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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ **CS(COMM) 755/2022**
ULTRA TECH CEMENT LIMITED AND ANR Plaintiffs
Through: **Mr.Pravin Anand, Ms.Prachi Agarwal**
& Ms.Ridhie Bajaj, Advs.

versus

ULTRA PLUS CEMENT PVT.LTD AND ORS Defendants
Through: **Mr.Ayush Sharma & Mr.Pawanshree**
Agarwal, Advs.

CORAM:
HON'BLE MR. JUSTICE NAVIN CHAWLA

ORDER
% 04.11.2022

CS(COMM) 755/2022

1. Let the Plaint be registered as a suit.
2. Issue summons to the defendants.
3. Summons are accepted by Mr.Ayush Sharma, the learned counsel on behalf of the defendants. He is granted thirty days time to file written statement(s). Along with the written statement(s), the defendants shall also file the affidavit(s) of admission/denial of the documents of the plaintiffs, without which the written statement(s) shall not be taken on record.
4. Liberty is given to the plaintiffs to file the replication(s) within a period of three weeks of the receipt of the written statement(s). Along with the replication(s), if any, filed by the plaintiffs, the affidavit(s) of admission/denial of documents of the defendants be filed by the plaintiffs, without which the replication(s) 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.

5. List on 20th December, 2022.

I.A. 17733/2022

6. Issue Notice.

7. Notice is accepted by Mr. Ayush Sharma, the learned counsel on behalf of the defendants. He prays for and is granted a period of two weeks to file reply. Rejoinder thereto, if any, be filed within a period of two weeks thereafter.

8. It is the case of the plaintiffs that the plaintiffs are carrying on business of manufacture, marketing and sale of cement and other allied goods and services, *inter alia*, under the 'UltraTech' formative marks such as 'UltraTech Cement', 'UltraTech Concrete and Birla White', 'UltraTech Building Solutions' and 'UltraTech Building Products'. The plaintiff no. 1 is one of the largest manufacturers of grey cement, white cement, and ready-mix concrete, and is the third-largest cement producer globally (excluding China) with operations in four countries, namely, India, U.A.E., Bahrain and Sri Lanka. The plaintiff no.1 is a market leader in the said products with a consolidated revenue of Rs. 52,599 Crore (Rupees Fifty-Two Thousand Five Hundred Ninety-Nine Crore only) in the Financial Year 2020-21. The consolidated revenue of the plaintiff no.2 is stated to be Rs. 95,701 Crore (Rupees Ninety-Five Thousand Seven Hundred One Crore only) during the same period.

9. It is stated that the plaintiffs adopted the mark 'UltraTech' in India in the year 2003 with respect to cements. The words 'UltraTech/UltraTech Cements/Ultra' form an essential, prominent and distinguishing feature of the marks used by the plaintiffs. The plaintiffs have also given details of

registrations of their marks in paragraphs 17 to 19 of the plaint.

10. The plaintiffs further assert that their mark '**UltraTech**' has been added to the list of '*well-known trade marks*' maintained by the Registrar of Trade Marks at Sl. No. 79, pursuant to the orders of the High Court of Bombay dated 12.12.2011 and 30.01.2012 in Suit No. 443/2012, recognising the trade mark '**UltraTech**' to be a well-known trade mark.

11. The plaintiffs state that in a recent market survey conducted between 30.07.2022 and 04.08.2022 in six cities in the State of Rajasthan, it was reported that people in the trade associate the mark '**Ultra**' with plaintiffs' '**UltraTech**' products.

12. The plaintiffs also expended huge amounts in advertising and promoting their brand, the details of such expenditure are given in paragraph 31 of the plaint.

13. The plaintiffs further assert that it has been zealously protecting the above marks by taking various civil actions against the parties adopting the similar marks, the details of such litigations also being given in the plaint.

14. The plaintiffs assert that the defendants have adopted a deceptively similar mark '**Ultra Plus**' not only as a corporate name of the defendant no.1, but also as a trade mark. It was in May 2020 that the plaintiffs became aware of the adoption of the similar mark by the defendant no.2 for manufacturing, marketing and selling cement, and later learned that the defendant no.2 has also filed an application in Class 19 seeking registration of the mark '**Ultra Plus**', being application no. 3939342 on 08.09.2018.

15. The plaintiffs thereafter sent a cease and desist notice to the defendant no.2 dated 30.05.2020. The defendant no.2 did not send any response to the same. The plaintiffs also filed an opposition against the above application of

the defendant no.2 seeking registration of the mark '**Ultra Plus**', and on further investigation found that the defendant no.3, is the director of the defendant no.1 and a partner in the defendant no.2. It was further revealed during the course of investigation that the defendant nos. 1 and 2 are sister concerns and that the defendant no. 3 and his brother are key figures in both. As far as the defendant no.2 is concerned, it was earlier selling cement under the marks '**Super Shree Ultra**' and '**Super Ultra Cement**'. It had also applied for registration of the said mark. The said application, however, was abandoned by the defendant no.2.

