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

+ CS(COMM) 738/2018

DEERE & COMPANY & ANR
Through

..... Plaintiffs
Mr. Pravin Anand with
Ms. Vaishali Mittal,
Mr. Siddhant Chamola and
Ms. Vrinda Gambhir,
Advocates

versus

MR. MALKIT SINGH & ORS
Through

..... Defendants
Mr. J. Sai Deepak with Mr Rohit
Mittal and Mr Avinash K. Sharma,
Advocates

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Date of Decision: 23rd April, 2018

**CORAM:
HON'BLE MR. JUSTICE MANMOHAN**

J U D G M E N T

MANMOHAN, J: (Oral)

I.A. 3692/2018

1. Despite the matter being vehemently argued by learned counsel for plaintiffs on 16th March, 2018, this Court did not pass an ex-parte injunction order, but a short notice was issued as it was of the view that an injunction would have very serious consequences and the defendants should be given one opportunity to plead their case. Consequently, this Court while issuing




notice had directed the Registry to specifically state that the matter would be taken up for hearing on the date fixed and no adjournment would be granted.



2. Today, Mr. J. Sai Deepak, learned counsel for the defendants prays for adjournment by a week to place on record the written statement.


3. In view of the specific direction and the pre-emptory order passed by this Court, the prayer for adjournment is declined and the matter is taken up for hearing.

4. It is pertinent to mention that the present suit has been filed for permanent injunction restraining infringement and dilution of trademark, passing off of trade dress, unfair competition, rendition of accounts, delivery up, damages etc.


5. In the plaint, it is stated that the plaintiffs are leading manufacturers and exporters of agricultural vehicles including tractors, harvesters etc. as well as their spare parts under the trademark JOHN DEERE. It is further stated that the products of the plaintiffs are easily identifiable by their distinct share of green paint, augmented by yellow strip. It is stated in the plaint that the plaintiff no.1 company was established in the year 1837 and is a company existing under the laws of the state of Delaware, USA and the plaintiff no.2 is the wholly owned subsidiary of plaintiff no.1.

6. It is stated in the plaint that the plaintiffs' 'leaping deer' logo  comprises an image of a yellow deer in conjunction with the trademark 'John Deere'. It is further stated that in the year 1910, the plaintiffs started making use of a particular combination of the Green  and Yellow  colours for its agricultural implements in a distinctive manner and the same was also adopted for tractors in the year 1918. It is further stated that the Green and Yellow color combination has become so

synonymous with the plaintiffs that the particular shades of Green and Yellow, i.e.  is commonly referred to as John Deere Green and John Deere Yellow and the  logo and the Green and Yellow color combination used by the plaintiffs have collectively been termed as the JOHN DEERE marks.

7. It is averred in the plaint that the plaintiffs have a pan-India presence through its 18 area offices, 4 divisional offices and more than 400 authorized dealers spread across the country. It is stated in the plaint that the plaintiffs have secured registrations for a number of its JOHN DEERE trademarks, including the  trademark, under various classes, including Classes 7, 12 and 28 under the Trademarks Act, 1999.

8. It is the case of the plaintiffs' that the expenditure incurred by the plaintiffs on advertising and promotion in the financial year 2016-2017 was INR 2170.65 million and the annual revenue generated by the plaintiffs in the said year was INR 46769.14 million.

9. Learned counsel for the plaintiffs states that in the last week of October 2017, it came to the plaintiffs' knowledge that the defendants were manufacturing, selling, exporting and advertising infringing products under the mark MALKIT by using an identical colour combination as that of the plaintiffs. Subsequently, the plaintiffs addressed a cease and desist letter dated 25th October, 2017 advising the defendants to stop the use of the impugned trademark and trade dress. He states that the defendants, in response to the cease and desist letter, addressed a letter dated 11th  ember, 2017 emphasising their rights in its Green and Yellow mark.

10. Learned counsel for the plaintiffs further states due to the continued violation of the plaintiffs' rights in its JOHN DEERE trademarks, the

plaintiffs conducted an investigation into the activities of the defendants and the said investigation revealed that the defendants were engaged in the manufacture, supply, export and sale of infringing tractors and agricultural equipment like Combine Harvesters, Rice Transplanter, Thresher, Straw Reaper, Mini Harvester etc. with an average production of 350 harvesters a year.

11. Learned counsel for the plaintiffs states that the investigation further revealed that the defendants provide their services in various States with authorised dealers in Uttaranchal, Madhya Pradesh, Andhra Pradesh and Uttar Pradesh and also cater to consumers in New Delhi.

12. A pictorial representation of the plaintiffs and defendants product is reproduced hereinbelow:


Plaintiffs Product




Defendants Product



13. Learned counsel for the plaintiffs states that the defendants also advertise their products through their websites www.malkitcombines.com, www.combineharvester.co.in and www.malkitnabha.onlineindia.org and on third party online portals such as www.justdial.com, www.facebook.com etc. He states that the defendants operate through email ids being malkitcombine@yahoo.com and www.superindiatimes@gmail.com, which also allow potential customers to request for products.

14. Learned counsel of the plaintiffs states that the defendants' activities clearly evidence their intention to ride upon the reputation and established goodwill of the plaintiffs' products under the JOHN DEERE marks. He states that the defendants have adopted and use identical trade dress, wherein the colour scheme, getup, layout, manner of placement of various parts of the equipment is identical to the trade dress of the plaintiffs JOHN DEERE products and its Green and Yellow  colour combination and the same is bound to create a false impression in the minds of unwary consumers and members of the trade that, the defendants are somehow associated with the plaintiffs' business and that the defendants have been specifically authorized to provide their goods and products under the John Deere trademarks by the plaintiffs themselves.

