



2024 : DHC : 3221



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

% Reserved on : 10th April, 2024

Pronounced on : 24th April, 2024

+ **I.A. 14318/2022 in CS(COMM) 614/2022, I.A. 6943/2024 &
CRL.M.A. 10836/2024**

MR SANJAY ARORA Plaintiff

Through: Mr. Rishabh Gupta, Mr. Shivam
Gupta and Ms. Vidhi Goel,
Advocates.

versus

JASMER Defendant

Through: Mr. Harish Kumar, Mr. Mukund
Yadav, Mr. Shivam Kumar and Mr.
Sd. Hussain, Advocates.

ANISH DAYAL, J.

ORDER

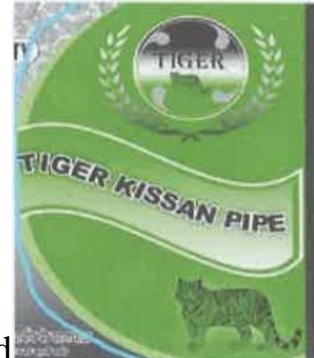
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I.A. 14318/2022 (under Order XXXIX Rule 1 and 2 CPC)

1. This application has been filed under Order XXXIX Rule 1 and 2 CPC as part of accompanying suit seeking permanent injunction restraining defendant and all those acting for and on his behalf from manufacturing, selling, using, displaying, advertising, importing, exporting or in any other manner dealing with impugned goods and products bearing the



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trademark/device/label and or any other trade mark/label/device identical with or deceptively similar to



plaintiffs trademark/label/device 'TIGER' .

2. Notice in the application was issued on 6th September, 2022. On 29th February, 2024, when submissions were heard on behalf of counsel for plaintiff, a set of additional documents filed on 1st March, 2023 were adverted to. However, as the counsel for defendant stated that he did not have a copy of the same, it was directed that documents be supplied to defendant, despite the fact that they were filed one year prior.

3. On 29th February, 2024, two photographs were adverted to by counsel for plaintiff to show that in 2014, defendant was actually an employee of plaintiff, who had already been using the registered trademark



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‘**TIGER**’ with respect to their products i.e. pipes used for agricultural purposes.

4. On 8th April, 2014, further submissions were heard on behalf of parties. A query was put to counsel for defendant by the Court whether the person in photographs was defendant himself or not. To this, counsel for defendant did not make any statement. Accordingly, directions were issued for defendant to appear in Court on 10th April, 2024, as also, to file an affidavit in this regard.

5. On 10th April 2024, an affidavit was filed by defendant/Mr. Jasmer stating that he had seen the coloured photographs that plaintiff had placed on record which were taken from the surveillance camera installed in the premises of plaintiff. Further, he confirmed that he was the person in those photographs. He did not accede to the genuineness of the said surveillance camera recording, including the date, but did state that the image appearing in the video showed his presence.

Submissions on behalf of Plaintiff

6. Counsel for plaintiff has made the following submissions in support of his application:

6.1 The first application No. 3746492 for trademark ‘**TIGER**’ (device)/



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was applied on 6th February, 2018 in class 17, claiming user from 17th June, 2003. The said mark was registered on 5th July, 2021 in favour of plaintiff.

6.2 Yet another registration was sought by plaintiff in class 19 *vide* application No. 3746494, with the same user detail being 17th June, 2003, applied on 6th February, 2018 and granted on 27th June, 2021.

6.3 On 29th May 2019, copyright registration *vide* A-129594/2019, was also granted in favour of plaintiff in artistic work in said device, with the first year of publication being 2003 in India.

6.4 Plaintiff became proprietor of said trademark and has been an honest and *bona fide* user of the same, in course of its trade for product of agricultural pipes and has built up enormous goodwill and reputation in the said mark.

