



2023

Case Law Updates

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Preface:

Intellectual Property (IP) regime in India took the revolutionary road in the year 2022-23 with radical and profound changes seeing the light of the day. It will not be a hyperbole to throne this year as the flag bearer of cardinal transformations. Post the abolition of Intellectual Property Appellate Board, the IP litigation and court system in India witnessed an unprecedented development with the Delhi High Court paving the way with creation of the first Intellectual Property Division (IPD) in the country. Taking into consideration the best practices from around the world, detailed rules of functioning were laid down for the IPD which marked its tremendous presence with path breaking decisions delivered in the last one year on complex IP disputes. The advent of IPD has ushered in speedy disposal of cases, especially in cases of appeals from refusal orders issued by the Registrar of Trade Marks which may get decided within 1-2 hearings before the Court.

Following the path, the High Court of Judicature at Madras also created IPD in the Madras High Court which had its first sitting on 13th April 2023. Hearings of the transferred cases from IPAB as well as appeals/rectifications directly filed have also started in High Courts of Bombay, Gujarat, and Calcutta; and creation of special intellectual property division along with Rules is in pipeline. The hearings are being conducted in physical as well as via video-conference mode.

The present compilation brings to you the ratios of some of the interesting decisions rendered by the Courts.

Research & Publication Team

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TRADEMARKS





The Boeing Company and Ors. vs. Advance Technologies and Ors.

Forum: High Court of Delhi

Case No.: 254/2022

Order Dated: 18th April 2023



Issue: Is use of  by the defendant infringes  of the plaintiff, The Boeing Company in same set of services and business sector?

Order: The Court found that defendant adopted the plaintiff's trademark/logo in its entirety and have merely added a second swoosh graphic element that does not mitigate the deceptive and confusingly similar appearance of the impugned mark. The defendants are using the impugned trademark/logo in relation to aviation and defence sector, which are identical to that of the plaintiffs'. The defendants are infringing the trademark/logo of the plaintiffs, as also passing off their goods and services as that of the plaintiffs. Permanent injunction was granted against the defendants. Further, in view of obvious misconduct on behalf of the defendant, the suit was decreed in favour of the plaintiffs for INR 3 lakhs (USD 3670) towards damages to be paid by the defendants and INR 2 lakhs (USD 2450) as costs of the suit to be paid to the plaintiff.

KEI Industries Limited vs. Raman Kwatra and Another

Forum: High Court of Delhi

Case No: FAO (OS) (Comm) 172/2022 and C.M. Appl. 30278/2022

Order Dated: January 6, 2023

Issue: Can the ground of 'honest and concurrent use' be a defense in the case of trademark infringement? What is the effect of the principle of estoppel if contrary submissions are made while replying to an examination report issued by the Trade Marks Registry? Can the doctrine of '*ejusdem*

generis’ be applied in the specification of goods covered in a trademark application?

Judgement: The appellant had filed the present appeal against the order of the Single Judge whereby in the plaintiff-respondent’s suit against the appellant for trademark infringement *qua* use of their mark ‘KEI’, an application for interim injunction/restraint was allowed. The appellant was engaged in the business of manufacturing electrical fans and other appliances while the respondent was engaged in the business of manufacturing, marketing and sale of wires and cables. The respondent claimed that they had been using the trademark/trade name “KEI” since the year 1968 which was thereafter registered in 1988 in class 9 for wires and cables. Subsequently, the respondent registered the word mark KEI in its name for Classes 6, 16, 35, 37 and 42 which was followed by the respondent adopting the mark KEI (logo) in 2007. The respondent contended that based on its long and extensive usage, the mark KEI had acquired goodwill and reputation in the market. Further, it came to know during a due diligence check that the appellant had applied for registration of the mark KEI (logo) in classes 7, 11 and 35. The respondents further claimed prior use of the mark KEI, as the appellant had adopted the mark years later i.e., in 2008 in comparison to the respondent’s use since 1968.

In the appeal filed, the appellant had claimed that they began their business in the name of Kwaliti Electrico (India) as started by the appellant’s father under the trademark/label “KEI Kwaliti (Logo)” in relation to *electrical goods such as electric fans, room coolers, geysers, electric heating apparatus, electric rods, and the like*. It was also claimed that the appellant’s father on April 4, 1997, had applied for registration of the mark “KEI Kwaliti (Logo)” in classes 9 (*for Electrical iron, electric kettle, electric rods, testers and electrical accessories and appliances and parts thereof*) and 11 (*for electric fans, room coolers and geysers, electric heating apparatus and parts thereof*). Subsequently, on May 25, 2009, appellant’s father issued a Consent Letter in favour of the appellant towards change in the constitution of the firm Kwaliti Electrico (India) from partnership to a sole proprietorship of the appellant. The appellant claimed to continue operations of the former partnership firm using the trade name KEI. It was argued that appellant created the contested mark in 2008 and

had been using it ever since, and that the abbreviated "KEI" had been in use since 1966 through the appellant's father. In light of this, the appellant asserted user primacy over the respondent's use of the mark KEI. In response, the respondent disputed and denied that appellant inherited any such use to the trademarks "KEI Kwaliti (Device)" or "KEI" from the alleged date. The respondent contended that the appellant could not assert honest and concurrent user. The respondent additionally argued that appellant could not take refuge under Section 12 of the Trade Marks Act as to honest and concurrent use since that only applied to registration of marks and not to their use or as a defence to a case of trademark infringement. The Single Judge observing and relying on certain case precedents, also agreed with the respondent's said contention. It was observed by the Single Judge that the respondent owned a legitimate and active registration for the word mark "KEI" in relation to electric wires and cables, and the court reasoned that any use of the abbreviation KEI by a third party in relation to the same or comparable goods would constitute infringement. According to Section 29(2) of the Trade Marks Act, the appellant's use of the contested mark in relation to electric fans, electric water heaters, immersion water heaters, etc. constituted *prima facie* an infringement of the respondent's registered word mark and device mark containing "KEI". The Single Judge observed that the appellant's impugned trade mark KEI was being used in respect of *electrical goods*, while the respondent's word mark KEI and device mark were also registered in respect of *electrical goods and instruments* and hence there was a clear *prima facie case of infringement* by the appellants. Accordingly, the appellant was restrained from using the impugned mark KEI in relation to any *electrical goods or instruments, including electrical fans, room coolers, geysers, electric heating apparatus etc., or any allied or similar goods*.

In the appeal, the appellant contended that the Single Judge erred in not considering that the impugned trademark was registered in class 11. The appellant, to substantiate its claim, submitted its trademark registration for the impugned trademark, "KEI" in Class 11. Further, it was contended that the goods covered by the appellant's trademark were distinct from those covered by the respondent's trademarks. The appellant based its contention on the principle that the respondent was precluded from asserting any likelihood of confusion with respect to the impugned mark, as this assertion

was entirely contrary to its earlier assertions made before the Trademark Registry in replying to an examination report for its mark in class 11, stating: “*the services of the Applicant are different to that of the cited marks and therefore, there is not any likelihood of confusion....*” and wherein one such citation was the impugned mark of the appellant. The Court was satisfied with the appellant’s contention that a party who has obtained trademark registration based on specific representations and declarations made before the Trade Marks Registry would be ineligible for equitable redress if it claimed otherwise. The Court further observed that if a party has obtained the registration of their trademark by alleging that their mark is distinct from a cited mark, such party cannot obtain an interim injunction against the cited mark’s owner on the contention that the marks are deceptively similar. On the aspect of honest and concurrent use, the Court observed the same to be a special circumstance, and as a matter of applicability of principle, concluded that where special circumstances existed that warrant grant of registration of identical or similar trademarks in respect of similar goods and services, the person claiming entitlement to such registration may also be entitled to resist a restraining order for use of such trademark. The Court also went on to correctly apply the doctrine of ‘*ejusdem generis*’ to hold that “*other kinds of electrical and electronic instruments*” in the specification of the respondent’s registration were to be read in a restrictive sense by the items listed before the same, being “*electrical wires & cables (viz. power cable, control cable, instrumentation cable, rubber cable, winding, flexible & house wire), electrical switchgears, control panels, circuit breakers, transformers, amplifiers, electric and electromagnetic and mechanical relays, switches, fuses of all kinds..*” Hence, such electrical and electronic instruments would necessarily mean instruments for control, interruption, and manipulation of flow of electric energy. Such words could not be read expansively to cover all electrical appliances. Thus, the Court held that the respondent’s registered trademarks did not cover goods similar to those of the appellant for which it used its impugned mark. In view of the above, the impugned order was accordingly set aside. However, the matter was remanded back to the Single Judge to examine the respondent’s claim for infringement of its trademarks under Section 29(4) of the Trade Marks Act, 1999 which covers infringement where the goods are not similar.

PEPS Industries Pvt. Ltd. vs. Kurlon Ltd.

Forum: High Court of Delhi

Case No.: FAO(OS) (COMM) 94/2020 and CM No. 18937/2020

Judgment Dated: 7th October 2022

Issues:

- Whether the Defendant, who had itself applied for registration of the mark 'NO TURN' claiming it to be a distinctive mark is estopped from raising the issue of validity of the same mark on the ground of being descriptive?
- Whether the learned single Judge was correct in adjudicating an issue, which was not raised by the parties?
- Whether the descriptive mark can also be entitled for protection and whether the mark 'NO TURN' is descriptive?

Judgment: The Plaintiff, PEPS claims to have been using the mark 'NO TURN' in respect of mattresses, wall beds, etc. since 2008 and also got it registered in the year 2011 in respect of the same goods falling under Class 20. The Defendant, Kurlon claims to have been using the same mark 'NO TURN' in respect of mattresses since 2007. The Plaintiff upon becoming aware of the same mark being used in respect of the same goods, filed a suit seeking permanent injunction against the Defendant from the use of the said mark. The Defendant took the stand under Section 34 of the Trade Marks Act, 1999 stating that they have been using the mark 'NO TURN' from *prior* in time than the Plaintiff. However, the learned Single Judge dismissed the application ("impugned judgment") on the ground that the mark 'NO TURN' is a descriptive mark in relation to its use on mattresses. The Plaintiff contended that the impugned judgment was erroneous as the Defendant had not taken any defence or raised any issue that the mark 'NO TURN' was a descriptive mark for which no registration could have been granted. Thus, in the absence of any challenge to the validity of the registration of the mark on the ground of being descriptive, the learned Single Judge could not have denied an interim injunction on the ground of mark being descriptive. The Defendant, on the other hand, defended the impugned judgment and contended that even if it had not taken the objection

that the impugned mark was generic or descriptive, the Court can still examine the issue whether the plaintiff's mark is descriptive or not.

The Court noted that the stand of the Defendant for denial of injunction in favour of the Plaintiff since the beginning was its claim of a *prior user*. A specific stand was taken that the mark 'NO TURN' is a coined word and because of its long usage by the Defendant, it is being associated with it. The Defendant, in fact, also filed an application for registration of the mark 'NO TURN' in the year 2018.

The Court thus observed that, a party cannot approbate and reprobate at the same time. The Defendant having itself applied for the registration of the mark 'NO TURN' and contending the same to be a coined word, now cannot take an inconsistent plea and argue that the mark is descriptive. The Defendant only adopted the said argument for the first time before this Court, in order to support the impugned judgment. Thus, The Defendant who has not asserted the mark 'NO TURN' to be a descriptive mark, is now estopped from raising such a plea in order to oppose the injunction sought by the Plaintiff. The Court placed reliance on *Kiran Devi vs. Bihar State Sunni Wakf Board*, 2021 SCC OnLine SC 280; *Suzuki Parasrampuriah Suitings (P) Ltd. vs. Official Liquidator*, (2018) 10 SCC 707; *Telefonaktiebolaget LM Ericsson vs. Intex Technologies (India) Limited*, 2015 SCC OnLine Del 8229; *Mind Gym Ltd. vs. Mindgym Kids Library Pvt. Ltd.*, 2014 SCC OnLine Del 1240; *Automatic Electric Ltd. vs. R.K. Dhawan*, 1999 SCC OnLine DEL 27.

Regarding the second issue, the Court observed that once the mark has been registered, it is accepted as *prima facie* valid unless an objection is raised questioning the validity of the registration and is adjudicated by the Court. As mentioned above, no such objection was raised by the Defendant before the learned Single Judge. Further, no such objection was taken before the Registrar of trademarks either at the time of registration or, thereafter, by way of filing of an application for rectification. Therefore, the Court held that the learned Single Judge had erred in holding that the mark 'NO TURN' is descriptive as the validity of the same was never raised as an issue/objection by the Defendant. The Court placed reliance on *Bachhaj Nahar vs. Nilima Mandal*, (2008) 17 SCC 491; *Communication*

Components Antenna Inc. vs. Mobi Antenna Technologies (Shenzhen) Co. Ltd., 2021 SCC OnLine Del 5471; *Procter & Gamble Manufacturing (Tianjin) Co. Ltd. vs. Anchor Health & Beauty Care Pvt. Ltd.*, 2014 SCC OnLine Del 3374.

As for the last issue, the Court held that even a descriptive mark can be registered and exclusivity can be claimed if before the date of application for registration, it has acquired a distinctive character as a result of its use made or is a well-known trademark. In the present case, the mark ‘NO TURN’ has been used in relation to mattresses, which is *prima facie* not descriptive generally of the mattresses but can be called to be communicating a peculiar quality or feature of a mattress. However, the Court concluded to say that it refrains from expressing any conclusive view on the question.

Sanjha Chulha vs. Sanjha Chulha

Forum: High Court of Delhi

Case No.: FAO (COMM) 128/2022 and CAV 254/2022 and CM Nos. 37879/2020, 37880/2020

Order Dated: 2nd November 2022

Issues:

- Whether the Appellant had exclusive rights over the registered device marks to prohibit the Respondent from using the words ‘Sanjha Chulha’?
- Whether there is a case of prior use regarding the Appellant’s trademarks?

Order: The Appellant claimed to have been providing food and catering services since 1986-1987 from its different food outlets and restaurants in Delhi under the name ‘Sanjha Chulha’. The Appellant has the mark



registered under Class 29 through application filed in

1997 claiming use since 1991; mark



registered under Class

29 through application filed in 2001 claiming use since 1987; marks



and




registered under Class 16

through application filed in 2001 claiming use since 1986; and mark



registered under Class 30 through application filed in 2001 claiming use since 1986. The Appellant also gave details of its




erstwhile pending applications – objected device mark  and word mark **SANJHA CHULHA** filed in 2020 and 2021, respectively on a *proposed to be used* basis and claiming use since 1986, respectively under Class 43; word mark **Sanjha Chulha** accepted and advertised under Class 29 and objected under class 30, both filed in 2021 claiming use since 1986. Other pending application mentioned was for the mark **SANJHA CHULHA** (class 43) filed in 2011 claiming use since 1986 which stood opposed by the Respondent.

It is pertinent to note that the Appellant did not have any registration for the word mark **SANJHA CHULHA** in its favour as the pending applications were either objected or opposed at the time. The Appellant had also obtained copyright registration in the artistic work of its labels stating that the packaging/trade dress it uses has a unique design, structure, combination of various colours and features, get up, make up, etc. and is an ‘artistic work’ under Section 2(c) of the Copyright Act, 1957.

In February 2004, the respondent had applied for the registration of its



device mark “”, under Class 30, claiming use since April 1992 but the registration lapsed in February 2014. The Appellant filed a

rectification petition against this registration in August 2018. The Respondent also applied for registration of its device mark



in March 2016 under Class 30, claiming its use since April 1992 which stood opposed by the Appellant who also sent a cease-and-desist notice to the respondent in April 2021, along with a takedown notice/legal notice in April 2022. A suit was then filed by the Appellant seeking permanent injunction against the use of the mark by the Respondent claiming infringement and passing off against its trademarks.

The Appellant claimed that the Respondent's mark was phonetically and visually identical/similar to its marks and claimed to be the *prior user* of the marks enjoying *enormous reputation* and the status of a *well-known trademark*. Countering this, the Respondent claimed that the words 'Sanjha Chulha' were not coined by the Appellant and the literal meaning of the words is 'Community Clay Oven' in the Punjabi language. The Respondent contended that a television series by the said name had also been telecast on the channel Doordarshan in 1990-1991. Therefore, the Appellant's registered trademarks which are device marks do not confer exclusive rights to it for using the words 'Sanjha Chulha' which are now commonly associated with *dhabas* or local eateries. The Respondent also disputed the *prior use* of the Appellant and further claimed that due to distance between the outlets of the restaurants, they both enjoy a separate customer base.

The Commercial Court herein agreed with the contentions of the Respondent and held that the composite words 'Sanjha Chulha' were "*in vogue since immemorial*" and accepted the Respondent's argument that the words are a part of the common vocabulary. Holding the composite words to be descriptive in nature, the court rejected the Appellant's exclusive claim over the words. Further, the court held that the Appellant failed to produce any material to prove its prior usage of the trademark since 1986 as claimed while the Respondent successfully proved that it was using the trade name since 1996-1998. However, since the Appellant also registered the trade name during this period, it was concluded that both the parties were concurrent users of the trade name 'Sanjha Chulha'.

Further, the sales figures of both parties were taken into consideration, and the court found that the Respondent had sales 33 times higher than the Appellant in the year 2020-2021. The Commercial Court also accepted the contention of the Respondent that the distance between the two restaurants was unlikely to cause any confusion among customers. Therefore, the Commercial Court held that the device marks of the parties were neither identical nor similar to each other. It also found that the words 'Sanjha Chulha' were descriptive in nature, and the Appellant could not be granted exclusive rights to use such a mark.

The Hon'ble High Court of Delhi while deciding the instant appeal, agreed with the findings of the Commercial Court. The High Court further stated that the date on which the Appellant adopted the trademark could not be ascertained due to the inconsistent user claims and observed that the mere fact that the Appellant has registered the marks in its name and claimed their usage from a prior date is not sufficient evidence to establish *prior use*.

Thus, while dismissing the appeal of the Appellant, the Hon'ble High Court of Delhi observed that it is not always the case that the use of a prominent part of the registered trademark by another user, either on a standalone basis or as a part of the composite mark causes deceptive similarity between the two marks.

S.N.R. Dhall Mill vs. Kaleesuwari Refinery Private Limited

Forum: High Court of Madras

Case No.: I.A. 8147/2020 in CS(COMM) 379/2020

Order Dated: 26th April 2021

Issue: Whether the use of the trademark "Gold Winner" by the Defendant on products, such as edible oils is infringement of the registered trademark GOLD WINNER for manufacturing and preparations of different varieties of Pulses and Flour by the Plaintiff and passing off its products?

Order: The Plaintiff had filed an opposition against the Defendant's trademark application, which was rejected by the Trademark Registry.

Subsequently, the Plaintiff filed a rectification petition before the Intellectual Property Appellate Board (IPAB) seeking cancellation of the Defendant's trademark "Gold Winner" under registration number 1232740 in class 30 for the goods, edible oils.

The Defendant was accused of using the trademark "Gold Winner" without permission of the Plaintiff, asserted that they had been using the mark "Gold Winner" for their products, such as edible oils, since the year 1999. The Defendant, however, has also been using the identical mark since 1993 for their line of edible oil goods.

According to the IPAB, the Plaintiff had not shown that they were the original owner of the "Gold Winner" trademark. The evidence provided by the Plaintiff was not sufficient to show that they had been using the mark continuously and extensively before the Defendant started using it. The IPAB also noted that the Plaintiff had not filed any infringement suit against the Defendant in the past, which would have strengthened their claim of prior use.

The IPAB further observed that the Defendant had been using the mark "Gold Winner" for a considerable period of time and had built up substantial goodwill in relation to their products.

These conclusions led the IPAB to reject the Plaintiff's rectification petition and grant the Defendant permission to keep using the name "Gold Winner" as a trademark for their goods.

Mondelez India Foods (P) Ltd. and Another vs. Neeraj Food Products

Forum: High Court of Delhi

Case No.: CS (COMM) 393/2018

Order Dated: 26th July 2022

Issue: Whether the use of the impugned mark 'JAMES BOND'/'JAMEY BOND' and the product packaging bearing the said mark, is infringing

Plaintiff's registered trademark 'CADBURY GEMS'/'GEMS', its copyright registrations featuring the character 'GEMS BOND'.

Order: The Plaintiffs in this suit are the parent company of the well-known brand Cadbury India Ltd and Cadbury Schweppes Overseas Ltd, the suit is filed to seek permanent and mandatory injunction and damages for infringement of trademarks and copyright against a Delhi-based sole proprietorship set up during the early 2000s called Neeraj Food Products, who were accused by Cadbury of infringing and selling products similar to 'Cadbury Gems'.

The Plaintiff holds copyright registration in its former name being M/S. Hindustan Cocoa Products Ltd. for the artistic work of the character known as 'Gems Bond' which character has been used by the Plaintiffs for promotion of their GEMS branded product. Further they had the trademark registration for the word GEMS, CADBURY GEMS, CADBURY'S MILK CHOCOLATE GEMS in class 30.

The Plaintiff had filed this suit in 2005 against the Defendant's James Bond chocolate which was directly infringing in terms of layout, design and colour scheme. The product launched by the Defendant was confusingly similar to Cadbury's famous 'Cadbury Gems' product. There was an infringement of the registered trademark of Cadbury Gems. The petition pleaded with the Court to restrict the sale of "James Bond".

In the judgement, the Court said that the products in question are chocolates which may be consumed by the young and old alike. The 'GEMS' product is also usually consumed by small children, both in urban and rural areas. The test in such a matter is not that of absolute confusion. Even the likelihood of confusion is sufficient.

The Court further went ahead and stated that the Defendant's infringing products are nothing but a knock off, of the Plaintiff's 'CADBURY GEMS'. Since the chocolate is sold INR 1 (0.01 USD) and INR 5 (0.06 USD) everywhere, including shopping malls, local vendors, roadside shacks, there is high chance of confusion in the minds of the consumers which include majorly children. The Court also noted that the Plaintiff having already

received registration for artistic work for the character ‘GEMS BOND’ whereas the Defendant’s packaging uses the mark JAMES BOND/JAMEY BOND with the same purple/blue base and colourful button chocolates.

At the final hearing Court said that “*the Defendant did not deny having sold chocolates under the infringing packaging and the Defendant did not take any substantial defence in its written statement except for the fact that their products are different from the Plaintiff’s product. The search report of the Defendant placed on record shows that the Defendant had adopted a packaging with the same illustrations and blue/purple colour as that of the Plaintiffs’ product. Therefore, the impugned packaging of the Defendant’s product sold under the mark ‘JAMES BOND’/‘JAMEY BOND’ has clearly infringed the Plaintiffs’ rights in the mark ‘CADBURY GEMS’, as also, the copyright in respect of the products sold under the said mark.*”

The Court slapped a fine of INR 15.8 lakhs (USD 19,325.75) on Neeraj Food Products for the violation of Copyright and Trademark Acts and Rules and directed the Defendant to compensate the Plaintiff in terms of litigation fees.

Under Armour, Inc. vs. Aditya Birla Fashion & Retail Ltd.

Forum: High Court of Delhi

Case No.: CS(COMM) 41/2023, I.A. 1349/2023 & I.A. 4142/2023

Order Date: 20th April 2023

Issue 1: Whether the plaintiff’s marks seen as whole marks, are, or are not, infringed by the defendants?

Issue 2: Whether “ARMOUR” part of the plaintiff’s marks descriptive?

Order: The plaintiff UNDER ARMOUR, Inc (UA India) is a US-based company, The plaintiff officially entered the Indian market in 2017, by selling its goods through Amazon. In 2018, the plaintiff incorporated its Indian subsidiary Under Armour India Trading Pvt. Ltd. Mark UNDER ARMOUR stands registered in the plaintiff’s favour in Classes 18, 25 and 28 since, February 2009 and the mark UA stands registered in the plaintiff’s favour in the same classes since January 2011.

The plaintiff argued that their reputation was established by their website appearing as one of the first results on Google search for the word “ARMOURI”. However, the court ruled that this was insufficient evidence as appearing on Google search results does not establish a brand's reputation or goodwill in the market.

The plaintiff operates websites with the "ARMOUR" mark and claims that the defendant's use of the same word is confusingly similar. The defendant argues that the plaintiff should consider their entire trademark, not just the "ARMOUR" portion. The court agrees and considers the totality of the composite marks to determine if there is infringement or passing off. The court also addresses the "dominant part" argument, concluding that the probability of confusion must be assessed by taking into account the totality of the composite marks as an indivisible whole rather than by cutting or segmenting.

The court considered the issue whether the defendant's use of "STREET ARMOUR" and "ARMOUR" in connection with athletic equipment infringed on the plaintiff's registered mark "UNDER ARMOUR". The court found that there was infringement under Section 29(2)(b) of the Trade Marks Act since there was a likelihood of confusion or association between the marks. The court considered the marks as a whole and did not regard "ARMOUR" as the dominant component of the plaintiff's mark. Other issue considered by the court Is the “ARMOUR” part of the plaintiff's marks descriptive? the defendant argued that the "ARMOUR" part of the plaintiff's mark was descriptive and could not be protected. However, the court rejected this argument and held that "ARMOUR" was not descriptive of the goods of either party. The court noted that sportswear is not armorial in nature and even if the clothing was protective, the mark could only be suggestive, which is registerable. The court also observed that the plaintiff's use of the mark was not protective, and "ARMOUR" was arbitrary when used for such apparel.

The court dismissed the defendant's argument that "ARMOUR" was a common word in the market and that it had applied for registration of the "STREET ARMOUR" mark. The court found the defendant's marks

deceptively similar to the plaintiff's marks, and whether "ARMOUR" was common to the trade was insignificant. The defendant also claimed the plaintiff suppressed material facts by not disclosing their response to the FER during trademark registration, but the court disagreed and stated that the plaintiff's response to the FER is only relevant in litigation where the defendant's mark is cited as similar. The plaintiff did not suppress any material facts that would disentitle them to relief.

The court issued a ruling that restrains the defendant from using or dealing in trademarks and logos that resemble or can be misleadingly associated with the plaintiff's registered marks, including "UNDER ARMOUR", "UNDR ARMR", and "UA" word marks or device marks. The defendant is prohibited from using the following marks: "STREET ARMOR/ ||", STRT ARMR, ARMR, ARMOR, SA, ARMR DEPT, SA DEPT, STREET ARMOR CO, and STRT ARMR LAB. This restriction applies to apparel and other goods or services that are similar or related to the plaintiff's products. The court's decision was based on the facts and legal issues presented in the case.

Anubhav Jain vs. Satish Kumar Jain

Forum: High Court of Delhi

Case No.: CO (COMM. IPD-TM) 55/2021

Judgment Dated: 8th February 2023

Issues:

- Whether the Respondent's mark was rightfully registered as a trademark and deserves to remain on the Trade Marks Register?
- Whether the Examiner is required to state the reasons for accepting a trademark for registration as per the provisions of the Trade Marks Act and Rules?

Order: The Petitioner challenged the registration of the Respondent's



device mark (‘‘impugned mark’’) under Section 57(1) and (2) read with Section 9(1)(a) of the Trade Marks Act, 1999 submitting that

the mark was devoid of distinctive character. Further, the Petitioner pointed out certain technical deficiencies in the prosecution and subsequent acceptance of the impugned mark. Firstly, it was alleged that the impugned mark was wrongfully accepted with a false user claim of June 14, 1996 as the same was not corroborated with any substantive evidence; secondly, it was alleged that the Respondent did not file any reply to the examination report, wherein multiple prior marks were cited under Section 11 objection on relative grounds. The Petitioner alleges that despite such procedural deficiencies/inaccuracies, the mark was proceeded for registration.

The Court firstly did not accept the submission that the mark is not distinctive and held that the impugned mark being a device mark, is *clearly distinctive*. Even as a word mark, the Court stated that ‘JAIN SHIKANJI’ cannot be inherently said to lack distinctiveness. Coming to the procedural deficiencies, the Court favoured the Petitioner’s contentions that the impugned mark was accepted without stating any reasons (especially with respect to the user claim) and opined that, a reading of Rule 33 of the Trade Marks Rules, 2017 makes it clear that the exercise of consideration of the objections in the Examination Report, and the response of the applicant thereto, is quasi-judicial in nature, involving notice to show cause, a reply thereto, and personal hearing if sought. An Examination Report must set out the reasons for prayer for registration of the mark being proposed to be refused. The applicant has a right to file a response. The applicant is also given a right to seek a personal hearing. After a response is filed by the applicant and hearing, if sought, is granted, sub-rule (8) of Rule 36 requires the Registrar to “pass an appropriate order”. The Court went ahead to say that *“An “order” jurisprudentially, especially when it follows upon a quasi-judicial proceeding, has necessarily to be informed by reasons. Else, it is not an order in the eyes of law. Reasons constitute, as it were, the raison d’etre of the order... An order which is open to challenge before a higher authority has necessarily to be reasoned as, else, neither would the aggrieved party, who seeks to challenge the order, know why the order was passed, nor would the authority before whom the challenge is laid be so aware. Section 57 permits a challenge to a mark which already stands registered. The person seeking to so challenge the grant of registration is entitled to know the reasons for the dismissal, by the Registrar, of the objections in the Examination Report. Else, the authority before whom the*

challenge has been laid would have no option but to presume that there has been no application of mind to the said objections.”

In conclusion, the Court directed the learned Registrar to re-examine the mark on two counts namely, (i) the objections predicted on Section 11 of the Trade Marks Act, as contained in the Examination Report, and (ii) the date of user of the impugned mark by the respondent.

Hermès International & Anr. vs. Crimzon Fashion Accessories Private Limited


Forum: High Court of Delhi


Case No.: CS (COMM) 919/2022 & I.A.22377/2022

Judgment Dated: 8th February 2023


Issue: Whether the Plaintiff's H “” mark can be declared to be a well-known mark?

Judgement: The Plaintiff filed the present suit, restraining the Defendant from using an identical, deceptively or confusingly similar mark to their

registered H “” trademark. On 23rd December 2022, the Hon’ble Court decreed in favour of the Plaintiff and against the Defendant. On 9th February 2023, the Plaintiff with regard to its prayer seeking declaration of


its mark “” as well-known, made submissions with respect to each of the five factors enumerated in Section 11(6) of the Act for determining a trade mark as a well-known trade mark. For factor 1, the Plaintiff submitted that it has stores in Mumbai and Delhi wherein its products bearing the stylized 'H' logo are displayed, mentioned retail distributions and revenue generated in its activity report for the year 2021 and it also submitted that several articles and magazines have reviewed and recognised the Plaintiff's


ORAN sandals bearing the mark “”. For factor 2, it submitted that

the Plaintiff's Oran sandals bearing the mark “” were conceptualised in the year 1997 and have been circulated in the market ever since. For factor 3, it asserted that Plaintiff has engaged in extensive promotional activities since 1997. For factor 4, the Plaintiff submitted that it has secured international registrations and/or national registrations, in over ninety-three countries, such as the United Arab Emirates, France,

Canada, Switzerland, Singapore, Australia, etc., including India. For factor 5, it submitted that it has been vigilant in protecting and safeguarding its trade mark rights from misuse by third parties and placed on record injunction orders granted by the German Courts in favour of the Plaintiff and undertakings given by third parties. Lastly, the Plaintiff asserted that that knowledge or recognition of the trade mark is required to be assessed vis-à-vis the relevant section of the public and in light of the same, the Plaintiff has submitted sufficient material on record which indicates that the criteria enumerated in Clauses (i) to (v) of Section 11(6) are satisfied with respect to the renown of the mark in the fashion industry, and that therefore, the mark is entitled to be certified as a well-known trade mark.

The Hon'ble High Court considering the volume and nature of material placed on record by the Plaintiff to support the plea for declaration of its

mark “” as a well-known trade mark, held that the criteria as enumerated in section 11(6) of the Trade Marks Act, read with Section 11(7), stood satisfied in the present case, so as to justify declaration of the “

” mark as a well-known trade mark within the meaning of Section 2(1)(zg) of the Trade Marks Act 1999.

TTK Prestige Ltd. vs. K.K. and Company Delhi Pvt. Ltd. and Ors.

Forum: High Court of Delhi
Case No.: CS (COMM) 864/2022
Order Dated: 20th February 2023

Issue: Whether the defendant's claimed prior use of its trademark was substantiated by sufficient evidence?

Judgement: The plaintiff, has been using the trademark 'PRESTIGE' for its kitchen home appliances since 1955, filed an application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC) against

the defendant, who is engaged in manufacturing and selling 'gas stoves' under a conflicting trademark. The plaintiff has several trademark registrations for 'PRESTIGE' in various classes and has provided evidence of substantial sales turnover and promotional expenses under the trademark. The defendant filed an application for registration of a device mark



in 2018, which was opposed by the plaintiff citing its conflicting trademark.

Defendant no.1 claims to have used the trademark in question since 1981 and is a prior user of the mark for gas stoves. This was mentioned in their trademark application filed in November 2018. The plaintiff filed a trademark application for the same mark in June 1981 on a proposed to be used basis and was aware of the defendant's use since 1981.

The court held that the defendant claimed to be a prior user of the trademark since 1981 but only presented three invoices from 1982 as evidence. The defendant's counsel requested more time to provide further documents to prove the continuous use of the trademark since 1981. However, the court pointed out that according to the rules of the Commercial Courts Act, the defendant must file all documents in their possession and can only submit additional documents with the court's permission and reasonable explanation. Since the defendant did not seek permission to file additional documents, the court held that no further time could be granted to provide additional evidence. Therefore, the court would presume that there was no continuous use of the trademark by the defendant.

The court referred to the *Pioneer Nuts case* and stated that a trader must demonstrate a connection between the trader and the goods due to the use of the trademark. The court held that the defendant in the present case had not provided enough evidence of continuous use of the trademark to establish goodwill or reputation. The defendant had only sporadically used the trademark, which did not qualify as continuous use under section 34 of the Act. The court also noted that the plaintiff's registration date of June 16, 1981, was earlier than the defendant's three invoices. The court found that

the defendant had failed to establish the use of the trademark prior to the plaintiff's registration. The defendant had not challenged the validity of the plaintiff's registration in their written statement. Therefore, the court granted an interim injunction in favour of the plaintiff.

The court also held that the plaintiff established a prima facie case of infringement and passing off, as well as immense goodwill and reputation of its trademark 'PRESTIGE' in respect of pressure cookers. The defendant's defense that pressure cookers and gas stoves are different products was rejected. The court relied on a previous judgment and observed that the use of the trademark 'PRESTIGE' by the defendant in respect of gas stoves is likely to cause confusion in the market. The court found that the balance of convenience is in favour of the plaintiff and granted an injunction against the defendant from manufacturing, selling, and advertising gas stoves or any related goods under the mark 'PRESTIGE' or any deceptively similar mark.

Loreal vs. The Registrar Of Trade Marks

Forum: High Court of Delhi

Case No.: C.A.(COMM.IPD-TM) 119/2021

Order Dated: 8th December 2022

Issue: Whether the Appellant's mark 'PILLOW PROOF BLOWDRY' in class 3 is devoid of distinctiveness and unworthy of registration.

Order: This case is an appeal filed by the Appellant who impugned the order dated 16th August 2019 issued by Senior Examiner of Trade Marks declining review of his own order dated 26th June 2018 whereby Appellant's application no. 2590315 was refused. The Appellant applied for the mark "PILLOW PROOF BLOWDRY" in Class 03 to be used in relation to 'shampoos, gels, powders, sprays, mousses, balms, creams, lotions, serums and wax for hair styling and hair care, hair lacquers, hair colouring and hair decolourant preparations, protective colour for treated hair, permanent waving and curling preparations, hair strengtheners preparation,

and essential oil for personal use'. Presumably, the concerned examiner refused the application alleging the mark as devoid of distinctiveness, as there were no prior marks cited against the Appellant's mark. The refusal order simply mentioned that *"The trade mark applied for is objectionable under Section 9 (devoid of distinctiveness)/Section 11 (presence of prior marks) of the Act. The application is accordingly refused"*.

The Delhi High Court set aside the order passed by the Respondent and directed the Trademarks Registry to process the registration application of the wordmark 'Pillow Proof Blowdry'. The court noted that the mark is not devoid of distinctive character and when assessed on an overall basis, it is a combination of three random words which is not descriptive of the concerned product i.e., a shampoo. The court clarified and asked for a disclaimer in the trademarks journal that the subject mark shall not be granted with any exclusive rights in the words, "Pillow", "Proof" or "Blowdry", separately or individually.

Aktiebolaget Volvo & Ors. vs. Gyan Singh

Forum: Delhi High Court
Case No.: CS(COMM) 1203/2018
Order Dated: 25th April 2023

Issue: The plaintiffs had their business in transportation and automotive sector, including the business of manufacturing spare parts, accessories, and ancillary parts for vehicles under the mark 'VOLVO'. The plaintiffs were the registered proprietor of the mark 'VOLVO' and 'VOLVO' formative marks in Class 12 and various other Classes and the 'VOLVO' mark had acquired the status of 'well-known trade mark' within the meaning of Section 2(1)(zg) of the Act, which was recognized in *Aktiebolaget Volvo of Sweden v. Volvo Steels Ltd. of Gujarat (India)*, 1997 SCC OnLine Bom 578. In 2018, the plaintiffs became aware of the defendants' activities when they came across the advertisements and sale of the bicycles by the defendants under the mark 'VOLVO'. The Defendant 2, Road Master Autotech (P) Ltd.

offered their products for sale on their website www.roadmasterindia.com as well as on third party merchant platforms like www.indiamart.com. Therefore, the plaintiffs submitted that the use of the registered and well-known mark of the plaintiffs by the defendants in respect of goods in identical classes amounted to infringement of the plaintiffs' mark 'VOLVO' and passing off the goods of the defendants as that of the plaintiffs.

Order: The Delhi High Court decreed the suit in favour of the plaintiff. The court relied on Section 29(6) of the Trademarks Act to hold that the “use” of a mark is not limited to the manufacture of the goods but also includes affixing the impugned mark and offering the goods bearing the impugned mark for sale. In light of the above reasoning, the court held that the defendants, which include manufacturers and sellers of the goods bearing the impugned mark, are infringing the mark “Volvo” and awarded INR 10 Lakhs as damages and costs to the plaintiff.

Macleods Pharma vs. Union of India

Forum: Bombay High Court

Case No.: WRIT PETITION NO.1517 OF 2022

Order Dated: 15th February 2023

Issue: Whether a mere existence of the slightest probability of confusion in case of medicinal product marks requires the use of such mark to be restrained?

Order: The Petitioner is a pharmaceutical company incorporated under the provisions of the Companies Act, 1956. It is the claim of Respondent 4 that it had applied for registration of trademark “OFRAMAX” on 30th August 1989 and registration was granted on 13th May 1994 in Class-5 i.e., “pharmaceutical products for human and veterinary use”. However, the Petitioner filed the trademark application on 28th January 1999 for the mark “OFLOMAC” in said Class-5 and was granted registration for the same. Thereafter, Respondent 4 filed a rectification application seeking cancellation/ removal of the said ‘OFLOMAC’ trademark registration of the Petitioner, which was thereby allowed, and the order has been impugned in

the present petition. The Petitioner aggrieved by the order passed by the Intellectual Property Appellate Board (IPAB) filed a petition.

The court noted that the principles to determine the question of confusing similarity in the case of trademarks used in respect of medicinal products are as follows:

- In cases where there is a question of medical or pharmaceutical product trademarks causing deception in the minds of the public. It is the duty of the Court to take utmost care to prevent any possibility of confusion between the use of these trademarks.
- The Court opined that in cases of non-medicinal products it may only lead to economical loss to the person but, in case of confusion between two medicinal products the Court must take utmost care keeping in mind the health and safety of the general public. Hence, it is proper to require a lesser quantum of proof of confusing similarity for such products.
- The mere existence of a slightest probability of confusion between the marks is enough to restrain the impugned trademark. The Court's primary duty is always to protect the public irrespective of what hardship or inconvenience it may cause to any party whose trademark is likely to deceive or cause confusion.
- The Courts decide from a view of an ordinary common man with average intelligence which include considering multiple factors such as the first impression of the mark, salient features of both the products, nature of the commodity, overall similarity, and the possibility of the same creating confusion amongst the public at large.

The Court further noted that the conclusions recorded by the IPAB are proper and legal and recorded by applying the established principles to the same and held that there is no substance in the Writ Petition filed by the Petitioner and therefore, the same was dismissed.




Cable News Network vs. CTVN Calcutta Television Network Pvt Ltd

Forum: High Court of Delhi



CS (COMM) 309/2021 & IA 7844/2021 & IA 9228/2021

Order Dated: 28^h April 2023



Issue: Does use of  and  by the defendant infringes  of the plaintiff, Cable News Network Inc. for television broadcasting services? And if the plaint is returnable for lack of jurisdiction?

Order: Relying on judicial precedents set by the Division Benches and Supreme Court, the Court observed that issue of jurisdiction has distinctly to be examined vis-à-vis Section 20 of the Civil Procedure Code and vis-à-vis Section 134(2) of the Trade Marks Act. If either applies, the court's jurisdiction would be invoked. The Court found that there is no proof that any commercial transaction could be concluded across the defendant's website within the jurisdiction of this Court, nor it has been pleaded that defendant's website is interactive, mere accessibility of a website does not amount to arising of a part of cause of action, Section 20(c) of the CPC would not apply. However, the Section 20(b) of the CPC could be invoked as the essential part of the business of the defendant of providing news services (via websites and social media pages) was within jurisdiction of the Court. Furthermore, it was noted that even the Plaintiff carried on its business within jurisdiction of the Court and Section 134(2) of the Trade Marks Act was invoked. Therefore, the Defendant's application for return of plaint was dismissed.

The Court observed that the way the Defendant has styled its logo , with the C and N joined at the base, each letter otherwise standing erect, is deceptively similar to the manner in which the Plaintiff has styled its logo . While there is additional N in Plaintiff's logo, there is a possibility that viewer may have an impression, given the similarity of the logo and the fact that both entities are involved in providing identical service of

dissemination of news over the television, that there is an association between the two. Thus, case of infringement and passing off is made out. Injunction order was issued against the Defendant.

Winzo Games Pvt. Ltd. vs. Google LLC and Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 176/2022

Judgement dated: 14th February 2023

Issue: Whether the warning shown on the defendant's platform using the plaintiff's mark WinZO constituted "*use of the trademark during the course of trade*" under section 29 (4) of the Trade Marks Act, 1999?

Judgement: The present suit was filed seeking a decree of permanent injunction along with other ancillary reliefs by the plaintiff, the registered proprietor of the marks "WinZO" and "WinZO Games" under relevant classes. The application of the plaintiff was available on the Google Playstore until it was converted by the plaintiff to a paid gaming platform. Thereafter, the plaintiff had to remove its application from the Google Playstore. The plaintiff's website 'www.winzogames.com/' was accessible through various search engines, to the consumers to download its games. In November 2021, the plaintiff was informed of the defendants displaying a disclaimer/warning to its users upon an attempted download of the plaintiff's application as: "*This type of file may harm your device. Do you want to keep WinZO. apk anyway?*" The plaintiff argued among other things that the aforesaid warning goes beyond the mandate of the Information Technology Rules, 2021, and that the warning placed by the defendants amounted to infringement/tarnishment of the plaintiff's trademarks. The defendants argued that they were only cautioning the users in respect of all third-party applications that were downloaded from the internet, similar to the practice followed by other browsers. The Court held that *prima facie* this seemed to be an industry practice. Further, the Court held that to make out a case for infringement under Section 29(4) of the Trade Marks Act, 1999 (Trade Marks Act), all three conditions under the said provision have to be met. Since the defendant was not providing any goods or services using the impugned trademarks, thus, the same did not

constitute ‘*use of the trademark in the course of trade*’ within the meaning of Section 29(4) of the Trade Marks Act. Further, since the defendant was not advertising goods/services by using the plaintiff’s marks in any manner, there was no infringement under Section 29(8) of the Trade Marks Act. It was also held that there was no competing interest of the products/services of the defendants involved and thus, no case of disparagement was made out. Lastly, as far as the ground of inducement of breach of contract between a user and the plaintiff was concerned, the act of a user opting to download an application from the website of the plaintiff would not result in a contract, but after such download would merely constitute “willing to execute a contract”. Therefore, there was no contract at the stage when the warning appears. Thus, the application was dismissed.

Mohan Meakin Limited vs. Accord Distillers & Brewers Pvt. Ltd.

Forum: High Court of Himachal Pradesh

Case No.: COMS No. 1 of 2023

Order dated: 17th March 2023

Issue: Whether use of the defendant’s mark “Missionary Monks Authentic Pure Xo Brandy” infringed the plaintiff’s registered and famous trademark “Old Monk” (for rum)?

Order: The plaintiff filed a suit against the defendants for permanent injunction against infringement of the famous registered trademark “Old Monk” (for rum), passing off, unfair competition, damages, rendition of accounts, etc. as the defendant was found to be selling brandy under the mark “Missionary Monks Authentic Pure Xo Brandy” which conspicuously projected the word, “Monk”. The defendant had also filed an application for registration of its said mark which was opposed by the plaintiff. The plaintiff also submitted that it had earlier approached the Delhi High Court against use of the marks ‘TOLD MOM’ and ‘CRAFTY MONK’ by different companies and the case in ‘TOLD MOM’ was decided in its favour, whereas the case pertaining to ‘CRAFTY MONK’ was decreed as per compromise between the parties and in those cases the defendants had

been restrained from using the deceptively similar trademarks involved. The plaintiff submitted that in this case as well, the defendant was trying to create an illusion in the minds of the consumers/trade that its trademarked goods belong to the plaintiff thereby amounting to grave misinterpretation, and dilution of the reputation and goodwill of the plaintiff in the mark “Old Monk”.

The Court, after analysing the two sets of marks concluded that the manner of representation of the defendant’s mark and the use of the word ‘Monk’ prominently, made out a *prima facie* case in favour of the plaintiff for passing ad-interim injunction. Accordingly, defendant, their promoters, assigns, relatives, successors-in-interest, licensees, franchisees, directors, representatives, servants, distributors, employees, agents, etc., or anyone associated with them were restrained from using the impugned mark ‘Missionary Monks Authentic Pure Xo Brandy’ and /or any mark identical with or similar to the plaintiff’s registered trademark Old Monk and/or Monk and/or formative variants thereof singularly or in conjunction with any other word or monogram/logo as a trade mark, service mark, house mark, trade name, trading style, corporate name, website, email address, or otherwise in any manner whatsoever.

Scholl’s Wellness Company Limited vs. M/S. Arihant Remedies

Forum: High Court of Delhi
Case No.: CS(COMM) 918/2022
Order Dated: 23rd December 2022

Issue: Whether the Defendant Arihant Remedies was infringing the registered trademark Krack and trade dress of the Plaintiff?

Order: The trademark KRACK was adopted in the year 1993 by the Plaintiff’s predecessor Paras Pharmaceuticals to be used in respect of a heel repair cream along with allied products. The Plaintiff predecessor-in-interest had obtained two trademark registrations under application nos. 1892735 and 1892733 in class 5 and these registrations were assigned to

Scholl's Wellness Company Ltd. by way of assignment from Reckitt Benckiser Group Plc which had acquired Paras Pharmaceuticals. The Plaintiff had come to know about the Defendant's trademark KRACKSOL during search on the records of the Trade Marks Registry. The Defendant's trademark was identical/ deceptively similar to the Plaintiff's registered trademarks and filed in the same class. On conducting ground investigation, it came to the knowledge of the Plaintiff that the Defendant was using the trademark KRACKSOL in a yellow and purple trade dress which was similar to the trade dress of the Plaintiff. The Plaintiff contended that the Defendant's trademark contained the Plaintiff's trademark as well as its trade dress. It was argued that the goods of the Defendant are available on various e-commerce websites which are bound to cause confusion and likely to be believed that the products provided by the Defendant originate from or bear an association/ affiliation/ connection with the Plaintiff. It was also pointed out that by the Plaintiff that the directions of use as stated by the Defendant in its packaging clearly indicated blatant imitation by the Defendant.

The Court noted that the Plaintiff has made out a prima facie case in its favour and balance of convenience also lies in favour of the Plaintiff and against the Defendant. The Court granted ex-parte ad-interim injunction in favour of the Plaintiff and restrained the Defendant and its agents or any such person acting for and on their behalf from using the word 'KRACK' or trade dress on the product which is violative of the Plaintiff's statutory and common law rights.

Dhananjay Rathi vs. Shree Vasu Steels Private Limited and Others

Forum: High Court of Delhi
Case No.: CS (COMM) 267/2022
Order Dated: 15th June 2022

Issue: Whether the Court has the power at any stage of the proceeding to implead a party in whose absence the subject matter of the suit cannot be decided effectively.

Order: A company by the name of Rathi Steel Rolling Mills ('RSRM') was started by three male members of the Rathi Family. In 1968, RSRM entered into a technical collaboration with M/s. TOR Istag Steel Corporation for manufacturing of TOR Steel Bars under the registered trademark RATHI. In 1969, RSRM split into two different groups of companies, namely, M/s G.D Rathi Steels Limited, and M/s K.L Rathi Steels Limited applied for and obtained registration for the trademark RATHI in class 6 for certain items, while G.D. Rathi Steels Limited obtained registration in class 6. The Trust named Rathi Foundation was created and registered under the Indian Trusts Act, 1882 and the trademark RATHI along with the goodwill was assigned to the 'Foundation'. To bring on record the 'Foundation' as the subsequent proprietor of the trademark RATHI, an appropriate assignment request was filed before the Trademarks Registry and the same was accepted.

A Memorandum of Understanding ('MoU-2') was entered into between few other members of the Rathi Family. In furtherance of MoU-2, a Trust was created by the name of Rathi Research Centre which was duly registered under the Indian Trusts Act, 1882. A suit was filed by one of the lifetime Trustees of the 'Foundation', upon learning through market surveys that the Defendants were using the mark RATHI PRAGATI alleging infringement, passing off etc.

An ex-parte ad interim injunction was granted by the Court. On being served, Defendants No.1 to 3 who are stated to be assignees/licensees, filed an application seeking vacation of the injunction order as Defendants have

been assigned the user licenses to lawfully use the trademark RATHI for specified periods as per a new Trust Deed.

Defendant also submitted that Plaintiff has not impleaded the Rath Research Centre 'Centre' as a party to the present suit and has concealed the execution of the new Trust Deed. After such objection, the Plaintiff filed the present application for impleading the 'Centre' as a party Defendant.

The Plaintiff filed the suit against the Defendants upon learning through market surveys that the Defendant's were using the mark RATHI PRAGATI alleging infringement, passing off etc. It is claimed that Rath Foundation was formed pursuant to a Memorandum of Understanding dated 24th June, 1995 executed by three different groups of the Rath Family, named therein. MoU incorporated inter alia provisions specified the number of licenses to be granted to each family group as well as regulating/restricting the use and/or assignment of the licenses, with respect to the trademark RATHI.

The fundamental ground raised by the Plaintiff in the suit is that by virtue of the restrictive covenants in the MoUs, only the Members/Trustees of Rath Foundation and the 'Centre' were licensed to use the trademark RATHI and in the manner provided in the respective MoUs and thus the Defendants were using the mark unauthorizedly. *Vide* order dated 28th April 2022, an *ex parte ad interim* injunction was granted by the Court restraining Defendants from using the trademark RATHI and/or any other mark deceptively and confusingly similar to RATHI on the ground that third parties not being Members/Trustees of the Trusts could not use the mark RATHI in terms of MoUs and the Trust Deeds.

On being served, Defendants filed an application seeking vacation of the injunction order. The Defendants set up a case pursuant to MoU-2 dated 26th June 1995, stating that the 'Centre' was constituted as a Trust with six lifetime Trustees, divided into two groups. MoU-2 regulated the manner of granting licenses for use of the trademark RATHI. The 'Centre' executed a new Trust Deed incorporating Clause which permits grant of license for use of the trademark RATHI to other companies/firms/persons, not owned by the Members/Trustees whose names appear in the MoU-2 dated 26th June

1995, provided that the grant is by a unanimous Resolution, in writing, by all six Trustees of the 'Centre' and signatories of the MoU-2. Pursuant thereto, Defendants have been assigned, the user licenses, to lawfully use the trademark RATHI for specified periods mentioned in the Agreements and limited to the products provided therein and subject to geographical restrictions. Defendants submitted that thus, the use of the mark by the Defendants is neither illegal nor unauthorized as alleged and does not constitute infringement.

The Court was of the view that is a common ground and a broad consensus between the Plaintiff and the Defendants that the 'Centre' is a necessary party, and the allowed the application and the Members/lifetime Trustees of the 'Centre' were directed to be impleaded as Defendants in the suit.

Considering the respective stands of the Plaintiff and the Defendants, the Court observed that the 'Centre' is a necessary party for effective and complete adjudication of the disputes and the issues arising in the suit and accordingly allowed the application.

Roger Yang vs. Registrar of Trade Marks

Forum: High Court of Delhi

Case No.: C.A. (COMM) 109/2022

Order Dated: 05th July 2022

Issue: Whether the Plaintiff can claim the rights on the words TRAVELER'S CHOICE'.

Order: The appeal was originally filed before the Intellectual Property Appellate Board (IPAB) and due to the enactment of Tribunals Reforms Act, 2021, the matter has been placed before Delhi High Court. An appeal had been filed challenging the order dated 15th March 2019 passed by the Registrar of Trade Marks by which the application of Appellant for the mark



Traveler's Choice

under application no. 3008920, refusing the registration of the mark 'Traveler's Choice' in Class 18 for luggage, sports bags, carrying bags, backpacks, book bags etc. The mark was rejected based on three prior

cited marks containing the standalone word ‘Choice’ or ‘Traveler’, in addition to the mark being devoid of distinctive character.

The Appellant submitted that in so far as the word ‘Choice’ is concerned, there is a disclaimer qua the word 'Choice' in the prior applications. On being devoid of distinctiveness, the Appellant submitted that the mark was adopted by the Plaintiff globally in the 1960s and has also been registered in other countries. Therefore, the mark ought to be permitted to proceed with registration.

The Court held that the Appellant's mark is a composite mark in Class 18 and considering the mark as a whole and set aside the refusal order. The mark was ordered to be advertised, subject to a disclaimer on individual terms (TRAVELER, TRAVELER'S or CHOICE) in the mark.


The Free Elective Network (P) Ltd. vs. Matrimony.com. Ltd.

Forum: High Court of Madras


Case No.: Civil Suit (Comm. Div.) No. 122 of 2021, O.A. Nos. 826 and 828 of 2021 and A. No. 442 of 2022

Order Dated: 14th July 2022

Issue: Whether the Plaintiff can claim infringement of its registered trademark JODI365 due to the Defendant's use of the trademark Jodii? Whether the Plaintiff is the registered proprietor of the trademark “Jodi365”, whether the Defendant's mark “Jodii” is deceptively similar to the Plaintiffs trademark?

Order: Plaintiff claimed that they owned and adopted the trademark  (Jodi 365 composite mark) under Registration No. 1971072 in classes 35, 38 and 41 and other registered trademarks (Peepul365). The Defendant infringed the Plaintiff's mark by using a deceptively similar trademark ‘Jodii. Plaintiff argued that the use of the word "Jodii" by Defendant was likely to cause confusion among the public and result in dilution of its trademark rights.

The Defendant stated that the application is in Tamil and that the word “Jodi” directly refers to the nature and purpose of services offered. According to the Defendant, the Plaintiff has a registration in respect of the device mark "Jodi365" and not in respect of the word “Jodi”. Consequently, by virtue of such registration, the Plaintiff is not entitled to a monopoly over the word “Jodi” or any variant thereof. The Defendant asserted that the device marks of the Plaintiff and the Defendant are not even remotely similar. The Defendant further stated that several other entities use the word “Jodi” as part of applications in relation to matchmaking or dating services.

The Court analysed the mark "Jodi" and held that the mark was distinctive and unlikely to cause confusion with the mark "  " owned by Plaintiff. The Court further observed that the mark "Jodi" was a common word in the Indian matrimonial market or dating services and had been used by various players in the market, including Defendant.

The Court opined that since a generic term describes either the product/service category or the product/service, no person is permitted to monopolize or appropriate such term and claim exclusive use thereof. Such terms may be entitled to protection provided they acquire distinctiveness and secondary meaning.

The suit filed for a permanent injunction restraining the Defendant was dismissed by the Court subject to the observations on the acquired distinctiveness of the composite mark. Since the Plaintiff is the prior user of the mark, the registered proprietor thereof and it was held that the Plaintiff is entitled to protect the composite mark but not the element “Jodi”.

Star Television Productions Ltd. vs. Eurosport

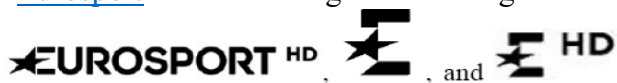
Forum: High Court of Delhi

Case No.: CS (COMM) 359/2020 and I.As. 7682/2020, 11913/2020 & 16049/2021

Order Dated: 09th September 2022

Issue: Whether the changed logo of the Defendant is infringing the well-known device mark of STAR Television Productions Ltd.

Order: Plaintiff is the owners and operators of various branded television channels whose logo contains the star device and its variant, as a prominent part in its family of marks. Plaintiff has been using the trade mark “STAR” since 1991, continuously and uninterruptedly in the broadcasting space, and, in India, when they launched the first TV channel, “STAR TV” in 1992. It is the case that Defendants recently renamed their sports channel which was earlier called as “[DSport India](#)” with the logo of a globe to “[Eurosport](#)” and the usage of the single Star. The newly adopted logos

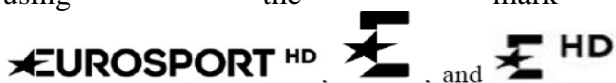


of Defendants was deceptively similar to the registered trade mark of Plaintiff. It was also submitted by the Plaintiff that the star has been positioned prominently in juxtaposition with the letter “E” which was why the “Star” in “[Eurosport](#)” was deceptively similar to its various registered STAR Marks in India.


The Defendant claimed that the two marks were different and not nearly comparable enough to lead to consumer confusion. The Defendant further argued that the Plaintiff's trademark had no reputation or goodwill and was not well-known in India. The Court accepted the fact that EUROSPORT was not at all similar and obviously not identical to Star Sports, but when the Single Star Device is used by [Eurosport](#), in the light of the fact that Plaintiff had several channels, the possibility of confusion cannot be ignored, which in turn would affect the distinctiveness of Plaintiff's marks. Thus, the adoption of the Single Star by no stretch can be considered to be a bona fide adoption.

The Court determined that the Plaintiff's trademark "STAR SPORTS" was a well-known mark in India's television broadcasting industry and that it had gained a distinctive character and reputation among consumers. In addition, the Court found that the Defendant's use of the name "EUROSPORT" with star image has clearly violated Trade Mark laws and was likely to mislead consumers.

The Court gave the Plaintiff an injunction preventing the Defendant from using the mark "EUROSPORT"



and, or any other mark which is identical or deceptively similar to the Plaintiff's registered STAR

Marks including the STAR Device  in connection with television broadcasting services. The Court has stayed further proceedings, pending a rectification dispute between the rival parties.

Vee Excel Drugs & Pharmaceuticals (P) Ltd. vs. Union of India and Others

Forum: High Court of Delhi

Case No.: W.P.(C)-IPD 101/2021 and CM 12260/2013

Order dated: 18th August 2022

Issue: The Plaintiff has filed the present petition against the order passed by the IPAB (Intellectual Property Appellate Board), directing the cancellation of its registered trade mark 'VEGA ASIA' and its removal from the Register of Trade Marks.

Order:

The Plaintiff filed the writ petition challenging the order dated 31st July 2013 passed by the-then Intellectual Property Appellate Board (hereinafter 'IPAB'), whereby the tribunal had allowed the rectification/cancellation petition filed by the Defendant of the Plaintiff's registered trade mark 'VEGA ASIA' in Class 05. It is claimed that the application for the

registration of trade mark '**VEGA ASIA**' was filed on 08th February, 2002 on a '*proposed to be used*' basis and the same was granted registration on 31st March, 2005. Whereas the Defendant applied for the registration of the mark of '**VEGAH TABLETS**' on 24th April 2002 in Class 05, claiming use thereof since 1st April 2002. The said mark was registered in favour of the Defendant on 19th December 2003.

The Plaintiff and the Defendant both filed cross-petitions before the IPAB, seeking rectification/cancellation of the marks registered in favour of each other. The IPAB passed an order directing to remove both the marks of the Plaintiff and the Defendant no.2 from the Register of Trade Marks. The aggrieved party that is the Plaintiff has filed this petition against the order passed by the IPAB towards removal of the Plaintiffs' mark '**VEGA ASIA**'.

The Ld. Counsel for the Plaintiff stated it is not only the prior adopter of '**VEGA ASIA**' but also the prior applicant for the registration of the mark. Since it has been the user of the trademark '**VEGA ASIA**' since the year 2012.

The Plaintiff vide a license agreement acquired the mark '**VEGA**' from another entity M/s Ma Gayatri, whose use predated the Defendant no.2's use of the mark. Further the Plaintiff claimed that there was on record an application made by M/s Ma Gayatri to the Drug Controller General of India and a NOC (No Objection Certificate) granted in its favour for the medicinal preparation in the mark VEGA-100. Further showcasing the usage of the mark VEGA since 2001.

The learned counsel for the Plaintiff, drawing reference to the copyright registrations obtained by the Defendant no.2 under the registration no. A-73948/2005 in '**VEGA-50**', and vide the registration no. A-71707/2005 in '**VEGA-100**', submitted that as in the year 2005 also, the said marks were claimed to be 'unpublished' by the Defendant no.2, therefore, any user claimed by it prior to the year 2005 is false. Further, the Plaintiff has been using the mark till the commencement of the rectification petition filed by Defendant no. 2.

The Defendant claimed that the Plaintiff having used the mark 'VEGA ASIA' prior to the year 2002 is false by its own claim in the application seeking registration of the said mark, where it claimed the mark to be 'proposed to be used'. They further claimed that the Plaintiff cannot rely upon the license agreement between the Plaintiff and M/s Ma Gayatri because in the agreement the Plaintiff is the licensor and M/s Ma Gayatri is the licensee. Further, the agreement has not been placed on record by the Plaintiff either before the IPAB or before the High Court.

The Court observed that the Plaintiff in its application seeking registration of the mark 'VEGA ASIA' had claimed the same to as '*proposed to be used*' and any claim of prior user thereof by the Plaintiff itself, cannot therefore be accepted. Further, Licence Agreement with M/s. Ma Gayatri, upon which the Plaintiff has placed reliance describes the Plaintiff as a Licensor and M/s. Ma Gayatri as a Licensee. By this Agreement, it is the Plaintiff who licenced the use of its marks to M/s. Ma Gayatri and not the other way around. An adverse inference, therefore, should be drawn against the Plaintiff in this regard. Further, with reference to the reliance placed by the Plaintiff on the NOC, the Court observed that the said document does not bear any reference to a trade mark. The Court arrived at a conclusion that the Defendant had been able to show the use of the mark 'VEGA' since the year 2001. In view of the facts of the case, the Court observed that there was no merit in the petition and therefore the same was dismissed.

Perfetti Van Melle S.P.A. vs. Suresh Nanik Lilaram Hingorani and Others

Forum: High Court of Delhi
Case No.: CS (COMM) 363/2017
Order dated: 01st September 2022

Issue: Whether the Defendant's argument, that they were using the name "Harnik Chupa Chups" descriptively rather than as a trademark for confectionery item, if acceptable.

Order: The case is related to the trademark infringement dispute between parties - Perfetti Van Melle S.P.A. (PVMS/Plaintiffs) and Suresh Nanik Lilaram Hingorani (Defendants). PVMS/Plaintiffs are the owner of the "Chupa Chups" trademark and had filed a suit against Defendant for using a deceptively similar mark "Harnik Chupa Chups" on its products and goods.

Defendant argued that they were using the name "Harnik Chupa Chups" descriptively rather than as a trademark. The Defendant asserted that since the term "Chupa Chups" was frequently used to denote lollipops as Chupa Chups lollipop, they were allowed to use the mark in this way.

The Court stated that although it is true that no single dealer can monopolise descriptive phrases, it is also crucial to take the context of their use into account. The Court noted that the Defendant was using the mark "Harnik Chupa Chups" as a trademark rather than just a descriptive term. The Court further noted that it was likely to lead to consumer confusion if the same font and colour scheme were used as those in the Chupa Chups trademark.

Accordingly, the Court held that Defendant had infringed on the trademark of PVMS/ Plaintiffs and restrained Defendant from using the mark "Harnik Chupa Chups" or any other deceptively similar mark. The Court also directed Defendants to pay damages to PVMS/Plaintiffs for the infringement.


Phonepe (P) Ltd. vs. Ezy Services

Forum: High Court of Delhi

Case No.: CS (COMM) 292/2019 & I.A. 4975/2022

Order dated: 29th August 2022

Issue: Whether the Plaintiff has the right to use the term 'Pe' or any deceptive variant of 'PhonePe'?

Order: The Defendant, EZY Services, was accused of trademark infringement and passing off in relation to the Plaintiff's "PHONEPE" () trademark. Phonepe (P) Ltd., the Plaintiff, is a digital payments business that runs a mobile application under the "PHONEPE" brand. Under the name "PHONPE", the Defendant, EZY Services, was also running a mobile application with a similar name and design.

The Plaintiff argued that the Defendant's use of a mark and logo that deceitfully resembled its own was likely to confuse customers and dilute the Plaintiff's trademark. The Plaintiff demanded damages for trademark infringement and passing off, as well as an injunction prohibiting the Defendant from using the mark "PHONPE" and the logo going forward.

The Defendant claimed that because the mark "PHONPE" was a combination of two distinct words, "PHONE" and "PE," and had a distinctive logo and colour scheme, it did not infringe on the Plaintiff's trademark.

The Court ruled that the Defendant's use of the mark "PHONPE" was likely to confuse consumers since it was misleadingly similar to the Plaintiff's trademark "PHONEPE".

The Defendant's use of a mark and logo that are similar to the Plaintiff's is likely to weaken its trademark and cause irreparable harm to the Plaintiff's business, the Court added, noting that the Plaintiff has a well-established reputation in the market.

Considering these conclusions, the Court granted the Plaintiff an interim injunction barring the Defendant from using the mark "PHONPE" and the logo going forward. The Defendant was also ordered by the Court to pay the Plaintiff damages for passing off and trademark infringement.

The Official Liquidator of M/s. Ideal Jawa (India) Ltd. (In Liquidation) vs. Registrar of Trademarks & Ors.

Forum: High Court of Karnataka, Bengaluru

Case No.: CA No. 71/2018

Order Dated: December 16, 2022

Issue: Would a Company's trademark and associated goodwill get devolved onto the promoter of the Company after it gets liquidated/wound-up? Can the promoter of a Company claim any ownership over the trademark owned by the Company, after its liquidation?

Order: This is an interesting case which sheds light on the determination of rights over a Company's trademark and the goodwill attained by the use made of it, after the Company is liquidated. The trademark "Yezdi" was registered in the name of Ideal Jawa (India) Ltd. in the year 1969, which later went under liquidation. The Company used to manufacture and sell bikes and motorcycles under the said trademark which became a sensation amongst the public. However, the Company had discontinued operations in 1996 and it was wound-up in 2001, and the Official Liquidator (OL) was appointed to oversee the dissolution process under the supervision of the Court. However, the promoter of the Company formed another company with a separate entity and allegedly filed and obtained registrations for the mark "Yezdi" after the winding-up of the original Company. The promoter of the Company had registered a website www.yezdi.com in 1998. Subsequently, in 2013 and 2014, the promoter obtained a number of registrations for the mark "Yezdi", which were accepted and granted by the Trade Marks Registry since the original Company's registered trademark "Yezdi" was not renewed and thus became invalid after 2007 on account of such non-renewal in the Registry's records. Being aggrieved by the above actions, an application was filed by both the Official Liquidator and Ideal Jawa Employees Association against the promoter who had obtained registration of the Yezdi marks knowing that the Company was under winding-up conditions.

The Court observed that during the winding-up process, no one claimed right over the trademark "Yezdi", as the same still stood registered in the name of the Company as per the records of the Trade Marks Registry. In

view of the above, it was held that the rights over the said mark still belonged to the Company even after winding-up. The claims of the promoter over succession of the trademark “Yezdi” were rejected by the Court. Further, the Court held that it is the goodwill of the trademark “Yezdi” that had helped the promoter to conduct business by using the said trademark. Such legacy made it easy to establish other entities/businesses in the market and this was termed as goodwill by the Court. Further, it was held that the goodwill of the Company’s trademark would continue to exist even after the trademark ceased to be used by or registered in the name of the Company. It was also held that the common sensical approach in this matter would be that the marks would retain a goodwill and reputation in the minds of the public which would be capable of being monetized by the Receiver/Official Liquidator appointed by the Court, under the process of liquidation. Further, for removal of the trademark “Yezdi” by the Trade Marks Registry on account of non-renewal, it was important to issue notices, which were not issued in the present case. It was also held that the winding-up of the Company did not affect its rights over its trademarks, which came to be in the custody of the Official Liquidator through its appointment by the Court. Therefore, the trademark “Yezdi” was deemed to be *custodia legis* of the Court and the subsequent registrations by the promoter for the mark “Yezdi” were deemed to be null and void. The Court also ordered the promoter and the separate entity that the promoter had created to do business under the mark, to pay INR 10 lakhs [USD 12,226 (approx.)] each, to the Official Liquidator and give an account of the earnings made as a result of such use of the mark “Yezdi” and its goodwill. Further, the Official Liquidator was allowed to monetize and sell/assign the trademark by setting an auction for the same.

Corona Remedies Pvt Ltd vs. Franco Indian Pharmaceuticals Pvt. Ltd.

Forum: Bombay High Court

Case No.: SLP(C) No. 3509/2023 IX

Order Dated: 20th Jan 2023

Issue: Whether Corona Remedies Pvt Ltd was justified in impugning the injunction decision passed against them?

Order: The Appellant Corona was prohibited from using the name “STIMULET” in connection with pharmaceutical medicines. The Respondent Franco filed a suit against Corona for infringement of their trademark “STIMULIV” thus seeking an injunction from a single bench court for which this appeal had been taken up..

Franco’s mark “STIMULIV” is an Ayurvedic remedy supplied in syrup and tablet form for liver function whereas Corona’s “STIMULET” is an allopathic formula used in the treatment of breast cancer and infertility.

Franco’s contention was that they were using the mark “STIMULIV” uninterruptedly since 1975 and hence obtained an injunction against Corona for their use of the word “STIMULET”. Franco’s invested a significant amount of time and money in developing its mark and has begun exporting its goods with the mark “STIMULIV” to a number of nations, including Bhutan and Mauritius and others. Whereas Corona was using their mark since 2010 and by 2010 Franco had developed goodwill and reputation in the pharmaceutical business.

Franco asserted that on November 19, 2020, it requested to the trade mark registry to prevent the word mark “STIMULET” from being registered. Franco claimed that Corona was violating its “STIMULET” trademark, as a result, it requested and was granted an order of injunction against trademark infringement as well as a comparable injunction against passing off, all of which are challenged in the appeal.

The Counsel for Corona argued that the name “STIMU” is an acronym taken from the dictionary word “STIMULATE,” which means “to make

anything active,” according to Corona. Together, these two words formed the mark STIMU-LET. The word “LET” is obtained from the chemical name “LETROZOL,” which is the substance used in the Corona product, which was commonly used by pharma companies in naming their products.

The Court held that it is settled principle of law that in determining this question it must be proved that plaintiff had acquired such goodwill and reputation when defendant began use of its trade mark. The indisputable position is that Corona is openly and extensively using its registered trademark **STIMU-LET** since the year 2010. The relevant date for determining passing off in the recent action must be the year 2010. Based on the documents relied upon by Franco, the Court held that Franco did not pass this test. Appeal was disposed with costs to the tune of INR 5,00,000/- (USD 6331).

Tata Sia Airlines Limited vs. Shenzhen Colour splendour Gift Co. Ltd.

Forum: High Court of Delhi

Case No.: CS(COMM) 352/2020 and I.A. 9553/2021

Order dated: 31st August 2022

Issue: The Plaintiff is aggrieved by the use of the marks ‘**VISTARA**’ and



by the Defendant.

Order: The Plaintiff claimed that they commenced operations with a maiden flight from New Delhi to Mumbai on 09th January 2015 and presently operates flights between several Indian cities as well as international destinations namely, Bangkok, Dubai, Nepal, Sri Lanka and Singapore. The Plaintiff claimed to be the registered proprietor of the ‘**VISTARA Marks**’ in several classes in India. The Plaintiff states that since their launch in the year 2014, the Plaintiff adopted and used the colour combination of violet (aubergine) and gold as a part of its trade dress, *inter*

alia, as part of its logo, on the uniform of its airline staff, its advertisement panels and its signboards/message panels at airports. The Plaintiff further states that the Plaintiff's word mark '**VISTARA**' was declared to be a '*well-known trade mark*' as defined under the Trade Marks Act, 1999 by this Court. The Defendant was found using the mark VISTARA for the baggage tags and keychains.

The Court observed that the use of '**VISTARA Marks**' by the Defendant not only amounts to infringement and passing off of the mark of the Plaintiff but would cause dilution of the mark of the Plaintiff. Furthermore, the apprehension of national as also international security concerns at airports by *mala fide* usage of the baggage tags and keychains being offered for sale by the Defendant *prima facie* appears to be valid in nature. Airports are an incredibly critical junction of not only travel but also of trade and commerce; any lapse in security, especially by permitting the sale of flagrantly infringing goods would be turning a blind eye to obvious wrongdoings of the Defendant.

The Court granted decree in its favour and against the Defendant and the Plaintiff was awarded damages and costs quantified at INR 20 Lakh (24,378 USD).

Sanofi India Limited vs. Ridley Life Science Private Limited

Forum: High Court of Delhi

Case No.: CS (Comm) 245/2021 and I.A. 2195/2022

Order Dated: 20th April 2022

Issue 1: Whether the defendant has violated the injunction order by using the plaintiff's registered marks 'CONCIFLAM' and 'CORIFLAM'?

Issue 2: Whether the court should grant the relief prayed for by the plaintiff.?

Order: Plaintiff filed suit for permanent injunction against trademark infringement, passing off, unfair competition, etc. Court granted ex-parte ad-interim injunction on May 31, 2021. Plaintiff also filed an application under Order XXXIX Rule 2A CPC alleging continuous violation by

Defendant of injunction order prohibiting use of 'CONCIFLAM' and 'CORIFLAM' marks registered by the Plaintiff since 1984. The Plaintiff's counsel stated that this Defendant, Ridley Life Science Pvt. Ltd., has a history of infringing well-known marks related to pharmaceutical preparations and is a habitual infringer. The defendant argued that no products have been produced under the marks 'CONCIFLAM' and 'CORIFLAM' since June 2021, despite the injunction order being issued in May 2021.

The Defendant filed an application to add an additional reply to the contempt application under Order XXXIX Rule 2A CPC. The Plaintiff's Counsel opposed the application, arguing that the Defendant has changed their stance from their earlier reply, which included an unconditional apology and a statement of non-contestation.

On 6th February 2019, the Delhi High Court directed the DCGI to conduct an inspection of Ridley's products, in view of the various brand names/mark adopted by the company. However, the court, in this order, observed that it is unclear whether the DCGI had taken any action pursuant to the order. The Court issued notice to the DCGI, to place on record an affidavit as to what steps have been taken pursuant to the orders passed by this Court in CS(COMM.) 1071/2018.

TM 25 Holding BV vs. Uma Manja Shivappa

Forum: High Court of Delhi

Case No.: CS (COMM) 78/2021 and I.As. 2346/2021, 9196/2021

Order Dated: 28th April 2022

Issue:

- (i) Whether the Defendant has not been complying with the injunction order passed by the Hon'ble Court and has continued use of infringing mark 'GS STAR'?
- (ii) Whether Defendant's mark 'GS STAR' is identical and deceptively similar to the Plaintiff's mark 'G-STAR'?

Order: The present suit had been filed by the Plaintiff to seek protection for its trademark 'G-STAR' which was adopted by it in 1989 for various apparel goods, including jeans, tops and other clothing, as well as a diverse line of luxury accessories, etc., because in June 2020, it discovered that the Defendant has been using an infringing mark 'GS STAR' for apparel and has also filed an application dated 21st November 2018 before the trademark registry for the registration of the same for the same class of products as that of the Plaintiff on a 'proposed to be used' basis. It also found that the Defendant's products were advertised and promoted on www.indiamart.com and www.justdial.com. In view of the same, the Court had granted an interim injunction on 16 February 2021. Thereafter, a Local Commissioner was appointed on 16 August 2021 in order to check the Defendant's compliance with the above injunction order, who did not find any products with the mark 'GS STAR' in the premises of the Defendant. The Defendant was shown to have started using a new board by the name 'Higher Fields Way 2 Journey' for its apparels. Photographs were placed on record by the Local Commissioner of the apparels and the board with the name 'Higher Fields Way 2 Journey'.

However, in this present application, Plaintiff contended that the Defendant has not been complying with the injunction order dated 16th February 2021. The said application was based on the affidavit of an independent investigator, who visited the Defendant's premises in June 2021 wherein it was provided that the Defendant's listings on www.indiamart.com and www.justdial.com were still persisting and presented photographs of the Defendant's premises which showed products, labels and tags still bearing the mark 'GS STAR'. The Hon'ble Court noted that the Applicant appointed independent investigator visited the Defendant's premises in June 2021, while the court appointed Local Commission was executed later in August 2021 which found no continuing use of 'GS STAR' and contended that post the Defendant receiving a copy of the present application, it must have stopped using the mark 'GS STAR' and adopted the new mark 'Higher Fields Way 2 Journey' for its board and goods. Hence, the Court directed that as there is no continued use of the impugned mark by the Defendant, the only order it shall pass is to direct www.indiamart.com and www.justdial.com to remove the Defendant's

listings bearing the mark 'GS STAR' and dismissed the Applicant's contempt application.


When it comes to the factual matrix of the case, the Hon'ble Court took note of the Plaintiff's mark 'G-STAR' and various other existing registered variants of the same in different classes that the Applicant put on record. The Court opined that the Plaintiff is clearly the prior user of the mark 'G-STAR' globally as also in India and that the Plaintiff also enjoys goodwill and reputation in the said mark 'G-STAR' in relation to apparels and garments, and thus there can be no justification for use of a deceptively similar mark in respect of identical products by the Defendant. Furthermore, it noted that despite the Plaintiff filing opposition against its mark, the Defendant had filed the Counter Statement and had continued using the mark post the opposition, and as it has not appeared for the past five hearings therefore, the use of the impugned mark was clearly deliberate and hence, passed an order for damages and litigation costs in favour of the Plaintiff.

V Guard Industries Ltd. vs. Crompton Greaves Consumer Electricals Ltd.


Forum: High Court of Delhi
Case No.: CS(COMM) 92/2022
Order Dated: 12th May 2022


Issue: Whether the Plaintiff can claim infringement of its mark basis different rival goods?



Order: The Plaintiff put forth that it has been selling products like pumps, fans, batteries, electric irons, UPS, inverters, solar water heaters, industrial motors, etc. since 1977 and particularly under its well-known mark PEBBLE since 2013 and that it is the registered proprietor of the trademark/label  in Class 11 since then for goods water heaters, electric water heaters, heating coils, electric water geysers, etc. It filed an application for registration of the word mark PEBBLE for goods namely, ironing machines, ironing presses, electric irons and electric clothes presses

etc. on 26th May 2021, however it was objected to by the Trade Marks Registry on the ground of an existing conflicting mark on the Trade Marks Register whose application was currently pending. The Plaintiff came across the impugned mark 'CROMPTON PEBBLE' under which the impugned product, 'electric iron', was being sold on the Defendant's interactive website - <https://www.crompton.co.in/> and also found that products bearing the impugned mark were also available on third party e-commerce websites like, Amazon and Flipkart wherein the word 'PEBBLE' was reflected prominently.

The Plaintiff contended that the impugned mark 'PEBBLE' was phonetically, visually, structurally identical or deceptively similar to the Plaintiff's trademark/label  and as word 'PEBBLE' is the essential and dominant part of the registered trademark/label of the Plaintiff, it confers on the Plaintiff the exclusive right to use the said word in respect of the electrical goods falling in the said Class. It contended that the competing products, i.e., electric irons and water heaters were goods which were related and similar. Before proceeding with the contentions raised by the Defendant, the Hon'ble Court noted of a development that occurred during the present suit i.e., the Defendant's mark 'CROMPTON PEBBLE' had been suspended. The main contention that was to be raised by the Defendant which fell through due to this development was that as the Plaintiff currently only holds registration in Class 11 *inter alia* with respect to 'water heaters', it cannot claim infringement against the Defendant's mark which was registered for the goods 'electric irons'.

Firstly, the Hon'ble Court opined that the Defendant's argument of the word 'CROMPTON' being a source identifier due to which its mark 'CROMPTON PEBBLE' would not lead to confusion with the Applicant's mark  was not tenable as no evidence showing such extensive use was put forth by the Defendant and that it had only claimed use since 2020, in contrast to the Applicant's use since 2013. When it comes to the contention of the Plaintiff that its goods i.e., water heaters were of similar nature with the Defendant's products i.e., electric irons, the Court refused the same and opined that water heaters and electric irons were dissimilar in their physical nature, their intended purpose and their method of use and

that the two products also failed the tests of being competing products, of being complementary to each other or of having a trade connection with each other and thus, infringement could not be claimed under Section 29 (2). However, it turned to Section 29 (4) of the Trade Marks Act and observed that the conditions required for infringement under it were that the impugned mark was identical with or similar to the registered trademark, that it used in the course of trade, that the registered trademark was reputed, that use of the impugned mark would be detrimental to said reputation and most importantly, that the impugned mark is used in relation to goods or services different from those in respect of which the trademark is registered. Other than the fulfilled criteria of the competing goods being dissimilar, the Court opined that the word 'PEBBLE' was an arbitrary word, which was being used by the Plaintiff since 2013 and for which the Plaintiff also had registration and over the years it had gained a reputation that was solely attributed to the Plaintiff. Therefore, the Court held that the Defendant had used the impugned mark PEBBLE without 'due cause' and that the Plaintiff had *prima facie* established the ingredients of Section 29(4) of the Act and thus *prima facie* case of infringement had been made out against the Defendant.

The British School Society vs. Sanjay Gandhi Educational Society and Ors.

Forum: High Court of Delhi

Case No.: CS (Comm.) 509/2021, I.As. 13426/2021, 17285/2021 and 3942/2022

Order Dated: 25th April 2022

Issue: Whether a permanent injunction could be granted against the Defendant for using the trademark 'The British School'?

Order: The Present suit was filed by the Plaintiff, The British School Society for permanent injunction against infringement of trademark, passing off, unfair competition, etc.

The Plaintiff runs 'The British School' in New Delhi which was established in 1963 by a group of British parents and the British High Commissioner to serve the diplomatic and expatriate community. The Plaintiff society operates the school with the High Commissioner as its President. The word

mark 'The British School' is registered as a trade mark claiming user since 1963 in respect of services related to education, schools, colleges, etc. for educational services, but with a condition that the registration does not grant exclusive rights to use the mark. while Defendant No.1 is a registered society in Chandigarh and Defendant No. 2 is a resident of Panchkula, Haryana.

The Defendants were accused of adopting and using Plaintiff's well-known mark 'The British School' for their four schools in Punjab & Haryana without authorization. Defendant No.2 filed a trademark application for a device mark claiming user since 1st January 2005. The application has been objected to under Sections 9(1)(a) and 11(1) of the Trade Marks Act, 1999. Defendant No.1 also filed a trademark application for a device mark on 29th January 2020, which has been opposed by the Plaintiff. Defendant submitted the term 'The British School' is not an invented word. The mark of the Plaintiff, that it seeks to protect in the present lis, is a combination of three generic words- 'The', 'British', and 'School' and the registrations of the Plaintiff for the mark 'The British School' has the specific disclaimer that the registration of the trade mark shall give no right to the Plaintiff for the exclusive use of 'The British School'

The Plaintiff's school was established in the year 1963 and it had enjoyed more than 40 years of reputation before the Defendant could adopt an identical name in the year 2005. It continues to impart high level of education to its students. Hence, goodwill in the name/mark was sufficiently established. Although the plaintiff had trademark registrations, they were with disclaimers, so exclusive rights could not be claimed. The Court held that continued use of mark 'The British School' for schools of Defendants would constitute misrepresentation in course of rendering educational services. This would imply that Defendants' schools are in some way connected or affiliated with Plaintiff. Such continuous use may cause irreparable prejudice and damage not merely to Plaintiff's goodwill alone. It may cause injury to various students who may be enrolled and studying in said school. Therefore, as it was not even in the larger public interest to permit Defendants to use the mark 'The British School', the application under Order XXXIX Rule 1 and 2 of CPC was allowed and the Court directed the Defendant to change the names of their schools.

ML Brother LLP vs. Maheshkumar Bhuralal Tanna

Forum: High Court of Delhi

Case No.: CS(COMM) 126/2022 & I.A. 3037/2022

Order Dated: 12th May 2022

Issue: Whether the report of a Local Commissioner can be treated as evidence in the suit where it is not challenged by any party?

Order: The Plaintiff was seeking to protect its mark ‘UBON’ and its variants under classes 9 and 44, with its first registration dating back to the year 2008 with a user claim from 2005. In March 2018, the Plaintiff came to know about an application filed by the Defendant for the mark ‘UBON THAI SPA’ in class 44 and it also came to know that the Defendant had three spas in Goa under the impugned mark. Thereafter, the Plaintiff filed the present suit. On 23rd February 2022, an *ex parte ad interim* injunction was granted in favour of the Plaintiff, restraining the Defendant from using the infringing mark. Thereafter, by the said order, a Local Commissioner was also appointed to visit the Defendant's premises in Goa. The Local Commissioner visited the three premises of the Defendant in Goa, and filed a report as per which, the Defendant had sold the spas to one Mr. Vansh Chandra and Mr. Chandra had agreed to remove the mark ‘UBON’ from the hoardings and replace the name ‘UBON’ with another mark. Despite adequate service of the report on the Defendant, the Defendant did not file the written statement within the stipulated time and the matter proceeded *ex parte*.

The Hon’ble Court held that the Plaintiff is the registered owner of the marks ‘UBON’, ‘UBON PLANET’ and ‘UBON PRIME’ since 2008 and that the word ‘UBON’ was adopted by the Plaintiff in 2005. In terms of the report submitted by the Local Commissioner, the Court opined that the person Mr. Vansh Chandra who bought the spas from the Defendant did not wish to contest the matter as he had agreed to change the name from ‘UBON’ to some other name and moreover, the application filed for the registration of the mark ‘UBON THAI SPA’ had been abandoned by the Defendant.

Lastly, the Hon'ble Court observed that Order 26 Rule 10(2) CPC stipulates that the report of the Commissioner and the evidence taken by the Commissioner shall be evidence in the suit and shall form part of the record. Furthermore, it relied on the case of *Levi Strauss & Co. v. Rajesh Agarwal* wherein it was held that once the Commissioner has filed the evidence along with his report, it becomes evidence in the suit itself and that examination of the Commissioner is not mandatory. Therefore, the Hon'ble Court, in view of Order 26 Rule 10(2) CPC and the above judgment, opine that the settled legal position is that the report of the Local Commissioner can be treated as evidence in the suit where it is not challenged by any party and hence, in the present case, the report of the Local Commissioner and the contents therein could be relied upon by the Court as evidence as the same was left unchallenged.

Aqua Pump Industries, Rep. by its Managing Partner Mr. Ramaswamy Kumaravelu and Another vs. Subhash Chandra Jain

Forum: High Court of Madras

Case No.: C.S. No. 509 of 2005

Order Dated: 8th June 2022

Issue: Whether the Plaintiffs are the registered proprietors of the Trade Mark “TEXMO”?

Order: In this case, the Plaintiffs contended that they were manufacturers of different types of electrical motors and pumps since 1st April 1974 and that since then, they have been extensively using the Trade Mark “TEXMO” all over India in respect of the abovementioned goods. Due to this they have acquired enormous goodwill under their mark and if any person uses the same mark in respect of those goods or other related goods, the public would be confused regarding the identity of the goods and its source. However, it put forth that the Defendant had adopted a deceptively similar Trade Mark TEXIMO solely for the purpose of exploiting the commercial goodwill of the Plaintiffs and that it knew very well the quality of pumps and motors manufactured and marketed by the Plaintiffs using the Trade Mark TEXMO. Therefore, the Plaintiff had filed for permanent injunction against

the Defendant, contending that it was a calculated attempt to infringe the Registered Trade Mark of the Plaintiffs and pass off the Defendant's goods as the goods of the Plaintiffs.

The Court as well as the learned counsel for the Plaintiff noted that they had taken various steps to serve notice on the Defendant, but the Defendant neither represented nor filed vakalat on behalf of them, hence the Defendant was set ex parte. On perusal of the documents submitted by the Plaintiffs, the Hon'ble Court opined that it was made clear that the Plaintiffs are the registered proprietors of the Trade Mark "TEXMO" and they have been using said trademark in their products even prior to the year 1999. In the absence of any oral or documentary evidence on the side of the Defendant to show that the Defendant has not supplied any goods or materials using the similar Trade Mark "TEXIMO" in their products, the Court held that the Plaintiffs have proved their suit claim and they are entitled to the relief of permanent injunction against the Defendant.

MakeMyTrip India Private Limited vs. Booking.com B.V. and Ors.

Forum: High Court of Delhi

Case No.: CS (COMM) 268/2022 and I.As. 6443-47/2022

Order Dated: 27th April 2022

Issues:

- (i) Whether bidding on a registered trademark as a keyword through the Google Ads Program constitutes infringement and passing off?
- (ii) Whether allowing non-owners to bid on a registered trademark as a keyword is justified if it takes advantage of the trademark's distinctive character and reputation?
- (iii) Whether using a registered trademark as a keyword in the Google Ads Program constitutes misrepresentation?

Order: Plaintiff sought permanent injunction to protect its registered trademark 'MakeMyTrip' and its variations. Plaintiff owns the domain name www.makemytrip.com since 2000 and is the registered owner of the trademark in various classes. The Plaintiff states that the first result on

searching 'MakeMyTrip', which is its registered trademark, is Booking.com. Therefore, the said action should constitute infringement. Defendant used the trademark 'MakeMyTrip' as a term on Google Ads Program, despite Plaintiff's notices to stop bidding on the keyword. Plaintiff approached the High Court seeking relief from Defendant's conduct. Defendant No. 1 is an online travel portal, comparable to the plaintiff. The respondent relied on the European Commission case ("Guess decision") to argue that there can be no restrictions on rivals' use of a trademark as a term in the Google Ads Program. Defendant state that generic phrases like make," my,' and 'journey' are acceptable under Sections 34 and 35 of the Act

Delhi High Court held that the use of a registered trademark as a keyword on Google Ads Program for advertising purposes is a violation of the Trademarks Act and constitutes passing off. The court held that competitors cannot encash on the reputation of the plaintiff's mark for their monetary advantage, and the balance of convenience lies in favour of the plaintiff. The court rejected the defense that there is no infringement if there is no visible use of the mark, stating that the "invisible" use of a mark as a keyword can constitute passing off. The proprietor of the mark has the right to book its own trademark for advertising purposes. The court also cited previous cases, such as MakeMyTrip vs Happy EasyGo India and MakeMyTrip vs Easy Trip Planners, where competitors were restrained from bidding for keywords identical or deceptive variants of the plaintiff's mark. Court also stated that this shall not prevent the Defendants from using words 'make', 'my', 'trip' not conjunctively on a standalone basis in a descriptive or generic sense on the Google Ads Program. The Court also clarified that this injunction would only apply within the territory of India. The Court reserved judgment on whether the plaintiff would be entitled to an injunction against the use of the mark 'MMT', which is registered in its favour.

Blue Heaven Cosmetics Pvt. Ltd. vs. Shivani Cosmetics through its Partners Vinod Monga Nishant Monga

Forum: High Court of Delhi

Case No.: CS(COMM) 702/2021 and I.A. 17434/2021

Order Dated: 18th May 2022

Issue: Whether the Defendant has infringed upon the Plaintiff's marks "BLUE HEAVEN" and "BLUE HEAVEN GET BOLD" and the trade dresses of the products bearing these marks?

