



# INDIAN INTELLECTUAL PROPERTY CASES REPORT, 2021

BananaIP Counsels

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Published: 18th July, 2022

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## ABOUT BANANAIP COUNSELS

BananaIP Counsels was founded in 2004 with the vision of providing law, technology, and business driven intellectual property (IP) services. The firm was incubated from IIM-B's entrepreneurship cell (NSRCEL) and has today emerged as a top ranked and premier IP firm in India.

The firm's commitment to excellence led to multiple accomplishments making BananaIP the best and the most sought-after firm in India. The firm has:

- Built the strongest and best IP team in India;
- Acquired an enviable client portfolio;
- Developed a reputation for world-class expertise;
- Contributed significantly to the Indian IP law, policy, and ecosystem;
- Launched highly specialized IP services; and
- Integrated modern, cutting edge technologies with proprietary techniques to augment the firm's service offerings.

BananaIP differentiates itself from other firms through its achievements and accomplishments in IP services, contributions to the law and policy framework, and business-driven IP research. The firm and its partners are recognized and ranked as leaders in the IP industry. They hold honorary positions with national and international IP committees and research centres, and their views are regularly cited by leading news organizations, journals and research publications.

To learn more about BananaIP, please visit: <https://www.bananaip.com/about-us/>.

## BACKGROUND

BananaIP publishes Intellectual Property Cases in the form of a case note and/or case brief on its blog Intellepedia. These case briefs and notes cover important decisions of Courts in India on critical questions of law and fact with respect to various species of intellectual property. At the end of the year BananaIP's team compiles all the case notes and publishes the same. This report is a compilation of notes relating to some important IP Cases decided by Indian Courts in the year 2021.

## STRUCTURE OF THE REPORT

The report has been divided into four parts. The first part includes cases related to Patents, the second part includes cases related to Trademarks, the third part has cases related to Designs, and the fourth part comprises of Copyright cases.

## PATENT CASES 2021

### 1. H. Lundbeck A/S & Anr. vs. Symed Labs Limited

In this case, the patent holder (Plaintiff) and the Defendant settled a patent suit even before notice was served and filed an application asking the Court to decree the suit as per the terms of the settlement agreement, which the Court did. The Court also refunded the Court fee paid by the Plaintiff in the case. This settlement agreement between the parties is interesting because it dealt with use of the patent under Section 107A, which provides exemptions to patent infringement for use of the invention to develop and submit information for Government approval and parallel importing. Technically, the permission of the patent holder is not required for such a use, and the agreement defines the scope of permitted use in general terms. It states that research and development use for regulatory approval is permitted, but commercialization is not.

The settlement terms cited by the Court read as follows:

“i. The Defendant acknowledges the validity of the Indian Patent No. 227963 during its subsistence.

ii. The Defendant undertakes that it will not be commercially launching any product, including but not limited to Vortioxetine and/or Vortioxetine Hydrobromide violating the suit patent IN 227963 (hereinafter, ‘IN ‘963 patent’) during its subsistence.

iii. The Defendant undertakes that it will furnish a statement to the Plaintiffs and their counsel, every 6 months, starting from the date on which the settlement is recorded and until the subsistence of the IN ‘963 patent, containing the particulars and quantities of Vortioxetine and/or Vortioxetine Hydrobromide supplied/ to be supplied to third parties whether in the domestic market or by export for R&D purposes prescribed under S. 107A of The Patents Act, 1970 (hereinafter, ‘Patents Act’).

- iv. The Defendant undertakes that at all times and until the subsistence of the IN'963 patent, the Defendant will obtain declarations/ and undertakings from all third-party customers that such purchase/sale/export of Vortioxetine and/or Vortioxetine Hydrobromide is for the purposes prescribed under S. 107A of the Patents Act and provide the same to the Plaintiffs and their counsel.
- v. The Defendant further undertakes that, going forward and till the subsistence of the Indian Patent No. 227963, it will supply Vortioxetine and/or Vortioxetine Hydrobromide to only those entities which will provide them the information on the quantities of Vortioxetine and/or Vortioxetine Hydrobromide required for regulatory purposes under the laws of their country and/or any other country where they are applying for regulatory approval, whichever is applicable. Upon obtaining the said information, the Defendant will provide the same to the Plaintiffs and their counsel.
- vi. The Defendant further undertakes that if, during the subsistence of the Indian Patent No. 227963, it is discovered that any of the parties to whom the Defendant has supplied the product Vortioxetine and/or Vortioxetine Hydrobromide, are commercializing the product, the Defendant will promptly inform the Plaintiffs and their counsel along with requisite proof of such commercialization. Further, the Defendant would also stop the supply of the product to such party immediately and provide a confirmation thereof in writing to the Plaintiffs and their counsel.
- vii. The Defendant further undertakes that all communications to be made by the Defendant to the Plaintiffs and their counsel, in writing, in compliance of the aforesaid terms, would be at their respective postal addresses or email addresses, mentioned below: XXX
- viii. The Plaintiffs reserve their right to seek revival of the instant law-suit if the Plaintiffs find the Defendant herein has made commercial use of the suit patent, IN 227963.

ix. The present suit may be decreed in view of the aforesaid terms and that the Plaintiffs may be entitled to refund of court fees under the Court Fees Act, 1870.”

*Citation: H. Lundbeck A/S & Anr. vs Symed Labs Limited, decided by the Delhi High Court on 4th June, 2021, available at: <https://indiankanoon.org/doc/115266148/>.*

## **2. Merck Sharp and Dohme Corp & Anr. vs. YMS Laboratories Private Limited**

In this case, the Plaintiff, owner of patents pertaining to Sitagliptin and its derivative salts, filed an infringement suit against the Defendant. The Plaintiff prayed for an Ad Interim Injunction during the pendency of the suit. After reviewing the facts presented, the Court granted an ex-parte ad-interim injunction as the Plaintiff had made out a *prima facie* case. The Plaintiff in the case submitted evidence to show that the Defendant was planning to launch an infringing product under the brand ‘Stallip – m,’ which enabled it to get the ex-parte injunction.

*Citation: Merck Sharp and Dohme Corp & Anr. vs. YMS Laboratories Private Limited, decided by the Delhi High Court on 31st May, 2021, available at <https://indiankanoon.org/doc/56196795/?type=print>*

## **3. FMC Corporation & Anr. vs. Natco Pharma Limited**

The patent holder (Plaintiff) in this case held two patents covering the product and process to make Chlorantraniliprole (“CTPR”), an insecticide. The patents were species patents that were claimed in Markush claims of an expired patent that covered several species along with the patents in question. When the Plaintiff filed this suit for patent infringement of its CTPR patents, the Defendant counterclaimed that the patents were invalid because they were covered in a prior patent. In response, the Plaintiff argued that though the species were covered, they did not form part of the patent disclosure.

In this particular order, the Court dealt with an application filed by the Defendant to permit launch of its products pending the suit and applications for interim injunctions. After hearing the parties, the Court concluded that such permission may not be granted taking into consideration the fact that damages from patent infringement are not always calculable. It also pointed out that non-disclosure in a prior patent may not be fatal to subsequent patents though they are covered in the earlier patent.

The Court in the case also did not see the need to permit the sale of the products in furtherance of public interest.

*Citation: FMC Corporation & Anr. vs. Natco Pharma Limited, decided by The Delhi High Court on 19th May, 2021, available at: <https://indiankanoon.org/doc/95815021/>.*

#### **4. FMC Corporation & Anr. vs. Natco Pharma Limited**

In this comprehensive judgment with respect to grant of interim injunctions involving a patent relating to “Chlorantraniliprole” (also known as CTPR), the Delhi High Court rejected the Defendant’s application on several grounds under patent law. The Court refused to grant permission to the Defendant to manufacture and sell the insecticide during the pendency of the suit. While coming to its conclusion, the Court pointed out that the Defendant failed to make a credible challenge with respect to vulnerability of patent validity.

The Court stated that the Supreme Court’s judgment in Novartis does not state that disclosure is equal to claim coverage, but simply points out that there cannot be a large gap between the two. The Court also observed that disclosure of a compound in a Markush claim does not necessarily make the specific patent susceptible to anticipation, prior claiming, obviousness or a Section 3d challenge. It then went on to cite a few principles pertaining to analyzing patentability of selection patents by equating selection patents to species patents in this case.



*Citation: FMC Corporation & Anr. vs. Natco Pharma Limited, decided by the Delhi High Court on 7th July, 2021, available at <https://indiankanoon.org/doc/83320267/>, last visited on 9th July, 2021.*

## 5. Novartis Ag & Anr. vs. Natco Pharma Limited & Anr.

This case relates to a patent covering Eltrombopag Olamine (Eltrombopag bis (monoethanolamine)) held by Novartis. The drug is used for treatment of thrombocytopenia sold under the brand name “REVOLADE”. Novartis filed a patent infringement suit against the Defendant, NATCO, which was planning to launch the same product. In response NATCO claimed patent invalidity based on prior claiming, obviousness, Section 3d, industrial applicability and Section 8 non-compliance.

After hearing the parties, the Court held that the claims of invalidity of NATCO do not hold water, and restrained NATCO from launching the product during the pendency of the suit. This case outlines a few important patent principles of prior claiming, non-obviousness, Section 3d, and genus/species patent interplay from the context of coverage and disclosure.

*Citation: Novartis Ag & Anr. vs. Natco Pharma Limited & Anr., decided by the Delhi High Court on 13th December, 2021, available at <https://indiankanoon.org/doc/104159826/>, last visited on 19th December, 2021.*

## 6. Sulphur Mills Limited vs. Dharmaj Crop Guard Limited & Anr.

In this case involving a patent with respect to an agricultural fertilizer composition, the Delhi High Court granted an interim injunction in favour of the patent holder. In a comprehensive and well-reasoned judgment, Justice Pratibha Singh rejected the Defendant’s plea of *prima facie* patent invalidity based on a pre-existing patent of the patent holder. Justice Singh came to the *prima facie* conclusion that the patented invention was novel and inventive because it used a higher percentage of sulphur and had a smaller particle size

compared to the prior patent of the patent holder. She pointed out that there is no teaching, suggestion or motivation in the prior patent to arrive at the patented invention. She referred to the standard of the person in the know put forth by the Delhi High Court in a recent case, and stated that the invention would be non-obvious despite the said standard. As the defendant failed to make out a *prima facie* case of invalidity, the Court granted an interim injunction in favour of the plaintiff.

*Citation: Sulphur Mills Limited vs. Dharmaj Crop Guard Limited & Anr., decided by the Delhi High Court on 2nd August, 2021, available at <https://indiankanoon.org/doc/3021893/>, last visited on 4th August, 2021.*

## 7. Novartis Ag & Ors. vs. Natco Pharma Limited

This case relates to a patent pertaining to a pharmaceutical composition comprising combination of Valsartan and Sacubitril or pharmaceutically acceptable salts held by Novartis. Novartis filed an infringement suit against NATCO and others and sought an interim injunction during the pendency of the suit. NATCO argued in the case that its supramolecular complex, which includes Valsartan, Sacubitril, solution ion and water molecules is not covered within Novartis' patent. It also argued that a later application filed by Novartis with respect to the supramolecular complex excludes it from the scope of the patent being asserted against NATCO. The Court rejected both the arguments and stated that NATCO's complex is covered within the scope of the Novartis' patent claim. While doing so, the Court also rejected the opinion of the scientific advisor which observed that NATCO's supramolecular complex is not covered in the claim. It therefore granted an interim injunction in favour of Novartis.

*Citation: Novartis Ag & Ors. vs. Natco Pharma Limited, decided by the Delhi High Court on 28th October, 2021, available at: <https://indiankanoon.org/doc/15824335/>, last visited on 2nd November, 2021.*

## TRADEMARK CASES 2021

### 1. El Baik Food Systems Co. S.A. vs. Arsalan Wahid Gilkar & Anr.

In a recent decision, the Delhi High Court granted an ex-parte injunction against use of the trademark 'Albaik' for restaurants and related services. The Plaintiff in the case was the Albaik Group based out of Saudi Arabia, which started its business in 1986, has several trademark registrations over the mark, Albaik, in word and logo forms. The Plaintiff briefly operated under the mark, Albaik, in India between 2017 and 2020, and had to shut down its operations due to the COVID lock downs.

The Defendants in the case were offering franchises bearing the Plaintiff's mark without permission, by charging a franchise fee of five 5% of gross revenue or a minimum of Rs. 75,000, whichever is higher. On further investigation, it was revealed that the Defendants also operated a fake social media account on Facebook, in the name of the Plaintiff Company. Convinced with the *prima facie* case of the Plaintiff, the Court granted the ex-parte injunction in favor of the Plaintiff.

*Citation: El Baik Food Systems Co. S.A. vs. Arsalan Wahid Gilkar & Anr., decided by the Delhi High Court on 4th June, 2021, available at <https://indiankanoon.org/doc/99016397/>.*

### 2. United Spirits Limited vs. Som Fragrances Private Limited & Ors.

In this case, United Spirits, the Plaintiff filed an application for *ad-interim injunction* with respect to use of its well-known trademark, SIGNATURE, by the Defendants for Gutka. The parties had earlier entered into a settlement agreement pertaining to use of the said mark for tobacco and related products by the Defendants, and United Spirits argued that the Defendants had breached the settlement agreement and related undertaking, which made the settlement invalid. The Court disagreed and stated that actions were taken by parties with respect to the trademark applications filed after the settlement, which made the agreement valid. Acknowledging that well-known marks get broader protection, the Court asked the Defendants to use the trademark,

Signature, in line with the settlement agreement. It did not injunct the Defendants from using the mark for Gutka.