6.5 Turnover claimed by plaintiff in the said mark is as under:



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Financial Year	Turnover (in rupees)
2004-2005	42,08,400/-
2005-2006	56,49,900/-
2006-2007	60,79,535/-
2007-2008	1,20,78,359.80/-
2008-2009	97,20,719.40/-
2009-2010	1,02,58,000/-
2010-2011	77,67,015.00/-
2011-2012	1,25,68,222/-
2012-2013	1,19,53,250/-
2013-2014	2,03,80,670/-
2014-2015	2,06,31,180/-
2015-2016	1,81,71,880/-
2016-2017	2,04,92,854/-
2017-2018	5,08,81,882/-
2018-2019	6,90,94,843/-
2019-2020	7,40,42,175.54
2020-2021	8,33,75,487/-
2021-2022 January	6,39,10,789/-

6.6 Defendant had been an employee of plaintiff, but owing to misconduct and theft committed by him at the premises of plaintiff, defendant was removed from his job in February, 2017. Therefore, defendant was well aware of plaintiff's marks and other details of his business.

6.7 A complaint was filed on 23rd February, 2017 by Mr. Sanjay Arora of plaintiff company with SHO of PS Samaipur Badli, stating that defendant



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was doing business of ‘**TIGER KISSAN PIPES**’ etc. under ‘**TIGER BRAND**’. FIR bearing No. 459 dated 2nd June, 2018 was registered under Sections 408 and 34 of the Indian Penal Code, 1860 (“**IPC**”) against defendant. Allegation was made therein that defendant had committed fraud on the complainant and had threatened him as well. On this basis, counsel for plaintiff stressed that their complaint was proof enough that as of 2017, plaintiff was already using ‘**TIGER BRAND**’, while it was applied for by defendant only on 25th May, 2017.



6.8 Defendant had sought registration of mark *vide* application No. 3556724, dated 25th May, 2017 in class 19 on ‘*proposed to be used*’ basis. This mark was subsequently abandoned and not used by defendant, which fact has been confirmed by counsel for defendant.

6.9 Subsequently, the second mark for which defendant sought



registration was on 8th October, 2019 in mark in class



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17 *vide* application No.4314765 on '*proposed to be used*' basis. This mark, as confirmed by counsel for defendant, is still being used.

6.10 Reference was made to para 10 of the written statement filed by defendant, contending that plaintiff had adopted same and similar label as of defendant. It was further stated that defendant was his previous employee, which fact was also confirmed by counsel for defendant. It was thus asserted by counsel for plaintiff that it was defendant's own submission, that the mark of plaintiff was similar/same to that of defendant, therefore, on question of similarity, there could be no opposition.

6.11 Invoices of plaintiff were shown from 2005 onwards with watermark '**TIGER BRAND**'. However, counsel for defendant strongly refuted the same stating that watermark on invoices were only from 2015 onwards, as produced by plaintiff.

6.12 It is asserted that end user of the product is a farmer and therefore, possibility of confusion arises with the same mark '**TIGER**' being used as part of registered marks of both plaintiff and that of defendant. Further, it is evident from a comparison of both marks that there would be a likelihood of confusion and association between both marks in the minds of the end user.

6.13 A cease-and-desist notice was sent to defendant on 14th October, 2021, to which defendant replied on 26th October, 2021, stating that his mark was different from that of plaintiff. Thereafter, defendant on 1st November, 2021 filed rectification petitions against plaintiff's registered trademarks alleging that the word '**TIGER**' was common to trade.



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6.14 Defendant had visited all distributors and retailers, being the former marketing executive of plaintiff, and therefore, had complete knowledge of the market and user of the product. It was alleged that defendant had informed the whole network in the market that trademark of plaintiff had changed and therefore, created tremendous confusion in the minds of the users in the said market by such deception.

Submissions on behalf of defendant

7. Mr. Harish Kumar, counsel for defendant, placed the following submissions in response:

7.1 Counsel for defendant stated that defendant had applied for registration of trademark on 25th May, 2017 in class 19 on a '*proposed to be used*' basis. He submitted that plaintiff was not using the '**TIGER BRAND**' since 2003, as wrongly claimed by plaintiff and had adopted the mark in February, 2018, only after the trademark application was filed by defendant.

