

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

% *Judgment Reserved on: April 01, 2016*
Judgment Delivered on: April 07, 2016

+ **FAO(OS) COMM 11/2016**

APPLE INC Appellant
Represented by: Mr.Sudhir Chandra, Sr.Advocate
instructed by Mr.Pravin Anand and
Mr.Aditya Gupta, Advocates

versus

ROHIT SINGH & ANR. Respondents
Represented by: Ms.Shwetashree Majumdar, Advocate
with Ms.Prithvi Singh, Ms.Tanya
Varma and Mr.Vishnu Rege,
Advocates

CORAM:

HON'BLE MR. JUSTICE PRADEEP NANDRAJOG

HON'BLE MS. JUSTICE MUKTA GUPTA

PRADEEP NANDRAJOG, J.

1. Rohit Singh is a software developer and works as a consultant with Vyoooh Low Level Computing LLP. The two joined in an action, as plaintiffs, claiming relief of damages as also an injunction against Apple Inc from using the mark 'SplitView' or a deceptively similar variant thereof in relation to its software products.
2. The action is one of passing of.
3. As per Rohit Singh, he developed three proprietary software products targeted at the end consumers which he named SplitView, Disk View and ViewScribe respectively. As per him, the trademark in issue in the suit i.e. SplitView was the most commercial successful product. It permitted the user to simultaneously work on multiple windows on the users' computer

screen. He initially sold his software products through a sole proprietary concern named Vyoooh and later on formed a single member limited liability company called Vyoooh LCC, through which he sold his software products and in the year 2010 he gave an exclusive license of his software products to Vyoooh Low Level Computing LLP. As per him, the motivation to develop a software on which two or more applications on the computer screen could be simultaneously opened was, he observing in the year 2005 that there was a consumer need to have two or more applications simultaneously opened. Consumers were using two monitors to overcome the problem which was cumbersome and costly. Having developed the software in the year 2005, he purchased the domain name www.splitview.com in August 2005 and has since then been selling the software. He pleaded that he had applied for registration of the trademark SplitView in the United States of America and in India. He claimed uniqueness and innovativeness in his software which earned the product Citrix Ready Membership on account of Citrix finding his product compatible with Citrix XenApp and XenDesktop as delivering a true multi-monitor experience with server based computing. He claimed reputation and goodwill in the product, disclosing sales of US\$ 5.9 million over the last decade; with over 14000 paying customers.

4. He pleaded that Apple Inc launched an update to their operating software – Mac OS X El Capitan and iOS 9 in December, 2015 for computer and mobile devices respectively, which allowed the monitor and/or screen on the iPad to be split into two halves to enable working on two applications, and the feature had been named Split View by Apple Inc. He pleaded that functionally the product of Apple Inc fulfils the same purpose of letting the user work on two applications simultaneously, without having to manually resize each of the application windows; the only

difference being that Apple Inc's product was bundled with Apple's Operating System and was not available for retail sale nor it was meant for Operating Systems other than MAC OS X El Capitan Operating System and iOS 9. He pleaded having sent an e-mail on December 30, 2015 to Apple putting it to notice of his right in the trademark SplitView to which he received a response from January 14, 2016 in which Apple accepted his right in the trademark SplitView but claimed using it in a descriptive sense; but simultaneously questioning whether SplitView could at all be a trademark; alleging it being descriptive.

5. As per Rohit Singh, SplitView is capable of being a trademark because the word Split and the word View are not words that would ordinarily be used in conjunction with each other. To bring home this argument he referred to a number of third party operating systems which allow for multi monitor functionality, none of which adopted names similar to SplitView or used Split View in a descriptive manner to describe the functionality of their software. The product of the third parties being Divvy, AquaSnap, GridMove, WindowSpace, MaxTo and Gridy.

6. The suit, accompanied by IA No.2885/2016, came up for admission before the learned Single Judge on March 01, 2016. Issuing summons in the suit returnable for May 09, 2016, invoking power under Order 39 Rule 1 and 2 of the Code of Civil Procedure, the learned Single Judge granted an ex-parte ad-interim injunction in favour of Rohit and Vyoooh Low Level Computing LLP and against Apple Inc restraining Apple Inc from in any manner using the trademark SplitView for any of the programmes and features within a programme or in any hardware or software.

7. Prima-facie finding in favour of Rohit and Vyoooh Low Level Computing LLP have been returned on the reasoning that the two have

established Rohit developing for the first time a computer programme which allows a user to simultaneously work on multiple windows on the users' computer screen and its sale since the year 2005. Reference has been made by the learned Single Judge to the plaintiff's e-mail dated December 30, 2015 and Apple's response on January 14, 2016 in which Apple did not dispute user of plaintiff's trademark SplitView for software programmes since the year 2006. The learned Single Judge has reasoned that the trademark SplitView was prima-facie a unique combination of two English words Split and View. The learned Single Judge has reasoned that names such as Split Screen, Split Monitor, Multi View, Dual View, Multi Screen and Dual Screen etc. were available to highlight the feature of a software programme which could enable a user to simultaneously work on multiple windows on the users' computer screen. Learned Single Judge has reasoned that other software programmers, having programmes allowing multiple windows on the users' computer screen had adopted different names such as Divvy, AquaSnap, GridMove, WindowSpace, MaxTo and Gridy.

