



## Newsletter February 2015

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- INDIA: TRADEMARK LITIGATION HIGHLIGHTS 2014

### India: Trademark Litigation Highlights 2014

In trademarks, the Delhi High Court opened the innings with Justice Manmohan Singh deciding early in January The Pranik Healing case . This case lays down and confirms various principles. Firstly, for testing jurisdiction of a Court, the court should look at averments made in the plaint and these have to be seen as correct. In this case, Justice Singh was required to consider the plaintiffs claim of copyright on Pranik Healing techniques and whether these techniques could be legally protected. More importantly the plaintiff had obtained registration for the trademark Pranik Healing and was attempting to exercise its rights under the registration. Justice Singh came to the conclusion that although the mark was registered, it attracted serious objections and it lacked distinctive character. An important principle provided by Dr. Singh was that where the plaintiff obtains registration by making a false claim as to proprietorship, it will be disentitled to exercise its rights under the registration.

The next judgment was from Mumbai where Justice Kathawalla in the UltraTech case , had occasion to discuss the provisions of Section 134(2) of the Trademarks Act and decided that in a mixed case of infringement of a trademark and passing off, it was acceptable to combine the causes of action to avoid multiplicity of proceedings. From Mumbai the scene moved on to Calcutta where Justice Mukerji in the Mankind case , the Court had to deal with a group of 11 trademarks, which were copied by the defendant who was the erstwhile sales manager of the plaintiff. The Court was shell shocked as to how a similar brand could be use to sell two different medicinal preparations and pointed out that the public was in danger in such cases. Mankind succeeded in obtaining injunctions in respect of each of the violated brands. From Calcutta the scene moved back to Mumbai where Justice Kathawalla again pronounced judgement in the SABMiller case dealing with the numeral 5000 in respect of beer. Holding that the numeral was not generic the Court granted an injunction in favour of plaintiff. Shortly, thereafter, Disney obtained an injunction against J.J. International who were selling chocolates bearing the characters such as Winni The Pooh, Tigger, Eeyore and Piglet which were registered trademarks of the plaintiff . Simultaneously, Microsoft obtained an injunction against the use of its trademark X-Box on gray market products. And Mex switch gears succeeded against the use of the trademark Max switch gears by the defendant. Although, in the second case the defendant was given six months time to dispose-offits existing stocks and change its trademark and trade name.

The case of Sanjay Kapoor vs. Dev Agri was an interesting case of trade dress where the defendants were retrained in selling tea in packaging bags identical to the packaging bags of the plaintiff. In the same genre was the case of Coca Cola vs. Salim in which Coca Cola obtained injunctions against the defendant using the trademark bright in containers similar to the mark Sprite and the mark Funs up in containers similar to the trademark Fanta and ThumbsUp. The Castrol infringement case pending since 2007 was also finally decreed ex parte and damages of Rs. 2 Lac were awarded in favour of the plaintiff . Similarly, in faster time Caterpillar obtained an ex parte permanent injunction and was awarded punitive damages of Rs. 1 Lac 50 Thousand and counsel fee of Rs. 50 Thousand. Still further, in the case of Fantech PTY ltd. vs. Adept Fantech India Pvt. Ltd. , the plaintiff obtained an ex parte degree against the use of Fantech by the defendant as part of its corporate name to the tune of Rs. 2 Lac. Justice Chauhan of the High Court of Rajasthan delivered a well researched judgement whilst granting injunction in India in the scooter Vanaspati infringement case . The issue involved the defendant wanting to lead additional evidence during appeal and the judge came to the conclusion that inadvertence of the party, inability to understand legal issues, wrong advice of lawyers, negligence of a lawyer and not realizing the importance of a document were not grounds by themselves to allow admitting of evidence in appeal. From Jaipur the scene shifts to Madras where Judges Jaichandrea and Venugopal were called upon to deliberate in the case of @Road Inc. Vs E-Logistics Pvt. Ltd. on a peculiar requirement of the Madras High Court of obtaining a leave to sue in cases where part of the cause of action has arisen outside the jurisdiction of the Court. There lordships opined that while considering such an application opportunities should be given to both parties to let in oral and documentary evidence and examine relevant witnesses.

