

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

% **Reserved on: March 17, 2023**
Pronounced on: May 12, 2023

+ **FAO(OS) (COMM) 100/2017 & CM APPL.17734/2017**

M/S DARZI ON CALL

..... Appellant

Through: Mr. J. Sai Deepak with Mr. Mohit Goel, Mr. Sidhant Goel, Mr. Deepankar Mishra, Mr. Abhishek Kothala and Mr. Avinash Sharma, Advocates.

Versus

SUNIL MITTAL & ANR.

..... Respondents

Through: Mr. C.M. Lall, Senior Advocate with Ms. Gunjan Paharia, Ms. Apurva Bhutani, Mr. Sudhir Balyan, Mr. Amit Tomer, Mr. Raghav Vig, Ms. Ananya, Advocates.

CORAM:

HON'BLE MR. JUSTICE MANMOHAN

HON'BLE MR. JUSTICE SAURABH BANERJEE

J U D G M E N T

SAURABH BANERJEE, J.

1. The appellant (*defendant*) by this appeal has impugned order dated 19.04.2017 passed by the learned Single Judge in CS(COMM) 1381/2016 whereby an application under *Order XXXIX rules 1 & 2* of The Code of Civil Procedure, 1908¹ filed by the respondents (*plaintiffs*) has been allowed in their favour and the appellant has been restrained from using the word “*Darzi*” in its trademark/logo/label.

¹ Henceforth referred as “*CPC*”

2. The respondents, claiming to be the registered proprietor of the logo mark



in Class 24 instituted a suit for permanent injunction restraining infringement, passing off and for rendition of accounts against the appellant seeking to restrain it from using the word “*Darzi/ The Darzi*” along with other relief(s). As per respondents, they were operating under the concern “*Darzi/ The Darzi*” since 1981 to provide bespoke tailoring and have been continuously using the said trademark/ label “*Darzi/ The Darzi*” bona fide since its adoption whereafter, they have filed various applications for registration of the same in different classes and have also obtained copyright registrations and the word “*Darzi/ The Darzi*” is forming the most prominent part of their trademark.

3. When the suit came up for hearing on 05.10.2016, the appellant was restrained from using the trademark or trade name having as component thereof the word “*Darzi/ The Darzi*” or any other trademark or trade name similar or deceptively similar thereto, till further orders. However, when the suit came up for hearing on 07.12.2016, the appellant was permitted to use the following marks: -



&



4. Thereafter, appellant contended that since the respondents were owners of a composite logo mark comprising of the words “*Darzi/ The Darzi*” they did not have any rights on the individual components therein and that the respondents never claimed protection for the words “*Darzi/ The Darzi*” as it was common to the trade. Also, even though the respondents applied for the wordmark “*The Darzi*” vide TM No.900352 dated 28.01.2000, the same was abandoned and so they cannot assert any rights over the word “*Darzi*”.

5. Learned Single Judge after hearing both sides, vide the impugned order, restrained the appellant from using the said word “*Darzi*” as the

respondents were able to make out a *prima facie* case with the balance of convenience in their favor and against the appellant as the respondents were using the said trademark for at least twenty years prior to the appellant. Further, it was observed that, the appellant was using a different trademark than what was in consideration since the last six months of passing of the impugned order and as the prejudice to the appellant would be negligible as compared to the respondents by non-grant of injunction, a *prima facie* case was found in favor of the respondents and that they will suffer irreparable injury from the continuous use of the impugned mark by the appellant.

6. Being aggrieved, appellant chose to challenge the impugned order vide the present appeal primarily contending that the word “*Darzi/ The Darzi*” is ‘generic’ as it refers to a profession and thus cannot be monopolized. Also, relying upon various judgments, learned counsel for appellant contended that the learned Single Judge has wrongly relied upon the various third-party documents on record and also that as the respondents have admitted that their ‘logo’ mark is different from the word mark “*Darzi*” owned by third parties as per their own contention before the Trade Mark Registry, they cannot approbate and reprobate to now contend that the mark of the appellant is similar to their logo mark though they are very different from each other. According to learned counsel for the appellant, the trademark of the respondents has to be considered as a whole and they are estopped from claiming independent rights in any part of the composite logo mark in view of *Section 17* of the Trade Marks Act, 1999².

