

Itc Limited vs.arora Offset Printers & Ors

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SooperKanoon Citation : sooperkanoon.com/1219310

Court : Delhi

Decided On : Nov-15-2018

Appellant : Itc Limited

Respondent : Arora Offset Printers & Ors

Advocate for Def. : Ms. Dimple Vivek, Mr. Akhilesh Dixit, Ms. Karuna Sharma

Advocate for Pet/Ap. : Mr. Sandeep Sethi, Mr. Sudeep Chatterjee, Ms. Nupur Lamba, Ms. Drishti Chatterjee, Ms. Aishwarya Chaturvedi

Judgement :

* % + IN THE HIGH COURT OF DELHI AT NEW DELHI Date of decision:

15. h November, 2018. CS(COMM) 1512/2016 & IAs No.14230/2016 (of the plaintiff u/O XXXIX R-1&2 CPC) & 13699/2018 (of the plaintiff u/O XXXIX R-2A CPC) ITC LIMITED Plaintiff Through: Mr. Sandeep Sethi, Sr. Adv. with Mr. Sudeep Chatterjee, Ms. Nupur Lamba, Ms. Drishti Chatterjee and Ms. Aishwarya Chaturvedi, Advs. Versus ARORA OFFSET PRINTERS & ORS Defendants Through: Ms. Dimple Vivek, Adv. for D-1,5,6&7. Mr. Akhilesh Dixit and Ms. Karuna Sharma, Advs. for D-2,3,4&8. CORAM: HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW The senior counsel for the plaintiff and the counsels for all the eight 1. defendants (defendants no.9 to 12 are Ashok Kumars) have been heard on IA No.14230/2016 of the plaintiff under Order XXXIX Rules 1&2 of the Code of Civil Procedure, 1908 (CPC).

2. The counsels for the defendants, during the course of hearing stated that it is only the defendants no.3,5&8 namely Durga Trading Co., Meena Agarbatti Company and Shashi Dhoop Industries who are manufacturing the infringing goods and the other defendants are either printers of the packaging CS(COMM) 1512/2016 Page 1 of 27 used by the defendants no.3,5&8 or suppliers of raw material or the retailers of the said products and thus have no interest in contesting this suit. It is stated that the said defendants, other than the defendants no.3,5&8, are willing to make a statement that they will not violate the rights claimed by the plaintiff and suffer a decree for permanent injunction as claimed in para 63(B) of the plaint dated 17th November, 2016.

3. Thus, the suit, insofar as against the defendant no.1 Arora Offset Printers, defendant no.2 Delhi Agarbatti Company, defendant no.4 National Agarbatti Factory, defendant no.6 Seema Agarbatti and defendant no.7 Jagdamba Trading Company is disposed of by issuing a decree for permanent injunction in favour of the plaintiff and against the said defendants, of permanent injunction in terms of prayer paragraph 63(B) of the plaint dated 17th November, 2016, and leaving the parties to bear their own costs. The said defendants need not to participate further in the suit. Decree sheet be drawn up.

4. The plaintiff has instituted this suit for permanent injunction to restrain the defendants from using the mark/trade dress/label/writing style/packaging SHUBH MANGALAM DHOOP, SHUBH MANGALAM DEEP, MANGALDHAM, SUBHMANGAL, MANGLAMJYOT, MANGLAM JYOT, MANGALKAMNA, MANGAL KAMNA, SHUBHMANGAL and SHUBH MANGAL or from using any other identical/deceptively similar mark/trade dress/ label/ writing style/ packaging so as to impinge rights of the plaintiff in its well- known trade mark and label MANGALDEEP in relation to puja dhoop or any other products including cognate/allied products so as to result in the CS(COMM) 1512/2016 Page 2 of 27 violation of the plaintiffs intellectual property rights in MANGALDEEP and passing off, unfair competition, dilution etc.

5. The suit came up first before this Court on 18th November, 2016 when, though the suit was entertained and summons of the suit and notice of the application for

interim relief issued but neither any ex parte order of injunction as sought granted nor the commissions as sought issued.

6. The plaintiff instituted FAO(OS)(COMM) No.127/2016 against the non-grant of ex parte injunction and non-issuance of commission and vide detailed order running into as many as 20 pages therein, notice thereof was issued, commissions issued and interim injunction granted in terms of prayer paragraph (B) of the plaint.