8. Without invoking the right available under Order 39 Rule 4 of the Code of Civil Procedure, Apple Inc has chosen to file the instant appeal laying a challenge to the order dated March 01, 2006, and needless to state Apple has to skate on the ice wearing skates having a very thin blade. The reason? Being an appeal against an ex-parte ad-interim order the area encompassed in the appeal is small : Whether on the material placed before the learned Single Judge case was made out to grant an ex-parte ad-interim injunction. Apple has enlarged the area by urging suppression of material facts with reference to documents of Apple, through its predecessor NeXT Inc. being a prior user of the word SplitView since 1993 albeit as a feature of its product and with the plea that the same is good evidence that Split

View is descriptive of the essential functionality of the software i.e. a software which splits the screen and two windows open through which the contents of the two applications be simultaneously seen and operated upon. Another facet of suppression alleged is that third parties also used the words Split View in a descriptive sense and that said documents/literature are accessible on the net and thus Rohit, who claims to be a software wizard, could not be oblivious to the said documents. The charge is thus one of suppressio veri and suggestio falsi. It is also the case of Apple that though worded as a prohibitory injunction its acts as a mandatory injunction for the reason Apple would have to change its operating software.

9. We preface our discussion by highlighting that the area of the appeal sought to be extended required proper pleadings and thus one would be handicapped in deciding said factual matrix and that is the reason why remedy under Order 39 Rule 4 of the Code of Civil Procedure ought to have been availed of for the reason one of the many cardinal rules of pleadings is that if a document is material for the purpose of adjudicating a fact in issue, the effect of the document needs to be pleaded so that the opposite party knows with precision the case of the party relying upon the document to enable that opposite party to respond with equal precision qua its version regarding inference to be drawn from the document in question. When the appeal was listed before us for admission on March 28, 2016, said aspect was pointed out by us to the learned senior counsel for Apple, who replied that so ex-facie clear is the suppression and false pleadings that the appellant risks urging said aspect, sans pleadings before the learned Single Judge.

10. Thus, with respect to said aspect of the matter, the focus of our consideration would be : Whether ex-facie suppression or false pleadings emerge. For if the point becomes arguable, Apple has to be told to approach

the learned Single Judge by making proper pleadings to enable the respondents to respond in writing and then a full-fledged debate ensues between the parties. Thus, our reflection on the arguments and the documents relied upon would not be construed as any final opinion, save and except if we find it to be a case of gross suppression which is ex-facie apparent and/or a case of gross false pleadings which are discernible to the naked eye.

11. Case of Apple is that an operating system of a computer manages its memory; processes its software and hardware. For its Mac and iPad products Apple offers the OS X El Capitan and iOS operating systems respectively. The OS X El Capitan Operating System, which was shown live in Court, contains many in-built features which as per Apple are functionalities available to users to perform various functions. For instance, a user can access one's e-mail using the 'Mail' feature. The 'Photos' features lets the user manage its photograph. The 'Notes' feature helps a user make quick notes. One can browse the internet using Apple's 'Safari' feature. As per Apple, 'Split View' is also a feature. It splits the screen/users' view into different parts and allows the user to work on multiple windows simultaneously. It is the case of Apple that all these ('Mail', 'Photo', 'Notes', 'Safari' and 'Split View') are in-built features within the operating system. That is to say they are integrated with the operating system and are not sold separately by Apple to any user. A user wanting to avail all or any one of the features visits Apple's 'App Store' and downloads the OS X El Capitan Operating Systems and the package as a whole has to be purchased. The individual integrated features i.e. 'Notes' 'Mails' 'Photos' 'Safari' and 'Split View' cannot be purchased individually. As a matter of fact the purchaser cannot download these features separately.

He purchases the OS X El Capitan System as an integrated package. Apple highlights that it is not the case of the respondent that Split View is available as a ‘standalone’ software and is not integrated with the operating system; it cannot be bought or sold in any physical or the virtual market as a standalone product. Apple highlights that these in-built features of the OS X El Capitan Operating System could be contrasted with other software which can be separately bought as a standalone product. By way of example, the software in Microsoft Office which a MacBook user can download from the internet or buy from the physical market in CD-RoMs and download the software on the laptop. It is in this background that Apple argues that there exists a distinction between a ‘*product*’ and a ‘*feature*’. According to Apple, OS X El Capitan is the product which is bought and sold in the virtual market place of which Split View is a feature; to highlight this distinction Apple contrasts, as noted hereinabove, software programmes which can be purchased standalone.

