

Sandick Intellectual Property Ab vs Sanvik Coresoft Llp on 25 July, 2024

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IN THE HIGH COURT OF DELHI AT NEW DELHI
CS(COMM) 602/2024 & I.A. 34033/2024, I.A.
34035/2024, I.A. 34036/2024 & I.A. 34037/2024

SANDICK INTELLECTUAL PROPERTY AB

SANVIK CORESOFT LLP

Through:

CORAM:

HON'BLE MS. JUSTICE MINI PUSHKARNA
ORDER

% 25.07.2024 I.A. 34035/2024 (Exemption from filing clear/certified copies of documents)

1. The present is an application under Section 151 of the Code of Civil Procedure, 1908 ("CPC"), on behalf of the plaintiff, seeking exemption from filing translated copies, clearer copies/documents with correct margins.

2. Exemption is granted, subject to all just exceptions.

3. Applicant shall file legible, clear, and original copies of the documents, on which the plaintiff may seek to place reliance, within four weeks from today, or before the next date of hearing.

4. Accordingly, the present application is disposed of.

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5. This is an application seeking leave to file additional documents under the Commercial Courts Act, 2015.

6. The plaintiff, if it wishes to file additional documents at a later stage, shall do so strictly as per the

provisions of Commercial Courts Act, 2015 and the Delhi High Court (Original Side) Rules, 2018.

7. The application is disposed of, with the aforesaid directions. I.A. 34037/2024 (Application seeking extension of time to file documents under Section 63(4)(C) of the BSA)

8. This is an application under Section 151 CPC seeking extension of thirty days for filing hash report and certificate of expert under Section 63(4)(c) of Bharatiya Sakshya Adhiniyam, 2023 ("BSA").

9. In view of the averments made in the application, the same is allowed and extension sought is granted.

10. Let the needful be done, accordingly.

11. With the aforesaid directions, the application is disposed of. I.A. 34036/2024 (Exemption from Pre-Institution Mediation)

12. The present is an application under Section 12A of the Commercial Courts Act, 2015 read with Section 151 of CPC for exemption from undergoing Pre-institution Mediation.

13. Having regard to the facts of the present case and in the light of the judgment of Supreme Court in the case of Yamini Manohar versus T.K.D. Keerthi, 2023 SCC OnLine SC 1382, and Division Bench of this Court in Chandra Kishore Chaurasia Versus RA Perfumery Works Private Ltd., 2022 SCC OnLine Del 3529, exemption from attempting Pre-Institution Mediation, is granted.

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14. Accordingly, the application stands disposed of. CS(COMM) 602/2024

15. None appears for the defendant despite advance service.

16. Let the plaint be registered as suit.

17. Upon filing of the process fee, issue summons to the defendant by all permissible modes. Summons shall state that the written statement be filed by the defendant within thirty days from the date of receipt of summons. Along with the written statement, the defendant shall also file affidavit of admission/denial of the plaintiff's documents, without which, the written statement shall not be taken on record.

18. Liberty is given to the plaintiff to file replication within thirty days from the date of receipt of the written statement. Further, along with the replication, if any, filed by the plaintiff, an affidavit of admission/denial of documents of the defendant, be filed by the plaintiff, without which, the

replication shall not be taken on record. If any of the parties wish to seek inspection of the documents, the same shall be sought and given within the timelines.

19. List before the Joint Registrar (Judicial) for marking of exhibits on 17th September, 2024.

20. List before the Court on 26th November, 2024.

I.A. 34033/2024 (Application under Order XXXIX Rules 1 and 2 CPC)

21. The present suit has been filed for permanent injunction restraining trade mark infringement, passing off, acts of unfair competition, seeking damages/rendition of accounts and other appropriate relief.

22. Learned counsel appearing for the plaintiff submits that the plaintiff uses numerous marks on and in relation to its goods and services. The mark This is a digitally signed order.

The authenticity of the order can be re-verified from Delhi High Court Order Portal by scanning the QR code shown above. The Order is downloaded from the DHC Server on 29/07/2024 at 23:08:50 'SANDVIK' is the plaintiff's house mark and corporate name and has been used by the plaintiff on a worldwide basis since as early as the year 1876.

23. It is submitted that since the first use began, the mark 'SANDVIK' has been used on and in relation to mining, metal cutting and manufacturing, digital manufacturing solutions, tool management solutions, metrology solutions, software, etc. Over the years, the plaintiff has used and continues to use, marks that incorporate the 'SANDVIK' marks:

24. It is submitted that in the year 2023, the plaintiff adopted a new logo inspired by its 1962 'SANDVIK' logo, as a tribute to the company's long history and heritage, which is as follows:

25. Learned counsel for the plaintiff submits that the plaintiff is seeking relief in the present suit against the defendant's unauthorised adoption and use of the defendant's 'SANVIK' marks in the defendant's corporate name, corporate logo, on and in relation to software, IT consulting and development services, cloud services, e-commerce, website and mobile applications development services, digital marketing, CMS support services as well as part of its domain name.

26. It is submitted that the word 'SANDVIK' does not have any meaning in the English language, nor does it mean anything in Hindi or any Indian vernacular language. Thus, it is submitted that plaintiff's 'SANDVIK' name and marks are highly distinctive and entitled to the highest protection under This is a digitally signed order.

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27. It is submitted that for numerous years, the plaintiff has used and continues to use, the plaintiff's 'SANDVIK' name and marks, on and in relation to its goods and services in numerous countries around the world, including India. The plaintiff's 'SANDVIK' name and marks are also used in promotional and advertising materials, relating to its goods and services, as part of the plaintiff's domain names besides other use.

