

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

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Reserved on: 3rd April, 2019
Pronounced on: 29th April, 2019

CS (COMM) 313/2018

M/S PARIDHI UDYOG

..... Plaintiff

Through: Mr. Umesh Mishra, Adv.

versus

JAGDEV RAJ SARWAN RAM DHIMAN

..... Defendant

Through: Ms. Rajdipa Behura, Advocate with
Mr. Philomon Kani and Ms. Kirti Handa,
Advocates

JUDGMENT

SANJEEV NARULA, J

1. The present suit concerns Plaintiff's intellectual property rights in its registered trademark "AADHAR SHREE" [label].

Case of the Plaintiff

2. Plaintiff, a partnership firm is the registered proprietor of the trademark "AADHAR SHREE" (Label) in Class 19. The firm is manufacturing and marketing Plaster of Paris and Plaster Sheets bearing Trademark AADHAR SHREE. Plaintiff adopted and conceived the said mark in the year 2005 and has been using the same since then. It is claimed by the Petitioner that the goods bearing the afore-noted trade mark have acquired distinctiveness, substantial goodwill and reputation amongst the consumers because of excellent quality of the products and high preference by the consumers.

This business of the aforesaid goods is being conducted from Rajasthan and from several other places including Delhi.

3. Plaintiff has also applied for registration of its trademark "AADHAR SHREE (Label)" in other classes, details whereof are as under:

<u>S.No.</u>	<u>Trade Marks</u>	<u>Class</u>	<u>Status</u>	<u>Application No.</u>	<u>J/No.</u>
1	Aadhar Shree (label)	19	REGD.	1354729	1339
2	AADHAR SHILA	19	Pending	1751362	
3	Aadhar Shree (label)	19	Pending	1751359	
4	Aadhar Shree (label)	1	Pending	1751356	
5	Aadhar Shree (label)	2	Pending	1751357	
6	Aadhar Shree (label)	6	Pending	1751358	
7	Aadhar Shree (label)	20	Pending	1751360	

4. Plaintiff has huge sales turnover and has spent considerable amount in publicity and advertisement of its trademark. Due to long continuous use of

the trademark and the wide area of operation, the trademark AADHAR SHREE has acquired secondary meaning. The year wise sale of the Plaintiff is given as under:

“Year	Sales (Rs.)
2005-06	8,79,218
2006-07	50,57,350
2007-08	1,50,65,559
2008-09	3,13,57,852”

5. The Defendant is carrying on the business which is similar to that of Plaintiff. He is using the trademark “AADHAR SHILA” (Label) in relation to goods in class 19 which is deceptively similar to the mark of the Plaintiff and constitutes infringement and passing off of the plaintiff’s registered trademark “AADHAR SHREE”. The use of deceptive/identical mark on the part of the Defendant has damaged the reputation of the Plaintiff both in the trade as well as in the minds of the members in the public. The use of deceptively similar mark AADHAR SHILA for the same or any class of goods as that of the Plaintiff, results in violation of Plaintiff’s statutory and common law rights. The use of the word “AADHAR SHILA” as a trademark by the Defendant is bound to cause deception and confusion. The adoption and use of the trademark by the Defendant is mala fide and actuated with a view to earn illegal profits for encashing upon the goodwill and reputation of the Plaintiff. Since the goods being sold by the Plaintiff as well as the Defendants are under the same class, the probability of confusion is high and the same would cause immense injury to the Plaintiff’s business and reputation.

6. In first week of May 2009, Plaintiff came to know about the infringing activities of the Defendant through its publication in Trademark Journal No. 1412 dated 16th March 2009. Thereafter plaintiff filed an Opposition bearing No. 745 342 with the trademark Registry Ahmadabad against the registration by the Defendant. The goods are being sold in Delhi and also others parts of the country.

Defendant's version

7. The summons in the suit were issued on 13th October 2009. No *ex-parte* injunction was granted. In the written statement, the Defendant objected to the maintainability of the suit on the ground of territorial jurisdiction. It is averred that both Plaintiff as well as Defendant have their registered office in Rajasthan and are manufacturing and carrying on business outside the jurisdiction of this Court. Defendant carries on business as a manufacturer, retailer and wholesaler in the classes of goods specified for the purpose of sales in the course of inter-state trades as under:

- “(a). Re-Sale: - Electric Goods, Gypsum Powder, Machinery, Machinery parts. Packing Material, POP.
- (b). Manufacture or Processing of Goods for Sale: - Building Materials, Gypsum, Machinery, Machinery parts, Tools.
- (c). Use in Mining: - Gypsum.
- (d). Use in Generation or Distribution: - POP.
- (e). Use in Packing of Goods for sale/ re-sale: - Packing Material.”

8. The specified goods under the name of “AADHAR SHILA” are being manufactured and sold since 2005. The Defendant is the prior user of the mark since April 2005. The Defendant got registered with the Sales tax

authorities on 07.05.2005 i.e prior to Plaintiff's registration dated 2nd August 2005, under the Central Sales tax Act, 1956. The word "AADHAR SHILA" remotely resembles AADHAR SHREE and the same will not deceive or cause confusion, unless the purchaser of the goods is familiar with both the words. The two marks should be considered and compared as a whole. The name, label and packaging of AADHAR SHILA have been developed by the Defendant. It is not likely to be confused with AADHAR SHREE whose packing is distinctly different in design and layout. The Defendant honestly adopted the trademark AADHAR SHILA following the practice of the manufacturing industry. The word AADHAR SHILA is generic and Plaintiff cannot claim exclusivity in respect of the words which are *publici juris* and are descriptive of the generic substance. Defendant has been using the mark for last five years and has applied for trademark registration which was advertised on 16th March 2009.

