

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

% **Date of decision: 17<sup>th</sup> April, 2020**  
**22<sup>nd</sup> November, 2019**

+ **CS(COMM) 74/2019**

**KELLER WILLIAMS REALTY, INC. .... Plaintiff**

Through: Mr. Ajay Sahni, Mr. Himanshu  
Deora, Mr. Sumit Kumar and Mr.  
Naqeeb Nawab, Advs.

Versus

**DINGLE BUILDCONS PVT. LTD. & ORS. .... Defendants**

Through: Mr. Akhil Sibal, Sr. Adv. with Mr.  
S.K. Bansal, Mr. Ajay Amitabh  
Suman, Mr. Shantanu Parasher and  
Ms. Shriya Misra, Advs. for D-1.

**CORAM:**

**HON'BLE MR. JUSTICE RAJIV SAHAI ENDLAW**

**IA No.2111/2019 (of plaintiff u/O XXXIX R-1&2 CPC)**

1. The plaintiff has instituted this suit for permanent injunction to restrain the three defendants namely (a) Dingle Buildcons Pvt. Ltd., (b) KW Homes Private Limited and (c) KW Security and Services Private Limited, from infringing the trade mark of the plaintiff and passing off their services as that of the plaintiff, and for ancillary reliefs.

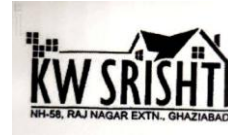
2. It is the case of the plaintiff, (i) that the plaintiff, incorporated and existing under the laws of the State of Texas, United States of America (USA), is an American International Real Estate Franchisor, founded as far back as in the year 1983 and today having approximately 900 franchisees with over 1,70,000 associates, worldwide; (ii) that the plaintiff is one of the

largest privately held global residential real estate brokerages; (iii) that the plaintiff conducts and operates its real estate affairs business on worldwide



basis, under the famous and distinctive trade marks 'KW', and/or 'KELLER WILLIAMS', through various agents/entities including wholly owned subsidiaries, agents, franchisees and associates; (iv) that the plaintiff is aggrieved from adoption by the defendants of identical and/or deceptively similar marks in respect of identical and/or similar services *inter alia* of insurance, financial affairs, monetary affairs, real estate affairs, advertising, business management, business administration, office functions etc.; (v) that the plaintiff honestly adopted the inherently distinctive trade mark 'KW' as an abbreviation for 'Keller Williams' and the trade mark 'KW' has become solely associated with the plaintiff; (vi) that the plaintiff has been using the said mark either in stand alone manner or in conjunction with its other marks; (vii) that the plaintiff has got the said mark 'KW' registered in a large number of countries; (viii) that in India, the plaintiff applied for registration of 'KW' and 'KELLER WILLIAMS' in Classes 35 & 36, on 2<sup>nd</sup> March, 2012 and the said registrations were granted; (ix) that the plaintiff also has common law rights in the said 'KW' marks; (x) that owing to extensive use and campaigns across the public worldwide, 'KW' marks have garnered immense goodwill and reputation across Indian public staying abroad as well as in India; the plaintiff has served various Non-Resident Indian (NRI) clients and has trained various agents resulting in spillover of reputation in India as well; the plaintiff has various real estate agents of Indian origin or NRI's, as Keller Williams Signature Agents; (xi)

that the plaintiff is also the owner of domain names [www.kw.com](http://www.kw.com) and [www.kwworldwide.com](http://www.kwworldwide.com), since the year 1995 and 2005 respectively; (xii) that the plaintiff also has a worldwide presence on social networking sites; (xiii) that the defendant No.1 applied for registration of its new logo in Class 08 and to which opposition was filed by the plaintiff and from reply of the defendant No.1 whereunto, the plaintiff learnt of uses by the defendants of the said mark; (xiv) however, the said use by the defendants is very recent and miniscule and the defendant No.1 has failed to file evidence to show use of the impugned marks since 2006, as claimed in its application; (xv) that prior thereto, in March, 2013 also, attention of the plaintiff was drawn to another application of the defendant No.1 in Class 36 for registration of 'KW', when the said application was cited as a prior pending application in the examination report dated 14<sup>th</sup> March, 2013 with respect to the plaintiff's application for registration of the mark 'KW' in Class 36; at about the same time, the defendant No.1 filed another application which was also cited in response to the plaintiff's application as a prior pending applications; (xvi) that the said applications had been filed by the defendant No.1 on 5<sup>th</sup> November, 2009, claiming use from 1<sup>st</sup> April, 2006; (xvii) that during research, the plaintiff learnt of the other registrations applied for by the defendants on 5<sup>th</sup> November, 2009 and obtained by the defendants, also claiming user since 1<sup>st</sup> April, 2006; however, since the plaintiff's application for registration was accepted, the plaintiff did not then pursue the matter, especially since no use by the defendants of the said mark was found; (xviii) that the plaintiff has thereafter filed opposition to the other applications filed by the defendants and filed Rectification Petitions to the registrations obtained by the defendants; (xix) that the defendant No.1 claims to have



