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

Date of Decision: 3rd April, 2019

+ **CS (COMM) 467/2018**

INTEL CORP.

..... Plaintiff

Through: Mr. Ranjan Narula, Mr. Himani
Makkad and Ms. Payal Kalhan,
Advocates. (M:9717517630)

versus

C. L. DHINGRA AND ORS.

..... Defendants

Through: Mr. Gaurav Miglani and Mr. Anand
Raj, Advocates. (M:9871304455)

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. The present suit is listed before the Court after conclusion of evidence. Matter has been heard on behalf of both the counsels. The present suit for permanent injunction restraining infringement of trademark, passing off, damages, rendition of accounts, etc., has been filed by the Plaintiff seeking protection of the mark '*INTEL*'.

2. The case of the Plaintiff is that the Defendants are using the name '*Intel Cable Industries*' as the name of their firm. Knowledge about the business of the Defendants was acquired by the Plaintiff sometime in January, 2002, and thereafter, the Plaintiff's counsel addressed legal notice dated 23rd January, 2002 to the Defendants calling upon the Defendants to stop using the mark '*INTEL*' and also to take steps to change the name of the firm '*Intel Cable Industries*'. In response thereof, the Defendants replied on

9th February, 2002 as under:

“Dear Sirs,

In response to your letter No.10298 (G-1) dated 23.01.02 on the subject mentioned above, we hereby confirm that the work “INTEL” has never been used as a Trademark for marketing of our Cables.”

3. Thereafter, a follow-up notice was issued by Plaintiff’s counsel on 20th June, 2002 reiterating their earlier stand. The Defendants, however, responded on 29th June, 2002 to the following effect.

“Dear Sirs,

We are in receipt of your letter No.10298 (G-1) dated 20.06.2002 on the subject mentioned above and we have to say as under.

As already informed you vide our letter of even number dated 9.2.2002 that we have never used the word “Intel” as our trade mark for marketing of our cables and we confirm that it still stands.

For marketing of our cables we have our own mark “EDISON CABLES” and this is also printed on our cables for supply.

Our various purchasers quote our trade mark and not ‘INTEL’ in their enquiries for cables. A photocopy of a recent enquiry from National Centre For Radio Astrophysics (T.I.F.R.) Pune is enclosed. From this it is clear that our cable products are totally different from the computers the products of “INTEL” and do not cause any confusion in the minds of Purchasers.

In view of the above your contention in para 5 of your letter under reference that the word ‘INTEL’ used in the name of our firm is to cash upon the name ‘INTEL’ is not correct.

In the end we once again confirm that we are using our own trade mark ‘EDISON CABLE’ for marketing of our cables and it is printed on the cables as well.

This is for your information please.”

4. This correspondence between the parties continued until 17th July, 2003 and has been placed on record. All along, the stand of the Defendants was that they have been using the name 'Intel Cable Industries' as a firm name and not as a trademark.

5. The present suit came to be filed in November, 2003. When the suit was filed, summons and notice were issued to the Defendants. Settlement negotiations also took place between the parties, however, the same did not fructify. On 8th May, 2007 issues were framed in the matter. Thereafter, the parties led their evidence.

6. An application under Order XII Rule 6 CPC being I.A.13853/2015 came to be filed by Plaintiff, in which Plaintiff relied upon the statement of the Defendants in the preliminary submissions to the following effect.

"3. The defendants have filed written statement in the present suit categorically stating in paragraph 16 of written statement under the heading "preliminary submission" that they are not using INTEL as a trade mark but only as part of their trading name/corporate name. The relevant extract of the is reproduced herein;

"Para 16. The defendants have, vide their numerous letters (filed by the Plaintiff along with its list of documents), addressed to the counsel for the Plaintiff, pointed out that they are not using INTEL as a trade mark but only as a part of their corporate name."

Further in response to paragraph 20 of the plaint under the heading "Reply on Merits", the Defendant has stated that

"it is correct that in response to Plaintiff's letter of June 20, 2002 , the Defendants replied through their letter of June 29, 2002 reiterating their contention that name INTEL was not being used

by them as trademark but as trading style"
Therefore it is submitted that the defendants have clearly admitted that defendants are using the mark INTEL only as trade name / corporate name i.e. "Intel Cable Industries."

7. In view thereof, a partial decree was prayed for restraining the Defendants from use of the word 'INTEL' as a trademark. In paragraph 5 of this application, the use by the Defendants of the name 'Intel Cable Industries' is not disputed. Paragraph 5 of the same reads as under:

"5. With regard to the defendants use of 'Intel cable Industries' as their trading/corporate name for the purpose of running their business and its use for running bank accounts, stationery, filing of tax returns, tenders and other statutory compliances as per the law and local regulations is not being disputed by the Plaintiff."

