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

+ CS(COMM) 856/2022

WHITEHAT EDUCATION TECHNOLOGY
PRIVATE LIMITED

..... Plaintiff

Through: Ms.Swetaree Majumdar, Mr.Prithvi
Singh, Mr.Rohan Krishna Seth and
Ms.Archita Nigam, Advocates.

versus

VINAY KUMAR SINGH

..... Defendant

Through: None.

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

ORDER

% **12.12.2022**

I.A. 20835/2022(for exemption)

1. Subject to the plaintiff filing the true/ typed copies of the dim documents on which the plaintiff may seek to place reliance, within four weeks from today, exemption is granted for the present.
2. The application is disposed of.

I.A. 20834/2022(O-XI R-1(4) of Commercial Courts Act)

3. The present application has been filed on behalf of the plaintiff seeking leave to file additional documents under the Commercial Courts Act, 2015.
4. The plaintiff is granted thirty days' time to file additional documents.
5. Accordingly, the application is disposed of.

I.A. 20833/2022(u/s 12A of Commercial Courts Act)

6. In view of the urgent interim relief sought, plaintiff is granted

exemption from the requirement of pre-institution mediation in terms of Section 12A of the Commercial Courts Act, 2015.

7. The application stands disposed of.

CS(COMM) 856/2022

8. Let the plaint be registered as a suit.

9. Issue summons.

10. Summons be issued to the defendant through all modes.

11. The summons shall state that the written statement shall be filed by the defendant within thirty days from the date of the receipt of summons. Along with the written statement, the defendant shall also file an affidavit of admission/denial of the documents of the plaintiff, without which the written statement shall not be taken on record

12. Liberty is given to the plaintiff to file replication, if any, within thirty days from the receipt of the written statement. Along with the replication filed by the plaintiff, an affidavit of admission/denial of the documents of the defendant, be filed by the plaintiff.

13. The parties shall file all original documents in support of their respective claims along with their respective pleadings. In case parties are placing reliance on a document, which is not in their power and possession, its detail and source shall be mentioned in the list of reliance, which shall be also filed with the pleadings.

14. If any of the parties wish to seek inspection of any documents, the same shall be sought and given within the timelines.






15. List before the Joint Registrar on 2nd February, 2023 for completion of pleadings.


16. List before the Court on 21st March, 2023.

I.A. 20832/2022(O-XXXIX R-1& 2 of CPC)

17. The present suit has been filed seeking permanent injunction restraining infringement of trademarks, passing off and other ancillary reliefs.



18. Plaintiff company is a edutech start-up offering online education services. In August, 2020 the plaintiff company was acquired by Think & Learn Private Limited. Plaintiff company has registrations of the mark ‘WhiteHat Jr’ as well as other derivatives in class 38 and other classes, details of which are given below:

S. No.	Trademark No.	Mark	Class	Date
1.	4765358	WHITEHAT JR	38	02-12-2022
2.	4143790	Whitehat Jr	9	10-04-2019
3.	4143802	Whitehat Jr	41	10-04-2019
4.	4765361		38	02-12-2020
5.	4765363		09	02-12-2020
6.	4765364		41	02-12-2020
7.	4252284		9	31-07-2019
8.	4251271		41	30-07-2019

9.	5093554		16	18-08-2021
10.	5093555		41	18-08-2021
11.	5126281		9	10-09-2021
12.	5126282		41	10-09-2021

19. Plaintiff also holds the domain name “whitehatjr.com”, which was registered on 23rd May, 2018. It is averred that on account of exclusive and extensive use of the plaintiffs’ trademark the said trademark has acquired the status of “*well known*” trademark.

20. It has been averred in the plaint that in October, 2022, the plaintiff came across the defendant’s website “www.whitehatsr.in”. Defendant is in the business of providing services pertaining to digital marketing under the

marks “WHITEHAT SR”/  /  (hereinafter referred to as the “impugned marks”). The impugned marks are also being used as part of the defendants’ domain name i.e., “whitehatsr.in”, which was registered on 9th March, 2020. The defendant also operates various social

media platforms using the impugned marks.

21. A comparative analysis of the marks and domain name used by the defendant and the plaintiff is reproduced below:

Comparative Analysis	Plaintiff	Defendant
Trademark		
		
Website/ Domain name	whitehatjr.com	whitehatsr.in

22. A legal notice dated 4th October, 2022 was sent by the plaintiff to the defendant calling upon the defendant to cease the usage of the impugned marks. A response was received from the defendant on 18th October, 2022 wherein the defendant acknowledged the plaintiff's intellectual property rights in its 'WhiteHat Jr' trademarks and it was claimed that the impugned marks are different from the marks of the plaintiff's and are being used for different services i.e., consultancy services.

23. Issue notice.

24. Notice be issued to defendant through all modes.

25. Reply be filed within four weeks.

26. Rejoinder thereto, if any, be filed before the next date of hearing.



27. A perusal of the aforesaid table comparing the marks and the domain

name of the plaintiff and the defendant shows that the marks being used by the defendant are deceptively similar to those of the plaintiff. The replacement of the suffix “Sr” in ‘WhiteHat Jr’ would not result in a material difference so as to distinguish the marks of the defendant from those of the plaintiffs.

28. In the *prima facie* opinion of the Court, the consumers will be misled that the defendant is in some manner associated/affiliated with the plaintiff or the services are connected to that of the plaintiff.

29. A *prima facie* case has been made out on behalf of the plaintiff. Balance of convenience is in favour of the plaintiff and against the defendant. Irreparable harm and injury would be caused to the goodwill and reputation of the plaintiff if the defendant is continued to use the impugned marks.

30. Consequently, till the next date of hearing, the defendant, its agents, representatives and/or all other acting for and on its behalf are restrained

from using the marks “WHITEHAT SR”/  /  or any other deceptively similar variant thereof as a trademark, tradename, domain name, as a part of its email address/es or in any other manner which amounts to infringement of the plaintiff’s trademarks..

31. Godaddy.com LLC is directed to suspend access and operation of the impugned website/domain name, i.e., whitehatsr.in and take down the said domain name of the defendant.

32. Defendant is also directed to take down all social media pages including but not limited to Facebook, Instragram and LinkedIN which

infringes the trademarks of the plaintiff.

33. Compliance Report under Order XXXIX Rule 3 of the Code of Civil Procedure, 1908 (CPC) be filed within five days.

34. List before the Joint Registrar on 2nd February, 2023 for completion of pleadings.

35. List before the Court on 21st March, 2023.

AMIT BANSAL, J

DECEMBER 12, 2022

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