

#### FULL SERVICE IP AND CORPORATE/COMMERCIAL LAW FIRM

# IP ASSET MANAGEMENT AND LITIGATION SUPPORT PRACTICE



# A HOLISTIC COMPENDIUM HIGHLIGHTING KEY TRADE MARK LITIGATION CASES

For 2022-2023

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### A Holistic Compendium: Indian Trade-Mark Cases Summary for 2022-2023

#### Preface

The year 2022 witnessed significant IPR developments. The IPR regime underwent significant developments which contributed immensely to the interpretation of trademark laws and the determination of the legislature's intent. There was an increase in the number of IP litigations before the Courts of Law which brought about critical judgments. Staying true to the subject's essence, the courts reaffirmed and reiterated certain essential principles of trademark jurisprudence and also deliberated upon new principles. To mention a few:

- 1. The Hon'ble Court reiterated that trademark protection for shape marks is granted only under strict grounds. In the view of the Hon'ble Court, a shape mark can be registered as a trademark only if it acquires a secondary meaning.
- 2. The Hon'ble Court expressed its view that the phrase "SCHEZWAN CHUTNEY" referred to a sauce that has a flavor of "SCHEZWAN," rather than a distinct and unique product. The court also noted that if the protection of this trademark were to be granted, then other types of sauces, such as "Tamarind Chutney" or "Tomato Chutney," should also be eligible for similar protection.
- 3. It was observed by the Hon'ble Court that 'Rooh Afza' and 'Dil Afza' were not identical trademarks.
- 4. The Hon'ble Court observed that 'BUKHARA' was a well-known mark across the world and as such declared it to be well-known trademark under Section 2(zg) read with Section 11(2) of the Trademarks Act, 1999. In this regard, the Hon'ble Court directed the Registrar of Trade Marks to add 'BUKHARA' mark to the list of 'well-known trademarks.
- 5. It was held by the Hon'ble Court that the use of a trademark as a keyword on the Google Ads Program by any competitor amounts to trademark infringement.

This compendium aims to present summaries of significant judgments that reflect a range of issues discussed and adjudicated by the Indian judiciary in the year 2022 regarding the interpretation and implementation of various provisions of The Trade Marks Act, 1999.

#### A Holistic Compendium: Indian Trade-Mark Cases Summary for 2022-2023: Table of Content

S. No.	Content	Page No
1	List of Important Cases	3-5
2	Case Summaries	6-31
3	Reference	32-37
4	Disclaimer	38
5	Glossary	39-73

#### A Holistic Compendium: Indian Trade Mark Cases Summary for 2022-2023

### List of Important Cases on Trade Marks – 2022

S No	Торіс	Citation	Page No
1	For shape marks to be afforded protection, the shape must have lost its inherent or generic meaning and ought to have acquired a secondary connotation. The standard of distinctiveness required to be acquired is substantially high.	Knitpro International vs. Examiner of Trademarks through Registrar of Trademarks C.A. (COMM. IPD-TM) 110/2022	6
2	Granted protection to numeral mark "91" for bicycles and injuncted the defendant from using "99", accepting the plaintiff's argument that "9" is a dominant part of both marks.	Alphavector India Pvt Ltd vs. M/S Sach Industries & Ors. 2023/DHC/000823	7-8
3	Karnataka High Court held that a plaint seeking remedies against passing off can be amended to include remedy against infringement where cause of action is substantially identical and same in law.	Milaap Social Ventures India Pvt. Ltd vs. Google India Pvt. Ltd. Writ Petition No. 6220 of 2022	9-10
4	Held 'SCHEZWAN CHUTNEY' to be descriptive trade mark. The Court laid down certain principles that has to be considered if a mark falls within Section 9(1(a) to (c) of the Trade Marks Act, 1999.	Capital Food Private Limited vs. Radiant Indus Chem Pvt. Ltd. 2023/DHC/000224	11-12

#### A Holistic Compendium: Indian Trade Mark Cases Summary for 2022-2023

### List of Important Cases on Trademarks – 2022

S No	Торіс	Citation	Page No
5	Delhi High Court directed Trade Marks Registry to transfer five pending applications to itself upon the reasoning that if the Registrar of Trade Marks can refer the matter to court under Section 125(2) of the Act, they can also direct the same to itself and in commercial proceedings foremost consideration is expeditious disposal of cases.	Jumeirah Beach Resort LLC vs. Designarch Consultants Pvt Ltd & Anr C.O.(COMM. IPD- TM) 124/2022	13-15
6	The conjunctive "and" used in Section 29(4) and Section 30 of the Act indicates that all conditions and clauses of the sections has to be satisfied. The Hon'ble SC overturned High Court's decision stating that interpretation of section must depend on text and context and part of a section cannot be read in isolation.	Renaissance Hotel Holdings Inc. vs. B. Vijaya Sai and Ors. Civil Appeal no. 404 of 2022	16-17
7	The appellate court found that the mark 'DIL AFZA' was similar to 'ROOH AFZA'. The word 'AFZA' was considered as prominent amongst the marks and similarity amongst the marks was established.	Hamdard National Foundation (India) Vs. Sadar Laboratories Pvt. Limited FAO (OS)(COMM) 67/2022	18-20
8	Emphasizes the clean hands doctrine vis-à-vis trademark law. Cost of Rs 10 Lakhs were imposed on Plaintiff for concealing material facts	Sun Pharmaceuticals Industries vs. Dwd Pharmaceuticals Ltd, 2022/DHC/005037.	21-22

#### A Holistic Compendium: Indian Trade Mark Cases Summary for 2022-2023

### List of Important Cases on Trademarks – 2022

S No	Торіс	Citation	Page No
9	BUKHARA' as a well-known trade mark under Section 2(zg) read with Section 11(2) of the Trade Marks Act, 1999 and directed the Registrar of Trade Marks to add the mark 'BUKHARA' to the list of well-known trade marks.	ITC Ltd. vs. Central Park Estates Private Ltd, 2022 SCC OnLine Del 4132	23-24
10	Well-structured analysis of Section 29(4) and 29(5) of the Trade Marks Act. Explaining on the distinction between "marks with reputation" and "well known" marks, the Court observed that in order to establish infringement under Section 29(4), there is no requirement that the mark be recorded in the list of well-known trademarks.	RPG Enterprises Limited vs. Riju Ghoshal Trading As RPG, MANU/MH/0945/2022	25-27
11	The "invisible" use of a mark as a keyword by any person other than the Proprietor can amount to passing off as a matter of principle. The use of the Plaintiff's registered mark 'MakeMyTrip' on the Google Ads Program as a keyword would amount to trademark infringement.	MakeMyTrip India Private Limited Vs. Booking.Com B. V. & Ors, CS (COMM) 268/2022 & I.As. 6443- 47/2022	28-29
12	Reiterated that sporadic use of Trade Marks will not constitute continuous use	Ttk Prestige Ltd Vs. K K and Company Delhi Pvt Ltd & Ors. 2023/DHC/001280	30-31

# 1. Knitpro International vs. Examiner of Trademarks through Registrar of Trademarks

C.A. (COMM. IPD-TM) 110/2022

#### Decided on 13.07.2022

#### Parties

• The appellant applied for the registration of the shape of a knitting needle in class 26 in respect of 'Knitting needles and crochet hooks'.

• The respondent is the Examiner of Trademarks who rejected the application of the appellant.

#### **Brief Facts**

• The Learned Examiner rejected the appellant's application on the basis of lack of distinctive characteristics under sections 9(1)(a) and 9(1)(b) of the Trademarks Act, 1999.

• Aggrieved by the same, the appellant filed an appeal on the grounds that the knitting needle's shape is quite distinctive and has maintained its own goodwill and meaning.

#### Issues

Whether the impugned mark is distinctive and has acquired a distinctive meaning?

#### **Applicable Rule**

- Section 2(1)(m) of Trademarks Act, 1999.
- Section 9(1)(a) of Trademarks Act, 1999.
- Section 9(1)(b) of Trademarks Act, 1999.

#### Ratio

The court, while deciding the issue, reiterated the strict grounds for trademark protection of a shape mark. The hon'ble court stated that the novel shape of a product which has aesthetic appeal is protectable under the law of designs if the requisite conditions are satisfied. However, under the law of trademarks, the threshold for extending exclusive rights to the shape of a product is quite high. The shape by itself should immediately be identifiable with the source of the product without anything further appended on shape. For trade mark registration of the shape of a product, the same can only be granted if it has acquired a secondary meaning. Therefore, shape marks ought to have acquired a secondary connotation to be able to be registered.

