

\$~20(Original)

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

+ CS(COMM) 503/2022 & I.A.20127/2022, I.A.458/2023,
I.A.2491/2023, I.A.4887/2023

SIRONA HYGIENE PRIVATE LIMITED Plaintiff
Through: Mr.Vaibhav Vutts, Ms. Aamna
Hasan, Ms. Anupirya Shyam and
Mr.Devadathan Jayachandran, Advs.

versus

AMAZON SELLER SERVICES PRIVATE LIMITED AND
ORS. Defendant

Through: Mr.Vivek Ayyagari and
Ms.Ramya Aggarwal, Advs. for D-1
Mr.Manish Jha, Mr.Dheeraj Nair and
Mr.Dhruv Nayar, Advs. for D-2
Mr. Anil Kumar Sahu and Mr. Mohit
Sharma, Advs. for D-7
Mr. Sahil Jafri/D-14 in person
Mr.Praveen Kumar, Adv. for D-15

CORAM:
HON'BLE MR. JUSTICE C.HARI SHANKAR

JUDGMENT (ORAL)

%

14.03.2023

I.A.20127/2022 (under Order XXXIX Rules 1 and 2 of CPC)

1. By this judgement, I proceed to decide the present application, which seeks interim injunctive relief against the defendants.

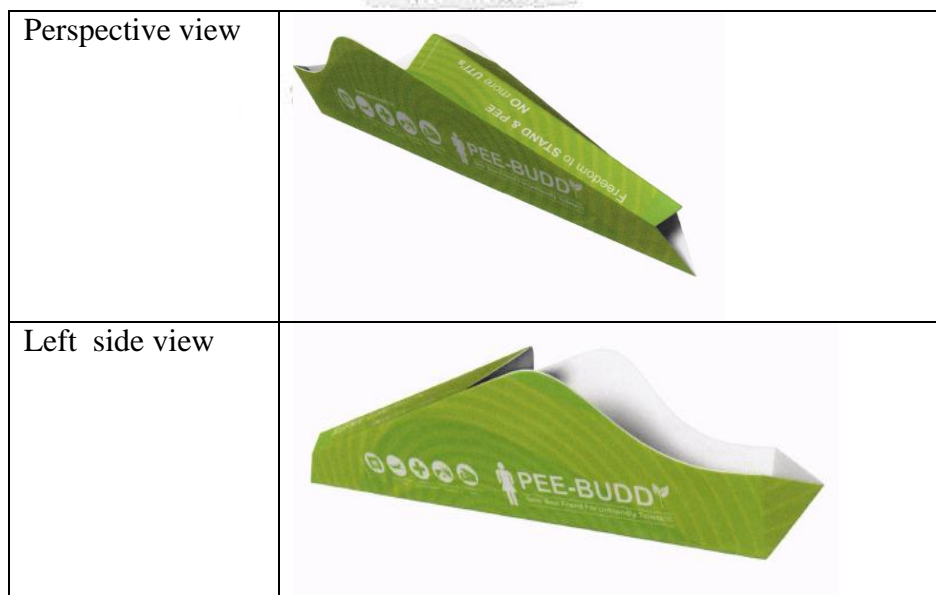
2. There are fifteen defendants, of which the allegedly infringing defendants are Defendants 3 to 15. Of these defendants, the suit stands settled and decree sheet drawn up in respect of Defendants 2, 3, 5, 6, 8, 10, 11, 12, 13, 14 and attempts at settlement of the dispute with Defendants 15 are in progress.

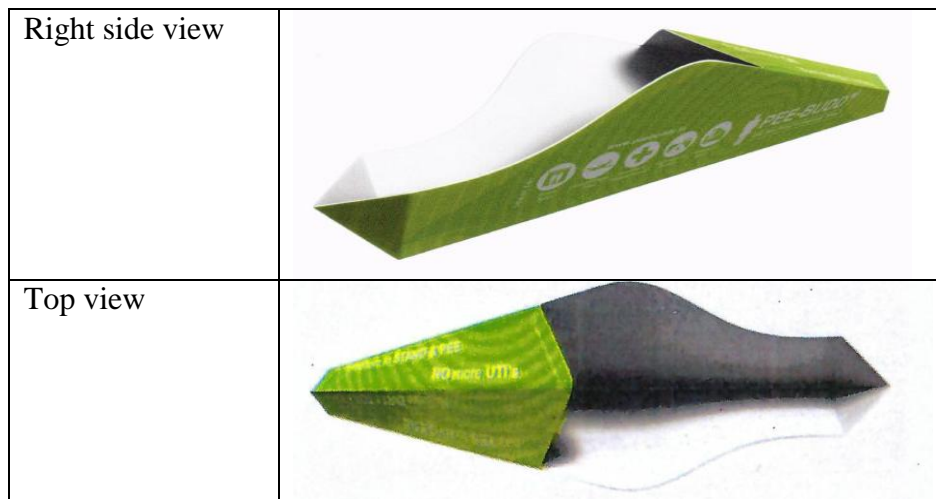
3. Defendant 9 has remained absent in these proceedings. The only surviving defendants are Defendant 1-Amazon Seller Services Pvt Ltd and Defendant 7, who continues to contest the plaint.

