

Deere and Co. and Anr. Vs. S. Harcharan Singh and Anr.

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Court : Delhi

Decided On : Dec-05-2014

Judge : Manmohan Singh

Appellant : Deere and Co. and Anr.

Respondent : S. Harcharan Singh and Anr.

Judgement :

* IN THE HIGH COURT OF DELHI AT NEW DELHI Order delivered on:

5. h December, 2014 % + CS(OS) No.3760/2014 DEERE & CO. & ANR. Through Plaintiffs Mr.Pravin Anand, Adv. with Ms.Vaishali Mittal, Ms.D. Neha Reddy and Mr.Siddhant Chamola, Adv. versus S. HARCHARAN SINGH & ANR. Through None Respondents CORAM: HON'BLE MR.JUSTICE MANMOHAN SINGH MANMOHAN SINGH, J.

(Oral) I.A. No.24478/2014 This is an application filed by the plaintiffs under Order 13 Rule 1 read with Section 151 CPC seeking exemption from filing the originals of the documents. For the reasons stated in the application, the same is allowed, subject to originals being produced at the time of admission/denial of the documents. The application is disposed of. I.A. No.24479/2014 (U/s 149 CPC) Learned counsel for the plaintiffs states that he would be filing the court fee within one week. In view of the statement made by the learned counsel, the application is disposed of. CS(OS) No.3760/2014 Let the plaint be registered as a suit. Issue

summons to the defendants through all modes of service including e-mail in addition, returnable on 15th January, 2015. I.A. No.24477/2014 (u/o XXXIX R.1 & 2 CPC) Issue notice to the defendants, returnable on 15th January, 1.

2015. 2. The plaintiffs have filed this suit for permanent injunction for restraining infringement, dilution of trade marks, passing off trade dress, unfair competition, rendition of accounts, delivery up and damages etc.

3. The case of the plaintiffs as per the plaint is that: (i) The Deere Group is commonly referred to as the John Deere after its founder and Chairman Mr. John Deere. The plaintiffs were established in the year 1837 and traces its origin to a blacksmith shop in Grand Detour, Illinois, U.S.A when Mr. John Deere invented the first commercially successful steel plow allowing pioneer farmers to cut clean furrows through sticky Midwest prairie soil. (ii) The plaintiff No.1 claims to be one of the largest and leading agricultural and construction equipment manufacturer in the world including India primarily having four business segments namely Agricultural Equipment; Commercial & Consumer Equipment; Construction & Forestry and Finance. (iii) The plaintiffs are listed as a Fortune 500 company and ranked amongst the top 100 companies therein, employing over fifty five thousand staff members in twenty seven countries worldwide, including the United States, Australia, Turkey, Canada, United Kingdom, China, France, Germany, Spain, Italy, India, Poland, Mexico, Morocco and South Africa. (iv) The plaintiffs first adopted its trademark John Deere in the year 1837 and has used the said trademark continuously and extensively ever since. (v) The plaintiffs logo essentially comprises of a leaping deer in conjunction with the trade mark John Deere. The plaintiffs logo of the animated version of the leaping deer has even been recognised by the United States Court of Appeals as a well-known mark. The Unique Green and Yellow Colour Scheme: (vi) The earliest illustration of the plaintiffs goods with the arbitrary green and yellow scheme (hereinafter referred to as the John Deere Trade Dress-Colour Combination) is of a plow in the 1905 Deere and Weber catalog. (vii) In the year 1910, the plaintiffs started making use of a particular combination of the colours Green and Yellow in relation to its agricultural implements in a unique and distinct manner which was further adopted for tractors in the year 1918. The manner of use of this combination of colours was

such that it included the body of the vehicle being substantially painted Green while the seat and the wheels of the vehicle being substantially painted Yellow in the manner depicted herein below: (viii) It is further submitted that in the year 1956 the colours Green and Yellow were also defined in its internal standards which clearly depicted the colours and the scope of their application on the agricultural equipment. Further, the plaintiffs make use of sample plates which are maintained under defined conditions in order to compare the original colours used by the plaintiffs with the use of colours on agricultural equipment in the present day. It is submitted that by virtue of continuous and extensive use of the CS(OS) No.3760/2014 for its products by the plaintiffs, the consumers and members of the trade alike associate the above mentioned colour scheme solely with the products of the plaintiffs. (ix) The plaintiffs have been investing huge amounts of money and energy in promoting its John Deere trademarks including the colour marks and logo and have put in unparalleled efforts to advertise and promote the said trademarks including trade dress in order to ensure that its trademarks secure and maintain the vast goodwill and reputation that is vested in them through decades until the present day. (x) The plaintiffs have reputation in India of its well known John Deere trademarks and the unique yellow) colour scheme and (green and logo. This is evidenced from the fact that its agricultural equipment especially Tractors, Harvesters and Combines have been featured in various Hollywood movies and TV shows such as A Summer Catch (2001), Burn Notice (2007), SeaBiscuit (2003) and The Longest Yard (2005). Further, the plaintiffs tractors have also featured in Indian movies such as Govindudu Andarivadele (Telugu) and even TV shows such as the widely acclaimed Satyamev Jayate (2014) wherein the plaintiffs tractor was used by the famous Bollywood actor Aamir Khan as a part of the theme song for the show. (xi) The plaintiffs presence over the internet is available and the websites of the plaintiffs being www.deere.com, www.johndeereclassic.com and www.deere.co.in are easily accessible to persons in Delhi and other parts of India as well as across the world. The plaintiffs unique and distinct (green and yellow) colour scheme and logo is also displayed extensively and also constitutes the basic colour scheme and layout of these websites. Plaintiff No.2 has tie-up agreements for research and development of a business model for delivering high quality premier agricultural mechanization