16. The plaintiffs further learned that defendant no.3 has obtained registration of the mark '**Ultra Plus**' under application no. 1783193 filed on 09.02.2009 in Class 19 for cement, claiming user since 21.08.2008. The plaintiff no.2 has filed a rectification petition no. 27419 against the same on 04.03.2022, which is pending adjudication. The said registration was granted to the defendant no.3, subject to the condition that '*the sale of goods shall be confined to the State of Rajasthan*'.

17. The learned counsel for the plaintiffs submits that the defendant no.3 has filed no proof for its claim of user since the year 2008. The earliest invoice placed by the defendant no.3 is a License Agreement dated 02.10.2018. The learned counsel for the plaintiffs further submits that in any case, the adoption of the mark being dishonest, no benefit can be claimed by the defendants of any alleged user of the same.

18. The learned counsel for the plaintiffs further submits that even otherwise, the packaging of the products would clearly show the intent of the defendants to come as close to the plaintiffs so as to deceive the general unwary consumer. The dishonest adoption is explained by the plaintiffs in

the following manner:-

“66. The deceptive similarity between the trademarks, colour combination in the trade dress of the Plaintiffs' products bearing the UltraTech and Ultra formative marks and the Defendants' Ultra Plus products is depicted herein below:



S. NO	ELEMENTS OF DECEPTIVE SIMILARITY
1.	Use of an identical yellow, red and black colour combination as part of the trade dress with yellow background and font in red and black ink.
2.	Use of the deceptively similar mark Ultra Pus incorporating the word 'Ultra' which is a prominent feature of the Plaintiffs' Ultra Tech mark
3.	Similar manner and style of writing Ultra Plus above a horizontal band in black bold with font

	<i>overwritten</i>
4.	<i>Identical manner of writing Ultra Plus Cement in vertical accent on the longer edge of the packaging in Hindi</i>
5.	<i>Similar names of the place of manufacture of the products, i.e. 'Aditya Cement' (of Defendants' Ultra Plus) and 'Aditya Cement Works' (of Plaintiffs' Ultra Tech cement) are displayed on the packaging in a similar manner and style.</i>

67. Further, in the new packaging delivered to Delhi on October 13, 2022 the manner and placement of writing the details of the place of manufacture, Aditya Cement is also identical to the Plaintiffs' packaging, as depicted below:



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19. On the other hand, the learned counsel for the defendants, who

appears on advance notice, submits that the mark **ULTRA PLUS** is registered in favour of Shree Balaji Traders, wherein the defendant no.3 is a partner. The defendant nos.1 and 2 are the licensed users of the said mark. The said mark has been registered way back in the year 2009. He further submits that the plaintiffs cannot claim any exclusive right in the word '**Ultra**' inasmuch as the same is laudatory and descriptive in nature. In this regard, he places reliance on the order dated 10.06.2016 passed by the High Court of Bombay in Notice of Motion no. 76/2014 in Suit No. 42/2014 titled **Ultratech Cement Limited v. Shree Balaji Cement Industries and Ors.**, wherein it was held that '**Ultra**' is a laudatory and descriptive word commonly used in the English language and no individual trader can monopolise the same.

20. He further submits that this Court would not have the territorial jurisdiction to entertain and adjudicate the present suit, inasmuch as, the defendants have no business operations within the territorial jurisdiction of this Court.

21. I have considered the submissions made by the learned counsels for the parties.

22. *Prima facie*, the plaintiffs have been able to show the reputation and goodwill that they possess in the mark '**Ultra**', though in variants thereof. The plaintiffs are the registered proprietor of various marks in which '**Ultra**' appears as a predominant part. The same, as per the assertion of the plaintiffs, has also been declared to be a '*well-known trade mark*' under Section 2(1)(zg) of the Trade Marks Act, 1999. The goods of the plaintiffs and the defendants are same and any resemblance in the marks is likely to deceive an unwary consumer of the association of the defendants' products

with the plaintiffs.

23. As far as the order dated 10.06.2016 of the High Court of Bombay referred hereinabove by the learned counsel for the defendants is concerned, it is seen that the said order, apart from noting that no person can claim exclusive right over the mark '**Ultra**', also observed that the use of the mark by the defendants therein was not deceptively similar to that of the plaintiffs. In the present case, the plaintiffs, in my opinion, have been able to *prima facie* show that the defendants have tried to come close to the plaintiffs in all aspects and the use of the mark by the defendants is likely to deceive an unwary consumer.

24. The learned counsel for the plaintiffs has also stated that even after the order dated 10.06.2016 passed by the High Court of Bombay, protection has been granted to the plaintiffs in various other matters in which '**Ultra**' formative marks were being used by third parties.

