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A Holistic Compendium
Highlighting Key Trade Mark Litigation Cases
For 2020

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A Holistic Compendium: Indian Trade Mark Cases Summary for 2020

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PREFACE

Indian Trade Mark jurisprudence saw a sea of developments and critically weighed judgements in the year 2020 which re-iterated old principles as well as new. With a notable increase in the number of IP litigations, Indian Judiciary; especially Delhi High Court, made an 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 re-iterated certain key principles of Trademark jurisprudence. 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 said prior use is sufficiently proven.
- The Hon'ble Court Opined that under the guise of educating the general public, one cannot make false claims against a product. Social media users should behave at the highest responsibility if they command a crowd.
- In cases wherein a difference in which marks are deceptively similar, the judge has to place himself as a consumer to assess whether he would be likely to be deceived.
- No trademarks for common words that are generic or descriptive in nature in respect of goods and services for they are meant to be used.

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LIST OF IMPORTANT CASES ON TRADEMARKS - 2020

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3	To check whether a mark is creating confusion or not, it has to be assessed through the eyes and ears of the consumer.	Rajesh Kumar Agarwal and Ors. v. Sanjay Gupta CS No. 101 of 2019	08
4	Any logo deceptively similar to the plaintiff's mark will amount to infringement	Puma Se v. Mr. Vikas Jindal CS NO.552/2019	09
5	Phonetic similarity will amount to infringement of the trademark.	Imagine Marketing Pvt. Ltd. v. Exotic Mile CS(COMM) 519/2019	10
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11	Trademarks and the reputation and goodwill enjoyed by said Trademarks, is not restricted merely to India but is global	HT Media Limited and Ors. vs. Brainlink International Inc. and Ors CS (COMM) 119/2020	16
12	Cannot escape liability on the ground of being an intermediary	Jagran Prakashan Ltd. vs. Telegram FZ LLC & Ors CS(COMM) 146/2020	17
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15	Merely because the DSGs are notified in the Gazette, they do not attain the status of “law” within the meaning of Article 13 of the Constitution.	Amazon Seller Services Pvt. Ltd. & Ors. v. Amway India Enterprises Pvt. Ltd. & Ors. FAO(OS) 133/2019	22
16	What should or should not be suspended could be arrived at only by assessing and balancing rival merits.	Hindustan Unilever v. Endurance Domain and Ors. 202 SCC Online Bom 809	24
17	Using fake website of a reputable brand does not cause loss to the brand only, consumers also suffer irreparable loss.	Gujarat Cooperative Milk Marketing Federation Ltd. & Anr vs. Amul Franchise.in &Ors CS(Comm) 350/2020	25
18	To obtain a quia timet injunction the Plaintiff must be able to show considerably more sufficient material.	Plex, Inc v. Zee Entertainment Enterprises Limited 2020 SCC OnLine Bom 989	26
19	The registration of a trademark in a particular class is only limited to the goods and services for which it is registered and used and not for the entire class.	Mittal Electronics v. Sujata Home Appliances (P) Ltd & Ors CS(Comm) 60/2020	27

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1

Nike Innovate C.V v. G.B. Shoe and Ors.
CS (Comm) No.542/19 | Decided on - 22.01.2020

PARTIES

- The Plaintiff, **Nike Innovate** is a shoe manufacturing company originally based in the USA
- The Defendants, **G. B. Shoe** is also a shoe manufacturing company registered in Agra

BRIEF FACTS

- Plaintiff has reason to believe that defendants, who are involved in the manufacturing and sale of shoes and other allied/cognate goods, are using the trademarked 'NIKE' and '**Swoosh**' design in relation to their own products.



Plaintiff's Mark



Defendant's Mark

ISSUE

- Whether the defendant has infringed or passed off the plaintiff's trademark?
- Whether the plaintiff is entitled to any damages?

APPLICABLE RULES

- Section 29 of The Trade Marks Act, 1999
- Section 134 of The Trade Marks Act, 1999
- Section 135 of The Trade Marks Act, 1999
- Section 35 of The Copyrights Act, 1957

14

RATIO

- Relying on the proof and documentation submitted by the designated local commissioner, the Court found that the adoption and use of the mark by the defendants produce unjust enrichment by the creation of confusion and deception in consumer minds. In addition, the Court ordered the defendants to pay Nike Rs. 50,000 each as damages.

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

14 AIR 1960 SC 142

15 2009 (40) PTC 22 (Del.)

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2

Lacoste S.A v. Suresh Kumar Sharma
CS (Comm) No.534/19 | Decided on 13.02.2021

PARTIES

- The Plaintiff is **Lacoste S.A.** is a French company, founded in 1933 by. It sells clothing, footwear, sportswear, eyewear, leather goods, perfume, towels, and watches.
- The Defendant is **Suresh Kumar Sharma.**

BRIEF FACTS

- The plaintiff, a major clothing brand from France had reason to believe that the defendant, in Delhi, was selling T-Shirts with trademarked logo and name of 'Lacoste' and the alligator.



Plaintiff's Mark

ISSUE

- Whether the defendant has infringed or passed off the plaintiff's trademark?

APPLICABLE RULES

- Section 29 of The Trade Marks Act, 1999
- Section 135 (2)(c) of The Trade Marks Act, 1999

RATIO

- The court held that the adoption and use of the mark by the defendant give rise to unjust enrichment by the creation of confusion and deception in consumer minds.

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3

Rajesh Kumar Agarwal and Ors. v. Sanjay Gupta
CS No. 101 of 2019 | Decided on 22.01.2020

PARTIES

- The Appellate is **Rajesh Kumar Agarwal**
- The Respondent is **Sanjay Gupta**

BRIEF FACTS

- The parties entered into a partnership for vegetarian catering under the name of 'Ganpati Enterprises' borrowed from the plaintiff's pre-existing business. However, later the defendant resigned and a deed of retirement was executed. The result of this was that the plaintiff's owned the exclusive right to use the trademark 'Ganpati Enterprises'. However, the defendant continued to keep using the name for his own business as 'Ganpati Sanjay'

ISSUE

- Whether the defendant has infringed or passed off the plaintiff's trademark?

APPLICABLE RULE

- Section 29 of The Trade Marks Act, 1999.
- Section 30(1)(b) of the Trade and Merchandise Marks Act, 1958.

RATIO

- The court here reiterated the following: *'to assess whether a projection, as to whether the mark complained of, is likely to deceive or cause confusion, it has to be assessed through the eyes and ears of the prospective user of the goods or services. The Judge has to place himself in the position of a prospective customer and assess whether he would then be likely to be deceived or confused.'*
- Since both parties operate in the same field of vegetarian catering and the same locality in Kolkata, the court held the marks to be deceptively similar and a grant of injunction was provided to the plaintiffs.

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4

Puma SE v. Mr. Vikas Jindal
CS NO.552/2019 | Decided on 13.02.2020

PARTIES

- The Plaintiff; Puma, a Germany based multinational corporation is famous for manufacturing sophisticated sportswear and athletic shoes. Plaintiff company has registered trademark PUMA. It has also its PUMA logo. This company has established a history of making fast product designs for the fastest athletes. This company is engaged in a wide range of products, interalia, sports, shoes, apparel, and accessories including tracksuits, t shirts, shorts, polo shirts, socks, ladies purse, bags, and other accessories.
- The Defendant Mr. Vikas Jindal, Proprietor of Jindal Belts 133137D, Caliber Plaza, AC Market, Opposite Bahadur House, Ludhiana

BRIEF FACTS

- The plaintiff, a famous German company, had reason to believe that the defendant was using its trademark 'PUMA' and its logo. By this misrepresentation, the defendant gained an unfair advantage.