12. With reference to the decision of the Supreme Court reported as AIR 1965 SC 1980 Kavi Raj Pandit Vs. Durga Dutt Sharma, Apple highlights that in an action for passing off, ‘*added matters*’ such as marks, get-up, packaging, writing on the product ensures that there is no likelihood of confusion or deception, Apple takes the argument forward by urging that since action initiated by respondents is one for passing off, the distinction between a separately marketable product bearing a trademark as against a feature having no standalone status because of it being integrated within the operating system has to be kept in mind and if so kept, it would not be a case of passing off. Apple highlights that the trademark for its operating system software is OS X El Capitan and iOS and not ‘Split View’. As per Apple the mode and manner of sale of products is also relevant. As regards its

products the consumer purchases one of the Mac line of computers or iPad Tablets with the operating system software already loaded on the device, and may periodically download updated software. According to Apple there is thus substantial use of added matter by it. In other words, a consumer encounters Apple's features in the market place as part of its integrated product which would also contain a number of other features, marks and writings.

13. Second limb of the contention of Apple is that the term 'Split View' was never conceptualized by the respondents and has been used by companies around the world for many years before respondents first allegedly used the phrase. In this regard, Apple cited the following:-

- i. Use by its predecessor-in-use, NeXT Computer, Inc. which used NXSplit View and NSSplitView in the 1990s in relation to a multi-window functionality.
- ii. Patent applications by entities such as Xerox Corporation (US20050086259A1), International Business Machines (US6226652B1), Seiko Instruments Inc. (US5477049A), Shih-Yang Wang (US20060020903A1) which were published prior to the year 2005 and use the term 'split view'.
- iii. Use by prominent entities such as Microsoft, Samsung, Apache OpenOffice, Sprint LG, Bluebeam, NQR Productions and AnguilaLab to describe a multi-window functionality.

14. Thus, according to Apple a commonly used phrase such as Split View cannot be said to be distinctive of a software programme because it is descriptive of the multi-window functionality provided by companies around the world for several decades and a consumer would never rely on a descriptive phrase to distinguish the product of the respondents from those

of others. As per Apple it has not used the symbols ‘*TM*’ nor applied for trademark registration for the expression Split View in any country because it can never be claimed as a trademark and as per Apple it does not claim trademark rights over the expression. Apple highlights that the words Split View do not appear either on any product or on any advertisement issued by it and that consumers do not place an order for Apple’s operating system by reference to the word ‘Split View’.

15. Conceding that for other features such as ‘Spot Light’ and ‘Mission Control’ Apple has applied for trademark protection, Apple urges that this is irrelevant because a feature which does not describe any characteristic of a product can be the subject matter of a trademark registration. Apple contrasts the names of features such as ‘Split View’, ‘Maps’, ‘Photos’, ‘Mail’, ‘Calendar’ and ‘Clock’ etc. to highlight that being descriptive of the functionality provided by these features, being not capable of a trademark registration, Apple has not applied for a trademark registration for them. Thus, Apple states that for such features which are descriptive, since no one can appropriate the word, it has not sought to appropriate the word and for such features where the word is not descriptive, it is within its right to do so.

16. The aspect of this argument, though not conceded to by learned senior counsel for Apple and for which lack of concession we were a little bit surprised, is that different items can be packaged and each item would be a product, but when packaged together and sold as a package under a trademark, the goods which are sold in the market, whether real or virtual are under the trademark of the package. It is akin to a combo offer. To wit : A chicken burger + A can of coke + French Fries, under the banner ‘Happy Meal’. The consumer buys Happy Meal and understands that he would get three things. The consumer cannot purchase only one of the three.

17. Put into distinct compartments the case of Apple hinges on four contentions:

A. That SplitView/Split View is a descriptive term and cannot assume trademark significance. On this basis, Apple argues that Rohit Singh cannot claim proprietorship over the mark, let alone seek to restrain third parties from using it.

B. That Apple is in fact a prior user of the word SplitView since 1993 through their predecessor in use NeXT Inc. and recognizing that the words Split View are descriptive of the functionality of the software, used the words Split View with reference to the functionality of the software and as a result an inference needs to be drawn regarding the bona-fides of NeXT Inc. and hence Apple, an aspect which would be very relevant for purposes of grant of injunction. A sub-argument concerning this contention was that Rohit Singh was guilty of suppressing that Apple was a prior user (through its predecessor) of the word SplitView and that in the trade others were also using the word SplitView because it was an essential feature of the product.

C. If there are various methods to describe an essential feature and in particular concerning the functionality of a product, any one or more may be used and it is no argument that there are other words to describe the feature. To wit : a person who has no right to be in possession of a property may be described as : (i) A trespasser. (ii) In wrongful possession. (iii) In illegal possession. (iv) Usurper of the property etc.

D. Apple is selling the operating system OS X El Capitan and iOS which would be akin to a combo offer to purchase a basket having an integrated package comprising various elements and assuming each element is treated as a product, individually none is being sold and respondents' product is

sold individually and this distinction would be akin to a situation where Apple has added matters.

18. We recant the essential principles that govern an evaluation as to what constitutes a descriptive use of a word versus a trademark use.

