

Email by Registry-IPD

IN THE HIGH COURT OF DELHI AT NEW DELHI

No.....234489.....DHC/Orgl./IPD

Dated.....18-12-23.....

From:

The Registrar General
Delhi High Court
New Delhi.

To:

THE CONTROLLER GENERAL OF PATENTS,
DESIGNS & TRADEMARKS OF INDIA
EMAIL: llc-ipo@gov.in

C.O.(COMM.IPD-CR) 6/2023

HUGO BOSS TRADEMARK MANAGEMENT GMBH AND CO. KG.PLAINTIFF


Vs

SANDEEP ARORA TRADING AS ARRAS THE BOSS & ORS. ...DEFENDANTS

Sir,

I am directed to forward herewith for information and necessary compliance a copy of order dated **08.12.2023** passed by **HON'BLE MS. JUSTICE PRATHIBA M. SINGH** of this Court.

Yours faithfully,


Admn. Officer (Judl.) (O)
for Registrar General
KS

Encl. : 1) Copy of the order dt: 08.12.2023.



§~16

* IN THE HIGH COURT OF DELHI AT NEW DELHI
Date of decision: 8th December, 2023

+ C.O.(COMM.IPD-CR) 6/2023, I.As. 12778/2023 & 12779/2023
HUGO BOSS TRADEMARK MANAGEMENT
GMBH AND CO. KG. Petitioner

Through: Mr Rishi Bansal & Mr Mankaran
Singh, Advs. (M: 9718833632)

versus

SANDEEP ARORA TRADING AS
ARRAS THE BOSS & ORS. Respondents

Through: Mr. Harish Vaidyanathan Shankar,
CGSC, with Mr. Srish Kumar Mishra,
Mr. Alexander Mathai Paikaday, Mr.
Krishnan V., Advs. (M: 9810788606),
for R-2 and R-3.

CORAM:
JUSTICE PRATHIBA M. SINGH

JUDGMENT

PRATHIBA M. SINGH, J.

1. This hearing has been done through hybrid mode.

Background

2. The present petition seeking rectification of Register has been filed by the Petitioner - HUGO Boss Trademark Management GMBH and CO. KG under Section 50 of the Copyright Act, 1957 (*hereinafter 'the Act'*). The Petitioner is seeking expunction/removal of the Copyright registration titled 'ARAAS THE BOSS' bearing Copyright registration number A-136350/2021 (*hereinafter 'impugned registration'*). The impugned registration dated 7th January, 2021 has been obtained by Mr. Sandeep Arora under Diary No. 464/2021-CO/A. The Respondent is stated to be trading as



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M/s ARRAS THE BOSS.

3. The case of the Petitioner is that it is the registered proprietor of the Trade Marks 'HUGO BOSS' and 'BOSS' as also other 'BOSS' formative marks, which were first adopted by it in the year 1923. The said marks have been used extensively internationally and the 'HUGO BOSS' mark was adopted by the Petitioner in 1984, for the purpose of marketing and selling fragrance and perfumes. The Petitioner is stated to be having worldwide sales of 1.9 billion Euros in the year 2020. In addition, the Petitioner reports that it achieved worldwide sales worth more than 2 billion US Dollars with net profit of more than 262 million US dollars in the year 2010.

4. Respondent No. 1- Sandeep Arora trading as Arras the Boss is stated to be engaged in the business of sale of perfumery related goods/products. Respondents Nos. 2 and 3 are the Registrar of Trademarks and Registrar of Copyrights respectively.

Proceedings before Court

5. Notice was issued in this petition by this Court on 19th July, 2023. On the said date, the Court considered the mark and label of the Petitioner and also Respondent No. 1. Records from the office of the CGPDTM were also requisitioned on the said date.

6. Vide order dated 22nd November, 2023, the Id. Joint Registrar has recorded that Respondent No. 1 has been served through email on 14th September, 2023. The said order is extracted below:

"Respondent no. 1 could not be served through the registry or through the speed post / courier sent by the petitioner. However, as per the affidavit of service dated 15.09.2023, respondent no. 1 has been served on 14.09.2023 through email. Respondent no. 2 & 3 also






stand served through email.

Matter is already listed before the Hon'ble Court for 08.12.2023.

