

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

% Judgment delivered on: 28.11.2011

+ **C.S. (OS). No.2248/2007**

M/S ECOLAB INCPlaintiff

Through: Mr S.K. Bansal, Adv. with Mr Ajay
Amitabh Suman and Mr Harsh
Vardhan, Advs.

Versus

M/S EACO LABS LTDDefendant

Through: Defendant is *ex-parte*.

CORAM:-

HON'BLE MR JUSTICE MANMOHAN SINGH

MANMOHAN SINGH, J.

1. This is a suit under Section 134 and 135 of the Trade Marks Act, 1999 for permanent injunction to restrain infringement, passing off, damages and rendition of account.

CASE OF THE PLAINTIFF AS PER PLAINT

2. The plaintiff is a corporation under the Laws of United States of America. It was incorporated in the year 1924 with the name and style of Economic Laboratory and in the year 1986 it was changed to M/s Ecolab Inc. Mr. Edward R. Courtney, Trademark Attorney is the authorized signatory.

3. The plaintiff is into a business of manufacture and trade of premium cleaning, pest elimination and repair products having wide application in the hospitality, food service, healthcare and industrial markets and other areas as well.

4. Apart from the above services the plaintiff manufactures and markets numerous products which include detergents, instruments care, skin care, surgical scrub, surface disinfectants and other things.

5. Since 1924, the plaintiff has been engaged in the said business. In year 1986 the plaintiff bonafidely adopted and changed its name or word mark "Ecolab" from "Economic Laboratories". Since then the plaintiff has been using the said trade name and house mark under the said style as an essential part of its corporate name and a house mark in relation to its goods and business.

6. With the advent of e-commerce, the said Ecolab trade name/trade mark has been used by the plaintiff in the domain of www.ecolabs.com and has been since associated with good business and goodwill.

7. The details of the said trade mark Ecolab is duly registered in India in favour of the plaintiff. The details of the trademarks of the plaintiff are herein mentioned below:-

1	Trade name	Ecolab
	Application No.	461913
	Date	17 th October 1986
	Class	1
	Goods	Chemical products used in industry, detergents for use in industrial and manufacturing process, cleaning composition for industrial purposes, chemical products used in laundries and ware washing process, water treatment chemicals, chemicals for treating fabrics, chemical degreasing agents, antistatic and anti fog preparation; chemical oil and fuel additives; surfactants; de-scalers; catalysts; industrial solvents;

		corrosives; metal conditions; chemical machine fluids; phocphatizres.
	Journal	980

2	Trade name	Ecolab
	Application No	461914
	Date	17 th October 1986
	Class	3
	Goods	Bleaching preparation and other substances for laundry use; cleaning; polishing; scouring and abrasive preparations; stain removing preparation, paint removing preparation; soaps, detergents; fabric softeners; rising agents; laundry starch; cleaning solvents.
	Journal	979

3	Trade name	Ecolab
	Application No	461915
	Date	17 th October 1986
	Class	5
	Goods	Preparation for killing weeds and destroying vermins, herbicides, fungicides, parasiticides, bactericides, germicides, insecticides, slimicides,, veterinary and sanitary substance, disinfectants, sanitizers, deodorants, air fresheners, insect repellants.
	Journal	970
4	Trade name	Ecolab

	Application No	461916
	Date	17 th October 1986
	Class	7
	Goods	Laundry and ware washing machines, machinery for cleaning, polishing and scrubbing parts and accessories therefore are being goods includes in class 7.
	Journal	1001

5	Trade name	Ecolab
	Application No	461917
	Date	17 th October 1986
	Class	9
	Goods	Mechanical electric and electronic apparatus to measure and/or dispense liquid, powdered or solid chemicals, detergents, cleaning and rinsing agents, parts and accessories.
	Journal	979

8. Plaintiff states that the above registrations are legal, regular and in full force. By this registration the plaintiff has exclusive rights over the said registered trade mark.

9. Plaintiff states that trade mark ECOLABS (word per se stylized, logo or labels) are duly registered in favour of the plaintiff for goods in class 1,3,5,6,7,9,11,35,40,42,47 in over 100 countries in North & South America, Europe, Africa, Asia, Asia Pacific, Australia and many other countries.

10. The plaintiff state that the art work involved in the plaintiff's Ecolab stylized trade mark as also its various logo and label is the original artistic work within the meaning of the Indian

Copyright Act 1957. Plaintiff is the owner and proprietor of the copyright therein.

11. The goods of the plaintiff are well known, recognized, demanded, sold and traded world over with reference to the trade name/ mark/house mark/ domain name. The said domain name is well known and recognized by the public at large. The plaintiff's trade mark/trade name/domain name has a strong presence in India. Apart from that, trans-border reputation is also relied upon by the plaintiff.

