



A Holistic Compendium:

Indian Trade Mark Cases Summary

For 2019

Authors:

Tarun Khurana

Abhishek Pandurangi

Niharika Sanadhya

PREFACE

Indian Trade Mark jurisprudence saw a sea of developments and critically weighed judgements in the year 2019. With a notable increase in the number of IP litigations, Indian Judiciary; especially Delhi High Court, made immense contribution to help interpret trademark laws and zero down on the intent of the legislature. Staying true to what the subject possesses in its roots, the Courts also got creative with their decisions. To mention a few:

- The Hon'ble High Court opined on the psychology of a customer and on how customers perceive trademarks and words while recollecting pieces of information.
- That a prior user shall always triumph over a mark registered post the prior user's mark if proof of said prior use is sufficiently proven.
- Investigation is and shall always be considered a foundational feature and the Defendant will be given the benefit of doubt when the court is of the opinion that the Defendant is stuck in a bootless case with deficient evidence.
- In cases wherein a difference in opinion exists and decision by a single judge bench doesn't satisfy a question of law, the case may be referred to a larger bench since justice is always the prime most concern; considering such cases are difficult to conclude on the very first hearing.
- The necessity to inspect whether there has been any spill-over of the global goodwill and reputation within the relevant geographical territory was highlighted.

With that background and Khurana and Khurana's involvement in trademark litigations, this compendium aims to provide certain key judgment summaries that reflect a diverse range of issues discussed and adjudicated upon by the Indian Judiciary in the year 2019 pertaining to the interpretation/ implementation of various provisions of The Trade Marks Act, 1999 as provided herein below:

1. Copyright registration as evidence for trademark use¹:

Copyright registration of an artwork is immaterial for the purpose of proving the use of a trademark.

2. Exclusivity over the pre-fix part of a registered mark²:

A descriptive part of even a registered mark cannot acquire distinctiveness in its individual capacity through the use of the mark, even if as a whole.

3. A trade dress cannot be based off of a registered design in its entirety³.

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.

¹M/S Khushi Ram Behari Lalvs M/S Jaswant Singh Balwant Singh (2019) 258 DLT (CN 14) 14

² Bigtree Entertainment Pvt Ltd vs D Sharma &Anr 2019(77) PTC 411(DEL)

³ Crocs Inc. v. Bata India Ltd. and Others 2019 SCC OnLine Del 6808

4. The applicability of Geographical Indication right⁴:

The Calcutta High Court has ruled that GI Rights shall only be applicable to goods and not services.

5. Principle of Territoriality and the Doctrine of Universality ⁵:

It is necessary to inspect whether there has been any spill-over of the global goodwill and reputation within the relevant geographical territory.

6. In cases where there exists a difference of opinion on questions of law by coordinate benches, the matter should be referred to a larger bench⁶.

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 the Single Judge's invocation of a provision under the code of Civil Procedure dealing with 'judgement 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

⁴ Tea Board, India v. ITC Limited C.S. No. 250 of 2010

⁵ Intercity Hotel GMBH v. Hotel Intercity Delhi and Others 2019 SCC OnLine Del 7644

⁶ Christian Louboutin SAS v. Abubaker & Ors RFA (OS)(COMM) 13/2018 & CM 29064/2018

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.

7. The business of manufacturing counterfeiting and spurious goods shall be met with heavy costs⁷:

The Bombay HC in this case takes a strong stand against counterfeiting and imposes an exemplary cost of INR 5 crore on the Defendant.

8. Grant of protection to a well-known mark when the area of business and services are different⁸.

Even if the Defendant's area of business and services are different and the plaintiff's trademark has not been registered in the Class listing the area; the plaintiff's mark, being a well-known mark and in lieu of Section 2(1)(zg) of the Trade Mark Act will be liable for protection even if the mark is being used in respect of other goods or services for which it may not be registered.

9. When two independent rights of action may exist against a Defendant in a trademark infringement suit⁹.

The plaintiff will have two independent rights of action against the defendant who may be using the *corporate name* of a previously

⁷ Nippon Steel & Sumitomo Metal Corporation v. Kishor D. Jain & Anr. Notice of Motion (L) No 810 of 2019 in COMIP (L) No 383 of 2019

⁸ Exxon Mobil Corporation v. Exoncorp Private Ltd. CS (COMM) 111/2019

⁹ Thermax Limited vs Thermax Engineers Pvt Ltd CS(COMM) 157/2017

incorporated company; one under Section 22 of the Companies Act¹⁰ and the other for injunction restraining the defendant from using the corporate name of the plaintiff or from using a name bearing a close resemblance which may cause or which is likely to cause confusion in the minds of the customers or general public in view of the similarity of names.

10. Using similar trademarks along with different house marks – whether sufficient to establish distinctiveness ¹¹:

Whether using similar trademarks along with distinct house marks generates enough distinctiveness to allow consumers to differentiate between the two products depends upon facts of the case and attendant circumstances. These include, mode of purchasing, class of consumers, and the extent of similarity.

11. Priming and Word Association¹²:

Words are not stored in our minds as single lexical items but as forming clusters with other words or concepts. In order to see whether a mark is deceptively similar, one has to look at the concept of priming as well as imperfect recollection.

¹⁰ Excerpts from the Bare Acts are attached at the end of the document for reader's ready reference.

¹¹ Meso Private Ltd. v Liberty Shoes Ltd. &Ors. (Bombay High Court), 2019 SCC OnLineBom 1506

¹² Make My Trip (India) Private Limited v. Make My Travel (India) Private Limited, 2019 SCC OnLine Del 10638

INDEX

S.No	Content	Page No.
1.	List of important cases	8-9
2.	Case Summaries	10-44
3.	Disclaimer	45
4.	Glossary	46-60

LIST OF IMPORTANT CASES ON TRADE MARKS - 2019

S. NO	TOPIC	CITATION	PAGE
1.	Copyright registration of an artwork is immaterial for the purpose of proving the use of a trademark.	M/S Khushi Ram Behari Lalvs M/S Jaswant Singh Balwant Singh (2019) 258 DLT (CN 14) 14	10-12
2.	A descriptive part of even a registered mark cannot acquire distinctiveness.	Bigtree Entertainment Pvt Ltd vs D Sharma &Anr 2019(77) PTC 411(DEL)	13-15
3.	A trade dress cannot be based off of a registered design in its entirety	Crocs Inc. v. Bata India Ltd. and Others 2019 SCC OnLine Del 6808	16-18
4.	GI Rights shall only be applicable to goods and not services.	Tea Board, India v. ITC Limited C.S. No. 250 of 2010	19-22
5.	It is necessary to inspect whether there has been any spill-over of the global goodwill and reputation within the relevant geographical territory.	Intercity Hotel GMBH v. Hotel Intercity Delhi and Others 2019 SCC OnLine Del 7644	23-25
6.	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.	Christian Louboutin SAS v. Abubaker & Ors RFA (OS)(COMM) 13/2018 & CM 29064/2018	26-28