Put up before the Hon'ble Court on the date already fixed i.e. 08.12.2023, for further directions."

Brief Facts

7. The mark 'BOSS' is a registered Trade Mark in several countries of the world including in India. The details of some of the said Trade Mark registrations in India are as under:

S. No.	Trademark	Application No.	Date of Application	Class	User
1	BOSS	502837	23-12-1988	3	Proposed to be used
2	BOSS	944967	03-08-2000	14	01/06/2000
3	BOSS	957566	20-09-2000	9	Proposed to be used
4	BOSS AQUA	766732	21/08/1997	3	Proposed to be used
5	HUGO BOSS	4498555	10-05-2020	3	19/06/2003
6		4182182	21/05/2019	35	Proposed to be used
7	HUGO	4373357	10-12-2019	3	19/06/2003
8	BOSS BOTTLED	4432674	06-02-2020	3	31/03/2012
9		610823	01/11/1993	18	01/11/2023
10		861272	16/06/1999	14	Proposed to be used



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8. The manner in which the Petitioner uses the mark 'BOSS' for perfumes is illustratively depicted the following images:



9. Further, the Petitioner uses its marks 'BOSS' and 'HUGO BOSS' in a stylised manner in various forms including the following:



10. The Petitioner also owns rights in various writing styles of 'BOSS' and according to the Petitioner, the mark 'BOSS' has also attained the status of a well-known mark. The products of the Petitioner are extensively advertised on its global website www.hugoboss.com and www.hugoboss.in insofar as Indian customers are concerned. It has more than 1200 stores and several which are being operated through franchise across the world as also in various international airports including India, Hongkong, Indonesia, Korea, Malaysia, Philippines, Singapore, UAE in Asia, Cyprus in East Europe and Austria, Croatia, Denmark, Finland, France, Great Britain, the Netherlands, Norway, Switzerland and Iceland in Europe and Mexico in South America. The Plaintiff's products are also advertised in several well known international



magazines including TIME, Newsweek, Fortune, The Economist, The Business World, Executive, Vogue, GQ, Forbes, Vanity Fair etc.

11. The Petitioner also has a large social media presence on a variety of social media platforms including Facebook, Instagram, YouTube, X (formerly Twitter), etc. The extensive reputation of the Petitioner has been pleaded in the petition as under:

“24. That it is submitted that the Petitioner has a strong presence on social networking websites such as Facebook, Instagram, YouTube, Twitter etc. As on 23rd of May, 2023, the Petitioner's page with mark "HUGO" on Facebook had around 713,186 followers and that of "BOSS" had 8488503. HUGO and BOSS had 10.7 K and 182 K subscribers on its YouTube page respectively. "HUGO" AND "BOSS" had 1.7 million and 11 million followers on Instagram Page, HUGO BOSS - 708 K and HUGO BOSS has 97.9 K followers on its Pinterest page. All of them being operated under the said trademarks/labels of the Petitioner.”

Analysis and findings

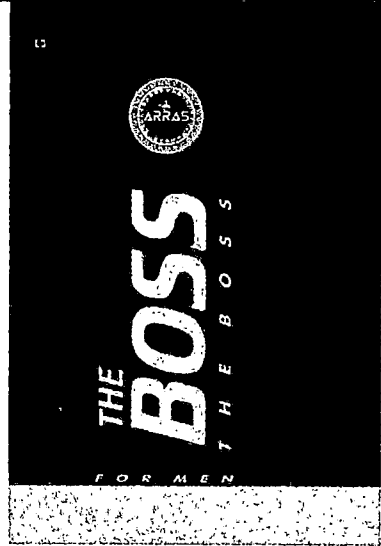
12. In the present petition, the Petitioner claims to be aggrieved by Respondent No. 1's registration of the copyright bearing registration number A-136350/2021.

