

CIVIL REMEDIES FOR INFRINGEMENT OF INTELLECTUAL PROPERTY RIGHTS

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The human being is the only creature endowed with the ability to think and is always trying to find solutions to the multifaceted problems faced by him. As a result of his thinking process, new ideas and inventions keep on emerging in every conceivable field of science and technology. Similarly new creations are made in the field of arts and literature. All this is an outcome of the human brain. The resulting outcome is known as intellectual property. The law extends protection to intellectual property and in case of infringement certain remedies are available to the owner of intellectual property. These remedies may be classified into three heads: (1) Civil remedies (2) Administrative remedies and (3) Criminal remedies. This paper is confined only to civil remedies.

The civil remedies for infringement of intellectual property include interlocutory injunction, final injunction, damages, account of profits and delivery-up or destruction.

I. INTERLOCUTORY INJUNCTION

Injunction is the most important remedy against the infringement of intellectual property because the defendant is stopped dead in his tracks.

The owner of intellectual property normally wants speedy and effective relief to prevent further infringements of his intellectual property and further damage to his business. He cannot afford simply to wait for some years until the full trial takes place. As a consequence, the law provides interim relief to the plaintiff by way of interlocutory injunction.

Injunction means a judicial process by which one who is threatening to invade or has invaded the legal or equitable rights of another is restrained from commencing or continuing such act or is commanded to restore matters to the position in which they stood previous to that action.¹

The grant of this remedy is within the discretion of the trial Court which is not arbitrary, vague and fanciful but legal and regular.²

A. Copyright

In India, Copyright Act, 1957 provides the remedy of interlocutory

injunction against the infringement of copyright.³ Interlocutory injunction is granted under Order XXXIX, Rule 1 and 2 of the Civil Procedure Code, 1908. The principles laid down in English precedents are frequently relied upon and followed in courts in India.

It is settled law that in granting interlocutory injunction three factors would be taken into consideration. First, the establishment of a *prima facie* case, second, the balance of convenience in the favour of plaintiff and finally irreparable injury would be caused to the plaintiff if interlocutory injunction is not granted.⁴

Injury caused to the plaintiff by the acts of defendant must not be trifling. Acquiescence or delay on the plaintiff's part may disentitle him to an interlocutory injunction.

The proviso of Section 55(1) of the Copyright Act, 1957 provides that if the defendant proves that at the date of infringement, he was not aware and had no reasonable ground for believing that copyright subsisted in the work, the plaintiff shall not be entitled to any remedy other than an injunction in respect of the infringement and a decree for the whole or part of the profits made by the defendant by the sale of the infringing copies as the Court may in the circumstances deem reasonable.

In case if the work is very large and the pirated portion can be separated from the unobjectionable portion, the pirated work will be stopped from publishing but where pirated work cannot be separated from lawful work the Court will not hesitate in granting injunction to restrain the publication of the whole work.⁵

B. Designs

The plaintiff may ask for an interlocutory injunction *pendente lite* against the infringement of the copyright in his registered design. The principles applicable to the grant of interlocutory injunction in the case of infringement of design can be summed up as under: (1) plaintiff should make out a *prima facie* case; (2) the balance of convenience is in the favour of plaintiff; (3) interlocutory injunction may not be granted when the plaintiff can be adequately compensated in the event of his success in the action; (4) interlocutory injunction will be denied to the plaintiff if there are substantial grounds for attacking the validity of the registration of plaintiff's design; (5) interlocutory injunction will normally be denied if the defendant gives an undertaking to keep an account and such undertaking will give the relief which the plaintiff requires; (6) if interlocutory injunction is granted the plaintiff will have to give a cross undertaking in damages to recoup the defendant for any loss sustained if the plaintiff fails in the action.

In *Niki Tasha P. Ltd. v. Faridabad Gas Gadgets P. Ltd.*,⁶ the Delhi High Court denied the interlocutory injunction to the plaintiff. Rohatgi J. on the basis of the principles laid down in a British case *American Cyanamide v. Ethicon*⁷ decided by the House of Lords concluded:

“The balance of convenience lies in favour of refusing the interlocutory relief that is sought. The granting or withholding of interlocutory relief will depend upon the ability of either party adequately to be compensated in monetary terms and ultimately on the balance of convenience. The defendants’ ability to pay damages is a factor which tilts the scales against the plaintiffs.”

In case of *Bansal Plastic Industries v. Neeraj Toys Industries*⁸ the Court held that it is in the discretion of the Court to grant a temporary injunction which would be exercised in accordance with reasons and sound principles. Interim injunction will be refused to plaintiff where the defendant is also holding registration of design.⁹

C. Trademark

In a trademark infringement action, the plaintiff wants to stop the defendant from using his mark before his market is destroyed. The plaintiff in order to get interlocutory injunction, has to show at the preliminary hearing that the mark used by defendant is likely to confuse customers.