7. The defendants appeared in the said appeal and the said appeal was disposed of vide order dated 27th April, 2017 continuing the interim order till the disposal of the application under Order XXXIX Rules 1&2 of the Code of Civil Procedure, 1908 (CPC) by this Court.

8. The senior counsel for the plaintiff has handed over in the Court the packagings containing the product i.e. pooja dhoop of the plaintiff as well as of the defendants and which are as under:-

"Page 3 of 27 CS(COMM) 1512/2016 PLAINTIFF DEFENDANTS FRONT
CS(COMM) 1512/2016 Page 4 of 27 BACK PLAINTIFF DEFENDANTS
CS(COMM) 1512/2016 Page 5 of 27 PLAINTIFF DEFENDANTS FRONT
CS(COMM) 1512/2016 Page 6 of 27 BACK PLAINTIFF DEFENDANTS
CS(COMM) 1512/2016 Page 7 of 27 PLAINTIFF DEFENDANTS FRONT
CS(COMM) 1512/2016 Page 8 of 27 BACK PLAINTIFF DEFENDANTS
CS(COMM) 1512/2016 Page 9 of 27 9. The senior counsel for the plaintiff has argued that the plaintiff holds registrations of device mark with the word MANGALDEEP as under: REGISTERED MARKS S.No.TM Application Mark Class 37,35,40,41, 39, 42, 38,36 MANGALDEEP FRAGRANCE OF TEMPLE35 4 34 Page 10 of 27 No.1. 1237216 2. 1897214 3. 1249401 4. 1249400 5. 1117458 CS(COMM) 1512/2016 6. 1123577 7. 1292443 8. 1316940 9. 1117458 34 34 34 34 10. It is also argued that the plaintiff also has applied for registration of the word mark MANGALDEEP as well as other device marks with MANGALDEEP as under: PENDING MARKS1 1221756 2. 1221757 CS(COMM) 1512/2016 03 03 Page 11 of 27 3. 1221758 4. 1221759 5. 1221760 6. 1243574 7. 1306556 8. 1306557 9. 1306558 10. 1306559 11. 1306560 12. 1306561 03 03 03 03 03 03 03 03 03 CS(COMM) 1512/2016 Page 12 of 27 13. 1306562 14. 1306564 MANGALDEEP ()

15. 1363455 16. 1363456 17. 1363457 18. 1363458 19. 1363459 20. 1363460 03
03 03 03 03 03 03 03 CS(COMM) 1512/2016 Page 13 of 27 21. 1363461 22.
1363462 23. 1363463 24. 1363464 25. 1363465 26. 1363467 03 03 03 03 03 03
CS(COMM) 1512/2016 Page 14 of 27 27. 1363468 28. 1363469 29. 1363470 30.
1373924 31. 1373925 03 03 03 03 03 03 CS(COMM) 1512/2016 Page 15 of 27 32.
1373926 33. 1385692 34. 1516933 35. 1734816 36. 1868439 03 03 03 03 03 03
CS(COMM) 1512/2016 Page 16 of 27 37. 1868440 38. 1868441 39. 1868442 40.
1868443 41. 1868444 42. 1868445 03 03 03 03 03 03 CS(COMM) 1512/2016
Page 17 of 27 43. 1868446 44. 1868447 45. 1868448 46. 2088991 47. 2088992
48. 2694537 03 03 03 03 03 03 CS(COMM) 1512/2016 Page 18 of 27 49.
2694538 50. 2694539 51. 2694540 52. 2694541 53. 2709159 54. 2709160 03 03
03 03 03 03 CS(COMM) 1512/2016 Page 19 of 27 55. 2916457 56. 2930356 57.
3101026 03 03 03 Attention is drawn to the order dated 23rd November, 2016 of
the Division Bench where all the said registration applications are listed.

11. It is the contention of the senior counsel for the plaintiff that a bare perusal of the aforesaid packagings is indicative of the similarity between the packaging of the plaintiff and of the defendants and the intent of the defendants to, riding on the goodwill of the plaintiff who is admittedly the prior adopter of the mark and the packaging, sell the products of the defendants. It is contended that the commissioners appointed by the Division Bench have also reported thousands of infringing packaging in the premises of the defendants, further strengthening the claim of the plaintiff, of the defendants by adopting packagings, all identical to that of the plaintiff, seeking to ride on the goodwill of the plaintiff.

