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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
+ CS(COMM) 411/2021 & I.A. 16406/2022, I.A. 16407/2022, I.A.
19103/2023, I.A. 44900/2024, I.A. 44901/2024, I.A. 44902/2024
SANDISK LLCPlaintiff

Through: Ms. Devyani Nath, Adv.
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versus

R D TELECOM AND ANR.Defendants
Through: Mr. Faraz Khan, Adv. for D-2.
M: 8860479247

CORAM:
HON'BLE MS. JUSTICE MINI PUSHKARNA

ORDER
13.11.2024

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I.A. 44901/2024 (Exemption from filing original and clear copies of documents)

1. The present is an application under Section 151 of the Code of Civil Procedure, 1908 ("CPC"), on behalf of the plaintiff, seeking exemption from filing clearer copies and documents with proper margins.
2. Exemption is granted, subject to all just exceptions.
3. Plaintiff shall file clearer copies and documents with proper margins, on which the plaintiffs may seek to place reliance, before the next date of hearing.
4. Accordingly, the present application is disposed of.



I.A. 44902/2024 (Joint application under Order XXIII Rule 3 read with Section 151 CPC on behalf of the plaintiff and defendant no. 2)

5. The present joint application has been filed under Order XXIII Rule 3 read with Section 151 CPC on behalf of the plaintiff and defendant no. 2.

6. The plaintiff has filed the present suit for permanent injunction restraining the defendants, their partners, employees, servants, representatives, affiliates, agents, or any other person claiming under or through him or acting in concert with him from committing acts amounting to infringement of trademarks, infringement of copyright, passing off and other incidental reliefs.

7. The plaintiff and defendant no. 2, in order to put an end to the litigation and with a view to amicably resolve their disputes, have agreed to settle the matter, terms of which have been given in Para 7 of the present application.

8. Learned counsels appearing for the plaintiff and defendant no. 2 affirm the terms of settlement and submit that the suit be decreed in favour of the plaintiff, and against defendant no. 2, in terms of settlement.

9. This court has perused the terms of the settlement and finds the same to be lawful.

10. In terms of the settlement, the defendant no. 2 has acknowledged that

the plaintiff is the owner of the trademarks SanDisk,  (red frame logo), SanDisk Ultra and Cruzer Blade under the Trademarks Act, 1999 as well as under common law.



11. The defendant no. 2 undertakes that it will not deal and/or in any counterfeit SanDisk products and/or any SanDisk products which are not meant for sale in India.

12. Further, defendant no. 2 has undertaken that it will not manufacture products that bear the plaintiff's SanDisk trademarks and/or any other mark which is identical/deceptively similar to the plaintiff's SanDisk trademarks.

13. Further, in terms of the Settlement Agreement between the parties, the defendant no. 2 has already paid a sum of ₹ 4,50,000/-, towards damages to the plaintiff.

14. Accordingly, the present suit is decreed in favour of the plaintiff and against defendant no. 2, in terms of the Settlement Agreement between the parties, as contained in Para 7 of the present application, which shall form part of the decree.

15. The parties shall remain bound by the terms of the settlement.

16. Decree sheet be drawn up.

I.A. 44900/2024 (for Summary Judgment)

17. The present application has been filed on behalf of the plaintiff under Order XIII-A Rules 3 and 6(1) (a) read with Section 151 CPC for summary judgment *qua* defendant nos. 1, 3 and 4.

18. It is submitted that the defendant nos. 2, 3 and 4 were impleaded vide order dated 18th July, 2022.

19. Vide order dated 18th July, 2023, the right to file written statement of defendant nos. 2 and 3 was closed and *ex-parte* injunction granted vide order dated 6th September, 2021, was made absolute during the pendency of the suit.

20. It is further submitted that vide order dated 2nd April, 2024, defendant



nos. 1, 3 and 4 were proceeded *ex-parte*.

21. Considering the facts and circumstances before this Court, this Court is of the view that the present case is a fit case for passing a summary judgment.

22. The plaintiff is the registered proprietor of the trademarks SanDisk,

SanDisk



, and the red frame logo, SanDisk

Ultra and Cruzer Blade. As per the plaint, the plaintiff is one of the world's largest dedicated providers of flash memory storage solutions under the house mark 'SanDisk'. The SanDisk brand is recognised around the world. The plaintiff's parent company i.e., Western Digital Corporation, is engaged in the business of developing, marketing and producing computer data storage and is one of the largest hard disk drive manufacturers in the world.