In the Tudor vs. Arre Clothing case which involved the infringement of the trademark 'Array' by the trademark 'Arre', the Court decided in the favour of plaintiff. Although, both the plaintiff and the defendant were located in Ludhiana, the Delhi Court exercised jurisdiction on the basis of sale within the territorial limits of Delhi.

In the Pepsi Co. vs Aqua Mineral case , Pepsi Co. was able to establish that Aquafina was a well known trademark in India that Aquafine was an infringement of a trademark Aquafina and that the plaintiff was entitled to damages of Rs. 5 Lacs in the case of such an infringement.



In the Officer's choice case , in a well research judgement, Justice Sistani of the Delhi High Court concluded that the trademark "officer's special" was deceptively similar to the trademark "officer's choice" in respect of Whiskey. The Judge came to the conclusion that officer was a distinctive part of the trademark and 'choice and special' could be considered as variants of the same product.

In the Clindoxyl case, Justice Sachdeva of the Delhi High Court concluded that the trademark 'Clinoxyde' was deceptively similar to the trademark 'Clindoxyl', both products being used in relation to skin ointments for the treatment of acne. An injunction was granted, in spite of the fact that the defendant was the registered proprietor of the trademark Clinoxyde and explained the adoption of the trademark Clinoxyde from the ingredients of the drug Clindamycin and Benzoyl Peroxide.

Two interesting cases of the Bombay High Court were the cases of people interactive vs. Gaurav Jerry and Tech legal vs. Genelia Ritesh Deshmukh . In the first case, the defendant was enjoined from using the domain name and trademark Shaadihishaadi.com by the owner of the trademark shaadi.com whereas in the other case, the Court refused to grant an injunction against the use of the title 'Laibhari' to a Marathi Film, although the plaintiff was the owner of the domain name laibhari.com much before the adoption of the title by the defendant. And in yet another case, filed by Madley Pharmaceuticals , the Bombay High Court granted an injunction to Medley who were the owners of registered trademarks O2 and O2H against the marks O1B and O1B +.

The Haagen Dazs case was an interesting case of infringement of a coined suffix. In this case, the defendant was using the trademark DDaazs and the plaintiff's trademark was Haagen Dazs. The defendant's argument was that they had coined the mark DDaazs from the name of the father of one of its founding director Shri Dwarkadas. The defendant also pleaded that it had been using the trademark since 2009 before the plaintiff's first shop was opened in India. In its considered opinion, the Delhi High Court granted an injunction to General Mills the owner of the trademark Haagen Dazs.

In a rare case from the High Court of Himachal Pradesh, Justice Chauhan delivered another well-reasoned and balanced judgment in the case of Alkem vs. Elnova . Alkem has been using since the year 2000, the trademark Gemcal and the slogan 'Gem of Calcium'. Elnova launched a similar calcium product using an identical mark Gemcal but with the slogan "Pearl of Calcium" although, the judge granted an injunction restraining the defendant from using the word Gemcal. The Court refused to grant injunction against the use of the slogan 'Pearl of Calcium'.

In August, in the case of Precious Jewels vs. Varun Gems , the Supreme Court confirmed the provisions of Section 35 of the Trademarks Act which permitted a trader to do business in its own surname in a bona fide manner. Both plaintiff and defendant belong to the same family and they both were in the business of jewellery.

The case of Lt Foods Ltd. vs. Sachdeva & Sons dealt with the use of trademark Heritage in respect of rice. The plaintiff was the registered proprietor of the trademark Heritage for rice. The defendant had started using the trademark Indian Heritage Select also in respect of rice. In the written statement initially filed by the defendant, the defendant had not pleaded that Heritage was a generic word and the no person could claim an exclusive right to use the same. Subsequently, they wanted to amend their written statement to include this pleading. The Court held that although it has a new ground of defence that could be added in the written statement subsequently and mere delay in filing such an application for amendment of written statement could not be a ground for its rejection.

The Maruti Suzuki vs. Kavisha Motors case raised another interesting issue. The plaintiffs Maruti Suzuki were the owners of the trademark Maruti Suzuki. The defendant was former authorized dealers of the plaintiff. After his dealership was terminated, the defendant continued to use the trademark and logo of the plaintiff soliciting customers for service and repair of cars originated from the plaintiff. The Delhi High Court considered this infringement and deception on the public which could cause loss of reputation and goodwill of the plaintiff. The suit was decreed in favour of Maruti Suzuki a sum of Rs. 1, 30,000/- was awarded towards costs and damage.