7.	The business of manufacturing counterfeiting and spurious goods shall be met with heavy costs.	Nippon Steel & Sumitomo Metal Corporation v. Kishor D. Jain & Anr. Notice of Motion (L) No 810 of 2019 in COMIP (L) No 383 of 2019	29-31
8.	Even if the Defendant's area of business and services are different and the plaintiff's trademark has not been registered in the Class listing the area; the plaintiff's mark, being a well-known mark.	Exxon Mobil Corporation v. Exxoncorp Private Ltd. CS (COMM) 111/2019	32-34
9.	When two independent rights of action may exist against a Defendant in a trademark infringement suit.	Thermax Limited vs Thermax Engineers Pvt Ltd CS(COMM) 157/2017	35-38
10.	Whether using similar trademarks along with distinct house marks generates enough distinctiveness to allow consumers to differentiate between the two products depends upon facts of the case and attendant circumstances.	Meso Private Ltd. v Liberty Shoes Ltd. & Ors. (Bombay High Court), 2019 SCC OnLineBom 1506	39-41
11.	In order to see whether a mark is deceptively similar, one has to look at the concept of priming as well as imperfect recollection.	Make My Trip (India) Private Limited v. Make My Travel (India) Private Limited, 2019 SCC OnLine Del 10638	42-44

M/S Khushi Ram Behari Lalvs M/S Jaswant Singh Balwant Singh

(2019) 258 DLT (CN 14) 14

PARTIES

- The Petitioner is a partnership firm trading as **M/S Khushi Ram Behari Lal** (Export Division) established in the year 1978 carrying on the business of processing, marketing and exporting of rice since 1978. They own the trademark 'TRAIN BRAND WITH DEVICE OF TRAIN' in relation to said goods and business and have been continuously using the same since 1978 up to the present time.
- The Respondent i.e. **M/S Jaswant Singh Balwant Singh** is also engaged in the same business of processing, marketing and exporting of rice.

BRIEF FACTS

- The petitioner firm was taken over as a going concern including its Trade Marks and other assets and properties by M/s. Khushi Ram Behari Lal Ltd. with effect from 1.4.1996 under an agreement. The partners of the petitioner firm were engaged as the directors of the incorporated company which as on date is carrying on the said business under the subject matter trademarks, hence, owing to the previous Partnership concern's name 'M/s Khushi Ram Behari Lal'; the petitioner and its successors changed their name to M/s. KRBL Ltd. The Petitioner, M/s Khushi Ram Behari Lal ("KRBL") hence, filed

an application for its registration in class 30 of the IV Schedule of the then Trade & Merchandise Marks Act, 1958 before the Registrar of trade marks on 11.10.1993.

- The respondent filed notice of opposition on 24.07.2000 objecting to the registration of the said Trade Mark in favour of the petitioner on the grounds *inter alia* that the respondent is engaged in the business of Rice under the Trade Mark "**TRAIN**" as well.
- The Registrar, on consideration of the Respondent's previously registered trade mark, dismissed Petitioner's Form TM-16(an application to request for correction of clerical error or for amendment) and refused the application for registration of the said trade mark.
- The Petitioner, aggrieved by the order, approached the IPAB which dismissed the appeal on the ground that the Respondents had adopted and registered the trade mark prior in point of time.

ISSUE

- Whether copyright registration is sufficient for proving the use of subject Trademark?

APPLICABLE RULES

- Section 12 in The Trade Marks Act, 1999¹³
- Section 18 in The Trade Marks Act, 1999

ARGUMENTS

¹³ Excerpts from the Bare Acts are attached at the end of the document for reader's ready reference.

- The petitioner contended that the order of the assistant registrar is contrary to law and facts of the case. The documents filed by the respondent are forged and fabricated.
- It was further alleged that the invoices of telephone number are doctored and forged.
- The respondent had pleaded before the Assistant Registrar to reject the impugned application outright as the applicant had failed to establish entitlement to trade mark. The Respondent has also secured copyright registration for the artistic label comprising the word & device of the trade mark under No.A-44877/84.

DECISION

- The Hon'ble court on perusal of the documents on record, said that the learned Appellate Board had relied on the Copy Right Registration of respondent under No. A44877/84. The Copy Right Registration of the art work of "TRAIN" brand is extraneous for the purpose of proving the use subject Trade Mark.
- The Hon'ble High Court hence, through this case, decreed that a Copyright Registration of the artwork of the brand "TRAIN" is immaterial for the purpose of proving the use of the subject trade mark. Some cases with similar issue before the Supreme Court were cited as Corn Products Refining Co. v. Shangrila Food Products Ltd¹⁴ and in case of Gandhi Scientific Company v. Gulshan Kumar¹⁵.

¹⁴ AIR 1960 SC 142

¹⁵ 2009 (40) PTC 22 (Del.)

Bigtree Entertainment Pvt Ltd vs D Sharma &Anr

2019(77) PTC 411(DEL)

PARTIES

- The Plaintiff, **Bigtree Entertainment** owns India's largest Online Ticketing portal "BookMyShow" Online since 2007, the business online ticketing for movies in cinemas like PVR, INOX, SPI and Justickets; sporting extravaganzas like IPL, ISL, IPTL and even music concerts like Sunburn, EVC all of who are official partners.
- The Defendants, **D. Sharma** owns a customized portal called BOOKMYEVENT that facilitates online ticketing for live concerts, musical nights, movies, corporate seminars, plays, theatre, etc.

BREIF FACTS

- The Plaintiff started using the mark "BOOKMYSHOW" in 2007 as a ticketing venture and had revenues of Rs. 150 Crores per year. Defendant was using "BOOKMYEVENT".
- Plaintiff filed a suit against the Defendant for infringement and passing off in respect of its trade mark "BOOKMYSHOW".
- The present matter decided Plaintiff's application for Temporary Injunction and Defendant's application for Vacation of Ex-parte order of Temporary Injunction.

