



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

% *Judgment Reserved on: 29th March, 2023*
Judgment Delivered on: 29th May, 2023

+ **CS(COMM) 920/2022**

MAYO FOUNDATION FOR MEDICAL
 EDUCATION & RESEARCH

..... Plaintiff

Through: Mr. Raunaq Kamath, Mr. Aditya
 Gupta and Ms. Aishwarya Kane,
 Advocates.

versus

BODHISATVA CHARITABLE TRUST & ORS. Defendants

Through: Mr. C.M.Lall, Senior Advocate with
 Ms. Aakanksha Kaul, Mr. Ashish
 Kumar, Ms. Versha Singh and
 Ms. Ananya Chugh, Advocates.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL

JUDGMENT

I.A. 22385/2022 (O-XXXIX R-1 & 2 of the CPC)

1. By way of the present judgment, I shall decide the application filed on behalf of the plaintiff under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC).

CASE SET UP IN THE PLAINT

2. The case set up by the plaintiff in the plaint is as follows:

2.1. The plaintiff is a wholly owned subsidiary of Mayo Clinic, a world-famous charitable organisation incorporated under the laws of the United

Signature Not Verified
 Digitally Signed By: AMIT
 BANSAL
 Signing Date: 29.05.2023 15:40:02



States of America. The origins of the plaintiff can be traced back to an American surgeon, Dr. William Worrall Mayo and his two sons. Dr. Mayo opened the first private clinic in Rochester in the 1880s and his sons established Mayo Clinic in 1914.

2.2. The plaintiff is a leading internationally known medical center recognized for, *inter alia*, providing medical care through a diverse physician-led team of people involved in offering clinical, educational, diagnostic and research services in a unified multi-campus system. The plaintiff owns and operates campuses under the trade mark/name Mayo Clinic in Rochester, Minnesota; Jacksonville, Florida; and Phoenix, Arizona and employs approximately 73,000 personnel comprising of physicians, scientists and health staff.

2.3. The plaintiff's gross revenue under the mark "MAYO" in the year 2021 was around USD 15.7 billion which demonstrates goodwill and reputation under the mark 'MAYO'.

2.4. The plaintiff has been regarded as the leading medical centre for research and specialist education and has garnered substantial goodwill and reputation over the years, including being named the '*#1 hospital nationwide*' by U.S. News and World Report.

2.5. The plaintiff has received widespread exposure and acceptance in the field of health and medicine in India on account of news and health reports of the plaintiff being regularly published and cited in Indian newspapers, magazines and online publications.

2.6. From 2014 to 2022, there have been over 33 crore sessions by Indian users on the plaintiff's website, www.mayoclinic.org and over 10 lakh sessions by Indian users on the plaintiff's website, www.mayo.edu.

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



2.7. The plaintiff is the proprietor of the trademark MAYO and MAYO formative marks in relation to the goods and services offered by the plaintiff in Classes 16, 41, 42 and 44 and other classes including a registration for the standalone word mark 'MAYO' dating back to 1992 in India, details of which are given in paragraph 22 of the plaint. The legal proceedings certificates for the plaintiff's trademarks have been filed along with the plaint. 'MAYO' is also the plaintiff's house mark and constitutes the essential and dominant part of the plaintiff's trading style and the domain names for its websites www.mayoclinic.org, www.mayo.edu and www.mayoclinic.com.

2.8. The plaintiff has also obtained registration of the trade mark 'MAYO' and 'MAYO' formative marks in over 85 countries.

2.9. Defendant no.1, Bodhisatva Charitable Trust is a non-government trust established on 11th July, 2000 under the Indian Trust Act, 1882 providing dissemination of education in the medical field and providing help for medical and surgical treatment. Defendant no.2, Mayo Medical Centre Private Limited, a company incorporated in 1995, is operating a multi-speciality health care centre under the name 'Mayo Medical Centre'. Defendant no.3, Mayo Medical Centre is a super-specialty hospital established by the defendant no.1. Defendant no.4, Mayo Institute of Medical Sciences was established by the defendant no.1 in 2012 and offers medical courses. Defendant no.5, Mayo School of Nursing has been established by the defendant no.3 in 2003. Defendant no.6 is a clinic/hospital operated under the name 'Mayo Hospital'. Defendants no.7 and 8 are the Directors of the defendant no.4 and trustees of the defendant

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



no.1 and are also believed to be responsible for the management and operations of the defendants no.2 to 6.

2.10. The plaintiff became aware of the dishonest adoption of the trademark 'MAYO' by the defendant no.1 in 2014. A legal notice was issued on 11th April, 2014, which was responded to by the defendants on 9th June, 2014. A rejoinder notice was also issued to the defendant no.1. Though the plaintiff has placed on record the response of the defendant no.1, it could not trace out the copy of the legal notice and the rejoinder and hence, the same have not been filed.

