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

+ CS(COMM) 300/2022

SINGH & SINGH LAW FIRM L.L.P & ANR. Plaintiffs
Through: Mr. Sandeep Sethi and Mr. Chander M.
Lall, Senior Advocates with Mr. Tanmaya Mehta
and Mr. Anurag Sahay, Advocates.

versus

SINGH & SINGH LAW, PLLC & ORS. Defendants
Through: None.

CORAM:
HON'BLE MS. JUSTICE JYOTI SINGH

ORDER

% **10.05.2022**

I.A. 7211/2022, 7212/2022 & 7311/2022 (Exemptions)

1. Subject to the Plaintiffs filing originals, legal proceeding certificates, clearer copies, scanned copies, certified translations of files and documents with proper margins, which they may seek to place reliance on, within four weeks from today, exemption is granted.

2. Applications are allowed and disposed of.

I.A. 7213/2022 (Seeking exemption from filing documents in separate volumes)

3. Allowed, subject to all just exceptions.

4. Application stands disposed of.

I.A. 7214/2022 (Section 12(A) of the Commercial Courts Act, 2015 seeking exemption from pre-institution mediation)

5. For the reasons stated in the application, the requirement of pre-institution mediation is dispensed with.

6. Application is allowed and disposed of.

I.A. 7210/2022 (seeking leave to file additional documents)

7. Present application has been preferred on behalf of the Plaintiffs seeking leave to file additional documents under Order 11 Rule 1(4) CPC.

8. Plaintiffs, if they wish to file additional documents at a later stage, shall do so strictly as per the provisions of the Commercial Courts Act, 2015.

9. Application is allowed and disposed of.

I.A. 7215/2022 (For seeking leave to place audio-visual data in pen-drive)

10. By way of the present application, Plaintiffs seek leave to file a pen-drive comprising of audio-visual data.

11. For the reasons stated in the application, the same is allowed.

12. Plaintiffs are permitted to file the aforementioned pen-drive within a period of two weeks from today.

I.A. 7216/2022 (exemption from service to Defendants)

13. Since there is an urgency in the matter and the matter is being heard today, Plaintiffs are exempted from serving advance notice on Defendants.

14. For the reasons stated in the application, the same is allowed and disposed of.

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15. Let plaint be registered as a suit.

16. Upon filing of process fee, issue summons to the Defendants, through all permissible modes, returnable on 26.07.2022. Summons shall state that the written statement shall be filed by the Defendants within 30 days from the receipt of summons. Along with the written statement, Defendants shall also file an affidavit of admission/denial of the documents of the Plaintiffs.

17. Replication be filed by the Plaintiffs within 15 days of the receipt of the written statement. Along with the replication, an affidavit of admission/denial of documents filed by the Defendants, shall be filed by the Plaintiffs.

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

19. List before the Joint Registrar on 26.07.2022.

20. List before the Court on 19.09.2022.

I.A. 7209/2022 (under Order 39 Rules 1 and 2 CPC, by Plaintiffs)

21. Present application has been preferred by the Plaintiffs under Order 39 Rules 1 and 2 read with Section 151 of the Code of Civil Procedure 1908 for grant of *ex parte ad-interim* injunction.

22. Issue notice to the Defendants, through all prescribed modes, returnable on 19.09.2022.

23. Present suit has been instituted by the Plaintiffs, aggrieved by the use of the name “Singh & Singh”, “Singh & Singh Law”, “Singh & Singh Law, PLLC” and other derivatives, by Defendants No. 1 to 3. It is averred by the Plaintiffs that the name “Singh & Singh” was coined in the year 1997 by its founders and the mark has been used continuously and uninterruptedly by the Plaintiffs, ever since. The Firm has, over the years, grown into a large and well-established firm in India, especially in the area of practice of Constitutional Law, Commercial Laws, Intellectual Property Laws, Media and Telecommunications Laws, Broadcasting, Arbitration, etc.

24. It is further averred that the trademark Singh & Singh, adopted in the year 1997, was registered as a trademark in 2005 as “Singh & Singh Advocates”. Registration was sought in 2009 with respect to another mark

“Singh & Singh”. The trademarks were subsequently assigned to its current Proprietor/Plaintiff No.2 with effect from April, 2014. In 2011, one of the Plaintiff No.1’s founder registered a Limited Liability Partnership by the name “Singh & Singh Law Firm LLP”. Details of valid and subsisting registrations in the name of Plaintiff No.2 are provided in the plaint.

25. It is averred that the firm Singh & Singh has acquired enormous acclaim and fame in India and in several foreign countries and the clientele hails from different parts of the world such as USA, Canada, Japan, etc. The firm Singh & Singh has a well-renowned cross border reputation spanning across the globe. Firm’s reputation is also established from the fact that it has earned a large number of accolades and awards as being a leading firm in various branches of law, as highlighted in the plaint.

26. It is stated in the plaint that Plaintiff No.1 regularly publishes articles, case law analysis, etc. in several international and national magazines relating to recent developments in different fields of law. Various international IP Organisations’ Chapters in India such as APAA, IPAA were founded or established by the founders of Plaintiff No.1. Plaintiff No.1 has handled some of the landmark cases in various fields of law, particularly under Intellectual Property Rights and relating to telecommunications, broadcasting and arbitration.

