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

Date of Decision: 21st May, 2019

+ **CS (COMM) 1213/2018**

M/S ALLIED BLENDERS AND DISTILLERS

PVT. LTD.

..... Plaintiff

Through: Mr. Sanjay S. Chhabra, Mr. Shrawan Chopra, Mr. Vibhav Mithal, Mr. Bobby Jain and Ms. Vijay Laxmi Mewana, Advocates. (9717172611)

versus

RANGAR BREWERIES LTD.

..... Defendant

Through: Mr. Dushyant K. Mahant and Mr. Ajit Pathak, Advocates. (9899996299)

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. The Plaintiff, M/s. Allied Blenders and Distillers Pvt. Ltd. is a manufacturer and seller of whisky under the trademark '*Officer's Choice*'. The same is registered in the name of the Plaintiff and has been in use since 1988. The case of the Plaintiff is that *Officer's Choice* is the largest selling whisky in the world in terms of volumes. The Plaintiff has placed on record several orders which have been passed in various proceedings protecting the trademark '*Officer's Choice*'. The registrations for the mark, '*Officer's Choice*' have also been set out in paragraph 14 of the plaint.

2. The present suit has been filed against Defendant - M/s. Rangar Breweries Ltd., which sells country made liquor under the brand name '*Rangar da Santra*' among others. The Plaintiff has raised a grievance that the Defendant's products are being sold with the label of the Defendant. However, the said bottles have embossings of the trademark '*Officer's Choice*' on them. The bottles could be recycled bottles of the Plaintiff but

the Defendant has no right to be using the same for the purpose of manufacture and sale of their own product '*Rangar da Santra*'.

3. The Plaintiff has instituted proceedings against the Defendant in the past being CS (OS) No. 1198/2012. At that time, the Defendant was selling country made liquor under the mark/label '*Lal Quila*'. In the said suit, the Defendant had given an undertaking to the following effect:

"(a) The defendant will not use the bottles on which "Officer's Choice" has been embossed, for selling liquor in any other manner;

(b) The defendant will not use the bottles having designs identical or similar to the plaintiff's design Registration no. 223751 dated 10th July, 2009 under class "09-01";

(c) The bottles, if any, which infringe the registered design of the plaintiff and/ or on which "Officer's Choice" has been embossed would be destroyed by the defendant Company within two weeks."

4. Thereafter, the Plaintiff traced infringing activity of use of '*Officer's Choice*' bottles by the Defendant and addressed letters to the Defendant, including letter dated 6th April, 2015. The Defendant, vide its reply dated 11th April, 2015, confirmed that it had withdrawn all the bottles bearing the name '*Officer's Choice*' and that it would abide by the decree dated 18th September, 2012.

5. The present suit has, thereafter, been filed on the premise that the Plaintiff again found bottles under the mark, which were being sold bearing the Defendant's label by embossing the mark '*Officer's Choice*'. One such bottle was purchased by the Plaintiff on 30th June, 2018, from M/s. Daya Nand Tyagi & Co., Beli Bangla, Teh. Nalagarh, Ramshehar Unit. The Plaintiff has produced the original bottle which has the embossing of

‘Officer’s Choice’ and on the front side bears the yellow and black ‘Rangar da Santara’ label. The label also bears the printed excise batch number and the date of manufacturing. The Plaintiff also claims that it has a registered design in respect of the said bottle. The registration certificate of the design no. 221521 has also been placed on record. In view of these submissions, vide order dated 31st October, 2018 the Defendant was restrained from using the said glass bottles bearing the mark ‘Officer’s Choice.’ The said order reads as under:

“13. It appears that the Defendant is sourcing these bottles from the market and fixing its own label and mark with whisky in the said bottle. The same constitutes not just infringement of the registered trademark but also constitutes falsification of the mark of Plaintiff. Defendant is well aware of the Plaintiffs mark owing to earlier proceedings, which have been filed against it. Plaintiff has made out a prima facie case in its favour. Balance of convenience rests in favour of the Plaintiff and irreparable harm would be caused to the Plaintiff if the Defendant is not enjoined. Accordingly, it is ordered that till the next date the Defendant is restrained from marketing its liquor/whisky or any other products in glass bottles, which bear name 'Officer's Choice' in any form including embossed bottles. Compliance of Order XXXIX Rule 3 CPC be made within three days.”

