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

+ CS(COMM) 644/2016

ADITYA BIRLA NUVO LIMITED Plaintiff

Through Mr. Ajay Sahni, Advocate with
Ms. Kritika Sahni, Advocate

versus

M/S R.S SALES CORPORATION & ANR Defendants

Through Mr. B.P. Singh Dhakray, Advocate

Reserved on: 04th May, 2018

Date of Decision: 10th July, 2018

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CORAM:

HON'BLE MR. JUSTICE MANMOHAN

J U D G M E N T

MANMOHAN, J:

1. The present suit has been filed for permanent injunction restraining infringement of trade mark, rendition of accounts, etc. The prayer clause in the suit is reproduced hereinbelow:-

"32. *The Plaintiff prays:-*

(i) *For an order for perpetual injunction restraining the defendants, their proprietor/partners/directors, as the case may be, principal officers, servants, retailers, stockiest, distributors, representatives and agents from manufacturing itself, permitting others to manufacture on its behalf, selling, offering for sale, stocking, advertising, directly or indirectly dealing in clothing, footwear, headgear or any other allied and cognate goods under the impugned trade mark PETER ENGLAND or any other trade mark which incorporates or contains the registered trade mark PETER ENGLAND of the plaintiff or any other trade mark/marks*

which are deceptively similar to the plaintiff's said registered trade mark PETER ENGLAND amounting to infringement of the registered trade mark PETER ENGLAND of the plaintiff registered under No.665416 in class-25.

(ii) For an order for rendition of accounts of profits illegally earned by the defendants by manufacturing and selling their products containing and/or incorporating the impugned infringing trade mark PETER ENGLAND.

(iii) For an order for delivery for purposes of destruction of all impugned cartons, boxes, wrappers, dies, labels, advertising material, blister packs, footwear, etc. and any other infringing copies or media used by the defendants in pursuit of their illegal activities.

(iv) For costs in the proceedings."

2. Vide order dated 17th June, 2013, the learned predecessor of this Court had granted an ex parte ad interim injunction in favour of the plaintiff and against the defendants. The relevant portion of the ex-parte injunction order is reproduced hereinbelow:-

"After having heard the learned counsel for the plaintiff and going through the plaint and the accompanying documents, I am of the view that the plaintiff has been able to make out a case for grant of interim injunction. I am also of the view that if the interim injunction is not granted ex parte the very purpose of granting this relief would be defeated.

So, issue notice of this application also to the defendants for 5th September, 2013 and it is further ordered that till further orders the defendants are restrained from selling/marketing its products by using the mark/name 'PETER ENGLAND'."

3. The ad-interim order was confirmed on 28th July, 2016 till the disposal of the suit.

4. The relevant facts of the present case are that the plaintiff is the flagship company of the Aditya Birla Group of Companies and is the registered proprietor of the trademark 'PETER ENGLAND' under registration No.665416 in class-25, in respect of clothing, footwear and headgear in India since 1997, as also in several other countries of the world.

5. It is averred in the plaint that the trademark 'PETER ENGLAND' was originally conceived and adopted more than a century ago, i.e., in the year 1889, by the plaintiff's predecessor, Carrington Viyella Garments Limited (CVGL), England. It is asserted that the said company underwent a series of corporate adjustments and changes during the course of time. It is stated that the 'PETER ENGLAND' trademark was assigned by an assignment deed dated 21st January, 2000 in favour of the plaintiff (then known as Indian Rayon & Industries Limited). It is further averred that subsequently, the plaintiff's name was changed to Aditya Birla Nuvo Limited and an application for recording the change in name was filed with the office of the Registrar of Trade Marks on 24th November, 2006. It is stated that the plaintiff had also applied for the registration of the trademark 'PETER ENGLAND' in respect of other classes, which are pending. The plaintiff has further averred in the plaint that apart from the trademark 'PETER ENGLAND', the plaintiff is also the proprietor of several other trademarks, which incorporate the trademark 'PETER ENGLAND'.

6. It is stated in the plaint that the plaintiff had filed two applications on 03rd September, 2001 for registration of the trademarks ELEMENTS PETER ENGLAND (label) and PETER ENGLAND (label) under registration nos. 1041517 and 1041520 in class-25 and these trademarks were published in the Trade Mark Journal No.1331 (S-1) dated 15th June, 2005.

7. It is stated in the plaint that the defendant No. 1 is engaged in the business of manufacturing and selling footwear and defendant No. 2 is defendant No. 1's stockist and the said defendants sell, *inter alia*, footwear under the trademark 'PETER ENGLAND VIP SHOES'.

