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

+ **CS(COMM) 1449/2016**

SANDISK LLC

..... Plaintiff

Through : Ms.Shwetasree and Ms.Vishnu, Advs.

versus

AJAY GUPTA & ORS

..... Defendants

Through

CORAM:

HON'BLE MR. JUSTICE G.S.SISTANI

ORDER

% **25.10.2016**

I.A. 13279/2016

This is an application filed by plaintiff seeking exemption from filing original documents, legible copies of documents and documents with proper margin.

Let original documents, legible copies of documents and documents with proper margin be filed within eight weeks.

Application stands disposed of.

I.A. 13278/2016

This is an application filed by plaintiff seeking leave of the Court to file additional documents on record.

Let additional documents be filed by the plaintiff within eight weeks from today.

Application stands disposed of.

CS(COMM) 1449/2016

Plaintiff has filed the present suit for permanent injunction, restraining infringement of trademark, copyright, passing off, rendition of account of profits, damages, delivery up, etc.

Issue summons in the suit to the defendants by all modes including dasti, returnable on 6.12.2016.



I.A. 13276/2016

This is an application filed by the plaintiff under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure for grant of *ex parte ad interim injunction*.

Issue notice in the application to the defendants for the date fixed.

As per the plaint, the plaintiff is one of the world's largest dedicated provider of flash memory storage solutions under the house mark 'SanDisk'. The SanDisk brand is recognized around the world and the plaintiff's pioneering flash memory technologies, which are marketed direct to retail consumers and enterprises as well as to other equipment makers, are integrated into and/or used in a wide range of consumer electronic devices such as mobile phones, tablets, digital cameras, gaming devices and personal computers. The plaintiff additionally owns all rights, title and interest in and to, and holds the exclusive rights to market and sell products bearing, *inter alia*, the trademark SanDisk. The plaintiff possesses both common law trademark rights to the trademark SanDisk and trademark registrations for the same in 150 countries all over the world. The plaintiff claims to be the registered proprietor of a variety of word marks and device marks in India and abroad, details of which have been filed along with the plaint. The key among those, for the purposes of the present suit are the plaintiff's house mark 'SanDisk', which is registered under the trademark Application No.1249761 in Class 9; the SanDisk logo, which is registered under the Trademark Application No.1249762 in Class 9; the SanDisk logo, which is registered under the Trademark Application No.2632942 in Class 9; and the 'Red Frame Logo', which is registered under no.1805766 in Class 9. All these trademarks are stated to be valid and subsisting.

Further, as per the plaintiff, the plaintiff sells its memory cards in a unique packaging style, which has been described in para 9 of the plaint, and qualifies as an original artistic work within the meaning of Section 2(c) of the Copyright Act, 1957.



The plaintiff has been selling its products directly in Indian market since the year 2005. The plaintiff's national distributors buy original SanDisk products directly from the plaintiff or one or more of the plaintiff's subsidiaries for distributing the products in Indian market.

The plaintiff has spent large amount of time and money in marketing and popularizing its SandDisk trademarks in India and even undertaken a variety of marketing campaigns and product launches catering to the Indian marketing. The plaintiff has filed few advertisements of the plaintiff's products, third-party write-ups and other media publications along with the present plaint. On account of extensive marketing efforts and its quality, the plaintiff's SanDisk trademarks enjoy an immense goodwill and reputation both in India and worldwide. By virtue of such extensive sale and sale promotions, the plaintiff's SanDisk trademarks are exclusively associated with the plaintiff alone.

Learned counsel for the plaintiff submits that in the month of October, 2016, the plaintiff learnt that unauthorised third parties in the Old Delhi area are selling counterfeit microSDHC cards bearing the SanDisk trademarks. The investigator of the plaintiff visited the premises of defendant no.1 wherein he came across microSDHC cards, which appeared to be the counterfeit products and were being sold in the packaging bearing the plaintiff's trademarks. The investigator purchased a sample of the said product, the photograph of which has been filed along with the present plaint. The plaintiff has also scanned the images of the product of the plaintiff and the counterfeit product of the defendant to show the similarity between both the products. The plaintiff has also extracted a detailed summary of similarity between the product of the plaintiff and the counterfeit product of defendant no.1. Counsel further submits that at the premises of defendant no.1, the plaintiff's investigator came across few microSDHC cards bearing the trademark TRANDISK. Upon further investigation from defendant no.1, it is revealed that TRANDISK is the own



brand of defendant no.1 and they are stated to be selling the said product from the premises of defendant no.1.

