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

+ CS(OS) 1059/2005 & IA No.17064/2013 (u/S 124 Trademarks Act)
& CC No.1349/2005

M/S MARC ENTERPRISES PVT. LTD. Plaintiff
Through: Mr. Ajay Amitabh Suman, Adv.

Versus

M/S FIVE STAR ELECTRICALS (INDIA) AND ANR ...Defendants
Through: Mr. Saurabh Srivastava, Ms. Shilpa
Gupta, Mr. Ranjeet Singh Sidhu and
Ms. Arpika Singhal, Advs. for D-1.

CORAM:

HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

ORDER

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10.11.2016

1. The suit is ripe for final hearing.
2. The plaintiff sued the (i) defendant No.1 Five Star Electricals (India) (informed to be the sole proprietorship of Mr. Gaurav Arya) and (ii) defendant No.2 B-Tech House, for injunction restraining the defendants from using the trademark 'MARC' or any other trademark similar or identical thereto in infringement of the trademark 'MARC' of the plaintiff and passing off their goods as that of the plaintiff and for ancillary reliefs.
3. The counsel for the defendant No.1 Five Star Electricals (India) informs that defendant No.2 B-Tech House was proceeded against *ex-parte*. It is further stated that the present suit is for the relief of passing off

only and the defendant No.1 Five Star Electricals (India) is willing to give up the trademark 'MARC' but needs a transit period of six months for the said purpose and whereafter the decree for permanent injunction can become operative.

4. On enquiry, it is informed that there is no interim injunction in this suit.

5. It is further stated that the defendant No.1 Five Star Electricals (India) is intending to change its mark to 'MARSELLA' and 'MARXELLA'.

6. The counsel for the defendant No.1 on enquiry further states that though the mark of the defendant No.1 Five Star Electricals (India) was also registered but on a rectification application filed by the plaintiff, the defendant's mark has been struck off and a writ petition has been filed by the defendant No.1 Five Star Electricals (India) against the said order and which is pending consideration and there is an interim order in the said writ petition.

7. On further enquiry, it is stated that if the aforesaid is agreeable to the counsel for the plaintiff, the defendant No.1 Five Star Electricals (India) will withdraw the said writ petition being W.P.(C) No.6448/2013 also on the same terms.

8. The counsel for the plaintiff is agreeable to the aforesaid but contends that the plaintiff is not agreeable to the defendant No.1 Five Star Electricals (India) adopting the mark 'MARSELLA' or 'MARXELLA', both of which according to the plaintiff are deceptively similar to the registered trademark 'MARC' of the plaintiff.

9. However, on enquiry as to how the said question is to be gone into in these proceedings when there is no evidence on this aspect, it is stated that this Court may not put its stamp of approval on use by the defendant No.1 Five Star Electricals (India) of the marks 'MARSELLA' or 'MARXELLA' and leave it open to the plaintiff to, if feels aggrieved from any such mark adopted by the defendant No.1 Five Star Electricals (India), take appropriate action with respect thereto.

10. The counsel for the plaintiff also controverts that the present suit is not for infringement. It is stated that vide interim order dated 8th October, 2013 in W.P.(C) No.6448/2013 supra, the defendant No.1 Five Star Electricals (India) herein has been restrained from representing or claiming its mark to be a registered trademark and on the said condition the removal of the mark from the register has been stayed. A copy of the said order is shown.

11. It is also informed by the counsel for the plaintiff that while the plaintiff is using the trademark 'MARC' for electrical products as described in para 2 of the plaint, the defendant No.1 Five Star Electricals (India) is using the same on the goods as stated in para 2 of the preliminary objection of the written statement of the defendant No.1 Five Star Electricals (India).

12. The counsel for the defendant No.1 Five Star Electricals (India) controverts that the plaintiff is using its trademark 'MARC' with respect to all the goods as described in the plaint.

13. On a reading of the order dated 8th October, 2013 in W.P.(C) No.6448/2013, the counsel for the plaintiff is found to be correct in contending that the plaintiff is not precluded from claiming the relief in this

suit on the ground of infringement also.

14. In view of the aforesaid, a decree for permanent injunction is passed in favour of the plaintiff and against the defendants in terms of para 26 (i)(a) to (c) of the plaint. However, to enable the defendant No.1 Five Star Electricals (India) to take steps for stopping using the trademark 'MARC', the said decree shall come into operation with effect from 30th June, 2017.

15. All pending applications have become infructuous and be treated as disposed of in terms of above.

16. In view of the aforesaid, CC No.1349/2005 is also disposed of.

17. The parties are left to bear their own costs.

18. Decree sheet be drawn up.

RAJIV SAHAI ENDLAW, J.

NOVEMBER 10, 2016

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