12. The plaintiff has been promoting the business through e-commerce. The plaintiff initially offered its goods through an Indian company. The plaintiff has already got the subsidiary of the Indian company in the trade name of M/s Ecolab Food Safety & Hygiene Solution Pvt. Ltd.

13. Plaintiff, apart from excellent quality of the said goods and business, lays tremendous application on research and development and spends a great emphasis on innovation. By 1960, the plaintiff had more than 50 patents and 200 plus people are employed in the research department. In 1962, plaintiff completed state of art Merit J. Osborn Research & Development Center.

CASE AGAINST DEFENDANT AS PER PLAINTIFF

14. The defendant company is incorporated under Indian Companies Act 1956 and is engaged in the business of manufacture and trade of medical and pharmaceuticals preparations and allied goods (hereinafter referred to as "impugned goods").

15. The defendant adopted the word Ecolabs as an essential and distinguishing feature of its impugned trade name. The name adopted by the defendant is phonetically, visually, structurally in its basic idea and in its essential features.

16. The defendant has not only adopted the trade name/word mark of the plaintiff but has also infringed the registered trade mark under Nos. 461913 in Class 1, 461914 in Class 3, 461915 in Class 5, 461916 in Class 7 and 461917 in Class 9. Defendant is not exonerated from these charges of falsification, unfair and unethical trade practices.

17. Defendant is fully aware of the plaintiff's rights, goodwill, reputation, benefits and user etc in the plaintiff inspite of this, defendant is blatantly using the same mark. Due to the defendant's unlawful and impugned activities there are losses suffered by the plaintiff.

THE CASE OF THE DEFENDANT

18. The defendant states that plaintiff has filed the present suit with dishonest intention and stated false facts.

19. Defendant states that the plaintiff could have easily obtained proper verification from the ROC to ascertain the name of M/s Eacolab Ltd. but plaintiff did not do that properly.

20. Defendant states that defendant is prior user of the name and has adopted prior user. Defendant states that the plaintiff obtained the name by furnishing false particulars.

21. In the amendment pertaining to change in name of plaintiff for change of name of plaintiff from M/s Economic Laboratory Inc to M/s Ecolab Inc was to be effective from 01.12.1986. But, the applications for registration of trade mark Ecolab filed by plaintiff bears the following dates.

Registration & Class	No.	Date of filing	Filed by
461316/1		October 1 st , 1986	M/s Ecolab Inc
461913/1		October 17 th , 1986	“

461914/3	“	“
461915/5	“	“
461916/7	“	“
461917/9	“	“

22. In all the above application/registration filed by M/s Eco Lab Inc. the date of filing principally is the month of October 1986, whereas as per the plaintiff, the alleged change of name of plaintiff from M/s Economic Laboratory to M/s Ecolab came into operation only in December 1986. In October 1986 there was no company existing in the name of M/s Ecolab Inc and the aforesaid applications are filed in the name of a non existing company. Hence, it is clear that plaintiff deliberately furnished false, wrong details and concocted facts. Because of these false facts the trademark is liable to be dismissed and cancelled.

23. The suit is liable to be dismissed on the ground of delay and laches. The plaintiff has known this fact since 21.10.1986 but till now they have not come forward. It is only after a lapse of 10 years that they have filed this suit and all these years they were sitting silent on the matter.

24. Defendant denies that plaintiff is in numerous manufacturing products. Defendant also denies that the plaintiff, since 1924 is engaged regularly (put from file) and defendant also denies that plaintiff has bonafidely and honestly adopted the trade name Ecolab from Economic Laboratories.

25. The plaintiff in addition to Ecolab trade mark/trade name has been using numerous other trademarks/trade name, like Endure, ASEPTI-Solid, Lapid-Zyme, Nature Mild, Bacti-Stat, Medi-Scrub etc. The plaintiff pirated the name of the defendant.

26. Defendant submits that if the plaintiff has been doing business bonafely, openly, honestly, continuously, commercially then why the plaintiff has not filed any proof along with the plaint to establish their user.

27. The defendant also states that plaintiff has been carrying on business in India. The plaintiff cannot show any effective sales in India. The goods are also not available in the market and hence it is inconsequential to the claims raised by the plaintiff in their plaint.

28. The defendant denies that plaintiff has been publicizing the trade name through newspaper, magazines and other electronic form about their product.

