

No Such Caveat has been lodged
in this case


District Judge
New Delhi

BEFORE THE HON'BLE DISTRICT JUDGE
PATIAL HOUSE COURTS, NEW DELHI

TM No. _____ of 2016

IN THE MATTER OF:

Extramarks Education India Pvt. Ltd.
Having its registered office at:
506, Surya Kiran Building
19, K.G. Marg, Connaught Place
New Delhi-110 001

Extramarks Education Pvt. Ltd.
Having its registered office at:
506, Surya Kiran Building
19, K.G. Marg, Connaught Place
New Delhi-110 001

Versus

Bindals Papers Mills Limited
Having its registered Office at:
NP 151 B Maurya enclave
Pitampura
New Delhi -110 034

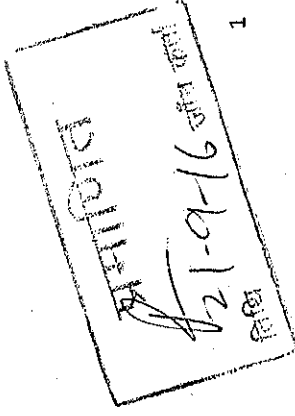
...Defendant

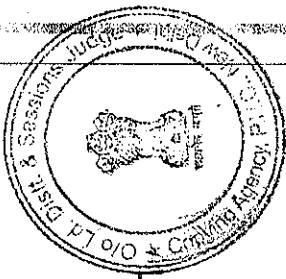
SUIT FOR PERMANENT INJUNCTION RESTRAINING INFRINGEMENT
OF TRADE MARK, FOR RENDITION OF ACCOUNTS OF PROFITS,
DELIVERY UP, ACTS OF UNFAIR COMPETITION E.I.C.

MOST RESPECTFULLY SHOWETH:

Uf 8428/16
21.3.16

1. The Plaintiff No. 1, Extramarks Education India Pvt. Ltd. is a company registered under the Companies Act, 2013 having its registered office at 506, Surya Kiran Building, 19, K.G. Marg, Connaught Place, New Delhi-110 001. Mr. Naresh Sharma is the authorised representative of the Plaintiff No.1 and is duly authorized through a Board Resolution to sign and verify the Plaint and to institute the present suit for and on behalf of the Plaintiff No.1.





IN THE COURT OF SH. SURINDER S. RATHI: LD. ADDITIONAL DISTRICT JUDGE-
03:PATIALA HOUSE COURT:NEW DELHI DISTRICT

TM No. 366/2016

Extramarks Education India Pvt. Ltd. & Anr.Plaintiff

Versus

Bindals Papers Mills LimitedDefendant

23.07.2016

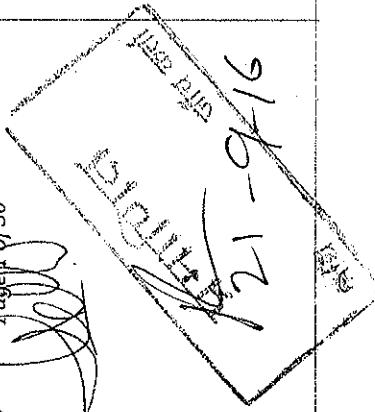
Order

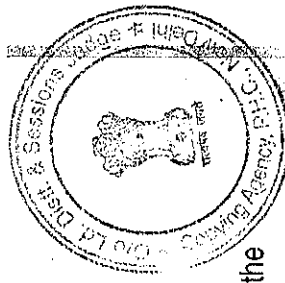
1. By this order I shall dispose of application filed by the defendant company under Order 39 Rule 4 read with Section 151 CPC dated 29.04.2016.
2. I have heard arguments of Ld. Counsel for plaintiff Shri Sachin Gupta and Ld. Counsel for defendant Shri Sachin Dutt, Ld. Senior Advocate alongwith Shri Vinit Sinha and Shri Prabhakar Tiwari and have perused the file.
3. It is case of the plaintiff that they are the owner of registered Trademark "EXTRAMARKS.COM" for education and has filed various other applications for different classes which are pending before the Registrar of Trade Marks internationally as well as in India. The registration in India is under class 41 from 20.08.2007 onwards for EXTRAMARKS.COM. The plaintiffs are in the business of providing new age digital education solution under trademark name/corporate name "EXTRAMARKS.COM".

TM 366/16

COURT OF SH. SURINDER S. RATHI: LD. ADJ-3, NDD

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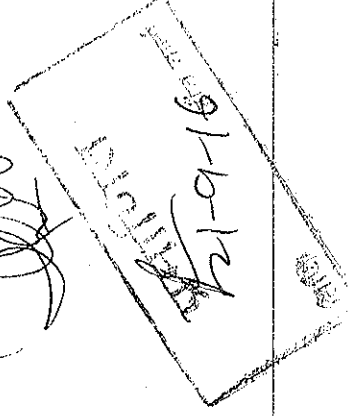


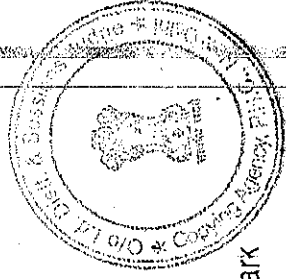
4. The plaintiffs has business of providing educational services under the mark namely "EXTRAMARKS.COM". The plaintiffs have been using the said trade marks honestly, bonafidely, extensively, exclusively, continuously, commercially and in course of trade since 2007 for educational services under its said trademark/trade name and sells them directly to the public.

5. The plaintiffs' services under the said trademarks are freely and commercially available in India as well as overseas. Plaintiffs have 20 offices in India apart from offices at Singapore, South Africa and UAR and is employing 1500 employees directly. Its products are being used in around 7000 schools and around 80 lacs students world over. The details of the plaintiffs' registration in India and abroad have also been provided in the plaint. The plaintiffs has been regularly and continuously promoting its distinctive trademark through extensive advertisements, publicities promotions and marketing research and has been spending enormous amounts of money, efforts, skills and time thereon.

6. It is alleged that the defendant is a company is engaged in the business of manufacturing, marketing notebooks, paper and articles made of paper under trade name **BINDALS**. It is alleged that the defendant has now adopted the trademark **BINDALS' EXTRAMARKS** for notebooks and has been selling these notebooks under the impugned mark intermittently.

7. The defendant has as such allegedly infringed plaintiffs' trade marks. It is also pleaded that the defendant is also passing off their impugned goods and business as that of the plaintiffs. He is using all kinds of false description on its impugned goods to wrongly link the impugned goods with those of the plaintiffs





and mislead common people and customers.

8. Further more upon electronic search of the official website of trademark registry www.ipindia.nic.in plaintiff came to know that on 25.11.2013 defendant applied for registration of impugned trademark **BINDALS' EXTRAMARKS**. This application has been objected to by Registrar of Trademark and is as such not published in the Trademark Journal as of yet.

9. It is alleged that the defendant has adopted and started using the impugned trade mark dishonestly, fraudulently and out of positive greed with a view to take advantage and to trade upon the established good will, reputation and proprietary rights of the plaintiffs in the plaintiff's said trade mark/label/trade name. Because of such activities of the defendant, the plaintiff is suffering huge losses both in business and in reputation which cannot be compensated in terms of money. Print out of web page of www.snapdeal.com showing the picture of defendant's impugned products with trade name **BINDALS' EXTRAMARKS** is filed alongwith plaint at page 262 of the paper book.