# 2. Alphavector India Pvt Ltd vs. M/S Sach Industries & Ors. 2023/DHC/000823

#### Decided on 01.02.2023

#### **Parties**

• The plaintiff is a manufacturer and vendor of bicycles and accessories.

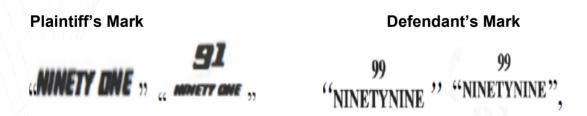
• the plaintiff is a registered proprietor of several marks featuring the number '91' in conjunction with words such as 'outdoors', 'cares', 'vector' and a 'V' logo.

- The defendants began using the mark SACHIN and its variations.
- The defendants also started using the marks NINETY-NINE and 99 on its Facebook page in July 2021.

#### **Brief Facts**

• The plaintiff filed a lawsuit alleging infringement and passing off before the Hon'ble court. It stated while no registration existed for the mark 91 per se, the defendants' use of the 99 marks on identical products amounted to infringement of the plaintiff's registered composite trademarks where '91' was a dominant element.

• The defendants responded by seeking to justify the use of the 99 marks on the grounds of priority of use. They contended that they were using the marks NINETY-NINE and 99 in conjunction with the words 'only' and 'Sachin' and were prior users of such marks.



#### Issues

Whether use of the mark '99/NINETY-NINE' amounts to the infringement of the plaintiff's mark?

#### **Applicable Rule**

• Section 29 of Trademarks Act, 1999.

#### Ratio

The court held that both numeral marks 91 and 99, whether used in word or numeral format, were arbitrary in respect of bicycles and bicycle accessories and entitled to protection under the Trademarks Act. Further, the use of the 99 marks without any plausible explanation – coupled with the fact that the first digit of the rival marks was '9' – clearly established the defendants' mala fide intent to ride upon the goodwill and reputation vesting in the plaintiff's marks. Prima facie it appeared that the plaintiff had acquired goodwill in its mark within a short period from 2020.

The court also applied the principles laid down in **Slazenger & Sons V. Feltham & Co.** and **Munday Vs. Carrey**, that are respectively as follows:

- (i) where there is clear imitation with an intent to deceive, the Court must not bend backwards to presume that the intent is not successful, and
- (ii) where there is intent to deceive, the Court must pay greater attention to the similarities between the competing marks.

The court also took note of the products' nature, observing that the people who bought the bicycles may have been deceived into believing that they originated from the same manufacturer and that the marks NINETY-NINE/99 and NINETY-ONE/91 are series marks.

### 3.Milaap Social Ventures India Pvt. Ltd vs. Google India Pvt. Ltd. Writ Petition No. 6220 of 2022 Decided on 23.11.2022

#### Parties

• The petitioner incorporated its office in Singapore and later in India filed a Trademark application for registration of the mark.

• Respondent No. 1 is Google India Private Limited and respondent No. 2 is Impact Guru Technology Ventures Private Limited.

#### **Brief Facts**

• The petitioner/plaintiff instituted a suit for injunction seeking the remedy of perpetual injunction against the respondents/defendants from passing off petitioners' trademark 'MILAAP'. It was alleged that the respondent No.2 was using the petitioner's mark 'MILAAP' to divert traffic to its own website crafted and designed by respondent No.1

• While the pendency of the suit, the petitioner's mark 'MILAAP' that was pending registration, came to be registered with Trademark No.3428351. In this scenario, the petitioner filed an application seeking amendment of plaint to include remedy of trademark infringement by the respondents by using the mark 'MILAAP' in its key words and metatags.

#### Issues

Whether the use of trademark 'MILAAP' amounts to infringement of plaintiff's rights?

#### **Applicable Rule**

- Section 2(1)(w) of Trademarks Act, 1999.
- Section 134(1)(c) of Trademarks Act, 1999.
- Section 28 of Trademarks Act, 1999.
- Section 20 of Civil Procedure Code, 1908.

#### Ratio

The Hon'ble High court found that the order of the trial court under challenge was unsustainable and erroneous. The Hon'ble Court observed that the plaintiff clearly indicated that their application seeking Trademark registration is pending consideration before the authority.

The defendants are opposing this application on the grounds that it adds a new cause of action that arose after the lawsuit was filed and, if it were to be approved, it would seriously infringe on the rights of the defendants.

When a trademark is not registered, a user of the trademark may file a passing-off lawsuit. The reality is that the plaintiff asserted that it has suffered as a result of the defendants passing on similar goods in an unfair manner as the plaintiffs. After the trademark is registered, a lawsuit for infringement on the same principle can be filed and when the cause of actions for passing off and infringement is substantially similar, both the reliefs are virtually based on the same idea. Thus, incorporating the remedy of infringement will not change the character of the suit in a fundamental sense and it is only in the nature of an alternate relief. It was observed that if the defendants' argument is accepted and the plaintiff is forced to file a second lawsuit, it will only result in a multiplicity of actions between the parties, which is something that should be avoided. Thus, it was concluded that the defendants failed to persuade the court of the reasons why the proposed modification cannot be considered in the current lawsuit.

# 4. Capital Food Private Limited vs. Radiant Indus Chem Pvt. Ltd. 2023/DHC/000224

#### Decided on 11.01.2023

#### **Parties**

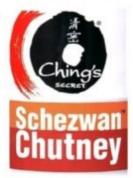
• The plaintiff is one of the leading food companies in India, engaged in the manufacturing and marketing a wide variety of dips, spreads, condiments, sauces, noodles, soups, pastes, dressings, ready-to-eat food products and other food preparations, for more than 25 years.

• The defendant is engaged in the business of manufacture and sale of food products such as jams, culinary sauces, Chinese sauces, mayonnaise, pickles, etc.

#### **Brief Facts**

• The plaintiff was the first to independently create the distinctive trade mark "SCHEZWAN CHUTNEY" for dips and spreads.

• The defendant was selling and offering for sale the contested item "MRS. FOODRITE SCHEZWAN CHUTNEY" on the online shopping site www.amazon.in in 2020 when the plaintiff discovered it. The defendants had obtained trade mark registrations for the same in different classes.





Defendant's Mark

### Plaintiff's Mark

#### Issues

- Whether the mark "SCHEZWAN CHUTNEY" is distinctive?
- Whether the defendant is infringing the rights of the plaintiff?

### Applicable Rule

- Section 9 of Trademarks Act, 1999.
- Section 30(2)(a) of Trademarks Act, 1999.
- Section 35 of Trademarks Act, 1999.

#### Ratio

This Court was asked to decide whether the mark "SCHEZWAN CHUTNEY" was descriptive of the in-question product. According to the court, "SCHEZWAN CHUTNEY" represented a "CHUTNEY" (sauce) with a "SCHEZWAN" flavour, and if protection were to be granted to such a mark, then similar protection should also be granted to "Tamarind Chutney" or "Tomato Chutney" as they were also made up of words from both English and Hindi. The phrase "SCHEZWAN CHUTNEY" also met the second requirement outlined in "McCarthy on Trade Marks," known as "The Competitors Need Test," meaning that the phrase was likely to be used by the rivals to describe their goods. The court considered that the use of house marks such as "Ching's" and "MRS. FOODRITE" to be important in distinguishing the source of the goods, while "Schezwan Chutney" only identified the nature of the product. Therefore, the plaintiff's request for a grant of an ad interim injunction barring the defendant from using the mark "SCHEZWAN CHUTNEY" or "SZECHUAN CHUTNEY" was denied.

### Jumeirah Beach Resort LLC vs. Designarch Consultants Pvt Ltd & Anr C.O.( COMM. IPD- TM) 124/2022 Decided on 28.11.2022 Parties

• Plaintiff is Jumeirah Beach Resort LLC ("Jumeirah") is an international hotel food chain.

 Defendant is Designarch Infrastructure Pvt. Ltd. ("Designarch") claiming to build a residential project under the mark BURJ NOIDA/Burj Noida

#### **Brief Facts**

• A petition has been filed by the plaintiff against the defendant alleging infringement and passing off by the defendant of the mark 'BURJ AL ARAV'.

• Further two other petitions, have been instituted by plaintiff against defendant, directed against the mark 'BURJ NOIDA' and the logo used by the defendant in that regard, seeking rectification of the register of trademarks and removal of the said mark from the Register of Trademarks. The said petitions were earlier pending before the Intellectual Property Appellate Board (the IPAB) and have been transferred to Delhi High Court Intellectual Property Division consequent to the enactment of the Tribunal Reforms Act, 2021.