4. As such, this plaint survives for consideration only *vis-à-vis* Defendant 7.

5. I have heard Mr. Vaibhav Vutts, learned Counsel for the plaintiff and Mr. Anil Kumar Sahu, learned Counsel for Defendant 7, at considerable length.

6. The present case is one of alleged design infringement. The plaintiff asserts Design 263764, certified in favour of the plaintiff on 30th June 2014 by the Patent Office. The design is in respect of a disposable female urination device titled “PEE BUDDY”, intended to enable females to pass urine while standing. The certificate of registration registers the suit design in its perspective view, the left side view, the right side view and the top side view, which are as under:





7. The statement of novelty, in the certification, certifies that “novelty resides in the shape and configuration of the product”.

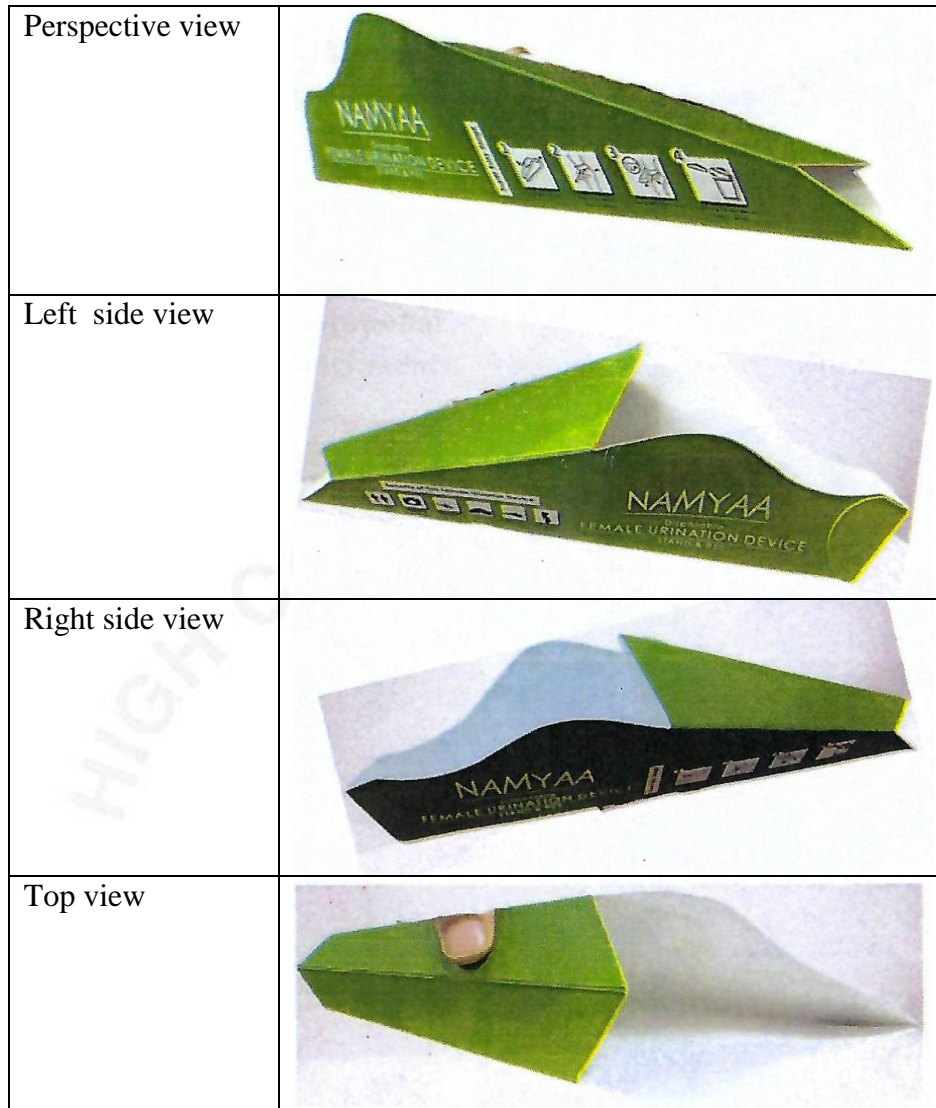
8. The plaintiff is aggrieved by the fact that Defendant 7 is manufacturing and selling identical devices under the name “NAMYAA”. Mr. Vutts submits that the design of the defendant’s product is identical to the suit design and, therefore, constitutes piracy of the suit design within the meaning of Section 22(1)¹ of the Designs Act 2000.

