

***SEARCH ORDERS AND EFFECTIVE COOPERATION  
WITH STATE AUTHORITIES – INDIA***

SESSION 2.2

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*Gaurav Mukerjee*

*Partner*

*Remfry & Sagar*

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## **FUNDAMENTAL PRINCIPLES UNDERLYING INDIAN TRADE MARKS JURISPRUDENCE**

- India is a common law jurisdiction.
- Use of a trade mark takes precedence over registration.
- Registration of a trade mark confers no better right than what already exists at common law.

### **Having said that, Registration:**

- Is *prima facie* evidence of proprietorship.
- Entitles the registered proprietor to avail of the statutory remedy of infringement.

**SEIZURES AVAILABLE UNDER BOTH:**

➤ CIVIL PROCEEDINGS

Anton Piller Orders (including John Doe Orders).

➤ CRIMINAL PROCEEDINGS

Orders to the Police to investigate which includes conducting search & seizure operations.

**Civil Remedies**

**Infringement  
(statutory remedy)**

**Passing Off  
(common law remedy)**

**Interim Injunction  
&  
Appointment of Local Commissioners**

## **SEIZURES UNDER CIVIL PROCEEDINGS**

### ANTON PILLER ORDERS

- Granted by Courts *ex-parte*.
- Issued even against unknown entities (John Doe Orders).
- Officer(s) popularly known as Local Commissioner(s) or Court Receivers appointed to assist the Right Holder in execution of search orders.

## **SEIZURES UNDER CIVIL PROCEEDINGS**

### ANTON PILLER ORDERS

- Such officers are usually practicing lawyers selected randomly from the Bar or from an existing panel.
- Representative/Counsel for the Right Holder required to accompany and assist.
- Mostly such Commissions, depending upon the area in which the Commission (search order) is to be executed, are granted Police assistance. The Role of the Police is confined to ensure peaceful execution of the search order.

## **SEIZURES UNDER CIVIL PROCEEDINGS**

### **ANTON PILLER ORDERS: SCOPE**

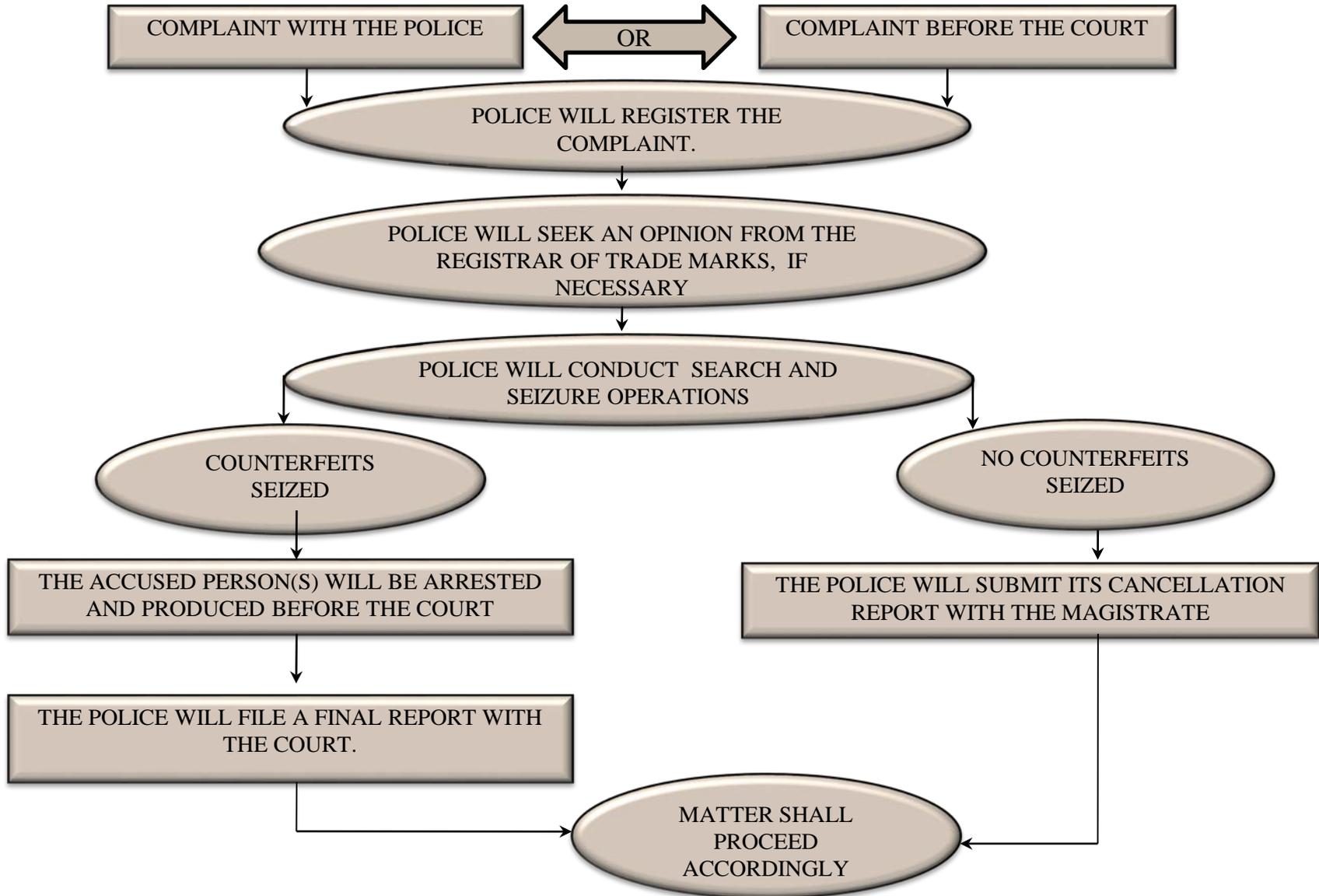
- Search of premises, seizure, sealing and inventory of all infringing material.
- Seized material left in the safe custody of Defendants on an undertaking to produce the same as and when called for by the Court.
- Report of the search and seizure has to be filed before the Court by the Local Commissioner.

