



A HOLISTIC COMPENDIUM HIGHLIGHTING KEY TRADE MARK LITIGATION CASES

For 2021-2022

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A Holistic Compendium: Indian Trade Mark Cases Summary for 2021-2022

Preface

Indian Trade Mark jurisprudence saw a sea of developments and critically weighed judgements in the year 2021, which re-iterated old principles as well as new. With a notable increase in the number of IP litigations, Indian Judiciary; especially Bombay High Court and 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:

1. 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.
2. That a prior user shall always triumph over a mark registered post the prior user's mark if said prior use is sufficiently proven.
3. The Hon'ble Court opined that under the guise of educating the general public, one cannot make false claims against a product or sell the counterfeit products. Social media users should behave at the highest responsibility if they command a crowd.
4. 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.
5. 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.

With that background, 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 2021 pertaining to the interpretation/ implementation of various provisions of The Trade Marks Act, 1999



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1. GS1 India vs. Global Barcodes S.L and Ors.

CS (Comm) No. 147 of 2020

Decided on 12.01.2021

Parties

- The Plaintiff, GS1, is a not-for-profit standards organization, set up by set up in 1996 by several industry bodies and statutory bodies like Bureau of Indian Standards, Federation of Indian Chambers of Commerce and Industry (FICCI), Associated Chambers of Commerce and Industry of India (ASSOCHAM), Confederation of Indian Industry (CII).
- The Defendant No. 1, Global Barcodes S.L., is an entity based outside India and was primarily engaged in the business of operating websites, which generated and provided barcodes for various products.

Brief Facts

- The plaintiff company, the only licensed body in India, has been allocated the code '890', which is used along with ten other digits to create a 13 digit unique barcode. This barcode is subsequently allocated to various manufacturers, suppliers for their products to be certified with it. Post allocation, the barcode is entered into the database of the global page of GSI thereby giving it uniqueness and also ensuring uniformity in the standards. The plaintiff has also obtained a trademark registration with respect to this code. The defendant No. 1 was operating the websites through which it allocated barcode numbers starting with '890' which did not originate from the Plaintiff; were not compliant with GSI standards; were not unique; and could be verified against the GSI global database.

Issues

- Whether issuance of barcodes starting with the numbers '890' amounts to Trademark Infringement?



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Applicable Rule

- Section 29 of The Trade Marks Act, 1999.
- Section 135 of The Trade Marks Act, 1999.

Ratio

- The Court granted the ex-parte injunction in favour of plaintiff and ordered the websites to be blocked. Since the websites in question allocated barcodes starting with numbers '890', which did not originate from GS1 India and were non-compliant with GS1 standards, the Court observed that due to the misrepresentation by defendants, innocent customers were made to believe that the barcodes so allocated originated from GS1. The Hon'ble Court also observed that "It is manifest that defendants No. 1 who is supposed to be an entity based outside the country is bent on carrying on its illegal activities by mischievously and falsely allocating bar codes starting from '890' illegally to innocent third parties."



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2. Piyush Subhashbhai Ranipa vs. The State of Maharashtra

Anticipatory Bail Appl. No. 336 of 2021

Decided on 26.02.2021

Parties

- The Applicant was allegedly manufacturing pipes bearing trade mark of the complainant company pursuant to which an FIR was lodged by one Mr. Prakash Gore, zonal manager of Jain Irrigation System.
- The Respondent in the instant case was The State of Maharashtra acting upon the said F.I.R.

Brief Facts

- The Applicant sought an Anticipatory bail pursuant to an FIR registered against him with Mohol Police Station, Solapur, under sections 418, 465, 482, 483, 485, 486, 488 r/w 34 of the Indian Penal Code ('IPC'), under section 63 of the Copyright Act, 1957, and section 103 of the Trade Marks Act, 1999.

Issues

- Whether offences of copyright infringement and falsely applying for a trademark are bailable or non-bailable?

Applicable Rule

- Section 103 of The Trade Marks Act, 1999.
- Section 63 of The Trade Marks Act, 1999.

Ratio

- The Court, while dealing with the matter, held that offences under The Copyright Act, 1957 and falsely applying for a trademark under The Trade Marks Act are non-bailable as they attract up to three years of punishment, and in such cases, the punishment can be exactly three years. Referring to relevant the CrPC schedule, the Court noted that if an offence under any law, other than the IPC, is punishable with imprisonment for three years then it is cognizable and non-bailable.



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3. M/s Golden Tobie Pvt. Ltd. vs. M/s Golden Tobacco Ltd.

CS (Comm) No. 178 of 2021

Decided on 04.06.2021

Parties

- The Plaintiff was established in the year 2015 and started its association with the Defendant in the year 2019 for multiple cigarette/tobacco brands.
- The Defendant is a well-known company engaged in the business of manufacturing tobacco products.

Brief Facts

- The Plaintiff had filed a suit seeking permanent injunction against the Defendant from inter alia selling and advertising its allegedly exclusive brands namely "Golden's Gold Flake, Golden Classic, Taj Chhap, Panama and Chancellor". Subsequently, the Defendant filed an application under Section 8 of the Arbitration and Conciliation Act, 1996 for referring the disputes to arbitration as the Trademark Licence Agreement vide which the said brands were allegedly transferred to Plaintiff contained an Arbitration clause.

Issues

- Whether the present suit contains an arbitrable dispute and is thus liable to be referred to arbitration in view of the arbitration agreement between the parties?

Applicable Rule

- Section 8 of the Arbitration and Conciliation Act, 1996

Ratio

- The Court after dealing with the judgments on point noted that actions in rem including grant and issue of patents and registration of trademarks are exclusive matters falling within the sovereign and government functions and have erga omnes effect. Such grants confer monopolistic rights, and they are non-arbitrable.



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A co-ordinate bench of Delhi High Court had in Hero Electric Vehicles Pvt. Ltd. decision (2021 SCC OnLine Del 1058) held that non-arbitrability may be said to exist where inter alia the cause of action and subject matter of the dispute relate to inalienable sovereign and public interest functions of the State, not amenable to adjudication by the arbitral process. In view of the above decision, it was observed that the disputes in question solely involved interpretation of terms of the Agreements executed between the parties therefore, the rights asserted by the Plaintiff emanated from such agreements alone and not from any statutory law including the Trade Marks Act, 1999. Since the disputes did not involve any exercise of sovereign functions of the State, therefore such disputes were held to be arbitrable in nature.

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4. PhonePe Private Limited vs. Ezy Services & Anr.

CS (Comm) No. 292 of 2019

Decided on 15.04.2021

Parties

- Plaintiff is an online payment service portal and operates through its Phone application of the name 'PhonePe'.
- The Defendant too is engaged in the business of providing payment services through its own application but its services are restricted to merchants exclusively unlike the Plaintiff.