current projects by the name 'KW SRISHTI', and 'KW



Delhi 6' in Ghaziabad; (xx) that the defendant No.2 KW Homes Private Limited has been incorporated in the year 2012 and the defendant No.2 and defendant No.3 claim to be part of KW Group; (xxi) that the plaintiff has now learnt of the defendants having launched 'KW Blue Pearl, a commercial complex at Karol Bagh, New Delhi; (xxii) that the conduct of the defendants, of filing multiple applications, shows a false claim of user; and, (xxiii) that adoption and use by the defendants of the impugned 'KW' marks which are identical and/or deceptively similar to the plaintiff's marks, not only infringe the plaintiff's mark but also convey the services of the defendants to be originating from the plaintiff.

3. The suit first came up before this Court on 11<sup>th</sup> February, 2019, when though the same was entertained but no *ex-parte* injunction sought granted.

4. The senior counsel for the defendants, when appeared on 25<sup>th</sup> February, 2019 pointed out that the plaintiff, in its response to the objection raised by the Registrar of Trade Marks with respect to the prior pending applications of the defendants, took a stand that there was no likelihood of confusion because the mark of the plaintiff was used for services relating to franchising, namely, offering technical assistance in the establishment and/or operation of real estate brokerages while the defendants were engaged in advertising, business management, business administration, office functions and due to difference in the nature of services and absence

of any commonality of trade channels, there was no possibility of confusion. Though the senior counsel for the plaintiff on that date stated that the plaintiff along with the documents filed with the plaint had filed the documents in this regard but admitted that there was no reference in the plaint to the explanation given by the plaintiff to the Registrar of Trade Marks. In this view of the matter, it was felt that the application for interim relief be heard after the pleadings are completed.

5. The three defendants have contested the suit by filing a joint written statement pleading that, (i) the plaintiff has based its rights on registered trade mark 'KW' in Class 35 dated 2<sup>nd</sup> March, 2012; (ii) the defendants are also registered proprietor of various KW formative trade marks in Classes 14, 16, 17, 20, 21, 28, 35, 36, 37, 41 & 42; (iii) the defendants have KW formative trade marks registered in Class 35 effective since 8<sup>th</sup> August, 2011; (iv) thus, under Section 28(3) of the Trade Marks Act, 1999, the suit, insofar as for reliefs on the basis of infringement, is not maintainable; (v) to be entitled to injunction on the claim of passing off, the plaintiff has to establish not only prior user but also continuous extensive user and tremendous goodwill and reputation and which the plaintiff has failed to make out; (vi) the defendants are using various other words with KW, making it quite distinctive from the impugned trade mark of the plaintiff; the added matter in the defendants' trade mark / trade name / label are sufficient to defeat any chance of confusion; (vii) the trade mark applications filed by the plaintiff in India, since 2<sup>nd</sup> March, 2012 are on proposed to be used basis, indicating that the plaintiff has no user at all in India; (viii) neither the plaintiff has used the KW trade mark in India nor has any intention to do so; (ix) the registration obtained by the plaintiff is invalid on account of non-



