

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 30.08.2019

CORAM

**THE HONOURABLE MR.JUSTICE KRISHNAN RAMASAMY**

C.S.No.433 of 2010

Mercer(US) Inc.  
1166,Avenue of the Americas  
New York, New York 10036,  
Rep. By Mr.David M. Goldenberg  
Secretary and General Counsel  
...Plaintiff

Vs.

1.Mercer Job Network and HR Consultancy Private Ltd.,  
New No.63/11, Old No.37/11,  
Arcot Road, Kodambakkam,  
Chennai 600 024, Tamil Nadu.

2.Mr.P.K.Shivashankar,  
Managing Director,  
New No.63/11, Old No.37/11,  
Arcot Road, Kodambakkam,  
Chennai 600 024, Tamil Nadu.

3.Mrs. Uma Shivashankar,  
Director,  
New No.63/11, Old No.37/11,  
Arcot Road, Kodambakkam,  
Chennai 600 024, Tamil Nadu.

4.Uditi Technologies  
Uuditi House, 54/4, Palwels Road,  
Sripuram Colony, St.Thomas Mount,

Chennai-600 016, Tamil Nadu.

...Defendants

**PRAYER :** Civil Suit filed under Order VII Rule 1 read with order IV Rule I O.S.Rules and Sections 27,28 and 135 of the Trade Marks Act, 1999, praying for a Judgment and Decree against the defendants: (a) an order of permanent injunction to restrain the Defendants, jointly and severally, by themselves, their Directors, Servants, Agents, representatives and all those acting in concert with them or claiming under or through them or otherwise from infringing the Plaintiff's trade mark and trade name 'MERCER' under No.1580611 in Classes 9,35,36,38,41 and 42; (b) an order of permanent injunction to restrain the Defendants, jointly and severally, by themselves, their Directors, Servants, Agents, representatives and all those acting in concert with them or claiming under or through them or otherwise howsoever, from using the impugned name 'MERCER' upon or in relation to their business, company name, services and / or any other name/ marks which may be identical to and / or deceptively similar to the Plaintiff No.1's corporate name, trade mark 'MERCER' and from in any manner, passing off or attempting to pass off or causing, enabling or assisting others to pass off their business, company name, services as and for the business and products of the Plaintiff; (c) a decree of Permanent injunction restraining the Defendants, their partners, affiliates, employees, assignees, successors in – interest, licensees, distributors, stockists and agents or anyone associated with them from passing-off the Plaintiff's trade mark MERCER and its

registered domain name www.mercer.com by using www.mercerjobnetwork.com, or any other combination of words/ letters that may be identical to or phonetically/ structurally/ deceptively similar to the trade mark MERCER of the Plaintiff's, as domain names/ website addresses and further restrain the Defendants jointly or severally from seeking registration of any identical or confusingly/ deceptively similar expressions as domain names whether singularly or in conjunction with any other word used as a pre-fix or suffix; (d) an order for delivery up for destruction upon oath all stationery, business cards, bill boards, brochures, promotional material, letter heads, sign boards, sign posts, leaflets, or any other items of whatsoever description and nature, bearing the name MERCER and/ or any other mark(s) which may be identical and / or deceptively similar to the plaintiff's name trade mark/ trade name/ domain name MERCER which would offend against the foregoing injunction; (e) directing the defendants to render an account of profits made by them using the Trade Mark MERCER with respect to the services rendered and decree the suit for the profits found to have been made by the Defendants, after the Defendants have rendered accounts; (f) an order for costs of this suit.

For Plaintiff : Ms.C.Daniel & Gladys Daniel  
For Defendants : Set exparte

**J U D G M E N T**

The above suit has been filed seeking an order of permanent injunction restraining the defendants from infringing the plaintiff's Trademark passing off their business name Mercer Job Network and HR Consultancy Private Limited, use of the domain name and other consequential reliefs.

