

\$~

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

% *Date of Decision: 29th March, 2023*

+ CS(COMM) 189/2017

CENTRAL PARK ESTATES PVT. LTD.
& ORS.

..... Plaintiffs

Through: Mr. Peeyoosh Kalra and
Mr. Rohan J. Kapoor, Advocates.

versus

SAMVARA BUILDTECH
PRIVATE LIMITED & ANR.

..... Defendants

Through: Mr. Jayant Mehta, Senior
Advocate with Mr. Shantanu Malik,
Mr. Jaskaran Singh Narula, Ms. Isha Dhanda
and Mr. Srikar P.D.V., Advocates.

CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH

JUDGEMENT

JYOTI SINGH, J.

I.A. 3107/2017 (under Section 135(2) Trade Marks Act, 1999 r/w
Order 39 Rules 1 and 2 CPC, by Plaintiffs) **and I.A. 6778/2017** (under
Order 39 Rule 4 CPC, by Defendants)

1. This judgment shall dispose of the aforementioned applications, one filed by the Plaintiffs under Section 135(2) of Trade Marks Act, 1999 (hereinafter referred to as the 'Act') read with Order 39 Rules 1 and 2, CPC and the other by the Defendants under Order 39 Rule 4, CPC for vacation of *ex parte ad interim* injunction granted vide order dated 10.03.2017.

2. The suit, in which the present applications have been filed, is for permanent injunction restraining the Defendants *inter alia* from infringing Plaintiffs' registered trademark 'CENTRAL PARK' or its


variants as well as from constructing, developing, marketing etc. any housing or real estate projects under the impugned trademarks or any other trademark which incorporates or contains any reference to the registered trademarks of Plaintiff No. 1.

3. Factual matrix emerging from the plaint is that Plaintiffs No. 1 to 4 are Companies with common Directors and are part of the same Group of Companies, incorporated under the Companies Act, 1956. Plaintiffs are one of the most reputed real estate developers in the



country who adopted the registered trademark years ago on 21.03.2015. Currently, Plaintiff No. 1 is the registered proprietor of 11 such registered trademarks with the words 'CENTRAL PARK' as their prominent and leading feature.

4. It is stated that Plaintiffs enjoy unparalleled goodwill and reputation as real estate developers and have been instrumental in developing land and constructing premier residential apartments, hospitality projects, five-star hotels with projects and production units in various parts of the country and can boast of an audited annual turnover of Rs.1,784 crores in the Financial Year 2015-16 alone. Each of these projects have been undertaken under the umbrella trademark/housemark CENTRAL PARK. It is averred that apart from common law rights which the Plaintiffs enjoy by prior adoption and use, Plaintiff No. 1 in order to secure statutory rights in the word mark CENTRAL PARK and its derivatives/formatives has obtained registrations, which are valid and subsisting and the list is as follows:-

S. No.	Mark	Class	Appl. No.	Date of Appl.	Status
1.		37	1346017	21.03.2005	Registered

2.	 <i>Central Park</i>	36	1346018	21.03.2005	Registered
3.	CENTRAL PARK RESORTS	37	2095018	04.02.2011	Registered
4.	CENTRAL PARK RESORTS	43	2095019	04.02.2011	Registered
5.	CENTRAL PARK RESORTS & RESIDENCE	37	2095025	04.02.2011	Registered
6.	THE RESORTS - CENTRAL PARK	37	2102851	21.02.2011	Registered
7.	CENTRAL PARK RESORT RESIDENCES	37	2148074	23.05.2011	Registered
8.	CENTRAL PARK RESORT RESIDENCES	43	2148079	23.05.2011	Registered
9.	 <i>Central Park</i> ...expect the world...	36	2642272	13.12.2013	Registered
10.	 <i>Central Park</i> ...expect the world...	37	2642273	13.12.2013	Registered
11.	 <i>Central Park</i>	43	3100341	18.11.2015	Registered

5. It is further stated that some of the projects of the Plaintiffs are internationally recognized and renowned. One of their projects namely, Central Park-II at Gurugram was executed under the guidance and technical supervision of world's largest architectural and engineering Firm, HOK International Limited, which has the singular distinction of planning the Dubai Marina. Various National publications such as Times Property as well as other print and digital media have covered the projects of the Plaintiffs and the popular channel Zee News, included the CENTRAL PARK-II project in its list of Top-9 high-end real estate complexes in India. Plaintiff No. 1 is also the recipient of the Award for the 'Best Residential Project in NCR under Luxury Segment category'.

6. It is further averred that the annual turnover of the Plaintiffs from their projects, as mentioned in the plaint, is an excellent indicator of the popularity and reputation of the mark CENTRAL PARK. Total revenue collection of the Plaintiffs and their licensees from booking and sale of properties under the project CENTRAL PARK-I was to the tune of Rs.189.42 crores and was Rs.1922.44 crores under the project CENTRAL PARK-II, till the date of filing the suit. The total estimated sale value of project CENTRAL PARK-II is approximately Rs.3,900 crores. The advertising expenses of the various projects run into several hundred crores, which is a pointer to the goodwill and success of the Plaintiffs' trademarks, of which CENTRAL PARK is the essential part.

7. It is stated that Plaintiffs have been extremely vigilant in prosecuting their intellectual property rights and have filed infringement/passing off cases against third parties whenever there was an attempt to infringe the Plaintiffs' trademarks or tarnish their goodwill by passing off the goods/services. Details of various Court cases have been furnished by the Plaintiffs in the plaint.

8. The cause of action to file the present suit, according to the Plaintiffs, arose in the third week of February, 2017, when one of the representatives of the Plaintiffs, while surfing the internet came across Defendants' group websites namely www.palava.in/central-park and www.lodhagroup.com, wherein Defendants had boldly and openly advertised their real estate project under the impugned infringing

trademark **Central Park**.

9. On 10.03.2017, this Court passed an *ex-parte ad interim* order restraining the Defendants and their Directors etc. from using CENTRAL PARK as a mark for any of their activities. Upon service

of summons, Defendants filed the written statement and an application under Order 39 Rule 4 CPC seeking vacation of the *ex-parte* injunction order.