15. Learned counsel for plaintiffs lastly states that a Coordinate Bench of this Court in *Deere & Co. & Anr. v. S. Harcharan Singh & Ors.*, being CS (OS) 3764/2014, vide order dated 05th March, 2015 has also recognized the immense goodwill and reputation vested in the plaintiffs' said marks and has held such marks to be well-known trademarks as defined under Section 2(1)(zg) of the Trade Marks Act, 1999. According to him, this Court has held that the JOHN DEERE trademarks including the  Green and Yellow color mark have become so significant and synonymous with the plaintiffs, that the use of these trademarks by any other entity in India will be construed by members of the general public, as having emanated from the plaintiffs instead.

16. Mr. J. Sai Deepak, learned counsel for defendants states that the defendants to the knowledge of the plaintiffs have been using the impugned colour scheme for Combine HARVESTER at least since 2008 and the

impugned colour scheme has been used by the predecessor of the defendant no. 6 since 1988.

17. He further states that the Ministry of Agriculture took products of both the parties for testing purposes in 2015 and therefore the plaintiffs are deemed to have been aware of the defendants' use of the impugned colour combination since 2015.

18. In rejoinder, Mr. Pravin Anand, learned counsel for the plaintiffs states that the defences now sought to be urged are an afterthought and contrary to the defendants' own reply to the cease and desist notice. He points out that in the reply to the cease and desist notice the defendants had taken the stand that the colour combination being used by them was totally different from the plaintiffs' colour combination. He points out that in the said notice the defendants had asserted monopolistic copyright in the colour combination.

19. Having heard learned counsel for the parties, this Court is of the view that it is essential to outline the relevant provisions of the Trade Marks Act, 1999. The relevant sections are reproduced hereinbelow:-

- (i) Section 2(1)(m) states, *“a “mark” includes a device, brand, heading, label, ticket, name, signature, word, letters, numeral, shape of goods, packaging or combination of colours or any combination thereof.*
- (ii) Section 2(1)(zb) states, *“a “trade mark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and.....”*
- (iii) Section 28 states, *“Rights conferred by registration –(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if*

valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act....”(emphasis supplied).

(iv) Section 29 states, “*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 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 trademark 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.

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(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising---

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

20. Keeping in view the aforesaid, it is apparent that in India, the definition of trade mark under Trade Marks Act, 1999, include combination of colours. However, in order to constitute a trade mark, a colour or combination of colours must be capable of distinguishing the goods or services of one trader from those of other traders.

21. In the instant case, the plaintiffs have secured registrations for  i.e. a trade mark comprising a colour combination of green and yellow. This Court is of the prima facie opinion that plaintiffs are entitled to sole and exclusive use of this trade mark comprising such colour combination as well as the right to claim an injunction in respect of infringement of rights.

22. The unrebutted case as of today is that the plaintiffs had used the green and yellow colour combination over agricultural products for the first time in 1910. By 1918, this combination was used on tractors and has been used ever since. The manner of use is very peculiar and unique to the plaintiffs i.e. Green colour for the body and yellow colour for the seat and the wheels/rims. As on date, this colour combination has been used for 100 years. Consequently, the colour combination of green and yellow in relation to agricultural equipment is associated solely with the plaintiffs. The plaintiffs' goodwill in the agricultural industry is substantial as is apparent


from the fact that the plaintiffs are the largest exporter of tractors from India. Consequently, in the prima facie opinion of this Court, Section 29(1) of the Trade Marks Act, 1999 is attracted, as the use of the colour combination of green and yellow by the defendants, in conjunction with other elements, is liable to be taken as use in the sense of a trademark, especially when the defendants claim that it helps set apart their products.

23. Section 29(2) of the Trade Marks Act, 1999 is also prima facie attracted as the defendants have used an identical colour combination in relation to identical products to that of the plaintiffs, i.e. agricultural vehicles as well as in the same manner as that of the plaintiffs i.e. Green colour for the body and Yellow colour for Wheels and Seat and such use is likely to cause confusion amongst members of the public.

24. Further, this Court is of the prima facie view that the plaintiffs' Green and Yellow colour combination is reputable, distinctive and stands as an instant source-identifier for the plaintiffs' agricultural products. Also, the defendants' adoption of an identical colour combination, its use in the same manner as that of the plaintiffs and its denial of the plaintiffs' rights in the said colour combination in its reply to legal notice dated 11th November, 2017 prima facie amounts to unfair advantage and constitutes behaviour which is contrary to honest and industrial practices. Consequently, the defendants' action, in addition, prima facie amounts to infringement of trade mark in accordance with Section 29(8) of the Trade Marks Act, 1999.

25. Keeping in view the aforesaid, this Court is of the opinion that a *prima facie* case of infringement and passing off is made out in favour of the plaintiffs and balance of convenience is also in their favour. Further, irreparable harm or injury would be caused to the plaintiffs if an interim

injunction order is not passed.

26. Consequently, till further orders, the defendants, their partners or proprietors, principal officers, servants, agents and distributors and all others acting on their behalf as the case may be, are restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in any manner with Combine Harvesters, Rice Transplanter, Thresher, Straw Reaper, Mini Harvester, other agricultural products and/or any other goods and/or services using the plaintiffs' trademark including trade dress comprising the  Green and Yellow colour combination and any other mark deceptively similar thereto, in any manner whatsoever.

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Learned counsel for the defendants prays for and is permitted to file a written statement to the plaint as well as a reply to the injunction application within three weeks.

Replication/rejoinder, if any, be filed before the next date of hearing.

List before the Joint Registrar on 21st May, 2018 for completion of pleadings and admission/denial of documents.

List before Court on 30th July, 2018 for disposal of I.A.3692/2018 as well as for framing of issues and for case management hearing.

MANMOHAN, J

APRIL 23, 2018

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