

C.S.(Comm.Div.)No.77 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

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DATED: 22.11.2023

CORAM:

THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

C.S.(Comm.Div.) No.77 of 2023

Eicher Motors Ltd.,
3/9, Royal Enfield, Besant Avenue,
Adayar, Chennai,
Tamil Nadu – 600 020.
Rep. By its Power Agent
Mr.Tapaswi Kumar Gupta

... Plaintiff

Vs.

Nitin Service Point and Automobiles,
Shop No.5, Runwal Classic,
A Block, Kalewadi Main Road,
Jagtap Nagar, Tapkir Chowk,
Thergaon, Pimpri-Chichwad,
Maaharashtra.

... Defendant

Prayer: Civil Suit is filed under Order IV Rule 1 of O.S. Rules and Order VII Rule 1 CPC read with Sections 27, 29, 134 & 135 of the Trademarks Act, 1999, and first proviso to Section 7 of the Commercial Courts Act, 2015, praying:-

a) to grant permanent injunction restraining the Defendant, its partners, directors, officers, men, servants, agents, distributors, stockists,



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successors in business, retailers, legal representatives, assigns or any other person claiming through or under them in any manner whatsoever from infringing the registered trademark ROYAL ENFIELD by the use of an identical mark ROYAL ENFIELD or any other mark identical or deceptively similar in respect of any goods or services or in any other manner whatsoever;

(b) to grant permanent injunction restraining the Defendant, its partners, directors, officers, men, servants, agents, distributors, stockists, successors in business, retailers, legal representatives, assigns or any other person claiming through or under them, from in any manner using, selling, offering for sale, advertising its services and products or otherwise dealing with the trademark ROYAL ENFIELD, singularly or in combination with any other word and/or any mark similar or deceptively similar thereto and thereby passing off their products, services and business as and for the products, services and business of the Plaintiff or in any other manner whatsoever;

(c) to grant permanent injunction restraining the Defendant, its partners, directors, officers, men, servants, agents, distributors, stockists, successors in business, retailers, legal representatives, assigns or any other person claiming through or under them, from in any manner replicating the look and feel and the exterior, interior of the Plaintiff's authorized outlets, thereby passing off their services/business by use of color scheme, get up, arrangement of features and layout deceptively similar to the Plaintiff's authorized outlets.

(d) the Defendant be ordered to pay to the Plaintiff, a sum of



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Rs.10,00,000/-, as damages for committing infringement of trademark and passing off its products/services/business as being associated with the Plaintiff;

(e) the Defendant be ordered to surrender to the Plaintiff for destruction of the name boards, invoices/bills, prints, brochures, screen prints and advertising material and any other material in the Defendant's possession, which bears the mark ROYAL ENFIELD;

(f) to pass an order of declaration, declaring the Plaintiff's registered trademark ROYAL ENFIELD as "well-known" trademark within the meaning of Section 2(1) (zg) read with Section 11(6) of the Trademarks Act, 1999 along with a direction to the Registrar of Trademarks to notify the mark ROYAL ENFIELD on the register of well-known marks;

(g) a preliminary decree be passed in favor of the Plaintiff directing the Defendant to render account of profits made by use of the Plaintiff's trade mark ROYAL ENFIELD amounting to infringement of the Plaintiff's registered trademark and/or passing off and a final decree be passed in favor of the Plaintiff for the number of profits thus found to have been made by the Defendant after the latter have rendered accounts; and (h) for costs of the suit;

For Plaintiff : Mr.Vijay Narayanan, Sr. Counsel
for Mr.Arun C.Mohan

Defendant is set exparte



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JUDGMENT

This suit has been filed seeking the following reliefs;

(a) to grant permanent injunction restraining the defendant from infringing the registered trademark “ROYAL ENFIELD” by the use of an identical mark “ROYAL ENFIELD” or any other mark identical or deceptively similar thereto in respect of any goods or services or in any other manner whatsoever;

(b) to grant permanent injunction restraining the defendant from in any manner using, selling, offering for sale, advertising its services and products or otherwise dealing with the trademark ROYAL ENFIELD, singularly or in combination with any other word and/or any mark similar or deceptively similar thereto and thereby passing off their products, services and business as and for the products, services and business of the Plaintiff or in any other manner whatsoever;

(c) to grant permanent injunction restraining the defendant from in any manner replicating the look and feel, and the exterior and interior of the Plaintiff’s authorized outlets, thereby passing off their services/business by use of color scheme, get up, arrangement of features and layout deceptively similar to the Plaintiff’s authorized outlets;



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(d) to order the defendant to pay a sum of Rs.10,00,000/- to the plaintiff as damages for committing infringement of trademark and passing off its products/services/business as being associated with the Plaintiff;

(e) the Defendant be ordered to surrender to the Plaintiff for destruction of the name boards, invoices/bills, prints, brochures, screen prints and advertising material and any other material in the Defendant's possession, which bears the mark ROYAL ENFIELD;

(f) to declare the Plaintiff's registered trademark "ROYAL ENFIELD" as "well-known" trademark within the meaning of Section 2(1) (zg) read with Section 11(6) of the Trademarks Act, 1999 (in short "the Act") along with a direction to the Registrar of Trademarks to notify the mark ROYAL ENFIELD on the register of well-known marks;

(g) to grant a preliminary decree in favor of the Plaintiff directing the Defendant to render account of profits made by use of the Plaintiff's trade mark ROYAL ENFIELD amounting to infringement of the Plaintiff's registered trademark and/or passing off and a final decree be passed in favor of the Plaintiff for the number of profits thus found to have been made by the Defendant after the latter have rendered accounts; and

(h) for costs of the suit;



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WEB COPY 2. Since no one has entered appearance on behalf of the defendant despite effecting substituted service, the defendant was set exparte by this Court on 09.11.2023.