10. Arguing in support of the application for vacation of the interim injunction, it was contended on behalf of the Defendants that:-

- (A) Plaintiffs have failed to disclose that in relation to the mark CENTRAL PARK, Plaintiffs have asserted before the Trade Marks Registry, on several occasions, that they do not claim exclusivity/monopoly over the word mark and the label marks must be seen as a whole. In response to the examination reports of the Trade Marks Registry, wherein marks of the third parties such as CENTRAL PARK in Class 42 and CENTRAL PARK-17 (device) in Class 43 were cited, Plaintiffs have stated that the cited marks were different conceptually, structurally and visually since the marks have to be seen as a whole, without dissection and relied on the judgment of this Court in *United Biotech Pvt. Ltd. v. Orchid Chemicals & Pharmaceuticals Ltd. & Ors., 2012 SCC OnLine Del 2942*. Therefore, Plaintiffs are estopped from claiming monopoly over the word mark CENTRAL PARK and/or seeking a restraint against the Defendants in respect thereof. It is trite that a proprietor cannot take inconsistent stands before the Trade Marks Registry and the Courts and on this ground alone injunctions have been refused by the Courts in several matters. Reliance was placed on the judgments in *S.K. Sachdeva and Another v. Shri Educare Limited and Another, 2016 SCC OnLine Del 6708*, *Mankind Pharma Ltd. v. Chandra Mani Tiwari & Anr., 2018 SCC OnLine Del 9678*, *Poly Medicure Limited v. Polybond India Pvt. Ltd., 2019 SCC OnLine Del 11967* and *Teleecare Network*

India Pvt. Ltd. v. Asus Technology Pvt. Ltd. and Others, 2019 SCC OnLine Del 8739.

- (B) The words 'CENTRAL PARK' are not used by the Defendants as a trademark/mark and they serve as mere indicators of the geographical layout and description of the project. Usage of 'CENTRAL PARK' is not standalone but along with the trademarks of the Defendants and purely in a descriptive sense as 'Palava Central Park or 'Lodha Palava Central Park' or 'Central Park Palava's Most Premium and Green Neighbourhood' and not as a source identifier, which is the function of a trademark.
- (C) Defendants belong to the Lodha Group, which is in the business of real estate development for over 35 years and are currently developing excess of 41 million sq. ft. real estate properties with over 40 projects in Mumbai, Pune, Thane, Hyderabad and two in London. The Group has recently acquired the iconic McDonalds House in London for 500 million dollars besides other prestigious acquisitions such as Washington House on Altamont Road. Defendants have tie ups with various brands, both in India and overseas, to execute their projects such as Armani, Larsen and Toubro, Jade Jagger etc. The annual sale for the Financial Year 2014-15 was Rs.6304 crores, for Financial Year 2015-16 was Rs.6430 crores and for Financial Year 2016-17 was Rs.6924 crores, when the written statement was filed. It is thus evident that Defendants have a huge brand image, formidable and immense goodwill and reputation of their own and do not need to derive any mileage or exploit the goodwill and reputation of the Plaintiffs by using 'CENTRAL PARK' as a Trademark, as alleged by the Plaintiffs.

- (D) Plaintiffs have wrongly averred and claimed that Defendants have adopted and imitated the mark of the Plaintiffs, while not disclosing that Plaintiffs have registration only in the label marks and not in CENTRAL PARK/Central Park word marks *per se*. Plaintiffs have, in fact, never applied for registration of the word mark and therefore, cannot seek indirectly what they cannot seek or be granted directly. It is trite that registration of a label mark does not give exclusivity of use over any word(s) contained therein. Reliance is placed on the judgment of the Supreme Court in ***Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd., AIR 1955 SC 558*** and on the judgment of this Court in ***Vardhman Buildtech Pvt. Ltd. & Ors. v. Vardhman Properties Ltd., 2016 SCC OnLine Del 4738***.
- (E) The expression 'CENTRAL PARK' is comprised of 2 separate words in English language and are generic or at best descriptive and cannot be monopolized and perhaps for this reason, till date Plaintiffs have not even applied for registration of the word mark, without any suffix or prefix. As per the settled law, generic words are given the lowest protection. Reliance was placed on ***India Habitat Centre v. Sunita Aeren and Ors., MANU/DE/0830/2008; Living Media India Ltd. and Anr. v. Alpha Dealcom Pvt. Ltd. & Ors., 2014 SCC OnLine Del 768*** and ***Ultratech Cement Limited and Another v. Dalmia Cement Bharat Limited, 2016 SCC OnLine Bom 3574***.
- (F) Section 17(2) of the Act clearly and unambiguously provides that when a trademark contains any part, which is not the subject matter of a separate application by the proprietor, for registration as a trademark or contains any matter which is common to trade or otherwise of non-distinctive character,

registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trademark so registered. On all counts, Plaintiffs fail and cannot claim monopoly on the mark CENTRAL PARK, which is common to trade, generic and inherently non-distinctive and not registered separately as a trademark in favour of the Plaintiffs. There are several builders who use the mark CENTRAL PARK in a descriptive manner in relation to their buildings or housing projects as the expression merely denotes a park located centrally within a defined area. As per information available with Defendants, some of the projects under the mark CENTRAL PARK are NITESH CENTRAL PARK by Nitesh Estates, CENTRAL PARK by the Proviso Group in Navi Mumbai, DARSHANAM CENTRAL PARK VADODRA by Crisil Real Estate, CENTRAL PARK, a theme park, a project undertaken by Navi Mumbai Municipal Corporation (NMMC) in Savali Village, Ghansoli, CENTRAL PARK by Urban Constructions in Hyderabad, SANKALP CENTRAL PARK by Sankalp Group and THE CENTRAL PARK HOTEL, PUNE.

- (G) Word mark CENTRAL PARK is also common to the Register of Trade Marks. CENTRAL PARK is registered in Class 24 by Poonam Hotels Limited, bearing registration No. 405272 for linen, textile goods etc. It is also registered under registration No. 405273 by the same entity in Class 25 for uniforms and other readymade garments etc.
- (H) Plaintiffs have placed heavy reliance on the judgment of this Court in *Central Park Estates Pvt. Ltd. and Others v. Godrej Skyline Developers Private Limited and Another, 2019 SCC OnLine Del 11580*. The judgment cannot come to the aid of the

Plaintiffs, as firstly, being an order of interim injunction, it does not finally or conclusively adjudicate the issues on facts or law and cannot be treated as a precedent. Reliance was placed on the judgments of the Supreme Court in *State of Assam v. Barak Upatyaka D.U. Karmachari Sanstha*, (2009) 5 SCC 694 and *Ram Parshotam Mittal and Others v. Hotel Queen Road Private Limited and Others*, (2019) 20 SCC 326, in support of this proposition. Even otherwise, the judgment is distinguishable for various reasons. In the said judgment, Godrej had itself filed an application for registration of the device mark GODREJ CENTRAL PARK and thus, the Court observed that anyone who applies for registration of the mark cannot claim that it is generic or descriptive, which is not the case here. Unlike in the present case, Godrej had not cited large scale use of the mark by third parties to show that the mark was common to trade as also prior registrations of third parties. The judgment proceeds on the basis that Plaintiffs have a monopoly or exclusive rights over the words CENTRAL PARK which is incorrect, as no rights can be claimed over generic marks, more particularly, in the absence of their registrations and the stand of the Plaintiffs before the Trade Marks Registry.

