



2024:DHC:9927



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

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Judgment Reserved on: 13.12.2024
Judgment pronounced on: 23.12.2024

+ CS(COMM) 430/2024 with I.A. 32723/2024

EVERGREEN SWEET HOUSE

.....Plaintiff

Through: Mr. Sidhant Kumar, Mr. Rakshit
Dhingra, Ms. Manyaa Chandok and
Mr. Om Batra, Advocates.

versus

JV EVERGREEN SWEETS
AND TREATS & ORS.

.....Defendants

Through: Mr. Ashutosh Lohia, Advocate with
Ms. Shraddha Bhargava, Mr. Rohit
Saraswat, Ms. Sharan Mehta, Ms.
Rishika Jain and Ms. Princey Sharma,
Advocates for D-1
Mr. Abhay Pratap Singh and Ms.
Mitali U., Advs. for D-3
Mr. Varun Pathak, Adv. for D-4

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

JUDGMENT

AMIT BANSAL, J.

I.A. 32723/2024 (Under Order XXXIX Rules 1 & 2 CPC)

1. By way of the present Judgment, I shall decide the captioned application filed on behalf of the plaintiff under Order 39 Rule 1 and 2 of the Civil Procedural Code, 1908 (CPC).



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2. The present suit has been filed seeking relief of permanent injunction restraining the defendants from infringing the trademarks of the plaintiff and passing off their business as that of the plaintiff and other ancillary reliefs.

3. Summons in the suit were issued on 22nd May, 2024 and notice in the present application was issued on 10th July, 2024. However, no *ad interim* injunction order was passed in favour of the plaintiff. Thereafter the matter was listed on various dates and pleadings have been completed in the suit as well as the present application. The application was heard on 22nd October, 2024 and 13th December, 2024, when the judgment was reserved.

CASE SET UP IN THE PLAINT

4. Briefly stated, the case set up in the plaint is as follows:-

4.1 The plaintiff is a registered partnership firm engaged in the business of preparing and selling Indian sweets and namkeens since 30th September, 1963. The shop of the plaintiff is located in Green Park, New Delhi.

4.2 The mark “Evergreen” was adopted by the plaintiff in the year 1963 and the plaintiff has been using the same ever since in connection with its business, i.e., the sale of Indian sweets and namkeens.

4.3 The plaintiff has given its revenues from the year 2019 to 2023 in paragraph 20 of the plaint. In the year 2023, the revenues of the plaintiff were to the tune of ₹ 38 crores.

4.4 The plaintiff also has a registered domain name, <http://www.evergreensweethouse.net>, which has been in use since 2019.



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4.5 The plaintiff has obtained registration for the device mark



bearing the word “Evergreen” with effect from 26th August, 1998 claiming use from 1963 in class 30. The aforesaid registration is valid and subsisting.

4.6 The registered mark of the plaintiff features a unique trade dress including colour scheme, get up and layout.

4.7 The plaintiff received an email dated 13th May, 2024 wherein one of its customers complained to the plaintiff that there is another shop under the name and style “JV Evergreen Sweets & Treats” operating in Lajpat Nagar, New Delhi, which is also selling products similar to that of the plaintiff.

4.8 The plaintiff also came to know that the defendant no.1 is operating on food delivery platforms like Zomato (defendant no.2) and Swiggy (defendant no.3) under the impugned mark and selling products identical to that of the plaintiff, which is causing confusion amongst the customers of the plaintiff.

4.9 Thereafter, the plaintiff sent a cease-and-desist notice to the defendant no.1 on 15th May, 2024 calling upon the defendant no.1 to refrain from using the word ‘Evergreen’.

4.10 The defendant no.1 replied to the aforesaid cease-and-desist notice on 17th May, 2024 stating that the mark adopted by the defendant no.1 is different from that of the plaintiff and the word ‘Evergreen’ is a generic name, which cannot be monopolised by anyone.



5. Accordingly, the present suit was filed seeking a decree of permanent injunction on the basis of infringement and passing off along with other ancillary reliefs.

CASE SET UP IN THE WRITTEN STATEMENT

6. In the written statement filed on behalf of the defendant no.1, it has been pleaded as under:-

6.1 The defendant operates under the name and style of “JV Evergreen Sweets & Treats” in which ‘JV’ represents the initials of the two partners of the defendant no.1.

6.2 The families of the partners of the defendant no.1 have been in the business of sweets in the Lajpat Nagar area since 1950 under the name of “Bhagwan Sweets”.