• The defendant argued that already five rectification petitions in five different classes is pending before the Trademarks Registry seeking rectification/ removal of the plaintiff's mark 'BURJ AL ARAV'.

• A predecessor bench in the instant suit noted that it would be appropriate that the above-mentioned proceedings be transferred to the present Court, especially as the rectification/removal petitions filed by Jumeirah against Designarch before the IPAB already stood transferred.

#### Issues

Whether rectification/removal proceeding pending before the Registrar of Trademarks can be transferred to the IP Division of Delhi High Court?

#### **Applicable Rule**

Section 125 of Trademarks Act, 1999 Rule 26 of the Delhi High Court, IPD Rules, 2022

#### Ratio

The court remarked that all appeals before the IPAB stands transferred to the IP Division of Delhi High Court, consequent to the introduction of Tribunal Reforms Act, 2021. The present court was held effectively to be the successor of the IPAB with respect to appeals filed against decisions of the Registrar of Trademarks. As per Section 125(2) of the Trademarks Act, 1999, the Registrar of Trademarks is empowered, at any stage, to refer matter, in an appropriate case, to the IPAB. The jurisdiction, authority and powers of the IPAB having been transferred to the present Court it was interpreted that the Registrar can then exercise the power of reference of matters, in appropriate circumstances, to the present court. Further, the court while applying the same rationale, observed that, there is no reason why the present Court could not direct transfer of the matter to itself, especially where all other connected petitions, including petitions for passing off and cancellation/removal/rectification petitions instituted by Jumeirah against Designarch, which are pending before the IPAB, already stand transferred to this Court.

The plaintiff argued that the Rule 26 of the IPD Rules, envisages transfer/consolidation of any matter pending before the commercial court with a matter pending before the IPD. The plaintiff's submission was that, in stricto sensu, Registrar of Trademark cannot be considered as 'Commercial Court' and in that sense, consolidation of matters pending before the IPD and matters pending before the Registrar of Trademarks was not possible. However, the said submission was rejected.

Affirming the defendant's submission, it was opined by the court that the 'restrictive wording' of the second sentence in Rule 26 of the IPD Rules cannot restrict the ambit of the first sentence, which permits consolidation of "proceedings", "where there are multiple proceedings relating to the same or related IPR subject matter".

Prominently it was also observed that in all commercial matters, the subject of paramount consideration is expeditious and meaningful disposal of the proceedings, and isto ensure that all proceedings related to the subject matter of IPR are heard together. Confusion can occur in case where the rectification/removal proceedings instituted by Jumeirah against Designarch are taken up by the present Court and the counter proceedings for removal/rectification instituted by Designarch against Jumeirah pending before the Learned Registrar of Trademarks are allowed to continue before the Registry. Thus, in consideration of holistic decision of disputes, it was held that all proceedings shall be taken up together.

#### 6. Renaissance Hotel Holdings Inc. vs. B. Vijaya Sai and Ors.

### Civil Appeal no. 404 of 2022

#### Decided on 19.01.2022

#### **Parties**

• The appellant is the proprietor of the registered trademark "RENAISSANCE" for hotels, restaurants, bars, etc., and for the goods commonly found in its hotels.

• The respondent adopted the name "SAI RENAISSANCE" for hotels running for the last 15 years.

#### **Brief Facts**

• The appellant first filed the suit in the year 2009 to restrain the respondent from using the trademark "SAI RENAISSANCE" or any other trade mark identical with the appellant's trade mark.

• The appellant learned that the respondents had imitated their design and use of phrase "Renaissance" in order to operate two hotels.

• The respondent took the defense by claiming that the word "Renaissance" was a generic word and was used quite frequently.

• Also, respondent claimed that the appellant had not accrued any reputation for using it.

• The respondents claimed that they were not aware of the fact that appellant is using the Mark.

• Initially, the trial court restrained the respondents from using "RENAISSANCE" or any deceptively similar mark thereto. However, it rejected the claim of the appellant- for damages.

• The appellant appealed before the High Court and it decided in favour of the respondent stating that there is no infringement. The appellant aggrieved by the High Court's order approached the Supreme Court

#### Issues

Whether the use of 'SAI RENAISSANCE' amounts to infringement and appellant is entitled to damages?

#### **Applicable Rule**

- Section 29(2) of Trademarks Act, 1999.
- Section 29(3) of Trademarks Act, 1999.

#### Ratio

The Supreme Court observed that the Impugned Mark was identical to the Trade Mark and was being used in relation to identical services, and hence, there was a presumption of likelihood of confusion as per Section 29(3) of the Act. The Supreme Court further observed that the High Court erroneously relied upon Section 29(4)(c) of the Act standalone without taking into consideration sub-clauses (a) and (b) of Section 29(4) of the Act which makes it clear that Section 29(4) of the Act is applicable only when the rival goods / services are different. The Supreme Court also opined that in order to take avail the benefit of Section 30 of the Trademark Act, 1999, it is necessary to establish that the use of impugned mark is consistent with the honest practices in industrial or commercial matters in addition to establishing that the use of impugned trade mark did not take unfair advantage of or is detrimental to the distinctive character or repute of the trade mark. The Supreme Court reiterated that the basic tenet of interpretation of statutes that if the sub-clauses are separated by the word 'and' and not 'or', then all sub-clauses are to be considered cumulatively and not standalone.

# 7. Hamdard National Foundation (India) vs. Sadar Laboratories Pvt. Limited

FAO (OS) (COMM) 67/2022 Decided on 21.12.2022 Parties

- The appellant in this case is the Hamdard National Foundation (India), a charitable foundation that was established in 1906 by Hakeem Abdul Hameed.
- For almost a hundred years, the plaintiff has been involved in producing and distributing a range of products, including Unani and Ayurvedic medicines, oils, syrups, and non-alcoholic beverages.
- The respondent company, Sadar Laboratories Pvt. Ltd. has been in the business of making Unani medicines, syrups, and botanical items since 1949, through its progenitor, M/s. Sadar Dawakhana.
- Sadar adopted the mark 'Dil Afza' for one of its products.

#### **Brief Facts**

• An interim application was filed by the plaintiff alleging that the defendant has infringed its well-known trademark in 'Rooh Afza' and was passing off in the name 'Dil Afza'.

• It was claimed that in March 2020, the defendant launched a syrup/sharbat 'Dil Afza' with a mark, get-up and design deceptively similar to that of the plaintiff's.

• The defendant noted that the plaintiff did not hold separate registrations for 'Rooh' and 'Afza', thus could not claim a monopoly over the mark 'Afza' and that 'Afza' was not a distinctive word. The plaintiff argued that 'Dil' and 'Rooh' entail deep emotions and that the word 'Afza' is common to both. However, the single judge held that it would be an extreme position to assume that the use of the words 'Rooh' and 'Dil' would cause confusion to an ordinary consumer even if they denote similar meaning. It was remarked that there cannot be a confusion being created on account of the meaning of the two words.

• In view of the aforesaid reasoning, the application for seeking an

interim injunction, restraining the defendant from using the impugned trademark in respect of its products, was rejected. Aggrieved by the same, the appellant herein has filed the present suit seeking permanent injunction restraining the respondent from using the trade mark 'SHARBAT DIL AFZA/DIL AFZA' which is alleged to be deceptively similar to the registered mark 'ROOH AFZA'.



#### Issues

Whether the use of 'DIL AFZA' by the respondent amounts to infringement and passing off of the mark 'ROOH AFZA'?

#### **Applicable Rule**

• Section 29 of Trademarks Act, 1999.

#### Ratio

The court held that the commercial impression of the impugned trademark is deceptively similar to the appellants' trademark in consideration of various factors. First of all, it was stated that the impugned trademark has certain phonetic similarities in as much as the trademarks end with the word 'AFZA' and the last syllables in both the competing mark are thus similar. Secondly, the word 'AFZA' was identified as a prominent and significant part of the trademark 'ROOH AFZA' and contributes to the overall commercial impression of the trademark 'ROOH AFZA' as well as the impugned trademark. Thirdly, conceptual similarity between the words was also found to be existing, since, if a recall from memory is triggered by the English meaning of the words 'ROOH' and 'DIL', the fact that heart and soul is a commonly used phrase, provides a common conceptual background.

