



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

**Reserved on: 31<sup>st</sup> July, 2024**  
**Pronounced on: 14<sup>th</sup> August, 2024**

+ **CS(COMM) 1550/2016**  
**LACOSTE & ANR.**

..... Plaintiffs

Through: Mr. Chander M. Lall, Senior Advocate  
with Ms. Nancy Roy, Ms. Prakriti  
Varshney, Mr. Prashant, Mr. Raghav  
Malik and Mr. Abhinav Bhalla,  
Advocates.

versus

CROCODILE INTERNATIONAL PTE LTD & ANR. .... Defendants

Through: Mr. Pravin Anand, Mr. Saif Khan, Mr.  
Shobhit Agrawal and Mr. Prajjwal  
Kushwaha, Advocates.

**CORAM:**  
**HON'BLE MR. JUSTICE SANJEEV NARULA**

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### **SANJEEV NARULA, J.**

1. In the competitive world of fashion, where symbols adorning our garments carry a unique allure, often conveying affluence, this Court is faced with a battle over iconic emblems that have transcended mere branding to become symbols of style and social standing. In this milieu, the critical question is whether there is space for two crocodiles, or does the presence of one spell trouble for the other?



## THE CONTROVERSY

2. Lacoste, Plaintiff No. 1, and their licensee in India, Sports and Leisure Apparel Ltd. [Plaintiff No. 2],<sup>1</sup> have initiated this lawsuit to protect their copyright and trademark rights in the device of a crocodile or a saurian “



,”<sup>2</sup> affixed on the clothing articles sold by them around the world, including in India. The parties have historically been engaged in legal tussles over their emblems in many jurisdictions. In the Indian territory, Lacoste seeks to restrain the Defendants – Crocodile International Pte Ltd., and their Indian counterpart, Crocodile Products Pvt. Ltd.,<sup>3</sup> from utilizing a



similar saurian device “ ,” appended as Annexure-A to the plaint,<sup>4</sup> on the apparels produced by them, alleging it to be a mirror image of Lacoste’s registered trademark. In contrast, Crocodile International maintains that Lacoste is breaching a previously agreed upon understanding regarding peaceful co-existence in the Asian countries, arguing for its extension to the Indian territory. Navigating through the complexities of trademark law in the backdrop of parties’ prior agreements, this judgment aims to discern whether these reptilian depictions on apparel are coincidental or a deliberate imitation by Crocodile International.

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<sup>1</sup> Collectively, “Lacoste.”


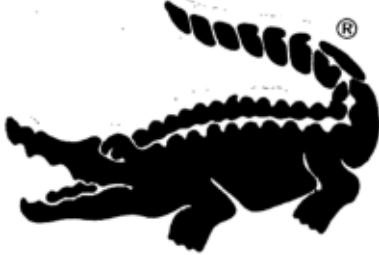
<sup>2</sup> The terms ‘crocodile’ and ‘saurian’ are being interchangeably used in the judgment to refer to the parties’ devices; the pleadings and issues describe it as a ‘crocodile’ device, while the submissions advanced mentioned a ‘saurian’ device.

<sup>3</sup> Collectively, “Crocodile International.”

<sup>4</sup> Interchangeably, “Annexure-A device” or “impugned mark.”



3. To contextualize the forthcoming narration of the dispute and subsequent findings, a comparison of the two conflicting saurian devices is illustrated below:

<i>Plaintiffs' mark</i>	<i>Defendants' mark</i>
	

**LACOSTE’S CASE IN BRIEF**

4. The facts of the case, as presented by Lacoste, are as follows:

4.1. Plaintiff No. 1-company is internationally acclaimed for their clothing articles adorned with the mark/ logo “LACOSTE” and a crocodile device. The company was founded by the renowned tennis player, Mr. Jean René Lacoste, famously regarded as ‘Le Crocodile’ for his victories at various national and international tennis championships between 1925 to 1928. In this time, Mr. Lacoste ventured into manufacturing of knitted shirts tailored for tennis and other sports players by partnering with Louis Emile André Gillier in 1931. The shirts manufactured by ‘René Lacoste & André Gillier’ were called Chemise Lacoste, and featured an embodied crocodile symbol on the front, which was crafted by Mr. Robert George and was first introduced in France in 1927. The first trademark filing in Troyes, France for this crocodile device dates back to 27<sup>th</sup> April, 1933 (under registration No. 207916). Similarly, the marks “LACOSTE” and “CHEMISE LACOSTE” were registered on 22<sup>nd</sup>





June, 1933 and 19<sup>th</sup> July, 1935 under registrations No. 287668 and 302681, respectively.

4.2. In India, the copyright in the artwork of crocodile device remains with Plaintiff No. 1. During the continuance of the instant proceedings, the artistic



work “ ” was registered in favour of Plaintiff No. 1 under No. 62692/2002, bolstering their rights in India under the provisions of the Copyright Act, 1957 and the Copyright (Amendment) Act, 1994. This ownership grants Plaintiff No. 1 the exclusive authority to reproduce the crocodile device in any material form and seek redressal against infringement of their copyright.

4.3. Plaintiff No. 1 is also the registered proprietor of the crocodile device and its formative variant in class 25, as detailed below:

<i>Trademark and No.</i>	<i>Application Date</i>	<i>Goods</i>	<i>User claimed</i>
 Under No.: 400265	19.01.1983	Clothing, including boots, shoes, and slippers	Proposed to be used
	19.01.1983	Clothing, including boots, shoes, and slippers	Proposed to be used




Under No.: 400267			
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4.4. By virtue of the above registrations, Plaintiff No. 1 possesses the exclusive statutory rights to use afore-noted trademarks in connection with the goods for which they are registered. These trademarks have been in extensive and open use in India since October 1993 through Plaintiff No. 2, and are now exclusively linked with the Plaintiffs. To substantiate this assertion, the plaint sets out the annual sales figures and promotional expenditures for the products bearing the “LACOSTE” mark and crocodile device, since 1993.

4.5. Defendant No. 1, operating under the name Crocodile International Pte Ltd., is a company based in Singapore. Defendant No. 2 is a joint venture associated with Defendant No. 1. Defendant No. 1 holds registrations for marks entailing the word ‘Crocodile’ along with a corresponding device. The Defendants commenced use of the said device in India sometime during the two years preceding the initiation of this suit (in 2001). More recently, they




have introduced the Annexure-A device – “,” which bears a deceptive and confusing similarity to Lacoste’s previously registered and





utilized “.” This recent adoption of a similar crocodile device by Crocodile International forms the crux of the present lawsuit. The impugned mark, which is affixed on pockets of shirts and t-shirts without the brand name ‘Crocodile,’ mirrors the manner in which Lacoste uses their



registered “” device, thus heightening the risk of consumer confusion.

4.6. Crocodile International has further complicated the matter by using the symbol ‘®’ alongside the Annexure-A device, despite lack of its independent registration, which constitutes misrepresentation. On 13<sup>th</sup> December, 1999, Plaintiff No. 1 formally requested Crocodile International to cease using the Annexure-A device in India in order to mitigate market confusion, which yielded no response. As the infringing activities continued, Plaintiff No. 1 addressed communications on 23<sup>rd</sup> January, 2001 and 06<sup>th</sup> March, 2001 to Defendant No. 1. However, Defendant No. 1 refused Plaintiff No. 1’s request, citing a Co-Existence Agreement dated 17<sup>th</sup> June, 1983.<sup>5</sup> According to Lacoste, this Agreement, whereunder Plaintiff No. 1 and Defendant No. 1 agreed to concurrent usage of certain trademarks in various territories, does not extend to India. Moreover, the 1983 Agreement does not authorize

Defendant No. 1 to use the device “” without the word/ mark “CROCODILE.” In contrast, the Agreement permits the use of crocodile device by Plaintiff No. 1. Significantly, on 22<sup>nd</sup> August, 1985, Defendant No. 1 themselves furnished a letter consenting to the registration and use of

crocodile device/ “” by Plaintiff No. 1 in India.<sup>6</sup> This underscores Crocodile International’s apparent disregard for Lacoste’s intellectual

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<sup>5</sup> “1983 Agreement.”


<sup>6</sup> “1985 Letter.”





property rights, thereby compelling the initiation of this legal action seeking a permanent injunction, restraining Crocodile International from further use

of “” device. This device is alleged to be deceptively and

confusingly similar to Lacoste’s registered “” device, thus constituting an infringement and passing off of the Plaintiffs’ registered trademarks. In addition to the injunctive relief, Lacoste also requests for ancillary reliefs, including an order for Crocodile International to provide access to their financial accounts for assessment of damages.

### **OVERVIEW OF CROCODILE INTERNATIONAL’S DEFENCE**

5. The version of facts elucidated by Crocodile International is as follows:

5.1. The “CROCODILE” trademark was originally devised, created, and adopted by Dato Dr. Tan Hian Tsin,<sup>7</sup> the founder of Defendant No. 1, in 1947 in Singapore. Since their inception in the same year, Defendant No. 1 has continuously and extensively used both the “CROCODILE” word and device marks, and is now an internationally renowned company, recognized for their superior quality products under the mark/ name “CROCODILE.” Defendant No. 1 has utilized the “CROCODILE” trademark and crocodile device, sometimes accompanied by other words or devices, across a diverse range of products, including articles of clothing, accessories, sports equipment, eyewear, travel ware, and timepieces.

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<sup>7</sup> “Dr. Tan.”



5.2. The “CROCODILE” trademark was first registered in Singapore in 1949, followed by registrations in several other countries, such as Malaysia, Indonesia, Japan, Korea, and India. In India, the trademark “



” was registered by Dr. Tan on 12<sup>th</sup> June, 1952 under No. 154397 in class 25 for shirts and singlets. This registration was subsequently assigned by Dr. Tan to Defendant No. 1 on 15<sup>th</sup> September, 1983. On 21<sup>st</sup> November, 1990, Defendant No. 1 applied for registration of the device “



” in class 25 under No. 540315 in respect of articles of clothing.

5.3. Defendant No. 1 executed a Technical Collaboration Agreement with one K.L. Narayansa and Associates (predecessors of Defendant No. 2) for commercial launch of products bearing the mark “CROCODILE” and the associated device. Consequently, Defendant No. 2 was incorporated on 21<sup>st</sup> April, 1994. Crocodile International’s products were introduced in Southern India in August 1998 by inaugurating showrooms styled as ‘Crocodile Galleries,’ following extensive advertisements through different media channels. These advertisements commenced in April, 1997, when Crocodile International issued a caution notice in newspapers that depicted the “CROCODILE” mark and device. Gradually, Defendant No. 2 expanded their business presence to other regions in the country. By virtue of their registration, extensive, long-standing, and uninterrupted use, coupled with significant investments in advertising and promotions, Crocodile



International has acquired absolute and exclusive rights to the “CROCODILE” mark and device, particularly the Annexure-A device.

5.4. Historically, Lacoste and Crocodile International have operated within their respective territories. However, when Plaintiff No. 1 attempted to expand their market presence into Asian countries, they encountered the established domain of Defendant No. 1. In 1971, upon initiating business operations in Japan, Plaintiff No. 1 faced legal action from Defendant No. 1, who challenged their use of the mark before the District Court of Osaka, Japan. In the said proceedings, Plaintiff No. 1 argued that their mark, which includes both a crocodile device and the word “LACOSTE,” was distinct and easily distinguishable, emphasizing that “LACOSTE” had no conceptual link to a crocodile. The Court ruled in favour of Plaintiff No. 1 and concluded that there was no possibility of confusion or deception between the marks. Consequently, Defendant No. 1’s claim was dismissed.

5.5. On 16<sup>th</sup> July, 1980, Defendant No. 1, through their attorneys, issued a cease-and-desist notice to Plaintiff No. 1’s licensee, Royal Sporting House, demanding that they must discontinue the use of their crocodile device in Singapore. In response, the licensee, acting for Plaintiff No. 1, engaged in negotiations with Defendant No. 1 and proposed a financial settlement to resolve the legal disputes over the use of the crocodile device mark by them. This initial engagement led to further correspondence, where on 21<sup>st</sup> January, 1983, Plaintiff No. 1 sent a letter to Dr. Tan, enclosing a draft financial settlement proposal for commercial co-existence of both parties’ trademarks. This was met with a response from Defendant No. 1’s licensee, who included representations of their existing “CROCODILE” trademarks, which includes the Annexure-A device. These exchanges facilitated extensive negotiations,



ultimately culminating in the 1983 Agreement signed by both parties on 17<sup>th</sup> June, 1983.

5.6. The 1983 Agreement was intended to avoid further legal disputes and foster an amicable resolution regarding future registrations and use of the respective crocodile trademarks by both Defendant No. 1 and Plaintiff No. 1 in various countries. The Agreement enumerates five separate and distinct marks belonging to Defendant No. 1 in Schedule B, with the fourth mark – “



” being central to the current suit. As per the stipulations contained in the 1983 Agreement, Plaintiff No. 1 would even facilitate the registration of Schedule B trademarks in favour of Defendant No. 1. Since the Agreement’s inception in 1983, Defendant No. 1 has actively used these five



marks, particularly “ ,” in Singapore, Indonesia, and other countries. Reliance was placed on Ex. DW 1/81 to DW 1/90, which are the certificates of registration of Annexure-A device in Defendant No. 1’s name. As such, Lacoste is precluded from pursuing an action of passing off against Crocodile International, as the use of the impugned mark by Crocodile International was explicitly delineated and authorized within the terms of the Agreement. This clear contractual provision negates any claims of deceptive similarity or confusion that could be construed as passing off under the current legal framework.

5.7. In alignment with the spirit of mutual co-existence established by the 1983 Agreement, through the 1985 Letter (dated 22<sup>nd</sup> August, 1985), the parties’ understanding was expanded to include Korea, India, Bangladesh,



and Pakistan. This extension was crucial for Plaintiff No. 1's ability to register their trademarks in these territories, where Defendant No. 1 already held prior trademark rights. Without an Agreement between the parties in 1985, Defendant No. 1, who held prior registration rights in their crocodile trademarks, would not have consented to Plaintiff No. 1's registration in these countries, making it impossible for them to register or market products under the trademarks "LACOSTE" and the saurian device in the above-stated jurisdictions.

5.8. Plaintiff No. 1 was the first to propose executing an agreement for co-existence in the Indian market in exchange for Korea. As a gesture of goodwill, Dr. Tan included Pakistan and Bangladesh as additional countries where Crocodile International would not object to Lacoste's registration, as outlined in the Agreement executed in 1985. This mutual understanding of the parties is evident from subsequent communications dated 15<sup>th</sup> June, 1990 and 16<sup>th</sup> September, 1993. Pursuant to the Agreement of 1985, Plaintiff No. 1 also issued consent letters for registration of Defendant No. 1's trademarks in Pakistan. Thus, the parties intended for the 1985 Letter to be treated as a legally enforceable contract, with defined rights and liabilities.

5.9. Crocodile International is till date, completely committed to honour their intention and understanding of the Agreements executed in 1983 and 1985. In this spirit, they did not oppose the registration of Plaintiff No. 1's trademarks in *inter alia*, India, Bangladesh, and Pakistan, despite Defendant No. 1's previous registrations. Defendants have spared no effort to maintain congenial and harmonious atmosphere wherever possible. They have also tried to differentiate between Plaintiff No. 1's and Defendant No. 1's trademarks and towards this end, spent millions of dollars in advertising the



“CROCODILE” marks in English, Chinese, Indonesian and Thai languages. The market is clearly able to discern the differences between Defendants’ products with that of Plaintiffs’, which includes several factors, such as differences in pricing policy and the steps undertaken by the parties in creating their awareness and recognition. Plaintiffs’ action is therefore not maintainable.

5.10. Plaintiff No. 1 and Defendant No. 1 have co-existed in close proximity at several locations. The co-existence has been pleasant and mutually beneficial, and the same spirit should be applied to India, keeping in view Defendant No. 1’s rights with prior registration of the word and crocodile device mark and a joint reading of 1983 and 1985 Agreements.

5.11. Plaintiff No. 1 has been impinging on Defendant No. 1’s trademark rights in various territories, including Jordan and China, and despite an undertaking in the 1985 Agreement, they have refused to tender a no-objection to registration of the mark “CROCO KIDS” in Defendant No. 1’s favour in Korea. Lacoste must not be permitted to reverse course and deviate from their contractual obligations.

5.12. Lacoste’s claims in the instant suit are impacted by significant delay and laches as Crocodile International has been openly using the Annexure-A device in India since 1997. Given that Lacoste operates in the same trade, they must have been aware of such use. Moreover, Lacoste first objected to the use of the impugned mark through their letter dated 18<sup>th</sup> December, 1998 resulting in an unexplained delay of three years in initiation of these proceedings.

