

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

% Decided on: 21st August, 2017

+ **CS(COMM) 322/2016**

M/s. L'OREAL Plaintiff

Represented by: Mr. Ajay Amitabh
Suman, Advocate.

versus

Sh. YOGESH JATHI & ANR.Defendants

Represented by: None.

CORAM:

HON'BLE MS. JUSTICE MUKTA GUPTA

MUKTA GUPTA, J. (ORAL)

1. By the present suit, plaintiff seeks the following reliefs:

(a) *“For a decree of permanent injunction restraining all the defendants by themselves as also through their individual proprietors/partners, employees, agents, representatives, distributors, assigns, heirs, successors, stockiest 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 GARNIER or any other word/mark which may be identical with and/or deceptively similar to plaintiff’s said trade mark/trade name GARNIER in relation to impugned goods and business of toiletries; personal care, scalp care, hair care products, 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 trademark GARNIER registered under No. 491768, 1041162, 1335359 in Class 3;*

- ii. *Passing off and violation of the plaintiff's rights in the plaintiff's said trade mark GARNIER.*
 - iii. *Violation of plaintiff's proprietary right in its trade name i.e. GARNIER.*
 - iv. *Infringement of plaintiff's copyrights in its GARNIER Label.*
- (b) *For an order for delivery up of all the impugned finished and unfinished materials bearing the impugned and volative trade mark GARNIER or any other word/mark which may be identical with or deceptively similar to the plaintiff's said trade mark/trade name GARNIER including its blocks, label display boards, sign boards, trade literatures and goods etc. to the plaintiff for the purposes of destruction and erasure.*
- (c) *For a money decree of damages to the tune of ₹ 40,00,000/- (Rupees Forty Lakh Only) to be paid by the defendants, jointly and severally.*
- (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 restraining them from using trade mark 'GARNIER' in relation to toiletries and other related products. Defendant No. 1 entered appearance on 3rd March, 2009. Since Defendant No. 2 could not be served, he was directed to be served through publication vide order dated 14th January, 2010 and subsequently, through affixation on 9th May, 2011. However defendant no. 2 did not enter appearance, and was proceeded ex-parte vide order dated 4th November, 2011. Though Defendant no.1 initially appeared and filed written statement, however, he stopped appearing from 4th February, 2013 and did not file any written statement to the

amended plaint. Defendant No. 7 was thus proceeded ex-parte vide order dated 29th August, 2014.

3. As per the amended plaint, plaintiff is a company duly incorporated under the laws of France. Plaintiff had acquired all the rights pertaining to the subject matter trade mark/label GARNIER from M/s. Laboratorie Garnier & CIE vide dissolution deed dated 28th November, 2011. Defendant No.1 Yogesh Jethi and Defendant no. 2 Hanif Rahim Memom alias Pappu are engaged in the trading of toiletries, hair care products and other allied products.

4. It is the case of the plaintiff that the impugned trade mark GARNIER was adopted and used by the defendants in relation to their impugned goods and business which is identical and deceptively similar to the plaintiff's trade mark GARNIER. The defendants also copied the artistic features involved in the plaintiff's mark. The defendants are using all kind of false description on its goods to wrongly link the goods with that of the plaintiff. The defendants are not the proprietor of the impugned trade mark, however, by adopting the trade mark, are violating the plaintiff's trade mark and thereby passing off of their goods as that of plaintiff's and diluting plaintiff's proprietary rights therein.

5. Plaintiff came to know in December, 2007 that some unknown persons have illegally adopted and were using the impugned trade mark. A complaint was filed and consequently FIR No. 56/2008 was registered at PS Economic Offences Wing under Sections 103 and 104 of Trademark Act 1999 and Section 63 of Copyright Act. During the investigation, raids were conducted and defendant no. 1 was found to

be dealing with goods bearing the impugned trade mark. In May 2008, plaintiff came to know that defendant no. 2 was also dealing in goods bearing impugned trade mark. Consequently, FIR No. 125/2008 was lodged at PS Bhyculla Mumbai under Sections 419 & 420 IPC and Sections 51 & 63 of Copyright Act.

