



# IP Case Compilation 2019

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## Preface

Intellectual Property (IP) regime in India took the revolutionary road in the year 2018-19 with radical and profound changes seeing the light of the day. It will not be a hyperbole to throne this year as the flag bearer of cardinal transformations. Department of Industrial Policy and Promotion (DIPP), the government department that is responsible for promotion and protection of IP rights in India, including the functioning of the Intellectual Property Office, has introduced various administrative and procedural mechanisms for improvising prosecution in the different domains of intellectual property law.

In addition, the litigation and assertion domain has also witnessed unprecedented developments and path breaking decisions by the apex court and the high courts. There has been an escalation in the number of IP litigations in India. The High Court of Delhi, as always, has been the front line player in development of the IP litigation matrix with Bombay and Calcutta High Courts actively following the pursuit. The present compilation brings to you the ratios of some of the groundbreaking and interesting IP litigations of the last few years.

Research & Publication Team

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## TRADEMARKS

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### **H&M Hennes & Mauritz AB & Anr. v. HM Megabrands Pvt. Ltd. & Ors.**

Court: High Court of Delhi

Case No.: Interim Application No. 7259 of 2016 in CS (Comm) No. 707 of 2016

Order dated: 31st May 2018

#### **Issue:**

1. Whether the Defendants' mark infringed the Plaintiff's mark?
2. Whether the Plaintiff's mark had gained any recognition in India at the time when the Defendants adopted their mark?
3. Whether the Plaintiff was entitled to claim exclusive rights over the two letters HM or H&M?

**Judgement:** The Delhi High court granted a permanent injunction in favour of the plaintiff, Hennes & Mauritz, thus securing the rights of a foreign company in their trade mark against the rights of an Indian company. The dispute arose when the plaintiff, proprietor of the famous brand/mark H&M came across the defendants' mark HM and filed a suit seeking injunction to restrain the infringement of their trade mark.

Plaintiff No. 1, is a well-known designer and seller of fashionable clothing having over 4000 outlets worldwide along with online presence in 21 countries. The trade mark H&M was adopted by the plaintiffs in early 1970. The plaintiffs secured the first registration in the said trade mark in UK in 1985, whereas it was registered in India in 2005. The plaintiffs claimed prior and exclusive rights in their trademark and contended that the defendants had represented the letters "H" & "M" in a manner similar to that of the plaintiffs and used the colour combination of red and white as well, thus infringing the plaintiffs' rights in their mark.

On the other hand, the defendants, HM Megabrands, an Indian company engaged in the business of marketing, supplying and selling of garments etc. adopted the mark HM in 2011 and applied for its registration in 2014. In their defence, the defendants argued that the adoption of their mark was honest as the same was derived from the initials of its directors' names. In addition to this, they claimed that the use of "megabrands" in their mark sufficiently differentiated their goods from those of the plaintiff. Further, their primary contention was that the plaintiffs had not entered the Indian market in 2011 i.e. the year of adoption of the defendants' mark and thus had not acquired any reputation with respect to their trademark in India.

The Court while dealing with the question of similarity between the two marks stated that any consumer familiar with the plaintiffs and their brand H&M upon seeing the defendants' brand and seeing it being described as "megabrand" may associate the goods of the latter with the former. Further, it noted that the addition of "megabrands" to the alphabetical letters "HM" in the Defendants' mark creates an impression of association between the two parties and reinforces the impression in the minds of the consumers that the businesses of the rival parties are related to each other.

As regards the generic nature of "H&M" or "HM", the Court held that the said trademarks were not generic or publici juris to the trade or businesses of the plaintiffs and defendants. The said trademark was alien to the trade of both the parties which was related to fashion clothing and had been admittedly adopted by the plaintiffs much prior to the defendants.

As far as the question of the plaintiffs' presence in India at the time of adoption of the defendants' mark was concerned, the Court noted that for an international mark/brand to have reputation or goodwill in India, setting up of a shop or sale in India is no longer a necessity and the introduction of web-based sales has increased the familiarity of international marks and brands in the Indian market. Thus, the court concurred with the plaintiffs' claim of prior rights in their mark and concluded that the case was prima facie in favour of the plaintiff.

Thus, the court restrained the defendants from using in any manner whatsoever the trade mark/service mark/trade name .HM, .HM, .HM MEGA BRANDS/ .HM or any other deceptive variations of the same in relation to their businesses, products etc.

## **Arun Chopra v. Kaka-Ka Dhaba Pvt. Ltd. and Ors.**

Court: High Court of Delhi  
Case No.: CS (Comm) No. 728 of 2018  
Order dated: November 28, 2018

**Issue:** Whether the Defendants have infringed the Plaintiff's rights by adopting trademarks with the expression – Kaka.

**Judgement:** The famous restaurant Kake Da Hotel has managed to secure its rights in its name and trademarks against Nashik-based food outlets namely Kaka-kaDhaba', 'Kaka-Ka Restaurant' and 'Kaka-Ka Garden'. The Court observed that although there is no doubt that the Plaintiff's user is extremely long and extensive, the question as to whether the word 'Kaka' or 'Kake' can be monopolised by any party could only be adjudicated at trial. Although, the interim order has been granted in favour of the plaintiff whereby the defendants have been prohibited to use the expression 'Kaka-ka' in relation to any new outlet during the pendency of suit, it has permitted the defendants to continue using the names Kaka-ka Dhaba', 'Kaka-Ka Restaurant' and 'Kaka-Ka Garden'. Further, even though, it allowed the operation of the defendants' company, 'Kaka Da Dhaba Pvt. Ltd.', the establishment of any new entity by the name of Kaka was prohibited. The rights of the parties shall be determined in the subsequent hearing.

## **Bigtree Entertainment Pvt. Ltd. v. D. Sharma and Anr.**

Court: High Court of Delhi  
Case No.: CS (Comm) No. 609 of 2016  
Order dated: January 21, 2019

**Issue:** Whether the mark 'BOOKMY' has attained an exclusive meaning and that the plaintiff can claim exclusive rights on the same.

**Judgement:** The Court refused to grant injunction in favour of the plaintiff. The plaintiff, Bigtree Entertainments, proprietor of the 'BOOKMYSHOW' mark had filed a suit for trademark infringement, seeking restraint of use of mark 'Book My Event' or prefix 'Bookmy' by the Defendants. The Court ruled that the plaintiff's mark "BOOKMYSHOW" has not attained exclusivity and that the prefix 'BOOKMY' is a common English term and its link with booking for shows, events, films, etc. is obvious which makes it descriptive of the services in respect of which it is claimed for. It noted that the visual effects namely, font and colour schemes of the rival marks are different and therefore, it is unlikely that the customers would be confused by the said trade names or marks.

## **Carlsberg Breweries v. Som Distilleries and Breweries Limited**

Court: High Court of Delhi  
Case No.: CS (Comm) No. 690 of 2018  
Order dated: December 14, 2018

**Issue:** Whether a composite suit that joins infringement of a registered design and passing off of a trademark is maintainable?

**Judgement:** The Delhi High Court has held that a composite suit dealing with infringement of a registered design and passing off is maintainable, thus overruling its judgment in Mohan Lal v. Sona Paint wherein it was held that these actions cannot be combined in one suit as the causes of action on which both the matters were premised on were different.

The Court observed that in the instant matter, the cause of action pertaining to the infringement of a design as well as passing off emanated from the same transaction and therefore to avoid multiplicity of proceedings, the claims for infringement and passing off could be clubbed together in one suit. The Court observed that since the sale of products by

the defendant would be in question in both causes of action, a substantial part of the facts of the two actions would be the same as to whether the article being sold by the defendant of a particular design is or is not a fraudulent or obvious imitation of the article of the plaintiff. Thus, it was held that to a considerable extent, the evidence of two causes of action would be common and therefore, in order to avoid multiplicity of proceedings, a joinder of the two causes of action should take place.

## **Crocs Inc Usa v. Bata India Ltd & Ors**

Court: High Court of Delhi

Case No.: FAO (OS) (COMM) 78/2018 & CM APPL. 17358-61/2018 and others  
Order dated: January 24, 2019

**Issue:** Whether a design can also function as trademark?

**Judgement:** The plaintiff was unsuccessful in a suit filed for design infringement as the designs on which the suit was filed were found to be not new or original and therefore the Plaintiff pressed for the injunction on the ground of passing off which is an action in common law. It was settled by an earlier judgment of five judge bench that as long as the elements of design are not used as a trade mark, but a larger trade dress get up, presentation of the product through its packaging and so on, given that a passing off claim can sustain. A passing off action has been held to be maintainable with respect to elements of trade dress and overall get up, other than registered design and not with respect to registered design. It was argued by the Defendant that if the passing off is claimed of elements of the design as a trade mark, no passing off action lies. Since the plaintiff itself relied on use of its registered designs as a shape trade mark and no additional features qualifying as trade dress, which are not part of the registered design have been pleaded or pointed out, the passing off suit is not maintainable. The court agreed with the Defendant that the plaintiff has not been able to show any extra features, besides the design, which is used as a trade mark.

The Court interpreted the legislative intent of the Design Act which is to grant limited monopoly by design registration and after the term of registration, it should be open for anyone to use the said design. The legislative intent will be defeated if the design after its term was allowed to be used as trademark. The court used the analogy of patents rights which is granted for a limited period and observed that the intention to give design protection for a limited time cannot be extended to protection in perpetuity by claiming trademark rights. Therefore, the court gave an opinion that not only the registered design cannot be a trade mark during the period of design registration but even thereafter. Accordingly, the court held that a registered design cannot constitute a trade mark; however if there are features other than those registered as a design and are shown to be used as a trade mark and with respect to which goodwill has been acquired, it is only those extra features which can be protected as a trade mark. If there has been a copy of registered design, only an action for infringement under the Designs Act would lie.

