IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

INTERIM APPLICATION (L) NO. 22386 OF 2024
IN
COMMERCIAL IP SUIT (L) NO. 20290 OF 2024

Universal Test Solutions ...Plaintiff
Versus
Punam Kumari Singh and Others ...Defendants

Mr. Zal Andhyarujina, Senior Advocate a/ w Ms. Akansha Agarwal, Naira Jejeebhoy and Mr. Arun Panicker, Mr. Jacob Kadntot for the Plaitniff.
Mr. Rashmin Khandekar, Ms. Akshata Modi and Mr. Pankaj Uttaradhi for Defendant Nos. 1 to 3.
Mr. Arkesh Ayyagari i/b Mr. Meghnath Navlani and Mr. Suraj Singh for Defendant Nos. 4 and 6.

Coram : Sharmila U. Deshmukh, J.
Reserved on : 30th January, 2026
Pronounced on : 11th March, 2026.

ORDER :

1. This is an action for infringement of trade mark, copyright and passing-off. By the Interim Application, the Plaintiff seeks to restrain the Defendants from using the impugned trade marks "Test Magic – innovative test solutions" (device), "eZscript", "RoboMagic – An Enterprise Automation Platform" (device), "Universal Technology Soltuions", "ODC Universal Technology Solutions" and/or "UTS" or any other deceptively similar trade mark which according to the Plaintiff infringes the Plaintiff's registered trade mark "Test Magic - innovative test solutions (device), "eZscript - beyond imagination" (device) and

"UTS – Universal Test Solutions with device of world".

2. During the hearing of the Interim Application, the written note tendered on behalf of Defendant Nos. 1 to 3 stated that the Defendant Nos 1 to 3 are currently using "ODC Universal Technological Solutions Private Limited" as their corproate name and their domain name www.uts-global.com/"uts-global". Upon query by this Court, Mr. Khandekar on instructions makes a statement which will continue till the hearing and final disposal of the suit that the Defendant Nos 1 to 3 have never used nor they intend to use the mark "eZscript-beyond imagination" or any other marks similar to it and that since July, 2024, the Defendant Nos. 1 to 3 have not been using the marks "Test Magic – Innovative Test Solutions" (device), "Robo Magic – an enterprise automation platform" and "eZAutomate" and do not intend to use the same.

3. The Plaintiff's case is that the Defendant No. 1 was carrying out proprietary business in the name and style of Universal Test Solution to develop automation platform which requires huge investment. The Plaintiff No. 2 and Defendant No. 1 executed Memorandum of Understanding dated 1st September, 2012 briefly outlining the modalities and terms and conditions. The broadly agreed terms were (a) formation of limited liability partnership under the common name Universal Test Solutions (b) the limited liability partnership formed

would take over the business of software development being carried out by Defendant No 1 in name of Universal Test Solution (c) patent right and other trademark of the software developed by Defendant No 1 would be introduced in the LLP and (d) any product of future development and ownership of any resultant intellectual property shall be property of LLP.

4. In accordance with the MOU, in or around 6th October, 2012, the Plaintiff No. 2 and Defendant No. 1 entered into limited liability partnership agreement dated 6th October, 2012 whereby the Plaintiff No. 1 was incorporated and registered under the name and style of M/s. Universal Test Solutions LLP. Subsequently, disputes arose between the parties and the Defendant No 1 was expelled from Plaintiff No. 1. Arbitration proceedings were invoked by the parties which culminated in the Award dated 31st July, 2019 which upheld the expulsion of the Defendant No. 1 from Plaintiff No. 1-LLP. Insofar as the dispute regarding IPR is concerned, the learned Arbitrator held that this dispute was beyond the jurisdiction of the Arbitrator.