13. The details of the registration of Respondent No. 1 are set out below:



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S. No.	Title	Artistic Work	Registration No.
1.	ARRAS THE BOSS		A-136350/2021

14. The Petitioner thus, prays for cancellation of the artistic work as extracted above. Mr. Rishi Bansal, Id. Counsel appearing for the Petitioner submits that the Respondent is a habitual infringer and violator of rights in various marks. In order to prove this point, he has handed over a large list of Trade Marks, which Respondent No. 1 has applied for. In addition, he submits that Respondent No. 1- Mr. Sandeep Arora had also applied for registration of the mark 'BOSS' as a Trade Mark, which was refused by the Registrar of Trade Marks by citing the Petitioner's Trade Mark bearing no. 4732764 in Class 3. The application was filed on 5th November, 2020 on a proposed to be used basis. The device for which the Respondent had applied is set out below:



**THE
BOSS**

15. This Court notes that Section 45 of the Act clearly specifies that when any person is seeking copyright registration for artistic works used or potentially used in connection with goods or services, the application for copyright registration must include a statement acknowledging this use. Additionally, the said application must include a certificate from the Registrar of Trade Marks that no Trade Mark identical or deceptively similar to the artistic work has been registered or applied for by anyone other than the Applicant. This requirement ensures that the artistic work does not infringe upon existing trademarks. Section 45 of the Act is set out below:

“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 3 of the Trade Marks Act, 1999 (47 of 1999), to the effect that no trade mark identical with or deceptively similar



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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.”

16. Vide judgement dated 20th April, 2018, this Court in **Marico Ltd. vs. Jagit Kaur, 2018 SCC Del 8488** had observed that though Trade Marks and Copyrights operate under different statutes, since rights in an original artistic work could overlap with label marks registrable under the Trade Marks Act, 1999, the legislature in its wisdom added a proviso to Section 45 in the Copyright Act. Clearly, this proviso has been inserted into the Act to prevent unscrupulous persons from copying label marks with the intention of passing off and taking shelter under a false claim of ownership of Copyright in an artistic work. Unquestionably, this proviso would be applicable in this case as well.

17. Despite the factual background of the present case and the legal position, when Respondent No. 1 sought Copyright Registration for the impugned artistic work, the said Respondent obtained a No Objection Certificate from the Registrar of Trade Marks. Following this, a search certificate was issued on 4th January, 2021 stating that no similar mark existed on the record of the Register of the Trade Marks. The said certificate reads as under:



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INTELLECTUAL
PROPERTY INDIAGOVERNMENT OF INDIA
TRADE MARKS REGISTRY
TRADE MARKS DIVISION
INTELLECTUAL PROPERTY BHAVAN
BESIDE ANTOPI HILL POST OFFICE
MUMBAI-400037

सं/No.TMR-CC.No 104891

खोज प्रमाणपत्र/SEARCH CERTIFICATE

(व्यापार चिह्न अधिनियम, 2017 के नियम 22(1) के तहत)
(Under Rule 22 (1) of the Trade Marks Rules, 2017)
(कॉपीराइट अधिनियम, 1957 की धारा 45(1) के अर्थात् प्रयोजन हेतु)
(FOR USE UNDER SECTION 45(1) OF THE COPYRIGHT ACT, 1957)

MR. SANDEEP ARORA,
D/1504, OCTACREST BUILDING, BEHIND CENTRIUM MALL, NEAR LOKHANDWALA CIRCLE, LOKHANDWALA
TOWNSHIP, KANDIVALI EAST, MUMBAI- 400 101 के
निम्न प्रदर्शित कलात्मक कार्य के कॉपीराइट पंजीकरण के संदर्भ में
IN THE MATTER Of Copyright Registration of an artistic Work
depicted below of MR. SANDEEP ARORA.,
D/1504, OCTACREST BUILDING, BEHIND CENTRIUM MALL, NEAR LOKHANDWALA CIRCLE, LOKHANDWALA
TOWNSHIP, KANDIVALI EAST, MUMBAI- 400 101

आपके आवेदन के कलात्मक कार्य के लिए व्यापार चिह्न पंजीकरण के अभिलेखों की खोज मैंने की है और यह प्रमाणित किया जाता है कि इस कार्यालय के कंप्यूटर अभिलेख के अनुसार उक्त कलात्मक कार्य (एलएड द्वारा संलग्न) के सदृश या ब्रह्मक रूप से समान कोई व्यापार चिह्न (आवेदक के व्यापार चिह्न के अतिरिक्त) व्यापार चिह्न अधिनियम 1999 के तहत पंजीकृत अथवा पंजीकरण हेतु आवेदित नहीं है।

I have made the search from the Records of the Register of Trade Marks for the artistic work applied by you and it is certified that no Trade Marks(except the applicant's own Trade Mark) has been registered or applied for registration under the Trade Marks Act 1999 as per Computer Record of this office.