Brief Facts

- The Plaintiff is using the Trade Mark 'PhonePe' whereas the Defendant is using the mark 'BharatPe'. Such use of the mark 'BharatPe', according to the Plaintiff, amounts to infringement of its mark 'PhonePe'. Hence the present suit was filed by the Plaintiff seeking permanent injunction restraining the Defendant from using the term 'Pe' or any other allegedly identical mark.



Plaintiff's Mark



Defendant's Mark

Issues

- Whether the use of Defendant's mark(s) amounts to infringement of the Plaintiff's mark(s)?

Applicable Rule

- Section 29 of The Trade Marks Act, 1999.
- Section 34 of The Trade Marks Act, 1999.

Ratio

- It was held that "PhonePe" and "BharatPe" are both composite marks therefore these marks cannot be dissected into "Phone" and "Pe" and "Bharat" and "Pe" respectively.



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The Court observed that no exclusivity can be claimed over the "Pe" suffix as it forms only a part of the registered trademark and as per settled principles of Trade Mark Law, infringement cannot be claimed over or on the basis of isolated elements of registered Trade Marks. It was an admitted position that the term 'Pe' connotes the expression and meaning 'Pay'. In this context, it was observed that both the plaintiff and the defendant were engaged in the services of online payments and the expression "pay" thus was clearly descriptive of the services offered by them. Since no protection is generally granted to descriptive words, like 'pay' in the instant case, the court held that "By misspelling "Pay" as "Pe", the legal position cannot change. The plaintiff would, therefore, be as entitled to claim exclusivity over the suffix "Pe", as it would have been, had the suffix in its trademark been "Pay"." As a consequence injunctive reliefs as prayed for were not granted to the Plaintiff.

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5. Sun Pharma Laboratories Limited vs D. D. Pharmaceuticals Private Limited.

CS (Comm) No. 687 of 2014

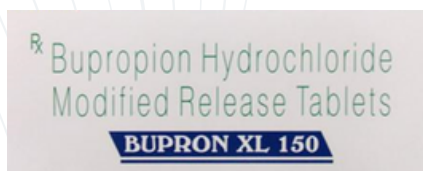
Decided on 23.09.2021

Parties

- The Plaintiff, Sun Pharma manufactures and sells pharmaceutical formulations and active pharmaceutical ingredients.
- The Defendants, D. D. Pharmaceuticals also manufacture and market broad range of healthcare products.

Brief Facts

- Plaintiff filed the suit at the Madras High Court seeking inter alia permanent injunction against the use of mark 'BUPRO' by the defendant, which according to the plaintiff was identical and/or similar to plaintiff's trademark 'BUPRON'



Plaintiff's Mark



Defendant's Mark

Issues

- Whether the defendant is infringing the plaintiff's registered trademark 'BUPRON' by using a deceptively similar trademark 'BUPRO'?
- Whether the plaintiff is entitled to any relief?

Applicable Rule

- 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 20 of Civil Procedure Code 1908



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Ratio

- Relying on the plaintiff's contention the court observed that there is a clear possibility of confusion between marks of plaintiff and that of defendant. It was observed that there were sufficient chances of deception or confusion as merely one or two letters were missing in both marks. Furthermore, the court observed that there was a lack of bona fide intention on part of defendant, which would definitely cause confusion among the general public/consumer. Therefore, the plaintiff was entitled to relief of prohibitory as well as mandatory injunction.
- The Court delved upon Section 20 of Code of Civil Procedure, pointing out that it is always open to the plaintiff to choose a Court where the jurisdiction had either arisen in full or a part of the cause of action has arisen. For Intellectual property infringement suit, the jurisdiction will have to be decided in conjunction with the relevant provisions of the Trade Marks Act, which deal with the said rights. Relying over Section 134(2) of the Trade Mark Act, the Court noted that the Trade Mark Act, which is a special legislation gives an additional option to the plaintiff to sue from a place where it carries on business and therefore, once the plaintiff is found to be carrying on business from within the jurisdiction of this Court, this Court would be perfectly justified in entertaining the suit.

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6. Exxon Mobil Corporation v. Mobilfuels Private Limited & Anr

CS (Comm) No. 608 of 2021

Decided on 29.11.2021

Parties

- The Plaintiff, Exxon Mobil Corporation is an American multinational oil and gas corporation headquartered in Irving, Texas.
- The Defendant, Mobil fuels Private Limited is in the business of fuel supply chain connecting number of outlets and vendors.

Brief Facts

- The plaintiff filed a trademark infringement suit at the Delhi High Court against the defendant for using MOBIL as part of the defendant's trade mark MOBILFUELS/ used in relation to a Mobile App available for download on the Google Play Store all over the country and in relation to door step fuel delivery services, the trade names MOBILFUELS PRIVATE LIMITED and MOBILFUELS SERVICES LLP and the domain name www.mobilfuels.com by the defendants.

The ExxonMobil logo, featuring the word "Exxon" in red and "Mobil" in blue, with a red and blue checkmark-like symbol above the "x" in Exxon.

Plaintiff's Mark



Defendant's Mark

Issues

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

Applicable Rule

- Section 29 of The Trade Marks Act, 1999
- Section 135 of The Trade Marks Act, 1999.

Ratio

- The court, in the absence of a response from the defendant, granted ex-parte injunction restraining the defendant from using its marks MOBILFUELS until the next hearing.

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7. United Spirits Limited vs Som Fragrances Private Limited and Others

CS (Comm) No. 420 of 2020

Decided on 28.04.2021

Parties

- The Plaintiff, United Spirits Limited, is a leading alcoholic beverage company and manufacturer of premium brands
- The Defendant, Som Fragrance Private Limited, is involved in the manufacture of tobacco and tobacco related products.

Brief Facts

- The plaintiff and defendant entered into a settlement agreement for use of the plaintiff's well known trade mark 'Signature'. Plaintiff introduced trade mark Signature in 1993 for their iconic green coloured octagonal bottles. The mark stands registered since 1994 in Class 33. Representative of plaintiff found the use of the mark SIGGNATURE for pan masala product in 2018. Cease and Desist Notice were served and thereafter, defendant executed an Undertaking dated 14.03.2019 acknowledging that the plaintiff is the exclusive proprietor of the Trade mark. Later, plaintiff argued that the defendant has breached the settlement agreement and filed a suit for ad interim injunction against the defendant for use of the said mark at the Delhi High Court.



Plaintiff's Mark



Defendant's Mark

Issues

- Whether the plaintiff can be granted injunction against defendant for the use of its well-known mark?

Applicable Rule

- Section 29(4) of The Trade Marks Act, 1999.
- Section 135 of The Trade Marks Act, 1999



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Ratio

- The court validated the settlement agreement and asked the defendant to use the trademark, Signature, in line with the settlement agreement. While, the court acknowledged the principles of a well known mark, but did not injunct the defendant from using the said mark on its tobacco and tobacco related products.



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8. Kaira District Cooperative Milk Producers Union Ltd and Anr. V/S. Maa Tara Trading Co. and Ors.