## **Glenmark Pharmaceuticals Ltd. v. Curetech Skincare and Galpha Laboratories Ltd.**

Court: High Court of Bombay

Case No: Notice of Motion (L) No. 1890 of 2018 in COMIP (L) NO. 1063 of 2018  
Order dated: 28th August, 2018

**Issue:** Whether a defendant being a habitual offender can be asked to pay exemplary damages?

**Judgement:** The dispute concerned the Plaintiff's product Candid-B, an anti-fungal cream, and a similar drug being sold by Defendant No. 2 named Clodid-B ("impugned mark"). In addition to the adoption of similar word mark, the Defendant No. 2 had also copied the trade dress, color scheme, art work, font style and even manner of writing of the Plaintiff's product. The Defendant No. 2 stated that the impugned mark was adopted by mistake and chose not to contest the suit. The Defendant No. 1, being just the contract manufacturer for Defendant No. 2, also chose to submit to the decree. While decreeing the suit in favour of the Plaintiff, the Court considered the fact that the Defendant No. 2 is a habitual offender. The counsel for the Plaintiff produced a prior judgment of the Delhi High Court [Win-Medicare Pvt. Ltd. Vs. Galpha Laboratories Ltd. & Ors.], wherein it was categorically observed by the Delhi High Court that



Defendant No. 2 is a habitual offender. It was also noted by the Court that various pharmaceutical companies have instituted infringement cases against Defendant No. 2 and most of them have obtained injunction orders. Over and above the infringing activities, the Defendant No. 2 was also found to be a violator of FDA regulations. In many instances, the medicinal products of Defendant No. 2 were found to be of “Not of standard quality/Spurious” by Central Drugs Standard Control Organization. In view of the repeated violations, the Court, as a matter of deterrence, slapped an exemplary cost of Rupees One Crore Fifty Lakhs on Defendant No. 2. Along with this cost, the Court also ordered the furnishing of personal undertakings to the Court from all the Directors of Defendant No.2 to the effect that they would withdraw and destroy all products bearing the impugned mark and its variants from the market; apply for cancellation of manufacturing permission for products bearing the impugned mark; shall conduct business in accordance with FDA rules and regulations and would not indulge in infringing activities qua products of not only the Plaintiff but other pharmaceutical companies also.

## **M/s. Nandini Deluxe v. M/s. Karnataka Co-Operative Milk Producers Federation Ltd.**

Court: Supreme Court of India  
Case No: Civil Appeal Nos. 2937-2942 of 2018  
Order dated: 24th July, 2018

**Issue:** Does a registered proprietor have unfettered exclusive rights to stop the adoption and use of the mark (not being an invented word/mark) by another in respect of different goods but falling in the same class?

**Judgement:** In this case, the Hon’ble Supreme Court has held and observed that certain goods may fall in the same class; however, they may be quite different in their commercial applications, businesses and markets which would obviate the likelihood of confusion between the rival marks, especially when the marks are commonly used words and not invented. In this case, the rival marks/labels in question pertained to the words “Nandini” and “Nandhini” of the Respondents (registered proprietor) and Appellants respectively, where the former was used only in respect of milk and milk products and the latter in respect of foodstuffs sold in restaurants and restaurant services. It was noted that “Nandini” / “Nandhini” was a commonly used word representing the name of a Goddess in Hindu Mythology and that it was not an invented or coined word of the Respondents. The Court also held the marks not to be deceptively similar as seen in light of the difference in the corresponding goods and businesses even though both the marks pertained to classes 30 and 43. The Court also relied upon its own observations in the case of Vishnudas Trading as Vishnudas Kishendas v. The Vazir Sultan Tobacco Ltd. and Anr. AIR 1996 SC 2275 that “if a trader or manufacturer actually trades in or manufacturers only one or some of the articles coming under the broad classification and such trader or manufacturer has no bona fide intention to trade in or manufacture other goods or articles which fall under the said broad classification, such trader or manufacturer should not be permitted to enjoy monopoly in respect of all the articles which may come under such broad classification.”

## **Christian Louboutin SAS v. Abubaker & Ors.**

Court: High Court of Delhi  
Case No: CS (Comm.) No. 890/2018  
Order dated: 25th May, 2018

**Issue:** Can the use of a single colour, claimed to be a trademark on products sold in the market, amount to the use of a ‘trademark’ in law? Can a single colour ever become a trademark as defined in the Trade Marks Act, 1999?

**Judgement:** In this case, the mark in question was the colour red applied on the entire outer face of the sole of ladies’ footwear. The Plaintiff claimed exclusive ownership over its red sole trademarks in respect of the ladies’ footwear that it designed and manufactured. A suit for passing off and infringement of trademark was filed seeking an injunction and damages against the Defendants, who were selling shoes, the soles of which were red. However, the Court held that a single colour is incapable of being a trademark since it is not even a “mark” as defined in the Trade Marks Act, 1999. The Court observed that in order to become a “trademark”, the matter in question would first have to be a “mark”. When a mark is used in the course of trade and identifies the source of goods as originating from a particular manufacturer or



seller then that mark becomes a trademark. The definition of “mark” under section 2(m) of the Act “includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof”. As with regard to colour, this definition contains only “combination of colours”, the Court held that a single colour, not being envisaged in the definition of “mark”, is incapable of being elevated to the status of a “trademark”. Although the plaintiff relied on a previously decided case of *Christian Louboutin SAS v Mr Pawan Kumar & Ors* (12 December 2017) wherein the court had upheld the Plaintiff’s exclusive entitlement to trademark ownership of the colour red on the sole of ladies’ footwear and awarded the trademark well-known status; the Court in the present case observed that the judgment relied upon had not considered section 2(m) of the Act, which being vital to the issue ought to have been taken into account. This section is deemed to prohibit a single colour from being given the status of a trademark and thus no manufacturer or seller can be given exclusive ownership of such a trademark. The Court also held that a red sole was a feature that enhanced footwear’s visual appeal and marketability, and a third party was free to use it as a characteristic feature of its products. This order has been overruled by the Division bench which has been discussed herein below.

## **Christian Louboutin SAS v. Abubaker & Ors.**

Court: High Court of Delhi

Case No: RFA (OS)(COMM) 13/2018 & CM 29064/2018

Order dated: 11th April, 2019

**Issue:** Can a single colour ever become a trademark as defined in the Trade Marks Act, 1999?

**Judgement:** The Division Bench of the Delhi High Court allowed an appeal filed by Christian Louboutin. The appeal challenged the judgment passed by a single judge of the court in a suit filed seeking monopoly on its RED SOLE trademark. The Division Bench has set aside the judgment and observed that that the Single Judge’s invocation of a provision under the code of Civil Procedure dealing with ‘judgment on Admissions’, to dismiss the lawsuit at the first date of hearing was erroneous. It was observed that the impugned Judgment passed was contrary to the other orders passed in favour of Christian Louboutin by coordinate Single Benches of the Delhi High Court, in particular the judgment passed recognizing the RED SOLE trademark as a well-known trademark. The Hon’ble Bench stated that it was well established that in cases where there exists a difference of opinion on questions of law by coordinate benches, the matter should be referred to a larger bench.

## **M/s. Epsilon Publishing House Pvt. Ltd. v Union of India & Ors.**

Court: High Court of Delhi

Case No.: LPA 73/2018, C.M. APPL.7426-7431/2018

Order dated: 9th March, 2018

**Issue:** Whether procedural delays on the part of Trade Mark Registry can hamper the rights of the owner to renew his registered trademark?

**Judgement:** Affirming the decision of the learned Single Judge, the Division Bench of the Delhi High Court noticed that procedural delays on part of the Trade Marks Registry cannot act as an impediment on the rights of the registered owner of a trademark. The challenge was made by the Appellant, owner of the trademark Easy Notes, on the ground that since the renewal application for its trademark ‘LokpriyaEasyNotes’ was filed by the Respondent after a few days of its expiration, it was required to be accompanied by the prescribed surcharge in addition to the prescribed fee, which the Respondent failed to pay.

The Court rejected the Appellant’s arguments and observed that since the renewal application filed by the Respondent in the year 2011 was not taken up by the Registry for six years, the defect of deficit fee was not brought to the attention and knowledge of the Respondent, and when the renewal application was finally processed in the year 2017, the Registry demanded the surcharge which was duly paid by Respondent. Therefore, the renewal request was allowed within the ambit of the law. The Court also held that the defect was a curable one, which the Registrar ought to have brought to the

Respondent's notice and since the Registrar failed to do so, the Respondent could not be deprived of its right due to fault or delay on part of the Trade Marks Registry. Thus, the Court upheld the Registry's decision to renew the Respondent's trademark 'LokpriyaEasynotes' that had expired in 2011.

### **Skechers USA Inc. & Ors. v. Pure Play Sports & Ors.**

Court: High Court of Delhi

Case No.: CS(COMM) 573/2016

Order dated: 15th May, 2018 and 20th August, 2018

**Issue:** Whether a summary judgment along with cost of the proceeding can be awarded by the Court?

**Judgement:** The dispute that began in 2016 concerning infringement of the trade dress of the Plaintiffs' shoes has finally been disposed of in favour of the Plaintiff. An interim injunction was granted vide order dated May 25, 2016 along with appointment of a commissioner for entering the premises of the Defendants and seizing the goods therein. All the Defendants lost their rights to file the Written Statement vide order dated May 03, 2018. Pure Play Sports appeared before the Court but did not offer any defence; other Defendants were proceeded against ex parte. Considering these circumstances coupled with other documents/information and detailed reasons given in the order dated May 25, 2016, the present court passed a decree of permanent injunction by way of summary judgment in favour of the Plaintiffs along with the costs of suit to be paid by Pure Play Sports. In consonance with Chapter 23 of the Delhi High Court (Original Side) Rules, 2018, the taxing Officer determined the costs and amount of INR Eighty Six Lacs Ninety Eight Thousand One Hundred and Seventy Three was imposed by the Court on Pure Play Sports.

### **Parakh Vanijya Pvt. Ltd.v. Baroma Agro Product & Ors.**

Court: Supreme Court of India

Case No: Civil Appeal No. 6642 OF 2018

Order dated: 12th July, 2018

**Issue:** Whether exclusive rights can be claimed over the word MALABAR?

**Judgement:** Affirming the decision of the Division Bench of the Calcutta High Court, the Supreme Court of India dismissed the appeal without costs. An interim order of injunction initially passed by the Single Judge of the Calcutta High Court was later modified to the effect that the Respondents shall be entitled to use the word 'MALABAR' in conjunction with 'BAROMA' where all the words and letters must be in the same font but the word 'MALABAR' may be increased with font size of not more than 25% than the rest of the words or letters. Aggrieved by this, an appeal was preferred before the Division Bench by the Appellant which dismissed the same by upholding the modified decision of the Single Judge. An appeal was then filed at the Supreme Court. Relying on the disclaimer to the exclusive use of the word 'MALABAR' as applied by the Appellant for its mark in class 30 and on the basis of already existing MALABAR formative marks registered in Class 30, the Apex Court held that the Appellant has no right over the exclusive use of the word 'MALABAR'. Further, the Apex Court also specifically held that on comparing the two label marks, the same appeared substantially different. The modified label of the Respondents consisting of the words "BAROMA", "MALABAR", "GOLD" had a different get-up from that of the Appellant. Owing to the above submissions and materials placed on record, the Apex Court upheld the order of the Calcutta High Court and did not find any serious infirmity warranting interference with the impugned order.

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

Court: Supreme Court of India

Case No: Civil Appeal Nos. 5375-5377 of 2017

Order dated: 14th December, 2017

**Issue:** Whether the quantum/degree of trans-border reputation, for the purpose of enforcement, should be so high as to involve the awareness of the public at large?