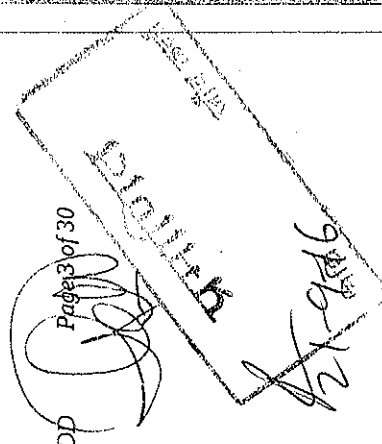
10. Such has been conduct of the defendant that even though plaintiff served it with a legal notice requesting him for desisting from using plaintiffs' registered trade name/marks **EXTRAMARKS**, in a detailed reply dated 09.07.2015 they accepted that they are using **BINDALS' EXTRAMARKS** on their products and that they would continue to do so.

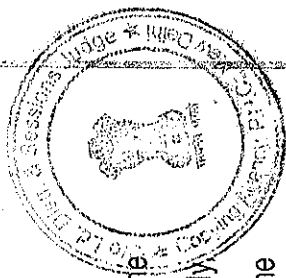
11. In the light of the submissions made by the plaintiff this Court vide order dated 31.03.2016, observed that the plaintiff's Trademark has acquired the status of a well known Trademark and as such plaintiff has a prima facie case and the

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COURT OF SH. SURINDER S. RATHI: L.D. ADJ-3, NDD

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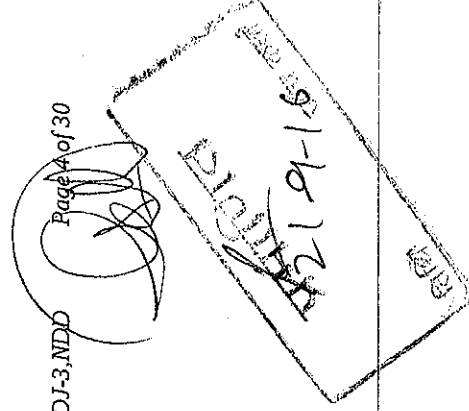


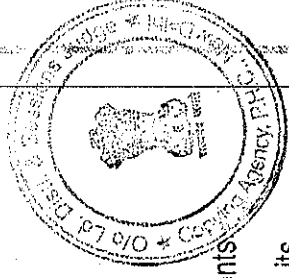
balance of convenience also lied in the plaintiff's favour and also in case the defendant is not injuncted plaintiff would suffer irreparable loss. Consequently ex-parte ad-interim injunction was granted to the plaintiff restraining the defendant from using Tradename Extramarks. Also simultaneously request of plaintiff under Order 29 Rule 6 CPC was allowed and a Local Commission was issued for execution at Lucknow, UP.

12. Upon service of summons of the suit and compliance of Order 39 Rule 3 CPC, defendant company filed a detailed Written Statement. Even though there was a delay in filing the written statement but the same was condoned. Admission/denial was carried out and issues were identified on 08.07.2016 itself. Matter was referred to Ld. Local Commissioner for recording of evidence and upon conclusion thereof, 17.10.2016 was fixed as date for final arguments.

13. A separate application was filed by the defendant company under Order 39 Rule 4 Read with Section 151 CPC for vacation of ad-interim injunction order dated 31.03.2016. Reply to this application was filed on behalf of the plaintiff.

14. In the application under disposal as well as pleadings, it is case of the defendant that plaintiff did not approach this Court with clean hands. It is argued that the suit has been filed by the plaintiff under a premise that plaintiff's registered Trademark has acquired the status of a "Well Known Mark" as per **Section 2 (zg) of Trade Mark Act, 1999**. It is pleaded that the suit in hand is barred under **Section 27 of Trade Marks Act**. In para 19 b of the plaint, plaintiff has specifically mentioned that it is not pressing the suit for the relief of passing-off for the purpose of jurisdiction and as such the suit of the plaintiff, by its own





choice was reduced to be a suit under **Section 29 of TM Act.**

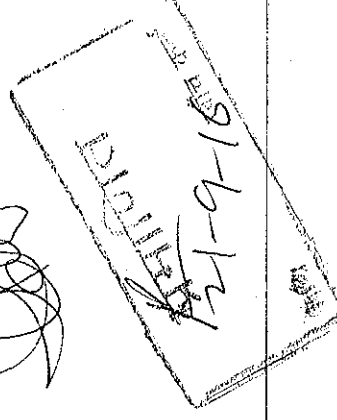
15. It is further case of the defendant that as per the pleadings and documents filed with the plaint the Trade mark which the plaintiff has got registered in its favour is Extramarks.com under Class 41 of the Fourth Schedule of Trade Marks Rules, 2002. This Schedule contain a classification of Goods and Services alongwith their name. The Trade marks registered under **Class 41, Fourth Schedule, Trade Marks Rules, 2002**.

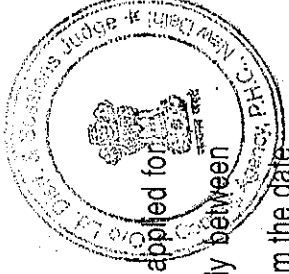
"Education; Providing of Training; Entertainment; Sporting and Cultural Activities".

16. Whereas admittedly, the business activities carried out by the defendant company are not covered under Class 41 and are rather covered under **Class 16, Fourth Schedule, Trade Marks Rules, 2002**.

"Paper, Cardboard and goods made from this materials, not included in the other classes; printed Material; Book Binding Material; Photographs; Stationary; Adhesive of Stationary or Household purposes; Artists, Materials; Paint Brushes; Typewriters and office Requisites (except furniture); Instructional and Teaching Material (except Apparatus); Plastic Materials for Packaging (not included in other classes); Playing Cards; Printers Type; Printing Blocks".

17. Even though Plaintiff's Trade Marks EXTRAMARKS.COM might be registered since 2007 under Class 41, but their application for registration under Class 16 are under objection. Defendant filed application under Class 16 for their

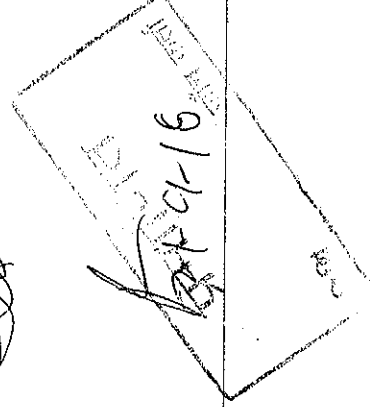


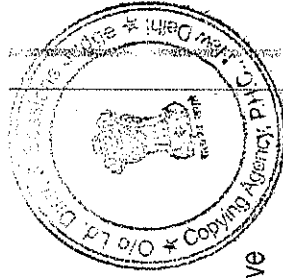


Trade Mark BINDALS EXTRAMARKS on 25.11.2013 whereas plaintiff applied for registration of Trade Mark EXTRAMARKS.COM under Class 16 only between 23.01.2014 and 19.08.2014 i.e. after a minimum two to nine months from the date of defendant's application.

18. As per defendant, the company Bindals Newsprints Ltd. is in existence since 2006 and all the activities are covered only in Class 16. Their Trademark BINDALS EXTRAMARKS which is pending registration is an innovative combination of three words i.e BINDALS, EXTRA and lastly the word MARKS. Defendant has been using the Trade Marks BINDALS EXTRAMARKS since 19.04.2013 for the purpose of manufacturing and distribution of notebooks, exercise books, registers, practical workbooks, drawing notebooks and paper articles across the nation.