Issues

9. On the basis of the pleadings, the following issues were framed:

- “(i) Whether this court has territorial jurisdiction to decide the subject matter of the present suit? OPP
- (ii) Whether the defendant has infringed the rights of the plaintiff under the registered trademark AADHAR SHREE? If so to what effect? OPP
- (iii) Whether the plaintiff is entitled for perpetual and mandatory injunction against the defendant as prayed in clause (a) of the prayer clause? OPP
- (iv) Whether the plaintiff is entitled to the relief of delivery up/damages/rendition of accounts against the defendant as prayed for? OPP
- (v) Whether the defendant is using the trademark AADHAR SHILA since 2005? If so, to what effect? OPP
- (vi) Relief”

10. Mr Amit Gupta partner of the Plaintiff firm deposed on behalf of the Plaintiff. On behalf of the Defendant, besides the Defendant himself, two other witnesses namely Sh. Manoj Kumar Bansal and Sh. Subhash Sood filed their affidavits. All the said witnesses were cross-examined.

Analysis and Findings

Issue No 1: Facts and Evidence

11. The present suit is for permanent injunction restraining infringement of trademark, rendition of accounts, delivery up etc. Plaintiff relying upon section 134(2) of the Trademarks Act, 1999, claims that this Court has jurisdiction to try and entertain the present suit against the Defendant who is having its place of work outside the jurisdiction of this Court. On the subject of territorial jurisdiction, para Nos. 7&19 of the plaint, read as under:

“7. That due to extensive sales and publicity, the trade marks Aadhar Shree (label) of the plaintiff is enjoying wide popularity & goodwill and has become their precious business property. The plaintiff has built-up a good reputation and market for aforesaid goods under the said trade mark has become distinctive of plaintiffs goods and concern. The use of any deceptively similar / identical mark / name on the part of another therefore is bound to cause confusion and deception both in the trade as well as in the minds of the purchasing public. That the goods of the plaintiff sold under Trade Mark Aadhar Shree (label) are also available in almost all the states of India like Delhi, Haryana, Punjab, Rajasthan, U.P, Maharashtra, Gujarat, Southern States, Uttaranchal, M.P. etc.. As such the plaintiff has exclusive rights in the said trademark and thus the use of the trademark of the plaintiff by any other person including the defendant herein is bound to lead to

confusion and deception and would amount to passing off .The use of the trade mark Aadhar Shila (label) by the defendant is nothing but a dishonest & illegal attempt to thrive upon the goodwill and reputation of the plaintiff.”

para 19:

“19. That this Hon'ble Court has jurisdiction to entertain and try the present suit against the defendants as they are carrying on illegal trade activities clandestinely at various places including Delhi. The plaintiff came to know about the illegal trade activities of the defendant at the Delhi from the Trade Mark Journal, within the jurisdiction of this Hon'ble Court. The plaintiff is also carrying on business from Delhi for their good bearing trade mark Aadhar Shree (label) from Delhi. The plaintiff also invokes jurisdiction as per Section 134 (2) of the Trade Mark Act, 1999, which gives the plaintiff cause of action to file the present suit at Delhi on the basis of their business office at Delhi.”

12. The documents accompanying the suit include Registration Certificates of the Plaintiff's trademark, photographs of mark and packaging of Plaintiff and Defendant, copy of Sales Figures, copies of Income Tax Returns, advertisements of the Plaintiff's products featuring the Plaintiff's mark in newspapers of Delhi etc. The additional representation annexed to the certificate of registration of trademark (Ex. PW-1/1) mentions the address for services of the Plaintiff's office at Delhi. However, in the Certificate of Registration, the principal place of business, is mentioned as Bikaner, Rajasthan. All the Sales Invoices of the Plaintiff also mention the address as Bikaner, Rajasthan. The advertisements in newspapers of the Plaintiff's business also showcase the place of business to be in Bikaner, Rajasthan. From the above, it manifests that plaintiff's place of business in Delhi is

only a additional business location or a branch/subordinate office. No documentary evidence has been placed on record to show that Defendant's infringing trademark is being used within the jurisdiction of this Court, i.e. in Delhi. The cause of action in Delhi is alleged only on the basis of an advertisement in the Trademark Journal No. 1412 dated 16th March 2009, of the Defendant's proposed to be used mark, AADHAR SHILA.

13. On this issue, Parties have led evidence. Plaintiff's affidavit by way of examination in chief states as under:

"The plaintiff is carrying on the business of the aforesaid goods from Delhi and Rajasthan and have several stockiest/distributors at various other places.

That the goods of the plaintiff are sold under trade mark AADHAR SHREE (LABEL) are also available in almost all the states of India like Delhi, Haryana, Punjab, Rajasthan, U.P., Maharashtra. Gujarat, Southern States, Uttaranchal, M.P.etc. "

14. During cross examination, he deposed as under:

"I have filed my partnership deed to show that I am having business in Delhi also and the sales tax number of Delhi. It is correct that no such partnership deed is on record.

.....

It is wrong to suggest that I have filed this case in Delhi in order to harass the defendant. I am manufacturing plaster of paris exclusively in Rajasthan but the same is supplied in Delhi, Rajasthan, Punjab, Haryana, U.P., Himachal Pradesh and Uttrakhand. I have filed invoices of UP, Haryana, Chandigarh. It is correct that I have not filed invoice of Delhi."

15. The stand of the Defendant in the written statement on the question of jurisdiction is as under:

“The answering defendant has a preliminary objection that this Hon'ble High Court lacks territorial jurisdiction in the present suit and thus the suit is not maintainable. Both the plaintiff as well as the defendant, their registered office at Rajasthan and manufacture and carry on business outside the jurisdiction of this court. The mere fact that a business office of the plaintiff situated at Delhi does not confer territorial jurisdiction on this Hon'ble Court.

There is no documentary evidence filed by the plaintiff to even prima facie establish that the product of answering defendant on the date of filing of the suit was available within the jurisdiction of this Hon'ble Court or even the plaintiff has not averred or produced any document as to how the product of answering defendant including the packaging has been procured in Delhi.

That the suit is to be filed either in the place where the defendant resides or carries on business or the place where the cause of action arises. Since the answering defendant resides at Rajasthan and carries on business from Rajasthan only and even supplies the goods at Rajasthan.”

