

Singh & Singh Law Firm Llp & Anr vs Singh + Singh Lawyers Llp & Ors on 2 June, 2021

Author: Sanjeev Narula

Bench: Sanjeev Narula

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IN THE HIGH COURT OF DELHI AT NEW DELHI

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CS(COMM) 263/2021

SINGH & SINGH LAW FIRM LLP & ANR.

..... Plaintiffs

Through: Mr. Rajiv Nayar, Mr. Sandeep Sethi
and Mr. Chander M Lall, Senior
Advocates with Mr. Saurabh Seth and
Mr. Tanmaya Mehta, Advocates.

versus

SINGH + SINGH LAWYERS LLP & ORS.

..... Defendants

Through: Mr. Divjyot Singh, Ms. Avsi Malik
and Mr. Nipun Dwivedi, Advocates
for D-1, 2 & 4.
Mr. Nimish Chib, Advocate for D-3
& 5.
Mr. Alipak Banerjee, Advocate for
D-6 & 7.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA
ORDER

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02.06.2021

[VIA VIDEO CONFERENCING]

I.A. 7144/2021 (for exemption)

1. Exemption allowed, subject to all just exceptions.

2. The application is disposed of.

I.A. 7145/2021 (for exemption from filing affidavit without notarization/attestation and for exemption for vakalatnamas from bearing seal /stamp of Plaintiffs)

3. The present application under Section 151 of the Code of Civil Procedure, 1908 (in short 'CPC') on behalf of the Plaintiffs seeks exemption from filing affidavits without notarization/attestation and further, seeks exemption from filing vakalatnamas without seal/stamp of the Plaintiffs.

4. The Plaintiffs submit that due to the current COVID-19 pandemic and resultant restrictions, they are unable to file the notarized/attested affidavits and the stamped vakalatnamas. Due to the urgency of the matter, Plaintiffs have filed the subject suit without the abovementioned documents.

5. The application is allowed, subject to the Plaintiff filing the exempted documents within two weeks from the day the lockdown restrictions imposed by the Government of NCT of Delhi are lifted and the facility for attestation of affidavits is resumed.

6. The application stands disposed of.

I.A. 7146/2021 (seeking exemption from filing the requisite court fee)

7. The present application under Section 149 read with Section 151 of the Code of Civil Procedure, 1908 (in short 'CPC') on behalf of the Plaintiffs seeks exemption from filing the requisite court fee.

8. The Plaintiffs submit that due to the current COVID-19 pandemic and resultant restrictions, they are unable to procure the necessary court fee stamps. Due to the urgency of the matter, Plaintiff has filed the subject suit without the court fee.

9. The application is allowed, subject to the Plaintiffs filing the requisite court fee within two weeks from the day the lockdown restrictions imposed by the Government of NCT of Delhi are lifted and the facility for obtaining court fees is resumed.

10. The application stands disposed of.

I.A. 7147/2021 (u/O 11 R 1(4) of the Commercial Courts Act, 2015 r/w Section 151 CPC seeking leave to file additional documents)

11. This is an application seeking leave to file additional documents under the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 (in short 'Commercial Courts Act').

12. The Plaintiffs, if they wish to file additional documents at a later stage, shall do so strictly as per the provisions of the Commercial Courts Act.

13. Accordingly, the application stands disposed of.

I.A. 7148/2021 (for seeking exemption from Pre-Litigation Mediation under Section 12A of the Commercial Courts Act, 2015)

14. The Plaintiffs have filed the present application seeking exemption from pre-litigation mediation under Section 12A of the Commercial Courts Act. The Plaintiffs urge that since there is an urgency in the matter so it may be exempted from the mandate of Section 12A of the Commercial Courts Act.

15. For the grounds and reasons stated in the application, the same is allowed, subject to just exceptions.

16. The application stands disposed of.

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17. Let the plaint be registered as a suit.

18. Issue summons. Summons are accepted by Mr. Divjyot Singh, learned counsel for the Defendant Nos. 1, 2 and 4, Mr. Nimish Chib, learned counsel for the Defendant Nos. 3 and 5 and Mr. Alipak Banerjee, learned counsel for the Defendant Nos. 6 and 7. The written statements shall be filed by the Defendants within 30 days from today. Along with the written statement, the Defendants shall also file an affidavit of admission/denial of the documents of the Plaintiffs, without which the written statements shall not be taken on record.

