



2024:DHC:7355-DB



\$~48 & 49

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

%

*Date of decision: 19.09.2024*

+ **FAO(OS)(COMM) 144/2021 & CM APPL. 40965/2021**

DESIGNARCH CONSULTANTS PVT LTD AND ANR

.....Appellants

Through: Ms Shwetasree Majumder, Ms Diva Arora Menon, Mr Rohan Krishna Seth and Ms Shilpi Sinha, Advocates.

versus

JUMEIRAH BEACH RESORT LLC

.....Respondent

Through: Mr Jayant K. Mehta, Senior Advocate with Mr Naqeeb Nawab, Ms Sejal Tayal, Ms Apurva Bhutani, Mr Ashutosh Ranga, Mr Rajat Sinha, Advocates.

+ **FAO(OS)(COMM) 181/2021 & CM. 46584/2021**

JUMEIRAH BEACH RESORT LLC

.....Appellant

Through: Mr Jayant K. Mehta, Senior Advocate with Mr Naqeeb Nawab, Ms Sejal Tayal, Ms Apurva Bhutani, Mr Ashutosh Ranga, Mr Rajat Sinha, Advocates.

versus

DESIGNARCH CONSULTANTS PRIVATE LIMITED & ANR.

.....Respondent

Through: Ms Shwetasree Majumder, Ms Diva Arora Menon, Mr Rohan Krishna Seth and Ms Shilpi Sinha, Advocates.

**CORAM:**

**HON'BLE MR. JUSTICE RAJIV SHAKDHER**

**HON'BLE MR. JUSTICE AMIT BANSAL**

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FAO(OS) (COMM) 144/2021 & 181/2021

Page 1 of 8



2024:DHC:7355-DB



**[Physical Hearing/Hybrid Hearing (as per request)]**

**AMIT BANSAL, J. (ORAL)**

1. The present cross-appeals have been filed against the impugned judgment dated 9<sup>th</sup> November, 2021 passed by the learned Single Judge in CS(COMM)124/2021. By way of the impugned judgment, the application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (hereinafter referred to as the ‘CPC’) filed by the plaintiff/Jumeirah Beach Resort LLC (hereinafter referred to as “Jumeirah”), was decided.

2. The learned Single Judge partly allowed the application filed by Jumeirah and restrained the defendants, Designarch Consultants Pvt. Ltd. and Designarch Infrastructure Pvt. Ltd. (hereinafter collectively referred to as “Designarch”) from using the marks ‘BURJBANGALORE’, ‘BURJMUMBAI’, ‘BURJDELHI’, ‘BURJGURUGRAM’ and ‘BURJGURGAON’ till the pendency of the said suit. However, since the residential project ‘BURJNOIDA’ was in construction for the last ten years, the learned Single Judge allowed the use of the mark ‘BURJNOIDA’ for the said project.

3. During the course of hearing of the appeals, the terms of a possible settlement were discussed with the counsel appearing on behalf of the parties on 3<sup>rd</sup> September, 2024, 17<sup>th</sup> September, 2024 and 18<sup>th</sup> September, 2024.

4. At the hearing today, i.e., 19<sup>th</sup> September, 2024, counsel for the parties, on instructions from their respective clients, have agreed to the following terms of settlement:

I. Jumeirah acknowledges that Designarch are the owners of the

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17:26:09

FAO(OS) (COMM) 144/2021 & 181/2021

Page 2 of 8



2024:DHC:7355-DB



trademark “BURJNOIDA” and the logo ‘

II. Designarch acknowledge that Jumeirah is the owner of the trademark



“BURJ AL ARAB” and the logo ‘

III. Designarch shall not make any modifications to the “BURJNOIDA” tower as depicted in the photograph dated 20<sup>th</sup> August, 2024, annexed herewith as **Annexure-A**.

IV. Designarch undertake to withdraw the cancellation petitions filed against Jumeirah’s mark within seven (7) working days, as detailed below:

| Mark                                   | Application No. | Class     | Status                                                                       |
|----------------------------------------|-----------------|-----------|------------------------------------------------------------------------------|
| <i>Jumeirah Beach Resort LLC Marks</i> |                 |           |                                                                              |
| <i>BURJ AL ARAB</i>                    | <i>1253325</i>  | <i>35</i> | <i>Cancellation filed by Designarch.<br/>C.O.<br/>(COMM.IPD-TM)130/ 2023</i> |
|                                        |                 | <i>36</i> | <i>Cancellation filed by Designarch.<br/>C.O.<br/>(COMM.IPD-TM)131/ 2023</i> |
|                                        |                 | <i>39</i> | <i>Cancellation filed by Designarch.</i>                                     |

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17:26:09

FAO(OS) (COMM) 144/2021 & 181/2021

Page 3 of 8



2024:DHC:7355-DB



|  |  |    |                                                                                       |
|--|--|----|---------------------------------------------------------------------------------------|
|  |  |    | <i>C.O.<br/>(COMM.IPD-<br/>TM)132/ 2023</i>                                           |
|  |  | 41 | <i>Cancellation filed<br/>by Designarch.<br/>C.O.<br/>(COMM.IPD-<br/>TM)133/ 2023</i> |
|  |  | 42 | <i>Cancellation filed<br/>by Designarch.<br/>C.O.<br/>(COMM.IPD-<br/>TM)134/ 2023</i> |