6. The Defendant thereafter entered appearance and made a categorical statement that it does not use glass bottles bearing the mark ‘Officer’s Choice’ for its alcoholic beverages. Injunction was accordingly made absolute on 9th January, 2019. On 6th February, 2019, counsel for the Plaintiff submitted that the Plaintiff does not wish to give up the relief of damages in view of the history of litigation with the Defendant.

7. Today, the matter is listed for case management hearing. Ld. Counsel for the Defendant, Mr. Dushyant K. Mahant, submits that there is no dispute in respect of the issues raised by the Plaintiff. Defendant does not wish to use the '*Officer's Choice*' bottles or trademark in any manner, whatsoever. In fact, he submits that the Defendant has itself been proactive and lodged a criminal complaint on 29th January, 2019 in Nalagarh Police Station, Himachal Pradesh for investigating the matter as to how the bottles bearing the mark/name '*Officer's Choice*' are passing through the production line of the Defendant. The status of the said criminal complaint is that the investigation is pending in the same. He submits that in view of the fact that the Defendant does not dispute the Plaintiff's rights in the bottle and in the trademark, there is no issue that arises to adjudicate in the present suit.

8. Learned counsel for the Plaintiff submits that the Defendant is a repeated defaulter and is deliberately using their glass bottles bearing the mark '*Officer's Choice*' so that it can piggy-back its country made liquor on the strength of the Plaintiff's trademark. He submits that seeing the past violations by the Defendant, it should pay damages or costs should be imposed on them.

9. The Court has heard the counsels for the parties. Under the Commercial Courts, Commercial Division and. Commercial Appellate Division of High Courts Act, 2015, it is clear that the Court needs to frame issues only if there is a contested issue arising between the parties. A perusal of Order XVA Rule 2 shows that it is only when issues of fact and law arise that the court needs to frame issues. The necessary corollary is that, if there are no issues to be tried, the court need not frame issues in every suit.

10. In the present suit, the Defendant has agreed to suffer an injunction

and has also undertaken not to use glass bottles bearing the mark '*Officer's Choice*' with the infringing design. The Plaintiff has produced the original infringing bottle bearing the embossed mark '*Officer's Choice*' as also the label of '*Rangar da Santra*'. The Court is satisfied that bottles bearing the mark '*Officer's Choice*' are being used in some manner for sale of '*Rangar da Santra*'. Under these circumstances, permanent injunction as prayed would be liable to be granted against the Defendant. The Defendant's arguments that the bottles are counterfeit bottles of the Defendant, depends on the outcome of the complaint, which is pending investigation and unless and until some other party is found to be indulging in the counterfeiting, the Defendant cannot escape liability. Under these circumstances, suit is liable to be decreed in terms of Paragraph (i) and (ii) of the prayer clause.

11. The fact that the Plaintiff is being repeatedly forced to institute proceedings, including the filing of the earlier suit, issuance of legal notice and filing affidavits, the Defendant is directed to pay costs of Rs.3 lakhs to the Plaintiff. If in the investigations, it is revealed that some third party was involved in the counterfeiting or the misuse of the '*Officer's Choice*' bottles and any charge sheet is filed by the police in this regard, the Plaintiff agrees to refund 50% of the amount to the Defendant.

12. With these orders, the suit and all pending I.A.s are disposed of. Let the costs be paid in four weeks. Remaining reliefs are not pressed. Original bottle has been returned to counsel for the Plaintiff. Decree sheet be drawn.

PRATHIBA M. SINGH
JUDGE

MAY 21, 2019/sk