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RKD Special

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Wings Entertainment Limited V. Star India Private Limited

The legal dispute between Wings Entertainment Limited and Star India Pvt. Ltd over infringement of registered Trademarks 'Master Chef' and 'Master Chef Series' of the plaintiff went in favor of Wings Entertainment Limited, with the Honorable District Judge of Gurgaon passing an ad-interim injunction restraining Star India Pvt. Ltd from using the trade marks in dispute till pendency of the infringement suit filed by Wings Entertainment Limited. Wings Entertainment Limited was represented by R. K. Dewan & Co. in this matter.

Wings Entertainment Limited is the manufacturer and distributor of VCD/DVD sets in which some well-known chefs performed. The VCD/DVD sets were also marketed under the trademarks 'Master Chef' and 'Master Chef Series'. The defendants being a Media and Entertainment Company, broadcasted the Television show 'Master Chef India' thereby infringing the Plaintiff's trademark regarding which a suit for permanent injunction was filed in 2010 and is pending before the Honorable High Court of Delhi.

During the pendency of the infringement suit the Defendants started broadcasting another television show 'Master Chef Australia' and being aggrieved by such an act of the Defendants, Wings Entertainment filed a suit for permanent injunction, damages and an order seeking appointment of Court Commissioner for the purpose of destruction of infringing goods in the Defendant's possession. The Honorable Court restrained the Defendants from using the disputed trademarks and directed the Defendants to prepare an inventory of documents pertaining to the details of infringement of trademarks registered in name of the Wings Entertainment Limited.

Deccan Education Society, Pune V. Deccan Education Society, Gulbarga & others: Passing Off case.

The Plaintiff, Deccan Education Society, Pune (DES, Pune) is an educational institute having a registered trademark 'Deccan Education Society' in relation to educational services to impart vocational and basic education in Western Maharashtra. DES, Pune was established in 1884 by Lokmanya Bal Gangadhar Tilak and other freedom fighters for promoting education and it is registered as a charitable trust under the Bombay Public Trust Act, 1950 in addition to its registration as a society under The Societies Registration Act, 1860. The well-known Fergusson College was also founded by Deccan Education Society, Pune in the year 1885. The plaintiff was represented by R. K. Dewan & Co in this matter.

Another entity, Deccan Education Society (Regd.) Gulbarga (DES, Gulbarga) recently obtained registration under the Trade Marks Act, 1999 in class 41, for the trademark 'Deccan Education Society' in respect of educational services. In a suit and application for interim injunction instituted by the Plaintiff before the Honorable District Court, Pune it was alleged that the use of the mark 'Deccan Education Society' amounts to mala fide use of the Plaintiff's mark amounting to passing off and prayed that the Defendants should be restrained from using the mark 'Deccan Education Society'.

While deciding the Interim application for grant of injunction, the Honorable District Court was called upon to determine:

- Whether there is a prima facie case in favour of the Plaintiff?
- Whether balance of convenience is in the Plaintiff's favour?
- Whether the Plaintiff would suffer hardship or irreparable loss, if injunction is not granted?

The Honorable District Court responding to the questions in affirmative, agreed with the Plaintiff's claim that DES, Gulbarga has dishonestly adopted the mark 'Deccan Education Society' and registered the mark with a motive to gain unlawfully from the reputation of the Plaintiff's registered trade mark. The Court also agreed that the act of DES, Gulbarga imitating the registered mark of the Plaintiff was in itself enough to establish a prima facie case against DES, Gulbarga. It was also observed that even though granting interim injunction would cause hardship and financial loss to DES, Gulbarga, the interim injunction was justified taking into account the wrong committed by the Defendants.

M/S Shree Krishna International & Ors Vs Google India Pvt. Ltd. & Ors.

In the case of M/s Shree Krishna International & Ors Vs Google India Pvt. Ltd & Ors, the District Court of Gurgaon disposed off an application for interim injunction filed by the Plaintiffs for copyright Infringement. The Plaintiffs represented by R. K Dewan & Co. were granted an interim injunction against the Defendants.

M/s Shree Krishna International & Ors are the owners of the copyright of various cinematograph films, audio & video visual songs as well as sound recordings. Their primary contention against Defendant nos. 1, 2 & 3 namely Google India Pvt. Ltd. , Youtube LLC and Google Inc. respectively was that the Defendants were infringing copyrights of the Plaintiffs. The Plaintiff stated that whenever a user searched for any of the Plaintiff's films on the website of Defendant nos. 1 & 3 the search engine directed the user to Defendant no. 2 which contained material for which copyrights were owned by the Plaintiff. The Plaintiff contended that all the three Defendants had common interests, were operating for each other and had used the copyrighted work without any license or any authority which amounted to primary acts of infringement. The Plaintiff also contended that the Defendants had absolute and complete knowledge of the infringing materials on their website as each & every video was examined thoroughly by their huge team of specialists/Data Analysts before being uploaded on the website.

