

**Legal Issues in ‘Doctrine of estoppel / Prosecution history estoppel’**

**Issue: Whether prosecution history estoppel bars a party from taking a contrary stand in a trademark infringement suit?**

## Relevant Legal Provisions

- *Section 115 of Indian Evidence Act, 1872 / Section 121 of The Bharatiya Sakshya Adhiniyam, 2023*

*“Estoppel - When one person has, by his declaration, act or omission, intentionally caused or permitted another person to believe a thing to be true and to act upon such belief, neither he nor his representative shall be allowed, in any suit or proceeding between himself and such person or his representative, to deny the truth of that thing.”*

## Relevant Judicial Decisions

- ❖ **H and M Hennes and Mauritz AB and Ors. vs. HM Megabrands Pvt. Ltd. and Ors. [2018:DHC:3620, Delhi High Court, Judgement dated May 31, 2018]**

15. *“The plea of the defendants that the plaintiffs, at the time of seeking registration and when confronted with 'HMT', 'HMTV', 'HMTW', 'H.M. Tex Kamal' and 'H.M.C, having taken a stand that the mark has to be considered in entirety, may be considered at this stage. The question to be adjudicated is, whether the plaintiffs, having taken such a stand, is estopped from suing for infringement. The question, in my opinion, cannot be answered in abstract and has to be answered on facts. None of the businesses, marks whereof as aforesaid the plaintiffs were confronted with, were in any business even remotely connected to business of the plaintiffs. In fact, the marks HMT & HMTV were abbreviations of their earlier names Hindustan Machine Tools and His Masters Voice respectively and which businesses, over the years had come to be referred by their abbreviation. **Merely because the plaintiffs at the stage of seeking registration took a stand as aforesaid, cannot stop the plaintiff from exercising its statutory and natural rights. There is no estoppel against statute.**” (emphasis supplied)*

## Relevant Judicial Decisions (contd.)

- ❖ **Telecare Network India Pvt. Ltd. Vs. Asus Technology Pvt. Ltd. and Ors. [2019:DHC :2889, Delhi High Court, Judgement dated May 28, 2019]**

*“POST GRANT OF REGISTRATION OF THE MARK NEITHER THE EXAMINATION REPORT NOR THE REPLY TO THE SAME ARE RELEVANT DOCUMENTS FURTHER THERE IS NO ESTOPPEL AGAINST STATUTE.*

*41. Once a mark is registered, the certificate of registration has to be seen as it is. Post grant of registration of the mark ZEN, neither the Examination Report dated 01st May, 2010 nor the plaintiff's reply are relevant documents.*

*42. In any event, as there is no estoppel against statute, the stand taken by plaintiff in reply to the examination report is not relevant. THERE IS NO SUPPRESSION OR MISREPRESENTATION THAT REGISTERED MARKS ZEN AND ZENMOBILE ARE WORD MARKS AS THE PLAINTIFFS HAD PLACED ON RECORD THE REGISTRATION CERTIFICATES. FURTHERMORE, THE PLAINTIFF HAD NOT SUPPRESSED ITS REPLY TO THE EXAMINATION REPORT DATED 01ST MAY 2010 AS THE SAME IS AVAILABLE IN THE PUBLIC DOMAIN.” (emphasis supplied)*

## Relevant Judicial Decisions (contd.)

### ❖ **Insecticides (India) Limited Vs. Parijat Industries (India) Pvt. Ltd. [2018:DHC :3972, Delhi High Court, Judgement dated July 09, 2018]**

*“(N) The question which arises is, whether on account of the plaintiff in the letter dated 3rd March, 2015 having stated that "goods in relation the mark subject matter for registration is altogether different from the goods in relation to the trademark cited in the examination search report" and "comes in no conflict and suited for registration", is estopped from suing the defendant for injunction against passing off.*

*(R) In my opinion, the plaintiff cannot be so bound and estopped. The applications of the plaintiff were in Class 05 "in respect of insecticides, weedicides, herbicides, fungicides and preparations for destroying vermin included in Class 05" and the cited mark 'VICTOR 80' of the defendant was mentioned as for "pesticides included in Class 05";*

*(S) What the Advocate for the plaintiff stated in the letters, in view of the aforesaid, was clearly contrary to the statute i.e. the classification of goods in Schedule IV to the Rules supra...Thus, the representation of the plaintiff, on the basis whereof the plea of estoppel is raised by the defendant, being contrary to Statute, does not give rise in law to the plea of estoppel.”*

## Relevant Judicial Decisions (contd.)

- ❖ **AMPM Designs Vs. Intellectual Property Appellate Board (Mumbai Bench) and Ors. [2021(88)PTC 338(Bom)], Bombay High Court, Judgement dated October 29, 2021]**

29. *“The inconsistency in the stand of the petitioner as regards the similarity of the marks comes to the fore. In any event, the claim of the petitioner that the mark of respondent No. 3 is deceptively similar to that of the petitioner, could not have been construed against the petitioner as there can be no estoppel against law.”*

32. *“There can be no qualm over the position in law that an erroneous admission on a principle of law by a party would have no relevance in determining the rights and liabilities, for cannot an estoppel against a statute. In this case, the stand of the petitioner as regards the similarity of the mark differed at different stages of the proceedings. In response to the examination report, the petitioner claimed that the marks were dissimilar. Whereas in the notice of opposition, to the application of respondent No. 3 for registration of the latter's mark under Class-42, the petitioner claimed that respondent No. 3's mark was deceptively similar to that of the petitioner. Evidently; after the petitioner's mark was registered, the petitioner took the stand that the proposed mark of respondent No. 3 is deceptively similar to that of the registered mark of the petitioner. In any event, this aspect does not bear upon the core controversy except reflecting upon the litigative conduct of the petitioner.” (emphasis supplied)*

