

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

% **Date of decision: 19th April, 2017.**

+ **CS(COMM) 1381/2016**

SUNIL MITTAL & ANR **Plaintiffs**
Through: Mr. D.K. Yadav & Mr. Sudhir Balyan,
Advs.

Versus

DARZI ON CALL **Defendant**
Through: Mr. J. Sai Deepak, Mr. Mohit Goel,
Mr. Sidhant Goel, Mr. Bhardwaj
Jaishankar, Ms. Pragya Mishra & Mr.
Ashutosh Nagar, Advs.

CORAM:
HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW

**IA No.12449/2016 (of plaintiffs u/O XXXIX R-1&2 CPC) & IA
No.15269/2016 (of defendant u/O XXXIX R-4 CPC)**

1. The plaintiffs Mr. Sunil Mittal and Darzi (India) LLP claiming to be registered proprietor of the label mark



in respect of textile cloth included in Class 24 (of IV Schedule of Trade Marks Rules, 2002) have sued the defendant M/s Darzi on Call (a partnership of Md. Ali Reza, Ms. Nazia Nabi and Sh. Avinash Kumar) for injunction restraining the defendant from using the word 'DARZI' or any other word, mark, label identical with or deceptively similar to the word / mark 'DARZI' amounting to infringement of plaintiffs' trademark and passing off its services as those of the plaintiffs' and for ancillary reliefs, pleading:

- (i) that the plaintiffs founded the business concern "THE DARZI" in the year 1981 to provide the finest quality of bespoke tailoring and made to measure to clients;
- (ii) that the plaintiffs honestly and *bona fide* conceived and adopted the trademark / label and trade name "THE DARZI" in respect of providing the services of tailoring and draping as well as relating to the trade and business of selling and marketing of all kinds of clothing and wearing apparels, textile clothes, readymade garments;
- (iii) that to acquire rights, the plaintiffs filed Trade Mark (TM) Application No.1024154 in Class 24;
- (iv) that subsequently several other applications in different classes have been filed and the same are pending registration;
- (v) that the plaintiffs have been using the trademark / trade name / label "THE DARZI" continuously since the adoption till the present time;
- (vi) that artistic work, placement of words, get up and make up of trademark / label are unique and the plaintiffs are the owners and proprietor in the artistic features in the trade name / trademark / label

“THE DARZI” and the artistic work involved in the trade name / trademark / label “THE DARZI” is registered under the Copyright Act, 1957; hence, the plaintiffs are the registered proprietor of the copyright involved in the artistic work of the trade name / trademark / label “THE DARZI”;

(vii) that the defendant claims to be engaged in the same nature of goods / services as that of the plaintiffs and has adopted an identical and / or deceptively similar trade name / trademark “DARZI ON CALL” in a manner which cannot be differentiated and distinguished from the plaintiffs trade name / trademark;

(viii) that the word ‘DARZI’ is pivotal and cardinal in the trade name / trademark of both, the plaintiffs and defendant;

(ix) that the plaintiffs, immediately on coming to know of the defendant, made enquiries and found that the defendant had also filed TM application for registration of the trade name / trademark “DARZI ON CALL”;

(x) that the plaintiffs sent a cease and desist notice dated 15th October, 2015 to the defendant and to which though no reply was given but the plaintiffs did not find use by the defendant of the mark “DARZI ON CALL”;

(xi) however in August, 2016, the plaintiffs received query from its customers whether the plaintiffs had launched “DARZI ON CALL” and wherefrom the plaintiffs learnt that the defendant had again started use of the trademark / label “DARZI ON CALL”.

2. The suit came up first before this Court on 5th October, 2016, when finding (*prima facie*) that the defendant, besides using the word ‘DARZI’

had also written the word 'D' in the same style as in the mark of the plaintiffs, while issuing summons of the suit and notice of the application for interim relief, the defendant, till further orders, was restrained from using the trademark or trade name having as component thereof the word 'DARZI' or any other trademark or trade name similar or deceptively similar thereto.

3. Vide subsequent ad-interim order dated 7th December, 2016, the defendant was permitted to use the alphabet 'D' stylised as under:



and the logo as under:



without the word 'DARZI'.