CS (Comm) No. 107 of 2020

Decided on 22.03.2021

Parties

- The Plaintiff, Kaira District Cooperative Milk Producer Union Ltd., popularly known as Amul is one of the largest producers of milk and milk related products in the world and is headquartered at Anand, Gujarat.
- The Defendant, Maa Tara Trading Co., is a manufacturer of jaw crusher, vibro feeder, impact mill, drum magnet, box and bench magnet headquartered at Andal, West Bengal.

Brief Facts

- The plaintiff, who is the proprietor of trademark 'Amul' contended that defendants were incorporating the 'Amul' trademark in the labels of candles being marketed by them, which also had a deceptively similar font. This was alleged to be an act of trademark infringement and the suit was filed at the Calcutta High Court. The counsel of plaintiff pointing towards the fact that 'Amul' being the well-known trademark makes this case an important development towards the well-known trademark and the list of the well-known trademark as maintained by the TM registry.



Issues

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

Applicable Rule

- Section 29 of the Trade Marks Act, 1999



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Ratio

- The court ordered in favour of plaintiff and granted temporary injunction restraining the defendant from using the 'Amul' mark, until the disposal of suit. The Court further observed, that there is substance in the contention of the plaintiff that, the defendant is seeking to ride on the business goodwill of the plaintiffs in marketing the products of the defendants.



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9. Sony Corporation vs. K. Selvamurthy

CS (Comm) No. 8464 of 2018

Decided on 18.06.2021

Parties

- The Plaintiff, Sony Corporation, is a multinational corporation and is one of the world's largest manufacturers of electronic products.
- The defendant, K Selvamurthy, is engaged in the business of transport services and car rental services under the trading name M/s. Sony Tours and Travels.

Brief Facts

- The Plaintiff filed a trademark infringement suit at the Bangalore District Court against the defendant claiming dilution of its well-known trademark 'SONY.' The defendant is a sole proprietor and runs a tour and travel business under the name Sony Tours and Travels.

SONY

Issues

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

Applicable Rule

- Section 29 of The Trade Marks Act, 1999.
- Section 135 of The Trade Marks Act, 1999.

Ratio

- The District Court observed that the defendant had not taken any unfair advantage or caused any detriment to the reput of plaintiff's SONY mark. The business of Sony Corporation is limited to electronics products and the defendant is into the tours and travel business, which can be easily differentiated. The use of Sony by the defendant, in no way can cause confusion to the consumer. The Plaintiff was also directed to pay costs amounting to INR 25,000 to the Defendant for filing a suit after a long delay and dragging a smaller entity through court proceedings.

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10. Sun Pharmaceutical Industries Limited vs Cipla Limited

CS (Comm) No. 176 of 2021

Decided on 27.05.2021

Parties

- The Plaintiff, Cipla Limited, develops medicine to treat respiratory, cardiovascular disease, arthritis, diabetes, weight control and other medical conditions
- The defendant, Sun Pharma manufactures and sells pharmaceutical formulations and active pharmaceutical ingredients

Brief Facts

- The Respondent/Plaintiff filed a suit at the Madras High Court, for a permanent injunction against the defendant owing to the alleged infringement of its copyright and trademark. It alleged substantial imitation of artistic packaging, trade dress, and labels of Cipla's 'BUDECORT RESPULES' and 'DUOLIN RESPULES'



Issues

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

Applicable Rule

- Section 29 of The Trade Marks Act, 1999.
- Section 17B(e) of The Drugs and Cosmetics Act, 1940

Ratio

- The Court granted a relief in terms of interim injunction in favour of plaintiff/respondent. Thereafter, for vacating the interim relief the defendant/applicant filed three applications on grounds of urgency since these drugs were in demand due to ongoing pandemic. The Court however did not interfere with the interim order stating that the balance of convenience was in the favour of plaintiff/respondent. The Court upheld the order by observing that even though the country is facing a crisis, they could not allow a party to violate another person's IPR.

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11. Franco Indian Pharmaceuticals Pvt. Ltd. vs Micro Labs Limited and Anr.

CS (Comm) No. 12337 of 2021

Decided on 14.06.2021

Parties

- The plaintiff, Franco Indian Pharmaceuticals, is engaged in the business of manufacturing of pharmaceuticals medicines.
- The Defendant, Micro Labs, is a multi-faceted healthcare organization, having its manufacturing facilities and R&D centres.

Brief Facts

- One of the products of the Plaintiff Company is sold under the registered mark DEXORANGE. The product is sold in a uniquely shaped bottle. The plaintiff filed a suit against the defendant at the Bombay High Court seeking interim injunction against the use of the mark FERRI ORANGE by the defendants claiming infringement of its trade mark and trade dress.



Issues

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

Applicable Rule

- Section 29 of The Trade Marks Act, 1999.
- Section 135 of The Trade Marks Act, 1999.

Ratio

- The Court granted an ex-parte injunction in favour of plaintiff for the word and label mark Dexorange and trade dress of the bottle. The Court observed that the plaintiff has been using the same for more than 50 years and holds several registrations for the same. It was further observed that a permanent injunction was earlier granted against the defendant and as defendant's dishonest behaviour was apparent by its conduct, the Court found it appropriate to grant an ex-parte injunction.

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12. M/S. Dabur India Limited vs. Bison Laboratories Private Limited

CS (Comm) No. 919 of 2001

Decided on 22.06.2021

Parties

- The Plaintiff, Dabur India Limited, manufactures Ayurvedic goods and natural consumer goods.
- The Defendant, Bison Laboratories Private Limited, is engaged in manufacturing of chemical products.

Brief Facts

- The plaintiff was having a registered trademark 'ODOPIC.' The plaintiff filed a suit for permanent injunction, at the Madras High Court, for restraining defendant against the use of mark 'ODOSOL.'



Plaintiff's Mark



Defendant's Mark

Issues

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

Applicable Rule

- Section 29 of The Trade Marks Act, 1999.

Ratio

- The Court granted a permanent injunction against the use of the mark, ODOSOL, by the defendant for cleaning preparations. The Court observed that the mark is confusingly and deceptively similar to the mark ODOPIC. The Court also acknowledged that a past injunction was operating against the defendant and thus granted a permanent injunction in favour of Plaintiff.

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13. V Guard Industries Ltd vs Sukan Raj Jain & Anr.

CS (Comm) No. 25 of 2021

Decided on 05.07.2021

Parties

- The Plaintiff, V Guard Industries Ltd., is a company with its registered office in Kerala and is engaged in the business of manufacturing, distribution, and marketing/selling electrical goods
- The Defendant, Sukan Raj Jain, is the sole proprietor of M/s N-Guard Electronic Industries, which has its registered office in Karnataka.

Brief Facts

- The plaintiff filed a suit against the defendant, at the Delhi High Court alleging trademark infringement owing to the use of mark 'N-Guard' by the defendant. The Court issued ex-parte ad interim injunction against the defendant restraining it from using the mark. The defendant challenged the territorial jurisdiction of the Court contending that no cause of action had arisen in the territory.