6. Plaintiff led ex parte evidence and examined Ms. Surbhi Bansal, constituted Attorney of the plaintiff company, as PW-1. She tendered her evidence by way of affidavit (Ex. PW-1/A). Copy of the resolution-cum-power of attorney in her favour was exhibited as Ex. PW-1/7 and copy of Memorandum and Articles of Association of the plaintiff company as Ex. PW-1/13.

7. On behalf of the plaintiff it is deposed that the plaintiff company is the absolute owner and proprietor of the trade mark GARNIER on account of prior, honest and bona fide adoption in the year 1904 and continuous, commercial and exclusive use thereof in relation to cosmetics, toiletry products, hair care products, Sun care cream, tooth paste, shampoos, hair colours etc. The mark GARNIER also formed a key and material part of its predecessor M/s. Laboratorie Garnier & CIE which was dissolved vide deed of dissolution dated 28th November, 2011 exhibited as Ex. PW-1/18. The plaintiff's trade mark has become distinctive, associated and acquired secondary significance with the plaintiff and plaintiff's goods and business. Specimens of plaintiff's trade mark are exhibited as Ex. PW-1/1 and Ex. PW-1/2 as under:

Ex. PW-1/1

Trade Mark/Label of the plaintiff.



Ex. PW-1/2



8. Plaintiff uses the trade mark GARNIER individually as well as in combination of other formative/bearing marks, such as Belle Colour, Ultra Doux, Fructis, Synergie, Ultra Rich, AMbre Solaire etc. The plaintiff company obtained registration of the aforesaid trade mark in numerous countries of the world. The plaintiff company also obtained registration of the trade mark in India under the provisions of Trade Marks Act, 1999. Copy of Certificates of registration with respect to trade mark nos. 491768, 1041162 and 1335359 in class 03 are exhibited as Ex. PW-1/9, Ex. PW-1/10 and Ex. PW-1/10A respectively.

9. The plaintiff is the absolute owner and proprietor of the artistic work involved in the aforesaid trade mark and holds copyright therein.

10. The plaintiff has been regularly promoting its trade mark through extensive advertisements in print and electronic media. The plaintiff has spent enormous amount of money, effort, skills and time on popularizing the said trade mark. Advertisements and other sales promotional literature of the plaintiff published and circulated in India is Ex. PW-1/6.

11. The defendants adopted and started using the trade mark GARNIER in relation to its impugned goods. Specimens of defendants mark infringing the plaintiff's trademark and copyright are exhibited as Ex. PW-1/5 and Ex. PW-1/5A as under:

Ex. PW-1/5



Ex. PW-1/5A



12. Copies of various advertisements as published in Trade Marks Journal are exhibited as Ex. PW-1/11 (Colly). Copy of FIR No. 56/2008 registered at PS Economic Offences Wing under Sections 103 and 104 of Trademark Act 1999 and Section 63 of Copyright Act is Ex. PW-1/14. Copy of FIR No. 125/2008 lodged at PS Bhyculla Mumbai under sections 419 & 420 IPC and Sections 51 & 63 of Copyright Act is Ex. PW-1/15. Copy of sale invoices of the plaintiff's subsidiary/associate company in India are exhibited as Ex. PW-1/12 (colly).

13. Evidence of the plaintiff has gone unrebutted. Thus the plaintiff has been able to prove that the defendants were infringing the trade mark of the plaintiff as well its copyright in the artistic work. Since the plaintiff has not led evidence with respect to the damages caused to it, prayer (c) cannot be allowed.

14. Consequently, the suit is decreed in favour of the plaintiff and against the defendants in terms of prayer (a) and (b).

(MUKTA GUPTA)
JUDGE

AUGUST 21, 2017