4. The defendant (Darzi on Call Private Limited / Darzi on Call Services Pvt. Ltd.) has contested the suit by filing a written statement pleading:

(a) that the defendant was originally founded in April, 2015 as a partnership firm which got incorporated into a company on 3rd August, 2015;

(b) that the plaintiffs have referred to their mark as “THE DARZI” when in fact the only registered trademark of the plaintiffs is a composite logo mark which comprises of a stylized iteration of the words “THE DARZI”, a tag line “The Suit People” and the numbers “1981”;

(c) that the alleged registration obtained by the plaintiffs under TM Application No.1024154 and their pending applications are all for the logo or the label and none of them are for the word “DARZI” or “THE DARZI”;

(d) that in other words, the plaintiffs themselves have never claimed protection for the words “THE DARZI” or “DARZI” per se given that they are conscious that these words are common to the trade and / or generic and descriptive of textile and tailoring;

(e) that the plaintiffs have concealed that they had applied to register the word mark “THE DARZI” under TM Application No.900352 on 28th January, 2000 and this application was subsequently abandoned;

(f) that under Section 2(m) of the Trade Marks Act, 1999, a “device”, “word”, as well as a combination thereof is separate /

independent subject matter and Section 17 of the Act clearly says that registration of a trademark will not confer any rights in the parts of a trademark without separate registration of such parts (under Section 15);

(g) that registration of a label or a logo mark does not confer any exclusive rights in the matter forming only a part of the whole of the trademark so registered; such label or logo mark registrations confer rights over the mark as a whole and not over the independent constituents thereof;

(h) therefore the plaintiffs cannot assert any right over the mark “DARZI” (word per se);

(i) that the logo or label mark cannot have a phonetic connotation and it cannot be pronounced, but only seen / perceived visually;

(j) that in respective marks of the parties, the word “THE DARZI” and “DARZI ON CALL” have been written in differed stylized font;

(k) that the tag line of the two marks is also different;

(l) that the letter ‘D’ in the two marks is also different;

(m) that the get up and trade dress including the colour combination of the two marks is different;

(n) that a comparison of the rival marks clearly establishes the two marks to be completely different and distinguishable;

(n) that the plaintiffs do not use the word ‘DARZI’ independently in the course of their business activities, which is obviously on account of this word being generic and / or descriptive;

- (o) that the word 'DARZI' standalone cannot function as a trademark on account of its generic, laudatory and descriptive characteristics;
- (p) that the plaintiffs cannot assert any statutory or proprietary rights over the word 'DARZI' (word per se);
- (q) that the word 'DARZI' for tailor has no known or popular synonym in Urdu or Hindi;
- (r) that several third parties have applied to register and have in fact registered marks containing the word 'DARZI' for tailoring services, thereby rendering the said word 'DARZI' as common to trade;
- (s) that there are several others who are also using 'DARZI' formative marks as part of tailoring and stitching business;
- (t) that the plaintiffs, in their response to the examination reports issued for their pending applications, have admitted that the plaintiffs' logo mark is different to the third party registrations and pending applications containing the word 'DARZI'; such admissions on the part of the plaintiffs extends to the fact that a pictorial mark containing the word 'DARZI' cannot cause any confusion and deception vis-a-vis the plaintiffs logo mark;
- (u) that the defendant's trademark is a unique and fanciful pictorial or logo mark and the plaintiffs own admission and concession distinguished the plaintiffs logo mark from the defendant's logo mark;
- (v) that the services of tailoring do not fall in Class 24 but rather in

Class 40;

(w) that the defendant's TM Application No.2985596 has been made in Class 40 for tailoring services;

(x) that the plaintiffs are thus precluded from averring that their statutory rights for tailoring services have been infringed by the defendant, when the plaintiffs do not own any registration in respect of tailoring services;

(y) that the plaintiffs have not established any use of the mark in the nature of textile products falling in Class 24;

(z) that the copyright applications filed by the plaintiffs along with the suit are for the work "be suited bespoke(n)" and not for 'DARZI';

(aa) that the plaintiffs registered mark under TM Application No.1024154 dates back to 9th July, 2001 and some of the invoices filed by the plaintiffs date back to the year 1996; the plaintiffs have wrongly represented registration since the year 1981;

(bb) that the defendant adopted the trademark "DARZI ON CALL" logo since 2015 in respect of its tailoring and stitching business;

(cc) that the defendant as a method of brand recall and personal touch, stitches the letter 'D', as depicted in its logo mark on every article of clothing tailored and stitched by the defendant;

(dd) that the defendant's trademark has been adopted keeping in mind its business of offering tailoring services on a call;

(ee) that there can be no possibility of any unwary consumer of average intelligence being misled or deceived into availing the

defendant's services instead of the plaintiffs;

(ff) that the plaintiffs are not entitled to the reliefs on the ground of laches, acquiescence and waiver.

5. No replication has been filed by the plaintiffs. The counsels were heard on the application for interim relief on 15th December, 2016 and 2nd January, 2017 and orders reserved.

6. Though extensive oral arguments were addressed by the counsels but since the counsels at the end thereof also sought permission to file written arguments and have filed written arguments, instead of giving a narrative of the arguments addressed, their submissions in writing, in addition to the pleadings, are recorded herein below.

