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

+ **CS(COMM) 847/2018, I.As. 6373/2018, 11510/2018 & 11512/2018**

**L AIR LIQUIDE SOCIETE ANONYME POUR I ETUDE ET I
EXPLOITATION DES PROCEDES GEORGES CLAUDE AND
ANR** Plaintiffs

Through: Mr. Vinod Khurana and Mr. Anirudh
Sarin, Advocates. (M:9650741530)

versus

M/S LIQUID AIR & ORS Defendants

Through: Mr. Pallav Shishodia, Senior
Advocate with Ms. Pratiksha Sharma
and Mr. Ankit Acharya, Advocates.
(M:9818573748)

**CORAM:
JUSTICE PRATHIBA M. SINGH**

ORDER
% **26.09.2018**

1. The present suit for trademark infringing/passing off has been filed by the Plaintiffs claiming rights in the trademark 'AIR LIQUIDE'. The Plaintiff No.1 is a French company who claims to have adopted the trademark 'AIR LIQUIDE' along with the logo since the year 1902. The Plaintiff No.2 is a subsidiary of Plaintiff No.1 in India. The Plaintiffs together claim rights to the trademark 'AIR LIQUIDE' which is used by them in more than 60 countries in the world. The Plaintiffs have placed on record their sales figures and marketing figures. The Plaintiffs have also applied for and obtained registration of their trademark 'AIR LIQUIDE' and the logo as detailed in paragraph 11 of the plaint.

2. The grievance of the Plaintiffs in the present case is in respect of the use of the mark 'LIQUID AIR' as a trade name by the Defendants as also the use of the domain name www.liquidair.in. Defendant No.1 is a registered partnership firm which is promoted by the Chhangani family, who are arrayed as Defendant Nos.3 to 6 in the plaint. Defendant No.2 is a company which is involved in event management. The name of this company was earlier Liquid Air Pvt. Ltd which was changed to Circular Plastics Pvt. Ltd. The Defendants, are involved in the trading and marketing of gas related products. The Plaintiffs thus sought an injunction on the ground that the marks are identical/deceptively similar and the Defendants are in the same business. The Plaintiffs, issued legal notice dated 31st March, 2016 calling upon the Defendants to change the name and stop use of the mark. The Defendants replied to the said notice on 16th April, 2016 (wrongly mentioned as 16th March, 2016) and stated as under: -

"14. However, On receipt of your Notice, and becoming aware of your clients business, registered trademark and similar domain name. Our clients are ready to take necessary steps to avoid unnecessary legal litigations an lawsuits and wish to resolve the matter amicably in the best interests of both the parties.

15. Our Client have taken note of your Clients request and / or demands listed down in paras 13, 14 and 15, and also noted and take on record your Clients commitment in Para 15 not to proceed legally to claim its legitimate 'Proprietary rights' and not to claim damages of any kind, (whatsoever), nor or any time in the future.

16. In the view to bring this matter to a fast, amicable resolution, our Clients agree to

- a) *Change their firm name from Liquid Air to some other name within 2 to 3 months time, not later than 15th July, 2016, as necessary procedures of preparing and registering partnership deed is involved.*
- b) *Stop using the domain name www.liquidair.in within a month's time and apply for its cancellation.*
- c) *Not use the name Liquid Air as their Business name or for soliciting business from hereon.*
- d) *Not use the name, tradename, trademark LIQUID AIR in their business or any of their stationery, bills, invoices, catalogues, sales materials, etc.*
- e) *Change the name of the Company Liquid Air Events Pvt. Ltd. by removing the words LIQUID AIR from the name by applying for Name change to the Registrar of Companies. This act will be done within 2 to 3 months or such earlier time as the ROC approves name change. We will keep you informed about the application and the progress once we prepare & submit the same."*

3. However, since the Defendants did not fully comply with the requisitions of the Plaintiffs, the present suit was filed seeking an injunction. On 9th May, 2018, this Court had passed an ex-parte order of injunction in the following terms: -

*"In the circumstances, let summons of the suit and notice of the injunction application be issued to the defendants through all modes returnable before the learned Joint Registrar on **05.09.2018** and in the meanwhile the defendants are restrained from dealing, directly or indirectly, in any goods/services similar to the goods/services of the Plaintiffs under Trade Mark 'Liquid Air' or any other Mark deceptively similar to Plaintiffs' Trade Mark "AIR LIQUIDE" and*

variations thereof and from using the domain name liquidair.in or any other domain name comprising of the term Liquid Air or any term similar to “AIR LIQUIDE”, to the Plaintiffs.”