**Judgement:** Affirming the decision of the Division Bench of the Delhi High Court, the Supreme Court of India noticed that though the Plaintiff had used the mark PRIUS first in the world in 1997 and gained certain amount of publicity since then across the world in relation thereto, it was able to use the mark in India only in 2010 and had filed an application for its registration in 2009 on a “proposed to be used” basis. The Apex court observed that the existence of trans-border reputation and claimed well-known nature for the mark PRIUS on or before the relevant date (i.e. the year 2001 when the Defendant started using the mark) needed to be established, which was lacking in this case owing to ‘scanty’ evidence and/or absence of appreciable documentary proof. The Apex court also observed that knowledge of the said brand even among the relevant sections of the public was not prominent, due to inter alia, lack of internet connectivity/omnipresence of the world-wide-web back in 1997 when just two news items were published in print (in India) pursuant to the Plaintiff’s launch of its PRIUS brand of cars in Japan. The importance of having customers within a particular jurisdiction from a brand-specific perspective was also seen by the Apex Court as a key factor for establishing goodwill within that jurisdiction.

## Royal Orchid Hotels Ltd. v. Kamat Hotels (India) Ltd

Court: Supreme Court of India

Case No: SLP (C) No. 6131 of 2017

Order dated: 14th December, 2017

**Issue:** (1) Whether the adoption of the mark ‘ORCHID’ by the Petitioner was dishonest? (2) Whether the use of the mark ‘ORCHID’ by the Petitioner will cause confusion in the mind of consumers?

**Judgement:** The dispute between Petitioner and the Respondent, which commenced as an opposition proceeding before the Trade Marks Registry, has finally come to an end after the Supreme Court recently dismissed the Special Leave Petition in favour of the Respondent in a case revolving around the trademark ‘ORCHID’.

The Deputy Registrar rejected the Petitioner’s applications for registration of the marks ‘ROYAL ORCHID’ and ‘ROYAL ORCHID HOTELS’ in class 42. The Registrar, after a careful consideration of the evidence submitted, concluded that the Respondent was prior user of the mark ‘ORCHID’, and since ‘ORCHID’ is the only registrable part of the Petitioner’s trademarks, the rival marks are confusingly similar. The Registrar also held that the Respondent’s mark ORCHID has become ‘well-known’ and the Petitioner’s marks have been dishonestly adopted.

Later, IPAB reversed the order of the Deputy Registrar on two grounds. Firstly, it observed that although the Respondent has claimed use of its mark ORCHID since 1997, the Registrar of Companies had given his approval for the name of the Petitioner’s company ‘Royal Orchid Hotels Private Limited’ in 1996. Thus, it cannot be said that the adoption of the Petitioner’s mark is dishonest. Secondly, on the premise of ‘anti-dissection rule’, the Petitioner’s marks were held to be dissimilar to the Respondent’s mark ‘ORCHID’. It was held that since the class of consumers would be of high income group, any chance of confusion between the rival marks is unlikely.

Thereafter, the Respondent approached the Madras High Court by instituting a writ claiming that the Petitioner has merely added the descriptive word ‘ROYAL’ to its trademark ‘ORCHID’. The well-reasoned judgment of the High Court brought another twist in the case, wherein the court took into account all the factors including the fact that the Petitioner has acquired registration for its marks in class 16. Although it was clarified that the adoption of the Petitioner’s marks is honest, the two issues of prior use and likelihood of confusion were decided in favour of the Respondent. It was held that although the Petitioner’s company was incorporated in 1997, it commenced its business in the year 2001. Also, it was opined that the fact of target consumers belonging to high income group cannot be taken as a general proposition as each individual would have a different mind-set to a particular factual situation. Thus, IPAB’s order was set aside.

Finally, the Apex Court reaffirmed the views taken by the High Court and dismissed the Special Leave Petition in favour of the Respondent.

## Patel Field Marshal Agencies v. P.M. Diesels Ltd. And Ors.

Court: Supreme Court of India  
Case No: Civil Appeal Nos.4767-4769 OF 2001  
Order dated: 29th November, 2017

**Issue:** Whether rectification of a registered trademark under section 47/57 of the Act can still be availed where an infringement suit is pending wherein the issue of validity of the registration has been raised either by the plaintiff or the defendant and no issue on the said question of validity has been framed in the suit, or if framed, has not been tried by the concerned party by filing a rectification application to the Tribunal/IPAB?

**Judgement:** The Supreme Court has provided much desired clarification with respect to Section 124 of the Trademarks Act. The Apex Court held that it is a settled law that the issues relating to and connected with the validity of registration has to be dealt with by the Tribunal and not by the civil court. In cases where the parties have not approached the civil court, the provision of Sections 47 and 57 provide an independent statutory right to an aggrieved party to seek rectification of a trade mark. However, in the event the Civil Court is approached and parties have raised the issue of invalidity of the trade mark, such plea will be decided not by the civil court but by the IPAB. The Court noted that the Tribunal will however come into picture only if the Civil Court is satisfied that an issue with regard to invalidity ought to be framed in the suit. Once an issue to the said effect is framed, the matter will have to go to the Tribunal and the decision of the Tribunal will thereafter bind the Civil Court. If despite the order of the civil court the parties do not approach the Tribunal for rectification, the Court held that the plea with regard to rectification will no longer survive. The Apex Court held that if an aggrieved party does not approach the Tribunal for a decision on the issue of invalidity of registration, the right to raise the issue of invalidity would no longer survive between the parties to enable the concerned party to seek enforcement of the same by recourse to or by a separate action under the provisions of Section 47/57 of the Act.

Furthermore, in a situation where the Civil Court does not find a triable issue on the plea of invalidity, the remedy of an aggrieved party would not be to move under Sections 47/57 of the Act but to challenge the order of the Civil Court in appeal.

## Deere & Company and Ors. v. Malkit Singh and Ors.

Court: High Court of Delhi  
Case No.: CS(COMM) 738/2018  
Order dated: 23rd April, 2018

**Issue:** Whether the use of colour scheme, getup, layout, manner of placement of various parts of the equipment is an infringement of the trade dress of the Plaintiffs?

**Judgement:** The Plaintiffs had been using green and yellow colour combination over agricultural products since 1910 and for the tractor, this colour combination was in use since 1918. The manner of use was very peculiar and unique to the Plaintiffs i.e. Green colour for the body and yellow colour for the seat and the wheels/rims. The Defendants had used an identical colour combination in relation to identical products, i.e. agricultural vehicles, as well as in the same manner as that of the Plaintiffs i.e. Green colour for the body and Yellow colour for wheels and seat. The Court was of the opinion that the colour combination of green and yellow in relation to agricultural equipments is associated solely with the Plaintiffs and their goodwill in the agricultural industry is substantial as apparent from the fact that the Plaintiffs are the largest exporter of tractors from India. Consequently, the Court observed that in a prima facie opinion, Section 29(1) of the Trade Marks Act, 1999 is attracted, as the use of the colour combination of green and yellow by the Defendants, in conjunction with other elements, is liable to be taken as use in the sense of a trademark, especially when the Defendants claim that it helps in setting apart their products. The Court also held that the Defendants' adoption of an identical colour combination, its use in the same manner as that of the Plaintiffs and its denial of the Plaintiffs' rights in the said colour combination in its reply to legal notice dated 11th November, 2017 prima facie amounts to unfair advantage and constitutes behaviour which is contrary to honest and industrial practices. Consequently, the Defendants' action, also amounts to infringement of trade mark in accordance with Section 29(8) of the Act.

## **Yahoo Inc. v. Mr Rinshad Rinu & Ors.**

Court: High Court of Delhi  
Case No.: CS (COMM) 668/2016  
Order dated: 3rd July, 2017

**Issue:** Whether the Defendants' adoption of Plaintiff's mark YAHOO on his website is dishonest?

**Judgement:** Relying on the evidences and arguments of the Plaintiff, the Court granted permanent injunction in favour of the Plaintiff restraining the Defendants from using the trade mark YAHOO in any manner. The Court further clarified that, "...the adoption of the YAHOO mark by the Defendants is dishonest as is evident from the fact that the font used by the Defendants to represent YAHOO in their trading name was identical to the unique stylized font which the Plaintiff used to represents its YAHOO trade mark till 2014. There is also no plausible explanation for the adoption of the identical mark as a part of the trading name and domain name of the Defendants. Further, the Defendants cannot have any justification for the adoption of the mark YAHOO. The potentiality of harm is enormous on the internet as the Plaintiff has a very wide internet presence and operates various YAHOO formative websites. In any event, as the averments in the plaint have not been rebutted by the Defendants in spite of ample opportunities given by this Court, they are deemed to have been admitted." The Court further imposed monetary damages amounting to INR 5 Lacs on the Defendants.

## **Pidilite Industries Limited v. Poma-Ex Products & Ors.**

Court: High Court of Bombay  
Case No.: Notice of Motion No.2695 of 2016 in Suit No. 653 OF 2014  
Order dated: 2nd August, 2017

**Issue:** Whether the adoption of part trademark "KWIK" by the Defendants is diluting the distinctiveness of the Plaintiff's trade mark?

**Judgement:** The Court held that the mark 'KWIKHEAL' used by the Defendants is prima facie deceptive and misleading. The Court was also of the opinion that the Defendants have adopted identical packaging to ride on the reputation of the Plaintiff. The Court further held that there exists a high degree of phonetic similarity between the mark of the Plaintiff "FEVIKWIK" and the mark of the Defendants "KWIKHEAL", as the word "KWIK" is a dominant part of the Plaintiff's trademark. The Court issued an injunction in favour of the Plaintiff.

## **Puma Se & Anr. v. Nikhil Thermoplast Ltd. & Ors.**

Court: High Court of Delhi  
Case No.: CS (COMM) 992/2016  
Order Dated: 22nd August, 2017

**Issue:** Whether the use of the Defendants' device/logo mark is descriptive in nature and whether the Defendants' use of such mark infringes the trademark rights of the Plaintiffs?

**Judgement:** The Court considered the evidences and arguments submitted by the Plaintiff and held that due to extensive use over a substantial period of time, the Plaintiffs' PUMA mark along with the Form Strip Logo has acquired reputation and goodwill. The Court further opined that the use of the impugned mark by the Defendant is bound to cause incalculable loss of reputation and sales to the Plaintiff. The Court, therefore, granted a permanent injunction in favour of the Plaintiff. However, the Defendant did not appear before the court and did not file a written statement in response. Therefore, the order was passed ex-parte.

## **Tata Sons Ltd. vs Sunil Kumar Jangra & Ors.**

Court: High Court of Delhi  
Suit No.: CS (OS) 2297/2011  
Order dated: 9th October, 2017

**Issue:** Whether the Defendants' adoption of Plaintiff's mark TATA in relation to transport, packaging and storage of goods, travel arrangement, packaging / and moving services and also on his website [www.tatasafe.com](http://www.tatasafe.com) is dishonest?