3. The plaintiff, with regard to their reputation as a leading manufacturer of motorcycle (ROYAL ENFIELD), has made the following averments in the plaint:-

1. During 1901, the first Royal Enfield motorcycle was produced by The Enfield Cycle Company Limited at Redditch, England. This was discussed in detail in The Autocar newspaper of 12thSeptember 1901. The motorcycle was designed by Bob Walker Smith and Frenchman Jules Gobiet and was launched at the famous Stanley Cycle Show in London in November1901. The motorcycle was advertised in the newspapers including in The Autocar newspaper dated 21stDecember 1901. In 1913, at the first India Tourist Trophy race, Royal Enfield had won the first prize.

2. After first Indo Pakistan war and considering the continued hostilities along the Cease-Fire Line (now known as Line of Control ('LOC')), the Government of India ('GOI') during1951 looked out for the '**seize- proof**'



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motorcycles for Indian army to carry out patrolling at the inaccessible tracts along the Cease-Fire Line. The Plaintiff's Royal Enfield Bullet 350 was chosen as the most suitable bike for the job. Immediately, during 1952, 500 of such bikes were ordered by the GOI. The Royal Enfield Bullets gave a sterling service on the tough terrain of Kashmir and in scorching desert of Rajasthan. Thereafter, subsequent orders were issued by GOI, with requirement to manufacture such bikes in India. An industrial license was granted with provision for the company to manufacture upto 5000 units per annum provided it followed a phased programme of making an ever-increasing number of components in India. This was the beginning of a relationship of paramount importance to Royal Enfield-with Indian Army and other armed forces.

3. In 1955, the Redditch company partnered with Madras Motors in India to form 'Enfield India' to assemble, under licence, the 350 cc RoyalEnfield Bullet motorcycle in Madras and The Enfield India Limited('The Enfield India') was incorporated. Initially, it started with the assembling of Royal Enfield Bullets shipped from Royal Enfield Redditch, at its plant in Madras, India. By 1962, all components were made in India. From 1977, Enfield India begins exporting the 350cc Bullet to the UK and Europe.



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4. The Plaintiff states that since the year 1955, the Plaintiff has been continuously, extensively and widely manufacturing and marketing their motorcycles in India under the distinctive trademark ROYAL ENFIELD. All Plaintiff's products bear the house mark ROYAL ENFIELD and are sold across India and the globe. The Plaintiff's ROYAL ENFIELD motorcycles are sold under several well-known brands like Royal Enfield, Bullet, Enfield, Royal Enfield Continental GT, Royal Enfield Thunderbird, Classic, Royal Enfield Himalayan, Royal Enfield Interceptor, Royal Enfield Hunter, Royal Enfield Meteor etc. The Plaintiff's ROYAL ENFIELD motorcycles and accessories are sold extensively all over India and are also exported to over 70 countries viz. USA, Europe, Brazil, Thailand, Nepal, Australia, Colombia, etc. The Plaintiff's motorcycles sold under the mark ROYAL ENFIELD by reason of their excellent quality and volume of sales have garnered enviable reputation and goodwill amongst the members of the trade and public and the mark ROYAL ENFIELD is always associated with that of the Plaintiff only and to this day its Royal Enfield motorcycles stand as a symbol of power, toughness, elegance and to put it in a few words it still represents the legacy of "Royal Enfield - Made Like A Gun!".

5. The Plaintiff's manufacturing operations go through a series of modernization and improvement



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efforts, with a number of automated processes. Its products are known for their reliability, quality and toughness. The Plaintiff has a state-of-the-art infrastructure to manufacture its vehicles and has an active in-house research and development wing (one in India and another one in United Kingdom) constantly at work to meet the changing customer/market preferences. At present, the Plaintiff operates via various subsidiaries across multiple countries namely in the United Kingdom, Thailand, North America, Brazil and Canada. It operates through its dealers and distributors and by means of more than 1088 large format stores and 1024 studio format stores in major cities and towns across India and exports to multiple countries worldwide. Through its distribution network, the Plaintiff has 187 exclusive stores in 22 countries and sells through about 724 multi-brand outlets and has over 1000 dealers/retainers around the world.

6. The Plaintiff has more than 1088 authorized dealers in India, all maintaining a similar Brand Retail Identity (BRI) and are operating outlets that are uniquely designed with distinguishing features which include distinctive interiors, exteriors, colour scheme and get-up which has become inalienably associated with the goods and business of the Plaintiff apart from using the trademarks vesting with the Plaintiff. This is an exercise done at considerable cost and effort, and with a uniform



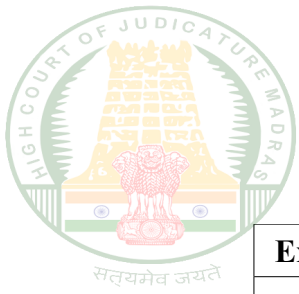
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standard across the country and abroad.