19. Defendant's Trade name BINDALS EXTRAMARKS is neither identical nor deceptively similar to the plaintiff's Trade Marks and also both of them are functioning in a mutually exclusive field of trade/industry related to Education. Defendant company is prior user of Trade Mark as far as Class 16 is concerned as compared to the plaintiff under his class and also they applied for registration under the Class before the plaintiff. As per them, plaintiff has never carried out any business under Class 16. It is further case of the defendant that the defendant company was unaware of the existence of the plaintiff in the Electronic Education Services when it adopted the Trade Mark BINDALS EXTRAMARKS in the year 2013. EXTRAMARKS is pleaded to be an essential element of Indian Education System which cannot to be an exclusive or innovative Trade Mark of



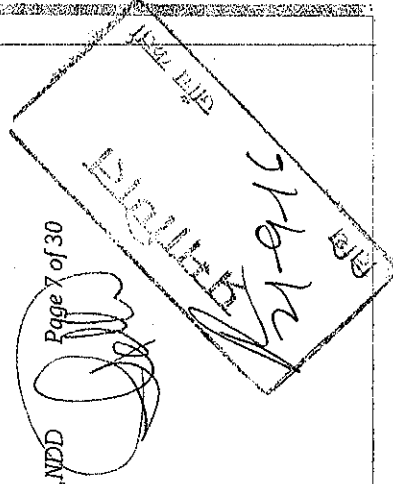


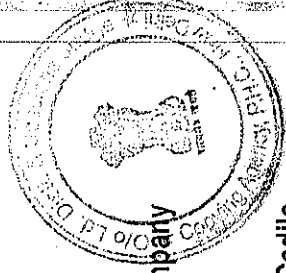
plaintiff. Also when the word BINDALS is added to it, it becomes an innovative combination of three words which are not available in the dictionary.

20. As per defendant, once the plaintiff company does not own registered Trade Mark for Class 16, it cannot legally initiate proceedings for infringement of Trade Mark as it did by way of filing of suit in hand. There is no over lapping or commonality of interest as plaintiff works as a Service Provider under Class 41 in a virtual and intangible settings of Computer, Laptops and Tablets whereas defendant is in the business of Paper and Notebook under Class 16 which are tangible in nature. As such there is no similarity of any nature of business qua which both the plaintiff and the defendant can be said to be competitors to each other. It is also argued that the products manufactured by the defendant under Trade Mark BINDALS EXTRAMARKS are available only in stationary shops throughout the country whereas plaintiff's services are only available through their portal www.extramarks.com on the Internet.

21. It is said that the Class of purchasers who would buy the goods/services of the plaintiff and the products of the defendant are entirely different. The plaintiff does not hold with it Trade Mark EXTRAMARKS as the registration is only for the Trade Mark EXTRAMARKS.COM and as such plaintiff cannot alleged any infringement as pleaded in the suit. More so, when defendant is not carrying out any activity under Class 41.

22. It is further argued that since respondent is a bonafide and honest user of **BINDALS EXTRAMARKS** under Class 16, the ad-interim injunction order may be vacated. In support of his pleadings and submissions, defendant has relied on





case titled **Vishnu Das Trading Vs. Vazir Sultan Tobacco Trading Company Ltd., (1997) 4 Supreme Court Cases 2001.**

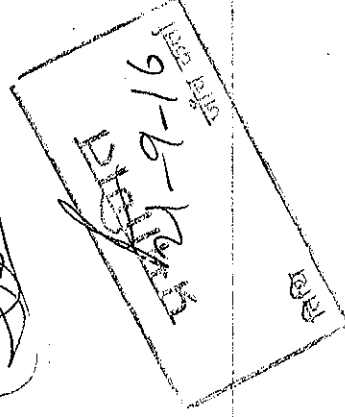
23. Defendant also relied upon **Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73** wherein Hon'ble Supreme Court enlisted the factors which shall be looked into to decide a question on whether the two Marks adopted by the parties are deceptively similar or not observed-

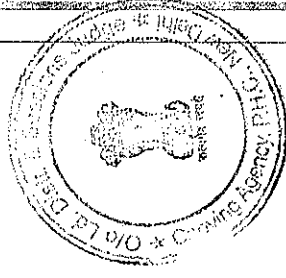
"35. Broadly stated, in an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered:

- i. The nature of the marks i.e. whether the marks are word marks or label marks or composite marks, i.e. both words and label works.*
- ii. The degree of resemblance between the marks, phonetically similar and hence similar in idea.*
- iii. The nature of the goods in respect of which they are used as trademarks.*
- iv. The similarity in the nature, character and performance of the goods of the rival traders.*
- v. The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.*
- vi. The mode of purchasing the goods or placing orders for the goods.*
- vii. Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks."*

24. Defendant has also relied upon **Rameshwari Devi Vs. Nirmala Devi, (2011) 8 SC 249**, Hon'ble Supreme Court observed-

"E. the Courts should be extremely careful and cautious





in granting ex-parte ad interim injunction or stay orders. Ordinarily short notice should be issued to the Answering Respondent or respondents and only after hearing concerned parties appropriate orders should be passed.

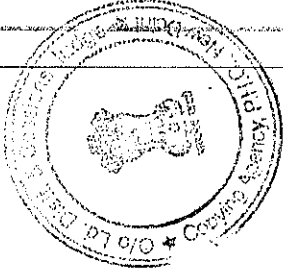
F. Litigants who obtained ex-parte ad interim injunction on the strength of false pleadings and forged documents should be adequately punished. No one should be allowed to abuse the process of the court."

25. During the course of arguments another submission put forth by learned counsel for defendant is that the plaintiff has concealed facts from the Court in so far as the legal notice dated 17.07.2014 has been referred to the plaint as notice dated 17.07.2015 and also that defendant reply 30.07.2014 has been concealed from the plaint. It is further argued that legal notice of 17.07.2014 was primarily for passing-off and not for infringement of Trade Mark as the suit was finally framed. In this regard plaintiff relied on case titled **J Samuel. Vs. Gattu Mahesh, (2012) 1 SCR 295.**

26. Ld. Counsel for defendant has also relied on case titled **International Foodstuffs Co. LLC Vs. Parle Products Pvt. Ltd., MIPR 2016 (2) 0034.** In this case Single Judge of Hon'ble Bombay High Court dealt with a case of infringement as well as of passing-off between two rival marks **LONDON DAIRY** and **LONDONDERRY** on account of close resemblance. While relying on Vishnu Dass case supra Hon'ble Single Judge ruled -

14 Every registrant, he submits, should be required to be careful to specify the goods within the class, even multiple goods, for which the use is proposed. At any rate, by virtue of this admitted and demonstrated non-user, the

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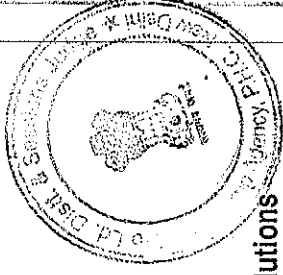


plaintiffs must be deemed to have limited their use only to ice-cream within Class 30. I think Mr. Tuzapurkar is correct. Certainly this is how I would understand an entry in that class. A registration must be read in a reasonable and rationale fashion. I do not think that the purpose of this statute is to afford such wide ranging protection irrespective of use.....class in the Fourth Schedule to the Act may include a very large number of goods or articles, each separately identifiable and vendible, but not necessarily all being goods of the same description as commonly understood in trade or common parlance. Within that particular class to which tobacco products related, there were a number of distinctly identifiable goods, marketed separately, and used differently. The contention that registration for a class carried with it protection across the entire spectrum of the goods in that class was not accepted by the Supreme Court. We are in very much the same p position here".

