



Mohan Meakin Limited vs. The Devisolam Distilleries Ltd.

COMS No.5 of 2023

02.06.2023

Present: Mr. Bipin C. Negi, Senior Advocate, along with M/s Arvind Sharma and Krishna Gambhir, Advocates, for the plaintiff.

COMS No.5 of 2023

Notice, returnable on 17th July, 2023, on taking steps by tomorrow i.e. 03.06.2023, be issued to the defendant.

OMP No. 236 of 2023

Notice in the aforesaid terms.

Applicant-plaintiff has preferred a suit for permanent injunction against infringement of Trade Marks, passing off, unfair competition, damages, rendition of accounts etc. by submitting plaintiff-Company having its registered office at Solan Brewery in Himachal Pradesh, with Branch Offices at Mohan Nagar, Ghaziabad, U.P., is a renowned Indian Company in liquor industry with established Breweries and Distilleries in various parts of the Country, which owns and uses several distinctive Trade Marks, including prominent Trade Marks 'Old Monk' and 'Monk' being used by the Company since 1959 having been registered in favour of the plaintiff-Company since 1971 and 2008 respectively.

It has further been claimed that 'Old Monk' is the third largest selling rum in the world and is biggest Indian-Made Foreign Liquor (IMFL) brand. It has further been claimed that Old Monk has been awarded gold medals at Monde Selections. The products/bottles under the Trade Mark Old Monk/Monk are being sold in unique, artistic and distinctive

trade dress/shape/design/label/packaging/layout/colour scheme since many decades. Further that, plaintiff is enjoying extensive reputation and goodwill in India as well as abroad and sales in India during 2021-2022 amounts to Rs.774.09 Crores and export of Old Monk Beer during 2021-2022 is Rs.1,61,03,346/-. It has further been submitted that expenditure incurred by the applicant-plaintiff for marketing as well as promotion of sale with respect to its products, including Trade Mark 'OLD MONK' in India and worldwide during 2021-2022 is 774.09 lacs.

It has been submitted that, as per information available with the plaintiff, defendant is a Private Limited Company having its registered office in Kochi and engaged in the business of manufacturing and marketing of Alcoholic Beverages.

It has further been submitted by learned counsel for the applicant-plaintiff that though defendant is situated and has its registered office in Kochi and, applicant-plaintiff has its office in Himachal Pradesh, but for provisions of Section 134(2) of the Act, a suit has to be instituted where the person instituting the suit actually and voluntarily resides and carry on business or personally works for gain and, therefore, present suit has been preferred in this Court, as the applicant-plaintiff is entitled for relief for infringement and passing off the Trade Mark as provided under Section 135 of the Act.

It has been submitted on behalf of applicant-plaintiff that defendant has filed an application for registration of word mark 'DDLs OMR' in Class 33 being Application No.5583398 on 25.08.2022.

Further that aforesaid application filed by defendant has been opposed by the applicant-plaintiff by filing representation in the Trade Marks Office. The said application is pending adjudication before the concerned authority.

Applicant-plaintiff has also placed on record documents/printouts of e-Register maintained by Trade Mark Office, indicating that 'OLD MONK' and 'MONK' trademarks have been registered in its favour since 05.07.1971 and 04.08.2008 with respect to Class 33 with user thereof since 01.08.1959.

Plaintiff has also placed on record print of e-Register with respect to application filed by the defendant for registration of 'DDLs OMR' as its Trade Mark indicating that the said application is pending. Printout of e-Register and representation filed by the applicant-plaintiff, have also been placed on record.

Applicant-plaintiff has also placed on record photographs/printout of exhibition of its trademark on its product as well as exhibition trademark proposed to be registered by the defendant on its product, wherein defendants have used words 'OMR' in stylized form similar to product of plaintiff in a manner giving impression of similar product to the product of applicant-plaintiff.

It has been further submitted on behalf of plaintiff that the impugned product of the Defendant is being used in respect of identical goods, i.e., Alcoholic Beverages and Rums and a holistic comparison between the competing products, the style of writing the trade marks on the products as well as the placement of the labels clearly establish the dishonest

intention of the Defendant to misrepresent its impugned product as that of the Plaintiff and ultimately confuse the unwary purchaser with a *mala fide* agenda to cash upon the goodwill and reputation enjoyed by the Plaintiff, its said trademarks/labels and its products.

