

CASE LAWS



The Delhi High Court passed interim orders in the copyright infringement lawsuit filed by **Sholay Media & Entertainment Pvt. Ltd. & Anr. (“Plaintiff”)** against **Vodafone Essar Mobile Services Ltd. & Ors. (“Defendant”)**, **CS (OS) No. 490/2011**, regarding the sale and distribution of ringtones of songs from the Bollywood movie Sholay.

The bone of contention was the difference in the interpretation of the definition of ‘record’ and the scope of ‘any other device’ within its meaning under the Deed of Assignment signed between the parties in 1978.

The Plaintiff alleged that the Defendant had infringed its copyright as the rights assigned extended to (i) the right to make records for sale and distribution and (ii) the right to communicate the sound-recordings by way of radio broadcast. The Defendants had been using the clippings and songs from the movie and providing VAS to their customers through ringtones, caller tunes etc. The Defendants contended that they were granted all rights for exploitation of sound-recording on mobile cellular service. Hence, there was no ground for copyright infringement.

The Court opined that the crux of the issue was the definition of ‘record’ which was defined to include ‘disc, tapes or any other device in which sounds are to be embodied’. The entire case thus centered on ‘any other device’ could be extended to ringtones and digital medium. The Court held that the term “record” would include physical as well as digital device and the Defendants were allowed to use the sound-recording of the film Sholay through digital and mobile media subject to the condition that royalty paid to the Plaintiff as per the terms of Deed of Assignment would be inclusive of the royalty for use of the sound-recording through digital/mobile media.

The Delhi High Court in the matter of **Champagne Moet and Chandon (“Petitioner”) vs. Union of India and Ors. (“Respondents”), W.P. (C) 9778 of 2006**, has held that same trademarks can be registered for different classes of goods.

The Petitioner had registered the trade marks “MOET” and “MOET & CHANDON” under the Trade and Merchandise Marks Act, 1958 (the “TM Act, 1958”) in the years 1982 and 1985 respectively, in Class 33 for quality wines, spirits and liquor. The Petitioner contended that the adoption of the mark “MOET” Respondent, M/s Moets, a Delhi-based partnership firm, in Class 29 for meat, fish, poultry and meat extracts was dishonest as it had used two dots on letter ‘E’ and this was the essential feature of the Petitioner’s mark. The Respondent contended that the Petitioner had not been able to challenge the grant of registration of the trademark “MOET” in favor of the Respondent in Class 16 for paper packaging for ‘take away’ food and that the mark applied for registration under Class 29 was supported by evidences showing usage since the year 1968. It was further contended that due to the difference in goods of the parties, there arises no question of deception or confusion.

The Court concluded that the Petitioner had not satisfactorily established sale of its goods in India prior to 1980 and that none of the evidence provided by the Petitioner referred to the mark “MOET” alone, but to the composite mark “MOET & CHANDON”. In the light of the Respondent’s usage of the mark since 1967 and the fact that they were able to establish their goodwill in the trade regarding the mark “MOET’S”, the Court dismissed the plea of dishonest usage of the mark by the Respondent and allowed the mark to be registered by the Respondent.

In the case between **Gorbatschow Wodka KG v. John Distilleries Limited**, the shape of the bottle of Vodka gave rise to the controversy.

The Plaintiff was the manufacturer of “Gorbatschow Wodka” and had applied for registration of the shape of its bottle as a trade mark in January 2008 under Class 33 of the Trade Marks Act, 1999 (the “Act”), claiming prior use since December 1999 and the same was registered in various jurisdictions worldwide. The Defendant launched its Vodka by the mark “SALUTE” in the year 2008 and had obtained the design registration for the bottle in February 2008 under the Designs Act, 2000.

The Plaintiff alleged that the bottle adopted by the Defendant was deceptively similar to the bottle of the Plaintiff, which was inspired by the onion dome/ bulbous structure of the architecture of the Russian church and the same forms an integral part of its extensive trans-border reputation. It was further contended that under Section 2(zb) of the Act, the definition of “trade mark” includes the shape of the goods. The Defendant contended that there was no scope of confusion between the bottles due to the distinctive label and colours. Further, the Plaintiff’ product was premium Indian Manufactured Foreign Liquor (IMFL), the target consumer being the highly rich and educated and the test of passing off would have applied if the target consumer was of average intelligence and imperfect recollection.

The Bombay High Court held that the Plaintiff has not only established its trans-border reputation but also its reputation in the Indian market. The Court drew the fallacy of the submission of the Defendant that because the purchasers of the Plaintiff’s product are educated and affluent, likelihood of deception was minimal. Further, the registration of the bottle under the Designs Act, 2000 by the Defendant does not take away the right of the plaintiff to move an action of passing off. As the balance of convenience weighed in favour of the Plaintiff, the Court restrained the Defendant from commencing business using the disputed product.