



IP Law & Remedies

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Intellectual Property



- Limited Monopoly
- Exception to the rule against monopoly
- Granted for a public purpose – incentive for creativity

Dramatis Personae

- Reasonable Man (Administrative Law)
- Person having skill in the Art (Patent)
- Informed User (Design)
- Average consumer of imperfect recollection TM
- Average lawyer with 3 to 4 years experience
(Target of this Webinar)

Essentials Of Ubi Jus Ibi Remedium:

This legal maxim is applicable only when any legal injury has occurred to any person, if no legal injury is caused then the legal maxim *damnum sine injuria* is used which implies that any harm without any legal injury

Any unlawful or wrongful act must have been done which violates the legal rights of a person.

This maxim can be used only when sufficient relief has not been provided by the court to the person who sustained the injury.

This maxim can only be applied wherever this right exists and can be recognized by the court of law.

Limitations Of Ubi Jus Ibi Remedium:

We cannot apply this maxim if any proper remedy is given in case of any breach of rights under law.

This maxim cannot be applied to moral and political wrong which are not actionable.

If plaintiff is negligent or there is negligence by the side of the plaintiff then this maxim will not be applicable.

In case of public nuisance unless a plaintiff shows that he suffered more injury than other members of the society , this maxim will not be applicable.

Trade Marks Act - Remedies

- Sec. 83 – Establishment of IPAB
- Sec. 91 – Appeals from any order or decision of the Registrar within 3 months
- Sec.92 – Procedure and powers of IPAB
- Sec.93 – Bar of jurisdiction of courts
- Sec.95 – Conditions as to interim orders
- Sec.57 – Power of Registrar to cancel or vary registration/rectify register

Trade Marks Act - Remedies

- Sec. 122 – Protection of action taken in good faith
- Sec.124 – Stay of proceedings where validity of registration questioned – IPAB
- Sec.134 - Suit in District Court – where Plaintiff resides, carries on business or personally works for gain
- Sec.135 – Relief in suits for infringement/passing off: injunction; damages or account of profits; delivery-up of infringing labels/marks for destruction or erasure;
- Sec.136 - Registered User to be impleaded
- Sec.137 – Evidence of entries in register
- Sec.142 – Groundless Threats

Suit for Infringement (Sec.134)

Suit for Infringement or Passing off

- To be Instituted in District Court only
- Where plaintiff resides or carries on business

Burger King Corporation v. Techchand Shewakramani 2018(76)PTC90(Del)

The Plaintiff filed a suit, under S.134(2) of the Trade Marks Act and S.20 CPC, alleging infringement and passing off of its registered marks “BURGER KING” and “HUNGRY JACK’S” by the Defendant before Delhi High Court. The Defendant sought rejection of the plaint on the ground of lack of cause of action and lack of territorial jurisdiction of the DHC as the Defendant’s business was in Mumbai. The Court concluded that either Section 20 or Section 134 can be invoked when it comes to deciding the forum for initiating a trademark infringement suit. The Defendant’s application was rejected as the Court found that the Plaintiff made out a cause of action within the territorial jurisdiction of the Court as the Defendant had promoted the impugned mark in Delhi, entertained franchisee queries from Delhi, sought franchise requests through its website and publicly expressed their intention to expand their business across India.

Ratio: the provisions of Section 134 of the TM Act and Section 62 of the Copyright Act are in addition to and not in exclusion of Section 20 of the CPC. If the Plaintiff can make out a cause of action within the territorial jurisdiction of this Court under Section 20, no reference needs to be made to Section 134.