WEB COPY 4. The plaintiff came to know in the month of January, 2023, through its authorized dealer that the defendant is using the identical name “ROYAL ENFIELD” for its service center. The service center established by the defendant is situated just 4.7 km. away from the authorized showroom of the plaintiff. Therefore, since the showroom established by the defendant is creating deception and confusion in the minds of the general public, the plaintiff was constrained to file this suit seeking for the reliefs as prayed for in the plaint.

5. Before the learned Additional Master-III, the power agent of the plaintiff by name Mr.Tapaswi Kumar Gupta, was examined as PW1 on the side of the plaintiff. Through PW1, the following documents were marked as exhibits on the side of the plaintiff:-

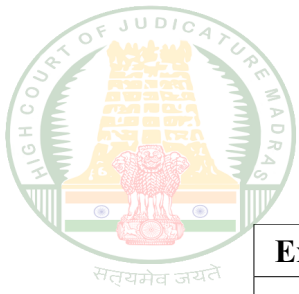
Ex.No.	Description and nature of documents
Ex.P1	Power of Attorney
Ex.P2	Copy of registration certificate of trademark ROYAL ENFIELD (WORD MARK) under no. 657319 along with copy of Trademarks Journal. (photocopy)
Ex.P3	Copy of registration certificate of trademark ROYAL ENFIELD THUNDER BIRD (WORD MARK) under no. 1035163 along with copy of Trademarks Journal. (photocopy)



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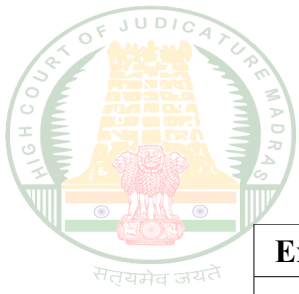
Ex.No.	Description and nature of documents
Ex.P4	Copy of registration certificate of trademark ROYAL ENFIELD CAFE RACER (WORD MARK) under no. 1095489 along with copy of Trademarks Journal. (photocopy)
Ex.P5	Copy of registration certificate of trademark ROYAL ENFIELD CLUBMAN (WORD MARK) under no. 1095490 along with copy of Trademarks Journal. (photocopy)
Ex.P6	Copy of registration certificate of trademark ROYAL ENFIELD METEOR (WORD MARK) under no. 1095491 along with copy of Trademarks Journal. (photocopy)
Ex.P7	Copy of registration certificate of trademark ROYAL ENFIELD TRAIL (WORD MARK) under no. 1095492 along with copy of Trademarks Journal. (photocopy)
Ex.P8	Copy of registration certificate of trademark Royal Enfield Label under no. 1107889 along with copy of Trademarks Journal. (photocopy)
Ex.P9	Copy of registration certificate of trademark ROYAL ENFIELD CLASSIC (WORD MARK) under no. 1788966 along with copy of Trademarks Journal. (photocopy)
Ex.P10	Copy of registration certificate of trademark ROYAL ENFIELD TRIP (WORD MARK) under no. 1884955 along with copy of Trademarks Journal. (photocopy)
Ex.P11	Copy of registration certificate of trademark ROYAL ENFIELD THUNDERBIRD 'LOGOUT' (WORD MARK) under no. 1884957 along with copy of Trademarks Journal. (photocopy)
Ex.P12	Copy of registration certificate of trademark ROYAL ENFIELD 'LOGOUT' (WORD MARK) under no. 1884958 along with copy of Trademarks Journal. (photocopy)
Ex.P13	Copy of registration certificate of trademark ROYAL ENFIELD CRUZR (WORD MARK) under no. 1986869 along with copy of Trademarks Journal. (photocopy)



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Ex.No.	Description and nature of documents
Ex.P14	Copy of registration certificate of trademark ROYAL ENFIELD TOURER (WORD MARK) under no. 1986870 along with copy of Trademarks Journal. (photocopy)
Ex.P15	Copy of registration certificate of trademark ROYAL ENFIELD HIMALAYAN TOURER (WORD MARK) under no. 1986871 along with copy of Trademarks Journal. (photocopy)
Ex.P16	Copy of registration certificate of trademark ROYAL ENFIELD CONTINENTAL GT WORD PER SE under no. 2347096 along with copy of Trademarks Journal. (photocopy)
Ex.P17	Copy of registration certificate of trademark ROYAL ENFIELD Logo under no. 2893335 along with copy of Trademarks Journal. (photocopy)
Ex.P18	Copy of registration certificate of trademark Royal Enfield Himalayan Sleet under no. 3734184 along with copy of Trademarks Journal. (photocopy)
Ex.P19	Copy of registration certificate of trademark ROYAL ENFIELD HUNTER (WORD) under no. 4353491 along with copy of Trademarks Journal. (photocopy)
Ex.P20	Copy of registration certificate of trademark ROYAL ENFIELD ROADSTER (WORD) under no. 4426653 along with copy of Trademarks Journal. (photocopy)
Ex.P21	Copy of registration certificate of trademark ROYAL ENFIELD MADE LIKE A GUN under no. 5129738 along with copy of Trademarks Journal. (photocopy)
Ex.P22	Copy of registration certificate of trademark R WITH WING DEVICE under no. 5129739 along with copy of Trademarks Journal. (photocopy)
Ex.P23	Copy of registration certificate of trademark ROYAL ENFIELD WITH R AND WING DEVICE under no. 5129740 along with copy of Trademarks Journal. (photocopy)



