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

Date of Decision: 6th November, 2023

\+ **C.A.(COMM.IPD-TM) 59/2022 & I.A. 9937/2023, 22123/2023**

GIRNAR FOOD AND BEVERAGES PVT. LTD. ..... Appellant

Through: Ms. Akanksha Singh, Advs. (M. 94388 04704)

versus

THE REGISTRAR OF TRADE MARKS AND ORS..... Respondents

Through: Mr. Harish Vaidyanathan Shankar, Central Government Standing Counsel with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advocates for R-1.
Ms. Pooja Dodd, Advocate for R-2.

2 WITH

\+ **CS(COMM) 1443/2016**

GOODRICKE GROUP LIMITED ..... Plaintiff

Through: Mr. Shobhit Agrawal, Adv. (M. 8800520258)

versus

M/S. GIRNAR FOOD & BEVERAGES PVT LTD..... Defendant

Through: Mr. Sushant Singh, Mr. Sourav Pattanaik, Advs. (M. 98117 77625)
Ms. Akanksha Singh, Adv. (M. 94388 04704)

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.

2. The mark ‘SUPER CUP’ is the subject matter of both these

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proceedings. The predecessor in interest of GOODRICKE *i.e.*, Godfrey Phillips India Ltd. had filed the present suit in the year 1996 as ***CS (OS) 1813/1996***, thereafter, upon the enactment of the Commercial Courts Act, 2015, the present suit was renumbered as ***CS (COMM) 1443/2016***. In the suit, the Plaintiff sought an injunction against the Defendant- ***M/s. Girnar Food & Beverages Pvt. Ltd***. from using the mark 'SUPER CUP'.

3. The present appeal, i.e., ***C.A.(COMM.IPD-TM) 59/2022*** was originally filed by the Defendant before the Intellectual Property Appellate Board (IPAB) in the year 2020 and was transferred to this Court upon the enactment of the Tribunals Reforms Act, 2021. The said appeal was filed in respect of the decision dated 13th September, 2019 issued by the Registrar of Trade Marks. The decision concerned the opposition to the mark 'SUPER CUP', bearing Trade Mark Application No. 712036 in Class 30 claiming use since 1st January, 1988. By the said decision, the Registrar of Trade Marks had dismissed the opposition filed by the Defendant and permitted re-advertisement of the Plaintiff's mark without any conditions.

4. In the suit, initially, vide order dated 2nd August, 1996, an *ex parte interim* injunction was granted, restraining the Defendant from using the mark 'SUPER CUP'. The said interim injunction was confirmed by the Court vide order dated 23rd June, 1997, till the pendency of the suit. The relevant extract of the order dated 23rd June, 1997 is set out below:

> *"This is an application filed on behalf of the plaintiff under Order 39 Rule 1 and 2 read with Section 151 CPC. I have heard the learned counsel for the plaintiff and have also carefully gone through the averments made in the plaint, the contents of the application which is duly supported by an affidavit. The plaintiff claims to be the proprietor of Trade*

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> *Mark 'SUPER CUP'. I am satisfied that the plaintiff has made out a strong prima facie case for grant of an ex parte interim relief which if not granted would defeat the very purpose by delay. It is, therefore, directed that the defendant, its agents, servants, representatives, assigns are restrained till for them orders from manufacturing, selling, ring for sale or distributing goods in relation to the trade mark 'SUPER CUP' or any other trade mark deceptively similar So the trace mark SUFER CUP in relation to (defendant's) goods."*

5. The Defendant preferred an appeal against the interim order dated 2nd August, 1996 before the ld. Division Bench of this Court. The said appeal was admitted by the ld. Division Bench on 28th July, 1997. Thereafter, vide a detailed order dated 3rd October, 1997, the *interim* injunction was stayed till the pendency of the appeal. The relevant extract of order dated 3rd October, 1997 of the ld. Division Bench is set out below:

> *"Coming now to the facts of this case, we find that the mark "Super Cup" is not registered trade mark of the respondent and when it had applied for registration of trade mark "Tea City "it had disclaimed the exclusive right to use the mark "Super Cup" and the device of cup and saucer. When the label of the plaintiff / respondent was advertised for registration as a trade mark in Trademark Journal on 16th January, 1995 it was specifically mentioned that the "Registration of this trade mark shall give no right to the exclusive use of the words "Super Cup" and "Sensible new way to buy tea" and the device of the cup and saucer".*
>
> *In view of the mark which is now registered, the words "Super Cup" having been disclaimed, the only effective part of the registered mark of the plaintiff is "TEA CITY"/ The plaintiff / respondent, therefore, prima facie, cannot claim exclusive right to use the*

