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IN THE HIGH COURT OF DELHI AT NEW DELHI

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**Reserved on: 30th October, 2017
Pronounced on: 03rd November, 2017**

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**CS(OS) 286/2012, IA Nos. 2228/2012, 5097/2012, 5099/2012,
7917/2012**

NOKIA CORPORATION & ORS

..... Plaintiff

Through : Mr.Neeraj Grover and Mr.Naqeeb
Nawab, Advs.

versus

MOVIEEXPRESS & ORS

..... Defendant

Through : None.

CORAM:

HON'BLE MR. JUSTICE YOGESH KHANNA

YOGESH KHANNA, J.

1. The plaintiff has filed this suit for declaration, permanent injunction for restraining, passing off of trade mark, delivery up and recovery of damages. In this suit the plaintiff has prayed for declaration that plaintiff's trademark is a well known trademark in India. Further the plaintiff has sought a decree of permanent injunction restraining the defendants, their directors, partners, proprietors, distributors, agents etc. from advertising, airing songs, publishing, publicizing, offering for viewing, the impugned movie under the title Mr.NOKIA and/or Mr. NO.KEYIA and/or Mr. NA-VKIA and/or offering the songs containing the reference to the mark NOKIA and/or NO.KEYIA and/or any other

identical or deceptively similar to the Plaintiffs registered trade mark 'NOKIA' amounting to infringement or amounting to passing off their services as for the services of the plaintiff or amounting to dilution thereof. The plaintiff has also demanded an order of delivery up and damages of Rs.20,05,000/-.The case of the plaintiff is as follows:-

- a)** The Plaintiff No. 1 - Nokia Corporation is a Corporation organized and existing under the laws of Finland. Mr. Jeremie Vaquer has been appointed as authorized signatory vide Power of Attorney dated 22.04.2015;
- b)** the Plaintiff No. 2 - Nokia India Private Limited is a Company incorporated under the Companies Act, 1956 having its registered office at Flat No. 1204, 12th Floor, Kailash Building, Kasturba Gandhi Marg, New Delhi-110001;
- c)** Nokia is a well-known reputed company who does business in virtually every country in the world and has obtained registration of its well-known mark NOKIA in almost every country of the world;
- d)** the trade mark NOKIA was coined & adopted by the predecessors of the Plaintiffs way back in the year 1865. Since its adoption, the Plaintiffs predecessors expanded the use of the trade mark NOKIA on and in connection with a wide variety of products ranging from paper, rubber boots, tyres, power generation, cable and electronics business to its now famous telecommunication & mobile phone related business;

- e) the Plaintiffs' trade mark NOKIA qualifies to be termed as a well-known trade mark in terms of the provisions of The Trade Marks Act, 1999 as the trade mark NOKIA has become so to the substantial segment of the public which uses such goods and services that the use of such trade mark in relation to any other goods and services would be likely to be taken as indicating a connection in the course of trade or rendering of those services between the goods or services and the Plaintiff No.1;
- f) the Plaintiff No.1 first launched its products in India in the year 1995. In light of high technology services in the field of telecommunications and infrastructure directly as well as indirectly through its associations with other companies in India, NOKIA has been awarded as 'Top Wireless Infrastructure Company in 2013', 'Top Managed Services vendor in India' for FY 2013-14, 3 times in a row, by Voice & Data, 'Top Telecom Equipment Company in India in 2013 (Devices and Networks combined);
- g) the Plaintiff No. 1 owns trade mark registrations for its well-known trademark NOKIA in diverse classes in almost all major jurisdictions of the world. A list of Plaintiff No. 1's trade mark registrations in numerous countries of the world for NOKIA have been filed with the Plaintiff - (Mark-B). In India, the Plaintiff No.1 is the registered proprietor of the famous trade mark NOKIA;
- h) plaintiff No. 1 has spent hundreds of millions of dollars worldwide in connection with the promotion of its trade mark NOKIA. For the years between 2011 to 2014, the Plaintiff No. 1,

directly or via its authorized licensees, had spent to the tune of approximately around 1218.0120 crores for its annual advertising and promotional expenses;

i) the aforesaid establish the following;

- i. The Plaintiffs' NOKIA mark is a well-known trade mark.
- ii. The adoption and prior use of the Plaintiffs' mark NOKIA worldwide including in India which cannot be and has not been disputed. The law is settled that to claim ownership of a trade mark under the common law, the Plaintiff has to establish use of the mark prior to that of the Defendant;
- iii. the exclusive association of Plaintiffs' trade mark NOKIA around the world and in India with Plaintiffs and its predecessors and subsidiaries;
- iv. the Plaintiff is registered proprietor of the trade mark NOKIA inter alia in class 41 under no. 1237567 which extends to entertainment services. Thus under the provisions of Section 28 of the Trade Marks Act, 1999, the plaintiff has exclusive rights to use the same in relation to such entertainment services;
- v. the Plaintiff being the registered proprietor of the mark NOKIA in various classes and the mark NOKIA having repute in India is entitled to be protected against any attempt to dilute the same by a use thereof in relation to even different goods or services without any due cause.