5.13. Without prejudice to the afore-noted, Crocodile International objected to the maintainability of the present suit, contending that this Court lacks the territorial jurisdiction to entertain the same. This suit, filed under Section



62(2) of the Copyright Act, alleges infringement of copyright of the Plaintiffs by Crocodile International. While Plaintiff No. 2 is conducting their business operations in Delhi, they have not established their ownership to the copyright as they are only a permitted user of Plaintiff No. 1's trademarks. Therefore, they lack the competency to maintain the instant proceedings. Further, the Defendants are also not residing or carrying out their business operations in Delhi, further impacting this Court's jurisdiction to decide the instant suit.

5.14. The mention of the '®' symbol on Defendants' products featuring the Annexure-A device is a result of inadvertent oversight in a few batches as the said device is registered in Defendant No. 1's name in Singapore and various other countries, where these articles are exported. Since the institution of the suit, Crocodile International has taken prompt steps to remove the said symbol from their goods.

## **PROCEDURAL ORDERS AND FACTS OF SIGNIFICANCE**

### **I. Case management proceedings**

6. The suit was instituted on 01<sup>st</sup> May, 2001, and listed for hearing for the first time on 03<sup>rd</sup> May, 2001. Summons were however issued only on 23<sup>rd</sup> May, 2001, whereafter the Defendants filed their written statement, controverting the Plaintiffs' case. The Plaintiffs have not filed replication to the written statement despite opportunities, leading to closure of their right through order dated 21<sup>st</sup> October, 2003.

7. On 07<sup>th</sup> May, 2004, admission/ denial of documents was conducted. Defendants admitted eight documents of Plaintiffs, which were marked as Ex. PW 1/1 to PW 1/8. Plaintiffs admitted twelve documents of Defendants, which were exhibited as DW 1/1 to DW 1/12.



## II. Issues

8. On the basis of the pleadings, the following issues were framed on 14<sup>th</sup> January, 2005:

1. *Whether the plaintiff is the owner of the copyright in the 'Crocodile Device'? OPP*
2. *Whether the plaintiff is the proprietor of the 'Crocodile Device' In India by virtue of registrations and use? OPP*
3. *Whether the suit suffers from gross and unexplained delay and is hit by laches and acquiescence? OPD*
4. *Whether the defendant is entitled to use the 'Crocodile Device' attached as Annexure 'A' to the plaint in India by virtue of an agreement dated June 17, 1983 between the parties? OPD*
5. *Whether this Court does not have territorial Jurisdiction to entertain and try the present Suit? OPD*
6. *Whether the plaintiffs are not entitled to any relief as they are guilty of concealing (sic) vital facts and documents? OPD*
7. *Whether the plaint is liable to be dismissed on account of it being fictitious with an intention of thwarting the legitimate business of the defendant? OPD*
8. *Whether the use of 'Crocodile Device' attached as Annexure 'A' to the plaint by the defendant violates the plaintiff's' copyright and trade mark rights in India? OPP*
9. *Whether the defendant is liable to be prosecuted and non-suited on account of use of the symbol ® with a view to misrepresent the members of the trade and public that the 'Crocodile Device' is a registered trade mark in India? OPP*
10. *Whether the first defendant is the prior adopter and user of the saurian device and the owner of trade mark rights in the same? OPD*
11. *Whether the first plaintiff and the first defendant signed and entered into co-existence agreements dated 17<sup>th</sup> June 1983 and 22<sup>nd</sup> August 1985 for respective territories? OPD"*

## III. The conduct of trial

9. Post framing of issues on 14<sup>th</sup> January, 2005, parties filed their list of witnesses and the trial commenced. The Plaintiffs deposed two witnesses, Mr. Christian London [PW1] and Mr. S.S. Negi [PW2]. The Defendants also examined two witnesses, namely, Mr. Trisno Kemat Leono [DW1] and Mr. Ramesh Babu [DW2].





10. Plaintiffs' first witness, Mr. Christian London, a French national, requested for a translator at the time of cross-examination, which was allowed on 08<sup>th</sup> January, 2007, and one Ms. S. Shobha was appointed as the translator. However, his testimony faced hurdles as prior to commencement of cross-examination, the Defendants raised multiple objections, highlighting several discrepancies in the affidavit by way of evidence filed by Mr. London. They pointed out that Mr. London had filed two affidavits, one dated 03<sup>rd</sup> December, 2005, and the other dated 02<sup>nd</sup> February, 2006. Additional objections were also raised concerning the introduction of new documents in the affidavits, documents being in foreign language without accompanying translations, and improper legalization and lack of an apostille. These objections were overruled through a detailed judgment dated 18<sup>th</sup> January, 2007, where the Court directed the Defendants to proceed with the cross-examination of Plaintiffs' witness. Taking note of Defendants' conduct and the delay caused, they were burdened with costs of Rs. 50,000/-. Mr. London was subsequently cross-examined on 18<sup>th</sup> January, 2007 and 19<sup>th</sup> January, 2007. On 20<sup>th</sup> January, 2007, after conclusion of the cross-examination, PW1 was also re-examined and further cross-examined.

11. The afore-noted interlocutory order dated 18<sup>th</sup> January, 2007 was assailed in FAO(OS) 110/2007, which was decided by the Division Bench through detailed judgment dated 20<sup>th</sup> December, 2007, dismissing the appeal, and imposing further costs of Rs. 15,000/-.

12. In the meantime, Plaintiffs' second witness, Mr. Anoop Singh, was not traceable as he was not in contact with Plaintiffs. Through I.A. 3174/2008, the Plaintiffs then applied for the said witness to be substituted by Mr. S. S. Negi. This request was again met with opposition from Defendants, and



decided through order dated 07<sup>th</sup> August, 2008, allowing the substitution of witness.

13. Subsequently, through I.A. 3221/2011, Plaintiffs sought to produce originals of the Power of Attorney in favour of PW2 and certificate of the Chartered Accountant, attesting to the sales turnover of Plaintiff No. 2. This application was allowed in part on 24<sup>th</sup> February, 2012, permitting the Plaintiffs to place on record the original Power of Attorney. Plaintiffs then assailed the said order of the Joint Registrar in O.A. 58/2012, which was allowed in their favour on 19<sup>th</sup> July, 2012, subject to payment of costs of Rs. 50,000/-.




14. Later, the Plaintiffs preferred I.A. 10811/2013, seeking permission to produce an Arbitration Award dated 15<sup>th</sup> August, 2011 passed by the Arbitrator in Singapore in a dispute between the parties concerning the 1983 Agreement. Their request was allowed on 24<sup>th</sup> February, 2014, subject to imposition of costs.

15. Testimony of Plaintiffs' second witness, Mr. S. S. Negi, was finally concluded on 28<sup>th</sup> January, 2016 and thereafter, on 09<sup>th</sup> March, 2016, the Award dated 15<sup>th</sup> August, 2011 was admitted by Defendants, without prejudice to the interpretation of the contents. It was marked as Exhibit P-1.

16. Defendants examined Mr. Trisno Kemat Leono as DW1, whose deposition was concluded on 24<sup>th</sup> February, 2018. Mr. Ramesh Babu, DW2 was then examined and the trial stood concluded on 30<sup>th</sup> November, 2018.

17. After the trial concluded, an application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 [I.A. 10863/2020] was filed by the Plaintiffs seeking to prevent the Defendants from using their newly



devised trademarks “    ” on a standalone basis, arguing that use thereof reflects Defendants’ intention to imitate the Plaintiffs’ trademarks, causing consumer confusion. However, given the advanced stage of the suit, on 23<sup>rd</sup> November, 2020, the parties consented to addressing arguments in the suit for final adjudication. Consequently, extensive arguments were advanced, which stood concluded on 15<sup>th</sup> May, 2024. The Plaintiffs’ interlocutory application [I.A. 10863/2020] is being decided through a separate order passed today.

18. The Court has considered the submissions advanced and thoroughly examined the evidence presented by the parties. Documentary evidence submitted by the parties, which has been specifically referred to in the judgment, is delineated in the appendices to the judgment.

### **ISSUE-WISE ANALYSIS AND FINDINGS**

#### **ISSUE NO. 5 - WHETHER THIS COURT DOES NOT HAVE TERRITORIAL JURISDICTION TO ENTERTAIN AND TRY THE PRESENT SUIT?** OPD

19. The onus to prove the afore-noted issue is on the Defendants. No submissions were advanced on this issue during the course of final arguments by either party, nor were the witnesses examined on this aspect. The issue stems from Crocodile International’s objection to the territorial jurisdiction of this Court in their written statement. They contend that under Section 62(2) of the Copyright Act, a suit can be instituted within territorial jurisdiction of the courts where the Plaintiff is residing or carrying on business; however, in this case, Plaintiffs have not established their right, title or interest to the



copyright comprised in the artistic work of the crocodile logo. Crocodile International further questioned the competence of Plaintiff No. 2, who is carrying on commercial operations in Delhi, to initiate this lawsuit. According to the Defendants, the Registered User Agreement [Ex. PW 2/4] executed between the two Plaintiffs, only pertained to a license for using Plaintiff No. 1's trademarks, and not the copyright in artistic work of the crocodile logo. Therefore, the benefit of Section 62(2) is not available to Lacoste as Plaintiff No. 2 has not acquired right in Plaintiff No. 1's copyright. It is also emphasized that Defendants were not manufacturing or trading under the Annexure-A device within territorial jurisdiction of this Court.

20. The Plaintiffs have filed this composite suit for trademark and copyright infringement before this Court on the basis of Section 62 of the Copyright Act and availability of the offending goods within the territorial jurisdiction of this Court. Section 62 of the Copyright Act reads as follows:

*“Section 62- Jurisdiction of court over matters arising under this Chapter-  
(1) Every suit or other civil proceeding arising under this Chapter in respect of the infringement of copyright in any work or the infringement of any other right conferred by this Act shall be instituted in the district court having jurisdiction.*

*(2) For the purpose of sub-section (1), a “district court having jurisdiction” shall, notwithstanding anything contained in the Code of Civil Procedure, 1908 (5 of 1908) or any other law for the time being in force, include a district court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceeding, the person instituting the suit or other proceeding or, where there are more than one such persons, any of them actually and voluntarily resides or carries on business or personally works for gain.”*

21. Section 62(2) of the Copyright Act authorizes initiation of legal proceedings before the court within whose territorial limits the Plaintiff resides or carries on business or personally works for gain. The provision, as worded, endows jurisdiction to a forum to adjudicate the cases of copyright



infringement based on the convenience of the Plaintiff in addition to the provisions of the CPC. This avenue does not override the jurisdiction of courts envisaged in Section 20 of the CPC, rather it supplements the grounds for invoking a court's jurisdiction. This is evident from the inclusive nature of the definition of a "district court having jurisdiction" in Section 62(2), suggesting a wider import than Section 20 of the CPC. This legal principle has been recognized in the decisions of the Supreme Court in *Exphar SA and Anr. v. Eupharma Laboratories Ltd. and Anr.*,<sup>8</sup> and *Dhodha House v. S.K. Maingi*.<sup>9</sup>

22. It is undisputed that Plaintiff No. 2 in the instant case, being a 'person instituting the suit' conducts their business operations in Delhi. The uncontroverted promotional materials submitted by Crocodile International, such as Ex. DW 1/17, unequivocally establish that the Defendants offer the impugned apparels displaying the Annexure-A device through their retail outlets across the country, including New Delhi. Therefore, the cause of action for violation of copyright has partly emerged in Delhi, thus prompting this Court's jurisdiction in terms of Section 20(c) of the CPC.

23. In addition to the allegations of copyright infringement, Lacoste is also seeking injunctive reliefs against Crocodile International to prevent infringement and passing off of their trademarks. As per Section 105 of the Trade and Merchandise Marks Act, 1958,<sup>10</sup> a suit for infringement and passing off may be initiated before a court of appropriate jurisdiction, not inferior to a District Court.<sup>11</sup> The goods bearing impugned mark are available

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<sup>8</sup> (2004) 3 SCC 688.

<sup>9</sup> (2006) 9 SCC 41.

<sup>10</sup> "Trade Marks Act, 1958."

<sup>11</sup> In terms of Section 159(4) of the Trademarks Act, 1999, all legal proceedings instituted before the commencement of the 1999 Act shall be governed by the Trade and Merchandise Marks Act, 1958. The




in Delhi, and the pleadings and evidence presented indicate a valid cause of action for trademark infringement and passing off within this Court's territorial jurisdiction. Consequently, the Defendants' objection to the maintainability of the suit does not find favour with the Court.

**Finding**

24. In view of the lack of evidence and the admitted sale of impugned products within Delhi, the Defendants have not been able to sustain their objection to this Court's territorial competence to decide the present suit. Accordingly, this issue is answered in favour of the Plaintiffs.

**ISSUE NO. 1 - WHETHER THE PLAINTIFF IS THE OWNER OF THE COPYRIGHT IN THE "CROCODILE DEVICE?"** **OPP**

25. Copyright is a form of protection given to the authors of original creations, including artistic works. The key factor in assessing copyright eligibility is the originality of the creation, and its expression in a tangible form that allows for its reproduction. Lacoste's claim to copyright hinges not just on creation, but also on the original expression and subsequent registration of the crocodile device as an artistic work. Thus, in ascertaining

copyright ownership of Lacoste, their crocodile device – “” must be examined for its originality and expression.


26. Lacoste submitted that the crocodile device was created by Mr. Robert George in France, where it was first published in 1927. PW1 provided a

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present suit was filed on 01<sup>st</sup> May, 2001. At the time of initiation of these proceedings, the Trademarks Act, 1999 had been notified (on 30<sup>th</sup> December, 1999), but not enforced. Accordingly, the Court has decided the instant suit guided by the principles entailed in the Trade and Merchandise Marks Act, 1958.



detailed deposition affirming the creation and publication history of the device, tracing the conveyance of rights from Mr. Robert George to Plaintiff No. 1. Mr. London has highlighted the continuous use of this crocodile device by Lacoste to demonstrate a longstanding recognition and fixation of the artwork on their products. PW1 has further presented Copyright Registration Certificate bearing No. A-62692/2002 dated 16<sup>th</sup> January 2002 [Ex. PW-

1/10], which confirms the copyright registration of “” in the name of Plaintiff No. 1. The application for registration filed on 09<sup>th</sup> June, 1999 by Plaintiff No. 1 and the certificate, explicitly record the initial publication date of 1927 in France, and a subsequent publication in India in 1992, reinforcing the work’s continuous recognition and protection under copyright laws.

27. It is crucial to note that Mr. London’s testimony regarding the creation, registration, and ongoing validity of the copyright for the crocodile device went unchallenged by the Defendants during cross-examination. This uncontroverted testimony is a strong indicator of the reliability and acceptance of the facts, as presented by Lacoste. Furthermore, during the arguments, Crocodile International did not contest the claim to copyright, implicitly acknowledging Lacoste’s asserted rights.

### **Finding**

28. Based on the evidence presented, including the historical documentation concerning registration and the uncontested testimony of Mr. London, the Court finds that Plaintiff No. 1 has satisfactorily established copyright ownership over the crocodile device. The copyright in this artistic work remains valid and subsisting not only in India, but also globally, thereby



granting Plaintiff No. 1 the exclusive rights to control its reproduction and use and protect infringement under the current legal framework governing copyright. Issue No. 1 is accordingly decided in favour of the Plaintiffs, and against the Defendants.

**ISSUE NO. 2 - WHETHER THE PLAINTIFF IS THE PROPRIETOR OF THE 'CROCODILE DEVICE' IN INDIA BY VIRTUE OF REGISTRATIONS AND USE? OPP**

29. Trademark ownership in India is established through registration under the Trade Marks Act, 1958 or Trademarks Act, 1999, or by virtue of extensive and continuous use that leads to brand recognition in the market. In the case at hand, Lacoste asserts ownership over their crocodile device both by trademark registrations and use since October, 1993. In support, they have presented substantial evidence: the legal proceedings certificates in respect of



registrations No. 400265 for the mark “



” were provided as part of the evidence [Ex. PW 1/11 and PW 1/12, respectively] and referenced during the testimony of PW1. Plaintiff No. 1 is the only party holding a registration for the standalone version of their



crocodile device *viz.* “” in India. These registrations, which date back to 19<sup>th</sup> January, 1983, have not only legally strengthened Lacoste’s claims, but have also presumably contributed to the establishment of the “LACOSTE” mark and the crocodile device as a recognized symbol of their goods in the market. Additionally, in his deposition, PW1 has confirmed that






the apparels bearing the “LACOSTE” mark and the crocodile device were first launched in India in October 1993, with the opening of the first Lacoste boutique. Moreover, PW2, Mr. S.S. Negi, has also testified that following the execution of the User Agreement between Plaintiff No. 1 and Plaintiff No. 2 on 23<sup>rd</sup> July, 1994 [Ex. PW 2/4], Plaintiff No. 2 has been extensively trading in products bearing Plaintiff No. 1’s trademarks. Their definite and categorical statements concerning the year of commercial use have not been disproved in trial. Crocodile International did not cross-examine the Plaintiffs’ witnesses to debilitate their assertions regarding the usage of the Lacoste’s marks in India.