Plaintiff's Mark

ISSUE

- Whether the defendant has infringed or passed off the plaintiff's trademark?

APPLICABLE LAWS

- Section 34 of the Trademarks Act, 1999
- Section 29 of the Trademarks Act, 1999

RATIO

- The court, in the absence of a response from the defendant, passed an ex-parte order of permanent injunction based on the evidence submitted by the plaintiff. Nominal damages of Rupees 50,000 were also granted.

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5

Imagine Marketing Pvt. Ltd. v. Exotic Mile
CS(COMM) 519/2019 | Decided on 21.01.2020

PARTIES

- The Plaintiff (appellant) **Imagine Marketing Pvt. Ltd.** is a company incorporated under the Companies Act in the year 2013 having its registered office in Mumbai and in a short span of time, plaintiff has become a market leader in electronic gadgets such as earphones, headphones, speakers, soundbars, travel chargers, and premium rugged cables, which are marketed, sold and distributed under its flagship trademark (**boAt**)
- The defendant **Exotic Mile** are associated with a similar business in electronic gadget such as earphones by the brand name of '**BOULT**'

BRIEF FACTS

- Imagine Marketing Pvt. Ltd. is an electronic product seller and has a registered trademark over the name 'boAt'. Exotic Mile, another company dishonestly adopted the phonetically similar sounding mark 'BOULT' and started selling its products under this name in 2017. Additionally, they devised the tagline 'Unplug Yourself' which is deceptively similar to boAt's tagline 'Plug into Nirvana'.



Plaintiff's Mark



Defendants's Mark

ISSUE

- Whether phonetic similarity equals infringement of trademark?
- Whether delay in bringing an action is a valid ground for dismissal of petition?

APPLICABLE LAWS

- Section 29 of Trademarks Act, 1999.
- Section 35 of Trademarks Act, 1999.
- Section 135 of Trademarks Act, 1999.

RATIO

- The court held that a phonetic similarity is also an infringement since the similarity between the marks is adjudged by the public's perception and memory retention of the same and the name need not have the exact same letters.
- Further, the court held that a delay in bringing an action is not a valid ground by the defendant since 'in a case of dishonest adoption mere delay in bringing the action is not sufficient to defeat the claim of a grant of injunction, as also, the delay if any by the plaintiff in bringing the action for an injunction does not amount to acquiescence by the plaintiff'.

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6 MakeMyTrip (India) Pvt. Ltd. v. MTB Travel Planner Ltd. & Anr.
CS(COMM) 430/2019 | Decided on 27.02.2020

PARTIES

- The Plaintiff MakeMyTrip, a travel company incorporated on 13th April 2000, with the trade name 'Travel by Web Private Limited' and subsequently, vide a fresh Certificate of Incorporation, dated 02 August 2000, its trade name changed to 'Makemytrip.com Pvt. Ltd'. Thereafter, on 28 June 2002, another change was affected and that remains its current and present name, i.e., 'MakeMyTrip (India) Pvt. Ltd.'
- The defendant MTB Travel Planner is also a travel agency.

BRIEF FACTS

- Plaintiff has reason to believe that the defendant by use of the plaintiff's trademark 'MyTripBazaar' and a domain name similarly worded is infringing his trademark, seeking to benefit from the plaintiff's goodwill. Importantly, the defendant's website is made to look identical to the plaintiff's website. The defendant has also deceptively used the plaintiff's logo.



Plaintiff's Mark



Defendants's Mark

ISSUE

- Whether the defendant has infringed or passed off the plaintiff's trademark?

APPLICABLE RULES

- Section 29 of The Trademarks Act, 1999.
- Section 33 of the Trademarks Act, 1999.

RATIO

The court found all these marks to be phonetically, visually, conceptually, and structurally similar to the plaintiff's marks and so defendants are found to be guilty of infringing the trademark and copyright of the plaintiff. The cost of ₹2,02,000 is also awarded in favor of the plaintiffs.

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7 Starbucks Corporation v. Copamocha Café and Restaurant & Anr.
CS(COMM) 676/2019 | Decided on 28.02.2020

PARTIES

- The plaintiff Starbucks Corporation, a Company registered in 1985 in the USA.
- The Defendant Copamocha Cafe`, a restaurant based in India.

BRIEF FACTS

- The plaintiff is a famous beverage company and has trademarked 'Frappuccino' and has acquired the domain name 'www.frappuccino.com'. The defendant is a store in Kerala selling various cold beverages under the name 'Frappuccino' in a deceptively similar fashion as the plaintiff, implying a connection with the plaintiff to take advantage of their goodwill. The same is listed on various food delivery apps as well.



Plaintiff's Mark

ISSUE

- Whether the defendant has infringed or passed off the plaintiff's well-known mark?

APPLICABLE RULES

- Section 29 of The Trademarks Act, 1999.
- Section 36 of the Trademarks Act, 1999.

RATIO

The court concluded that the word 'Frappuccino' was exclusive to the Plaintiff and could not be used by any other beverage company/café passing an injunction against the defendant and ordering monetary damages of ₹7,34,100/.

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8 Bajaj Electricals Limited v. Gourav Bajaj & Anr.
Commercial IP Suit (L) No. 195 of 2020 | Decided on 03.03.2020

PARTIES

- The Plaintiff Bajaj Electricals Limited, is a public limited company duly incorporated under the Indian Companies Act, 1913 and deemed to exist within the purview of the Companies Act, 2013. It is stated that Plaintiff is a part of the Bajaj conglomerates of businesses and industries, one of the oldest.
- The defendant Gourav Bajaj is operating two retail electronic and electrical appliances stores at Abohar, Punjab under the trade name "APNA BAJAJ STORE"

BRIEF FACTS

- The defendant was operating two electrical stores under the names 'Apna Bajaj Store' and 'Bajaj Excellent'. Moreover, the defendant was operating a website 'www.apnabajajstore.com'. Here, Bajaj contended that it was a well-known mark and the defense of use of the personal name would not be valid since the defendant dishonestly adopted the expression 'Powered by Bajaj' in its advertising, implying a connection with the plaintiff to take advantage of their goodwill.



Plaintiff's Mark



Defendant's Mark

ISSUES

- Whether the defendant has infringed or passed off the plaintiff's well-known mark?

APPLICABLE RULES

- Section 29 of The Trade Marks Act, 1999.
- Section 35 of Trademarks Act, 1999.
- Section 20 in The Companies Act, 1956.

RATIO

The court passed an ex-parte order of interim junction against the stores as well as website based on the plaintiff's submissions as there was no response from the defendants.

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9 ISKCON v. Iskcon Apparel Pvt. Ltd and Ors
Commercial IP Suit (L) No. 235 of 2020 | Decided on 06.03.2020

PARTIES

- The Plaintiff **ISKCON**, founded by the Late Acharya, His Divine Grace A. C. Bhaktivedanta Saami Prabhupada in or around the year 1966, when he started the Krishna Consciousness Movement in the name and style of "International Society for Krishna Consciousness" (ISKCON) in New York, United States of America.
- The Defendant **Iskcon Apparel Pvt. Ltd** is a business manufacturing of clothing, textiles, garments, clothing accessories, etc. under the trading name ISKCON Apparel Private Limited.

BRIEF FACTS

- Iskcon Apparel was using the trademark 'ISKCON' to sell its clothes.



ISSUES

- Whether the defendant has infringed or passed off the plaintiff's trademark?
- Whether ISKCON is a well-known mark?

