

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

% **Date of decision: 1<sup>st</sup> November, 2019.**

+ **CS(COMM) 699/2018, IA No.3814/2017(u/O.XXXIX R-2A CPC)**  
**& IA No.5770/2019(u/O.III R-4(2) CPC)**

**MEHRA COSMETICS**

**..... Plaintiff**

Through: Mr. Mohan Vidhani with Mr. Rahul Vidhani, Mr. Ashish Singh, Ms. Elisha Kumar & Mr. Saurabh Kumar, Advs.

Versus

**RAM KUMAR GULATI & ORS.**

**..... Defendants**

Through: Mr. Saurav Rajan Chauhan with Mr. Akshay Srivastava & Ms. Pratibha, Advs. along with D-1&2.

**CORAM:**

**HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW**

1. The plaintiff instituted the suit against the four defendants, namely (a) Ram Kumar Gulati; (b) Raj Kumar Gulati; (c) D.K.Cosmetics; and, (d) G.M. Plastics, for permanent injunction restraining the defendants from (a) infringing the trade mark BLUE CLIFF of the plaintiff by adopting the mark BLUE CHEF with respect to the same goods; (b) passing off their goods as that of the plaintiff under the mark BLUE CHIEF, by use of the mark BLUE CHEF; (c) infringement of registered design 266053 of the plaintiff and for ancillary reliefs.

2. The suit, initially filed in the District Court, was transferred to this Court on the defendants written statement challenging the validity of the registered design claimed by the plaintiff.

3. Vide order dated 6<sup>th</sup> December, 2016 on the application of the plaintiff for interim relief, the defendants, during the pendency of the suit, were restrained from using the word CHEF in conjunction with the word BLUE in respect of White Petroleum Jelly or any other cosmetics or any other mark deceptively similar to the mark CHIEF of the plaintiff. FAO(OS) 71/2017 preferred by the defendants no. 1 to 3 against the said interim order as well as the cross-objections filed by the plaintiff therein against the part of the order dated 6<sup>th</sup> December, 2016 declining interim order with respect to design, were dismissed vide judgment dated 17<sup>th</sup> September, 2018.

4. The suit came up before this Court on 23<sup>rd</sup> September, 2019 for framing of issues when finding that there was no factual controversy, the suit was posted for today and the personal presence of the defendants no. 1 and 2 directed.

5. The counsel for all the four defendants states that the defendants no. 1 and 2 are present in the Court and on further enquiry states that the defendants have now adopted the mark BLUE PALAK and have been using the same for the last five years. It is also stated that though the plaintiff is using the mark BLUE CHIEF but it is the claim of the defendants that the documents filed by the plaintiff to show use of BLUE CHIEF are forged and fabricated.

6. On enquiry, from which date, according to the defendants, the plaintiffs are using the mark BLUE CHIEF, the counsel for the defendants states that the defendants do not know. It is also contended that the defendants are not controverting the mark BLUE CLIFF of the plaintiff.

7. This suit, though of the year 2016, is now being treated as a commercial suit and has been given the nomenclature and number of a commercial suit and is governed by the provisions thereof. Finding to the effect that BLUE CHEF earlier being used by the defendants amounts to infringement and/or passing off of the trade marks BLUE CLIFF and BLUE CHIEF, has already been given for the reasons detailed in the judgment of 6<sup>th</sup> December, 2016 upheld by the Division Bench.

8. Once it is so, when the defendants even today are not able to say that they are the prior user of the mark BLUE CHEF qua which they have been enjoined, merely for the sake of adjudication of the plea of the defendants of fabrication by the plaintiff, the said pleas are not required to be put to trial. Even if the plaintiff is found to have forged the documents of use, as long as it is not the plea of the defendants that the defendant is the prior user of the mark BLUE CHEF, the plaintiff would be entitled to permanent injunction in terms of the interim order.

9. The counsel for the defendants contends that the findings in the interim order are on a *prima facie* view of the matter.