Finally, the trade dress, of the rival marks which includes the shape of the bottle, the overall design of the bottle, the placement of the house mark, the colorfully busy design of the label, all of them substantially contribute to the commercial impression of the marks and was held to be similar. Thus, the impugned order of the Learned Single judge was set aside and similarity amongst the rival marks was established.

# 8. Sun Pharmaceutical Industries Ltd vs. DWD Pharmaceuticals Ltd CS (COMM) 328/2022

#### Decided on 22.11.2022

#### Parties

• The plaintiff is the successor of 'Ranbaxy Laboratories Ltd.', who coined and adopted the trademark 'FORZEST' in 2003.

• Defendant is a leading manufacturer and distributor of pharmaceutical products in the domestic and international markets and is a registered proprietor of 'ZEST' formative marks.

#### **Brief Facts**

• The plaintiff submitted that the FORZEST mark of the plaintiff and the FOLZEST mark of defendant appeared to be confusingly similar. It was also submitted that the threshold of confusion is low in case of pharmaceutical goods, and the test of deceptive similarity is stringent, with public interest being paramount. The plaintiff averred that any confusion between the two marks can lead to wrongful consumption and have disastrous consequences as they were used for different medicinal preparations.

• The defendant argued that the plaintiff should have disclosed the facts regarding the oppositions it had filed at multiple instances against ZEST Family of marks of the defendant. It was contended that such material facts were concealed because they would have refuted the plaintiff's claim that it learned of the use of the defendant's mark "FOLZEST" only in 2022.

#### Issues

Whether the plaintiff infringed the defendant's mark 'ZEST' through the use of the mark 'FORZEST'?

#### **Applicable Rule**

- Section 124 of Trademarks Act, 1999.
- Section 125 of Trademarks Act, 1999.
- Section 151 of Code of Civil Procedure.

#### Ratio

The Court held that the crucial and material information that the plaintiff had withheld should have been disclosed in the plaint itself because doing so would have undoubtedly affected the Court's decision to grant the plaintiff an ad-interim ex-parte injunction. According to the court, in spite of the concealment of the material facts and misstatements made, the plaintiff would still be eligible to receive an adinterim injunction against the defendant such that the following conditions were met. The following facts were considered relevant:

- 1. The plaintiff, through its predecessor-in-interest, had been the registered owner of the mark "FORZEST" since the year 2003;
- 2. The plaintiff/its predecessor-in-interest had used the said mark since the year 2003 and had substantial sales;
- 3. Although the defendant had a "ZEST" Family of Marks, it had only begun using the impugned mark "FOLZEST" in June 2021/May 2022;
- 4. The plaintiff and defendant used different medications;
- 5. Relied upon Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73, even a remote chance of deception has to be avoided in a medicinal goods. It was held that two marks are deceptively similar and any confusion in the same can lead to disastrous consequences.

In view of the above, the ad-interim ex-parte order of injunction was confirmed in favor of the plaintiff. However, the plaintiff was not allowed to escape the consequences of concealing material facts and was imposed a penalty of Rs 10 Lakhs. The decision is a noteworthy precedent revisiting the importance of 'clean hands' doctrine.

#### 9. ITC Limited vs. Central Park Estates Private Limited & Anr.

#### C.O. (COMM.IPD-TM) 763/2022 and I.A. 18332/2022 Decided on 14.11.2022 Parties

• The plaintiff began operating in the hospitality industry in 1975 and was known as one of India's leading private sector businesses with operations in a variety of industries, including fast-moving consumer goods (FMCG), hotels, paperboard and packaging, agri-business, and information technology.

• Defendant uses trademark 'BALKH BUKHARA' for their restaurant business.

#### **Brief Facts**

• In the late 1970s, the plaintiff registered the mark "BUKHARA" for its restaurant at the ITC Maurya Hotel.

• The plaintiff maintained websites like www.itcportal.com and www.itchotels.in that contained details about the plaintiff's hotel operations in India and other countries as well as evidence of the plaintiff's use of the trade mark "BUKHARA."

• It was also claimed that 'BUKHARA' had acquired the status of a well-known trade mark.



#### Issues

Whether the defendant infringed the plaintiff's mark 'BUKHARA' through their use of 'BALKH BUKHARA'?

#### **Applicable Rule**

- Section 2(zg), Trademarks Act, 1999
- Section 11(2), Trademarks Act, 1999
- Section 29(4) of Trademarks Act, 1999.
- Section 57, Trademarks Act, 1999

#### Ratio

The Court noted the US Court's decision in ITC Ltd. v. Punchgini, Inc., 552 US 827 (2007), where the plaintiff was unsuccessful in protecting their 'BUKHARA' mark. However, the Court clarified that this decision would not be relevant in the Indian context. Instead, the court ruled that the plaintiff's supporting documents show not only that the mark "BUKHARA" had been organically linked to Indian food, but also that the plaintiff's restaurant had gained recognition on a global scale as a frequent stop for foreign dignitaries and celebrities. As a result, the plaintiff's mark, "BUKHARA," had acquired a solid name and distinctiveness around the world, and the plaintiff had unmistakably globalized Indian food.

The Court held that the mark 'BUKHARA' was declared as a well-known mark under Section 2(zg) read with Section 11(2) of the Act. Further, the Court directed the Registrar of Trade Marks to add 'BUKHARA' mark to the list of 'well-known trade marks', upon the plaintiff completing the requisite formalities.

### 10.RPG Enterprises Limited v. Riju Ghoshal and Ors. MANU/MH/0945/2022

#### Decided on 21.03.2022

#### Parties

• The plaintiff is the 1979 established, multi-industry Indian conglomerate, RPG Enterprises, who has been using the trademark 'RPG' since 1979, and wherein the said trademark is an acronym of the initials of its founder, Ram Prasad Goenka, the famous industrialist.

• The Defendants, a married couple, were jointly operating and managing the two businesses under the trademark 'RPG Opticals' and 'RPG Pharmacy', which uses the trademark 'RPG' registered by the plaintiff.

#### **Brief Facts**

• The Plaintiff had adopted the unique and distinctive trademark "RPG" in 1979 and has also applied and secured registration of RPG/RPG stylized/formative trade marks in various classes under the Trade Marks Act, 1999 for different goods and services, including but not limited to, charitable endeavours through its trust- RPG Foundation, RPG Academy of Art and Culture, CSR activities, etc., which has substantially contributed to the goodwill and brand value of the trade mark 'RPG'.

• The Plaintiff claims the 'RPG' mark is being used by the plaintiff continuously, extensively and uninterruptedly, for its goods and services, as a trade mark, trade name, and trading style, hence, the mark 'RPG' is a 'source identifier' for the goods and services of the Plaintiff.

• In October 2017, the Plaintiff became aware of the trade mark application of the Defendants for the mark 'RPG Opticals', and filed an opposition application which had been pending before the Trade Marks Registry.

• In May 2018, the Plaintiff became aware of the Trade Mark Registration, 'RPG Pharmacy', and filed a Rectification Application for removal of the impugned trademark and rectification of the Register of Trademarks, which had also been pending.

• The Plaintiff claims that due to the longstanding goodwill and reputation of the 'RPG' mark across multiples classes of goods and services, it must be recognized as a "Well-Known" trademark, and the use of the 'RPG' mark by the Defendants is infringing the Trademark and trade name of the Plaintiff, hence the present suit has been filed.

#### Plaintiff's Mark:



#### **Defendant's Mark:**



#### Issues

- Whether the Defendant has been infringing the trade mark of the plaintiff under Section 29(4) of the Trade Marks Act, 1999?
- Whether there can be an action of passing off against the Defendants?
- Whether the use of the impugned trade mark by the Defendants as a trade name, is infringing the Plaintiff's trademark under Section 29(5) of the Trade Marks Act, 1999?

#### **Applicable Rule**

- Section 29(4) of Trademarks Act, 1999.
- Section 29(5) of Trademarks Act, 1999.

#### Ratio

The Hon'ble Bombay HC made the following observations:

#### 1. Infringement of Trade Mark under Section 29(4)

The HC held that the Defendant's the Defendant is liable for infringement under Section 29(4) by using "RPG", which is the leading, essential and prominent feature of Plaintiff's trade mark, and the taglines "Opticals" and "Pharmacy" are merely descriptive and indictive of the services provided by the defendant and also, do not form the prominent part of the Defendant's marks. After applying the first impression test, a customer with an average mind of ordinary intelligence and imperfect recollection, is likely to associate and connect the services/business of the Defendants as those of the Plaintiff.