user thereof and is liable to be removed under Section 47 of the Trade Marks Act, 1999; (x) there is no possibility of deception or confusion; (xi) when the plaintiff applied for registration in Class 35, the Trade Mark Registry raised objection in view of the prior trade mark applications filed by the defendants; the plaintiff in reply to the said objection of the Trade Mark Registry stated that its “proposed mark is used for services relating to Franchising namely, offering technical assistance in the establishment and/or operation of real estate brokerages. It is therefore submitted that the services of the Applicant (plaintiff herein) are different from the services as applied for, by the above cited party (the defendants herein)”; (xii) in view of the said admission of the plaintiff, there is no question of any confusion or deception or passing off; (xiii) the defendants also have copyright registrations in their favour; (xiv) the plaintiff is guilty of suppression of this material fact from this Court; (xv) the plaintiff, in the plaint has also wrongly pleaded cause of action to have accrued in last week of November, 2018, with a view to obtain *ex-parte* injunction against the defendants; the plaintiff, since objection vide Examiner’s Report dated 30<sup>th</sup> January, 2013 raised by the Registry citing the defendants’ trade mark application dated 5<sup>th</sup> November, 2019, is aware of the defendants’ trade mark ‘KW’ at least since its reply dated 20<sup>th</sup> May, 2013; (xvi) the present suit is liable to be dismissed only on the ground of suppression and wrong pleading; (xvii) the plaintiff has acquiesced in the user of the defendants; (xviii) the defendants have adopted the trade mark ‘KW’ from surname of late Umadhar KesarWani; (xix) the defendants were not aware of the trade mark of the plaintiff at the time of adoption and use of the said trade mark since the year 2006; (xx) the trade mark applications filed by the defendants in the year 2009 were

abandoned owing to a communication gap between the defendants and their lawyers; (xxi) the defendants never abandoned their rights in the trade mark and again filed the trade mark applications in the year 2011 and 2016 respectively and most of them were registered; (xxii) the plaintiff has filed Cancellation Petitions against the registered trade marks of the defendants and which are pending; (xxiii) the defendants are the honest and prior adoptor and continuous and extensive user of the subject mark; (xxiv) KW is a brain child of Umadhar KesarWani who ventured in the real estate business, initially as a broker in the year 1998 and, in the year 2001 got incorporated Madhyam Constructions Co. Pvt. Ltd.; in the year 2003 incorporated Madhyam Housing Solutions Pvt. Ltd.; Madhyam Housing Private Limited and in the year 2006 Accurate Infra Private Developers Private Limited, Becon Constructions Private Limited and Dingle Buildcons Private Limited.; (xxv) In January, 2017, a mall by the name of 'KW Blue Pearl' was launched at a plot acquired by Umadhar KesarWani in Delhi in the name of Madhyam Housing Pvt. Ltd.; (xxvi) later on, Umadhar KesarWani launched various projects like 'KW Srishti' and 'KW Delhi 6' and also various other companies comprising of the word 'KW'; (xxvii) the word 'KW' remains the most essential indicator of the various projects and is used in relation to goods and services; (xxviii) in 2010, K World Developers Private Limited, KW Power Private Limited, KW Securities and Services Private Limited Ltd., KW Agro Pvt. Ltd. and K World Estate Private Limited, in the year 2012, KW Infrabuild Private Limited, KW Homes Private Limited and KW Buildcons Private Limited, in the year 2015, KW Dream Homes Consortium Private Limited, were incorporated; (xxix) the trade mark 'KW' has been used by the defendants as most

essential feature of their trading style; and, (xxx) the defendants have a large customer base over all their projects.

6. Though the plaintiff has filed replication to the written statement aforesaid but need to refer thereto is not felt.

7. The counsels were heard on the application for interim relief on 19<sup>th</sup> November, 2019 and have been heard further today.

8. The counsel for the plaintiff has argued, that (a) the plaintiff adopted the mark in the year 1994 and has been using the same for their business of rendering brokerage services in real estate; (b) the plaintiff has no business in India but targets Indians for projects; (c) the plaintiff has a website since the year 1995 and which appears on the Indian section of the Search Engine Google and has a large number of hits from India; (d) though the plaintiff, while applying for registration as trade mark in Class 35 in the year 2012, applied on proposed to be used basis but the affidavit accompanying the application for registration disclosed the user of the mark by the plaintiff; (e) the defendants have registration of 2016, claiming user since 2006; (f) the defendants are builders and have used KW in respect of three of their projects, of which two are under construction; (g) the explanation offered by the defendants, of having adopted the mark 'KW' from the surname KesarWani of their promoter is contrary to the representation made by the defendants to the Ministry of Corporate Affairs, on 8<sup>th</sup> May, 2010 when required to state the significance if any of the key or coined word in the proposed name of K World Developers Pvt. Ltd., to the effect that alphabet 'K' stood for 'Kesarwani' and 'W' for 'World'; (h) the explanation offered by the defendants in the written statement for adoption of KW is also



contrary to the brochure of the defendants, of the alphabets 'KW' having been taken from the mission of the defendants of "crafting the world"; (i)



attention is invited to the logo used by the defendants and it is stated that the plaintiff would have no objection to use by the defendants of 'KWK'; (j) that the defendants were not using the mark 'KW' earlier and have started using the same now only; and, (k) that the plaintiff is the prior adopter of the mark.

