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

Date of Decision: 21st March, 2024

+ **CS(COMM) 1614/2016**

VISAKHA CHEMICALS

..... Plaintiff

Through: Mr. Shailen Bhatia, Ms. Zeba Tarannum Khan, Mr. Arnav Chatterjee and Ms. Deeksha Gulati, Advocates.

versus

BINDAL FOOD PRODUCTS

..... Defendant

Through: *Ex-parte vide* order dated 15th December, 2015.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA

JUDGMENT

SANJEEV NARULA, J. (Oral):

1. The case at hand involves a dispute over intellectual property rights between two companies, both engaged in the production and marketing of Ayurvedic medicinal products like digestive powders (*churan*) and tablets. M/s Visakha Chemicals, the Plaintiff, claims ownership of the trademark rights for “ROCHAK” and “AM PACHAN,” along with the trade dress rights for their product packaging. Asserting their prior usage and statutory rights, they accuse the Defendant of trademark infringement and passing off, due to deployment of trademarks and product packaging that bears a deceptive resemblance to their own. Despite initially challenging the



Plaintiff's allegations, the Defendant ceased participation at the onset of the trial. As a result, on 15th December, 2015 the Court proceeded *ex-parte* against the Defendant. Following this, the Plaintiff produced their oral evidence in the absence of the Defendant, which remains uncontroverted, bringing this case to the point of final adjudication.

THE PLAINTIFF'S CASE

2. Mr. Shailen Bhatia, counsel for Plaintiff, presents the following facts and contentions:

2.1. The Plaintiff is a registered partnership firm that is engaged in the business of manufacturing and marketing of Ayurvedic and medicinal products, such as *churan* and tablets for digestive purposes, since the year 1982. In the same year, they adopted the trademark "ROCHAK" for *churan* tablets. Alongside the trademark, the Plaintiff also developed the following unique label/ pouch to pack the said goods:



2.2. During the course of their business operations, the Plaintiff modified



the above packaging to “ and then



“ ”¹

2.3. Later, in the year 1985, the Plaintiff adopted the trademark “AM PACHAN” for another kind of *churan* tablets manufactured by them along



with the packaging “ ”, which was first changed to



“ ” and then “ ”²



¹ All three versions of the label shall collectively be referred to as “Rochak labels”.

² All three versions of the label shall collectively be referred to as “Am Pachan labels”.



2.4. Notwithstanding the change in the outer packaging/ label, the unique features thereof remained consistent in all the versions of the “ROCHAK” and “AM PACHAN” products. The distinctive elements of the Rochak labels include the blue, white and red colour combination, graphical representations of a boy, spoons, two-toned red plate, font size and colour of the mark “ROCHAK” in English and Devnagri script. Similarly, all the Am Pachan labels bear a colour combination of green, red, white and yellow, artistic devices of a mango and children, with “AM PACHAN” written in English and Hindi languages in the same manner.

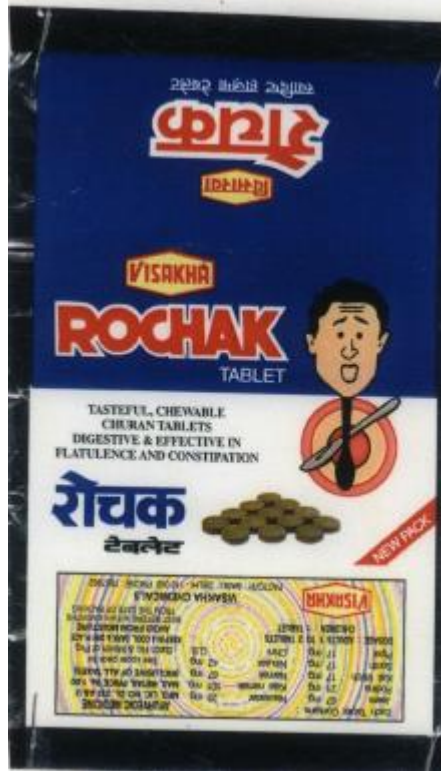
2.5. The Plaintiff filed for registration of the mark “ROCHAK” on 25th January, 1988. This registration was granted, and the said trademark is presently registered in their name under No. 484698 in class 05 in respect of “*Ayurvedic preparations including digestive power and tablets, balm (pain killer).*”

