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

Date of Decision: 29th November, 2023

+ **CS(COMM) 849/2023**

MAHESH NAMKEEN PVT. LTD. Plaintiff

Through: Mr. Shravan Kumar Bansal & Mr.
Ajay Amitabh Suman, Advs. (M.
9990389539)

versus

PATOLA INDUSTRIES AND ANR Defendants

Through: Ms. Aparna Jain & Mr. Ishan Berry
Advs. (M. 8800288998)
Mr. Dhruv Sharma, Adv., D-1&2,
(M. 9999099322)

13

WITH

+

CRP-IPD 6/2023 & CM APPL. 35188/2018

PATOLA INDUSTRIES Decree Holder

Through: Ms. Aparna Jain & Mr. Ishan Berry
Advs. (M. 8800288998)

versus

MAHESH NAMKEEN PVT LTD & ORS Judgement Debtors

Through: Mr. Shravan Kumar Bansal & Mr.
Ajay Amitabh Suman, Advs. (M.
9990389539)

11

WITH

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C.O. (COMM.IPD-TM) 187/2021

PATOLA INDUSTRIES Petitioner

Through: Ms. Aparna Jain & Mr. Ishan Berry
Advs. (M. 8800288998)

versus

MAHESH NAMKEEN PVT LTD AND ANR Respondents

Through: Mr. Shravan Kumar Bansal & Mr.



Ajay Amitabh Suman, Advs. (M.
9990389539)

12
+

WITH
C.O. (COMM.IPD-TM) 198/2021

PATOLA INDUSTRIES

..... Petitioner

Through: Ms. Aparna Jain & Mr. Ishan Berry
Advs. (M. 8800288998)

versus

MAHESH NAMKEEN AND ANR

..... Respondents

Through: Mr. Shravan Kumar Bansal & Mr.
Ajay Amitabh Suman, Advs. (M.
9990389539)

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.
2. The Plaintiff - Mahesh Namkeen Pvt. Ltd. has filed the present suit against Defendant No. 1- Patola Industries and Defendant No.2- M/s Anil Confectionery, seeking injunction against the use of the mark 'MAHESH' for namkeen and other food items.
3. The said suit was filed before the District Judge, Patiala House Court. In the said suit, the allegation of the Plaintiff is that it has adopted the word and label mark 'MAHESH' both in English and Hindi in the year 1983, through its predecessor in interest M/s. Mahesh Dalmoth Bhandar.
4. The Plaintiff has been engaged in the business of manufacturing and selling sweets, namkeens and confectionery items in the state of Madhya Pradesh under the mark 'MAHESH'. The earliest registration for the trade mark 'MAHESH (in Hindi)' bearing no. 945893 under class 30 dates back to 8th August, 2000.



5. The Plaintiff also operates its business through the domain name www.maheshnamkeen.com as also sell its products through other online websites like www.indiamart.com.

6. The allegation in the Plaint is that the Defendants are using the mark and label 'MAHESH' for identical goods and business of namkeen, snacks, confectionery and other allied/cognate goods. As per the Plaint it is averred that Defendant No. 2 is the distributor of Defendant No.1.

7. The jurisdiction of Courts in Delhi was invoked on the ground that the products of the Defendants are available for sale in various markets of Delhi. Initially, an *ex parte* injunction was granted on 8th March, 2018 and Local Commissioners were appointed. The relevant portion of the order is extracted below:

“(f) Therefore, it is obvious that plaintiff has prima facie exhibited that all the mandatory conditions required for granting of an ad interim ex-parte injunction are in favour of plaintiff and against the defendants and hence a restrain order against the defendant may be passed. Nonetheless, it also seems that granting of ad interim injunction against the defendant is essential, urgent and is in public interest and delay may defeat the object of injunction; since it is likely that unwary purchasers of average intelligence and imperfect recollection may be deceived and public interest in general shall suffer adversely due to availability of the goods of the defendants in open market with aforesaid deceptive trademark.

