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

+ **CS(COMM) 735/2024**

MERCK KGAA

.....Plaintiff

Through: Ms. Nancy Roy, Mr. Raghav Malik
and Ms. Aastha Kakkar, Advocates.

Versus

BHARAT PATEL

.....Defendant

Through: None

CORAM:

HON'BLE MR. JUSTICE SAURABH BANERJEE

ORDER

% **29.08.2024**

I.A. 37716/2024 (Section 12A CCA, 2015)

1. The plaintiff *vide* the present application, is seeking exemption from instituting pre-litigation mediation.
2. Considering the averments made therein and as the plaintiff is seeking an urgent ad-interim relief as also in view of the orders passed in ***Yamini Manohar v. T.K.D. Krithi*** 2024 (5) SCC 815 and ***Chandra Kishore Chaurasia vs. R. A. Perfumery Works Private Limited*** 2022:DHC:4454-DB, the plaintiff is exempted from instituting pre-litigation mediation.
3. Accordingly, the present application is allowed and disposed of.

I.A. 37718/2024 (for exemption)

4. Exemption as sought is granted, subject to all just exceptions.
5. Applicant shall file legible, clear, and original copies of the documents on which the applicant may seek to place reliance upon within

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four weeks from today or before the next date of hearing, whichever is earlier.

6. Accordingly, the application stands disposed of.

I.A. 37715/2024 (*additional documents*)

7. The plaintiff *vide* the present application under Order 11 Rule 1(4) of the Code of Civil Procedure, 1908 as applicable to commercial suits under the Commercial Courts Act, 2015 is seeking to place on record additional documents within thirty days.

8. The plaintiff will be at liberty to file additional documents within thirty days as sought, *albeit*, strictly as per the provisions of the Commercial Courts Act, 2015 and the DHC (Original Side) Rules, 2018.

9. Accordingly, the present application is allowed and disposed of.

I.A. 37717/2024 (*seeking permission to file documents in a compact disc (CD/ DVD)*)

10. The plaintiff *vide* the present application is seeking permission to file certain documents as mentioned at para 4 of the present application in the form of electronic records i.e. in compact disc (CD/ DVD).

11. In terms of Rule 24 of Chapter XI of the Delhi High Court (Original Side) Rules 2018, let the electronic record by way of an encrypted CD/DVD/Medium with a hash value in a non-edited form be filed before the Registry within a period of four weeks.

12. Let the same accordingly form a part of the record of the present suit by way of an electronic folder in such a manner that it can be opened to view by this Court as and when required. Also let the hash value shall be kept separately by the Registry on the file.

13. The application is allowed and disposed of.



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14. The plaintiff has instituted the present suit seeking a decree of permanent injunction for infringement of trademarks, passing off, unfair trade competition and damages against the defendant.

15. Let the plaint be registered as a suit.

16. Upon filing of the process fee, issue summons of the suit to the defendant through all permissible modes returnable before the Joint Registrar on 03.12.2024.

17. The summons shall state that the written statement be filed by the defendant within a period of *thirty days* from the date of the receipt of the summons. Written statement be filed by the defendant along with affidavit(s) of admission/ denial of documents of the plaintiff, without which the written statement shall not be taken on record.

18. Replication thereto, if any, be filed by the plaintiff within a period of *fifteen days* from the date of receipt of written statement. The said replication, if any, shall be accompanied by with affidavit(s) of admission/ denial of documents filed by the defendant, without which the replication shall not be taken on record within the aforesaid period of *fifteen days*.

19. If any of the parties wish to seek inspection of any document(s), the same shall be sought and given within the requisite timelines.

20. List before the Joint Registrar for completion of pleadings on 03.12.2024. It is made clear that if any party unjustifiably denies any document(s), then it would be liable to be burdened with costs.

21. List before the Court on 07.01.2025.

I.A. 37714/2024 (*Order XXXIX rule 1 & 2 CPC, 1908: Stay*)

22. The plaintiff *vide* the present application is seeking to restrain the



defendant and all those acting on his behalf from infringing upon the registered and well known trademark namely 'MERCK' registered in the plaintiff's name.

23. As per pleadings before this Court and arguments addressed in support thereof by the learned counsel for plaintiff, the case of the plaintiff is as under:-

23.1. The plaintiff is a world-renowned manufacturer and merchant of pharmaceutical and chemical products in addition to being among the oldest and active pharmaceutical and chemical companies of the world, established in the year 1668 in Germany. Further, the plaintiff has been using the registered and well-known trademark 'MERCK' since as early as 1668 and in connection to its worldwide business has been using it both as a corporate name and its flagship brand as well as a house mark.

23.2. Though the plaintiff is headquartered in Germany, however, it generates sales in over 66 countries around the world. Further, the plaintiff has been active in India since the turn of the 20th century, its first representation *E. Merck (India) Private Ltd.* was set up in India in 1967 as the plaintiff's first wholly owned Asian subsidiary, which became a public limited company in 1981.

