

# Sandvik Intellectual Property Ab vs Sanvik Coresoft Llp on 27 March, 2025

**Author: Amit Bansal**

**Bench: Amit Bansal**

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IN THE HIGH COURT OF DELHI AT NEW DELHI

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Date of decision: 2

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CS(COMM) 602/2024 with I.A. 34033/2024 and I.A. 2547/20

SANDVIK INTELLECTUAL PROPERTY AB

...

Through: Mr. Urfee Roomi, Ms. Ja

Ms. Anuja Choudh

Ms. Vanshika Bansal, Ad

versus

SANVIK CORESOFT LLP

...

Through: None

CORAM:

HON'BLE MR. JUSTICE AMIT BANSAL

AMIT BANSAL, J. (Oral)

1. The present suit has been filed seeking relief of permanent injunction restraining the defendants from infringing the trademark, passing off along with other ancillary reliefs.

## CASE SETUP IN THE PLAINT

2. Plaintiff, Sandvik Intellectual Property AB, is an intellectual property holding company that is organised and existing under the laws of Sweden. The plaintiff is part of the renowned group of Sandvik group of companies.

3. Sandvik Group of Companies was founded in 1862 and is a leading multinational high-tech engineering company specialising in mining and rock excavation, rock processing, and metal cutting. The plaintiff group of companies is known for its innovative, digitalized, and sustainable engineering solutions that drive industry advancements. It is stated that the plaintiff group of companies prioritizes enhancing customer productivity, promoting sustainability, and ensuring safe operations across its business activities.

4. The plaintiff utilizes various 'SANDVIK' trademarks in connection with its goods and services. The mark 'SANDVIK' functions as the plaintiff's house mark and corporate name and has been in continuous and extensive use on a global scale since 1876. It is stated that from the inception of its

use, the 'SANDVIK' mark has been applied to and is inherently associated with mining, metal cutting, manufacturing, digital manufacturing solutions, tool management solutions, metrology solutions, and software, among other offerings. Along with the word mark, the plaintiff has also adopted device marks for its goods and services.

5. In 2023, the plaintiff introduced a new logo , inspired by its 1962 'SANDVIK' logo, as a homage to the company's rich history and legacy. It is stated that the plaintiff's new brand identity reflects its strategic shift towards integrating hardware, software, and digital solutions within the mining, manufacturing, and infrastructure industries. This transformation is aimed at enhancing sustainability and productivity for customers on a global scale.

6. It is stated that the plaintiff's association with India dates back to 1950, following an official invitation from India's first Prime Minister, Pt.

Jawahar Lal Nehru, to establish operations in the country. Since then, the plaintiff has continuously used its 'SANDVIK' name and marks in India and has significantly expanded its business operations.

7. To further strengthen its presence in India, the plaintiff has incorporated subsidiary companies, including Sandvik Coromant India Pvt. Ltd. (established in 1960) and Sandvik Mining and Rock Technology India Pvt. Ltd. (established in 2019).

8. Through a series of mergers and acquisitions with leading companies, the plaintiff has consistently expanded and diversified its product and service portfolio. In 2021 alone, the plaintiff acquired twelve (12) companies. Further, in 2024, the plaintiff announced the launch of Artificial Intelligence in CAM software in collaboration with Microsoft and its integration into future versions of its CAD/CAM software, including Cimatron, GibbsCAM, and SigmaEST. The plaintiff continues to expand its technology division by acquiring companies specializing in cutting-edge digital solutions and software.

9. The plaintiff has also expanded its business in software and digital solutions in India, integrating artificial intelligence and automation into its offerings. The plaintiff's Indian business was among the first to adopt CoroPlus Process Control, a real-time machining monitoring system. It has also played a key role in the digital transformation of Hindustan Zinc's Sindesar Khurd mine, utilizing the Sandvik OptiMine software platform.

10. Over the years, the plaintiff has obtained trademark registrations for the 'SANDVIK' name and marks for its diverse range of goods and services across multiple jurisdictions worldwide. These jurisdictions include, but are not limited to, India, the United States of America, the United Kingdom, Australia, the European Union, Canada, New Zealand, Indonesia, France, Malaysia, and China. The registrations obtained by the plaintiff in India are given below:

S. No.	Mark	Registration No.	Class
1.	SANDVIK	141520	6

2.	SANDVIK	1658699	9
3.		1673895	6, 7, 11, 12

10.1. Copies of the Certificates of Registration and Certificates of Renewal issued by the Trade Marks Registry are exhibited as Ex. PW- 1/20 (colly). 10.2. Certificates of Registration issued by the Trade Marks Offices of different countries have been exhibited as Ex. PW- 1/21 (colly).