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words Super Cup by virtue of any alleged user. The appellant is marketing its tea as "Girnar Super Cup Tea" since 1995 and it is in the trade of manufacturing and marketing tea for the last about twenty years. The appellant has in its application stated that it has export contracts for export of tea under the trade mark "Girnar Super Cup Tea" with the device of cup and saucer in the name of its associated concern Girnar Exports and we feel that in case the impugned order is not stayed not only that the appellant would suffer monetary loss and loss of foreign exchange but it may also result in the loss of business, reputation and goodwill of the appellant which in our view cannot be compensated in terms of money. The appellant shall in our view suffer substantial loss in case the impugned order is not stayed.

Appeal having already been admitted, as the same in our view needed consideration, we feel the impugned order should not be allowed to continue. We therefore, stay the impugned order till the disposal of the appeal."

6. The Plaintiff filed an SLP, numbered ***SLP (C) No. 21531/1997***, challenging the said decision of the ld. Division Bench which was admitted on 5th December, 1997 as ***C.A. No. 8557 of 1997*** titled ***Godfrey Phillips India Ltd. v. Girnar Food & Beverages Pvt. Ltd***. On the said date, the decision of the ld. Division Bench was set aside and the Supreme Court remanded the case back to ld. Division Bench for a fresh consideration. In the *interregnum*, parties were directed to maintain *status quo* in respect of the use of the mark 'SUPER CUP'. The relevant extract of the said order is set out below:

"3. Ordinarily, special leave would not have been granted to appeal against an interlocutory order but

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the nature of the order in the present case is such that it has great significance and, therefore, we considered it appropriate to grant special leave in the matter.

4. Having heard the learned counsel for the parties, we find that the reason given by the Division Bench for its conclusion, even if correct, is against the settled principles in a matter of this kind. Shri Jaitley, learned counsel for the respondent, made no attempt to support the basis of the order made by the Division Bench but he added that the conclusion reached by the Division Bench is correct and can be supported on the basis of ample material on the record. In our opinion, it would be appropriate that the Division Bench, in the first instance, should consider this aspect instead of the same being considered by us in this appeal.

5. The order made by the Division Bench is based on its view indicated as under:

"In view of the mark which is now registered, the word 'Super Cup' having been disclaimed, the only effective part of the registered mark of the plaintiff is TEA CITY'. The plaintiff/respondent therefore prima facie, cannot claim exclusive right to use the words Super Cup by virtue of any alleged user."

6. The proposition in the above extract is clearly in conflict with the decision of this Court in Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd, MANU/SC/0052/1955 : [1955] 2 SCR 252. There is no dispute before us that even on disclaimer, a passing-off action lies and that is the reason why Shri Jaitley did not support the above reason given by the Division Bench in its order.

7. In the facts and circumstances of the case, we set aside the order of the Division Bench of the High Court and remit the matter back to the Division Bench for a fresh decision. In our opinion, the arguments required to be heard for making an interim order in

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15:45:44

*the pending appeal before the Division Bench may itself be sufficient to dispose of the appeal and, therefore, it would be appropriate that the Division Bench disposes of the appeal as early as possible preferably within three months, after hearing both sides. **Meanwhile, status quo would be maintained with respect to the use of the mark "Super Cup".**"*

7. Vide judgement dated 19th March, 2001, ld. Division Bench, held that the mark 'SUPER CUP' was laudatory and descriptive of the goods of the Plaintiff. Accordingly, the appeal was allowed and it was ruled that the Plaintiff was not entitled to an injunction. The relevant extract of the said judgement is set out below:

"20 In view of the above discussion, the finding of the learned Single Judge that the plaintiff's product displays the mark "Super Cup" prominently and "Tea City" does not occupy a prominent position is unassailable and is required to be sustained. Consequently, we do affirm the view taken by the learned Single Judge that the plaintiff's mark in question is "Super Cup." However, the further and consequential conclusion of the learned Single Judge that the word "Super" does not refer to the character or quality of the tea, in our view, cannot be sustained on account of the foregoing discussion and our finding that the word "Cup" refers to a "Cup of Tea" and word "Super Cup" was, therefore, laudatory of tea. This conclusion of the learned Single Judge cannot, therefore, be sustained.

21 Accordingly, since the terms "Super Cup' has now been held by us to be descriptive and laudatory of the plaintiff, the plaintiff / respondent is not entitled to an injunction.