Judgement: The present suit was filed by the Plaintiff seeking permanent injunction restraining infringement of registered trademark, trade dress, copyright, writing style, colour combination etc. The Plaintiff - M/s. Blue Heaven Cosmetics Pvt. Ltd. is engaged in the business of manufacturing and sale of cosmetics and other allied goods. It is the case of the Plaintiff that the Defendant had infringed the rights of the Plaintiff in the registered marks "BLUE HEAVEN" and "BLUE HEAVEN GET BOLD" (word as well as formative marks), which it had been using from 1972 and 2020 respectively. By order dated 23rd December 2021, an *ex parte* ad interim injunction was granted, restraining the Defendant basis the observation that the Defendant copied not only the trademark but also the trade dress/ copyright/ writing style/ colour combination/ label/ packaging/ overall get up of the Plaintiff's mark.

In the present case, despite service being affected, no one appeared for the Defendant. The counsel for the Plaintiff submitted a letter it had received from the Defendant wherein it provided that it was willing to take down the boxes of its products which were considered infringing. The Court observed that this showed that service had been affected properly. This Court has also perused the competing products of the Plaintiff and the Defendant which have been handed over to the Court. A perusal of the same shows that the Defendant's products have a packaging that is virtually identical to that of the Plaintiff. The Court was convinced that the Defendant's product was nothing but a counterfeit of the Plaintiff's product, though the mark 'CANDY' was being used in place of the Plaintiff's mark 'BLUE HEAVEN'. However, in the opinion of this Court, the same was not sufficient to distinguish the Defendant's product from the Plaintiff's product. Considering that these are eyeliners and are used by the consumers on their eyes, the standard of quality that is expected in this regard is quite high, and counterfeits/knockoffs cannot be encouraged.

The Plaintiff also submitted that the Defendant's products did not appear to be approved by the Drugs Controller General of India, as no manufacturing dates have been mentioned on the packaging of the Defendant's products. Thus, due to the abovementioned factors and the fact that the Defendant chose not to appear despite service being affected, the Court agreed with the Id. Counsel for the Plaintiff that the Defendant's product was liable to be permanently enjoined from being manufactured and sold and passed the order in this respect.

Geoscope Exim Private Limited, Rep. by its Senior Manager/Authorized Signatory Mr. V. Prakash vs. SNJ Distillers Private Limited and Another

Forum: High Court of Madras

Case No.: O.A. No. 94 of 2022 and Civil Suit(Comm. Div.) No. 27 of 2022

Order Dated: 8th June 2022

Issue: Whether all aspects of the trade dress should be compared from the perspective of a potential consumer of average intelligence and imperfect recollection in a passing off suit?

Order: The Plaintiff, a company involved in the business of manufacturing liquor, applied for an interim injunction restraining alleged passing off by the Defendants due to use of the mark HOBBS which was considered deceptively similar to its mark HOBSONS. The Plaintiff stated that it adopted the mark HOBSONS for brandy in the year 2011, has been using the mark continuously and extensively since then and that it had it registered in class 33 since 23rd September 2010. In January 2022, it came to know about the Defendant using the mark HOBBS for the same goods and it contended that the impugned mark is holistically similar to the Plaintiff's registered mark. Furthermore, it emphasised on the retail sale environment for alcoholic drinks in the State of Tamil Nadu and pointed out that the likelihood of deception and confusion being compounded by the fact that consumers do not have access to the shelves on which the products are displayed and that the purchase is made by requesting for the product at the counter. On the other hand, the Defendants argued that its mark has been

registered in class 33 since 15th September 2020 and stated that the marks HOBSONS and HOBBS are not phonetically, visually or structurally similar. It drew attention to the trade dress of the Plaintiff's product in comparison to the Defendants' product, stating that a consumer of average intelligence and imperfect recollection would not be deceived as the Plaintiff's product is sold in an orange carton, which is much taller and the label on the bottle is completely different in comparison to the label on the Defendants' bottle. The Defendants point out that the label on the Defendants' bottle is predominantly black with a white and gold diagonal stripe running across the said label and that even the device, which is placed above the mark HOBBS, is different. The Defendants further stated that its products are sold to TASMAC and not to customers and, therefore, there is virtually no scope for deception or confusion.

The Hon'ble Court observed that as the Defendant's mark is registered, a suit for passing off has been filed by the Plaintiff, and that although the products i.e., brandy are identical, the marks itself are not particularly identical, an action for passing off is dependent on the likelihood of deception and, therefore, the two marks and the trade dresses should be examined from that perspective. The Court relied on judgments such as *Dongre and Cadila Healthcare* which instruct uniformly that the likelihood of deception should be tested from the perspective of a consumer of average intelligence and imperfect recollection. When viewed holistically for interlocutory purposes, the Court agreed with the differences in the bottles and labels as set out by the Defendant above. It opined that these differences would be readily noticeable even to an average consumer making the purchase in the unique retail environment that prevails and said that although there is some similarity between the two registered word marks, HOBSONS and HOBBS, but such similarity should be balanced against the fact that the word mark HOBBS is registered. The fact that the two products are sold at different price points is an additional factor that worked in the Defendants' favour. The Hon'ble Court held that the Plaintiff had failed to make out a case which warrants an order of interim injunction, but the Defendants were directed to maintain separate accounts of revenue and profit earned from the sale of alcoholic beverages with the impugned mark.

Cable News Network INC vs. Fayyaz Shaikh and Another


Forum: High Court of Delhi

Case No.: CS (COMM) 135/2021 and I.A.4459/2021

Order Dated: 19th May 2022

Issue: Whether the Defendant has infringed upon Plaintiff's well known 'CNN' mark?

Order: The present suit has been filed by the Plaintiff - Cable News Network, Inc., a company based in USA, involved in the broadcasting/production of an English news channel under the name/mark

/CNN'. The case of the Plaintiff is that the said news channel 'CNN' was launched in September 1985 and since 1989, the news channel 'CNN' has been available for viewers in India as well. The Plaintiff contends that its television channel 'CNN' was the first private television channel which was allowed to be broadcasted on an Indian Satellite and that its mark 'CNN' has been protected by the Plaintiff by filing various proceedings. Furthermore, it put forth that it has several trademark registrations in India for the mark 'CNN', since the year 1999, in several classes. In March 2021, the Plaintiff came to know that the Defendants had started running a news channel running under the name 'CNN News Khabar Update Marathi' and were also running YouTube Channels and were promoting the mark 'CNN' on social media. in view of the identical use of the mark 'CNN' by the Defendants for an identical service i.e., news service on the internet, the present suit was filed by the Plaintiff, and in lieu of which, an *ex parte ad interim* injunction was granted against the Defendants. Thereafter, the Defendants were served in the matter, however, till date there has been no appearance on behalf of the Defendants and no written statement has been filed.

Attention was brought to the judgment *Cable News Network, Inc. v. Anshu Jain (Anim Desire Private Limited)*, wherein the Plaintiff's rights in the mark 'CNN' had been previously upheld by the Court and wherein, the mark 'CNN' has also been declared as a well-known mark. Therefore, in

view of the same, the Hon'ble Court held that the use of an identical mark for identical services by the Defendants was a clear infringement of the Plaintiff's rights in the 'CNN' mark. The Court elaborated that even if the name of the Defendants' network was City News network, the use of the abbreviated form 'CNN' would be impermissible owing to the well-known nature of the Plaintiff's mark which was globally well known in the field of news dissemination and media related business. Thus, the Hon'ble Court opined that the present suit is a fit case for grant of a permanent injunction against the Defendants from using, broadcasting, telecasting any news or any other program under the mark 'CNN' and using the mark 'CNN', in any manner, with or without any suffix or prefix for any goods or services which are cognate and allied to the Plaintiff's news services or other related services.

Dr. Reddy Laboratories Limited vs. Controller General of Patents Designs and Trademarks

Forum: High Court of Delhi

Case No.: W.P.(C)-IPD 4/2022, Review Pet. 102/2022, W.P.(C)-IPD 88/2021, W.P.(C)-IPD 103/2021, W.P.(C) 1907/2022 and CM APPLs. 5485/2022, 11118/2022, 12729/2022

Order Dated: 9th September 2022

Issues:

- (i) The first issue pertains to a review application filed by officers of the CGPDTM regarding an order from March 21, 2022. The officers are seeking a review of the order, which imposed a Rs. 1 lakh cost on each officer for lapses in communicating incorrect facts to the Court.
- (ii) The second issue concerns a large number of oppositions that are currently pending and ripe for hearing in the CGPDTM office.

Order: Officials in the CGPDTM had filed affidavits explaining why the Court was not informed about over 7000 oppositions filed and taken on record beyond the period of limitation. The Court observed a clear lack of communication among the officers, conflicting notices, and a lack of

understanding of the Supreme Court's orders regarding extension of limitation periods during the pandemic. The officers claimed that they were not in the CGPD TM in the capacity of hearing officers and were unaware of oppositions being accepted beyond the limitation period.

Considering the affidavits, the Hon'ble Court clarified that the lapse in communication regarding oppositions filed beyond the period of limitation shall be treated as an overall lapse of the CGPD TM office and not of individual officials. The cost of Rs. 1 lakh imposed on each officer will stand, but the Controller General will decide whether the costs will be deposited by the office or by individual officers. The procedure for handling cases where registration certificates have been issued but oppositions have been filed or may be filed by 30th May 2022, has been outlined in an affidavit. The office of the CGPD TM would suspend the registration certificate upon receiving an opposition, and the opposition petition will be processed according to the law. If the opposition is allowed, the registration certificate will be cancelled, and the digital record updated accordingly. If the opposition is dismissed, the suspension of the registration certificate will be revoked, and registration will be restored in the e-Register.

The CGPD TM was ordered to place Hearing Officers in various offices within the next eight weeks. A status report on the progress of hearings and recruitment of officers for pending oppositions must be filed by the CGPD TM and presented to the Court at least one week before the next hearing.

Lastly, In W.P.(C)-IPD 103/2021, the Court stated that Court's order on 21st March 2022, addressed trademark applications whose oppositions were rejected due to being filed beyond the limitation period, which was contrary to the extension of the limitation order passed by SC during the pandemic. The order stated that any opposition filed pursuant to the order would be decided on its own merits. The filing of the opposition and suspension of the registration certificate would not affect the dispute between the parties in the suit and appeal, as the opposition was allowed to be filed on technical grounds and not on merits. The opposition proceedings would proceed in accordance with the law and will not affect any other disputes pending between the parties and status report dated 7th September 2022, has been

filed indicating the appointment of officials for hearing opposition matters, with priority given to older matters.

Cipla Limited vs. Sun Pharmaceuticals Industries

Forum: High Court of Madras

Case No.: 1980, 1982, and 1983 of 2021 and 1949 of 2021

Order Date: 26th May 2021

Issue: Whether the ad-interim order should be allowed in favour of plaintiff on the grounds of passing off, trademark and copyright infringement when there is an ongoing pandemic?

Judgement: The plaintiff filed a suit seeking a permanent injunction against the defendants for infringing their mark “Respule” which they are using since 2013. The plaintiff contends that the defendants are illegally using the mark “Respule” and have attempted to pass it off by imitating the artistic trade dress, packaging, and label. The court passed an interim order restraining the defendants from using the mark. In response to that the defendants have filed three counterstatements seeking to vacate the interim order stating that the products under the alleged infringing mark had already been stocked due to an unprecedented medical emergency.

The defendants further state that they have manufactured products valued at approximately Rs. 1.5 Crores to 3.5 Crores and they shall be allowed to sell in the market and the defendants would adopt a new packaging which will be absolutely different from the one they are using. They further state that since these medicines come with expiry and the defendants should be allowed to sell them as these medicines are required for the treatment of Covid- 19 symptoms and the defendant is one of the companies which is required to report the sale of stock to the Union Health Ministry.

The court is of the opinion that it cannot allow a party to violate another person’s Intellectual property and remain a mute spectator where there is an

attempt to pass off the goods in the market notwithstanding fact that the country is facing an unprecedented medical emergency and possibly the patients suffering from Covid symptoms require the drugs manufactured both by the plaintiff and the defendant for treating patients with respiratory ailments during these tough times. The court observed that the defendants has copied the packaging of the plaintiff to take advantage of the unprecedented demand for this particular drug in the market during Covid-19 and make a quick profit. The court further stated that if the defendants are allowed to sell the medicines in the market, then it will result in incalculable damage to the proprietary rights of the plaintiff and will dilute it.

Hence the court held that the applications filed by the defendants for the vacation of the interim orders should be dismissed and the interim injunction shall continue.

Dabur India Limited and Ors. vs. Ashok Kumar and Ors.

Forum: High Court of Delhi

Case No.: CS (COMM) 135/2022 I.As 3423/2022.

Order Dated: 27th March 2023

Issue: Whether the court will grant relief to the plaintiff for permanent injunction in its favour in the case of fraudulent websites using their well-known marks?

Order: Two suits were filed after discovering that several fraudulent websites bearing Plaintiffs' well-known marks 'AMUL' and 'DABUR' are soliciting business from vulnerable customers. Various domain names and websites, which were operating with the name DABUR such as www.daburdistributor.com, & <https://daburdistributorships.in>. Monies were being collected from vulnerable customers through the said websites. The Court found that the use of the well-known trademark 'DABUR' on fraudulent websites was illegal and harmful to the Plaintiff's legal rights. The attempt to impersonate the Plaintiff by using their trade dress, labels, logos, and product packaging was not just infringement and passing off but

complete impersonation. The Court granted an ex-parte injunction as it found a prima facie case that irreparable loss would have been caused to the Plaintiff due to these activities.

The Court directed the defendants to immediately block and cease all use of infringing domain names and websites bearing the mark 'DABUR'. They are also restrained from allowing any third-party apart from the plaintiff to register domain names using the mark/name 'DABUR'. The plaintiff is permitted to implead the registrants of the infringing domain names as defendants, and permitted to approach the court for appropriate relief in case it comes across any other infringing domain names or websites.

This Court in its Previous Order Stated and emphasized the need for stringent measures to curb the misuse of well-known marks and business names in illegal domain name registrations. The MeitY and ICANN had been approached to act against non-compliant DNRs, and MeitY has suggested that non-compliance with court orders can be considered a violation of public order under Section 69A of the IT Act.

The court is considering how to enforce injunction orders in cases of infringing domain names, considering the views of MeitY and applicable laws. The issue raises questions about how to enforce court orders when DNRs only recognize orders from competent courts in their own jurisdiction.

Havells India Ltd. vs. Panasonic Life Solutions India Pvt Ltd. And Another

Forum: High Court of Delhi

Case No.: CS(COMM) 261/2022 & I.A. 6259/2022, 7226/2022

Order Dated: 31st May 2022

Issue: Whether a Composite Suit Seeking relief for Design Infringement and Passing off can be filed by the Plaintiff?

Judgement: This design dispute stems from the deceptive similarities between the designs of fans used by both the parties. The Plaintiff in 2016 acquired a design registration for its Enticer series of Ceiling Fans. In 2022 the defendant released a catalogue showcasing its Venice Prime Series which were deceptively similar to the Plaintiff's fans design. The court relied on the Judgement of *Mohan Lal, Proprietor of Mourya Industries v Sona Paint and Hardwares (2013 SCC Online Del1980)* which stated that the design registration is not liable to be cancelled if the same goods are used as an unregistered trademark. The Designs Act only prohibits the registration of registered designs as trademarks and not merely their use as a trademark.

The court further relied upon the case of *Carlsberg Breweries A/S v Som Distilleries and Breweries Ltd. (2018 SCC Online Del 1292)*, in the present case it was held that a composite suit for passing off and design infringement is maintainable “as long as the elements of the design are not used as trademark, but a larger trade dress get up, presentation of the products through its packaging and so on.”

However, in the present case it is observed that the plaintiff has failed to make out a case of passing off as the court found out that the ornamentation on both the fans were not similar enough to deceive the average customer.

As regards the issue of the design infringement, it was observed by the court that there is a prima facie case of infringement under section 22 of the Design Act, 2000. The court relying on *Whirpool of India v Videocon Industries Ltd. (2014 SCC OnLine Bom 565)* observed that the test of design infringement is to look at the given designs from the perspective of the average viewer. The defendant's fan design was not identical but entailed enough resemblance with the plaintiff's fan design. Hence the court found a prima facie case in the favour of the plaintiff and the court passed the order of interim injunction restraining the defendants and its agents, dealers,

retailers, representatives, assignees etc. from manufacturing, marketing, selling or using design 2016 and Design 2020 in any manner for their “Venice Prime” series of fan.

Hell Energy vs. Kriti Karki Trading and Anr.

Forum: High Court of Delhi

Case NO.: C.O.(COMM.IPD-TM) 7/2022

Order dated: 1st June 2022

Issues: Whether the marks Hell Energy and Hell Rock would be considered identical and deceptively similar?

Judgment: There were four cases filed relating to the trademark “Hell”. The plaintiff is in the business of manufacturing and sale of energy drinks under the brand names “Hell” and “Hell Energy”. The trademark for the same has been registered in various countries under class 32 including India since 2017. An exclusive distributorship agreement was signed between the plaintiff and the Jes & Ben Group, but the said agreement was terminated in 2019 but it is seen that the defendants kept on using the trademark even after the termination of the agreement. In 2020 an interim injunction was passed in the case of *Hell Energy v Jes & Ben Group* which restrained the defendants from using the disputed trademark. The Interim injunction was granted against the Defendants on the grounds that the plaintiff has made a prima facie case as the defendants kept on using the trademark in an unauthorised manner and the balance of convenience is also in the favour of the plaintiff.

In 2019 it came to the notice of the plaintiff that the defendant has filed for the trademark of ‘Hellrock Energy’ and has started manufacture and sale under the same. The said mark was opposed by the plaintiff on the grounds that both the marks are identical and deceptively similar. In April 2022 the defendants agreed to change the mark and made the submission that they do

not intend to use “Hell”, “Hellrock”, “Hell Rock Energy” or any other trademarks but they intend to use “Heyrock”, however the exact packaging and colour scheme has not been yet disclosed. Hence while permitting the defendants to use the mark “Hey Rock” it is directed that the defendants shall ensure that the said packaging, colour combination, trade dress etc are to identical to that of plaintiff. In furtherance, to the directions given in CS(COMM) 43/2020, the defendants also agreed to transfer the mark “Hellrock” to the petitioner. The defendants were prohibited from manufacturing and selling the new products under the disputed marks and the existing stock of products shall be exhausted within 3 Months. In addition to the above reliefs the domain name www.hellrockenergy.com was ordered to be transferred to the plaintiff. In furtherance, the defendants were directed to pay Rs. 5 Lakhs as costs to the plaintiff

Sudhir Bhatia Trading as vs. Bhatia International v Central Govt. of India

Forum: High court of Delhi
Case No.: W.P. (C)-IPD 37/2021
Order Dated: 19th May 2022

Issues: Whether merely writing letters or making representations would give sufficient ground to a party to seek condonation of delay?

Judgment: In the current case, the petitioner requested a writ of certiorari to nullify the advertisement for a Class 5 application for the registration of the trademark LAXMAN REKHA (label) filed by Midas Hygiene Industries (P) Ltd./respondent 3 and a further directive to the Registrar of Trade Marks to re-advertise the application.

The facts of the case are such that the trademark of Respondent No. 3 was advertised in the journal and was totally black and illegible. The Petitioner approached the Registrar of Trademark requesting him to re-advertise the mark and this was followed by reminder letters requesting the Registrar to

take action under Section 57(4). Subsequently, a legal notice was sent to Respondent 2 seeking a grievance relating to illegible advertising.

The Petitioner contended that the Registrar failed to appreciate the purpose of advertising the application by not rectifying and not re-advertising the mark again. Next, he contended that the registrar also failed to appreciate the scheme of the act as since the application was not advertised properly, the Petitioner was unable to file for opposition within 4 months of advertisement. The Respondents contended that around 17 years have elapsed since the advertisement the court should not direct the same to be re-advertised as registration has been granted to him bestowing his statutory rights under section 28(1) of the act. Respondent further contended that the advertisement was published at the time when the printing was outsourced and whenever there were errors in the journal it was corrected through rectification. And is stated by the respondents that the advertisement is proper and readable although the background may be slightly dark.

The Court after going through all the contentions observed that the Petitioner had knowledge about the registration of mark since 2006 and even then, the writ petition was filed after a delay of 2 years and stated that the court would not assist those who are lethargic and indolent. The court further stated that the petitioner after the registration of the trademark would've filed for rectification for the cancellation of the said mark, which a remedy available under section 57 of the Act but instead filed for a writ petition. The court further held that the petitioner took no action except to file for repeated reminders with the Registrar and hence the court was not persuaded to exercise the writ jurisdiction in favour of the Petitioner.

Netsweeper Inc., Rep. by its authorised signatory Mr. N. Krishnan vs. Netsweeper Technologies Private Limited and Others

Forum: High Court of Madras

Case No.: Civil Suit (Comm. Div) No. 334 of 2018

Order Dated: 8th June 2022

Issue: Whether the Plaintiff is entitled to claim damages for passing off of its products or software by the Defendant Nos. 1 to 6, and if so, whether the amount of INR 1,00,00,000/- as damages is reasonable and justified?

Judgement: Plaintiff states that it is company incorporated in the year 1999 under the laws of Ontario, Canada engaged in Internet content filtering and web threat management solutions, has developed an AI-based software to manage internet activity globally. According to the Plaintiff, the trademark 'NETSWEEPER' was registered by the Plaintiff under classes 9 and 42 in Canada and USA in the year 2003 and 2006, respectively and is in the process of applying for registration of the said trade mark in India.

The Plaintiff filed a Civil Suit under Order VII Rule 1 of the Civil Procedure Code, 1908, along with Order 4 Rule 1A of the Original Side Rules and Section 134(1)(C) of the Trademarks Act, 1999, seeking INR 1,00,00,000/- (Indian Rupees one crore only) as damages from Defendant Nos. 1 to 6 for passing off their products or software as the Plaintiff's products or software by wrongfully associating themselves with the Plaintiff and/or its affiliates. As well as permanent injunctions to restrain the Defendants from infringing the Plaintiff's trademarks or similar names. The Plaintiff also seeks payment of outstanding invoices with interest at 18% per annum and an order for the Defendants to surrender all materials bearing the Plaintiff's trademark. Finally, the Plaintiff seeks a preliminary and final decree for the Defendants to account for all revenues made through use of the Plaintiff's trademark, and an order for the Defendants to pay service tax debts owed to the Government of India.

The Court on examining the plaint, proof affidavit found that the plaintiff is the registered proprietor of the trademark in Canada and the USA and

granted relief to the plaintiff for some of their prayers but denied others due to a lack of evidence. The defendants were ordered to pay the plaintiff a sum of INR 3,00,000 (USD 3,654) as costs, including court fees and lawyer's fees.

Vikas Jain vs. Aftab Ahmed and Ors.

Forum: High Court of Delhi

Case No.: CS (COMM) 384/2018

Order Dated: 25th May 2022

Issue 1:

- Whether the Plaintiff is the proprietor of the registered design?
- Whether the plaintiff's design registration is liable for cancellation on grounds of it lack novelty and originality?

Judgment: The case is brought by the Plaintiff alleging that the Defendant was infringing their registered design “Boom Scooty” and imitating the various features of the same including the shape, configuration and arrangement of the features

The Court state that the averments made by the Plaintiff hold strong grounds and it is understood by the evidence present on record that the Defendants have started manufacturing and selling the scooters using the infringing design and hence an ex parte injunction has been issued against the Defendants restraining them from manufacturing, selling, offering for sale, directly or indirectly dealing in toy scooters which identical or deceptively similar.

The injunction order was confirmed vide a detailed judgment on 4th July 2007, where the court stated that the plaintiff is able to establish a prima facie case and the balance of convenience is also in the favour of the

plaintiff. The defence was taken by the defendants that the prior publication cannot be substantiated by any evidence.

The Defendants challenged the validity of the design of the Plaintiff under section 19 of the said act. It was contended by the defendants that the designs were prior published. It was observed that the cancellation petition has since not decided, hence the Division Bench directed the suit to be listed for the final hearing. The matter was listed on 8th march, 2022 for hearing but the plaintiff was not present. On 16th March 2022 the counsel for the Plaintiff stated that they are not able to contact the plaintiff for their directions. It is observed by the court that during the pendency of the current suit, the design registration has lapsed and the same has fallen into the public domain in 2019. After the grant of the *ex parte* injunction, the Defendants have not manufactured any scooter. The injunction has operated from 2005 till date i.e 18 years. Therefore, the court held that since the prayer, in this case, is for permanent injunction and the injunction order has operated for the entire time till the lapse of the registered design the suit no longer needs to be continued. The suit has become infructuous, and it is stated that the court has not gone into the merits of the case.

Vishal Pipes Limited vs. Bhavya Pipes Industry

Forum: High Court of Delhi

Case No.: FAO-IPD 1/2022 & CM APPLs. 12-14/2022

Order Dated: 3rd June 2022

Issue 1: Can IPR suits be valued below Rs.3 lakhs and be listed before the District Judges who are not notified as Commercial Courts?

Issue 2: Whether the provisions of CCA would be applicable to such disputes?

Judgment: The present case is an appeal challenging the order dated 28th January 2022 passed by ADJ of the Patiala House Court, New Delhi for

seeking permanent injunction against infringement of registered trademark and copyright for usage of trademark “BPI” which is stated to be similar to the plaintiff’s trademark “VPL India”. The plaintiff contends that the ADJ refused to grant an ex parte order of injunction and also failed to appoint local Commissioner for seizure of the alleged infringing goods. The Court observes that the order is passed by the ADJ who is not designated as commercial court and raised the question whether the District Court who is not designated as a Commercial Court can hear IPR matters in view of the Commercial Courts Act and Trademarks Act. The question is whether IPR suits filed before District Courts valued below Rs. 3 Lakhs ought to be adjudicated by District Judges as normal civil suits.

The contentions of the Plaintiff state that their numerous cases of IPR which are valued below INR 3 Lakhs are placed before the ADJ for adjudication and various orders regarding the same are attached. The plaintiff further states that the definition of the specified value in section 2(c)(xvii) read with section 12 provides for determination of specified value and in view of these provisions it is stated that any suit valued below 3 Lakhs cannot be adjudicated by Commercial Courts.

Submission of Sr. Counsel states that the specified value under the CCA cannot be ignored. However, since in Delhi the pecuniary Jurisdiction of District Courts is Rs. 3 Lakhs same also matches with the specified value for the commercial disputes at the district Court level. This shows that both the District Judges commercial and non- commercial have subject matter jurisdiction over IPR disputes, but neither has the requisite pecuniary jurisdiction as the jurisdiction even for ordinary civil suits starts at Rs. 3 Lakhs.

The counsel for the Defendants contends that the specified value should not be given utmost importance to control the jurisdiction of the Commercial Court itself. Hence it is said that the IPR statutes and the CCA must be

harmoniously construed. In conclusion the counsel states that commercial disputes especially IPR disputes irrespective of their valuation should be tried and decided by a District Court which is designated as Commercial Courts.

Another counsel for the Defendants looked into the definition of the Commercial Disputes and states that Section 2(c)(xvii) includes dispute arising out of IPR. Hence, he concludes all IPR suits are commercial disputes. The next contention raised by him was with regards to the jurisdiction of IPR suits. Before the enactment of the CCA, Section 9 of the CPC stated that all civil suits can be tried by the civil courts. Thus, IPR suits irrespective of their valuation could only be filed before the district court and not before the Sub- Judges, Civil Judges, etc. after the CCA came into picture there came in to forums namely District Judges/ ADJ at the district level and Commercial division of the High Court. Now the District Judges act in both a Commercial Courts and Non- Commercial Courts.

Next the counsel for the defendants brings in the minutes of the Meeting of the State Court Management Systems Committee. The decision of this committee states that question as to whether a trademark suit can be valued below INR 3 Lakhs (USD 3,653) ought to be left to be decided on the judicial side by the District Court. The court is of the opinion that this decision may not have been uniformly implemented in District Courts and thus even till date there are IPR disputes that are being adjudicated by District Judge non-commercial. According to the Judge, it would be necessary for IPR lawsuits to have a "specified value"; otherwise, if the Court finds that the plaintiff's valuation of the case is arbitrary or capricious, it should step in.

The Hon'ble Court is of the opinion that "The subject matter of IPR disputes is typically trademarks, rights in copyrightable works, patents, designs, and such other intangible property," which is why it established the threshold of

INR 3 Lakhs (USD 3,653) for "Specified Value" in Commercial Cases. The government believes that the specified threshold of INR 3 Lakhs (USD 3,653) is the lowest sum in any "commercial dispute" in India that qualifies for faster resolution as a result of the nation's economic development. The Legislature's aim in maintaining a lower threshold of INR 3 lakhs (USD 3,653) for a "commercial dispute" cannot be made meaningless. The valuation of IPR issues below INR 3 lakhs (USD 3,653) may only be justified in extreme circumstances.

Hence the court made it clear that litigants as well as lawyers cannot escape the provisions of the CCA by valuing the suits below INR 3 Lakhs (USD 3,653). All IPR suits which were to be instituted in a District Court will first be instituted before District Judge (Commercial). In lieu of this the Court has issued the following instructions:

- The Court should analyse the substantive remedy requests and look into the accusations in the plaint. No frivolous valuation is accepted.
- A suit's valuation must be sufficient and reasonable. The plaintiff is not allowed to undervalue the relief arbitrarily or intentionally. The plaintiff must make a sincere attempt to calculate the remedy.
- If the plaintiff's value is arbitrary or unjustified, the court may reject it, offer the plaintiff a chance to fix it, or dismiss the complaint.
- When there are affirmative materials or objective norms of valuation of the remedy, the plaintiff cannot arbitrarily pick a ludicrous amount for initiating the complaint.
- The claimant must provide specific justifications for not knowing the exact value of the remedy. The plaintiff's discretion would become arbitrary if a precise value was not performed based on some fundamental standards.
- By reading these directions it can be understood that all IPR suits will be instituted before District Judge (Commercial) and in case if any suit is valued below Rs. 3 Lakhs the plaintiff will be given the

choice to amend the plaint or proceed further with non- commercial suit.

Proklean Technologies Pvt. Ltd. vs. Godrej Consumer Products Ltd.

Forum: High Court of Madras

Case No: O.A. Nos.71 & 72 of 2022 in C.S. (Comm Div) No.22 of 2022

Order Dated: 9th June 2022

Issue: Whether the defendants can be restrained from using the mark 'ProKlean' as the plaintiff has been using the mark 'ProKlean' from 2010?

Judgment: Plaintiff has its word mark "ProKlean" registered since 17th June 2010 for class 3 goods described as cleaning preparation within the Southern Indian Territory. It came to the notice of the plaintiff that the defendants have been using a similar mark "ProClean" in relation to the floor cleaning products. Hence before filing this suit the plaintiff issued a Cease-and-desist notice, but such notice did not elicit an appropriate response. With regards with the disclaimer with respect to the territorial limits the plaintiff submits that it was accepted in 2010 as he was not advertising the products outside South India at that time. But now the Defendant is advertising it in the whole of India and contends that he is entitled to the interim order prayed for in these applications.

The Defendants contended that the plaintiff has not produced any proof of sales turnover or advertising expenditures. The Defendants relied upon the principle of prosecution history estoppel and contended that an estoppel operates against the applicant because in response to the objections of the Trademark Registry the applicant asserted that 'Preclean' with the letter 'K' is distinct from 'ProClean' with the letter 'c'. Consequently, the defendants cannot contend otherwise upon noticing the respondent's product, which is 'ProClean' with the letter 'C' instead of the letter 'K'. The defendant further

contended that the two marks should be looked at as a whole and, if so examined, the products are easy to differentiate because the respondent uses the distinctive and well-known prefix 'Godrej'. The defendant further contended that its products are chemical based, whereas the applicant's products are organic.

The Defendants further contended that the objections were raised by the Trademark Registry in the year 2014 when the application for "ProKlean" was prosecuted. He states that the plaintiff distinguished its mark from the mark 'ProClean', which was previously registered in class 3, by stating that the use of the letter 'K' makes it distinct from the earlier mark. The defendant also pointed out that the plaintiff had agreed to restrict the area of operation to South India. On such basis, it was contended that the Trademark Registry agreed to advertise the mark before acceptance.

The Defendants made a compelling case for why the plaintiff cannot assert that the names "ProClean" with a "C" and "ProKlean" with a "K" are deceptively similar. The Trademark Registry made these remarks on November 7, 2014. Many judgments, including Medley, BRS Refineries, and Sachdeva, were cited in support of the idea that prosecution history estoppel works against the plaintiff. Any estoppel, including prosecution history estoppel, is an evidentiary rule that works against the person who made the representation as long as the person to whom the representation was made suffered as a result. In this instance, just the Trademark Registry's observations are on file, the representation is not.

Hence in the view of the court the above contentions tilt the balance of convenience against the grant of interim injunction to the plaintiff because the hardship caused consequently to the defendants would outweigh the hardship given to the plaintiff. Nonetheless, the Defendant is required to keep track of and present quarterly reports to the court detailing sales of items using the disputed mark "ProClean." According to the plaintiff, the applicant has not provided evidence of either the amount spent on

advertising or the sales turnover necessary to prove goodwill with relation to the claim for passing off. Hence, the higher threshold is not met at this time.

Karim Hotel Pvt Ltd vs. Kareem Dhanani

Forum: High Court of Delhi

Case no.: CS (COMM) 112/2022 & I.A. 2695/2022

Order Dated: 27th May 2022

Issue: Whether the Plaintiff is the rightful owner of the mark(s) Karim/ Karim's/ Kareem?

Judgment: The facts of the case are such that the plaintiff is the registered owner of the trademark Karim/ Karim's/ Kareem of which the word "Karim" formed a prominent and essential feature and is using this mark since 1913. The plaintiff stated that the word Kareem is exclusively associated with plaintiff for high- quality Mughlai Food. In December 2014, the plaintiff came to know that the defendants were using the identical mark after which legal notice was issued to them. The defendants contend that they had the registration for the device mark "Kareem".

A cancellation petition was filed before the IPAB, and it is still pending, and no proceedings has taken place. Since the IPAB has been abolished thus the case has been transferred to the jurisdictional High Court. This court notices that this is the second round of litigation. The court after examining the records states that the plaintiff is the prior owner and user of the marks. The court observes that that the defendants have adopted the mark in 2003 which is almost 90 years after the plaintiff's adoption. In the first round of litigation the suit has been initially adjourned which permitted the plaintiff to file proceedings after IPD taking a decision in the cancellation petition.

The present suit seeking a permanent injunction to restrain infringement, passing off, delivery up, damages etc. was filed by the plaintiff on the ground that, owing to the long delay in the disposal of the said cancellation petition, Defendant was continuing to expand their restaurant business. It was submitted that the defendant 41 restaurants already and the court has opined that a balance would have to be struck so as to ensure that neither party is prejudiced irreparably.

Hence the court issued the following directions:

- The defendants shall not open any further restaurants under the marks Kareem/ Karim's or any other mark which is identical.
- The defendants should ensure that no representations are made to the customers that the defendant is associated with the plaintiff.
- At least two public notices shall be issued in prominent newspapers that there is no association of the defendants with the plaintiff's restaurant.
- All the advertisements and promotional materials should contain the disclaimer- "No connection with Karim's Jama Masjid/ Delhi".

The High Court further directed the defendants to record his statements by 5th July 2022 along with franchise agreements entered into him with his various franchisees and state the monthly fees being earned collected by him till date.

USV Private Limited. vs. Hindustan Unilever Limited & Ors.

Forum: High Court of Bombay

Case No.: Commercial Appeal (L) No. 22103 of 2022, Interim Application (L) No. 22107 of 2022, Commercial Appeal (L) No. 22122 of 2022 and Interim Application (L) No. 22126 of 2022

Order Dated: 13th July 2022

Issue: Whether the advertising campaign run by USVPL constituted unlawful disparagement and denigration of HUL and Wipro products, in

which plaintiffs had valuable intellectual property rights, and whether the order passed by the Single Judge in the suit filed against USVPL need interference?

Judgement: HUL and Wipro both complained that USVPL launched an advertising campaign promoting and publicising its product under the brand SEBAMED. They claimed that the advertising campaign run by USVPL constituted unlawful disparagement and denigration of HUL and Wipro products, in which the Plaintiffs had valuable intellectual property rights. To be perfectly clear at the beginning, HUL sought protection for four of its products under the brand names, LUX, DOVE, PEARS and RIN. Clearly RIN is not of a class with the other three because it is a detergent. For its part Wipro sought protection for its product SANTOOR.

It was held that Single Judge was entirely correct in his approach. He steered clear of invitation to hold a mini trial on factual issues and correctly assessed prima facie case. Mere nomenclature confusion could not and did not change actual nature of product. It does not matter what you call product, what matters is what product is and with what one is comparing it. Judge found no interference with the order passed by trial court and dismissed the appeal.

Kiran Jain & Ors. vs. Kangaro Industries (Regd.) & Ors.

Forum: High Court of Delhi
Case No.: CS (COMM) 415/2022
Order Dated: 3rd June 2022

Issue: Whether the Plaintiff is entitled to relief in the nature of anti-suit injunctions in the suit filed against the Defendant?

Judgement: The Plaintiffs seek a permanent injunction restraining the Defendants from filing, instituting or prosecuting any trademark application and/or litigation proceedings based on registrations in any foreign jurisdictions, in relation to the mark 'KANGARO'. The dispute relates to the use of the 'KANGARO' mark used by both parties in respect of the manufacture of various stationery products, staplers, hole punchers and other related goods. Disputes arose between the parties sometime in the year 1992. Since then, the parties have been at loggerheads with each other, both in India and in foreign countries.

The Plaintiffs also sought the following reliefs in the suit:

- (i) A permanent injunction restraining the Defendants from filing any proceedings or trademark action in any jurisdiction outside India against the Plaintiffs for objecting to the use of the Trademark "KANGARO,"
- (ii) A mandatory injunction directing the Defendants to withdraw all pending applications/oppositions/cancellations or similar proceedings thereto in respect of the Trademark "KANGARO" and/or file appropriate actions for the cancellation of registrations obtained by the Defendants in foreign jurisdictions
- (iii) A permanent injunction restraining the Defendants from claiming to be the proprietors/owners of the Trademark "KANGARO" in any foreign jurisdiction.

The parties have filed several trademark applications and opposition proceedings in various countries. The Plaintiffs had earlier filed a suit in Ludhiana, wherein an interim injunction order was granted on 7th January 1997 against the Defendants. The suit was then transferred to the Delhi High Court. In 2006, the Plaintiffs' goods bearing the 'KANGAROO' mark were seized in Dubai as counterfeit products at the instance of the Defendants,

leading to contempt proceedings and an interim injunction against the Defendants from pursuing litigation in Dubai. The Defendants' appeal from the order stood dismissed by the Division Bench of the High Court. The order was challenged before the Supreme Court. The Supreme Court ordered the parties to explore the possibility of an amicable settlement, being near relatives, with a request to the Dubai Court to adjourn the hearing.

Interim directions were passed that both parties are permitted to pursue their trademark applications, opposition proceedings and other statutory proceedings before the trademark authorities in India and in foreign countries; However, if any step is taken by either party in any country to revive or institute any fresh civil or criminal proceeding, the opposing party is permitted to approach the Court.

Mankind Pharma Limited vs. Registrar of Trade Marks

Forum: High Court of Delhi

Case No.: C.A.(COMM. IPD-TM) 52/2022

Order Dated: 18th May 2022

Issue: Whether the Appellant's appeal challenging the impugned order passed by the Senior Examiner of Trademarks should be granted by which the application for the mark “DON'T WORRY” in Class-3 had been rejected.

Judgement: The Appellant has filed the appeal challenging the impugned passed by the Senior Examiner of Trade Marks by which the review petition filed by the Appellant has been dismissed. The said review petition was filed by the Appellant seeking review of order dated 20th December, 2018 vide which the trade mark application of the Appellant for registering the word mark “DON'T WORRY” in Class-3 had been rejected. The Appellant's trademark application was rejected by the Senior Examiner of Trade Marks under Sections 9 & 11 of the Act as the mark was deemed objectionable. The Appellant filed a review petition, which was dismissed by the Senior Examiner of Trade Marks on the grounds that the mark lacked

distinctive character, was a combination of non-distinctive words, and was descriptive in nature, therefore the refusal order was upheld.

The Court held that the trademark application on a "proposed to be used" basis in Class-3 cannot be rejected solely on the basis that the words "Don't Worry" lack distinctive character. The application can proceed for advertisement before acceptance with certain conditions, including association with the trademarks of 'Mankind's Don't Worry' registered in Class 1 and Class 5. The use of the mark in Class-3 shall be with the word 'Mankind's' and the registration shall not grant exclusive rights in the words 'Don't' and 'Worry' separately or jointly for unrelated products or services. The application shall be advertised before acceptance in the Trade Mark Journal within four months, and the observations in the order shall not prejudice any opposition proceedings if initiated against the application.

Unimed Technologies Limited and Ors. vs. Cadila Healthcare Limited and Ors.

Forum: High Court of Madras

Case No.: Civil Suit (Com. Div) No. 822 of 2013

Order Dated: 9th June 2022

Issue: Whether the suit filed by the Plaintiff as a rolled-up action to restrain alleged trademark infringement and passing off is tenable?

Judgement: The first and second Plaintiffs are manufacturers of pharmaceutical drugs and active ingredients. They claim that their registered trademark HYVISC has been extensively used and identified with their products. The Plaintiffs' manufacture two products, namely, the "HYVISC" Eye Drops and "HYVISC Plus", the Defendants manufacture and market "ZYVISC" Ophthalmic Solution and "ZYVISC PFS". They came across the Defendant's medicinal preparation bearing the almost identical mark ZYVISC, which is allegedly deliberate, mala fide, and dishonest. The similarity in marks used for similar products can cause confusion and deception. "

It was held that two marks are phonetically similar. Even visually, there is considerable similarity. Both products are used in treatment of ophthalmic conditions. Although likelihood of confusion is reduced when any product is administered in hospital setting. Given phonetic and ocular similarity of two marks, likelihood of confusion cannot be discounted. Impugned mark ZYVISC is deceptively similar to plaintiffs' registered trade mark "HYVISC". Suit decreed by granting reliefs prayed for. In addition, the Plaintiffs are entitled to a preliminary decree directing the Defendants to render accounts of profits made by selling products bearing the mark ZYVISC. The Plaintiffs are also entitled to costs assessed in a sum of Rs. 3 lakhs and no evidence was adduced with regard to the claim for liquidated damages of Rs. 1,00,000/-, the said claim was rejected.

Osram GMBH and Another vs. Tejmeet Singh Sethi and Another

Forum: High Court of Delhi
Case No.: CS (COMM.) 84/2022
Order Dated: 3rd June 2022

Issue: Whether the plaintiff is entitled to the relief of permanent injunction against the defendants for infringing the Plaintiff's trademark 'OSRAM'?

Judgement: M/s Osram GmbH and Osram Lighting Private Limited filed a suit against Tejmeet Singh Sethi and Hartej Singh Sethi claiming their rights in the registered trademark "OSRAM." The plaintiffs had been using the mark since 1906 and registered it in India in 1945 by General Electric Company Limited. Plaintiffs were engaged in manufacturing a range of products comprising Lumilux Plus Fluorescent Lamps, CFL lamps and other related products. The defendants were manufacturing and selling coolants and filters for automobiles under the same trademark. The Defendants applied for the registration of the trademark 'OSRAM' in two classes, which the Plaintiffs opposed, leading to the filing of this suit. The

plaintiffs sought a permanent injunction against the defendants to protect their trademark rights.

The Court issued a permanent injunction against the Defendants from using the Plaintiffs' trademarks or similar marks and cancelled/withdrawn the Defendants' trademark applications. Defendants assure that there are no products in their possession bearing the mark 'OSRAM'. They were ordered to pay Rs. 10 lakhs towards litigation costs within two weeks. The Plaintiffs can revive the suit and claim damages of Rs. 2 crores and complete costs of litigation if the payment is not made in time.

Veranda Race Learning Solutions Private Limited, Rep. by its Director, Mr. R. Rangarajan vs. Trichy Race Academy, Rep. by its partner Mr. Satish Kumar and Another

Forum: High Court of Madras

Case No.: O.A. Nos. 73 and 74 of 2022 in Civil Suit (Comm. Suit) No. 23 of 2022
Order Dated: 8th June 2022

Issue: Whether the two applications filed by the Plaintiff to restrain alleged infringement of trademark and passing off for using the name Chennai Race Coaching Private Limited and the logo Chennai Race Coaching Institute Private Limited are maintainable?

Order: The Plaintiff is the assignee of a registered device mark for education and training services. They allege that the Defendants are operating a similar coaching institute using the mark 'Trichy Race Academy' from the same premises, causing confusion and riding on the Plaintiff's reputation. The Second Defendant has filed a trademark application for "RACE IAS Academy" claiming its use since 1st April 2014 and produced evidence of a rental agreement and receipts from an advertising agency in the years 2017 to 2019. A partnership deed for the constitution of Trichy Race is also on record.

The Court held that Defendants have been using the mark "RACE" and "RACE IAS Academy" since 2014, and "Trichy Race Academy" since mid-

2021. The balance of convenience is not in favour of granting an interim injunction, and therefore O.A. No. 74 of 2022 is dismissed. However, O.A. No. 73 of 2022 is disposed of by declining an interim injunction but by directing the Defendants to maintain accounts of revenues earned from the use of the impugned mark Trichy Race Academy and profits derived on such account, to be provided if called for by the court in the final disposal.

Puma Se vs. Hi-Tec Point Technologies and Ors.

Forum: High Court of Delhi

Case No.: CS (Comm) 137/ 2021; 2022 (91) PTC 590[Del]

Order Dated: 19th May 2022

Issue: Whether the mark 'PUMA THE VEHICLE GUARD' infringes upon the Plaintiff's registered mark 'PUMA'?

Judgement: The Court had through its order dated 24th March 2021, granted an ad interim injunction in favour of the Plaintiffs. Vide the same order a Local commissioner was also appointed to visit the premises of the Defendant no. 2 and prepare an inventory of the products with the impugned mark.

The present suit was being contested by Defendant nos. 1 and 2, who had applied for the impugned mark and were using it online, while the Defendant nos. 3-6 were the Registrar of domain names as well as the web hosts of the websites with the impugned marks, the rest of the defendants (Defendants 7-11) were Twitter, Facebook, Google inc., Apple, LinkedIn etc. as the impugned products were being promoted, advertised and solicited for sale on the said social media handles and the applications available for downloads on Google play store and Apple app store. Despite orders being passed by the Court, the defendant's application continued to be available on Google play store and the defendant's profile also continued to be operational on LinkedIn, while it was removed by rest of the Defendants from all other online portals/ websites.

The Court then noted that during the pendency of the suit, the Plaintiff and Defendant Nos.1 and 2 had arrived at a settlement. The said Defendants acknowledged the Plaintiff's rights in the mark 'PUMA,' and stated that they had discontinued using the mark 'PUMA,' for their GPS tracking devices or any other similar products, which might amount to infringement and passing off, according to the terms of the settlement. Further, the Delhi High Court directed Google LLC to remove the application 'PUMA GUARD' from its Google Play Store while decreeing the said suit in favour of the Plaintiffs considering the settlement entered between the parties. Also, to give full effect to the injunction granted, the Court additionally ordered that Defendants No. 1 and 2's LinkedIn profiles be removed.

Radico Khaitan Ltd vs. Registrar Trade Marks

Forum: High Court of Delhi

Case No.: C.A. (COMM.IPD-TM) 79/2021

Order Dated: 18th May 2022

Issue: Whether the rejection of the trademark application for the registration of the mark "EFKAY'S XXX RUM (Device)" in class 33 is valid?

Whether the appeal filed by the Appellant challenging the rejection is maintainable?

Judgement: The Appellant filed a trademark application for "EFKAY'S XXX RUM (Device)" in class 33, which was objected by the Trade Mark Registry under Section 11 of the Trade Marks Act. The Appellant responded to the objection by relying on an assignment deed and a user affidavit, claiming use of the mark since April 1987. However, the application was rejected in July 2018. The Appellant filed a review petition which was dismissed in June 2020, leading to the current appeal.

The court has ruled that the Appellant cannot seek a monopoly on the words "XXX RUM," "RUM," or "XXX" or the descriptive matter on the label. The distinctive feature of the mark is only the word "EFKAY'S," which is now assigned to the Appellant. Therefore, the rejection of the Appellant's mark is not sustainable, and the application will proceed for advertisement in the trademark journal with the condition that *'No exclusive rights in the words "XXX RUM", either jointly or otherwise as also in the descriptive matter contained in the label'*.

Shakthi Fashion and Another vs. Burberry Limited

Forum: High Court of Delhi

Case No.: CRP-IPD 2/2022 and CM APPL. 20304/2022

Order Dated: 24th May 2022

Issue: Whether the impugned order passed by the Id. Commercial Court is legally tenable? Whether the revision petition filed challenging the order is maintainable?

Judgement: The present revision petition has been filed challenging the impugned order dated 21st December 2021 passed by the Id. Commercial Court concerning the application filed by Petitioners/Defendants (hereinafter, "Defendant") under Order VII Rule 11 CPC seeking rejection of the plaint on the ground of territorial jurisdiction. The application was dismissed by the Id. Commercial Court.

The case of the Respondent/Plaintiff (hereinafter, "Plaintiff") is that Plaintiff is the owner of the mark 'BURBERRY', involved in manufacture, distribution, and sale of high-end garments, bags, perfumes among others. And, owner and proprietor of the marks 'BURBERRY', 'BURBERRY EQUESTRIAN KNIGHT LOGO', 'CHECK' device and various 'BURBERRY' formative trademarks/labels and Defendants are indulging in selling counterfeit 'BURBERRY' branded goods. The Plaintiff preferred a suit CS(COMM) 526/20, before the Commercial Court against M/s Shakthi Fashion and APB Designs for infringement of copyright,

trademark, passing off, damages, delivery up, etc. Before filing the lawsuit, the plaintiff lodged a complaint that led to the seizure of goods bearing the mark 'BURBERRY' in Bangalore. The said goods are also promoted by the Defendants on the website, including on India Mart. A revision petition has been filed to challenge a court order dated 21st December 2021, which rejected the Petitioners application seeking rejection of the plaint on territorial jurisdiction grounds. The application was dismissed by the Commercial Court, and now the petitioners are seeking a revision of the decision.

In this case Delhi High Court relied on its judgement of RSPL Limited vs Mukesh Sharma and Ors, wherein it was held that the question of jurisdiction in some cases could be a mixed question of facts and law and that if plaintiff were merely to state that a court has territorial jurisdiction to try and adjudicate a suit, that would not be sufficient. The plaintiff would have to plead as a fact as to how the court would have territorial jurisdiction. But, at the same time, the plaintiff would not have to give details of that material fact or the evidence by which the material fact is to be proved.”

The Hon’ble High Court observed that the principle would be applicable in this instance as well because the IndiaMart’s listing, the clandestine sales, as well as the promotion of the defendants' goods and business in Delhi, would all require evidence. The impugned order cannot, therefore, be said to be incorrect at this stage. On the question of jurisdiction, an issue would be framed by the Commercial Court and evidence would be led. The observations made in this order as also in the impugned order dated 21st December 2021 shall not affect the adjudication of the issue of territorial jurisdiction post-trial.

Accordingly, the present revision petition disposed of and pending applications were also disposed of.

Starbucks Corporation vs. Tequila A Fashion Cafe and Another

Forum: High Court of Delhi

Case No.: CS (COMM) 479/2019 & I.A. 12127/2019

Order Dated: 6th May 2022

Issue 1: Whether the plaintiff is entitled to the relief sought for trademark infringement and passing off against the defendants for their unauthorized use of the FRAPPUCCINO mark and similar beverage marks/ names?

Issue 2: Whether the Defendants were registered and honest users of the trademark?

Judgement: Plaintiff has valid trademark registrations for "FRAPPUCCINO" in over 185 countries, including India. Plaintiff's mark is used for blended cold beverages, and it also owns the domain 'frappuccino.com'. Defendant No.2 ran a cafe called "Cafe TeaQuila- A Fashion Cafe" where Defendant No.1 sold beverages named "BUTTER SCOTCH FRAPPUCCINO" and "HAZEL NUT FRAPPUCCINO" without the Plaintiff's permission or license. The marks used by the Defendants are visually and phonetically identical to Plaintiff's FRAPPUCCINO mark and the beverage names are similar to Plaintiff's "SMOKED BUTTERSCOTCH FRAPPUCCINO" and "HAZELNUT FRAPPUCCINO BLENDED COFFEE". Relief sought included damages and delivery up of infringing goods, with an alternative relief of rendition of accounts of profits earned by Defendants using the mark.

The court dismissed the plaintiff's claim for damages as it is based on assumptions and lacks sufficient evidence. The plaintiff alleged that 400 beverages were sold by the defendant, but only one invoice was presented as evidence. The court found that this was not enough to support the claim and no stocks were recovered from the defendant's premises. Therefore, the court was unable to award the damages claimed by the plaintiff. However, the court recognized that the defendants were guilty of trademark infringement and awarded notional damages of INR 2,00,000 (USD 2,435)

to the plaintiff based on the judgment in Indian Performing Right Society v. Debashis Patnaik.

Thus, a decree of damages of INR 2,00,000 (USD 2,435) was passed in favour of Plaintiff and costs of INR 9,60,100 (USD 11,693) were awarded in its favour and against the Defendants. Pending applications were also disposed of.

3M Company vs. Vikas Sinha and Ors.

Forum: High Court of Delhi

Case No.: CS (COMM) 144/2019, IAs 4095/2019 and 9172/2019

Order Dated: 5th July 2022

Issue: Whether the application for condonation of delay in filing of written statement was correctly dismissed by Joint Registrar?

Order: The defendant nos. 1 and 2 were formally served with the summons on 22nd April 2019 and defendant no. 3 was served with the summons on 23rd April 2019. The defendants filed their written statement on 19th August 2019 on the 118th day of service of summons. The official objection on the written statement was raised by the Court's Registry on 15th November 2019 and corrected written statement was re-filed on 20th November 2019 and an application seeking condonation of delay in filing of the written statement was filed on 21st November 2019. The Joint Registrar (Judicial) dismissed application seeking condonation of delay on the ground that written statement was filed by the defendants in the suit on the 118th day of service of summons and no application for condonation of delay was filed with it. It was not filed within the statutory period of 120 days prescribed under the Commercial Courts Act, 2015. The Court concluded that despite reliance placed on judicial precedents by the defendants, the defendants/appellants were not able to make out any case for the grant of condonation of delay in filing of their written statement. The Court observed that the object and purpose of the Commercial Courts Act is to ensure that the commercial cases are disposed of expeditiously, fairly and reduce delays in disposal of commercial cases. Observing the Apex Court's brief in

judicial precedent, it was noted that ordinarily a written statement is to be filed within a period of 30 days. However, grace period of a further 90 days is granted which the Court may employ for reasons to be recorded in writing and payment of such costs as it deems fit to allow such written statement to come on record. The Court noted that defendants/appellants were made aware that their written statement would not come on record as no application seeking condonation of delay was filed and yet, the defendants took no action until the return of the written statement by the Court's Registry. The application was dismissed.

Lifestar Pharma (P) Ltd. vs. Starlife Healthcare

Forum: High Court of Delhi

Case No.: CS (COMM) 62/2020, I.As. 1844/2020, 2953/2021 and 3480/2021

Order Dated: 18th April 2022

Issue: Whether the application for condonation of delay in filing of written statement can be allowed?

Order: The Defendant had first entered appearance on 10th February 2020 and was supposed to file written statement and affidavit of admission/denial within the prescribed period, as per the Commercial Courts Act, 2015. The written statement and the affidavit of admission/denial were filed on 23rd September 2020 and applications for condonation of delay were also filed. The Court considered the Apex Court's order dated 8th March 2021 in the *Suo Motu Writ Petition (Civil) No. 3 of 2020* (Covid extension) and held that the delay of filing the written statement and affidavit of admission and denial has to be condoned under the computation of limitation period set by the Apex Court subject to payment of costs which is payable by the defendant to the Plaintiff's counsel.

Sun Pharma Laboratories Ltd. vs. Trugen Neurosciences (P) Ltd.

Forum: High Court of Delhi

Case No.: CS (Comm.) 695/2021 and I.A. 17351/2021

Order Dated: 28th March 2022

Issue: Is use of UROCOL infringement of registered URSOCOL trademark?

Order: The Court decreed the suit in favour of the plaintiff on amicable settlement of issues between the defendant and plaintiff. The plaintiff sought permanent injunction restraining infringement of trademark and passing off of its 'URSOCOL' mark for medicines & pharmaceutical preparations containing Ursodeoxycholic Acid. The defendant was retailing its product called 'UROCOL' with same molecule. The Court had granted ad-interim injunction against the defendants and Local Commissioner appointed by the Court made inventory of impugned products. The defendants agreed to give up the mark 'UROCOL' and stop manufacturing and marketing of their pharmaceutical preparations under the mark 'UROCOL'. The Court ordered the defendants to pay the litigation costs amounting to INR 2 lacs (approx. USD 2440) and destroy the packaging of the products bearing the infringing mark.

Exide Industries Limited vs. Krishna International and Ors.

Forum: High Court of Delhi

Case No.: CS (COMM.) 367/2020, I.As. 7801/2020, 1017/2021, 2402/2021 and 4794/2022

Order Dated: 29th March 2022

Issue: Can quantum of damages be quantified with seizure value?

Order: The plaintiff, Exide Industries Limited sought permanent injunction against defendants from infringement of their registered trademark and

trading name 'EXIDE' and passing off, etc. The defendant was engaged in business of automotive products under the brand name 'EXIDE', as well as its trading style. An *ex-parte* interim order was granted in favour of the plaintiff. The defendants had agreed to stop the use of the mark 'EXIDE', both as a trademark and as a trade name. The plaintiff prayed for additional damages in view of large quantities of infringing products seized at defendant's premises. Since defendant no. 2 did not present itself despite service, the Court observed that plaintiff is not required to move no *ex-parte* evidence as the same would-be repetition of the contents of the plaint. The written statements filed by defendant nos. 1 and 3 were filed with enormous delay of more than 280 days and was not allowed to be recorded in view of strict timelines to be observed in a commercial suit. The Court granted decree of permanent injunction as use of the mark 'EXIDE' by any third-party in respect of identical goods would violate plaintiff's statutory and common law rights and would be contrary to consumer interests as safety of the passengers and owners who drive these vehicles is of paramount importance. In view of the huge quantity of the goods seized at defendant's premises, the defendants were directed to reimburse the court fee deposited by the Plaintiff in this suit to the plaintiff.

Reckitt Benckiser India (P) Ltd. vs. Sharad Jagat Pal Shrivastav

Forum: High Court of Delhi

Case No.: CS (Comm.) 552/2021 and I.A. 14245/2021

Order Dated: 5th April 2022

Issue: Should costs be awarded in commercial matters?

Order: The plaintiff, Reckitt Benckiser (India) Private Limited, sought permanent injunction against the misuse of its trademark 'HARPIC', essential features of 'HARPIC' labels and the shape of the 'HARPIC' bottles, by the defendant. The defendant adopted the mark 'HAPRIC' in identical blue and red containers for toilet cleaners and bathroom cleaners. The defendant was injuncted vide previous order dated October 2021. The Local

Commissioner appointed by the Court seized large quantity of infringing products at defendant's premises. The Court noted that defendant's infringing products appeared to be counterfeit products of the plaintiff's 'HARPIC' products, clearly showing that the defendant intended to cheat and defraud customers and blatantly violate various rights of the plaintiff. The Court also noted that despite service of summons vide various modes, the defendant did not enter appearance showing that it has no defence to put forth. The Court granted decree of permanent injunction restraining the defendant from manufacturing, selling, offering for sale, advertising or promoting, either offline or online, any products which use the mark which is identical or deceptively similar to the plaintiff's mark including 'HARPIC' in any containers, bottles or other labels which are a colourable imitation of the plaintiff's packaging/trade dress/label/mark. To decide on payment of costs, the Court referred to settled legal position in commercial matters which makes it clear that the actual costs ought to be awarded, keeping in mind the bill of costs, including counsel fees. The Court referred to salutary principles: (i) costs should ordinarily follow the event; (ii) realistic costs ought to be awarded keeping in view the ever-increasing litigation expenses; and (iii) the cost should serve the purpose of curbing frivolous and vexatious litigation. The Court concluded that present case was a fit case for award of actual costs to the plaintiff and decreed the suit for a sum of INR 13,50,000/- (court fees and legal costs approx. USD16,444).

Mankind Pharma Ltd. vs. Tata Medical & Diagnostics Ltd.

Forum: High Court of Delhi

Case No.: CS (COMM) 192/2022 and I.As. 4838-40/2022

Order Dated: 30th March 2022

Issue: What factors can be considered to give weightage to public interest against infringement and passing off claims?

Order: The plaintiff sought permanent injunction to protect its registered trademark 'OMIPURE' in respect of pharmaceutical and medicinal preparations- containing the chemical compound "Omeprazole" which are

used as antacids, anti-reflux agents, and anti-ulcerants. There is a gap of 9 years between 2012 to 2021 when there was no sale under the mark 'OMIPURE'. Post 2012, sales were resumed by the Plaintiff only in 2021-2022. The defendant, Tata Medical and Diagnostics Ltd. launched Covid-19 virus detection kit under the mark 'OMISURE'. The Court assessed if diagnostic kits/testing kits would fall in class 5 since as per NICE classification, such kits would be covered in class 10. The test kit sold under the mark 'OMISURE' is of a specialised nature used in laboratories for diagnosing the Omicron variant of Covid-19 and is not sold openly by chemists to the consuming public. Section 29(2)(a),(b),(c) of the Trade Marks Act, 1999 stipulates different varieties of confusion which can take place under Section 29(2) of the Act. In present case, 'OMIPURE' and 'OMISURE' are not identical, and products belong to different categories. The Court observed key differences between the products based on set principles for establishing confusion and deception in medicines - plaintiff's product is a capsule/tablet for gastro-resistant intestinal ailments which is sold across the counter and consumed directly by patients. The defendant's product is a RT-PCR test kit used for the detection of omicron variant of the Covid-19 in human swab samples, only by laboratories and not sold over the counter to public. There can be no dilution as there has been gap of 9 years in use of 'OMIPURE' and no extensive sales were made. The defendant's RT-PCR test kit to test Omicron variant of the Covid-19 is a breakthrough innovation and any objection/hurdle would be contrary to the interest of the patients and the public who are suffering from Covid-19. The trademark 'OMISURE' is used in full form as 'TATA MD CHECK RT-PCR OMISURE', and the same would not cause any confusion in the market or even association between the defendant's product and the plaintiff's mark. The Court believed it has to strike a balance between the rights of the individual and the public interest and apply the law to the facts and circumstances of each case. While there were phonetic similarities between these two marks, however the present case wasn't liable to be granted ad-interim injunction.

Modicare Ltd. vs. Registrar of Trade Marks

Forum: High Court of Delhi

Case No.: C.A.(COMM.IPD-TM) 9/2022 & I.A. 745/2022
Order Dated: 4th April 2022

Issue: Will prolonged use of trademark assist in overcoming descriptiveness objection?

Order: The appellant applied for the mark 'SALON PROFESSIONAL' in class 3 which was used since 2003 and had already secured trademark registration for 'MODICARE SALON PROFESSIONAL' in class 3. The Examiner objected the mark on the grounds of descriptiveness and prior mark. While the prior mark was shown to be different, to overcome descriptiveness objection, the Court considered that mark was in continuous use since 2003 and had acquired a secondary meaning. The Court agreed to the appellant's agreement to modify the word mark to a device mark which was taken on record and the device mark was directed to proceed for advertisement in the category of 'advertised before acceptance' with association with earlier registration and disclaimer that there would be no exclusive rights in the words 'SALON' or 'PROFESSIONAL'.

Abbott Healthcare Private Limited vs. Glensmith Labs Pvt. Ltd. & Anr.

Forum: High Court of Delhi
Case No.: CS (COMM) 430/2020
Order Dated: 18th April 2022

Issue: Whether mark 'LIMCEE PLUS' and the product's packaging is identical to that of the Plaintiff's?

Order: A suit had been filed by the Plaintiff seeking permanent injunction, restraining infringement of the trademark, copyright passing off, damages, rendition of accounts, dilution, delivery up, etc. The Plaintiff sought protection of its trademark 'LIMCEE' which is a chewable Vitamin - C preparation. the trademark 'LIMCEE' along with its packaging has been identically copied by the Defendants by using the mark 'LICMEE' and

'LICMEE PLUS' for identical preparations of Vitamin - C. his was noticed by the Plaintiff in August 2020, and in September 2020, it was also revealed that Defendant No.1 had applied for the registration of the mark LICMEE PLUS under No.4635687 in Class 5. The product of the Defendants including the packaging, is nothing but an imitation of the Plaintiff's mark and packaging. Accordingly, the Plaintiff had filed the present suit.

After perusing the records, the court concluded the mark 'LIMCEE' and 'LICMEE' were almost identical to each other. There was deceptive, ocular, and phonetic similarity between the two marks. The Defendants' packaging was also an imitation of the Plaintiff's packaging which was noted by the Court.

The Court also observed that the mark of the Plaintiff is a registered mark and considering the sales of the Plaintiff, the Plaintiff's product enjoyed enormous goodwill and reputation. The Defendants were directed reimburse the court fee to the Plaintiff, to remove all listings on the B2B/B2C or any other websites, where the products under the impugned mark were listed and to pay INR 1.5 Lacs (USD 1827) as litigation costs. Defendants were also warned not to imitate or copy any of the brands or marks of the plaintiff in the future, or they would be liable to pay at least INR 20 lakhs (USD 24,362) to the Plaintiff. Lastly, the trademark application as filed by the Defendants in class 5 was also directed to be abandoned within four weeks of the present order.

Burberry Ltd. vs. Aditya Verma

Forum: High Court of Delhi

Case No.: R.F.A. (IPD) 4/2021, CM Appeals 6298/2020 and 6300/2020

Order Dated: 29th March 2022

Issue: Six issues were framed by the Trial Court. In respect of issues 2 to 6, the trial court came to the reasoning that the Appellant/ Plaintiff had failed to prove that the goods that were seized by the Local Commissioner were counterfeit products. The Appellant/ Plaintiff failed to discharge the

onus of proving its case since no expert was examined and no evidence produced established that the goods seized were counterfeit. Trial court was of the view that the seized goods were not proved to be counterfeit. The suit has thus been filed in view of the present issue.

Order: Burberry Ltd. Has filed a suit under Sections 134 and 135 of The Trade Marks Act, 1999 and Section 55 of The Copyright Act, 1957 for a permanent injunction restraining Aditya Verma from violating proprietary rights. Learned ADJ, Patiala House Courts, New Delhi dismissed Burberry's suit.

After hearing both the sides, Court stated that a perusal of the impugned judgment would reveal that the learned Trial Court has completely misdirected itself in placing undue emphasis on proof of counterfeit products whereas the issue before it was whether there was an infringement of the registered trade mark of the appellant by the respondent and/or whether the respondent was passing off his own goods as those of the appellant or was indicating the source of his goods as that of the appellant and thus infringing the registered trademarks of the appellant, and to its detriment by dilution.

The High Court stated that unlike in a criminal case, in a case of infringement of registered Trade Marks or of passing off, similarity of the marks used is to be considered. There is no call to have an expert witness to testify to the use of an identical or similar Trade Mark. The emphasis is on the branding and not on the manufacture of the goods in question. It is the false branding that results in the product being counterfeit. Thus, the learned Trial Court fell into grave error in holding that the absence of expert testimony disproved the case of infringement and passing off.

The High Court stated that it is but obvious, that the products of the appellant, which is a company having worldwide operations and having earned reputation for the various products manufactured by it and sold under the trade mark "BURBERRY" with its logo and labels, would have a quality that would be far superior to the goods found from the respondent, who himself claims, that he is selling various products at a stall in Khan Market. But the fact that people coming to Khan Market would be familiar with the

label and trade mark “BURBERRY”, apparently prompted him to try and cash in on the appellant’s reputation and make a neat profit for his products. It is thus, clear, that the appellant has, in fact, proved its entitlement to the reliefs claimed by it and the suit ought to have been decreed rather than dismissed.

After evaluating submissions made by both the parties the Court held that the appeal is allowed, and the impugned judgment and decree dated 7th November 2019 was set aside and the suit decreed.

Imagine Marketing Private Limited vs. Green Accessories

Forum: High Court of Delhi

Case No.: I.As. 12556-57/2020, C.S. (Comm) 564/2020

Order Dated: 21st March 2022

Issue: It was seen that the trademark and the trade dress of the Plaintiff, an Indian Company which designs and markets earphones, headphones and variety of phone accessories, was being infringed as a way of counterfeit products. In an earlier order- Defendant Nos 2, 4 and 5 had already amicably settled their disputes subject to the payment of cost of INR 50,000 (USD 609)

Order: The premises of Defendant Nos 1, 3 and 6 were visited by the Local Commissioner for the purpose of investigation. A total of 22 counterfeit pieces were found from the premise of Defendant No. 1, 120 counterfeited items including Bluetooth headsets, wireless headsets, earphones etc were found from the premise of Defendant No. 6 and no infringing products were found from the shop of Defendant No. 3.

Following the rationale established through precedents, the ordered Defendant No. 1 to pay a sum of INR 5 Lakhs (USD 6088) Defendant No. 6 to pay INR 10 Lakhs (USD 12,177) and no monetary damages were imposed on Defendant No. 3.

RPG Enterprises vs. Riju Ghoshal

Forum: High Court of Bombay

Case No.: Commercial IP Suit No. 769 of 2019

Order Dated: 2nd April 2022

Issue: Whether there has been an infringement of the trademark and passing off action by the Defendants

Order: RPG Enterprises, a multi-industry company founded in 1979 and is the plaintiff in the present lawsuit. The plaintiff holds numerous registrations for other RPG/RPG formative marks under the Trade Marks Act, 1999 in different classes along with a copyright registration under artistic work and has been continuously, extensively and uninterruptedly using the mark. As a result, the mark RPG has become a source identifier of the Plaintiff and its goods/services thereunder.

The plaintiff came across the marks “RPG opticals” and “RPG pharmacy” and subsequently filed objection and rectification against them respectively, both of which were pending. The plaintiff, therefore, filed a suit against the above-said marks for infringement of trademarks as well as copyright infringement and passing off.

The court went through a supremely profound analysis to weigh the rival party’s contentions. The court took into consideration relevant points such as the plaintiff being in the market for around 37 years as marked before the defendant’s entry in the market, the plaintiff’s mark having acquired secondary meaning and the immense recognition amongst the public. The interpretation of certain legal points that paved way for the present conclusion of the court also entailed the true test for checking the deceptive similarity, the built-up goodwill and reputation and the aftermath it could render if deception continues at the instance of the defendants and the superiority of prior users over the registrations.

Resilient Innovations Private Limited vs. PhonePe Private Limited

Forum: High Court of Bombay

Case No.: COMPIL Suit (L) No. 24136 of 2021

Order Dated: 11th March 2022

Issue: The Bombay High Court had allowed fintech firm PhonePe to file a fresh suit against BharatPe's Buy Now Pay Later (BNPL) platform PostPe for trademark infringement. Resilient innovations had then filed a SLP against the Bombay High Court order.

Order: The Court observed that the mark PostPe adopted by Resilient Innovations is so phonetically, structurally, and visually similar to PhonePe mark that it also thought that PostPe/postpe is a natural evolution of the word PhonePe and emanated from PhonePe.

Om Logistics Ltd. vs. Mahendra Pandey

Forum: High Court of Delhi

Case No.: CS (Comm) 447/2021

Order Dated: 15th March 2022

Issue: Petitioner had approached the Delhi High Court, seeking an ex parte injunction to restrain Mr. Mahendra Pandey (Mahendra) from providing services under the name 'OM EXPRESS LOGISTICS' or using the said name or any other deceptively similar name in any manner whatsoever. The petitioner was granted an ex parte ad-interim injunction by the court restraining Mahendra from using the mark/trading name 'OM EXPRESS LOGISTICS'. Mahendra has filed an application to set aside the ex-parte injunction.

Order: The Court held that Om Logistics Ltd was guilty of suppression and concealment and vacated the ex parte ad interim injunction. The Court stated, "*A party that approaches the Court for a grant of discretionary relief has to come with clean hands and disclose all material facts which would*

have a bearing on the merits of the case". The Court also held that Religious symbols like Om and names of deities cannot be monopolized. In India, it is a common practice that names of gods and goddesses and religious symbols are used as parts of names of individuals as well as business entities. No person can claim exclusivity with regard to names of deities as well as religious symbols.

Kent RO System Ltd. and Ors. vs. Gattubhai and Ors.

Forum: High Court of Delhi
Case No.: CS (COMM) 426/2019
Order Dated: 23rd March 2022

Issue: The plaintiff sought ad-interim injunction restraining the defendants from manufacturing, selling, offering for sale, advertising or in any manner dealing on product bearing a mark 'KENT' or 'KENT APPLIANCES' or variants thereof or any other mark or logo or trade name, which is deceptively similar to the trade mark of the plaintiffs.

Judgement: Court modified the judgment to the extent that the ex parte ad-interim injunction restraining the defendants from manufacturing, selling, offering for sale, advertising or in any manner dealing on product bearing a mark 'KENT' or 'KENT APPLIANCES' or variants thereof or any other mark or logo or trade name, which is deceptively similar to the trade mark of the plaintiffs, is vacated. The Court observed that An action for passing off, as the phrase "passing off" itself suggests, is to restrain the defendant from passing off its goods or services to the public as that of the plaintiff's. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public.

Coldsmiths Retail Services Private Limited vs. Nirulas Corner House Private Limited and Ors.

Forum: High Court of Delhi
Case No.: CS (COMM) 426/2019
Order Dated: 4th April 2022

Issue: Whether interim measures of protection need to be granted in the present case. Both the parties had entered into a business transfer agreement and a deed of assignment. However, Nirulas retained certain businesses including a hotel operated under the Trademark “Nirula’s hotel” and Coldsmiths entered into a trademark license agreement dated 3rd January 2018 with Nirulas for licensing the said trademark. Nirulas issued a termination notice to terminate both agreements on the grounds that Coldsmiths had failed to comply with its payment obligations under the Business transfer agreement.

Order: Since Coldsmiths had paid substantial portion of the consideration, the court did not consider it apposite to accede to the interim prayers for interdicting Coldsmiths from carrying on the transferred business or for using the trademarks assigned to it. Coldsmiths was restrained from selling, transferring, encumbering or in any manner alienating any of the assets including the Intellectual Property Rights acquired by it pursuant to the Business Transfer Agreement and the Deed of Assignment, till the conclusion of the arbitral proceedings.

S. Sudhakar and Another vs. Priya Krishnakumar and Anr.

Forum: High Court of Madras
Case No.: CS (Commercial division) No. 324 of 2017
Order Dated: 1st December 2021

Issue: An injunction was filed by the Plaintiff alleging infringement of the registered trade mark of the plaintiffs, passing off of goods and infringement of the registered trade mark of the plaintiff, passing off of goods and

infringement of copyright in respect of the artistic work contained in the label and the plaintiff have sought for various reliefs against the defendants.

Order: The court held that Udhyaan and Udhyaan masala were similar and there was deceptive similarity in mark/label/artistic work of sunrays. It was observed that the Plaintiff had certainly earned a goodwill/reputation. It was held that the plaintiff was entitled to the relief of permanent injunction sought by them. The defendants were restrained from using or claiming the impugned mark since it was visually and deceptively similar to the Plaintiff's label mark.

Tirumala Milk Products Pvt. Ltd. vs. Tirumala Dairy Ltd. and Ors.

and

Swaraj India Industries Ltd. and Ors. vs. Tirumala Milk Products Pvt. Ltd.

Forum: High Court of Madras

Case No.: O.S.A. (CAD) Nos. 97 and 111 of 2021 and O.S.A. (CAD) Nos. 5 and 4 of 2021 and O.S.A. (CAD) Nos. 97, 111, 5 and 4 of 2021

Judgement dated: January 31, 2022

Issue: Whether the plaintiff can file additional documents not presented at the time of the plaint, without the leave of the Court? Whether under Section 62 of the Copyright Act, 1957 and Section 134 of the Trade Marks Act, 1999, the plaintiff is allowed to file a suit at its subordinate office where cause of action did not arise?

Judgement: The plaintiff filed a suit against the defendants, who were having their respective offices in the State of Maharashtra, for perpetual injunction restraining the defendants to use plaintiff's trademark "THIRUMALA"/ "THIRUMALA MILK" or components thereof

including “THIRUMALAA DAAIRY”. Plaintiff also filed applications for grant of interim injunctions in order to restrain the infringement of their trade mark as well as to restrain defendants from passing off their business and dairy products. An *ex parte* order of injunction was also granted in favour of the plaintiffs on 21st August 2020. The defendants objected to the said order of injunction against them. The Learned Single Judge in this application, passed an order to make the interim injunction as absolute till the disposal of this suit. The defendants thereafter filed an application for rejection of plaint on the contention that the plaintiff was not actually having any sales office at the address furnished in the plaint. Final order was passed on 19th April 2021, holding that the plaintiff had not placed any material to show that it was carrying on business within the territorial limits of jurisdiction of the court on the date of filing of the suit and though it was not a ground to reject the plaint, it was directed to be returned for representation before the appropriate court having jurisdiction. The plaintiff’s review application was also rejected. Thus, the plaintiff filed the present intra-Court appeal against the order of 19th April 2021, claiming that it had filed relevant additional documents in earlier proceedings. It had then been held by the Single Judge that both the parties were only allowed to then file written submissions and no additional document could be filed by the plaintiff at that stage, especially without the leave of the Court. The Court also observed that the plaintiff itself had claimed vacating the said office after filing of the present suit and such explanation was only given after the defendants pointed out the issue of lack of jurisdiction. Further, the Court applied the principles enunciated by the Hon’ble Supreme Court in the case of *Sudhir Kumar @ S. Baliyan v. Vinay Kumar G.B.*, (Judgment dated 15.09.2021 in Civil Appeal No. 5620 of 2021) and held that the plaintiff neither disclosed the above document regarding its alleged office in the jurisdiction of this Court at the time of presentation of the plaint nor did it apply for the leave of the Court showing reasonable cause for the same or for its presentation at a later stage. Thus, the said document was not entertained by the Court and the order of the Single Judge was upheld.

Regarding the jurisdiction of the Court, it was held that Section 62 of the Copyright Act, 1957 and 134 of the Trade Marks Act, 1999, was inserted for the convenience of the plaintiff. However, this right to institute suit at such a place has to be read subject to certain restrictions, such as in case the

plaintiff is residing or carrying on business at a particular place/having its head office and at such place cause of action has also arisen wholly or in part, the plaintiff cannot ignore such a place under the guise that he is carrying on business at other far-flung places also. These provisions were intended to operate in the field where the plaintiff had its principal place of business, and the cause of action had also arisen at that place. It was not the intention to enable the plaintiff to file a suit at a distant place where its subordinate office is situated where no cause of action had arisen. Such interpretation would cause great harm to the legislative intent behind these provisions. The Court observed that the registered office of the plaintiff was not situated within the Court's territorial jurisdiction. It was also observed that in the absence of the plaintiff establishing that any cause of action had arisen within the Court's jurisdiction where its sales office was allegedly located at the time of filing of the suit (which could not be taken on record as per the aforesaid binding case-precedent), the suit could not be tried in this Court. Thus, it was held that this Court did not have jurisdiction. As such, the order of interim injunction as passed earlier in favour of the plaintiff would also be effaced. The plaint was accordingly returned to the plaintiff to file it before an appropriate forum where the plaint, along with the applications for interim injunction, would stand revived and would be considered afresh.

Chetan Adesera and Ors. vs. State of Jharkhand and Anr.

Forum: High Court of Jharkhand

Case No.: Cr. M.P. No. 1493/2019

Judgement dated: 4th May 2022

Issue: Whether a counter case between the parties involving trademark infringement was sufficient to quash any criminal proceedings against the accused charged with forgery and fabrication of documents in the existing complaint case?

Judgement: A Criminal Miscellaneous Petition was filed by the accused person for quashing the entire criminal proceeding wherein the accused was charged with forgery and fabrication of documents showing proprietorship

over the alleged trademark “Chhaganlal Dayaljee” in the existing complaint case. In the counter case filed by the accused against the complainant’s husband, infringement of the alleged mark “Chhaganlal Dayaljee” was alleged. According to the accused, a suit was instituted by it against the husband of the complainant, wherein a decree was passed in favour of the accused under the provisions of Trade Marks Act, 1999 and the defendant of the suit (i.e., the husband of the complainant of the present case) was permanently enjoined and directed to deliver and destroy all packets having the plaintiff’s registered trade mark being either ‘Chhaganlal’ or ‘Chhaganlal Dayaljee’ and permanently restrained from using the said trademarks. As such, the entire present criminal proceeding was fit to be set-aside as it was allegedly a mere counterblast and that since the proceedings were filed under special law i.e., the Trade Marks Act, 1999, the present Court did not have powers to interfere.

The Court observed that the complainant of the present case claims to be sole proprietor of “Chaganlal Madanlal & Sons Jewellers” and also the sole proprietor of “Chaganlal Santosh Jee Silver”. Further, it also appeared to the Court that the case of the complainant was that the accused persons have lodged a false case based on forged and fabricated documents although the genuine documents are with the complainant. Thus, the Court held that merely because there is case and counter case between the parties, the same by itself is not sufficient to quash any criminal proceedings and noted that if any forged document is used in a case, then the allegation of forgery is required to be established by instituting a specific case for the purpose. Further, it was held that the evidence brought on record at the stage of inquiry, had not been completely produced before this Court and upon perusal of the complaint petition and the solemn affirmation of the complainant, this Court was of the considered view that the order finding *prima facie* case for the alleged offence under the sections of the Indian Penal Code involving offences of forgery and fabrication of documents, under which cognizance had been taken against the petitioners, was sustainable in the eyes of law. Thus, the present Petition filed to quash the

criminal proceedings against the accused for forgery and fabrication of documents was accordingly dismissed.

Cutis Biotech Sole Proprietorship Concern vs. Serum Institute of India Pvt. Ltd.

Forum: High Court of Bombay

Case No.: Appeal from Order No. 53/2021

Judgement dated: 20th April 2021

Issue: Whether a case of passing off against Serum Institute of India Pvt. Ltd. for using the mark “Covishield” was made out? Can there be another facet to the concept of ‘balance of convenience’ pertaining to large scale ramifications for the public at large and traversing beyond the parties to the suit?

Judgement: This is an appeal filed by the plaintiff against the defendant under section 13 of Commercial Court Acts, 2015. The subject-matter of this appeal is the trade mark “Covishield”. Both, the appellant- Cutis Biotech and the respondent- Serum Institute of India Pvt. Ltd. have applied for registering this trade mark, and their applications are pending. Cutis Biotech filed a suit against Serum Institute seeking an interim injunction to restrain Serum Institute from using the trade mark “Covishield” and to also maintain the accounts regarding the sale. The learned District Judge/commercial Court rejected the interim application. The Court observed that neither Cutis Biotech nor Serum Institute have a registration for the trade mark “Covishield”. The Court further observed that since Cutis Biotech does not have a registered trade mark, it has based its case on the action of passing off. The Court further observed that to grant an injunction in cases of passing off, both ingredients of injunction i.e., prima facie case and balance of convenience, should exist in favour of the applicant and also for the grant of interim injunction it has to be satisfied that there are serious questions to be tried at the suit, irreparable damage will be caused to the applicant, and

the hardship would be more to the applicant and that the applicant has to make out a strong case that the respondent's action would materially injure its business, and the danger is imminent. After the analysis of the facts, the Court observed that the defendant (Serum Institute) was actually the prior adopter and user of the mark and since there was no *prima facie* case in favour of Cutis Biotech, its prayer to direct the defendant to maintain accounts could not be granted. The Court observed that the foundation of a passing off action is the existence of goodwill, and as to who conceived and adopted the mark earlier is also relevant. The Court noted that a direction to maintain accounts is not a routine order and cannot be issued when there is no *prima facie* case made out by Cutis Biotech. The Court also observed that in certain cases in which grant of, or refusal of the injunction is done, any adverse impact on the public interest is also to be considered. In respect of balance of convenience, the Court noted that “Covishield” is a vaccine to counter Coronavirus and is widely known to the public. A temporary injunction directing Serum Institute to discontinue the use of mark “Covishield” for its vaccine will cause confusion and disruption in the vaccine administration programme of the State and therefore the Court believed that in present case the grant of an injunction would have large scale ramifications traversing beyond the parties to the suit. The Court further observed that the scope of an appeal against the discretionary order is well established that the appellate Court will not interfere with the exercise of discretion of the trial Court and will only substitute it unless the discretion of the trial Court is arbitrary or perverse or where the trial Court has passed an order contrary to the settled principles of law governing injunctions and will not generally interfere with the conclusion arrived at by the trial Court. Further, it was held that Cutis Biotech has made self-destructive statements by saying that due to the presence of “Covishield” vaccine manufactured by Serum Institute, the public in confusion might buy Cutis Biotech’s sanitisers thinking that it would help in recovery from covid. However, in case of passing-off one has to put forth the argument as to how they will face a loss of revenue due to another entity passing off its

goods as theirs. Since no *prima facie* case was made out and there was also no balance of convenience in favour of Cutis Biotech, the Court dismissed the present appeal.

Hero Electric Vehicles Private Limited and Anr. vs. Guddu Ansari and Ors.

Forum: High Court of Delhi

Case No.: CS (COMM) 598/2021 and I.A. 15337/2021

Judgement dated: 21st April 2022

Issue: Whether the fees collected through the use of a domain name by the defendant, resembling earlier registered domain name of the plaintiff, can be considered as duping?

Judgement: In the present case, the plaintiffs i.e., Hero Electric Vehicles Private Limited and M/s. V.R. Holdings have filed the present suit against four entities namely, defendant Nos. 1 & 2 being Mr. Guddu Ansari and M/s. Hero Electro, defendant No. 3 being GoDaddy.com (GoDaddy), LLC and defendant No. 4 being Yes Bank Limited (Yes Bank), seeking injunction in view of the fact that defendant Nos. 1 & 2, are duping several innocent persons and offering dealerships with the similar brand name of the plaintiff i.e., HERO and other HERO formatives with an intention to swindle large sums of money. It was submitted in the Court by the plaintiff that in October 2021, it came to know that defendant Nos. 1 & 2 have started operating the domain name www.heroelectro.in, in which they were soliciting dealership enquiries for sale of HERO electric vehicles. The defendants also claimed to be providing services of getting lease land of third parties in return of an application fee for setting up charging infrastructure. The said domain name of www.heroelectro.in, was registered through GoDaddy and the bank account of defendant Nos. 1 & 2 was opened with Yes Bank. Whereas the plaintiff's domain name www.heroelectric.in was registered way back in December 2006. On the

portal of Defendant Nos. 1 & 2, the content of the Plaintiffs' website was also replicated. Further, the Court after analysing the facts and keeping in mind the various registrations and long usage of the plaintiff's marks and brand HERO, combined with the goodwill vested in the mark '*HERO ELECTRIC*' directed permanent injunction in favour of plaintiff and against the defendant Nos. 1 and 2. The Court further held that in the present case, the defendants Nos. 1 & 2 were liable for exemplary and punitive damages. The Court also placed reliance on the case *Koninklijke Philips N.V. v. Amazestore*" [CS(COMM) 737/2016] pertaining to the principles to be borne in mind and the standards for grant of punitive and exemplary damages. The Court observed that the defendants' illegal use of the domain name www.heroelectro.in and blatant copy of the plaintiff's website and collection of amounts in the name of the said domain name made this a fit case for passing an order for exemplary and punitive damages. After examining the bank accounts of the defendants, the Court concluded that defendants have benefitted an amount up to INR 8-10 lakhs [USD 9,782 to 12,282 (approx.)] by duping customers and misrepresenting their affiliation with the plaintiff, which is clearly a renowned brand. The Court further noted that the said amounts had also been withdrawn surreptitiously by the defendants just before freezing of the bank accounts. Therefore, the Court ordered that the suit be decreed for a sum of INR 50 lakhs [USD 61,143 (approx.)] in favour of the plaintiff and against the defendant Nos. 1 & 2. In addition, litigation costs of INR 3 lakhs [USD 3,669 (approx.)] was also awarded, to be paid by the defendant Nos. 1 & 2 to the plaintiff.

The Court further directed defendant No. 3 to transfer the domain name www.heroelectro.in to the plaintiff. The Court also gave a warning to Yes Bank that they must follow the instructions and order of the Court, and whenever Court orders are received for suspension or freezing of bank accounts, steps should be taken immediately so that the order is not rendered infructuous by the bank's delay, thereby allowing the holders of such bank accounts to withdraw the amounts in the said bank.

Hamdard National Foundation (India) and Anr. vs. Sadar Laboratories Pvt. Ltd.

Forum: High Court of Delhi

Case No.: CS(COMM) 551/2020 and FAO(OS) (COMM) 67/2022

Order dated: 6th January 2022 & 21st December 2022

Issue: Whether an interim injunction/order should also be stayed when the infringement suit is stayed? Whether the defendant's mark "Dil Afza" caused infringement / passing off against the well-known trademark of the plaintiff "Rooh Afza"?

Order: The present suit involved the application under Order 39 Rules 1 and 2 of the Code of Civil Procedure filed by the plaintiffs, seeking permanent injunction, restraining the defendant from infringing their registered trademark "Rooh Afza" and seeking protection against disparagement, dilution and tarnishment of the trade marks, and damages to reputation, etc. This particular case was filed on the ground that the defendant was not only infringing the well-known trade mark "Hamdard" and "Rooh Afza" of the plaintiffs but was also passing off its products as those of the plaintiffs by using the name "Dil Afza". Both parties' respective marks were also registered. However, the plaintiff had filed rectification proceedings to challenge validity of defendant's registration. The Court agreed with the plaintiffs that they, over prolonged periods of time, have acquired immense reputation and goodwill under their trademark 'Rooh Afza'. Further, the Court observed that this goodwill did not extend to the word 'Afza,' neither plaintiff have obtained any separate registration for this specific word/mark "Afza". Therefore, Court opined that the plaintiff's exclusivity is extended only to the complete name 'Rooh Afza,' and not to either of the words constituting the mark. Further, with regard to the defendant's contention that the plaintiff is barred from requesting interim injunction in view of Section 124(5) of the Trade Marks Act, 1999, the Court disagreed and confirmed that an interim order can be passed even if

the infringement suit has been stayed in view of Section 124 of the Trade Marks Act, 1999. It was also held that in the context of a common consumer, the words 'Rooh' and 'Dil' do not denote the same context. It observed that where the suffix is common, the prefix becomes the distinctive feature of the mark, and applying this principle, the Court observed that the prefix 'Rooh' and 'Dil' would not cause confusion due to their different meaning. The Court further observed that since the plaintiffs had failed to show that the word 'Afza' had acquired a secondary meaning denoting only their product 'Rooh Afza,', it could not be said that the defendant's product 'Dil Afza' was passing off as the plaintiff's product and reputation. The Court further observed that no case was made out for an interim order and dismissed the present interim application, with a direction that a true account of sales of 'Dil Afza' syrup be maintained by the defendants during the pendency of the suit. The Court further directed that in light of Section 124(1)(b)(i) of the Trade Mark Act, 1999 the suit of infringement be stayed till the final disposal of the rectification application filed by the plaintiff. However, against the order of the Court, the plaintiff filed an Appeal before the Division Bench. In the Appeal, it was held by the Division Bench that the question of similarity of marks and likelihood of confusion is determined on the basis of their overall commercial impression. However, in viewing whether composite marks are deceptively similar, it is permissible to examine a dominant part of the mark. It was held that the word 'AFZA' – which is a significant part of the appellant's composite trademark – as a part of a trademark in respect of a competing product, is material in determining whether the two competing marks are similar. This is also relevant to determine whether the respondent's intention is to deceptively pass off its goods as those of the appellant. 'AFZA' was also not descriptive of the goods *Sharbat*. In view of the similarities in the packaging/labels/trade dress of the goods, the conceptual similarity between 'DIL' and 'ROOH' (meaning heart and spirit, respectively, and as the words 'heart and soul' are part of commonly used phrase of the English language), recollection of the label of ROOH AFZA would take place in the mind of

an average consumer by looking at the label of DIL AFZA. As such, the impugned order of the Court was set aside by the Division Bench, in favour of the plaintiff-appellants and the defendant-respondent was ordered to not manufacture and sell any product in class 32 under the impugned trademark ‘DIL AFZA’ till the disposal of the suit.

