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

%   Decided on: 18th December, 2019

\+   **CS(COMM) 179/2019**

FERRERO SPA & ORS.

..... Plaintiff

Represented by: Ms.Vaishali Mittal, Adv. with Ms.Mrinali Menon, Adv.

versus

KAMCO CHEW FOOD PRIVATE LIMITED & ORS.

..... Defendant

Represented by: Mr.Amit Jain, Adv. with Ms.Neelam Pathak, Adv.

CORAM:
HON'BLE MS. JUSTICE MUKTA GUPTA

MUKTA GUPTA, J. (ORAL)

1. Learned counsel for the defendants states that since no summons were issued to the defendants, no written statement was filed. The order dated 8th April, 2019 notes as under:-

> *"Today Mr.Shailen Bhatia, Advocate enters appearance on behalf of the defendants. He states that he had filed a caveat. Let an advance copy of the paper book be supplied to Mr.Shailen Bhatia during the course of the day. List on 10th April, 2019".*

2. It is apparent that the defendants claimed to be on caveat.

3. Be that as it may, there is no denial that the advance copy of the paper book was supplied to the defendants in the course of the day. Thus,

summons have been issued to the defendants and accepted. The defendants were thus required to file the written statement within the statutory period. The written statement having not been filed in the statutory period the plaintiffs are entitled to a decree of the suit in terms of Order XIII-A CPC.

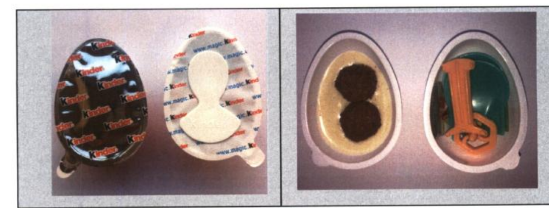
4. By the present suit, the Plaintiff, inter alia, prays for a decree for permanent injunction restraining the defendants, their partners, proprietors, principal officers, servants and agents, distributors, or any other person acting on their behalf from manufacturing, selling, importing, exporting, offering for sale, advertising directly or indirectly in any manner with confectionery products including the trade dress of the egg-shaped confectionery chocolates under the trade mark and/ or trade dress KAMCO MOTU PATLU and GRV MOTU PATLU or any other goods under the trademark or trade dress similar to that of the Plaintiff's "KINDER trademarks" amounting to infringement of registered trademarks of the Plaintiff which will lead to passing off of defendant's goods as those of plaintiff's and/or dilution of plaintiff's trademarks , logo and trade dress or unfair competition besides delivery up of the impugned material including products, container boxes, labels, wrappers, stickers and stationery or any other material; rendition of accounts of the illegally earned profits and a decree for the amount so ascertained; order for damages and an order declaring the

Plaintiff's trademark "Kinder Trade Marks" as a well-known trademark under Section (1) (zg) of the Trade Marks Act.

5. Plaintiff No. 1, Ferro S.P.A is a company incorporated under the laws of Italy. Plaintiff No. 2, Soremartec S.A, is a company incorporated under the laws of Luxemburg whereas plaintiff No. 3, Ferrero India Pvt. Ltd. is a company incorporated under the laws of India. Pankaj Pahuja is the authorized signatory on behalf of plaintiff nos. 1 to 3.

6. Case of the plaintiffs is that they are a part of the renowned "Ferrero Group" which traces its origin to the year 1946 in Italy. It is the 3rd largest confectionery producer in the world having 25 production plants and around 34,543 employees. In the year 2009, as per Reputation Institute Survey in the Forbes Magazine it was ranked as the most reputable company in the world. Further in the year 2014, it was ranked as the no. 1 employer in Italy. Ferrero Group's trademarks include FERRERO ROCHER, NUTELLA, TIC TAC, KINDER, KINDER JOY, KINDER BUENO, KINDER SCHOKO-BONS, CONFETTERIA RAFFAELLO, FERRERO RONDNOIR etc.

