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

% *Date of decision: 11th March, 2025*

+ CS(COMM) 717/2023

THE INDIAN HOTELS COMPANY LIMITEDPlaintiff

Through: Mr. Pravin Anand, Mr. Achuthan
Sreekumar, Mr. Rohil Bansal and
Mr. Swastik Bisarya, Advocates.

versus

GAURAV ROY BHATT & ANR.Defendants

Through: Mr. Abhyanand, Advocate.

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. The present suit has been filed seeking relief of permanent injunction restraining the defendants from infringement of trade marks and copyright and passing off of their services as those of the plaintiff along with other ancillary reliefs.

PROCEEDINGS IN THE SUIT

2. Summons in the suit was issued to the defendants on 10th October 2023. On the same date, an *ex-parte ad interim* injunction in favour of the plaintiff and against the defendants was granted and a Local Commissioner was appointed by this Court.

3. As recorded in the order of Joint Registrar dated 21st November 2023, the defendants were served on 1st November 2023.



4. The defendants entered appearance in the suit on 21st November 2023 and a written statement was filed on their behalf.
5. On 24th January 2025, counsel for the defendants, on instructions, submitted that a decree of permanent injunction may be passed against the defendants. Accordingly, the suit was decreed against the defendants in terms of prayer clause contained in paragraphs no.79(i) to 79(iv) and 79(vi) of the plaint.
6. Counsel for the plaintiff pressed for its prayer contained in paragraph no.79(vii) of the plaint for declaring its registered TAJ marks as well-known trade marks under the provisions of Section 2(1)(zg) of the Trade Marks Act, 1999 (hereinafter 'Act') read with Section 11(6) of the Act, to which the defendants did not object.
7. Accordingly, the plaintiff was directed to file an affidavit in support of its aforesaid prayer within two weeks.
8. In terms of the aforesaid order, an affidavit dated 20th February 2025 of the plaintiff's witness Mr. Naveen Batra was filed and on 25th February 2025, plaintiff's evidence was recorded in the suit.

DECLARATION OF THE TAJ MARKS AS WELL-KNOWN TRADE MARKS

9. The plaintiff, a company incorporated on 1st April 1902, is a part of the TATA Group of Companies, which is India's oldest, largest, most trusted and best-known business conglomerate.
10. The plaintiff and its subsidiaries bring together a group of brands and businesses in the hospitality industry and they include TAJ, SeleQtions, VIVANTA and GINGER.
11. The plaintiff opened its first hotel (The Taj Mahal Palace) in Mumbai



in 1903, which now enjoys a legacy of over 120 years across consumers and businesses. Thereafter, the plaintiff's business under the brand has expanded across cities, countries and continents. The plaintiff commenced use of the

mark  in the year 2016. The marks TAJ and  are hereinafter collectively referred to as the 'TAJ marks'.

12. The plaintiff is one of the pioneers in the hospitality industry not only in India but also across the globe. The plaintiff has a portfolio of about 350 hotels including 118 under development globally across 4 continents, 13 countries and in over 130 locations. The plaintiff is South Asia's largest hospitality company by market capitalization and is primarily listed on the Bombay Stock Exchange and National Stock Exchange.

13. Section 11(6) of the Act sets out the factors to be considered while determining whether a mark is a well-known trade mark. For ease of reference, the same is set out below:

"Section 11 –

...

(6) *The Registrar shall, while determining whether a trade mark is a well known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—*

- (i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;*
- (ii) the duration, extent and geographical area of any use of that trade mark;*
- (iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;*
- (iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent that they reflect the use or recognition of the trade mark;*
- (v) the record of successful enforcement of the rights in that trade mark,*



in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.”

14. Section 11(7) of the Act lists the factors that the Registrar of Trade Marks need to consider while deciding whether a mark is known or recognized in the relevant section of the public for the purposes of Section 11(6) of the Act. The same is also set out below:

“Section 11 –

...

(7) The Registrar shall, while determining as to whether a trade mark is known or recognised in a relevant section of the public for the purposes of sub-section (6), take into account—

- (i) the number of actual or potential consumers of the goods or services;*
- (ii) the number of persons involved in the channels of distribution of the goods or services;*
- (iii) the business circles dealing with the goods or services, to which that trade mark applies.”*

15. Counsel for the plaintiff has drawn the attention of this Court to the following data, from the documents filed in the present suit, to satisfy each of the factors enumerated in the aforesaid sub-sections as being relevant in deciding whether the TAJ marks are eligible to be declared as well-known trade marks:

I. Knowledge and recognition in relevant section of the public in India obtained because of promotion [Section 11(6)(i)]

- a. Documents showing that the plaintiff’s brand TAJ has been awarded as India’s strongest brand across all sectors and industries by Brand Finance in 2020, 2022 and 2023, which have been exhibited as **Exhibit PW-1/3**.
- b. Old photographs of dignitaries such as Mahatma Gandhi, Jawahar Lal Nehru, Rabindranath Tagore, etc. along with photographs of the plaintiff’s iconic Taj Mahal Palace, Mumbai, which have been



exhibited as **Exhibit PW-1/4**.

- c. Flyer showing the award and recognition garnered by the plaintiff's TAJ hotels over the years, which has been exhibited as **Exhibit PW-1/5**, along with a list of awards received by the plaintiff's TAJ hotels since 2008, which has been marked as **Mark-B**.
- d. Various new articles from the internet showing the fame and repute associated with the plaintiff's TAJ marks, which have been exhibited as **Exhibit PW-1/6**.
- e. Various reviews taken from MOUTHSHUT website showing the immense popularity of the plaintiff's TAJ marks, which have been exhibited as **Exhibit PW-1/7**.
- f. Articles from the internet showing the fame and repute associated with the plaintiff's TAJ marks, which have been exhibited as **Exhibit PW-1/8**.

