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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
Date of Decision: 7th September, 2022

+ **C.O. (COMM.IPD-CR) 17/2021**

MOHD ERSHAD SOLE PROPRIETOR EK
AGENCIES

..... Petitioner

Through: Mr. Febin M. Varghese and Mr. Dhiraj
A Philip, Advocates (M:9953418874)
Bhuvneshwar Tyagi, Advocate
(8826824663).

versus

REGISTRAR OF COPYRIGHTS & ORS Respondents

Through: Mr. Harish Vaidyanathan Shankar,
CGSC with Mr. Srish Kumar Mishra,
Mr. Sagar Mehlawat and Mr.
Alexander Mathai Paikaday,
Advocates. (M:9810788606)

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.
2. The present petition has been filed under Section 50 of the Copyright Act, 1957 (*hereinafter 'Act'*) seeking rectification of the artistic work titled "*ASLI KESRI CHAI*" bearing No. **A-131509/2019** registered by Respondent No.3 - Mr. Shazad Ali. The present petition has been preferred by M/s EK Agencies, sole proprietorship firm of Mohd. Ershad Ansari. The case of the Petitioner is that it has been involved in the business of trading, packing, marketing and selling tea leaves since 1998. The Petitioner has been continuously selling tea leaves using artistic work along with the trade mark '*HIGHGRON*' since 2015. The Petitioner got the mark '*HIGHGRON*' registered under Trade Mark No. 3035105 as a word mark in class 30 in

respect of tea. One of the products of the Petitioner is 'HIGHGRON KESRI CHAI', which is sold in a distinctive yellow, green and red colour packaging.

3. It is the case of the Petitioner that the said mark along with the artistic work is associated exclusively with the Plaintiff and its business. The Petitioner's artistic work 'HIGHGRON', which is a label, was registered with the Registrar of Copyrights bearing registration no.124161/2018, on 27th February, 2018.

4. The Petitioner is aggrieved by grant of copyright registration to the Respondent No.3 on 21st October, 2019 for its label "ASLI KESRI CHAI". The competing labels of the parties are set out below:

Petitioner's registered work	Respondent's artistic work
	

5. According to the Petitioner, Respondent No.3 is selling tea leaves under a different name but has chosen to adopt packaging, which is almost identical to that of the Petitioner. Respondent No.3's copyright registration

was granted subsequent to the Petitioner's registration, on 21st October, 2019 bearing registration no.A-131509/2019.

6. Both the parties had applied for grant of no objection certificate under Section 45 of the Copyright Act and thereafter, obtained their respective registrations. The Petitioner, after acquiring the knowledge of the Respondent No.3's copyright registration, filed objections dated 27th December, 2019 with the Registrar of Trademarks, Mumbai seeking withdrawal of the no objection certificate issued to Respondent No.3 under Section 45 of the Copyright Act. The said objections were decided by the Trademark Registrar on 23rd March, 2021 by which the NOC, which was granted to Respondent No.3 was cancelled.

7. In addition to the cancellation order, an order was also passed on 16th March, 2021 by the Registrar of Trade Marks refusing the trade mark application of Respondent No.3 on the ground that the mark applied for by Respondent No.3 under TM application No. 3681696 consisting of artistic work is identical/similar to earlier trademarks on record and there is a likelihood of confusion in the minds of the public. In view of this, Id. Counsel for the Petitioner submits that as on date the NOC issued under Section 45 itself having been cancelled, the copyright registration cannot stand in favour of Respondent No.3. On the other hand, Id. counsel for Respondent No.3 submits that his client has already sought review of the order dated 23rd March, 2021 passed by the Registrar of Trade Marks by which the NOC was cancelled.

8. Heard. As per the scheme of the Copyright Act, 1957 in order for any person to obtain copyright registration of an artistic work, which is being used or is capable of being used in respect of goods and services, the NOC is

mandatorily to be obtained under the proviso of Section 45(1) of the Copyright Act, 1957. The said provision reads as under:

“45. Entries in register of Copyrights.—

(1) The author or publisher of, or the owner of or other person interested in the copyright in, any work may make an application in the prescribed form accompanied by the prescribed fee to the Registrar of Copyrights for entering particulars of the work in the Register of Copyrights:

Provided that in respect of an artistic work which is used or is capable of being used in relation to any goods or services, the application shall include a statement to that effect and shall be accompanied by a certificate from the Registrar of Trade Marks referred to in section 4 of the Trade Marks Act, 1999 (47 of 1999), to the effect that no trade mark identical with or deceptively similar to such artistic work has been registered under that Act in the name of, or that no application has been made under that Act for such registration by, any person other than the applicant.

(2) On receipt of an application in respect of any work under sub-section (1), the Registrar of Copyrights may, after holding such inquiry as he may deem fit, enter the particulars of the work in the Register of Copyrights.”

9. The purpose behind this provision is to ensure that there is no conflict between labels, packagings, etc. registered or used by trademark owners and registrations granted under the TM Act. The registration of copyright in respect of artistic works is, thus, founded on the basis of the NOC issued by the Trademark Office. Recently, this Court in **C.O.(COMM.IPD-CR) 1/2021** titled **Abhishek Kumar v. Union of India Through Registrar of Copyrights** in order dated 30th August, 2022 has summed up the legal position under section 45 of the Act and held as under:

“15. Considering now the fact that the search certificate has been cancelled and the Petitioner’s first application for the trademark has also been revived, the copyright registration in favour of Respondent No.3 can no longer stand. Obtaining an NOC under the proviso to Section 45 of the Act is compulsory in order to obtain registration of copyright. Clearly, there seems to be some misconduct indulged into by Respondent No.3 which has resulted in this entire sequence of events leading up to the grant of copyright registration in favour of Respondent No.3. The NOC having been cancelled, the first trademark application of the Petitioner having been revived and no reply having been filed by Respondent No.3 to contest the present petition as also the mark of the Petitioner and the artistic work of Respondent No.3 being identical, the copyright registration in favour of Respondent No.3 would be an entry which is wrongly made and wrongly remaining on the register in terms of Section 50 of the Act...”