Plaintiff's Mark



Defendant's Mark

Issues

- Whether the Court has the territorial jurisdiction in the present case?

Applicable Rule

- Section 29 of The Trade Marks Act, 1999
- Section 134 of The Trade Marks Act, 1999
- Section 62 of The Copyright Act, 1908
- Section 20 of Civil Procedure Code, 1908



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Ratio

- The Court citing various cases observed that it had the territorial jurisdiction to adjudicate the case at hand because the plaintiff had its business in Delhi and the product bearing the mark was being advertised and sold in Delhi through online means. Court was satisfied with the initiation of infringement suit as per Section 134 of TM Act where the plaintiff resides or carries on business coupled with the fact that plaintiff had purchased defendant's product from Delhi from amazon.in. This is an important decision for product manufacturers to have strong agreements in terms of selling products to distributors, thereby clarifying territories. In case of failure, the companies can face litigation in areas where they do not intend to do business. Control over channels of distributors is an important part and must be complied with by all manufacturers.

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14. Frankfinn Aviation vs Fly High Institute & Ors.

CS (Comm) No. 25 of 2021

Decided on 05.07.2021

Parties

- The Plaintiff, Frankfinn Aviation, is a premium Air Hostess Training Institute and provides varied level of airhostess training.
- The Defendant, Fly High Institute, also provides various degrees, diplomas and certificate courses in Aviation, Tourism sectors.

Brief Facts

- The plaintiff is the holder of the registered trademark 'FLY HIGH' which was coined and created by the plaintiff in 2004 and enjoys a repute at national and international level. The plaintiff alleged that the defendant had been operating under registered domain name, www.flyhighinstitute.in. The plaintiff further asserted that the defendants were promoting their services on social media networks under the impugned trademark. The plaintiff filed the suit against the defendant seeking ad interim injunction against the use of the said mark.



Issues

- Whether the Court has the territorial jurisdiction in the present case?

Applicable Rule

- Section 29 of The Trade Marks Act, 1999
- Section 134 of The Trade Marks Act, 1999
- Section 62 of The Copyright Act, 1908
- Section 20 of Civil Procedure Code, 1908



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Ratio

- The Court granted ex-parte injunction in favour of plaintiff thereby restraining the defendant from using the mark on its websites, social media platforms or otherwise. The Court also acknowledged the fact that the plaintiff was using the mark from 2007 while the defendant was using it only from 2018. Acknowledging the irreparable harm, the court granted interim relief.





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15. Sony Pictures Network India Pvt. Ltd. vs. The State of Maharashtra and Anr.

Criminal Writ Petition Nos. 2929 and 2874 of 2021

Decided on 23.08.2021

Parties

- The Plaintiff, Sony Pictures, is a multinational corporation and is one of the world's largest manufacturer of electronics products.
- The Defendant is The State of Maharashtra

Brief Facts

- An FIR was filed by Karad Urban Co-operative Bank (KUCB) for defamation by the web series 'Scam 1992: The Harshad Mehta story,' which aired on SonyLIV App. The FIR accused Sony Pictures Network India Pvt. Ltd. and others of offences punishable under Section 500 of IPC and Sections 102 and 107 of the Trade Marks Act, and Sections 66C and 43(b) of the Information Technology Act.
- In its FIR, the bank alleged that in the third episode of the web series, a logo displayed in the background resembled its trademark, causing severe damage to its financial, commercial and social reputation. Aggrieved by the FIR the accused filed two criminal writ petitions seeking a stay on investigations.

Issues

- Whether an investigation can be done by an officer below the rank of Deputy Superintendent of Police as per Section 115(4) of the Trade Marks Act 1999?
- Whether a web series would come under the scope of Trade Marks Act, 1999?

Applicable Rule

- Section 102 of The Trade Marks Act 1999.
- Section 107 of The Trade Marks Act 1999.
- Section 115 of The Trade Marks Act, 1999.
- Section 66C of The Information Technology Act, 2000
- Section 43A of The Information Technology Act, 2000
- Section 500 of The Indian Penal Code, 1860
- Section 41A of The Code of Criminal Procedure, 1973



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Ratio

- The Court came to the conclusion that an investigation as per Section 115(4) of the Trade Marks Act, 1999, couldn't be done by an officer below the rank of Deputy Superintendent of Police, however the said FIR was being investigated by a police inspector.
- The Court stated that the web series did not come within scope of Trade Marks Act, 1999 based on Prateek Chandragupta Goyal Vs. The State of Maharashtra & Anr, wherein the same court held that mere use of trademark in an article does not amount to false application. Being satisfied by the grounds stated above, the Court stayed the investigation.



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16. Hindustan Unilever Limited v. Vansh Cosmetic and Anr

Commercial IP Suit (L) No. 15634 of 2021

Decided on 27.07.2021

Parties

- The plaintiff, Hindustan Unilever Limited, is a consumer goods company that manufactures foods, beverages, cleaning agents, personal care products.
- The defendant, Vansh Cosmetics, is also engaged in the business of personal care products.

Brief Facts

- The Plaintiff is the proprietor of various marks such as “LAKME”, “LAKME NINE TO FIVE, NINE TO FIVE”, “LAKME EYECONIC”, “LAKME ABSOLUTE”, “LAKME ABSOLUTE WHITE INTENSE.” The defendants were selling counterfeit cosmetic products under the brand name of LAKME, which the plaintiff alleged was blatant imitation and obvious copy of the artistic work. Hence, the plaintiff filed the suit at the Bombay High Court.

LAKMĒ

Issues

- Whether the defendant has infringed the plaintiff's trademark through selling of counterfeit products?

Applicable Rule

- Section 29 of The Trade Marks Act, 1999
- Section 135 of The Trade Marks Act, 1999.
- Section 28 of The Trade Marks Act, 1999.



A Holistic Compendium: Indian Trade Mark Cases Summary for 2021-2022

Ratio

- The Court going through various evidences, found a clear case of prima facie infringement of the trademarks and copyrights owned by the Plaintiff. Moreover, owing to the fact that the plaintiff has used the mark at a much larger scale, the Court noticed that the deceptive similarity between the two can not be mere coincidence. Therefore, the court granted an ex-parte ad interim order restraining the Defendant from manufacturing/ packaging/ printing/ selling/ distributing any counterfeit products/goods bearing marks deceptively similar to the Plaintiff's registered marks.
- The Court, moreover, appointed a receiver for receiving the defendants' counterfeit goods bearing the impugned marks.

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17. Prince Pipes and Fittings Limited vs Prince Platinum Pipes and Fittings

Commercial IP Suit (L) No. 5286 of 2021

Decided on 10.03.2021

Parties

- The Plaintiff, Prince Pipes and Fittings Limited, is one of the largest PVC manufacturers and multi polymer processor.
- The Defendant, Prince Platinum Pipes and Fittings, is the client-centric manufacturer and supplier firm of modern day CPVC and UPVC Pipe Fittings.