9. The counsel for the plaintiff, after hearing, has handed over compilation of following judgments under the following heads:

**Trans-border reputation and goodwill / Malafide adoption**

1. *Mac Personal Care Pvt. Ltd. Vs. Laverana Gmbh and Co. Kg.* 2016 (65) PTC 357 (DB)
2. *Staples Inc. Vs. Staples Paper Converters Pvt. Ltd.* 2015 (61) PTC 207 (Del)
3. *H&M Hennes & Mauritz AB Vs. HM Megabrands Pvt. Ltd.* 2018 (74) PTC 229 (Del)
4. *Cadbury UK Limited Vs. Lotte India Corporation Ltd.* 2014 (57) PTC 422
5. *Icrave LLC Vs. Icrave Designs Pvt. Ltd.* 2013 (53) PTC 323 (Del)

**Wrong date of use in the registration is a ground for cancellation of registration**

6. *Suresh Kumar Jain Vs. Union of India* 2012 (49) PTC 287 (Del)

**Infringement against registered proprietor is maintainable**

7. *Dabur India Ltd. Vs. Alka Ayurvedic Pvt. Ltd.* 2018 (73) PTC 517
8. *Raj Kumar Prasad Vs. Abbott Healthcare Pvt. Ltd.* 2014 (60) PTC 51 (Del)


**Classification of goods & services is merely for administrative purpose**

9. *FDC Limited Vs. Docsuggest Healthcare Services Pvt. Ltd.* 2017 (69) PTC 218 (Del)
10. *Allied Auto Accessories Ltd. Vs. Allied Motors Pvt. Ltd.* 2003 (27) PTC 115 (Bom)
11. *Insecticides (India) Limited Vs. Parijat Industries (India) Pvt. Ltd.* 2018 (75) PTC 238 (Del).

10. Per contra, the senior counsel for the defendants has contended (i) that the plaintiff, while applying on 2<sup>nd</sup> March, 2012 for registration of the word mark 'KW', against the column, "User Detail" stated "proposed to be used" and sought registration for the service of "franchising, namely offering technical assistance in the establishment and/or operation of real estate brokerages"; (ii) that since then no business has been initiated by the

plaintiff, the proposal for use has not come into effect; (iii) that the matter at this stage has to be considered from the aspect of one registered proprietor against other; (iv) that the registrations in favour of the defendant No.1 of



the device mark  dated 17<sup>th</sup> October, 2016 with user since 1<sup>st</sup> April, 2006 in Class 36, is in the services of insurance, financial affairs, monetary affairs, real estate affairs and dated 17<sup>th</sup> October, 2016 with user since 1<sup>st</sup> April, 2006 in Class 37 is for the services of building constructions, repair, installation services including builders and developers, land developments, property development, construction and civil interior, repairs and civil works; (v) therefore while the plaintiff's registration is limited in scope, the defendants' is wider; (vi) that once both, plaintiff and the defendants have registration per se, there is no invalidity; (vii) that the plaintiff does not have a case of infringement under Section 29(1)&(2) and Section 30(2)(e) of the Trade Marks Act; (viii) that under Section 124 of the Trade Marks Act, a suit for infringement is maintainable provided the registrations are challenged; (ix) however the Court has to *prima facie* go into the question of validity; (x) that the plaintiff has not used the mark in India till now; (xi) that the defendants are a prior user of the mark, notwithstanding the registration in favour of the plaintiff being earlier in point and time; (xii) attention is drawn to page 1581 of defendants documents, being an advertisement in newspaper published on 26<sup>th</sup> August, 2010, of KW Srishti, Ghaziabad as well as to other newspaper advertisements published at that time, of KW Srishti; (xiii) attention is similarly drawn to the advertisements in the newspaper of KW Srishti