2. The Defendant No. 1, Moviestar is an advertising agency involved in promotion, sponsorship for new movies and mass media communication such as short films, ad-films and audio-visual aids. The Defendant No. 2 M/s Shailendra Cinemas is a production house and is involved in producing movies and the Defendant No. 3, Mr. D. S. Rao, is a film producer.

3. In the month of March, 2011 Moviestar (Defendant no. 1) approached the Plaintiffs' marketing team in Hyderabad and gave a proposal to the Plaintiffs for an In-Film branding in an upcoming telugu movie of Defendants No. 2 & 3. The In-Film Branding was for a proposed Telugu movie starring Manchu Manoj, Praneetha, Priyamani, and was provided via an email communication dated 08.03.2011 from the email id moviestar.in@gmail.com. Also a document detailing the advantages for In-Film branding and proposed title for the movie such as Mr. NOKIA, Connecting People, and number of photographs illustrating few proposed posters with Mr. NOKIA as the title were provided.

4. Emails dated 10.03.2011, 16.03.2011, 26.03.2011 and 28.04.2011 were sent by Defendant No. 1.

5. The Plaintiff No. 2 vide an email 28.04.2011 communicated to Defendant no.2 the proposal of branding NOKIA in their upcoming movie MR. NOKIA is not acceptable by the Plaintiffs.

6. However, in June, 2011 the Plaintiff was informed about the Defendants' press release claiming that the movie Mr. NOKIA was under

the banner of Shailendra Movies/Cinema and produced by Mr.D.S. Rao, the Defendant No. 3.

7. The Plaintiffs immediately send a Cease & Desist Notice to the production house, the Defendant No.2. Simultaneously a communication was sent to the South India Film Chamber of Commerce requiring confirmation regarding the claim of the press release that a movie by the title "Mr. NOKIA" is registered. The Plaintiff No.1 received an immediate response from the Film Chamber which confirmed that no such title was registered with them.

8. The Defendant no. 3 acknowledged the superior trade mark rights of the plaintiffs' in the mark NOKIA and offered to change the title of their movie from Mr. NOKIA to Mr. NAV-KIA vide an email dated 08.07.2011 from the email id moviexpress.in@gmail.com.

9. In the last week of December 2011, the Plaintiffs' was informed about a press release that the Defendants are planning for an early release of the movie with the impugned title Mr. Nokia.

10. Legal notice dated 12.01.2012 was sent to the Defendants. The Defendant No. 3 again contacted the Plaintiff No.2 via email dated 05.01.2012.

11. On 27.01.2012, the Plaintiff's legal counsel received a reply dated 24.01.2012 on behalf of the Defendants to the legal notice dated 12.01.2012.

12. Internet search revealed that the Defendants movie was still being referred as "Mr. Nokia" in all press reports & was all slated to be released in February, 2012 itself. The Defendants also released songs. A CD containing songs of the impugned movie has been filed in the present proceedings.

13. It is without a doubt that the Plaintiffs had given the Defendants number of opportunities to redress the Plaintiffs' grievances and settle the matter amicably, however, left with no other option, the Plaintiffs' filed a suit on 03.02.2012 and this Court was pleased to grant ex parte ad interim injunction on 06.02.2012.

14. Pursuant to the filing of the suit and even service of summons, it came to the notice of the Plaintiffs' representatives that the Defendant No 2 & 3 have been deliberately and openly violating the injunction orders passed by this Court. The Plaintiffs immediately took steps to get the photographs of the aforesaid Hoardings along with newspapers bearing a date of 06.03.2012.

15. Thereafter, the Plaintiffs caught hold of a press release issued by the Defendant No. 3 stating that the movie is being released under the name Mr. NOOKAYYA. The aforesaid information was further confirmed when some other press reports stating that the impugned movie was all set to release on 07.03.2012, came to the notice of the Plaintiffs.

16. The Plaintiffs were made aware that the movie is set to release in a number of theaters including PVR Cinemas, Hyderabad. The Plaintiffs in

order to confirm the said news made an online booking for the first show of the movie at 11.15 AM on 08.03.2012.