Brief Facts

- The plaintiff adopted its mark 'PRINCE' since 1996 which it uses in conjunction with a crown device as a registered trade mark in relation to its PVC pipe products. Having obtained series of registration from 2014 of its 'Prince' mark and logo, the plaintiff claimed that it has the legal right to display its mark on every unit or segment of the supplied products. The defendant, on the other hand, uses the mark "PRINCE PLATINUM" to trade the goods and also created a website with domain name "www.princeplatinumplastindia.com" for trading the goods similar to plaintiff. Also, one of the dealers of plaintiff asked for the platinum products building a strong prima facie evidence of actual deception and confusion. The plaintiff moved to Bombay High Court against the defendant's usage of the mark.



Plaintiff's Mark



Defendant's Mark

Issues

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

Applicable Rule

- Section 29 of The Trade Marks Act, 1999.
- Section 30 of The Trade Marks Act, 1999.



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Ratio

- The Court gave an order in favour of plaintiff thereby restraining defendant from using the impugned trade mark “Prince Platinum” and also the impugned domain name “www.princeplatinumplastindia.com.” Moreover, the Court restrained the use of business name “Prince Platinum Pipe & Fittings.” The Court also restrained the defendant from using business name/trading style containing the word PRINCE and/or any other trade mark, domain name or business name/trading style identical with and/or deceptively similar to the Plaintiff’s well-known trade mark “PRINCE” in respect of plaintiff’s business.
- The Court, also appointed a receiver for receiving the defendants’ goods, stamps, printing materials, labels, brochures, pamphlets, flyers, advertising material, papers, stationery, printed matter, things and such material and documents of the Defendants bearing or containing the impugned trade mark “PRINCE PLATINUM”.

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18. Saint-Gobain India Private Ltd. vs Geeta Kaler & Ors.

Commercial IP Suit (L) No. 17388 of 2021

Decided on 27.09.2021

Parties

- The Plaintiff, Saint-Gobain, designs, manufactures and distributes materials and solutions for Homes, Commercial space, Automotive industry, industrial application. It manufactures insulation systems, glass, building materials, water supply systems etc.
- The Defendant is Geeta Kaler

Brief Facts

- The plaintiffs 1 to 4, in the present case, were English, French, UK and Indian Companies. These companies are the part of Saint-Gobain Group of corporate entities. All companies mainly deal in manufacturing of insulation systems, glass, building materials, water supply systems and so on across many international jurisdictions. The plaintiff no. 1 has a registered mark "GYPROC". Plaintiff No. 2 has the registered mark "SAINT-GOBAIN and label "SAINT-GOBAIN." The Defendant filed for registration of the mark "GYPROCK", which was objected. The Defendant further did not respond to the plaintiff's cease and desist notice. Moreover, the defendant filed another mark "SAND GOVIND GYPROCK" which was abandoned post plaintiff's opposition proceeding.
- In 2020, the Plaintiffs discovered that the Defendant had tried to trade under the marks "GYPROCK" and "SAND GOVIND GYPROCK" again. Hence, the plaintiffs filed a suit at the Bombay High Court against the defendant.



Issues

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



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Applicable Rule

- Section 29 of The Trade Marks Act, 1999.
- Section 135 of The Trade Marks Act, 1999.

Ratio

- The Court gave an order in favour of plaintiff thereby restraining defendant from using the impugned trade mark “Prince Platinum” and also the impugned domain name “www.princeplatinumplastindia.com.” Moreover, the Court restrained the use of business name “Prince Platinum Pipe & Fittings.” The Court also restrained the defendant from using business name/trading style containing the word PRINCE and/or any other trade mark, domain name or business name/trading style identical with and/or deceptively similar to the Plaintiff’s well-known trade mark “PRINCE” in respect of plaintiff’s business.
- The Court, also appointed a receiver for receiving the defendants’ goods, stamps, printing materials, labels, brochures, pamphlets, flyers, advertising material, papers, stationery, printed matter, things and such material and documents of the Defendants bearing or containing the impugned trade mark “PRINCE PLATINUM”.

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18. Pidilite Industries Limited v. Platinum Waltech Limited

Commercial IP Suit (L) No. 10568 of 2021

Decided on 24.08.2021

Parties

- The Plaintiff, Pidilite Industries, is an Indian adhesives manufacturing company. It manufactures products which can be segmented into consumer products, art materials and stationary, food and fabric care etc.
- The Defendant, Platinum Waltech Limited, is a Rajasthan based leading manufacturer, marketer & exporter of building material products like-Wall Putty, Decorative White cement, Exterior Cement Paint, Water Proof compound, Cement Primer, Oil Bond Distemper, and P.O.P. etc

Brief Facts

- In this case, Plaintiff is a well-known manufacturer of products concerning construction and paint industry, having a worldwide presence since 1969. “DR FIXIT” is one of the registered marks of the plaintiff with a distinctive device of a man wearing a yellow construction helmet and product identification marks including LW+, LW, URP, PIDIPROOF. Later, the plaintiff came across the product of defendant having a strong similarity with that of plaintiffs. The product also contained the mark LWC which was deceptively similar to the plaintiff’s mark. Given such resemblance, the plaintiff filed a suit against the defendant, at the Bombay High Court, seeking relief pertaining to trademark, copyright, and design infringement along with the passing off.



Plaintiff's Mark



Defendant's Mark



A Holistic Compendium: Indian Trade Mark Cases Summary for 2021-2022

Issues

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

Applicable Rule

- Section 29 of The Trade Marks Act, 1999.
- Section 135 of The Trade Marks Act, 1999.

Ratio

- Applying the test of average intelligence and imperfect recollection, the Court observed that the container used by the defendant was a dead giveaway. Doubting the bona fide nature of the defendant, the Court found no reason for adoption of a strikingly similar container. Disagreeing with the defendant's contention that LWS mark was descriptive, the Court ruled that the intention of the defendant was not to use the expression "liquid waterproof compound" rather to use a similar mark which was registered by the plaintiff. Even the device of a man that was portrayed by the defendant was also similar to the DR FIXIT device. Finally, the court granted injunction in favour of plaintiff and restrained the defendant from using the mark and further ordered it to pay Rs. 2.5 lakh to the plaintiff within two weeks.



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Reference

- **Barcodes starting with specific codes are entitled to Trade Mark Protection.[1]**

The Court granted the ex-parte injunction in favour of plaintiff and ordered the websites to be blocked. Since the websites in question allocated barcodes starting with numbers '890', which did not originate from GS1 India and were non-compliant with GS1 standards, the Court observed that due to the misrepresentation by defendants, innocent customers were made to believe that the barcodes so allocated originated from GS1. The Hon'ble Court also observed that "It is manifest that defendants No. 1 who is supposed to be an entity based outside the country is bent on carrying on its illegal activities by mischievously and falsely allocating bar codes starting from '890' illegally to innocent third parties."