**Judgement:** Relying on the evidence and arguments of the Plaintiff, the Court granted permanent injunction in favour of the Plaintiff restraining the Defendants from using the trade mark TATA in any manner. The Court further clarified that the Defendants' adoption and usage of the trade mark TATA and the domain name [www.tatasafe.com](http://www.tatasafe.com) is causing deception and confusion in the minds of the public. The Court also directed to transfer the domain name [tatasafe.com](http://tatasafe.com) in favour of the Plaintiff; and also imposed a cost of INR 2,17,941 as legal fee in addition to the monetary damages of INR 20,05,000 against the Defendant.

## **SAP SE & Ors. v. Transweave Solutions Pvt. Ltd. & Anr.**

Court: High Court of Delhi  
Suit No.: CS (OS) 325/2013  
Order Dated: 12th October, 2017

**Issue:** Whether the Defendant used the Plaintiff's mark even after the expiry of the agreement, and if yes, then will such use cause deception, and damage to the Plaintiff's reputation?

**Judgement:** Relying on the evidence and arguments submitted by the Plaintiff, the Court opined that, the Defendants had been blatantly installing/using pirated software to train students amounting to unauthorised reproduction of the Plaintiffs' copyrighted software, and also using the Plaintiffs' registered trade mark SAP and SAP logo which amounts to trade mark infringement and is bound to cause incalculable losses, harm and injury to the Plaintiffs' business. The Court therefore, passed a decree of permanent injunction restraining the Defendants from using the trade mark SAP or SAP logo or any other mark similar to that of the Plaintiffs' and also awarded cost including lawyers' fees, local commissioner's fee as well as the amount spent on court fees.

## **The Singer Company Limited & Anr. vs. Ms. Anshu Singh**

Court: High Court of Delhi  
Suit No. CS (COMM) 1584/2016  
Order dated: 17th October, 2017

**Issue:** Whether the Defendant's adoption of Plaintiff's mark SINGER AGENCIES in relation to the same class of goods would amount to infringement and/or passing off?

**Judgement:** The Court was of opinion that the Plaintiff is the prior user and registered proprietor of the mark SINGER and that the Defendant has no justification for the adoption and use of a virtually identical trade mark in relation to identical products and thus, the act of the Defendant clearly amounts to infringement as the Defendant is not a permitted user of the Plaintiff's registered mark SINGER. The Court permanently restrained the Defendant from using the trade mark SINGER Agencies or any other mark similar to that of the Plaintiff and also ordered the Defendant to voluntarily withdraw/cancel all the trade mark applications filed for any mark similar to that of the Plaintiff and also awarded actual cost of litigation including attorney's fees to the Plaintiff.

## **Prudential IP Services Limited v. Prudential Prosperities Company Pvt. Ltd. & Ors.**

Court: High Court of Delhi  
Suit No.: CS (OS) 3325/2015  
Order Dated: 14th November, 2017

**Issue:** Whether the use of the word mark PRUDENTIAL by the Defendants is infringing the trademark rights of the Plaintiff and does such act also amount to passing off?

**Judgement:** After hearing all the averments, the Court decided that the Plaintiff's trademark holds a worldwide reputation and has acquired goodwill and that the Defendant has used the trademark without any authorization or permission. Also, the Defendant did not rebut the claims and evidence submitted by the Plaintiff Company. The court, thus, held that usage of the impugned mark by the Defendant amounted to infringement and passing off, causing damage and injury to the Plaintiff. Apart from the permanent injunction granted as per the Plaintiff's prayer, the Defendant was also directed to pay the cost of the suit to the Plaintiff.

## **Christian Louboutin SAS v. Mr. Pawan Kumar & Ors.**

Court: High Court of Delhi  
Suit No.: CS (COMM) 714/2016  
Order Dated: 12th December, 2017

**Issue:** (1)Whether the signature style "RED SOLE" high heeled shoes of Plaintiff can be considered as a well- known trade mark because of its international recognition and trans- border reputation?(2)Whether styling of the Defendant's product (red sole shoes) are infringing the trade mark rights of the Plaintiff?

**Judgement:** The Delhi High Court restrained the Defendant from using the Plaintiff's signature style "RED SOLE" high heeled shoes. The Court, deciding ex parte, observed that since the trade mark of the Plaintiff enjoys substantial goodwill and trans- border reputation, it can be considered as a well- known trade mark. The Court also granted damages in favour of the Plaintiff.

## **Bigtree Entertainment Pvt. Ltd. v. Brain Seed Sportainment Pvt. Ltd. & Anr.**

Court: High Court of Delhi  
Case No.: CS (COMM) 327/2016  
Order dated: 13th December, 2017

**Issue:** (1)Whether the Defendant's use of the prefix "BOOKMY" in its mark BOOKMYSports amounts to infringement and/or passing off of the Plaintiff's mark BOOKMYSHOW? (2)Whether the prefix "BOOKMY", is a descriptive phrase or an invented term?

**Judgement:** The Court denied the grant of injunction against the Defendant observing that the word 'BOOKMY' is not a coined or invented word and the prefix is a descriptive one which describes exact description of a business that is involved in the booking of a particular thing/activity. The Plaintiff also failed to show any substantive evidence that the prefix 'BOOKMY' has acquired a distinctive meaning in the relevant market which led to the denial of injunction.



## **M/s. Castrol Limited & Anr. v. Iqbal Singh Chawla & Anr.**

Court: High Court of Delhi  
Case No: CS (OS) 4/ 2011  
Order dated: 3rd January, 2018

**Issue:** (1)Whether the Defendants have infringed the registered trade mark ‘ACTIVE’ of the Plaintiff by using the mark ‘T4 ACTIVE’?(2)Whether the Defendants have infringed the copyright of the Plaintiff by using the impugned label?

**Judgement:** The Castrol Limited sued the Defendants who were involved in selling 4T oil under the trade mark “Lumax Active” who were said to have infringed the trade mark “Castrol Active” which was separately registered in the name of Castrol Limited. Castrol Limited, the Plaintiffs here claimed relief in relation to its trade dress, copyright in packaging including the shape of the container of the bottle. The Plaintiffs’ case was that the Defendants have copied the exact trade dress, shape of the bottle, label lay-out and colour scheme of the Plaintiffs which amounts to infringement of trade mark, copyright as well as makes a fit case for passing off. The Court opined that if there is a comparison between trademarks “Castrol Active” of the Plaintiff and “Lumax Active” of the Defendant, there does not appear to be any deceptive similarity between the marks if it is seen in isolation of the trade dress, colour scheme, packaging, design, layout, shape and configuration. Thus, the moment when the rival trademarks were examined in conjunction with the trade dress, colour scheme, packaging, design, layout, shape and configuration, it became evidently clear that the adoption of the trade mark “Active” by the Defendants was clearly a dishonest adoption to in cash upon the goodwill and reputation of the Plaintiffs. In this said case though the Court found that the rival marks were different, the dishonesty of the Defendants lied in adopting the exact same trade dress. The Court however added that the said injunction will not affect the right of the Defendants if the Defendants used the word “Active” in completely different trade dress, colour scheme, packaging, design, layout, shape and configuration.

## **Sun Pharma Laboratories Ltd. v. Lupin Ltd. & Anr.**

Court: High Court of Delhi  
Case No: CS (COMM) 918/2016  
Order dated: 19th February, 2018

**Issue:** (1)Whether the Defendant’s mark TRI-VOBIT is prima facie deceptively similar to the Plaintiff’s trade mark TRIVOLIB?(2)Whether the prior use of a mark will be recognized over statutory rights obtained through Registration?

**Judgement:** The primary arguments taken by Defendant were its trademark registration for the mark TRI-VOBIT and its prior use of the mark VOBIT since 2008. As the Defendant was also the registered proprietor of the mark, the Court could not decide the preliminary injunction application on the infringement issue and the only relief which the Court could have granted was on the passing off. The Plaintiff refuted the Defendant’s arguments by submitting that they do not have any objections on Defendant’s use of the mark VOBIT or TRI but argued that the Defendant could be permitted to use the word TRI-VOBIT as it is structurally and phonetically similar to the Plaintiff’s registered trade mark TRIVOLIB. The court noted that the passing off rights are considered to be superior to that of registration rights. It was observed that passing off in common law is considered to be a right for protection of goodwill in the business against misrepresentation caused in the course of trade and for prevention of resultant damage on account of the said misrepresentation. The court noted that plaintiff is a prior user of the trade mark TRIVOLIB and it commenced use of the trade mark in October 2011. While relying on various case laws, the Court held that the Defendant’s mark was indeed deceptively similar to the Plaintiff’s mark and thus affirmed the earlier order of interim injunction passed in this matter.

## **Max Healthcare Institute Ltd. v. Sahrudya Health Care Pvt. Ltd.**

Court: High Court of Delhi  
Case No: CS (COMM) 866/2016  
Order dated: 29th November, 2017

**Issue:** Whether a plaint can be rejected on the basis of non-joinder of a necessary party?

**Judgement:** Though a suit cannot be defeated/rejected for misjoinder or non-joinder of parties; however, in case of non-joinder of a necessary party, suit may not only be liable to be dismissed on a preliminary issue being framed in this regard but also liable to be rejected by way of demurer on basis of averments in plaint on an application under Order VII Rule 11 of CPC, or otherwise. The Plaintiff sought a relief under the Act alleging infringement of its registered trade mark, relief of passing off having been given up. A bare reading of Sections 52 and 53 of Act, shows that, only a registered proprietor or a registered user of Trade mark is competent to institute proceedings for infringement in his own name. Thus, very maintainability of a suit for infringement is by a registered proprietor/registered user. As per the plaint, Plaintiff is not registered proprietor/registered user of Trade mark 'Max'. It is registered owner/proprietor of composite label mark and word 'Max' is a part of mark. Present suit seeking infringement of word 'Max' is liable to be rejected for non-joinder of necessary parties under proviso to Order I Rule 9 of CPC, read with Section 52, 53 and 134 of Act, however Plaintiff is registered owner of six label marks namely Max Health Care, Max Hospital, Max Medcentre, Dr. Max Clinic, and Max Health Staff and claim of Plaintiff in plaint is that word 'Max' is an essential feature of Plaintiff's six label marks and thus, by using word 'Max' Defendant has infringed essential feature of its label mark. Since in plaint, Plaintiff claims and even from label marks it is evident that 'Max' is essential feature of label mark of six Trademarks, thus, use of word 'Max' by Defendant amounts to infringement. Consequently, plaint cannot be rejected at this stage.

