

\$~18

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

Date of Decision: 1st November, 2022

+ **CS (COMM) 91/2022**

WESTERN INFRABUILD PRODUCTS LLP Plaintiff
Through: Mr. Sachin Gupta, Ms. Swati Meena
and Ms. Yashi Agrawal, Advocates.
(M:9811180270)

versus

MS WESTERN ROOF TILE & ANR. Defendants
Through: Mr. Jaimon Andrews, Mr. P. Harold,
Mr. Ameen Hassan, Ms. Firdouse
C.P. Advocates. (M:8547593919)
with Mr. Safeer Ali, proprietor in
person.

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.

CS(COMM)-91/2022

2. The present suit has been filed by the plaintiff - M/s. Western Infrabuild Products LLP seeking a decree of permanent injunction against the alleged infringement of its mark 'WESTERN' by the Defendants as also an order of delivery of the goods bearing the infringing mark. The Defendants M/s. Western Roof Tile - Defendant No.1 and M/s. Western Roof and Floor - Defendant No.2, are proprietary concerns of Mr. Safeer Ali. The said proprietor has joined the proceedings today virtually from Kodyathur near Kozhikode in Kerala.

3. The case of the Plaintiff is that the mark 'WESTERN' has been used

by it in respect of roof tiles, roofing materials, clamps/chains and other goods in classes 6 & 19 since 2015. The said mark is also part of the corporate name of the Plaintiff company, which is engaged in the manufacture and sale of construction and roofing material. The mark has been registered since 2015 by the Plaintiff vide Trade Mark Nos. 3065037 and 3065038 in classes 6 and 19 respectively, with an application date of 28th September, 2015. The Plaintiff's products are sold across the country and are even purchased by various institutions. The claim of the Plaintiff is that extensive use of the mark and sales of almost Rs.13 crores in the year 2021 would show that the mark has become a well-known mark.

4. The grievance of the Plaintiff in the present case is that the Defendants were using an identical mark 'WESTERN' in respect of tiles, roofing material, rivets and other related products. The Plaintiff claims to have acquired knowledge of the Defendants' infringing actions when, in the last week of September 2021, it came across the Defendant's trade mark application dated 22nd February, 2020 for registration of the mark 'WESTERN ROOF TILE' in Class 19 bearing application No. 4450585. In the said application, the Defendants claim to be using the mark since 31st October, 2017, which according to the Plaintiff, was a false claim of user.

5. Thereafter, the Plaintiff, on 23rd September, 2021 issued a legal notice asking the Defendants to cease and desist from using the mark. Subsequently, on 31st January, 2021, an interlocutory petition praying to take a notice of opposition on record was also filed by the Plaintiff against the Defendants' mark. The Defendants were also displaying their products on various social media and online platforms. According to the Plaintiff, the use of the mark 'WESTERN' for identical products constitutes infringement

of registered trade mark and passing off.

6. In the present suit, a decree of permanent injunction has been sought by the Plaintiff along with damages. The suit of the Plaintiff was listed on 9th February, 2022 on which date an *ad-interim* injunction was passed in the following terms:

“17. Accordingly, till further orders, defendants, their proprietors/directors, assignees in business, franchisee, licensees distributors, dealers, stockists, retailers etc. are restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in tiles, roofing materials, clamps/ chains, etc. and other materials for building and construction under the impugned mark WESTERN and labels thereof; trade name containing the word Western or any other trade mark, trading name as may be deceptively similar to the plaintiffs trade mark WESTERN amounting to infringement of the plaintiffs registered trade marks and passing off of the plaintiffs trade mark WESTERN.”

7. Vide the said order, a Local Commissioner was also appointed to visit the premises of the Defendants and prepare an inventory of the infringing goods. The Local commission was executed on 17th February, 2022. The Local Commissioner prepared an inventory of the goods, which shows that a total of 22 packets constituting 8360 tiles were seized by the Local Commissioner. The relevant extract of the report of the Local Commissioner to this effect is:

“10. That thereafter, we started sealing the stocks. The 9 to 10 tiles are there in per carton. 22 cartons in a line, total number of Tiles are 8360. The Original Inventory of Seizure Goods dated 17.02.2022 is annexed herewith as Annexure-B

11. That the photography and videography of the execution of the commission were recorded. The copies of the Photograph and videography are annexed as Annexure-C

12. That thereafter we have complete our counting of stock and recorded them in superdarinama. Than we request Mr. Rashid to take the superdarinama he again refused to receive that. We request to Police Officers to sign the attendance sheet they said they will not sign any paper we can only protect you but will not take or sign any paper”

8. The Defendants entered appearance in this suit on 27th July, 2022 and submitted that they had already adopted a new mark.