11. Refuting the contentions raised on behalf of the Defendants, learned counsel representing the Plaintiffs contended as follows:-

(A) Plaintiffs are the registered proprietors of the label mark



and its variants and thus have a statutory right of exclusive use of the trademark in relation to the goods or services in respect of which the trademark is registered, as well as to obtain relief in respect of infringement of the

trademark in the manner provided by the Act, by virtue of provisions of Section 28(1) of the Act, besides common law rights. Defendants are using CENTRAL PARK, which is phonetically, structurally and visually identical with the mark of the Plaintiffs and since there is identity in the field of activity i.e. estate development and hospitality and the customer base is the same, confusion amongst unwary customers and/or association of the projects of the Defendants with the Plaintiffs is inevitable. Plaintiffs are reputed real estate developers with unparalleled goodwill and reputation in the real estate industry. Plaintiffs have been and are associated with projects with turnovers of crores of rupees, details of which are furnished in the plaint and have to their credit not only in India but also internationally, projects such as CENTRAL PARK-II at Gurugram, which has been covered by the print and electronic media as one of the Top 9 high-end estate complexes in India. Several awards and accolades have been earned by the Plaintiffs including the award of 'Best Residential Project in NCR under Luxury Segment category' in 2014, in Delhi. The financial statements reflecting the annual turnovers and the expenses incurred on publicity and advertisement in India and abroad are indicators of the unparalleled reputation of the Plaintiffs. The trademark of the Plaintiffs CENTRAL PARK has become distinctive and is exclusively associated with the Plaintiffs beyond geographical boundaries. Plaintiffs have successfully obtained interim orders in cases where third parties have attempted to infringe the trademark CENTRAL PARK, as detailed in the plaint. By using identical mark, Defendants are guilty of infringement under Section 29 of the Act.

- (B) Stand of the Defendants that they are not using the mark CENTRAL PARK as a trademark is false and incorrect. A bare perusal of the manner, in which the mark is used, shows that the words CENTRAL PARK have been prominently displayed so as to catch the eye of the intending customers and the intent is only to gain advantage from the goodwill and reputation of the mark generated by the Plaintiffs. Defendants have copied the leading and prominent feature of Plaintiffs' registered trademark in entirety. The project in question which triggered the filing of the suit is launched as 'Central Park Palava's most Premium and Green Neighbourhood' and this itself shows that Central Park is projected as a trademark, which gets pronounced by use of a thick and large font used for the words 'Central Park' on the cover page of the introductory brochure. While Plaintiffs have no objection to the Defendants using their trademarks Lodha and Palava for their real estate business but they cannot be permitted to use CENTRAL PARK. If it is Defendants' own pleaded case that they have a huge brand image under Lodha and Palava and do not need to encash upon the goodwill of the mark CENTRAL PARK, then it is not understood why there is insistence on continuing to use Plaintiffs' mark 'CENTRAL PARK'.
- (C) The stand of the Defendants that the mark CENTRAL PARK is generic, is baseless. Plaintiffs have adopted the mark more than a decade ago and only because some unscrupulous elements with an ill intent to exploit the goodwill of the Plaintiffs used the mark to gain advantage, cannot lead to a conclusion that the mark is generic. Moreover, this contention was raised by Godrej in the case of *Central Park Estates Pvt. Ltd. and Others*

(*supra*) and was negated by the Court.

(D) It is true that Plaintiffs do not have a separate registration in the word mark CENTRAL PARK *per se*, however, Plaintiffs have registrations in the label marks and its formatives, of which 'CENTRAL PARK' is the dominant/essential part. In *United Biotech Pvt. Ltd. (supra)*, the Division Bench of this Court has held that when a label mark is registered, it cannot be said that the word mark contained therein is not worthy of protection. In the said case, although the registered mark was a label mark, the word mark ORZID contained therein was held entitled to protection and reliance was in turn placed by the Division Bench on the judgment of the Supreme Court in *Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel and Others, (2006) 8 SCC 726*.

(E) Plaintiffs' case is entirely covered by the judgment in *Central Park Estates Pvt. Ltd. and Others (supra)*, where the Court has by a detailed judgment restrained the Defendants therein from using the infringing mark GODREJ CENTRAL PARK. In the said suit, Defendants had pleaded that the trademark of the Plaintiff i.e. CENTRAL PARK is descriptive and *publici juris* as well as common to trade and thus invalid under Sections 9 and 11 of the Act. It was also contended that the Defendants use their own name Godrej as a prefix to the dominant part of the mark. These defences were negated by the Court and none of the differences sought to be pointed out by the Defendants herein are enough to distinguish the said judgment. Defendants have sought to carve out an exception to the said judgement by portraying that Plaintiffs have pleaded before the Trade Marks Registry that they do not claim exclusivity in the word mark

CENTRAL PARK, which is wholly incorrect. Replies of the Plaintiffs to the examination reports cannot be read out of context. All that the Plaintiffs stated was that marks have to be read as a whole for comparison and cannot be dissected, but this cannot be read to imply that Plaintiffs had given up their claim to the essential part of their registered trademarks. Contention of the Defendants that non-registration of the word mark CENTRAL PARK *per se* disentitles the Plaintiffs to protection under Section 28(1) of the Act, is a misreading of various judgements holding to the contrary, wherein it is observed that a word mark, which is part of a registered label mark, is worthy of protection.

12. I have heard learned counsel for the Plaintiffs and learned Senior Counsel for the Defendants and given a thoughtful consideration to their respective contentions.

13. It is not in dispute that Plaintiff No. 1 is the registered



proprietor of the label mark and its formatives, as mentioned above. It is an admitted position that Plaintiff No.1 does not hold registration in 'CENTRAL PARK' word mark *per se*. Section 17 of the Act provides that where a trademark consists of several matters, its registration shall confer on the proprietor exclusive right to use of the trademark taken as a whole and shall not confer any exclusive right in the matter forming only a part of the whole of the trademark so registered. [*Ref. Ashok Chandra Rakhit Ltd. (supra)*]. In *Bhole Baba Milk Food Industries Ltd. v. Parul Food Specialities (P) Ltd., 2011 SCC OnLine Del 288*, the Division Bench of this Court held that a registered proprietor of a mark can assert a right of exclusivity only to what he gets registered as a whole and this

CS(COMM) 189/2017 Page 13 of 30

registration will not give an exclusive statutory right qua a particular word of common origin or generic in nature. This issue of exclusivity to a part of a mark which is registered as a whole, becomes pronounced where the proprietor himself asserts proprietary rights over the whole mark and expressly gives up his claim/right to part of the mark, on a realization that being generic and thus inherently non-distinctive, that part of the mark will not be separately registered.