Where the matter is extremely urgent, the plaintiff may move for an *ex-parte* interim injunction before the motion for interim injunction is fully heard. The Court may grant an *ex-parte* injunction for a limited period subject to certain conditions, where plaintiff make full disclosure to the Court of all facts which are material to the exercise of the Court’s discretion and the Court is satisfied that it is in the interest of justice to issue an *ex-parte* injunction to the plaintiff.

Under Order XXXIX, Rule 3 of Civil Procedure Code, 1908 when an *ex-parte* injunction is issued to the applicant, it becomes his duty to deliver to the opposite party, or to send to him by registered post, immediately after the order granting the injunction has been made, a copy of the application for injunction together with other documents.

The Trade Mark Bill, 1993 which was introduced in the Parliament with the intention of repealing the existing Trade and Merchandise Marks Act, 1958 and re-enacting a new one with necessary changes provided for an *ex-parte* injunction or for an interlocutory order.

Clause 136 of the Bill was proposed to provide expressly that the Court might grant an *ex-parte* injunction and in particular, orders intended to

preserve evidence or documents relating to the subject matter of the suit so that the defendant was restrained from dealing with assets in a manner which would affect the plaintiff's ability to recover damages or other pecuniary remedies after final orders.

The factors for granting interim injunction against the infringement of trademarks are same as are available in the case of copyright infringement.¹⁰

In order to establish a *prima facie* case for grant of *ad interim* injunction against the infringement of trademark or passing-off, it is incumbent upon the plaintiff to show, *inter alia*, that plaintiff has been using its trading style and trademark for quite a long period and continuously; that the goods of the plaintiff have acquired a distinctiveness and are associated in the mind of the general public as goods of the plaintiff and that goods of defendant also carry the same or similar trademarks; that the trademark of the defendant is likely to deceive and cause confusion in the public mind and injury to the business reputation of the plaintiff; and that the market of consumption of goods of the parties are the same.¹¹

In *Johnson and Johnson v. Christine Haden India (Pvt.) Ltd.*,¹² plaintiff failed to have made a *prima facie* case for the grant of interim injunction. In *National Carbon v. Raj Kumar*,¹³ plaintiff were using trademark EVEREADY on their torches while the defendants who were newcomers and had manufactured only 2000 torches used LITEREADY trademark, interlocutory injunction was granted.¹⁴

Interim injunction may be granted even though the defendant has moved for rectification of the plaintiff's mark and the suit is stayed.¹⁵ Colourable imitation of mark which may cause confusion in the mind of the purchaser is also a ground for granting the interlocutory injunction.¹⁶

Phonetic similarity is also a ground for granting interlocutory injunction.¹⁷ But the rule of phonetic similarity should not be extended in such a way that words with same consonants of similar despatch should always be treated as phonetically similar.¹⁸

Generally unexplained delay in bringing the action may be a ground for refusal of interim injunction.¹⁹ However, Court may condone the delay in some circumstances.²⁰

D. Patent

The principles upon which interlocutory injunction may be granted in a patent action are the same as are applicable in the case of copyright infringement.

In *National Research and Development Corporation of India v. Delhi*

Cloth & General Mills Co. Ltd.,²¹ the Delhi High Court observed that for grant of temporary injunction, principles applicable to the infringement of patent actions are that there is a *prima facie* case, that the patent is valid and infringed, that the balance of convenience is in favour of the injunction being granted and that the plaintiff will suffer an irreparable loss. It is also a rule of practice that if a patent is a new one, a mere challenge at the Bar would be quite sufficient for a refusal of a temporary injunction, but if the patent is sufficiently old and has been worked, the Court would for the purpose of temporary injunction, presume the patent to be valid one. If the patent is more than six years old and there has been actual user, it would be safe for the Court to proceed upon this presumption.²² But if the patent has not been used in India, the plaintiff cannot in equity seek temporary injunction.²³

Unlike other intellectual property, interim injunction restraining the defendant from infringing a patent does not come within the scope of Order XXXIX, Rule 1. However, Section 151 of the Civil Procedure Code provides that nothing in the Code shall be deemed to limit or otherwise affect the inherent power of the Court to make such orders as may be necessary for the ends of justice or to prevent abuse of the process of the Court. And it has been held that the Court has powers under Section 151 to grant injunction in cases not falling within Order XXXIX Rule 1 and 2.²⁴ Reliefs for the infringement of patents will be granted under Section 108 of Patents Act which are subject to certain other provisions.

II. FINAL INJUNCTION

A. Copyright

If the plaintiff succeeds at the trial in establishing infringement of copyright, he will normally be entitled to a permanent injunction to restrain future infringements. This injunction will be operative only during the unexpired term of the copyright.

Injunction will be refused to the plaintiff if compensation will afford him adequate relief. But if the invasion of plaintiff's copyright is of a serious character which would not adequately be compensated by an award of damages, the injunction will be granted to the plaintiff.

In *K.P.M. Sundhram v. M/S Rattan Prakashan Mandir*,²⁵ it was held by the Court that withholding of injunction would be more injurious to plaintiff's right than the grant of injunction would impose burden on defendants. Therefore, the Court restrained defendants 1 to 3 from printing, publishing and selling the books of plaintiff.