दिनांक/Dated this Monday 04th day of January 2021

लेबल तथा संलग्न/Label As Annexed



(S. B. PALO)
DEPUTY REGISTRAR OF TRADE MARKS.



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18. Accordingly, the artistic work, which the Respondent had applied for, got registered under the Copyright Act.

19. It is the submission of Id. Counsel for the Petitioner that an identical mark being used even as an artistic work would result in complete violation of the Petitioner's right. Moreover, the 'BOSS' mark could not have been registered and the search certificate was itself completely untenable. The submission of Mr. Bansal is that the copyright registration is liable to be expunged.

20. Under Section 50 of the Act, any entry which has been wrongly made and is remaining on the register, can be expunged by filing the rectification petition before the High Court. Such a rectification petition, can thus be filed by any 'person aggrieved' by the registration. Section 50 of the Act is set out below for ready reference:

"50. Rectification of Register by High Court.— The High Court, on application of the Registrar of Copyrights or of any person aggrieved, shall order the rectification of the Register of Copyrights by—
(a) the making of any entry wrongly omitted to be made in the register, or
(b) the expunging of any entry wrongly made in, or remaining on, the register, or
(c) the correction of any error or defect in the register."

21. While, the term 'person aggrieved' is not defined in the Copyright Act, the said term/expression has been used in several statutes in India. In **Bar Council of Maharashtra v. M.V. Dabholkar and Ors., (1975) 2 SCC 702**, a Seven Judges Bench of the Supreme Court had held:

"The words 'person aggrieved' are found in several statutes. The meaning of the words "person aggrieved" will have to be ascertained with reference



to the purpose and the provisions of the statute. Some times, it is said that the words "person aggrieved" correspond to the requirement of locus standi which arises in relation to judicial remedies."

22. Vide judgement dated 26th May, 2005, a Id. Division Bench of this Court in *Shri Ganga Vishnu Raheja vs Shri Swami Satyanand Dharmarth Trust, 2005 (30) PTC 577 Del* had observed that though the object and intention of the Trade Marks Act, 1999 and the Copyright Act, 1957 were different, Courts could look into the interpretation and meaning given to two identical expressions given in different statutes. The relevant extract of the said decision is set out below:

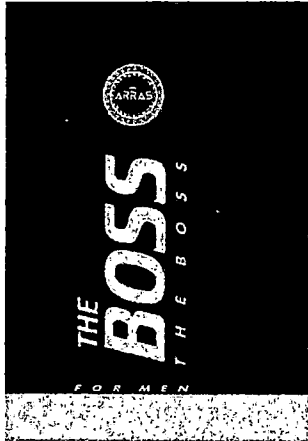

"21. The issue, therefore, which falls for our consideration, is whether the appellant could be said to be a 'person aggrieved' who can seek for cancellation of the registration of copyright in respect of all 11 books authored by Swami Ji and registered in favor of the respondent trust. The aforesaid issue was the bone of contention between the parties before the Copyright Board, which held that the appellant is not a 'person aggrieved'. The same question, therefore, arises before us for our consideration as to whether or not the appellant could be said to be a person aggrieved. The said expression is not defined either under the Copyright Act or under the Trade Marks Act. The object and the intention of the Copyright Act and the Trade Marks Act is not the same. The purpose for which the aforesaid two Acts were enacted and as stated in the statement of objects and reasons are distinctly different. Still it does not preclude us from looking into a similar expression and the interpretation and meaning given to the same expressions under different legislations. In the decision in National Bell co. (supra), a meaning and interpretation is given to the expression aggrieved person with reference to Trade Marks Act. According to



the said decision, the said expression includes a person against whom infringement action is taken or threatened.”

