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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Date of Decision: 15th March, 2024.

+ C.O.(COMM.IPD-CR) 875/2022, I.A. 19662/2022

KUNAL MONDAL

..... Petitioner

Through: Mr. Anirudh Bakhru, Mr. D.K. Yadav, Mr. Kapil Yadav, Ms. Pragya Choudhary, Ms. Vijay Laxmi Rathi, Mr. Umang Tyagi and Ms. Chanchal Bhardwaj, Advocates.

versus

UNION OF INDIA AND ORS.

..... Respondents

Through: Mr. Rakesh Kumar, CGSC with Mr. Sunil and Mr. Satyanand Kumar, Advocates for R-1, 3. Mr. Lovenish Mendiratta and Mr. Arun Kumar, Advocates for R-2.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA

JUDGMENT

SANJEEV NARULA, J. (Oral):

C.O.(COMM.IPD-CR) 875/2022

1. This case presents a dispute over of copyright ownership relating to an artistic label applied to tobacco products. Both the Petitioner and Respondent have obtained copyright registration for their respective labels, which bear a striking resemblance to each other. The Court must now determine whether the existing copyright registration of Respondent No.2, impugned in this petition is valid by identifying the true owner of the



intellectual property inherent in the disputed artistic work.



2. Mr. Anirudh Bakhru, counsel for Petitioner, has narrated the factual backdrop to the instant petition as follows:

2.1. The Petitioner, sole proprietor of M/s Anjali Trading Company, commenced their business of manufacturing and trading, *inter alia*, tobacco products, smokers items and *bidi*¹, in the year 1999. In connection with this business, they adopted the trademark/ label ‘**NEW CALCUTTA BIDI**’. This trademark/ label is presented in a unique artistic manner, incorporating distinctive get-up, lettering style, colour schemes, and a characteristic placement of words. A particularly notable aspect of the artistic work is the depiction of a sunrise behind tree-lined hillocks, complemented by additional creative details.

2.2. In the same year of its creation, the Petitioner sought to formalize this identity by registering with the Central Excise, submitting the artistic work for approval. To further secure legal protection, the Petitioner subsequently filed trademark applications under the Trade Marks Act, 1999 [“*TM Act*”]. Some of these applications were opposed by Respondent No. 2.


2.3. In 2021, the Petitioner sought to bolster their intellectual property rights over their distinctive labels by applying for copyright registrations for




labels ‘’ and ‘’, which were granted in their favour. These applications were successful, and the Petitioner became the registered

¹ Also referred to as “*Biri*”.



proprietor of the copyright in the label ‘’ under No. A-



138413/2021, and the label ‘’ under No. A-139752/2021. Notably, the Petitioner obtained the necessary No Objection Certificates (NOCs) from the Registrar of Trademarks before pursuing copyright registration. The Petitioner thus created a public record of the ownership over the creative works referred above conferring them statutory rights under the Copyright Act 1957 [*“Copyright Act”*].

2.4. In March of 2022, the Petitioner discovered that Respondent No. 2 had obtained copyright registration (No. A-139634/2021) [*“Impugned Copyright”*], for a work strikingly similar – to the point of being nearly identical – to the Petitioner’s previously copyrighted labels. It is important to note that Respondent No. 2, like the Petitioner, had also obtained a No Objection Certificate from the Trademark Registry prior to this copyright registration. Alarmed by this development, the Petitioner, asserting their prior claim as the original creators and copyright holders, has initiated the present action seeking cancellation of the Impugned Copyright.

3. In the above background, Mr. Anirudh Bakhru has advanced the following submissions in support of the Petitioner’s case:

3.1. As the original creator and author of the artistic work embodied in the ‘NEW CALCUTTA BIDI’ trademarks/ labels, the Petitioner holds sole ownership and exclusive rights over this work. This grants them the exclusive legal right to use, publish, reproduce, or engage in any



transactions involving this trademark/label. Respondent No. 2's unauthorized registration and use of a nearly identical work constitutes a direct infringement of the Petitioner's statutory rights under the Copyright Act.

3.2. The fact that that Respondent No. 2's Impugned Copyright is an exact replica of the Petitioner's original label is demonstrably evident from a side-by-side comparison chart depicting the key elements of the competing labels, a copy whereof is reproduced as under:

REPRESENTATION OF PETITIONER'S ARTISTIC WORK	REPRESENTATION OF ARTISTIC WORK OF THE RESPONDENT NO. 2 ILLEGALLY COPIED.
	