4. Plaintiffs' trademark "KINDER JOY" is unique and distinctive being an egg-shaped device branded by fanciful decorations. KINDER JOY and KINDER formative trademarks (*'Kinder trademarks'* herein) have long been in use and thus have acquired immense goodwill and reputation all over the world. Plaintiffs' KINDER JOY products comprise of two halves, one half containing a toy and the other half containing milk and cocoa cream with crispy wafer balls filled with cocoa cream along with a spoon.



5. The packaging of the said product bears a unique colour combination of white and reddish orange along with the wave device that is and .

The product "Kinder Surprise" a selection of Kinder trademark was launched by the plaintiff as an extension of the KINDER mark in the year 1974 and thereafter is being sold worldwide in a variety of packaging, including but not limited to the following:

6. Subsequently, the trademark "Kinder Joy" was launched worldwide including India in an egg-shaped container in the year 2001 and the manufacturing plant for the same is located in Baramati, Maharashtra. The KINDER JOY confectionery products are popular all over the world

amongst children and adolescents for their distinctive get-up, layout and packaging. Thereby, making its egg-shaped unique device and shape associated widely with the KINDER range of products under plaintiffs FERRERO group. The character represented as is one of the distinctive feature of KINDER JOY packaging as shown below:

7. Plaintiffs are also selling other Kinder products including "Kinder Schoko-Bons Crispy" bearing the said "wave" device that is and on the respective packagings in India.

8. Kinder Joy specialties are also available in varied form for its young consumers such as :

9. In the year 2018, the worldwide sales of Kinder Joy aggregated to be several hundred million of Euros and the ever-growing net sales of Kinder

specialties in India for the years 2010 to 2018 aggregated to be over ₹ 2800 crores. Plaintiff has also invested a huge amount of money and efforts to advertise and promote its products. The advertising/promotional expenditure of plaintiff was over ₹ 400 crores in India till December 2018.

10. Ferrero India Pvt. Ltd., plaintiff no. 3 herein, commenced the manufacturing and importing of KINDER specialties for domestic consumption. The plaintiffs uses www.ferreroindia.com, www.kinder.com, www.magic-kinder.com, www.ferrero.com, http://in.ferrerocareers.com/en-in, www.kinderbrands.co.nz, www.kinderbrands.com.au, www.kinder.com.ar and other websites to ensure widespread access to information and promotion worldwide.

11. Plaintiff's products are also advertised on various platforms including www.youtube.com, www.facebook.com and other third-party websites. Along side commercial outlets in India, the said products are available on third-party websites such as www.amazon.in, www.flipkart.com, www.grofers.com etc.

12. Plaintiffs are the owner of hundreds of"Kinder Trade Marks" including the distinctive wave device in more than 180 countries and only a few of KINDER, KINDER SURPRISE and KINDER JOY trademark registrations have been filed in the present suit. Plaintiffs have registration in various classes including Classes 29, 30, 32 etc.

13. Due to the long, extensive and continuous use of the "Kinder trademarks", plaintiff has acquired common law rights and statutory rights in the said mark. The plaintiffs' kinder trademark has attained goodwill and reputation all over the world and due to its long standing and widespread use, it has acquired the "well-known" status. The said marks are solely

associated only with the Ferrero Group and the range of products under it are available world-wide. Ferrero Group is the registered proprietor for the said marks in over 180 countries. Ferrero SPA plaintiff no.1 herein, is also the registered proprietor of the wave design under registration no. 1411117 and 1411116 and for the word mark "KINDER" under registration no. 302455 in India. Being one of the widely selling chocolate and confectionaries brands in the world, the Ferrero Group has been cautious in protecting and safeguarding its rights in the said mark. Plaintiffs' products are extensively advertised and promoted worldwide and are available through retail stores in India.

14. Grievance of the plaintiff is that the defendants have been involved in manufacturing of a product named "KAMCO MOTU PATLU -Biscuit Ball with Choco & Milk Rabdi" under the trading style of Kamco Chew Food Private Limited, defendant no. 1 herein, being identical to plaintiffs "KINDER JOY" as shown below:

15. In the first week of September 2018, plaintiffs conducted an investigation to ascertain the extent of commercial presence and availability of the impugned product. The impugned product was listed on defendant no.1's website www.kamcoindia.net as *"Motu Patlu Choco Balls in Eggs Shape Pack" under the Category: Chocolate Balls* as shown below:

“

Furthermore, the website of defendant no.1 explained that it is a professional manufacturer and exporter of a wide range of confectionery items in India and abroad, including but not limited to confectionery products.