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Ex.No.	Description and nature of documents
Ex.P24	Copy of registration certificate of trademark ROYAL ENFIELD WITH R AND WING DEVICE under no. 5129741 along with copy of Trademarks Journal. (photocopy)
Ex.P25	Copy of registration certificate of trademark ROYAL ENFIELD MADE LIKE A GUN under no. 5129742 along with copy of Trademarks Journal. (photocopy)
Ex.P26	Copy of registration certificate of trademark ROYAL ENFIELD CONSTELLATION under no. 5323674 along with copy of Trademarks Journal. (photocopy)
Ex.P27	List of International registrations obtained by the Plaintiff for the mark ROYAL ENFIELD (Printout)
Ex.P28	Invoices for sale of motorbikes by the Plaintiff (Photocopy)
Ex.P29	Certificate of sales and Sales promotional expenses for the mark ROYAL ENFIELD (Photocopy)
Ex.P30	Advertisements and promotional materials issued by the Plaintiff for the mark ROYAL ENFIELD (Photocopy)
Ex.P31	Awards and Recognitions granted to the Plaintiff for the mark ROYAL ENFIELD (Photocopy)
Ex.P32	Plaintiff's ROYAL ENFIELD logo and photographs of the service centre (Photocopy)
Ex.P33	Defendant's service outlet photographs

PW1 has also reiterated the contents of the plaint in his proof affidavit.

6. The issues that arise for consideration in this suit are as follows:-

(a) Whether the plaintiff has proprietary



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right to the trademark 'ROYAL ENFIELD'?

(b) Whether the plaintiff's trademark falls within the definition of Well-Known mark within the meaning of Section 2(1)(zg) of the Trade Marks Act?

(c) Whether the plaintiff is entitled for damages and surrender of infringed materials by the defendant and rendition of accounts by the defendant as sought for in prayer (d), (e) and (g) of the plaint?

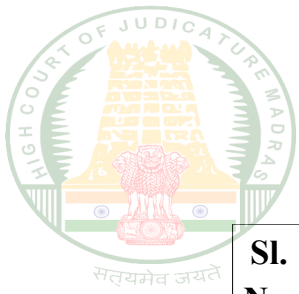
(d) Whether the use of the word “ROYAL ENFIELD” by the defendant would amount to infringing and passing off of the trademark of the plaintiff? and

(e) To what other reliefs the plaintiff is entitled to?


Issue (a):-

Whether the plaintiff has proprietary right over the trademark “ROYAL ENFIELD?”

7. The list of registrations for the mark “ROYAL ENFILED” and its variations obtained by the plaintiff are as follows:-



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Sl. No.	Date of Application	Application No.	Trademark	Classes
1.	03-01-1995	657319	ROYAL ENFIELD (WORD MARK)	12
2.	08-08-2001	1035163	ROYAL ENFIELD THUNDER BIRD (WORD MARK)	12
3.	15-04-2002	1095489	ROYAL ENFIELD CAFE RACER (WORD MARK)	12
4.	15-04-2002	1095490	ROYAL ENFIELD CLUBMAN (WORD MARK)	12
5.	15-04-2002	1095491	ROYAL ENFIELD METEOR (WORD MARK)	12
6.	15-04-2002	1095492	ROYAL ENFIELD TRAIL (WORD MARK)	12
7.	29-05-2002	1107889	Royal Enfield Label 	12
8.	24-02-2009	1788966	ROYAL ENFIELD CLASSIC (WORD MARK)	12
9.	16-11-2009	1884957	ROYAL ENFIELD THUNDERBIRD 'LOGOUT' (WORD MARK)	12 and 41
10.	16-11-2009	1884958	ROYAL ENFIELD 'LOGOUT' (WORD MARK)	12 and 41
11.	29-06-2010	1986870	ROYAL ENFIELD TOURER (WORD MARK)	12
12.	29-06-2010	1986871	ROYAL ENFIELD HIMALAYAN TOURER (WORD MARK)	12 & 41
13.	16-11-2009	1884955	ROYAL ENFIELD TRIP (WORD MARK)	12 & 41



Sl. No.	Date of Application	Application No.	Trademark	Classes
14.	29-06-2010	1986869	ROYAL ENFIELD CRUZR (WORD MARK)	12
15.	06-12-2012	2347096	ROYAL ENFIELD CONTINENTAL GT WORD PER SE	12
16.	02-05-2015	2893335	ROYAL ENFIELD Logo 	12,9,18,25,35,41
17.	14-03-2016	3209850		12
18.	22-01-2018	3734184	Royal Enfield Himalayan Sleet	12,25,35,41
19.	20-11-2019	4353491	ROYAL ENFIELD HUNTER (WORD)	12
20.	31-01-2020	4426653	ROYAL ENFIELD ROADSTER (WORD)	12
21.	13-09-2021	5129738	ROYAL ENFIELD MADE LIKE A GUN 	9,12,18,25,35,37,41