APPLICABLE RULES

- Section 29(2)(c) of Trade Marks Act, 1999
- Section 2(1)(zg) of Trade Marks Act, 1999
- Section 11(6) of Trademarks Act, 1999

RATIO

- ISKCON Apparel was found to be infringing the plaintiff's trademark and was made to take an undertaking to the effect that it would not use the brand name at all.
- Further, based on the submissions made by the plaintiff that it had international recognition and covered within its ambit various goods and services, the court was satisfied that requirements of the Trademark Act were fulfilled and it was awarded the status of a well-known mark.

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10

Matrimony.com Limited v. Kalyan Jewellers India Limited and Ors.
OSA.No.4 of 2020 | Decided on:13.03.2020

PARTIES

- The Appellant **Matrimony.com Limited** is a registered trademark along with 'BharatMatrimony' and combining the term 'Matrimony' with other places also like 'Keralamatrimony'.
- The Defendant **Kalyan Jewellers India Ltd.**, a leading jewelry maker, and seller associated in India.

BRIEF FACTS

- Google, one of the best search engines, has started an AdWords program. This is facilitated through a sponsored link and keywords are those phrases that would trigger these sponsored links to appear in the search results.
- The appellant has registered several trademarks in lieu of its business such as BharatMatrimony, KeralaMatrimony, etc depending on the state and religion. Some of the defendants have used these trademarks as AdWords, the only difference being the spacing between words.
- Importantly, Google's AdWord Trademark Policy does not restrict the use of trademarks as they believe that the sole usage of a trademark does not violate any rights of a trademark.



Plaintiff's Mark



Defendant's Mark

ISSUES

- Whether the defendant has infringed or passed off the plaintiff's trademark?

APPLICABLE RULES

- Section 29 of Trademarks Act, 1999.
- Section 30 of Trademarks Act, 1999.
- Section 28 of Trademarks Act, 1999.
- Section 31 of Trademarks Act, 1999.

RATIO

- The court held that there had not been any infringement or passing off as there was no likelihood of confusion in a consumer's mind nor is there scope for dilution of the mark. The trademark is generic and descriptive in nature so a monopoly over these words cannot be granted via registration. Further, granting an injunction here would mean setting aside Google's policy in itself.

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11

HT Media Limited and Ors. vs. Brainlink International Inc. and Ors
CS (COMM) 119/2020 | Decided on 28.04.2020

PARTIES

- The Plaintiff **HT Media Limited** is a newspaper company founded in the year 1924, established their presence as a newspaper with editorial excellence, innovation, and integrity.
- The Defendant **Brainlink International Inc.** is a NewYork based Corporation and to be engaged in the business of providing IT-related support services to its customers.

BRIEF FACTS

- Plaintiffs have a registered trademark in 'Hindustan Times and 'Hindustan'. The defendants are the owners of the domain name www.hindustan.com. The plaintiffs believe that the defendants are infringing their trademarks and cybersquatting as the website solely exists to profit off the squatting and has no other use.
- The defendants have also initiated proceedings in a foreign court, in the Eastern District of New York Court (EDNY) which is considered vexatious by the plaintiffs as no foreign jurisdiction lies in the present matter.



Plaintiff's Mark



Defendant's Mark

ISSUES

- Whether the defendant has infringed or passed off the plaintiff's trademark via the domain name?
- Whether the High Court in the present case has the jurisdiction to restrain the proceedings of a Foreign Court by an anti-suit injunction?

APPLICABLE RULES

- Section 29 of Trademarks Act 1999.
- Section 93 Of Trademarks Act 1999.
- Section 134 of Trademarks Act, 1999.

RATIO

- The court opined that the domain name was in bad faith as per Clause 4 of the Uniform Dispute Resolution Policy since they have no legitimate use for it and have registered the same for monetary profit.
- The court also stated that the suit before EDNY court is vexatious and oppressive since the plaintiffs have not asserted their trademarks in nor do they carry out business in the U.S.A. Therefore, an anti-suit injunction was directed here against the suit in EDNY.

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12

Jagran Prakashan Ltd. vs. Telegram FZ LLC & Ors
CS(COMM) 146/2020 | Decided on 29.05.2020

PARTIES

- The Plaintiff **Jagran Prakashan Ltd.** is a registered company, engaged in publishing and distributing a newspaper by the name of 'Dainik Jagran'.
- The Defendant **Telegram FZ LLC**, is a registered company in Dubai, UAE, has an online messaging app by the name of 'Telegram'.

BRIEF FACTS

- The plaintiff publishes a Hindi newspaper called 'Dainik Jagran' which was, without prior permission, being circulated on Telegram. Importantly, the plaintiff was the exclusive owner of the trademark 'Dainik Jagran' and its variations



Plaintiff's Mark



Defendant's Mark

ISSUE

- Whether the defendant has infringed the plaintiff's trademark?

APPLICABLE RULES

- Section 29 of Trademarks Act, 1999.
- Section 35 of Trademarks Act, 1999.
- Section 79 of Information Technology Act, 2000.

RATIO

- The court found in favor of the plaintiff, keeping in mind the financial loss and violation of the trademark. Interestingly, the court also directed Telegram to reveal the identity of the users and administrators of channels where the paper was being circulated.

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- 13 1. Sun Pharma Laboratories Ltd. v. BDR Pharmaceuticals International Pvt. Ltd. & Ors.
CS(COMM.) 757/2017 | Decided on 05.06.2020

PARTIES

- The plaintiff **Sun Pharma Laboratories** is an Indian multinational pharmaceutical company headquartered in Mumbai, Maharashtra, that manufactures and sells pharmaceutical formulations and active pharmaceutical ingredients primarily in India
- The defendant **BDR Pharmaceuticals** is also a pharmaceutical company registered in Mumbai.

BRIEF FACTS

- The defendant has been operating under the name 'Lulibet' similar to the plaintiff's trademarked 'Labebet', in the same medicinal field.



Plaintiff's Mark



Defendant's Mark

- However, the medicine of the plaintiff is for the ailment of hypertension and is in a tablet and injection form, and the medicine of the defendants is for the ailment of fungal infection and marketed in ointment and spray form.

ISSUE

- Whether the defendant has infringed the plaintiff's trademark?

APPLICABLE RULES

- Section 29 of Trademarks Act, 1999
- Section 36 of Trademarks Act, 1999.
- Section 21 of Trademarks Act, 1999.
- Section 28 of Trademarks Act, 1999.

RATIO

- The court, in this case, states that *'the question whether there has been an infringement is to be decided by comparison of the two marks. Where the two marks are identical no further questions arise; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiffs registered trademark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered'*

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- Court also reiterated that *'A point has sometimes been raised as to whether the words "or confuse" introduce any element which is not already covered by the words "likely to deceive" and it has sometimes been answered by saying that it is merely an extension of the earlier test and does not add very materially to the concept indicated by the earlier words "likely to deceive". But this apart, as the question arises in an action for infringement the onus would be on the plaintiff to establish that the trademark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar.'*
- The court found in favor of the plaintiff and granted an injunction against the defendant's use of 'Lulibet'.

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14

ITC Limited v. Nestle India Limited
C.S.No.231 of 2013 | Decided on 10-11-2020

PARTIES

- The Plaintiff **M/s ITC Limited** is an Indian multinational conglomerate company headquartered in Kolkata, West Bengal. Established in 1910 as the Imperial Tobacco Company of India Limited, the company was renamed as the India Tobacco Company Limited in 1970 and later to I.T.C. Limited in 1974.
- The Defendant **Nestle India Limited** is the Indian subsidiary of Nestlé which is a Swiss multinational company. The company is headquartered in Gurgaon, Haryana. The company's products include food, beverages, chocolate, and confectioneries.