Normally, the Court will refuse injunction in the circumstances where (1) there is no evidence that the defendant has done or threatens to do anything

which would interfere with the enjoyment of any right vested in the plaintiff, or (2) invasion of the right, if any, of the plaintiff, is of a theoretical nature, which would at the most give the plaintiff a right to claim nominal damages, or (3) the injunction would inflict far more injury on the defendant than the advantage which the plaintiff could derive from it.²⁶

B. Designs

If the plaintiff succeeds at the trial in establishing infringement of his registered design, he will normally be entitled to a permanent injunction to restrain future infringement because there is always a possibility of recurrence of such infringement in future. The object of granting injunction is to prevent such recurrence and restore the *status quo*. In a few exceptional cases, however, if it can be definitely shown that there is no such likelihood of any recurrence, then an injunction may be refused.

On the other hand, even if there is no infringement the Court may grant an injunction if it is shown that the defendant had the intention of infringing or had threatened to infringe.

In *Calico Printers Association Ltd. v. Savani & Co.*,²⁷ the Bombay High Court granted the permanent injunction to plaintiff against the importation of infringed articles to India. The injunction was restricted to British India and only for the period of copyright in respect of future infringements of the plaintiff's copyright.

C. Trademark

The plaintiff is entitled to permanent injunction if he establishes the infringement of his trademark at the final hearing. Permanent injunction may be granted on the basis of threatened future injury. The Court need not wait for the appropriation of one's property by use of a similar trade name actually to take place, if it clearly appears that such wrongful appropriation is extremely probable and is likely to occur.²⁸

In *Aravind Laboratories v. V.A. Samy Chemical Works*,²⁹ permanent injunction was granted where defendant's trademark 'RANI EYEVIX' was found deceptively similar to plaintiff's trademark 'EYETAX'. An injunction may be denied where the infringement or unfair competition was discontinued in good faith before commencement of the suit, and there is no reason to believe that it will be resumed.

If a defendant is guilty of deliberate and intentional fraud, he will be dealt with more strictly and permanent injunction will be granted but on the other hand if the plaintiff's trade is fraudulent, relief will be denied.

D. Patent

The factors for granting permanent injunction against the infringement of patent are same as are available for the infringement of any other intellectual property. Permanent injunction will be limited for the duration of the patent only. Permanent injunction will also be granted where a threat to infringe plaintiff's patent has been established. Actual infringement is merely evidence upon which the Court implies an intention to continue in the same course.³⁰

Injunction will not be granted where defendant has stopped the use of infringing article. In such a case only damages would be awarded. Acquiescence of plaintiff is a ground for the refusal of injunction.

Injunction will also be denied where the infringement relates to a patent endorsed "Licences of right" and the defendant is willing to take a licence under Section 88 of the Patents Act 1970. This privilege is not available against the infringement by importation of the patented article from foreign Countries.³¹ After coming into force of Trade Related Aspects of Intellectual Property Rights (TRIPs) Agreement in 1995, it became obligatory for India to do away with provisions of "licences of right".

In case of partially valid patent if the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the Court has discretion to grant injunction or other relief in respect of any valid claim which is infringed.³²

III. DAMAGES

The purpose of an award of damages is to restore the plaintiff to his position before the infringement. Such damages are therefore compensatory.

A. Copyright

Copyright infringement is a tort and the overriding principle in tort law is that damages should be compensatory.³³ Damages in tort aim to put the victim back to his position before the tort.³⁴ If infringement is established, damages are presumed.³⁵ Nominal damages are always awarded where a legal right has been infringed irrespective of the actual damage.³⁶ Generally, the damages would be equivalent to the fair fee or royalty which the defendant would have paid had he got the licence from the copyright owner. But it does not mean that defendant has got a licence from the copyright owner. Some more factors will also be taken into consideration to assess the damages *e.g.* diminution of the sales of copyright owner's work, or the loss of profit which he might otherwise have made, but this will exclude any benefit which may have accrued to the defendant by use of his work. Apart from this, the fact that the pirated work may have injured the reputation of copyright owner is also a fact that may be taken

into consideration in assessing the damages.³⁷

Unlike United Kingdom, there is no provision in India in the Copyright Act, 1957 for the award of additional damages in special circumstances such as the flagrancy of the infringement or the fortune reaped by the defendant by his misdeed. However, court, in the absence of such a provision, may award exemplary or punitive damages in appropriate cases.

Damages for conversion as defined by Lord Atkin in *Lancashire and Yorkshire Railway v. Mac Nicoll*³⁸ are damages while dealing with goods in a manner inconsistent with the rights of the true owner, provided that it is also established that there is also an intention on the part of defendant, in so doing, to deny the owner's right, or to assert a right which is inconsistent with the owner's right.