II. The duration, extent and geographical area of any use of that trade mark [Section 11(6)(ii)]

- a. Various magazines from 2009 to 2015 showing the extensive use of the plaintiff's TAJ marks, which have been exhibited as **Exhibit PW-1/9**.
- b. The plaintiff's annual reports for the financial years 2002-03, 2014-15, 2015-16 and 2022-23 showing its turnover, which have been exhibited as **Exhibit PW-1/12** to **Exhibit PW-1/15**. The plaintiff has also given its turnover for the financial years 2018-19 to 2023-24, which are set out below:



Year	Turn-Over / Revenue (In Lakhs)
2023-24	336758
2022-23	284461
2021-22	152991
2020-21	90075
2019-20	220958
2018-19	226767

III. The duration, extent and geographical area of any promotion of the trade mark including advertising or publicity and presentation, at fairs, or exhibition of the goods or services to which the trade mark applies [Section 11(6)(iii)]

- a. Various documents evidencing the plaintiff's CSR and other philanthropic activities, which have been exhibited as **Exhibit PW-1/2**.
- b. Copies of sample advertisements and promotional material of the plaintiff dating back to 1903, which have been marked as **Mark-C**.
- c. A copy of the TAJ worldwide directory of March 2005, which have been marked as **Mark-D**.
- d. The plaintiff operates its websites, accessible at www.ihcltata.com and www.tajhotels.com, extracts of which have been exhibited as **Exhibit PW-1/10** and **Exhibit PW-1/11** respectively.
- e. The plaintiff also operates its social media profiles on Facebook, Instagram, X (Twitter), YouTube and LinkedIn under the TAJ marks, where it has huge following/ subscriber base. The details are provided below:

➤ Facebook – 542,000 likes and 548,000 followers as on 6th



February 2025;

- Instagram – 2,799 posts and 405,000 followers as on 6th February 2025;
- X (Twitter) – 66,900 followers as on 6th February 2025;
- YouTube – 42,800 subscribers and 134 videos as on 6th February 2025;
- LinkedIn – 768,000 followers as on 6th February 2025.

- f. The plaintiff's annual reports for the financial years 2002-03, 2014-15, 2015-16 and 2022-23 showing its expenditure towards advertising and promotional activities as well as towards CSR and philanthropic activities, which have been exhibited as **Exhibit PW-1/12** to **Exhibit PW-1/15**. The plaintiff has also given its advertising and promotional expenditure for the financial years 2018-19 to 2022-23, which are set out below:

Year	Advertisement / promotional expenditure (In Lakhs)
2022-23	3260
2021-22	2362
2020-21	1546
2019-20	5221
2018-19	5167

IV. The duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark [Section 11(6)(iv)]

- a. List of over 100 trade mark registrations for the TAJ marks and other TAJ-formative marks in favour of the plaintiff in India, which has



been exhibited as **Exhibit PW-1/16**.

- b. Legal proceeding certificates for the plaintiff's TAJ marks and other TAJ-formative marks registered in the name of the plaintiff, which have been exhibited as **Exhibit PW-1/17** to **Exhibit PW-1/26**.
- c. A list detailing the plaintiff's trade mark registrations for the TAJ marks in several other countries, which has been marked as **Mark-F**.

V. The record of successful enforcement of the rights in that trade mark in particular, the extent to which the trade mark has been recognized as a well-known trade mark

- a. The plaintiff has initiated proceedings and successfully enforced its rights in the mark TAJ against third-parties before this court, the details of which are provided as under:
 - Order dated 6th October, 2022 and judgment dated 30th August 2024 in CS(COMM) 683/2022, which have been marked as **Mark-G** and **Mark-H** respectively.
 - Order dated 26th July 2023 and final order dated 30th April 2024 in CS(COMM) 498/2023, which have been marked as **Mark-I** and **Mark-J** respectively.
 - Final order dated 17th December 2008 in CS(OS) 2304/2008, which has been marked as **Mark-K**.

16. I have heard the submissions made by counsel for the plaintiff and gone through the material placed on record.

17. On the strength of the averments made in the plaint as well as the nature and volume of the documents placed on record, I am of the view that the plaintiff has established well beyond doubt that the TAJ marks have



acquired the status of well-known trade marks within the meaning and scope of Section 2(1)(zg) of the Act.

18. It is pertinent to note that yet another mark of the plaintiff VIVANTA, which is also being used in relation to hotels, has already been declared by this Court as a well-known trade mark *vide* order dated 26th September 2022 in CS(COMM) 560/2022 titled ***The Indian Hotels Company Limited v. Grand Vivanta Vacations Private Limited***.

19. The long duration for which the TAJ marks have been in use by the plaintiff, wide geographical area of their use, their knowledge among the general public and their goodwill and reputation due to the extensive promotion, publicity and extensive revenue generated by the plaintiff, in India as well as other countries, the TAJ marks have achieved the status of well-known trade marks. Accordingly, the plaintiff fulfils all the criteria set out in Section 11(6) read with Section 11(7) of the Act for declaring the TAJ marks as well-known trade marks in respect of hotels and other related services in the hospitality industry.

20. Accordingly, in terms of prayer clause contained in paragraph no.79(vii) of the plaint, a decree of declaration is passed declaring the TAJ marks as well-known trade marks within the meaning of Section 2(1)(zg) of the Act.

21. Let the decree sheet be drawn up.

AMIT BANSAL, J

MARCH 11, 2025

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