

(2016) 10 DEL CK 0064
In the Delhi High Court
Case No : CS(COMM) No. 1155 of 2016

Western Digital Technologies Inc

APPELLANT

Vs

Mr. Ashish Kumar

RESPONDENT

Date of Decision : 20-10-2016

Acts Referred:

Trade Marks Act, 1999 — Section 29

Citation : (2016) 68 PTC 554 : (2017) 3 RAJ 711

Hon'ble Judges : G.S. Sistani, J.

Bench : Single Bench

Advocate : Mr. Naresh Kaushik and Ms. Joymoti Mize, Advocates, for the Defendants; Ms. Shwetassree Majumder and Mr. Prithi Singh, Advocates, for the Plaintiffs

Final Decision : Disposed Off

Judgement

G.S. Sistani, J.(Oral) - Plaintiffs have filed the present suit for permanent injunction restraining infringement of registered trade marks, passing off of unfair competition, delivery up and rendition of accounts.

2. As per the plaint, the plaintiffs are world-renowned manufacturers and marketers of inter alia storage devices, media players, routers/switches/bridges, comprising of OEM/system manufacturer, desktop and enterprise, solid state drives(SSD) and software and mobile applications which are marketed and sold under the plaintiffs' trademarks. In India, the plaintiff no.1 holds statutory rights in the plaintiffs' trademarks. Details of such registrations have been tabulated in para 9 of the plaint. The plaintiffs claim that the trademarks registrations are valid and subsisting in law. The plaintiffs have also recorded the above trademarks rights with the Customs authorities under the Intellectual Property Rights(Imported Goods) Enforcement Rules, 2007 under which they are entitled to specifically prevent the import of infringing goods bearing the above trademarks. It is claimed that on account of the aforesaid registration, whenever any third party attempts to import products bearing the plaintiffs' registered

trademarks and the Customs authorities either find that the said party is not included in the list of the plaintiff's authorised importers or the products appear to be counterfeit, a notice is generated seeking the plaintiffs' inputs on the said products and comment on whether they are infringing goods or are genuine products in order for them to be appropriately dealt with under the Customs Rules.

3. It is claimed that the plaintiffs also own and maintain several websites whose domain names contain "Western Digital" or "WD" and are used for marketing and selling WD products, some of which are as under:

www.wd.com ? created on May 25,1994;

www.westerndigital.com ? created on January 21, 1998;

www.wdstore.com ? created on May 23, 2001;

www.westernditigal.info ? created on September 12, 2001;

www.westerndigital.biz ? created on March 28, 2002;

www.westernditigal.asia ? created on March 17, 2008.

4. Defendant no.2 is an importer of computer peripherals and hardware such as hard disk drives, flash drives, tablets, USB dial drives, micro SDHC cards. Defendant no.1 is the proprietor of defendant no.2. The complaint of the plaintiffs is that goods of the plaintiffs are being imported into India. However, the goods are not imported through legitimate channel or in a lawful manner. Another complaint of the plaintiff is that although to the best of the knowledge of the plaintiff, the goods may be genuine, but the goods do not show that they are parallel imports from a particular country. The goods are not supported by the Western Digital warranty services or customer care and thus, the unwary customers may be misled that the goods being sold to have carried the same warranty and services as provided by the plaintiffs. The result of this would be that the disgruntled customer may affect the rights and reputation of the plaintiffs. Both the parties had relied on a decision rendered in the case of Kapil Wadhwa & Ors., v. Samsung Electronics Co. Ltd. & Anr., reported at 2013(53) PTC 112(Del)(DB). The parties have very fairly agreed that the matter can be amicably resolved, subject to the condition that the defendants would be willing to place permanently and affix a label to show that the goods have been imported and are not supported by an authorised Western Digital warranty.

5. The present suit is decreed on the following agreed terms:

(1) Label on products and packaging: A clear, un-removable and prominent label on both the packaging and product itself informing customers that the hard disk drives of Ambitious Marketing are:

(i) Parallel imports from _____ country;

(ii) Not supported by Western Digital warranty services or customer care;

(2) Invoices: All invoices issued by Ambitious Marketing as also by third parties who sell the products must also contain (i) to (ii) above;

(3) Marketing materials: Any advertising, marketing, offers for sale etc. for the WD parallel imported products ? whether on a third party e-commerce site or in physical premises or in print matter must contain (i) to (ii) above;

4. Warranty and After Sales services:

(iii) After sales services provided by Ambitious Marketing to be prominently indicated in signage at physical stores(whether the stores are run by Ambitious Marketing or by any authorised agent) as well as on online portals (whether by Ambitious Marketing or by any third party) where the goods are sold;

(iv) Terms of service must be drafted so that there are no differences in services and warranties between products offered by Western Digital and Ambitious Marketing;

(v) Terms to be printed on all invoices as also displayed in the online market places where the goods are sold by the defendants;

(vi) The warranty should at least run for the same duration as Western Digital's warranty;

6. The goods handed over by the Local Commissioner to the defendants on Superdari may be put to use by the defendants by complying with the order passed by the Court today.

7. The Court appreciates the efforts put in by the counsels for early resolution of the matter.

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8. The applications stand disposed of in view of the suit having been decreed.