#### 2. Claim for the common law right and action of passing off

The Court held that the claim for passing off action is maintainable.

# 3. Infringement of Trade Mark under Section 29(5)- Use of a Trade Name

The court held that there are two requirements to attract infringement under Section 29(5), firstly, the Defendant uses a 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, and secondly, Defendant is in the business of dealing with goods or services in respect of which the Plaintiff's trade mark is registered. The second of the requirements for attracting under Section 29(5) are not met in the present case as the defendant is not dealing in goods and services in respect of which the Plaintiff's trade mark is registered.

The court also created the distinction between "marks with reputation" and "well-known" marks, held that Section 29(4) of the Act does not require the trade mark to be recorded in the list. The term "and" used under Section 29(4) mandates presence of three factors to establish infringement, which are being satisfied in the instant case, hence, held the defendant liable for infringement under Section 29(4) and granted injunction in favor of the Plaintiff.

# 11. MakeMyTrip India Private Limited V. Booking.Com B. V. & Ors CS (COMM) 268/2022 & I.As. 6443-47/2022

#### Decided on 27.04.2022

#### **Parties**

• The Plaintiff, MakeMyTrip is a pioneer amongst the online traveling portals in India and abroad.

• The Defendant No. 1, Booking.com is an online travel agency and competitor of MakeMyTrip.

#### **Brief Facts**

• The plaintiff has registered trademarks for 'MakeMyTrip', 'MakeMy', 'MyTrip', 'MMT' and logo and variants thereof and the domain name www.makemytrip.com since the year 2000.

• The plaintiff initiated legal action to safeguard their registered trademarks, which were being utilized as keywords by Booking.com B.V on Google Ads Program to publicize its services as adverts displayed on Google search results.

• Booking.com submits that there has been concealment and suppression of material facts by the Plaintiff.

• Strategic Partnership Agreement entered in 2016, into between Defendant and the Plaintiff wherein, under clause 4.4.1.2, Defendant permitted the Plaintiff to conduct, undertake, use, and perform paid searches or Search Engine Marketing (SEM) activities using the mark 'booking.com'.

#### Issues

Whether the encashment of the goodwill and reputation of MakeMyTrip a registered trademark by Booking.com by bidding on it as a keyword through the Google Ads Program would amount to infringement and passing off or not?

#### **Applicable Rule**

- Section 2(2)(b), Trademarks Act, 1999
- Section 29(4)(c), Trademarks Act, 1999
- Section 29(6)(d), Trademarks Act, 1999
- Section 29(7), Trademarks Act, 1999
- Section 29 (8), Trademarks Act, 1999

#### Ratio

The Delhi High Court ruled that by allowing competitors to bid on a trademarked term on Google Ads for the purpose of advertising, Google is encashing over the goodwill of the trade mark owner.

The Court observed that the usage of the Plaintiff's trademark by the Defendant No. 1 is not visible but it is evident that the Defendant No.1, for advertising purposes, was engaging in unfair business practices by intending to lure customers away from the Plaintiff's website towards their own. In the prima facie opinion of the court, this practice amounts to taking unfair advantage of the plaintiff's mark and constitutes an infringement under Section 29(8) of the Trademarks act, 1999. With regard to the question of passing off, the element of 'deceit' which is of paramount consideration in passing off actions was found to be writ apparent. The question of essential consideration was, whether there was 'misrepresentation' as there was no visible 'representation' and use of the mark in the traditional sense while using a mark as keyword in Google Ads. However, relying on Kerly's Law of Trade Marks and Trade Names (15th Ed., p.628 & 629), it was held that the "invisible" use of a trademark as a keyword can be considered passing off. But the trademark owner has control over booking its own trademark for advertising purposes.

The Hon'ble High Court held that the balance of convenience lies in favour of the Plaintiff and the use of Plaintiff's trademark 'MakeMyTrip' by The Defendant No. 1 who is one of the major competitors of the Plaintiff, prima facie amounts to trademark infringement. Thus, injunction was granted to the Plaintiff so as to restrain the defendants from using the trademark 'MakeMyTrip" and its variants together/ in conjunction with or without spaces as a keyword on the Google Ads Platform.

#### 12. TTK Prestige Ltd vs. K.K. and Company Delhi Pvt. Ltd. and Others

#### CS(COMM) 864/2022

#### Decided on February 20, 2023

#### Parties

• The plaintiff is engaged in the business of manufacture and sale of home appliances like pressure cookers, gas stoves, non-stick cookware, mixer grinders, induction cook-tops, chimneys etc. under the brand name of 'PRESTIGE'.

• The defendant no.1 is engaged in the business of manufacture and sale of 'gas stoves and its component parts. Defendant no. 2 and defendant no. 3 are sister concerns of the defendant no. 1.

#### **Brief Facts**

• The plaintiff sells all its products under the brand of 'PRESTIGE'. The earliest registration of the plaintiff's trademark 'PRESTIGE' (word per se) in Class 8 and 21 dates back to 1949. The trademark 'PRESTIGE' (word per se) was registered in favour of the plaintiff in Class 11 since 1981 in respect of 'installations for cooking' and another application is also registered since 1999 specifically in respect of 'gas stoves' both of which are filed on a 'proposed to be used basis'.

• The defendant no.1 filed a trademark application on 2<sup>nd</sup> November, 2018 for the registration of the device mark 'PRESTIGE' (hereinafter referred to as the 'impugned trademark'). The defendant no. 1 claimed that it has been a prior user of the impugned trademark in respect to 'gas stoves' since 1<sup>st</sup> January, 1981.

• The plaintiff filed the present suit seeking a decree of permanent injunction against the defendants restraining them from using the trademark 'PRESTIGE' and other identical or deceptively similar marks.

## PRE/TIGE

#### Issues

• Whether the defendant no. 1 is a prior user of the impugned trademark and has been continuously using the impugned trademark since the year 1981?

• Whether a case of infringement and passing off is made out on behalf of the plaintiff?

#### Applicable Rule

- Section 34 of Trademarks Act, 1999.
- Sub-Rule 7 Order XI Rule 1 of the Civil Procedure Code, 1908.
- Sub-Rule 10 Order XI Rule 1 of the Civil Procedure Code, 1908.

#### Ratio

The Hon'ble Court was not convinced that defendant no. 1 was a prior and continuous user of the impugned trademark because of absence of any credible documents evidencing the same. Defendant no. 1 had placed on record only three invoices, all of the year 1982 in support of his contention whereas the plaintiff had a trademark registration dated 16<sup>th</sup> June, 1981 with respect to 'installations for cooking'. The Hon'ble Court opined that 'installations for cooking' also encompass 'Gas Stoves'. Since, the defendant no. 1 had filed invoices of a subsequent date and had failed to bring into the record any credible evidence showing prior use or continuous use under Section 34 of the Trademarks Act, 1999, the Hon'ble Court was of a view that the defendant no. 1 had at best shown sporadic use of the impugned trademark and in this regard relied on the judgement of *Pioneer Nuts and Bolts Pvt. Ltd. v. Goodwill Enterprises, 2009 SCC OnLine Del 2851*.

Furthermore, the plaintiff placed reliance on the case of *United Brothers v. Navin Kumar, 2006 SCC OnLine Del 185*, in order to counter the only defense, put forth by the defendant no. 1 that 'pressure cookers' and 'gas stoves' are different products. The reliance on the said judgement was affirmed by the Hon'ble Court holding that the use of the impugned trademark by the defendant no. 1 with respect to gas stoves is likely to cause confusion in the minds of the public as the goods of the plaintiff and defendant no.1 are both used as kitchen appliances and therefore, there would be confusion for the consumer using both the products, they would not be able to distinguish the products of the defendant no. 1 from that of the plaintiff. Thus, the Hon'ble Court held that a prima facie case of infringement and passing off is made out on behalf of the plaintiff and the balance of convenience also lies in favour of the plaintiff.

The defendant no. 1 and its directors, sister concerns, dealers, agents etc. were injuncted from manufacturing, selling, offering for sale, exporting, advertising etc. any goods under the mark of 'PRESTIGE' or any other identical or deceptively similar mark.

#### References:

#### • Shape marks require secondary meaning for trademark protection [1]

The court, while deciding the issue, reiterated the strict grounds for trademark protection of a shape mark. The hon'ble court stated that the novel shape of a product which has aesthetic appeal is protectable under the law of designs if the requisite conditions are satisfied. However, under the law of trademarks, the threshold for extending exclusive rights to the shape of a product is quite high. The shape by itself should immediately be identifiable with the source of the product. For trade mark registration of the shape of a product, the same can only be granted if it has acquired a secondary meaning.' Therefore, shape marks ought to have acquired a secondary connotation to be able to be registered.