Sl. No.	Date of Application	Application No.	Trademark	Classes
22.	13-09-2021	5129739	R WITH WING DEVICE 	9,12, 18,2 5,35, 37,4 1
23.	13-09-2021	5129740	ROYAL ENFIELD	9,12, 18,2 5,35, 37,4 1
24.	13-09-2021	5129741	ROYAL ENFIELD WITH R AND WING DEVICE 	9,12, 18,2 5,35, 37,4 1
25.	13-09-2021	5129742	ROYAL ENFIELD MADE LIKE A GUN 	9,12, 18,2 5,35, 37,4 1
26.	10-02-2022	5323674	ROYAL ENFIELD CONSTELLATION	9,12, 18,2 5,35, 37,4 1



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8. The aforesaid registration certificates for the mark “ROYAL ENFIELD” and its variants have been marked as Exs.P2 to P26. Apart from adopting a unique trademark “ROYAL ENFIELD”, the plaintiff has a standard pattern for interiors and exteriors for each and every authorized outlet so as to have the same look and feel/identity for all its outlets to enable its customers to easily identify the plaintiff's authorized outlets. The authorized outlets are distinctive and are exclusively identified by the trade and public with the plaintiff's establishments for motorcycles, parts, fittings, servicing and accessories. While appointing the dealers, the plaintiff ensures that all the dealers maintain the same standards, interiors and exteriors in accordance with plaintiff's BRI (Brand Retail Identity). Therefore, it is clear from the documentary evidence placed on record before this Court that the plaintiff has proprietary right over the trademark “ROYAL ENFIELD” and its variants. Infact, the registration under various classes shows that the plaintiff has got various proprietary rights and rights as conferred for registration as applicable for a registered proprietor. Therefore, issue (a) is decided in favour of the plaintiff by declaring that the plaintiff has proprietary right to the trademarks “ROYAL ENFIELD” and its variants.



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Issue (b):-

WEB COPY (b) Whether the plaintiff's trademark falls within the definition of Well-Known mark within the meaning of Section 2(1)(zg) of the Trade Marks Act?

9. This Court earlier had a doubt as to whether concurrent powers are vested with both the trademark registry as well as this Court for granting recognition for a particular trademark as a well-known mark. In the year 2017, the Trade Marks Rules were amended empowering the trademark registry to grant recognition of a trademark as a well-known mark within the meaning of Section 2(1)(zg) of the Act, but, did not exclude the power of the Court also to grant such a recognition. Prior to the amendment of the Trade Marks Rules in the year 2017, the power to grant recognition of a trademark as a well-known mark was vested only with the Court. Only due to the said reason, a doubt had arisen in the mind of this Court as to whether, with the amendment of the Trade Marks Rules, 2017, the power of this Court to grant recognition of a trademark as a well-known mark has been ousted. To get over the doubt, this Court had to analyze the provisions of Sections 11(6) and 2(1)(zg) of



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the Act and the amended Trade Marks Rules, 2017, pertaining to grant of recognition by the trademark registry for a trademark to be recognized as a well-known mark.

10. After analyzing the said provisions and the authorities pertaining to grant of recognition of a trademark as a well-known mark, this Court is now convinced that concurrent powers are vested with both this Court as well as the Trade Marks Registry for granting recognition to a trademark as a well-known mark.

11. Section 2(1)(zg) of the Act defines a 'well – known trademark' in relation to any goods or services, as "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." The above definition clearly demonstrates the extraordinary protection provided to a well-known mark.



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12. The relevant provisions under the Trade Marks Act, 1999, with regard to “well-known” marks, are as follows:-

(a) Section 11(2) recognizes one of the relative grounds of refusal of a trade mark stating that a trade mark shall not be registered if or to the extent the earlier trade mark being a well-known trademark in India.

(b) Section 11(6) lays down the criteria for determination of a well-known mark, which is as follows:-

(i) The knowledge or recognition of that trademark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trademark;

(ii) the duration, extent and geographical area of any use of that trademark;

(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 registration of or



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

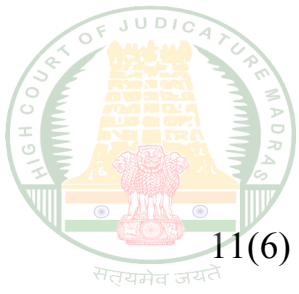
(v) the record of successful enforcement of the rights in that trade mark, in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

(c) Section 11(9) lays down the conditions/factors which are taken into consideration for grant of a well-known trademark. They are as follows:-

- (i) That the Trademark is registered in India.
- (ii) That public at large has knowledge of the trademark .
- (iii) That the Trademark has been used in India.
- (iv) Application for registration of trademark is underway in India
- (v) That the trademark is registered in any other jurisdiction

(d) Section 11(10) sets out an obligation on the Registrar of Trade Marks to protect a well-known trademark against marks which are identical and/or similar.

13. As seen from the aforesaid sections and in particular, Section



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11(6) of the Trademarks Act, 1999, it is clear that both the Registrar of Trademarks as well as the Court having competent jurisdiction can recognize a trademark as a well-known mark. The Trademarks Act does not prohibit this Court, which is a competent Court, from recognizing the plaintiff's trademark as well-known marks.