27. Another judgment relied upon by defendant is titled as **Balkrishan Hatcheries Vs. Nandos International Ltd. & Anr., 2007 SCC online Bom 449**, wherein Hon'ble Supreme Court observed-

"13. Section 28(1) confer upon the registered proprietor a statutory monopoly to use the trade mark in relation to the goods or services in respect of which the trade mark is registered. This would mean that a trade mark registered for goods or for any particular goods will confer upon the proprietor a monopoly only in respect of that class or if the registration is narrow only in respect of the goods for which the registration is given within a particular class. Similarly, the monopoly over the mark qua services would be restricted to only those services mentioned in the registration certificate. In the present case, as the plaintiffs registration certificate discloses that the first trade mark is only in respect of "processed and frozen meat products" falling in Class 29 of Schedule IV to the 2002 Rules. The mark confers upon the plaintiff the exclusive right to use the trade mark in respect of processed or frozen meat product and qua no other goods."

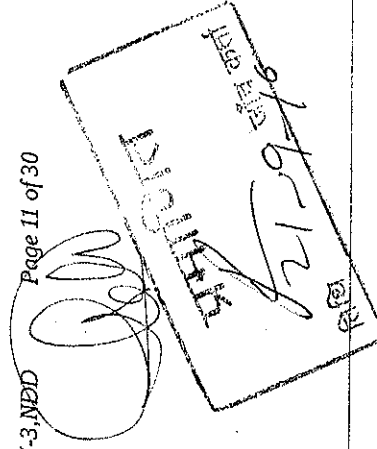
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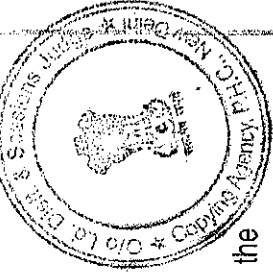


28. Last judgement relied is **Asian Paints Limited Vs. Home Solutions Retail (India), 2007 (35) PTC 697 Bom** wherein plaintiff's Trade Mark HOMESOLUTIONS and ASIAN PAINTS HOMESOLUTIONS was allegedly infringed by the defendant by incorporating a company under the name and style of HOMESOLUTIONS Retail India Ltd., Hon'ble High Court observed-

"8. In this context the plaintiff would contend that the defendant has malafide coined its corporate name as "HOME SOLUTIONS RETIAL (INDIA) LIMITED" which is identical and similar to the mark used by the plaintiff. In the first place, it is common ground that the defendant is using the mark "HOME TOWN" in respect of the services provided to its customers and not the mark "HOME SOLUTIONS". Moreover, the mark used by the plaintiff is associated with its name "ASIAN PAINTS" which precedes the expression "HOME SOLUTIONS". Besides, the registered device of the plaintiff is an artistic work which depicts a house in the alphabet "O" in expression "HOME".....The expression "HOME SOLUTIONS" is inherently incapable of becoming distinctive of any single person with respect of any single product or service. It is generic and publici juris. It describes the nature of services offered. Thus understood, at this stage of the proceedings, it is not possible to accept the plaintiff's claim that it has unique enviable reputation and exclusive goodwill to the mark "HOME SOLUTIONS."

9. It a person employing a word or term of well-known signification and inordinary use...is yet able to acquire the right to appropriate a word of terms ordinary use in the English language to describe his goods, and to shut others out from the use of this descriptive term, he would really acquire a right much more valuable than either a patent or a trade mark for he and his successors in business would gain the exclusive right, not for a limited time as in the case of patent, but for all time coming, to use the word as applicable to goods which others may be desirous of



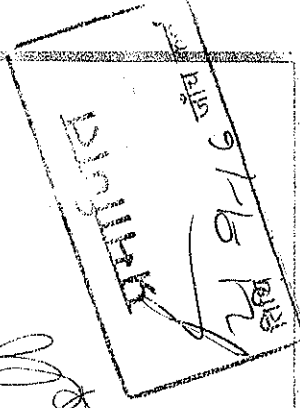


manufacturing and are entitled to manufacture and sell as much as he is. That being so, it appears to me that the utmost difficulty should be put in the way of any one who seeks to adopt and use exclusively as his own a merely descriptive term."

29. On the contrary, it is argued on behalf of plaintiff company that the injunction order passed by this Court on 31.03.16 deserves to be confirmed in so far as the defendant company, which is simply paper and stationary trader, has deliberately tried to encashed the popularity of plaintiff's Trademark and is mischievously using the tradename Extramarks so as to earn money by way on intentional deception by misappropriating the goodwill and reputation of the plaintiff.

30. It is denied that plaintiff has concealed material facts or has pleaded false facts as alleged by the defendant. It is pointed out that no notice exchanged between the parties was concealed and that all the copies thereof have been filed along with the plaint. It is submitted that notice dated 17.07.14 was inadvertently typed as 17.07.15.

31. On the merits of the case it is pleaded as well as argued that the adoption of tradename EXTRAMARKS by the defendant is not at all honest as sought to be made out. Even though plaintiff is using the tradename I.e EXTRAMARKS since 2007, defendant adopted the trademark **BINDAL'S EXTRAMARKS** only in the year 2013. Also the manner in which the above trademark is being projected is such that the word BINDAL'S is written in a very small font while the word EXTRAMARKS is highlighted in a bold and large font. This only indicates that



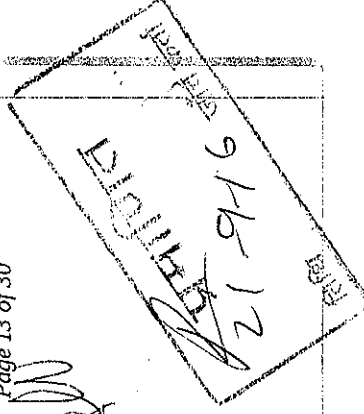
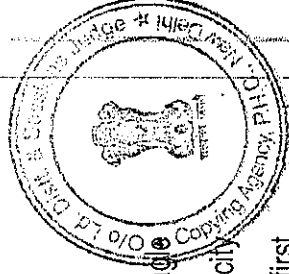
defendant is interested in deceptively encasing the plaintiff's popularity.

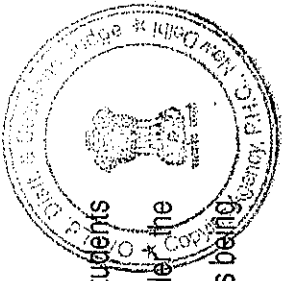
32. It is further argued that plaintiff company has had revenues for a single year of 2013-14 at Rs. 185 Crores and it had spent Rs. 1.16 Crores on the publicity of trademark EXTRAMARKS alone. It is in this year that defendant for the first time decided to use a tradename EXTRAMARKS for selling its stationary goods i.e note book which is nothing but an act of misappropriation and dilution of distinctiveness of plaintiff's trademark.

33. It is also argued that the distinctiveness of trademark EXTRAMARKS cannot be question of challenge by the defendant for the simple reason that defendant company had itself applied for registration of this trademark while trying to claim exclusive right over the same. As such it is pleaded that defendant is not sure of as to whether it should treat the tradename EXTRAMARKS as an distinctive mark or not. When the defendant refers to trademark EXTRAMARKS being used by the plaintiff since 2007 it calls this trademark to be a dictionary word under public domain which is laudatory in nature. Simultaneously when he refers to its usage by the defendant for the purpose of getting its registered in its own name as a private trademark, it is being referred to as an distinctive and innovative mark.

