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**A HOLISTIC COMPENDIUM HIGHLIGHTING KEY TRADE MARK  
LITIGATION CASES**

**For 2023-2024**

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# **A Holistic Compendium: Indian Trade Mark Cases Summary for 2023-2024**

## **Preface**

The year 2023 witnessed significant IPR developments. The IPR regime underwent significant developments which contributed immensely to the interpretation of trade mark 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 trade mark jurisprudence and also deliberated upon new principles. To mention a few:

1. The Hon'ble Delhi High Court observed that Google was an active participant in use of the trade mark as keywords and was also involved in selecting the recipients of the information of the infringing links disentitling it from availing the immunity of an intermediary under Section 79 of the Information Technology Act, if the alleged activities are found to be infringing.
2. The Hon'ble Delhi High Court discussed spill-over reputation in India and delved into the distinction between goodwill and reputation holding that goodwill requires a physical business presence, and reputation is a matter of fact related to the extent to which the indicium is known in the public mind.
3. The Hon'ble Delhi High Court reiterated that according to Section 28(1) of the Trade Marks Act 1999, the mere proprietorship of a registered trade mark will not render the proprietor the right to obtain relief against any infringement. The registration is primarily required to meet the condition of validity. Registration of the trade mark is not a conclusive proof for validity, rather it is merely a prima facie proof.
4. It was held by the Hon'ble Delhi High Court that in order for inclusion of a mark in the well-known list of marks, filing of Form TM-M and payment of fee is mandatory, even if the mark is adjudged well-known by a Court order.

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 2023 regarding the interpretation and implementation of various provisions of The Trade Marks Act, 1999 and accompanying Rules.

## **A Holistic Compendium:**

### **Indian Trade Mark Cases Summary for 2023-2024**

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## A Holistic Compendium:

### Indian Trade-Mark Cases Summary for 2023-2024

#### List of Important Cases on Trade Marks

S. No.	Topic	Citation	Page No.
1.	Reply to the FER would be a relevant document in litigation between the parties only where the FER cites the Defendant's mark as a similar mark.	<a href="#">Under Armour, Inc vs. Aditya Birla Fashion &amp; Retail Ltd</a> 2023 SCC OnLine Del 2269	8-11
2.	Clarified the distinction between "common to register" and "common to the trade". Merely citing registrations of marks of products containing DEX as a suffix is insufficient to substantiate a contention that DEX, as a suffix, is common to the trade in pharmaceutical preparations but compelling evidence of use has to be produced.	<a href="#">GlaxoSmithKline Pharmaceuticals vs. Horizon Bioceuticals Pvt. Ltd &amp; Anr.</a> CS(COMM) 8/2023	12-15
3.	Held that the mark "INSAID" of Fullstack Education Private Limited bears a strong phonetic similarity to the Petitioner's mark "INSEAD" which could lead to confusion among	<a href="#">Institut Europeen D Administration Des Affairs Association vs.</a>	16-19

	<p>consumers. The Delhi High Court stated that what matters in such cases is phonetic similarity, not phonetic identity.</p>	<p><a href="#"><u>Fullstack Education Private Limited &amp; Anr</u></a> (2023:DHC:3524)</p>	
4.	<p>Interpreted Section 9(1)(b) of the Act holding composite marks stand ipso facto excluded from the scope of Section 9(1)(b), even if part of such marks consists of marks or indications which serve, in trade, to designate the geographical origin of the goods or services in respect of which the mark is registered.</p>	<p><a href="#"><u>Abu Dhabi Global Market vs. The Registrar Of Trademarks, Delhi</u></a> (2023:DHC:3476)</p>	20-24
5.	<p>Ruled that once a mark has been declared well-known by a judicial order, the Registrar is bound to proceed with the recording of well-known mark in the list. Redetermination of well-known status is not necessary as per Section 11(8). However, it does not automatically qualify for inclusion in the Trade Marks Registry's list of well-known trademarks unless a mandatory application under Form TM-M is filed along with prescribed fee.</p>	<p><a href="#"><u>Tata Sia Airlines vs. Union of India</u></a> (2023:DHC:3659)</p>	25-28

6.	<p>The mere fact that the marks are dealing in different business models (B2C vs. B2B) is not sufficient to conclude that the Defendant’s mark “MOJ” is not deceptively similar to that of Plaintiff’s trade mark “MAUJ”. The marks were held to be phonetically and visually similar even if they had different spellings.</p>	<p><a href="#"><u>Mauj Mobile Private Limited vs. Mohalla Tech Private Limited &amp; Ors</u></a> (2023 SCC ONLINE BOM 1094)</p>	29-32
7.	<p>There is No Likelihood Of Confusion Between ‘Bhaiyaji Kahin’ And ‘Bhaiya Ji Superhit’:</p>	<p><a href="#"><u>Tv 18 Broadcast Limited vs. Bennett, Coleman And Company Limited</u></a> 2023/DHC/004452</p>	33-36
8.	<p>In order for a determination of well-known status of a trademark, affidavit by way of evidence cannot be held to be a mandatory requirement for grant of well- known status under the 1999 Act and the 2017 Rules. The non-filing of the affidavit by way of evidence shall not be fatal to the application for determining well-known status.</p>	<p><a href="#"><u>Kamdhenu Ltd. vs. The Registrar of Trade Marks</u></a> C.A.(COMM.IPD-TM) 66/2021</p>	37-39

9.	<p>Google is not entitled to the defence of an intermediary under Section 79 of the IT Act because it actively participates in promoting and facilitating the use of trademarks as keywords by its advertisers and benefits from such use.</p>	<p><a href="#">Google LLC vs. Drs Logistics (P)Ltd. &amp; Ors. and Google India Private Limited vs. DRS Logistics (P) Ltd. &amp; Ors.</a> (FAO (OS) (COMM) 2/2022) (FAO OS (COMM) 22/2022)</p>	40-44
10.	<p>The issue was between the marks ‘PANTOCID’ of the Plaintiff and ‘PANTOPACID’ of the Defendant. The Delhi High Court held that it would not be just to the Defendants to bring the usage of PANTOPACID to a halt knowing that the Plaintiff took no steps from 2010 to 2023 about the infringement fully aware of the existence of such a mark.</p>	<p><a href="#">Sun Pharma Laboratories Ltd vs. Finecure Pharmaceuticals Ltd &amp; Ors</a> 2023: DHC:5755</p>	45-50
11.	<p>Ruled in favour of the Petitioners and restrained the Respondent from using the marks “World Trade Centre Faridabad” &amp; ”WTC Faridabad” and the “WTC” Logo, or any similar trademarks in any manner observing that after termination of licensing agreement, the ex-licensee is not considered a permitted user and is restrained from using the trademark.</p>	<p><a href="#">Viridian Development Managers Private Limited vs. RPS Infrastructure Limited</a> O.M.P.(T) (COMM.) 335/2023</p>	51-55

12.	<p>Delved into the distinction between reputation and goodwill. While goodwill traditionally requires a business presence, reputation is a matter of fact related to the extent to which the indicium is known in the public mind.</p>	<p><a href="#"><u>Bolt Technology Ou vs. Ujoy Technology Private Limited &amp; Anr.</u></a> 2023/DHC/001312</p>	56-60
13.	<p>The Calcutta High Court dismissed the Plaintiff's application for an injunction, citing the lack of deceptive similarity between the marks and emphasizing the descriptive nature of the term "SILK" in the paint industry.</p>	<p><a href="#"><u>Berger Paints India Limited vs. JSW Paints Private Limited</u></a> 2024 LiveLaw (Cal) 1</p>	61-64



## **1. Under Armour, Inc Vs. Aditya Birla Fashion Retail Ltd.**

**2023 SCC OnLine Del 2269**

**Decided on April 20, 2023, (Delhi High Court)**

### **PARTIES**

- a. The Plaintiff UNDER ARMOUR, Inc (UA India) is a company incorporated in the US, with its registered office at Maryland US. The Plaintiff incorporated its Indian subsidiary in October 2018, under the name Under Armour India Private Ltd. and the first physical store was opened in 2019.
- b. The Defendant Aditya Birla Fashion Retail Ltd. is an Indian fashion retail company headquartered in Mumbai.

### **BRIEF FACTS**


The Plaintiff uses its UNDER ARMOUR/UA/UNDR ARMOR mark essentially on sports apparel. The Plaintiff's mark UNDER ARMOUR stands registered in Classes 18, 25 and 28 with effect from 24th February 2009 and the mark UA stands registered in the Classes 18, 25 and 28 with effect from 12th January 2011.

The Defendant also started using the mark STREET ARMOR/SA/STRT ARMOR on sports apparel. It is alleged that the Defendant is using, for its "ARMOR" part of the mark, a font, style and lettering which is deceptively similar to that is used by the Plaintiff for its mark "ARMOUR".

The principal submission made by the Plaintiff was that ARMOUR is the dominant part of UNDER ARMOUR and as the Defendant's impugned mark end with the word "ARMOR" it is deceptively similar to the Plaintiff's.

The primary contention of the Defendant was that the plaintiff was liable to be rejected for suppression and misstatement, as the Plaintiff deliberately concealed the replies to First Examination Reports filed by it. The Defendant contended that the Plaintiff,

had, in its reply to the FER, taken a position that the Plaintiff's marks could not be refused registration under Section 11(2)(a) on the ground that other marks which had ARMOUR as a part thereof were already registered, and the marks have to be seen as a whole. Thus, the Plaintiff now claiming "ARMOUR" to be the dominant mark and claiming exclusivity is opposing the stand presented in FER.

PLAINTIFF'S MARKS	DEFENDANT'S MARKS
<b>UNDER ARMOUR</b>	<b>STREET ARMOR</b>
UA	SA
<u>UNDR ARMR</u>	<u>STRT ARMR</u>
<b>ARMOUR</b>	<b>ARMOR</b>
ARMOUR	
<b>ARMOURFLEECE</b>	<b>STREET ARMOR</b>

### ISSUES

1. Whether, when viewed as whole, Defendant's marks infringe the Plaintiff's marks and whether the use of the Defendant's marks constitute a passing of the Plaintiff's marks?
2. Whether the word "ARMOUR" is the dominant part of the Plaintiff's mark?
3. Whether the Plaintiff has suppressed material facts and non-disclosure of Replies of FER results in rejection of the plaint?

### APPLICABLE STATUTES

Section 11(2)(a) of the Trademarks Act, 1999.

Section 17(2)(b) of the Trademarks Act, 1999.

Section 29(2) of the Trademarks Act, 1999.

**RATIO:**

With respect to the contention raised regarding the First Examination Report it was observed that the stand taken by the Plaintiff in its Reply to Examination Report would actually support the stand taken by it in the present case, as when deceptive similarity of the marks is assessed as a whole, the rival marks were found to be deceptively similar.

The Delhi High Court rejected the contention of suppression of facts and non-disclosure of Reply to FERs, stating that the said document would only be relevant in cases where the FER included Defendant's mark as one of the cited marks. The Court relied upon the judgment of *Raman Kwatra & Anr. v. M/S. KEI Industries Ltd.* FAO(OS) (COMM) 172/2022 & CM APPL. 30278/2022 according to which the Reply to FER would be a relevant document only when the Defendant's mark is one of the cited marks against the mark asserted by the Plaintiff. It was cleared that the principle of approbate, and reprobate has no application where the Defendant's mark has not been cited as a similar mark in the FER, and in the instant case since the Defendant's mark was not cited in the prosecution stage while objecting the Plaintiff's mark 'UNDER ARMOUR', the issue of approbate and reprobate was dismissed.

With respect to the contention of ARMOUR being dominant part of the Plaintiff's mark, the Court reiterated the principle of anti-dissection which states that conflicting competing marks should be compared by looking at them as a whole and not by breaking the component parts for comparison. It was reiterated that identification of 'dominant mark' is not antithetical to the principle of anti-dissection. If viewed in a holistic perspective, the mentioned principles complement each other. It was held that if an ordinary customer with average intelligence and a not-so-great memory encounters the Plaintiff's UNDER ARMOUR trademark and later sees the Defendant's STREET ARMOR trademark on the same type of product, such as sports clothing, there is a high chance of confusion or a belief that there could be some connection between the two marks. Even if the customer only feels curious or uncertain, this could still be considered a

possibility of confusion or deception. Essentially, all it takes is for the customer to be unsure about the two trademarks for there to be a potential problem. The Court also relied upon the principles laid down in the decision of *Amritdhara Pharmacy v. Satyadev Gupta* 1963 AIR 449 which states that if a trademark is similar to another one that is already registered, it can be considered misleading or confusing if it's likely to cause confusion in the regular use of the market where both trademarks are being used by traders. In other words, if the two trademarks are being used in the same market by different traders, and there is likelihood that the similarity between the two marks could create confusion among consumers, then it's considered deceptive.

A customer with average intelligence and not-so-great memory who has previously purchased sportswear with the Plaintiff's UNDER ARMOUR or UNDR ARMR trademark is likely to have a fuzzy memory of buying a similar item with a similar name. So, if the same customer later sees the Defendant's STREET ARMOUR or STRT ARMR trademark, there is a good chance that the customer might remember the previous purchase and get confused or uncertain about the two marks. The Court ruled that where a composite mark consists of various parts, of which one or the other is dominant, the Court can, while assessing whether the mark is infringed by another mark, take into account the dominant part thereof. The Court however, did not accept that ARMOUR/ARMOR is a dominant mark in the present case stating the reason that STREET and UNDER is no less dominant than the word ARMOUR/ARMOR. Still the verdict was passed in the favour of the Plaintiff due to the deceptive similarity between the two marks.

The Hon'ble Delhi High Court restrained the Defendants from dealing in or using the impugned marks and logos which are identical with and/or deceptively similar to the Plaintiff's registered marks.

**2. Glaxosmithkline Pharmaceuticals Ltd. vs. Horizon Bioceuticals Pvt. Ltd & Anr.**

**CS(COMM) 8/2023, 2023: DHC:2390**

**Decided on 10th April 2023, (Delhi High Court)**

**PARTIES:**

- a. The Plaintiff is an Indian research-based pharmaceutical and healthcare company. Its word mark COBADEX is registered in Class 5 under the Trademarks Act, 1999.
- b. The Defendant is an Indian incorporated pharmaceuticals company. It is a manufacturer, supplier of pharmaceutical medicine, tablet, capsule from Sirmaur, Himachal Pradesh, India.