Inter Ikea Systems BV vs. Italica Floor Tiles Pvt. Ltd.

Forum: High Court of Delhi

Case No.: CS(COMM) 628/2019

Order dated: 3rd January 2022

Issue: Whether the *ex parte* interim order, judgement and decree can be stayed or set aside in case of apparent inaction, deliberate omission, and misdemeanour by the defendant’s advocate, especially when the defendant can show sufficient cause and its *bona fides*?

Order: The present applications were filed to stay the order dated 15th December 2019 as well as order and judgement dated 31st January 2020, whereby *ex-parte* ad interim injunction was granted and the suit was decreed *ex parte*, respectively, against the applicant defendants. The applicant-defendant’s foremost argument in this case was that the company name of the defendant No. 1 was Italica Floor Tiles Pvt. Ltd., and its trademark “ITALICA” was registered in the year 2005 in class 19 and in year 2017 in class 11; whereas defendant No. 2 is a company registered under the name Ikaa Granito Pvt. Ltd. It was further stated that the mark “ITALICA” of the applicant defendant is not similar to the mark “IKEA” of the plaintiff, and it was the name of the company of defendant No. 2 that was “Ikaa” and not a registered mark. Further, the applicant-defendant pleaded that they had received the summons issued against them on 20th November 2019 and the matter was listed on 5th December 2019. For the same reason, the applicant defendant informed the Court that they had appointed an advocate for the said case who promised to follow-up with the

case diligently and had also transferred INR 25,000 [USD 305 (approx.)] as his fees for the same but the advocate did not appear on their behalf. It was only in January 2020 when the defendants received a copy of the contempt petition, they realised the scenario. They again appointed another advocate and this time since the applicant defendants belonged from Gujarat, it took some time for them to get all the relevant information regarding the case from this Court. Keeping in mind the whole facts and circumstances and the efforts taken by the defendants, the Court after relying on *G.P. Srivastava v. R.K. Raizada*, (2000) 3 SCC 54 and other landmark judgements, held that the inaction, deliberate omission, misdemeanour of the defendants' advocate should not affect the applicant-defendants' rights and case. It was also noted by the Court that in compliance of order dated 5th December 2019, the defendants had removed the name of Ikaa Granite Private Limited from the LinkedIn account and from the Italica Granite Private Limited's website. Thus, the Court gave another chance to the applicant-defendants to present their case only upon paying cost of INR 40,000 [USD 489 (approx.)] in favour of the plaintiff and INR 15,000 [USD 183 (approx.)] in favour of Delhi High Court Legal Services Committee and to present their written statement within 30 days and directed tenure of two weeks for the payment of the costs. The Court also set aside the ex-parte ad interim order of injunction, judgement and decree observing that it is the right of every party to be heard in a suit, and the plaintiff and the defendants shall both now be able to prove their mettle on the merits of the case.

Jindal Stainless (Hisar) Ltd. vs. Sourabh Jinal and Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 247/2019

Order dated: 3rd January 2022

Issue: Whether the document which ought to be produced in Court by defendant, but is not so produced, be produced at a later stage i.e., at the time of hearing of the case?

Order: The present application has been preferred by the applicant/defendant to bring on record certain additional documents before this Court. The suit between the parties was filed by the plaintiff to seek permanent injunction, restraining infringement of its trademark “JINDAL”, passing-off etc. The documents sought by the applicant-defendant included: a) registration of its trademark “Sourabh Jindal” in classes 16 and 35. b) formation of a limited liability partnership with the addition of MR Sourabh Jindal to a Company/ LLP in the name of Sourabh Jindal LLP. c) an assignment deed by the applicant-defendant assigning its trademark “Sourabh Jindal” to Sourabh Jindal LLP. The Court heard both the sides and observed that the documents sought to be placed by the defendant on record clearly showed that applications for registration of trademarks in Class 35 and 16 respectively were made on 7th June 2019, whereas written statement was filed thereafter on 25th June 2019. Further, it was observed that the fact of having applied for registration of word mark “Sourabh Jindal” during pendency of this suit, was not mentioned in the written statement. However, it cannot be lost sight of that by virtue of interim order dated 15th May 2019, this Court had permitted the defendants to use the said trade/word mark and no restraint order in respect thereof was passed and after receipt of trade mark registration certificate, defendant No. 1 has approached this Court to place the same on record. Moreover, as far as bringing on record the partnership agreement dated 14th August 2020, deed of assignment, receipt of payment of demand draft etc. was concerned, the Court found that defendant No. 1 informed the Court that it created a Limited Liability Partnership company from 14th August 2020 which is run by the named persons and has thereby informed the Court as to the persons responsible in case of fixation of any liability. Further, relying upon the Hon'ble Supreme Court's decision in *Sugandhi (Dead) by Legal Representatives v. P. Rajkumar*, (2020) 10 SCC 706, this Court, without

prejudice, took the additional documents presented by the applicant-defendant on record.

Shree Ganesh Besan Mill and Ors. vs. Ganesh Grains Limited and Anr.

Forum: High Court of Calcutta

Case No.: APO 69/2021, CS 92/2020, and IA No. GA 2/2021

Judgement dated: 24th December 2021

Issue: Whether the respondent's word mark "Ganesh" which was registered without any limitation or condition, prevents the appellants from using the mark "Ganesh"? Whether a common word mark be considered having distinctive character?

Judgement: This is a trademark appeal in this Court's Commercial Division. It is from a judgment and order dated 15th March 2021 read with the order dated 17th March 2021 made by the learned Interlocutory judge on an interim application filed by the respondent plaintiffs, in the suit, *inter alia*, complaining of infringement of their registered word mark "Ganesh" by the appellant/defendants. The suit was initiated in relation to the registration and usage of the word mark 'GANESH.' Both the parties use the word GANESH in all their trademarks and their variants and deal with the same products and same set of consumers. By virtue of registration of the word mark "Ganesh" the respondent seeks to restrain the appellants from using that mark in any manner whatsoever.

The Court observed that the wordmark "Ganesh" is quite common to the flour trade, generic and moreover registration of word mark 'Ganesh' was without any disclaimer, further observing that absence of a disclaimer does not always vest an exclusive right over a word mark. Further it observed that registration for the wordmark in this case appeared to be *prima facie*

invalid on account of the said reasons. The Court further held that Ganesh Grains Limited cannot restrain Shree Ganesh Besan Mill from using word mark 'Ganesh' in an 'infringement action.' Further, the Court opined that Ganesh, a Hindu deity, Son of Maa Durga and Lord Shiva, is most powerful and widely worshiped. Hence, word or mark 'Ganesh' can never be distinctive of any person or trade. It is too common to be so. The Court further observed that any name of God is not distinctive and quite common and is usually not registered as a trademark. The Court further opined that respondents have the proprietary rights over label mark and/or trade dress under which its goods are sold and further focused on a remarkably interesting and important concept that is: 'trade dress.' The Court held that the appellants have imitated the character, size, font and style of writing "Ganesh" and the prominence of "Ganesh" in their label mark also containing the word mark "Ganesh" and colourful designs is such, that the label resembles the trade dress of the plaintiff-respondents, causing deception and confusion in the trade. Comparing the two trade dresses the Court concluded that overall effect of 'trade dress' of Shree Ganesh Besan Mill was quite similar to Ganesh Grains Limited and was bound to cause confusion in trade. Even if case for 'infringement of trademark' fails on plea of 'invalidity' or 'lack of distinctiveness' and 'common use,' a case in 'passing off' would lie. Therefore, Ganesh Grains Limited, *prima facie*, was able to make out a case of 'passing off.' Even if Ganesh Grains Limited had registered trademark 'Ganesh', it could not prevent Shree Ganesh Besan Mill to use the mark "Ganesh" as per Section 35 of The Trade Marks Act, 1999. Further, the Court concluded that order granting blanket injunction restraining use by the appellant of respondent's trademark should be modified to the extent that they will be entitled to use the label mark wherein the word "Ganesh" could not be used in isolation and the words "Shree Ganesh Besan Mill" must be written on the label differently from the style adopted in the respondent's product. Also, the place of manufacture Raipur, Chhattisgarh should be mentioned on the label mark so as not to cause any confusion or deception in the trade.

Manohar Singh vs. Vimal Sehnaaz and Ors.

Forum: High Court of Madras

Case No.: O.A. Nos. 359, 360, 361 and 362 of 2020 in C.S.(Comm. Div.), No.203 of 2020 and A. Nos. 423, 424 and 425 of 2021 in O.A. Nos. 359, 360 and 362 of 2020 in C.S. (Comm. Div.) No. 203 of 2020.

Order dated: 1st April 2021

Issue: Whether the plaintiff can seek passing-off based injunction when the defendant has a registered mark as well?

Order: Four applications were filed by the plaintiff in the suit seeking an order of interim injunction restraining the defendants from passing off their products by using the mark 'BANSURI' or any other mark deceptively or phonetically or visually similar to the plaintiff's mark 'BANSURI' pending disposal of the said suit and for an order of interim injunction restraining the respondents/defendants from infringing the copyright of the plaintiff with respect to the artistic work comprising the 'BANSURI' label and for an interim injunction restraining the respondents/defendants from offering for sale and distributing 'Mehandi' cone or any other cosmetic products using the mark 'BANSURI'; and for an interim injunction restraining the respondents/defendants from infringing the registered trademark of the plaintiff 'BANSURI'. The plaintiff by these applications seeks protection of their copyright and trademark (Logo and Trademark word).

Plaintiff Product:



3rd Defendant's product:



Further, applications were also filed by the defendant to vacate the interim injunctions granted by the Court. The Court held that a *prima facie* case had been made out by the plaintiff and that the balance of convenience was also in favour of the plaintiff, and thus, an order of ex-parte interim injunction as prayed was granted. The Court observed that plaintiff was aggrieved by the usage of the 3rd defendant of the very same mark 'BANSURI', also for Mehendi products and also in the manner in which the said product was marketed.

The Court after analysing the pictorial representations held that a casual would indicate that there is a strong resemblance between the two pictures and there is every possibility of confusion being caused in the minds of the general public who would be misled into thinking that the products of the 3rd defendant are actually the products of the plaintiff, and the resemblance is striking. The Court further noted that since the distribution channels are the same, even traders would be equally confused. Therefore, the Court said that the plaintiff has made out a *prima facie* case owing to their registration of both copyright and trademark. Further, the Court said that even if there is a registered mark in the name of the defendant, the prior proprietor of registration can still maintain an application for passing off. The pendency of the petition before the Intellectual Property Appellate Board for cancellation/invalidation against such a registration will not be a bar to examine the issues relating to injunction, in view of Section 124 (5) of the Trade Marks Act, 1999. The Court directed the 3rd defendant to wait for the decision of Intellectual Property Appellate Board. It was further held that the plaintiff has made out a *prima facie* case and this is strengthened by their registration both under the Trade Marks Act, 1999 and under the Copyright Act, 1957. Any infringement necessarily will have to be struck down by the Court. The Court further observed that the plaintiff has been in the business for a considerable period, running a profitable business and spending large amount of money for their product's/mark's advertisement. Hence, it was held that the 3rd defendant has moved remarkably close to the colour scheme and trade dress of the plaintiff, and thus, the interim injunction was made

absolute, pending the disposal of the suit. Therefore, the Court granted an order of interim injunction till disposal of the suit, in favour of the plaintiff. Accordingly, the Court also dismissed the vacation applications filed by the defendants.

Century 21 Real Estate LLC vs. Alchemist Ltd. and Another

Forum: High Court of Delhi

Case No. CS(COMM) 416/2020 and I.A. No. 8969/2020 (O-XXXIX R-1&2)

Order Dated: 24th January 2022

Issue: Whether the use of the domain names www.century21.in and www.century21.co.in by the defendants after termination of agreement amounts to trademark infringement of the plaintiff's registered mark 'CENTURY 21' ?

Judgement: The plaintiff, a prominent and globally renowned franchisor in the field of real estate is the registered proprietor of the trademark 'CENTURY 21' and runs a global website, www.century21.com since March 2, 1995, which is also accessible in India. The plaintiff entered into a sub franchise agreement (Agreement) with defendant No.1 on December 21, 2012, whereby the latter was granted the exclusive right to use and sublicense 'CENTURY 21' trademark and systems to franchisees in India and defendant no.2 (Century 21 Properties India Pvt. Ltd.) was formed by way of the aforesaid Agreement. The defendants pursuant to the Agreement registered domain names www.century21.in and www.century21.co.in to advertise business under the mark 'CENTURY 21.' However, due to non-fulfilment of commitments under the Agreement, the same was terminated by the plaintiff along with directions for payment of minimum service fee with interest. The defendants acknowledged the termination and admitted liability under the Agreement, however, they continued to renew the domain name registrations and misuse the trademark 'CENTURY 21.' In light of the same, plaintiff filed the suit for permanent injunction restraining infringement of trademark, passing off, rendition of accounts of profits, damages and delivery-up against the defendants.

The Court maintained that the defendants had no real prospect of defending the claim as they had neither entered appearance nor filed their written statement or reply. Additionally, it was maintained that the defendants continued to use the Plaintiff's domain names post termination of the Agreement which amounted to infringement of the plaintiff's registered mark 'CENTURY 21.' The Court observed that the defendant's use of the plaintiff's mark was to benefit from the reputation and goodwill associated with the said name and pass off its services as that of the plaintiffs. Accordingly, a decree of permanent injunction, transfer of the domain name to the plaintiff, change of defendant's name and damages to the extent of INR 24,31,036/- [USD 22,000 (approx.)] was passed in favour of the plaintiff and against the defendant.

H. S. Sahni vs. Mukul Singhal & Others

Forum: High Court of Delhi

Case No: CS (Comm) No. 31 of 2021 and IA Nos. 921 of 2021 & 923 of 2021

Order Dated: 17th January 2022

Issue: Whether the suit filed by the plaintiff was liable to be stayed under Section 10 of the Code of Civil Procedure, 1908?

Judgement: The plaintiff filed a suit against the defendants on grounds that the latter was manufacturing vehicle parts being identical products as that of the plaintiff's business, under the mark "MG Cable" and trade name "MG Cables (India)" which were nearly identical / deceptively similar to the plaintiff's registered trademark MG and M.G.I. being used since 1989 by the plaintiff. It was further contended that the market had grown to associate the trademarks with the plaintiff's products and services.

The defendant, however, contended that the present suit filed by the plaintiff is barred and not maintainable as the prior suit filed by the defendant was of the same issue. The defendant stated that upon receiving the cease-and-desist notice from the plaintiff, the defendant sued the plaintiff for an

injunction against groundless threats which was dismissed. However, thereafter, the defendant resorted to filing another suit against the plaintiff alleging copyright violation of the trade dress of the defendant which culminated in the trial court restraining the plaintiff from using the trade dress 'MG Cable' of the defendants but declined to grant injunction against use of its trademark by the plaintiff. Thereafter, appeals were filed against the order delivered by the trial court by both parties which were pending before the division bench of the Court. The defendant contended that as directions had been issued by the Learned trial court and appeal was pending against the same, the present suit was liable to be stayed.

The Court while placing reliance on case precedent, *Aspi Jal &Anr. v. Khushroo Rustom Dadyburjor* maintained that the language of Section 10 of the Code of Civil Procedure uses a negative expression thereby making the said provision mandatory thus the Court in which the subsequent suit has been filed is prohibited from continuing with the prosecution of the matter. The Court while upholding the decision laid down by the Apex Court in the matter of *Aspi Jal &Anr. v. Khushroo Rustom Dadyburjor* reiterated the fundamental purpose and basic intent behind Section 10 which is to prohibit courts of legislative authority from concurrently entertaining and settling disputes in two parallel litigations in respect of the same reason with a view to eliminate the likelihood of two courts issuing inconsistent orders for the same remedy and to safeguard the respondent from multiple hearings. The Court upon viewing the prayer clauses of the plaintiff and defendant in the pending suits opined that both parties were claiming right to use their respective trademark and alleging that the other side was using a deceptively similar trademark. In light of the same, the Court maintained that concurrent trials would not only lead to plethora of lawsuits but contradictory outcomes such as one party being permitted to utilise its trademarks in the first lawsuit but barred from doing so in the second suit. Thus, in view of the settled law, the Court categorically held that pursuant to Section 10 of the Code of Civil Procedure, 1908, the present suit was liable to be stayed.

Dabur India Limited vs. Shree Baidyanath Ayurved Bhawan Pvt. Ltd.

Forum: High Court of Calcutta

Case No: I.A. G.A. NO. 1 of 2021 in C.S. NO. 232 of 2021

Order Dated: February 08, 2022

Issue: Whether the defendant's advertisements amounted to disparagement of the goodwill and reputation of the plaintiff and its products?

Judgement: The plaintiff filed a suit against an advertising campaign containing five impugned advertisements issued by the defendant one after the other during October and November 2021 in relation to its product "Baidhyath Chyawanprash Special" seeking an order of injunction restraining the defendant from issuing, publishing or uploading the impugned advertisements disparaging the goodwill and reputation of the petitioner and its product 'Chyawanprash' being sold under the trademark "DABUR". The plaintiff contended that it is an admitted fact by the defendants that the impugned advertisements are comparative in nature and as a result such untruthful comparisons are actionable. The plaintiffs contend that a malicious comparison has been made by the defendant in stating that its product is made with '100% pure ghee' whereas plaintiff-petitioner's product is made with a mixture of ghee plus vegetable oil spreading further misinformation and confusion because Dabur uses a mixture of 'til' oil and pure desi ghee based on ancient ayurvedic texts. It was further contended that assuming that that no direct reference is made to Dabur, there still exists a generic disparagement to the entire class of Chyawanprash thus giving a cause of action to the plaintiff as a manufacturer of the product. The plaintiff further stated that the First Schedule to the Drugs and Cosmetics Act, 1940 provides for various ayurvedic texts that may be followed to manufacture Chyawanprash and in none of these texts a Chyawanprash can be made with 42 ingredients and can only be made with a minimum of 47 ingredients. Thus, it was argued that the defendant's reference to '42' was false and amounted to clear disparagement. The plaintiffs contended that the intent and the manner of representation in the impugned advertisements are false and misleading and

deceptive advertising is not protected under commercial speech as laid down in Article 19 (1) (a) of the Constitution of India, however, attracts the application of Article 19(2), which makes it impermissible. The defendants on the other hand argued that its advertisement and right to commercial speech is a part of freedom of speech and expression guaranteed under Article 19 (1) (a) of the Constitution and that as per settled law any restraint or curtailment of advertisements would affect the fundamental right under Article 19(1)(a). It was further argued that consumers may look at advertisements and conclude that one product is superior while some other consumer may look at it from another point and think that the other product is inferior, and the advertisement cannot be restrained. The defendants contended that the plaintiff has attempted to create a monopoly in the market by abusing the process of law and that the plaintiff cannot restrain others from advertising on the ground that they possess larger market share of a particular product. It was argued that comparative advertising is permissible under the law and that the defendant's advertisement is not comparative in the strict sense as the defendant's advertisement only compares the defendant's product with an unnamed fictitious product.

The Court while placing reliance on case precedents arrived at the following observations while determining if the impugned advertisement was disparaging or a mere puffery. The Court opined that (i) while deciding the issue of disparagement the court has to apply the reasonable man test, that is, whether a reasonable man would take the claim being made as being a serious claim or not ; (ii) the impugned advertisement campaign has to be looked into with a broader perspective to decide whether a serious comparison is made by the alleged infringer ; (iii) the comparison in the nature of "Better or Best" based on truthful claims is permitted, but comparison in the nature of "Good v. Bad" is not permitted; (iv) the impact and impression of the impugned advertisements has to be examined and if it gives out an impression that the rival product has a defect or demerit (which is not true) then such impression would make it disparaging ; (v) The comparison between rival products is allowed only to the extent of "Puff" and honest trade practice, and any malicious or deliberate depiction of rival product in a bad taste is not permitted ; (vi) no one can disparage a class or genre of product within which a complaining plaintiff falls and raise

a defence that the Plaintiff has not been specifically identified and comparative advertising campaign should be ‘comparison positive’ and if the advertisements contain valuable information for the consumers and can promote healthy competition in the market, the courts should be resilient and allow the negative derivatives of such comparison. The Court concluded that the comparison made by the defendant is specifically pointing towards deficiency of the other rival products including the petitioner’s product. Moreover, the claim made by the defendant with regard to number of ingredients of the rival product is false and misleading. Further, the Court opined that the defendant’s comparison with respect to the number of ingredients, i.e., the comparison with several ingredients, that is, 42 ingredients, is malicious and slanderous as the product cannot be complete with 42 ingredients and the product of Chyawanprash in the market are all having at least 47 ingredients as per the Drugs and Cosmetics Act, 1940. It was further noted that when the defendant highlights that other Chyawanprash contains only 42 ingredients, which is an untrue statement, it cannot claim the right to free speech as the same is not allowed to communicate untruthful facts about the other rival products. The Court permanently enjoined four out of the five advertisements of the defendants which contained *inter alia* the above noted misleading and disparaging claim on the number of ingredients. However, the court held that the advertisements would be permitted if this misleading and disparaging claim was removed and also the bottle that was shown in the advertisement should only contain the printed word CHYAWANPRASH and no other word.

Sun Pharmaceutical Industries Ltd. vs. Uggapi Tech Solutions P Ltd. and Others

Forum: High Court of Delhi
Case No: CS (COMM) 13/2022
Order Dated: January 25, 2022

Issue: Whether court fees can be refunded to the plaintiff on account of the dispute being amicably resolved out of court by the parties?

Judgement: The suit had been filed by the plaintiff seeking permanent injunction restraining infringement of registered trademark, passing off, unfair competition, rendition of accounts of profits and delivery up, etc. against the defendants. The parties submitted to the Court that the settlement had been amicably reached by both the parties. The plaintiff submitted that since the subject matter of the suit stood amicably resolved, therefore, pursuant to Section 16 of the Court Fees Act, the entire court fees be refunded to the plaintiff.

At the outset, the Court observed that the settlement reached was valid and lawful and that the parties should be bound by the terms of settlement reached between them. The Court also took note of the case laws relied upon by the plaintiff wherein it was held that the Section 89 Code of Civil Procedure shall cover, and the benefit of Section 69-A of the Court Fees 1955 Act shall also extend to all methods of out-of-court dispute settlement between parties which have been arrived at legally and that such sections are to be interpreted in a liberal manner. Considering the same, the Court held that the plaintiff was entitled to a refund of the entire court fees and that the Registry be directed to issue necessary authorization in favour of the plaintiff to seek refund before the appropriate authorities.

Moonshine Technology Private Limited vs. Tictok Skill Games Private Limited and Others

Forum: High Court of Delhi
Case No: CS(COMM) 331/2021
Order Dated: January 31, 2022

Issue: Whether defendant's usage of the plaintiff's registered trademark 'Baazi' was dishonest and resulted in taking unfair advantage of reputation of the Plaintiff?

Judgement: The plaintiff is part of the Baazi Group, renowned in the gaming industry and is a registered proprietor of several variations of marks containing the term 'Baazi' (i.e., PokerBaazi, RummyBaazi, etc.) and has exclusive rights over the same. The plaintiff filed the suit seeking perpetual and mandatory injunction restraining the defendants from infringement of

plaintiff's registered trademarks, passing off, unfair practices, etc., along with costs, damages, delivery up, etc. against the defendant. The plaintiff contended that the defendant, competitor of the plaintiff, dishonestly started using the word Baazi for its services and was passing off their services as that of the plaintiff as they began adding the plaintiff's trademark "Baazi" to their registered trademark "WinZo" i.e., "WinZo Baazi." The plaintiff contended that the act of copying of the word 'Baazi' by the defendant creates confusion in the public's mind and amounts to trademark infringement under Section 29(3) of the Trade Marks Act, 1999. It was further argued that pursuant to section 29 of the Trade Marks Act, 1999, the defendant's use of the word 'Baazi' was not *bona fide*, and the defendant cannot claim defence that it was *bona fide* use. The plaintiff contended that Baazi was not descriptive in nature, and one does not associate it directly with the gaming application and/or the gaming industry. It was contended that several registered users of the plaintiff's online gaming platform associated the term Baazi with the plaintiff's gaming application and the mark had therefore acquired secondary meaning which was being illegally exploited by the defendant. The defendants argued that the term 'Baazi' was used as a descriptive word in 'WinZo Baazi' and was generic in nature as the word translated to game in the Urdu language. The defendant claimed that the use of the term 'Baazi' was of *bona fide* intent.

The Court at the outset while placing reliance upon case precedents held that pursuant to Section 28 of the Trade Marks Act, 1999, the Plaintiff acquired exclusive right to use the registered trademark "Baazi" and its variations. The defendant also had not initiated any invalidation /cancellation proceedings against registration of the said mark of the plaintiff. The Court observed that consumers' interests need to be protected, who rely on trademarks to distinguish the products and services to purchase as trademark signifies the product's origin, and usage of a similar or identical trademark by a competitor in a similar product category would confuse consumers. The Court further observed that the defendant had failed to establish that the usage of the word "Baazi" was honest and was a descriptive word as no clear reasoning was provided by the defendant which indicated the reason towards adopting the term 'Baazi' and further held that the statutory defence taken by the defendant under Section 30 and 35 of the Trade Marks Act, 1999 (pertaining to use being descriptive or *bona fide*)

was inapplicable. The Court maintained that the plaintiff's thriving business will suffer *irreparable loss and injury* on account of the defendant's act and the identical gaming app of "WinZo Baazi" by the defendants would confuse the players, which would damage and impact the plaintiff's reputation. The Court held that the plaintiff had disclosed a *prima facie* case for interim injunction for trademark infringement and for passing off to restrain the defendants from using the mark 'Baazi.' Accordingly, an order of interim injunction was passed against the defendant and in favour of the plaintiff with the direction to the defendant to remove/delete all and any references to or use of the plaintiff's well-known brand and registered mark "Baazi".

Ganesh Gouri Industries and Others vs. R.C. Plasto Tanks and Pipes Pvt. Ltd. and Another

Forum: High Court of Delhi
Case No: FAO (COMM) 18/2022
Order Dated: 28th January 2022

Issue: Whether any corrective action could be taken by the Appellate Court where the Trial Court passed an order for interim injunction and search and seizure, and its jurisdiction to do so/entertain the plaintiff's plaint was questioned and needed to be settled?

Judgement: The Court maintained that upon conclusion of the arguments by the parties, the defendant/appellants shall file an application under Order 39 Rule 4 read with Rules 1 & 2 CPC for vacation of order of ad interim injunction, which shall be responded to by the plaintiff within 3 working days. It further maintained that the Trial Court is directed to dispose of the said application filed under Order 39 Rule 4 read with Rules 1 & 2 CPC within 10 days of filing of the same including on the issue of lack of jurisdiction of the learned Trial Court to entertain the plaint. The Court further clarified that the said applications are to be decided with no reference made to any other application nor should it depend on the outcome of any other application pending as on date or filed subsequently. With the

parties' consent, the Court appointed a new local commissioner who is to visit address of the appellants where the impugned goods and/or material is expected to be found. Thereafter, the Local Commissioner was directed to conduct, *inter alia*, the following which was to (i) de-seal the premises that was sealed as per the directions in the order passed by the Trial Court; (ii) seize and take into custody only those impugned goods i.e., WATER STORAGE TANKS and other incriminatory material bearing the impugned label/trade dress/colour scheme and no other goods; (iii) inspect and sign all books of accounts of the defendants and take a photocopy in physical form and/or electronic form; (iv) the Local Commissioner shall prepare the inventory of the seized goods and take the photography and videography of the seized goods; (v) the Local Commissioner shall seal all the seized goods and hand over the same to the appellant's representatives on *Superdari* after getting an undertaking that the sealed material will be produced before the Court as and when directed; (vi) the representative of respondent no. 1 and their respective counsel, not exceeding 3-4 in number, would be allowed during the execution of the present proceedings of the Local commissioner; (vii) the Local Commissioner is to inform the parties in advance before visiting the premises in question. Thus, the Court while disposing of the appeal and pending application did not delve into the merits of the case and the rights and contentions with respect to the parties were left open.

Western Digital Technologies, INC vs. Sumit Pandey and Others

Forum: High Court of Delhi
Case No: CS (COMM) 240/2021
Order Dated: November 9, 2021

Issue: Whether use of the plaintiff's marks 'Western Digital', 'WD', 'My Passport' and 'My Cloud' by the defendants amounted to trademark infringement?

Judgement: The plaintiff has filed this suit seeking permanent injunction for trademark infringement against the defendant, for use of its registered trademarks "WESTERN DIGITAL", "WD", "MY PASSPORT" and "MY

CLOUD” (Western Digital Trademarks). The plaintiff is a manufacturer of computer storage devices, media players, software and mobile applications sold under the aforementioned trademarks. The plaintiff stated that it registered its marks “WESTERN DIGITAL”, “WD”, “MY PASSPORT” and “MY CLOUD” which have been in use since 1997, 1999 and 2008 respectively. Additionally, the plaintiff owns the domain names www.westerndigital.com, www.wd.com, www.wdc.com, etc. and claims that its marks are ‘well-known’ trademarks on account of long prior use. The plaintiff alleged that defendant registered the domain names “wd-my-passport.com”, “wdmypassport.co” and “support-wdc.com” with the intent to make it appear that they are associated with the plaintiff. The plaintiff claimed that the acts of the defendants were made known upon receiving a consumer complaint wherein it was revealed that the defendant was identifying himself as ‘Western Digital’ and charging money for providing customer service for Western Digital’s products and utilizing the domain name ‘http://www.wd-my-passport.com/.’ The plaintiff claimed that the defendant was deceiving and misleading consumers into believing that there existed genuine association between the parties. The plaintiff further claimed that there were prior lawsuits filed against defendant titled “*Seagate Technology LLC v. Domains by Proxy, LLC/Sumit Pandey*”, and that, in the said proceedings, the WIPO passed an order recording the fact that defendant was operating the domain “www.seagate.support” to mislead users into believing that it was associated with M/s. Seagate Technology LLC. The plaintiff further contended that the defendant was a habitual offender involved in creating domain names of registered trademarks without any consent or authorization from the owners. The plaintiff also prayed that the Court passes an order directing the relevant authority to, upon the plaintiff approaching it, suspend the infringing domain names with any other domain name extensions. Lastly, the plaintiff prayed that the Court decrees the matter in its favour since it was not pressing for damages.

The Court observed that by order dated May 27, 2021, the said Court had on previous occasion found defendant guilty of infringing the plaintiff’s domain names by utilising the domain names of “wd-my-passport.com”, “wdmypassport.co” and “support-wdc.com” and directions were issued against the defendant restraining him from using the said domain names as well as directing defendant no.2 to suspend the said domain names. The

Court further held that the domain names “wd-my-passport.com”, “wdmypassport.co” and “support-wdc.com” stood transferred by WIPO in favour of the plaintiff. The defendant also had no intention to contest the plaintiff’s suit as no appearance was entered on behalf of it. The Court decreed the suit with a permanent injunction maintaining that the use of the domain names by the defendant amounted to clear trademark infringement and held that such infringement would continue to exist if the said domain names were to be used with any other domain name extensions.

TATA Sons Private Limited and Another vs. Chirag Pramod Shah Authorised Representative and Proprietor ANA Realty and Others

Forum: High Court of Delhi

Case No: CS(COMM) 80/2021 and I.A. 3470/2022

Order Dated: March 8, 2022

Issue: Whether the use of the plaintiff’s trademark ‘TATA’ by the defendants amounted to trademark infringement and whether application for a summary judgement in favour of the plaintiff be granted?

Judgement: The plaintiff No.1 is a company duly incorporated in the year 1917 while plaintiff No.2 is incorporated in the year 1962 an integrated engineering consultant, providing concept to commissioning services in various sectors such as power, infrastructure, hydrocarbons and chemicals, mining and metallurgy etc. and is a 100% subsidiary of plaintiff No.1. Plaintiff No.1, its group companies, subsidiaries including the companies promoted by it have laid its foundation in the industrial core sector, textiles, iron and steel, automobiles, etc. and have also branched into computers, computer software, electronics, telecommunications, broadcasting, aerospace, to name a few. The plaintiff submits that the TATA companies, was most recently announced to be India’s most valuable brand and illustrated the immense goodwill, repute and fame associated with its business activities under the marks TATA and the 'T' within a circle device. The trademark TATA is derived from the surname of plaintiffs' founder and

is a rare patronymic name possessing the distinctiveness of an invented word. It is averred that plaintiffs are the owners and registered proprietors of well-known trademarks TATA as well as 'T' within a circle device mark and various other TATA formative marks by virtue of priority in adoption, long, continuous, and extensive use as well as advertising and the reputation consequently accruing thereto in the course of trade. Plaintiff No.1 has licensed plaintiff No.2 to use the said marks by virtue of a License Agreement dated 20.01.2010, also known as Brand Equity and Business Promotion Agreement. The trademarks have only been used by the plaintiffs and their group companies, subsidiaries, etc., and they are all consistently recognised as being a source indicator for goods and services coming from the plaintiffs and the "House of Tata." Further, the aforementioned marks have been recognised as well-known trademarks by this Court and the Trade Marks Registry in a number of judgements. The trademarks described above, and the devices are recognised as well-known trademarks under the provisions of Section 2(1)(zg) read with Section 11(6) of the Trade Marks Act, 1999, according to a list of well-known trademarks filed by the plaintiffs and maintained by the relevant Trademarks Registry. The plaintiff's registrations in classes 37 and 42 were also placed on record. The plaintiffs state that on October 23, 2013, plaintiff No.2 and the defendants entered into a formal agreement by way of a Letter of Intent whereby plaintiff No.2 agreed to provide integrated design consultancy services to the defendants for their project titled ANA Realty. Further, it was argued that plaintiff No.2 never authorized the defendants to use the plaintiff's well-known trademarks TATA, in any form or manner. Thereafter in the year 2020, the plaintiffs came to know that the defendants were unauthorizedly using the trademark TATA on their hoardings as well as online social media pages. The plaintiffs intended to resolve the matter amicably, however, the defendant continued to violate the plaintiff's rights by continuing to use the plaintiff's trademarks and copyright. As a result, the plaintiff filed the suit for permanent injunction restraining the defendants from using its well-known trademark TATA as well as its registered copyright. Subsequently, the Court after hearing the parties on February 24, 2021, passed an ad-interim injunction order against the defendants by which the offending marks were taken down from the defendant's social media pages. The plaintiff further submitted a plethora of cases to support their claim for a summary judgement. At this juncture,

the defendants submitted that they had discontinued and taken down plaintiffs' well-known trademark TATA as well as the 'T' within a circle device from all platforms such as hoardings, online and physical materials. As the defendants were also willing to suffer an injunction in case the plaintiffs gave up their claim for costs and damages, the Court allowed the plaintiff's application seeking summary judgement.

The Court while allowing the application decreed the suit in favour of the plaintiffs and ordered for a permanent injunction restraining the defendants, their partners or proprietors, as the case may be, its officers, servants and agents from manufacturing, selling, offering for sale, supplying, advertising, directly or indirectly dealing in any business unauthorisedly using the plaintiffs' well-known trademark TATA and and/or any mark(s) confusingly or deceptively similar to the said marks amounting to passing off of the defendants' services / goods as that of the plaintiffs as well as restrained the defendants from engaging in any act whatsoever that would result in the dilution and tarnishment of the plaintiff's well-known trademark TATA, and lastly directed the defendants to immediately stop using and to take down all references to the plaintiff's well-known trademark TATA and from its website, Facebook, Instagram and other online platforms as well as from the physical hoardings of the defendants.

Modicare Limited vs. Registrar of Trademarks

Forum: High Court of Delhi

Case No: C.A.(Comm. IPD-TM) 9/2022, I.A. 745/2022, C.A.(COMM. IPD-TM) 11/2022, I.A. 969/2022 and C.A.(COMM. IPD-TM) 4/2022

Order Dated: April 19, 2022

Issue: Whether the Trade Marks Registry can refuse the mark 'Achievers Academy' on the basis of several marks which have been cited in the examination report, which have the word 'ACHIEVERS ACADEMY'?

Judgement: The appellant filed the appeals challenging the impugned orders of the Trade Marks Registry which refused the applications of the

appellant in classes 35 and 41 for the word and device mark of 'ACHIEVERS ACADEMY'. The appellant was stated to be involved in direct selling business in India since 1996 and had more than 50 lakh active consultants catering to over 2700 cities across the world and had adopted the device mark of 'ACHIEVERS ACADEMY' in 2015. The said mark was coined in respect of events/programs done for honouring its high achieving consultants to boost their confidence, the intent behind the same was as a human resource measure to recognise the achievements of the consultants in fulfilling their metrics and targets. It was submitted that the said mark was registered in class 35 as a device mark and in class 45, both as word mark and device mark. The appellant argued that the mark 'ACHIEVERS ACADEMY' had been rejected by the Registrar of Trademarks based on several marks which had been cited in the examination report, which have the word 'ACHIEVERS ACADEMY'. The appellant argued that most of the cited marks in the examination report were not in use and that they were using the mark 'ACHIEVERS ACADEMY' with the house mark of the appellant being 'MODICARE'. It was further submitted that the mark 'ACHIEVERS ACADEMY' had been extensively used by the appellant since 2015 and had acquired distinctiveness with a high turnover and rejection of the mark would cause grave injustice to the appellant. The respondents in response argued that there are identical applications /registrations of the mark 'ACHIEVERS ACADEMY' which were stated in the examination reports.

The Court observed that the cited marks in the examination report were identical/similar applications / registrations for the mark 'ACHIEVERS ACADEMY/ACHIEVERS', however, it was also observed that some of the marks had been removed from the Register while the others were not being used by their respective proprietors. The Court took note of the remaining marks consisting of either the word 'ACHIEVERS' or 'ACADEMY' and stated that the appellant in any case has used the mark 'ACHIEVERS ACADEMY' along with the house mark 'MODICARE'. The Court also emphasized the fact that the turnover of the appellant by the usage in its direct selling business was high. The Court thus held that the applications filed by the appellant should be permitted to proceed for advertisement subject to the conditions that (i) the house mark 'MODICARE' shall be added, by filing a specific form by the appellant, as a prefix to the mark

'ACHIEVERS ACADEMY; (ii) the application shall be associated with the appellant's existing registered trademarks in classes 35 and 45 and (iii) the description of the goods in the applications be confined to direct selling business as specified in the order of the Court. Further, the Court held that if any third party opposes any of the marks of the appellant, the same shall be adjudicated in accordance with law without being affected by the observations made by the Court. Thus, the Court disposed of the pending applications and appeals in the above terms.

Global Car Group Ltd. and Anr. vs. Mohit Goyal and Anr.

Forum: High Court of Delhi


Case No.: CS(COMM) 709/2021 & I.A. 17520/2021

Order Dated: 19th January 2022

Issue: Whether the plaintiff was entitled to injunction against defendants for infringement of its “24 Formative word marks” and “24 Formative marks”?

Order: In the present suit even after many attempts to contact the defendants, they failed to appear in the Court and hence, the present order was passed *ex-parte*. The plaintiff is a registered proprietor/owner of the marks (A) “Cars24”, “Auction24”, “Funding24”, “Unnati24” and

“Bikes24” and (B)  ,  ,  ,
 ,  ,  ,  and  . The

defendants were using the mark “Drivers24” and  . The plaintiff was incorporated in 2015 as an e-commerce company and is engaged through its subsidiaries across the globe. Its sales turnover was around INR 30,000 crores [USD 3,656,004,134 (approx.)] for the financial year 2019-2020 in respect of its 24 Formative Marks and it also put substantial amounts of investments in promotions and advertising in India. An application for registration of its mark was filed by the defendant but it

was later abandoned. However, the defendant adopted a similar mark with same colour scheme, and the plaintiff had also sent a cease-and-desist notice to them to which the defendants failed to reply. The plaintiff acknowledged that no one could claim statutory right over the number '24' but in this case it was about the combination of the words "Cars" and "24". The use of such words with number 24 had gained reputation and association with the plaintiffs. Thus, it was contended that defendants' marks "Drivers24" and

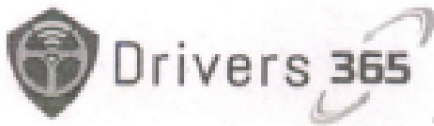


would cause confusion in the minds of consumers with average intelligence. Therefore, the use of such marks by the defendant in relation to identical business constituted infringement of the plaintiff's trademarks.

The Hon'ble Court held that the plaintiff has *prima facie* established infringement of its statutory rights over its 24 Formative Marks. It was also held that balance of convenience lies in favour of the plaintiff as it would suffer from irreparable loss and injury in case the interim injunction was not granted in respect of restraining the defendants from using similar/identical marks. Thus, the Hon'ble Court ordered the defendants, their franchisees, business partners, subsidiaries etc. to refrain from selling, offering for sell, advertising, directly or indirectly dealing with any product or services under the infringing marks. The defendants were also directed to remove /delete their social media accounts and listings on third-party e-commerce websites maintained under the domain name of infringing marks. The defendants were directed to suspend their mobile application and website www.drivers24.com as well.

During the pendency of the suit, the parties finally arrived at a settlement vide Settlement Agreement dated 30th March, 2022 under the aegis of the Delhi High Court Mediation and Conciliation Centre. As per the settlement terms, the defendant agreed to stop the use of the impugned mark 'Drivers24' and plaintiff's 24 formative marks. the defendant also adopted a different mark 'Drivers365' with a new logo. the defendant acknowledged

the plaintiff's prior and undisputed statutory and common law rights for its 24 formative marks and also undertook to not adopt any mark which is identical and/or deceptively similar to the plaintiff's marks. The defendant further undertook to transfer the infringing domain name www.drivers24.in to the plaintiff and the new logo adopted by the defendant is



Western Infrabuild Products LLP vs. Western Steel India and Anr.

Forum: High Court of Delhi

Case No.: CS(COMM) 562/2021

Order Dated: 5th January 2022

Issue: Whether Section 89 of the Civil Procedure Code, 1908 and Section 69-A of the Court Fees Act, 1955, regarding entitlement of refund of Court fees applies to out of the Court settlements?

Judgement: The present suit was filed by the plaintiff against the defendants for infringement of copyright, trademark/trading name/corporate name, passing off, unfair competition, delivery up, damages etc. However, both the parties agreed on an out of Court settlement amicably and decided to refund the Court fees to the plaintiff as per section 16 of the Court Fees Act, 1955. The Court also relied upon the Supreme Court judgement of *The High Court of Judicature at Madras rep. by its Registrar General vs. M.C. Subramaniam [(2021) 3 SCC 560]* wherein Section 89 of the Civil Procedure Code, 1908 and Section 69-A of Court Fees Act, 1955 was discussed at length. It was decided by the apex Court that since the parties have saved the State's resources and time by cutting short litigation and coming to an amicable settlement, they are a beneficiary under section 69-A of the Court Fees Act, 1955. In the present case, the Court also took note of the case laws relied upon by the Plaintiff and held

that the Plaintiff is entitled to refund of entire Court fees and that the Registry be directed to issue necessary authorization in favour of the Plaintiff to seek refund before the appropriate authorities.

Colorbar Cosmetics Pvt. Ltd. vs. Faces Cosmetics India Pvt. Ltd. and Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 228/2022

Order Dated: 11th May 2022

Issue: Whether the plaintiff was entitled to an ad interim injunction in consequence of infringement of its statutory rights over its trade mark “VELVET MATTE” by the defendants?

Order: The plaintiff filed the present suit against the defendants on account of infringing its statutory rights over its prior and registered mark ‘VELVET MATTE’. Plaintiff had adopted the mark “VELVET MATTE” in respect of cosmetics including *inter alia* lipstick, lip gloss, liquid pre-makeup base, lip colour, lip liner, in 2009 as a sub-brand/ mark under the umbrella of its brand/house mark ‘COLORBAR’. The plaintiff then registered the mark “VELVET MATTE” bearing registration no. 3370299 in class 3 and applied on 22nd September 2016, with a user claim since 12th August 2009. The sale of the plaintiff’s products under the said trade mark “VELVET MATTE” for the year 2020-2021 was more than INR 687 Lakhs [USD 837,411 (approx.)] with promotional expenses of INR 1,496 Lakhs [USD 1,823,532 (approx.)] for the year 2021-2022. The defendants started using the mark “VELVET MATTE” for the same class of goods. On 16th November 2021, the plaintiff issued a cease-and-desist notice to the defendants to refrain from using the said mark and to which the defendants replied that the products under the marks are not similar and the words “VELVET MATTE” are common to trade and descriptive.

Actually, the defendants had changed their stand from willing to give up the mark “VELVET MATTE” to not doing so. The Court observed that the intention of the defendants was to gain time and avoid an injunction. Thus, the Court held that firstly, the plaintiff is a prior and registered proprietor of the mark “VELVET MATTE” and the balance of convenience lies in favour of the plaintiff as it would face an irreparable loss and injury if injunction was not granted to the plaintiff. Although the defendant was using the mark ‘FACES CANADA VELVET MATTE’ and the plaintiff was using the mark ‘COLORBAR VELVET MATTE’, there was not much difference practically, as a search on an e-commerce platform for “VELVET MATTE”, would also show up the defendant’s product. It was also stated by the defendants that there were many sellers/manufacturers selling their products under the same mark to which the Court relied on the case of *Info Edge (India) Pvt. Ltd. v. Shailesh Gupta* [2002 SCC OnLine Del 239] and held that if the plaintiff did not assert its right over another third-party using their mark, it did not take away the plaintiff’s right to assert statutory right over another third-party using their mark, in this case, the defendants. Further, the Court by stating the decision in the case of *Automatic Electric Limited v. R. K. Dhawan* [(1999) 77 DLT 292] held and observed that the defendants using the mark “VELVET MATTE” and having applied for its registration as a trademark is estopped from now saying that the same is a generic term. Thus, considering the injunction granted to the plaintiff, it was held by the Court that the defendants shall stand restrained from selling, manufacturing, and offering for sale cosmetics under the said trademark “VELVET MATTE” or a similar trademark and shall also take down any products listed by them on e-commerce platforms under the said mark.

Astral Poly Technik Ltd. vs. Dharti Pipe and Ors.


Forum: High Court of Delhi

Case No.: CS (COMM) 59/2021 and I.A. 1600/2021

Order Dated: 20th April 2022

Issue: Whether the plaintiff is entitled to injunction against the defendants for infringement, passing off and counterfeiting of its trademarks “ASTRAL” (word and logo)? Whether plaintiff’s mark “ASTRAL” (word and logo) can be considered as well-known?

Judgement: The present case was filed by the plaintiff seeking declaration and injunction against the defendants restraining the infringement of their

mark “ASTRAL” and ‘ **ASTRAL**’, in class 17 in respect of pipes, parts, and fittings thereof. The plaintiff was using the said mark since 1996 and claimed to have sales of more than INR 2000 crores [USD 243,787,600 (approx.)] in the year 2019-2020 with more than INR 70 crores [USD 8,532,566 (approx.)] spent on advertising and promotion of the said mark/s. The plaintiff further claimed that the said trademark was “well-known”. The plaintiff had filed a suit before the District Court, Surat, Gujarat in August 2019 against the defendants for using a deceptively similar mark “ARSTAL” and was granted ad interim injunction till the disposal of the suit, for passing off. Despite this, the defendants continued to manufacture and sell products under the mark “ARSTAL”. Thereafter, it was realised by the plaintiffs that the defendants were also using the identical mark “ASTRAL” amounting to counterfeiting and hence, the present suit was filed. It was observed that though the word “ASTRAL” has a dictionary meaning, it was registered as an arbitrary mark and later its variants were also registered in various classes of interest by the plaintiff. In the present suit, the plaintiff was granted an *ex parte ad interim* injunction by the Court stating that the defendant’s mark “ARSTAL” was deceptively similar to that of the plaintiff’s mark “ASTRAL” (word and logo) and could cause likelihood of confusion. Further, various goods were seized from Defendants under the mark “ASTRAL” which amounted to counterfeiting.

However, in this case both the parties came to an amicable settlement wherein the defendants had accepted the injunction granted against them and the defendants were allowed to sell the seized goods after effacement of the impugned marks on them. Further, the Court according to the decision in the case of *Munish Kalra v. Kiran Madan* [C.S. (OS) 2940/2014, decided on 8th April 2019], directed that the entire Court fees be refunded to the plaintiffs, considering the parties had resolved their disputes amicably. In regard to declaring plaintiff's mark to be well-known and defendants conceding to a decree, the said issue was left open for the plaintiff to assert the same in another case if need be.

Snapdeal Pvt. Ltd. vs. Godaddycom LLC and Ors.

Forum: High Court of Delhi

Case No.: CS (Comm.) No. 176 of 2021

Order Dated: 13th July 2022

Issue: Whether the plaintiff is entitled to permanent injunction restraining the infringement of its trademark by the defendants through the offering of various domain names incorporating the plaintiff's mark "Snapdeal"?

Judgement: The present case is filed by the plaintiff to seek permanent injunction against the defendants restricting the infringement, passing off, unfair trade practices, damages, rendition of accounts and other reliefs. The plaintiff in the present case is a registered proprietor of the trademark "Snapdeal"/ "Snap Deal" and its other formative marks whereas the defendants nos. 1 to 32 are Domain name Registrars (DNRs), defendant no. 33 is the Department of Telecommunications (DoT), and defendant no. 34 is the National Internet Exchange of India (NIXI). The suit is instituted as various domain names containing the plaintiff's mark "Snapdeal" are being registered by the DNRs. Earlier, in the present suit, as per one of the reliefs in IA No. 5407 No. 2021 under Order 39 Rule 1 and 2 of the Code of Civil procedure, 1908, it was held on 18th April 2022 that such a wide order,

without identifying the specific domain names, cannot be granted and for every domain name a specific relief has to be sought by the plaintiff after identifying the domain name. It was also observed that the plaint then filed by the plaintiff was akin to a *quia timet action* which basically means ‘before any injury has occurred, a suit can be filed to restrain an anticipated wrong or tort, and the Court if satisfied, it may issue a *quia timet injunction*’. However, it cannot be granted to the plaintiff in the present case as under the Trade Marks Act, 1999, under Section 29, Infringement means and envisages the “use of a mark” which infringes the registered mark of another and a *quia timet* action cannot be predicated on hypothetical or imaginary infringements for every prospective alternative domain name containing the word/thread/string ‘Snapdeal’ in an omnibus and global fashion; and an allegedly infringing mark must be clear and identifiable. Thus, the plaintiff has to necessarily petition the court against each domain name that it finds to be infringing.

In the present case, it was submitted by defendant no. 1 that GoDaddy has an abuse policy which enables trademark owners to fill up a form to seek suspension/locking of the domain name complained of. To this, the Court held that merely having an abuse policy would again bring the parties to Court and not resolve the matter. Thus, the Court directed the DNRs to create a mechanism for the owner of the trademark to enable them to seek cancellation/transfer of the infringing domain name through the DNR itself. Such a mechanism should be fair, impartial, and independent. If this fails, then the owner can seek remedies in accordance with the law in an appropriate forum. Further, the Court also directed that such mechanism can be set out by the DNRs through officials based in India, and they will ensure that if the owner is not satisfied or is refused the suspension/transfer/cancellation of the infringing domain name, the owner can approach the Court against the decision of the DNR. Further, the Court instructed defendants 1 to 4 to file an affidavit as to whether the said mechanism can be put in place. The Court also directed that instructions will be sought from the DoT the way all DNRs, even though based outside

India but offering its services and earning revenues in India, would implement orders passed by the Courts in India.

V.R. Industries Pvt. Ltd. vs. Mohan Meakin Ltd. and Anr.

Forum: High Court of Delhi

Case No.: CS(Comm) No. 485/2018

Order dated: 29th January 2021

Issue: Whether the plaintiff is entitled to any injunction against the defendants for infringement and/or passing off its mark “8AM”, despite concealment of material facts from the Court?

Judgement: The present case was filed by the plaintiff to seek injunction against the defendant for infringement of its trademark “8AM”. The plaintiff claimed to be a prior user and proprietor of the trademark “8AM” for manufacturing and selling of food items like corn flakes, muesli, cereals etc. and claimed to have been engaged in this business since 1986. According to the plaintiff, the mark was a coined and adopted trademark since 1st May 2004 and had been in continuous use since then and the plaintiff was the registered thereof. It also claimed to be the proprietor of various other marks in relevant classes of interest. The plaintiff also alleged that the defendant was using a similar/identical mark “8AM Corn Flakes (Label)”. The matter was initially heard *ex parte*, and the defendants were restrained from using the mark ‘8AM’ or a confusingly similar mark in any manner. Later, after the defendants appeared, they denied all the statements made by the plaintiff and claimed to be the prior user of the mark “Mohun’s 8AM Corn Flakes” since January 2004 of which it became the registered proprietor in class 30 in August 2005. The defendant also stated that the plaintiff had concealed various material facts while applying for an interim injunction which was erroneously granted, including the fact that the plaintiff’s director was employed with the defendant no.1 and was living with his family in the defendant no.1’s premises and was fully aware of the

adoption and use of the mark “Mohun’s 8AM Corn Flakes” by the defendant no.1 till shortly before the institution of the suit.

The Court observed that the plaintiff had concealed material facts which should have been disclosed and put up for the Court to decide if they were material facts or not. Thus, the Court held that the plaintiff did not come with clean hands while seeking interim injunction, even for a case of passing off, which disentitled the plaintiff of any equitable relief of injunction and thus, the previous interim injunction granted to the plaintiff against the defendants was vacated. It was also observed that the plaintiff admitted that the defendants were registered proprietors of the mark “8AM Corn Flakes (Label)” which was applied on 23rd August 2005, 8 years prior to the institution of this suit. The plaintiff, by concealing the above fact of association with the defendant, also evaded positive plea of not having knowledge by virtue of association with the defendant no. 1, of use of the mark by the defendant. The Court further held that the two marks “8AM” and “Mohun’s 8AM Corn Flakes” would not entail confusion as they were distinguishable, and no irreparable injury was made out by the plaintiff. It was also held that the plaintiff was not able to *prima facie* establish its claimed prior use of the mark.

Red Bull AG vs. Pepsico India Holdings Pvt. Ltd. and Anr.

Forum: High Court of Delhi

Case No.: CS (Comm.) No. 1092 of 2018, IA No. 11452 of 2018 (Order 26 Rule 9) and IA No. 8931 of 2019 (under Section 124 of TM Act)

Order Dated: 6th April 2022

Issue: Whether a case for grant of injunction can be made out against the defendant’s use of the tagline “Stimulates Mind. Energises Body”, claimed to be deceptively similar to the plaintiff’s registered trademark/tagline “Vitalises Body and Mind”.

Judgement: The present case was filed by the plaintiff to restrain against passing off and infringement of the plaintiff's tagline "Vitalises Body and Mind" by the defendant's use of the tagline "Stimulates Mind. Energises Body" in respect of energy drinks. The plaintiff also asserted that it was a prior registered proprietor of the tagline "Vitalises Body and Mind". The Court placing reliance on the landmark judgement in *Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd. (2004) 6 SCC 145* concluded that the product of both the parties in terms of the layout of the cans, the manner of depiction and use of their taglines on the products, and the colour scheme of the two sets of products were different from each other, and the brand names "RED BULL" and "STING" were prominently displayed on their respective products. Thus, it was held that the case of passing off was not made out.

As regards the claim of infringement, the Court relied on various landmark judgements and held that the plaintiff's tagline was descriptive and laudatory. The same objection was raised in their examination report whereby the Registry had raised an objection that the plaintiff's mark/tagline was descriptive of quality of the product. It was also observed by the Court that the defendants had not registered their tagline and in comparison, on their product the tagline was in small fonts whereas its brand name "STING" was prominently visible. Thus, it was held that no infringement had been committed by the defendants under Section 29 of the Trade Marks Act, 1999.

Further, the Court observed that the present case was squarely covered by two landmark judgements of *Marico Ltd.* case and *Stokely Van Camp Inc.* case and held that the tagline of the plaintiff and that of the defendant were descriptive in nature thus, the plaintiffs were not entitled to any interim injunction. It was also held that since the product of the defendants was launched in October/November 2017, and the suit was filed in 2018, and since no injunction had yet been granted in favour of the plaintiffs which further led to defendants using their tagline and product in the market for

almost 5 years, and the plaintiffs failed to establish the irreparable loss that would be caused to them if no injunction was granted, therefore, the balance of convenience was in favour of the defendant and interim injunction was denied.

In regard to secondary meaning/acquired distinctiveness, the Court on the basis of *Bharat Biotech International Ltd. vs. Optival Health Solutions (P) Ltd.* held that the expenses shown by the plaintiff in regard to promotion and sales, at this point could not be segregated into the sole expenses for the tagline, and thus it could not be established at this stage whether the plaintiff's tagline had acquired distinctiveness and secondary meaning. The Court opened a window for the plaintiff and directed that the same could only be established as a matter of trial. In light of the above, the application for injunction under Order 39 Rules 1 and 2 of the Civil Procedure Code, 1908, was dismissed.

Prateek Chandragupt Goyal vs. State of Maharashtra, through Vishrambaug Police Station and Anr.

Forum: High Court of Bombay

Case No.: Criminal Writ Petition No. 62 of 2021

Order Dated: 20th April 2021

Issue: Whether the two articles written by the petitioner on 27th March 2020 and 11th June 2020 wherein the registered trademark of Sakal Media Group was printed could fall within the definition of 'goods' or 'service' under section 2(1)(j) and (z) of the Trade Marks Act, 1999? Whether the petitioner was liable under Sections 101, 102 and 103 of the Trade Marks Act, 1999?

Judgement: The present case was filed by the petitioner for quashing of FIR filed on 16th September 2020 for allegedly committing the offence of Section 103 of the Trade Marks Act, 1999 which states the penalty for

applying false trade marks, trade descriptions etc. It was contended by the petitioner that the ingredients of the said offence were not made out in the present case. The petitioner was a journalist working with online news portal 'NewsLaundry' and had earlier worked with other Media entities including 'Sakal Times'. The said FIR had been registered by respondent no. 2 on the ground that the petitioner had falsely applied the trade mark of the Sakal Group in two articles authored by him published on 27th March 2020 with the heading '*The future is bleak: Sakal Times staffers say they have been sacked in violation of Maharashtra order*' and the other one on 11th June 2020 with the heading '*They wanted to get rid of us: over 50 people laid off as Sakal Times closes down*'. The respondent's stand was that such use of the trademark of its organization amounted to falsely applying the said trademark, thereby resulting in the offence under Section 103 of the Act. The Counsel for the petitioner submitted that since respondent's trademark was not applied in relation to either any goods or any services, the same indicated that there was no question of falsely applying the trade mark. It was also submitted that the action of the petitioner was protected as a nominative fair use of the trade mark of the respondent under Section 30 (1) (a) and (b) of the Act and further informed the Court that the respondent no.2 had already initiated a civil proceeding in the form of a suit for injunction and any other grievance should also be dealt with in the appropriate Civil Court. The respondent submitted that mere clicking on the word 'Sakal' online led to the link of the above-mentioned articles on the online news portal of 'NewsLaundry' which were authored by the petitioner. It was also averred by the respondent that since the unauthorized use of its mark(s) by the petitioner projected the respondent unfairly and in a negative light, its use was not entitled to any such protection of nominative fair use.

In this case, the Court held that the articles authored by the petitioner and published by the online news portal 'NewsLaundry' neither qualify as 'goods' nor 'service' as the respondent's mark used by the petitioner was

not in context of any ‘goods’ or ‘services’. It was further held that merely because a search of the word ‘Sakal’ led to the link of these two articles, it could not be said that the petitioner had falsely applied the trade mark to any goods/services. The said articles were published on a different portal and there was no suggestion that the said portal was that of the respondent. Therefore, in the absence of the ingredients of the offence under Section 103 of the Act, the FIR could not have been registered.

It was further held by the Court on the basis of the ratio in *State of Harayana vs. Bhajanlal 1992 Supp (1) SCC 335* that by a mere reading of the provision of the Trade Marks Act and applying it to the present facts and circumstances, if it cannot be said that the ingredients of Sections 101, 102 and 103 are demonstrated then the FIR deserved to be quashed. Further, it would be unnecessary to go into alternative contention raised by the petitioner of nominative fair use of the trade mark under Section 30 of the Act.

VST Industries Ltd. vs. Rudra Ventures Pvt. Ltd. and Ors.

Forum: High Court of Delhi

Case No.: IA No. 11874 of 2021 and CS (Comm) No. 369 of 2021

Order dated: 7th January 2022

Issue: Whether the defendants are entitled to use the trade mark “TOPAZ”, with a similar trade dress and packaging as that of the plaintiff under its mark “TOTAL”? Whether the defendants are liable for infringement of the plaintiff’s trademark and passing off its goods as those of the plaintiff?

Order: The present application is filed on behalf of the defendants against and for vacation of the order dated 10th August 2021 vide which *ex parte ad interim* injunction was granted in favour of the plaintiff against the defendants for infringement of plaintiff’s mark ‘TOTAL’ or ‘TOPAZ’ or any other mark deceptively similar, written in same style and font as that of

the plaintiff. The plaintiff claimed to be the user and owner of the mark “TOTAL” since 2015 whereas the defendants claimed to be the user of the mark “TOPAZ” since 2011 and became the registered proprietor of the mark in 2015. The plaintiff claimed that the present case was not due to any similarity between the marks/words “TOTAL” and “TOPAZ” but due to the deceptive similarity between the trade dress i.e., the packaging of the two sets of products. The Court observed that to grant *ex parte ad interim* injunction, only a *prima facie* view had to be considered and deep investigation of merits need not be done. A preliminary objection was raised by the defendants regarding the delay in filing of the suit by the plaintiffs and that the order for injunction needed to be set aside. The Court held that the plaintiff took the argument of not being aware of the defendant’s similarly packaged products until June 2021 and the Court also observed that since the product in question was cigarette, the same was not advertised by companies manufacturing/selling them as it was prohibited and thus, a hyper technical view on the aspect of delay need not be taken. Further, with regard to the trade dress/packaging of the defendant’s product when compared to the plaintiff’s product, the Court held that the golden dot in the middle of the cigarette bud was common to trade and the plaintiff could not claim proprietary rights over the same. The Court further held that the design and packaging of the defendant’s cigarettes was similar to that of the plaintiff. Regarding the statutory health warning message, the Court did not find it fit to discuss or compare the same in this matter, being a regulatory requirement. Further, the packaging on the inside, the foil paper, the font in which the plaintiff’s use of words “Dual Flavor” and the defendant’s use of the words “Twin Flavor” were depicted were also held to be very similar among the two sets of goods. After observing the packaging in detail, the Court upheld the restraint order in favour of the plaintiff and against the defendants. The Court directed the defendants on their submission that cigarettes are perishable items, that the cigarette sticks seized by the Commissioner from the defendants be released and allowed to be sold

outside India with fresh packaging and also directed the defendants to maintain a proper sales account through an affidavit.

DRS Logistics (P) Ltd. and Another vs. Google India Pvt. Ltd. and Others

Forum: High Court of Delhi

Case No.: CS(COMM) 1/2017

Order Dated: 21st April 2022

Issue: Whether there is a possibility of vicarious liability being attracted in contempt proceedings?

Order: In this case applicants are the plaintiffs in the suit seeking permanent injunction against the defendants, in which the applications were filed for interim relief and order dated 30th October 2021 allowed the same. The order was to the effect that the defendants would investigate any complaint made by the plaintiff alleging use of its trademark and its variations as keywords resulting in the diversion of traffic from the website of the plaintiff to that of the advertiser; they will also investigate and review the overall effect of an Ad to ascertain that the same is not infringing/passing off the trademark of the plaintiff; and if any such infringement is found to take place they will restrain the advertiser from using such trademark and will also remove/block such advertisements. The contempt application in present suit had thereafter been moved alleging that the defendants/contemnors had violated the order dated 30th October 2021. According to the plaintiffs, when they sought to conduct a Google search with the keywords ‘AGARWAL PACKERS & MOVERS and AGGARWAL PACKERS & MOVERS’, they were shocked to see that the Search Engine still reflected the third parties’ sponsored links with the use of the said keywords. Also, nowhere on their websites, the marks ‘AGARWAL/ AGGARWAL/ AGARWAL PACKERS & MOVERS/ AGGARWAL PACKERS & MOVERS’ in conjunction with each other were listed and despite this, such third parties’ websites appeared on the top

results of Google. This according to the plaintiff was a violation of the interim injunction and a notice was addressed to the defendants/alleged contemnors on 29th November 2021.

The Court observed that as regards the defendants who had received the orders, it could not be considered in a summary fashion whether there was any wilful disobedience at the present stage. The Court further held that it would be for the defendants No. 1 and 3 to state and disclose to the Court, as to who received the orders on their behalf and who would have the obligation to implement these orders within the organization to enable the Court to take a considered decision and see whether to proceed against them or not. The Court further held that contempt applications are *quasi* criminal proceedings, and the response of the alleged contemnors need to be brought on record and at least one opportunity in this regard can be accorded to them. About the other defendants/alleged contemnors being the Directors of the defendants' companies, the plaintiff's application and the order dated 30th October 2021 of the Court was silent and the Court relying on the Supreme Court's judgement in the "*Dr. U.N. Bora case*," observed that vicarious liability in contempt proceedings cannot be attracted. Therefore, the Court directed that none of these other alleged contemnors, need to be even issued notice on the application. It was also held that while proceedings shall continue *qua* defendants Nos. 1 and 3, the other alleged contemnors are discharged, subject to anyone of them being named by the defendants Nos. 1 and 3, as being responsible for compliance of the Court's directions and upon such disclosure, the applicants/plaintiffs seeking appropriate directions from the Court.

Soothe Healthcare Private Limited vs. Dabur India Limited

Forum: High Court of Delhi

Case No.: FAO(OS) (COMM) 100/2022 and CAV 112/2022, CM APPL. 20947/2022, CM APPL. 20948/2022

Order Dated: 11th July 2022

Issue: What is the and nature of appeals and the limitations of the powers of the Appellate Court to substitute its own discretion in an appeal preferred against a discretionary/interlocutory order?

Order: The Plaintiff, Soothe Healthcare filed infringement suit against Dabur India for infringing/passing off registered SUPER CUTE'S trademark in respect to baby diapers. The Single Judge refused to grant interim injunction and present appeal was filed. The Court relied upon the findings in judicial precedent where it was observed that the appellate bench may interfere with the order where it seems that the discretion has been exercised arbitrarily or capriciously or perversely or where the court had ignored the settled principles of law regulating grant or refusal of interlocutory injunctions. The Appellate court will not reassess the material and seek to reach a conclusion different from the one reached by the court below if the one reached by that court was reasonably possible on the material. If the discretion has been exercised by the trial court reasonably and in a judicial manner the fact that the appellate court would have taken a different view may not justify interference with the trial court's exercise of discretion. Applying the same principle, the Appellate court held that SOOTHE has not been able to establish that the Single Judge has exercised his discretion arbitrarily or has ignored the settled principles of law regulating grant or refusal of interim injunctions. The Single Judge has rightly reached a prima facie conclusion that DABUR's mark and packaging does not infringe SOOTHE's trademark and does not have the effect of passing off their goods as that of SOOTHE. The word 'SUPER' is descriptive and laudatory. SOOTHE cannot prima facie claim that the word "SUPER" appearing in its registered mark has acquired a secondary meaning or a distinctive character when used for diapers.

Manish Agarwal vs. Registrar of Trade Marks and Others

Forum: High Court of Delhi

Case No.: W.P.(C)-IPD 10/2021 and CM APPL. 12180/2020

Order Dated: 7th July 2022

Issue: Whether the filing of evidence in support of opposition under the incorrect head on e-filing portal within the statutory timeline be admitted?

Order: The writ petition filed by the Petitioner; Manish Agarwal arises out Registrar's order wherein the Respondent's evidence in support of oppositions was admitted. The Respondent filed by way of e-filing, filed its evidence in support of oppositions under Rule 45 under head of 'Evidence under Rule 47'. When the documents under the head Evidence under Rule 47 were scrutinized, it came to the fore that Annexure under Rule 47 contained the "Evidence in support of evidence under Rule 45" of Trade Marks Rules 2017. The first page of the documents so filed starts with the heading "Evidence By Way Of Affidavit In Support Of Opposition U/S 21(4); Rule 45" in all the four matters. The Court considered the circumstances and noted that evidence was filed under Rule 45 on 5th August 2019 and even if there was some delay in the dispatch of the final documents which were received on 13th August 2019, it cannot be said that evidence have not been filed under Rule 45. The Court was unable to hold that the evidence was not filed in time and directed the Applicant's evidence under Rule 46 to be filed within the timelines. Considering the delay suffered by the Petitioner in prosecuting the trademark applications due to the confusion caused by the Respondent and their improper filing, evidence in support of oppositions is to be taken on record subject to costs of INR 5,000/- in each of opposed applications.

Puja Aggarwal vs. Pravesh Narula

Forum: High Court of Delhi

Case No.: CM (M)-IPD 1/2022 and CM Appl. 4146/2022 (under Section 151 CPC)

Order Dated: 29th March 2022

Issue: Can High Court interfere with the Trial court's order in writ petition?

Order: The writ was moved by the defendant/petitioner, Puja Aggarwal against Trial Court's orders dismissing the application under Order VII Rule 11 CPC for rejection of the suit as there was no cause of action. The Trial Court observed that the petitioner/defendant had been selling socks using the impugned logo and packaging. And thus, the issue of cause of action was a disputed question of fact which could be decided on merits, only after the evidence was led by both the parties. The petitioner/defendant pleaded that it would be grave injustice upon them to be subjected to an unwarranted trial. To ascertain the scope of Article 227 of the Constitution of India, the Court referred to numerous judicial precedents concluding that the powers under Article 227 of the Constitution of India are not of the same nature as appellate powers of the High Court. Power under Article 227 is one of judicial superintendence and cannot be exercised to upset conclusions of facts however erroneous those may be. The High Court exercising supervisory jurisdiction does not act as a court of first appeal to reappreciate, reweigh the evidence or facts upon which the determination under challenge is based. Supervisory jurisdiction is not to correct every error of fact or even a legal flaw when the final finding is justified or can be supported. The jurisdiction exercised is correctional jurisdiction to set right grave dereliction of duty or flagrant abuse, violation of fundamental principles of law or justice. The Court observed that while dealing with an application under Order VII Rule 11 CPC, it is required to look at the averments in the plaint and plaint alone. The documents filed along with the plaint can also be considered, and the stand of the defendant is irrelevant. Order VII Rule 11(a) CPC deals with a situation where the plaint does not disclose a cause of action. In the present case, plaint states that the respondent/plaintiff has been using the logo and name "R.D. SPECIAL" in a particular packaging since long and they came across an application of the

petitioner/defendant for registration of the trademark "R.D." The capital letters R.D. was used in a similar fashion. That the Trial Court was right in observing that the questions raised by the petitioner/defendant being one of facts, would require trial. An appropriate issue regarding the existence and non-existence of the cause of action, amongst other issues can also be framed to be disposed of together, after evidence is recorded. The said order needed no interference in the exercise of powers under Article 227 of the Constitution of India.

Prakash Pipes Limited vs. Bauchhaar Poly Industries and Ors.

Forum: High Court of Delhi

Case No.: CS (COMM) 548/2021 and I.A. 14166/2021

Order Dated: 06th April 2022

Issue: Can quantum of damages be ascertained by blatant infringement?

Order: The plaintiff, Prakash Pipes Limited sought permanent injunction against defendants from using the mark 'PRAKASH'/trade dress/copyright/colour combination/writing style/formative marks, for PVC pipes and other related goods, as also reliefs for passing off, delivery up, rendition of accounts and further damages. An *ex-parte* interim order was granted in favour of the plaintiff. The defendants had agreed to stop the use of the 'PRAKASH' and 'PRAKASH GOLD', etc. marks and matter was referred to mediation. The mediation did not prove to be fruitful, and the matter was listed before the Court. The Court observed that trademark being used by the Defendants is identical and the logo being used is also a colourable imitation of the Plaintiff's logo. There is a violation of the statutory and common law rights of the Plaintiff who appear to be market leaders in the same industry. The Court held that this is a fit case for grant of permanent injunction restraining the Defendants from using the mark 'PRAKASH', its formative marks including 'PRAKASH GOLD', and/or the accompanying logos in any form whatsoever in respect of pipes, fittings, storage tanks, PVC products and any other PVC products or allied goods or construction materials and/or other products having the same trade channel and the suit is decreed. The Defendants were directed to withdraw their

trademark applications and any other trademark/copyright applications which they may have filed, in respect of other marks which may be deceptively similar to the Plaintiff's mark 'PRAKASH' or any variant of the same, including the Plaintiff's logos. Considering the blatant infringement of the Plaintiff's marks and the costs incurred, the Court also imposed costs of INR 5,00,000/- (USD 6100) on the Defendants.

HTC Corporation vs. LV Degao and Ors.

Forum: High Court of Delhi

Case No.: 263/2020

Order Dated: 06th April 2022

Issue: What are the factors to be considered to grant injunction against the party who may have valid registration in its favour for covered goods? The Plaintiff, HTC Corporation filed the suit for permanent injunction, restraining infringement of trademark, passing off, etc. against Chinese manufacturer of electric hair trimmers, hair clippers and hair dryers bearing HTC mark. The defendant was registered proprietor of 'hTC' trademark in class 8 and the plaintiff had registration in class 9.

Order: In order to grant injunction to the plaintiff, the Court observed that while determining the question of the existence of a "*prima facie* case" or "irreparable loss" or "balance of convenience", there could be more than 1 or 2 situations where two identical or similar trademarks may or may not be registered in view of the existence or absence of factors. The following situations may arise:

- (a) Two persons may have the same Trade Mark registered in their name:
 - (i) for identical or (ii) similar or (iii) different goods.
- (b) Ordinarily if the two Trade Marks are validly registered, both the registered proprietors can use the Trade Marks to the exclusivity of third parties, but cannot assert their rights against each other.
- (c) However, in certain situations, registration of the later Trade Mark may be refused registration or cancelled. These situations are: (i) when deception or confusion results, (ii) there is dishonest user, (iii) subsequent use without

due cause, (iv) there is bad faith, or (v) dilution of the distinctiveness of a prior registered Trade Mark may occur.

(d) Therefore, these factors would be relevant to decide whether the subsequent user/registered proprietor should be restrained from using his Trade Mark, even if it was registered.

(e) Certain other aspects would also aid this determination, for example, (i) whether user is only to indicate origin of the goods, (ii) the reputation of the Trade Mark, (iii) whether it is "well-known", (iv) whether the prior user has established acquisition of distinctiveness, or (v) whether he had acquiesced in the latter's user of the same Trade Mark and if so, to what effect.

The Court found that defendant adopted their HTC mark in 2013 which was subsequent to gain unfair advantage, and such adoption is without due cause. The action of the defendants has no valid explanation. The dishonesty in the use of the trademark is also reflected from the fact that the defendant hyperlinked their webpage with that of the plaintiff on Amazon India to blur the source and origin of their goods. For a consumer of average intelligence and observation, it may not be difficult to believe that the hair grooming products of the defendants with the HTC trademark and link to the website of the plaintiff, were being produced and marketed by the plaintiff. Thus, the plaintiff has disclosed a prima facie case not only for infringement, but also for passing off. The "balance of convenience" lies in favour of the plaintiff as invoices show that defendant's products have been in the market only since 2017 and the sales are few. The injunction was granted against the defendants until the decision in the rectification/cancellation proceedings filed against defendant's registration is rendered.

Hugo Boss Trade Mark Management GMBH and Co. KG vs. Ashok Kumar

Forum: High Court of Delhi

Case No.: FAO-IPD 5/2022

Order Dated: 23rd February 2022

Issue: Whether the learned Trial Court was justified to exercise its discretion in refusing to grant ex-parte ad-interim injunction?

Order: The appellant has filed the present appeal against the order dated 7th February 2022 whereby the learned Trial Court declined to grant ex-parte ad interim injunction against the respondent/defendant. The identity of the defendant who were infringing registered trademarks of the appellant, viz. 'HUGO BOSS', 'BOSS', 'HUGO' and other BOSS/HUGO were unknown to the appellant. The Trial Court placing reliance on the case Januki Kumari J.B. Rana v. Ashok Kumar refused to grant ex-parte ad interim injunction to the appellant. The counsel for the appellant argued that the court erred in not appointing the Local Commissioner, as prayed by the appellant as infringers would come to the court once the counterfeit products were seized.

The Delhi High Court upholding the order of the learned Trial Court stated that the reliance place by the court on Januki Kumari J.B. Rana was correct. Like present case there was no known infringer in Januki Kumari J.B. Rana hence court declined to grant ex-parte ad interim injunction. While concluding the order the court remarked that when an ex-parte ad interim injunction is granted, the opposite party against whom an order of injunction is passed is required to be served with the copy of the order along with the other relevant documents on same day or next day and the plaintiff must file such an affidavit of compliance in the Court. If the defendant is unknown how the applicant would fulfil the conditions and if this Court cannot ensure the compliance, it would be failing in its obligations conferred under the provisions of law. As the appellant failed to point out how it would serve the ex-parte order upon the defendants, granting of such an order would mean issuing a blank civil search warrant allowing appellant to enter any premises, any shop in search of the counterfeit articles, either personally or through court commissioners, which is not the object of the provision (Order 26 Rule 9 of CPC). Therefore, there is no error in the order of the learned Trial Court.

Havells India Limited vs. L. Ramesh



Forum: High Court of Delhi

Case No.: CS (COMM) 20/2020


Order Dated: 24th February 2022

Issue: Whether the use of impugned mark by the defendant constitutes infringement/passing off of the plaintiff's well-known trademark.

Order: Plaintiff is the registered proprietor of the trademark STANDARD in India as well as in foreign jurisdictions. It has been using the trademark/logo STANDARD since the year 1958 and its trademark STANDARD has been declared a well-known mark. It has been stated by the Plaintiff that the trademark, brand name and trading style STANDARD has acquired distinctiveness and secondary meaning. The Plaintiff filed

opposition against  and  marks of the Defendant and upon market investigation came to know that Defendant has not only copied Plaintiff's trademarks but has also copied the packaging and other elements of the trade dress of the Plaintiff's products to deceive the consumers into believing that the impugned products are those of the Plaintiff.

The Delhi High Court noted that Plaintiff has been able to establish that it is the registered owner and has been using the trademark STANDARD since the year 1958 in respect of electrical goods such as miniature circuit breaker, switch gear, isolator etc. The Defendant argued that the registration granted to the Plaintiff has condition that Plaintiff would have no right for the

exclusive use of the word 'STANDARD' or of  or of the letter 'S' and this fact was concealed at the time of grant of ex parte injunction on 17th January 2020. The Court rejecting the argument of Defendant stated that disclaimer cannot come in the way of the claim of passing off and that the marks of the Defendant and Plaintiff have been to be seen as whole for

purpose of grant of relief of infringement on account of the long usage of the word mark 'STANDARD' which has attained a secondary meaning so as to identify the goods of the Plaintiff. The Defendant also contended that Plaintiff is no longer using the aforesaid trademarks, however, the Court noted the fact of the matter is that the Plaintiff is still the registered proprietor of aforesaid marks and is free to use the same whenever it desires. The Court noted that in an action for infringement, where the Defendant's trademark is identical or deceptively similar with the Plaintiff's mark, the test must be likelihood of confusion or deception arising from the similarity of marks. The Court noting that Plaintiff has made out a prima facie case in its favour for the grant of interim injunction granted ex parte injunction against all trademarks that are identical/deceptively similar to the trademarks/logos and packaging of the Plaintiff.

Ashim Gujral and Ors. vs. Kuvam Gujral and Ors.

Forum: High Court of Delhi

Case No.: CS (COMM) 659/2021

Order Dated: 28th February 2022

Issue: Issue 1: Whether Kuvam was entitled to any rights in the trademark 'MOTI MAHAL' on account of his being a great-grandson of late Sh. Kundan Lal Gujral?

Issue 2: Whether Kuvam's company was entitled to use the mark as Mr. Ashim Gujral is a 50% shareholder in Kuvam's company?

Issue 3: Whether there was any Acquiescence on part of the Plaintiffs?

Order: Plaintiff Sh. Kundan Lal Gujral was the registered proprietor of the mark "MOTI MAHAL" since 1992 which was being used since 1974. He expired in December 1997 leaving behind his two grandsons (Mr. Ashim Gujral & his brother) and his daughter in law (mother of Mr. Ashim Gujral) as his son Mr. Nand Lal Gujral predeceased him, (hereinafter jointly referred to as the 'Plaintiffs'), as his only Class I legal heirs. Ashim Gujral & his brother incorporated a company named Motimahall Delux on 23rd November 2004 and on a routine check found that Kuvam Gujral, being the

son of Mr. Ashim Gujral gave franchise to an entity. He also came to know that Kuvam had approached an existing franchisee of the Plaintiffs in Mathura to enter into a franchise agreement based on a forged 'No Objection Certificate' granted by Mr. Ashim Gujral in favour of Kuvam's company. Upon sending a cease-and-desist notice, he claimed that he is the owner of the trademark 'MOTI MAHAL'. The Court earlier granted an ex parte ad interim injunction order restraining Kuvam, his company, and other defendants from using the trademarks 'MOTI MAHAL', 'MOTI MAHAL DELUX', 'MOTI MAHAL CAFÉ' and MOTI MAHAL (stylized), formative marks or any other marks deceptively similar to the Plaintiffs' registered marks.

After hearing the arguments of the parties, the Court on first issue, held that since Sh. Kundan Lal Gujral died intestate therefore in terms of Section 8 read with the Schedule to the Act, the only Class-I legal heirs of late Sh. Kundan Lal Gujral would be Mr. Ashim Gujral and his brother (plaintiffs No.1 and 2) (sons of the predeceased son) and their mother(plaintiff No.3) (widow of the predeceased son). Kuvam would not fall in the category of Class-I heir. The Court held that applying the principles of Sections 8, 9, and 10 of Hindu Succession Act, the Plaintiffs would equally inherit the properties of Late Shri Kundan Lal Gujral including the trademark, to the exclusion of Kuvam.

With respect to the second issue, the Court clarified that just because Mr. Ashim Gujral is a 50% shareholder in Kuvam's company, it would not entitle Kuvam's company to use the trademarks that are registered in the name of Mr. Ashim Gujral unless Mr. Ashim Gujral has authorized or permitted Kuvam's company to do so.

As for the issue of acquiescence, the court noted that it has been stated that the Plaintiffs came to know about the infringement of their mark by the Defendants on a routine check conducted on the internet in March 2021, and immediately thereafter the Plaintiffs filed the present suit. Therefore, it cannot be said that there was any delay or acquiescence on part of the Plaintiffs. The Court also added that *"In any event, where adoption of a*

mark has been dishonest, mere delay in bringing the action cannot come in the way of grant of injunction.”

The Court held that a prima facie case of infringement of trademarks and passing off is made out in favour of the Plaintiffs and the balance of convenience also is in favour of the Plaintiffs and against the defendants. Further, irreparable harm and injury would be caused to the Plaintiffs if an interim injunction restraining the Defendants from using the registered trademarks of the Plaintiffs is not passed. Therefore, the Court confirmed its interim injunction order till the disposal of the suit. The matter is next listed on 4th May 2022.

Bulgari Spa vs. Notandas Gems Private Limited

Forum: High Court of Delhi

Case No.: CS (COMM) 658/2021

Order Dated: 21st February 2022

Issue:

- Whether the plaint is bad for want of territorial jurisdiction,
- Whether a prima facie case of infringement of trademark is made out,
- Whether a prima facie case of infringement of design is made out and
- Whether a case of passing off, by the defendant, of the plaintiff's mark, is made out.

Order: The Plaintiff, Bulgari Spa is a leading manufacturer and dealer of the luxurious jewellery since 1940s and its products (wristwatches and bracelets) were identified by its unique snake-like design in the jewellery market. The Plaintiff submitted that it held for registrations with “SERPENTI” as a common word. In 2015, the Plaintiff also obtained registration for the device mark of a snakehead as well as the design of its wristwatches. On the other hand, the Defendant, Notandas Gems Pvt. Ltd. was also a manufacturer of the high-end luxury jewellery in India and was

using the mark "SERPENTINE", with similar snake-like design for its manufactured bracelets.

The Court while deciding the issues framed propounded, that where the website or platform merely provides information, the Court would not have the jurisdiction to deal with the case unless and until it is shown that such information has been accessed by a person located within the jurisdiction of the Court, thus creating a cause of action within the jurisdiction of the Court. However, in the present case, the Court pointed out that the Defendant's website was in fact interactive in nature and permits commercial transactions through it. In such cases, the Courts which have the jurisdiction over the places from which such commercial transactions can be affected and concluded will have the jurisdiction to deal with trademark infringements.

Upon issue of infringement, the Court noted that the Defendant's use of the mark 'SERPENTINE' in for the same nature of goods and caters to the same class of customers. It is also phonetically similar with the mark of the Plaintiff. The Court noted that the mark 'SERPENTI', is a coined fanciful mark and cannot be claimed to be descriptive in context of bracelets. It cannot be presumed that bracelets in serpent form and shape are common to trade. The Court thus, observed that Defendant's use of the mark "SERPENTINE" is infringing the mark of the Plaintiff.

As for design infringement, it was held by the Court that there is no infringement of the device mark of snakehead by the Defendant since the Defendant's mark is "completely distinct in shape, configuration, contour and even visual appearance" from that of the Plaintiff's. The design of defendant's bracelet does not infringe registered design held by the Plaintiff in either the bracelet or the wristwatch.

The Court lastly, issued an interim injunction restraining the Defendant, from using the trademark "SERPENTINE" in respect of any of its products, however, no injunction was granted against the Defendant's use of designs.

Reddys Laboratories Limited and Ors. vs. Controller General of Patents Designs and Trademarks and Ors.

Forum: High Court of Delhi

Case No.: W.P. (C)-IPD 4/2022

Order Dated: 18th May 2022

Issue: Issue 1: the review application filed on behalf of the officers of the CGPDTM seeking review of the order dated 21st March 2022, by which Rs. 1 lakh was imposed as costs on each of the officers for lapses in communicating incorrect facts to the Court.

Issue 2: A large number of pending oppositions, ripe for hearing, in the Controller General of Patents, Designs and Trade Marks/Respondent

Order: This case relates to four writ petitions filed by different Petitioners in view of the completely arbitrary and discriminatory manner in which the Controller General of Patents, Designs and Trademarks/Respondent (hereinafter "CGPDTM") has disallowed the Petitioners from filing oppositions to the trademark applications, which each of them wishes to oppose.

The Delhi high Court has imposed cost of 1 lakh on Deputy Registrar of Trademarks & GI and, Assistant Registrar of Trademarks, due to failure to disclose that around 6,000 to 7,000 oppositions were filed during the pandemic period beyond the four-month statute of limitation and were heard by the CGPDTM. The Court deciding on the issue stated that cost imposed on official of CGPDTM shall stand however, Ld. Controller General shall decide if such cost shall be deposited by official individually or by the office.

With respect to second issue of handling of large number pending oppositions ripe for hearing, the affidavit was filed on behalf of Deputy Registrar. It stated at present 12 Registrar level officer are working in Trade Marks Registry and the Government has sanctioned 30 post of Hearing officers (on Contract basis) to dilute the pendency of cases. It was stated that recruitment of 11 Assistant Registrars of Trade Marks & GI is pending

with the UPSC and it is expected to be completed before the end of this year. That promotion proposal of 8 Assistant Registrars of Trade Marks & GI is also under consideration and is expected to be completed soon and that by the end of 2022, the Trade Marks Registry would have around 59 Hearing officers to dispose pending opposition in the System. It was submitted that Office is targeting the disposal of approx. one lakh ninety-six thousand applications on priority basis by the end of the year 2025 and that Office intends to start a mediation and settlement drive in the Trademark Registry for quicker disposal of the trademark oppositions.

In the case of trademark applications for which oppositions have been made or will be submitted by May 30, 2022, the Court order that such opposition petition be taken on record and the status of the application is reflected as opposed on e-Register. Registration certificates will either not be issued or, if previously issued, will be suspended until the oppositions are resolved by the CGPDTM office.

Sanjay Chadha and Another vs. Union of India and Another

Forum: High Court of Delhi

Case No.: W.P. (C)-IPD 12/2021

Order Dated: 19th January 2022

Issue: Issue 1: Whether the trademark ‘EVEREADY’ is a well-known mark within the meaning of Section 2(1)(zg) of the Act.

Issue 2: Effect of acquiescence (if any) on the part of Eveready Industries India Limited under Section 33 of the Act.

Issue 3: Effect of non-grant of injunction in favour of Eveready Industries by the Civil Court.

Issue 4: Concealment (if any) by Eveready Industries and its effect; or any admission in the cross-examination of witness of Eveready Industries.

Issue 5: Whether the adoption of the same mark and logo was honest on the date of filing of application of registration.

Issue 6: Validity of assignment by the proprietor in favour of his Sanjay Chadha.

Issue 7: Use of a mark in relation of goods which are not similar.

Issue 8: Conduct of the assignor and assignee of two marks which are under rectification.

Issue 9: Concurrent user.

Issue 10: If the answer to Issue No. 1 is affirmative, then whether there is dilution of the Eveready Industries' well-known trademark."

Order: The Petitioners in the present case were engaged in the business of manufacturing and marketing of hand tools sold under the trademark/label "EVEREADY" which the Petitioners claimed to be using since 1985. Vide assignment between the Petitioner Nos. 1 and 2, the mark "EVEREADY" along with its goodwill was assigned to the Petitioner No. 1. The Respondent Eveready Industries India Limited on the other hand, was engaged in the business of manufacturing and trading, inter alia, in dry cell batteries, flashlights, compact fluorescent lamps (CFLs), and general service lamps (GSLs) under its brand name and trademark "EVEREADY". The Respondent claimed to be the registered proprietor of the mark "EVEREADY" which was being used since 1942 and had attained the status of "well known trademark". The present petition was filed against the order of the Intellectual Property Appellate Board (hereinafter referred to as the 'IPAB') allowing the removal of the trademarks of the Petitioner. The Delhi High Court dealing with the issues framed by the IPAB, confirmed the order of IPAB in present case. The Court stated as below:

1. The Court, in view of the facts that the Respondent was using the mark "EVEREADY" since 1942 which was confirmed by various judicial orders, registrations obtained for the said mark from the year 1942 in various classes, sale and advertisement figures in crores, confirmed that the mark of the Respondent is a well-known trademark.
2. In relation to different goods, the Court noted that the marks of the involved parties are identical, hence it does not matter if the involved trademarks are used in respect of similar goods or not. The Court noted that the mark of the Respondent and its use will be detrimental to the distinctive character or repute of the Petitioner's trademark.

3. The Court noted that no explanation has been given by the petition on the adoption of the identical word mark “EVEREADY” and device which proves that the Petitioners have adopted the trademark “EVEREADY” in a dishonest and mala fide manner and with an intention to usurp the goodwill and reputation of the Respondent.
4. On the point of delay and acquiescence on the part of the Respondent, the Court noted that based on evidence filed by the Petitioners there was no use of the mark “EVEREADY” by the Petitioners between the years 2000-2005 and the registration of the said mark has already expired in 2006. The Petitioners started using the mark in the year 2006 and rectification petitions were filed in 2009, hence there cannot be said to be any laches and acquiescence.
5. On issue of assignment deed, it was noted by the Court that such deed was signed by the Petitioners in 2009 however, the same was made effective retrospectively from 2005. It was noted that as per the Trade Marks Act there cannot be any retrospective assignment of a trade mark. Hence, the deed was not valid. Further, on the date of assignment, mark of the Petitioners was not valid on the register as the registration of the same had lapsed in the year 2006 itself. Therefore, there could not have been an assignment thereof.
6. Finally, the Court noted that the IPAB had passed a detailed and well-reasoned order and there is no error apparent on the face of record. The Court noted that IPAB had an independent jurisdiction, and it is guided by principles of natural justice.

