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SELECTED INDIAN INTELLECTUAL PROPERTY CASES

2016 - 2018

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Citizen Holdings Co. Ltd.**vs Dinesh Kumar Laxman Bhai Virda**Delhi High Court, Single Bench, 22nd December 2015**Injunction Granted****Facts and Contentions:**

Plaintiff is in the business of manufacturing, marketing and sale of various products including lathe machines under the trademark CITIZEN. Plaintiff's trademark is registered in Class 07 with the Trademark Registry from 1961. Defendant had applied for registration of trademark CITIZEN in respect of lathe machines in 2008 in Class 07. On becoming aware of the Defendant's application Plaintiff filed an opposition which is still pending. Defendant had also applied for registration of trademark CITIZEN in respect of lathe machines in 2010 in Class 07. Plaintiff again filed an opposition which is also pending.

Plaintiff submitted before the Court that use of the identical mark CITIZEN, by the Defendant for its lathe machine tools amounts to infringement of Plaintiff's trademark within the meaning of Section 29(1) and 29(2) of the Trade Marks Act, 1999. Plaintiff also came to know that the defendant has adopted the domain name <citizenlathe.com> and had started a website <http://citizenlathe.com> wherein use of the word "Citizen" amounts to infringement of Plaintiff's trademark.

Held:

The High Court after hearing the Counsel for the Plaintiff and perusing the plaint and annexed documents, held that the Plaintiff has succeeded in disclosing a prima facie case in its favour and ordered that the Defendant is restrained from manufacturing, marketing, advertising, selling or using its products under the trademark CITIZEN, or any other deceptively similar mark as that of the Plaintiff's, in any manner whatsoever.

The High Court also appointed a Local Commissioner to visit the Defendant's address, make inventory and seize the infringing materials to produce the same in Court at the appointed time. ■

Cartier International AG & Ors.**vs Gaurav Bhatia & Ors.**Delhi High Court, Single Bench, 4th January 2016**Injunction Granted With Costs****Facts:**

Plaintiffs have filed the present suit seeking inter alia permanent injunction restraining Defendants from infringement of their trademarks PANERAI, VACHERON CONSTANTIN and JAEGER LECOULTRE, passing off, damages, etc. Plaintiffs claimed that the Defendants are operating an e-commerce website where they are offering counterfeit products bearing the trademarks and logos of various luxury brands, including those of the Plaintiffs, for sale. The Defendants did not appear before the Court.

Held:

The High Court opined that the Plaintiffs have been able to establish all of their claims, which remain un-rebutted since the Defendants were not present before the Court. Consequently, the High Court granted Plaintiffs' request for permanent injunction and claim of damages of Rs. 10 million*. In addition, High Court also declared the trademarks PANERAI, VACHERON CONSTANTIN and JAEGER LECOULTRE as well-known trademarks. ■

[*Rs./ INR 65 = USD 1 approx]

Mac Personal Care Pvt. Ltd. & Anr.**vs Laverana GmbH & Co. KG & Anr.**Delhi High Court, Division Bench, 28th January 2016**Injunction Granted****Facts:**

Respondent is the proprietor of the trademark LAVERA in connection with a cosmetic product and the product was marketed for the first time in Germany in the year 1982. Respondent learnt of Appellant's use of the mark MAC'S LAVERA in September, 2010 when it was published in the Trademark Journal No.1441 for purposes of opposition, to which application the Respondent filed an opposition. In addition, Respondent filed a suit for trademark infringement.

Contentions:

Appellant pleaded that the respondent has not

used the mark anywhere in India and that it had been using the word LAMERA as a part of its trademark since 2005, and that Respondent had acquiesced in the use of the word by the Appellant, evidenced by the fact that the suit was filed in the year 2012.

The Single Judge had issued an ex-parte interim injunction against the Appellant and in favour of the Respondent. Against the said ex-parte injunction order, Appellant filed the present appeal.

Held:

The Division bench found that the Respondent had established a reputation abroad which has spilt over to India and that Respondent was entitled to an injunction against the Appellant because, prima-facie, the Appellant has adopted the mark in a dishonest manner. ■

Inter IKEA Systems BV vs Aikya Enterprises

Delhi District Court, Single Bench, 29th January 2016

Injunction Granted With Costs

Facts:

Plaintiff is a company incorporated under the laws of Netherlands and is the worldwide owner of the IKEA Trademarks under which a wide range goods and services are sold, such as furniture, accessories, bathroom and kitchen fittings, home and office furnishing products, stationery, including paper and paper articles, tools and implements.

According to Plaintiff, IKEA India is a major regional buying center for the IKEA group specializing in purchase of textiles and fabrics from South Asia comprising India, Pakistan and Sri Lanka. Plaintiff claimed that Defendant Aikya Global is apparently engaged in the goods, services and business of furniture on rent, polishing unfinished furniture, installation, imported furniture and allied and cognate goods. According to Plaintiff, Defendant had adopted and started using and / or intends to use in relation to its products, the trademark AIKYA.

Contentions:

At the initial stage, an ex-parte injunction order was granted in favour of the Plaintiff. Despite several attempts to issue summons to the Defendant,

Defendant failed to appear before the District Court and the matter proceeded ex-parte.

Held:

The Court held that Plaintiff had successfully established its rights in the IKEA trademarks and that the Defendant intends to encash on the goodwill of the stated mark by adopting the phonetically identical mark in relation to similar kind of products. Accordingly, the District Court granted Plaintiff's request for permanent injunction and held that Plaintiff is entitled to damages of Rs.50,000* ■

Adidas AG vs Union of India

Delhi High Court, Single Bench, 10th February 2016

Facts:

Petitioner Adidas is the proprietor of the trademark RESPONSE with respect of footwear and apparel, which it claims has garnered worldwide goodwill and reputation. Petitioner found that the Respondent has obtained registration of the trademark RESPONSE and it filed a rectification petition for removal of the said registration before the IPAB (Intellectual Property Appellate Board). According to Petitioner, Respondent had not appeared before the IPAB nor had it filed any response to the rectification application. The IPAB dismissed Petitioner's rectification application on the ground that Petitioner was not qualified to be a "person aggrieved" or had not demonstrated to how the registration was causing confusion or deception in the market. Accordingly, Petitioner filed the present writ petition against the IPAB order.

Held:

The High Court was of the opinion that the expression "person aggrieved" is a term of wide amplitude and an applicant for registration whose trademark has been objected to or refused by reason of prior registration by a third party of the same or similar or identical mark for the same goods or description of goods or whose application for registration is opposed on the basis of prior registration of the same or similar mark by the Registry is a person aggrieved. The High Court also

held that IPAB's finding, that even when the marks and goods are identical, there is no person aggrieved, is contrary to law.

Accordingly, High Court set aside the IPAB's order and remanded the matter to the IPAB for fresh consideration ■

L'Oreal vs Jainsons Lipstick House

Delhi High Court, Single Bench, 18th February 2016

Injunction Granted With Costs

Facts:

Plaintiff is engaged in the business of manufacture, distribution and trade of a wide range of cosmetics and beauty products including make up preparations and accessories used thereof and other allied / related products. It is alleged that the Plaintiff, through their predecessor in year 1917, adopted the word / mark MAYBELLINE.

It is alleged by the Plaintiff that the Defendants are engaged in trading of cosmetics and beauty products including make up preparations and accessories used thereof and other allied / related goods thereof. The Defendants had adopted and started using the impugned trademarks/labels viz. MAYBELLINE THE COLOSSAL KAJAL, MAYBELLINE THE COLOSSAL VOLUME EXPRESS, CAMIEO THE KAJAL, VOV THE COLLOSSAL KAJAL in relation to its goods. Accordingly, Plaintiff filed a suit for trademark infringement against the Defendant.

Contentions:

Initially, an ex-parte interim injunction was granted by the High Court. During the course of proceedings, the dispute was settled between the Plaintiff and the Defendant Nos. 1 and 3 and Defendant No.2 was removed from the array of parties by Plaintiff. The only contesting parties which remained were Defendant Nos. 4 and 5. Defendant No.4 undertook never to use Plaintiff's trademarks. On the other hand, Defendant No.5 claimed that it had been doing business of printing with the printing press and has no concern or connection with Plaintiff or the Defendant Nos. 1 to 4. It further claimed that it had never adopted or used the trademark of Plaintiff at any point of time and he has no concern or connection with the alleged trademark and even the answering

Defendant is not using the alleged goods and business of the Plaintiff. At the trial stage, Defendant Nos.4 and 5 did not appear before the High Court.

Held:

The High Court observed that Plaintiff's trademark MAYBELLINE was well-known in the cosmetics industry and Defendants were well aware of Plaintiff's rights in the said mark. High Court also found that there was no rebuttal from Defendants to Plaintiff's evidence. Accordingly, High Court allowed Plaintiff's request for a permanent injunction and claim of damages of Rs.50,000* ■

[*Rs./ INR 65 = USD 1 approx]

Parfums Guy Laroche vs Singh Cosmetics & Ors.

Delhi District Court, Single Bench, 18th February 2016

Injunction Granted With Costs

Facts:

Plaintiff is engaged in the business of manufacturing and marketing of a wide range of ready to wear men and women's collection (hosiery, lingerie, swim wear, jewelery, watches, belts, etc.) perfumes, deodorants, toiletries, shaving cream, after shave lotion and cosmetic products. Plaintiff is the absolute and global owner and proprietor of trademark/label DRAKKAR and DRAKKAR NOIR. Singh Cosmetics are engaged in manufacture and trading of perfumes, deodorants, toiletries, shaving cream, after shave lotion and cosmetic products. Plaintiff alleges that Singh Cosmetics had dishonestly adopted the mark DRAKKAR NOIR in relation to its products and aggrieved by such activities, Plaintiff filed the present suit.

Contentions:

Plaintiff argued that Singh Cosmetics, by virtue of its dishonest adoption of the mark DRAKKAR NOIR mark, has infringed its trademark rights. At the initial stage, an ex-parte interim injunction was granted to Plaintiff. Singh Cosmetics submitted that Plaintiff had obtained the ex-parte injunction order through misrepresentation and suppression of facts. Singh Cosmetics submitted that Plaintiff had filed a suit in 2009 against Singh Cosmetics making identical claims. Also High Court had appointed

Local Commissioners who did not find any infringing product on Singh Cosmetics' location. In the present suit as well, Local Commissioners could not find any infringing products on Singh Cosmetics' location. Singh Cosmetics argued that the infringing products were being manufactured by other entities – Kenstar Consultants Inc., Breeza Marketing Incorporated and Celine Healthcare Pvt. Ltd., who were subsequently added as parties to the suit. Among the three entities, only Celine Healthcare filed their written response while the rest remained ex-parte.

Held:

The High Court found that the evidence on record showed that defendant has adopted the trade mark DRAKKAR and DRAKKAR NOIR in relation to impugned goods in complete violation of Plaintiff's statutory and common right in Trademark and Copyright. Accordingly, the High Court held that Plaintiff is entitled to a permanent injunction and damages of Rs.50,000* ■

[*Rs./INR 65 = USD 1 approx]

International Foodstuffs Co. LLC vs Parle Products Pvt. Ltd. & Anr.

Bombay High Court, Single Bench, 11th April 2016

Injunction Not Granted

Facts:

Plaintiff claims to be the proprietor of the trademark LONDON DAIRY in respect of ice creams. Defendant is using the mark LONDONDERRY, a single word mark in a different colour scheme. Plaintiff filed the suit for trademark infringement against Defendant claiming that the mark LONDONDERRY infringes its mark LONDON DAIRY.

Contentions:

Plaintiff claimed that Defendant had dishonestly adopted the impugned mark and if Defendant is unable to establish its bona fides in adoption, then injunction must follow, since Plaintiff is a prior registered proprietor and there is phonetic similarity between the marks. Defendant on the other hand claimed that there is no similarity in the concerned products, since Defendant's products do not include ice creams and Plaintiff had never used

its mark in relation to any products other than ice creams.

Held:

Considering the facts of the case, the High Court held that the products cannot be considered to be cognate or allied. Also, when judging similarity between marks, consideration must be given equally to visual or structural similarity and must not rely merely on phonetic similarity. Accordingly, the High Court refused to grant Plaintiff's request for interim injunction ■

Burger King Corporation vs Shameek & Ors.

Delhi High Court, Single Judge, 2nd May 2016

Injunction Granted

Facts:

The Plaintiff's company was founded in 1954 when it commenced its business with one restaurant in Miami, Florida trading under the name and style of BURGER KING. In or around December 2012, the Plaintiff became aware of the existence of the Defendants' restaurant in Chennai operating under the trading style of KING BURGER and was alarmed to note that the Defendants' were using a trade mark/ name which is a mere rearrangement of the Plaintiff's well-known trade mark/ name BURGER KING. Accordingly, Plaintiff filed a suit for trademark infringement and passing off against Defendant.

Contentions:

On the aspect of territorial jurisdiction of the Delhi High Court to entertain the present suit, Plaintiff contended that although Plaintiff is an American company and has no registered office in India, it is carrying on its business within the jurisdiction of the Delhi High Court. Considering that the Defendant in the present case has refused to accept summons and failed to appear before the High Court and also failed to submit any written statement, Plaintiff requested the High Court to pronounce its judgement on such ground.

Held:

The High Court noted that the mark KING BURGER

adopted by the Defendant appears to be similar to the Plaintiff's registered mark BURGER KING, as Defendant had merely changed the order of use of the two words BURGER and KING and had also added the letter 'Z' at the end of the word BURGER, which has little impact phonetically. According to the High Court, an unwary customer is likely to be deceived and confused and to assume that KING BURGERZ is a mark of the plaintiff, who has been using BURGER KING since 1954 worldwide, and in India since 2014. High Court observed that Plaintiff being the registered proprietor of the mark BURGER KING, is entitled to protection against infringement of the said mark by anyone, who uses any other mark which may be deceptively or confusingly similar to the Plaintiff's mark. Accordingly, High Court held that Plaintiff is entitled to an order of injunction as prayed. ■

**KSB Aktiengesellschaft Germany & Ors.
vs Anil Agarwal**

Bombay High Court, Single Bench, 17th June 2016

Injunction Granted

Facts:

Plaintiff is a German company and is the proprietor of the trademark KSB which is an acronym comprising the first letters of the surnames of the three first founders of this company. Plaintiff is the registered proprietor of the KSB trademark in Classes 6, 7, 9, 11, 16, 37, 41 and 42. Plaintiff found that the Defendant had filed an application for registration of the trade mark KSB as a label mark in Class 7 in relation to manufacturing of and trading in bearings. The said application was advertised in the Trade Marks Journal, however, Plaintiff had failed to oppose the trademark application within time. Instead, Plaintiff sent a cease and desist letter to Defendant. Meanwhile, Defendant's trade mark application was granted registration despite Plaintiff's earlier trademark registration KSB in relation to Class 7. Accordingly, Plaintiff filed the present suit for trademark infringement and passing off, although, Plaintiff later restricted its reliefs to only passing off.

Contentions:

Plaintiff alleged that Defendant's use of the identical mark in respect of identical goods will

cause confusion and dilute the well known nature of its KSB mark. Defendants denied that the rival marks or the goods thereunder were either identical or similar. Defendant also countered Plaintiff's claims of confusion or deception in the market.

Held:

High Court rejected each and every ground of defence raised by Defendant and observed that there was no evidence of prior use of the subject mark by Defendant. High Court upheld all claims of the Plaintiff and granted an injunction order restraining Defendants from use of the trademark KSB or any similar mark thereto till the final disposal of the suit. ■

**Exxon Mobil Corporation & Ors.
vs Shailesh H.Mehta & Ors.**

Delhi High Court, Single Bench, 14th July 2016

Injunction Granted

Facts:

Plaintiff is engaged in the business of petroleum and gas but has also diversified into retail stores and rubber products, and operates under the trademark EXXON which it adopted in the year 1967. Plaintiff's grievance against the Defendants is that they are in the business of conducting online examination which is not the business of the Plaintiff but the use by the Defendant of the name/trademark 'EXON' which is similar in pronunciation to the trademark 'EXXON' of the Plaintiff will result in dilution of the Plaintiff's trademark. Accordingly, Plaintiff filed the present suit for trademark infringement and passing off. Initially, an ex-parte interim injunction order was granted to Plaintiff. Defendants filed a request for vacation of the ex-parte injunction order, which was not granted.

Contentions:

In response to Plaintiff's allegations of trademark infringement, Defendants stated that they were only involved in the business of conducting online examinations and tests, which was completely separate and distinct from Plaintiff's business. Defendants also stated that they have registered the trademark EXON in Classes 9 and 16 since 2005 with use claimed from 2002, and such trademark

registrations were never opposed by Plaintiffs.

Held:

In response to the claim of having registered the EXON mark, Plaintiff submitted that it had filed rectification proceedings before the IPAB and requested the High Court to stay the proceedings of the present suit till disposal of such rectification proceeding. High Court acceded to such request and in the meantime, made the ex-parte interim injunction absolute considering that the rival marks were identical and Defendant had not been using its trademarks for the products for which they had obtained registration ■

Exxon Mobil Corporation & Ors. vs P.K.Sen

Delhi High Court, Single Bench, 22nd July 2016

Facts:

Plaintiff No.1 is a US based company who did not have any direct presence in India, except through its wholly owned Indian subsidiary, Plaintiff No.2, with its registered office in New Delhi.