8. Evidence in the matter has since been concluded. Today, Mr. Ranjan Narula, Ld. counsel appearing for the Plaintiff submits that so long as the Defendants agree not to use the mark 'INTEL' as part of their trademark, the Plaintiff does not have any objection if the word 'INTEL', as part of their trading style, is used by the Defendants in a manner which is not akin to a trademark and is used only for the purposes of statutory regulations, tender requirements etc. He submits that in fact, a proposal to this effect was also given to the Defendants in 2014. A copy of the draft proposal given by Ld. Counsel for the Plaintiff is taken on record.

9. Mr. Gaurav Miglani, Ld. counsel for the Defendants, on the other hand, submits that that Defendants have all-along been willing to abide by this condition i.e. they would not use the mark 'INTEL' as a trademark. Despite the same, the Defendants have been subjected to such a long drawn

litigation from 2003. He submits that the written statement would show that the Defendants are using the name '*Intel Cable Industries*' since 1989, when the partnership was set-up.

10. After hearing the parties, the Court called upon the Defendants to produce the label, which is used by them. The Court has perused the label. The same is taken on record and is exhibited as **Exhibit.X**, The Court has also perused the visiting cards **Exhibit DW-1/27**, which are used by the Defendants. The Plaintiff has also no objection in the Defendants using the name '*Intel Cable Industries*' in a manner which is not akin to a trademark. After perusing the visiting cards, invoices of the Defendants and the label, it is directed that a decree shall be passed against the Defendants in the following terms:

- a) The Defendants, their partners or proprietors, agents, servants, or anyone authorised to deal on their behalf, as the case may be, are restrained from using the mark '*INTEL*', or any other deceptively similar mark as a trademark for selling their products.
 - b) The Defendants are, however, permitted to use the name '*Intel Cable Industries*', as is being currently used without giving undue prominence to the word '*INTEL*'.
 - c) Use of the word '*INTEL*', as contained in the visiting card (**Exhibit DW1/27**)/label (**Exhibit X**), is permitted to be used by the Defendants, including for statutory complaints, tenders etc. However, the word '*INTEL*' shall not be used as a trademark.
11. No other reliefs are prayed for by the Plaintiff.
12. The correspondence between the parties has already been captured in the preceding paras. Despite the above correspondence, the suit came to be

filed and was listed before the Court on 14th November, 2003. Thereafter, admission/denial was completed between the parties on 1st May, 2007 and issues were framed on 8th May, 2007. Since March, 2008, the evidence of the Plaintiff was to commence but the affidavits-in-evidence were not filed. On 10th May, 2010, the Court records that *“The order sheet reflect persistent default on behalf of the plaintiff. It has not filed affidavits-in-evidence”*. On the said date, the Plaintiff’s right to lead oral evidence was closed. This order was carried in appeal and the Ld. Division Bench dismissed the appeal on 23rd July, 2010. The Plaintiff preferred an SLP to the Supreme Court and on 25th October, 2010, the proceedings in the suit stayed. Vide order dated 11th July, 2012, the SLP was dismissed and the stay was vacated.

13. On 6th December 2012, Ld. Single Judge noticed that an affidavit-in-evidence was filed on 20th August, 2007 by the Plaintiff, but the same was not pointed out by the counsels, resulting in the proceedings being carried right till the Supreme Court. Vide the said order, costs of Rs.1 lakh were imposed on the Plaintiff and further opportunity to file affidavits in evidence was also granted. The evidence of the Plaintiff continued and the Plaintiff filed applications for taking on record additional documents. The evidence of the Plaintiff was closed on 15th May, 2014. The Defendant’s evidence concluded on 23rd September, 2015. Thus, issues having been framed on 8th May, 2007, the evidence of the Plaintiff concluded only in 2014 that too after so many lapses. The Defendant has diligently led evidence in the matter. Under these circumstances, there has been enormous delay by the Plaintiff.

14. Since the Defendants had agreed, right at inception, to not use the word ‘*INTEL*’ as a trademark, which is acceptable to the Plaintiff even now,

the Defendants are liable to be compensated for being made to go through such a long drawn litigation. Accordingly, costs of Rs.2,00,000/- is imposed upon the Plaintiff to be paid to the Defendants within four weeks.

15. Accordingly, the suit is decreed in the above terms. Decree sheet be drawn. All pending applications also stand disposed of.

PRATHIBA M. SINGH
JUDGE

APRIL 03, 2019/dk