#### • The numeral marks are entitled to trademark protection [<sup>2</sup>]

The court held that both numeral marks 91 and 99, whether used in word or numeral format, were arbitrary in respect of bicycles and bicycle accessories and entitled to protection under the Trademarks Act. Further, the use of the 99 marks without any plausible explanation – coupled with the fact that the first digit of the rival marks was '9' – clearly established the defendants' mala fide intent to ride upon the goodwill and reputation vesting in the plaintiff's marks. Prima facie it appeared that the plaintiff had acquired goodwill in its mark within a short period from 2020.

The court also took note of the products' nature, observing that the people who bought the bicycles may have been deceived into believing that they originated from the same manufacturer and that the marks NINETY-NINE/99 and NINETY-ONE/91 are series marks.

#### • Consideration of an amendment in the cause of action [<sup>3</sup>]

The hon'ble court stated that the defendants are opposing this application on the grounds that it adds a new cause of action that arose after the lawsuit was filed and, as a result, if it were to be approved, it would seriously infringe on the rights of the defendants. When a trademark is not registered, a user of the trademark may file a passing-off lawsuit.

<sup>1</sup> Knitpro International vs. Examiner of Trademarks through Registrar of Trademarks

- C.A. (COMM. IPD-TM) 110/2022
- <sup>2</sup> Alphavector India Pvt Ltd vs. Sach Industries & Ors.
- 2023/DHC/000823

<sup>3</sup> Milaap Social Ventures India Pvt. Ltd vs. Google India Pvt. Ltd., W.P. No. 6220 of 2022

The reality is that the plaintiffs have asserted that they have suffered as a result of the defendants passing on similar goods in an unfair manner as the plaintiffs. After the trademark is registered, a lawsuit for infringement on the same principle can be filed. If the defendants' argument is accepted and the plaintiffs are forced to file a second lawsuit, it will only result in a multiplicity of actions between the parties, which is something that should be avoided. The defendants have failed to persuade the court of the reasons why the proposed modification cannot be considered in the current lawsuit.

#### Nature of the mark "SCHEZWAN CHUTNEY" [<sup>4</sup>]

This Court was asked to decide whether the mark "SCHEZWAN CHUTNEY" was descriptive of the in-question product. According to the court, "SCHEZWAN CHUTNEY" represented a "CHUTNEY" (sauce) with a "SCHEZWAN" flavour, and if protection were to be granted to such a mark, then similar protection should also be granted to "Tamarind Chutney" or "Tomato Chutney" as they were also made up of words from both English and Hindi. The phrase "SCHEZWAN CHUTNEY" also met the second requirement outlined in "McCarthy on Trade Marks," known as "The Competitors Need Test," meaning that the phrase was likely to be used by the rivals to describe their goods. The plaintiff's request for a grant of an ad interim injunction barring the defendant from using the mark "SCHEZWAN CHUTNEY" or "SZECHUAN CHUTNEY" was denied because the Court determined that the defendant's use of the mark "SCHEZWAN CHUTNEY" could not be deemed dishonest.

### In commercial proceedings foremost consideration is expeditious disposal of cases [<sup>5</sup>]

With reference to interpretation of Rule 26 of IP Division Rules, 2022 it was remarked that "howsoever it may be worded, is obviously to ensure that proceedings relating to the same or related IPR subject matters are heard together and that, if any such proceeding(s) are pending before the IPD of this Court, all connected and related proceedings should also be taken up by it." Furthermore, court opined that multiplicity of proceedings will lead to confusion and in the interest of expeditious disposal of cases in commercial matters liberal interpretation of Rule 26 of the IPD Rules, 2022 was applied.

<sup>&</sup>lt;sup>4</sup> Capital Food Private Limited vs. Radiant Indus Chem Pvt. Ltd. 2023/DHC/000224

<sup>&</sup>lt;sup>5</sup> Jumeirah Beach Resort LLC vs. Designarch Consultants Pvt Ltd & Anr C.O.(COMM. IPD-TM) 124/2022

#### • Infringement of the 'RENAISSANCE' mark [6]

The Supreme Court observed that the Impugned Mark was identical to the Trade Mark and was being used in relation to identical services, and hence, there was a presumption of likelihood of confusion as per Section 29(3) of the Act. The Supreme Court further observed that the High Court erroneously relied upon Section 29(4)(c) of the Act standalone without taking into consideration sub-clauses (a) and (b) of Section 29(4) of the Act which makes it clear that Section 29(4) of the Act is applicable only when the rival goods / services are different. The Supreme Court reiterated that the basic tenet of interpretation of statutes that if the sub-clauses are separated by the word 'and' and not 'or', then all sub-clauses are to be considered cumulatively and not standalone.

# • 'Rooh Afza' and 'Dil Afza' were held to be deceptively similar 'AFZA' being dominant part of the marks[<sup>7</sup>]

It was observed that though marks have to be compared as whole, it is not impermissible to examine the dominant part of the mark for determining the overall impression a composite mark may carry. It was held that the word 'AFZA' is an integral part of the marks. It was reaffirmed that the question whether two composite marks are similar must be adjudged by examining the two marks as a whole and not by dissecting the same; but it may be expedient to examine the dominant part of the marks and it is also settled that a composite marks end with 'AFZA' does lend an element of similarity to both the marks. It was held that the words with similar meaning or close connection may leave mental impressions that may lead one to confuse with the other.

# • Emphasizes the clean hands doctrine vis-à-vis trademark law. Cost of Rs 10 Lakhs were imposed on Plaintiff for concealing material facts [8]

The Court held that the crucial and material information that the plaintiff had withheld should have been disclosed in the plaint itself because doing so would have undoubtedly affected the Court's decision to grant the plaintiff an adinterim

<sup>6</sup> Renaissance Hotel Holdings Inc. vs. B. Vijaya Sai and Ors.

Civil Appeal no. 404 of 2022

<sup>7</sup> Hamdard National Foundation (India) Vs. Sadar Laboratories Pvt. Limited FAO (OS) (COMM) 67/2022

<sup>&</sup>lt;sup>8</sup> Sun Pharmaceuticals Industries vs. Dwd Pharmaceuticals Ltd, 2022/DHC/005037.

ex-parte injunction. According to the court, the plaintiff would still be eligible to receive an ad-interim injunction against the defendant provided the following conditions were met. The following facts are relevant:

- 1. The plaintiff, through its predecessor-in-interest, had been the registered owner of the mark "FORZEST" since the year 2003;
- 2. The plaintiff/its predecessor-in-interest had used the said mark since the year 2003 and had substantial sales;
- 3. Although the defendant had a "ZEST" Family of Marks, it had only begun using the impugned mark "FOLZEST" in June 2021/May 2022;
- 4. The plaintiff and defendant used different medications;
- 5. Two marks are deceptively similar and any confusion in the same can lead to disastrous consequences.

### • BUKHARA' as a well-known trade mark under Section 2(zg) read with Section 11(2) of the Trade Marks Act, 1999 and directed the Registrar of Trade Marks to add the mark 'BUKHARA' to the list of well-known Trade marks [<sup>9</sup>]

The court ruled that the plaintiff's supporting documents show not only that the mark "BUKHARA" had been organically linked to Indian food, but also that the plaintiff's restaurant had gained recognition on a global scale as a frequent stop for foreign dignitaries and celebrities. As a result, the plaintiff's mark, "BUKHARA," had acquired a solid name and distinctiveness around the world, and the plaintiff had unmistakably globalized Indian food.

The Court held that the mark 'BUKHARA' was declared as a well-known mark under Section 2(zg) read with Section 11(2) of the Act. Further, the Court directed the Registrar of Trade Marks to add 'BUKHARA' mark to the list of 'well-known Trade marks.

• Well-structured analysis of Section 29(4) and 29(5) of the Trade Marks Act,1999. Explaining on the distinction between "marks with reputation" and "well-known" marks, the Court observed that in order to establish infringement under Section 29(4), there is no requirement that the mark be recorded in the list of well-known trademarks [<sup>10</sup>]

<sup>9</sup> ITC Ltd. vs. Central Park Estates Private Ltd, 2022 SCC OnLine Del 4132
<sup>10</sup> RPG Enterprises Limited vs. Riju Ghoshal Trading As RPG, MANU/MH/0945/2022

The Court held that the Plaintiff's mark has acquired distinctiveness and characteristics of a well-known mark through continued and uninterrupted usage, and is solely associated with Plaintiff's goods and services, hence, usage of the 'RPG' mark by Defendant for opticals and pharmacy may lead to dilution and affect the distinctive character of the Trade Mark.