The Copyright Act 1957 declares that all infringing copies of any work in which copyright subsists and all plates used or intended to be used for the production of such copies shall be deemed to be the property of the owner of the copyright. It then entitles him to take proceedings for the recovery of possession of the infringing copies and plates or in respect of the conversion thereof.³⁹ But the owner of copyright will not be entitled to any remedy if the defendant proves that at the time of conversion of the infringing copies, he was not aware and had no reasonable grounds for believing that copyright subsisted in the work or that he had reasonable grounds for believing that such copies do not involve infringement of the copyright in the work.⁴⁰

The remedies of damages for infringement of copyright and for conversion set out above, are not alternative but cumulative.

B. Designs

When a person commits an infringement of copyright in designs as detailed in Section 53(1) of the Designs Act 1911, he will be liable for every contravention of the section to pay to the registered proprietor of the design a sum not exceeding Rs. 500/- which is recoverable as a contract debt. The total sum recoverable in respect of any one design will not exceed Rs. 1000/-.⁴¹

If the proprietor elects to bring a suit for the recovery of damages for any such contravention and for an injunction against the repetition thereof, the infringer is liable to pay such damages as may be awarded and to be restrained accordingly.⁴²

The remedies available under Section 53(2)(a) and 53(2)(b) are two distinct remedies and plaintiff cannot avail both the remedies simultaneously. He has to elect one out of two and that too on an earlier stage of the trial.⁴³

The Rangoon High Court in *Calico Printers Association Ltd. v. Hajee*

*Yusuf Fateh Mohamed*⁴⁴ held that the actual damage suffered by the plaintiff must always be seriously considered in determining the amount recoverable. In this case while upholding the claim of plaintiff under Section 53(2)(a), Court awarded much reduced amount on the ground that the plaintiff had suffered very little actual damage.

C. Trademark

In trademark infringement cases, it is sufficient for the plaintiff to prove that his right has been invaded. He need not prove special damage in order to get damages. Normally, if a plaintiff succeeds in getting an injunction for the infringement of his trademark he is entitled to claim damages. But where the suit for infringement relates to a certification mark, the Court cannot grant relief by way of damages other than nominal damages.⁴⁵ The plaintiff is entitled only to nominal damages, where the infringement is innocent and the infringer discontinues the use of plaintiff's trademark the moment he becomes aware of the infringement.⁴⁶ In a passing-off action also, in similar circumstances only nominal damages will be granted to the plaintiff.⁴⁷

In trademark infringement cases, the defendant is liable for all the loss actually sustained by the plaintiff which was the natural and direct consequence of the unlawful acts of the defendant. But if the plaintiff claims substantial damages, the onus is on him to prove that the action of the defendant has resulted in substantial damages to him.⁴⁸ In *Gujarat Ginning v. Swadeshi Mills*,⁴⁹ only nominal damages were ordered as there was no evidence of a fall in the sales of the plaintiff's goods.

Damages will also include injury to the plaintiff's reputation, business and goodwill.⁵⁰ While assessing damages, the cost of advertisements to counteract the effect of the defendant's conduct may also be taken into account. In *Manockju Petit Manufacturing Co. v. Mahalaxmi Spinning and Weaving Co.*⁵¹ it was held by Farran J.:

"In cases of unlawful use of a trademark, loss of profits forms the substantial ground of the claim for compensation. Loss of profits can be caused evidently in two ways: (1) by diminishing the amount of the goods sold by the plaintiff by taking his customers or ousting him from his usual market, or in some similar way; (2) by causing the goods actually sold by the plaintiff to be sold at a diminished price".⁵²

D. Patent

A successful plaintiff is entitled to damages in respect of actual infringements of his patent, or at his option, an account of profits.⁵³ Damages should be equivalent to the injury which the plaintiff has suffered from wrongful acts of the defendant. Only those injury would be taken into account which have

been resulted to plaintiff from the natural consequence of the wrongful acts of the defendant.⁵⁴ If the patentee licences his patent, the easier way of assessing the damages is royalty payment which the defendant would have made, had he got the licence from the patentee.

But if the patentee seeks to recover damages on account of reduction of his prices, he must establish that the reduction was necessitated by the defendant's wrongful competition and was not the result of the ordinary exigencies of the trade.⁵⁵

Damages may be refused by the court where the infringement is innocent,⁵⁶ or renewal fee has not been paid within the prescribed period⁵⁷ or where the amendment of a specification is allowed, the infringement caused by defendant before the date of the decision allowing the amendment.⁵⁸

IV. ACCOUNT OF PROFITS

As a corollary of the injunction, equity might require a defendant to account to a plaintiff for profits made by infringement of his intellectual property. The remedy of account of profits is not in addition to the remedy of damages. It is an alternative remedy.

The distinction between an account of profits and damages is that by the former the infringer is required to give up his ill gotten gains to the party whose rights he has infringed whereas by the latter he is required to compensate the party wronged for the loss he has suffered.⁵⁹

Therefore, a plaintiff is entitled to opt either damages or account of profits.