16. Plaintiffs’ representative also made a call to the sales department of defendant no.1 on the contact number (+91-9893329161) provided on the official website. It was informed to the said representative that the products of defendant no. 1 are sold worldwide. Further, on enquiring about the availability of the said products in Delhi, the representative was provided with the contact number of Mr. Mohit Sachdeva defendant no. 3 herein, being the official and authorized distributor of the impugned products that is KAMCO and GRV MOTU PATLU along with . The plaintiffs’ representative was also informed that “GRV” and “KAMCO” are the brands of defendant No. 1 and defendant No. 2 is one of the units of defendant No. 1.

17. Plaintiffs’ representative searched for the contact number as provided by defendant no. 1 that is +91 9971424292 on the internet and discovered information concerning defendant no. 3. Thereafter on 4th September 2018, the plaintiffs’ representative met Mr. Mohit Sachdeva owner of Sachdeva

Bakers and Confectioners and was informed that the impugned products are readily available with them and also confirmed that he is the distributor of the same in Delhi. The impugned products were purchased by the plaintiff's representative for a sum of ₹3448/- and a perusal of the packaging of the same confirmed that defendant no.2 is the manufacturer of the product.

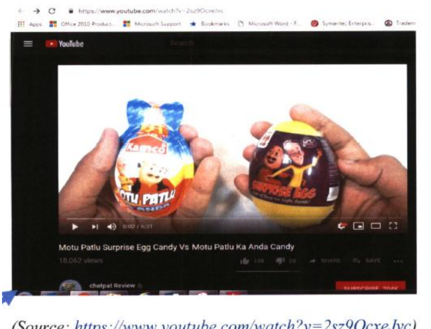
18. Further, a follow-up investigation was conducted in the first week of March 2019 and the plaintiff learnt that the defendants continued to sell the impugned products in Delhi. Plaintiff also learnt that other than the existing range of products under KAMCO MOTU PATLU with the trade dress , the defendants were also involved in the manufacturing of another range of egg-shaped chocolates named as "HORROR CHOCOLADE" bearing a trade dress of a skeleton, monster and other ghostly images as shown below:

Defendants egg-shaped chocolates called "HORROR CHOCOLADE"

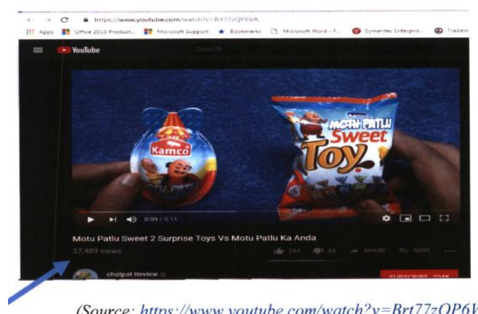
Egg shaped chocolates bearing a trade dress of a skeleton, monster and other such ghostly images.

"MOTU PATLU" chocolates under their GRV brand

19. The impugned products bear the registered trademark of plaintiff being , on their packaging. On 1st March 2019, the plaintiffs' representative purchased the aforesaid impugned products for ₹2785/-. Further, various websites such as www.youtube.com and www.facebook.com show several videos uploaded by various users of the impugned product such as follows:



(Source: https://www.youtube.com/watch?v=2sz9OcxeJvc)



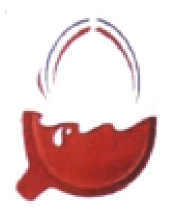
(Source: https://www.youtube.com/watch?v=Brt77zQP6VA)

It is also listed on third party websites such as www.indiamart.com with details of the company with a catalogue of the products sold by it which shows its widespread publicity and commercial outreach.