5. It is stated that Plaintiff No. 2 is the registered proprietor of trade mark "UTS-Universal Test Solutions with the device of world" (label), and "UTS Global Software House" (label). Since incorporation of Plaintiff No. 1 in or around 4th October, 2012, the Plaintiff No. 1 has been using the trade mark cum trade name "Universal Test Solutions"

and "UTS". Since its inception, the Plaintiff No. 1 registered and was using the domain name www.uts-global.com containing the trade name "UTS" as its leading, essential and memorable feature. The Defendant No. 2 also opened an account and was maintaining and utilizing not only the domain name www.uts-global.com, but also services of Drive HQ registered in name of Defendant No. 2 instead of Plaintiff No. 1 in collusion with Defendant No. 1. The cost to maintain the said domain name, annual renewal fees were borne by the Plaintiff No. 1.

6. The web-based software marketed under the Plaintiff's registered trade mark was developed entirely by Plaintiff No. 1 out of the funds infused by Plaintiff No. 2 which is evidenced from the employment contracts entered between the employees and Plaintiff No. 1. The contracts between the Plaintiff No. 1 and its customers was signed by Defendant No. 1, at the relevant time as the partner of Plaintiff No. 1, which clearly acknowledged that the software is owned by Plaintiff No. 1. The software of the Plaintiff No. 1 and its source code/computer programme are original artworks within the meaning of Copyright Act, 1957 and the Plaintiff No. 1 is the owner of the copyright in various computer programmes.

7. The Plaintiff has produced the statement of annual figures of the amounts expended in promoting, selling software products and services of the Plaintiff No. 1 under the registered trade mark and

trade name Universal Test Solutions and UTS for the period 2014-2016 duly certified by Chartered Accountant.

8. It is stated that the Defendant No. 1, 2, 4 and 6 and certain unknown persons registered a company under the trade name ODC Universal Technology Solutions Private Limited and ODC Universal Technology Solutions LLP incorporating the trademark/trade name- Universal Technology Solutions which is similar and identical to the trade name Universal Test Solutions and are using the domain name www.uts-global.com". The Defendant Nos 1 and 2 and certain unknown persons are using and marketing the Plaintiff No 1's software indulging in piracy of software.

9. The Defendants have uploaded the domain video of software on Youtube which clearly establishes that the software being used and marketed by Defendant and downloaded/installed in the server of clients is the same as developed by Plaintiff No 1 and is being marketed under the impugned trade marks clearly infringing the Plaintiff's registered trade mark.

10. The Affidavit-in-reply on behalf of Defendant Nos. 4 and 6 state that Defendant No. 4 is the director of Defendant No. 3 whereas Defendant No. 6 is the ex-director of Defendant No. 3-company and was a designated partner of Defendant No. 5-LLP which is now dissolved and struck-off. It is stated that the Defendant No. 6 has been

impleaded as one of the incorporators of Defendant No. 3 whereas the Defendant No. 6 has since resigned from the post of Director in 2021. It is stated that Defendant No. 5-LLP has been dissolved and struck off from the records. It is stated that there is no averment that Defendant Nos. 4 and 6 have ever entered into any transaction/contract in their personal capacity which has led into infringement of Plaintiff's right in their trade mark and therefore, no injunction can be granted against Defendant Nos. 4 and 6.

11. The Defendant Nos. 1 to 3 by their Affidavit-in-reply contends that the Defendant No 1 is the rightful owner of the trade mark registered under No 2065575. The invoices produced on record are raised internally amongst the concerns owned by Plaintiff No. 2 to create false impression of alleged activity of user. The domain name www.uts-global.com is owned by Defendant No 2. It is pleaded that the Plaintiff's mark "UTS- Universal Test Solutions with the device of world' vs "UTS", "Universal Technology Solutions" and "ODC Universal Technology Solutions" are significantly different and the phrase Universal Technology Solutions is different from the term used by the Plaintiff. The Defendant's use of the terms "UTS" and "Universal Technology Solutions" is honest and descriptive reflecting the nature of their business. The term "UTS" is acronym commonly used across the industries and lacks inherent distinctiveness. The Defendants have

been using their mark for substantial period from 2016. There is no evidence produced on record to substantiate the Plaintiff's claim of extensive goodwill and reputation in the usage of their mark. The objection to jursidction was raised as no business is conducted within the jurisdiction of this Court.