14. In the present case, it is brought forth by the Defendants in their written statement that the Plaintiffs in their reply dated 18.04.2016 filed before the Registrar of Trade Marks, in response to an Examination Report dated 26.02.2015, wherein third party marks 'CENTRAL PARK' and CENTRAL PARK-17 were cited, had stated that the mark they were seeking to register must be read as a whole and not dissected into its constituent elements, for purpose of comparison. To support this plea reliance was placed on the judgment of this Court in *United Biotech Pvt. Ltd. (supra)*.

15. Court has perused the reply filed by the Plaintiffs in response to the Examination Report and finds the stand of the Defendants to be factually correct. Thus, the question that begs an answer is whether by adopting this position before the Trade Marks Registry, are the Plaintiffs estopped from claiming exclusivity on the word mark 'CENTRAL PARK' and the answer, in my view, is in the affirmative. This very legal issue came up for consideration before this Court in *Vasundhra Jewellers Pvt. Ltd. v. Kirat Vinodbhai Jadvani and Another, 2022 SCC OnLine Del 2996*, where the Plaintiff was the prior and registered proprietor of the 'VASUNDHRA' marks and the impugned marks/labels etc. were word marks 'VASUNDHRA FASHION/VASUNDHRA' and its formatives. Amongst other contentions, one of the objections of the Defendants to the grant of

interlocutory injunction was that the Plaintiff had in its reply to the Examination Report before the Trade Marks Registry, claimed that the device mark had to be seen as a whole and therefore, no confusion will be caused by the use of the word 'VASUNDHRA' as a part of the device mark.

16. The learned Single Judge observed that while considering the claim of exclusivity to the word 'VASUNDHRA', the claim made by the Plaintiff before the Registrar of Trade Marks, though may not act as an estoppel, but would be a relevant consideration and since the Plaintiff had sought to distinguish other cited marks 'VASUNDHRA' by contending that the mark has to be considered as a whole, Plaintiff cannot be allowed to approbate and reprobate. Pertinent it is to mention that against the said order declining the relief of injunction, Plaintiff filed an appeal before the Division Bench and the *prima facie* view of the learned Single Judge was upheld and the Division Bench in *Vasundhra Jewellers Pvt. Ltd. v. Kirat Vinodbhai Jadvani and Another, 2022 SCC OnLine Del 3370*, held as follows:-

“40. It is also relevant to note that the learned Single Judge had also noted that before the Registrar of Trademarks, the appellant had sought to distinguish other trademarks, which included the word 'Vasundhra', by claiming that the VASUNDHRA Trademarks were required to be considered as a whole. Thus, it is not open for the appellant now to take a contrary stand and claim that the device

mark "VASUNDHRA FASHION " is deceptively similar to the VASUNDHRA Trademarks on the ground that it includes the word 'Vasundhra'.

41. Plainly, if the appellant had sought an exclusive right to register the word mark 'VASUNDHRA' on a standalone basis, it would not be open for the appellant to claim that its marks were dissimilar to the marks cited by the Registrar of Trademarks on the aforesaid ground (that, its marks must be considered as a whole).

42. This Court is unable to accept that the appellant can now, by indirect means, secure the benefit of the registration for the word mark 'VASUNDHRA' after having secured the registration of its mark by claiming that it was not similar to other cited marks, which contain the word 'Vasundhra'."

17. In yet another decision in ***Raman Kwatra and Another v. KEI Industries Limited, 2023 SCC OnLine Del 38***, the Division Bench of this Court held that when a party obtains registration of a trademark based on certain representations and assertions before the Trade Marks Registry, it would be disentitled to any equitable relief by pleading to the contrary in the Court. Relevant part of the judgment is as follows:-

*“43. We also find merit in the appellant's contention that a party, that has obtained the registration of a trademark on the basis of certain representation and assertions made before the Trade Marks Registry, would be disentitled for any equitable relief by pleading to the contrary. The learned Single Judge had referred to the decision in the case of *Telecare Networks India Pvt. Ltd. v. Asus Technology Pvt. Ltd. (supra)* holding that after grant of registration neither the Examination Report nor the plaintiff's reply would be relevant. We are unable to agree with the said view. In that case, the Court had also reasoned that that there is no estoppel against statute. Clearly, there is no cavil with the said proposition; however, the said principle has no application in the facts of the present case. A party that has made an assertion that its mark is dissimilar to a cited mark and obtains a registration on the basis of that assertion, is not to be entitled to obtain an interim injunction against the proprietor of the cited mark, on the ground that the mark is deceptively similar. It is settled law that a person is not permitted to approbate and reprobate. A party making contrary assertions is not entitled to any equitable relief.*

44. The respondent had applied for the word mark “KEI” in Class 11 (Application No. 3693719). The Trade Marks Registry had cited three marks in its Examination Report including the impugned trademark (Application No. 3256919). In its response to the Examination Report, the respondent had, inter alia, stated “.....the services of the Applicant are different to that of the cited marks and therefore, there is not any likelihood of confusion....” Clearly, in view of the aforesaid statement, it would not be open for the respondent to contend to the contrary in these proceedings.

45. Mr. Lall had contended that the aforesaid statement was not contrary to the stand in the suit. He submitted that a meaningful reading of the respondent's response to the Trade Marks Registry would indicate that the respondent's stand was that there was no likelihood of confusion since it was well-known that the word mark “KEI” was associated with the respondent's goods. Given the unambiguous statement as quoted above, the said contention is unsubstantial. There is a clear assertion made by the respondent that its services are different to that of the cited marks. It is not open for the respondent to now claim that appellant's goods covered under the impugned trademark are similar to its goods and services.

46. Mr. Lall also submitted that the respondent had reserved its right to take the appropriate legal remedies and its response to the Trade Mark Registry was without prejudice to its rights and contentions. Undoubtedly, the respondent had reserved its right to avail of appropriate remedies in respect of the impugned trademark, however, reserving a right to avail of other remedies would not include the right to make a contrary assertion. A party approaching the Trade Marks Registry must be held to its statements made before the Trade Marks Registry and cannot be permitted to make a factual assertion contrary to what it claims before the Trade Marks Registry. For this reason, as well, it was not permissible for the respondent to claim that the goods covered under its trademarks were similar to those of the appellant.”

18. In view of the observations of the Division Bench referred to above, which binds this Court, it is clear that Plaintiffs would be bound by the assertions and stand taken in the reply before the Trade Marks Registry that the mark has to be seen as a whole. In their endeavour to distinguish the word mark ‘CENTRAL PARK’ from the cited marks ‘CENTRAL PARK’ and CENTRAL PARK-17 in the Examination Report, having taken a categorical position before the Trade Marks Registry that the Plaintiffs are proprietors of the label marks, which must be seen as a whole, it is impermissible for them to assert to the contrary before this Court and claim exclusivity over the words ‘CENTRAL PARK’ for continuing with the interim injunction. Therefore, in my view, the interlocutory injunction order deserves to be vacated on this ground alone.

