

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

% **Date of decision: 1st February, 2022.**

+ **C.O.(COMM.IPD-CR) 4/2021, I.A. No. 11085/2021 (u/O-39R-1 &2) & I.A. No. 11087/2021 (for summoning of record)**

THE POLO/LAUREN COMPANY L P **Decree Holder**

Through: Mr. Shivang Bansal with Mr. Rahul Sharma and Mr. Saurabh Arora, Advocates.

Versus

SANDEEP ARORA & ANR. **Judgement Debtors**

Through: Mr. Krishna Kumar Mishra with Mr. Aashish Kumar, Advocate for R-1.
Ms. Suparna Srivastava, CGSC with Mr. Tushar Mathur, Advocates for R-2.

CORAM:
HON'BLE MR. JUSTICE AMIT BANSAL
[VIA VIDEO CONFERENCING]

JUDGMENT

AMIT BANSAL, J. (Oral)

1. This rectification petition has been filed under Section 50 of the Copyright Act, 1957 (hereinafter '*the Act*') seeking removal of the registration made in the Register of Copyright in respect of impugned artwork of the respondent no.1, namely, 'SPORTS POLO' under No. A-136709/2021, obtained by the respondent no.1 in the year 2021.

2. It is the case of the petitioner that (i) the petitioner is the registered proprietor and user of the mark 'POLO SPORT' since the year 1967 along

with a device mark of a ‘horse with a person riding it while flinging his club to hit a ball in the sport of polo’; (ii) the trademarks of the petitioner are formative in nature and the petitioner has created various combinations and versions of the same; (iii) the formative marks of the petitioner are registered as trademarks in India under the Trade Marks Act, 1999 in respect of various goods and services *inter alia* clothing, textiles, foot-wear, soaps, perfumes etc., details of which have been provided by the petitioner; (iv) the trademark of the petitioner is a “well-known” mark, as recognized by this Court in its judgment dated 19th December, 2011 in CS(OS) 1763/2005 titled as ***The Polo/Lauren Company L.P. Vs. Rohit S. Bajaj and Ors.*** and the aforesaid trademarks have acquired immense good will and reputation over the years; (v) the said formative marks are capable of distinguishing goods of the petitioner with those of the others; (vi) the artistic work adopted by the respondent no.1 in the impugned copyright registration is an infringement of the petitioner’s literary and artistic copyright as the respondent no.1 has substantially reproduced in material form many aspects of the petitioner’s registered marks; (vii) the respondent no.1 has also misappropriated the words ‘Polo’ and ‘Sport’ in their entirety and the only distinguishing feature is that the respondent no.1 has added four horses with riders who are playing the game of polo, as compared to the petitioner’s mark having one horse with a rider playing polo; (viii) the work of the respondent no.1 is not an original literary/artistic work in respect of Section 13 (1) (a) of the Act; (ix) the Registry failed to act in terms of Section 45 of the Act, as a careful search of the Register of Trademarks would have clearly indicated the similarity between the petitioner’s trademarks, in respect of which the copyright also subsists in the respondents’ artistic

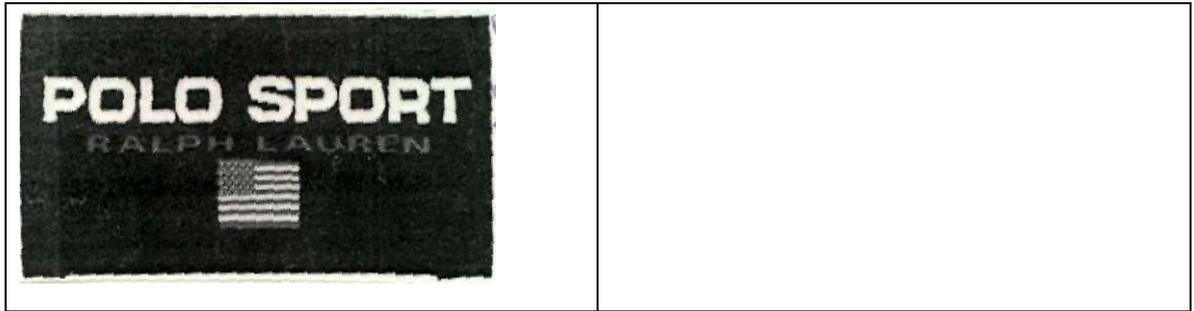
work; and, (x) since the work of the respondents is an unpublished copyright, no prejudice would be caused to the respondents if the said mark is removed from the Register of Copyrights. Accordingly, the counsel for the petitioner submitted that the Registration Certificate granted in favour of the respondent no.1 should be cancelled.

3. A reply has been filed on behalf of respondent no.1 wherein it is stated that (i) the said respondent has been using the words ‘ARRAS SPORTS POLO’ since the year 2020 in their perfumery business; (ii) their copyrighted mark is substantially different from that of the petitioner’s marks; and, (iii) even in respect of logo, the respondent is using four horses with riders on them, who are not playing the game of polo and therefore, the same is very different from the registered trademarks of the petitioner.

