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IN THE HIGH COURT OF DELHI AT NEW DELHI

Date of decision: 28th October, 2022

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CS(COMM) 343/2021

**GUJARAT COOPERATIVE MILK MARKETING FEDERATION
LTD & ANR. Plaintiffs**

Through: Mr. Sunil Dalal, Sr. Advocate with
Mr. Abhishek Singh, Mr. J. Amal
Anand, Mr. Eluin Joshy, Ms. Alisha
Sharma, Mr. Ujjawal Verma, Ms.
Manisha Saroha, Ms. Pratibha Varun,
Mr. Shanul Kadian and Mr.
Devanshish, Advocates (M:
9910291290).

versus

MARUTI METALS & ANR. Defendants

Through: Mr. Shailen Bhatia and Mr. Arnav
Chatterjee, Advocates for D-1 with
Mr. Nilesh Veljibhai Tilala, partner
(M: 9818558690).

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid conferencing.

I.A. 5773/2022 (u/O XXXIX Rule 2A) and I.A. 13342/2021 (u/O XXXIX Rule 4)

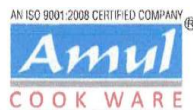
Brief Facts

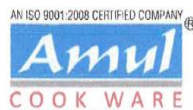
2. This suit has been filed by Plaintiff No.1 - Gujarat Cooperative Milk Marketing Federation Ltd. and Plaintiff No.2 - Kaira District Cooperative Milk Producers' Union Ltd. (*hereinafter, 'Plaintiffs'*) seeking permanent injunction *qua* the Plaintiffs' well-known mark 'AMUL'. The Defendant

No.1 - Maruti Metals is engaged in the business of cookware, pressure cookers manufactured and sold under the trade mark AMUL. Defendant No. 2 - GO DADDY.COM LLC is the Domain Registrar of the infringing domain name of the Defendant No.1 i.e., www.amulcooker.com.

3. The case of the Plaintiffs is that Plaintiff No.2 is the registered proprietor of the 'AMUL' trademarks and has licensed Plaintiff No.1, *vide* Trademark License Agreement dated 15.01.2001, right to use the said trademarks for milk, milk products and other foods and beverages. The Plaintiff No. 2 made its entry into the dairy industry in the year 1948 and has been using the trademark 'AMUL' originating from the name "Anand Milk Union Limited", since 1958. The Plaintiffs mark 'AMUL' is renowned in India and is one of the country's best known brands for dairy products. The Plaintiffs are stated to have daily milk procurement of more than 250 Lakh kgs, produced from more than 18,559 village milk Co-operative societies and 3.6 million milk producers. They have also sponsored and promoted a large number of international events including sporting events under the brand name 'AMUL' and are said to have the longest running advertisement campaign in the world, running since 1966.

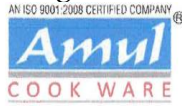
4. The grievance of the Plaintiffs is that the Defendant No.1 is manufacturing, marketing and selling pressure cooker, sauce pans and other



cookware under the mark  (hereinafter, 'impugned mark') which is identical/deceptively similar to the Plaintiffs' well known trademark 'AMUL'. The following reliefs are prayed for in the present suit:

“a) Pass a decree of permanent injunction restraining Defendant No.1, their principal officers, family members, servants, agents, dealer, distributors,

franchisees and anyone acting for and on their behalf, from advertising, promoting or in any other manner using or dealing with the infringing mark



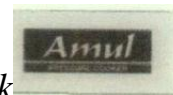
' and the mark

b) Pass a decree of permanent injunction restraining Defendant No.1, their principal officers, family members, servants, agents, dealer, distributors, franchisees and anyone acting for and on their behalf, from advertising, promoting or in any other manner dealing with the Plaintiffs' 'AMUL' trademarks or any logos or any word, which is identical or deceptively similar to the Plaintiffs "AMUL' trademarks.

c) Pass a decree of permanent injunction qua Defendant No.1 to transfer the domain name: www.amulcooker.com to the Plaintiffs and a further Order of permanent and mandatory injunction restraining Defendant No.1, their principal officers, family members, servants, agents, dealer, distributors, franchisees and anyone acting for and on their behalf, from in any manner 'using the domain name .. www.amulcooker.com .. or any domain name which has 'AMUL' as suffix or prefix

d) Pass a decree directing Defendant No.2' to permanently block/delete/suspend the domain name .. www.amulcooker.com ..