*Citation: United Spirits Limited vs. Som Fragrances Private Limited & Ors., decided by the Delhi High Court on 28th April, 2021, available at <https://indiankanoon.org/doc/155080630/>.*

### **3. Kaira District Cooperative Milk Producers Union Ltd and Anr. vs. Maa Tara Trading Co. and Ors.**

In this case, the Calcutta High Court passed an interim order against the Defendants, restraining them from using the trademark 'Amul' in connection with their products. The case was instituted by Kaira District Cooperative Milk Producers Union Ltd, who are the proprietors of the trademark 'Amul'. The Plaintiffs alleged that the Defendants were infringing the Plaintiff's registered 'Amul' trademark by using the mark with a deceptively similar font on the labels of candles marketed and sold by them at cake shops and confectionaries. The counsel for the Plaintiff also pointed out that the 'Amul' trademark was recognised as a well-known mark by the Trademark Registry, and there exists a high likelihood that consumers would associate such infringing products with the Plaintiff. The Calcutta High Court duly passed an order of temporary injunction restraining the Defendants from using the 'Amul' mark until the disposal of the suit.

*Citation: Kaira District Cooperative Milk Producers Union Ltd and Anr. vs. Maa Tara Trading Co. and Ors., decided by the Calcutta High Court on 22nd March, 2021, available at <https://indiankanoon.org/doc/148365026/>*

### **4. Franco Indian Pharmaceuticals Pvt Ltd vs. Micro Labs Ltd and Anr.**

In this case, the Bombay High Court granted an ex-parte injunction with respect to the word and label marks, "Dexorange", and trade dress of the bottle. The trademarks were being used for folic acid supplements for more than 50 years, and the Plaintiff held several registrations with respect to its trademarks.

The Defendants in this case were selling products under the name 'Ferri Orange,' though a permanent injunction had been granted earlier against one of them. As the Plaintiff had established a *prima facie* case of the trademark and the trade dress being copied, and as the Defendants behaved dishonestly, the Court granted an ex-parte injunction against them.

*Citation: Franco Indian Pharmaceuticals Pvt. Ltd. vs. Micro Labs Limited & Anr., decided by the Bombay High Court on 14th June, 2021, available at: <https://indiankanoon.org/doc/45913753/>*

#### **5. Sulphur Mills Limited vs. Virendra Kumar Saini**

The Bombay High Court in this case granted an interim injunction against use of the mark, Fortis Royal, by the Defendant. The Plaintiff in the case held a trademark over "Fertis" under which it sold sulphur products. On comparing the packaging, the Court came to the conclusion that the Defendant had copied the Plaintiff's packaging and trademark representation. The Court pointed out that change of one vowel would not make the Defendant's use of the mark non-infringing. The Court enjoined the Defendants from using the mark Fortis and/or any other mark similar to Fertis until the disposal of the suit.

*Citation: Sulphur Mills Limited vs. Virendra Kumar Saini, decided by the Bombay High Court on 14th June, 2021, available at <https://indiankanoon.org/doc/14684884/>.*

#### **6. M/s Sri Tulasi Industries vs. M/s Sri Sapthagiri Industries and Anr.**

In this case, the Plaintiff/Appellant challenged the order of the District Court vacating the interim injunction with respect to its trademark, Tasty Gold, before the Telangana High Court. The Defendant/Respondent in the case was using the trademark, Tasty Drops and different suffix variations.

Both parties were using the trademarks for edible oils. After reviewing the facts, the Court reinstated the interim injunction as the prefixes were similar, products were similar, and as the Plaintiff's products had acquired goodwill in the market. The Court reasoned that the Defendant should not be permitted to ride on the Plaintiff's goodwill during the pendency of the suit.

*Citation: M/s Sri Tulasi Industries vs. M/s Sri Sapthagiri Industries and another, decided by the Telangana High Court on 9th June, 2021, available at <https://indiankanoon.org/doc/158670689/>.*

### **7. Sony Corporation vs. K. Selvamurthy**

In this case, Sony Corporation filed a trademark infringement suit claiming dilution of its well-known SONY trademark against a sole proprietor running a tours and travels business under the name, Sony Tours and Travels. After analyzing the facts before it, the District Court concluded that the Defendant did not take unfair advantage of, or cause detriment to the distinctive character or repute of the Plaintiff's SONY mark. The Court came to this conclusion as Sony Corporation's business was limited to electronics and media, which could be differentiated from the tours and travels business of the Defendant. The Court also noted that the use of the word "Sony" by the Defendant did not cause any confusion among the consumers. It also took note of the inordinate delay of the plaintiff in approaching the Court, and granted the Defendant Rs. 25, 000/- as costs.

*Citation: Sony Corporation vs. K. Selvamurthy, decided by the Bangalore District Court on 18th June, 2021, available at: <https://indiankanoon.org/doc/22176292/>*

### **8. M/s. Dabur India Ltd. vs. Bison Laboratories Pvt. Ltd. and Anr.**

In this case, the Madras High Court granted a permanent injunction against the use of the mark, ODOSOL, by the Defendants for cleaning preparations. The Plaintiff in the case had a registered trademark over ODOPIC.

After citing a test laid down in a Supreme Court judgment, [Parle Products Private Limited Vs. J.P. & Co., Mysore](#), the Court concluded that the mark, ODOSOL, was confusingly and deceptively similar to the mark, ODOPIC. The Court took note of the fact that an injunction was operating against the Defendants for about twenty years while granting the permanent injunction.

*Citation: M/s. Dabur India Limited vs. Bison Laboratories Private Limited and Anr., decided by the Madras High Court on 22nd June, 2021, available at: <https://indiankanoon.org/doc/171318470/>*

### **9. V3 Events and Entertainments Pvt. Ltd. vs. V3 Entertainments/V3 Artists and Ors.**

In this case, the Plaintiff sued the Defendants for using its trademark, V3, on social media platforms and to carry out their business. After reviewing the facts, the District Court came to the conclusion that the trademark usage by the Defendants was deceptive, and that such usage was likely to cause confusion among consumers seeking wedding and event management services. The Court therefore restrained the Defendants from using the V3 trademark on websites, Facebook, Instagram, Google Plus, and other social media platforms in addition to a general restraint from using the Plaintiff's mark.

*Citation: V3 Events And Entertainments Private Limited vs. V3 Entertainments/V3 Artists and Ors., decided by SH Umed Singh Grewal District Court in Delhi on 1st July, 2021, available at: <https://indiankanoon.org/doc/7857343/>*

### **10. Sun Pharmaceutical Industries Ltd. vs. Cipla Limited**

In this case, Sun Pharma filed a suit for a permanent injunction before the Madras High Court against Cipla for infringement of its copyright and trademark. The Court granted an interim injunction in favour of Sun Pharma. Thereafter, Cipla filed three applications with a plea to vacate the interim relief granted on grounds of urgency.



The plea was based on the fact that the drugs were of a huge amount, carried an expiry date of 1 year, and were in demand because of the ongoing pandemic as they helped in relieving the Covid-19 symptoms. The Court held that Sun Pharma made out a *prima facie* case for continuance of the interim order as the balance of convenience continued to be in their favour. The Court pointed out that it could not allow a party to violate another person's IP rights, notwithstanding the fact that the country was facing an unprecedented medical emergency. The Court upheld the interim order and held that it would continue to remain in force subject to the final decision of the suit.

*Citation: Sun Pharmaceutical Industries Ltd. vs. Cipla Limited, decided by the Madras High Court in May, 2021, available at: <https://indiankanoon.org/doc/95848712/>*

#### **11. V Guard Industries Ltd vs. Sukan Raj Jain & Anr.**

In this case relating to allegations of "V Guard" trademark infringement, the Defendants argued against the territorial jurisdiction of the Delhi High Court as the Plaintiff and Defendants did not have their principal businesses in Delhi. The allegedly infringing products were being offered for sale, advertised, and sold through online portals. After reviewing the facts, the Court came to the conclusion that it had territorial jurisdiction because the Plaintiff has business in Delhi, and because the product bearing the mark was being advertised and sold in Delhi through online means.

The Court cited the following judgments pertaining to jurisdiction of copyright and trademark suits while arriving at its conclusion:

"34. The aforesaid contention raised on behalf of the Defendant is facile in view of the settled position of law. The Supreme Court in IPRS (SC) has settled the debate on choice of forums available to a Plaintiff to file an action against infringement and passing off. It has been declared that by virtue of Section 134 of the Trade Marks Act, additional jurisdictions have been made available to the Plaintiff, over and above the jurisdictions available under Section 20 CPC.



The Supreme Court, after considering its earlier decisions including *Patel Roadways Limited, Bombay (Supra)* and *Dhodha House (Supra)*, held as follows:

“18. On a due and anxious consideration of the provisions contained in Section 20 of the Code of Civil Procedure, Section 62 of the Copyright Act and Section 134 of the Trade Marks Act, and the object with which the latter provisions have been enacted, it is clear that if a cause of action has arisen wholly or in part, where the Plaintiff is residing or having its principal office/carries on business or personally works for gain, the suit can be filed at such place/s. Plaintiff (s) can also institute a suit at a place where he is residing, carrying on business or personally works for gain de hors the fact that the cause of action has not arisen at a place where he/they are residing or any one of them is residing, carries on business or personally works for gain. However, this right to institute suit at such a place has to be read subject to certain restrictions, such as in case Plaintiff is residing or carrying on business at a particular place/having its head office and at such place cause of action has also arisen wholly or in part, Plaintiff cannot ignore such a place under the guise that he is carrying on business at other far flung places also. The very intendment of the insertion of provision in the Copyright Act and Trade Marks Act is the convenience of the Plaintiff. The rule of convenience of the parties has been given a statutory expression in Section 20 of the Code of Civil Procedure as well. The interpretation of provisions has to be such which prevents the mischief of causing inconvenience to parties.”

“19. The intendment of the aforesaid provisions inserted in the Copyright Act and the Trade Marks Act is to provide a forum to the Plaintiff where he is residing, carrying on business or personally works for gain. The object is to ensure that the Plaintiff is not deterred from instituting infringement proceedings “because the court in which proceedings are to be instituted is at a considerable distance from the place of their ordinary residence...”

35. The decision in IPRS (SC) was later followed by a Division Bench of this Court in Ultra Home Construction Pvt. Ltd. vs. Purushottam Kumar Chaubey & Ors. reported as 2016 SCC OnLine Del 376, wherein it was held as under:

“14. It is evident from the above observations that the interpretation given to the expression “carries on business” in the context of a Defendant under Section 20 of the Code has also been employed in the context of a Plaintiff under the said sections 134(2) and 62(2). Thus, in addition to the places where suits could be filed under section 20 of the Code, the Plaintiff can also institute a suit under the Trade Marks Act, 1999 and the Copyright Act, 1957, as the case may be, by taking advantage of the provisions of Section 134(2) or Section 62(2), respectively. Both the latter provisions are in pari materia. Under these provisions four situations can be contemplated in the context of the Plaintiff being a corporation (which includes a company). First of all, is the case where the Plaintiff has a sole office. In such a case, even if the cause of action has arisen at a different place, the Plaintiff can institute a suit at the place of the sole office. Next is the case where the Plaintiff has a principal office at one place and a subordinate or branch office at another place and the cause of action has arisen at the place of the principal office. In such a case, the Plaintiff may sue at the place of the principal office but cannot sue at the place of the subordinate office. The third case is where the Plaintiff has a principal office at one place and the cause of action has arisen at the place where its subordinate office is located. In this eventuality, the Plaintiff would be deemed to carry on business at the place of his subordinate office and not at the place of the principal office. Thus, the Plaintiff could sue at the place of the subordinate office and cannot sue (under the scheme of the provisions of Section 134(2) and 62(2)) at the place of the principal office. The fourth case is where the cause of action neither arises at the place of the principal office nor at the place of the subordinate office but at some other place. In this case, the Plaintiff would be deemed to carry on business at the place of its principal office and not at the place of the subordinate office.

And, consequently, it could institute a suit at the place of its principal office but not at the place of its subordinate office. All these four cases are set out in the table below for greater clarity:

S.No.	Place of Plaintiff's Principal Office (Sole Office in s.no.1)	Place of Plaintiff's Subordinate /Branch Office	Place where cause of action arose	Place where Plaintiff can additionally sue under section 134(2) and section 62(2)
1	A	...	C	A
2	A	B	A	A
3	A	B	B	B
4	A	B	C	A

36. If under Section 20 CPC, jurisdiction of the Court is attracted by virtue of location of the Defendant's place of business or from where the Defendant is carrying on its business or working for gain, under Section 134 of the Trade Marks Act, it is the Plaintiff's office location or from where he is carrying on business, is a material factor.

However, in IPRS (SC) (Supra), the occurrence of cause of action has been read into Section 134 of the Trade Marks Act, as a determining factor, even though not spelt out in the language, on the lines of Section 20 CPC. Therefore, if some part of cause of action has arisen at a place where the plaintiff has its branch/subordinate office, Courts at that place will have jurisdiction to entertain a suit against infringement and passing off. In other words, the occurrence of cause of action or any part thereof, at a place, is held to be a determining factor, both under Section 20 CPC, and Section 134 of the Trade Marks Act, to attract jurisdiction of the court at such place. "

*Citation: V Guard Industries Ltd. vs. Sukan Raj Jain & Anr., decided by the Delhi High Court on 5th July, 2021, available at <https://indiankanoon.org/doc/166471642/>*

## **12. Frankfinn Aviation Services Private Limited vs. Fly High Institute & Ors.**

In this case the trademark involved was “Fly High”, the Delhi High Court granted an ex-parte injunction in favor of the Plaintiff, and restrained the Defendant from using the mark on its websites, social media platforms or otherwise. The Court in a short observation pointed out that there was a *prima facie* case because the Plaintiff had been using the trademark from 2007 while the Defendant had been using it only from 2018. It pointed out that irreparable harm would be caused if interim relief was not granted, and therefore proceeded with its order.