30. Thus, the documentary evidence, including trademark registration details, and absence of evidence negating their claims, demonstrate Lacoste’s trademark rights over the crocodile device. This combination of statutory registration and use of the trademark by the Plaintiffs strongly supports the conclusion that Plaintiff No. 1 is indeed the proprietor of the crocodile device in India, thus reinforcing their claim to exclusive rights over the mark. The absence of any cross-examination or contrary arguments from Crocodile International concerning the validity of these trademark registrations or the associated rights further suggest an acceptance, or at least, a failure to dispute, Lacoste’s claims to these marks.


### **Finding**

31. In light of the above evidences of valid and active trademark registrations, international recognition and specific legal protection, coupled with the lack of opposition from Defendants regarding these marks, the Court concludes that Plaintiff No. 1 is indeed the rightful proprietor of the registered



crocodile device “.” Consequently, issue No. 2 is decided in favour of the Plaintiffs, affirming their exclusive rights to use and enforce the trademark in relation to the specified goods, as per their registration No. 4000267.

**ISSUE NO. 10- WHETHER THE FIRST DEFENDANT IS THE PRIOR ADOPTER AND USER OF THE SAURIAN DEVICE AND THE OWNER OF TRADE MARK RIGHTS IN THE SAME?** **OPD**

32. Crocodile International has founded their defence on honest adoption and continuous use of the ‘crocodile family of marks’ since 1947 worldwide, which is supported with evidence. Specifically in India, their first registration dates 12<sup>th</sup> June, 1952 for the mark “.” Over the decades, Crocodile International alleges to have developed and used various saurian/crocodile devices, which are illustrated in the evidence submitted as Ex DW 1/16 (colly). The visual representations provided are crucial in assessing the scope and distinctiveness of Crocodile International’s marks in comparison to those claimed by Lacoste. The relevant variants of Defendants’ crocodile/saurian device are therefore, reproduced below:



CROCODILE INTERNATIONAL PTE. LTD. TRADE MARKS							
A1	CROCODILE						
A10		CROCODILE		鱷魚			
A17			鱷魚	CR			
A22			鱷魚				
B1							
C1							
D1	CROCO KIDS						
E1	CROCO						
F1	CROCO2						
G1							004

33. The saurian device which is central to the litigation, “



,” is depicted at point B1 of the afore-mentioned chart.

Given the historical context of the legal conflict between the parties, in the current proceedings, it is essential to distinguish between the use and adoption of the two saurian devices – the one incorporated within the Defendant No. 1’ registered trademarks, and the one depicted in Annexure-A. With this distinction in mind, the Court proceeds to examine the pleadings and evidence to assess Defendant No. 1’s claim of prior use of the saurian device portrayed in Annexure-A to the plaint.



34. Defendant No. 1's charge of prior use in India pivots on their first trademark registration No. 154397, dated 12<sup>th</sup> June, 1952, for the mark “



,” in the name of Dr. Tan. This registration was subsequently assigned to Crocodile International Pte Ltd. (formerly, Li Seng Min Company Ltd.). Later, Defendant No. 1 secured another registration





operative from 21<sup>st</sup> November, 1990 for “ ” in class 25, under No. 540315. Defendant No. 1 commercially launched their products bearing the composite trademarks illustrated above, through their licensee – Defendant No. 2, in August, 1998. The commercial launch was preceded with promotional campaigns documented through caution notices and advertisements in major newspapers from 1995 onwards, with the advertisements particularly intensifying post 1998. This is evident from the caution notices issued in Deccan Herald on 05<sup>th</sup> December, 1995 [Ex. DW 2/P3] and in The Hindu on 27<sup>th</sup> April, 1998 [Ex. DW 2/6], as well as Ex. DW 1/17, being the advertisements issued by Defendants in various newspapers, such as, The Hindu on 09<sup>th</sup>, 12<sup>th</sup>, 15<sup>th</sup>, 17<sup>th</sup> and 28<sup>th</sup> October, 2001, Assam Tribune on 22<sup>nd</sup> October, 2001, Chandigarh Times on 13<sup>th</sup> October, 2001, and Sambad on 18<sup>th</sup> October, 2001. These documents consistently depict the use of Defendant No. 1's crocodile devices, including Annexure-A device in conjunction with the word/ mark “CROCODILE”/ “CROCODILE INTERNATIONAL,” reinforcing the consistent use of a composite mark by Crocodile International from the year 1998 and upwards.



35. In the pleadings and testimony of DW1, it is asserted that Defendants commenced the use of crocodile mark and devices, encompassing Annexure-A device, from the year 1997. Although Defendant No. 1 has actively used the crocodile word and device mark in India since at least 1997, as stated in their written statement, there is a notable absence of specific pleading or assertion that they were the prior adopters and users of the saurian device depicted in Annexure-A to the plaint, before the Plaintiffs. This omission is significant, especially since Defendants do not deny the use of the Annexure-A device. In fact, in their written statement, it is contended that “(i)t is therefore submitted that the defendants have been advertising and using the Crocodile word and device mark in India since at least 1997 i.e. for the last 4 years. It is strongly denied that the defendants commenced use of the mark in India since the last 2 years only.” Without a clear assertion of prior adoption specific to the device in question, the defence lacks the specificity required to effectively counter Lacoste’s claims of earlier rights.

36. Lacoste, on the other hand, has proved their trademark rights in the



registered devices “  ” and “  ” since 19<sup>th</sup> January, 1983. They have also submitted evidence of use of “LACOSTE” trademark and crocodile device since 1993, beginning with the launch of their products in October, 1993. In this scenario, Defendant No. 1’s assertions must be examined in respect of two distinct trademarks – the composite crocodile device and the Annexure-A device:

36.1. ***Defendant No. 1’s prior rights in the composite crocodile device:*** Due to their historical registration dating back to 1952 and documented use since



1997, the Court finds that Defendant No. 1 indeed possesses prior rights in the composite device that entail a crocodile device accompanied with the word “CROCODILE” as Plaintiff No. 1’s registration (1983) and demonstrated use (1993) of their devices are subsequent.

36.2. ***Prior adoption and use of Annexure-A device:*** Defendant No. 1 has not specifically pleaded prior adoption and use of the standalone saurian device shown in Annexure-A, which is central to Lacoste’s claims. Thus, any claim by Defendant No. 1 to prior adoption and ownership of trademark rights is strictly confined to the composite saurian device that forms part of their registered trademarks. This point is critical: while Defendants are the prior registrants and users of a composite saurian device, this does not automatically confer rights over any and all variations of saurian devices, especially those that are not part of their registered trademarks. Contrastingly, Lacoste has proved their rights over the standalone crocodile device “




,” which was registered in their name in 1983. This timeline predates Defendant No. 1’s claimed use of the Annexure-A device by several years, establishing a precedent of use and recognition in the Indian market in favour of Lacoste. Thus, Lacoste’s registration of their standalone crocodile device not only proves their claim to the rights in the trademark, but also enhances their standing to allege infringement based on prior use and registration.


### **Finding**

37. To conclude, there is clear acknowledgment by the Defendants in their written statement that their use of the saurian device commenced in 1997, with documentary proof of continuous use starting from 1998. Lacoste’s



rights in their registered device operate *w.e.f.* 19<sup>th</sup> January, 1983. At the time that when Plaintiff No. 1 obtained registrations in India, Defendant No. 1 had not adopted the Annexure-A device. Defendant No. 1 therefore, cannot assert prior adoption of the infringing Annexure-A device as they are the subsequent adopter and user thereof.

38. Nonetheless, Defendant No. 1 has established prior rights to their registered composite mark that includes a saurian device [“”

and “”]. These registrations are clearly delineated to include only the specific composite mark as registered and Crocodile International has failed to show any evidence that would extend these prior rights to the standalone saurian device depicted in Annexure-A, which substantially resembles the device used by the Lacoste.

39. Therefore, issue No. 10 is decided by holding that Defendant No. 1 is not the prior adopter or user of the Annexure-A saurian device. They retain ownership of the trademark rights solely in the context of their registered composite marks, bearing registrations No. 154397 and 540315. Consequently, while they maintain rights to their composite trademark, they do not hold prior rights to the standalone device that closely resembles Plaintiff No. 1’s registered mark. Issue No. 10 is thus resolved in the above terms.

**ISSUE NO. 4 - WHETHER THE DEFENDANT IS ENTITLED TO USE THE ‘CROCODILE DEVICE’ ATTACHED AS ANNEXURE ‘A’ TO THE PLAINT IN INDIA BY VIRTUE OF AN AGREEMENT DATED JUNE 17, 1983 BETWEEN THE PARTIES?**

**OPD**



**ISSUE NO. 11 (REWORDED) - WHETHER THE FIRST PLAINTIFF AND THE FIRST DEFENDANT SIGNED AND ENTERED INTO CO-EXISTENCE AGREEMENTS DATED 17TH JUNE, 1983 AND 22ND AUGUST, 1985 FOR RESPECTIVE TERRITORIES? IF SO, WHETHER SUCH CO-EXISTENCE EXTENDS TO ANNEXURE-A DEVICE IN INDIA?** **OPD**

**ISSUE NO. 8- WHETHER THE USE OF ‘CROCODILE DEVICE’ ATTACHED AS ANNEXURE ‘A’ TO THE PLAINT BY THE DEFENDANT VIOLATES THE PLAINTIFF’S COPYRIGHT AND TRADE MARK RIGHTS IN INDIA?** **OPP**

40. For an effective determination, and considering the nature of the controversy and submissions advanced, under Order XIV Rule 5 of CPC, it is deemed appropriate to reframe issue No. 11 to “*Whether the first plaintiff and the first defendant signed and entered into co-existence agreements dated 17<sup>th</sup> June, 1983 and 22<sup>nd</sup> August, 1985 for respective territories? If so, whether such co-existence extends to Annexure-A device in India? OPD.*”

41. Crocodile International rebuts the allegations of copyright and trademark infringement, claiming honest and concurrent use, supplemented by terms of peaceful co-existence entailed in the 1983 Agreement and 1985 Letter. These agreements are purported to justify Crocodile International’s continued use of the Annexure-A device within the agreed territories, making their actions compliant with mutually recognized terms, rather than infringing. In this context, issue No. 4 pertains to an agreement dated 17<sup>th</sup> June, 1983, which is critical in determining whether Defendant No. 1 has the right to use the Annexure-A device within India, thereby directly impacting the legal basis for any trademark use within this territory. In deciding issue No. 11, we would explore the existence and specifics of the co-existence agreements dated 17<sup>th</sup> June 1983 and 22<sup>nd</sup> August 1985, which are alleged to be dictating the terms under which each party may operate within their






respective territories. The decision on issue No. 8 will ascertain whether such use infringes upon Lacoste’s copyright and trademark rights – a determination that hinges on the conclusions drawn from the scope and applicability of the rights discussed in issues No. 4 and 11. Collectively, the above-captioned issues focus on the rights and agreements pertaining to the use of the Annexure-A device. Given the overlapping nature of these concerns, a joint assessment is both appropriate and necessary.

42. The court’s primary task in any case of trademark and copyright infringement is to determine the degree of similarity between the contested marks and works and to assess the ensuing likelihood of confusion and defiance of exclusive rights. This evaluation rests on the anvil of Section 29 of the Trade Marks Act, 1958, which addresses trademark infringement, and Section 51 of the Copyright Act, concerning copyright infringement.

**I. Similarity between the two trademarks**

43. Here, both trademarks feature a crocodile for garments, making them conceptually identical and leaving little room for dispute on the point of similarity. In trademark disputes involving the arbitrary use of designs such as the present, the courts would typically resolve the issue swiftly if the two crocodile logos have apparent resemblances. However, this case presents a unique context: both parties have acknowledged co-existence and hold registrations for a crocodile design within their trademarks. This co-existence necessitates a detailed scrutiny of specific elements of the conflicting saurian emblems.



44. The visual analysis of the two trademarks “  ” and “



” reveals identical shape and posture. Both crocodiles are depicted in a horizontal position with an upwardly curved tail. Their body postures are quite similar, with both showing a side view portraying the legs and tail in a similar fashion. The depiction of the feet and claws is also similar, entailing a detailed and realistic representation of a crocodile. Although there are certain distinctions in the limbs and other features of the impugned mark, the positioning mirrors that of Lacoste’s logo, reinforcing the overall visual similarity. Both the devices feature an open mouth with visible teeth, whose shape and placement are nearly alike. The detailed portrayal of the teeth and shape of the mouth are critical visual elements that consumers associate with Lacoste’s mark. The arrangement and pattern of scale on the back of both reptiles is very similar, further contributing to visual resemblance. Besides, the overall silhouette of both crocodiles, including the head shape, body curvature, and tail positioning, is almost indistinguishable. Both designs convey a similar aggressive stance, enhancing the conceptual similarity. This congruence in the overall silhouette not only heightens the visual similarity, but also strengthens the conceptual resemblance. These elements are crucial in the holistic assessment of the marks, as they contribute to the overall impression retained by the average consumer. The near-exact duplication of the specific posture of the crocodile and other features by Crocodile



International exacerbates the deceptive similarity between the two marks, creating a substantial likelihood of consumer confusion.

45. Under Section 2(1)(d) of the Trade Marks Act, 1958, a mark is considered to be deceptively similar if it “*so nearly resembles that other mark as to be likely to deceive or cause confusion.*” This principle of ‘likelihood of confusion,’ as elucidated by judicial precedents, warrants an examination of the contesting marks with a focus on their similarities, rather than their differences. In *Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd.*,<sup>12</sup> reinforcing the holding in *Amritdhara Pharmacy v. Satya Deo Gupta*,<sup>13</sup> the Supreme Court held that the assessment of deceptive similarity extends beyond a side-by-side comparison, entailing a consideration of the overall impression delivered by the marks and the imperfect recollection of an average consumer. In *James Chadwick and Bros. Ltd. v. National Sewing Thread Co. Ltd.*,<sup>14</sup> the conflicting trademarks were a “representation of a bird perching on a cylinder of cotton sewing thread with its wings fully spread out” alongside the name ‘Eagle brand’ of the Respondent therein and “representation of an eagle with its wings half opened trying to stand erect on some flat object” with the brand name ‘Eagley Sewing Machine Thread’ of the Appellant therein. In these proceedings, arising out of grant of opposition to Respondent’s trademark application, the Division Bench of High Court of Bombay held that in ascertaining the possibility of confusion, courts must evaluate the resemblances in the distinguishing features of the trademark, rather than undertaking a meticulous examination to discover their points of

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<sup>12</sup> (2001) 5 SCC 73.



<sup>13</sup> 1962 SCC OnLine SC 13.

<sup>14</sup> 1951 SCC OnLine Bom 33.



differences. In these circumstances, irrespective of the differences in the posture, poise and positioning of the birds and their wings, the Court ruled in favour of the Appellant therein, finding that a person of ordinary intelligence would mistake the impugned mark to be of the Appellant therein.

46. Having carefully compared the distinctive elements of both the Plaintiffs’ and Defendants’ crocodile logos, it becomes clear that the similarities are not only numerous, but also substantial. Bearing the aforementioned principles of evaluation in mind, the noticeable difference in the orientation of the crocodiles – with Lacoste’s crocodile facing right, and Crocodile International’s facing left – carries minimal weight and is likely to be perceived as insignificant by the average consumer. The dominant visual similarities between the two marks discussed previously, create a strong overall ocular and conceptual resemblance. These elements are so closely mirrored that they overshadow the minute directional difference of the logos. To gain a deeper understanding, a comparison is made below between the reversed version of the Annexure-A device, oriented to face right, with Lacoste’s crocodile device is drawn below:

<i>Lacoste’s crocodile device</i>	<i>Crocodile International’s device</i>
	

47. Controverting the allegations of consumer misperception, Crocodile International stated in their defence that it is standard industry practice to



emboss only the logo on the front pockets of t-shirts, while the tags and labels clearly identify Crocodile International as the manufacturer. Despite the apparent lack of supporting evidence, the Court finds that the striking resemblance between Lacoste’s crocodile mark and the Annexure-A device across multiple key visual aspects, augments the prospects of ‘initial interest confusion.’ This means that an average consumer might initially believe that the goods are from Lacoste based on the prominent and recognizable features of the impugned mark, even though this confusion may not persist throughout the transaction.<sup>15</sup> Thus, this substantial resemblance strongly supports a finding of deceptive similarity.

