

Roll No.

OPEN BOOK EXAMINATION

Time allowed : 3 hours

Maximum marks : 100

Total number of questions : 6

Total number of printed pages : 10

NOTE : *Answer ALL Questions.*

1. Read the following case study and answer the questions given at the end :

During 1901, the first Royal Enfield motorcycle was produced by The Enfield Cycle Company Limited at Redditch, England. The motorcycle was designed by Bob Walker Smith and Frenchman Jules Gobiet and was launched at the famous Stanley Cycle Show in London in November, 1901. The motorcycle was advertised in the newspapers including in The Autocar newspaper dated 21st December, 1901. In 1913, the first India Tourist Trophy race, Royal Enfield had won the first prize. After first Indo Pakistan war and considering the continued hostilities along the Cease-Fire Line (now known as Line of Control ('LOC')), the Government of India ('GOI') during 1951 looked out for the 'seize-proof motorcycles for Indian army to carry out patrolling at the inaccessible tracts along the Cease-Fire Line. The Plaintiff's Royal Enfield Bullet 350 was chosen as the most suitable bike for the job. Immediately, during 1952, 500 of such bikes were ordered by the GOI. The Royal Enfield Bullets gave a sterling service on the tough terrain of Kashmir and in scorching desert of Rajasthan. Thereafter,

subsequent orders were issued by GOI, with requirement to manufacture such bikes in India. An industrial license was granted with provision for the company to manufacture upto 5000 units per annum provided it followed a phased programme of making an ever-increasing number of components in India. This was the beginning of a relationship of paramount importance to Royal Enfield-with Indian Army and other armed forces. In 1955, the Redditch company partnered with Madras Motors in India to form 'Enfield India' to assemble, under licence, the 350 cc Royal Enfield Bullet motorcycle in Madras and The Enfield India Limited ('The Enfield India') was incorporated. Initially, it started with the assembling of Royal Enfield Bullets shipped from the Enfield Cycle Co. Ltd. of Redditch, at its plant in Madras, India. By 1962, all components were made in India. From 1977, Enfield India begins exporting the 350cc Bullet to the UK and Europe, since the year 1955, the plaintiff has been continuously, extensively and widely manufacturing and marketing their motorcycles in India under the distinctive trademark ROYAL ENFIELD. All plaintiff's products bear the house mark ROYAL ENFIELD and are sold across India and the globe. The plaintiff's ROYAL ENFIELD motorcycles are sold under several well-known brands like Royal Enfield, Bullet, Enfield, Royal Enfield Continental GT, Royal Enfield Thunderbird, Classic, Royal Enfield Himalayan, Royal Enfield Interceptor, Royal Enfield Hunter, Royal Enfield Meteor etc. The plaintiff's ROYAL ENFIELD motorcycles and accessories are sold extensively all over India and are also exported to over 70 countries viz. USA, Europe, Brazil, Thailand, Nepal, Australia, Colombia, etc. The plaintiff's motorcycles sold under the mark ROYAL ENFIELD by reason of their excellent quality and volume of sales have garnered enviable reputation and goodwill amongst the members of the trade

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and public and the mark ROYAL ENFIELD is always associated with that of the plaintiff only and to this day its Royal Enfield motorcycles stand as a symbol of power, toughness, elegance and to put it in a few words it still represents the legacy of “Royal Enfield-Made Like A Gun!”. The plaintiff’s manufacturing operations go through a series of modernization and improvement efforts, with a number of automated processes. Its products are known for their reliability, quality and toughness. The plaintiff has a state-of-the-art infrastructure to manufacture its vehicles and has an active in-house research and development wing (one in India and another one in United Kingdom) constantly at work to meet the changing customer/market preferences. At present, the plaintiff operates via various subsidiaries across multiple countries namely in the United Kingdom, Thailand, North America, Brazil and Canada. It operates through its dealers and distributors and by means of more than 1088 large format stores and 1024 studio format stores in major cities and towns across India and exports to multiple countries worldwide. Through its distribution network, the plaintiff has 187 exclusive stores in 22 countries and sells through about 724 multi-brand outlets and has over 1000 dealers/retainers around the world. The plaintiff has more than 1088 authorized dealers in India, all maintaining a similar Brand Retail Identity (BRI) and are operating outlets that are uniquely designed with distinguishing features which include distinctive interiors, exteriors, colour scheme and get-up which has become inalienably associated with the goods and business of the plaintiff apart from using the trademarks vesting with the plaintiff. This is an exercise done at considerable cost and effort, and with a uniform standard across the country and abroad, it was further claimed by the plaintiff that apart from selling the motorcycles, it also