*Citation: Frankfinn Aviation Services Pvt. Ltd. vs. Fly High Institute & Ors., decided by the Delhi High Court on 5th July, 2021, available at <https://indiankanoon.org/doc/32074880/>*

## **13. Sun Pharmaceutical Industries Limited vs. Cipla**

### **Limited FACTS OF THE CASE**

In this case, Cipla Limited (“Cipla”), the Respondent, filed a suit for permanent injunction before the Madras High Court. The suit was filed against Sun Pharmaceuticals Industries Limited (“Sun Pharma”), the Applicant, alleging that it infringed Cipla's copyright and registered trademarks as follows:

1. Sun Pharma imitated and substantially reproduced the artistic packaging, trade dress and labels of Cipla ‘BUDECORT RESPULES’ and ‘DUOLIN RESPULES’ which amounted to infringement of its copyright in artistic works. These were Budeonide Nebuliser Suspension BP, Levosalbutamol and Ipratropium Bromide Respirator Solution which were used in treating patients with respiratory ailments.

2. Sun Pharma used the mark 'RESPULE' by calling its medicine "Budeflex Respules" and "DuoZ Respules" which amounted to infringement of Cipla's registered trademark.
3. Sun Pharma used packaging identical to Cipla's packaging for 'Budesonide Respules' and 'DUOLIN Levosalbutamol Respules' which amounted to passing off of its goods. The aforementioned acts of Sun Pharma gave it an unfair advantage in the market and proved detrimental to the well-known trademark and copyright of Cipla.

In this suit for permanent injunction against Sun Pharma's infringing acts, Cipla filed three applications before the Court and prayed for the grant of an interim injunction against Sun Pharma. The Court perused the averments made in the affidavit as well as the colour label of both the parties and opined that an identical colour label was adopted by Sun Pharma imitating that of Cipla. Hence, the Court passed an order for an interim injunction on 30.04.2021, and restrained Sun Pharma from marketing its product with an identical colour, design, and wave design till 02.06.2021.

Aggrieved by the order, Sun Pharma on 03.04.2021, filed three counter applications to vacate this interim order. The plea for vacation was based on the fact that existing stock was of a huge amount and carried an expiry date of 1 year. Sun Pharma brought to the Court's notice that its drug was in demand because of the ongoing pandemic as they helped in relieving the Covid-19 symptoms, and it was directed to report to the Union Health Ministry about the stock and position. Sun Pharma also prayed the Court to allow it to sell its existing stock with a thoroughly different packaging in the public interest, which Cipla alleged was an attempt to infringe its intellectual property rights.

**ISSUE**

The issue which came before this Court was as to whether or not the ad-interim order granted in favour of Cipla should be vacated on the ground of urgency as pleaded by Sun Pharma.

**RULING**

Application filed under Order XIV Rule 8 of Original Side Rules read with Order 39 Rule 4 & Section 151 of the Civil Procedure Code, 1908.

**HOLDING**

The Court held that the interim injunction shall continue to remain in force subject to the final decision of the suit and dismissed the said applications filed by Sun Pharma for vacation of the interim order.

**ANALYSIS**

The question before the Court of setting aside the interim order so granted was mooted by Sun Pharma on the ground of urgency by Cipla on the ground of unfair dissolution of its rights. The Court analyzed Sun Pharma's plea for urgency and said that it could not allow violation of the Cipla's rights.

Though the country was facing a pandemic along with a huge demand for the drugs manufactured by both the parties, Sun Pharma was not permitted to infringe Cipla's rights merely because it was a viable opportunity to make heavy profits. The Court then pointed out that the label and the trade dress had been copied by Sun Pharma to take advantage of the unprecedented demand in the market for those medicines and that it was intended to ride on the goodwill and reputation of Cipla. The Court noted that although it was open for Sun Pharma to recall and repack its products, no such concession could be granted in the name of the ongoing pandemic.

The Court observed that Cipla had made out a *prima facie* case for continuance of the interim order as the balance of convenience continued to be in favour of

Cipla. The learned judge opined that no harm would be caused to Sun Pharma if the interim order was allowed till the disposal, but on the other hand if they were allowed to release their products in the market, it would amount to incalculable damage to Cipla's proprietary rights. The Court, in the end, recommended that the parties take advantage of the Commercial Disputes Act, 2015 for early dispute resolution. Additionally, under the aforementioned circumstances, the court dismissed the applications filed by Sun Pharma and reiterated its previous order.

### CONCLUSION

The Court remarked that they could not be a mute spectator to a party violating another person's intellectual property rights, notwithstanding the angle of public interest due to the demand for the drugs manufactured by both. Hence, upheld the interim injunction as the balance of convenience continued to be in favour of Cipla.

### RELEVANT EXCERPTS

"12..... if the Applicant/Defendant does alter the package/label as stated in the of the affidavit filed in support of these applications in Application Nos.1982 and 1983 of 2021, it is without prejudice to the Respondent/Plaintiff's right to question the same. In my view even the proposed changes retains the words "Respule" as trademarks in the label which are prima facie deceptively similar to the trademark "Budecort Respules" and "Duolin Respules" and "Respules" of the Respondent/Plaintiff. Though not argued, the conduct of the Applicant/Defendant borders on the violation of the provisions of Drugs and Cosmetics Act, 1940 and the Rules made thereunder. Prima facie the attempt of the Applicant/Defendant is to trade on "spurious drugs" within the meaning of Section 17B

(e) of the Act .....

13. The Respondent/Plaintiff has made a prima facie case for the continuance of the Interim Order. In the light of the above discussion, the balance of convenience to continue the interim order granted by the court on 30.4.2021

still continues in favor of the Respondent/Plaintiff notwithstanding the fact that an attempt has been made by the dependent to nix the public interest due to the medical emergency in the country and world over with the rights of the Respondent/Plaintiff.

14. In my view, no prejudice or harm would be caused to the Applicant/Defendant if the interim order is allowed to continue until the above suit's disposal. On the other hand, if the Applicant/Defendant is allowed to release the products in the market, it will result in incalculable damage to the proprietary rights of the Respondent/Plaintiff and by permitting the Applicant/Defendant to sell the good it will be allowing dilution of the proprietary rights of the Respondent/Plaintiff."

*Citation: Sun Pharmaceutical Industries Limited vs. Cipla Limited, decided by the Madras High Court in May, 2021, available at <https://indiankanoon.org/doc/95848712/>*

#### **14. Cross Fit LLC vs. Mr. Renjith Kunnumal & Anr.**

The Plaintiff herein used 'CrossFit', a registered word and device mark, on a global basis for fitness & training services as well as its domain name [www.crossfit.com](http://www.crossfit.com). The Defendants were found using the name "SFC CROSSFIT" in their advertisements, website and social media handles, for identical gym and fitness services. Aggrieved by these actions, the Plaintiff filed a suit and an application seeking interim injunction before the High Court of Delhi. The averments in the plaint, remained uncontested by the Defendants, and hence were deemed to be true based on the principle of non-traverse. The Court pointed out that the word "CrossFit" was entitled to an enhanced degree of protection as it had no known etymological significance. The Court concluded that a *prima facie* case and balance of convenience for grant of interim injunction existed in the Plaintiff's favour. The Defendants were enjoined from using the mark "CrossFit" or any other identical or deceptively similar mark offline or online. They were also directed to take down their website and domain name [www.sfccrossfit.com](http://www.sfccrossfit.com) as well as all listings, posts, pictures etc. from all sites on the internet including their social media webpages.



*Citation: CrossFit LLC vs. Mr Renjith Kunnumal & Anr., decided by the High Court of Delhi on 8th July, 2021, available at <https://indiankanoon.org/doc/86262643/>*

### **15. ITC Limited vs. Maurya Hotel (Madra) Pvt Ltd**

In this case, the Madras High Court allowed the Plaintiff to add relief for trademark infringement to a passing off suit based on subsequent registration of the trademark by the Plaintiff. The Court pointed out that adding relief is permitted, and helps in avoiding multiplicity of suits. It also stated that the outcome might have been different if the application was for conversion of the plaint from the relief of passing off to infringement.

*Citation : ITC Limited vs. Maurya Hotel (Madra) Pvt Ltd, decided by the Madras High Court on 22nd July, 2021, available at <https://indiankanoon.org/doc/36231681/>*

### **16. M/s Praba's V Care Health Clinic Private Limited vs. M/s I-Care Aesthetic Clinic**

This case involved a dispute between an employer and its ex-employee. The Plaintiff in the case registered the trademark 'V Care,' which was given registration with the limitation that no protection would extend to the term 'Care.' The Defendant started a competing business in related goods/services pertaining to personal and health care with the mark 'I Care.' The Plaintiff sued for infringement, and the Court dismissed the case summarily.

While arriving at its decision, the Court stated that the marks are dissimilar, and that there is no likelihood of confusion between the two marks. It pointed out that the word 'care' is publici juris, and that use of the word in a trademark would not give rise to liability.

*Citation: M/S Praba's V Care Health Clinic Private Limited vs. M/S I-Care Aesthetic Clinic, decided by the Madras High Court on 29th July, 2021, available at <https://indiankanoon.org/doc/27457134/>*

**17. Reliance Industries Ltd. & Anr. vs. Ashok Kumar**

In this case, Reliance Industries Limited, the Plaintiff, found a hardware fittings and bathroom accessories retailer using its well-known mark 'JIO' and hence filed a trademark & copyright infringement suit before the Bombay High Court. The Defendant on 11th June, 2021 had filed two applications for registration of the mark JIO and pirated artwork which were advertised, claiming use since 16th December, 2016. The Court noted that the Defendant not only copied Plaintiffs' mark, logo and artwork but also added an image of a leaping jaguar which violated Jaguar Land Rover's intellectual property as well. The Plaintiffs filed an interim application praying for injunction against Defendant's use of its copyright and trademark until the final disposal of the suit. The Court was of the opinion that an overwhelming *prima facie* case and balance of convenience lay in the Plaintiffs' favour, and irretrievable prejudice would be caused if the reliefs sought were denied. Hence, the Court granted a temporary injunction and gave the Defendant the liberty to apply for a variation, modification or recall of the order after 7 days' notice to the Plaintiffs' Advocates. Finally, the Court listed the matter for hearing on further ad-interim relief on 30th September, 2021.

*Citation: Reliance Industries Limited and Anr. vs. Ashok Kumar, decided by the Bombay High Court on 23rd August, 2021, available at <https://indiankanoon.org/doc/58666138/>*

**18. Sony Pictures Network India Pvt. Ltd. vs. The State of Maharashtra & Anr.**

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

Aggrieved by the FIR, the accused filed two criminal writ petitions seeking a stay on investigations. The Bombay High Court heard both the matters jointly, in which the petitioners sought the stay on three grounds. Firstly, as per

Section 115(4) of the Trade Marks Act, 1999, investigation could not be conducted by an officer below the rank of Deputy Superintendent of Police, but the said FIR was being investigated by a police inspector. Secondly, that the alleged offence under Section 500 of IPC was non-cognizable and could not be investigated by police on the basis of an FIR. Lastly, that the web series did not come within scope of Trade Marks Act, 1999 based on [Prateek Chandragupt Goyal vs. The State of Maharashtra & Anr.](#), wherein the same court had held that the mere use of a trademark in an article does not amount to false application. Convinced by all the three grounds the Court stayed the investigations until the next date of hearing i.e., 17th September, 2019.

*Citation: Sony Pictures Network India Pvt. Ltd. vs. The State of Maharashtra & Anr., decided by the Bombay High Court on 23rd August, 2021, available at <https://indiankanoon.org/doc/75179673/>*

### **19. Meher Distilleries Pvt. Ltd. vs. SG Worldwide Inc. and Radico Khaitan Ltd.**

An appeal to Commercial court was filed by Meher Distilleries, which was the registered proprietor of the trademark THE ASWA for class – 33 including alcoholic beverages. Respondent No. 2, Radico Khaitan, launched a product in the same class, a single malt whiskey, using the mark ASĀVA. The appellant filed a commercial suit for trademark infringement and an interim application to restrain the Respondents from using ASĀVA as a trademark. The learned Single Judge by the impugned order dismissed the interim application. Challenging the judgment and praying for a restraint order,

Appellant filed this commercial appeal under Section 13 of the Commercial Courts Act, 2015. The Appellate Court set aside the finding of the learned Single Judge that RAMPUR ASĀVA and not ASĀVA alone was the trademark of Defendant No. 2. The Court also set aside the finding that there was no visual, phonetic or structural similarity between THE ASWA and ASĀVA trademarks, and found that the similarity/identity would have to be decided as per the settled principle that in respect of expensive consumable products, the use of house mark with the product mark will obviate the likelihood of confusion. Thus, the Appeal was allowed and the impugned order was quashed and set aside.

*Citation: Meher Distilleries Pvt.Ltd vs. Sg Worldwide Inc. and Radico Khaitan Ltd., decided by the Bombay High Court on 23rd August, 2021, available at <https://indiankanoon.org/doc/149887609/>*

#### **20. Victoria Foods Private Limited vs. Rajdhani Masala Co. & Anr.**

In this case, the Plaintiff claimed to have originally conceived and adopted the trademark “Rajdhani” for food products, condiments, confectionary, etc. Through social media it found that the Defendants, engaged in the business of Indian Spices under the name of “Rajdhani Masale Co.” and “New Rajdhani Masala Co.” were using its trademark and labels on their products. Aggrieved by the same, the Plaintiff filed a suit as well as an interim application seeking injunction against Defendants’ use of the impugned trademarks. On the other hand, the Defendants denied the Plaintiff’s claims, and counterclaimed that they were the prior user. The Delhi High Court heard the plea for ad-interim relief on the grounds of ownership, prior use, deceptive similarity and delay in approaching the Court. The Court observed that the Plaintiff was the prior user and registered owner of the trademark and was ‘first in the market’ to use it. Moreover, while comparing the marks, the Court noted that the Defendants’ trademarks were deceptively similar to Plaintiff’s trademark, use of which would further infringe Plaintiff’s rights.