14. Rule 124 of the Trade Marks Rules of 2017, which empowers the trademark registry to grant recognition of a trademark as a well-known mark, also makes it clear that once the Court passes an order recognizing a trademark as a well-known mark, trademark registry will have to give due consideration to the said recognition, while adjudicating as to whether the applicant is entitled to be granted the recognition of its trademark as a well-known mark. As seen from Section 11(6) of the Act, for adjudicating whether a trademark is a well-known mark or not, the following 10 factors will have to be considered:-

- (i) The extent of knowledge of the mark vis-à-vis the relevant public segment;
- (ii) Duration of use;
- (iii) Extent of product and services to which the mark is being used;
- (iv) Method, frequency and duration of advertising and promotion



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of the mark;

- (v) Geographical extent of trading area where the mark is being used
- (vi) Registration of the mark;
- (vii) Volume of goods and services being sold under the mark;
- (viii) Nature and extent of use of same or similar marks by other parties;
- (ix) Extent to which rights claimed in the mark have been successfully enforced; and
- (x) Actual number of consumers consuming goods or availing services under the brand.

15. In the case of the plaintiff, the trademark “ROYAL ENFIELD” has satisfied all the tests required for granting recognition as a well-known mark. The exhibits marked on the side of the plaintiff make it clear that in respect of the motorcycle industry, their trademark “ROYAL ENFIELD” is well-known, not only in India, but also in abroad. They have commenced their business in the year 1955 and over a period, they have established 187 exclusive stores in 22 countries and have over 1000 dealers/retainers around the world. Their annual reports also prove that their turnover runs into several hundreds of crores of rupees and they have carved a niche for themselves in the motorcycle industry. Judicial



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notice can also be taken with regard to the said fact. Ten-factors tests highlighted supra are also satisfied by the plaintiff for recognizing their trademark as a well-known mark as per the provisions of Section 11(6) of the Act.

16. The name “ROYAL ENFIELD” is synonymous to the plaintiff and the plaintiff is therefore entitled to the highest level of protection as the public at large associate the name “ROYAL ENFIELD” only with the plaintiff. Therefore, the plaintiff's trademark falls within the definition of well-known mark within the meaning of Section 2(1)(zg) of the Act and deserves protection, that is conferred to well-known marks under the Trade Marks Act.

17. The judgments relied upon by the learned counsel for the plaintiff during the course of his submissions also throw light on the circumstances when a trademark can be recognized as a well-known mark under Section 11(6) of the Act. In all those judgments, the respective High Courts have recognized the trademark involved in those cases as a well-known mark under Section 11(6) of the Act. The plaint



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averments, oral and documentary evidence placed on record make it clear

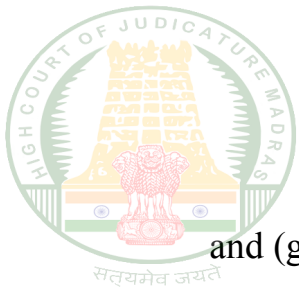
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that the plaintiff's trademark "ROYAL ENFIELD" and its variants are well-known marks in the motorcycle industry. Hence, the plaintiff is entitled to get recognition by this Court for its trademark "ROYAL ENFIELD" as a well-known mark in respect of the motorcycle industry. Accordingly, issue (b) is answered in favour of the plaintiff by declaring that the trademark "ROYAL ENFIELD" is a well-known mark in the motorcycle industry as per the provisions of Section 11(6) read with Section 2(1)(zg) of the Act.

Issue (c):-

(c) Whether the plaintiff is entitled for damages, surrender of infringed materials and rendition of accounts by the defendant as sought for in prayer (d), (e) and (g) of the plaint?

18. The learned counsel on record for the plaintiff has made an endorsement in the plaint on instructions that the plaintiff is not pressing the relief as sought for in the prayer (d), (e) and (g) of the plaint. Hence, there is no necessity for this Court to adjudicate with regard to prayer (d), (e) and (g) of the plaint. Hence, the suit claim insofar as prayer (d), (e)



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and (g) of the plaint has to be dismissed as not pressed.

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Issue (d):-

Whether the use of the word “ROYAL ENFIELD” by the defendant would amount to infringing and passing off of the plaintiff's trademark?

19. As could be seen from the materials available on record, on receiving the information about the defendant's unauthorized use of the mark “ROYAL ENFIELD”, the plaintiff had sent its Area Sales-Manager for inspection, who, upon such inspection, demanded the defendant to refrain from using the plaintiff's registered trademark “ROYAL ENFIELD”, and the similar getup, layout, look and feel of the interiors of its authorized outlets to portray themselves as the authorized dealer of the plaintiff. However, without removing the signage and changing the getup and layout of its service center, even now, the defendant has been using the same trade name “ROYAL ENFIELD” for its outlet. As observed earlier, the plaintiff is having registration for its trademark “ROYAL ENFIELD” and its variants in different Classes under the Trade Marks Act. They have been using their trademark “ROYAL



ENFIELD” ever since 1994.