17. The Plaintiffs filed an application under order 39 Rule 2 and under Rule 2A, CPC read with section 12 of the Contempt of Courts Act, 1971 on 07.03.2012 bearing no. 7917 of 2012. The Hon'ble Court was pleased pass restrain order dated 07.03.2012. In spite of the restraining orders from this Hon'ble Court, the Defendants released the movie under the name Mr.NOOKAYYA on 08.03.2012.

18. In the year 2013, the Plaintiffs were made aware of the availability of the compact disc (CD) of the movie Mr. NOOKAYYA on e-commerce websites such as www.infibeam.com.www.flipkart.com etc. The plaintiff purchased CD online from the website www.infibeam.com. and has filed copy of the invoice no. BT-131210-861-0037 dated 10.12.2013 along with coloured prints of the cover of the CD. The plaintiff also filed CD purchased online from the website www.flipkart.com. and filed copy of the original invoice no. OD40101055134 dated 2nd January 2014 along with coloured prints of the cover of the CD.

19. The plaintiff has also filed the Copies of extracts obtained from the Google search engine talking about the online downloading of the movie Mr.NOOKAYYA.

20. The plaintiff examined two witnesses (a) Mr.Jeremie Vaquer constituted attorney of Nokia Corporation at Finland who proved the Power of Attorney dated 22.04.2015 as Ex.PW1/1; the certificate of

incorporation of plaintiff no.2 as Mark-A; the lists of trademarks registrations in favour of plaintiff in numerous countries of the world as Mark-B; copy of the Registration No. 494897 as Ex.PW1/2, copy of Registration No. 646393 as Ex.PW1/3; copy of Registration No. 1237566 as Ex.PW1/4; copy of Registration No. 1237568 as Ex.PW1/5; copy of Registration No. 1237570 as Ex. PW1/6; copy of Registration No. 1237567 as Ex.PW1/7; copy of Registration No. 1364898 as Ex.PW1/8; copy of Registration No. 1237565 as Ex.PW1/9; copy of Registration No. 1237564 as Ex. PW1/10; copy of Registration No. 1566635 as Ex.PW1/11; copy of Renewal Certificate of Registration No.993281 as Ex.PW1/12; copy of Renewal Certificate of Registration No. 993282 as Ex.PW1/13, copy of Renewal Certificate of Registration No. 466090 as Ex.PW1/14; copy of online status of the Registration No. 1237569 as Ex.PW1/15; and Copy of online status of the Registration No. 466089 as Ex.PW1/16; samples of advertisements and promotional materials filed with the Plaint as Ex.PW-1/17; copy of the email communication dated 8th March, 2011 as Ex.PW1/18; copy of a document as Ex.PW1/19; photographs forwarded by the Defendant No.1 as Ex.PW1/20; Copy of the email communication of 10th March 2011 as Ex.PW1/21; copy of the email communication of 16th March 2011 as Ex.PW 1/22; copy of the email communication of 26th March 2011 as Ex.PW 1/23; copy of the email communication of 28th April 2011 alongwith a copy of the synopsis sent for the movie Mr.NOKIA as Ex.PW1/24; copy of the email communication of 28th April 2011 as Ex.PW1/25; the press releases as Ex.PW1/26; copy of the Cease and Desist notice as Ex.PW1/27; copy of the response from the Film Chamber which confirmed that no movie title

such as Mr. Nokia was registered with them as Ex.PW1/28; copy of the email dated 8th July, 2011 as Ex.PW1/29; copies of the press release from the internet showing that the Defendants had advanced to the final stages of the shooting for the movie Mr. NOKIA as Ex.PW 1/30; copy of said legal notice as Ex.PW1/31; copy of the email dated 05th January, 2012 forwarded by Defendant No.3 as Ex.PW1/32; copy of the letter dated 24th January, 2012 as Ex.PW1/33; copy of the press release taken from the internet as Ex.PW 1/34; copy of the internet screen shots of Mr.Nokia songs downloaded as Ex.PW 1/35; the CD containing the songs having vocal reference to the well-known trade mark "NOKIA" as Ex.PW1/36; the said press releases as Ex.PW1/39; copy of the ticket as Ex.PW1/40; the CD purchased online from the website www.infibeam.com. copy of the original invoice no. BT-131210- 861-0037 dated 10th December 2013 along with coloured prints of the cover of the CD as Ex.PW1/41; the CD purchased online from the website www.flipkart.com. copy of the original invoice no. OD40101055134 dated 2nd January 2014 along with coloured prints of the cover of the CD as Ex.PW1/42; copies of extracts obtained from the Google search engine talking about the online downloading of the movie "Mr. NOOKAYYA" as Ex.PW1/43; and the certificates under section 65(B) of the Indian Evidence Act 1872 of Mr.Kapil Kumar Mahipal as Ex.PW1/45.