6.3 The defendant no.1 partnership was formed on 12th November, 2020 under the aforesaid name and style of “JV Evergreen Sweets & Treats”.

6.4 The defendant no.1 applied for trade mark registration for the device



mark in classes 35 and 43 on 11th January, 2021, which were granted in its favour on 8th May, 2024 and 11th May, 2024, respectively.

SUBMISSIONS OF THE PLAINTIFF

7. Mr. Sidhant Kumar, Learned counsel appearing on behalf of the plaintiff has made the following submissions:-



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7.1 The plaintiff is the prior user of the mark from the year 1963. The plaintiff is also the prior registered proprietor of the device mark



with effect from 28th August, 1998. The word “Evergreen” is the most prominent and essential part of the registered trade mark.

7.2 The plaintiff has accumulated substantial reputation and goodwill in the market, having been in existence for the past 60 years.

7.3 The defendant no.1 began the use of the impugned mark only in the year 2021. A comparison of the impugned mark of the defendant no.1 with that of the plaintiff reflects that the defendant no.1 has adopted all predominant features of the impugned mark including the trade dress to pass off his business/products as that of the plaintiff.

7.4 The impugned mark is being used by the defendant to sell identical products as that of the plaintiff which is likely to cause confusion in the market and would also cause dilution of the goodwill and reputation of the plaintiff in the market. Reliance is placed on the judgment of the Division Bench of this Court in *Wipro Enterprises Private Limited v. Himalaya Wellness Company and Ors.*¹.

SUBMISSIONS OF THE DEFENDANT

8. Mr. Ashutosh Lohia, learned counsel appearing on behalf of the defendant no.1 has made the following submissions:-

¹ 2024 SCC OnLine Del 6859



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8.1 The term 'Evergreen' is a generic word and is highly descriptive in nature and therefore, nobody can monopolise the same.

8.2 There are various other entities using the name 'Evergreen' in the same line of trade which shows that the term is generic in nature.

8.3 The defendant no.1 is a registered proprietor of the impugned mark in class 35 and class 43, and the plaintiff has not filed any objection to the said registrations.

8.4 In a short span, the defendant no.1 has established a strong reputation in its domain and has obtained better ratings and reviews on various food delivery applications in comparison with the plaintiff.

8.5 A comparison of the defendant no.1's mark with the plaintiff's mark would show that there is a significant difference between them. The combination of the prefix "JV" and the suffix "Sweets & Treats" is integral to the defendant no.1's entity.

8.6 The mark used by the defendant no.1 taken as a whole is completely different from that of the plaintiff and therefore, there is no possibility of any confusion in the marks.

8.7 In support of his submissions, the counsel for the defendant no.1 places reliance on the judgment of the coordinate bench in *Mountain Valley Springs India Private Limited v. Baby Forest Ayurveda Private Limited*².

8.8 No interim injunction can be granted in favour of the plaintiff on account of the plaintiff having acquiesced in the use of the impugned mark by the defendant no.1. The defendant no.1 has been using the mark for over 4 years, reliance in this regard has been placed on the judgment of the

² 2024:DHC:4053



Supreme Court in *M/s Power Control Appliances v. Sumeet Machines Pvt. Ltd*³.

ANALYSIS AND FINDINGS

9. I have heard the counsel for the parties and perused the material on record.

10. It is an undisputed position that the marks of both the plaintiff and the defendant no.1 have been registered, the plaintiff under class 30 whereas defendant no.1 under classes 35 and 43.

11. The present suit has been filed by the plaintiff for infringement as well as passing off. Under Section 27(2) of the Trade Marks Act, an action on the basis of passing off is maintainable *dehors* the registration granted under the Act. A reference may be made to the judgment of the Supreme Court in *S. Syed Mohideen v. P. Sulochana Bai*⁴, wherein the Supreme Court has held that the rights of the prior user are superior to the rights of a subsequent user emerging out of registration. It was also observed that the rights of the prior user remain unaffected by the registration granted under the Act. The observations of the Supreme Court in paragraph 31 are set out below:-

“31. Secondly, there are other additional reasonings as to why the passing off rights are considered to be superior than that of registration rights.