7. Arguments of the counsel for the plaintiffs:

(A) The trade name / trademark / label of the plaintiffs is "THE DARZI" and no logo can be portrayed without the words "THE DARZI"; hence the pleading of the defendant that the trademark of the plaintiffs is a logo mark and that the word 'DARZI' is nowhere connected with the label is wholly misconceived and baseless;

(B) The word 'DARZI' is the integral and essential part of the label of the plaintiffs as well as of the defendant;

(C) Reliance is placed on *United Biotech Pvt. Ltd. Vs. Orchid Chemicals and Pharmaceuticals Ltd.* 2012 (50) PTC 433 (Del) to contend that when a label mark is registered, it cannot be said that the word mark contained therein is not registered;

(D) "THE DARZI" is not generic as it is not synonymous to

stitching and is neither generic for textile nor for garments;

(E) Reference is made to Section 9(1) of the Trade Marks Act providing that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of use made of it and to Section 32 providing that a trade mark registered in breach of Section 9(1) shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration and before commencement of any legal proceedings challenging the validity of such registration, acquired a distinctive character in relation to the goods for which it is registered and to Section 31 pronouncing the registration to be *prima facie* evidence of validity;

(F) Reliance is placed on *Jagdish Gopal Kamath Vs. Lime & Chilli Hospitality Services* 2015 (62) PTC 23 (Bom) to contend that the registration of a device mark is neither a presumption nor axiomatic in the absence of being described as a word mark and to contend that even in case of device mark what is to be considered is the essential, prominent and leading feature of that mark whether be a label, device, composite, word and where finding that there was nothing else in the so called device than the words 'Cafe Madras', the said words were held to enjoy protection;

(G) The registration of the mark of the plaintiffs does not carry any disclaimer; reliance in this regard is placed on *Pidilite Industries Ltd. Vs. S.M. Associates* 2004 (28) PTC 193 (Bom);

(H) Reliance is placed on *Central Park Estates Pvt. Ltd. Vs. CHD*

Developers Ltd. 2015 (61) PTC 221 (Del) holding that the defendant therein himself having filed an application for registration of the mark 'BELLEVUE' could not contend the same to be generic;

8. Arguments of the counsel for the defendant:

(I) Reliance is placed on *Living Media India Ltd. Vs. Alpha Dealcom Pvt. Ltd.* 2014 (58) PTC 589 (Del) holding that the plaintiff having admitted 'Punjab Today' to be different from 'India Today' cannot be permitted to contend similarity between 'India Today' and 'Nation Today';

(II) *Astrazeneca UK Ltd. Vs. Orchid Chemicals & Pharmaceuticals Ltd.* 2012 SCC OnLine Del 2092 holding that a party cannot be allowed to approbate and reprobate;

(III) *Dwijendra Narain Roy Vs. Joges Chandra De* AIR 1924 Cal 600 holding that a defendant cannot be allowed to shift his position;

(IV) *Caterpillar Inc. Vs. Mehtab Ahmed* 2002 (25) PTC 438 (Del) holding that the words which are directly descriptive of the quality or attributes of the goods are neither patented nor proprietary names; however words, though also directly descriptive of the quality or attribute of goods but without any element of laudation, can be used as mark or trademark only if acquire secondary meaning;

(V) *Indchemie Health Specialties Ltd. Vs. Intas Pharmaceuticals Ltd.* 2015 (63) PTC 391 (Bom) holding that if the plaintiffs have got protection for a narrow class of goods, it is only fair that they ought to be restricted to that narrow class and not be permitted to extend the

protection to other goods for which the protection was not meant to;

(VI) ***Rhizome Distilleries Pvt. Ltd. Vs. Union of India*** 2012 (50) PTC 1 (Mad) (DB) holding that the conflicting composition marks must be compared in their entirety and a mark should not be dissected or split into its component parts and each part then compared with corresponding parts of the conflicting mark to determine the likelihood of confusion;

(VII) ***IHHR Hospitality Pvt. Ltd. Vs. Bestech India Pvt. Ltd.*** 2012 (50) PTC 535 (Del) (DB) holding that sales of Rs.200 crores spread over ten years would *prima facie* be insufficient evidence to establish that the word 'ANANDA', in relation to an abode, has acquired such secondary meaning that an ordinary consumer, without thinking any more, would automatically conclude every abode with the appellant;

(VIII) ***People Interactive (India) Private Limited Vs. Vivek Pahwa*** 2016 (68) PTC 225 (Bom) holding that exclusivity claims based on secondary meaning acquisition must be established by cogent material and mere use and statements of sales and expenses do not, of their own, establish the acquisition of a secondary meaning;

(IX) ***SBL Ltd. Vs. Himalaya Drug Co.*** 1997 (17) PTC 540 (Del) holding that a mark is said to be common to the trade when it is in common use in the trade or when it is open to the trade to use and whether a mater is or is not common to trade is a question of fact and that nobody can claim exclusive right to use any word, abbreviation or acronym which has become *publici juris*; in that case it was held that in the trade of drugs, it is common practice to name a drug by the

name of the organ or ailment which it treats or the main ingredient of the drug and such organ, ailment or ingredient being *publici juris* or generic cannot be owned by anyone for use as a trademark;

