

# INDIA

## Intellectual Property Litigation Report

2004

### CONTENTS

#### PATENTS

- Name of firm not determinative of its status  
*Zuko Engineers v Ministry of Commerce & Industries*

#### DESIGNS

- Infringement of Mitsubishi pen design restrained  
*Mitsubishi Pencil Co. Ltd. v Flair Pen*

#### TRADEMARKS

- Action for Infringement and Passing off does not lie only against the manufacturer but also against any party involved in the infringement chain  
*Lalli Enterprises v Dharam Chand & Sons*
- Aftek Infosys and Jupiter Infosys restrained from using the Trademark/Trade name 'INFOSYS'  
*Infosys Technologies Ltd. v Aftek Infosys Ltd. & Jupiter Infosys Ltd.*
- Allegations of Misrepresentation and Passing Off of the Cricket World Cup Trademarks dismissed  
*ICC Development (International) Ltd. v Arvee Enterprises & Others*
- Amendment is a discretionary matter  
*Time Warner Entertainment Company v A K Das*
- Bharat Business Channel restrained from using the abbreviation BBC  
*British Broadcasting Corporation v Bharat Business Channel*

- Counterfeiting of Cartier products restrained  
*Cartier International B.V v Choosy corner*
- Deception/confusing similarity not found in use of 'BLACK LABEL' on beer products  
*United Breweries Ltd. v Khoday's Brewing and Distilling Industries Ltd.*
- Drug trademark 'PLAGON BOLUS' found deceptively similar to Wockhardt's 'ANALGON'.  
*Wockhardt limited v Patiala Medical Agencies*
- Infringing use of the 'DUNHILL' trademark/trade name restrained  
*Alfred Dunhill Ltd. v Dunhill Securities Ltd.*
- Injunction by *quia timet* action appropriate and essential to prevent future harm  
*Mars Incorporated v Kumar Krishna Mukherjee*
- Mere incorporation of famous trademark/tradename in a company name does not create any right  
*Pizza Hut International LLC., Pizza Hut Inc. and Tricon Restaurants (India) Pvt. Ltd. v Pizza Hut India Pvt. Ltd.*
- Misuse of logo, title and other copyright elements of television serial in domain name and website restrained  
*Celador Productions Ltd. v Gaurav Mehrotra*
- No monopoly over words that are *publici juris*  
*USV Limited v Systopic Laboratories Ltd.*



BANGALORE 560 001  
TELEFAX: 91(80)22215380  
MADRAS 600 034  
TELEFAX: 91(44)28257258  
NEW DELHI 110 048  
TELEFAX: 91(11)26232664

### D. P. AHUJA & Co.

PATENT & TRADEMARK ATTORNEYS

Members:

D.P. AHUJA (1924-1996)

S. D. AHUJA, S. CHAKRABORTY, S. R. GUPTA  
K. M. RAO, R. BARMA, R. SIRCAR, A. K. CHATTERJEE,  
M. ISLAM, S. MUKHERJEE, I. S. BHATTACHARYA  
S. GHOSH, S. K. GUE, J. V. RAGHAVAN, S. MANI  
V. J. SINGH, D. K. CHAUDHRY, S. CHOWDHURY  
S. S. DATTA, P. PRASAD, M. MAHARAJ, V. HARAN  
P. BOSE, J. MUKHERJEE, S. JOSEPH, S. BANERJEE  
R. HARIHARAN, T. CHOWDHURY

Head Office

53 SYED AMIR ALI AVENUE  
CALCUTTA 700 019 INDIA

Telephone:

91 (33)22819195; 91(33)22808059

Telefax:

91 (33)24757524; 91 (33)22819444  
91 (33)22814782; 91 (33)22819441  
91 (33)24541490; 91 (33)22485229

Email:

patents@dpahuja.com  
trademarks@dpahuja.com  
info@dpahuja.com

Website:

www.dpahuja.com

- Not allowing parties to establish rival claims by leading evidence is disregard of legal procedure  
*J K Goe v Grow-On Marketing Ltd.*
  - 'NOVERAN' found infringing 'VOVERON'  
*Novartis AG v Ishwar Lal Jain*
  - Order granting registration and subsequent cancellation of trademark, found in contravention of law  
*DCW Home Products Ltd. v Deputy Registrar of Trademarks*
  - Passing off of CASTROL and INDROL marks and original labels restrained  
*Castrol Ltd. v Auto Link Sales Corporation*
  - PHILIPS tradename protected  
*Philips India Ltd. v Philips Infotech Ltd.*
  - Phonetic and visually similar mark found infringing  
*Frito Lay India v Shivdeep Food Products Pvt. Ltd.*
  - Phonetically similar word found deceptive  
*Chanel Ltd. v Sunder Chemicals Agarbati Works (P) Ltd.*
  - 'PLAYBOY' trademark and 'rabbit head' logo are protected by transborder reputation  
*Playboy Enterprises International Inc. v Advance Cosmetic and Research Centre*
  - *Prima facie* case essential for grant of injunction  
*Heineken Brouwerijen B V. v Som Distilleries & Breweries*
  - Prior use of similar trademark does not necessarily create balance of convenience  
*East African (I) Remedies Pvt. Ltd. v Wallace Pharmaceuticals Ltd.*
  - Proprietary right in a geographical trademark/name cannot be claimed after transfer of property  
*Bloomfield Tea Co. Ltd. v Bagaria Business (P) Ltd.*
  - Rectification for non-use of trademark is erroneous when special circumstances exist  
*Hardie Trading Ltd. v Addisons Paint and Chemicals Ltd.*
  - Reputation in 'MAC' trademark not established  
*McDonald's Corporation v MacGilz Fast Food*
  - SmithKline Beecham seeks permanent injunction against infringement of trademark and copyright  
*Smith Kline Beecham Plc. v Lalitbhai Patel*
  - Stray adoption of internationally famous invented word does not give legal right  
*Honda Motor Co. Ltd. v Mr. Charanjit Singh & Ors*
  - The addition of a geographical suffix does not sufficiently alter the underlying mark to which it is added to create a right  
*Honda Motor Company Limited v Lokita Enterprise*
  - Trademark/name having transborder reputation is protected against trademark infringement in India  
*Yahoo Inc. v Sarda Trading Company*
  - Trademark Office directed to call for search report for pharmaceutical trademarks  
*Bio-chem Pharmaceutical Industries v Astron Pharmaceuticals*
  - Use of 'Kohinoor' as a trademark permissible  
*Sant Ram & Co. v Satnam Overseas*
  - Use of domain name similar to trademark considered to be infringement  
*Red Bull GmbH v Bayer Shipping & Trading Ltd.*
- ## COPYRIGHTS
- Delay in bringing action for copyright infringement is not sufficient to defeat grant of injunction  
*Midas Hygiene Industries Pvt. Ltd. v Sudhir Bhatia*
  - Delhi High Court rules against infringement of copyright in logo  
*Fenner (India) Limited v Farms and Farms (India) Ltd.*
  - Godrej & Boyce restrained from infringement of copyright in design  
*N Rangaswamy v Godrej & Boyce Manufacturing Co. Ltd.*  
*Godrej & Boyce v N Rangaswamy*  
*Godrej & Boyce Manufacturing Co. Ltd. v N Rangaswamy*
  - Idea cannot have a copyright  
*Star India Pvt. Ltd. v Leo Burnett (India) Pvt. Ltd.*
  - Logo is an artistic work protected by the Copyright Act  
*ICC Development International v Ever Green Service Station*
  - Publication of copyrighted work in breach of agreement restrained  
*The Chancellor Masters & Scholars of the University of Oxford v Orient Longman Pvt. Ltd.*
  - Zee TV restrained from airing serial in violation of copyright  
*Sundial Communications v Zee TV*