48. In the course of cross-examination, Lacoste questioned the Defendants’ witnesses about the likelihood of confusion between the parties’ marks, particularly referring to a version of the saurian device allegedly used by



Defendant No. 1, depicted at point A10 of Ex. DW 1/16 – “ ,” which represents a crocodile facing right. The relevant responses of DW-1 are reproduced below:

***Testimony of DW1 recorded on 24<sup>th</sup> February, 2018:***

*“Q55. Please see para no. 13 of your affidavit and explain as to what is your understanding of there being no cause for “any conflict or confusion in the market”. Is it on account of your Saurian device facing left and plaintiff’s device facing right or are there other considerations as well?  
Ans. The direction of Saurian device is one of the main considerations that is why we have not possibly used trademark A10.”*

***Testimony of DW2 recorded on 30<sup>th</sup> November, 2018:***

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<sup>15</sup> Vol. 4, J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §23:6 (5<sup>th</sup> edn., 2023).



*“Q1. Please see the specific trademark encircled in Red in Ex DW2/6 at Point X and compare the same with the certified copy of plaintiff’s registered trademark bearing No. 400267 in Class 25 (Ex PW1/12). Please point out the difference between the two?”*

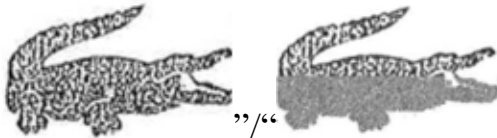
*A. In the representation of the mark in Ex DW2/6 encircled in red, the Crocodile face is on the left hand side. The tail on this device is turning on the upper side towards the left. The word Crocodile is written below the device. In the registration of the plaintiff on the other hand, the Crocodile face is on the right hand side and the tail is going on the upper side towards the right. There are no other differences.*



**Q2. Is it correct that a mirror image of the defendant mark would make the crocodile face right and mirror image of plaintiff’s mark would make it face left?**

**A That is correct.”**

[Emphasis Supplied]

49. The above-noted excerpts demonstrate that DW1 and DW2 acknowledge the similarities between Lacoste’s crocodile device and Annexure-A device, conceding that the key distinction lies in the orientation of the two crocodiles. However, during the course of arguments, counsel for Crocodile International argued that the images of Lacoste’s trademarks shown

to DW2 viz. “”/“” differ significantly from the

actual device used “”/“,” thereby suggesting that the response of the witness cannot be understood as an admission. However, in the opinion of the Court, the witnesses deposing on behalf of the parties were fully conscious of the dispute and the trademarks involved in the controversy. Therefore, presenting an unclear image to DW 2, the constituted attorney of Defendant No. 2, does not dilute their admission of the overall optical similarities. Consequently, this objection raised is rejected.



50. To conclude, in light of the jurisprudence of trademark law, which is well-established by the court rulings referred above, and based on the detailed visual analysis conducted, the Court observes that the visual and conceptual parallels between Lacoste’s crocodile device and Annexure-A device have a strong potential to mislead consumers or cause them to confuse one brand with another. The similarities in shape, silhouette, and key design elements, especially when coupled with their application to identical products, create a significant likelihood of consumer confusion. Given these comprehensive observations, it is evident that the Annexure-A device used by Crocodile International so nearly resembles Lacoste’s mark that it meets the criteria for being deceptively similar under Section 2(1)(d) of the Trade Marks Act, 1958.

***I.I. Judicial precedents cited by Crocodile International***

51. To refute the allegation of deceptive similarity, Crocodile International relied on judgments rendered by courts of different jurisdictions [Ex. DW 1/92 to DW 1/97]. After a thorough examination of the same, the Court finds that these rulings vary on facts, and do not advance the Defendants’ case for following reasons:

51.1. *Ex. DW 1/92*: Lacoste had instituted a suit against Crocodile International before the District Court of Yangon, Myanmar claiming infringement of “LACOSTE” trademark and crocodile device, which was decreed in their favour. The device impugned in the said suit contained “the word crocodile and the figure of a crocodile.” An appeal was filed before the Divisional Court of Yangon in Civil Appeal No. 2/2001. The Divisional Court, through judgment dated 07<sup>th</sup> March, 2001, set aside the District Court’s order, finding a lack of territorial jurisdiction to entertain the suit. On merits,



the Court opined that the simultaneous presence of the two marks will not result in confusion as the word ‘Lacoste’ is contained inside the device of crocodile, and is distinguishable from a crocodile figure with the word ‘Crocodile.’

51.1.1. The rival trademarks in the instant proceedings are distinct from the marks forming a subject matter of the afore-noted suit. Here, the Defendant is using the Annexure-A device unaccompanied with the word ‘Crocodile,’ an attribute that considerably increases the likelihood of confusion. Therefore, the observations of the Divisional Court of Yangon, Myanmar do not hold significance in the present context.

51.2. *Ex. DW 1/93 and Ex. DW 1/94*: Crocodile International filed an application for registration of a crocodile device containing the word ‘Crocodile’ in respect of clocks, jewellery, watches, shoe ornaments etc. in Sri Lanka. The application was opposed by Lacoste. The Director General of Intellectual Property dismissed Lacoste’s objection on 10<sup>th</sup> September, 2012 [Ex. PW 1/94] in view of the parties’ continued co-existence across classes and the inclusion of the words ‘Lacoste’ and ‘Crocodile’ in their respective trademarks. Lacoste challenged these findings before the High Court of the Western Province Holden in Colombo, Sri Lanka. The High Court delivered the judgment on 03<sup>rd</sup> December, 2013 [Ex. DW 1/93], upholding the view of Director General of Intellectual Property. It opined that there was longstanding concurrent use of the image/ device of a crocodile with or without the words ‘Lacoste’ and ‘Crocodile.’

51.2.1. The trademarks in contest before this Court are distinguishable from the judgments discussed above. Further, the observations of the High Court of uncontested concurrent use are also not relevant to the present dispute as





Lacoste launched a challenge to Crocodile International's use of Annexure-A device at the first instance.

51.3 *Ex. DW 1/96 and Ex. DW 1/97*: Ex. DW 1/96 and DW 1/97 pertain to decisions of the Court of Appeal of Paris and Supreme Court of Paris. In these decisions, the courts categorized Lacoste's two trademark applications as fraudulent. This conclusion is premised on Lacoste's concealment of the 1983 Agreement while pursuing their trademark applications, and is irrelevant to the dispute at hand. Notably, the Court of Appeal declined to evaluate the effect of the 1983 Agreement, citing its limited territorial applicability.

52. In light of the foregoing findings of deceptive similarity between the two trademarks, we must now address whether the Defendants' use of Annexure-A device infringes upon the Plaintiffs' trademark rights. This inquiry necessitates an examination of the Defendants' defence based on co-existence, anchored in the 1983 Agreement and 1985 Letter. These agreements or arrangements are critical as they potentially delineate the extent of legal violations and permissible scope of use for the impugned mark within specific territories.

## II. *The 1983 Agreement*

### II.I. *Historical backdrop to the execution of the 1983 Agreement presented by Crocodile International*

53. In 1971, when Plaintiff No. 1 commenced operations in Japan, Defendant No. 1 initiated a legal action against Plaintiff No. 1's licensee in the District Courts of Osaka, Japan. In the said proceedings, Plaintiff No. 1 contended that their mark, featuring what they described as an 'alligator' and prominently including the word "LACOSTE," was distinct from Defendant



No. 1's crocodile device, which diminishes the risk of confusion or deception. On 24<sup>th</sup> February, 1971, the court ruled in favour of Plaintiff No. 1, affirming the distinguishability of the marks.

54. Subsequent interactions between the parties further underscored the contentious nature of their relationship concerning rights in their respective trademarks. On 16<sup>th</sup> July, 1980, Defendant No. 1 issued a cease-and-desist letter to Plaintiff No. 1's licensee in Singapore, Royal Sporting House, demanding that they discontinue the use of the crocodile device [Ex. DW 1/19]. In their response dated 30<sup>th</sup> July, 1980 [Ex. DW 1/20], Royal Sporting House maintained that Plaintiff No. 1's logo represented an alligator rather than a crocodile, emphasizing the visual distinctions between the two and asserting that their customers associate their products with the name "LACOSTE" beyond the device itself.

55. In a gesture acknowledging the established history and reputation of Defendant No. 1's crocodile marks, Plaintiff No. 1, on 09<sup>th</sup> December 1980, offered a settlement, including a financial compensation, to resolve ongoing legal disputes [Ex. DW1/21]. The dialogue continued with Plaintiff No. 1 proposing, on 21<sup>st</sup> January 1983 [Ex. DW 1/18], a draft settlement that aimed to establish co-existence between the two parties, outlining an offer to compensate Defendant No. 1 with USD 1 million for their efforts in protecting their trademarks and for aiding Plaintiff No. 1 in their trademark registrations. A meeting to develop a co-existence arrangement and to collaboratively oppose third-party infringements was also suggested.

56. Defendant No. 1 asserted that by 1983, they had established a formidable brand image and significant value for their crocodile marks, with a reputation that extended across many countries. Plaintiff No. 1 and



Defendant No. 1 had been operating in distinct territories. However, when Plaintiff No. 1 attempted to enter the markets of Asian countries with their products, they encountered the strong presence of Defendant No. 1, whose crocodile marks enjoyed tremendous reputation and goodwill, effectively dominating these regions. This realization highlighted the challenges of market entry in regions where Defendant No. 1's marks were already well-established and highly regarded.

57. *Correspondence and clarification of trademark use:* On 10<sup>th</sup> February, 1983, Defendant No. 1's licensee in Singapore sent a letter to Plaintiff No. 1's attorney, enclosing representations of their existing crocodile marks [Ex. DW1/22]. The enclosed documents detailed three separate and distinct marks



– identified as A4, A3, and B1 in Ex. DW 1/16, respectively. Notably, B1 mark is the subject of contention in the current lawsuit. This correspondence was intended to clarify the scope of use and registration of these marks, underscoring the established rights and presence of Defendant No. 1's trademarks in the market.

58. The settlement proposal initiated a series of negotiations that ultimately culminated in the signing of the 1983 Agreement on 17<sup>th</sup> June, 1983 [Ex. PW 1/8]. The Defendants argued that the 1983 Agreement was expressly executed to resolve and settle existing disputes, legal actions, and controversies, significantly reducing the potential for conflict in their respective trademark uses across different markets. Central to this Agreement was the principle of mutual cooperation and co-existence, articulated clearly and unequivocally



within the document. The Agreement also envisioned a collaborative stance against third-party infringers, highlighting the expected level of cooperation between the parties across various jurisdictions. Crocodile International maintained that under the 1983 Agreement, the mutual intent was not only to co-exist peacefully, but also to extend cooperation globally wherever feasible, setting a precedent for future interactions. This intention was substantiated by the specific inclusion in Schedule A of five separate and distinct marks owned by Defendant No. 1, with the fourth mark (Annexure-A device), currently under dispute. Since 1983, Defendant No. 1 has actively used these marks, including Annexure-A device, in Singapore, Indonesia, and other countries as outlined in the Agreement.

59. Given these conditions, Crocodile International asseverated that Lacoste is arguably precluded from initiating an action alleging violation of intellectual property rights against Crocodile International, as the latter has adhered to the stipulations of the 1983 Agreement, which underscore their commitment to resolving trademark disputes amicably and cooperatively. This, they argued is established by a post Agreement communication dated 13<sup>th</sup> February 1984, issued by Defendant No. 1 to Plaintiff No. 1 [Ex. DW1/23]. In this communication, Defendant No. 1 purportedly clarified their position concerning the use of various crocodile marks across different countries. Defendant No. 1 highlighted that although the crocodile family of marks included a multitude of designs, they had decided to limit their use to the marks specifically listed in Schedule A of the 1983 Agreement. Additionally, Defendant No. 1 informed Plaintiff No. 1 of the concerted efforts they had undertaken to ensure that their marks and products were distinctively differentiated from those of Plaintiff No. 1 to minimize market



confusion, and uphold the spirit of cooperation and distinction as outlined in the 1983 Agreement.

60. The evidentiary value and significance of the documents marked as Ex. DW 1/18 to DW 1/23 shall be examined in a subsequent section that addresses the contemporaneous documents presented by Crocodile International.

**II.II. *Co-existence framework established by the 1983 Agreement [Ex. PW1/8]***

61. The key terms of the 1983 Agreement, which outline the mutual understanding between Plaintiff No. 1 (referred to as ‘LCL’ in the Agreement) and Defendant No. 1 (denoted by ‘LSM’ in the Agreement) regarding co-existence of their respective trademarks, are as follows:

“ **xx** ... **xx** ... **xx**  
*WHEREAS LSM and LCL wish to cooperate in the countries listed in Article -1 of this Agreement.*

**xx** ... **xx** ... **xx**  
*WHEREAS LSM and LCL agree that their respective emblem marks as shown in Schedule A and B can co-exist in the market concerned without confusion.*

*WHEREAS it is also the intention of the parties to cooperate in other parts of the world wherever possible.*

**xx** ... **xx** ... **xx**

**ARTICLE I – TERRITORY**

*This Agreement shall cover the following countries:*

- TAIWAN
- SINGAPORE
- INDONESIA
- MALAYSIA (Malaya, Sabah, Sarawak)
- BRUNEI

*Herein referred to as the Territory.*

**ARTICLE II – TRADEMARK REGSITRATIONS**



xx ... xx ... xx

3. LSM shall permit LCL to apply for the registration within the Territory of its various emblem trademarks as shown in Schedule B appended hereto and shall give LCL all possible assistance to obtain such registrations in the various classes of products and services under which LCL wishes to do business.

However, it is hereby agreed between the parties that LCL shall not use nor apply for the registration in the Territory of any Saurianlike trademark other than those shown in the said Schedule B and shall take all necessary steps to cancel and/or withdraw registrations and/or applications, if any, for any Saurian-like trademark other than those shown in that Schedule B.

xx ... xx ... xx

4. Likewise, LCL shall give all possible assistance to LSM to apply for the registration within the Territory of its own emblem trademarks as shown in Schedule A appended hereto in the various classes of products and services under which LSM wishes to do business.

LSM shall not use nor apply for the registration in the Territory of any Saurian-like trademark other than those shown in the said Schedule A and shall take all necessary steps to cancel and/or withdraw registrations and/or applications, if any, for Saurian-like trademarks other than that shown in Schedule A.

xx ... xx ... xx

ARTICLE III – COMPENSATION

In order to compensate LSM for the expenses incurred in the past for protection and defense of Saurian Trademarks within the Territory, LCL shall pay LSM the annual payments indicated in Schedule C appended hereto over the next 15 years commencing in 1982.

xx ... xx ... xx

ARTICLE IV – COOPERATION

1. Both parties undertake to cooperate technically in every possible manner within their own means and rights in the defense of the Saurian Trademarks against any third party infringers.

2. However, a decision taken by either party not to join in any legal action against such infringers shall not prevent the other party from proceeding alone at its own expense.



ARTICLE V – TERMINATION OF EXISTING LEGAL PROCEEDINGS AND RELEASES

1. *LSM and LCL agree that all law suits, legal actions, controversies, disputes and claims which are the subject of legal proceedings between them pending before any court or administrative body in any jurisdiction within the Territory shall be settled and discharged.*

2. *LSM and LCL therefore waive and abandon hereby any and all claims and counter-claims at any time made by them in respect of the use by either party of their respective Saurian Trademarks*

3. *As a consequence of the foregoing, LSM and LCL shall take all steps to execute such documents as may be necessary to discontinue, with prejudice, all pending proceedings.”*

62. Schedules A and B appended to the 1983 Agreement are as under:





63. The parties in their pleadings and evidence have not controverted the execution of the 1983 Agreement. However, its relevance and applicability to the Indian territory is the point of dispute. Lacoste has categorically denied the relevance of the 1983 Agreement [Ex. PW 1/8] to the current proceedings. They contended that the terms of the Agreement were geographically specific and did not extend to India. This geographical limitation, they argued, clearly delineates the boundaries of the influence of the 1983 Agreement, thereby excluding its application to any trademark disputes arising in India or other unlisted territories. This position underlines Lacoste’s challenge to Crocodile International’s assertions of a broader, implied scope of the Agreement, focusing the Court’s attention on the explicit terms and conditions as documented.