Further the Court pointed that delay *per se* was not sufficient to disentitle the Plaintiff to interim relief. The Court concluded that the Plaintiff was successful in establishing a *prima facie* case in its favour and hence granted the interim order restraining the Defendants from using the Plaintiff's trademark.

*Citation: Victoria Foods Private Limited vs. Rajdhani Masala Co. & Anr., decided by The Delhi High Court on 1st September, 2021, available at [http://164.100.69.66/jupload/dhc/JAN/judgement/01-09-2021/JAN01092021SC1082021\\_105848.pdf](http://164.100.69.66/jupload/dhc/JAN/judgement/01-09-2021/JAN01092021SC1082021_105848.pdf)*

### **21. Tata Sons Private Limited vs. Sunil Keshavji Tataria & Anr.**

The Plaintiff, Tata Sons Pvt. Ltd., sought a permanent injunction restraining the defendant Sunil Keshavji Tataria from infringement of Plaintiff's registered trademark, passing off, dilution and tarnishment of trademarks, and for damages and rendition of accounts. The Defendant was engaged in the manufacture and sale of adult diapers and underpads sold online on the website [www.tatariahigiene.com](http://www.tatariahigiene.com) which infringed the Plaintiff's registered trademark "Tata". The subject matter of the suit was amicably resolved in terms of Settlement Agreement dated 03.08.2021 passed by the Delhi High Court Mediation and Conciliation Centre. Since the dispute between the parties was resolved prior to commencing of pleadings, the Court found that the Plaintiff was entitled to refund of entire court fees.

*Citation: Tata Sons Private Limited vs. Sunil Keshavji Tataria & Anr., decided by the Delhi High Court on 31st August, 2021 available at <https://indiankanoon.org/doc/53529635/>*

## 22. Prince Pipes and Fittings Limited vs. Prince Platinum Pipes and Fittings & Ors.

The Plaintiff, Prince Pipes was using the mark “PRINCE” in conjunction with a crown device as a registered trade mark in relation to its PVC pipe products since 1996. The Plaintiff had obtained a series of registrations from 2014 onwards of the “PRINCE” mark and logo in relation to “Piping Systems”. The PRINCE mark was prominently displayed on every unit or segment of the supplied products. The Defendant, Prince Platinum Pipes, was using “PRINCE PLATINUM” on similar goods which it was also selling through its website “[www.princeplatinumplastindia.com](http://www.princeplatinumplastindia.com)”. Deceived by the advertisement of the Defendants, one of the dealers of the Plaintiff sent a communication on 4<sup>th</sup> January, asking for their platinum products. The Plaintiff claimed that such communication was strong *prima facie* evidence showing that actual deception and confusion had in fact already taken place and anyone would be lured into believing that the PRINCE platinum product was in fact from the house of the Plaintiff. The Court gave interim orders and restrained the Defendants from using the impugned trademark “PRINCE PLATINUM”, the impugned domain name [www.princeplatinumplastindia.com](http://www.princeplatinumplastindia.com) and/or impugned business name “Prince Platinum Pipe & Fittings” and/or any other impugned mark/domain name/business name/trading style containing the word PRINCE and/or any other trade mark, domain name or business name/trading style identical with and/or deceptively similar to the Plaintiff’s well-known trade mark “PRINCE” in respect of Plaintiff’s business. The Court also appointed a court receiver as the receiver of Defendants’ goods, stamps, printing materials, labels, brochures, pamphlets, flyers, advertising material, papers, stationery, printed matter, things and such material and documents of the Defendants bearing or containing the impugned trade mark “PRINCE PLATINUM”.

*Citation: Prince Pipes & Fittings Limited vs Prince Platinum Pipes & Fittings & Ors, decided by the Bombay High Court on 10th March, 2021 available at <https://indiankanoon.org/doc/64355958/>*

### **23. Prateek Chandragupt Goyal vs. State of Maharashtra and Anr.**

In this case, the Petitioner, Prateek Goyal, a journalist working with Newslandry filed a writ petition to quash the First Information Report registered against him at Vishrambaug Police Station, Pune for offences under Section 103 of the Trade Marks Act, 1999. The FIR was registered against the Petitioner by Chief Administrative Officer of Sakal Group for writing highly defamatory articles against the Sakal Media Group and for using the official logos / trademark of the Sakal Media Group and Sakal Times on these articles which clearly amounted to falsely applying the said trademark, thereby resulting in an offence under Section 103 of the aforesaid Act. The Court was of the view that the articles authored by the Petitioner and published in the news portal Newslandry neither qualify as goods nor as services as defined under Section 2(j) and 2(z) of the aforesaid Act. The Court found that, although the mark shown in the two articles was indeed the 'trademark' of Sakal Media Group under Section 2(z)(b) of the aforesaid Act, the said mark being shown in the articles could not be said to be in the context of either 'goods' or 'services'. It would have been a completely different matter if the Petitioner had used the registered trademark of Sakal Media Group to portray as if the news portal itself was that of Sakal Media Group. Thus, the Court directed the Vishrambaug Police Station to quash the FIR.

*Citation: Prateek Chandragupt Goyal vs. State of Maharashtra and Anr., decided by Bombay High Court on 20th April, 2021, available at <https://indiankanoon.org/doc/96389521/>*



#### **24. Kaveri Hotels Private Limited - Presently Known as Chouki vs. Intellectual Property Appellate Board & Ors.**

In this case, a Letters Patent Appeal was filed by the Appellant, Kaveri Hotels Pvt. Ltd. as the lower court did not look into adequacy of stamp fee. The questions before the High Court of Gujarat were whether the agreement reduced to writing on a Non- Judicial Stamp Paper of Rs.100 required appropriate stamp duty to be affixed in order to become admissible as evidence before the Registrar of Trademarks, and whether the dispute between the parties over the trademark 'Chokhi Dhani' should be registered in favour of the Appellant or in favour of the Respondent. The Court observed that at the previous instances the question of stamp duty was neither raised by the parties nor discussed by the Registrar of Trademarks or the Lower Court and therefore not discussed by the Single Judge. The Court opined that all the orders passed by the Authorities below could not be sustained and the entire matter had to be remanded back to the Registrar to decide the case again with the question of stamp duty as a preliminary issue after giving an opportunity of hearing to both the sides. Hence, the Letters Patent Appeal was allowed, the orders passed by the Single Judge and IPAB were set aside, and the matter was restored to the Registrar.

*Citation: Kaveri Hotels Private Limited - Presently known as Chouki vs. Intellectual Property Appellate Board & Ors., decided by the High Court of Gujarat on 1st July, 2021, available at <https://indiankanoon.org/doc/27698270/>*

#### **25. Guccio Gucci S.P.A. vs. Intiyaz Sheikh**

In this case, the Plaintiff, Guccio Gucci S.P.A. filed a suit for permanent injunction against Defendant Intiyaz Sheikh so as to restrain him and persons claiming under him from infringing its trademark, copyright, passing off, unfair trade competition, rendition of accounts, delivery up, etc. The Plaintiff had been advertising its products bearing its IP, registered in many countries, through various printed media including newspapers, magazines, internet and trade journals, leaflets and other promotional literature.



Plaintiff in its course of market survey came to know that the Defendant was illegally manufacturing socks using Plaintiff's registered "green and red stripes" logo and mark "Gucci" in its entirety. The Court had passed an ex-parte ad-interim injunction. At the later stages of the suit the Court noted that the Defendant deliberately chose not to participate in the proceedings despite the pendency. The Court reasoned that a civil case proceeded on the doctrine of preponderance of probabilities and not on proof beyond reasonable doubt. Although the mere non-appearance of Defendant could not be inferred against him, but also in view of overall facts, coupled with the evidence on record along with the report of the local commissioner, the Plaintiff was successful in establishing the case in its favour. The Court decreed a permanent injunction against the Defendant and directed him to handover all the infringing goods to the Plaintiff as well as pay ₹2,00,000/- and ₹1,66,000/- as costs and damages respectively.

*Citation: Guccio Gucci S.P.A. vs. Intiyaz Sheikh, decided by the District Judge (Commercial Court), Tis Hazari Court, Delhi on 27th August, 2021, available at <https://indiankanoon.org/doc/178127761/>*

## **26. Hindustan Unilever Limited vs. Vansh Cosmetic and Anr.**

In this case, the Plaintiff was the true proprietor of the marks "LAKME", "LAKME NINE TO FIVE," "NINE TO FIVE", "9 to 5", "LAKME EYECONIC", "LAKME ABSOLUTE", "LAKME ABSOLUTE WHITE INTENSE", "LAKME ABSOLUTE ARGAN OIL RADIANCE" and many others, which had been successful in the market since 2011. Around July 2021, it was found that the Defendants were selling the counterfeit cosmetic products/goods of "LAKME" brand the counterfeit products were a blatant imitation and obvious copy of the artistic work, trade dress or the overall colour scheme of the original, which in turn might have led to deception and confusion

amidst the general public. The plaintiff also averred the apprehension that the Defendant's products were of an inferior quality and could thus be a health threat to the users. It was submitted that the Defendant was infringing the registered trademarks and copyrights owned by the Plaintiff.

The Court found a clear case of *prima facie* infringement of the trademarks and copyrights owned by the Plaintiff and found that the evident and deceptive similarity between the two could not be a mere coincidence. Thus, the court granted an ex-parte ad-interim order restraining the Defendant from manufacturing/ packaging/ printing/ selling/ distributing any counterfeit products/goods bearing marks deceptively similar to the Plaintiff's registered marks. The Court also appointed a Court Receiver as receiver of the defendants' counterfeit goods bearing the impugned marks or the pirated artistic works. As per the said order the Court commissioner was vested with the powers to execute this said order, which was held to be in operation till 17th September 2021.

*Citation: Hindustan Unilever Limited vs. Vansh Cosmetic and Anr., Decided by the Bombay High Court on 27th July, 2021, available at <https://indiankanoon.org/doc/115803403/>*

## **27. Global Car Group PTE Ltd. & Anr. vs. Mr Krishni Ramesh Khandelwal & Ors.**

The Plaintiff, Global Car Group PTE Limited. & Anr., filed an application under Order 39 Rule 1 and 2 of the Civil Procedure Code, 1908, seeking a *prima facie* ex-parte injunction to restrain the Defendants, Mr. Krishna Ramesh Khandelwal & Ors., from using or offering for sale, advertising, or dealing in goods infringing the trademarks of the Plaintiffs specifically, "Bikes24x7" or any other identical or deceptively similar '24 Formative Marks'. The Plaintiff has been using the trademarks since 2015 and the concept combining the words 'Cars', 'Funding', 'Auction' and 'Unnati' along with the number '24' was an essential feature of all the trademarks of the Plaintiff. The Plaintiff while conducting a search for the word 'Bikes24' came across the Defendant's mark,

which was infringing the Plaintiff's trademarks in connection with its second-hand/refurbished motorcycles business. The Defendant was also operating the website [www.bikes24x7.com](http://www.bikes24x7.com) and had filed a trade mark application for the mark in class 35 which was pending before the Registrar of Trademarks. The Plaintiff had previously issued a cease-and-desist notice to the Defendant. The Court stated that it was clear that the Defendant was *prima facie* trying to adopt a mark which was deceptively similar to the Plaintiff's trademark, and thus restrained the Defendant from selling, offering for sale, advertising, or dealing in goods or services bearing the infringing marks, or any other trademark which was identical to the Plaintiff's trademarks until further orders were given by the Court. The Defendant was also directed to suspend the use of domain name <https://bikes24x7.com/> within three weeks from the date of the receipt of the order.

*Citation: Global Car Group Pte Ltd & Anr. vs. Mr. Krishi Ramesh Khandelwal & Ors., decided by the Delhi High Court on 21st September, 2021, available at <https://indiankanoon.org/doc/9080762/>*

### **28. P. Kanthilal vs. Shetan Singh**

Kanthilal, the Plaintiff, filed a suit seeking a permanent injunction and damages against Shetan Singh, the Defendant, for infringement and passing off of the Plaintiff's trademark. Plaintiff claimed to own the trademark "PREETHI" which had acquired distinctiveness as a result of continuous and extensive use and promotion since 1998. The Plaintiff became aware that the Defendant was infringing and passing off the Plaintiff's trademark by using the identical mark PREETHI/RREETHI for identical goods as those manufactured and marketed by the Plaintiff and thereby diverting customers looking for the Plaintiff's products. The Defendant claimed that the registration of the Plaintiff's mark was currently the subject matter of rectification proceedings before the Registrar of Trademarks, Chennai under rectification filed by M/s. Maya Appliances Limited on 10.4.2006 which was pending for adjudication and hence there could be no infringement suit against the Defendant. The Court rejected this argument and held the Defendant liable for infringement, and permanently restrained

the Defendant from infringing and passing off the Plaintiff's registered trademark PREETHI by using the identical and deceptively similar trademark PREETHI/RREETHI or any other identical or deceptively, confusingly similar trademark in relation to the goods manufactured and traded by the Plaintiff.

*Citation: P. Kanthilal vs. Shetan Singh, decided by the Addl. City Civil Judge Bangalore City on 30 August, 2021, available at <https://indiankanoon.org/doc/130347445/>*

## **29. Geetanjali Studio Private Limited & Anr. vs. Nuxi To Kut N Kurl Private Limited (through its Directors) & Ors.**

In this case, Geetanjali Studio Private Limited, the Plaintiff, filed an application under Order 39 Rule 1 and 2 of the Civil Procedure Code, 1908, seeking *prima facie* ex-parte injunction to restrain Nuxi To Kut N Kurl Private Limited, the Defendant, from offering for sale of any similar services or goods under the marks GEETANJALI, GEETANJALI SALON, GEETANJALI STUDIO or any other identical or deceptively similar marks. The Plaintiff entered into a new franchise agreement with the Defendant, whereby the Plaintiff licensed the Defendant to use its trade mark on a non-exclusive basis for a certain payment. The Defendant failed to pay the franchise fee even after several reminders, thus, on 30.03.2021, the Plaintiffs sent an email to the Defendant demanding a total sum of Rs.3,83,210/- as an outstanding fee as a last measure. On failure of the Defendant to pay the fee within the given time, the Plaintiff terminated the franchise agreement by issuing a notice of termination on 06.04.2021. In June 2021, after the lockdown was lifted, it was found that the Defendant was using the Plaintiff's trademark and running 'Geetanjali Studio' despite the termination notice, and a legal notice was sent to the Defendants on 28.06.2021. However, the Defendant continued to use the said trademark.