2.11. The defendant no.1 had also filed trademark application no.2321790



for the device mark, in Class 41 relating to 'Institute for Medical Sciences and Educational Services', which was opposed by the plaintiff by filing opposition dated 25th October, 2016. The said application stood abandoned by the order dated 21st March, 2018 of the Trade Marks Registry. In 2020, it came to the plaintiff's notice that the defendant no.1 continued to use the mark "MAYO" in relation to healthcare and educational services.

2.12. The plaintiff filed an application for pre-litigation mediation dated 20th July, 2020 before the Delhi High Court Mediation & Conciliation Centre (DHCMC). Notice of the application for pre-litigation mediation was sent by the DHCMC to the defendant no.1 requesting the defendant no.1 to provide its consent for participation in the mediation session scheduled on 6th August, 2020. Despite service, no response was received from the defendant no.1 and the mediation proceedings were closed as "non-starter".

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



2.13. In December, 2021, the plaintiff engaged an investigator, whose report revealed that the defendants were using the plaintiff's registered mark 'MAYO' on, *inter alia*, display boards, prescription slips, OPD slips, invoices as well as in their trade names and business concern. The plaintiff's registered mark 'MAYO' was also being used as a part of the domain name on the websites of the defendants, www.mayomedicalcentre.com and www.mayoschoolofnursing.com. The defendants were also advertising their services in the fields of healthcare and medical education on social media platforms and third-party websites under the mark/name 'MAYO'.

2.14. Accordingly, the present suit was filed seeking the relief of permanent injunction against the defendants restraining them from infringement of the registered trademarks of the plaintiff as well as passing off along with other ancillary reliefs.

CASE SET UP BY THE DEFENDANTS

3. The written statement was filed on behalf of the defendants on 22nd March, 2022. Admittedly, the same was filed beyond the period of thirty days and is yet to be taken on record.

4. In the reply filed on behalf of the defendants to the application filed by the plaintiff under Order XXXIX Rules 1 and 2 of the CPC, the case set up by the defendants is as under:

4.1. Defendant no.1, being a charitable trust with the defendants no.7 and 8 as its trustees, operates (a) Mayo Institute of Medical Sciences (defendant no.4), which was started in the year 2012 and imparts medical education; (b) Mayo School of Nursing (defendant no.5), which was established in the year 2003 and offers nursing courses; (c) Mayo Hospital (defendant no.6), which

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



was established in 2012 in Ambedkar Nagar, Uttar Pradesh and offers specialty and super-specialty services.

4.2. Defendant no.2 company was incorporated in the year 1995 and operates a famous hospital in Lucknow by the name of 'Mayo Medical Centre', which was started in the year 1999/2000. The said hospital offers many specialty and super-specialty services and is a premium medical institution.

4.3. The aforesaid defendant institutions mainly cater to patients from small towns of Eastern Uttar Pradesh, who have not even heard of the plaintiff or Mayo Clinic, USA. Therefore, there cannot be any question of confusion in the relevant section of the public.

4.4. The plaintiff cannot claim monopoly over the word 'MAYO' as it is not a coined term.

4.5. This Court does not have the territorial jurisdiction to entertain the present suit. Merely because defendants' websites are accessible in Delhi, would not clothe this Court with the territorial jurisdiction.

4.6. Plaintiff's marks are not entitled to protection as a '*well-known trademark*' in India as the said marks do not have any reputation or goodwill in India.

4.7. The reliefs sought in the present suit are barred by delay, laches and acquiescence as the plaintiff was aware of the use of the mark 'MAYO' by the defendants since the year 2011/2012 and yet did not initiate any action.

PROCEEDINGS IN THE SUIT

5. Summons in the suit were issued on 23rd December, 2022 and the parties were referred for mediation before the DHCMC. However, the meditation proceedings were not successful. Thereafter, submissions on

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



merits were heard on 21st February, 2023, 2nd March, 2023, 3rd March, 2023, 10th March, 2023 and 29th March, 2023, when judgment was reserved and liberty was given to both parties to file written note of arguments within ten days. Pursuant thereto, a written note of arguments has been filed by the plaintiff.

6. During the course of the submissions, an additional affidavit was filed on behalf of the defendants on 28th February, 2023 wherein it was stated that the defendants were ready and willing to add long prefix before the mark 'MAYO'.

SUBMISSIONS OF THE PLAINTIFF

7. Counsel for the plaintiff has made the following submissions:

7.1. The marks of the plaintiff 'MAYO' and 'MAYO CLINIC' were registered in 1992 in Class 16. Prior to 15th September, 2003, registrations in India were only in respect of Classes 1 to 34 and accordingly, the plaintiff acquired registrations in Class 16 in 1992 dealing with medical journals and printed matter.

7.2. Hospitals and education services are allied and cognate to medical journals, periodicals and printed matter. Therefore, there would be infringement if the defendants are using the registered mark of the plaintiff in respect of allied and cognate services such as healthcare and education. Reliance in this regard is placed on the judgments in ***Corn Products Refining Co. v. Shangrila Food Products Ltd.***, (1960) 1 SCR 968 and ***FDC Limited v. Docsuggest Healthcare Services Private Limited and Anr.***, 2017 SCC OnLine Del 6381.