2.6. The Plaintiff has also obtained registration of copyright in the Rochak and Am Pachan labels, details whereof are as follows:

<i>Title</i>	<i>Artistic Work</i>	<i>Registration Number</i>
ROCHAK		A-61431/2002



ROCHAK



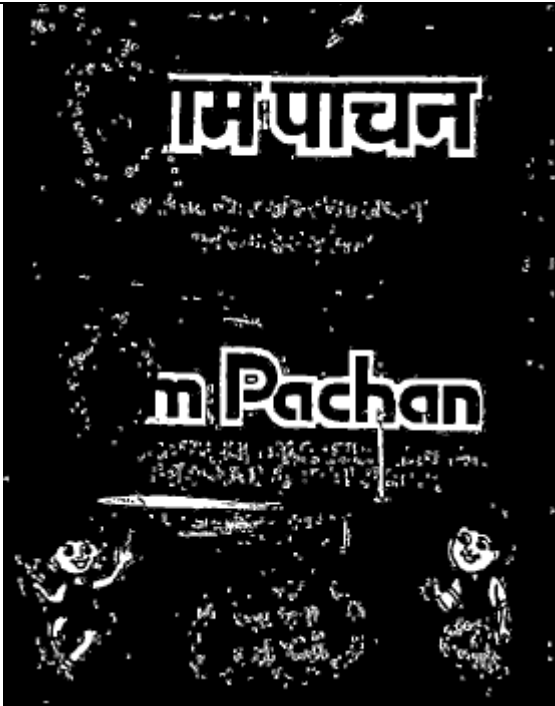
A-64130/2003

ROCHAK



A-64132/2003



AMPACHAN		A-58545/2001
AMPACHAN		A-61480/2002

2.7. Of all the products manufactured by Plaintiff, about 50% of their sales pertain to “ROCHAK” product and about 48% are of the “AM PACHAN” product. These products are thus, the most prevalent goods manufactured by the Plaintiff. The Plaintiff has also conducted substantial business under the trademarks “ROCHAK” and “AM PACHAN”, which is established by the sales figures and advertisement expenses, details whereof have been set out



in paragraphs No. 7 and 8 of the plaint.

2.8. On the basis of evidence provided, the Plaintiff has established significant goodwill and reputation for the trademarks “ROCHAK” and “AM PACHAN,” which have become exclusively linked to the Plaintiff’s products. The consistent and uninterrupted use since 1982/ 1985, has resulted in the trademarks acquiring a secondary meaning within the market, signifying that these trademarks not only identify the goods, but also denote the Plaintiff’s unique source and quality.

2.9. In September 2002, the Plaintiff was alerted to the unauthorized sale of Ayurvedic medicinal products, particularly *churan* and digestive tablets, bearing their trademarks “ROCHAK” and “AM PACHAN” in Delhi and its neighbouring states. The Plaintiff filed criminal complaint against such misappropriation of their trademarks and copyright by unknown persons. The police investigation conducted pursuant to the orders of the Additional Chief Judicial Magistrate, Patiala House Court, New Delhi, identified Defendant as the source of the impugned goods. However, despite the criminal complaint and consequent arrest of their proprietor, the Defendant did not cease the sale and distribution of impugned goods under the trademarks “ROCHAK” and “AM PACHAN” and the labels



“” and “”.³ Faced with Defendant’s persistent infringement, the Plaintiff filed the present suit for restraining the Defendant from using the Plaintiff’s trademark “ROCHAK” and “AM PACHAN” as also the label/ packaging /trade dress utilized for the goods sold under the aforementioned trademarks.

2.10. In the meantime, the Defendant filed a suit for permanent injunction, declaration, and damages against the Plaintiff before the District Court in Delhi. In the said suit, the Defendant has admitted that they are using the terms “ROCHAK” and “AM PACHAN” for the products in question, but contends that no person can have rights in the said words as they are common to trade. Thus, the Defendant’s suit seeks to restrain Plaintiff from using the words “ROCHAK” and “AM PACHAN” as trademarks as well as the associated trade dress/ packaging.

2.11. The use of identical marks “ROCHAK” and “AM PACHAN” by the Defendant for identical products is bound to cause confusion and deception amongst the purchasing public and trade, who will be misled into buying the Defendant’s impugned goods. The Defendant is intending to ride on the Plaintiff’s unrivalled standing in the market, thereby, impinging their rights in the trademarks “ROCHAK” and “AM PACHAN” and their labels.