The court found that the continued use of the trademark in question by the Defendant to be violating the Plaintiff's rights and restrained the Defendant from using the impugned trademark or any other or identical or deceptively similar mark to the Plaintiff's trademark 'GEETANALI'. The Defendant was ordered to comply within five days from the date of the order.

*Citation: Geetanjali Studio Private Limited & Anr. vs. Nuxi To Kut N Kurl Private Limited through its Directors & Ors., decided by the Delhi High Court on 21st September, 2021, available at <https://indiankanoon.org/doc/18307181/>*

### **30. Brandzstorm India Marketing Pvt. Ltd. vs. L N Agency**

In this case, the Plaintiff was the registered proprietor of the brand name "LUXXUBERANCE" and also a dealer of many internationally acclaimed and well-known brands for lifestyle products such as handbags and watches. The Plaintiff chose the Defendant to operate the franchise which was to be opened at Jamshedpur for the purpose of selling goods under the Plaintiff on a sale-or-return basis. Thereby a Letter of Intent ("LoI") was executed between the parties and the Defendant agreed to make a security deposit of Rs 7.5 lakhs and the Plaintiff delivered stocks worth around Rs. 42 Lakhs to the Defendant. The Defendant was unable to generate service and the commission-related obligations in accordance with the LoI and sent an email to the Plaintiff intimating his decision to shut down the store by 1st May 2021. The Defendant claimed Rs. 52 lakhs from the Plaintiff citing the amount it had spent for the signage and setting up of the outlet in spite of the fact that the LoI clearly indicated that those expenses were to be taken from the Defendant's account. The Plaintiff also submitted that the Defendant had not generated any income from the said franchisee set-up. Though the Plaintiff stated that the LoI signed as a part of Franchise had come to an end, the Defendant still continued to use the Plaintiff's registered trademark in order to sell many products. Thus, having made out a prima facie case and found the balance of convenience in favour of

the Plaintiff, the court issued temporary injunction restraining the Defendant from dealing/ advertising/ marketing/ selling any goods with the Plaintiff's registered marks or the other well-known trademarks owned by the Plaintiff.

The court further ordered ad- interim relief such that if any material/items were found at the Defendant's outlet, the same would be seized by the Court Receiver and handed over to the Plaintiff and. The Court appointed an Additional Special Receiver, empowered and vested with the powers to take police assistance for successful execution of the commission. The order was held to be in operation till 20th October 2021 or until receipt of further order from the Court.

*Citation : Brandzstorm India Marketing Pvt. Ltd. vs. L N Agency, decided by the Bombay High Court on 21st September, 2021, available at: <https://indiankanoon.org/doc/160060846/>*

### **31. Saint-Gobain India Private Limited vs. Geeta Kaler & Ors.**

In this case, the Plaintiffs 1 to 4 an English, French, UK and Indian Company respectively were part of the SAINT-GOBAIN group of corporate entities which mainly dealt with the manufacture and sale of a variety of insulation systems, glass, building materials, water supply systems and so on across many international jurisdictions. The SAINT-GOBAIN group had established its presence in the Indian market since 1996. In India, the mark "GYPROC" was registered in the name of the Plaintiff No. 1 and the marks "SAINT-GOBAIN" and the label "SAINT-GOBAIN" were registered in the name of Plaintiff No. 2. They also owned a few other trademarks such as "GLASROC", "GYPROC HABITO" and so on. Around May 2014, Defendant-1 filed an application for the mark "GYPROCK" and the Registry in its objection cited Plaintiff-1's mark "GYPROC" as the conflicting mark. Defendant-1 claimed dissimilarity and did not respond to the Cease and Desist notice issued by the Plaintiffs. The Plaintiffs filed an Opposition Notice and eventually the application was deemed to be abandoned. In 2017, another application for the mark "SAND GOVIND GYPROCK" was filed by Defendants 1 and 2, operating under the banner of Defendant-3.

The Plaintiffs initiated the opposition proceedings and this application too was abandoned. In 2020, the Plaintiffs discovered that the Defendants tried to trade under the marks “GYPROCK” and “SAND GOVIND GYPROCK” again. Hence, they filed this suit and the Court found sufficient *prima facie* case on the grounds that the Defendants’ mark was indistinguishable from that of the Plaintiffs’ and was a blatant imitation to take undue advantage of the phonetic, aural, structural and visual similarity between the said marks and to in turn trade upon Plaintiffs’ hard-earned goodwill and reputation. The Court granted an injunction restraining the Defendants from using the marks “GYPROCK”, “SAND GOVIND GYPROCK” or “SAND GOVIND GYPSUM CO” or the packaging/trade dress that might be similar or in any way identical to the registered marks “GYPROC”, “SAINT-GOBAIN” owned by the Plaintiffs. The order was held to be in operation till 26th October, 2021 or until receipt of further order from the Court.

*Citation: Saint-Gobain India Private Limited vs. Geeta Kaler & Ors., decided by the Bombay High Court on 27th September, 2021, available at <https://indiankanoon.org/doc/173802317/>*

### **32. Avtar Singh & Ors. vs. Sakshi Srivastava & Anr.**

There were four Plaintiffs in this case, i.e., Mr. Avtar Singh, Mr. Harkirat Singh, Aero Traders Private Ltd. and Aero Associates Pvt. Ltd., who co-owned M/s Aero Club. They filed an application for the trademark “WOODS” in the club’s name firstly in 1994 and 1996 under Class 25 and in 2017 under Class 3. The Plaintiffs together subsequently registered trademarks “WOODLAND”, “WOODLAND” (stylised) and other “WOODLAND” marks on varying dates in compliance with Section 28 and 31 of the Trademarks Act, 1999. They had pending applications for trademarks “WOODS” (word) and “WOODS” (stylised) under Class 18. The two Defendants in this case jointly owned M/s Siddhi Vinayak Clothes and Concepts. Defendant 1 also registered trademarks with the same names as the Plaintiffs’, as well as “WOODLEY” under Class 18 and 35. On October 4th, 2021,



the Plaintiffs filed an opposition under Classes 18, 25 and 35 on the grounds that the Defendants had dishonestly adopted the Plaintiffs' impugned mark "WOODLEY". The Plaintiffs argued that the Defendants' mark "WOODLEY" was deceptively, visually and phonetically similar to the Plaintiff's marks "WOODLAND" and "WOODS". The style and font of "W" on the Defendants' device or label "WOODLEY" was also virtually identical, along with the identical colour scheme of blue background with white font colour. The Defendants contended that there was unreasonable delay on the part of the Plaintiffs in the filing of the suit and that the word "wood" cannot have any exclusivity over it as it is non-distinctive and generic. The Defendants claimed that their mark "WOODLEY" was phonetically pronounced "wad-lee", which was different from the Plaintiff's marks and the logos as a whole had many differences in styling, colour schemes and font size. The Defendants also claimed that they were under litigation for the issue of similarity before the specialized authority i.e., the Trademark Registry for the last 3 years, so this case filed by the Plaintiff was to hasten those proceedings. The Delhi High Court observed, in favour of the Plaintiffs, that a mark should not always be looked at in totality because some elements of a mark could be deceptively similar. The Court also observed that the similarity test was to be applied differently for different economic classes, which was an argument in the favour of the Defendants, as their targeted buyers were not on the affluent side unlike the Plaintiffs'. The Court also observed that the Defendants submitted that they would only use their trademarks under class 25 and class 35 and not use blue colour. The Court ruled in favour of the Plaintiffs and allowed the interim order mainly because the Plaintiffs had a prima facie case against the defendant.

*Citation: Avtar Singh & Ors. vs. Sakshi Srivastava & Anr., decided by the High Court of Delhi on 4th October, 2021, available at <https://indiankanoon.org/doc/45312155/>*



### **33. Jumeirah Beach Resort LLC vs. Designarch Consultants Pvt Ltd. & Anr.**

In this case, Jumeirah, the hotel and trademark owner of “Burj Al Arab,” filed a case against a real estate/construction company, which was using the marks Burj Noida, Burj Bangalore, Burj Mumbai and so on. Jumeirah asked for an interim injunction during the pendency of the suit. The Defendant also had registrations over its marks, and argued that Jumeirah does not hold any rights over the word ‘Burj,’ which means tower. After reviewing the facts and arguments, the Delhi High Court allowed the Defendant to use Burj Noida for its ongoing project, but restrained the Defendant from using Burj Bangalore, Burj Mumbai and so on. While arriving at its conclusion, the Court stated that Burj is the essential part of Jumeirah trademark, and that well-known nature of the mark has to be established on trial.

*Citation: Jumeirah Beach Resort Llc vs. Designarch Consultants Pvt. Ltd. & Anr., decided by the Delhi High Court on 9 November, 2021, available at <https://indiankanoon.org/doc/88013685/>*

### **34. Bacardi and Company Limited vs. Bahety Overseas Private Limited & Ors.**

Bacardi filed a trademark infringement and passing off case against Bahety with respect to its products sold under the registered trademark, BREEZER, and its trade dress. The suit was filed against Bahety’s use of the marks, Freeze and FreezeMix’ for non- alcoholic drinks, which were being sold in bottles having similarities in design. After looking at the usage of the marks and bottle designs, the Court came to the conclusion that Bahety was using the trademark, FreezeMix, by writing it in a manner similar to Bacardi’s Breezer. According to the Court, the emphasis was on the word ‘Freeze,’ which was being used in a prominent manner along with bottles bearing similar designs. It stated that the bottle of Bahety included a similar champagne base, ridges and bottle top. Though Bacardi was selling alcoholic drinks and Bahety was selling non-alcoholic drinks, the Court came to the conclusion that there was infringement

as there was consumer association between the products. The Court went on to grant an interim injunction in favour of Bacardi restraining Bahety from using the trademark FreezeMix and related trade dress.

*Citation: Bacardi and Company Limited vs. Bahety Overseas Private Limited & Ors, decided by the Delhi High Court on 12th November, 2021, available at <https://indiankanoon.org/doc/48139811/>*

### **35. Pidilite Industries Limited vs. Platinum Waltech Limited**

The Plaintiff filed this suit against the Defendant seeking relief in trademark, copyright and designs combined with causes of action for passing off in each. The Plaintiff was a well-known manufacturer of products relating to the construction and paint industry and had a worldwide presence since 1969. The Plaintiff had several trademarks related to its products which included the DR FIXIT mark with a distinctive device of a man wearing a yellow construction helmet and product identification marks including LW+, LW, URP, PIDIPROOF. The Plaintiff claimed copyright protection in the labels as well, being original artistic works. The Plaintiff claimed goodwill and reputation acquired by usage of its IP over an extended period of time continuously and without interruption. The Plaintiff also claimed distinctiveness in the configuration of the can or container used for its products.

The Plaintiff came across a construction chemical product manufactured by the Defendant, which had some striking similarities with the Plaintiff's product. The container was almost indistinguishable from that of the Plaintiff, which also used the mark LWC. The colour scheme was also broadly the same as that of the Plaintiff's products and there was a feature of a man in tie and jacket wearing a yellow construction helmet. The Defendant stated that the mark LWC, used by the Defendants was purely descriptive and stood for 'liquid waterproof/waterproofing compound'.

The Court stated that the entire set of actions of the Defendant must be seen as one. The Court applied the test of average intelligence and imperfect recollection. The Court stated that the container used by the Defendant was a dead giveaway. If the Defendant was *bona fide* in its adoption, there was no reason for it to adopt a container of this design that was so strikingly similar to the Plaintiff's. With respect to the Defendant's claim that its use of the LWS mark was descriptive, the Court stated that the Defendant was not using the expression "liquid waterproof compound", but was using the abbreviation LWC, which was similar to marks LW and LW+ that were registered by the Plaintiff. Further, the man portrayed by the Defendant was also similar to the DR FIXIT device of the Plaintiff.

The Court issued an injunction against the Defendant, and also ordered the Defendant to pay costs in the amount of Rs. 2.5 lakhs to the Plaintiff within two weeks from the date of the order.

*Citation: Pidilite Industries Limited vs. Platinum Waltech Limited, decided by the High Court of Bombay on 24th August, 2021, available at <https://indiankanoon.org/doc/55280317/>*

### **36. N. Ranga Rao & Sons Private Ltd. vs. Sree Annapoorna Agro Foods**

The Plaintiff, engaged in the business since 1948, was a leading manufacturer and supplier of incense sticks and other allied products. It held several trademarks, of which the mark 'CYCLE' was in dispute in this case. The Defendant adopted the mark 'CYCLE' concerning edible oil. Plaintiff claimed that the mark was immensely popular and owing to its wide turnover and extensive sales and promotional activities, the trademark CYCLE was a well-known mark. The Plaintiff filed the suit under Sections 27, 28, 29, 134 and 135 of Trade Marks Act, 1999 and claimed that Defendant intended to take undue advantage of its reputation and goodwill. It was further claimed that such use caused unwarranted confusion among the public and amounted to clear infringement of Plaintiff's registered trademark. The Court stated that the burden was on the Plaintiff to prove (i) its reputation in India;

(ii) that the Defendant was using the mark without due cause; (iii) that by using the mark without cause the Defendant took unfair advantage, or it was detrimental to the distinctive character or reputation of the Plaintiff's registered trademark.