## Relevant Judicial Decisions (contd.)

❖ **Raman Kwatra and Ors. Vs. KEI Industries Limited [2023:DHC:83, Delhi High Court, Judgement dated Jan 06, 2023]**

43. *“We also find merit in the appellant's contention that a party, that has obtained the registration of a trademark on the basis of certain representation and assertions made before the Trade Marks Registry, would be disentitled for any equitable relief by pleading to the contrary. The learned Single Judge had referred to the decision in the case of Telecare Networks India Pvt. Ltd. v. Asus Technology Pvt. Ltd. (supra) holding that after grant of registration neither the Examination Report nor the plaintiff's reply would be relevant. We are unable to agree with the said view. In that case, the Court had also reasoned that that there is no estoppel against statute. Clearly, there is no cavil with the said proposition; however, the said principle has no application in the facts of the present case. A party that has made an assertion that its mark is dissimilar to a cited mark and obtains a registration on the basis of that assertion, is not to be entitled to obtain an interim injunction against the proprietor of the cited mark, on the ground that the mark is deceptively similar. It is settled law that a person is not permitted to approbate and reprobate. A party making contrary assertions is not entitled to any equitable relief.” (emphasis supplied)*

## Relevant Judicial Decisions (contd.)

### ❖ **Shantapa Vs. Anna [2024(2)BomCR518, Bombay High Court, Judgement dated October 29, 2021]**

37. *“Having made a representation for securing registration of its Marks that the same does not resemble the Defendant's Mark, the issue is whether Plaintiff can now be estopped from seeking injunction against Defendant from using its Mark . To paraphrase, whether Plaintiff's stand while securing registration of his Marks would now continue to haunt him in passing off action initiated against Defendant?”*

38 . *“The doctrine of prosecution history estoppel predominantly used in patent infringement actions is now being increasingly applied to trademark infringement actions as well. By now there is plethora of precedents about applicability of the doctrine to trademark infringement and passing off actions, to which a reference is being made little later. **The doctrine of prosecution history estoppel seeks to estop a person from claiming any advantage associated with a right which he has consciously waived in previous proceedings. It essentially emanates out of the doctrine of estoppel laid down under Section 15 of the Indian Evidence Act, 1872”***

32. *Hence, this Court is of the opinion that the **principle of prosecution history estoppel is correctly invoked by the defendant in the present case. The plaintiff cannot successfully claim discretionary reliefs in the backdrop of such conduct.**” (emphasis supplied)*



## Relevant Judicial Decisions (contd.)

❖ **PhonePe Private Limited v. Resilient Innovations Private Limited [2023:BHC-OS:2477, Bombay High Court, Judgement dated April 06, 2023]**

17. *“Having heard the elaborate submissions made on behalf of the rival parties, this Court is of the opinion that two major aspects viz., the effect of the earlier legal proceedings and prosecution history estoppel need to be dealt with first.*

28 *“...prosecution history estoppel assumes significance. The plaintiff is not justified in contending that once it has obtained registration for its trademark, the stand taken on its behalf in proceedings leading upto grant of such registration cannot haunt the plaintiff in subsequent legal proceedings..”*

9

32. *“Hence, this Court is of the opinion that the principle of prosecution history estoppel is correctly invoked by the defendant in the present case. The plaintiff cannot successfully claim discretionary reliefs in the backdrop of such conduct.”*  
(emphasis supplied)

## Relevant Judicial Decisions (contd.)

❖ **Vasundhra Jewellers Pvt. Ltd. Vs. Vasundhara Fashion Jewellery LLP and Ors. [2023:DHC :4960, Delhi High Court, Judgement dated July 19, 2023]**

4.8. *“The plaintiff in its reply to the Examination report issued by the Trade Mark Registry in connection with the trade mark application no. 4169987 has admitted that the plaintiff's mark is not identical and/or deceptively similar to that of the defendant no.1...”*

28. *“In view of the aforesaid stand taken by the plaintiff, the plaintiff cannot take a contrary stand in the present suit to the effect that the mark of the defendant no.1 is deceptively similar to that of the plaintiff. The plaintiff cannot be permitted to approbate and reprobate. Reliance in this regard may be placed on the judgment in Raman Kwatra v. KEI Industries Limited.”*

*“Hence, the reliefs sought in the present suit are barred by principles of waiver, estoppel and acquiescence. there is no similarity and therefore, the same would not create any confusion in the minds of consumers when read as a whole.”*

## Conclusion

- ❖ “Prosecution history estoppel” is a known menace in trademark infringement suits, wherein parties used to take contrary stands in different forums. Time and again courts have interpreted Prosecution history estoppel in different ways, depending upon the facts and relevant background of the case.
- ❖ Some courts were of the view that since there can be no estoppel against law/statute, a party may take a different stand in the court of law as to what was originally taken during the prosecution stage. This is because in Trademark disputes issues like ‘deceptive similarity’, ‘consumer confusion’ etc., are mixed question of law and facts. The courts provided a leeway in some cases by not absolutely confining the Applicant to the statements made during the prosecution and take some context or error margin into account.
- ❖ However, lately, the courts are taking a stricter approach barring the parties from making a contrary claim owing to Prosecution history estoppel. This is primarily because the court don’t want to permit the parties to approbate and reprobate on a particular fact, which has been previously admitted. This approach also avoids frivolous litigations and is less time-consuming.

# THANK YOU!

## Questions?

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12

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