34. Plaintiff has also denied the assertion of the defendant that plaintiff company is not engaged in the business of Class 16 goods or that it is confined only to educational services under Class 41.

35. It is further argued on behalf of plaintiff that there is no strength in the plea of defendant company that the adoption of tradename EXTRAMARKS by the defendant would not cause any confusion in the minds of consumers and general





public. The reason thereof is simple that the same consumer group i.e Students and their parents who access the educational service of plaintiff under the trademark of EXTRAMARKS.COM would primarily be buying the notebooks being sold by defendant as BINDAL'S EXTRAMARKS.

36. It is submitted that the defendant's reliance on **Vishnudas Case** supra of Supreme Court of 1996 is misplaced because it pertain to cancellation of trademark proceedings and not for infringement of trademark and also because the concept of "Well Known Trademark" was introduced for the first time in 1999 in Trademarks Act. This concept was not available in 1958 Trademarks law.

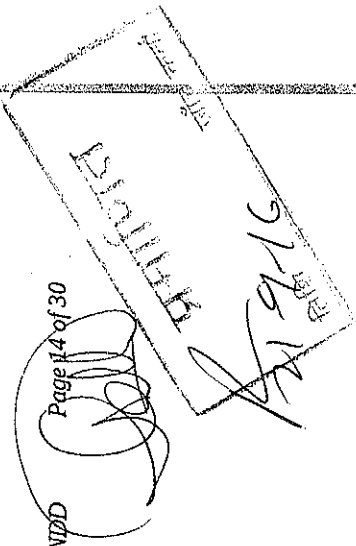
37. Likewise, reference to **Cadila Case** supra, it submitted that the petition is for infringement of registered trademark U/Sec 29 of TM Act, 1999 and not under passing-off u/Sec 27 of the Act.

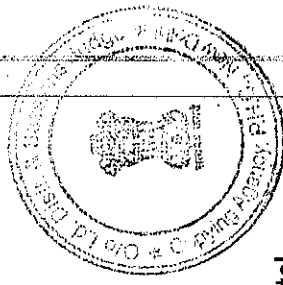
38. Plaintiff has relied on case titled **Mahindra and Mahindra Paper Mills Ltd. VS Mahindra & Mahindra Ltd., AIR 2002 SC 117**, where the Hon'ble Supreme Court held as under:

"16... whether there is a likelihood of deception or confusion arising is a matter for decision by the Court, and no witness is entitled to say whether the mark is likely to deceive or to cause confusion; that all factors which are likely to create or allay deception or confusion must be considered in combination..."

39. Plaintiff has relied on case titled **Durga Dutt Sharma vs Navaratna Pharmaceutical, AIR 1965 SC 980**, wherein the Apex Court held as under :

"29. When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark





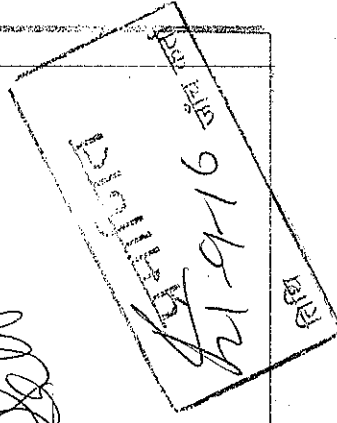
is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out."

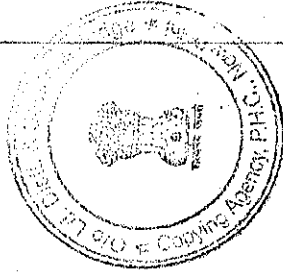
40. Plaintiff has also relied on **Industria De Diseno Textiule SA Vs. Oriental Cuisines Pvt. Ltd. and Ors., MANU/DE/1602/2015** decided on 19.05.2013, Hon'ble High Court of Delhi While giving with the matter wherein defendant company adopted trademark ZARA TAPAS BAR as compared to the plaintiff's registered trademarks of ZARA, an international fashion label and mark. Hon'ble Delhi High Court observed,

"the case of the plaintiff is defendants are using the mark ZARA per se as also ZARA TAPAS BAR. This way the mark ZARA is being used by the defendants, there is huge prominence of the word ZARA and it is sought to be conveyed as if defendants own the trademark ZARA and have relation with the plaintiff..... plaintiff had been using the trademark ZARA since 1975 and he entered India in the year 2010 while defendant adopted the trademark ZARA TAPAS BAR in 2005..... it is therefore evident that wherever defendant use TAPAS BAR along with ZARA or TAPAS BAR and RESTRAURANT or TAPAS, the BAR and RESTRAUNT, the word ZARA is almost 10 times bigger than other words used in the advertisements/ screen shots..... Plaintiff has placed on record host of documents to show that ZARA was a well known mark and has trans-border reputation".

It has also observed:

'64. In the instant case, although there was no ZARA store in India opened prior to 2010 but the mark ZARA (word) was registered in





Class 25 since 1993. The plaintiff has placed on record a number of documents to show that it was getting the fabrication done from various exporters in India. Some of the documents, particularly at pages 219, 259, 260, 262, 263 and 266 of the plaintiff documents reveal that the clothes with mark ZARA were being got fabricated in India by Inditex.

65. We are living in the 21st century. At least since the beginning of this century, there is widespread dissemination of information through the internet and television. ZARA was catering to the middle class and higher middle class. Consumers in India cannot be unaware of the Plaintiff's company and its product.

66. To sum up, the Defendants' adoption of the mark ZARA TAPAS BAR and ZARA, the Restaurant and Bar has been found to be adopted dishonestly and fraudulently. The explanation as to the manner of adoption of the name and that it has a dictionary meaning is found to be not convincing. The mark ZARA (word) is being used prominently with very small words "TAPAS BAR" which indicates the Defendants' intention to ride on the Plaintiff's reputation as ZARA was a well known mark even in the year 2003 having its presence in over 44 countries and annual turnover of 3 million Euros. Thus, the Plaintiff, in my considered opinion, has a good prima facie case entitling it to protection of the mark even in relation to dissimilar goods and services. The balance of convenience also lies in favour of the Plaintiff in view of the fact that the mark was not only well known worldwide but was also registered in India in Class 25 in the year 1993.

67. All the more, the Plaintiff filed an Affidavit in opposition to the Defendants' application for registration immediately on publication of the application. I am satisfied that the Plaintiff shall suffer irreparable loss and injury in case its mark is not protected and the Defendants are permitted to carry on their business with the name ZARA TAPAS BAR or ZARA, the Tapas Bar and Restaurant even in relation to the hotel and hospitality business. Accordingly, I grant ad interim injunction in terms of prayer clauses (a) to (d) of the application for injunction, which have been earlier extracted in para 9 of this order.