The Court found that the Plaintiff proved only reputation regarding goods related to incense sticks and failed to prove that the Defendant was using the mark without due cause or taking unfair advantage. Further, no evidence was led by Plaintiff to show that the use of the mark by the Defendant was detrimental to or caused dilution to the Plaintiff's reputation. The Court noted that though the mark CYCLE was a common household item and a generic word the distinctiveness acquired by the Plaintiff was restricted to the goods for which it had registration, and it could not obtain a monopoly over the word or claim exclusive right across other classes of goods. In view of the findings the Court dismissed the suit.

*Citation: N. Ranga Rao & Sons Private Ltd vs. Sree Annapoorna Agro Foods, decided by the Madras High Court on 18th November, 2016, available at <https://indiankanoon.org/doc/25237434/>*

### **37. Aqua Pump Industries & Anr. vs. Tapesesh Kumar**

Plaintiffs No. 1 and 2, Aqua Pump Industries and Aqua Sub Engineering respectively, manufactured different types of electric motors and pumps under their registered trademark "TEXMO". They also jointly owned the trademark in respect of goods such as centrifugal pumps, domestic pumps and sugar cane machines categorised under Class 7 of the Schedule of the Trademark Rules. They registered "TEXMO" as a mark and device mark, with the expression "TEXMO" impressed on an inverted triangle. Plaintiff No. 1 commenced its business in April 1974 under the trademark "TEXMO", while Plaintiff No. 2 started its business in November 1982 under the same mark. They entered into an agreement together to officially register as proprietors of the trademark "TEXMO" in April 1998. In Trade Mark Journal No. 1915 published in August



2019, the Plaintiffs discovered that the Defendant applied for registration of a mark with the same name for industrial and domestic sewing machines, under Class 7. The Plaintiffs claimed that the Defendant knowingly exploited the commercial goodwill gained all over the Indian market attached to the Plaintiffs' trade mark "TEXMO". They contended that the Defendant not only adopted an identical mark, but did so for goods in the same class, thus making it cognate to the Plaintiffs' goods. Even though the nature of goods was different, the public may have confused the Defendants' goods with theirs, diluting their mark's reputation. The Defendants would unfairly gain from Plaintiff's business with annual turnover of 1,200 crore rupees. The Madras High Court observed that the Defendant could have easily found that the mark was existing, if it had conducted a bona fide search for the invented word "TEXMO", being used by the Plaintiffs since 1976. Thus, the Court granted permanent injunction in the Plaintiffs' favour restraining the Defendants from using their mark.

*Citation: Aqua Pump Industries & Anr. vs. Tapes Kumar, decided by the Madras High Court on 31st August, 2021, available at <https://indiankanoon.org/doc/156980139/>*

### **38. Walmart Apollo LLC vs. Aayush Jain & Anr.**

In this case, the Plaintiff owned a registered trademark for WALMART/WALMART. The Defendant applied for WMART and allegedly used it since April, 2019. The Plaintiff filed an infringement suit against the Defendant, who was using 'WMart' and [www.wmartretail.com](http://www.wmartretail.com). The Plaintiff prayed for an injunction during the pendency of the suit, which the Court granted until the next date of hearing.

*Citation: Walmart Apollo Llc vs. Aayush Jain & Anr., decided by the Delhi High Court on 12th November, 2021, available at: <https://indiankanoon.org/doc/121804661/>.*

### **39. Khandelwal Edible Oils Limited vs. Landsmill Agro Private Limited**

In this case, the Plaintiff registered a trademark on the word “Chakra” for edible oils. The Defendant in the case was using the marks “CHAKRA KOLHU”, “CHAKRIKA” and “CHAKRESH” for its oil products. The Court in the case granted an interim injunction in favour of the Plaintiff with respect to the Defendant’s use of “CHAKRA KOLHU”, but allowed the Defendant to file a reply before making a decision on “CHAKRIKA” and “CHAKRESH.” Though the Defendant argued that the word “Chakra” was commonly used in the industry, the Court opined that the Defendant’s use of the mark with yellow lettering with black background like the Plaintiff warranted an interim injunction.

*Citation: Khandelwal Edible Oils Limited vs. Landsmill Agro Private Limited, decided by Delhi High Court on 12th November, 2021, available at <https://indiankanoon.org/doc/71243154/>.*

### **40. M/s. Y.V. Seshachalam and Co. vs. M/s. Sri Om Sai Traders**

The Plaintiff, engaged in trading pooja products, sought a permanent injunction against the Defendant for infringing its registered trademark despite having issued a Cease- and-Desist notice. The Plaintiff alleged that the Defendant’s trademark ‘GOKULAM’ was phonetically similar to ‘GOPURAM’, and claimed that the Defendant adopted the Plaintiff’s colour scheme with the intent to pass off its goods as that of the Plaintiff’s. The High Court of Madras acknowledged the similarity of trademarks and opined that the Defendant had deliberately adopted a similar colour scheme to mislead an average consumer into thinking that the product belonged to the Plaintiff. The Court verified the Plaintiff’s stronghold in the market by perusing various trade-related certificates that were submitted. The relief sought by the Plaintiff restraining the Defendants from further infringement of trademark was granted, and the Court imposed exemplary costs of Rs. 50,000 for the act of infringement. However, due to lack of evidence that proved unjust enrichment of trademark, the Court denied a relief that directed the Defendant to surrender the accounts of profits earned during the period of infringement.

*Citation: M/s. Y.V. Seshachalam and Co. vs. M/s. Sri Om Sai Traders, decided by the Madras High Court on 6th September, 2021, available at <https://indiankanoon.org/doc/66419635/>.*

#### **41. Agatha Christie Limited vs. Registrar of Trademarks**

In this case, Agatha Christie Limited filed a trademark application for the mark, “And Then There Were None.” The Registrar rejected the application, and Agatha Christie Limited appealed. The Delhi High Court came to the conclusion that there was no ground on which the mark could have been rejected under the Trademarks Act, 1999, as the mark was not descriptive and because no similar marks were existing on the Register. It also pointed out that the mark was distinctive, and directed the Registrar to register the mark.

*Citation: Agatha Christie Limited vs. Registrar of Trade Marks, decided by the Delhi High Court on 8th December, 2021, available at <https://indiankanoon.org/doc/183502564/>*

#### **42. Sun Pharma Laboratories Limited vs D.D.Pharmaceuticals Private Limited & Anr.**

In this case, Sun Pharma filed three trademark infringement suits against DD Pharma for adoption of similar trademarks. One of the trademarks of the Plaintiff was BUPRON, and the Defendant was using BUPRO.

DD Pharma primarily argued that its trademarks were not infringing because the trademarks were adopted by both parties from the names of active ingredients. With respect to BUPRON, the active ingredient was Bupropion Hydrochloride. It was also argued that the marks are prescription drugs, which can be differentiated by doctors and pharmacists.



The Court disagreed with DD Pharma, and held that the likelihood of confusion required a lower standard of proof with respect to pharmaceutical products as confusion in drug marks is likely to cause harm to the general public. It also pointed out that patients are likely to be easily confused if the names were similar. Though the marks of both Sun and DD Pharma were adopted from the names of active ingredients, the Court stated that there was a likelihood of confusion and granted a permanent injunction in favour of Sun Pharma prohibiting DD Pharma from using the marks in question.

*Citation: Sun Pharma Laboratories Limited vs. D.D. Pharmaceuticals Private Limited., decided by The Madras High Court on 23rd September, 2021, available at <https://indiankanoon.org/doc/40229201/>*

#### **43. Exxon Mobil Corporation vs. Mobilfuels Private Limited & Anr.**

In this case, Exxon Mobil filed a trademark infringement suit against MOBILFUELS for use of its registered trademark, MOBIL, as part of the name of its mobile app on the Google Play Store. The defendant in the case was using MOBILFUELS as the name of its app. The Court passed an ex-parte interim injunction restraining the defendant from using the mark, MOBILFUELS, until the date of the next hearing.

*Citation: Exxon Mobil Corporation vs. Mobilfuels Private Limited & Anr, decided by the Delhi High Court on 29th November, 2021, available at <https://indiankanoon.org/doc/130852639/>*



## DESIGN CASES 2021

### 1. M/s Kamdhenu Limited vs. M/s Aashiana Rolling Mills Ltd.

In a case involving a registered design pertaining to double rib pattern of steel rods, the Delhi High Court cancelled the registration summarily stating that there was no need for a full trial. The Court came to this conclusion primarily based on the fact that the design that formed part of the registration was published as part of British, ISO and other standards before the filing date of the design application. Based on the evidence on record, the Court stated that the application for cancellation of the Registered Design has a high likelihood of success, and that no further evidence needs to be led in this respect. While stating so, the Court pointed out that a strong *prima facie* case at the interim level does not necessarily give rise to a high likelihood of success.

*Citation: M/s Kamdhenu Limited vs. M/s Aashiana Rolling Mills Ltd., decided by the Delhi High Court on 12th May, 2021, available at: <https://indiankanoon.org/doc/45300504/>, last visited on 17th November, 2021.*

### 2. E.N. Project and Engineering and Ors vs. Kvt Electrical Project and Ors.

In this case, the Plaintiffs, manufacturers of 'cable trays' filed a suit for infringement of their registered design. The Trial Court granted an ad-interim ex-parte injunction in their favour. The Defendant filed an interim application seeking vacation of the order, alleging the registration to be male fide as the design was generic and lacked originality. The Court pointed out that, once registration was granted, the onus shifted to the challenger to demonstrate prior existence of the design by way of prior publication. While applying the ocular test the Court noted that the Defendants' cable tray was an apparent imitation of the Plaintiffs' registered design and found the Defendants'

adoption to be dishonest. The Defendants failed to satisfy the Court on equity. The Court disposed of the application and affirmed the injunction order to be absolute.

*Citation: E.N. Project and Engineering and Ors. vs. Kvt Electrical Project and Ors. decided by the Delhi High Court on 12th October, 2021, available at: <http://indiankanoon.org/doc/146680473/>, last visited on 17th November, 2021.*

### 3. Relaxo Footwears Limited vs. Aqualite Industries Pvt. Limited

In this case the Plaintiff, the largest footwear producer in India, filed an application seeking ex-parte injunction against the Defendant. The Plaintiff alleged that the Defendant imitated Plaintiff's products/design/trade dress/get up. The Court analyzed the case at hand from the purview of Sections 2, 4, 5, 19, 22 of the Designs Act, 2000 and various cases. It noted that mere registration of the design would not entitle a registrant of the design to claim protection. It would always be open to the Defendant to plead and set up a defence of lack of novelty or existence of prior art. The Court stated that the test in deciding such matters was: "judged solely by the eye are the essential features present or are the two substantially different". The Court compared their products and concluded that *prima facie* the Defendant had copied the Plaintiff's design. It was brought to the Court's notice that although the Defendant alleged lack of originality in Plaintiff's design, it had applied for registration of a similar design. The Court stated that the issue of the existence of prior art would be considered after evidence had been led. The Plaintiff had made out a *prima facie* case and the balance of convenience was in its favour, and hence an interim injunction was granted against the Defendant.

*Citation: Relaxo Footwears Limited vs. Aqualite Industries Pvt Limited, decided by the Delhi High Court on 8<sup>th</sup> October, 2021, available at: <http://indiankanoon.org/doc/41801560/>, last visited on 17<sup>th</sup> November, 2021.*

#### 4. Crompton Greaves Consumer Electricals Ltd. vs. CG Power and Industrial Solutions Ltd.

The Plaintiff, Crompton Greaves Consumer Electricals Ltd. (CGCEL) approached the Court regarding passing off/infringement of its registered design for submersible centrifugal pumps by the Defendant, CG Power and Industrial Solutions Ltd. (CGPISL) which copied the design and structure of the pump as well as used the trade name 'CROMPTON' or 'CROMPTON GREAVES' while advertising for the infringing pumps.

The Plaintiff sent a notice, post which the Defendant agreed to inform its dealers/channel partners to cease the use of the words 'CROMPTON' and/or 'CROMPTON GREAVES' on the products, or the relevant promotional material, and destroy any such packing or promotional material which infringes the rights of the Plaintiff. However, despite such communication, the products were still visible on websites such as *amazon.in* or on Google searches – where the Defendant's products were being sold with the Plaintiff's trade name. More so, the Plaintiff alleged that there were communications being circulated in the market by the Defendant, deliberately showing association with the Plaintiff's reputation.

The Defendant asserted that it claimed no right on the concerned trade names, and reaffirmed the Court that it would notify its channel partners once again to cease activities which infringed the rights of the Plaintiff, in any manner, including advertising on e-commerce websites.

*Citation: Crompton Greaves Consumer Electricals Ltd. vs. CG Power and Industrial Solutions Ltd., decided by the Delhi High Court on 8th December 2021, available at: <https://indiankanoon.org/doc/35584829/>, last visited on 6th January, 2022.*

## COPYRIGHT CASES 2021

### 1. Sony Pictures Network India Pvt. Ltd. vs. [www.sportsala.tv](http://www.sportsala.tv) And Ors

In this case, Sony Pictures filed a suit against numerous Defendants primarily praying for a permanent injunction against reproducing, making available, distributing, and broadcasting of the cricket matches between India's tours of England and Sri Lanka. During the pendency of the suit, Sony Pictures prayed for an interim injunction and other similar reliefs.

The Court granted an injunction in favour of Sony Pictures against websites including their redirects, mirrors and alpha-numeric versions. A dynamic injunction was also granted against rogue websites, which could reproduce, broadcast, make available, communicate to the public or distribute the cricket matches. The Court also passed an order directing ISPs to block the mentioned and other rogue websites, and asked the Government of India to give appropriate directions to prevent infringement of copyrights of Sony Pictures in the matches.