	

3.3. Respondent No. 2's Impugned Copyright reveals a deliberate and unmistakable imitation of the Petitioner's original label. It replicates not merely a few elements, but the label's comprehensive get-up, lettering style, colour schemes, word placement, and even the unique artistic details such as



the depiction of a sun rising behind tree-lined hillocks. This extensive, near-identical reproduction, including specific colour combinations, strongly suggests a clear intent on the part of Respondent No.2 to infringe upon the Petitioner's copyright.

3.4. The Petitioner's swift response in filing an FIR against Respondent No. 2, even before the application for the Impugned Copyright was filed, demonstrates their strong objection to this infringement. This proactive measure underscores the Petitioner's commitment to protecting their intellectual property and preventing unauthorized use of their original artistic work.

4. Mr. Lovenish Mendiratta, counsel for Respondent No. 2, strongly controverts the aforementioned contentions. His submissions are summarised as follows:

4.1. Petitioner does not hold the original authorship of the contested artistic work. In support of this averment, reliance is placed on the Settlement Agreement effected between the Petitioner and a third party—Hindustan Bidi Manufacturing. This Agreement, arising from a separate lawsuit, contains an acknowledgment from the Petitioner that they would cease using the mark "NEW CALCUTTA BIRI" and modify their trademark to "CALCULATOR." Furthermore, the Agreement includes the Petitioner's relinquishment of rights to the depiction of the Howrah Bridge. This concessions fundamentally undermine the Petitioner's claim of originality over the artistic work.

4.2. Respondent No. 2 asserts their position as the prior adopter and user of the disputed label. They directly challenge the reliability of the Petitioner's handwritten invoices from 2018, emphasizing that printed



invoices, which would better substantiate the Petitioner's claim, are unavailable before 2021. In contrast, Respondent No. 2 presents their GST registration dated 20th February 20, 2018, as compelling evidence of their earlier use. This, they argue, establishes their position as the original creator of the label. Consequently, Respondent No. 2 contends that the Petitioner's infringement allegations lack merit, warranting the dismissal of the petition.

ANALYSIS AND FINDINGS

5. Having carefully examined the arguments presented and reviewed the relevant documents, the Court now turns its attention to the heart of the matter – copyright infringement, which would help resolve the dispute at hand. Copyright law serves as a shield, protecting the original and creative works of authors. It grants them exclusive rights, including control over the use, reproduction, and distribution of their creations. The crux of copyright infringement lies in the unauthorized copying of substantial or protected elements. Therefore, a meticulous comparison of the two allegedly infringing labels is necessary to determine if a copyright violation has occurred.

6. With this principle of substantial similarity in mind, a close examination of the comparison chart reveals a high degree of similarity between the labels, directly contradicting Respondent No. 2's claim of distinctiveness. This observation is further bolstered by an admission within the counter-statement filed by Respondent No. 2, wherein they paradoxically argue that their mark "NEW GOLD KOLKATA BIRI NO 220" possesses unique characteristics/ distinctive features, while simultaneously alleging that the Petitioner had blatantly copied the Impugned Copyright. This contradictory stance implicitly acknowledges the substantial similarities



between the two artistic works. The relevant portion of reply/ counter statement filed by Respondent No. 2, is extracted hereunder:

“That the trade mark/artistic work NEW GOLD KOLKATA BIRI NO 220 of the Respondent No.2 is not identical/similar to the alleged trade mark/artistic work of the Petitioner. In fact, the Respondent is the first and prior adopter and user of the trade mark/label/artistic work NEW GOLD KOLKATA BIRI NO 220 having distinctive features and using the same since 2017 for goods biri. On the other hand, it is humbly submitted that the alleged trade mark/label of the Petitioner is slavish copy including colour, representation and layout of the trade mark/ artistic work of the Respondent No.2. The Petitioner who has itself copied the alleged trade mark/label from the trade mark/label of the Respondent No.2. The Petitioner has failed to establish the user of its alleged trade mark/label prior to the trade mark/label in question of the Respondent No.2. The Petitioner has no case.”

7. Despite Respondent No. 2’ s implicit acknowledgment of similarities between the labels, their claim of prior adoption necessitates a closer examination of originality and the sequence of creation and use. Therefore, the Court must focus on establishing the primacy of copyright ownership, the authenticity of the claimed originality, and the evidentiary basis supporting each party’s claims of prior use and adoption.

