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

Date of decision: 9th August, 2018.

+ **CS (COMM) 329/2018 & I.A. 10676/2014**

RE/MAX, LLC Plaintiff

Through: Mr. Peeyoosh Kalra and Mr. Amol
Dixit, Advocates for Plaintiff.
(M:9810009763)

versus

GULSHAN BAJAJ AND ORS Defendants

Through: Ex-parte.

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. The present suit for injunction has been filed by the Plaintiff in respect of the trademark 'RE/MAX'. The expression 'RE/MAX' is the trademark of the Plaintiff as also an essential feature of its corporate name/trading style. As per the Plaintiff, the mark 'RE/MAX' has been coined from the phrase 'ReaEstate MAXimums' in January, 1973, by two real estate professionals Dave and Gail Liniger from Denver, Colorado. The Plaintiff renders services in the real estate sector and claims to have become the number one real estate organization in Canada. In 1997, the Plaintiff had closed more than 1 million transactions in one year which led to the coining of the slogan "*Nobody in the world sells more real estate than RE/MAX*".

2. The Plaintiff claims that it has a network of more than 90,000 real estate agents operating across 6,300 offices in 85 countries of the world. It is further averred in the plaint that the Plaintiff has been the highest ranked real

estate franchise agent in the world.

3. A perusal of the documents on record reveals that the mark '*RE/MAX*' both in a word form and in logo form is registered in several countries of the world, the list of which is contained in para 13 of the plaint. The mark '*RE/MAX*' and logo '*RE/MAX*' are also registered in India in classes 16, 35 & 36. The registration is pending in classes 25 and 41. According to the Plaintiff, the website '*www.remax.com*' attracts large number of users including those from India and according to the Plaintiff, the mark is distinctive of the Plaintiff's services in the real estate arena.

4. In October, 2012, the Plaintiff became aware of the use of the mark '*REALMAXX*' by the Defendants in identical field of business. The logo which was used by the Defendants was also similar to that of the Plaintiff's logo. Accordingly, the Plaintiff issued a cease and desist notice dated 30th October, 2012. A reminder was addressed on 28th November, 2012 to which the counsel for the Plaintiff received a telephonic call from Defendant No.1. Defendants No.1 to 3 are the persons in control of Realmaxx, Realmaxx Investment Solutions – Defendant No.4 and Realmaxx Realty Solutions – Defendant No.5. In the telephonic conversation, they confirmed that they have stopped use of the infringing mark and also confirmed that the website '*realmaxx.com*' is not operational. However, in August, 2013, the Plaintiff was again informed that the Defendants' website has become operational and the Plaintiff again addressed a letter dated 5th September, 2013. No response was forthcoming. Thereafter, the present suit was filed by the Plaintiff on 26th May, 2014. The suit was listed on 28th May, 2014 when an *ex-parte* order for injunction was granted in the following terms:

“Hence, till the next date of hearing, the defendants,

their promoters, Directors or anyone associated with them are restrained from using the mark REALMAXX and any other mark which is identical with or deceptively similar to the mark RE/MAX of the plaintiff. However, the defendants are granted two weeks time from the date of receipt of summons for removing the said mark from their advertisement/trading style website, domain name, e-mail address and they would be entitled to use a different brand name after the first alphabets "REAL" by adding the suffix which may not be either identical with or deceptively similar with part of the mark MAX."

5. Thereafter, the Defendants failed to enter appearance and the summons were repeatedly received back with the noting that the Defendants have left the premises. The Plaintiff thereafter served the Defendants through publication in The Statesman and the citation was also placed on record. Despite the same, the Defendants did not put in appearance on 22nd February, 2017. They were proceeded *ex-parte*.

6. The Plaintiff then filed affidavit of evidence of Mr. Larry E. Oberly, Vice-President, Global Development of the Plaintiff Company. The following documents were exhibited by the Plaintiff:

- **Ex. P1:** Notarial Acknowledgment dated 15th April, 2013.
- **Ex. P2(Colly):** Copies of the Certificate and Articles of Incorporation
- **Ex. P3(Colly):** 'General Corporation Law' of the Delaware Code
- **Ex. P4(Colly):** Copies of the Certificate of formation, conversion and subsequent change of name.
- **Ex. P5(Colly):** Extracts from the website www.remax.com
- **Ex. P6(Colly):** Extracts from the website www.remax.in