Reliefs in such suit - Sec.135

- The relief which a court may grant ...includes injunction and
 - at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringement labels and marks for destruction or erasure.
 - The order of injunction may include an ex parte injunction or any interlocutory order for any of the following matters, namely:-
 - (a) for discovery of documents;
 - (b) preserving of infringing goods, documents or other evidence which are related to the subject-matter of the suit;
 - (c) restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

Civil remedies

following forms of civil relief are available:

an interlocutory, temporary or *ad interim* injunction;

a Mareva injunction;

an Anton Piller order;

a John Doe order;

a permanent or perpetual injunction;

damages or accounts of profits; and

delivery up and destruction

UK COURT OF APPEAL, CIVIL DIVISION -Mareva Compania Naviera SA v International Bulkcarriers SA - 1980

The Shipowners issued a writ on 25 June 1975 claiming against the defendants, International Bulkcarriers SA (“the Charterers”), unpaid hire and damages for repudiation of a charterparty. The Defdts had sub-chartered to the President of India for carrying fertilisers. The Indian High Commission paid the sums due to a bank in London. The court of first instance felt court has no jurisdiction to protect a creditor before he gets judgment – yet ordered injunction till 23rd June. The parties appealed for extension.

Lord Denning MR

“If it appears that the debt is due and owing, and there is a danger that the debtor may dispose of his assets so as to defeat it before judgment, the court has jurisdiction in a proper case to grant an interlocutory judgment so as to prevent him disposing of those assets.”

Gujarat High Court - Galatea Ltd vs Diyora And Bhanderi Corporation - 2018

Plaintiffs, an Israeli company claim an invention pertaining to the determination of the location of inclusions (flaws and blemishes) in gemstones. Claim that the defdts have started manufacturing, selling and using certain machines, which directly infringe the Suit Patent.

Defdts deny averments – have filed revocation of Pltf patent; defdts are using an immersion technique using selenium, not infringing on Pltf.

Defdtss have raised substantial, tenable and credible challenge to the patent which raises a triable dispute, therefore, the plaintiff has failed to make out a prima facie case for the grant of ad interim injunction. Considerable doubt has been raised by this Court about the working of the patent in commercial sense and on the other hand, the defendants are stated to be in the business of manufacturing mirrors since the year 1993. Not granted.

- Is patent grant sufficient to prove validity?

Delhi High Court - Ten Xc Wireless Inc & Anr vs Mobi Antenna Technologies - 2011

The plaintiffs have instituted two suits for **permanent injunction, delivery up, damages and rendition of accounts** to restrain the defendants from manufacturing, distributing, selling, offering for sale, importing or in any other manner dealing with the infringing device/product violative of plaintiffs' registered Patent No. IN 240893 for the invention titled "Asymmetrical Beams for Spectrum Efficiency".

Section 13(4) of the Act expressly denies presumptive validity to the grant of a patent on account of search or examination undertaken by the Examiner under Sections 12 and 13 of the Act. In other words, the Act does not impute conclusiveness to the search or examination undertaken by the Patent Office, and the results thereof. The Act vests the Court with original powers to probe and verify for itself, the validity of a patent on the anvil of novelty, existence of an inventive step, and industrial applicability which is limited to the grounds that can be invoked under Section 64 (revocation of patents)

Madras High Court - M.C.Jayasingh vs Mishra Dhatu Nigam Limited -2014



The plaintiff got Patents and Designs registered for about 15 kinds of custom mega prosthesis invented and developed by him for shoulder, hip, elbow, wrist, knee, ankle, pelvic region, etc.

that the plaintiff has been manufacturing, marketing and selling various CMPs through another proprietary concern by name Arc Bio-Mechanical Engineers;

the first defendant is the sole producer of titanium and its alloy mill products and they enjoy monopoly status and they are fully aware of the product line of the plaintiff;

that the plaintiff and his proprietary concern have also been supplying CMP to the third defendant through its patients

that an operation had been performed at the second defendant hospital, removing and replacing the cancer infested bone and knee joint of a 18 year old boy with a Prosthesis developed by Engineers of the first defendant's Bio-medical Division;

Not granted as infringement not proved.