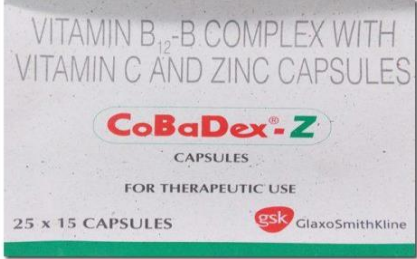
**BRIEF FACTS**

COBADEX is registered word mark under Trade Marks Act, 1999 for pharmaceuticals goods falling under Class 5 in the favour of the Plaintiff with effect from 18th July 1958. The Plaintiff alleges that the Defendant is using a similar mark COMODEX which infringes Plaintiff's word mark COBADEX. The fact that the Defendant is using "PLUS" in COMODEX makes no difference and the infringement remains.

In response, the Defendant contended that the word "DEX" as a suffix, is publici juris, which means that it is subject to the use of the public. The Defendant cited several examples of pharmaceutical preparations such as Cozodex, Cooldex, Kofadex, Kofradex, Ceefodex, Celodex etc., which uses the suffix DEX. The Defendant contends that COMODEX does not infringe the Plaintiff's mark COBADEX within Section 29 of the Trade Marks Act, 1999. The Defendant asserted that the Plaintiff's product is to be sold in retail only on the prescription of a registered medical practitioner. However, the Defendant's product, which is COMODEX PLUS, is not a prescription drug and therefore, the products of both the parties being distinct, there is no possibility of confusion.

Against the Defendant's contention it was argued by the Plaintiff that even if it is

presumed that the prescribing physician would not confuse between the two marks, however, such confusion is likely to occur on the chemist's end. The chemist, in a moment of carelessness, can dispense the Defendant's product. Thus, it is sufficient to suggest that there is a likelihood of confusion due to the similarity between the two marks.

Plaintiff's Pack	Defendant's Pack
	

**ISSUES:**

Whether the Plaintiff is entitled to an injunction against the use, by the Defendants, of the COMODEX mark, with or without the suffix PLUS?

**APPLICABLE STATUTES:**

Section 17(2)(b) of the Trademarks Act, 1999

Section 29 of the Trademarks Act, 1999

**RATIO:**

Primarily, the Hon'ble Delhi High Court rejected the contention made by the Defendant that the use of "DEX" is common to the trade. The Court held that merely citing registrations of marks of products containing DEX as a suffix is insufficient to substantiate a contention that DEX, as a suffix, is common to the trade in pharmaceutical preparations. The Court clarified the distinction between "common to register" and "common to the trade". It was observed that several proprietors register the mark but leave it unused.

Also, the insertion of a definitive article “the” by the legislature is intended to serve a particular purpose. The requirement of Section 17(2)(b) is commonness of the asserted mark to “the trade” which means in the trade relating to the goods to which the mark pertains.

The Court held that in order to say that the mark is “common to the trade”, it has to essentially satisfy two grounds: (i) the existence of a trade involving the goods the Plaintiff is using the mark for, and (ii) common i.e., the frequent, customary or habitual use, in that way of the mark or its part in that trade. Therefore, it is only when the Defendant provides compelling evidence that satisfies these two conditions that the Court may consider invoking Section 17(2)(b) at prima facie stage, leading to the conclusion that the Plaintiff's mark, or a part of it, has become "common to the trade." This would then disqualify the Plaintiff from claiming exclusive rights over the mark. Plainly stating that the term is common to the trade without overwhelming statistical data will not prove the case of the Defendant. It was held, herein, that the use of DEX as suffix was arbitrary, and the Defendant failed to prove the claim that DEX is common to the trade, with substantial statistical data. While assessing the brand names that ends with “Dex” as cited by the Defendant and if from the cited examples when the products containing dexamethasone and dextromethorphan are removed, the remaining examples cannot make out a case u/s 17(2). In view of such reasons, the defence of common to the trade raised by the Defendant was rejected.

It was also held that there is a phonetic similarity between the Plaintiff's and Defendant's mark, and the phonetic similarity between the rival marks, does not begin or end with the common suffix “DEX”. The only difference is in the intervening middle syllable which, in COBADEX is BA, and in COMODEX is MO. Therefore, confusion and deception as envisaged under Section 29 of the Act from the perception of a person of average intelligence is bound to occur in due course of time.

The Hon'ble Court mentioned the test of “initial interest wonderment” according to which if, upon first seeing the Defendant's mark, an individual with average intelligence and an imperfect memory becomes uncertain whether they have

previously encountered the same mark or a related one, and this uncertainty arises because they have indeed seen the Plaintiff's mark earlier, then the Defendant's mark constitutes infringement under Section 29 of the Trade Marks Act.

The Hon'ble Court held that it is highly probable that an individual with average intelligence and an imperfect memory, who encounters COBADEX tablets from the Plaintiff at one time and later comes across COMODEX tablets from the Defendant, would be confused. The Court relied upon the observation of *Cadila Healthcare Ltd. vs Cadila Pharmaceuticals Ltd* 2001 (2) PTC 541 SC which stated that in cases involving pharmaceutical products, it is crucial to emphasize the need to prevent confusion by using similar marks. The consequences of dispensing the wrong medicine can be catastrophic.

The Court, therefore, restrained the Defendant as well as others acting behalf on them, from using COMODEX mark or any other similar mark that could cause confusion with the Plaintiff's COBADEX mark. It was held that the use of "plus" or "forte", and other such additions, whether with COBADEX or COMODEX, cannot alter this position. This restriction applies to all forms of usage and includes the use of any suffix in relation to pharmaceutical preparations or related goods.



**3. Institut Europeen D Administration Des Affairs Association vs. Fullstack Education Private Limited & Anr  
(2023:DHC:3524)**

**Decided on 05.05.2023, (Delhi High Court)**

**PARTIES:**

- a. The Petitioner under the name Institut Europeen D Administration Des Affaires Association ('INSEAD') began its business in the year 1957.
- b. The Respondent under the name the International School of AI and Data Science runs a business school.


**BRIEF FACTS :**

- The Petitioner and the Respondent are both engaged in running a business school known as Institut Europeen D Administration Des Affaires Association, which is abbreviated as INSEAD, and International School of AI and Data Science, abbreviated as INSAID, respectively. It is acknowledged that the logos of the Petitioner and the Respondent are different, with the Petitioner's logo being



and the Respondent's logo being



- Both parties have registered their respective trade marks. The Petitioner's mark, INSEAD, is registered in Class 16, 35, and 41. The Respondent's mark,  /INSAID, is registered in Class 41, specifically for education, training, entertainment, sports, and cultural activities.

- The word mark INSEAD has been registered in favour of the Petitioner since August 7, 2007, on a "proposed to be used" basis. Additionally, the Petitioner holds registrations for the device mark in Classes 41, 35, and 16, effective from December 28, 2012. On the other hand, the Respondent's mark came into effect on February 12, 2020, with claimed usage starting from December 14, 2018.

- The Petitioner argued that the Respondent's mark, INSAID, is deceptively similar to the Petitioner's mark, INSEAD, and asserted that the two marks are phonetically

almost indistinguishable. As evidence of confusion, the Petitioner has provided an email dated December 5, 2020, from a student who mistakenly attended a program by the Respondent believing that it is provided by the Petitioner.

- In light of these circumstances, the Petitioner issued a notice to the Respondent on January 19, 2021, demanding the cessation of the use of the acronym INSAID, alleging that it was deceptively similar to the Petitioner's acronym, INSEAD, and causing confusion. Unfortunately, the notice did not elicit a favourable response.
- Therefore, the Petitioner has filed the present rectification petition under Section 57 of the Trade Marks Act, 1999, seeking the removal of the Respondent's registered

trade mark, , from the Trade Marks Register.

#### **ISSUES:**

- a. Whether the mark "INSEAD" and "INSAID" are phonetically similar or not?
- b. Whether the competing marks in the present case, characterized as device marks rather than word marks, are dissimilar to an extent that eliminates any possibility of confusion?

#### **APPLICABLE STATUTES:**

Section 11(1)(b) of Trademarks Act, 1999.

#### **RATIO:**

- The Delhi High Court observed that the Petitioner holds the benefit of both priority of registration and priority of use over the Respondent. The Petitioner's word mark INSEAD has been registered since August 7th, 2007, and its device marks have been registered since December 28th, 2012. On the other hand, the Respondent claims to have used its mark starting from December 14th, 2018.

Regarding phonetic similarity, the Court stated that what matters in such cases is phonetic similarity, not phonetic identity. The assessment of phonetic similarity should be made from the perspective of the consumer not from the viewpoint of either party involved. The Court emphasized that the consumer should be an average person with imperfect recollection and average intelligence. It was made clear that

the consumer should not be someone overly familiar with either of the marks.

- In this case, the Court applied the "Initial Interest Confusion Test" and concluded that if there is a chance of confusion or infringement when the consumer encounters the marks for the first time, then infringement is established. The fact that the confusion may be dispelled later does not negate the infringement that has already taken place.
- After applying these tests, the Court observed that (i) INSAID and INSEAD are phonetically similar, (ii) they are used for similar services involving AI-based higher education, and (iii) according to the initial interest confusion principle, there is a likelihood of confusion. Given the phonetic similarity and the fact that both marks are acronyms for institutions providing similar services, a consumer, including a student intending to enrol, may wonder if they have encountered the mark before. Therefore, the likelihood of confusion is established.
- The Court also noted that INSEAD is pronounced as "in-si-yaad." The similarity between "Ead" and "aid" in words like "dead" and "said" was highlighted. The Court clarified that what matters is not phonetic identity, but rather phonetic similarity, which prima facie exists between INSEAD and INSAID.
- On the second issue, the Court held that even if the surrounding features or representations of the devices used as marks are significantly different, the similarity or identity of the prominent parts or essential features of the rival marks cannot be mitigated. The Court noted that INSAID and INSEAD form the prominent parts of the rival marks. It is common knowledge that when referring to acronyms of educational institutions, the average consumer tends to remember the acronym rather than the accompanying pictorial features or representations. The Court provided an example of the All-India Institute of Medical Sciences (AIIMS), where the average consumer remembers the institute by the acronym AIIMS, not by the various figures accompanying the logo. Thus, the presence of distinguishing pictorial representations or other features in the overall logos of the marks does not detract from their confusingly similar nature.

- The Court referred to Section 11(1)(b) of the Trade Marks Act, which prohibits the registration of a mark that, due to its similarity to an earlier trademark and the identity or similarity of goods or services covered by both marks, leads to a likelihood of confusion among the public. This provision is subject to Section 12 of the Trade Marks Act, which allows for the registration of identical or similar marks if their use is found to be honest and concurrent.
- To avoid such confusion in future cases, the Court instructed that when an application for mark registration involving a word is submitted, a word mark search and a phonetic search should be conducted at the preliminary stage. This will help identify possible marks that are phonetically similar to the applied mark. The Registrar should then determine whether any of the suggested marks are indeed phonetically similar to the marks for which registration is sought, within the meaning of Section 11(1)(b) of the Trade Marks Act.

Therefore, the Court quashed and set aside the registration of the impugned device mark INSAID. In conclusion, the Delhi High Court has ruled in favour of INSEAD and invalidated the registration of the device mark "INSAID" held by Fullstack Education Private Limited. The Court has determined that the marks bear a strong phonetic similarity, which could potentially lead to confusion among consumers. This decision emphasizes the significance of safeguarding trademark rights and preventing confusion within the marketplace.

**4. Abu Dhabi Global Market vs. The Registrar Of Trademarks, Delhi  
2023:DHC:3476**


**Decided on 18.05.2023, (Delhi High Court)**

**PARTIES:**

- a. Abu Dhabi Global Market, an international financial center and free zone located on Al Maryah Island in the United Arab Emirates's capital, Abu Dhabi is the Appellant.
- b. Trade Marks Registry, Delhi is the Respondent in this case

**BRIEF FACTS:**

- An appeal against the rejection of Application No. 3184380 for trademark

registration of " " under classes 16, 35, 36, 41, and 45 was filed by the Appellant.


- The order of the Registry cited following grounds for rejection: The Appellant failed to establish the distinctiveness of the mark in the applied classes, as it did not appear to be coined or invented. Additionally, it was cited that the Appellant failed to provide evidence of use to establish distinctiveness, and the mark contained a geographical name (ABU DHABI) and the mark as a whole was considered non-distinctive and hence cannot be registered.

**APPELLANT'S CONTENTIONS:**

- The Appellant's argued that both grounds for rejection are unfounded in fact and law. Regarding the finding of non-distinctiveness, it was asserted that the mark is already registered and recognized by the Registrar of Trademarks, indicating its distinctiveness and compliance with Section 9 of the Trademarks Act 1999. It was

further argued that the addition of the words "ABU DHABI GLOBAL MARKET" below the mark does not diminish its distinctiveness.



- In response to the finding that the mark  is not coined or invented, Appellant highlighted that the trading name "ABU DHABI GLOBAL MARKET" has been legally adopted by the Appellant under the Federal Laws of the United Arab Emirates (UAE).
- Regarding the objection related to the mark containing a geographical indicator, Appellant argued that there is no legal prohibition in the Trademarks Act against registering a composite mark that includes the name of a place.
- And in response to not filing an affidavit of use, Appellant clarified that when the application is filed on a proposed-to-be-used basis, there is no statutory requirement to submit an affidavit of use.

#### **RESPONDENT'S CONTENTIONS:**

- The Registrar's submissions were focused on the objections regarding the use of the name "Abu Dhabi" as a geographical indicator and the lack of distinctiveness of the mark.
- Respondent contended that the Assistant Registrar rightly rejected the mark based on the absolute prohibition stated in Section 9(1)(b) of the Trademarks Act, which prohibits the registration of marks containing the name of a place as the geographical name constituting the prominent part of the mark.

#### **ISSUES:**

- a. Whether the first ground cited by the Assistant Registrar, stating that the mark is neither coined nor invented, be considered valid or not?
- b. Whether the ground that Appellant had failed to establish distinctiveness by filing an affidavit of evidence of use of the mark can be considered valid or not?

c. Whether the ground that Abu Dhabi is a geographical name, being the capital of the UAE, and therefore non-registrable, considered valid or not?