22 Consequently the finding of the learned Singly Judge that the plaintiff has been selling "Super Cup" tea since 1988 with considerable expenses and

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15:45:44

the trademark "Super Cup" identifies the Plaintiff's goods as well as the finding that no plausible explanation has been given by the defendant for adoption of the mark "Super Cup" in 1995 is not of any relevance as the plaintiff/ respondent prima facie is held disentitled to the protection claimed for Super Cup and the consequent grant of an injunction.

23 In so far as the finding of the learned Single Judge that there are basic features of similarities between the two marks which make misleading of the public a reasonable inference, we are of the view that this finding cannot stand in view of the findings arrived at by us to the effect that taking into account the differences between the plaintiff / respondent's and defendant / appellant's marks and trade dresses there can be no legally relevant confusion in the marketplace. Accordingly, the appeal is allowed. The order dated 23rd June, 1997 is set aside to the extent indicated above. The appellant / defendant's application, IA. 7896/96 under order 39 Rule 4 CPC is allowed and IA. 6973/96 under order 39 Rules 1 & 2 CPC, filed by the plaintiff / respondent is dismissed. Appeal stands disposed of accordingly."

8. Vide order dated 2nd August, 2001, this Court placed this matter before the Joint Registrar for fixing of dates for trial. Trial dates were thereafter fixed in the month of August, 2004.

9. In the meantime, the Plaintiff preferred another SLP before the Supreme Court ***SLP (C) No. 13311/2001***, challenging the Division Bench order dated 19th March 2001, which was admitted on 20th August, 2001 and numbered as ***CA No. 5611 of 2001*** titled ***M/s. Godfrey Philips India Ltd. v. M/s. Girnar Food & Beverages Pvt. Ltd***. However, no stay on proceedings was granted by the Supreme Court. At this stage, the proceedings in the suit were then transferred to District Judge, District Courts, Tis Hazari, Delhi for

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trial on 1st March, 2004, as the relief claimed in the present suit was less than Rs. 20,00,000/-.

10. Vide judgement dated 20th April, 2004 in ***Godfrey Philips India Ltd. v. Girnar Food and Beverages Pvt. Ltd***., ***(2004) 5 SCC 627***, the Supreme Court held that any mark which is held to be a descriptive trademark is liable to be protected if it has assumed a secondary meaning, which identifies it with a particular product or being from a particular source. The relevant extract of the said judgement of the Supreme Court is set out below:

> *"4. Without going into the question whether the conclusion arrived at by the Division Bench that the trade mark is descriptive is correct or not, it appears to us, and as is conceded by both parties before us, that the enunciation of the principle of law with regard to the protection available even in respect of the descriptive trade mark was wrong.* ***A descriptive trade mark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source. We, therefore, remand the matter back to the Division Bench of the High Court so that it may address its mind to this question without disturbing the other conclusions arrived at at this stage.*** *In the event the Division Bench answers the additional issue formulated by us against the appellant, it will be open to the appellant to raise all the issues which have already been concluded and which are the subject-matter of this appeal in any further appeal as it may be entitled to prefer from the final decision of the Division Bench. The Division Bench is directed to dispose of the appeal as expeditiously as is conveniently possible.* ***It is made clear that the trial of the suit may also be proceeded with and concluded expeditiously without being inhibited either by the pendency of the appeal or by***

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Signing Date:16.11.2023
15:45:44

any observation in the orders of the High Court on the interlocutory application."

11. In the meantime issues were framed in the suit and the matter was at the stage of trial. In the *interregnum*, Girnar Food & Beverages Pvt. Ltd. also sought cancellation of the mark 'SUPER CUP' bearing No. 712036 in Class 30, vide opposition no. 246952 before the Registrar of Trade Marks. The Registrar of Trade Marks refused the opposition filed by the Defendant. Thereafter, the same was appealed before the IPAB. During the pendency of the appeal, ***C.A.(COMM.IPD-TM) 59/2022***, the IPAB was abolished and the present appeal, was transferred to this Court. Considering that the appeal against and the suit were both pending before this Court, the same were directed to be listed together.

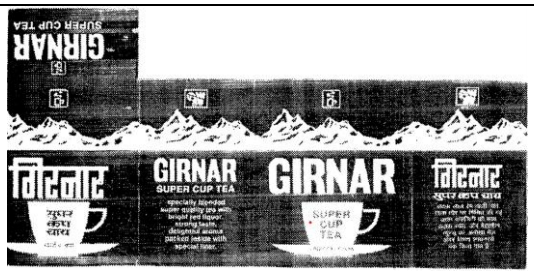
12. Parties have now reported that their disputes have been resolved by virtue of Co-Existence Agreement dated 3rd October, 2023. In terms of the said agreement, it has been recorded that both the parties have various trademark registrations in their favour in Class 30. In addition, rectifications and oppositions have been filed by both the parties against each other.