10. Undoubtedly so.

11. In spite of enquiry, it has not been disclosed as to what evidence would be led which would lead to this Court, at the time of final decision, taking a different view from that taken at the interim stage qua similarity/deceptive similarity. It has been held in ***Mahendra & Mahendra Paper Mills Ltd. Vs. Mahindra & Mahindra Ltd.*** (2002) 2 SCC 147 followed in ***Larsen and Toubro Ltd. Vs. Lachmi Narain Traders*** (2008) 149 DLT 46 (DB), ***Staar Surgical Company Vs. Polymer Technologies***

*International* 2016 SCC OnLine Del 8768, *Jaideep Mohan Vs. Hub International Industries* (2018) 249 DLT 572, *The Financial Times Ltd. Vs. The Times Publishing House Ltd.* (2016) 234 DLT 305 and judgment dated 22<sup>nd</sup> November, 2018 in CS(COMM) No.1668/2016 titled *Biofarma Vs. Bal Pharma Ltd.* that qua pleas of similarity/deceptive similarity, the recording of evidence does not serve any purpose.

12. Moreover, the Commercial Courts Act, 2015 entitles the commercial divisions to summarily dispose of a suit if finds no real prospect in the claim or the defence thereto. Furthermore, the defendants for the last five years having already marketed their goods under a different mark viz. BLUE PALAK, the possibility of the defendants, even if succeeding in the suit, reverting back to the mark BLUE CHEF is remote. Thus, the need to put the suit to trial, insofar as for permanent injunction restraining infringement and passing off, is not felt.

13. The counsel for the plaintiff has made nearly similar arguments with respect to the claim in the suit for permanent injunction restraining infringement of design.

14. On enquiry, it is stated that the design is valid till 2024.

15. This Court, in the interim order/judgment, on a perusal of the registered design, has already returned a finding, again though *prima facie*, that there is no novelty in the design of the container of the Petroleum Jelly, against copying of which infringement is claimed, inasmuch as a large number of other products are available in the market in similar containers.

16. I have thus asked the counsel for the plaintiff, how the decision on the said aspect can be any different today and or what evidence would be led by

the plaintiff to establish the novelty in the design, even if put to trial. The decision is unlikely to be before the expiry of the period of validity of the design.

17. The counsel for the plaintiff has contended that since the plaintiff has a certificate of registration of design, the same will be shown to establish novelty. It is also contended that the defendant no. 4 has since also obtained registration of a similar design and the same will be proved in evidence.

18. The process of registration of a design is materially different from that of a trade mark, where an opportunity is given to others to object. Merely because registration has been obtained, is no proof, even *prima facie*, of the validity of the design. Reference, if any required, in this regard can be made to observations in *Mohan Lal, Proprietor of Mourya Industries Vs. Sona Paint & Hardwares* 200 (2013) DLT 322, *Aashiana Rolling Mills Ltd. Vs. Kamdhenu Ltd.* (2018) 253 DLT 359 and *Vega Auto Accessories (P) Ltd. Vs. S.K. Jain Bros Helmet (I) Pvt. Ltd.* 2018 SCC OnLine Del 9381. Similarly, merely because the defendant no.4 may have obtained registration of the same design would not make the design of the plaintiff novel.

19. A perusal of the certificate of registration of design at Pages 17 to 22 of Part IIIA File also shows the plaintiff to have claimed novelty “in the shape and configuration of container” without any particulars and the counsel for the plaintiff on enquiry has only contended that the novelty is in the ring at the centre of the container to handhold the same. To say the least, the same is not even claimed in the registration, particularly in respect of the front side, back side, left side and right side view of the container.

20. Thus, no purpose will be served in putting the claim of the plaintiff for infringement of design also to trial and the same can be summarily dismissed.

21. Resultantly, a decree is passed, in favour of the plaintiff and jointly and severally against the defendants, of permanent injunction in terms of prayer paragraph 30 (i), (ii) and (iii) of the plaint dated 7<sup>th</sup> January, 2016/3<sup>rd</sup> December, 2016, leaving the parties to bear their own costs.

22. Counsel for the defendants states that the costs imposed on the last date have been paid by the defendants to the counsel for the plaintiff.

23. The counsel for the defendants, with reference to the last order states that the applications for registration of 'BLUECHIK' and 'BLUECHES' were withdrawn by the assignee of the said marks.

24. Decree sheet be prepared.

**RAJIV SAHAI ENDLAW, J**

**NOVEMBER 01, 2019**

'ak'

*(corrected & released on 13<sup>th</sup> November, 2019)*