**APPLICABLE STATUTES:**

Section 9(1)(b) of the Trade Marks Act, 1999

**RATIO:**

- With respect to the first ground cited by the Assistant Registrar as the basis for refusal is that the mark in question is not coined or invented it has been observed that the Trade Marks Act, specifically Sections 9 and 11, comprehensively and exhaustively outline the grounds for refusal of trademark registration and there is no requirement for a mark to be coined or inventive in order to be eligible for registration.
- While distinctiveness is a prerequisite, inventiveness is not necessary for trademark registration. Inventiveness is only required for the registration of a design or a patent therefore, the Assistant Registrar could not have refused to register the mark on the ground that it is not “coined” or “inventive”.
- With respect to issue of the Appellant’s failure to establish distinctiveness through the submission of an affidavit of evidence regarding the mark's use. This decision by the Assistant Registrar attempts to establish a connection between distinctiveness and evidence of use, which goes against the definition provided in Section 9(1)(a) of the Trade Marks Act. According to the Act, "distinctiveness" is defined as the capability to differentiate the goods and services of one person from those of another .
- It was observed that the requirement of ‘evidence of use’ to establish distinctiveness is not necessary. Accepting such an interpretation would render the registration of marks on a "proposed to be used" basis impossible, as sought in the present case. Therefore, the finding of the Assistant Registrar not only contradicts the provisions of the statute but also demonstrates a complete lack of consideration. .
- Furthermore, it was noted that the mark " ABU DHABI GLOBAL MARKET"

is already registered in favour of the Appellant with the Registrar of Trademarks, indicating the recognition of its distinctiveness. The Delhi High Court referred to the case of Mohd Rafiq v. Modi Sugar Mills, which cited Section 9(3) of the Trade & Merchandise Marks Act, 1958. According to which, a trademark must be adopted to distinguish the goods of the proprietor from those of others in order to be considered distinctive. As long as no one else uses the mark or a similar mark, it is generally not considered non-distinctive. Even if a mark may seem insignificant, if it is exclusively used by one person, it can be deemed distinctive. For example, if someone uses the simple exclamation mark (!) as a trademark and no one else is using it, it cannot be claimed that it lacks distinctiveness. Whenever the exclamation mark is mentioned in relation to that category of goods, people would naturally associate it with the sole registrant of the mark.

- In the present case, there is no evidence to suggest that the mark is being used by anyone else. Moreover, the mark consists of a combination of a  ABU DHABI GLOBAL MARKET motif and the words "ABU DHABI GLOBAL MARKET." Therefore, the ground on which the Assistant Registrar rejected the mark was deemed invalid.

- With respect to the third ground of refusal to register the mark for the reason that Abu Dhabi is a geographical name, being the name of the capital of the UAE and is, non-registrable under Section 9(1)(b) of the Trade Marks Act it was clarified that the Section in its clear and explicit terms, proscribes registration only of trade marks “which consist exclusively of mark or indications, which may serve in trade to designate the ... geographical origin... of the goods or services”. It is only, therefore, trade marks, which consist exclusively of marks or indications which designate the geographical origin of the goods, which cannot be registered. The Court held that *composite marks stand ipso facto excluded from the scope of Section 9(1)(b), even if part of such marks consists of marks or indications which serve, in trade, to designate the geographical origin of the goods or services in respect of which the mark is registered.*

- Therefore, the Court quashed and set aside the impugned order dated 9th December 2022 and allowed Application No 3184380 to be remanded to the office of the Registrar of Trademarks for advertisement and proceedings thereafter in accordance with law. The Court also explicitly expressed its dissatisfaction in the way



in which the Ld. Examiner disposed-off the examination of the trade mark application.

- In conclusion, the Court determined that the rejection of the trademark application was unjustified, as the grounds for rejection lacked a solid foundation. The Court emphasized that the registration of a trade mark does not require inventiveness, dismissing the need for evidence of usage to establish distinctiveness. The mark was deemed to possess distinctive characteristics, rendering the objection pertaining to the geographical name inapplicable to a composite mark.

Accordingly, the Court set aside the rejection and remanded the application for further proceedings. Therefore, it can be asserted that trademark registrars and authorities should prioritize specific aspects, such as:

- a. Conducting regular training sessions for trademark examiners to ensure consistent interpretation of laws.
- b. Streamlining the examination process to enhance efficiency and consistency.
- c. Ensuring transparency and accountability in the examination process.

## **5. Tata Sia Airlines Vs. Union of India**

**2023:DHC:3659**

**Decided on 25.05.2023, (Delhi High Court)**

### **PARTIES:**

- a. The Petitioner was 'Tata Sia Airlines' which operates a full-service airline under the trademark 'VISTARA'.
- b. The Defendant was Union of India.

### **BRIEF FACTS:**

The facts are straightforward: In 2019, The Delhi High Court declared 'VISTARA' as a Well-known trademark in TATA SIA Airlines Limited v. M/s. Pilot18 Aviation Book Store & Anr. CS(COMM) 156/2019. Thereafter, the Petitioner wrote to the Registrar of Trademarks to include its trade mark in the list of 'Well-known trade marks' vide Section11(8) of the Trade Marks Act, 1999 ('Act'). When the Registrar did not take the appropriate action, Petitioner filed this lis.

### **PETITIONER'S CONTENTIONS:**

The Petitioner's argued that once a trademark is declared 'Well-known' by a Court under Section11(8) of the Act, the necessity to file a form TM-M and the requisite fee of ₹100,000 under Rule 124(1) of the Trademark Rules, 2017 ('Rules') need not be fulfilled. It was reasoned that there are two authorities which can declare a trademark 'well known' : a Court of law under Section11(8) & the Registrar himself under Rule 124. Besides the determining authority under Rule 124(1), the Registrar also has the authority to include such trade marks in the register under Rule 124(5). However, when a Court of law has declared a trade mark 'well known', the Registrar cannot sit as an appellate authority or redetermine the status of such a trade mark. In other words, since the process of determination stands fulfilled, the Registrar ought to include such a trade mark in the register. And therefore, the requirements under Rule 124(1) need not be fulfilled.

### **AMICUS CURIAE CONTENTIONS:**

The Amicus Curiae echoed the Petitioner's submissions and added that Rule 124 is supplemental to Section 11(8) and provides an alternative mechanism to the proprietor to get his mark declared as Well-known. Moreover, the word 'shall' in Section 11(8) leaves no room for further determination by the Registrar and any insistence on his part to follow the procedure under Rule 124(1) would be contrary to the scheme of the Act. Additionally, the trade mark rules find no mention of a provision which necessitates the payment of a fee for a trade mark to be published in the list of Well-known trade marks. Therefore, the insistence of payment of fee by the Registrar is misconceived.

### **REGISTRAR'S CONTENTIONS:**

The Registrar agreed to the Petitioner's and Amicus Curiae submission inasmuch that once a trademark is declared Well-known by a Court, such trademark will be directly published under Rule 124(5) without engaging in procedure laid under Rule 124(3) & (4), both of which concern the power of determination of the Registrar. This much was agreed. Notwithstanding this, the Registrar submitted Rule 10(5) states that if a document is filed without fee, it shall be deemed not to have been filed at all. Moreover, Clause (k) in form TM-M and Entry-18 of the First Schedule both refer to inclusion of a trademark and not determination. Additionally, the Second Schedule shows 'Request for Inclusion of a Trademark in the List of Well-Known Marks', as opposed to request for determination of the mark as a Well-known mark. And lastly, Rule 124(1) makes it clear that procedure is to be followed. Therefore, when the procedure is to formally include a trademark declared Well-known in the register, the Registrar ought to do basic verification. Thus, the fee being charged (and the form being filled) is for the purpose of verification and due-diligence.

### **ISSUES:**

a. If a Court declares a trademark as 'Well-known' under Section 11(8) of the Act, can the Applicant be compelled to comply with Rule 124 of the Trademark Rules?

### **APPLICABLE STATUTES:**

Section 11(6) of the Trademarks Act, 1999

Section 11(7) of the Trademarks Act, 1999

Section 11(8) of the Trademarks Act, 1999

Section 11(9) of the Trademarks Act, 1999

Rule 124(1) of the Trademark Rules, 2017

Rule 124(2) of the Trademark Rules, 2017

Rule 124(3) of the Trademark Rules, 2017

Rule 124(4) of the Trademark Rules, 2017

Rule 124(5) of the Trademark Rules, 2017

**RATIO:**

- The Single bench, following the Golden Rule of Statutory interpretation to give words an ordinary meaning, observed that the use of “shall” in Section 11(8) leaves no room for redetermination of the status of trademark by the Registrar, once such determination has been made by a Court. Therefore, inasmuch the aspect of redetermination was concerned, the Single Bench upheld the argument of the Petitioner and the Amicus Curiae.
- The Single bench also upheld the submission of Amicus Curiae that there are two different mechanisms to declare a trademark Well-known: first, by a Court or the Registrar under Section 11(8). And second, by the Registrar on an application under Rule 124. Therefore, if either one of them has determined a trademark to be Well-known, the other cannot. Importantly, the Registrar himself conceded that once a trademark is declared Well-known, the Registrar will directly publish such a trademark under Rule 124(5) and will not engage in the procedure laid under Rule 124(3) & (4).
- The Single bench then observed that Section 11(8) is a mandatory provision in law; whereas, Section 11(6)(7) & (9) are criteria upon which the Well-known status of a mark is determined. Having said that, Section 11(8) does not provide a procedure to include the mark so declared in the List of Well-known Trademarks.
- It is at this stage; the applicability of Rule 124 becomes functional. To this extent, the Single Bench rejected the Petitioner’s contention that Rule 124 is restricted in the scope, and its ambit is limited only to determine if a trademark is Well-known.

Because evidently, the ambit of Rule 124 also has the aspects of examination of the trademark and its inclusion under Rule 124(5). In other words, when Rule 124 is read as a whole with Section 11(8), it provides the Registrar the power for inclusion of a trademark in the list of Well-known marks (and not merely of its determination, as contended by the Petitioner).

- Upon holding that the Registrar, under Rule 124, has the power of inclusion, it was evident that such process of inclusion must have due-diligence to be compiled with. On this aspect, the Single Bench observed that in Rule 11(1), the word used is “shall” and the mandate is that the Forms set forth in the Second and Third Schedules shall be used in all cases, to which they are applicable. Therefore, drawing attention to Column-3, the Single Bench observed that it deals with ‘*Title for which form may be used*’ under which there is a clear reference to ‘*Request to inclusion of a mark in List of Well-known Trade Marks*’. Therefore, when Column-3 is read with Rule 11, the conclusion is that even for a request to include a trademark in the List of Well-known Trademarks, Form TM-M is mandatory.

- Lastly, when Form TM-M is deemed mandatory, all there was left for the Court was to decide if the requisite fee must be filled along with Form TM-M. On this aspect, the Single Bench observed that Rule 10 & 11 and First & Second Schedule are relevant. The purpose to pay fee is under Rule 10, and although there is no express mention for the payment of fee for a trademark to be published in the list of ‘Well-known’ trademarks, the expression ‘any other matter under the act’ in Rule 10 will take effect. This is to be read with Rule 11, Entry 18 which provides a fee of ₹100,000 for inclusion of a trademark in the list of Well-known marks. In other words, when Section 11(8) is read with Rule 10(1)(2)(5) & 11(2), the fee of ₹100,000 is payable for both determination and inclusion of trademark in the list of Well-known marks. Accordingly, it was concluded that the fee is mandatory to be paid and form TM-M must also be filed.

**6. Mauj Mobile Private Limited Vs. Mohalla Tech Private Limited & Ors.  
2023 SCC ONLINE BOM 1094**

**Decided on 05.06.2023, (Bombay High Court)**

**PARTIES**

- a. The Appellant is Mauj Mobile Private Limited company specializing in premium mobile apps and content marketplaces.
- b. The Respondent Mohalla Tech is an Indian technology company, headquartered in Bangalore, India.

**BRIEF FACTS:**

Mauj Mobile Private Limited (“The Plaintiff”) filed for interim injunction before Bombay High Court against Mohalla Tech Private Limited (“The Defendant”) for using the mark “MOJ” which was allegedly deceptively or confusingly similar to the Plaintiff’s trade mark “MAUJ” that was registered and was in use since 2003 along with the domain name www.mauj.com which is also registered. The Plaintiff contended that the mark which was phonetically and visually similar to the Plaintiff’s mark was used by the Defendant in a short video social media app which constituted the tort of passing off.

**PLAINTIFF’S CONTENTIONS:**

- The Plaintiff contended that the use of the mark “MOJ” by the Defendant is an act of infringement upon Plaintiff’s registered trademark “MAUJ” because Defendant’s mark was merely a misspelling of the Plaintiff’s mark.
- The Plaintiff contended that the mark “MOJ” was phonetically very similar to that of “MAUJ” and it was hard not to notice how such phonetic similarity created a deception or confusion amongst customers.  
The Plaintiff also contended that both the marks are visually very similar to each other because there is a difference of just one word.
- Moreover, the Plaintiff contended that both the marks, “MOJ” and “MAUJ” had the same meaning in Hindi language creating an absolute ground of deception.

- The Plaintiff also argued that the nature of rival services is similar and hence, the Defendant has deliberately taken upon the mark “MOJ” with the intention of taking advantage of Plaintiff’s goodwill which constitutes to tort of passing off.

**DEFENDANT’S CONTENTIONS:**

- The Defendant, on the point of having same meaning in Hindi language, argued that its mark “MOJ” doesn’t comply to the Hindi meaning but it is an acronym of “Moments of Joy” so, there stands no chance of deception.
- The Defendant, on the point of visual similarity, argued that the mark “MOJ” had a laughing emoji that made it visually and structurally dissimilar to the Plaintiff’s mark. Also, the Defendant argued that the Plaintiff cannot claim monopoly over Hindi word because of it being generic in nature.
- The Defendant also argued that both the Plaintiff and the Defendant dealt in different business models (B2C vs B2B) and this fact eliminated any chance of confusion amongst public.

**ISSUES:**

- a. Does the argument given by the Defendant that there is no chance of deception because both, the Plaintiff and the Defendant deal in different business models stand?
- b. Whether the argument given by the Defendant that their mark “MOJ” was derived from its Hindi meaning ‘Moments of Joy’ and stood as acronym of the same stand?
- c. Whether the mark of the Defendant “MOJ” is visually and phonetically deceptively similar to Plaintiff’s trade mark “MAUJ” or not?

