

All Things IP



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AllThings IP Newsletter – September 2020

Defence of delays or laches in trademark infringement claims - Validity – an Analysis

A trademark owner generally adopts the following prudent ways to preclude a person/entity (defendant) from infringing his trademark:

- Filing a notice of Opposition against a similar trademark if the mark is advertised in the Trademark Journal.
- Issuing of cease and desist notice against a similar trademark.
- Initiating infringement suit and/or passing off action against a similar trademark in order to preclude the infringer from using the similar mark in trade or commerce.

One of the most common defences that a defendant normally sets up against the action is that there are delays or laches on the part of the trademark owner bringing such an action thereby tantamount to acquiescence of the trademark owner in the defendant's use of a similar trademark.

Whether mere silence or inaction from the trademark owner will be construed as acquiescence?

Acquiescence means “*acceptance or agreement*” and the same cannot be inferred merely due to silence or inaction on the part of the trademark owner against the infringement of his rights.

It is a judicially settled position in India that to use a defence of acquiescence, there should be a tacit or an express assent by the plaintiff to the defendant's use of the mark. A mere failure to sue without a positive act of encouragement cannot be a valid defence for the defendant and is not acquiescence on the part of the trademark owner/ plaintiff.

The Supreme Court of India has, while adjudicating on various matters, held that acquiescence would arise only out of positive acts and not merely by silence or inaction (*Power Control Appliances and Ors v Sumeet Machines* [1994]).

The above principles have been reiterated by the Bombay High Court in the matter of *Emcure Pharmaceuticals v Corona Remedies* (2014) where it held that a mere failure to sue without a positive act of encouragement is no defence and is not acquiescence.

Further, examining the concept of “acquiescence”, it was observed that: “He who possesses a legal right must have encouraged the alleged violator of that right in acting to the latter's detriment, confident in the knowledge that the former is not asserting his rights against the violator.”

This was confirmed in October 2019 by the Delhi High Court in the matter of *Make My Trip (India) v Make My Travel (India)* whereunder, while rejecting the plea of acquiescence set up by the defendant it was opined that: “In order for a defence of acquiescence to succeed, there must be an express abandonment of the right to exclusivity on the part of the plaintiff.”

It is important to bear in mind the above judicial principles while initiating/defending infringement actions. We, at Eshwars, have been assisting our clients in taking informed decision while initiating action against the infringing marks and we have expertise in IP litigations in addition to prosecutions. Feel free to contact us at saisunder@eshwars.com for any assistance in respect of IP matters.