9. Today, Mr. Jaimon Andrews, Id. Counsel for the Defendants along with Mr. Piyo Harold submits that the Defendants do not wish to contest the case and are ready to suffer a permanent injunction as they have already adopted a new mark and have ceased using the mark/name WESTERN. It is further submitted that the Defendants have attempted to resolve this case through mediation with the Plaintiff but the same did not work out due to lack of agreement on monetary terms. He further submits that the Defendants are willing to pay a total sum of Rs.4 lakhs towards litigation costs and damages in the present case. He also prays that the seized goods may be returned to the Defendants. Mr. Safeer, who has joined the proceedings virtually also has no objection if the permanent injunction is granted in favour of the Plaintiff and against the Defendants as he does not intend to use the mark ‘WESTERN’

10. Mr. Sachin Gupta, Id. counsel for the Plaintiff submits that the Plaintiff is willing to resolve the disputes if the decree for injunction is passed and the sum of Rs. 4 lakhs is paid. He however submits that the

seized goods have been disposed of by the Defendants. This position is disputed by the Defendants.

11. Insofar as the seized stock is concerned, on a query from the Court, Mr. Ali submits that the total value of the said stock is around Rs. 6-6.5 lakhs only. Ld. Counsel also submits that most of the tiles are broken or damaged as they are stocked in the open.

12. In this factual background and in view of the submissions made herein above, framing of issues and recording of any evidence would not be necessary, since the main disputes have been resolved amicably. The present suit is accordingly decreed in terms of paragraph 26(a) and (b) of the plaint which read as under:

“26. It is therefore, respectfully prayed that this Hon’ble Court may be pleased to grant the following reliefs in favour of the Plaintiff and against the Defendants:

a) A decree for permanent injunction restraining the Defendants, their proprietors, their assigns in business, licensees, franchisee, distributors, dealers, stockists, retailers, from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in tiles, roofing materials clamps/ chains, etc. and other materials for building and construction under the impugned mark WESTERN and labels thereof, trade name containing the word WESTERN or any other trade mark, trading name, as may be deceptively similar to the Plaintiff’s trade mark WESTERN amounting to infringement of the Plaintiff’s registered trade marks as tabulated in para 7 of the plaint;

b) A decree for permanent injunction restraining the Defendants, their proprietors, their assigns in business, licensees, franchisee, distributors, dealers, stockists, retailers, from manufacturing,

selling, offering for sale, advertising, directly or indirectly dealing in tiles, roofing materials clamps/ chains, etc. and other materials for building and construction under the impugned mark WESTERN and labels thereof, trade name containing the word WESTERN or any other trade mark, trading name, as may be deceptively similar to the Plaintiff's trade mark WESTERN amounting to passing off of the Defendant's goods and business for those of the Plaintiffs;"

13. Considering that the Plaintiff is not pressing the prayer for damages while taking into account the fee of the Local Commission, and other costs the agreed amount of Rs. 4 lakhs shall be paid by the Defendant to the Plaintiff in the following manner.

- Rs. 2 lakhs to be paid on or before 15th December, 2022.
- Rs. 2 lakhs to be paid on or before 31st January, 2022.

14. The said amount shall be handed over in the name of the Plaintiff company i.e. M/s. Western Infrabuild Products LLP to the Id. Counsel for the Plaintiff.

15. Insofar as the goods, which were seized bearing the mark WESTERN are concerned, the Defendants are permitted to dispose of the same after removing the mark WESTERN.

16. Decree sheet be drawn in the above terms.

17. In view of the fact that the dispute is amicably resolved, full court fee is directed to be refunded to the Plaintiff, through counsel, in terms of the judgement of the Court in ***Nutan Batra vs. M/s Buniyaad Associates, 2018 SCC OnLine Del 12916.***

I.A. 17719/2022 (u/O XXXIX R 2A CPC)

18. This is an application filed by the Plaintiff under Order XXXIX Rule 2A CPC raising issues regarding the disobedience of the order dated 9th February, 2022 passed by this Court. The case of the Plaintiff in this application is that on three social media/online platforms i.e., Facebook, Just Dial and VY Maps, listings of the Defendants are still being reflected.

19. Ld. counsel for the Defendants along with the Defendant Mr. Ali who appears virtually submits that the Defendants are willing to take down the said listings. In view of the permanent injunction granted in the above suit, let the defendants take steps and write to these platforms to take down the listings bearing the mark WESTERN. The said platforms shall give effect to the same within 48 hours of receiving the request from Defendant.

20. In this application, the conduct for the Defendants has also been questioned by the Ld. Counsel for the Plaintiff. However, in view of the above order passed in the suit, no further orders are required to be passed.

21. All pending applications are disposed of and the next date of hearing i.e. 16th December, 2022 stands cancelled.

PRATHIBA M. SINGH
JUDGE

NOVEMBER 1, 2022/dk/ms/Am