64. The preamble to the 1983 Agreement stipulates that Plaintiff No. 1 and Defendant No. 1 intended to cooperate in the ‘Territory’ delineated in Article I. It explicitly states that their respective emblem marks, as detailed in Schedules A and B, can co-exist in the specified markets without causing confusion. Crocodile International argues that, based on the parties’ overall intention to cooperate globally stated in the recitals, the principle of co-existence should apply beyond the specified Territory. This language suggests flexibility, and thus, requires a careful interpretation by the Court for determination of applicational boundaries of the 1983 Agreement.

### **II.II.I. *Geographical Limitations and interpretation***

65. Article I of the 1983 Agreement explicitly lists the territories covered: Taiwan, Singapore, Indonesia, Malaysia (including, Malaya, Sabah, and Sarawak), and Brunei. This specific enumeration of countries indicates that





the 1983 Agreement is intended to apply only within these jurisdictions. The mention of potential cooperation in other parts of the world does not extend the operative terms of the Agreement to India or implicitly include it within the scope of the Agreement. This is evident by the absence of any mention of India in the list of countries in Article I. The clauses concerning trademark registrations stipulated in Article II also emphasize operational limits within these defined territories. Therefore, the argument that the 1983 Agreement implicitly covers India lacks substantive contractual or documentary support based on the explicit territorial definitions provided within the Agreement itself.

66. Contracts must be expressed in precise and unambiguous terms. The entire tenor of the 1983 Agreement and its specific clauses clearly delineate the rights and obligations concerning the use of saurian trademarks by both parties within the defined territories. There is no documentary evidence or contractual provision supporting the inference that Plaintiff No. 1 expressly or impliedly agreed to extend the terms of the 1983 Agreement to encompass the Indian territory, whether under the notions of ‘understanding,’ ‘spirit of goodwill,’ ‘cooperation,’ or any other analogous terms. Given these considerations, the legal status, and implications of the 1983 Agreement must be confined to the explicit terms agreed upon by the parties. The situation in each country, including India, must be adjudicated based on the prevailing law and the specific rights and obligations arising from the parties’ conduct and explicit agreements, rather than any implied extension of purported spirit of the 1983 Agreement. The Court thus finds merit in the contention of Lacoste that the terms of this Agreement cannot be binding on them in the Indian territory.



67. This jurisdictional specificity is particularly relevant when considering the legal framework under which international trademark agreements operate. On this issue, it is also crucial to consider the principles of trademark law, particularly the concept of territoriality, which plays a decisive role in determining the scope of trademark agreements. Trademark rights are inherently territorial; they are confined to the jurisdictions in which they are granted and enforced. This principle of territoriality ensures that a trademark registered in one country does not automatically confer rights to the holder in another, unless explicitly stated through international agreements or treaties. In the context of the 1983 Agreement, the explicit listing of certain countries signifies a clear intention to limit the scope of the Agreement to those territories only. The lack of mention of India or any provisions for its inclusion at a later date reinforces this intention and aligns with the principle that trademark rights and obligations cannot be presumed to extend beyond the territories for which they were specifically negotiated.

68. The parties' intention to restrict the co-existence arrangement to the countries specified in the 1983 Agreement is also evidenced by the continuance of legal proceedings by Plaintiff No. 1 pertaining to the use and registration of parties' respective crocodile devices in various jurisdictions, such as Myanmar and China. Plaintiff No. 1's objections to the use of similar marks by Defendant No. 1 in other regions demonstrates their efforts to protect their trademark rights rigorously, indicating the restrictive territorial scope of the co-existence agreement.

The Partial Arbitral Award [Ex. P-1]



69. In resolving this issue, it is also imperative for the Court to consider the Partial Arbitral Award dated 15<sup>th</sup> August, 2011 [Ex. P-1] rendered in arbitration proceedings between Plaintiff No. 1 and Defendant No. 1 in Singapore, which also addressed the applicability of the 1983 Agreement beyond the territories explicitly listed therein. The dispute before the Tribunal originated from Defendant No. 1's registration of the trademark “



,” which exceeded the devices enlisted in Schedule A to the 1983 Agreement, in Indonesia. Although Indonesia is enlisted as ‘Territory’ under Article I of the Agreement, an issue concerning the territorial scope of 1983 Agreement was raised. The findings of the Arbitral Tribunal provide crucial insights into the interpretation and enforcement of the 1983 Agreement across additional territories. The relevant portions of the Award, which are extracted and analysed below, will shed light on how the Tribunal perceived the scope of the 1983 Agreement and whether it found any basis for its application in other international contexts beyond those explicitly mentioned:

*“The Tribunal’s construction of the Agreement*

... xx ... xx ... xx...

178. *There is also no dispute that these obligations relate to the territory only. **The Tribunal agrees and finds that these obligations, as set out in Article II, are clearly confined only to the five countries listed as ‘the Territory’ in the Agreement.***
179. *Crocodile International, however, goes further. It says that prior to the signing of the Agreement there was potential for disputes arising between the Parties in countries other than those five countries listed in the Territory because both Parties used saurian-like trade marks, Crocodile International using a left facing crocodile and Lacoste using a right facing crocodile or alligator. Thus, says Crocodile International, the Parties wished to do more than just settle the disputes in the five countries listed in the Territory and to provide a*



*framework for those countries going forward, they also wanted to provide a framework whereby disputes, wherever they arose, would not arise in the future, there would be cooperation between the Parties and each Party would be able to develop its own business. The Tribunal notes parenthetically that if this truly was the purpose of the Agreement, it has significantly failed. Lacoste says that there are or have been 123 pieces of litigation between the Parties. Crocodile International disputes the figure and says that it is only 84; either way it is a very substantial number.*

... xx ... xx ... xx...

185. *Lacoste argues that there are four pillars to the Agreement, limited geographical scope (Article I), coexistence (Article II), entry to the Territory (Article III), and cooperation (Article IV). In respect of the obligation of cooperation, Lacoste accepts that the obligation of cooperation is not limited geographically but argues that the cooperation extends only to the cooperation of both Parties in relation to third party infringers, is for the protection of the Parties' trade marks and is an obligation of technical co-operation only.*
186. *'Technical cooperation', according to Lacoste, is cooperation on such matters as investigations of infringements of the Parties' trade marks by third parties and the taking of action to prevent or stop such infringements.*
187. *Crocodile International says that cooperating technically is in contrast to commercial cooperation (e.g. joint marketing) but includes practical technical cooperation in matters concerning protection of the trade mark from attack.*
188. *Lacoste says that the reason why the obligation contained in Article IV is not limited geographically in the Agreement is that it might be necessary for the Parties to take action in countries outside the Territory to prevent infringements in countries within the Territory, the most obvious example being a manufacturer situated outside the Territory whose products (which contain infringing trade marks) are distributed and sold within the Territory. Crocodile International goes further and says that the proper construction of Clause 1 of Article IV includes an obligation that neither Party will seek to adopt for itself the other Party's marks as set out in Schedules A and B in any geographical region and that neither Party will attack the other Party's registered marks in any geographical region.*
189. *The Tribunal accepts Lacoste's arguments on the construction of the Agreement in relation to cooperation and coexistence.*
190. **In the first place it seems to the Tribunal that the Agreement is clear on its face in its meaning and that there is no ambiguity in**



- its use of language.*
191. **Article I of the Agreement clearly provides that the Agreement covers the five countries in the Territory and Article II also clearly limits the Parties' obligations under that Article to the Territory. The only Articles which do not refer to the Territory are Article IV in relation to co-operation and Article VII, the arbitration provision. The Tribunal rejects Crocodile International's argument that the words "in the market concerned", in the fourth recital of the Agreement are used to contrast with the countries listed in the Territory defined in Article I and relate to countries where market conditions are similar to any of those which exist in any of the five countries of the Territory, and would include any countries in Asia "at least".**
192. *The Tribunal finds that the words "in the market concerned" refer only to the countries listed under the Territory in Article I. Each of those countries is a "market". The countries together constitute the "Territory". Whilst it might have been clearer for the fourth recital, which in any event is only a part of the preamble to the Agreement, to refer specifically to the countries listed in Article I, the Tribunal is clear that "the market concerned" intended to refer to those countries. In the Tribunal's view, the fourth recital must be read subject to Article I of the Agreement, which plainly restricts the scope of the Agreement to the five countries listed. It states specifically that "this Agreement" covers the five countries in the Territory.*
193. **The Tribunal finds that the only contractual obligation which takes effect outside the Territory is that contained in Article IV. The Tribunal accepts Lacoste's contention that this only concerns technical cooperation in combating third party infringers outside the Territory. The obligation is expressed exactly in those words. The Tribunal does not accept that the fourth recital contains a collateral agreement, or creates a binding estoppel by convention (or otherwise) to the effect that the Parties' marks can coexist outside the Territory, as contended by Crocodile International.**
194. *In the first place the Tribunal finds that the fourth recital is entirely consistent with the remainder of the Agreement if one reads "the market concerned" in the sense identified above. The Tribunal is unable to give the phrase the extended meaning put forward by Crocodile International. If this was the correct meaning the Tribunal would have expected there to have been express wording to that effect as it would run contrary to the main provisions of the Agreement.*
195. *Secondly, in order to found an estoppel by convention, it must be shown that there was a course of dealing such that the Parties proceeded on the basis of an agreed interpretation of the contract*



- (see for example *Singapore Island Country Club v Hilbourne* [1996] 3 SLR (R) 418). In this case, far from there having been an established course of dealing between the parties under which they cooperated and coexisted, or a shared assumption by them that they would do so, there has been a multitude of disputes between the parties.
196. Thirdly, the argument that “in the market concerned” means the market in any countries where market conditions are similar to those in the five countries listed in the Territory, seems to the Tribunal extremely (and fatally) vague. Where are market conditions “similar”? Is the provision limited to Asia or is it applicable to other parts of the world? Are market conditions similar in Europe? Or North America? Commercial certainty would be necessary if Crocodile International’s argument of a collateral contract were to succeed and the Tribunal does not consider that Crocodile International’s interpretation of the phrase “in the market concerned” is sufficiently certain. Faced with a construction which, in the Tribunal’s view, is consistent with the geographical scope of the Agreement expressed in Article I and a construction which is at best vague, and which runs counter to Article I, the Tribunal has no hesitation in finding that the former construction is to be preferred.
197. As regards Crocodile International’s argument that implicit in Clause 1 of Article IV is an obligation by each Party that it will not “hi-jack” or attack the other’s marks outside the Territory, the Tribunal considers that, if the Parties had truly intended to impose such important mutual obligations, they would have clearly said so in the Agreement, which they have not done. This is discussed in further detail below when the Tribunal considers Crocodile International’s Counterclaim.
198. **Accordingly, the Tribunal finds that there is no obligation upon the Parties that their trademarks should coexist outside the Territory and that the Parties’ obligations of cooperation contained in Article IV, read with the fifth recital, whilst existing outside the Territory, are limited to technical cooperation in the manner described in paragraph 189 above.**
- ... xx    ... xx    ...    xx...
228. The Tribunal therefore finds that in putting forward a misconstruction of the effect of the Agreement, Crocodile International has not acted in breach of contract. This finding only affects Lacoste’s claim for damages in respect of past cases, and does not affect its claim for declarations on the effect of the Agreement which it seeks in connection with possible future litigation, and which will be considered in Section L below.
229. **Notwithstanding its finding that Crocodile International’s**



**misrepresentation or mischaracterisation of the Agreement is not a breach of the Agreement, the Tribunal would hope that, in the light of this Award, Crocodile International does not repeat such misrepresentation or mischaracterisation in any Court or tribunal in the future.**

... xx ... xx ... xx...

261. *The Tribunal has carefully considered Crocodile International's arguments but concludes that the granting of appropriate declarations by this Tribunal will assist both Parties in the event of further litigation between the Parties where the question of the scope and effect of the Agreement arises.*
262. *It is quite evident to the Tribunal from the record in these arbitration proceedings that the construction and effect of the Agreement has been mischaracterised by Crocodile International in various proceedings outside the Territory and that time has been taken up, sometimes considerable time, in dealing with this issue. The Tribunal is, by virtue of the arbitration agreement confirmed in the Agreement, the judge of the Agreement's true construction. The Tribunal accepts that its declarations, of themselves, may not have the effect of preventing future litigation between the Parties, and that other issues may arise, such as whether or not there is a likelihood of confusion between the Parties' marks, which fall outside the ambit of the Agreement. **However, the Tribunal hopes that the declarations it gives in this Award will at least put an end to the issue of the Agreement's true construction and effect.***

... xx ... xx ... xx...

#### M THE AWARD

... xx ... xx ... xx...

3. *The Tribunal declares that upon a true construction of the Agreement:*
- (i) *The Agreement does not require either Party to the Agreement to consent to registration of the other Party's trade marks outside the five countries in the Territory named in the Agreement, that is Taiwan, Singapore, Indonesia, Malaysia and Brunei, nor does the Agreement constitute such consent*
  - (ii) *The Parties' undertakings of technical cooperation are directed against third party infringers only and do not include any obligation not to object to the other Party's trade*



- marks enumerated in Schedules A and B of the Agreement.*
- (iii) *The preamble to the Agreement gives rise neither to an agreement nor a binding statement of facts according to which the trade marks enumerated in Schedules A and B of the Agreement can coexist outside the Territory.*

[Emphasis Supplied]

70. Thus, the Arbitral Tribunal determined that aside from the parties' commitment to collaborate technically to combat infringement by third parties, the terms of the 1983 Agreement cannot be extended to jurisdictions not originally specified in Article I of the Agreement. The Tribunal also specifically notes that the preamble to the 1983 Agreement cannot be construed as a binding obligation of parties to co-exist in jurisdictions beyond the delineated Territory. Additionally, the Tribunal noted that Defendant No. 1 must refrain from misrepresenting or mischaracterizing the nature and scope of 1983 Agreement before judicial fora outside the Territory. The Arbitral Tribunal's determinations specifically constraining the application of the terms of mutual co-existence to Territory, further reinforce this Court's view. Notably, this Partial Arbitral Award was made final on 18<sup>th</sup> April, 2016 [Mark X-1]. In his testimony, DW1 has accepted this fact.<sup>16</sup> This Award has also not been challenged and is binding on parties.

#### Testimony of DW1

71. The territorial constraints on applicability of the 1983 Agreement are also substantiated by deposition of DW1. During his cross-examination on 22<sup>nd</sup> February, 2018, DW1 has also admitted that the 1983 Agreement does not extend to India, in the following terms:

*“Q2. According to you, do the terms of the agreement extend to India?”*

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<sup>16</sup> Refer: Cross-examination conducted on 24<sup>th</sup> January, 2017.





*A. Specifically in the case of 1983 agreement, the record shows that it does not extend to India.”*

72. This categorical acknowledgment of DW1 reflects the parties’ intention to extend the cooperation framework contained in the 1983 Agreement to only select countries mentioned in Article I.

### Conclusion

73. In absence of an express provision or subsequent amendment incorporating India into the territories covered coupled with the findings of the Arbitral Tribunal’s, which has not been challenged by either of the parties, and DW1’s admission, any assumption of the applicability of the 1983 Agreement to Indian territory would contravene its letter and spirit. Therefore, any attempt by Defendant No. 1 to enforce rights or claim co-existence under the 1983 Agreement within Indian jurisdiction lacks a legal basis and is inconsistent with the territorial nature of trademark rights.

### ***II.III. Decision of the Supreme Court of the People’s Republic of China [Ex. DW 1/95]***

74. Crocodile International has presented the judgment dated 29<sup>th</sup> December, 2010 delivered in a suit for trademark infringement filed by Lacoste against Crocodile International as Ex. DW 1/95. The conflicted trademarks before the Supreme Court of China mentioned in Appendices 2 and 3 to the judgment, are as follows:


#### **Lacoste’s trademarks:**




#### **Crocodile International’s trademarks:**



75. The Supreme Court, while acknowledging the similarity between the trademarks, refused to grant any relief in view of the longstanding global co-existence of the parties, underscored by the 1983 Agreement. The Court opined that non-inclusion of China in the defined Territory would not preclude the Court from considering its impact and the parties' shared intention of concurrent existence. The restricted commercial reach of Lacoste's products in China also weighed with the Court in holding that no consumer confusion would ensue from the use of the two marks. Significantly, the Court directed Crocodile International to ensure steps to disassociate their labels from Lacoste's registered trademarks to the maximum extent possible.