Plaintiff



Administrative remedies

- Opposition against a similar mark (Sec.21);
- Rectification of a registered mark (Sec.57);
- Recordal with Customs to prevent the import or export of goods bearing the infringed trademark.
 - The IPR (Imported Goods) Enforcement Rules, 2007 in conjunction with the Customs Act offers trademark rights holders to register their trademark with the customs houses to stop the import of infringing and counterfeit products.
 - The said Rules provide for a mechanism for registering a trademark with the Central Board of Excise and Customs, whereby the concerned Customs offices shall watch out, seize and confiscate any goods that are found to be infringing or counterfeiting the said trademark.

Troll trademark

Halvar Flake
@halvarflake · Follow

Today in IP law: someone registered a trademark for CUGGL as a clothing brand in Japan, and sells shirts with the logo partially obscured. GUCCI sued, JP trademark office states that CUGGL is not similar enough to GUCCI to warrant enforcement.



1/2

★CUGGLペイント消しT お洒落な蛍光プリント！新品未使用

¥2,500 税込



JPO found similarities between the inverted crocodile and the original crocodile (of the brand). (Japan Trademark Review)



(Japan Trademark Review)



A 'Balehengana' T-shirt (Image credit: Parodys / Nobuaki Kurokawa)

Titan Industries vs. Nitin P. Jain 2006(32)PTC95(Del)

The question was whether the Plaintiff could claim both the relief, that is, for damages and for rendition of accounts together

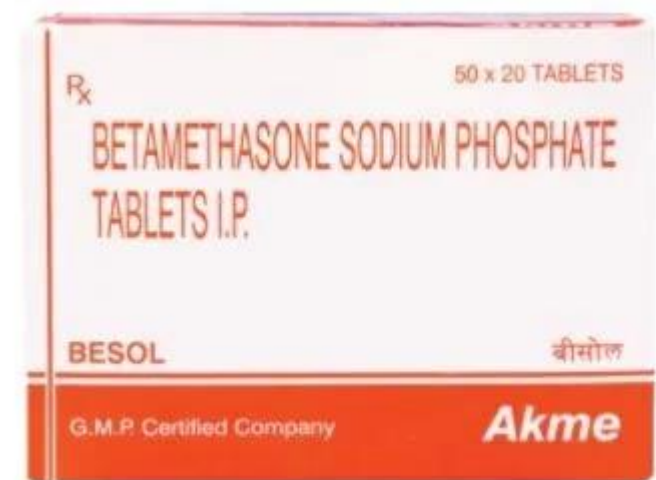
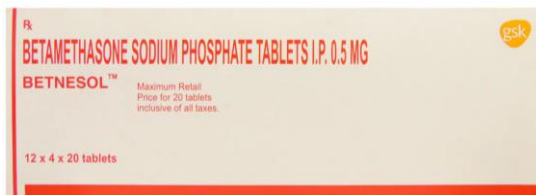
- Held, claimant was given an option to claim either damages or profits and such an option was exercisable at the conclusion of hearing of the case - Both the reliefs could be claimed in the alternative with right to the plaintiff to make an informed election between damages and profits in the course of trial.

Delhi High Court - Glaxo Group Limited vs Naresh Goel & Ors - 2022

seeking permanent injunction restraining trademark infringement, copyright infringement, and reliefs for passing off, acts of unfair competition, damages, rendition of accounts, freezing of assets, etc. against Defendants in respect of BETNESOL - Betamethasone Sodium Phosphate – in use as eye/ear drops and wide variety of allergies and inflammation

The imitation trade dress of the Defendants' tablets bearing the BESOL mark are in a silver-coloured aluminium strip packaging with red lettering.