20. Defendants are manufacturing, marketing and selling the products namely *"KAMCO MOTU PATLU —Biscuit Ball with Choco & Milk Rabdi"* & *"GRV MOTU PATLU —Biscuit Ball with Choco & Milk Rabdi"* with Defendant No. 3 as the authorized distributor in Delhi as shown below:

21. On 11th October 2018, the plaintiffs through their legal representatives sent a legal notice to the defendants acquainting them of the rights vested in Kinder Joy trademarks and trade dress which was successfully delivered. However, no response to the same was received. On 7th December 2018, plaintiffs received a copy of the caveat petition filed before this court. It is evident from the aforesaid that the defendants continued to manufacture, market and sell the impugned products. The said caveat petition had expired and was not renewed by the defendants.

22. A comparison of the plaintiffs' product with that of the defendants' KAMCO MOTU PATLU and GRV MOTU PATLU shows that the egg-shaped packaging using white and reddish orange colour . Egg shaped picture used on the packaging of the product with two chocolate balls similar to KINDER JOY's product packaging with dissected egg. The presence of small egg shaped device with reddish orange and white stripes on the product similar wave device of KINDER JOY

product that is  . It also has reddish orange strips on the product packaging .

23. Comparison of Defendants KAMCO MOTU PATLU and GRV MOTU PATLU with Plaintiffs KINDER JOY is shown below:

S.No.	**PLAINTIFFS "KINDER JOY"**	**DEFENDANTS "KAMCO MOTU PATLU"**	**COMPARISON**
1.			• Egg shaped packaging making used by the Defendants which is similar to the Plaintiffs' well-known egg-shaped chocolates; • Manner of representation of the colors on the product similar to the Plaintiffs' KINDER JOY chocolates; • Small device used to open the packaging of the chocolate from the bottom-left of the egg-shaped chocolate;