³ Collectively referred as impugned labels.



Defendant's contest to the suit

3. The Defendant's contentions, as set out in the amended written statement, are as follows:

3.1. The words "ROCHAK" and "AM PACHAN" cannot be extended trademark protection as they are both generic words, having a dictionary meaning. The word "ROCHAK" means interesting. Whereas, "AM PACHAN" is a combination of two Hindi words – "AM" and "PACHAN" that translate to "mango" and "digestion", respectively. Thus, the combination of two words "AM" and "PACHAN" would mean a digestive product made from mango.

3.2. The two words are neither arbitrary nor fanciful or coined words, which when used in relation to the goods in question – Ayurvedic and medicinal products including *churan* and digestive tablets – would purely describe their character and quality. The use of the terms "ROCHAK" and "AM PACHAN" on the said goods directly conveys the ingredients contained therein. There are several contenders in the market who are also using these terms for their products. To support this contention, the Defendant has filed the trademark search results for "ROCHAK". Therefore, Defendant contends that Plaintiff's registration of the mark "ROCHAK" in class 05 is invalid and cannot be sustained.

3.3. The Defendant sells their products under the trademark "ANMOL-G", which is prominently displayed on the labels and uses the term "ROCHAK" and "AM PACHAN" in a descriptive sense. The Plaintiff's brand name is "VISAKHA", which is distinct from the Defendant's trademark "ANMOL-G"; the pouches/ labels/ trade dress utilised by both parties are also different.

3.4. One M/s Bajaj Food Products obtained registration of the trademark



“ROCHAK” under No. 447376 in class 30 for breads, biscuits, cakes, pastries, and confectionary. This registration has been assigned to the Defendant under the Assignment Deed dated 05th March, 2004. The Defendant has completed the formalities to effect this change on the Trademarks Registry’s record. Thus, the Plaintiff cannot interfere with the Defendant’s rights to use their registered trademark “ROCHAK” in view of Section 30(2)(e) of the Trademarks Act, 1999.

3.5. By virtue of their longstanding operations and wide publicity, the Defendant’s goods sold under the marks “ROCHAK” and “AM PACHAN” have acquired tremendous goodwill and reputation in the market. They are distinctive and solely associated with the Defendant.

3.6. Assuming Plaintiff does possess proprietary rights in the words “ROCHAK” and “AM PACHAN”, given the Defendant’s honest and concurrent user thereof since long, there can be no violation of the Plaintiff’s copyright and trademarks.

3.7. The Plaintiff is not the creator of the Rochak and Am Pachan labels. These labels are registered in the name of Mr. Ratan Lal Poddar, and there has been no assignment in the Plaintiff’s favour. Thus, Plaintiff has no locus to initiate the present suit. Further, the Plaintiff claims that these labels were first published in 1982 and 1985, however, at that time, Mr. Poddar would have been about 16 and 18/19 years old, respectively. Being a minor in 1982, he could not have designed the labels or entered into a contract in respect thereof.

3.8. The Plaintiff-firm was constituted in 1986 and Mr. Poddar joined the firm on 01st April, 1987. Both of these events occurred after the claimed date of first publication of the Rochak and Am Pachan labels, which further raise



doubts over the Plaintiff's case that they invented the said labels.

LITIGATION INTER-SE THE PARTIES

4. On service being effected, the Defendant appeared and contested the suit by filing a written statement on 16th July, 2004, which was subsequently permitted to be amended on 17th May, 2006. Alongside filing of the written statement, the Defendant initiated a civil suit, CS(OS) 767/2004 titled ***Raj Kumar Saraf v. Vishakha Chemicals***, for injunction against Plaintiff from infringing the Defendant's registered trademark "ROCHAK" and passing off "AM PACHAN".

