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

+ **CS(COMM) 1307/2016**

M/S. KHUSHI RAM BEHARI LAL Plaintiff
Through **Mr. Ajay Amitabh Suman with**
Mr. Kapil Kumar Giri and Mr.
Pankaj Kumar, Advocates

versus

P.V. KANAKARAJ TRADING AS
KALPATHARU TRADING CO. Defendant
Through **None**

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Date of Decision : 05th December, 2017

CORAM:
HON'BLE MR. JUSTICE MANMOHAN

J U D G M E N T

MANMOHAN, J (Oral):

1. Present suit has been filed for permanent injunction restraining infringement of copyright, passing off, delivery up etc. The prayer clause in the suit is reproduced hereinbelow:-

(a) For a decree of permanent injunction restraining all the defendant by themselves as also through their individual proprietors, partners, directors, 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 trademark TAJ MAHAL WITH DEVIDE OF TAJ MAHAL and/or any other trademark/label, identical

and/or deceptively similar thereto in relation to their impugned goods and business of rice and related/allied products and from doing any other acts or deeds amounting to or likely to:

(i) Infringe the plaintiff's copyright in the said trademark/label TAJ MAHAL label (device of TAJ MAHAL)

(ii) Passing off and violation of plaintiff's common law right in the said trademark/label TAJ MAHAL label (device of TAJ MAHAL).

(iii) Dilution of plaintiff's goodwill and reputation to the plaintiff's well known trademark/label said trademark/label TAJ MAHAL label (device of TAJ MAHAL).

(b) Restraining the defendant from disposing off or dealing with its assets including its shops and premises as mentioned in the memo of parties of the plant and its stocks-in-trade or any other assets a may be brought to the notice of this Hon'ble Court during the course of the proceedings and on the defendant disclosure thereof and which the defendant are called upon to disclose and/or on its ascertainment by the plaintiff as the plaintiff is not aware of the same as per Section 135 (2) (c) of the Trade Marks Act, 1999 as it could adversely affect the plaintiff's ability to recover the costs and pecuniary relief(s) thereon.

(c) For an order for delivery up of all the impugned finished and unfinished materials bearing the impugned an violative trademark TAJ MAHAL with device of TAJ MAHAL or any other deceptively similar trademark/label including its blocks, labels, display boards, sign boards, trade literatures and goods etc. to the plaintiff for the purposes of destruction and erasure.

(d) For a decree for grant of damages in the sum of Rs.20,01,000/- (Rupees Twenty Lakh and One Thousand only) from the defendants to the plaintiff.

(e) For an order for cost of proceedings.

(f) For such other and further order as this Hon'ble Court may deem fit and proper in the facts and circumstances of the present case."

2. On 19th December, 2013, this Court granted an ex parte ad interim injunction in favour of the plaintiff and against the defendant. The relevant portion of the said order is reproduced hereinbelow:-

"Accordingly, the defendant is restrained by way of ex parte ad interim injunction from selling or dealing with the product rice or allied products using the trade mark TAJ MAHAL on the device TAJ MAHAL till further orders. It is clarified that defendant may sell the products after changing the packaging and without using the impugned trade mark.

Plaintiff shall comply with provisions of Order XXXIX Rule 3 CPC within a period of 3 weeks from today."

3. On 16th September, 2016 the defendant's applications being I.A.No.5529/2014 under order VII Rule 11 CPC and I.A.No.8938/2014 under Order XXXIX Rule 4 CPC were dismissed and the ex parte interim injunction was confirmed. The relevant portion of the said order is reproduced hereinbelow:-

"11. At the present stage, when the matter is yet to go to trial, the Court cannot insist that the full particulars of where precisely the Defendant was found selling its products in Delhi have to be set out in the plaint itself. That would be a matter for evidence. Consequently, this

Court is unable to accept the plea of the Defendant that the averments in the plaint are insufficient for the Court to entertain the action of passing off of the trademark of the Plaintiff.”

4. Despite entering appearance and having filed the written statement, the defendant stopped appearing after 7th February, 2017. Accordingly, it was proceeded ex parte vide order dated 3rd August, 2017 and the plaintiff led its ex-parte evidence.

5. Mr. Ajay Amitabh Suman, learned counsel for the plaintiff states that the plaintiff is engaged in the business of processing and marketing Basmati rice including exports thereof. He states that the plaintiff is the prior adopter and user of the mark TAJ MAHAL along with TAJ MAHAL device in relation to rice since the year 1978.

6. He further states that the plaintiff has filed an application dated 27th February, 1989 for registration of the mark TAJ MAHAL claiming user since 1st July, 1978. However, the same is pending consideration on account of objections raised by third parties.

7. Mr. Suman states that the plaintiff's label bears the original artistic feature created by the plaintiff and the same constitutes an original artistic work within the meaning of the Copyright Act, 1957. He states that since the adoption of the mark TAJ MAHAL along with TAJ MAHAL device, the plaintiff has been continuously and exclusively using the same to the exclusion of others.

8. Learned counsel for the plaintiff states that the defendant is using the mark/label TAJ MAHAL along with device TAJ MAHAL in relation to same product i.e. rice dishonestly and fraudulently in order to take advantage of the plaintiff's established reputation and

goodwill.