<table>
<tr><td>2.</td><td></td><td></td><td>• Identical presentation of the open egg-shaped chocolate packaging with two chocolate balls present in dark brown and milky colored white chocolate base.
• Identical manner of red/orange and white wave device on the packaging of the product identical to the Plaintiffs' well-known orange and white shaped device.</td></tr>
<tr><td>3.</td><td></td><td></td><td>• Adoption of a nearly identical lookalike character namely "MOTU - PATLU" as that of Plaintiff's KINDER JOY character used widely on the products and the packaging</td></tr>
<tr><td></td><td>PLAINTIFFS "KINDER JOY"</td><td>DEFENDANTS "GRV MOTU PATLU"</td><td>COMPARISON</td></tr>
<tr><td>4.</td><td></td><td></td><td>• Egg shaped packaging making used by the Defendants which is similar to the Plaintiffs' well-known egg-shaped chocolates;
• Manner of representation of the colors on the product similar to the Plaintiffs' KINDER JOY chocolates;
• Small device used to open the packaging of the chocolate from the bottom-left of the egg-shaped chocolate;</td></tr>
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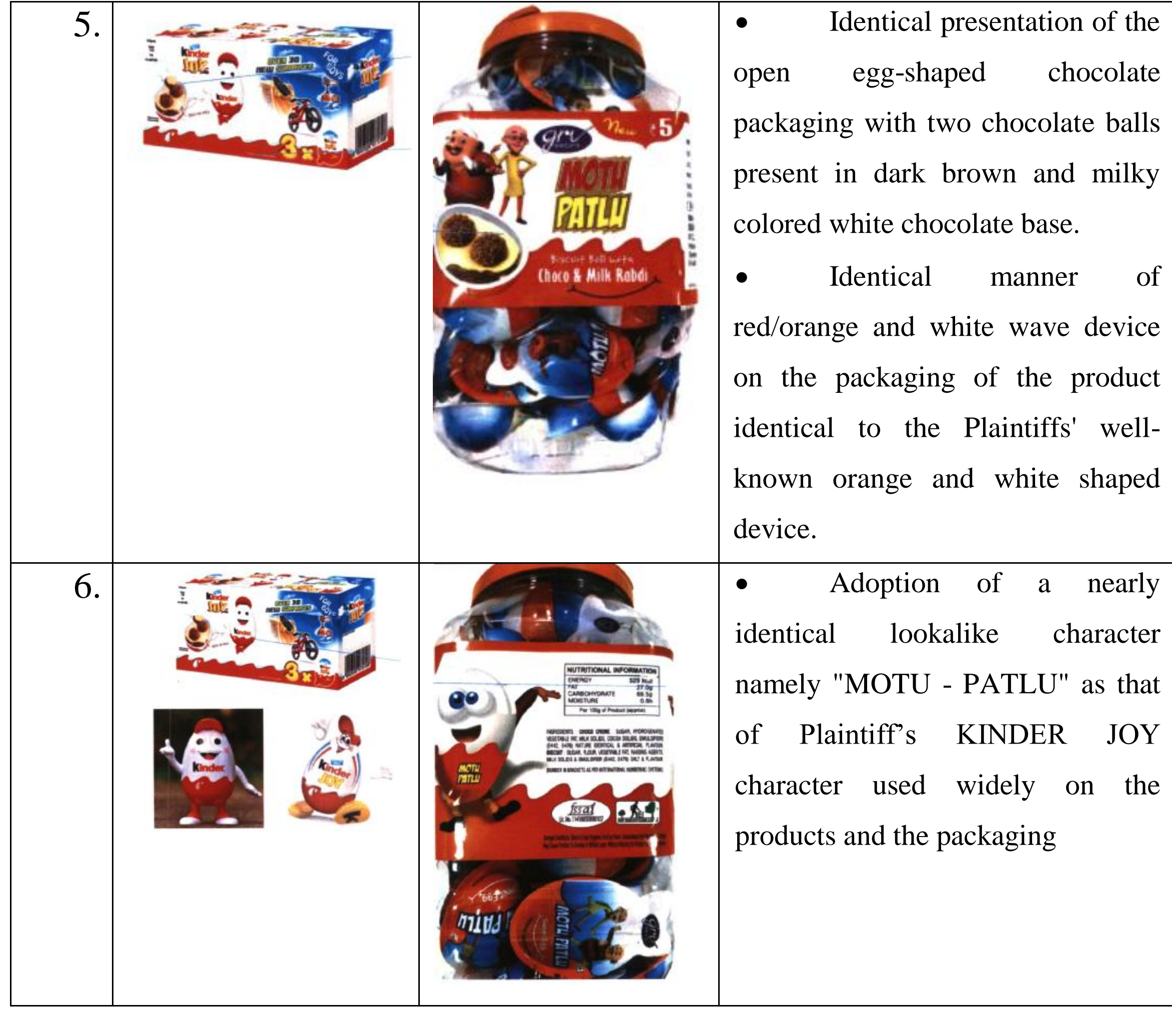

5.			• Identical presentation of the open egg-shaped chocolate packaging with two chocolate balls present in dark brown and milky colored white chocolate base. • Identical manner of red/orange and white wave device on the packaging of the product identical to the Plaintiffs' well-known orange and white shaped device.
6.			• Adoption of a nearly identical lookalike character namely "MOTU - PATLU" as that of Plaintiff's KINDER JOY character used widely on the products and the packaging

24. Plaintiffs are the registered proprietors of the trademarks and they have exclusive rights over the use of the same. Any use of these marks by third-party without authorization from plaintiffs would result in infringement of the said marks under Section 29 of the Trade Marks Act. Defendants have used a deceptively similar trade dress and

identical colour combination that is , and to induce consumers into mistaken impression that the defendants' product stems from the plaintiffs'. Further, defendants' use of the said colour combination is "use in the sense of a trademark" and such use is likely to cause confusion in minds of the public. It could be ascertained from the aforementioned that the triple identity test for infringement of trademark is hence satisfied that is defendants are associated with the plaintiffs' business, goods and services of the defendant emanates from the plaintiffs and the defendants have been authorized by the plaintiffs to provide its goods and services under the plaintiffs marks.

25. From the pleadings of the plaintiff in the plaint as also the documents enclosed with the plaint along with the necessary certificate, the plaintiffs have clearly made out a case for grant of injunction in terms of prayer (i), (ii), (iii) and (iv) of para 53 as the defendant is violating the rights of the plaintiff in its trademark.