### **Louis Vuitton Malletier Vs. Kapil Pahuja and Ors.**

Court: High Court of Delhi

Case No: CS (OS) 1320/2014

Order dated: 16th January, 2018

**Issue:** Whether the Court has territorial jurisdiction to entertain suit?

**Judgement:** Where a corporation is having ordinary residence/principal place of business and cause of action has also arisen at that place, corporation has to institute a suit at said place and not at other places Section 134 of Act, never intended to operate in a field where place of business and cause of action has arisen at that place so as to enable it to file a suit at a distant place where its subordinate office is situated. In present case, Plaintiff does not carry on business at Chandigarh where cause of action has arisen. On other hand, Plaintiff carries on business from Delhi. Hence, in view of Section 134(2) of Act, this Court would have territorial jurisdiction to adjudicate present suit.

### **Saregama India Limited Vs. Eros Digital FZ LLC and Ors.**

Court: High Court of Delhi

Case No: CS (COMM) 625/2017

Order dated: 12th October, 2017

**Issue:** Whether the Court has no territorial jurisdiction to entertain suit due to Clause 29 of License Agreement whereby parties had consented to submit to jurisdiction of Courts at Kolkata?

**Judgement:** Where there are two or more competent Courts which can entertain a suit consequent upon a part of cause of action having arisen therewith, if parties to contract agree to vest jurisdiction in one such Court to try dispute which might arise as between themselves, agreement would be valid. This cannot be understood as parties contracting against statute. Said agreement would not be contrary to public policy or in contravention of Section 28 or 23 of Act. Clause 29 of agreement is clear and unambiguous. Parties by this clause have bound themselves that in any matter arising between them under said agreement, it is Court in Kolkata alone which will have jurisdiction. Once parties bound themselves as such, it is not open for them to choose a different jurisdiction as such, as the suit would be in violation of said agreement. Averments in plaint are to be considered to ascertain if this Court has territorial jurisdiction to entertain suit. Plaintiff has alleged infringement of its Copyright by Defendants. Merely because Defendant No. 2 is not a party to license agreement it cannot be inferred that suit qua Defendant No. 2 alone can be entertained by this Court. Since this Court has no territorial jurisdiction to entertain suit, relief as claimed cannot be granted by this Court. Plaintiff will have to approach Court of competent jurisdiction to avail relief claimed.

## Microsoft Corporation and Ors. Vs. Rajesh Kumar and Ors.

Court: High Court of Delhi  
Case No: CS (COMM) 444/2016  
Order dated: 17th October, 2017

**Issue:** Whether the Court has jurisdiction to try and decide this suit as cause of action has arisen only at Gurugram, Haryana and in Hyderabad, Telangana at which places Plaintiffs have their offices?

**Judgement:** It was incumbent upon Defendant to specifically deny each and every assertion of Plaintiff qua territorial jurisdiction lest there shall be a deemed admission. Coming to facts of this case where Defendants on its website has admitted of its offices at New Delhi, it being a global company and per its governing laws viz. Courts in New Delhi has exclusive jurisdiction; coupled with fact of no specific denial in its written statement to averments made in para 28 of plaint viz. Defendant deemed to have admitted such allegations and hence, at this stage it cannot be said this Court has no jurisdiction. This issue rather needs to be elaborately gone into evidence.

## Nokia Corporation and Ors. Vs. Movie express and Ors.

Court: High Court of Delhi  
Case No: CS (COMM) 286/2012  
Order dated: 3rd November, 2017

**Issue:** Whether the suit for declaration, permanent injunction for restraining, passing off of Trade mark and delivery up should be decreed as prayed for?

**Judgement:** Defendant's marks Mr. NOKIA and/or Mr. NO.KEYIA and/or Mr. NAV-KIA and/or NOOKAIAH are deceptively and confusingly similar to Plaintiff's well-known and Registered mark NOKIA. For comparing marks, test is whether totality of proposed Trade mark is such that it is likely to cause deception or confusion or mistake in minds of persons accustomed to existing trade. As Plaintiff is Registered proprietor of mark NOKIA in class 41 under No. 1237567 in relation to entertainment services, use thereof by Defendant in relation to such services amounts to infringement under Section 29(1) of Act. Infringement under Section 29(1) of Act does not require confusion in minds of public/consumers with regard to trade origin. It is enough to show that impugned marks are deceptively similar to Registered marks of Plaintiff, even if, there are added matters to show a different trade origin. Plaintiff's mark is a well-known Registered Trade mark and has repute in India. Use of mark by Defendants is without any due cause and is detrimental to distinctive character of Plaintiffs' highly distinctive, well-known and Registered mark. In such circumstances too, Plaintiff is entitled to seek benefit of statutory provisions of Section 29(4) read with Section 29 (7), (8) and (9) of Act. None should be continued to be allowed to use a world famed name to goods which has no connection with the type of goods which have generated worldwide reputation. Plaintiffs' mark "NOKIA" has also developed a global goodwill and reputation and use of defendant's mark may dilute and debase goodwill and reputation of Plaintiff and would lead public to believe goods/services are originating from Plaintiff. In view of circumstances, suit of Plaintiff is decreed in terms of prayer Clauses No. a, b, c, d and e as stated in para 56 of plaint. A decree of permanent injunction restraining Defendants, their directors, partners, proprietors, distributors, agents etc. from advertising, airing songs, publishing, publicizing, offering for viewing, impugned movie under title Mr. NOKIA and/or Mr. NO.KEYIA and/or Mr. NAV-KIA and/or offering songs containing reference to mark NOKIA and/or NO.KEYIA and/or any other identical or deceptively similar to Plaintiffs Registered Trade mark 'NOKIA' is granted.

## Columbia Sportswear Company v. Harish Footwear & Anr.

Court: High Court of Delhi  
Case No.: CS (COMM) 1611/2016  
Order dated: April 28, 2017

**Issue:** Whether the plaintiff's mark has trans-border reputation?

**Judgement:** The Court held that the Plaintiff has failed to discharge (through any documentary evidence) its burden showing that its presence in India has been active or that it is recognized in the Indian Market. After comparing the Defendant's use of the mark COLUMBIA for shoes since the year 2002 against the Plaintiff's subsequent trade mark registration of 2007, the Court held the Plaintiff has failed to make prima-facie case and balance of convenience also lies in favour of Defendant no. 2 on the basis of which the Delhi high court has vacated its initial interim injunction.

## **Rubiks Brand Ltd. & Anr. v. Mahesh Vaman Manjrekar & Ors.**

Court: High Court of Bombay

Case No.: NMCDL/155/2017

Order dated: April 5, 2017

**Issue:** Whether the usage of trade mark Rubik's Cube by the Defendant in a film title amounted to passing off upon the trademark rights of the plaintiff?

**Judgement:** The Court passed an ad interim injunction order against Mr. Mahesh Manjrekar and other Defendants restraining them from continuing to work on any film or other material bearing the name or title Rubik's Cube or the word 'Rubik' in the title. It stated that to determine passing off, intention and fraud need not be proved, instead the trinity test of goodwill/reputation, misrepresentation and likelihood of damage was to be relied upon which was in favour of the Plaintiff. The court also observed that Mr. Manjrekar used similar colours in his poster as that used in the "Rubik's Cube" toy which clearly amounted to trademark dilution of the Plaintiff.

## **Godfrey Phillips India Ltd. V. P.T.I. Pvt. Ltd.**

Court: High Court of Delhi

Case No.: CS (Comm.) No. 851/2017 and IA Nos. 14952-54/2017

Order dated: December 12, 2017

**Issue:** Whether the use of colours of green and gold in Defendant's packaging amount to infringement or passing off of Plaintiff's registered marks?

**Judgement:** The Court held that the plaintiff does not have a real prospect in establishing a case of passing off because the word mark used by the defendants as their trademark is totally different from the word mark which is used by the plaintiff as its trademark i.e 'CAVANDERS' of the plaintiff as compared to 'FUN GOLD' by the defendants. The customers who purchase cigarettes are reasonable and not reckless/negligent consumers, and that cigarettes are purchased on the basis of the brand name/trademark of the cigarettes. The plaintiff along with word mark 'CAVANDERS' is using an expression 'GOLD LEAF' whereas the defendants are using the expression 'SUPER LEAF' with the trademark 'FUN GOLD'. Also in any case and ultimately the main word mark which is a trademark of the plaintiff 'CAVANDERS' is so different from the word mark which is the trademark of the defendants namely 'FUN GOLD' that there will not arise at all any issue of passing off simply because of both parties using green and gold colours on their packaging especially because as stated above reasonable consumers purchase cigarettes by their brand name/word mark which is used as a trademark. Thus, mere existence of similar colour scheme of two simple shades of green and gold in the respective packaging will not cause passing off by the defendants when selling their goods/cigarettes simply because the plaintiff is also using those same two colours in their packaging for cigarettes.

The causes of actions of either of infringement or of passing off are not made out in favour of the plaintiff and against the defendants because the suit lacks real prospect of succeeding in terms of the causes of action pleaded, consequently leading to the dismissing of the suit by the Court.

### **Koninklijke Philips Electronics N.V. v Rajesh Bansal & Ors.**

Court: Delhi High Court

Case No: CS (COMM) 24/2016

Order Dated: 12th July, 2018

**Issue:** Whether there has been infringement of standard essential patent in respect of DVD playback technology?

**Judgement:** The Court recognized the essentiality of the patent related to the DVD playback technology, found the acts of the defendant infringing and also awarded damages in favor of the Plaintiff Phillips in accordance with FRAND terms.

On the question of essentiality of the suit patent, the court largely on the basis of the essentiality certificates of the US and EP Patents held that the suit patent is a SEP for the fulfilment of the DVD Standard. On the question of infringement, the court held that the claims of the suit patent are directed towards a decoding device without which DVD players cannot function and that plaintiff has successfully proved infringement by way of essentiality and also by expert evidence by showing the use of EFM and demodulation techniques in defendants' products. The court also held that defendants have failed to provide any evidence that so-called legitimate sources were licensees of the plaintiff and therefore the doctrine of exhaustion does not apply. Referring to the US Federal Court's decision in Commonwealth Scientific and Industrial Research Organization vs. CISCO Systems, Inc., the court held that defendants are required to pay royalty to the plaintiff @USD 3.175 from the date of institution of the suits till mid-2010 and after that @USD 1.90 till patent expiry in 2015 with interest @10% annually. The court also held that considering the conduct of one defendant who was an ex-employee of the plaintiff and knew fully well and with impunity infringed the suit patent, was liable to pay punitive damages of INR 5 lakhs. The court also appointed a Local Commissioner to inquire into the number of video players manufactured or sold by defendants during the relevant period and to ensure that the plaintiff shall be entitled to recover the amounts so found due.

### **Bayer Corporation v. Union of India & Anr. [W.P.(C) 1971/2014], Bayer Intellectual Property GMBH & Anr. v. Alembic Pharmaceuticals Ltd. [CS(COMM) No.1592/2016]**

High Court of Delhi

Order dated: 8 March, 2017

**Issue:** Whether the export of product covered under a patent falls within the Bolar exception to infringement of patent as provided for under section 107A (a) of the Patents Act, 1970

**Judgement:** A Single Judge bench of the Delhi High Court while hearing the above two cases interpreted the provisions of Section 107A(a) (Bolar exception) and held, inter alia, that the language of Section 107A of Patents Act permits exports from India of a patented invention solely for uses reasonably related to the development and submission of information required under any law for the time being in force, in India, or in a country other than India, that regulates the manufacture, construction, use, sale or import of any product. No suit prohibiting export per se of a patented invention can lie.