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sells “bike care products, apparels and other products such as riding gear, rain suits, caps, T-shirts, readymade garments, jeans, trousers, jackets, gloves, helmets, head gears, boots and shoes, mugs, key-chains, bike covers etc.” under its various trademarks.

The plaintiff came to know that the defendant is using the identical name “ROYAL ENFIELD” for selling cosmetic items. This act of defendant is creating deception, confusion in the minds of the general public and creates an assumption that the products are those of the plaintiff company. The plaintiff thus, filed the suit for restraining the defendant from using the mark.

The defendant put forth his defence by stating that plaintiff mark is not registered for cosmetic items under Trademark Act and hence the plaintiff is not entitled to restrain them for using the mark of ROYAL ENFIELD.

Based on the above facts answer the following :

- (a) Will the plaintiff succeed ? Substantiate your argument with the help of decided cases.
- (b) How infringement of trademark by comparative advertising is dealt under Trademark Act, 1999 ? Explain with the help of decided cases.
- (c) Refusals of registration are criteria or conditions set by the trademark office that, if not met, can result in the rejection of a trademark application. Explain.
- (d) Discuss the doctrine of prior use under the Indian Trademark Act, 1999.

(10 marks each)

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2. Read the following case and answer the questions given at the end :

The plaintiff, Polymer India Ltd., is a leading manufacturer and distributor of quality products made using plastic moulding technology. Its products include toys, school furniture and playground equipment. The plaintiff is also the registered proprietor of the trademark 'PLAY' since 25th August, 2005.

The plaintiff sued eight defendants namely Playwell Impex Pvt. Ltd., Mayank, Ms. Meenakshi, Pawan, Vishal, Darshan, R.P. Associates and Funko India who are involved in manufacture and distribution of similar products. The plaintiff claimed relief of permanent injunction to restrain the defendants from infringing its copyright, common law rights in designs and passing off of deceptively similar products.

An ex parte ad interim injunction was granted to the plaintiff by a Court vide its order dated 7th August, 2015 and the goods of the defendants were seized by the Court Commissioner appointed vide the same order.

The plaintiff's contentions are :

- That the products of plaintiff are unique and conceptualised individually, which involves study of the market, preparation of the drawings, drawing a feasibility report, preparation of a new colour scheme, finalisation of dimensions, etc.

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- That the defendant Playwell Impex Private Ltd. is engaged in the business of manufacture, distribution and sale of toys in collusion with the other defendants including R.P. Associates who was earlier the distributor of plaintiff's products and Darshan, who is an ex-employee of the plaintiff. The defendant Playwell Impex Pvt. Ltd. has launched a range of toys which are identical and deceptively similar to the toys made by the plaintiff and is thereby passing off its goods as those of the plaintiff, infringing the bundle of intellectual property rights of the plaintiff in its products.
- That the toys manufactured and sold by the defendants under the brand FUNKID are a substantial re-production and colorable imitation of the products of the plaintiff.
- That there is a clear distinction between an original artistic work and a design derived from it for industrial application on a product. The original artistic work which may be used to industrially produce the designed article would fall within the meaning of artistic work defined under section 2(c) of the Copyright Act, 1957 and would be entitled to copyright protection as defined under section 2(d) of the Designs Act, 2000.
- That the defendants in their written statement have admitted the e-mail of the defendant Darshan to the defendant Playwell Impex Pvt. Ltd. forwarding the brochure of the toys of the plaintiff and therefrom it is evident that the defendant Playwell Impex Pvt. Ltd. is replicating from the brochure of the plaintiff.