Pernod Ricard India Private Limited vs. Frost Falcon Distilleries Limited

Forum: High Court of Delhi

Case No.: IA 2821/2021

Order Dated: 02nd March 2022

Issue: Issue 1: Whether Defendant's impugned marks infringe the Plaintiff's registered trademarks?

Issue 1: Whether a case of passing off can be made against the defendant?

Order: The plaintiff, Pernod Richard India Pvt. Ltd., claims to be into the business of manufacturing liquor with the trade names "Blenders Pride" and "Imperial Blue," which was registered and in use since 1994 and 1997, respectively. On the other hand, the Defendant was using the impugned "CASINOS PRIDE" mark since 2017, which the Plaintiff claimed to be confusingly similar to the Plaintiff's mark. It was submitted by the Plaintiff that products under the involved mark belong to same segment i.e., Indian Made Foreign Liquor ("IMFL"), and would move to the same customer base through same outlets. The Plaintiff alleged that the Defendant deliberately infringed registered marks of the Plaintiff- "BLENDERS PRIDE" and "IMPERIAL BLUE".

The Court while dealing with the issue of infringement ruled that no exclusive right can be claimed over the word "PRIDE" by the Plaintiff as the same denotes the quality of the product, is prima facie laudatory in nature. It was noted by the Court that the word "PRIDE" is of common usage and does not distinguish the product of the Plaintiff from those of other manufacturers. The Court used the 'plain glance' test to determine if "PRIDE" is a dominant part of the mark "BLENDERS PRIDE". It was noted that there is no phonetic, visual or other similarity, between the 'BLENDERS' and 'CASINOS' parts of the Plaintiffs and the Defendant's marks. Visually, too, there is no similarity in the 'BLENDERS PRIDE' device mark of the Plaintiff and the 'CASINOS PRIDE' device mark of the Defendant. Hence, the Court concluded that there is no evidence of infringement.

The Court on issue of passing off, noted the difference between tort of passing off and the tort of infringement and stated that it is not bound by the specific ingredients of the tort of infringement whilst considering the former claim. The Court noted that to prove passing off mens rea, or mala fide, is not essential and existence of certain sufficient factors that would indicate that the Defendant seeks to pass off its product as that of the Plaintiff is enough. The Court highlighted all similarities between the marks of the

Plaintiff and Defendant noted that prima facie a case of passing off does exist.

T.V. Today Network Limited vs. News Laundry Media Private Limited & Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 551/2021, I.As.14238/2021, 14296/2021, 14964/2021, 37/2022, 1055/2022 & 4827/2022

Order Dated: 29th July 2022

Issue: Whether the videos that the Defendants had posted on their website and YouTube channel that featured excerpts from programmes previously broadcasted on Plaintiff's channel amounted to violation of the Plaintiff's copyright.

Order: The Plaintiff owns news channels India Today and Aaj Tak, the dispute is regarding a program posted by it on its channel. A number of videos that the Defendants had posted on their website and YouTube channel featured excerpts from a program that had been previously broadcasted on India Today and Aaj Tak. The defamatory suit alleged that, the Defendant NewsLaundry had copied the works of India Today and Aaj Tak, and that it violated the Plaintiff's copyright under the Copyright Act of 1957. Additionally, it was submitted by the Plaintiff that specific words were used like the description of the program as a "shit programme" which has resulted in commercial disparagement. It was further contended that the Defendants have mocked and disparaged the Plaintiff company, its news channels, its employees, and management, and have posted numerous videos and articles on their website as well as on different social media platforms that contain misleading, malicious, derogatory information. Consequently, the Plaintiff's reputation has suffered because of the false and defamatory comments.

The Court observed that under the Copyright law, the excerpts of a broadcast could be re-broadcast if the use is consistent with fair dealing and is in respect of reporting of current events or for bona fide review or

teaching or research. The Court commented that making comments about the act of reporting would fall under the definitions of "criticism" or "review" under the Copyright Act. Keeping in mind the three cardinal principles namely prima facie case, irreparable loss and injury, and balance of convenience, the Court acknowledged that the right to free speech and expression includes the ability to remark on material posted on social media or broadcast television. According to the Court, there won't be any "irreparable loss or injury" to the Plaintiff without the interim injunction, it did not believe that the existence of a few videos using the words listed in the Plaintiff's written submissions or of articles and posts that have been around for a while now qualifies as exceptional circumstances for the issuance of directions in the nature of the mandatory injunction. Thus, the Plaintiff's application seeking an interim injunction was denied.

Alkem Laboratories Ltd vs. M/S Laborate Pharmaceuticals India Ltd

Forum: High Court of Delhi
Case No.: FAO (COMM) 94/2022
Order Dated: 17th June 2022

Issue: Whether the Appellant against whose use of its trade mark an injunction has been granted by the trial Court, be allowed to sell the existing stock under its trade mark in question.

Order: Alkem Laboratories Ltd (Alkem) had approached the Delhi High Court seeking permission to sell the existing stock of the product 'ALDIGESIC PAIN RELIEF' pending the final case decision. Laborate Pharmaceuticals India Ltd (Laborate) alleged that Alkem's product packaging of 'ALDIGESIC' product was similar to the product sold by them under the mark 'LABDIC RELIEF'. The trial Court granted an ex-parte injunction restraining Alkem from manufacturing, selling, or dealing in pharmaceutical preparations in packaging/trade dress, which had similar colour combination, get-up, design, etc., including the similarity in the blister packs in terms of colour combination, etc.

The Court while dismissing the technical objection that Appeal qua return of goods is not maintainable, held that Alkem's prayer to sell the existing stock was decided as part of the application to set aside the injunction. Alkem's limited prayer is to allow them to sell the existing stock of the 'ALDIGESIC Pain Relief' worth INR 90 lacs (approx. USD 113,994) without prejudice to contentions between the parties before the trial Court. Admittedly, the impugned product is a pain reliever sold under Doctor's prescription, being a Schedule 'H' drug.

Without going into the merits of the rival claims, the High Court took the view that the balance of equities would be maintained if Alkem was permitted to sell the existing stock, which is worth INR 90 lakhs (approx. USD 113,994). The Court considered the product in question was a Schedule H drug (to be sold on prescription of a medical practitioner). Furthermore, there was no dispute on the quality of the impugned product.

The Court remarked that even in matters relating to pharmaceutical products, Courts have been holding that in some instances, a prima facie case or even a strong case of infringement in favour of one party can be offset by an interim arrangement. The purpose is to balance the equities between the parties and maintain public interest. Therefore, Alkem was granted permission to sell the existing stock, subject to maintaining a sales record for computing a claim of damages, if Laborate was to succeed finally.

Ajay Kumar And Anr vs. Anugya Gupta

Forum: High Court of Delhi

Case No.: FAO(OS) (COMM) 177/2022 & CAV 180/2022, CM APPL. 31176/2022

Order Dated: 18th July 2022

Issue: Whether an Injunction can be granted against the Registered Proprietor of a trade mark.

Order: The appellants have filed the present appeal impugning an order dated 5th July 2022 passed by the learned Single Judge, through which the appellants were restrained from using the marks/domain name. The respondent is engaged in the business of providing information services relating to admissions, jobs, and career opportunities across India and has been using the trade mark SARKARIRESULT since 01 01 2012 and registered the domain name 'SARKARIRESULT.COM'. She used her mark on YouTube, Instagram, Facebook and Twitter and launched the said website for public access. She asserts that it is one of the most popular websites in India as per the statistics regarding website traffic. She also



adopted the logo mark on 23rd April 2014.

The appellants, in the month of July 2015, established the websites 'WWW.SARKARIRESULT.INFO' and 'WWW.SARKARIRESULTS.INFO'. Subsequently, in the month of July 2018, the appellants applied for registration of their mark "SARKARIRESULTS", under Class 41.

The respondent filed a suit against the appellants under the provisions of the Trademarks Act, 1999 seeking a permanent injunction against the appellant from, inter alia, infringing, and passing off the trademarks of the respondent.

Examining the evidence of the respondent, the Court accepted that the respondent/Plaintiff has provided sufficient details to establish the extensive reach of her website and that the details indicate that the respondent/Plaintiff has generated substantial revenue by displaying advertisements on her website.

The Court held that the domain names used by the appellants are deceptively similar to the domain name of the respondent. The appeal was accordingly dismissed.

Kaira District Cooperative Milk Producers Union Ltd. & Anr. vs. Maa Tara Trading Co. & Ors.

Forum: High Court of Calcutta

Case No.: CS 107 of 2020 IA NO: GA 1 of 2020

Order Dated: 18th July 2022

Issue: Whether ‘Amul’ being recognized as a well-known trademark, deserves a broader scope of protection against unauthorized use on non-competing goods or services

Order: In its petition, Kaira District, which is a registered proprietor of brand Amul, had filed an instant suit seeking a perpetual injunction restraining Maa Tara, a candle making company for infringement of its registered trademark and passing off. Amul is a renowned milk and milk products brand known across India and across the globe. It was registered in 1958. The brand symbolizes a very Indian brand that has become a household name across the length and breadth cutting across class lines, Kaira District claimed in its petition. The matter came to the notice of Kaira District in February 2020 that candles under the mark Amul were being sold by Maa Tara Trading Co.. The Court held that the Defendants (Maa Tara Trading Co) are not entitled to use the mark Amul or any other mark deceptively similar thereto as that of the Plaintiffs(Kaira District). The trade mark Amul has assumed a secondary meaning and as such the trade mark Amul is solely and exclusively identified with the goods and services of the Plaintiffs. The said trade mark cannot be utilized by any entity. The Court also held that Amul, being recognized as a well-known trade mark, deserves a broader scope of protection against the unauthorized use on non-competing goods or services.

Bright Lifecare Private Ltd vs. Vini Cosmetics Private Limited and Anr.

Forum: High Court of Delhi

Case No.: CS(COMM) 144/2022 & I.A. 3585/2022

Order Dated: 18th July 2022

Issue: Whether an advertising campaign and its various elements be protected under intellectual property law? If so, in what manner?

Order: Bright Lifecare Pvt. Ltd. (Plaintiff), is a company engaged in manufacturing and trading health supplements, nutraceuticals, and food products. One of its most popular products is a protein supplement sold under the 'MuscleBlaze' trademark. 'MuscleBlaze' started an ad campaign in 2018 titled 'Ziddi Hoon Main'. Its creative's use of words like 'Zidd' and 'Ziddi' portrays an image of a person who doesn't give up easily.

'Vini Cosmetics Pvt Ltd' (Defendant) sells deodorant and perfume brands like Fogg, Ossum, and Whitestone. Plaintiff alleged that the two advertisements of the deodorant named 'Realman' of Vini adopted the tagline 'Ziddi Perfume'. Plaintiff alleged that the advertisement was conceptually and visually similar to that of 'MuscleBlaze'.

After considering screenshots and viewing both advertisements, the Court held that the two commercials are likely to give an ordinary viewer the impression that they are connected or emanating from the same source.

The Court further held that There can be no monopoly or exclusivity on the use of the word 'ZIDD' and 'ZIDDI' as an idea to show perseverance. However, the portrayal has to be different. There can also be no monopoly or exclusivity on showing a muscular person working out in a gym but the expression of the idea has to be different. Again, the portrayal of a person using a punching bag can also not be monopolized but the expression has to be different. In the impugned commercials, the expression

is a colourable imitation of the Plaintiff's advertising commercial. Court held that the two impugned commercials which are evocative of and very similar to Plaintiff's campaign are liable to be restrained in their present form and the Defendants are asked to pull down the two impugned commercials from www.youtube.com and other platforms where they are available for viewing by the public. It, however, clarified that there is no restraint on Defendant from using the words or expression 'Zidd' or 'Ziddi' and they are free to modify their ads to remove the objectionable frames and then re-launch them.

DocTutorials Edutech Private Limited vs. Telegram FZ-LLC & Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 60/2022 & I.A. No. 1338/2022 (O-39 R-1 & 2)

Order Dated: 25th January 2022

Issue: Whether Telegram the Defendant was liable to disclose the information it had on the infringers who posted infringing content on its platform?

Order: A suit was filed by Plaintiff against unknown Defendants No. 5 & 6 (referred to as John Doe), as well as any other persons associated with them, for releasing its paid content on a platform run by Defendants No. 1 & 2, i.e., Telegram.

The Plaintiff Company provided online content for medical entrance exam preparations, through their website and mobile applications, and was the sole licensee of the copyright over the preparatory content. The Plaintiff alleged that Defendants 5 & 6 hacked into their secure service and obtained the copyrighted material and disbursed them on channels made on Defendant No. 1's app, and Defendant No.2's website. The Plaintiff further asserted that Defendants No. 1 & 2 did not take down the infringing content despite receipt of notices from the Plaintiff.

Defendants 1 & 2 asserted that they had taken all possible measures to take down the infringing content that appeared on their platforms and that they would continue to do so when notified by the Plaintiff. The Court took into consideration the claims and agreed that the Plaintiff had made a prima facie case. The Court held that Defendants 5 & 6 were infringing Plaintiff's copyright and restrained them from using the copyrighted content on their platforms. The Court also ordered Defendants 1 & 2 to provide the Plaintiff with all the details that they had regarding Defendants 5 & 6. The Court concluded by stating that Defendants 1 and 2 shall remain bound by their statement that they would take down all the unauthorized content and block all channels which contain such infringing content, expeditiously.

Frankfinn Aviation Services Private Limited vs. Frankfinn Creations and Others.

Forum: High Court of Delhi
Case No.: CS (COMM) 292/2021
Order Dated: 13th July 2022

Issue: Whether 'Frankfinn Creations' and 'Frankfinn' are similar trade marks, and a ground for granting an injunction to the Plaintiff.

Order: Frankfinn Aviation Services Pvt. Ltd. coined and adopted the trademark 'FRANKFINN' in the year 1980. It imparts training in the field of Aviation, Hospitality, Travel Management, and Customer Services and has several other businesses. These institutes run under the trademark and style of "FRANKFINN" and "Frankfinn Institute Of Air-Hostess Training". Frankfinn has a registration for the mark "FRANKFINN" and logo



in various classes. Frankfinn was aggrieved by the fact that **Frankfinn Creations** has adopted the trademark "FRANKFINN/ FRANKFINN CREATIONS", therefore it approached the

Court seeking a permanent and mandatory injunction, restraining Frankfinn Creations from infringing Frankfinn's trademark 'FRANKFINN' and passing off as and indulging in other acts of unfair competition. Frankfinn claimed that Frankfinn Creations has adopted an identical name with an intent to deceive the public at large and to ride on the enormous reputation and goodwill earned by Frankfinn over the years. The website of Frankfinn Creations prominently displayed the name "FRANKFINN CREATIONS" and was described as a company for event management across India. It is offering management services similar to that of Frankfinn and the area of operation is also the same.

The Court stated that the screenshots of the website of Frankfinn Creations show the use of the mark "FRANKFINN" spelt in the same manner as spelt by Frankfinn. There is also a clear overlap of the services at least to the extent of advertisement, business management, office functions, and training.

Hence the Court passed an order of interim injunction in favour of Frankfinn restraining Frankfinn Creations from using the trademark "FRANKFINN" on their website or any other place or through any other means as a tradename for their services.

Skechers, USA Inc II vs. Union of India and Ors.

Forum: High Court of Delhi

Case No.: W.P.(C)-IPD 90/2021 & CM APPL.27003/2019

Order Dated: 14th July 2022

Issue: Whether the trade mark 'RELAXEDFIT' for footwear in class 25 is devoid of distinctiveness and unworthy of registration as a trade mark in India and what should be the manner of giving reasons for refusal of a trade mark by the Registrar.

Order: The Petitioner is one of the leading manufacturers of shoes in the US, they are known for selling high quality shoes under their registered name "SKECHERS". The Petitioner has been commercially using the

impugned mark 'RELAXEDFIT' since 28th May 2008. The present petition has been filed by the Petitioner to challenge the impugned order dated 7th June 2018 passed by the Registrar of Trademarks against the Petitioner's trademark application no. 2425633 in Class 25 for the mark '



'. Furthermore, the Petitioner has also challenged an order dated 29th March 2019 for reviewing the refusal order dated 7th June 2018 which was also dismissed by the Registrar of Trademarks.

The Petitioner applied for the mark, 'RELAXEDFIT' on 8th November 2012. On 18th November 2013 the Petitioner received an examination report which raised objections under Sections 9 (lack of distinctiveness) and 11 (citation of prior similar marks) stating that the mark is descriptive and does not have any distinctiveness to it. The Petitioner responded by stating that the word 'RELAXEDFIT' is a unique combination of two words 'RELAXED' and 'FIT' and that none of the cited marks was similar to the Petitioner's marks and asked the Registrar to consider the fact that the mark has been registered in over 15 countries.

However, the Registrar of Trademarks did not accept the reply filed and called the mark for a hearing on 5th April 2019. The mark was refused in the hearing. Owing to which the Petitioner filed a form TM-M with a prescribed fee asking the Registry to communicate in writing the grounds for refusing the application in the hearing. The Registrar of Trademarks gave only one line of reasoning in support of his decision.

The Court stated that the Registrar of Trade Marks is bound to send the copy of the order passed containing the grounds for refusal/acceptance and material used by him in arriving at his decision to the applicant.

Regarding the registrability of the trade mark, the Court gave due acknowledgement to how the mark is used by the Petitioner, and to the list of global registrations, which the petitioner had obtained for the mark 'RELAXEDFIT' showing that the mark 'RELAXEDFIT' is registered in almost all major jurisdictions, including United States of America, European Union, United Kingdom, Chile, China, Colombia, Taiwan, UAE, Australia, Japan, Russia, and several South American Countries

The Court further set aside the impugned orders by the Registrar of Trade Marks and proceeded with the mark 'RELAXEDFIT' for advertisement with certain disclaimers.

Gm Modular Pvt. Ltd. vs. Syska Led Lights Pvt. Ltd.

Forum: Delhi High Court

Case No.: CS(COMM) 329/2021

Order Dated: 22 August 2022

Issue: Whether the simultaneous registration of a shape of a good under the Designs Act and the Trade Marks Act can subsist?

Order: The Plaintiff alleged that their product design is similar to that of the Defendant and further showed a pictorial comparison and pleaded the Court to restrain the Defendant from selling any product having the infringing design. The Defendant argued that the Plaintiff had obtained trademark registration of the product and hence by virtue of the law is not liable to be protected under the Designs Act, 2000.

The Defendant submitted that where the Plaintiff itself claims a right in a shape of the product as a trade mark, the registration of design in its favour is liable to be cancelled and cannot be a ground for granting relief to the Plaintiff.

The Defendant stated that the design registration obtained by the Plaintiff is dated 22nd April 2016 and, therefore, was after the alleged usage of the shape of the product of 6th April 2016 claimed by the Plaintiff itself in its

trade mark registration. The design having been prior published, was not entitled to be registered and is now to be cancelled.

The Plaintiff explained that the application seeking registration of the design was prepared on 06th April 2016 and was sent to Kolkata for filing the same. Due to delay in the postal and filing work, the same could be filed only on 22nd April 2016. Plaintiff, therefore, submitted that it cannot be said that the design of the product was prior published by the Plaintiff's own application for registration of its trade mark. The Plaintiff further submitted that, in fact, no sales had been made in the impugned shape by the Plaintiff before the registration of the design.

The Court opined if the registered design *per se* is used as a trade mark, it cannot be registered as a 'design' under the Design Act and such registration, if granted, is liable to be cancelled. The Court further stated that for seeking registration of the design, the applicant must show that it is the author of the design or is the person for whom the author of the design, for good consideration, executes the work, or is a person who acquires the design or the right to apply the design to any article, or the person to whom the design has devolved from the original proprietor. The Plaintiff, itself being an importer of the products, cannot claim to be a proprietor of the design. The plaintiff does not deny the fact of importing the product from the Chinese manufacturer, however, in a vague manner, states that it is getting these goods manufactured from other manufactures on a job-work basis.

In the present case, by an admitted use of the design since 06th April 2016, that is prior to the date of filing of the application, the design, at least *prima facie*, was prohibited to be granted registration for being prior published.

Astral Poly Technik Ltd. vs. Astralglee through its Proprietor Ms. Pooja Surendra Ayre and Others.

Forum: Delhi High Court
Case No.: CS(COMM) 440/2020
Order Dated: 22 August 2022

Issue: Whether the Defendant's use of the trademark "ASTRALGLEE" constituted to trademark infringement of the Plaintiff's registered trademark "ASTRAL" for similar goods?

Order: The Plaintiff was incorporated on 25th March 1996 and is engaged in diversified business activities with its prime focus on manufacturing, distributing and selling of high-quality pipes, parts and fittings for use in plumbing, sewage and drainage, agriculture, surface drainage, industrial use, fire protection, cable protection, urban infrastructure, insulation; adhesives and ancillary products such as clams, hangers, pipe flanges and connectors; surface and glass cleaners, sanitizers, stain removers and surface protectants. The Plaintiff sells its product under the trade name "ASTRAL". The Plaintiff has spent Rs. 70.80 Crore (86,51,080.32 USD) as the advertisement expenditure in the year 2019-2020. The mark is registered under class 3 bearing class description "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices".

The Defendant also produced essential oil, aroma oil, essential oil roll-on and floral water, diffuser under the brand name "ASTRALGLEE /



ASTRALGLEE

". Therefore, the Plaintiff claimed that the Defendant's use of mark "ASTRALGLEE" word likely to mislead customer and create uncertainty in their minds about the affiliation of the Defendant's products. According to the Defendant he had *bonafidely* created the mark "ASTRALGLEE" merging two words ASTRAL means 'relating to space' and GLEE, which means 'blissfulness'. The said application was opposed by the Plaintiff no. 1, whereafter the Defendant no. 2 did not file its counterstatement and therefore, the application was abandoned.

The Court stated that the mark of the Defendants incorporates the complete mark of the Plaintiffs. The test to determine whether the two marks can be

said to be deceptively similar to each other, is now too well-settled. The Court ruled that the Plaintiff's registered trademark "ASTRAL" was in fact confusingly similar to the Defendant's use of the mark "ASTRALGLEE." As both marks were deceptively similar, and that the Defendant had purposefully chosen a mark that was likely to mislead and confuse consumers. The Court observed that use of Defendant's trademark "ASTRALGLEE" would curtail the scope of expansion of Plaintiff business. The court further directed the Defendant to remove all his goods from various social media website, ecommerce platform and suspended the domain names.

Hell Energy Magyarország Kft vs. Shri Brahm Shakti Prince Beverages Pvt. Ltd. and Others

Forum: Delhi High Court

Court Case No.: CS(COMM) 403/2022 & I.As. 10543-44/2022

Order Dated: 21 July 2022

Issue: Whether the Defendants' use of the mark "HILLxxx" for their energy drink constituted trademark infringement and passing off of the Plaintiff's registered trademark "HELL"?

Order: The Plaintiff is a Hungarian company which is engaged in the business of manufacture and sale of energy drinks. The Plaintiff had filed the present suit seeking protection of its trademark 'HELL' used for energy drinks. The Plaintiff adopted the said mark in 2006 along with a unique logo, trade dress and artistic work. The Plaintiff's marks are 'HELL'/'HELL ENERGY', 'HELL ENERGY DRINK' which are used in various logo forms and variations. The colour scheme used by the plaintiff is red and black as is depicted below:



The Plaintiff claimed that the Defendant has been a repeated infringer in the previous suit filed by the Plaintiff against the Defendant, the Court granted an ex-parte ad interim order of injunction. In the said order, two Local Commissioners were also appointed who seized large amounts of infringing products from the premises of the Defendants. Thereafter, the parties settled their disputes and had entered into a settlement agreement.

It was argued by the Defendant that ‘HILLxxx’ is a coined mark and is structurally, phonetically, and visually different from Plaintiff’s marks ‘HELL’ and ‘HELL ENERGY’.

The Court observed that the settlement recognized Plaintiff’s rights in the mark ‘HELL’/‘HELL ENERGY’ and other variants and the Defendants undertook that they would not manufacture, sell or advertise products under the impugned mark ‘HELLxxx’, ‘HELL ENERGY DRINK’, or any other deceptively or confusingly similar trademark. The Court held that in any manner, the Defendants are not entitled to use the mark “HILLxxx” as the same is confusingly and deceptively similar to “HELLxxx”, which is the name/mark used by the Plaintiff.

The Court directed that by 30th November 2022, the Defendant should pay damages in three instalments. Further, it was also made clear by the Court that if the Defendants are found to be in violation of the court orders again, they would be liable to pay damages to the tune of INR. 1,00,00,000/- (USD 1,22,238).

The Court directed that the Defendants shall ensure that the proposed label and mark of their product are not in any manner identical or deceptively/

confusingly similar to that of the Plaintiff. The new label and the mark which would be adopted by the Defendant shall be given to the Plaintiff, within ten days from the order of the court.

Dreams Lingerie Products vs. Akash Chawdhary

Forum: Delhi High Court

Case No.: CS (Comm) 370/2022

Date of Decision: 21 September 2022

Issue: The Court was asked to decide whether the Defendant had violated the Plaintiff's rights in its trademark DREAMS LINGERIE by using the mark DREAM COMFORT.

Order: The Plaintiff is a manufacturer and registered proprietor of DREAMS LINGERIE and markets lingerie goods under the trademark since 2003, in India and other jurisdictions. The use of the mark "DREAM COMFORT" by the Defendant, according to the Plaintiff, was confusingly similar to its registered trademark. The Defendant claimed that the marks in question are not identical or confusingly similar to each other and the Plaintiff uses the word "DREAMS" i.e. plural whereas the Defendant uses "DREAM" in singular along with the words "comfort" and "DREAM" is common to trade.

The Plaintiff stated that the Defendant, in his capacity of being a distributor of the Plaintiff-firm, and his father, being the ex-manager of the Plaintiff-firm, had full access to the dealer network, vendors, trade channels, internal business details, product supply chain, price points, product demands, product details et cetera and, therefore, the adoption of a deceptively similar mark is clearly mala fide and intended to draw a connection with the Plaintiff and to ride on its reputation. The Plaintiff further stated that the trade dress adopted by the Defendant is similar to that of the Plaintiff, with the use of yellow and white colour combination.

The Court opined that the submission of the Defendant that the word "DREAM" is common to trade is also liable to be rejected. The Defendant, apart from placing reliance on certain marks registered with the Registrar

of Trade Marks, has not filed any proof of the actual product being sold under those marks. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register. Even otherwise, the Defendant himself having applied for registration of his mark is estopped from contending that the mark “DREAM’ or ‘DREAMS’ is descriptive or generic in relation to the goods in question. The Plaintiff clearly is not only the prior adopter but also the registered proprietor of the mark. In fact, the Defendant admits that he was the distributor of Plaintiff’s products. The Defendant, therefore, cannot challenge the reputation and goodwill of the Plaintiff in its mark.

ITC Ltd. vs. Thathireddy Indra Reddy and Others

Forum: Madras High Court

Case No.: 795 of 2018

Date of Decision: 08 July 2022

Issue: Whether the Defendant had violated the Plaintiff’s trademark “AASHIRVAAD” by adopting a similar mark, “AASHIRVAAD” in the same class of goods.

Order: The Plaintiff is a leading manufacturer of Flour in India, they found out that the Defendant has been selling Flour under a similar tradename and trade dress and hence, the Plaintiff proceeded and filed a suit for obtaining permanent injunction against the Defendant.

The Plaintiff showed the similarity between the packaging of the two marks in question. He also drew reference to a certified copy of the deed of assignment dated 04th April 2013 and the legal user certificates in respect of the Plaintiff’s trademark AASHIRVAAD. The Plaintiff also pointed out the evidence of the sales turnover of the Plaintiff running in Crores. By drawing attention to the Defendants’ impugned label, the Plaintiff pointed out that it goes beyond trademark infringement and passing off and is tantamount to counterfeiting.

The Plaintiff pleaded the Court for a permanent injunction against all persons claiming through or under them from infringing the registered

trademark AASHIRVAAD of the Plaintiff by manufacturing, selling and/or distributing atta/flour products under identical mark AASHIRVAAD or any other similar or identical mark and in any other manner whatsoever.

The Plaintiff pleaded that the Defendants be ordered to surrender to the Plaintiff for destruction all labels, cartons, containers, packaging materials, blocks, dyes, prints, screen prints, notices, pamphlets, advertisements, hoardings, and other promotional materials bearing the mark and packaging/label which is identical to the Plaintiff's registered trademark AASHIRVAAD and the Plaintiff's AASHIRVAAD SUPERIOR MP ATTA label.

The Court held that permanent injunction should be granted against the Defendant for infringing the trademark “ASHIRVAAD” of the Plaintiff and restraining the Defendant from selling, offering, distributing flour/ atta under the similar name. By order dated 18 November 2021 the Court recorded that the Defendants did not appear in spite of service of summons by publication and printing the names of the Defendants in the cause list. Therefore, the Defendants were set *ex parte*.

Court ordered to surrender all the promotional items, labels, packaging materials which was identical to Plaintiff marks along with the sum of INR.200,000 (USD 2444) as compensatory costs to the Plaintiff.

Colgate Palmolive Company & Anr. vs. John Does & Anr.

Forum: High Court of Delhi

Case No.: CS (COMM) 612/2022 & I.A. 15704/2021, 15708/2021

Order Dated: 26th September 2022

Issue: Whether the Defendants have infringed upon the Plaintiffs' trademark, copyright, and trade dress rights by shipping toothpaste with packaging that is nearly identical to the Plaintiffs' product, 'COLGATE MAX FRESH'.

Judgement: Colgate Palmolive Company and Colgate Palmolive (India) Ltd. have filed the suit for permanent injunction, restraining infringement of trademark, copyright, trade dress etc. against unknown Defendants and the Central Board of Indirect Taxes & Customs. The Plaintiffs are renowned manufacturers of personal care, household surface care, fabric care, and oral health care products, including toothpaste, under the 'COLGATE' trademark, which was adopted in 1806. The Plaintiffs have an extensive global presence and employee base, and several registered 'COLGATE' trademarks in various forms.

Plaintiffs claim that a container of toothpaste labelled as 'CONAETE COOL-ICE' shipped on October 2021 from Yiwu City to Mundra Port in India is infringing on their product 'COLGATE MAX FRESH' due to nearly identical packaging and features. The Plaintiffs claim that the unique blue and red colour combination with a white cap, bold font, and placement of various features were all copied from their product. Defendant 2 assured that customs wouldn't allow import of goods bearing the impugned mark found in the container, and later confirmed that import wasn't permitted by the custom authorities.

The Court observed that the import of goods that violate Intellectual Property Rights is regulated by the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007 (PR Rules). These rules state that the import of counterfeit products or products that violate IP rights is not allowed. The customs authorities must form an opinion on whether IP rights have been infringed upon, either upon receiving a complaint from an IP owner or on their own. If they find an infringement, the import or sale of the products must be stopped.

The Court concluded that since the import had been stopped by the customs authorities, an injunction was not necessary. None of the goods bearing the impugned mark in the said container, have been allowed to enter India. However, the Plaintiffs are free to take legal action in accordance with the law, either in India or in other foreign jurisdictions.

Willowood Chemicals Private Limited v. Assistant Controller of Patents

Forum: High Court of Delhi

Case No.: W.P.(C)-IPD 15/2023 & CM No. 34-35/2023

Judgement Dated: 17th March 2023

Issue:

- Whether the Applicant can challenge the Report/recommendations of the Opposition Board by invoking Article 226/227 of the Constitution of India.

Judgement:

Willowood Chemicals Private Limited filed a patent application titled "Synergistic Fungicidal Composition" in the Indian Patent Office on December 31, 2013. Haryana Pesticides Manufacturers' Association filed a pre-grant opposition on January 11, 2019, which was later dismissed. The Controller upheld the validity of the application, and the patent was granted on July 20, 2020. However, Safex Chemicals India Ltd. filed a post-grant opposition on August 28, 2020, under several sections of the Indian Patent Act. The parties involved submitted their written statements, evidence, and necessary documents to the Indian Patent Office and the Opposition Board issued their recommendation in a report dated November 29, 2022. Dissatisfied with the Opposition Board's report, the Petitioner filed a writ petition before the Hon'ble High Court of Delhi, challenging the report and the additional evidence submitted by the Opponent.

The petitioner argued that the Opposition Board made an unjustified departure from the Controller's decision, as most of the documents cited by Respondent No. 2 had already been considered in the pre-grant opposition. The Opposition Board's conclusion that the subject patent lacks novelty based on prior art documents was deemed a fundamental error. The petitioner also claimed that the expert affidavit was disregarded, and the Opposition Board exceeded the time limit for submitting their report. Additionally, the petitioner objected to Respondent No. 2 submitting additional evidence after the hearing date, which was considered impermissible. Due to concerns that the Deputy Controller of Patents might be influenced by the flawed findings of the Opposition Board, the petitioner sought to invalidate the report and establish a new Opposition Board.

The Respondent opposed the petition by asserting the availability of a suitable remedy against the Controller's final decision. They argued that the Opposition Board's recommendations should not be considered at this stage as they only make suggestions and challenges. Furthermore, since the Petitioner's grounds address the merits of the Opposition Board's decision, the Respondent claimed that the Court cannot act as an appellate authority. They suggested that the Petitioner can present their grievances to the Controller during the hearing or when the disputed report is being considered.

The Court emphasized the relevance of the Opposition Board's recommendations in the decision-making process, as stated in the *Cipla Ltd. v. Union of India* case. It was stated that the Controller has the authority to

independently evaluate and determine whether to uphold, modify, or revoke the patent. The Court clarified that there is no provision for appealing the Opposition Board's recommendations or challenging them under Article 226/227 of the Constitution. The Controller was yet to make a final decision on the opposition, allowing the petitioner the opportunity to present arguments regarding the patent's validity during the hearing. The Court directed the Controller to make an independent decision after hearing all stakeholders, as per Section 25(4) of the Patents Act.

The Court clarified that the Patentee cannot appeal or challenge the validity of the Board's report/recommendations. However, the Controller's final order in a Post Grant Opposition proceeding can be appealed under Section 117A (2) of the Patents Act. The judgment also emphasizes that the Controller must independently evaluate the Opposition Board's report and decide whether to maintain, modify, or revoke the patent.

Khilendra Gupta Trading as Bobby Enterprises Vs Rakesh Kumar Trading as Sai Birbal Das Gupta

Forum: High Court of Delhi

Case No.: CM(M)-IPD 3/2023, CM 53/2023 & CM 54/2023

Order Dated: 1st May 2023

Issue: Whether the amendments made by the petitioner should have been permitted by the commercial court as the amendments claimed to support the petitioner's case without contradicting any existing averments.

Judgment: A Petition was filed by the Petitioner under Article 227 of the Constitution of India, challenging the order passed by the learned District Judge (Commercial) ("the learned Commercial Court") in CS (Comm)

498/2020, whereby application of the Petitioner seeking amendment of the Pleading was rejected.

The petitioner filed a written statement in response to the suit, claiming that the mark in question had been used by the petitioner's predecessor since January 1, 2001. Subsequently, the petitioner sought amendments to the written statement under Order VI Rule 17 of the Code of Civil Procedure (CPC). The amendments sought to change the claimed user date of the mark from 2000-2001 to 1999, include averments about sales figures and advertising expenses, and introduce various legal arguments in the written statement. However, the Commercial Court rejected the amendment application, stating that the change in the user date constituted a "U-turn" and that the amendments would adversely affect the respondent. The petitioner contends that the amendments related to sales figures, advertising expenses, and legal proceedings should have been allowed since they supported the petitioner's case without contradicting any existing averments.

The High Court held that, in the interests of justice, the amendments sought to be incorporated in the written statement by the petitioner, through the amendment application filed before the learned Commercial Court, ought to have been allowed. The court rejected the notion that the amendments represented a "U-turn" and considered them to be corrective in nature. As the defendant, the petitioner had the right to claim the use of the mark from any chosen date. The court quashed the order rejecting the amendment application and allowed the incorporation of the amendments. An amended written statement had already been filed and should be recorded.

However, the High Court clarified that it did not pronounce the judgment on the merits of the amendments and stated that it would be the petitioner's responsibility to prove the assertions of fact included in the amendments. The respondents were allowed to challenge the correctness of those averments as per the law.

ADS Spirits Pvt. Ltd. Vs. Shubhom Juneja

Forum: High Court of Delhi

Case No.: CS(COMM) 277/2023

Order Dated: 4th May 2023

Issue: Whether the defendant's trademark "Royal Queen" and its packaging/trade dress committed the torts of infringement and passing off.

Order: The Plaintiff manufactures and sells whisky under the trademark ROYAL GREEN. They are the proprietor of several registrations for ROYAL GREEN and ROYAL GREEN-formative marks for, inter alia, alcoholic beverages. From September to October 2014, Plaintiff introduced a distinctive packaging and trade dress for its Royal Green Whisky, which was slightly modified in 2019. The Plaintiff asserted that within a short period, their ROYAL GREEN Whisky has become a preferred brand and secured an entry in the prestigious annual list of spirit brands around the world, in 2020. It was also asserted by the Plaintiff that the sale of Royal Green Whisky has rose to 2750000 bottles by 2022-2023 on a year-wise basis.

The Plaintiff submitted that earlier the Defendant was selling Royal Queen product (Whisky) in Punjab in a packaging which was completely dissimilar to that of the plaintiff but has, recently, introduced, for sale in Delhi, a trade dress which is nearly identical to the Plaintiff's. The Defendant contended that the colour green and the suffix ROYAL are common to trade in relation to alcoholic beverages. The Defendant also sought to rely on its registration for the ROYAL GREEN device mark.

The Plaintiff repudiated the Defendant's defence stating that once the court finds prima facie, that the mark of the Defendant is deceptively similar to that of the Plaintiff, and that the trade dress of the Defendant's product also imitates that of the Plaintiff's product, the issue of whether the suffix Royal is, or is not, common to the trade, ceases to be of any considerable

significance, as infringement already stands established, *prima facie*. The Plaintiff submitted that it is not alleging infringement due to the commonality of the suffix Royal or on the ground that the colour of bottles is green. It is because the overall colour scheme of the bottles and the outer packings, as well as the arrangement of the text and graphics on the outer packings, are deceptively similar. The Plaintiff further argued that the plea of the marks being common to trade cannot be taken until it is established that the use by another person is substantially affecting the registered proprietor. The counsel for the Plaintiff submitted that the sales of the Defendant's product can be affected only after excise clearance is obtained which was applied by the Defendant in June 2022 only. As the Defendant was not selling the products bearing the impugned trade dress for long, it cannot inhibit the court from granting an injunction.

The court held that *prima facie*, it is apparent that the present trade dress of the Defendant is nearly identical to the trade dress of the Plaintiff, to the extent that a similar colour combination is used, the placement of the name of the product is also similar, and the bottles, too, are similar in shape and colour. The court held that a customer of average intelligence and imperfect recollection, who comes across the Plaintiff's Royal Green Whisky, whether in packed or unpacked condition, on a particular date and, a few days later, comes across the Defendant's Royal Queen product would be confused between the two. The likelihood of confusion stands exacerbated by the phonetic similarity between the names Royal Queen and Royal Green. Even the lettering in which the names of the figure of the product on the bottles and the outer packaging of the Plaintiff's and the Defendant's products are similar and a similar green font is used.

The court noted that the test of triple identity is satisfied here as the two rival marks are deceptively similar. They are used for the same product, i.e., whisky. The trade dress in which the Plaintiff's and Defendant's products are sold are nearly identical. The products are available at the same outlets, i.e., liquor vends. They cater to the same category of consumers those who

imbibe alcoholic beverages. Thus, the court granted interim injunction noting where a prima facie case of infringement and passing off is made out the court has necessarily to injunct further release, manufacture, and sale of the infringing.

The court restrained the Defendant, as well as its proprietors, partners and all others acting on its behalf shall stand restrained from advertising, manufacturing, offering for sale, selling or dealing in any manner with alcoholic beverages using the mark ROYAL QUEEN and/or the packaging/trade dress or any other mark or trade dress which is deceptively similar to the registered trademark and trade dress of the Plaintiff till next hearing.

Yamini Manohar Vs. TKD Keerthi

Forum: High Court of Delhi

Case No.: CRP-IPD No. 4/2023, CM No. 48/2023 and CM No. 49/2023

Judgement Dated: 8th May 2023

Issues:

- Whether the plaintiff's failure to comply with Section 12A of the Commercial Courts Act warrants rejection of the plaint?
- Whether the suit filed by the plaintiff qualified for urgent interim relief?

Judgment:

The petitioner filed a revision petition against the order passed by the District Judge dismissing their application seeking rejection of the plaint. The suit was filed by the plaintiff seeking a permanent injunction for trademark infringement and passing off, along with other reliefs. The petitioner filed an application under Order VII Rule 11 of the CPC to reject the plaint on the grounds of non-compliance with Section 12A of the

Commercial Courts Act. The petitioner argued that the plaintiff should have undergone pre-institution mediation before filing the suit.

Petitioner/defendant contended that filing an application under Order XXXIX Rules 1 and 2 of CPC does not exempt the plaintiff from complying with Section 12A of the Commercial Courts Act. Compliance with Section 12A is mandatory, even if the plaintiff seeks interim relief. The Commercial Court did not properly determine if urgent interim relief was contemplated in the suit. Subsequently, the respondent/plaintiff contended that the reliance on the Patil Automation case is misplaced as it does not address cases involving urgent interim relief. Section 12A of the Commercial Courts Act does not require seeking leave from the court. The suits in question do not involve urgent interim relief. The suit cannot be dismissed solely based on non-compliance with Section 12A if urgent interim relief is sought.

It was held that the Commercial Court concluded that the suit filed by the plaintiff involved urgent interim relief against the defendant. Also, the plaintiff was not required to undergo pre-institution mediation as mandated by Section 12A (1) of the Commercial Courts Act. Hence, the present petition lacked merit and was dismissed, and all pending applications were disposed of.

Glaxo Group Limited v. Biogen Serums Private Limited

Forum: High Court of Delhi

Case No.: CS (COMM) 701/2022 and I.A. 16553/2022

Date: 10th May 2023

Issue:

- Whether the use of the impugned mark “BETNOL” by the defendant is infringing the plaintiff’s “BETNESOL” mark?

Order:

The plaintiff company is incorporated under the laws of England and Wales and part of the GSK group of companies. It is an international science-led global healthcare company that researches and develops a wide range of innovative specialty medicines. The mark “BETNESOL” was first adopted by the plaintiff in the early 1960s in relation to medicinal and pharmaceutical products, including injections and is now the registered proprietor of the mark “BETNESOL” in Class 5. A standalone google search for the word “BETNESOL” leads to the plaintiffs’ products, and the plaintiff has long and continuous use of the mark with a global reputation.

The defendant is engaged in the manufacturing, marketing, and sale of pharmaceutical and medicinal preparations under the mark “BETNOL”, used for medicine in the treatment of skin allergies.

The plaintiff first found out about the defendant’s use of the “BETNOL” mark in April 2022 through listings on third party websites like IndiaMart pursuant to which, the plaintiff sent a legal notice to the defendant. The defendant replied to this stating that it has withdrawn the brand “BETNOL” from the market on 1st May 2022; however, when the defendant’s listing continued to remain active on IndiaMart, the plaintiff sent another notice. In August 2022, the plaintiff became aware that the defendant had employed new packaging for the injection bearing the mark “BETNOL” and accordingly, the plaintiff filed the present suit.

Vide an order suit dated 12.10.2022, the Court granted an *ex-parte ad interim* injunction in favour of the plaintiff restraining the defendant from using the trademark “BETNOL”. The Court noted that the defendant deliberately chose not to enter appearance and since the maximum permissible period of 120 days in filing a written submission was over, it was evident that the defendant had no defence to put forth on merits.

The Court, in lieu of the arguments made, and the documents filed by the plaintiff, held that plaintiff had proved that it is the registered proprietor of “BETNESOL” mark in Class 5, being valid and subsisting and that the plaintiff has also been able to show its goodwill and reputation in respect of the same. The Court held explicitly that the plaintiff has established statutory and common law rights on account of its long usage of the

“BETNESOL” mark. Further, making a comparison between the marks of the plaintiff and defendant, the Court held that the mark of the defendant is deceptively similar to the plaintiffs’ “BETNESOL” in respect of the same products i.e., injections.

Noting that the defendant used the infringing mark with the intent to benefit from its business by drawing association with the plaintiff and its trademark, the Court held that this act of the defendant amounts not only to the infringement of the plaintiff’s trademark but also to passing off of the defendant’s goods as that of the plaintiff. Moreover, since the consumer base of the parties is the same, the defendant has not only taken unfair advantage of the reputation and goodwill of the plaintiffs’ mark but has also deceived unwary consumers of its association with the plaintiff. In view of these undisputed facts, the Court opined that no purpose would be served by the plaintiff leading *ex-parte* evidence and that this suit deserved to be decreed in favour of the plaintiff summarily.

Infiniti Retail Ltd. v. Croma through its Proprietor

Forum: High Court of Delhi

Case No.: CS(COMM) 71/2022, I.A. 1538/2022 (O-XXXIX R-1 & 2 of CPC), I.A. 1543/2022 (u/s 12A Commercial Courts Act), I.A. 10960/2022

Date: 12th May 2023

Issue:

- Whether the defendant’s use of the mark “CROMA” on its website constitutes trademark infringement and passing off?

Order:

The case was brought up by Infiniti Retail Limited, which is a part of TATA Group. It owns and manages a national chain of retail shops offering a wide range of electronics, consumer products, household appliances and allied goods such as televisions, home appliances, kitchen appliances, phones, computers, etc., under the mark “CROMA”.

The Plaintiff operates through its physical stores and website www.croma.com and is the registered proprietor of the mark “CROMA” and formative marks in Classes 9, 11 and 35 in relation to wide range of goods and services. In January 2022, the plaintiff came to know about the registration of the domain name www.crome.in, an impugned website using plaintiff’s well-known trademark “CROMA” by a third party. The said website was illegally occupied by third party who has been earning profit through targeted advertisements provided by a separate service. The plaintiff claimed that such use was infringing its trademark, and was an act of passing off by misleading the public, causing damage to the plaintiff’s reputation.

The Court vide its Order in 2022 granted an *ex parte* ad interim injunction in favour of the plaintiff restraining Defendant 1 from using the trademark ‘CROMA’. The Court said that the plaintiff had been able to prove that it was the registered proprietor of the well-known trademark ‘CROMA’ in several classes and the registrations were valid and remain in effect. The Court noted that the website of Defendant 1 was identically similar to that of the plaintiff and will surely create confusion in the minds of the people and the targeted public will associate the website with that of the plaintiff.

The Court was of opinion that the user might draw to the website due to the same or similar domain name, which could result in a user mistakenly accessing one domain name instead of the one intended. Therefore, it was considered that a domain name has all the characteristics of a trademark and could result in an act of passing off. Thus, it could create likelihood of confusion and mislead the public about its association with the Plaintiff.

The Court further said that it was clear that Defendant 1 had registered the impugned website under the name of the plaintiff’s trademark with the sole purpose of deceiving the public into believing that the impugned website is somehow associated with the plaintiff. Also, the Defendant 1 was earning profit through advertisements on the impugned website and was seeking to

offer the website for a large sum of money. The acts of Defendant 1 not only amounted to infringement of the well-known trademark of the plaintiff, but the Defendant also had dishonest intention to deceive customers for illegal profits.



Jindal Industries Private Limited V. Jindal Sanitaryware Private Limited and Another

Forum: High Court of Delhi

Case No: CS(COMM) 251/2023



Judgement: May 9, 2023

Issue:

- Whether the defendants mark  is infringing the Plaintiff's registered trademark  ?

Order:

The Plaintiff, Jindal Industries Private Limited, is a leading company in the steel sector that produces steel pipes and holds reputation in the pipe manufacturing industry. Jindal Sanitaryware Private Limited, the Defendant is a leading manufacturer of sanitary ware products.

The Plaintiff filed a suit against the Defendant with respect to the mark “JINDAL” used by the Defendant for PVC pipes. The Plaintiff claims that they obtained registrations for the work mark “JINDAL” for steel tubular poles, cast iron pipes, galvanised iron pipes and PVC pipes in 2006 and have registration in device mark  since 1981. The Defendant argued that they also possess trademark registration for  in Classes 20 and 11 since 1988.

The Plaintiff argued that though Defendant possessed trademark registration for the device mark in Class 20, but it only includes PVC water storage tanks, PVC cabinets, and mirror cabinet and mirror frame made of plastic and in Class 11 covering cistern and cistern parts, floated balls, seat covers and bathtubs all made of plastic. However, nowhere the Defendant has registration for the mark “JINDAL” in respect of PVC pipes. The defendant started using the mark “JINDAL” for PVC pipes for which they have no registration. The plaintiff claims that it is the prior user in using the mark “JINDAL” in respect of PVC pipes and also, hold registration for the word mark “JINDAL” for PVC pipes since 2006.

The Court held that that the registration of the “JINDAL” device mark, held by Defendant, do not cover PVC pipes and the plaintiff, on the other hand, held a registration of the word mark “JINDAL” for PVC pipes since 2006. Also, the court opined that the Plaintiff is the prior user of the mark “JINDAL” for PVC pipes and Defendant has registered mark “J PLEX” for such pipes and only recently start using “JINDAL” along with the mark “J PLEX” for such goods.

The Court noted that on the website of Defendant, the recital was that “JINDAL” is the mother brand of Defendant, which provides its entire range of sanitaryware and plumbing products whereas “J PLEX” was another of Defendant’s sub-brands, providing its pipes and fittings range of products. The Court opined that by applying the principle of balance of convenience at this stage, the Defendant would not be subjected to any serious prejudice if it was restrained from using “JINDAL” mark on its PVC pipes, as it was already using the mark “J PLEX”, which was registered in Defendant’s favour.

Thus, the Court held that prima facie, a case of infringement was made out against the defendants by use of the mark “JINDAL” in respect of PVC pipes, for which the plaintiff had registration since 2006. The Court directed that till the next date of hearing, the defendants were restrained from using

the marks “JINDAL” or any other mark deceptively similar to the plaintiff’s trademark “JINDAL” in any manner on PVC pipes.

Mahendra Dattu Gore v. State of Maharashtra

Forum: High Court of Bombay

Case No.: CA 496/2023

Date: 17th May 2023

Issue:

- Whether the police can seal a premises while exercising powers granted under Section 115(4) of the Trade Marks Act, 1999?

Order:

The petition was filed seeking the urgent de-sealing of a factory alleged to have been sealed under Section 115 of the Trade Marks Act, 1999, pursuant to an FIR registered with the Chakan Police Station for offences under Section 420 of the Indian Penal Code, 1860 and Sections 103, 104 and 105 of the Trade Marks Act.

The petitioner submitted that Section 115 of the Trade Marks Act does not empower the police officer to seal the factory premises and that by way of Section 115(4), the police only have the authority to seize, without warrant, the goods, die, block, machine, plater, other instruments, or things involved in committing the offence. The respondents, on the other hand, submitted that the machinery being huge in size, it was not possible for the police officer to seize the same as envisaged under Section 115(4) of the Trade Marks Act and, therefore, to secure the machinery and ensure that the same is not used in the commission of any offence, the factory premises were sealed. Additionally, the respondents submitted that the petitioner had an alternate remedy before the Judicial Magistrate, First Class where the seized articles are required to be produced by the police.

The Court, on perusal of Section 115 of the Trade Marks Act, noted that there is no power vested in the police to seal the factory premises where the incriminating articles are situated and that the provisions of Section 115(4) only permit the police officer to seize without warrant, the articles/items enumerated therein. Further, regarding the respondents' submission of alternate remedy, the Court held that the provisions indicate that where there is seizure of articles, the same is required to be produced before the Magistrate, however, there is no seizure in the present case. Holding that the petitioner has established a prima facie case for grant of ad-interim relief for de-sealing of the factory premises, the Court ordered the same to be done. The Court further held that it is open for the police to seize the incriminating articles in accordance with Section 115(4) of the Trade Marks Act. The Court ordered for the factory premises to be de-sealed and further submitted that seizure of incriminating articles will be done in accordance with the provisions of the law.

Mayo Foundation v. Bodhisatva Charitable Trust and Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 920/2022, I.A. 22385/2022

Order Dated: 29th May 2023

Issues:


- Whether the adoption of the mark “MAYO” by the defendants was honest?
- Whether the use of the mark “MAYO” by the defendants amounted to infringement as well as passing off?

Order:

The plaintiff is a wholly owned subsidiary of Mayo Clinic, a world-famous charitable organisation incorporated in the United States of America (“USA”). 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. '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. The plaintiff became aware of the use trademark 'MAYO' by the defendant no.1 in 2014 and subsequently sent a legal notice to them about the same.

Defendant no. 1 had been using the mark 'MAYO' for the defendant institutions since 2011/12 and had filed trademark application no.2321790

for the device mark,  in Class 41 which was opposed by the plaintiff. The said application stood abandoned by the order dated 21st March 2018 of the Trade Marks Registry. However, in 2020, on being notified of the Defendant no.1's continued use of the mark 'MAYO' in relation to healthcare and educational services, the plaintiff filed an application for pre-litigation mediation with defendant no.1 before the Delhi High Court Mediation & Conciliation Centre. However, the mediation proceedings were closed as "non-starter" as no response was received from the defendant no.1. The plaintiff filed the present suit 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.

In its reply to the said application, the defendants contented that the defendant institutions mainly cater to patients from small towns of Eastern Uttar Pradesh, who have not heard of the plaintiff or Mayo Clinic, USA and, therefore, there cannot be any question of confusion in the relevant section of the public. It was also contended that the plaintiff cannot claim monopoly over the word 'MAYO' as it is not a coined term and further, that the 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. Additionally, the defendants submitted that the Court does not have the territorial jurisdiction to entertain the present suit merely because

defendants' websites are accessible in Delhi and that the reliefs sought in the present suit are barred by delay, laches, and acquiescence.


While making its submissions before the Court, the plaintiff submitted that defendant no. 4's website, clearly states that the defendants gathered inspiration from Dr. William Mayo of 'MAYO CLINIC', U.S.A. and that its founder studied medicine and worked in hospitals in the U.S.A making the adoption of the trademark 'MAYO' by the defendants dishonest and an attempt to ride on the goodwill and reputation of the plaintiff. They further argued that the adoption of trademark by the defendants being dishonest, the defence of delay cannot be taken by the defendants and that 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.

The defendants submitted that they have been using the mark 'MAYO' since the year 1995 in relation to healthcare facilities and even though prior registrations of the mark 'MAYO' and 'MAYO CLINIC' in favour of the plaintiff have existed since 1992, these were only in Class 16. Subsequent registrations granted to the plaintiff in 2008 would not matter as the defendants had already made extensive use of the word 'MAYO' by then. They also submitted that, since the usage of the mark by 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. Additionally, it was submitted by the defendants that 'MAYO' is a common name in India, also being used by the 'MAYO COLLEGE' in Rajasthan, India. The defendants also submitted that they were ready to add the prefix, 'Dr Kailash Narayan' to their existing names wherever the mark 'MAYO' occurs to distinguish the same from the plaintiff's trademark in response to which the plaintiff submitted that the fact that the defendants are ready to this shows that the adoption of the mark 'MAYO' by the defendants in the first instance was indefensible and that the balance of convenience is in favour of the plaintiff as the defendants can easily transition to a new mark.


The Court noted that the plaintiff got the word marks 'MAYO' and 'MAYO CLINIC' as well as the device mark 'MAYO', registered under Class 16 dealing with *'periodicals, medical or other journals, printed matter'* in

1992. At the time, there were only Classes 1 to 34 under the Trade Marks Act, 1999 and therefore, the registration under Class 41 and 44, respectively dealing with educational services and medical and health care services were not available to the plaintiff. Having noted this, the Court held that '*hospitals*' and '*education services providing courses of 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 and held that the defendants using identical marks in respect of services that are like those of the plaintiff, makes for a *prima facie* case of infringement under Section 29(2)(a) of the Trade Marks Act, 1999. Further, the Court also held that the plaintiff obtained registration of the mark 'MAYO CLINIC' under Class 41 in 2008, whereas the defendants began to use 'MAYO' for education purposes only in the year 2011/2012 and therefore, the defence of prior use under Section 34 of the Trade Marks Act, 1999 would not be available to the defendants.

Holding the use of the mark 'MAYO' by the defendants in relation to healthcare services to be completely arbitrary and distinctive, the Court noted that the use of the mark in 'MAYO COLLEGE' is not relevant as it has nothing to do with the field of healthcare or medical education. The Court also found it relevant to point out that the defendants themselves had

filed an application for registration of the device mark,  and therefore, it cannot argue that 'MAYO' is non-distinctive. The Court noted that the founder of the defendant institutions was not only aware of 'Mayo Clinic' in the USA but also drew inspiration from Dr. William Mayo, the founder of 'Mayo Clinic', USA and in its *prima facie* view, held that the adoption of the name 'MAYO' by the defendants was clearly dishonest and further held that, because of this even if there was a delay on part of the plaintiff in filing the present suit, the statutory right of the plaintiff could not be denied.

On the question of acquiescence, the Court pointed out that the plaintiff had sent a legal notice to the defendants as far back as 2014 and it had also placed on record the reply of the defendants to this notice, which has not been denied by the defendants. Further, 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, but they continued to use the mark of the plaintiff in a dishonest manner. The defendants also failed to participate in mediation proceedings initiated by the plaintiff and therefore, considering these instances, the Court held that it cannot be said that there was any acquiescence on part of the plaintiff to the use of the mark 'MAYO' by the defendants. In the added matter of the prefix, the Court noted that if the defendants are willing to add the proposed prefix, 'Dr. Kailash Narayan', to their institutions, there is no justification for them to continue using 'MAYO' as a part of their name and held that even with the addition of the proposed prefix 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 defendants with the plaintiff and therefore, infringement would continue.

In the matter of passing off, the Court, while upholding the test of '*first in the world market*', held that it cannot be denied that the name 'MAYO' was first adopted and used by the plaintiff in respect of hospitals and medical educational institutes and that the mark 'MAYO' has attained global reputation as well as sufficient reputation and goodwill in India evidenced from 33 crore sessions by Indian users on www.mayoclinic.org and over 10 lakh sessions by Indian users on the www.mayo.edu. Holding the adoption by the defendants of the mark 'MAYO' to be an attempt to ride on the goodwill and reputation of the plaintiff, the Court held that a *prima facie* case of passing off has been made out by the plaintiff. Finally, on the question of territorial jurisdiction, the Court expressed its view that the issue is a mixed question of law and fact which would have to be finally determined on the basis of evidence produced by both sides, however, based on the averments made in the plaint and the material on record, at the *prima facie* stage, it was not inclined to reject the suit on the ground of territorial jurisdiction.

The balance of convenience was held to be in favour of the plaintiff as the use of the identical mark 'MAYO' by the defendants is likely to cause confusion in the minds of the consumer and the plaintiff would continue to suffer irreparable injury to its goodwill and reputation. Accordingly, the

defendants, their directors, officers, servants, agents, distributors, stockists, representatives and anyone acting for or on their behalf were restrained from using the plaintiff's trade mark/ name "MAYO" or any mark/name deceptively similar thereto, in any manner and listings on any social media platforms and third-party websites till the final adjudication of the suit.

Pepsico Inc. and Anr. v. Jagpin Breweries Ltd. and Anr.

Forum: High Court of Delhi

Case No.: CS(COMM) 288/2022

Date: 1st May 2023

Issues:

- Whether the impugned mark and its Hindi translation used by the defendant was infringing the plaintiff's mark "MIRINDA"?

Order:

Plaintiff No. 1 is a corporation incorporated under the laws of the State of Northern Carolina in the USA and is one of the world's most reputed consumer products companies engaged in manufacturing and distribution of non-alcoholic beverages, packed and aerated waters and snack foods. Plaintiff No.2 is a wholly owned subsidiary of Plaintiff No.1 and engaged in the sale of these products under its own marks and those of Plaintiff No.1 that it is authorized to use and protect. The concerned mark "MIRINDA" is claimed by the plaintiffs to be first adopted in 1959 and used by Plaintiff No.1, and/or its predecessors, for over the past 60 years.

The earliest registration of the mark in India dates to the year 1997 in Class 32 and additionally, "MIRINDA" marks have been registered or applications for registration have been made by Plaintiff No.1 or its subsidiaries in about 190 countries. The plaintiffs became aware that Defendant No. 2, who is the Director of Defendant No.1, applied for registration of the mark "Continental Mirinda Beer" in Class 32 with the

user claim from 06.07.2015 and on further investigation found that Defendant No.1 was currently using the Hindi transliteration of the mark MIRINDA i.e., , in relation to country made liquor and had also filed an application seeking registration of the mark under Class 33 before the Trade Marks Registry, which was abandoned subsequently. The plaintiffs, therefore, alleged that “MIRINDA” marks being the registered marks of Plaintiff No.1, the use of the impugned mark or its deceptive variations by the defendants amounts to infringement of the statutory rights of Plaintiff No.1 under Section 29 of the Trade Marks Act, 1999. Further, the continued use of by the defendants is bound to confuse the public and make them assume that the products sold under the impugned mark are those of the plaintiffs, which makes it clear that the defendants intend to take unfair advantage of the goodwill and reputation of the Plaintiff No.1’s MIRINDA marks. The plaintiffs also contended that the “MIRINDA” marks enjoy the status of well-known marks within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999 which entitles them to the highest degree of protection. It was further argued that the use of the impugned mark by the defendants is inherent in its misrepresentation to the consumers that the defendants’ products originate from or are licensed by the Plaintiffs, causing damage to the Plaintiff, and amounting to passing off.

The Court held that the plaintiffs had made out a prima facie case for the grant of ex-parte ad interim injunction and that the balance of convenience was in their favour. Further, the Court also noted that the plaintiffs were likely to suffer irreparable harm in case the injunction, as prayed for, was not granted. Being satisfied of these conditions basis the facts of the case, the Court restrained the defendants, by themselves, their agents, representatives, servants, men, distributors and all those acting in concert with them or on their behalf or claiming under or through them or otherwise howsoever, from using the transliteration of the trademark “MIRINDA” and/or any other language, and/or any other mark which may be identical and/or deceptively similar to Plaintiff No.1’s registered trademark “MIRINDA” in relation to their products and/or business activities and/or in any other manner which infringes the statutory rights of Plaintiff No.1 in “MIRINDA” marks.

Jaquar Company Pvt Ltd V. Villeroy Boch Ag & Anr.

Forum: High Court of Delhi

Case No: CS(COMM) 777/2022

Order Dated: 4th May 2023

Issues:

- Whether the defendant's mark “ARTIS” is deceptively similar to the Plaintiff's mark “ARTIZ” and infringed the said mark?
- Is Villeroy using “ARTIS” in a trademark sense?

Order:

The present suit is related to the dispute between two established brands in the field of sanitary and bathroom fitting products, namely, M/s Jaquar & Company Pvt. Ltd and M/s Villeroy & Boch AG, Villeroy & Boch Sales India Pvt. Ltd with respect to the usage of the words “ARTIZE” and “ARTIS”, respectively.

The plaintiff- Jaquar filed a suit against the defendant for an interim injunction claiming that they have adopted the word “ARTIZE” in the year 2008 and have been in continuous and uninterrupted use of the same. The defendant, Villeroy argued that the word “ARTIS” is a Latin term which means “art” and thus “ARTIZE” is nothing but a derivative of the same and is purely descriptive, on which no monopoly or exclusivity can be claimed. They also argued that “ARTIS” is a sub-brand and used in conjunction with their other well-known brand Villeroy and Boch therefore such use does not amount to infringement or passing off the Plaintiff's trademark.

In November 2022, Plaintiff became aware of the defendant's launch of identical products under the impugned mark “ARTIS” through an article. The plaintiff claims that both parties are market competitors hence the

defendant is aware of the plaintiff's products that are sold under the mark "ARTIZE".

The plaintiff claims that their trademark "ARTIZE" has a well-established reputation and goodwill as it's been fourteen years since they have been using their trademark continuously and uninterrupted. Hence, because of the longevity of the trademark "ARTIZE" it is solely and exclusively associated with the Plaintiff. The Defendant argued that their company is years old and has established a global presence; Villeroy is a luxury brand for bathroom products, and it has various series of products under different names and one of them is "ARTIS". Such names are only meant to distinguish between different product categories and in no way replace the value of the brand itself. Every such product bears the brand logo. The defendants also argued that "ARTIS" is only a sub-brand in conjunction with their well-known brand Villeroy & Boch and the use of the brand name along with the impugned mark is sufficient to distinguish and will not lead to public confusion.

The plaintiff has also obtained trademark registration for formative marks in classes 11 and 35. Plaintiff claims that "ARTIZE" is an essential feature of their trademark registration and use of a deceptively similar mark by Defendant under the same product category will create confusion in the minds of the people and is an infringement of the plaintiff's trademark under Section 29(1) of the Trademark Act, 1999. The Defendant argued that "ARTIS" is neither phonetically nor visually or structurally identical to "ARTIZE". And that their individual brand name act as the source identifier for the products also there is no likelihood of confusion between the two marks as Defendant's products are priced higher as compared to Plaintiff resulting in a difference in targeted customers.

The Plaintiff said that there has been no delay on the part of the Plaintiff. Immediately upon learning of the impugned activities, Plaintiff acted promptly and filed the instant suit. The defendant argued that there has been

a substantial delay in filing the instant suit as Defendant launched the “ARTIS” segment of products in 2015 but the present case is filed in 2021. Thus, Plaintiff would have known of the use of the impugned mark from the start itself and chose to sit over their rights. “ARTIS” series was launched at an international Trade Fair where Plaintiff was the active participant thus, ought to have known of the launch; therefore, Plaintiff's case is also hit by acquiescence as Defendant has been using the “ARTIS” mark since 2015.

The Plaintiff claimed that the balance of inconvenience lies with them and in case an interim junction is not granted they will suffer insufferable harm and loss. Defendant claimed that both parties have been co-existing in the market since 2015, and therefore, an interim injunction must not be granted during the pendency of the suit.

The Court held that if a mark is used in a way that identifies the source of goods, then it is being used as a trademark irrespective of whether it is a sub-brand or an individual brand. The Court also said that once the defendant has opted to gain trademark protection for “ARTIS” for identical goods in the European Union, they have acknowledged the distinctiveness of the mark, which demonstrates that the Defendant has used “ARTIS” in a trademark sense and intends to continue doing so which weaken their argument that the mark is purely descriptive and that Plaintiff cannot claim monopoly over “ARTIZE”, is flawed and cannot be accepted.

The court held for the argument put forth by the defendant with respect to acquiescence that the mere absence of legal action by the trademark owner is not sufficient to establish acquiescence. The trademark owner's conduct or inaction must suggest a conscious decision that allows the other party to use the trademark. Mere participation in an international exhibition is not sufficient to know that Plaintiff permitted Defendant to erode their rights. Also, the facts of the case do not indicate that Plaintiff encouraged Defendant to use “ARTIS” in the Indian market, where Plaintiff is the

dominant player. The court decided that the balance of convenience is in favour of granting an injunction to Plaintiff.


Absogain Retail Solutions vs Puma SE

Forum: High Court of Delhi

Case No.: RFA(COMM) 39/2023 & CM APPLs. 10165-10166/2023

Date: 15th May 2023

Issue:

- Whether the logo used by the appellant was deceptively similar to respondent's registered trademark "Form Strip logo"  and constituted infringement?

Order:

Puma had initially filed a lawsuit against Absogain, alleging that the defendant had engaged in various activities such as manufacturing, trading, selling, and marketing goods, including shoes and accessories, utilizing a logo closely resembling Puma's registered "Form Strip logo". The district court had previously granted a decree for permanent injunction against the defendant.

During the appeal, the defendant argued that it was unaware of Puma's registered trademark and that the design used on their product was a common one. They asserted that if they were aware about Puma's registration, they would not have used a similar design. Additionally, the defendant challenged the territorial jurisdiction of the trial court. They highlighted the testimony of the plaintiff's witness, who stated that there was no proof of defendant selling infringing goods in Delhi, both offline and online. They also contended that the damages awarded by the trial court were unreasonable and exceeded the scope of the issue framed.

The plaintiff countered by asserting that the defendant failed to provide any evidence supporting their claim of lack of territorial jurisdiction. They presented various documents, including internet downloads, photographs, and invoices, to demonstrate that the infringing products were sold on online platforms accessible from Delhi. The plaintiff also emphasized the defendant's history of copying famous registered designs, as evidenced by their registration application combining designs of other renowned brands.

The Delhi High Court dismissed the appellant-defendant's arguments and upheld the trial court's judgment. The court compared both the products as under:



After comparing the products, the court held that the plaintiff's design was unique and eligible for registration. The court also noted the defendant's track record of copying famous registered designs, further establishing them as a repeat offender. Consequently, the court rejected the appellant-defendant's argument of ignorance regarding the plaintiff's registration. Based on the evidence, including internet downloads and invoices, the court affirmed the trial court's jurisdiction to hear and decide the case. Considering the defendant's repeated infringement and the sale of infringing

products on an interactive website, the court upheld the damages awarded by the trial court.

Institut Europeen D Administration Des Affaires Association v. Fullstack Education (P) Ltd

Forum: High Court of Delhi

Case No.: C.O. (COMM. IPD-TM) 1/2021


Order Dated: 17th May 2023



Issue:

- Whether the respondents' mark "INSAID" infringed upon the petitioner's mark "INSEAD" on the grounds of phonetic similarity?

Order:

The petitioner, a business school found in 1957, has been operating under the name Institut Europeen D Administration Des Affaires Association

(‘INSEAD’) and logo . The petitioner had obtained registration for the word mark “INSEAD” on a ‘proposed to be used’ basis along with registrations for the device mark in Classes 41, 35 and 16.

The respondents operate a similar institution under the name International School of AI and Data Science (‘INSAID’) and logo . The respondent had registered its mark  in Class 41 (education; providing of training; entertainment; sporting and cultural activities).

It was claimed by the petitioner that the respondent's mark “INSAID” was deceptively similar to its mark “INSEAD”, and the two marks were phonetically indistinguishable.

It was observed by the Court that the petitioner registered its word mark “INSEAD” in 2007 and its device mark in 2012, as compared to the

respondents' claimed use since 2018. This, it was observed by the Court that the petitioner was the prior user of the mark "INSEAD", and rejected the respondents' claims that the marks "INSEAD" and "INSAID" were not phonetically similar.

The Court further observed that the outlook of phonetic similarity must be assessed from the consumer's point of view of the consumer. The Court applied the classical test of phonetic similarity as formulated in *Pianotist Co.'s Application, Re*, (1906) 23 RPC 774, and observed that such infringement matters must be decided on the 'initial interest confusion' basis. If there was any chance of confusion after the initial encounter by a consumer, then it is, ipso facto, an infringement case. The fact that such confusion might be dispelled later, does not eliminate such infringement.

The Court stated that under Section 11(1)(b) of the Act, a mark could not be registered if it was similar to an existing mark, such marks were used for identical or similar, goods or services, and there was a likelihood of confusion among the public.

Since the marks "INSAID" and "INSEAD" were phonetically similar and used for similar services, there was a likelihood of confusion ipso facto. The mere fact that the overall logos of the two marks were accompanied by pictorial representations or other features that may distinguish the marks as device marks, would not diminish the confusingly similar nature of the two marks.

The Court said that the use of the acronym "INSAID" which is phonetically similar to the "INSEAD" could not be said to be honest or concurrent because the CEO of INSAID was well of the petitioner's institution and continued with the adoption of the acronym INSAID. The Court observed that no phonetic search was conducted and only a word mark search was conducted, which did not highlight the "INSEAD" mark as a suggested similar mark.

Thus, the Court directed that where an application was submitted for registration of a mark which involved a word, then a word mark search along with a phonetic search should be conducted even at the preliminary stage. Since the case falls under the ambit of Section 11(1)(b) of the Act, the registration of the respondents' mark could not be sustained due to its similarity to the petitioner's trademark "INSEAD". The Court further ordered for the registration of the impugned device mark "INSAID" to be quashed and set aside.

Fybro Electric Pvt. Ltd. Vs. Mukesh Singh & Anr.

Forum: High Court of Delhi

Case No.: C.O. (COMM.IPD-TM) 10/2021 & I.A. 12679/2021

Judgement Dated: 18th May 2023

Issues:

- Whether the mark "Pbros" registered by Respondent 1 is eligible for registration under Section 11(1)(b) of the Trademarks Act?
- Whether the petitioner has the right to request rectification of the register and removal of the mark under Section 57 of the Trademarks Act?

Judgment:

The petitioner filed a petition under Section 57(2) of the Trademarks Act 1999, requesting rectification of the Trademarks Register by removing the mark "Pbros" registered in favour of Respondent 1. The mark in question was registered under No. 4643936 in Class 11 starting from September 7, 2020.

The petitioner argued that the mark "Pbros" registered by Respondent 1 should not have been granted registration as it is similar to the petitioner's mark "Fybro", and both marks are registered for identical goods, which could cause confusion among the public. Evidence was presented, including

invoices, to establish that the petitioner has been using their mark since 2011.

Furthermore, the petitioner argued that since Respondent 1 filed the application for registration on a proposed to be used basis on September 7, 2020, their use of the mark cannot predate that date.

Due to the deceptive similarity between the marks, the petitioner requested rectification of the register by removing the impugned mark under Section 11(1)(b) read with Section 57 of the Trademarks Act.

The respondent submitted that the petitioner did not challenge the application for registration of the impugned mark when it was advertised. They also contended that the marks of the petitioner and respondent were phonetically, textually, visually, structurally, and design-wise, distinct, and different in entirety, and there was no possibility of any confusion in the minds of the public.

The respondent also claimed that it operated its business in different spheres and in different markets than the petitioner and the petitioner failed to indicate that the registration of the impugned mark caused them any damage.

The Court disagreed with the petitioner's claims that the registration of the impugned mark by the respondent was malafide. However, it was observed that a case of grant of relief existed under Section 11(1)(b) of the Trade Marks Act.

The court held that the marks "Pbros" and "Fybros" are phonetically similar and that the marks are used for identical goods. The court refuted the respondent's argument that there was no opposition to the mark by the petitioner after its advertisement and held that any inaction at the time of advertisement does not divest the petitioner's right to seek rectification under Section 57.

Abu Dhabi Global Market Vs. Registrar of Trademarks, Delhi

Forum: High Court of Delhi

Case No.: C.A. (COMM. IPD-TM) 10/2023

Order Dated: 18th May 2023

Issues:

- Whether the rejection of application of appellant's mark by Registry of Trademarks the grounds that the mark contains the word 'Abu Dhabi' which is a geographical name, and the mark not being distinctive in nature, valid?
- Whether the appellant's mark, after the addition of the words "ABU DHABI GLOBAL MARKET" eligible for registration?

Order:

The Registrar of Trademarks rejected the application to register of applicant on the that the Attorney of applicant failed to establish the distinctiveness character of the mark by filing the evidence of use through an affidavit. It was held by the Registrar that the mark was neither coined not invented.

An appeal was filed against the order passed, where the appellant submitted that the finding that mark was not distinctive, was completely unreasonable by any reason as the mark was already registered in favour of the appellant. Consequently, there was recognition on the part of the office of the Registrar of Trademarks, that the device mark was distinctive and did not breach any of the occupying factors envisaged by Section 9 of the Trade Marks Act, 1999, as would bar registration of the mark. It was also submitted that if the mark was distinctive, the mark could not lose its distinctiveness by the addition of the words “ABU DHABI GLOBAL MARKET”.

The appellant also submitted that the mark “ABU DHABI GLOBAL MARKET” had been adopted by the appellant under the Federal Laws of

United Arab Emirates (UAE) and issued in the name of the President of the UAE, which stated that “a Financial free zone shall be established under the name ‘Abu Dhabi Global Market’.” The respondent contended that Abu Dhabi was the name of a place and constituted the most prominent part of the mark which was sought to be registered. Therefore, the Assistant Registrar had correctly refused to register the mark in view of the absolute prohibition against such registration mentioned in Section 9(1)(b) of the Act.

The impugned order dated 9th December 2022, rejected the application on the grounds that the mark was not distinctive in nature and word “Abu Dhabi” is a geographical name. Although, the mark was a composite mark, merging the words “Abu Dhabi Global Market” with logo and adding the words “Abu Dhabi Global Market” below the logo would not lose its distinctiveness. The requirement for providing evidence of the mark’s usage to establish distinctiveness was not necessary, and the Assistant Registrar could not have rejected to register the mark on the grounds that, it is nor “coined” or “inventive”.

Due to abovementioned reasoning, the impugned order was quashed and set aside. The court held that the mark could be registered as a Composite Mark, and the evidence of the mark’s usage was not required to establish the distinctiveness.

Rukhmani Keshwani Trading as Vishwas Agarbatti Store v. Naresh Jeswani

Forum: High Court of Delhi

Case No.: RFA (COMM) 6/2023

Order Dated: 25th May 2023

Issue: Whether the Trial Court was right in rejecting the plaint of the Plaintiff by invoking powers under Order 7 Rule 11 of the Code of Civil Procedure, 1908.

Order: An appeal was filed by the Plaintiff-appellant against the order of the Trial court, where the plaint was rejected under Order 7 Rule 11 of the Code of Civil Procedure. It was noted by the trial court that the Plaintiff-appellant had not carried out any investigation and failed to produce tax invoices or decoy purchase documents that proved that Defendant had been selling infringing goods of the Plaintiff within Territorial jurisdiction of the court. The Plaintiff-appellant submitted that the Trial Court has committed a ‘manifest illegality’ and that while dealing with applications under Order 7, Rule 11, the submission made in the plaint alone is liable to be considered.

The court perused the records and referred to precedents that deal with the very issue. The cases referred in the matter reiterated that an objection to the territorial jurisdiction in an application under Order 7, Rule 10 of the Code of Civil Procedure is by way of a demurrer, that is, the objection to territorial jurisdiction must be construed after taking all the averments in the plaint to be correct. In another case, the Supreme Court has observed that when an objection to jurisdiction is raised by way of demurrer and not at the trial, the objection must proceed on the basis that the facts, as pleaded by the initiator of the impugned procedure, are true. Keeping these points in consideration, the appeal was allowed, and the previous order as passed by the Trial Court was set aside.

Fybros Electric Pvt. Ltd. vs. Vasu Dev Gupta Trading as Vasu Electronics

Forum: High Court of Delhi


Case No.: C.O. (COMM. IPD-TM) 13/2021 and I.A. 13372/2021


Judgment Dated: 25th May 2023

Issues:

- Whether the Respondent’s mark **NJBROS** is liable to be removed from the Trade Marks Register by applying Section 57 read with Section 11(1)(b) of the Trade Marks Act, 1999 (“the Act”)?

- What constitutes “*common to the trade*” under Section 17(2)(b) of the Act, and whether the term “BROS” is common to the trade?
- Whether the adoption of the Respondent’s mark **NJBROS** was *bona fide*?

Order: The Petitioner, being the registered proprietor of the mark  in classes 9 and 11, challenged the registration of the Respondent’s wordmark **NJBROS** registered in class 11 (“impugned mark”) under Section 57(2) read with Section 11(1)(b) of the Act, submitting that:


- (i) the mark **NJBROS** is deceptively similar to the mark ,
- (ii) the goods in respect of which the two marks are presently being used are allied and cognate,
- (iii) the Petitioner has a subsisting registration for its mark in Class 11, for the same goods in respect of which the impugned **NJBROS** mark is registered in favour of the Respondent, and
- (iv) there is, therefore, a likelihood of confusion in the minds of the public, if the marks are allowed to co-exist.

The Petitioner further produced evidence to show the use of its mark since 2010-11, while the impugned mark is filed on a *proposed to be used* basis, thereby claiming not only priority of registration but also priority of use.

The Respondent contended that the adoption of the impugned mark **NJBROS** was *bona fide* as the same was derived from the names of two brothers, Nitin and Jatin. Moreover, the Respondent argued that the suffix “BROS” is common to the trade and therefore the Petitioner cannot claim any exclusivity over it as per Section 17 of the Act. To support this claim, the Respondent submitted a copy of the search reports from the online records of the Trade Marks Registry, showing the use of “BROS” in several marks. The Respondent also contended that while the Petitioner’s mark is registered in both classes 9 and 11, the proof of actual use of the mark is not available for Class 11, in which the impugned mark is registered, and therefore, Section 11 will not apply.


As for the first issue, the Court enumerated the essential requirements for the applicability of Section 11(1)(b) namely, (i) similarity to an earlier trademark, (ii) identity or similarity of the goods or services covered by the conflicting trademarks, and (iii) likelihood of confusion thereof.

The Court noted firstly that the conflicting marks are similar. The Court relied on its pronouncement which was made a few days before this in favour of the same Petitioner, in the case of *Fybro's Electric Pvt. Ltd. v.*

Mukesh Singh, wherein the conflicting marks  were held to be similar. The Court held the same ruling to apply *mutatis mutandis* to the instant case.

The Court further elaborated the *classic test of similarity* by relying on various landmark cases which have laid down that the question of similarity must be approached from the point of view of a man of average intelligence and imperfect recollection. What is to be seen is the overall structure and phonetic similarity without splitting it into parts or considering the etymological meaning. Where the Petitioner's mark essentially consisted of a word, and the word which constituted the dominant part of the impugned mark was phonetically similar, the presence of added material in the conflicting marks would not derogate from the similarity between the two marks.

Thus, the first requirement of Section 11(1)(b) stood satisfied. Coming to the second requirement, the Court noted, contrary to the Respondent's contention that the Petitioner's mark is not being *used* for the goods in class 11, that the expression "*covered by the trademark*" in Section 11 cannot be equated with the words "*in respect of which the mark is used*". Coverage of a trademark has to be decided based on the certificate of registration which sets out the goods in respect of which the trademark is registered. All such goods would be *covered by the trademark*. Here, the conflicting marks were registered in class 11 covering the same goods.

The Court further noted that, even if one were to go by the user of the conflicting marks, it was seen that the Petitioner uses its mark  in respect of wires, cables, switchgear and lightning systems and the

Respondent uses **NJBROS** for electronic items and home appliances. Thus, the goods are allied and cognate even if not identical, and there exists a clear likelihood of confusion. Thus, the other two requirements of Section 11(1)(b) were also satisfied, and it was applicable in this case.

As for the second issue, the Court while relying on landmark cases, opined that to ascertain whether something is “*common to the trade*”, one cannot merely rely on a search report from the online records. The addition of the article “*the*” in the phrase “*common to trade*” makes the word “trade” a noun instead of a verb. That is, it is to be seen if the question words are common to that specific trade. The Court further described the word “common” to mean frequent, customary, or habitual. To ascertain such commonality, evidence in the form of statistical figures is to be looked at, and the onus of proving such commonality lies on the party who makes the assertion.

In the case at hand, the argument of the Respondent was dismissed as the same was not raised in the pleadings. And in any case, the search report results were not enough to establish the commonality of the term “BROS”. Hence, Section 17(2)(b) was not applicable.

As for the last issue regarding *the bona fide* adoption of the impugned mark by the Respondent, the Court held that Section 11 is not bound by the ground of *bona fide* adoption. While Section 11 is subject to Section 12 however, Section 12 talks about honest and concurrent users and not *bona fide* adoption. And therefore, it is not relevant for the applicability of Section 11 if a mark was adopted *bona fide*. In conclusion, the Court directed the Registrar to remove the impugned mark **NJBROS** from the Register of Trade Marks under Section 57(2) read with Section 11(1)(b) of the Act.

Resilient Innovations Pvt. Ltd. Vs. Phonepe Private Limited & Anr.

Forum: High Court of Delhi




Case No.: RFA(OS)(COMM) 8/2021

Judgment Dated: 25th May 2023

Issues:

- Whether the appeals preferred by RIPL are maintainable?
- Whether Section 124 of the Trade Marks Act, 1999 is applicable over the matter?

Judgment:



PhonePe Pvt. Ltd. (PPL), claimed to be using its logo  since September 2015 which was placed on register on December 2016. RIPL applied for **Bharat**  in January 2018 which was withdrawn in November 2018 pursuant to addressal of legal notice from PPL. RIPL continued using **BharatPe**  instead. In May 2019, PPL instituted a suit for infringement and passing off against RIPL seeking injunction against use of deceptive variant of "Pe" or "PhonePe" before the Delhi High Court. An interim injunction was not granted, however RIPL was directed to maintain accounts of profit. RIPL, subsequently filed for "PostPe" trademark in April 2021 which was then opposed by PPL in September 2021. In October 2021, RIPL initiated rectification petitions against PPL's trademarks which were dismissed via Single Judge's judgment. PPL also filed suit before the Bombay High Court asserting that RIPL's continued use of its "PostPe" trademark was infringing its trademarks "PhonePe", and its variants.


Two issues arose in adjudication of these appeals – maintainability of appeals as PPL contended that there is no intra-court appeal available against a judgment passed under Section 57 of the Trade Marks Act (rectification provision) and if the Single Judge's judgment was rightly passed.



With respect to first issue, PPL contended that rectification provision of Trade Marks Act (including amendments incorporated after abolition of IPAB) does not provide for an intra-court appeal in matters where the decision on the rectification petition was rendered by the High Court. CPC

provisions were also not made applicable to the rectification petitions filed under Section 57 of the Trade Marks Act and therefore, appeal by way of Letters Patent would not be available qua a decision passed by a Single Judge of the High Court on a rectification petition. RIPL defended the maintainability of their appeals by claiming that appeal lies under Clause 10 of the Letters Patent from which the High Court derives its powers. And such intra-court appeal is not expressly excluded under the Trade Marks Act.

With respect to second issue, RIPL contended that Section 124 of the Trade Marks Act for stay of infringement proceeding is invoked when there is pending infringement suit and the defendant had pleaded the invalidity of the plaintiff's registered trademark based on which the infringement action is filed. Infringement suit filed before the Delhi High Court by PPL was

based on statutory rights in three registrations  in classes 9, 38 and 42 against RIPL's use of , and rectification petitions filed by RIPL were initiated against same three registrations and additional registration for

 in class 36. Thus, at least the Single Judge's judgment wasn't sustainable against fourth registration since RIPL could not have pleaded its invalidity in the suit filed before the Delhi High Court. PPL countered

that suit before the Delhi High Court was based on infringement of  by RIPL's use of  and RIPL had stated in their written statement that reliant PPL's trademarks were liable to be rectified as those have been dishonestly registered. Since RIPL had taken the defense of invalidity in the Delhi suit, which was pending when rectification petitions were filed, instances of Section 124 of the Trade Marks Act were fulfilled. As mandated under this provision, since no permission was sought by RIPL before filing rectification petitions, the petitions were rightly dismissed.

The Court took into account various case precedents relied upon by both sides for maintainability of appeals. It was observed that an appeal can be

preferred if a statute provides for an appeal and since Letters Patent is treated as the paramount charter under which the High Court functions, the provision for appeals made under it, cannot be obliterated unless it is excluded specifically by the concerned statute. A plain reading of Clause 10 of the Letters Patent showed that an appeal would lie from a decision of one judge of the High Court or one judge of any of the Division Courts unless specifically excluded from the purview of the relevant statute. Comparing the relevant appeal provisions of Trade Marks Act of 1940, 1958 and 1999 (unamended – prior to abolition of IPAB), the Court found that one level of appeal is provided from a decision on a rectification application rendered by the Registrar, however no appeal could be preferred from IPAB's decision. With abolition of IPAB, now both the High Court and Registrar could decide the rectification petition. The Registrar's decision can still be appealed before the High Court. Considering the instances where intra-court appeal would fall, the Court held that Trade Marks Act, 1999 did not exclude one level of scrutiny by way of an intra-court appeal preferred under Clause 10 of the Letters Patent and thus, present appeals filed before the Court were maintainable.

As per Section 124 of the Trade Marks Act, if rectification proceedings against trademark/s in issue are pending, the court trying the infringement action is required to stay the suit, pending the final disposal of those rectification petitions before the Registrar or the High Court. The Court agreed with RIPL's contentions that rectification petition filed against fourth registered trademark of PPL could not have been dismissed by the Single Judge. Coming to second issue, following the principle set by Patel Field Marshall case, the Court observed that Section 124 of the of the Trade Marks Act doesn't state that rectification petition ought to be dismissed *in limine*, where the concerned Court was yet to frame an issue. Thus, dismissal of the rectification petitions was not correct and those rectification petitions must have been kept in abeyance till the concerned Court decided

on the validity of registered trademark, as a tenable issue. The appeals were accordingly allowed, the Single Judge's judgment was set aside, and rectification petitions were directed to be kept in abeyance until the court in Delhi suit framed an issue regarding validity of the concerned registered trademarks of PPL. If no issue in this regard is framed, rectification petitions would be closed.

Navaid Khan v. Registrar of Trademarks Office

Forum: High Court of Delhi

Case No.: C.A.(COMM.IPD-TM) 8/2023


Date: 30th May 2023

Issue:

- Whether the appellant's mark "CruzOil" is liable to be rejected under Section 9(1)(b) of the Trade Marks Act, 1999?

Order: The appellant filed the present appeal before the Delhi High Court under Section 91 of the Trade Marks Act, 1999 against the order dated 12.01.2023 passed by the Registrar of Trade Marks, refusing registration of



the appellant's mark "CruzOil /  " under Section 9(1)(b) of the Act holding that the subject mark may serve in trade to designate the kind, intended purpose of the goods or other characteristics of the goods. Further, the impugned order held the subject mark to indicate that "the oil is used in Cruz or for Cruz. It is the name of the product. It is not coined nor invented. It cannot be monopolized."

The appellant contended that the subject mark is completely arbitrary and does not relate to the goods which are industrial lubricants making is

distinctive. Further, it was stated that the word “CruzOil” does not have a dictionary meaning and the device mark having a combination of words and devices must be considered as a whole for registration. The respondent, on the other hand, opposed this appeal and submitted that the grounds for refusal under Section 9(1)(b) of the Act are absolute and since the mark is descriptive and designates the kind and intended purpose of the goods, the Registrar has rightly refused the application.

The Court noted that the subject mark for which the appellant has applied for registration is a composite device mark that contains the word “CruzOil” along with other elements and the mark having a combination of devices and words must be considered as a whole for the purpose of registration. In this case, the Court held that the subject mark is a device mark containing various unique and arbitrary elements. Relying on the Delhi High Court’s recent judgment in *Abu Dhabi Global Market v. The Registrar of Trademarks, Delhi* which interpreted Section 9(1)(b) of the Act in respect of composite marks and held that only those trademarks, which consist exclusively of marks or indications which designate the geographical origin of the goods, which cannot be registered under the provision which ipso facto excludes composite marks from its scope. Agreeing with this definition, the Court held that the Registrar erred in dissecting the subject mark into its individual parts for consideration while registration. The Court also noted that there were other composite marks containing the word “Cruz” that have been registered as valid trademarks.

Kent Cables Private Limited & Ors. vs Kent Ro Systems Limited & Ors.

Forum: High Court of Delhi

Case No: CS(COMM) 596/2022 & I.A. 16118/2022

Order Dated: 30th May 2023

Issue:

- Whether Kent RO's manufacturing and sale of fans under the 'KENT' trademark amounted to trademark infringement and passing off, taking into account the potential confusion among consumers and the potential diversion of Kent Cables' customer base.

Judgment:

The Delhi High Court ruled that Kent RO Systems Ltd. should be permanently prohibited from manufacturing and selling fans under the 'KENT' trademark. The court determined that such actions were likely to confuse potential customers and lead to the diversion of Kent Cables Ltd.'s clientele, resulting in loss and harm. Kent RO's application to restrain Kent Cables from selling fans was dismissed by the court.

The dispute arose when Kent Cables sought a permanent injunction against Kent RO and others, alleging infringement of their registered trademark 'KENT' and engaging in passing off activities related to electronic and electrical goods, including fans. Similarly, Kent RO sought an injunction against Kent Cables from manufacturing, selling, and advertising electric appliances, including fans, using the 'KENT' mark or any deceptively similar mark. Both applications were considered jointly by the court due to the similarities in facts and issues.

Upon examining the registration details of both companies, the court identified the bone of contention as the claim related to fans. It noted that Kent Cables had been openly selling fans since 1984, while Kent RO was in the process of launching their fan products at the time the lawsuit was filed.

Regarding the infringement claim, the court concluded that the conditions for infringement were not met. Although the registered trademarks of both parties were identical, the goods in question were not found to be identical or similar. The court emphasized that for infringement to be established, it was necessary to demonstrate that the goods in question were allied and

cognate to the registered goods of the claimant. Referring to a previous judgment, the court highlighted that cables/wires were not considered similar to fans.