- **Offenses pertaining to Copyright Infringement and applying False Trade Marks are cognizable and non-bailable.[2]**

The Court, while dealing with the matter, held that offences under The Copyright Act, 1957 and falsely applying for a trademark under The Trade Marks Act are non-bailable as they attract up to three years of punishment, and in such cases, the punishment can be exactly three years. Referring to relevant the CrPC schedule, the Court noted that if an offence under any law, other than the IPC, is punishable with imprisonment for three years then it is cognizable and non-bailable.

- **Disputes arising out of and involving questions of interpretation of terms of License Agreements are arbitrable in nature.[3]**

The Court after dealing with the judgments on point noted that actions in rem including grant and issue of patents and registration of trademarks are exclusive matters falling within the sovereign and government functions and have erga omnes effect.

[1] GS1 India vs. Global Barcodes SL & Ors. CS(COMM) 147/2020

[2] Piyush Subhashbhai Ranipa vs. The State of Maharashtra. ANTICIPATORY BAIL APPL. NO. 336 OF 2021

[3] M/s Golden Tobie Pvt. Ltd. vs. M/s Golden Tobacco Ltd. CS(Comm) No. 178/2021



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Reference

Such grants confer monopolistic rights, and they are non-arbitrable. A co-ordinate bench of Delhi High Court had in Hero Electric Vehicles Pvt. Ltd. decision (2021 SCC Online Del 1058) held that non-arbitrability may be said to exist where inter alia the cause of action and subject matter of the dispute relate to inalienable sovereign and public interest functions of the State, not amenable to adjudication by the arbitral process. In view of the above decision, it was observed that the disputes in question solely involved interpretation of terms of the Agreements executed between the parties therefore, the rights asserted by the Plaintiff emanated from such agreements alone and not from any statutory law including the Trade Marks Act, 1999. Since the disputes did not involve any exercise of sovereign functions of the State, therefore such disputes were held to be arbitrable in nature.

- **By misspelling "Pay" as "Pe", the legal position cannot change. The term would remain descriptive and not be entitled to Trade Mark Protection as a result.[4]**

It was held that "PhonePe" and "BharatPe" are both composite marks therefore these marks cannot be dissected into "Phone" and "Pe" and "Bharat" and "Pe" respectively. The Court observed that no exclusivity can be claimed over the "Pe" suffix as it forms only a part of the registered trademark and as per settled principles of Trade Mark Law, infringement cannot be claimed over or on the basis of isolated elements of registered Trade Marks. It was an admitted position that the term 'Pe' connotes the expression and meaning 'Pay'. In this context, it was observed that both the plaintiff and the defendant were engaged in the services of online payments and the expression "pay" thus was clearly descriptive of the services offered by them. Since no protection is generally granted to descriptive words, like 'pay' in the instant case, the court held that "By misspelling "Pay" as "Pe", the legal position cannot change.

[4] PhonePe Private Limited vs. Ezy Services & Anr. CS(COMM) NO. 292 OF 2019



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Reference

The plaintiff would, therefore, be as entitled to claim exclusivity over the suffix "Pe", as it would have been, had the suffix in its trademark been "Pay"." As a consequence, injunctive reliefs as prayed for were not granted to the Plaintiff.

- **There is a likelihood of confusion if merely one or two letters are missing in the marks in dispute.[5]**

Relying on the plaintiff's contention the court observed that there is a likelihood of confusion between marks of plaintiff and that of defendant. There were chances of deception or confusion between the marks as there were only one or two letters that were missing in the marks in question. Moreover, the court observed that there was lack of bona fide intention on part of defendant, which would definitely cause confusion among general public or consumer. Therefore, the plaintiff was entitled to relief of prohibitory as well as mandatory injunction.

- **Any logo deceptively similar to the plaintiff's mark will amount to infringement.[6]**

The court, in the absence of a response from the defendant, granted ex-parte injunction restraining the defendant from using its marks MOBILFUELS until the next hearing.

- **Settlement agreement entered between the parties in relation to the use of marks must be obeyed.[7]**

The court validated the settlement agreement and asked the defendant to use the trademark Signature, in line with the settlement agreement. The court acknowledged the principles of well-known marks but did not injunct the defendant from using the mark its tobacco and tobacco related products.

[5] Sun Pharma Laboratories Limited vs D. D. Pharmaceuticals Private Limited. CS NO.687 of 2014

[6] Exxon Mobil Corporation v. Mobilfuels Private Limited & Anr CS (Comm) No. 608/2021

[7] United Spirits Limited vs Som Fragrances Private Limited and Others CS (Comm)No. 420/2020



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Reference

- **Since the plaintiff's mark is a well-known mark, the defendant cannot be allowed to ride over the goodwill of plaintiff.[8]**

The court ordered in favour of plaintiff and granted temporary injunction restraining the defendant from using the 'Amul' mark, until the disposal of suit. The Court further observed that there is substance in the contention of the plaintiff that the defendant is seeking to ride on the goodwill of the plaintiff's business while marketing its products.

- **Business of Plaintiff which is limited to one sector cannot cause confusion among the consumer in relation to the marks used for other sectors.[9]**

The District Court observed the defendant has not taken any unfair advantage or caused any detriment to the reputation of plaintiff's SONY mark. The business of Sony Corporation is limited to electronics products and the defendant is into the tours and travel business, which can be easily differentiated. The use of Sony by the defendant, in no way can cause confusion to the consumer.

- **Country being hit by the pandemic is no reason to violate or infringe upon other person's IP Rights.[10]**

The Court granted relief in terms of interim injunction in favour of plaintiff/respondent. Thereafter, for vacating the interim relief the defendant/applicant filed three applications on grounds of urgency since these drugs were in demand due to ongoing pandemic. The Court however did not interfere with the interim order stating that the balance of convenience was in the favour of plaintiff/respondent. The Court upheld the order by observing that even though the country is facing a crisis, they could not allow a party to violate another person's IPR.

[8] Kaira District Cooperative Milk Producers Union Ltd and Anr. V/S. Maa Tara Trading Co. and Ors CS(COMM) No.107 /2020

[9] Sony Corporation vs. K. Selvamurthy Com. O.S. No. 8464/2018

[10] Sun Pharmaceutical Industries Limited vs Cipla Limited. CS NO. 176 of 2021



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Reference

- **Use of Plaintiff's mark by the defendant despite knowing that the plaintiff has been using the same for more than 50 years demonstrates the dishonest intention of the defendant[11].**

The Court granted the ex-parte injunction in favour of plaintiff for the word and label mark Dexorange and trade dress of the bottle. The Court observed that the plaintiff has been using the same for more than 50 years and holds several registrations for the same. The court observed that a previous permanent injunction was earlier granted against the defendant, and as defendant's dishonest behavior was apparent, the Court granted an ex-parte injunction against it.

- **The marks which are confusingly and deceptively similar to a registered mark can cause confusion among the consumer.[12]**

The Court granted a permanent injunction against the use of the mark, ODOSOL, by the defendant for cleaning preparations. The Court observed that the mark is confusingly and deceptively similar to that of mark ODOPIC. The Court also acknowledged that a past injunction was operating against the defendant and granted a permanent injunction.