published in the year 2012; (xiv) that therefore Section 34 of the Trade Marks Act saving the rights of the first user, applies in the present case; (xv) attention is invited to Section 47 of the Act providing for removal from registration of the mark, for non-user thereof; (xvi) that though the plaintiff has not shown trans-border reputation in India in 2010, but even if were to be held so, *prima facie*, the plaintiff has not shown any goodwill with respect to the same and which is *sine qua non* for an action for passing off; (xvii) that having a reputation is different from having a goodwill; (xviii) that goodwill can be culminated only from carrying on business and the plaintiff has no business in India; (xix) reliance is placed on (a) *Kerly's Law of Trade Marks and Trade Name*, 15<sup>th</sup> Edition (b) *Wadlow's Law of Passing Off: Unfair Competition by Misrepresentation* 4<sup>th</sup> Edition (c) *Starbucks (HK) Limited Vs. British Sky Broadcasting Group PLC* 2015 UKSC 31 (d) *Toyota Jidosha Kabushiki Kaisha Vs. Prius Auto Industries Limited* (2018) 2 SCC 1 (e) *Intex Technologies (India) Ltd. Vs. AZ Tech (India)* 2017 SCC OnLine Del 7392 (DB) (f) *Veerumal Praveen Kumar Vs. Needle Industries (India) Ltd.* (2001) 93 DLT 600 (g) *Neon Laboratories Limited Vs. Medical Technologies Ltd.* (2016) 2 SCC 672 (h) *L.D. Malhotra Industries Vs. Ropi Industries* 1975 SCC OnLine Del 172 (i) *S. Syed Mohideen Vs. P. Sulochana Bai* (2016) 2 SCC 683 (j) *Roca Sanitario S.A. Vs. Naresh Kumar Gupta* 2010 SCC OnLine Del 1135 (k) judgment dated 2<sup>nd</sup> May, 2012 in *Roca Sanitario S.A. Vs. Naresh Kuamr Gupta* (FAO(OS) 289/2010) and (l) judgment dated 22<sup>nd</sup> October, 2019 in *Roca Sanitario S.A. Vs. Naresh Kumar Gupta* (CS(COMM) No.172/2018), to contend that, a passing off action cannot be maintained in the absence of the mark having sufficient goodwill or reputation in India, no injunction has

been granted where the plaintiff is not using the mark in India and that, the principle of 'owner or prior user worldwide' of the mark is not relevant for passing off; and, (xx) that an action for passing off is not concerned with the rights in the mark but with possibility of confusion and deception.

11. The counsel for the plaintiff, in rejoinder has (a) drawn attention to the emails received by the plaintiff from Indians in India wanting to become franchisee / agent of the plaintiff and has contended that the same shows that people in India know of the plaintiff; (b) drawn attention to the summary of the hits from India on the website [www.kw.com](http://www.kw.com) of the plaintiff; (c) contended that the Division Bench of this Court in *Mac Personal Care Pvt. Ltd.* supra held (i) that anything done at a commercial level should suffice to achieve the *prima facie* satisfaction unless it can be called *de minimis* or trivial; (ii) that trans-border reputation essentially means that a plaintiff wishing to enforce its unregistered trade mark in India need not necessarily have a commercial use in the Indian market in order to maintain an action for passing off; international reputation and renown may suffice if the same spills over to India; (iii) that registrations in multiple jurisdictions create stronger presumption of reputation in favour of the plaintiff; and, (iv) that if user inception is dishonest, subsequent concurrent user will not purify dishonest intention; (d) stated that though the registration of the defendants is KW Srishti but the defendants are using KW Group; (e) drawn attention to *Suresh Kumar Jain* supra where a Division Bench, of which I was a part, dismissed an appeal against the order of Intellectual Property Appellate Board (IPAB) of cancellation of registration owing to lack of evidence to show that the mark of which registration with earlier user was obtained, was not in use; (f) argued that though the defendants, at the time of obtaining



registration claimed user since 2006, but have been unable to produce a single document of use since 2006; and, (g) argued that Section 28 of the Trade Marks Act is subject to other provisions of the Act.