## **A TYPICAL ORDER APPOINTING LOCAL COMMISSIONERS**

(e) that pending the hearing and final disposal of the suit, this Hon'ble Court be pleased to appoint the Court Receiver having all powers conferred under Order XI of the Code of Civil Procedure, 1908 to visit the premises of the Defendants along with representatives of the Plaintiffs at the addresses given above and any other premises which the Defendants, their promoters, (assigns, successors-in-interest, licensees, franchisees,) partners, directors, representatives, servants, (distributors,) employees, agents (etc.) would disclose, where the infringing goods/products, stationery, letterheads, signage, reprographic material, packaging, labels or any other material for advertising, selling or marketing any goods and/or other material infringing the Second Plaintiff's trade marks [REDACTED]

[REDACTED], [REDACTED], [REDACTED], [REDACTED], and [REDACTED], is kept or (stocked) and to make an inventory, seize and take possession thereof and the Defendants their promoters, (assigns, successors-in-interest, licensees, franchisees,) partners, directors, representatives, servants, (distributors,) employees, agents (etc.) be ordered and directed to deliver up all of the aforesaid goods/products/material to the Court Receiver and the Court Receiver shall be empowered to break open any lock, gate or door, to enter any place at any time, even after sunset and on holidays, without prior notice, and with police protection, if required in executing the aforesaid;

# CRIMINAL PROCEEDINGS



## □ **Civil Proceedings**

- Temporary/permanent injunction;
- Damages, delivery up, costs etc.

**Vs.**

## □ **Criminal Proceedings**

- Helps in removal of the infringing goods from the known sources;
- May also lead to removal of the impugned goods from the market to a large extent on account of news of the action taken by the right holder;
- Recommended course of action for dealing in cases of Counterfeiting and Piracy.

***Both remedies are not mutually exclusive.***

## **INTERPLAY BETWEEN CIVIL & CRIMINAL REMEDIES**

Evidence of misuse as unearthed during one action can be used for the other:

- Local Commissioner's report as filed with the Civil Court can form the basis of a subsequent Criminal complaint.
- Similarly, Polices' seizure report and records of the subsequent proceedings can serve as evidence in Civil proceedings.

## **FACTORS DETERMINING CHOICE OF REMEDY**

- Scale of operations;
- Reach of the impugned products;
- Location of the impugned entity;
- Area of operations;
- Modes of distribution;
- Whether the impugned entity is a part of the organized/unorganized sector; and
- Whether the impugned entity has applied for/secured any trade mark registration.

## **POINTS FOR EFFECTIVE COORDINATION WITH ENFORCEMENT AGENCIES**

- Relevant details are to be withheld till a Police team for the assignment has been constituted and allocated to the Right Holder/its Representative/Counsel.
- Advisable to have Counsel coordinate with the Police.
- Pre-raid surveillance should be undertaken to ensure availability of infringing material. Police expects the Right Holder to be diligent and to have done its 'homework'.



*Remfry & Sagar*

**Headquarters**

**New Delhi/ Gurgaon**

Remfry House at the Millennium Plaza,  
Sector 27, Gurgaon - 122 009  
New Delhi, National Capital Region, India  
Tel: 91-124-280-6100, 91-124-465-6100  
Fax: 91-124-280-6101, 91-124-257-2123  
Video Call: 91-124-465-6115  
E-mail: [remfry-sagar@remfry.com](mailto:remfry-sagar@remfry.com)

**Chennai**

376-B (Old No. 202),  
Avvai Shanmugam Salai,  
Gopalapuram, Chennai – 600 086,  
India  
Tel : 91-44-4263 7392  
Fax: 91-44-4263 7392  
E-mail: [remfry-sagar@remfry.com](mailto:remfry-sagar@remfry.com)

[www.remfry.com](http://www.remfry.com)