The Single Judge held that the terms and conditions of compulsory licence issued to the defendant Natco Pharma would not come in the way of the defendant exercising its rights under Section 107A(a) as a non-patentee.

Bayer challenged the decision of Single Judge before a Division Bench (DB) and secured an interim injunction against Natco from exporting the patented invention. The DB observed that prima facie it appears that Bayer would suffer irreparable loss and damage, if the interim protection was not granted.

## Monsanto Technology LLC & Ors Vs. Nuziveedu Seeds Ltd & Ors

High Court of Delhi  
Case No.: CS (Comm) 132/2016  
Order Dated: 28 March, 2017

**Issue:** Whether the termination of the sub-license agreement by Monsanto on the ground of non-payment of the agreed trait value by the defendant was legally tenable in view of the fixation of the trait value by respective state governments?

Whether the patent rights will be extended (directly or indirectly) to provide protection over those variety/seeds which were expressly excluded from the purview of patent protection?

**Judgement:** The Single Judge Bench of the Delhi High Court found at the interim stage that the termination of the sub-license agreement by MMBL was illegal and arbitrary. Accordingly, the Single Judge, modified its earlier order of injunction, and directed for restoration of the sub-license agreement between the parties with modification of trait fee payable by the defendants to MMBL. It was further held that the other issues would be decided if and when the case moves for full trial.

Later, a Division Bench of the Delhi High Court granted a stay on the restoration of the sub-license agreement between the parties in an appeal filed by Monsanto Technology.

## M/S. Iritech Inc. vs The Controller Of Patents

High Court of Delhi  
Case No.: W.P. (C) 7850/2014  
Order Dated: 20 April, 2017

**Issue:** Whether incorrect mentioning of the patent application number in Form 18 (Request for examination) will be considered as deemed to be withdrawn, even if the request to correct the clerical error was filed within statutory time limit?

**Judgement:** The Delhi High Court set aside the deemed to be withdrawn status assigned by the Patent office to the plaintiff's application. Rejecting the contention of the Patent Office that the power of the Controller to correct clerical errors can only be exercised when patent application is in examination procedure, and hence no office action was possible in present case, the Court observed that if the examiner had examined the application under Section 11B, in time and submitted his report, it would have been brought to the notice of the Petitioner well before the expiry of 48 months prescribed period that there was an error in the request for examination and the petitioner could have taken steps to remedy the error. It was held that if the Patent Office had stuck to the timelines for examination, the patent application would have been in the examination procedure.

## Roche & Cipla Settlement

Roche vs. Cipla long-standing battle eventually, as expected, reached the Supreme Court as Cipla preferred Special Leave Petitions [SLP (C) No. 1677-78 of 2016] against the Division Bench ruling in F. Hoffmann-La Roche Ltd. v. Cipla Ltd. affirming the Single Judge Judgement and decree dated September 7, 2012. The Supreme Court was finally considering the various questions of law and issues including issues such as the true scope and import of Section 3(d) in the civil appeal. However, in a surprising development, after a series of legal proceedings, the parties have finally settled their disputes. On May 30, 2017, the Single Judge of the Delhi High Court disposed of the suit as well as the counter-claim in terms of the compromise arrived at between the parties and accordingly passed a decree. Finally, on Cipla's request, the SC on June 22, 2017 dismissed the civil appeals as unconditionally withdrawn and accordingly allowed Cipla's application for withdrawal of the appeals.

## Merck Sharp & Dohme Corporation &Anr. v. Aprica Pharmaceuticals Private Limited

Court: High Court of Delhi  
Case No.: CS (OS) 1236/2013  
Order Dated: November 14th, 2017

**Issue:** Whether the Defendant's launch of ECOGLIPT in the Indian market would lead to infringement of the Patent right of the Plaintiff in SITAGLIPTIN?

**Judgement:** The Court was of the view that Defendant's product blatantly infringed and completely contravened Plaintiff's patent right. Although the Defendant had not launched the product commercially, still the court felt that there was reasonable apprehension that launching the product could cause irreparable damage to the Plaintiffs which could not be compensated in terms of money. The suit was, thus, decreed in favour of the Plaintiffs and against the Defendants along with the actual costs. The Plaintiff was also given the liberty to file the exact amount of money incurred in the adjudication of this suit.

## Shamnad Basheer vs Union of India & Ors.

Court: Delhi High Court  
Case No.: W.P 5590/2015  
Order Dated: April 23rd, 2018

**Issue:** Whether the Patentees are complying with requirements of working patents?

**Judgement:** This petition was filed with regard to issues relating to the working of patents. A stakeholder consultation meeting was also scheduled, whereby the Court had directed the Respondent No. 1 to place before the Court a reasonable timeline within which the consultation would be completed, suggestions would be received, examined and such amendments as may be deemed necessary would be made. The Petition was adjudicated by the High Court, thereby directing the Government to complete all steps towards effecting necessary amendments in the patent working provisions, strictly within the timelines proposed by it. It has also asked the Government to place a report before it upon completion of this exercise.

## Guangxi liugong Machinery Co. Ltd. Vs J.C. Bamford excavators

Opposition Proceedings before the Controller of Patents  
Opposition in the matter of Patent No. 251037  
Order Dated: April 9th, 2018

**Issue:** Whether the Controller can step into the shoes of the opponent who has withdrawn the opposition?

**Judgement:** In the captioned matter, the Controller of Patents, Patent Office, Delhi revoked a patent IN251037 owned by J.C. Bamford Excavators Ltd. ("JCB") on the ground of non-compliance of Section 8(1) of the Patents Act, 1970 (as amended) even though he acknowledged the novelty and inventive step of the claimed invention following a post-grant opposition filed by Guangxi Liugong Machinery Co. Ltd. ("Guanxi"). The subject patent was granted to JCB in 2012, in respect of an invention titled "Excavating and Loading Machine". On February 22, 2013, Guangxi filed a post-grant opposition to said patent within the prescribed time limit taking various grounds, inter alia, lack of novelty and inventive step, insufficiency of disclosure and violation of Section 8. Parallel to the opposition proceedings, an infringement suit between both the parties was also pending in the High Court of Delhi. Meanwhile, the parties amicably resolved their disputes and reached a settlement, the terms of which were also recorded by the High Court of Delhi. However, the Controller revoked JCB's Patent observing that though the settlement between the Parties mentions the withdrawal of the post grant opposition, but there is no provision in the Patents Act to withdraw the post grant opposition filed under



section 25(2). The Controller further noted that the court order is regarding the settlement towards infringement suit but not towards the post Grant opposition per se filed under section 25(2) of the Patents act 1970.

## **Nuziveedu Seeds Ltd. And Ors. Vs Monsanto Technology LLC and Ors.**

Court: Delhi High Court

Case No.: FAO (OS) (COMM) 86/2017

Order Dated: April 11th, 2018

**Issue:** Whether the Monsanto's patent over selected genetic sequence from a particular bacteria/micro-organism called *Bacillus thuringiensis* (bt), which when modified and inserted into a plant cell would produce a toxin that would repel pests, was valid in light of the statutory bar, in Section 3(j) of the Patents Act, against the patenting of plants and essentially biological material?

**Judgement:** The Division Bench of the Delhi High Court declared Monsanto's patent for Bt. Technology invalid because Section 3(j) of the Patents Act prohibited the grant of patents for plants, plant varieties or seeds or any part thereof. The court however did give three months to Monsanto to seek protection for its invention under the Plant Variety Protection & Farmer's Rights Act, 2002. While invalidating the Patent, the Court observed that what was granted was not a patent over the product, or even the method, but over identification of the "event" i.e. the place in the genetic sequence of the DNA where the CryAB2 protein, in the plant cell. The Court held that transgenic plants with the integrated Bt.Trait, produced by hybridization (that qualifies as an "essentially biological process") are excluded from patentability within the purview of section 3(j), and Monsanto cannot assert patent rights over the gene that has thus been integrated into the generations of transgenic plants. The other reason why the Court invalidated the Patent was that the Court was of the view that Bt. trait induced varieties is that they are parts of "seed". The trait, by itself has no intrinsic worth. It was further noted by the Court that the future propagation of the transgenic plants (after introgression and hybridization) and the subsequent transfer of the Bt. Trait in such plants and consequently, the transgenic seeds, will be a process of nature, and no step of human intervention can impede such transfer of the sequence. Therefore, it would be contrary to law and Parliamentary intent to enable Monsanto to have patent rights over the nucleic sequence once it is been duly introgressed and hybridized into the transgenic plants. This judgment has been overruled in Supreme Court which has been discussed below.

## **Nuziveedu Seeds Ltd. And Ors. Vs Monsanto Technology LLC and Ors.**

Court: Supreme Court of India

Case No.: CIVIL APPEAL NOS.4616-4617 OF 2018

Order Dated: January 08, 2019

**Issue:** Whether the summary invalidation of Monsanto's patent was valid?

**Judgement:** The Supreme Court allowed the appeal filed by Monsanto and held that summary adjudication of a technically complex suit requiring expert evidence also, at the stage of injunction in the manner done, was certainly neither desirable nor permissible in the law. The suit involved complicated mixed questions of law and facts with regard to patentability and exclusion of patent which could be examined in the suit on basis of evidence. The Supreme Court was satisfied that the Division Bench ought not to have disposed of the suit in a summary manner by relying only on documents extracted from the public domain, and not even filed as exhibits in the suit, much less examination of expert witnesses, in the facts of the present case. It was observed that the issues raised were complicated requiring technological and expert evidence with regard to issues of chemical process, biochemical, biotechnical and microbiological processes and more importantly whether the nucleic acid sequence trait once inserted could be removed from that variety or not and whether the patented DNA sequence was a plant or a part of a plant etc. are again all matters which were required to be considered at the final hearing of the suit. The court was satisfied in the facts and circumstances of the case that the nature of the injunctive relief granted by the Single Judge was in order and merits no interference during the pendency of the suit and the suit was remanded to the learned Single Judge for disposal in accordance with law.

## UnilinBeheer B.V. vs Balaji Action Buildwell

Court: Delhi High Court  
Case No.: CS(COMM) 1683/2016  
Order Dated: January 29th, 2018

**Issue:** If there is a revocation petition pending before the IPAB and a subsequent patent infringement suit is filed before a High Court, would the Court necessarily be required to stay the suit awaiting the decision of the IPAB on the validity of the patent?