**APPLICABLE STATUTES:**

Section 29(9) of the Trade Marks Act,1999

Section 28 of the Trade Marks Act,1999

## **RATIO:**

- With respect to the first issue where the argument has been raised by the Defendant that there cannot be any deception by the use of the mark “MOJ” because both, the Plaintiff and the Defendant deal in different business models, the Hon’ble Bombay High Court was of the opinion that this argument given by the Defendant didn’t have any merit and cannot be allowed. The Plaintiff had registration of the trade mark “MAUJ” under Class 41 for “Entertainment” and the Defendant was also using the mark for similar services. Similarity in the nature of the services offered was a very valid reason for the mark “MOJ” to cause deception or confusion. The mere fact that they both are dealing in different business models (B2C vs. B2B) is not sufficient to conclude that the Defendant’s mark “MOJ” is not deceptively similar to that of Plaintiff’s trade mark “MAUJ.”
- Regarding the second issue, the Hon’ble Bombay High Court held that the argument given by the Defendant that MOJ being an acronym of ‘Moments of Joy’ was only an afterthought because the Defendant failed to furnish any material proof substantiating the claim. Also, the question was not in reference to the meaning of the mark but pertained to whether the Defendant’s mark can create confusion which will definitely be the case because of the visual and phonetic similarity and as far as the meaning is concerned if at all the mark ‘MOJ’ being an acronym of ‘Moments of Joy’, it would create confusion only because the Plaintiff’s mark ‘MAUJ’ also means the same in Hindi language.
- The Hon’ble Court also rejected the argument given by the Defendant stating that the Plaintiff cannot claim monopoly over a Hindi word opining that the dispute is not on the meaning of the word but on the word itself so, this argument stands futile.
- Regarding the third and final issue which was whether the Defendant’s mark ‘MOJ’ visually and phonetically deceptive in nature and whether it was capable of causing confusion with Plaintiff’s mark ‘MAUJ’, the Hon’ble Bombay High Court held that the Defendant’s mark was definitely deceptive. The Hon’ble High Court ruling again in the favor of the Plaintiff rejected Defendant’s argument that their mark had a laughing emoji unlike Plaintiff’s mark. The Court pointed out that merely adding an emoji in the mark was insufficient to help stand the mark distinguished



from the Plaintiff's registered trademark 'MAUJ'. The Hon'ble Bombay High Court also rejected Defendant's argument that the spelling of both the marks were different because of a letter missing from the Defendant's mark adjudicating that mere misspelling is not at all a strong difference that is supposed prevent confusion or deception claim. Also, the question was not in reference to the meaning of the mark but pertained to whether the Defendant's mark can create confusion which will definitely be the case because of the visual and phonetic similarity and as far as the meaning is concerned if at all the mark 'MOJ' being an acronym of 'Moments of Joy', it would create confusion only because the Plaintiff's mark 'MAUJ' also means the same in Hindi language.

- The Hon'ble Court also rejected the argument given by the Defendant stating that the Plaintiff cannot claim monopoly over a Hindi word opining that the dispute is not on the meaning of the word but on the word itself so, this argument stands futile.
- Regarding the third and final issue which was whether the Defendant's mark 'MOJ' visually and phonetically deceptive in nature and whether it was capable of causing confusion with Plaintiff's mark 'MAUJ', the Hon'ble Bombay High Court held that the Defendant's mark was definitely deceptive.

The Hon'ble High Court ruling again in the favour of the Plaintiff rejected Defendant's argument that their mark had a laughing emoji unlike Plaintiff's mark. The Court pointed out that merely adding an emoji in the mark was insufficient to help stand the mark distinguished from the Plaintiff's registered trademark 'MAUJ'. The Hon'ble Bombay High Court also rejected Defendant's argument that the spelling of both the marks were different because of a letter missing from the Defendant's mark adjudicating that mere misspelling is not at all a strong difference that is supposed prevent confusion or deception.

**7. Tv 18 Broadcast Limited vs Bennett, Coleman And Company Limited  
Decided on 04.07.2023, (Delhi High Court)**

**2023/DHC/004452**

**PARTIES:**


- a. Network 18 group, India's largest media and entertainment conglomerate is the Plaintiff in the present case.
- b. The Defendant is the media conglomerate "Times Group".

**BRIEF FACTS:**


The Plaintiff, part of a media and entertainment conglomerate, operates various television channels, including news channels like CNBC TV18, CNN News, and News18. The Plaintiff also runs a Hindi News channel titled "Bhaiyaji Kahin" under a registered trademark.

The Defendant, also a media conglomerate under the Times Group, operates television channels like Times Now, ET Now, and Times Now Navbharat. The Defendant launched a new show titled "Bhaiya Ji Superhit". The Plaintiff alleges that the Defendant's use of the term "Bhaiyaji" in their show infringes on their registered trademarks and causes confusion among viewers.

**PLAINTIFF'S CONTENTIONS:**

The Plaintiff adopted the device mark  on 29th December 2016 under class 38 and 41, with over 1,200 episodes since then. The show has gained significant goodwill and reputation, with some episodes garnering over 11 million views and winning various awards as well.

The Plaintiff's show "Bhaiyaji Kahin" generated revenue of Rs. 73,89,40,000/- from 2017-2018 to 2021-20211, with Rs. 16,26,42,000/- in 2021-2022 alone. In January 2022, the Plaintiff discovered that the Defendant, part of the Times Group, was

launching a show titled "Bhaiya Ji Superhit" using the trademark 

and is airing on Times Now Navbharat YouTube channel. The Plaintiff alleged that the Defendant's use of the term 'Bhaiyaji' creates confusion among viewers and constitutes trademark infringement. Plaintiff also raises a claim of passing off, alleging that the Defendant's use of the term "Bhaiyaji" in their show title deceives the public and creates an impression of association with the Plaintiff's popular show "Bhaiyaji Kahin," leading to potential damage to the Plaintiff's reputation and goodwill.

#### **DEFENDANT'S CONTENTIONS:**

The Defendant is part of the Times Group, involved in print, digital, and television media, including channels like Times Now, ET Now and Times Now Navbharat. The Defendant's show "Bhaiya Ji Superhit" is an infotainment program that aired on 8th January 2022 and is scripted and non-interactive, hosted by a comedian. The Defendant argues that "Bhaiyaji" is a generic Hindi word meaning "brother" and the Plaintiff cannot claim exclusive use. The Defendant further cites the Plaintiff's previous stand taken during trademark registration proceedings, which supports the use of the term "Bhaiyaji" as a part of a larger mark.

#### **ISSUES:**

- a. Whether the Defendant's use of the term "Bhaiyaji" in their show title "Bhaiya Ji Superhit" infringes on the Plaintiff's registered trademarks "Bhaiyaji Kahin" under class 38 and 41?
  
- b. Whether there is of likelihood of confusion between the Plaintiff's show "Bhaiyaji Kahin" and the Defendant's show "Bhaiya Ji Superhit."?

#### **APPLICABLE STATUTES:**

Section 28(2) of the Trade Marks Act, 1999

#### **RATIO:**

- Television programmes, especially news programmes, are categorized under class 41, not class 38. Class 38 specifically excludes television programmes and focuses on telecommunication services, which include television broadcasting. Therefore, the

names of television channels like "Times Now," "CNN News," and "News18" fall under class 38, while the names of the programmes aired on these channels are subject to class 41. Since the Plaintiff's registration for the mark "Bhaiyaji Kahin" has a clear disclaimer under class 41, the relevant class for determining infringement is class 41, making the Plaintiff's reliance on registration under class 38 irrelevant in this context.

- The only similarity between the marks of the Plaintiff and the Defendant is the use of the term "Bhaiyaji." However, there is no similarity between the terms "Kahin" and "Superhit" used by the Defendant. Given the disclaimer attached to the term "Bhaiyaji" under class 41, the Plaintiff cannot prevent the Defendant from using the same term. This is in line with Section 28(2) of the Trademarks Act, which states that the exclusive right to use a trademark is subject to any conditions and limitations specified in the granted registration.

Even otherwise, the term "Bhaiyaji" is a word of common use in certain states of India, including Uttar Pradesh and Bihar, which literally translates to the word "brother" and is therefore of non-distinctive character. Further, there was sufficient material to show that the term "Bhaiyaji" is a part of various television and radio programmes in India is therefore common to trade. Therefore, the term "Bhaiyaji" is a generic term of widespread use, and nobody can claim the exclusive right to use such a generic word.

- Defendant has also drawn the attention of the Court to the stand taken by the Plaintiff in its reply to the examination report of the Registry when the Plaintiff had applied for registration of the mark "Bhaiyaji Kahin" under class 41. In its reply dated 3rd April 2017, while distinguishing the Plaintiff's mark from the earlier mark, "Bhaiyaji Aisa Kyun", the Plaintiff has clearly taken a stand that the Plaintiff's mark is not similar to the said mark as the marks have to be compared as a whole and cannot be dissected. Having obtained registration on the basis of the aforesaid assertion, now the Plaintiff cannot be permitted to take a contrary stand that the Defendant's mark is infringing the Plaintiff's mark on account of both marks using the term "Bhaiyaji". The Plaintiff cannot be permitted to approbate and reprobate.

- Regarding the passing off claim, at an interlocutory stage, the Court found that

the formats of the Plaintiff's and Defendant's shows are substantially different. The Plaintiff's show is interactive and unscripted, hosted by a news anchor/journalist, while the Defendant's show is scripted and non-interactive, hosted by a standup comedian. Moreover, the shows air on different television channels. Therefore, in the Court's prima facie view, there is no likelihood of confusion between the two television shows.

Regarding the Plaintiff's assertion that the mark "Bhaiyaji Kahin" has acquired distinctiveness through long use, the Court opines that this aspect can only be appropriately examined during the trial and cannot be the sole basis for granting an interim injunction at this stage. In other words, the determination of acquired distinctiveness requires a thorough examination of evidence and legal arguments, which is more suitable for the trial proceedings rather than an interim injunction decision.

- In light of the analysis and findings presented in the case between the Plaintiff and the Defendant over the use of the term "Bhaiyaji" in their respective television shows, the Court has reached a definitive verdict. The Court dismisses the Plaintiff's application for an interim injunction, ruling in favour of the Defendant.

**8. Kamdhenu Ltd vs. The Registrar of Trade Mark  
Decided on 06.07.2023, (Delhi High Court)**

**C.A.(COMM.IPD-TM) 66/2021**

**PARTIES:**

- a. Kamdhenu Limited is the Appellant who filed an appeal against a decision of the Registrar of Trademarks, who had dismissed their application to have their trademark 'KAMDHENU' included in the "List of Well-Known Trademarks."
- b. The Registrar of Trademarks is the Respondent in the present case.

**BRIEF FACTS:**

- Application No. TM-M 764900 dated 17th August was filed by the Appellant for the inclusion of the word 'KAMDHENU' in the list of well-known marks.
- The Appellant initially incorporated as Kamdhenu Ispat Limited changed its name to Kamdhenu Ltd. and claimed to be the owner and proprietor of the trade mark 'KAMDHENU' in relation to various goods and services involving TMT steel bars, and various other construction-related materials such as structural steel, plywood, PVC pipes, allied goods, plaster of paris, water Proofing Compounds, Wall Putty etc. since the year 1994.
- The Appellant expanded its business over the years, venturing into milk, dairy products, mineral water, paint, real estate, etc. and other businesses. The said expansion has taken place over several years since 1994.
- Along with the TM-M Application several other supporting documents, such as judicial orders recognizing the Kamdhenu brand as a well-known mark, were also filed. Newspaper advertisements, contracts, invoices, media-related documents, and a list of successful cases where the Appellant obtained an injunction in respect of the 'KAMDHENU' mark were also placed on record. All of which was rejected by the Ld. Deputy Registrar in the hearing of 22<sup>nd</sup> February 2018.

- The Appellant had appealed before the Intellectual Property Appellant Board (IPAB) in 2019 which was later transferred to the High Court of Delhi in 2021, due to the abolition of the IPAB after the enactment of the Tribunal Reforms Act 2021.

#### **APPELLANT'S CONTENTIONS:**

The Appellant submits that the primary ground on which the Application had been rejected was due to the non-filing of evidence by way of an affidavit which is not a mandatory requirement under Rule 124 of the 2017 Rules and argues that Rules 80, 86, 95, 96 and Rule 45 of the 2017 Rules specifically states when an affidavit has to be filed. The Appellant also relies upon the provisions of the Indian Evidence Act, 1872, which allows the inclusion of both oral and documentary evidence. The Appellant further contended that Section 129 which provides the requirement of evidence by way of affidavit to be a directory provision in terms of Statement of Objects and Reasons accompanying the Trade Mark Bill 1999.

#### **RESPONDENT'S CONTENTIONS:**

The Respondent relied upon the Public Notice dated 22nd May 2017 bearing no. CG Office/TMR/Well-Known TM/355 issued by the Office of the Controller General of Patents, Designs and Trademarks, which requires filing of evidence for declaration as a well-known mark.

The Respondent also argued that from the nature of the required evidence, it is implicitly understood that the same has to be filed by way of an affidavit, and the non-filing of an affidavit would in effect mean that the same cannot be considered by the Registrar.

#### **ISSUES BEFORE THE COURT:**

- a. What is the nature of the evidence, and the documents which are to be filed by an Applicant for determination as a well-known trademark under Section 11 of the 1999 Act read with Rule 124 of the 2017 Rules?
- b. Was the rejection of the grant by the Registry justified on the failure of the Appellant to provide evidence of the well-known status of the mark by the way of affidavit?

**APPLICABLE STATUTES:**

2(1)(zg) of the Trade Marks Act 1999

11(6) of the Trade Marks Act 1999

11(7) of the Trade Marks Act 1999

11(9) of the Trade Marks Act 1999

Rule 124(3) Trade Mark Rules, 2017

Section 3 of the Evidence Act, 1872

**RATIO:**

- It was held that in the light of the provisions of the Evidence Act and the Public Notice, it is held that in order for a determination of well-known status of a trade mark, affidavit by way of evidence cannot be held to be a mandatory requirement for grant of well-known status under the 1999 Act and the 2017 Rules. However, documentary evidence would be required.
- In accordance to Rule 124(3) documents need to be supported by way of an affidavit, the Registrar can always give an opportunity to the Applicant to file such an affidavit rather than rejecting an application in a completely summary manner. The non-filing of the affidavit by way of evidence shall not be fatal to the application for determining well-known status.
- Registrar is expected to call upon the Applicant to comply with, if the documentary evidence and the statement of case is not sufficient. Non-filing of the affidavit could not have resulted in the dismissal of the Application itself.
- Opportunity to file supporting document is given to the Applicant in support of its Application for the grant of well-known status for the mark KAMDHENU.