27. It is stated that the name Singh & Singh has been protected against misuse by this Court on two separate occasions in the past. In June, 2021 Plaintiffs instituted a suit for infringement and passing off against a Canadian Law Firm titled *Singh & Singh Law Firm LLP & Another vs. Singh + Singh & Ors., CS(COMM) 263/2021* and an interim injunction was granted by this Court against the Defendants, who had started their practice

using the name Singh+Singh in Canada. Court was of the *prima facie* view that use of identical marks/names would cause significant confusion among potential clients. Court rejected the objection of the Defendants that this Court did not have the jurisdiction to entertain the suit merely because the Defendants were practicing only in Canada. Finally, the suit was decreed in light of a settlement between the parties and the Defendants agreed to practice under a different mark/name. In another suit filed for infringement of trademark and passing off being CS(OS) 1173/2012, this Court by a detailed judgment held that the reputation of Singh & Singh was well-recognized and accordingly granted protection to the said mark. Court also recognized the fact that it was in the interest of clients also that the distinction between the legal service providers is maintained.

28. It is further averred that in March 2022, Plaintiffs were surprised to discover that the name Singh & Singh was used on the website www.singhandsinghlaw.com by Defendant No. 1. Upon further inquiry, it was noticed that Defendants No. 1 to 3 provide legal services with specialisation in Immigration Law, Commercial Law, Business Law, Corporate Law, Real Estate and Criminal Law, which is evident from the practice areas listed on the website of Defendant No.1. Defendants No.2 and 3 claim to be the owners/founders of Defendant No.1.

29. Defendants No.2 and 3, it is averred, are fluent in Punjabi, Hindi and Urdu languages and are used as soliciting tools for prospective clients, based out of India or of Indian origin. Defendant No.4 is a broadcasting company with studios/offices in USA and India and is regularly advertising the legal services offered by Defendants No.1 to 3 to people in both the countries, through its TV Channels, radio and online media such as YouTube, etc.

Defendant No.5 operates Punjabi television channel and is based in India. It telecasts and uploads paid advertisements and interviews of the Defendants in several countries through online media in order to promote the Defendants.

30. It is further stated that Defendants No.1 to 3 have been giving multiple interviews discussing legal matters and offer their legal services to the Indian community during the discussions, apart from offering free online consultations across the globe.

31. It is the contention of learned Senior Counsel for the Plaintiffs that Defendants No.1 and 3 have copied the name Singh & Singh and the corresponding logo for providing legal services. A bare look would indicate that the mark and the logo are identical. Defendants have used all capital letters like the Plaintiffs including the ‘&’ (ampersand) in their name. The font used in the logo as well as the blue colour makes the logo identical to that of the Plaintiffs and in fact Defendants No.1 to 3 are also using identical entity name, i.e. ‘Singh & Singh Law’. Defendants No.1 to 3 have thus made every effort possible to come as close to the Plaintiffs, to create confusion amongst the current and potential viewers/clients of Plaintiff No.1. Defendant No.1’s domain name is also identical/deceptively similar to the domain name of the Plaintiffs and is used for providing identical services. The mark Singh & Singh is extensively used by Defendants No.1 to 3 on social media platforms including Facebook, etc. which are clearly accessible in India and it is clear that Defendants No.1 to 3 are also advertising their services through Indian Channels such as ‘PTC Channel’ and ‘Jus Punjabi’ to target Indian clients, taking undue advantage of the name Singh & Singh. The impugned marks are being used in relation to legal services and there is

a clear violation of the statutory rights of the Plaintiffs. The acts of Defendants No.1 to 3 clearly amount to infringement under Section 29(1), 29(2)(c) and 29(5) of the Trade Marks Act, 1999.

32. It is also contended that the adoption of the impugned marks by Defendants No.1 to 3 is deliberate, *malafide* and with the sole intention to encash on the enormous and formidable reputation and goodwill that the mark Singh & Singh enjoys in India and abroad. The *malafide*, dishonest adoption and misrepresentation are writ large also from the fact that on the social media posts, Defendant No.1 is being referred to as ‘Singh & Singh Law Firm’ instead of ‘Singh & Singh Law, PLLC’. The confusion is also apparent from a search of ‘Singh & Singh Law’ on Facebook.