## PATENTS

### Name of firm not determinative of its status

*[Renewal of Patent – Writ of mandamus – Fee for individual – Sole proprietor – Petition disposed]*

#### ***Zuko Engineers v Ministry of Commerce & Industry***

*Delhi High Court (July 24, 2002)*

The Petitioner, **Zuko Engineers**, sought a writ of mandamus directing the defendant to accept the renewal fee for renewal of patent in the category of individual, as he is the sole proprietor of the concern. The defendant countered that since the name of the patentee is Zuko Engineers, the fee has to be paid for legal entity other than individual. **The Honorable Court held the defendant's view as erroneous as the name of a concern cannot be determinative of whether the concern is a proprietorship or a partnership firm and hence, directed the defendant to charge the fee from the petitioner for the renewal of patent that is applicable to individual.**

## DESIGNS

### Infringement of Mitsubishi pen design restrained

*[Similar Design – Likelihood of confusion – Injunction granted]*

#### ***Mitsubishi Pencil Co. Ltd. v Flair Pen***

*Delhi High Court (January 2003)*

Petitioners, **Mitsubishi Pencil Co. Ltd.**, and its sole distributor Linc Pen & Plastic Ltd. filed a suit against **Flair Pens** for infringement and passing off of Mitsubishi's design of the model 'UniBall Vision Elite'. **The Honorable Court granted an *ex parte* interim injunction and held that similarities in design created likelihood of confusion and deception among the customers as to the source and origin of the Flair pens.**

## TRADEMARKS

### Action for Infringement and Passing off does not lie only against the manufacturer but also against any party involved in the infringement chain

*[Infringement – Passing off action – Not necessary to produce cash memos of clandestine sales]*

#### ***Lalli Enterprises v Dharam Chand & Sons***

*Delhi High Court (September 22, 2002)*

Plaintiff, **Lalli Enterprise** filed a suit for infringement of copyright and passing off against the defendant, Dharam Chand & Sons. The learned Single Judge dismissed the suit without issuing summons to the defendant on the ground that the suit is against the manufacturer of the infringed article and the defendant is not the manufacturer, there were no cash memos of sale and therefore, the court did not have territorial jurisdiction in the matter. The Plaintiff, filed an appeal against the said order. **The Honourable Delhi High Court, set aside the impugned order and held that, it is incorrect that an infringement action lies only against the manufacturer of the goods; it can lie with any party involved in the infringement chain. Secondly, production of cash memos is not necessary as clandestine sales are often without cash memos and summons are to be issued to the defendant at this stage as the averments in the plaint are to be seen and evidence is required to be led to determine territorial jurisdiction.**

## **Aftek Infosys and Jupiter Infosys restrained from using the Trademark/Trade name 'INFOSYS'**

*[Trademark/tradename INFOSYS v JUPITER INFOSYS and AFTEK INFOSYS – Unauthorised use of trademark – Passing off – Damage to reputation and goodwill – Interim injunction granted]*

### ***Infosys Technologies Ltd. v Aftek Infosys Ltd. and Jupiter Infosys Ltd.***

*Delhi High Court (December, 2002)*

Petitioner, **Infosys Technologies Ltd.**, sought injunctive relief against Defendants, **Aftek Infosys Ltd.** and **Jupiter Infosys Ltd.**, for unauthorised use and passing off of the trademark/trade name 'Infosys'. Both the Defendants and the Plaintiff are in the same line of business, hence it was alleged that there was likelihood of confusion and deception leading to damage of reputation and goodwill of the Plaintiff. **The Honorable Court passed an interim order restraining the Defendants from using the 'INFOSYS' trademark and passing off the trade name as well.**

## **Allegations of Misrepresentation and Passing Off of the Cricket World Cup trademarks dismissed**

*[World Cup Trademarks – Suit for Temporary injunction – Passing off – Absence of prima facie case – Application dismissed]*

### ***ICC Development (International) Ltd. v Arvee Enterprises & Others***

*Delhi High Court (January 2003)*

Plaintiff, **ICC Development International Ltd.**, filed a suit for temporary injunction restraining defendants, **Arvee Enterprises & Ors.** from publishing any advertisement associating themselves with the plaintiff in any manner whatsoever. The defendants countered that the word 'World Cup', is a generic word and is not protected by any international treaty or domestic law. **The Honourable Court held that the plaintiff had failed to make out a prima facie case for grant of an ad interim injunction and dismissed the application.**