12. The counsel for the defendants has argued with reference to the written statement of the defendant no.3 stating that the same encompasses CS(COMM) 1512/2016 Page 20 of 27 the defences of the defendants no.5&8 also. It is contended that the defendant no.3 is using the mark MANGALDHAM; that MANGAL DHAM is a temple in Darjeeling from where the ancestors of the defendants have come and owing whereto the defendant no.3 adopted the said mark. It is further contended that the defendants are engaged in the business of manufacturing and marketing of pooja dhoop only and are not carrying on business in any of the other products and services in which the plaintiff holds

registration; thus the claim of the plaintiff for infringement is to be seen vis- -vis class 3 only and not with respect to any other class. The counsel for the defendants has also handed over in the Court a computer generated search report from the website of the Registrar of Trade Marks to show that nine applications of the plaintiff for registration of MANGALDEEP along with variants thereof with respect to pooja dhoop, agarbatti, hawan samagri incense sticks, perfumery having already been refused. It is also shown that other applications are either shown as opposed or abandoned.

13. The senior counsel for the plaintiff, on enquiry states that the applications which are shown as refused were prior applications and do not include any of the applications pleaded in the plaint or recorded in the order dated 23rd November, 2016 of the Division Bench.

14. The counsel for the defendants has further contended that according to the plaintiff also, one Ram Dulari was first adopter of the trade mark MANGALDEEP for pooja dhoop and had applied for word registration in class 3 in the year 1988, but which application was reported to be removed; the said Ram Dulari again applied in 1991 but the application was again ordered to be removed; that the plaintiff claims to have obtained assignment CS(COMM) 1512/2016 Page 21 of 27 of the mark from Ram Dulari in the year 2003 and from the year 2003 till the year 2018 has been unable to obtain registration of the work mark MANGALDEEP in class-3.

15. The only other argument of the counsel for the defendants is that MANGAL is a generic word which is publici juris and has ancient origins and the plaintiff cannot claim any exclusive right thereto. It is also contended that the depiction on the trade dress of the plaintiff of an Indian woman wearing a sari and in the namaste pose cannot be monopolised by the plaintiff and the plaintiff cannot restrain others from using the same. It is argued and demonstrated that every pooja dhoop on its packaging also has a lady wearing similar dress and in a similar pose. However, the counsel for the defendants agrees that the said packagings are of products under different trade mark/brands as Shagun, Swaran Champa and Mangalkari.

16. I have enquired from the counsel for the defendants, under what trade dress and trade mark the defendants, since ex parte order dated 23rd November, 2016 of injunction, are selling their products.

17. The counsel for the defendants states that the defendants have stopped carrying on business in pooja dhoop and are not manufacturing, selling or marketing the same in any other name/package and are desirous of contesting this suit to be able to market pooja dhoop only in the impugned packaging and with the impugned mark.

18. I have considered the rival contentions and also enquired from the counsel for the defendants, what is different in the arguments urged by the counsel for the defendants than the position, as prevailing at the time of institution of the suit and in which position, notwithstanding the Single CS(COMM) 1512/2016 Page 22 of 27 Judge of this Court having not granted ex parte injunction, the Division Bench had intervened and granted ex parte injunction and issued the commissions sought by the plaintiff.

19. The counsel for the defendants states that the defendants did not have an opportunity to address before the Division Bench as the appeal, after the defendants appeared before the Division Bench, was disposed of by continuing the interim order till the disposal of the application for interim relief by this Bench and the defendants thus have not addressed, what has been argued today, before the Division Bench.

20. Undoubtedly so, but still, once the Division Bench on the given facts deemed it appropriate to grant interim injunction, that too ex parte, unless it is shown that there is something fresh before this Court which was not before the Division Bench, ordinarily the order of injunction would continue. I am afraid the defendants in their arguments have not urged any fact which can be said to be not in contemplation of the Division Bench. The only thing which could be said to be new is the refusal of the applications, but as aforesaid, the applications which are shown to be refused are not the applications which were pleaded in the plaint at the time of institution which were for consideration before the Division Bench.