7.2 Counsel for defendant while adverting to para 14 of written statement submitted that plaintiff had been using other marks like 'KING', 'KARTIK', 'SHERA' and 'EXPLODE' while defendant was working with the plaintiff.

7.3 Plaintiff could not claim exclusive use of the mark '**TIGER**' and in any event defendant used a completely different trade dress for their packaging, along with their device mark.



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7.4 List of marks on the trademark register in class 17 which used ‘**TIGER**’ brand were adverted to by defendant, to show that ‘**TIGER**’ was common to this class and plaintiff cannot claim exclusivity of same.

7.5 Defendant filed a rectification on 1st November, 2021, however, plaintiff asserted that it was 3 years after the registration application by plaintiff.

7.6 Invoices of plaintiff till 2019 did not show the ‘**TIGER**’ watermark and only subsequent to invoice dated 4th July, 2019, the watermark of ‘**TIGER**’ was present.

7.7 Invoices of plaintiff from 2005 to 2007 which show the ‘**TIGER**’ watermark did not match the copies that defendant obtained from parties that had been supplied goods by plaintiff. The third-party copies show that there was no watermark on the said invoices. He vehemently contended that plaintiff had fabricated their invoices and interpolated the watermark, in order to show that they were actually in use.

Rejoinder on behalf of plaintiff

8. Counsel for plaintiff, countering the submissions made by defendant’s counsel, submitted in rejoinder as under:

8.1 On the issue of registrations of other users, it was submitted by counsel for plaintiff that defendant cannot rely upon other trademarks in the word ‘**TIGER**’ registered in classes 19 or 17, since only five of the registered users in class 19 for the word ‘**TIGER**’ pertain to pipes and are



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marginal users and further, have been registered subsequent to registration of plaintiff's mark. Only one mark as regards class 19 was registered prior to registration of plaintiff's mark, being, 'TIGER GAON' by applicant 'KUBER Tobacco Products Pvt Ltd.' and as regards class 17, only seven were with respect to pipes and only one namely, 'TIGER HILL', had been registered prior to registration of plaintiff's mark.

8.2 In any event, he placed reliance on decision on *Pankaj Goel v. Dabur India Ltd.*, 2008 SCC OnLine Del 1744, of Division Bench of this Court, to state that mere citing of trademark register by defendant was not enough and that defendant has not been able to *prima facie* prove that other users of the same brand '**TIGER**' had significant business turnover and posed a threat to plaintiff's distinctiveness. It was also stated that plaintiff is not expected to sue all third-party infringers not impacting plaintiff's business in any way.

8.3 Counsel for plaintiff had extensively relied upon video-captures filed subsequently, which were of the year 2014 for the months of February, September and November, to show that perusal of the CCTV footage revealed that while the process of packaging of plaintiff's products was ongoing in his warehouse, pertaining to the brand '**TIGER**', defendant was also present in the picture. The said captures are extracted as under:



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Analysis

9. The essential controversy revolves around as to who was the prior user of the trademark '**TIGER**' and who adopted it subsequently. Application for registration was made by plaintiff on 6th February 2018 for both classes 17 and 19. Plaintiff has claimed user from 17th June 2003 in the '**TIGER**' (device) in both these classes. Defendant on the other hand, applied for registration of his trademark on 25th May 2017 in class 19 on '*proposed to be used*' basis. Moreover, the said mark of defendant in class 19 was subsequently abandoned and therefore, its relevance and applicability would be in question. Even though registration application was



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filed by defendant prior to that of plaintiff, the issue would be as to since when the user is claimed.