19. In the decision reported as 2012 (49) PTC 54 Carlsberg India Pvt. Ltd. v. Radico Khaitan Ltd., this Court had the occasion to evaluate the principles that establish descriptive use of a word vis-a-vis its use as a trademark, and posed the question:-

“Whether the use of the numeral “8” by Carlsberg is in the nature of a descriptive, and hence non-trademark use, or a trademark use.”

20. In paragraph 54 of its opinion, the Division Bench observed that the two are antithetical to each other and one plea, if successful, must necessarily destroy the other. The Division Bench noted the principle enunciated by a learned Single Judge of this Court, in the decision reported as 57 (1995) DLT 49 Automatic Electric vs. R. K. Dhawan, in the following words:-

"The fact that the defendant itself has sought to claim trade proprietary right and monopoly in "DIMMER DOT", it does not lie in their mouth to say that the word "DIMMER" is a generic expression. User of the word "DIMMER" by others cannot be a defense available to the defendant, if it could be shown that the same is being used in violation of the statutory right of the plaintiff."

21. The immediate response to the above question in the instant appeal by the learned senior counsel for Apple was to say that it has in fact not claimed trademark rights over SplitView and to that end it is not contradicting its own claim. And we highlight that the argument was that through its

predecessor NeXT Inc. Apple used the words Split View to describe an essential functional feature of its product.

22. We need not quibble with this aspect because the question is not whether Apple has claimed trademark rights in its response to the respondents' legal notice or in the instant appeal, but whether on facts, and on a prima-facie evaluation of the documents on record, Apple, from the perspective of the consuming public has in fact used Split View in a trademark sense. The law being succinctly stated in the decision reported as (2002) 3 SCC 65 Laxmikant V.Patel vs. Chetanbhai Shah as under:-

“13. In an action for passing-off it is usual, rather essential, to seek an injunction, temporary or ad interim. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of. The plaintiff must prove a prima facie case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction. According to Kerly, passing-off cases are often cases of deliberate and intentional misrepresentation, but it is well settled that fraud is not a necessary element of the right of action, and the absence of an intention to deceive is not a defence, though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception. Christopher Wadlow in Law of Passing-Off (1995 Edn., at p.3.06) states that the plaintiff does not have to prove actual damage in order to succeed in an action for passing off. Likelihood of damage is sufficient. The same learned author states that the defendant's state of mind is wholly irrelevant to the existence of the cause of action for passing –off. As to how the injunction granted by the court would shape depends on the facts and circumstances of each case. Where a defendant has imitated or adopted the plaintiff's distinctive trade mark or business name, the order may be an absolute injunction that he would not use or carry on business under that name.”

23. Learned senior counsel for Apple argued that use of the words Split View by Apple (with a space between the two words) is an example of

descriptive use, that cannot conflict with the respondents' use. Thus, Apple has used the descriptiveness argument, both to challenge the respondents' entitlement over SplitView as a trademark, as also in the form of a defence to justify use by it of Split View.

24. In support of the first argument, Apple has relied on a number of documents filed from pages 288 onwards to demonstrate third party use of Split View in a descriptive sense, thus arguing that no exclusive proprietorship can accrue to the respondents.

25. The documents were filed in the appeal. They do not form part of the suit record because Apple has chosen not to file an application under Order 39 Rule 4 of the Code of Civil Procedure and has preferred to challenge the impugned order. The documents were taken on record.

26. With respect to the documents, we note the same and simultaneously offer our prima-facie view thereon.

27. The first is the document at pages 288-289. The terminology SplitView Object and SplitView Class are apparent on the face of the document, but the respondent response is that a document should not be read only skin deep and a little penetration would reveal that Microsoft provides a coding language for developers to build their own applications. SplitView is a component in the coding language to sub-divide a window, in one application only. Consumers will never be aware or be able to use this coding language. That it is not a product or a feature in a product. It does not reach a consumer. Further, on page 289, Split View is used in a descriptive manner and the document also appears to have a copyright of the year 2016.

28. The second is a document at pages 290-291. As was with the preceding document, this document also uses the terminology Split a View. But as was the explanation to the preceding document of not being misled

by a skin deep analysis, counsel for the respondent explained that the document uses the phrase ‘*split a view*’ or ‘*a split view*’, thereby making it apparent that the usage is descriptive. That it pertains to a functionality of Microsoft Word and the learned counsel for the respondents demonstrated the manner in which it shows up in the actual product itself. Counsel demonstrated that when one opens Microsoft Word, the toolbar at the top has a tab which says ‘Split’ and ‘Split Window’ under it. Counsel therefore concluded that it is apparent that this is not meant for a split screen functionality but a functional feature within MS Word/MS Office which does not use the name/mark Split View.

29. The third is a document at pages 292-295. It uses the terminology Samsung Galaxy Tab S2 – MultiWindow. Ex-facie, the top of the page shows clearly that Samsung is using MultiWindow as a trademark and not SplitView/Split View. Prima-facie Samsung has used it in a descriptive sense to explain how to use multiple windows on its tablet.