12. It is further pleaded that the Plaintiff's reliance on the so called code does not establish any similarity in the source code allegedly used by the present Defendants. The Defendant No. 2 has continuously maintained and paid for the domain name "uts-global.com" since 2009 and no part of the alleged source code have ever been uploaded, distributed or displayed through this domain.

13. Insofar as the passing-off is concerned, the Plaintiffs have not demonstrated any reputation and goodwill associated with the alleged mark, there is no misrepresentation by the Defendant Nos. 1 to 3 and there is no evidence of any actual or likely damage to Plaintiff's reputation and goodwill.

14. In the Affidavit-in-rejoinder, insofar as the claim of ownership by Defendant No. 2 to the domain name "uts-global.com" is concerned, it is pleaded that the payments made by Defendant No. 2 were reimbursed by Plaintiff No. 1, which is evident from the arbitration award. The software being used by the Defendant is the same software being used by Plaintiff No. 1. The trade mark bearing No

2065575 has lapsed as it was not renewed. The Defendant Nos 1 to 3 are using the marks UTS or Universal Technology Solutions as trade marks and not to describe their business. It is denied that domain name www.uts-global.com was used by Defendant Nos. 1 to 3 as the company itself was incorporated in 2016 and Defendant No. 2 was never part of the Plaintiff No. 1 in any official capacity.

15. Mr. Andhyarujina, learned Senior Advocate appearing for Plaintiff has taken this Court through the terms of the MOU dated 1st September, 2012 to contend that immediately on execution of MoU, the Plaintiff No. 1 acquired ownership of all rights in the software developed by Defendant No. 1 including the trade mark. He submits that the Plaintiff No. 1 is the registered owner of the trade mark "UTS-Universal Test Solutions with device of world" (label) and the Plaintiff's trade mark "Test Magic" is also linked to www.uts-global.com with "UTS" being leading and essential feature. He submits that the acronym UTS is used by the Plaintiff since the year 2012 and is essential feature of its trade mark. He submits that the TestMagic software and its source code belongs to Plaintiff No. 1 and is marketed under the Plaintiff No. 1's registered trade mark and points out the extracts of the source code appended to plaint at page 384-385 and screenshots of the demo video appended at page 386-387. He submits that the conduct of the parties show that all parties proceeded on the basis

that the software and trade marks are owned by LLP evident from the employment contracts, business alliance agreement and the invoices. He would further submit that the learned Arbitrator has observed in the Award that the software test magic was shown as the asset of LLP.

16. He would submit that the Defendants without any authorization are operating the business of software by using the Plaintiff No. 1-LLP name. He submits that the trade name ODC Universal Technological Solutions Private Limited and ODC Universal Technological Solutions LLP uses the trade mark/trade name "Universal Technological Solutions" which is deceptively similar to the Plaintiff's trade mark "Universal Test Solutions". He submits that the Defendants are also carrying on business by using the acronym "UTS" and identical domain name. He submits that Defendant No. 2 had opened an account and was maintaining and utilizing not only the domain name www.uts-global.com but also services of Drive HQ registered in his personal name which account was part of asset of Defendant No 1 and was to be transferred to Plaintiff No 1. He submits that the cost relating to domain name was borne by the Plaintiff No. 1 and the Plaintiff No. 1 has done substantial business through the said domain name.