WEB COPY 20. A comparison of the plaintiff's outlet(Ex.P32) and the defendant's outlet (Ex.P33) submitted at a above distance is shown below;

Plaintiff's authorized outlet:-



Defendant's outlet:-

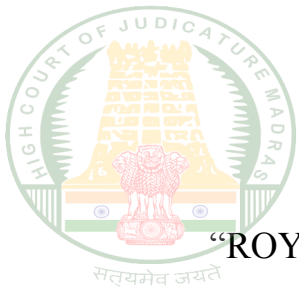




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would amply depict that the defendant has not only blatantly copied the essential features of the plaintiff's authorized outlets, but has also unauthorizably used the plaintiff's registered trademark "ROYAL ENFIELD" to market its service center. Apart from this, exterior of the plaintiff's outlets has ROYAL ENFIELD written in red lettering on a dark grey background with golden yellow lines on either side; and the frontage of the outlet consists of a deceptively similar glass paneling as that of the plaintiff's outlet. Therefore, the defendant selling its products by using such a deceptively similar/identical trade mark and thereby creating confusion and deception in the minds of the general public, would amount to infringement of the plaintiff's registered trademark "ROYAL ENFIELD".

21. Further, based on the oral and documentary evidence available on record, it is clear that only with a dishonest intention of making undue profits by using the trademark "ROYAL ENFIELD", which belongs exclusively to the plaintiff, the defendant has been using the mark "ROYAL ENFIELD". Both the plaintiff and the defendant are in the same area of business. If the defendant is allowed to use the mark



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“ROYAL ENFIELD”, it will certainly cause confusion in the minds of

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the public, who are familiar only with the usage of name “ROYAL ENFIELD” for motorcycle industry by the plaintiff alone and no one else. Being a deceptively similar mark to that of the plaintiff, the defendant should be permanently enjoined from using the name “ROYAL ENFIELD” for its outlet business. The defendant has not only infringed the plaintiff's trademark, but also committed an act of passing off on account of the fact that the public will be deceived as they will be under the impression that “ROYAL ENFIELD” is also an outlet run by the plaintiff, which, in reality, is not true. Therefore, permanent injunction reliefs sought for by the plaintiff in the suit as found in prayer (a), (b) and (c) of the plaint have to be granted by this Court. Accordingly, issue (d) is answered in favour of the plaintiff.

22. In view of infringement and passing off committed by the defendant, the defendant will have to pay for the costs of this suit.

23. For the foregoing reasons, this suit is partly decreed by granting the following reliefs:-



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(a) It is declared that the mark “ROYAL ENFIELD” is a well-

known trademark insofar motorcycle industry is concerned as per the provisions of Section 2(1)(zg) read with Section 11 of the Trade Marks Act, 1999. Consequently, Registrar of Trademarks is directed to notify the mark “ROYAL ENFIELD” on the register of well-known marks.

(b) Permanent injunction is granted restraining the defendant from infringing the registered trademark “ROYAL ENFIELD” by use of an identical mark “ROYAL ENFIELD” or any other mark identical and deceptively similar thereto in respect of any goods or services or in any other manner whatsoever.

(c) Permanent injunction is granted restraining the defendant from in any manner using, selling, offering for sale, advertising its services and products or otherwise dealing with the trademark ROYAL ENFIELD, singularly or in combination with any other word and/or deceptively similar thereto and thereby passing off their products, services and business as and for the products, services and business of the Plaintiff or in any other manner whatsoever;

(d) Permanent injunction is granted restraining the defendant from in any manner replicating the look and feel, and the exterior and interior



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of the Plaintiff's authorized outlets, and thereby passing off their services/business by use of color scheme, getup, arrangement of features and layout deceptively similar to the Plaintiff's authorized outlets.

(e) Insofar as prayer (d), (e) and (g) sought for in the plaint is concerned, the same is dismissed as not pressed.

(f) The defendant is directed to pay the costs of this suit.

22.11.2023

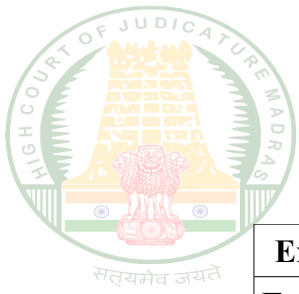
Index: Yes/no
Speaking order/non-speaking
Neutral citation : Yes/no
rkm

Plaintiff's witness:

Mr.Tapaswi Kumar Gupta - PW1

Documents exhibited by the Plaintiff:

Ex.No.	Description and nature of documents
Ex.P1	Power of Attorney
Ex.P2	Copy of registration certificate of trademark ROYAL ENFIELD (WORD MARK) under no. 657319 along with copy of Trademarks Journal. (photocopy)