Learned counsel for plaintiff has also referred comparison chart of the competing products of both the parties, reproduced herein below:

PLAINTIFF	DEFENDANT
	
<p>On the cap OLD MONK RUM has been written in a particular stylized font</p>	<p>On the cap OMR (short form of OLD MONK RUM) is written in same stylized font to cause confusion</p>
<p>Cap bears the mark OLD MONK RUM written in a particular stylized font</p>	<p>Cap bears the mark OMR in same stylized font/manner as that of the Plaintiff</p>
<p>Label is Oval in shape with mark OLD MONK written in a particular stylized font</p>	<p>Label is also Oval in shape in same stylized font/manner as that of the Plaintiff</p>
<p>Bottle is rectangular in shape with curved edges</p>	<p>Bottle is also rectangular in shape with curved edges and is nearly identical to</p>

PLAINTIFF	DEFENDANT
	the Plaintiff's bottle

According to learned counsel for plaintiff the moment the Plaintiff became aware of Defendant's objectionable activities, the Plaintiff on 01.02.2023, filed a request before the Registrar of Trade Marks for particulars of advertisement of the impugned trade mark application for 'DDL'S OMR' (word mark) of Defendant under application number 5583398 in Class 33 and thereafter, Plaintiff addressed a Cease and Desist letter dated 02.02.2023 to Defendant calling upon them to cease all use of the mark 'OMR' and its impugned trade dress/ shape/ overall get up being an abbreviation of Plaintiff's prior and well-known trade mark 'OLD MONK RUM' and its trade dress/ shape/ overall get up used in respect of its 'OLD MONK' Rum. It is further case of the plaintiff that *vide* reply dated 19.02.2023, Defendant refuted the contents of the 'cease and desist' notice and refused to give up use of the impugned trade mark 'OMR' and of the impugned trade dress/ shape/ overall get up and thereafter being aggrieved by the intransigent stance of Defendant, Plaintiff has no other option but to approach this Court.

It is further claim of the plaintiff that use of the impugned trade mark 'OMR' in a similar stylized font in conjunction with a near identical trade dress/ shape/ overall get up that too for alcoholic beverages is an attempt to create confusion in the minds of the people that it belongs to the Plaintiff and such objectionable

acts amount to grave misrepresentation and further dilutes the reputation and goodwill acquired by the Plaintiff in the course of trade. Further that dishonest adoption/ use of near identical trade dress/ shape/ overall get up by the Defendant under impugned trade mark 'OMR' is inexplicable and would mislead the unwary consumers and members of trade, because Plaintiff having priority in adoption, long and continuous usage and extensive popularity, reputation and goodwill is etched in the minds of the people and use of such an acronym 'OMR' (short form of **OLD MONK RUM**) along with such an identical trade dress/ shape/ overall get up by the Defendant shall cause deception and confusion in the minds of public thereby hampering the reputation and goodwill enjoyed by Plaintiff.

It is claim of the plaintiff that objectionable acts of the Defendant conspicuously exhibit its clear knowledge of Plaintiff's goodwill and reputation including that attached to its products under the trade mark/ label OLD MONK and its said trade dress/ shape/ overall get up for its unique bottle as well as their intention to trade upon the same and derive unjust benefits therefrom as confusion is inevitable in the marketplace.

It has been submitted on behalf of plaintiff that entire attempt of the Defendant is to ride on Plaintiff's extensive and long standing reputation as such deliberate copying of the Plaintiff's trade mark and bottle is not a mere coincidence but is testimony to Defendant's dishonest adoption and fraudulent

intention to derive unjust gains at the Plaintiff's expense. Further that Defendant's subsequent adoption of Plaintiff's aforementioned intellectual property is completely *mala fide* and tainted since inception, and therefore, the Plaintiff is constrained to approach this Hon'ble Court.

