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

+ **CS (COMM) 587/2022**

DOMINOS IP HOLDER LLC & ANR. .... Plaintiffs  
Through: Mr. Pravin Anand, Mr. Shantanu  
Sahay, Ms. Imon Roy and Mr.  
Apoorv Bansal, Advocates.  
(M:8210095739)

versus

MS DOMINICK PIZZA & ANR. .... Defendants  
Through: None.

**CORAM:**

**JUSTICE PRATHIBA M. SINGH**

**ORDER**

% **29.08.2022**

1. This hearing has been done through hybrid mode.

**I.A.13558/2022 (for exemption)**

2. This is an application seeking exemption from filing original/certified/clearer/typed or translated copies of documents. Exemption is allowed, subject to just exceptions.

***I.A.13558/2022*** is disposed of.

**I.A. 13557/2022 (additional documents)**

3. This is an application seeking leave to file additional documents under the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 (*hereinafter, 'Commercial Courts Act'*). The Plaintiff, if it wishes to file additional documents at a later stage, shall do so strictly as per the provisions of the Commercial Courts Act.

4. ***I.A. 13557/2022*** is disposed of.




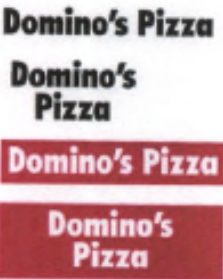
**CS (COMM) 587/2022**




5. Let the plaint be registered as a suit.
6. Issue summons to the Defendants through all modes upon filing of Process Fee.
7. The summons to the Defendants shall indicate that a written statement(s) to the plaint shall be positively filed within 30 days from date of receipt of summons. Along with the written statement, the Defendants shall also file an affidavit of admission/denial of the documents of the Plaintiffs, without which the written statement shall not be taken on record.
8. Liberty is given to the Plaintiffs to file a replication within 15 days of the receipt of the written statement(s). Along with the replication, if any, filed by the Plaintiffs, an affidavit of admission/denial of documents of the Defendants, be filed by the Plaintiff, without which the replication 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.
9. List before the Joint Registrar for marking of exhibits on 14th October, 2022. It is made clear that any party unjustifiably denying documents would be liable to be burdened with costs.
10. List before Court on 24th November, 2022.

**I.A.13556/2022 (u/O XXXIX Rules 1 & 2 CPC)**

11. The Plaintiff No.1 - Dominos IP Holder LLC, has filed the present suit for permanent injunction restraining infringement of trademark, rendition of accounts, damages etc., against the Defendants. The Plaintiffs are seeking protection of the mark 'Domino's Pizza', and the accompanying device mark, logo mark, as also the marks 'Cheese Burst' and 'Pasta Italiano', which are used by the Plaintiffs. The marks of the Plaintiff, as also

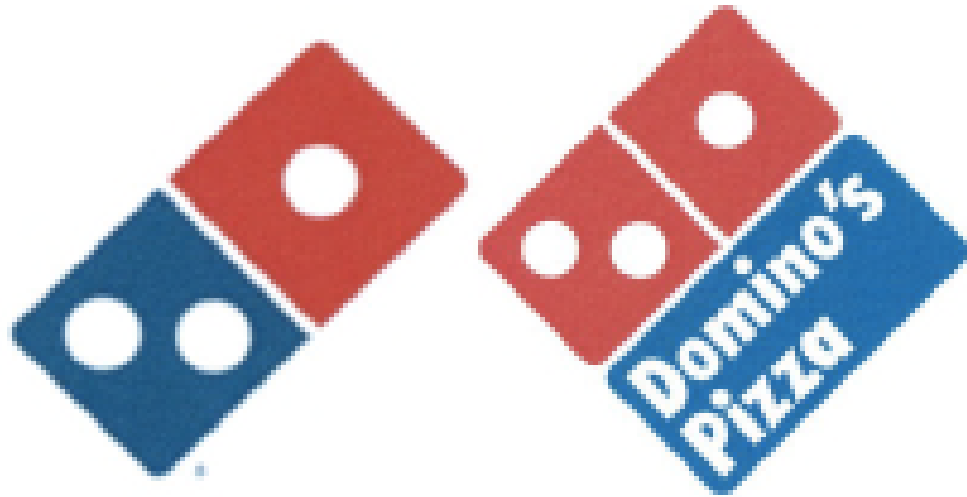
the accompanying logos, in various variant forms, are all registered trademarks. The details of the said marks are set out hereinbelow:

Application No.	Trademark	Application date	Class	Status
463304	DOMINO'S	19/11/1986	30	Registered
572312		30/04/1992	30	Registered
1238053		18/09/2003	42	Registered
1238054		18/09/2003	39	Registered
2145011		16/05/2011	29, 30, 39 & 43	Registered

2145001		16/05/2011	29, 30	Registered
2145008		16/05/2011	29,30	Registered
2145009		16/05/2011	29,30,39 & 43	Registered

12. The case of the Plaintiffs is that the Plaintiff No. 1 company was founded in Michigan, USA, when Mr. Tom Monaghan, along with his brother James Monaghan, purchased a pizza store by the name “DomiNick’s Pizza”, owned by Mr. Dominick DiVarti. It is submitted that in 1965, the

Monaghan's purchased two more restaurants, and changed the name to Domino's Pizza. Since then, the Plaintiff No. 1 has continually adopted the mark 'Domino's Pizza'. The proprietary logo of the Plaintiff No. 1, in its traditional blue and red colour combination, is copied hereinbelow:



13. The Plaintiff No. 1 has expanded its operations in over 90 countries. It has almost 20,000 stores across the world, with retail sales amounting to 17.8 billion US dollars globally in 2021, including in the USA. The Plaintiffs launched in India in 1996, when the first outlet was opened in New Delhi. In India, the Plaintiff No. 1 conducts its business through Plaintiff No. 2 - Jubilant FoodWorks Limited. Since 1996, the Plaintiffs have operated around 1567 outlets in over 337 cities across the country.

14. The Plaintiffs have promoted the pizza business in India through the website [www.dominos.co.in](http://www.dominos.co.in), and also enjoy considerable social media presence, with over 100 lakhs downloads for the mobile application. It is submitted that the promotional expenses of the Plaintiffs are over Rs.100/- crores annually, and the Indian annual revenues are to the tune of Rs. 2900/-

crores.

15. It is submitted by Mr. Anand, Id. Counsel for the Plaintiffs, that the mark “Domino’s Pizza” has also been protected repeatedly in several suits, such as in *CS(COMM) 249/2020* titled *Dominos IP Holder LLC & Anr. Vs. Hominos Pizza*, and *CS(COMM) 614/2019* titled *Dominos IP Holder LLC & Anr. Vs. Domi’s Pizza & Ors.*, wherein the decrees have been granted in favour of the Plaintiffs.

16. The Defendant No.1 in the present case is M/s Dominick Pizza, through its proprietor Mr. Sandeep Kumar Sharma, who has three outlets i.e., one in Indirapuram, Ghaziabad, Uttar Pradesh, the second one at Raj Nagar Extension, Ghaziabad, Uttar Pradesh, and lastly in Nakodar, Mehatpur, Punjab. It is the grievance of the Plaintiffs in the present suit that the Defendant No. 1 is using a deceptively similar logo, mark, and trade name - ‘Dominick Pizza’. The Defendant No. 1 is also unauthorizedly using the Plaintiffs’ other registered trademarks, such as ‘Cheese Burst’ and ‘Pasta Italiano’. The Defendants are using the following marks/names, along with the device:







17. The Plaintiffs acquired knowledge of the Defendant No. 1's use of the mark 'Dominick Pizza', in January, 2020, when they came across the Ghaziabad outlet. An investigation was conducted on behalf of the Plaintiffs', and the investigators report dated 5<sup>th</sup> August, 2022, is on record. Through the online investigation, it was revealed that the Defendants are listed on popular online food ordering platforms, such as Zomato.

18. The case of the Plaintiffs is that the Defendant No. 1 has not only copied the name, but also the flavour and dishes of the Plaintiffs'. Mr. Anand, Id. Counsel, submits that the investigator has clearly confirmed that the Defendants are supplying pizzas in Delhi, which can be easily ordered through online food portals. Actual instances of confusion have taken place, and one review of a customer is relied upon to show the manner in which the



Plaintiffs' mark and business is being tarnished and diluted by the Defendants' use of the similar mark and logo, as also the dishes of the Plaintiffs. There are several other Google reviews on record, which reveal customers have placed online Zomato orders with the Defendant No. 1, while thinking that an order is being placed with the Plaintiffs.

19. Mr. Anand further submits that the Plaintiffs also gave a notice for pre-litigation mediation, which has evoked no response from the Defendants and thus, the Delhi High Court Mediation and Conciliation Centre (*hereinafter "Mediation Centre"*), has ended the conciliation proceedings as a "non-starter", vide Conciliation Report dated 4<sup>th</sup> April, 2022.