10. While plaintiff claims user since 2003, defendant's application was on a '*proposed to be used*' basis. The registration for the subsequent mark, which is currently being used by defendant, was obtained in 2019 in class 17, again on a '*proposed to be used*' basis. Defendant's mark, which is in current use, uses the word '**TIGER**' in a circular globe surrounded by a wreath and the words '**TIGER KISSAN PIPE**' along with a picture of a tiger. It is therefore, evident that the device mark sought to be relied upon by defendant, is focused and centered on the mark '**TIGER**'.

11. For the sake of argument, even if the abandoned mark of defendant is considered, it is evident that on 25th May 2017, when defendant had applied, it was on a '*proposed to be used*' basis. Plaintiff, however, claims user since 2003 and in support of the same, has placed invoices from 2005 onwards with the product mentioned as '**AGRICULTURE KISSAN PIPE**' which had a watermark with '**TIGER BRAND**'. These invoices with watermark were appended by plaintiff for various years *inter alia* 2005-2018.

12. Counsel for defendant had sought to raise a doubt by drawing attention to certain invoices of plaintiff which did not have the watermark and which were relatable to 2007, in particular, 25th December 2007, 26th December 2007 and 29th December 2007 selling the product '*plastic dana*'. However, on careful perusal of the record, it bears out that plaintiff has



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produced those three invoices also without a watermark and therefore, there is no question of any dispute in that regard. The other invoices of plaintiff to which counsel for defendant draws attention to, which do not have a watermark, are scattered invoices of various dates in the years 2011, 2014, 2015, 2017 and 2018. However, this may not have any bearing considering that plaintiff's sets of invoices filed which have watermark are approximately 69 in number from year 2005 till 2018 in various products *inter alia* 'Agriculture Kissan Pipe', 'Plastic Reprocessed Tubing', 'Bundle Reprocessed Tubing', 'Recycled Plastic Pipe', etc. By selectively picking out invoices which did not have a watermark, defendant cannot possibly displace the claim of user by plaintiff since 2005 at the minimum. In any event, *prima facie*, the Court cannot countenance defendant's submissions that the watermark is interpolated. Defendant of course, would have to prove the same during trial. However, at this stage, on a bare perusal of said documents, it does not seem, *prima facie* that the watermark has been interpolated.

13. Aside from this, the critical evidence which plaintiff relies upon are the coloured photographs which are captures of video footage from surveillance cameras in plaintiff's warehouse / factory. It is an admitted position that defendant was an employee of plaintiff till February 2017. The photographs, as is admitted by defendant, show defendant in the said footage of surveillance camera, as extracted above. Even though as per plaintiff, these photographs have a time stamp of the year 2014 for the months of February, September and November (which defendant denies



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being accurate), his presence in photographs does show that he was an executive / worker in the said factory and is seen in various frames along with plaintiff's products packaging bearing plaintiff's mark '**TIGER**' in the device (now registered). Even assuming that the time stamp is wrong, at the very least, it will be prior to February 2017. In such a scenario, defendant having applied for his first mark on 25th May 2017 (abandoned



subsequently), which was

& was therefore,



identical with plaintiff's mark , it would clearly seem that defendant had dishonestly adopted the same. Even though defendant gave an explanation for abandoning the said mark later, having been confronted and not wanting to get into a dispute with plaintiff, it would suggest that defendant was attempting to adopt plaintiff's mark and then



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made a second attempt later by adopting a different device being



14. Defendant's submission that it was plaintiff who had copied the mark from defendant when defendant had sought to register it on 25th May 2017, cannot be sustained on the basis of documents presented before the Court in the suit. Further, defendant would find it very difficult to squirm out or explain away his presence in the plaintiff's factory prior to February 2017, along with plaintiff's goods showing the '**TIGER BRAND**'.

15. Plaintiff had rightly adverted to complaint dated 3rd February 2017 as well alleging that defendant had committed fraud upon him. The said complaint stated that plaintiff was using '**TIGER BRAND**'. This too, would bear out that plaintiff was very much a user of said brand in February 2017 which is much before defendant's application in May 2017. Besides, there are no other documents produced by defendant to show any user prior to the said date.

