

* IN THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment Reserved on : 04th February, 2022
Judgment Delivered on : 24th February, 2022

+ CS(COMM) 20/2020

HAVELLS INDIA LIMITED Plaintiff

Through Mr. Tejveer Singh Bhatia, Mr.Sudeep
Chatterjee, Mr. Kiratraj Sadana,
Ms.Ipshita Datta and Ms. Aamna
Ahmad, Advocates

versus

L RAMESH

..... Defendant

Through Ms. Shilpi M. Jain, Advocate

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

JUDGMENT

AMIT BANSAL, J.

I.A.12276/2021 (early hearing)

1. For the reasons stated in the application, the same is allowed.

I.A.578/2020 (O-XXXIX R-1 &2), I.A.2481/2020 (O-XXXIX R-4)

2. By way of the present judgment, I propose to decide the application filed on behalf of the plaintiff under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC) for grant of interim injunction pending the disposal of the suit and the application filed on behalf of the defendant

under Order XXXIX Rule 4 of the CPC seeking vacation of the *ex parte* ad interim injunction granted on 17th January, 2020, in favour of the plaintiff.

3. The plaintiff has filed the present suit seeking permanent injunction against the defendant from infringing/passing off, *inter alia*, the trademark, copyright, logo, trade dress of the plaintiff and other ancillary reliefs. In the suit, it has been pleaded that:

- (i) Plaintiff's company and its predecessors have been using the trademark/logo 'STANDARD' in relation to electrical products, including switch gears, fuse gears, cables, insulation wires, miniature circuit breakers since the year 1958.
- (ii) Plaintiff has obtained a number of trademark registrations in its favour for the mark 'STANDARD' in India as well as foreign jurisdictions, such as Kuwait, Africa, Nigeria, Saudi Arabia, etc.
- (iii) Due to extensive and long usage, the trademark/trade name 'STANDARD' has gained immense popularity and reputation in relation to the electrical products among the plaintiff's consumers and the general public. In support of this, the plaintiff has given its gross annual turnover as well as the amount spent on advertising and sales promotion for the years 2018–19.
- (iv) Plaintiff's trademark 'STANDARD' has been declared a well-known mark under Section 11(6) of the Trade Marks Act, 1999 by this Court in the order dated 8th March, 2016 in CS(OS) 2966/2015.
- (v) Plaintiff's trademark, brand name and trading style 'STANDARD' has acquired distinctiveness and secondary meaning.



- (vi) Defendant has dishonestly adopted the impugned marks  and  and has also copied the mark 'STANDARD' and has replaced the letter 'D' occurring at the end of the word STANDARD with the letter 'O' to form the impugned trademark 'SS STANDARO'.
- (vii) It is alleged that the defendant has not only copied the trademark of plaintiff but also copied the font thereof and has adopted the device of the triangle in the impugned trademark in which the letter 'S' is contained, so as to look deceptively similar to the logo of the plaintiff.
- (viii) In June, 2019, the plaintiff came across the defendant's impugned mark, which was published in the trademark journal in February, 2019 and filed an opposition against the same.
- (ix) In August, 2019, counter-statement with respect to the defendant's trademark application was filed by the defendant.
- (x) Pursuant to an investigation conducted on behalf of the plaintiff, the plaintiff came to know that defendant has not only copied trademarks but has also copied the packaging and other elements of the trade dress of the plaintiff's products to deceive the consumers into believing that the impugned products are those of the plaintiff.
- (xi) Defendant is using the impugned trademarks in relation to electrical goods such as MCB, switch gears, etc., which are identical to the goods being sold by the plaintiff.
- (xii) In view of the fact that the plaintiff is the registered proprietor and prior adopter of the trademark 'STANDARD', it is entitled to protect its registered trademark as also its goodwill and reputation.

4. The suit came up for hearing before the Court on 17th January, 2020, when, finding a *prima facie* case in favour of the plaintiff, this Court was pleased to pass an *ex parte* ad interim injunction order restraining the defendant from using the trademark 'STANDARD' / 'SS STANDARO' or

the logo/device of  and , or any other logo/device, trade dress deceptively similar to the plaintiff's registered trademarks.

5. The defendant in his written statement has, *inter alia*, pleaded that:

(i) The defendant is a registered proprietor for the trademark



under Class 9 and has been using the said trademarks since 1st November, 2003.