21. Mr.Kapil Kumar Mahipal was examined as PW2 and he proved the documents PW2/1-PW2/39 which are websites on internet relevant to the matter. He also proved a certificate under section 65(B) of the Indian Evidence Act.

22. Both the witnesses besides proving the documents aforesaid have also deposed in the line of the averments made in the plaint qua the mark “NOKIA” being a well known trademark in the world; its registration in various jurisdiction; the expenses the plaintiffs have incurred on advertisements and promotion of the trademark and its products as also various cases the plaintiffs have filed against the infringers in various jurisdictions.

23. Thus there can be no dispute to the fact that the Defendant's marks Mr. NOKIA and/or Mr. NO.KEYIA and/or Mr. NAV-KIA and/or NOOKAIAH are deceptively and confusingly similar to the Plaintiffs well-known and registered mark NOKIA. It is well settled that for comparing marks, the test is whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade. As the Plaintiff is the registered proprietor of the mark NOKIA in class 41 under no. 1237567 in relation to entertainment services, the use thereof by the defendant in relation to such services amounts to infringement under Section 29 (1) of the Trade Marks Act, 1999. Infringement u/s 29 (1) does not require confusion in the minds of public/ consumers with regard to trade origin. It is enough to show that impugned marks are deceptively similar to the registered marks of Plaintiff, even if, there are added matters to show a different trade origin. In *Kaviraj Pandit Durga Dutt vs. Navrattana Pharmaceuticals Laboratories* AIR 1965 SC 980 the Court held:

“28. The other ground of objection that the findings are inconsistent really proceeds on an error in appreciating the basic differences between the causes of action and right to relief in suits for passing off and for infringement of a registered trade mark and in equating the essentials of a passing off action with those in respect of an action complaining of an infringement of a registered trade mark. We have already pointed out that the suit by the respondent complained both of an invasion of a statutory right under s. 21 in respect of a registered trade mark and also of a passing off by the use of the same make. The finding in favour of the appellant to which the learned Counsel drew our attention was based upon dissimilarity of the packing in which the goods of the two parties were vended, the difference in the physical appearance of the two packets by reason of the variation in their colour and other features and their general get-up together with the circumstance that the name and address of the manufactory of the appellant was prominently displayed on his packets and these features were all set out for negating the respondent's claim that the appellant had passed off his goods as those of the respondent. These matters which are of the essence of the cause of action for relief on the ground of passing off play but a limited role in an action for infringement of a registered trade mark by the registered proprietor who has a statutory right to that mark and who has a statutory remedy in the event of the use by another of that mark or a colourable imitation thereof. While an action for passing off is a Common Law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for

infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the exclusive right to the use of the trade mark in relation to those goods (Vide s. 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable limitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that use of the defendant's mark is likely to deceive, but were the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise and the court reaches the conclusion that there is an limitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the make would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff."

24. The plaintiff's mark is thus a well known registered trade mark and has repute in India. The use of the mark by the defendants is without any due cause and is detrimental to the distinctive character of the Plaintiffs highly distinctive, well-known and registered mark. In such circumstances too the plaintiff is entitled to seek the benefit of the statutory provisions of Section 29 (4) read with Section 29 (7), (8) and (9) of the Trade Mark Act. None should be continued to be allowed to use a world famed name to goods which have no connection with the type of goods which have generated the worldwide reputation.

25. In *Daimler Benz Aktiengesellschaft vs Hybo Hindustan* AIR 1994 Delhi 239, 1994 RLR 79 the court held:

“17. However, if despite legal notice, any one big or small, continues to carry the illegitimate use of a significant world wide renowned name/ mark as is being done in this case despite notice dated 09-12-1989, there cannot be any reason for not stopping the use of a world reputed name. None should be continued to be allowed to use a world famed name to goods which have no connection with the type of goods which have generated the world wide reputation.”

26. In *Midas Hygiene Industries P. Ltd. and Anr. vs. Sudhir Bhatia and Ors.* (22.01.2004 - SC) : MANU/SC/0186/2004 the court held:

“5. The law on the subject is well settled. In cases of infringement either of Trade Mark or of Copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima

facie appears that the adoption of the Mark was itself dishonest.”