ISSUE

- Whether the mark 'BOOKMY' has attained an exclusive meaning and whether the plaintiff can claim exclusive rights on the same.

APPLICABLE LAWS

- Section 17 in The Trade Marks Act, 1999

ARGUMENTS

- The Plaintiff pleaded to have acquired rights in the trade mark "BOOKMY" which the Plaintiff pleaded had become a prefix associated exclusively with the Plaintiff's brand and that the prefix 'BOOKMY' is an essential part of the Plaintiff's registered trade mark.
- The Plaintiff pleaded that the pre-fix in itself has acquired distinctiveness over a period of time due to open, continuous and extensive use. Plaintiff has filed various applications to consolidate its right in BOOKMYSHOW and BOOKMY trademarks which are pending.
- The Defendant pleaded that BOOKMY is a generic term used substantially in the industry and cannot be a subject matter of any trade mark.



DECISION

- The Court refused to award injunction in favour of the plaintiff.

- 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.



Crocs Inc. v. Bata India Ltd. and Others

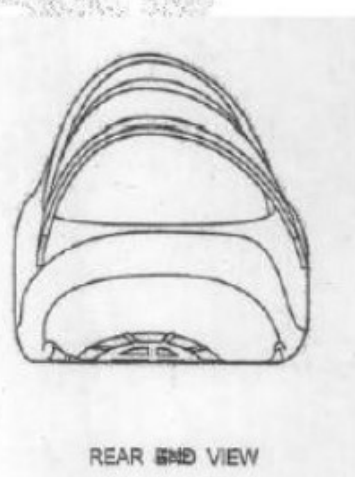
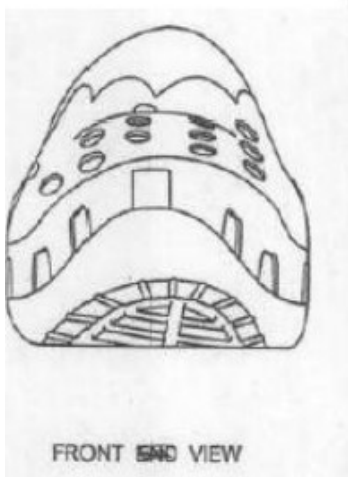
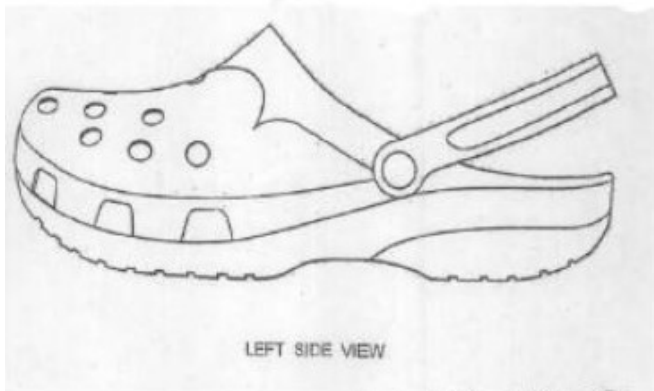
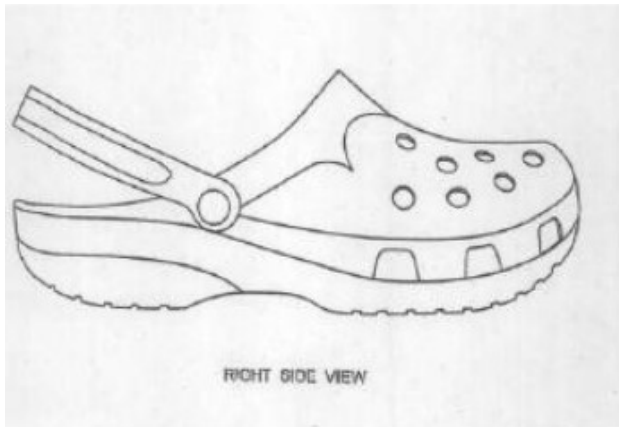
2019 SCC OnLine Del 6808

PARTIES

- The Appellate is **Crocs Inc**;
- The Respondents are, inter alia, **Bata India Ltd., Liberty Shoes Ltd., Action Shoes Pvt. Ltd., Aqualite India Ltd., Bioworld Merchandising India Ltd., Relaxo Footware Ltd., and Kidz Palace.**

BRIEF FACTS

- 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 of trademark which is an action in common law.
- It was settled by an earlier judgment of a 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.



ISSUE

- Whether a design can also function as a trademark?

APPLICABLE RULE

- Section 2(d), Designs Act, 2000

ARGUMENTS

- It was argued by the Defendants that if the passing off action 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.

DECISION

- 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 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

Tea Board, India v. ITC Limited

C.S. No. 250 of 2010

PARTIES

- The Plaintiff is **Tea Board of India** which is a state agency of the Government of India established to promote the cultivation, processing, and domestic trade as well as export of tea from India
- The Defendant is **ITC Ltd.** a multinational conglomerate company headquartered at Kolkata, West Bengal.

BRIEF FACTS

- The Tea Board of India filed a suit for trademark infringement against ITC Ltd. for using the name “Darjeeling” at one of its refreshment lounges, namely, “Darjeeling Lounge” at its Hotel in Kolkata.
- The Plaintiff filed a suit in the Calcutta High Court which was rejected by the Single Judge. The Division Bench of the Court also upheld the decision. On appeal to the Supreme Court, the Court directed the suit to return to the Calcutta High Court with an instruction for expeditious decision on pleadings and admitted material only. Hence, the present appeal lies before the Calcutta High Court.

ISSUES

- Has the plaintiff in lieu of its trademark registration acquired any right other than the authority to certify tea that originates from registered tea gardens in Darjeeling to use the name or logo “Darjeeling”?

- By using the name “Darjeeling” does the defendant falsely suggest that goods/services sold and catered to, owe their origin to Darjeeling or creates an impression that it operates under a license from the plaintiff?
- Is the “Darjeeling” logo protectable under Copyright Act as claimed by the plaintiff?