## **Amendment is a discretionary matter**

*[Trademark HBO – Amendment of plaint – No change in nature of suit – Amendments allowed when necessary]*

### ***Time Warner Entertainment Company v A K Das***

*Delhi High Court (December 20, 2002)*

The Plaintiff, **Time Warner Entertainment** filed for an amendment in their plaint on the ground that the HBO channel was not available on cable television in India at the time of filing of the infringement and passing off suit. **The Honourable Court allowed the application and held that amendment is a discretionary matter and should be allowed when necessary for the purpose of determining the real questions in a controversy. It would not cause any prejudice to the defendants in this case as it does not change the nature of the suit.**

## **Bharat Business Channel restrained from using the abbreviation BBC**

*[Trademark BBC – Identical abbreviation – Deliberate attempt to damage reputation and goodwill – Prima facie case]*

### ***British Broadcasting Corporation v Bharat Business Channel***

*Delhi High Court (February 2003)*

Petitioner, **British Broadcasting Corporation** filed a suit to restrain **Bharat Business Channel** from using its abbreviation and registered trademark 'BBC'. The plaintiff contended that the adoption of the identical abbreviation was a deliberate attempt by the defendant to tread upon the reputation and goodwill of the BBC. **The Honourable court ruled ex parte, restraining the Bharat Business Channel from using the trademark BBC.**

## Counterfeiting of Cartier products restrained

[Trademark CARTIER – Registered Trademark – Infringement – Passing off – Permanent injunction]

### *Cartier International B.V. v Choosy Corner*

Delhi High Court (September 5, 2002)

Plaintiff, **Cartier International**, proprietors of the registered trademark CARTIER, filed a criminal complaint and a suit for permanent injunction against defendant, **Choosy Corner** to restrain manufacture and sale of counterfeit goods under the ‘CARTIER’ trademark. **Granting an ex parte decree of permanent injunction in favour of the plaintiff, the Honourable Court, permanently restrained the defendants from manufacturing and selling goods with the trademark ‘Cartier’ and from using the ‘Cartier’ logo in any manner that could infringe the trademark or copyright of the plaintiff.**

## Deception/confusing similarity not found in use of 'BLACK LABEL' on beer products

[Tradename BLACK LABEL – Suit for interim injunction – Passing off action – Difference in label – Application denied]

### *United Breweries Ltd. v Khodays Brewing and Distilling Industries Ltd.*

Karnataka High Court (January 21, 2002)

Plaintiff, **United Breweries Limited**, filed a suit against defendants, **Khodays** claiming trademark infringement and passing off. Contrary to the allegation of the plaintiff, it was proved that only the name “Black Label” is registered and is distinctly mentioned only on the product that it is sold in West Bengal, under the name “Kalyani Black Label”; whereas it was clear from the documents produced by the defendant, that they are manufacturing and selling beer under the brand “Hercules Black Label Super Strong Beer” and the word “Hercules” is registered. **The Honourable Court held that the Trial Court had correctly rejected the application for injunction as on comparison of the two labels it is clear that they cannot be said to be deceptive nor cause any confusion in the minds of the consumers.**

## Drug trademark 'PLAGON BOLUS' found deceptively similar to Wockhardt's 'ANALGON'

[Trademark PLAGON BOLUS v ANALGON – Permanent injunction – Infringement action – Deceptive similarity – Injunction granted]

### *Wockhardt Limited v Patiala Medical Agencies*

Delhi High Court (January 24, 2003)

Plaintiff, **Wockhardt Ltd.**, filed a suit seeking permanent injunction against **Patiala Medical Agencies** on the ground of deceptive similarity in trademarks. **The Honourable High Court granted a permanent injunction restraining the defendants from selling products under the trademark ‘Plagon Bolus’ and packaging similar to Wockhardt’s ‘Analgon’.**

## Infringing use of ‘DUNHILL’ trademark/trade name restrained

[Trademark DUNHILL – Registered trademark – Passing off – Confusion and deception – Damage to reputation – Permanent injunction]

### *Alfred Dunhill Ltd. v Dunhill Securities Ltd.*

Delhi High Court (April 2003)

Plaintiff, **Alfred Dunhill Ltd.** sought a permanent injunction to restrain infringement of the registered trademark ‘DUNHILL’, passing off and rendition of accounts against defendant, **Dunhill Securities**. The plaintiff

contended that DUNHILL was a registered trademark and has a worldwide reputation. The use of the trademark by the defendant had caused immense confusion, deception, loss of reputation and goodwill to the plaintiff. **The Honourable Court passed an injunction restraining the defendants from advertising, dealing in or using the plaintiff's trademark 'Dunhill'.**

## **Injunction by *quia timet* action appropriate and essential to prevent future harm**

*[Trademark MARS – Suit for permanent injunction – Registered Trademark – Injunction by Quia Timet Action]*

### ***Mars Incorporated v Kumar Krishna Mukherjee***

*Delhi High Court (October 30, 2002)*

Plaintiff, **Mars Inc.** filed a suit for permanent injunction against the defendant, **Kumar Krishna Mukherjee** for adopting and thereby, infringing their registered trademark 'MARS' in regard to food products, passing off of goods and resultant loss of goodwill and reputation. **The Honourable Court granted an injunction by \*Quia Timet Action and held that the plaintiff's apprehension that the defendant may start manufacturing in the food sector under the same tradename, is a real and tangible possibility and as they will suffer a greater hardship than the defendant, the misconception of the defendant about the importance of the trademark and trade name has to be erased before they start their business.**

\* **Quia Timet** - It is a Latin word which means "because he fears or apprehends". In legal terminology it has been defined as an action by which a person may obtain an injunction to prevent or restrain some threatened act being done which, if done, would cause him substantial damage and for which money would be no adequate or sufficient remedy.