**Judgement:** The Court observed that unlike in the Trade Marks Act, 1999 where the jurisdiction to cancel the mark vests only with the IPAB, under The Patents Act, 1970, the jurisdiction to revoke a patent vests with the IPAB as well as with the Civil Court. The Court also analyzed the decision in the case of Patel Field Marshal Agencies v. P.M. Diesels Ltd. 2017 SC 1388 in respect of rectification of trademarks before the IPAB pursuant to an issue of invalidity of registration being framed and then taken up as a defence in a suit for infringement. In respect of trademarks, the IPAB will come into action only if the Civil Court is satisfied that an issue with regard to invalidity ought to be framed in the suit. Once an issue to the said effect is framed, the matter will have to go to the IPAB (during which the suit will be stayed) and the decision of the IPAB will thereafter bind the Civil Court. The Court further observed that the IPAB is not in a position to grant the relief of infringement or any consequential relief. Also, since the term of validity of the patent had expired, it was more convenient and expedient that the proceedings in the suit continue, rather than be stayed during the pendency of the revocation proceedings before the IPAB. The Court thus allowed the defendant to file a Counter Claim against the validity of the patent after withdrawing its revocation proceedings before the IPAB.

## K. Mannivanan v. The Chairman

Court: Madras High Court  
Case No.: W.P No.11951 of 2011  
Order Dated: August 18th, 2017

**Issue:** Whether a ‘sufficient difference’ between two inventions is enough to grant patent?

**Judgement:** The Writ Petition was filed to challenge the dismissal of a revocation application by the Intellectual Property Appellate Board. The court passed the order in favour of the respondent stating that the two machines in dispute were different. It observed that the finding of an invention may be deemed as a question of fact – and further observed the “constructional features” of the respondent’s machine were sufficiently and inherently different from the petitioner’s and it would be appropriate to say that it constitutes an invention. The Court also observed certain unessential features that in no way would affect the ‘substantive identity’ of the machine. The Writ Petition was therefore dismissed.

### **Vega Auto Accessories (P) Ltd. v SK Jain Bros Helmet (I) Pvt. Ltd.**

Court: Delhi High Court  
Case No.: CS(COMM) 837/2017  
Order dated: 1 June, 2018

**Issue:** Whether a registered proprietor of a design could use the invalidity or prior publication of the plaintiff's design as a defence in a suit for design infringement?

**Judgement:** Addressing the issue of estoppel against the defendant's plea of invalidity of design registration, the court considered various trademark cases where it was held that the defendant, being a registered proprietor of a trademark, when faced with an infringement suit, could not say that the mark of the prior registrant was not distinctive or could not have been registered. The reasoning provided by the court was that if a party has taken a specific stand at a particular stage of the court proceedings, it should not be open for that party to take a contrary position at a subsequent stage of litigation or in a different proceeding. A litigant cannot be permitted to take inconsistent positions in court to the detriment of the opposing litigant. The court discussed the difference between trademark and design registration. Trademark registration gives rise to a presumption of validity of registration while registration of a design is prima facie evidence only of the matters directed or authorized to be entered in the register. This was not an issue in the current case.

Once a party files an application claiming that a design is new or original, has not been published before, and is distinguishable from known designs, that party cannot oppose the claim for infringement by a prior registrant, if the party's design is identical to that of the prior registrant, by contending that there is no newness or novelty in the design of the plaintiff and/or that the design of the plaintiff was published before. Finally, it was held that where the plaintiff has prior registration of a design, and the defendant is the registered proprietor of a design that has infringed registered design of the plaintiff, the defendant is estopped from pleading invalidity of the registration in favour of the plaintiff.

### **M/S Crocs Inc. USA v. Liberty Shoes Ltd. & Ors.**

Court: High Court of Delhi  
Case No.: CS(COMM) 837/2017  
Order dated: 8 February, 2018

**Issue:** Whether the designs which registered by Crocs with respect to footwear are new or original designs or not?

**Judgement:** The issue of prior publication was held against the plaintiff because plaintiff's entitlement to exclusivity of the design of its footwear was from 28.5.2003, and that the defendants filed the printout downloads from the website of the plaintiff itself earlier than 28.5.2003 evidencing that the subject designs were clearly in the public domain before the priority date of registrations of the plaintiff. The court held that registration granted to the plaintiff with respect to registered designs which were subject matter of the suits will not afford any legal entitlement to the plaintiff to allege piracy of the designs under Section 22 of the Act. The Court held that Croc's design elements were simply the trade variants of sandal's design which have already existed for long, and were neither new nor original enough to claim protection under the Designs Act.

## **Kent RO Systems Ltd & Anr. v. Amit Kotak & Ors.**

Court: High Court of Delhi  
Case No.: CS (COMM) 1655/2016  
Order dated: 18 January, 2017

**Issue:** Whether EBay can be obligated to remove the content alleged to be infringing on an ex-ante, in contradiction to an ex-post, basis?

**Judgement:** The Court commenced its analysis by noting that, in order to prevail, the plaintiffs would have to explain how the Intermediary Guidelines spell out an obligation upon intermediaries to screen content to ascertain if it is of an infringing character. This onus would be imposed upon the plaintiffs, the Court reasoned, in light of the fact that a bare perusal of the Rules reveals that intermediaries are only bound to apprise users of their privacy policy/ rules and regulations and to disable infringing content, on being informed of its existence, within 36 hours.

Since the plaintiffs were apparently unable to answer this question in a satisfactory fashion, the Court arrived at the conclusion that no such directions could be issued. It gave 3 reasons in support of this conclusion. First, to accept the plaintiffs' prayer, it reasoned that it would result in converting the intermediary "into a body to determine whether there is any infringement of intellectual property rights or not" – a role which intermediaries are ill-equipped to perform. Second, if the intention of the legislature was to cast such an obligation upon intermediaries, the intermediary guidelines would have imposed an absolute embargo on hosting infringing content. However, the Guidelines merely cast an obligation to disable content on being informed that it is of an infringing character. Finally, since no obligation to screen infringing content is imposed on the publishers of newspapers etc., it would be inappropriate to impose such an obligation on intermediaries who are similarly situated as the aforementioned categories of service providers.

## **Krishna Plastic Industries v. Controller of Patents and Designs**

Court: High Court of Calcutta  
Case No.: AID 5 of 2013  
Order dated: 23 February, 2017

**Issue:** The subject matter of the appeal was an application for cancellation of the registration of the Appellant's design, which the Deputy Controller had allowed. The design in question related to a specific 'surface pattern' applied to a plastic seal.

**Judgement:** The Court perused the novelty statement filed by the Appellant at the time of registration, which read that the novelty in the design resided in the 'surface pattern' of the plastic seal, which was illustrated. The High Court noted that the Deputy Controller had allowed the application for cancellation without providing proper reasoning as to whether the surface patterns constituted a shape, configuration, pattern or ornament, to fall under the definition of a design under the Act, noting that 'only a single sentence (in the Controller's order) relates to the surface pattern'. The Court found, prima facie, that the 'ocular impression' given by the design of the Appellant seemed distinct from the design which was the basis of the challenge of the registration. On this basis, the Court remanded the matter to be reconsidered afresh by Deputy Controller, and to give a reasoned order. Separately, the Court also considered the distinction between a shape and configuration and a pattern or ornament, and opined that ornaments or patterns, particularly if pronounced (as in the case of grooves in a hot water bottle or markings on a chair) may also constitute a 'shape or ornament', applied upon an article, and asked the Deputy Controller to make a reasoned decision on the issue as to whether the surface pattern constitutes a shape, configuration, pattern or ornament.

## **Cello Household Products v. M/S Modware India and Anr.**

Court: High Court of Bombay  
Case No.: SUIT (L) NO. 48 OF 2017  
Order dated: 30 March, 2017

**Issue:** Whether a prima facie case of design infringement and passing off was made out.

**Judgement:** On the question of reputation, it was held that since this particular bottle of the plaintiff has achieved a great deal of commercial renown, the plaintiff has successfully established 'reputation' for the purposes of passing off. It was held that due to the obvious similarity between the rival designs, the question is not whether it is confusing, but whether it is calculated to deceive because Passing off is an action in deceit; the deceit lies in the misrepresentation; and the misrepresentation must be as to source, i.e., to deceive the average consumer into believing the defendant's product is the plaintiff's. It was held that defendant was attempting to deceive consumers into believing that its products came from the house of Cello i.e. plaintiff as there can be no possible explanation for defendant to adopt a shape, configuration, ornamentation and colour combination, so very nearly identical to that of plaintiff. The third element of passing off i.e. likelihood of damage was also deemed to have been fulfilled in the case. Further, it was held that since defendant's product was almost identical to the plaintiff's product, prima facie, plaintiff's design was sufficiently original and that defendant's product infringed upon it. Finally, prima facie, design infringement was concluded to have occurred.

## **Carlsberg Breweries A/S v. Som Distilleries and Breweries.**

Court: High Court of Delhi  
Case No.: C.S. (OS) No.1485/2015  
Order dated: 2nd May, 2017

### **Issue:**

1. The issue of maintainability of the composite lawsuit was raised by the defendants on the grounds that the Micolube judgement had held that a suit for design infringement action could not be combined with a suit for passing off.
2. Whether the design is novel and if there is any design infringement?
3. Whether functional designs can be protected?

**Judgement:** The Delhi High Court declined to grant plaintiff an interim injunction in a composite lawsuit filed for design infringement and passing off against Som Distilleries, the manufacturers of 'Hunter' beer, on the grounds that the design was prima facie not novel and that there was no infringement. It was held that on the basis of 'Statement of Novelty' it is clear that the plaintiff has not claimed novelty in respect of any peculiar feature of its bottle registration. The whole bottle has been registered as a design, and the shape of the bottle as a whole, undoubtedly, exists in the prior art. As such if the plaintiff had specifically claimed the specific grooves and indentations outlined in the pictures, it may have stood a better chance.

Apart from denying an interim injunction, Justice Sanghi has referred to a question of law to the Chief Justice on the grounds that the judgement in Micolube India regarding maintainability of composite suits decided by a three judge bench of the Delhi High Court, may have been decided per incuriam and observed that Order II Rule 3 of the Code of Civil Procedure clearly allows for combining different causes of action.

Although, there was no specific conclusion drawn with respect to the issue of functionality, it was observed that although both the Copyright Act and the Trade Marks Act have specific provisions prohibiting the protection of articles that are functional or technical in nature but there is actually no such prohibition in the Designs Act against the protection of designs that are functional. Further, it was also held that normally, designs which are purely functional cannot be protected or form the basis for an action for infringement but those cases must be excluded where a customer might choose an article of that shape not because he thought that the shape made it more useful to him.

## **Holland Company LP and Anr. v. S.P. Industries**

Court: High Court of Delhi  
Case No.: CS (COMM) 1419/2016  
Order dated: 27 July, 2017

**Issue:** The issue was regarding the existence of copyright in the industrial drawings of ATL devices of the plaintiffs.