12. I have considered the rival contentions, only for the purposes of the application for interim relief, and am of the opinion that the plaintiff is not entitled to any interim relief for the following reasons:

(A) Though, the Supreme Court in *Neon Laboratories Ltd.* supra and in *Milmet Oftho Industries Vs. Allergan Inc.* (2004) 12 SCC 624 applied the 'first in the market' test and held that the mere fact that the plaintiff had not been using the mark in India would be irrelevant if they were first in the world market, but the same, in *Milmet Oftho Industries* supra was held in the context of drugs and medicinal products and after holding the field of medicine to be of an international character and in *Neon Laboratories Ltd.*, again in the context of drugs and medicinal products, and after finding, the defendant, though to be a prior registrant having not used the mark till after registration and commencement of use of the mark by the plaintiff therein. Thereafter, in *Toyota Jidosha Kabushiki Kaisha* supra, after noticing the view in *Milmet Oftho Industries* supra, final decree in a suit for permanent injunction restraining passing off was declined, holding (a) that the plaintiff was first worldwide user of the mark but the defendants were the first user of the mark in India; (b) that the first use by the plaintiff outside India of the mark did not have much reportage in India; (c) that the territoriality doctrine (a trade mark being recognised as having a separate existence in each

sovereign country) holds the field; (d) that prior use of the trade mark in one jurisdiction would not *ipso facto* entitle its owner or user to claim exclusive rights to the said mark in another dominion; (e) that it is necessary for the plaintiff to establish that its reputation has spilled over the Indian market prior to the commencement of the use of the trade mark by defendants in India and which was not established in that case; (f) the test of possibility/likelihood of confusion would be valid in a *qua timet* action and not at the stage of final adjudication of the suit, at which stage the test would be one of actual confusion and in which respect no evidence had been led by the plaintiff; (g) that it is essential for the plaintiff in a passing off action, to prove his goodwill, misrepresentation and damages; the test is whether a foreign claimant has a goodwill in India; if there are customers for the product of the foreign claimant in India, then the foreign claimant stands in the same position as a domestic trader; and, (h) else what has to be seen is whether there has been a spill over of the reputation and goodwill of the mark used by the foreign claimant, into India; if goodwill or reputation in India is not established by the plaintiff, no other issue really would need any further examination to determine the extent of plaintiff's right in an action for passing off.

(B) Applying the aforesaid law, (i) the present case is not concerned with field of medicine, which was held to be of an international character; (ii) the plaintiff herein, till date has no business, customers, agents or franchisees in India and has not been instrumental in establishment and/or operation of any real estate brokerage in India; (iii) save for producing e-mails from some Indians

expressing interest in becoming agents of the plaintiff in India, the plaintiff has not been able to show spill over of its reputation and goodwill in India; (iv) the business of brokerage in real estate, in India is very different from the said business in USA; a distinct from USA, in India, no qualifications or permissions are required for setting up a business of real estate brokerage and the said business is not regulated; (v) though certain foreign brands as Coldwell Banker, RE/MAX, Jones Lang LaSalle, Cushman and Wakefield have entered the business of real estate brokerage in India but the plaintiff, in spite of obtaining registration of its trade mark in India nearly 8 years back in the year 2012 with intention to set up business in India, has till date not entered India; (vi) there are no rights in a trade mark without use/utilization thereof; (vii) mere ownership or even registration of a mark does not lead to any presumption of the mark having a reputation and goodwill, even in the territories where the mark is being used; the plaintiff, while applying for registration of the mark, did not claim any use, in India, of the mark, by spill over of reputation and goodwill from another territory to India; the plaintiff has not made out any case of any use or spill over of goodwill and reputation, since registration; and, (viii) the plaintiff, even at this stage, without establishing before this Court reputation and goodwill outside India and such reputation and goodwill having spilled over to India, *prima facie*, cannot restrain the defendants from passing off their services as that of the plaintiff or infringing its trade mark. The plaintiff has failed to make out a *prima facie* case.

(C) The business of real estate brokerage is very different and distinct from the business of development and construction of real estate. The plaintiff does not claim to be in business of or having reputation and goodwill in the construction and development of real estate. Rather the plaintiff does not even claim to be carrying on business of real estate brokerage. The plaintiff describes itself as a real estate franchisor. The plaintiff itself on 20<sup>th</sup> May, 2013 while responding to the objections in the examination report of the Trade Mark Registry to the application of the plaintiff for registration of the mark, took a stand that the business of advertising, business management, business administration and offices functions for which the defendant no.1 had applied for registration of the same mark prior to the plaintiff was very distinct and different from the business of franchising/offering technical assistance in the establishment and/or operation of real estate brokerage for which the plaintiff had applied for registration. The defendants even today are not pleaded to be in the business of franchising or providing technical assistance for real estate brokerage. The position thus remains the same as on 20<sup>th</sup> May, 2013. When the plaintiff then had not objection to defendants also using the 'KW' marks, there is no reason, why today. From the response dated 20<sup>th</sup> May, 2013 aforesaid of the plaintiff, it is clear that the plaintiff had no objection to use by the defendants or by others of the same mark as the plaintiff i.e. KW, as long as for businesses other than the business for which the plaintiff intended to use the said mark. The plaintiff cannot be entitled to restrain the defendants without establishing by evidence how today there is a possibility of confusion