11. It is averred that the term 'SANDVIK' holds no meaning in English, Hindi, or any Indian language and therefore it is liable to be protected.

12. The plaintiff has received numerous accolades over the years for its products, services, and contributions to the industry. In 2022, the plaintiff was awarded the 'CSR Project of the Year' for establishing the Sandvik Mine Automation Learning Centre ('SMAC') at IIT Dhanbad. The plaintiff also received the 'CSR Leadership Award' at the 5th Corporate Social Responsibility Summit & Awards 2022. Printouts of the online articles evidencing the awards won by the plaintiff in India are exhibited as Ex PW- 1/14 (colly).

13. Over the years, the plaintiff has experienced substantial growth in revenue due to its provision of services and sale of goods under the 'SANDVIK' name and marks. The annual revenue of the plaintiff for the years 2013 to 2023 has been exhibited as Ex. PW1/5.

14. Plaintiff actively promotes its products and services under the 'SANDVIK' name and marks in India through its official websites <https://www.home.sandvik/en/> and <https://www.sandvik.coromant.com/en-gb>. The plaintiff also employs these marks across its social media platforms and in various other commercial and digital engagements. Extracts from the aforesaid websites have been exhibited as Ex PW1/18 (colly). Additionally, the plaintiff has also acquired branding rights for the Phugewadi Metro Station in Pune, which is now called 'Phugewadi Sandvik'. Documents announcing the branding at the Phugewadi Metro station are exhibited as Ex PW-1/7 (colly).

15. Defendant, Sanvik Coresoft LLP, a limited liability partnership based in New Ranip, Ahmedabad, is engaged in the business of providing software, IT consulting, and development services under the SANVIK and device marks.

16. In January 2024, the plaintiff became aware of the defendant upon discovering the defendant's trademark applications, filed on a 'proposed to be used' basis, for the 'SANVIK CORESOFT LLP' device mark. Upon conducting further investigation, the plaintiff discovered the defendants were actively promoting its services through its website, [sanvikcore.com](http://sanvikcore.com), registered in November 2022, as well as on various social media platforms, including Facebook, Instagram, and LinkedIn.

17. Subsequently, on 22nd January 2024, the plaintiff filed Notices of Opposition against the defendant's trademark applications in Classes 9 and

35. In response, the defendant submitted counter-statements defending the adoption of the 'SANVIK' mark, claiming that it was derived from the initials of its partners' names 'SAN' from Sandip and 'VIK' from Vikas. The plaintiff, in turn, filed affidavits along with documentary evidence supporting its opposition.

18. On 10th April, 2024, the plaintiff also opposed another application by the defendant for the 'SANVIK CORESOFT LLP' device mark in Class 42.

19. Parallel to these proceedings, the plaintiff issued a legal notice to the defendant on 13th March, 2024, demanding cessation of the use of the SANVIK marks, withdrawal of trademark applications, transfer of the domain name SANVIKCORE.COM, and a change of the corporate name. On 20th March, 2024, the defendant issued a letter in reply to the legal notice wherein the defendant denied the plaintiff's claims and refused to comply.

20. The plaintiff issued a reply on 9th April, 2024, reiterating its position and addressing the defendant's contentions. It is stated that despite sending a follow-up reminder on 18th April, 2024, the defendant has failed to respond to the demands of the plaintiff and still continues to use the 'SANVIK' marks.

#### PROCEEDINGS IN THE SUIT

21. On 25th July 2024, this Court granted an ex-parte ad-interim injunction against the defendant restraining the defendant from using the mark 'SANVIK' or any other mark which is deceptively or confusingly similar to the plaintiff's 'SANDVIK' trademark.

22. In the order passed by the Joint Registrar on 17th September 2024, it was noted that the defendant has been served with the summons, sent through courier on 3rd September 2024 and through email on 28th August 2024. An affidavit of service has been filed by the plaintiff in this regard.

23. Since none had entered an appearance on behalf of the defendant and no written statement was filed on behalf of the defendant, the Joint Registrar, vide order dated 14th January 2025, closed the right of the defendant to file its written statement.

24. On 30th January 2025, the defendant was proceeded against ex-parte.

25. On 19th March 2025, the Joint Registrar concluded the recording of ex-parte evidence of the plaintiff's witness Mr. Harshit Gupta [PW1]. ANALYSIS AND FINDINGS

26. I have heard the submissions of the counsel and also perused the material on record.

27. The plaint has been duly verified and is supported by the affidavit of the plaintiff. In view of the fact that no written statement has been filed on behalf of the defendant, all the averments made in the plaint have to be taken to be admitted. Further, since no affidavit of admission/denial has been filed on behalf of the defendant in respect of the documents filed with the plaint, in terms of Rule 3 of the Delhi High Court (Original Side) Rules 2018, the same are deemed to have been admitted. The plaintiff has also led evidence of Mr. Harshit Gupta [PW1] affirming the facts of the plaint.

