TM No. 149/17
R K Steel (India) Vs. Smt. Shyama Devi Bohra & Anr.

11.04.2018

Order-

1. By this order I shall dispose off an application under Order 39 Rule 1 and 2 CPC.

Plaintiff's Case-

2. It is the case of plaintiff that it is engaged in the business of manufacturing and trade of wide range of window and door fittings and hardware products which includes bolts, screws, door handles, tower belts, aldrops, hinges, rivets, fasteners, door stoppers etc. and related allied and cognate goods and offering services in connection therewith as a trade in relation to its said goods and business. In the year 1998 the plaintiff has adopted the trademark/label **"ROYAL"**. The plaintiff over a period of time has been using its said trademark in various stylized/artistic format/labels which have been created and are being created over a period of time. The plaintiff has also provided details of its trademarks including class. It is averred that plaintiff also holds copyright in the art work involved in the plaintiff's trademarks/labels. The plaintiff is also promoting the said trademark through different means and modes including through their advertisement and publicity in leading newspapers, trade literature, trade hoardings and boards.

3. According to the plaintiff the said trademark has acquired secondary significance with the goods and business of the plaintiff an in view of the

unique goodwill and reputation it has earned, it has become well-known trademark within the meaning of Section 2(1) (zg) of the Trade Marks Act, 1999.

4. The plaintiff has been using the said trade marks honestly, bonafidely, extensively, exclusively, continuously, commercially and in course of trade. The plaintiff's goods under the said trademark are freely and commercially available in India. The details of the application for registration of trademarks in respect of various classes of goods have also been provided in the plaint.

5. It is a case of plaintiff that though defendant has filed a print out of all the 'registered' or 'objected to' Trademark from the website of the Registrar of Trademark Office under Class 6 but none of them have been registered for manufacturing of window and door fittings. It is further contended that as per the print out filed by defendant on record, the trademark of the plaintiff is registered since 1998 for window and door fittings under Class 6. Further Class 6 is a vast class and there are different products under which various goods are being manufactured and various owners have been registered with the trademark including ROYAL for different goods. None of the goods are the same as that of the plaintiff. It is further argued that only because certain other trademarks are registered with the tradename ROYAL, it does not prove that they are user of the said trademark as well. There is difference between common to trade and common to register.

6. It is further argued that in view of Section 28(3) of Trademark Act, in case more than one person is a registered owner of a Trademark, any of them can sue the defendant/infringer. Further no proof is filed by the defendant to show that all these registered users are manufacturer of same or similar

goods or that of plaintiff with the same or deceptively similar Trademark.

7. It is further argued that defendant applied for registration in 2008 and his application is still pending. Hence, if it is the argument of ld. counsel for defendant that the word ROYAL is descriptive of trade and goods of plaintiff, there was no need for him to apply for registration of the Trademark ROYAL.It is further the argument of plaintiff that the argument of counsel for defendant that he is not suing other trademark users is not a ground to permit defendant to keep on infringing his mark. Further plaintiff has filed copy of the order of one Civil Court wherein plaintiff has sued one of the infringers of his trademark. Further defendant has not filed any proof to show that he is in use of the said trademark since 2005.

Defendant's Argument-

8. It is the argument of ld. counsel for defendant that in view of the print out taken from website of the Trademark Registry, there are several other registered users with tradename ROYAL or other deceptively similar trademarks as that of plaintiff. Since all these registered users are in Class 6, hence the tradename is descriptive of Class 6. Further defendant is user of mark ROYALTEK since 2005. Further since other users are also using ROYAL, there cannot be injunction against him. Other users of ROYAL mark are not sued by plaintiff. Further application is bad for delay and laches. Further TOYAL and ROYALTEK are not deceptively similar.

9. I have heard both the sides and gone through the record.

Reasons for decision-

10. Admittedly, plaintiff is owner of the trademark ROYAL since 19.08.1998. He is registered under Class 6 for Steel and aluminum window and door

fittings included in Class 6.

11. Defendant has applied on 09.06.2008 claiming user since 2005 for registration of Trademark ROYALTEK with logo/device. The application is still pending before the Trademark Registry.