16. The Defendant in the examination-in-chief stated on similar lines. He deposed that the firm was established and is engaged in the business of manufacturing, wholesale and retail at Rajasthan. The goods/products have never been sold within the jurisdiction of this Court and the sale of goods was only in Rajasthan or by way of inter-state sales in other states. In the cross examination, Plaintiff has not put any question that could contradict the statement made in the examination in chief, by way of affidavit.

Judgments on Jurisdiction

17. The question of jurisdiction has been subject matter of several decisions of this Court as well as the Supreme Court and it can now be said that the law relating to jurisdiction is no longer *res integra*. It would be apt to note few landmark judgments on this issue. The Supreme court in ***Indian Performing Rights Society v Sanjay Dalia (2015) 10 SCC 161*** has held as under:

“18. In our opinion, in a case where cause of action has arisen at a place where the Plaintiff is residing or where there are more than one such persons, any of them actually or voluntarily resides or carries on business or personally works for gain would oust the jurisdiction of other place where the cause of action has not arisen though at such a place, by virtue of having subordinate office, the Plaintiff instituting a suit or other proceedings might be carrying on business or personally works for gain.

20. There is no doubt about it that the words used in Section 62 of the Copyright Act and Section 134 of the Trade Marks Act, 'notwithstanding anything contained in Code of Civil Procedure or any other law for the time being in force', emphasise that the requirement of Section 20 of the Code of Civil Procedure would not have to be complied with by the Plaintiff if he resides or carries on business in the local limits of the court where he has filed the suit but, in our view, at the same time, as the provision providing for an additional forum, cannot be interpreted in the manner that it has authorised the Plaintiff to institute a suit at a different place other than the place where he is ordinarily residing or having principal office and incidentally where the cause of action wholly or in part has also arisen. The impugned judgments, in our considered view, do not take away the additional forum and fundamental basis of conferring the right and advantage to the authors of the Copyright Act and the Trade Marks Act provided under the aforesaid provisions.

23.The Legislature has never intended that the Plaintiff should not institute the suit where he ordinarily resides or at its

Head Office or registered office or where he otherwise carries on business or personally works for gain where the cause of action too has arisen and should drag the Defendant to a subordinate office or other place of business which is at a far distant place under the guise of the fact that the Plaintiff /corporation is carrying on business through branch or otherwise at such other place also. If such an interpretation is permitted, as rightly submitted on behalf of the Respondents, the abuse of the provision will take place. Corporations and big conglomerates etc. might be having several subordinate offices throughout the country. Interpretation otherwise would permit them to institute infringement proceedings at a far flung place and at unconnected place as compared to a place where Plaintiff is carrying on their business, and at such place, cause of action too has arisen. In the instant cases, the principal place of business is, admittedly, in Mumbai and the cause of action has also arisen in Mumbai. Thus, the provisions of Section 62 of the Copyright Act and Section 134 of the Trade Marks Act cannot be interpreted in a manner so as to confer jurisdiction on the Delhi court in the aforesaid circumstances to entertain such suits. The Delhi court would have no territorial jurisdiction to entertain it.

24. The avoidance of counter mischief to the Defendant is also necessary while giving the remedy to the Plaintiff under the provisions in question. It was never visualised by the law makers that both the parties would be made to travel to a distant place in spite of the fact that the Plaintiff has a remedy of suing at the place where the cause of action has arisen where he is having head office/carrying on business etc. The provisions of the Copyright Act and the Trade Marks Act provide for the authors/trade marks holders to sue at their ordinary residence or where they carry on their business. The said provisions of law never intended to be oppressive to the Defendant. The Parliamentary Debate quoted above has to be understood in the manner that suit can be filed where the Plaintiff ordinarily resides or carries on business or personally works for gain. Discussion was to provide remedy to Plaintiff at convenient

place; he is not to travel away. Debate was not to enable Plaintiff to take Defendant to farther place, leaving behind his place of residence/business etc. The right to remedy given is not unbridled and is subject to the prevention of abuse of the aforesaid provisions, as discussed above. Parliament never intended that the subject provisions to be abused by the Plaintiff by instituting suit in wholly unconnected jurisdiction. In the instant cases, as the principal place of business is at Mumbai the cause of action is also at Mumbai but still the place for suing has been chosen at Delhi. There may be a case where Plaintiff is carrying on the business at Mumbai and cause of action has arisen in Mumbai. Plaintiff is having branch offices at Kanyakumari and also at Port Blair, if interpretation suggested by Appellants is acceptable, mischief may be caused by such Plaintiff to drag a Defendant to Port Blair or Kanyakumari. The provisions cannot be interpreted in the said manner devoid of the object of the Act.”

18. This Court in ***Ultra Home Constructions v Purushottam Kumar Chaubey*** 227 (2016) DLT 320, also had the occasion to deal with the question of jurisdiction. Taking note of the ratio of the judgment of the Supreme Court in ***IPRS v Sanjay Dalia*** (*supra*), the division bench of the court summarized the law as under:

“13. It is evident from the above observations that the interpretation given to the expression "carries on business" in the context of a defendant under section 20 of the Code has also been employed in the context of a plaintiff under the said sections 134(2) and 62(2). Thus, in addition to the places where suits could be filed under section 20 of the Code, the plaintiff can also institute a suit under the Trade Marks Act, 1999 and the Copyright Act, 1957, as the case may be, by taking advantage of the provisions of section 134(2) or section 62(2), respectively. Both the latter provisions are in pari materia. Under these provisions four situations can be contemplated in the context of the plaintiff being a corporation (which includes a company). First of all, is the case where the

plaintiff has a sole office. In such a case, even if the cause of action has arisen at a different place, the plaintiff can institute a suit at the place of the sole office. Next is the case where the plaintiff has a principal office at one place and a subordinate or branch office at another place and the cause of action has arisen at the place of the principal office. In such a case, the plaintiff may sue at the place of the principal office but cannot sue at the place of the subordinate office. The third case is where the plaintiff has a principal office at one place and the cause of action has arisen at the place where its subordinate office is located. In this eventuality, the plaintiff would be deemed to carry on business at the place of his subordinate office and not at the place of the principal office. Thus, the plaintiff could sue at the place of the subordinate office and cannot sue (under the scheme of the provisions of section 134(2) and 62(2)) at the place of the principal office. The fourth case is where the cause of action neither arises at the place of the principal office nor at the place of the subordinate office but at some other place. In this case, the plaintiff would be deemed to carry on business at the place of its principal office and not at the place of the subordinate office. And, consequently, it could institute a suit at the place of its principal office but not at the place of its subordinate office. All these four cases are set out in the table below for greater clarity:

S.No.	Place of Plaintiff's Principal Office (Sole office in s.no.1)	Place of Plaintiff's Subordinate /Branch Office	Place where cause of action arose	Place where Plaintiff can additionally sue under section 134(2) and section 62(2)
1	A	--	C	A
2	A	B	A	A
3	A	B	B	B
4	A	B	C	A

19. In a suit relating to the infringement of trademark, the Plaintiff can sue as per section 134 (2) of the Act in addition to the provisions relating to jurisdiction under CPC, 1908. As per section 134(2) of the Act, the residence or the place of business of the Plaintiff becomes an essential factor to determine the question of jurisdiction. In case the Plaintiff is carrying on business or personally works for gain at multiple locations, then if the Court's jurisdiction is invoked by virtue of having subordinate/ branch office, the Plaintiff would also have to show that cause of action for the suit has also arisen at such a place (Ref: See Serial No. 3 of the Table above). Plaintiff is entitled to institute a suit at a place other than where he ordinarily resides or has its principal office, however for that the Plaintiff should be in a position to show that there is a branch/subordinate office and cause of action has also arisen within the jurisdiction of that Court.

20. The term "cause of action" has also been lucidly explained in ***Indian Performing Rights***(supra) in the following words:

"15. Accrual of cause of action is a sine qua non for a suit to be filed. Cause of action is a bundle of facts which is required to be proved to grant relief to the Plaintiff. Cause of action not only refers to the infringement but also the material facts on which right is founded. Section 20 of the Code of Civil Procedure recognises the territorial jurisdiction of the courts inter alia where the cause of action wholly or in part arises. It has to be decided in each case whether cause of action wholly or in part arises at a particular place. As held by this Court in Rajasthan High Court Advocates Association v. Union of India and Ors. [MANU/SC/0827/2000: AIR 2001 SC 416]. Thus, a Plaintiff can also file a suit where the cause of action wholly or in part arises."

21. Bearing in mind the aforesaid principles of law relating to territorial jurisdiction of the Court as laid down by the Supreme Court, we now proceed to discuss the facts and the evidence brought on record relating to the question of jurisdiction. From the evidence brought on record, as noted in preceding paragraphs, it emerges that the Plaintiff has its principal place of business at Rajasthan. As a proprietor of the registered trademark, he has invoked the jurisdiction of this Court for the infringement on the basis of carrying on business in Delhi. Although the Plaintiff satisfies the test of having a subordinate office in Delhi, however it has miserably failed to show that any cause of action has arisen within the jurisdiction of this Court. The pleadings and the evidence brought on record show that the cause of action has arisen at the Plaintiff's principal place of business i.e. at Rajasthan. Plaintiff in his cross examination has admitted that Plaintiff is manufacturing the goods (Plaster of Paris) exclusively in Rajasthan. Although the witness states that the goods are being supplied in Delhi, however he also admitted that he has not filed any invoice pertaining to Delhi. The witness further admitted that Plaintiff was not supplying goods in Delhi and the sale was through dealer network. The Plaintiff has also not been able to show any document which would indicate that the Defendant is infringing the Plaintiff's mark within the jurisdiction of this Court. When the Defendant resolutely deposed that he is not selling any goods in Delhi, Plaintiff did not contradict or disprove his statement with any material or document. The suit was filed in 2009. Till date, Plaintiff has not been able to show any documentary evidence that would prove that Defendant's infringing activity was felt in Delhi. Thus, no cause of action has arisen within the jurisdiction of this Court. In the absence of any cause of

action, Defendant cannot claim territorial jurisdiction based solely on the basis of the branch/subordinate office in Delhi.

22. The Issue No.1 is decided against the Plaintiff and in favour of the defendant.

Remaining Issues

23. The present suit was filed in 2009 and since then the suit has been pending. The issue of territorial jurisdiction was not taken up as a preliminary issue, perhaps for the reason that the issue of jurisdiction in the present case is a mixed question of fact and law. Be that as it may, as Issue No.1 was not taken up as a preliminary issue, trial was conducted and concluded. Thus although the court has concluded that it has no jurisdiction to entertain the present suit, but having regard to the mandate of Order 14 Rule 2 read with Order 20 Rule 5, the court deems it appropriate to deal with the remaining issues for the sake of completeness of things. This is also necessary as the order passed by this court is subject to appeal. Should the Appellate court not agree with the findings of this court on Issue No.1, there will be a fresh round of hearing in this suit. Deferring the decision on the remaining issues thus would not be appropriate.

Issue Nos. 5

24. Defendant claims that it is using the trademark 'AADHAR SHILA' since 2005, prior to Plaintiff's use of 'AADHAR SHREE'. The issue of prior use is interlinked and would have bearing on the question in infringement of Plaintiff registered trademark 'AADHAR SHREE'. Hence, Issue No. 5 is being taken up first. Plaintiff has adopted the trademark 'AADHAR

SHREE' as a label mark in Class 19 as of 3rd May 2005 (the date of use claimed by the Plaintiff). The Defendant claims that he has been manufacturing and marketing its goods under the trademark 'AADHAR SHILA' since 2005 for the goods specified in Class 19 of the Trademark Act. In support of this contention, it has been pleaded that the Certificate of Registration of the Defendant on 07.05.2005 issued under the Central Sales Tax Act 1956, ante dates Plaintiff's registration on 2nd August 2005. Additionally, the Defendant has relied upon certain invoices for the period between 21st April 2005 to 30th July 2005.