26. In the present suit the plaintiff also prays for a decree of declaration that the Plaintiffs 'Kinder Trade Marks' are well-known trademarks.

27. Section 2(zg) which defines a "well-known trademark" and Section 11(6) of the Trademark Act read as under:

> *"2(zg) "well-known trade mark", in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such*

services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.

……

11(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

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

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

(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark;

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

28. In the decision reported as (<u>2009) 41 PTC 284 (Del) Rolex Sa Vs. Alex Jewellery Pvt. Ltd. & Ors</u>. this Court dealing with a well-known trademark held:

> *"15. Section 2(4)(c) defines a well known trademark as the one which in relation to any goods, means a mark which has become so to the substantial segment of the public which uses such goods that the use of such mark in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person using the mark in relation to the first mentioned goods. In my view the segment of the public which uses the watches of the category/price range as the watches of the plaintiff, ROLEX is a well known trademark. The said segment of the public if comes across jewellery/artificial jewellery also bearing the trademark ROLEX is likely to believe that the said jewellery has a connection to the plaintiff.*
>
> *16. Yet another provision in the Act, though for the guidance of the Registrar but in relation to well known trademarks is to be found in Section 11(6) of the Act. Upon testing the trademark of the plaintiff on the touchstone of the ingredients of the said provision also, I find the said trademark of the plaintiff to be satisfying the test of a well known trademark. The documents filed by the plaintiff i.e., the advertising done in the media in India since 1947 and particularly in years immediately preceding the suit, registrations obtained show that relevant section of the public in India had knowledge of the trademark ROLEX in relation to the watches. The pleadings of the plaintiff and which are not contested also show that the plaintiff for the last nearly one century has been using the said trademark spread over nearly the entire developed/developing world. The advertisements of the plaintiff had appeared in the magazines in this country even when there were import restrictions. The*

plaintiff has filed documents to show registration of the trademark in a large number of countries and also to show successful enforcement of its rights with respect to the said trademark.

20. Over the years and very quickly in recent times, the international boundaries are disappearing. With the advent of the internet in the last over ten years it cannot now be said that a trademark which is very well known elsewhere would not be well known here. The test of a well known trademark in Section 2 is qua the segment of the public which uses such goods. In my view any one in India, into buying expensive watches, knows of ROLEX watches and ROLEX has a reputation in India. Not only so, to satisfy the needs/demands of consumers in different countries, the well known international brands which were earlier available at prices equivalent to prices in country of origin and which owing to the exchange rate conversion were very high, have adapted to the Indian situation and lowered prices. A large number have set up manufacturing facilities here and taken out several variants. Thus, merely because today the price of a ROLEX watch may be much higher than the price of items of jewellery of the defendants as argued, cannot come in the way of the consumer still believing that the jewellery is from the house of the plaintiff. Also, there can be no ceiling to the price at which the defendants will continue to sell their jewellery. The defendants have claimed to be selling rolled gold jewellery; with the price of gold soaring, there is no certainty that the pieces of artificial jewellery of the defendants would not also be in the same range as the watches of the plaintiff. Even otherwise, the trend in modern times has been towards artificial/semi precious jewellery. In fact, the attraction to gold is confined to this part of the world only. In India also today there are several brands of artificial jewellery/semi precious

jewellery whose brand value and/or prices are quite comparable to the gold jewellery of the conventional gold smiths

24. The goods of the plaintiff may lose their sheen to the strata of the society for which they are intended if such strata finds the goods in the same brand name even though not from the house of the plaintiff being available for a much lower price. The goods of the plaintiff would then cease to be a status symbol or a fashion statement. Undoubtedly, the same would be to the detriment of the plaintiff. Having found a prima facie case in favour of the plaintiff and irreparable injury to be caused to the plaintiff by allowing the defendant to continue using the trademark, I also find the element of balance of convenience to be satisfied in the present case. The registration of the mark of the plaintiff is over 90 years prior to the claimed commencement of the use by the defendant. Even if the defendant, at the time of commencing the use, did not know of the inherent risk in adopting the well known trade mark, the defendant, at least, immediately on applying for registration and on opposition being filed by the plaintiff became aware of the perils in such use. Thus, use by the defendant of the mark is for short time only and use during the period of opposition is of no avail. The mark has got no relation to the jewellery being marketed by the defendants. Unless the defendant is deriving any advantage of the goodwill/brand value of the plaintiff and which it is not entitled to, it ought not to make any difference in the business of the defendants if the said jewellery is sold under a mark other than ROLEX."

