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

+ **CS(OS) 3325/2015**

PRUDENTIAL IP SERVICES LIMITED Plaintiff

Through **Mr. Neeraj Grover, Advocate**
with **Mr. Naqeeb Nawab,**
Advocate

versus

PRUDENTIAL PROSPERITAS
COMPANY PRIVATE LIMITED & ORS. Defendants

Through: **None**

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Date of Decision: 14th November, 2017

CORAM:

HON'BLE MR. JUSTICE MANMOHAN

J U D G M E N T

MANMOHAN, J :

1. Present suit has been filed for permanent injunction against trademark infringement, passing off, unfair competition, rendition of accounts, damages and delivery up. The prayer clause in the suit is reproduced hereinbelow:-

“(a) Pass and pronounce a decree of permanent/perpetual injunction against infringement of Plaintiff’s registered trade/service mark PRUDENTIAL, by restraining the Defendants, their promoters, directors, assigns, sister concern, affiliates, relatives, successors-in-interest, licensees,

franchisees, partners, representatives, servants, distributors, employees, agents etc. or anyone associated with them from using the mark PRUDENTIAL and/or any mark identical with or deceptively similar to the Plaintiff's trade/service mark PRUDENTIAL singularly or in conjunction with any other word or monogram/logo as a trade mark, service mark, house mark, trade name, trading style, corporate name, website, domain name, e-mail address, other webpages or otherwise in any manner whatsoever so as to infringe the Plaintiff's aforesaid registered trade/service marks;

- (b) Pass and pronounce a decree of permanent/perpetual injunction restraining Defendants, their promoters, directors, assigns, sister concern, affiliates, relatives, successors-in-interest, licensees, franchisees, partners, representatives, servants, distributors, employees, agents etc. or anyone associated with them from using the mark/name PRUDENTIAL and/or any mark identical with or deceptively similar to the Plaintiff's trade/service mark/name PRUDENTIAL in any manner so as to pass off or enable others to pass off their products or services as that of the Plaintiff or in some manner connected with the Plaintiff;*
- (c) Pass and pronounce a decree of mandatory injunction against Defendants directing it to change the corporate name of Defendant No. 1 by deleting PRUDENTIAL therefrom;*
- (d) Pass and pronounce a decree directing Defendants, their promoters, directors, assigns, sister concern, affiliates, relatives, successors-in-interest, licensees, franchisees, partners, representatives, servants, distributors, employees, agents etc. or anyone associated with them to deliver-up to the Plaintiff for*

destruction of their entire stationery, letterheads, signage, reprographic material, brochures, literature or any other material for advertising, offering or marketing any services under the mark PRUDENTIAL and/or any mark identical with or similar to the Plaintiff's trade/service mark/name PRUDENTIAL;

- (e) Pass and pronounce a decree directing the Defendants to transfer in favour of the Plaintiff or cancel all the domains registered by them or on their behest containing PRUDENTIAL including, inter alia, 'prudential.net.in' and 'prudentialpoints.com';*
- (f) Pass and pronounce a decree for rendition of accounts directing each of the Defendants to produce before the Hon'ble Court or any person nominated/designated/appointed by this Hon'ble Court all accounts in general and invoices and sales figures in particular;*
- (g) Pass and pronounce a money decree in favour of the Plaintiff and against the Defendants for payment of damages in the sum of Rupees Two Crores and One Lakh or in such higher sum as may be determined/ascertained pursuant to the rendition of accounts;*
- (h) Award costs of the Suit; and*
- (i) Any other orders as this Hon'ble Court may deem appropriate in the facts and circumstances of the case."*

2. At the outset, learned counsel for the plaintiff states that he does not wish to press prayers (d), (e), (f) and (g) of the aforesaid prayer clause. The statement made by learned counsel for the plaintiff is accepted by this Court.

3. On 05th November, 2015, this Court had granted an *ex parte* ad interim injunction in favour of the plaintiff and against the defendants.