services with EM3 Agri services Private Limited (Delhi). Plaintiff No.2 has had agreements with IIT Delhi for collaborative research projects for Masters Degree or Ph.D to provide industrial exposure to the faculty and students of IIT Delhi. (xii) The plaintiffs have sold their products in Indian agricultural market, including first sales of equipment in India at least 6 decades ago. The plaintiffs entered directly into the Indian market in 1997 with the incorporation of its wholly owned subsidiary John Deere India Private Limited, the plaintiff No.2. As a result of its continued efforts to expand its business activities across the world including in India, the plaintiff No.1 entered into a Joint Venture Agreement with Larsen & Toubro Limited, an engineering company of high repute in India. Through this Joint Venture, the plaintiffs engaged in various activities such as the establishment of a green field project in the year 1999 in addition to establishing a state of the art manufacturing plant for the John Deere 5000 series tractors at Sanaswadi, near Pune in the year 1999. Subsequently, in the year 2005, the plaintiff No.1 acquired nearly all the shares of the said Joint Venture, whereby a new enterprise John Deere Equipment Private Limited was established in India. The plaintiffs further expanded its presence in India with the incorporation of John Deere Financial India Private Limited in the year 2011. (xiii) The plaintiffs claim to be one of the leaders in the Indian Tractor market and has achieved a pan-India presence through its 18 area offices, 4 divisional offices and more than 400 authorized dealers spread across the country. It is pertinent to mention that the plaintiffs are the largest exporter of tractors from India and these tractors are exported to the USA, Mexico, Turkey, North and South Africa, and South East Asia. The plaintiffs have also entered into a partnership with the State Government of Gujarat to benefit marginalized tribal farmers. The plaintiffs partnership with the Government of Gujarat was the first of its kind in the agricultural industry in India which is positively impacting an estimated 50,400 marginal farmer families. (xiv) The plaintiffs have invested huge sums of money in promoting and advertising its John Deere trademarks and unique trade dress in India. The advertising/promotional expenses of the plaintiffs in India for the period 2008-2012 (in million INR) are:

Year	2008-09	2009-10	2010-11	2011-12	2012-13
Promotional Expenditure	666.63	888.56	866.81	1,351.02	1,097.28

(xv) The vast promotion of the John Deere Trademarks including Trade Dress thereof has resulted in enormous sales of the

plaintiffs products in India. The sales figures of the plaintiffs in India for the period 2008 -2013 (in million INR) are: Year 2008-09 2009-10 2010-11 2011-12 2012-13 Sales Figures 18,600.56 21,262.83 32,978.86 39,862.36 41,330.90 (xvi) The plaintiffs John Deere trade marks are registered in more than 20 countries. It is submitted that the plaintiffs use of its John Deere trade marks dates back to 1943 in India. A list of the plaintiffs registrations for its John Deere trademarks/ trade dress in India is as under: # Trade Mark Registration Number

1. 224850 Class

2. 1551757 28 Date of application 12 October, 1964 20th April, 2007

3. 1551758 28 20th April, 2007

4. 1551759 7 20th April, 2007

5. 1551760 7 20th April, 2004 6.

7. 1551761 1551762 7 12 20th April, 2007 20th April, 2007 8. 1551763 12 20th April, 2007 9.

10. 1551764 1551765 12 28 20th April, 2007 20th April, 2007 7 Trade Mark (xvii) It is claimed that the plaintiffs John Deere Trade Marks including Trade Dress are well known trade marks in India for many reasons, the details of which are mentioned in para 24 of the plaint.

