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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ **FAO (COMM) 215/2024, CM APPL. 63863/2024 (Stay), CM APPL. 63864/2024 (Summoning Of Electronic Record)**

ARVI LIGHTS & ORS.Appellants
Through: **Mr. J. Sai Deepak, Mr. Shravan Kr. Bansal, Mr. Amit Chanchal Jha and Mr. Abhishek Avdhani, Advs.**
versus

AMAR GUPTARespondent
Through: **Mr. Raj Shekhar Rao, Sr. Adv. with Mr. Nischal Anand, Mr. Siddharth Arora and Ms. V. Gupta, Advs.**

CORAM:
HON'BLE MR. JUSTICE YASHWANT VARMA
HON'BLE MR. JUSTICE RAVINDER DUDEJA

ORDER
% **04.11.2024**

1. The appellants seek to impugn the order dated 04 September 2024 passed by the Trial Judge which has in essence affirmed the ex parte injunction which had been granted on 06 May 2024 and has simultaneously rejected the application under Order XXXIX Rule 4 of the **Code of Civil Procedure, 1908¹** in terms of which the appellants had sought vacation of that order.
2. The suit itself came to be instituted with the respondent-plaintiff alleging infringement of the marks '*Baisun*' as adopted by it and in respect of which it held a registration under the **Trade Marks Act**,

¹ CPC



1999² in Class 11. It was averred by the respondent-plaintiff that ‘*Baisun*’ as a trademark had been exclusively used by it by virtue of the registration which came to be granted in its favour under the TM Act on 08 November 2017. The plaintiff had further asserted that the mark ‘*Baisun*’ as a distinctive trade dress/logo had been adopted by it in the year 2011 and although registration in respect thereof had been sought in terms of an application made under the TM Act in 2016, the same was presently lying in opposition. It was alleged that the appellant-defendant had dishonestly adopted the mark ‘*Baisun*’ owned by the respondent-plaintiff. It was on the basis of the aforesaid facts that the Trial Judge had come to issue an ex parte order on 06 May 2024.

3. The appellant-defendant upon being placed on notice, petitioned for the vacation of that order by moving an application referable to Order XXXIX Rule 4 of the CPC. It was their case that the Baisun Group of Companies incorporated in the **People’s Republic of China**³ had adopted and started using the trade mark ‘*Baisun*’ and related logos from as far back as 2007. It was averred that the trade mark and logo relating to the Baisun Group of Companies was registered by the Trade Marks Registry of PRC in 2008. The submission essentially was that since the products of the Chinese entity were present in India consequent to having being lawfully imported, the ex parte injunction as granted was clearly unsustainable.

4. We had by and in terms of our order rendered on **M/s Arvi Lights And Ors. v. M/s Big Deeper Industries LLP And Anr.**⁴ and which appeal came to be disposed of by a separate judgment rendered

² TM Act

³ PRC

⁴ FAO(COMM) 214/2024



today, examined the scope of extra territorial reputation and the rights which could be claimed by owners of well-known trademarks notwithstanding those not being registered in India. We had in that context taken note of the enunciation of the legal position as it appears in **Bolt Technology OU v. Ujoy Technology Private Limited and Another**⁵.

5. However, and distinguishable from the facts as they obtained in *Big Deeper Industries*, we find that the appellants here did not rest their claim on any authorization granted by the PRC entity nor did they produce or lead any evidence in support of a valid import of goods bearing the mark ‘*Baisun*’ and thus establishing, at least prima facie, those marks having acquired a cross border reputation and presence in India.

6. Mr. Sai Deepak, learned counsel appearing for the appellant-defendant, however, sought to draw sustenance from a judgment rendered by the Court in **MAC Personal Care Pvt. Ltd. v. Laverana GMBH and Co. KG & Anr.**⁶ where while dealing with international reputation, the Court had observed as follows:-

“14. The concept of trans-border reputation has grown quite considerably through case law, which has been noted by the learned Single Judge, and the judgments referred to by the learned Single Judge have been noted by us in paragraph 7 above. We therefore need not rewrite the same. The concept of trans-border reputation essentially means that a plaintiff wishing to enforce its unregistered trademark in India need not necessarily have a commercial use in the Indian market in order to maintain an action for passing off. International reputation and renown may suffice if the same spills over to India.

15. Thus, there are two elements to the above, namely: -

(i) That there is an international reputation inuring in a trademark in favour of the plaintiff on account of use made overseas; and

⁵ 2023 SCC OnLine Del 7565

⁶ 2016 SCC OnLine Del 530



(ii) The reputation spills over to India.

16. With the growth of the internet and the modern means of communication including radio, television and broadcasting, the second element is relatively easier to establish as compared to the position which existed even one decade ago. In fact, each new telecom technology (e.g. for 2G to 4G) increased band width enabling more and more to be achieved on say a hand-held cell phone. Therefore, standing anywhere within the country at any time pressing a few buttons, a person is able to view international trademarks with such ease that the spill over factor has become quite easy to establish.

17. But as regards the first element, of having a reputation in an international market, the question does arise as to the extent and magnitude of the reputation in order for it to be considered adequate to prima-facie satisfy the first condition of trans-border reputation; justifying the grant of an interim injunction pending trial.

18. In our opinion anything done at a commercial level should suffice to achieve the prima-facie satisfaction unless it can be called de minimis or trivial. Even if one is to assess in a rough way the amount or magnitude of the international reputation, there can be certain factors which assists in this process. If the trademark is registered in favour of the plaintiff in a jurisdiction abroad, said fact would demonstrate : -

- (i) That the proprietor has declared to the world that the subject matter is its trademark;
- (ii) That the declaration has been made in a public record open to inspection under the Trademark Laws of most jurisdictions; and
- (iii) That in all probability, the Registering Authority of the registering country satisfied itself that the mark was distinctive and therefore, capable of distinguishing the Registrant's Trademark from those of other traders.

19. As against a single registration, registrations in multiple jurisdictions create an even stronger presumption that reputation inures in favour of the trademark.”

7. According to Mr. Sai Deepak, a registration in multiple jurisdictions was sufficient for maintaining the prayer for vacation of the ex parte injunction which had been granted. This, learned counsel contends, clearly flows from what the Court in *MAC Personal Care* came to observe in paragraph 19 of that report.



8. We, however, find ourselves unable to sustain that submission for the following reasons. As would be manifest from a reading of paragraph 15 of the aforementioned decision, it becomes apparent that spillage of reputation constitutes an essential and indelible ingredient for the purposes of establishing cross-border reputation. These aspects were duly highlighted by us even in *Bolt* and where we had held that notwithstanding registration in multiple jurisdictions, spill over and cross border reputation would be issues of fact which would have to be independently established.

9. However and in light of the conceded failure of the appellant to lead any evidence in support of cross-border reputation, we find no justification to interfere with the injunction as granted.

10. The appeal consequently fails and shall stand dismissed.

YASHWANT VARMA, J.

RAVINDER DUDEJA, J.

NOVEMBER 04, 2024/DR