

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

% *Judgment reserved on : 01.05.2017*
Judgment delivered on : 04.05.2017

+ CS(OS) 3205/2014

M/S SANDISK CORPORATION Plaintiff

Through Mr.Prithvi Singh, Advocate.

versus

RAMJEE & ORS. Defendants

Through None.

CORAM:

HON'BLE MS. JUSTICEINDERMEET KAUR

INDERMEET KAUR, J.

1. The present suit has been filed by the plaintiff against the defendants for permanent injunction restraining infringement of trademarks and copyright, delivery up, rendition of accounts of profits as also damages.
2. The plaintiff SanDisk LLC, previously known as SanDisk Corporation is registered in the United States of America. The plaintiff is involved in the business of flash memory storage solutions under the trademark 'SanDisk'. The plaintiff claims to have markets globally and sells more than two million products, each day. The memory cards of the plaintiff bearing the mark 'SanDisk' are used in mobile phones, computers and other consumer

electronics. Plaintiff claims registration of its trademarks in more than 150 countries with respect to the mark 'SanDisk'. In addition to this, the plaintiff claims registration of the word 'SanDisk' and 'SanDisk' Logo. Besides the plaintiff holds a copyright of the unique packaging style, which the plaintiff claims is an artistic work and is protected within the meaning of Section 2(c) of the Copyright Act, 1957. As a result of extensive marketing efforts through advertisement by various modes, research work and on account of excellent quality of its products, the plaintiff's 'SanDisk' mark enjoys an immense goodwill and reputation both in India and worldwide.

3. In October 2014, the plaintiff became aware that there are certain unknown persons who are selling counterfeit SanDisk Micro SD memory cards through large number of stalls set up all across the pavements in the makeshift Sunday markets at Daryaganj, Old Delhi. The packaging of these counterfeit memory cards was identical to that of plaintiff's bearing the trademark 'SanDisk' of the plaintiff in an identical manner. Since it was impossible to identify the names of such persons primarily because they were fly-by night operators, these unnamed and undisclosed persons were arrayed as 'John Doe/s' initially.

4. Present suit has accordingly been filed praying for a relief of

permanent injunction and seeking a restraint on the infringement of the trademark and copyright of the plaintiff. Restraint on passing off, delivery up of goods and damages to the tune of Rs.20,00,000/- have also been prayed for.

5. On 17.10.2014, an ex parte ad interim injunction had been granted in favour of the plaintiff and against the unknown defendants restraining them from manufacturing, selling, offering for sale, advertising, directly or indirectly, dealing in counterfeit products, which are identical to the plaintiff's trademark 'SanDisk' and logo marks and the 'Red Frame' Logo, with identical product packaging, product get-up, colour scheme, layout, overall look and feel as that being used by the plaintiff. Also, three local commissioners were appointed to visit the make-shift locations in order to seize the counterfeit products and also to identify the infringers.

6. The Local Commissioners in their reports identified the sellers of the counterfeit products of the plaintiff as Mr. Ramjee, Mr. Munna Kumar and Mr. Vikas Jain. These proposed defendants were then impleaded as defendant No. 1, defendant No. 2 and defendant No. 3 respectively, in terms of the order dated 13.03.2015. The local commissioners had also seized 4500 packets of the infringing memory cards bearing the identical SanDisk logo

and packaging.

7. Summons of the suit were issued and served on all three defendants, who in spite of repeated issuance of summons did not appear. They were proceeded ex parte on 09.02.2016.

8. Ex parte evidence by way of affidavit of PW1 (constituted attorney of the plaintiff) has been filed and marked as Ex. PW1/A. PW1 has reiterated all the averments made in the plaint and has proved various documents delineated as Ex.PW1/1 to Ex.PW1/11. The plaintiff owns various registrations of its trademark 'SanDisk' both as a word mark as well as a label not only in India but also worldwide, in more than 150 countries. A list of these trademark registrations in India and worldwide has been proved as **Mark A**. Ex.PW1/7(colly) is a report of the United States Securities and Exchange Commission showing the annual revenues of the plaintiff as USD 5,052.5 million, USD 6,170 million, USD 6,627.7 million and USD 5,564.9 for the year endings of 2012, 2013, 2014 and 2016 respectively. Documentary evidence of advertisements of the plaintiff's 'SanDisk' trademark and its wide publicity through various third party write-ups, media reports etc. have also been proved as Ex.PW1/10(colly) and Ex.PW1/11(colly). On oath it has been reiterated that the plaintiff is the

owner of the copyright in the artistic work in the 'SanDisk' Logo and the 'Red Frame' Logo, as well as in the artistic work comprised in the red and white rectangular packaging style within the meaning original artistic work prescribed under section 2(c) of the Copyright Act, 1957.

9. The plaintiff has established and proved his case. Photographs of the counterfeit products when compared with those of the plaintiff's bearing the trademark 'SanDisk' (Ex.PW1/8(colly)) clearly show that the infringing products are identical in all aspects. It is clear that the defendants have copied the trademark and logo of the plaintiff's in all respects. This adoption of the trademark of the plaintiff is fraudulent and is done with a malafide intention and has caused huge losses to the plaintiff not only in monetary terms but even in terms of loss to its reputation and goodwill.

10. Accordingly, the suit of the plaintiff is decreed and by way of the permanent injunction, the defendants, their partners, proprietors, servants and agents and all others acting for and on their behalf are restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in products identical to the products bearing the plaintiff's trademark 'SanDisk' and 'SanDisk logo' and the 'Red Frame' logo, with identical product packaging, product get-up, colour scheme, layout, overall look and

feel as that being used by the plaintiff and from passing off their goods as those of the Plaintiff and also which infringe the plaintiff's copyright in the artistic work comprised in the SanDisk product packaging, the 'Red Frame' Logo, color scheme, product layout or any substantial part thereof.

11. The defendants are also directed to destroy all the infringing goods, advertising material, blocks, dies etc bearing the plaintiff's mark and the product literature appearing on its packaging.

12. The plaintiff has also claimed damages. In the affidavit by way of evidence (Ex.PW1/A) it has been reiterated that the use of the infringing trademark by the defendants has caused huge losses to the plaintiff not only in monetary terms, but also to the goodwill and reputation of the plaintiff. The plaintiff has also made out a case for entitlement of damages and is awarded damages quantified at Rs. 15 lacs/-. Cost of the suit also be granted in favour of the plaintiff. Decree sheet be drawn. File be consigned to record room.

INDERMEET KAUR, J

MAY 04, 2017