In terms of claiming an injunction based on 'prior user' and passing off, the court recognized the superiority of the rights of a prior user over a registrant. It acknowledged that Kent Cables had adopted the 'KENT' trademark in 1984 and held prior registration for various goods, while Kent RO's first registration for a device mark using 'KENT' occurred in 1994. The court noted the extensive evidence presented by Kent Cables, demonstrating the use of the 'KENT' mark for fans since 2006. It concluded that allowing Kent RO, a newcomer to the fan business, to use the identical 'KENT' mark would likely confuse potential customers. Taking into account the increase in Kent Cables' sales during Kent RO's period of inactivity, the court found that the balance of convenience favoured Kent Cables. As a result, the court restrained Kent RO from manufacturing and selling fans under the 'KENT' mark, while dismissing Kent RO's application to restrain Kent Cables from selling fans.

Bennet, Coleman & Company Limited vs E! Entertainment Television LLC

Forum: Delhi High Court

Case No.: CS (COMM) 253/2019

Order Dated: 31st May 2023

Issue:

- Whether the defendant's marks "E! Now" and "E! News Now" infringed the plaintiff's marks "TIME", "TIMES" and "NOW" and their series thereof, for its channels Times Now, ET Now, Mirror Now, Movies Now, and Romedy Now?

Order:

Bennet, Coleman & Co., the plaintiff, popularly known as the Times Group, operates myriad businesses in print media, television broadcasting and channel distribution. It claimed to have trademarked “TIME”, “TIMES” and “NOW” and their series thereof, for its channels Times Now, ET Now, Mirror Now, Movies Now, and Romedy Now. From October 2008, the plaintiff started using the “E Now” logo for entertainment and film review shows wherein ‘E’ referred to Entertainment and ‘Now’ connected it with the Times Group. Their trademark applications for E Now marks/logos in Classes 38 and 41 were opposed by the defendant, E! Entertainment based on their rights on “E!”.

The plaintiff claimed that the defendant asserted its proprietary rights in “E! Now” and “E! News Now” for television entertainment services falling in Class 41, but no trademark application was filed by it in India. The plaintiff has over 250 registrations for the mark “NOW” with 78 registrations in Class 38, and 76 in Class 41. The plaintiff also claimed its exclusive right to use the “NOW” family of marks. Defendant’s impugned marks bear structural similarity with the plaintiff’s marks E NOW for the same services constituting infringement and passing off.

The defendant contended that the plaintiff’s earliest registration of the mark was in July 2008 - after it started using “E! News Now” in 2007 internationally. It also claimed that the “NOW” label/marks were wrongly registered in the plaintiff’s favour. The injunction granted was for Class 38, in which the plaintiff had no registered rights in the mark. The defendant sought vacation of the injunction based on the plaintiff’s misrepresentation where it concealed its response to the examination report for Romedy Now, that the mark NOW had no exclusivity being "common to the trade", and several third parties were using such marks.

The plaintiff also accepted that it was not using “NOW” as a standalone mark, and no cause of action arose in Delhi due to lack of purposeful availment. The defendant’s E! family of trademarks also enjoyed a

transborder reputation in India. The plaintiff countered this with the need for substantial corroboration evidence to prove "common to trade".

The court considered these factors and basis judicial precedents vis-à-vis cause of action, acknowledged its territorial jurisdiction to entertain the suit based on the plaintiff's subsidiary office in Delhi and service of legal notice there.

The court observed that the injunction was issued based on the representation of several registrations for the "NOW" trademark in various classes; however, only Classes 38 and 41 were relevant for the present suit. The plaintiff did not have standalone proprietary over the mark in Class 38, and the registration in Class 41 was filed in September 2014 on an intent-to-use basis, which remains unused till date. The registration in Class 41 cannot be used to seek an injunction against the defendant's marks, especially when the first use of "E-News Now" dated to 2007.

Following the test of trademark infringement laid down by celebrated judgments, it was observed that the action for infringement is a statutory remedy for registered proprietors of a trademark to vindicate exclusive rights for using it. While the plaintiff held different "NOW" formative registrations, the court concluded that "NOW" is a common word and used by several entities.

The plaintiff also admitted to the term being "common to trade" and disclaimed "NOW" in its three registrations, including one in Class 38. Therefore, the plaintiff cannot take a contrary stance that "NOW" is distinctive to its services. The court observed that the defendant was using E and E! with "NOW" and "E NEWS NOW", before the plaintiff.

The Court also denied the injunction to the plaintiff due to suppression of material facts. The original plaint incorrectly claimed that the plaintiff's principal office was in Delhi, and the plaintiff had a wavering stance on the defendant's transborder reputation to seek an injunction and refute the

defendant's prior rights. The Court directed to vacate the ad-interim injunction issued against the defendant.

New Balance Athletics Inc vs New Balance Immigration Private Limited

Forum: High Court of Delhi

Case No.: CS(COMM) 444/2022

Date: 1st June 2023

Issue:

- Whether the use of the impugned mark by the Defendant was infringing the plaintiff's "NEW BALANCE" and "NB" marks?

Order:

The Plaintiff, New Balance Athletics Inc., is a company specialising in the designing, production and distribution of footwear and apparel globally. It commenced a legal action against New Balance Immigration Private Limited to obtain a permanent injunction, asserting that the defendant had violated its trademarks, engaged in deceptive practices by passing off its goods and services as that of the plaintiff, and carried out other associated activities.

To substantiate their allegations, the plaintiff presented evidence showcasing their extensive history of using and registering the 'NEW BALANCE' and 'NB' marks. The plaintiff claimed that it started using the mark 'NEW BALANCE' in India in 1986 and had valid and subsisting registrations for the said marks in Class 25 and other classes along with a domain name, 'NEWBALANCE.COM' registered in 1995.

The Defendant, New Balance Immigration Private Limited was offering immigration and visa procurement services in India. In May 2022, the

plaintiff issued a legal notice and reminder notice to the defendant, to which the latter submitted no response. Subsequently, the plaintiff sought an investigator's report, which stated that the defendant was using the 'NEW BALANCE' mark as a part of its corporate name and the 'NB' device mark as a part of its corporate logo. It was also highlighted that the impugned mark formed a part of the defendant's domain name, 'NEWBALANCEIMMIGRATION.COM'.

Despite being served with the summons, the defendant failed to appear in court, resulting in an *ex-parte* order in favour of the plaintiff on October 12, 2022. This order granted an interim injunction restraining the defendant from using the trademarks in any manner, including advertising, and using them as its corporate name or its domain name.

Subsequently, the defendant filed an application seeking permission to participate in the lawsuit. Considering the defendant's justification for their absence, the court permitted them to participate in the lawsuit from the date they officially appeared.

It was claimed by the defendant that it was using the impugned marks in different trade channels, thereby eliminating any likelihood of confusion. However, the court addressed the plaintiff's request to incorporate additional documents into the official records, which provided proof of the defendant's persistent use of the infringing marks despite the previously issued injunction. The court approved the application and admitted the additional documents as admissible evidence.

The court analysed the plaintiff's claims, including their ownership of the 'NEW BALANCE' marks, the goodwill and reputation associated with those marks, and the deceptive similarity between the plaintiff's and the defendant's marks. The court made a comparison between the marks of the plaintiff and the defendant as under:

Defendant's Marks	Plaintiff's Marks
NEW BALANCE	NEW BALANCE
	<p>NB</p>  

Following the above comparison, the court determined that the defendant's mark was deceptively similar to the plaintiff's marks. Moreover, the defendant was found to be using an 'NB' device mark that fully incorporated the plaintiff's 'NB' mark, thus creating an association with the plaintiff.

The court also held the Defendant's domain name to be deceptively similar to that of the plaintiff and is likely to deceive the public of its association with the plaintiff. Accordingly, the court concluded that the defendant's utilization of these marks in their trade name and domain name was likely to deceive the public, constituting trademark infringement and passing off. The court further observed that the defendant's failure to appear and file a written statement within the prescribed period undermined their defence.

Consequently, the court ruled that the defendant had no real prospects of successfully defending the claims in the lawsuit. As a result, considering the evidence presented by New Balance Athletics Inc., the High Court of Delhi granted relief to the plaintiff by allowing their participation in the suit and admitting the additional documents as evidence. The court found the defendant to be in violation of the injunction order and concluded that they had no real prospects of successfully defending the case.

Mohan Meakin Limited Vs. The Devicolam Distilleries Ltd.

Forum: High Court of Himachal Pradesh

Case No.: COMS No. 5 of 2023

Judgement Dated: 02nd June 2023

Issue: Whether the defendants use of trademark 'OMR', short form of plaintiff's mark **Old Monk Rum** written in same stylised font/manner as that of the plaintiff amounts to confusion?

Judgement: The High Court of Himachal Pradesh has delivered a judgment dated June 02, 2023, in a matter between Mohan Meakin Limited and The Devicolam Distilleries Ltd., wherein the defendants are guilty of adopting a trademark which is nearly identical to the plaintiff's trademark in relation to same goods.

The plaintiff is aggrieved by the defendant's trademark OMR, the short form of plaintiff's mark **Old Monk Rum**, written in nearly identically stylised font/manner as that of the plaintiff. Plaintiff claims to be a renowned Indian Company in liquor industry with established Breweries and Distilleries in various parts of the Country and owns and is using several Trade Marks, including the marks 'Old Monk' and 'Monk' since 1971 and 2008 respectively.

The plaintiff, in support of its submissions, placed reliance upon the judgments pronounced by the Supreme Court in *ADS Spirits Pvt. Ltd. vs. Shubhom Juneja*, (2023) SCC OnLine Del 2654; *Parle Products Private Limited vs. J.P. and Co., Mysore* (1972)1 SCC 618; *Heinz Italia & another vs. Dabur India Ltd.* (2007)6 SCC 1; *Colgate Palmolive Company and another vs. Anchor Health and Beauty Care Pvt. Ltd.* (2003) SCC Online Del 1005; *Laxmikant V. Patel vs. Chetanbhai Shah and another* (2002)3 SCC 65 and *Wander Ltd and another vs. Antox India P. Ltd.* (1990) Supp. SCC 727.

The plaintiff further submits that a trademark application filed by the defendant for the word mark 'DDLs OMR' in Class 33 has been opposed by the plaintiff by filing a representation in the Trade Marks Office, the same is pending for adjudication.

Taking into consideration the materials placed before the High Court and submissions made by the plaintiff, the court opined that prima facie case is made out in favour of the plaintiff for passing ad-interim order. Consequently, the Court restrained the defendant and their promoters, assigns, relatives, successors-in-interest, licensees, franchisees, directors, representatives, servants, distributors, employees, agents, etc., or anyone associated with the defendant from using/selling/importing/exporting the products/bottles bearing the objectionable trade dress/shape/design/label/packaging/layout/colour scheme viz dress / shape/ design/ label / packaging / layout /colour scheme under the mark OMR, short form of plaintiff's mark **Old Monk Rum** and/or any other trade dress / shape/ design/ label / packaging / layout / colour scheme identical with or similar to the plaintiff's products/bottles under the mark OLDMONK/ MONK and trade dress / shape/ design/ label /packaging / layout / colour scheme used in respect thereof in any manner whatsoever in respect of their business so as to pass off or enable others to pass off their business and/or goods/services as that of the plaintiff or in some other manner connected with the plaintiff.

Ferrero Spa & Ors. v. Kamco Chew Food Pvt. Ltd.

Forum: High Court of Delhi

Case No.: CS(COMM) 427/2023

Date: 2nd June 2023

Issue:

- Whether the defendants' marks make out a prima facie case of infringement and passing off against the plaintiffs' mark?

Order:

The plaintiff in the present matter is a company registered under the laws of Italy and asserts that it coined the trademark “NUTELLA” in 1964 and has been using it continuously and extensively since then. The plaintiff also presented its registrations for the “NUTELLA”. The plaintiff also asserts that “NUTELLA” product uses a unique and distinctive packaging with a distinctive design which acts as a source identifier for the plaintiff. Further, the trademark “KINDER” was adopted by the plaintiff in 1968 and the mark “KINDER SURPRISE” was adopted by the plaintiff in 1974 as an extension to the former.

In May 2023, the plaintiff saw the defendant advertising its product, “COKOTELLA” using a label and colour combination which was deceptively similar to the label and colour combination used by the plaintiff for “NUTELLA”. The plaintiff provided a detailed comparison report in its plaint of the similarities between the plaintiff and defendants’ labels and submitted that the defendant has merely created a combination of “KIND” from the “KINDER” and “ELLA” being the latter half of the word “NUTELLA” to make “KINDELLA”. Additionally, it was submitted that the use of the concluding syllable “ELLA” renders the defendants’ marks phonetically as well as otherwise deceptively similar to the mark of the plaintiff. The plaintiff also pointed out that by way of an earlier order, against the same defendant, where the suit was decreed in favour of the plaintiff vide judgment dated 18.12.2019 and the mark “KINDER” was declared as a well-known trade mark within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999.

The plaintiff filed the present suit in the pursuance of these facts and sought a decree of permanent injunction restraining the defendants as well as all others acting on their behalf from using its products “COKOTELLA”, “KINDELLA” and “MYTELLA” in the packaging and by using the trademark or any other mark which is deceptively similar to “NUTELLA”

and “KINDER” of the plaintiff. Additionally, the plaintiffs also filed an application under Order 39 Rules 1 and 2 of the Code of Civil Procedure, 1908 seeking an interlocutory injunctive relief against the prima facie case of infringement and passing off.

The Court held that the facts herein made out a prima facie case of infringement and passing off, and the plaintiff was entitled to the registration of the plaint as a suit and ad interim interlocutory relief. The Court ordered that till the next date of hearing, the defendants, as well as all others acting on their behalf, shall stand restrained from manufacturing, marketing, making available for sale, selling, and dealing in any manner whatsoever in the impugned products or any other deceptively similar mark or product not authorized by the plaintiff and having identical or deceptively similar features of the plaintiffs’ trademarks NUTELLA, KINDER, etc.

PhonePe Private Limited vs DigiPe Fintech Private Limited

Forum: High Court of Madras

Case Number: O.A. Nos. 809 to 812 of 2022 and O.A. Nos. 156 to 159 of 2023 in C.S. (Comm. Div). No. 248 of 2022

Order Dated: 7th June 2023

Issue:

- Whether the applicant can obtain an injunction against the respondent for infringement of its trademark “PhonePe”?

Order:

An application was filed by the appellant stating that “PhonePe” is a distinct mark that has been in operation since September 2015. It is conceived by the applicant and is a combination of the words “phone” and “Pe.” The word “Pe” does not have a meaning in English. However, it was adopted as a Hindi word ‘पे’ which literally means “on” and is also legally registered under the Trade Marks Act, 1999.

The appellant claimed that the mark “PhonePe” is distinctive and has a 40% share in the UPI business in India. Thus, it should be given protection through an exclusive right over the mark. Further the usage of the same suffix ‘pe’ by the respondents in their trademark “DigiPe” is deceptively similar and can confuse the public.

The respondents contended that the applicant is not entitled to claim protection for the word ‘Pe’ since the expression in English is unregistered. Further, the applicant submitted that in Hindi, the expression ‘Pe’ means ‘on’ which results in the literal interpretation of the trademark as ‘on the phone’. Therefore, the mark ‘PhonePe’ in terms of meaning is a general expression and is not eligible for registration under Section 9(1)(a) of the Trade Marks Act, 1999.

It was stated that the effect of registration of parts of a mark and the infringement of a registered trademark have been invoked in this case under Sections 17 and 29 of the Trade Marks Act, 1999. Based on Section 17, the respondent submitted that a registered trademark owner is not entitled to claim any “exclusive right” over part of the mark. In this case, the applicant has registered the word "Pe," but only in combination with "PhonePe." As a result, the applicant cannot assert any exclusive right over the expression "Pe".

In a recent case, Resilient Innovations Private Limited vs. PhonePe Private Limited, a similar suit against a third party was filed by the applicant, seeking protection and injunction from using the trademark “PostPe.” The court in the case held, that the plaintiff is ineligible for claiming relief against ‘PostPe.’ The applicant in the current case failed to display complete and proper facts concerning the previous dismissal of a similar application. Based on this, the respondents stated that the applicant cannot seek equitable relief of injunction as he did not approach the court with clean hands and failed to disclose all the material since the same was not mentioned in the plaint.

Further, the respondents claimed that the 'DigiPe' app is exclusively intended for merchant establishments and is not intended for individual consumers in general. It was also claimed that in addition to photographs of the business and bank account information, the user of this application needs to submit information such as the merchant's name, address, business name, PAN Number, GST Registration, and Aadhar. Many features in 'DigiPe' are different from 'PhonePe' as a result, and the respondent's app targets literate, business establishments, which is not identical to the applicant's app.

The High Court of Madras observed that the applicant's act of withdrawing the interim application when it was about to be dismissed is absent in the affidavit. There is no mention of the previous suits filed before the Delhi High Court and Madras High Court.

The court further stated that equitable relief of injunction is granted to those who come with clean hands before the court, and the applicant failed to disclose all the material facts concerning failing to obtain interim orders in previous cases and dismissal of similar interim applications filed against the third parties. The court held that the applicant is not entitled to receive any protection for its mark.

Ashique Exports (P) Ltd vs Suresh K.K

Forum: High Court of Madra

Case Number: O.S.A. (CAD) No. 96 of 2021

Order Dated: 20th June 2023

Issue:

- Whether there was an infringement on the part of the defendant of the plaintiff's mark 'Super Wash – 555'?
- Whether the cause of action occurred within the territorial jurisdiction covered by the Original Side of the Court?

Order:

The plaintiff, a prominent manufacturer of soap and detergent, alleged that they extensively marketed their washing soap under the trademark 'Super Wash – 555' since 1997. In 2012, the plaintiff discovered that the defendants had started a business using an identical soap wrapper with the words 'Super Wash,' aiming to deceive customers into thinking their products were from the plaintiff. Consequently, the plaintiff sought a permanent injunction to prevent the defendants from infringing on the plaintiff's trademarks 'Super Wash' and 'Super Wash – 555'. This included using a similar or misleadingly similar trademark on the soap wrapper, as well as any written content or representation that resembled the plaintiff's trademarks on the defendants' products.

However, the defendants argued that they had been producing handmade washing soap prior to the plaintiff, establishing a good reputation among the public and customers. They explained that the words on their soap were in the Malayalam language and targeted the territory of Kerala, without reaching beyond the state. They emphasized that there were noticeable differences in the product appearance, such as layout, colour combination, and letter font size, making it clear to the average person that the plaintiff's and defendant's products were distinct.

During the witness examination in the trial court, it was noted that the defendants objected to the plaintiff's request to mark photocopies of the documents as evidence. The Trial Court referred to Rule 1 of Order XI of the Code of Civil Procedure, 1908, which allowed the plaintiff to submit a list of documents and their photocopies along with the initial suit. However, it was emphasized that such documents must be proven as primary evidence under Section 64 of the Indian Evidence Act, 1872, during the trial. If a party intended to present a document as secondary evidence, they had to strictly adhere to the conditions specified in Section 65 of the Indian Evidence Act, 1872. In this case, the Trial Court observed that these conditions were not fulfilled.

The Trial Court concluded that the plaintiff did not adequately explain why they did not produce the original documents when photocopies were provided. As a result, the photocopies could not be accepted as evidence in the suit. The Bench agreed with the Trial Court's viewpoint, noting that the plaintiff had made no effort to present the originals of the relevant photocopies, thus affirming the Trial Judge's decision.

Additionally, the Bench pointed out that the plaintiff did not claim that the defendants conducted their business, manufacturing, or marketing within the territorial jurisdiction covered by the Original Side of the Court. Consequently, the requirements of Clause 12 of the Letters Patent, 1865 were not fulfilled for the suit to be filed on the Original Side of the Court. The Bench further noted that Section 124 of the Trademarks Act, 1999 could not assist the plaintiff since no part of the cause of action occurred within the territorial jurisdiction covered by the Original Side of the Court.

Varun Chopra Vs Shyam Sunder Chopra and Sons

Forum: High Court of Karnataka

Case No.: MFA No.2638 OF 2023 (IPR)

Order Dated: 30th June 2023

Issue:

- Whether Section 20 of CPC is applicable for the cases filed for infringement and passing off of trademark?

Order:

M/s Raja Traders was a partnership firm, using the trademark 'NATRAJ' since 1956. The partnership firm was dissolved in 1980 due to the demise of one partner, and the other partner became the sole proprietor of the firm.

The defendants impleaded in the suit filed an application for the registration of trademarks 'SV NATRAJ' and 'SHRI NATRAJ JI' and were using the

said trademarks and selling their products in the city of Bengaluru, and therefore, the plaintiffs filed the suit before the Civil Court, Bengaluru.

The defendants filed an application for rejection of the plaint under Order 7, Rule 11(a) of the Civil Procedure Code, 1908 as neither party was residing or carrying on business within the jurisdiction of the Civil Court of Bengaluru.

The Plaintiffs filed objections to the application and emphasized Section 20 of the CPC, as the defendants were selling their products in the city of Bengaluru. The trial court held that the Civil Court had no territorial jurisdiction to try the suit and ordered the return of the plaint. The plaintiffs being aggrieved by this decision filed an appeal in the High Court.

The plaintiffs pleaded that the defendant was selling the product in the city of Bengaluru, and they have admitted the same in their written statement. The plaintiffs further pleaded that the trial court misconstrued judicial precedent relied upon where the respective courts had considered Section 134(2) of The Trademarks Act, 1999, and Section 62 of the Copyrights Act. The Courts have never held that Section 20 of CPC is not applicable for the matters filed for infringement and passing off the trademarks.

The Plaintiffs further argued that the Hon'ble Supreme Court has declared that the applicability of Section 134(2) of the Trademarks Act does not oust the applicability of Section 20 of the Civil Procedure Code, 1908.

Emphasis was further placed on Section 134(2) of the Trademarks Act. It was further argued that Section 134(2) excludes the applicability of Section 20 of the Civil Procedure Code, 1908 for cases filed for infringement and passing off the trademark.

The High Court analyzed Section 134 of the Trademarks Act, 1999, Section 62 of the Copyrights Act; and Section 20 of Civil Procedure Code, 1908, and it was observed that Section 134 was introduced under the umbrella of Section 20 of the Civil Procedure Code, 1908. It was further observed that

the main object of the enactment of Section 134(2) of the Act was to create an additional forum for the Plaintiffs.

The Court stated that from a conjoint reading of Section 134(2) of the Trademarks Act and Section 20 of the Civil Procedure Code, 1908, it is evident that an additional forum has been provided that includes a District Court within whose limits, the plaintiff actually and voluntarily resides or carries on business or personally works for gain. The object of the provisions was to enable the plaintiff to institute a suit at a place where he or they resided or carried out business.

The Court further declared that the expression “notwithstanding anything contained in the Code of Civil Procedure” does not oust the applicability of the provisions of Section 20 of CPC. The Court stated that the trial court misconstrued the relevant judicial precedent and remanded the matter back to the trial court with a direction to reconsider the rejection of the plaint.

Paragon Cable India & Anr vs Essee Networks Private Limited & Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 112/2023

Order Dated: July 3, 2023

Issues:

- Whether prior use of the 'ELEKTRON' trademark, both in a general sense and specifically in relation to the products - wires and cables exists?
- Whether the registration of the trademark [No. 1306921] in class 07 extends the Plaintiffs' rights to seek injunction against Defendants

with regards to wires and cables on the anvil of infringement under Section 29(2)(a) or (b) of the Trademarks Act, 1999?

- Whether Defendants' use of both marks for wires and cables amounts to infringement and passing off of Plaintiffs' trademark?
- Whether Plaintiffs' delay in initiating this action can affect their claim and potentially bar them from obtaining injunctive relief?
- Whether the extent of reputation and goodwill each party has amassed under their respective 'ELEKTRON' trademark, specifically in relation to wires and cables, needs to be considered?

Judgment:

The court examined the critical issues in the case, primarily focusing on the validity of the Defendants' claim of prior use, the likelihood of infringement, and the question of passing off. The Defendants' claim of prior use of 'ELEKTRON' for capacitors in 1992 was supported by evidence, preceding Plaintiffs' adoption in 1998. However, Plaintiffs established themselves as prior users of 'ELEKTRON' specifically for wires and cables. Both parties had been using variations of 'ELEKTRON' for different products without conflict. The court recognized the possibility of peaceful coexistence, given their diverse product lines and lack of significant public confusion.

Plaintiffs' claim of infringement against Defendants based on Section 29(2)(a) or (b) was dismissed, as the Defendants were registered owners. Plaintiffs' challenge to the validity of Defendants' registrations hinged on the Defendants' incorrect user claims. Defendants' registrations were challenged due to lack of evidence supporting usage before 2004. The court found Defendants' registrations misleading and not immune from an injunction.

The court determined that electric wires and cables were not cognate or similar to Plaintiffs' goods like juicers, mixers, etc. Plaintiffs' registration in class 07 did not extend to wires and cables. Plaintiffs established prior usage, reputation, and significant sales of 'ELEKTRON' goods. Defendants' minimal usage and potential confusion justified an injunction to prevent passing off.

Defendants' claim of delay was rejected due to Plaintiffs' continuous and extensive use, established goodwill, and no reliance by Defendants. The court issued an injunction restraining Defendants from using the 'ELEKTRON' trademarks for electric wires and cables. However, to avoid undue hardship, the injunction applied only from the date of the order forward. Products manufactured before the order date were exempt. Defendants were directed to submit an affidavit detailing existing stock within two weeks to ensure fairness in enforcement.

Sun Pharma Laboratories Limited Vs. Glenmark Pharmaceuticals Limited

Forum: High Court of Delhi

Case No.: CS(COMM) 711/2022 & I.As. 20492-20493/2022, 1306/2023

Judgment Dated: July 3, 2023

Issues:

1. Whether the two competing marks i.e., "ISTAMET XR CP" and "INDAMET" are deceptively similar?
2. Whether the description of goods mentioned under Sun Pharma's registration and packaging of products under the competing marks, is sufficient to distinguish the parties' marks?
3. Whether Sun Pharma's stand in the present suit is hit by the plea of estoppel?

4. Where does the balance of convenience lie?

Judgment:

The case involves a dispute between Sun Pharma and Glenmark over their pharmaceutical product trademarks, particularly "ISTAMET XR CP" and "INDAMET." The key issue was whether these marks were deceptively similar and whether such similarity poses risks to public health. The court emphasized evaluating trademarks as a whole and protection based on overall consumer impression. The dominant feature of Sun Pharma's mark is "ISTAMET," similar to Glenmark's "INDAMET." The court dismissed the notion that "MET" cannot be claimed exclusively. Pharmaceuticals require special consideration due to potential health risks. Different prescriptions and packaging are insufficient to prevent confusion, as patients self-administer medications. Added matter or packaging differentiation is inadequate to prevent confusion. The court prioritized public interest and safety, rejecting differentiation arguments.

Defendant argued to limit Sun Pharma's "ISTAMET XR CP" to diabetes treatment under Class 5. However, the court disagreed, considering consumer perspective and potential confusion. Differences in MRP and applications were overshadowed by the shared "MET" suffix. Accidental consumption risks and the ineffectiveness of differentiation strategies were also stressed. Defendant's claim about DPI use was refuted, as Rota haler is not packaged with the drug. The court also emphasized correct assessment, rejected differentiation, and supported potential confusion claim.

Defendant also argued estoppel due to Sun Pharma's previous distinctions of similar trademarks. Court dismissed this as unrelated to "INDAMET", as estoppel requires specific conditions, which were not met. The legal evaluation of trademark similarity is not subject to estoppel, and the weight of legal rights is paramount and not determined by routine oppositions. Therefore, the court held that the estoppel doctrine was inapplicable here.

Sun Pharma's usage and recognition of "ISTAMET" since 2011 favoured it, and Glenmark's recent "INDAMET" launch, despite opposition, suggested risk-taking. The 'first in the market' principle was also in favour of Sun Pharma, and Glenmark's disregard for opposition did not favour them. There was also no concealment of facts to deny injunction, therefore, the irreparable harm to Sun Pharma and public health concerns warranted it an injunction.

Sun Pharma received an injunction against Glenmark, and the latter was restrained from producing, selling, advertising, or marketing products with marks similar to "ISTAMET XR CP." Existing products with the contested mark were exempt, however, Glenmark has not provide further details for such products.

SAP SE Vs. Swiss Auto Products and Another

Forum: High Court of Delhi

Case No.: C.A.(COMM.IPD-TM) 130/2021

Judgement Dated: July 3, 2023

Issues:

- Whether the stipulations of 2002 Rules regarding timelines for submission of evidence are of a mandatory or directory nature?
- Whether Respondent No. 2 had the jurisdiction to apply the 2002 Rules to formulate the disputed conclusion in the impugned decision?
- Whether the amendment introduced by 2017 Rules to the limitation of timelines for filing of evidence under the 2002 Rules is a procedural or a substantive one?

Judgment:

In this case, the central theme of the arguments presented by both parties revolved around determining whether the stipulations of the 2002 Rules regarding timelines for submission of evidence are of a mandatory or directory nature. However, before addressing this, the Court found it essential to address a fundamental question - whether Respondent No. 2 had the jurisdiction to apply the 2002 Rules to formulate the disputed conclusion in the impugned decision.

The Court acknowledged that the relevant provisions pertaining to filing of evidence have undergone considerable revisions with the enactment of the Trademarks Rules, 2017. It is crucial to ascertain whether the 2002 Rules, which prescribed rigid timelines for evidence submission, can be applied by the Registrar.

Under the Trade and Merchandise Marks Rules, 1959, Rule 54 did not impose strict timelines on the Registrar's discretion to admit evidence requests beyond the prescribed period. A Full Bench of the Court had previously classified Rule 53 (evidence in support of opposition) of the 1959 Rules as directory, not mandatory, as the Registrar was allowed to extend timelines for filing evidence under various provisions of the Trade and Merchandise Marks Act, 1958 and the 1959 Rules due to the absence of specific timelines in the 1958 Act itself.

However, a subsequent decision by the Court in **Sunrider Corporation v. Registrar of Trademarks** differed from the earlier ruling. The Court held that Rule 50(2) of the 2002 Rules was mandatory, not directory, due to specific language present in the 2002 Rules. With the enactment of the 2017 Rules, which reverted to the state existing before the 2002 Rules, the core rationale behind the Sunrider Corporation decision no longer applied. Hence, the earlier decision in **Hastimal Jain Trading as Oswal Industries v. Registrar of Trademarks** regained relevance in determining whether the Registrar possesses the discretion to admit evidence submitted beyond the stipulated period of two months.

In the present case, the Impugned Order was passed when the 2002 Rules had been superseded by the 2017 Rules, which took effect on 06th March 2017. The Court examines the repeal and savings provision (Rule 158) in the 2017 Rules. Rule 158 states that the 2002 Rules are repealed without

prejudice to anything done under those rules before the coming into force of the 2017 Rules.

The Court noted that the 2017 Rules repealed the 2002 Rules entirely, but preserved actions, decisions, and rights under the 2002 Rules prior to the effective date of the 2017 Rules. In this case, since there was no final decision made by Respondent No. 2 under the 2002 Rules, the relevant proceedings would be governed by the 2017 Rules.

The Court delved into the retrospective application of law and refers to various judgments, stating that procedural amendments are generally presumed to hold retrospective efficacy unless explicitly indicated otherwise. Provisions related to timelines for filing evidence, being procedural in nature, do not confer vested rights on parties. Therefore, pending actions would be governed by the amended procedure.

After this, the Court examined the effect of the repeal on the 2002 Rules by referring to the General Clauses Act, 1897. It clarifies that the savings clause in the GCA does not apply to the repeal of a 'rule.' The 2017 Rules and the 2002 Rules are rules within the meaning of the GCA, and thus, the saving clause in Section 6 does not protect the applicability of the 2017 Rules to proceedings before the Registrar.

The Court held that the Examiner erred by applying the 2002 Rules when they had been repealed and replaced by the 2017 Rules. While actions taken, decisions made, or rights granted under the 2002 Rules are preserved and valid, the 2017 Rules should govern the ongoing proceedings, considering the significant procedural changes they introduced.

The Court disagreed with the view expressed in **Mahesh Gupta v. Registrar of Trademarks** and emphasizes the need for clarity on whether the procedural changes introduced by the 2017 Rules apply retrospectively to proceedings initiated under the 2002 Rules. A Larger Bench is necessary to decide the following issues:

- Whether the procedural aspects, including the filing of evidence introduced by the 2017 Rules, apply retrospectively to proceedings initiated under the 2002 Rules.

- Whether failure to file evidence in support of the trademark application would be covered under "anything done under the Trademarks Rules, 2002," which is saved by Rule 158 of the Trademarks Rules, 2017, and would continue to be governed by the 2002 Rules.

Therefore, the Court requested the Chief Justice to constitute a Larger Bench to decide these crucial issues.

Zydus Wellness Products Ltd. vs. Cipla Health Ltd. & Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 115/2023, I.A. 4235/2023 (Order XXXIX Rules 1 and 2 of the CPC) and I.A. 9493/2023 (Section 151 of the CPC).

Judgment Dated: July 3, 2023

Issues:

1. Whether the defendant's marks ("Gluco-C" and "Gluco-D") infringe the plaintiff's registered trademarks ("GLUCON-C" and "GLUCON-D")?
2. Whether the marks of the plaintiff ("GLUCON-C" and "GLUCON-D") and the defendant ("Gluco-C" and "Gluco-D") were likely to cause confusion was a question of first impression.
3. Whether the marks "GLUCON-C" and "GLUCON-D" are not entitled to registrations in view of Section 9(1)(a) and (b) of the Trademarks Act?

Judgment:

The court held that the plaintiff holds registrations for its marks "GLUCON-C" and "GLUCON-D." The defendant's marks "Prolyte Gluco-C ++" and "Prolyte Gluco-D ++" were held to be deceptively similar to the plaintiff's marks. The presence of additional elements does not absolve the defendant from infringement, as the essential parts "Gluco-C" and "Gluco-D" are

prominently displayed on the packaging. The defendant's marks were found to infringe the plaintiff's registered marks due to their deceptive similarity.

While the defendant's product pack shares some features with the plaintiff's, the distinct absence of key elements from the plaintiff's trade dress makes confusion unlikely. The court found that the trade dress of the defendant's products was not deceptively similar to that of the plaintiff's products, thereby negating any possibility of passing off.

The court disagreed with the defendant's claim that the plaintiff's marks were descriptive, holding that they were suggestive rather than merely descriptive. The marks were considered eligible for registration and do not violate the Trademarks Act. Protection under Section 32 for acquired distinctiveness through continuous use may apply.

The defendant's attempt to rely on Section 30(2)(a) was rejected since the entire marks "Prolyte Gluco-C ++" and "Prolyte Gluco-D ++" were not used descriptively. The court also dismissed the defendant's contention that the "+" signs were descriptive of calcium and flavor. Section 35 was deemed inapplicable as the defendant's marks did not describe the character or quality of the goods.

The court ruled in favour of the plaintiff, finding the defendant's marks "Prolyte Gluco-C ++" and "Prolyte Gluco-D ++" to infringe the plaintiff's registered marks "GLUCON-C" and "GLUCON-D" respectively. The defendant's attempt to claim protection under Section 30(2)(a) and Section 35 was rejected. While the trade dress of the defendant's product was not deceptively similar, the injunction is granted against the defendant's use of the infringing marks. The defendants were restrained from using the marks "Gluco-C" or "Gluco-D" in any form similar to the plaintiff's marks for identical or related products.

Modern Snacks Pvt. Ltd. Vs. Modern Foods Enterprises Pvt. Ltd.

Forum: High Court of Delhi

Case No.: I.A. 6478/2020 in CS (COMM) 299/2020 and I.A. 9542/2020 in CS (COMM) 460/2020

Judgement Dated: July 4, 2023

Issues:

- Whether the defendant's use of mark "MODERN" infringes the plaintiff's trademark and copyright?
- Whether the goods of the plaintiff and the defendant are similar, cogent, and allied?
- Whether the plaintiff's claim of being the proprietor of the mark "MODERN" is valid?
- Whether the defendant's claim of being an honest and concurrent user of the mark "MODERN" is a valid defence?
- Whether the delay in filing the suit by the plaintiff prejudices the defendant's rights?

Judgment:

The plaintiff asserted ownership of the mark based on its use since 1968 and its registration of various trademarks containing the word 'MODERN.' The defendant challenged the plaintiff's claim of prior use, arguing that the plaintiff only provided sales figures from April 2016 and lacks evidence of earlier use. However, the plaintiff cited newspaper articles suggesting extensive use and a tremendous reputation for the mark 'MODERN' when the plaintiff was a Public-Sector Undertaking. The court found the defendant's argument unconvincing and believed that the plaintiff has provided sufficient documentary proof to support its claim of being the owner of the 'MODERN' mark. The defendant's reliance on an application for a device mark with a different date was disproved, as the plaintiff asserts ownership of a word mark registered on October 11, 1985, and its use in various device marks since 1968.

The defendant argued that there is no likelihood of confusion between the goods because they are different. However, the court disagreed with this plea. The court believed that both the plaintiff's and defendant's goods are general consumable food items available in the same stores. They claim that these goods can easily be confused as an extension of each other and fall within the category of being allied and cognate goods.

The court stated that the consumer who buys these goods from general Confectionary/Kirana shops, would not pay much attention to the minor differences in packaging that the defendant's counsel highlighted. It was held that the consumer would be deceived into thinking that the defendant's goods are the plaintiff's, considering it as a natural expansion of the plaintiff's product range. The court suggested that such a consumer is likely to perceive a connection between the two goods and their origin.

The court referred to Section 29(2) of the Act, which states that the use of an identical mark registered for similar goods, if likely to cause confusion or association with the registered trademark, amounts to infringement. Therefore, the plaintiff did not need to demonstrate that the defendant's goods are identical to theirs, only that they are similar. The similarity of goods should be considered based on various parameters such as the supply chain, class of consumers, and general business model related to the goods. The court concluded that based on these parameters, the plaintiff's and defendant's goods cannot be considered so dissimilar as to rule out the possibility of causing confusion to ordinary unwary consumers.

The defendant argued that the additional information on the label of the product was enough to prevent any confusion among consumers. However, the court disagreed with this argument. It stated that the main trademark used by both parties involved was 'MODERN,' and the goods in question would be traded under this trademark. The differences highlighted by the defendant were insignificant and inconsequential, and thus, they could not be considered enough to eliminate the possibility of confusion and deception among consumers.

In this case, the defendant claimed to be an honest concurrent user of the mark since 1990 and has obtained various registrations for it. The defendant argued that the plaintiff knew about their use of the mark since 2003 but took no action until the present suit. The court found that the defendant's

initial sales were minor, and the plaintiff can be excused for not challenging the registrations earlier. Mere registration of a mark does not prove its actual use, and the plaintiff was not obligated to take immediate action against every infringer. However, the court noted that the delay in filing the suit will impact the balance of convenience and irreparable harm when considering an interim injunction. The court determined that the plaintiff has a prima facie case in their favour but concludes that the balance of convenience favours the defendant, who has been using the mark since 1990 and has obtained registrations.

The court restrained the defendant from using the 'MODERN' mark for goods other than those sold at the time of the suit's filing. The defendant was needed to disclose their product range and marks used, refrain from expanding the product line using the 'MODERN' mark during the suit and provide a statement of sales turnover using the mark on a bi-annual basis. The court clarified that the observations made are preliminary and do not reflect the final findings on the case's merits.

The court ruled in favour of the plaintiff, finding that the plaintiff has made out a prima facie case in its favour. However, the balance of convenience was in favour of the defendant, who is likely to suffer grave irreparable injury if an ad interim injunction is granted. The defendant shall be allowed to use the subject mark only in the labels that were in use by the defendant on the date of the filing of the present suit and/or are registered in favour of the defendant with the subject mark. The defendant shall remain restrained from expanding its line of products using the impugned mark 'MODERN' in any form during the pendency of the present suit. The defendant shall also file a statement of the sales turnover of its products using the subject mark 'MODERN' on a bi-annual basis.

TV 18 Broadcast Limited vs. Bennett Coleman and Company Limited

Forum: High Court of Delhi
Case No.: CS(COMM) 279/2022
Judgement Dated: July 4, 2023

Issues:

- Whether the plaintiff's mark "Bhaiyaji Kahin" is registered under both classes 38 and 41?
- Whether television programs, including news-related programs, fall under class 41 and not class 38, as per the Nice Classification?
- Whether the mark "Bhaiyaji Kahin" has acquired distinctiveness on account of long user and whether this aspect can only be examined during the trial and not for granting an interim injunction?

Judgment:

Under this case the plaintiff's mark ("Bhaiyaji Kahin") was registered under classes 38 and 41, with a disclaimer for the term "Bhaiyaji" in class 41 but not in class 38. The television programs, including news-related ones, fell under class 41, and class 38 excluded such programs. Therefore, for determining infringement, the relevant class was class 41, where the plaintiff's mark has a disclaimer.

The court found that the only similarity between the plaintiff's and defendant's marks was the term "Bhaiyaji." As the plaintiff's mark had a disclaimer in class 41, they cannot restrict the defendant from using the term. Additionally, the term "Bhaiyaji" was common in certain states of India and is of a non-distinctive character.

The plaintiff's reliance on previous registrations and judgments was deemed irrelevant, and the court dismissed their application for an interim injunction, as a prima facie case for infringement is not established.

The court also noted that the formats of the television shows of both parties are different, and there is no likelihood of confusion between the two shows. The court listed the case before the Joint Registrar on 16th August 2023. The observations made for the purpose of adjudication and did not impact the outcome of the suit.

Hershey Company vs. Dilip Kumar Bacha, Trading as Shree Ganesh Namkeen and Another

Forum: High Court of Delhi

Case No.: C.O. (COMM. IPD-TM) 179/2023 and I.A. 11901/2023

Judgment Dated: July 5, 2023

Issues:

- Whether the cancellation petition filed by The Hershey Company under Section 57 of the Trademarks Act, 1999, seeking cancellation of the registered trademark 'HARSHY' is maintainable before the present Court or if it should be filed before the High Court within whose jurisdiction the appropriate office of the Trademarks Registry for the subject mark is located (in this case, the Bombay High Court)?
- Whether the expression 'High Court' under Section 2(1)(i) of the Patents Act, 1970, can be interpreted in a manner similar to the Trademarks Act, 1999, to determine the appropriate High Court for the cancellation petition?

Judgment:

This case involves a cancellation petition filed by The Hershey Company against Dilip Kumar Bacha, trading as Shree Ganesh Namkeen, seeking cancellation of the registered trademark 'HARSHY.' The petition is filed under Section 57 of the Trademarks Act, 1999. The trademark in question, TM Application no. 3897902, was registered on 25th July 2018 by Shri Dilip Kumar Bacha.

The court raised a query regarding the maintainability of the cancellation petition, as the appropriate office of the Trademarks Registry for the subject mark is in Mumbai. However, the petitioner drew a parallel with the Patents Act and sought reliance on a previous court decision to argue that the Bombay High Court should be the jurisdiction for this cancellation petition.

The court decided to permit the petitioner to make submissions on this jurisdictional issue and allowed them to file a written note of arguments and relevant provisions of law.

The court directed the registry to serve the notice of the petition to the respondent through all available modes, including email, and to the respondent's trademark agent.

Kamdhenu Ltd. Vs. Registrar of Trademarks

Forum: High Court of Delhi

Case No.: C.A.(COMM.IPD-TM) 66/2021

Judgment Dated: July 6, 2023

Issues:

- Whether the impugned order passed by the Registrar of Trademarks, New Delhi, under Rule 124 of the Trademark Rules, 2017, was valid and justified?
- Whether the Application bearing no. 'TM-M 764900' filed by the Appellant, seeking inclusion of the trademark 'KAMDHENU' in the List of Well-Known Trademarks, was wrongfully rejected by the Registrar?
- What is the nature and scope of the evidence and documents required to be filed by an Applicant under Section 11 of the Trademarks Act, 1999, read with Rule 124 of the Trademark Rules, 2017, for the determination of a well-known trademark?

Judgment:

The court discussed the nature of evidence and documents required for determining a well-known trademark under Section 11 of the 1999 Act read with Rule 124 of the 2017 Rules. The evidence presented should establish contemporaneous and continuous use, reputation, and goodwill of the trademark. The suggested documentary evidence includes invoices showing

widespread use of the mark, promotional and advertising materials, participation in exhibitions and trade fairs, market surveys, consumer recognition, distribution networks, e-commerce exposure, awards or recognition, and financial documents such as balance sheets and chartered accountant certificates.

The court clarified that Rule 124 of the 2017 Rules refers to "evidence and documents," which can include affidavits and other documents. However, it stated that an affidavit is not mandatory as long as sufficient evidence is provided. Evidence can be in the form of oral testimony or documentary evidence, as defined in Section 3 of the Evidence Act, which includes both types. The Registrar's determination would require documentary evidence, and relying solely on affidavits without supporting documents may not be enough to establish the well-known status of the mark.

Furthermore, the court highlighted that while some facts may require an affidavit, there is no strict requirement for its submission. The authenticity and verifiability of certain documents may not necessitate an affidavit. However, if the Registrar deems it necessary, an opportunity may be given to the applicant to file an affidavit to support specific documents.

Hence, an affidavit is not mandatory for establishing the well-known status of a trademark. Documentary evidence is essential, but the Registrar may request an affidavit if deemed necessary. Non-compliance with the affidavit requirement will not automatically result in the rejection of the application, as it can be seen as an additional requirement to support the case. Applicants have the option to submit both an affidavit and the relevant documents if they choose to do so.

In this case, the Appellant has provided supporting documents and court orders to establish the well-known status of its trademark. The court found that if the Trademark Registry believed an affidavit was necessary, they should have given the Appellant an opportunity to submit one without requiring them to go through the entire application process again. The failure to file an affidavit should not have led to the dismissal of the application. As a result, the court grants the Appellant the chance to file a supporting affidavit and any additional documents within 8 weeks. The Registrar of Trademarks will then review these documents and provide a hearing to the Appellant before deciding based on the law. All other

remedies remain available to the parties involved. The appeal is allowed and concluded according to the terms outlined above.

Vijay Kumar Varshney Vs. Longlast Power Products Ltd. and Anr

Forum: High Court of Delhi

Case No.: CM(M)-IPD 1/2023

Judgement Dated: July 3, 2023

Issues:

- Whether the Petitioner's applications seeking leave to introduce additional documents were rightly dismissed by the Commercial Court Judge on the grounds of non-disclosure and non-filing?
- Whether the Petitioner's reasons for delayed submission of documents due to the Covid-19 pandemic were reasonable and justifiable?
- Whether the Commercial Court Judge's distinction between 'non-disclosure' and 'non-filing' of documents was correct in light of the relevant provisions of CPC?

Judgment:

The Petitioner and the Respondents were parties to a commercial dispute involving the unauthorized use of the trademark "AMAZE." The Petitioner sought permission to introduce additional documents in the trial court, which were initially not included with the plaint. The Commercial Court Judge dismissed the applications on the grounds of non-disclosure and non-filing. The Judge differentiated between 'non-disclosure' and 'non-filing' and emphasized the need for a reasonable cause for non-disclosure..

The High Court found that the distinction between 'non-disclosure' and 'non-filing' as drawn by the Commercial Court Judge was erroneous. It highlighted the dual requirement under Order XI Rule 1 of the CPC, which

mandates both disclosure and filing of documents along with the plaint. The Court noted that the Commercial Court Judge's distinction was not in line with the provisions.

The High Court recognized the impact of the Covid-19 pandemic on court proceedings and emphasized a more lenient approach during such exceptional circumstances. It noted that the Commercial Court Judge erred in dismissing the Petitioner's reasons for the delayed submission of documents due to the pandemic.

The High Court also acknowledged that the Petitioner's reasons for submitting the additional documents in response to the Respondents' assertions were valid. It held that the documents were relevant in determining the issue of prior use between the parties.

The High Court, under its supervisory jurisdiction, set aside the Impugned Order and allowed the additional documents to be taken on record, subject to exceptions. It imposed a cost on the Petitioner for the delay, and also granted the Respondents the opportunity to submit additional documents if desired.

In conclusion, the High Court allowed the Petitioner's appeal, corrected the errors in the Impugned Order, and the present petition was allowed with following directions:

- Impugned Order dated 02nd August 2022 is set aside.
- Additional documents forming subject matter of Impugned Order are permitted to be taken on record, subject to the exceptions.
- Cost of INR 50,000/- was imposed on Petitioner, to be paid to Respondents within a period of one week from the date of release of this judgment.

Crest Education (P) Ltd Versus Career Launcher (I) Ltd

Forum: High Court of Delhi

Case No.: C.O. (COMM. IPD-TM) 179/2023 and I.A. 11901/2023

Judgment Dated: July 5, 2023

Issues:

1. Whether the impugned award contained any or adequate findings with regard to the invalidity of the termination of the Contract by the petitioner?
2. Whether the award of damages ought to have been limited to Rs. 5 lakhs in terms of Clause 14.6 of the Contract?
3. Whether the quantification of damages in the impugned award is vitiated by lack of evidence?

Judgment:

The court considered the principles laid down in **Dyna Technologies** and held that arbitral awards should not be interfered with casually unless the award is so perverse that no alternative interpretation could sustain it. It emphasized that courts should not interfere merely because an alternative view on facts and contract interpretation exists. The requirement of a reasoned order was discussed, stating that it should be proper, intelligible, and adequate, but not necessarily elaborate. The court then assessed the present case where the arbitrator did not explicitly find termination of the contract, but a holistic reading showed that the termination was considered unjustified.

The arbitrator found that the petitioner's contention of not being the same as "Team Satyam" was unfounded, relying on documentary evidence, and awarded damages for the petitioner's breach of the non-compete clause. The court considered the adequacy of reasons and concluded that the award sufficiently reflected the arbitrator's thought process, making it legally sustainable.

The court referred **NHPC Ltd. v. Jaiprakash Associates Ltd.** and held that the particularity of reasoning required is context specific. In this case, the court found no lacuna in the award, and thus, the limited jurisdiction of the Court under Section 34 of the Arbitration Act was not invoked.

The court found that the arbitrator's award impliedly held the petitioner's termination of the contract to be invalid. Therefore, the court upheld the award and did not discuss the enforceability of the non-compete clause after termination, as the award covered the balance period of the contract.

Under this issue, it was determined that the Clause 14.6 in the Contract does not limit the damages payable to the respondent at Rs. 5 lakhs. This interpretation is based on paragraph 10 of the impugned award.

Clause 14.6 is related to the termination of the Contract upon default, and it is applicable to the respondent, not the petitioner. It does not address termination by the licensee (petitioner). The liquidated damages mentioned in Clause 14.6 do not affect the licensor's (respondent) general right to recover damages.

The arbitrator's interpretation is considered valid as it is a possible reading of the Contract. Unless the award is deemed unreasonable, the arbitrator's interpretation of the contract is respected.

Hence, there is no flaw found in the impugned award's ruling that Clause 14.6 is not applicable in this case.

It was stated that the learned arbitrator specified the damages based on the respondent's earnings from the Contract during its operative period (01.04.2009 to 03.03.2010). Additionally, the arbitrator awarded Rs. 1,50,000/- for arrears of license fee and Rs. 2,21,864/- for study material supplied by the respondent to the petitioner. However, the arbitrator rejected the respondent's claim for further damages related to IP rights infringement, expenses on a third-party license, damages for mental pain, and interest.

Petitioner argued that the damages were speculative and lacked supporting evidence, but the court disagreed. It stated that future profits could not be proven and relied on the amount earned by the respondent during the Contract's currency as a benchmark for evaluating estimated damages. The court cited a Supreme Court judgment that emphasized a broad evaluation for estimating expected profits, rather than minute details.

The judgment in **Kishan Lal Kalra case** was also relied upon, supporting an award of damages based on past earnings under the contract. The court acknowledged that damages for loss of profit are prospective and contingent, and although precise evidence might not be obtainable, the court should do its best to assess damages based on available indicators.

The court cited a case of the Sikkim High Court in **KMC Brahmaputra**, which held that an objection related to damages is not sustainable under Section 34 of the Act.

In the end, the court found the learned arbitrator's findings reasonable, as they were based on the respondent's actual earnings during the contract period, and therefore, saw no reason to interfere with the Arbitral Award.

The court finds no reason to interfere with the impugned award under Section 34 of the Act. Therefore, the petition is dismissed, with no order as to costs. The awarded amount, previously deposited by the petitioner as per the Division Bench's order dated 08.12.2020 in FAO(OS)(COMM) 167/2020, will be disbursed as directed in O.M.P.(ENF.) (COMM) 47/2020. Consequently, O.M.P.(COMM.) 57/2017 is dismissed, and the current enforcement proceedings are scheduled before the Roster Bench on 25.09.2023.

Carlton Shoes Ltd. & Anr. vs VIP Industries Ltd.

Forum: High Court of Delhi

Case No.: I.A. 18443/2019 in CS(COMM) 730/2019 and I.A. 1369/2020 in CS(COMM) 52/2020

Judgment Dated: July 17, 2023

Issues:

- Whether VIP has demonstrated the presence of its mark within Indian boundaries prior to Carlton's presence?
- Whether VIP has made a prima facie case for passing off against Carlton?

Judgment:

This judgment contains two applications filed by the parties, i.e., I.A. 18443/2019 in CS(COMM) 730/2019 and I.A. 1369/2020 in CS(COMM) 52/2020, seeking interim injunction under Order 39 Rules 1 and 2 of the Civil Procedure Code (CPC). These applications are intended to seek temporary relief while the main suits are pending.

Both applications share similar facts and involve common questions of law, making them closely related. Due to this interconnected nature, both applications were heard together, and the court has decided to provide a single common judgment to dispose of them. However, if there are any specific differences in the facts between the two suits, the judgment will address them separately later.

In CS(COMM) 730/2019, Carlton Shoes Limited and Carlton Overseas Private Limited (collectively referred to as 'Carlton') filed an application seeking a permanent injunction against VIP and others on its behalf. Carlton accuses VIP of infringing on their registered trademarks, including CARLTON, CARLTON LONDON, and other similar marks leading to passing off.

Carlton Shoes Ltd. is a UK-based company, while Carlton Overseas Pvt. Ltd. is an affiliate company incorporated under Indian laws with its registered office in Delhi. Carlton is renowned for designing and manufacturing shoes and fashion accessories, such as bags, belts, jewellery, perfumes, and watches under the brand name CARLTON LONDON.

Over the years, Carlton has grown its business and brand reputation globally. They have registered the trademark CARLTON in various classes in India and internationally, securing their intellectual property rights. Carlton has an extensive presence with retail outlets, shop-in-shop stores, and sales through multi-brand retail stores and online platforms.

The dispute between Carlton and VIP arose when VIP sent a cease-and-desist notice to Carlton, alleging trademark infringement of VIP's trademark CARLTON in relation to class 18 goods. Carlton responded with evidence of their prior rights to the mark CARLTON dating back to 1994. Carlton later discovered that VIP acquired a dormant company, Carlton International PLC, UK, and asserted rights over the mark CARLTON based on this acquisition, without actual use of the mark before the acquisition. Carlton initiated a cancellation action against VIP's registration of the mark CARLTON.

In response to Carlton's suit, VIP filed (CS(COMM) 52/2020) accusing Carlton of infringement and passing off.

The court did not grant an ex parte ad-interim injunction to Carlton, considering VIP's existing registration for the same mark in the same class for several years. However, the court directed that VIP would not claim any rights in case they expand into any other sector of business. Carlton seeks legal protection for their valuable trademarks, while VIP contests the allegations and claims its own rights over the mark CARLTON.

CS(COMM) 52/2020 is filed by VIP Industries, a prominent company seeking a permanent injunction against Carlton, from manufacturing, selling, distributing, or dealing with goods falling under class 18, such as travel bags, luggage, trolleys, suitcases, duffel bags, laptop bags, wallets, etc. These goods are being sold under the trademark 'CARLTON LONDON' and its related marks. VIP claims that these marks are identical or deceptively similar to their own registered trademark 'CARLTON,' and its related marks, which amounts to trademark infringement and passing off, among other claims.

VIP Industries asserts itself as a market leader in its segment, manufacturing various products under renowned brands, including VIP, CARLTON, Caprese, Aristocrat, Skybags, and Alfa. VIP traces its first use of the CARLTON trademark back to 1980, through an assignment of intellectual property rights from its predecessor. In 2004, VIP acquired the CARLTON marks and goodwill from Carlton International PLC.

According to VIP, the CARLTON marks have been registered in various jurisdictions, including India, in different classes, with the earliest trademark application for the CARLTON mark in class 18 filed by VIP's predecessor in the UK on 19.05.1988, and in India on 26.07.1995, which has been registered.

VIP claims to have a substantial reputation and goodwill built over decades of extensive sales and promotion efforts for products under the CARLTON brand. It cites figures to show increasing sales and popularity, including export sales to the UK and other countries.

The disputes between VIP and Carlton emerged in October 2019 when VIP learned that Carlton was using the CARLTON trademark for handbags and was expanding its business into manufacturing, marketing, distributing, and selling goods in class 18. VIP issued a cease and desisted notice to Carlton,

claiming prior rights to the CARLTON marks. Carlton responded with a detailed reply, asserting proprietary rights in the trademark CARLTON LONDON and its variants.

The Court found that the rival marks are phonetically, structurally and visually similar and both VIP and Carlton have registrations for their respective trademarks in bags and allied goods under class 18. Regarding the claims of infringement, the Court referred to the provisions of Section 28 (3) of the Trade Marks Act, 1999 according to which where two or more persons are registered proprietors of trademarks that are identical to or nearly resemble each other and in such an eventuality, the exclusive right to use these trademarks shall not be deemed to have been acquired by one of those persons against each other, merely on account of registration, subject to a caveat that the trademarks are registered for similar goods. In this scenario, neither of the two can sue each other for infringement. Hence, this position was settled.

With respect to the claims of passing off and spillover of the trans-border reputation the Court commented that the action for passing off is premised on the rights of a prior user generating goodwill, the essence and ethos of passing off being that nobody has a right to represent his goods as those of somebody and encash on the prior user's formidable goodwill and reputation. The Court pointed out that in order to succeed in the claim for passing off, both VIP and Carlton in their respective rights would have to establish their existence through their marks in India and their goodwill and reputation abroad alone would not suffice, applying the territoriality principle. Assessing the evidentiary documents filed by VIP the Court opined that its documents shed no light on whether the purported promotion material was extensively and widely published and/or circulated in India and whether customers here had seen and read them such that the goodwill and reputation of VIP's predecessor percolated and spilt into India, since universal or worldwide goodwill and reputation, without any evidence of territorial goodwill and reputation, is no longer the yardstick. In this light, it was found by the Court that none of the promotional material or articles placed on record by VIP even obliquely reflect its predecessor's existence in the Indian market till 2004. Some documents, purportedly advertisements/price lists, reflect their origin dating back to the 1980s and

1990s, but there was no supporting material to show their awareness amongst customers in India. Court pointed out that in this era, knowledge and awareness of brands was mostly through the travel of people off shores or through electronic/print media as the online exposure was limited and the Court in this context, the Court found that no documents are there which would evidence sales in India by VIP's predecessor, in the form of invoices, bills, delivery documents, photographs of stores displaying the products, etc. under the trademark CARLTON.

Assessing the evidence of Carlton on the same bench mark, the Court found that Carlton is 'first in the Indian market' in respect of bags and allied goods falling under class 18 sold under the trademark CARLTON, noting that the territoriality principle having overtaken the universality doctrine. In the Indian market, prima facie Carlton has made out a case of prior user and enviable exposure of bags under the mark CARLTON.

The Court, therefore, concluded that VIP had failed to establish spillover of transborder reputation in India and/or prior user while Carlton is first in the Indian market and has shown formidable goodwill and reputation under the trademark CARLTON and its formative marks, consequently, the injunction was granted against VIP and VIP's suit was dismissed.

Sporta Technologies Pvt. Ltd. And Anr. Vs. Unfading OPC Private Limited

Forum: High Court of Delhi

Case No.: CS (COMM) 202/2022 and I.A. 5072/2022

Judgment Dated: July 14, 2023






Issues:

- Whether the Defendant's domain name www.sattadream11.com, which includes the mark 'Dream11', infringes upon the registered trademark of the Plaintiff, 'Dream11'?

- Whether the Defendant's use of a similar domain name and offering identical or similar services creates a likelihood of confusion among consumers, leading to trademark infringement and passing off?
- Whether the Defendant's actions have tarnished the reputation and image of the Plaintiffs by associating them with unlawful activities, and whether such association justifies the grant of an injunction?

Judgment:

Sporta Technologies (referred to as Plaintiff No. 1) stands as a private limited company. Dream Sporta Inc. (referred to as Plaintiff No. 2) is a company incorporated in the USA, with Plaintiff No.1 serving as its wholly owned subsidiary. The plaintiffs jointly form a prominent fantasy sports platform, originating back to 2012 and hold the title of the official fantasy sports partner for esteemed entities such as the International Council of Cricket (ICC), the Campeonato Nacional de Liga de Primera Division ('La Liga'), Vivo Indian among others.

Additionally, it is pertinent to note that Plaintiff No. 2 is the registered proprietor for the trademark 'Dream 11' in several classes in India and registered the domain www.dream11.com on March 17th, 2008. Plaintiff No. 1 holds a registration under various classes for the marks '  , '  , 3660717, 3660851,  ,  ,  .

The Plaintiffs assert signing a four-year Central Sponsorship contract with BCCI from IPL 2019, including prompting Dream11 during IPL 2020 in the UAE with ads on player jerseys, stadium, and TV broadcasts. They facilitated the IPL Season-long Fantasy Sport and showcased Dream11 via ads during live game breaks in the 2019, 2020, and 2021 IPL seasons.

The Plaintiffs cited several orders issued by the court where Sporta Technologies had been granted orders of protection in similar cases and determined that the claims of infringement and passing off were supported.

The main issues to be Considered by the Delhi High Court was whether Unfading's use of the domain name "www.sattadream11.com" and similar logo lead to trademark infringement and passing off.

Turning our attention to the subject at hand, it's important to delve into the Defendant's website, www.sattadream11.com. This site has essentially taken/ copied the Plaintiff's registered trademark "DREAM11". Upon closer inspection of Defendant's web presence, it becomes clear that they are providing gaming services that bear a striking resemblance to Plaintiff's offerings. What's noteworthy is that they are doing so under the name 'sattadream11', a name that closely mirrors the Plaintiff's trademark. The services they offer, such as fantasy cricket games, come with a payment mechanism are again the similar to that of the Plaintiff's. Additionally, users can conveniently create accounts on the 'sattadream11' platform. Furthermore, Defendant has been actively promoting their services on popular social media platforms.

The contested domain name is viewed as a deliberate attempt to capitalize on the reputation of the Plaintiff's mark 'Dream11'. Both 'Dream11' and 'sattadream11' are remarkably similar, and confusion between the two marks is highly likely. This becomes especially pronounced on the internet, where the subtleties of such domain names can easily be overlooked. The nature of the internet also fosters assumptions of affiliation between similar-sounding website names. Thus, using such similar domain names for identical services leads to the passing off of one service as associated with the other.

The court has ruled in favour of Sporta Technologies, solidifying the ex parte ad-interim injunction. By issuing a permanent injunction restraining Unfading from using the mark 'Satta Dream 11' or any deceptively similar.

Additionally, the court directed [GoDaddy.com](https://www.godaddy.com) LLC to transfer the domain name www.sattadream11.com to Sporta Technologies. Further, the court observed that unfading was served through email, speed post and electronic means but failed to respond despite multiple attempts. Subsequently, through an order dated May 22nd, 2023, the joint Registrar observed that Defendant had not filed a written statement resulting in the closure of the right to file one. As a result, the interim injunction issued on April 1st, 2022, was made absolute.

In conclusion, this case highlights the complexities surrounding trademark infringement and the challenges of maintaining distinct online identities in the digital age. It serves as a testament to the legal measures taken to protect intellectual property and maintain fair competition in the market.

USCO S.P.A. And Anr. vs Twin Parts Pvt. Ltd. And Ors.

Forum: High Court of Calcutta

Case No.: CS NO.87 OF 2023

Judgment Dated: July 3, 2023

Issues:

- Whether the defendants' use of the mark "USCO" has caused confusion in the market?
- Whether the plaintiffs have made out a strong prima facie case for granting an injunction against the defendants?
- Whether the defendants are entitled to the benefit of Section 28(3) of the Trademarks Act, 1999?

Judgment:

The plaintiff no.1 is a company incorporated in Italy named "USCO" S.P.A in 1989. They manufacture and distribute spare parts for Earth Moving Machines, including repair parts and undercarriage products. The plaintiff no.2, incorporated in Dubai in 2006, acts as a distributor for the plaintiff

no.1 in India. The plaintiffs claim that their mark "ITR" is registered and has been used in association with the word "USCO" to identify their products in the market.

The plaintiffs alleged that the defendant no.1, along with defendant nos. 4 and 5 as its directors, is involved in a limited liability partnership (defendant no.3), and defendant no.2 is a proprietary concern owned by defendant no.5. They claimed that defendant no.2 was an authorized distributor of the plaintiffs and had been selling products with the registered mark "ITR" and the word "USCO" mentioned on invoices since 2007. However, the defendants have allegedly taken over the mark "USCO" and obtained its registration in 2019. Moreover, the defendants were accused of applying for another mark, "IITR," which the plaintiffs consider to be deceptively similar to their registered mark "ITR," which is leading to infringement and passing off actions.

The plaintiffs relied on various sections of the Trademarks Act, 1999, including Sections 27, 28(3), and 29(5), to assert their claims of infringement and passing off. They argued that even if defendant no.1 has registered the mark "USCO" in 2019, the prior use of the mark "USCO" by the plaintiffs establishes infringement under Section 29(5). The plaintiffs also cited relevant judgments in support of their contentions.

The defendants refused the plaintiff's allegations, claiming that they never used the mark "USCO" in connection with the sale of their products, which were sold under the mark "ITR." They argued that they applied for the mark "IITR" but faced objections and have not sold any goods under this mark. They assert that "USCO" is their registered mark, and they have been selling products under it with substantial reputation and business.

After considering the arguments and evidence presented by both parties, the court found that the plaintiffs have made out a prima facie case of infringement and passing off. The court observed that the mark "USCO" has become synonymous with the plaintiffs' products, and the defendants' actions in attempting to register and use similar marks is suspicious. The court applied the principles laid down in **Ratnagiri Nagar Parishad vs. Gangaram Narayan Ambekar & Ors.**, including the test of likelihood of confusion, and concludes that the plaintiffs are entitled to a temporary injunction.

Based on this, the court granted a temporary injunction against the defendants, restraining them from selling any goods similar to those of the plaintiffs under the marks "IITR" or "USCO" until 31st August 2023 or until further orders. The court also ordered the defendants to file their affidavits in response to the claims made by the plaintiffs.

Vasundhra Jewellers Pvt. Ltd. vs M/S Vasundhara Fashion Jewellery

Forum: High Court of Delhi

Case No.: CS(COMM) 161/2022, I.A. 12076/2022 (seeking leave to file surrejoinder), I.A. 12737/2022 (O-XI R-10 of CPC), I.A. 15262/2022 (O-XI R-1(1)(c)(ii) for filing additional Documents)

Judgment Dated: July 19, 2023

Issues:

- Whether the decree of permanent injunction on the basis of infringement and passing off can be granted, or not?
- Whether the plaintiff is a prior user of the mark 'VASUNDHRA' and has established exclusivity through extensive use?
- Whether the plaintiff's mark 'VASUNDHRA' and the defendant no.1's mark 'VASUNDHARA' are deceptively similar and likely to cause confusion among consumers?
- Whether the plaintiff can claim exclusive rights over the mark 'VASUNDHRA' considering it is a common word and has been used by other registered trademarks?

Judgment:

The Plaintiff's Company, established in 1999 as "VASUNDHRA JEWELLERS PRIVATE LIMITED," has been using the names "VASUNDHRA" and "VASUNDHRA JEWELLERS" continuously for their jewellery business. They hold trademarks and domain names related to their brand and have a significant online and social media presence.

The Plaintiff claims that due to their prior adoption, registration, continuous use, and extensive promotion of the "VASUNDHARA" marks, consumers exclusively associate these marks with their business. However, in June 2019, they discovered that the Defendant No.1, M/s Vasundhara Fashion Jewellery LLP, was also using the "VASUNDHARA" marks for identical goods and services, including selling jewellery and precious stones on their website and social media accounts.

In January 2022, the Plaintiff issued a cease-and-desist notice to Defendant No.1, but the latter claimed to have been using the "VASUNDHARA" marks since 2001. As a result, the Plaintiff filed a lawsuit seeking a permanent injunction for infringement and passing off, along with other related reliefs.

In the written statement, Defendant No.1 argued that they are engaged in the business of designing high-quality jewellery with ethically sourced materials and obtained registrations and copyright for the "VASUNDHARA" mark in 2001. They stated that Ms. Vasundhara Mantri, with a 99.09% shareholding in the defendant LLP, started her business with the name "VASUNDHARA" in 2001. The defendant also claimed to have taken over all assets, liabilities, and intellectual property rights from Ms. Mantri, including the "VASUNDHARA" mark.

Defendant No.1 presented CA certificates indicating their sales figures and advertising expenses related to the "VASUNDHARA" mark from 2001 to 2020. They argued that the Plaintiff has not provided sufficient evidence to prove their use of the mark from their claimed incorporation date, and the Plaintiff's mark was not identical or deceptively similar to theirs, thus seeking dismissal of the Plaintiff's claims based on waiver, estoppel, and acquiescence.

The Plaintiff claimed exclusive rights to the "VASUNDHARA" marks and sought to stop Defendant No.1's use, while Defendant No.1 contended that they have valid rights to the "VASUNDHARA" mark and requests the dismissal of the Plaintiff's claims.

The court stated that, these marks are phonetically identical. As per Section 28(3) read with Section 30(2)(e) of the Act, an action for infringement may not be maintainable since both parties have identical registered marks.

However, the plaintiff had also filed a case for passing off, and the court will consider this claim at the stage of granting an interim injunction. The essential elements for constituting passing off have been outlined in the case of **Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd.**

Ms. Vasundhara Mantri had been using the trading name 'Vasundhara' since 2001, and she obtained multiple registrations and copyrights for the mark. She launched her website in 2007. On 14th February 2014, she incorporated 'Vasundhara Creative Jewellery Private Limited,' which later became 'Vasundhara Fashion Jewellery Private Limited' and was converted into an LLP, i.e., defendant no.1. She holds a significant share of 99.09% in defendant no.1.

All assets, liabilities, and intellectual property rights of Ms. Vasundhara Mantri were transferred to defendant no.1 through takeover and assignment agreements. The defendant no.1 is considered an extension of Ms. Vasundhara Mantri.

In the past, the plaintiff had sought injunctions against others using the mark 'VASUNDHRA', claiming exclusive rights over it, but the courts ruled that the mark is generic and weak, and exclusive rights cannot be granted solely based on registration of composite marks.

The court found that the marks 'VASUNDHRA' and 'VASUNDHARA' have differences in spelling and writing style, and they do not create confusion in the minds of consumers when compared as a whole. The plaintiff's own reply to the Trademark Registry had stated that there was no similarity between the marks.

Hence, the court dismissed the application for an interim injunction, as the plaintiff failed to establish a prima facie case for passing off. The defendant no.1 had been using the mark 'VASUNDHARA' since 2001, and the balance of convenience was against granting an injunction. The observations made in this ruling are for the purpose of this application and will not impact the final outcome of the case.



Zenith Dance Institute Pvt. Ltd. vs Zenith Dancing and Music

Forum: High Court of Delhi

Case No.: CS(COMM) 36/2021 & I.A. 3851/2022

Judgment Dated: July 18, 2023


Issue:


- Whether the Defendant's registration for its mark  infringing upon the plaintiff's marks  and ZENITH ARTS?

Judgment:




Previously on January 22, 2021, this Court had already passed an *ex-parte ad interim* order, restraining the Defendant from using the mark ZENITH or any such deceptively similar mark for its goods or services. Thereafter which the Defendant filed for vacation of the said interlocutory order.

The Plaintiff at the outset, laid out that the proprietor having a passion for dance, had opened the Plaintiff dance institute in 1997 itself. Thereafter


which registration for the marks  and ZENITH ARTS were obtained on June 07, 2007, and April 25, 2004, both claiming use from April 01, 1997. Since then, the Plaintiff had been engaged in providing education in relation to various forms of dance. In May 2014 however, the Plaintiff

came across the Defendant's registration for its mark  in Class 41, in relation to music and dance institutes. Post the Plaintiff applying to the Intellectual Property Appellate Board ("IPAB") for rectification of the Register by removal of this mark under Section 57 of the TM Act, the

Defendant's  mark was removed from the Register. However,


despite this, the Defendant continued to run four dance studios in Delhi, under the variant marks  and . In light of this, the Plaintiff contended that since the prominent element of these marks remained to be “ZENITH” and that as the  logo from the removed mark was still being used in these iterations, the Defendant was still infringing the Plaintiff’s registered trademarks by running dance institutes under these marks.

In its defence, the Defendant firstly argued that the Plaintiff was *ipso facto* disentitled to any equitable injunctive relief, as it had come to the Court with


 unclean hands, for it had not revealed how the Defendant’s mark had been one of the cited marks in the FER issued against the Plaintiff’s then application for its mark ZENITH ARTS and how the Plaintiff had argued that its mark was different visually and identically from the cited marks. Therefore, the Defendant contended that the Plaintiff could not be allowed to take up the contradictory stance of the Defendant’s mark being deceptively similar to its mark just for the sake of these infringement proceedings.



With regards to the issue of whether the Plaintiff could be estopped from instituting an infringement suit basis the Defendant’s marks being deceptively similar to its registered marks now, when it had taken a contradictory stance in its response against the FER issued against its mark ZENITH ARTS, the Hon’ble Court held that the enunciation of law as laid out in the case *Raman Kwatra v. K.E.I. Industries Ltd.* would apply *mutatis mutandis* to the facts of the present case. The law laid therein was that “if the impugned mark of the Defendant had been cited against the mark asserted in the plaint, at the time when the Plaintiff had applied for registration thereof, and the Plaintiff, in order to obtain registration, had pleaded that the two marks were not so similar as to result in likelihood of confusion or deception, then the Plaintiff could not, in infringement proceedings, seek to injunct the very same cited mark of the Defendant by pleading that it *was* confusingly or deceptively similar to the Plaintiff’s


mark”. Furthermore, the Court also relied on the principle of “approbate and reprobate”, as provided in the judgement *Karam Kapahi v. Lal Chand Public Charitable Trust*, which simply means that no party can accept and reject the same instrument. Therefore, in light of the above, the Court rejected the plea of confusing or deceptive similarity between the

Defendant’s mark  and Plaintiff’s mark ZENITH ARTS.

The Hon’ble Court then came to the important question of the extent to which the aforesaid estoppel would apply. It held that as per the principles enunciated in the *Raman Kawatra* case, the estoppel against the Plaintiff would apply only to the extent of the right of the Plaintiff to assert that the

Defendant’s  mark was confusingly or deceptively similar, or infringed, the Plaintiff’s registered mark ZENITH ARTS, but not beyond that. In the case *K. R. Chinna Krishna Chettiar v. Sri. Ambal & Co.*, the Supreme Court had held that the words “Ambal” and “Andal” being phonetically strikingly similar, the Sri. Andal mark would be regarded as deceptively similar to the Sri. Ambal mark, resulting in likelihood of confusion if both marks were allowed to be registered, though visually the two marks were completely dissimilar. Relying on this, with regard to the

Defendant’s other two marks  and , the Court held that as the word “Zenith” was the distinctive feature of both the Plaintiff’s and the Defendant’s marks and as both were being used for providing education in dance, confusion in the mind of a customer of average intelligence and imperfect recollection was bound to happen. Furthermore,

the Court opined that since the Defendant had continued to use the  /ZD logo which was a prominent feature of the invalidated device mark



in its two later marks, it had exposed its later device marks/logos to vulnerability on the ground of infringement.

Lastly the Court rejected the Defendant's plea that "Zenith" was *publici juris*, and a common English expression, over which the Plaintiff could not claim a monopoly, and held that it could not be regarded as *publici juris* or as descriptive of the particular services of dance education provided under it.

The Hon'ble Court therefore ruled in favour of the Plaintiff, holding that the Plaintiff was entitled to interlocutory injunction as sought, as the Defendant's marks infringed the registered marks of the Plaintiff within the meaning of Section 29(2)(b) of the Trade Marks Act, and the *ad interim* injunction passed previously by this Court was made absolute. Thus, we can see that the Hon'ble Court in the present case, kept in mind the principle of estoppel *in pais*, or equitable estoppel i.e., a "rule of equity, by which a person may be precluded, by way of his actions, or conduct, or silence when he has to speak, from asserting a right which he would have otherwise had", by not only disallowing the Plaintiff from executing a *volte face* by bringing an infringement action against the very same mark of the Defendant, it had priorly submitted not being deceptively similar with; but also by making sure to emphasize that a principle of estoppel has to be restricted to its legitimate boundaries, that thus, the Plaintiff cannot be estopped from claiming deceptive similarity with any other marks of the Defendant.

Allied Blenders and Distillers Pvt. Ltd. v. Ashok Kumar conducting activities through webpage

Forum: High Court of Delhi

Case No.: CS (COMM) 103/2022 & I.A.2452/2022

Judgment Dated: July 13, 2023

Issue:

- Whether a page on Facebook containing obscene, vulgar and derogatory posts and had an image/name as "Officer's Choice" with social media handle as "@officerchoicel. Wine/Spirits" exploitative of the plaintiff's well-known trademark?

Judgment:

The plaintiff, Allied Blenders held the registration for "Officer's Choice" since 1988 which was also declared as a "well-known trademark" in the year 2017. The plaintiff came across a page on Facebook which contained obscene, vulgar and derogatory posts and had an image/name as "Officer's Choice" with social media handle as "@officerchoicel. Wine/Spirits". The defendant was John Doe, whose identity remained unknown.

The Court reviewed the Facebook page and concurred that the plaintiff had established a *prima facie* case in its favour for grant of *ex-parte* ad interim injunction. The Court directed the defendant to takedown his Facebook page and Grievance Officer of Facebook was also directed to immediately take down the Facebook page and furnish details about the defendant.

Despite issuance of summons, no reply was furnished by the defendant, nor did he enter appearance. Facebook enforced the order and removed the reference of Officer's Choice product from the impugned Facebook page.

The Court proceeded to adjudicate the injunction application based on set judicial precedents and it was noted that "OFFICER'S CHOICE" was held to be a well-known trademark by Single Judge bench of Delhi High Court in the year 2017. The Court took into account, several suits initiated by the plaintiff in the past to enforce their rights in OFFICER'S CHOICE. The plaintiff had obtained several interim orders injunctioning third parties from using marks identical/deceptively similar to 'Officer's Choice', 'Officer's Choice Blue' and its variants including marks which contained the word 'Choice' even without the word 'Officer' which pointed to the fact that the trademark 'Officer's Choice' possesses certain strength in the market and that even use of the word 'Choice' has the potential to cause confusion.

The Court passed a decree of permanent injunction restraining the defendant from using the mark “OFFICER’S CHOICE” label, logos etc. and/or not mark any reference to the Plaintiff’s product on any social media platform.

This order succinctly studied the progression and journey of arbitrary mark gaining strength from its early adoptive stage to be eventually declared as a well-known trademark basis its well-rounded branding strategy which included continuous and extensive use, extensive promotion and advertisement, high-quality products, consumer’s preference and earned goodwill in the market. No party can be allowed to exploit the goodwill and reputation which has been gained by brand owner via its efforts to make illegal gains or worse, which could tarnish the image of well-established brand in the market.

Ashwa Ghosh vs Vizrt Ag And Others

Forum: High Court of Delhi

Case No.: FAO-IPD 5/2023 & CM 84/2023, CM 85/2023

Judgment Dated: July 19, 2023

Issue:

- Whether an appeal under Section 91 of the Act maintainable against the domain name decision of the administrative panel of the World Intellectual Property Organization (WIPO)?

Judgment:

An appeal was preferred by the appellant invoking Section 91 of the Act against a domain name decision of the administrative panel of the World Intellectual Property Organization (WIPO) before the Hon’ble Delhi High Court. The preliminary issue that arose before the Hon’ble High Court was whether an appeal under Section 91 of the Act maintainable against the domain name decision of the administrative panel of the World Intellectual Property Organization (WIPO). The Hon’ble High Court opined that Section 91 of the Act provides for an appeal against the order/decision of

the “Registrar” to the High Court within three months from the date on which such order/decision is communicated to such person preferring the appeal. In furtherance of the above, the next issue that arose in front of the Hon’ble High Court was whether the administrative panel of the World Intellectual Property Organization (WIPO) falls under the definition of “Registrar” under section 2(y) of the Act which states the Registrar of Trade Marks as referred to in Section 3 of the Act. It is pertinent to note that Section 3 of the Act states the appointment of Registrar as a specific officer appointed by the Central Government of India by notification in the Official Gazette as the Controller-General of Patents, Designs and Trade Marks (CGPDTM), who shall be the “Registrar” of the Trade Marks for the purposes of the Act. On the other hand, as per the Uniform Domain Name Dispute Resolution Policy (UDRP), an administrative panel is appointed to decide upon a domain name complaint.

Thus, the Hon’ble High Court in its order dated 19th July 2023 held that the impugned order/domain name decision passed by the administrative panel of the World Intellectual Property Organization (WIPO) in the present case cannot be considered to be passed by the “Registrar” of Trade Marks under the Act, as the administrative panel of the World Intellectual Property Organization (WIPO) does not possess the same legal standing and authority as that of the “Registrar” for the purposes of the Act. It was further held that the Hon’ble High Court did not have jurisdiction to decide an appeal under Section 91 of the Act filed against the decision of the administrative panel of the World Intellectual Property Organization (WIPO). In view of the above, it was held that the said appeal was not maintainable and the same was dismissed in limine.

Thus, the above stand of the Hon’ble Delhi High Court clarified and laid emphasis on the importance of understanding the scope of jurisdiction of different systems of dispute resolution and their applicability in Indian Courts. The stand taken by the Hon’ble Court further clarified that the parties seeking remedy against an order/decision passed by the administrative panel of the World Intellectual Property Organization (WIPO) must seek other alternative remedies, as the said order/decision cannot be appealed under Section 91 of the Act.

The Polo/ Lauren Company LP v. M/s. Home Needs

Forum: Tis Hazari Court of Delhi
Case No.: CS (COMM) NO. 1722/20
Judgment Dated: July 14, 2023

Issue:

- Whether the defendant's impugned mark POLO LIFETIME (Label) and the mark "POLO LIFETIME" (word) infringed upon the

plaintiff's marks "POLO LIFETIME",

A rectangular label with the words "POLO LIFETIME" in a bold, black, sans-serif font.A logo featuring the word "Polo" in a large, bold, serif font, with "Lifetime" in a smaller, cursive script font below it.

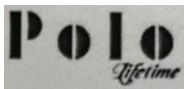
and ?

Judgment:

The Plaintiff sought an interim injunction restraining the Defendant from *inter alia* exporting, manufacturing, advertising, selling, etc., its products under the trademarks / labels "POLO LIFETIME",

A rectangular label with the words "POLO LIFETIME" in a bold, black, sans-serif font.

and

A logo featuring the word "Polo" in a large, bold, serif font, with "Lifetime" in a smaller, cursive script font below it.

(the "impugned marks"). The

Plaintiff asserted that it was engaged in its celebrated and world-renowned business of manufacture, distribution, trade and sale of a wide range of clothing, fashion and lifestyle products including spans fashion wear, sportswear, eye wear, luggage, bags and luxurious home decor including bedding, towels, area rugs, wall covering, tabletop and table covering and other allied and related goods, and was also offering services in this connection. It was further stated that the Plaintiff had adopted the trademark "POLO" in the year 1967 and was subsequently using the "POLO" formative marks including word marks and various stylized representations in conjunction with other marks/words and device of a polo player in relations to its goods and services. Few examples of the famous POLO

marks of the Plaintiff were



and



Further, the artistic works in these marks of the Plaintiff were asserted to be original artistic works under the scope of the Copyright Act, 1957. The Plaintiff also relied upon and asserted its trademark registrations for its POLO formative marks in class 25. It was also stated that the Plaintiff's trademark was held to be "well-known" by the High Court of Delhi in the cases of *The Polo Lauren Company L.P. vs. Rohit S. Bajaj* in CS (OS) No. 1763/2005 and *The Polo/Lauren Company L.P vs. Europa Bevcorp & Ors.* dated 19.10.2022 in CS (Comm) No. 730 of 2022. It was further stated by the Plaintiff that it entered the Indian market through Aditya Birla Fashions and Retail Ltd. through a license agreement and launched its first store in Delhi (in September 2018).

The Defendant was engaged in the business of manufacturing a range of household products and kitchen utensils and other allied/related products using the impugned marks/labels, which were alleged to be violative of the Plaintiff's statutory and common law rights over its "POLO" formative marks. The Defendant was also found to be operating its website <http://homeneedsindia.net/> and several social media platforms through which it was advertising the impugned goods and offering them for sale. The Plaintiff further informed that in the last week of October 2020, the Plaintiff came across the impugned mark POLO LIFETIME (Label) bearing Application Number 3836918 and the mark "POLO LIFETIME" (word) bearing Application Number 3836919, in Class 21, in the name of the Defendant. The Plaintiff had accordingly initiated opposition proceedings against the said applications. The Plaintiff had also initiated cancellation proceedings against the registration of the impugned trademark POLO LIFETIME (Label) under No. 2105994 in Class 21 in the name of the Defendant, after first learning about this registration in the last week of

October 2020 itself. However, the said proceedings were pending at the time of pronouncement of the present judgement. It was also alleged that the Defendant had adopted and started using the impugned mark dishonestly, fraudulently and out of positive greed with a view to take advantage of the Plaintiff's well-established goodwill, reputation and proprietary rights in the POLO formative marks.

The Defendant in its written statement and reply took the defence that the Plaintiff's mark was not registered in class 21 which covered the goods in which it was engaged, and that the Plaintiff only had registration for its "POLO" marks in class 25, which was not conflicting in nature. Further, the word mark "POLO" was not registered by the Plaintiff in India and the label marks registered by the Plaintiff were dissimilar to the 'POLO LIFETIME' (marks/labels) being used by the Defendant. It was also stated by the Defendant that the Plaintiff had failed to establish its sales under/use of the "POLO" formative marks in India prior to the adoption and use of the POLO LIFETIME marks/labels of the Defendant. It was further argued that more than hundred persons in India were using the trademark POLO and the Plaintiff's trademark was declared well-known by the Delhi High Court after the Plaintiff started using the trademark and thus that judgement was not applicable to the present case. Both the parties, respectively, relied upon various landmark judgements in support of their case.

The court held and observed with regard to the issue of passing off that in most of the Plaintiff's trademarks, besides the word element POLO, the name "Ralph Lauren" was also used besides a device of a polo player on a horse. Whereas the Defendant used the mark/label 'POLO LIFETIME' where except the word POLO there was no similarity between the Plaintiff's trademark and the Defendant's trademark. Further, it was held that the lines of businesses, goods and services of both the parties were significantly different. Moreover, the Plaintiff had failed to show, substantiate, and assert as to when it started its business in India. However, through the documents filed by the Plaintiff, it was noted that it entered into an agreement in 2018 with Aditya Birla group to enter the Indian market. Whereas the Defendant was found to be selling goods with the trademark POLO since 2005 in India, as per the documentary evidence (invoices) filed by it. The commencement of use of the impugned mark(s) by the Defendant was thus observed to be before 2018. The court in this case did not find the Plaintiff to be able to

establish the balance of convenience in its favour or a *prima facie* case against the Defendant as it failed to show prior use of its marks in India and that irreparable injury or loss would be caused to the Plaintiff. The court noted that such loss, injury or inconvenience, if any, would rather be caused to the Defendant as an injunction at this stage would amount to shutting down of its business despite the fact that Defendant was the registered owner of the trademark/label 'POLO LIFETIME' and the said registration had still not been cancelled. Further, it was held that the Defendant's mark had a predominant suffix LIFETIME whereas Plaintiff's marks had suffixes/prefixes including 'Ralph Lauren' & picture of a polo player, resulting in distinguishable trademarks. Thus, the court vacated the *ex-parte* interim injunction that was earlier granted to the Plaintiff on November 26, 2020 by another judge. It was held that the Plaintiff had *prima facie* failed to establish that the Defendant was infringing the Plaintiff's trademark or passing off its goods as the goods of the Plaintiff.

Coty Germany GMBH v. Xeryus Retail Private Limited & Anr

Forum: High Court of Delhi

Case No.: CS(COMM) 1298/2018 & I.A. 8603/2023

Judgment Dated: July 21, 2023



Issue:

- Whether the defendant was liable for the illegal use of plaintiff's

marks ,  and Calvin Klein ?

Judgment:

The issue arose between the Plaintiff and the Defendants on account of the

unauthorized and illegal use of the marks ,  and

Calvin Klein

by the latter. The Defendants were found to be using the Plaintiff's reputed marks on their products and also sold testers of the perfumes manufactured by the Plaintiff, which were not intended for retail sale to customers. The Plaintiff asserted before the court that it was a reputed name in the field of perfumes and was also the holder of a number of "**Calvin Klein**" / "**CK**" formative registrations in class 3 in India, *inter alia*, dating back to **1992**. The Plaintiff further submitted that its trademarks "**Calvin Klein**" / "**CK**" were first adopted and founded on the basis of the name of its founder in the year **1967** and had been in use since then. It was also stated that the particular way of representing/using the Plaintiff's marks in a special stylized manner was unique in itself, thereby constituting original artistic works within the meaning of the Indian Copyright Act, 1957, which were strongly associated with the Plaintiff, being duly entitled to protection. It was further stated by the Plaintiff that it sold a wide variety of fragrances under these marks which had become extremely popular amongst the public in general. The Plaintiff also operated the website www.calvinklein.com, through which it disseminated information about its products and the brand, and the same was accessible globally.

The Plaintiff's grievance was that the Defendants, through their websites www.perfumery.co.in and www.unboxed.in, were using the Plaintiff's marks for their products and were also selling the testers of the Plaintiff's perfumes. The main concern of the Plaintiff was that the Defendants engaged themselves in unfair trade practices which harmed the reputation of the Plaintiff as the tester products of the Plaintiff were not meant to be sold for commercial value but were intended to enable prospective customers to sample and analyse the fragrances before deciding to purchase them. The Defendants were earning money by luring the customers to buy these testers which were not meant to be sold, thereby hampering the goodwill and reputation of the Plaintiff. The *mala fide* intent of the Defendants and the dishonest adoption and use of the Plaintiff's marks



by them was also particularly asserted by the Plaintiff. It was also noted that the Written Statement filed by Defendants in this case was struck off vide an order of the court passed on November 8, 2019, on account of the unreasonable delay in filing the same beyond the statutory deadline of 120 days. Even afterwards, the Defendants repeatedly failed to cooperate and appear in the present matter and thus, vide an order dated February 13, 2023, the court proceeded *ex-parte* against the Defendants. It was held that the Defendants had failed to establish their case and the statements made in the Plaint were, therefore, deemed to be admitted. It was further held that the act of the Defendants showed that they had no substantial defence to offer. Further, the Plaintiff in its plaint had also prayed for an award of damages for a sum of Rs. 2,00,01,000/- [USD 240521 (approx.)]. The court held that the case made out by the Plaintiff established infringement by the Defendants as well as passing off of their goods and the Plaintiff's testers as the Plaintiff's products meant for commercial sale, thereby defrauding the purchasing public at large. The court further awarded costs of Rs. 1,00,000/- [USD 1203 (approx.)] in favour of the Plaintiff to be paid by the Defendants.

M/S Ite India Pvt. Ltd vs M/S Tarsus Group Plc

Forum: Patiala House Courts of Delhi

Case No.: CIVIL SUIT No.57441/2016

Order Dated: July 27, 2023

Issues:

- Whether the plaint should have been returned on account of lack of cause of action?
- Whether the defendant was guilty of infringing and/or passing off the registered mark as described (International Food and Drink Expo)?