17. He submits that the defense of acquiescence is not available in the absence of any positive act of Plaintiffs encouraging the Defendant's business. He submits that the Defendants are estopped

from contending that the trade mark is descriptive or common or generic when the Defendants themselves had applied for registration of the mark. He would further submit that continuous infringement gives rise to recurring cause of action. In the written submissions, reference is made to the decisions in the case of:

Bal Pharma Ltd. vs. Centaur Laboratories Pvt. Ltd.[1]

Renaissance Hotel Holdings Inc. vs. B. Vijaya Sai[2]

Raj Kumar Prasad vs. Abbott Healthcare Pvt. Ltd.[3]

Corza International and Others. vs. Future Bath Products Pvt. Ltd.[4]

Abdul Rasul Nurallah Virjee and Jalalluddin Nurallah Virjee vs. Regal Footwear[5]

Vintage Distillers Limited vs. Ramesh Chand Parekh[6]

Peps Industries Private Limited vs. Kurlon Ltd.[7]

Sunil Mittal vs. Darzi on Call[8]

Pidlite Industries Ltd. vs. Jubilant Agri and Consumer Products[9]

M/s. Bengal Waterproof Limited vs. M/s. Bombay Waterproof Manufacutring Company[10]

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1 2002 (24) PTC 226 (BOM)
2 (2022) 5 SCC 1.
3 FAO(OS) 281/2014 DHC.
4 FAO(OS) (Comm) 2/2023.
5 2023 SCC OnLine Bom 10.
6 2022:DHC:004894.
7 FAO (OS) (Comm) 94/2020.
8 2017 (70) PTC 346 (Delhi)
9 2014 (57) PTC 617 (Bom)
10 AIR 1997 SC 1398

and the decision of ***Mrs. Rajnish Aggarwal and Others vs. M/.s. Anantam***[11] was physically handed over.

18. Mr. Khandekar, learned counsel appearing for Defendant Nos 1 to 3 submits that it is not the case of Plaintiffs that the domain name stood transferred to them by operation of MoU and even reading of the MoU does not make out any such case. He submits that the Exhibit-M of the plaint contains multiple entries which clearly demonstrate that the domain name stood registered in Defendant No. 2 and renewals were effected by him. He submits that the domain name has been registered in the name of Defendant No. 2 and has been maintained out of his own funds and was never the subject-matter of any transaction between the parties. He submits that a new case is tried to be introduced in rejoinder that the payment made by Defendant No. 2 was allegedly reimbursed by the Plaintiff.

19. He would further submit that the Plaintiffs have failed to plead or *prima facie* establish any copyright infringement in software or source code as no details about the Plaintiff's software is given nor any comparison with Defendant's software to show infringement and as to which portion of Defendant's source code is said to have been copied.

20. He would further submit that insofar as the corporate name of Defendant No 3 is concerned, i.e. ODC Universal Technological

11 2009 SCC OnLine Del 3827

Solutions Private Limited, the Defendant No. 3's corporate name is structurally, visually and conceptually distinct from the mark Universal Test Solutions and the ingredients of Section 29(5) of Trade Marks Act, 1999 are not satisfied.

21. He would further submit that the mark for which the Plaintiff's claim proprietorship i.e. Universal Test Solutions was being used by Defendant No. 1 prior to entering into MoU and trade name Universal Test Solutions was not transferred by virtue of MoU. He submits that in any event, the MoU was executed in limited context and did not operate as assignment or transfer of intellectual property. He would further submit that the MoU was preliminary and transitional document which did not effectuate any transfer of IPR and was enforceable contract. He submits that the MoU cannot be construed as document of vesting of intellectual property as formal instrument of assignment was required to be effected.

22. He would submit that no case for infringement or passing-off is made out as the Plaintiffs have failed to establish enforceable goodwill for passing-off on the date when the Defendants commenced the impugned use. He further submits that the Plaintiffs are guilty of unexplained delay which would deny them any interim relief. He would further submit that this Court has no jurisdiction to entertain the matter as the Plaintiff's assert that the part of cause of action has

arisen out of territorial jurisdiction and there is no leave sought under Clause XII or Clause XIV of Letters Patent (Bombay). In support, he relies upon the following decisions :