7. *Per contra*, learned senior counsel for respondents contended that they have themselves coined and conceived the trademark “*The Darzi*” for the tailoring services offered by them since the year 1981. Relying upon

² Hereinafter referred as “*TM Act*”

various judgments and *Section(s) 9, 31 and 32* of the TM Act, learned senior counsel for the respondents contended that their mark “*Darzil The Darzi*” is not ‘generic’ as it acquired distinctiveness and secondary meaning. It was also contended that in any event and under the facts involved, even if the trademark “*Darzil The Darzi*” was ‘generic’, the same can be registered and protected.

8. This Court has heard the learned (senior) counsels for both parties at length and gone through the various documents and judgements relied upon by them.

9. While addressing arguments, the learned senior counsel for respondents, after conclusion of arguments by learned counsel for appellant and before commencing his own arguments, contended that the appellant has misled this Court by withholding information that it is no longer using the impugned mark “*Darzi On Call*” and is instead using the mark “*Designer On Call*”. With a view to fortify the said contention, the learned Senior counsel for respondent handed over a few fresh (additional) documents which, *admittedly*, are not forming a part of the record before the learned Single Judge. Thereafter, learned senior counsel for the first time apprised this Court that after passing of the impugned order under challenge and filing of the present appeal before this Court the respondents have been granted the registrations of the wordmark “*The Darzi*” in various Classes.

10. On a pointed query from this Court, though the learned senior counsel confirmed that the respondent has since then taken requisite steps and filed an application under *Order VI rule 17* of The Code of Civil Procedure Code, 1908 (I.A. No. 10754/2018) before the learned Single Judge, which, has since been allowed vide order dated 16.01.2019 and

further issues have also been framed thereafter vide order dated 07.10.2022. *Admittedly*, the above said documents shown or sought to be filed before this Court were never forming a part of the record before the learned Single Judge at the time of passing of the impugned order and thus could not have been/ were considered. Similar is the situation before this Court as they can neither be taken on record nor considered. In fact, the handing over and acceptance of the said few fresh (additional) documents by learned senior counsel for respondent has been, *rightly*, opposed by the learned counsel for appellant. As is trite law, the same cannot be taken on record by this Court [*Jain Shikanji Private Limited vs Satish Kumar Jain*³(paras 25-28)].

11. In any event, learned senior counsel for respondent, submits that the aforesaid few fresh (additional) documents along with a fresh application seeking interim relief(s) are being filed before the learned Single Judge, meaning thereby, the appellant will also have to be given a chance of rebuttal, i.e., an opportunity for filing its amended written statement and reply to the said application seeking interim relief(s). Thereupon, based on the pleadings therein and if deemed fit, proper and necessary, the appellant may also be given an opportunity of filing additional documents by the learned Single Judge. In view thereof, inherently the nature of the present suit, of which the impugned order is under challenge, will change as it will be on a different footing altogether. At the time of passing of the impugned order, the whole case of the respondents as set out in the plaint was based upon a device mark where the word “*Darzi/ The Darzi*” was forming a part of the logo whereas now the same respondents have been granted independent rights in the wordmark “*Darzi/ The Darzi*”.

12. In fact, the respondents had instituted a suit with respect to the logomark “*The Darzi*” in Class 24 as they were not the owner of the (now) registered wordmark “*The Darzi*” though they claimed rights in and to the same as it was forming a part of the logomark “*The Darzi*”. It is also clear that since the grant of registration of the new wordmark “*The Darzi*”, the respondents have amended/ incorporated the pleadings and reliefs qua the same before the learned Single Judge. Needless to say, registration of the wordmark “*The Darzi*” in the name of respondents instead of the earlier logomark “*The Darzi*” of the respondents has completely changed the nature of the case on hand.

13. Consequently, in wake of the fresh change in circumstances and position of law, especially the registration of wordmark “*The Darzi*” obtained by respondents in various classes, in the opinion of this Court there is no purpose of proceeding with the present appeal and adjudication thereof by this Court, as it would have no bearing upon the pending suit and the parties, as scope and effect thereof have since long changed. In fact, any finding by this Court might be prejudicial to (either) parties. This Court feels that there will be no useful purpose of allowing the parties to agitate their case before it as much water has flown under the bridge since passing of the impugned order and filing of the present appeal. It is thus felt by this Court that it would be best, instead of entering into the merits of the disputes involved, relegate the parties to agitate their case(s) before the learned Single Judge.