(g) Therefore, an ex-parte ad interim injunction order is granted in favour of plaintiff and against the defendants and defendants and their agents are restrained from trading, advertising and dealing in any mode and manner from any platform its goods



under the trademark MAHESH with label of MAHESH and in all its forms till the next date.

6. In view of the aforesaid discussion and observations, it seems that it is in the interest of justice to appoint a Local Commissioner as local investigation is requisite for the purpose of proper elucidation of the matter in issue and to protect the infringing evidence. Accordingly, Sh. Mukesh Ahuja, Advocate, Chamber No. G-409, 4th Floor, G-Block, Karkardooma Court, Shahdara, Delhi-110032 and Ms. Vinita Singh, Advocate, Chamber No. D-714, 7th Floor, Lawyer's Chamber, Karkardooma Courts Complex, Delhi-32 are appointed as Local Commissioners and their fees is fixed to be Rs. 1,00,000/- (One lakhs) each exclusive of transport, pocket expenses and tax. Plaintiff is directed to pay the fees of the Local Commissioners at the earliest within a week of passing of this order by cheque, demand draft, pay order or any other convenient mode except cash.”

8. The said Local Commissioners had made seizure of more than 20,000 products bearing the mark MAHESH.

9. On 24th March, 2018, an application under Order XXXIX Rule 4 CPC, 1908 was filed by the Defendants claiming that the Defendants had adopted the mark ‘MAHESH’ in the year 2000 and had applied for registration in the year 2008. There were some defects in the said registration and a correction was applied for, which was subsequently granted. Since the Defendants also obtained a registration, the District Judge vacated the injunction on 27th March, 2018 in the following terms:

“ It seems at this stage that both the parties are the registered proprietor in class 30 for the trademark MAHESH. The defendant has claimed that defendant applied for registration of the trademark MAHESH



in the year 2008 claiming use since 2000. The disposal of the application under Order 39 rule 1 and 2 CPC of the plaintiff and under Order 39 rule 4 CPC of the defendant will take some time. It seems that since defendant no.1 is also the registered proprietor of trademark MAHESH, therefore, it is in the interest of justice that permission be given to the defendant to carry on its business using trademark MAHESH till disposal of the aforesaid applications, subject to the condition that the defendant shall maintain the record of the sale of its goods and keep on filing the invoices/receipts in the court after every 15 days and simultaneously supply copy of the same to the plaintiff. However, it is clarified that the observation made in this order shall have no affect on the merits of the case at any stage.”

10. Subsequently, the goods which were seized by the Local Commissioners were also released and were permitted to be sold after changing the packaging. The Plaintiff then approached the IPAB challenging the registration certificate granted to the Defendant. Vide order dated 16th July, 2018 the IPAB cancelled the registration certificate of the Defendants. The *ex-parte* interim injunction order dated 8th March, 2018 was restored and the order dated 27th March, 2018 was recalled.

11. The Defendants then moved an application under Order VII Rule 11 CPC, 1908 in the suit, challenging the maintainability of the suit in Delhi on the ground of territorial jurisdiction. The said application was dismissed on 20th August, 2018, on the ground that the Plaintiff is carrying on its business physically as also through its dealers and distributors in Delhi, accordingly it was held that the Court has jurisdiction. Challenging the said order, the revision petition no. **CRP 181/2018** has been filed.



12. In the meantime, the Defendants had also filed two cancellation petitions challenging the trademark registrations bearing nos.1014562 and 1321699 in class 30 in ***C.O. (COMM.IPD-TM) 187/2021 & 198/2021*** respectively.

13. Vide the last order dated 1st September, 2023, after having perused that there are so many proceedings which were pending between both the parties, this Court exercised jurisdiction under Rule 26 of the Delhi High Court Intellectual Property Rights Division Rules, 2022 and called for the suit for being consolidated along with the cancellation petitions. The suit has today been received.