The interim injunction also covered MSOs and cable operators, and local commissioners were appointed to monitor and act against violations of the Court's orders. The Court's orders primarily cover the copyrights held by Sony Pictures, and by implication permits non-infringing uses and fair uses of the content pertaining to the cricket matches between India and England/Sri Lanka.

*Citation: Sony Pictures Network India Pvt. Ltd. vs. [www.sportsala.tv](http://www.sportsala.tv) and Ors., decided by the Delhi High Court, on 4th June, 2021, available at <https://indiankanoon.org/doc/7278687/>*

### 2. Krishna Kishore Singh vs. Sarla A. Saraogi & Ors.

In this case, the Delhi High Court refused to grant an interim injunction against publication and release of films purportedly related to Sushant Singh Rajput (SSR) as the Plaintiff, SSR's father, failed to make out a prima facie case, and because irreparable harm and balance of convenience were in favour of the Defendants.

The Plaintiff argued that films and series such as 'NYAY The Justice,' 'Suicide or Murder,' and 'Shashank,' must be enjoined and restrained from being released, published and communicated to the public. The Plaintiff filed the case on several grounds including violation of publicity rights and privacy rights, right to fair trial, defamation, and violation of Article 21 of the Constitution.

After reviewing the facts and relevant cases, the Court came to the conclusion that the Plaintiff failed to make out a valid case for violation of celebrity or publicity rights of SSR or his family members because the Plaintiff was not aware of the content of the films, the defendants were not using SSR's image, likeness or name, and because the films had appropriate disclaimers. It also pointed out that celebrity rights may not subsist after the death of the celebrity, and that facts that form part of the public record may be used by the Defendants without liability. About defamation, the Court stated that a case of defamation is merely speculative without access to the defamatory content.

The Court also pointed out that no violation of the right to fair trial may be contemplated because of publication in news or by way of films. It went on to note that freedom of expression prevails over Article 21 for information that forms part of the public record. While denying the injunction, it asked the Defendants to render accounts as any damage may be compensated by way of damages.

*Citation: Krishna Kishore Singh vs. Sarla A. Saraogi & Ors., decided by the Delhi High Court, on 10th June 2021, available at <https://indiankanoon.org/doc/152020280/>*

### **3. Dassault System Solidworks Corporation and Anr. vs. Spartan Engineering Industries Pvt. Ltd. and Anr.**

In this case, the Delhi High Court dealt with the issue of copyright infringement of software. Plaintiff no. 1 was a French company which developed a software

called 'Solidworks'. This software facilitated modelling and development of products in a three-dimensional environment. Plaintiff no.2 was a sister concern established by Plaintiff no.1 to manage all its affairs with respect to 'Solidworks' in India.

Plaintiff no.1 and Plaintiff no. 2 ("Plaintiffs"), stated that the software was developed by their employees as a work-for-hire, and hence the Plaintiffs owned the copyright. The Plaintiffs claimed that the software program and its instruction manuals were literary works under the Copyright Act, 1957 (Act) and were entitled to copyright protection. The software was first published in the United States of America (US) and was entitled to protection in India under Section 40 of the Copyright Act, 1957 as India and the US were members of the Berne Convention, Universal Copyright Convention and the World Trade Organisation's TRIPS Agreement.

The Plaintiffs alleged that in May 2018, the Plaintiffs received information regarding the commercial use of pirated and unauthorised versions of the 'Solidworks' software program by the Defendants, without paying the required license fee. The Plaintiffs further asserted that such unauthorized use of the software had increased since August, 2020 and all efforts to reach an amicable resolution were futile, as the Defendants were denying infringement.

Following this, the Plaintiffs approached the Court seeking an injunction, as use of any pirated or unauthorised copy of the Plaintiffs' software program would amount to copyright infringement under Section 51 of the Copyright Act. The Plaintiffs also relied on Section 63B of the Act, which made it a criminal offence to knowingly use a pirated computer program. Further, the Plaintiffs asserted that there was a contractual breach and intellectual property infringement, due to the violation of the End User License Agreement by the Defendants.

While issuing the order, the Court remarked that software infringement was "a serious issue, and deserves to be nipped in the bud". The Court granted the Plaintiffs an ad interim ex-parte injunction, restraining the Defendants from

using, reproducing and distributing any pirated or unlicensed or unauthorized software programs owned by the Plaintiffs and also from formatting their computer systems and/or erasing any data, in relation to assisting others to infringe the Plaintiffs' copyright.

*Citation: Dassault System Solidworks Corporation & Anr. vs. Spartan Engineering Industries Pvt. Ltd. Anr., decided by the Delhi High, on 28th January, 2021, available at <https://indiankanoon.org/doc/21554764/>*

#### **4. Mr. John Hart Jr. & Anr. vs. Mr. Mukul Deora & Ors.**

In this case, Plaintiff No. 1 claimed to be vested with the exclusive copyright to make a movie adaptation of the book "The White Tiger" authored by Mr. Aravind Adiga by virtue of a Literary Option/Purchase Agreement dated 4th March, 2009. Plaintiff no.1 and Plaintiff no.2 ("Plaintiffs") approached the Court at the eleventh hour to seek an injunction restricting the release of the film "The White Tiger" ('Film') produced by Defendant No. 1 to be released on the streaming platform, Netflix. The Plaintiffs assert that when it came to their knowledge that Netflix was in the process of making and releasing the film, a cease-and-desist notice dated 4th October, 2019, was sent by Plaintiff No. 2 to Defendant No. 1. Further, the Plaintiffs stated that allowing the release of the film would result in irreparable injury, as the Plaintiffs planned to release the film in Hollywood. The Plaintiffs also attempted to justify the delay in approaching the Court by stating that the delay was unavoidable as the Plaintiffs were unaware of the fact that Defendants were shooting the film during the Covid-19 pandemic.

The Court opined that no case existed for grant of any interlocutory injunction and the case constituted a misuse of the judicial process. The Court held that, "The Plaintiffs were aware of the possibility of the film being released on the Netflix platform at least from 4th October, 2019. There is not a scintilla of material produced on record to justify the Plaintiffs approaching this Court less than 24 hours prior to the release of the subject film, seeking stay thereof."



The Court relied on several precedents to elucidate that a Plaintiff who approached the Court at the eleventh hour, seeking an interlocutory injunction against the release of a cinematographic film, was disentitled to any such relief. A delay in approaching the Court for equitable relief was always fatal.

The Delhi High Court held that the balance of convenience favoured the Defendants and by granting an injunction at the eleventh hour, greater irreparable loss and injury would be caused. The Plaintiffs were disentitled from seeking any interlocutory injunction against the release of the film on the ground of unconscionable delay in approaching the Court. The Court nevertheless directed the Defendants to keep detailed accounts of the earnings made from the film, so that, if the Plaintiffs were to succeed in the future, the account details would facilitate awarding damages or monetary compensation.

*Citation: Mr. John Hart Jr. & Anr. vs. Mr. Mukul Deora & Ors, decided by the Delhi High Court, on 21st January 2021, available at <https://indiankanoon.org/doc/155648023/>*

### **5. Aman Chhabra and Ors. vs. Trac Entertainment Pvt Ltd and Ors.**

In this case, the copyright of two music videos, “Pyar Ko Na Kaho” and “Lutti Heer,” were involved, where the Appellant contested the order of the Single Judge vacating an interlocutory consent order restraining the Respondents from commercially exploiting the songs. On appeal, the Division Bench reversed the order of the Single Judge stating that time ought to be given to the Appellants to contest the interim application filed by the Respondents to vacate the interlocutory consent order. This was required as several facts that formed the basis for vacation were disputable and should have been considered by the Single Judge. The Division Bench also pointed out that as the attempts by the Respondents to commercially exploit the songs yielded no financial returns, and that the songs could be taken down from the platform, Believe International, at any time, no third party rights had been created, and therefore,



the interlocutory consent order may be in force until the Single Judge decides that matter after hearing the parties.

*Citation: Aman Chhabra and Ors vs. Trac Entertainment Pvt Ltd and Ors., decided by the Bombay High Court on 3rd July, 2021, available at: <https://indiankanoon.org/doc/111847206/>*

#### **6. Sun TV Network Limited vs Iquest Enterprises Private Ltd and Anr.**

In this case, the primary question before the Madras High Court was with respect to ownership of satellite rights pertaining to the Telugu film, Pelli Koduku. Like many other films of the nineties, the agreements with respect to transfer of rights with respect to this film were not worded very clearly, and copyright terms were not always clearly expressed. Also, many of these films were the subject of multiple transfers, which in this case included at least five. Owing to ambiguity of rights, duplicity of right transfers was common, and in this case, the Plaintiff prayed for a declaration of copyright ownership over satellite rights.

After reviewing the first transfer agreement, the Court came to the conclusion that the initial transfer included satellite rights also. Based on the conclusion, the Court stated that the subsequent transfer to the Plaintiff was not valid. As the transfer/assignment was not valid, the Court concluded that the Plaintiff did not hold the satellite rights asserted and was not entitled to a permanent injunction restraining the defendant from telecasting the film.

*Citation: Sun TV Network Limited vs Iquest Enterprises Private Ltd and Anr., decided by the Madras High Court on 14th July, 2021, available at: <https://indiankanoon.org/doc/92332286/>*

#### **7. Muthoot Finance Limited vs. Shalini Kalra and Ors.**

In this case, the Plaintiff, Muthoot Finance Limited, a non-banking financial institution, provided business and personal loans against the deposit of gold jewellery. As a part of this business the Plaintiff had to maintain proprietary and

confidential information related to its vast customer base in the form of a database which in turn constituted a 'literary work' as under Section 2(o) of the Copyright Act, 1957 and it also amounted to trade secrets of Plaintiff which ought not be disclosed to any third party. The Defendants no. 1 to 4 were the former employees of the Plaintiff. At the time of joining the employment, each of them had duly signed the non-disclosure undertaking as provided in the appointment letter along with a Declaration of fidelity. The main allegation in the plaint was that the Defendant No. 1 & 4, during the course of their employment, had unauthorizedly and illegally downloaded, extracted, copied and later on transmitted the confidential information of the Plaintiff's customers to Defendant No 2 & 3 along with employees of Defendant No.5, a company engaged in similar services as that of the Plaintiff. Thus, the Plaintiff's customer base started drifting towards the Defendant No.5. Eventually Defendant 1 & 3 on being terminated by the Plaintiff, in turn joined the employment under Defendant 5. Aggrieved by this, the Plaintiff filed a criminal complaint against Defendant No. 1 to 5 with the Joint Commissioner of Police, Crime Branch, New Delhi. However, there were similar instances of disclosure of confidential information at various other branches of the Plaintiff which in turn resulted in a loss of around 9 crore rupees to the Plaintiff. Thus, the Plaintiff again lodged an FIR at the Special Offences and Cyber Crime division under the relevant sections of IPC and IT Act. The plaint also averred that Defendant No.5 was poaching the Plaintiff's employees and customers with the aid of the information illegally obtained by the Defendants.

Hence, the Plaintiff moved this Court seeking a decree of permanent injunction thereby restraining the Defendants and any other person acting on behalf of/through them from using/disclosing any confidential information pertaining to the Plaintiff, using/infringing any copyright or other IP rights belonging to the Plaintiff, from directly or indirectly luring/canvassing any of the Plaintiff's customers, inducing any of the Plaintiff's employees to quit employment or provoke them to join the Defendant No.5 or any of its businesses, and to give up all the said confidential information/trade secrets in hand.

The Plaintiff also sought damages of Rs.2,00,01,000/- payable to the Plaintiff jointly and severally by Defendants 1 to 5 together with an interest of 18% p.a. till the date of payment. The Court issued summons to the Defendants and gave them an opportunity to file a written statement (if any). Pertaining to the IA filed by the Plaintiff, the Court ordered an interim injunction restraining the Defendants from disclosing or using any confidential information, trade secrets or any other information, pertaining to the business and operations of the Plaintiff Company, and from using proprietary content of any nature, including copyright and other intellectual property rights of the Plaintiff Company or doing any acts or deeds that would infringe/dilute the Plaintiff Company's intellectual property rights.

*Citation: Muthoot Finance Limited vs. Shalini Kalra & Ors., decided by the Delhi High Court on 13th September, 2021, available at: <https://indiankanoon.org/doc/22108976/>*

#### **8. Progress Software Solutions India Private Limited vs. Dcit 13(1)(2)**

In this case, the Appellant (Assessee) was a resident company involved in the business of trading and sale of software license and development of computer software. For the assessment year 2009-10, the Assessee filed the return of income declaring Rs.89,29,099/- as loss. But originally the assessment was completed later on in 2011, which was computed after making few disallowances as u/s 143(3) of the Act. On an appeal against this assessment order to the learned Commissioner (Appeals), partial relief was granted, by deleting one of the disallowances. Still being aggrieved by the same additions repeated once again in the fresh assessment, the Assessee again approached the Tribunal.

With regard to the disallowance of Rs.23,50,466/-, the Assessee put forth the contention that by merely being a distributor, the payment so made to Savvion, USA (a non- resident company) for the purchase of a copyrighted article for the

purpose of reselling was not in the nature of royalty under either U/A 12 of Indo-USA tax treaty or u/s 9(1)(vi) of the Act, and therefore tax deducted at source as u/s 195 of the Act was not required. Thus, the Court analysed whether a copyrighted article was genuinely purchased for the purpose of resale/distribution or internal use, or according to the convenience and own will of the Assessee. After verifying the reseller agreement, the Court concluded that the license granted therein was not for the purpose of any internal use. The Court found that the agreement also restricted the reseller/any other third party from translating, modifying, extending, de-assembling or reversing the said copyrighted software program. The reseller too acknowledged and agreed that on occasion of any unauthorized use/disclosure/copying of the software program, it would be liable for remedies and consequential actions from Savvion, USA. Citing a few judicial pronouncements of the Hon'ble SC, it was averred that when a non-transferable and non-exclusive license to resell a copyrighted article without actually transferring the copyright in the said article was provided to the ultimate end-user/distributor, then there was no additional right granted to sub-license/transfer/reverse/reproduce/modify anything, other than that allowed by virtue of the license given to the ultimate user. It was agreed by the Tribunal that payment made for the purchase of copyrighted articles for the purpose of distribution was not in the nature of royalty and hence the grounds were allowed and thus the concerned disallowance was thereby deleted.