e) Pass a decree directing the Defendant No.1 to surrender to the Plaintiffs, for destruction, all goods, advertisement materials, packing materials, cartons, wrappers, labels, which bear the infringing



mark ' or the mark .. or any mark which is identical/deceptively similar to the Plaintiffs' "Amul" trademarks.

f) Pass a preliminary decree in favour of the Plaintiffs directing the Defendant No.1 to render a true and faithful account of profit earned by it on account of infringement of the well known trademark of the

Plaintiffs "Amul" and a final decree be passed in favour of the Plaintiffs for the amount of profits thus found to have been made by the Defendant No.1 after the Defendant No.1 has rendered the accounts.

g) Pass a decree awarding damages to the tune of INR 2,01,00,000/- for committing infringement of the Plaintiffs well known trademark "Amul".

5. Defendant No. 1 in the present case, as per its pleadings on record adopted the mark AMUL PRESSURE COOKER / AMUL COOKWARE in 1991. The basis of adoption given by the Defendant is that the word AMUL is a short form of the word AMULYA which translates to 'priceless' in English. As per the sales figures averred in the Written Statement, Defendant No. 1 has been using the impugned mark since the year 1992. The Defendant No. 1 is stated to have filed a trademark application in 1992 which was abandoned by it in the same year. Thereafter, it filed a second trademark application bearing no. 1029249 for the mark 'AMUL PRESURE COKKER' in 2001. A notice of opposition bearing no. 163643 against the same was filed by the Plaintiff No. 2 in 2004 but was "deemed to have (been) abandoned" *vide* order dated 7th January, 2005 passed by the Id. Assistant Registrar of Trademarks. Thus, the Defendant No.1 trademark was granted registration in class 21 bearing registration no. 1029249 from 20th July 2001 *vide* Certificate No. 860005 dated 30th March 2010. Thereafter, in 2016 a rectification Application was filed by the Plaintiffs against the impugned mark before the Trademark Registry and the same is pending before the said authority.

6. In the present suit, on the first date of hearing, *vide* order dated 30th July, 2021 the Court observed as follows:

- “3. The Court has been able to trace out, from the record of the Trademark Registry, as available in the public domain, an order dated 7th January, 2005, passed by the Assistant Registrar of Trademarks, noting the fact that the opposition, of the plaintiffs, to Trademark Application No. 1029249 of the defendant was "deemed to have (been) abandoned ... under rule 50(2) of the Trade Marks Rules, 2002. It was only thereafter that the Trademark Registry proceeded to register the trademark of the defendant.
4. This document does not find place either in the pleadings in the plaint or in the documents filed with the plaint.
5. Before proceeding to hear the plaintiffs even for issuance of summons or considering of prayer for grant of interim relief, the court has to satisfy itself regarding the bona fides of the plaintiffs and the justification for not placing the aforesaid document and details on record. The submission that the Trade Marks Registry had not "factored in" the objection, of the plaintiff, to the defendant's mark does not appear to reflect the true position.”
7. Subsequently vide order dated 13th August, 2021, an *ex-parte ad interim* order was granted restraining the Defendant No. 1 with the following observations:

“1. The prayer clause in this application, under Order XXXIX Rules 1 and 2, reads thus:

“In the abovementioned facts and circumstances, it is most respectfully prayed that this Hon'ble Court may be pleased to:

- a) Pass *ad-interim ex-parte* orders restraining Defendant No. 1, their principal officers, family members, servants, agents, dealer, distributors, franchisees and anyone acting for and on their behalf from advertising, promoting or in any other

manner using or dealing with the infringing



mark 'COOK WARE' and the mark

b) Pass ad-interim ex-parte orders restraining Defendant No. 1, their principal officers, family members, servants, agents, dealer, distributors, franchisees and anyone acting for and on their behalf from advertising, promoting or any other manner dealing with the Plaintiffs 'AMUL' trademarks or any other logos or any word, which is identical or deceptively similar to the Plaintiffs "AMUL" trademarks.

c) Pass ad-interim ex-parte orders restraining Defendant No. 1, their principal officers, family members, servants, agents, dealer, distributors, franchisees and anyone acting for and on their behalf, from in any manner using the domain name www.amulcooker.com or any domain name which has 'AMUL' as suffix or prefix.

d) Pass ad-interim ex-parte orders directing Defendant No. 2 to permanently block/delete/suspend the domain name "www.amulcooker.com"

e) Any other relief that this Court may deem fit and proper while looking into the facts and circumstances of the case."

2. Issue notice to the defendants.

3. Notice be served by all modes. Notice be served on Defendant No. 1 dasti in addition, by the plaintiff through its own agency, as the office of the Defendant No. 1 is situated outside Delhi.