76. The Court respectfully disagrees with the afore-noted decision. As discussed hereinabove, the scope of co-existence and mutual cooperation envisaged in the 1983 Agreement is confined to the territories delineated in Article I. This view is reinforced by the Arbitral Award [Ex. P-1] as well as the parties' conduct in protesting the use of their respective trademarks in different jurisdictions. By executing the 1983 Agreement, Plaintiff No. 1 and Defendant No. 1 did not envision an all-encompassing arrangement for co-existence worldwide. Moreover, in 2023, the Beijing Higher People's Court has followed a similar approach, upholding Lacoste's rights in a suit concerning the conflict between Lacoste's “” and Crocodile



International's “” titled *Xinjiang Kae E-commerce Co. Ltd. and Anr. v. Lacoste* and connected matters and bearing (2022) Jing Mingzhong, No. 293 [Ex. P-2].<sup>17</sup>

### III. Extended co-existence and the 1985 Letter

77. Building upon the foundation laid by the 1983 Agreement, Crocodile International cites several correspondences whereby Plaintiff No. 1 and Defendant No. 1 mutually agreed to the use of the other's trademarks, thus facilitating the mark's registrations across countries. These correspondences have been tendered in evidence as Ex. DW 1/24 to DW 1/79.<sup>18</sup> To demonstrate that the mutual co-existence understanding was formally extended to include Korea, India, Bangladesh, and Pakistan, Crocodile International specifically references to the letter dated 22<sup>nd</sup> August, 1985 [Ex. DW 1/80]. Through this communication, Defendant No. 1 assented to the trademark applications for Plaintiff No. 1's emblems in the afore-noted countries, in the following terms:

*“22 August 1985*

*I, Tan Hian Tsin, acting in my own name and on behalf of CROCODILE INTERNATIONAL PTE LTD of 89 Neil Road, Singapore 0208 (formerly known as LI SENG MIN CO SDN BHD) and/or of any individual or corporate body controlling, controlled by or under common control or affiliated with CROCODILE INTERNATIONAL PTE LTD, hereby undertake:*

*1. Not to oppose to present or future applications filed by LA CHEMISE LACOSTE for the hereunder LA CHEMISE LACOSTE's emblem marks or marks containing said emblems in Korea.*

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<sup>17</sup> On 31<sup>st</sup> July, 2024, with the consent of the counsel for parties, the judgment of Beijing Higher People's Court was admitted as evidence, and is being allocated an exhibit number – Ex. P-2.

<sup>18</sup> Collectively, “contemporaneous documents.”



2. *Should CROCODILE INTERNATIONAL's application or registration in Korea be opposed or in conflict with LA CHEMISE LACOSTE application(s) as defined in paragraph 1 hereabove, to supply LA CHEMISE LACOSTE upon its requests with the appropriate consent letter.*
3. *To withdraw in Korea oppositions eventually filed against LA CHEMISE LACOSTE's applications as defined in paragraph 1 hereabove and never filed, directly or indirectly, any invalidation or cancellation actions against said defined marks.*
4. *To supply LA CHEMISE LACOSTE, upon its request, with the appropriate consent letter(s), that LCL might need to register the hereunder LA CHEMISE LACOSTE's emblem marks or marks containing said emblem in BANGLADESH, INDIA and PAKISTAN.*



*Yours faithfully  
For and on behalf of  
CROCODILE INTERNATIONAL PTE LTD*

*TAN HIAN TSIN"*

78. Crocodile International traced the inception of the understanding entailed in the 1985 Letter to an offer from Plaintiff No. 1, proposing to exchange their market presence in Korea for Defendant No. 1's position in India, with Dr. Tan including Pakistan and Bangladesh within the ambit of this arrangement. This expansion was purportedly a gesture of goodwill, emphasizing the unequal market values between these regions. As per



Crocodile International, the practical enforcement and recognition of the 1985 Letter, as evidenced by various communications submitted in evidence, affirm its status as a legally binding contract. This Letter enabled Plaintiff No. 1 to register their trademarks in India, Bangladesh, and Pakistan – regions where Defendant No. 1 already held prior rights. Without Defendant No. 1’s consent, it would have been impossible for Plaintiff No. 1 to secure registrations and market its products in these territories. Defendants also argued that the 1985 Letter, which reflects a joint commitment to combat third-party infringers, aligns with the cooperation between the parties envisaged in the 1983 Agreement. However, Lacoste has allegedly not disclosed these critical documents, which not only continued the cooperative intent of the 1983 Agreement, but also explicitly extended it to new territories including India, Bangladesh, Pakistan, and Korea. This concealment, according to Crocodile International, undermines the full context of mutual co-existence and cooperation that was intended to transcend geographical boundaries.

79. On the other hand, Lacoste challenged this interpretation, pointing out that the 1985 Letter was unilaterally issued by Defendant No. 1, and lacks formal acknowledgment or a response from Plaintiff No. 1. They argued that it was neither addressed to Plaintiff No. 1, nor signed by them, thus lacking the essential of a bilateral agreement for extending the terms of the 1983 Agreement. The 1985 Letter, according to Lacoste, cannot be connected to the 1983 Agreement or to the use of the Annexure-A device, as it does not constitute a mutual agreement or bear any legal weight that modifies or extends the original terms set forth in 1983. They further highlighted that Plaintiff No. 1 had already registered their trademarks in India prior to the 1985 Letter, eliminating the need for any consent letter from Defendant No.



1 in this jurisdiction. Thus, they contended that reference in the 1985 Letter to provide consent letters ‘upon request’ to Plaintiff No. 1 had no practical implication since Plaintiff No. 1’s trademarks proceeded to registration in class 25 without such letters.

80. The Court has considered the afore-noted contentions. The 1985 Letter issued by Defendant No. 1 records their consent to the registration of two formative variants of Plaintiff No. 1’s crocodile devices in Korea and a commitment to deliver consent letter for registration of the said devices in India, upon Plaintiff No. 1’s request. This Letter, allegedly issued pursuant to negotiations between the parties to allow for concurrent presence in other regions, does not bear reference to any previous communications/ documents. There is no documentary or oral evidence evincing the events antecedent to the issuance of the 1985 Letter. In these circumstances, Crocodile International seeks to induct an inference to the 1983 Agreement in the 1985 Letter, advocating for application of the terms entailed in the Agreement 1983 to the Indian territory. This situation highlights the need for clear, specific, and actionable agreements in international trademark law. General expressions of support or non-opposition, as demonstrated in the 1985 Letter, must be backed by precise legal documentation that clearly delineate the rights and obligations of each party, especially in a complex legal landscape like trademark registration in foreign jurisdictions. Absence of this specificity undermines the characterization of the 1985 Letter as an ‘agreement’ as it does not reflect the reciprocal obligations of Plaintiff No. 1, particularly their no-objection to the use of Annexure-A device by Crocodile International, which is the foundation of this infringement action. Lacoste also pointed out the lack of evidence demonstrating Plaintiff No. 1’s demand and subsequent



use of the consent letter to secure trademark registration, which is bolstered by the following excerpts from the cross-examination of DW1 conducted on 22<sup>nd</sup> and 23<sup>rd</sup> February, 2018:

*“Q2. According to you, do the terms of the agreement extend to India?*

*A. Specifically in the case of 1983 agreement, the record shows that it does not extend to India.*

*Q.3 In your affidavit, you have referred to several co-existence documents. What according to you was the need for these documents?*

*A. This is to show the acknowledgement of each party in terms of the trademarks that are owned or used.*

**xx ... xx ... xx**

*Q.8 Is there any document to show that the plaintiff requested this so called 1985 letter from the defendant. If yes, please point out which is that document?*

*A. This is a letter Mark-J dated 22.06.1990 written by the plaintiff to defendant. In the second paragraph, it is stated “our agreement for South Korea given in counterpart of yours for India and Pakistan”. So in this statement, there was a request for consent letter for India in return for consent in South Korea.*

*Q.9 Are you saying that a 1985 consent letter was issued by the defendant upon a request made by the plaintiff in 1990?*

*A. I was not involved directly during that time but from the company history, I believe it was requested by the plaintiff*

*Q.10 Is there any other letter that you were able to locate in your company history making a request for a consent letter from the plaintiff to the defendant prior to 1985 against which the defendant purportedly issued the 1985 consent letter?*

*A. I have to check with my company records but the letters in the affidavit clearly shows that the plaintiff requires our consent letter to register the plaintiff marks.*

*The witness is directed to check the records of the company and inform on the next date of hearing.*

**xx ... xx ... xx**

*Q43. Have you checked the company records as stated by you in answer to question 10?*

*Ans. We cannot locate the specific request letter as of now but in a letter by the plaintiffs dated 13<sup>th</sup> February, 1989, there was an acknowledgement of consent letter made by defendants thus implying that there should have*



*been a request for such consent made by the plaintiffs.*

*Q44. Were you able to locate any consent letter issued by the plaintiffs to the defendant anywhere in the world consenting to use of the device forming annexure - A to the plaint?*

*Ans. The consent letters submitted along with my affidavit of evidence show the facts clearly.*

*Q45. Which particular consent letter are you referring to?*

*Ans. Since I do not recall all the consent letters so I leave it to the court to judge.”*

81. The elusive responses of DW1 noted above, including in reference to the Annexure-A device, further diminish the significance of the 1985 Letter to the present proceedings and cast doubts on its practical impact.

82. In determining the link of the 1985 Letter to parties' previous agreement regarding co-existence, reference must also be made to the Arbitral Award [Ex. P-1], which recognizes that while both parties adhered to the 1983 Agreement within the specified territories, outside those territories, each party's actions were governed by national laws on a case-by-case basis. Notably, in countries like Hungary, Japan, Myanmar, Uganda, India, Pakistan, Vietnam, Cambodia, Laos, Italy, and China, Lacoste often rejected Crocodile International's requests and opposed their applications based on the applicable national laws, indicating a strategic and legal approach that varied significantly from the cooperative spirit intended in the 1983 Agreement. Thus, while Crocodile International may argue for an extended understanding of mutual co-existence, the legal realities and Lacoste's actions reflect a more complex interplay of consent, trademark rights, and national legal frameworks.

83. Extensive arguments were presented to the Court concerning the interpretation of trademarks listed in Schedule A to the 1983 Agreement, with





Crocodile International emphasizing that the Schedule A includes five distinct trademarks, including the Annexure-A device. Crocodile International contended that Lacoste permitted the use of Annexure-A device in India through the arrangement entered in 1985. Applying this interpretation, they argued that 1985 Letter permits use of Annexure-A device on terms stipulated in the 1983 Agreement. However, this position is not supported by the 1985 Letter, where Defendant No. 1 has explicitly restricted their consent to only two devices of Plaintiff No. 1 mentioned in Schedule B of the 1983 Agreement, and not all of them. This decision to confine consent to only two devices of Schedule B reinforces the view that the terms of co-existence of 1983 Agreement do not apply to India, and co-existence arrangements, if any, were specifically tailored to the region in question. Thus, the specific context in which the 1985 Letter was issued becomes critical, a point that Defendant No. 1 has not adequately demonstrated. However, since Crocodile International heavily relied on the contemporaneous documents to invalidate Lacoste's claims, attempting to show Plaintiff's subsequent acknowledgment of the co-existence arrangement within India, the Court now proceeds to deal with the same.

### **III.I. *The contemporaneous documents***

84. For ease of reference and a convenient read, the relevant communications referred by Crocodile International are encapsulated in the tabular chart annexed with the judgment as Annexure-B.

85. Ex. DW 1/13 to Ex. DW1/35, Ex. DW 1/37 to DW 1/40 and Ex. DW 1/45 to DW 1/79 were tendered in evidence on 23<sup>rd</sup> January, 2017. Lacoste objected to the aforesaid documents being read into evidence, citing failure to



produce originals before the Court. It is their contention that Defendants have not led any secondary evidence and therefore, the contemporaneous documents have not been proved in accordance with law, and have no evidentiary value. The documents were tentatively given an exhibit number, leaving these objections to be decided at the final stage. The admissibility and strength of the contemporaneous documents are detailed in the forthcoming segment of the judgment.

### **III.I.I. *Probative value of the contemporaneous documents***

86. Crocodile International has presented photocopies of the communications Ex. DW 1/18 to Ex. DW 1/23 and the contemporaneous documents submitted as Ex. DW 1/24 to Ex. DW 1/35, Ex. DW 1/37 to Ex. DW 1/40, and Ex. DW 1/45 to Ex. DW 1/79. Apart from DW 1/36 and DW 1/44, these documents have been denied by Lacoste. Therefore, to take aid of the above-mentioned documents in invalidating Lacoste's claim, Crocodile International must establish a case for leading secondary evidence in order to legally prove the contents of the said documents. On this aspect, referring to the holding of the Supreme Court in *Dhanpat v. Sheo Ram (Deceased) through LRs and Ors.*,<sup>19</sup> they argued that the Court's permission for leading secondary evidence is not required, so long as their pleadings and evidence sufficiently justify this approach. The principle of law propounded by Crocodile International cannot be disputed. Section 65 of the Evidence Act, 1872 enlists the circumstances where secondary evidence as to the existence, condition or contents of a document may be submitted in trial. In *H. Siddiqui*

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<sup>19</sup> (2020) 16 SCC 209.



*(Dead) by LRs v. A. Ramalingam*,<sup>20</sup> it has been held that the right to adduce secondary evidence is not unrestricted, and the non-production of the original document must be accounted for in the factual foundation laid by the party.

87. On a scrutiny of the pleadings and evidence presented by Crocodile International, the Court is unable to discern the foundational facts explaining the non-availability of the original letters by the Defendants. There is no averment to this effect in the written statement. While the affidavit by way of evidence of DW1 mentions that ‘office copies’ of certain documents have been filed on record, there is a notable absence of any reason justifying the non-production of originals. The Defendants ought to have led evidence demonstrating the circumstances entailed in Section 65 of the Evidence Act, either through examination of their witnesses or cross-examination of the Plaintiffs’ witnesses.<sup>21</sup> In the course of his cross-examination on 25<sup>th</sup> January, 2017, DW1 deposed as under:

*Q. Please see para no.19 of your affidavit Ex.DW1/A, do you have originals of documents other than Ex.DW1/36 and Ex.DW1/41 to Ex.DW1/44?*

*Ans. I do not know. Vol. but some documents were sent in original to the plaintiffs, so defendant no.1is not having originals of the same.*

88. DW1 has vaguely alluded to “some documents,” originals whereof were sent to Plaintiff No. 1. Such an unclear and imprecise explanation fails to qualify the criteria for foundational pleadings or evidence envisioned for leading secondary evidence under Section 65 of the Evidence Act. Resultantly, the Court finds that the documentary evidence marked as Ex. DW 1/18 to DW 1/23, Ex. DW 1/24 to Ex. DW 1/35, Ex. DW 1/37 to Ex. DW

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<sup>20</sup> (2011) 4 SCC 240.

<sup>21</sup> See: *Prem Chandra Jain (Deceased) represented by LRs v. Sri Ram (Deceased) represented by LRs*, 2009 SCC OnLine Del 3202.



1/40, and Ex. DW 1/45 to Ex. DW 1/79 has not been proved in accordance with the prescribed legal standard. There is no foundational evidence authenticating that the alleged copy is a true copy of the original and thus, the documents are inadmissible in evidence and cannot be considered by this Court.<sup>22</sup>

### **III.I.II. *Significance of the contemporaneous documents to merits of the case***

89. Despite the earlier noted observations about the inadmissibility of Ex. DW 1/18 to DW 1/23, Ex. DW 1/24 to Ex. DW 1/35, Ex. DW 1/37 to Ex. DW 1/40, and Ex. DW 1/45 to Ex. DW 1/79, the Court has nonetheless reviewed these documents to evaluate the strength of Crocodile International's argument about the co-existence of Lacoste's crocodile devices with the Annexure-A device in India, as allegedly outlined in the 1985 Letter.

*Ex. DW 1/18 to 1/23:*

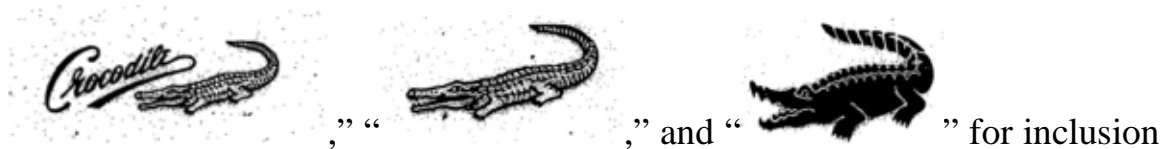
90. The communication marked as Ex. DW1/18 was written by Plaintiff No. 1 to Defendant No. 1 proposing the terms of an amicable resolution of their trademark disputes. Ex. DW 1/19 is Defendant No. 1's cease-and-desist notice dated 16<sup>th</sup> July, 1980 issued to Plaintiff No. 1's licensee in Singapore, protesting the use of crocodile device by the licensee in Singapore. Ex. DW 1/20 and DW 1/21 are the communications dated 30<sup>th</sup> July, 1980 and 09<sup>th</sup> December, 1980, respectively, ensuing from the cease-and-desist notice. In Ex. DW 1/20, Plaintiff No. 1's licensee, asserting their rights over the "LACOSTE" trademark and alligator device in Singapore, emphasized the

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<sup>22</sup> See: *Vijay v. Union of India and Ors.*, SC Neutral Citation: 2023 INSC 1030.



points of distinction between the parties' marks, customer base, price range and product quality. As per Plaintiff No. 1's licensee, these factors dispel consumer confusion between the brands. Ex. DW 1/21 contains Plaintiff No. 1's offer to amicably resolve the perceived trademark conflicts, which apparently culminated in the 1983 Agreement. Crocodile International strongly urged that the communication dated 10<sup>th</sup> February, 1983 [Ex. DW 1/22] establishes that the 1983 Agreement envisaged co-existence *vis-à-vis* the Annexure-A device. This communication, preceding the execution of the 1983 Agreement, proposed three separate and distinct marks – “



,” “ ,” and “ ” for inclusion within the Agreement's scope. Ex. DW 1/23 dated 13<sup>th</sup> February, 1984 was addressed by Defendant No. 1 to Plaintiff No. 1 highlighting their extensive and consistent efforts to avoid consumer confusion in the market.