No substantial difference between packaging – injunction gra



Meaning of Copyright – Sec.14

“Copyright” means the exclusive right subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely:—

(a) in the case of a **literary, dramatic or musical work, not being a computer programme**,—

- (i) to reproduce the work in any material form including the storing of it in any medium by electronic means;
- (ii) to issue copies of the work to the public not being copies already in circulation;
- (iii) to perform the work in public, or communicate it to the public;
- (iv) to make any cinematograph film or sound recording in respect of the work;
- (v) to make any translation of the work;
- (vi) to make any adaptation of the work;
- (vii) to do, in relation to a translation or an adaptation of the work, any of the acts specified in relation to the work in sub-clauses (i) to (vi);

Computer Programme

(b) in the case of a computer programme,—

(i) to do any of the acts specified in clause (a);

(ii) to sell or give on commercial rental or offer for sale or for commercial rental any copy of the computer programme:

(ii) to sell or **give on commercial rental** or offer for sale or for commercial rental any copy of the computer programme:"

Provided that such commercial rental does not apply in respect of computer programmes where the programme itself is not the essential object of the rental.

Sound Recording

(e) in the case of a sound recording,—

- (i) to make any other sound recording embodying it;
- (ii) to sell or give on hire, or offer for sale or hire, any copy of the sound recording, regardless of whether such copy has been sold or given on hire on earlier occasions;
- (iii) to communicate the sound recording to the public. Explanation.— For the purposes of this section, a copy which has been sold once shall be deemed to be a copy already in circulation.

Artistic Work

[\(c\)](#) in the case of an artistic work,—

[\(i\)](#) to reproduce the work in any material form including depiction in three dimensions of a two dimensional work or in two dimensions of a three dimensional work;

[\(ii\)](#) to communicate the work to the public;

[\(iii\)](#) to issue copies of the work to the public not being copies already in circulation;

[\(iv\)](#) to include the work in any cinematograph film;

[\(v\)](#) to make any adaptation of the work;

[\(vi\)](#) to do in relation to an adaptation of the work any of the acts specified in relation to the work in sub-clauses (i) to (iv);

Cinematograph Film

[\(d\)](#) in the case of a cinematograph film,—

[\(i\)](#) to make a copy of the film including a photograph of any image forming part thereof;

[\(ii\)](#) to sell or give on hire or offer for sale or hire, any copy of the film, regardless of whether such copy has been sold or given on hire on earlier occasions;

[\(iii\)](#) to communicate the film to the public;

Delhi High Court - Warner Bros. Entertainment Inc vs Http://Tamilrockers.Ws & Ors 2022

Issue an order and decree of permanent injunction restraining the Defendants – a torrent website

In the opinion of this Court, while blocking is antithetical to efforts to preserve a "free and open" Internet, it does not mean that every website should be freely accessible. Even the most vocal supporters of Internet freedom recognize that it is legitimate to remove or limit access to some materials online, such as sites that facilitate child pornography and terrorism. It has to be held that the defendant nos. 1 to 16 and 51 to 237 are 'rogue websites', with their primary purpose being to commit and facilitate infringement of the copyright of the plaintiff.

This Court is of the view that to ask the plaintiffs to identify individual infringing URLs would not be proportionate or practicable as it would require the plaintiffs to expend considerable effort and cost in notifying long lists of URLs to ISPs on a daily basis.

In UTV Software, the Court also examined the issue of **grant of dynamic injunctions** and permitted subsequent impleadment of mirror/redirect/alphanumeric websites which provide access to the rogue websites, by filing an application under Order I Rule 10 of the CPC before the learned Joint Registrar (Judicial) along with an affidavit with supporting evidence, confirming that the proposed website is mirror/redirect/alphanumeric website of the injuncted defendant websites. At the request of the learned counsel for the plaintiff, the same directions are liable to be made in this case also.

Copyright Act: Remedies

Chapter: XII – Civil Remedies

Sec.55 – Injunction, Damages,

Sec.56 – Separate Rights

Sec. 57 – Author's special rights

Copyright Act - Remedies

Sec.58 – Rights of owner against person possessing infringing copies

Sec.59 – Restriction in case of architectural works

Sec. 61- Owner of Copyright to be party

Sec. 62 – Jurisdiction

Sec.63 – Offence of infringement of Copyright or other rights



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Thank you

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