29. Dealing with the "well-known trademark", this Court in the decision reported as *2011 (46) PTC 244 (Del) Tata Sons Ltd. Vs. Manoj Dodia & Ors*. held:

"5. A well known trademark is a mark which is widely known to the relevant general public and enjoys a comparatively high reputation amongst them. On account of advancement of technology, fast access to information, manifold increase in international business, international travel and advertising/publicity on internet, television, magazines and periodicals, which now are widely available throughout the world, of goods and services during fairs/exhibitions, , more and more persons are coming to know of the trademarks, which are well known in other countries and which on account of the quality of the products being sold under those names and extensive promotional and marketing efforts have come to enjoy trans-border reputation. It is, therefore, being increasingly felt that such trademark needs to be protected not only in the countries in which they are registered but also in the countries where they are otherwise widely known in the relevant circles so that the owners of well known trademarks are encouraged to expand their business activities under those marks to other jurisdictions as well. The relevant general public in the case of a well known trademark would mean consumers, manufacturing and business circles and persons involved in the sale of the goods or service carrying such a trademark.

6. The doctrine of dilution, which has recently gained momentous ,particularly in respect of well known trademarks emphasises that use of a well known mark even in respect of goods or services, which are not similar to those provided by the trademark owner, though it may not cause confusion amongst the consumer as to the source of goods or services, may cause damage to the reputation which the well known trademark enjoys by reducing or diluting the trademark's power to indicate the source of goods or services.

7. Another reason for growing acceptance of trans-border reputation is that a person using a well known trademark even in respect of goods or services which are not similar tries to take unfair advantage of the trans-border reputation which that brand enjoys in the market and thereby tries to exploit and capitalize on the attraction and reputation which it enjoys amongst the consumers. When a person uses another person's well known trademark, he tries to take advantage of the goodwill that well known trademark enjoys and such an act constitutes an unfair competition.

8. The concept of confusion in the mind of consumer is critical in actions for trademark infringement and passing off, as well as in determining the registrability of the trademark but, not all use of identical/similar mark result in consumer confusion and, therefore, the traditionally principles of likelihood of confusion has been found to be inadequate to protect famous and well known marks. The world is steadily moving towards stronger recognition and protection of well known marks. By doing away with the requirement of showing likelihood of confusion to the consumer, by implementing anti-dilution laws and recognizing trans-border or spill over reputation wherever the use of a mark likely to be detrimental to the distinctive character or reputation of an earlier well known mark. Dilution of a well known trademark occurs when a well known trademark loses its ability to be uniquely and distinctively identify and distinguish as one source and consequent change in perception which reduces the market value or selling power of the product bearing the well known mark. Dilution may also occur when the well known trademark is used in respect of goods or services of inferior quality. If a brand which is well known for the quality of the products sold or services rendered under that name or a mark similar to that

mark is used in respect of the products which are not of the quality which the consumer expects in respect of the products sold and/or services provided using that mark, that may evoke uncharitable thoughts in the mind of the consumer about the trademark owner's product and he can no more be confident that the product being sold or the service being rendered under that well known brand will prove to be of expected standard or quality.