5. Given the commonality in issues and the parties in the two suits, the Court consolidated the proceedings on 16th December, 2010, and directed the instant suit to be treated as the lead matter. The following common issues were framed on 03rd September, 2013:

- "1. Whether the Plaintiff is the registered proprietor of the trademark ROCHAK under No. 484698 in Class 5? OPP.*
- 2. Whether the registration of the Trademark ROCHAK under No. 484698 in Class -5 in favour of the Plaintiff is legal and valid? OPD*
- 3. Whether the Plaintiff or Defendant is the proprietor of the trademark AM PACHAN? Onus on parties.*
- 4. Whether the Plaintiff can claim copyright in the artistic work ROCHAK and AM PACHAN? OPP*
- 5. Whether the Defendant or Plaintiff is passing off its goods as those of the other under the trademark ROCHAK and AM PACHAN? Onus on Parties.*
- 6. Whether the Defendant or Plaintiff is passing its goods in the similar/deceptive pouches bearing the same getup, colour combination, trade dress etc. as those of the other under the trademark ROCHAK and AM PACHAN? Onus on parties.*
- 7. Whether the Plaintiff or the Defendant is the prior adopter and user of the trademark ROCHAK and AM PACHAN? Onus on parties.*
- 8. Whether the Defendant is infringing the rights of the Plaintiff in trademark ROCHAK/AMPACHAN? OPP*
- 9. Whether there is a valid and legal assignment of trademarks ROCHAK and AMPACHAN in favour of the Defendant by a third party? OPD.*
- 10. Relief."*



6. As the events unfolded, at the time Plaintiff was recoding their oral evidence, the Defendant's lawsuit – CS(OS) 767/2004 – was dismissed on 15th December, 2015 due to Defendant's non-appearance and failure to prosecute. The said order reads as follows:

“It is noticed that plaintiff in the abovesaid matter is not appearing since for the last four dates. Even today no one appeared when the matter is taken up. Suit of the plaintiff is accordingly dismissed.”

7. Parallely, the Defendant's erstwhile counsel moved an application in the present suit for discharge, which was allowed on 22nd September, 2015. Court notice was issued to the Defendant, but despite service, they did not join the proceedings. Accordingly, through order dated 15th December, 2015, the Court proceeded *ex-parte* in this suit, directing the Plaintiff to lead *ex-parte* evidence.

8. The Plaintiff has examined the following four witnesses:

- a. PW-1: Mr. Ratan Lal Poddar, Partner of the Plaintiff.
- b. PW-2: Ms. Himani, Data Entry Operator, Office of Trademarks Registry.
- c. PW-3: Mr. Zafar, SJA, High Court of Delhi.
- d. PW-4: Ms. Tanuja Dhoulakhadi, Legal Assistant, Copyright Office.

9. The Plaintiff's evidence was concluded on 04th December, 2018, and the matter is now fixed for final disposal.

10. Meanwhile, the Defendant submitted petitions to the Copyright Board to cancel the Plaintiff's copyright registrations for the Rochak and Am Pachan labels. These petitions were decided in favour of the Defendant on 21st January, 2009. Subsequently, in appeal, the Copyright Board's decisions were overturned by the Division Bench of this Court in RFA 175/2009 and



RFA 176/2009. The reversal, rendered in a judgment dated 10th January, 2020, restored the Plaintiff's copyright registrations.

ISSUE-WISE ANALYSIS AND FINDINGS

Issue No. 1 – Whether the Plaintiff is the registered proprietor of the trademark ROCHAK under No. 484698 in Class 5? OPP

11. The Plaintiff has, through oral and documentary evidence, proved their ownership over the trademark “ROCHAK” registered under No. 484698 in class 05. PW-1, Mr. Ratan Lal Poddar, has testified that Plaintiff has secured aforesaid registration.⁴ The application was filed by the Plaintiff on 25th January, 1988, with a user claim of 01st April, 1982. This is supplemented by: (a) Ex. PW1/7, which is the trademark registration certificate issued in favour of the Plaintiff on 21st March, 2003, and (b) Ex. PW 2/1 (Colly), true copy of the entry in the Register of Trademarks in respect of the Plaintiff's mark “ROCHAK” in class 05. Since the evidence was recorded on 21st September, 2016, Ex. PW 2/1 records that the Plaintiff's registration is valid up to 25th January, 2019. However, Mr. Bhatia confirms that the registration has since been renewed, and as per the information available on the website of Trademarks Registry, the registration subsists till 25th January, 2029.