- Whether the suit was liable to be dismissed for non-disclosure of material facts?
- Whether the plaintiff was entitled to an injunction and/or damages, as claimed?

Judgment:

The matter revolved around the alleged infringement of the trademark "IFDE INDIA" by the defendant's use of an identical abbreviation. The court meticulously analyzed the evidence, case laws, and legal principles presented by the parties in order to arrive at its final decision.

The court assessed whether the plaintiff possessed a valid cause of action to initiate the lawsuit. After a thorough examination of the facts, it was determined that the plaintiff had a valid cause of action. The court referred to Section 28 of the Trademarks Act, 1999, which clarifies that the valid registration of a trademark confers exclusive rights to the registered owner of the trademark to use it in relation to the goods or services for which it is registered. The court subsequently examined the matter of whether the plaintiff, in their capacity as the registered owner of the trademark "IFDE INDIA," was entitled to any rights in the designation "International Food and Drink Expo." The evidence and legal principles were scrutinized by the court to determine whether the trademark had attained well-known status. It was concluded that the plaintiff had failed to establish the well-known status of the trademark and, as a result, did not possess exclusive rights over the description "International Food and Drink Expo."

In relation to the matter of whether the defendant was culpable for infringing and/or passing off the registered mark, the court diligently scrutinized the evidence proffered by both parties. The court extensively relied on Sections 134 and 135 of the Trademarks Act, 1999, which deal with remedies in cases of trademark infringement and passing off. The court specifically referred to the exceptions mentioned in Section 135(3)(b)(i) and (ii), which state that damages shall not be granted if the defendant can prove ignorance of the plaintiff's trademark's existence or immediate cessation of usage after becoming aware of it. The defendant's admission of using the trademark abbreviation was considered inadvertent and made under

ignorance. The court's analysis was based on the principle that infringement required intentional use of the mark. It was found that the defendant's usage was unintentional and lacked malicious intent, thereby resulting in a ruling against the plaintiff's claim of infringement.

The court proceeded to assess whether the plaintiff was entitled to an injunction. Drawing upon the evidence and legal precedents, it was concluded that the plaintiff had satisfied the necessary conditions for an injunction and a ruling was made in favor of the plaintiff.

In the context of the claim for damages, the court made reference to the case of "Inter Ikea System B.V & Ors. Vs Sham Murari & Ors.", which involved a discussion on the concept of punitive damages. The court emphasized the importance of having evidence of intentional infringement and malafide intent in order to impose punitive damages. It was further noted that punitive damages were to follow the award of general damages. Upon conducting an analysis of the evidence and legal principles, it was determined by the court that there was no significant evidence indicating intentional infringement or malicious intent on the part of the defendant. Therefore, punitive damages were rejected and nominal damages of Rs. 3,00,000/- (Three Lac Rupees) was awarded to the plaintiff.

In conclusion, the court partially decreed the suit. Nominal damages were awarded to the plaintiff and the previously granted injunctive relief was maintained. The court had determined that the plaintiff had not succeeded in establishing the well-known status of the trademark and intentional infringement by the defendant. Consequently, the claim for punitive damages was rejected and nominal damages were awarded. The court's final order has reflected a comprehensive analysis of the evidence, legal principles, and relevant case laws, ensuring a just and reasoned outcome.

Societe Das Products Nestle S.A. & Anr. vs. Kit Kat Food Products & Anr

Forum: High Court of Calcutta
Case No.: CS/48/2000
Order Dated: July 31, 2023

Issue:

- Whether the Defendants, Kit Kat Food Products & Anr., were engaging in the violation of their intellectual property rights through the utilization of a comparable trademark and packaging?

Judgment:

In this case, the Court conducted an examination of the material presented and proceeded to use the established principles of intellectual property law in order to ascertain the legitimacy of the claims put up by the Plaintiffs. The Plaintiffs, Societe Das Products Nestle S.A. & Anr., asserted their ownership of the trademark "KIT KAT" in accordance with the provisions of the Trade and Merchandise Marks Act, 1958. Additionally, they claimed copyright protection for the packaging of "KITKAT" as per the Copyright Act, 1957. The Plaintiffs contended that the Defendants, Kit Kat Food Products & Anr., were engaging in the violation of their intellectual property rights through the utilization of a comparable trademark and packaging.

The Court noted that the Plaintiffs had provided evidentiary support for their claims, such as a certificate of registration and rulings from the Intellectual Property Appellate Board. The Court observed that the Defendants had submitted opposition notices in response to the Plaintiffs' trademark applications, alleging their own rights to the "KIT KAT" trademark.

During the process of examining the evidence, the Court made reference to Section 124 of the Trademarks Act, 1999. This particular section outlines that the orders issued by the Intellectual Property Appellate Board in rectification proceedings hold legal authority over civil courts. The Intellectual Property Appellate Board ruled in favor of the Plaintiffs' trademark registration and confirmed their prior usage of the "KIT KAT" mark. The Court also took into account the possibility of consumer confusion arising from the resemblance between the products and trademarks of the Plaintiffs and Defendants.

The Court reached the conclusion that the Plaintiffs have effectively demonstrated their case through the presentation of evidence and the application of legal principles, i.e., suit maintainability, ownership over

copyright and trademark, degree of originality & creativity, prior use status, first use status, reputation built and infringement leading to damages. The Plaintiffs were successful in their case before the Court, which resulted in the granting of a permanent injunction against the Defendants. This order prohibits the Defendants from engaging in any activities that would violate the Plaintiffs' trademark and copyright. The Defendants were directed by the Court to discontinue their use of the "KIT KAT" trademark or any modifications thereof that could potentially mislead or deceive.

In summary, the Court rendered a decision in favor of the Plaintiffs, recognizing their entitlement to intellectual property rights and awarding the remedy sought in the form of a permanent injunction against the Defendants' conduct that infringed upon such rights.

Puma Se vs. Girish Vohra Owner & Proprietor

Forum: High Court of Delhi

Case No.: CS(COMM) 93/2021, I.A. 2795/2021 & I.A. 12233/2023

Order Dated: July 27, 2023

Issues:

- Whether the defendant's "BERKINS" shoes breach the plaintiff's "RS-X 3D" sports shoe intellectual property rights, resulting in a passing off claim?
- Whether the plaintiff's "RS-X 3D" sports shoes have built a strong reputation in India?
- Whether the defendant's "BERKINS" shoe design and sales violate the plaintiff's trademark and trade dress?
- If the defendant's shoes' remarkable likeness in design, color scheme, and overall appearance to the plaintiff's "RS-X 3D" shoes confuses consumers, leading them to mistake differentiating between the two products, causing damage to the plaintiff?

Judgment:

The court conducted a thorough analysis of the evidence, submissions, and circumstances that were presented throughout the course of the proceedings. Puma SE, the plaintiff, successfully cultivated a positive reputation and created a strong brand presence in the Indian market by virtue of its "RS-X 3D" line of athletic footwear. The sales of the RS-X series exhibited a consistent upward trend throughout the years, as seen by the sales figures provided by the plaintiff, amounting to a total of Rs. 58,38,49,948.

In addition, it is noteworthy that the plaintiff's trademark, specifically the mark "PUMA," has been officially recognized as a well-known trademark in accordance with Section 2(1)(zg) of the Trade Marks Act by the Registry of Trade Marks.

In contrast, the defendant refrained from contesting the proceedings by abstaining from both appearing in court and submitting a written statement. The defendant's failure to provide a response was interpreted as an implicit admission of the plaintiff's claims stated in the complaint. These claims included the plaintiff's allegation regarding the positive reputation and goodwill associated with their "RS-X 3D" footwear, as well as the alleged imitation of this footwear by the defendant's "BERKINS" brand shoes.

The court decided that the defendant engaged in passing off, since the defendant's footwear closely replicated the design, color scheme, and general visual characteristics of the plaintiff's "RS-X 3D" shoes. The aforementioned resemblance had the potential to result in purchasers erroneously perceiving the defendant's merchandise as belonging to the plaintiff.

As a result, the court rendered a decree in support of the plaintiff, encompassing the subsequent directives:

- The defendant, Girish Vohra, and any individuals or entities representing them, are hereby subject to a permanent injunction that prohibits the manufacturing or sale of shoes that display designs that are intentionally misleadingly similar to those seen in the plaintiff's "RS-X 3D" series.
- The second defendant is required to make a payment of punitive damages amounting to ₹50,000/- to the plaintiff.

- Furthermore, it is imperative that Defendant 1, also known as Girish Enterprises, adheres to the instructions outlined in a previous ruling on 3 March 2022.

The court, in its decision, issued injunctive relief to protect the plaintiff's intellectual property rights and to prohibit any future infringement by the defendant. The court's ruling was based on the plaintiff's well-established reputation, the clear similarity between the footwear, and the lack of protest from the defendant during the legal procedures.

COPYRIGHT



Global Music Junction Pvt. Ltd. vs. Annapurna Films Pvt. Ltd.

Forum: High Court of Delhi
Case No.: CS(COMM) 715/2022
Judgement dated: 06th January 2023

Issue: Whether the plaintiff's suit requesting a declaration of their rights, title, and interest in the content created by the defendant, is a request for specific performance of a "contract of service" disguised as an injunction for copyright infringement.

Order: The plaintiff filed a suit for a declaration that they have all the rights, title, and interest in the content created by the defendant. The plaintiff also sought a decree permanently restraining the defendants from infringing their copyrights and intellectual property rights. However, the court found that the plaintiff cannot claim copyright in songs/content that are yet to come into being, and the suit is only a request for specific performance of the contract disguised as an injunction for copyright infringement. The plaintiff is engaged in producing, aggregating, distributing, and monetizing music and entertainment content, while the defendant no. 1 is involved in producing, marketing, and monetizing such content. Defendants 2-4 are entertainment channels on the platform of defendant 5, YouTube LLC, an online video sharing and social media platform. The plaintiff and defendant 6 had entered into a production agreement, and a breach occurred when the artist released songs to third parties in violation of the exclusivity clause. The parties resolved the issue and added an addendum with some clauses, including a right of first refusal in favour of the plaintiff company. Despite this, disputes arose between the parties, and the artist terminated the original agreement allegedly in blatant infringement of the plaintiff company's copyrights and exclusivity. The plaintiff company filed the present suit. The court found that the contract was a "contract of service" and depended on the personal qualifications of the artist, making it not specifically enforceable under Section 14(c) of the Specific Relief Act, 1963. The court also held that since the parties had lost mutual trust and confidence, the contract being determinable in nature, was not enforceable under Section 14(d) of the Specific Relief Act, 1963. Therefore, the court concluded that it is a suit for specific performance of a "contract of service," which is barred under Section 14(c) and (d) of the Specific Relief Act, 1963.

V.Prabhakar vs. M/S.Saga Films

Forum: High Court of Madras
Case No.: C.S. (Comm. Div.) No. 228 of 2022
Judgement dated: 17th November 2022

Issue: Whether the pre-institution mediation and settlement under Section 12A of the Commercial Courts Act is mandatory?

Order: The plaintiff, a cinema Director-cum-writer, alleged that the defendant, a film producer, infringed on his rights by violating the script, storyline, casting of characters, dialogues, sequence of scenes, and songs. The court examined the case under Section 12A of The Commercial Courts Act, 2015, and the Patil Automation case law, where the Supreme Court held that Section 12A is mandatory, and the Commercial Division can reject a plaint for non-compliance with it. The Court considered the following:

- Whether the request for temporary relief was carefully considered before being made.
- Whether proceeding with pre-institution mediation could result in an irreversible situation.
- Whether the plaintiff created the sense of urgency.
- Whether the plaintiff has reasonable grounds to request urgent interim relief.

After examining this, this Court held that it has no doubt that the plaintiff is solely responsible for creating the urgency in this case. The court also highlighted the need for the plaintiff to think carefully about the possibility of a thing happening and take prompt action.

Phonographic Performance Limited vs. Union Of India & Ors.

Forum: High Court of Delhi

Case No.: W.P. (C)- IPD 41/2021 and CM No.27851/2021

Judgement dated: 09th March 2022

Issue: Whether the rejection of Phonographic Performance Limited's (PPL) application for re-registration as a copyright society, and the registration of Recorded Music Performance Limited (RMPL) as a copyright society for sound recordings was correct?

Judgement: The petitioner, "Phonographic Performance Limited," a company registered under the Companies Act, 1956 (hereinafter known as PPL), which was a registered copyright society until the introduction of an

amendment to the Copyright Act in 2012 filed a writ petition challenging the orders for the rejection of their registration as copyright society, and the registration of Recorded Music Performance Limited (RMPL). The Delhi High Court has set aside the registration of Recorded Music Performance Limited (RMPL) as a copyright society for sound recordings and directed the government to reconsider Phonographic Performance Limited's (PPL) application for registration as a copyright society. PPL's application for re-registration had been rejected in 2021, eight years after the initial application, with the government claiming the earlier application was withdrawn and the 2018 application was belatedly filed. The court found that PPL had a legitimate expectation that its application for re-registration would be considered and that the order for rejection was passed without application of mind, which was illegal. The court upheld PPL's arguments on two grounds. Firstly, PPL had a reasonable expectation that their application for re-registration would be considered, based on the government's conduct in keeping the original application in abeyance and granting registration to IPRS under similar circumstances. Additionally, a 2016 office memorandum stated that both PPL and IPRS applications were "under examination." Therefore, PPL believed their application was being considered and had a legitimate expectation that it would be evaluated. The court dismissed the respondent's claim that PPL had chosen to operate as a company instead of a society, stating that the government's delay in considering PPL's application had forced PPL to act as an incorporated entity in the interest of its members. Secondly, the court found that the order of rejection was passed without giving PPL a chance to be heard and without considering the merits of the application. This was in violation of established administrative law principles and was therefore deemed illegal. The court also ordered that RMPL's registration be set aside as only one copyright society should be registered for one class of works.

AP International, Represented by its Partner, Mr. Sanjay A. Wadhwa vs. Arun Mathew

Forum: High Court of Madras

Case No.: C.S. (Comm. Div.) No. 96 of 2021

Order Dated: 8th June 2022

Issue: Whether the Plaintiff is the producer of the feature film BHRAMAM and whether the infringement notice sent by the Defendant constitutes as a baseless threat?

Judgement: The present suit was filed under Section 60 of the Copyright Act, 1957 seeking a declaration that the threats of infringement by the Defendant are baseless and for a consequential permanent injunction in respect thereof. Suit summons were served on the sole defendant and in spite of service of summons and the printing of the name of the defendant in the cause list, there was no representation for the defendant. Therefore, by order, the defendant was set *ex parte*. The Plaintiff referred to the infringement notice dated September 30, 2021, and contended that the said notice constituted as a groundless threat. To justify such contention, the Plaintiff asserted that it is the producer of the Malayalam feature film BHRAMAM and that the said film was a remake of a Hindi film. According to the Plaintiff, the contention of the Defendant that it has a copyright in the title of the film BHRAMAM, which the Defendant released on 17th June 2016, was misconceived. Therefore, upon receipt of the above-mentioned notice, the Plaintiff issued a reply dated 6th October 2021. The Plaintiff also put forth that it released its movie on 7th October 2021 and that it has expended considerable sums of money in producing, advertising, and exhibiting the movie.

After going through the evidence adduced by the Plaintiff, the Hon'ble Court opined that the Plaintiff is the producer of the feature film BHRAMAM as evidenced by the Censor Certificate adduced by it. Furthermore, on examining the Defendant's notice and the Plaintiff's reply sent thereafter, and by considering the fact that the defendant remained *ex parte* and did not choose to controvert the evidence, the Hon'ble Court held that the Plaintiff is entitled to succeed. The Court also directed the

Defendant to pay costs assessed in a sum of Rs. 1,50,000/- towards court fees, lawyer's fees, witness and other expenses.

Five Star Films Pvt. Ltd. vs. Sri Thenandal Films

Forum: High Court of Madras

Case No.: (Comm. Suit) 116 of 2019

Order Dated: 8th June 2022

Issue 1: Whether the plaintiff is holder of the absolute and exclusive remake rights of the Tamil movie Moondru Mugham by the third defendant?

Issue 2: Whether “Mersal” is an infringement of the plaintiff’s remake rights for the movie “Moondru mugham”?

Judgment: The present suit has been filed for injunctive relief and damages for the infringement in the copyright in the movie “Moondru Mugham” by the remake movie “Mersal”. The third defendant had had produced “Moondru Mugham” and entered into an assignment agreement with M/s Group Company for the assignment of the copyright in the story of the movie that is to be remade in Tamil Language. In 2015 the assignment was transferred to the plaintiff. A Tamil movie was released in 2017 titled as “Mersal” which was produced and directed by the defendants 1 & 2. The Plaintiff claims that the story in both the movies have substantive similarities in relation with the characters and the story line.

The Defendant contends that his movie is based on his original literary work and points out difference between the two movies by setting out the story line and the essential features of the two movies. The Defendant states that “Mersal” is the story about the exploitation of the common man by corrupt doctors whereas “Moondru Mugham” is based on the personal agenda of revenge against the villain. The Defendants further supported their claims by pointing out the differences in the characters of the movie.

With regards to the issue no. 1, it is observed by the court that the original assignment was done to M/s Group Company by the third Defendant and the agreement entailed that the reassignment of rights is prohibited. But in the written statement the third defendant states that the plaintiff holds the remaking rights, and this shows that the Defendant has acquiesced in the assignment to the plaintiff and hence it is in the favour of the Plaintiff.

With regards to issue 2 the plaintiff concedes *“that there can be no copyright in an idea, concept or theme, the Plaintiff asserts that the expression of the idea in the form of scenes, sequences, narration and the like are legitimately the subject matter of copyright.”* The plaintiff contends that the central events of the two movies are similar, and the differences are not material.

After going through all the contentions, the Court is of the view that there is sufficient basis to conclude that there are similarities with the regard to the central characters and the events. But in contrast the motive of murder in both the movies are different and it is understood that although there are some similarities and reasonable basis to conclude that “Mersal” is inspired by “Moondru Mugham”, but it cannot be concluded that the average viewer of average intelligence who views the two movies would leave with the unmistakable impression that “Mersal” is the copy of “Moondru Mugham”. Hence the plaintiff has failed to establish that there is an infringement of copyright.

Sun TV Network Ltd., Rep. by its authorized signatory vs. Parameswara Art Productions, Rep. by its proprietor, Mr. B. Ganesh Babu and Another

Forum: High Court of Madras
Case No.: Civil Suit No. 924 of 2015
Order Dated: 7th June 2022

Issue: Whether the present suit filed by the Plaintiff under Order VI Rule 1 of the O.S. Rules r/w Section 55 and 62 of the Copyright Act and Order VII Rule 1 of the CPC is maintainable?

Judgement: The plaintiff claims to be the exclusive copyright holder of the film "Temper" and seeks a permanent injunction against the defendants from exploiting or exhibiting the film. The first defendant assigned the copyright to the plaintiff for a sum of Rs. 7,75,00,000, and the payments were made in full. The second defendant claims to be the exclusive video copyright holder and denies the authenticity of the assignment agreement. The plaintiff alleges that the second defendant uploaded the movie on YouTube without permission.

In the court it was held that Plaintiff is granted a declaration and permanent injunction against both Defendants, while the second Defendant's counterclaims are dismissed. Both the Plaintiff and second Defendant can initiate legal action against the first Defendant, subject to the law of limitation. The first Defendant must pay INR 1,50,000 (USD 1,826) in costs to the Plaintiff and Rs. 1,00,000/- in costs to the second Defendant towards various expenses.

Warners Bros Entertainment Inc. vs. [Https://Otorrents.Com](https://Otorrents.Com) & Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 367/2019 & I.A. 9854/2019, 9856/2019 & 6469/2022

Order Dated: 1st June 2022

Issue: Whether restraints should be put on the torrent websites termed as rogue websites for copyright infringement?

Judgment: The Plaintiff filed a suit against the defendants for infringing its copyrights by illegally streaming and hosting the plaintiff's content on its

website. A cease-and-desist notice was served on them to stop engaging in their infringing activities. The Plaintiff sought relief from the court to issue an order and decree of permanent injunction restraining Otorrents from hosting and streaming its content and issue an order to ISPs to block the access to Ottorents' website. It also prayed to the Court to issue an order to Union Ministry of Electronics and Information Technology (MEITY) and other government departments to issue a notice calling upon various internet and telecom service providers registered under it to block access to the website.

The Plaintiff claims that the work produced by him qualify to be a cinematograph under section 2(f) of the Copyright Act. The claims of the plaintiff are premised on the illegal and unauthorized distribution, re-broadcasting, transmission, and streaming of the plaintiff's content.

The Court referred to the case of UTV Software which stated several illustrative factors to be considered for determining whether a website fall under the category of rogue website, but the court was of the opinion that these factors are illustrative and not exhaustive and the real test for examining whether a website is rogue is a qualitative approach and not a quantitative one.

According to the definitions given in the Copyright act, whether or not the audience actually views the film, making any work available for them to view or hear, whether simultaneously or at locations of their choosing, will entail communicating that work to them. Intentionally included digital copies of works meant that they would fall under its purview when they were made available online (as opposed to the physical world). There are several ways to communicate, including directly, visually, orally, orally, or via diffusion. In this context, the term of "broadcast" which describes communication to the public by wire or wireless diffusion is equally pertinent.

The Court is of the view that blocking is antithetical to efforts to preserve a “free and open” Internet, but it does not mean that every website should be freely accessible.

In conclusion the court permitted the Plaintiff to implead any mirror/redirect/alphanumeric websites which provided access to its content by filing appropriate applications supported by affidavits and evidence. “Any website impleaded as a result of such application will be subject to the same decree,” the judgment stated.

Samir Kasal vs. Prashant Mehta and Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 39/2022

Order dated: 19th January 2022

Issue: Whether the plaintiff’s idea, being a conceptual format for the sport of cricket, constitutes ‘work’ under the Copyright Act, 1957? Whether there is a violation of confidentiality and infringement of copyright by the defendants?

Order: The arguments of both the parties were heard and the Court held that the conception of plaintiff to organize a competitive cricket league, where retired international players were to play at neutral venues, does not come under the definition of ‘work’ as provided under Section 2(y) of the Copyright Act, 1957, and the idea of a “Ten Overs” cricket match with two innings was first introduced in 1997 in New Zealand. Further, retired players have been playing matches all around the world since a long time. Test matches have also been held in countries that do not play cricket. Thus, the idea of the plaintiff was not original, and he cannot claim statutory rights of exclusivity over the same.

In deciding whether there is any infringement of copyright by the defendant it was held that the concept of the defendant was different from that of the

plaintiff. The fundamental concept of “game of cricket” was held to be similar on which no one can claim copyright. Further, it was held that no copyright can be claimed over the several permutations and combinations of number of overs and innings in a cricket match as it had been done and continues to be done in the game of cricket. It also involved selection of venue and duration and length of the matches. Although it was stated by defendant no. 1 that novelty was not essential for copyright, but the Court held that where the substratum is so fundamentally fixed, it would be novelty alone which can be protected, which the plaintiff has *prima facie* failed to establish.

With regards to confidentiality, it was held that confidentiality would depend on the nature of the information being shared. It was held that the information shared by the plaintiff of his idea to organize a league match consisting of retired international players at neutral venues could have been protected but the fact that the plaintiff did not choose to follow-up and act on the idea between August 2018 and the entire 2019, would mean failure of plaintiff’s right to confidentiality and it could no longer bind the defendant no.5 from organizing a separate cricket format since he was himself continuously involved in the sponsorships and promotions in IPL matches.

Further, both the ideas of plaintiff and defendants were compared at length, and it was held that the plaintiff’s idea for the name “World Cricket Masters” which was later changed to “Legends Premier League” was different from the defendants’ idea for the name “Legends League Cricket”. Further, on comparing the format, business model, venue, teams and their names, number of innings and overs, it was held that the defendants did not infringe plaintiff’s right (if, any) as the above parameters were different of both the parties.

With regards to the interim injunction to be provided to the plaintiff, it was held that firstly the plaintiff slept over his rights and did not immediately

take any action against defendants since April 2021 as assuming that defendant no. 1 had already informed him of such other concept being introduced by defendants no. 2 to 5. Further, it was held that within such short period of time wherein the money of the defendants, its investors and of general public was involved, and also broadcasting rights were given, Mr. Amitabh Bachchan was approached to be the brand ambassador, various contacts were made between the defendants and the retired international players, an injunction could not be granted to the plaintiff. It was further held that the ‘balance of convenience’ here lay in the favour of the defendants, and if the injunction was to be granted, and plaintiff was to lose the trial, it would cause an ‘irreparable loss and injury’ to the defendants and general public. Whereas, if the injunction was not granted and plaintiff was to win the trial, he could be compensated with the interest of earnings by the defendants. In view of the same, it was also ordered by the Hon’ble Court that the defendants would maintain clear accounts of their earnings and expenditure in respect of these matches. Thus, in light of the above discussion, the plaintiff’s applications for interim injunction were dismissed, and the plaint was directed to be registered as a suit and summons were issued. The defendants were also directed to file written statements within 30 days and parties were directed to complete all the pleadings along with necessary affidavits before the Joint Registrar.

Star India Pvt. Ltd. and Anr. vs. Afilmywap. TOP and Ors.

Forum: High Court of Delhi

Case No.: CS (COMM) 485/2020 and I.A. 10011/2020

Judgement Dated: 17th January 2022

Issue: Whether the plaintiff could seek suspension of rogue websites of the defendants in anticipation of copyright infringement over its cinematographic film “Laxmii” (formerly known as “Laxmi Bomb”)?

Judgement: The present suit was filed by the plaintiffs for injunction and damages against the defendants for anticipated infringement of their

exclusive rights over the cinematographic film “Laxmii” (formerly known as “Laxmi Bomb”). The plaintiffs and defendant no. 51 had the exclusive rights as enumerated under Section 14(d) of the Copyright Act, 1957. It was alleged that the defendant nos. 1 to 50, had earlier infringed their copyright in the cinematographic films produced on earlier occasions. These rights included *inter alia* the right of making a copy of the Film including the storing of it in any medium by electronic or other means and the right of communicating the Film to the public. It was further agreed by both plaintiffs and the defendants no. 53, 63 and 64 (being one of the domain name registrars, Department of Telecommunication, and the Ministry of Electronics and Information Technology, respectively) that the plaintiffs shall not press for damages and cost; and the defendants no. 53, 63 and 64 agreed to passing of order of permanent injunction against them (including for causing suspension of the domain name registration of rogue websites of other defendants) as the defendants had complied with the directions passed by this Court in an earlier order.

Aman Chhabra vs. TRAC Entertainment Pvt. Ltd. and Ors.

Forum: High Court of Bombay

Case No.: Commercial Appeal (L) No. 10715/2021, I.A (L) 2928/2021 and Commercial IP Suit (L) No. 7101/2020

Judgement dated: 3rd July 2021

Issue: Whether the varied consent order passed without giving a proper chance to the appellant to present its case, maintainable?

Judgement: This is an appeal whereby the appellant challenged the order varying the earlier consent order in a commercial suit filed by the appellant against the respondents regarding infringement of copyright of its two music videos, “Pyar to Na Kaho” and “Lutti Heer.” The appellant sought a declaration that the respondent no.1 company owned the copyright and had prayed for an injunction against the respondents no. 2 to 6. In the interim

application taken out by the appellant, an interim order was passed by consent of parties. However, later, upon an application filed by the respondents no. 2 and 3, the consent order was varied to allow the said respondents to exploit the songs and bring revenue to the respondent no.1 company, as the appellant wasn't able to exploit the suit songs commercially. The main grievance of the appellant in this appeal was the denial of opportunity by the learned Single Judge to file a reply and contest the application taken out by respondents no. 2 and 3 for such modification of the earlier consent order. The Court agreed that time should have been given to the appellants to file reply to the respondents' application to vary the earlier consent order. The Court, on the positions of the respondents, observed that zero revenue had been generated from the exploitation of the songs and no irreversible position had taken place nor equity had arisen so as to direct that the position under the impugned order should continue till the matter is heard by the learned Single Judge afresh. Therefore, the Court allowed this appeal and directed that the impugned order passed by the learned Single Judge be quashed and set aside. The Court also restored the interim application of the appellant and directed the appellant to file a reply to the respondents' application as per the schedule set by the learned Single Judge with the matter having been remanded back.

Jayant Industries vs. Indian Tobacco Company and Ors.

Forum: High Court of Bombay

Case No.: I.A (L) No. 6771/2020, Commercial (IP) Suit No. 242/2015 and Chamber Summons No. 604/2019

Judgement dated: January 11, 2022

Issue: Whether in a summary judgement, costs can be imposed on the plaintiff for filing a frivolous lawsuit?

Judgement: An interim application was filed by the defendant for dismissal of plaintiff's claim for copyright infringement and passing off, and for

payment of costs and expenses by the plaintiff to the defendant, on the ground that the documents relied upon by the plaintiff were fraudulent. In a nutshell, the defendant sought a summary judgement for dismissal of the suit as the plaintiff's suit did not have any real prospect of succeeding. The plaintiff claimed to be the author of the artistic work on the label and mark "CLASSIC" written in a characteristic style, having adopted that mark since 1968. However, it was disclosed that the plaintiff was actually born in 1987. Thereafter, the plaintiff tried taking shelter under statements and a produced affidavit-cum-declaration allegedly signed by her grandmother who had purportedly assigned the said artistic work, somehow showing transfer of proprietorship in favour of the plaintiff. The plaintiff had also claimed a fanciful amount of INR 2,100 crores [USD 256,850,790 (approx.)] as damages/money decree from the defendants. However, defendants took the stand that the evidence provided by the plaintiff was completely fabricated and false. They also argued that the plaintiff could never be the author of the work. Further, it was stated that the defendant was a registered proprietor and user of the mark "CLASSIC" and had 97 registrations in class 34. The mark "CLASSIC" for cigarettes was exclusively associated with the defendants since long due to its reputation and built goodwill in the market. They had also claimed the use of the mark "CLASSIC" since 1979. The Court was convinced and was of the view that the defendant was entitled to a summary judgment of dismissal of the above suit.

After the perusal of the circumstances of the case, the Court stated that as far as the application of the provisions of costs to a commercial dispute is concerned, Section 35(1) of the Civil Procedure Code stipulates that in relation to any commercial dispute, the Court, notwithstanding anything contained in any other law for the time being in force or rule, has the discretion to determine whether costs are payable by one party to another, the quantum of those costs and when they are to be paid. The Court further noted that there is also an explanation to the said Section which clarifies that "costs" shall mean reasonable costs relating to the fees and expenses of the witnesses incurred, the legal fees and expenses incurred; and any other

expenses incurred in connection with the proceedings. The Court further focused on section 35(2) which contemplates that if the Court decides to make an order for payment of costs, the general rule is that the unsuccessful party will be ordered to pay the costs of the successful party and section 35(3) sets out the factors that the Court should consider whilst granting/awarding costs. One such factor is the conduct of the parties, and the other (amongst others) is also whether the party had made a frivolous claim and instituted a vexatious proceeding wasting the time of the Court. Further, the Court concluded that the plaintiff is reprehensible, as she approached Court with a false case and based on dubious documents and had also lied to the Court. This finding was concluded after carefully discussing each document including invoice and affidavit presented by the plaintiff. The Court evaluated that the invoices before 1972 had a stamp of the plaintiff with postal codes whereas it was only after 15th August 1972 that the regions in India were allotted pin codes. Further, the Court also observed that the phone number on many invoices of the same retailer had a seven-digit number which were again only allotted somewhere near the year 1980 and not before that. Thus, the Court concluded that the plaintiff in the present case did not come with clean hands and intentions, and this was a frivolous suit filed against the defendants. Therefore, the Court directed the plaintiff to bear the entire costs incurred by the defendants in defending this frivolous litigation. The advocates for the defendant had also quantified their costs at INR 1,19,26,308 [USD 145,834 (approx.)] mentioned in the written statement filed by the defendant.

However, the Court keeping in mind that the plaintiff was a lady, awarded costs to the defendants of a total sum of INR 60 lakhs [USD 73,370 (approx.)] and further directed those costs be paid within a period of four weeks, failing which the defendant would be at liberty to recover these costs as arrears of land revenue.

Siddhi Margarine Specialties Ltd. and Another vs. Zydus Wellness Ltd.

Forum: High Court of Delhi

Case No. FAO(OS) (COMM) 36/2022, CAV 35/2022 and CM APPLs.8310-8312/2022

Order Dated: 15th February 2022

Issue: Was the Ld. Single Judge's ex-parte injunction order against the appellant from using its registered trademark 'NUTDELIGHT' justified?

Judgement: The appellant filed the present appeal against Ld. Single Judge's ex-parte injunction order in a suit for copyright infringement and passing off by which the appellant was restrained from using its registered trademark 'NUTDELIGHT' which was registered since 2006 and had been uninterruptedly used for the last 15 years. The appellant was also restrained from selling its products bearing the mark 'NUTDELIGHT' under the trade dress in question, which as per the appellant was adopted nearly a decade ago. The appellant further contended that the respondent had failed to disclose that the appellants had trademark registration in their favour for their mark 'NUTDELIGHT' and that the respondent's application for its trademark 'NUTRALITE' had been abandoned. The appellant also submitted that both sets of business operations and trade channels were active from the same city and it was thus doubtful that the respondent learnt about the defendant-appellant's product 'NUTDELIGHT' only in October 2021. It was further contended that the appellants were in possession of inventory of a substantial amount and the shelf life of the said goods were extremely limited. The respondents argued that they in fact are the market leaders of the products in question, and the appellants were riding upon the reputation associated with the respondent's products. It was contended that the appellants were as a matter of fact selling their products under the mark 'SIDDHILITE' previously and that the sales figures of the appellants were a meagre INR 85 Lakhs [USD 103,982 (approx.)].

The Court at the outset was of the view that as the matter was previously attended by the Ld. Single Judge, it was not proper to interfere with the

impugned orders of the said judge and thus, the Court disposed of the appeal directing the Single Judge to dispose of the pending applications as expeditiously as possible. It was also clarified that the Court in the present Appeal did not delve into the merits of the controversy and the rights and contentions of all the parties were left open.

Polo/Lauren Company LP vs. Sandeep Arora and Another

Forum: High Court of Delhi

Case No: C.O. (COMM. IPD-CR) 4/2021, I.A. No. 11085/2021 (u/O-39R-1 &2)
and I.A. No. 11087/2021

Judgement Dated: 1st February 2022

Issue:

- Whether the respondent's adoption of the artistic work titled 'SPORTS POLO' (having depiction of 4 horses with riders), amounted to being an imitation of the petitioner's trademark 'POLO SPORT' (with device of a horse with a person riding it, flinging his club to hit a ball in the sport of polo)?
- Whether the copyright registration of the respondent for the said artistic work liable to be rectified/cancelled?

Judgement: The petitioner's registered trademark under consideration is 'POLO SPORT' device which consists of a 'horse with a person riding it, while flinging his club to hit a ball in the sport of polo' and which has been in use since 1967. The same has also been declared as a 'well-known trade mark' in 2011 by the Hon'ble High Court of Delhi on account of its reputation and goodwill in the market by way of judgement titled *The Polo/Lauren Company L.P. v. Rohit S. Bajaj and Ors.* The petitioner's mark was formative in nature and there were several combinations and versions of the same in respect of various goods and services (i.e., clothing, textiles, footwear, soaps, perfumes, etc.) that were registered in India and capable of distinguishing the petitioner's goods from those of others. The petitioner had filed a rectification/cancellation petition seeking removal of respondent no.1's registration titled 'SPORTS POLO' which consisted of 'four horses with riders who are playing the game of polo' from the register of copyright.

The petitioner contended that respondent no.1's work was not an original artistic work under Section 13(1)(a) of the Copyright Act, 1957 and that the Trade Marks Registry also failed to conduct a careful search of the trademarks register before granting a clearance certificate which would have established that respondent no.1's mark/applied artistic work was a slavish imitation of the petitioner's trademark. Respondent No.1 in reply to the petitioner stated that it had been using the words 'ARRAS SPORTS POLO' for its perfumery business and that it was substantially different from the petitioner's label.

The Court observed that the logo of respondent no.1 was an imitation of the petitioner's registered trademarks, as upon comparison, the respondent no.1 had used four horses with riders titled in a manner very similar to the logo of 'horse with a person riding it while flinging his club to hit a ball in the sport of polo' which was a registered trademark of the petitioner. The court further applied the test of originality and qualitative analysis and maintained that respondent no.1 had also used the words 'SPORTS' and 'POLO' while determining if respondent no.1's logo was similar to that of the petitioner's registered trademarks. The Court highlighted that respondent no. 2 (Trademarks Registry) failed to conduct the statutory exercise of checking the records of its register to identify if there existed deceptively similar trademarks to that of respondent no.1's logo as the said logo was capable of being used in relation to goods and services which necessitated the Trademarks Registry to issue a certificate that no such deceptively similar mark was present in its Register.

The Court maintained that the petitioner's mark was widely used in the market for a variety of products since 1967 and reiterated the judgment wherein the petitioner's mark was held to be well-known. The Court, as per its qualitative analysis, held that respondent no.1's logo was a substantial reproduction of the petitioner's mark done in bad faith, which contained the words 'SPORTS' and 'POLO' along with the image of four horses with riders, given its arrangement as well as the colour scheme. The Court, allowing the present petition, thus directed that respondent no.1's copyright registration be expunged from the Register of Copyright.

JA Entertainment Pvt. Ltd. vs. MS Sithara Entertainment and Others

Forum: Delhi High Court

Case No.: 191/2022

Order Dated: 11th July 2022

Issue: The Plaintiff (JA Entertainment) had sought the Hindi remake rights of a Malayalam film along with the rights to dub and subtitle the film in Hindi and any other language, which were granted through an agreement. The Producer of the Malayalam film also granted the Defendant, Sithara Entertainment the right to remake the Malayalam Film in Telugu. The present dispute arose when JA Entertainment came across a trailer of a Telugu film on YouTube “Bheemla Nayak” dubbed in Hindi and produced by Sithara Entertainment. The movie Bheemla Nayak was a Telugu remake of the Malayalam movie. Alleging infringement of its rights granted through the Agreement, the Plaintiff approached the Delhi High Court and was granted a temporary injunction against the Sithara and the Producer from releasing Bheemla Nayak. The Defendant’s then filed an application to vacate the injunction that was granted against them, and the matter was taken up by the Court and decided in the present order.

Order: The court reviewed the provisions of the Copyright Act, the Agreements and the holding of the Madras High Court in *Thiagarajan Kumararaja v. Capital Film Works (India) Pvt. Ltd.*, and came to the conclusion that the Producer of a movie was the first owner of a Copyright and the rights of a Producer in a movie included the right to communicate the work, make copies, sell/rent the work and the right to remake the work in another language. Accordingly, the Defendant in its own right as a copyright owner in the remade Telugu movie has a right to dub the Telugu film in any language including Hindi and that the Plaintiff could not assert any right to restrain Sithara from dubbing the Telugu film in Hindi.

T.V. Today Network Limited vs. News Laundry Media Private Limited and Ors.

Forum: High Court of Delhi

Case No.: CS (Comm) No. 551 of 2021

Order Dated: 29th September 2022

Issue: The plaintiff has sought relief against videos which are allegedly containing infringing material and defamatory/derogatory material against the plaintiff. The plaintiff operates television channels, namely, 'AajTak', 'AajTak HD', 'India Today Television' and 'Good News TV' and is part of 'INDIA TODAY GROUP'. They claim that the defendants have ridiculed and defamed the plaintiff, its news channels, and have published various videos and articles containing false, malicious, defamatory and derogatory information on their website as well as on various social-media platforms. The Defendants claim that excerpts have been used of Plaintiff's broadcasts to report current events for bona fide review and criticism and thus, were protected under Section 52 as a "fair dealing".

Order: For grant of interim injunction, there should be an existence of a "prima facie case" and the Plaintiff has shown that the content created by them is protected by the statute under broadcast rights and the Defendants have not been granted any licence for reproduction. The use of words such as, "shit standards", "shit playing" on the channel, "shit reporters", "shit show", would show, that the words are intended by the Defendants to indicate that the programmes/shows of the Plaintiff are bad. The other two requirements of "balance of convenience" and "irreparable loss and injury" are to be established as well for grant of injunction. Since the extent of infringement or fair use for fair comment and criticism would be a matter of trial as each video would have to be considered to determine whether the excerpts are significant to be outright copying or constitute fair use without infringement. These videos must be looked into individually to determine if they contain malicious, dishonest, defamatory and disparaging statements or constitute honest and possible satirical opinion. Thus, decision can be rendered after trial as present facts do not constitute exceptional circumstances for the issuance of directions as mandatory injunction.

Warner Bros. Entertainment Inc. vs. HTTP://MP4MOVIEZ. IO and Others

Forum: High Court of Delhi

Case No.: CS(COMM) 399/2019 & I.A. 10535/2019, 10537/2019 & 6470/2022

Order Dated: 01st June 2022

Issue: Whether the Plaintiff can get a permanent injunction against rogue websites showcasing their content illegally?

Order: Warner Bros filed a lawsuit contending that the Defendant websites infringed its copyright by illegally streaming and hosting its content. The company submitted that an independent investigator investigated to probe the extent of the infringing activity of the rogue websites. It also informed the Court that a cease-and-desist notice was served on the rogue websites calling upon them to stop engaging in their infringing activities. However, despite the legal notice, it was contended that the rogue websites continue to infringe the Plaintiff's rights. Warner Bros thus sought the following relief from the Court to issue an order and decree of permanent injunction restraining Otorrents from hosting and streaming its content and to issue an order to ISPs to block access to Otorrents' website. It also wished for an order directing the Union Ministry of Electronics and Information Technology (MEITY) and other government departments to issue a notice calling upon various internet and telecom service providers registered under it to block access to the website.

The Court noted that the Defendants did not have any real prospect of successfully defending the copyright infringement claim. Thus, it granted a permanent injunction in favour of Warner Brothers while restraining "rogue" torrent websites from distributing, broadcasting, transmitting, and streaming their content. The Court held that the suit could be decided summarily as the websites in question were not represented and further held that since the Defendants had no real prospect of successfully defending the claim of copyright infringement, they had chosen not to contest the said claim further. Based on the evidence placed on record, the Court found that there was sufficient evidence to hold that the Defendant No.1 and 51 other websites as "rogue websites" and passed a summary judgment invoking the

provisions which laid down the law on grant of dynamic injunctions, the Court permitted Warner Bros to implead any mirror/redirect/alphanumeric websites which provided access to its content by filing appropriate applications supported by affidavits and evidence. *“Any website impleaded as a result of such application will be subject to the same decree,”* the judgment stated. In its order, the Court also noted that in 2019, it had directed the MEITY and internet service providers to block the domain name “Otorrents.com” and its URL <https://otorrents.com>. It was informed that following a notification issued by the government departments, ISPs had blocked access to the infringing websites.

M/s Thind Motion Films Private Limited vs. Ishdeep Randhawa and others

Forum: High Court of Punjab & Haryana

Case No.: CR No.2780 of 2023

Order Dated: 4th May 2023

Issue: Whether the civil suit filed by the plaintiff-respondents against the petitioner for allegedly preparing a film based on the book 'Awaz Mard Nahi' without their permission is maintainable before the Civil Judge (Junior Division) or should it have been presented before the District Court having proper jurisdiction?

Judgement: The petition under Article 227 of the Indian Constitution challenges the ex-parte ad-interim injunction passed by the Civil Judge (Junior Division), Ludhiana, which restrained the defendants from releasing the film "Jodi Teri Meri" on 05.05.2023.

The Respondents are the sons of Gurdev Singh Randhawa, the director of Gurdevfilms. Gurdev Singh Randhawa entered into an agreement with the widow of Amar Singh Chamkila to make a motion film on the biography of Amar Singh Chamkila and Bibi Amarjot Kaur, and the agreement was binding on the heirs as well. After Gurdev Singh Randhawa's death, his sons learned that Gurmail Kaur is making the same film, a biography of Amar Singh Chamkila and Bibi Amarjot Kaur in association with M/s Reliance

Entertainment, Imtiaz Ali, Diljit Dosanj, and Parineeti Chopra. The Respondents earlier filed a civil suit against the aforesaid persons titled *Ishdeep Randhawa and another vs. Gurmail Kaur and others*, which is pending in the Court of Harsimranjit Singh, Civil Judge (Senior Division), Ludhiana. During the pendency of the suit, the respondents came to know that another film, "Jodi Teri Meri," was being made and was scheduled for release on 05.05.2023.

The plaintiff-respondent No.1 and 2 filed a suit against the defendant-respondent No.3 to 6 as well as the petitioner for allegedly preparing a film based on the book 'Awaz Mardi Nahi' authored by Sh. Gulzar Singh Shonki without their permission. An ad-interim injunction was granted on 01.05.2023, restraining the petitioners from releasing the film 'Jodi Teri Meri' until 08.05.2023. Formal notice of the suit or the application for ad-interim injunction was not ordered to be issued by the impugned order but it was made clear that if the service of defendants is not affected by 08.05.2023 through RC/AD etc. then the stay order shall stand vacated automatically.

The petitioner argued that the suit was not maintainable before the Civil Judge (Junior Division) due to the specific bar contained in Section 62 of the Copyright Act, 1957 and should have been presented before the District Court having jurisdiction. The petitioner also argued that the impugned order resulted in a gross and manifest failure of justice due to basic principles of natural justice having been flouted.

The petitioner's counsel cannot deny that an ex parte ad interim injunction was granted in the impugned order, which is appealable under Order 43 Rule 1(r) of the CPC. The failure to give reasons for the order does not render it non-appealable. The petitioner's argument that statutory appeal is not an efficacious remedy is not accepted as the trial court had sufficient time to serve the defendants. The court refrained from making any comments that may prejudice either party in the case. However, the court noted that the trial court had enough time to serve the defendants before granting the ex-parte order. The court concluded that no exceptional case has been made for jurisdiction under Article 227 of the Constitution of

India, as the petitioner had not availed the remedy of statutory appeal. The petitioner is advised to still pursue their remedy before the lower courts. This order does not prevent the petitioner from appealing or approaching the trial court. The court's observations should not be taken as an expression of opinion on the merits of the case. The revision petition was thus disposed of.

C. Prakash vs. Zee Entertainment Enterprises Limited and Others

Forum: High Court of Madras

Case No.: Civil Suit No. 301 of 2018

Order dated: 06th September 2022

Issue: Whether Plaintiff is the absolute owner of Copyright of the three films titled “Haridas”, “Endrendrum Punnagai”, and “Yarukku Yaaro”?

Order: The first Defendant filed a complaint against the Plaintiff’s video of “Yarukku Yaro” with Youtube, the second Defendant, acting on behalf of the first Defendant, filed similar complaint against the Plaintiff’s video of the movie “Endrendrum Punnagai”, and subsequently a similar complaint was made against the movie “Haridas” and this resulted in the removal of all three movies and eventually deletion of the Plaintiff’s Youtube channel.

The Plaintiff filed a suit seeking a declaration that the Plaintiff is the absolute owner of the copyright in the Tamil cinematograph films titled “Haridas”, “Endrendrum Punnagai”, and “Yarukku Yaaro”. Additionally, the Plaintiff also prayed for damages of INR. 53,426/- (USD 653.11) for loss of revenue caused by the termination of his YouTube Channel between 23rd April 2018 and 26th April 2018 and further damages on the same ground from the date of suit till the date of decree.

The Plaintiff entered into assignment agreements in relation to the acquisition of rights in the Tamil movies “Haridas”, “Endrendrum Punnagai” and “Yarukku Yaaro” on 04th September 2014, 17th December,

2014 and 20th February, 2014, respectively. On the basis of these assignment agreements, the Plaintiff asserted that he is the absolute owner of the copyright in the said movies. As regards the Assignment Agreement dated 17th December 2014 in respect of “Endrendrum Punnagai”, the Plaintiff relied upon the assignment clause therein to contend that the assignment extends to video copyrights, cable rights and other communication rights. As regards the movie “Yarukku Yaaro”, the Plaintiff asserted that the assignment in his favour was from S. Balakrishnan who, in turn, was assigned the said rights by the producer of the movie, M/s. Universal Thavamani Cine Arts. As regards the movie “Haridas”, the Plaintiff referred to the relevant portion of the Agreement dated 04th September 2014, to state that the assignment extended to video rights, cable rights and other communication rights.

The Plaintiff’s Youtube channel named “New Tamil Movies” was taken down and the Plaintiff could not access its content.

The first Defendant contended that with regards to the movie “Endrendrum Punnagai” it had acquired exclusive copyright in the movie under the agreement date 16th April 2012 which pre-dated the agreement relied upon by the Plaintiff. The Defendant claimed that this agreement was entered and executed by Dr. V Ram Productions Pvt Ltd which was also the producer of the movie and the first owner by virtue of Copyright laws.

With respect to the movie “Yarukku Yaaro”, the first Defendant obtained exclusive rights in the movie under an agreement dated 30th July 2008 which was executed by M/S Future Films. The Defendant further stated that M/s Future Films was the owner of Copyright for “Yarukku Yaaro” since they had agreed on an assignment with the original owner M/s.Universal Thavamani Cine Arts.

With respect to the movie “Haridas” the first Defendant stated that it acquired the exclusive Copyright under an agreement dated 04th March 2013. This assignment was made by Dr. V.Ram Production Private Limited, the producer of the movie and the first owner of the Copyright as disclosed in the certificate issued by the CBFC.

The Court with respect to Endrendrum Punnnagai, opined that the agreements relied upon by both the parties are not free from discrepancies since the agreement on which the Plaintiff relies is executed by a private limited company and as per laws a private limited company is headed by a Board of Directors whereas the agreement is executed by a Mr.G.K.M Tamil Kumaran, proprietor. Both the agreements are executed by Mr.G.K.M Tamil Kumaran who is also the fourth Defendant and executed the same on different limited companies. Due to the discrepancies in the agreement, it was held that the same was not valid for the movie in question “Endrendrum Punnnagai”.

The Court with respect to the movie “Yarukku Yaaro”. The first Defendant asserted that it owns the copyright. However, Ld Counsel of the Plaintiff pointed out that the assignment relied upon by the first Defendant is between M/S Future Films and Zee News Limited and not in favour of the first Defendant. First Defendant’s Counsel pointed out that the Plaintiff did not deny the agreement relied upon in his statement. The non denial meant that the execution of an agreement by M/S Future Films in favour of Zee News Limited is not disputed by the Plaintiff. The Court opined that it cannot be inferred from such admission that the Plaintiff is admitting that the assignment was in favour of Zee Entertainment Enterprises Limited, which is a separate legal entity. In the absence of evidence of devolution of title to the first Defendant, the contention of Ld. Counsel for the Plaintiff that the first Defendant has failed to establish the devolution of title in favour of the first Defendant is liable to be accepted.

Thus, it was held that the Plaintiff had failed to establish that he is the owner of the copyright in any of the three movies, which formed the subject of the suit. On the contrary, the first Defendant has established ownership of copyright as regards the movies "Haridas" and "Endrendrum Punnnagai". The first Defendant, however, failed to establish ownership of copyright as regards the movie "Yarukku Yaaro" the first Defendant, the said Defendant is entitled to injunctive relief to restrain the Plaintiff from infringing its copyright in the movie “Haridas” and “Endrendrum Punnnagai”. The first Defendant is also entitled to an order for delivery of infringing material for destruction and rendition of account of profits regarding the movies

“Haridas” and “Endrendrum Punnagai”. As regards the claim for damages, the first Defendant has not adduced evidence of loss. Therefore, the first Defendant is not entitled to damages.

Court held that the suit claimed by the Plaintiff was dismissed. In addition, the Plaintiff was directed to pay the first Defendant a sum of INR 2,00,000/- (USD 2446.62) as costs towards Court fees, lawyer's fees, and expenses.

YashRaj Films Private Limited vs. Triller Inc CS(COMM) 9/2023

Forum: High Court of Delhi
Case No.: CS(COMM) 9/2023
Order dated: 1st January 2023

Issue: Whether Plaintiff's copyright work has been infringed by the Defendant's platform or not?

Order: The Plaintiff in this case has alleged copyright infringement by the Defendant's platform, which allows users to upload audio-visual content/short videos that may contain the Plaintiff's copyrighted works. The Plaintiff sought relief through an application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (CPC).

The Court had granted an exemption to the Plaintiff for filing the original, clear, and legible copies of the documents within four weeks, as it is necessary to establish the Plaintiff's claims. The Court has also registered the Plaintiff's Complaint as a suit and ordered the Defendant to file a written statement within 30 days from the date of the order to understand the Defendant's defence. Both parties have been ordered to file all original documents in support of their respective claims, along with an affidavit of admission/denial of the other party's documents, to avoid any ambiguity in the future.

After hearing the parties, the Court had directed the matter to mediation, but the mediation failed, and the matter is now back in court and is pending.

Elsevier Ltd. And Ors vs. Alexandra Elbakyan and Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 572/2020

Order dated: 9th February 2023

Issue: Whether the Plaintiff's assignment agreements, that is relied upon to claim copyright ownership of the impugned works, are valid under the Indian Contract Act and the Copyright Act.

Order: The High Court of Delhi has rejected the plaint by Ms. Elbakyan on the grounds that it does not disclose a cause of action and is barred by law. The argument put forth is that the assignment agreements relied upon by the Plaintiffs do not confer ownership of copyrights on the impugned works as they are void under the Indian Contract Act, 1872. The Plaintiff was required to pay royalty and other consideration to the authors in exchange for the exclusive right to publish and distribute the articles, failing which the agreements are invalid. Ms. Elbakyan also argues that the assignment agreements relied upon by the Plaintiffs are irrelevant as they pertain to publication of books and not articles, for which the suit is filed against Ms. Elbakyan. However, Ms. Elbakyan, in her written statement, had admitted that the Plaintiffs are owners of copyright in the subject works.

The Court notes that Order VII Rule 11 of CPC helps in streamlining the judicial process by reducing the burden on the courts, as it permits weeding out of cases that are not worthy of its attention. However, it is well-settled legal proposition that while deciding the application under Order VII Rule 11 of CPC, only averments made in the plaint are germane and contrary pleas taken by Defendant(s) on merits are immaterial. The case as set out in the plaint discloses the cause of action and therefore the ground for seeking rejection of the plaint has no merit.

The Court also notes that the admission of Ms. Elbakyan qua copyright in favour of Plaintiffs makes the legal question urged in the application, founded on the construction of the agreements, no longer a pure question of

law. The dispute relating to the validity of such agreements regarding adequacy or sufficiency of economic/monetary consideration itself is a question of fact and plea advanced in the instant application, founded on provisions of Copyright Act, which would require adjudication on facts.

Therefore, the Court dismisses the application by Ms. Elbakyan invoking Order VII Rule 11 of CPC for rejection of the plaint. The case will proceed to trial where the legality, veracity and relevancy of such agreements cannot be undertaken at this stage.

Maheshbhai @ Kanbhai Haribhai Sojitra vs. State Of Gujarat

Forum: High Court of Gujarat

Case No.: CR.M.A.8581/2022

Order dated: 14th September 2022

Issue: Whether the impugned FIR filed by Respondent no. 2, alleging infringement of copyright by the applicant, is a sheer abuse of process of law and

Whether the ingredients of Section 51 of the Copyright Act, 1957 are prima facie satisfied in this case.

Order: The Applicant had filed an application seeking relief against the impugned FIR filed by Respondent no.2 for alleged infringement of copyright. The learned counsel for the Applicant submits that the impugned FIR is an abuse of process of law and is filed with a view to oust the Applicant from the business. He relies on the certificates of registration of copyright issued by the Registrars of Copyright to substantiate his contentions. The learned counsel further submits that the Applicant cannot be said to have committed any infringement as they have certificates issued by the Registrar of Copyright. The learned counsel for the respondent opposes the application and relies on various sections of the Copyright Act, coupled with judgments of various High Courts and Supreme Court.

After hearing the respective parties, the Court observed that prima facie, the ingredients of Section 51 of the Copyright Act are not satisfied as the Applicant is a holder of a certificate issued by the Registrar of Copyright. Further, the invocation of Section 64 of the Copyright Act by the police in the impugned FIR is a non-application of mind as it is not an offence, but a power envisaged to the police or Investigating Officer to seize the material if any infringement is found. Therefore, the Court grants interim relief and makes the rule returnable on a later date. The Applicant seeks permission to withdraw the application as having become infructuous, which is granted, and the application stands disposed of as withdrawn.

Indian Performing Right Society Limited vs. Rajasthan Patrika Pvt. Ltd.

Indian Performing Right Society Limited vs. Music Broadcast Limited

Forum: High Court of Bombay

Case No.: IA (L) No. 9452/2022, COMIP 193/2022, IA 1213/2022 and COMIP 84/2022

Order Dated: 28th April 2023

Issues:

1. Whether the amendments of 2012 to the Copyright Act create a substantive right of the authors of underlying literary and musical work?
2. Whether private broadcasters are liable to pay royalties to the authors of such underlying literary and musical work?

Order: Defendant Music Broadcast Private Limited operates the radio station 'Radio City' and had entered into a license agreement with the IPRS in 2001 to use its collection of literary and musical works to broadcast them on FM radio. The other defendant Rajasthan Patrika Pvt. Ltd. also operates a radio station 'Radio Tadka' and had entered into a similar agreement with the IPRS. In 2010, the Copyright Board laid down compulsory license fees

for radio broadcasting under Section 31(1)(b) of the Copyright Act. The said arrangement expired in 2020, and the erstwhile IPAB fixed royalty rates for such copyrighted works, as well as the underlying works in such sound recordings.

A separate case was filed by Entertainment Network India Ltd. with the Delhi High Court to review the statutory license rates under Section 31D and seek an order of status quo. The court clarified that despite pending an appeal against the IPAB order, the Respondents, Phonographic Performance Limited India, and others were entitled to receive royalties and employ necessary remedies upon failure.

The IPRS filed the applications for an interim injunction, arguing that the Amendment of 2012 to the Copyright Act brought changes to the rights relating to underlying works of the authors in a copyrighted work. Contrarily, the defendants argued that no new substantive rights could be granted by such an amendment since it did not affect Sections 13 and 14 of the Act, and merely clarified the nature of such rights.

While deciding the matter in question, the court stated that “it becomes clear that when sections 13 and 14 of the Copyright Act use the words ‘subject to the provisions of this Act’ the reference is to all the provisions of the Copyright Act, including sections 17, 18, 19 and others”. It further held that whenever the words ‘subject to’ are used, the expression makes the provision compliant with other provisions of the statute as well.

The Bombay High Court relied on *Indian Performing Right Society Ltd. v. Eastern Indian Motion Pictures Assn.*, (1977) 2 SCC 820, the Statement of Object and Reasons of the 2012 Copyright Amending Act and the Parliamentary Standing Committee Report on the Amendment while identifying the additional rights of the authors of underlying works.

Upholding the claims of the IPRS, the court believed that the ownership rights held by the composers and authors of lyrical and musical composition were significantly affected by the amendments of 2012 to the Copyright Act. The court observed that such amendments create a substantive right of the authors of underlying literary and musical work, and if any broadcaster

utilises sound recordings and communicates them to the public without paying the requisite royalties, it would be an act of infringement of the author's right in such works.

The court noted that the use of such literary and musical work in any form other than in a cinema hall entitles the authors or composers to receive royalties. The court ordered such broadcasters to pay the necessary royalties to the IPRS within six weeks, as per the 2020 decision of the Intellectual Property Appellate Board. Any shortcomings in payment of such royalties would invite an interim injunction against any form of broadcasting of such musical work.

Adv. Anoop V.R vs. Union of India, Ministry of Information and Broadcasting, Central Board of Film Certification (CBFC) and Ors.

Forum: High Court of Delhi
WP(C) NO. 15036 OF 2023(S)
Order Dated: 5th May 2023

Issue: Should release and circulation of teaser and trailer of the movie 'The Kerala Story' be suspended which is based on unverified and incorrect facts and if this movie can disturb public order, decency, and morality, particularly women and particular religious community?

Order: The Court reviewed the trailer and found nothing offensive to any community as a whole. That the competent statutory body, Central Board of Film Certification must have examined the movie, found the same to be suitable for public exhibition (that film is sensitive to values and standards of society) and the film has been certified. Moreso, the producer has undertaken to remove teasers from social media handles and has also published a disclaimer along with the movie – the film has been fictionalised and is a dramatized version of events and accuracy of historic events has not been claimed. Thus, this film does not require to be restrained

from exhibiting to the public and no interim order for staying the release of the film was passed.

Red Chillies Entertainment Pvt. Ltd. vs. Ashok Kumar/John Doe and Others

Forum: High Court of Delhi

Case No.: CS(COMM) 240/2023

Order Dated: 25th April 2023

Issue: Whether the use of clips from the Plaintiff's film by internet platforms and service providers amounted to copyright infringement?

Order: The Plaintiff filed a dynamic injunction suit against rogue websites and internet service providers broadcasting clips from its film 'Jawan' as no entity was provided with any license to broadcast or transmit any part of the said film. The Plaintiff argued that several websites across the internet was hosting and displaying clips from its film without any licensed authorization. The Plaintiff while arguing placed reliance on cases decided by the Hon'ble Delhi High Court viz. *UTV Communication Ltd. v. 137x.To* wherein the Court had passed a restraining order against rogue websites from participating in indulging in screening and making available without any authorization the broadcast of copyrighted works.

The Court observed that the Plaintiff had not licensed the transmission or distribution or broadcasting of its film to any entity and was therefore entitled to injunctive relief as the Plaintiff was able to show balance of convenience, irreparable loss and prove a *prima facie* case at the stage of filing the plaint. The Court also directed that the Plaintiff's plaint be registered as a suit and that summons be issued and served on the Defendants too and further directed the parties to file their respective replies. The Court in passing interim directions held that the Defendants be restrained from copying, recording, reproducing, allowing recording, transmitting, communicating or making available for distribution, duplication, display or release, exhibiting or playing in any manner, any stills, audio/video clips, songs, recordings or other proprietary information

relating to the cinematographic film “Jawan” or any part thereof without a proper license from the Plaintiff, through any medium whatsoever. The Court also directed the Defendants to block and take down all infringing content (i.e., URLs) provided in the schedule and documents filed with plaint as well as directed that any mirror/alphanumeric/redirect websites also be immediately blocked. The Court categorically mentioned that all the above directions be complied with within a period of one week.

Sony Music Entertainment India Pvt Ltd and Ors vs. Yt1s.Com and Ors

Forum: High Court of Delhi
Case No.: CS(COMM) 13/2023
Order Dated: 12th January 2023

Issue: Whether providing copyrighted content hosted on various platforms by the Defendants amounted to stream ripping and copyright infringement?

Order: The Plaintiff has filed the suit for copyright infringement against the Defendants which engaged in providing copyrighted content on various platforms, namely, YouTube, wherein content can be downloaded in MP3 or MP4 format by copying the YouTube link in the space provided on the rogue websites. The Plaintiff placed reliance on the case of *UTV Software Communication Ltd. v. 1337X.TO* to enumerate the criteria required for websites such as the Defendants to be categorized as ‘rogue websites.’ The Plaintiff also argued that the acts committed by the Defendant’s websites amounted to stream ripping. It was further contended that the WHOIS details of the Defendant’s websites were masked which made it impossible to pursue such websites through separate proceedings for copyright infringement and to prohibit and block access to such websites in India. In addition to seeking blocking of Defendant Nos. 1 to 18 websites, the Plaintiff also prayed for permanent injunction against any other mirror/redirect/alphanumeric websites, or any other website associated with the said Defendants. The Plaintiff also filed applications seeking (i)

exemption from filing pre-suit mediation as required by Section 12A of the Commercial Courts Act as the identity of the contesting defendants were unknown; (ii) exemption from serving the Defendants who are governmental authorities as required under Section 80 of the Code of Civil Procedure, 1908; (iii) exemption from filing separate suits against the Defendants.

The Court at the outset maintained that a *prima facie* case was made out in favour of the Plaintiff that justified grant of interlocutory injunctive relief and directed that the plaint be registered as a suit and that summons be issued to all Defendants arrayed in the suit. The Court also direct that the parties file their respective responses within timelines provided in the order. Further, the Court permitted exemption from the requirement of pre-institution mediation considering the unknown identity of the Defendants and placed reliance on the case of *Chandra Kishore Chaurasia v. R.A. Perfumery Works Private Ltd.* in doing so. The Court further granted exemption to the Plaintiffs from Section 80 of the Code of Civil Procedure, 1908 and filing separate suits against the Defendants.

Accordingly, the Court granted the following interlocutory order whereby Defendant Nos. 1 to 18 as well as any mirror websites be restrained from hosting, reproducing, distributing, facilitating or making available to the public, works in which the plaintiffs hold copyright, or facilitating the downloading and dissemination of such works in any manner whatsoever and directed Defendant Nos. 19 to 27 to block access to the websites operated by Defendant Nos. 1 to 18 in India that are engaged in stream ripping and infringement of the Plaintiff's copyrighted work. The Court also specifically directed the governmental authorities i.e., Defendant Nos. 28 and 29 to issue notification calling upon internet service providers (ISPs) registered under the said Defendants to block access of websites, or any mirror websites operated by Defendant Nos. 1 to 18 and provided a timeline of one week for compliance of the directions. The Court also observed that the role of the Joint Registrar would not involve any exercise of an adjudicatory functions regarding infringement and only requires the learned Joint Registrar to facilitate the implementation of the order passed by this Court by ensuring that the website that is being blocked is in fact a mirror or alphanumeric *avatar* of the websites which already stand enjoined by

the previous order passed by this Court. Accordingly, the Court directed that in the event of a mirror/alphanumeric website of the Defendant Nos. 1 to 18 coming into existence, the Plaintiffs will be entitled to file an affidavit before the Joint Registrar who shall upon ensuring that website is indeed a mirror website, issue directions to the ISPs to disable such mirror websites.

Universal City Studios LLC & Ors. vs. Fzmovies.net & Ors.

Forum: High Court of Delhi
Case No.: CS (COMM) 202/2023
Order Dated: 11th April 2023

Issue: Whether Defendants by providing unauthorised access to original content and making it available for download, have infringed the copyright rights of the Plaintiff in their original content/work?

Order: In the present case, Plaintiffs 1 to 6, i.e., Universal City Studios LLC.; Warner Bros. Entertainment Inc.; Columbia Picture Industries, Inc.; Netflix Studios, LLC.; Paramount Pictures Corporation and Disney Enterprises, Inc. contended that the Defendants 1 to 40 were online locations which enabled the use of the Defendant's website services, without any authorisation or license from the Plaintiffs to view cinematograph films, motions pictures, television programs or other audio-visual content, on devices connected to the internet by either streaming or downloading. Moreover, the Defendant's websites allowed copies of these content to be downloaded onto the memory of their devices for watching further or enabling others to further copy the content, and contained a process called "linking" which enabled users to stream, copy and download. The Plaintiffs investigated, monitored, and gathered evidence in respect of the Defendant's websites which showed that the operators of the Defendant websites were using known "pirate branding" to signal to users that the Defendant websites were merely new iterations of sites that had been blocked earlier. It was further contended that despite the legal notice calling upon the concerned Defendants to cease from engaging in their infringing activities, they continue to infringe the rights in the Plaintiffs' original content. Therefore, the Plaintiffs submitted that the Defendants were liable

for infringement of the Plaintiffs' copyright works under Section 51(a)(ii), Section 51(b) and Section 51(a)(i) of the Act, for making a copy of the original content, including storing of it in any medium by electronic or other means and communicating the original content to the public the hosting, streaming, reproducing, distributing, making available to the public, and/or communicating to the public of the original content for streaming and downloading, or facilitating the same, without authorization of the Plaintiffs. The Plaintiffs also contended that the Defendant websites were anonymous in nature and the information provided in the public domain regarding the owners of the website is either incomplete, incorrect and/or protected behind a veil of secrecy.

In view of the same, relying on the judgment of *UTV Software Communication Ltd. & Anr. vs 1337x.to and Ors.*, the Hon'ble Court opined that a *prima facie* case was made out in favour of the Plaintiffs and irreparable harm would be caused to the Plaintiffs if an interim injunction is not passed. Therefore, the Hon'ble Court restrained the Defendants from, in any manner hosting, streaming, reproducing, distributing, making available to the public and/or communicating to the public, or facilitating the same, on their websites, through the internet in any manner whatsoever, any cinematograph work/content/programme/show in relation to which Plaintiffs have a copyright. The Court further directed the Internet Service Providers to ensure compliance with this order by blocking Defendants no. 1 to 40 websites, their URLs, and the respective IP addresses.

The Mathrubhumi Printing and Publishing Co. Ltd. vs. Hombale Films & Ors.

Forum: High Court of Kerala
Case No.: OP(C) NO. 2281 OF 2022
Order Dated: 23rd November 2022

Issue: Whether the Hon'ble High Court under its supervisory jurisdiction under Article 227 of the Constitution of India, set aside an ad-interim order for injunction passed by a court below?

Judgement: The first Respondent, a musical band named ‘Thaikudam Bridge’, had filed a suit against the Petitioner and Respondents 2 to 10, inter-alia, to declare that they were the original author and composer under the Copyright Act in the musical work and sound recording named ‘Navarasam’. The first Respondent also filed another suit for passing of an order of temporary injunction against the Petitioner and the other Respondents from exhibiting, releasing on Over the Top platforms, streaming, and/or in any manner communicating to the Public in and/or through their services; the Cinematographic Film – ‘Kantara’ with the synchronised song ‘Varaha Roopam’. The below Court restrained the Respondents in the application from using the music in ‘Varaha Roopam’ without the permission of the Petitioner as a music in the Kannada film ‘Kantara’. Thereafter, the Petitioner filed the present suit in front of the Hon’ble Court for setting aside the above order by the below court, by exercising its power under Article 227 of the Constitution.

The Court relied on several precedents of the Supreme Court which laid down the limits of the supervisory jurisdiction of the High Courts under Article 227. The Hon’ble Court, as per the precedents, laid down some broad principles which are to be followed by this Court while exercising its supervisory jurisdiction, which included that the power under Article 227 was to be exercised to keep the subordinate courts within the bounds of their authority; that the jurisdiction was to be exercised sparingly and in appropriate cases with care, caution and circumspection; otherwise, it will result in grave injustice; and that the jurisdiction was not to correct errors of law, fact, or just because another view is possible. Furthermore, it also laid down that the High Court shall not, at the drop of a hat, exercise its power of superintendence under Article 227 of the Constitution and interfere with the orders of tribunals or courts inferior to it and that is not to be practiced as a court of appeal.

Coming to the present case, the first Respondent had filed the suit on 28th October 2022. The court below passed the impugned order on the same day and posted the suit to 4th November 2022 for return of notice. Even before the Petitioner received the copy of the order, they rushed to this court and filed the first original petition raising manifold contentions, including the

lack of inherent, pecuniary and territorial jurisdiction of the court below, and sought to set aside the order under Article 227 of the Constitution of India. The Hon'ble Court noted that The Code of Civil Procedure has explicitly laid down the procedure and the timelines to be followed by the courts while dealing with applications under Order 39 of the Code and the hierarchy of Courts that needs to be approached for the redressal of the grievances of a litigant confronted with orders passed. Therefore, in view of the same, the Hon'ble Court opined that the supervisory jurisdiction of this Court is not to be exercised to inter-meddle with every ad-interim order passed by the subordinate courts. It further emphasized that the Court failed to understand why the Petitioner has directly approached this Court to vacate an ad-interim order by-passing the procedure established under law. It opined that it is up to the Petitioner to appear before the court below, file its counter statement/affidavit and raise all its contentions before the court below and that the Hon'ble Court is not persuaded to sit in appeal over the ad-interim order and examine its legality on the points urged before this Court under Article 227 of the Constitution of India, and dismissed the petitions raised.

Neetu Singh & Anr. vs. Telegram FZ LLC & Ors.

Forum: High Court of Delhi
Case No.: CS (COMM) 282/2020
Order Dated: 30th August 2022

Issue: Whether Telegram could be held liable for the unauthorized dissemination of copyrighted material through various channels on its platform?

Judgement: In the case Ms. Neetu Singh and K.D. Campus Pvt. Ltd. (coaching institute) filed a suit seeking permanent injunction restraining infringement of copyright, damages and other reliefs against Telegram for unauthorized dissemination of their copyrighted material through various channels on the platform. Despite receiving takedown notices, some channels continued to exist, and new ones were created daily on the said

platform. The plaintiffs filed an application seeking the identity of the persons who are disseminating the infringing materials on these channels which ought to be disclosed so that the Plaintiffs can avail of their remedies against the said persons.

The Counsel for Defendant argued that the existing arrangement directing Telegram to take down infringing channels is sufficient to protect the Plaintiffs' interests. They relied on the Personal Data Protection Act, 2012, of Singapore to argue that Telegram cannot disclose subscriber information to an Indian court, as the court must be based in Singapore. They also cited Rule 3(1)(d) and Rule 4 of the Information Technology Intermediary Guidelines and Digital Media Ethics, 2021, to support their argument. Finally, they argued that any disclosure of information by Telegram in breach of their contract with the channel creators would be contrary to law and could constitute an offence under Section 72A of the Information Technology Act, 2000.

The Counsel for the Plaintiff then submitted that Telegram is duty-bound to reveal the identities of individuals operating channels that infringe upon the Plaintiff's rights, pursuant to its Privacy Policy. Furthermore, they contended that relying on Singapore law would be inappropriate in the present case, as any competent court in India is empowered to issue directions concerning a mobile platform operating within the country.

The Delhi High Court ruled that the Telegram app stores its data on servers outside of India, it does not preclude the court's jurisdiction. The court recognized that copyrighted materials on Telegram channels violate the Copyright Act and stated that Telegram cannot evade the jurisdiction of Indian courts by virtue of its servers being in Singapore. The court also found Telegram's takedown policy insufficient and held that conventional concepts of territoriality cannot be strictly applied in the age of cloud computing.

Therefore, Telegram was directed to disclose the details of channels/devices used to disseminate infringing content, including mobile numbers, IP addresses, email addresses etc. The defendant's argument under Article 21 and Article 19(1)(a) of the Constitution which relates to the right to life and

personal liberty, and the right to freedom of speech and expression, respectively, was rejected by the court. The court noted that these rights cannot be invoked to evade liability for illegal actions. Telegram filed an affidavit on October 6th, 2022, affirming compliance with the court's order. The court directed that the disclosed data be treated as confidential and shared with the plaintiffs, and further authorized disclosure to governmental authorities and police, as required by law.

Star India (P) Ltd. vs. Aapkeajaanese. Net and Ors.

Forum: Delhi High Court

Case No.: CS(COMM) 510/2019

Order Dated: 31st August 2022

Issue: Whether the Defendant's website was infringing on Plaintiff's copyright by making Plaintiff's copyrighted content available without any authorization?

Order: Plaintiff is a well-known entertainment and media company in India and the owner of several television channels. The proprietor of the online platform HOTSTAR is Plaintiff No. 2, a fully owned subsidiary of Plaintiff No. 1. At www.hotstar.com, HOTSTAR provides online streaming services that may be accessed through web browsers and mobile applications.

The Plaintiff's claim that Defendant Nos. 1 to 67 (hereafter referred to as "Rogue Websites") illegally and without authorization distributed, broadcast, rebroadcast, transmitted, and streamed the Plaintiffs' original content. The claim of the Plaintiffs is that the Rogue Websites violate their copyright in the original works they produce, which is protected by the Act, as a result of the unauthorised transmission of their original content.

In the opinion of the Court, some of the factors to be considered for determining whether the website complained of is a FIOL/Rogue Website are:

- whether the website's primary purpose is to violate or facilitate the violation of intellectual property rights;
- the flagrancy of the violation or the facilitation of the violation;

- whether the registrant's information is obscured and no identifiable or tracable information about the registrant or the third party is available.
- Whether the website remains silent or does nothing after receiving copyright takedown notices
- the amount of traffic to or frequency of access to the website;
- any other pertinent information;
- whether the website offers guides or instructions to get beyond security measures or any court order that blocks access to the website due to or associated with copyright infringement.

The Court observed that proceedings in Cases Nos. 69 to 80 have been ex parte, and since none of the Defendants have filed written statements or their affidavit of admission/denial of Plaintiff's documents, the court is in the opinion that the Defendants have no real chance of successfully defending the claim of copyright infringement and have further chosen not to contest the said claim. The court observed that there is sufficient evidence to hold that the Defendants nos. 1 and 2 are guilty as charged.

Abhishek Kumar vs. Union of India Through Registrar Of Copyrights & Ors.

Forum: High Court of Delhi

Case No.: C.O.(COMM.IPD-CR) 1/2021 & I.As. 9070/2021, 9073/2021

Order Dated: 30th August 2022

Issue: Whether the cancellation of search certificate issued by the Trademark Registry in respect of an artistic work leads to cancellation of copyright registration issued in respect of the said artistic work on the basis of the said search certificate?

Order: The Petitioner filed a cancellation petition under Section 50 of the Copyright Act, 1957 (Act) seeking cancellation of copyright registration granted in favour of his brother, Respondent No.3 for the artistic work 'TURBO PLUS LABEL'. The Petitioner argued that it had filed its

trademark application for the mark 'TURBO' in class 4 for coolants which was pending before the Trademark Registry. It was later brought to the attention of the Petitioner that an incorrect affidavit had been filed in the TMR with his forged signatures for withdrawal of his trademark application, which he suspected to have been filed by his brother. The said affidavit stated incorrectly that the Petitioner had no intention to pursue the trademark application for the mark 'TURBO' and wanted to withdraw the same. The Petitioner immediately retracted the incorrect affidavit and filed a fresh affidavit on 27th September 2018 before the Trademark Registry. However, on 22nd January 2019, the Deputy Registrar of Trademarks passed a withdrawal order in respect of Petitioner's trademark application, which later the Petitioner contested by way of a review application and was successful thereby restoring the application of the Petitioner. Subsequently, the Petitioner filed a fresh application dated 21st February 2021 for registration of the device mark 'TURBO'. The Petitioner then learnt that Respondent No.3 had obtained copyright registration dated 2nd December 2019 for the same logo after obtaining a search certificate dated 20th September 2019 from the Trademark Registry. It was submitted by the Petitioner that his second application was pending on the date when the search certificate was granted by the TMR to Respondent No.3 and thus, the search certificate was wrongly issued and prayed for the cancellation of the copyright registration in favour of Respondent No. 3. During pendency of the present cancellation petition in the Court, these facts were brought to the Notice of the Registrar of Trademarks who cancelled the search certificate vide order dated 3rd August 2021.

At the outset, the Court observed that there is doubt surrounding the way the Petitioner's application stood withdrawn and brought its attention to the issue of how the copyright registration was granted in favour of Respondent No.3. It was observed that the mark 'TURBO' was applied for by the Petitioner sometime in December 2015 and the said pending application was incorrectly withdrawn and thereafter a fresh application was filed by the Petitioner. The Court perused Section 45 of the Act which provided for 'entries in register of copyright' which requires that a person who wishes to register an artistic work which could also be subject matter of a pending or

a registered trademark, such person has to obtain a NOC from the Trademark Registry and noted that Respondent No. 3 had applied for such a certificate and was granted the same. The Court opined on the Order dated 3rd August 2023 delivered by the Trademark Registry re-affirming that the grant of the NOC while the Petitioner's second application for the registration was pending was erroneous and contrary to the proviso as provided under Section 45 of the Act and that Respondent No.3 was not entitled to get the registration of copyright artistic work which is deceptively similar to the Petitioner's artistic work. Accordingly, the Court ordered that as the search certificate has been cancelled and the Petitioner's first application for the trademark has also been revived, the copyright registration in favour of Respondent No.3 can no longer stand. The Court categorically stated that obtaining an NOC under the proviso to Section 45 of the Act is compulsory in order to obtain registration of copyright and there appears to be some misconduct indulged into by Respondent No.3 hence the copyright registration is in favour of Respondent No.3 no longer deserves to be continued on the Register of Copyright and the same be accordingly rectified as under Section 50 of the Act.

Mohd Ershad Sole Proprietor EK Agencies vs. Registrar of Copyrights & Ors.

Forum: High Court of Delhi
Case No.: C.O. (COMM.IPD-CR) 17/2021
Order Dated: 7th September 2022

Issue: Whether the cancellation of search certificate issued by the Trademark Registry in respect of an artistic work leads to cancellation of copyright registration issued in respect of the said artistic work on the basis of the search certificate?

Order: The Petitioner filed a cancellation petition under Section 50 of the Copyright Act (Act) seeking rectification of the artistic work titled 'ASLI KESRI CHAI' registered by Respondent No. 3 dated 21st October 2019. The Plaintiff argued that it has been involved in the business of trading,

packing, marketing, and selling tea leaves since 1998 and has been continuously selling tea leaves using artistic work along with the trademark 'HIGHGRON' since 2015 as a word mark in class 30 in respect of tea. The Plaintiff contends that one of its products 'HIGHGRON KESARI CHAI' is sold in a distinctive yellow, green and red color packaging and the mark along with the artistic work is associated exclusively with the Plaintiff and its business, it was further submitted that the Petitioner had also secured copyright registration dated 27th February 2018 in respect of the said packaging. The Plaintiff further stated that after acquiring knowledge of Respondent No.3's copyright registration, they filed objections with the Registrar of Trademarks seeking withdrawal of search certificate issued to Respondent No.3 as under Section 45 of the Act. Thereafter, in addition to a cancellation order, the Trademark Registry refused the trademark application of Respondent No.3 on the ground that the mark applied for by Respondent No.3 consisted of artistic work identical/similar to earlier trademarks on record and there is a likelihood of confusion in the minds of the public vide order dated 23rd March 2021. The Plaintiff further submitted that as on date the NOC issued under Section 45 itself having been cancelled, the copyright registration cannot stand in favour of Respondent No.3. While Respondent No. 3 argued that they had sought review of the order dated 23rd March 2021 whereby the NOC was cancelled.

At the outset, the Court stated that as per the scheme of the Act that in order for any person to obtain copyright registration of an artistic work, which is being used or is capable of being used in respect of goods and services, the NOC is mandatorily to be obtained under the proviso of Section 45 of the Act. The Court opined that the purpose behind the said provision was to ensure that there is no conflict between labels, packaging, etc. registered or used by trademark owners and registrations granted under the Trademark Act, 1999 and that the registration of copyright of artistic works is founded on the basis of the NOC issued by the Trademark Registry. In arriving at the aforementioned observations, the Court placed reliance on the case of *Abhishek Kumar vs. Union of India Through Registrar of Copyrights & Ors.* which held that the copyright registration in favour of the Respondent can no longer stand once the search certificate has been cancelled and the Petitioner's application being revived and that obtaining an NOC under the

proviso to Section 45 of the Act is compulsory in order to obtain registration of copyright. The Court stated that in the present case a perusal of the copyright registration and the packaging used by both the parties are identical in nature and that Respondent No.3's label is a substantial imitation of the Petitioner's packaging. While arriving at a decision, the Court held that the two competing registrations, which are almost identical to each other, and hence cannot be sustained under the Act and reaffirmed the findings in the order delivered by the Trademark Registry dated 23rd March 2021. As per the aforesaid order, the Registry came to the conclusion that both the artistic labels the colouring of both the packaging is identical, the device of woman plucking tea leaves is identical, the manner of presentation of the words, logo and devices are also identical, the said findings were reaffirmed by the Court further maintaining since the search certificate issued in respect of Respondent No. 3's artistic work has been cancelled, Respondent No.3's copyright registration no longer has any legs to stand upon since its foundation has been revoked. The Court further submitted that if the review filed by Respondent No.3 against order dated 23rd March 2023 is adjudicated in favour of Respondent No.3, the parties shall accordingly be left to their legal remedies available in accordance with law and Respondent No.3 would be free to apply for copyright registration.

Anil G. Karkhanis vs. Kirloskar Press and Another

Forum: High Court of Bombay

Case No.: Commercial Miscellaneous Petition No.1 of 2022

Order Dated: 21st March 2023

Issue: Whether the Court can grant the Petitioner license under Section 32 of the Copyright Act, 1957 to translate a literary work without the authorization of the author?

Order: The Petitioner filed the petition before the Court to invoke Section 32 of the Copyright Act, 1957 (Act) and Rule 32 of the Copyright Rules, 2013 (Rules) for grant of licence to produce and publish a translation of a literary work titled "The Spirit's Pilgrimage" in Marathi language and a further direction to the Registrar of Copyrights to notify such grant of

licence in the Official Gazette and to post the same on the website of the office of the Registrar of Copyrights. The Petitioner on previous occasions had satisfied the Court that a case was made out for publication of appropriate notice as per Rule 33 of the aforementioned Rules and it was directed that such a notice would be published by Registrar of Copyrights and according to the Court vide its earlier order dated 11th October 2022 directed that such a notice be published in two newspapers i.e. Free Press Journal and Loksatta (Marathi). The Petitioner pleaded that an amendment also be made to the prayer clause to replace the words 'Rule 38' with 'Rule 32'. The Petitioner also submitted that the original publishers of the work (Orient Longmans Pvt. Ltd. (in India) and Longmans, Greens and Co. (Britain) have undergone restructuring and that the Pearsons Education group has taken over the Longman name globally and upon writing to the Orient Blackswan Pvt. Ltd., the Petitioner was informed that the group does not deal with autobiographies and is not connected to Longmans. Regarding the Pearsons Education group, the Petitioner no response was received from the same. The Petitioner further submitted that he has been reading Marathi books since childhood and has a large collection of Marathi literature and is an advocate with the financial capability to pay the royalties. The Petitioner also submitted that the retail price of the translated book will be around INR 450/- and specifically stated that he does not intend to publish more than 1000 paperback copies and considering that the prevailing rate of maximum royalty is 7.5% or 8% for most authors for paperbacks, he is willing to pay 8% royalty for the translated version making the total royalty payable at Rs. 36,000/- (8% X Rs. 450 per copies X 1000 copies).

At the outset, the Court observed that the aforesaid directions by the Court vide order dated 11th October 2022 were complied with and that no objection was raised by any person within the 120-day period wherein any third party could oppose the Petitioner's interest in the copyright of the work. The Court further also permitted the amendment of the prayer clause as pleaded by the Petitioner and observed that that the specific requirements for grant of a license for translation can be granted which according to the Court has been satisfied. The Court further perused the particulars and reference in the pleadings which detailed the year when the subject matter

work was first published, details of the publisher, proposed price of copy of the work to be translated and the number of copies of the translated work to be published as well as the undertaking by the Petitioner with respect to deposit fees for grant of such license. The Court also observed that the Petitioner was not able to find the author, nor her family members and other submissions put forward by the Petitioner. The Court also took note of the Petitioner's submission that the intention behind seeking the license to translate the work is the larger public interest involved and considering the diverse set of languages spoken in the country, the order will surely enable the widespread reach of the work among the Marathi speaking population. The Court accordingly allowed the Petitioner's prayer for translation of the literary work titled 'the Spirit's Pilgrimage' in Marathi granting him the license with the condition that the Petitioner undertakes to deposit the royalty in the Court which shall be payable to the right owner as and when directed by the Court.

Ten Events and Entertainment vs Novex Communications Private Limited

Forum: High Court of Delhi

Case No. CS(COMM) 74/2021

Order Dated: 12th May 2023

Issue: Whether the Defendant's communication issued to the Plaintiffs calling upon them to obtain a license or a no objection certificate from them for playing songs in wedding ceremonies in which they held copyright was justified under the law?

Judgement: The plaintiff, *Ten Events*, is an event management company that organizes private extravaganzas and wedding ceremonies in luxury hotels, for which they often hire DJs to play songs, the said plaintiff received calls from the Defendants wherein they were asked to obtain NOC/license from the latter. Considering the same, the Plaintiff filed the suit under Section 60 of the Copyright Act, 1957 (Act) maintaining the case of groundless threats of legal proceedings from the Defendants. The Plaintiff

argued that they were not under a legal obligation to obtain a license and placed reliance on Section 52(1)(za) of the Act, the explanation to the said section as well as a public notice issued in regard to the aforementioned section which stated that *“utilization of any sound recording...including a marriage procession and other social festivities associated... no license is required.”* The Defendants argued that firstly they held copyright in the songs and that the Plaintiffs did not meet Section 52(1)(za)’s explanation of wedding ceremonies as the songs played were for entertainment purposes and were not religious. It was also argued that music played for a wedding procession has distinct implications than music played for the social events that go along with it, and Plaintiff was only protesting the license fee for the latter.

Upon hearing the submissions of both parties, the Court arrived at the following conclusions firstly that the Plaintiff would not fall either within subclause (i) or (ii) of Section 51(a) of the Act and that the Plaintiff is not in control of the venue of where the activities take place, thus the Plaintiff cannot be copyright infringer under Section 51 of the Act. Further, it was held that only legal actions and threats of liability based on suspected copyright violations that have already been committed are covered by Section 60 of the Act. In the present case, as it was related to an act that had not yet been committed, Novex's i.e. (Defendants) threat of legal action against Marriott in the letter dated December 14, 2020, did not meet the requirements of Section 60 of the Act. The benefit of Section 60 is only extended to a person against whom an infringement suit would be instituted by the copyright holder under the said Section, thus the Court held that the Plaintiff cannot be regarded as a person aggrieved within the meaning of the said section of the Act and therefore are not entitled to institute the suit against the Defendants. The Court also maintained that the Claimant/Plaintiff herein was to satisfy the following to claim exemption from liability under Section 52(1)(za), i.e., “the festivity in question is a social festivity; the festivity is associated with the marriage; and the festivity is bona fide.” It was also observed by the Court that a Division Bench of a

Constitutional Court held that the exemption granted by the various clauses of Section 52(1), including clause (za) and the Explanation thereto, are not intended to apply to commercial festivities or ceremonies but cater to non-profit activities. Considering the aforesaid, the Court opined that it might not be able to ignore the fact that religious services and wedding processions are both non-profit activities without any overtly commercial elements. If, therefore, a copyrighted recording is played on either of these occasions, it is not motivated by consideration of profit, and the communication according to the public is not for any commercial purpose. A strong qualitative difference exists between this situation and one in which DJs frequently play copyrighted recordings of popular Bollywood tunes for hefty fees. In such cases, it is obvious that the DJ's objective for playing the records is commercial. Thus, it may be debatable and difficult to settle whether commercial use of copyrighted recordings in lavish wedding celebrations would qualify for the benefit of the Explanation to Section 52(1)(za) by treating them as "social festivities associated with marriage" given the nature of "bona fide religious ceremonies" and "marriage processions".

The Court also observed that what the Plaintiff was seeking through the lawsuit is an advance ruling that would allow the Plaintiff to organize wedding ceremonies, regardless of their nature, at any location and for all time, with the public hearing of recordings over which Defendants(1 to 3) hold copyright, without needing permission from any of the aforementioned Defendants and that the main justification for this request for an advance judgement is Section 52(1)(za) of the Act, coupled with the Explanation thereto. The Court maintained that no law can permit such an advance ruling to be sought, moreover, the suit did not disclose the places/events, the Plaintiff proposed to hold and that there is no prayer in the plaint wherein it is prayed that the Plaintiff be permitted to conduct any particular identified wedding ceremony, in any of the impleaded hotels, without obtaining a license from Defendants 1 to 3. Thus, as Plaintiff sought an omnibus advance ruling, qua any and every wedding ceremony to be held in any and

every venue in the country, the relief sought as under Section 52(1)(za) of the Act was not granted by the Court.

RDB and Co. HUF vs. Harpercollins Publishers India Private Limited

Forum: High Court of Delhi

Case No.: CS (COMM) 246/2021

Order Dated: 23rd May 2023

Issues:

- Who owns the copyright in the screenplay of a film, if the author has been commissioned by the producer of the film to write the screenplay?
- Is it the producer of the film, or the author of the screenplay?

Order:

Satyajit Ray was commissioned by R.D. Bansal who was the Karta of the Hindu Undivided Family i.e., the plaintiff, for the purpose of writing the screenplay as well as directing the film Nayak and he solely completed this task assigned to him. After the passing away of Satyajit Ray on 23rd April 1992, Bhaskar Chattopadhyay novelized the screenplay of Nayak and the same was published by defendant and released on 5th May 2018. To seek injunction against defendant, the plaintiff approached the Delhi High Court within the scope of Section 51 of the Copyright Act, 1957.