31.1. Traditionally, passing off in common law is considered to be a right for protection of goodwill in the business against misrepresentation caused in the course of trade and for prevention of resultant damage on account of the said misrepresentation. The three ingredients of passing off are goodwill, misrepresentation and damage. These ingredients are considered to be classical trinity under the law of passing off as per the speech of Lord Oliver laid down in Reckitt & Colman Products Ltd. v. Borden Inc. [Reckitt &

³ 1992 2 SCC 448

⁴ (2016) 2 SCC 683



Colman Products Ltd. v. Borden Inc., (1990) 1 WLR 491 : (1990) 1 All ER 873 (HL)] which is more popularly known as “Jif Lemon” case wherein Lord Oliver reduced the five guidelines laid out by Lord Diplock in *Erven Warnink Besloten Vennootschap v. J. Townend & Sons (Hull) Ltd.* [*Erven Warnink Besloten Vennootschap v. J. Townend & Sons (Hull) Ltd.*, 1979 AC 731 at p. 742 : (1979) 3 WLR 68 : (1979) 2 All ER 927 (HL)] (“the *Advocaat* case”) to three elements: (1) goodwill owned by a trader, (2) misrepresentation, and (3) damage to goodwill. **Thus, the passing off action is essentially an action in deceit where the common law rule is that no person is entitled to carry on his or her business on pretext that the said business is of that of another.** This Court has given its imprimatur to the above principle in *Laxmikant V. Patel v. Chetanbhai Shah* [*Laxmikant V. Patel v. Chetanbhai Shah*, (2002) 3 SCC 65].

31.2. The applicability of the said principle can be seen as to which proprietor has generated the goodwill by way of use of the mark/name in the business. The use of the mark/carrying on business under the name confers the rights in favour of the person and generates goodwill in the market. Accordingly, the latter user of the mark/name or in the business cannot misrepresent his business as that of business of the prior right holder. That is the reason why essentially the prior user is considered to be superior than that of any other rights. Consequently, the examination of rights in common law which are based on goodwill, misrepresentation and damage are independent to that of registered rights. The mere fact that both prior user and subsequent user are registered proprietors are irrelevant for the purposes of examining who generated the goodwill first in the market and whether the latter user is causing misrepresentation in the course of trade and damaging the goodwill and reputation of the prior right holder/former user. That is the additional reasoning that the statutory rights must pave the way for common law rights of passing off.”

[Emphasis is mine]

12. The principle of law that emerges from the aforesaid decision is that the remedy of passing off is broader in its ambit than infringement. The three elements which are necessary to make out a case of passing off are goodwill and reputation attained by the plaintiff, misrepresentation by the



defendant and the damage caused to the plaintiff's goodwill and reputation by the acts of the defendant. The fact that both the 'prior user' and the 'subsequent user' are registered proprietors shall be irrelevant for the purposes of passing off action.

13. The judgement in *S. Syed Mohideen* (supra) was followed recently by the Division Bench of this court in *Wipro Enterprises* (supra).

14. In *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*⁵, the Supreme Court laid down the following tests for determining deceptive similarity between the competing goods/services. Paragraph 35 of the aforesaid judgment is set out below:-

“35. Broadly stated, in an action for passing-off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors are to be considered:

(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.

(b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect of which they are used as trade marks.

(d) The similarity in the nature, character and performance of the goods of the rival traders.

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods.

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.”

[Emphasis is mine]

15. Applying the principles of passing off as set out in the aforesaid precedents to the facts of the present case, in my *prima facie* view, the

⁵ (2001) 5 SCC 73



plaintiff has established a case of passing off, for the reasons set out hereinafter.

16. It cannot be denied that the most distinctive and prominent part of the name of the plaintiff's mark is 'Evergreen'. A comparison made between the marks used by the plaintiff and the defendant no.1 is set out in the table below:-

Plaintiff's Trade Mark	Defendant's Trade Mark
	
Plaintiff's Shop	Defendant's Shop
	

17. The above comparison makes it abundantly clear that the defendant no.1 has copied the most distinctive part of the plaintiff's mark, which is 'Evergreen'. In the case of the defendant no.1, the word 'Evergreen' has the



prefix “JV” and the suffix “Sweets and Treats”, whereas in the plaintiff’s case, the word ‘Evergreen’ is followed by the word “Sweet House”.

18. However, in my view, the aforesaid differences are inconsequential as the most prominent part of the mark of the plaintiff’s mark is ‘Evergreen’. Additionally, both the plaintiff and the defendant no.1 prominently use the colour green in their banners as well as logos.