9. Physical samples of the plaintiff’s product and the defendants’ product have been handed over to the court. While the plaintiff’s product is clearly reflected in the views contained in the design certificate issued to the plaintiff, a photograph of the perspective view, the left side view, the right side view and the top side view of the

¹ 22. Piracy of registered design. –

- (1) During the existence of copyright in any design it shall not be lawful for any person –
- (a) for the purpose of sale to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or
 - (b) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or
 - (c) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

defendant's product may be provided thus:



10. It is clear, from a comparison of the two products that the design of the Defendant 7's product is identical to that of the plaintiff's product.

11. Indeed, Mr. Anil Kumar Sahu, learned Counsel for Defendant 7, does not dispute this fact.

Rival Submissions

12. Mr Sahu launches a three-pronged attack on the suit patent.

13. Lack of novelty and originality – Section 22(3)² read with Section 19(b) and (c)³ and 4(a)

13.1 Mr. Sahu’s contention is that, much before the plaintiff had visualised the suit design, a product “P-MATE”, also intended to serve the very purpose which the plaintiff’s product served, was already in existence, though the said device was created and registered in the US. A photograph of the said “P-MATE device” is available at page 72 of the documents filed by the defendant, and a physical sample of the product has also been handed over by Mr. Sahu across the Bar.

13.2 Mr. Sahu’s contention is that, even if the “P-MATE” device is not identical in design to the plaintiff’s product, the distinctions between the two are so infinitesimal as to constitute merely trade variants, which are insufficient to impart novelty or originality to the plaintiff’s design. He relies, for this purpose, on the judgment of a Division Bench of this Court in *Crocs Inc. v. Bata India Ltd.*⁴ as well as the judgments of learned Single Judges of this Court in *Philips Lighting Holding B.V. v. Jai Prakash Agarwal*⁵ and *Steelbird Hi-tech India Ltd. v. S.P.S. Gambhir*⁶.

13.3 Mr. Vutts, submits, *per contra*, that the designs of the “P-MATE” device and the suit design are different in major respects,

² (3) In any suit or any other proceeding for relief under sub-section (2), every ground on which the registration of a design may be cancelled under Section 19 shall be available as a ground of defence.

³ **19. Cancellation of registration. –**

(1) Any person interested may present a petition for the cancellation of the registration of a design at any time after the registration of the design, to the Controller on any of the following grounds, namely:—

(b) that it has been published in India or in any other country prior to the date of registration; or

(c) that the design is not a new or original design; or

⁴ (2019) 78 PTC 1

⁵ 2022 SCC OnLine Del 1923

⁶ (2014) 58 PTC 428

which cannot be treated as mere trade variants. He has specifically drawn my attention to the overall shape of the plaintiff's product and the aperture at the end of the plaintiff's product which, he submits, is markedly different of the "P-MATE" device.

13.4 I may note that Mr. Sahu has also relied on Design No. 224868 which stands registered for a "female standing urinal device" in favour of Jitender Agarwal on 11th February 2011. However, the only photograph or representation of the said design available on record is the following, at page 59 of the documents filed by the defendant:



14. Non-registration of assignment deed – Sections 30(1), (3) and (5)

14.1 Apart from the aforesaid submissions on merits, Mr. Sahu also contends that the plaintiff is not entitled to interim injunction in view of Section 30(1),(3) and (5)⁷ of the Designs Act. He submits that the

⁷ 30. **Entry of assignment and transmissions in registers. –**

(1) Where a person becomes entitled by assignments, transmission or other operation of law to the copyright in a registered design, he may make an application in the prescribed form to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of such design, and shall cause an entry to be made in the prescribed manner in the register of the assignment, transmission or other instrument affecting the title.

(2) Where any person becomes entitled as mortgagee, licensee or otherwise to any interest in a registered design, he may make an application in the prescribed form to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his

plaintiff has admittedly sourced its right to exclusivity in the suit design on the basis of an assignment deed dated 1st January 2017, issued by M/s First Step Projects, a partnership firm. However, he submits that there is no evidence to indicate that the said assignment deed was tendered to the Controller of Designs in accordance with Section 30(1) of the Designs Act, resulting in the controller registering the plaintiff as the proprietor of the design. He submits that registration of the plaintiff as the proprietor of the design is a *sine qua non* to entitle the plaintiff to seek an interim injunction. In the event of failure on the part of the plaintiff to secure such registration, Mr. Sahu's contention is that the assignment deed cannot even be read in evidence, in view of Section 30(5), resulting in the plaintiff becoming disentitled to any relief from the court.