4. In response to the present suit, the Defendants moved an application under Order XXXIX Rule 4 being I.A. 11510/2018 in which the Defendants plead that their firm was registered in 1995 with the Registrar of Firms i.e. on 6th September, 1995. It is also pleaded that the Defendants are not engaged in the manufacturing of gases but are only involved in the trading of gas products. Mr. Pallav Sisodia, learned senior counsel appearing for the Defendants has pointed out one set of documents to show how Liquid Air is merely used on the stationery/invoices and on no other physical products. He also submits that the Defendants have been a member of All India Industrial Gas Manufacturers Association from 2002 till 2012 without any objection from the Plaintiffs. It is also submitted that the Plaintiffs were also the member of the said association.

5. On the other hand, learned counsel for the Plaintiffs relies heavily on the reply dated 16th April, 2016 (@ 16th March, 2016) as also email dated 23rd May, 2018 sent to the law firm representing the Plaintiffs on behalf of the Defendants. In the said email, it was stated on behalf of the Defendants as under: -

“Dear Shri Adv. Vinod Khurana

In the above subject matter and in respect of any/all the legal proceedings initiated thereof, I have been duly authorized to represent my Clients and on behalf and on instructions of my clients 1. Liquid Air 2. Circular Plastics Pvt. Ltd. 3. Omprakash Chhangani 4. Kumud Chhangani 5. Rupal Chhangani 6. Pooja

Chhangani, I wish to address you as under,

1. As per the telephonic conversation with you on Monday 21st May, 2018, please take note that our Clients hereby convey their intention to reach an amicable and expeditious solution to put the entire matter regarding the trademark to rest. Our clients feel that a protracted legal battle will be in neither their interest nor in your Client's interest.

2. Our Clients are ready to enter into a MOU / Consent terms with your Clients.

3. Our Clients will be taking detailed steps needed in all respects in a guaranteed time frame of 45 days from your acceptance in writing to our offer to enter into MOU / consent terms. The end effect will be putting the matters raised in the subject matter / litigation to complete rest, in favour of your clients.

4. In consideration for an amicable time bound resolution, we want a written assurance from you and your Clients that all pending Suits / Plaints / Complaints / Proceedings initiated against our clients including the Suit CS (COMM) No.847/2018 in the High Court of Delhi at New Delhi will be withdrawn and NO DAMAGES / COSTS of any kind whatsoever will be claimed / sued / recovered from our Clients now or in future.

Sincerely hoping for the same immediate, positive response which you expressed in our telecom."

6. He submits that the Plaintiffs are the registered proprietors of the mark 'AIR LIQUIDE' and the use by the Defendants would constitute infringement and passing off.

7. Mr. Sishodia, at this stage under instructions from Mr. Om Prakash

Chhangani who is present in Court submits that if the Plaintiffs are willing to give up the relief of damages and rendition of accounts, his client is willing to change the name provided six months time is given to change the same.

8. Mr. Khurana, on the other hand, submits that if the Defendants change the name, his clients are willing to give up the damages and rendition of accounts.

9. Considering the nature of the disputes between the parties and the reply to the legal notice as also the email dated 23rd May, 2018 there does not seem to be any major dispute remaining in the matter. It is the settled position in law that even if a registered trademark is used as a business name or trading style, would constitute infringement of the trademark under Section 29(5) of the Trademarks Act. Thus, holding the Defendants to the statements made by them in the reply and in the email as extracted above, it is directed as under: -

- (i) The Defendants would not adopt any mark or name which is identical or deceptively similar to the Plaintiffs' mark 'AIR LIQUIDE'. The Defendants' firm name 'LIQUID AIR' would be changed w.e.f. 1st April, 2019.
- (ii) The Defendants shall obtain the requisite approvals from the Registrar of Firms or any other authority including the Registrar of Companies insofar as Defendant No.2 is concerned to ensure that the name 'LIQUID AIR' is changed to a new name.
- (iii) The domain name www.liquidair.in would be surrendered by the Defendants and would not be used for the purposes of their business activities. No other domain name or website name

would be adopted which contains any mark or name identical or deceptively similar to the mark AIR LIQUIDE.

- (iv) The Plaintiffs does not press the relief of damages and rendition of accounts.

10. Statement of Defendant no.3 is recorded today. The suit is decreed in terms of paragraph 46(a) and (b). Insofar as the domain name is concerned, the same shall be surrendered. No other reliefs are pressed in this matter. The decree shall come into effect from 1st April, 2019. All pending IAs are disposed of. No further orders as to costs. Decree sheet be drawn.

PRATHIBA M. SINGH, J.

SEPTEMBER 26, 2018

Rekha