4. For this purpose, the Registry is directed to issue notice to Defendant No. 1 dasti, and provide a copy thereof to the plaintiff, so that service of notice could be effected on the said defendant.

5. Affidavit of service along with proof thereof be placed on record before the next date of hearing.

6. *Let a response to this application be filed by the defendants within two weeks of effecting of service with advance copy to learned counsel for the applicant/plaintiff, who may file rejoinder thereto, if any, before the next date of hearing.*

7. *Renotify this application on 9th September, 2021 for hearing and disposal, subject to completion of pleadings.*

8. *In the meantime, there shall be an ad interim order in terms of prayers (a) and (b) in this application.”*

8. Pursuant to the aforementioned order, the *interim* injunction application bearing **IA 9876/2021** was listed on 9th September, 2021. On the said date the Court while recording the submission on behalf of the Defendant No.1 that the domain name - www.amulcooker.com was disabled and no other domain name with ‘AMUL’ as suffix or prefix was being used by Defendant No.1, held that in view of the same no further *ad interim* orders are required to be filed in the said interim injunction application.

9. Defendant No. 1 filed **I.A. 13342/2021** seeking vacation of the interim order. Meanwhile, the Plaintiffs in April 2022 filed contempt application **I.A. 5773/2022** against Maruti Metals – Contemnor No.1, the partners in Maruti Metals - Contemnor No.2-8, and IndiaMart Intermesh Ltd – Contemnor No.9, alleging that the Contemnor No.1-8, have not complied with the aforementioned *ad-interim* order dated 13th August, 2021 and are continuing to use the impugned mark for online sales and is therefore in contempt. The allegation against Contemnor No.9 is that it has not delisted the infringing products from its website as per the injunction order.

Submissions


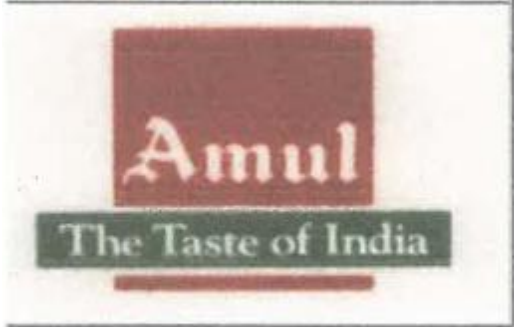

10. Today, Mr. Dalal, Id. Senior Counsel for the Plaintiffs, submits that 'AMUL' is a very well-known brand in India and deserves to be protected across the board in all classes. The adoption of the mark 'AMUL' by the Plaintiffs took place in 1958 and the adoption of the said mark for cookware and pressure cookers is a dishonest adoption by the Defendant No.1. He further submits that the Plaintiff's sales are in thousands of crores and since it is one of India's most valuable brands Defendant No.1 ought not to be allowed to use the mark 'AMUL' even in respect of unrelated class of goods such as cookware, houseware, homeware and appliances etc. He further relies on the judgements of this Court in *CS(COMM) 294/2021* titled *Gujarat Cooperative Milk marketing Federation Ltd. v. M/s Shree Bankey Bihari Vegetables and Foods Co &Anr.* and *CS(COMM) 501/2019* titled *Kaira District Co-Operative Milk Producers Union Limited & Anr. v. Amul Travels & Anr.* to submit that Plaintiffs' mark is a renowned mark and has been protected by this Court on several instances.

11. Mr. Bhatia, Id. Counsel appearing for the Defendant No.1 submits that the Plaintiff is guilty of gross suppression of material facts inasmuch as the Plaintiffs claim in the suit to have learnt about Defendant No.1 for the first time in June, 2021. Id. Counsel submits that Plaintiff No. 2 had filed notice of opposition against the trademark application bearing no. 1029249 of the Defendant No. 1 in 2004 and had also filed a Rectification Petition against the impugned mark in 2016, nearly 11 years after the notice of opposition. The case in the plaint is belied by the opposition which was abandoned as also the rectification petition. Id. Counsel also relies on the sales figures of Defendant No.1 amounting to 615.63 Lakh for the financial year 2020-21

under the impugned mark to seek vacation of the *ad-interim* injunction order dated 13th August, 2021.