23. The plaintiff is the registered proprietor of a variety of word marks and device marks in India, details of which are reproduced as under:-

Trademark	Registration Number	Class	Status	Registration Date	Valid up to
SanDisk	1249761	09	Registered	14.11.2003	14.11.2023
SanDisk	2632942	09	Registered	25.11.2013	25.11.2023
Red Frame Logo	1805766	09	Registered	13.04.2009	13.04.2029



Cruzer Blade	2261469	09	Registered	04.01.2012	04.01.2022
SanDisk Ultra	1249763	09	Registered	14.11.2003	14.11.2023
SANDISK	2898190	09, 35, 37, 41, 42, 45	Registered	10.02.2015	10.02.2025

24. All these trademarks are valid and subsisting. Apart from the trademarks, the plaintiff sells its memory cards with a unique red and white packaging. The plaintiff since the last several years, has been selling its Cruzer Blade USB flash drives in the packaging, which comprises “Red frame logo”, on the top right corner, indicating the capacity of the flash drive, as follows:-



25. The plaintiff's products are being sold in the Indian market since 2005, through a country wide network, who have been authorised to import



and distribute the same in India. The plaintiff's products under SanDisk trademarks have been extensively advertised throughout the country through various forms of media.

26. Defendant no. 1 is a mobile accessories and spare parts shop, which is engaged in the marketing and selling of counterfeit microSDHC cards, USB flash drives and dual drives under identical trademarks and packaging, as the plaintiff's products being marketed and sold under the SanDisk trademarks. Similarly, defendant nos. 3 and 4 are also involved in selling counterfeit SanDisk products.

27. Vide order dated 06th September, 2021, this Court granted an *ex-parte* injunction against defendant no. 1 and unidentified John Doe defendants restraining them from manufacturing, selling, offering for sale, directly or indirectly dealing in infringing products bearing the plaintiff's SanDisk trademarks, so as to suggest an affiliation, approval, license, connection, sponsorship or endorsement with the plaintiff, resulting in passing off. Further, two Local Commissioners were appointed to visit the premises of defendant no. 1 and unidentified John Doe defendants, and seize the infringing products, packaging and all other material bearing the registered trademarks of the plaintiff.

28. In compliance of the order dated 06th September, 2021, local commissions were executed at the premises of the defendants on 13th September, 2021. The report of the Local Commissioners has been filed in the present proceedings. A mere perusal of the report of the Local Commissioners makes it clear that various quantities of infringing products bearing the plaintiff's registered trademarks and an identical product packaging, were found, seized and sealed at the premises of the defendants.



The quantity of the counterfeit products seized from the premises of the defendants, are detailed below-

Defendant	Quantity of products seized
Defendant No.1 – R D Telecom	3286
Defendant No. 2 – Sri Salasar Electronics	4206

Defendant No.3 – Sri Mahalaxmi Mobiles	4
Defendant No.4 – Patel Telecom	398

29. Thus, it is manifest that the defendants were indulging in counterfeiting and piracy, with a view to dupe innocent and unwary consumers, who are bound to be confused/deceived by the use of the plaintiff's trademarks/product/packaging by the defendant and will assume that the said products originate from the plaintiff. The said acts of confusion will result in passing off the defendants' products, as those of the plaintiff or as those which are connected or related to the plaintiff either directly or indirectly. Further, the unauthorised use of the plaintiff's SanDisk trademarks and trade dress by the defendants is also likely to cause irreparable loss to the goodwill and reputation of the plaintiff and its brand equity.

30. The defendants' patently dishonest activities amount to unfair trade practices, causing irreparable loss and damage to the goodwill, business and



reputation of the plaintiff's. It is evident that the defendants, by selling counterfeit products under identical trademarks and identical/deceptively similar product packaging as the plaintiff's SanDisk products, have infringed the statutory and common law rights of the plaintiffs in the registered SanDisk trademarks and trade dress.

31. The defendants 1, 3 and 4 have not filed any written statement and have been proceeded *ex-parte*. Thus, it is evident that the said defendants do not have justifiable case on merits whatsoever, and have thereby chosen not to pursue the present suit.

32. In view of the counterfeit products having been discovered from the premises of the defendants during the course of execution of the local commission, the plaintiff is entitled to damages, in proportion to the quantities seized by the learned Local Commissioner from their premises. On the aspect of damages, the plaintiff has taken the value of each product seized from defendant nos. 1, 3 and 4 as ₹200/-, considering the counterfeit nature of the products.

33. Accordingly, the following directions are issued:

- I. Suit is decreed in favour of the plaintiff and against defendant nos. 1, 3 and 4, in terms of prayer (a) to (c) of Para 42 of the plaint.
- II. An amount of ₹800/-, is payable by defendant no. 3 to plaintiff, as damages.
- III. An amount of ₹75,000/-, is payable by defendant no. 4 to plaintiff, as damages.
- IV. An amount of ₹4,00,000/-, is payable by defendant no. 1 to plaintiff, as damages.

34. The suit has already been decreed *qua* defendant no. 2, in terms of



settlement between the parties, wherein the defendant no. 2 has paid a sum of ₹4,50,000/- as damages to the plaintiff.

35. Decree sheet be drawn up.

36. Accordingly, the present suit, along with the pending applications, stands disposed of.

MINI PUSHKARNA, J

NOVEMBER 13, 2024
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