19. Liberty is given to the Plaintiffs to file replications within 15 days of the receipt of the written statements. Along with the replications, if any, filed by the Plaintiffs, an affidavit of admission/denial of documents of the Defendants, be filed by the Plaintiff, without which the replications shall not be taken on record. If any of the parties wish to seek inspection of any documents, the same shall be sought and given within the timelines.

20. List before the Joint Registrar for marking of exhibits on 2nd August, 2021. It is made clear that any party unjustifiably denying documents would be liable to be burdened with costs.

21. List before Court for framing of issues thereafter on 23rd September, 2021.

I.A. 7143/2021 (under Order 39 Rule 1 and 2)

22. The Plaintiffs have filed the instant application under Order 39 Rule 1 and 2 CPC in the suit seeking protection of their mark/name 'Singh & Singh'. The Plaintiffs are aggrieved by the use of identical marks 'Singh + Singh'; 'Singh + Singh Lawyers LLP' and other derivatives, by Defendant Nos. 1 to 5.

23. The case of the Plaintiffs, as set out in the plaint is that the name 'Singh & Singh' was coined and used by the founders as the name of the law firm. The same has been in use since 1997 and is currently in use by Plaintiff No.

1. The details of the trademark registration in the name of Plaintiff No. 2 are as under:

S.No.	Mark	Date of Application	Regd. No.	Class	Services
1.		22.12.2005	1408313	42	all kinds of legal services

24. The abovementioned registrations are valid and subsisting in the Register of Trademarks. The Plaintiff No. 1 firm has, over the years of its functioning, expanded into several branches of law, including Constitutional law, Commercial Laws, Arbitration and Intellectual Property. The firm has required enormous acclaim and fame in India and in several foreign countries and has rendered services to Indian as well as foreign clients. The firm's clientele hail from different parts of the world such as USA, Canada, Japan, Australia etc. Over the years, Plaintiff No. 1 has become one of India's leading law firms in the fields of Intellectual Property litigation, Information Technology, Technology, Media and Telecommunication (TMT) and related aspects. The plaint also sets out the details of the various accolades and awards received by the firm. The lawyers of the firm are members of International Organizations as INTA, APAA, AIPPI, FICPI etc., and they attend the conferences which are held by these organizations every year. These conferences are global and are held in various parts of the world, including USA, Canada, Germany, Australia etc.

25. Mr. Rajiv Nayar, Mr. Chander Lall and Mr. Sandeep Sethi, learned Senior Counsel for the Plaintiffs submit that in May 2021, the Plaintiffs were surprised to find a post on social media using the name 'Singh + Singh LLP' and 'Singh + Singh Lawyers LLP' (Defendant No. 1). On further research, they were shocked to note that the said name was being used by the husband of Defendant No. 3 i.e., Defendant No. 2 along with another partner i.e., Defendant No. 4. Defendant No. 3 used to work as an associate in the Plaintiff No. 1 firm in 2010-2011, a fact admitted by her on her Facebook profile. Defendant Nos. 2 and 3 are registered with the Bar Council of Delhi. Defendant No. 5 claims to be a business development and account management professional with an MBA degree and an ex-employee of Ernst & Young (E&Y) and a perusal of his LinkedIn profile reveals that he is associated with 'Singh + Singh' and claims to be involved in business development and client relationships.

26. Prior to May 2021, neither Defendant No. 2 nor Defendant No. 4 used 'Singh' as part of their trading style and ran their individual legal practices under the name and style 'GSC Law' with its website 'www.gsclaw.ca' and 'KSK Law' having the website 'www.kohlilaw.com'. The conspicuous absence of the word 'Singh' in the trading styles or names of any of the Defendants shows that Defendant Nos. 2 and 4 have changed to the impugned name in May 2021 deliberately and with full knowledge of the Plaintiffs' rights in the mark 'Singh & Singh' to encash upon the same. The name 'Singh & Singh' has been registered since 2005 in respect of legal services and has been in use since 1997. The name 'Singh & Singh' and 'Singh + Singh' are identical to each other and there is a clear case of infringement under Section 29(2)(c) of the Trademarks Act, 1999 (in short 'the Act') for which there is presumption of confusion under Section 29 (3) of the Act. Besides, it is also contended that Defendant No. 3 being an ex-associate of the Plaintiff No. 1 law firm and Defendant No. 2 being the spouse of the said ex-associate, the adoption of the impugned name is deliberate,

malafide and has been coined with the sole intention of encashing upon the enormous transborder reputation and international goodwill that the mark 'Singh & Singh' enjoys and carries. The counsel also referred to the documents placed on record to demonstrate that the adoption of the impugned mark by the Defendants is dishonest and use of such an identical name would inevitably cause confusion and deception amongst the various litigants and would give Defendants an unfair advantage.