and deception by the defendants, in the business of real estate development and construction, using the KW formative marks registered in favour of the plaintiff, as part of their device/logo mark. Without the plaintiff establishing the tort, of the defendants, by confusing the customers, passing off the properties developed by the defendants as those from the plaintiff, cannot be entitled to any relief on the ground of passing off.

(D) The marks of the defendants, to which objection is taken by the plaintiff, at least at this stage, cannot be said to be similar or deceptively similar to the marks of the plaintiff. While the plaintiff is using merely the alphabets 'KW' or together with Keller Williams, the defendants are using the same in conjunction with, either 'Blue Pearl' or 'Srishti' or 'Delhi-6' or in corporate names, in conjunction with 'Power Pvt. Ltd.' or 'Securities and Services Pvt. Ltd.' or 'Agro Pvt. Ltd.' or 'Infrabuild Pvt. Ltd.' etc. and which is sufficient to distinguish the two.

(E) When the plaintiff chose to use bare alphabets 'KW' as its mark, the possibility of another using the same alphabets, is inherent, as the plaintiff also conceded in its reply dated 20<sup>th</sup> May, 2013 supra. The plaintiff then, on learning of the same, did not feel the need to oppose the application of the defendants for registration or to restrain the defendants from, even if then not in use, commencing use thereof, specially since the plaintiff also, though then not using, proposed to use identical mark. The same is sufficient to deny interim relief of plaintiff.



(F) At least, at this stage it appears that the plaintiff is also guilty of delay and laches. The plaintiff, in the plaint admits knowledge in March, 2013 of the claim of the defendants of use of the mark since 2006 and the application filed by the defendants prior to the plaintiff for registration of the said mark. However the plaintiff, instead of opposing the said application of the defendants or immediately suing the defendants in 2013 itself to restrain the defendants from using the said mark, was content with obtaining registration in its own favour. The defendants have placed before this Court advertisement published in Delhi newspapers of their project KW Srishti in the years 2010 and 2012 i.e. prior to 2013 when the plaintiff admits to have become aware of the defendants. There is no explanation why the plaintiff, on becoming so aware in March 2013, did not enquire into the operations and extent of operations and which would have revealed the project KW Srishti of the defendants, even if the plaintiff was not aware of the same earlier. The plaintiff has thereby allowed the defendants to launch other projects with KW brand and thereby acquiesced in use of the mark at least from 2013 till 2019, by the defendants. The same also disentitles the plaintiff to any interim injunction.

(G) Since the plaintiff till date has no business in India, the question of the plaintiff suffering any irreparable loss and injury does not arise and the balance of convenience is also in favour of the defendants. The consumers of the projects of the defendants under the KW brand, who use the same as their address, would also be affected by any injunction granted and all of which cannot be reversed in the event of the plaintiff ultimately failing in the suit. On the contrary, if the

plaintiff ultimately succeeds in the suit, the defendants can always be enjoined then and the mere fact that the defendants during the pendency of the suit have continued use of the mark, would not be of any avail, as the expansion if any by the defendants of use of the impugned marks, would be at their own peril.

(H) Though the explanation of the defendants of the reason for the use of alphabets 'KW' does not inspire confidence and is also contrary to the stand of the defendants themselves, of KW standing for "Kesarwani World", however the same alone would not entitle the plaintiff to injunction without making out at least a *prima facie* case for infringement or passing off.

13. Resultantly, the application of the plaintiff being IA No.2111/2019 for interim relief is dismissed.

**CS(COMM) No.74/2019**

14. List for framing of issues if any and for consideration of other pending applications, on 27<sup>th</sup> July, 2020.

**APRIL 17, 2020**  
**NOVEMBER 22, 2019**  
'bs/ak'

**RAJIV SAHAI ENDLAW, J.**