8. It is stated in the plaint that despite repeated reminders and objections raised by the plaintiff, to the adoption and use of its registered trade mark 'PETER ENGLAND', by defendant No.1, the plaintiff noticed in the last week of March, 2012 that the defendant No.1 had continued selling its infringing goods in Kerala. It is stated that the plaintiff filed a civil suit No.OS 4/2012 in the Court of District Judge, Manjeri, Kerala and even after the lapse of twelve months from the date of institution of the suit, the defendant No.1 had evaded service of summons and had started selling its products in other jurisdictions.

9. It is stated that in the second week of June, 2013 the plaintiff came to know that the defendant No.1 had started selling its infringing footwear in Delhi and the plaintiff was able to purchase one such infringing product from the premises of defendant No.2.

10. It is stated in the plaint that the defendants were using an identical trade mark, i.e., 'PETER ENGLAND', as the primary and dominant part of its trade mark and the use of the suffix of VIP SHOES below the said trade mark 'PETER ENGLAND' in a much smaller font, did not diminish the deceptive similarity of the said infringing mark of the defendants to that of the plaintiff. A pictorial representation of the marks of the plaintiff and defendants is reproduced hereinbelow:-



11. On 04th May, 2018, the present suit had been listed for framing of issues. Learned counsel for defendants suggested that the following issues arise for consideration:-

- (i) Whether the plaintiff is not the registered owner of the trademark PETER ENGLAND, as its pedigree is allegedly incomplete?
- (ii) Whether the validity of the plaintiff's trademark registration is open to challenge by the defendants?
- (iii) What is the effect of a copyright registration by the defendants, of its brand PETER ENGLAND VIP SHOES?
- (iv) Whether the plaintiff is entitled to any relief as the plaintiff is only involved in the business of apparel, while the defendants are involved in the business of shoes?

12. Since this Court was of the prima facie opinion that the defendants had no plausible defense and none of the issues suggested by the defendants arose for consideration, the matter was heard at length.

13. Learned counsel for the defendants stated that the PETER ENGLAND logo is registered in the name of Indian Rayon and Industries Ltd. He stated that the plaintiff's Form TM-33, seeking substitution of the name of the proprietor, which was filed on 24th November, 2006, is still

pending consideration. He stated that the defendant No.1 started using the brand PETER ENGLAND VIP SHOES on 11th May, 1998 and filed an application bearing No. 805051 in class-25 for registration of the trademark PETER ENGLAND VIP SHOES on 08th June, 1998. He stated that the same had been advertised in the Trade Mark Journal No.1401 dated 01st October, 2008 and is still pending. He stated that the defendant No.1 has also filed oppositions to two trademark registration applications filed by the plaintiff, for registration of the trade marks ELEMENTS PETER ENGLAND (Label) and PETER ENGLAND (Label) on the ground that it was the proprietor of the trademark PETER ENGLAND (along with the suffix VIP SHOES) and the same are still pending

14. Learned counsel for the defendants stated that on 01st July, 2000 the defendant No.1 had applied for registration of its copyright in the brand PETER ENGLAND VIP SHOES and was allotted the same on 20th August, 2001. He stated that the search report, dated 27th June 2000, conducted by Mr. T.R. Subramaniam, Joint Registrar of the Trade Marks Central Building Maharashi Karve Road, Mumbai – 400 020, revealed that no trademark identical with or deceptively similar to the artistic work of the defendants had been registered under the Trade And Merchandise Marks Act, 1958. He stated that subsequently, a certificate under Section 45(1) of the Copyright Act, 1957 had been issued by the Govt. of India Trade Marks Registry. He stated that in view of defendants' existing copyright registration, with regard to the mark and artistic work PETER ENGLAND VIP SHOES, it had propriety rights in the trademark PETER ENGLAND VIP SHOES.

15. Learned counsel for the defendants contended that there is no infringement of the plaintiff's registered mark PETER ENGLAND in terms

of Sections 28 and 29 of the Trade Marks Act, 1999, as the defendants are not engaged in the same business as the plaintiff, i.e. of clothing, readymade garments, apparels, headgear etc., but are only engaged in manufacturing/fabrication of different brands of shoes. He stated that the defendant No.1 had advertised its business for shoes, slippers, chappals, sandals, etc. since 1999 and the defendant No. 1 had established itself as a market leader in the field of footwear, under the brands PETER ENGLAND VIP SHOES, LONDON VIP SHOES, ENGLISH QUEEN and ROYAL MAN.

16. Learned counsel for the defendants emphasized that although the plaintiff's mark PETER ENGLAND is registered under class-25 of Trade Marks Act, 1999, for clothing, footwear and headgear, the plaintiff is not engaged in the business of sale of shoes.