27. Mr. Divjyot Singh, learned counsel for Defendant Nos. 1, 2 and 4 who appears on advance notice submits that there is no urgency in the matter, and that he should be given an opportunity to file a written statement and reply to the application, before considering grant of interim relief. Mr. Singh further submits that the use of the mark 'Singh + Singh' by the Defendants is completely bonafide. He explains that Defendant No. 1 firm is founded by Defendant Nos. 2 and 4 in Toronto, Canada and has been registered with a Law Society in Ontario. The areas of practice of this firm do not overlap with the practice areas of the Plaintiff No. 1 firm. The Defendant No. 1's practice is confined to Ontario and as per law, they cannot practice beyond the jurisdiction of Ontario, Canada, and in any case, certainly not in India. In these circumstances, Mr. Singh submits that since the Defendants are not servicing any clients in India, the Plaintiffs are not prejudiced by the use of the mark 'Singh + Singh' by the Defendants and therefore there is no ground or reason to grant an injunction. Mr. Singh urges that Defendant No. 2 is a permanent resident of Canada and Defendant No. 4 is a citizen of Canada. They are young lawyers, who are establishing their practice in Canada and any interim order by this Court would impact their law practice. Mr. Singh further clarifies that although, Defendant No. 2 is registered with the Bar Council of Delhi, he is no longer practicing in India. It is also contended that since Defendant Nos. 2 and 4, in association, have started the Defendant No. 1 firm by the name of 'Singh + Singh', with valid registration in accordance with the laws of Canada, there is no case for grant of any injunction. He further relies upon Section 35 of the Act, to contend that 'Singh' being part of the name of Defendant No. 2, entitles him to the use of the word 'Singh' as part of his firm name. In view of the protection provided under the said provision, injunction cannot be granted, merely because the name of the Defendant No. 2 is a part of the trade name of the Plaintiffs. Lastly, by referring to para 47 of the plaint, it is contended that since the Defendants have no office or practice in India, and Plaintiff No. 1 does not have any practice in Canada, this Court does not have the jurisdiction to entertain the present suit. Mr. Nimish Chib, learned counsel for Defendant Nos. 3 and 5 submits that Defendant No. 3 has no connection with Defendant No. 1, and presently she is not practicing law. As far as Defendant No. 5 is concerned, it is contended that he was associated with 'GSC Law', however that association is not continuing in respect of 'Singh + Singh' i.e., Defendant No. 1 firm.

28. The Court has considered the contentions of the parties. In the prima facie view of the Court, the facts conspicuously demonstrate that the infringing marks are identical marks/names; are being used for identical services; and identical class of customers/clients. Merely because the Defendants contend that they are currently practicing only in Canada, cannot be a ground to refuse the grant of injunction. The profile of the Plaintiff No. 1, as noted above, and as delineated in the plaint, clearly indicates that Plaintiff No. 1's law practice is not confined to India. Plaintiff No. 1 has a global reputation and goodwill and is servicing clients across the globe. On this aspect, the documents placed on record support the assertions made in the plaint. The Court also finds prima facie merit in

the contention of the Plaintiffs that nowadays legal services are rendered across the globe through internet and electronic means. In this internet-driven world, law firms such as the Plaintiff No. 1 would have a reputation which is not limited by geographical boundaries. Therefore, there is a strong possibility of confusion amongst the foreign clients/law firms relating to the two marks which are predominantly identical. There is a strong likelihood that they would be led to believe that 'Singh + Singh' is another branch or an associate office of 'Singh & Singh'. This Court is also of the prima facie opinion that the use of the marks that are identical or deceptively similar to the trademarks of the Plaintiffs, is likely to cause confusion to the clients. Plaintiff No. 1 has significant and extensive digital presence. Thus, adoption of identical mark/name by the Defendants in deceptively similar colour combination on online platforms for providing legal services is fraught with mischief and does not appear to be bonafide. The comparative table showing the Plaintiffs' marks/names and the marks/names and derivatives being used by the Defendants is set out in the comparison table, in the plaint as extracted below:

S.No	Description	Plaintiffs	Defendants 1 - 5
1.	Mark/name	Singh & Singh	Singh + Singh
2.	Full name	Singh & Singh Law Firm LLP	Singh + Singh Lawyers LLP
3.	Abbreviated name	Singh & Singh LLP	Singh + Singh LLP
4.	Domain name/website	www.singhandsingh.com	www.singhllp.com
5.	LinkedIn Profile	www.linkedin.com/company/singh-singh-law-firm-llp	www.linkedin.com/company/gsclaw (Defendants are publicising the impugned name Singh + Singh on this URL)
6.	Twitter handle	@singh_llp	@singhsinghllp
7.	Facebook	@SinghandSinghLawFirmLLP	@Singh-Singh-LLP-102349685322467
8.	LOGOS		

Infact the likelihood of confusion is demonstrated by the Senior Counsel for the Plaintiffs' during the course of the arguments, by drawing the attention of this Court, to a printout of a post on the LinkedIn page of Defendant No. 2, to the following effect:

29. The above comments clearly exhibit the misunderstanding that may be caused by the use of identical marks by the Defendants. Defendant No. 2 is receiving congratulatory messages for

opening of an office bearing the name 'Singh and Singh LLP', which is the Plaintiff No. 1's name. Defendant No. 2 accepts the same without making any distinction. This confusion is bound to happen, as the marks are identical and thus needs to be prevented otherwise it would create an impression that the Defendant No. 1 firm is associated with the Plaintiffs. In the present scenario of law practice, where cross border reputation exists, the confusion amongst clients can have undesirable ramifications for the Plaintiffs, in case the Defendants are not enjoined by this Court.

30. Another fact brought to light by the counsel for the Plaintiffs is the similarity in the Twitter handle of the Plaintiff No. 1 and Defendant No. 1. While the Twitter handle of Plaintiff No. 1 is '@singh_llp', Defendant No. 1 uses '@singhsinghllp' (along with the website of the Defendant No. 1 being www.singhllp.com). This aspect, coupled with the fact that Defendants Nos. 2 and 3 were associated with 'Singh & Singh' earlier, seems to prima facie suggest that the Defendants have deliberately adopted the Plaintiffs' trademark. Further, it is not in dispute that Defendant No. 2 continues to be registered with the Bar Council of Delhi. Thus, the Plaintiffs have established a prima facie case. The balance of convenience lies in favour of the Plaintiffs, and they are likely to suffer an irreparable loss, in case the injunction is not granted.

31. Accordingly, till the next date of hearing, the Defendants, their partners/promoters, associates, family members, employees and anyone acting for and on their behalf are restrained from using the impugned marks including the name/mark "Singh + Singh", "Singh + Singh LLP", "Singh + Singh Lawyers LLP", singhllp.com, singhllp, [@singhllp](https://twitter.com/singhllp), [@singhsinghllp](https://twitter.com/singhsinghllp), Singh-Singh-LLP, the Singh + Singh impugned logo, or any other trademark/trade name/service name/trading style or domain name or Twitter handle, LinkedIn profile, Facebook profile, logo, device, etc., which is either identical to or deceptively similar to the Plaintiffs' mark(s) 'Singh & Singh', 'Singh & Singh Law Firm LLP', 'Singh & Singh.com', 'Singh & Singh Advocates' or any other derivatives thereof so as to result in infringement of trade mark(s), passing off, acts of unfair competition, dilution etc. for rendering legal services, consultancy services related to law, or any other cognate/allied services, at any place or in any form including in print or electronic media, online platforms etc.

32. Further, till the next date of hearing, the Defendant No. 6 is directed to suspend the domain name of 'www.singhllp.com'. Mr. Alipak Banerjee, learned counsel, appearing on behalf of Defendant Nos. 6 and 7 is directed to ensure compliance with the said direction.

33. Compliance of Order 39 Rule 3 be done within a period of one week from today.

34. List before the Joint Registrar for completion of pleadings on 2nd August, 2021.

35. List before the Court on 23rd September, 2021.

SANJEEV NARULA, J JUNE 2, 2021 nk