(ii) The letters 'SS' in the defendant's trademark initially stood for 'Shree' and 'STANDARO' but, later 'Shree' was deleted by the defendant.

(iii) The goods of the defendants using the logo/device  are sold only in Tamil Nadu.

(iv) The defendant has never used any trademark in the name of 'STANDARD' or 'SS STANDARD' or .

(v) The claim of the plaintiff is barred due to delay and laches as the plaintiff was aware of the user by the defendant since 2003 but chose to file the present suit in January, 2020.

(vi) The plaintiff has not filed any rectification proceeding in respect of the registered trademark of the defendant.



- (vii) The word 'STANDARD' is common to trade, and no one can claim exclusivity in respect to the word 'STANDARD'. As per the Trademark Public Search Report, more than 159 trademarks exist with the trademark 'STANDARD' as suffix or prefix or stand alone, out of which almost 46 trademarks are still registered.
- (viii) The defendant's trademark/logo (phonetically and visually) is different from that of the plaintiff's trademark/logo.
- (ix) The order dated 8th March, 2016 in CS(OS) 2966/2015 passed by this Court, whereby the trademark of the plaintiff was held to be well-known, was in terms of compromise decree under Order XXIII Rule 3 of the CPC, wherein the defendant had given no objection for the same.
6. Counsel for the plaintiff made the following submissions:
- (i) Various registrations granted in favour of the plaintiff in respect of the trademark 'STANDARD' as well as the logo in classes 7, 9 and 11 demonstrate that the word 'STANDARD' has been part of all the trademark applications filed on behalf of the plaintiff.
- (ii) Due to extensive and long use of its products under the mark 'STANDARD', the plaintiff's electrical products have gained immense popularity. In this regard, plaintiff has placed on record various sample invoices of the plaintiff selling its products under the mark 'STANDARD' as well as certificate of the Chartered Accountant certifying the gross turnover of the plaintiff in respect of products with the 'STANDARD' brand as well as the certificate of the Chartered Accountant showing the advertisement and selling

promotion carried out by the plaintiff for the ‘STANDARD’ brand from 2011–12 to 2018–19.

- (iii) A comparison between the trademarks and packaging of the plaintiff’s products and the defendant’s products show that the defendant has adopted trademarks/logos as well as packaging/trade dress which is deceptively similar to that of the plaintiff.
- (iv) Reliance is placed on the judgment by the Coordinate Bench of this Court in *Telecare Network India Pt. Ltd. v. Asus Technology Pvt. Ltd.*, 2019 SCC OnLine Del 8739 to contend that the trademark ‘STANDARD’ is a suggestive mark and not a descriptive mark. Reliance is also placed on the judgment of this Court in *Living Media India Ltd. v. Jitender V. Jain & Ors.*, (2002) 98 DLT 430.

7. *Per contra*, the defendant has advanced the following submissions:

- (i) The plaintiff obtained the *ex parte* order dated 17th January, 2020 on the basis of gross concealment. The plaintiff did not disclose to the Court that while being granted registration, a condition was imposed on the plaintiff that it would not have any exclusive right to use either

the word ‘STANDARD’ or ‘S’ or



- (ii) For the last many years, the plaintiff is using the trademark

‘STANDARD’ but are using the logo/device



and



. This information is available from the website of the



plaintiff. As on date, it is contended that there is no  in the plaintiff's current logo.

- (iii) It is denied that the defendant has ever used the flash device symbol as a part of its trademark.
- (iv) The word 'STANDARD' is a word occurring in the English language and no person can monopolise the use of the word 'STANDARD'.
- (v) In any case, the defendant has never used the word 'STANDARD' but has been using the word 'STANDARO'.

8. I have considered the pleadings and contentions of the counsels for the parties.

9. Plaintiff has been able to establish that it is the registered owner and has been using the trademark 'STANDARD' since the year 1958 in respect of electrical goods such as miniature circuit breaker, switch gear, isolator



etc. Plaintiff is also the registered owner of the device mark , which it has been using since 1969 as also the registered logo

STANDARD

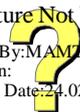
. The plaintiff has given its annual sale figure of Rs.538.93 crores for the year 2018–19 and also advertisement expenses of Rs16.57 crores for the year 2018–19, which shows that plaintiff has spent large amount of money for the promotions of its products under the mark 'STANDARD'. On account of the long usage and immense popularity of the electrical products of the plaintiff, the word mark 'STANDARD' has attained a secondary meaning so as to identify the goods of the plaintiff.