19. Additionally, Defendants have also brought forth that the expression ‘CENTRAL PARK’ is a combination of two commonly used words in English language and purely generic, incapable of being distinctive and therefore, also common to trade. Number of projects in the real estate business, where the expression ‘CENTRAL PARK’ is indiscriminately used, have been illustratively cited by the Defendants such as, NITESH CENTRAL PARK by Nitesh Estates, CENTRAL PARK by the Proviso Group in Navi Mumbai, DARSHANAM CENTRAL PARK VADODRA by Crisil Real Estate, CENTRAL

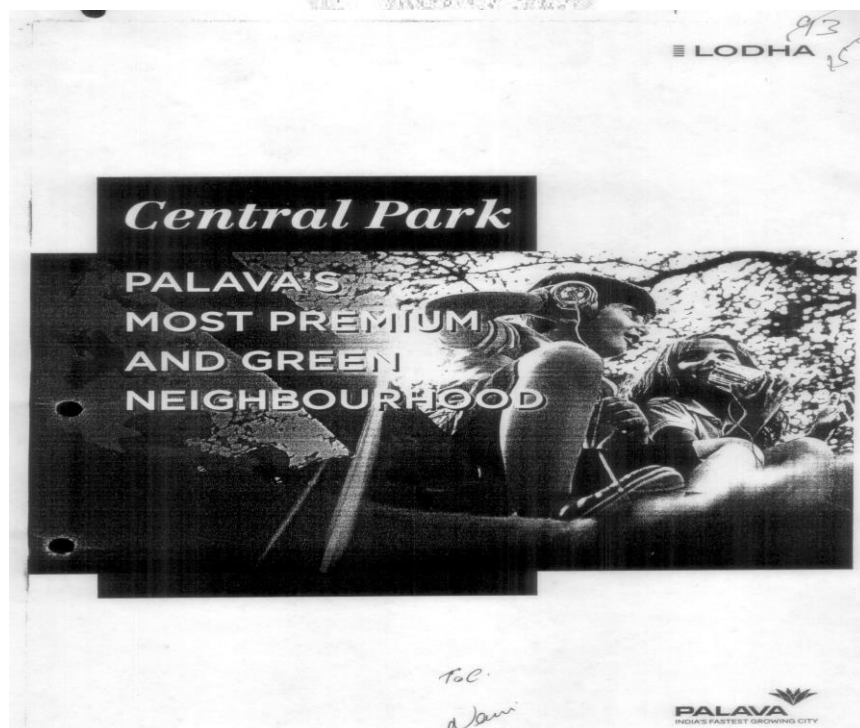
PARK, a theme park, a project undertaken by Navi Mumbai Municipal Corporation (NMMC) in Savali Village, Ghansoli, CENTRAL PARK by Urban Constructions in Hyderabad, SANKALP CENTRAL PARK by Sankalp Group and THE CENTRAL PARK HOTEL, PUNE. Therefore, *prima facie*, Plaintiffs cannot claim exclusive right in the mark 'CENTRAL PARK' word *per se* being an expression of common parlance, descriptive in character and common to trade.

20. Useful it would be to refer to a judgment of the Supreme Court in *Skyline Education Institute (India) Private Limited v. S.L. Vaswani and Another*, (2010) 2 SCC 142, where the issue before the Supreme Court was with respect to the validity of the trademark 'SKYLINE'. The Supreme Court upheld the judgment of the High Court where both the learned Single Judge and the Division Bench held that the word 'SKYLINE' was a generic word, being used by a large number of people in India as part of their trading name or business activities.

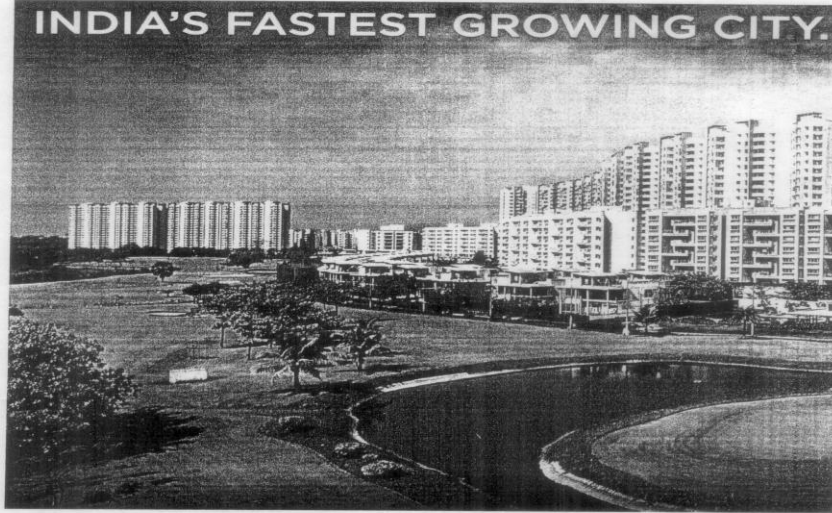
21. In this context, judgement in *OM Logistics Ltd. v. Mahendra Pandey*, 2022 SCC OnLine Del 757 is also relevant, where the rival marks were 'OM LOGISTICS LTD.' and 'OM EXPRESS LOGISTICS'. The contention of the Plaintiff was that it had various trademark registrations under Class 39 including the word mark 'OM LOGISTICS LTD.' and that the marks of the Defendant were phonetically similar to the Plaintiff with the only difference of the word 'EXPRESS' which was inconsequential and in any case, even if the Plaintiff's mark contains descriptive words, it had acquired distinctive character by long usage. Defendant *per contra* had stated that 'OM' is *publici juris*, a religious symbol or word, incapable of being monopolised, 'EXPRESS' is a common dictionary word used in

transport/courier service and 'LOGISTICS' was commonly used in transportation business. It was also urged that the mark of the Plaintiff was inherently descriptive and common to trade. Analysing the contentions of the respective parties, the Court held that 'OM' and 'LOGISTICS' were common to trade as evident from various documents filed by the Defendant including search reports from the Trade Marks Registry, website of the Ministry of Corporate Affairs, etc.

22. Defendants have also taken a defence that they are not using 'CENTRAL PARK' as a trademark but are using the expression in the descriptive sense and therefore, clearly steer away from the allegations of infringement and are covered under the exception carved out to infringement under Section 30(2)(a) of the Act. Before embarking on the journey of examining the said issue, it would require to be seen whether the Defendants are using 'CENTRAL PARK' as a trademark or as a descriptor and in order to understand this, I may only extract hereunder screenshots of the relevant pages from the brochure of the concerned project:-



81 154
**WELCOME TO PALAVA,
INDIA'S FASTEST GROWING CITY.**



Waking up to birdsong, enjoying scenic views, living the privileged life in a world-class city - these are no longer dreams.