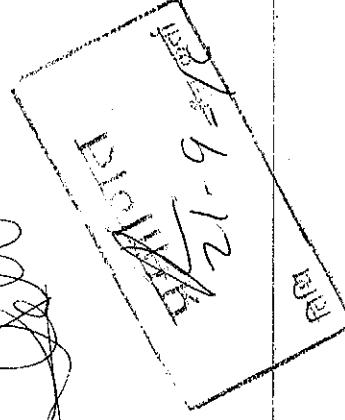
41. Another judgment plaintiff has relied is **Larsen & Toubro Limited**

Vs Lachmi Narain Trades and Ors., MANU/DE/0187/2008, 2008

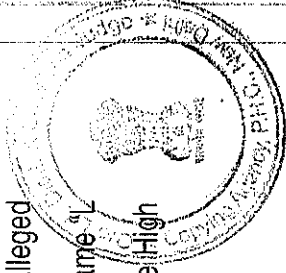
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(36)PTC223(Del). While dealing with the case where plaintiffs alleged dishonest usage of its trademarks "L and T" by defendants usage of tradename "L N T" even though plaintiff's application for registration was pending, Hon'ble High Court of Delhi observed-



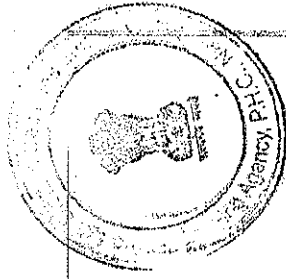
"Without intending to be exhaustive some of the principles which are accepted as well settled may be stated thus; that whether there is a likelihood of deception or confusion arising is a matter for decision by the court, an no witness is entitled to say whether the mark is likely to deceive or to cause confusion; that all facts which are likely to create or ally deception or confusion must be considered in combination; that broadly speaking, factors creating confusion would be, for example, the nature of the market itself, the class of customers, the extent of the reputation, the trade channels, the existence of any connection in course of trade, and others.

We have, in the light of the above pronouncements, no difficulty in holding that the dissimilarity in some of the products in which the parties trade does not make any material difference insofar as the grant or refusal of injunction against the defendants in the facts and circumstances of this case are concerned."

42. Another case plaintiff has relied **Hyundai Corporation VS. Rajmal Ganna, MANU/DE/8614/2007**, wherein plaintiff's company sought injunction against the defendant for restraining him from using plaintiff's trademark HYUNDAI. It was being used by plaintiffs 1976 and was also registered in India for certain specific classes i.e Class 7, 9, 11 and 12. It came to know of usage of its trademark HYUNDAI by defendant in 2005 for selling televisions, antennas, cables etc. The defence taken by the defendants is that he is applied for registration of trademarks HYUNDAI under Class 11 in the year 1999. It was ruled

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that in passing-off cases it was not necessary whether plaintiff and defendant are trading in the same field or in different products.

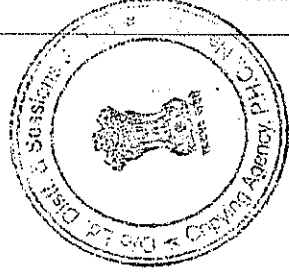
43. After discussing several judgments, the defendant was restrained from selling the merchandise using the trademarks HYUNDAI.

44. Plaintiff also relied on **Automatic Electric Limited Vs. R K Dgawan & Anr, 77 (1999) DLT 292** wherein plaintiff adopted the trademarks DIMMERSTAT in the year 1945 in Class 9 for auto transformers. Defendant adopted the mark DIMMER DOT. Injunction was sought on a plea that the two names are identical or deceptively similar as they have identical prefixes DIMMER and this would leave and overall impression to the consumers mind that they are products of the same company. The defence was taken that the word DIMMER is generic word and it cannot serve or function as a trademark. Hon'ble Delhi High Court ruled -

"16. The defendants got their trade mark "DIMMER DOT" registered in Australia. The fact that the defendant itself has sought to claim trade proprietary right and monopoly in "DIMMER DOT", it does not lie in their mouth to say that the word "DIMMER" is a generic expression. User of the word "DIMMER" by others cannot be a defense available to the defendants, if it could be shown that the same is being used in violation of the statutory right of the plaintiff.

19. It is undoubtedly true that the first syllable of a work mark is generally the most important and thus, when the defendants are using a similar prefix with that of the plaintiff with a little variation in the suffix part of it, in my considered opinion, the trade marks are deceptively similar and cause of action for prima facie infringement is complete. The submission of the learned counsel for the defendants that the word "DIMMER" is a generic and descriptive word also cannot be accepted for the trade mark is "DIMMERSTAT" and not "DIMMER" and the Court

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in a case of infringement of trade mark has to look into the whole of the trade mark as registered including the word "DIMMER". Since the plaintiff has been using the said trade mark for a long period of time, user of deceptively similar trade mark by the defendants would necessarily cause irreparable loss and injury to the plaintiff. In my considered opinion, balance of convenience is also in favor of the plaintiff and against the defendants."

45. Plaintiff has also placed reliance on **United Biotech Pvt. Ltd. Vs. Orchid Chemicals & Pharmaceuticals Ltd. & Ors. , LPA No.679 of 2011 decided on 18.05.2012.**

46. In this matter DB of Hon'ble Delhi High Court decided a rectification petition whereby cancellation of trademark FORZID was sought by respondent who had a pre registered trademark ORZID in the same Class. This plea was accepted by Intellectual Property Appellate Board. Its decision was upheld by Ld. Single Judge. While discussing the use for checking the similarity between two competing marks was ruled:-

34. Following Rules of Comparison can be culled out from various pronouncements of the Courts from time to time.

I. Meticulous Comparison not the correct way.

II. Mark must be compared as a whole.

III. First Impression.

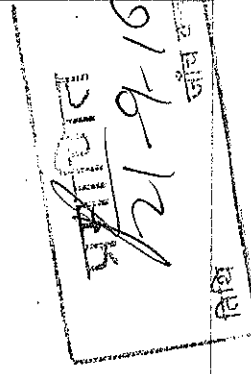
IV. Prima Facie view not conclusive.

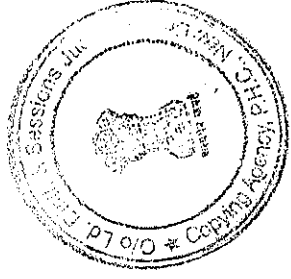
V. Structural Resemblance.

VI. Similarity in Idea to be considered.

33. In this process, first, plaintiff is required to prove the following:

(i) The business consists of, or includes selling a class of goods to which the particular trade name applies;





(ii) That the class of goods is clearly defined & is distinguished in the public mind from other goods;

(iii) Because of the reputation of the goods, there is goodwill in the name;

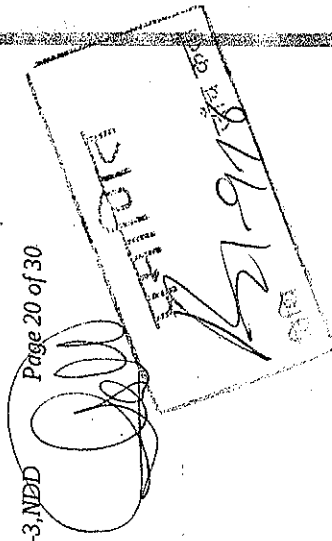
iv) The Plaintiff is a member of the class selling the goods is the owner of goodwill which is of substantial value;

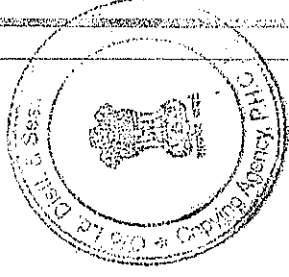
(v) He has suffered or is likely to suffer damage.

34. While comparing the few marks in order to see as to whether there is likelihood of confusion or not, following words of wisdom of the Supreme Court in Laxmikant V. Patel Vs. Chetanbhai Shah and Another, (2002) 3 SCC 65 also need to be kept in mind:

"10. A person may sell his goods or deliver his services such as in case of a profession under a trading name or style. With the lapse of time such business or services associated with a person acquire a reputation or goodwill which becomes a property which is protected by courts. A competitor initiating sale of goods or services in the same name or by imitating that name results in injury to the business of one who has the property in that name. The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury."