30. The fourth is a document at pages 296-298. It uses the terminology Apache Open Office – Framework/SplitView. Apple relied on this document to urge that Apache is using the mark SplitView. The response was the same as was for the second document at pages 290-291 i.e. it is used for coding to display multiple views of the same document and not for multiple windows. It is not a word used on a product which will reach consumers.

31. The fifth is a document at page 299. It uses the terminology LG Android Split View. We find that the product feature is called Dual Window and not Split View. When one sets the Dual Window feature and thereafter selects a ‘Split view’ option, it automatically engages dual window when tapped on links in full screen or for image attachments in e-

mails. The name of the feature is rightly called Dual Window by the creator thereof.

32. The sixth is a document at pages 300-303. It uses the terminology Revu Split View. As per Apple, Revu is a PDF viewing application which has a feature called Split View. It allows users to view multiple PDF documents on the same monitor. The response was that it uses Split View as a feature to open PDF documents and is not a comparable product and further that distinction between functionality and feature must be kept in mind.

33. The seventh is a document at pages 304-306. It uses the terminology Google Play – Split View Multi Screen Tablet. Learned counsel for the appellant referred to the same as one of the two examples, of Google using Split View. But concededly it is an application (app) by NQR Productions which is available for sale on the google play store, in respect of which learned counsel for the respondents submitted that a takedown notice has already been sent by the respondents in this regard to Google.

34. The eighth is a document at pages 307-308. It uses the terminology Skipper – Split-view web browser by AnguriaLab. This is an application available on iTunes under the mark/name Skipper. Split-view has been used after the word Skipper and as per learned Counsel for the respondents, as a descriptive term for the application Skipper and is an example of an instance where an application (app) launched in 2010, and not very successful till date, used ‘Split View’ in its name/title to help the application (app) come up in search results. This phenomenon is known as app store optimisation/ad words optimization.

35. The ninth is a document at pages 309-310. It uses the terminology Football Manager. This is a game on a football management simulation. In

the said game/application, one way to see the information is to display the same in the multiple sections. The tab which is called Split View allows the user to do the same. All the tabs in the game are descriptive in nature, such as Information, TV Pitch View, Classic Pitch View and Pitch View Analysis & Stats. It is of limited application and restricted to a limited audience.

36. The tenth is a document at pages 312-313. It uses the terminology Google's method of showing multiple languages in mobile search results interface in India. This, according to learned counsel for Apple is the second instance of Google using Split View. Learned counsel for the respondents replied that it is evident from reading the article that only the author of the article has called the tabbed interface as Split View. The article quotes a twitter user, Abhijeet Mukherjee to say that 'Google is showing search results in English and a native language in a tabbed interface'. Google made no announcements and there is no product by Google called Split View, contrary to the appellant's claim.

37. The eleventh is a document at pages 318-341. It uses the terminology European Patent Application titled 'Apparatus and method for processing Split View in Portable Device'. The said application has been filed by Samsung Electronics Pvt. Ltd. on September 18, 2013, and prima-facie we find that the words Split View have been used in a functional sense in a patent application.

38. We may therefore summarise as to what emerges from the documents. A serious debate requiring proper pleadings concerning :-

(i) Instances of third party use relied upon by Apple to constitute valid examples of descriptiveness of the Split View mark have to be seen in the context of whether a product similar to that of Apple and the respondents has been offered by such third parties under the said mark to customers with

further pleadings on the subject whether 4 instances cited i.e. 1, 4, 10 and 11 do not pertain to products or apps.

(ii) Whether the document at serial No.2 which uses the terminology Split a View is a feature of a product (MS Word) and not a product itself and further what is the effect of the words SplitView being used along with other descriptors such as Split Window and further what is the effect of these words appearing alongside the tabs HOME, INSERT, DESIGN, PAGE LAYOUT, REFERENCES, MAILINGS and REVIEW and therefore not used for a stand-alone product.

(iii) What is the effect of the document at serial No.9, which is an app/product called Football Manager, though called SplitView, but allows the user to view the game/application in multiple sections and therefore whether its field of operation is so distinct that there cannot be any overlap between the product of the respondents and the said product. The backdrop being that the software does not permit simultaneous viewing of two applications.

(iv) Documents at serial No.3, 5 and 6, which clearly relate to products, the impact of the three having a clear trade mark/feature, being MultiWindow, DualWindow and Revu respectively and the sixth allowing user to view multiple PDF documents on the same monitor.

(v) The document at serial No.8 using the mark Skipper for search optimization and using the words SplitView in the name of the application; whether SplitView has been used as a descriptive term for the application and whether use of the word SplitView was intended to help the application come up in search results.

39. The sum and substance of respondent's contention put simply, is that the difference between the instances cited and Apple's case is that if Split

View was understood in the context of Apple to have been used descriptively, then the question would be : what is the name/mark by which Apple's product/feature is to be identified by the consumers?