12. It is argument of counsel for defendant that there are several other registered users with ROYAL in Class 6 hence the word ROYAL is descriptive to Class 6. However, defendant has not filed any document to show that these registered users are manufacturing window and door fittings with the word ROYAL and selling in the market. The word ROYAL being common to registration under Class 6 does not imply that it is common and descriptive to the trade also. It was observed in **Century Traders Vs. Roshan Lal Duggar Co. dated 27.04.1977**, Hon'ble Court has observed-

> *"21. We now come to the question of balance of convenience. It has been urged on behalf of the respondents that the mark "RAJA-RANI" is common to the trade and for this purpose reliance has been placed on the registration in Andhra Pradesh and Amritsar. There is a distinction between a mark being "common on the register" and "common to the trade". There is no evidence on record to show that there is actual user of this mark by any party other than the parties before us."*

13. Further it was observed in para 13 of the said judgment that registration of a mark itself does not mean and does not prove its user at all. It is observed-

> *13.The Supreme Court in Corn Products Refining Co. v. Shangrila Food Products Ltd., ladi down the rule vis-a-vis user of mark as opposed to registration of mark. It observed that the onus of proving user is on the person who claims it. It did not approve of looking into the register of trade marks where a mark may be entered to be any proof of user. To quote from the speech of A K Sarkar, J: "Now, of course, the presence of a mark in the register does not prove its user at all. It is possible that the mark may have*

been registered but not used. It is not permissible to drawn any inference as to their user from the presence of marks in the register."

14. Hence, if the defendant claims that these registered users are also users of the said mark and are manufacturing similar goods as that of plaintiff, he must prove the same. Moreover, Class 6 itself is a vast class and there may be registration for different products under Class 6 itself. Under Class 6 also, there are 'specific goods' which are mentioned for which different trademarks with word ROYAL are registered. None of them is registered for window and door fittings except that of plaintiff.

15. Further it is not denied by the defendant and rather in the print out filed from Ministry of Home and Industry website, Trademark application of the defendant with word ROYALTEK is also mentioned. Defendant cannot plead on one hand that the word ROYAL is descriptive for trade and on the other hand applied for registration of the trademark ROYALTEL.

16. In case titled Indian **Hotels Company Ltd. & Anr. Vs. Jiva Institute of Vedic Science & Culture, 2008 (37) PTC 468 (Del.) (DB)**, Hon'ble Court observed-

> *"40. It was next argued by Mr. Rohtagi that the word 'JIVA' is a descriptive word which cannot be protected as a trade mark by a Civil Court. We do not think so, the appellant has itself applied for registration of the Jiva as a trade mark and cannot, therefor, argue that the mark is descriptive. In Automatic Electric Limited Vs. R K Dhawan & Anr. 1999 PTC (91) 81 this court has in similar circumstances repelled the contention and held that since the defendant had itself sought to claim a proprietary right and monopoly in "DIMMER DOT", the disputed trade mark it did not lie in its mouth to say that the said mark was a generic expression."*

17. It is also further argued by counsel for defendant that since other registered users under Class 6 were also using trademark ROYAL hence

there cannot be an injunction against him. It is further observed-

> *41. It was also contended by Mr. Rohtagi that since other parties were also making use of the trade mark Jiva the plaintiff was not entitled to the injunction prayed for. The decision of this Court in Info Edge (India) Pvt. Ltd. & Another Vs. Shailesh Gupta & Another 2002 (24) PTC 355 (Del.) provides a complete answer to that submission. The Court was in that case also dealing with a similar argument against the issue of an injunction which was repelled, holding that the use of the trade mark by some other party against whom the plaintiffs have not proceeded immediately for seeking an injunction would not dis-entitle him from seeking an injunctionagainst another party who was similarly committing a violation.*
> *42. To the same effect is the decision of this Court in Essel Packaging Limited Vs. Sridfhar Narra & Anr. 2002 (25) PTC 233 (Del.) where the court has in almost similar circumstances held that use of the trademark by other parties against whom the plaintiffs have not proceeded does not dis-entitle him to proceed against the defendant. The Court observed:*
> *"22. Merely because some other parties or persons are using the name ESSEL does not provide a justification to the defendants for using the said name as the plaintiff has been using this name mush prior to the adoption of this name by defendants and its widespread use of this name shows that this word has become synonymous with the business of the plaintiff and its group companies."*

18. It is further the argument of ld. counsel for defendant that plaintiff has not sued other owners with trademark ROYAL. Hence no injunction can be granted against him. However, it is argument of plaintiff that as and when he feels there is threat to his business from any other manufacturer he will sue the same as well. It was observed in **Pankaj Goel Vs. Dabur India Ltd., 2008 (38) PTC 49 (Del.) (DB)**-