APPLICABLE RULES

- Section 2(c) of the Trade and Merchandise Marks Act, 1958
- Section 159(2) of the Trademark Act, 1999
- Section 69(c) of the Trademark Act, 1999
- Section 75 of the Trademark Act, 1999
- Section 78 of the Trademark Act, 1999
- Section 26(4) of the Geographical Indications Act

ANALYSIS

- The Court pointed out the fact that the plaintiff has not obtained a registration under Sections 18 and 23 of the Trademark Act, 1999. The registration was done under Chapter VIII of the Trade and Merchandise Marks Act, 1958.
- It looked into the definition of “certification trademark” under the 1999 Act and the 1958 Act and held that in lieu of Section 159(2) of the 1999 Act, the protection granted to the certification mark in question will only extend to goods and not services. Although the 1999 Act extends protection of certification mark to services as well, the Court

was of the opinion that 159(c) only provides a continuing effect and not an extension of the protection already granted under the old Act.

- The Court also looked into the plaintiff's own showing of the copy of the entry in the register of trademarks and held that it was apparent from the registry that the certification trademark of the plaintiff was only applicable in respect of goods and not services.
- The court pointed out that the right acquired by certification trademarks are limited as compared to regular trademarks and infringement of certification marks are covered under Section 75 unlike Section 29 which covers regular trademarks. In light of these observations the Court stated that the only right that has been granted to the plaintiff through the registration of trademark is to certify tea as "Darjeeling Tea". No right with respect to any service or in respect of the word "Darjeeling" has been granted to the plaintiff.
- The Court agreed with the contention of the defendant and held that the action of the plaintiff with respect to violations of the Geographical Indications Act is barred under Section 26(4) of the GI Act. The Court stated that it was apparent on the face of the records that the presentation of the plaint was made beyond the expiry of the 5 years period mandated by Section 26(4) of the Act.
- According to the Court, there was no substance in the allegations of passing off. The Court said that the plaintiff was not able to substantiate its allegations by way of leading cogent evidences either documentary or oral.

- Similarly, the Court stated that the plaintiff failed to substantiate its argument and prove that there was a dilution of either the registered Trademark or the Geographical Indication. Also, the Court could not find any substance in the argument of the plaintiff that the adoption, use and attempted registration of the trademark “Darjeeling Lounge” by the defendant was done in bad faith.
- The Court also pointed out to the fact that the parties were engaged in different industries and there was no competition between the two. Hence, the court ruled out the possibility of any unfair competition on the part of the defendant. It also reiterated the defendant’s case that only high-end guests accessed the lounge. These guests were generally educated and knowledgeable and thus, they were not likely to be confused or misled by the use of it. Therefore, it was adjudged by the Court that there was no dishonesty or any fraudulent act committed on the part of the defendant.
- With respect to the issue of copyright infringement as claimed by the plaintiff, the Court pointed out that there is no similarity between the certification trademark logo and the logo of the defendant. Thus the court held this issue to be irrelevant and redundant.
- The court concluded by saying that the suit was frivolous and dismissed it with a cost of Rs. One Lakh.

Intercity Hotel GMBH v. Hotel Intercity Delhi and Others

2019 SCC OnLine Del 7644

PARTIES

- The Plaintiff; **Intercity Hotel GMBH** is in the business of providing temporary accommodations with food and drinks.
- The Defendant **Hotel Intercity Delhi** is also in the business of providing temporary accommodation with food and drinks and is operating a hotel in Karol Bagh.

BRIEF FACTS

- Plaintiff's trademark INTERCITYHOTEL is registered in multiple jurisdictions, dating as far back as 1992 in Germany. In India, it was registered in the year 2011, in class 43 – temporary accommodation providing food and drink. The plaintiff also has the registered device mark for the same.
- The defendant is using the trade mark 'HOTEL INTERCITY DELHI' in respect of his hotel in Karol Bagh.
- The defendant has been using the trademark in India since 2010.
- The plaintiff, on the other hand, had applied for registration on 20-05-2011 as a proposed user. Admittedly, more than five years elapsed and the plaintiff did not use the trade mark in India. Evidently, no hotel or

any similar establishment was set up by the plaintiff in India to make use of the said trade mark.

- Effectively, the only ground on which the plaintiff is claiming protection of his trade mark is that it has acquired a global reputation and goodwill in light of plaintiff's 37 hotels abroad.

ISSUES

- Whether a trade mark is to be governed by the principle of territoriality or by the doctrine of universality?
- Whether the plaintiff is entitled to seek an interim injunction despite not having commenced business in India using the registered trademark?

APPLICABLE RULE

- Section 34 of the Trademarks Act, 1999

ARGUMENTS

- The plaintiff argued that even though they had not commenced business in India under the registered trademark, in light of their global reputation and goodwill, defendants should be stopped from using the deceptively similar trade mark.
- The defendant claimed to be a prior user of the said trademark.

DECISION

- The Hon'ble High Court of Delhi referred to a number of Supreme Court judgments and concluded that it is necessary to inspect whether there has been any spill-over of the global goodwill and reputation within the relevant geographical territory.
- The Hon'ble Court noted that the plaintiff had failed to show any spill-over of the global reputation in India. No details or evidence was adduced with regard to advertisement and promotion done in India.
- The Hon'ble Court held that in light of the above, balance of convenience did not favor the plaintiff and hence no injunction can be granted.
- In the interests of justice however, the Court ordered the defendant to declare on their website that defendant hotel is in no manner associated with Intercity Hotel GMBH, Frankfurt, Germany.

Christian Louboutin SAS v. Abu baker&Ors

RFA (OS)/(COMM) 13/2018 & CM 29064/2018

PARTIES

- The Plaintiff (appellant) **Christian Louboutin Sas** is a shoe manufacturing company bearing a 'Red sole' trademark.
- The defendants **Abu Baker** are associated with the similar business and carrying on its business at two outlets in Mumbai. The defendant no.3/entity M/s Veronica is owned by the defendant nos.1 and 2.

BRIEF FACTS

- The Plaintiff's, "RED SOLE" trademark has been registered in Clause 25 with No. 1922048 in respect of the shoes, except orthopaedic footwear, with the sole condition and disclaimer that "the mark shall be limited to the colour "Red".
- The plaintiff conducted a market survey and found out that, the defendants use plaintiff's "Red Sole" trademark on its ladies shoes. Thus, the plaintiff filled a suit against defendant for a permanent injunction to restrain the Defendants from infringing the Plaintiff's trademark, passing off, unfair competition, dilution and tarnishment, apart from damages, rendition of accounts of profits and delivery up etc.
- The same suit was dismissed by the learned single judge. Hence, plaintiff appealed in high court against the judgment of learned single judge.