**9. Google LLC v. DRS Logistics (P) Ltd. & Ors., and Google India Private Limited Vs. DRS Logistics (P) Ltd. & Ors.**

**Decided on 10.08.2023, (Delhi High Court)**

**(FAO (OS) (COMM) 2/2022) (FAO OS (COMM) 22/2022)**

**PARTIES:**

a. The Appellant Google LLC, is a company incorporated under the laws of the United States of America and owns, manages and operates the Google Search Engine ([www.google.com](http://www.google.com) /[www.google.co.in](http://www.google.co.in)) as well as the Google Ads Programme. Google India Private Limited, the Appellant in FAO OS (COMM) 22/2022, hereafter referred to as 'Google India', is a subsidiary of Google and is appointed as a non-exclusive reseller of the Ads Programme in India.

b. The Respondent no. 1 DRS Logistics (P) Ltd.) and Respondent no. 2 Agarwal Packers and Movers Pvt. Ltd. , are hereinafter collectively referred to as 'DRS'.

**BRIEF FACTS:**

The Respondent alleged that the Appellant was using the Respondent's trade mark as a keyword in its Ad Program, which resulted in the diversion of traffic from the Respondent's website to its competitors and, therefore, amounted to infringement under the Trade Marks Act. The Respondent also alleged that the Appellant encourages the use of its registered trademarks as keywords for third parties to display their sponsored links pertaining to websites that infringe its trade marks and also claims that use of its trademarks as keywords infringes the trade marks.

**APPELLANT'S CONTENTIONS:**

The principal contention of the Appellant in this regard was that since keywords are not visible to internet users, therefore, their use does not qualify as 'use of a mark' since 'use' under Section 2(2)(b) of the Trade Marks Act is to be construed as 'use of printed or other visual representation of the mark' For this contention, the Appellant relied on a catena of foreign judgements. This was further substantiated on the basis that use of keywords is not per se infringement across many jurisdictions.

Besides this argument already proffered, the Appellant also claimed that even if assuming ‘use’ of keywords amounts to using a trade mark, such use is made by the advertiser and not by the Appellant. In other words, the Appellant ‘merely permits the advertisers to use keywords for display of sponsored links; it does not select the keywords.

Moreover, the Appellant argued that since it is an intermediary, it can claim safe harbour under Section 79 of the IT Act. Further, the Appellant also contended that since the keywords are invisible, the statutory test of confusion (based on the marks perceptibility) is not met.

Lastly, the Appellant argued that the single bench’s reasoning was erroneous since ‘Meta Tag’ and ‘Keywords’ are not the same thing. The Appellant submitted that ‘Meta Tags’ are different from ‘Keywords’ because Meta-tags form part of the source code of the website, but keywords do not form a part of such a source. Moreover, keywords are not visible and are merely used for shortlisting the Ads that may be displayed pursuant to a search query that includes the relevant key word. Inter alia, the Appellant placed reliance on Google France SARL v. Louis Vuitton Malletier SA,( ECLI:EU:C:2010:159) where the Court held that ‘use’ of Keywords by the Appellant did not amount to use ‘in relation to goods & services’

#### **RESPONDENT’S CONTENTIONS:**

It alleged that the Appellant was using the Respondent’s trademark as a keyword in its Ad Program, which resulted in the diversion of traffic from the Respondent’s website to its competitors and, therefore, amounted to infringement under the TM Act. Respondent also claimed that internet users are deceived into believing that they are availing the services of the Respondent. The Respondent submitted that the Appellant actively promotes sponsored Ads and cannot claim safe harbour as ‘Meta Tags’ & ‘Keywords’ serve similar functions.

#### **ISSUES:**

- a. Whether use of the trademarks as keywords amounts to use of those marks for the purposes of Section 29 of the TM Act?
- b. If so, whether such use is that of the advertiser or by Google as well ?;

c. Whether the use of the trademark as keywords per se amount to infringement of a trade mark? and

d. If so, whether Google is absolved of its liability in respect of use of trademarks as keywords by virtue of being an intermediary under Section 79 of IT Act?

**APPLICABLE STATUTES:**

Section 2(2)(b) of the Trade Marks Act 1999

Section 2(2)(c)(i) of the Trade Marks Act 1999

Section 79 of the Information Technology Act 2000

Section 29(1) of the Trade Marks Act 1999

Section 29(4) of the Trade Marks Act 1999

Section 29(2) of the Trade Marks Act 1999

**RATIO:**

- The Division bench of the Delhi High Court observed that judgements relied on by the Appellant vary in determining the precise law. Moreover, some of the judgements were in the context of the Australian Trade Marks Act, the scope of which is smaller than that of Section 29 of the Indian act. Therefore, the Division bench relied on the Supreme Court's judgement in *Hardie Trading Ltd. v. Addisons Paint & Chemicals Ltd* ((2003) 11 SC 92) wherein it was held that Section 2(2)(c)(i) of the Trade Marks Act (which explains use of mark) is couched in wide terms and 'use' of a mark, other than physical form, could also be "in other relation whatsoever" to such goods.

- Having noted that the use of 'keywords' amounts to the use of a trade mark, the Division bench laid down a caveat that the use of a trade mark as a keyword does not constitute an infringement per se. The bench observed that rights conferred upon registration of a trade mark will not give the Respondent a monopoly upon the results of a sponsored search. This point was crucial since it concerns the extent of rights conferred upon registration. The bench was silent herein but noted that since the Respondent's grievance is that internet users are being diverted to the websites of their competitors (than their own website), they have rights and a remedy. In this

aspect, the application of Section 29(1) was rejected since it requires that the embezzler uses the mark in relation to goods or services in respect of which it is registered. This was evidently not the case here. Similarly, application of Section 29(4) was also not applicable to the facts at hand. Coming then to Section 29(2), the Division bench, while referring to several foreign judgments, put to use the Doctrine of Initial Interest Confusion. The bench held that if an internet user is initially confused upon opening the sponsored links containing the Respondent's mark, the indicia of infringement, as under Section 29(2), will stand fulfilled.

- Thus, infringement under Section 29(2) was made out.
- Also, the division bench did not accept the dicta adopted by the European Court of Justice in view of the fact that Appellant is an active participant in promoting the use of trademarks as keywords. Thus, it is the Appellant (and not the advertiser) who was liable.
- With regard to the Appellant's contention regarding distinction in 'Meta Tags' and 'Keywords' the bench while noting that there is some merit in this contention, they upheld the decision of the single bench by reasoning that 'Meta-tags' and 'Keywords' serve a similar purpose for displaying advertisements and attracting internet traffic. Thus, the dicta of Indian judgments where use of a trade mark as a Meta-tag was considered infringement, and they would squarely be applicable to keywords. The bench held that 'safe harbour' is also unavailable to the intermediary if he selects the receiver of the transmission.'

Noting that Google is an active participant where it monetized the keywords and sold the use of them, it cannot be said that Google is merely an intermediary. The judgement is significant on two accounts: Firstly, it undertakes a comparative analysis of the trite law on the subject matter, bringing to the fore the differences between foreign jurisdiction and our law. And secondly, it endeavours to harmonize the change in electronic commerce vis-à-vis the rights in a trademark for a proprietor. Having said that, two observations could be made herein: Firstly, it seems quite apparent that the reasoning for the difference between 'Meta tags' & 'Keywords' needs further elucidation since both serve a different function and involve a significant technical question. Thus, it must be critically examined.

And secondly, the bench has left the question open whether the unpermitted use of a registered trademark as a meta-tag by a third party would lead to infringement of the trademark under the Trade Marks Act, leaving a substantial grey area about the law to be answered.

## **10.Sun Pharma Laboratories Ltd vs Finecure Pharmaceuticals Ltd & Ors**

**Decided on 16.08.2023, (Delhi High Court)**

**2023: DHC:5755**

### **PARTIES:**

a. The Appellant “Sun Pharma Laboratories Ltd.” is claimed to be the largest pharmaceutical company in India and the fourth largest Generic Pharmaceutical Company in the world with a global turnover of ₹33,139 crores.

b. The Respondent “Finecure Pharmaceuticals Ltd. & Ors.” is claimed to be a leading manufacturers and marketers of Pharmaceutical formulations and Nutraceuticals in several therapeutic segments and is also WHO GMP certified and ISO certified.

### **BRIEF FACTS:**

- The Plaintiff manufactures pantoprazole, an anti-acidity drug, under the brand name PANTOCID in many varieties, both as stand-alone and in combination with other drugs.
- Wherein it is in combination with other drugs, suffixes are added to the term like PANTOCID-L, PANTOCID-DSR and so on, each of which holds registration under the Trademarks Act, 1999.
- The Plaintiff came across the Defendant’s product, PANTOPACID, which also contains pantoprazole, in April 2023 and alleged that the Defendant’s mark was similar to theirs. However, the Defendants claimed to have adopted the mark in 2007 which they have been using ever since.
- Moreover, the notice of opposition opposing the mark of Defendant No.3 was filed by the Plaintiff in 2010 after which they waited for 13 years to approach the Court in 2023

### **PLAINTIFF'S CONTENTIONS:**

- The Plaintiff contended that the Defendant's mark is merely a convenient corruption of the Plaintiff's mark with the only difference of the letters PA in between the word, thus making PANTOPACID visually, structurally and phonetically similar to PANTOCID.
- The Plaintiff also averred that the Defendant's mark would lead to unwary customers mistaking the Defendant's products for the Plaintiff's. They further alleged that the adoption of PANTOPACID has resulted in the infringement of the Plaintiff's registered mark, under Section 29(2)(b) of the Trademarks Act, 1999.
- The Plaintiffs sought to permanently restrain the Defendants from using the mark PANTOPACID or any other variant mark which is deceptively similar to the Plaintiff's PANTOCID, by means of an injunction from the Court.

### **DEFENDANTS' CONTENTIONS:**

- The Defendants have contested the case on various fronts through their written statement, the first and foremost, addressing the aspect of similarity. They claimed that PANTOPACID is not deceptively similar to the Plaintiff's PANTOCID, rather it was a mere portmanteau of the words PANTO (for pantoprazole), P (to indicate that the drug was a Proton Pump Inhibitor) and ACID (referring to the drug being used to treat acidity).
- The Defendants also averred that they sought registration for PANTOPACID in 2009, under the Trademarks Act, in Class 5 of the Nice Classification of Trade marks. The Plaintiff had then filed a notice of opposition in 2010 to which the counter statement was filed by the Defendants in 2011. The Plaintiff, thereafter, waited for 13 years to approach the Court as a result of which the Defendants alleged that the plaintiff suffers from delay, laches and acquiescence.
- The Defendants also contended for the registration of the Plaintiff's trade mark to be revoked for having been sought on misrepresentation. An earlier application under the same name was filed by a German company Takeda GMBH, for the same product under the same class. Hence, the Plaintiffs did not coin the term as claimed

in their suit.

- The Defendants also disputed the Plaintiff's monopoly over the word PANTO of PANTOCID, as it only merely duplicates a part of the name of the original product pantoprazole. Moreover, the word PANTO has been used as a prefix in almost 371 registered trademarks for pharmaceutical products.
- Another averment was the fact that both these products of PANTOCID and PANTOPACID could only be dispensed with the prescription of a medical practitioner, who unlike an unwary consumer, will be well versed with the names of these medicines and their companies, thus eliminating the chance for causing confusion. The Defendants also claimed to be untrue the averments in the plaint stating that PANTOPACID has not been featured in any medical journals where in reality, in several journals since 2007, PANTOCID and PANTOPACID have shared spaces.
- Further, the Defendants also alleged that in order to support their claims, the Plaintiffs have relied on invoices that are fabricated. Based on these reasons the Defendants believed that the Plaintiffs did not deserve to be granted an interlocutory injunction.

**ISSUES:**

- a. Whether the Plaintiff has proprietary rights over the mark PANTOCID or not?
- b. Whether the Defendant's mark PANTOPACID is deceptively similar to PANTOCID or not?
- c. Whether the Plaintiff's registration of the mark PANTOCID is valid or not?
- d. Whether the Defendant's usage of the mark PANTOPACID could possibly create confusion in the market or not?
- e. Whether the Plaintiff is entitled to injunctive relief or not?

**APPLICABLE STATUTES:**



Section 9, Trade Marks Act, 1999  
Section 11(1), Trade Marks Act, 1999  
Section 11(4), Trade Marks Act, 1999  
Section 12, Trade Marks Act, 1999  
Section 17, Trade Marks Act, 1999  
Section 19, Trade Marks Act, 1999  
Section 28, Trade Marks Act, 1999  
Section 29(1)(b), Trade Marks Act, 1999  
Section 31, Trade Marks Act, 1999  
Rule 50(4), Trade Mark Rules, 2017  
Rule 53(1), Trade Mark Rules, 2017

**RATIO:**

- It was observed that, according to Section 28(1) of the Trademarks Act 1999, the mere proprietorship of a registered trade mark will not render the proprietor the right to obtain relief against any infringements. The registration is primarily required to meet the condition of validity. In other words, only valid registered trademarks are entitled for protection against infringement.
- Validity of the trademark is a necessary pre-condition not only for obtaining the final relief in the case of infringement, but also equally for interlocutory reliefs, like in this case. Validity of registration in itself has nothing to do with registration, however, it comes into play with the right of the Plaintiff to obtain relief against infringement. According to the Court, “even if infringement exists, the Plaintiff, as the holder of the registered trademark, cannot be entitled to any relief against such infringement, unless and until the registration of the Plaintiff’s trademark is valid. That is, statutorily, the inexorable scheme of Section 28(1) and Section 29 of the Trade Marks Act.”
- Registration of the trademark is not a conclusive proof for validity, rather it is merely a prima facie proof. However, the Plaintiff is only expected to make prima facie evidence at the interlocutory stage wherein the onus to displace such a case established by them is predominantly on the Defendants.

- For “infringement” to take place under the Trademarks Act, 1999 there are three conditions to be satisfied. The first condition is that the goods and services of the Defendants should be similar to that of the Plaintiff’s trademark. The goods and services represented by the marks of both the parties should be identical or similar. It should cause confusion to the consumers or lead to the association of the Defendant’s trademark with the Plaintiff’s trademark.

- There is evident visual and phonetic similarity between PANTOCID and PANTOPACID and both these marks are used to represent pantoprazole. It is only likely for these two marks to cause confusion among the consumers, especially in a scenario wherein a consumer who has once used PANTOCID who comes across PANTOPACID later on to mistake the latter for the former. The deceptive similarity does not cease to exist just because it is a prescriptive drug as claimed by the Defendants. It is humane to commit errors and if not the prescribing doctor, it is highly probable for the dispensing chemist to get confused between the products.