It has been submitted that the Defendant is seeking to enjoy advantage of the reputation and goodwill earned by the Plaintiff in respect of its products under the said trade mark 'OLD MONK' and the trade dress/ shape/ overall get up used in respect thereof, by deliberately copying the Plaintiff's OLD MONK bottles for its products along with adopting the acronym 'OMR', which may be stocked and sold in the same premises/outlets as the Plaintiff's with sole intent to signify a trade connection with the Plaintiff and augment the chances of confusion and deception amongst the consumers with intention to capitalize on the reputation and goodwill subsisting in the Plaintiff's business by projecting the members of trade and public that impugned goods of the Defendant bearing the impugned trade mark 'OMR' along the impugned trade dress shape/ design/ label/ packaging/ layout/ colour scheme emanate from or enjoy the backing/ approval/ consent/ license of the Plaintiff in order to achieve an increase in its sales and the concomitant revenue generated therefrom.

It has further been submitted on behalf of the applicant-plaintiff that plaintiff exercising vigilance in protecting its intellectual property rights, in the brand,

earlier also, had approached Delhi High Court for using marks 'TOLD MOM' and 'CRAFTY MONK' by different Companies and the case in "TOLD MOM' has been decided in favour of the applicant-plaintiff whereas case pertaining to 'CRAFTY MONK' has been decreed as per compromise between parties and in those cases defendants have been restrained from using deceptively similar Trade Marks involved in those cases i.e. "TOLD MOM' and 'CRAFTY MONK'. Copies of judgments/orders passed in those cases have also been placed on record.

Learned counsel for the applicant-plaintiff has submitted that trademark being used and proposed to be registered by the defendant Company is similar to the trademark being used by and registered in the name of applicant-plaintiff Company and its exhibition on the products of the defendant resembles with mark of the applicant-plaintiff Company and, therefore, as defined under Section 2(h) of the Trade Marks Act, 1999 (hereinafter referred to as 'the Act') the Trade Mark, being used and proposed to be registered by the defendant Company, is deceptively descriptively similar to the Trade Mark used by the applicant-plaintiff Company.

Referring Section 27(2) of the Act, learned counsel for the applicant-plaintiff has submitted that applicant-plaintiff has right of action against the defendant for passing off goods or services as the goods of plaintiff or as services provided by plaintiff.

To substantiate claim of interim relief, learned counsel for the applicant-plaintiff has also placed

reliance upon pronouncements of the Supreme Court in ***ADS Spirits Pvt. Ltd. vs. Shubhom Juneja, (2023) SCC OnLine Del 2654; Parle Products Private Limited vs. J.P. and Co., Mysore (1972)1 SCC 618; Heinz Italia & another vs. Dabur India Ltd. (2007)6 SCC 1; Colgate Palmolive Company and another vs. Anchor Health and Beauty Care Pvt. Ltd. (2003) SCC Online Del 1005; Laxmikant V. Patel vs. Chetanbhai Shah and another (2002)3 SCC 65*** and ***Wander Ltd and another vs. Antox India P. Ltd. (1990) Supp. SCC 727.***

Taking into consideration material placed before me, and submissions made by learned counsel for the applicant-plaintiff, I am of the considered opinion that *prima facie* case is made out in favour of the applicant-plaintiff for passing ad-interim order.

Accordingly defendant, their promoters, assigns, relatives, successors-in-interest, licensees, franchisees, directors, representatives, servants, distributors, employees, agents, etc., or anyone associated with them are restrained from using/selling/importing/exporting the products/bottles bearing the objectionable trade dress/shape/design/label/packaging/layout/colour scheme viz dress / shape/ design/ label / packaging / layout /colour scheme viz.,



under the mark 'OMR' (short form of OLD MONK RUM) respectively and/or any other trade dress / shape/ design/ label / packaging / layout / colour scheme identical with or similar to the Plaintiff's products/bottles under the mark OLDMONK/ MONK and trade dress / shape/ design/ label / packaging / layout / colour scheme used in respect thereof in any manner whatsoever in respect of their business so as to pass off or enable others to pass-off their business and/or goods/services as that of the Plaintiff or in some other manner connected with the Plaintiff.

Compliance under Order 39 Rule 3 CPC be ensured within 24 hours.

Applicant-plaintiff is permitted to produce a copy of this order, downloaded from the web-page of the High Court of Himachal Pradesh, before the authorities concerned, and the said authorities shall not insist for production of a certified copy but if required, may verify passing of order from Website of the High Court.

(Vivek Singh Thakur)
Judge

June 02, 2023
(ms)