25. The aforesaid documents do not in any way prove the use of the trademark 'AADHAR SHILA' prior to Plaintiff's use of the trademark 'AADHAR SHREE'. Defendant's Sales Tax Registration Certificate may be prior in time, but the same do not in any way prove the use of the mark in relation to the goods under consideration. Defendant also produced two witnesses, DW-2-Manoj Kumar Bansal (proprietor of Bansal Paints and Hardware Stores) and DW-3, Sh. Subhash Chand (as proprietor of Subhash Chand Sushil Kumar). Both the witnesses, by way of examination-in-chief stated that AADHAR SHILA POP has been supplied by the Defendant since April 2005 for further selling the same in the market.

26. However, the said two witnesses during the course of the cross-examination, admitted that there was no document to prove that the supplies of AADHAR SHILA POP were indeed made by the Defendant. The said witnesses also stated that their statement was on the basis of the bills that were issued to them. They further deposed that they have not produced any invoices in support of their statement. The bills in question which form the

basis of the testimony of the two witnesses have been exhibited by the Defendant as Ex. DW-1/4. The said bills have been issued by 'Jai Shiv Shanker Mineral Industries' to several parties including M/S Bansal Paints and Hardware Store and M/s Subhash Chand Sushil Kumar. However, the said bills do not show the use of the trademark 'AADHAR SHILA' and are thus of no avail to the Defendant to prove prior use of the mark. Moreover, the Defendant admits that he applied for the registration of the trademark 'AADHAR SHILA (label)' on 6th February 2008 and the same was advertised in the Trademark Journal dated 16th March 2009. The application of the Defendant Ex. P-3 also mentions that the trademark is 'proposed to be used'. The Defendant, therefore, has not brought any evidence on record to show that they were using the trademark 'AADHAR SHILA' prior to Plaintiff's use of the trademark 'AADHAR SHREE'.

27. On the other hand, Plaintiff has proved the registration certificate of its trademark as Ex. PW1/1. He has also proved other pending applications of the Plaintiff which were subsequently verified by the Official of Trademark Registry and the same has been exhibited as PW 1/2 to PW 1/9. Plaintiff has also produced on record photographs of the Plaintiff's trademark in piecemeal at various places. The same have been marked as Mark-G. The advertisement material of the Plaintiff's trademark in magazines/newspapers is marked as Mark-H. The copies of the Sale/Invoices of the Plaintiff are marked as Mark-I (Colly.). Plaintiff has deposed that he is the original adopter and registered proprietor of the trademark 'AADHAR SHREE (label)' and the goods have been extensively sold and advertised in the entire country. Plaintiff has also given details of the year wise sales of its

products. He has further deposed that Plaintiff's adoption and extensive use and promotion of the trademark has resulted in the general public identifying the trademark exclusively with the Plaintiff. The cross examination of the Plaintiff has been centered around the Plaintiff not being the prior user of the mark. He has also been cross examined on the question of cause of action not having occurred in Delhi. There has however been no attempt to discredit his statement regarding the use of the trademark 'AADHAR SHREE' continuously from 2005 onwards. It is therefore clear from the deposition of the Plaintiff and the other documentary evidence placed on record that Plaintiff has been continuously using the trademark 'AADHAR SHREE' since 2005. On the other hand, Defendant is unable to prove his prior use of the trademark 'AADHAR SHILA'. The Issue No. 5 is thus decided against the Defendant and in favour of the Plaintiff.

Issue No.2

28. Section 29 of the Trademarks Act defines as to what would constitute an infringement of a registered trademark. The same reads as under:-

“29. Infringement of registered trade marks.—

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of

permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(c) imports or exports goods under the mark; or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.”

29. In order to determine whether the Plaintiff's right in the registered trademark is being infringed, the Court would have to examine whether the Defendant's mark is identical with or deceptively similar to Plaintiff's trademark in relation to goods or services in respect of which the trademark

is registered. The test is to compare the two marks. The Plaintiff's registered trademark is a label mark. The Defendant is using the mark 'AADHAR SHILA' on the goods, in the form of a label. The two marks are as under:-



The trademarks are affixed on the packaging as under:-



30. The comparison of the two marks as a whole shows stark similarities. The essential features of the Plaintiff's Label mark are the words 'AADHAR' and 'SHREE'. The Defendants have completely copied the word 'AADHAR' and has replaced the suffix 'SHREE' with the word 'SHILA'. The placement of the word 'AADHAR' in the Plaintiff's mark is at the top and SHREE is at the bottom. Defendant's placement of the words is also identical. The font type and size used in the two marks is also strikingly similar. Both the suffixes (second words) start with letters "SH" and are phonetically similar. The packaging used by both the Plaintiffs and the Defendants uses the words 'Plaster of Paris' placed immediately below the words "AADHAR SHREE" and 'AADHAR SHILA'. It is noticed that the colour scheme of the two marks is also similar being a combination of blue and red. Pertinently and significantly, both Plaintiff and Defendant are in the same business and the use of the mark by the Defendant is in relation to the same goods for which the Plaintiffs mark has been registered i.e. Plaster of Paris (one of the items defined in Class 19).

31. The true test for determining the question of deceptive similarity mark is to look at the two marks in totality and then proceed to analyze whether the same is likely to cause deception or confusion or mistake in the minds of the intending purchaser. The overall similarity of the most essential feature of the Plaintiff's mark being 'AADHAR SHREE' and 'AADHAR SHILA', is conspicuous. The words 'SHREE' and 'SHILA', by themselves are not decisive of the matter. The critical comparison of the two suffixes SHREE and SHILA may bring out certain differences, however, the test to be applied here is one that has been aptly defined by the Supreme Court in a

series of judgments such as ***Corn Products Refining Company v. Shangrila Food Products Limited*** AIR 1960 SC 142, the relevant portion thereof reads as under:-

“19. We think that the view taken by Desai, J., is right. It is well known that the question whether the two marks are likely to give rise to confusion or not is a question of first impression. It is for the court to decide that question. English cases proceeding on the English way of pronouncing an English word by Englishmen, which it may be stated is not always the same, may not be of much assistance in our country in deciding questions of phonetic similarity. It cannot be overlooked that the word is an English word which to the mass of the Indian people is a foreign word. It is well recognised that in deciding a question of similarity between two marks, the marks have to be considered as a whole. So considered, we are inclined to agree with Desai, J., that the marks with which this case is concerned are similar. Apart from the syllable 'co' in the appellant's mark, the two marks are identical. That syllable is not in our opinion such as would enable the buyers in our country to distinguish the one mark from the other.

