

All Things IP



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LEGAL REMEDIES IN CASE OF INFRINGEMENT AND PASSING OFF OF TRADEMARKS

Registration gives the proprietor an exclusive right to use the trademark in relation to the goods/services for which it is registered. Registration of a trademark prima facie evidences the validity of a trademark vis-à-vis the trademark proprietor.

In case of infringement of trademarks in India, a trademark proprietor has both civil and criminal remedies to stop the unauthorized use of his trademark.

Civil Remedies

With a view to restrain the impugned person from unauthorized use of a trademark, a trademark owner can initiate legal action before the civil courts seeking the following remedies:

1. INJUNCTION

- The Courts, either through an interlocutory or permanent injunction, grants protection to the trademark owner by restraining the infringer from using or in any manner applying the trademark(s) in question.
- In some cases courts also grant an Anton Piller order. In these kind of orders, the Courts may appoint a local commissioner for search, seizure and preservation of infringing goods, documents or other evidence, etc. in addition to the injunction against use of the trademark(s) in question.
- A John Doe order – Such type of injunction orders are passed by the Courts when the identity of the infringers are not known.

2. DAMAGES

An aggrieved trademark owner can also seek monetary compensation from the impugned party in the name of damages to recover the losses faced by him on account of the infringement and/or passing off.

3. SEEKING CUSTODY OF INFRINGING MATERIALS

Under this remedy, the Court may ask the infringing party to deliver or surrender all goods with the infringing labels. This remedy is commonly sought in relation to counterfeit and pirated goods.

Criminal and Penal Remedies

- Falsifying and falsely applying a trademark is a crime. Under Section 103 and 104 of the Trademarks Act, 1999 (“the Act”), any person who falsifies or falsely applies a trademark or sells such goods/services shall on conviction be punished with imprisonment of not less than 6 months to a maximum of three years and a fine of a minimum of Rs. 50000 to a maximum of 2 lakhs.
- The offences under Section 103, 104 and 105 are Cognizable and Non-Bailable offences. No court inferior to that of a Metropolitan Magistrate or Judicial Magistrate of the first class shall try an offence under the Act. Further, any officer not below the rank of a Deputy Superintendent of



Police can initiate suo moto/ex-officio action but will have to obtain an opinion from the registrar of Trademarks as provided under Section 115 of the Act, before any such action.

- The Trademark owner can also file a criminal complaint under Section 156 of the Code of Criminal Procedure, 1973. In case of refusal by the police to lodge an FIR or initiate criminal action, Sub section 3 of Section 156 provides that the aggrieved party can file a complaint before the Magistrate for issuance of summons and trial of the infringers, the detailed procedure whereof is given in section 190 of the Code of Criminal Procedure, 1973.
- In order to fast track the process, a search warrant can also be obtained by directly approaching the magistrate court, as per the procedure laid down under Section 93 of Code of Criminal Procedure, 1973.

We at Eshwars regularly advise our clients on various Trademark & IPR enforcement and infringement matters and for more information please reach out to us at: saisunder@eshwars.com.