BRIEF FACTS

- To differentiate between the produced flavors, the term 'Magic Masala' was added by Sunfeast yippee Noodles in 2010. In 2013, Nestle also used the same term for their products which was earlier used by ITC limited, therefore ITC filed a suit against Nestle in the court of law. The plaintiff in his prayer has sought to restrain the defendant from using the expression 'Magic Masala' or 'Magical Masala' for any of their products by way of a permanent injunction from the court of law.



Plaintiff's Mark



Defendant's Mark

ISSUE

- Whether the mark 'Magic Masala' is purely distinctively or is descriptive but has some secondary meaning?
- Whether there is a prima facie case for grant of injunction?

APPLICABLE RULES

- Section 29 of Trademarks Act, 1999.
- Section 36 of Trademarks Act, 1999.
- Section 30 of Trademarks Act, 1999.
- Section 35 of Trademarks Act, 1999.

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RATIO

- The court took the reference of one of the cases where it was decided that passing off is premised on the right of the prior user generating goodwill.^[1] The term 'Magical Masala' shall not be considered a Flavor descriptor because there is no such flavor called 'Magic' exists. In fact, the term 'Magic Masala' is used as a taste enhancer that adds a flavor to the product which comes with it. The court held that the term 'Magic Masala' was used by 'Lays' way before being used by ITC. Both the words Magic and Masala are common to the Food Industry and therefore they cannot be assigned or allocated to a particular company or any entity.
- Law of Trademark allows an owner to acquire exclusive rights over a term or expression which is descriptive in nature but only if this term or expression has a secondary meaning which "identifies it with a particular product or as being from a particular source" the term 'magic masala' were not intended to be used as a trademark or a sub-brand. The court held that the adoption of the word cannot be treated malafide because the defendant's use of the same word is not only taken from the words which are common in the industry but also from some of its product. The court is of the view that since both the expressions are common to the food packaging industry, it will be unjust to grant a monopoly over these words.

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15 Amazon Seller Services Pvt. Ltd. & Ors. v. Amway India Enterprises Pvt. Ltd. & Ors.
FAO(OS) 133/2019 | Decided on 31.01.2020

PARTIES

- The Plaintiff **Amazon Seller Services Pvt. Ltd.** is an American multinational technology company based in Seattle, Washington, which focuses on e-commerce, cloud computing, digital streaming, and artificial intelligence.
- The Defendant **Amway India Enterprises Pvt. Ltd.** is, engaged in the manufacture and distribution business of its healthcare, wellness, cosmetic, and home products through a business model called the Direct Selling Business Model. The products offered for sale by Amway include moisturizers, creams, lipsticks, detergents, surface cleaners, shaving creams, deodorants, etc.

BRIEF FACTS

- In late 2018, Amway came across its products being sold on Amazon and other platforms. These products were being sold by Amway's direct sellers, by tampering with the original products or selling fake products by associating them to the name of Amway.
- Amway has a strict policy of quality control of its products and this sale was interfering with its ordinary course of business, by hurting Amway's goodwill and reputation and hampering its further sales. The contention therein is that Amway did not give permission to these platforms to sell its products online, as was required by Clause 7(6) of the Direct Selling Guidelines (DSG), 2016. The e-commerce platform alleged that the DSGs were not binding in law and that they were further exempted from any liability by virtue of Section 79 of the Information Technology Act, 2000 as they were merely intermediaries.



ISSUE

- Whether the Direct Selling Guidelines (DSG), 2016 are valid and binding on the defendants and if so, to what extent?

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- Whether the sale of the Plaintiffs' products on e-commerce platforms violates the Plaintiffs' trademark rights or constitutes misrepresentation, passing off and results in dilution and tarnishes the goodwill and reputation of the Plaintiffs' brands?
- Whether e-commerce platforms are "intermediaries" and are entitled to protection under the safe harbor provided in Section 79 of the Information Technology Act and the Intermediary Guidelines of 2011?
- Whether e-commerce platforms such as Amazon, Snapdeal, Flipkart, 1MG, and Health kart are guilty of tortious interference with the contractual relationship of the Plaintiffs with their distributors/direct sellers?

APPLICABLE RULE

- Section 29 of Trademarks Act, 1999.
- Section 30 of Trademarks Act, 1999.
- Section 79 of Information Technology Act, 2000.

RATIO

- The submission by the ASG on the nature of the DSGs can be 'advisory' and not 'evidence'.
- It was crucially overlooked in the impugned judgment that the DSGs were not in the form of 'executive instructions' at all.
- Merely because the DSGs are notified in the Gazette, they do not attain the status of "law" within the meaning of Article 13 of the Constitution. The source to frame such guidelines is traceable only to the Consumer Protection Act, 2019 (CPA). With the CPA, 2019 itself not having been notified, these draft guidelines could not have attained the character of "binding rules". Hence, they could not be sourced to either Article 73 or 77 of the Constitution.
- Clause 7(6) of the DSGs imposes a restriction on the buyer that he/she can't resell the product online. Such a condition is not an enforceable law vis-à-vis the third party, and though it were considered to be binding, the contract was between Amway and the ABO which suggests that Amway can only proceed against the ABO for breach of such condition and not the online platforms.
- Guidelines can't be invoked to injunct online sellers against the sale of products of Amway, Oriflame, etc. merely because they have their channels of online sale.

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16

Hindustan Unilever v. Endurance Domain and Ors.
2020 SCC Online Bom 809 | Decided on 12.06.2020

PARTIES

- The Plaintiff **Hindustan Unilever Limited** is an Indian consumer goods company headquartered in Mumbai, India. It is a subsidiary of Unilever, a British company. Its products include foods, beverages, cleaning agents, personal care products, water purifiers, and other fast-moving consumer goods.
- The defendant **Endurance Domain** is an IT services company specializing in web hosting. The company was founded in 1997 and is headquartered in Burlington, Massachusetts, USA.

BRIEF FACTS

- In this case, Plaintiff approached the Bombay High Court seeking to suspend domain names with Plaintiff's HUL trademarks which were registered under the authority of Defendant, a domain name registrant. Even though the Court was quick to grant relief to the defendant, it opined that Domain name registrars were neither equipped nor authorized to indefinitely suspend domain names once registered, since there was no human element involved to oversee the legitimacy of domain names.

ISSUE

- Whether Domain name registrars are authorized to block the registered domain names once registered?

APPLICABLE RULE

- Section 58 of Trademarks Act, 1999.
- Section 59 of Trademarks Act, 1999.

RATIO

- The Court ruled that deciding what should or should not be suspended (or blocked) is a serious judicial function that could be arrived at only by assessing and balancing rival merits. Moreover, the Court observed that anyone can use a VPN to bypass a proxy server or firewall and have access to such blocked websites by masking the originating country IP of the user, hence, such 'access blocking' only offers a hollow and faux sense of safety to the Registrant. Besides, holding the Registrar liable if he is unable to effectively block access would expose the Registrar to the constant threat of contempt proceedings.

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17

GCMMF & Anr vs. Amul Franchise.in & Ors
CS(Comm) 350/2020 | Decided on 28.08.2020

PARTIES

- The Plaintiff **Gujarat Cooperative Milk Marketing Federation Ltd (GCMMF)** is an Indian dairy cooperative society, based at Anand in the Indian state of Gujarat. Formed in 1946, it is commonly popular as 'AMUL'
- The defendant is **Amulfranchise.in**

BRIEF FACTS

- This suit has been filed by the plaintiffs aggrieved on receiving several complaints from various parts of the country regarding fraudulent websites being in operation using the well-known trademark 'AMUL' of the plaintiffs as suffix or prefix in the domain names. By virtue of the said websites, the defendant Nos. 1 to 8 are impersonating and deceiving the public at large by creating an impression that they are either the services rendered by the plaintiffs or their authorized representatives. From the said websites, the defendant Nos. 1 to 8 offer dealership, distributorship, jobs, etc. relating to AMUL and ask for money to be deposited by the individuals seeking franchises, jobs, dealerships, etc.