Findings & Analysis

12. The Court has considered the matter. In the present case the two competing marks are identical i.e., 'AMUL' and 'AMUL'. A side by side comparison of the marks of the Plaintiffs and Defendant No.1 are reproduced herein below:

PLAINTIFFS' TRADEMARKS	DEFENDANT NO. 1's TRADEMARK
<p>AMUL (word mark)</p>   <p>(device mark)</p>	<p>AN ISO 9001:2008 CERTIFIED COMPANY[®]</p>  <p>COOK WARE</p> <p>since-1991</p>

13. Plaintiffs use the mark 'AMUL' for various milk and dairy products and have various registrations in classes 5,29, 30,31,32 and 35, the earliest being of 1958 bearing registration no. 185698 in class 29. The mark has also been used as prominent part of the mark for various products such as AMUL FRESH CREAM, AMULICK, AMULDAN etc. The sales turnover of the Plaintiffs for the last financial year is stated to be over Rs. 32,960 crores and the marketing expense for the mark 'AMUL' for the last financial year is claimed to be Rs. 862.96 crores which itself shows that the Plaintiffs' mark 'AMUL' is extremely well-known. Further, the Plaintiffs' mark was recognized as a well-known mark for the first time in **OA/56/2011/TM/KOL** titled **M/s. Kaira District Co-Operative Milk Producers Union Limited v. Deputy Registrar of Trade Marks & Ors.** wherein the IPAB emphasised 'AMUL' as being a well-Known Trademark. The relevant part of the said order is as follows:

*6. Aggrieved by the said order, the appellants are before us on appeal. The main grievance of the appellant is that their trade mark AMUL is extensively and continuously used since 1955 for milk and diary products. Their sales turnover runs to several crores of rupees. **The trade mark AMUL is a well known mark.** The use of the impugned trade mark will definitely cause confusion and deception among the trade and public. The learned Registrar though considered the trade mark AMUL to be a well known trade mark but had gone ahead to decide in favour of the respondents considering the issue that the respondents are using the trade mark since 2001. The impugned order therefore deserves to be set aside and the appeal be allowed.*

14. Plaintiffs' mark has been recognized as a well-known trademark by the Id. Registrar of Trademarks vide its letter bearing No.CG/TMR/Well-known trademarks/2015/147 dated 29.05.2015. This Court has also granted the Plaintiffs injunction against AMUL TRAVELS in **CS(COMM) 501/2019** titled ***Kaira District Co-Operative Milk Producers Union Limited & Anr. v. Amul Travels & Anr.*** Moreover, in **CS (OS) 107/2020** titled ***Kaira District Milk Producers Union Ltd. & Anr. v. Maa Tara Trading Co. & Ors.*** the High Court of Calcutta while granting an injunction in favour of the Plaintiffs held as follows:

“3. The trade mark “AMUL” is a brand known across India and across globe. The brand symbolizes a very Indian brand that has become a household name across the length and breadth cutting across class lines. The trade mark “AMUL”, irrespective of goods it is applied upon, is the sole repository and identifier of the plaintiff and its member. The trade mark “AMUL” symbolizes a movement among Indian Rural Community towards prosperity and Indian public perceives the trade mark “AMUL” having association of connection with the plaintiffs and no other. It is a combination of all the forgoing factors that had culminated into the trade mark “AMUL” being recognized as well-known trade mark and, therefore, deserves a broader scope of protection against unauthorized use on non competing goods or services.”

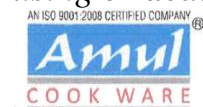
15. In the background of these facts, judicial notice can be taken that the Plaintiffs' mark 'AMUL' is a well-known mark owing to its large scale use, extensive promotion and the immense goodwill which it has acquired. Dairy products and cookware are allied goods inasmuch as they are used in the kitchen and thus the use of an identical mark i.e. 'AMUL' in respect of dairy

products, cookware and pressure cookers cannot be permitted as it is likely to cause confusion and deception in the mind of the consumer. Owing to the expanse of the Plaintiffs' business, as also the instantaneous recognition of the AMUL brand, consumers are likely to associate cookware under an identical brand as originating from the Plaintiffs. Further, since the Plaintiff's mark 'AMUL' is known across the length and breadth of the country it deserves to be protected as a well-known mark even in respect of unrelated goods in terms of Section 29(4) of the Trademarks Act, 1999.

16. Accordingly, the prayers in the interim injunction application – **I.A. 9876/2021** which are set out below are liable to be allowed.