16. The argument relating to brand '**TIGER**' being used by various users in classes 17 and 19 and therefore common to trade, may not come to the rescue of defendant, in facts and circumstances as already adverted to above, which *prima facie* show dishonest adoption of an identical mark for



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identical goods. In this context, the following judgments become relevant in favour of plaintiff:

16.1 Firstly, reliance may be placed on the decision of a Coordinate Bench of this Court in *Ishi Khosla v. Anil Aggarwal*, 2007 SCC OnLine Del 126, where defendants added the word ‘Diet’ as prefix in their mark after adopting the trademark of plaintiff i.e. ‘Whole Foods’. The Court held that dishonest adoption of somebody else’s trademark who entered the market prior in time, is to be discouraged. The relevant paragraph of the said decision is extracted as under:

“23. ...It is not to suggest that the plaintiff has monopoly over these products. Any other person may enter the trade and be a competitor. Competition is healthy for not only consumers but for manufacturer as well and is, therefore, in public interest. However, what is to be discouraged in the dishonest adoption of somebody else's trademark and trying to ride on the goodwill created by the competitor who entered the market prior in time. This is what is sought to be done by the defendants by clever manipulation, namely, adding the word ‘DIET’ in their mark after adopting identically the entire trademark of the plaintiff i.e. ‘Whole Foods’. This intention of the defendants becomes manifest as they have also adopted same style of the trademark and same labels/packing etc...”

(emphasis added)



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16.2 Secondly, the decision of a Coordinate Bench of this Court in *Copenhagen Hospitality and Retails and Others v A.R. Impex and Other*, 2022 SCC OnLine Del 4701, is also relevant. In the said decision, defendant was a former employee of plaintiffs', who were operating a chain of pizzerias under the name 'La Pino'z Pizza'. After a termination agreement was executed between the parties, defendant set up its own 'La Milano Pizzeria'. The Court held that adoption of such mark by defendant was dishonest and mischievous, considering the past contractual relationship between the parties and the manner in which defendants adopted the impugned mark. The relevant paragraph is extracted below:

“45. ...Further, a brand-owner is not duty-bound to initiate or file an action against every infringer whatsoever, even if it does not impact its business. Therefore, even if a Plaintiff has not taken action against other third parties who may be using marks similar to its own, this non-action cannot be a good ground to refuse injunction. That said, the facts of the case demonstrate that the adoption of the marks by the Defendant was dishonest. Undisputedly, Defendant No. 1 was the franchisee of Plaintiff No. 1. Whilst in business, they were using the Plaintiffs' trademarks as a licensee. They used these-marks for monetization of their business and now cannot turn around and challenge the validity of such marks. Significantly, on termination of the agreement, they adopted marks for their pizza names which are visually and phonetically, ex facie, similar to the Plaintiffs' marks. This adoption is therefore mischievous, considering the past contractual relationship between the parties and



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the manner in which the Defendants have come to adopt the impugned marks. These facts establish a prima facie case. Balance of convenience also lies in favour of the Plaintiff to be entitled to an injunction restraining the Defendants from using any marks deceptively similar to Plaintiffs' registered marks noted in the table above.”

(emphasis added)

16.3 Thirdly, the decision of a Single Judge of this Court in *ACL Education Centre Pvt. Ltd. and Another v Americans' Centre for Languages and Another*, 2007 SCC OnLine Del 2010, while granting an *ex parte* injunction in favour of plaintiffs, relied upon the case of *A.C. Krishnan v. Nambisan's Dairy Pvt. Ltd.*, (1997) 17 PTC 806, to elaborate on dishonest adoption of plaintiff's mark by defendant who was a former employee of plaintiff's firm. Further, reliance was also placed on decision of *Munday v. Carey*, 1905 RPC 273, to state that in the case of dishonest adoption, greater attention is to be paid to the items of similarity and less to the items of dissimilarity. The relevant paragraphs are extracted as under:

“9. In A.C. Krishnan v. Nambisan's Dairy Pvt. Ltd., 1997 PTC 17 (DB), the plaintiff had adopted the trade mark 'Nambisans'. First defendant was working as Manager in one of the branches of the plaintiff's firm. Second defendants' father was a dismissed employee of the plaintiff. They had started using the trade mark 'Nambeesans'. The Court held that it was dishonest adoption and would cause confusion in the mind of the probable



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customers or purchasers and thus, confirmed the injunction granted by the High Court against the defendants from using the said name. It was also held that generic name had relevance only for the purpose of registration and in an action of passing off it was immaterial.”