The relevant portion of the said order is reproduced hereinbelow:-

“3. In view of the arguments urged on behalf of the plaintiff, till further orders unless varied by the Court, defendants are restrained from in any manner using the trademark PRUDENTIAL with respect to any of its business and more particularly the business of finance, funds management and related services. The defendants are also forthwith restrained from carrying on business via internet by using the word PRUDENTIAL or any other trademark/wordmark identical or deceptively similar to the same. The similar injunction will operate against any business otherwise being carried on by the defendant with use of the trademark/wordmark PRUDENTIAL or any other deceptive similar trademark/tradename. However, so far as the user of the word PRUDENTIAL by the defendant no.1 in the name of its company which is registered as such with the Registrar of companies, the said name though will not be used in any manner to carry on business and the defendant no.1 is directed within four weeks from today to apply for getting the said word/trademark PRUDENTIAL removed from the name of its company before the Registrar of companies.

Plaintiff will comply with the provision of Order 39 Rule 3 of Code of Civil Procedure, 1908 (CPC) within one week from today.”

4. Defendant no.4, an erstwhile employee of the defendant no.1, was deleted from the array of defendants vide order dated 19th November, 2016.

5. In view of the fact that the defendant no.3 had expired, this court vide order dated 26th May, 2017 held that the suit abated against

him.

6. Since defendant nos.1 and 2 did not enter appearance nor file their written statement within the stipulated time granted, they were proceeded ex-parte by this Court vide order dated 26th May, 2017.

7. It is stated in the plaint that the plaintiff company is a company incorporated under the laws of United Kingdom, having international operations, providing services pertaining to insurance, finance, funds management and other related services. It is stated that the plaintiff's operations commenced way back in the year 2000, as a holding company for the trademarks, including the trade/service mark/name PRUDENTIAL, and other intellectual property rights of the Prudential Group. In India, the plaintiff has a tie up with ICICI Bank and the joint venture company is known as ICICI Prudential Life Insurance Company.

8. It is averred that the plaintiff has an extensive presence in terms of geographical spread and is well recognized in the industry for business/services under the trade/service mark/name PRUDENTIAL, with business history for over 165 years internationally and for 80 years in Asia in relation to wide range of insurance and financial services.

9. It is stated in the plaint that the plaintiff's adopted its trademark PRUDENTIAL in the year 1848 in the United Kingdom and the said trademark is registered in the United Kingdom since the year 1974 and in India since 1994. In India, the plaintiff has registrations under Classes 16 and 36 of the Trademarks Act, 1999 for the trademark/trade name PRUDENTIAL. It is further stated that the

plaintiff's company operates through various domain names on the internet and which use the trademark/word mark PRUDENTIAL.

10. It is stated that the worldwide sales figures pertaining to services under the trade/service mark PRUDENTIAL/PRUDENTIAL in year 2014 was £32,832 million and the sales figures of the plaintiff's joint venture company in India was ₹239.20 billion. The worldwide advertising/promotion expense for the same period, worldwide was £21.39 million and ₹184.53 million in India.

11. It is stated in the plaint that the plaintiff has acquired common law rights in and to the trademark/trade name PRUDENTIAL and has acquired worldwide reputation by prior, long, continuous, extensive and exclusive use of the trademark/trade name PRUDENTIAL. It is also stated that the trademark/trade name PRUDENTIAL is considered a well-known trade mark globally, as per the provisions of Article 6 *bis* of the Paris Convention Treaty, to which India is also a signatory, as well as the provisions of Section 2(1) (zg) of the Trade Marks Act, 1999.

12. Learned counsel of the plaintiff states that in June 2015, it came to the plaintiff's knowledge that the defendants were unauthorizedly using the plaintiff's trade mark/trade name for their websites viz. www.prudential.net.in and www.prudentialpoints.com. He states, that subsequent enquires revealed that the defendant no.2 is a unit of Defendant no.1 and that the defendants were using PRUDENTIAL as part of its trade name – Prudential Partners; company name – Prudential Prosperitas Company Private Limited; trade/service mark – PRUDENTIAL; domain name – www.prudential.net.in and

prudentialpoints.com; websites www.prudential.net.in and www.prudentialpoints.com and email address – wecare@prudential.net.in in respect of 'investment related services', identical to that of the plaintiff.