Google India Pvt. Ltd. submitted that although it is a subsidiary of Defendant no. 3 it had an independent management from the parent company and was not an agent for the same in India. Therefore, Google India Pvt. Ltd. was in no position to control or maintain services offered by Defendant no. 3 such as Google search & Youtube.com. Youtube LLC was owned by Google Inc. and Google Inc. had not appointed Google India as its agent in India, therefore, they both should have been served in their own capacity and their summoning could not be done through Google India. It was further clarified by the counsel for Defendant no. 1 that Google search was an automated search engine and merely performed the task of indexing information available across the world in response to a search query that was entered by a user. The content/ material was already available on independent third party websites and hence was beyond the control & supervision of Google. The counsel for Defendant no.1 also clarified that Youtube respected the valid & subsisting Intellectual Property Rights of third parties and has always discouraged & disapproved of any attempts to infringe such rights through its websites.

The Hon'ble Additional District Judge observed that the Plaintiffs held copyrights in respect of numerous films, audio-visual sound recordings, underlying lyrics and musical components in said audio visuals songs. The Hon'ble Judge also held that the works of the Plaintiffs were being re-produced and communicated to the public by the Defendants without the Plaintiff's permission or consent. The Hon'ble Judge in the absence of Defendants' no. 2 & 3 passed an ex parte order restraining the Defendants from using in any manner on their websites or otherwise, works over which the Plaintiff's held copyrights, without obtaining an appropriate license.

Saurashtra Cement Ltd. v/s Zuari Cement Ltd.

Saurashtra Cement Ltd., represented by R. K. Dewan & Co. filed an application in the Hon'ble High Court of Judicature, Madras for grant of an order of ad-interim injunction, pending disposal of the suit, restraining the respondent Zuari Cement Ltd. from infringing the registered trade mark of the applicant. The respondent featured an Elephant in their advertisement which is a registered trade mark of the applicant.

The respondent Zuari Cement Ltd. earlier filed two applications for grant of ad-interim injunction against Saurashtra Cement Ltd. restraining them from proceeding further with the groundless threat for alleged infringement in respect of the use of the picture of an Elephant in the sales promotion materials and advertisements.

In the preceding application for threat, the Hon'ble High Court granted an interim injunction stating that Zuari Cement Ltd. had made out a case in terms of Section 142 of the Trade Marks Act. The judge opined that registration of a trade mark will not give any right to the exclusive use of the device of an elephant.

Saurashtra Cement had registered the trade mark in respect of their product in 1975 and the hindi version of the same was registered in 1998. Registration was also done in other languages including Tamil. Subsequent registration was obtained in 2005 and the registration is valid by way of subsequent renewals as on date. Therefore, the Hon'ble Judge, Mr. K Chandra vide order dated 13th October, 2012 opined that issuance of a notice from Saurashtra Cement to Zuari Cement cannot be considered as a groundless threat.

Zuari Cement contended that the elephant was shown only to convey high strength of the Company's product i.e. cement. They also argued that an Elephant is considered foremost in terms of strength and load bearing capacity which has also been talked about in the epics and that it was a custom in the Indian market to use the picture of an Elephant to portray the strength of any product to justify their use of the picture. They also listed out other companies which use pictures of elephants to signify the strength of products.

The Hon'ble High Court was of the view that a prima facie case was made out by Saurashtra Cement and hence the order of interim injunction was granted. The court also vacated the interim injunction granted in the preceding applications by dismissing those orders.

MTR Food Private Ltd. v/s Raniammal Agencies & Ors.

MTR Foods Pvt. Ltd., represented by R. K. Dewan & Co. filed an application for grant of temporary injunction against the respondents namely Raniammal Agencies, Sooriya Supermarket & Pharmacy, Grace World Supermarket, Happy Provision and Rajam Herbal Technologies for passing off of their badam (almond) drink mix by using a similar get up and design of the applicant's carton.

The Hon'ble High Court of Judicature, Madras after finding merits in the application passed an order of interim injunction on 21st May, 2012 restraining the respondents from using a design similar to the applicant's carton and passing off their goods as that of the applicant's.