28. From the averments made in the plaint and the evidence on record, the plaintiff has been able to prove that it is the registered proprietor of the mark 'SANDVIK' and its formative marks. Due to its long and extensive use, the plaintiff has also been able to demonstrate and prove its goodwill and reputation in respect of the same.

29. The plaintiff has placed on record images of the defendant's impugned trademarks to show that the defendant is indulging in the infringement and passing off of the plaintiff's registered mark, 'SANDVIK' and other formative marks. A comparison table illustrating the similarities between the plaintiff's marks and the defendant's impugned marks is set out below:

**PLAINTIFF'S NAME AND MARKS DEFENDANT'S IMPUGNED NAME AND MARKS SANDVIK SANVIK**

30. From the comparison above, it is evident that the mark adopted by the defendant is deceptively similar to the plaintiff's 'SANDVIK' marks. The defendant has merely removed the letter 'D' from the plaintiff's 'SANDVIK' mark. Moreover, the defendant is also using a logo that is deceptively similar to the plaintiff's 'SANDVIK' device mark. The defendant's device mark also employs a font style similar to that of the plaintiff's 'SANDVIK' device mark. The changes are insufficient to distinguish the defendant's 'SANVIK' mark from the plaintiff's 'SANDVIK' mark. Thus, the rival marks, when viewed as a whole in its entirety have a similar appearance. Further, the services of the defendant also pertain to software and information technology (IT) services, which will be offered to the same consumers as that of the plaintiff.

31. The defendant's mala fide intention is also evident from the fact that, despite receiving a legal notice from the plaintiff, the defendant continued using the 'SANVIK' mark to benefit from their unauthorized use. Clearly, the defendant was trying to ride on the goodwill of the plaintiff's 'SANDVIK' marks and tried to pass off its services as those of the plaintiff's.

32. Based on the discussion above, a clear case of infringement of trademark is made out. The defendant has taken unfair advantage of the reputation and goodwill of the plaintiff's trademark and has also deceived the unwary consumers into believing their association with the plaintiff by dishonestly adopting the plaintiff's registered marks without any plausible explanation. Therefore, the plaintiff has established a case of passing off as well.

33. Since the defendant has failed to take any requisite steps to contest the present suit, despite having suffered an ad interim injunction order, it is evident that it has no defence to put forth on merits.

34. Accordingly, the plaintiff is entitled to restrain the defendant from using the impugned marks.
35. Counsel for the plaintiff presses for declaration of the mark 'SANDVIK' as a well-known mark.
36. In the facts and circumstances of the present case, I am unable to grant the said relief to the plaintiff. However, the right of the plaintiff to get its mark 'SANDVIK' declared as well-known is kept open and the same may be pursued by the plaintiff in an appropriate proceeding. RELIEF
37. In view of the above, a decree of permanent injunction is passed in favour of the plaintiff and against the defendant in terms of prayer clauses 65 (a) to (c) of the plaint.
38. Further, a decree is passed in favour of the plaintiff in terms of the relief prayed in prayer clause 65 (e) directing the defendant to transfer the domain name, SANVIKCORE.COM, in favour of the plaintiff or cancel all the domains registered by it.
39. In terms of the relief prayed in prayer clause 65 (f), a decree is passed in favour of the plaintiff directing the defendant to withdraw application no. 6233332, 6233334 and 6233338 for the SANVIK CORESFOT LLP device mark, or any other applications filed before the Trade Marks Registry for its 'SANVIK' marks.
40. Additionally, the plaintiff is granted the liberty to approach the social media platforms, such as Facebook, Instagram and LinkedIn, to remove references to the defendant's 'SANVIK' marks.
41. Further, the plaintiff is granted liberty to approach the Domain Name Registrar, Hostinger Operations, to suspend and lock the registration of the domain name, SANVIKCORE.COM.
42. Insofar as the relief of costs sought in prayer clause 65 (k) is concerned, for the purposes of calculation of actual costs, the plaintiff is directed to file their bill of costs in terms of Rule 5 of Chapter XXIII of the Delhi High Court (Original Side) Rules, 2018 within four weeks.
43. For this purpose, the representatives of the plaintiff shall appear before the taxation officer on 19th May 2025, who shall determine the actual costs incurred by the plaintiff in the present litigation.
44. Counsel for the plaintiff does not press for the remaining reliefs claimed in the plaint.
45. Let the decree sheet be drawn up.
46. All pending application(s) stand disposed of.

AMIT BANSAL, J MARCH 27, 2025 ds