9. Article 6bis of Paris Convention, 1967 enjoined upon the Countries of the Union, subject to their legislation so permitting or at the request of the interested parties, to refuse or to cancel the registration and to prohibit the use of trademark which constitutes a representation and imitation or translation liable to create confusion of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of Convention and used for identical or similar goods. This provision was also to apply when the essential part of the mark constituted a reproduction of any such well known mark or an imitation liable to create confusion therewith. The prohibition against use of a well known trademark, under Paris Convention, was, thus, to apply only when the impugned use was in respect of identical or similar goods. Vide Article 16 of TRIPS Agreement 1994, it was decided that Article 6bis of Paris Convention, 1967 shall apply mutatis mutandis to services as well as to goods or services, which are not similar to those in respect of which a trademark is registered, provided that the use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and the interests of the owner of the registered trademark and are likely to be damaged by the impugned use. It was further decided that in

determining whether the trademark is well known, the members shall take account of the knowledge of the trademark in relevant sectors of the public, including knowledge in the member concerned which has been obtained as a result of the promotion of the trademark. Thus, the TRIPS Agreement, 1994 brought about a material change by prohibiting use which constitutes a representation or imitation and is likely to create confusion even if such use is in relation to altogether different goods or services, so long as the mark alleged to have been infringed by such use is a well known mark. This Article, thus, grants protection against dilution of a trademark, which may be detrimental to the reputation that the business carried under a well known trademark enjoys.

10. Well known marks and trans-border reputation of brands was recognized by Courts in India, even before Trade Marks Act, 1999 came into force. In , the manufacturers of Mercedes Benz sought an injunction against the Defendants who were using the famous "three pointed star in the circle" and the word "Benz". The Court granted injunction against the Defendants who were using these marks for selling apparel. Similarly, in Whirlpool Co. and Anr. v. N.R. Dongre (1996) PTC 415 (Del.) the Plaintiff Whirlpool had not subsequently registered their trademark after the registration of the same in 1977. At the relevant time, the Plaintiff had a worldwide reputation and used to sell their machines in the US embassy in India and also advertised in a number of international magazines having circulation in India. However, the Defendant started using the mark on its washing machines. After an action was brought against them, the Court held that the Plaintiff had an established "transborder reputation" in India and hence the Defendants were injuncted from using the same for their products. In the Kamal trading Co. v. Gillette UK Limited (1998

IPLR 135), injunction was sought against the Defendants who were using the mark 7'O Clock on their toothbrushes. This was further reaffirmed by the Bombay High Court, which held that the Plaintiff had acquired an extensive reputation in all over the world including India by using the mark 7'O Clock on razors, shaving creams. The use of an identical mark by the Defendant would lead to the customer being deceived."

30. Applying the tests laid down for determining a well-known mark, the KINDER TRADE MARK has been in use for almost two decades now and has gained immense goodwill and reputation around the world. The said marks are solely associated with the Ferrero Group. The Ferrero group also enjoys the status of registered proprietor for 'Kinder Trade Marks' in more than 180 countries. Plaintiff No. 1 is also the registered proprietor of its unique wave design and for the word mark KINDER under registration number 302455 in India. The sales figures and the promotional figures also exhibit the high quality of goods and services under the trademark and the trademark is a commonly known trademark amongst children and adolescents. Hence, a decree in favour of the plaintiff and against the defendant in terms of prayer (v) of para 53 is passed declaring the 'KINDER' as a well-known trademark.

31. Learned counsel for the plaintiff's states that she does not press the relief of damages as per prayer (viii) of para 53. Plaintiffs also does not press prayers (vi) and (vii) of para 53. Hence no decree is being passed in terms of prayers (vi),(vii) and (viii).

32. As regards cost, the plaintiffs has not filed an affidavit indicating the actual cost incurred by the plaintiff, however the court-fee paid by the plaintiffs amounts to ₹2,05,000.

33. Suit is accordingly decreed in terms of prayer (i), (ii), (iii), (iv) and (v) of para 53 of the plaint in favour of the plaintiffs and against the defendants. Cost of ₹2,05,000 is awarded in favour of the plaintiffs and against the defendants.

I.A. 5127/2019 (under Order XXXIX Rule 1 and 2 CPC)

I.A. 5128/2019 (under Order XI Rule 1(4) CPC)

I.A. 5129/2019 (under Section 151 CPC)

Disposed of as infructuous.

(MUKTA GUPTA)
JUDGE

DECEMBER 18, 2019
'mv/sk'