- It was argued by the Defendants that PANTO being the prefix cannot be claimed exclusivity over by the Plaintiffs as that portion alone has neither been registered in the Plaintiff’s favour nor is it a unique word as it is common to trade among pharmaceuticals products. However, to this the Court held that the Plaintiffs did not contend similarity between the marks due to the word PANTO alone, but owing to the visual and phonetic similarity between both of the entire words. Hence, the Court accepted that there exists deceptive similarity between both the marks leading to a prima facie infringement.

- The Court also identified that the claim of the Plaintiffs to have coined the term PANTOCID to be false owing to the earlier application made by the company Takeda. It was found that the plaintiff tries to suppress this earlier application and all aspects relating to it.

- Another false claim of the Plaintiff was that they came across the existence of the mark PANTOPACID in April 2023 as the Plaintiffs themselves had opposed the Defendant’s application in 2010. The Plaintiffs were also found to have omitted the legal notice they served in 2010 while drafting the current plaint. Hence, the Plaintiff

was found to have conveniently waited for 13 years to file the suit fully aware that PANTOPACID had been functional the whole time. As the Plaintiff did not approach the Court with clean hands, the Court held that their application deserving to be rejected.

- The Court held that it would not be just to the Defendants to bring the usage of PANTOPACID to a halt knowing that the Plaintiff took no steps from 2010 to 2023 about the infringement fully aware of the existence of such a mark. However, the Court directed the Defendants to maintain accounts of their earnings from the use of PANTOPACID mark, to be periodically submitted to the Court.
- As the Plaintiffs were not successful in establishing their entitlement to relief against the Defendants, the prayer for interlocutory infringement was rejected by the Court.

**11. Viridian Development Managers Private Limited &Anr. Vs. RPS Infrastructure Limited**

**Decided on 06.11.2023, (Delhi High Court)**

**O.M.P.(I) (COMM.) 335/2023, 2023 SCC OnLine Del 7134**

**PARTIES:**

- a. Appellants are Viridian Development Managers Private Limited (Petitioner No.1) and WTC Faridabad Infrastructure Development Private Limited (Petitioner No.2)
  
- b. RPS Infrastructure Limited is the Respondent in this case

**BRIEF FACTS:**

The Petitioners, Viridian Development Managers Private Limited and WTC Faridabad Infrastructure Development Private Limited, filed a petition under Section 9 of the Arbitration and Conciliation Act, 1996, seeking various reliefs against the Respondent, RPS Infrastructure Limited. The dispute arises from a project developed by the Respondent in Faridabad known as "RPS Infinia." In 2021, the Respondent approached the Petitioners for branding and sales services, leading to the execution of a Memorandum of Understanding (MOU) and consultancy agreements on June 28, 2021. The MOU and agreements outlined the rebranding of the project as "WTC Faridabad" and the use of certain trademarks. Disputes arose between the parties, leading to the Petitioners terminating the agreements through a legal notice on May 12, 2023. The Petitioners allege that the Respondent continued using their trademarks improperly, violated agreements, and failed to make payments. Legal notices were exchanged, and the Petitioners invoked arbitration on October 4, 2023.

**APPELLANT'S CONTENTIONS:**

- The Appellants seek interim orders to restrain the Respondent from using specific trademarks related to World Trade Centre and to inform the public about the dissociation of the projects from World Trade Centre.
  
- The Petitioners argue that despite the termination of the MOU and agreements,

the Respondent continued to use the trademarks, including "World Trade Center Faridabad," "WTC Faridabad," and the WTC Logo. This, according to the Petitioners, amounts to a clear violation of their intellectual property rights.

- The Petitioners contend that the Respondent's continued use of their trademarks creates a false impression in the minds of the public, suggesting an association between the projects, namely "RPS Infinia" and "12th Avenue," and the World Trade Centre brand. They assert that such misleading practices harm their brand image and reputation.
- The Petitioners rely on the estoppel doctrine, arguing that once the Respondent has enjoyed the benefits of the branding services outlined in the MOU and agreements, it is legally barred from questioning the basis of the branding or demanding a copy of the original license agreement.
- The Petitioners emphasize the urgency of obtaining interim orders, stating that the continued unauthorized use of their trademarks by the Respondent is causing immediate and irreparable harm to their brand and business.

### **RESPONDENT'S CONTENTIONS**

The Respondent contends that the Petitioners approached the Court with a delay of five months from the termination of the agreements. The Respondent raises the issue of delay, pointing out that the Petitioners approached the Court five months after terminating the MOU and agreements. They argue that the delay raises questions about the urgency and necessity of interim orders.

- The Respondent contends that the Petitioners' failure to provide a complete copy of the license agreement raises doubts about the authenticity and completeness of their rights to the trademarks. They assert that the incomplete license copy holds no value in establishing the legitimacy of the trademark usage.
- In response to the potential issuance of interim orders, the Respondent requests a reasonable period to approach the Real Estate Regulatory Authority (RERA) and financial institutions. They argue that any order restraining the use of trademarks may

necessitate changes in documentation related to the project.

- The Respondent, in their email dated 15.09.2023, highlights a payment dispute, claiming that significant amounts have been paid to the Petitioners for branding fees. They question the authenticity of the services provided by the Petitioners and seek clarification on the License Agreement and MOU with "WTCA New York."

**ISSUES:**

- a. Whether the Court should grant interim orders restraining the Respondent from using specific trademarks after termination of agreements?
- b. Whether the delay of five months in approaching the Court affects the Petitioners' claim?
- c. Whether the non-supply of a complete copy of the license agreement affects the Petitioners' right to the trade mark?
- d. Whether the Court should allow time for the Respondent to make necessary changes if any order is passed restraining the use of trademarks?

**APPLICABLE STATUTES:**

Section 9 of the Arbitration and Conciliation Act, 1996

Section 29 of Trade Marks Act, 1999

**RATIO:**

The Memorandum of Understanding (MOU) and Agreements, executed on 28.06.2021, confer upon the Respondent the right to utilize and/or license the brand/marks of the Petitioners, specifically "World Trade Center Faridabad," "WTC Faridabad," and the WTC Logo, for the rebranding of the "RPS Infinia" Project. Clause 2.6 of the MOU explicitly states that upon termination of the agreement, the developer/Respondent loses any right to use the Petitioners' brand/marks associated with the Project. The clause reads:

*“Neither Developer, nor any plot/unit buyer in Project shall have any right or claim or interest in any brand/trademark associated with the Consultant in any way, and upon termination/determination of this agreement have no right to use any brand/trade mark, identical or deceptively similar thereto, in relation to Project, expansion or part thereof.”*

- On 12.05.2023, the Petitioners terminated the MOU and Agreements, asserting that the Respondent is prohibited from using the Petitioners' brand/mark for the "RPS Infinia" Project. The argument is based on the principle that post-termination of a license contract, any use of the mark by the ex-licensee constitutes trademark infringement and deceives the public by implying an ongoing connection with the licensor. Drawing from legal precedents and principles outlined in "McCarthy on Trademarks and Unfair Competition," the Petitioners argue that the Respondent has no right to continue using the mark after the termination.
- With the termination of the MOU and Agreements through a legal notice dated 12.05.2023, the Respondent is expressly prohibited from using the Petitioners' brand/marks, including "World Trade Centre Faridabad," "WTC Faridabad," and WTC Logo, in connection with the Project.
- The Court cites *Morgardshammar India Limited v. Morgardshammar AB*, emphasizing that upon license revocation, the licensee is restrained from using the trademark. Another case, *Sorrel Hospitality Pvt. Ltd. v. Nakodar Hotels Pvt. Ltd.*, is referenced to underscore that termination of the agreement renders the licensee a non-permitted user, justifying an injunction. The use of a mark by an ex-licensee after the termination of a license contract constitutes trademark infringement. This continued use is viewed as misleading to the public, fostering the belief that the ex-licensee remains connected to the licensor. The licensor, post-termination, has the right and duty to ensure the consistency and quality of goods or services associated with its mark. The law unequivocally states that once a license has expired, any use of the formerly licensed trademark is considered infringement, and no rights are established by such use.
- Relevant judicial decisions further support the notion that upon termination of a license, the ex-licensee is prohibited from using the licensed trademark. The rationale is based on the principle that there can be only one mark, one source, and one proprietor for a trademark. These decisions establish that after termination, the ex-licensee is not considered a permitted user and is restrained from using the trademark.

- Concerning the argument of delay in approaching the Court, the Petitioners contend that once infringement is established, delay is not a valid defense. The Court concurs with this position, citing *Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia*, which establishes that mere delay does not defeat the grant of an injunction in cases of trademark infringement. Therefore, in cases of infringement, delay cannot defeat the grant of an injunction. The essence is that once infringement is proven, an injunction is warranted.
- Considering the evidence and legal precedents, the Court finds that the Petitioners have made a prima facie case for injunctive relief against the Respondent's use of the marks. The termination of the MOU and Agreements deprives the Respondent of any right to the brand/marks, and the continued usage poses a risk of confusion and deception to the public.
- In response to the Respondent's request for time to make necessary changes, a two-week period is granted to apply for changes in regulatory and financial documentation. The switchover to a non-infringing mark is mandated to be completed within three months. The removal of references to the brand/marks from digital and promotional materials is also directed.
- The Court upholds the Petitioners' right to seek injunctive orders against the Respondent and rejects the contention that delay affects their rights. The Court emphasizes that the Respondent's use of the marks post-termination constitutes infringement and must be restrained.



## **12. Bolt Technology Ou Vs. Ujoy Technology Private Limited & Anr.**

**Decided on 30.11.2023, (Delhi High Court)**

**2023/DHC/001312**

### **PARTIES:**

a. Formerly known as Taxify OU, the Plaintiff, Bolt technology OU, was incorporated in 2013 in Estonia as a taxi aggregator, to aggregate all taxis in Tallinn, Estonia, Riga and Latvia on one platform.

b. The Defendant is Ujoy Technology Pvt Ltd., which makes only EV charging docks/stations under the name 'Bolt'.

### **BRIEF FACTS:**

- The Appellant, a globally recognized mobility service provider operating in 400 cities across 45 countries, sought to establish its exclusive right to the mark "BOLT" in connection with electric bikes, scooters, and allied services. The Respondent, who applied for trademark registration in 2021 for Electronic Vehicle (EV) chargers under the same mark, faced allegations of potential confusion and passing off.
- The Court, in analyzing transborder reputation, emphasized the need for the Appellant to demonstrate spillage of goodwill into India. Despite the Appellant's extensive global presence and services, including e-scooter sharing and ride-hailing, the Court found insufficient evidence of transborder reputation in the specific field of EV charging.

### **APPELLANT'S CONTENTIONS:**

- Trademark Adoption and Use: The Appellant asserts that it adopted the "BOLT" mark in 2018 and consolidated operations under this mark in 2019, focusing on EV-related services globally.

International Reputation: Relying on the concept of transborder reputation, the Appellant contends that it has an international reputation in the mark, with registrations in over 85 countries as of August 2022. The Appellant cites MAC Personal Care Pvt. Ltd. v. Laverana GMBH & Co. KG to support the claim that an

international reputation can suffice if it spills over to India.

- **Commercial Presence in India:** The Appellant argues that it has a presence in India, supported by the number of downloads of its mobile app, advertising campaigns, and media coverage.
- **Allied/Cognate Goods or Services:** The Appellant relies on the principle of allied/cognate goods and services, arguing that EV-related services and EV charging stations are related and likely to cause confusion.
- **Intent to Launch in India:** The Appellant refers to Starbucks (HK) Ltd v. British Sky Broadcasting Group, emphasizing that the intent to launch services in a country is relevant in determining protectable goodwill.
- **Dishonest Adoption:** The Appellant asserts that the Respondent had knowledge of the "BOLT" mark before adoption, indicating a dishonest adoption, and highlights the Respondent's initial use of the name "REVOS."

#### **RESPONDENT'S CONTENTIONS:**

- **Specificity Challenge:** Respondent disputes Appellant's lack of specific details on "BOLT" mark adoption.
- **India Presence Dispute:** Respondent challenges Appellant's claim of significant India presence, citing lack of specifics on EV charging operations.
- **New Facts Objection:** Respondent objects to introduction of new facts, particularly allied services argument.
- **Generic Nature Claim:** Respondent argues "BOLT" is generic, showing no confusion in visual mark comparison.

#### **ISSUES:**

- a. Whether the Plaintiff has, prima facie, been able to make out a case of passing off, by the Defendant, of its product or services as those of the Plaintiff, by use of the impugned BOLT mark?

b. Whether the Appellant has sufficiently demonstrated transborder reputation for the "BOLT" mark in the EV charging sector, particularly in the context of India, and whether there is substantial spillage of goodwill into the Indian market to support a passing-off claim?

c. Whether the Respondent's claim of prior use of the "BOLT" mark in EV charging services is credible, based on social media posts and trademark applications since 2020?

d. Whether the scope and impact of the services offered by both parties, w.r.t to the likelihood of confusion among consumers, and examining the distinctiveness of the services in question render the trademark valid in India?

**APPLICABLE STATUTES:**

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

Section 11(6) of the Trade Marks Act, 1999

Section 11(9) of the Trade Marks Act, 1999

Section 56 of the Trade Marks Act, 1999

**RATIO:**

- The legal principles surrounding the establishment of goodwill and reputation in passing-off actions, particularly in the context of transborder reputation, play a crucial role in shaping the outcome of cases involving trademark disputes. These principles, as elucidated by various legal precedents such as Milmet Oftho Industries v. Allergan Inc., Keller Williams Realty v. Dingle Buildcons Pvt. Ltd., and the Anheuser-Busch case, reflect the evolving dynamics of global commerce, communication technologies, and the need for a balanced approach in protecting the rights of trademark proprietors.

One fundamental aspect addressed in these legal principles is the concept of transborder reputation. The Court, drawing from precedents, emphasizes that a claimant can enforce an unregistered trademark in a jurisdiction if there is international reputation and if that reputation spills over into the jurisdiction concerned. The notion of spill-over is crucial in establishing the link between the

global recognition of a trade mark and its impact on the relevant jurisdiction, in this case, India.

- The Court, referring to the Busch case, underscores the importance of having customers in the jurisdiction where the passing-off action is brought to establish goodwill. While goodwill is traditionally considered territorial, the evolving nature of international trade and communication challenges this principle. The Court acknowledges the spillover factor, recognizing that reputation and goodwill can permeate across borders, especially in the era of the internet and modern communication technologies.