33. It is submitted that the manner in which the legal services are rendered across the globe, i.e. by word of mouth, reputation, name, quality of services, etc. coupled with the familiarity of foreign clients/law firms with Plaintiff No.1’s name, Singh & Singh, would clearly lead the public to believe that Defendant No. 1 is another branch or an associate office of Plaintiff No.1. The confusion would be of affiliation, sponsorship and/or some connection. This is not only leading to passing off, but is also resulting in enormous damage to the Plaintiffs in their goodwill and reputation. Learned Senior Counsel draws the attention of the Court to a comparative table in the plaint to demonstrate the identity/deceptive similarity between the Plaintiffs’ marks and the impugned marks, which is scanned and placed below for ready reference:

Plaintiffs marks	Defendants 1 - 3
SINGH & SINGH	SINGH&SINGH
SINGH & SINGH	SINGH & SINGH
SINGH & SINGH LAW FIRM LLP	
SINGH & SINGH LAW FIRM LLP	
SINGH & SINGH LAW FIRM LLP	

34. Mr. Sethi, learned Senior Counsel submits that Defendant Nos. 1 to 3 were given a phase out period of 60 days from the date of the legal notice, to cease all current and future use of “Singh & Singh” and any derivative, identical or similar mark/name/logo in connection with legal services and related services, business names, and source identifiers, etc., however,

Defendants No.1 to 3 have made their position clear that they shall not cease from using the mark/name Singh & Singh of the Plaintiffs.

35. Having heard learned Senior counsel for the Plaintiffs, this Court is of the *prima facie* opinion that the use of the marks “Singh & Singh”, “Singh & Singh Law”, “Singh & Singh Law PLLC”, “Singh & Singh Law, PLLC”, which are identical or deceptively similar to the trademarks of the Plaintiffs is likely to cause confusion to the clients, both in India and abroad, as Plaintiff No.1 is stated to have significant and extensive digital presence. The Court is also of the *prima facie* opinion that the adoption of the identical name by Defendants No.1 to 3 is not *bona fide* and is with a view to ride over the formidable goodwill and reputation of the Plaintiffs. Learned Senior Counsel is right in his contention that confusion amongst the clients can have undesirable ramifications for the Plaintiffs in case injunction is not granted.

36. This Court is thus of the view that Plaintiffs have made out a *prima facie* case for grant of *ex parte ad-interim* injunction. Balance of convenience lies in favour of the Plaintiffs and they are likely to suffer irreparable harm in case the injunction, as prayed for, is not granted.

37. Accordingly, Defendants No. 1, 2 and 3, their partners/promoters, associates, family members, employees and any one acting for and on their behalf are restrained from using the impugned marks including the mark(s)/name(s)/logo(s) “Singh & Singh”, “Singh & Singh Law”, “Singh & Singh Law PLLC”, “Singh & Singh Law, PLLC”, singhandsinghlaw.com, [singhandsinghlaw](https://www.instagram.com/singhandsinghlaw), [@singhandsinghlaw](https://twitter.com/singhandsinghlaw), Singh-Singh-Law, the Singh & Singh impugned logo(s), or any other trademark/trade name/service name/trading style or domain name, Twitter handle, LinkedIn profile,

Facebook profile, YouTube channel content, paid advertisements, social media promotions, Instagram handle, username, logo or device etc., which is either identical to or deceptively similar to the Plaintiffs' mark(s)/name(s)/logo(s) Singh & Singh, Singh & Singh Law Firm LLP, Singh & Singh.com, Singh and Singh, singhandsingh.com, Singh & Singh Advocates or any other derivatives thereof amounting to infringement of trade mark(s), passing off, or unfair competition, dilution etc. for rendering legal services, consultancy services related to law, or any other cognate/allied services, at any place or in any form including in print or electronic media, online platforms etc., till the next date of hearing.

38. Defendants No. 1 to 3 are directed not to transfer the domain name www.singhandsinghlaw.com or create third party interest in the same.

39. Defendants No.1 to 3 are directed to rescind, remove and delete all content, messages, media, images, posts, notifications, advertisements, videos, interviews, commercial hoardings, scrolls, displays etc. either on the internet or on any other physical or electronic platform/medium, containing the impugned mark(s)/name(s)/logo(s) relating to Defendants No. 1, 2 and 3, including the mark(s)/name(s)/logo(s) "Singh & Singh", "Singh & Singh Law", "Singh & Singh Law PLLC", "Singh & Singh Law, PLLC", singhandsinghlaw.com, singhandsinghlaw, @singhandsinghlaw, Singh-Singh-Law, the Singh & Singh impugned logo(s), or any other trademark/trade name/service name/trading style or domain name, Twitter handle, LinkedIn profile, Facebook profile, YouTube channel content, paid advertisements, social media promotions, Instagram handle, username, logo or device, etc., identical or deceptively similar to the Plaintiffs' marks, from social media (professional or personal networking) and all other internet

and/or physical platforms including but not limited to those of Defendants No. 1, 2 and 3, including but not limited to LinkedIn, Facebook, Twitter, YouTube, Instagram etc.

40. Defendants No. 6 and 7 are directed to suspend the domain name www.singhandsinghlaw.com, till the next date of hearing.

41. Defendants No. 8, 9 and 10 are directed to suspend/block/remove Defendants No. 1 to 3's account(s)/page(s) being operated under the impugned mark(s)/name(s)/logo(s) and to takedown/remove/delete all content relating to the same, from their social network platforms/websites, which are being used by Defendants No. 1 to 3 for infringing/passing off the Plaintiffs' mark(s).

42. Plaintiffs shall comply with the provisions of Order 39 Rule 3 CPC within ten days from today.

JYOTI SINGH, J

MAY 10, 2022/yg