> ***Satyam Infoway Ltd. vs. Siffynet Solutions (P) Ltd.***[12]
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> ***Eicore Technologies Pvt. Ltd. vs. Eexpedise Technologies Pvt. Ltd.***[13]
>
> ***Sarine Technologies Ltd. vs. Diyora and Bhandari Corporation***[14]
>
> ***Chemco Plastic Industries Pvt. Ltd. vs. Chemco Plast***[15]
>
> ***Mangalam Organics Ltd. vs. N Raga Rao and Sons Pvt. Ltd.***[16]
>
> ***Exegis Infotech (India) Pvt. Ltd. vs. Mediamanage Insurance Broking Pvt. Ltd.***[17]
>
> ***Uniply Industries Ltd. vs. Unicorn Plywood Pvt. Ltd.***[18]
>
> ***H. L. and D. Ltd. vs. C. B. Co. Op. H. S. Ltd.***[19]
>
> ***Maganlal Savani vs. Multi Screen Media Pvt. Ltd.***[20]
>
> ***Lord Inn Hotels and Developers Pvt. Ltd. vs. Vikas Seth, trading as Lords Residency, Manali***[21]

23. Learned counsel for Defendant Nos. 4 and 6 seeks deletion and

12 (2004) 6 SCC 145.
13 CS (Comm) No. 1146/2018, decided on 4th September, 2023.
14 2017 SCC OnLine Guj 2200.
15 2025 SCC OnLine Bom. 4896.
16 2025 SCC OnLine Bom 3017.
17 2015 SCC OnLine Bom 3797.
18 MANU/SC/0315/2001.
19 2014(3) Mh. L. J. 376.
20 2016 SCC OnLine Bom 10472.
21 IA NO. 190 of 2025 in COMIP No. 247 of 2024, decided on 5th March, 2025.

submits that no reliefs are sought against them and they are impleaded in their personal capacity. He submits that in the year 2021, the Defendant No 5 LLP was struck off from the records and the Defendant No 4 has resigned from Defendant No 3 company. On instructions, he makes a statement that none of the infringing activities are being carried out by Defendant No 4 and 6 and none of the marks are used or will be used by the Defendant nos 4 and 6.

24. Rival contentions now fall for determination.

25. The statement made by Mr. Khandekar, on instructions, are accepted as undertaking given to this Court. The statement about discontinuation by the Defendant Nos 1 to 3 of the trade marks "Test Magic-Innovative Test Solutions" device, "Robo Magi- An Enterprise Automoation Platform" (device), "ezAutomate" considerably narrows down the marks of which infringement is claimed and restricts the scope of inquiry as to infringement of domain name "www.uts-global.com/ utsglobal", infringement of the Plaintiff's trade mark by use of the corporate name of Defendant No 3 i.e. "ODC Universal Technological Solutions Private Limited", UTS and copyright infringement by use of the Plaintiff's software and source code. In view of the narrow confine of the inquiry to trade mark vs trade name, it is not necessary to deal with the decisions cited in context of trade mark vs. trade mark infringement.

26. The contest is between the Plaintiff's mark UTS- Universal Test Solutions with the device of World, its domain name www.uts-global.com vs the Defendant No 3's corporate name- ODC Universal Technological Solutions Private Limited and domain name www.uts-global.com.

27. There is a specific pleading that the Defendant No. 5-ODC Universal Technology Solutions LLP is struck off from the records of the register of firms. There is thus no issue of infringement of the Plaintiff's trade mark by the tradename of Defendant No 5.

28. Dealing first with the issue of infringement of domain name www.uts-global.com, the case of infringement is premised on the ground that the impugned domain name uses the word "**uts**" which forms the essential feature of the Plaintiff's registered mark UTS-Universal Test Solutions with the device of world and since its inception in the year 2012, the Plaintiff No 1 is using the domain name www.uts-global.com. In this context if the plaint is perused, paragraph No. 15 of the Plaint specifically pleads that the Defendant No. 2 had also opened an account and was maintaining and utilizing the domain name which was registered in his personal name in collusion with Defendant No. 1 and the cost to retain the domian name, annual renewal fees and maintenance cost was borne by the Plaintiff No 1.