23.3. The plaintiff has acquired significant goodwill and recognition in the market *qua* the registered trademark 'MERCK'. In fact, in order to strengthen the same, it has also acquired registrations of the said trademark and its variations in different languages as well in India under Class(s) 1, 2, 3, 5, 7, 9, 11, 16, 17, 29, 30, 32, 35, 40, 41, 42 and 44 as per details entailed in paragraph 5 of the present application.

23.4. The plaintiff's mark 'MERCK' has been recognized as a well-



known trademark under the Trade Marks Act, 1999 as per the list of well-known marks published by the Trade Marks Registry and was advertised in Journal No. 2144 at Page No. 18415 as under:-

271	MERCK	MERCK KGaA FRANKFURTER STRASSE 250, 64293 DARMSTADT, GERMANY.	Registrar of Trade Marks	The Registrar observed that the "MERCK" is a well-known trade mark.
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23.5. The plaintiff also owns and maintains several websites specifically targeted towards Indian customers and which are used for marketing and selling its products as also updating its customers about the plaintiff's research and development forays, drug developments, new product launches, etc. All the said domain names contain the trademark 'MERCK'. The list whereof are as under:-

Domain Name	Date of Registration
▪ www.merck.co.in/	28 February 2004
▪ www.merckmillipore.in/	1 March 2010
▪ www.merckmillipore.co.in/	1 March 2010
▪ www.merck-millipore.co.in	1 March 2010
▪ www.merckserono.in/	22 December 2006
▪ www.merck-serono.co.in/	26 April 2011
▪ www.merck-performance-materials.in	4 November 2011
▪ www.merckfertility.in	10 September 2018

23.6. The well-known house mark and trading name 'MERCK' of the plaintiff forms an essential part of the branding of the plaintiff's products, which can be ascertained from some of its pharmaceutical products as under:-





23.7. Ever since its inception, the plaintiff has spent tremendous time, effort, and resources for extensively promoting and advertising its registered trademark 'MERCK' nationally and internationally, in many major medical books, journals, magazines and through the electronic medium of television and internet which are accessible to a large number of the Indian population. It is also submitted that over the years, the plaintiff has been honoured with many awards and recognitions, many of which directly in relation to the plaintiff's activities in India.

23.8. The goodwill and reputation of plaintiff can be gauged from the fact that it operates in 66 countries and currently employs over 62,000 people worldwide and global net sales of around 21 billion Euros in 2023. The plaintiff under the said trademark recorded an annual total sales figure of 42,600 against its plaintiff's product in India of 42,600 (INR to Mio) in the year 2023 as per details entailed in paragraph 53 of the present suit. Further, the promotional figures of the products bearing the trademark 'MERCK' indicates that the plaintiff spent 370 (INR to Mio) in the financial year 2022-2023 for promoting and marketing the products containing the said marks.

23.9. The defendant operates as a sole proprietorship firm trading under the name and style of *M/s. Merck International*, engaged in exporting, manufacturing, trading and supplying of goods/ services such as industrial chemicals, synthetic rubber adhesive, industrial chloroform, industrial thinner, paint thinner and many other kind of chemicals, under the impugned trade name MERCK INTERNATIONAL and the impugned

marks MERCK/





23.10. It was in the third week of February, 2023 when the plaintiff became aware of the defendant from the e-commerce website IndiaMart that it established its business in the year 2022 and is engaged in the business of exporting, manufacturing, trading and supplying of goods/ services such as industrial chemicals, synthetic rubber adhesive, industrial chloroform, industrial thinner, paint thinner and many other kind of chemicals, under the aforesaid impugned name and marks. Furthermore, an extensive investigation revealed that the defendant had registered a domain name namely *www.merckinternational.com*, though the said impugned domain name was registered on 23.04.2022, the same was found to be not operational.

23.11. Thereafter, the plaintiff issued two Cease and Desist notices on 23.02.2023 and 23.03.2023 and then kept in constant touch with the defendant, who sought some time to make the relevant changes in the impugned trade name/ mark and domain name. Thereafter, the plaintiff came to know of the renewal of the website *www.merckinternational.com* of the defendant and also that the domain name registration was recently renewed on 02.07.2024.

24. In the wake of the above, the plaintiff has instituted the captioned suit against the defendant.

25. This Court has heard the submissions advanced by the learned counsel for the plaintiff and gone through the pleadings as also perused the documents on record.

26. Trade name being the prime identification of an entity acts as a



mirror to the outside world at large and connotes an individual identity of the said entity to them as it denotes who/ what it is in more than one, if not all, respects. It is for this reason that an entity has to be careful and cautious while choosing a trade name. If the trade name of such an entity is identical and/ or similar and/ or comparable and/ or like that of another already existing entity or for that matter another trademark then it is not only bound to create suspicion and doubt but also may give rise to a semblance of a relation/ connection *inter se* the two in the minds of one and all, be it anyone from the general public and/ or someone belonging to the members of the trade.