ISSUES

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

APPLICABLE RULES

- Order XII Rule 6 CPC Judgment on admissions.
- Section 30(2)(a) in The Trade Marks Act, 1999
- Section 31 in The Trade Marks Act, 1999
- Sections 2(m) and 2(zb) of the Trade Marks Act, 1999

ARGUMENTS

- The Plaintiff has explained that the aforementioned "RED SOLE" trademark is in fact a device mark wherein a specific tone of red colour is applied to the outsole of a shoe and "is unique in its own accord and became known in the world of fashion only after being introduced by the Plaintiff".
- The plaintiff further averred that "the trademark, being an innovation of the Plaintiff, is used and known only in relation to the Plaintiff and goods of the Plaintiff only".
- The claim of the Plaintiff is that "due to its uniqueness and since the said trademark is the central and quintessential element of the goods of the Plaintiff, the Plaintiff considers this intellectual property is incredibly valuable and has expended a significant amount of resources on securing registrations and protecting the 'RED SOLE' trademark".

- The plaintiff further claims that the “RED SOLE” trademark is internationally recognizable and has extensive usage in India; the 'RED SOLE' trademark enjoys trans-border reputation in India; the goodwill and renown of the 'RED SOLE' trademark has spilled over into India from various countries and that the consumers are well aware of this goodwill and reputation even before the Plaintiffs trademark was first formally launched in India.

DECISION

- According to the court, the finding of the Single Judge that a single colour cannot be claimed as a trademark was not something that could be finally determined *suo motu* by the court at the very first hearing of the suit, particularly in view of the fact that under Section 31 there was a *prima facie* presumption of validity of the plaintiff's trademark. Moreover, whether the plaintiff's trademark was unique or validly registered in favour of the plaintiff could not be definitely concluded by the Single Judge at the first stage of the suit.
- Whether the plaintiff's claim that its trademark was not a single colour trademark, but qualified as a device mark consisting of an arbitrary placement of a particular shade of the colour red at a specific part of a shoe, according to the court, had to be tested further by the court on the basis of pleadings and evidence.

Nippon Steel & Sumitomo Metal Corporation v. Kishor D. Jain &

Anr.

PARTIES

- The Plaintiffs are **Nippon Steel & Sumitomo Metal Corporation** is a large steel producing company.
- The Defendants **Kishor D. Jain** who is involved in the business of trading in steel.

BRIEF FACTS

- The plaintiff in the present case filed a suit for permanent injunction against the defendants from using its trademark. The suit was filed on the basis of a complaint that the plaintiff received from a steel company in Saudi Arabia, which brought to the notice of the plaintiff that the defendants have been selling carbon pipes bearing the plaintiff's trademark and logo, falsely representing the same to be emanating from the plaintiff.
- On further enquiry it was found that the supplies of the defendants were accompanied by fabricated inspection certificates issued in relation to the counterfeited goods.

ISSUE

- Whether the acts of the defendants make them liable for counterfeiting the plaintiff's trademark under the Trademarks Act, 1999?

APPLICABLE RULES

- Section 102 of the Trademark Act, 1999
- Section 103 of the Trademark Act, 1999.

ARGUMENTS

- On such allegations of counterfeiting products by the plaintiff, the Court appointed receivers to visit the premises of the defendants and report on their activities.
- The reports of the receivers showed the defendants possessing several inspection certificates and a large quantity of branded and unbranded pipes in their premises.
- The defendants submitted that after receiving pipes from the supplier, they had put the plaintiff's logo on the pipes and thereafter had the inspection certificates fabricated so as to falsely represent that the goods originated from the plaintiff.
- The plaintiff submitted that the goods in question are used in the oil industry and may result in dreadful accidents if they are fake and do not meet the required standards. The plaintiff also submitted that such acts of counterfeiting by the defendants, in addition to causing serious damage to the goodwill of the company, bring disrepute to the reputation of the country. On the basis of its submissions, the plaintiff pleaded before the Court to impose heavy and unprecedented cost on the defendant.
- The Court took into consideration the fact that the goods in question are used for extremely sensitive purposes and non satisfaction of the

safety requirements of such products were bound to have “disastrous consequences”.

DECISION

- In view of this fact the Court took the stand to set an example and imposed a cost of five crore Rupees (5,00,00,000/-) on the defendants to act as a deterrent factor for all such entities undertaking counterfeiting activities. In addition to the heavy cost, the Court also ordered the defendants to furnish a personal undertaking stating that it would communicate with all the entities to which it supplied the counterfeited products and that it would also publish a Caution Notice in Saudi Arabia where the importer’s business is located.
- The Bombay High Court took cognizance of the fact that industries are extremely sensitive areas and apparatus that does not meet safety requirements may result in dreadful consequences; and hence, in order to set a deterrent for all such entities engaging in the selling of counterfeiting products, took strict penal action in the form of a heavy cost.

Exxon Mobil Corporation v. Exxoncorp Private Ltd.

CS (COMM) 111/2019

PARTIES

- The Plaintiff **Exxon Mobil Corporation**, is in the business of gas exploration, oil production, refinery and various other fields primarily related to petroleum, chemical and oil industry.
- The Defendant **M/s Exxoncorp Technology Solutions** runs a comparatively small business through its website which primarily concerns providing IT services.

BRIEF FACTS

- The plaintiff has filed a suit for trademark infringement and passing off against the defendant. On account of protecting its trademark “EXXON”, the plaintiff has previously filled a deluge of such similar suits in various High Courts and have successfully restrained a number of similar/identical trademarks.
- It is also pertinent to keep in mind that the plaintiff has no trademark registered in “Class 42” which deals with IT services.

ISSUE

- Whether a trademark can infringe another trademark when the area of business and services are different?

APPLICABLE RULE

- Section 2(1)(zg) of Trade Marks Act, 1999

ARGUMENTS

- The Defendants argued that the use of word “EXONCORP” was done as a whole along with a logo derived from a DNA structure and with the phrase ‘technology solutions’ underneath. They contended that these features made the defendant’s mark entirely different from that of the plaintiff’s, which removed any possibility of deceptive similarity.
- They also contended that the defendant’s area of business and services were different and the plaintiff’s trademark was not registered in Class 42 which deals with IT services.