The living experience you have always wanted awaits you at Mumbai's sister city, Palava - designed to fulfill every dream and desire. Spread over 4500 acres and located close to the upcoming Navi Mumbai International Airport (via Taloja Bypass), Palava lies at the heart of the economic activity in the Mumbai Metropolitan Region (MMR). Palava is a short 20 minute drive from Thane, Navi Mumbai and Kalyan - and less than an hour's drive from South Mumbai via the Eastern Freeway.

To C.
Nauri
In the last 6 years - 300% appreciation | 26,500 + homes purchased



Palava has been planned and designed by the world's smartest minds, for over half a decade - with the goal of offering the best residential, employment, business, academic and sports opportunities, along with international retail and leisure activities.

Palava is benchmarked to be amongst the top 50 most liveable cities in the world by 2025, and is set out to be everything a 21st century city ought to be.

To C.



Nauri

PALAVA
INDIA'S FASTEST GROWING CITY

Introducing Central Park, the most upscale neighbourhood in Palava city, adorned with picturesque gardens, green covers and ample open spaces providing your family with world class air quality - the best gift for their health and well being. Soon, brisk morning walks and leisurely evening strolls will become a way of life for you. And why not, when you can enjoy the convenience of world-class amenities, all located at walking distance from your home.


LIVE GREEN. BREATHE CLEAN.

- + Over 2 Lac trees that give you the cleanest air across the top Indian cities
- + 6-acre landscaped park around a natural lake to enjoy a family picnic or to simply relax
- + Nature Interpretation Centre that promotes sustainability
- + Expansive Forest Greens* that adorns the landscape and welcomes all kinds of flora and fauna
- + Courtyards around your home with play areas, walkways and seating areas
- + Tree-lined streets that gives you a chance to unwind after a long day at work

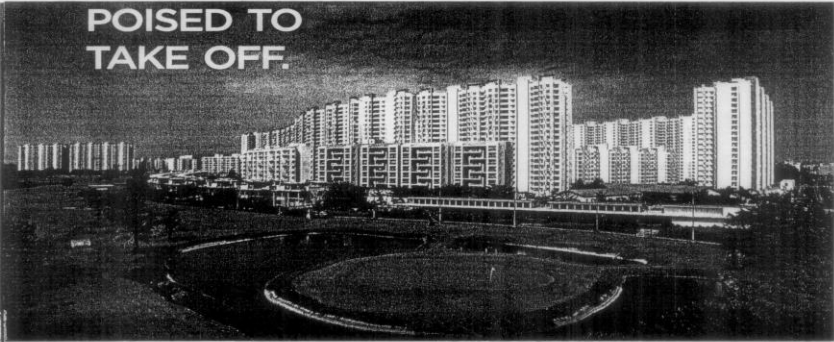
To C.

Neuro




98 169


PALAVA TODAY. POISED TO TAKE OFF.




Spread across 4,500 acres, Palava is planned to perfection by the best urban designers in India. With over 18,000 homes delivered till date, Palava has not only promised a great lifestyle but also delivered it.




20,000+ TREES
WITH
60% OPEN SPACES




HOME TO
26,500+
FAMILIES



300% VALUE APPRECIATION
IN 6 YEARS



INDIA'S FASTEST GROWING CITY
WITH ANNUAL POPULATION GROWTH OF MORE THAN 50%



PALAVA WORLD SCHOOL

- + Two ICSE schools operational with 3,000+ students
- + International Standard sports facilities including a 9-hole golf course, a FIFA standard football ground, a cricket ground, a multi-sport arena and opportunities to get coached by professionals
- + 5 lac sq.ft. mall with PVR multiplex, Big Bazaar and other shopping & dining options
- + 1.3 km Riverside promenade with an amphitheatre to host cultural performances
- + Luxurious clubhouses in every neighbourhood
- + Dedicated shuttle buses to key locations in Thane, Mumbai and Navi Mumbai
- + Smart City tie-up with IBM for 24x7 CCTV monitoring, e-governance, Palava Smart Card and much more

Actual City Images

To C.

23. Careful analysis of the aforementioned screenshots shows that the expression CENTRAL PARK is not used by the Defendants in isolation but is used along with their registered trademarks LODHA and PALAVA *albeit* the font of CENTRAL PARK is comparatively more conspicuous on account of its larger font and a prominent and distinctive black background in which it is set. The brochures also reflect that the registered trademarks of the Defendants LODHA and PALAVA are mentioned on almost all pages of the brochure in one way or the other. Along with the words CENTRAL PARK, Defendants have clearly mentioned that the project is ‘Central Park Palava’s Most Premium and Green Neighbourhood’ and on the next page, it is mentioned ‘WELCOME TO PALAVA’. While referring to ‘CENTRAL PARK’, the description states that the project is *the most upscale neighbourhood in Palava city, adorned with picturesque gardens, green covers and ample open spaces providing your family with world class air quality – the best gift for their health and well being. Soon, brisk morning walks and leisurely evening strolls will become a way of life for you.* The emphasis in the brochure, in my *prima facie* view, is promotion of the real estate project under the trademarks PALAVA and LODHA and the reference to CENTRAL PARK is only for the purpose of indicating that the project is planned in a manner where the allottees would enjoy a green cover with natural landscapes, clean air, etc. because of parks in the centre of the buildings. Therefore, *prima facie* this Court finds merit in the contention of the Defendants that the expression ‘CENTRAL PARK’ is used to describe the project and its special features of a green cover and clean environment and not as a source identifier or a trademark or mark so as to relate the real estate project to the Defendants and/or to create any association with the Plaintiffs. Therefore, in my view,

Plaintiffs have been unable to make out a *prima facie* case of infringement under Section 29 of the Act and Court is not persuaded to continue the *ex-parte* ad interim injunction in their favour.

24. Plaintiffs have placed heavy reliance on the judgment of this Court in *Central Park Estates Pvt. Ltd. and Others (supra)*, to contend that the Court in the said case has negated the contention that the expression 'CENTRAL PARK' is generic. Having carefully perused the judgment, this Court is unable to accept this contention. Although, this plea was raised in the said case, however, the Court has not given any finding for the reason that the Defendant in the said case has also applied for registration of the mark 'CENTRAL PARK' and on this ground alone, the Court had declined to adjudicate on this issue. Insofar as reliance on *United Biotech Pvt. Ltd. (supra)* is concerned, no doubt, the Court has held that when a label mark is registered, it cannot be said that the word mark contained therein is not worthy of protection. However, this judgment cannot come to the aid of the Plaintiffs in the present case, since it is their own stand before the Trade Marks Registry that their trademark would have to be seen as a whole mark and this was obviously to get over the objection of the Trade Marks Registry that the words 'CENTRAL PARK' are generic and common to trade.