ISSUE

- Is the domain name used by the defendant, fraudulent in nature?

APPLICABLE RULE

- Section 35 of Trademarks Act, 1999.

RATIO

- The court finds that the plaintiffs have made out prima facie in their favor and in case no ex-parte ad-interim injunction is granted, not only the plaintiffs but the common public would suffer an irreparable loss. The balance of convenience also lies in favor of the plaintiffs. Consequently, an ex-parte ad-interim injunction is granted in favor of the plaintiffs and against the defendant Nos. 1 to 8.
- The defendant Nos. 26 to 34 are directed to suspend/block/delete the domain names as mentioned in the plaint within 36 hours of the receipt of this order. The defendant Nos. 26 to 34 are further restrained from offering for further sale the domain names so directed to be suspended/blocked/deleted by this order and also those containing names/domain names/websites having the words/expressions AMUL with or without a prefix or a suffix. The defendants Nos. 35 to 37 are directed to block access of defendant Nos. 1 to 8 websites.
- Defendant No. 9 to 25 which have the details of the bank accounts in the various banks will furnish to this Court, the details of the account holders, their addresses and contact details as also the statement of account.

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18

Plex, Inc v. Zee Entertainment Enterprises Limited
2020 SCC OnLine Bom 989 | Decided on 01.10.2020

PARTIES

- The Plaintiff **Plex, Inc** is an online movie channel service to be launched on 2nd October 2020.
- The defendant **Zee Entertainment Enterprises Limited** is an Indian media conglomerate owned by Essel Group. Headquartered in Mumbai, it has interests in television, print, internet, film, mobile content and allied businesses.

BRIEF FACTS

- The restraint sought by the Plaintiff is against the Defendant's use of the word 'PLEX' is an online movie channel service to be launched on 2nd October 2020. Defendant ("Zee") is a large multi-media conglomerate. It has a number of media channels and services including internet, OTT, DTH, satellite, cable, etc. These channels are in different languages too. On 1st September 2020, it announced its proposed launch about a month later of a 'cinema-to-home' pay-per-view service.



Plaintiff's Mark



Defendant's Mark

ISSUE

- Whether the defendant has infringed or passed off the plaintiff's trademark?

APPLICABLE RULE

- Section 29 of Trademarks Act, 1999.
- Section 36 of Trademarks Act, 1999.

RATIO

- In the usual set of factors to be considered, the Court finds no prima facie case. But on the second-level test of balance of convenience, the court must find against Plex too. It is unable to show any anticipated injury. Its amendment application is problematic. Its user base and domestic sales are not enough to show even prima facie that Zee is acting in deceit and trying to pass off its new channel as an association with, or a spin-off from, Plex.
- The grant of the injunction Plex seeks would, on the other, cause immense and immediate financial loss and harm to Zee — it says it has already spent more than Rs. 11 crores (rather more than Plex's combined India sales for the last five years) on this new channel. Plex is in no position to show that it can cover any part of any such potential loss.

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19

Mittal Electronics v Sujata Home Appliances (P) Ltd & Ors.
CS(COMM) 60/2020 | Decided on 09.09.2020

PARTIES

- The Plaintiff **Mittal Electronics** is a company involved in the manufacturing and sale of juicers, mixers and grinders under the trademark 'Sujata'.
- The defendant **Sujata Home Appliances (P) Ltd** is a company involved in the sale of Water Purifiers, Water Filters and R.O. Systems.

BRIEF FACTS

- The present dispute is related to the use of the trademarks SUJATA and Star SUJATA being used by the plaintiff for home appliances in classes 7, 8, 9, 11 and 35 and by the Defendant in class 11. The Plaintiff when it came to know about the usage of the trademark by the defendant, sought an injunction order against usage of the trademark for home appliances including water purifiers, RO system, water filters even though the plaintiff does not manufacture these three appliances. An ex parte ad interim injunction was issued in favour of the Plaintiff covering all the appliances as requested by the plaintiff by the Delhi HC. The Defendant only seeks to modify the order to exclude water purifiers, RO system, water filters from its scope so that they can continue to manufacture it.
- The registration of the defendant for the mark 'SUJATA' in application No.2337951 w.e.f. 25th February, 2012 was sought with the user as 1st April, 2008.
- The trademark was first used by Rajesh Kumar Bansal trading under the name Luxmi Enterprises for the products water purifiers under the brand name 'SUJATA' from 1st April, 2008.
- The plaintiff has shown no proof that they are using or have ever used the disputed trademark for water purifiers RO system and water filters. Furthermore, they did not file an objection to the registration of the defendant's trademark.
- The plaintiff had not even applied for the registration of the mark and when the plaintiff applied for the registration of the mark in Class-11 it was on proposed to be used basis. Additionally they have not shown any proof that the trademark created confusion on part of the customers.

ISSUE

- Whether the defendant has infringed or passed off the plaintiff's trademark?

APPLICABLE RULE

- Section 29 of Trademarks Act, 1999.
- Section 36 of Trademarks Act, 1999.

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RATIO

- In the Nandhini Deluxe case, the Supreme Court held that the registration of a trademark in class is only limited to the goods and services for which it is registered and used and not for the entire class.
- The Court, after hearing both the parties, modified the ex-parte order and allowed Sujata to manufacture and sell only water purifiers, water filters, and RO systems under the mark “SUJATA”. The Court stated that as per the proviso to Order XXXIX Rule 4 of Code of Civil Procedure, 1908 if a party had obtained an ex parte order by concealing material facts, the court could modify its order in the interest of justice. The Court relied upon Nandhni’s case and stated that the registration of a mark in a certain class does not necessarily give rights to the proprietor over the entire class. It only gives rights with respect to said good or service which were being provided under the mark. In the current case, since Mittal was not manufacturing or selling water purifiers, water filters, and RO systems under the mark
- “SUJATA”, it was not entitled to obtain an interim injunction with respect to these goods.

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- REFERENCER -

- **Adopting another company's mark creates confusion and deception amongst the general public.**^[2]

Relying on the proof and documentation submitted by the designated local commissioner, the Court found that the adoption and use of the mark by the defendants produce unjust enrichment by the creation of misunderstanding in consumer minds.^[3]

- **To check whether a mark is creating confusion or not, it has to be assessed through the eyes and ears of the consumer.**^[4]

The court held that since both parties operate in the same field of vegetarian catering and the same locality in Kolkata, the court held the marks to be deceptively similar and a grant of injunction was provided to the plaintiffs. The court also reiterated that *'The Judge has to place himself in the position of a prospective customer and assess whether he would then be likely to be deceived or confused.'*

- **Any logo deceptively similar to the plaintiff's mark will amount to infringement.**^[5]

Any mark/logo which is deceptively similar to the plaintiff mark PUMA and PUMA logo may amount to infringement of the registered trademark of the plaintiff, or which may amount to passing off goods of the defendant as those of the plaintiff. The court, in the absence of a response from the defendant, passed an ex-parte order of permanent injunction based on the evidence submitted by the plaintiff.

- **Phonetic similarity will amount to infringement of the trademark.**^[6]

The court held that a phonetical similarity will amount to infringement since the similarity between the marks is adjudged by the public's perception and memory retention of the same and the name need not have the exact same letters. The court further stated that *'in a case of dishonest adoption mere delay in bringing the action is not sufficient to defeat the claim of the grant of injunction, as also, the delay if any by the plaintiff in bringing the action for an injunction does not amount to acquiescence by the plaintiff'.*

- **Similarity in the name can hamper the reputation of the trademark owner.**^[7]

Both plaintiff and defendant are using similar names and both are in a similar business which can lead to confusion and deception in the minds of the consumers. The actions of the defendant are in violation of the common law rights of the plaintiff.