14.2 For this purpose, Mr. Sahu relies on the judgment of a learned Single Judge of this Court *Amit Jain v. Ayurveda Herbal*⁸, and on judgements of learned Single Judges of the High Court of Bombay in *Cott Beverage Inc. v. Silvassa Bottling Company*⁹ and of the High

satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of designs, with particulars of the instrument, if any, creating such interest.

(3) For the purposes of sub-section (1) or sub-section (2), an assignment of a design or of a share in a design, a mortgage, licence or the creation of any other interest in a design shall not be valid unless the same were in writing and the agreement between the parties concerned is reduced to the form of an instrument embodying all the terms and conditions governing their rights and obligation and the application for registration of title under such instrument is filed in the prescribed manner with the Controller within six months from the execution of the instrument or within such further period not exceeding six months in the aggregate as the Controller on the application made in the prescribed manner allows:

Provided that the instrument shall, on entry of its particulars in the register under sub-section (1) or sub-section (2), have the effect from the date of its execution.

(4) The person registered as the proprietor of a design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the design and to give effectual receipts for any consideration for any such assignment, licence or dealing.

Provided that any equities in respect of the design may be enforced in like manner as in respect of any other movable property.

(5) Except in the case of an application made under Section 31, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of sub-sections (1) and (2) shall not be admitted in evidence in any court in proof of the title to copyright in a design or to any interest therein, unless the court, for reasons to be recorded in writing, otherwise directs.

⁸ MANU/DE/1323/2015

⁹ (2004) 29 PTC 679

Court of Himachal Pradesh in ***Claridge Moulded Fiber Ltd. v. Mohan Fiber Products Ltd¹⁰***.

14.3 To this submission, Mr. Vutts' response is that the suit design was registered in favour of M/s First Step Projects, which was a partnership firm of Mohit Bajaj and Deep Bajaj, who constituted a private limited company, namely the plaintiff, on 25th June 2015 and, *vide* assignment deed dated 1st January 2017, transferred its rights in the suit design to the plaintiff company. He submits that, on the very same day i.e. 1st January 2017, the plaintiff applied to the Controller of Designs to have the plaintiff's name registered as the proprietor of the suit design, and also tendered the requisite fees of ₹ 2,000/- for this purpose. He has drawn my attention to the communication dated 1st January 2017 from the plaintiff to the Controller of Designs, to the said effect as well as a copy of the cheque for ₹ 2,000/- in the name of the Controller of Designs, towards the payment of the requisite fees for registration of the name of the plaintiff as the proprietor of the suit design.

14.4 As such, he submits that the plaintiff cannot be non-suited merely because no formal entry of the plaintiff as the proprietor of the suit design was made before the suit was filed.

15. Suppression

15.1 Mr. Sahu further contends that the plaintiff has suppressed the fact that the plaintiff had addressed a legal notice to NYKAA E-Retail Pvt. Ltd (hereinafter referred to as "NYKAA"). He submits that this suppression was deliberate as NYKAA had, in that regard,

¹⁰ MANU/HP/0153/2004

communicated to the defendant, who had, in its reply dated 2nd March 2020 to NYKAA, alleged that the suit design was bad on account of prior publication. Mr. Sahu's contention is that the suppression, by the plaintiff, of its legal notice to NYKAA was only so that this reply of Defendant 7 to NYKAA would not be brought to the notice of the court.

Analysis

16. I proceed to deal with the above submissions, but in reverse order.

17. Re. allegation of suppression of fact

17.1 Insofar as the plea of suppression of fact is concerned, I am of the opinion that the submission of Mr. Sahu cannot hold water. There is nothing to indicate that the plaintiff was aware of the communication made by defendant to NYKAA. Insofar as the inaction in suing NYKAA is concerned, the decision regarding the defendants whom he wishes to sue is the pristine prerogative of the plaintiff.

17.2 Be that as it may, in the absence of any material to indicate that the plaintiff was aware of the communication dated 2nd March 2020, from the defendant to NYKAA, the allegation of suppression of fact must necessarily fail.

18. Re. Section 30 of the Designs Act

18.1 Adverting, next, to the submission of Mr. Sahu predicated on Section 30 of the Designs Act, the documents filed by the plaintiff

indicate, clearly, that, on 1st January 2017 itself, on which date First Step Projects assigned its rights in the suit design to the plaintiff, the plaintiff wrote to the Controller of Designs, seeking registration of the suit design in the plaintiff's name. The plaintiff has also placed on record a copy of the cheque for ₹ 2000/- issued in the name of the Controller of Designs, which is also of the same date i.e. 1st January 2017. At a *prima facie* stage, therefore, there is no reason for me to disbelieve Mr. Vutts' contention that the plaintiff had, in fact, applied to the Controller of Designs within the stipulated period of six months, envisaged in Section 30(1) of the Designs Act, for recording the plaintiff as the proprietor of the suit design in the register of designs. In fact, the application was made with utmost promptitude, having been made on the very date when the rights in the suit design were assigned to the plaintiff by First Step Projects.