25. Having said that, the next question that pronouncedly emanates is the relief that can be granted at this stage. While this Court has rendered a *prima facie* finding that the Plaintiffs are not entitled to claim exclusivity on the expression 'CENTRAL PARK', both on account of inconsistency in their stands before the Trade Marks Registry and this Court, as well as the expression being *prima facie* generic and common to trade, however, it cannot be lost sight of or overlooked that the expression 'CENTRAL PARK' is a part of the

Plaintiffs' registered label marks and word marks in conjunction with other words. The manner of usage of expression by the Defendants is likely to cause confusion amongst the potential customers, more particularly, in light of the fact that the competing parties are in the real estate business and may have common consumer base. With this, in the backdrop, coupled with the fact that it is Defendants' own stand that 'CENTRAL PARK' is only used as a descriptor and not a mark or a trademark, in my view, it would be imperative to direct the Defendants to restrain from using the expression 'CENTRAL PARK' in a font size conspicuously larger than their trademarks LODHA and PALAVA. This Court is mindful of the fact that the interim injunction has operated from 10.03.2017 and Defendants would have discontinued the use of CENTRAL PARK in connection with their projects. Therefore, correct course of action at this stage in order to balance the equities would be to direct that in case the Defendants intend to use 'CENTRAL PARK' for their projects in the future, they shall do so only after changing the manner of use including the font size and placement, as directed hereinafter.

26. For issuing the aforesaid direction, this Court draws strength from the judgment in *Cadila Healthcare Ltd. v. Gujarat Cooperative Milk Marketing Federation Ltd. & Ors.*, 2007 SCC OnLine Del 1439, where the Court was faced with a similar situation and the conundrum was resolved by directing the Defendant to change the size of the existing font to make it less conspicuous. While the Court agreed with the Defendant that the expression 'Sugar Free' was generic and the Defendant was using the mark as a descriptor along with its registered trademark Amul, however, to balance the equities at the interim stage, more particularly on account of the fact that the expression 'Sugar Free' was conspicuously displayed on the

packaging and was in a much larger font than the font of the registered mark Amul, the Court modified the *ex parte* order restraining the Defendant from using the expression 'Sugar Free' in the present font size and permitted it to use it as a part of a sentence or a catchy legend, so as to describe the characteristic features of its product. I may quote the relevant paragraphs as follows:-

"47. A Prima facie visual perusal of the defendant's sample demonstrates that the defendant has used 'Amul' as a trade mark before the expression 'Sugar Free'. Even though, I see no perceptible similarity between the two different packagings in terms of colour scheme and get-up, what has really caught my attention is the manner in which the expression 'Sugar Free' has been displayed on the packaging of the defendant's product. It is difficult to ignore that 'Amul', despite being the trade mark of the defendant, is written in comparatively much smaller font than the words 'Sugar Free' which are more conspicuous by their larger fonts. The expression 'Pro biotic Frozen Dessert' again has been written in a comparatively small size. The entire get up in the defendant's packaging is such that the focus is on the words 'Sugar Free' so much so that the defendant's trade mark 'Amul' is completely overshadowed.

48. What is important to be examined is how an average consumer, in this case being a consumer who is either a regular purchaser of the plaintiff's product or is well-informed about its functional utility, will perceive the defendant's product. The chances of deceiving such consumer are minimal inasmuch as he is well informed about the product he is intending to purchase and can ably distinguish between the plaintiff's product and the defendant's product. However, the possibility of confusion in the present case cannot be ruled out. It is important to note that the defendant's product contains Sucralose (see, sample B), which happens to be the chief ingredient of the plaintiff's product. There may be a possibility, though less likely, that such consumer may be misled into believing that the plaintiff's product being in the nature of an 'add on' has been used as an ingredient in the preparation of the defendant's Pro Biotic Frozen Dessert and, thus, may be gravitated to purchase the defendant's product.

49. The defendant has not satisfactorily explained this Court the reason behind the overwhelming impact of the expression 'Sugar Free' on the packaging of its product Pro Biotic Frozen Dessert. Moreover, if the defendant's plea that it has used the expression 'Sugar Free' only in a descriptive sense is to be believed, then there is no justification by the defendant as to why it has chosen to focus only on the expression 'Sugar Free' when the expression 'Pro biotic' can equally be used as a descriptive epithet in relation to its frozen dessert.

xxx

xxx

xxx

52. *It is noteworthy that it is not for the first time that this Court, whilst adjudicating upon such matters, has been confronted with a purely descriptive trade mark seeking protection against passing off. I recall the stand taken by a Division Bench of this Court in Johnson & Johnson v. Christine Hoden India (P) Ltd., reported at 1988 PTC 39. In this case, both the plaintiffs and defendants were manufacturers of sanitary napkins. Whilst the plaintiffs were using the expression 'Stay Free' as a trade mark in relation to their products, the defendants, on the other hand, were admittedly using the said expression merely to describe the characteristic nature of their product. The question that came up before this Court was whether the use of the expression 'Stay Free', in a purely descriptive sense, amounted to passing off? On a visual perusal of both products, that Court took a Prima facie view that the defendant was entitled to use the expression 'Stay Free' insofar as it was using the same to describe its products in the descriptive sense but not in a trade mark sense.*

53. *Coming back to the present case, the plaintiff herein has sought for an absolute embargo on the defendant from using the expression 'Sugar Free' on the packaging of its product Pro Biotic Frozen Dessert purporting that such use is likely to confuse potential consumers in mistaking the defendant's product from being in some manner connected to its Sugar Free range of products. However, notwithstanding the confusion which the defendant's packaging is likely to create amongst potential consumers of the plaintiff, there are certain seminal questions that have been weighing heavily on my mind right from the beginning. Owing to the descriptive nature of the plaintiff's trade mark 'Sugar Free' which makes the expression extremely popular and much used especially in relation to foods products, can the defendant be absolutely restrained from using the expression 'Sugar Free' in relation to its products? To what extent will it be equitable to allow a blanket injunction on the defendant from using the expression 'Sugar Free', especially when the defendant pleads to use such expression only as descriptive epithet and not as a trade mark? Will not imposing a positive embargo on the use of the expression 'Sugar Free' by the defendant collaterally have the effect of allowing the plaintiff to monopolise the use of the said expression?*

54. *It is important to be borne in mind that use of a descriptive expression as a trade mark by a trader, irrespective of the said trade mark having acquired a secondary meaning and distinctiveness in relation to the trader's products, does not entitle such trader from precluding other traders from using the said expression for the purposes of describing the characteristic features of their products. I have no hesitation in stating, albeit without prejudice to the rights and interests of the plaintiff in the present suit, that by adopting such a purely descriptive and laudatory expression 'Sugar Free' as its trade mark, the plaintiff must be prepared to tolerate some degree of confusion which is inevitable owing to the wide spread use of such*

trade mark by fellow competitors. Simply because the plaintiff claims to be using the expression 'Sugar Free' as a trade mark much prior to the launch of the defendant's product Pro Biotic Frozen Dessert in the market does not give this Court a good ground for imposing a blanket injunction on the defendant from using the expression 'Sugar Free', especially when the defendant intends to use this expression only in its descriptive sense and not as a trade mark, and even otherwise, when the use of this expression is widespread in relation to foods and beverages.