## **Mere incorporation of famous trademark/tradename in a company name does not create any right**

*[Trademark/Tradename PIZZA HUT – Infringement – Passing off – Transborder reputation – Use – Balance of convenience]*

### ***Pizza Hut International LLC., Pizza Hut Inc. and Tricon Restaurants (India) Pvt. Ltd. v Pizza Hut India Pvt. Ltd.***

*Bombay High Court (July 26, 2002)*

Plaintiffs, **Pizza Hut International, Pizza Hut Inc.** and **Tricon Restaurants** sought injunctive relief against Defendants **Pizza Hut India Pvt. Ltd.** for infringement and passing off of its distinctive and reputed trademark/trade name PIZZA HUT. **Granting the injunction, the Honourable Court held that the defendant was incorporated with the sole intention of trading on the plaintiff's well established and worldwide reputation and their famous mark/logo. Mere incorporation cannot constitute use of the words as a trademark especially as the defendant has no goodwill or reputation in India.**

## **Misuse of logo, title and other copyright elements of television serial in domain name and website restrained**

*[Distinctive logo and symbol – Use of logo on defendant's website – Deceptive similarity – Copyright infringement]*

### ***Celador Productions Ltd. v Gaurav Mehrotra***

*Delhi High Court (January 18, 2002)*

Plaintiff, **Celador Productions Ltd.**, filed a suit for permanent injunction against defendant Gaurav Mehrotra restraining him from running a website using the domain name "*crorepatikaun.com*"<sup>1</sup> with logos, names and identical photographs of the presenter of the plaintiff. **The Honourable Court granted an ex parte injunction restraining the defendant from operating and hosting any website using similar domain name and from**

**offering on line games based on the format and design with the distinctive features of the TV program of the plaintiff, “Kaun Banega Crorepati”<sup>2</sup>.**

1. Literal translation from Hindi "Millionairewho.com".
2. Literal translation from Hindi "Who will become a Millionaire".

## **No monopoly over words that are *publici juris***

[Trademark *PIO v PIOZ* – Interim Injunction – Passing off action – Words not similar – *Publici Juris* – Injunction denied]

### ***USV Limited v Systopic Laboratories Ltd.***

Madras High Court (July 11, 2003)

The Plaintiff, **USV Ltd.**, filed an application for an injunction restraining the defendant, **Systopic Laboratories**, from using the trademark “PIO” in any form and manner. **The Honorable Court refused to grant an injunction and held that, as per the Indian Drug Report, many drugs using the chemical Pioglitazone Hydrochloride as an ingredient for treatment of Diabetes, use the word “PIO”, hence the word is *publici juris*\* and the applicant has no monopoly over it. Moreover, the words, “PIO” and “PIOZ” are phonetically dissimilar and also the cartons are different, hence it cannot be said that the two are identical.**

\* *Publici Juris* - It is a Latin term which means "of public right"

## **Not allowing parties to establish rival claims by leading evidence is disregard of legal procedure**

[Trademark *ENERGIC* – Suit for infringement and passing off – Dismissed by trial court – Parties not allowed to establish rival claims by leading witness – Wrong-legal procedure]

### ***J K Goe v Grow-On Marketing Ltd.***

Delhi High Court (January 20, 2003)

Plaintiff, **J.K. Goe**, had filed a suit for infringement and passing off against the defendant, **Grow-On Marketing**, in the Trial Court **which dismissed the case** for concealment of facts on part of the plaintiff and maintained that “Energic” was not a coined word and was *publici juris*. **The Delhi High Court held that the plaintiff’s suit was disposed off in disregard of legal procedure and in violation of the rights of the parties to establish their rival claims. The impugned judgment therefore becomes unsustainable and is set aside. The suit shall be revived and be dealt with and disposed of under law, afresh.**

## **‘NOVERAN’ found infringing ‘VOVERAN’**

[Trademarks *NOVERAN v VOVERAN* – Infringement – Passing off action – Permanent Injunction]

### ***Novartis AG v Ishwar Lal Jain***

Delhi High Court (October 9, 2002)

Plaintiff, **Novartis AG**, filed a suit against defendant, **Ishwar Lal Jain**, for permanent injunction, restraining the infringement of trademark and copyright and also restraining passing off of the goods by the defendant as that of the plaintiff’s and rendition of accounts and handing over of infringing goods. **The Honourable Court granted perpetual injunction in favour of the plaintiff and held that the defendant has adopted the trademark “Noveran” which is virtually identical to the plaintiff’s registered trademark “Voveran”, and a packaging which is an imitation in terms of get up, lay out and color scheme with an intention to pass off its product as that of the plaintiff’s.**

## Order granting registration and subsequent cancellation of trademark, found in contravention of law

[Trademark CAPTAIN COOK – Registration – Cancellation – Notice of opposition not served to petitioner – Order set aside]

### *DCW Home Products Ltd. v Deputy Registrar of Trademarks*

*Bombay High Court (July 25, 2002)*

Petitioner, **DCW Home Products** filed an application against the order of cancellation of registration of "CAPTAIN COOK" trademark by the **Deputy Registrar of Trademarks**. The Petitioner had applied for registration of their trademark "CAPTAIN COOK", in respect of iodised salt. The Deputy Registrar of Trademarks issued a certificate of registration of the trademark to the petitioner. Thereafter, **Vishal Salt Industries** issued a notice to the Deputy Registrar objecting to registration of the trademark on the ground that they had already lodged a notice of opposition, hence the certificate of registration could not be granted without deciding their notice of opposition. The Deputy Registrar found that the claim of Vishal Salt Industries was true and canceled the Certificate of Registration. **The Honorable Court set aside the impugned order of cancellation and held that the Deputy Registrar had caused injury to the petitioner on the ground that the notice of opposition was not served on the petitioner. Hence the grant and subsequent cancellation of registration is in contravention of law.**

## Passing off of CASTROL and INDROL marks and original labels restrained

(Trademark CASTROL v INDROL – Permanent Injunction – Infringement and passing off action – Registered Trademarks – Injunction granted ex parte)