Plaintiff No.1 was the registered proprietor of the EXXON trademark in India, which it had allowed its Indian subsidiary to use via a licence agreement.

Plaintiff alleged that Defendant had dishonestly adopted EXON as part of its corporate name Exon Engineering Corporation. Aggrieved, the Plaintiffs filed a suit for trademark infringement against Defendant before the Delhi High Court.

Contentions:

Plaintiffs had filed an application for interim injunction in the suit before the Delhi High Court. The Defendant contested the suit arguing that the Delhi High Court lacked territorial jurisdiction as it was carrying on business in Kolkata, and the complaint ought to be dismissed as such. The Single Judge accepted Plaintiff's plea for interim injunction holding that the Plaintiff's Indian subsidiary was operating within the jurisdiction of the Delhi High Court, and that Plaintiff No.2 was a 'permitted user' of the EXXON mark.

On appeal by the Defendant, the Division Bench of the Delhi High Court set aside the interim injunction order. The Division bench agreed with the

Defendant's contention that under the relevant provisions of the Trade Marks Act, 1999, only a registered proprietor and a "registered user" was allowed to initiate a suit for infringement of trademark and not a "permitted user". In the present case, since the Plaintiff's Indian subsidiary was not a "registered user" and the Plaintiff did not have a registered office in India, Plaintiff could not have filed the suit before the Delhi High Court relying on the place of business of Plaintiff No.2. Accordingly, the Division bench returned the complaint directing the Plaintiffs to file the suit before a court of competent jurisdiction.

Aggrieved by the decision of the Division bench, the Plaintiffs filed a Special Leave Petition before the Supreme Court of India. The Supreme Court refused to interfere with the decision of the Division bench, and directed the Plaintiffs to submit the complaint before the Court with competent jurisdiction ■

Exide Technologies

vs Exide Industries Ltd. & Ors.

Delhi High Court, Division Bench, 2nd August 2016

Injunction Not Granted

Facts:

The present case is an appeal against the decision of the Single Judge allowing the suit filed by Exide India against the Appellant Exide US, and dismissing the counter-claim filed by Exide US. In the decision, Single Judge held that Exide India was the registered proprietor and prior user of the EXIDE mark in India and Exide US was restrained from selling any products under the EXIDE mark in India.

Contentions:

Appellant alleged that:

- (i) Exide India used suppression and concealment of material facts while obtaining the ex-parte injunction as well as at the stage of final arguments.
- (ii) Exide US is the proprietor of the EXIDE mark worldwide and Exide India acquired its rights from Exide US' predecessors and Exide India has no independent rights in the EXIDE mark.
- (iii) Exide US had not abandoned use of EXIDE mark in India.

On the basis of the said grounds, Exide US claimed that the injunction order ought to be set aside.

On the other hand, Exide India defended the impugned decision as under:

- (a) Exide India is the continuous prior and registered user of the mark EXIDE in India and therefore, is entitled to restrain every person including Exide US from using the said mark in India.
- (b) Exide US was not using EXIDE in India at any point of time.
- (c) Exide US' claims of trans-border reputation and existence of special circumstances is beyond the pleadings and cannot be urged as grounds of appeal.
- (d) Exide India is entitled to restrain Exide US from using the corporate name/trade name EXIDE because EXIDE is a registered trademark owned by Exide India, and has been used by it since 1947.
- (e) Even if it is assumed that Exide US used the mark EXIDE through CESCO (Exide US' predecessors) till 1947, there was clear abandonment of such use.

Held:

On the basis of the contentions raised by both parties, Division Bench formulated the following issues on which it needed to decide.

- (i) Whether Exide India is the lawful registered proprietor of the trademark 'EXIDE' in India.
- (ii) Whether Exide US is prior user of the mark 'EXIDE' in India.
- (iii) Whether use of the mark 'EXIDE' by Exide US in India, amounts to infringement/passing off.
- (iv) Whether Exide India's use of the trademark 'EXIDE' amounts to passing off, and
- (v) Whether Exide India suppressed any material/relevant facts and, if so, whether the suit deserves to be dismissed on such ground.

On the first issue, Division Bench ruled that the appropriate forum to decide this matter is the IPAB or the Registrar of Trade Marks and not the civil court. With regard to the issues of trademark infringement and passing off, High Court observed that the present dispute arose when Exide US proposed use of its mark PRESTOLITE to market its products in India. Exide India sought to prevent Exide US from using anything that will result in any connection between PRESTOLITE and EXIDE in the minds of the public. High Court found that documentary evidence on record clearly shows Exide US' predecessors' continuous use of the EXIDE mark in India for nearly half a decade. High Court

also found that Exide US was compelled by reason of the US Court's injunction to stop business in India for about three decades. High Court held that the documentary materials show that the title to the EXIDE mark was prima facie obtained by Exide India but the goodwill attached to the EXIDE mark was not transferred to them, by its predecessors.

Accordingly, Division Bench ruled that Exide US did not infringe the mark, or attempt to pass off a mark over which they had no right and their use of the word EXIDE was both bona fide and legitimately concurrent. Division Bench also opined that by reason of the transnational reputation enjoyed by Exide US, they had the right to use the EXIDE mark in India, and allowed Exide US to describe the existing relationship between Exide US and Exide India suitably. Finally, Division Bench ruled that Exide India's suit for infringement and passing off is dismissed.

Division Bench also rejected the counter-claim filed by Exide US holding that Exide India's proprietary rights to the EXIDE mark is the domain of the IPAB. ■

**Citizen Holdings Co. Ltd.
vs Chandrakant Vanmaladas Shah & Anr.
Delhi High Court, Single Bench, 22nd August 2016**

Injunction Granted

Facts and Contentions:

Plaintiff filed the present suit praying inter alia, for a decree of permanent injunction restraining the Defendants from manufacturing, marketing, selling, offering for sale, importing and exporting precision machines, precision measuring instruments, scales, balances, checking instruments, laboratory goods, machines and machine tools and other types of precision products and machines or any type of goods and services bearing the mark 'Citizen/Citizen/Citizen/Citizen' or any other trademark deceptively similar thereto, and from using the aforesaid expressions as a trademark trade/name/corporate name/ domain name or part thereof and in any other manner which may infringe Plaintiff's registered trademark CITIZEN.EN. Defendants claimed to have been using the trademark CITIZON also registered, since 2006 and the mark CITIZEN since 1987. Plaintiff alleged that the trademark 'CITIZEN' is registered in its favour in several classes. It was ex-facie apparent that the marks 'CITIZON' and 'CITIZEN'

being used by the Defendant were deceptively similar to the registered trademarks of the Plaintiff's.

Held:

The High Court held that the trademarks used by the Defendants were deceptively similar to the registered trade mark CITIZEN which had been adopted by the Plaintiff in respect of measuring, signalling and checking apparatus and instruments in 1961. The word 'CITIZEN' was also part of the corporate name of the Plaintiff's predecessor since 1930. Plaintiff was not only the registered proprietor of the trademark CITIZEN but also the prior user thereof. Therefore, the Defendants cannot be permitted to use the trademarks/trade name CITIZON, CITIZEIN or CITIZEN in any manner. The Defendants' requested the Court for some time to change their trademarks/trade names and obtain required licenses and not be interdicted from using the offending trademarks during this period. They were granted 9 months time to discontinue use of those trademarks and also change their corporate name. ■

Yahoo! Inc. vs Sanjay Patel & Ors.

Delhi High Court, Single Bench, 1st September 2016

Injunction Granted With Costs

Facts:

The present suit has been filed by Yahoo! Inc., a US company against Apricot Foods Pvt. Ltd., and others, seeking permanent injunction to restrain the Defendants from infringing the Plaintiff's trademark, passing off, damages and delivery up, etc. According to Plaintiff, sometime in April 2014, it learnt of Defendants' activities that were infringing Plaintiff's trademark YAHOO!. Plaintiff claimed that Defendants were dealing in products bearing infringing names YAHOO MASALA CHAKRA and YAHOO TOMATO TANGY in relation to their snack foods like chips, wafers, namkeens, etc.

Initially, an ex-parte injunction order was granted by the High Court in Plaintiff's favour. High Court also allowed Plaintiff's request for Local Commissioners, who raided Defendant's premises and located infringing products under the YAHOO mark, which were seized and produced before the High Court.

Upon issuance of summons, Defendant No.3 appeared before the High Court and submitted that he is not dealing in the products under the YAHOO mark and undertook never to do so in the future. On the basis of such undertaking, Plaintiff agreed not to press for damages against such Defendant and the suit was accordingly decreed against the 3rd Defendant. Despite summons, Defendant Nos.1 and 2 failed to appear before the High Court and the matter proceeded ex-parte against them.

Held:

The High Court held that the Plaintiff had also been able to prove that Defendant Nos. 1 and 2 have adopted the Plaintiff's trademark as the name of their product in order to piggyback on the reputation of the Plaintiff and the Plaintiff's trademark and that such adoption of the trademark YAHOO for Defendants' snack items is undoubtedly dishonest. High Court ruled that Defendants had, by using the YAHOO mark, taken an unfair advantage of the Plaintiff's trademark and that this use is detrimental to the distinctive character and repute of the Plaintiff's well known trademark. Accordingly, High Court restrained Defendants from using the YAHOO mark in any manner. Additionally, High Court directed Defendants to pay a sum of Rs.32,00,000* as damages and a sum of Rs.6,44,000* towards costs to Plaintiff. ■

[*Rs./ INR 65 = USD 1 approx]

Seven Towns Ltd. & Ors. vs Kiddiland Toys Pvt. Ltd. & Ors.

Delhi High Court, Single Bench, 6th September 2016

Injunction Granted

Facts:

Plaintiff is world-renowned in connection with the manufacture and distribution of a wide range of leisure products inter alia including the world famous Rubik's Cube. Defendant No. 1 is Kiddiland who is engaged in the retail business of toys and games and sells/offers for sale the products of Defendant No.2 through its outlets in New Delhi. Cybershop Marketing Private Ltd., the Defendant No.2, is engaged in the business of manufacturing, marketing and distribution of toys and games, upon information and belief, within the territory of India.

The Plaintiff filed the present suit for permanent injunction against Defendants.

The High Court initially passed an ex-parte interim order restraining the Defendants from using the label, which is similar to, or identical with, the Plaintiff's label or packaging or offering or displaying for sale of the cubes being marketed by the defendants.

Against such order, Defendant No.2 filed an appeal, claiming that the said order appeared to put a ban on sale of cubes per se and requested the High Court to clarify its interim injunction order granted earlier. Accordingly, the Appellate Court stated that the injunction was in respect of the infringing label only and did not extend to the sale of cubes per se. Plaintiff thereafter amended its claims and stated that they wish to restrict their claims to infringement of legal rights over trade dress of the Rubik's cube.

Contentions:

Plaintiff alleged that Defendant has used an identical combination of colours which directly infringes the trade dress of the Plaintiff's product. Plaintiff argued that there are a number of ways in which a puzzle cube can be made, and there are a number of combinations of colours that can be used in relation to it and in fact, a puzzle cube can be expressed in ways other than by use of colors.

Plaintiff claimed that use of the identical trade dress by Defendant shows its bad faith and its malafide intention to free ride on the goodwill created by the Plaintiff in the Rubik's Cube.

Plaintiff also claimed that the combination of colours used by them in its product Rubik's Cube has become distinctive of the Plaintiff's cubes. On the other hand, Defendant submits that the label on the packaging of its product is artistically different and distinct from the label on the packaging of the product of the Plaintiffs and it is a well settled proposition that similarity in trade dress (i.e. packaging and labelling) is to be adjudged on the overall look and not individual elements. Defendant submitted that the overall look of the packaging and labelling used by the Plaintiff and Defendant are entirely different and discernible to the naked eye.

Held:

On the basis of the facts and the evidence on record, the High Court ruled that Plaintiff had been able to establish a prima facie case, and the balance of convenience was in its favour. Accordingly, the interim injunction order already operating was made absolute and Defendants were restrained from selling the infringing cubes with similar trade dress or get up or colour combination as that of Plaintiff's.

Advance Magazine Publishers Inc. & Ors. vs Just Lifestyle Pvt. Ltd.

Bombay High Court, Single Bench, 19th September 2016

Injunction Not Granted

Facts:

Plaintiffs have filed the present trademark infringement and passing off suit, seeking a temporary injunction restraining the Defendant from using the word 'VOGUE' as part of their impugned trade mark "JUST IN VOGUE" or any other deceptively similar mark or trade name in relation to its goods and services. Plaintiffs are registered proprietors and users of the trademark "VOGUE" in respect of magazines, which are said to be published and sold in several countries around the world, including India.

Contentions:

Plaintiffs claimed that in or around January 2009, they came to know of the Defendant's application for registration of the trademark "JUST IN VOGUE" in class 35 in respect of retail stores and sales services, etc. Upon making further inquiries, Plaintiffs claim to have learnt of the Defendant's use of the trademark "JUST IN VOGUE" in relation to retail stores and sales services.

On the other hand, Defendant claims that its stores, run under the name 'JUST IN VOGUE', are known largely for the collection and range of watches and writing instruments belonging to reputable brands. Defendants further claimed that the goods of the Plaintiffs covered by the registered trade mark "VOGUE" are dissimilar to the goods sold or services offered by the Defendant.

Held:

On evaluation of the facts of the case, High Court was of the opinion that it was absurd to suggest that discerning customers who are expected to buy these branded goods are likely to somehow imagine that these goods or the retail services offered by the Defendant in connection with them have some trade connection or association with the Plaintiffs or their magazine 'VOGUE'.

High Court noted that it cannot possibly be suggested that the magazine "VOGUE" competes with either the branded goods retailed by the Defendant or the retail services of the Defendant. High Court observed that there is no per se visual, phonetic and structural similarity between the two marks when they are compared as a whole. High Court held that the similarity in the two was restricted to only by the use of the word 'VOGUE' in both the marks, the word being the whole of the mark in case of one and in a combination of words in the other, and therefore, the dissimilarities between the two marks, when viewed in their entirety, sufficiently outweigh this singular similarity. On such basis, High Court refused to grant Plaintiff's claim for injunction. ■

**Bausch & Lomb Incorporated
vs Union of India**

Gujarat High Court, Single Bench, 3rd October 2016

Facts:

Respondent had filed an application for registration of trademark OCUVIT which had been opposed by the Petitioner on 7th May 2004. Respondent filed its counter statement, which was taken on record and forwarded to the Petitioner/Opponent on 14th October 2004. As per the Trade Marks Rules 2002, Petitioner had 2 months' time to file its evidence in support of opposition, and could avail of a further extension of 1 month. Accordingly, on 30th November 2004, Petitioner applied for an extension of 1 month for filing Opponent's evidence, which request was granted by the Trade Marks Registry on 31st January 2005. Thereafter, instead of submitting the evidence within the extended time limit, Petitioner filed its evidence only on 2nd April 2005 along with an Interlocutory Petition for condonation of delay. The Interlocutory Petition

came up before the Learned Registrar for hearing only on 15th May 2015, when the Learned Registrar ruled that he had no power to condone such delay as per the provisions of Rule 50 of the Trade Marks Rules, 2002. Aggrieved by the order of the Learned Registrar, Petitioner filed the present writ requesting the High Court to set aside the order of the Learned Registrar.

Held:

According to the High Court, the main question involved in the present petition was whether the provisions of Rule 50 of the Rules are 'mandatory' or 'directory' in nature. Single Judge after going through the various decisions relied upon by both parties, such as the case of Sanyo Ceramics, Wyeth Holdings Corporation and the case of M/s. Sunrider Corporation, USA, was of the opinion that the provisions of Rule 50 of the Rules are directory in nature. Considering the facts and circumstances of this case, the Learned Judge set aside the order of the Learned Registrar, allowed the Interlocutory Petition for condonation of delay and directed the Learned Registrar to expeditiously resolve the opposition proceeding. ■

**World Wrestling Entertainment Inc.
vs Reshma Collection & Ors.**

Delhi High Court, Single Bench, 5th October 2016

Injunction Granted With Costs**Facts:**

Plaintiff has filed the present suit for permanent injunction restraining the Defendants from infringement of copyright, infringement of trademarks, passing off, dilution, rendition of accounts, damages, etc. The Plaintiff has additionally prayed for a declaration that its marks are well-known under Section 2(1)(zg) of the Trade Marks Act. Initially, an ex-parte injunction order was granted in favour of Plaintiff. Despite issuing summons, Defendant failed to appear before the High Court and the matter proceeded ex-parte. Plaintiff alleged that in the month of July, 2013, they learnt that Defendants were engaged in selling and offering for sale counterfeit products including T-shirts, caps and wrist bands bearing the images of its talents. The goods of the Defendants displayed

[*Rs./ INR 65 = USD 1 approx]

the characters 'Randy Orton', 'CM Punk' and 'John Cena' and the Plaintiff's registered trade mark 'New Scratch logo'. In addition, the Defendants were also offering for sale T-shirts and caps bearing the Plaintiff's device mark 'U CANT SEE ME'.