A. Copyright

The plaintiff is entitled to require the defendant to account for the profits made by him by the unauthorised use of former's copyright. The account is of net profits *i.e.* the sale price of the infringing copies minus manufacturing and delivery cost. In *Mohan Lal Gupta v. The Board of School Education, Haryana*,⁶⁰ the defendant was ordered to pay 20% of the profits to the plaintiff as the matter copied was less than one-tenth of the book.

The basis on which an account is ordered is that there should not be any unjust enrichment on the part of the defendant and that the defendant should be deprived of any profit which he earned by wrongful acts committed in breach of the plaintiff's rights.⁶¹ The plaintiff would be refused an account of profits if there are no profits. In such a case the plaintiff may elect to claim damages and he would be bound by an election once made.⁶²

B. Designs

In case of infringement of copyright in designs, it is not clear under Designs

Act, 1911 whether a defendant can be asked to keep an account. The judgements of the Courts on this issue are not very clear. However, in a case *Calico Printers Association, Ltd. v. Goshu Kabushiki Kaisa Ltd.*,⁶³ this remedy was refused to the plaintiff. The Court in this case, made it clear that the plaintiff could not have an account of profits made by the defendant as an alternative to a claim of damages or to a claim for the payment of Rs. 1000/. This is for the simple reason that it was not so provided by the statute.⁶⁴

In *Calico Printers Association Ltd. v. Ahmed Abdul Karim Bros. Ltd.*,⁶⁵ the defendants admitted infringement of the design of plaintiff and gave an undertaking not to infringe plaintiff's rights in future and offered him to pay profits made by infringement. The Court granted the profits earned by the defendant as damages to the plaintiff.

However, Prof. Ponnuswami is of the view that instead of granting an interlocutory injunction against the defendant, the Court may order the defendant to keep an account. It is within the judicial discretion whether the injunction will be ordered or the defendant will be ordered to keep an account.⁶⁶

To sum up, it can be said that despite the fact that Sections 53(2)(a) and 53(2)(b) do not provide a remedy by which a defendant may be ordered to keep an account, but the Courts are entitled under its general jurisdiction to grant equitable remedies which have not been excluded by the statute expressly or by necessary implication. The same attitude was taken by the Court in the case of remedy of delivery of goods under the Designs Act in *Calico Printers Association Ltd. v. Savani & Co.*⁶⁷

C. Trademark

The principle upon which the Court grants an account of profits is that where one party owes a duty to another, the person to whom that duty is owed is entitled to recover from the other party every benefit which that other party has received by virtue of his fiduciary position as he has obtained it without the knowledge or consent of the party to whom he owed the duty.⁶⁸

So far as apportionment of profits is concerned there are two ways of sharing the profits. Where the trade mark infringed has become well known as the product of a particular manufacturer and has acquired a reputation under that mark, all profits made by an infringer by selling goods of that kind under that name may in some cases be said to be attributable to his use of the mark.⁶⁹ But where a substantial part of the sale of the defendant's articles is a result of the merits of his articles and his established reputation, the plaintiff will not be awarded the full profits. The burden to prove this situation is on defendant. It lies on the plaintiff who seeks an account of profits to establish that profits were made by the defendant knowing that he was transgressing the plaintiff's rights.⁷⁰

D. Patent

It has been held in *Saccharin Corporation Ltd. v. Chemicals and Drugs Co. Ltd.*⁷¹ that the patentee who elects to take profits stands in the shoes of the infringer, and condones so to speak, his wrong, and is entitled only to those profits.

The Court will order an account of profits which is equitable. If the Court considers it necessary in the interests of justice, it will direct an apportionment and then ascertain the profits.

Account of profits will be refused to patentee where the defendant proves that at the time of infringement he was not aware and had no reasonable grounds to believe that the patent existed.⁷² The Court may also refuse an account of profits in respect of any infringement committed after a failure to pay renewal fee within the prescribed period.⁷³ In case of amendment of specification, the Court will not grant account of profits in respect of the use of invention before the date of decision allowing the amendment unless it is shown that the specification was originally framed in good faith and with the reasonable skill and knowledge.⁷⁴

V. DELIVERY UP OR DESTRUCTION

In order to ensure that injunctions are properly effective, Courts of equity and their successors maintain a discretion to order delivery up of infringing articles or documents for destruction, or else to require their destruction under oath by the defendant.⁷⁵

A. Copyright

Where a person is found in possession of infringing copies of works or an article specifically designed or adapted for making copies of a particular copyright work, knowing or having reason to believe that it has been or is to be used to make infringing copies, the Court can order such person to deliver infringing copies or articles to the owner of copyright. The machinery⁷⁶ made or used for the purpose of making infringing copies would also be delivered up to plaintiff.

In *Muddock v. Blackwood*⁷⁷ the defendant had in his possession some of the infringing copies and sold others, but without making any profits on the sales. It was held by the Court that the plaintiff was entitled to the usual injunction, to delivery up of the copies in defendant's possession and to damages representing the actual amount of the proceeds of the copies sold.