(X) ***Marico Limited Vs. Agro Tech Foods Limited*** 2010 (44) PTC 736 (Del) (DB) holding that the expression ‘Low-Absorb’ is a common descriptive expression / adjective, at an interlocutory stage, it cannot be said that it had become distinctive of the plaintiff therein;

(XI) ***Astrazeneca UK Limited Vs. Orchid Chemicals & Pharmaceuticals Ltd.*** 2007 III AD (Delhi) 430 holding that the expression ‘MERO’ in relation to drug with the molecule ‘MEROPENEM’ had become a generic term and being *publici juris*, no exclusive right thereto as a constituent to a trademark could be claimed;

(XII) ***Pidilite Industries Limited Vs. Vilas Nemichand Jain*** 2015 (64) PTC 185 (Bom) also holding that mere evidence of extent of use is not enough to show that the use is such that the mark has become distinctive;

(XIII) ***Ultratech Cement Limited Vs. Dalmia Cement Bharat Limited*** 2016 (67) PTC 314 (Bom) denying interim injunction to restrain use of the words ‘DALMIA ULTRA’ on the ground of passing off owing to the plaintiff’s mark ‘UltraTech’ therein;

(XIV) ***Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd.*** AIR 1955 SC 558 holding that absence of a disclaimer in respect of parts contained in a trade mark registered as a whole does not confer any statutory right with respect to that part;

(XV) *Three-N-Products Private Limited Vs. Emami Limited* MANU/WB/0011/2010 Cal (DB) laying down the distinction between the tests of infringement and passing off;

(XVI) *P.P. Jewellers Pvt. Ltd. Vs. P.P. Buildwell Pvt. Ltd.* ILR (2010) II Delhi 165 denying interim injunction on the ground of passing off to restrain use of the alphabets 'PP' which were part of plaintiff's logo 'PPJ' in relation to jewellery by the defendant in relation to real estate;

(XVII) *Subhash Chand Bansal Vs. Khadim's* 2012 (52) PTC 565 (Del) granting interim injunction against use of trademark 'KHADIM SHRIMAN KHAZANA' on the ground of being in infringement of plaintiff's mark 'KHAZANA', though registered as a label / device but without any additional word or logo or monogram;

(XVIII) *Carlsberg India Pvt. Ltd. Vs. Radico Khaitan Ltd.* 2012 (49) PTC 54 (Del) (DB) denying interim injunction to the proprietor of the composite mark '8 PM', applying the test of essential feature;

(XIX) *M/s Aravind Laboratories Vs. Modicare* 2011-4-L.W.55 (Mad) denying interim injunction to the proprietor of 'EYETEX DAZLLER' against the use of the word 'DAZLLER' because there was no registration of the mark 'DAZLLER' per se;

(XX) *S.P. Chengalvaraya Naidu Vs. Jagannath* (1994) 1 SCC 1 holding that a plaintiff who obtains an order playing fraud on the Court, has to be summarily thrown out;

(XXI) *Arunima Baruah Vs. Union of India* (2007) 6 SCC 120 holding that one who suppresses material facts is not entitled to invoke

discretionary jurisdiction of the Court.

9. The counsel for the plaintiffs in his written submissions has also countered the arguments of the counsel for the defendant contending:

(a) that every case is decided on its own peculiar facts and circumstances;

(b) that the trademarks relied upon by the defendant are not being used in the course of trade and business and mere pendency of applications for registration does not prove user of the mark; else, the plaintiffs have filed suits against whosoever has been found using the mark 'DARZI' in relation to tailoring services; reference in this respect is made to *Corn Products Refining Co. Vs. Sangrila Food Products Ltd.* AIR 1960 SC 142 holding that presence of the mark in the register does not prove its user;

(c) that whether a trademark is common to trade or not can also be proved only post evidence;

(d) referred to *Himalaya Drug Company Vs. S.B.L. Limited* 2013 (53) PTC 1 (Del) (DB) holding that where the defendant's mark contains the essential feature of the plaintiff's mark combined with other matter, the correct approach for the Court is to identify an essential feature depending particularly on the Court's own judgment and burden of the evidence that is placed before the Court and that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered, not by placing the two side by side but rather by overall similarity and the impression it leaves in the mind of the general

public;

(e) that the plaintiffs have not practised any misrepresentation and have in the plaint as well as the documents represented their trademark as a trade name and trademark / label;

(f) that the plaintiffs have been using the trademark / label / trade name for 36 years prior to the institution of the suit and for 35 years before the defendant claims to have commenced using;

(g) reliance is placed on *Laxmikant V. Patel Vs. Chetanbhai Shah* (2002) 3 SCC 65 laying down that honesty and fair play are, and ought to be, the basic policies in the world of business and that when a person adopts a name in connection with his business or services which already belongs to someone else it results in confusion.