Held:

The High Court observed that the evidence on record submitted by Plaintiff established its prior rights in the said trademarks as also established the well-known nature of its WWE mark in India. High Court noted that use of the said marks by Defendants will cause confusion and deception in the market and will cause dilution of the well-known nature of the WWE mark. Accordingly, High Court allowed Plaintiff's request for permanent injunction and also allowed a claim of damages of Rs.5 00,000*.

ABRO Industries Inc. vs Dhirish Nimbawat & Ors.

Delhi High Court, Single Bench, 6th October 2016

Injunction Granted

Facts:

Plaintiff is a leading manufacturer, distributor and exporter of a wide range of products including tapes, sealants, adhesives and epoxies, automotive appearance, maintenance and repair products and paint products worldwide under the trademark and name ABRO. According to Plaintiff, Defendants were involved in the activities of manufacturing, distributing and selling inferior quality counterfeit tapes under the name and mark ABRO, which is identical to the Plaintiff's trademark ABRO. Plaintiff claimed that Defendants have also copied and reproduced each and every essential feature of the packaging material of the Plaintiff's product sold under the trademark ABRO. At the initial stage, an ad interim ex-parte injunction order was awarded to the Plaintiff. On being issued summons, Defendants 1, 2, 4, 5 and 6 appeared before the High Court and the matter was settled between Plaintiff and the said Defendants. However, Defendant No.3 did not appear and the suit proceeded against such single party on ex-parte basis.

Held:

On the issue of trademark infringement, the High Court held that since the marks are identical and the goods being applied to are also identical, the activities of Defendant No. 3 ought to be considered as infringing the registered mark of Plaintiff. On passing off also, High Court ruled in Plaintiff's favour. Accordingly, the High Court allowed the interim injunction granted earlier to be made absolute and decreed the suit.

The Singer Company & Ors. vs Mohammad Fayaz

Delhi High Court, Single Bench, 27th October 2016

Injunction Granted

Facts:

Plaintiffs are world leaders in the sewing machine industry, and started their business in the year 1851 to manufacture and sell a revolutionary product, i.e. a machine to automate and assist in making clothing. In India, the Plaintiff markets a wide range of sewing machines under the mark "MERRITT". The Plaintiff's trademark "MERRITT" was registered in India in the year 1962 and has been used extensively in connection with sewing machines ever since. According to Plaintiff, in the first week of March, 2013, they learnt that sewing machines are being sold in the market under the mark MERRITT STAR. Thereafter, upon making inquiries, it was revealed that sewing machines are being sourced from Delhi by the Defendant. Also, Plaintiffs found out that the Defendant has also filed an application for registration of its mark. Accordingly, Plaintiffs have filed the present suit for permanent injunction restraining infringement of trademark, passing off, dilution, delivery up, etc. against the Defendant.

Contentions:

In response to Plaintiff's allegations of trademark infringement, Defendant had merely denied all the allegations and denied infringement on two grounds. First, that the word 'Merritt' was not associated with the Plaintiffs' and they are not using their primary mark, i.e. 'Singer'. Secondly, that there is no similarity between the marks of the parties, 'Merritt' and 'Merritt Star' to constitute infringement.

Held:

Applying the principles of comparison of trademarks, High Court concluded that Defendant was infringing Plaintiff's registered mark MERRITT and was also indulging in passing off of their products as and for those of the Plaintiff. Accordingly, High Court confirmed the interim injunction order granted earlier and decreed the suit in favour of Plaintiff.

**Flamagas SA
vs Irfan Ahmed & Ors.**

Delhi High Court, Single Bench, 4th November 2016

Injunction Granted With Costs

Facts:

Plaintiff is the first company in the world to introduce refillable gas lighters. For this purpose, the plaintiff adopted the mark "CLIPPER" for identifying its products and the brand "Clipper" was printed on all of Plaintiff's products and product packaging. According to Plaintiff, in the month of March 2015, it learnt that Defendant No. 1 was selling counterfeit lighters with an identical shape as that of the Plaintiff's lighters. Upon investigation, the Plaintiff learnt that the counterfeit lighters identical to that of the Plaintiff's lighters are being imported and sold in India in large quantities by Defendant Nos. 2 to 6, and the only difference being that the counterfeit lighters sold do not bear any trademark.

Accordingly, Plaintiff filed the present suit for permanent injunction restraining infringement of trademark, copyright, passing off, rendition of accounts, etc. At the initial stage, an ex-parte interim injunction was granted to Plaintiff. Despite issuing summons, Defendants failed to appear before the High Court and the matter proceeded ex-parte.

Held:

Applying the tests of trademark infringement as evolved under various judicial precedents, the Single Judge held that the lighters sold by defendants are an exact imitation of the Plaintiff's lighters in all respects including the shape of the lighter. High Court observed that since the marks being used are identical and the goods being

applied to are also identical, Defendants were infringing the registered mark of the Plaintiff. On the issue of passing off also, High Court found in favour of Plaintiff. Accordingly, High Court allowed the interim injunction order granted earlier to be made absolute and also awarded Rs.300,000* to Plaintiff as punitive damages.

**Pepsico Inc. & Anr.
vs Sagarnil Enterprise & Ors.**

Delhi High Court, Single Bench, 21st December 2016

Facts:

The present suit was filed by Plaintiff in November, 2014 seeking permanent injunction against violation and infringement of the rights of the Plaintiff in the trademark/logo/label/name/packaging style of 'AQUAFINA' alleging that the adoption and use by the Defendants of a visually similar and phonetically identical trademark/name/logo/label/packaging 'AQUALINA' for identical products, viz., packaged drinking water. An ex-parte injunction was granted in favour of Plaintiff and also an order allowing appointment of Local Commissioners to visit the Defendant's premises for seizing infringing goods and materials. Upon visiting the Defendant's premises, the local commissioners found two banners, one calendar, twenty-three loose labels and two (20-litres) bottles having labels using the mark AQUALINA, which were seized and submitted before the High Court. Despite issuing summons, Defendants failed to appear before the High Court and the matter proceeded ex-parte.

Held:

Upon consideration of the facts and circumstances of this case, the High Court noted that Plaintiffs had invoked the jurisdiction of the Delhi High Court incorrectly. High Court noted that the first Plaintiff is a corporation existing under the laws of State of North Carolina, USA having its principal office in New York, USA. The second Plaintiff, being a fully owned subsidiary of the first Plaintiff, has its principal registered office located in Gurgaon (in the State of Haryana). Moreover, all the Defendants admittedly reside or work for gain or carry on business in the State of West Bengal.

In view of the same, High Court disposed off the suit

with liberty to Plaintiff to place the matter before an appropriate court. ■

**Prius Auto Industries Ltd. & Ors.
vs Toyota Jidosha Kabushiki Kaisha**

Delhi High Court, Division Bench, 23rd December 2016

Facts:

Respondent, Toyota is an internationally known company, in the trade of manufacture and sale of motor vehicles. Respondent is the registered proprietor of the trademark TOYOTA in countries abroad and even in India pertaining to goods in Class 1 to 5, 7 to 12, 15, 17 to 20, 27, 36, 37 and 39. Toyota learnt that Appellants were selling auto parts meant for use in different brands of automobiles manufactured and sold by Toyota and were marketing the spare parts using the registered trade marks of Toyota. Plaintiff prayed for injunction to restrain the Appellants from manufacturing or selling auto parts using identical or deceptively similar trade marks as that of Toyota i.e. Prius, Toyota, Innova and Toyota device.

Contentions:

Appellants did not challenge Toyota's proprietary rights over the trademarks TOYOTA and INNOVA. Admitting using the words Toyota and Innova on the packaging material in which auto parts were packed, Defendants pleaded that the use was not as a trade mark, but to make it known to the consumers that a particular automobile part was suitable for a particular brand of motor vehicle manufactured and sold by Toyota. With regard to the trademark PRIUS, Appellants claimed that PRIUS was a dictionary word and was honestly adopted. Appellants claimed that they had been using the PRIUS mark since 2001 onwards and Plaintiff had no reputation with regard to the said mark as of 2000 and Plaintiff was guilty of acquiescence since it had not filed the suit till 2009. Initially, an ex-parte interim injunction was granted by the Single Judge of the trial court. Thereafter, the interim injunction was vacated and on an appeal by Plaintiff, the Division Bench imposed an interim arrangement wherein Defendant/Appellants were allowed use of the TOYOTA/INNOVA on a restricted basis.

At the conclusion of the trial, the Single Judge restrained Appellants from using the trademarks TOYOTA/INNOVA in any manner other than what was allowed in the order of the Division Bench. With regard to PRIUS mark, Single Judge restrained Appellants from using the PRIUS mark holding that Plaintiff had established trans-border reputation for the PRIUS mark and merely because the suit was instituted in the year 2009, use by the appellants of the trade mark Prius relating back to the year 2001, would not entitle the Appellants to succeed on the plea of waiver, estoppel, delay and laches.

Held:

After making detailed examination of the evidence on record, the Division Bench held that Toyota has failed to establish trans-border reputation of its trade mark Prius in India when Appellants adopted the same. Division Bench also found credibility in the justification given by the Appellants as to how they adopted the word Prius which was publici juris in the year 2001. Accordingly, the Division Bench allowed the appeal with respect to the limited issues concerning the trade mark PRIUS and set aside the injunction issued relating to the trade mark PRIUS. However, as far as the trademarks TOYOTA and INNOVA were concerned, the order of injunction was retained. ■

**Montblanc Simplo GmbH
vs Gaurav Bhatia & Ors.**

Delhi High Court, Single Bench, 4th January 2017

Injunction Granted

Facts:

Plaintiff is a German company, engaged in the manufacture, distribution and sale of writing instruments and has been producing high quality products with extensive sales and has acquired a distinct and distinguished reputation for its name. Plaintiff had adopted the trademark MEISTERSTUCK 1924 and thereafter, Plaintiff adopted several variants of the trademark along with symbol 'the Star Device' which is a white stylized six-pointed star with rounded edges and the 'Three Ring Device' comprising of three metallic bands around the circumference of the pen which are located near the middle of the body of the pen cap.

Contentions:

Plaintiff alleged that Defendants were operating an e-commerce website www.digaaz.com where it is offering lifestyle and fashion products for sale and supplying counterfeit products bearing several registered trademarks of the Plaintiff. Plaintiff came to know of Defendant's infringing activities in 2013, that the defendants were selling counterfeit product of MONTBLANC writing instruments on their website www.digaaz.com at a discounted rate of 75% representing the product as that of the original product of the Plaintiff. Initially, Defendants filed their written statement in response to Plaintiff's complaint, however, subsequently Defendants stopped appearing before the High Court and the matter proceeded ex-parte.

Held:

The Single Judge noted that from the evidence and documents on record, it was clear that Plaintiff is the proprietor of the trademarks MONTBLANC, MEISTERSTUCK, Star Device and Three Ring Device. High Court observed that Plaintiff has also proved that defendants were counterfeiting their products by copying and marketing the same products as that of the Plaintiff's products through their website. Accordingly, High Court issued a permanent injunction restraining Defendants from using Plaintiff's MONTBLANC, MEISTERSTUCK, Star Device and Three Ring Device trademarks and also passing off their counterfeit products as those of Plaintiff's. ■

SAP SE

vs Saraswati Technologies & Ors

Delhi High Court, Single Bench, 19th January 2017

Injunction Granted With Costs

Facts:

The Plaintiff has filed the present suit for permanent injunction to restrain Defendant No.1 from unauthorisedly reproducing/installing, providing training, classroom and/or offering remote access, of Plaintiff's programs including but not limited to, SAP BASIS, BI/BW, GRC, BOBJ / BODS HANA & FIORI Development & Security, etc., including the use of all training manuals, course material, software, etc., claiming copyright therein

and for restraining the Defendant No.1 from infringing the registered mark 'SAP' or 'SAP Label' and displaying the same on its website and for ancillary reliefs.

Contentions:

Plaintiff claimed that the website of Defendant No.1 on being accessed, directs visitors to the websites of Defendant Nos.2 to 10 from where the software of the Plaintiff can be downloaded. The Plaintiff also sought directions from the High Court that Defendant, Nos.12 to 21, being Internet Service Providers, ought to implement the order sought by the Plaintiff, though no other relief against Defendant Nos.12 to 21, had been claimed. In addition, Plaintiff sought a direction to Defendant Nos.12 to 21, to block the services provided by Defendant Nos.1 to 10, and to prevent Defendant Nos.1 to 10, from carrying out illegal activities but Plaintiff had not explained whether the websites which are sought to be blocked have no other content other than the infringing content. Finally, Plaintiff also sought the relief of injunction against other websites, besides the websites of Defendant Nos.1 to 10, by seeking a John Doe order.

Held:

At the outset, High Court was of the opinion that on the basis of the averments in the plaint and the documents filed therewith has made out a case for grant of ex-parte injunction restraining Defendant Nos.1 to 10, from infringing the copyright in the software programmes aforementioned and the trademark of Plaintiff. However, High Court noted that if Defendant No.1 or anyone else is a lawful user of Plaintiff's software, they cannot be restrained from providing training to any other person. Accordingly, subject to such disclaimer, High Court restrained Defendant Nos.1 to 10 from infringing the copyright of Plaintiff in SAP BASIS, BI/BW, GRC, BOBJ / BODS HANA & FIORI Development & Security and from infringing the trademark 'SAP' or 'SAP Label' of the Plaintiff by using the same on their websites or in any other manner whatsoever.

Additionally, accepting Plaintiff's claim that the websites of Defendant Nos. 1 to 10 contain no content other than the infringing content, High

Court directed Defendant Nos. 12 to 21 (Internet Service Providers) to block the services provided by the websites of Defendant Nos. 1 to 10. Subsequently, Defendant No.1 appeared before the High Court and agreed to suffer a decree of permanent injunction and the High Court further directed Defendant No.1 to pay damages of the sum of Rs.7,50,000* to Plaintiff. ■

**Intas Pharmaceuticals Ltd.
vs Macleods Pharmaceuticals Ltd.**

Delhi High Court, Single Bench, 25th January 2017

Injunction Granted

Facts:

Plaintiff is the proprietor of the trademark GABAPIN for its medicinal preparation comprising the chemical compound "Gabapentin" used primarily for treating epilepsy and neuropathic pain. Plaintiff launched its products under the GABAPIN mark in 1997 and obtained registration of the mark in 2007. Both Plaintiff and Defendant are engaged in the business of manufacture and sale of pharmaceutical preparations.

Contentions:

Plaintiff filed the present suit claiming that Defendant's mark GABAMIN/GABAMIN NT, introduced in the market in 2006, infringed its earlier mark GABAPIN. Plaintiff alleged that it learnt about Defendant's products having been introduced in the market sometime in May 2016. Plaintiff also submitted that earlier, in May 2006, Defendant had applied for registration of the mark "GABAMIN" under class 5 before the Trademark registry and Plaintiff had filed its opposition in January 2010 to which the defendant had failed to file any counter statement. Defendant contended the expression "GABA", being derivative of the chemical compound "Gabapentin" has been used only as a prefix and since the said prefix is a generic term, monopoly cannot be claimed by the Plaintiff. In addition, Defendant submitted that that the rest of its mark is dissimilar and that the suffix "MIN" is sufficient to distinguish the product of the Plaintiff from that of the Defendant's. Defendant also alleged that Plaintiff's claim of knowledge of Defendant's products in 2016 was false, as Plaintiff had knowledge of Defendant's products in 2010

when it filed the opposition.

Held:

High Court observed that Plaintiff's objection to Defendant's mark was not related to the prefix GABA (obviously derived from the chemical compound Gabapentin) but adoption of the suffix MIN which resulted in the complete mark GABAMIN being phonetically similar to Plaintiff's mark GABAPIN. Single Judge also found no substance in Defendant's allegation of suppression of facts about Plaintiff's knowledge of its products in 2016, considering Defendant had not filed any counter statement to the opposition nor submitted any cogent evidence to such effect, but held that at this stage it could not be determined whether Plaintiff was aware of Defendant's products prior to 2016. Considering that Plaintiff is the registered proprietor of the GABAPIN and Defendant did not challenge the validity of Plaintiff's registration, High Court held that Plaintiff is eligible for the grant of interim injunction against Defendant. Accordingly, the High Court issued a temporary injunction against Defendant from using the marks GABAMIN/GABAMIN NT in any manner. ■

**Abbott Healthcare Pvt. Ltd.
vs Fizark Healthcare & Anr.**

Delhi High Court, Single Bench, 28th February 2017

Injunction Granted

Facts:

Plaintiff Abbott Healthcare is the present proprietor of the trademark ESGIPYRIN, after being assigned the trademark from its previous proprietor Piramal Enterprises Limited. In the present suit, Plaintiff alleges infringement and passing off their trademark by Defendants through use of their near identical and deceptively similar mark EASIPYRIN.

Contentions:

Plaintiff claims that it became aware of Defendant's infringing products under the near-identical and deceptively similar mark EASIPYRIN in October 2014. Defendants were asked to appear before the High Court through summons, but they failed to appear and the matter proceeded ex-parte.