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



7.3. The website of the defendant no.4 clearly states that the defendants gathered inspiration from Dr. William Mayo of 'MAYO CLINIC', U.S.A. and that their founder studied medicine and worked in hospitals in the U.S.A. Therefore, the adoption of the trademark 'MAYO' by the defendants is dishonest and an attempt to ride on the goodwill and reputation of the plaintiff.

7.4. When the adoption by the defendants is dishonest, delay cannot be a defence. Reliance in this regard is placed on the judgment in *Midas Hygiene Industries (P) Ltd. And Anr. v. Sudhir Bhatia And Ors.*, (2004) 3 SCC 90 and *Hindustan Pencils (P) Ltd. v. India Stationery Products Co. And Ors.*, 1989 SCC OnLine Del 34.

7.5. The plaintiff had put the defendants to notice by issuing a legal notice in the year 2014 and subsequently filed opposition proceedings to the trademark application filed by the defendants. Therefore, there cannot be any question of acquiescence.

7.6. It is an admitted position that the defendants started using the mark 'MAYO' for education only in the year 2011/12, whereas the plaintiff's registration under class 41 for educational services is from the year 2008.

7.7. The mark 'MAYO' has acquired reputation and goodwill in India and its usage by the defendants is likely to cause confusion in the public. Reliance is placed on the judgment of the Supreme Court in *Milmet Oftho Industries and Ors. v. Allergan Inc.*, (2004) 12 SCC 624, to submit that in the field of healthcare, the test to be applied would be as to who is the first user of the mark worldwide.

7.8. The websites of the defendants are interactive and allow customers to 'take an appointment' and 'book a health check-up', which can be done

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



from Delhi. Further, the defendants offer their services under the mark 'MAYO' to entities in Delhi as they are empanelled by entities such as Indira Gandhi Airport, Delhi and Aakashvani Delhi, as well as other entities based in Delhi. Therefore, the territorial jurisdiction of this Court is made out.

SUBMISSIONS OF THE DEFENDANTS

8. Senior counsel appearing on behalf of the defendants makes the following submissions:

8.1. Defendants have been using the mark 'MAYO' since the year 1995 in relation to healthcare facilities. The prior registrations of the mark 'MAYO' and 'MAYO CLINIC' in favour of the plaintiff in 1992 were only in Class 16. The subsequent registrations of the plaintiff in 2008 would not matter as the defendants already had made extensive use of the word 'MAYO' by then. Since the user of the defendants is in respect of services which are not covered by the registrations in favour of the plaintiff, no case for infringement is made out.

8.2. The trademark 'MAYO' cannot be said to be a '*well-known trademark*' in India in terms of Section 11(6) of Trade Marks Act, as it cannot be shown that relevant section of the public in India had knowledge of it.

8.3. In the present case, neither is there any likelihood of confusion, nor any likelihood of association of the defendants' mark with the mark of the plaintiff. Therefore, no grounds of infringement are made out under Section 29(2) of the Trade Marks Act, 1999.

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



8.4. To make out a case for passing off, the plaintiff has to prove goodwill and reputation in the year 1995 when the defendants started using the mark 'MAYO'. The plaintiff has failed to do so and therefore, no case of passing off is made out. Reliance is placed on the judgment of the Supreme Court in ***Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd.***, (2018) 2 SCC 1 (hereinafter referred to as "***Prius***").

8.5. Mere dishonesty cannot be a ground for grant of interim injunction. Reliance in this regard is placed on the judgment in ***Britannia Industries Ltd. v. ITC Ltd.***, 2021 SCC OnLine Del 1489. Reliance is also placed on the judgments of the Supreme Court in ***Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.***, (2004) 6 SCC 145 and ***Wockhardt Limited v. Torrent Pharmaceuticals Limited And Anr.***, (2018) 18 SCC 346.

8.6. The plaintiff, at the very latest, knew about the use of the mark 'MAYO' by the defendants in the year 2014 and the present suit has been filed in December, 2022. Therefore, the suit is barred by acquiescence, delay and laches.

8.7. Mere access of the defendants' website from Delhi cannot create territorial jurisdiction of this Court. Reliance is placed on the judgment in ***Banyan Tree Holding (P) Ltd. v. A. Murali Krishna Reddy***, 2009 SCC OnLine Del 3780. In the present case, the website of the defendants does not offer any payment gateway.

8.8. 'MAYO' is a common name in India, being the name of one of the Viceroys of India and on whose name the famous Mayo College was established at Ajmer, Rajasthan in India. Further, it is a common surname in the West. The dictionary meaning of the word 'MAYO' shows that it is the informal word used for Mayonnaise.

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



8.9. The judgment in *Milmet* (supra) relied by the plaintiff is only applicable in the case of medical products and would not apply for hospitals. In any event, the judgment in *Milmet* (supra) was considered by Supreme Court in *Prius* (supra).