35. We would like to quote from the following passage from the book "The Modern Law of Trade Marks" authored by Christopher Morcom, Butterworths 1999,





which finds approval by the Supreme Court in Ramdev Food Products Ltd. (supra):

"The concept of distinguishing goods or services of the proprietor from those of others was to be found in the requirements for a mark to be registrable. Essentially, whatever the wording used, a trade mark or a service mark was an indication which enabled the goods or services from a particular source to be identified and thus distinguished from goods or services from other sources. In adopting a definition of 'trade mark' which simply describes the function in terms of capability of 'distinguishing the goods or services of one undertaking from those of other undertakings' the new law is really saying precisely the same thing."

47. While upholding the order of Single Judge, Hon'ble DB observed that Anti Dissection Rule is not applied generally and can only be invoked in an exceptional cases. It observed that for average buyer the points of similarity are more important than minor points of difference. The Bench also observed-

"The Court should not engaged in 'Technical Gymnastics' in an attempt to find some minor differences between conflicting marks. However, were there are both similarities and differences in the marks, they must be weighed against one and another to see which predominates."

48. In so far as the suit in hand is not filed on the basis of passing-off rights protected u/Sec 27 of TM Act but has been filed only u/Sec 29 of TM Act qua infringement of Trademark, it would be handy to have a glance at the section-

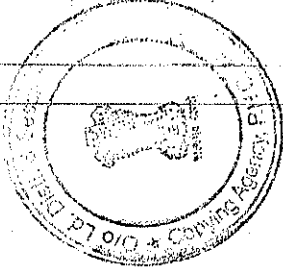
Section 29. Infringement of registered trade marks- (1)

A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in

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relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of--

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark;

or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which--

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5)

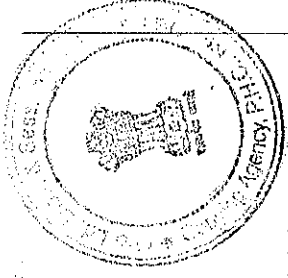
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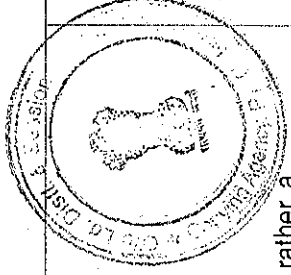
49. Now let in evaluate the facts in this case in the light of above statutory provision and guiding judgments on the issue involved. It is found that there is no denial that plaintiff is registered owner of the trademark EXTRAMARKS.COM and is prior user of the tradename EXTRAMARKS, in so far as it has been using since 2007. The registration of the trademark is also admitted for Class 41, as detailed supra. Defendant admittedly adopted tradename EXTRAMARKS by adding a prefix BINDAL'S to it for the first time only in the year 2013 for the purpose of selling notebooks which for under Class 16.

50. During the course of argument, it is fairly conceded by Id counsel for plaintiff that he is not pressing his suit u/Sec 29 (1) of TM Act, in so far as it is not his case that the defendant is using the trademark in respect of goods and services covered under Class 41.

51. Rather, interestingly plaintiff has taken arguments on his plea of covering this case either u/Sec 29 (2)(a) or u/Sec 29 (4) of TM Act, alternatively.

52. In order to cover of this case u/Sec 29 (2) (a) of TM Act, plaintiff has to establish on record, firstly, that the mark used by defendant is identical or similar or its identity is such that is likely to cause confusion in the minds of the public. Secondly, plaintiff has to simultaneously prove on record identity or similarity of goods and services covered by such registered trademark.

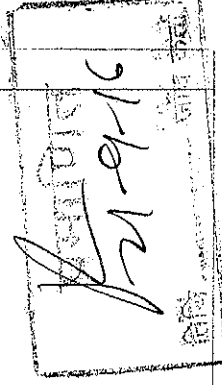
53. As far as first part is concerned, upon comparing the plaintiff's registered trademark EXTRAMARKS.COM with defendants tradename BINDAL'S EXTRAMARKS, it is apparent that in word EXTRAMARKS is common to the both.

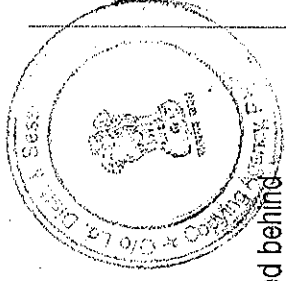


Evidently, word EXTRAMARKS is not in English Dictionary word. It is rather a combination of two words. Upon Dissection thereof its constituent words EXTRA and MARKS are apparently found to be common dictionary words which are used by the same group of persons related to education and educational services. As such per se the combination of there two words and its usage as a one word EXTRAMARKS prima facie appears to be unique and distinctive usage by the plaintiff.

54. As detailed supra plaintiff was using the word EXTRAMARKS since 2007 and holds registration of trademark EXTRAMARKS.COM as well and has a right to protect the same. No cause or reason whatsoever has been shared by the defendant to show as to what made defendant company to adopt the word EXTRAMARKS in the year 2013 but for their perse attempt to encash the reputation of the plaintiff company. It would not be out of place to mention here that plaintiff company has international presence as its products are being used is around 7000 schools by around 80 lakhs students. There revenue was Rs. 185 Crores during the year 2013-14 and they had spend around 1.16 Crores in that year for developing their brand name EXTRAMARKS.COM.

55. On the hind side defendant has not placed anything on record to show as to what is the volume of notebooks it has sold since 2013 when they adopted the trademarks BINDAL'S EXTRAMARKS. Also no statement of any revenue earned from usage of this trademarks or any expenses incurred in its publicity has been shared with the Court. In view of the same, at this juncture, it can be prima facie concluded that this deceptive manner in which word BINDAL is being used by the





defendant along with an enlarged EXTRAMARKS, suffix the only objected behind the same is to create confusion in the mind of the public. This adoption of the defendant of tradename EXTRAMARKS does not appear to be honest by any standards.

56. As far as second aspects of Section 29 (2) of TM Act is concerned , this Court is of the considered prima facie that running an educational website and selling of note books are similar and closely related to each other in so far as they both pertain to the field of education and their consumer base is also common. Even though the educational services are covered under Class 41 and stationary material is placed under Class 16, the close proximity of both the goods and services in the case in hand and titles plaintiff to cover his case and seek protection u/Sec 29 (2) as well.

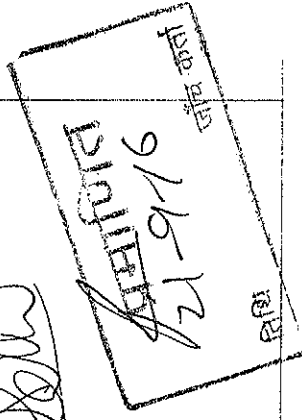
57. As regards Section 29 (4) the situation is technically diverse in so far as Section 29 (4) (b) requires that the protection this clause can be granted only when the goods and services are not similar. As far as the plaintiff is concerned, no doubt the company has a right to seek protection of its trademarks EXTRAMARKS.COM by doing all that is possible under the IPR laws and for this purpose the plaintiff is well within its rights to seek protection by taking alternative pleas. In order to cover this case the plaintiff has to prima facie show on record that it has to reputation in India and that defendant is using their mark in order to derive the unfair financial advantage which is detrimental to the plaintiff's mark as well as its reputation.