Held:

The High Court held that a comparison of the rival marks and the nature of pharmaceutical products clearly showed that Plaintiff's grievances were genuine and well founded. High Court also noted the stark similarity in the packaging and trade dress of the Defendants' products to the Plaintiff's products, which was established through evidence. Defendants being ex-parte, all of Plaintiff's evidence or submissions remained uncontested. Accordingly, High Court granted Plaintiff's request and issued a permanent injunction restraining Defendants from using the trademark EASIPYRIN or the deceptive packaging/trade dress ■

Boman R. Irani

vs Rashid Ahmad Mirza & Ors.

Delhi High Court, Single Bench, 17th April 2017

Injunction Not Granted

Facts and Contentions:

Defendants have obtained registration of the mark "YEZDI" in 2008, in relation to footwear under Class 25.

- Plaintiff filed suit alleging that Defendants were passing off their footwear with the trademark "YEZDI" as that of the Plaintiff's or emanating from the house of the Plaintiff, and that Defendants had dishonestly copied the word YEZDI to create an impression of association/collaboration between the Plaintiff and the Defendant

Plaintiff claimed the following:

- The mark YEZDI was coined by Plaintiff's father Mr. Rustom Irani from the name of his native province Yazd in Iran.
- The first YEZDI branded motor-bike was launched in the year 1968.
- The mark YEZDI in word and label form was used from 1969 onwards for motorcycles manufactured by Ideal Jawa (India) Pvt. Ltd. (IJIPL), a company promoted by Plaintiff's father, and since his demise the brand YEZDI had devolved upon the Plaintiff who continued to allow its permitted use by IJIPL.
- Though manufacturing of the YEZDI motorcycles ceased in 1996, and registration of the trademark was not renewed after 1997, he continued to own the website www.yezdi.com and to advertise and promote the YEZDI brand in India, and that he was in the process of reviving manufacturing of the motorcycles under the

brand YEZDI and of launching refurbished YEZDI motorcycles.

- The Official Liquidator in the proceedings for winding up of IJIPL has staked a claim to the trademark YEZDI.
- The brand YEZDI continues to enjoy extensive reputation and goodwill owing to long usage and popularity among motorcycle enthusiasts, social media presence and resale market.
- In 2013 and 2014, he filed applications for registration of various YEZDI trademarks and that he was the copyright owner of the artistic work in the YEZDI label.

The Defendants disputed the Plaintiff's ownership of the mark YEZDI and contended as follows:

- Plaintiff has not filed any document in support of the title claimed to the mark YEZDI or that his father licensed the brand to IJIPL
- The registrations for YEZDI were obtained by IJIPL and the record does not show the Plaintiff or his father as predecessor-in-interest.
- The Official Liquidator of IJIPL has admittedly claimed adversely to the Plaintiff and should be a necessary party to this suit.
- Plaintiff is not entitled to injunction on grounds of laches, acquiescence and waiver.
- YEZDI is not an invented word but the name of a religious community.
- The question of passing off does not arise as the Plaintiff has admittedly never used the trademark YEZDI. IJIPL has also not used the trademark YEZDI since 1996, and has abandoned the trademark registrations in its favour.
- On the contrary, Defendants have been continuously using the mark since 2008, and are the owners of the registered trademark "YEZDI". Further, the Defendants have acquired goodwill and reputation in the mark "YEZDI" for footwear and that there is no scope of confusion between the goods motorcycles and shoes.

Held:

The High Court was of the prima facie view that the Plaintiff is not entitled to interim injunction for the following reasons:

- (i) The Plaintiff is yet to prove his title to the mark.
- (ii) Defendants are admittedly the registered proprietor of the mark "YEZDI" in Class 25 without any objection from the Plaintiff.
- (iii) The Plaintiff himself or through anyone else is

not using the mark in relation to any goods, admittedly for at least ten years prior to the institution of the suit. It is yet to be established that the acts claimed by the Plaintiff amount to use of the mark.

(iv) It is yet to be established that use by the Defendants of the mark amounts to the Defendants passing off their goods as that of the Plaintiff's or the goods of the Defendants being consumed for the reason of association with the Plaintiff.

(v) The Plaintiff will not suffer any injury from non-grant of interim injunction, but the Defendants will suffer irreparable injury from grant of interim injunction.

(vi) The balance of convenience is thus in favour of the Defendants. However, Defendants were restrained from mentioning in their advertising, marketing websites or otherwise that their mark is inspired by YEZDI motorcycles. ■

Biswanath Hosiery Mills Ltd. vs Mohd Azharuddin

Delhi High Court 21st November 2013 and 18th May 2017

Injunction Granted

Facts and Contentions:

Plaintiff commenced use of the trademark LUX in the year 1957 and has been using it in relation to a range of clothing, hosiery items, etc. Thereafter, sometime in 2002 it extended the LUX series of trademarks and adopted the mark LUX COZI. Plaintiff's trademark LUX is also registered in various countries, including India, since 1972.

In July 2012, the Plaintiff came to know that the Defendants had obtained registration for the trademark LUX COZI JEANS, which was identical to the Plaintiff's prior adopted and prior use, well-known mark LUX and LUX COZI. Plaintiff filed a rectification petition before the Intellectual Property Appellate Board on 30 July 2012, and a suit for passing off before the Delhi High Court.

Held:

It is clear that the Plaintiff has been using the mark LUX COZI since 2002 from the material placed on record, and therefore prior to the use by Defendant. No provision of the Act bars an action for passing off by an anterior user of a trade mark against a registered user of the same.

In other words registration does not provide a defence to proceedings for passing off. Plaintiff has made out a prima facie case in its favour. Balance of convenience is also in favour of the Plaintiff. The High Court restrained, by interim injunction, the Defendant from using the impugned trademark LUX/LUX COZI or any other deceptively similar mark on their goods till further hearing. Thereafter, a settlement agreement was entered into by both parties on 30th March 2017, in which the Defendant acknowledged that the Plaintiff is the true and lawful owner of the trademarks LUX and LUX COZI in respect of hosiery items and related goods included in Classes 23, 24 and 25 of International Classification of Goods/Services under the Trade Marks Act, 1999 and undertook not to use the same in respect of clothing items or any other goods which may lead to infringement of those trademarks.

The High Court held the settlement arrived at between the parties as lawful and the suit was decreed in terms of the settlement. ■

Burberry Group PLC vs Digaaaz E-Commerce Pvt. Ltd.

Delhi High Court, Single Bench, 8th September 2017

Injunction Granted

Facts:

Plaintiff is a company established under the laws of England and has an Indian subsidiary through which it markets and sells its products in India. Plaintiff's business was founded in 1856 by Thomas Burberry in Basingstoke, England. Over the past one and a half centuries, Plaintiff had been trading under "T. BURBERRY", "BURBERRY & Sons", BURBERRY'S and now BURBERRY, and the business has flourished to the extent that the Plaintiff is now one of the most renowned luxury brands in the world today. Defendant on the other hand is a private limited company incorporated in India, engaged in the business of online sales of a wide range of products including men's and women's apparel, footwear, bags, handbags, wallets, accessories like sunglasses, etc.

In September, 2013, Plaintiff came to know that the Defendant is dishonestly selling or offering for sale counterfeit products styled and marketed to be products of the Plaintiff's, under the trademarks

BURBERRY, BURBERRY CHECK and Equestrian Knight Device, in relation to men's shirts, handbags, etc., infringing the Plaintiff's intellectual property rights, posting advertisements and offering for sale such products on their website www.digaaz.com without permission or authorization from the Plaintiff. Aggrieved by the Defendant's infringing activities, the Plaintiff filed a suit for trademark infringement and passing off.

Held:

Despite being notified, the Defendant failed to appear before the Delhi High Court, and accordingly, the matter proceeded ex-parte against such Defendant. The Delhi High Court issued a decree of injunction in favour of the Plaintiff as the claims remained un-rebutted. However, since the Plaintiff was unable to prove the existence of any infringing/counterfeit material bearing the impugned marks or provide any evidence to support its claims for damages, the High Court did not deal with such claims in its decision ■

Nokia Corporation & Ors. vs Movie Express & Ors.

Delhi High Court, Single Bench, 3rd November 2017

Injunction Granted With Costs

Facts:

Nokia Corporation, a Finnish entity, is the proprietor of the trademark NOKIA which was adopted in 1865. Since its adoption, Plaintiffs expanded the use of the trade mark NOKIA on and in connection with a wide variety of products ranging from paper, rubber boots, tyres, power generation, cable and electronics business to its now famous telecommunication and mobile phone related business. The Defendant No.1 Movie Express is an advertising agency involved in promotion, sponsorship for new movies and mass media communication such as short films, ad-films and audio-visual aids, Defendant No.2 is a production house involved in producing movies and Defendant No. 3 is a film producer. In 2011, the Defendants approached the Plaintiffs for in-film branding and proposed the title of a movie – Mr. NOKIA. The proposal was not acceptable to the Plaintiffs, which was communicated to the Defendants via email. Thereafter, Plaintiffs came across a press release

claiming production of a movie entitled Mr. NOKIA by the Defendants. Aggrieved, the Plaintiffs filed a suit for trademark infringement against the Defendants.

Contentions:

At the initial stage of the suit, an ex-parte interim injunction was issued in favour of the Plaintiffs and against the Defendants. Subsequently, the Plaintiffs came across news reports that suggested that the Defendants were set to release a movie under the name NOOKAYYA. Plaintiffs filed a contempt petition, and obtained favourable orders from the High Court. Despite the same, Defendants released the movie NOOKAYYA. The Plaintiffs submitted evidence before the High Court showing availability of the movie NOOKAYYA in CD formats in addition to availability via online streaming over the Internet. The High Court examined the evidence on record and held that the movie names Mr. NOKIA and/or Mr. NO.KEYIA and/or Mr. NAV-KIA and/or NOOKAIAH were deceptively and confusingly similar to the Plaintiffs' well-known and registered mark NOKIA.

Held:

The High Court was of the opinion that the Plaintiffs' mark NOKIA is a well known registered trade mark and has repute in India, and that the use of the mark by the Defendants, is without due cause and detrimental to the distinctive character of the NOKIA mark. Accordingly, the High Court issued a decree of permanent injunction against the Defendants as per the Plaintiffs' request. The High Court also awarded damages to the tune of Rs. 500,000* to the Plaintiffs, payable to them by the Defendants ■

Samsung Electronics Co. Ltd. & Anr. vs D. R. Radio Corporation & Ors.


Delhi High Court, Single Bench, 15th November 2017

Injunction Granted

Facts:

Plaintiffs are a part of the SAMSUNG group of companies and the group's core business sectors consist of electronics, finance, trade and services. The Plaintiffs are engaged in the business of

[*Rs./ INR 65 = USD 1 approx]

manufacturing and trading in telecommunication devices such as mobile phones, tablets, hand-held devices, etc. and are today the number one mobile phone manufacturer/trader in the world. Plaintiff No. 1 is the proprietor of the mark SAMSUNG and the SAMSUNG formative works, including the oval device . In January-February 2015, the Plaintiffs conducted an investigation in various markets in Delhi, Mumbai, Ahmedabad and Surat in order to ascertain the extent and the amount of infringing SAMSUNG goods available in the Indian market.

Such survey revealed the Defendants' goods such as sewing machines, gas stoves, rubber hoses, mixers, helmets, t-shirts, mobile accessories, DVD players, etc. bearing the Plaintiffs' trademark SAMSUNG. Accordingly, a trademark infringement and passing off suit was filed by the Plaintiffs against a total of 47 Defendants.

Contentions:

At the initial stage of the suit, the High Court issued an ex-parte interim injunction against Defendant Nos. 1 to 36. Thereafter, Defendant Nos. 9, 19, 31, 32, 33, 36 and 37 to 47 were deleted from the array of parties and the suit was decreed in favour of the Plaintiffs, and against the Defendant Nos. 2, 12, 13 and 17, in accordance with prayers of complaint filed by the Plaintiffs to the statement/undertaking given by the them. The remaining Defendants did not appear before the High Court despite being notified, hence they were declared ex-parte.

Plaintiffs submitted that their mark SAMSUNG is a well-known mark in India and sought a declaration to such effect from the High Court. Plaintiffs further submitted that the goods/products of the Defendants were counterfeit and the acts of the Defendants were deliberate and to consciously deceive the public into believing that the infringing goods originate from the Plaintiffs.

Held:

The High Court accepted the Plaintiffs' prayers in so far as infringement and passing off of Plaintiffs' rights in the SAMSUNG marks by the Defendants were concerned. Accordingly, the High Court issued a decree of permanent injunction against the remaining Defendants. However, with regard to the Plaintiffs' request for determination of the

SAMSUNG mark to be a well-known mark in India, the High Court held that the Plaintiffs have to resort to the procedure established under the new Trade Marks Rules 2017. The High Court opined that since this was an uncontested proceeding, the Plaintiffs could not be allowed to circumvent the procedure under the Rules. The High Court went on to state that it could have issued a well-reasoned and well-weighted order regarding the maintainability of the Plaintiffs' claim that the mark SAMSUNG is well-known, provided this were a contested proceeding. ■

Perfetti Van Melle SPA & Anr. vs Tanya Lakhwani & Ors.

Delhi High Court, Single Bench, 7th December 2017

Injunction Granted

Facts and Contentions:

Plaintiff is engaged in producing and selling its candy gums with the trademark/word mark CENTER FRUIT.

Defendant were found to be using a deceptively similar trademark FRUIT SENTER for the same product, i.e., candy gums, with more or less similar colour combination of the labels, i.e., magenta and green.

Plaintiff is a multinational company having worldwide presence and its turnover runs into crores of rupees and therefore, Plaintiff, in order to protect its reputation, always ensures impeccable quality of its products, including CENTER FRUIT candy. Plaintiff argued, relying on a precedent of this Court wherein it was observed that where the products being sold are such that they affect children's or minors' health or that of other vulnerable sections of the society then, in such case a Court, to protect public interest being the health of children, would be inclined to grant ex parte injunction. Plaintiff also argued relying on a decision of the Supreme Court wherein it was observed that once a manufacturer who is a Plaintiff takes scrupulous care of the quality of its product, and which a Defendant as per his nature/scale of business or a type of business may not do so, then this would be one of the grounds for the courts to consider grant of interim orders.

Held:

In view of the arguments placed by the Plaintiff, the

High Court granted an injunction restraining the Defendants from selling any candy products or other related products with the trademark/word mark FRUIT SENTER or any other trademark/word mark which is identical or nearly identical or deceptively similar the trademark/word mark CENTER FRESH of the Plaintiff.

The Court also appointed a Local Commissioner to visit the premises of Defendant No. 1. ■

**Christian Louboutin
vs Kamal Family Footwear & Ors.**

Delhi High Court, Single Bench, 12th December 2017

Injunction Granted With Costs

Facts:

Plaintiff is a company incorporated under the laws of France. Plaintiff derived its name from Mr. Christian Louboutin, famous designer of high end luxury products known for his signature "RED SOLE" high heeled shoes. Defendants own retail outlets and are in the business of selling women's shoes and accessories. In addition, Defendants operate through social media platforms such as Facebook. Plaintiff learned of Defendants' use of the its 'RED SOLE' trademark for ladies shoes being sold by the Defendants through a market survey. Further investigation conducted by the Plaintiff confirmed the infringing activities of the Defendants. Accordingly, Plaintiff filed a suit for trademark infringement and passing off against the Defendants.

Contentions:

Despite notice, Defendant Nos. 1 to 3 did not appear before the High Court and the proceeding continued on ex-parte basis against them. On the other hand, Defendant Nos. 4 and 5 submitted their written statement in response to the complaint filed by the Plaintiff, but did not appear before the High Court. Therefore, the proceeding continued ex-parte against the said Defendants as well. The High Court appointed Local Commissioners who visited the Defendants' premises and seized the infringing products. Plaintiff placed on record evidence of its prior rights and reputation associated with the RED SOLE mark, along with confiscated items and with other evidence of the infringing goods manufactured/sold by the Defendants before the High Court.

Held:

The High Court was convinced that a prima facie case of trademark infringement and passing off had been successfully established by the Plaintiff. Accordingly, a decree of permanent injunction was issued by the High Court in favour of the Plaintiff and against the Defendants. On the issue of compensation, the High Court examined the evidence on record as well as the judicial precedents, and awarded damages to the tune of Rs.15,093/- in favour of the Plaintiff and against Defendant Nos. 1 to 3 and Rs.1,48,088/- in favour of Plaintiff and against Defendant Nos. 4 and 5. The High Court also awarded costs towards legal fees to the tune of Rs.4,31,895*/- in favour of the Plaintiff and against Defendant Nos. 1 to 3 and Rs.4,31,895*/- in favour of the Plaintiff and against Defendant Nos. 4 & 5. ■

**Bigtree Entertainment Pvt. Ltd.
vs Brain Seed Sportainment Pvt. Ltd. & Anr.**
Delhi High Court, Single Bench, 13th December 2017

Permanent Injunction Not Granted

Facts and Contentions:

- **P**laintiff established its company in 1999. Its website "www.bookmyshow.com" was launched in 2007. Plaintiff provides a range of ticketing solutions through call centers, Internet ticketing, kiosk and a mobile ticketing platform from its website and mobile app BOOKMYSHOW.
- Defendant's company was incorporated in May 2015. Defendant's website, "www.bookmysports.com", is an online platform for booking sports facilities. The domain name "www.bookmysports.com" was created on 6th March, 2010. The creator is unknown. During the period 6th March, 2010 to 15th May, 2015, the domain was parked on the World Wide Web with no activity.
- Plaintiff claims to have become aware of the domain in December 2015 and filed suit in April 2016, for infringement and passing off. The High Court granted an ex parte ad interim order of injunction which was later suspended on 20th September 2016, and the order remained in abeyance till the present hearing.