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The defendants' contentions are :

- That the drawing in which the plaintiff claims a copyright does not constitute a design within the meaning of section 2(d) of the Designs Act, 2000 and is thus, not capable of being registered under the Act.
 - That the plaintiff has no right to claim protection of design without any registration.
 - That the plaintiff's toys which are being manufactured since the year 1992, are not novel and similar products are available in the market for a long time.
 - That the plaintiff's products to which the design has been applied have been reproduced by it, more than 50 times by an industrial process.
 - That the interim injunction granted is not justified when infringement is not proved.
- (a) Discuss in the light of the above case the relation between the Copyright Act, 1957 and the Designs Act, 2000.
- (b) Explain the copyright protection to foreign works in India. What are the conditions for such copyright protection in India ?

(6 marks each)

3. (a) Critically analyse the background and controversial cases for enacting the Geographical Indications of Goods (Registration and Protection) Act, 1999 in Indian scenario.
- (b) An Indian automobile company is interested in joint venture arrangement with a foreign company. It has, however, little knowledge about Due-diligence of intellectual property rights in a corporate transaction. Advise the company.

(6 marks each)

4. (a) Decisions of the Supreme Court of India relating to patents clearly indicate that the framework of Patent Law in India is utilitarian. Explain.
- (b) “The doctrine of equivalents has been accepted in the jurisprudence to protect patent rights from being infringed by infringers.” Elucidate the statement.

(6 marks each)

5. The block printing craft of Bagru is unique and has its own distinct character. This kind of art is said to have started around 450 years ago. The village Chippa or traditional community used these fabrics by hand. These traditional people came from Alwar, Madhopur, Jhunjhunu and some other districts of Rajasthan to permanently settle at Bagru. Bagru was historically recognized as producing more upscale products for royal clientele and for use in temples. The Print designs and colour are such that these are ideal for the rural folk. The design and colours of Bagru prints have been greatly improved and diversified to meet the requirement of the designers and export market. The Production requires high degree of coordination of eyes, hands and allied pressure on the blocks. The main tools of the printer are wooden blocks in different shapes—square, rectangle, oval, round and semicircular or crescent – and sizes called bunta. Blocks are hand-carved of seasoned teak wood and on the bottom face the motifs are engraved with steel chisels of different widths and cutting surface by the carver. Each block has a wooden handle and two to three cylindrical holes drilled into the block

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for free air passage and also to allow release of excess printing paste. The new blocks are soaked in oil for 10-15 days to soften the grains in the timber. These blocks sometimes have metal over the wood. The community approached you asking to protect their unique art.

- (a) Advice how this art can be protected under IPR to save the community artist of this region.
- (b) What is meant by legal auditing of Intellectual Property ?

(6 marks each)

6. (a) Sane Aztec Ltd. was in business of electroplating the internal surface of cylinders of internal combustion engines with a thin layer of nickel silicon carbide. The company employed Mr Rahul as a sales engineer from March, 2017 to September, 2018. Rahul, after resigning, started similar business under the name of Ultra Cylinders. Sane Aztec instituted a law suit against Rahul for breach of trade secrets and related it to the use of similar type of electroplating apparatus and list of customers. Rahul pleaded that electroplating process and apparatus was not a novel one and that the contract with the company was very vague about the confidentiality of information.

Will Mr Rahul succeed ? Give reasons in support of your answer.

(6 marks)

- (b) Cediff Communications registered the domain name “Cediff.com” with Net Solution on 15th February, 2017. On 31st January, 2018 Syberboot registered the domain name “Cardiff.com” with Net Solutions. Cediff communications (plaintiffs) incited proceedings under the Trade Marks Act, 1999 alleging that the Syberboot (defendants) had adopted the word “Cardiff” as part of their trading style deliberately to pass off their business services as that of the plaintiffs’.

Defendants pleaded that the word “Cadiff” is coined by taking the first three letters of the words catch, information and free. They further contended that the “look and feel” of the plaintiff’s website was totally different from that of the defendants’ website. They added that the users of the internet can never connect to a website by mistake as users of the website are persons skilled in the use of computer and hence there could be no possibility of confusion between the two names. Is the contention of the defendants valid ?

Can plaintiffs claim trade mark protection of domain names ? Give reasons in support of your answer.

(6 marks)

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