[2] Lacoste S.A. v. Suresh Kumar Sharma CS (Comm) No. 534/19.

[3] Nike Innovate C.V. v. G.B. Shoes & ors CS(Comm) no. 542/19.

[4] Rajesh Kumar Agarwal & Ors v. Sanjay Gupta CS No. 101 of 2019.

[5] Puma Se v. Mr. Vikas Jindal CS no. 552/2019.

[6] Imagine Marketing Pvt. Ltd. v. Exotic Mile CS (Comm) 519/2019.

[7] Make My Trip (India) Pvt. Ltd v. MTB Travel Planner Ltd & Anr CS(Comm) 430/2019.

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- REFERENCER -

- **The curious case of Frappuccino.**^[8]

The court granted an injunction to the plaintiff against the defendant who was using the registered Trademark on the product called Frappuccino. The court levied a penalty of Rs. 7,34,000 on the defendant.

- **Trademark name, label, and website can all be deceptively similar to a well-known trademark.**^[9]

The court opined that the use of the impugned name 'APNA BAJAJ' and impugned website apnabajajstore.com, is an infringement of the rights of the plaintiff since it is deceptively similar to the plaintiff's well-known Trademark 'BAJAJ'.

- **Trademarks of international repute deserve highest degree of protection.**^[10]

Plaintiff has international recognition and covered within its ambit various goods and services, the court was satisfied that requirements of the Trademark Act were fulfilled and it was awarded the status of a well-known mark hence deserves the highest degree of protection.

- **Trademark cannot be generic and/or descriptive in nature.**^[11]

Court held if there is no confusion in the distinctiveness of words, it is not an infringement or passing off on trademark. Court further added that the trademark cannot be generic and descriptive in nature. Trademark cannot be awarded for one common word.

- **Trademarks and the reputation and goodwill enjoyed by said Trademarks, is not restricted merely to India but is global.**^[12]

The court also stated that the suit before EDNY court is vexatious and oppressive since the plaintiffs have not asserted their trademarks in nor do they carry out business in the U.S.A. Therefore, an anti-suit injunction was directed here against the suit in EDNY.

- **Cannot escape liability on the ground of being an intermediary.**^[13]

The court held that defendant is required to conduct due diligence and in terms of Rule-3 sub-rule 4 of the Information Technology (Intermediaries Guidelines) Rules, 2011 on being informed about the misuse, the defendant is required to pull down the said channels within 36 hours. The court granted an injunction to the plaintiff against the defendant.

[8] Starbucks Corporation v. Copamocha Café and Restaurant & Anr CS (COMM) 676/2019.

[9] Bajaj Electricals Ltd. v. Gaurav Bajaj & Anr. Commercial IP suit (L) no. 195/2020.

[10] ISKCON v. Iskcon Apparel Pvt. Ltd. and Ors Commercial IP Suit(L) No. 235/2020.

[11] Matrimony.com Ltd v. Kalyan Jewellers India Ltd and Ors. OSA no. 4 of 2020.

[12] HT Media Ltd. and Ors v. Brainlink International Inc. and Ors CS(COMM) 119/2020.

[13] Jagran Prakashan Ltd v. Telegram FZ LLC and Ors. CS (Comm) 146/2020.

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- REFERENCER -

- **The identification of the essential features of the mark is in essence a question of fact and depends on the judgment of the Court based on the evidence led before it as regards the usage of the trade.**^[14]

Where the two marks are identical no further questions arise, When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiffs registered trademark as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered.

- **Law of Trademark allows an owner to acquire exclusive rights over a term or expression which is descriptive in nature – only if it has acquired secondary meaning.**^[15]

Law of Trademark allows an owner to acquire exclusive rights over a term or expression which is descriptive in nature but only if this term or expression has a secondary meaning which “identifies it with a particular product or as being from a particular source.”

- **Merely because the DSGs are notified in the Gazette, they do not attain the status of “law” within the meaning of Article 13 of the Constitution.**^[16]

Guidelines can’t be invoked to injunct online sellers against the sale of products of Amway, Oriflame, etc. merely because they have their channels of online sale. The source to frame such guidelines is traceable only to the Consumer Protection Act, 2019 (CPA). With the CPA, 2019 itself not having been notified, these draft guidelines could not have attained the character of “binding rules”.

- **What should or should not be suspended could be arrived at only by assessing and balancing rival merits.**^[17]

Anyone can use a VPN, masking the originating country IP of the user, hence, such ‘access blocking’ only offers a hollow and faux sense of safety to the Registrar. Holding the registrar liable would expose him to a constant threat of contempt.

- **Using a fake website of a reputable brand does not cause loss to the brand only, consumers also suffer irreparable loss.**^[18]

The court ordered the defendant to block/suspend/delete the domain having the word ‘AMUL’ with or without a prefix or suffix.

[14] Sun Pharma Laboratories Ltd. v. BDR Pharmaceuticals International Pvt. Ltd & Ors CS(COMM) 757/2017.

[15] M/s ITC Limited v. Nestle India Limited CS No. 231 of 2013

[16] Amazon Seller Services Pvt. Ltd. & Ors v. Amway India Enterprise Pvt. Ltd. & Ors FAO(OS) 133/2019.

[17] Hindustan Unilever v. Endurance Domain & Ors 202 SCC Online Bom 809

[18] Gujarat Co-operative Milk Marketing Federation Ltd & Anr v. Amulfranchise.in & Ors CS(Comm) 350/2020.

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- REFERENCER -

- **To obtain a quia timet injunction the Plaintiff must be able to show considerably more sufficient material.**^[19]

The court stated that there is obvious difference between the services and the defendant is using PLEX as suffix only and hence does not create deception or confusion in the minds of the general public.

- **The registration of a trademark in a class is only limited to the goods and services for which it is registered and used and not for the entire class.**^[20]

The Delhi High Court re-iterated the principles of trademark laid down by the Supreme Court in the *Nandhini Deluxe* case stating that the registration of a mark in a certain class does not necessarily give rights to the proprietor over the entire class. It only gives rights with respect to said good or service which were being provided under the mark.

[19] Plex, Inc v. Zee Entertainment Enterprises Ltd 2020 SCC online BOM 989.

[20] Mittal Electronics v Sujata Home Appliances (P) Ltd CS(Comm) 60/2020

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GLOSSARY

I. Section 29 of 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.

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(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.

II **Section 35 of the Trademark Act, 1999**

Saving for use of name, address or description of goods or services—

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods or services.

III **Section 36 of the Trademark Act, 1999**

Saving for words used as name or description of an article or substance or service.—

(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use after the date of the registration of any word or words which the trade mark contains or of which it consists as the name or description of an article or substance or service: Provided that, if it is proved either—

- (a) that there is a well known and established use of the said word as the name or description of the article or substance or service by a person or persons carrying on trade therein, not being use in relation to goods or services connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) in relation to goods or services certified by the proprietor; or

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(b) that the article or substance was formerly manufactured under a patent that a period of two years or more after the cesser of the patent has elapsed and that the said word is the only practicable name or description of the article or substance, the provisions of sub-section (2) shall apply.