12. In view of the above, issue No. 1 stands proved by the Plaintiff and is answered in their favour.

Issue No. 2 – Whether the registration of the trademark “ROCHAK” under No. 484698 in Class 05 in favour of the Plaintiff is legal and valid? OPD

13. The Defendant's challenge to the Plaintiff's registration is principally

⁴ Paragraph No. 7 of Ex. PW1/X.



based on their assertion that the word “ROCHAK” is generic and common to trade and thus, cannot serve as a trademark. In the Hindi language, “ROCHAK” means “मनोरंजक” or “प्रिय”, which translates to entertaining, interesting, or amiable in English. These connotations of the word “ROCHAK” do not render them descriptive of the goods to which it is applied – *churan* or digestive tablets, that would debilitate its ability to distinguish the goods or services of the Plaintiff.⁵ The mark “ROCHAK” could, at best, be considered as suggestive of the emotion or sensation that would be experienced by the purchaser after consuming the product and thus, is entitled to trademark protection. This stance of the Defendant is further contradicted by the fact that they themselves claim registration rights in the trademark “ROCHAK”, albeit in class 30 for confectionary goods.

14. Insofar as the claim that “ROCHAK” is common to trade is concerned, it is pertinent to note that the Defendant has not led any evidence to substantiate this fact. While copies of packaging adopted by certain third parties have been filed along with the written statement, their veracity and evidentiary significance have not been proved by the Defendant, who, consciously abstained from the proceedings.

15. As the Defendant has failed to produce sufficient evidence to effectively challenge the validity of the Plaintiff’s trademark registrations, the Court remains unconvinced by their arguments intended to counter the presumption of validity. Conversely, the Plaintiff has successfully demonstrated the lawful registration of their trademark. Therefore, upon careful consideration of the evidence and arguments presented, issue No. 2

⁵ See: Section 2(1)(zb) of the Trademarks Act, 1999.



is decided in favour of the Plaintiff, holding that their registration of the trademark “ROCHAK” in class 05 is valid and subsisting.

Issue No. 3 - Whether the Plaintiff or Defendant is the proprietor of the trademark AM PACHAN? Onus on parties

16. On this issue, Mr. Bhatia, on instructions, submits that the Plaintiff does not claim proprietorship over the wordmark “AM PACHAN” and is



asserting rights over the Am Pachan labels – “



“, and “



” [Ex. PW

1/6].

17. According to Mr. Ratan Lal Poddar [PW-1], the mark “AM PACHAN” and afore-noted labels were first adopted by Plaintiff for their *churan* tablets in 1985.⁶ This label comprises of characteristic features such as the colour scheme, the manner of writing “AM PACHAN”/ “आम पाचन”,

⁶ Paragraph No. 6 of Ex. PW1/X.



the device “”/ “”, pictorial graphics of children playing/ in a joyful mood, and mention of the brand “VISAKHA”. These elements endow the label with the ability to function as a trademark, signifying the source of goods as the Plaintiff – Visakha Chemicals. The adoption of the “AM PACHAN” mark and labels by the Plaintiff has been demonstrated in trial through invoices, with the first one dating 21st March, 1986 [Ex. PW1/16] and advertisements [Ex. PW1/17 and PW 1/18].

18. On the contrary, the Defendant has not explained their adoption of the



impugned “” label/ mark. They merely maintain that the words “AM PACHAN” have been used to describe the goods, but have not presented any document/ invoice showing its utilization. It is noticed that Defendant has obtained a copyright registration in respect of the afore-noted label/ artwork under No. A-75765/2006. In the said application, the Defendant has claimed 1997 as the year of first publication. Although the Defendant has not provided any evidence to substantiate their claim, assuming the claimed date to be correct, the same does not precede the Plaintiff’s date of adoption of their Am Pachan labels.



19. Therefore, by virtue of prior adoption and continuous and open use, the Court finds the Plaintiff to be the proprietor of the Am Pachan labels. Accordingly, this issue is decided in favour of the Plaintiff, with a slight modification. It is held that Plaintiff is the proprietor of the labels/ marks



“”, “”, and “”, rather than exclusively of the trademark “AM PACHAN”.