Learned counsel for the plaintiff further submits that the product of the defendant bearing the mark TRANDISK reveals that the TRANDISK is written in a manner identical to the plaintiff's SANDISK logo and falsely uses **(R)** at the end of it to give an impression that the logo is registered. Counsel further submits that the plaintiff's trademark SanDisk and the defendants' trademark TranDisk are phonetically similar and, thus, it may lead to confusion among the persons in trade and the general public. Counsel has also drawn the attention of the court to the comparison of the plaintiff's product and the product of the defendants, which have been extracted in para 18 of the plaint. Learned counsel contends that a comparison of both the products would show that the defendants have adopted a similar writing style as that of the plaintiff's. The word TranDisk is split in two parts i.e. Tran and Disk and the words 'T' and 'D' are in capital as that of the plaintiff's trademark SanDisk logo. The letter 'D' is artistically represented where there is no vertical line and it grows out of the 'n', as that of the plaintiff's logo. Further the dot above the letter 'i' is a parallelogram, which is similar to the plaintiff's logo. It is further contended that the unauthorised use of the plaintiff's trademarks and the logo by the defendant with respect to substandard products by the defendants is causing irreparable loss to the goodwill and reputation of the plaintiff's trademarks and brand equity, and is also giving an impression that the product of the defendants originates from the house of the plaintiff. Counsel, in these circumstances, prays for grant of *ex parte ad interim injunction*.

I have heard learned counsel for the plaintiff and also perused the plaint, application and the documents filed along with the plaint. I am satisfied that it is a fit case for grant of *ex parte ad interim injunction*. Accordingly, till the next date of hearing, defendants, their partners, proprietors, servants, agents, and/or



anyone on behalf of the defendants are restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly dealing in products, which are identical or deceptively similar to the plaintiff's product bearing the SanDisk trademarks, SanDisk logo and the copyright in the artistic and literary works comprised in the SanDisk product packaging.

Plaintiff shall comply with the provisions of Order XXXIX Rule 3 CPC within fifteen days from today.

I.A. 13277/2016

This is an application filed by the plaintiff under Section 135 of the Trademarks Act, 1999, read with Order XXVI Rules 9 and 10 read with Section 151 of the Code of Civil Procedure seeking appointment of three Local Commissioners to visit the premises of the defendant.

Learned counsel for the plaintiff submits that in case Local Commissioners are not appointed, the plaintiff would suffer an irreparable loss, as upon receipt of summons the defendant will remove the impugned goods.

Having regard to the submissions made, present application is allowed.

SL.NO.	NAME & MOBILE NO.	PLACE OF VISIT
1.	Mr. Insaaf Duggal, Advocate (Mobile No.9999234877)	Captain Video, Shop No.562, Old Lajpat Rai Market, Delhi- 110006.
2.	Jatinder Pal Singh, Advocate, Mobile No.9811695921	Ajay Gupta & Co., Shop No.14, Angoori Bagh, Behind Red Fort, Yamuna Bazar, Delhi- 110006.
3.	Mr.Jaideep Tandan, Advocate, Mobile No.9810070237 Phone-23269025	Rishabh Electronics, Shop no.1, Ground Floor, Arya Samaj Road, Opposite Metro Mall, Karol Bagh, Delhi-110005.



The Local Commissioners shall prepare an inventory of and take into custody the infringing products or packaging or any other material bearing the SanDisk trademark of the plaintiff as also the TRANDISK logo mark, including blocks, dies, cartons, machines for making the moulds for the flash drives, printed matter as also computer hard disks where the files bearing the artwork may be stored and hand them over to the representative of the defendant on *Superdari*.

The fees of the Local Commissioners is fixed at Rs.80,000/-, each, besides all out of pocket expenses, which shall be borne by the plaintiff. SHO of the concerned Police Stations are directed to render all Police assistance to the Local Commissioners on the date of execution of the commission.

Application stands disposed of.

DASTI under the signature of Court Master.

G.S.SISTANI, J

OCTOBER 25, 2016

msr