91. Upon careful review, the Court finds that while these documents form part of the preliminary discussions leading up to the formal agreement, their relevance to the present proceedings concerning the Indian territory is limited. The arguments and assertions made within these letters pertain primarily to regions explicitly outside of India and as such, do not directly impact the legal standing or implications within the Indian jurisdiction. The territorial specificity of trademark rights, as outlined in previous discussions, restricts the enforceability and relevance of objections and rights to the territories in which they are legally recognized and registered. Moreover, the 1983 Agreement, which was subsequently finalized, explicitly delineates the territories where co-existence was agreed upon, and India is not among them.



The Defendants have not provided concrete evidence to support their claim that these letters indicate a global co-existence intent that includes India. The explicit terms of the 1983 Agreement, which followed these letters, supersede the preliminary discussions, and outline the agreed-upon territories for co-existence.

92. Therefore, Ex. DW 1/18 to DW 1/23 do not substantiate the Defendants' claim of an extended co-existence agreement covering India. Ex. DW 1/18 to Ex. DW 1/22 are letters precursor to the 1983 Agreement, whereas Ex. DW 1/23 demonstrates Defendant No. 1's proactive trademark management in other regions, and does not hold independent relevance in the current context. As such, they are rejected as evidence of any binding agreement applicable to the use of the Annexure-A device in India.

*Ex. DW 1/24 and Ex. DW 1/25:*

93. Ex. DW1/24 is the letter dated 10<sup>th</sup> February, 1989 addressed by Defendant No. 1 to Plaintiff No. 1, which Crocodile International cites as evidence of the ongoing spirit of co-existence between the parties in Asia. This letter references to Defendant No. 1's intention to not oppose Plaintiff No. 1's trademark application in India, and a reciprocal offer to seek assistance of Plaintiff No. 1 in registering the "CROCODILE" mark in the Middle Eastern countries. Ex. DW 1/24 was responded to by Defendant No. 1 on 13<sup>th</sup> February, 1989 [Ex. DW 1/25], recognizing that Defendant No. 1's choice to not oppose Plaintiff No. 1's application was in line with the arrangement arrived at in 1985. The Defendants asserted that Ex. DW 1/25 contains an express acknowledgment of the '1985 agreement,' suggesting a



mutual recognition of extension of terms beyond the specific territories initially outlined in the 1983 Agreement.

94. Lacoste, on the other hand, contested the implications that Crocodile International seeks to draw from these documents. They pointed out that while Ex. DW 1/24 expresses a willingness from Defendant No. 1 not to oppose Plaintiff No. 1's mark in India, it lacks details about which particular mark the consent pertains to. Additionally, Lacoste argued that Ex. DW 1/24 is CC'd to Mr. Bernard Lacoste, linking it to an earlier correspondence dated 21<sup>st</sup> January, 1983, which initially proposed co-existence between the parties. This connection is being misused by Crocodile International to argue that there was a consistent, mutual understanding aimed at supporting each other's trademark registrations across various jurisdictions, including India.

95. In the opinion of the Court, these documents do not establish any binding agreement that was formally signed in 1985 in relation to India pertaining to the Annexure-A device. The reference to a general spirit of co-existence in Ex. DW 1/24 is insufficient to establish a binding agreement applicable to new territories, such as India. For an agreement to be enforceable, it must be clear, specific, and mutually acknowledged, which this letter fails to achieve, rendering it ineffective as a basis for use of Annexure-A device in India. Likewise, Ex. DW 1/25, even if taken at face value, does not constitute legal evidence of an enforceable co-existence agreement *vis-à-vis* Annexure-A device, and is thus, irrelevant to the instant lawsuit.

*Ex. DW 1/26 (colly):*

96. Ex. DW 1/26 comprises of the letter dated 06<sup>th</sup> March, 1989 of Defendant No. 1, apprising Plaintiff No. 1 of the prevalence of counterfeit



shirts of Lacoste in Indonesia and the ensuing communications dated 13<sup>th</sup>, 14<sup>th</sup>, and 23<sup>rd</sup> March, 1989 deliberating the legal avenues for combating the problem. Through these documents, Crocodile International sought to portray a co-existence arrangement between the parties that embraces various countries, and argued that same should apply to India. However, in the Court’s view, since Indonesia comprises the ‘Territory’ defined in Article I of the 1983 Agreement, the parties’ conjoint efforts to protect their trademark rights within Indonesia do not advance the Defendants’ case. Instead, Ex. DW 1/26 further fortifies the view that parties’ collaboration was restricted to specific regions.

*Ex. DW 1/27 (colly):*

97. This exhibit includes a letter from Defendant No. 1 to Plaintiff No. 1 dated 15<sup>th</sup> June, 1990, and a corresponding reply from Plaintiff No. 1 of 22<sup>nd</sup> June, 1990. In the communication dated 15<sup>th</sup> June, 1990, Defendant No. 1 *inter alia* requested Plaintiff No. 1 to not object to their application for the trademark “CROCOKIDS” in Korea, citing the co-existence agreement allowing registration of “CROCODILE” mark in Defendant No. 1’s favour, in exchange for their consent to Plaintiff No. 1’s registration in India. In their reply issued on 22<sup>nd</sup> June, 1990, Plaintiff No. 1 refused to abide by Defendant No. 1’s request, clarifying that the “*agreement for Korea given in counterpart of yours for India and Pakistan concerned your original crocodile device and word trademark.*” In their oral arguments, Crocodile International claimed that the reply letter from Plaintiff No. 1 constitutes an admission that there was an agreement to mutually refrain from opposing each other’s trademarks in India. This interpretation is used to argue that there was a recognized and





ongoing understanding between the parties regarding non-opposition to the Annexure-A device in India. Lacoste, however, disputes this interpretation. They contended that the subject matter of Ex. DW 1/27 does not pertain to the Annexure-A device. Specifically, item number 1 in the correspondence references a third-party trademark application No. 435480 for the trademark



“ ” in the name of Gaja Shoes, which is unrelated to the devices directly contested between the parties.

98. The Court finds that the clarification supplied by Plaintiff No. 1 in their response clearly demarcates the extent of their consent to Defendant No. 1’s composite trademark that entails the crocodile device and the word ‘Crocodile.’ This suggests that the correspondence was focused on specific trademark issues, rather than establishing or acknowledging a broad non-opposition agreement in India, encompassing the Annexure-A device. Therefore, Ex. DW 1/27 does not substantiate Crocodile International’s claim of an agreed strategy of mutual non-opposition across all trademarks in India, especially in the absence of a formal, documented agreement to that effect. The legal significance of this correspondence is limited to the trademarks specifically discussed, and does not extend to a broader contractual understanding between the parties.

*Ex. DW 1/28 to DW 1/31:*

99. Ex. DW 1/28, Ex. DW 1/29 and Ex. DW 1/30 are Defendant No. 1’s letters to Plaintiff No. 1, dated 16<sup>th</sup> August, 1990, 20<sup>th</sup> September, 1990, and 28<sup>th</sup> September, 1990, respectively. In the said communications, Defendant



No. 1 describes the co-existence arrangement in Korea, India, and Pakistan as a “gentleman’s agreement,” and offers suggestions to maintain this co-existence in the territories outlined in the letters. The letter dated 08<sup>th</sup> January, 1991, marked as Ex. DW 1/31, was addressed by Plaintiff No. 1 to Defendant No. 1, apprising Defendant No. 1 of the course of action adopted by Plaintiff No. 1 in respect of third parties operating in South Korea, where a “gentleman’s agreement to coexist” subsisted between the parties. Through these documents, Crocodile International sought to demonstrate an ongoing intent for co-existence under the terms of the 1985 Agreement. However, Lacoste contested the significance and implications of these letters, pointing out that Ex. DW 1/28 to Ex. DW 1/30 were unilateral communications from Defendant No. 1.

100. The exhibits referred above also do not pertain to the Annexure-A device specifically contested in this case. As highlighted by Lacoste, Defendant No. 1, within Ex. DW 1/28 to Ex. DW 1/30 itself, acknowledges that the mark accepted by Plaintiff No. 1 in certain countries is referred to as the “Crocodile Brand,” which is distinct from the Annexure-A device. The analysis of these letters must consider the principles of contract and trademark law, particularly focusing on the requirement for mutual consent and clear, bilateral agreements for co-existence to be enforceable. Additionally, the context of the correspondences is crucial. Without explicit references to the Annexure-A device, these letters cannot be assumed to demonstrate an ongoing mutual understanding and intent for co-existence, implying that Plaintiff No. 1 agreed to a non-formal, yet binding, arrangement concerning the use of the Annexure-A device in India. Moreover, for any “gentleman’s promise” or informal understanding to have legal standing, there must be clear



evidence of mutual consent and acknowledgment from both parties. Informal understandings or promises, unless clearly documented and mutually agreed upon, do not hold the same legal weight as formally executed agreements.

101. Thus, the lack of specific references to the Annexure-A device undermines the argument that these letters constitute an acknowledgment of co-existence regarding the trademark in question in the current proceedings. The specific acknowledgment by Defendant No. 1 that only certain aspects of their branding were accepted by Plaintiff No. 1 in some countries is crucial as it delineates the boundaries of what was agreed upon by the parties. Given these considerations, Ex. DW 1/28 to Ex. DW 1/31 are only indicative of Defendant No. 1's perspective and intentions, rather than as conclusive proof of a mutual, legally binding agreement on trademark co-existence in India in relation to the Annexure-A device.

*Ex. DW 1/32 to Ex. DW 1/35:*

102. Defendant No. 1's communication dated 01<sup>st</sup> February, 1993 [Ex. DW 1/32] raises concerns over a raid executed by Plaintiff No. 1's legal representative at the premises of Defendant No. 1's licensee in Bangkok. In this letter, referencing to the 'good relation and co-operation' of the parties, Defendant No. 1 had offered to counsel their licensee not to proceed against Plaintiff No. 1 in Bangkok. Ex. DW 1/34 (dated 24<sup>th</sup> February, 1994) and Ex. DW 1/35 (dated 18<sup>th</sup> May, 1994) are letters of Defendant No. 1 underlining their consistent efforts to distinguish their trademarks from Plaintiff No. 1's across various markets. Ex. DW 1/33 is a letter by Defendant No. 1, expressing gratitude to Plaintiff No. 1 for their consent to the registration of the "crocodile & device" trademark in Pakistan as per parties' co-existence



arrangement for India, Korea, and Pakistan. The Plaintiffs strongly refuted Defendants' implied understanding of spirit of goodwill/ cooperation from these documents, asserting that these letters are unilateral communications from Defendant No. 1 and do not specifically pertain to the Annexure-A device.

103. These exhibits must be evaluated on the anvil of specific references to the Annexure-A device together with an explicit mention of the Indian market, which are noticeably absent from the letters. In fact, Lacoste's consistent clarification that consent was only limited to the original crocodile device is underscored by Ex. DW 1/33, which indicates that Plaintiff No. 1 supposedly furnished a no-objection for registration application of the mark consisting of crocodile device and the word 'Crocodile' in Pakistan. This clearly indicates that there was no broader, generalized enforceable agreement *qua* Annexure-A device that could be inferred to apply to India. The legal relevance of these documents is limited to demonstrating Defendant No. 1's perspective, and cannot substantiate a claim of a mutual, binding agreement impacting the current legal proceedings.

*Ex. DW 1/36 and Ex. DW 1/37:*

104. The above-referred exhibits are crucial in ascertaining the alleged cooperation between parties regarding the use of standalone saurian device by Crocodile International in Korea under the 1985 Letter. Ex. DW 1/36 was issued by Plaintiff No. 1 on 29<sup>th</sup> March, 1995, protesting the use of a "*crocodile without the signature crocodile above*" by Defendant No. 1's licensee in the Korean market. Plaintiff No. 1's grievance noted in Ex. DW 1/36, is reproduced below:



*“Dear Mr. Tan,*

*We have received your fax dated March 27, 1995 and thank you for the instructions you gave to your Licensee concerning the deletion of the wording “FRANCE” and “PARIS” from the brochure and the withdrawal of such from the market.*

*We will, within the next weeks, ask our Licensee to check if yours has complied with your request and of course we will let you know.*

*Unfortunately, as regards the second issue raised in my letter, related to the use in Korea by your Licensee of a Crocodile without the signature Crocodile above, your answer is not at all satisfactory.*

*As you certainly know, our products with our Crocodile trademark have been distributed and sold on the Korean market since 10 years and in Korea, amongst other countries, a Crocodile on a garment on a product whatsoever necessarily implies, in the mind of the public, that is a LACOSTE garment or a LACOSTE product.*

*Accordingly, if we can coexist on the Korean market, the condition is that the design of your emblem does not create any possibility of confusion with ours which is not the case as it is its exact replica, the only difference being that it looks left.*

*We consider that the Crocodile as used by your Licensee on the chest of the polo-shirt is too close to ours and infringes our trademark rights as it is quite different from the shape of the one registered.*

*This is also the opinion of our Licensee, the SUKWANG Company, and of our Trademark Agent.*

*We accordingly request that your Licensee uses on the products a Crocodile strictly identical to the one you have been able to register, with our consent, i.e. not only looking left but also thinner, longer and in an oblique position.*

*Unless this be done, we and our Licensee shall have no alternative but to take the necessary legal steps for the protection of our Crocodile emblem.*

*Thank you to let us know your decision within a fortnight.*

*Looking forward to hearing from you.*

*Yours sincerely,*

*Sd/-  
Christian LONDON  
Legal Manager”*



105. The afore-noted communication has not been refuted by Lacoste. Instead, they argued that this letter clarifies that co-existence is only feasible if the emblem used by Crocodile International is not an exact replica of Lacoste's mark, with the sole difference being the direction that the crocodile faces. This indicates that Plaintiff No. 1's consent under the parties' understanding of 1985 envisions registration of the crocodile device which entails the word 'Crocodile' alongside the crocodile device. Ex. DW 1/36 specifically addresses issues related to use of crocodile device without the accompanying signature 'Crocodile' on top *i.e.*, the Annexure-A device. Ex. DW 1/37 is the response from Defendant No. 1 dated 06<sup>th</sup> April, 1995. During oral arguments, Crocodile International contended that this letter addresses and clarifies the contention regarding mention of five and three marks in Schedule A of the 1983 Agreement and supports their position on the mutual understanding of trademark use and co-existence under the 1985 Letter. The Court finds that Ex. DW 1/37 is only a response to the specific objection raised by Plaintiff No. 1. Plaintiff No. 1's objections to the use of the crocodile device without 'Crocodile' signature underscore their insistence on clear differentiation between the trademarks to avoid consumer confusion. The response from the Defendant, therefore, must be viewed within the context of addressing specific conditions for trademark use rather than establishing a comprehensive co-existence agreement, envisaging the Annexure-A device within its ambit.

106. In conclusion, Ex. DW 1/36 and Ex. DW 1/37, while indicative of some level of understanding between the parties regarding the crocodile device accompanied with the word 'Crocodile,' does not substantiate Crocodile International's claims of a broader co-existence agreement encompassing the



Annexure-A device in the Indian market. Rather, the letter's specific focus and the conditions outlined by Plaintiff No. 1 for acceptable co-existence further reinforces that Plaintiff No. 1 never consented to the use of Annexure-A device even in Korea, a purported co-existence agreement country.