8.10. Without prejudice to their right and contentions, the defendants are ready to add the prefix, 'Dr Kailash Narayan' to their existing name so as to distinguish the same from the plaintiff's trademark.

SUBMISSIONS IN REJOINDER OF THE PLAINTIFF

9. In rejoinder, the counsel for the plaintiff has made the following submissions:

9.1. The fact that the defendants are ready to add a prefix to all their existing names wherever the mark 'MAYO' occurs shows that the adoption of the mark 'MAYO' by the defendants in the first instance was indefensible. It also demonstrates that the balance of convenience is in favour of the plaintiff as the defendants can easily transition to a new mark.

9.2. The defence of prior user under Section 34 of the Trade Marks Act, 1999 would not be available for the proposed mark of the defendants. Similarly, for the purposes of passing off, the plaintiff's common law rights in the trademark 'MAYO' in India at present would have to be considered.

9.3. Reliance is placed on *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceuticals Laboratories*, (1965) 1 SCR 737 to contend that added matter is irrelevant in an action for infringement. The proposed added matter will enhance the likelihood of confusion as the proposed name



would convey an impression of a joint venture between the plaintiff and the defendants.

9.4. Reliance placed on behalf of the defendants on the judgment in *Prius* (supra) is completely misplaced as that was in the context of automotive spare parts. In the facts of the present case, the judgment in *Milmet* (supra) would be relevant as the said judgment dealt with healthcare and medicine. Though, *Prius* (supra) was a subsequent judgment, it did not overrule *Milmet* (supra).

9.5. The judgment in *Britannia Industries* (supra) relied upon by the defendants has been set aside in appeal by the Division Bench.

9.6. The use of the mark 'MAYO' in relation to healthcare services is completely arbitrary and distinctive. This is illustrated by the fact that even the defendants had applied for registration of the aforesaid mark in relation to healthcare services.

10. I have heard the rival contentions and examined the material on record.

ANALYSIS AND FINDINGS

REGISTRATION OF THE "MAYO" MARKS BY THE PLAINTIFF

11. At the outset, reference may be made to the registrations granted in favour of the plaintiff. As far back on 16th June, 1992, the plaintiff got registered the word marks 'MAYO' and 'MAYO CLINIC' as well as the device mark 'MAYO' under Class 16 dealing with '*periodicals, medical or other journals, printed matter*'. At that point of time, there were only Classes 1 to 34 available under the Trade Marks Act, 1999 in India. The

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



registrations under Class 41 dealing with educational services and Class 44 dealing with medical and health care services were not available and therefore, the plaintiff obtained registrations in Class 16, which was closest to the activities of the plaintiff.

12. In ***Corn Products*** (supra), the Supreme Court held that if a trade connection can be established between the two commodities having similar trademarks there is likelihood of confusion or deception in the market. In the said case the Supreme Court held that there was a trade connection between glucose manufactured by the appellant and biscuits manufactured by the respondent. Similarly, in ***FDC*** (supra) a Co-ordinate Bench of this Court held that ‘*pharmaceuticals preparations*’ and ‘*booking of appointment of doctors*’ are allied and cognate as they stem from same healthcare sector and hence, granted an interim injunction against the defendants as the defendants were using identical trademark in respect of allied and cognate services.

13. In ***Renaissance Hotel Holdings Inc. v. B. Vijaya Sai***, (2022) 5 SCC 1, the plaintiffs trademark “RENAISSANCE” was registered under Class 16 for ‘*printed matter, periodicals, books*’ and Class 42 for ‘*hotel, restaurant, catering*’ and the defendant was using the mark “SAI RENAISSANCE” in relation to hotels. The Supreme Court held that the adoption by the defendant of the aforesaid mark in relation to hotels would amount to infringement of the plaintiff’s registrations under Classes 16 and 42.

14. In the present case also, the plaintiff had registration under Class 16. Applying the ratio of the aforesaid judgments to the facts of the present case, in my view, ‘*hospitals*’ and ‘*education services providing courses of*

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



instruction in medicine and health care’ would be allied and cognate to *‘medical journals and periodicals’* as all of them relate to the healthcare and medical education sector. Since, the defendants are using identical marks in respect of services that are similar to the services of the plaintiff, it is likely to cause confusion in the public and is also likely show an association with the registered trademarks of the plaintiff. Therefore, a *prima facie* case of infringement in terms of Section 29(2)(a) of Trade Marks Act, 1999 is made out.

15. The plaintiff obtained registration of the mark ‘MAYO CLINIC’ under Class 41 on 26th August, 2008, whereas the defendants began to use ‘MAYO’ for education purposes only in the year 2011/2012 as admitted by them in paragraph 30 of their reply to I.A.22385/2022. Therefore, the defence of prior use under Section 34 of the Trade Marks Act, 1999 would not be available to the defendants in respect of its medical education services.