18.2 The question, then, is whether the plaintiff can be non-suited or disentitled to interlocutory relief merely because the Controller of Designs had not, by the time the suit was filed, entered the plaintiff's name in the register of Designs as the proprietor of the suit design. Mr. Sahu would submit, relying on the decisions in *Amit Jain*⁸, *Cott Beverage Inc.*⁹ and *Claridge Moulded Fiber Ltd.*¹⁰, that the answer to this poser has to be in the affirmative.

18.3 I regret my inability to agree.

18.4 *Lex non cogit ad impossibilia*¹¹, the law tells us. In *G.P. Ceramics Pvt Ltd v. Commissioner, Trade Tax*¹², the Supreme Court has, even while not expressly invoking the maxim, held, in

¹¹ The law does not compel a man to do the impossible.

¹² (2009) 2 SCC 90

unexceptionable terms, that where the entitlement of a citizen to rights is dependent on a certification or a registration to be made by a governmental authority, and the citizen applies within time to the governmental authority to secure such registration or certification, the inaction on the part of the governmental authority in issuing the certification or registration cannot act to the prejudice of the citizen and the citizen would be entitled to be treated as having obtained the requisite registration or certification. This maxim applies, squarely, to the facts of the present case, inasmuch as the plaintiff had applied, on the very date of execution of the assignment deed assigning the rights of the suit design to the plaintiff, i.e. 1st January 2017, for entering the name in the register of Designs as the proprietor of the suit design. The inaction on the part of the Controller of Designs in acting on the said request before the suit was filed, cannot, therefore, act to the prejudice of the plaintiff.

18.5 There is yet another reason why this submission of Mr. Sahu does not merit acceptance, at least at a *prima facie* stage. Section 30(1), even while ordaining that a document or instrument in respect of which no entry has been made in the register in accordance with Section 30(1) and (2) shall not be admitted in evidence in proof of the title to copyright in a design or to any interest in the design, saves the power of the court, in an appropriate case, to direct otherwise, for reasons to be recorded in writing.

18.6 In my considered opinion, where the assignee has applied to the Controller of Designs, in accordance with Section 30(1) with all due promptitude and without any avoidable delay, and the Controller does not take any decision on the application till a suit is filed, the interests of justice would require the document of assignment to be taken into

account while considering the plaintiff's case for interim injunctive relief. Else, a peculiar situation would arise in which, till the Controller takes a decision on the plaintiff's application, the plaintiff would be disentitled to seek any relief predicated on his right or title to the suit design. That, quite obviously, is the mischief which the escape clause in Section 30(5) specifically intends to avoid.

18.7 For the said reason, as the request to the Controller of Designs for entering the plaintiff's name as the proprietor of the suit design had been made on 1st January 2017 itself, being the very date on which the right in the suit design was assigned to the plaintiff, I am of the opinion that the plaintiff is entitled, at this *prima facie* stage, to assert its right in suit design.

18.8 This second preliminary objection of Mr. Sahu, too, fails.

19. Re. merits of the dispute – validity of the suit design

19.1 Adverting, now, to merits.

19.2 Mr. Sahu contends that the suit design is bad for want of novelty and originality. He has cited, in this context, the P-MATE device which was already in the market much before the suit design.

19.3 The P-Mate device, it may be noted, looks like this:



19.4 Mr. Sahu himself candidly acknowledges that the suit design is not identical to the design of the P-MATE device. However, he submits that the differences between the two are only minor trade variants, which are insufficient to impart novelty or originality to the suit design.

19.5 It is correct that a design cannot be treated as novel and original if, *vis-a-vis* prior art, it is different only in respect of minor trade variants.