27. Similar is the case with respect to adoption and usage of a trademark by an entity.

28. The present proceedings is one such which has arisen since the plaintiff is aggrieved by the adoption and usage of its registered trademark 'MERCK', which has since been declared as a well-known mark under *Section 2(1)(zg)* of the Trade Marks Act, 1999, by the defendant. The cause for concern of the plaintiff is more since the defendant is also dealing in, offering and selling its goods/ services such as industrial chemicals, synthetic rubber adhesive, industrial chloroform, industrial thinner, paint thinner and many other kind of chemicals as that of the plaintiff.

29. That the plaintiff is an old well established entity having a well-established registered trademark 'MERCK', having more than 350 years of existence in the world market and a presence of more than 55 years in the Indian market, is likely to give an impression that it has/ is merely extending its line of business. Under such circumstances, the adoption and



usage of the said registered trademark 'MERCK' of the plaintiff by the defendant, which came into existence in India as late as on 11.11.1950, more so, since as per plaintiff it is the prior adopter and prior user having registration of the trademark 'MERCK', since the last 55 years in India and which has since been declared as a well-known mark under *Section 2(1)(zg)* of the Trade Marks Act, 1999, defies logic.

30. Since the defendant is also engaged in the identically similar line of business and dealing/ offering/ selling goods/ services such as industrial chemicals, synthetic rubber adhesive, industrial chloroform, industrial thinner, paint thinner and other kind of chemicals as that of the plaintiff and is/ will be using the identically similar trade channels *qua* the same set of identically similar customers, there can be no qualms with respect to it already having the knowledge about the plaintiff, its registered trademark 'MERCK', which has also since been declared as a well-known mark under *Section 2(1)(zg)* of the Trade Marks Act, 1999 and the goodwill and reputation attached to them, both worldwide and in India. The defendant, thus, while adopting and using the registered trademark 'MERCK', which has since been declared as a well-known mark under *Section 2(1)(zg)* of the Trade Marks Act, 1999, of the plaintiff, was required to be more careful and tread with caution and care.

31. Having given a go-bye to the aforesaid, the intentions of the defendant are shrouded with mystery as it has been guilty of blatantly adopting and using the identically similar registered trademark 'MERCK' of the plaintiff. The only reason for this can be that the defendant was bent to somehow make all efforts to come as close as possible to the plaintiff and show/ portray to the general public that it is somehow associated/



connected with the plaintiff and that its goods/ services such as industrial chemicals, synthetic rubber adhesive, industrial chloroform, industrial thinner, paint thinner and many other kind of chemicals are coming from the house of the plaintiff.

32. In view of the aforesaid, the *balance of convenience* and probabilities heavily tilt in favour of the plaintiff for grant of an *ex parte ad interim* injunction in its favour and against the defendant. So much so, as per the existing circumstances, the plaintiff has been able to make out a *prima facie* case in its favour and against the defendant as well. Therefore, allowing the defendant to continue using the impugned mark, which is identically similar to that of the registered trademark 'MERCK' of the plaintiff, is prone to cause *irreparable harm, loss and injury* to it.

33. Though the plaintiff issued two Cease and Desist notices on 23.02.2023 and 23.03.2023, however, as per plaintiff, since they then kept in constant touch with the defendant, who sought some time to make the relevant changes in the impugned trade name/ mark and domain name and since the acts of the defendant were a continuous cause of action, bearing in mind the dicta in ***Bengal Waterproof Ltd. v. Bombay Waterproof Mfg. Co.***, (1997) 1 SCC 99 and ***Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia***, (2004) 3 SCC 90, a well reputed entity like the plaintiff who is holding the registered trademark 'MERCK' in its name is entitled to grant of an *ex parte ad interim* injunction in its favour.

34. Accordingly, till the next date of hearing, the defendant, and all those acting on their behalf is/are restrained from using, manufacturing, selling or offering for sale, marketing, advertising, promoting, displaying or in any other manner whatsoever using the impugned trade name



MERCK INTERNATIONAL and the impugned marks MERCK/



or any

other trade name/ mark which is identical, virtually identical or deceptively and/ or confusingly similar or encompasses the plaintiff's earlier and well-known trademark MERCK, in any manner whatsoever.

35. Upon filing of the process fee, issue notice to the defendant by all permissible modes returnable before the Joint Registrar on 03.12.2024.

36. Reply, if any, be filed within a period of *thirty days* from the date of service. Rejoinder thereto, if any, be filed within a period of *fifteen days* thereafter.

37. The provisions of *Order XXXIX rule 3 CPC* be complied within one week from the receipt of this order.

38. List before the Court on 07.01.2025.

Dasti.

SAURABH BANERJEE, J

AUGUST 29, 2024/Ab