27. In *Honda Motors Co. Ltd. vs. Mr. Charanjit Singh and Ors.* (28.11.2002 - DELHC) : MANU/DE/1845/2002 the court held:

“42. In the present case the plaintiff's mark HONDA has acquired a global goodwill and reputation. Its reputation is for quality products. The name of HONDA is associated with the plaintiff's especially in the field of automobiles and power equipments on account of their superior quality and high standard. The plaintiff's business or products under the trade mark HONDA has acquired such goodwill and reputation that it has become distinctive of its products and the defendants' user of this mark for their product "Pressure Cooker" tends to mislead the public to believe that the defendants business and goods are that of the plaintiff. Such user by the defendants has also diluted and debased the goodwill and reputation of the plaintiff.”

28. Similar is the case here. The plaintiff's mark “NOKIA” has also developed a global goodwill and reputation and if the defendants use such mark in relation to its business it may dilute and debase the goodwill and reputation of the plaintiff and would lead the public to believe the goods/services are originating from the plaintiff.

29. In view of the aforesaid circumstances the suit of the plaintiff is decreed in terms of prayer clauses No. **a**, **b**, **c**, **d** and **e** as stated in para 56 of the plaint.

30. The present case is also a fit case for awarding damages due to the highly dishonest conduct of the defendants, who have time and again

sought to mislead the Plaintiffs and the Court. The defendants have also deliberately stayed away from the present legal proceedings, no doubt in an attempt to avoid any punitive action. Granting compensatory damages as well as punitive damages would discourage law breakers who indulge in violations with impunity out of lust for money so that they realize that in case they are caught, they would be liable not only to reimburse the aggrieved party but would be liable to pay punitive damages, which may spell financial disaster for them.

31. It has been well settled by this Court in *Hero Honda Motors Ltd. vs. Shree Assuramji Scooters* [2006 (66) DRJ 113]

“a defendant who chooses to stay away from the proceedings of the Court should not be permitted to enjoy the benefits of evasion of Court proceedings. Any view to the contrary would result in a situation where a defendant who appears in Court and submits its account books would be liable for damages, while a party which chooses to stay away from the court proceedings would escape the liability of damages as stated and set out by the plaintiff. It is also well settled that where a defendant deliberately stays away from the proceedings with the result that an enquiry into the accounts of the defendant for determination of damages cannot take place, the plaintiff cannot be deprived of the claim for damages as that would amount to a premium on the conduct of such defendant. The result would be that parties who appear before the court and contest the matter would be liable to damages while the parties who choose to stay away from the court after having infringed the right of the plaintiff, would go scot-free.”

32. In *Jockey International Inc & Anr vs. R. Chandra Mohan & Ors* 211 (2014) DLT 757 the court noted as under:-

*“43. I am in agreement with the aforesaid submission of learned counsel for the plaintiffs that damages in such cases must be awarded and a defendants, who chooses to stay away from the proceedings of the Court, should not be permitted to enjoy the benefits of evasion of court proceedings. Any view to the contrary would result in a situation where a defendants who appears in Court and submits its account books would be liable for damages, while another defendants who, chooses to stay away from court proceedings would escape the liability on account of failure of the availability of account books. A party who chooses not to participate in court proceedings and stays away must, thus, suffer the consequences of damages as stated and set out by the plaintiffs. There is a larger public purpose involved to discourage such parties from indulging in such acts of deception and, thus, even if the same has a punitive element, it must be granted. R.C. Chopra, J. has very succinctly set out in *Time Incorporated's case (supra)* that punitive damages are founded on the philosophy of corrective justice.”*

33. Since the plaintiff has been able to show prima facie violation of the plaintiff's exclusive right by the defendants and since the conduct of the defendant is deplorable inasmuch as despite committing serious violation of the plaintiff's right, the defendants have chosen not to appear before this Court which indicates the tendency of the defendants to indulge in illegal activities and since the intention of the defendants was to deceive the plaintiff and obtain wrongful advantage of the Trademark

of the plaintiff, hence to preserve the exclusive mark and reputation / goodwill of the plaintiff, the Plaintiff is awarded damages to the tune of Rs.5.00 Lac against the defendants, payable jointly and severally. The cost of the suit is also awarded in favour of plaintiff and against the defendants.

34. All the pending applications stands disposed of.

35. Decree Sheet be drawn.

36. At last, in view of the nature of disputes between the parties, Registry is directed to re-number it as a 'Commercial Suit' and while doing so retain both the numbers. Needless to state the decree sheet shall contain the new numbers.

YOGESH KHANNA, J

NOVEMBER 03, 2017

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