19. It is not in dispute that the plaintiff is the prior user of the mark ‘Evergreen’. The plaintiff is also the prior registrant of the device mark bearing the word ‘Evergreen’. The plaintiff claims to be using the mark ‘Evergreen’ from 1963, the date when the plaintiff opened its shop in the Green Park market of South Delhi. The user of the name ‘Evergreen’ by the plaintiff from 1963 has not been denied by the defendant no.1. In support of its aforesaid claim, the plaintiff has placed on record the following documents/details:-

- i. Certificate of registration dated 26th April, 1965, under the Delhi Sales Tax Act. [Page no.29, plaintiff’s documents]
- ii. The registration certificate dated 25th June, 1965, under the Delhi Shops and Establishment Act. [Page no.30, plaintiff’s documents]
- iii. Invoices bearing the name ‘Evergreen’. [Page nos.34-51, plaintiff’s documents]
- iv. The revenue figures of the plaintiff from 2019 to 2023. [paragraph 20 of the plaint]



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20. Based on the aforesaid, in my assesment, the plaintiff has placed on record sufficient evidence to establish its goodwill and reputation in the market at a *prima facie* stage.

21. On the other hand, admittedly, the defendant no.1 firm came into existence only on 12th November, 2020, when the Partnership Deed was executed. The GST registration was obtained by the defendant no.1 on 11th December, 2020. The defendant no.1 applied for registrations in respect of its device mark bearing the word 'Evergreen' only on 11th January, 2021, which were subsequently granted.

22. Admittedly, the defendant no.1 is in the similar business of selling identical products as the plaintiff, i.e. sweets and namkeens. Pertinently, the defendant no.1 operates its shop in Lajpat Nagar, which is in close proximity to the store of the plaintiff in Green Park market.

23. So, there is a very real likelihood of the customers being misled into believing that the outlet being operated by the defendant no.1 has some association with the plaintiff.

24. On behalf of the defendant no.1, it is contended that the family members of the two partners of the defendant no.1 have been in the Sweets and Namkeen business for about 50 years albeit under different names.

25. On a pointed query from the Court as to how did the defendant no.1 adopt the name 'Evergreen', the counsel for the defendant no.1 could not provide any explanation. His only answer was that there are many entities in the same business using the name 'Evergreen' and the plaintiff has selectively filed a case only against the present defendant.

26. The aforesaid stand of the defendant no.1 is not sustainable in law. Merely because the plaintiff has chosen to sue the defendant no.1 and not



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other infringing parties, cannot be held against the plaintiff. The plaintiff cannot be compelled to file legal proceedings against all the persons who are allegedly infringing or passing off their goods as that of the plaintiff. Reference in this regard may be made to the judgment of the Division Bench of this Court in the case of *Amba Shakti Steels Limited. v. Sequence Ferri Private Limited.*⁶ which followed the judgment of the Division Bench in *Nutrica Pusti Healthcare Pvt v. Morepen Laboratories*⁷.

27. It is not the case of the defendant no.1 that they surveyed the market or conducted a search on the Trade Mark Registry before adopting the name 'Evergreen', nor is it the case of the defendant no.1 that they were unaware of the plaintiff running a sweet shop under the name 'Evergreen'.

28. In *Wipro Enterprises* (supra), both the plaintiff and the defendant had obtained registrations for the mark "Evecare" in respect of allied and cognate products. The Division Bench held that the defendant was a subsequent user of the identical mark and did not offer any plausible explanation for adopting the said mark. Accordingly, the order of interim injunction passed in favour of the plaintiff on the basis of passing off was confirmed by the Division Bench.

29. In the present case also, the defendant no.1 has failed to give any plausible reason for adopting an identical name as that of the plaintiff. Therefore, in my *prima facie* view the adoption of the mark 'Evergreen' by the defendant no.1 was not *bona fide* and amounts to misrepresentation.

30. Counsel for the defendant no.1 has placed reliance on the judgment of *Power Control Appliances* (supra), in support of his contention that there

⁶ 2024 SCC OnLine Del 6179

⁷ 2021 SCC Online Del 2631



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has been acquiescence on the part of the plaintiff. The said judgment is not applicable to the present case as there is nothing on record to show that the plaintiff was aware of the defendant no.1 using an identical trade mark for an earlier period of time. It is the case of the plaintiff that they became aware of the defendant no.1's use of the impugned mark only in May, 2024 and immediately, a cease-and-desist notice was issued by the plaintiff to the defendant no.1. Therefore, there is no question of any acquiescence by the plaintiff.