- **Court will have the territorial jurisdiction even if the goods are sold through online mode in that area[13].**

The Court citing various cases observed that it had the territorial jurisdiction because the plaintiff had a business in Delhi, and because the product bearing the mark was also being advertised and sold in Delhi through online means.

[11] Franco Indian Pharmaceuticals Pvt. Ltd. vs Micro Labs Limited and Anr. Commercial IP Suit (L) No. 12337 OF 2021

[12] M/S. Dabur India Limited vs. Bison Laboratories Private Limited Commercial IP Suit (L). No. 919 of 2001

[13] V Guard Industries Ltd vs Sukan Raj Jain & Anr. CS(COMM) 25/2021



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Reference

- **Defendant cannot be allowed to use the mark of plaintiff knowing that the plaintiff has been using the marks for long and that too for the same services[14].**

The Court granted ex-parte injunction in favour of plaintiff thereby restraining the defendant from using the mark on its websites, social media platforms or otherwise. The Court also acknowledged the fact that the plaintiff was using the mark from 2007 while the defendant was using only from 2018. Acknowledging the irreparable harm that might be caused, the court granted interim relief.

- **Mere use of trademark in a web series does not amount to false application[15].**

The Court stated that the web series did not come within scope of Trade Marks Act, 1999 based on Prateek Chandragupta Goyal Vs. The State of Maharashtra & Anr, wherein the same court held that mere use of trademark in an article does not amount to false application. Being satisfied by the grounds stated above, the Court stayed the investigation.

- **Deceptive similarity with a mark, which the plaintiff has been using for long, cannot be mere coincidence. Defendant restrained of trading in counterfeit goods.[16]**

The Court going through various evidences, found a clear case of prima facie infringement of the trademarks and copyrights owned by the Plaintiff. Moreover, owing to the fact that the plaintiff has used the mark at a much larger scale, the Court noticed that the deceptive similarity between the two cannot be mere coincidence. Therefore, the court granted an ex-parte ad interim order restraining the Defendant from manufacturing/ packaging/ printing/ selling/ distributing any counterfeit products/goods bearing marks deceptively similar to the Plaintiff's registered marks.

[14] Frankfinn Aviation vs Fly High Institute & Ors. CS (COMM) 25/2021

[15] Sony Pictures Network India Pvt. Ltd. vs. The State of Maharashtra and Anr. Criminal Writ Petition Nos. 2929 and 2874 of 2021

[16] Hindustan Unilever Limited v. Vansh Cosmetic and Anr COMMERCIAL IP SUIT (L) NO.15634 OF 2021



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Reference

- **Deceptive similarity with the mark established. Defendant restrained of trading counterfeit goods bearing the mark[17].**

The Court gave an order in favour of plaintiff thereby restraining defendant from using the impugned trade mark “Prince Platinum” and also the impugned domain name “www.princeplatinumplastindia.com.” Moreover, the Court restrained the use of business name “Prince Platinum Pipe & Fittings.” The Court also restrained the defendant from using business name/trading style containing the word PRINCE and/or any other trade mark, domain name or business name/trading style identical with and/or deceptively similar to the Plaintiff’s well-known trade mark “PRINCE” in respect of plaintiff’s business.

- **Taking undue advantage of the plaintiff’s repute and blatantly imitating plaintiff’s mark cannot be allowed.[18]**

The Court found sufficient evidence against the defendant that the mark being used by the defendant was a blatant imitation of the plaintiff’s mark. The Court acknowledged that the defendant’s similar mark is for the purpose of trading upon Plaintiffs’ hard-earned goodwill and reputation. Finally, the Court granted injunction restraining the Defendants from using the marks “GYPROCK”, “SAND GOVIND GYPROCK” or “SAND GOVIND GYPSUM CO” or the packaging/trade dress that might be similar or in any way identical to the registered marks “GYPROC”, “SAINT-GOBAIN” owned by the Plaintiff.

[17] Prince Pipes and Fittings Limited vs Prince Platinum Pipes and Fittings COMMERCIAL IP SUIT (L) NO. 5286 OF 2021.

[18] Saint-Gobain India Private Ltd. vs Geeta Kaler & Ors. COMMERCIAL IP SUIT (L) NO. 17388 OF 2021.



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Reference

- **Seeing through the eyes of a person with average intelligence, a container with similar design as that of plaintiff is enough to conclude trademark infringement[19].**

Applying the test of average intelligence and imperfect recollection, the Court observed that the container used by the defendant was a dead giveaway. Doubting the bona fide nature of the defendant, the Court found no reason for adoption of a strikingly similar container. Disagreeing with the defendant's contention that LWS mark was descriptive, the Court ruled that the intention of the defendant was not to use the expression "liquid waterproof compound" rather to use a similar mark which was registered by the plaintiff. Even the device of a man that was portrayed by the defendant was similar to the DR FIXIT device. Finally, the court granted injunction in favour of plaintiff and restrained the defendant from using the mark and also ordered to pay Rs. 2.5 lakh to the plaintiff within two weeks.

[19] Pidilite Industries Limited v. Platinum Waltech Limited COMMERCIAL IP SUIT (L) NO. 10568 OF 2021



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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.

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Glossary

I. Section 29 of The Trade Marks Act, 1999

Infringement of registered trademarks-

(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



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(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



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- (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 28 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 trademarks 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 trademarks 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.



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III. Section 30 of The Trade Marks 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;

(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;



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(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.

IV. Section 21 of Trademarks Act, 1999

Opposition to registration-



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(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.



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(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.

V. Section 31 of The Trade Marks Act, 1999

Registration to be prima facie evidence of validity-

(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.

VI. 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 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.

VII. 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



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(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.

VIII. Section 135 of The Trade Marks 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.

IX. Section 102 of The Trade Marks 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, -



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- (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.

X. Section 107 of The Trade Marks Act, 1999

Penalty for falsely representing a trade mark as registered. —

(1) No person shall make any representation—

- (a) with respect to a mark, not being a registered trade mark, to the effect that it is a registered trade mark; or
- (b) with respect to a part of a registered trade mark, not being a part separately registered as a trade mark, to the effect that it is separately registered as a trade mark; or
- (c) to the effect that a registered trade mark is registered in respect of any goods or services in respect of which it is not in fact registered; or
- (d) to the effect that registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitation entered on the register, the registration does not in fact give that right.

(2) If any person contravenes any of the provisions of sub-section (1), he shall be punishable with imprisonment for a term which may extend to three years, or with fine, or with both.



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(3) For the purposes of this section, the use in India in relation to a trade mark of the word “registered”, or of any other expression, symbol or sign referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except—

(a) where that word or other expression, symbol or sign is used in direct association with other words delineated in characters at least as large as those in which that word or other expression, symbol or sign is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside India being a country under the law of which the registration referred to is in fact in force; or

(b) where that other expression, symbol or sign is of itself such as to indicate that the reference is to such registration as is mentioned in clause (a); or

(c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside India and in relation solely to goods to be exported to that country or in relation to services for use in that country.