“ In the abovementioned facts and circumstances, it is most respectfully prayed that this Hon'ble Court may be pleased to:

a) Pass ad-interim ex-parte orders restraining Defendant No. 1, their principal officers, family members, servants, agents, dealer, distributors, franchisees and anyone acting for and on their behalf from advertising, promoting or in any other manner using or dealing with the infringing mark



and the mark

b) Pass ad-interim ex-parte orders restraining Defendant No. 1, their principal officers, family members, servants, agents, dealer, distributors, franchisees and anyone acting for and on their behalf from advertising, promoting or any other manner dealing with the Plaintiffs 'AMUL' trademarks or any other logos or any word, which is identical or deceptively similar to the Plaintiffs "AMUL" trademarks.

c) Pass ad-interim ex-parte orders restraining Defendant No. 1, their principal officers, family members, servants, agents, dealer, distributors, franchisees and anyone acting for and on their behalf,

from in any manner using the domain name www.amulcooker.com or any domain name which has 'AMUL' as suffix or prefix.

d) Pass ad-interim ex-parte orders directing Defendant No. 2 to permanently block/delete/suspend the domain name "www.amulcooker.com"

17. At this stage, Mr. Bhatia, Id. Counsel for the Defendant No.1, upon instructions from Mr. Nilesh Veljibhai Tilala - Partner, Defendant No.1 Company, submits that Defendant No.1 is willing to change its brand name from 'AMUL' to 'AMULYA' as an *ad interim* arrangement. However, Id. Senior Counsel for the Plaintiffs objects to this on the ground that 'AMULYA' is also a registered trademark of the Plaintiffs and is used by them for certain products.

18. The Court is of the view that despite the objection of the Id. Senior Counsel for Plaintiffs, in the overall facts of this case, where the use by the Defendants dates back to the year 1992 Defendant No.1 ought to be allowed to change its name brand name from 'AMUL' to 'AMULYA' as an *ad interim* arrangement. This is because in the present case a perusal of the prayers in the plaint and the prayers in the interim injunction application show that the same are focused on the mark 'AMUL' and/or any other mark confusingly/deceptively similar to the Plaintiffs' mark 'AMUL'. The word AMULYA used for cookware cannot at this stage be held to be deceptively similar to AMUL, especially in the factual background of this case. The said word also has connotations in Hindi as also in Sanskrit. As an *interim* arrangement the following directions are issued:

- i) The Defendant No.1 shall cease manufacture or sale, advertising etc., of products under the mark 'AMUL'.

ii) The Defendant No.1 shall write to the e-commerce platforms or any online platforms/directories selling the impugned products of the Defendant No.1 seeking removal of the said listings. If the said listings are not removed, the Plaintiffs are also permitted to write to all the online platforms, upon which the said platforms shall give effect to this order without any further directions of this Court. Accordingly, all 'AMUL' branded cook wear and pressure cooker products shall remain delisted from all e-commerce platforms or any other online platforms

iii) All existing packaging under the mark 'AMUL' kept with the Defendant No.1, will not be used and shall be destroyed by Defendant No.1.

iv) Defendant No.1 is permitted to use the mark 'AMULYA' as an *interim* arrangement in respect of its cookware, pressure cookers, etc.

v) In respect of the mark 'AMULYA', the colour combination, style of writing etc. shall be completely distinct and different from the Plaintiffs' mark 'AMUL'. In order to ensure that there is no dispute regarding the writing style, colour combination, etc, Mr. Bhatia, Id. Counsel for the Defendant No.1 shall forward to the Id. Senior Counsel for the Plaintiff within a week the new writing style and colour combination which the Defendant No. 1 intends to adopt. Upon arriving on an agreement on the same, the Defendant No.1 may adopt the mark 'AMULYA' with the agreed writing style and colour combination.

19. The present *interim* arrangement between the parties shall not bind the final decision in this suit, post trial. The opinion expressed in this order is

prima facie in nature.

20. The Plaintiff's remedies *qua* the Defendant's registration of the mark 'AMULYA' are left open.

21. If there are any fresh listings or continuous use of the mark 'AMUL' or sale of AMUL marked products by the Defendant No.1, the Plaintiff is permitted to approach this Court.

22. *I.A. 5773/2022 and I.A. 13342/2021* are disposed of.

I.A. 13694/2021 (u/O VII Rule 10 & 11)

23. *I.A. 13694/2021* is not pressed by Mr. Bhatia, Id. Counsel for the Defendant No.1.

24. *I.A. 13694/2021* is disposed of.

CS(COMM) 343/2021

25. List before the Joint Registrar for marking of exhibits on 2nd December, 2022.

26. List before the Court on 24th January, 2023.

**PRATHIBA M. SINGH
JUDGE**

**OCTOBER 28, 2022
MR/KT**