Plaintiff claimed the following:

- Since launching of its website in 2007, Plaintiff has emerged as a prominent player in the ticketing

industry major sports events and cinema houses and had established its presence in 26 states in India.

- Plaintiff has secured several trademarks under Classes 41 and 42 for BOOKMYSHOW word marks and logos, and had filed applications for numerous other BOOKMYSHOW and BOOKMY trademarks as well.
- Plaintiff gave examples of diligently safeguarding its trademark interests in the past, including against the domain "www.bookmysport.in", which had no relation to Defendant.
- Plaintiff believed that its performance in the ticketing industry and the wide publicity associated with it, gives the BOOKMYSHOW trademark a secondary meaning associated with high standards of service delivery and professionalism, further claiming that the prefix BOOKMY is an essential part of Plaintiff's registered trademark having acquired distinctiveness over a period of time.
- Plaintiff claimed that Defendant's trademark is deceptively similar to that of the Plaintiff's and can mislead prospective clients into associating the Defendant's domain with the Plaintiff's due to the substantial goodwill and publicity acquired by Plaintiff and that this amounts to infringement and passing off of the Plaintiff's trademarks.
- Plaintiff conceded that it does not possess trademark on the prefix BOOKMY but avers that it is not the words BOOK, MY, and SHOW in isolation, but the interplay of these words which give the trademark distinctiveness. Plaintiff claims that continued existence of Defendant's domain name is financially detrimental and injurious to its reputation.

Defendants disputed the Plaintiff's ownership of the word BOOKMY and contended as follows:

- Concealment of contrary stand in other proceedings, namely Plaintiff had admitted in a letter to the Registrar of Trademarks that Defendant's trademark BOOKMYSPO RTS is dissimilar and distinct from Plaintiff's trademark BOOKMYSHOW.
- Plaintiff had falsely pleaded to be the exclusive user and adopter of the mark BOOKMY/BOOKMYSHOW.
- Third party prior use and registrations were concealed.
- Concealment and misrepresentation with regard to the cause of action.
- Concealment of opposition to, and rectifications filed against, the Plaintiff's trademark BOOKMY and BOOKMYSHOW.
- That Defendant's domain of activity being booking sports facilities is squarely different from

that of the Plaintiff's except that they are both engaged in facilitating online bookings.

- That the prefix BOOKMY is not an invented phrase meriting legal protection, but a descriptive one that is common to the particular business being run. To support this Defendant placed on record a list of domain names containing the prefix in question that had been registered prior to Plaintiff's as well as a list of domain names that have been registered since.
- That Defendant's trademark is visually, structurally, and conceptually different from that of the Plaintiff's and not likely to cause deception or confusion with the Plaintiff's mark.

The Plaintiff submitted in its rejoinder to clarify the parameters of its suit, as follows:

- That its word mark BOOKMYSHOW was registered in Class 41 which includes providing sports facilities and rental of sports grounds
- That the Defendant was guilty of dishonest adoption as it was aware of the goodwill of Plaintiff's BOOKMYSHOW mark and the BOOKMY prefix, and has not placed on record any information about its business activities.
- That the Defendant had not challenged the legal validity of the Plaintiff's mark because Defendant itself wants the mark BOOKMYSPO RTS and a party that wants a monopoly on a mark cannot be heard to say that the mark cannot be registered.
- That the Plaintiff's correspondence with the Registrar of Trademarks should be construed as a layered response rather than a legally binding conceding of its rights.

The Single Judge HELD:

- That it is not in dispute that the Plaintiff owns a trademark for its domain name, www.bookmyshow.com. Therefore determining whether the Defendant's use of the prefix common to both trademarks, BOOKMY, amounts to infringement and/or passing off of the Plaintiff's mark hinges on the ancillary question of whether the prefix is a descriptive phrase or an invented term.
- Examination of the market in which the prefix is abundant further gives the impression that the prefix is not invented but a description of the type of business that is being run.
- The phrase BOOKMY is not an arbitrary coupling of two English words but an apt description of a business that is involved in the booking of a

particular thing for its consumers, whether it is a concert, a movie, or a sports facility.

- In the present case Defendant placed on record examples of numerous other companies that operate with the same domain prefix, and the Plaintiff was yet to put on record any evidence suggesting that the prefix BOOKMY is only associated in the minds of the public with the Plaintiff's business and none else, and therefore had acquired a secondary meaning and distinctiveness.
- Considering the fact that the words BOOKMY are descriptive in nature and Plaintiff's trademark BOOKMYSHOW has not acquired a distinctive meaning, no case for grant of permanent injunction pending hearing of the suit is made out. ■

Levi Strauss & Co. vs Rajesh Agarwal

Delhi High Court, Single Bench, 3rd January 2018

Injunction Granted

Facts:

The Plaintiff had filed the present suit for permanent injunction restraining the Defendant from infringement and passing off of the trademark and copyright in respect of the Plaintiff's trademark "LEVI'S", "LEVI STRAUSS", derivatives and labels. The Plaintiff had alleged that the Defendant was selling wearing apparel bearing identical logos and devices as that of the Plaintiff's.

Contentions:

The suit was transferred to the Delhi District Court. In the suit, proceedings were conducted ex-parte, as the Defendant did not appear before the Court despite repeated notices. In October 2001, an ex-parte interim injunction was granted in the suit, which continued till the disposal of the suit by the District Court in November 2006. The District Court had also appointed an officer to visit and search the Defendant's premises and seize any infringing goods, if found. However, the District Court dismissed the Plaintiff's suit on two grounds. Firstly, the Plaintiff had not examined the Local Commissioner who had conducted the search and seizure at the Defendant's premises, and secondly, that no assignment deed was furnished to show that Plaintiff No.1 had assigned its trademarks to its Indian subsidiary Levi Strauss India Pvt. Ltd. Plaintiff

filed an appeal against the decision of the District Court before the High Court.

Held:

On appeal, the Delhi High Court held, that the Local Commissioner is an officer of the court, and the report filed by him is already part of the evidence on record. Hence, there was no need for further examination of such Local Commissioner by the Plaintiff. On the second issue, the High Court ruled that the Plaintiff was the registered proprietor of the LEVI'S trademarks, and had filed the suit on such proprietary rights. The High Court noted that the sales and advertising information provided by the Plaintiff had been incurred by the Plaintiff's subsidiary in India and the same relate to the trademarks in issue. High Court also noted that Plaintiff had furnished documentary evidence to show that such usage was through its Indian subsidiary. The High Court held that the fact that the sales and advertising were carried out through the Indian affiliate company does not in any manner prejudice the Appellant inasmuch as the said Indian Company along with the Plaintiff ought to be treated as 'one economic entity'. On the basis of the above, the Delhi High Court upheld the appeal and set aside the order of the District Court. ■

Kellogg Company vs Pops Food Products (P) Ltd.

Delhi High Court, Single Bench, 5th January 2018

Facts:

The Respondent Pops Food Products is the proprietor of the registered trademark "POPS" in India, in a number of classes including Class 30. Pops Food Products had been using the said trademark for its goods, being chewing gum, bubble gum and dairy products. On the other hand, Kellogg was the registered proprietor of the trademark "POPS" bearing registration no. 507137 in class 30. The trademark had been registered in favour of Kellogg since 16.03.1989 and was subsisting in its name for the past 22 years.

Pops Food had filed an application for registration of a trademark "POPS" in class 30 which also included use for confectionery. Kellogg sent a legal notice to Pops Food indicating its intention to oppose the

respondent's application. In July, 2001, Pops Food filed a cancellation petition, which was subsequently allowed by the Intellectual Property Appellate Board (IPAB) by its order dated 06.01.2012. Kellogg filed the subject writ petition, challenging the said IPAB order.

Contentions:

In the writ petition, Kellogg alleged that the IPAB order was erroneous as Pops Food was not a person aggrieved and, therefore, could not maintain an application for rectification of the registration in respect of the impugned mark. Kellogg further alleged that the IPAB had failed to appreciate that Kellogg intended to use the trademark in question in India.

Held:

The High Court observed that Pops Food was the registered proprietor of POPS, which it was using in respect of chewing gums and bubble gums. The dispute between the parties arose when Pops Food applied to register POPS for confectionery items. Moreover, the High Court noted that the trade channels for breakfast cereals and confectionery items were similar, and both were targeted at children. Hence, Pops Food was reasonable in its apprehension that the target consumers could be confused into assuming that the disputed mark used in respect of breakfast cereals belonged to Pops Food. The High Court was of the opinion that use of the trademark POPS – which had been used by Pops Food for several years – by any other entity, would result in dilution of the POPS mark. The High Court further stated that Kellogg had itself sent a legal notice to Pops Foods, hence it had itself felt threatened by the application for POPS filed by Pops Food. Hence, Kellogg could hardly allege that Pops Food was not affected by the registration of the disputed mark, and hence, was not an aggrieved person.

In addition, the High Court found that there was no doubt that the disputed mark had not been used by Kellogg upto three months prior to the date of the cancellation petition – in fact, the trademark had been filed on the basis of proposed use, and had not been used since the date of registration. The High Court held that there was no infirmity in the order issued by the IPAB, and hence, dismissed the writ petition ■

E.I. du Pont de Nemours and Company & Anr. vs Jeetender Kumar Kaushik & Ors.

Delhi High Court, Single Bench, 16th January 2018

Injunction Granted

Facts:

Plaintiffs are a world renowned global company, having a diverse array of product offerings. Plaintiff No.1 is also the registered proprietor of its well-brands CORAGEN and DUPONT. Plaintiffs claimed that they had received that there was large scale counterfeiting of CORAGEN products in certain areas/districts. Accordingly, Plaintiffs deployed their representatives to visit those areas/districts. As per the Plaintiffs the survey revealed that there are several counterfeiters of CORAGEN, authorized distributors of CORAGEN, as well as manufacturers and sellers of products wrongly claiming to be bio-products but was, in fact, the Plaintiffs' patented product and insecticide CTPR. Consequently, the Plaintiffs filed the present suit for trademark infringement and passing off.

Contentions:

The High Court appointed Court officers to conduct search of the Defendants' premises, and seize any counterfeit products, if found. The Court-appointed officers seized a number of infringing products from the Defendants' premises. Defendants had initially filed a response to the complaint filed by the Plaintiffs but stopped appearing before the High Court thereafter. As a result, the proceedings were conducted ex-parte. The Plaintiffs prayed to the High Court for a default decree of injunction, considering that the matter was ex-parte, and drew the High Court's attention to judicial precedents on this issue.

Held:

The High Court accepted the Plaintiffs' argument, and opined that since the Plaintiffs were the prior and registered proprietor and user of the trademark in question, the Defendants had no justification in adopting the said mark. The High Court issued a decree against the Defendants as prayed for by the Plaintiffs ■

Louis Vuitton Malletier vs Kapil Pahuja & Ors.

Delhi High Court, Single Bench, 16th January 2018

Injunction Granted

Facts:

The Plaintiff, a French entity, has built and maintained a reputation for producing a variety of lifestyle goods that are products of imaginative and distinctive designs, etc. The Plaintiff is the proprietor of several trademarks in India such as "LOUIS VUITTON" word mark, the "LV" logo, the Toile monogram pattern, the Damier pattern and the LV Flower Patterns, etc.

The Defendants have shops located in Chandigarh, which are involved in the business of selling apparel and fashion accessories. According to the Plaintiff, the Defendants' shops were found to be dealing in counterfeit goods bearing various registered trademarks of the Plaintiff. The Plaintiff had filed a suit for trademark infringement and passing off against the Defendants.

Contentions:

The High Court had appointed officers to conduct a search of Defendants' shops and seize any infringing products, if found. The Court-appointed officers located 174 infringing products in the Defendants' shops. Defendants argued that the Delhi High Court could not exercise its jurisdiction as the cause of action had not arisen within the territorial jurisdiction of the said court. Defendants also denied that the goods found within their premises were counterfeit products.

Held:

The High Court noted that the Plaintiff does not carry on business at Chandigarh where the cause of action had arisen. The High Court found that the Plaintiff conducted its business from Delhi. The High Court held that as per the provisions of the Trade Mark Act, Delhi High Court would have territorial jurisdiction to adjudicate the suit. The Court also observed that the Defendants had not made any counter-arguments on the merits of the case, except bland denials. Accordingly, the High Court issued a decree of mandatory injunction against the Defendants. ■

Ferrero SPA & Anr. vs Piyush Devangan & Anr.

Delhi High Court, Single Bench, 22nd January 2018

Injunction Granted

Facts:

Plaintiffs' chocolates are sold under the trademark FERRERO ROCHER at worldwide level and are amongst the best known confectionery products in the world. Through a market survey, Plaintiff became aware that the defendants are manufacturing and selling look-alikes of the Plaintiffs' FERRERO ROCHER chocolate specialities under the name D-Lizie. Plaintiffs filed a suit for trademark infringement and passing off against the Defendants claiming that the Defendants' products have not only copied the trade dress of the individual pieces of the FERRERO ROCHER chocolate specialities but have also copied the overall getup and the unique aspects of the packaging of the Plaintiffs' product.

Held:

The Defendants did not appear before the Court despite being notified and hence, the proceedings were conducted ex-parte. The High Court held that the details of the complaint and the evidence on record clearly showed that the Defendants are infringing the statutory and common law rights of the Plaintiffs with respect to the said products and the trade dress. Accordingly, the High Court issued a decree of permanent injunction against the Defendants. ■

Paramount Surgimed Ltd. vs Paramount Bed India Pvt. Ltd. & Ors.

Delhi High Court, Single Bench, 25th May 2017

Ex-parte Injunction Vacated

Facts and Contentions:

- Plaintiff, an Indian company, claims to have adopted the word PARAMOUNT in 1993 as part of its corporate name.
- Plaintiff's products including surgical blades, disposable scalpels, stitch cutters, skin graft blades, etc., are manufactured and sold under the mark and name PARAMOUNT.
- Plaintiff has also stated that it is manufacturing, exporting and supplying intensive care hospital beds

in India through its sister concern United Poly Engineering Pvt. Ltd. which was established in the year 1980, and that its products are exported to over 50 countries.

- Plaintiff is the registered proprietor of label mark PARAMOUNT under Class 10 (surgical, medical, dental, etc.), as also in Class 20 (furniture, mirrors, picture frames, etc.) and its first registration for the mark PARAMOUNT dates back to the year 2000.
- Plaintiff's contention is that it is the prior adopted user and lawful owner of the trademark /name PARAMOUNT.
- Defendant No.1 is an Indian company incorporated in the year 2012. Defendant No.2 is a foreign company incorporated under the laws of Japan. It is engaged in manufacturing, selling and exporting hospital beds under the trademark PARAMOUNT.
- Plaintiff contended that Defendants have recently adopted and started using Plaintiff's trademark /label PARAMOUNT as their trade name in relation to their impugned goods and activities in India.
- Plaintiff further contended that adoption by the Defendants of the trade name PARAMOUNT, which is the Plaintiff's registered mark, is dishonest and the Defendants are riding upon the Plaintiff's goodwill and reputation which it has built up over the years.
- In March 2012, Defendant No.2 had been directed to file a response to the notice of opposition dated 01.04.2009 filed by the Plaintiff, but no response was received.
- Claiming irreparable loss and injury, tarnishment and balance of convenience, Plaintiff filed the present suit and had prayed for an ad-interim ex-parte order.
- On 23.03.2017 an ex-parte order had been passed in the Plaintiff's favour.

Defendants moved an application seeking modification of the order based on the following contentions:

1. That the Plaintiff obtained the ex-parte order on 23.03.2017 by concealing material facts. The Plaintiff was well aware of the Defendants, having filed an opposition in 2009 against Defendants' application dated 25.4.2007 for registration of their trademark PARAMOUNT. Further, in 2012, the parties were in active negotiations with one another, clearly showing that the Plaintiff was well aware that the Defendants were in the market for the sale of hospital beds. Thus the Plaintiff's submission that it learned about the

Defendants' activities only in February, 2017 is clearly a wrong statement and the Plaintiff is not entitled to any equitable relief from this Court.

2. The Defendants have been prior users of the mark PARAMOUNT which they adopted as early as 1950 and the trademark PARAMOUNT is registered in over 20 countries.
3. Defendants also contended that the Plaintiff's registration of the mark PARAMOUNT is, in fact, dishonest.
4. Defendants further contended that the Plaintiff had not come into the market for sale of hospital beds and although it's mark PARAMOUNT may have been registered in Classes 10 and 20, there is no document to show that it is selling hospital beds.