8. In instances of substantial similarity, publication dates can be crucial in determining the original work. Publicly documented release establishes a clear timeline for a work’s existence, which becomes vital evidence in originality disputes. In the instant case, the Petitioner has demonstrated their prior use on the basis of the public record. Specifically, Petitioner has placed on record the certificate dated 12th October, 1999, issued by the Central Excise Department, which approved the Petitioner’s label/ artistic work, the subject matter of their copyright. The said certificate annexes copies of the Petitioner’s label/ artistic work, as reproduced hereunder:



9. The aforementioned Central Excise Department certificate compellingly demonstrates that the Petitioner had published their label/artistic work, featuring the distinctive rising sun over the tree-adorned hillocks, as early as 1999. This early documentation unequivocally establishes the timeline of the Petitioner's claim to copyright ownership of the said artistic work. Furthermore, the Petitioner's claim is also supported by their engagement with the trademark process. Although Petitioner's trademark application No. 1666910 for registration of the same label in Class 34, filed on 19th March, 2008, was abandoned, it serves as an indicator of the steps undertaken by the Petitioner to safeguard the label as a distinct



trademark. This too reinforces their claim to original authorship. Invoices and additional trademark applications provided by the Petitioner further document their continuous use of the copyrighted label/artistic work. These credible evidences affirms the Petitioner's position as the original creator and substantiates the longstanding association of the artistic work with their brand, significantly predating Respondent No. 2's claims.

10. Respondent No. 2 attempts to demonstrate prior use by presenting handwritten invoices dated from 2017 onwards. However, these are significantly later than the Petitioner's well-documented 1999 evidence. Notably, these handwritten invoices undermine Mr. Mendiratta's own argument against the validity of the Petitioner's similar invoices. Furthermore, as Mr. Bakhru observes, discrepancies exist within these invoices. Some dates predate Respondent No. 2's GST registration, raising concerns of potential foul play – an issue formally raised by the Petitioner through CRL.M.A. 651/2024. While handwritten invoices from both parties can hold evidentiary value in proving use, the timing and inconsistencies within Respondent No. 2's invoices significantly diminish their claim of prior use.

11. The Court must now address Mr. Mendiratta's argument regarding the Settlement Agreement, the implications of relinquishing their use of 'CALCUTTA' from their trademark/ trade name, along with certain elements of their copyrighted label. We find that this agreement does not negate the Petitioner's ownership rights over the entirety of the artistic work. While it is true that the Petitioner has consented to discontinue their use of 'CALCUTTA' in favour of 'CALCULATOR', and remove the HOWRAH BRIDGE imagery in their label, this adjustment resulted from a specific



agreement with another party. Petitioner's relinquishment of certain elements does not inherently diminish their claim to original authorship of the broader artistic work and does not constitute an admission of lacking original authorship in the overall artistic work.

12. In determining the present dispute between the two competing artistic works, the Court will apply the principle of substantial similarity. This approach, supported by the precedents as by the Petitioner², concentrates on the cumulative impact of the artworks rather than isolating minor discrepancies. Under this scrutiny, it becomes evident that the critical features of the artistic work claimed by the Petitioner as their unique creation—specifically, the depiction of a rising sun over hillocks dotted with trees, alongside the distinct colour scheme and overall composition—are replicated within the Respondent's Impugned Copyright. The Petitioner has substantiated, with compelling evidence, that these elements were part of their original artistic expression as far back as 1999.

13. Based on the afore-noted analysis, the Impugned Copyright is evidently a substantial reproduction of the Petitioner's copyrighted work, bordering on a colourable imitation. The substantial similarity between the two labels not only casts doubt on the originality of Respondent No. 2's work but also raises concerns of potential copyright infringement. Such infringement could diminish the value and distinctiveness of the Petitioner's established intellectual property. Respondent No. 2's replication directly undermines these core objectives of the Act which prioritizes originality as the measure of copyrightability.


² *Marico Ltd. v. Mrs. Jagit Kaur*, 2018 SCC OnLine Del 8488; *Manju Singal Proprietor Singla Food Products v. Deepak Kumar & Anr.*, 2023 SCC OnLine 5503.



14. In conclusion, the Impugned Copyright exhibits substantial reproduction and colourable imitation of the Petitioner's original work. This lack of originality undermines the validity of their copyright registration. Petitioner's original creative expression must be accorded primacy and protected. Accordingly, the present petition is allowed with the following directions:

14.1. Copyright Registration No. A-139634/2021 for label



“  ” shall stand rectified and Respondent No. 2 shall no longer rely upon the said copyright registration.

14.2. Respondent No. 1 shall take all necessary steps to reflect the effect of this order on the Register of Copyrights, including the online platform, within two weeks from the date of uploading of this order. Let this order be communicated to Respondent No. 1 through their counsel to ensure timely compliance. Additionally, a copy of this order shall also be sent directly to the Registrar of Copyrights for their records.

15. With the above directions, the petition is allowed, with no orders as to costs.

CRL.M.A. 651/2024

16. For adjudication of the above-captioned application, the presence of Respondent No. 1 is not necessary, and is therefore dispensed with.

17. List on 3rd July, 2024.

SANJEEV NARULA, J

MARCH 15, 2024/nk