29. It is therefore the Plaintiff's own case that the domain name

was registered in the name of Defendant No. 2, though, alleged to have been so registered with the collusion of Defendant No 1. In the Affidavit-in-rejoinder, it is pleaded that the Defendants cannot claim rights in the domain name merely because it was purchased by Defendant No. 2 in his name.The pleadings constitutes an admission of the domain name being registered in personal name of the Defendant No 2. It is not the Plaintiff's case that by virtue of MoU or LLP Agreement, the domain name stood transferred to the Plaintiff No 1. Apart from the same, there is no material to demonstrate that the domain name constituted an asset of Defendant No. 1 and therefore, there is no question of considering whether under the MoU, the domain name was transferred to Plaintiffs.

30. It is the specific case of the Defendant Nos 1 to 3 in paragraph 24 of the reply affidavit that the Defendant No. 2 has continuously maintained and paid for the domain name "uts-global.com" since the year 2009. The document annexed at Page 320 of the plaint shows registration of the domain name uts-global name on 22nd February, 2010 in the nameof Defendant No 2. The billing invoice at Page 323 of the domain name is in the name of the Defendant No 2. The credit card statements show payment in respect of the domain name are stated in the name of the Defendant No 2. In response to paragraph 24 of the reply affidavit, in rejoinder, it is not denied that the payments were

made by Defendant No. 2 and the Plaintiffs sought to improvise its case by pleading that the Defendant No. 2 was duly reimbursed for the same. The case of reimbursement is bare pleading unsubstantiated by any document on record.

31. The MoU/LLP arrangements were admittedly between the Plaintiff and Defendant No 1 and in so far as the Defendant No 2, who is the husband of Defendant No. 1, is concerned, the case is that in or about the year 2014, the Plaintiff No 1 had formed Universal Test Solutions LLC in the UAE for carrying out marketing of Plaintiff No 1's software in which Defendant No 2 was inducted as partner. There is no case pleaded of transfer of the domain name by the Defendant No 2 to Universal Test Solutions LLC and the said entity is not a party to these proceedings. *Prima facie* the material placed on record shows creation and registration of the domain name using the word "**uts"** in the name of the Defendant No 2 on 22nd February, 2010 prior to the use of the Plaintiff No 1 which was constituted on 4th October, 2012.

32. The Plaintiff's trade mark is "UTS-Universal Test Solutions with device of world" which is label mark comprising of the word "UTS" depicted in an elongated circle with the words "Universal Test Solutions" written below the elongated circle followed by the words ROI Simplified against the background of the world. The Plaintiff's claim that the word "UTS" is the label mark's leading and essential

feature. The registration certificate appended to the Plaint shows that the mark has been registered in the name of the Plaintiff No. 2 on 12th April, 2017 which registration relates back to the date of the application on 26th July, 2016 in class 9 and the second registration on 14th April, 2017 relating back to the date of application on 26th July, 2016 in class 42. The registration of the Plaintiff's trade mark is therefore, subsequent to the registration and use of the Defendant No. 2 of the domain name comprising of the word "**uts".** Even accepting that the word "UTS" is an acronym of the Plaintiff No. 1's trade name "Universal Test Solutions", it needs to be noted that the Defendant No 1 was already trading in the name of Universal Test Solutions. There is *bona fide* explanation for adoption of the domain name bearing the words "uts" as the Defendant No 2 is the husband of Defendant No 1. As the material on record *prima facie* demonstrates prior use and registration of the domain name by the Defendant No 2 and *sans* any material to show that the domain name was transferred to the Plaintiffs or the expenses incurred by the Defendant No 2 in respect of the domain name were reimbursed to the Defendant No 2, no proprietary right can be claimed by the Plaintiffs in the domain name and the prior user constitutes valid defense under Section 34 of Trade Marks Act, 1999.

33. In so far as the use of deceptively similar mark by the Defendants

on their website which is demonstrated at Pages 467, 468 and 469 of the plaint is concerned, perusal of the extracts show the use of device of world deceptively similar to the device of world of the Plaintiff's registered mark. It is pleaded in the plaint that the Defendants have altered their website by amending the UTS logo with device of world which is demonstrated from page 533 of the plaint, which diffuses the claim of infringement by use of device of world.