19.6 The passage from the opinion of Buckley L.J. in *Simmons v. Mathieson & Cold*¹³, which has been followed by this Court in *Philips Lighting Holding B.V.*⁵ as well as in *Steelbird Hi-tech India Ltd.*⁶ classically lays down the tests for determining whether the difference between a suit design and prior art is substantial or merely in the nature of trade variants. The passage may be reproduced thus:

17. In *Phillips v. Barbro Rubber Company*¹⁴, Lord Moulton observed that while question of the meaning of design and of the fact of its infringement are matters to be judged by the eye, it is necessary with regard to the question of infringement, and still more with regard to the question of novelty or originality, that the eye should be that of an instructed person, i.e. that he should know what was common trade knowledge and usage in the class of articles to which the design applies. The introduction of ordinary trade variants into an old design cannot make it new or original. He went on to give the example saying, if it is common practice to have or not to have, spikes in the soles of running shoes, any man does not make a new and original designs out of an old type of running shoes by putting spikes into the soles. The working world, as well as the trade world, is entitled at its will to take, in all cases, its choice of ordinary trade variants for use in particular instance, and no patent and no registration of a design can prevent an ordinary workman from using or not using trade knowledge of this kind. It was emphasized that it is the duty of the Court to take special care that no design is to be counted as “new and original design” unless it is distinguished from that previously existed by something essentially new or original which is different from ordinary trade variants which have long been common matters of

¹³ (1911) 28 RPC 486

¹⁴ (1920) 37 R.P.C. 233

taste workman who made a coat (of ordinary cut) for a customer should be left in tender whether putting braid on the edges of the coat in the ordinary way so common a few years ago, or increasing the number of buttons or the like, would expose him for the prescribed years to an action for having infringed a registered design.”

19.7 In examining whether the differences between the suit design and prior art are sufficient to impart novelty to the suit design, or are merely in the nature of trade variants, the court must, in my opinion, keep in mind two important factors. The first is the reason for which the Controller of Designs has, while granting certification to the suit design, regarded the suit design as novel. The second is the purpose to which the article is to be put.

19.8 Though the definition of “design”, in Section 2(d) of the Designs Act, is not with respect to the utility of the product to which the design pertains, but reflects, instead, the features of the design which appeal to the eye, when one considers whether the differences between the prior art and the suit design are merely in the nature of trade variants and where the suit design is in respect of a product which is utilitarian in nature, the extent to which the differences in prior art and the suit design would make a difference to the utility of the product has also, in my opinion, to be borne in mind. There is, in my considered view, a difference between a design which is merely ornamental and a design which is utilitarian, when one considers the aspect of distinction of a suit design vis-a-vis prior art. Where a design is utilitarian, it is possible that the differences vis-a-vis prior art, though minor on a visual inspection, may be substantial where the utility of the product is concerned.

19.9 Without going into specifics, the differences in the suit design,

vis-a-vis the design of the P-MATE device, include marked differences in the shape of the device, which would impact the manner in which it is used by the user, as well as the terminal outlet for passing out of urine. The Controller of Designs has specifically held that novelty in the suit design resides *in its shape* and configuration. It cannot be said, *prima facie*, that the differences in the shape of the suit design, *vis-a-vis* the design of the P-MATE device are so minor as to be merely trade variants. The shape of the P-MATE device is markedly different qua the part of the device which would be in touch with the body, as compared to the suit design. The said difference cannot, given the nature of the device involved, be regarded as a mere trade variant, at least at a *prima facie* stage, in the absence of any positive evidence to so indicate. At the very least, it would a matter of trial for the defendant to prove, by leading evidence, that the difference in design is merely a trade variant. The court is unable, at a *prima facie* stage, to convince itself that the differences in shape between the suit design and the design of the P-MATE device are merely minor trade variants, and are insufficient to impart novelty and originality to the suit design.

19.10 Insofar as the prior art cited in para 13.4 *supra* is concerned, the image is so obscure that is impossible to visualize the actual product from it. While it is not essential that the physical products should be brought before the court for comparison of designs, whether for assessing infringement or the validity of the suit designs, it has been settled by the Supreme Court, in *Bharat Glass Tube Ltd. v. Gopal Glass Works Ltd.*¹⁵, that the image must be such as would empower the Court to visualize the design in all its dimensions. That test is not satisfied by the image cited in para 13.4.

¹⁵ (2008) 10 SCC 657

19.11 As such, even applying the classical test of novelty and originality as held by Buckley L.J. in *Simmons*¹³, I am of the opinion that it cannot be said the suit design is lacking in novelty and originality *vis-a-vis* prior art.

19.12 Even though the Designs Act does not contain any provision analogous to section 31 of the Trade Marks Act deeming registration of design to be prima facie proof of its validity, nonetheless, at the interlocutory stage, in the absence to the convincing evidence to the contrary, the Court can rely on the fact that a design is registered as a factor in favour of the design registrant. In this context, one may usefully refer to *Micolube India Limited v. Rakesh Kumar*¹⁶. Therefore, in the absence of evidence to the contrary, a certificate of granting registration to a design has to be treated as prima facie evidence of validity of the design. Of course, this would be subject to the defendant being able to establish, at least *prima facie*, that the suit design suffers from want of novelty and originality. That, unfortunately, Mr. Sahu has not, in the present case, been able to do.