28. It is submitted that the plaintiff extensively markets and advertises its goods and services under the plaintiff's 'SANDVIK' name and marks, through both print and electronic media. Owing to its prominent use, the consumers associate the plaintiff's 'SANDVIK' name and marks solely and exclusively with the plaintiff and no one else.

29. It is submitted that owing to the plaintiff's extensive promotion and use of the plaintiff's 'SANDVIK' name and marks, the plaintiff has accrued tremendous goodwill in the plaintiff's 'SANDVIK' name and marks, and they are among the most famous and recognizable marks in the world today. In fact, the plaintiff's 'SANDVIK' name and marks have acquired the status of well-known marks under Article 6bis of the Paris Convention.

30. Learned counsel appearing for the plaintiff submits that the plaintiff is the proprietor of various registrations and/or applications for the plaintiff's 'SANDVIK' name and marks in India, which are as follows:

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31. It is submitted that as per the knowledge and belief of the plaintiff, the defendant is engaged in the business of providing, inter alia, Software, IT consulting and development services under the SANVIK and SANVIK CORESOFT LLP Device marks, which are as follows:

32. It is submitted that the plaintiff first became aware of the defendant in January 2024, when it came across the defendant's trademark applications to register the SANVIK CORESOFT LLP Device mark, which are as This is a digitally signed order.

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33. Attention of this Court has been drawn to the comparison between the plaintiff's 'SANDVIK' name and the defendant's 'SANVIK' marks, as follows:

34. Thus, it is submitted that the defendant's 'SANVIK' marks are clearly identical and deceptively similar to the plaintiff's 'SANDVIK' name and marks. The defendant has merely removed the letter

D from the plaintiff's SANDVIK mark to arrive at 'SANVIK' mark and has misappropriated the This is a digitally signed order.

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35. It is further submitted that defendant is dealing with similar and/or related goods and services for which the plaintiff uses and enjoys registration for the plaintiff's SANDVIK name and marks in India. Further, the trade channels and modes of dissemination of information about the goods and services, as well as the consumers of the defendant, will be similar to that of the plaintiff.

36. Further, the services of the defendant, which also pertain to software and IT services, will be offered to the same consumers. It is very likely that owing to the near identity of the rival marks, consumers may believe that the products and services under the defendant's 'SANVIK' marks are an extension of the plaintiff's range of products and services under the plaintiff's 'SANDVIK' name and marks. Thus, it is submitted that there is no doubt that the defendant's 'SANVIK' marks are likely to cause confusion among the consuming public, as to the source of the goods sold/services offered by the defendant.

37. It is submitted that given that the defendant and the plaintiff are involved in similar businesses, it is likely that the defendant adopted the defendant's 'SANVIK' marks with a mala fide intention to ride on the goodwill and reputation attached to the plaintiff's 'SANDVIK' name and marks. The defendant's mala fides become apparent from searches for the SANVIK CORESOFT LLP Device mark on the image search engines, This is a digitally signed order.

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38. Having heard learned counsel appearing for the plaintiff, the plaintiff has established a prima facie case in its favour. Balance of convenience also lies in favour of the plaintiff and against the defendant. Irreparable loss shall be caused to the plaintiff, if interim order, is not passed in favour of the plaintiff.

39. This Court notes that the plaintiff has been able to establish that the defendant's 'SANVIK' marks are nearly identical/deceptively similar to the plaintiff's 'SANDVIK' name and marks, and the rival goods are similar and/or related.

40. This Court also notes the submission of learned counsel appearing for the plaintiff that the trade channels and modes of dissemination of information about the goods and services, as well as the

consumers of the defendant, will be similar to that of the plaintiff.

41. Accordingly, this Court is of the view that there is likelihood of confusion, which includes a likelihood of association between the rival parties. The consumers might believe that the plaintiff has launched new goods and services under the defendant's 'SANVIK' marks, or that it has authorized the defendant's use of the defendant's 'SANVIK' marks, which is, actually not the case.

42. It is settled law that in cases where the marks are nearly identical/deceptively similar, and the goods/services are similar and/or related, and the trade channels/ target consumers are similar, consumer confusion must be assumed.

43. Accordingly, it is directed that till the next date of hearing, defendant, This is a digitally signed order.

The authenticity of the order can be re-verified from Delhi High Court Order Portal by scanning the QR code shown above. The Order is downloaded from the DHC Server on 29/07/2024 at 23:08:50 its partners, any other individuals, officers, managers, employees, agents, dealers, licensees, companies and retailers, or any persons/entities that are related or affiliated to defendant, and all other acting for and on behalf of the defendant, whether individually or collectively, are restrained from using the defendant's 'SANVIK' marks, including the SANVIK, , marks and marks that incorporate the defendant's 'SANVIK' marks, or any other mark, that is nearly identical/deceptively similar to the plaintiff's 'SANDVIK' name and marks including SANDVIK, , and marks, in any manner whatsoever, including, in relation to development, offering for sale, sale, display, advertising, marketing, whether directly or indirectly, and whether on the Internet or otherwise, any goods or services, including as a part of the defendant's corporate name or corporate logo; or as a part of the defendant's domain name or Email addresses also as part of defendant social media account profile names and handles.

44. Issue notice to the defendant by all modes.

45. Let reply be filed within a period of four weeks. Rejoinder thereto, if any, be filed within a period of two weeks thereafter.

46. Compliance of Order XXXIX Rule 3 to be done, within a period of ten days from today.

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47. List before the Court on 26th November, 2024.

MINI PUSHKARNA, J JULY 25, 2024 AK This is a digitally signed order.

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