(2) Where the facts mentioned in clause (a) or clause (b) of the proviso to sub-section (1) are proved with respect to any words, then,—

(a) for the purposes of any proceedings under section 57 if the trade mark consists solely of such words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, or of the services or of any services of the same description, as the case requires, shall be deemed to be an entry wrongly remaining on the register;

(b) for the purposes of any other legal proceedings relating to the trade mark,

(i) if the trade mark consists solely of such words, all rights of the proprietor under this Act or any other law to the use of the trade mark; or

(ii) if the trade mark contains such words and other matter, all such right of the proprietor to the use of such words, in relation to the article or substance or to any goods of the same description, or to the service or to any services of the same description, as the case requires, shall be deemed to have ceased on the date on which the use mentioned in clause (a) of the proviso to sub-section (1) first became well known and established or at the expiration of the period of two years mentioned in clause (b) of the said proviso.

IV Section 135 of the Trademark Act, 1999

Relief in suits for infringement or for passing off-

(1) The relief which a court may grant in any suit for infringement or for passing off referred to in section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

(2) The order of injunction under sub-section (1) may include an ex parte injunction or any interlocutory order for any of the following matters, namely:—

(a) for discovery of documents;

(b) preserving of infringing goods, documents or other evidence which are related to the subject-matter of the suit;

(c) restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

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(3) Notwithstanding anything contained in sub-section (1), the court shall not grant relief by way of damages (other than nominal damages) or on account of profits in any case—

- (a) where in a suit for infringement of a trade mark, the infringement complained of is in relation to a certification trade mark or collective mark; or
- (b) where in a suit for infringement the defendant satisfies the court—
 - (i) that at the time he commenced to use the trade mark complained of in the suit, he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was on the register or that the plaintiff was a registered user using by way of permitted use; and
 - (ii) that when he became aware of the existence and nature of the plaintiff's right in the trade mark, he forthwith ceased to use the trade mark in relation to goods or services in respect of which it was registered; or
- (c) where in a suit for passing off, the defendant satisfies the court—
 - (i) that at the time he commenced to use the trade mark complained of in the suit, he was unaware and had no reasonable ground for believing that the trade mark for the plaintiff was in use; and
 - (ii) that when he became aware of the existence and nature of the plaintiff's trade mark he forthwith ceased to use the trade mark complained of.

V **Section 136 of the Trademark Act, 1999**

Registered user to be impleaded in certain proceedings

(1) In every proceeding under chapter VII or under section 91, every registered user of a trade mark using by way of permitted use, who is not himself an applicant in respect of any proceeding under that Chapter or section, shall be made a party to the proceeding. (2) Notwithstanding anything contained in any other law, a registered user so made a party to the proceeding shall not be liable for any costs unless he enters an appearance and takes part in the proceeding.

VI **Section 30 of the Trademark Act, 1999**

Limits on effect of registered trade mark

(1) Nothing in section 29 shall be construed as preventing the use of a registered trade mark by any person for the purposes of identifying goods or services as those of the proprietor provided the use—

- (a) is in accordance with honest practices in industrial or commercial matters, and
- (b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark.

(2) A registered trade mark is not infringed where—

- (a) 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;

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- (b) a trade mark is registered subject to any conditions or limitations, the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market or in relation to services for use or available for acceptance in any place or country outside India or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend;
- (c) the use by a person of a trade mark—
- (i) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the registered proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or
 - (ii) in relation to services to which the proprietor of such mark or of a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark;
- (d) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services, as the case may be;
- (e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.
- (3) Where the goods bearing a registered trade mark are lawfully acquired by a person, the sale of the goods in the market or otherwise dealing in those goods by that person or by a person claiming under or through him is not infringement of a trade mark by reason only of—
- (a) the registered trade mark having been assigned by the registered proprietor to some other person, after the acquisition of those goods; or
 - (b) the goods having been put on the market under the registered trade mark by the proprietor or with his consent.
- (4) Sub-section (3) shall not apply where there exists legitimate reasons for the proprietor to oppose further dealings in the goods in particular, where the condition of the goods, has been changed or impaired after they have been put on the market.

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VII. **Section 34 of the Trade Marks Act, 1999**

Saving for vested rights-

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 by 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.

VIII. **Section 33 of the Trade Marks Act, 1999**

Effect of acquiescence-

(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.

IX. **Section 36 of the Trade Marks Act, 1999**

Saving for words used as name or description of an article or substance or service-

(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use after the date of the registration of any word or words which the trade mark contains or of which it consists as the name or description of an article or substance or service: Provided that, if it is proved either—

(a) that there is a well known and established use of the said word as the name or description of the article or substance or service by a person or persons carrying on trade therein, not being use in relation to goods or services connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) in relation to goods or services certified by the proprietor; or

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(b) that the article or substance was formerly manufactured under a patent that a period of two years or more after the cesser of the patent has elapsed and that the said word is the only practicable name or description of the article or substance, the provisions of sub-section (2) shall apply.

(2) Where the facts mentioned in clause (a) or clause (b) of the proviso to sub-section (1) are proved with respect to any words, then,—

(a) for the purposes of any proceedings under section if the trade mark consists solely of such words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, or of the services or of any services of the same description, as the case requires, shall be deemed to be an entry wrongly remaining on the register;

(b) for the purposes of any other legal proceedings relating to the trade mark,—

(i) if the trade mark consists solely of such words, all rights of the proprietor under this Act or any other law to the use of the trade mark; or

(ii) if the trade mark contains such words and other matter, all such right of the proprietor to the use of such words,

in relation to the article or substance or to any goods of the same description, or to the service or to any services of the same description, as the case requires, shall be deemed to have ceased on the date on which the use mentioned in clause (a) of the proviso to sub-section (1) first became well known and established or at the expiration of the period of two years mentioned in clause (b) of the said proviso.

X **Section 20 of the Companies Act, 1956**

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,—

(i) The name by which a company in existence has been previously registered, or

(ii) a registered trade mark, or a trade mark which is subject of an application for registration, of any other person under the Trade Marks Act, 1999, may be deemed to be undesirable by the Central Government within the meaning of sub-section (1).

(i) The name by which a company in existence has been previously registered, or

(ii) a registered trade mark, or a trade mark which is subject of an application for registration, of any other person under the Trade Marks Act, 1999, may be deemed to be undesirable by the Central Government within the meaning of sub-section (1).

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XI **Section 2(1)(zg) of the Trademark 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.

XII **Section 11 of the Trademarks Act, 1999**

Relative grounds for refusal of registration

(1) Save as provided in section 12, a trade mark shall not be registered if, because of—

- (a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or
- (b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(2) A trade mark which—

- (a) is identical with or similar to an earlier trade mark; and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor, shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.

(3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented—

- (a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or
- (b) by virtue of law of copyright.

(4) Nothing in this section shall prevent the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration, and in such case the Registrar may register the mark under special circumstances under section 12

Explanation.—For the purposes of this section, earlier trade mark means—

1 [(a) a registered trade mark or an application under section 18 bearing an earlier date of filing or an international registration referred to in section 36E or convention application referred to in section 154 which has a date of application earlier than that of the trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trade marks;]

(b) a trade mark which, on the date of the application for registration of the trade mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection as a well-known trade mark.

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(5) A trade mark shall not be refused registration on the grounds specified in sub-sections (2) and (3), unless objection on any one or more of those grounds is raised in opposition proceedings by the proprietor of the earlier trade mark.

(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

- (i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;
- (ii) the duration, extent and geographical area of any use of that trade mark;
- (iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;
- (iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent that they reflect the use or recognition of the trade mark;
- (v) the record of successful enforcement of the rights in that trade mark, in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

(7) The Registrar shall, while determining as to whether a trade mark is known or recognised in a relevant section of the public for the purposes of sub-section (6), take into account—

- (i) the number of actual or potential consumers of the goods or services;
- (ii) the number of persons involved in the channels of distribution of the goods or services;
- 1. Subs. by Act 40 of 2010, s. 2, for clause (a) (w.e.f. 8-7-2013). (iii) the business circles dealing with the goods or services, to which that trade mark applies.

