Ex. PW-1/1 to PW-1/48. It was also noted that the appellant/defendant had admitted that they had started using the trademark '**BRITE**' from 01st December 1992 and they were using their trading name as M/s. Brite Stationers and Manufacturers.

13. Considering that no sample or packaging had been placed by respondent/plaintiff, the packaging placed by appellant/defendant was exhibited as Ex. PW-1/D1, which was manufactured and marketed by Stationary Syndicate. The respondent/plaintiff claimed, in its replication, that Stationary Syndicate came into existence in 1997 and later in the cross-examination stated that they were functioning since 1992.



14. However, the Trial Court noted that the respondent/plaintiff had noted that no bill was issued in the name of Stationary Syndicate. It was, therefore, held that it could not be believed that bills produced by respondent/plaintiff pertaining to trademark '**BRITE**' in respect of foot rulers were under the same packaging/wrapper and that respondent/plaintiff could be having manufacturing and marketing wooden foot rulers under the trademark '**BRITE**' before 1997.

15. It was recorded by Trial Court, there was no evidence on record showing prior use of the trademark. However, the Trial Court relied upon the bills, Ex. PW-1/1 to PW-1/48 as submitted by respondent/plaintiff. On the basis that no suggestion was put by appellant/defendant that these bills were fabricated or forged, or not genuine, the Trial Court took into account the said bills, which included those since 1990-91.

16. Merely on this basis, the finding of the Trial Court was that respondent/plaintiff had started using the mark since 1990-91, appellant/defendant had started using the mark since 1992, and therefore, decreed the suit in favour of the respondent/plaintiff.

17. Counsel for appellant/defendant, however, points out that during the cross-examination, the respondent/plaintiff had produced all their bill books while they had filed only 48 number of bills along with the plaint. They have also shown to this Court a certified copy of these bills or the bill books submitted by respondent/plaintiff, in particular pointing out to some bills of the year 1990-91.

18. The analysis chart of these bills has also been made and appended as Annexure-L to the appeal. A perusal of the said chart as well as the bill books would bear out the following:



- i. The bill books are mostly handwritten bills, which are purported to be under M/s Radhey Shyam & Sons, although that is not evident immediately from a perusal of the said bills. The Court has perused the bills under number 501 till 515 in particular. Some scattered isolated bills are in the name of M/s Radhey Shayam & Sons on a typed invoice, however, are mostly of 1993 onwards. It is not noticed that any of the bills of 1991 are, in fact, on a typed invoice copy;
 - ii. Most of these bills do not show any mention of trademark '**BRITE**' and even if they do, those are in respect of '*foot rulers*';
 - iii. These bills also show various other products are sold under Radhey Shyam & Sons and Stationary Syndicate including boxes, sharpeners, rulers, erasers, pencils under different brand names, *inter alia* Bharat, Venus, Natraj, Swati, Crystal, Archies, etc. On this basis, the appellant/defendant's counsel submits that it is an indication that appellant/defendant was a trader and not a manufacturer;
 - iv. As per the said analysis of the bills, the total turnover till December 1992 when appellant/defendant started its enterprise, amounts to Rs. 23,043/- which, the appellant/defendant's counsel claims, is hardly evidence of wide reputation in the mark '**BRITE**' in order to sustain a passing off action.
19. In these facts and circumstances, it is quite evident that the Trial Court has not taken an assessment of the bill books filed by the respondent/plaintiff in the right perspective and, merely on the basis lack of cross-examination, has decreed the suit in favour of respondent/plaintiff.
20. It is settled law that to sustain an action for passing off, the triple test has to apply i.e. – *firstly*, the respondent/plaintiff has to establish a goodwill and



reputation in the mark; *secondly*, it has to be shown that the defendant has adopted deception or misrepresentation; and *thirdly*, that plaintiff has suffered loss and damages.

21. The Trial Court has not assessed these factors in any detail. Goodwill and reputation cannot be established on the basis of these documents filed by respondent/plaintiff, and also the adoption by appellant/defendant of the said mark cannot be said to be dishonest for the reason that not only they are using that as a trading name and style but they apply the said mark on the portfolio of all their products as is evident from the record. Further, they happen to be part of the Delhi Stationers Association (Regd.) showing that they are a responsible enterprise and not attempting to ride on the goodwill of any other entity.

22. Moreover, the presence of '**BRITE**' in the respondent/plaintiff's portfolio seems to be only for foot rulers and, as per the analysis made above, it seems that the respondent/plaintiff was only at best a trader vending products of various brands through his enterprise.

23. Else, the bills filed by respondent/plaintiff, if they were to establish a goodwill and reputation in '**BRITE**', would have shown extensive sales and use, however, it is not so.

24. Moreover, considering the subsequent events as well, of the appellant/defendant's trademark now being registered and respondent/plaintiff's being abandoned, it gives further support to the conclusion that the respondent/plaintiff did not have any real basis for prosecuting their suit.

25. On the basis of above discussion and assessment, the appeals are allowed and decree passed against the appellant/defendant is set aside.

26. In these circumstances, now that the mark has been registered in favour



of appellant's, counsel for appellant/defendant states on instructions that they do not want to pursue the counter claim as well.

27. In view of this, present appeals are disposed of with the above directions.

28. Order be uploaded on the website of this Court.

ANISH DAYAL, J

MAY 21, 2024/RK/sc