10. I have considered the pleadings and contentions of the respective counsels keeping in mind the plethora of precedents cited by them. As would be obvious from the precedents cited by the two counsels, though the determining principles remain the same, but outcome depends upon the peculiar facts of each case.

11. My experience of life in the city of Delhi, to the high-end section of the society wherein both plaintiffs and the defendant claim to be providing tailoring services, is that the words 'Tailors' and / or 'Drapers' are used to describe the nature of the business being provided by a tailor under a trade name. Mention in this regard may be made of Raymond Tailors, D. Vaish & Sons Tailors & Drapers, Vedi Tailors, Libas Tailors, Iqbal Brothers Tailors & Drapers, Bedi Tailors, University Tailors, Mohan Lal Sons, Jainsons etc., to mention a few. Though 'DARZI' is undoubtedly the Urdu word for

‘tailor’ and used in Hindi as well but at least I have not come across any person / entity providing tailoring services describing the services rendered as that of a ‘DARZI’. The defendant also has been unable to cite any person carrying on tailoring business describing his/her/its services as those of ‘DARZI’. In fact, the word ‘Tailor’ has also found acceptance in the Hindi language with those not speaking or reading or writing English language also using the same instead of the word ‘DARZI’. It however cannot be denied that it is not as if ‘DARZI’, the Hindi / Urdu equivalent of the word ‘Tailor’, is not understood or is uncommon. However, it is generally used in spoken language, as distinct from in writing, to describe the profession of a person.

12. Not only so, I had also not come across use of the word ‘DARZI’ as a trade name / trade mark and as between the plaintiffs and the defendant the plaintiffs are admittedly the prior adopter of the word ‘DARZI’ as trade name / trade mark or as part of trade name / trade mark.

13. A distinction has to be carved between use of a word as descriptive of services provided under a trade name / trade mark and use of that word as trade name / trade mark in itself. A person who for the first time starts using as a trade name / trade mark, a word which in the past has always been used as descriptive of the services, cannot, in my opinion, be denied the protection as available to other proprietors of trademark, on the ground of the word being descriptive of the trade. Protection afforded to intellectual property, to which genre trade names and trademarks belong, in the ultimate analysis, is protection of a novel idea/concept/thought. If none else has in the past thought of adopting as a trade name / trademark, a word which till then has been used as descriptive of services, then the person who has this novel

thought / idea deserves protection.

14. Not only so, what is peculiar here is that the word which can be said to be descriptive in writing of the tailoring services is the word 'Tailor' and not the Hindi / Urdu equivalent 'DARZI' thereof. It is the word 'Tailor', written in Hindi language and accompanied with the word 'MASTER', also in Hindi language which is / are found written on boards outside shops providing tailoring services in the Hindi speaking neighbourhoods.

15. That brings me to the principal contention of the counsel for the defendant, of the word 'DARZI' being inherently incapable of being a trade mark owing to being generic or *publici juris* of the tailoring services.

16. The law of trade marks, insofar as statutory, is to be found in Section 9, listing the absolute grounds for refusal of registration. Sub-section (1)(a) thereof provides that a trade mark which is devoid of any distinctive character, not capable of distinguishing the goods or services of one person from those of another, shall not be registered. In consonance with discussion hereinabove, though the word 'TAILOR', (in the context of the city of Delhi where the plaintiffs and the defendant are carrying on their tailoring business and which business is largely territorial in nature with a customer not travelling to a city other than of his ordinary residence for availing tailoring services) may fall in this category in relation to service of tailoring but not the word 'DARZI'. Sub-section (1)(b) of Section 9 makes not registrable the trade marks which consist exclusively of marks (word) which may serve in trade to designate the services rendered thereunder. Though on first reading it appears that the word 'DARZI' which describes the services of Tailoring, would fall thereunder and be unregistrable but the words "which may serve

to designate the rendering of services” therein, in my opinion, have to be again read and understood in relation to the nature of business, place where the business is carried on, the word generally used at that place to designate the service of tailoring etc. There may be multiple words listed in the Thesaurus / Dictionary to describe any goods or service. However all such words would not become unregistrable as a trade mark under Section 9(1)(b) supra. Only such of these words would be unregistrable which are commonly used in the territory of business to designate the service rendered thereunder.

17. Supreme Court, in *T.V. Venugopal Vs. Ushodaya Enterprises Ltd.* (2011) 4 SCC 85, considered the Telugu language word ‘EENADU’ meaning ‘Today’ in the context of the State of Andhra Pradesh i.e. territorially, where it was well understood.

18. It was indeed the argument of counsel for the defendant during the hearing that because the word ‘DARZI’ is understood in Delhi as a ‘TAILOR’, it cannot be used as a trade mark though in the State of Kerala it may not qualify as descriptive.

19. However the test as aforesaid is not only of whether a word / or its meaning is understood at a particular place but also of whether it is generally used at that place as descriptive of service rendered thereunder. Not only is the word ‘DARZI’ not used in Delhi as to designate the service of tailoring provided under a trade mark but is used in spoken language as descriptive of vocation / profession of a person individually and not as a service, which is designated as “TAILOR”.