17. At the outset, learned counsel for plaintiff stated that no issue arose for consideration. He confined his relief to prayers 32 (i) and (iv) of the plaint. The statements made by the learned counsel for the plaintiff were accepted by this Court and the plaintiff was held bound by the same.

18. Learned counsel for the plaintiff stated that Indian Rayon and Industries Ltd. was the earlier name of the plaintiff company and the plaintiff had filed a Fresh Certificate of Incorporation dated 27th October, 2005, proving the same. He further stated that due to change in name, the plaintiff filed Form TM-33, for change of the registered proprietor's name from Indian Rayon and Industries Ltd. to M/s Aditya Birla Nuvo Ltd., as a formal intimation to the Trade Marks Registry regarding the same. He contended that the rights of the plaintiff already stood established even in the absence of any formal order passed by the Trade Marks Registry. He stated that the plaintiff's registration, with regard to the trademark 'PETER

ENGLAND', is still valid and subsisting. He stated that the defendants' trademark application claims user since 1998, while the plaintiff had been using the mark PETER ENGLAND since 1997, at least.

19. He stated that the plaintiff is the prior user and adopter of the trademark PETER ENGLAND and its artistic label. He stated that the defendant No.1 had fraudulently obtained a certificate under Section 45(1) of the Copyright Act, 1957, in regard to the artistic work PETER ENGLAND, by suppressing the fact that the defendant No.1 had copied the prior published artistic label PETER ENGLAND of the plaintiff. He stated that the Registry issued the aforesaid certificate, in error, without notice to the plaintiff and the same would not entitle the defendants to any rights in the infringing trademark/ artistic work. He stated that no public notice was issued for an application for copyright registration and that the plaintiff had challenged the defendants' copyright registration and the same is pending adjudication before the Copyright Appellate Board.

20. The present suit is at the stage of framing of issues. In the opinion of this Court, the defense sought to be adopted by the defendants is contrary to admitted facts, untenable in law and is not relevant or necessary for deciding the controversy involved in the present suit. Consequently, this Court is not bound nor would it be justified to frame an issue on such unnecessary or baseless pleas as propounded by the defendants, which would only cause unnecessary and avoidable inconvenience to the parties and waste valuable time of the Court.

21. This Court in ***Zulfiquar Ali Khan & Ors. vs. Straw Products Limited & Ors.*** 2000 (56) DRJ (Suppl) 590 has held as under:

"If a plea is not valid and tenable in law or is not relevant or necessary for deciding the controversy involved, the would not be

bound and justified in framing issue on such unnecessary or baseless pleas, thereby causing un-necessary and avoidable inconveniences to the parties and waster of valuable court time.”

22. Detailed reasons for not framing any of the issues suggested by the defendants are as under:-

Issue 1: Whether the plaintiff is not the registered owner of the trademark 'PETER ENGLAND', as its pedigree is allegedly incomplete?

23. On a perusal of the file, this Court finds that the plaintiff has filed its original Legal Proceeding Certificate for its registered trademark 'PETER ENGLAND' in class 25 dated 22nd August, 2017, which is renewed upto 12th May, 2025. Since the Legal Proceeding Certificate names the plaintiff, i.e. Aditya Birla Fashion and Retail Limited, as the owner of the aforesaid mark, this Court is of the opinion that the plaintiff is the registered proprietor of the mark 'PETER ENGLAND' and possesses all rights and title over the aforesaid mark. This Court is further of the view that the defendants have not challenged the validity of the said certificate and in the absence of any challenge to the said Certificate, the Legal Proceeding Certificate dated 22nd August, 2017, filed by the plaintiff is legal, valid, binding and subsisting. Consequently, the proposed issue does not arise for consideration.

Issue 2: Whether the validity of the plaintiff's trademark registration is open to challenge by the defendants?

24. This Court is further of the opinion that although the defendants had filed oppositions to two pending applications filed by the plaintiff for registration of the marks ELEMENTS PETER ENGLAND (Label) and PETER ENGLAND (Label), the defendants have neither filed an

application under Section 57(1) of the Trade Marks Act, 1999 for cancellation/rectification of the plaintiff's registered trademark PETER ENGLAND, nor an application under Section 124(1) of the Trade Marks Act, 1999, seeking stay of the present proceedings.