The court also created the distinction between "marks with reputation" and "well-known" marks, held that Section 29(4) of the Act does not require the trade mark to be recorded in the list of "Well-Known" trade marks. The term "and" used under Section 29(4) mandates presence of three factors to establish infringement, which are being satisfied in the instant case, hence, held the Defendant liable for infringement under Section 29(4) and granted injunction in favor of the Plaintiff.

Further with respect to the passing-off Action, the honorable HC held that passing off is a common law right that comes into play in case of any false representation made by the Defendant with respect to the source/origin of goods and services, that causes confusion amongst the public and leads to actual or likelihood of injury to the Plaintiff as referred in *((Reckitt & Colman Products Ltd. v. Borden Inc MANU/UKHL/0012/1990 ('Jif Lemon Case'))*. The said common law action is maintainable in the case of a well-known trade mark, irrespective of whether or not the goods and services offered by the Defendant are dissimilar to that of the goods and services offered by the Plaintiffs.

With respect to Section 29(5) of the Act, the Court held that the use of term "and" by the legislature requires the following conditions to be qualified to establish infringement:

- Defendant using a 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; and
- 2. Defendant is in the business of dealing with goods or services in respect of which the Plaintiff's trade mark is registered.

Section 29(5) of the Act does not use the term "in course of trade" or "same/identical/similar goods" as a criterion for establishing infringement, hence, the same cannot be read into it. Additionally, the goods and services associated with the trade name of the Defendants are different from the goods and services offered by the Plaintiff under the registered trade mark 'RPG', hence, the use of the registered trade mark by the Defendant as the trade name does not amount to infringement of Plaintiff's registered trade mark under Section 29(5) of the Trade Marks Act, 1999.

• The "invisible" use of a mark as a keyword by any person other than the Proprietor can amount to passing off as a matter of principle [<sup>11</sup>]

The Hon'ble Court observed that the usage of the Plaintiff's trademark by the Defendant No. 1 is not visible but it is evident that the Defendant No.1, for advertising purposes, was engaging in unfair business practices by intending to lure customers away from the Plaintiff's website towards their own. The Hon'ble High Court held that the balance of convenience lies in favour of the Plaintiff and the use of Plaintiff's trademark 'MakeMyTrip' by The Defendant No. 1 who is one of the major competitors of the Plaintiff, prima facie amounts to trademark infringement Thus, inunction was granted to the Plaintiff so as to restrain the defendants from using the trademark 'MakeMyTrip' and its variants as a keyword on the Google Ads Platform.

#### • Sporadic use of Trade Marks will not constitute continuous use [<sup>12</sup>]

The Court found that the defendant's claim of being a "continuous user" of the trademark "PRESTIGE" since 1981 was not supported by sufficient evidence. In the absence of any documents, the Court presumed that there was no continuous use by the defendant, despite their claim of using the trademark since January 1st, 1981. The Court noted that the defendant had only sporadically used the trademark and had not built a significant reputation or goodwill associated with it, thus not meeting the requirement of being a "continuous user" under Section 34 of the Act. On the other hand, the Court considered the plaintiff's evidence, such as their sales turnover and promotional expenses, which demonstrated that their trademark "PRESTIGE" had significant goodwill and reputation, particularly in relation to "pressure cookers". The Court concluded that the plaintiff had established a prima facie case of the value and reputation of their trademark. Additionally, the Court stated that the balance of convenience favored the plaintiff and was against the defendant. As a result, the Delhi High Court granted a permanent injunction against the defendant, holding that the plaintiff had a strong case for both trademark infringement and passing off.

#### Disclaimer

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

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

References used for judgments for the purpose of this document were reliable and ordinarily known to be accurate and it is believed that information provided therein is true to the best of our knowledge. If, however, there is any discrepancy or inaccuracytherewith, Khurana and Khurana disclaims any liability thereto, but invites the readers to highlight the same so that it can be checked and if relevant, rectified in this document.

#### 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 goodsor 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

#### Glossary

- (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

#### Glossary

- (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 besubject 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 acquiredby 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 permitteduse) as he would have if he were the sole registered proprietor.

# 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

#### Glossary

- (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, inany 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
  - (d) 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 b 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 hasbeen 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 thanin accordance with the fact, a connection in the course of trade between any person and the goods or services, as the case may be;
    - (ii) y the proprietor or a registered user of the mark;

#### Glossary

- (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, inexercise 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.

## I. Section 21 of 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 theRegistrar, 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 hedoes 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.

#### Glossary

(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 onbusiness 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.

## II. 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.

#### Glossary

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

## IV. 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 anarticle 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

#### Glossary

- (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 caserequires, 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.

#### V. 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.

## Glossary

(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.

# VI. 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 mannerwhich may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

## Glossary

- (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 isin relation to a certification trade mark or collective mark; or
- (b) where in a suit for infringement the defendant satisfies the court-
- 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-
- 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.

# VII. 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 adeceptively similar mark; or
- (b) falsifies any genuine trade mark, whether by alteration, addition, effacement orotherwise.
- (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, -

#### Glossary

- (a) applies such trade mark or a deceptively similar mark to goods or services or anypackage 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.

## VIII.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.

### Glossary

- (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 toregistration 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 thatword or other expression, symbol or sign is delineated and indicating that thereference 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 thereference 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 thelaw 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.

## IX. 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 section108 or section 109 except on complaint in writing made by the Registrar orany 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 respectof 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.

#### Glossary

(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 orequivalent, 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.

X. Section 2 (1) (j) of The Trade Marks Act, 1999 "goods" means anything which is the subject of trade or manufacture;

Section 2 (1) (m) of The Trade Marks Act, 1999 - "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;

Section 2 (1) (z) of The Trade Marks Act, 1999 - "service" means service of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters such as banking, communication,

#### Glossary

education, financing, insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising;

Section 2 (1) (zb) of The Trade Marks Act, 1999 - "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and-

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

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;

Section 2 (1) (t) of The Trade Marks Act, 1999 - "register" means the Register of Trade Marks referred to in sub-section (1) of section 6;

Section 2 (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.

## Glossary

Section 2(1)(v) of The Trade Marks Act, 1999 - "registered proprietor", in relation to a trade mark, means the person for the time being entered in the register as proprietor of the trade mark;

Section 2(1)(w) of The Trade Marks Act, 1999 - "registered trade mark" means a trade mark which is actually on the register and remaining in force;

**Section 2(1)(x) of The Trade Marks Act, 1999 -** "registered user" means a person who is for the time being registered as such under section 49;

Section 2(1)(y) of The Trade Marks Act, 1999 - "Registrar" means the Registrar of Trade Marks referred to in section 3;

**XI. Section 3 of The Trade Marks Act, 1999 -** Appointment of Registrar and other officers. - (1) The Central Government may, by notification in the Official Gazette, appoint a person to be known as the Controller-General of Patents, Designs and Trade Marks, who shall be the Registrar of Trade Marks for the purposes of this Act.

(2) The Central Government may appoint such other officers with such designations as it thinks fit for the purpose of discharging, under the superintendence and direction of the Registrar, such functions of the Registrar under this Act as he may from time to time authorise them to discharge.

XII. Section 48 of The Trade Marks Act, 1999 - Registered users.
(1) Subject to the provisions of section 49, a person other than the registered proprietor of a trade mark may be registered as a registered user thereof in respect of any or all of the goods or services in respect of which the trade mark is registered.

(2) The permitted use of a trade mark shall be deemed to be used by the proprietor thereof, and shall be deemed not to be used by a person other than the proprietor, for the purposes of section 47 or for any other purpose for which such use is material under this Act or any other law.

#### Glossary

XIII. Section 49 of The Trade Marks Act, 1999 - Registration as registered user. - (1) Where it is proposed that a person should be registered as a registered user of a trade mark, the registered proprietor and the proposed registered user shall jointly apply in writing to the Registrar in the prescribed manner, and every such application shall be accompanied by-

(a) the agreement in writing or a duly authenticated copy thereof, entered into between the registered proprietor and the proposed registered user with respect to the permitted use of the trade mark; and

(b) an affidavit made by the registered proprietor or by some person authorised to the satisfaction of the Registrar to act on his behalf,-

(i) giving particulars of the relationship, existing or proposed, between the registered proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;

(ii) stating the goods or services in respect of which registration is proposed;

(iii) stating the conditions or restrictions, if any, proposed with respect to the characteristics of the goods or services, to the mode or place of permitted user, or to any other matter;

(iv) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof; and

(c) such further documents or other evidence as may be required by the Registrar or as may be prescribed.