16. As regards the submission of the defendants that the word ‘MAYO’ is a name common to trade and therefore, not entitled to protection as a registered trademark, in my *prima facie* view, the use of the mark in relation to healthcare services is completely arbitrary and distinctive. The use of the mark ‘MAYO’ in ‘MAYO COLLEGE’ is not relevant as it has nothing to do with the field of healthcare or medical education. It may be relevant to point out that the defendants themselves had filed an application for registration of

the device mark,



(Mayo Institute of Medical

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



Sciences). Therefore, it does not lie in the mouth of the defendants that ‘MAYO’ is a name common to trade or has a dictionary meaning and is therefore, non-distinctive. Reference in this regard may be placed on the judgment of a Division Bench of this Court in ***Indian Hotels Company Ltd. and Another v. Jiva Institute of Vedic Science & Culture***, 2008 SCC OnLine Del 1758.

WHETHER THE ADOPTION OF THE MARK ”MAYO” BY THE DEFENDANTS WAS HONEST

17. At this stage, a reference may be made to the website of the defendant no.5. The relevant part of the website is set out below:

“It is an honor and privilege to write as a Director of Mayo Group of Institutions. With an inspiration from Dr. William Mayo of Mayo Clinic USA; Mayo School of Nursing was established in 2000 with a mission to serve the Society.”

18. A reference may also be made to the relevant extract from the website of the defendant no.4 with regard to the founder of the defendant institution, Dr. Kailash Narayan Singh, which has been reproduced as under:

“...Dr K. N. Singh started his education in 1960 as a first grader in Stanstead College, Canada. Thereafter, he moved to the US in 1967 where he graduated from Ridley High School, Folsom, Pennsylvania, in 1972. He was drafted for the US Army but, as his conscience could not accept the indiscriminate killing of people, he moved to India. He did his MBBS (1973 – 1978) from Magadh University, Bodh Gaya, Bihar, and subsequently returned to the US to study for his USMLE. He did his MD from Pennsylvania Medical School and started working there although he also worked at Saint Barnabas Medical Centre while in New York. Dr K. N. Singh ultimately shifted base to India in 1996.”

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



19. It is clear from a reading of the passages set out above, that the founder of the defendant institutions, Dr. K. N. Singh was not only aware of 'Mayo Clinic' in the USA but drew inspiration from Dr. William Mayo, the founder of 'Mayo Clinic', USA. It also emerges that Dr. K. N. Singh studied extensively in the USA. Further, he got his medical qualification from Pennsylvania Medical School and worked as a doctor in the USA before shifting to India in 1996. Defendants have not given any other reason for adopting the mark 'MAYO'. Therefore, in my *prima facie* view, the adoption of the name 'MAYO' by the defendants was clearly dishonest.

20. In *FDC* (supra) it has been clearly held where the defendants dishonestly adopt a mark that is identical to a prior registered trademark, whether well-known or not, the benefit of prior user in terms of Section 34 of the Trade Marks Act, 1999 would not be available to the defendants even if such user by the defendants was in respect of different goods and services.

DELAY AND LACHES

21. In *Midas* (supra), the Supreme Court has held that if the adoption of the mark is dishonest, delay alone cannot be the ground to deny injunction. The relevant extract from the aforesaid judgment is set out below:

“5. The law on the subject is well settled. In cases of infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was itself dishonest.”

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



22. A reference may also be made to the judgment of this Court in *Hindustan Pencils* (supra), the relevant portion of which is set out below:

“30. Even though there may be some doubt as to whether laches or acquiescence can deny the relief of a permanent injunction, judicial opinion has been consistent in holding that if the defendant acts fraudulently with the knowledge that he is violating the plaintiff's rights then in that case, even if there is an inordinate delay on the part of plaintiff in taking action against the defendant, the relief of injunction is not denied. The defence of laches or inordinate delay is a defence in equity. In equity both the parties must come to the Court with clear hands. An equitable defence can be put up by a party who has acted fairly and honestly. A person who is guilty of violating the law or infringing or usurping somebody else's right can't claim the continued misuse of the usurped right. It was observed by Romer, J. in the matter of an application brought by J.R. Parkinson and Coy. Ltd., 63 R.P.C. 171 at page 181 that “in my judgment, the circumstances which attend the adoption of a trade mark in the first instance are of considerable importance when one comes to consider whether the use of that mark has or has not been a honest user. If the user in its inception was tainted it would be difficult in most cases to purify it subsequently”. It was further noted by the learned Judge in that case that he could not regard the discreditable origin of the user as cleansed by the subsequent history. In other words, the equitable relief will be afforded only to that party who is not guilty of a fraud and whose conduct shows that there had been, on his part, an honest concurrent user of the mark in question. If a party, for no apparent or a valid reason, adopts, with or without modifications, a mark belonging to another, whether registered or not, it will be difficult for that party to avoid an order of injunction because the Court may rightly assume that such adoption of the mark by the party was not an honest one. The Court would be justified in concluding that the defendant, in such an action, wanted to cash in on the plaintiff's name and reputation and that was the sole, primary or the real motive of the defendant adopting such

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



a mark. Even if, in such a case, there may be an inordinate delay on the part of the plaintiff in bringing a suit for injunction, the application of the plaintiff for an interim injunction cannot be dismissed on the ground that the defendant has been using the mark for a number of years. Dealing with this aspect Harry D. Nims in his “The Law of Unfair Competition and Trade-Marks”, Fourth Edition, Volume Two at page 1282 noted as follows:

“Whether infringement is deliberate and wilful and the defendant acts fraudulently with knowledge that he is violating plaintiff's rights, essential elements of estoppel are lacking and in such a case the protection of plaintiff's rights by injunctive relief never is properly denied. “The doctrine of estoppel can only be invoked to promote fair dealings.””