### *Castrol Ltd. v Auto Link Sales Corporation*

*Delhi High Court (September 9, 2002)*

Plaintiff, **Castrol Ltd.** filed a suit for permanent injunction against the defendant, **Auto Link Sales Corporation**. The plaintiff contended that they were the owners of the registered trademark, "CASTROL" and "INDROL" and the defendants had made use of a deceptively similar trademark and logo for their products. **The Honourable Court granted an ex parte injunction and held that the plaintiff's trademark has been infringed and it is apparent that the defendants are trying to pass off their goods as that of the plaintiff's, thereby causing deception and confusion.**

## PHILIPS tradename protected

[Tradename PHILIPS – Famous name – Registered Trademark – Unauthorised use would lead to confusion]

### *Philips India Ltd. v Philips Infotech Ltd.*

*Regional Director, Dept. of Company Affairs, Madras (April 28, 2003)*

Plaintiff, **Philips India Ltd.**, filed an application for issuance of directions to the defendant, **Philips Infotech Ltd.**, for change of name as the trademark/tradename "Philips" is globally known and recognized and unauthorized use of the trademark/tradename would lead to confusion. **The Regional Director granted the application and directed the defendant to delete the word "Philips" from its existing name within three months from the date of the order.**

## Phonetic and visually similar mark found infringing

[Trademark KURKURE – Slogan - Infringement – Phonetic and visual similarity – Permanent injunction]

### *Frito Lay India v Shivdeep Food Products Pvt. Ltd.*

Delhi High Court (February 4, 2003)

Plaintiff, **Frito Lay**, filed a suit seeking permanent injunction restraining defendant, **Shivdeep Food Products Pvt. Ltd.**, from infringing the plaintiff's trademark KURKURE and packaging design for a snack product, in the latter's adoption of the deceptively similar name "Kurram Kurram" for a similar product with a imitative pack, and from copying the plaintiff's slogan "Bindaas Fun" by adopting the slogan "Bindaas Snack". **The Honourable court granted the injunction and restrained the defendant from using "Kurram Kurram"\* with the letter "K" and also from using slogans deceptively similar to that of the plaintiff.**

## Phonetically similar word found deceptive

[Trademarks CHANEL v SHANELLE – Phonetically similar names – Injurious to goodwill & reputation – Infringement and Passing off action – Interim Injunction granted]

### *Chanel Ltd. v Sunder Chemicals Agarbati Works (P) Ltd.*

Delhi High Court (October 1, 2002)

Plaintiff, **Chanel Ltd.**, filed a suit for interim injunction against defendant, **Sunder Chemicals Agarbati Works (P) Ltd.** on the grounds of infringement and passing off, through use of the word "Shanelle" which is phonetically similar to the plaintiff's trademark "Chanel". **The Honourable Court granted the injunction in favour of the plaintiff and held that the fact that the trademark of the plaintiff is registered itself confers on the plaintiff an absolute right of injunction as soon as the infringing mark is shown to be capable of deceiving or causing confusion.**

## 'PLAYBOY' trademark and 'rabbit head' logo are protected by transborder reputation

[Trademark PLAYBOY and Rabbit head device – Infringement – Transborder reputation – Damage to reputation and goodwill]

### *Playboy Enterprises International Inc. v Advance Cosmetic and Research Centre*

Delhi High Court (February 2003)

Plaintiff, **Playboy Enterprises International Inc.**, filed suit alleging trademark infringement and seeking injunction restraining defendant, **Advance Cosmetic and Research Centre** from manufacturing and selling perfumes with the Playboy trademark and the 'rabbit head' logo. In the absence of the defendant's response, **the Honourable Court upholding the transborder reputation of the 'Playboy' trademark, ruled ex parte that the defendants are restrained from using the 'Playboy' trademark and logo and also from manufacturing and selling perfumes under the said trademark. The court also granted an injunction and appointed commissioners to raid the premises of the defendant and take into custody all infringing products.**

## Prima facie case essential for grant of injunction

[Suit for interim injunction – Infringement action – Deceptive similarity – No prima facie case – Injunction refused]

### *Heineken Brouwerijen B V. v Som Distilleries & Breweries*

Delhi High Court (January 29, 2003)

Plaintiff, **Heineken Brouwerijen**, filed an application for interim injunction against defendant, **Som Distilleries** for infringement of trade dress of its Heineken beer cans. **The Honourable Court refused to**

grant injunction and held that “Heineken” beer is brewed in Holland and is not available in India off the shelf. Rather the product is being marketed here only in cans, that too, in duty free shops, star hotels and big clubs and the clientele at these places would ask for the beer by its brand name rather than by the color of the label. Hence there is no chance of an ordinary purchaser being deceived merely by the look or color of the label. In comparison, the product of the defendant is an indigenous product, brewed and bottled in India, and therefore, it is not possible to hold on to the contention that the defendant is trying to pass off its products as that of the plaintiff.

## **Prior use of similar trademark does not necessarily create balance of convenience**

[Trademarks RIVOX v REVOX – Deceptively similar trademarks – Both marks pending registration – Use of trademark by plaintiff was sporadic – Defendant’s adoption of trademark is bona fide]

### ***East African (I) Remedies Pvt. Ltd. v Wallace Pharmaceuticals Ltd.***

*Delhi High Court (April 1, 2003)*

Plaintiff, **East African Remedies Pvt. Ltd.** filed an application seeking an ad interim injunction against defendant, **Wallace Pharmaceuticals Ltd.**, restraining use of the trademark “Rivox” or any other trademark deceptively similar to it. **The Honorable Court did not grant the injunction and held that the Plaintiff is not a continuous and regular user of the trade mark and has not acquired any goodwill in the market. In comparison, the defendant has been continuously using the trademark “Revox” and has acquired a goodwill and reputation and the sales of its product has been substantial in the preceding years. Therefore, the balance of convenience lies in favour of the defendant, as they will suffer irreparable loss and injury if the injunction is put in force.**