4. I have heard the counsels for the parties.

5. In order to determine whether the logo of the respondent no.1 is a substantive reproduction of the trademarks of the petitioner, it would be apposite to refer to the two competing marks/logos, as set out below:

PETITIONER’S MARKS	RESPONDENT’S LOGO
	



6. A perusal of the above reveals that the logo of the respondent no.1 is an imitation of the registered trademarks of the petitioner, hence, the petitioner is 'a person aggrieved' for the purposes of Section 50 of the Act and is entitled to maintain the present petition. Section 50 of the Act is set out below:

“50. Rectification of Register by Appellate Board.- The Appellate Board 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 wrongly omitted to 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.”

7. In order to satisfy the conditions of Section 13 (1) (a) of the Act, an artistic work would have to satisfy the test of originality. Section 13(1) (a) of the Act is set out hereinbelow for ease of reference:

“13. Works in which copyright subsists.— (1) Subject to the provisions of this section and the other provisions of this Act, copyright shall subsist throughout India in the following classes of works, that is to say,—

(a) original literary, dramatic, musical and artistic works;

It is clear from a comparison of the competing marks/logos that the respondent no.1 has used four horses with riders, tilted in a manner very similar to the logo of ‘horse with a person riding it while flinging his club to hit a ball in the sport of polo’, which is a registered trademark of the petitioner. While comparing the two marks, the qualitative differences have to be examined and not the quantitative difference. So, the respondent no.1 using four horses as against the petitioner using one would not, in my mind, make a qualitative difference. Not only the horses, the respondent no.1 has also used the word marks of the petitioner i.e. SPORTS and POLO. The differences between the logo of the respondent no.1 and the trademarks of the petitioner pointed out by the counsel for the respondent no.1 are minor differences and not significant enough to make the logo, which is subject matter of the impugned copyright, an original artistic work eligible to be registered as a copyright.

8. When seeking registration under the Act in respect of artistic work, the application has to include the statement to the fact that the said artistic work is used or is capable of being used in relation to any goods and services and has to be accompanied by a certificate from the Registry of Trademarks referred to in Section 3 of the Act to the effect that no trademark identical and/or deceptively similar to such artistic work has been registered under the Trademarks Act. This stems from the proviso to Section 45 (1) of the Act, reproduced hereinafter:

“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 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 subsection (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. Clearly, the respondent no.2 has failed to conduct this exercise in the present case before issuing the certificate in favour of respondent no.1. If the respondent no.2 had checked the records of the Register of Trademarks, it would have emerged that trademarks that are identical/deceptively similar to the logo of the respondent no.1 have been granted registration in favour of the petitioner.

10. This Court in *Marico Ltd. Vs. Mrs. Jagjit Kaur*, 2018 SCC OnLine Del 8488 while dealing with the issue of rectification of copyright had observed as under:

“5. The question that arises in this case is as to whether the Respondent's impugned copyright registration is an “entry wrongly made in or remaining on the Copyright Register”. Any entry made of a work which is not an original work would be an entry wrongly made in the Register. A perusal of the Respondent's registration shows that the Respondent claims the “NIHAR UTTAM” label extracted above to be

an 'artistic work' published for the first time in 2002. Copyright registration can only be granted to original artistic works. Registration of copyright cannot be granted to works which are a reproduction or imitation of other original works. If any person has obtained registration of copyright of a work which is not an original work under Section 13 of the Copyright Act, such a registration or entry made in the register would be an entry wrongly made.

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."*

11. The above observations are squarely applicable to the facts and circumstances of the present case. The registered trademarks of the petitioner i.e. 'POLO SPORT' and '*horse with a person riding it while flinging his club to hit a ball in the sport of polo*' have been widely used in the market for a variety of products since 1967. The judgment of this Court in ***The Polo/Lauren Company L.P*** (supra) unequivocally records that the petitioner's marks are well-known in the market and the products of the petitioner enjoy high reputation and goodwill. Additionally, the petitioner has also filed documents containing advertisements and promotional material of the petitioner along with news articles detailing the list of stores operated by the petitioner in India. The aforesaid documents clearly establish that the petitioner's trademarks have been in the market since 1967 and owing to their popularity, have been substantially reproduced by the

respondent no.1 in its logo. The logo of the respondent no.1 which is subject matter of the impugned copyright contains the words SPORTS and POLO and the image of four horses with riders. The arrangement of the tilted horses as well as the colour scheme of the aforesaid logo leaves no doubt in my mind that the respondent no.1 has dishonestly and in bad faith copied the registered trademarks of the petitioner. The artistic works in the logo of the respondent no.1 is almost an imitation of the trademarks of the petitioner and is not an original artistic work for the purposes of registration under the Act and deserves to be expunged from the Register of Copyrights.

12. Accordingly, the present petition is allowed. The respondent no.2 is directed to cancel the impugned copyright registration for the artwork titled 'SPORTS POLO' under No. A-136709/2021 from the Register of Copyrights within eight weeks.

13. Pending applications stand disposed of.

FEBRUARY 1, 2022

at

AMIT BANSAL, J.

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