- In assessing transborder reputation, proof of reputation becomes a pivotal element. The Court outlines that the Plaintiff must demonstrate that their trade mark has gained international recognition, and this reputation spills over into the relevant jurisdiction, emphasizing India in this case. This proof of reputation extends beyond mere mechanical repetition and requires material scrutiny from various perspectives.

- The Court stresses the importance of media and general awareness, including advertisements in the media and the internet, as evidence of the product's recognition among consumers.

- The legal principles further delve into the distinction between reputation and goodwill. *While goodwill traditionally requires a business presence, reputation is a matter of fact related to the extent to which the indicium is known in the public mind.* This distinction is vital in understanding the parameters for establishing the rights of a trademark proprietor, particularly in cases where a commercial presence may be limited.

The Court, points out that even if the proprietor cannot establish customers or sufficient goodwill in the jurisdiction, well-known marks are protected. This legal provision reinforces the idea that the reputation of a trademark, irrespective of a commercial presence, deserves protection, provided it meets the criteria of being well-known and having international recognition.

- The Court considered the Respondent's claim of having established EV charging stations across India, and after evaluating the evidence presented by both parties, the Division bench concurred with the view of Single Judge, concluding that the Appellant failed to establish a prima facie case for injunctive relief. The decision

hinged on the court's interpretation of the evidence regarding the scope and impact of the respective services offered by the parties under the "BOLT" mark. It was observed that *“Mere global reputation or asserted goodwill has neither been accorded a judicial imprimatur nor accepted as being sufficient by our courts to answer a claim of transborder reputation. In order to succeed on this score, it is imperative for the claimant to prove and establish the existence of a significant and substantial reputation and goodwill in the concerned territory. Unless a sizeable imprint of the presence of the mark is established amongst the consuming public, a claimant would not be entitled to protection. In fact, knowledge amongst a sizeable and noteworthy number of the concerned segment would be a sine qua non for proving reputation itself.”*

- In conclusion, the legal principles outlined underscore the complexity of transborder reputation and the evolving landscape of global commerce. The Court's ratio in these legal precedents provides guidance on factors such as proof of reputation, general awareness, dishonest adoption, and the distinction between reputation and goodwill. The need for recognition of the changing dynamics in the digital era and the importance of adapting legal frameworks to protect trademark rights in an interconnected global landscape.

### **13. Berger Paints India Limited vs JSW Paints Private Limited**

**Decided on 12 December, 2023, (Calcutta High Court)**

**2024 LiveLaw (Cal) 1**

#### **PARTIES:**

- a. The Petitioner is “Berger Paints India Limited”
- b. The Defendant is JSW Paints Private Limited.

#### **BRIEF FACTS:**

- In the instant matter, the Petitioner-Plaintiff, Berger Paints India Ltd., filed an application seeking an injunction to restrain the Defendant-Respondent from infringing its registered trademark “SILK” by using the trademark “HALO SILK”. The Plaintiff, originally incorporated in 1923 as Hadfields India Ltd., has evolved into Berger Paints India Ltd. and has a significant international presence.
- The Plaintiff owns over 250 trademarks in India, including the registered trademark “SILK” adopted in 1980 for paint products. In December 2019, the Plaintiff discovered that the Defendant, a newcomer in the paint industry, was using the mark “HALO SILK” for its products. The Plaintiff issued a legal notice to cease and desist, but the Defendant refused to comply. The Defendant, a newcomer in the paint industry, has been marketing its products using the mark “HALO SILK”, leading to a legal dispute.

#### **PETITIONER’S CONTENTIONS:**

- The Plaintiff contended that “SILK” has been used since 1980 and has become a highly sought-after brand in the field of paint and allied products. It was contended that the Plaintiff conducted extensive promotional campaigns to establish the reputation of its trademark “SILK”.
- The Plaintiff alleged that the Defendant’s use of “SILK” in conjunction with “HALO” infringes on its well-known trademark, causing confusion and taking advantage of the Plaintiff’s reputation. The Plaintiff asserted that the Defendant has no right to use the “SILK” mark, as it is the exclusive property of the Plaintiff for paint products.

### **RESPONDENT'S CONTENTIONS:**

- The Defendant argued that “SILK” on the Defendant’s packaging is used to describe the characteristics/quality/finish of its products, not as a trademark. The Defendant claimed that the use of “SILK” is industry jargon indicating a mid-shine finish and easy maintenance. According to the Defendant, the term “SILK” for paint finish is customary in the trade and not capable of exclusive protection.
- The Defendant challenged the Plaintiff’s exclusive rights over “SILK”, citing the lack of statutory or common law support. It was contended that the Defendant filed trademark applications for labels in January 2020, specifically for the silk finish variant, which were accepted and advertised by the Registrar of Trademarks.

### **ISSUES BEFORE THE COURT:**

- a. Whether the Defendant’s use of “SILK” amounts to infringement constitutes trademark infringement or if the term is merely descriptive and customary in the paint industry?
- b. Whether the Plaintiff can claim exclusive rights over the term “SILK”?

### **APPLICABLE STATUTES:**

- Section 2(1)(h) of Trademarks Act, 1999
- Section 17 of Trademarks Act, 1999
- Section 29 of Trademarks Act, 1999

### **RATIO:**

The Court stated that the Trademark protection involves establishing a connection during trade between a manufacturer and their goods, serving as a “badge of origin.” The distinctive nature of a trademark is crucial for distinguishing goods and services, with the primary aim of protecting consumers from being misled. Trademark infringement is assessed by comparing the two marks, focusing on the likelihood of confusion or deception. The Court referred to *Durga Putt Sharma v. Navaratna Pharmaceuticals Laboratories*, 1964 SCC OnLine SC 14, *F. Hoffman La Roche &*

Co. v. Geoffrey Manner Co. (P) Ltd., (1969) 2 SCC 716, Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73 and Ramdev Food Products (P) Ltd. v. Arvind bhai Rambhai Patel, (2006) 8 SCC 726, emphasizing the need to establish deceptive similarity and the potential for confusion.



- The Court observed that the principle of trademark dilution, though not explicitly mentioned in the law, is recognized to protect well-known trademarks from losing their distinctiveness due to unauthorized use in connection with dissimilar goods. The Court highlighted the distinct requirements for infringement under Section 29(1) and (2) and dilution under Section 29(4), emphasizing the importance of protecting well-known trademarks from losing their distinctiveness.

The Court observed that Section 29(4) of the Trademarks Act, 1999 addresses trademark dilution, specifically for dissimilar goods or products. The Court relied on the principles established in *Daimler Benzaktiegesellschaft v. Eagle Flask Industries Ltd.*, 1993 SCC OnLine Del 604, to emphasize the importance of preventing dilution for marks that have achieved global recognition. The Court noted that unlike infringement actions for similar goods, Section 29(4) does not require a likelihood of confusion. The Court observed that to establish trademark dilution, the Plaintiff must prove:

- a. Identity or similarity of the marks,
- b. Reputation of the senior mark in India,
- c. Use of the impugned mark without due cause, and
- d. Unfair advantage or detriment to the distinctive character or reputation of the registered trademark.



- Referring to Canon Kabushiki Kaisha v. Metro Goldwyn Mayer Inc., 1999 RPC 117, the Court emphasized the need to assess the likelihood of association between conflicting marks, even in the absence of direct or indirect confusion.
- The Court emphasized the need for the Plaintiff to establish that their mark has a reputation in India, and that the use of the Defendant's mark is without due cause and detrimental to the distinctive character or repute of the registered trademark.
- The Court noted the absence of a presumption of infringement under Section 29(4), and stated the Plaintiff must prove each element of dilution. The Court noted that the Plaintiff asserted the deceptive similarity based on the use of "SILK" by the Defendant and on the other hand, the Defendant asserted that "SILK" is used merely to describe the paint finish, i.e., as a customary term in the paint trade and not as a trademark.
- Taking into account the Defendant's contention that the Plaintiff's registrations for "SILK" included disclaimers, limitations, and conditions, making them distinguishable from the present case, the Court analysed Khadim India Ltd. v. Lifestyle International (P) Ltd., 2015 SCC OnLine Cal 3866 and Parakh Vanijya (P) Ltd. v. Baroma Agro Product, (2018) 16 SCC 632 and considered the significance of disclaimers and limitations in trademarks.

The Court noted that "products of the Defendant are sold under the mark "HALO", such as, with the word "Silk" being used only to define the finish/sheen of the paint." The Court examined the label marks, containers, and packaging and found no actual similarity between the marks as the "the packaging, shape of container and the colour scheme of the products of the Plaintiff and the Defendant are completely different". The Court held that the Plaintiff failed to establish deceptive similarity and denies the injunction.

## REFERENCES:

- **Aditya Birla restrained by Delhi High Court from Infringing Trademark registered by Under Armour<sup>1</sup>**

The Delhi High Court ruled that logos and motifs used by Aditya Birla Fashion and Retail Limited on its own performance wear reading ‘Street Armor’ were infringing on the intellectual property rights of Under Armour and its ‘Under Armour’ branding. The Court also observed that the Reply to the FER would be a relevant document in litigation between the parties only where the FER cites the Defendant’s mark as a similar mark.

- **Criteria for “common to the trade” marks:<sup>2</sup>**

The Court held that for a mark to be regarded as “common to the trade” it has to fulfil 2 criteria: - First, existence of a trade in the article or class of the article in which the Plaintiff uses the mark; Second, common use of the mark or parts thereof. The Court held that since it does not have the statistical data regarding market presence of other pharmaceutical compounds, the brand names that ends with “Dex” and when one removes from the cited examples the products containing dexamethasone and dextromethorphan, the remaining examples cannot make out a case u/s 17(2). Furthermore, the Court also held that the competing marks are phonetically similar and that extra caution must be applied in the present case since the Plaintiff’s product is a prescription drug.

- **Assessing phonetic similarity and likelihood of confusion<sup>3</sup>:**

The Delhi High Court, in its judgement, held that the mark “INSAID” of Fullstack Education Private Limited bears a strong phonetic similarity to the Petitioner’s mark

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<sup>1</sup> Under Armour, Inc vs Aditya Birla Fashion & Retail Ltd 2023 SCC OnLine Del 2269

<sup>2</sup> GlaxoSmithKline Pharmaceuticals vs Horizon Bioceticals Pvt. Ltd & Anr. CS(COMM) 8/2023

<sup>3</sup> Institut Europeen D Administration Des ... vs Fullstack Education Private Limited & Anr (2023:DHC:3524)

which could lead to confusion among consumers. Consequently, the Court decided in the favour of INSEAD and cancelled the registration of the Respondent's Trademark "INSAID". The Delhi High Court's analysis of the phonetic similarity and likelihood of confusion between the marks INSEAD and INSAID highlights the importance of considering the perspective of an average consumer. The Court's decision emphasizes the importance of initial interest confusion and the potential for confusion among consumers when confronted with comparable marks.

➤ **Composite marks are ipso facto not prohibited under Section 9(1)(b)<sup>4</sup>:**

The Delhi High Court held that Section 9(1)(b) of the Act only bars marks which consist exclusively of marks or indications which designate the geographical origin of the goods and composite marks which merely contain names of a geographical area are not barred. The Court, accordingly, expressed its disagreement with the reasoning of the Assistant Examiner and set aside the refusal order. The Court also remanded the application back to the Registry to advertise the mark in the Trade Marks Journal.

➤ **Determination of Well-Known mark<sup>5</sup>:**

It was ruled that once a mark has been declared well-known by a judicial order, it does not automatically qualify for inclusion in the Trade Marks Registry's list of well-known trademarks. The Court further stated that Rule 124 of the TM Rules was implemented to execute Section 11(8) of the Trade Marks Act, 1999, since the header of the relevant TM-M form states 'Request for inclusion of a Trademark' rather than 'Request for determination of a Trademark'. The Court, accordingly, dismissed the writ petition and ruled that even after such a declaration, proprietor of such marks would be required to file a request in form TM-M along with prescribed fee as required under Rules 124 of the TM Rules for inclusion of such marks in the list of well-known trademarks.

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<sup>4</sup> Abu Dhabi Global Market vs The Registrar Of Trademarks, Delhi (2023:DHC:3476)

<sup>5</sup> Tata Sia Airlines v. Union of India (2023:DHC:3659)

- **Change in the spelling of a trademark is not relevant if it is phonetically similar to another mark<sup>6</sup>:**

The Hon'ble High Court granted interim injunction in favour of the Plaintiff. The Defendant was barred from using the mark 'MOJ' for their services even for separate models of business taking in view that the nature of services was similar and capable of breaching Plaintiff's reputation. The Court found out that the Defendant had no material evidence to substantiate whatever they were claiming and hence, all their arguments seemed to be afterthoughts and futile. The argument given by the Defendant that the Plaintiff cannot claim monopoly on all services including those that the Plaintiff has never introduced under their name in the class of 'Entertainment' as it is a very broad ambit was also rejected by the Hon'ble Court stating that the Plaintiff was very much entitled to claim monopoly based on the registration of their mark. The Hon'ble Court very clearly stated that the Plaintiff's had a strong prima facie case as all the evidences and arguments were in favour of Plaintiff.

- **No Likelihood Of Confusion Between 'Bhaiyaji Kahin' And 'Bhaiya Ji Superhit'<sup>7</sup>:**

This judgement reiterated the principle that a person is not allowed to approbate and reprobate. In light of the analysis and findings presented in the case between the Plaintiff and the Defendant over the use of the term "Bhaiyaji" in their respective television shows, the Court has reached a definitive verdict. The Court dismisses the Plaintiff's application for an interim injunction, ruling in favour of the Defendant. The Court's verdict highlights the need for a comprehensive understanding of trademark laws and practices, and the case will set a precedent for future disputes over generic terms in the entertainment industry.

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<sup>6</sup> Mauj Mobile Private Limited V. Mohalla Tech Private Limited & ors (2023 SCC ONLINE BOM 1094)

<sup>7</sup> Tv 18 Broadcast Limited vs Bennett, Coleman And Company Limited (2023/DHC/004452)

➤ **Affidavit by way of Evidence cannot be held to be a mandatory requirement for determination of well-known status of a mark<sup>8</sup>:**

It is held that in order for a determination of well-known status of a trademark, affidavit by way of evidence cannot be held to be a mandatory requirement for grant of well-known status under the 1999 Act and the 2017 Rules. However, documentary evidence would be required. In accordance to Rule 124(3) of the 2017 Rules documents need to be supported by way of an affidavit, the Registrar can always give an opportunity to the Applicant to file such an affidavit rather than rejecting an application in a completely summary manner. The non-filing of the affidavit by way of evidence shall not be fatal to the application for determining well-known status. Non-filing of the affidavit could not have resulted in the dismissal of the Application itself.

