

Designarch Consultants Pvt. Ltd. & Anr vs Jumeirah Beach Resort Llc on 10 September, 2020

Author: Mukta Gupta

Bench: Mukta Gupta

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* IN THE HIGH COURT OF DELHI AT NEW DELHI
+ CS(COMM) 366/2020

DESIGNARCH CONSULTANTS PVT. LTD. & ANR.
Represented by: Ms.Shwetashree Majum
Arora and Ms.Eva Bis

versus

JUMEIRAH BEACH RESORT LLC.
Represented by: None

CORAM:
HON'BLE MS. JUSTICE MUKTA GUPTA
ORDER

% 10.09.2020 The hearing has been conducted through Video Conferencing. I.A. 7794/2020 (exemption from filing clear copies)

1. Exemption allowed, subject to all just exceptions.
2. Original documents, if any, be filed within two weeks of the resumption of the normal Court functioning.
3. Application stands disposed of accordingly. I.A. 7793/2020 [under Order XI Rule 1 (4) CPC]
1. Additional documents be filed within 30 days from today.
2. Application stands disposed of accordingly.

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1. Plaint be registered as a suit.
2. Issue summons of the suit to the defendant on plaintiffs' taking steps through e-mail, Whatsapp, SMS, returnable before this Court on 19 th January, 2021.

3. Written Statement and reply affidavit to the application shall be filed by the defendant within 30 days from the receipt of the summons along with affidavit of admission/denial. Replication and rejoinder thereto alongwith the affidavit of admission/ denial of documents be filed within three weeks thereafter.

4. Claim of the plaintiff in the present is that the plaintiff company was incorporated on 31st July, 1991, whereafter they are carrying on the construction business. The plaintiff is the proprietor of the trade mark BURJNOIDA, which was first used in India by the plaintiff on 24 th December, 2010 which had been registered under Class-37 in favour of the plaintiff with effect from 2nd February, 2011, the date on which the application was filed in respect of 'building construction, repairs and installation services'.

5. Pursuant to the filing of the application for registration of mark BURJNOIDA in class 37, plaintiffs group company E-Homes Infrastructure Pvt. Ltd. entered into an agreement with M/s Engineering Creations to provide structural design analysis of Burj Noida tower on 30 th May, 2011 and thereafter, after preparing the lay out and revised lay out, the plaintiff are in the process of construction of the said building. The plaintiff registered its domain name www.burjnoida.com on 30th August, 2018 and was granted registration of the copyright under the application No. A-

Signing Date:10.09.2020 21:47:13 This file is digitally signed by PS to HMJ Mukta Gupta 128569/2019 titled s 'Burj Noida - Tower A Area Plan, Floor Plan, Elevation and Section V', which shows the image of the entire building including the doppler sound wave inspired external encasing. Besides the said registration, plaintiff has 12 other copy right registrations for BURJNOIDA. The plaintiff No. 1's device mark/ logo was also registered in India on 21st September, 2019. The plaintiffs' claim to have spent a substantial amount towards construction, as also advertisements, branding and channel partner development.

6. Grievance of the plaintiff is that defendant issued a legal notice to the plaintiff No. 1 on 13th August, 2020 on the groundless and unjustified allegations of trademark infringement of its mark 'BURJ AL ARAB' and of its devise mark and infringement of its copyright in the shape of the 'Burj Al Arab' hotel building. The defendant has registration in Classes 35, 36, 39, 41, 42 for 'BURJ AL ARAB' and not in Class 37 in respect of its logo.

7. The defendant has no presence in India and has a resort at United Arab Emirates. The logo of the defendant is also quite distinct from that of the plaintiffs. Further the entrance of the Hotel Burj Al Arab show the mark instead of the mark .

8. Learned counsel for the plaintiffs further submits that Burj is a Signing Date:10.09.2020 21:47:13 This file is digitally signed by PS to HMJ Mukta Gupta common word in Arab meaning a 'tower' and there are various registrations for the mark Burj alongwith suffixes even in India. As per learned counsel for the plaintiff mark 'BURJ' per se is a public juris in country of origin and is capable of registration only with a prefix or suffix and thus, according to the plaintiff the mark 'BURJNOIDA' is a fanciful and arbitrary trademark in India. The defendant cannot claim infringement for the reason, the two marks are different, the defendant mark being 'BURJ AL ARAB' and the plaintiffs'

mark being 'BURJNOIDA' and also no case of passing off is made out because plaintiff has not been able to show that it has any presence in India or the trans-border reputation. Further, violation of the right in respect of the logo claimed by the defendant is also incorrect for the reason that defendant has no registration of the logo in its favour, whereas the plaintiffs' logo is duly registered in India.

9. The third threat given by the defendant in its legal notice relates to the shape of the building. The learned counsel for the plaintiff has placed on record the difference in the two shapes. The shape of the building is also different as is evident from Para 52 of the plaint, as under:

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10. Plaintiffs have also placed on record material to show that the shape of defendant's building is also not unique and there are other buildings with similar shapes.

11. Considering the averments in the plaint and the documents filed therewith, the plaintiff has made out the prima facie case in its favour and in case, no ex parte ad interim injunction is granted, plaintiff would suffer an irreparable loss.

12. Consequently, till the next date of hearing, defendant, its directors, proprietors, partners, owners, agents dealers are directed to give atleast seven days' prior notice to the plaintiff at the address mentioned in the cause title of the plaint before initiating any proceedings including legal proceedings in any Court claiming infringement and/or for passing off the defendant's mark, logo or the shape by the plaintiff. Defendant is also further restrained from extending any threat to the plaintiff or any of its assignees, agents etc. in relation to the registered mark/ logo or the design of the plaintiffs' building till the next date of hearing.

13. Compliance affidavit under Order 39 Rule 3 CPC be filed within a week.

14. List on 19th January, 2021.

15. Order be uploaded on the website of this Court.

MUKTA GUPTA, J.

SEPTEMBER 10, 2020 PB Signing Date:10.09.2020 21:47:13 This file is digitally signed by PS to HMJ Mukta Gupta