The High Court held that:

- This is not a case where the Plaintiff was unaware that the Defendants were about to commence the sale of their product. It was well known to the Plaintiff long back and even as per the showing of the Plaintiff dating back to the year 2009 when it had filed its opposition to the trade mark registration application of the Defendants. The Defendants have in fact been in the market with a fair amount of publicity; this also entitles Defendants to the discontinuation of the interim order in favour of the Plaintiff.
- Although the Plaintiff has a registration for PARAMOUNT, it has not been selling hospital beds under the said trade name. The miniscule sales of five single beds in one current year and there being a gap of almost seven years between 2010 to 2017 when there was no sale effected of any hospital bed by the Plaintiff clearly reflects that the Plaintiff is not really into the business of sale of hospital beds. On the other hand the Defendants' sales figures showed that since the year 2014-2015, their initial sales figure of Rs.22 million* plus had escalated to more than Rs.35 million* in the year ending 2015-16.
- The Plaintiff has failed to establish a prima facie case in its favour. Balance of convenience is in fact in favour of the Defendants. If an injunction is granted, at this stage, the business which the Defendants have built up over the years, of which the Plaintiff was well aware, would be brought to a stand-still; irreparable loss and injury would be suffered by the Defendants which may not be able to be compensated at a later stage.
- Accordingly, the ex-parte order dated 23.03.2017 is set aside and Defendants' Prayer is allowed. ■

[*Rs./ INR 65 = USD 1 approx]

Telefonaktiebolaget LM Ericsson vs Xiaomi Technology & Ors.

Delhi High Court, Single Bench, 22nd April 2016

Injunction Vacated

Facts:

Plaintiff filed a patent infringement suit against the Defendants in relation to products (telephone instruments, mobile handsets, tablets, hand held devices, dongles, etc.) that include the AMR, 3G and EDGE technology/devices/apparatus as patented by Plaintiff. In the suit an interim injunction order dated 8th December 2014 was issued by the Delhi High Court against Defendants. In response, Defendants had filed a request for vacation of the injunction order on the grounds of concealment and suppression of material facts by Plaintiff.

Contentions:

Defendants claimed that Plaintiff had concealed the existence of a multi-party license relating to its CDMA patents with Qualcomm Ltd., by which Qualcomm is granted the right to manufacture and sell chipsets and devices incorporating such chipsets. Defendants contended that use and implementation of the chipsets from Qualcomm amount to authorised use of Plaintiff's patents. Plaintiff on the other hand contended that Defendants were involved in manufacture and sale of devices that use, 2G/EDGE and 3G technologies for which no license was granted to them by Plaintiff and thus, Defendants were infringing Plaintiff's patents.

Decisions:

After hearing the rival arguments and examining the evidence, Delhi High Court observed that the agreement in question would have been conclusive, yet none of the parties had placed the agreement on record. High Court stated that party seeking an ex-parte order, has a heightened duty to disclose all evidence which is relevant for the purpose of the ex-parte injunction sought by it. Plaintiff having failed to do so, Delhi High Court accepted Defendants' claims of concealment and vacated the ex-parte interim injunction order granted earlier to Plaintiff. ■

Telefonaktiebolaget LM Ericsson vs Lava International Ltd.

Delhi High Court, Single Bench, 10th June 2016

Injunction Granted

Facts:

Plaintiff Ericsson had filed a suit for infringement of its patents relating to AMR, 3G and EDGE technologies. In the suit, Plaintiff filed an application for interim injunction to prevent Defendant from manufacture and sale of mobile and other telecommunication devices using the said patents. Defendant also filed an injunction application against Plaintiff for stay of operation of suit patent and to restrain Plaintiff from claiming any right to the suit patent.

Contentions:

Plaintiff contended that Defendant's devices use AMR technology in 3G and 2G and possess EDGE capabilities and thus, it was alleged that all these devices utilise and therefore, infringe its SEPs (Standard Essential Patents). Plaintiff also stated that it is obligated to offer a license to the patents on FRAND terms and has sought to negotiate with Defendant who has refused to take the licence on FRAND terms. Defendant challenged the validity as well as the essential nature of the suit patents and argued that the suit patents are not essential standard patents.

Held:

After hearing the contentions of both parties, Single Judge allowed Plaintiff's application for interim injunction. High Court observed that once it has arrived at the decision that Defendant is guilty of infringement, the patents are valid and no credible defence has been shown by Defendant, there is no question of allowing the relief claimed by Defendant. High Court also directed that from 21st June 2016 onwards, the Customs Authorities will not release Defendant's mobile phones utilising the technology covered by the suit patents, to either Defendant or any person on its behalf, if they are received from overseas countries. However, High Court stated that the interim injunction order shall remain stayed till final disposal of the suit if Defendant submits Rs.500,000,000* as security amount by 20th June 2016 and continues to file its statement of accounts during the pendency of the suit. ■

[*Rs./ INR 65 = USD 1 approx]

Bristol-Myers Squibb Holdings Ireland & Anr. vs Sanjay Jain & Anr.

Delhi High Court, Single Bench, 17th October 2016

Injunction Granted

Facts:

Plaintiffs are proprietors of Indian Patent No.203937 in respect of invention of a drug, containing the active pharmaceutical ingredient 'DASATINIB'. Plaintiffs were manufacturing and selling this drug, which was invented by them, for the treatment of cancer. As per the Plaintiffs, Defendants were about to launch their own product under the brand name 'DASACY' containing 'DASATINIB', in complete disregard to Plaintiffs' patent and had already obtained manufacturing licence from the relevant Government authorities. Aggrieved by the Defendants' acts, the Plaintiffs filed the present suit for infringement of its patent against the Defendants.

Held:

At the initial stage of the suit, the Delhi High Court allowed the Plaintiffs' request and issued an ex-parte interim injunction order against the Defendants. The application for interim relief remained unchallenged and therefore the High Court confirmed the ex-parte injunction order till the disposal of the suit. The main suit proceeding is currently pending before the Delhi High Court. ■

Bristol-Myers Squibb Co. & Anr. vs Dharmesh M. Shah & Anr.

**Bristol-Myers Squibb Co. & Anr.
vs J. D. Joshi & Anr.**

Delhi High Court, Single Bench, 13th January 2017

Injunction Granted

Facts:

Plaintiff No.1 is in the business of manufacturing an Active Pharmaceutical Ingredient DASATINIB which is a drug invented by the Plaintiffs. Plaintiff No.1 has obtained a patent for the said drug under patent no. 203937 dated 12.04.2000.

Plaintiffs filed two suits for permanent injunction restraining infringement of Indian Patent No.203937 and for damages against the Defendants.

Plaintiffs had learned that Defendant – M. J.

Chempharm Private Limited (now known as BDR Lifesciences Pvt. Ltd.) was in the process of seeking marketing approval from the DCGI in respect of its drug DASATINIB API. Aggrieved, Plaintiffs had filed the first suit for infringement of its patent in November 2009 against Mr. J.D. Joshi, Director of Defendant No.2 and BDR Lifesciences Pvt. Ltd.

During the pendency of the first suit, Plaintiffs realised that BDR or BDR Lifesciences intended to circumvent the ad-interim injunction granted in the first suit and the Defendants may introduce the drug by infringing the suit patent. Accordingly, Plaintiffs filed the second suit in April 2013 on the basis of fresh cause of action.

BDR Pharmaceuticals Pvt. Ltd. (hereinafter referred to as the BDR or BDR Pharma) a group company of BDR Lifesciences approached the Plaintiffs requesting for a voluntary license for IN 203937 to manufacture and market Dasatinib. Plaintiffs responded asking for certain details to evaluate its decision to grant the voluntary license. However, no such response was received for over 14 months.

During this period, and without informing the Plaintiffs or the Delhi High Court, Defendants applied and obtained a manufacturing license for Dasatinib Tablets from the Food and Drug Control Administration, Maharashtra. Defendants also obtained a manufacturing license for Dasatinib BULK from Food and Drug Control Administration, Gujarat. Defendants also applied for a Compulsory License before the Controller General in respect of the patented drug.

In the same period BDR also started advertising and offering Dasatinib Tablets for sale under the head "Finished formulations" on its website.

Contentions:

At the initial stage of the first suit, Plaintiffs were granted an ex-parte interim injunction against the Defendants.

With regard to the Defendants' application for Compulsory License, the Controller General held that Defendants/Applicants were unable to establish a prima facie case for grant of the Compulsory License and accordingly, rejected the application.

Plaintiffs claimed that Defendants' actions amounted to infringement of its patent and Defendants' request for voluntary license was just to conceal the real intention of the Defendants to

infringe the patent. Defendants on the other hand challenged the validity of Plaintiffs' patent via counter-claim.

Held:

The Delhi High Court observed that, prima-facie, Defendants could not establish any credible challenge to the Plaintiffs' patent, but have rather admitted infringement in their pleadings. High Court also noted that the main intent of the Defendants were to manufacture and sell the product in question. Accordingly, the High Court held that the interim order issued earlier shall continue to operate till such time the suits were disposed of.

Subsequently, during the suit proceedings, the parties entered into a settlement by virtue of which the Defendants acknowledged the Plaintiffs' rights to the suit patents and agreed not to violate the patent during its validity period. Defendants also withdrew their counter-claims. On the other hand, Plaintiffs withdrew their prayers for damages and costs. As per the terms of the settlement, the High Court disposed off the suits by issuing permanent injunctions in favour of the Plaintiffs and against the Defendants. ■

Sugen Inc. & Ors. vs K. V. Prakash & Ors.

Delhi High Court, Single Bench, 16th August 2016

Injunction Granted With Costs

Facts:

Plaintiff is a drug discovery company focused on research and development of small molecule inhibitors of protein kinases, key enzymes in signal transduction and cellular decision making and had, in fact, been successful in developing various protein kinase inhibitors. Plaintiff has innovated and developed a molecule known as 'SUNITINIB' for adults with Gastrointestinal Stromal Tumor and Renal Cell Carcinoma. Plaintiffs are selling the pharmaceutical preparations under the brand name 'SUTENT' which contains SUNITINIB. Defendant No.1 is the Director of Defendant Nos. 2 and 3 who were involved in manufacture and sale of pharmaceutical products, while Defendant No. 4 was conducting advertising activities for Defendant

No. 2. Plaintiffs found out that Defendants were intending to launch a generic version of 'SUNITINIB' in complete disregard of the Plaintiffs' Patent No.209251. Accordingly, Plaintiff filed the present suit for patent infringement and sought to restrain the Defendants.

Contentions:

At the initial stage of the suit, an ex-parte interim injunction was granted to the Plaintiffs against the Defendants. Thereafter, Plaintiffs filed a contempt petition alleging that the impugned products continued to be available in the market in violation of the interim injunction order. Defendant Nos. 1, 2 and 3 appeared before the High Court and requested for time for filing their response to the complaint of the Plaintiff. Defendant Nos. 1 and 3 submitted that they wish to adopt the written statement and counter claim filed by Defendant No.2. Despite being given ample time, Defendant No.2 could not meet the deadline to file its written statement, and the same was filed after the expiry of the due date. Even then, the High Court condoned the delay, and directed the Defendant No.2 to pay a fine of Rs.30,000* to the Plaintiffs. However, Defendant No.2 failed to pay such fine and, at a later date appeared before the High Court and urged the High Court to be allowed an opportunity to pay such fine belatedly.

Held:

High Court refused to allow Defendant No. 2 to pay such fine beyond the due date, and also refused to take on record the written statement filed by Defendant No.2. Consequently, there was no reply from Defendant Nos. 1, 2 and 3 in response to the complaint filed by the Plaintiffs. Accordingly, the High Court issued a decree of permanent injunction against Defendant Nos. 1, 2 and 3. As far as Defendant No. 4 is concerned, it submitted that it was neither making nor using the patented product of the Plaintiffs and subsequent to the receipt of the summons of the suit, it has even stopped this information from appearing on its web page. Also, the Plaintiffs' grievance of contempt was not applicable against Defendant No.4. Accordingly, the suit was also decreed against Defendant No.4 as per its submissions.

With regard to the contempt petition, the High

[*Rs./ INR 65 = USD 1 approx]

Court noted that no reply had been filed by the Defendant Nos. 1, 2 and 3. Defendants requested the High Court to be given another opportunity to file their reply, however, the High Court refused to give any further indulgence to the Defendants. Accordingly, the Delhi High Court directed the Defendants to pay costs to the tune of Rs.100,000* each. ■

**Sugen Inc. & Ors.
vs K. Vijaya Prakash & Ors.**

Delhi High Court, Single Bench, 12th September 2017

Injunction Granted

Facts:

Sugen is a drug discovery company focused on research and development of small molecule inhibitors of protein kinases, key enzymes in signal transduction and cellular decision making, and has developed various protein kinase inhibitors. Plaintiff is the Patentee of the Indian Patent No. 250050 in respect of CRIZOTINIB. Plaintiff came to know that Defendants were manufacturing the impugned generic product in India and exporting, selling and/or offering for sale the same in Bangladesh and/or, at the very least, surreptitiously and clandestinely importing and diverting for sale into the Indian markets the impugned product, that is, 'CRIZO SPL', having the same molecule as that of CRIZOTINIB involved in Indian Patent No. 250050. Plaintiff filed the present suit seeking to restrain the Defendants from infringing the CRIZOTINIB patent.

Contentions:

At the initial stage, the Delhi High Court granted an ex-parte interim injunction order in favour of Plaintiffs and against the Defendants. Subsequently, Defendant Nos. 1 to 4 and 6 & 7 appeared before the Delhi High Court and submitted that they have never engaged in any infringing activity related to the suit patent in any manner and have no relation or concern with the component CRIZOTINIB covered by the suit patent. The said Defendants also submitted that they were not manufacturing or selling the products CRIZO SPL and CRIZO SPAL which were using the patented component CRIZOTINIB. On the basis of such undertaking, the Plaintiff agreed to not press its request for an award for damages against the said Defendants.

Held:

On the basis of the undertaking provided by the Defendants No.1 to 4 and 6 & 7, the suit was decreed in favour of Plaintiff and against the said Defendants. Defendant No. 5 had not appeared before the High Court despite notice, hence the High Court had passed an order allowing the proceeding to continue ex-parte so far as Defendant No. 5 was concerned. ■

**Merck Sharp & Dohme Corp.
vs Munish Thakur & Ors.**

Delhi High Court, Single Bench, 27th October 2017

Injunction Granted

Facts:

Plaintiff is the owner of Indian Patent no.209816 with respect to a molecule having International Non-Proprietary Name (INN), SITAGLIPTIN. Plaintiff learned that Defendants have not yet launched their drug containing the molecule Sitagliptin on a large scale and the drug Glipsit-MI is only available at Palampur Zonal Hospital and at no other chemist. Plaintiff filed the present suit in order to prevent the Defendants from launching their infringing product and causing any further damage to its patent.

Contentions:

The High Court had issued an interim injunction in favour of the Plaintiff and against the Defendants. Despite being notified, Defendants did not appear before the High Court, and the matter proceeded ex-parte.

Held:

The High Court was of the opinion that since the Defendants had not appeared before the court, the submissions in the complaint filed by the Plaintiff remained un rebutted. Hence, as per the High Court, the Plaintiff was entitled to a decree of permanent injunction against the Defendants. ■

Merck Sharp & Dohme Corp. vs Aprica Pharmaceuticals

Delhi High Court, Single Bench, 14th November 2017

Injunction Granted

Facts:

Plaintiff is one of the world's leading pharmaceutical companies and is dedicated to discovering, developing and providing innovative pharmaceutical products. The Defendant is engaged in the business of marketing, selling and/or offering for sale various pharmaceutical products. had filed the present suit for permanent injunction for restraining the Defendants from infringing its registered patent in respect of SITAGLIPTIN and its derivative salt. In the suit, Plaintiff claimed that the defendant was intending to launch a medicine with the identical salt which would be an infringement of the patent of the Plaintiff. At the initial stage of the suit, the High Court issued an ex-parte interim injunction in favour of the Plaintiff and against the Defendant.

Contentions:

In the suit, the Defendant initially appeared before the High Court, but thereafter stopped appearing and also did not file any written statement in response to the complaint filed by the Plaintiff. Accordingly, High Court allowed the proceedings to continue ex-parte against the Defendant.

Held:

The High Court held that since the Defendant did not appear, the contents of the complaint filed by the Plaintiff remained uncontroverted. Thus, the High Court was of the opinion that the Plaintiff was entitled to a decree of permanent injunction against the Defendant and issued appropriate judgement in this regard ■

E.I. du Pont de Nemours and Co. vs Sahib Seeds Ltd. & Anr.

Delhi High Court, Single Bench, 9th September 2016

Injunction Granted

Facts:

Plaintiff is manufacturing and selling insecticides namely CHLORANTRANILIPROLE (CTPR).

The Plaintiff is the patent holder of this insecticide and is also responsible for its use since it is of toxic nature and manufacture or sale of such insecticide is not permitted without appropriate license or authorization. Plaintiff came to know that the Defendants were manufacturing and selling insecticide products namely KALIA, KALIA - 185 as a by-product containing CTPR which is forbidden by law.

