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

+ **CS(COMM) 496/2023**

M/S L OREAL INDIA PRIVATE LIMITED
AND ANR.

..... Plaintiffs

Through: Mr. S. K. Bansal and Mr. Ajay
Amitabh Suman, Advocates (M:
9990389539).

versus

M/S PORNSRICHAROENPUN CO. LTD AND
ANR.

..... Defendants

Through: Mr. Yatin Khochare, Ms. Janhvi
Chadha, Ms. Preeta Panthaki and Ms.
Pritika Juneja, Advocates (M:
9871354113).

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WITH

+ **C.O. (COMM.IPD-TM) 653/2022**

BERINA COSMETICS PVT. LTD.

..... Petitioner

Through: Mr. Yatin Khochare, Ms. Janhvi
Chadha, Ms. Preeta Panthaki and Ms.
Pritika Juneja, Advocates (M:
9871354113).

versus

L OREAL

..... Respondent

Through: Mr. S. K. Bansal and Mr. Ajay
Amitabh Suman, Advocates for R-1
(M: 9990389539).

CORAM:

JUSTICE PRATHIBA M. SINGH

ORDER

% **25.07.2023**

1. This hearing has been done through hybrid mode.
2. The present matters pertain to the use of the mark 'HAIR SPA' which is under dispute between the parties.



3. After hearing Id. Counsel for the parties, the following issues are framed in the present suit:

- (i) *Whether the suit is instituted by a proper person? OPP*
- (ii) *Whether the Plaintiff enjoys any rights in the mark Hair Spa per se, independently of the mark Loreal? OPP*
- (iii) *Whether the mark Hair Spa enjoys exclusive reputation and goodwill, qua the Plaintiff, independently of the mark Loreal? OPP*
- (iv) *Whether the mark Hair spa has acquired secondary meaning qua the Plaintiffs? OPP*
- (v) *Whether the relief sought is barred due to delay and acquiescence on part of the Plaintiff? OPD*
- (vi) *Whether any exclusive rights can be claimed in the said mark Hair Spa due to the limitations and conditions imposed therein? OPD*
- (vii) *Whether the word Hair Spa is descriptive, publici juris and common to the trade, and hence the Defendant is entitled to use the same in view of Section 30 of the Act? OPD*
- (viii) *Whether the Defendant's claimed user of the mark since 2006 is genuine and bonafide and is borne out from the record?OPD*
- (ix) *Whether the Plaintiff is entitled to permanent injunction qua the mark Hair Spa either on the ground of infringement or passing off? OPP*
- (x) *Whether the manner of use of the mark Hair Spa also results in passing off, of the Defendant's products as that of the Plaintiffs? OPP*
- (xi) *Whether the trademark registration 1515107 in Class 3 is invalid and is liable to be rectified? OPD*



(xii) Relief, Damages and costs OPP

4. Issues have been framed. In view of the fact that the Tribunal Reforms Act, 2021 has abolished the IPAB and the jurisdiction vests in the High Court now for cancellation or rectification of trademark, it is deemed appropriate not to stay the suit as the issues which would be arising for determination would be overlapping and common between the suit and the rectification petition.

5. Rule 26 of the Intellectual Property Division ('IPD') read as under:-

“Rule 26- Intellectual Property Division ('IPD') – Consolidation of IPR subject matters or cases or proceedings or disputes -Where there are multiple proceedings relating to the same or related IPR subject matter, irrespective of whether the said proceedings are between the same parties or not, the Court shall have the power and the discretion, wherever appropriate, to direct consolidation of proceedings, hearings, and also to direct consolidated recording of evidence/common trial and consolidated adjudication. If the Court is of the opinion that any matter pending before a Commercial Court is to be consolidated with a matter pending before the IPD, it may exercise powers of transfer under Section 24, Code of Civil Procedure, 1908 for transfer and consolidation of such matter to itself.”

6. Exercising powers under Rule 26 of the IPD Rules , the trial in the suit and the rectification petition is consolidated and common issues have been framed as set out above.

7. Both parties are permitted to file their additional documents, if any, within thirty days as a last and final opportunity. No further opportunity



shall be granted to file documents. Any documents which the witnesses wish to rely upon shall also be part of these additional documents. No additional documents shall be filed with the witness statements or the affidavits in evidence.

8. After conferring with the parties, the Court is informed that the Plaintiff and the Defendant would wish to produce three witnesses each. By the next date of hearing before the Court, both parties shall file their list of witnesses. Plaintiff shall also file its affidavits in evidence by the next date. The same shall be perused and then the schedule for trial shall be set by the Court.

9. Considering the nature of the matter, both parties consent to the appointment of a Local Commissioner to record the evidence in the matter. Accordingly, Mr. Tejveer Singh Bhatia, Advocate (9899528289) is appointed as a Local Commissioner to record the evidence.

10. The fee of the Local Commissioner is fixed at Rs.1.5 lakh to be paid by the Plaintiff and Rs.1 Lakh by the Defendant. The expenses for the Local Commissioner, for recording of evidence and the booking of rooms etc. shall be incurred by the Plaintiff for their witnesses' evidence and by the Defendant for their witnesses' evidence.

11. The Admission/Denial of all documents shall be carried out after the additional documents are filed. For the said purpose, list before the Joint Registrar for marking of exhibits on 13th September, 2023.

12. List before the Court on 18th October, 2023.

PRATHIBA M. SINGH, J.

JULY 25, 2023/mr/rp