



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

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



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.

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.

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;

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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