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

Date of decision: 6th April, 2022

+ **CS (COMM) 548/2021 & I.A. 14166/2021**

M/S PRAKASH PIPES LIMITED Plaintiff
Through: Mr. Rishabh Srivastava, Advocate
(M:9737708556)
versus

M/S BAUCHHAAR POLY INDUSTRIES THROUGH ITS
PROPRIETOR SH TANISHQ AGARWAL & ANR. Defendants
Through: Mr. Rahul Rajput & Ms. Nishi Ranjan
Singh, Advocates

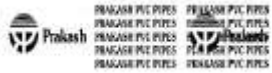
CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.
2. The Plaintiff has filed the present suit seeking permanent injunction against the Defendants' use of the mark 'PRAKASH'/trade dress/copyright/colour combination/writing style/formative marks, for PVC pipes and other related goods, as also reliefs for passing off, delivery up, rendition of accounts and further damages.
3. The case of the Plaintiff is that it adopted the mark 'PRAKASH' and its corresponding logos in the 1980s and the said mark has come to be associated with high quality PVC products such as PVC pipes, PVC water storage tanks, PVC tubes and fittings, PVC House Pipe Hi - Density Poly Ethylene (HDPE) Pipes, etc., as set out in paragraph 2 of the plaint. The logos of the Plaintiff are set out below:



4. The Plaintiff also has registered trademarks being 'PRAKASH', 'PRAKASH GOLD' and other variants, including the logos, in Classes 9, 17, 20 and 35. The Plaintiff also has pending applications in respect of 'PRAKASH' and its derivative marks. The details of the Plaintiff's registered trademarks are as under:

Trade Mark No.	Class	Trade Mark
562627	17	PRAKASH
783208	17	
796026	17	PRAKASH
812431	17	PRAKASH GOLD
2692893	17	
1071895	17	PRAYAG
562626	09	
595436	09	



812298	09	
2850865	20	
4253765	35	

5. The copyright for one of the artistic works is also registered vide Registration No. A-55155/98. One copyright application for the round logo, is stated to be pending. The sales of the Plaintiff for the year 2018-19 of the PVC products are more than Rs.4,000 crores annually by the two entities, namely, Prakash Industries Limited and Prakash Pipes Limited.

6. In October, 2021, the Plaintiff discovered that the Defendants, M/s Bauchhaar Poly Industries - Defendant No.1, and Sh. Tarun Agarwal - Defendant No.2, had commenced using the mark 'PRAKASH', 'PRAKASH PREMIUM' and 'PRAKAS' in a similar logo style for their PVC products, including for PVC pipes, in a similar trade dress/colour combination/writing style/label/get up. Upon further inquiries, the Plaintiff also learnt that Defendant No.1 had applied for the trademark registration of the mark 'PRAKASH PREMIUM' by Application bearing No. 4903662 in Class 17 for 'unprocessed and semi-processed rubber, guttapercha, gum, asbestos, mica and substitutes for all these materials, plastics and resins in extruded form for use in manufacture, packing, stopping and insulating materials, flexible pipes, tubes and hoses, not of metal', on a 'Proposed to be Used' basis. According to the Plaintiff, Defendant No.2 had also applied for

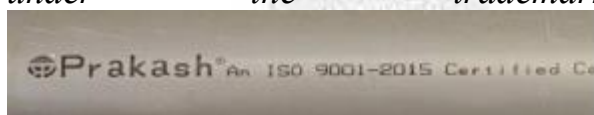


trademark registration for three marks consisting of the mark 'PRAKASH', details of which are set out as under:

Application No.	Class	Trademark
5022904	17	SUBPRAKASH
5047796	20	SUBPRAKASH
5087243	17	PPLPRAKASH

7. As per the Plaintiff's inquiries, Defendant No.2 is a brother of the promoter of the Defendant No.1 and hence it was a clear deliberate action on their part to use the mark 'PRAKASH' and encash upon the goodwill of the Plaintiff. This Court, vide order dated 29th October, 2021 had injuncted the Defendants in the following terms:

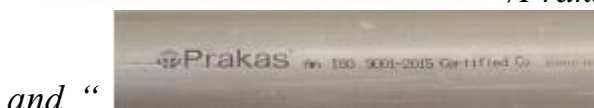
"5. The plaintiff has made out a prima facie case. An interim order is passed in favour of the plaintiff and against the defendants restraining the defendants, their partners, etc. from manufacturing, selling, offering for sale, advertising their products or operating a website or any social media accounts under the trademarks "



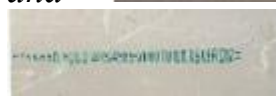
"Prakash, "



"Prakash Premium



and "Prakas, "



"Prakash Gold/

PRAKAS/SUBPRAKASH/PPLPRAKASH or any other mark that is identical or deceptively similar to the Plaintiff's trademark as listed above till further



orders.”