2. According to the Plaintiff, it was founded in the year 1937 as an Employee Benefits Department of Marsh & McLennan, Inc. The Plaintiff took the name of William M Mercer in 1959 when Marsh & McLennan acquired William M. Mercer Limited, a Canadian firm founded by William Manson Mercer in 1945. Ever-since the Plaintiff has continued to use the trademark/trading style MERCER. The Certificate of Incorporation of the Plaintiff was marked as **Exhibit P2.**

3. The Plaintiff has subsidiaries world wide as evidenced by **Exhibit P3.** Further, the Plaintiff's activities worldwide are evidenced by **Exhibit P5.** The Plaintiff has endeavoured to create

Intellectual Properties by filing Applications for Registration of the Trademark MERCER worldwide. The Trademark Registration and Pending Applications for the mark MERCER is marked **Exhibit P14**. The Plaintiff has also secured various domain name incorporating the Trademark MERCER'. The WHOIS database with relevant extracts reflecting the Plaintiff's domain names is marked as **Exhibit P6**.

4. It is further stated that the Plaintiff's turnover in respect of the Trademark MERCER has been growing every year. The Annual Reports of the Plaintiff for the period 2000-2009 is marked as **Exhibit P7**. The Plaintiff has garnered tremendous goodwill and reputation among the trade and public. The Award won by the Plaintiff in respect of the business MERCER is evidenced by **Exhibit P9**. Several articles have also been published about the Plaintiff as evidenced by **Exhibit P11**. The Plaintiff caters to several Fortune 500 Companies. The list of some of the Plaintiff's Fortune 500 clients is marked as **Exhibit P10**.

5. The Plaintiff has two Indian subsidiaries MERCER Consulting

India Private Limited and MERCER India Private Limited. The Incorporation Certificate along with Articles of Association and Memorandum of Association is **Exhibit P4**. The audited financial statement of the Indian Subsidiary Mercer Consulting India Private Limited for the year 2008 is **Exhibit P8**.

6. In India the Plaintiff has filed a multiclass application for registration of the Trademark MERCER under No.1580611 in Classes 9,25,26,38,41 & 42. The Application has been advertised in Trademark Journal No.1428 dt. 16.11.2009 at page 7108 in **Exhibit P12**. No Opposition has been filed and the online record reflecting the same is marked **Exhibit P13**.

7. While so, the Plaintiff came across the 1<sup>st</sup> Defendant company incorporated having the name MERCER forming part of the company name. The details of incorporation of the 1<sup>st</sup> Defendant with the 2<sup>nd</sup> and 3<sup>rd</sup> Defendants as its Directors is marked as Exhibit P17. The 1<sup>st</sup> Defendant has created a domain name with the name MERCER forming part of the domain name as evidenced by Exhibit P15. Exhibit P16 is the extract of the WHOIS database reflecting the

4<sup>th</sup> Defendant.

8. Being aggrieved, the Plaintiff issued a legal notice on 25.06.2009 to the Defendant Nos. 1 to 4, which is marked as **Exhibit P18**. A reply was received on 17.07.2009 indicating a possibility of settlement which is marked as **Exhibit P19**. The Plaintiff immediately responded on 04.08.2009 proposing a conference to negotiate settlement which is marked as **Exhibit P20**. On 12.08.2009, 27.08.2009, 08.09.2009, 26.10.2009, 29.10.2009, 30.10.2009, 09.11.2009 the parties continued to correspond as evidenced by **Exhibits P21 to P24**. Thereafter, The Plaintiff sought to settle the matter amicably with the Defendants. However, on 26.11.2009 the Plaintiff was shocked to receive an email from the Defendants demanding 30 million INR as settlement for change of its company name and domain name deleting the word MERCER belonging to the Plaintiff.

9. It is further stated that the Plaintiff is the prior user and registered proprietor of the Trademark MERCER around the world. In India, the Plaintiff is carrying on business through its Indian

Subsidiary under the name MERCER. The trade and public associate the trademark MERCER with the Plaintiff alone.

10.The Defendants have dishonestly adopted the Plaintiff's trademark and are trading on the Plaintiff's goodwill and reputation. The dishonesty is evident in the demand made upon the Plaintiff for 30 million INR to delete the name MERCER forming part of the company name and domain name. Hence, left with no other alternative the plaintiff filed the present suit seeking for the aforesaid reliefs.