10. It is an admitted position that the user of the plaintiff has been prior in time to that of the defendant. Though, it is contended on behalf of the defendant that the plaintiff is no longer using the aforesaid trademarks, the fact of the matter is that the aforesaid marks are still registered in favour of the plaintiff and the plaintiff is free to use the aforesaid trademarks whenever it desires. In an action for infringement, where the defendant's trademark is identical or deceptively similar with the plaintiff's mark, the test has to be likelihood of confusion or deception arising from the similarity of marks.

11. At the outset, it would be apposite to reproduce a comparative table in respect of the trademarks being used by the plaintiff and the defendant:

	Plaintiff	Defendant
Mark/Logo		
Mark/Logo		



	Plaintiff	Defendant
Product Packaging	(Before 2015)	
	(After 2015)	
		

12. From a comparison in the table above, it is clear that the logo used by the defendant  is deceptively similar to that of the plaintiff's logo. Even the triangle device above the word 'STANDARO' with the letters 'SS' inside make the defendant's logo deceptively similar to that of the plaintiff. Even though the defendant uses the word 'STANDARO,' as opposed to 'STANDARD' used by the plaintiff, the fact of the matter is that both are written in the same font, the same colour and in uppercase, and consequently, a reader may end up reading the word 'STANDARO' as 'STANDARD'.

13. The mark  of the defendant (of a rectangle with the flash sign superimposed on the alphabet 'N'), is also deceptively similar to that of the plaintiff's mark, which also uses the flash sign superimposed on the letter 'N'. Though the defendant denies ever having used the flash device, the plaintiff has placed reliance on the invoices filed along with the report of the Local Commissioner to contend that the defendant was using the flash device on its logo.

14. A comparison of the defendant's packaging with that of the plaintiff's packaging and the trade dress, where also the aforesaid marks/logos and blue and white colour scheme have been used, show a great degree of similarity. It emerges from the above that the adoption of the marks by the defendant in the packaging on its product, being deceptively similar to that of the plaintiff's was not *bona fide*. Clearly, the attempt of the defendant has been to ride on the goodwill of the plaintiff. In my view, there is a likelihood of confusion being caused in the mind of a consumer taking into account the overall similarity between the impugned marks of the defendant and those of

the plaintiff and the plaintiff has been able to, *prima facie*, establish a case of infringement and passing off.

15. It is the defendant's own case that it does not use the word mark 'STANDARD' and nor does it intend to do so. The plaintiff has placed reliance on the judgment of this Court in *Telecare India Network* (Supra) in respect of its contention that the word 'STANDARD' is a suggestive mark and is therefore, entitled to registration. In my *prima facie* view, the word 'STANDARD' is a suggestive mark and not a descriptive mark.

16. It was contended on behalf of the defendant that there was a condition attached at the time of granting registration to the plaintiff, that the plaintiff would have no right for the exclusive use of the word 'STANDARD' or of



or of the letter 'S' and this was concealed at the time of grant of *ex parte* injunction on 17th January, 2020. I do not agree with the said contention of the defendant. The registration certificates were duly filed by the plaintiff and therefore, there can be no question of concealment. In any case, the said disclaimer cannot come in the way of the claim of the plaintiff with regard to passing off, nor would it come in the way of comparison of the label/device marks of the plaintiff and the defendant, which have to be seen as a whole for purpose of grant of relief of infringement on account of the long usage of the word mark 'STANDARD' which has attained a secondary meaning so as to identify the goods of the plaintiff.

17. In this regard, reference may be made to *Shree Nath Heritage Liquor Pvt. Ltd. V. M/s. Allied Blender & Distillers Pvt. Ltd.*, (2015) 63 PTC 551 (Delhi). The relevant portions of this judgment are set out below:

“15. We first need to discuss the effect of the disclaimer on the word ‘Choice’ in two of the respondent’s trademark registrations. In the decision reported as AIR 1955 SC 558 Registrar of Trademarks v. Ashok Chandra Rakhit, regarding passing off, the Supreme Court held that statutory disclaimer will have no bearing if the respondent’s trademark has acquired secondary meaning. In the facts of the present case, our prima facie view is in favour of the secondary meaning of the respondent’s mark ‘Officer’s Choice’ in light of the respondent’s long use and sales under the said trademark. Hence, the question of disclaimer is not relevant to the question of passing off in the present case.