The Plaintiff contented that they should be the owner of the copyright of the film Nayak because the contract between him and Satyajit Ray was of mere providence of service, which does not entitle copyright of such screenplay to Satyajit Ray. The Plaintiff further stated that all the monetary expenses related to the screenplay of Nayak including costs incurred in writing and direction was borne by them. Plaintiff also based his contention on the

decision in the case of Ramesh Sippy, in which the court held that the producer in the scenario of cinematograph film would be considered as the author, and hence, also the first owner of the copyright of such screenplay.

The Defendant contended that the Plaintiff has no copyright over the screenplay of Nayak, and the same has been vested with Sandip Ray after the death of his father (Satyajit Ray). The publication done by them would not amount to any infringement as they have taken permission from Sandip Ray and Society for Preservation of Satyajit Ray Archives (“SPSRA”).

The High Court of Delhi held that the ownership of the copyright would be with Sandip Ray (since the death of Satyajit Ray) and not with the producer/plaintiff because according to section 13(1) of the Copyright Act, 1957, the copyright held in a cinematographic film shall not affect the separate copyright in any work, in respect of which, or in respect of a substantial part of which, the film is made. The court also explained in detail the scope of literary work mentioned in Section 2(o) and considered the screenplay Nayak as a literary work for the purpose of section 13(1). On this basis, the court stated that according to Section 17, the first owner of the copyright should be the author which would be Satyajit Ray in the present case. The court opined that there can be no copyright ‘de hors’ (outside the scope) of the copyright and hence the contention of monetary expenses borne by the Plaintiff would not be of any use and hence, the plaintiff has no right to seek injunction against the defendant.

The publication done by the defendant would not amount to infringement because as per Section 18(1) of the Copyright Act 1957, only the copyright owner can assign the right to someone else wholly or partially to anyone. It was concluded the owner in the present case would be Sandip Ray, and permission was taken from him before novelizing of the screenplay of Nayak and publication of the same by the defendant. Therefore, the same would not amount to infringement of the rights of the copyright owner.

Sony Animation Inc. v. FLIXHD.CC and Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 366/2023, I.A. 10681/2023

Order Dated: 29th May 2023

Issue:

- Whether the plaintiff is eligible for grant of interlocutory injunctive relief under Order 39 Rules 1 and 2 against the defendant websites, characterized as “rouge websites” from streaming “Spider-Man: Across the Spider-Verse”?

Order:

The plaintiff being the copyright holder in the cinematographic films, “Spider-Man: Across the Spider-Verse” and its prequel “Spider-Man: Into the Spider-Verse” (“**the films**”), was aggrieved by the fact that the films were available for viewing on various websites characterized as “rouge websites”. The plaintiff has not licensed the right to broadcast or communicate, to the public, the films to any other authorities/websites, except its own and pursuant to the same, filed the present plaint seeking permanent injunction restraining the said defendant websites as well as any mirror/redirect/alphanumeric website associated with them, as well as all others acting on their behalf, from posting, streaming, distributing or making available to the public, the films in addition to seeking issues of directions to the defendant internet service providers and Department of Telecommunications (“**DoT**”) and the Ministry of Electronics and Information Technology (“**MEITY**”) to block access to these defendant websites. The plaintiff submitted that the defendant websites fit the description of “rouge websites” as laid down by this Court in its judgment in *UTV Software Communication Ltd. v. 1337X*. and that similar orders have been passed by this court in such cases. The court accepted the merits of the plaintiff’s contentions, *prima facie* and allowed the plaint to be registered as a suit.

Further, in an application filed by the plaintiff under Order 39 Rules 1 and 2 seeking interlocutory injunctive relief, the court held that the facts indicated that the plaintiff's copyright in the films have/are in the process of being infringed and violated by the defendant websites and found that *prima facie*, the defendant websites qualified as “rouge websites”, entitling the plaintiff to *ex-parte* interim relief in the matter. The court, therefore, ordered that the defendant websites as well as all others acting on their behalf, are restrained from posting, streaming, reproducing, distributing, or making available to the public, on their websites, or through the internet, in any manner whatsoever, any cinematograph work/content/program in which the plaintiff has copyright, including the films. The court also ordered the internet service providers to block access to the defendant websites, as well as any mirror/redirect/alphanumeric websites which appear to be associated with any of them and directed DoT and MEITY to issue a notification calling on all internet and telecom service providers to block the access to the defendant websites.

M/S Mangalore New Sultan Beedi vs State of Karnataka

Forum: High Court of Karnataka

Case Number: WP No. 10870 of 2023

Order Dated: 31st May 2023

Issue:

- Whether the police can withhold or delay the investigation of a criminal complaint due to the pendency of a civil suit.

Order:

The petitioner, a beedi-making partnership firm, filed a writ petition seeking directions to the police to conduct a speedy and fair investigation in a case of copyright infringement. The argument of the petitioner was based on the contention that Section 63 of the Copyright Act, 1957 provides for both civil remedies and criminal prosecution for copyright infringement and the jurisdictional police should conduct investigation promptly, without delaying the matter due to an ongoing civil suit.

The respondents argued that the police must refrain from interfering in civil disputes and cites previous court decisions supporting this argument. It was further stated that unless the law prohibits a particular action, the police do not have the authority to keep a complaint pending solely because the parties concerned are involved in a civil proceeding.

The court, based on the arguments, broadly agreed with the writ petition. The writ of mandamus was issued to the respondent to undertake and complete the investigation of the subject offense within a maximum period of three months.

Shemaroo Entertainment Ltd. Vs. Super Cassettes Industries Pvt. Ltd. & Ors.

Forum: High Court of Bombay
Case No.: Commercial IP Suit No. 297 of 2022
Order Dated: 5th June 2023

Issues:

- Whether the plaintiff substantiated its submissions of claiming that only audio rights of the suit films are assigned in favour of defendant no. 1?
- Whether temporary injunction can be granted to the plaintiff against defendant no. 1 based on the plaintiff's submissions and averments?
- Whether the defendant has substantiated its claims of owning the copyright of audio-visuals of the songs and whether such action of the defendant amounts to infringement of copyright or not?

Order:

The plaintiff filed a suit claiming copyright in 24 cinematographic films, including the audio-visual songs based on agreements executed in its favour by various entities. The plaintiff alleged that defendant No. 1 illegally published audio-visuals of songs from the suit films on various channels, like the YouTube platform of defendant no. 3 without permission or license

from the plaintiff. On the other hand, the defendant claimed limited rights to the audio-visuals of songs in the said films stating that the original producers did not object to such use by the defendant.

The court found that the plaintiff was unable to establish a prima facie case in their favour regarding copyright infringement. The court additionally determined that the plaintiff's assertion that only the audio rights of the films in question were assigned to defendant No. 1 lacked merit. Consequently, the plaintiff did not have the right to obtain a temporary injunction against defendant No. 1.

The court also ruled that the plaintiff's claim that only the audio rights of the films in question were assigned to defendant No. 1 was not justified. The court pointed out that the assignment deed for the cinematograph film "Amba" and "the said work" mentioned refuted such a claim by the plaintiff. Additionally, the court observed that defendant No. 1 had provided evidence of long-term exploitation of the audio-visuals of the songs in the films, and none of the original producers or owners of the films had raised any objections against defendant No. 1.

The Court also emphasised the delay by the plaintiff in initiating an action against the defendant, as the first 'Cease and Desist' notice was issued to the defendant in 2019 and the present suit was filed in 2022, when the defendant was using the audio-visuals of songs of suit films since 2012. As a result, the court determined that the plaintiff did not successfully present sufficient evidence to support their request for an interim injunction order and consequently rejected the application.

Aarur Tamilnadan v. S. Sankar and Anr.

Forum: High Court of Madras

Case No.: C.S. No. 914 of 2010

Date: 15th June 2023

Issues:

- Whether the plaintiff is the author and first owner of the copyright of the story "Enthiran", which was stolen from the original story?

- Whether the film “Enthiran” is the infringed story of the plaintiff’s “Jugiba”?

Order:

The plaintiff, a Tamil writer, claimed that he had written a story about a Humanoid Robot “Jugiba” (“magazine story”), published in a Tamil monthly magazine “Iniya Udayam” during April 1996 issue. The same publishers published the same magazine story of the plaintiff in the book titled “Thik Thik Theepika” in 2007, which was sold in book stalls and exhibitions. The first defendant in his capacity as a story writer and director made a film “Enthiran” in Tamil and other languages, produced by defendants 2 and 3.

The plaintiff claimed that the story of the film is the same magazine story written by the plaintiff and published in the year 1996. Further, the plaintiff averred that though the magazine story was published in the monthly magazine “Iniya Udayam”, per an understanding between the publisher and the plaintiff, the plaintiff is the first owner of the copyright in the magazine story. The plaintiff ultimately claimed that the magazine story is pirated in the film and that the defendants, never having obtained permission from the plaintiff, have illegally stolen the magazine story and have made the mega film “Enthiran”. The defendants made huge profits from the film and therefore, it is the plaintiff’s claim that he is entitled to claim damages.

In response to the plaintiff’s claim, the first defendant averred that the story of Humanoid Robots is several decades old, and expressly denied that the film is a pirated version of the magazine story. The first defendant claimed that the story line of the film is different and that the basic knowledge about the Humanoid Robot is one and the same and many movies in the past have been made on the concept meaning that there is no justification for the plaintiff to file the present suit. The first defendant then pointed out dissimilarities between the two works. Further, it was claimed that there

cannot be copyright in an idea, subject matter, themes, plots, or historical legendary facts. The claim of the first defendant is that the film is an original work of the first defendant, and he has got first right of ownership over the copyright.

Defendants 2 and 3 averred that the story of the defendants was presented and treated differently from that of the alleged story of the plaintiff and therefore, there cannot be a question of violation of copyright. It was further claimed that the plaintiff has come up with this suit because of the huge success of the film, therefore, the intention of the plaintiff is only unjust enrichment. Therefore, it was the defendants claim that the suit should be dismissed.

Further, the defendants claimed that the plaintiff failed to plead the story line of the defendants' film and produce any material evidence to show that the story line of the defendants' film is an infringing copy of plaintiff's magazine story. They further argued that the plaintiff failed to examine any person who had read the magazine story of the plaintiff and viewed the film of the defendants to prove that the story line of the defendants' film is based on the plaintiff's magazine story.

The Court noted that, a close reading of the evidence given by the plaintiff made it clear that there are several dissimilarities between his magazine story and the story of defendants' film. The plaintiff himself admitted during evidence that the defendants have made additions to his magazine story to suit the cinema audience. The Court noted that it is settled law, that nobody can claim any copyright over an idea or concept and copyright can be claimed only in respect of the manner of expression of idea or concept. In this regard, the Court referred to the observations of the Apex Court in ***R.G. Anand v. Delux Films***.

The Court noted that when both the stories are based on the same idea namely Humanoid robot falling in love with a human being, similarities, are

bound to occur and further, that the plaintiff has not examined any independent witnesses to prove that the similarities in the magazine story of the plaintiff and the story of the film are so fundamental to make it as a literal imitation of magazine story. Further, the plaintiff has not made any such attempt to enable the Court to compare the story line and has also failed to examine any independent witnesses to prove that the story line of the defendants is literal imitation of plaintiff's magazine story.

In lieu of these holdings, the Court moved on the issues against the plaintiff and held that the plaintiff is not entitled to any relief in the suit. The Court dismissed the suit and directed the plaintiff to pay the cost of the suit to the defendants.

The Raring Corporation and Anr. vs Neogie Engineering Works Pvt Ltd.

Forum: High Court of Calcutta

Case No.: IA NO- GA/1/2023EOS/4/2022

Order Dated: 20th June 2023

Issue:

- Whether the registered design "Sonic Nozzle" is purely functional and therefore not eligible for protection?

Order:

The petitioners are well-known manufacturers and suppliers of Dust Collection and Suppression Systems of different varieties. Petitioner no. 2 had entered into a collaboration with the petitioner no.1 to market and sell the petitioner no.1's Agglomerative Dust Suppression (ADS) systems in India.

The petitioners contended that the registered design in favour of the petitioner no.1 has been copied in all aspects by the respondent and is identical to the registered design of the petitioner no.1.

The respondent contended that the registered design in favour of the petitioner is functional and does not have any aesthetic pleasing appeal. It was further contended that the alleged design of the petitioner no. 1 is purely a mechanical device which is dictated solely by functionality. There is no aesthetic element involved in the registered design and the Designs Act, 2000 specifically excludes designs which are purely mechanical devices. It was also contended that the registered design is a published prior design.

It was observed by the Court that upon comparison, the impugned article had striking resemblance with the registered design of the petitioner no.1. A visual inspection prima facie shows that the respondent has copied all the primary features of the petitioner's article such as the shape, configuration, pattern etc., and bear a striking similarity to the registered design of the petitioner no.1. The court further opined that the respondent failed to present documentary evidence in furtherance of their objection with respect to the registered design being purely functional.

With regards to prior publication, no annexed documents demonstrate prior publication of the registered design. Most of the invoices relied upon by the respondents were filed after the date of the registered design, and the remaining invoices from the respondent's website pertained to different articles when compared to the registered design of the petitioner no. 1. Therefore, court held that the petitioners have been able to establish a strong prima facie case on merits. The balance of convenience and irreparable injury is also in favour of orders being passed as prayed.

Aathira Mannath A v. Lloyd Law College

CASE NO: OS.NO.4789/2023

Issue:

- Whether the defendants were liable for infringement of plaintiff's copyright in her literary work?

Judgment:

The plaintiff, Aathira Mannath A initiated legal proceedings by filing a lawsuit with the objective of obtaining a perpetual injunction against the defendants, (1) LLOYD College, (2) Anil Thakur, (3) Sherry Pant and (4) The editor- Journal of Survey in Fisheries sciences. The purpose of this injunction is to prohibit the defendants from engaging in any kind of infringement of the plaintiff's literary work, specifically titled "The Challenges of providing Humanitarian Assistance in Non-permissive Environments." Such infringement includes reproduction in print, internet dissemination, or any other means of communication. The plaintiff (law student in the college) asserts that defendant no. 2 and 3, who hold the position of Assistant Professors at defendant no. 1 institution, disseminated the plaintiff's literary creation in a scholarly periodical issued by defendant no. 4. The plaintiff submitted a range of evidentiary materials alongside the complaint in order to substantiate their assertions. These materials encompassed duplicates of brochures, regulations, email exchanges, certificates, photographs, and illicit publications procured from the website of defendant no. 4.

The plaintiff initiated a lawsuit by submitting a formal complaint with the aim of securing a permanent injunction against the defendants. The primary objective of this injunction was to restrict the defendants from partaking in any form of infringement pertaining to the plaintiff's literary creation, which is expressly identified as "The Challenges of providing Humanitarian Assistance in Non-permissive Environments." This form of infringement includes the replication of content in printed materials, dissemination through the internet, or any other form of communication. The plaintiff alleged that defendant no. 2 and 3, who are Assistant Professors at defendant

no. 1 school, distributed the plaintiff's literary work in an academic journal published by defendant no. 4. The plaintiff included a variety of evidentiary materials with the complaint to support their claims. The assortment of materials included replicated brochures, rules, email correspondences, certificates, images, and unauthorized publications obtained from the website associated with the fourth defendant.

With reference made to the ruling of the Supreme Court of India in AIR 2011 SCW 4000 (Rameshwari Devi and others V/s Nirmala Devi), it was recognized by the court that injunctions are only granted in exceptional circumstances. Furthermore, in the event that the lawsuit was ultimately dismissed, the plaintiff was required to provide complete restitution, bear the costs incurred, and account for any mesne profits. In accordance with this guiding principle, the court issued an order to prohibit the defendants and any individuals asserting rights through them from engaging in any acts that would constitute copyright infringement of the plaintiff's literary work titled "The Challenges of providing Humanitarian Assistance in Non-permissive Environments" or any of its constituent parts.

Nevertheless, the court imposed specific stipulations on the injunction, which encompassed a clear commitment from the plaintiff to reimburse the defendant for expenses and damages in the event of an unsuccessful lawsuit, adherence to procedural obligations, and refraining from distributing authorized copies of the order and summons until the plaintiff fulfils these conditions. The court has mandated the issuing of a temporary injunction, along with the notice of IA (interlocutory application) and suit summons, to be delivered to the defendants via registered post no later than August 31, 2023.

The court's ruling is anticipated to be grounded upon many tenets of intellectual property law, particularly those pertaining to copyright. Presented below is a concise overview of the pertinent concepts that the court may employ in order to render a decision in the matter at hand:

- **Assessment of Originality:** The court has the authority to evaluate whether the literary work in question satisfies the prerequisite of originality for the purpose of copyright protection.

- Idea- expression dichotomy- The concept of copyright law safeguards the particular manner in which ideas are articulated, rather than the ideas in se.
- Exclusive rights- This entails evaluating whether the defendants have participated in actions that are under the copyright holder's exclusive rights.
- Infringement, extent of infringement and substantial similarity.
- The doctrine of fair use- The court has the authority to evaluate whether the defendants' utilization of the plaintiff's work aligns with any exceptions pertaining to fair use or fair dealing.

The court issued an ex-parte provisional injunction in favour of the plaintiff, which prohibits the defendants from engaging in any actions that may violate the plaintiff's literary work, however, is yet to speak on the assessment of balance of convenience and irreparable injury to the plaintiff. The court has set specific restrictions on the injunction in order to guarantee that the plaintiff would provide compensation to the defendant for any costs and losses incurred in the event that the lawsuit is unsuccessful, as well as to ensure compliance with procedural obligations.

patent

protection

law

idea

property

document

right

copy

judgment

brand

concept

lawsuit

creative

holding

intelligence

commercial

business

exclusive

authority

formal

prosecution

license

right

think

author

patented

judiciary

se

page

crime

trademark

intellect

security

word

invention

vision

judicial

contract

piracy

copyrighted

free

juridic

intellectual

attorney

certification

agreement

infringement

legal

creativity

mark

information

ownership

legislation

finance

computer

internet

definition

conceptual

paper

awareness

Forum: High Court of Delhi
Case No.: CS (COMM) 156/2021 & I.A. 6539/2021
Order Dated: 25th March 2022

Order: The Plaintiff filed the suits seeking permanent injunction restraining the infringement of Indian Patent No. IN229051. The suit patent relates to

a pharmaceutical composition consisting of Valsartan or a pharmaceutically acceptable salt thereof, and Sacubitril or a pharmaceutically acceptable salt thereof, and a pharmaceutically acceptable carrier. The Plaintiff submitted that the product information literature of the product 'ZAYO' clearly showed that the product was manufactured by MSN Laboratories. The Defendants argued that the products being marketed by ERIS are supramolecular forms of the combination of Valsartan and Sacubitril, and the suit patent does not cover the same. Further, the status quo order was passed against the ERIS on 21st December 2020 and said order did not cover any products manufactured by Windlas. The order against Windlas was passed only on 26th March 2021.

The Court observed that the appearance of the name of MSN Laboratories Pvt Ltd in the product literature of Windlas, is inexplicable. The photographs of strips show that the products branded as ZAYO are marketed by ERIS, and the name of the manufacturer is shown as Windlas. The injunction qua ERIS has been operating since 21st December 2020. Thus, it is not clear as to how ERIS procured this huge quantity as of February 2021, and how it could have marketed the same. The Court considered that the suit patent is itself due to expire in January 2023, the medicines are for cardiovascular disease which may be needed by a large number of patients; and recall from distributors or retailers would be an extremely cumbersome exercise and may result in panic. Even if the exercise is undertaken, owing to the sheer number of distributors and chemists, directing recall is not a viable option. Therefore, the Court directed an interim injunction restraining all the Defendants from manufacturing, selling, offering for sale any pharmaceutical preparations which are a combination of Sacubitril and Valsartan, either in tablet form or any other form, either packaged as strips or in bottles/containers, and from infringing the Patent IN'051, in any manner whatsoever. In respect of the stocks, Eris Lifesciences Limited is directed to deposit a sum of Rs.5 crores.

Novartis Ag & Anr. vs. Natco Pharma Limited & Anr.

Forum: High Court of Delhi
Case No.: CS(COMM) 256/2021 & I.A. 6980/2021
Order Dated: 13th December 2021

Issue: Whether the defendant (NATCO) was infringing the patent IN 233161 of plaintiff 1 (Novartis) which protected the drug Eltrombopag Olamine marketed as “Revolade”? The court has explicitly provided the dichotomy between deference to the validity of a granted patent vis-a-vis the challenge to its validity and consequently disregarding the exclusivity granted to it, in litigation.

Order: The Plaintiff instituted a suit of infringement against Natco and also filed an application seeking interlocutory or interim injunction a suit seeking an interlocutory injunction against the perceived infringement, by the defendant, Natco Pharma Ltd, of the plaintiffs’ suit patent IN 233161 (in short, ‘IN 161’). To defend itself against the interim injunction application, Natco claimed a plea of invalidity of the EO patent under multiple subsections Section 64 read with other provisions. Section 107 of the Patent Act provides that in “any suit” of infringement, every ground on which the patent may be revoked (under Section 64) can be sought as a valid defence. Natco argued that the suit patent is covered under prior art IN 213176 (IN 176) which is a “compound and a pharmaceutical composition for use in enhancing platelet production.” The filing date for IN 176 is May 24, 2001 and thus its term expired in May 2021.

On basis of the above, Natco argued as follows:-

1. The suit patent i.e. EO was invalid on account of anticipation by prior claiming and publication under Section 64 (1)(a) and Section 64 (1) (e). For this, Natco did a claim to claim comparison of both IN 176 and IN 161 to establish that EO is a pharmaceutically accepted salt Eltrombopag (subject matter of IN 176). Natco specifically points out that a plain reading of Claim 6 of IN 176 which states “*a compound as claimed in claim 1 (Eltrombopag) and pharmaceutically acceptable salts, hydrates, solvates and esters thereof.*” To substantiate this, Natco argued that in parallel patent prosecution proceedings in the EU, US and Canada, the

Eltrombopag patentee (GSK or Novartis) claimed EO as a part of Eltrombopag patent.

2. Relying on Novartis v. UoI, Natco argued that coverage implies disclosure and there is no distinction between the two. Thus, once in other jurisdiction when it has been claimed that Eltrombopag covers EO, Novartis, in India, cannot argue that IN 176 does not disclose EO. Furthermore, it also relied on Section 11(2) of the Patent Act which states that when a claim is based on matter disclosed in a previous provisional/ other specification in lieu thereof, the priority date of the claim is the date of filing the relevant specification. Therefore, according to Natco, since EO was covered under the Eltrombopag patent (IN 176), Novartis cannot claim that it was not disclosed in the IN 176 specification.
3. Natco then argued that the EO patent is invalid owing to the Section 3(d) deformity. It argued that EO lacks an enhanced efficacy over Eltrombopag as enhanced bioavailability is not enhanced efficacy as held under Novartis v. UoI.
4. Natco then argued EO lacked an inventive step over Eltrombopeg patent and was obvious. It argued that EO was a monoethanolamine salt of known substance i.e. Eltrombopeg and IN 161 nowhere disclose how it was an inventive step or why it was not obvious from Eltrombopeg per se.
5. Natco then argued that by waiting for IN 176 to expire, it has 'cleared the way' for launching its own product and thus need not wait for expiry of EO's patent.
6. Owing to the price difference between the competing products of the parties, public interest expects the court to not pass an order for interim injunction.
7. Assertion by Novartis of genus patent IN 176 and specie patent IN 161, it has itself rendered the specie patent vulnerable to invalidity.

However, the court had a different opinion. It opined that Natco has a heavy burden of proof to establish the EO patent's invalidity and ruled that it was not able to relieve it on the basis of the above arguments. Thus, the court rejected Natco's plea of invalidity on the following grounds-

1. On anticipation by prior claiming and publication the court observed that the anticipation cannot be asserted by resorting to hindsight deduction. The court stated that Section (61)(a) will be applied when a claim whose validity is being challenged **is identical to the claim in prior art**. On this basis, it ruled that Natco cannot cherry pick substituents from cited prior art and substitute them at sites to arrive at suit patent. Furthermore, on Natco's reference to the Eltrombopag applications in EU, US and Canada patent offices, the court hesitated to rely on them at an interim stage and instead suggested a more detailed assessment of the merit in Natco's this argument in the course of the trial.
2. On disclosure- coverage dichotomy, the court relied on Merck v. Glenmark, and ruled that there is a difference between "broad coverage" of a claim and "protected coverage" i.e. the one which will be entitled to protection under the Act. The court reiterated that coverage encompassed by the claim, as worded, read with disclosure which would enable a person skilled in art would be entitled to protection under Section 48. On the basis of the above understanding it clarified that coverage is wider than disclosure. In the present case, the court held that though the broad coverage of the IN 176 claims would embrace EO, it refused to accept that EO is claimed in IN 176, as the wording of the relevant claims read with the enabling disclosure contained in the complete specifications, does not result in EO.
3. On application of Section 3(d) deformity in the present case, the court held that Natco's understanding of Novartis v. UoI to this regard is somewhat misplaced as the court therein had held that bioavailability can be an evidence of enhanced therapeutic efficacy given the patentee can establish the enhanced efficacy by evidence or research data. In the present case Novartis argued that, when combined with olamine, there is a much higher yield of Eltrombopag, insofar as bioavailability is concerned. Furthermore, the maximum plasma concentration of EO was thrice the plasma concentration of the Eltrombopag free acid, which, too, enhanced the therapeutic efficacy of EO vis-a-vis the Eltrombopag free acid. The court also highlighted that in Novartis v. UoI the case was different since in this case the applicability of Section 3(d) was

assessed from the standpoint of rejection of a patent application whereas in the present case the patent office has granted the suit patent to Novartis, presumed thorough study of the application.

4. On the obviousness argument, the court explained for obviousness to be established it has to be shown that a person skilled in art, in possession of complete specifications of the prior art would be able to arrive at the suit patent without detailed exercise or research. However, in the present case the court held that prima facie even after using the complete specifications of IN 176 it cannot be said that one can reach to IN 161.
5. On the argument that Natco has sufficiently “cleared the way” by waiting for IN 176 to expire, the court pointed out that Natco has waited for more than 12 years for raising the plea of invalidity. No pre or post grant opposition was filed by Natco nor any application for revocation was moved before the concerned authority by it in the past. It was only after the institution of the present suit, had Natco raised this plea. Therefore, the court ruled that in light of the above, it cannot be said that Natco has cleared the way sufficiently.
6. On the argument of asserting infringement of both IN 176 and IN 161, the court clarified that in Astrazeneca v. Intas, assertion of infringement of both genus and specie patent alone was not the sole reason for rejecting the application for interim injunction. In the present case, though Novartis had made a pleading of infringement of both the patent, during the argument it asserted infringement of IN 161 alone.

Astra Zeneca AB vs. Natco Pharma

Forum: High Court of Delhi

Case No.: I.A.12825/2021 (for Directions) in CS(COMM) 117/2020

Order Dated: 2nd February 2022

Issue: Whether or not the defendant should be released from extending the bank guarantee of Rs.3,00,00,000/-?

Order: The matter is related to the infringement of the patent IN 205147 and IN 235625 and counter invalidation proceedings thereof. The defendant submitted in the Court that the matter will take time to argue, and agreed to stop production or dealing with the impugned drug “DAPNAT” or any other drug which is in violation of the patent IN 205147 and IN 235625 till first October, 2020 as the genus patent IN 205147 expires on 02.10.2020. The defendant further submitted that products worth about Rs. 20 crores have been sold in the market by the defendant and it is not possible to recall the above products. The defendant further submitted that the defendant is willing to give a bank guarantee for a sum of Rs. 3 crores which would be encashable in case this court records a finding against the defendant/ on the issue of damages and mesne profits.

Thereafter, after expiry of the genus patent IN 205147 on 02.10.2020, the defendant stated that as the plaintiffs does not oppose the sale of the impugned products by the defendant, on 8th October, 2021, the defendant was relieved of its undertaking.

The court observed that the defendants had offered to give the aforesaid bank guarantee on account of the fact that the products worth Rs.20,00,00,000/- had already been sold in the market by the defendants and it was not possible to recall the said products. The fact that the defendants expressed their readiness and willingness to stop production or dealing with the impugned drug “DAPNAT” or any other drug which was in violation of patent IN 147 and IN 625 till 1st October, 2020, amounted to an implied acceptance of the fact that the drugs were sold in violation of IN 147. Further, the offer of furnishing a bank guarantee was made, in effect, to avoid an order of injunction against the defendant.

In view of the above, the court directed that the bank guarantee of Rs.3,00,00,000/-given by the defendants would continue till the final adjudication of the suit.

Koninklijke Phillips N.V. vs. VIVO Mobile Communications Co. Ltd.

Forum: High Court of Delhi

Case No.: Review Petition 24/2022 in CS (COMM) 383/2020

Order Dated: 15th February 2022

Issue: Whether to review the Court's order dated January 7, 2022 which allowed in-part the application related to production of license agreements, executed between defendants and chipset manufacturers, from Defendants for resolution of dispute related to infringement of SEP patents of Plaintiff

Order: The petitioners/defendants were gravely aggrieved by the directions issued by this Court to produce their third-party agreements, since the findings, on the basis of which, the directions have been issued, are contrary to the submissions made by both the parties and the facts on the record. The petitioners/defendants urged that there was enough material on the record to determine what patents are there on the chipset, when the respondent/plaintiff itself had claimed in the rejoinder that there was cogent evidence placed by it to show that the patent was in the handset, and further stated that it was an error to direct the production of the documents that were irrelevant.

The Court observed that the scope of a review is extremely limited, and the error that the petitioners/defendants are seeking to establish in the order, seems to require the court to delve into the materials, apply its mind afresh after re-evaluating the materials and further, decide the application being I.A. No.3048/2021 now in favour of the petitioner/defendant, by dismissing it.

Further, while referring to various judgements of Supreme Court in *Thungabhadra Industries Ltd. v. Govt. of A.P., (1964) 5 SCR 174* and

Kamlesh Verma v. Mayawati, (2013) 8 SCC 320, the Court dismissed the review petition. Specifically, the Court stated that the jurisdiction of review is not that of an appeal. An error which is not self-evident and has to be detected by a process of reasoning cannot be described as an error apparent on the face of the record, justifying the court exercising its power of review. Additionally, the Court stated that the petitioner, in a review, cannot seek the same relief which had been sought at the time of arguing of the main matter and which had been rejected.

Novartis AG and Another vs. Centurion Remedies Private Limited

Forum: High Court of Delhi

Case No.: I.A. 7321-22/2022 IN CS(COMM) 306/2022

Order Dated: 26th May 2022

Issue: Suit was filed for seeking permanent injunction restraining infringement of Indian Patent No. 229051, damages, rendition of accounts, delivery up etc.

Order: The Plaintiff (Novartis AG) has filed the suit for seeking permanent injunction of its granted patent 229051 titled “Pharmaceutical Compositions Comprising Valsartan and NEP Inhibitors”. This is in view of the directions issued by the Department of Pharmaceuticals, Ministry of Chemicals and Fertilizers (*hereinafter as ‘DOP’*) seeking details of local manufacturers available for various drugs including the composition covered in the granted patent. However, the said notification nowhere directs or compels anyone to infringe upon the rights of the patent holders as submitted by DOP. DOP further clarified that the said notification was not to be treated as directions by the Government under Section 100 of the Patents Act, 1970, or any other provision of the Patents Act.

Defendant has taken a stand that it has an export licence for exporting of the pharmaceutical preparation namely Sacubitril + Valsartan. The Public

Notice seems to have been wrongly interpreted by the Defendant as a form of Government Authorization to manufacture the patented drug.

On merits of the suit, the defendant submitted an undertaking that it has not manufactured or imported or traded or has not caused to manufacture or caused to import or caused to trade the pharmaceutical preparation namely SACUBITRIL+VALSARTAN, in any manner, either directly or indirectly and aware of the fact that the plaintiff is the exclusive proprietor/owner of the Indian Patent.

The Court directed that the Defendant shall not undertake or cause commercial manufacture, sale, use, export or import of any pharmaceutical preparations consisting of SACUBITRIL+ VALSARTAN, covered by the suit patent **IN- 229051**, till the expiration of the term of the suit patent i.e., 16 January 2023. Consequently, the suit was decreed in the above terms and all pending applications were also disposed of.

Sun Pharmaceutical Industries Ltd. vs. Union of India and Others

Forum: High Court of Delhi
Case No.: W.P.(C)-IPD 14/2022
Order Dated: 30th June 2022

Issue: To fix the hearing in post-grant opposition filed in IN257402, under Rule 62(1) of the Patent Rules, 2003 and adjudicate the same at the earliest, in accordance with the law.

Order: The petitioner submitted a patent application having the number 2771/DELNP/2006, which was granted on October 4, 2013, as IN257402. On September 29, 2014, Sun Pharma and USV filed two post-grant oppositions against Novo Nordisk's patent (IN257402) titled "Propylene Glycol-Containing Peptide Formulations."

In March 2015, the notice of opposition, the patentee's reply and evidence, and the opponents' response and evidence were primarily filed within the

prescribed timeframes. In spite of this, the patentee proceeded to submit additional evidence (from two additional experts) through the end of August 2015. At the end of December 2015, in response to provocation, the opponents offered testimony from a second expert. The patentee objected to this response on the grounds that it raised new issues and filed a second response. The adversary responded to this response. Responses, rejoinders, and expert testimony kept moving across the patent office until the end of 2016.

The patentee, who had previously submitted the testimony of at least three experts in 2019, filed the evidence from a fourth expert in 2019. Therefore, additional evidence was submitted in 2019 (five years after the opposition was lodged), after the Opposition Board issued its recommendation and a hearing date was set.

As per law, once pleadings are complete, the Opposition Board is required to provide its recommendations within three months of receipt of documents. The Opposition Board issued its recommendations only after three years in August 2019 and it was alleged by the Petitioner that the same was not in accordance with of Section 25(3) read with Rule 56(1) of the Act the recommendation. The second recommendation was issued after another three years i.e., in February 2022.

The court had directed the Patent Office to decide the case by September 30, 2022, and parties were directed not to file further evidence, documents, petitions etc.

The Court did not express any opinion on the merits of the case in the petitions and all rights and contentions of the parties were left open. Petitions was disposed of in the aforesaid terms along with the pending application.

Novo Nordisk AS vs. Union of India and Others

Forum: High Court of Delhi

Case No.: W.P.(C)-IPD 19/2022 and CM 68-69/2022

Order Dated: 5th July 2022

Issue:

Issue 1 – Whether report of the Opposition Board’s recommendation should be made available to the parties (Patentee and Opponent) and should the report mention names of all the board members?

Issue 2 – Whether an opponent can make a statement without evidence in a pleading relating to post-grant opposition?

Issue 3 – Whether parties can file further evidence after completion of post-grant opposition proceedings, including submission of opposition, patentee's reply, and opponent's rejoinder, and after the Opposition Board has provided its recommendation and the hearing has been fixed?

Issue 4 – Whether merely observing a representation and then scheduling a hearing date constitute a decision on the representation?

Order: Novo Nordisk was granted a patent in Oct, 2013. Sun Pharmaceuticals Industries Ltd and USV Private Ltd. filed independent post-grant oppositions against the patent within a year. The pleadings completed in 2015, however the parties continued to file affidavits (even after a Hearing was fixed), reply evidence, additional documents, and miscellaneous petitions, resulting in multiple delays. In the interim, the opponent withdrew 3 affidavits. Despite issuance of two recommendations by the Opposition Board, the final hearing in the post-grant opposition is yet to take place. The Patentee filed a representation seeking a revision of the Opposition Board's second recommendation. The Patent Office disposed the same and scheduled a hearing for the opposition. The Patentee argued *inter alia* that the decision is invalid as no actual decision was made on the representation, and that names of the members comprising the Opposition Board were still unknown to the Patentee.

The Court ruled that the recommendation of the Opposition Board should be made available to parties before the Controller passes orders, despite

there being no obligation to do so. The Court also directed the CGPDTM to ensure the names of the members of the Opposition Board are clearly mentioned on the recommendation to ensure transparency. Further, as per Rule 57, it is not mandatory for the Opponent to file evidence in support of their pleadings in the opposition. The Court also stated that post-grant oppositions are time-sensitive and must be disposed of in an expeditious manner within 12 to 18 months from filing the opposition. Rule 60 permits a party to seek leave for filing further evidence only before the hearing date is fixed. Post issuance of Hearing, as per Rule 62(4), a party can only rely on any publication (and not new affidavit) not filed earlier, provided five days' notice is given to the other party. Lastly, since the Deputy Controller's decision did not address the points raised by the Patentee in their representation, the points must be considered in the final hearing. The Court concluded that the parties are not allowed to submit any more documents or evidence in the case, and the final hearing must proceed on the scheduled date.

Chugai Seiyaku Kabushiki Kaisha and Another vs. Hetero Labs Limited and Another

Forum: High Court of Delhi

Case No.: CS (COMM) 515/2021 & I.As. 13467/2021, 13468/2021, 13469/2021, 13470/2021

Order dated: 13th July 2022

Issue: *Suit for seeking permanent injunction restraining infringement of Indian Patent No. 294424*

Order: The suit has been by filed by patentee “Chugai Pharmaceutical Co. Ltd.” and F. Hoffmann-La Roche AG (an exclusive licensee for the suit patent) for seeking permanent injunction restraining infringement of suit patent No. 294424 by Hetero Labs Limited and Hetero Drugs Limited. The suit patent claimed tetracyclic compound ‘*Alectinib*’, being commercially sold under the brand name Alecensa®. The suit is filed on the basis of an investigation, revealing that Hetero Labs had imported Alecensa/Alectinib Hydrochloride from Germany and had made an application for expansion of its facilities for manufacturing Alectinib Hydrochloride, as per the

Prefeasibility Report submitted before the State Level Environmental Impact Assessment Authority. Further, Hetero Drugs was also listed as a supplier of Alectinib Hydrochloride in one of the online business directories.

Hetero in response pleaded the alleged infringement on the basis of "Bolar" provision as set out in Section 107A of the Patents Act, 1970, which permit use of patented invention for purpose of research and to undertake developmental studies necessary for submissions to various regulatory authorities. Hetero also argued that presently, they do not have any license to commercially manufacture the drug and in case they decide to commercially manufacture and launch the said product, they will give four weeks' advance notice to the plaintiffs.

The Court taking statement of the defendants on record, that they were only using the drug in question for permitted purposes of research and obtaining required regulatory approvals, disposed the suit concluding that since the defendants have not made any commercial manufacture or launch, the prayers for damages or rendition of accounts are not made out. Although Court has directed the defendants that they shall not launch the product commercially in the market without prior permission of the court.

Novartis AG vs. Controller of Patents and Designs

Forum: High Court of Delhi

Case No. CA (COMM.IPD-PAT) 12/2022

Judgment dated 23rd August 2022

Issue: The Appellant assailed the Controller's order for refusal of its divisional application for a pharmaceutical compound for the treatment of dry eye disease. The Controller's main objection was that compound of divisional is already covered by the granted claims of the parent application. For plurality and divisional assessment, the Court was to consider twin criteria:

- (i) Whether the compound claimed in the divisional was disclosed in the complete specification of the parent and claimed in the complete specification of the parent?
- (ii) Whether the claimed compound in the divisional was granted in the parent?

Order: The Court found that the specific compound claimed in divisional was fully disclosed in the description of the specification and it was also among the claims as originally filed in the parent. Thus, the Court answered point (i) in affirmative. The Court observed that a **Markush** structure was disclosed in the parent specification and was also claimed originally, however, eventually it was **not in granted** claimed of the parent application. The Court further noticed that three **specific compounds** (definite permutations of the Markush) were **granted** in the parent. The Court established that the specific compound claimed in divisional (obtained from same Markush) was, however, structurally **different** from three specific compounds granted in parent. As the Markush claim was not granted in parent, the Court held that the compound claimed in the divisional was not covered by the granted claims of the parent application. Thus, the Court answered point (ii) in negative. As the **twin conditions** u/s 16 got satisfied, the Court upheld the validity of divisional and remanded the matter back to the Patent Office for reconsideration on merits.

Apart from the above, the Court also cautioned that the test of therapeutic efficacy u/s 3(d) would not be applicable while judging as to whether the compound claimed in the divisional application is a valid claim in a divisional application or not because the divisional application traces its origin to the parent application.

Bristol-Myers Squibb Holdings Ireland Unlimited Company and Others vs. Zee Laboratory

Forum: High Court of Delhi

Case No.: CS(COMM) 550/2021 and I.A. 6483/2022

Order Dated: 2nd November 2022

Issue: The suit has been filed in an effort to get permanent injunction restraining infringement in respect of the Plaintiffs' patent bearing Indian Patent No. IN 247381, related to a novel pharmaceutical preparation, name 'APIXABAN'.

Order: The patent no. IN 247381 was granted by the Patent Office on 4th April, 2011 and the term of the patent is till 17th September, 2022. The Plaintiffs' claim is that the Defendants manufactured generic Apixaban products available for purchase on third-party e-commerce websites and social media platforms under the trade names "APIXAZ" and "APIQUIS."

Vide order dated 8th November, 2021, an ad-interim injunction was granted prohibiting defendant from using, manufacturing, selling, distributing, advertising, exporting, importing, and offering for sale any products, including but not limited to the brand names "Apixaz" and "Apiquis" or any other brand name, that infringe the subject matter of Indian Patent No. 247381 and permanently delist and remove all advertisements/links relating to the infringing generic products 'Apixaz' and 'Apiquis' from any website.

Vide order dated 14th January, 2022, the matter was referred to mediation. However, mediation had failed.

Vide order dated 19th April, 2022, the Defendants were directed to file on record an affidavit disclosing the stock/quantum of the impugned products sold by them.

A very small amount of the allegedly impugned products, "Apixaz" and "Apiquis", totaling about Rs. 8,00,000, were sold by the defendant,

according to an affidavit submitted by Sh. Chander Shekhar on November 2, 2022. Said products were sold during the COVID period, when there was a high demand for the products and increased market pressure. The defendant also revealed that some additional stock was still held by the defendant(s).

The plaintiff's counsel concurs that there cannot be an order prohibiting the manufacture of the stock that is currently on the market because the patent has expired. He does, however, contend that the Defendants might be ordered to pay some minimal manufacturing expenses for the duration of the patent term.

Given the foregoing and the fact that the defendants have not disputed this issue, the present lawsuit is dismissed with the instruction that the defendants pay for two purifiers that the honourable Registrar General of this Court will purchase for use in its facilities.

Avery Dennison Corporation vs. Controller of Patents and Designs

Forum: High Court of Delhi

Case No.: C.A. (COMM.IPD-PAT) 29/2021

Judgement dated: 4th November 2022

Issue: Whether the simplicity of an invention should deter granting of a patent and whether the time gap between the prior art documents and the invention should be considered while determining the inventive step/obviousness under section 2(1)(j) of the Indian Patents Act.

Judgement: The Appellant (Avery Dennison Corporation) filed an appeal seeking inter alia, an order to set aside the decision dated August 12, 2021 (hereinafter 'impugned order') of the Respondent (Controller General of Patents and Designs). The impugned order refused the application for grant of a patent titled '*Notched Fastener*' bearing Application No. 5160/DELNP/2013, filed on June 10, 2013 (hereinafter 'subject patent'),

under Section 15 of the Patents Act, 1970 (hereinafter 'the Act') on the ground that the claimed subject matter of the subject patent does not constitute an invention under Section 2(1)(j) of the Act. In the impugned order, the Respondent relies upon the prior art documents D1 published on February 4, 1981, D2 published on May 11, 1994, and D3 published on June 26, 1984, to refuse the patent application on the ground of lack of inventive step in light of the aforesaid prior art documents. The Respondent submitted, in the impugned order, that the invention of the subject patent is a mere workshop improvement for a person skilled in the art in light of the cited prior art documents. Further, the Respondent submitted that the subject patent is an attempt aimed at evergreening of the patent since one of the prior art documents is also of the Appellant. Furthermore, the Respondent submitted that there has not been any substantial data provided by the Appellant to substantiate their claim of economic advantage over the cited prior art documents.

In light of the aforesaid arguments from the Respondent and the arguments presented by the Appellant, the Hon'ble Court laid down the following fundamental principles to analyze the inventive step of the subject invention:

i. Simplicity does not defeat an invention:

The Hon'ble Court relied upon the findings in **Pope Appliance Corp. v. Spanish River Pulp & Paper Mills Ltd, (1929) 46 R.P.C. 23** and **Vickers v. Siddell (1890) 7 R.P.C. 292** where the House of Lords while considering simplicity in an invention observed: *"If the apparatus be valuable by reason of its simplicity, there is a danger of being misled by that very simplicity into the belief that no invention was needed to produce it. But experience has shown that not a few inventions, some of which have revolutionized the industries of this country, have been of so simple a character that when once they were made known it was difficult to understand how the idea had been so long in presenting itself, or not to believe that they must have been obvious to everyone"*.

Thus, the Hon'ble Court asserted that simplicity in the invention should not deter the Court from granting a patent. The Hon'ble Court opined that the

differences which the Respondent described as 'superficial' may appear simple but clearly had an impact on the product concerned. The description of the said differences as superficial would, therefore, be misplaced.

ii. Time gap/lapse between the prior art and the subject patent application to be considered while deciding the obviousness of the subject patent:

The Hon'ble Court opined that one of the sure tests in analyzing the existence of inventive step would also be the time gap between the prior art documents and the invention under consideration. If a long time has passed since the prior art was published and a simple change resulted in unpredictable advantages which no one had thought of for a long time, the Court would tilt in favour of holding that the invention is not obvious.

The Hon'ble Court cited **Terrel on Law of Patents (16th Edition)** and noted the observations made in **Brugger v. Medic-Aid Ltd, [1996] R.P.C. 635** delivered by the UK Patents Court, where it was stated: *"The fact that a piece of prior art has been available for a long time may indicate, contrary to first impressions, that it was not obvious to make the patented development from it...In other words the age of prior art may be an indication that a development from it is not obvious if it can be shown that the circumstances in the relevant trade were such that a failure of the development to appear earlier is surprising"*.

The Hon'ble Court noted that the prior art document D2 belongs to the Appellant, and the subject patent application was filed almost 18 years after the filing of D2 (with priority date of November 1992). The complete specification of the subject patent clearly explains the disadvantages of the prior art and sets out in clear terms the various advantages of the subject invention. The said advantages are logically decipherable while one understands the invention. No other prior art has been cited between the period 1992 till 2010 which discloses the subject invention or even comes close to suggesting the changes in the invention of the prior art as explained/suggested in the subject invention.

The Hon'ble Court held that the subject patent disclosed a technical advancement in light of the closest prior art and the features involved an inventive step that was not obvious to a person skilled in the art therefore, the subject patent application satisfied the test of inventive step. The Hon'ble Court ordered that the patent should proceed for the grant.

Chandra Sekar vs. The Controller of Patents and Designs

Forum: High Court of Judicature at Madras

Case No.: W.P. Nos. 12620 & 12621 of 2017 and W.M.P. No. 13420 of 2017

Judgement dated: 4th November 2022

Issue: Whether the patent application abandoned due to delay in filing a Request for Examination can be restored if such delay is due to negligence of legal counsel.

Judgement: The Petitioner (Chandra Sekar) filed two patent applications titled 'Methods of Manufacturing a Paint Roller and Components Parts Thereof' which entered the National Phase in India in November 2011. As per the Indian Patents Act, the Applicant of the patent application is required to file a Request for Examination (Form-18) within the prescribed timeline of 48 months from the filing date or priority date. The Petitioner was taking services, for the National Phase applications, of a local Indian counsel engaged by the Petitioner's legal counsel based out of the United States. In the subject applications, the local Indian counsel failed to file the request for examination within the prescribed timeline of 48 months. In particular, it was stated by the Petitioner (hereinafter referred to as the applicant) that even though multiple queries were raised by the US law firm enquiring the local Indian counsel regarding the filing of Form 18 (Request for Examination), the local Indian counsel responded that according to their understanding, the prescribed timeline was still a few months away. Their understanding, however, was caused to due a docketing error that reflected their deadline to be at the end of November 2015, while the actual deadline was May 2015. The local Indian counsel on realizing their error filed a petition of condonation of delay in filing Form 18 with the Indian Patent Office on May 22, 2013, after a delay of 22 days. In August 2013, the

applicant realized the error of judgment by the local Indian counsel, made changes, and engaged the services of another Indian counsel. The new Indian counsel thereafter, on October 4, 2013, filed a detailed petition under Rule 137 read with Rule 138 of the Patents Rules, 2003 at the Indian Patent Office. The applicant continued to make due efforts on their part and filed a letter dated December 4, 2013, to request the Indian Patent Office to accept Form 18 with the petition of condonation of delay. However, the Patent Office dismissed the same stating that Rule 137 does not apply to the present case.

Subsequently, the present writs were filed by the applicant to challenge the orders dated May 3, 2016, passed by the Indian Patent Office, which had dismissed the applications filed by the applicant since the request for examination was not filed within the prescribed timeline of 48 months. The writs were filed by the applicant who was aggrieved by the services of a local Indian counsel engaged by the applicant's legal counsel based out of the United States. The submissions of the applicant before the High Court rested upon the fact that the erstwhile local Indian counsel engaged by them was negligent and had failed to abide by the prescribed timelines, even upon multiple enquiries being raised by the applicant through their US counsel. The applicant further submitted that the Patent Office had failed to appreciate that the Applicant had been willing and intending to pursue the patent applications and therefore prayed before the High Court that the provisions governing the rules of procedure should be construed liberally in the applicant's favour.

The Patent Office, contrastingly, submitted that the prescribed timelines were essential to the process of granting a patent since the grant of a patent confers exclusive rights upon the applicant and in case an applicant does not comply with the statutory requirements, the rights of others which had been previously restricted due to the pending application would be revived. Therefore, such a flexible interpretation of statutory compliances could prejudice others. Further, they submitted that the applicant, being the inventor, should directly authorize the Indian Counsel instead of relying upon foreign agents, and therefore the contention that the delay should be condoned on account of negligence by the Indian Counsel is unacceptable. They further relied upon Rules 137 and 138 and stated that the provisions

did not allow for condonation of delay and that since the applicant's erstwhile counsel had filed the petition after a gap 22 days after the expiry of the prescribed timeline of 48 months. Therefore, the automated computer system of the Indian Patent Office did not accept the request for examination (Form 18) filed by the applicant's erstwhile counsel.

After hearing the arguments presented by the parties, the High Court observed that the point of deliberation in the writ petitions was not whether the applicant was the inventor of the subject patent applications or whether there was any delay in filing Form 18, the only ground to decide upon was whether such sheer negligence on the part of the applicant's erstwhile Indian counsel could affect the statutory rights of the applicant.

Considering the facts and circumstances of this case, the High Court held that no delay or fault can be attributed to the petitioner. The delay was mainly caused by the erstwhile Indian counsel who failed to present the application for examination diligently in time. In fact, the erstwhile Indian counsel informed in the submitted email communications that due to the docketing error, he provided the wrong due dates for filing of the applications for examination. These facts cannot be ignored altogether. Therefore, for the negligence on the part of the erstwhile Indian counsel, the valuable statutory rights of the applicant cannot be completely deprived of.

Ace Technologies Corp and Ors. vs. Communication Components Antenna Inc.

Forum: High Court of Delhi
Case No.: FAO(OS) (COMM) 186 of 2019
Order Dated: 10th April 2023

Issue: The plaintiffs, ACE Technologies Corp and other patent holders, filed a lawsuit against Communication Components Antenna Inc. for infringing their patents related to wireless communication technology.

Order: The Plaintiff has filed an appeal challenging the judgment passed in the case CS (COMM) No. 1222/ 2018 dated 12th July 2019. In this case,

the Defendant had filed a suit against the Plaintiff, seeking a decree of a permanent injunction for infringing their Patent No. IN'893. The Plaintiff had claimed that the patent IN'893 was invalid, which was dismissed by the single-judge bench earlier. The Plaintiff has filed an appeal in the High Court against the order of the single-judge bench.

During analysis, the court has observed that the patent IN'893 relates to a split-sector antenna emitting at least one asymmetrical beam in a specific configuration. The Court has provided a comprehensive analysis of the interlinking between the claims and the disclosure of the specification of the patent. Furthermore, the Court has also explained the evaluation criteria of Section 3(d) of the Patent Act with respect to the patent, among other observations. In view of the section 3(d) of the Patent Act, the Court noted that the objection under Section 3(d) of the Patents Act would be available against attempt to patent a mere discovery, or a new property or a new use. The court in the subject case stated that, though the plaintiff uses known antenna/split-sector antenna but the combination, at least one of the beams emanating from which is asymmetrical, but since the resultant beam has increased subscriber capacity, it constitutes an enhancement of known efficacy of beams and Section 3(d) would not be attracted. The Court had rejected the challenge that the patent IN'893 could not be granted by virtue of Section 3(d) of the Patents Act.

Further, the Court also did not accept that the validity of the patent IN'893 could be challenged under Section 3(f) of the Patents Act as it was not a rearrangement but a change in the manner in which asymmetry was introduced in an antenna leading to greater efficiency. In view that the aforesaid invention enhances the known efficacy, the Court observed that the ground of revocation under Section 64(d) is not made out. Furthermore, the Court had also rejected the contention that the patent IN'893 was disclosed by prior art and was thus, liable to be revoked under Section 64(e) and 64(f) of the Patents Act. In this regard, the Court was of the view that the patent IN'893 was in broad terms. The Court held that the method in which the invention is claimed does not specify the particulars of the antennae to be used and/or the beams to be generated and the method described is vague. This would permit the patentee to claim infringement qua any method used for increasing the subscriber capacity as the same

would involve the use of antennae/spilt-sector antennae emitting beams. Further, as regard to the Plaintiff allegation of the present invention under Section (1)(a) and 64(1)(h), the Court has directed that for evaluating the Patentability under Section (1)(a) and 64(1)(h), not only the claims, but also whole specification has to be seen. The embodiments also aid in understanding and interpreting the Claims. The court vacates the impugned order. The Court upheld the order passed by the single-judge bench and dismissed the appeal raised in light of the invalidity of patent IN'893.

Communication Components Antenna Inc. (Earlier Known As Ten Xc Wireless Inc) vs. Mobi Antenna Technologies Co. Ltd. & Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 977/2016, CC(COMM) 38/2017 & I.As. 10524/2018, 16746/2021 Order Dated: 4th Feb 2022

Issue: Whether the revocation of patent can be argued as a question of law and whether the patent can be revoked on the basis of terms of the patent itself.

Order: *Vide* order dated 4th February, 2016, the issues that was framed are: (i) *Whether the impugned Patent No.IN240893 is invalid in view of any of the grounds raised in counterclaim No.38/2012?*, (ii) *Whether the defendants have infringed any of the claim of the impugned Patent No.IN240893*, (iii) *If the answer to issue no.(ii) is in affirmative, what is the relief that the plaintiff is entitled to, and for what period.* The afore-noted Issue No. (i) was taken up first and hearing on Issue No. (ii) and (iii) was deferred. In the judgment dated 10th August, 2021, the Court while rendering findings on Issue No. (i), rejected all grounds urged by the Defendants and upheld the patent. However, at the same time, the Court on its own, proceeded to analyse whether the subject patent was liable to be revoked under Sections 64(1)(h) and (k) of the Patents Act, in the context of Section 10. On this aspect, findings were rendered against Plaintiff, and

it was concluded that the subject patent i.e., ‘IN240893’ – was invalid and liable to be revoked under Section 64(1)(h) and (k) of the said Act.

When the matter was carried out in appeal, the Division Bench vide order dated 1st December, 2021, set-aside the Single Judge’s judgement and made several observations. The Division Bench directed the Single Judge to frame a specific issue, and accordingly, an additional issue was framed, which reads as

i) Whether the Plaintiff’s Patent Number IN 240893 is liable to be revoked on the grounds under Sections 64(1)(h) or 64(1)(k) of the Patents Act, 1970 in the context of Section 10 of the Patents Act, 1970? OPCC.” The aforementioned issue was framed in the presence of the Defendant’s counsel. However, the said counsel subsequently took discharge, and summons were re-issued to the Defendant,

The Plaintiff has filed a suit for revocation of patent under Sections 64(1)(h) and (k) of the Act against the Defendant. The Defendant has denied the allegations and submitted that the revocation of patent can only be for grounds enumerated under Section 64 of the Act which have to be founded on facts and proved by placing supporting material before the Court. The Defendant has also argued that the subject patent cannot be revoked as there are no pleadings or evidence led on grounds of insufficiency of disclosure. The Plaintiff has argued that the onus is on the Defendant to establish that the suit patent is liable for revocation on the ground of invalidity. The court has observed that the revocation of patent under Sections 64(1)(h) and (k) of the Act has to be premised on facts. However, in absence of any foundation in pleadings or evidence, the issue stands disproved against the Defendants. The sufficient disclosure of the invention in the patent specification is the consideration for which a patent is granted. Thus, the onus on the Defendant to establish that the suit patent is liable for revocation on the ground of invalidity. The Court has also stated that sometimes opinion of an expert/ a person skilled in the art, may become relevant to conclude whether a patent is insufficient or not. Thus, the court decision has been answered in favour of the Plaintiff, and against the Defendant.

Koninklijke Phillips N.V. vs. VIVO Mobile Communications Co. Ltd.

Forum: High Court of Delhi

Case No.: I.A. 3048/2021 in CS (COMM) 383/2020

Order Dated: 7th January 2022

Issue: Whether to allow production of license agreements, executed between defendants and chipset manufacturers, from Defendants for resolution of dispute related to infringement of SEP patents of Plaintiff

Order: The plaintiff alleged that the defendants were infringing five of its patents related to technologies in the field of telecommunications, which have been adopted by various standard setting organizations, such as European Telecommunications Standards Institute (ETSI).

The defendants submitted that the services that the technologies it had advertised as being available on its handset were derived from the chips which were sourced from Qualcomm and MediaTek. Therefore, if there was any infringement, the plaintiff had to question these two companies, who, however, were not made parties to the present case. The instant application was moved for production of the license agreements executed between the defendants and Qualcomm and other companies, as it would help to determine the truth in the claim of the defendants.

The Court observed that there is an obligation on parties to produce all documents in their possession and to answer every plea, giving reasons as to why a stand contrary to the plea was being taken. After noting the documents sought by the plaintiff from the defendants and what are the questions to which answers have been sought, the Court observed that the contention of the learned counsel for the defendants that it is for the plaintiff to map their patents on to the standard essential features would be settled by the production of this agreement, as it would be evident as to whether the patents work on the chipset or handset and what was the technology transferred by Qualcomm and others to the defendants. The Court also directed constitution of a confidentiality club for keeping the necessity of

industry confidentiality stating that these documents need not be brought out into the open.

Accordingly, the Court partially allowed the application, allowing interrogatories related to whether defendants' mobile devices comply with the following ETSI standards related to used technologies therein, since they have a direct bearing on the technologies used by the defendants which in turn would have a bearing on the question of infringement as well as FRAND licensing, thereby directing the defendants to answer these interrogatories by way of an affidavit. Some of the interrogatories related to other context for such agreements were not allowed as these did not lead anywhere.

Allergan Inc. vs. The Controller of Patents

Forum: High Court of Delhi

Case No.: C.A.(COMM.IPD-PAT) 22/2021

Order dated: 20th Jan 2023

Issue: Scope of claim amendments as permissible under Section 59(1) of the Patents Act.

Order: The judgement is peculiar in way that it sets out a precedent for purposive interpretation of different provisions of Patents Act. The Court in its judgement has identified that plain reading of Section 59(1), dichotomizing the claims and the accompanying specifications is completely against the very ethos and philosophy of the Patents Act. The Court heavily emphasized that that a purposive interpretation of provisions be adopted for fostering the inventiveness over literal interpretation, which in contrast would discourage inventiveness and would be counterproductive. The Court by adopting the purposive interpretation has held the claim amendments from “*a method for treating an ocular condition*” claim to “*an intracameral implant*” (product) as permissible, which as per literal interpretations of Section 59(1) were identified to be as non-permissible by the Controller. The judgement has thus clearly expanded the scope of claim amendments that the applicants may under

Section 59 of the Patents Act to deal with circumstances arising due to various reasons during the prosecution of a patent application in India.

Societe Des Produits Nestle SA vs. Controller of Patents

Forum: High Court of Delhi

Case No.: CA (COMM.IPD-PAT) 22/2022

Judgment dated: February 03, 2023

Issue: Controller rejected Appellant's amendments u/s 59 and also refused its application "Composition for use in the Prophylaxis of Allergic Disease" on ground of non-patentability u/s 3(i), lack of inventive step and synergism. On appeal, the Court dealt with the following issues:

- (iii) Whether the claims define a method for "treatment of human body"?
- (iv) Whether the High Court can direct the applicant for amendment during the appeal?
- (v) Whether the amendment of "composition for use in the prophylaxis" to "composition" was valid u/s 59?
- (vi) Whether the composition had a "sufficient" synergistic effect?
- (vii) Whether the composition lacked inventive step?

Order: On analyzing each issue, the Court held *in seriatim*:

1. *No.* The expression "composition comprising DGLA for use in prophylaxis" was used only for defining the composition and not directed towards any method of treatment. The exclusion u/s 3(i) would not be applicable to originally filed as well as amended claims.
2. *Yes.* High Court, hearing an appeal against an order of the Patent Office, necessarily has the same powers as given to the Controller u/s 15, which includes the power to require amendment.
3. *No, but curable.* The appellant's amendment of purpose-limited product claims ("composition for use in the prophylaxis") to general

product claims (“composition”) was clearly in the teeth of S. 59. However,

- 3.1 the amendments were made by the appellant to delete the phrase “for use in prophylaxis” only on account of an erroneous objection raised by the Patent Office u/s 3(i).
- 3.2 in the interest of justice, High Court granted liberty to the appellant to file the previously filed claims. On the direction, as the appellant resorted back to the previously filed claims (purpose-limited composition), the objection u/s 59 was remedied accordingly.
4. *Yes.* It was not necessary to disclose all conceivable ways of operating the invention. If the best method known to the patentee is disclosed, it is sufficient. The court considered appellant’s data (on six parameters) sufficient enough and held that the reduction of IL4 values for the composition over its individual ingredients was a synergistic effect.
5. *No.* Closest art D1 was silent on a distinguished technical feature that the claimed composition had. D2, aimed at an entirely different purpose, taught away. If these differences between the prior art and subject invention were “obvious to try”, then the same would have been attempted by now, especially considering 20 years old prior arts. Thus, *Roche v Cipla* five-step test coupled with secondary indicia suggested a clear inventive step.

With aforesaid issues decided in favour of appellant, the application proceeded for grant. (*The pro-patentability could have a bearing on a large number of pharmaceutical and biotechnological applications.*)

Perkinelmer Health Sciences vs. Controller Of Patents

Forum: High Court of Delhi

Case No.: C.A.(COMM.IPD-PAT) 311/2022

Judgement dated: January 04, 2023

Issue: Whether during the course of Hearing an examiner can raise further or additional objections, whether without giving any prior notice for a Hearing on an objection the controller can refuse the grant of patents, and

whether it's mandatory for the controller to give prior notice for the objections raised for Hearing.

Judgement: The Appellant (Perkinelmer Health Sciences) filed an appeal seeking inter alia, an order to set aside the decision dated February 8, 2019 (hereinafter 'impugned order') of the Respondent (Controller of Patents). The impugned order refused the application for grant of a patent, under Section 15 of the Patents Act, 1970 (hereinafter 'the Act') on the ground that the claimed subject matter of the application is non-patentable under section 3(f) of the Act. The Appellant stated that the present application was subjected to a Hearing, and later during the time of Hearing, the examiner raised additional objections on the grounds provided under Section 3(f) of the Act without any prior notice. The appellants raised contentions on the same as the same was not only against the basic tenets of the principle of natural justice but also against the circular released by the Indian Patent Office on 21st September 2011 named "Examination of Patent Applications and Consideration of Report of Examiner by Controller". Under the said circular the clause 1 (i) *provides that during the time of Hearing the examiner may stay present, however, such examiner shall not communicate with the applicant directly nor shall the examiner raise any additional or further grounds for refusal.* In the current case, the rejection of the application was based on the collective grounds of Section 15 and Section 3(f) and for the grounds raised under Section 3(f) any prior notice or intimation was not even provided which is totally in breach of the said circular. Apart from that it does not even stands true to the basic principle of natural justice that is Audi Alteram Partem which simply implies that the other party needs to be given an opportunity to be heard and a reasonable time shall be given to that party to prepare a defence for himself.

In light of the aforesaid arguments from the Appellants and the arguments presented by the Respondents, the Hon'ble Court stated that if upon Examination of the response submitted by the Applicant, the Examiner reports that some objections are still outstanding or raises further objection(s), such objections shall be communicated along with the notice of Hearing, giving reasonable time to the Applicant. It is clarified that there

is no need to send a second examination report. Further, the Hon'ble Court stated that at the time of the Hearing, no further objections can be raised. Thus, the Controller/ Examiner is not permitted to raise new grounds of objection at the time of the Hearing. The Hon'ble Court in the present case referred to all the grounds, and without going into the merits of the case set aside the impugned order stating it to be vitiating the principles of natural justice and the norms provided in the circular and remanded back to the respondent for a fresh consideration. The respondent was directed to issue a fresh notice of Hearing raising all objections.

FMC Corporation vs. Natco Pharma

Forum: High Court of Delhi

Case No. FAO(OS) (COMM) 301/2022

DB Judgment dated 05th December 2022

Suit Patent (Appellant Patent) IN '645, process/method for the manufacturing/preparation of Chlorantraniliprole ('CTPR')

Defendant NATCO's Application with claims for "Method for preparing N-Phenylpyrazole-1-Carboxamides" along with several other claims related to the manufacturing of CTPR

Issue: Appellant alleged that the process, as disclosed by NATCO's application, is *equivalent* to the process claimed in the suit patent IN'645. On the basis of equivalence, the appellant claimed that NATCO's process infringes the suit patent.

Whether the Defendant's process for preparing CTPR is equivalent to the process claimed by the suit patent IN'645"? and whether the 'doctrine of equivalence' would be applicable in this case?

Order: The Division Bench (DB) concurred Single Bench (SB)'s findings that there was no infringement since the reagent i.e., *sulfonyl chloride* was an essential element in Appellant's process and NATCO's process admittedly used *thionyl chloride* as the reagent, which had *different and distinct role* in achieving the *same task* and accomplishing substantially,

the *same result*. Use of a different reagent and a completely different sequence of reactions in the NATCO's process could not be termed as a minor or insubstantial variation. The triple test (substantially the *same function*, in substantially the *same way* and to yield the *same result*) was applied by the SB to assess the equivalence and the DB upheld the SB's triple test findings, in that, the use of thionyl chloride could not be considered as equivalent to the element of sulfonyl chloride in the suit patent. Therefore, no prima facie of infringement was made out.

The doctrine of equivalents is applicable only in cases where the variation or difference between the product or process and the patented claim is insignificant, insubstantial and not essential to the patented claim.

The doctrine seeks to address infringers who introduce minor variations as subterfuge to defeat patent rights and applied to ascertain whether there is an infringement by excluding any insubstantial, minor or trivial changes that are designed to deprive the patentee of the benefits of his invention.

Adama Makhteshim Ltd vs The Controller of Patents

Forum: High Court of Delhi

Case Number: C.A.(COMM.IPD-PAT) 167/2022

Order Dated: 1st May 2023

Issue:

- Whether the appellant's patent application can be refused based on Section 10(4)(a) of the Patents Act, 1970?
- Whether the vagueness and conciseness of the appellant's invention application can be questioned?

Order:

A patent application was filed by the appellant titled "5-FLUORO-4-IMINO-3- (ALKYL/SUBSTITUTED ALKYL)-1-(ARYLSULFONYL)-3, 4- DIHYDROPYRIMIDIN- 2(ii)- ONE AND PROCESSES FOR THEIR

PREPARATION" which was refused under Section 10(4)(a) and 15 of the Patent Act, 1970.

It was argued by the Appellant that the objection raised under Section 10(4)(a) was a jurisdictional error by the Assistant Controller of Patents and Designs and that the appellant was not given the opportunity to meet the requirements of the raised objection. Section 10(4)(a) of the Patents Act, 1970 states that the full description and specification of an invention must be disclosed along with the methods of its operation.

The court considered that the alleged invention describes the process of the preparation. However, the submitted documents only disclosed the preparation of a compound using an alkylating agent and potassium carbonate or lithium carbonate. It was silent about the usage of "alkali alkoxide" and no technical advancement or any distinguishing element could be observed.

The Assistant Controller had observed that the evidence submitted by the appellant was insufficient. There was an absence of examples with respect to the usage of "alkali alkoxide." Due to a lack of proper evidence, the appellant failed to meet the requirements and thus, the invention was not patentable under section 10(4)(a).

The Delhi High Court held that a fresh notice of hearing, answering all the objections raised should be issued to the appellant following the legal procedure. Further, it was observed by the court that there is a limitation period for patent applications and since the invention in question was filed in the year 2016, half the patent duration has elapsed. The court stated that the current application has been rejected only on one ground, i.e., the ground of vagueness and conciseness of the invention.

Baes on the merit of the case, the operation of the invention in question was not adequately described and its details were explained vaguely; therefore, it was considered non-patentable. However, the court has emphasized another aspect in this case that there are additional objections that have

remained unanswered and cannot be disregarded; therefore, an order cannot be passed merely on one technical ground.

To answer the question of the patentability of the invention, the court opted for a feasible approach and observed that a fresh notice answering all the objections should be filed. Even if the application is non-patentable based on technicalities, a comprehensive order should be passed addressing all the objections.

Sony Group Corporation vs Assistant Controller of Patents

Forum: High Court of Delhi

Case Number: C.A.(COMM.IPD-PAT) 480/2022

Order Dated: 8th May 2023

Issues:

- Whether the appellant's application can be rejected based on section 59(1) of the patents act 1970?
- Whether "exceeding the scope of claim" is valid for rejecting the amendment claims?
- Whether the appellant's amendment claims correspond to the claims of the divisional application as well as the EP application of the instant application?

Order:

An appeal under Section 117-A of the Patents Act 1970 was filed opposing the order passed by the Assistant Controller of Patents and Designs. On 15th May 2013, the appellant filed a subject application, which was examined by the Patent Office in November 2018, titled "Data Processing Device and Data Processing Method". The purpose of the subject invention was to enhance the processing of control data required for demodulation during digital video broadcasting.

The appellant on 16th February 2022 amended claims 1 to 8 of the application. Among these amendments, the independent claims 1 to 4 were

modified to align with the independent claims 4 to 10 respectively, of a corresponding European patent divisional application.

The European Patent Number EP3429084 was granted based on the divisional application. The amendments made by the appellant in the claims aimed to ensure consistency and alignment between the subject application claims and the claims in the corresponding EP divisional application.

The respondent alleged that the amended claims exceed the scope of amendment and are different from the claims of the instant application. The amendments were to change the feature “dummy data” to “zero padding bits” and “creating a frame containing the post-shortening LDPC code data and multiplexing the frame into a DVB-T2 signal for transmission.

Subsequently, the appellant proceeded with only the application corresponding to the EP divisional application. It was further submitted that the appellant has only limited the scope of the principal claim by proceeding with the said application.

The respondents contended that the proposal of an amendment should only be approved if it adequately addresses the objections raised in the prior publication. Awareness about the objection stemming from the prior publication and delay in applying for the amendment is also a “ground for refusal.” Further, an amendment aimed to convert a “non-essential element” into an “essential element” is not allowable.

In addition, the primary claim has resulted in a “limitation of the scope of the claim.” The addition of a limitation acts as a “disclaimer.” This recourse of disclaimer can be adopted to clarify the exact scope of the invention in cases of the challenge of the validity of the patent.

Based on the claims of both the parties the High Court of Delhi held that the amendment claims by the appellant are supported by specifications and that it does not limit the scope of the application. The purpose is to enhance the scope of the patent and to make it more specific.

The Court further observed that the appellant has the freedom to proceed with one invention that corresponds with the divisional application of the

European patent. Both the main European patent and the Divisional European patent correspond to the subject application.

Further, the court elaborated on the fact that the current appeal only focuses on the aspect under Section 59 of the Act, however other issues and objections have remained unaddressed and therefore, will be taken up by the patent office. Based on this, Delhi High Court set aside the impugned order based on the observation that the amendment made by the applicant did not expand the scope of the claim and only makes it clearer.

OpenTV Inc Vs Controller of Patents and Designs and Anr

Forum: High Court of Delhi

Case No.: C.A. (COMM. IPD-PAT) 14/2021

Date: 11th May 2023

Issue:

- Interpretation of business method aspect of Section 3(k) for determining of patentability of an invention.

Order:

The subject patent application is stated to be a network architecture and a method implemented on the same to enable the exchange of interactive media content distribution of any type of digital or tangible media. During the prosecution of the application, the applicant had amended the claims at the time of Hearing of the application, which were found to be in non-compliance with Section 59 in the refusal order.

During the Appeal proceedings, the Hon'ble court offered an opportunity to the appellant to amend claims. Particularly, on 22nd April 2022, the Appellant was asked if it intends to prosecute the claims as they stand or whether any further amendments thereto are to be made. Accordingly, the Appellant filed an alternative set of claims which the Appellant wished to

prosecute in the appeal. In these claims, the Appellant basically reworded the method claims to system claims, seemingly, in an attempt to circumvent the scope of a business method.

The respondent objected to this opportunity given to the appellant, arguing that there is no provision to amend the claims at Appellate stage where the application is refused by the Controller under Section 15 of the Act. However, he later conceded that as per the decision of a Coordinate Bench of this Court in ***Societe Des Produits Nestle Sa v. Controller of Patents and Designs, 2023/DHC/000774*** amendments at the appellate stage amendments can be permitted.

The respondent further argued that the amended system claims 4 to 16 were newly added system claims which were never a part of the originally filed claims. Therefore, this amendment ought not to be allowed owing to the limitations imposed by Section 59, and also on the rationale that ‘*what is not claimed is disclaimed.*’ The respondent also argued that changing the method claims to system claims would not affect the patentability analysis, as it is still a system to provide something as a gift, and therefore in effect still constitutes a business method. Thus, even the amended claims, would continue to be hit by Section 3(k) of the Act.

After hearing both the parties, the Hon’ble court first addressed the question of whether the claim amendments can be permitted at the appellate stage, at the instance of the Applicant. The Hon’ble Court that there is no embargo on permitting an applicant to amend claims even at the appellate stage.

The Court held that the system claim, which is now sought to be patented as claim 1 may be within the overall scope of the specification but is not within the scope of the originally filed claims. Conversion of method claims into system claims in the manner sought to be done, would be broadening of the claims which is impermissible as per section 59 of the Act. The Court also observed that there may be some exceptional cases where such a

conversion may be permissible depending on the nature of the invention and the scope of Claims.

The fundamental principle governing amendment of claims is that amendments are permissible as long as the amendments are within the scope of the originally filed claims. However, the amendment sought in this particular case intends to widen the scope of the originally filed claims. It is due to this reason that the same cannot be allowed. Therefore, the claims as they stood originally were considered and accordingly further arguments were made on the claims that were refused by the Controller.

The Appellant argued that only because there are financial gains that can be achieved through a particular patented invention, the invention cannot automatically be concluded to be a business method. The Appellant relied upon the network architecture of the invention to establish that the novelty resides in the two-way communication channel between the headend system and the set-top-box, in contrast to the exiting art where only a one-way communication between the headend system and the user is possible. Hence, there is a clear technical advancement in the claims and the mere use of the word “method” in Claim 1 should not completely deprive the Applicant to obtain a patent on a novel and an inventive system.

The Appellant further argued the effect of the invention would be monetary in most inventions, but that would not prohibit grant of the patent under Section 3(k) of the Act as long as technical effect can be shown. Thus, if the technical architecture is innovative and novel, the same is liable to be granted a patent.

On the other hand, the respondent argued that a perusal of the claims itself would show that the subject patent is a business method as the focus of the claims is on the aspect of giving a media item as a gift. There is no ambiguity in claim 1 in the fact that it is meant to promote the user with a method to give the media item as a gift which is nothing but a business method.

After hearing both the parties, the court held that a perusal of the patent specification would show that the purpose of the subject invention is to enable giving of media as gifts. The bar in India to grant of business method patents must be read as an absolute bar without analysing issues relating to technical effect, implementation, technical advancement, or technical contribution. Thus, the only question that the Court or the Patent Office while dealing with patent applications involving a business method, needs to consider is whether the patent application addresses a business or administrative problem and provides a solution for the same.

The Court held that though there is no doubt that there is a two-way communication, the purpose of the invention is primarily to enable giving of a media in tangible or intangible format to the recipient. Such a giving of a media irrespective of whether is worded as a method or as a system would be nothing but a method for doing a particular business i.e., for giving of a media as a gift.

The court also referred to the status of the corresponding applications in other jurisdictions as provided in the latest **Form-3** and observed the Appellant has itself declared that it has abandoned the patent in several jurisdictions. It appears from the order that the Hon'ble court took that as an indication that the invention is a business method and is not patentable, leading to the Applicant abandoning the application in other jurisdictions. The reliance on the Form-3 in this manner is arguable because the abandonment of an application by the applicant cannot be equated with rejection of the application by the patent office. During the course of prosecution of applications, the applicants sometimes prefer to abandon the application, owing to the ever-changing market dynamics and other similar factors. Moreover, the application is granted in some jurisdictions as well, which could very well contradict this reasoning altogether.

Finally, the court held that the subject invention is directed purely towards a method of giving a media as a gift which is nothing but a method of selling a media for gift purposes and is hence a business method. The subject

invention is attracted by the exclusion from patentability under Section 3(k) of the Act.

Moreover, the Court went beyond the scope of the present matter and acknowledged the ever-mounting need of updating or clarifying the Section 3(k) limitations, by referring to the Parliamentary committee report. However, the Hon'ble Court observed that the modification of Section 3(k) would be in legislative domain. In terms of the statute as it stands, business method inventions are not patentable.

Further, the court observed that a large number of inventions in emerging technologies including by SMEs, start-ups, and educational institutions could be in the field of business methods or application of computing and digital technologies. There is a need to have a re-look at the exclusions in Section 3(k) of the Patents Act, 1970, in view of the growing innovations in this space. Accordingly, the Hon'ble court directed the Registry to send a copy of the present order to the Secretary, DPIIT, Ministry of Commerce and Industry for necessary consideration.

Microsoft Technology Licensing, LLC Vs Assistant Controller of Patents and Designs

Forum: High Court of Delhi

Case No.: C.A.(COMM. IPD-PAT) 29/2022

Order Dated: 15th May 2023

Issue:

- The interpretation of the phrase “computer program per se” in the exclusionary Section 3(k) of the Patent Act, 1970.

Order:

Microsoft filed an application (1373/DEL/2003) on November 7th, 2003 for the invention "*Methods and Systems for authentication of a user for sub-*

locations of a network location.” After examination, the IPO refused the application on the grounds of non-patentability under Section 3(k) and other unmet requirements under the Act. Microsoft thereafter filed an appeal before the Hon’ble High Court of Delhi, challenging the Controller’s order.

The Controller alleged that the invention is merely a set of computer-executable instructions or algorithms, constituting a “computer program *per se*”. Particularly, the Controller stated that the invention is a method/system for performing two-level authentications based on cookies. The alleged invention provides a technique for authentication involving the use of two different cookies for authenticated access to the client computer accessing a sublocation in a network location, which is a set of instructions in the form of an algorithm performed by the general computing device. It has been implemented on a conventional computing device and software environment. The Controller, therefore, held that claims 1-28 are an implementation of computer-executable instructions/algorithms on a general-purpose computing device to achieve the intended functional features, leading to the refusal of the application.

Microsoft argued that Section 3(k) has been misinterpreted in the impugned order. The inclusion of the term “*per se*” in Section 3(k) indicates that the intent of the legislature is not to refuse the grant of patents to computer programs altogether. The intent was to refuse patent protection only to the computer programs *as such*.

They further argued that the technical contribution/effect of the present application lies in the improved security of the existing computer and computer networks. The claims relate to a technical process, solve a technical problem, and provide a technical solution/advancement relating to the security of the data accessed on a network. Therefore, the contribution of the claimed invention does not lie solely in the excluded subject matter but rather in the combination of the software with the hardware components.

In the presence of the Controller who handled the application, the IPO argued that the claimed invention is merely an “algorithm” which, is a set of rules that must be followed to solve a problem. The set of instructions is being implemented on a computer program *per se*, and the subject invention is therefore non-patentable. They further argued that the subject patent operates at the user-interface level and enhances user experience/efficiency, thereby not having any technical effect or contribution to the hardware/computer system itself.

The Court found it reasonable, to revisit the historical background leading to the evolution of Section 3(k), to appreciate the legislative intent behind this provision. The Court noted that while the provision for the prohibition of certain categories of invention from patenting was introduced through the Patents Bill, 1953, it was only through the Patents (Second Amendment) Bill, 1999, that the term “computer programs” was inserted into Section 3. At that time, there was no mention of the term “*per se*” in this provision.

In 2001, the Joint Parliamentary Committee report recommended the insertion of the word “*per se*” in conjunction with “*computer program*” in Section 3(k). The report explained that this change has been proposed as the computer programme may include certain other things, ancillary thereto or developed thereon. Therefore, the intention here is not to reject them for grant of a patent if they are inventions, but to refuse the patent to the computer programmes *as such*.

Thereafter, the Rajya Sabha's Department Related Parliamentary Standing Committee on Commerce highlighted the need for a clear definition of “*per se*” under Section 3(k). In their report, the Committee acknowledged that a framework needs to be developed for patenting of algorithms by associating their use with a tangible result.

Based on this historical background, the Court, therefore, observed that the legislative discussions emphasize the need for adopting a clear definition of

the term "*per se*" to ensure accurate and consistent application of the law. It is evident that this term was added to clarify that "computer programs *as such*" are non-patentable. The amendment intended to allow the grant of patents to CRIs that involve a novel hardware component or provide a technical contribution to the prior art(s) beyond the program itself. More importantly, the Court acknowledged that although the legislative intent has always been clear, the term "*per se*" has led to inconsistent and imbalanced application of the law.

The Court referred to the CRI guidelines issued by the IPO and noted that the first CRI guidelines issued in 2013 clearly defined two terms, technical effect and technical advancement, which are used to assess the patent eligibility of a claimed invention in relation to Section 3(k).

Thereafter, 2017 CRI guidelines aimed to provide further clarity and consistency in the examination process of CRIs. These guidelines eliminated the three-step test laid down in the 2016 CRI guidelines and the requirement of novel hardware in conjunction with a computer program (software) when a method claims *qua* a new computer program in combination with the hardware being claimed. The Court noted that the focus in the 2017 CRI guidelines appears to be on substance over forms and claims.

The Court then referred to the MPPP issued in 2019 and noted that the MPPP also takes 2017 CRI guidelines into consideration. The 2017 CRI guidelines and 2019 Manual thus clarify that "computer programs *as such*" are non-patentable, but inventions that involve a technical contribution or effect, beyond the program itself, may be patentable.

The Court acknowledged that despite the legislative intent and interpretation of the courts (and earlier IPAB) on this issue, the IPO often places significant reliance on the necessity of novel hardware as the determining factor. In the present case as well, the non-patentability

objection alludes to the same objection. The Court thus reinforced the view that patent applications should be considered in the context of established judicial precedents, Section 3 (k) of the Act, extant guidelines related to CRIs, and other materials that indicate the legislative framework.

The Court particularly stated that if a computer-based invention provides a technical effect or contribution, it may still be patentable. The technical effect or contribution can be demonstrated by showing that the invention solves a technical problem, enhances a technical process, or has some other technical benefit. The mere fact that an invention involves a mathematical or computer-based method does not automatically exclude it from being patentable.

The Court emphasized the importance of signposts for the evaluation of "*technical contribution*" and "*technical effect*". The Court remarked that examiners must analyse the substance of the invention to determine whether an invention falls within the excluded categories, instead of focusing solely on the form of the claims. This approach ensures that inventions providing technical advancements and solutions to real-world problems are adequately considered for patent protection, irrespective of the way they are claimed or presented.

The Court further acknowledged that while the concept of technical effect and contribution is crucial in determining the patent eligibility of CRIs, there is currently a lack of clarity in this area. The Court accordingly suggested providing examples or illustrations of patentable and non-patentable computer programs in the CRI guidelines, as it would offer valuable guidance and clarity to applicants and patent examiners. The Court accordingly instructed the IPO to undertake the exercise of providing indicators to the examiners by citing an exhaustive list of worked examples, relating to patent eligibility.

The Court emphasized that creating signposts would serve as reliable guidance for the examiners and would result in consistency in the examination, leading to a more predictable and transparent patent system. It would also help the Applicants to draft patent applications that demonstrate/delineate the technical merits of their inventions. Besides, it would also ensure alignment with practices adopted in several jurisdictions, such as EPO and USPTO. The Court also stated that the signposts laid down by the EPO provide a well-established and structured framework for assessing the patentability of CRIs. The Court, therefore, instructed the IPO/CGPDTM to also frame signposts, keeping in mind the Indian legal framework.

The Court opined that the Controller has entirely missed the point and his approach is misguided. The mere conclusion that claims 1-28 are implemented on a computer and are computer-executable instructions/algorithms performed on a general-purpose computing device is not the correct approach for rejecting a patent application. The fact that the claimed invention involves a set of algorithms executed in a pre-defined sequential manner on a conventional computing device does not necessarily imply that it lacks a technical effect or contribution. If the subject matter is implemented on a general-purpose computer, but results in a technical effect that improves the computer system's functionality and effectiveness, the claimed invention cannot be rejected on nonpatentability as a "computer program *per se*". Even a mathematical method or computer program can be used in a technical process carried out by technical means, such as a computer comprising hardware or a suitably configured general-purpose computer. The interpretation of "*per se*" under Section 3(k) of the Act has been entirely overlooked by the Controller.

The Court also acknowledged the technical contribution of the invention, as using two different cookies for providing authenticated access to the client computer accessing a sub-location(s) within a network location, which simplifies user interaction with content received from feeds. The present

invention, therefore, enhances the security of accessing sub-locations of network locations and streamlines the user experience.

The Court, therefore, held that Controller's rejection stems from a misinterpretation of Section 3(k) of the Act, and an oversight of the technical effect and contribution of the claimed invention, resulting in an erroneous determination that the subject patent constitutes “computer program *per se*”.

The Court accordingly set aside the impugned order and held that the subject patent does not fall within the excluded categories and identified the next step to be assessing the novelty and inventive step (non-obviousness) of the claimed invention. However, since the impugned order did not have any discussion on other requirements, the Court did not comment on these grounds and remanded the matter back to the Controller for re-examining the application only for novelty and inventive step.

Moreover, the Court in general guided the IPO to adopt a more comprehensive approach when assessing CRIs, considering technical effects and contributions provided by the invention rather than solely focusing on the implementation of algorithms and computer-executable instructions. An invention should not be deemed a computer program *per se* merely because it involves algorithms and computer-executable instructions. Rather, it should be assessed based on its technical advancements and practical application in solving real-world problems.

AstraZeneca Ab & Anr. vs West Coast Pharmaceutical Works Ltd.

Forum: High Court of Delhi

Case No.: CS (COMM) 101/2022

Judgment Dated: 15th May 2023

Issues:

- Whether the term of validity of patent stands extended by the time taken in disposal of post grant opposition.
- Whether there is any screening or stringent admission procedure of a post grant opposition to a patent because it is felt that unless there is a stringent admission procedure, mere filing of a post grant opposition should not be permitted to freeze or keep in abeyance the rights of a patentee.
- Whether an infringement suit could be instituted till the expiry of a year from the date of grant of the patent.

Judgment:

In the present case, a patent claiming the compound Osimertinib was granted to the plaintiff on 11th June 2018. Post-grant oppositions were filed by Sunshine Organics Pvt. Ltd. on May 14, 2019, and by Natco Pharma Ltd. on June 10, 2019, under Section 25(2)3 of the Patents Act.

The present suit was filed only thereafter on Feb. 8, 2022, when the aforesaid post-grant oppositions of Sunshine and Natco were still pending before the Controller General of Patents.

Westcoast Pharmaceutical Works Limited, the defendant, has submitted a request under Order VII Rule 11 of the Code of Civil Procedure, 1903 (CPC), to dismiss CS (COMM) 101/2022, which was brought by the plaintiff, AstraZeneca AB.

The defendant contended that the suit is invalid due to a lack of pecuniary jurisdiction, asserting that it should have been filed before the District Court. However, the court determined that there is no provision in the Patents Act that prevents a patent holder, who has been granted a patent, from pursuing an infringement suit immediately after receiving the patent. Requiring the patentee to wait for a year before initiating infringement proceedings would create an opportunity for infringers. Consequently, the suit was not dismissed for want of pecuniary jurisdiction.

The plaintiff argued that the right to file an infringement suit only arises after the patent is granted. The court agreed with this argument and acknowledged that the plaintiff possesses the right to bring an infringement suit once the patent has been granted. Furthermore, the court noted that there is no legal restriction on the patentee waiting for a specific period before acting against perceived infringement.

The court determined that there are no grounds for rejecting the suit based on pecuniary jurisdiction or the plaintiff's right to file an infringement suit.

Additionally, the court opined that the observations in paragraph 19 of *Aloys Wobben* are incidental statements and do not hold precedential value. Moreover, the court distinguished between the granting of a patent and the crystallization of the right to hold the patent, emphasizing that obtaining a patent enables the patent holder to pursue action against infringement.

The court dismissed the defendant's application under Order VII Rule 11 and finds no reasons to reject the suit. The issue of territorial jurisdiction was not raised or contested during the arguments and will be addressed later. The case is pending, and the re-notification is scheduled for 1st August 2023.

Nokia Technologies Oy vs Guangdong Oppo Mobile Telecommunications Corp Ltd & Ors.

Forum: High Court of Delhi

Case No.: FAO(OS) (COMM) 321/2022 & CM APPL. 53576-53579/2022

Judgment Dated: July 3, 2023

Issues:

- Whether the Court has the power to pass a pro-tem (temporary) order without conducting an exhaustive exploration of the merits of the case?
- Whether, under the facts and circumstances of the present case, a pro-tem order is necessary? As one party is seeking an interim order,

to maintain the status quo or protect their interests until the full trial takes place.

Judgment:

Nokia and Oppo entered into a cross-licence agreement for use of Nokia's SEPs in 2018 for a period of three years which expired 30th June 2021. Nokia filed the underlying suit for infringement of its three SEPs upon failure of execution of a fresh licence agreement between the parties. The underlying suit was filed before a Single Judge in July 2021. The Single Judge dismissed Nokia's application stating that the court lacked the power to do so without examining the merits of the case. The Appellant, Nokia, then filed the present appeal before the division bench against the order dated 17th November 2022 passed by the Single Judge.

Nokia contended that while seeking the pro-tem deposit, sufficient facts and law had been pleaded by it before the learned Single Judge. Nokia submitted that admitting to the past licensor-licensee relationship between the two companies, Oppo had also offered to make payments of royalties for a fresh licence. It was further contended by Nokia that international and local jurisprudence mandate payment of security deposits by an implementer of SEPs at the pro-tem stage in almost all cases. Nokia stated that Oppo had been subject to injunction orders in Germany as it had been found to be an unwilling licensee by the Courts in Germany.

Nokia further contended that most of the issues raised in the present appeal have been recently decided by the Court in Intex Technologies (India) Ltd. Vs. Telefonaktiebolaget L.M. Ericsson (hereinafter referred to as 'Intex Vs. Ericsson') and are no longer res integra. Relying on the judgment in Intex Vs. Ericsson, Nokia stated that the judgement specifically held that implementers of SEPs are obligated to furnish security to the owner of SEP. Lastly, citing unstable financial condition of Oppo India, Nokia contended that it is also important to secure Nokia's interests and an order for deposit of money on a pro-tem basis won't enrich Nokia's account as it will only be deposited in the Court.

Oppo argued that a patent holder cannot seek an interim or even a permanent injunction as a matter of right in SEP matters. Comparing a pro-tem

arrangement to a conditional injunction order, Oppo submitted that before the grant of relief the plaintiff must pass the four-fold test stipulated by the learned Single Judge. Oppo further argued that there can be no finding of “unwillingness” prior to an assessment of the infringement, essentiality, and validity claims made by an SEP holder which is in accordance with the judgment in *Intex Vs. Ericsson* and is also the consistent practice across the world.