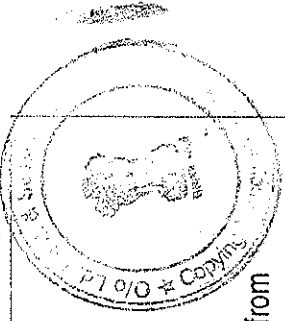
58. Since the case in hand is at the initial stage and evidence is yet to led and

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concluded, the merits of stand taken by both the sides as to be judge from whatever pleadings made or documents filed.

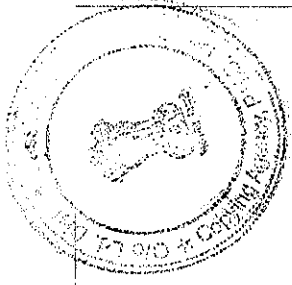
Section 2 (zg) of Trade mark Act, 1999-

2. Definitions and interpretation.-In this Act, unless the context otherwise requires-
(zg) "well-known trade mark", in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.

Section 11 (6) of Trade mark Act, 1999-

11. Relative grounds for refusal of registration-(1) Save as provided in section 12, a trade mark shall not be registered if, because of-
(6) The Registrar shall, while determining whether a trade mark is a well trade mark, take into account any fact which he considers relevant for determining a trademark as a well-known mark including-
(i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;
(ii) the duration, extent and geographical area of any use of that trade mark;
(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;
(iv) the duration and geographical area of any

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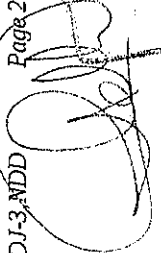
registration of or any application for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark;

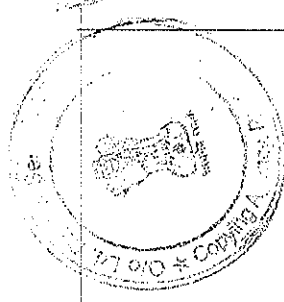
(v) the record of successful enforcement of the rights in that trade mark; in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

59. Plaintiff has filed enough material to prima facie to show that it has a reputation in India. The issue whether the plaintiff company can be covered under/Section 2(z)(g) as a well known trademark is a question which can be suitably decided conclusively only post leading of the evidence. In case a prima facie view has to be carved out, at this juncture, as per the definition of "Well Known Trademark" and parameters covered under/Section 11 (6) of the TM Act, plaintiff does appear to be a mark which has a reputation in India.

60. On this aspect in case titled **Choice Hotels International Inc. VS M. Sanjay Kumar and Ors., MANU/DE/0443/2015, Hon'ble High Court of Delhi** observed-

37. Section 29(4) is also distinct from Section 29(1) to (3) of the TM Act in another important aspect. The element of having to demonstrate the likelihood of confusion is absent. Perhaps to balance out this element, the legislature has mandated the necessity of showing that (a) the mark has a reputation in India (b) that the mark has a distinctive character (c) the use by the infringer is without due cause. In other words, the legislative intent is to afford a stronger protection to a mark that has a reputation without the registered proprietor of such mark having to demonstrate the likelihood of confusion arising from the use of an identical or similar mark in relation to dissimilar goods and services. The words 'detriment' in the context of the 'distinctive character' of the mark brings in the concept of 'dilution' and 'blurring'. In the context of 'repute' they are also relatable to the


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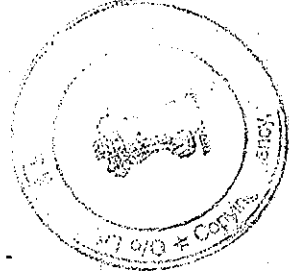
concept of 'tarnishment' and 'degradation'. The words "takes 'unfair advantage'" refers to 'free-riding' on the goodwill attached to mark which enjoys a reputation. The disjunctive 'or' between the words 'distinctive character' and 'repute' is designedly inserted to cater to a situation where a mark may not have a distinctive character and yet may have a reputation.

38. Section 2(zg) of the TM Act defines a 'well known trade mark' in relation to any goods or services to mean 'a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or service would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.' Under Section 11(9)(f) and (v), for the purposes of registration of a well-known mark it is not necessary for such mark to have been used in India or be well-known to the public at large in India. It must be well known to a substantial segment of the relevant public.

39. It may not be necessary for the proprietor of a registered mark to show that it is a 'well-known trademark' as defined in Section 2(zg) although if in fact it is, it makes it easier to satisfy the 'reputation' requirement of Section 29(4) of the TM Act. The presumption of distinctiveness attached to a registered mark is a rebuttable one. At the interim stage, either of these elements should be shown prima facie to exist. Whether in fact these elements are satisfied would depend on the evidence led by the parties at trial.

61. In case titled **Ford Motor Company and Anr. Vs. Mrs. C R Borman and Anr.**, Manu/DE/1564/2008, Hon'ble High Court of Delhi Bench held that once a Trademark has a reputation which travels beyond the class for which it is registered, it has a right to seek legal reputation of a vide protection. Meaning thereby that Trademarks of one class cannot be permitted to be spoiled on encashed in other class. observed-

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16. The learned Single Judge has interpreted Section 29(4) in a manner that would afford protection to a plaintiff only in respect of the Class in respect of which registration of the trademark has been carried out. The learned Single Judge has opined that the primary objective of the Act is to restrict protection to trademarks in respect of the Class under which it has been applied and registered. The view of the learned Single Judge is that the intent of the Act could not be for a blanket protection to be made available to a trademark in respect of the entire gamut of Classes. What should not be lost sight of is the fact that Section 29(4) is palpably an exception to the scheme of the Act and applies only to those trademarks which have earned a reputation in India. If it is, prima facie, clear or it is proved through evidence that the concerned trademark enjoys and commands a reputation in India, the plaintiffs do not have to prove deception on the part of the defendants or likelihood of the customer being misled because of the use of the challenged trademark. Once the plaintiffs have made out a case that the offending trademark is identical with or similar to its registered trademark, relief would be available even if the purveyed goods are not similar and/or fall in the same category or class. On a careful comparison of Section 29(4) with other provisions of that Section as well as the Act, this legal position commends itself to us. It is impermissible to ignore all these features of Section 29(4) only because they may be seen running counter to other provisions of the Act. This is the very purpose of inserting an exception. It would be advantageous to reproduce the sentence from Parliamentary Discussion on the Trade Marks Act, 1999 which reads thus: The proposed Bill seeks to introduce protection for registration of trade marks for services in addition of goods. It also seeks to extend protection for well-known trademarks and to do away with the system for registration in Part A and B and to provide for a single computerised register with a simplified procedure for registration with equal rights. Well-known trademarks, it is worthy of reiteration, have been specifically dealt with in

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Section 29(4) and it would be jurally impermissible to dilute or water down the intentment of the Legislature."

62. In view of the above discussion, and case law I am of the considered view that plaintiff is entitled to protection in law for safe guarding its trade name EXTRAMARKS. Nothing has been brought by defendant on record which would entitle defendant to seek vacation of injunction order passed by this Court on 31.03.2016. Application of defendant under disposal u/O 39 rule 4 CPC is accordingly dismissed. The injunction of 31.03.16 is hereby confirmed during the pendency of trial.

Announced in an open Court
On 23rd day of July, 2016.

(Surinder S. Rathi)
ADJ-03/PHC/NEW DELHI
23.07.2016