40. No product or application or feature can be nameless. If split view describes the product, then what is the product called? Learned senior counsel for Apple laid great emphasis on a judgement of a Division Bench of this Court reported as ILR (2010) II Del 85 Cadila Healthcare Ltd. v. Gujarat Cooperative Milk Marketing Federation Ltd. & Ors. to urge that the facts are identical and as the Court in said case had vacated the injunction, so must a vacation follow in the present case, on the ground of descriptiveness.

41. The two key observations of the Division Bench in Cadila's case (supra) that are relevant for the present case are:

(i) The conclusion that the mark 'Sugar Free' has acquired a considerable degree of distinctiveness in relation to the appellant's product is based on mere assumption and is without any reasonable basis.

(ii) The words 'Sugar Free' are always used along with the trademark 'AMUL' by the respondent within the same visual matrix and there is no possibility of confusion.

42. In other words, the first test to be applied to the respondent's trademark SplitView is whether it is inherently distinctive or has assumed secondary distinctiveness. Thereafter the test to be applied is to evaluate whether used by Apple is truly descriptive and in conjunction with a trademark for the consumer to know the difference between descriptive use and trademark use.

43. On the first question, it is prima-facie evident that SplitView comprises two words, joined together in one unique collocation. The

combination has prima-facie to be considered unique, although the words individually may not be so. There is prima-facie considerable strength in the respondent's argument that the respondent's product, for which the mark is being used for, is a split screen or a split monitor functionality – the view is complete, it is not being split, it is being reduced in size and there are multiple 'views' of applications (apps) or windows being made simultaneously available. This is for their personal edition. For the server edition of the product, Split View does not in fact split the user's monitor at all but permits the user to view multiple monitors together.

44. Dictionary extracts and technology term glossaries handed over by the learned counsel for the respondents demonstrates that while split screen is a dictionary word, split view or splitview are not so. This coupled with the US\$ 5.9 million sales of the product since the time of its launch and its highly positive rating on multiple application (app) review sites all go towards *prima facie* demonstrating the distinctiveness and reputation of the mark SplitView in the respondents' favour.

45. But on the other hand we find considerable material to establish to the contrary and we cite a few instances only. The first is a United States Patent Application published on December 19, 1995 pertaining to a product concerning a Particle Analysis Method. Explaining the background of the invention the patent claim discloses : *'The overall field of view is divided into a plurality of pre-determined views which are appropriate to deciding of the particle according to the size of the particle. **The divided view is called a split view hereinafter** and the magnification value is set according to the split view'*. The second is a European Patent Application published on April 07, 1999 pertaining to a product described as : **'Method and System for Automatically Detecting and Selecting Updated Versions of a Set of**

Files'. Explaining the summary of the invention the patent claim discloses : *'The views are : split, composite, split-merge and composite-merge. Figure 6 illustrates a collision handler in a **Split View** in accordance with the present invention. Buttons below the upper pain control the views that the user may utilize to resolve the conflicts. **Split View** button 330 will display a side-by-side view of the different part versions.'* Of the many claims, claim No.2 is described, amongst others : *'Displaying said version in a **Split View**.'* The third is a United States Patent Application published on April 21, 2005 pertaining to a product described as : **'Viewing Tabular Data on Small Handheld Displays and Mobile Phones'**. Explaining the background of the invention the patent claim discloses : *'A split screen view with local split-bars can be implemented to enable the user to manipulate their view point. This may be considered equivalent to selecting split view in an Excel-type spreadsheet and using scroll bars to navigate individual splits'*. The fourth is a United States Patent Application published on January 26, 2006 pertaining to a product described as : **'Window Split System and Method'**. Explaining the background of the invention the patent claim discloses *'Additionally, one application programme can perform different functions in each of the windows displayed on the screen. For example, a split view of an image'*.

46. The four documents lean in favour of the argument advanced by learned senior counsel for Apple that people in the field of computer software programming use the words Split View to describe an essential feature of the function of the software programme. Meaning thereby, as akin to somebody using the expression trespasser, somebody using the expression illegal possession, somebody using the expression wrongful possession; all describing the same concept, people use the words Split

View, Split Monitor, Split Window etc. to describe the same concept of simultaneously viewing akin to two windows on the same screen, albeit within the same application or simultaneously using two applications. It is trite that a number of alternative ways of describing a product is no answer to the criticism of the mark being adopted as a trademark and that different words and expressions can be descriptive of a product and it is not answer that since other words and expressions exist, I am entitled to appropriate the one which I have used to describe the product.

47. Learned senior counsel for Apple argued that Apple uses the two words Split View as a descriptor and not as a mark. Learned counsel for the respondents urged to the contrary. Prima-facie Apple's product is doing the same thing as the respondents' i.e. splits the window and on the monitor two applications can be seen while being simultaneously operated. Here the facts of the present case differ dramatically from Cadila's case (supra). While in Cadila the Division Bench found that the trademark of the respondent therein was in fact 'Amul' and Sugar Free was used along with the word Dessert, it is not the case here since the Split View feature is claimed to be used by Apple as a descriptor with the product having no name. In other words, what Apple appears to be suggesting is that descriptive use by it merges in the name of the feature itself so the consumer is expected to use only one name to refer to it and to understand that the said name is not a trademark. The argument on the other side is that there is nothing in the product literature of Apple surrounding El Capitan to support such a suggestion, as was the case in the instances (3), (5) and (6) which we have discussed hereinabove concerning Samsung Galaxy Tab S2 – MultiWindow, LG Android Split View and Revu Split View, wherein the

consumer is clearly able to distinguish between the trademark and the descriptive nomenclature and not confuse one for the other.