Where only a part of the work complained of infringes the plaintiff's copyright, then, if it is physically possible to separate one from another, the defendant would be ordered to deliver up infringing material, but where the

parts cannot be separated, the order for delivery up may extend to the whole of the article.

The Copyright Act, 1957, though does not speak specifically of the remedy of delivery up but provides in addition to injunction, damages and accounts, any other remedy which may be conferred by law.⁷⁸ Therefore, Court can grant remedy of delivery up under Copyright Act 1957.

B. Designs

The Designs Act, 1911 makes no provision for delivery up or destruction of infringing articles. But in *Calico Printers Association Ltd. v. Savani & Co.*,⁷⁹ the Court made an order for delivery up of the infringing goods. It was held by the Court in that case that though Sections 53(2)(a) and 53(2)(b) of the Designs Act, 1911 did not specifically provide for delivery up of the goods to the plaintiff for destruction but it did not have the effect of excluding equitable remedies in respect of an infringement of copyright in design which the Court is entitled to grant under its general jurisdiction.

In another case *Calico Printers Association Ltd. v. Ahmed Abdul Karim Bros. Ltd.*,⁸⁰ it was held by the Court that the order for delivery up can be made by this Court as an equitable relief. But such an order for delivery up must be made in the spirit of the provisions of Section 53. Such a relief can be granted only in respect of goods for the purpose of sale but not in respect of any other purpose.⁸¹ Thus it becomes clear that the Court while exercising its discretionary power can grant this equitable remedy to the plaintiff.

C. Trademark

Unlike copyright law, the Trade and Merchandise Marks Act refers only to "delivery up of infringing labels and marks for destruction or erasure" and not to delivery up of the goods bearing such labels or marks.⁸² It is therefore clear from the above mentioned provision that goods bearing the deceptive mark in the possession of the defendant may not be ordered to be destroyed but only that the labels or marks may be ordered to be erased therefrom and after erasing labels or marks the goods will be hand over to the defendant. But where the mark is so stamped or imprinted on the goods that erasure is impossible without destruction of the goods, the Court may order for the destruction of the goods.

Though under the old Trade Marks Act, 1940, there was no specific provision for delivery up of infringing labels and marks but the Court had ordered delivery up of infringing marks for destruction or erasure.⁸³

D. Patent

The Court can order for the destruction or delivery up of infringing goods

which are in possession of the defendant. It is entirely within the discretion of the Court. The purpose of making such order is to prevent the defendant from making use of the infringing articles which are in his possession. The Court will limit the order upto the extent which is necessary for the protection of the plaintiff. In *British United Shoe Machinery Co. Ltd. v. Grimson Shoe Machinery Co. Ltd.*⁸⁴ it was held that delivery up of a part of the offending combination was sufficient.⁸⁵

The defendant is not entitled to any compensation for loss caused to him by such destruction or delivery up, and cannot set off the value of goods delivered up against a claim for damages.⁸⁶

VI. CONCLUSION

Intellectual property law, a product of the industrial civilisation has assumed equal importance both at national and international levels. Today, when the demand for increased protection of intellectual property has arisen, the developing countries have shown reluctance to give full protection to intellectual property. For this reason the developed countries have negotiated trade related aspects of intellectual property (TRIPS) not under World Intellectual Property Organisation (WIPO) which is a body for intellectual property but under the auspices of General Agreement on Tariffs and Trade (GATT) which is a forum for international trade.

In India different type of civil remedies are available against the infringement of intellectual property. Though the remedy equivalent to the remedy of Anton Piller Orders in United Kingdom is not available in India but sometimes our Courts grant the same remedy.⁸⁷

There is no provision under the Copyright Act, 1957 for the award of additional damages in special circumstances such as the flagrancy of the infringement or the fortune reaped by the defendant by his misdeed. Therefore, our Copyright Act should be modified in order to cover additional damages under its provisions.

Damages under the Designs Act, 1911 seems to be inadequate. Under the Act, the infringer is liable to pay the proprietor a sum, not exceeding Rs. 1000/- in the aggregate as a contract debt.⁸⁸ Though this limitation of Rs. 1000/- does not expressly cover the damages that may be awarded by a court in an infringement suit but the general feeling is that damages are limited to Rs. 1000/-. The provisions of the Designs Act have become outdated. This is one of the reasons why there is not much innovation in India.

The remedies of account of profits and delivery up or destruction are not available under Designs Act, 1911 against the infringement of copyright in registered design. However, the Courts are entitled under their general

jurisdiction to grant equitable remedies as has been held by Court in *Calico Printers Association Ltd. v. Savani & Co.*⁸⁹

The Copyright Act 1957 has been amended by Copyright (Amendment) Act, 1994 to protect computer software in an effective manner.

The enforcement regime of designs protection is inadequate and requires a complete overhaul to provide strong penalties for design piracy.

The Trademark Bill, 1993 was proposed to update the trademark law and provided for strong penalties against the trademark infringements. But unfortunately that Bill has lapsed in the Parliament.

