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

% Judgment delivered on: 10.12.2015

+ **FAO(OS) 575/2015 & CM No. 23367/2015**

RETAIL ROYALTY COMPANY Appellant

versus

PANTALOONS FASHION & RETAIL
LIMITED & ORS

..... Respondents

Advocates who appeared in this case:

For the Petitioner : Mr Sudhir Chandra, Sr. Advocate with Mr Sujata Chaudhri,
Advocate

For the Respondents : Mr Ajay Sahni, Ms Kanika Bajaj, Ms Prena Verma, Mr
Sudhanshu Suman, Mr Gopal Nain and Mr Navneet Mathur,
Advocates

CORAM:-

HON'BLE MR JUSTICE BADAR DURREZ AHMED

HON'BLE MR JUSTICE SANJEEV SACHDEVA

JUDGMENT

BADAR DURREZ AHMED, J (ORAL)

1. We have heard the learned counsel for the parties. The appellant/plaintiff had filed the suit, inter-alia, for infringement of trademarks and copyright. The marks of the plaintiff/appellant which are registered with the Trademarks Registry are as under:-

(i) AMERICAN EAGLE

(ii) AMERICAN EAGLE OUTFITTERS

(iii) Eagle Device



2. The complaint was in respect of the marks which were being used by the respondent/defendant as under:-

(i) URBAN EAGLE AUTHENTIC OUTFITTERS

(ii) Eagle Devices



3. The appeal has been filed because the learned Single Judge has not granted any injunction in favour of the appellant. Mr Sudhir Chandra, learned Senior Counsel appearing on behalf of the appellant submitted that the marks and devices adopted by the defendant amounted to clear infringement of the rights under the Trademarks Act of the plaintiff/appellant, in as much as, the marks and devices were deceptively similar.

4. Before the learned Single Judge, the defendant/respondent had agreed to give up the words “AUTHENTIC OUTFITTERS” and thereby to only retain the mark “URBAN EAGLE”. The learned Single Judge had agreed with this proposal of the defendant/respondent.

5. This was on the basis that when the plaintiff/appellant sought registration of its marks, in particular, ‘AMERICAN EAGLE’, a point had been raised that there existed several entities which had registered trademarks bearing the word ‘EAGLE’. The plaintiff/appellant, at that point of time, had submitted before the Trademarks Registry that it is not the word ‘EAGLE’ which is to be seen but composite marks ‘AMERICAN EAGLE’ and ‘AMERICAN EAGLE OUTFITTERS’ which had to be seen and which are distinctive marks. It is on this basis that the trademarks were registered in favour of the appellant/plaintiff.

6. This being the position, we agree with the submissions made by the respondent and also as accepted by the learned Single Judge that the plaintiff/appellant cannot appropriate the word ‘EAGLE’ although it is the proprietor of the mark ‘AMERICAN EAGLE’ and the mark ‘AMERICAN EAGLE OUTFITTERS’. As such, an injunction cannot be granted, prima facie, because the marks ‘URBAN EAGLE’ and ‘AMERICAN EAGLE’, in our view, are not deceptively similar marks.

7. In so far as the Eagle Device employed by the appellant/plaintiff and the Eagle Devices used by the defendant/respondent are concerned, we find that they are deceptively similar. The distinction sought to be brought by the learned Single Judge referring to the appellant’s Eagle Device as a ‘*swooping Eagle*’ and that of the respondent/defendant as a ‘*taking off or a flying eagle*’ is too minute when we consider that the two devices would be viewed by a person

of average intelligence with imperfect recollection and we must also bear in mind that when the test of deceptive similarity is employed, the two marks cannot be kept side by side, they are to be considered as if they have been viewed at different points of time.

8. That being the case, prima facie, we find that the Eagle Devices employed by the respondent/defendant are deceptively similar to the registered Eagle Device of the plaintiff/appellant. Consequently, the respondents are restrained from employing the Eagle devices, which have been impugned in the present proceedings. However, we grant one month's time to the respondent/defendant to exhaust the stocks. In so far as the word marks are concerned, the respondents can only use the mark 'URBAN EAGLE' without adding the words 'AUTHENTIC' and/or 'OUTFITTERS'.

9. The appeal is partly allowed. We are making it clear that any observations made in this order are purely prima facie in nature and will not come in way of either party in the trial of the suit.

BADAR DURREZ AHMED, J

DECEMBER 10, 2015
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SANJEEV SACHDEVA, J