23. On behalf of the defendants, reliance has been placed on the judgment of a Co-ordinate Bench of this Court in **Britannia Industries** (supra), wherein the Court had observed that a conscious attempt at copying by itself would not constitute infringement or passing off and that the matter has to be examined from the point of view of a customer of average intelligence and imperfect recollection. Unless such a consumer is likely to get confused, no case of infringement or passing off is made out.

24. As correctly pointed out by the counsel for the plaintiff, the aforesaid judgment in **Britannia Industries** (supra) was set aside by a Division Bench vide judgment dated 4th August, 2021 passed in FAO(OS)(COMM) 65/2021 holding that the said judgment shall not be treated as a precedent. Reliance placed by the defendants on the judgments in **Satyam Infoway** (supra) and **Wockhardt** (supra) is misplaced as the said judgments do not hold in any manner that dishonest adoption of a mark by a defendant is irrelevant for the purposes of grant of injunction.

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



25. The aforesaid observations in *Midas* (supra) and *Hindustan Pencils* (supra) are fully applicable in the present case as the defendants have dishonestly adopted the mark of the plaintiff, being fully aware of the prior existence and use of the same by the plaintiff. Therefore, even if there is delay on the part of the plaintiff in filing the present suit, that in itself cannot be a ground to deny the statutory right of the plaintiff. Reference in this regard may be made to the judgment of another Co-ordinate Bench of this Court in *Modi-Mundipharma Pvt. Ltd. v. Preet International Pvt. Ltd. &Anr.*, 2009 SCC OnLine Del 3922, wherein this Court held that in cases of infringement of trademark where a party has got exclusive and statutory rights by virtue of registration, the said right cannot be defeated on the ground of delay.

ACQUIESCENCE

26. In *Modi-Mundipharma* (supra) the Court further held that where the plaintiff has issued a legal notice to the defendant, it cannot be said that the plaintiff has acquiesced to the user of the defendant.

27. It is relevant to point out that in the present case the plaintiff had sent a legal notice to the defendants as fact back in 2014. Even though the plaintiff could not trace the legal notice, it has placed on record the reply of the defendants, which has not been denied by the defendants. The plaintiff had also filed opposition to the trademark application of the defendants in



respect of the device mark , which was later abandoned by the defendants. Therefore, the plaintiff had put the defendants

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



to notice as far back in 2014 against the use of the mark 'MAYO' by the defendants. Despite that the defendants continued to use the mark of the plaintiff in a dishonest manner. It is also pertinent to note that even before filing of the present suit the plaintiff initiated mediation proceedings. However, the defendants failed to participate. Hence, in light of the discussion above, it cannot be said that there was any acquiescence on the part of the plaintiff to the use of the mark 'MAYO' by the defendants.

ADDED MATTER

28. During the course of the submissions, an additional affidavit was filed on behalf of the defendants on 28th February, 2023 wherein without prejudice to their rights and contentions, the defendants had agreed to add a long prefix to all the existing names of the defendants wherever the mark 'MAYO' occurs, in the following manner:

S.N.	Existing Name	Proposed Name
1.	Mayo Medical Centre Pvt. Ltd.	Dr Kailash Narayan Mayo Medical Centre Pvt Ltd
2.	Mayo Pharmacy	Dr Kailash Narayan Mayo Pharmacy
3.	Mayo Institute of Medical Sciences	Dr Kailash Narayan Mayo Institute of Medical Sciences
4.	Mayo School of Nursing	Dr Kailash Narayan Mayo School of Nursing
5.	Mayo Hospital	Dr Kailash Narayan Mayo Hospital

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



29. Counsel for the plaintiff correctly points out that the filing of the aforesaid affidavit amounts to an admission by the defendants that the initial adoption of the mark 'MAYO' was wrongful. It further demonstrates that the defendants can easily adopt to a new name.

30. I am unable to fathom the insistence of the defendants to continue using the name 'MAYO', when admittedly the defendants do not have any rights in the aforesaid name and the adoption by the defendants in the first place was dishonest. If the defendants are willing to add the name of the founder, 'Dr. Kailash Narayan' as a prefix to their institutions, there is no justification for them to continue using 'MAYO' as a part of their name.

31. In this regard, counsel for the plaintiff has placed reliance on the judgment of the Supreme Court in **Kaviraj Pandit** (supra) in support of his submission that added matter to an infringing mark would be irrelevant for an action of infringement if the goods and services of the defendants are not distinguishable from that of the plaintiff. The relevant observations from **Kaviraj Pandit** (supra) are set out below:

“28. ...Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.”