20. The test to be applied, at the same place, may also vary from business

to business and word to word. What may be held in respect of drugs and medicinal products may not apply to tailoring services.

21. This Court in *Info Edge (India) Pvt. Ltd. Vs. Shailesh Gupta* 2002 (24) PTC 355 (Del.) was concerned with grant of interim injunction at the instance of prior user of “NAUKRI.COM” against the user of “NAUKARI.COM”, both in the business of a job / employment portal. The defence *inter alia* was that the word ‘NAUKRI’ was generic and incapable of achieving the trade mark significance and performing function of a trade mark as it was descriptive of the work / business offered by the plaintiff. It was held that there was ‘peculiarity’ as the plaintiff had adopted Hindi word with English script and thus distinctiveness could be attributed to the said name. It was further held that if a product is marketed in a particular area or place under a descriptive name and has gained a reputation thereunder, that name which distinguished it from competing products, it will be protected against descriptive use. Interim injunction was granted.

22. The aforesaid decision, in my view, squarely applies to the facts of the present case. The plaintiffs here also have adopted a Urdu / Hindi word with English script and which word prior to the plaintiffs, was not generally used by those providing tailoring services as descriptive or designating their service.

23. Moreover the defendant itself having applied for registration of its label, is estopped from taking the plea of the word ‘DARZI’ being generic. Reference if any required can also be made to *Automatic Electric Ltd. Vs. R.K. Dhawan* 77 (1991) DLT 292, *The Indian Hotels Co. Ltd. Vs. Jiva Institute of Vedic Science & Culture* 2008 (37) PTC 468 Del and *Brij*

Mohan Bhatia Vs. Jain Sales Corporation MANU/DE/2955/2014.

24. In this context, no merit is also found in the contention of the defendant of the mark being label marks and not word marks. The essential feature of both marks is the word 'DARZI' and there is barely anything else on the labels to serve the purpose of a trade mark i.e. of recall. A consumer of tailoring services would remember the service availed of on an earlier occasion, whether it be of the plaintiffs or of defendant as 'DARZI' only and would not remember the defendant as different from the plaintiffs owing to the words "ON CALL" in the label of the defendant. Conversely, a customer of the plaintiffs, on coming across the defendant is likely to understand the service of the defendant, as an extension of the service of plaintiffs 'ON CALL'. Also, the goodwill of a business as of tailoring is by word of mouth. A person for whom either the plaintiffs or the defendant have customised or tailored, when asked of the reference of his tailor is unlikely to mention the defendant as 'DARZI ON CALL' as distinct from plaintiffs as 'THE DARZI'; even if he were to so mention, the person seeking reference is unlikely to remember the words "ON CALL" and what is likely to stick to his memory is the word 'DARZI'. The test of similarity / deceptive similarity have to have their roots in the human interactions in a particular society / city and cannot be in abstract. What has to be applied is the test of human beings and not a test as laid down in the law books in relation to a different society.

25. Applying the aforesaid tests, the presence in the label of the defendant of the alphabet 'D' in a stylised form besides the word 'DARZI' and the shape of a dress on a mannequin or of the words 'The Suit People' or '1981'

edged on the label of the plaintiffs are unlikely to distinguish the two. What stands out in the two marks is the word 'DARZI' with people remembering the marks as unique in adopting the Hindi / Urdu meaning of the word 'Tailor' in English script. The recall value of both the trademarks is thus the word 'DARZI'. I may in this context also record that though the colour scheme etc. may be relevant in relation to trademarks qua other products but have no relevance to the trademark in the context of tailoring services. Similarly, a person searching on the internet or trade directories for 'DARZI' referred to him is also likely to confuse between the two trademarks and likely to take down the telephone number and address of the other.

26. In fact I am of the opinion that *Subhash Chand Bansal* supra fairly cited by the counsel for the defendant where, without trial, the defendant was restrained from using label 'Khadim's Khazana' in relation to the same goods for which plaintiff had label registration which was but the word 'Khazana' in a square box, applies squarely to the facts of the present case, though goes against the defendant.

27. I again highlight that it is not merely the label of the plaintiffs and the defendant but both, are also using the words in the label i.e. "THE DARZI" and "DARZI ON CALL" as their trade name. It is not as if owing to distinct trade names, similarities in labels are of no avail.