16. Turning to the effect of disclaimer with respect to trademark infringement, it is pertinent to note at this point that only two registrations of the respondent, i.e. registrations No. 489582 and 538927, have the word ‘Choice’ disclaimed. The respondent has several trademark registrations, albeit some of which are labels, for alcoholic beverages and a host of other goods, for ‘Officer’s Choice’ without any disclaimer.

17. A disclaimer in a trademark does not travel to the market place. Hence, for the purpose of comparison of two marks, the disclaimed portion can also be considered. Therefore, the marks in the two registrations of the respondent with a disclaimer can be considered as a whole even for infringement.”

18. It has also been held in the said judgment that a subsequent dishonest user cannot take shelter under Section 17(2) of the Trade Marks Act, 1999 to contend that the statute permits it to commit passing off. Admittedly, the plaintiff is a prior user of the word mark ‘STANDARD’ as well as device marks and the defendant has adopted a deceptively similar mark wherein a dominant part of the defendant’s registered mark/label is being used.

19. The plaintiff has made out a *prima facie* case in its favour for grant of interim injunction. The balance of convenience also is in favour of the

plaintiff and against the defendant in as much as use by the plaintiff of the marks/logos according to the plaintiff is prior to that by the defendant.

20. During the course of the submissions, the counsel for the defendant made the submission that the defendant is prepared to give up the colour scheme of blue and white being used by the defendant so that there is no similarity with the orange, white and blue colour scheme used by the plaintiff and also that the defendant is willing to amend the word mark 'STANDARO' to being used in lowercase and in a different font in the script so that there is no visual similarity with the mark 'STANDARD' being used by the plaintiff.

21. The aforesaid changes suggested by the defendant were not acceptable to the plaintiff.

22. The *ex parte* injunction granted by this Court on 17th January, 2020 was on the basis of the impugned marks being used by the defendant at that point of time. The said injunction order covered trademarks 'STANDARD' /

'SS STANDARO' and the logo/device  and .

23. This injunction order would cover all trademarks that are identical/deceptively similar to the trademarks/logos and packaging of the plaintiff. Therefore, it is not for the Court, at this stage, to determine whether the proposed changes in the trademark by the defendant would be covered within the ambit of the injunction order passed by this Court on 17th January, 2020.

24. In any case, the said marks have not been placed before this Court. The defendant may, if so advised, use the amended label/logo, subject to the right of the plaintiff to challenge the same in appropriate proceedings.

25. The counsel for the defendant further submitted that the defendant is a small time trader, and should be allowed to sell the goods seized by the Local Commissioner since they are of immense value for a trader like the defendant. The defendant accordingly sought modification of the order dated 17th January, 2020 to the extent that he may be permitted to sell the goods seized by the Local Commissioner.

26. The goods have been duly described by the Local Commissioner in the report dated 07th February, 2020. The goods were given on *superdari* to the defendant with the undertaking to produce the seized goods as and when called by this Court.

27. Taking into account that the defendant is a small time trader, the defendant is permitted to sell the aforesaid goods subject to the following conditions:

- I. The defendant shall only put the aforesaid goods for sale after erasing the impugned marks/logos from the products as well as the packaging.
- II. The defendant shall file an affidavit to the effect that other than goods which were seized by the Local Commissioner and handed over on *superdari* basis, the defendant or his agents, stockiest, distributors shall not in any manner sell, advertise or in any manner deal with the goods bearing the impugned trademarks and logos.
- III. The defendant shall also undertake to give detailed and correct accounts of the sale of the said goods done pursuant to orders of this Court.

28. Accordingly, the order dated 17th January, 2020 is confirmed, subject to the aforesaid modification, till the disposal of the suit. I.A. No. 578/2020

of the plaintiff under Order XXXIX Rules 1 and 2 CPC and I.A. No. 2481/2020 of the defendant under Order XXXIX Rule 4 CPC stand disposed of in above terms.

CS(COMM) 20/2020 & I.A.5063/2021 (O-XXXIX R-2A)

29. List before the Joint Registrar on 14th April, 2022.

FEBRUARY 24, 2022

at/dk

AMIT BANSAL, J.