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



32. Even with the addition of the proposed prefix, ‘Dr. Kailash Narayan’ to the name ‘Mayo’, it cannot be said that there would not be any likelihood of confusion, as the aforesaid proposed name ‘Dr. Kailash Narayan Mayo’ would convey a false impression of affiliation/association of the defendant with the plaintiff. Hence, adding a prefix to the essential feature or characteristic is unlikely to dispel confusion as the essential feature of the plaintiff’s mark ‘MAYO’ would remain a part of the defendants’ name. Therefore, in my *prima facie* view, infringement would continue.

PASSING OFF

33. At this stage, reference may be made to the judgment of the Supreme Court in *Milmet* (supra). Dealing with a case of passing off in respect of medicinal/pharmaceutical products, the Supreme Court made the following observations:

“8. We are in full agreement with what has been laid down by this Court. Whilst considering the possibility of likelihood of deception or confusion, in present times and particularly in the field of medicine, the courts must also keep in mind the fact that nowadays the field of medicine is of an international character. The court has to keep in mind the possibility that with the passage of time, some conflict may occur between the use of the mark by the applicant in India and the user by the overseas company. The court must ensure that public interest is in no way imperilled. Doctors, particularly, eminent doctors, medical practitioners and persons or companies connected with the medical field keep abreast of latest developments in medicine and preparations worldwide. Medical literature is freely available in this country. Doctors, medical practitioners and persons connected with the medical field regularly attend medical conferences, symposiums, lectures, etc. It must also be remembered that nowadays goods are widely advertised in newspapers, periodicals, magazines and other media which is available in the country. This results in a product acquiring a

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



worldwide reputation. Thus, if a mark in respect of a drug is associated with the respondents worldwide it would lead to an anomalous situation if an identical mark in respect of a similar drug is allowed to be sold in India. However, one note of caution must be expressed. Multinational corporations, which have no intention of coming to India or introducing their product in India should not be allowed to throttle an Indian company by not permitting it to sell a product in India, if the Indian company has genuinely adopted the mark and developed the product and is first in the market. Thus the ultimate test should be, who is first in the market.

9. In the present case, the marks are the same. They are in respect of pharmaceutical products. The mere fact that the respondents have not been using the mark in India would be irrelevant if they were first in the world market. The Division Bench had relied upon material which prima facie shows that the respondents' product was advertised before the appellants entered the field. On the basis of that material the Division Bench has concluded that the respondents were first to adopt the mark. If that be so, then no fault can be found with the conclusion drawn by the Division Bench."

34. Though the infringing products before the Supreme Court were pharmaceutical products, the Supreme Court went on to make observations with regard to the field of medicine as a whole. In the aforesaid passages, the Supreme Court has observed that the fields of health care and medicine are of an international character and therefore, the worldwide reputation of a mark has to be seen. Further, the Supreme Court laid down the test of 'first in the world market'. However, it was also held that where the defendant has genuinely adopted the mark and is the first in the market, the right of such party cannot be curtailed.

35. *Per contra*, counsel for the defendants has relied upon the judgment of the Supreme Court in *Prius* (supra) to contend that in order to establish a

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



case of passing off, the plaintiff has to establish goodwill and reputation in India and mere international reputation would not suffice. However, it is to be noted that the products involved in **Prius** (supra) were automotive spare parts, which are completely different from health care services or medicinal products. Even though **Milmet** (supra) has been referred to in **Prius** (supra), it has not been overruled or distinguished in **Prius** (supra).

36. Senior Counsel on behalf of the defendants has also placed reliance on the judgment in **Roland Corporation v. Sandeep Jain and Ors.**, 2021 SCC OnLine Del 3482, which has followed **Prius** (supra). In **Roland Corporation** (supra), the Court was dealing with musical instruments, public address systems and their parts and therefore, the Court observed that the findings of the Supreme Court in **Milmet** (supra) cannot be extrapolated to apply to the said products. The Court made note of the fact that in **Milmet** (supra), the Supreme Court was concerned with pharmaceutical and medicinal products.

37. The aforesaid observations of the Supreme Court in **Milmet** (supra) are fully applicable in the facts of the present case, as in the present case we are concerned with ‘hospitals’ and ‘educational services relating to medicine’. It cannot be denied that the name “MAYO” was first adopted and used by the plaintiff in respect of hospitals and medical educational institutes. Further, the mark “MAYO” has attained global reputation in the field of healthcare and medical education. On a *prima facie* view, the plaintiff’s trademarks have also acquired sufficient reputation and goodwill in India as is evidenced from 33 crore sessions by Indian users on the plaintiff’s website, www.mayoclinic.org and over 10 lakh sessions by Indian users on the plaintiff’s website, www.mayo.edu. Various news and health

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



reports of the plaintiff have been regularly published and cited in Indian newspapers, magazines and online publications. Clearly, the adoption by the defendants of an identical trademark in relation to identical services was an attempt to ride on the goodwill and reputation of the plaintiff. Therefore, a *prima facie* case of passing off has been made out by the plaintiff.