Oppo contended that only on the basis of Oppo being an ex-licensee or having admitted an obligation to make interim payments, a prima facie case cannot be said to be established against Oppo. Arguing further against the pro-tem security deposit, Oppo submitted that the claimed assurances given to make interim payments cannot be construed to be an admission of any liability or requirement to submit any deposits during litigation in Court as the same were made in an effort to settle the dispute outside of litigation.

The Court, after hearing both the parties, held that payment of a pro-tem security is the implementer’s obligation in the negotiation phase itself. The implementer cannot continue to derive benefit by using the SEP technology without making any payments for such use if the negotiations between the parties fail. The Court, referring to *Intex Vs. Ericsson*, affirmed that the Indian Courts have the power to pass deposit orders even on the first date of hearing, if the facts so warrant. The Court observed that it takes time to examine various aspects on merits for deciding an application for interim relief and if no security is offered to the SEP holder during the interregnum, the implementer gets an unfair advantage over the SEP holder as well as other willing licensees in the market.

The Court clarified that a pro-tem security order does not confer any advantage upon an SEP holder as it only balances the asymmetric advantage that an implementer has over an SEP holder. Further, it clarified that a pro-tem security order is not like an injunction order as it does not stop or prevent the manufacturing and sale of the infringing devices. The Court also clarified that Section 140(1)(iii)(d) of the Patents Act is not applicable to the facts of the present case as the said Section only prevents a patent licensor from including terms which prevent challenge to the validity of the patent in question in a licence agreement. The said Section does not warrant

that an ex-licensee shall not be required to provide pro-tem security payment, at the interim stage, to the SEP holder.

Further, the Court, in agreement with Nokia's contentions and referring to the judgement in Intex Vs. Ericsson, held that the four-fold test as stipulated in the impugned judgment passed by the learned Single Judge is contrary to law. The Court while taking into account Section 151, Order XII Rule 6, Order XXXIX Rule 10 CPC held that Indian law under the said sections empowers the Courts to pass orders for deposit of a pro-tem amount with the court in case the Defendant admits that it owes money to the Plaintiff. The Court stated that in view of the suit filed by Oppo in China for determination of FRAND rate and the fact that Oppo had already paid royalty for three years without raising any dispute over the essentiality or validity of Nokia's patents at any stage earlier, a prima facie case of infringement can be made out in the present case.

Bayer Healthcare LLC vs. NATCO Pharma Limited

Forum: High Court of Delhi

Case No.: CS(COMM) 343/2019, I.As. 8878/2019, 9685/2019, 1178/2022, CS(COMM) 660/2022 and I.As. 15573/2022, 15574/2022, 1432/2023, 1848/2023

Judgment Dated: July 5, 2023

Issues:

- Whether an interim injunction should be granted against the defendant for potential patent infringement?
- Whether the defendant has raised a credible challenge to the vulnerability of the patent?
- Whether the product/process claimed in the subsequent patent was 'covered' in the earlier patent?

Judgment:

Bayer Healthcare LLC claimed an interim injunction against Natco Pharma Ltd. based on the patent for a molecule referred to as the "suit patent." This molecule was claimed to be a new chemical entity and was given the

International Non-proprietary Name (INN) "REGORAFENIB." The case was heard by a Single Judge Bench, Justice Navin Chawla.

In this case, the plaintiff holds a valid patent for the drug REGORAFENIB, which is used to treat cancer. They claim to have obtained an import license and have been selling the drug in various countries, including India, since 2015. The plaintiff argues that REGORAFENIB is a significant medical advancement, approved by the US FDA, and has proven to extend the lives of cancer patients.

On the other hand, the defendant asserts that the plaintiff had prior knowledge of REGORAFENIB when they filed a genus patent. During the patent prosecution, the plaintiff made amendments that excluded certain compounds, including REGORAFENIB, from the original patent application. The defendant alleges that this action allowed REGORAFENIB to enter the public domain when the genus patent expired.

The Court referred to previous cases (*B.P. Radhey Shyam v. Hindustan Metal Industries*; *F. Hoffmann-LA Roche Ltd. v. Cipla Ltd.*; *Novartis AG v. Union of India*; *AstraZeneca AB v. INTA's Pharmaceuticals Ltd.*; and *FMC Corporation v. GSP Crop Science Pt. Ltd.*) to establish that an old patent or lack of challenges to its validity does not presume its validity. The defendant's obligation was to show the patent's vulnerability and did not prove its invalidity.

The Court emphasized that a patent application must accurately describe the invention and its operation, including the best method known to the applicant. Once the patent term expires, the subject matter covered by the patent is no longer entitled to protection.

The plaintiff had filed a divisional application after deleting a reference to REGROFENIB in the original specification. The defendant claimed that the divisional application had been rejected for not meeting the criteria under the Patents Act, which raised a credible defence.

The plaintiff admitted that the said patent was covered by a genus patent that had already expired, which weakened their case for an interim injunction.

The court expressed the view that public interest demanded broad access to an affordable anti-cancer drug like REGORAFENIB. This drug could be a matter of life and death for certain patients and given the nature of the disease it aimed to treat; its affordability played a crucial role in making it accessible to a larger population. The defendant's product was significantly cheaper than the plaintiff's, making it more affordable for the public. Therefore, the Court refused to grant an injunction, considering the credible challenge to the patent and the importance of affordability in accessing the drug.

Considering these factors, the Court concluded that it would not be appropriate to prohibit Natco Pharma Ltd. from selling the product, especially when there was a legitimate challenge to the patent, and Bayer had already enjoyed full patent protection for the relevant term.

The Court decided against granting the interim injunction, considering the significance of affordable access to the drug for the wider public, the ongoing patent challenge, and the previous protection Bayer had received for a broader category patent.

Humanity Life Extension LLC vs Union Of India And Anr.

Forum: High Court of Delhi
Case No.: W.P.(C) 12238/2019
Judgment Dated: July 20, 2023

Issue:

- Whether the amendments in Rule 138 {Patents (Amendment) Rules 2016}, is ultra vires to Section 159 of the Patents Act, 1970 read in conjunction with the Patents (Amendment) Act No. 38 of 2002 and Patents (Amendment) Act No. 15 of 2005 and Rule 23 of the Patents Rules, 2021 read in conjunction with Rule 49.6 of the PCT Regulations?

Judgment:

The petitioner Humanity Life Extension LLC, who happened to miss filing of a national phase application in India within the prescribed period of thirty-one months from the date of priority, contends that the amendments in Rule 138 {Patents (Amendment) Rules 2016}, is ultra vires to Section 159 of the Patents Act, 1970 read in conjunction with the Patents (Amendment) Act No. 38 of 2002 and Patents (Amendment) Act No. 15 of 2005 and Rule 23 of the Patents Rules, 2021 read in conjunction with Rule 49.6 of the PCT Regulations.

In simple terms the petitioner's case was that since India is a signatory to the PCT and that the Patents Act and the Patents Rules were suitably modified for complying with the obligations under the PCT including provisions of Rule 49.6 of the PCT Regulations, Section 159 of the Patent Act does not empower the Central Government to make rules, which militates against the provisions of the PCT.

Rule 138 of Patents (Amendment) Rules 2016, which confers Controller with the power to extend the prescribed time reads out as:

“138. Power to extend time prescribed.- (1) Except for the time prescribed in clause (i) of sub-rule (4) of rule 20, sub-rule (6) of rule 20, rule 21, sub-rules (1), (5) and (6) of rule 24B, sub-rules (10) and (11) of rule 24C, sub-rule (4) of rule 55, sub-rule (1A) of rule 80 and sub-rules (1) and (2) of rule 130, the time prescribed by these rules for doing of any act or the taking of any proceeding thereunder may be extended by the Controller for a period of one month, if he thinks it fit to do so and upon such terms as he may direct.

(2) Any request for extension of time prescribed by these rules for the doing of any act or the taking of any proceeding thereunder shall be made before the expiry of such time prescribed in these rules.”

Rule 138 as currently in force compared to the preceding Rule 138, extended the scope of carved-out exceptions for applicability of Rule 138, and denudes the Controller of powers to condone the delay in respect of time limit to file national phase application.

Section 159 on the other side, concisely confers Central Government with power to make rules, while Patents Rule 23 states that the provisions of said Rule shall be supplemental to the PCT and the regulation and the

administrative instructions made thereunder and that in case of a conflict between any provisions of the Rules contained in this chapter and provisions of the Treaty and the regulations and the administrative instructions made thereunder, the provisions of the Treaty and the regulations and administrative instructions made thereunder shall apply in relation to international applications. While Rule 49.6 of the PCT Regulations, stipulates that the designated office is required to reinstate rights in respect of the International Application, if it finds that the delay in meeting the timeline was unintentional.

The court taking cues from decision of Co-ordinate bench of Delhi High Court in *Diebold Self Service Systems v. Union of India*, refused the petitioner's request for setting aside amendments of 2016 to Rule 138 for not being consistent with Rule 49.6 of the PCT Regulations and restricting the condonation of delay in filing of the national phase application. The Court held that reinstatement of rights after failure to perform the acts referred to in Article 22 as provided in Rule 49.6 of PCT regulation are subject to satisfaction of condition laid down in paragraph (f) of Rule 49.6. Paragraph (f) of Rule 49.6 summarizes that an incompatibility of paragraphs (a) to (e) of Rule 49.6 of PCT regulation with the national law of the designated office, render non-applicability of Rule 49.6, that would persist in respect of that designated office. Further, as India has expressed its reservations in respect of Rule 49.6(f) of the PCT Regulations, provisions provided under Rule 49.6(a) - (e) of the PCT Regulations are not applicable in India.

The judgement, however, doesn't sync with progressive approach adopted by the same court in many other judgements, some of them with similar cause of action, where non-compliance of non-extendable timelines had been obviated, albeit for different timeline and on different grounds, and by exercising its writ jurisdiction. In *European Commission vs Union of India*, Delhi High Court directed the Controller General of Patents to consider the response to FER filed by the applicant after the lapse of mandatory timeline and the factual matrix of said case was in essence similar to the present case, that is lapse on part of agent to act within the prescribed timeline. There appears to be no difference among different timelines, except that they are being extendable or non-extendable, at least as per the statutory provisions. However, considering that courts have contrarily decided on the gravity of

the mandatory nature of timelines in different cases, development of clear jurisprudence regarding mandatory nature of timeline would still take some time.

Oyster Point Pharma Inc vs The Controller Of Patents And Anr.

Forum: High Court of Calcutta

Case No.: AID NO.10 of 2022

Judgment Dated: July 26, 2023

Issue:

- Whether the details of the experiments conducted, comparative studies made, and their conclusive results should be considered to determine efficacy of a patent?

Judgment:

On May 5, 2011, Oyster Point Pharma Inc., a biopharmaceutical firm that discovers, develops, and markets innovative ocular surface treatments (the appellant), filed Patent Application No. 1879/KOLNP/2011 under Section 117A of the Patents Act of 1970. On September 16, 2021, the Assistant Controller of Patents and Designs refused the grant. Due to three prior art references, the application was refused under sections 2(1)(ja) and 3(d) of the Patents Act. The appellant claimed that the respondent failed to acknowledge the revised claims' greater efficacy.

The current invention relates to a stereospecific synthesis of (R)-5(E)-2-pyrrolidin-3-ylvinyl pyrimidine, its salts, and novel polymorphic salts. These not only treat pain and inflammation but also treat central and autonomic nervous system failure. The appellant voluntarily submitted claims 1-35 and Form 13 amending claims 1-9 on October 31, 2017, and October 22, 2018. The FERs were issued on July 10, 2019. On February 11, 2020, the appellant submitted the response and fresh claims. A hearing notice was issued on July 6, 2020. The appellant provided comprehensive written responses and updated claims 1 through 5 on September 11, 2020.

Respondent No. 2 refused the application, citing D1, D2, and D3. The rejection was due to a lack of innovative steps and Section 3(d) of the Indian Patents Act.

The chemical (R)-5-((E)-2-pyrroliding-3-ylvinyl)pyrimidine galactarate salt is talked about in document D1. It does not, however, give a competent person comprehensive knowledge of the compounds claimed in the subject invention or their intended features. The free base of (R)-5-((E)-2-pyrroliding-3-ylvinyl) pyrimidine is viscous and stable. To be marketed, the molecule's stability, solubility, production efficiency, formulation, and repeatability must be adjusted. The respondents do not understand how the PCT disclosure demonstrates that the mono-citrate salt can be obtained in stable, free-flowing solid forms that are both amorphous and crystalline, are not sensitive to moisture or temperature, are not hygroscopic, and do not deliquesce during stability testing. This result could only be obtained by specialized testing. As a result, producing a pharmaceutical-grade salt only from D2 and D3 acids is difficult. The order did not say anything about how the patent application in question lacked innovative processes. The respondents ignored the appellant's amended claims 1–5 and Appendix C, which show that the (R)-5-((E)-2-pyrroliding-3-ylvinyl) pyrimidine mono citrate salt has improved efficacy. The new claims indicate the salt compound's potency.

Furthermore, the respondent failed to consider the additional experimental evidence provided with the Written Submissions in support of the claimed invention. The appellant contends that the earlier case law in *Novartis AG v. Union of India (2013) 6 SCC* requires the prosecution to consider experimental evidence establishing the efficacy of a medication or substance. The claimed invention, according to the respondents, is essentially a novel mono-citrate salt of (R)-5-((E)-2-pyrroliding-3-ylvinyl)pyrimidine with no added effectiveness. The assertion is supported by the pillars of purity, stability, solubility, and bioavailability. Because the objection was lodged late, the Assistant Controller did not consider Appendices A, B, and C when issuing the disputed decision, according to Section 2(1)(ja) of the Act. Because the invention is a "new form of a known substance," it cannot be patented unless its efficacy differs significantly from that of the known substance. Furthermore, the absence of a Second

Examination Report (SER) would not have invalidated the appellant's claims. The compounds suitable for commercial use could not have been identified without prolonged and rigorous additional experimentation by a skilled individual, according to Section 2(1)(ja) of the Act. The viscous oil (R)-5-((E)-2-pyrroliding-3-ylvinyl)pyrimidine has limited solubility and stability in its free base form. According to the PCT specification for the claimed invention, stable, free-flowing crystalline and amorphous solid forms of mono-citrate salt are possible. Stability tests reveal no temperature or moisture sensitivity, hygroscopicity, or deliquescence. Such results necessitate extensive research.

The court emphasized that it is necessary to evaluate the prior art to establish whether the claimed invention, based on its disclosures, would have been evident to a person of ordinary competence in the art. As a result, the Controller must assess what is known and how a person of ordinary skill in the art could apply that knowledge to the invention under consideration, as stated in the application under examination. In the absence of such an approach, Section 2(1)(ja) of the Act prevents the rejection of the patent application. Respondent No. 2 erred in deciding that "*it would have been obvious to a person skilled in the art to try and arrive at the claimed alleged invention with a reasonable expectation of success to achieve the desired result without any inventive ingenuity.*" The respondent authority's prior art does not demonstrate that the appellant's claim was obvious. The order makes no mention of how the appellant attempted to distinguish D1 from innovation. The appellant identified flaws in prior art document D1. This is ignored by the order. As a result, the allegation that the asserted invention incorporates creative steps beyond D1 is unfounded.

The Court referred to *Novartis AG v. Union of India (2013)*, 6 SCC, which defines What exactly is "efficacy"? A patentable drug is a unique, more effective variation of an existing drug. A trained individual, on the other hand, cannot judge the efficacy of a substance without considering trial findings and comparison studies. It should have reviewed the experiments, comparative analyses, and decisive findings in Appendices A, B, and C to support the claimed invention before passing the order. The Act does not specify a time limit for filing new papers following the filing of a patent application. Drug development is difficult. When enrolling, it may not

disclose all of the information. Additional testing may be required before a drug enters clinical trials. Appendix C demonstrated the mono-citrate salt's nAChR subtype action. The compound's potency increased as a result of structural and functional adaptations. Appendices A, B, and C all validated the substance's efficacy. The Controller discarded Appendices A, B, and C without explanation. The goal was to obtain a stable salt for use in pharmaceutical formulation, and the disputed decision did not analyze or consider the stability data in Appendix A. The issuance of the Second Examination Report (SER) was not needed, and its concealment would not jeopardize the appellant's rights. Regardless of the decision, Section 13(3) must be followed. Furthermore, the Assistant Controller made a mistake by not issuing the SER in violation of Section 13(3) of the Act. The court concluded that when determining efficacy, the Controller should have considered the specifics of the investigations, comparative studies, and their results. After concluding that the Act has no time limit forbidding an applicant from submitting additional papers after filing a patent application, the court reversed its ruling and remanded the case to the respondent.

Communication Components Antenna Inc. v. Rosenberger Hochfrequenztechnik GMBH & Co KG & Ors

Forum: High Court of Delhi

Case No.: CS(COMM) 653/2019 and CC(COMM) 22/2022, I.A.
16988/2019, 7640/2022, 14592/2022

Order Dated: July 5, 2021

Issues:

- Whether the suit patent IN 240893 obligated to be revoked?
- Whether the suit patent was indeed infringed by the defendants?
- Whether the plaintiff entitled to a permanent injunction and damages/rendition of accounts?

Judgment:

This case concerned a patent infringement action concerning the plaintiff's patent IN240893 titled 'Asymmetrical Beams for Spectrum Efficiency.' The plaintiff, Communication Components Antena Inc., claimed that the defendants, Rosenberger Hochfrequenztechnik GmbH & Co. KG and others, infringed its patent rights. Furthermore, the defendants filed a counterclaim in which they sought the revocation of the patent under Section 104 of the Patents Act.

The court acknowledged the significant issues at hand, namely, the validity of the patent, infringement allegations, and the plaintiff's entitlement to remedies. The Patent Rules allowed summary adjudication for cases where the patent had less than a five-year term remaining, and certain conditions were met.

The court recognized the urgency in addressing the issues promptly. With the consent of both parties, the court directed the parties to finalize their expert affidavits on infringement and invalidity within four weeks. Furthermore, the defendants were instructed to provide details of their unencumbered assets valued at approximately Rs. 100 crores in India.

The court facilitated a structured process for trial preparation and evidence presentation. Time limits for cross-examination were established for both technical and non-technical witnesses. The evidence was recorded before the court with live transcription, and the costs were shared equally by the parties. The court scheduled further proceedings for trial arrangement and evidence recording.

In conclusion, it can be stated that the court ensured that the summary adjudication process was conducted efficiently, while respecting the parties' rights and facilitating a fair trial. The matter was treated as a part-heard case, and the court was set to address the issues raised by both parties in accordance with the Patent Rules.

Telefonaktiebolaget LM Ericsson (PUBL) vs Competition Commission of India & Anr.

Forum: High Court of Delhi

Issues:

- Whether the CCI possessed the authority to investigate and adjudicate matters pertaining to licencing conditions imposed by patentees, particularly within the context of SEPs.
- Whether the provisions of the Patents Act, 1970 and the Competition Act, 2002 were in conflict, and if so, which law should have prevailed in such cases, was examined.

Judgment:

The case presented a pivotal intersection between patent law and competition law, revolving around the power of the CCI to inquire into agreements involving licencing conditions imposed by patent holders. The court conducted a comprehensive analysis that delved into the nuanced aspects of both Acts, with a particular focus on the jurisdictional clash between them.

The factual context of the agreements entered into by Ericsson and other telecom companies was taken into account. The court examined the principles of competition law, with a focus on the significance of preventing anticompetitive behaviour, including the establishment of barriers to entry and the elimination of competitors from the market. It also delved into the aspects of consumer welfare, innovation, and economic development that were aimed to be promoted by competition law.

The court's reasoning was based on legal principles such as the maxim "generalialia specialibus non derogant" and the principle that special laws prevailed over general laws. The court emphasised the legislative intent behind the Patents Act, 1970, which had provided a comprehensive framework for issues related to licencing conditions, abuse of patent rights, and anticompetitive practises in the context of patents.

The argument regarding whether the provisions of the Competition Act, 2002 could override the provisions of the Patents Act, 1970 was addressed by the court. The interplay between the two statutes was critically analysed,

and it was concluded that the Patents Act was the special law governing issues pertaining to patent rights, licencing conditions, and abuse of patentee status.

Based on its analysis, the court determined that the CCI lacked the authority to conduct the inquiry into the licencing conditions imposed by Ericsson. The court emphasised that the Patents Act had provided a comprehensive framework for addressing such issues, and the CCI's jurisdiction had been limited by the domain of the Patents Act. In conclusion, the court quashed the proceedings initiated by the CCI against Ericsson, asserting that the CCI lacked the power to conduct an inquiry into the licencing conditions imposed by the patentees. The court's judgement upheld the primacy of the Patents Act in dealing with issues related to patent rights, licencing conditions, and abuse of patentee status, while reiterating the importance of maintaining a balance between competition and innovation. The judgement has clarified the respective scopes of the Patents Act, 1970, and the Competition Act, 2002, in the context of agreements involving patent rights, contributing to the legal landscape's understanding of the interplay between patent law and competition law.

RxPrism Health Systems Private Limited v. Canva Pty. Ltd.

Forum: High Court of Delhi

Case No.: CS(COMM) 573/2021 and I.A. 14842/2021

Order Dated: July 18, 2023

Issues:

- Whether the defendant's Canva product, specifically the component incorporating the 'Present and Record' feature, constituted an infringement upon the plaintiff's patent (IN360726)?
- The subject matter of the case pertained to the potential vulnerability of the Plaintiff's patent (IN360726) to invalidity claims, specifically in relation to prior art documents such as Auto-Auditorium, Loom, and the 2016 edition of Microsoft PowerPoint?

Judgment:

The matter concerned a legal dispute regarding patent infringement involving Rxprism Health Systems Pvt. Ltd. (Plaintiff) and Canva Pty. Ltd. & Others (Defendants). The Plaintiff possessed a patent (IN360726) for a system and methodology that enabled users to exhibit their items through the utilization of interactive content player technology. The Plaintiff alleged that the Defendant's Canva product included a function known as 'Present and Record' that was believed to be in violation of their patented technology.

The Plaintiff asserted that the Defendant's feature satisfied all components of their patent claims. On the other hand, the Defendant claimed that their product did not violate the Plaintiff's patent, contending that notable distinctions may be observed between the two systems. The Plaintiff successfully built a prima facie case of infringement by employing claim charts to illustrate and demonstrate that the Defendant's feature incorporated the essential aspects of their patented technology.

With regards to the issue of invalidity, the Defendant's main emphasis lay on the 2016 iteration of Microsoft PowerPoint. Nevertheless, the court determined that the Plaintiff's invention exhibits inventiveness in comparison to the most closely related prior arts, namely Auto-Auditorium, Loom, and the 2016 iteration of Microsoft PowerPoint. The court reached the determination that there had been no presentation of a credible or sustainable challenge to the validity of the patent.

The written statement provided by the Defendant utilized wording that implies the Plaintiff's motives involved obtaining an excessively high license fee and pressuring the Defendant into accepting unfavorable conditions. The court deemed these terms to be in violation of acceptable wording in legal documents and not justified in a case involving patent infringement. The instances of *Raj Parkash v. Mangat Ram Chowdhury* and *F. Hoffman La Roche v. Cipla* were also cited as references. The conduct exhibited by the Defendant, wherein they initially asserted ownership of the technology and thereafter relinquished their pursuit of associated applications, gives rise to apprehensions.

Based on an evaluation of the conflict between convenience and potential for irreparable harm to the Plaintiff's licensing prospects, the court decided in favor of the Plaintiff. The Defendant was prohibited from offering the

'Present and Record' functionality inside their Canva product. Furthermore, the Defendant is instructed to provide a sum of Rs. 50 lakhs as a form of collateral for the Plaintiff's assertions on the previous utilization of the infringing characteristic. The Plaintiff is granted a monetary award of Rs. 5 lakhs. The determinations made by the court in this particular ruling do not carry legal weight in determining the ultimate outcome of the trial.

In summary, the court has rendered a verdict in favor of the Plaintiff with regards to the matters of infringement and invalidity. As a result, the Defendant is prohibited from utilizing the infringing feature, a security deposit is mandated, and the Plaintiff is granted costs. The case is still pending more trial proceedings.

Vifor International Ltd & Anr. vs Dr Reddys Laboratories Limited

Forum: High Court of Delhi
Case No.: CS(COMM) 261/2021
Order Dated: July 24, 2023

Issue:

- Whether the plaintiff's patent suit claim solely a "product-by-process" claim?

Judgment:

The judgment deals with the collective disposal of three applications seeking an interim injunction against defendants MSN Laboratories Private Limited, Dr. Reddy's Laboratories Limited, Corona Remedies Private Limited, and Virchow Biotech Private Limited filed by Vifor International Limited in three separate suits asserting its rights for patent No. 221536 (IN'536). The judgment also disposes of an application filed by Corona Remedies Private Limited and Virchow Biotech Private Limited seeking an interim injunction restraining Vifor from threatening and hampering the business or taking any coercive action.

The suit patent is running in its last year term, which expires on October 20, 2023, and relates to a Ferric Carboxymaltose (FCM), and the process for preparation thereof. The product FCM can be used for intravenous treatment of iron deficiency and is commercialized by the patentee and its licensee under the brand names Encicarb, Ferium and Orofer FCM in India. Vifor in its application for injunction asserted that FCM is the first non-dextran water-soluble iron complex with the potential of higher and faster intravenous iron dosing. The product is also claimed to possess additional advantages such as advanced stability, easy sterilization, reduced toxicity, parenteral application etc.

At the core, the complexity of the suit resides in the presence of process limitations in claim language, which render the claim to be a "product-by-process" claim. Vifor's assertion of infringement is based on the assumption that the product claim of suit patent covers the product FCM, irrespective of the process used for its manufacture. The process elements described in a claim are merely used as an aid to describe the product and represent only an exemplary process but are not limitations that would restrict the scope of the product (FCM) claimed therein.

Vifor for strengthening its assertion of rights over FCM, irrespective of the process for its production, contended that the corresponding US patent of IN'536 has been listed in the US Food and Drug Administration's Orange Book as the "DS" or "Drug substance" and that no process patents, i.e., patents that have no claim over a product cannot be enlisted in the US FDA Orange Book. Vifor also emphasized that the suit patent has a huge commercial success and has been granted in 57 jurisdictions globally including major patent jurisdictions such as the US and EU. Net sales of FCM in India for the period 2017-21 is Rs. 650 Crores.

The Court, however, held a view contrary to the stand of Vifor, that the scope of claim 1 of IN'536 is limited to a product obtained by the specific process provided therein i.e., oxidation of maltodextrin using aqueous hypochlorite. The Court considered the process limitation in a claim in question as an essential and inextricable part and accordingly said claim does not cover any or all processes that may be used to obtain FCM or any or all processes for oxidation of maltodextrin.

To adjudicate the matter and to arrive at its view, the Court also deliberated upon issues of recognition of product-by-process patents by the Indian statutory regime by referring to the guidelines, which indicate that the Patent Office in India recognises the existence of product-by-process claims and thus have laid down the pre-requisites for assessment of novelty for product-by-process claims. The Court further held that the patentability of a product-by-process claim depends upon the product itself, only if it does not depend upon the method of production, which when provided, highlights that process steps in such claims are limitations but not additional/optional features of the product concerned.

The Court, borrowing the US concept of ‘Markman hearing’ and adhering to principles of claim construction laid down in *F. Hoffmann-La Roche Ltd. & Anr.*, conducted infringement analysis by determining the meaning and scope of the claims of the suit patent and comparing it to the allegedly infringing product/process. The court opined that in order to be categorised as a product claim, a product must be described by its composition and structure, both physical and chemical, but should not be limited by any process. However, claim 1 of IN’536 does not fit into the definition of ‘product claim’ and the limitations related to obtaining FCM by a specified process defined in said claim align the claim to be a ‘product-by-process claim’, and thus, the monopoly has to be limited to the product obtained by the specific process in the claims.

The Court, while performing claim construction not only considered complete specification but also considered prosecution history estoppel. The court considered the representation made by Vifor during the prosecution of the suit patent, that the novel properties in the product were attributable to characteristic features of the process mentioned therein, which are evident in the complete specification.

The court also considered the terminal disclaimer filed in corresponding US Patent Application 17/132652 which claims the iron (III) carbohydrate complex 'obtained by' oxidation of maltodextrins, and response filed in corresponding EP Application granted as EP1554315B1, wherein it was expressly stated that invention of claim 1 is different from the prior art in terms of using an alkali material, i.e., aqueous hypochlorite and that these submissions clearly amounts to an admission that this is the only feature

which distinguishes the product-by-process claim from the prior art and shows that step of oxidation of maltodextrins using aqueous hypochlorite in alkaline pH range is essential and critical to the determination of the scope of claim 1.

The Court, further considering the admission of Vifor in the complete specification, that iron carbohydrate complexes were already known, concluded that the only prima facie conclusion that could be reached is that the purported invention resides in preparing iron carbohydrate complexes with maltodextrin as the starting material and/or the step of oxidation using the specified oxidizing agent i.e., aqueous hypochlorite solution.

The process employed by the defendants to manufacture FCM involves the replacement of maltodextrin-oxidising agent i.e., Oxone in place of aqueous hypochlorite as used by Vifor. The chemical and physical properties of Oxone and sodium hypochlorite are distinct and different, and this difference gives an edge to the defendants in terms of avoiding the formation of undesired chlorinated by-products, inorganic impurities such as metal bromides, chlorides and carbonates, which impact the yield and purity of iron (III) Carboxymaltose, problems inherent in Vifor's process.

The Court also pointed out that Vifor while drafting claim 1, consciously and knowingly restricted the scope of the claim for obtaining FCM by a process where aqueous hypochlorite is used as an oxidising agent, which is not the oxidising agent used by the Defendants. This change of oxidizing agent is not insignificant or innocuous, particularly for a carefully drafted claim with a process limitation for oxidizing agent and thus brings out the defendants' process outside the scope of claim 1 of IN'536. As the defendants' product FCM is made by a different process, the defendants cannot be prima facie accused of an infringement.

In conclusion, this judgment not only sheds light into a less explored area related to "product-by-process" claims but also reconfirms that in order to obtain an interim injunction, the plaintiff must discharge the burden of proof by demonstrating that the rival process for manufacture is identical to the asserted process. Failure to discharge the burden of proof by the plaintiff would shift the balance of convenience against the plaintiffs and an irreparable injury be likely to be caused to the defendants if interim injunction is granted.

DESIGNS



TTK PRESTIGE LTD vs. KCM APPLIANCES PRIVATE LIMITED.

Forum: High Court of Delhi
Case No.: CS(COMM) 697/2022
Judgement dated: April 13, 2023

Issue: Whether the certificate of registration for design registered for a "Pressure Cooker with Container and Lid (Set) for Household," is invalid due to the registration of six designs instead of one, and whether the defendant's pressure cooker infringes the suit design.

Judgement: The Plaintiff filed a suit for infringement of its design 324727-001, which was registered for a "Pressure Cooker with Container and Lid (Set) for Household. The Defendant argued that the certificate of registration of a design is invalid because it registered six designs instead of one, contrary to the rule that one certificate can only register one design. Six different pressure cookers cannot be considered a set and, therefore, cannot be covered by one design registration.

However, the court mentioned that the definition of "set" in the Designs Rules is irrelevant to the validity of the design registration in question. The interpretation of "set" provided by Defendant is in line with the definition in the rules. The court agreed that six pressure cookers cannot be considered a set. Nevertheless, it concluded that the definition of "set" is not relevant to the current dispute. The suit design is registered in Class 07-02, which includes "Cooking appliances, utensils, and containers." The court noted that the term "article" in the Designs Act encompasses any part of an article capable of being made and sold separately. Therefore, multiple articles falling within the same class can be covered by one design registration.

The court further explained that the certificate of registration treats the "pressure cooker with container and lid" as a set for registration purposes. Thus, one pressure cooker with lid and five open pressure cookers can be legitimately covered by one design registration since they belong to the same class of articles. The court concluded that the certificate of registration covers essentially one design, involving the same shape and configuration of the container and lid, which constitutes a set.

The court examined the challenge to the validity of a suit design based on prior publication, novelty, originality, and functionality. The defendant argued that the suit design is invalid due to prior publication of a YouTube video featuring a pressure cooker similar to the design. However, the court determined that the YouTube pressure cooker and the suit design are different in shape, and therefore, the argument of prior publication is not applicable.

Regarding functionality, the court clarified that a design can have both functional and aesthetic attributes. While the pressure cooker lid may have

functional advantages, its aesthetic appeal is also relevant for design registration. The court held that the suit design has aesthetic attributes and qualifies for registration based on eye appeal.

In terms of piracy or infringement, the court compared the defendant's Impex Dripless pressure cooker with the suit design. It determined that the container and lid of the defendant's pressure cooker are similar in shape to the suit design. The minor differences mentioned by the defendant are considered trade variants or insignificant in light of the overall shape and configuration. Moreover, the court concluded that the defendant has borrowed the idea of the central depressed portion of the lid, which was originally devised by the plaintiff. Thus, the court restrained the defendant from manufacturing or selling the Impex Dripless pressure cookers or any other pressure cooker that infringes the suit design.

Philips Lighting Holding B.V. vs. Jai Prakash Agarwal and Another

Forum: High Court of Delhi
Case No.: CS(COMM) 46/2019
Order Dated: 22nd March 2022

Issue: Whether a mere trade variant to an existing design may be sufficient to establish protection under design law? Can the owner of such design file a suit for infringement?

Order: The Plaintiff, Philips Lighting Holding B.V. claims itself to be a prime manufacturer and seller of high quality and energy efficient lighting products, systems and services like stage lighting, home lighting, studio lighting, smart lighting etc. They claim to have developed a variety of innovative solutions with Light Emitting Diodes (LED).

Plaintiff claimed novelty of their products unique 'T-shape' design and its 'plug and play format' that allows the T-light to provide better and



focused lighting since the regular light bulbs are mostly available in a round shape and are incapable of the same.

The Plaintiff filed two suits claiming rights over the design of their new product, “T-shaped LED bulb” registered under the design registration no. 299147 (registered from the EUIPO on 08th May, 2017) on 06th November, 2017 in Class 26-04 against Jai Prakash Agarwal and Another and Syska LED Lights Pvt. Ltd. Further, claimed that the Defendants were misrepresenting their goods as that of the Plaintiff’s since the products looked deceptively similar to that of the Plaintiff’s. The Plaintiff had mentioned their date of Registration of Design as 08th May, 2015 in their application.

Plaintiff further claimed that the Defendants were misrepresenting their goods as that of the Plaintiff’s since the products looked similar to that of the Plaintiff. Further the Plaintiff stated that they are the Original Equipment Manufacturers (OEM) for many light companies in India like Havells, Eveready etc. These Plaintiff supplies these companies with T-Light and these companies sell it under their brand name in exchange for a license fee or other consideration as mentioned in their respective contracts.

On the contrary, the counsel on behalf of the Defendants stated that the definition of a “design” does not include a trademark and since the Plaintiff was claiming passing off in the design as a trademark, the registration of the design is entitled to be cancelled. The Plaintiff in order to claim its right over the design as “new” and “original” must depict that it had introduced a substantial change to the original design and that the Plaintiff had failed miserably in meeting the test, thus, is not entitled to any relief in this matter.

The counsel of the Defendant further submitted that the Design is entitled to be cancelled as it has already been published in India prior to the date of registration.

As per the Court, the test to determine if the design is “new” or “original” inter-alia is to determine and exclude ordinary trade variants into an old design. A design identical with or even materially similar to the relevant design should not have been published or registered previously. A slight

trivial or infinitesimal variation from the pre-existing design shall disqualify the relevant design for registration. The change introduced should be substantial. Therefore, the Court after applying the test to the present suit, found that the Plaintiff's design is just a trade variant of an already existing and registered design is disqualified for registration.

Novamax Industries LLP vs. Prem Appliances and Anr.

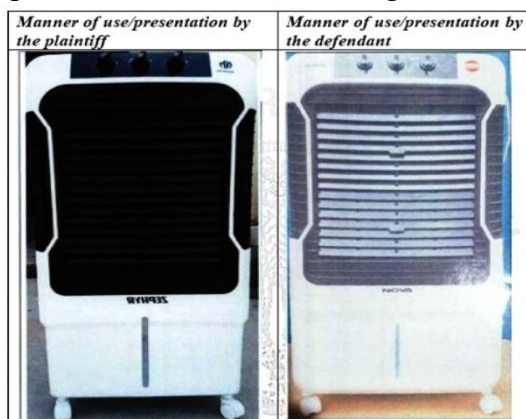
Forum: High Court of Delhi

Case No.: CS(COMM) 177/2021 & I.A. 5485/2021, I.A. 13748/2021, I.A. 7058/2022

Judgement Dated: 16th January 2023

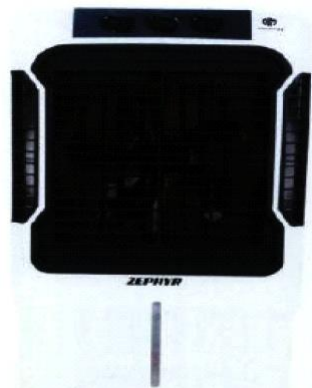
Issue: Whether a case of vulnerability to cancellation of the suit design was made out in terms of Section 19(1)(b) of the Designs Act?

Judgement: The present suit was filed by the plaintiff, the registered proprietor of Design No. 322384-002 (suit design) which was granted on 9th October 2019. The plaintiff was a manufacturer and seller of air coolers. The plaintiff's case was that the "NOVA" range of coolers sold by the defendant constituted infringement of the suit design. A pictorial representation of the same was produced as follows-



. Further, the defendant had filed an application to vacate the order dated 16th April 2021 wherein an *ex*

parte interim order in favour of the plaintiff was passed. The defendant agreed that the design of their “NOVA” range of coolers was identical to the suit design, however, he invoked section 22(3) of the Designs Act, 2000 (Designs Act) r/w section 19(1) of the Designs Act, to plead prior publication of the design as a ground for cancelation of the suit design. The defendant’s counsel further submitted that on the plaintiff’s website, their cooler “ZEPHYR” was published prior to 24th March 2019, which had the similar design as that of the NOVA range. The pictorial representation of



ZEPHYR cooler was produced as follows-

Further, it was also pointed out from the invoices produced by the plaintiff that ZEPHYR cooler was in fact sold prior to 9th October 2019. Thus, the Court held that the defendant had *prima facie* established prior publication of the plaintiff’s design, challenging the vulnerability of the suit design. Therefore, the said ground was validly available as a ground of defence to the defendant by way of Section 22(3) of the Designs Act. The Court further vacated the interim order dated 16th April 2021 and allowed the application filed by the defendant.

Havells India Limited vs. Panasonic Life Solutions India Pvt. Ltd. and Ors.

Forum: Delhi High Court

Case No.: CS (COMM) 261/2022, I.A. 6259/2022 and 7226/2022

Order Dated: 31st May 2022

Issue: Can the plea of passing off of design be allowed in case the Plaintiff also asserts trademark rights in the registered designs?

Order: The Plaintiff, Havells India sought interim injunction against the Defendant from manufacturing, marketing, selling (including on online platforms), using designs bearing Nos. 280666 and 328605, the VENICE PRIME series of ceiling fans which are identical or deceptively similar to Plaintiff's ENTICER series including ENTICER ART variants. The Defendant contended that since the Plaintiff had claimed trademark rights in its registered designs, the design registration had become vulnerable and was liable to be cancelled in accordance to Section 19(1)(e) of the Designs Act.

The Plaintiff, apart from pleading the use of registered design as a trademark for ENTICER/ENTICER ART series, also alleges that Defendant is blatantly copying the essential and ingenious features of the designs in its ENTICER/ENTICER ART fans as well as adopting the entire get-up, layout, colour scheme, motif patterns, trim, overall appearance, configuration, shape etc. amounting to passing off its products as that of the Plaintiff.

The Court noted that it is a settled law that parties can raise alternate and inconsistent pleas but should not be permitted to raise pleas which are mutually destructive of each other and even if the Plaintiff asserts a claim of trademark in a registered design, which makes a design vulnerable, it is open to the Plaintiff to plead that it has a goodwill and reputation and Defendant by misrepresentation is passing off its goods as that of the Plaintiff, thereby causing damage and injury. The Court held that a passing off action will lie when not limited to the trademark use alone but the claims are predicated on larger overall get-up, trade dress etc. The plea of passing off cannot be negated only on the ground that the Plaintiff has asserted trademark rights in the registered designs and requires consideration on its own merits and the suit, is maintainable in its present form.

The Court observed that a mere visual comparison shows that every attempt has been made by Defendant to come as close as possible to Plaintiff's fans. The Defendants were restrained from manufacturing, marketing, selling (including on the online platforms) the fans under the VENICE PRIME series or those which are identical or deceptively similar to them, using the designs of the Plaintiff and those which are colourable imitation or substantial reproduction of Plaintiff's get-up, layout, trade dress, colour scheme, pattern, shape, configuration etc. in the ENTICER ART-NS Stone series.

Diageo Brands B.V. and Ors. vs. Great Galleon Ventures Limited

Forum: High Court of Delhi

Case No.: 87/2021

Order Dated: 2nd August 2022

Issue: Whether the Plaintiff is entitled to injunction on grounds of infringement and passing off of its registered design?

Order: The Plaintiff, Diageo Brands sought injunction order against the Defendant, Great Galleon Ventures on grounds of infringing its registered design of Hipster bottle. The Court had initially granted an ad-interim injunction restraining the Defendant from selling the impugned bottles. The Defendant argued that since the Plaintiff's registered design is being disputed via cancellation action which is pending, the Plaintiff should not be granted any injunction. The Court held that if a design appears to be prima facie validly registered with all the necessary attributes for registration, and if the Plaintiff is able to demonstrate a strong case of infringement/passing off/imitation, an injunction should follow. The court observed that what is protected under the designs law is not the article itself, but the idea/conceptualization which has been applied upon it, that both design and the design which is to be applied to an article should go together. The court concluded that the Plaintiff's registered design was "new and original" and it was noted that while a bottle/hip flask was not a new or

novel invention by itself, the Plaintiff's Hipster product was the first in the market to take the visually-appealing features of a smartphone and applied onto pre-packaged alcohol. The Court found glaring similarities between both bottles and held that the Defendant's bottle was deceptively similar to the Plaintiff's registered design and case for infringement was made out. For assessment of passing off claims, it was observed that a trade dress is a combination of various elements that together create a strong visual impression. Analyzing both trade dresses, the Court concluded that it cannot be said that there is much similarity in labels, trade dress, and get-up of the respective trade dresses and that there is likelihood of confusion vis-à-vis origin of products. The Defendant's bottle was boldly displaying the GOA brand; labels were dissimilar, as well as their marketed prices. The Court held that key ingredients to prove passing off claims were not present in the instant case.

Diageo Brands B.V. & Anr. vs. Alcobrew Distilleries India Pvt

Forum: High Court of Delhi

Case No.: CS(COMM) 30/2022 & I.A. 725/2022

Judgement dated: December 19, 2022

Issue: Distinction created between the application of the Design Act 2000 and the Trademarks Act 1999 and the need for the plaintiff to establish the novelty and originality of its registered design vis-a-vis prior art, despite the design being registered.

Judgement: Diageo Brands B.V., a Dutch alcoholic beverage company, filed a law suit against Alcobrew Distilleries India Pvt Ltd in the Delhi High Court, alleging that the design of Alcobrew's "Golfer's shot" bottles infringed upon its "Scotch Hipster" range. Diageo claimed design piracy by the defendant under Section 22(1) of the Designs Act, 2000, and sought an injunction against the manufacture and sale of the bottles. However, the court dismissed the interlocutory application for a temporary injunction on

a prima facie basis, as the appropriate test to determine infringement in design cases is different from trademark cases, and the instructed eye test showed no infringement by the defendant. The judgment highlights a difference in interpretation of the law among judges of the same court, as it departs from a previous judgment on similar claims.

The court also discussed the distinction between the application of the Design Act 2000 and the Trademarks Act 1999, emphasizing the need for the plaintiff to establish the novelty and originality of its registered design compared to prior art, even if the design is registered. The defendant argued that the plaintiff's registered design was not novel due to prior publication, as it was identical to an existing international design. The court agreed with the defendant's arguments and dismissed the interlocutory application for a temporary injunction.

Relaxo Footwears Ltd. vs. Aqualite India Ltd.

Forum: High Court of Delhi

Case No.: FAO(OS) (COMM) 145/2019 and CM No. 29330/2019

Judgment dated: 27th October 2022

Issue: Whether the design of the footwear product of the Defendant is similar to that of the Plaintiff, and whether registration of the subject design is proscribed in Sections 4(a) and 4(c) of the Designs Act, 2000?

Judgment: The Appellant, Relaxo is engaged in the manufacturing and selling of various kinds of footwear and claims that it commenced its business in the year 1976. On 21st June 2017, the Appellant was granted registration of its design relating to footwear (slippers) under the Designs Act, 2000 bearing design registration no. 294938 (“subject design”). The Appellant claims that the subject design is novel, unique and originally created. In 2018, the Appellant discovered that the Respondent, Aqualite was manufacturing and selling the products which it claims infringes the subject design. Subsequently, the Appellant filed a suit claiming urgent interim relief.

The learned Single Judge asked the parties to carry out a market survey to ascertain the availability of third-party products similar to the infringing product. Based on this, the learned Single Judge noted that, (1) there were third-party products available in the market which were similar to the subject design; (2) the Appellant's application for registration of the subject design did not include any claim of novelty; (3) a letter sent by a Chinese manufacturer states that the strap of the footwear in the subject design was introduced in the market many years ago and became popular since 2016; and (4) the subject design appeared common to trade. Thus, the learned Single Judge held that the subject design lacked novelty and originality ("impugned order").

Before ascertaining the case, the Court first reproduced the subject design registration of the Appellant, as below.



TOP VIEW



BOTTOM VIEW



RIGHT SIDE VIEW



LEFT SIDE VIEW



FRONT VIEW








BACK VIEW

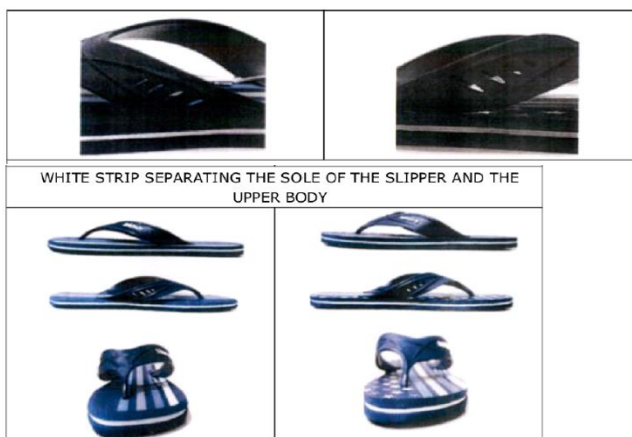


PERSPECTIVE VIEW

The Court noted that the Appellant claimed that “the novelty resides in the shape, configuration and surface pattern of the footwear as illustrated”, and that the Appellant specifically stated that it did not claim any right to the exclusive use of colours or the combination appearing in the subject design.

Thereafter, the Court drew a comparison of the two rival products, as below.

APPELLANTS (RELAXO)	RESPONDENTS (AQUALITE)
SURFACE PATTERN	
	
SHAPE AND PATTERN OF THE STRAP OF THE SLIPPERS	
	
PLACEMENT OF THE LABEL BEARING THE PRICE AND THE PRODUCT	
	
PLACEMENT OF THE LOGO/TRADE MARK ON THE PRODUCTS	
	
PATTERN AND NUMBER OF HOLES ON THE LEFT SIDE OF THE STRAP OF THE PRODUCTS	



The Court observed that the design of the product of the Respondent is *almost identical* to the subject design. The Court also observed that the finding of the learned Single Judge that the subject design lacked novelty and originality was premised on the results of the market survey, however the same cannot be relied upon.

The Court stated that “*it is not unusual for small players to copy designs which have become popular. It is not necessary for the proprietor of a design to pursue its remedies against each dealer/manufacturer selling infringing products... A proprietor of a registered design does not forfeit its right merely because it has not enforced the same against all infringers... It is open for the design holder to select the infringers that it wants to proceed against... the design holder retains the right to interdict infringement of the registered design notwithstanding that it has not proceeded against some infringers.*” The Court thus held that the finding that the subject design lacks novelty and originality is not acceptable.

The Court further observed that the finding in the impugned order that the subject design is common to trade is premised on the basis of the products available in the market. The Court noted that a mark, which is common to trade, cannot serve as a trademark as it would fail to perform the primary function of a trademark as the source identifier of the product. However,

this concept would have no application while considering infringement of a design. In the case of a design, what matters is the novelty. In terms of Section 4 of the Designs Act, for a design to be registered, it must be original and novel; not disclosed in any manner prior to registration; and should be significantly distinguishable from a known design or a combination of known designs. Thus, a mere trade variant would not be entitled to design protection.

As to whether the subject design is a mere trade variant or not, the Court observed that the Respondent has not produced sufficient material to ascertain and conclude the same. Thus, the impugned order of the learned Single judge is set aside.

Atomberg Technologies Private Limited V. Luker Electric Technologies Private Limited

Forum: High Court of Bombay

Case No: Commercial IP Suit (Lodging) No. 66 of 2023

Dated: 5th June 2023

Issue:

- Whether the registration for the design of the Defendant infringes upon the registered design of the Plaintiff?

Order:

The suit was filed by Atomberg Technologies Private Limited (plaintiff) seeking interim reliefs in the context of its registered design of ceiling fan named Atomberg Renesa Ceiling Fan challenging the registration of Luker Electric Technologies Private Limited (Defendants') fan design.

The Plaintiff claimed that its fan Atomberg Renesa Ceiling Fan is a registered design since September 8, 2018, and on March 21, 2022, Defendant fraudulently obtained design registration of two fans: Size zero Fan 1 and Size Zero Fan 2. Thus, Plaintiff filed a suit for design infringement and passing off and filed the present application for interim

relief. Opposing the suit, Defendant claimed that Plaintiff suppressed the material fact that the design under challenge was already in the public domain and was called the “Gorilla Ceiling Fans”. Defendant also submitted invoices showing that Atomberg Gorilla Renesa Ceiling Fans were sold in August 2018 i.e., before the registration of Plaintiff’s design on 8th September 2018. It also claimed that the Plaintiff could not have registered the design as it is not unique as per the provisions of the Designs Act.

The plaintiff submitted that as per provision of the Designs Act, for the claim of infringement of a registered design, as also the tort of passing off, the test of “look and feel” and “appeal to the eye” needs to be applied. The plaintiff also alleged that the defendant copied almost all the features of its registered design and the highlighted features of the plaintiff’s design in the plaint indicate its aesthetic aspects and what could be capricious features, which have nothing to do with functionality.

The defendant submitted that the plaintiff’s design was already in the public domain prior to grant of registration on 8th September 2018 and that therefore, the plaintiff is not entitled to rely upon the registration of such design for grant of interim reliefs.

Relying on Section 4 of the Designs Act, 2000, the court said that if a design is not new or original, is in the public domain, or is identical to known designs, the registration itself cannot be granted. Further any such registration if granted, can be cancelled as per Section 19.

The court considered social media posts showing pictures of Plaintiff’s fan with its house-marks “Gorilla” and “Atomberg”. These posts were made before the date of registration hence publication prior to the registration of Atom Berg’s design. Therefore, value of registration of design is diluted if material indicates that it was published before the registration date.

The court said that the Plaintiff’s registered design and the designs available in public domain before its registration are prima facie almost similar and

any difference is light and trivial. Thus, Plaintiff failed to make out a strong prima facie case about originality of its registered design.

Thus, the Court held that something more than mere similarity would have to be demonstrated by the plaintiff for successfully claiming interim reliefs and the plaintiff has not been able to make out that 'something more', as required under law, to successfully claim interim reliefs against the defendants on even on the aspect of passing off.

Since Plaintiff failed to make out a strong prima facie case against Defendant, the factors of balance of convenience and irreparable loss to the Plaintiff are insignificant. Therefore, the court dismissed the Plaintiff's application for interim relief.

Jayson Industries and Anr. vs Crown Craft (India) Pvt. Ltd.

Forum: High Court of Delhi

Case No.: CS(COMM) 580/2022, I.A. 13422/2022, I.A. 13425/2022

Order Dated: July 3, 2023







Issue:

- Whether the defendant's products are obvious and fraudulent imitations of their registered designs, constituting piracy?
- Whether the defendants' challenge to the suit designs' novelty and originality is credible?

Order:

The plaintiff, who holds Design Registrations 326707, 326883, and 326882, has accused the defendant of design piracy. Central to the plaintiff's claim is the novelty and uniqueness of the designs of their bucket, mug, and tub. According to the plaintiff, these products incorporate distinctive shapes, configurations, and surface patterns, setting them apart visually from similar items in the market. The plaintiff argued that the defendant's

products are obvious and fraudulent imitations of their registered designs, constituting piracy. The following comparison were made:

Plaintiff's designs	Defendant's pictures
	
	
	

To support their claims, the plaintiffs have presented various views of their registered designs, showcasing different angles and sections of each item. It was emphasized that the designs have been granted novelty based on their unique features, particularly the ribbed nature of the body and the flange-like extensions on the vessels' rims.

The dispute, initially filed before the District Judge (Commercial Court), was transferred to the High Court due to the defendant's plea challenging the validity of the suit designs. The district court had previously granted an ex-parte ad interim injunction in favour of the plaintiffs, restraining the defendant from selling, marketing, distributing, or supplying the disputed bucket, mug, and tub. The ex-parte interlocutory injunction remained in force, and the defendant sought relief and vacation of the injunction.

In response to the allegations, the defendant raised questions about the imitative nature of the designs and challenged the validity of the suit designs. The defendant argued that the Designs Act lacks a provision similar to the Trade Marks Act 1999, which statutorily presumes the validity of a registered trademark. Contrarily, the defendant claimed that there is no such presumption of validity for a registered design under the Designs Act. Additionally, the defendant contested the novelty and originality of the suit designs, seeking their cancellation based on grounds such as lack of novelty, originality, and prior publication.

The defendant presented various documents, including brochures and registered designs, to demonstrate the lack of novelty and originality in the suit designs. The argument emphasized that even slight differences in the shape of flanges or other minor changes would not save a design from invalidation if it were deceptively similar to prior art. Furthermore, the defendant contended that trade variants of existing prior art cannot be considered "original" within the meaning of the Designs Act. These contentions gave rise to a *prima facie* triable issue challenging the validity of the designs.

The court conducted a thorough examination of the application of the law to the presented facts, particularly focusing on the issue of design novelty. Based on the principles outlined in the Designs Act, the court raised doubts regarding the novelty and originality of the suit designs. It concluded that the suit designs lacked novelty and originality, leading to the rejection of the plaintiffs' request for an interlocutory injunction.

The court analysed the suit designs, specifically highlighting the plaintiffs' claimed novel and original features: the vertical ribs along the length of the designs and the flanges on the rim. However, upon careful examination of the prior art, the court found no convincing evidence that these features were indeed novel and original.

The court held that the vertical ribs along the length of the bucket, tub, and mug, as well as the extended flanges at the rim, were not unique to the plaintiffs' designs. It cited various prior art references that clearly demonstrated the existence and use of similar features before the plaintiffs' designs came into play. Following were the prior design documents:

- (i) Bathroom tub as uploaded by Sara China Bona Mould:



- (ii) Mug as uploaded by Sara China Bona Mould:



- (iii) Tub No. BN2103169 invoiced by Bona Mould to Crown Craft ,



- (iv) Mug No. BN2103170 invoiced by Bona Mould to Crown Craft,



- (v) Bucket from the catalogue of Migeplastics.



- (vi) Design 784645 registered in favour of David A. Richardson.



- (vii) SeMius Durable Practicle Solid Geometric Shape Storage Garbage Household Trash can available on [amazon .in](https://www.amazon.in) since 14 march 2019:



The court observed that the vertical ribs in the suit designs were identical to those found in the prior art. While there were some minor variations in the shape, number, and extent of protrusion of the flanges, the court considered these changes as trade variants rather than substantial differences. Therefore, the court deemed the defendants' challenge to the suit designs' novelty and originality credible, resulting in the rejection of the plaintiffs' request for an interlocutory injunction.

TTK Prestige Ltd. vs Gupta Light House



Forum: High Court of Delhi
Case No.: CS(COMM) 865/2022
Judgment Dated: July 24, 2023

Issue:

- Whether the defendant's pressure cookers either fraudulent or obviously imitative of the plaintiff's registered suit designs?

Judgment:

The plaintiff argued that the defendant's pressure cookers are either fraudulent or obviously imitative of their registered suit designs. The plaintiff presented a comparison of photographs, showcasing both their own pressure Handi cookers and the defendant's rival products as under.

The plaintiff's product	The defendant's product
	

The primary defence raised by the defendant was that the suit design is invalid due to prior publication. In response, the plaintiff refuted by stating that there is no evidence of prior publication of the suit design. They pointed out that any representations of pressure cookers with similar designs filed by the defendant occurred after the plaintiff's suit design was registered in 2004.

The defendant emphasized that the suit design has expired since its registration period ended in September 2019, making it accessible to the public for exploitation. As a result, the defendant argued that no permanent injunction against the use of the suit design could be granted, and there should be no order to deliver up any infringing goods.

Moreover, the defendant challenged the novelty and originality of the suit design, claiming that it was merely a replication of a pre-existing design—

the handi pressure cooker, a well-known cooking vessel used in India since ancient times. However, the court dismissed this argument, affirming the novelty and originality of the plaintiff's suit design.

The Delhi High Court concluded that the plaintiff's cooker design holds a valid registration, as it possesses distinctive eye appeal with its unconventional bulging mid/lower section, setting it apart from ordinary cookers and meeting the criteria for design registration. Furthermore, after conducting a thorough comparison between the suit design and the defendant's product, the court ruled in favor of the plaintiff, declaring the defendant's design to be imitative of the plaintiff's registered design. The court rejected the defendant's claim of prior publication due to the lack of substantial evidence supporting it.

Regarding the functionality argument, the court clarified that functional designs can still be eligible for registration if they possess aesthetic appeal. Since the suit design demonstrated such appeal, the court dismissed the plea that it was purely functional.

Although the court ruled out the possibility of a permanent injunction or delivery up of infringing goods, the plaintiff was granted the right to seek damages. The court directed the defendant to provide accounts of their earnings from sales of pressure cookers bearing the impugned designs. The plaintiff was also awarded costs for the litigation.

The court's judgment reaffirms the validity and uniqueness of the plaintiff's registered design while confirming the defendant's design as an imitation of the suit design. It serves as a significant precedent in design piracy cases, underlining the importance of recovering damages even if the suit design has expired.

DOMAIN NAMES



Snapdeal Private Limited vs. Godaddycom LLC And Ors

Forum: High Court of Delhi
Case No.: CS (COMM) 176/2021
Order Dated: 13th July 2022

Issue: Whether Domain Name Registrars could be held liable under Trade Marks Act?

Order: Snapdeal filed a Suit along with an application for an interim injunction against various DNRs, the Department of Telecommunications and the National Internet Exchange of India (NIXI) alleging that certain third parties, having no connection with Snapdeal, were registering domain names with the term “snapdeal” thereby infringing its trademark. Snapdeal did not implead any of the registrants and instead sought relief against the DNRs on the ground that the DNRs were facilitating the infringement of its trademark by third parties i.e., the registrants and were also themselves

infringing Snapdeal's trademark as per the provisions of the Trade Marks Act, 1999.

Snapdeal contended that the DNRs were providing alternate domain names, infringing its trademarks, to registrants, whose choice of domain names were unavailable and were charging a special price for such alternate domain names. Snapdeal also contended that the DNR was charging higher prices for alternate names involving popular trademarks such as "snapdeal". Further, Defendant No.1 had blocked the trademarks associated with "Go daddy" from appearing as alternate domain names which shows that they do have control over the alternate domain name options.

The DNR countered by arguing that they were intermediaries within the meaning of the Information Technology Act (IT Act) and were as such protected under the said IT Act. They argued that the process of providing alternate options to prospective registrants is entirely automated in nature and they have no control over it.

Snapdeal sought an interim injunction against the DNRs directing them to suspend registrations set out in Snapdeal's application and also restrain the DNRs from offering any domain names in future that infringe on Snapdeal's trademark.

The Court held that domain names qualify as electronic records, and as DNRs provide services with respect to domain names, which are sourced from a common Domain Name Registry, DNRs are "intermediaries" as per the IT Act.

The Court however observed that the DNRs in the present case were offering alternative domain names for a price, in case the domain name sought by the registrant is unavailable and were even charging a higher price for the domain names which were in demand, including the allegedly infringing marks of Snapdeal. The DNRs were therefore clearly acting for profit and in doing so, were using the allegedly infringing trademarks "in the course of trade". As such the DNRs were liable for infringement as per the Trade Marks Act.

The Court further rejected the contention of DNRs that they have absolutely no control over alternative domain names that are suggested to third-party registrants. The Court observed that it was an uncontroverted fact that no domain name, even reasonably proximate to “Go Daddy” i.e., trademark of Defendant No. 1, was available to third-party registrants. The Court further held that the algorithm, on the basis of which alternative domain names are made available is devised by each DNR itself, and it is the DNR’s responsibility to ensure that the alternative domain names do not infringe any registered trademark.

In the above circumstances, the Court held that if an intermediary provides services which are beyond the regular course of functions of an intermediary and operates for profit as a business enterprise, it cannot claim safe harbour protection under the IT Act for liabilities that arise from such functions.

Despite concluding that the DNRs may be held liable for infringement of the Trade Marks Act, the Court declined to grant an injunction restraining the DNRs from registering any domain name that may infringe Snapdeal’s trademark in future. The Court held that *quia timet action* cannot be predicated on hypothetical and imaginary infringements and it cannot be held in advance that all prospective alternative domain names which include Snapdeal as a word/thread would be infringing in nature. The Court ultimately held that Snapdeal has to undertake to petition the Court against each domain name that is registered and that it finds to be infringing and obtain relief on a case-by-case basis.

Eureka Forbes Ltd. vs. National Internet Exchange of India and Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 226/2021 and I.A. 15742/2022

Judgement Dated: 18th October 2022

Issue: Was the defendant’s domain name [violative of plaintiff’s statutory rights over its mark “AQUAGUARD”](#)?

Judgement: This present application was filed by defendant nos. 3 to 7 to modify/vary/vacate the previous order dated 17th May 2021. The defendants wished to use the domain name <http://www.rocareindia.com/> which was blocked/suspended by Defendant no. 2 (GoDaddy.com LLC) pursuant to order dated 17th May 2021, which brought the business of the defendant to a standstill. The plaintiff submitted that when any customer searched for Aquaguard repair service or its derivatives, they were directed to www.rocareindia.com and other related domain names, which violated its statutory rights over the mark “AQUAGUARD”. However, the Court observed that the domain name www.rocareindia.com did not violate the plaintiff’s rights in any manner and that there was no injunction against the defendants vide order dated 17th May 2021, from using the domain name www.rocareindia.com. Thus, the Court held that the said suspension should be uplifted by defendant no. 2 within 24 hours and the defendants must take due care and not misrepresent themselves as associated with the plaintiff. The same directions were applied for defendant no. 9 who was permitted to use its mark “GETAQUAEASY” vide order dated 23rd September 2022, wherein the Court had decided that the marks “AQUAGUARD” and “GETAQUAEASY” were not similar, and that the plaintiff cannot claim an exclusive right over the generic word “AQUA” as it would harm other businesses as well.

Adobe Inc. vs. Namase Patel and Others

Forum: Delhi High Court
Case No.: CS(COMM) 159/2022
Order Dated: 29 November 2022

Issue: The defendant, Namase Patel, secured the domain names, www.addobe.com and www.adobee.com, which the court held to be confusingly similar to the plaintiff’s marks. The defendant operated several sub-domains to include other trademarks such as Photoshop and Spark and

used URLs such as photoshop.adobe.com and spark.adobee.com to infect the computers of users with malware. The defendant used a catch-all site offering e-mail services provided by a domain name investor platform, www.above.com. This site drew in unsuspecting users who may have misspelled the word adobe. In this way, the defendant accessed confidential emails by allowing users to assume he was a representative of the plaintiff. This amounted to passing off of the defendant's services as those of the plaintiff.

Order: The plaintiff cited several World Intellectual Property Organisation domain dispute decisions in which the defendant had been held a habitual offender involved in cybersquatting and infringing trademarks of well-known entities by securing deceptively similar named domains.

In the final hearing, the court heard that the defendant was untraceable and could not be found. Wwww.above.com was not responding to court's order. The recent activities of the defendant's email account indicated he was in the USA. The court in its judgment ruled in favour of the plaintiff, granting the permanent injunction against the defendant and making the various orders relating to the domain names. In awarding the damages claimed by the plaintiff, the court accepted that the defendant was a habitual cybersquatter and domain name infringer, and made it clear that the damages were intended to be a deterrent.

Yonex Company Ltd. vs. John Doe

Forum: High Court of Delhi

Case No.: CS (COMM) 293/2022 and IA No. 6992/2022

Judgment Dated: 23rd September 2022

Issue: Whether a permanent injunction to be passed against the domain name *www.yonexindiastore.com* on account of it causing infringement against the Plaintiff's well-known mark 'YONEX'?

Judgment: The Plaintiff filed the present suit seeking permanent injunction restraining infringement of the trademark, copyright, passing off, rendition of accounts and other reliefs in respect of their registered trademark ‘YONEX’. The said mark is used by the Plaintiff for various sporting equipment, sporting goods, rackets, shuttlecocks, sporting apparel, etc. The Plaintiff was aggrieved by the registration of the domain name *www.yonexindiastore.com* by unknown parties qua which the reliefs were sought. The Court had already passed an interim injunction against the said domain name and directed the Domain Name Registrar (DNR) to block the website and maintain status quo. The impugned website had eventually been taken down.

The Court observed that the mark ‘YONEX’ and the logo



is globally used and recognised. The mark is registered as a trademark in India since 1980 and also as an artistic work under the Copyright Act, 1957. The Court recognised the immense goodwill accrued in the Plaintiff’s mark, and further that the said mark has been recognised as a well-known mark in India in terms of Sections 2(1)(zg), 11(6) and (7) of the Trade Marks Act, 1999 vide IPAB Order dated 18/06/2020.

In view of the same, the Court held that the impugned domain name *www.yonexindiastore.com* shall continue to remain blocked and locked by the DNR, and the name shall subsequently be transferred to the Plaintiff.

PRIVACY/PERSONALITY RIGHTS



Ms. Aaradhya Bachchan and Anr. vs. Bollywood Time & Ors.

Forum: High Court of Delhi

Case No.: CS(COMM) 230/2023

Order dated: April 20, 2023

Issue: Whether intermediaries needed to be proactive in observing due diligence over the content related to children, uploaded by users and hosted on their platforms?

Order: Plaintiff 1 namely, Aaradhya Bachchan, is the daughter of Abhishek Bachchan and Aishwarya Rai Bachchan and the granddaughter of Amitabh

Bachchan and Jaya Bachchan, all of whom are celebrities in their own right. The plaint had been filed by her father with the grievance that although plaintiff 1 is a healthy school going child, some miscreants, merely for the sake of puerile publicity, have, over a period of time, been circulating videos of YouTube, stating that plaintiff 1 was critically ill. One such video even claimed that she was no more. Morphed pictures were also used in such videos. According to the plaint, the plaintiff's right to privacy was breached through the circulation of such videos as per Rule 3(1)(b)(iii) of the Information Technology (Intermediary Guidelines and Digital Media Ethics Code) Rules, 2021 as amended in 2022 which also imposed a duty on intermediaries to make reasonable efforts to cause the user of its computer resource not to host, display, upload, publish, transmit, store or share any such content or information. Such acts were also claimed to violate the intellectual property rights which vested in the "Bachchan" family, including copyright in the images and pictures of the plaintiffs. One of the defendants, Google LLC that runs the YouTube platform, argued that it was difficult to have control over the content / videos that were uploaded on YouTube as the videos were not screened before they were posted. It was also argued that though they had special and immediate measures in place as a zero-tolerance policy for exceptional cases like child pornography and other such content, however, only remedial mechanism was in place for a person objecting to the content by bringing it to the notice of the Google LLC. This, the Court held to be plainly unacceptable. It was also pointed out by the plaintiffs that as per the amendment in 2022 of the Information Technology (Intermediary Guidelines and Digital Media Ethics Code) Rules, 2021, the words "and shall make reasonable efforts to cause the user of its computer resource" had been introduced. As such, the intermediary could no longer claim to be a mere passive spectator of the information uploaded on its platform, but was required to be more proactive in nature. After the said defendants argued their case, the plaintiffs clarified that all they were seeking was that the intermediary on being informed by the aggrieved party of such nature of content available on their platform, should

immediately proceed to take it down, without lapse of time. It was held by the Court that the said defendants were duty bound in law to ensure strict compliance with the entire statutory regime relating to intermediaries by which it is governed, which would include the 2021 Intermediary Guidelines Rules as amended in October 2022. It was also observed that the Court may have to examine whether the existing policy of the defendant was sufficient to ensure such compliance. As such, the plaint was registered as a suit and the Court also allowed the application for injunctive relief made by the plaintiffs. It was further held that a *prima facie* case was made out in favour of the plaintiffs for grant of *ad interim* relief without waiting for a response from the other defendants to prevent further prejudice to the plaintiffs. Accordingly, the Court directed *inter alia*, that the 24 URLs of YouTube as identified in the plaint, allegedly in breach, be immediately taken down and that no such other or similar content be uploaded or hosted, and this would encompass all such videos pertaining to the physical condition of plaintiff 1 Aaradhya Bachchan. Further, if the plaintiffs brought to the notice of Google LLC of any other video clip uploaded on YouTube pertaining to the health of plaintiff 1 then Google LLC would have to immediately proceed to take down such URLs. Furthermore, the Ministry of Electronics and Information Technology (MeitY) was also directed to block access to the aforesaid content as well as any similar content on the plaintiffs bringing the same to their notice.

Amitabh Bachchan vs. Rajat Nagi & Ors.

Forum: Delhi High Court
Case No.: CS(COMM) 819/2022
Order Dated: 25 November 2022

Issue: The case pertains to a suit filed by the veteran Bollywood actor, Amitabh Bachchan seeking protection of his publicity rights against the fake Kaun Banega Crorepati (KBC) lottery scam and myriad of other frauds

where his name ‘*Amitabh Bachchan/Bachchan/BigB/AB*’, image, voice and personality attributes were being used to deceive the public.

Plaintiff was aggrieved by defendant’s unauthorized use of his celebrity status to promote their own goods and services, without his permission or authorization and alleged violation of his ‘*publicity rights as a celebrity*’ as had been recognized in *Titan Industries Ltd. v. Ramkumar Jewellers*.

Order: The Delhi High Court Single Judge Bench of Navin Chawla, J. granted ad-interim ex-parte injunction in favour of the Actor, restraining the defendants in rem from infringing the actor’s personality rights. opined that plaintiff had made out a *prime facie* case in its favour for the grant of an *ad-interim ex-parte* injunction, noting that defendants were misusing plaintiff’s celebrity status for promoting their own activities, without plaintiff’s permission or authorization causing irreparable harm and injury to defendant’s reputation.

The court found balance of convenience in favour of the plaintiff and against the defendants. The court directed the telecom department and Ministry of Electronics & IT to pull down all links/websites that infringe upon Bachchan’s attributes. The court has also enjoined the registrants of the domain names ‘www.amitabhbachchan.com’ and ‘www.amitabhbachchan.in’ from creating third-party rights on them and directed telecom service providers to block access to all phone numbers used by the defendants to circulate the infringing messages.

The Court granted an *ad-interim ex-parte* injunction in favour of Amitabh Bachchan, restraining defendants from infringing Amitabh Bachchan’s publicity or personality rights for any commercial or personal gain.

Krishna Kishore Singh vs. Sarla A Saraogi

Forum: Delhi High Court
Case No.: CS(COMM) 187/2021
Order Dated: 10 June 2021

Issue: In this case, the Delhi High Court refused to grant an interim injunction against publication and release of films purportedly related to Sushant Singh Rajput (SSR) as the plaintiff, SSR's father failed to make out a prima facie case, and because irreparable harm and balance of convenience were in favour of the defendants. The plaintiff in the case argued that films and series such as 'NYAY The Justice,' 'Suicide or Murder,' and 'Shashank,' must be enjoined and restrained from being released, published and communicated to the public. The plaintiff filed the case on several grounds including violation of publicity rights and privacy rights, right to fair trial, defamation, and violation of Article 21 of the Constitution.

Order: After reviewing the facts and relevant cases, the Court came to the conclusion that the plaintiff failed to make out a valid case for violation of celebrity or publicity rights of SSR or his family members because the plaintiff was not aware of the content of the films, the defendants were not using SSR's image, likeness or name, and because the films had appropriate disclaimers. It also pointed out that celebrity rights may not subsist after the death of the celebrity, and that facts that form part of the public record may be used by the defendants without liability. About defamation, the Court stated that a case of defamation is merely speculative without access to the defamatory content.

The Court also pointed out that no violation of the right to fair trial may be contemplated because of publication in news or by way of films. It went on to note that freedom of expression prevails over Article 21 for information that forms part of the public record. While denying the injunction, it asked the defendants to render accounts as any damage may be compensated by way of damages.

Shri Om Prakash Lakhyani Trustee vs Union of India

Forum: High Court of Rajasthan

Case No.: 6922/2023

Order Dated: 26th May 2023

Issue: Whether the release of the film "Sirf Ek Banda Kaafi Hai" violates the petitioner's right to privacy and infringes upon their reputation?

Order: The present stay application was filed by the Applicant against the release of the film "Sirf Ek Banda Kaafi Hai" in the cinema house and OTT platforms. The Petitioner was found guilty of offences under the Indian Penal Code (IPC) and Protection of Children from Sexual Offences Act (POCSO Act) by the Trial Court, the appeal is still under adjudication before the Hon'ble Court. The petitioner claimed that his depiction in the movie was highly objectionable and caused damage to his dignity and repute, which violates the right to privacy under Article 21 of the Constitution of India.

The petitioner further argued that one of the respondents represented the victim as her attorney in the criminal case brought against the petitioner and that the film in question depicts the events of that criminal trial and he has sold his rights to the respondent-movie producer, in clear violation of the professional ethics outlined in the Advocates Act of 1961 and the Bar Council of India Rules. On the other hand, the respondent argued that the movie in question clearly states at the beginning that it is a fictional work that was inspired by actual life events, which are firmly within the public domain and therefore, has no negative effects on the petitioner's reputation or dignity.

The court observed that the movie in question is hinge on the criminal trial of the petitioner and hence, is a violation of his right to privacy and fair trial. However, after watching the trailer the court believed that nothing is directly related to the petitioner. After considering the factual matrix, the balance of inconvenience is in favour of the respondent as the grant of injunction will cause irreparable loss. The court did not find any irreparable loss to the petitioner and hence the stay application was dismissed.

Serum Institute of India Pvt. Ltd. And Anr. vs Yohan Tengra and 6 Ors

Forum: High Court of Bombay

Case No: INTERIM APPLICATION (L) NO. 33254 OF 2022 in SUIT (L) NO. 33253 OF 2022

Order Dated: 05th June 2023

Issue:

- Whether the defendants' dissemination of defamatory statements warrants a restraining order and removal of the content.

Judgment:

The Bombay High Court delivered a judgment dated June 05, 2023, in a dispute between Serum Institute of India Pvt. Ltd. and defendants who were found guilty of disseminating defamatory statements against the company. The court ruled in favour of Serum Institute and its CEO, Adar Poonawalla, and issued an order prohibiting the defendants from engaging in any form of derogatory or defamatory communication about Serum Institute or Adar Poonawalla through various mediums. Furthermore, the court mandated the removal and deletion of all existing defamatory content, while also demanding an unconditional apology recognizing the groundless and unjustified nature of the remarks.

The case stemmed from a defamation lawsuit filed by Serum Institute in response to the defendants' dissemination of false information suggesting the closure of Serum Institute of India and the arrest of Adar Poonawalla. Adar Poonawalla, renowned for his substantial contributions to vaccine manufacturing and trade, gained recognition during the COVID-19 pandemic due to the development of the 'Covishield' vaccine. The defendants cited a previous court order related to a compensation claim regarding alleged adverse effects of the Covishield vaccine. Subsequently,

they took to their social media platforms to make derogatory statements, incite anger and animosity among the public, and falsely accuse the plaintiffs of causing deaths. In presenting their case, the plaintiffs emphasized the approval process for clinical trials and the widespread administration of the Covishield vaccine across the nation, among other arguments that bolstered their position.

The court highlighted that the defendants were required to demonstrate that their statements were made in good faith and served the public interest. The court took into account an affidavit submitted by the Ministry of Health and Family Welfare, which affirmed that the plaintiffs had saved millions of lives in India, contradicting the defendants' assertions that their vaccines had caused fatalities. Addressing the defendants' arguments, the court dismissed claims regarding the statute of limitations, the lack of specification of defamatory statements by the plaintiffs, and references to the writ petition concerning the death of a girl. The court concluded that the contents were inherently defamatory and ruled in favour of Serum Institute, Adar Poonawalla, and the other plaintiffs. It clarified that the case solely revolved around defamatory content directed at the plaintiffs and was not concerned with the quality of the vaccine. Consequently, the Bombay High Court issued an order restraining the defendants from disseminating defamatory statements and mandated the removal of existing content.

Divya Spandana alias Ramya vs. Gulmohar Films Pvt. Ltd. and Others

Forum: Commercial Court of Bengaluru

Case No.: Com OS./812/2023

Judgment Dated: July 17, 2023

Issue:

- Whether the use of the plaintiff's the name, photographs, video clips, and GIFs in film "Hostel Hudugaru Bekagiddare," without her explicit consent, a violation of her rights and reputation?

Judgment:

Divya Spandana, aka Ramya filed a lawsuit seeking a permanent injunction to prevent the unauthorized use of her name, image, and video clips in the film titled "Hostel Hudugaru Bekagiddare." The plaintiff alleged that the defendants violated the terms of an artiste agreement by utilizing her name, photographs, and likeness without her approval. The agreement clearly stated that the producer could only use her name and other aspects with her explicit consent. Additionally, the plaintiff claimed that creative decisions were meant to be mutually agreed upon, and she should have been given the opportunity to review the film before its release.

In June 2023, despite the plaintiff's prior refusal to participate in the film, the defendant sent video clips of scenes featuring her, seeking her confirmation. However, the plaintiff requested the defendants to stop the process, but they continued without her approval, even setting a release date for the movie and its trailer. The trailer prominently featured the plaintiff's video clips, images, and GIFs, leading to a significant violation of her rights and reputation.

The court noted that the plaintiff had a valid artiste agreement with the defendants, which they breached by disregarding her objections and using her name and images in the film and trailer without her consent. This unauthorized usage potentially infringed upon the plaintiff's moral rights protected under the Copyright Act, as well as her performer's rights. Consequently, the defendants were directed to remove all trailers of the film "Hostel Hudugaru Bekagiddare" that included the plaintiff's name, photographs, video clips, and GIFs from social media platforms.

Furthermore, the court restrained the defendants from releasing the film "Hostel Hudugaru Bekagiddare," which contained the plaintiff's name, photographs, video clips, and GIFs, either directly or indirectly incorporated, until the next court date. The court's decision to grant a restraining order aims to safeguard the plaintiff's rights and reputation, preventing any further unauthorized use of her image in the film and its promotional materials. This court order represents a critical step in preserving the rights of artists and sets a precedent for similar cases in the future.

The court's recognition of the artiste agreement and its enforcement through the restraining order sets a crucial precedent for safeguarding the integrity and dignity of performers. This order emphasizes the importance of obtaining explicit consent from artists for any usage of their name, likeness, and creative contributions, reinforcing the respect and protection of their rights.

ADVERTISING



Dabur India Limited vs. Advertising Standards Council of India

Forum: High Court of Delhi

Case No.: FAO 323/2022

Order dated: January 9, 2023

Issue: Whether the claims in the Ad for the product ‘Dabur Vita’ stating (i) ‘India’s Best Immunity Expert’; and (ii) ‘No Other Health Drink Gives Your Child Better Immunity’ violative? Did the Ad deserve to be blocked?

Order: This is an appeal against an order of the Trial Court dismissing the plaintiff-appellant’s application for interim injunction. The appellant had

filed a suit for declaration, permanent and mandatory injunction wherein it was claimed that it was a company, having amongst other business of mass production, of Ayurvedic Medicines. It was also claimed that it was the first legal entity in India to provide healthcare through scientifically tested and automated production of formulations based on traditional ayurvedic science. This case pertained to an advertisement that was issued by the appellant for their product ‘Dabur Vita’ which was claimed to be an ‘Ayurvedic Medicine’. In the said advertisement, it was claimed that the ingredients in the product promoted immunity and the product itself offered double superior benefits of growth and immunity with superiority on taste compared to others in the milk food drinks category.

The respondent is a voluntary self-regulatory council governed by its own self-regulation code called ASCI Code under which mechanism is available to deal with complaints against advertisements. It received a complaint from a third party against the use of claims about the appellant’s product stating (i) ‘India’s Best Immunity Expert’; and (ii) ‘No Other Health Drink Gives Your Child Better Immunity’. It was alleged that the 2nd claim was superlative in nature and undermined the benefits consumers may get from any/all other products available in the market and that such claims also had no scientifically verifiable comparative studies. Based on the observations of the Fast Track Complaints Panel, ASCI, the impugned communication dated February 4, 2022, was issued by the respondent. In the impugned communication/request made by the respondent, all concerned media channels were to be directed to stop the release of the said Ads, and reference of its decision was made which observed that the claims in the Ad were inadequately substantiated, were misleading by exaggeration and likely to cause widespread disappointment in the minds of consumers. The claims were also stated to be denigrating all other products in the health drink category. The payer for injunction, against the said communication, was also dismissed by the impugned order, being subject of the present appeal.

The Court held that although harmless puffing or hyperbole in an Ad may be permissible, however, misleading claims made in Ads, especially, when the products relate to human consumption should be considered on a different footing. The Court *prima facie* observed that the Ad in the present case fell in the latter category and that it was misleading, as the efficacy of the appellant's product was yet to be established as per the established norms. The Court also noted that the plaintiff-appellant had *inter alia* prayed before the Trial Court for a declaration, and directions to the respondents not to publish its order/decision dated February 4, 2022, and to also not create impediments in the broadcast of the Ads in question. However, it wasn't prayed that the said order be even set aside. The Trial Court refused to grant injunction against the respondent since appellant could not show that the respondent tried to interfere with the broadcast of the advertisement in question as the respondent did not have the authority to block the broadcast of the advertisements and it could only send its recommendations to the Government of India to issue necessary directions. The decision to block the broadcast rested with the Government and not the respondent. Also, no evidence was produced before the Trial Court to show that the respondent tried to exceed its remit by sending communications to broadcasters directly requesting them to stop the broadcast of the advertisement in question. In view of the above, the present appellate Court also refused to interfere with the order of the Trial Court and the same was upheld. Accordingly, the appeal was dismissed.

Marico Limited vs Dabur India Limited

Forum: High Court of Delhi

Case No.: CS(COMM) 471/2022

Date: 2nd June 2023

Issue:

- Whether the WhatsApp and print advertisements of the defendant disparaged the plaintiff's product and registered trademarks?

Order:

Marico Limited (Plaintiff) filed a suit against Dabur India (Defendant) seeking an ad interim injunction restraining it from communicating or sharing its WhatsApp and print advertisements alleging that it disparaged Marico's product "Nihar Natural Shanti Badam Amla Hair Oil," and its registered trademarks. The plaintiff alleged that the opening statement in the print advertisement "*Yaad Rakhna, Sasta Aawla, balo ko mehenga padega*" which translates to "Remember, if you use cheap gooseberry, your hair will suffer" in English, constituted generic disparagement and false representation of fact.

Marico claimed that the advertisement features a bottle resembling its product, marked with a large red cross, suggesting a rejection of Marico's offering. Additionally, a WhatsApp message circulated alongside the print advertisement depicted a boxing glove knocking down Marico's bottle, indicating a targeted effort against the plaintiff and its product.

However, the defendant argued that the term "*sasta*" in the impugned print advertisement is neither disparaging the plaintiff's product nor is it misleading. The advertisement does not refer to the plaintiff's product. The term "*sasta*" referred to hair oils that are inexpensive in terms of quality and price, asserting the superiority of their Amla hair oil over ordinary and cheaper alternatives.

To assess whether the print advertisement could be considered disparaging, the court applied the test of an ordinary average consumer and evaluated its impact on them. The court relied upon the decision of the division bench in *Pepsi Co. Inc. and Ors v. Hindustan Coca-Cola Limited*, which observed that while deciding the question of disparagement, one must consider the intent, manner, and storyline of the commercial along with the message sought to be conveyed by it.

The court held that out of these factors, "manner of commercial" is very important. If the impugned advertisement is ridiculing or condemning products of the competitor, it amounts to disparagement. However, if the impugned commercial is merely stating the qualities of one's product as being better or best without derogating other's product then that is not

actionable. Mere puffing of goods is not actionable. The court observed that a tradesman can claim their goods to be best or better, but by way of comparison, the tradesman cannot slander or defame the goods of the competitor or call them bad or inferior.

The court referred to a previous judgment by the Bombay High Court, which concluded that a similar advertisement did not imply the inferiority of all cheaper Amla hair oils. Instead, it aimed to caution consumers about potential risks associated with using such products, highlighting the importance of quality. It held that a consumer, while reading the print advertisement, would not be able to relate the term “*sasta amla*” to the plaintiff’s product as the bottle in the advertisement is neither referring nor directly or indirectly implying the plaintiff’s product. It is also not a generic disparagement of all cheaper Amla Hair Oil. Thus, the court classified the advertisement as puffery rather than defamatory.

Furthermore, the court acknowledged that the reference to “*Asli Amla, Dabur Amla*” in the print advertisement was a registered trademark of the defendant, entitling them to use it. The tagline did not imply that only the defendant’s product was genuine but emphasized the need to pay attention to quality. The court also dismissed the plaintiff’s challenges regarding the claim of two times extra strength in the defendant’s hair oil, as these claims had been previously considered by courts and regulatory bodies.

The plaintiff claimed that the WhatsApp advertisement was circulated with the defendant’s concurrence, while the defendant denied any involvement. However, evidence indicated that the defendant’s employees were indeed involved in originating and circulating the WhatsApp message.

Considering the circumstances, the defendant expressed no objection to an injunction on the circulation of the WhatsApp advertisement. The court acknowledged that the message appeared to have originated from the defendant’s employees. However, the court also reviewed an email exchange between the defendant and its advertising agency, which focused on highlighting the strength and quality of the defendant’s product. Consequently, the court determined that although the defendant’s employees may have been involved in the circulation, their intent was not

to disparage the plaintiff's product but rather to convey the superiority of their product.

Following a comprehensive examination of the print and WhatsApp advertisements, the court arrived at the finding that the print advertisement did not contain any evident reference to the plaintiff's product. The inclusion of the term "*sasta amla*" in the advertisement did not have any direct or indirect implications for the plaintiff's product. As for the WhatsApp advertisement, since the defendant acknowledged that it had no objection to an injunction on its circulation, the court granted an injunction restraining the defendant from publishing it.

PLANT VARIETIES AND FARMERS' RIGHTS



Pan Seeds Pvt. Ltd. vs Ramnagar Seeds Farm Pvt. Ltd. and Ors.

Forum: High Court of Calcutta

Case No.: F.M.A.T 11 of 2023 CAN 1 of 2023

Judgment Dated: 9th June 2023

Issues:

- Whether the respondents were infringing the appellant's exclusive rights acquired through the registration of their plant variety?
- Whether the registration of the appellant's variety PAN 804 is valid?
- Whether the civil court had the jurisdiction to decide on the validity of the registration?

Judgment:

The appellant, Pan Seeds Pvt. Ltd., applied for the registration of their seed variety called PAN 804 under the Protection of Plant Varieties and Farmers' Rights Act, 2001 (PPVFR Act). The appellant alleged that the respondents, Ramnagar Seeds Darm Ovt. Ltd, were engaging in the use, sale, and production of seeds under the names JAMUN and DURONTO, which were identical to the appellant's variety. According to the appellant, this constituted an infringement of their exclusive rights obtained through the registration of their plant variety. The appellant filed an interim application for an injunction, seeking to restrain the respondents from continuing their alleged infringement. The court ruled that the respondents were indeed guilty of infringing the appellant's exclusive rights acquired through the registration of their plant variety. Furthermore, the court found that the registration of the appellant's variety PAN 804 was valid. However, the court also held that the civil court did not have the jurisdiction to determine the validity of the registration.

In reaching its decision, the court referred to various sections of the PPVFR Act, including Sections 14, 17, 23, 28, and 31. These provisions supported the court's reasoning that the registration of a plant variety under Section 24 of the Act grants exclusive rights to the breeder without any conditions. The court emphasized that the validity of such registration cannot be questioned in a civil court. It noted that the jurisdiction of the civil court is limited and does not extend to determining the validity of registrations under the PPVFR Act. In conclusion, the court determined that the respondents had infringed the appellant's exclusive rights obtained through the registration of their plant variety. It affirmed the validity of the registration of the appellant's variety PAN 804 and stated that this validity could not be challenged in a civil court. The court rejected the respondents' request for a stay of operation of the judgment and order. Therefore, the judgment and order would continue to be in effect without any suspension.

Pepsico India Holdings Vs. Kavitha Kuruganti

Forum: High Court of Delhi

Case No.: C.A.(COMM.IPD-PV) 2/2022 & IAs 7898/2022 & 7900/2022

Judgement Dated: July 5, 2023

Issues:

- Whether the Authority exceeds its jurisdiction by re-evaluating the facts of the appellant's registration application?
- Whether the revocation of the appellant's registration based on the application category of "New Variety" is arbitrary, unreasonable, harsh, and disproportionate?
- Whether the bona fide mistakes in the application form can be ground for revoking the registration?
- Whether the Impugned order wrongly declared the Assignment Deed as invalid?
- Whether the Registration granted by registrar can be revoked u/s 34 of the Act?

Judgment:

The court emphasized that the Act deals with intellectual property rights pertaining to plant varieties and compares these rights to other forms of intellectual property like patents, trademarks, copyrights, and designs. These rights are statutory in nature and didn't exist under common law.

The court reviewed the Act's provisions relating to the protection of plant varieties and highlights that the Act aims to strike a balance between the rights of plant breeders and farmers. Provisions such as Compulsory Licence underscore this balance. The case at hand revolved around the revocation of the appellant's plant variety registration, specifically focusing on the grounds provided in Section 34(a), (b), (c), and (h) of the Act.

The court analysed the first ground for revocation, concerning incorrect information in the application. The appellant marked the plant variety as "new" instead of "extant" in their application. The registrar proceeded with the application despite this mistake. The court delves into the definitions and criteria for registration of "new" and "extant" varieties. The appellant's error is considered a clerical mistake and the registration was granted in the correct category. The court dismisses the respondent's claim that the incorrect information provided unjust benefits.

The court then discussed the grounds under Section 34(b) and (c) regarding deficiencies in the application. The appellant's application lacked necessary documents and the required signatures. The court explained that the appellant failed to provide proof of assignment under Section 16 and Section 18(3) of the Act. The court determined that the Authority was justified in invoking Section 34(c) due to these deficiencies. The court found the Assignment Deed inadmissible as evidence due to omissions and lack of stamping.

The court rejected the appellant's argument about denial of opportunity to rectify deficiencies under Section 20(2) of the Act, stating that the appellant was provided an opportunity but failed to rectify the mistakes. The court highlighted the importance of adherence to requirements and emphasizes the Authority's rightful action in revoking the registration due to deficiencies in the original application.

Finally, the court addressed the application of Section 34(h) of the Act. The court opined that the requirements of this section are not met in this case. The court disputed the Authority's basis for revocation under this section, stating that filing lawsuits against farmers, even if frivolous, is insufficient to revoke registration. The court asserted that the Authority erred in revoking the registration based on this ground.

The appellant challenged the respondent's right to file a revocation application before the Authority. However, the court found this argument to be without merit. Based on these considerations, the court found no merit in the appellant's challenge to the respondent's locus (legal standing). Consequently, the appeal was dismissed, and all pending applications are disposed of. No costs are awarded in this matter.



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