21. Even otherwise, the factum of the defendants having not deemed it fit or profitable to carry on the business without the impugned packaging and impugned mark is also indicative of the defendants being unable to sell their product under any other packaging/mark and thus are clearly riding on the goodwill of the plaintiff, in selling their product, by aping the mark and trade dress of the plaintiff. CS(COMM) 1512/2016 Page 23 of 27 22. As far as the argument of the counsel for the defendants, of the plaintiff being not entitled to appropriate the word MANGAL to itself and the same being a generic word is concerned, the same will be for consideration after evidence has been led in the suit. As of today, it is found that the defendants were attempting to pass off their product as that of the plaintiff and there is a need to restrain the defendants during the pendency of the suit from continuing the same.

23. The balance of convenience is also in favour of plaintiff and against defendants. While plaintiff is in business, the defendants, for the last nearly two years are admittedly not in the business.

24. The application under Order XXXIX Rules 1&2 of the CPC being IA No.14230/2016 is thus allowed and the interim order dated 23rd November, 2016 as granted by the Division Bench, to continue till the disposal of the suit.

25. The counsel for the defendants at this stage states that the trade mark application no.1306564 of the plaintiff shown at serial no.22 in the table of marks set out by the plaintiff in para 23 of the plaint, as per search report handed over from the Trade Marks Registry, was refused after the filing of the suit.

26. The senior counsel for the plaintiff, on instructions states that the plaintiff in the table set out in para 23 of the plaint has listed all the marks including those which stood registered and of which registration was pending and/or which were opposed, but the plaintiff at page 230 of Part-III file had also filed a document showing that the subject application was being opposed by Shankar Perfumery Works. It is further CS(COMM) 1512/2016 Page 24 of 27 stated that though the opposition of Shankar Perfumery Works was accepted, but the plaintiff has preferred an appeal thereagainst and which is pending before the Intellectual Property Appellate Board (IPAB).

27. I may notice that the table of marks set out in para 23 of the plaint also at serial no.8&9 contains applications no.1221756 and 1221757 both dated 8th August, 2003 for registration of the work mark MANGAL DEEP in class-3.

28. In view of the aforesaid, the same would not require a change of opinion. As far as the application of the plaintiff under Order XXXIX Rule 2A of the CPC is concerned, the same cannot be decided without framing an issue thereon and without evidence being led thereon.

29. On the pleadings of the parties, the following issues are framed:-

"(i) Whether the plaintiff is the registered owner of the trade mark MANGAL DEEP?. OPP (ii) Whether the defendants no.3,5&8 have infringed the trade mark of the plaintiff?. OPP (iii) Whether the defendants no.3,5&8 have violated any copyright of the plaintiff?. OPP (iv) Whether the trade dress under which the defendants were selling identical product as the plaintiff was similar to the trade dress of the plaintiff and use thereof by the said defendants amounted to the defendants passing off their goods as that of the plaintiff?. OPP CS(COMM) 1512/2016 Page 25 of 27 (v) Whether the defendants or any of the defendants no.3,5&8 have violated the interim order in this suit and if so to what punishment are the said defendant/s liable for?. OPP (vi) If the above or any of the issues is decided in favour of the plaintiff, to what relief if any is the plaintiff entitled to against the defendants no.3,5&8 or any of them. OPP (vii) Relief.

30. No other issue arises or is pressed.

31. The parties to file their list of witnesses within fifteen days.

32. The plaintiff to file affidavits by way of examination-in-chief of its witnesses within six weeks.

33. Option of having the evidence recorded on commission has been accepted by the plaintiff and the plaintiff who has also agreed to bear the entire cost of commission subject of course to final order as to costs in the suit.

34. A commission is issued to Mr. H.S. Sharma, Additional District Judge (Retd.) (Mob.9910384647) to record evidence in the suit. He is requested to record the evidence within the Court Complex and to complete the same within six months of the date of first appearance of the parties before him. He is granted liberty to have the matter placed before the Court, if any of the parties are found delaying recording of the evidence.

35. The fee of the Court Commissioner is fixed at Rs.1,00,000/-, besides out of pocket expenses. CS(COMM) 1512/2016 Page 26 of 27 36. The Registry is directed to send the file of the suit at the place and time fixed by the Court Commissioner for recording of evidence.

37. The counsels to mutually fix a date for recording of evidence before the Commissioner within eight weeks of today.

38. List after the recording of evidence is completed. RAJIV SAHAI ENDLAW, J.

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