23. The ‘person aggrieved’ is a person, who has a real and tangible interest in the work or in the mark. In the context of the present case, the Petitioner is clearly a person aggrieved owing to its common law rights and statutory rights in the mark BOSS. Further, considering that the Petitioner and Respondent No. 1 are operating in the same trade, i.e., perfumes and fragrances, it is reasonable to believe that the Petitioner would be adversely affected by the impugned Copyright registration held by Respondent No. 1. The Petitioner would be severely aggrieved due to the fact that the registration of the copyright would dilute and erode the rights of the Petitioner in the BOSS mark which forms an integral part of the work for which the Respondent has obtained a registration. Thus the Petitioner is clearly a ‘person aggrieved’.

24. A comparative table of the impugned artistic work of the Respondent and one of the labels of the Petitioner is set out below:

Impugned Copyright Registration	Petitioner’s labels/Trade Marks
	



25. This Court in *Marico (supra)*, has also held that when two labels or artistic works are compared, to determine if they are original, the broad features of both the labels/works are to be compared. It has also been held that colour scheme and objects/items used in the artistic work also are a factor while determining substantial similarity/reproduction as also colourable imitation. The relevant extracts of the said decision are extracted as under:

*"6. A perusal of the labels extracted hereinabove shows that the comparative features of the two labels are so similar that "NIHAL UTTAM" label can safely be termed as colourful imitation or substantive reproduction. Colour scheme between the two labels is the same. The manner in which the coconut tree is arranged is the same, the arrangement of two broken coconuts is similar. Due to the long user in the market, the Appellant's label was quite extensively used and hence the Respondent had access to the Appellant's label. It is the settled position in law that when two labels or artistic works are compared, the broad features are to be compared and not by putting the two labels side by side. The Supreme Court in *Parle Products P. Ltd. v. J. P. & Co., Mysore (1972) 1 SCC 618* observed as under:*

"9. It is therefore clear that in order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one, to accept the other if offered to him. In



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this case we find that the packets are practically of the same size, the colour scheme of the two wrappers is almost the same; the design on both though not identical bears such a close resemblance that one can easily be mistaken for the other. The essential features of both are that there is a girl with one arm raised and carrying something in the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence. The word "Glucose Biscuits" in one and "Glucose Biscuits" on the other occupy a prominent place at the top with a good deal of similarity between the two writings. Anyone in our opinion who has a look at one of the packets to-day may easily mistake the other if shown on another day as being the same article which he had seen before. If one was not careful enough to note the peculiar features of the wrapper on the plaintiffs' goods, he might easily mistake the defendants' wrapper for the plaintiffs' if shown to him some time after he had seen the plaintiffs'. After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes. We have therefore no doubt that the defendants' wrapper is deceptively similar to the plaintiffs' which was registered. We do not think it necessary, to refer to the decisions referred to at the Bar as in our view each case will have to be judged on its own features and it would be of no use to note on how many points there was similarity and in how many others there was absence of it."

Though the above observation has been rendered in the context of comparison of label marks in a passing off action, the tests for comparison of labels which are



artistic works, would be the same.

xxx

xxx

xxx

13. A perusal of the Trademark Registrar's website shows that the Respondent has attempted registration of various trademarks bearing Nos. 1105118 for NIHAL UTTAM, 1452054 for NIHAL ACTIVE WASHING POWDER, 1452057 FOR NIHAL ACTIVE (LABEL), 1584396 for NIHAL ACTVIE FRESH, DEVICE OF WASHING MACHINE & BUBBLES (LABEL) and 1584398 for NIHAL GOLD, JK (MONO), DEVICE OF COCONUT, COCONUT TREE & DROPS (LABEL). All of the above trademarks have been refused, withdrawn or opposed. Thus, the Respondent appears to be making a special attempt to imitate the Appellant and copy various marks and labels of the Appellant. The conduct of the Respondent is clearly dishonest and thus, the dictum of Justice Kekewich in *Munday v Carey* (1905) R.P.C 273 at 276 clearly applies wherein the Court held as under:

"Where you see dishonesty, then even though the similarity were less than it is here, you ought, I think, to pay great attention to the items of similarity, and less to the items of dissimilarity"

26. In terms of Section 13(1)(a) of the Act, in order to be able to obtain copyright protection, an artistic work would be required to meet the threshold of originality. After perusing the above table, it is evident that the impugned artistic work is definitely not an original artistic work and primarily consists of the mark 'BOSS', which does not belong to Respondent No. 1. Even the colour scheme of the Petitioner has been substantially imitated by Respondent No. 1, which would also supplement the finding that the impugned registration is not an original work.



