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

% *Date of Judgment: 07th August, 2018*

+ RFA(OS) 94/2016

SAMSUNG ELECTRONICS COMPANY LTD. & ANR.

..... Appellants

Through Mr. Pravin Anand and Mr. Nishchal
Anand, Advocates

versus

GYANJI CHOUDHARY & ANR.

..... Respondents

Through *Nemo*

CORAM:

HON'BLE MR. JUSTICE G.S.SISTANI

HON'BLE MS. JUSTICE SANGITA DHINGRA SEHGAL

G.S.SISTANI, J. (ORAL)

1. The present appeal is directed against the judgment dated 07.09.2016 passed by a learned Single Judge of this Court by which the suit filed by the appellant herein has been dismissed for non-prosecution, as no evidence was led to prove issues which were framed in the matter.
2. Some necessary facts which are required to be noticed for the disposal of the present appeal are that the appellant had filed a suit for permanent injunction restraining infringement and dilution of trade marks, passing off, damages, rendition of accounts, delivery up etc. against the respondents. The appellant is a registered proprietor of the trade mark 'SAMSUNG'. The appellant company was established in the year 1938 in Korea. The appellant/plaintiff claims world-wide presence with more than 285 overseas operations in 67 countries,

employing approximately 175000 employees world-wide as on the date of filing of the plaint which was in the year 2006. The appellant also claims strong presence in India since the year 1995 when a joint venture was formed although it claims that the brand 'SAMSUNG' was available and on account of trans-border reputation, the trade mark 'SAMSUNG' has had a continued presence in this country.

3. While issuing summons in the suit, an *ex parte* injunction was granted by an order dated 06.09.2006. The Defendants(respondents) herein entered their appearance and filed their written statement, however, they stopped appearing in the matter and thus, were proceeded *ex parte*. The issues were framed as far back as on 05.11.2008. The order dated 05.11.2008 as far as it relates to the orders passed in the suit is reproduced below:

“CS(OS) No.1602/2006

The Plaintiffs have already filed the replication to the written statement of the Defendants. It is the case of the Defendants that the Defendants have never infringed and have no intent to infringe the trademark of the Plaintiff. In the circumstances, no issue arises as far as the relief of permanent injunction claimed in the plaint is concerned. The only issue which remains between the parties is as to whether the Defendants have in the past infringed the trademark and if so, to what damages and costs the Plaintiffs are entitled to. Accordingly, the following issues are framed.

- 1) Whether the Defendants infringed the trademark of the Plaintiff and if so, to what damages, if any, are the Plaintiffs entitled to? OPP
- 2) Whether the Plaintiffs are not entitled to any relief for the reason of having suppressed any material facts? OPD
- 3) Relief.

The counsel for the Defendants contends that no case of

infringement of trademark is made out since according to the Plaintiffs also the goods were sold by the Defendants under the trademark of the Plaintiffs only. However, the counsel for the Defendants contends that the goods in which the Defendants were dealing, though bearing the trademark of the Plaintiffs and sourced from the Plaintiffs, were meant for marketing in the other territories than India and since the services with respect thereto would not be available in India, it amounts to infringement under Section 30 (4) of the Trade Marks Act, 1999.

Since issue has already been framed as to whether the Defendants have infringed, no separate issue needs to be framed on the aforesaid aspect.

No other issue arises or is pressed. The parties to file additional documents, if any, and list of witnesses within 6 weeks. The Plaintiffs to file all their affidavits by way of examination-in-chief within 10 weeks of today. Evidence to be recorded before the Joint Registrar. List before the Joint Registrar on 16th January, 2009 for fixing dates for cross-examination of the witnesses of the Plaintiffs.”

(Emphasis added)

4. Mr. Anand, learned counsel appearing on behalf of the appellant submits that the learned Single Judge has while dismissing the suit failed to take into account the order dated 05.11.2008 wherein the defendants had taken a categorical stand that they have never infringed nor had any intention to infringe the trade mark of the plaintiff/appellant herein, no issue arises as far as the relief of permanent injunction as claimed in the plaint is concerned. Mr. Anand further submits that assuming that the learned Single Judge, for reasons stated did not grant further opportunity to lead evidence in the matter based on the stand taken by the defendants in the written statement, should have decreed the suit in terms of prayer 35(a) of the plaint.

5. We may note that notice was issued in the appeal, but none has chosen to appear in the matter. The prayer 35(a) of the plaint is reproduced as under:

“a) An order of permanent injunction restraining the Defendants, their partners or directors, as the case may be, their principal officers, servants, agents and all others acting for and on their behalf from importing, exporting, distributing, selling, offering for sale, advertising, directly or indirectly dealing in grey market ink cartridges/toners or any other products of the Plaintiffs under the trademark “SAMSUNG” or under any other mark as may be deceptively similar to the Plaintiffs’ trademarks amounting to the infringement of the Plaintiffs’ registered trademarks.”

6. Reading of the order dated 05.11.2008 would show that the same was passed by the learned Single Judge in the presence of the counsel for the defendants. A reading of the order dated 05.11.2008 together with the stand taken in the written statement leaves no room for doubt that the stand of the defendants was that they had neither infringed nor and had any intention to infringe the trade mark of the plaintiff appellant herein. The learned Single Judge had taken into account the statement made by the counsel for the defendants and observed that “*no issue arises as far as the relief of permanent injunction claimed in the plaint is concerned*”.
7. In view of the stand taken by the defendant, we find force in the submission made by the learned counsel for the appellant. No evidence was required to be led by the plaintiff/appellant herein, before the learned Single Judge with respect to the prayer 35(a). Accordingly, the order dated 07.09.2016 is modified to the extent that while the reliefs as claimed in paragraph 35(b), (c) and (d) are

rejected, the plaintiff/appellant herein would be entitled to a decree in terms of prayer 35(a) of the plaint. Accordingly, the respondents (defendants in the suit), their servants, their employees, directors, partners, principal officers, agents or anybody acting on their behalf are restrained from marketing, importing, exporting, distributing, selling, offering for sale, advertising, directly or indirectly dealing in grey market ink cartridges/toners or any other products of the plaintiffs/appellants herein under the trademark "SAMSUNG" or under any other mark as may be deceptively similar to the plaintiffs'/appellants' registered trademarks.

8. Decree sheet be prepared accordingly.

9. The appeal is allowed in above terms.

CMs. APPL.46567/2016 & 46568/2016

10. The applications stand disposed of in view of the order passed in the appeal.

G.S.SISTANI, J.

SANGITA DHINGRA SEHGAL, J.

AUGUST 07, 2018

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