The Patent Act, 1970 was also proposed to be amended by the Parliament. A Bill in this concern was introduced in the Parliament but it has also lapsed.⁹⁰

NOTES AND REFERENCES

- * Lecturer, Law Centre-II, Faculty of Law, University of Delhi, Delhi.
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- 2. *Harbuns v. Bhairo*, INDIAN LAW REPORTS, 5 C-259(PC).
- 3. Section 55 of COPYRIGHT ACT, 1957.
- 4. *Bharat Law House v. M/S Wadhwa & Co. Pvt. Ltd.*, AIR 1988 Del 68 at 70.
- 5. *Ghafoor Bux v. Jwala Prasad*, (1921) INDIAN LAW REPORTS 43 All 412.
- 6. AIR 1985 Del 136.
- 7. (1975) A.C. 396.
- 8. 1989 INDUSTRIAL PROPERTY LAW REPORTER 75.
- 9. *Indo Asahi Glass Co. Ltd. v. Jai Mata Rolled Glass Ltd. & Anr.*, 16 THE PATENT AND TRADE MARK CASES 1996 Del 220.
- 10. See also *Century v Roshanlal*, AIR 1978 Del 250 at 251.
- 11. *Hindustan Radiators Co. v. Hindustan Radiators Ltd.*, AIR 1987 Del 353 at 358-59. See also *M/s Bhatia Plastics v. M/s Peacock Industries Ltd. & Anr.*, 15 THE PATENT AND TRADE MARK CASES 1995 Del 150; *Ciba Geigy Ltd. v. Crosslands Research Laboratories Ltd.*, 16 THE PATENT AND TRADE MARK CASES 1996 Del 1; *Colgate - Palmolive Co. & Anr. v. Sundeep Enterprises*, 15 THE PATENT AND TRADE MARK CASES 1995 Del 389; *Metropol India (P) Ltd. v. Praveen Industries India*, 16 THE PATENT AND TRADE MARK CASES 1996 Del 77.
- 12. AIR 1988 Del 249.
- 13. AIR 1954 All 218.
- 14. See also *Roop Chand v. Kiran Soap*, 1980 INDUSTRIAL PROPERTY LAW REPORTER 76 where wrappers of articles of plaintiff and defendant which carried trademarks SINAULA AND SINDRELA were found similar.
- 15. *Jagan Nath v. Bhartiya Dhoop*, AIR 1975 Del 149; see also *M/s Gold Star Co. Ltd. v. M/s Gold Star Industries & Ors.* 15 THE PATENT AND TRADE MARK CASES 1995 Del 18.

16. *Kedar Nath v. Monga Perfumery*, AIR 1974 Del 12; see also *Castrol Ltd. & Anr. v. Subash Kapoor & Ors*, 15 THE PATENT AND TRADE MARK CASES 1995 Del 31.
17. *M/s Vrajil Manilal & Co. v. M/s Adarsh Bidi Co.*, 15 THE PATENT AND TRADE MARK CASES Del 88; *American Home Products Corpn., Wyeth Lab. Ltd. v. Lupin Lab. Ltd.*, 16 THE PATENT AND TRADE MARK CASES 1996 Bom 44; *M/s Mitaso Appliances Ltd. v. Shri Joginder Singh*, 15 THE PATENT AND TRADE MARK CASES 1995 Del 105.
18. *M.A. Rahim v. M/s Aravind Laboratories*, 15 THE PATENT AND TRADE MARK CASES 1995 Mad 1.
19. Interim injunction was refused in *Paras Traders v. Rajasthan Copy Manufacturers Association (Regd)*, 16 THE PATENT AND TRADE MARK CASES 1996 Del 229 where the plaintiff filed a suit after a delay of five years.
20. In *Hindustan Pencils v. India Stationary*, AIR 1990 Del 19 at 25, interim injunction was granted despite a delay of six years.
21. AIR 1980 Del 132.
22. *Id.* at 135.
23. *Franz Xaver Huemer v. New Yash Engineers*, 16 THE PATENT AND TRADE MARK CASES 1996 Del 232.
24. *National Research and Development Corporation of India v. Delhi Cloth & General Mills Co. Ltd.*, AIR 1980 Del 132; *Manohar Lal v. Seth Hira Lal*, AIR 1962 SC 527; *Surendra Lal Mahendra v. Jain Glazers and Ors*, THE PATENT AND TRADE MARK CASES 1981 at 112; See also P. Narayanan, PATENT LAW (Calcutta: Eastern Law House, 1985) at 556.
25. AIR 1983 Del 461.
26. Satyawrat Ponskshe, THE MANAGEMENT OF INTELLECTUAL PROPERTY (Pune: Bhate & Ponskshe Publications, 1991) at 305.
27. AIR 1939 Bom 103.
28. Srinivasa Iyengar, THE TRADE AND MERCHANDISE MARKS ACT & RULES (Allahabad: Law Book Co. (P) Ltd., 1986) at 410-11.
29. 14 THE PATENT AND TRADE MARK CASES 1994 Mad 223.
30. *Rohtas Industries Ltd. v. Indian Hume Pipe Co. Ltd.*, AIR 1954 Pat 492 at 496.
31. Section 112 of PATENTS ACT, 1970.
32. *Id.* Section 114.
33. Gerald Dworkin quoted in Stephen M. Stewart, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS (London: Butterworth & Co. Ltd., 1989) at 517.
34. W.R.Cornish, INTELLECTUAL PROPERTY: PATENTS, COPYRIGHT, TRADEMARKS AND ALLIED RIGHTS (London: Sweet & Maxwell, 1989) at 38-39.
35. *Moore v. Clarke* (1842) 11 LJ Ex 286.
36. *Constantine v. Imperial London Hotels Ltd.* 2 ALL E R (1944) 171.
37. E.P. Skone James *et. al.*, COPYRIGHT (London: Sweet & Maxwell, 1991) at 343.
38. (1919) 88 LJKB 601 at 605.
39. Section 58 of COPYRIGHT ACT, 1957.
40. *Id.* proviso to Section 58.