20. We also agree with Desai, J., that the idea of the two marks is the same. The marks convey the ideas of glucose and life giving properties of vitamins. The Aquamatic case (Harry Reynolds v. Laffeaty's Ld.) 1958 R.P.C. 387, is a recent case where the test of the commonness of the idea between two marks was applied in deciding the question of similarity between them. Again, in deciding the question of similarity between the two marks we have to approach it from the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonable likely to cause a confusion between them.

22. It is true that in both the above-mentioned cases the two competing trade marks were absolutely identical which is not the case here. But that in our opinion makes no difference. The absolute identity of the two competing marks or their close resemblance is only one of the tests for determining the question of likelihood of deception or confusion. Trade connection between different goods is another such test. Ex hypothesi, this latter test applies only when the goods are different. These tests are independent tests. There is no reason why the test of trade connection between different goods should not apply where the competing marks closely resemble each other just as much as it applies, as held in the "Black Magic" and "Panda" cases, where the competing marks were identical. Whether by applying these tests in a particular case the conclusion that there is likelihood of deception or confusion should be arrived at would depend on all the facts of the case."

32. Similar views were already expressed by the Supreme Court in **James Chadwick & Bros. Ltd. v National Sewing Thread Company Ltd AIR 1951 Bom 147** in an *obiter dicta*:

"The real question is as to how a purchaser, who must be looked upon as an average man of ordinary intelligence, would re-act to a particular trade mark, what association he would form by looking at the trade mark, & in what respect he would connect the trade mark with the good which he would be purchasing, It is impossible to accept that a man looking at a trade mark would take in every single feature of the trade mark. The question would be, what would be normally retain in His mind after looking at the trade mark? What would be the salient feature of the trade mark which in future would lead him to associate the particular goods with that trade mark? In this case, fortunately, we have no difficulty in deciding what is the distinguishing or essential feature of the trade mark of the appellants As we said before, it is on record that the goods sold under this trade mark are well known and commonly asked for as 'Eagley' or 'Eagle' & therefore the particular feature of the trade mark of the appellants by which the goods are identified & which is associated in the mind of the

purchaser is the representation of the Eagle appearing in the trade mark. Therefore the very narrow question which arises in this appeal is whether the trade mark sought to be registered by the respondents does contain a similar or identical distinguishing or essential feature. If it does, if the trade mark conveys the idea of an Eagle & if an unwary purchaser is likely to accept the goods of the respondents as answering the requisition for Eagle goods, then undoubtedly the trade mark of the respondents is one which would be likely to deceive or cause confusion.

11. The learned Judge below in a very careful judgment has meticulously examined the points of similarity & dissimilarity between the trade mark of the appellants & the trade mark of the respondents, & he has come to the conclusion that the points of difference are so numerous & the points of similarity so few that in his view there was no such resemblance as was likely to cause confusion. With very great respect, in our opinion, that was not the correct approach to the matter. What the learned Judge should have done was not to keep these two trade marks before him & to find out how they differ & how little they resemble; what he should have done was to decide for himself what was the distinguishing or essential feature of the appellants' trade mark, & then, looking at the trade mark of the respondents, to ask himself whether there was any resemblance in the trade mark of the respondents to that distinguishing or essential feature. It is true, as pointed out by the learned Judge, that the bird appearing in the respondents' trade mark is different in its posture, in its poise, in the position of its head, & in the spreading of its wings from the bird that appears in the trade mark of the appellants. But that is hardly the question. The question is whether the bird in the respondents' trade mark is likely to be mistaken by an average man of ordinary intelligence as an Eagle, & as we said before, whether, if he asked for Eagle goods & he got goods bearing this trade mark of the respondents, he would reject them saying, "This cannot be an Eagle; I asked for Eagle goods & the bird I see before me is anything but an Eagle." The learned Judge has very frankly stated in his judgment that he is not an ornithologist. My claims to be considered that are even

more slender, & I have no pretensions whatever of being able to distinguish an Eagle from a bird which is not an Eagle or indeed one bird from another. But in this case, fortunately, it is not necessary to give a judicial pronouncement as to whether the bird appearing in the respondents' trade mark is or is not an Eagle, because the pronouncement has been given by the respondents themselves, & no pronouncement can be more weighty than the pronouncement of the party who applies for the trade mark.....

13. Reliance was also placed on June's case Seville Perfumery Ltd. v. June Perfect Ltd. and F. W. Woolworth & Co. Ltd. (1941) 58 R. P. C. 147. In that case the distinguishing feature of the registered trade mark & the proposed trade mark was the word "June," & the Master of the Rolls in his judgment at p. 162 observes :

"Now the question of resemblance & the likelihood of deception are to be considered by reference not only to the whole mark, but also to its distinguishing or essential features, if any."

The learned Master of the Rolls also says that (p. 162):

"In such cases the mark comes to be remembered by some feature in it which strikes the eye & fixes itself in the recollection. Such a feature is referred to sometimes as the distinguishing feature, sometimes as the essential feature, of the mark."