4. It is the case of the plaintiffs that in the month of October 2014, they became aware that the defendants are manufacturing and selling lookalikes of the plaintiffs farm equipment including but not limited to Tractors, Harvesters and Combines under their trading name/mark SURINDERA across India who have made use of the plaintiffs CS(OS) No.3760/2014 logo and a trade dress which bears Page 9 of 14 striking resemblance with the plaintiffs registered trademarks (the colour marks) including trade dress. Plaintiffs Products Defendants Impugned Products 3 1 2 4 It is submitted by Mr.Praveen Anand, learned counsel for the plaintiffs that the defendants have infringed the registered trade mark of the plaintiffs.

5. It is submitted that the plaintiff No.1 is the registered proprietor of inter alia trademarks in relation to the unique Green and Yellow colour scheme and logo. The use of the Green and Yellow colour combination is not merely for a stylistic purpose. The defendants have blatantly copied the impugned marks in relation to their agricultural vehicles without any authorization from the plaintiffs who are using the (Green and Yellow) colour scheme for which the plaintiffs have secured trademark registrations in India for its agricultural equipments. Further, the manner of use of this colour combination by the defendants is also deceptively similar to that adopted by the plaintiffs, i.e. the body of the vehicle being painted Green with the wheels and the seat of the vehicle being painted Yellow. Therefore, the manner of use of the . colour scheme is similar to that of the plaintiffs.

6. It is further submitted by Mr. Anand that such deceptively similar adoption by the defendants of the plaintiffs trademark and trade dress is bound to cause confusion in the minds of the consumers that the defendants agricultural vehicles are emanating from the plaintiffs and the defendants are passing off its agricultural equipments as those of the plaintiffs.

7. Before proceeding further, it is imperative for the Court to discuss the following definitions: Section 2(m) of the Trade Marks Act, 1999 (hereinafter referred to as "the Act") reads as under: "mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof" Section (zb) of the Act reads as under: "(zb) trade mark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours" It appears from the said provisions that colour/colour combination can become trademarks if these are distinctive and exclusively associated with the trader. Once the same is registered, exclusive rights are granted under Section 28 of the Act and rights are granted to the party to initiate infringement proceedings if the case comes within the four corners of Section 29 of the Act and such party can obtain injunction under section 135 of the Act.

8. In the case of Sodastream Ltd. v. Thorn Cascade Co Ltd. reported at 1982 RPC459 the plaintiffs were marketing the gas cylinders of grey colour under their trade mark Sodastream and the defendants were marketing their black colour cylinders under their own trade mark Thorn Cascade. While granting interlocutory injunction in favour of the plaintiffs, it was observed that the proposals of the defendants to refill the grey colour gas cylinders of the plaintiffs, even with their own trade mark amounts to passing off as the grey colour cylinder is distinctive of the plaintiffs in respect of which the reputation accrued in favour of the plaintiffs.

9. In another case Hoffmann-La Roche and Co. A.G. v. D.D.S.A. Pharmaceuticals Limited, reported in 1972 RPC1 the plaintiffs manufactured and marketed chlordiazepoxide in distinctive black and green capsules bearing the word Roche on each capsule, the defendants also marked and advertised the drug chlordiazepoxide in black and green 10mg capsules which were identical to those of the plaintiffs except that they bore the letters DDSA instead of the plaintiffs name. The plaintiffs were granted interlocutory injunction to restrain the defendants from passing off capsules of the patented drug as the goods of the plaintiffs. It was held that marketing of the capsules by the defendants in almost identical form to those of the plaintiffs was calculated to cause damage to the plaintiffs. It was further held that there was a likelihood of confusion as both the capsules contained the same drug. The public were not concerned with the identity of the manufacturing of the capsules as long as the capsules contained the same substance and had the same effect.

10. In light of the above, it is clear that the plaintiffs have been able to make out a strong prima facie case in their favour. The balance of convenience also lies in favour of the plaintiffs and against the defendants. In case the interim orders are not issued, the plaintiffs would suffer irreparable loss and injury.

11. Thus, the defendants, their partners or proprietors, principal officers, servants, agents and distributors and all others acting on its behalf as the case may be, are restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in any manner with agricultural products and/or any other goods and/or services using the plaintiffs word mark John Deere, the logo, the registered

trademark including trade dress and the colour combination thereof and any other mark deceptively similar thereto leading to infringement of the plaintiffs word mark John Deere , the logo and the trade (colour) mark, overall colour scheme and trade dress in relation to their agricultural equipment and vehicles and/or passing off their products (agricultural equipment) as belonging to the plaintiffs by using marks, colour combination and the consequent trade dress which are identical and/or deceptively similar to the plaintiffs word mark John Deere; the logo; the trade (colour) mark, overall colour scheme and trade dress.

12. The compliance of Order XXXIX Rule 3 CPC be made within one week from today. (MANMOHAN SINGH) JUDGE DECEMBER05 2014

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