In another pharmaceutical case from Mumbai, the plaintiff Neon laboratories owners of the trademark Lox and series of other trademarks containing the word lox succeeded against Themis Medicare who was using the mark Zylox . Both marks were being used in respect of anaesthetic. The defendant tried to argue that Lox had become common to the trade because other companies had also registered marks such as Ciplox and Norflox. But these marks were used in respect of antibiotics. What appeared to have favoured the plaintiff was the fact that the plaintiffs and defendants marks were both used for anaesthetics.

In the Blue Valley case , the Delhi High Court refused to continue an ad interim injunction for similar cosmetics being sold by the defendant under the trademark Blue Very. One of the reasons that led to the decision was that the plaintiff failed to mention in the plaint that the term Blue in its registration was disclaimed.

An important case was The World Wrestling Entertainment case which put to rest once and for all the controversies on jurisdiction of the Court on the basis of website transactions and that presence on the website in the commercial sense would give jurisdiction to the plaintiff to file a suit against defendant who did no business or did not reside within the jurisdiction of the Court.

Another interesting case was the 4life . The plaintiff was the registered proprietor of the trademark 4life for pharmaceutical products. The defendant started using the mark forlife for the same type of pharmaceutical products and the packaging was also similar. Justice Manmohan Singh held that two trademarks were deceptively similar and therefore injunctions should be granted.

Hindustan Pencils has been an active litigator in the trademark field. 2014 also saw them getting a permanent injunction in respect of the trademark Natraj for pencils and erasers against the defendant who was using the trademark Namraaj . In addition, Hindustan pencil was awarded punitive damages to the tune of Rs. 3 Lac.

Similarly, Glaxo was able to secure a permanent injunction against the use of the mark Betobate on the basis of the registration of their mark Betnovate, as also punitive damages of Rs. 1 Lac .

December saw the Delhi High Court in rapid succession granting and then vacating the injunction in the one plus case filed by Micromax . The importance of this case is that the divisional bench made some scathing remarks on conduct of single judges in the Court granting ex-parte orders without hearing both parties. The bench pointed out that the principle of natural justice would warrant the defendant to be heard before an order adverse to the defendant's rights to be passed. Only if a Court were to find that so grave and irreparable is the injury that even a day's delay cannot be brooked and so strong is the prima facie case made out, only then would a Court be justified in granting an ad interim injunction. It will be interesting to see the future of IP litigation in the Delhi High Court in the coming years, in view of this decisive order passed by the bench against an ad interim injunction.

In the case of Rolex vs. Alex where Alex was using the trademark Rolex for jewellery, the plaintiff was able to establish that Rolex is a well known trademark. A sum of 8 Lacs was awarded as damages and fifty thousand as cost.

The case of Marico Limited vs. Pratik Goyal dealt with a use of the trademark Paralite by the owners of the trademark Parachute and Parachute lite in respect of coconut oil. The Delhi High Court came to the conclusion that the mark Paralite was deceptively similar.

An unfortunate case was the writ petition filed by the Intellectual Property Association vs. Union of India . The Delhi High Court made observations which were contrary to the Trademarks Act 1999 by holding that the Controller General and the Registrar of trademarks are two different entities and that the Controller General could not dictate any orders to the Registrar of Trademarks. The fact to the matter is the Controller General is in fact the Registrar of Trademarks and the Court, therefore, erred in law.

The case of Sanofi India Limited vs. Universal Neutraceuticals Pvt. Ltd. is a case dealing with the word "Universal" which was a part of several registered trademarks belonging to the plaintiff. Although, the defendant established that there were several persons who were also the proprietors of the trademark "Universal" and that there were several companies having "Universal" as part of their corporate name. The Delhi High Court, enjoined the defendant company from using the word "Universal" as part of the company. What seem to have gone in favour of plaintiff was that the promoters of the defendants were ex employees of the plaintiff.

The case of Edu care vs. S K Sachdev dealt with a use of "Shri Ram" in respect of a school's name. It appears that the plaintiff has been running a school since 1988 under the name "Shri Ram School". Thereafter, the plaintiff had established several schools around the country which all included the name Shri Ram. The defendant started a school recently under the name the Shreeram World School. The Court came to the conclusion that the Shri Ram School and the Shreeram World School are phonetically, structurally and visually identical to each other and that this was a fit case for granting an injunction against the defendant.