**Judgement:** It was held that a conjoint reading of Section 2(d) of Designs Act, 2000, Section 14(c) and 15(2) of the Copyright Act, 1957, makes it amply clear that where a design of an article is prepared for the industrial production of an article, it is a design registrable under Designs Act and under Section 14(c), the author of such design can claim copyright. However, since such a design is registrable under the Designs Act, and if such design has been used for production of articles by an industrial process for more than 50 times by the owner of the copyright, or, by any other person with his permission, then such person ceases to have copyright in such design. It was held that the averments in the plaint clearly show that plaintiffs had prepared the engineering drawings for the purpose of production of ATL devices. The drawings of the ATL devices of the plaintiffs, therefore, are registrable under the Designs Act. The said drawings have not been registered under the Designs Act. The plaintiffs have also not disputed the fact that these engineering drawings have been used in the production of more than 50 ATL devices by an industrial process and, therefore, it is clear that it has used these engineering drawings for more than 50 times in an industrial process. By virtue of Section 15(2) of Copyright Act, therefore, even if assuming the plaintiffs had a copyright in these engineering drawings, it ceases to have the same. The plaintiffs have failed to show any prima facie case in their favour.

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## COPYRIGHT

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### **Fermat Education v. M/S Sorting Hat Technologies Ltd.**

Court: Madras High Court  
Case No: C.S.No.330 of 2018  
Order Dated: 13 August 2018

**Issue:** Whether there has been infringement of copyright in the course materials (2IIM CAT questions) which are uploaded by the defendant on its web site?

**Judgement:** The Court held that the fair use of the materials by a teacher or a pupil in the course of instruction cannot be pressed into service since the first defendant uploads materials for consideration. It was held that once consideration is paid for uploading materials, then it becomes a business venture and a responsibility is imposed on the defendants to ensure that they do not infringe the copyright of any another person. It was held that the defendants cannot enjoy the fruits of infringed materials prepared by the plaintiffs.

### **Sanjay Kumar Gupta &Anr. v. Sony Pictures Networks India Pvt. Ltd. & Ors.**

Court: High Court of Delhi  
Case No: RFA No. 627/2018  
Order Dated: 10th August, 2018

**Issue:** Whether a concept can be a subject matter of copyright?

**Judgement:** Upholding the judgment of a trial court and by relying on the well settled legal principles and precedents regarding the Copyright Law, the single judge bench of the High Court of Delhi pronounced its verdict on a copyright infringement dispute. The appellant filed a copyright infringement suit against the respondents for misappropriating the appellant's concept named "Jeeto Unlimited", wherein home viewers get to simultaneously play along with the contestants on the live TV show through their phone and are rewarded for a successful answer. The appellant contended that they presented this concept to the respondent, which runs the famous show KaunBanegaCrorepati ("KBC") in the shape of a concept note and thereafter, were compelled to sign a consent letter to the effect that the respondent would have the freedom to use the concept without incurring any liability.

The court quashed appellant's contentions by relying on the well settled principle recognized by the Supreme Court of India in the landmark case of *RG Anand versus Delux Films* in 1978 that a concept is not entitled to copyright protection. Further, apart from the Trial Court's findings regarding crucial differences between the Appellants' and Respondent's concepts, the court also quoted that the concept of home viewer participation in a quiz show is not a product of the appellants' intellect as it is a well-known idea which has existed in the public domain for a substantial period. Finally, in response to the appellants' argument that the use of their concept constituted breach of confidential information, the Court held that the appellants had themselves signed a consent letter authorizing the respondent to use this concept without incurring any liability.

## **B.N. Firos v State of Kerala**

Court: Supreme Court

Case No: Civil Appeal No. 79 OF 2008

Order Dated: 27 March, 2018

**Issue:** The Developer of a software program, created as a part of a Government project, challenged the State Government's Notification to declare it as 'Protected System' under Section 70 of the IT Act 2000 in Official Gazette.

**Judgement:** The Hon'ble Supreme Court held that upon reading the Copyright Act and the IT Act together, it can be observed that only those 'computer systems' should be considered as 'protected system' under the Information Technology Act, which qualify as 'Government Works' as per the Copyright Act. The Court rejected the Appellant developer's claim of copyright of in the software created as a part of government project, holding that the Government is the first owner of the software in question, since the work was first published by a Government Body as per Section 2(k) of the Copyright Act which defines the 'Government work'. Once this condition was satisfied, the Notification under Section 70 of the IT Act 2000 in Official Gazette was found to be lawful.

## **MySpace Inc. v. Super Cassettes Industries Limited**

Court: Delhi High Court

Case No: FAO (OS) 540/2011

Order Dated: 23 December, 2016

**Issue:** Whether MySpace could be said to have knowledge of infringement so as to attract liability for secondary infringement?

Whether it is possible to harmoniously read and interpret safe harbour provisions of the Information Technology Act and Infringement & 'fair use' of the Copyright Act?

**Judgement:** The Division Bench of Delhi High Court absolved liability of intermediary/MySpace as there was no direct infringement by MySpace and the findings of the Single Judge based on constructive knowledge and secondary infringement were termed incongruous. The Court observed that nature of relief has to be specific in relation to the actual content and not vague. A methodical and comprehensive approach was adopted by the Bench and it considered the WIPO Copyright Treaty, Performance and Phonogram Treaty, European Copyright Directive as well as the Digital Millennium Copyright Act 1998 of the US as the primary source of jurisprudence dealing with the 'safe harbor' provisions granted to intermediaries as defence. The Division Bench highlighted the distinction between general knowledge and 'actual knowledge' under provisions of the Copyright Act, 1957 ("CA"). It was observed that the liability of intermediary shall arise if it has the actual knowledge of infringement and not just general knowledge. Further the nature and scope of safe harbor for intermediaries in India is clarified in light of the provisions of Indian Information Technology Act, 2000 ("ITA") and the Intermediary Guidelines Rules, 2011.

The Division Bench opined that the Notice and Take Down procedure is the right balance for allowing freedom of speech and expression and at the same time curbs or polices the misuse of copyright material. It expressly stated that in cases of online infringement of copyright and in determining liability of intermediaries, harmonious construction of Sections 79 and 81 of the IT Act along with the provisions of the CA dealing with infringement and 'fair use'.



## Neetu Singh v. Rajiv Saumitra & Ors.

Court: High Court of Delhi  
Case No.: CS (COMM) 935/2016  
Order dated: 4 August, 2017

**Issue:** Whether the copyright of a literary work authored by the director of a company subsists with him in absence of any written agreement to the contrary?

**Judgement:** While the Court accepted that the Plaintiff was working as a Director of the company from 2012 to 2014, it noted that the Defendants had failed to prove that the literary work was authored as part of her duties and obligations as a Director. It was held that in the absence of an agreement, or the articles/memorandum of the company that might lay down the terms and conditions of employment – the Plaintiff was held to own the copyright in the works. The Court distinguished works ‘in the course of instruction’ that, and works that were ‘commercial in nature’. Holding the present use of the Plaintiffs work to be commercial in nature, and with a profit motive – the Court granted an interim injunction in favour of the Plaintiff.

## Universal Music (India) Pvt. Ltd. vs Trimurti Films Pvt. Ltd.

High Court of Bombay  
Case No.: SUIT (L) NO.459 OF 2017  
Order dated: 28 August, 2017

**Issue:** The issue was regarding differences in nature and scope of rights assigned in relation to the musical work and sound recording.

**Judgement:** The Court granted the injunction against the sale and distribution of the song ‘Kehdoontumhe’ which was a remake of the original musical composition forming a part of the cinematographic film DEEWAR of the year 1975, as a part of the latest film ‘BAADSHAHU’. The copyright in relation to the said original composition vested in the plaintiff Trimurti Films Pvt. Ltd., and the defendant Super Cassettes Industries Pvt. Ltd. had used and exploited the lyrics and tune of the original composition without any intimation / authorisation / permission from the plaintiff.

The key fact was the nature and scope of the rights which were assigned by the plaintiff to Polydor of India Ltd (now Universal Music Media Pvt. Ltd) in respect of the said original musical composition in the year 1974. While the plaintiff was claiming to be the owner of the lyrics and the tune of the work in question, asserting that the rights assigned in the favour of Polydor of India Ltd. to make and sell gramophone records of the songs of the film Deewar were of limited nature.

The case of the defendant rested on the claim that the plaintiff had extinguished its rights in the original work after assigning its rights in the sound recording to Universal Music, from whom, the defendant had obtained its rights (to adapt / remake).

The Court held the source of the defendant’s rights as inadequate and clarified that the Plaintiff had assigned rights only in relation to the sound recording of the original composition to Universal and this assignment cannot be considered to be of absolute nature. The rights to the original composition continued to vest with the plaintiff including the rights in relation to the lyrics and tune of the original composition in question. Hence, the defendant cannot be said to have acquired the rights to use the same for its movie ‘BAADSHAHU’. Consequently, the defendant had been restrained from releasing the film with the impugned song but the same could be released without the said song.

Further, apart from the Trial Court’s findings regarding crucial differences between the Appellants’ and Respondent’s concepts, the court also quoted that the concept of home viewer participation in a quiz show is not a product of the appellants’ intellect as it is a well-known idea which has existed in the public domain for a substantial period. Finally, in

response to the appellants' argument that the use of their concept constituted breach of confidential information, the Court held that the appellants had themselves signed a consent letter authorizing the respondent to use this concept without incurring any liability.

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## PLANT VARIETIES

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### **Prabhat Agri Biotech Ltd. And Anr. v. Registrar of Plant Varieties and Ors.**

Court: High Court of Delhi

Case No: W.P. (C) 250/2009

Order Dated: 2 December, 2016

**Issue:** Whether Section 24(5) of the Protection of Plant Varieties & Farmers' Rights Act 2001, which gives unguided power to authorities to restrict users of plant varieties, Constitutionally valid or not ?

**Judgement:** The court observed that there is enormous danger in empowering authorities with unguided power through provisions that can implicate livelihoods and limit or impair food access to farmers and users of plant varieties. The existence of a large section of farmers unschooled in provisions of the Act and unaware of their rights renders unethical bio- prospecting practices and spurious claims to development of new or other registrable varieties, entitled to registration, a real possibility. It was held that though Section 24 (5) of the Protection of Plant Varieties & Farmers' Rights Act at present may undoubtedly be an adequate remedy to prevent abusive practices (assuming that what is abusive can be defined over a period of time); yet the danger of abuse of the provision itself and the attendant (likely) long term injury to innocent breeders, farmers and those in the business of development of hybrids and plant varieties far outweighs its benefits. In view of the unguided nature of the power which is destructive of the rule of law and contrary to Article 14 of the Constitution of India; Section 24(5) of the Protection of Plant Varieties and Farmers' Rights Act, 2001 was declared void.



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