DECISION

- According to the Court, the question of deceptive similarity was not a factual issue. It said that despite the difference in the logo, the word marks (“EXXON” & “EXON”) were almost identical and did not rule out the chances of confusion. In reply to the defendant’s anti dissection argument, the Court said that adding the word “CORP” after “EXON” in fact added to the confusion.
- Finally, with respect to the argument that the defendant’s area of business and services were different and the plaintiff’s trademark was not registered in Class 42 which deals with IT services, the Court was of the opinion that the plaintiff’s mark was a well-known mark and in lieu of Section 2(1)(zg) of the Trade Mark Act the plaintiff’s mark was

liable to be protected even if the mark was used in respect of other goods or services for which it may not be registered.

- The Court relied on the case of Exxon Mobil Corporation & Anr. V. Ankit Sukhuja¹⁶ which was one of the many judgments where the plaintiff's mark – "EXXON" had been declared as a well-known mark. The Court also noted that the nature of IT services in the present day were such that the same were used in every field and the plaintiff also had a technology company providing IT services. Thus, the Court ruled against the defendant's stand that the services were distinct and different from that of the plaintiff.

¹⁶ CS(OS) No. 2078 of 2015

Thermax Limited vs Thermax Engineers Pvt Ltd

CS(COMM) 157/2017

PARTIES

- The Plaintiff **Thermax limited** is a company involved in the business of installation, ducting, fitting, repairing and maintenance of air conditioners and refrigerators, technical consultation, engineering services etc.
- The Defendant is a company named **Thermax Engineers** involved in the same business as that of plaintiff. Their businesses are almost identical.

BRIEF FACTS

- The Plaintiff - Thermax Limited has filed the present suit seeking permanent injunction restraining infringement of trade mark and trade name, passing off, etc. in respect of its trade name 'THERMAX'. The case of the Plaintiff is that it had coined and adopted the mark 'THERMAX' in 1974 and the same is being used as a trademark, house mark and is also a distinctive and prominent mark of its corporate name and
- In May 2014, the Plaintiff came to know that the Defendant had started using the corporate name 'Thermax Engineers Pvt. Ltd'. Further enquiries revealed that the company was incorporated on 30th October, 2012 with the Registrar of Companies, Delhi. Its

Memorandum and Articles of Association explain its business areas as being almost identical to that of the Plaintiff. Hence, the plaintiff has filled suit seeking permanent injunction infringement of trademark and trade name.

ISSUE

- Whether a company can be registered by a name which is similar to the name of a company already existing and registered?

APPLICABLE RULES

- Section 29 in The Trade Marks Act, 1999
- Section 20 in The Companies Act, 1956

ARGUMENTS

- According to the Plaintiff, Defendant's use of the word 'THERMAX' as their corporate name is violating its statutory rights under the Trademark Act, 1999 as the mark 'THERMAX' is a well-known mark.
- The contention of the plaintiff's counsel is that the use of the identical name and corporate name which forms part of the trade mark THERMAX, which is a registered trade of the plaintiff, is amounting to infringement of trade mark and passing off. He states that it is a well-known trade mark. The same is protected under Section 29(4) of the Act. Therefore, the said trade mark is protected in relation to the dissimilar goods

- The Defendant shows that the primary defence raised therein is that the Defendant has been able to secure registration by the ROC and hence it is entitled to use the same. The Defendant has relied upon the provisions of the Companies Act, 1956 to state that since the ROC is expected to look into any objectionable name, the grant of registration shows that the ROC has conducted its due diligence before grant of registration of the corporate name.

DECISION

- The Hon'ble Court held that Section 20 of the Companies Act, 1956 provides that no company will be registered by a name which is similar or identical or too nearly resembles the name by which a company in existence has been previously registered. In case where a company has been incorporated with a name which is identical or too nearly resembles the name of a company which has been previously incorporated, Section 22 makes a provision for getting the name of the former altered.
- No doubt, Section 22 makes provision for rectification of the name of a company which has been registered with undesirable name but that does not mean that the common law remedy available to an aggrieved party stands superseded.
- The plaintiff will have two independent rights of action against the defendant who may be using the corporate name of a previously incorporated company, one under Section 22 of the Companies Act and the other for injunction restraining the defendant from using the

corporate name of the plaintiff or from using a name bearing a close resemblance which may cause or which is likely to cause confusion in the minds of the customers or general public in view of the similarity of names.

- The Plaintiff is entitled to a permanent injunction against the Defendant from use of the word/mark THERMAX. None of the other reliefs are pressed. Since the Defendant had agreed to give up the mark at an early stage of the proceedings, costs of Rs.1 lakh are awarded to the Plaintiff.

Meso Private Ltd. v Liberty Shoes Ltd. &Ors. (Bombay High Court)

2019 SCC OnLineBom 1506

PARTIES

- The Plaintiff, **MESO Private Ltd.** is a company engaged in the business of manufacturing and exporting perfumes and other similar class of goods.
- Defendant no. 1 is **Liberty Shoes Ltd.** that has been in the business of manufacturing and selling shoes and similar goods since 1954.
- Defendant no. 2, **Liberty Lifestyle** is not a distinct legal entity, but a brand introduced by the Liberty Group.

BRIEF FACTS

- Both 'Legend' and 'Flirt' are registered trademarks in respect of soaps, essential oils, cosmetics, perfumery etc. The marks were registered in the years 1988 and 1994, respectively.
- The Plaintiff Company (MESO) was assigned the trademarks 'Legend' and 'Flirt' in the years 2019 and 2016, respectively.
- MESO has been marketing and selling perfumes named Legend and Flirt under the house mark/ brand name Devon.
- Liberty Group announced the launch of its own perfumes called 'Legend' and 'Flirt' to be sold under the brand name Liberty.

- MESO filed for an injunction against the use of the said trademarks by Liberty in relation to its perfumes. The said injunction was granted by the learned Single Judge who held that a prima facie case was made out in the favor of MESO as it had the statutory rights in respect of the said marks and the rival marks were deceptively similar and were being used in respect of same category of goods.
- The ex-parte injunction was vacated upon Liberty's application.
- The present appeal has been filed by MESO against the order vacating the said injunction.

ISSUE

- Whether the use of house name along with the registered mark negate the likelihood of confusion?

APPLICABLE RULE

- Section 29(2)(c) of the Trade Marks Act, 1999

ARGUMENTS

- MESO's primary contention was that, it being the registered proprietor of the marks, prima facie case against Liberty was clearly made out and that they were registered in the year 1988 and 1994 respectively and it is not Liberty's claim that it has prior use.