28. As far as the contention of the counsel for the defendant, of the registration of the plaintiffs being in relation to textile cloths and not in relation to tailoring services and the plaintiffs being thus not entitled to any relief on the ground of infringement is concerned, the Fourth Schedule to the Trade Marks Rules while classifying goods and services does not provide

any separate classification for tailoring. Entries 1 to 34 therein are under the heading “articles” with Class 24 being “textiles and textile goods, not included in other classes; bed and table covers” and Class 25 being “Clothing, footwear, headgear”; and, Entries 35 to 45 are under the heading ‘Services’ with Entry 40 being “Treatment of materials”. In the absence of a specific class for tailoring, in my opinion, the plaintiffs cannot be deprived of the protection on account of their registration being in Class 24. After all textiles and textile goods are not usable articles without being tailored. Though business of tailoring per se / as a standalone business is not unknown but tailors are invariably found attached to the business of sale of textiles and textile goods with the shops of high-end textile goods having a tailoring desk so that the textiles can also be purchased as per the suggestions of tailors. Seen in this context, it cannot be said that the use by the plaintiffs of the trademark is not in the class registered or the plaintiffs having registration in Class 24 are not entitled to use the registration to prevent others from using the registered trademark for similar business.

29. Though the plaintiffs claim user since 1981 but the defendant also does not dispute the plaintiffs to be prior user at least by a couple of decades. It is not the case of the defendant that the defendant, at the time of launching its business was not in the know of the plaintiffs. The defendant inspite thereof chose use of the word ‘DARZI’ as part of its trade name.

30. That brings me to the most important and guiding light in the law of intellectual property which is found to be the ultimate reason which prevailed with the Courts in granting injunction i.e. of dishonesty and an attempt on the part of the defendant to ride on the goodwill of the plaintiffs,

to steal the market created by the plaintiffs, to have a headstart from the place to which the plaintiffs have built the business, to pass off his/her/its goods or services as that of the plaintiffs, all obviously to the prejudice of the plaintiffs and amounting to cheating the patrons/consumers/customers of the plaintiffs and the public at large. No society governed by law will permit a defendant to do so. The message which this Court will be sending out if it refuses injunction in a case as this is that it, embroiled in its legalese and technicalities of law as the defendant here has raised, is encouraging such deception in society and allowing hijacking of businesses which another has toiled to build. Such a message going out from the Court will kill entrepreneurship in the country, thereby spelling the doom for development. Even laws relating to tangible properties, as distinct from intellectual property have, have been interpreted to protect titles in property, as long as acquired honestly and for consideration, even if imperfect.

31. The entire argument of the defendant of 'generic' and '*publici juris*' and of the word 'DARZI' being descriptive is nothing but an argument of technicality. The defendant itself has used the word 'DARZI', not as descriptive of its trade identified by another name but as distinctive of it amongst the class of businesses which the defendant is carrying i.e. of tailoring. Such an argument would have been understandable if Md. Ali Raza, Ms. Nazia Nabi and Sh. Avinash Kumar who set up the business of defendant had commenced business of tailoring, say in the name of 'M/s Raza, Nabi & Kumar' and described the business carried on under the said name as "Darzis on Call". It could then have been said that the plaintiff No.1 Sunil Mittal, by adopting the name of his tailoring business as 'THE DARZI' is not entitled to restrain other tailors, catering to section of society

not familiar with the word 'TAILOR', is not entitled to restrain 'M/s Raza, Nabi & Kumar' from informing their prospective customers the services of 'DARZI' provided by them. The act of the defendant of having itself chosen the word 'DARZI', not as descriptive of its business but as a trade name, as the plaintiffs had done two decades before the defendant, is nothing but an act of dishonesty with which the Court is not only required to but bound to interdict. It is also not as if the defendant is writing the word 'DARZI' in Urdu or Hindi language, to cater to the section of the society which is unfamiliar with the word 'TAILOR'. The defendant also, as the plaintiffs, has chosen to write the word 'DARZI' in English script. The defendant is targeting the same customer base as the plaintiffs. I may in this regard also notice a shift in the society in the last few decades. Earlier, owing to limited availability of readymade garments in the country, only the rich were buying the same from foreign markets with the economically weak section of the society buying cloth and getting it tailored. Now, readymade garments are tailored in factories, mechanically with limited human skills and are available in volumes at much less price than the cost, if the cloth was to be purchased and tailoring charges given. Today, customised / bespoke tailoring, which both, plaintiffs and defendant are providing, is affordable only by the rich and high-heeled, who are generally literate and understand the word 'TAILOR' and find the word 'DARZI' 'exotic' and hence with high recall value, thereby serving very well the purpose of a trademark.