25. As far as the plea of lack of territorial jurisdiction of this Court is concerned, the plaintiffs have, in the plaint, asserted as under:-

“95. This Hon'ble Court has the territorial jurisdiction to entertain the present suit by virtue of the following factors:

i. Under Section 134(2) of the Trademarks Act, 1999 and Section 62 (2) of the Copyright Act, 1957 as the Plaintiff No. 1 and Plaintiff No. 2 have offices located in Delhi and they carry out their business inter alia of manufacturing and/or selling products under the UltraTech trademarks within the ordinary course of business including within the territorial jurisdiction of this Hon'ble Court.

ii. Under Section 20 (c) of the Code of Civil Procedure, 1908 to entertain and try the present suit in view of the following:

a) That the cause of action has arisen in Delhi since the Defendants are conducting business in Delhi as the Defendants are willing to sell

and deliver its products to New Delhi and the same have been delivered for sale within the territories of New Delhi within the ordinary course of business.

b) Further, the order for purchase of the Defendants' Ultra Plus cement products were placed within Delhi and the said products were delivered to Delhi on multiple occasions and thus, purchased in New Delhi.

c) Additionally, the Defendants are operating an interactive website, www.ultrapluscement.com which domain incorporates the deceptively similar mark Ultra Plus, advertises, promotes and offers to sell infringing Ultra Plus products and provides the contact details of the Defendants and is accessible to customers in Delhi who can enquire about the infringing products and the same can also be purchased via placing order online through the details given on the said website and delivered within the territories of New Delhi thus targeting the customers at New Delhi. The Defendants have therefore purposefully availed of the jurisdiction of this Hon'ble Court.

d) Further, the Defendants' product under the mark Ultra Plus are also being advertised and offered for sale on the e-commerce platform, www.indiamart.com, through which orders can be placed including from New Delhi. Thus, the Defendants are purposefully availing jurisdiction of this Hon'ble Court.

e) The Defendants have distributors located in Delhi through whom the Defendants are conducting business in Delhi and selling infringing products in Delhi. A substantial and integral part of the cause of action has thus arisen within the jurisdiction of this Hon'ble Court.

f) It is further submitted that New Delhi is a large hub and extensive market in India for building and construction related products and therefore, there is real, credible and imminent apprehension that the Defendants will soon expand their operations and their products will

soon be likely to be launched at New Delhi. Thus, in view of the above, a substantial and integral part of the cause of action lies within the jurisdiction of this Hon'ble Court which has the necessary jurisdiction to try the present suit.

The Plaintiffs crave leave to add to its case of jurisdiction such facts which can only be revealed through discovery in the present proceedings.”

26. At this stage, in view of the above assertion, it cannot be contended that this Court would not have territorial jurisdiction to entertain the present suit. This issue would have to be determined once the defendants file the response(s) to the plaint/application.

27. As far as the registration of the mark in favour of Shree Balaji Trading is concerned, it is the assertion of the plaintiffs that the mere presence of such registration on the Register of Trade Marks is no evidence of its user. As far as the plaintiffs are concerned, the plaintiffs seriously dispute the use of the said mark by the defendants. It is asserted that it is only in the year 2020 that the use of the said mark came to the notice of the plaintiffs, whereafter the plaintiffs have taken various steps to ensure protection of its mark, including filing of opposition and rectification proceedings.

28. In view of the above, I am of the opinion that the plaintiffs have been able to make out a good *prima facie* case in their favour. The balance of convenience is also in favour of the plaintiffs and against the defendants. The plaintiffs and general consumer are likely to suffer grave irreparable injury in case the *ad interim* injunction is not granted in favour of the plaintiffs and against the defendants.

29. Accordingly, an *ad interim* injunction in terms of prayer made in paragraph 41(i) of the present application is passed in favour of the plaintiffs and against the defendants till further orders.

30. It is made clear that the present order has been passed only on a *prima facie* view of the dispute and shall be open for re-consideration once the reply to the application is filed by the defendants.

31. List on 20th December, 2022.

I.A. 17734/2022

32. The learned counsel for the plaintiffs does not press this application. The same is disposed of as withdrawn.

I.A. 17735/2022

33. Issue notice.

34. Notice is accepted by Mr. Ayush Sharma, the learned counsel on behalf of the defendants/non-applicants.

35. Let reply be filed within a period of four weeks. Rejoinder, if any, be filed within a period of two weeks thereafter.

I.A. 17736/2022

36. The present application has been filed by the plaintiffs seeking leave to file additional documents which are not in the power, possession, control or custody of the plaintiffs at the moment.

37. The application is disposed of, recording that the plaintiffs shall file the additional documents strictly in accordance with law.

NAVIN CHAWLA, J

NOVEMBER 4, 2022/rv