10. In the present case, clearly, a perusal of the copyright registrations and the packaging used by both the parties itself shows that the labels are almost identical in nature. The Court has also seen the physical packagings which have been handed over to the Court and there is no doubt whatsoever that the Respondent No.3’s packaging/label is a substantial imitation of the Petitioner’s packaging. The Petitioner’s registration of copyright is dated 27th February, 2018 and the Respondent No.3’s NOC was issued on 18th June, 2019. Further, the copyright registration of Respondent No.3 dated 21 October, 2019 is subsequent to that of the Petitioner’s copyright registration. In the opinion of the Court, the two competing registrations, which are almost identical to each other, cannot be sustained under the Copyright Act. Respondent No.3’s artistic work is a substantial and colourable imitation of

the Petitioner's artistic work. In any event, the Registrar of the Trademarks, has vide its order dated 23rd March, 2021 has given the following findings:

“ **ORDER**

On 27/11/2017 the above named Applicant through their Attorney M/s. Tyagi Verifications, Delhi filed an application for search and certificate under Section 45(1) of the Copyright Act, 1957 vide C.C.No.87288 seeking NOC in relation to artistic label ASLI KESARI CHAI with device of "woman plucking tea leaves". The office conducted a search and issued a Search Report (NOC) for the artistic label applied under TM-C on 18/06/2019.

The Objector vide their letter dated 27/12/2019 filed a cancellation request under Rule 22(2) of the Trade Marks Rules, 2017 objecting to the NOC issued under Copyright Certificate No.87288. The said objection was forwarded to the Applicant for comments. The Applicant has not given any comments to the said objection letter. Thereafter the matter was fixed for hearing on 16/03/2021 when Mr. Rajat Agarwal, Advocate appeared for the objector and none appeared for the Applicant.

The Advocate for the Objector explained the facts. The Objector has filed copy of registration certificate in trademark no.3035105 in Class 30 and copyright registration certificate vide registration no.A-124161/2018 dated 27/02/2018. The objectors' contention is that the impugned NOC under C.C. No.827288 for the label ASLI KESARI CHAI has been obtained fraudulently by the Applicant. The Applicant's impugned label ASLI KESARI CHAI with device of woman plucking tea leaves, the colour scheme and get up of the packaging is identical and similar to the Objectors' copyright registration for artistic label HIGHGRON KESARI CHAI.

I carefully compared the NOC issued to the Applicant and rival artistic label of the objector. In both the artistic labels the colour of the packaging is identical, the device of woman plucking leaves is also identical, the manner of presentation of the word ASLI KESARI CHAI and HIGHGRON is deceptively similar. Both the labels compared as a whole shows mere re-production of the objector's HIGHGRON label by the Applicant for the artistic label KESARI CHAI.

In view of the similarity and intentionally adopting the artistic label of the objectors' to gain benefit of the copyright, the NOC issued in C.C.No.87288 is liable to be cancelled.

*IT IS HEREBY ORDERED that objection filed by the Objector is hereby allowed and search certificate issued under TMR-NOC-C.C.No.87288 dated 18/06/2019 is hereby **cancelled** as per Rule 22(2) of Trade Marks Rules, 2017.*

IT IS HEREBY FURTHER ORDERED that there shall be no order as to costs."

11. As per the above order, the Registrar of Trademarks has come to the conclusion that in both the artistic labels, the colouring of both the packaging is identical, the device of woman plucking tea leaves is identical, the manner of presentation of the words, logo and devices are also identical. These findings of the Registrar are also borne out from a comparison of the packaging, which have been shown to the Court today during the course of hearing. Since NOC issued under Section 45 of the Act has already been cancelled, Respondent No.3's registration no longer has any legs to stand upon, inasmuch as the foundation of Respondent No.3's registration itself has been revoked.

12. Accordingly, the present petition is liable to be allowed. Copyright

Registration no. A-131509/2019 shall stand rectified and Respondent No.3 shall no longer rely upon the said copyright registration.

13. Ld. counsel for Respondent No.3 submits that review against the order of the Registrar of Trade Marks dated 23rd March, 2021 is still pending. If the said review is adjudicated in favour of the Respondent No.3, then the parties are left to their legal remedies available in accordance with law and Respondent No.3 would be free to apply for copyright registration.

14. It is made clear that insofar as the mark 'ASLI KESARI CHAI' is concerned, Respondent No.3 is free to use the said mark along with any label or artistic work which is not an imitation of the Petitioner's label/packaging for products of its manufacture and sale.

15. Respondent No.1 shall take steps within two weeks to reflect the effect of the present order on the Register of Copyrights including the online platform. Let the present order be communicated to Respondent No.1 through counsel for compliance.

16. The petition is allowed in the above terms with no orders as to costs. All applications, if any, are disposed of.

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**PRATHIBA M. SINGH
JUDGE**

SEPTEMBER 7, 2022/dk/sk