## **Proprietary right in a geographical trademark/name cannot be claimed after transfer of property**

[Trademark/Tradename BLOOMFIELD – Temporary injunction – Passing off trademark/name – Transfer of property as a going concern – Cessation of ownership – No proprietary right]

### ***Bloomfield Tea Co. Ltd. v Bagaria Business (P) Ltd.***

*Calcutta High Court*

Plaintiff, **Bloomfield Tea Co.**, applied for temporary injunction restraining defendant, **Bagaria Business (P) Ltd.** from passing off the trademark/tradename ‘Bloomfield’. The defendant countered that the plaintiff had ceased to own the property hence no proprietary right in the associated trademark/tradename can be claimed. Moreover the plaintiff had sold the property as a ‘going concern’ and the defendant had acquired it likewise and it is a settled legal position that a ‘going concern’ passes its title along with its goodwill. **The Honourable Court dismissed the plaintiff’s injunction application and held that the plaintiff, having failed to establish a \*prima facie case, is not entitled to get any order of injunction restraining the defendant from using the word ‘Bloomfield’.**

\* *Prima Facie* - It means "so far as it can be judged from the first disclosure".

## Rectification for non-use of trademark is erroneous when special circumstances exist for such non-use

*[Trademark SPARTAN VELOX and device – Rectification – Non user of trademark – Special circumstances]*

### ***Hardie Trading Ltd. v Addisons Paint and Chemicals Ltd.***

*Supreme Court of India (September 12, 2003)*

Acting on defendant, **Addisons Paint and Chemicals'**, action for cancellation of plaintiff, **Hardie Tradings** trademark comprising of the words 'SPARTAN' and 'SPARTAN VELOX' and a picture of the upper body of a helmeted warrior carrying a shield and a spear, and rectification of the Register, the Registrar ordered the rectification. Plaintiff, **Hardie Trading**, filed an application against the order. The Calcutta High Court granted the application on the ground that there were no special circumstances for non use of the trademark over the period in question. Based on the facts placed before it **the Supreme Court of India held that the conclusion of the Calcutta High Court and the Joint Registrar that there were no special circumstances was erroneous, as the evidence on record shows that it was not economically possible for the plaintiff to put its goods in the Indian market due to the restrictions imposed by the Import Trade Control Policies for the relevant years.**

## Reputation in 'MAC' trademark not established

*[Tradename McDONALD v MACGILZ – Suit for interim injunction – Action for infringement and passing off – Similarity of trademarks – Reputation not established – Injunction rejected]*

### ***McDonald's Corporation v MacGilz Fast Food***

*Punjab & Haryana High Court (October 24, 2002)*

Plaintiff, **McDonald's** filed a suit for perpetual injunction against defendant, **MacGilz Fast Food** for infringement of trademark and passing off. **The Honourable Court rejected the application for injunction and held that the registration applications of the plaintiff for the word "Mac" were pending, hence, it was too early to accept the claim of the plaintiff and consequently injunct the defendant from using the aforesaid name.**

## SmithKline Beecham seeks permanent injunction against infringement of trademark and copyright

*[Trademarks ZENTEL v LETNEZ – Permanent Injunction – Infringement of trademark and copyright – Pharmaceutical trademarks – Intention to deceive apparent – Decree of permanent injunction granted]*

### ***SmithKline Beecham Plc. v Lalitbhai Patel***

*Delhi High Court ( February 17, 2004)*

The plaintiff **SmithKline Beecham** is engaged in the manufacture, marketing and distribution of various pharmaceutical preparations including a product with the brand name ZENTEL, which is an invented word having no dictionary meaning. The plaintiff sought injunctive relief on the ground that defendant **Lalitbhai Patel** had adopted the trademark LETNEZ in relation to a similar product with deceptively similar packaging and thereby infringed the trademark and the copyright of the plaintiffs. **The Honorable Court held that the trademark adopted by the defendant is the reverse form of the trademark of the plaintiff. As products contain the same pharmaceutical ingredient and would be sold to the same class of purchasers, close identity and similarity between the two trademarks is established and the intention to deceive is apparent. Hence a decree of permanent injunction is granted against the defendant.**

## Stray adoption of internationally famous invented word does not give legal right

[Trademark HONDA – Passing off – Use – Reputation – Invented word – Common surname – Honest concurrent use – Stray adoption – Prima facie case]

### ***Honda Motor Co. Ltd. v Mr. Charanjit Singh & Others***

*Delhi High Court (November 28, 2002)*

Plaintiff, **Honda Motors** of Japan, sought injunctive relief against defendants **Mr. Charanjit Singh and others** from passing off the famous trademark and trade name 'Honda' on pressure cookers. Defendants countered that 'Honda' is a common surname and that the Plaintiff had not used the mark 'Honda' in India independently. **The Honourable Court dismissed the defendants' allegation and held that the defendants had adopted the well known mark 'Honda', to trade off the goodwill and reputation vested in the mark. Further, stray adoption of an invented word does not give legal right. The plaintiff has a prima facie case and the defendants' continued wrongful use of the mark gives rise to a recurring cause of action.**

## The addition of a geographical suffix does not sufficiently alter the underlying mark to which it is added to create a right

[Trademark HONDA v Domain name hondaindia.com – Domain name Domain Name <hondaindia.com> - Complainant using several domain names consisting of the word HONDA – Respondent claiming to have adopted the name for future use – Respondent registered and used the name in bad faith – Directions given to transfer domain name to complainant]

### ***Honda Motor Company Limited v Lokita Enterprise***

*WIPO Arbitration and Mediation Center, Administrative Panel Decision (August 8, 2003)*