DECISION

- The Hon'ble Court held that whether use of house mark along with a trademark established enough distinction to avoid any likelihood of confusion depends on the facts and circumstances of the case. These include, mode of purchasing, class of consumers, attendant circumstances, and the extent of similarity.
- In the instant case, the Hon'ble Court observed, the above question was being raised at an interim stage. The Court looked at the product-wrappers of both the perfumes. The respective house marks and trademarks were printed on the same side of the bottled. Therefore, effectively, the goods were being sold as Liberty Flirt, Liberty Legend, Devon Flirt, and Devon Legend.
- In view of the above, the Court accepted Liberty's contention that the use of Legend and Flirt along with its house name will not cause confusion regarding the products.

**Make My Trip (India) Private Limited v. Make My Travel (India) Private
Limited**

2019 SCC OnLine Del 10638

PARTIES

- The Plaintiffs is **Make My Trip (India) Private Ltd.** which was incorporated in the year 2000 and changed its trade-name to the present name in the year 2002.
- The Defendant is **Make My Travel (India) Private Ltd.** in the present case.

BRIEF FACTS

- The Plaintiff, Make My Trip (India) Private Limited, is one of the largest travel companies in India. Over the years, expanding its services beyond online travel bookings, the Plaintiff has ventured into offering its services through its website and application-based online platforms.
- The plaintiff seeks a permanent injunction against the defendant, Make My Travel (India) Private Limited, wherein the Defendant is prevented from using:
 - a. the MAKE MY TRAVEL word mark, the MMT word mark and the 'Dreams Unlimited' tagline;
 - b. the MAKE MY TRAVEL logo; and
 - c. the website at 'www.makemytravelindia.com' (collectively referred to as the 'impugned marks').

ISSUES

- What amounts to acquiescence in the case of a company with many employees working at different levels?

APPLICABLE RULE

- Section 33 of the Trademarks Act, 1999

ARGUMENTS

- It is the plaintiff's case that defendant's marks are deceptively similar to the plaintiff's. The first two words are the same and the last word conveys the same meaning.
- The defendant argues that the case is barred by virtue of Section 33 of the Trademarks Act, 1999, as the plaintiff and its officials were aware that the defendant was incorporated as Make My Travel (India) Private Ltd. and carrying out its business since 2011. Various email exchanges between the office-bearers of the two companies between 2011-2017 point towards the fact of acquiescence. This is in addition to the fact that the two companies are part of same industry organizations where their names have appeared alongside each other in the list. Furthermore, between the years 2011 and 2017, various bank-transactions have taken place between the two companies. Similarly, the plaintiff has also acquiesced to the use of the tag line "Dreams Unlimited" by the defendant. Finally, the mark MMT was adopted by the plaintiff much later, during 2015-2016, whereas the defendant had been using it since 2011.

- The plaintiff further contends that the said email-exchanges were between plaintiff's franchisee-holders and the defendant and did not involve anybody in a managerial capacity from the plaintiff's side. Similar argument was led with regard to the bank-transactions.

DECISION

- With regard to the defendant's submission concerning acquiescence, the Court observed that prima facie, the plaintiff's plea that the said correspondence did not involve persons in key-managerial positions seems tenable, especially since the defendants had not brought the said emails on record. Any further examination of this point, the Court observed, would require a trial.
- The court ordered that the injunction shall be made absolute and continue to operate during the pendency of the suit, as the prima facie case and the balance of convenience lies in the favor of the plaintiff, as it will suffer irreparable loss if the defendant is not restrained from using the said marks.

-DISCLAIMER-

It is to be noted that the above illustration is provided to the reader for reference and understanding. It does not constitute legal opinion in any manner whatsoever.

While summarizing portions of judgments, maximum and honest effort has been taken to maintain the same effect and interpretation of the summarized text. However, due to linguistic, grammatical and expressive deviations from the original text required for the summary, interpretation and effect may not be absolutely congruent.

References used for judgments for the purpose of this document, were reliable and ordinarily known to be accurate and it is believed that information provided therein is true to the best of our knowledge. The logos, imagery and illustrations attached in the document too, are obtained off the public domain and to the best of our knowledge through reliable secondary sources. If however, there is any discrepancy or inaccuracy therewith, Khurana and Khurana disclaims any liability thereto, but invites the readers to highlight the same so that it can be checked and if relevant, rectified in this document.

I. Section 12 of The Trade Marks Act, 1999

12. Registration in the case of honest concurrent use, etc.—In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

II. Section 18 of The Trade Marks Act, 1999

18. Application for registration.—

(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark.

(2) A single application may be made for registration of a trade mark for different classes of goods and services and fee payable therefor shall be in respect of each such class of goods or services.

(3) Every application under sub-section (1) shall be filed in the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the applicant or in the case of joint applicants the principal place of business in India of the applicant whose name is first mentioned in the application as having a place of business in India, is situate: Provided that where the applicant or any of the joint applicants does not carry on business in India, the application shall be filed in

the office of the Trade Marks Registry within whose territorial limits the place mentioned in the address for service in India as disclosed in the application, is situate.

(4) Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit.

(5) In the case of a refusal or conditional acceptance of an application, the Registrar shall record in writing the grounds for such refusal or conditional acceptance and the materials used by him in arriving at his decision.

Absolute grounds for refusal of registration.—

(1) The trade marks—

(a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;

(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;

(c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade, shall not be registered: Provided that a trade mark shall not be refused registration if before the date of application for

registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

(2) A mark shall not be registered as a trade mark if—

(a) it is of such nature as to deceive the public or cause confusion;

(b) it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;

(c) it comprises or contains scandalous or obscene matter;

(d) its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950).

(3) A mark shall not be registered as a trade mark if it consists exclusively of—

(a) the shape of goods which results from the nature of the goods themselves;
or

(b) the shape of goods which is necessary to obtain a technical result; or

(c) the shape which gives substantial value to the goods. Explanation.—For the purposes of this section, the nature of goods or services in relation to which the trade mark is used or proposed to be used shall not be a ground for refusal of registration.

III. Section 17 of The Trade Marks Act, 1999

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark-

(a) Contains any part--

(i) Which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) Which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered."