41. Section 53(2)(a) of DESIGNS ACT, 1911.
42. *Id.* Section 53(2)(b).
43. *Calico Printers Association Ltd. v. Goshwami Kabushiki Kaisha K. Ltd.*, AIR 1936 Bom 408.
44. AIR 1933 Rangoon 240.
45. Section 106(2)(a) of the TRADE AND MERCHANDISE MARKS ACT, 1958.
46. *Id.*, Section 106(2)(b).
47. *Id.*, Section 106(2)(c).
48. *Aravind Laboratories v. V.A. Samy Chemical Works*, 14 THE PATENT AND TRADE MARK CASES 1994 Mad 223.
49. AIR 1939 Bom 118.
50. *Swadeshi Mills Co. v. Juggilal Kamlatpat Cotton Spinning and Weaving Mills Co.*, AIR 1927 All 81.
51. INDIAN LAW REPORTS 10 Bom 617.
52. *Id.* at 630.
53. Section 108 of PATENTS ACT, 1970.
54. *Meters Ltd. v. Metropolitan Gas Meters Ltd.*, 28 RPC 157 at 165 (C.A.).
55. *Alexander & Co. v. Henry & Co. and Ors*, 12 RPC 360 at 367.
56. Section 111(1) of PATENTS ACT, 1970.
57. *Id.*, Section 111(2).
58. *Id.*, Section 111(3).
59. *Supra* n. 48.
60. INDUSTRIAL PROPERTY LAW REPORTER, 1978 at 83.
61. *Supra* n. 37 at 353.
62. *Ibid.*
63. AIR 1936 Bom 408.
64. *Id.*, at 411.
65. AIR 1939 Bom 198.
66. Krishnaswami Ponnuswami, *Design Protection in India: The Designs Act 1911*, paper presented at WIPO NATIONAL WORKSHOP ON INTELLECTUAL PROPERTY TEACHING, UNIVERSITY OF DELHI, 1991 at 19.
67. *Supra* n. 27 at 112.
68. *Electrolux v. Electrix*, 70 RPC (1953) 158 at 159.
69. P. Narayanan, *LAW OF TRADE MARKS AND PASSING-OFF* (Calcutta: Eastern Law House, 1991) at 497-98.
70. *Supra* n. 48.
71. 17 RPC 612 at 615.
72. *Supra* n. 56.
73. *Supra* n. 57.
74. *Supra* n. 58.

75. *Supra* n. 34 at 41.
76. This includes plates, blocks, moulds, printing presses in cases of printed material, negatives in the case of photographs, matrices and all kinds of reproduction equipment in the case of phonograms or films.
77. 77 LAW TIMES REPORTS (1898) 493.
78. Section 55 of Copyright Act, 1957.
79. *Supra* n. 27.
80. *Supra* n. 65.
81. *Id.*, at 201.
82. Section 106(1) of the TRADE AND MERCHANDISE MARKS ACT, 1958.
83. *Bhagwan Das v. Watkins Mayor*, AIR 1956 Pun 17; *SWADESHI MILLS v. JUGGILAL KAMLAPAT*, AIR 1927 All 81.
84. 45 RPC 85.
85. See also *Mergenthaler Linotype Co. v. Intertype Ltd.*, 43 RPC 381 at 382.
86. *United Telephone Co. v. Walker*, 4 RPC 63 at 67.
87. See *Tata Oil Mills Co. Ltd. v. M/s Wipro Ltd.*, AIR 1986 Del 345; *K.P.M. Sundaram v. M/s Rattan Prakashan Mandir*, AIR 1983 Del 461.
88. Section 53 of the DESIGNS ACT, 1911.
89. *Supra* n. 27 at 112.
90. On 31 December 1994, the Patent (Amendment) Ordinance was passed. Thereafter the Patent Amendment Bill, 1995 was introduced in the Parliament to replace the Ordinance but the same has lapsed.