14. Considering the aforesaid change in circumstances, there is no requirement for this Court to delve into the judgements cited at bar by the learned counsel/senior counsel for the parties.

15. However, as the parties are at loggerheads since long and have been, *admittedly*, agitating their rights over the wordmark ‘*Darzi*’, seeing the gravity of the situation, in the view of this Court it would be in the interest of justice, fair play and good conscience, if the parties are given such options so that there is clarity and certainly no confusion amongst the members of the trade and also amongst the general public. In the meanwhile, without taking a grim view of the disputes involved and instead considering the overall factual matrix of the situation at hand, this Court feels that to bring a hiatus for the time being, the following interim arrangement be made for smooth functioning of both the parties and thus directs as under:-

- a. The appellant shall henceforth commence, within a period of *sixty days* from the passing of the present order, using the wordmark as “***Darzi On Call by Ali-Nazia-Avinash***” for stitching, offering or selling any kind of merchandise, advertising in any kind of active or subsequent print media, billboard, product, label/ sign, packaging, stationeries, wrappers, receptacles, and any goods, accounts, including but not limited to Facebook, Instagram, WhatsApp or like on the social media and depict the logo/label mark “***Darzi On Call by Ali-Nazia-Avinash***” as under:-



Appellant will be free to use its other earlier logo herein below as it is without specifying the names therein:-



- b. The respondent shall henceforth commence, within a period of *sixty days* from the passing of the present order, using the wordmark ***“The Darzi-THE SUIT PEOPLE 1981-SUNIL & SUSHAIN MITTAL”*** for stitching, offering or selling any kind of merchandise, advertising in any kind of active or subsequent print media, billboard, product, label/ sign, packaging, stationeries, wrappers, receptacles, and any goods, accounts, including but not limited to Facebook,

Instagram, WhatsApp or like on the social media and depict the logo/label mark “*The Darzi-THE SUIT PEOPLE 1981-SUNIL & SUSHAIN MITTAL*” as under:-



c. In the interregnum, both parties shall be free to dispose of their existing stocks of all the earlier stocks of any the earlier word/ label marks save and except what is devised/ detailed hereinabove within the period of *sixty days* from the passing of the present order and endeavor and put in their best efforts to dispose them prior to the expiry of the said period of *sixty days* from the passing of the present order.

d. After the expiry of the said period of *sixty days* from the passing of the present order, in due adherence to the above, both parties shall stop usage and instead destroy, damage, repair, change all the earlier stocks of any the earlier word/ label marks save and except what is devised/ detailed hereinabove.

16. It is clarified that both the aforesaid interim arrangement is a stop-gap arrangement which will be binding upon both parties till the adjudication of the dispute by way of a final decree passed by a Court of law or by way of any subsequent arrangement, if any, arrived between the parties or by any other means legally permissible. Needless to say, till such time the

adjudication is arrived at by any of the modes specified hereinabove, both parties shall remain bound by the aforesaid interim arrangement. It is also specified that the observations made by this Court in the present order are not final and/ or conclusive and will be subject to change. Albeit, till such time, nothing in the present order will come in the way of the learned Single Judge in adjudicating the disputes inter-se the parties involved in the suit on merits.

17. Irrespective of the above, although none of the parties shall use the word/ label marks as devised/ detailed hereinabove, however, both parties shall be free to proceed against each other with respect to the registrations of the earlier word/ label marks in any Court(s) of law. Any fresh cause of action shall give rise to a fresh institution of proceeding(s) and both parties will be free to take appropriate steps as available to them in accordance with the law.

18. In view of the aforesaid, the impugned order dated 19.04.2017 under challenge stands modified to the extent specified in *paragraph 15* hereinabove. Accordingly, for the afore-going reasons, the present appeal along with all the applications, if any, is disposed of with no order as to costs and leaving the parties to bear their own respective costs.

SAURABH BANERJEE, J.

MANMOHAN, J.

MAY 12, 2023

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