48. In this regard the respondents have given examples of third party applications with the same functionality which do not in fact call themselves Split View or use split view in a descriptive sense. This list of applications (apps) such as Divy, AquaSnap, GridMove, WindowSpace, MaxTo, Gridy, Aero Shake was recorded with approval in paragraph 4 of the impugned order passed by the Learned Single Judge. These applications pertain to products which are identical or similar to that of the respondents and yet we find that none of them use split view to describe their functionality.

49. But that would need a proper debate after pleadings because as we have highlighted hereinabove with reference to examples of trespasser, person in wrongful possession, person in illegal possession that a same concept can be described in many different ways and each would be descriptive of the concept.

50. We therefore have a lot of conflicting material where third party technology writers and commentators have referred to a split view feature as a name demonstrating the distinction between the descriptive phrase '*Split Screen*' functionality/mode/feature i.e. the words Split View perceived as a trademark for such a feature and perhaps the possibility of some ordinary consumers, with imperfect recollection, associating the words Split View as a trademark for the split screen feature and some associating the words Split Screen as descriptive of an essential feature of a system where visually the computer screen shows two windows displaying two different contents.

51. In the context of this debate, argument of Apple needs a weightage to be given with reference to Apple offering OS X El Capitan and iOS operating systems having in-built functionalities such as 'Mission Control',

‘Spot Light’ and ‘Split View’. These individual integrated function/features/products are not available separately. In other words Split View by Apple cannot be bought and sold in the market and assuming Split View has used the word to name its product and not describe the product the effect of added matters needs a proper consideration.

52. In respect to the second argument (which would also subsume the charge of suppression), we summarise the respondents’ submissions to demonstrate that Apple has in fact not used Split View in a descriptive manner. The arguments were:-

- (i) Apple uses Split View as the ‘name’ for the product feature – it appears as a stand-alone heading as the name and is not used as a part of a sentence that merely demonstrates its functionality.
- (ii) Split View is written in capital letters which is indicative of trademark use and not descriptive use.
- (iii) Several other ‘features’ of the El Capitan Operating System, i.e. Spotlight and Mission Control, which appear immediately after Split View are all terms or words over which Apple has claimed trademark rights. Apple filed a trademark application for Mission Control in India and Spotlight is in fact a registered trademark under No.1896699 in Class 9 as well as the subject of a pending application in the same class under No.IRD 2674730 in India. Similarly, Swift (used in respect of a programming language), Safari (used for a web browser) and Metal (used for a graphics technology) are all bundled with El Capitan and are a part of El Capitan and yet individual trademark rights have been claimed by Apple in respect of each of them.
- (iv) For an ordinary consumer, there is no discernible difference between the manner in which Apple presents the Split View feature and the manner

in which it presents the Spotlight or Mission Control feature, hence, there is no reason to assume that the ordinary consumer will assume that Split View is being used in a descriptive sense by Apple and Spotlight or Mission Control are being used in a trademark sense.

(v) Apple has claimed trademark rights over several seemingly descriptive or suggestive words in the past and Split View, from the perspective of consumers is no different. It is in fact a common practice in the technology space to do so. Thus, Apple has claimed trademark rights over AirPrint, CarPlay, Cinema Tools, DVD@CCESS, DVD Studio Pro, FileVault, Final Cut, LaserWriter, LocalTalk, NetInfo, Photo Booth, QuickDraw, App Store and to an ordinary consumer Split View is no different from this body of trademarks. There is no indication or suggestion in any of the documents of Apple that Split View is being used in a descriptive sense or that the consumer must understand and use it as such.

53. Each argument and especially at point No.(iii) and (iv) above certainly tend towards a view to be taken that Apple is using the terms in its operating system i.e. Spotlight, Mission Control, Split View as trademarks, but the countervailing view could well be, as was argued by Apple, and as has been noted by us in paragraph 11 above i.e. for Mac and iPad products Apple offers the two operating systems and no functional part of the programme is available standalone, coupled with the argument noted in paragraph 15 above, that the consumer understands when Apple uses the words ‘Maps’, ‘Photos’, ‘Calendar’ and ‘Clock’ it is for features and not products and therefore ‘Split View’ is used by Apple as a feature i.e. that the consumer recognizes that descriptive words are used by Apple to describe the essential functionality of its product and not the product and non-descriptive words are used by Apple as the name of the product.

54. The second argument of learned senior counsel for Apple was with a caveat, correctly put i.e. that if for some reason this Court holds that the word SplitView is not descriptive and is capable of being a trademark, Apple must trump the respondents on account of prior user through its predecessor NXSplitView.