25. According to the judgment in ***Patel Field Marshal Agencies and Another Vs. P.M. Diesels Limited and Others***, (2018) 2 SCC 112 the plea of invalidity of the plaintiff's trademark 'PETER ENGLAND', made by the defendant, is deemed to be abandoned as the defendants have not moved an application under Section 124 of the Trade Marks Act, 1999 (Section 111 of The Trade And Merchandise Marks Act, 1958), till date. The relevant portion of the aforesaid judgment is reproduced hereinbelow:-

“36. Thus, by virtue of the operation of the 1958 Act, the plea of rectification, upon abandonment, must be understood to have ceased to exist or survive between the parties inter se. Any other view would be to permit a party to collaterally raise the issue of rectification at any stage notwithstanding that a final decree may have been passed by the civil court in the meantime. True, the decree of the civil court will be on the basis of the conclusions on the other issues in the suit. But to permit the issue of rectification, once abandoned, to be resurrected at the option of the party who had chosen not to pursue the same at an earlier point of time would be to open the doors to reopening of decrees/orders that have attained finality in law. This will bring in uncertainty if not chaos in the judicial determinations between the parties that stand concluded. Besides, such an interpretation would permit an aggrieved party to get over the operation of a statute providing for deemed abandonment of the right to raise an issue relevant; in fact, fundamental to the lis.”

26. Consequently, the second issue proposed by the defendants also does not arise for consideration.

Issue 3: What is the effect of a copyright registration by the defendant of its brand PETER ENGLAND VIP SHOES?

27. This Court in *Societe Des Produits Nestle vs. Continental Coffee Ltd. (2011) 185 DLT 752* has held that mere registration under the Copyright Act, 1957 does not authorize the defendant to use the trademark of the plaintiff, if it is found that the mark being used by the defendants is identical or similar to the registered trademark of the plaintiff. The relevant portion of the said judgment is reproduced hereinbelow:

“19. In my view, mere registration under Copyright Act does not authorize the defendant to use the trademark of the plaintiff if it is found that the mark being used by him is identical or similar to the registered trademark of the plaintiff or it is proved that use of the impugned mark by him on identical goods is likely to cause confusion or create an impression of association with the registered trademark of the plaintiff. Registration under Copyright Act, in such a situation would be no defence to the charge of infringement and would not take the case out of the purview of Section 29(1) and (2) of Trademarks Act, 1999.”

28. In view of the aforesaid judgment, this Court is of the opinion that registration of an artistic work under the Copyright Act, 1957 in favour of the defendants, does not confer any right in the defendants to use the plaintiff's trademark 'PETER ENGLAND' and/or the same does not afford a defense to the defendants in a suit for infringement.

Issue 4: Whether the plaintiff is entitled to any relief as the plaintiff is only involved in the business of apparel, while the defendants are involved in the business of shoes?

29. In fact, the plaintiff is the registered proprietor of the trade mark 'PETER ENGLAND' under class-25, which includes clothing and headgear as well as footwear. Section 28(1) of the Trade Marks Act, 1999, grants the

trademark owner “...*the exclusive right to use of the trade mark in relation to the goods or services in respect of which the trade mark is registered...*”, which in the present case includes footwear as well as clothing and headgear.

30. This Court is also of the opinion that a mark which is registered is protected, irrespective of the fact whether the plaintiff uses the registered mark. The Apex Court in *M/s Gujarat Bottling Co. Ltd. and others v. Coca Cola Company and others (1995) 5 SCC 545* has held as under:

“11....In respect of a trade mark registered under the provisions of the Act certain statutory rights have been conferred on the registered proprietor which enabled him to sue for the infringement of the trade mark irrespective of whether or not mark is used....”

31. It is pertinent to mention that recently the owner of a restaurant in Seoul, South Korea, was fined 14.5 million KRW (about \$125,000) for adopting the name and signature monogram pattern of Louis Vuitton for his restaurant, to sell chicken. The owner adopted the name “*Louis Vuiton Dak*” in an attempt to play a parody on Louis Vuitton, as the last two words together read together as “*tongdak*”, the Korean word for “*whole chicken*”. The intention behind adopting the name “*Louis Vuiton Dak*” was to poke fun at the Louis Vuitton customers, thereby bordering on trademark parody. The defence that Louis Vuitton was not in the restaurant business did not ‘cut any ice’. When threatened with large fines, the owner changed it to “*chaLouisvui tondak*”, but was nonetheless fined 14.5 million KRW (about \$125,000). (See: <https://trademark.eu/louis-vuitton-dont-be-a-chicken/>)

32. In view of the above, the suit is decreed in favour of the plaintiff and against defendants in terms of prayer clause 32 (i) of the plaint along with the actual costs. The costs shall amongst others include the lawyers’

fees as well as the amounts spent on purchasing the court fees. The plaintiff is given liberty to file on record the exact cost incurred by it in adjudication of the present suit, if not already filed. Registry is directed to prepare a decree sheet accordingly. Consequently, the present suit and applications stand disposed of.

MANMOHAN, J

JULY 10, 2018

rs/mn