55. To sum up, even though the petitioner has Prima facie been successful in establishing the distinctiveness of its trade mark 'Sugar Free' in relation to its products, it has not been able to satisfy this Court why an embargo should be placed on the defendant from absolutely using the expression 'Sugar Free', especially when the defendant has Prima facie satisfied this Court of its bona fide intention to use the said expression not as a trade mark but only in its descriptive or laudatory sense. However, even as any possibility of the defendant trying to dishonestly pass off its products as those of the plaintiff stands ruled out, I have a predilection that the overwhelming impact of the expression 'Sugar Free' on the packaging of the defendant's product may lead to some confusion. Such confusion, though not rooted in deception or malice on the part of the defendant, and further, such confusion, though less likely to manifest owing to the well-informed consumer base of the plaintiffs products, nevertheless, carries a fair risk of misleading the consumers of the plaintiff into believing that its sweetener has been added as an ingredient in the defendant's Pro Biotic Frozen Dessert.

56. This brings us to the last, nevertheless, most challenging part of the present case, and that being, what relief should this Court afford at this interlocutory stage so as to subserve the ends of justice. The following impactful observations made by the Apex Court in *Wander Ltd. v. Antox India Pvt. Ltd.*, reported at 1990 Supp SCC 727, have become a guiding light for Courts of law whilst deciding upon the relief to be afforded at an interlocutory stage when evidence is yet to be led:

"The object of an interlocutory injunction is to protect the plaintiff against injury by violation of his rights for which he could not be adequately compensated in damages recoverable in the action if the uncertainty were resolved in his favour at the trial. The need for such protection must be weighed against the corresponding need of the defendant to be protected against injury resulting from his having been prevented from exercising his own legal rights for which he could not be adequately compensated. The Court must weigh one need against the, and determine where the 'balance of convenience' lies."

59. The ex parte order dated 3.4.2007 is accordingly varied to incorporate the following directions:

(i) The defendant is restrained from using the expression 'Sugar

Free' in the present font size which is conspicuously bigger than its trade mark 'Amul'.

(ii) The defendant is free to use the expression 'Sugar Free', as part of a sentence or as a catchy legend, so as to describe the characteristic feature of its product."

27. The matter was carried in appeal by the Plaintiff in FAO (OS) 62/2008, reported as ***Cadila Health Care Ltd. v. Gujarat Co-Operative Milk Marketing Federation Ltd. & Ors., 2009 SCC OnLine Del 2786*** and the Division Bench of this Court upheld the judgment of the learned Single Judge and observed as follows:

"15. The learned Senior Counsel for the respondent Shri Mihir Joshi has vehemently argued that the size of the font is not inappropriate in the context of trade usage as it merely serves to emphasize the category and unique selling point of the product and prominence of use, by itself, and would not amount to misrepresentation particular in view of the common font styling, which is completely different than that used by the appellant. He thus urged that the learned Single Judge was not justified in imposing the restrictions. In view of the findings recorded in the judgment about the descriptive nature of the phrase Sugar Free, we cannot restrict the use of the expression Sugar Free by the respondents especially as the part of a sentence or a catchy legend so as to describe the characteristic features of its product. The learned Single Judge, on the nature of lettering, has observed at the interlocutory stage that the respondents are exhibiting the expression Sugar Free' in a manner which even though prima facie does appear to be descriptive but still seems inappropriate and held that the respondents are restrained from using the expression Sugar Free' in the present font size which appeared conspicuously bigger than its trademark Amul'. The grievance of the appellant, in our view, has also been adequately redressed by the restriction on the size of font by the learned Single judge which adequately ensures that no connection with the appellant is indicated and the possible figuring of the appellant's product as the ingredient of the respondent's product is discounted and the usage of the appellant limited to the descriptive sense. Mr. Mihir Joshi's contention for the respondent that there can be no restraint of any kind on the font for the user of the phrase Sugar Free' by the respondent cannot thus be accepted at this interim stage particularly in view of the past correspondence between the appellant and the respondent of the possible use by the respondent of the appellant's product. In our view, the interim order of the learned Single Judge at the interlocutory stage is justified and does not warrant any interference. The remedy for the grievance made by the appellant regarding the use of the expression Sugar Free' in an inappropriate font size would be in the form of contempt petition. We were informed during the course of the hearing that a

contempt petition has been filed and the same is pending before the learned Single Judge.”

28. In this context, I may also refer to another interim order dated 09.05.2016 passed by a Co-ordinate Bench in CS(OS) 2044/2015, titled as ***Central Park Estates Pvt. Ltd. & Anr. v. Keystone Realtors Pvt. Ltd. & Anr.*** and the relevance of mentioning this case is that it related to the same Plaintiffs as in this case and the impugned mark was ‘Rustomjee CENTRAL PARK’. By order dated 09.05.2016, the learned Single Judge of this Court varied the interim injunction earlier granted, directing the Defendants to use the impugned mark in a manner that the font size of ‘Rustomjee’ equals that of ‘CENTRAL PARK’, so that the latter gets the same prominence as ‘Rustomjee’. This order was challenged before the Division Bench in FAO(OS) 179/2016 and without going into the contentions on merits which were almost identical to the ones raised by the Defendants herein, the Division Bench upheld the order noting that the said order was passed to protect the interest of the Appellants i.e. the Plaintiffs in the suit.

29. In view of the aforesaid, the interim order dated 10.03.2017 is hereby vacated, with a caveat/pre-condition that in case the Defendants are inclined to use ‘CENTRAL PARK’ in future, they shall ensure that the words are juxtaposed with Defendants’ registered trademarks LODHA and PALAVA and/or are in close proximity thereof and not standalone and the font size of CENTRAL PARK is reduced so as to highlight and give more prominence to Defendants’ registered trademarks, aforementioned.

30. Before disposing of the present applications, it is important to pen down the usual caveat that the views and observations expressed by the Court in this judgment are only *prima facie* and tentative and shall have no bearing on the final adjudication of the suit.

31. With these observations, both the applications are disposed of.

JYOTI SINGH, J

MARCH 29, 2023/shivam/kks