- **Ex. P7:** Extract of the trademark 'RE/MAX' under Registration No. 1,139,014 from the United States Patent and Trade Mark Office.
- **Ex. P8:** List of franchisees of the Plaintiff as downloaded from the website www.remax.in.
- **Ex. P9:** List of the countries where the trade/service marks 'RE/MAX' are registered and/or pending registration.
- **Ex. P10:** Copies of registration and respective renewal certificates for the Plaintiffs trade/service marks RE/MAX, etc. from various jurisdictions of the world.
- **Ex.P11:** Indian Register of Trade Marks pertaining to registration No. 716460 for the mark RE/MAX in Class 16
- **Ex.P12:** Copy of extract from the Trade Marks Journal pertaining to registration No. 716460 for the mark RE/MAX in Class 16
- **Ex.P13:** A copy of online extract from the website of the Indian Trade Marks Registry pertaining to the Plaintiffs registration No. 1237966 for the mark RE/MAX in Classes 35 and 36
- **Ex.P14(Colly):** Copies of the request filed on Form TM-70 for obtaining the certified extracts from the Indian Register of Trade Marks pertaining to the Plaintiffs registration No. 1237966 for the mark RE/MAX in Classes 35 and 36; receipt thereof; letter dated 18th March, 2014 received from the Trade Marks Registry and the Response dated 14th April, 2014
- **Ex.P15:** A copy of online extract from the website of the Trade Marks Registry pertaining to the application No. 2195676 for the mark RE/MAX in Classes 25 & 41

- **Ex.P16(Colly):** Compilation of copies of advertising material of the Plaintiff and its services worldwide
- **Ex.P17:** A list of regional domain names/websites owned by the Plaintiff or its regional franchisors.
- **Ex.P18:** Compilation of copies of the company profile and advertising/promotional material of the Plaintiff/its services in India including conferences/seminars hosted/attended by the Plaintiff
- **Ex.P19:** Copies of orders along with their English translations passed by the Turkish Patent Institute wherein the Plaintiffs trade/service marks RE/MAX and RE/MAX device (RE/MAX; & Balloon Design) were held to be well-known marks
- **Ex.P20:** Copy of the 'cease and desist' notice dated 30th October, 2012 along with the original postal receipt and printout of the tracking status of the courier
- **Ex.P21:** Copy of the reminder letter dated 28th November, 2012 along with the postal receipt
- **Ex.P22:** A copy of the letter dated 5th September, 2013, along with the postal receipt
- **Ex.P23(Colly):** A compilation of advertisement cutting; a business card of the Defendant No. 3, and profile of the Defendants
- **Ex.P24(Colly):** Printouts of profiles of the Defendants available on various internet directories
- **Ex.P25(Colly):** Printouts taken in October 2012 from the website of the Defendants viz. www.realm maxx.com.
- **Ex.P26:** A printout of the 'About Us' page of the Defendants' website

www.realmaxx.com as on 24th May, 2014

- **Ex.P27:** Printout of the WHOIS records of the domain "realmaxx.com"
- **Ex.P28:** Certified copy of the Order of the High Court of Delhi passed in CS(OS) No. 2540 of 2013

7. The Defendants having been proceeded *ex-parte*, the Joint Registrar on 16th January, 2018, after citing several decisions on the issue, observed that a witness who is from USA can be granted exemption from personal appearance. Accordingly, the exhibit marks were put on all the exhibits relied upon by the Plaintiff and the matter has been placed before this Court.

8. Counsel for the Plaintiff relies upon *Satya Infrastructure Ltd. & Ors v. Satya Infra & Estates Pvt. Ltd. 2013 (54) PTC 419(Del.)(hereinafter known as Satya Infrastructure)* and *The Procter & Gamble Company v. Midas Healthcare Limited And Ors. CS(COMM) 386/2017 dated 14th May, 2018 (hereinafter known as Procter & Gamble)* to argue that in *ex-parte* cases, there is no requirement to even lead as *ex-parte* evidence.

9. In matters of this nature where the Defendants chose not to appear before the Court and the Plaintiff has made out a case from the reading of the plaint and documents, it would be extremely burdensome to follow the usual process of requiring the appearance of the witness of the Plaintiff especially in cases such as these, wherein the witnesses are outside the shores of India. For this very purpose that the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 contains various provisions on the basis of which a judgment can be pronounced by the Court upon a reading of the Plaint and the documents in a summary manner. The adducing of evidence should not be a mere formality

unless it is going to make a real difference to the merits of the matter. In the absence of a Defendant and there being no defence on record, no useful purpose is served by insisting upon the appearance of the Plaintiff's witnesses.