14. After some hearing, Id. Counsel for the Defendants at the outset submits that the Defendants' business under the mark 'MAHESH' has been brought to standstill since 2018 and the Defendants have suffered immensely because of the injunction. However, since the Defendants have now adopted a completely different mark and have continued their business, they do not wish to contest the suit insofar as the injunction is concerned. Id. Counsel for the Defendants further submit that the Plaintiff has demanded substantial amount of damages and costs, which the Defendants are unable to pay due to closure of the business under the mark 'MAHESH'.

15. On the other hand, Id. Counsel for the Plaintiff submits that the Plaintiff is the prior user of the mark MAHESH since 1983 and the registered proprietor of the mark. It was further submitted that the Defendants' adopted the mark 'MAHESH' through misrepresentation, and the same was used for a long period of time. Thus the Defendant's ought to pay costs and damages.

16. In the present case, the pleadings on record would show that the



earliest trademark application by the Defendants is of 2008. It appears that due to a clerical error in the Journal advertisement the certificate issued was with wrong description of the goods read as 'MADHURAM SWEETS'. The same was sought to be corrected, but as on date, the Defendants are not claiming any rights in the said registration. The Defendants are also willing to concede to a decree today due to the events which have been recorded above.

17. In the present case the suit has been filed almost 10 years after the first trademark application by the Defendants. It is also the case of the Defendants that the mark 'MAHESH' is an ordinary mark and can be used by anyone.

18. The Defendants have agreed to the permanent injunction which can be granted. Insofar as the trademark registration is concerned which was granted to the Defendants', the said trademark applications have already been abandoned and the same is also reflected in the official website of the IPO.

19. Ld. Counsel for the Defendants submits that the Defendants' are not in position to pay any costs. The matter was passed over on request of Ld. counsel for the Plaintiff for seeking instructions in respect of costs and damages. Ld. counsel for the Plaintiff submits that the Plaintiff would not insist for any cost or damages if a decree of permanent injunction is granted in favour of the Plaintiff and against the Defendants as also if all the cancellation petitions filed against the Plaintiff's registrations are withdrawn.

20. The Defendants are stated to have filed five trademark applications for the mark 'MAHESH', all of which are opposed or abandoned by the



Plaintiff. The details of the same are as under:

S. No.	Trade Mark Applications of Defendant	Mark applied for	CLASS	Status
01.	1698451	MAHESH	30	Abandoned
02.	2977451	MAHESH LABEL	30	Opposed
03.	3043455	MAHESH LABEL	16	Refused
04.	3043456	MAHESH LABEL	29	Abandoned
05.	3439120	PATOLAS MAHESH (LABEL)	30	Abandoned

21. In these circumstances, the following directions are passed.

- (i) The suit of the Plaintiff is decreed in terms of paragraph 36(a) of the Plaint;
- (ii) Insofar as the relief of delivery up is concerned, since the goods seized were already permitted to be sold, no further orders are required to be passed;
- (iii) The Defendants shall withdraw all their trademark applications listed above. If the same have not been abandoned or removed or withdrawn, the Office of the CGPD TM shall pass appropriate orders within four weeks after receipt of this order reflecting withdrawal of all the four applications;



- (iv) If any copyright application has been filed by the Defendants, the same shall also stand withdrawn;
 - (v) The Defendants also agree to withdraw the cancellation petitions being ***C.O. (COMM.IPD-TM) 187/2021 & 198/2021*** *qua* the Plaintiff's registrations bearing nos. 1014562 and 1321699;
 - (vi) In view of the above withdrawal of the applications, the cancellation petitions, the Plaintiff does not press for rendition of accounts and costs in the present proceedings;
 - (vii) If any packaging under the mark 'MAHESH' is left with the Defendants, the same shall be destroyed within 2 weeks;
22. The suit is decreed in the above terms and all other petitions are also disposed of.
23. Decree sheet be drawn accordingly.
24. All pending applications are also disposed of.

PRATHIBA M. SINGH
JUDGE

NOVEMBER 29, 2023/dk/ks