(8) Where a trade mark has been determined to be well known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.

(9) The Registrar shall not require as a condition, for determining whether a trade mark is a well-known trade mark, any of the following, namely:—

- (i) that the trade mark has been used in India;
- (ii) that the trade mark has been registered;
- (iii) that the application for registration of the trade mark has been filed in India; (iv) that the trade mark—
 - (a) is well-known in; or
 - (b) has been registered in; or
 - (c) in respect of which an application for registration has been filed in, any jurisdiction other than India; or

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(iv) that the trade mark is well-known to the public at large in India.

(10) While considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall—

(i) protect a well-known trade mark against the identical or similar trade marks;

(ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark

(11) Where a trade mark has been registered in good faith disclosing the material informations to the Registrar or where right to a trade mark has been acquired through use in good faith before the commencement of this Act, then, nothing in this Act shall prejudice the validity of the registration of that trade mark or right to use that trade mark on the ground that such trade mark is identical with or similar to a well-known trade mark.

XIII **Section 30(2)(a) of the Trade Marks Act, 1999**

Rights conferred by registration-

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

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

(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

XIV **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.

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XV **Section 93 of the Trade Marks Act, 1999**

Bar of jurisdiction of courts, etc-

No court or other authority shall have or, be entitled to, exercise any jurisdiction, powers or authority in relation to the matters referred to in sub-section (1) of section 91.

XVI **Section 134 of the Trade Marks Act, 1999**

Suit for infringement, etc., to be instituted before District Court-

(1) No suit—

- (a) for the infringement of a registered trade mark; or
- (b) relating to any right in a registered trade mark; or
- (c) for passing off arising out of the use by the defendant of any trade mark which is identical with or deceptively similar to the plaintiff's trade mark, whether registered or unregistered, shall be instituted in any court inferior to a District Court having jurisdiction to try the suit.

(2) For the purpose of clauses (a) and (b) of sub-section (1), a "District Court having jurisdiction" shall, notwithstanding anything contained in the Code of Civil Procedure, 1908 (5 of 1908) or any other law for the time being in force, include a District Court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceeding, the person instituting the suit or proceeding, or, where there are more than one such persons any of them, actually and voluntarily resides or carries on business or personally works for gain.

Explanation.—For the purposes of sub-section (2), "person" includes the registered proprietor and the registered user.

XVII **Section 79 of the Information Technology Act, 2000**

Exemption from liability of intermediary in certain cases-

(1) Notwithstanding anything contained in any law for the time being in force but subject to the provisions of sub-sections (2) and (3), an intermediary shall not be liable for any third party information, data, or communication link made available or hosted by him.

(2) The provisions of sub-section (1) shall apply if—

- (a) the function of the intermediary is limited to providing access to a communication system over which information made available by third parties is transmitted or temporarily stored or hosted; or
- (b) the intermediary does not—
 - (i) initiate the transmission,
 - (ii) select the receiver of the transmission, and
 - (iii) select or modify the information contained in the transmission;
- (c) the intermediary observes due diligence while discharging his duties under this Act and also observes such other guidelines as the Central Government may prescribe in this behalf.

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(3) The provisions of sub-section (1) shall not apply if—

- (a) the intermediary has conspired or abetted or aided or induced, whether by threats or promise or otherwise in the commission of the unlawful act;
- (b) upon receiving actual knowledge, or on being notified by the appropriate Government or its agency that any information, data or communication link residing in or connected to a computer resource controlled by the intermediary is being used to commit the unlawful act, the intermediary fails to expeditiously remove or disable access to that material on that resource without vitiating the evidence in any manner.

Explanation.—For the purposes of this section, the expression — "third party information" means any information dealt with by an intermediary in his capacity as an intermediary.

XVIII **Section 21 of the Trademarks Act, 1999**

Opposition to registration-

(1) Any person may, within four months from the date of the advertisement or re-advertisement of an application for registration, give notice in writing in the prescribed manner and on payment of such fee as may be prescribed, to the Registrar, of opposition to the registration.

(2) The Registrar shall serve a copy of the notice on the applicant for registration and, within two months from the receipt by the applicant of such copy of the notice of opposition, the applicant shall send to the Registrar in the prescribed manner a counter-statement of the grounds on which he relies for his application, and if he does not do so he shall be deemed to have abandoned his application.

(3) If the applicant sends such counter-statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.

(4) Any evidence upon which the opponent and the applicant may rely shall be submitted in the prescribed manner and within the prescribed time to the Registrar, and the Registrar shall give an opportunity to them to be heard, if they so desire.

(5) The Registrar shall, after hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or limitations, if any, the registration is to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not.

(6) Where a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice neither resides nor carries on business in India, the Registrar may require him to give security for the costs of proceedings before him, and in default of such security being duly given, may treat the opposition or application, as the case may be, as abandoned.

(7) The Registrar may, on request, permit correction of any error in, or any amendment of, a notice of opposition or a counter-statement on such terms as he thinks just.

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XIX Section 58 of the Trademarks Act, 1999

(1) The Registrar may, on application made in the prescribed manner by the registered proprietor,—

- (a) correct any error in the name, address or description of the registered proprietor of a trade mark, or any other entry relating to the trade mark;
- (b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark;
- (c) cancel the entry of a trade mark on the register;
- (d) strike out any goods or classes of goods or services from those in respect of which a trade mark is registered, and may make any consequential amendment or alteration in the certificate of registration, and for that purpose, may require the certificate of registration to be produced to him.

(2) The Registrar may, on application made in the prescribed manner by a registered user of a trade mark, and after notice to the registered proprietor, correct any error, or enter any change, in the name, address or description of the registered user.

XX Section 59 of the Trademarks Act, 1999

Alteration of registered trade marks

(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) Where leave is granted under this section, the trade mark as altered shall be advertised in the prescribed manner, unless the application has already been advertised under sub-section (2).

XXI Section 13 of the Copyright Act, 1957

Works in which copyright subsists.—

(1) Subject to the provisions of this section and the other provisions of this Act, copyright shall subsist throughout India in the following classes of works, that is to say,—

- (a) original literary, dramatic, musical and artistic works;
- (b) cinematograph films; and
- (c) 1 [sound recording].

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(2) Copyright shall not subsist in any work specified in sub-section (1), other than a work to which the provisions of section 40 or section 41 apply, unless,—

(i) in the case of a published work, the work is first published in India, or where the work is first published outside India, the author is at the date of such publication, or in a case where the author was dead at that date, was at the time of his death, a citizen of India;

(ii) in the case of an unpublished work other than a [work of architecture], the author is at the date of the making of the work a citizen of India or domiciled in India; and

(iii) in the case of [work of architecture], the work is located in India.

Explanation.— In the case of a work of joint authorship, the conditions conferring copyright specified in this sub-section shall be satisfied by all the authors of the work.

(3) Copyright shall not subsist—

(a) in any cinematograph film if a substantial part of the film is an infringement of the copyright in any other work;

(b) in any [sound recording] made in respect of a literary, dramatic or musical work, if in making the 1 [sound recording], copyright in such work has been infringed.

(4) The copyright in a cinematograph film or a [sound recording] shall not affect the separate copyright in any work in respect of which or a substantial part of which, the film, or, as the case may be, the [sound recording] is made.

(5) In the case of [work of architecture], copyright shall subsist only in the artistic character and design and shall not extend to processes or methods of construction.