11. Pending suit this Hon'ble Court granted interim injunction on 23.04.2010. The order of interim injunction is still in force. Despite the suit summons being served on the defendants and their names printed in the cause list, none appeared on behalf of the defendants and therefore they were set exparte on 15.07.2019. Thereafter, the matter was listed before the learned Additional Master II for recording exparte evidence.

12. In order to substantiate their claim one Mr.Bhupinder

Singh Bindra (PW1) was examined on the side of the Plaintiff and Exhibits P1 to P25 were marked on their side.

13. I have heard the learned counsel for the Plaintiff and also gone through the Proof Affidavit as well as the documents filed on the side of the Plaintiff.

14. On a perusal of Exs.P2 to P7, it is clear that the Plaintiff is the registered proprietor of the Trademark MERCER. Further, the Application for registration of the Trademark MERCER in the name of the Plaintiff has not been been opposed as evidenced by Exhibits P12 & P13.

15. On the other hand, the defendants are also using the registered trade mark of the Plaintiff which clearly amounts to infringement in terms of Section 29 of the Trade Marks Act 1999. Therefore, the Plaintiff is entitled to the reliefs as prayed for.

**Mr.KRISHNAN RAMASAMY.J,**

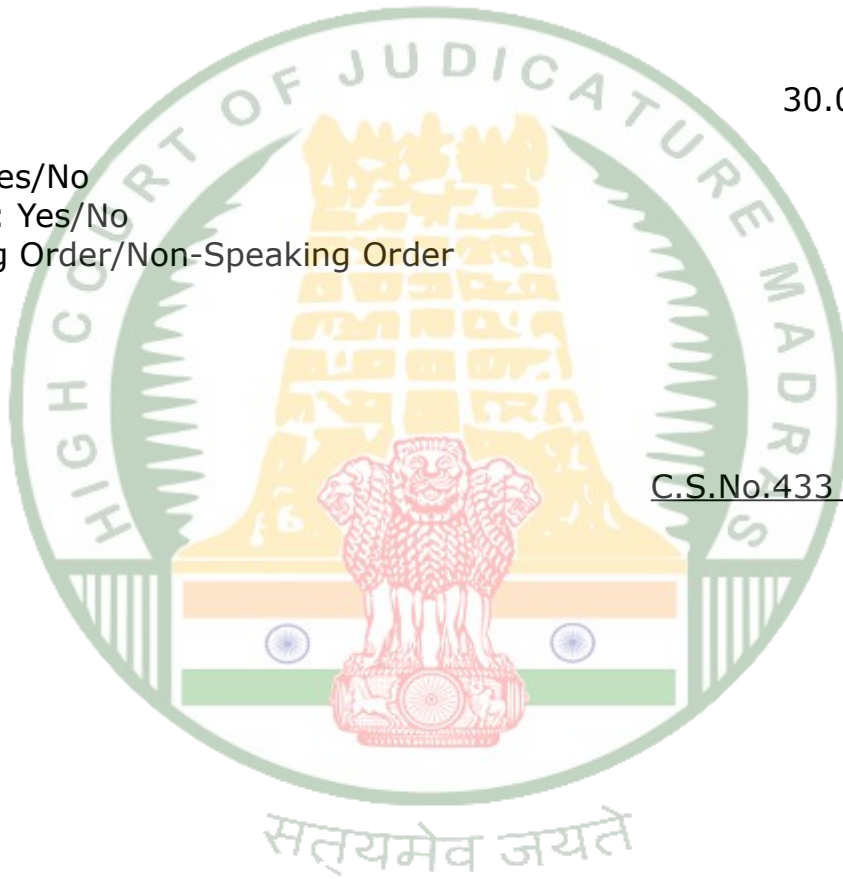
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16. Resultantly, the suit is decreed as prayed for with costs.

30.08.2019

Index: Yes/No  
Internet: Yes/No  
Speaking Order/Non-Speaking Order

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