13. By virtue of the present Co-Existence Agreement, both the parties have amicably resolved their disputes in respect of the use of the mark 'SUPER CUP', by deciding to mutually co-exist in the market and withdraw all proceedings against each other. The terms of settlement are recorded in paragraphs 1 to 20 of the agreement. The agreement is signed by Mr. Soumen Mukherjee on behalf the Plaintiff- Goodricke Group Ltd. in ***CS(COMM) 1443/2016 titled Goodricke Group Ltd. v. M/s. Girnar Foods & Beverages Pvt. Ltd.*** and by Mr. Harendra Shah, on behalf of Appellant-Girnar Food And Beverages Pvt. Ltd. in ***C.A.(COMM.IPD-TM) 59/2022***

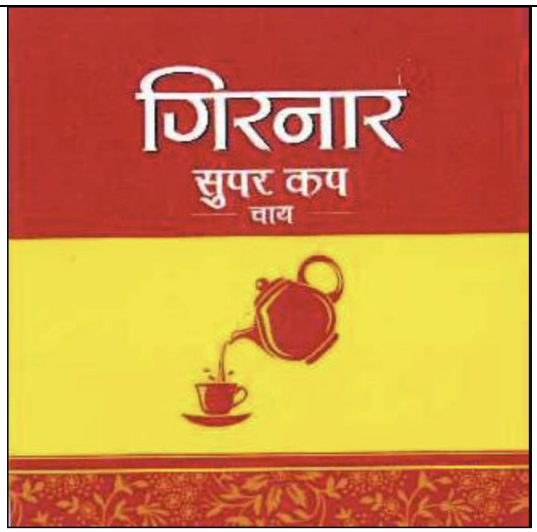
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titled ***Girnar Food and Beverages Pvt. Ltd. v. The Registrar of Trade Marks and Ors.***

14. Broadly, it has been agreed between the parties that Girnar Food and Beverages Pvt. Ltd. would use the mark 'Girnar Super Cup' for tea as also for other cognate and allied products, as applied for in its trade mark application Nos. 680968, 4458031, and 4458032 as represented in Schedule A of the agreement. The details of the said three trade mark registrations which would be used by the Defendant are set out below:

S. No.	**Application Number**	**Class**	**Application Date**	**Mark**
1	680968	30	21/09/1995	
2	4458031	30	28/02/2020	

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3	4458032	30	28/02/2020	

15. Barring such usage, the mark 'SUPER CUP' by itself would not be used by Girnar Food And Beverages Pvt. Ltd. Girnar Food And Beverages Pvt. Ltd. has also undertaken not to oppose any future applications of Goodricke Group Ltd. for the mark 'SUPER CUP' as a whole with or without prefix or suffix in Class 30. Parties have agreed to withdraw the oppositions filed against each other which are listed in paragraph 3 of the agreement. Girnar Food And Beverages Pvt. Ltd. has also undertaken to withdraw the rectification against the mark "SUPER CUP" bearing no.712036.

16. Goodricke has also undertaken to withdraw the present suit in terms of Clause 5 of the agreement filed against Girnar in ***CS (COMM) 1443 of 2016*** titled ***'Goodricke Group Ltd. v. Girnar Food & Beverages Pvt. Ltd***. Girnar Food And Beverages Pvt. Ltd**.** has also undertaken to withdraw the appeal filed against order dated 13th September, 2019 which is listed today as ***CA(COMM-IPD-TM) No. 59 of 2022*** titled ***'Girnar Food & Beverages Pvt. Ltd. v. The Registrar of Trade Mark & Ors.*** Both the parties have also agreed that they both have a right to stop any third party from using the said

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15:45:44

mark.

17. The Court has perused the Co-Existence Agreement and records that the settlement is lawful. Parties and all others, who are acting on their behalf shall be bound by the terms and conditions of the settlement.

18. Both, the appeal and the suit stand withdrawn in view of the above settlement. The dispute relating to the mark SUPER CUP which is more than 27 years old, with multiple rounds before the Division Bench and the Supreme Court, accordingly stands amicably resolved.

19. No orders are required to be passed against Goodricke Group Ltd. in the appeal *i.e.*, in ***C.A.(COMM.IPD-TM) 59/2022***.

20. Both the suit and the appeal are accordingly dismissed as withdrawn in view of the settlement. All pending applications are also disposed of.

PRATHIBA M. SINGH
JUDGE

NOVEMBER 06, 2023
mr/ks/am

[Corrected and released on 16th November, 2023]

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