



## Who owns it?

The Calcutta High Court recently ruled that only the owner of a trademark can sue for its infringement. Lucy Rana and Bijit Das SS Rana & Co report

The Calcutta High Court ruled in favour of Three Leaves India on 27 June, rejecting the plea of the petitioner for extending the ad interim order of injunction. In the present matter, the court also noted that a trademark infringement case can only be filed by the registered proprietor or the authorised licensee, and not by the user of the trademark.

The respondent, Three Leaves India, was restrained from selling and/or offering for sale or market tea in a packet, the labels of which contained 'Nowalty', due to similarities with the petitioner's logo and product, 'Lipton'.

It was further argued before the court that the word 'Lipton' is a registered trademark written in a distinct artistic typeface in a unique shape. It was argued that the respondent not only infringed the trademark but also passed off its product with a style that was deceptively similar to the trade design of the petitioner's product.

The respondent's advocate submitted that the trademark infringement suit was not maintainable before the court in view of Sections 52 and 53 of the Trade Marks Act, as the registration of 'Lipton' stood in the name of Unilever, a company registered under the laws of England. The moment those arguments were advanced by the respondent, the advocate for the petitioner instead contended that the suit was filed for copyright infringement rather than trademark infringement and passing off.

According to the petitioner, Section 62 of the Copyright Act of 1957 confers jurisdiction upon the Calcutta High Court and so the suit was maintainable. The petitioner further pointed out that the artist had assigned the artistic work to it, meaning it had the right to initiate an action the moment the infringement was realised.

Finally, the cause of action for infringement of a copyright was averred and pleaded and, therefore, the suit should not have been



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**Lucy Rana**, Managing associate advocate, SS Rana & Co

construed to have been founded upon the original trademark infringement and passing off claims.

The respondent argued that there had been a gross suppression of material facts and the attention of the court had not been drawn to the relevant paragraphs of the petition where it would have discerned that the entire case was founded on an infringement of a trademark and passing off. The respondent also highlighted several paragraphs of the petition where the petitioner categorically stated that it had a licence to the 'Lipton' trademark and possessed related trade dress rights.

There was no restriction on the court to refuse or extend the ad interim order on the returnable date before inviting the respondent to disclose facts in the form of affidavit if the materials produced by the respondent were sufficient enough to demolish the case made out in the complaint and injunction application, added the respondent.

The respondent referred to the statutory definition of a trademark, which means a mark capable of being represented graphically and is able to distinguish the goods or service of a person from those of others.

It may include the shape of the goods, packaging and a combination of colours. The respondent further drew the attention of the court to a definition of the registered trademark to mean the trademark that is actually on the register and is in force.

On the case of passing off, the respondent contended that it conducted business outside the jurisdiction of the court, meaning the present matter was not maintainable.

The petitioner also exploited its resources in securing police assistance and help rendered to the special officer in carrying out

the directions, passed on 12 May 12 2016, when the order did not indicate such police help.

A meticulous reading of the complaint would reveal that the petitioner categorically stated that it had a licence to the 'Lipton' trademark and possessed related trade dress rights, the court ruled.

The substantive reliefs claimed in the complaint were based on trademark infringement and passing off, except one, where the petitioner also claimed a decree of permanent injunction against the respondent from infringing the copyright. Apart from a solitary prayer, the court did not find any averments pertaining to its jurisdiction under the provisions of the Copyright Act, and neither the complaint nor the injunction application included material documents relating to an assignment of the trademark in favour of the petitioner.

An ad interim order in interlocutory proceedings does not necessarily bind the court or the parties at the later stage of the proceedings.

An ad interim order is usually made on the basis of the petitioner's version of things, which is supported by an affidavit and the documents relied upon in the petition. If the ad interim order is made ex parte, the respondent is permitted to present its version or documents to detract from the petitioner's case, on the returnable date.

The petitioner in this case misused and mutualised its resources in procurement of the police help to render assistance to the special officer appointed by the court in carrying out the directions passed on 12 May 2016. Finally, the court ruled that the ad interim order was obtained by misleading the court and caused immense suffering to the respondent.

The court declined to extend the ad interim order of injunction and also imposed a cost assessed at approximately US \$3,000 to be paid by the petitioner to the respondent. [IPPro](#)



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**Bijit Das**, Associate advocate, SS Rana & Co