Issue No. 4 – Whether the Plaintiff can claim copyright in the artistic work ROCHAK and AM PACHAN? OPP

20. The Plaintiff’s registration of copyright of the Rochak and Am Pachan labels [Ex. PW1/5 and PW1/6, respectively] have been proved by PW-1 and PW-4 [Mr. Tanuja Dhoulakhadi], who have affirmed the issuance of certificate of registrations in the Plaintiff’s favour.⁷

21. The grounds urged by the Defendant to question the grant of copyright registration to the Plaintiff’s aforesaid labels in the present suit have been considered and rejected by the Division Bench in the judgment dated 10th January, 2020, whereby the decision of Copyright Board to cancel the said registrations, was set aside. The relevant findings of the Division Bench are reproduced hereinbelow:

“28. A perusal of the order passed by the Copyright Board shows that the Board has not questioned the ownership of Shri Ratan Lal Poddar over

⁷ See: Ex. PW 1/8 to 1/12 and Ex. PW 4/1 to 4/5.



the works in question, but rather has observed that Shri Ratan Lal Poddar is exclusively the first owner of the said works. The Copyright Board has also observed that Shri Ratan Lal Poddar being the creator of the work, exercises an exclusive right over the same and his action of passing the same to the appellant consisting of three partners including Shri Ratan Lal Poddar, created collective interests which amounted to assignment in terms of Section 18 and 19 of the Act. Counsel for the respondent, while relying upon the observation made by the Copyright Board, has strongly contended that under Section 19 of the Act, assignment in writing is a mandatory statutory prerequisite for permitting usage of the copyrighted works. The said contention of the respondent cannot be accepted and lacks merit for the reason that Shri Ratan Lal Poddar, while applying for the registration of the said artistic works, mentioned the appellant i.e. M/s Visakha Chemicals as the owner of the artistic works. Additionally, after examining the affidavit of Shri Ratan Lal Poddar, we may also note that the appellant is a family concern of Shri Ratan Lal Poddar and he had been working in the appellant firm as an employee since 1982 and in 1987 joined the appellant firm as a partner; and the artistic works in question were developed by Shri Ratan Lal Poddar for the appellant firm while he was employed in the firm. Also, as the ownership of Shri Ratan Lal Poddar over the challenged artistic works is not disputed and in the absence of any disputes regarding the creation or usage of the said artistic works amongst the partners in the firm, the signing of the application form for the registration of the copyright for the challenged artistic works amounts to assignment made in favour of the appellant firm.

29. We may note that bare distinction in this case is that Shri Ratan Lal Poddar claims to be the author which is not disputed by the appellant firm. Shri Ratan Lal Poddar claims that he created artistic works for the appellant firm and applied for the registration in the name of the appellant firm which fact is not disputed by the partners in the firm. Moreover, Shri Ratan Lal Poddar is the real brother of one of the partners and it is claimed that at the time when he created the artistic works he was employed in the appellant firm. It is pertinent to mention that in Indian culture it is not unusual that the family members, irrespective of age and qualification, share the burden in the family business even while pursuing their education. Even otherwise, it is common knowledge that boys after college manage shops and other business centres with their respective fathers and other family members.

30. We are also of the view that since there was no dispute regarding the usage of the said artistic works amongst the partners in the appellant firm, the respondent cannot challenge the assignment since neither the respondent is an assignor nor is claiming prior assignment. The



respondent therefore being a third party has no locus to challenge the assignment made by Shri Ratan Lal Poddar.

31. In view of the above discussion, we are of the view that the decision rendered by the Copyright Board in expunging the five entries bearing registration numbers A-58545/2001, A-61480/2002 for artistic work AMPACHAN and A-61431/2002, A-64130/2003 and A-64132/2003 for artistic work ROCHAK from the Register of Copyrights is incorrect.

32. Accordingly, the present appeals are allowed.”

[Emphasis Supplied]

22. The afore-noted decision of the Division Bench clearly holds that ownership, creation and usage of the artistic work was never disputed by the Defendant. The Court held the Plaintiff to be the owner of copyright in the Rochak and Am Pachan labels/ artworks. In absence of any evidence to the contrary, this issue is decided in the Plaintiff’s favour.

Issue No. 5 – Whether the Defendant or Plaintiff is passing off its goods as those of the other under the trademark ROCHAK and AM PACHAN? Onus on Parties **and** Issue No. 6 – Whether the Defendant or Plaintiff is passing its goods in the similar/deceptive pouches bearing the same getup, colour combination, trade dress etc. as those of the other under the trademark ROCHAK and AM PACHAN? Onus on parties **and** Issue No. 7 – Whether the Plaintiff or the Defendant is the prior adopter and user of the trademark ROCHAK and AM PACHAN? Onus on parties **and** Issue No. 8 – Whether the Defendant is infringing the rights of the Plaintiff in trademark ROCHAK/AMPACHAN? OPP

23. As the determination of afore-noted issues centres around common set of facts and contentions, they are being dealt together.