Therefore the test we must apply in this case is, what is the feature in the appellants' trade mark which strikes the eye & fixes itself in the recollection, & the only answer to this question is that it is the Eagle which so strikes the eye & fixes itself in the recollection. Then we have the case of C. F. G. E. (In the matter of the Application of the Chemische Fabrik GreisheimElektron for Registration of a Trade Mark) (1910) 27 R. P. C. 201 & this case was cited before us by the Advocate-General in order to draw our attention to the considerable dissimilarity between the proposed & the registered trade mark, The reason why registration was refused to the proposed trade mark was that the registered trade

mark was a representation of primitive Eastern Dye Works & the same idea was conveyed by the proposed trade mark. It was urged before Neville J. that one trade mark was a representation of Japanese Dye Works & the other was Chinese. That argument did not find favour with the learned Judge & he answered it by saying that if orders were sent from the East to agents of either of these firms & they were told to send goods which had obtained popularity in the market by the trade mark representing Eastern Dye Works, goods bearing either trademark would have answered to the requisition, & the main ground on which the learned Judge refused registration was that the main feature of both the pictures was identical, & according to the learned Judge that concluded the question. Our attention has also been drawn to one case of an Elephant Trade Mark in Upper Assam Tea Co. v. Herbert & Co. (1889) 7 R. P. C. 188 where from the trade marks printed in the report it is clear that the two elephants in the two trade marks look entirely different judging by the way they are represented, & yet, because the goods had been associated with the name of the elephant, injunction was granted to restrain the deft, who also wanted his goods to be sold under a trade mark, the main feature of which was an elephant. There is another case (In the Matter of Farrow's Trade Mark (1890) 7 R. P. C 260 where we have trade marks of two buffaloes which look entirely dissimilar, & yet, again, as the goods had come to be associated with the buffalo, registration was refused to the subsequent applicant. There is another case also laying down the same principle in In the Matter of the Application of Pomril, Ltd. (1901) 18 R. P. C. 181, where the goods in question were cider & the proposed trade mark had the name 'Pormil' written on half an apple & the opposition came from sellers of cider who had their trade mark also containing an apple with the name "Apple Brand." In one case the name was "Pomril" & in the other case the name was "Apple Brand." Still registration was refused as the apple was considered to be the distinguishing & essential feature."

33. A reading of the aforementioned cases shows that the test applicable for determining the question of confusion between the disputed marks, would always require evaluation and comparison of the essential features of the

marks. In the present case there is an overall similarity and resemblance of the two marks. This aspect has to be scrutinized from the point of view of a purchaser of average intelligence and imperfect recollection and ignorant, thoughtless and incautious purchaser (*Kaviraj Pandit Durga Datt Sharma v Navratna Pharmaceutical Laboratories AIR 1965 SC 980*). The overall similarity of the combination words 'AADHAR SHREE' and 'AADHAR SHILA', and having regard to the circumstance that the goods bearing the said names are building material, persuades this Court to hold that the Defendant's use of the mark is deceptively similar to the Plaintiff's registered trademark and there is a reasonable probability of deception or confusion in the eyes of general public.

34. The Defendant's counsel argued that AADHAR and SHREE are the common words in Hindi language. Words of common language like 'AADHAR' and 'SHREE' cannot be made the monopoly of any individual. It was argued that the word 'AADHAR SHILA' is a generic term and the Plaintiff cannot claim exclusivity in respect of the word which are *publici juris* and descriptive of the generic substance. Reliance was placed on *Institute for Inner Studies v Charlotte Anderson 2014 SCC OnLine Del 136*. It was also argued that the whole phrase 'AADHAR SHREE' has been registered and the claim has to be to the use of the whole word and not part thereof. The marks should be compared as a whole and it is not correct to take a portion of the word and make the comparison. The Defendant also relied upon the judgment of the Supreme Court in *Cadila Health Care Ltd. V Cadila Pharmaceuticals Ltd AIR 2001 SC 1952*.

35. Per-contra, learned counsel for the Plaintiff relying upon the judgment of the Supreme Court in ***Cadila Health Care*** (supra) argued that the present case is for the enforcement of rights of a proprietor of the registered trademark. In an action based on a registered trademark, in order to determine the question of infringement, the Plaintiff is required to establish that the infringing mark merely resembles the Plaintiff's word, either visually or phonetically or to others and that is likely to deceive or cause confusion in relation to the goods in respect of which the Plaintiff got his mark registered. If the essential features of the Plaintiff's trademark had been adopted, the fact that there are some additional features in the Defendant's mark which show marked differences is immaterial. It was further argued that the comparison of the two marks leaves no room for doubt that the essential feature of the Plaintiff's mark is the combination of two words i.e. AADHAR and SHREE and that the Defendant has adopted this essential feature. The Plaintiff has relied upon several judgments being ***Amritdhara Pharmacy v Satya Deo Gupta*** AIR 1963 SC 449, ***Kaviraj Pandit Durga Datt Sharma v Navratna Pharmaceutical Laboratories*** AIR 1965 SC 980, ***Ruston and Hornby Ltd. V Zamindara Engineering Co.*** AIR 1970 SC 1649, ***Parle Products (P) Ltd. V J.P. & Co.*** AIR 1972 SC 1359, ***Cadila Health Care Ltd. V Cadila Pharmaceuticals Ltd*** AIR 2001 SC 1952, ***Amar Singh Chawal Wala v Shree Vardhman Rice and General Mills*** 2009 (40) PTC 417 (DB), ***Kirorimal Kashiram Mktg. & Agencies Pvt. Ltd. v Shree Sita Chawal Udyog Mill TollyVill*** 2010 (44) PTC 293 (Del) (DB).

36. The court agrees with the Plaintiff's submission. In an action for infringement of the registered trademark, proprietor's statutory rights to the

mark are required to be protected. In an infringement suit, the court would have to examine if the essential features of the trademark of the Plaintiff have been adopted by the Defendant. Trivial or insignificant differences would be immaterial. This aspect has been lucidly clarified in **Kaviraj Pandit** (supra) in the following words:-

“28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under s. 21 in respect of a registered trade mark and also of a passing off by the use of the same make. The finding in favour of the appellant to which the learned Counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in their colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy in the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the

vindication of the exclusive right to the use of the trade mark in relation to those goods (Vide s. 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable limitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that use of the defendant's mark is likely to deceive, but were the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an limitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the make would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.

29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered (Vide s. 21). A

point has sometimes been raised as to whether the words "or cause confusion" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks-the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant. The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff.