> *22. As far as the Appellant's argument that the word MOLA is common to the trade and that variants of MOLA are available in the market, we find that the Appellant has not been able to prima facie prove that the said 'infringers' had significant business turnover or they posed a threat to Plaintiff's distinctiveness. In fact, we are of the view that the Respondent/Plaintiff is not expected to sue all*

small type infringers who may not be affecting Respondent/Plaintiff business. The Supreme Court in NATIONAL BELL VS. METAL GOODS reported in AIR 1971 SC 898 has held that a proprietor of a trademark need not take action against infringement which do not cause prejudice to its distinctiveness. In EXPRESS BOTTLERS SERVICES PVT. LTD. VS. PEPSI INC. & OTHERS reported in 1989 (7) PTC 14 it has been held as under :-

"....To establish the plea of common use, the use by other persons should be shown to be substantial. In the present case, there is no evidence regarding the extent of the trade carried on by the alleged infringers or their respective position in the trade. If the proprietor of the mark is expected to pursue each and every insignificant infringer to save his mark, the business will come to a standstill. Because there may be occasion when the malicious persons, just to harass the proprietor may use his mark by way of pinpricks.... The mere use of the name is irrelevant because a registered proprietor is not expected to go on filing suits or proceedings against infringers who are of no consequence.... Mere delay in taking action against the infringers is not sufficient to hold that the registered proprietor has lost the mark intentionally unless it is positively proved that delay was due to intentional abandonment of the right over the registered mark. This Court is inclined to accept the submissions of the respondent No. 1 on this point....The respondent No. 1 did not lose its mark by not proceeding against insignificant infringers..."

In fact, in DR. REDDY LABORATORIES VS. REDDY PAHARMACEUTICALS reported in 2004 (29) PTC 435 a Single Judge of this Court has held as under :-

"..., the owners of trade marks or copy rights are not expected to run after every infringer and thereby remain involved in litigation at the cost of their business time. If the impugned infringement is too trivial or insignificant and is not capable of harming their business interests, they may overlook and ignore petty violations till they assume alarming proportions. If a road side Dhaba puts up a board of "Taj Hotel", the owners of Taj Group are not expected to swing into action and raise objections forthwith. They can wait till the time the user of their name starts harming their business interest and starts misleading and confusing their customers."

19. Further defendant has not filed any proof to show that he is using the said mark since the year 2005.

20. It is also the argument of counsel for defendant that the application is bad for delay and laches. However, counsel for plaintiff has observed in case titled Midas Hygiene Industries Pvt. Ltd. & Anr. Vs. Sudhir Bhatia & Ors., 2004 (28) PTC 121 (SC)-

> *"5. The law on the subject is well settled. In case of infringement either of Trade mark or of Copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the Mark was itself dishonest."*

21. In view of above, when plaintiff is registered user of ROYAL under Class 6 for window and door fittings, by adopting the trademark ROYALTEL the defendant appears to have infringed the trademark logo of the plaintiff. An unvary customer while going to market to purchase the goods of the trademark under the Trademark ROYAL and can easily be deceived in purchasing the goods of the defendant which are identical as that of plaintiff treating the goods of defendant as those of plaintiff.

22. It is also the argument of counsel for defendant that logo of the defendant is different. However, logo might be different but there is no explanation coming from the defendant regarding use of word ROYAL itself in the word ROYALTEK for use of this particular mark and both the words are deceptively similar. Only adding TEK to word ROYAL does not grant it any novelty.

23. In view of above, plaintiff being registered owner of the said mark ROYAL has been able to prove prima facie case in its favour. Plaintiff has filed various documents on record pertaining to the year 1999 onwards thereby showing sale of different products by the plaintiff.

24. In view of above, plaintiff has been able to establish on record that the ROYALTEK trademark adopted and being used by the defendant in relation to its impugned goods is identical or deceptively similar to the plaintiff's trademark ROYAL and both are manufacturing the same goods and services. Further the balance of convenience is also lies in favour of paintiff. Further plaintiff is going to suffer irreparable loss and injury if defendant is not injuncted from using the same. Plaintiff has filed documents on record pertaining to year 1991 even thereby showing proof of their use.

25. In the circumstances, application is alowed and defendant/ individual is hereby restrained from using, selling, soliciting, exporting, displaying, advertising or by any other mode or manner dealing in or using the impugned trademark ROYALTEK, word, artistic/stylized in relation to the impugned goods and business of 'window and door fittings'.

Application disposed of accordingly.

(TWINKLE WADHWA)
ADJ-03/PHC/NEW DELHI
11.04.2018

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Present: Ld. Counsel for the plaintiff.
Shri Lalit Kumar, Ld. Counsel for the defendant.

Vide separate order of even date, application under Order 39 Rule 1 and 2 CPC is disposed off.

Put up for admission/denial and framing of issues on **04.09.2018**.

(TWINKLE WADHWA)
ADJ-03/PHC/NEW DELHI
11.04.2018