20. Section 19(1)(b):

20.1 Though he faintly pressed Section 19(1)(b) of the Patents Act also into service, Mr Sahoo did not seriously labour the point. Apropos Section 19(1)(b), it is quite obvious that the provision has no application to the present case. Section 19(1)(b) applies only where the suit design has been published in India or in any other country prior to the date of registration. The prior publication has, therefore, to be of the design itself. Prior publication even of a deceptively or

¹⁶ (2013) 55 PTC 1 : 199 (2013) DLT 740 (FB)

confusingly similar design cannot invite the applicability of Section 19(1)(b) of the Designs Act.

20.2 It is nobody's case that the suit design has been published anywhere prior to the grant of certification of the design to the plaintiff. As such, Section 19(1)(b) does not apply.

Conclusion

21. For the aforesaid reasons, I am of the view that the plaintiff has made out a *prima facie* case in its favour, justifying the plaintiff to injunction. The design of the Defendant 7's product is identical to the suit design. Indeed, that aspect has not even been canvassed by Mr. Sahu. The submission of Mr. Sahu regarding invalidity of the suit design has not, for the reasons already cited hereinabove, found favour with the court, at this *prima facie* stage. The other preliminary objections of Mr. Sahu, too, are found to be lacking, *prima facie*, in merit.

22. Where there is a case of infringement, an injunction has necessarily to follow.

23. As such, pending disposal of the suit, Defendant 7 and all others acting on its behalf shall stand restrained from further manufacturing, marketing or selling the impugned "NAMYAA" disposable female urination device, as well as from manufacturing or marketing any product which has a design which is deceptively similar to the suit design.

24. The application is accordingly allowed.

25. The defendant is, however, permitted to dispose of the currently existing stock and given two months time to do so.

I.A.2491/2023 (under Order XXIII Rule 3 of the CPC)

26. This is a joint application under Order XXIII Rule 3 of the Code of Civil Procedure, 1908 (CPC) which seeks decreeing of the suit in terms of the settlement arrived at between the plaintiff and Defendant 14. The terms of settlement, as set out in the application, read thus:

i. That the Defendant No. 14 acknowledges the Plaintiff to be the owner of Registered Design No. 263764 in class 23-02 titled "Disposable Female Urination Device" sold by the Plaintiff under the trademark PEE-BUDDY (hereinafter collectively referred to as ("PEE-BUDDY Design & Trade Mark').

ii. That the Defendant No. 14 undertakes that it will not directly or indirectly use PEE-BUDDY Design & Trade Mark in any manner whatsoever or, directly or indirectly, offer not to sell, offer for sale, or market or advertise, by itself, its agents, licensees, affiliates, distributors, associates, including through any internet based ecommerce platform or any third party, including the ones hosted by Amazon Seller Services Private Limited and Flipkart Internet Services Private Limited (Defendants No. 1 and 2 respectively), any product that might infringe the intellectual property rights of the Plaintiff's PEE BUDDY Design & Trademark.

iii. That the Defendant No. 14 will not use Plaintiff's PEE BUDDY Design & Trade Mark on any products, board, hoarding, invoices, pamphlet, promotional, marketing or promotional materials.

iv. That the Defendant No. 14 undertakes that it will either withdraw or assign all copyright applications/industrial design applications/registrations or trademark applications/registration, if any, that are in conflict with the Plaintiff's PEE BUDDY Design & Trade Mark and provide the Plaintiff with a stamped copy of the withdrawal letter or duly executed assignment deed within a period of one month from the date of this Application.

v. That the Defendant No. 14 undertakes that it will not challenge the rights of Plaintiff's PEE BUDDY Design & Trade

Mark in any manner whatsoever.

vi. That the Defendant No. 14 undertakes that it has exhausted all stock of the impugned product 'SHE AID'.

vii. The Parties agree that the signatories to the present settlement are fully competent and authorized to enter into the present Application.

viii. The Parties agree that all the terms and conditions laid out in the present Application are fair and reasonable and have been entered into after full appreciation of its various clauses and implications.

ix. The Defendant No. 14 hereby agrees before this Hon'ble Court that the present terms and compromise shall be binding on all their principal officers, directors, agents, servants, successors, and assigns in business interest and title and all other acting for and on their behalf, for all times to come.

x. The Parties agree that all their disputes have been resolved by virtue of this Application and the Plaintiff would not institute or press whatsoever further remedies available to it including any money compensation, for Infringement of Plaintiff's PEE BUDDY Design & Trademark with respect to this subject matter.”

27. The plaintiff is represented by Mr. Vaibhav Vutts and Defendant 14 is present in person. They agree to abide by the terms of the settlement as noted hereinabove.