20. A perusal of the record shows that the Defendants have used the name 'Dominick Pizza', which is nothing but the identical historical name of the Plaintiff's store. The initial store, which was purchased by the Plaintiff No.1's founder in 1960, from Mr. Dominick DiVarti looked as under:



21. Thus, it is clear that the name 'Dominick' is integrally and historically

associated with the Plaintiffs, and the use of an identical name as the founder/predecessor of the Plaintiffs in a similar logo form for pizzas would be confusing and deceptive in nature. The dishonesty in the adoption is further strengthened by the fact that the Defendants are copying various flavour variants of the Plaintiffs, such as 'Cheese Burst' and 'Pasta Italiano'. One of the reviews which has been given by a customer on Google, which has been placed on record, shows clearly that there is complete confusion being caused.

22. A perusal of the record further shows that the Defendant No. 1 applied for the mark 'Dominick Pizza', vide application no. 3285916. The examination report of the said mark dated 15<sup>th</sup> December, 2017, cites the Plaintiff No. 1's registered trademark nos. 572312 and 2145011. Vide letter dated 23<sup>rd</sup> April, 2021, the Registrar of Trademarks was requested to withdraw the mark no. 3285916 of the Defendant No. 1. However, the same request was objected to vide letter dated 26<sup>th</sup> July, 2021, in which it was claimed on behalf of the Defendant No. 1, that the Defendant had never wished to withdraw the mark, and this was a mistake on behalf of the Defendant No. 1's erstwhile Counsels. The operative portion of the letter dated 26<sup>th</sup> August, 2021, has been extracted hereinbelow:

*“The above mentioned trade mark application is pending before this Hon'ble forum. Now the applicant has executed power of attorney in our favor and has changed the previous attorneys/agent. We have filed request on form TM-M to change the address for service in the said application; the said request has been allowed. Few days after filing of our said request on Form TM-M, the applicant's earlier attorneys S Vanchinathan Advocate, No. 6, Dhanammal Street, Spurtank Road, Chetpet, Chennai-*

*600031 wrongly filed a letter of withdrawal of our above mentioned trade mark application. The applicant had never passed any instructions to his previous attorneys/agent to withdraw the above said trade mark application and the letter of withdrawal uploaded by them has not been signed by the applicant, rather the applicant alleged that the previous attorneys/agent forged his signatures on the said withdrawal letter.”*

23. The Conciliation Report of the Mediation Centre also notes specifically that the Conciliator had fixed the matter for conciliation proceedings on at least six dates, being 20<sup>th</sup> March, 2022, 26<sup>th</sup> February, 2022, 12<sup>th</sup> March, 2022, 20<sup>th</sup> May, 2021, 5<sup>th</sup> July, 2021 and 19<sup>th</sup> July, 2021, and “*one of the parties was not interested in participating in the conciliation proceedings*”.

24. Upon hearing the Id. Counsel for the Plaintiffs and perusing the record, it is clear that the competing marks are deceptive and imitative of each other. The manner of the listings of the Defendant No. 1 on various social media platforms and online ordering platforms, leaves no doubt in the mind of the Court that the name and business of the Defendant No. 1 is being confused as that of the Plaintiffs’ outlets. The reviews of the consumers on Google Reviews, also re-affirms this fact that apart from the confusion that is taking place, there is severe tarnishment and dilution of the Plaintiffs’ mark and business. Accordingly, as per the facts and circumstances of this matter, the Plaintiffs have made out a *prima facie* case in their favour for grant of an *ex-parte ad interim* injunction. The balance of convenience lies in favour of the Plaintiffs, and irreparable injury would be caused if the injunction is not granted.

25. Accordingly, the Defendant No.1, its proprietors, partners, directors,

officers, servants, agents, franchisers and all others acting for and on its behalf, are restrained from advertising, selling, offering for sale, marketing etc. any product, packaging, menu cards and advertising material, labels, stationery articles, website or any other documentation using, depicting, displaying in any manner whatsoever, the impugned marks 'Dominick Pizza', 'Cheese Burst' and 'Pasta Italiano' or any other marks or devices/logos which are identical or confusingly/deceptively similar to the Plaintiff's registered trademarks, till the next date of hearing.

26. Insofar as the Defendant No.2 - GoDaddy is concerned, it is directed to block/suspend the Defendant No. 1's domain names, [www.dominickpizza.com](http://www.dominickpizza.com) and [www.dominickpizzas.com](http://www.dominickpizzas.com).

27. Compliance of Order XXXIX Rule 3 CPC be effected within two weeks.

28. Reply to the application be filed within four weeks from the service of the present order along with the paper book.

29. List on 24<sup>th</sup> November, 2022, the application before the Court

**PRATHIBA M. SINGH, J.**

**AUGUST 29, 2022/dk/ss**