55. Noting that the argument was made as an alternative argument, we prima-face find that SplitView was in fact never used in conjunction with a monitor splitting or screen splitting functionality offered by a software product/application (app) and was in fact called NXSplitView/NSSplitView in certain software developer toolkits, to describe a certain functionality that was to be used by app developers. The documents at appeal paper book pages 94 and 95 show that NXSplitView was clearly used in a kit for developers and not a trademark or a descriptive use of a product that was available to consumers. In respect of this document learned counsel for the respondents urged that this document is not accessible to a consumer and therefore cannot be interpreted as the use of the mark SplitView in a trademark context as understood to consumers, a question of fact regarding trial. A perusal of an extract from Apple's own website which was handed over by learned counsel for the respondents prima-facie demonstrates the absence of SplitView or even NXSplitView in the list of trademarks owned by NeXT Inc. which prima-facie further indicates that there was no consumer recognition of NXSplitView or SplitView as a trademark and indeed the same was not used as a trademark or a descriptive name for a product for Apple to be entitled to any benefit in law of prior adoption. In any event, the NXSplitView/NSSplitView manuals of 1993 and the 2006 book for software developers which seems to cross reference these developer tools do not discharge the threshold of what constitutes prior use

in trademark law. Reference may be made to the observations of the Supreme Court in the decision reported as AIR 2001 SC 2083 Uniply Industries Ltd. v Unicorn Plywood Pvt Ltd that the test to determine priority in a mark is to determine continuous prior use and the volume of sales or the degree of public familiarity with the mark.

56. Learned senior counsel for Apple had, in relation to a document showing it to be the year 2006, argued on the basis of the right hand column of the said document that OS X El Capitan, which contains Split View, is in fact of 2006 vintage. The same is clearly not correct as rightly pointed out by learned counsel for the respondents for the reason the right hand column is ex-facie in the nature of sponsored links that appear on the day of the search. Undisputedly OS X El Capitan was launched only in July 2015.

57. Learned counsel for Apple had drawn the attention of this Court to a notice sent by the respondents to Apple, to urge that respondents own best case would be the use of the trade mark SplitView from the year 2006-07 and not from the year 2005 as has been held by the learned Single Judge.

58. The learned counsel for the respondents, in turn, had drawn the attention of this Court to pages 162, 188, 191, 194 and 196 of the appeal paper book, which ex-facie supports the respondents' use claim of the year 2005. Of particular relevance is the document at page 191, which is an extract from the Wayback Engine (an internet tool that captures snap shots of web pages as they stood earlier) and the said document reflects what the respondent's website looked like in December, 2005. At page 167 is the who is record for the respondents' domain www.splitview.com which shows that it was created on August 23, 2005. Page 194 is the first order notification of the respondents' product, under the mark SplitView, dated September 05, 2005. These three documents as also the others mentioned

above were admittedly part of the suit record and the learned Single Judge has thus rightly concluded that the respondents had demonstrated the use of the trademark SplitView from 2005.

59. A loosely worded letter/notice by the respondents to the CEO of Apple, naively requesting him to rename the Split View feature/product wherein 2006 was mentioned as the year when Rohit Singh developed the application (app) cannot be said to contradict the documents on record nor does it establish that there is an erroneous factual finding by the learned Single Judge. The respondent's use of SplitView for their software product thus clearly dates back to the year 2005.

60. However, nothing turns on this. If the respondents are found to be legitimate proprietors of SplitView as a trademark then whether the same was adopted in the year 2005 or 2007 is irrelevant in the facts of the present case.

61. In a nut shell, our finding would be that on the existing material before the learned Single Judge case was not made out to grant an ex-parte ad-interim injunction because an ex-parte ad-interim injunction in a matter concerning trademark violation should ensue only if a very strong prima-facie case is made out with respect to a trade mark which is inherently distinctive. A serious issue arises for consideration in the instant case concerning whether Split View is descriptive of an essential feature of the computer programme thereby rendering the words, even if used in conjunction with each other, not eligible to be a trade mark. With respect to documents filed by Apple in appeal, we simply observe that proper pleadings are required as to the effect of the documents keeping in view the mandate of Order 6 Rule 9 of the Code of Civil Procedure, so that the respondents have an opportunity to plead as per them as to what is the effect

of the document.

62. Vacating the ex-parte ad-interim injunction dated March 01, 2016, we dispose of the appeal directing Apple to file its written statements of defence within two weeks and along therewith file all documents it seek to rely upon. The respondents are granted three weeks' time to file a replication and file such further documents as respondents desire. The next date of hearing before the learned Single Judge is May 09, 2016 and we request the learned Single Judge to hear arguments in the application seeking interim injunction pending disposal of the suit filed by the respondents on said date and try and pronounce judgment before the ensuing summer vacations which commence from June 04, 2016.

63. Parties shall bear their own costs in the appeal.

(PRADEEP NANDRAJOG)
JUDGE

(MUKTA GUPTA)
JUDGE

APRIL 07, 2016
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