34. Dealing next with the issue of infringement of the Plaintiff's registered trade mark "UTS-Universal Test Solutions" with device of world (label mark) by use of the corporate name by Defendant No. 3-ODC- Universal Technological Solutions Private Limited, the case put up is of trade mark vs trade name. The infringement is governed under the provisions of sub-sections (5) of Section 29 of Trade Marks Act, 1999 which reads as under :

> **"(5)** A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered."

35. Sub-section (5) of Section 29 provides that trade mark is infringed by use of the registered trade mark by a person as his trade name or part of his trade name. The legislature has used different expressions in sub-sections (1) to (4) and in (5) of Section 29. The

ingredients of other sub sections of Section 29 cannot be imported in sub section (5) of Section 29, which operates in a narrow field. There is no question of application of deceptive similarity test and what is required to be demonstrated that the registered trade mark is used as trade name or part of the trade name. In the case of ***Chemco Plastic Industries Pvt. Ltd. vs. Chemco Plast*** (supra), this Court had the occasion to consider the distinction between sub-sections (4) and (5) of Section 29 of Trade Marks Act, 1999. The Co-ordinate Bench held that sub-section (5) governs the phrase trade mark vs. trade or business name and proscribes infringement of trade mark by making use of the same in the trade or business name, while dealing in goods or services in respect of which the trade mark is registered. It noted the decision of the Hon'ble Full Bench of this Court in the case of ***Cipla Limited vs. Cipla Industries Pvt. Ltd., Delhi***[22] where the Hon'ble Full Bench held that Section 29(5) applies to the trade mark/business name/situation.

36. The Defendant No 3's corporate name is "ODC Universal Technological Solutions Private Limited", whereas the Plaintiffs trade mark is "UTS-Universal Test Solutions". The plaint pleads that the word "uts" is prominently displayed and that the word "uts" and "Universal Test Solution" are the essential and leading feature of the Plaintiff No 1's trade mark. Section 29(5) requires the exact use of the registered

22 2017 SCC OnLine Bom 6791.

trade mark as trade name or part of trade name. The dominant feature test if applied to infringement action under Section 29(5), would constitute application of test of deceptive similarity thus importing the ingredients of sub section (1) to (4) into sub section (5) of Section 29. The Defendant No 3's corporate name does not use the Plaintiff's trade mark as part of its trade name. The contention that by use of the words "uts" as part of domain name and email address, Section 29(5) gets attracted is unacceptable in view of the discussion above that the domain name is registered in name of Defendant No 2 prior to the use by the Plaintiff No 1. The ingredients of Section 29(5) are *prima facie* not satisfied in the present case.

37. Coming to the issue of copyright infringement in the software or source code, the Plaintiff has pleaded that that the software developed by Defendant No 1 was very rudimentary and nascent while the final software version developed by the Plaintiff No 1 and its employees was complete, highly efficient and thoroughly intuitive. It is stated that the web- based software marketed under the Plaintiff's registered trade mark as well as the source code are developed entirely by Plaintiff No. 1 in which the copyright subsists in favor of the Plaintiff.

38. Section 2(o) of Copyright Act, 1957 defines literary work to include computer programes, tables and compilations including

computer databases. Section 13 (1) (a) provides that copyright shall subsist in the original literary work and under Section 14(b) in case of computer programme, copyright means an exclusive right to reproduce the work in any material form, issuing copies and to sell or give on commercial rental or offer for sale or for commercial rental any copy of computer programme. The case of infringement as pleaded is that the copyrighted software and source code is being used by the Defendants illegally without any license or authorization from the Plaintiffs. The case thus is of unauthorised access and commercial exploitation of the copyrighted software and source code by the Defendants through its domain. The pleadings on the aspect of piracy are lacking in material particulars and constitute bare assertions. The pleadings concentrate on the manner of development of the software and source code by the Plaintiffs out of their funds and through their employees to assert its ownership in copyright. Even accepting the Plaintiff's copyright in the software and source code, it is necessary for the pleading of piracy to be substantiated by placing material on record for this Court to come to a *prima facie* finding of piracy of software. In cases where the claim is of copyright infringement of computer programme, it is necessary for the Plaintiff to seek appointment of an independent expert for the purpose of submitting a report on comparison of the Plaintiff's copyrighted software and source code with Defendant's software and