10. Even in the Civil Procedure Code, 1908, in the absence of the written statement, the Court is empowered to pronounce the judgment (Order VIII Rule 10), under the provisions of the Commercial Courts Act (Order 13A) as also in the Delhi High Court Original Side Rule, 2018 (Chapter 9 Rule 3 and 6), the Court is empowered to pass a judgment. This position is also recognized in the two judgments cited by the Plaintiff. A Learned Single Judge of this Court in ***Satya Infrastructure (supra)*** held as under:

“5. I am of the opinion that no purpose will be served in such cases by directing the plaintiffs to lead ex parte evidence in the form of affidavit by way of examination-in-chief and which invariably is a repetition of the contents of the plaint. The plaint otherwise, as per the amended CPC, besides being verified, is also supported by affidavits of the plaintiffs. If fail to fathom any reason for according any additional sanctity to the affidavit by way of examination-in-chief than to the affidavit in support of the plain or to any exhibit marks being put on the documents which have been filed by the plaintiffs and are already on record. I have therefore heard the counsel for the plaintiffs on merits qua the relief of injunction. ”

A similar view has been taken in ***Procter & Gamble (supra)***. The present case stands on a better footing. Apart from the plaint having been verified and accompanied by an affidavit, the Plaintiff's witness has also filed an affidavit which is duly signed and notarized from the USA. The documents

i.e. Trademark Registration Certificates, the registration of the domain name and the website thereof, registration certificates in other countries etc., are all publicly available documents and the authenticity of the same is not in question.

11. The documents placed on record clearly establish that the Plaintiff is the prior user of the mark 'RE/MAX'. The mark and logo 'REALMAXX' is deceptively similar. The Plaintiff has been able to establish use of the trademark dating back to 1973. The Plaintiff has also established its global reputation in India and extensive use of the mark in India. Para 17 of the affidavit in evidence is relevant and set out herein below:

"17. I say that the Plaintiff expanded its business to Asia with the sale of a Master Franchise to India in the year 2009. I say that at the time the India Master Franchise was created, there were over 70 countries in the Plaintiff's global network under the trade/service marks/name 'RE/MAX' and . I say that insofar as India is concerned, as on the date of filing of the instant Suit, the Plaintiff's Master Franchisee had divided the country into 32 regions of which 21 regions were operational in 14 states including in Delhi; the remaining regions were open for sale. I say that, in total, the Plaintiff's presence in India on the date of filing of the instant Suit was spread over more than 390 Agents and 54 offices."

The various notices given to the Defendants are not disputed.

12. The trademark 'REALMAXX' and the logo used by the Defendants in an identical services area i.e. real estate leaves no doubt as to the dishonesty of the Defendants in adopting the mark and logo. The Plaintiff's case is that the Defendant had originally agreed to give up the mark and logo but

thereafter restored the business. There is no reason to disbelieve the Plaintiff.

13. This Court finds:

- i) that the trademark '*RE/MAX*' and '*REALMAXX*' are deceptively similar, if not almost identical;
- ii) that the '*REALMAXX*' logo is an imitation of the '*RE/MAX*' logo. The services in which the competing marks are used is identical which is real estate. The class of customers are identical.
- iii) The Plaintiff has been able to establish enormous reputation and goodwill in the real estate industry.
- iv) There is also sufficient user of the mark '*RE/MAX*' of the Plaintiff in India.
- v) The mark '*RE/MAX*' is registered in India.

14. Under such circumstances, the Plaintiff is entitled to a decree of injunction in terms of paras 37(a), (b) and (c). The Plaintiff is also permitted to seek cancellation and transfer of the domain name '*realmaxx.com*' from the relevant Domain Registrar.

15. Counsel for the Plaintiff had, during the course of arguments submitted that the Plaintiff does not press the relief of rendition of accounts/damages and costs. In view of the above, decree sheet be drawn in terms of the para 37(a) to (d) of the plaint. The remaining reliefs are not pressed. Decree sheet be drawn accordingly. Suit is decreed. No orders as to costs. All pending I.As are also disposed of.

PRATHIBA M. SINGH
JUDGE

AUGUST 09, 2018
Rahul