9. He states that the defendant had fraudulently applied for registration of the impugned mark/device on 15th April, 2010 claiming use since 11th January, 2000.

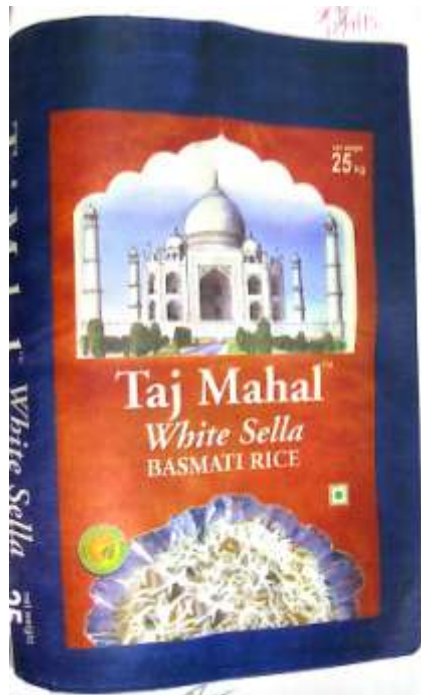
10. Having perused the paper book, this Court is of the opinion that the plea of the mark being *public juris* raised by the defendant in its written statement cannot be accepted as no evidence in this regard has been led by the defendant.

11. This Court is also of the view that the plaintiff on the basis of the bills/invoices filed by it in support of the present plaint and exhibited as Ex. PW1/8 (Colly) has been able to establish prior use of the mark TAJ MAHAL with device TAJ MAHAL atleast since 1980.

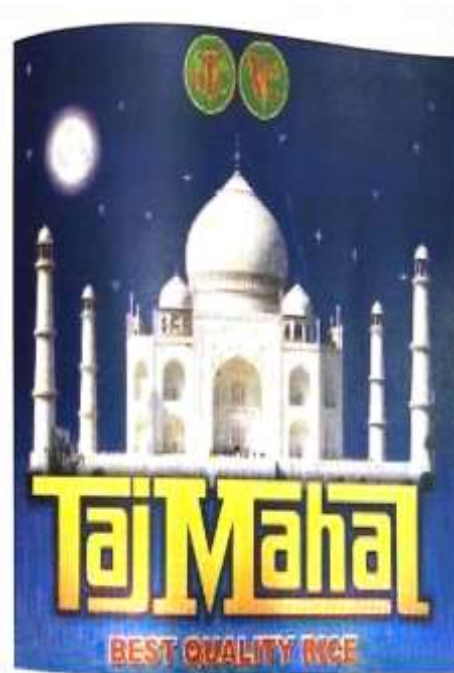
12. This Court is further of the view that though the defendant in its written statement has claimed use of the mark TAJ MAHAL with device TAJ MAHAL since 2000, yet it has not filed any document to establish the same and the only document relied upon by the defendant is its application for registration of the impugned mark/device filed in 2010.

13. This Court is also of the opinion that the defendant's mark TAJ MAHAL with device TAJ MAHAL is bound to cause confusion and deception among the public at large, consumers, business and trade circles and is likely to suggest that there is some nexus between the plaintiff and defendant. The mark/device of the plaintiff as well as the defendant is reproduced hereinbelow:

Plaintiff's Mark



Defendant's Mark



14. In any event, as the averments in the plaint have not been rebutted by the defendant nor did the defendant bother to put forth its stand in spite of ample opportunities given by this Court, they are deemed to have been admitted.

15. In the opinion of this Court the triple identity test is satisfied as the defendant has made use of a deceptively similar mark i.e. TAJ MAHAL as well TAJ MAHAL device in relation to identical goods (rice) having identical trade channels (products sold *vide* same trade channels).

16. However, as far as the prayer with regard to the damages is concerned, this Court is of the opinion that since the plaintiff has not led any evidence with respect to the quantum of damages suffered by the plaintiff, the same cannot be granted in light of the Division Bench

judgment of this Court in *Hindustan Unilever Limited Vs. Reckitt Benckiser India Limited*, 2014 (57) PTC 495 [Del][DB]. In fact, this Court recently in *Super Cassettes Industries Private Limited Vs. HRCN Cable Network*, CS(COMM) 48/2015 dated 09th October, 2017 has held as under:-

*“19. However, this Court is not satisfied on the evidence led in the present case that the compensation awarded is inadequate in the circumstances having regard to the three categories in *Rookes v. Barnard*, [1964] 1 All ER 367 and also the five principles in *Cassell & Co. Ltd. v. Broome*, 1972 AC 1027. In the event punitive damages are awarded in the present case, it would be an ad-hoc judge centric award of damages, which the Division Bench specifically prohibited in *Hindustan Unilever Limited* (supra)...”*

17. Keeping in view the aforesaid facts, mandate of law and the persistent conduct of the defendant in selling products bearing the mark TAJ MAHAL with device TAJ MAHAL, the suit is decreed in terms of prayers (a) and (e) of the prayer clause along with the actual costs incurred by the plaintiff. The cost shall amongst others include the lawyers' fees, local commissioner's fee as well as the amounts spent on purchasing the court fees. Registry is directed to prepare a decree sheet accordingly.

MANMOHAN, J

DECEMBER 05, 2017
KA/DK