IV. Section 2(d) of the Designs Act, 2000

"design" means "only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined" which in the finished article appeal to and are judged solely by the eye; but "does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958...or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957 (14 of 1957)" Section 4 prohibits registration of certain categories of designs (what is (a) is not new or original; or "(b) has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the

filing date, or where applicable, the priority date of the application for registration;”

or “(c) is not significantly distinguishable from known designs or combination of known designs;”

V. Section 2(c) of the Trade and Merchandise Marks Act, 1958

" certification trade mark" means a mark adapted in relation to any goods to distinguish, in the course of trade, goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified and registrable as such under the provisions of Chapter VIII in respect of those goods in the name, as proprietor of certification trade mark, of that person;

VI. Section 159(2) of the Trademark Act, 1999

(2) Without prejudice to the provisions contained in the General Clauses Act, 1897 (10 of 1897), with respect to repeals, any notification, rule, order, requirement, registration, certificate, notice, decision, determination, direction, approval, authorisation, consent, application, request or thing made, issued, given or done under the Trade and Merchandise Marks Act, 1958 (43 of 1958) shall, if in force at the commencement of this Act, continue to be in force and have effect as if made, issued, given or done under the corresponding provisions of this Act.

VII. Section 75 of the Trademark Act, 1999

The right conferred by section 78 is infringed by any person who, not being the registered proprietor of the certification trade mark or a person authorised by him in that behalf under the regulations filed under section 74, using it in accordance therewith, uses in the course of trade, a mark, which is identical with, or deceptively similar to the certification trade mark in relation to any goods or services in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken as being a use as a trade mark.

VIII. Section 78 of the Trademark Act, 1999

Rights conferred by registration of certification trade marks.—

(1) Subject to the provisions of sections 34, 35 and 76, the registration of a person as a proprietor of certification trade mark in respect of any goods or services shall, if valid,

give to that person the exclusive right to the use of the mark in relation to those goods or services.

(2) The exclusive right to the use of a certification trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

IX. Section 26(4) of the Geographical Indications Act

X. Section 34 of the Trademarks Act, 1999

Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior-

(a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his, or

(b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his.

Whichever is the earlier, and the Registrar shall not refuse (on such use being proved), to register the second mentioned trade mark by reason only of the registration of the first mentioned trade mark.

XI. Section 29(2)(c) of the Trade Marks Act, 1999

Infringement of registered trade marks.-- (1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of--

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

XII. Section 33 of the Trademarks Act, 1999.

(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark—

(a) to apply for a declaration that the registration of the later trade mark is invalid, or

(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later trade mark was not applied in good faith.

(2) Where sub-section (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark, or as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark may no longer be invoked against his later trade mark.

XIII. Order XII Rule 6 CPC Judgment on admissions.

(1) Where admissions of fact have been made either in the pleading or otherwise, whether orally or in writing, the court may at any stage of the suit, either on the application of an party or of its own motion and without waiting for the determination of any other question between the parties, make such order or give such judgment as it may think fit, having regard to such admissions.

(2) Whenever a judgment is pronounced under sub-rule (1) a decree shall be drawn up in accordance with the judgment and the decree shall bear the date on which the judgment was pronounced."

XIV. Section 30(2)(a) of The Trade Marks Act, 1999

The use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services

XV. Section 31 of The Trade Marks Act, 1999

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under section 57), the original registration of the trade mark and of all

subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the validity thereof.

(2) In all legal proceedings as aforesaid a registered trade mark shall not be held to be invalid on the ground that it was not a registrable trade mark under section 9 except upon evidence of distinctiveness and that such evidence was not submitted to the Registrar before registration, if it is proved that the trade mark had been so used by the registered proprietor or his predecessor in title as to have become distinctive at the date of registration.

XVI. Sections 2(m) and 2(zb) of the Trade Marks Act, 1999:

(m) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;

(zb) "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and—

(i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to

use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;

XVII. Section 102 of the Trademark Act, 1999

Falsifying and falsely applying trade marks.—

(1) A person shall be deemed to falsify a trade mark who, either,—

(a) without the assent of the proprietor of the trade mark makes that trade mark or a deceptively similar mark; or

(b) falsifies any genuine trade mark, whether by alteration, addition, effacement or otherwise.

(2) A person shall be deemed to falsely apply to goods or services a trade mark who, without the assent of the proprietor of the trade mark,—

(a) applies such trade mark or a deceptively similar mark to goods or services or any package containing goods;

(b) uses any package bearing a mark which is identical with or deceptively similar to the trade mark of such proprietor, for the purpose of packing, filling or wrapping therein any goods other than the genuine goods of the proprietor of the trade mark.

(3) Any trade mark falsified as mentioned in sub-section (1) or falsely applied as mentioned in sub-section (2), is in this Act referred to as a false trade mark.

(4) In any prosecution for falsifying a trade mark or falsely applying a trade mark to goods or services, the burden of proving the assent of the proprietor shall lie on the accused.

XVIII. Section 103 of the Trademark Act, 1999.

Penalty for applying false trade marks, trade descriptions, etc.—Any person who—

- (a) falsifies any trade mark; or*
- (b) falsely applies to goods or services any trade mark; or*
- (c) makes, disposes of, or has in his possession, any die, block, machine, plate or other instrument for the purpose of falsifying or of being used for falsifying, a trade mark; or*
- (d) applies any false trade description to goods or services; or*
- (e) applies to any goods to which an indication of the country or place in which they were made or produced or the name and address of the manufacturer or person for whom the goods are manufactured is required to be applied under section 139, a false indication of such country, place, name or address; or*
- (f) tampers with, alters or effaces an indication of origin which has been applied to any goods to which it is required to be applied under section 139; or*
- (g) causes any of the things above-mentioned in this section to be done, shall, unless he proves that he acted, without intent to defraud, be punishable with imprisonment for a term which shall not be less than six months but which may extend to three years and with fine which shall not be less than fifty thousand rupees but which may extend to two lakh rupees: Provided that the court may, for adequate and special reasons to be mentioned in the judgment, impose a sentence of imprisonment for a term of less than six months or a fine of less than fifty thousand rupees.*

XIX. Section 2(1)(zg) of Trade Marks Act, 1999

“well-known trade mark”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be

likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.

XX. Section 29 in The Trade Marks Act, 1999

29. Infringement of registered trade marks.—

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(c) imports or exports goods under the mark; or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.

XXI. Section 20 in The Companies Act, 1956

20. Companies not to be registered with undesirable names.

(1) No company shall be registered by a name which, in the opinion of the Central Government, is undesirable.

(2) Without prejudice to the generality of the foregoing power, a name which is identical with, or too nearly resembles, the name by which a company in existence has been

previously registered, may be deemed to be undesirable by the Central Government within the meaning of sub- section (1).