



India: Registered Proprietor of a Trademark injunctioned from using its Trademark by the Delhi High Court

In a recent decision by the Delhi High Court, Hon'ble Justice Manmohan granted an injunction against the defendant who was also the registered proprietor of the impugned trademark for persistent conduct of selling products bearing the mark AMIR'S, and more importantly, for wrongly obtaining a registration of their mark AMIR in Class 3.

Brief Facts:

M/S Ishar Dass Amir Chand (hereinafter referred to as the 'Plaintiff') claimed to be the prior adopter and registered proprietor of the trademark AMIR'S in Class 3 and is stated to be engaged in the business of cultivating Henna and in manufacturing and exporting the same as natural Henna powder under the said mark. The Plaintiff is stated to be continuously and uninterruptedly using the mark AMIR'S for its products since 1996.

Claims of the Plaintiff

The Plaintiff also claims to be the registered proprietor of the product label, and contended that the color combination, trade dress and get-up of the label/packaging of their product constituted an 'original artistic work' under Section 2 (c) of the Copyright Act, 1957. Their trade mark AMIR'S along with its label had acquired a heightened degree of distinctiveness owing to the exclusive, extensive and continuous use of the same since 1996. In support of this contention, the Plaintiff proved its original sale invoices showing sales and exports for the period 1996 to 2014.

The Plaintiff further claimed that, Mr. Jagdish Babu Sharma (hereinafter referred to as 'Defendant') who is the Director of Defendants No. 2 and 3 companies, are engaged in manufacturing, selling and exporting henna and henna based dyes under the mark AMIR'S with identical trade dress/get-up as that of the Plaintiff's product. Plaintiff exhibited the Defendant no. 2's certificate of incorporation which shows that it was incorporated on May 17, 2001. Further, the Defendants had wrongly obtained a registration of the impugned mark AMIR in Class 3 for which the Plaintiff had filed rectification and cancellation applications. In second week of August,



2015, it came to the knowledge of the Plaintiff that despite the orders passed by the Food and Drugs Administration cancelling the license of the Defendants, pursuant to complaints made by the Plaintiff, the Defendants continued to illegally manufacture, sell and export their products under the impugned trade mark as well as trade dress/get-up deceptively similar to that of the Plaintiff.

Aggrieved by the conduct of the Defendants, the Plaintiff had prayed for an *ex parte* ad interim injunction before the Delhi High Court and the Court had granted the said injunction in favor of the Plaintiff and against the Defendants on September 21, 2015 restraining the Defendants and it's agents from manufacturing, selling, offering for sale or exporting Henna/Henna based products under the mark, "AMIR's/AMIR" or any other mark that is identical/deceptively similar to the Plaintiff's trademark, "AMIR'S", which was registered prior in time.

The Court had further observed that as on date, the Defendants enjoy a registration in the mark, "AMIR" and "AMIR (Device of Lady)" and even as per the Plaintiff, they have remained in the market for some time, hence, it is deemed appropriate to grant the Defendants a period of two months to make compliances of the aforesaid order.

However, as the Defendants entered appearance only on two occasions and did not file their written statement within the stipulated time granted, their right to file written statement was closed vide order dated August 12, 2016. Thus, the Defendants were proceeded *ex-parte* by this Court vide order dated October 27, 2016 and the interim injunction was made absolute.

Decision of the Court

Having perused the papers and having heard the Learned Counsel for the Plaintiff, Hon'ble Mr. Justice Manmohan of the Delhi High Court was of the view that, since the averments in the plaint have not been rebutted by the Defendants as they did not bother to put forth their stand, in spite of ample opportunities given to them, they are deemed to be admitted.

Further, the Court was of the view that color combination, trade dress and get-up of the label/packaging of the Plaintiff's product constitutes an 'original artistic work' under Section 2 (c) of the Copyright Act and the Plaintiff has the exclusive right to use and produce the same under Section 14 of the Copyright Act. The use of the impugned AMIR'S Henna label by the Defendants which is a colorable imitation and substantial reproduction of the Plaintiff's AMIR'S Henna Label/logo in respect of its overall color combination, lay out and arrangement of features and get up constitutes infringement of copyright of Plaintiff's product under Section 51 of the Copyright Act and is liable to be enjoined under Section 55 of the Copyright Act.



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A D V O C A T E S

Additionally, the Defendants' impugned marks AMIR'S and AMIR are identical to the Plaintiff's mark. Even though both the Plaintiff's and Defendants' marks are registered, yet from the evidence on record, it is apparent that the Plaintiff is the prior adopter of the trade mark AMIR'S along with its label and has been using the same extensively since the year 1996. From the Plaintiff's sales figures it is also apparent that the product of the Plaintiff under the trade mark AMIR'S along with its label and get up, in particular the color combination of green and white has acquired distinctiveness and is identified as originating from the Plaintiff. The use of the impugned trade mark/trade dress/label comprising of box design, label including the overall color combination of golden and white by the Defendants for domestic and export sales is likely to cause confusion and/or deception in the minds of the consumers on account of imperfect recollection and the overall similarity and idea conveyed by the trade dress and packaging of both the parties. In fact, the adoption of the impugned trade mark AMIR'S and its packaging by the Defendants would invariably cause confusion and deception on account of being visually, structurally, phonetically and deceptively identical to the Plaintiff's mark and its packaging. The use and export of the impugned trade mark AMIR'S and its packaging by the Defendants constitute acts of misrepresentation, misappropriation and passing off.

Keeping in mind the aforesaid facts and contentions, the mandate of the law and the persistent conduct of the Defendants in selling products bearing the mark AMIR'S/AMIR, the suit is decreed in favour of the Plaintiff and the Plaintiff shall be entitled to costs including monies spent on Court-Fees, Local Commissioner's Fees and other expenses, etc.