TERRITORIAL JURISDICTION

38. On the aspect of territorial jurisdiction, the defendants have placed reliance on the judgment in ***Banyan Tree*** (supra) to hold that mere accessibility of the defendant's website in Delhi would not enable the Courts in Delhi to exercise jurisdiction. It was further held that merely because the website is interactive, one would also not create jurisdiction. To establish jurisdiction it would have to be shown that the nature of activity on account of use of the website was to conclude commercial transactions with the website users. The relevant findings of the Division Bench in ***Banyan Tree*** (supra) are set out below:

"58. We summarise our findings on the questions referred for our opinion as under:

Question (i): *For the purposes of a passing off action, or an infringement action where the Plaintiff is not carrying on business within the jurisdiction of a court, in what circumstances can it be said that the hosting of a universally accessible website by the Defendants lends jurisdiction to such Court where such suit is filed ("the forum court")?*

Answer : *For the purposes of a passing off action, or an infringement action where the Plaintiff is not carrying on business within the jurisdiction of a court, and in the absence of a long-arm statute, in order to satisfy the forum court that it has jurisdiction to entertain the suit, the Plaintiff would have to show that the Defendant "purposefully availed" itself of the jurisdiction of the forum court. For this it would have to be prima facie shown that*

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



the nature of the activity indulged in by the Defendant by the use of the website was with an intention to conclude a commercial transaction with the website user and that the specific targeting of the forum state by the Defendant resulted in an injury or harm to the Plaintiff within the forum state.

Question (ii): *In a passing off or infringement action, where the defendant is sought to be sued on the basis that its website is accessible in the forum state, what is the extent of the burden on the Plaintiff to prima facie establish that the forum court has jurisdiction to entertain the suit?*

Answer : *For the purposes of Section 20 (c) CPC, in order to show that some part of the cause of action has arisen in the forum state by the use of the internet by the Defendant the Plaintiff will have to show prima facie that the said website, whether euphemistically termed as “passive plus” or “interactive” was specifically targeted at viewers in the forum state for commercial transactions. The Plaintiff would have to plead this and produce material to prima facie show that some commercial transaction using the website was entered into by the Defendant with a user of its website within the forum state resulting in an injury or harm to the Plaintiff within the forum state.”*

39. On behalf of the defendants, it is contended that the observations of the Division Bench are fully applicable in the present case as the plaintiff has failed to show that the website of the defendants was intended to conclude a commercial transaction between the defendants and the website user. It is submitted that the website of the defendant no.2 hospital does not even offer a payment gateway to make a commercial transaction. However, the counsel for the plaintiff placed reliance on the screen-shots of the website of the defendant no.2 (page no.674 of the plaintiff's documents), which allow consumers to 'take an appointment' and 'book a health check-up' from within the jurisdiction of this Court. The plaintiff has also drawn

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



attention of the Court to the services of the defendant being offered to entities, which are solely based within the jurisdiction of this Court, such as Indira Gandhi Airport, Delhi and Aakashvani, Delhi.

40. In my view, the issue of territorial jurisdiction is a mixed question of law and fact which would have to be finally determined on the basis of evidence produced by both the sides. Based on the averments made in the plaint and the material placed on record, at this *prima facie* stage, I am not inclined to reject the suit on the ground of territorial jurisdiction.

41. In view of the discussion above, a *prima facie* case of infringement as well as passing off is made out on behalf of the plaintiff. Balance of convenience is also in favour of plaintiff and against the defendants as the use of the identical mark 'MAYO' is likely to cause confusion in the minds of the consumer. The plaintiff shall continue to suffer irreparable injury to its goodwill and reputation if the defendants are permitted to offer their services under the infringing marks.

42. Accordingly, the defendants, their directors, officers, servants, agents, distributors, stockists, representatives and anyone acting for or on their behalf are restrained from using the plaintiff's trade mark/ name "MAYO" or any mark/name deceptively similar thereto, in any manner including the marks/names "MAYO INSTITUTE OF MEDICAL SCIENCES", "MAYO MEDICAL CENTRE", "MAYO MEDICAL CENTRE PRIVATE LIMITED", "MAYO HOSPITAL", "MAYO CLINIC", "MAYO SCHOOL OF NURSING", "MAYO PHARMACY", and "MAYO GASTRO-LIVER CLINIC", the domain names www.mayomedicalcentre.com and www.mayoschoolofnursing.com and listings on any social media platforms and third-party websites till the final adjudication of the suit.

Signature Not Verified
Digitally Signed By: AMIT
BANSAL
Signing Date: 29.05.2023 15:40:02



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

AMIT BANSAL, J

MAY 29, 2023

rt/sr



Signature Not Verified
Digitally Signed By: AMIT
BANSAL

Signing Date: 29.05.2023 15:40:02