32. Privy Council, as far back as in *De Cordova Vs. Vick Chemical Coy* Reports of Patent, Design and Trade Mark Cases LXVIII (6) 103, in the context of the contention that the word 'VapoRub' was generic held (i) that

though the trademark was a visual device but the ascertainment of essential feature is not by ocular test alone and since the words formed part if not whole of the mark, it is impossible to exclude consideration of sound or significance of those words specifically when the word forming part of the mark has come in trade to be used to identify the goods of the owner of the mark; (ii) that there is no absolute incompatibility between what is descriptive and what is distinctive; (iii) it would be abuse of language to place a fancy word as 'VapoRub' in the same descriptive class as "malted milk" or "shredded wheat"; (iv) description of the word as generic in books / dictionaries is not enough, what is to be seen is whether the word has passed into the speech of general public; (v) the alleged infringer in that case also was not using the words as descriptive of its goods but as a trademark; and, (vi) 'VapoRub' though not an invented word, was "just outside". I may add it is not in every case / situation that adjudication whether a word has acquired a secondary meaning, cannot be done at interim stage. This Court in *Hindustan Pencils Ltd. Vs. Puma Stationery Ltd.* 2005 (31) PTC 541 (Del) held that in some case it may be possible at interim stage. I find this case to be such.

33. It is for all the aforesaid reasons that I find the act of defendant sought to be enjoined in this suit, to be dishonest. This is what also prevailed with this Court in *Info Edge (India) Pvt. Ltd.* supra also while enjoining 'NAUKARI.COM' and with the Supreme Court in *T.V. Venugopal* supra while enjoining use of the word 'Eenadu' though both generic. Reference may also be made to *Laxmikant Patel* supra holding that fairplay and honesty ought to be the basic policy in world of business and where a person adopts a name which already belongs to someone else, it causes injury to the

latter.

34. I, at least at this stage, am also of the opinion that search reports from the online records of the Trade Marks Registry cannot be relied upon to show use by any other person of 'DARZI' as a trade name. Not only so, it is not expected of a proprietor of a trademark to, instead of carrying on business under the trademark, make litigation a business by continuously being on the prowl for every use of that trademark, howsoever insignificant and inconsequential may be, and to take legal proceedings to prevent such use. A proprietor of a trademark is not expected to take legal proceedings if remains unaffected by use of the same trademark by others. Merely because the plaintiffs have not felt the need to take action against some others, even if using the word 'DARZI' as a trade name, if according to the plaintiffs such use does not affect the business of the plaintiffs, the same cannot deprive the plaintiffs of protective action, when another invades his business. Else, the defendant along with the written statement has filed only an impression of a rubber stamp and a business card of one "Mrs. Darzi" carrying on business in Rajouri Garden, New Delhi and one "d.a.r.z.i BY NAVITA" carrying on business at Derawal Nagar, Delhi and of one 'Darzi Boutique' for Women at Indrapuram, Ghaziabad. The defendant along with its written statement has also filed Facebook search of the word 'DARZI' but wherefrom the location cannot be known. The business of tailoring is a highly territorial business and the plaintiffs carrying on business at Delhi may not feel threatened from other business, even if under the same trade name, in other cities. Moreover, a number of entries in the Facebook search print out filed, are not even in relation to the tailoring services and are in as diverse businesses as of providing business services, art, clothing, authors, musicians etc. A number

of them are also not of the word 'DARZI' as standalone and are with prefixes or suffixes or a combination of the word 'DARZI' with other words.

35. This Court in *Brij Mohan Bhatia* supra, relying on *Express Bottlers Services Pvt. Ltd. Vs. Pepsico Inc.* 1989 (9) PTC 14 and *Century Traders Vs. Roshan Lal Duggar & Co.* AIR 1978 Delhi 250 (DB) held that (i) mere presence of mark in register does not prove use; (ii) proprietor of trademark is not expected to pursue each and every insignificant infringer, and relying on *P.M. Diesels Vs. S.M. Diesels* AIR 1994 Del 264 held that in such a suit it is the right of two parties before the Court which are to be examined and not qua others.

36. As far as reliance by the counsel for defendant on *IHHR Hospitality Pvt. Ltd.* supra is concerned, I have in order dated 11th April, 2017 in CS(COMM) No.242/2017 titled *IHHR Hospitality Pvt. Ltd. Vs. Hotel Ananda* noticed that the Division Bench, vide subsequent order dated 6th August, 2012 in the same appeal recalled the judgment.

37. The plaintiffs thus have made out a *prima facie* case. The balance of convenience also is in favour of the plaintiffs and against the defendant in as much as use by the plaintiffs of the trademark according to the defendant also is for at least 20 years prior to that by the defendant. The defendant already since the last about six months has been using a different trademark and I am of the view that the prejudice from the interim injunction to the defendant will be negligible in comparison to that to the plaintiffs from non-grant thereof. Needless to state that a *prima facie* case having been found in favour of the plaintiffs, the plaintiffs will suffer irreparable injury from continued use by the defendant of the mark. A customer of a tailor, once lost, is unlikely to come back.

38. Resultantly, IA No.12449/2016 of plaintiffs under Order XXXIX Rules 1&2 CPC succeeds and IA No.15269/2016 of defendant under Order XXXIX Rule 4 CPC is dismissed.

39. The orders dated 5th October, 2016 as clarified on 7th December, 2016 are made absolute till the disposal of the suit.

APRIL 19, 2017
'bs'

RAJIV SAHAI ENDLAW, J.