*Citation: Progress Software Solutions India Private Limited vs. Dcit 13(1)(2), Mumbai, decided by the Income Tax Appellate Tribunal – Mumbai on 30th August, 2021, available at : <https://indiankanoon.org/doc/177640115/>*

#### **9. Cristina Maiorescu vs. M/s Nishangi Enterprises Pvt. Ltd. and Ors.**

The Plaintiff, a professional photographer, filed a suit against the Defendants seeking direction from the Bangalore District Court for payment of a sum of Rs.1,56,025/- towards an invoice for services provided by her, with interest at the rate of 12% per annum.

The Plaintiff had entered into an agreement with the Defendants for providing photography services with respect to products to be sold by the Defendant No. 1, a company operating a chain of eateries/beverage stations under the name and style 'Frootality' in Hyderabad and Bangalore. As per the agreement, a sum of Rs.2,23,000/- was to be paid by the Defendants to the Plaintiff, who had to provide 62 photographs in two phases. Further, in pursuance of the agreement, the Defendant No. 1 paid a sum of Rs.1,00,000/- to the Plaintiff as advance.

It was alleged by the Plaintiff that after completion of her assignment, she raised an invoice and Defendants neither raised any objections regarding the completion of the assignment nor made the payment. It was also the case of the Plaintiff that the Defendants No. 1 and 2 utilized various services of the Plaintiff outside the scope of photography assignment and she also permitted the Defendant No. 3 to reside with her. The Plaintiff alleged that she incurred an expense to the tune of Rs. 3,85,000/- in fulfilling these and that the Defendants blatantly violated her intellectual property rights.

The Court held that owing to the facts and circumstances of the case, the burden was on the Plaintiff to prove that she provided photography services to the Defendant and that the Defendants were liable to pay damages and compensation for the additional services rendered by the Plaintiff and for unlawful use of photographs clicked by her. The Plaintiff placed on record evidence which included a copy of email communications between Plaintiff and Defendants, a copy of the invoice, a C.D. containing photographs, screenshots of websites of the Defendants, and a copy of the notice. The Court, after examining the evidence, concluded that the Plaintiff successfully established that she provided the services to the Defendant, who agreed to pay the amount that was claimed by her and the interest amount was also held to be appropriate. However, with regards to the additional services and unlawful use of photographs, except the issuance of notice no other evidence was available.

The Court held that in absence of any cogent material, Plaintiff was not entitled for damages and compensation as claimed in the plaint.

*Citation: Cristina Maiorescu vs. M/S Nishangi Enterprises Pvt. Ltd, decided by the Bangalore District Court on 24th September, 2021, available at:*

<https://indiankanoon.org/doc/139516246/>

#### **10. Saregama India Limited vs. Next Radio Limited and Ors.**

The Apex Court, in the instant case, set aside an interim order passed by the Madras High Court, which held that copyrighted material could not be broadcasted without prior notice as per Rule 29(4) of the Copyright Rules, 2013. The High Court had modified specific provisions of the Rule and applied it to the broadcasters, finding that the Rule lacked flexibility and created difficulties for the broadcasters. The mandate to furnish the particulars in the notice was revised to fifteen days as against 24 hours. Moreover, the Madras High Court rendered the second proviso under the Rule regarding prior notice as a mere routine procedure instead of an exception loosening the grips on broadcasters. The Petitioner pointed out that this modification would be applicable pan-India and create disparity regarding the Rule. Various landmark cases were relied on by the Petitioner in establishing the settled principle of law, which prohibited the judiciary from modifying or rewriting the words in a statute while interpreting the law. While setting aside the interim order, the Supreme Court opined that the Courts were not empowered to revise or rewrite the provisions of a statute by way of judicial review. Emphasis was laid on the fact that the powers to make and rewrite laws vested with the Legislature. The Court did not deliberate on the merits of the respondent's submission concerning the validity of Rule 29(4).

*Citation: Saregama India Limited vs. Next Radio Limited & Ors., decided by the Supreme Court on 27th September, 2021, available at:*

<https://indiankanoon.org/doc/11609677/>

### 11. Narendra Hirawat And Co. vs. Aftab Music Industries & Anr.

Plaintiff Narendra Hirawat and Co. filed a suit against the Defendants for violating consent terms and breaching film rights accorded to the Plaintiffs. The Plaintiffs claimed that despite the existence of an agreement which granted the Plaintiffs perpetual rights over certain movies produced by the Defendants, the latter uploaded it on their YouTube Channel. The Plaintiffs argued that the Defendants accepted the Plaintiffs' right over the film in perpetuity by relying on the Consent Terms mentioned in a suit filed in 2012. The Defendants countered this by alleging that they had only granted 'Internet Rights' and not 'YouTube Rights' to the Plaintiffs. However, the High Court of Bombay rendered the Defendants' arguments 'nonsensical' by holding that 'YouTube Rights' fall within the ambit of 'Internet Rights' and the two cannot be dealt with separately. The Court added that YouTube could not function without the existence of the Internet, thus denying the standalone 'YouTube Rights' claimed by the Defendants.

The Court ordered the Defendants to stop infringing the rights accorded to the Plaintiffs, and to cease storing or making copies of the films on any platform. The Court explicitly forbade the Defendants from representing their non-existent right over the films to any third party. Although the Court opined that exemplary and punitive costs were to be imposed along with issuing a contempt notice to the Defendants for having intentionally breached the agreement, no such imposition or issuance of notice was ordered. The Court denied the Defendants their right to reply by stating that the Defendants were dishonest and failed to adhere to the commitments made to the Court.

*Citation: Narendra Hirawat and Co. vs. Aftab Music Industries & Anr., decided by the Bombay High Court on 28th September, 2021, available at [https://www.livelaw.in/pdf\\_upload/narendra-hirawat-co-v-aftab-music-industries-anr-401683.pdf](https://www.livelaw.in/pdf_upload/narendra-hirawat-co-v-aftab-music-industries-anr-401683.pdf)*



**12. M/s. Sun T.V. Network Ltd. vs. M/s. Shree CMR Productions and Anr.**

The Plaintiff filed a suit seeking a declaration that it was the exclusive copyright holder of a Kannada film “ADDHURI”, along with a permanent injunction against the Defendant No. 2. The Defendant No. 1 assigned the copyrights in the film to Plaintiff perpetually, and consequently the Plaintiff became the absolute copyright owner of the said film, and could broadcast it without geographical area restrictions. On 02.03.2016, Defendant No. 2 telecast the songs from the said movie without permission or licence from the Plaintiff.

The Court examined Censor Certificate, the copyright assignment deed, and the supplementary agreement. The Court found that the assignment agreements showed that the Plaintiff was the exclusive copyright holder. The Court held that by telecasting the songs on 02.03.2016, Defendant No. 2 infringed the Plaintiff’s copyright, as it was done without obtaining any permission or licence from Plaintiff, and thus granted the injunction sought by the Plaintiff.

*Citation: M/S. Sun TV Network Ltd vs. M/S. Shree Cmr Productions and Anr., decided by the Madras High Court, on 7th September, 2021, available at <https://indiankanoon.org/doc/64307124/>*

**13. M/s. Sun TV Network Ltd. vs. M/s. Nitin Productions & Anr.**

Defendant Nitin Productions assigned the copyright of the film “HUDUGAATA” in favour of the Plaintiff after receipt of the agreed consideration. By virtue of the agreement, the Plaintiff became the absolute copyright owner of the aforementioned film which included satellite rights, radio rights and other similar rights perpetually. However, Defendant M/s. Public TV, telecasted songs from the film without obtaining prior permission. The Plaintiff, which held the copyright of both digital and negative format of the film, alleged that the Defendant had illicitly telecasted the songs of the film by making use of pirated CDs. After perusing the exhibits submitted, the High Court of Madras found a valid agreement and also found that the Defendant made use of pirated CDs.



In an ex-parte hearing, the Court declared that the Plaintiff was the exclusive copyright holder of the film and granted a permanent injunction against the Defendants, as they had no right to telecast the film or any part thereof.

*Citation: M/s. Sun TV Network Ltd. vs. M/s. Nitin Productions & Anr., decided by the Madras High Court on 7th September, 2021, available at <https://indiankanoon.org/doc/167369065/>*

#### **14. M/s. Sun TV Network Ltd. vs. Mr. B.V. Ravindranath & Anr.**

The producers assigned the copyright over the Kannada film 'JEEVA' to the Defendant Mr. B.V. Ravindranath, who in turn assigned the same in favour of the Plaintiff. By virtue of the agreement, the Plaintiff became the absolute copyright owner of the aforementioned film which included broadcasting via satellite, radio and other similar platforms perpetually. However, the Defendant M/s. Public TV, telecasted a song from the film without obtaining prior permission from the Plaintiff. The Plaintiff alleged that the Defendant had illicitly telecast songs of the film using pirated copies. The High Court of Madras inspected the exhibits put forth by the Plaintiff which included the assignment agreement and pirated CD of the film. The Court found that the assignment agreement was valid, and also found the Defendant to have made use of pirated copies of the film. In the ex-parte hearing, the Court declared that the Plaintiff was the exclusive copyright holder of the film and granted permanent injunction against the Defendants, prohibiting them from telecasting the film or any part of it on their channel.

*Citation: M/s. Sun TV Network Ltd. vs. Mr. B.V. Ravindranath & Anr., decided by the Madras High Court on 7th September, 2021, available at <https://indiankanoon.org/doc/197298793/>*

**15. M/s Sun TV Network Ltd. vs. Mr. P. Ramesh and Anr.**

The producer of the film, M/s Megha Movies, assigned the entire copyrights for a Kannada film in favour of Defendant No. 1 (P. Ramesh) on October 11th, 2012, who in turn passed on the copyrights permanently to the Plaintiff after 19 days. Thus, the Plaintiff became the absolute owner of copyright for the Kannada film titled "EDEGARIKE" to broadcast it through any satellite system, broadcasting service, mode of transmission. or any form of communication. Defendant No. 2, M/s Public TV, telecasts songs from the film in March 2016. The Plaintiff argued that it was the exclusive copyright holder for negatives and digital format of the movie, and that Defendant No. 2 was not allowed to exploit the film partially or fully without paying licensing fee or seeking permission. The relief of declaration was granted by the Madras High Court because the assignment deed in favour of the Defendant No. 1 from the first owner (producer) and further assignment towards the Plaintiff by the 1st Defendant showed that the Plaintiff had full copyrights for the film. Defendant No. 2 also did not approach the Court to justify release of the pirated version of the song made on CD through television without the permission of the copyright holder (Plaintiff), thus relief of permanent injunction (ex-parte order) was granted by the Court in favour of the Plaintiff.

*Citation: M/s Sun TV Network Ltd. vs. Mr. P. Ramesh and Anr., decided by the Madras High Court on 7th September, 2021, available at <https://indiankanoon.org/doc/159185632/>*

**16. Mr. S. Vijayaraghavan and Anr. vs. Mrs. Sellappappa Keeran**

The Plaintiff, Mrs. Sellappappa Keeran, wife of late Pulavar Keeran, a famous religious Hindu preacher and historian, sought a declaration from the Madras High Court that she was the rightful owner of the copyright of her husband's works. She also filed for an injunction against the Defendants, asking them to surrender all master tapes containing original recordings of the speeches, lectures and discourses and in any other form like cassettes or CDs.



Pulavar Keeran had met Defendant No. 1, S. Vijayaraghavan, who was the proprietor of Vani Recording Co., a small audio cassette shop in 1987, and decided to record his concerts in the form of 38 cassettes between 1987 and 1990 and sell them so they could be listened to at people's convenience. He allowed Defendant No. 1 to promote the cassettes in exchange for incurring the expenses involved in making the recordings. Defendant No. 1 also sold certain cassettes through a dealer, along with a temporary mutually beneficial agreement based on the market and the number of copies sold.

The Plaintiff claimed that her husband did permit any further reproduction after a formal agreement laying down the profit-sharing ratio was in place. He did not part with the copyright, and was not paid by Defendant No. 1 for his recordings. He suffered a brain hemorrhage in 1990, so he only completed recording 12 of his works. The Plaintiff entrusted the master tapes with Defendant No. 1 based on his assurance that he would keep it safe and maintain them well in his shop, but intended to retain the copyright of her husband's works. S. Vijayaraghavan commercially exploited the recorded works, against the Plaintiff's wishes, while she was abroad. The Plaintiff's counsel stated that as per Section 2(d) and Section 17 of the Copyright Act, 1957, the Plaintiff would be the rightful copyright owner as she was a legal heir, and Defendant No. 1 did not assist in the capacity of a producer.

The counsel for the Defendants claimed that the sound recordings were the work of a producer, which in this case was Defendant No. 1. They also claimed that the present suit was filed back in 2004, and was thus barred by limitation as it was 13 years after the preacher's death in 1990. The Court stated that this argument did not hold water, because the copyright was valid till 1/1/1991, i.e. 60 years from the beginning of the next calendar year after the death of Pulavar Keeran. The Court analysed Section 2(d), 13, 17 of the Copyright Act, 1957 and Section 2 of the Berne Convention. The Court held that the copyright holder would be the Plaintiff, and granted a permanent injunction against the Defendants, restraining them from using, selling, distributing, broadcasting as a whole or exploiting the literary works in isolation (transcript of speeches) through any media.

*Citation: Mr. S. Vijayaraghavan and Anr. v. Mrs. Sellappappa Keeran, decided by the Madras High Court on 12th April, 2011, available at <https://indiankanoon.org/doc/1932971/>*

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