30. The mark of the respondent which he claims has been infringed by the appellant is the mark 'Navaratna Pharmaceutical Laboratories', and the mark of the appellant which the respondent claimed was a colourable imitation of that mark is 'Navaratna Pharmacy'. Mr. Agarwala here again stressed the fact that the 'Navaratna' which constituted an essential part of feature of the Registered Trade Mark was a descriptive word in common use and that if the use of this word in the appellant's mark were disregarded, there would not be enough material left for holding that the appellant had used a trade mark which was deceptively

similar to that of the respondent. But this proceeds, in our opinion, on ignoring that the appellant is not, as we have explained earlier, entitled to insist on a disclaimer in regard to that word by the respondent. In these circumstances, the trade mark to be compared with that used by the appellant is the entire registered mark including the word 'Navaratna'. Even otherwise, as stated in a slightly different context : (Kerly on Trade Marks 8th Edn. 407)

"Where common marks are included in the trade marks to be compared or in one or in one of them, the proper course is to look at the marks as wholes and not to disregard the parts which are common"."

37. As discussed above, the noticeable differences in the Defendant's mark 'AADHAR SHILA', are unimportant and would still cause confusion or deception on account of the similarities of the mark. Similar views have been expressed by the Supreme Court in **Parle Products (supra)**.

38. The judgments relied upon by the defendant, on the question of infringement, are not applicable to the facts of the present case. As discussed above, each case has to be examined on its merit. The judgements relied upon by the Defendants are relevant to the facts of the said cases. The ratio of the judgments is what has been discussed above. In **J.K. Oil Industries v Adani Wilmar Limited MANU/DE/0332/2010**, the marks under consideration were 'KING' (label) and 'OIL KING' (label). It was considered therein that the font of the word 'OIL KING' on the plaintiff's trademark (label) is different from that of the defendant's mark. However, in the present case, as noted above, even the font and writing style of the plaintiff's mark and the impugned mark is the same. Similarly, in **Rich Products Corporation v Indo Nippon Food 2010 (42) PTC 660 (Del)**, the marks 'RICH'S WHIP TOPPING' for non-dairy topping and 'BELLS

WHIP TOPPING' for dessert sauces, custard etc were under contention. In ***Bhavnesb Mohanlal Amin v Nirma Chemicals Works*** MANU/SC/1590/2005, the similarity between the marks, 'NIMA' and 'NIRMA' had to be looked into. However, it was held therein that "we find it would not be proper to go into the legal position to be applied to the factual background in detail". The said decision also, therefore, does not come to the aid of the Defendant. In ***Cadila Healthcare Limited v Dabur India Limited*** MANU/DE/0972/2008, the defendant was manufacturing and marketing "CHYAWANPRAKASH" with the expression "SUGAR FREE", where, 'SUGAR FREE' had been registered as a mark of the plaintiff. Thus, the facts of the cases relied upon by the Defendant are significantly distinguishable from the facts of the present case.

39. The contention of the Defendant that the words AADHAR and SHREE are generic and descriptive of the trade is also untenable. This Court in a similar situation in ***H&M Hennes & Mauritz AB v HM Megabrand Pvt. Ltd.*** 251 (2018) DLT 651 relying upon the judgments of the Division bench of this court observed as under:

"23. A Division Bench of this Court in S.B.L. Limited v. The Himalaya Drug Co. ILR MANU/DE/0311/1997 : 1997 (2) Delhi 168 was concerned with the question whether 'LIV-T' is deceptively similar with the mark 'Liv.52'. After discussing a large number of judgments, it was held that though nobody can claim exclusive right to use any word, abbreviation, or acronym which becomes publici juris and the question whether such feature is publici juris or generic is a question of fact but if the two trade marks by two competing traders use a generic word or an expression publici juris common to both the trade marks, it has to be seen if the customers who purchase the goods would be guided by the use of such word/expression or would ignore it and give

emphasis to prefixes or suffixes or words used in association therewith. It was further held that the primary question to be asked is, what would remain in the memory of customers.”

40. Pertinently, the Defendant himself has applied for the registration of the label mark using the word AADHAR and SHILA. Thus, the Defendant cannot take such a plea that the words 'AADHAR SHREE' in the labeled mark were incapable of being registered. The word AADHAR in Hindi means “backbone”, “basis” or “foundation”. The said word, in relation to the goods in question, cannot be said to be descriptive. It could at best be said to be suggestive of the trade.

41. In view of the above discussion, Issue No. 2 is decided in favour of the Plaintiff and against the Defendant.

Issue No. 3

42. In view of the findings and conclusions, on Issue No. 2, holding that the Defendant has infringed the rights of the Plaintiff under the registered trademark, the Plaintiff is entitled to the injunction as prayed for and the issue is decided in favour of the Plaintiff and against the Defendant.

Issue No. 4

43. Plaintiff has not led any evidence to prove damages. There is no material on record to show that there has been loss of reputation and the goodwill of the Plaintiff. The Damages have to be proved by the party asserting loss and the same is *sine qua non* for award of damages (*Microsoft Corporation v K. Mayuri* (2007) 143 DLT 16)).

44. Further, the Plaintiff has not led any evidence regarding the extent of

sales made by the Defendant. There is no evidence on record in this case to show that the Defendant made any profit after it was subjected to notice by the Plaintiff that it was violating its (Plaintiff's) trade mark. The Plaintiff is required to establish that the defendant made profits knowing that he was transgressing the Plaintiff's right.

45. Accordingly, in absence of loss being proved or profits proved to be gained by the Defendant, this issue is decided against the Plaintiff and in favour of the Defendant.

Issue No. 6 (Relief)

46. In view of the finding given on Issue No. 1 holding that the Court does not have the territorial jurisdiction, this Court is not in a position to grant any relief to the Plaintiff. The question of territorial jurisdiction was not decided as a preliminary issue. The parties have led evidence and it has now been discovered that the Court has no jurisdiction. Thus, at this stage, it is not considered appropriate to return the plaint for presentation to the Court of competent jurisdiction and instead, the suit is dismissed on the ground that this Court has no jurisdiction to try and entertain the present suit.

47. In the facts and circumstances of the case, no cost.

April 29, 2019
nk/ss

SANJEEV NARULA, J.