The case of Maja Health Care vs. Trance International dealt with a use of mark Cobra for perfumes and cosmetics. The mark Cobra originally belonged to a well known perfumer S H Kelkar. The plaintiff with the consent of Kelkar registered the mark St. John Cobra. The defendant on the other hand started using the marks Diamond Cobra & Velvet Cobra for perfumes. The defendant claimed that it had been using these marks much before the plaintiff but the defendant was unable to prove this by documentary evidence. Eventually, the defendants were restrained to use the marks Diamond Cobra and Velvet Cobra.

Appu the baby elephant was the bone of contention in the case of Laxmi Rice Mills vs. Maharudra Rice Industries in the Karnataka High Court. Both parties were using Appu with the device of a baby elephant in respect of rice. It must be remembered that Appu was the mascot of the Asian Games in 1982. Although, the plaintiff had registered the mark in its favour the defendant contended that the plaintiff could not claim to be exclusive owners of this brand. Unfortunately for a defendant the overall getup of the bags along with the word Appu and baby elephant was also almost identical in its features and coloured schemes. The defendant was enjoined from using the trademark.

The use of registered trademarks as part of corporate name came up once again in the case of Citi Group Inc. Vs. Citi Corp. Business & Finance Pvt. Ltd. The plaintiff Citi Group Inc. is the owner of the series of trademarks and names all starting with the four letters CITI, the most well known being Citi Bank. It has been using the mark Citi in India since 1992. The defendant on the other hand provides financial services under the name Citi Corp. Business & Finance Pvt. Ltd. The defendant has been doing the activity only in the city of Kolkata. As usual the defendant pleaded that the Delhi High Court did not have jurisdiction. Because of the fact that Citi Bank had its operation in Delhi, the Delhi High Court thought it fit to accept jurisdiction unto itself. After going through the facts the Court thought it fit to restrain the defendant from using Citi Corp. as part of its corporate name but granted it 6 months time to change its name.

The Deere Company vs. Harcharan Singh case is a rare case dealing with colour combinations. Deere Company sells its farm equipment under its well known trademark John Deere and in distinctive colours bright yellow and green. The plaintiff is also the owner of a colour trademark containing the bands green and yellow. The defendant started selling farm equipment including tractors under the mark Surindera but the products including tractors were painted in the same shades of green and yellow holding that the use of the colour schemes green and yellow infringe the trademark of Deere Company. The Court, inter alia restrained the defendant from using the colour scheme green and yellow on its products.

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<sup>1</sup>Institute for Inner Studies & Ors. V. Charlotte Anderson & Ors. MIPR2014(1)129, 2014(57)PTC228(Del)

<sup>2</sup>Ultratech Cement Limited V. Dalmia Cement Bharat Limited 2015(1) ALLMR339, 2014(59)PTC484(Bom)

<sup>3</sup>Sirmour Remedies Private Limited V. Kepler Healthcare Private (2014)2CALLT357(HC)

<sup>4</sup>SabMiller India Ltd.V. M.P. Beer Products Pvt. Ltd. 2014(4)ABR674, 2014(3)ALLMR665, 2014(3)BomCR754, 2014(58)PTC571(Bom)

<sup>5</sup>Disney Enterprises Inc. & Anr. V. Balraj Muttneja & Ors. DLHC CS (OS) 3466/2012

<sup>6</sup>Microsoft Corporation & Anr. V. Jayesh & Anr 2014ivAD(Delhi)571

<sup>7</sup>Mex Switchgears Pvt. Ltd. V. Max Switchgears Pvt. Ltd 2014(58)PTC136(Del)

<sup>8</sup>Sanjay Kapur V. Dev Agri Farms Pvt. Ltd. DLHC C.S. (OS) 851/2012

<sup>9</sup> The Coca-Cola Company & Anr. V. K. M. Salim DLHC CS(OS) 102/2013,

<sup>10</sup>Castrol Ltd. V. Pandit Oil Company 2014(59)PTC406(Del)

<sup>11</sup> Fantech Pty. Ltd V. Adept Fantech India Pvt. 2014(59)PTC136(Del)

<sup>12</sup>M/s. Vijay Solvex Ltd. V. Shree Hari Agro Industries Ltd. and Anr. AIR2014Raj163, 2014(3)CDR1537(Raj), 2014(58)PTC602(Raj)