➤ **Use of Trademarks as Keywords<sup>9</sup>:**

The division bench upheld the order of the single bench to the extent that the use of the Respondent's trademark as a keyword in the Google Ads Programme would amount to infringement under the Trade Marks Act, 1999 ('TM Act') and that Google LLC was not entitled to the safe harbour provision under Section 79 of the Information Technology Act, 2000. ('IT Act'). Besides giving a verdict on the aforesaid contentions, the Division bench also made observations concerning ancillary aspects to the primary contentions and led a detailed and instructive discussion on trademark infringement in online commerce.

➤ **Validity of Trademark must be established<sup>10</sup>.**

The Plaintiff and the Defendants were manufacturing similar products of pantoprazole to treat acidity, and they were named PANTOCID and PANTOPACID respectively. The Plaintiffs filed a suit for infringement against the

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<sup>8</sup> Kamdhenu Ltd vs. The Registrar of Trade Mark C.A.(COMM.IPD-TM) 66/2021

<sup>9</sup> Google LLC vs. DRS Logistics (P) Ltd. & Ors., and Google India Private Limited v. DRS Logistics (P) Ltd. & Ors (FAO (OS) (COMM) 2/2022) (FAO OS (COMM) 22/2022)

<sup>10</sup> Sun Pharma Laboratories Ltd vs Finecure Pharmaceuticals Ltd & Ors (2023: DHC:5755)

Defendants in 2023 claiming to have come across the mark only then. PANTOPACID was alleged by the Plaintiffs to be a convenient corruption of PANTOCID, both being structurally, visually and phonetically similar and poses to cause confusion among unwary consumers. The Defendants, however, claimed to have been using the mark since 2007. It was also found that the Plaintiffs had filed notice of opposition to the Defendant's mark in 2007 contrary to their claim of knowing about the existence of PANTOPACID in 2023. The Delhi High Court ruled that proprietorship of registration in respect of a trademark does not ipso facto entitle to the proprietor the right to obtain relief against infringement of the mark.

➤ **Court restrains RPS Infrastructure Limited from using World Trade Centre marks or WTC logos<sup>11</sup>:**

The High Court of Delhi ruled in favour of the Petitioners and restrained the Respondent from using the marks "World Trade Centre Faridabad," "WTC Faridabad," and the WTC Logo, or any similar trademarks in any manner. The Court mandated the removal of all references to these marks from various platforms and directed the Respondent to ensure compliance with these directives.

➤ **Determining goodwill and reputation<sup>12</sup>:**

The Delhi High Court has denied Bolt Technology OU's plea for an interim injunction against Ujoy Technology Private Limited regarding the use of the 'Bolt' mark in electric vehicle (EV) charging stations in India. The Honourable Court noted that Bolt, an Estonian taxi aggregator, does not provide EV charging services globally, while having a small number of EV charging stations installed for its own cars. Bolt cannot thus assert that it has a transnational reputation for providing EV charging services that has extended to India.

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<sup>11</sup> Viridian Development Managers Private Limited vs Rps Infrastructure Limited O.M.P.(I) (COMM.) 335/2023

<sup>12</sup>Bolt Technology Ou vs. Ujoy Technology Private Limited & Anr. (2023/DHC/001312)

➤ **No one can claim exclusivity over a common adjective<sup>13</sup>:**

The Court dismissed the Plaintiff's application for an injunction, citing the lack of deceptive similarity between the marks and emphasizing the descriptive nature of the term "SILK" in the paint industry. The Court found no infringement and refuses the injunction sought by the Plaintiff.

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<sup>13</sup> Berger Paints India Limited vs Jsw Paints Private Limited 2024 LiveLaw (Cal) 1

## **A Holistic Compendium:**

### **Indian Trade Mark Cases Summary for 2023-2024**

#### **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.

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**A Holistic Compendium:  
Indian Trade Mark Cases Summary for 2023-2024**

**Glossary**

➤ **TRADE MARKS ACT, 1999:**

**Section 2(1)(h) of Trademarks Act, 1999**

2(1) (h) “deceptively similar”. —A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion;

**Section 2(1) (zg) of the Trade Marks Act 1999**

2(1)(zg) “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.

**Section 2(2)(b) of the Trade Marks Act 1999**

2(2) In this Act, unless the context otherwise requires, any reference—

(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;

**Section 2(2)(c)(i) of the Trade Marks Act 1999**

2(2) (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.

## **Section 9 of Trade Marks Act, 1999**

### **9. Absolute grounds for refusal of registration. — (1) The trade marks—**

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;

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;

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—

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

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

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—

the shape of goods which results from the nature of the goods themselves; or

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

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.

## **Section 11. Relative grounds for refusal of registration.**

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

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

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

(2) A trade mark which--

(a) is identical with or similar to an earlier trade mark; and

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

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

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

(b) by virtue of law of copyright.

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

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

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

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

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

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

mark as a well-known trade mark including--

(i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;

(ii) the duration, extent and geographical area of any use of that trade mark;

(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent that they reflect the use or recognition of the trade mark;

(v) the record of successful enforcement of the rights in that trade mark, in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

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

(i) the number of actual or potential consumers of the goods or services;

(ii) the number of persons involved in the channels of distribution of the goods or services;

(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.

(11) Where a trade mark has been registered in good faith disclosing the material information 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.

### **Section 12 of Trade Marks Act, 1999**

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

### **Section 17 of Trade Marks Act, 1999**

17. 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—  
contains any part—

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

which is not separately registered by the proprietor as a trade mark; or

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.

#### **Section 19, Trade Marks Act, 1999**

19. Withdrawal of acceptance. —Where, after the acceptance of an application for registration of a trade mark but before its registration, the Registrar is satisfied—

- (a) that the application has been accepted in error; or
- (b) that in the circumstances of the case the trade mark should not be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted, the Registrar may, after hearing the Applicant if he so desires, withdraw the acceptance and proceed as if the application had not been accepted.

#### **Section 28 of Trade Marks Act, 1999**

28. 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.

#### **Section 29 of Trade Marks Act, 1999**

29. Infringement of registered trademarks. —

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

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

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

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

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

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

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

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

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

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

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he— (a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for

those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

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

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

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

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

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

(b) is detrimental to its distinctive character; or

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

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

### **Section 31 of Trade Marks Act, 1999**

31. 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.



### **Section 56 of the Trade Marks Act, 1999**

56. Use of trade mark for export trade and use when form of trade connection changes. —

(1) The application in India of trade mark to goods to be exported from India or in relation to services for use outside India and any other act done in India in relation to goods to be so exported or services so rendered outside India which, if done in relation to goods to be sold or services provided or otherwise traded in within India would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods or services for any purpose for which such use is material under this Act or any other law.

(2) The use of a registered trade mark in relation to goods or services between which and the person using the mark any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the mark has been or is used in relation to goods or services between which and the said person or a predecessor in title of that person a different form of connection in the course of trade subsisted or subsists.

### **Section 124. 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 Defendants trade mark, the court trying the suit (hereinafter referred to as the court), shall, --

(i) if any proceedings for rectification of the register in relation to the plaintiff's or Defendant's trade mark are pending before the Registrar or the 1[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 1[High Court] for rectification 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 issues in the case.

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

(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.

## ➤ **TRADE MARK RULES, 2017**

### **Rule 50(4), Trade Mark Rules, 2017**

50. Hearing and decision. — (4) If the opponent is not present at the adjourned date of hearing and at time mentioned in the notice, the opposition may be dismissed for want of prosecution and the application may proceed to registration subject to section 19.

### **Rule 53(1) of Trade Mark Rules, 2017**

53. Entry in the Register. — (1) Where no notice of opposition to an application advertised or re-advertised in the Journal is filed within the period specified in sub-section (1) of section 21, or where an opposition is filed and it is dismissed, the Registrar shall, subject to the provisions of sub-section (1) of section 23 or section 19, enter the trademark on the register.

## **Rule 124 of Trademarks Rules, 2017**

### **Determination of Well-Known Trademark by Registrar. —**

1) Any person may, on an application in Form TM-M and after payment of fee as mentioned in First schedule, request the Registrar for determination of a trademark as well-known. Such request shall be accompanied by a statement of case along with all the evidence and documents relied by the Applicant in support of his claim.

(2) The Registrar shall, while determining the trademark as well-known take in to account the provisions of sub section (6) to (9) of section 11.

(3) For the purpose of determination, the Registrar may call such documents as he thinks fit.

(4) Before determining a trademark as well-known, the Registrar may invite objections from the general public to be filed within thirty days from the date of invitation of such objection.

(5) In case the trademark is determined as well-known, the same shall be published in the trademark Journal and included in the list of well-known trademarks maintained by the Registrar.

(6) The Registrar may, at any time, if it is found that a trademark has been erroneously or inadvertently included or is no longer justified to be in the list of well-known trademarks, remove the same from the list after providing due opportunity of hearing to the concerned party.

## **➤ INFORMATION TECHNOLOGY ACT , 2000**

### **Section 79 of the Information Technology Act 2000**

Exemption from liability of intermediary in certain cases. -

(1) Notwithstanding anything contained in any law for the time being in force but subject to the provisions of sub-sections (2) and (3), an intermediary shall not be

liable for any third-party information, data, or communication link made available or hosted by him.

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

(a) the function of the intermediary is limited to providing access to a communication system over which information made available by third parties is transmitted or temporarily stored or hosted; or

(b) the intermediary does not-

(i) initiate the transmission,

(ii) select the receiver of the transmission, and

(iii) select or modify the information contained in the transmission;

(c) the intermediary observes due diligence while discharging his duties under this Act and also observes such other guidelines as the Central Government may prescribe in this behalf.

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

(a) the intermediary has conspired or abetted or aided or induced, whether by threats or promise or otherwise in the commission of the unlawful act;

(b) upon receiving actual knowledge, or on being notified by the appropriate Government or its agency that any information, data or communication link residing in or connected to a computer resource, controlled by the intermediary is being used to commit the unlawful act, the intermediary fails to expeditiously remove or disable access to that material on that resource without vitiating the evidence in any manner.

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

## ➤ **ARBITRATION AND CONCILIATION ACT, 1996**

### **Section 9 of the Arbitration and Conciliation Act, 1996**

9. Interim measures, etc., by Court.

- [(1)] [Renumbered as sub-section (1) by Act No. 3 of 2016 dated 31.12.2015.] A party may, before or during arbitral proceedings or at any time after the making of the arbitral award but before it is enforced in accordance with section 36, apply to a Court:

(i) for the appointment of a guardian for a minor or a person of unsound mind for the purposes of arbitral proceedings; or

(ii) for an interim measure of protection in respect of any of the following matters, namely:

(a) the preservation, interim custody or sale of any goods which are the subject-matter of the arbitration agreement;

(b) securing the amount in dispute in the arbitration;

(c) the detention, preservation or inspection of any property or thing which is the subject-matter of the dispute in arbitration, or as to which any question may arise therein and authorising for any of the aforesaid purposes any person to enter upon any land or building in the possession of any party, or authorising any samples to be taken or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence;

(d) interim injunction or the appointment of a receiver;

(e) such other interim measure of protection as may appear to the Court to be just and convenient,

and the Court shall have the same power for making orders as it has for the purpose of, and in relation to, any proceedings before it.

(2) [ Where, before the commencement of the arbitral proceedings, a Court passes an order for any interim measure of protection under sub-section (1), the arbitral proceedings shall be commenced within a period of ninety days from the date of such order or within such further time as the Court may determine.

(3) Once the arbitral tribunal has been constituted, the Court shall not entertain an application under sub-section (1), unless the Court finds that circumstances exist which may not render the remedy provided under section 17 efficacious.] [Inserted by Act No. 3 of 2016 dated 31.12.2015.]

## ➤ **THE EVIDENCE ACT, 1872**

### **Section 3 of The Evidence Act, 1872**

#### **Interpretation-clause.**

In this Act the following words and expressions are used in the following senses, unless a contrary intention appears from the context: --

"Court."-- "Court" includes all Judges and Magistrates and all persons, except arbitrators, legally authorized to take evidence.

"Fact."-- "Fact" means and includes--

(1) anything, state of things, or relation of things, capable of being perceived by the senses;

(2) any mental condition of which any person is conscious.

Illustrations

(a) That there are certain objects arranged in a certain order in a certain place, is a fact.

(b) That a man heard or saw something, is a fact.

(c) That a man said certain words, is a fact.

(d) That a man holds a certain opinion, has a certain intention, acts in good faith or fraudulently, or uses a particular word in a particular sense, or is or was at a specified time conscious of a particular sensation, is a fact.

(e) That a man has a certain reputation, is a fact.

"Relevant?". -- One fact is said to be relevant to another when the one is connected with the other in any of the ways referred to in the provisions of this Act relating to the relevancy of facts.

"Facts in issue."--The expression facts in issue means and includes--

any fact from which, either by itself or in connection with other facts, the existence, non-existence, nature or extent of any right, liability, or disability, asserted or denied in any suit or proceeding, necessarily follows.

Explanation. -- Whenever, under the provisions of the law for the time being in force relating to Civil Procedure, any Court records an issue of fact, the fact to be asserted or denied in the answer to such issue is a fact in issue.

"Document."-- "Document" means any matter expressed or described upon any substance by means of letters, figures or marks, or by more than one of those means, intended to be used, or which may be used, for the purpose of recording that matter.

"Evidence."-- "Evidence" means and includes--

(1) all statements which the Court permits or requires to be made before it by witnesses, in relation to matters of fact under inquiry;

such statements are called oral evidence;

(2) [all documents including electronic records produced for the inspection of the

Court;] such documents are called documentary evidence.

"Proved."-- A fact is said to be proved when, after considering the matters before it, the Court; either believes it to exist, or considers its existence so probable that a prudent man ought, under the circumstances of the particular case, to act upon the supposition that it exists.

"Disproved." -- A fact is said to be disproved when, after considering the matters before it, the Court either believes that it does not exist, or considers its non-existence so probable that a prudent man ought, under the circumstances of the particular case, to act upon the supposition that it does not exist.

"Not proved." -- A fact is said not to be proved when it is neither proved nor disproved.

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