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

Date of Decision: 29th February, 2024

+ CS(COMM) 407/2023 & I.A. 11201/2023

VERIZON TRADEMARK SERVICES LLC & ORS. Plaintiffs

Through: Ms. Vaishali Mittal and Mr. Shivang
Sharma, Advocates.

versus

LATHIYA HANSHABEN ARVINDBHAI & ANR. Defendants

Through: None.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA

JUDGMENT

SANJEEV NARULA, J. (Oral):

1. Plaintiff No. 1 ('Verizon Trademark Services LLC'), an intellectual property holding company, is the proprietor of numerous trademarks consisting of/ incorporating the mark 'VERIZON'. Plaintiff No. 1 granted exclusive licence to Plaintiff No. 2 ('Verizon Licensing Company') for use of the trademark 'VERIZON' as well as the 'VERIZON' logos. Plaintiff No.2 then further granted an exclusive sub-license to Plaintiff No. 3 ('Verizon Communications India Private Ltd.') in accordance with the terms of the license agreement entered into with Plaintiff No. 1.

2. Plaintiffs are part of the Verizon group of companies, being among the world's leading providers of, *inter alia*, communications, information technology and security products/ services. They own and operate one of the most expansive end-to-end global Internet Protocol networks serving more



than 2,700 cities in over 150 countries worldwide, including India. Plaintiffs have coined and adopted the mark ‘VERIZON’, derived from the Latin word ‘Veritas’ (connoting certainty and reliability) and ‘Horizon’ (signifying forward looking and visionary), which is used as their trade name.

3. Plaintiffs have filed the present suit for infringement and passing off in respect of their registered trademarks and logos – ‘VERIZON’,

‘’, ‘’, ‘’, and its variants such

as – ‘’, ‘’, and ‘’, [collectively,

“**VERIZON Trademarks**”]. Plaintiffs have secured registrations in over 200 countries, with earliest registrations in India dating back to the year 2000. Details of Plaintiffs’ trademark registrations in India under various Classes have been set out at Paragraph No. 28 of the plaint. Plaintiff uses the VERIZON Trademarks for a wide range of products and services primarily in the telecommunications sector. The registrations also suggest that use of the VERIZON Trademarks is not limited to these areas, as the Plaintiffs continue to expand their services and products.

4. Plaintiffs have been using the VERIZON Trademarks extensively, continuously and uninterruptedly since their adoption in and about the year 2000. Further, they have expended heavily towards advertisement and promotion of their goods/ services, details whereof have been delineated at Paragraph No. 16 of the plaint. Consequently, Plaintiffs have acquired substantial goodwill and reputation in their VERIZON Trademarks, which



have become a source identifier solely and exclusively for the Plaintiffs' goods and services. Details of the significant global revenues generated by the Plaintiffs, reflecting their worldwide goodwill and reputation, are reproduced as under:

"Year"	Revenues (in Billion USD)
2001	67.2
2002	67.3
2003	67.8
2004	71.3
2005	75.0
2006	88.2
2007	93.5
2008	97.4
2009	107.8
2010	106.6''

5. Plaintiffs are aggrieved by the Defendants' dishonest adoption of the mark/ brand name 'VRIZON' [**"Impugned Mark"**], used in respect of *inter alia* various household and kitchenware goods. Pursuant to finding Defendants' trademark application No. 4300781 for registration of the Impugned Mark on a '*Proposed to be Used*' basis, Plaintiffs issued several cease-and-desist notices, however, no response was received despite attempts to follow up. In such circumstances, the Plaintiffs approached this Court asserting that the Impugned Mark is deceptively similar to their VERIZON Trademarks, thereby amounting to infringement under Section 29(4) of the Trade Marks Act, 1999 [**"Act"**].



6. On 1st June, 2023, finding a *prima facie* case in favour of the Plaintiffs, this Court granted an *ex-parte ad-interim* injunction in the following terms:

“22. The Court has considered the aforementioned submissions. Plaintiffs are the prior adopter, user and registered proprietor/ licensee/ sub-licensee of VERIZON trademarks. The dishonesty on part of Defendants is evident view of the use of slavish imitation of Plaintiffs’ well-known VERIZON trademarks. Defendants are brazenly violating Plaintiffs’ rights in VERIZON trademarks with dishonest intent to create unauthorised association with the Plaintiffs by taking unfair advantage of the reputation garnered by Plaintiffs, over several years. The use of infringing mark is highly detrimental to the distinctive character and reputation of VERIZON trademarks. In light of the fore-going, Court is of the opinion that a *prima facie* case of infringement is made out in favour of Plaintiffs. Balance of convenience also lies in favour of Plaintiffs and in case an *ex-parte adinterim* order of injunction is not granted, irreparable loss would be caused to Plaintiffs. Accordingly, till the next date of hearing, Defendants and any one acting on their behalf are restrained from manufacturing, marketing, selling, offering for sale or providing goods and/ or services or in any manner using the infringing mark ‘VRIZON’ and/ or any other mark(s) deceptively similar to ‘VERIZON’, as part of goods or services.”

7. Thereafter, Defendants were served with summons in the suit, however, they have not appeared or filed any written statement. Accordingly, by way of order dated 6th November, 2023, Defendants were proceeded *ex-parte* and the aforementioned interim injunction was made absolute. Pertinently, in view of the fact that overall condonable limit of 120 days for filing the written statement has expired, their right to do so also stands closed. In such circumstances, Ms. Vaishali Mittal, counsel for Plaintiffs, presses for an *ex-parte* summary decree in terms of Order VIII Rule 10 read with Order XIII-A of the Code of Civil Procedure, 1908 (CPC). In light of the above, the Court has proceeded to adjudicate the present matter by assessing the Plaintiffs’ case for infringement under



Section 29(4) of the Act on the basis of the pleadings and documents on record.