Contentions:

At the initial stage of the suit, Plaintiffs were granted an ex-parte interim injunction by the High Court. Upon being notified of the suit, Defendants appeared before the High Court and undertook to file their written statement in reply to the complaint filed by Plaintiff. However, Defendants did not file a written statement, and instead, informed the High Court that the parties were exploring the possibility of a settlement. Subsequently, it was noticed that settlement was not possible and the suit ought to proceed on merits. Accordingly, the High Court made the initial interim injunction order passed earlier, absolute.

On the final date of hearing, Plaintiff contended that the Defendants have sought numerous hearings on some pretext or the other. Plaintiff also submitted that the Defendants had suffered the interim injunction and had not taken any steps to set aside such order. On such basis, Plaintiff urged the High Court to issue a decree in terms of the interim injunction order. The High Court accepted the Plaintiff's prayer, and decreed the suit by issuing a permanent injunction order against the Defendants ■

TenXC Wireless Inc. & Anr. vs Andrew Comm Scope Inc.

Delhi High Court, Single Bench, 10th November 2017

Injunction Vacated

Facts:

Plaintiff has patented an invention called "Asymmetrical Beams for Spectrum Efficiency" which is used by mobile service providers to not only increase the frequency of spectrum for wireless communication but also to make use of the said spectrum, optimal. In the month of August

2010 Plaintiff learnt that this patent was being infringed by Defendant by providing the services of the infringed patent, i.e., "Asymmetrical Beams for Spectrum Efficiency" technology to some prospective customers in India. Plaintiff also learned that Defendant No.1 was in the process of selling the offending product to Reliance Communications and Tata Teleservices. Aggrieved, Plaintiff filed the present suit for patent infringement, against Andrew CommScope, Reliance Communications and Tata Teleservices.

Contentions:

At the initial stage of the suit, the High Court directed Reliance Communications and Tata Teleservices to maintain status quo, with regard to the installation of the Bi-Sector array antennae, purported to be supplied by the Defendant No. 1. Upon finding out about the ex-parte injunction order, Defendant No.1 appeared before the High Court and requested the High Court to set aside the interim injunction order because it is causing irreparable loss and damage to Defendant No.1, and also because the ex-parte injunction was obtained by the Plaintiff on the basis of false suppression of material facts, fabricated documents and by misleading the Court.

The High Court was of the opinion that the Plaintiff had given filtered and selective information as a consequence of which, although the interim order is not passed against the Defendant No. 1, it has hurt the interest of the said Defendant. Accordingly, the High Court set aside the ex-parte injunction order. Aggrieved by the order, Plaintiff filed an appeal against the said order before the Division Bench. The Appellate Court was of the opinion that the Defendant's application for vacation of the ex-parte injunction order contained some serious allegations and it was essential to obtain a response from the Plaintiff in respect to such allegations. Accordingly, the Division Bench set aside the order vacating the interim injunction.

The main suit proceedings are currently pending before the Delhi High Court at the stage of recordal of evidence. Parties are also reportedly exploring the possibility of settlement. ■

Bayer Intellectual Property GmbH vs Ajanta Pharma Ltd. & Ors.

Delhi High Court, Single Bench, 11th January 2018

Injunction Granted

Facts:

The present suit was filed by Bayer alleging infringement of its patent VARDENAFIL by the Defendants by selling their product VALIF that contains the patented component. At the initial stage, an ex-parte interim injunction was issued in favour of the Plaintiff which restrained Defendants from dealing in the patented component in any manner, including exporting the offending products.

Contentions:

Defendants approached the High Court for setting aside the ex-parte interim injunction by claiming that (a) Plaintiff had not used the patent in India (b) the Defendants were not operating within the territorial jurisdiction of the High Court and (c) that the impugned products had been launched by the Defendants way back in 2009, and that Plaintiff was well aware of Defendants' manufacturing activities through its Indian facilities, and also about such products being used internationally for a long time without any interruption or objection. Plaintiff conceded that it had not yet used its patent in India but argued that rights of a patentee included the exclusive right to prevent others from infringing its patent.

Held:

High Court noted that the objections raised by Defendants against the interim injunction order on the basis of the absence of territorial jurisdiction, or misrepresentation by Plaintiff, or delay and acquiescence, could not be determined at the initial stage before the completion of pleadings. However, the High Court noted that the issue of non-use of the patent or the balance of convenience on account of Defendants having exported the impugned products for a long time, deserved to be considered. Accordingly, the High Court modified the interim injunction order in a manner so that Defendants continued to be restrained from dealing in the offending products in India but were allowed

to manufacture and export the said products. The High Court further directed the Defendants to maintain proper account of their export/import sales and also to submit a certain percentage of profits as royalty to protect the Plaintiff's interest in the present suit.

Subsequently, Defendant Nos. 2 and 3 appeared before the High Court and submitted an undertaking whereby they declared that they are not manufacturing or selling or exporting the offending products, and shall continue to not do so during the validity of the patents in suit. Based on such undertaking, the Plaintiff agreed to give up its claim of damages against Defendant Nos. 2 and 3. Consequently, the suit was decreed in favour of Plaintiff and against the Defendant Nos. 2 and 3 in terms of such undertaking.

The suit is currently continuing as far as Defendant No.1 is concerned. Defendant No.1 has also filed a counter claim against the Plaintiff.

**Dolby International AB & Anr.
vs Universal Digital Connect Ltd. & Ors.
Delhi High Court, Single Bench, 18th January 2018**

Injunction Granted

Facts:

The Plaintiffs have instituted five suits against different Defendants for permanent injunction restraining infringement of Plaintiff's four patents and for ancillary reliefs. In the suits Plaintiffs alleged that Defendants' products, being /IEC 14496-3:2009(E) compliant, necessarily use HE-AAC v1 technology also known as aacPlus v1, eAAC, AAC+ or CT-aacPlus and High Efficiency Advanced Audio Coding v2 (HEAAC v2) technology, also known as aacPlus v2, eAAC+, AAC++ or Enhanced AAC+, in which the Plaintiffs claim patent.

At the initial stages of the suits, the High Court issued interim injunctions restraining Defendants from violating the suit patents. Upon receiving notice of the suits, the Defendants (Oppo Mobiles India and Vivo Mobiles) in two suits, No.1425/2016 and No.1426/2016, appeared before the High Court and agreed to pay royalty as demanded by the Plaintiffs without prejudice to their rights and contentions, to enable them to continue to manufacture and sell the products with the

technology in which the Plaintiffs have claimed patent. The High Court allowed such request and also directed the said Defendants to furnish accounts of sale and import of the offending products to the Plaintiffs on a monthly basis.

In the suit against Universal Digital Connect (Suit no.1429/2016) the Defendants applied for vacation of the interim injunction granted by the High Court by claiming that the technology used in Defendants' products was different from the technology patented by the Plaintiffs. However, the High Court refused to allow Defendants' plea stating that in the absence of a definite stand as to which technology is being used in Defendants' products, i.e. whether it is the technology for which the Plaintiffs claim patent or some other technology, the interim order cannot be vacated this day and Plaintiffs have to be granted an opportunity to respond to Defendants' allegations. As an interim measure, the High Court decided to apply the FRAND rates as fixed in the other suits i.e., Suit No.1425/2016 and Suit No. 1426/2016

In the suit between Plaintiffs and the Defendant Oppo Mobiles (Suit No.1425/2016), the parties reached a settlement, and the suit was decreed as per the terms of such settlement. Similarly, Mitashi Edutainment (Defendant in suit no.1427/2016) and Shreeji Tradelinks (Defendant in Suit No.1428/2016) had amicably settled the dispute and the suits were decreed in terms of the respective settlement agreement.

As of now, the suits against Defendants Das Telecom (Suit No.1426/2016) and Universal Digital (Suit No.1429/2016) are pending.

**DSM Sinochem Pharmaceuticals
Netherlands BV & Anr.
vs Sinopharm Weiqida Pharmaceutical Co.
Ltd. & Anr.**

Delhi High Court, Single Bench, 1st December 2017

Injunction Granted

Facts:

Plaintiff No.1 is the patentee of a technology under Patent No.247301. Plaintiff learned that Defendants – a Chinese entity and its Indian distributor, were manufacturing pharmaceutical products containing 'Amoxicillin Trihydrate' using the patented process and exporting such products into India. Aggrieved,

Plaintiffs filed the present suit for infringement of the process patent.

Contentions:

In response to Plaintiff's allegations, the Defendant No.1 submitted that though the Defendant No.1 is not exporting to India any product in violation of the process patent of the Plaintiff's but is exporting an intermediary product to some Indian entities. On the other hand, Defendant No.2 claimed that it had neither imported any medicine, more specifically Amoxicillin Trihydrate, from the Defendant No.1 nor had it sold it to any third party. Defendant No.2 submitted that it had objection to suffer a decree for permanent injunction and accordingly, the suit was decreed against the Defendant No.2, Sinopharm India Pvt. Ltd.

Considering Defendant No.1's failure to file its written statement within the stipulated time, the High Court directed Defendant No.1 to pay costs of Rs. 50,000 and also issued an interim injunction order against Defendant No.1, Sinopharm Weiqida Pharmaceutical Co. Ltd. (WQD), a Chinese entity, from exporting to India or otherwise selling in India any pharmaceutical product, the active ingredient whereof contains 'Amoxicillin Trihydrate' by a process in infringement of Patent No.247301 of the Plaintiff No.1.

Despite several opportunities, Defendant No.1 had neither filed its written statement, nor paid the costs as per the High Court's directions. Consequently, the High Court granted the Plaintiff's prayers and decreed the suit in favour of the Plaintiff and against the Defendant No.1.

Aggrieved by the Single Judge's order, the Defendant No.1 had filed an appeal. On appeal, Defendant contended that the time period of 120 days had not expired. Accordingly, the Division Bench allowed Defendant's prayer and directed that the final decree passed by the Single Judge would be treated as an interim order. On further consideration, the Division Bench allowed the Defendant's appeal, and granted them more time to file their written statement. The appeal court also directed that the interim order granted by the Single Judge would revive and operate till the next date of hearing.

The aforementioned suit is currently pending before the Delhi High Court. ■

Dr. G. Srinivasan

vs Voltamp Transformers Ltd. & Ors.

Madras High Court, Single Bench, 14th February 2017

Injunction Not Granted

Facts:

Plaintiff is an engineer who had innovated a novel concept of power distribution, wherein the need for huge and costly transformers has been eliminated by the invention called "midget transformer", which is smaller in size, easier to install and maintain and also reduces power wastage. Plaintiff's invention also employs "star node circuit breakers" (SNCB), which substitute the costly and conventional switchgear in control applications. With regard to such invention, Plaintiff had also obtained a patent under no.198725.

As per the Plaintiff, while he was visiting a site of P.V. Technologies India Limited at Sivaganga, Tamil Nadu, he found that his patented "midget transformers" were being used by Defendant No.1. Aggrieved, Plaintiff filed the present suit against the Defendants for infringement of his patent.

Contentions:

Defendants claimed that the suit was not maintainable and that there was no infringement of patent, since the transformers manufactured and used by Defendants were completely different from the Plaintiff's patented product. Defendants further alleged that Plaintiff had restored his patent only during January 2012 and has not filed any documents to show that the patent has been worked and commercially exploited. In addition, Defendants also filed a counter-claim alleging that Plaintiff's claims as covered by the specifications were not an invention under the Patents Act, 1970.

Held:

The High Court noted that the Plaintiff had not provided the complete specifications and held that Plaintiff has failed to establish infringement of his patent by Defendants. With regard to the Defendants' objections to the Plaintiff's patent, the High Court agreed that the Plaintiff had failed to provide complete specifications and method of use, that the specifications submitted do not unveil any "invention" as per the Act and that the patent has

not been worked or commercially exploited yet. The High Court further observed that despite having knowledge of Defendants' use of the impugned products in 2011, the Plaintiff filed the present suit only in 2012. Accordingly, the High Court revoked the Plaintiff's patent, and allowed the counter-claim of the Defendants. Consequently, the High Court dismissed the Plaintiff's suit, and allowed the Defendant's prayers in this regard as well. ■

**A. R. Safiullah
vs A. Sowkath Ali**

Madras High Court, Single Bench, 12th January 2017

Injunction Granted

Facts:

The present suit had been filed by the Plaintiff seeking a decree of injunction against infringement and passing off of a registered patent under No.198079 in respect of "food grade laminated paper method and the apparatus for manufacturing the laminated paper" and registered design under No.182931, by manufacture and sale of artificial laminated banana leaf identical or similar to the shape and configuration of Plaintiff's artificial laminated banana leaf registered under the Designs Act.

Contentions:

Plaintiff claimed that he had invented and introduced in India and in the world for the first time after conceiving the idea that an artificial laminated banana leaf can be used as an alternative to the traditional banana leaf obtained from plantain trees and had obtained a patent in respect of the same. In addition, Plaintiff also had a design registration for his artificial laminated banana leaf in various shapes and configurations. On the other hand, Defendant contended that the patent granted to the Plaintiff had been revoked by the Controller. Plaintiff had contended that the order revoking the patent had been stayed by the IPAB (Intellectual Property Appellate Board). The High Court stated however, that the stay order on revocation of patent will not have the effect of reviving the patent at issue. But, on the issue of infringement of design, the High Court was of the opinion that the Defendant had infringed Plaintiff's design. Accordingly, an interim injunction was granted to the Plaintiff by the High Court.

After issuance of the interim injunction, the Defendant no longer appeared before the High Court, nor did it file any written statement in response to the complaint filed by the Plaintiff. Accordingly, the High Court proceeded ex-parte with the matter against the Defendants.

Held:

Considering the matter was ex-parte, the High Court did not issue any order on the prayers of damages as requested by the Plaintiff. However, the High Court issued a decree of permanent injunction against the Defendant, in favour of the Plaintiff. ■

**Shomenath Roy Chowdhury & Anr.
vs Eskag Pharma Pvt. Ltd. & Ors.**

Calcutta High Court, Single Bench, 20th May 2016

Injunction Not Granted

Facts:

Plaintiff is the owner of the patent and proprietor of a therapeutic composition of topical applications to facilitate healing of wounds and the process for preparing the same using sucralfate, tinidazole and povidone iodine, and marketing the finished product under the trademark "Dresin". Defendant is manufacturing and selling its product under the name "Sufrate TP".

Contentions:

Plaintiff alleged that Defendants' product composition is identical to its patent and an infringement thereof. Defendants argued that there cannot be a patent for the ingredients used for making the product which are well-known in the medicinal field and, therefore, Plaintiff cannot prevent Defendants from marketing and/or selling their product.

Held:

Calcutta High Court held that this case did not warrant an interim injunction at the preliminary stage. Instead, High Court appointed a Special Officer to take inventory of Defendants' stock of allegedly infringing products. High Court also made it clear that Defendants are not prevented from selling their products as long as they keep the Special Officer informed of the manufactured amount of products. ■

Holland Company LP & Anr. vs S.P. Industries

Delhi High Court, Single Bench, 27th July 2017

Injunction Not Granted

Facts:

Plaintiffs are the owners of industrial drawings of Automatic Twist Lock (hereinafter referred to as "ATL") system for securing cargo containers for support such as the deck of a vehicle or a second cargo with which the first container is to be stacked. Plaintiffs claimed to have invented the product and possess intellectual property rights, patent and copyright. Plaintiffs had supplied their product to the Indian Railways and it used it on its container flat wagons. Plaintiffs claim that the drawings of ATL device along with its component, are the original Artistic Work and Plaintiffs are the owners of copyright of these industrial drawings.

Contentions:

As per the Plaintiffs, the Eastern Railway, Sealdah Division, had issued a tender for carrying out the repairs, replacement of spare parts and service, including overhauling and replacement of defective part of ATL devices, and Plaintiff No.2 was also one of the bidders. However, the successful bidder was the Defendant and the contract was awarded to the Defendant. According to the Plaintiffs, the drawings of the spare parts of ATL were readily available as they were public documents and were published by Indian Railways with due permission from Plaintiff No.2. The publication contained said detailed drawings of Plaintiff's design and this document could be procured easily by making a payment of Rs.2300*. Plaintiffs claimed that the Defendant, being in the same trade, was aware of such publication and had copied the Plaintiff's drawings from this document and also procured the Plaintiffs' product and spare parts and had prepared the drawings for manufacturing the ATL devices and its spare parts by using reverse engineering and/or by copying and using the said drawings in an unauthorized manner. Thus aggrieved, the Plaintiffs filed a suit for infringement of design and copyright, and prayed for a decree of injunction against the Defendant.

As per the Defendant, the Plaintiffs have no

copyright in the industrial drawings. Defendant argued that no copyright can exist in any drawing or design once the production has been done more than 50 times by an industrial process using such drawings or designs. Defendant further argued that under the contract awarded to it by the Indian Railways, it was bound to fulfil its obligation on the basis of specification and drawings mandated in terms of the contract. The Defendant also contended that it had never claimed to be a manufacturer and supplier of the Plaintiffs' spare parts. Defendant denied that it had misappropriated the Plaintiffs' know-how or information, or their drawings or designs.