28. As such, nothing survives for adjudication between the plaintiff and Defendant 14.

29. The suit shall stand decreed *qua* Defendant 14 in terms of the aforesaid terms of settlement by which the plaintiff and Defendant 14 shall remain bound.

30. Let the Registry draw up a decree sheet accordingly.

31. IA 2491/2023 is disposed of.

I.A.4887 /2023 (under Order XXIII Rule 3 of the CPC)

32. This is a joint application under Order XXIII Rule 3 of the Code of Civil Procedure, 1908 (CPC) which seeks decreeing of the suit in terms of the settlement arrived at between the plaintiff and Defendant 2. The terms of settlement, as set out in the application, read thus:

- i. That the Defendant No.2 acknowledges the Plaintiff to be the owner of Registered Design No. 263764 in class 23-02 titled "Disposable Female Urination Device" sold by the Plaintiff under the trademark PEE-BUDDY (hereinafter collectively referred to as ('PEE-BUDDY Design & Trade Mark').
- ii. The Plaintiff shall inform Defendant no. 2 whenever it comes across unauthorized use of the Plaintiff's Design no. 263764 for its product 'PEE-BUDDY' on the e-commerce platform www.flipkart.com of Defendant no.2 in the following manner:
 - a. Plaintiff shall send an email from the email IDs legal@vutts.com containing the specific URL which violates its Design no: 263764.
 - b. Plaintiff shall use the subject line - Takedown of URL(s) *Sirona Hygiene Pvt Ltd vs. Amazon Seller Services Pvt Ltd. and Ors.* while intimating Defendant No.2.
 - c. Plaintiff shall send the URL(s) on the following email ID — infringement@flipkart.com and takedown@jsalaw.com.
- iii. Upon receipt of the information in the manner specified above, Defendant no. 2 shall take down the infringing goods from its ecommerce portal within 72 hours.
- iv. In the event, Defendant No.2 is unable to remove the URL(s), it will intimate the Plaintiff of the same within 48 hours.
- v. Plaintiff undertakes to indemnify Defendant no, 2 before the appropriate judicial/quasi-judicial or administrative authority etc. in the event any legal action is brought by a third party against Defendant no. 2 for removal of a product listing, pursuant to Plaintiff's request for removal of URL.
- vi. The Parties agree that the signatories to the present settlement are fully competent and authorized to enter into the present Application.

vii. The Parties agree that all the terms and conditions laid out in the present Application are fair and reasonable and have been entered into after full appreciation of its various clauses and implications.

viii. The Defendant No.2 hereby agrees before this Hon'ble Court that the present terms and compromise shall be binding on all their principal officers, directors, agents, servants, successors, and assigns in business interest and title and all other acting for and on their behalf, for all times to come.

ix. The Parties agree that all their disputes have been resolved by virtue of this Application and the Plaintiff would not institute or press whatsoever further remedies available to it including any money compensation against Defendant No.2 for infringement of Plaintiff's PEE BUDDY Design & Trademark with respect to this subject matter.”

33. The plaintiff is represented by Mr. Vaibhav Vutts and Defendant 2 is represented by Mr. Manish Jha. They agree to abide by the terms of the settlement as noted hereinabove.

34. As such, nothing survives for adjudication between the plaintiff and Defendant 2.

35. The suit shall stand decreed *qua* Defendant 2 in terms of the aforesaid terms of settlement by which the plaintiff and Defendant 2 shall remain bound.

36. Let the Registry draw up a decree sheet accordingly.

37. IA 4887/2023 is disposed of.

I.A. 458/2023 (under Order XI Rule 1(5) of the CPC)

38. This is an application by the plaintiff to place certain additional documents on record. As the suit is at a pre-trial stage, following the

judgment of the Supreme Court in *Sugandhi v. P. Rajkumar*¹⁷, this application is allowed.

39. Subject to the right of the defendants to admit/deny the documents, the documents are taken on record.

40. List before the learned Joint Registrar (Judicial) for conducting the exercise of admission/denial of the additional documents placed on record today on 11th April 2023, whereafter the matter would be placed before the Court for case management hearing and further proceedings.

41. Mr.Vivek Ayyagari, learned Counsel for Defendant 1, submits that if the plaintiff draws the attention of Defendant 1 to any other infringing URLs, it would take down the URLs.

42. Accordingly, Mr. Vutts does not seek to continue D-1 as a party in these proceedings.

43. Defendant 1 shall stand deleted from the array of parties.

44. Let an amended memo of parties be filed by the plaintiff within a week from today.

C. HARI SHANKAR, J.

MARCH 14, 2023

dsn

¹⁷ (2020) 10 SCC 706