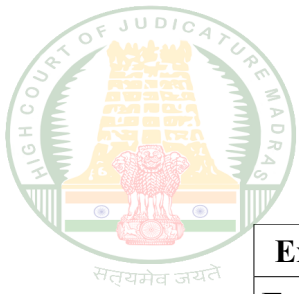


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Ex.No.	Description and nature of documents
Ex.P3	Copy of registration certificate of trademark ROYAL ENFIELD THUNDER BIRD (WORD MARK) under no. 1035163 along with copy of Trademarks Journal. (photocopy)
Ex.P4	Copy of registration certificate of trademark ROYAL ENFIELD CAFE RACER (WORD MARK) under no. 1095489 along with copy of Trademarks Journal. (photocopy)
Ex.P5	Copy of registration certificate of trademark ROYAL ENFIELD CLUBMAN (WORD MARK) under no. 1095490 along with copy of Trademarks Journal. (photocopy)
Ex.P6	Copy of registration certificate of trademark ROYAL ENFIELD METEOR (WORD MARK) under no. 1095491 along with copy of Trademarks Journal. (photocopy)
Ex.P7	Copy of registration certificate of trademark ROYAL ENFIELD TRAIL (WORD MARK) under no. 1095492 along with copy of Trademarks Journal. (photocopy)
Ex.P8	Copy of registration certificate of trademark Royal Enfield Label under no. 1107889 along with copy of Trademarks Journal. (photocopy)
Ex.P9	Copy of registration certificate of trademark ROYAL ENFIELD CLASSIC (WORD MARK) under no. 1788966 along with copy of Trademarks Journal. (photocopy)
Ex.P10	Copy of registration certificate of trademark ROYAL ENFIELD TRIP (WORD MARK) under no. 1884955 along with copy of Trademarks Journal. (photocopy)
Ex.P11	Copy of registration certificate of trademark ROYAL ENFIELD THUNDERBIRD 'LOGOUT' (WORD MARK) under no. 1884957 along with copy of Trademarks Journal. (photocopy)
Ex.P12	Copy of registration certificate of trademark ROYAL ENFIELD 'LOGOUT' (WORD MARK) under no. 1884958 along with copy of Trademarks Journal. (photocopy)

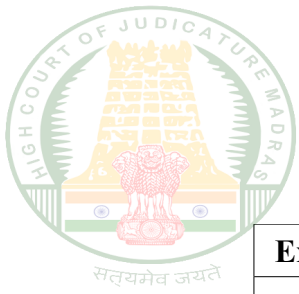


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Ex.No.	Description and nature of documents
Ex.P13	Copy of registration certificate of trademark ROYAL ENFIELD CRUZR (WORD MARK) under no. 1986869 along with copy of Trademarks Journal. (photocopy)
Ex.P14	Copy of registration certificate of trademark ROYAL ENFIELD TOURER (WORD MARK) under no. 1986870 along with copy of Trademarks Journal. (photocopy)
Ex.P15	Copy of registration certificate of trademark ROYAL ENFIELD HIMALAYAN TOURER (WORD MARK) under no. 1986871 along with copy of Trademarks Journal. (photocopy)
Ex.P16	Copy of registration certificate of trademark ROYAL ENFIELD CONTINENTAL GT WORD PER SE under no. 2347096 along with copy of Trademarks Journal. (photocopy)
Ex.P17	Copy of registration certificate of trademark ROYAL ENFIELD Logo under no. 2893335 along with copy of Trademarks Journal. (photocopy)
Ex.P18	Copy of registration certificate of trademark Royal Enfield Himalayan Sleet under no. 3734184 along with copy of Trademarks Journal. (photocopy)
Ex.P19	Copy of registration certificate of trademark ROYAL ENFIELD HUNTER (WORD) under no. 4353491 along with copy of Trademarks Journal. (photocopy)
Ex.P20	Copy of registration certificate of trademark ROYAL ENFIELD ROADSTER (WORD) under no. 4426653 along with copy of Trademarks Journal. (photocopy)
Ex.P21	Copy of registration certificate of trademark ROYAL ENFIELD MADE LIKE A GUN under no. 5129738 along with copy of Trademarks Journal. (photocopy)
Ex.P22	Copy of registration certificate of trademark R WITH WING DEVICE under no. 5129739 along with copy of Trademarks Journal. (photocopy)
Ex.P23	Copy of registration certificate of trademark ROYAL ENFIELD WITH R AND WING DEVICE under no. 5129740 along with copy of Trademarks Journal.



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Ex.No.	Description and nature of documents
	(photocopy)
Ex.P24	Copy of registration certificate of trademark ROYAL ENFIELD WITH R AND WING DEVICE under no. 5129741 along with copy of Trademarks Journal. (photocopy)
Ex.P25	Copy of registration certificate of trademark ROYAL ENFIELD MADE LIKE A GUN under no. 5129742 along with copy of Trademarks Journal. (photocopy)
Ex.P26	Copy of registration certificate of trademark ROYAL ENFIELD CONSTELLATION under no. 5323674 along with copy of Trademarks Journal. (photocopy)
Ex.P27	List of International registrations obtained by the Plaintiff for the mark ROYAL ENFIELD (Printout)
Ex.P28	Invoices for sale of motorbikes by the Plaintiff (Photocopy)
Ex.P29	Certificate of sales and Sales promotional expenses for the mark ROYAL ENFIELD (Photocopy)
Ex.P30	Advertisements and promotional materials issued by the Plaintiff for the mark ROYAL ENFIELD (Photocopy)
Ex.P31	Awards and Recognitions granted to the Plaintiff for the mark ROYAL ENFIELD (Photocopy)
Ex.P32	Plaintiff's ROYAL ENFIELD logo and photographs of the service centre (Photocopy)
Ex.P33	Defendant's service outlet photographs

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ABDUL QUDDHOSE, J.

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