<sup>13</sup>@Road Inc. V. E-Logistics Pvt. Ltd. (2014)4MLJ1

<sup>14</sup>Tudor International V. Arree Clothing Inc. 2014VIAD(Delhi)777, 210(2014)DLT417, 2014(143)DRJ247, 2014(59)PTC157(Del), 2014(58)PTC535(Del)

<sup>15</sup> 210(2014)DLT513, MIPR2014(2)357

<sup>16</sup>Allied Blenders and Distillers P. V. Sentino Bio Products P. Ltd.213(2014)DLT464

<sup>17</sup>Stiefel Laboratories, Inc & Anr V. Ajanta Pharma Ltd. DLHC CS(OS) No. 2373/2013

<sup>18</sup>People Interactive (I) Pvt. Ltd. V. Gaurav Jerry MANU/MH/1087/2014

<sup>19</sup>Techlegal Solutions Pvt. Ltd V. Genelia Ritesh Deshmukh 2014(4)BomCR822, 2014(59)PTC510(Bom)

<sup>20</sup>Medley Pharmaceuticals Ltd V. Twilight Mercantiles Ltd. 2014(5)ABR436, 2014(60)PTC85(Bom)

<sup>21</sup>M/S. South India Beverages Pvt. Ltd. V. General Mills Marketing Inc. 214(2014)DLT123

<sup>22</sup>Alkem Laboratories Limited V. Elnova Pharma High Court Of Himachal Pradesh CS 38 201

<sup>23</sup>2014 (5) AWC 4353 (SC), 2014(4)CDR906(SC), 2014(145)DRJ527, 2014(60)PTC465(SC), 2014(9)SCALE146, 2014 (3) WLN 138 (SC)

<sup>24</sup>Lt Foods Ltd. V. Sachdeva & Sons Rice Mills Ltd. 215(2014)DLT39, MIPR2014(3)118, (2014)176PLR42, 2014(60)PTC27(Del)

<sup>25</sup>Maruti Suzuki India Ltd. V. Kavisha Motors Agra Pvt. Ltd. DLHC CS (OS) No. 1483/2011

<sup>26</sup>Neon Laboratories Ltd. V Themis Medicare Ltd. MIPR2014(3)224, 2014(60)PTC621(Bom)

<sup>27</sup>Rajesh Jain V. Amit Jain 2014(145)DRJ694, 2014(60)PTC526(Del)

<sup>28</sup>World Wrestling Entertainment, Inc. V. Reshma Collection 2014(60)PTC452(Del)

<sup>29</sup>4 Life Trademarks LLC V. Aanchal Jain MIPR2014(3)235, 2014(60)PTC354(Del)

<sup>30</sup>Hindustan Pencils Pvt. Ltd. V. Anand Kumar Bajaj DLHC CS (OS) 1438/2011

<sup>31</sup>Glaxo Group Limited V. Indkus Drugs & Pharma Pvt. Ltd. DLHC CS (OS) 1841/2010

<sup>32</sup>Micromax Informatics Ltd. V. Shenzhen Oneplus Technology Co. Ltd. DLHC CS (OS) 3761/2014

<sup>33</sup>Rolex SA V. Alex Jewellery Pvt. Ltd. 215(2014)DLT6, 2014(60)PTC131(Del)

<sup>34</sup>Marico Limited V. Pratik Goyal 214(2014)DLT539, 2014(60)PTC185(Del)

<sup>35</sup>DLHC W.P. (c) No. 3679/2014 and DLHCCM No. 7455/2014

<sup>36</sup>Sanofi India Ltd. V. Universal Neutraceuticals Pvt. Ltd. MIPR2014(3)183, 2014(60)PTC593(Del)



<sup>37</sup>DLHC CS(OS) 1151/2014

<sup>38</sup>Maja Health Care Division V. Trance International DLHC CS(OS) 99/2013

<sup>39</sup>M.F.A. No. 2187/2014 (IPR) High Court of Karnataka

<sup>40</sup>Citigroup Inc. V. Citicorp Business and Finance Pvt. Ltd. DLHC CS (OS) No. 1789/2013

<sup>41</sup>Deere & Co. V. S. Harcharan SinghDLHC CS (OS) No. 3760/2014