

\$~

*

IN THE HIGH COURT OF DELHI AT NEW DELHI

+

CS(COMM) 1325/2016

TATA SONS LIMITED & ANR. Plaintiffs

Through None

versus

MR. CHARANJEET SHAH & ORS. Defendants

Through None

CORAM:**HON'BLE MR. JUSTICE MANMOHAN**

%

ORDER**19.02.2018**

Present matter has been listed in pursuance to the office note in which it has been stated that there is a typographical error in the last paragraph of the judgment dated 22nd November, 2017 inasmuch as date of 8th September, 2015 has been typed instead of 8th September, 2017.

Keeping in view the aforesaid note, the judgment dated 22nd November, 2017 shall now read as under:-

“On 08th September, 2017, this Court had passed the following order:-

“At the outset, learned counsel for the plaintiffs states that he wishes to delete the defendant no.6. Accordingly, the defendant no.6 is deleted from the array of parties.

Let amended memo of parties be filed within a period of one week.

Learned counsel for defendant nos.1 to 5, on instructions of

Mr.Charanjeet Shah, Director of True Colors Solutions & Technologies India Pvt. Ltd. who is personally present today in Court, states as under:-

- 1. The defendants acknowledge the plaintiff's mark TCS as a well-known;*
- 2. The defendants are ready to suffer an injunction as prayed for in the plaint;*
- 3. The defendants have discontinued use of the mark/name TCS as well as the domain www.tcsgroup.in;*
- 4. The defendants will do all that is needful to have the domain www.tcsgroup.in successfully transferred in favour of the plaintiff;*
- 5. The defendants will not use the mark/name TCS in any manner whatsoever in future.*

The statements/assurances/undertakings made by learned counsel for the defendants is accepted by this Court and the defendants are held bound by the same.

Learned counsel for the plaintiffs wishes to argue the effect of the acknowledgment by the defendants of the plaintiffs' trademark 'TCS' as a well-known name/trademark.

At request, adjourned to 22nd November, 2017."

Today, Mr.Pravin Anand, learned counsel for the plaintiffs states that TCS is a well-known mark. He contends that the well-known nature of the mark TCS is apparent from a bare perusal of the judgment of this Court in ***Tata Sons Ltd. Vs. Manoj Dodia 2011 (46) PTC 244 (Del)***. The relevant portion of the judgment relied upon by Mr.Pravin Anand is reproduced hereinbelow:-

"15.....TATA group of companies includes a number of large companies such as TISCO, Tata Motors Ltd., Tata Metaliks Limited, Tata Cummins Ltd., Tata Tea Limited, Tata Housing Development Company Ltd., Tata Finance Limited, Tata AIG Risk Management Services Ltd., Tata Consultancy Services (TCS), Tata Teleservices, Tata Honeywell Limited and Tata Infotech Limited.

17. Considering that (a) the mark TATA whether word mark or device or in conjunction with other words is being used for last more than 100 years, in respect of a large number of goods and services, (b) Tata Group, which is probably the oldest and largest industrial and business conglomerate having turnover of Rs.96,000 crores in the year 2005-06, Tata Group comprises a number of large companies, millions of consumers are using one or more Tata products throughout India, but also in other countries, (c) there are more than hundred registrations of the trademark TATA either by way of word mark or device or use of the name TATA with other words, (d) the Courts having in a number of judgments/orders recognized TATA as a well known mark, (e) there is no evidence of any other person holding registration of or using the trademark TATA and (f) the reputation which companies of TATA group enjoys not only in India but also in many other countries, it is difficult to dispute that the trademark TATA is a famous and well known brand in India. I, therefore, have no hesitation in holding that the mark TATA whether word mark or device or when use in conjunction with some other words is a well known trademark within the meaning of Section 2(z)(b) of the Trademarks Act, 1999. The use of the trademark TATA in relation to any goods or services is, therefore, likely to be taken as a connection between house of TATAs and the goods or services, which are sold under this trademark or a trademark which is similar to it."

However, this Court is of the view that in order to ascertain the status of a well-know mark in respect of a trade mark, the appropriate recourse for the plaintiffs would be to resort to the procedure prescribed under Rule 124 of the Trade Marks Rules, 2017 and file the requisite application before the Registrar.

Mr.Anand states that till date the Registrar has not independently granted the status of a well-know mark in accordance with Rule 124 of the Trade Marks Rules, 2017.

However, this Court is of the view that the procedure prescribed in Rule 124 needs to be availed of by the parties who claim the status of a well-known mark. Consequently, the plaintiffs are directed to file an appropriate application under Rule 124 of the Trade Mark Rules, 2017 within a period of two weeks. The Registrar is directed to decide the same as expeditiously as possible preferably within a period of three months.

Accordingly, the present suit is disposed of in view of the undertaking given by learned counsel for defendant nos.1 to 5 on **08th September, 2017**. Registry is directed to prepare a decree sheet accordingly.”

Registry is directed to prepare the decree sheet accordingly.

MANMOHAN, J

FEBRUARY 19, 2018

rn