31. The defendant has also placed reliance on the judgment of the Coordinate Bench on *Mountain Valley Springs India Private Limited* (supra)⁸. In the said case, the plaintiff was using the registered mark of "Forest Essentials" along with the device mark 'Tree' in respect of cosmetics. On the other hand, the defendants were using the mark "Baby Forest" in respect of baby products. After an elaborate discussion, the Court denied the grant of an interim injunction to the plaintiff holding that the defendants were only in the field of baby products whereas the plaintiff was in the field of adult cosmetics. Further, upon a comparison of the competing marks i.e., 'Forest Essentials' and 'Baby Forest' in conjunction with the trade dress used by the parties, it was observed that there is no likelihood of confusion.

32. In my view, the aforesaid judgment cannot come to the rescue of the defendant no.1 in the present case as the defendant no.1 is using an identical mark, i.e. 'Evergreen' in respect of identical products.

⁸ 2024:DHC:4053



33. Next, it is contended on behalf of the defendant no.1 that ‘Evergreen’ is a generic and descriptive word and no person can be allowed to monopolise the same. This submission is completely contrary to the stand taken by the defendant no.1 itself in its trademark registration applications. The defendant no.1 itself applied for and obtained registrations in respect of the device marks bearing the word ‘Evergreen’. In its reply to the examination report of the registry, the defendant no.1 has categorically taken a stand that its trade mark does not designate the kind, quality, quantity or intended purpose of the goods. Therefore, the defendant no.1 cannot be allowed to approbate and reprobate. Reference may be made to the judgment of this Court in the plaintiff’s own case, *Evergreen Sweet House v. Ever Green and Ors.*⁹ wherein the defendants took a similar stand that the mark ‘Evergreen’ is a generic and a descriptive mark. The relevant portion of the aforesaid judgment is set out below:-

“20. The plaintiff’s mark is a word mark. It is not descriptive or suggestive of the products or services offered. EVERGREEN does not readily conjure up the image of sweets- the two words used in conjunction with each other naturally lead the mind on to a green vista, or an association with the habitat, or environs.[sic environs] The mark, in relation to sweets and confections is arbitrary; a coined one. ...”

34. It is significant to note that in the present times, online delivery of food products has become the norm and food delivery apps like Zomato (defendant no.2) and Swiggy (defendant no.3) have become extremely popular. Both the plaintiff and the defendant no.1 are listed on the food delivery applications such as Swiggy and Zomato. If any unsuspecting consumer is to search for ‘Evergreen’ on these platforms, both the outlets of

⁹ 2008 SCC OnLine Del 1665



the plaintiff and the defendant no.1 would show up. Therefore, in my *prima facie* view, there is a likelihood of confusion and deception among the members of the public.

35. In view of the discussion above, a *prima facie* case of passing off is made out on behalf of the plaintiff. The balance of convenience is also in favour of the plaintiff and against the defendant no.1 inasmuch as the plaintiff has been in business for more than sixty years whereas the defendant no.1 has merely started about three years back.

36. Irreparable harm and injury would be caused not only to the plaintiff but also to the public at large if the defendant no.1 continues to use the infringing mark.

37. Accordingly, the defendant no.1 its partners or proprietors, officers, servants, agents and all persons acting by, through or under them are restrained from using “JV Evergreen Sweets & Treats”



or any other mark, trade dress, packaging/marketing material which bears the mark “Evergreen” or any other mark which is identical or deceptively similar to the mark “Evergreen”, in any manner whatsoever, till the final adjudication of this Suit.

38. The defendant no.1 is directed to take down all its listings bearing the mark “Evergreen” on the defendants no.2 and 3’s platforms namely, Zomato and Swiggy. If the defendant no.1 fails to comply with the aforesaid directions within two weeks, then the defendant no.2/Zomato Media Private



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Limited and the defendant no.3/Bundl Technologies Pvt. Ltd. are directed to delist/block the use of the impugned mark on their respective platforms.

39. The defendant no.1 is directed to remove the URLs bearing the



impugned marks “JV Evergreen Sweets & Treats”

from the defendant no.4/Meta Platforms, Inc.’s platforms. If the defendant no.1 fails to comply with the aforesaid directions in two weeks, then the defendant no.4/Meta Platforms, Inc., upon being notified by the plaintiff, is directed to immediately take-down/block/disable access to the defendant no.1’s social media accounts maintained on Instagram.

40. Needless to state, any observations made herein are only for the purpose of adjudication of the present application and would have no bearing on the final outcome of the suit.

41. The present application stands disposed of in the above terms.

42. List before Joint Registrar on 3rd February, 2025.

**AMIT BANSAL
(JUDGE)**

December 23, 2024

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