XI. Section 115 of The Trade Marks Act, 1999

Cognizance of certain offences and the powers of police officer for search and seizure-

(1) No court shall take cognizance of an offence under section 107 or section 108 or section 109 except on complaint in writing made by the Registrar or any officer authorised by him in writing:

Provided that in relation to clause (c) of sub-section (1) of section 107, a court shall take cognizance of an offence on the basis of a certificate issued by the Registrar to the effect that a registered trade mark has been represented as registered in respect of any goods or services in respect of which it is not in fact registered.

(2) No court inferior to that of a Metropolitan Magistrate or Judicial Magistrate of the first class shall try an offence under this Act.



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(3) The offences under section 103 or section 104 or section 105 shall be cognizable.

(4) Any police officer not below the rank of deputy superintendent of police or equivalent, may, if he is satisfied that any of the offences referred to in sub-section (3) has been, is being, or is likely to be, committed, search and seize without warrant the goods, die, block, machine, plate, other instruments or things involved in committing the offence, wherever found, and all the articles so seized shall, as soon as practicable, be produced before a Judicial Magistrate of the first class or Metropolitan Magistrate, as the case may be: Provided that the police officer, before making any search and seizure, shall obtain the opinion of the Registrar on facts involved in the offence relating to trade mark and shall abide by the opinion so obtained.

(5) Any person having an interest in any article seized under sub-section (4), may, within fifteen days of such seizure, make an application to the Judicial Magistrate of the first class or Metropolitan Magistrate, as the case may be, for such article being restored to him and the Magistrate, after hearing the applicant and the prosecution, shall make such order on the application as he may deem fit.

XII. Section 62 of The Copyright Act, 1999

Jurisdiction of court over matters arising under this Chapter-

(1) Every suit or other civil proceeding arising under this Chapter in respect of the infringement of copyright in any work or the infringement of any other right conferred by this Act shall be instituted in the district court having jurisdiction.



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(2) For the purpose 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 other 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.

XIII. Section 20 of The Code of Civil Procedure, 1908

Other suits to be instituted where defendants reside or cause of action arises-

Subject to the limitations aforesaid, every suit shall be instituted in a Court within the local limits of whose jurisdiction-

- (a) the defendant, or each of the defendants where there are more than one, at the time of the commencement of the suit, actually and voluntarily resides, or carries on business, or personally works for gain; or
- (b) any of the defendants, where there are more than one, at the time of the commencement of the suit, actually and voluntarily resides, or carries on business, or personally works for gain, provided that in such case either the leave of the Court is given, or the defendants who do not reside, or carry-on business, or personally works for gain, as aforesaid, acquiesce in such institution; or
- (c) The cause of action, wholly or in part, arises.

XIV. Section 2 (1)(zg) of The 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.



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XV. Section 17B of the Drugs and Cosmetics Act, 1940

Spurious drugs-

For the purposes of this Chapter, a drug shall be deemed to be spurious,-

- (a) if it is manufactured under a name which belongs to another drug; or
- (b) if it is an imitation of, or is a substitute for, another drug or resembles another drug in a manner likely to deceive or bears upon it or upon its label or container the name of another drug unless it is plainly and conspicuously marked so as to reveal its true character and its lack of identity with such other drug; or
- (c) if the label or container bears the name of an individual or company purporting to be the manufacturer of the drug , which individual or company is fictitious or does not exist; or
- (d) if it has been substituted wholly or in part by another drug or substance; or
- (e) if it purports to be the product of a manufacturer of whom it is not truly a product.

XVI. Section 500 of The Indian Penal Code, 1860

Punishment for defamation-

Whoever defames another shall be punished with simple imprisonment for a term which may extend to two years, or with fine, or with both

XVII. Section 41A of The Code of Criminal Procedure, 1973

Notice of appearance before police officer-

- (1) [The police officer shall], in all cases where the arrest of a person is not required under the provisions of sub-section (1) of section 41, issue a notice directing the person against whom a reasonable complaint has been made, or credible information has been received, or a reasonable suspicion exists that he has committed a cognizable offence, to appear before him or at such other place as may be specified in the notice.



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(2) Where such a notice is issued to any person, it shall be the duty of that person to comply with the terms of the notice.

(3) Where such person complies and continues to comply with the notice, he shall not be arrested in respect of the offence referred to in the notice unless, for reasons to be recorded, the police officer is of the opinion that he ought to be arrested.

(a) [(4) Where such person, at any time, fails to comply with the terms of the notice or is unwilling to identify himself, the police officer may, subject to such orders as may have been passed by a competent Court in this behalf, arrest him for the offence mentioned in the notice.

XVIII. Section 43A of The Information Technology Act, 2000

Compensation for failure to protect data-

Where a body corporate, possessing, dealing or handling any sensitive personal data or information in a computer resource which it owns, controls or operates, is negligent in implementing and maintaining reasonable security practices and procedures and thereby causes wrongful loss or wrongful gain to any person, such body corporate shall be liable to pay damages by way of compensation to the person so affected.

XIX. Section 66C of The Information Technology Act, 2000

Punishment for identity theft-

Whoever, fraudulently or dishonestly make use of the electronic signature, password or any other unique identification feature of any other person, shall be punished with imprisonment of either description for a term which may extend to three years and shall also be liable to fine which may extend to rupees one lakh.



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XX. Order XXVI Rule 9 of The Code of Civil Procedure, 1908

Commissions to make local investigations-

In any suit in which the Court deems a local investigation to be requisite or proper for the purpose of elucidating any matter in dispute, or of ascertaining the market-value of any property, or the amount of any mesne profits or damages or annual net profits, the Court may issue a commission to such person as it thinks fit directing him to make such investigation and to report thereon to the Court:

Provided that, where the State Government has made rules as to the persons to whom such commission shall be issued, the Court shall be bound by such rules.

XXI. Order XXXIX Rule 1 of The Code of Civil Procedure, 1908

Cases in which temporary injunction may be granted-

Where in any suit it is proved by affidavit or otherwise-

- (a) that any property in dispute in a suit is in danger of being wasted, damaged or alienated by any party to the suit, or wrongfully sold in execution of a decree, or
- (b) that the defendant threatens, or intends, to remove or dispose of his property with a view to [defrauding] his creditors,
- (c) that the defendant threatens to dispossess, the plaintiff or otherwise cause injury to the plaintiff in relation to any property in dispute in the suit,]

the Court may by order grant a temporary injunction to restrain such act, or make such other order for the purpose of staying and preventing the wasting, damaging, alienation, sale, removal or disposition of the property 1 [or dispossession of the plaintiff, or otherwise causing injury to the plaintiff in relation to any property in dispute in the suit] as the Court thinks fit, until the disposal of the suit or until further orders.