The complainant **Honda Motor Company** was incorporated with the name HONDA as the key and principal feature of its business name and also as its trademark since its inception. It hosts and maintains a large number of websites throughout the world with domain names consisting of the word 'honda' including the domain name <hondacarindia.com>. When the complainant found that the respondent **Lokita Enterprises** registered the domain name <hondaindia.com>, the complainant sought arbitration on the ground that the respondent's domain name was identical to the trademark of the complainant. It was intended to project a message to surfers/consumers that the respondent is a subsidiary and/or associate company of the complainant in India. The respondent has no trademark rights or legitimate interests in respect of the domain name at issue due to the complainant's long prior use of the mark and HONDA is not the legal name of the respondent. **The Panel held that the addition of the name of a geographical suffix to a trademark such as the addition of 'India' to HONDA is a common way of indicating subdivisions of global enterprises and does not sufficiently alter the underlying mark to which it is added. Complainant's trademark is famous around the globe. A user of the internet on seeing the domain name "<hondaindia.com>" is likely to assume that the complainant is the sponsor of or is associated with the website of Honda. The respondent is deliberately attempting to create a likelihood of confusion for the Internet users. The respondent has not used the name in connection with a bona fide offering of goods or services, has not been commonly. The respondent therefore has no rights or legitimate interests in the domain name at issue and hence the domain name, <hondaindia.com> is to be transferred to the complainant.**

## Trademark/name having transborder reputation is protected against trademark infringement in India

[Trademark YAHOO – Trademark infringement – Misappropriation of goodwill and reputation – Passing off]

### ***Yahoo Inc. v Sarda Trading Company***

*Delhi High Court (February 2003)*

Plaintiff, **Yahoo Inc.**, filed a suit for trademark infringement against defendant, **Sarda Trading Company**. The Plaintiff maintained that they had license for the 'Yahoo' mark and the defendant was passing off its goods as that of Yahoo Inc.'s and were damaging the goodwill and reputation of the trademark/name 'Yahoo'. **The Honourable court ruled that the defendant be restrained from marketing, distributing or selling tea under the trademark/trade name 'YAHOO'.**

## Trademark Office directed to call for search report for pharmaceutical trademarks

[Trademarks BIOCILIN v BICILLIN – Trademark Application – Dismissal of Opposition – Confusion and deception]

### ***Bio-Chem Pharmaceutical Industries v Astron Pharmaceuticals***

*Delhi High Court (January 15, 2003)*

The appellant, **Bio-Chem Pharmaceutical Industries**, proprietors of the trademark 'Biocilin' appealed against the dismissal of their opposition to the registration of defendant, **Astron Pharmaceuticals** deceptively similar trademark 'Bicillin'. **The Honourable Court, setting aside the order of the Registrar, allowed Bio-Chem's appeal and ruled that the phonetic similarity between the two trademarks was apparent and would cause confusion. The Court decided that the Trademark Office should take precaution by calling for an official search report from the Drug Controller pertaining to trademarks relating to medicines.**

## Use of 'Kohinoor' as a trademark permissible

[Trademark KOHINOOR – Honest user – Not a coined word – Usage possible – Registration possible]

### ***Sant Ram & Co. v Satnam Overseas***

*Delhi High Court (September 11, 2003)*

Plaintiff, **Sant Ram & Co.** filed a suit against the Defendant, **Satnam Overseas**, opposing the registration and use of the word "Kohinoor", in relation to rice. **The Honorable Court allowed the registration and held that evidence on record proves that the defendant honestly adopted the word "Kohinoor" as its trademark. The word "Kohinoor" is not a coined word, but is the name of a precious diamond, hence any person could pick up the word and use the same as its mark for product manufactured by it under a bona fide belief that he is entitled to use the same.**

## Use of domain name similar to trademark considered to be infringement

[Trademark REDBULL v Domain Name myredbull.com – Registered trademark – Infringement – Deceptive similarity – No rights – Used in bad faith – Domain name to be transferred to the plaintiff]

### ***Red Bull GmbH v Bayer Shipping & Trading Ltd.***

*WIPO Arbitration and Mediation Center, Administrative Panel Decision (June 3, 2003)*

Complainant, **Red Bull GmbH**, filed an application against the use of the domain name <myredbull.com> by the defendant, **Bayer Shipping and Trading**. **The Administrative Panel granted the application in favour of**

the complainant and held that the domain name registered by the respondent is identical and confusingly similar to the trademark of the plaintiff. The respondent has no legitimate rights to that domain name which has been registered and used in bad faith, hence the respondents domain name should be transferred to the plaintiff.

## COPYRIGHTS

### **Delay in bringing action for copyright infringement is not sufficient to defeat grant of injunction**

*[Allegation of Infringement – Registered mark – Intention to pass off – Laches – Interim Injunction]*

#### ***Midas Hygiene Industries Pvt. Ltd. v Sudhir Bhatia***

*Supreme Court of India (January 22, 2004)*

The appellant, **Midas Hygiene** filed an application for interim injunction against defendant **Sudhir Bhatia** for infringement of copyright and passing off. The Honorable High Court granted the injunction and restrained the defendant from infringing the appellant's copyright. The respondents appealed to the Division Bench who vacated the injunction on the ground of delay and laches in filing the suit. The plaintiff then filed an application against the vacated injunction to the Supreme Court. **The Honorable Supreme Court set aside the impugned order and restored the injunction and held that the Division Bench had erred in vacating the injunction merely on the ground of delay and laches as it is an established point in law that in cases of infringement, an injunction must follow. Delay in bringing action is not sufficient to defeat grant of injunction.**

### **Delhi High Court rules against infringement of copyright in logo**

*[Copyright Infringement – Use of similar logo – Malafide intention apparent – Decree of perpetual injunction]*

#### ***Fenner (India) Limited v Farms and Farms (India) Ltd.***

*Delhi High Court (March 26, 2004)*

Plaintiff, **Fenner (India) Limited** filed a suit seeking decree for perpetual injunction against defendant **Farms and Farms (India) Ltd.** for infringement of copyright and passing off. The plaintiff is a user of the registered trademark "Fenner" and the logo of "F&F inverted in square" in India, which has acquired tremendous reputation amongst the general public and has generated substantial and valuable goodwill.