V. Jumeirah undertakes to withdraw the cancellation petitions filed against Designarch's marks within seven (7) working days, as set forth below:

| <i>Mark</i>                                                                         | <i>Application No.</i> | <i>Class</i> | <i>Status</i>                                                                           |
|-------------------------------------------------------------------------------------|------------------------|--------------|-----------------------------------------------------------------------------------------|
| <i>BURJNOIDA</i>                                                                    | 2093367                | 37           | <i>Cancellation<br/>filed by Jumeirah<br/><br/>C.O.<br/>(COMM.IPD-<br/>TM) 124/2022</i> |
|  | 4112395                | 37           | <i>Cancellation<br/>filed by Jumeirah<br/><br/>C.O.<br/>(COMM.IPD-<br/>TM) 315/2022</i> |

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Signing Date:23.09.2024

17:26:09

FAO(OS) (COMM) 144/2021 & 181/2021

Page 4 of 8



2024:DHC:7355-DB



Designarch or their employees, agents and directors will not use the mark



“BURJNOIDA” and the logo “ ” to suggest any connection with or relation to Jumeirah, in any manner whatsoever.

VI. Designarch undertake to withdraw the oppositions filed against Jumeirah’s marks within seven (7) working days, as per the details given below:

| <i>Mark</i> | <i>Application No.</i> | <i>Class</i> | <i>Status</i>                                                   |
|-------------|------------------------|--------------|-----------------------------------------------------------------|
| <i>BURJ</i> | <i>4880347</i>         | <i>39</i>    | <i>Opposition filed by Designarch<br/>Opposition No-1108306</i> |
| <i>BURJ</i> | <i>4880351</i>         | <i>41</i>    | <i>Opposition filed by Designarch<br/>Opposition No-1108307</i> |
| <i>BURJ</i> | <i>4880353</i>         | <i>43</i>    | <i>Opposition filed by Designarch<br/>Opposition No-1269701</i> |

VII. Designarch covenant and agree not to design, construct or develop any building that is identical and/or resembles the pictorial reference given in **Annexure-B**.

VIII. Jumeirah undertakes to withdraw the opposition filed against Designarch’s mark within seven (7) working days, as per the details given below:

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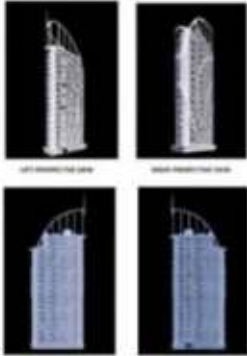
FAO(OS) (COMM) 144/2021 & 181/2021

Page 5 of 8



2024:DHC:7355-DB



| <i>Mark</i>                                                                       | <i>Application No.</i> | <i>Class</i> | <i>Status</i>                                                     |
|-----------------------------------------------------------------------------------|------------------------|--------------|-------------------------------------------------------------------|
|  | 4674363                | 06           | <i>Opposed by<br/>Jumeirah vide<br/>Opposition<br/>No.1106513</i> |

IX. Designarch undertake not to apply for or use in any manner BURJ or any BURJ formative mark other than BURJNOIDA in the future. Designarch further undertake to withdraw their pending trademark applications, as detailed in the table below within seven (7) working days:

| <i>Mark</i>          | <i>Application No.</i> | <i>Class</i> | <i>Status</i>   |
|----------------------|------------------------|--------------|-----------------|
| <i>BURJBANGALORE</i> | 2093371                | 37           | <i>Objected</i> |
| <i>BURJMUMBAI</i>    | 3982207                | 37           | <i>Objected</i> |
| <i>BURJGURUGRAM</i>  | 4179766                | 37           | <i>Opposed</i>  |

X. The settlement terms agreed by the parties are final and irrevocable. The settlement shall bind the parties, their successors, representatives and assigns.

5. The appeals are disposed of in terms of the aforesaid settlement.

6. All pending applications shall stand closed.

**AMIT BANSAL, J**

**RAJIV SHAKDHER, J**

**SEPTEMBER 19, 2024/kd**

[Click here to check corrigendum, if any](#)

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Signing Date:23.09.2024

17:26:09

FAO(OS) (COMM) 144/2021 & 181/2021

Page 6 of 8



2024:DHC:7355-DB



## Annexure-A

ANNEXURE A

5

PHOTOGRAPHS OF THE BURJ NOIDA RESIDENTIAL BUILDING AS  
ON 20 AUGUST 2024



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Signing Date:23.09.2024

17:26:09

FAO(OS) (COMM) 144/2021 & 181/2021

Page 7 of 8



2024:DHC:7355-DB



## ANNEXURE-B



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Digitally Signed By:KOMAL

DHAWAN

Signing Date:23.09.2024

17:26:09

FAO(OS) (COMM) 144/2021 & 181/2021

Page 8 of 8