(2) When the requirements of sub-section (1) have been complied with, the Registrar shall register the proposed registered user in respect of the goods or services as to which he is so satisfied.

(3) The Registrar shall issue notice in the prescribed manner of the registration of a person as a registered user, to other registered users of the trade mark, if any.

## Glossary

(4) The Registrar shall, if so requested by the applicant, take steps for securing that information given for the purposes of an application under this section (other than matters entered in the register) is not disclosed to rivals in trade.

# XIV. Section 9 of The Trade Marks Act, 1999 -. Absolute grounds for refusal of registration. - (1) The trade marks-

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

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

(c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade, shall not be registered:

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

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

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

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

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

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

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

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

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

#### Glossary

(c) the shape which gives substantial value to the goods.

Explanation. - For the purposes of this section, the nature of goods or services in relation to which the trade mark is used or proposed to be used shall not be a ground for refusal of registration.

XV. Section 11 of The Trade Marks 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.

#### Glossary

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

[(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.

(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 wellknown 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 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.

#### Glossary

(7) The Registrar shall, while determining as to whether a trade mark is known or recognized 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;

(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

(v) 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.

# Glossary

(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.

# XVI. 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-

#### Glossary

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

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

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

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

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

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

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

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

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

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

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

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

(b) is detrimental to its distinctive character; or

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

## Glossary

(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.

# XVII. 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 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.

XVIII. Section 35 of The Trade Marks 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 of quality of his goods or services.

#### Glossary

XIX. 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 be the proprietor or a predecessor in title of his; or

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

# XX. Section 17 of The Trade Marks Act, 1999 -. Effect of registration of parts of a mark.-

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

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

(a) contains any part-

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

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

#### Glossary

# XXI. Section 47 of The Trade Marks Act, 1999 -. Removal from register and imposition of limitations on ground of non-use.-

(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the [High Court] by any person aggrieved on the ground either –

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being upto a date three months before the date of the application; or

(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

Provided that except where the applicant has been permitted under section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the [Registrar or the High Court, as the case may be,] is of opinion that he might properly be permitted so to register such a trade mark, the [Registrar or the High Court, as the case may be,] may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to-

(i) goods or services of the same description; or

(ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered.

#### Glossary

(2) Where in relation to any goods or services in respect of which a trade mark is registered -

(a) the circumstances referred to in clause (b) of sub-section (1) are shown to exist so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in a particular place in India (otherwise than for export from India), or in relation to goods to be exported to a particular market outside India; or in relation to services for use or available for acceptance in a particular place in India or for use in a particular market outside India; and

(b) a person has been permitted under section 12 to register an identical or nearly resembling trade mark in respect of those goods, under a registration extending to use in relation to goods to be so sold, or otherwise traded in, or in relation to goods to be so exported, or in relation to services for use or available for acceptance in that place or for use in that country, or the [Registrar or the High Court, as the case may be,] is of opinion that he might properly be permitted so to register such a trade mark, on application by that person in the prescribed manner to the [High Court] or to the Registrar, the [Registrar or the High Court, as the case may be,] may impose on the registration of the first-mentioned trade mark such limitations as it thinks proper for securing that registration shall cease to extend to such use.

(3) An applicant shall not be entitled to rely for the purpose of clause (b) of sub-section (1) or for the purposes of sub-section (2) on any non-use of a trade mark which is shown to have been due to special circumstances in the trade, which includes restrictions on the use of the trade mark in India imposed by any law or regulation and not to any intention to abandon or not to use the trade mark in relation to the goods or services to which the application relates.

# XXII. 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-

#### Glossary

(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 or 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 or 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

#### Glossary

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 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 exist 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.

XXIII. Section 57 of The Trade Marks Act, 1999 - Power to cancel or vary registration and to rectify the register.-

(1) On application made in the prescribed manner to the [High Court] or to the Registrar by any person aggrieved, the tribunal may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or

#### Glossary

by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the [High Court] or to the Registrar, and the [Registrar or the High Court, as the case may be,] may make such order for making, expunging or varying the entry as it may think fit.

(3) The [Registrar or the High Court, as the case may be,] may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(4) The [Registrar or the High Court, as the case may be,], of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2).

(5) Any order of the [High Court] rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

# XXIV. Section 125 of The Trade Marks Act, 1999 - Application for rectification of register to be made to [High Court] in certain cases.-

(1) Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register and, notwithstanding anything contained in section 47 or section 57, such application shall be made to the [High Court] and not to the Registrar.

(2) Subject to the provisions of sub-section (1), where an application for rectification of the register is made to the Registrar under section 47 or section 57, the Registrar may, if he thinks fit, refer the application at any stage of the proceedings to the [High Court].

#### Glossary

XXV. Section 124 of The Trade Marks Act, 1999 - Stay of proceedings where the validity of registration of the trade mark is questioned, etc. - (1) Where in any suit for infringement of a trade mark -

(a) the defendant pleads that registration of the plaintiff's trade mark is invalid; or

(b) the defendant raises a defence under clause (e) of sub-section (2) of section 30 and the plaintiff pleads the invalidity of registration of the defendant's trade mark, the Court trying the suit (hereinafter referred to as the Court) shall, -

(i) if any proceedings for re citification of the register in relation to the plaintiff's or defendant's trade mark are pending before the Registrar or the [High Court], stay the suit pending the final disposal of such proceedings;

(ii) if no such proceedings are pending and the Court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is prima facie tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the [High Court] for re citification of the register.

(2) If the party concerned proves to the Court that he has made any such application as is referred to in clause (b)(ii) of sub-section (1) within the time specified therein or within such extended time as the Court may for sufficient cause allow, the trial of the suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the Court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the Court shall proceed with the suit in regard to the other issue in the case.

(4) The final order made in any rectification proceedings referred to in subsection (1) or sub-section (2) shall be binding upon the parties and the Court shall dispose of the suit conformably to such order insofar as it relates to the issue as to the validity of the registration of the trade mark.

# Glossary

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the Court from making any interlocutory order (including any order granting an injunction, directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.

**XXVI.** Section 2(2) of The Trade Marks Act, 1999 - In this Act, unless the context otherwise requires, any reference-

(a) to "trade mark" shall include reference to "collective mark" or "certification trade mark";

(b) to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark;

(c) to the use of a mark,-

(i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;

(ii) in relation to services, shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services;

(d) to the Registrar shall be construed as including a reference to any officer when discharging the functions of the Registrar in pursuance of sub-section

(2) of section 3;

(e) to the Trade Marks Registry shall be construed as including a reference to any office of the Trade Marks Registry.

XXVII. Rule 26, Delhi High Court Intellectual Property Rights Division Rules

Consolidation of IPR subject matters or cases or proceedings or disputes

Where there are multiple proceedings relating to the same or related IPR subject matter, irrespective of whether the said proceedings are between

#### Glossary

the same parties or not, the Court shall have the power and the discretion, wherever appropriate, to direct consolidation of proceedings, hearings, and also to direct consolidated recording of evidence/common trial and consolidated adjudication. If the Court is of the opinion that any matter pending before a Commercial Court is to be consolidated with a matter pending before the IPD, it may exercise powers of transfer under Section 24, Code of Civil Procedure, 1908 for transfer and consolidation of such matter to itself.

## XXVIII. 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.
- (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.
- (3) 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.

#### A Holistic Compendium:

## Indian Trade Mark Cases Summary for 2022-2023

#### Glossary

## XXIX. 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 carryon business, or personally works for gain, as aforesaid, acquiesce in such institution; or
- (c) The cause of action, wholly or in part, arises.

## XXX. 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 revealits 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 notexist; 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.

#### Glossary

## XXXI. 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

#### XXXII. 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.
- (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 shallnot 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 noticeor is unwilling to identify himself, the police officer may, subject to such orders asmay have been passed by a competent Court in this behalf, arrest him for theoffence mentioned in the notice.

#### XXXIII. 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.

#### Glossary

#### XXXIV. 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 forthe 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.

#### XXXV. 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 oralienated 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 witha 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 indispute in the suit] as the Court thinks fit, until the disposal of the suit or until further orders.