8. Thereafter, as recorded in the order dated 6th January, 2022, the Defendants had entered appearance and submitted that they have already stopped using the mark ‘*PRAKASH*’ and ‘*PRAKASH GOLD*’, etc. The Defendants also submitted that they were inclined to settle the matter amicably. Accordingly, the matter was referred to mediation.

9. However, the mediation did not prove to be fruitful and the matter has been listed today. The Plaintiff has produced the physical products of the Defendants, in Court. A perusal of the same shows that the trademark being used by the Defendants is identical and the logo being used is also a colorable imitation of the Plaintiff’s logo. The said marks of both the parties are as below:





10. Clearly, there is a violation of the statutory and common law rights of the Plaintiff who appear to be market leaders in the same industry.

11. Mr. Rajput, Id. Counsel for the Defendants, submits that the Defendants had manufactured these products only for a few days but had not commercially sold the products. He submits that the Defendants are primarily involved in trading activities and not in manufacturing of these pipes. He further submits that the Defendants are willing to suffer a decree that they would not use the mark '*PRAKASH*' or the accompanied logo, as also any variants thereof such as *PRAKASH GOLD*, *SUBPRAKASH*, *PPLPRAKASH*, *PRAKASH PREMIUM*, *PRAKAS*, etc.

12. Id. Counsel for the Plaintiff further submits that the Defendants had applied for registration of four marks deceptively similar to the Plaintiff's marks, which shows that the entire intention was to somehow capitalize on the Plaintiff's mark, hence he prays for costs being awarded.

13. Considering the exclusive rights of the Plaintiff in the mark



‘*PRAKASH*’ as also its various derivative marks, the logo and the copyright registration, this Court is of the opinion that this is a fit case for grant of permanent injunction restraining the Defendants from using the mark ‘*PRAKASH*’, its formative marks including ‘*PRAKASH GOLD*’, and/or the

accompanying logos being   , in any form whatsoever in respect of pipes, fittings, storage tanks, PVC products and any other PVC products or allied goods or construction materials and/or other products having the same trade channel.

14. Accordingly, the suit is decreed in terms of paragraphs 35(i), (ii) and (iii) of the plaint.

15. The Defendants shall also withdraw the above-mentioned trademark applications bearing nos. 5022904, 5047796, and 5087243, and any other trademark/copyright applications which they may have filed, in respect of other marks which may be deceptively similar to the Plaintiff's mark ‘*PRAKASH*’ or any variant of the same, including the Plaintiff's logos.

16. This Court is also conscious of the fact that the Plaintiff would have incurred legal costs in pursuing this litigation, which according to the Plaintiff are over Rs.10,00,000/- and the Court fee component itself is Rs.2,10,000/-. On the issue of costs to be awarded in commercial matters, the Supreme Court in *Uflex Ltd. v. Government of Tamil Nadu & Ors.* [Civil Appeal Nos.4862-4863 of 2021, decided on 17th September, 2021] has held that in commercial matters, actual costs ought to be awarded keeping in mind the bill of costs, including counsel fees.

17. In the present case, considering the blatant infringement of the



Plaintiff's marks and the costs incurred, it is deemed fit to direct the Defendants to pay a sum of Rs.5,00,000/- as costs to the Plaintiff. The same shall be paid in two instalments: (i) the first instalment of Rs.2,50,000/- shall be paid on or before 30th May 2022, and; (ii) the second instalment of Rs.2,50,000/- shall be paid on or before 30th October, 2022, as agreed between the parties.

18. The suit is decreed in the above terms. Let the decree sheet be drawn up accordingly. All pending applications are disposed of.

19. Copy of this order be communicated to the Registrar of Trademarks (**Address:** Trademarks Registry, New Delhi, Boudhik Sampada Bhawan, Plot No. 32, Sector 14, Dwarka, New Delhi-110078; **Email:** cgofficemh@nic.in, hodel.tmr@nic.in), as also through Mr. Harish Vaidyanathan Shankar, Id. CGSC for compliance. The Registrar of Trademarks shall, upon receiving this order pass appropriate orders considering that the Defendants are stated to have already withdrawn the said trademark applications.

20. The digitally signed copy of this order, duly uploaded on the official website of the Delhi High Court, www.delhihighcourt.nic.in, shall be treated as the certified copy of the order for the purpose of ensuring compliance. No physical copy of orders shall be insisted by any authority/entity or litigant.

PRATHIBA M. SINGH, J.

APRIL 6, 2022/aman/MS