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

+ **CS(OS) 1049/2011**

DISNEY ENTERPRISES, INC. & ANR

..... Plaintiffs

Through : Mr Bharat S Kumar, Adv

versus

DISNEYLAND HIGH SCHOOL & ANR

..... Defendants

Through : None being *ex-parte*.

CORAM:

HON'BLE MR. JUSTICE VIBHU BAKHRU

ORDER

04.08.2016

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1. The plaintiffs have filed the present suit for permanent injunction, *inter alia*, praying as under:-

“a. An order and decree for permanent injunction restraining the Defendants, their directors, partners or proprietors, their officers, servants, agents, members and all persons, in active concert or participation with the Defendants from, using the trade mark DISNEYLAND or DISNEY or any deceptive variant thereof, as part of their school name/ society's name / trading style / trade name or in any other manner thereby amounting to infringement of the Plaintiff No. 1's registered trade marks as detailed above;

b. An order and decree for permanent injunction restraining the Defendants, their directors, partners or proprietors, their officers, servants, agents, members and all persons, in active concert or participation with the Defendants from, using the trade mark DISNEYLAND or DISNEY or any deceptive variant thereof, as part of their school name/ society's name / trading style / trade name or in any other manner thereby amounting to passing off.

- c. An order and decree for delivery up by the Defendants of all finished and unfinished goods, materials, advertising material, blocks, dies etc. bearing the word marks / likenesses of the Plaintiff's trademarks or any other marks deceptively similar to that of the Plaintiffs', including but not limited to DISNEYLAND or DISNEY, or any other material infringing the trademarks of the Plaintiffs, lying in the possession of the Defendants and its principal officers, directors, agents, franchisees, servants, members etc;
- d. An order and decree for rendition of accounts of profits, directly or indirectly earned by the Defendants from its infringing activities and wrongful conduct and a decree for the amount so found due to be passed in favour of the Plaintiffs;
- e. A sum of Rs. 20,00,200 for a decree of damages as valued for the purposes of this suit in the preceding paragraph for the purposes of loss of business and sales, reputation and goodwill of the Plaintiffs' trade marks caused by the activities of the Defendants;”

2. By an order dated 03.05.2011, this Court passed an *ex-parte ad-interim* injunction restraining the defendants from using the trademarks “DISNEY” and “DISNEYLAND” or any other mark deceptively similar to Plaintiff no 1’s registered trademarks. Initially, the defendants had entered appearance and various opportunities were granted to the defendants to file their Written Statement. However, the defendants failed to file their Written Statement and on 15.03.2012, the right of the defendants to file the Written Statement was closed. The defendants also failed and neglected to appear and they were proceeded *ex-parte* on 23.04.2012.

3. Mr. Vishal Ahuja, being authorized signatory and constituted attorney of the Plaintiffs’, has filed an affidavit affirming the averments made in the

plaint. Mr Vishal Ahuja (PW1) has also filed evidence by way of affidavit. Ex. PW1/1 and PW1/2 are the copies of Letter of Authority on behalf of plaintiff no 1 and Power of Attorney on behalf of plaintiff no 2 authorising PW1 to represent the plaintiffs in the present suit.

4. The Plaintiff No.1 is a corporation formed under the laws of the State of Delaware, USA and Plaintiff No.2 is a master licensee of Plaintiff No.1's copyrights and trademarks in India. It is stated that the Plaintiff No.1 is the exclusive owner and proprietor of the trademark "DISNEY" and "DISNEY LAND" in India. It is further stated that the trademark "DISNEY" is a registered trade mark, however, the registration of the said mark has elapsed due to oversight and is pending restoration.

5. The trademark "DISNEY" is a *well known* mark. PW1 has affirmed that the same was adopted in the year 1923 and by virtue of continuous and extensive use, it has become popular and has come to be recognised as associated with Walt Disney Company. The Plaintiffs are stated to be the subsidiaries of the Walt Disney Company, which is also famous for establishing well known entertainment parks known as DISNEY LAND. The word DISNEY is used in conjunction with several ventures and businesses carried on by the Walt Disney Company, its subsidiaries or associates/affiliates. It is further stated that the word "DISNEY" was originally a surname of the founder and has no occasion or relevance in the Indian context.

6. It is stated in the plaint that defendant no 1, DISNEYLAND HIGH SCHOOL is a private unaided high school located at Hyderabad and

defendant no 2, DISNEYLAND EDUCATIONAL SOCIETY is a society that manages and operates defendant no 1. It is further stated that sometime in November,2010, the plaintiffs came to know that defendants are carrying on their activities under the names “DISNEYLAND HIGH SCHOOL” and “DISNEYLAND EDUCATIONAL SOCIETY,” which are similar to plaintiff no 1’s registered trademark “DISNEYLAND”. PW 1 has placed on record the photographs and advertisement evidencing the use of the plaintiffs registered trademark by the defendants as Ex PW1/12. It is stated in the plaint that defendants’ unauthorized and illegal act of incorporating plaintiff no 1’s well know mark “DISNEYLAND” as a part of their trade name is a violation of plaintiff no 1’s statutory as well as common law rights in the trademark “DISNEYLAND” and other “DISNEY” related marks.

7. The use of the word DISNEYLAND as a part of the name of the school as well as name of the society is clearly with an object to show association with the well known Walt Disneyland group. The DISNEYLAND is well known chain of entertainment parks which is very popular with the children. The use of word DISNEYLAND by the Defendants is clearly with an object of taking advantage of the popularity of the said name and also obviously to garner the unfair benefit.

8. The facts stated in the Plaint are not controverted. Therefore, the plaintiffs would be entitled to a decree of permanent injunction restraining the defendants from using in any manner the tradename “DISNEY” or “DISNEYLAND”. However, the Plaintiffs have not been able to establish that they have incurred any loss or suffered damages on account of

defendants using the name “DISNEYLAND” as part of their name. Accordingly, the suit of the plaintiffs is decreed in terms of prayer (a) and (b), as quoted above.

9. The Decree Sheet be drawn up.

IA No.7056/2011

10. In view of above order, instant application does not survive anymore and same stands disposed of accordingly.

VIBHU BAKHRU, J

AUGUST 04, 2016

O/M