8. Plaintiffs have, through documents, established their ownership over the VERIZON Trademarks, which have been registered under various classes and such registrations continue to be valid and subsisting. Moreover, Ms. Mittal has pointed out that during the course of the present proceedings, a coordinate Bench of this Court, in *Verizon Trademark Services LLC & Ors. and Vikash Kumar*¹, has held the mark ‘VERIZON’ to be a well-known trade mark within the meaning of Section 2(1)(zg) read with Section 11(6) of the Act. Considering the above, and given their significant revenue and marketing expenditure as noted above, Plaintiffs have established their substantial goodwill and reputation in the VERIZON Trademarks.

9. Defendants do not have any registration in respect of the Impugned Mark. In fact, their trademark application No. 4300781, against which opposition was filed by the Plaintiffs, has since been abandoned, and is reflected as such on the Trademark Registry website. Further, Defendants have not received any authorization from the Plaintiffs for their adoption of the Impugned Mark to qualify as ‘permitted use’ in the course of trade.

10. A comparison of the competing marks reveals that the Impugned Mark ‘VRIZON’ is a blatant imitation of the Plaintiffs’ mark ‘VERIZON’. They are phonetically, visually and structurally similar — the Impugned Mark merely drops the letter ‘E’ from ‘VERIZON’, which is insufficient for the purposes of distinguishing the same from the Plaintiffs’ mark, which is an original coined word. Thus, the Defendants’ Impugned Mark is identical/

¹ Judgment dated 11th July, 2023, in CS(COMM) 220/2023; DHC Neutral Citation No. – 2023:DHC:4911



deceptively similar to the Plaintiffs’ registered VERIZON Trademarks.

11. The Defendants’ trademark application seeks registration for ‘VRIZON’ under Class 21, which encompasses household and kitchenware items — a category distinctly separate from the Plaintiffs’ array of goods and services which primarily include communications, information technology, and security solutions. Moreover, the Defendants filed their application in the year 2019 on a ‘*Proposed to be Used*’ basis. Contrastingly, the Plaintiffs have shown that they have extensively and continuously utilized the VERIZON Trademarks since their inception in the year 2000, thereby affirming their status as the prior user of the mark.

12. Plaintiffs have thus unequivocally established through their pleadings and documentary evidence that the present case meets all the criteria for infringement as outlined in Section 29(4) of the Act:

12.1. The “Identity or Similarity” criterion is conclusively satisfied, owing to the phonetic and visual similarities between Defendants’ Impugned Mark “VRIZON” and the Plaintiffs’ VERIZON Trademarks.

12.2. The Defendants’ deployment of the Impugned Mark in course of trade, specifically targeting household and kitchenware under Class 21, substantiates the “Use of the Mark” requirement. This application distinctly diverges from the Plaintiffs’ focus on telecommunications and IT services, thus fulfilling the “Goods or Services Not Similar” criterion.

12.3. Moreover, the Defendants’ choice of the ‘VRIZON’ mark, devoid of any justifiable cause shown to the Court, is clearly an attempt to capitalize on the Plaintiffs’ well-established mark and take unfair advantage of the same.



12.4. Plaintiffs have also thoroughly substantiated the reputation of the VERIZON Trademarks in India through their annual reports evidencing revenue generated and promotional expenses. Further, this Court has also affirmed the well-known status of the 'VERIZON' mark, reinforcing its significance and protection under the law.

12.5. In view of the striking similarity between the competing marks, the Defendants' use of 'VRIZON' is bound to mislead the public, thereby diluting the distinctive character and reputation of the Plaintiffs' registered VERIZON Trademarks. Thus, Defendants' adoption and use of 'VRIZON' also meets the "Unfair Advantage or Detriment" criterion.

13. In light of the above, the Defendants' intended use of the Impugned Mark 'VRIZON' for products unrelated to those associated with the VERIZON Trademarks renders them liable for infringement claims under Section 29(4) of the Act. Thus, the instant suit is liable to be decreed in favour of the Plaintiffs as per Order VIII Rule 10 read with Order XIII-A of the CPC, as applicable to commercial suits, and Rule 27 of the Delhi High Court Intellectual Property Rights Division Rules, 2022.

14. Although Plaintiffs have also sought damages and legal costs in terms of prayers sought at Paragraphs No. 78 (v) and (vi) of the plaint, the Court does not find any reason to grant the same, in view of the fact that the Defendants' now abandoned trademark application was filed on a 'Proposed to be Used' basis, and no evidence of actual use of the Impugned Mark has been placed on record other than a few screenshots of listings on third party e-commerce websites. The prayer for declaration of the VERIZON Trademarks as 'well-known' marks is also not being considered by the



Court in the present case, given that an *ex-parte* decree is being passed with no contest by the Defendants. As regards the remaining prayers, Ms. Mittal states that the same are not being pressed in the present proceedings.

15. Accordingly, a decree of permanent injunction is granted in favour of the Plaintiffs and against the Defendants in terms of the prayer sought at Paragraph No. 78(i) of the plaint.

16. Decree sheet be drawn up.

17. The present suit, along with pending applications, is disposed of.

SANJEEV NARULA, J

FEBRUARY 29, 2024

as

(Corrected and released on: 16th March, 2024)