Held:

The High Court noted that Plaintiffs had prepared the engineering drawings for the purpose of production of ATL devices. High Court further noted that the industrial drawings were supplied to the Railways by Plaintiffs under a contract. Accordingly, High Court concluded that although the Plaintiffs' drawings of the ATL devices were registrable under the Designs Act, they had not been registered under the Designs Act. High Court also observed that Plaintiffs had not disputed the fact that these engineering drawings had been used for more than 50 ATL devices through an industrial process and, therefore, even assuming that Plaintiffs had a copyright in such engineering drawings, such copyright ceases to exist by virtue of the provisions of the Design Act. High Court also noted that Plaintiffs have not made the Railways a party to the suit although in the facts and circumstances of the case it is a necessary party, because prima facie is the Railways who have used the engineering drawings of the ATL devices for inviting tenders. High Court held that Plaintiff failed to show any prima facie in their favour and accordingly dismissed the Plaintiff's request for interim injunction. ■

SAP SE

vs Newyorksys Info Solutions Pvt. Ltd. & Ors.
Delhi High Court, Single Bench, 26th September 2017

Injunction Not Granted

Facts:

Plaintiff is a German company and the owner of the copyright in the software programmes and products

which are developed and marketed by it including SAP ERP 2005, SAP-HANA, SAP security and SAP GR, all of which are software programmes and constitute 'literary work' protected under Copyright Act. Plaintiff also has a wholly owned Indian subsidiary which is responsible for the sales of SAP solutions, implementation, post-implementation support, training and certification of its customers and partners in India. It came to Plaintiff's knowledge that Defendant No. 1 is claiming to be a leading SAP Training Institute, offering online SAP training in Hyderabad, falsely representing to be based in New York and is operating through websites www.newyorksystraining.com www.newyorksys.com, and several other websites.

According to Plaintiff, Defendant No. 1 also operated a number of alternate websites that use the mark SAP as part of its domain name. Plaintiff also claimed that Defendants have cleverly hidden their identity by not disclosing the domain registrant's name and veiled themselves through proxy registration services. Aggrieved, Plaintiff filed the present suit for permanent injunction restraining infringement of copyright, trademark, passing off, rendition of accounts of profit, damages and delivery up etc.

Contentions:

Plaintiff claimed that Defendants' activities are illegal since the Plaintiff has not authorised the Defendants to use the aforesaid software or access other material to provide training or use their trademark SAP and/or their logo. Also, no licence had been granted in favour of the Defendants to use any of the SAP's copyright protected software for providing training. Plaintiff argued that Defendants have infringed upon the exclusive rights of the Plaintiff by providing unauthorised training on their copyright-protected software such as SAP FICO, SAP-HANA, SAP-SECURITY, SAP GRC, SAP MM, etc. At the initial stage of the suit, Plaintiff was granted an ex-parte interim injunction by the High Court. Subsequently, Defendants did not appear before the High Court despite being notified, and hence, the proceedings continued ex-parte.

Held:

The High Court analyzed the contentions made in

the complaint and also examined the evidence placed on record by the Plaintiff. High Court was of the opinion that since the evidence filed by Plaintiff was un-rebutted, such evidence was acceptable as true and correct. Consequently, the High Court accepted Plaintiff's submissions that the trademark, logo, label and software to SAP used by Defendants on their website amounts to infringement of Plaintiff's copyright. High Court also agreed that the use of illegal trade activities by the Defendants is bound to cause incalculable losses, harm and injury to the Plaintiff as well as immense public harm. Accordingly, the High Court issued a decree as prayed for by the Plaintiff and disposed off the suit. ■

J C Bamford Excavators Ltd. & Ors. vs Bull Machines Pvt. Ltd.

Delhi High Court, Single Bench, 22nd December 2017

Facts:

Plaintiff No.1 J C Bamford is a UK based company, engaged in the manufacture of earth moving and construction equipment. JBEL claims to be the world's largest manufacturer of "Backhoe Loader" since 1945. Plaintiff No. 2 is a wholly owned subsidiary of JBEL and is engaged in manufacturing of earth moving and construction equipment in India. Plaintiffs filed the present suit alleging infringement of copyright and registered designs in respect of parts used in manufacture of 3DX Backhoe Loader, which is a versatile multi purpose earth moving machine and can be used both as an excavator and a loader. Plaintiffs claimed that designs relating to (i) Boom; (ii) Dipper; (iii) Bucket; and (iv) Stabilizer Leg were being infringed by Defendants. The designs of the said parts of the 3DX Backhoe Loader were registered under the design registration Nos. 200016, 200017, 200018 and 200019. In addition, Plaintiffs also alleged infringement of their copyright in respect of drawings of various components of the product and claimed that certain parts manufactured and used in the backhoe loader manufactured by Defendants were substantial reproductions of the drawings of the components of the Product.

Contentions:

In the initial stage Plaintiffs secured an ex-parte ad interim injunction. Defendants had filed an

application for setting aside the ex-parte interim injunction order. Thereafter, there were certain negotiations between the parties and the ad interim order granted in favour of Plaintiffs was suspended. While the settlement negotiations continued, Plaintiffs withdrew their application for interim injunction, and therefore Defendants were no longer enjoined from manufacturing and selling the disputed product. Meanwhile, Plaintiffs also filed a request for amendment of the complaint, which was uncontested by Defendants, and as a result, granted by the High Court.

Subsequently, Defendants filed a request for dismissal of the suit based on admissions made by the Plaintiffs in respect of the allegations and claims made by them in respect of infringement. The main challenges raised by the Defendants were (a) whether the copyright in respect of the designs of the parts of the Product have ceased, (b) whether the Plaintiffs are precluded from claiming infringement of their copyright in the technical drawings relating to the parts of the Product in question, and (c) whether the suit is liable to be dismissed on the basis of admissions as contained in the prior suits instituted by the Plaintiffs, and/or the suit instituted by the joint venture company and admissions contained in the technical report.

Held:

The High Court held that merely because the parts of the Product have been produced by an industrial process more than fifty times would not necessarily lead to the conclusion that the copyright in the technical drawings of the said parts has ceased. In order to arrive at this conclusion, the High Court noted that 'copyright' under the Designs Act has a different connotation from a copyright under the Copyright Act.

On the issue as to whether the part manufactured by Defendants were purely functional in nature and thus excluded from copyright protection, the High Court held that this was a question of fact and needed to be addressed after a full trial and the suit cannot be dismissed on this ground. The High Court refused to accept the Defendants' argument of admissions and held that the pleadings relied upon by Defendants were made in another suit, and Plaintiffs ought to have an opportunity to explain them at the trial stage. The High Court further observed that the power of the Court to issue a

decree based on admission is discretionary, and the applicable provisions are not mandatory. Based on the above, the High Court dismissed the Defendants' application for decreeing the suit in its favour. ■

Crocs Inc. USA vs Liberty Shoes Limited Delhi High Court, Single Bench, 8th February 2018

Injunction Not Granted

Facts:

Plaintiff has filed a number of suits for permanent injunction seeking to restrain the Defendants from infringing the registered design no. 197685 with respect to footwear. The suits have been filed on the basis of Plaintiff's allegation that the Defendants are imitating the Plaintiff's footwear design, therefore the Defendants are guilty of piracy of the Plaintiff's registered designs and hence the Plaintiff has approached the Delhi High Court for relief.

Contentions:

Defendants, in the suits, have contested the claim of the Plaintiff seeking grant of interim/pendente lite injunction. Defendants have denied that it is infringing the Plaintiff's registered designs. Defendants have argued that there cannot be piracy of a registered design if the registration granted to the Plaintiff with respect to footwear itself is invalid.

Held:

The High Court found that the designs for which the Plaintiff claims proprietary rights are neither innovative nor new or original as per the requirement of the Designs Act, 2000. The High Court held that the registered design of the Plaintiff is liable to be cancelled, and therefore the Defendants succeeded in claiming relief against the injunction applications filed by the Plaintiff. Accordingly, the High Court dismissed the injunction applications filed by the Plaintiff. In addition, the High Court directed the Plaintiff to pay a sum of Rs. 200,000* to each of the Defendants in addition to the actual legal costs, subject to final decision towards costs incurred for these proceedings. ■

[*Rs./INR 65 = USD 1 approx]

**SRMB Srijan Limited
vs Prime Gold International Ltd. & Anr.
Delhi High Court, Single Bench, 1st March 2018**

Injunction Granted

Facts and Contentions:

The suit pertains to the trade dress rights in the unique and distinctive pattern formed by way of artistic linings on the concrete reinforcing bar (TMT bar) manufactured by the Plaintiff which was given the name "X-RIBS" bars, since 2001, and blatant copying of the distinctive surface pattern by Defendant No. 1 on its TMT bars.

Plaintiff alleged that the "X-RIBS" pattern in its TMT bars had no connection with the natural shape of the article, and claimed to have spent large sums of money to promote and popularize its "X-RIBS" TMT bars. It had also issued warnings to the public about duplicate products.

Held:

The High Court was of the prima facie view that the "X-Rib" marks on the TMT bars of the Defendant on the face of it were identical with that of the Plaintiff's product. The Plaintiff has made out a prima facie case for an ex-parte ad interim injunction which if not granted would cause irreparable loss of revenue and goodwill to them, in addition to violation of their common law rights. The balance of convenience too lies in favour of the Plaintiff. The Court restrained the Defendant and all parties associated with them from manufacturing, marketing, selling and advertising products including TMT bars and rods by applying the pattern of 'X ribs' or any other colourable imitation thereof. The Court also appointed a Local Commissioner to identify, with help from the Plaintiff, if necessary, any offending goods at the Defendant's address and any other locations and prepare an inventory of the same to produce before the Court as and when required. ■

**The Chancellor, Masters & Scholars of University
of Oxford & Ors. (Appellants/Plaintiffs)
vs Rameshwari Photocopy Services & Ors.
(Defendants/Respondents)
Delhi High Court, Division Bench, 9th December 2016**

Injunction Not Granted

The Appellants are the Plaintiffs. The Respondents are the Defendants.

Background:

The dispute before the learned Single Judge concerned photocopying of pages from the copyrighted publications of the Plaintiffs, namely (i) Oxford University Press; (ii) Cambridge University Press, United Kingdom; (iii) Cambridge University Press India Pvt. Ltd.; (iv) Taylor & Francis Group, U.K.; and (v) Taylor & Francis Books India Pvt. Ltd. The first Defendant, Rameshwari Photocopy Services, has a shop licensed to it within the precincts of the Delhi School of Economics (University of Delhi). Albeit with an initial denial by the University of Delhi, the ultimate picture which emerged was that the professors imparting teaching in the Delhi School of Economics had authorized preparation of course packs and Rameshwari Photocopy Services was entrusted with the task of photocopying the pages from the books published by the Plaintiffs, and after binding the same, to supply them to the students charging 50 paise per page. Though not a part of the pleadings of the parties, access to the website of the Plaintiffs gives valuable data concerning the number of pages comprising the publications and the price thereof, in the paperback edition, as also the hardcover edition.

It is the case of the Plaintiffs that:

- The inclusion of specific pages of its publications by Rameshwari Photocopy Services, under the authority of the Delhi School of Economics, amounts to institutional sanction for infringement of its copyright.
- The professors of the Delhi School of Economics, through its Library, issued the books published by the Plaintiffs to Rameshwari Photocopy Services for preparing course packs.
- The course packs, which contain no additional material apart from photocopies of its copyrighted publications, were being used like textbooks and therefore, the compilations prepared were competing with the publications of the Plaintiffs.

- Rameshwari Photocopy Services was operating commercially as was evident from the rate charged by it for selling the course pack is 40/50 paisa per page, as distinct from the market rate of 20/25 paisa per page being charged by other photocopiers from the students while photocopying material given by the students to be photocopied.
- Section 52(1)(i) of the Copyright Act was not applicable since reproduction by Rameshwari Photocopy Services, with the assistance of Delhi School of Economics, could not be classified as reproduction by a teacher or a pupil in the course of instruction.
- Additionally/alternatively the reproduction in the manner carried out by Rameshwari Photocopy Services fell within the ambit of Section 52(1)(h) and was buttressed by Article 9 and Article 10 of the Berne Convention, 1886, as well as Article 13 of the Agreement on Trade-Related Aspect of Intellectual Property Rights (TRIPS), 1995.

Rameshwari Photocopy Services contested the copyright of the Plaintiffs in the books from which the course packs were prepared by pleading that:

- The preparation of course packs by it amounts to fair use within the meaning of Sections 52(1)(a) and (h) of the Copyright Act, 1957.
- Its activity does not affect the market for the Plaintiffs' books since it charges a nominal rate for its services as fixed by the License Deed executed between the Delhi School of Economics and Rameshwari Photocopy Services.
- The students cannot afford to buy all the books, extracts of which were mentioned in the syllabi prepared by the Delhi School of Economics.

Apart from adopting the stand taken by Rameshwari Photocopy Services, in its written statement, the University of Delhi denied issuing books to Rameshwari Photocopy Services for the purposes of preparation of course packs, and pleaded that:

- Section 52(1)(i) of the Copyright Act, 1957 permits students and educational institutions to copy portions from any work for research and educational purpose.
- Rameshwari Photocopy Services has been licensed by it to operate a photocopy shop within its premises in order to facilitate photocopying by students for educational and research purposes.
- No limitation on the quantum of reproduction under Section 52(1)(i) has been provided under the Copyright Act, 1957 and because Section 52(1)(i)

covers reproduction for educational purposes, unlimited photocopying would be permitted.

- That the term 'reproduction' used in Section 52(1)(i) was distinct from the term 'publication' used in Section 52(1)(h), with Section 3 of the Act defining "publication" as making a work available to the 'public', with the term 'public' having a wider connotation than the term 'students' and therefore, Section 52(1)(h) would not be applicable to preparation of course packs to be used by students for an educational purpose.

- The Berne Convention and the TRIPS Agreement permit signatory nations to make reasonable exceptions to copyright and the educational exception created under Section 52(1)(i) was such a reasonable exception.

Examining the relationship between Rameshwari Photocopy Services and the Delhi School of Economics, the learned Single Judge opined that:

- Making of multiple copies by photocopying copyrighted material by the University, being in the course of instruction, was permissible under the Copyright Act, 1957, holding further that it was immaterial whether the University carried out the photocopying through its employees or outsourced this work to a contractor.
- The price being charged by Rameshwari Photocopy Services for its services was not competitive with the price being charged by the Plaintiffs for their books and therefore, it could not be said that Rameshwari Photocopy Services was operating commercially.
- With regard to TRIPS, it had been left to each signatory country to define the scope of what would 'unreasonably prejudice the legitimate interests of the copyright holder' and 'justified by the purpose'; and since the legislature is deemed to have been cognizant of India's obligations under the International Covenants, while in the year 2012 incorporating the amendments to the Indian Copyright Act, 1957, and had allowed reproduction 'in the course of instruction' by teachers and pupils without placing any limits on the extent of reproduction, it could not be said that India's obligations under International covenants were not met.

The Court HELD, inter alia:

- Publication need not be for the benefit of, or available to, or meant for reading by, all the members of the community. A targeted audience would also be a 'public' as rightly urged by learned counsel for the Appellants.

- A publication would have the element of profit, which would be missing in the case of reproduction of a work by a teacher to be used in the course of instruction while imparting education to the pupils.
- That apart, if reproduction includes the plural, it cannot be held that making of multiple copies would be impermissible. It happens in law that footprints of one concept fall in the territory of another but that does not mean that the former should be restricted.
- Concerning the argument that there cannot be an intermediary when use of copyrighted material post reproduction takes place in the course of instruction, common sense tells us that neither the teacher nor the pupils are expected to purchase photocopiers and photocopy the literary work to be used during course of instruction in the class room. The argument concerning use of an agency is thus irrelevant.
- University of Delhi produced a copy of the licence in favour of Rameshwari Photocopy Services as per which, as of January 2012 it could charge only 40 paise per page and judicial notice is made of the fact that as of said year photocopiers were charging 50 paise per page in the market. Hence, apart from the usual profit which Rameshwari Photocopy Services would be making while photocopying material, no profit otherwise is being made for the activity in question and the activity therefore would simply be to photocopy pages and not prepare course packs in the context of the activity.
- No institutional sanction for photocopying was found as was urged by the Appellants, for the reason that the role of the University of Delhi ends when its academic council lays down the course curriculum.
- Nothing much turns on Article 13 of the TRIPS Agreement and Article 9 of the Berne Convention for the reason that the contents thereof are merely directory and have enough leeway for the signatory countries to enact the copyright law in their municipal jurisdiction concerning use of copyrighted works for purposes of dissemination of knowledge.
- The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.
- We find that the learned Single Judge has dismissed the application seeking interim injunction against the Defendants and simultaneously, on the reasoning that no triable issue arises, the suit has been dismissed. The suit is restored for trial on the issue of fact and for which parties would be permitted to lead expert witness testimony.
- Having restored the suit and identifying the triable issue warranting evidence, we are not inclined to grant interim injunction to the Appellants but would direct Respondent No.1 to maintain a record of course packs photocopied by it and supplied to the students. Every six months the statement of number of course packs photocopied and supplied shall be filed in the suit. ■

The suit was subsequently withdrawn by the Plaintiffs.

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