source code to demonstrate *prima facie* case of piracy. It cannot be disputed that the infringement of computer programme involving a software and source code involve highly technical questions and without the assistance of expert report merely on the basis of screen shots of the demo videos uploaded by the Defendants, it is not possible for this Court to come to a *prima facie* finding of the piracy of software and source code. It also does not help that there is no identified description of the software, which has been developed by the Plaintiffs and juxtapositioning the same with the Defendant's software for the purpose of *prima facie* comparison even by this Court. There were no submissions canvassed sufficient to arrive at finding of copyright infringement.

39. In light of the above *prima facie* finding that there is no infringement under Section 29(5) of Trade Marks Act, 1999 by use of the Defendant's trade name "ODC Universal Technological Solutions Private Limited", it is not necessary to deal with the nature and character of the MoU, as to whether there was transfer of Universal Test Solutions to the Plaintiff No 1 under the MoU or of intellectual property rights. Coming to the issue of passing off, the Defendant's case is of non user of the mark since the year 2016, which is responded by stating that non user cannot be used as defence for infringement. The aspect of non user of the mark *prima facie* constitutes absence of

goodwill and reputation relevant to the action of passing-off. The classical trinity test requires the Plaintiffs to prove (a) goodwill and reputation (b) misrepresentation and (c) damage to the goodwill and reputation. The Plaintiff is required to show existence of goodwill and reputation on the date when Defendant commenced the impugned use, which would not be available in case of non user of the mark. To demonstrate goodwill and reputation, the Plaintiffs have placed on record invoices at Pages 398 to 418 of the plaint. The invoices at Pages 398 to 406, 416 to 418 are of the year 2022 and issued to Richway OPC Private Limited and India Auto Works LLP. The invoices from pages 407 to 415 pertains to the year 2013 to 2015, which are in all six invoices and there is one purchase order at Page 419. The certificate of chartered accountant at pages 465 certifies the expenses towards marketing, promotion and development of software and does not certify that the expenses were incurred towards the development of software marketed under the registered trade mark. It is erroneously pleaded in the plaint that the document at Exhibit "T" is the annual income of the Plaintiff No 1 in respect of its business under the registered trade mark, whereas perusal of Exhibit "T" which is at Page 466 shows that the said certificate is not the annual statement of sales/income of Plaintiff No 1 but the same document which is annexed at Page 465 certifying the promotional and marketing

expenses. *Prima facie* there is no sales turnover placed on record, the invoices are sporadic and does not demonstrate enormity of use of the trade mark to assess the goodwill and reputation. It is pleaded by the Defendant Nos 1 to 3 that the invoices have been raised internally among the entities/concerns owned or controlled by the Plaintiff No 2 and are created. The rejoinder does not dispute this fact. The material produced on record is insufficient to make out a case of goodwill and reputation of the Plaintiff No 1 in respect of the registered trade mark. As the infringement is claimed by reason of use of the corporate name by the Defendant No 3, it must be pleaded and demonstrated that the Defendant No 3 has intentionally or unintentionally projected its services as that of the Plaintiff No 1. There is no such *prima facie* case of misrepresentation made out by the Plaintiffs. As the goodwill and reputation is not demonstrated there is no question of causing any damage. The Plaintiffs have thus failed to make out *prima facie* case of passing off against the Defendants.

40. In light of the above discussion, the Plaintiffs have failed to make out a *prima facie* case for grant of injunction.

41. Resultantly, Interim Application stands dismissed.

[Sharmila U. Deshmukh, J.]