13. Learned counsel for the plaintiff states that the defendant no.2 was originally incorporated on 31st August, 2007 as 'Kabir Bhalla (Consultants) Company Private Limited' and it was only on 15th January, 2013 that it changed its name to 'Prudential Prosperitas Company Private Limited'.

14. Learned counsel for the plaintiff states that the defendants' impugned marks/domain names/email address are deceptively similar to the plaintiff's well known and registered trade/service mark/name PRUDENTIAL, in respect of identical services and such infringement is aptly covered under Section 29(3) as well as Section 29(5) of the Trade Marks Act, 1999. However, learned counsel for the plaintiff admits that the validity of the domain names acquired by the defendants have expired and have not been renewed.

15. Learned counsel for the plaintiff states that the defendants are exploiting the goodwill and reputation inuring to the plaintiff in respect of its trade/service mark/name PRUDENTIAL and the use of the impugned marks by the defendants is bound to confuse an unwary consumer and that the defendants have already cheated the general public by making them believe that they are associated with the ICICI Prudential (plaintiff's joint venture in India) and have extracted lakhs of rupees from innocent customers.

16. The plaintiff has filed its ex-parte evidence by way of affidavit of Mr. David George Green (PW1). The plaintiff's witness has proved the legal proceeding certificate as Ex.PW1/7 and Ex.PW1/8 and the registration certificate of the plaintiff's trademark as Ex.PW1/11. The PW1 has further proved the extracts from the defendants' websites as Ex.PW1/21 and Ex.PW1/22. The PW1 has also proved print outs from various public forums wherein customers of defendants have posted negative reviews related to fraudulent activities of the defendants as Ex.PW1/28(Colly).

17. Having heard learned counsel for plaintiff as well as having perused the papers, this Court is of the view that due to extensive worldwide use over substantial period of time, the plaintiff's trademark/trade name PRUDENTIAL have acquired reputation and goodwill in the marks globally as well as in India.

18. From the evidence on record, it is apparent that without any explicit permission or authorisation to use the plaintiff's trademark and trade name, the defendant had malafidely used the trademark/trade name PRUDENTIAL of the plaintiff and was engaged in investment related services, identical to that of the plaintiff.

19. Further, as the plaintiff's evidence has gone un rebutted, said evidence is accepted as true and correct. The Supreme Court in ***Ramesh Chand Ardawatiya Vs. Anil Panjwani, AIR 2003 SC 2508*** has held as under:-

"33.....In the absence of denial of plaintiff averments the burden of proof on the plaintiff is not very heavy. A prima

facie proof of the relevant facts constituting the cause of action would suffice and the court would grant the plaintiff such relief as to which he may in law be found entitled. In a case which has proceeded ex parte the court is not bound to frame issues under Order 14 and deliver the judgment on every issue as required by Order 20 Rule 5. Yet the trial court should scrutinize the available pleadings and documents, consider the evidence adduced, and would do well to frame the "points for determination" and proceed to construct the ex parte judgment dealing with the points at issue one by one. Merely because the defendant is absent the court shall not admit evidence the admissibility whereof is excluded by law nor permit its decision being influenced by irrelevant or inadmissible evidence."

20. Consequently, the allegation that the trademark/trade name PRUDENTIAL, used by defendants, amounts to infringement and passing off, of the plaintiff's trademark/trade name, is correct. The use of the impugned mark by the defendants was bound to cause incalculable losses, harm and injury to the plaintiff and immense public harm.

21. Accordingly, present suit is decreed in accordance with the paragraph 35 (a), (b), (c) and (h) of the plaint. The cost shall amongst others include the lawyers' fees as well as the amounts spent on purchasing the court fees. Registry is directed to prepare a decree sheet accordingly.

MANMOHAN, J

NOVEMBER 14, 2017

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