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xxx

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11. In the case of *Munday v. Carey*, 1905 RPC 273 the Court held:

“...I believe that it is a rank case of dishonesty, and where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity”.

(emphasis added)

16.4 Lastly, in the decision of *Neuberg Hitech Laboratories Pvt. Ltd. v. Dr. Ganesan's Hitech Diagnostic Centre Pvt. Ltd.*, 2022 SCC OnLine Mad 8779, it was held that an injunction should follow if it appears, either *prima facie* or otherwise, that the adoption of the mark was dishonest. In the said decision, defendants were the the ex-employees of plaintiff and appropriated the mark of plaintiff by applying it to the business established by them. The relevant paragraph is extracted as under:

“33. It should also be noticed that the plaintiff's assertion that two employees of the plaintiff



resigned from its employment and established the second defendant under the trade name “Hitech Advanced Labs” is not denied by the defendants. Thus, it appears that two ex-employees of the plaintiff, without permission or authorisation, appropriated the mark of their ex-employer and applied it to the business established by them. Since these facts are not controverted, they qualify as prima facie evidence of dishonest adoption by the first defendant. The second defendant was admittedly acquired by the first defendant and, thereafter, a limited company was incorporated under the corporate name “Neuberg Hitech Laboratories Private Limited”, which contains the mark “Hitech”. The plaintiff is an established diagnostic services company especially in Tamil Nadu and the first defendant cannot and does not assert ignorance of the prior use of the mark “Hitech” by the plaintiff....

*.....Considering the above and the admitted fact that the first defendant's adoption of the mark owes its origin to the acquisition of the second defendant, the first defendant's adoption is also prima facie not honest. Both *Midas Hygiene Industries Pvt. Ltd. v. Sudhir Bhatia*, (2004) 3 SCC 90 and *T.V. Venugopal v. Ushodaya Enterprises Limited*, (2011) 4 SCC 85 instruct that an injunction should follow if it appears, either prima facie or otherwise, that the adoption of the mark was dishonest. Therefore, a prima facie case is made out for the grant of interim relief.”*

(emphasis added)



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17. In any event, reliance of plaintiff on *Pankaj Goel (supra)* to state that plaintiff cannot be expected to sue all infringers who might not be effecting 0further proof of commercial use or business status of these other ‘**TIGER**’ brands. In any event, what *prima facie* seems to be blatant dishonest adoption cannot be countenanced by Court, at least at this stage and therefore, in the opinion of this Court, plaintiff is entitled for an injunction in his favour in terms of Order XXXIX Rule 1 and 2 of CPC.

18. Accordingly, defendant and all those acting for him or on his behalf are restrained from using the mark ‘**TIGER**’ or ‘**TIGER KISSAN PIPE**’ or any other mark identical or deceptively similar to that of plaintiff’s registered mark ‘**TIGER**’, either as a wordmark or part a logo / device, part of trade dress, domain name, promotional campaign or brochure. Defendant will ensure that all existing packaging, promotional material is discontinued or withdrawn from distributors / vendors / sales force within a period of 3 weeks.

19. This application stands disposed of with the aforesaid directions.

CS(COMM) 614/2022 alongwith I.A. 6943/2024 & CRL.M.A. 10836/2024

1. List before Joint Registrar on 10th May, 2024.
2. Judgment be uploaded on the website of this Court.

ANISH DAYAL, J.

APRIL 24, 2024/sm/na