29. After the filing of the written statement, the defendant was proceeded *ex-parte* vide order dated 18.08.2009. The defendant also filed the counter claim which was also dismissed for non-appearance on the said date. The plaintiff was given time to file the ex-parte evidence which was filed by way of affidavit of Sh. Edward R. Courtney, who has almost reiterated the statements made in the plaint.

30. The said trade mark ECOLAB (word per se) is duly registered in India in favour of the plaintiff under Nos.461913 in class 01, 461914 in class 03, 461915 in class 05, 461916 in class 07 and 461917 in class 09 in relation to the goods mentioned in para 7 of the plaint. Legal Proceedings Certificate of the plaintiff's Registered Trade Mark "ECOLAB" under Nos. 461917 in class 9, 461916 in class 7, 461913 in class 1 and 461915 in class 5 are placed on record as Exh. PW1/12, Exh.PW 1/13, Exh. PW 1/14 and Exh. PW 1/15 with Index dated 02.05.2008.

31. The plaintiff's said Trade Mark ECOLAB (word per se, stylized, logo or labels bearing the same) are duly registered in relation to a wide range of goods falling in classes 1, 3, 5, 6, 7, 9, 11,

35, 37, 40, 42 and 47 in over 100 countries of the world and across all regions and continents including countries in North and South America, Europe, Africa, Asia, Asia Pacific, the Middle East, Australia etc. Original list of registered Trade Mark of the plaintiff company in different countries of the world are placed on record as Exh. PW 1/7 with list of documents dated 11.10.2007.

32. The plaintiff's products and services reaches customers in more than 160 countries including India wherein in addition the plaintiff enjoys its trans border reputation and users thereof as extending into India. The plaintiff's said goods and business are sold, traded and marketed by the plaintiff directly or through its wide network of associates and affiliates and through retail, internet and e-commerce. Sales figure of the plaintiff is placed on record as Exh. PW 1/6. Original documents downloaded from the internet, pertaining to the history of the plaintiff company is placed on record as Exh. PW 1/8 and showing the plaintiff's presence in India is placed on record as Exh. PW 1/9. Original brochure of the plaintiff company regarding plaintiff's product is placed on record as Exh. PW 1/10. The said exhibits are filed with the list of documents dated 11.10.2007.

33. Admittedly, in the present matter the defendant company was incorporated on 21.10.1986 and the permission was given to commence the business with effect from 11.12.1986. The defendant has placed photocopies of some of the documents. However, no original documents have been filed by the defendant. On the other hand, the plaintiff's application for registration of the trademark ECOLAB was filed on 17.10.1986. It is also a matter of fact that the plaintiff's application for registration of the trade mark ECOLAB was filed in United States Patent and Trademark Office on 12.05.1986.

All the above said trademarks are registered in India. Therefore, it appears from the record that it is the plaintiff who has adopted and used the trademark ECOLAB prior to the date of adoption and user of the defendant. Therefore, the defendant is incorrect in saying that it is the earlier user of the trademark and is the proprietor of the same. The plea of the defendant, therefore, cannot be accepted in view of the documents placed on record by the plaintiff.

34. Since the plaintiff's evidence has gone unrebutted as the defendant has also failed to cross-examine the witness of the plaintiff, the evidence filed by the plaintiff is liable to be taken as correct. The defendant, on the other hand, has failed to produce any evidence in support of its claim.

35. Admittedly, the plaintiff being the registered proprietor of the trade mark, in case the defendant will use the mark ECOLAB as a trademark and/or trade name, it would be infringing the trademark of the plaintiff. The following judgments are relied upon by the plaintiff:

- (i) **Ellora Industries, Delhi Vs. Banarsi Dass and Ors. Delhi, 1981 PTC 46.**
- (ii) **Montari Overseas Ltd. Vs. Montari Industries Ltd., 1996 PTC 16**
- (iii) **Midas Hygiene Industries P. Ltd. & Anr. Vs. Sudhir Bhatia & Ors., 2004 (28) PTC 121 (SC)**
- (iv) **Milment Oftho Industries & Ors. Vs. Allergan Inc., 2004 (28) PTC 585 (SC)**
- (v) **Century Traders Vs. Roshan Lal Duggar & Co. and Ors., AIR 1978 Delhi 250.**

36. After having gone through the above said decisions referred to by the learned counsel for the plaintiff, I am of the considered view that the plaintiff is entitled to a decree for permanent injunction in favour of the plaintiff and against the defendant in terms of para 36 (a) and (b) of the plaint. As regard the other reliefs are

concerned, the plaintiff has not been able to prove the same. Therefore, the same are rejected. However, the plaintiff is entitled to the costs of the suit. Decree be drawn accordingly.

MANMOHAN SINGH, J.

NOVEMBER 28, 2011