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27. Recently, vide judgement dated 6th September, 2023, this Court in, ***Manju Singal Proprietor Singla Food Products v. Deepak Kumar, Deepak Manocha, Sara Sales and Anr., 2023:DHC:6445***, while referring to the commentary, ***The Modern Law of Copyright and Designs, Fourth Edition*** by ***Laddie, Prescott and Victoria***, has emphasised emphasized that in discussions of ‘originality’ and ‘substantial part’, it is crucial to understand that if there is substantial similarity between two works, the later work cannot be considered original. The relevant extract from the same is set out below:

“The key question is, therefore: has the second man taken a substantial part of what the first man has created? The expression ‘work’ refers to a human creation; the artefact is merely the object in which the creation is embodied, as may be seen from the fact that the copyright in the work survives accidental destruction of the artefact. As was well put by Prichard J in a New Zealand case:

“It is not enough that there is a causal connection with a drawing in which the plaintiff owns copyright. There must also be such similarity between the article made by the defendant and a drawing in which the plaintiff has copyright that it be seen that a substantial amount of the skill and effort which was devoted to can making the drawing was appropriated by the defendant.

xxx

xxx

xxx

4.37 Whether or not a substantial part has been reproduced must be determined by reference to the copyright work and not the work that is alleged to infringe. The question in any particular case is whether the features found to have been copied from the copyright work formed a substantial part of that work as



an artistic work. That is a question of judgement or impression. However, in answering it, it is not generally relevant to consider whether the features that are alleged to have been copied also comprise a substantial part of the alleged infringing work. As a result, even though the alleged infringing work may not look particularly similar to the copyright work, it may amount to an infringement. That said, in certain cases it may still be important still not to lose sight of the differences between the copyright work and the alleged infringement since they may help to decide whether copying has taken place at all.

28. Registration of copyright can be granted only in respect of original works. It is inexplicable how the Trade Marks Registry issued a clear search report in respect of the impugned work, when clearly in respect of the Respondent's trade mark application, the Petitioner's marks were cited as conflicting. The search report itself is riddled with inaccuracies and contrary to the Register of Trade Marks. If any person or entity mis-describes the work as an original work, when it is actually not and it is also a substantial imitation of a registered Trade Mark and label, such registration would be a registration wrongly remaining on the Register of Copyrights. In view of this position and the prior and superior rights enjoyed by the Petitioner, the Respondent's registration is an entry, which is wrongly made and is also wrongly remaining in the register.

29. Notices were issued in this petition on 19th July, 2023. Despite repeated notice, Respondent No. 1 has not appeared in the matter. The last order dated 22nd November, 2023 clearly records that the Respondent has been served.

30. Since the Respondent has not appeared, the Respondent is proceeded



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ex-parte. Further, in terms of **Rule 6** of the *Delhi High Court Intellectual Property Rights Division Rules, 2022*, no evidence needs to be recorded in the present appeal as the Court deems it necessary considering facts are not seriously in dispute in this case.

31. Merits of the matter have been considered by this Court. The artistic work 'ARRAS THE BOSS' is an imitative mark and artistic work and not an original artistic work. Moreover, Respondent No. 1 cannot claim any rights in the mark 'BOSS' and thus, cannot own a copyright registration in an artistic work, the essential feature of which is the mark BOSS. The list of marks, which have been applied by Respondent No. 1, would also show that Respondent No. 1 is indulging in habitual copying of various well-known marks. Irrespective of the same, in the present case, this Court has no doubt that the grant of copyright registration is flawed due to severe procedural and substantive irregularities in view of the search report being clearly defective.

32. Accordingly, the copyright registration bearing no. A-136350/2021 is expunged and cancelled from the Register of Copyrights. Let this order be reflected on the website of CGPDTM within four weeks.

33. Accordingly, the petition is allowed and disposed of. All pending applications are also disposed of.

34. The Registry is directed to supply a copy of the present order to the office of the Controller General of Patents, Designs & Trademarks of India on the e-mail- llc-ipo@gov.in for compliance of this order.

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PRATHIBA M. SINGH
JUDGE

DECEMBER 08, 2023/dk/am
[Corrected and released on 13th December, 2023]