Similarity in conflicting marks and packaging

24. A comparison of the marks and packaging of the parties is drawn below:



<i>Plaintiff's marks/ products</i>	<i>Defendant's marks/ products</i>
ROCHAK	ROCHAK
	





25. The comparative analysis highlights numerous similarities between the trademarks and the overall trade dress/design/ product presentation of the “ROCHAK” and “AM PACHAN” products offered by both parties. These points of similarity encompass visual, stylistic, and conceptual elements that contribute to consistent and recognizable similarities. The Defendants have replicated the colour scheme, font size and style of writing



“ROCHAK”/ “AM PACHAN”, the devices of a man, children, “”, and loose tablets, that are present on the Plaintiff’s packaging. The points of distinction advocated by the Defendant, namely, the brand names “VISAKHA” and “ANMOL-G” are insufficient to dispel the element of consumer confusion, particularly when the manner of writing the brand



names on the labels is alike – “”/ “”,



and “”/ “”.—Thus, on a holistic comparison, the Court finds the parties’ trademarks/ trade dress to be nearly identical. Given the identity in the marks, products and trade channel, there is are high prospects of a consumer confusing the source of these products, and buying the Defendant’s goods assuming them to be emanating from the Plaintiff.

26. No cogent explanation for adoption of a nearly identical packaging by the Defendant is forthcoming. Their case hinges on the assertion that they use the terms “ROCHAK” and “AM PACHAN” in a descriptive sense. Insofar as “ROCHAK” is concerned, as noted above, the Defendant



themselves are asserting trademark rights in the word “ROCHAK”. As the Plaintiff is not pressing for reliefs against the wordmark “AM PACHAN”, the Court is not delving into this aspect.

Prior user

27. PW-1 has deposed that the Plaintiff adopted the mark “ROCHAK”



and the label “



PACHAN” and the label “

in 1982, whereas they started using “AM PACHAN” and the label “

in 1985. This adoption and continuous of the aforesaid marks/ labels for the goods in question has been proved in trial through invoices [Ex. PW1/16] and advertisements [Ex. PW1/17 and PW 1/18].

28. While the defence of prior use has not been set up in the amended written statement, the Defendant is claiming use of the trademark “ROCHAK” through their alleged predecessor-in-interest, Bajaj Food Products since 1981. For this purpose, they have placed on record certain



original invoices raised by Bajaj Food Products in the year 1981 to third parties for the supply of confectionary products. Bajaj Food Products held registration of the trademark “ROCHAK” in class 30, with a user claim of 01st January, 1981. The Defendant has alleged that this registration was subsequently assigned to them under an Assignment Deed of 05th March, 2004. Hence, they allege that any use of the trademark “ROCHAK” by Bajaj Food Products must accrue to the Defendant. In this regard, it is necessary to highlight that Defendant bears the onus to prove use prior to the Plaintiff, where they have evidently fallen short. It was incumbent upon the Defendant to present witnesses and evidence to prove the assignment of rights in their favour, use by their supposed predecessor-in-interest and the invoices filed on record. However, no evidence has been led. The failure to prove the purported Assignment Deed of 05th March, 2004 gravely impairs the Defendant’s stand as the user of the impugned mark. Thus, no benefit can accrue to the Defendant from the alleged use of the “ROCHAK” mark by Bajaj Food Products.

29. Another significant aspect that must be taken note of is that during the pendency of the present suit, on an application of the Plaintiff, the Intellectual Property Appellate Board has,⁸ through order dated 21st December, 2010 in OA/89/2008/TM/DEL and OA/89/2008/TM/DEL, upheld the removal of the trademark “ROCHAK” registered under No. 447376 in the name of Bajaj Food Products. It transpires that the said registration fell due for renewal on 26th December, 1999, however, the proprietor [Bajaj Food Products] failed to deposit the renewal fee. Yet, on account of an error on the part of the Trademarks Registry, the registration



was renewed without payment of the requisite fee. When the matter was brought to the attention of the authorities, the Registrar of Trademarks and the IPAB, cancelled the registration. However, while disposing of the appeal, the IPAB made certain pertinent observations regarding the assignment of the mark to the Defendant herein, which read as under:

“26. On a plain reading of the provisions it is clear that the trade mark shall be removed from the Register if no renewal fee has been paid. In the instant case, the mark fell due for renewal on 26.12.1999. The mark was assigned in the year 2004. In our considered opinion the appellants have not paid the renewal fees and the mark has been, therefore, removed from the Register. The appellants have not produced any proof to say that the renewal fee has been paid within the prescribed time limit. It also creates a doubt in our mind as to how the Registry could issue a renewal certificate without payment of renewal fees. Be that as it may, when the registration has come to an end the right of the proprietor also comes to an end as nothing survives in that registration and therefore the assignment itself is not valid as how a dead trade mark can be assigned. We do not find any force in the arguments of the counsel for the appellant that no Form O-3 notice was received. In fact, the Registrar sends the Form O-3 notice only if the Form TM 12 for renewal has not been received by the Registry.

27. The trade mark which has no effect cannot be assigned to a third person. The assignment executed in our view is not a valid assignment. The mark was not renewed in the year 1999 and hence there is no valid registration as on the date of assignment in the year 2004.”

30. In view of the above findings of the IPAB, nullifying the assignment of mark “ROCHAK” in the Defendant’s favour through the Assignment Deed dated 05th March, 2004, and the Defendant’s failure to adduce evidence to substantiate their claims, the Court does not agree with their stand of being the senior user.

31. Further, to challenge aforesaid invoices, the Plaintiff has produced on record Ex. PW1/31, which are returned envelopes of communications issued

⁸ “IPAB”.



to Bajaj Food Products. Such non-service on the addresses of Bajaj Food Products mentioned in the invoices filed by the Defendant, according to PW-1, implies that the firm Bajaj Food Products does not exist and the invoices so produced are fabricated. The Defendant has failed to lead evidence or cross-examine the Plaintiff's witness to controvert these assertions. This failure is critical, as it significantly undermines the claim of usage of the impugned marks/ labels by the Defendant, prior to the Plaintiff.

32. Therefore, the Plaintiff has established their prior trademark rights over "ROCHAK" mark and the Rochak and Am Pachan labels as also the copyright vested therein. Accordingly, the Defendant is found to be infringing the Plaintiff's trademark "ROCHAK" and registered copyright in Rochak and Am Pachan labels as well as passing off their products as that of the Plaintiff's. Thus, all the afore-noted issues are answered in favour of the Plaintiff, and against the Defendant.

Issue No. 9 – Whether there is a valid and legal assignment of trademarks ROCHAK and AMPACHAN in favour of the Defendant by a third party? OPD.

33. The Defendant has not led any evidence. They have not been able to prove any legal assignment of the trademark "ROCHAK" and "AM PACHAN". Their suit, as noted above, for infringement of the trademark "ROCHAK" has since been dismissed. Moreover, the Assignment Deed of 05th March, 2004 has been declared as invalid by the IPAB. In absence of any evidence to that effect, and in view of the facts noted above, this issue is decided against the Defendant and in favour of the Plaintiff.

Issue No. 10 – Relief



34. In view of the foregoing analysis, the Plaintiff is found entitled to a decree of permanent injunction against the Defendant, as prayed in paragraph No. 30(a), (b), (d), (e), (f) and (g).

35. On the aspect of award of damages, the Plaintiff has not led any evidence to demonstrate the actual damages suffered by them due to the Defendant's impugned operations. There has been no recovery of goods through appointment of a Local Commissioner. However, considering that the Defendant has abstained from the proceedings since the trial commenced as well as the overall facts of the case, detailed hereinabove, the Court is of the opinion that Plaintiff is entitled to nominal damages of Rs. 3,00,000/-, recoverable from the Defendant.

36. Further, the Plaintiff is found entitled to actual costs recoverable from the Defendant, in terms of the Commercial Courts Act, 2015 and Delhi High Court (Original Side) Rules, 2018 read with Delhi High Court Intellectual Property Division Rules, 2022. Plaintiff shall file their bill of costs in terms of Rule 5 of Chapter XXIII of the Delhi High Court (Original Side) Rules, 2018 on or before 15th May, 2023. As and when the same is filed, the matter will be listed before the Taxing Officer for computation of costs.

37. The suit is decreed in favour of the Plaintiff in the above terms.

38. Decree sheet be drawn up.

39. Disposed of.

SANJEEV NARULA, J

MARCH 21, 2024

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