The defendant markets farmlands and private orchards with the logo of "F&F inverted in square", exactly similar to the plaintiff's logo. The defendant copied all the distinctive and essential features of the plaintiff's logo including get up, layout and design. The plaintiff alleged that such adoption displays the *mala fide* intentions of the defendant, with a view to encroach upon the reputation and goodwill of the plaintiff.

**The Delhi High Court passed a decree for perpetual injunction against the defendant restraining them from infringement of copyright in the disputed logo and held that the logos of the plaintiff and the defendant are substantially identical and that the defendant has dishonestly adopted the plaintiff's logo with a view to give an impression to the general public that the goods being sold by the defendant are in fact the goods of the plaintiff.**

## Godrej & Boyce restrained from infringement of copyright in design

*[Interim Injunction – Allegation of infringement – Interim injunction granted – Appeal to Division Bench – SLP to Supreme Court – Trial Court directed to expedite proceedings]*

***N Rangaswamy v Godrej & Boyce Manufacturing Co. Ltd.***

*Madras High Court (August 29, 2002)*

***Godrej & Boyce v N Rangaswamy***

*Madras High Court, DB (November 7, 2002)*

***Godrej & Boyce Manufacturing Co. Ltd. v N Rangaswamy***

*Supreme Court of India (January 17, 2003)*

**N Rangaswamy**, filed an application for interim injunction against **Godrej & Boyce** restraining them from infringing his copyright on design of a pilfer proof locking system for liquid transportation and also from using and adopting his copyright wholly or in part by making representations to any third parties while canvassing for sale. The High Court of Madras held that, N Rangaswamy has made out a prima facie case and the balance of convenience being in his favour, Godrej & Boyce has to be restrained. Godrej & Boyce, appealed against the order to the Division Bench, Madras High Court, but the Court upheld the earlier judgment. Godrej & Boyce then appealed to the **Supreme Court, which held that, by consent of the parties, the orders of the Division Bench and the Trial Court are set aside and the application filed by the respondent - plaintiff is disposed off by directing the appellant to maintain separate accounts of the sales of the debated locking system which are to be submitted with the Assistant Registrar of the High Court every six months. The trial of the suit should be heard and disposed of as expeditiously as possible by the Trial Court.**

## Idea cannot have a copyright

*[Title - Infringement – Injunction application – Two productions entirely different – No action for infringement]*

***Star India Pvt Ltd. v Leo Burnett (India) Pvt. Ltd.***

*Bombay High Court (September 24, 2002)*

Plaintiff, **Star India** filed a suit for copyright infringement against defendant **Leo Burnett Pvt. Ltd.**, stating that there was substantial copying from their serial “Kyun Ki Saas Bhi Kabhi Bahu Thi”<sup>1</sup> in the latter's commercial advertisement titles “Kyun Ki Bahu Bhi Kabhi Saas Banegi”<sup>2</sup> promoting a detergent powder; and that considerable damage is being occasioned to the plaintiff due to continuous act of infringement of copyright. The defendants contended that their work is a commercial advertisement of 30 seconds and not a film. Furthermore, the two works are entirely different and one cannot be considered to be a copy of the other. **The Honourable Court refused to grant an injunction and held that when seen and compared, the two works prima facie are different and there is no evidence of substantial copying or similarity between the two. The question of infringement of any copyright of the plaintiff's television serial, therefore, does not arise.**

<sup>1</sup> Literally translated from Hindi - "Because the mother-in-law was once a daughter-in-law"

<sup>2</sup> Literally translated from Hindi - "Because the daughter-in-law will, at some time, become a mother-in-law"

## Logo is an artistic work protected by the Copyright Act

*[Artistic Work – Copyright – Use is infringement – Injunction granted]*

***ICC Development International v Ever Green Service Station***

*Delhi High Court (January, 2003)*

Plaintiff, **ICC international**, filed a suit seeking temporary injunction against the defendant, **Ever Green Service Station** for copyright infringement of the logo and mascot of the plaintiff. **The Honourable Court granted an ex parte injunction on use of the logo by the defendants and held that they had failed to**

make a *prima facie* case, showing that in the course of a promotional campaign, they could use the logo denoting black and white stripes of the zebra, especially in view of the fact that the logo is in the nature of an artistic work, protected under the Copyright Act.

## Publication of copyrighted work in breach of agreement restrained

[Publication – Existing agreement – Existing interim injunction – Copyright infringement – Injunction made absolute]

### *The Chancellor Masters & Scholars of the University of Oxford v Orient Longman Pvt. Ltd.*

Delhi High Court (December 19, 2002)

Petitioner, **Chancellor Masters and Scholars of the University of Oxford**, filed a suit for permanent injunction restraining defendant, **Orient Longman** from publication of a copyrighted work in breach of agreement. The defendant under a subsisting agreement with the plaintiff had undertaken not to publish any work on the same subject which might be regarded as conflicting with the copyrighted works of the plaintiff without his consent. The defendants tried to renege from the agreement and printed similar books with intent to sell to the same readership segment as that of the plaintiff without his consent. An *ex parte* ad interim injunction was already in force against them on the same issue. **The Honourable Court granted a permanent injunction and held that the balance of convenience in the case is in favour of the plaintiff who is likely to suffer irreparable injury if the *ex parte ad interim* injunction order is not confirmed.**

## Zee TV restrained from airing serial in violation of Copyright

[Television serial – Copying of concept and story – Violation of copyright restrained]

### *Sundial Communications v Zee Telefilms Ltd., & Another*

Mumbai High Court (March 27, 2003)

Plaintiff, **Sundial Communications**, filed suit alleging that defendant, **Zee TV**, had copied the story and concept of its serial 'Krish Kanhaiyya' in the latter's similarly titled serial "Kanhaiyya" and thereby, attempted to misrepresent the plaintiff's serial as their own. The defendant contended that there are many dissimilarities between the two serials. **The Honourable Court after viewing both the serials restrained Zee TV from airing its serial and held that the Plaintiff's copyright has been violated in terms of form, manner, arrangement and expression of the idea.**