*Ex. DW 1/38 to Ex. DW 1/40:*

107. Ex. DW-1/38 (letter dated 25<sup>th</sup> July, 1995), Ex. DW 1/39 (letter dated 28<sup>th</sup> July, 1995) and Ex. DW 1/40 (letter dated 02<sup>nd</sup> August, 1995) are correspondences between the parties seeking to establish a co-existence regime in China. In these communications, both parties refer to an arrangement of 22<sup>nd</sup> August, 1985 and thus, Crocodile International relied upon these documents to demonstrate the acknowledgement of co-existence and the applicability of the 1985 Agreement.

108. As these exhibits do not address the Annexure-A device directly, which is a crucial aspect of the current dispute, they cannot be construed as evidence of an agreement related to its use in India. Thus, these documents hold limited legal weight in the context of the current dispute.

*Ex. DW 1/41:*

109. Ex. DW 1/41 is the refusal by Plaintiff No. 1 to Defendant No. 1's request for consent to trademark registration in Vietnam. The contents of the document neither reveal the trademark in question nor a cooperation agreement in Vietnam. Nonetheless, in absence of cogent proof, any supposed collaboration in Vietnam would not extend to India. Therefore, Ex. DW 1/41 is not relevant to the instant dispute.



*Ex. DW 1/42:*

110. Ex. DW-1/42 is a letter dated 13<sup>th</sup> November, 1997, which Crocodile International has relied upon to argue that Plaintiff No. 1 admitted to the standalone saurian device (Annexure-A device) forming a part of the 1983 Agreement. Through this letter, Plaintiff No. 1 opposed the use of a crocodile emblem facing left on the suitcases manufactured by Defendant No. 1. The letter notes as follows:

*“Dear Mr Tan,*

*One of our representatives took the attached photo in the Mitsukoshi Department Store in Taipei showing suitcases bearing a Crocodile emblem looking left which is the exact mirror representation of our Lacoste Crocodile emblem.*

*May we remind you that the Crocodile devices you have been authorized to use or register according to the provisions of our Settlement Agreement of June 1983 are strictly limited to ones:*



*We consider that this is a strong and unacceptable infringement to said Agreement and to our trademark rights.*

*We suppose that this line of products has been licensed by you to a third party. Accordingly, we would appreciate that you ask your licensee to immediately stop the manufacturing and selling of these products and modify their branding including the labels, the leaflets, etc... according to our Agreement.*

*We are sure that you understand our position and are confident that you will take the necessary steps in order to maintain our peaceful coexistence in the markets agreed between us.*

*Yours faithfully,*

*Sd/-  
Christian LONDON”*





111. Lacoste explained that their representative in Taiwan discovered a crocodile emblem being used by Defendant No. 1, which was an exact mirror image of Plaintiff No. 1's crocodile device. Consequently, Plaintiff No. 1 immediately wrote to Defendant No. 1, highlighting this issue and reminding them that under the 1983 Agreement, they were only permitted to use two specific types of crocodile devices as specified in the Agreement. The use of any other device, including the contested Annexure-A device, would constitute a breach of the 1983 Agreement. However, Lacoste submitted that there was an error in reproducing the two crocodile devices in paragraph No. 2 of the letter, noted above. They submitted that the annexure to the letter clearly depicts the objectionable device used by Defendant No. 1 as “



,” which is an exact mirror representation of Plaintiff No. 1's crocodile device.

112. The letter clearly identifies the objectionable use of the crocodile device in Taiwan, indicating that Plaintiff No. 1 was actively monitoring and enforcing the terms of the 1983 Agreement. The annexure provides visual evidence of the device contested in the letter, supporting the Plaintiffs' assertion. Thus, the acknowledgment of an error in the letter regarding the specific objection does not undermine the overall argument as it clarifies the context in which the objection was made. Irrespective, given the failure of Defendant No. 1 in demonstrating application of the terms of 1983 Agreement to the Indian territory discussed hereinabove, the issue of inclusion of standalone Annexure-A device in Schedule A of the 1983 Agreement becomes irrelevant to the dispute at hand. Therefore, Ex. DW 1/42 does not



buttress the Defendants' claim of an agreed-upon use of the Annexure-A device within India.


*Ex. DW 1/43:*

113. Ex. DW 1/43 is a letter dated 02<sup>nd</sup> February, 1998 from Plaintiff No. 1 to Defendant No. 1, wherein Plaintiff No. 1 objected to the use and registration of the crocodile device by Defendant No. 1 in Myanmar, labelling the same as a contravention of the agreements made in 1984 and 1985, which were specific to certain countries. As per Crocodile International, this letter suggests an acknowledgement of the ongoing mutual understanding and willingness to co-exist under the terms outlined in the 1985 Agreement.

114. This letter's content does not indicate mutual consent to extend the 1983 Agreement to India or acknowledges the Annexure-A device. Instead, it reaffirms Plaintiff No. 1's efforts to restrict the Agreement's applicability and protect their trademarks from unauthorized use in countries outside the agreed territories, highlighting their vigilance in protecting their trademark rights. Therefore, this document also does not substantiate the Defendants' claims.

*Ex. DW 1/44:*

115. This letter, dated 28<sup>th</sup> May, 1998, clarifies the scope of parties' co-existence arrangement prevalent in Korea. Through this communication, Plaintiff No. 1 raised concerns regarding use of a crocodile emblem facing right by Defendant No. 1's licensee. Plaintiff No. 1 stressed that Defendant

No. 1 was authorized to register the mark “  ” in Korea and use of other variants of the crocodile symbol by Defendant No. 1 would constitute infringement of Plaintiff No. 1's trademark rights. This explicit



acknowledgement of the ambit of parties' understanding for a harmonious co-existence in Korea, which forms the subject matter of the 1985 Letter, unequivocally proves the reluctance of Plaintiff No. 1 to permit use and registration of designs other than the composite crocodile device, including Annexure-A device, by Defendant No. 1.

*Ex. DW 1/45 and Ex. DW 1/46:*

116. Ex. DW 1/45 is a letter dated 18<sup>th</sup> December, 1998. Through this letter, recognizing that parties have been co-existing in several Asian countries as per specific written agreements, Plaintiff No. 1 protested the infringement of their exclusive rights over their trademarks in China. Further, they also objected to the manner of use of crocodile device in India. Ex. DW 1/46 is Defendant No. 1's response to Ex. DW 1/45, offering to mutually resolve the issue in India. Ex. DW 1/45 is pivotal in confirming Lacoste's position regarding the territorial scope of the 1983 Agreement and their consistent opposition to any unauthorized use of the crocodile trademark by Crocodile International, ensuring that no implied consent or co-existence in respect of the Annexure-A device can be inferred in territories outside the agreed regions, including India.

*Ex. DW 1/47 to Ex. DW 1/79:*

117. Ex. DW 1/47 to Ex. DW 1/79 consist of a series of consent letters exchanged between the parties. Crocodile International argued that this collection of consent letters, covering various countries, demonstrates an overarching intent of co-existence between the parties. They suggested that



the issuance of these consent letters reflects a mutual understanding and willingness to allow the use of certain trademarks in different jurisdictions.

118. The consent letters included in Ex. DW 1/47 to Ex. DW 1/79 pertain to various countries, reflecting the parties' agreements in those specific jurisdictions. However, the absence of any consent letter related to the use of Annexure-A device in India underscores Lacoste's stance and weakens Crocodile International's arguments. For a co-existence agreement to be relevant to the current dispute, it must explicitly cover the specific trademark in question. The issuance of consent letters in various jurisdictions does indicate a willingness to co-exist under certain conditions. However, this willingness does not automatically extend to all trademarks or all countries. Each consent letter must be assessed based on its specific terms and the jurisdictions it covers.

119. Therefore, these documents do not substantiate Crocodile International's claims of a broader co-existence agreement applicable to the current dispute. The legal relevance of these consent letters is confined to the specific countries and trademarks they explicitly address, reinforcing Lacoste's position regarding the territorial and trademark limitations of their agreements.

**III.III. *Does the mutual co-existence under the 1985 Letter apply to the Annexure-A device in India?***


120. The 1985 Letter, as argued by Crocodile International, purportedly extended the mutual co-existence understanding founded in the 1983 Agreement to additional territories, including India. They assiduously maintained that their right to use the Annexure-A device in India, contested



in the present proceedings, originates from an agreement established in 1985 between the parties. Crocodile International contended that the parties had a mutual understanding for harmonious co-existence within the markets of Korea, India, Pakistan, and Bangladesh in respect of Annexure-A device. However, this purported mutual agreement is not borne out from the 1985 Letter, which is a unilateral communication issued by Defendant No. 1. This

letter offers support for use and registration of the devices “



and “  ” in Korea and proposes furnishing of a similar undertaking in India, upon Plaintiff No. 1’s request. Furthermore, there is no reference to any prior communication that would suggest ongoing negotiations between the parties. No other documentary evidence crystalizing this alleged mutual understanding has been put forth by Crocodile International. The lack of mutual acknowledgment from Lacoste further weakens the argument for an expanded co-existence agreement. The principles of contract and trademark law require clear mutual consent for co-existence agreements to be enforceable. In this case, such mutual consent is conspicuously lacking for the extension of the agreements to India.

121. In absence of a formal written agreement, Crocodile International aimed to corroborate their stance through the contemporaneous documents [Ex. DW 1/24 to Ex. DW 1/79], which allegedly contain admissions of the 1985 co-existence agreement for India by Plaintiff No. 1. However, Ex. DW 1/24 to Ex. DW 1/35, Ex. DW 1/37 to Ex. DW 1/40, and Ex. DW 1/45 to Ex.



DW 1/79 have not been proved by the Defendants, restricting their ability to rely on these purported admissions.

122. Notwithstanding their inadmissibility, upon thorough examination, it becomes clear that the aforesaid documents do not provide concrete evidence supporting the claim that Crocodile International is utilizing the Annexure-A device in India with Lacoste's consent. Even when taken on face value, at the highest, these exhibits suggest an arrangement between Plaintiff No. 1 and Defendant No. 1 permitting the use of crocodile device accompanied with the word 'Crocodile' by the Defendants. The Court's view is reinforced by Ex. DW 1/36 and Ex. DW 1/44, which have been admitted in evidence as Defendant No. 1 produced the originals. These documents demonstrate Plaintiffs' disinclination to sanction continuous use of a crocodile symbol without the 'Crocodile' signature in Korea, underscoring their commitment to protecting their trademark rights and limiting the scope of co-existence.

123. Significantly, neither the 1985 Letter nor the admissible contemporaneous documents evince an extended agreement, covering the crocodile devices, especially Annexure-A device, in India. Given the explicit territorial limitations of the 1983 Agreement and the lack of substantial evidence supporting the extension of the 1985 Letter to Annexure-A device, the Court concludes that the Plaintiffs have not consented to the use of Annexure-A device by Defendants in India.

#### **IV. Concluding observations on the 1983 Agreement, 1985 Letter and the contemporaneous documents**

124. The 1983 Agreement is confined to the five countries explicitly mentioned in Article I, and does not extend to India. The 1985 Letter, while



intended to promote co-existence in additional territories, lacks the necessary mutual consent and specific references to be applicable to India or the Annexure-A device. The contemporaneous documents do not show mutual consent or acknowledgment from Lacoste to the use of Annexure-A device in India. The Arbitral Award and the continuous actions of the Plaintiffs to protect their trademarks further reinforce this conclusion. Lacoste’s consistent objections and clarifications in their communications undermine Crocodile International’s claims of an extended co-existence agreement associated with the Annexure-A device in India.

125. The evidence on record overwhelmingly supports Lacoste’s position that the 1983 Agreement and 1985 Letter do not cover the Annexure-A device in India. Therefore, they are not bound by these agreements, and their objections to Crocodile International’s use of Annexure-A device are legally valid and enforceable. Accordingly, the Court upholds the Plaintiffs’ trademark rights and rejects the Defendants’ claims of an extended co-existence agreement covering these aspects.

## V. Conclusion on violation of trademark rights

### V.I. *Infringement*

126. While the co-existence of the parties’ registered trademarks – “



” and



“ LACOSTE ”,

and



“ Crocodile ”

and “



” – suggests a degree of tolerance within the Indian market

for similar designs, the exact nature and execution of the subject designs – “



” and “



” i.e., how they are perceived by the average

consumer, will ultimately dictate whether infringement has occurred. In light of the detailed observations in the preceding paragraphs, it is evident that Annexure-A device of Crocodile International is deceptively similar to Lacoste’s mark. The visual and conceptual parallels between the marks support a strong case for trademark infringement, underscoring the importance of protecting the distinctiveness of the Lacoste trademarks. Under Section 29(1) of the Trade Marks Act, 1958, this degree of deceptive similarity can cause confusion and deceive the average consumer and thus violates the Plaintiffs’ trademark rights.

## ***V.II. Assessing the allegations of passing off***

127. Having established the deceptive similarity between the two trademarks, the Court now proceeds to examine whether the use of the Annexure-A device by Crocodile International amounts to passing off their goods as that of Lacoste.

128. A passing off action is intended to protect the reputation or goodwill that has overtime come to be associated with a trademark. The doctrine aims to safeguard the public interest by preventing a party from dishonestly conducting their business as another’s. In order to prove that Crocodile International is indulging in passing off by falsely presenting their goods as that of Lacoste, Plaintiffs must conclusively demonstrate that they fulfil the classic trinity test, established in the landmark case of ***Reckitt and Colman***







*Products Ltd v. Borden Inc.*,<sup>23</sup> and later adopted and endorsed by the Supreme Court in *Laxmikant V. Patel v. Chetanbhat Shah and Anr.*,<sup>24</sup> and numerous other judgments. The test comprises of three prongs – (a) reputation of the Plaintiff, (b) misrepresentation to the public by the Defendant, and (c) damage to the Plaintiff’s goodwill or reputation caused from the Defendant’s impugned actions.

129. Lacoste’s witnesses asserted that the trademark “LACOSTE” and the crocodile device carry significant reputation in India. PW1 deposed regarding



Lacoste’s registrations of the trademarks “  ” and “  ” dated 19<sup>th</sup> January, 1983, which marked their entry into the Indian market. According to the witnesses, these devices were first commercially used in India in 1993. To demonstrate reputation and goodwill in the Indian market, Lacoste has presented the following oral and documentary evidence:

(a) The examination-in-chief of PW1 and PW2 (through affidavits by way of evidence) marked as Ex PW 1/A and PW 2/A. Paragraphs No. 19 to 22 of Ex. PW 1/A and paragraphs No. 4, 7, 8 of PW 2/A, which primarily echo the contents of the plaint, proclaim extensive reputation of “LACOSTE” trademark and the crocodile device in India, with the public identifying them as the exclusive source of the concerned products.

(b) Electronic documents in two compact discs,<sup>25</sup> which were marked as Ex. PW 1/15 and Ex. PW 1/16, along with prints of selective documents referred above. Ex. PW 1/15 contains information concerning Plaintiff No.

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<sup>23</sup> [1990] 1 WLR 491.

<sup>24</sup> (2002) 3 SCC 65.

<sup>25</sup> “CDs.”



1's founding, adoption of the trademarks, articles and advertisements displaying the trademarks stored electronically. Ex. PW 1/16 is the electronic copy of the report of a study conducted on the awareness of "LACOSTE" trademark and the crocodile device *inter alia* in India. PW1 has specifically produced print outs of the outcome of the study in India.

(c) Certificate issued by a Chartered Accountant endorsing the sales figures and promotional expenses of Plaintiff No. 2, marked as Ex. PW 2/5 and presented in evidence by PW2.

(d) *Ex-parte* ad-interim orders submitted as Ex. PW 1/17 passed by this Court granting injunction in favour of the Plaintiffs, restraining third parties from using "LACOSTE" mark and the crocodile device.

(e) Computer-generated prints of newspaper articles accompanied with an affidavit dated 02<sup>nd</sup> December, 2005 under Section 65B of the Evidence Act, 1872. These documents were neither referred to by any of the Plaintiffs' witnesses in their testimony, nor were they tendered in evidence.

130. In the realm of trademark law, establishing reputation and goodwill of a mark is paramount for a Plaintiff seeking protection against passing off. At the heart of a passing off claim lies the necessity to demonstrate that the trademark in question had garnered substantial recognition and goodwill in the marketplace on the date of adoption of the impugned mark, to the extent that its unauthorized use by another party could lead to consumer confusion and damage to the Plaintiff's business. Reputation refers to the recognition and standing that a trademark has acquired amongst the relevant public. It is a measure of the mark's distinctiveness and the associations that consumers form with the quality and characteristics of the goods or services it represents. Reputation is usually built over time through consistent use, quality



assurance, and strategic marketing efforts. Goodwill is the intangible asset that arises from the reputation of a trademark. It encompasses the positive perception and customer loyalty that the mark commands. Goodwill is a reflection of the trust and confidence consumers place in the trademark, translating into repeated business and competitive advantage. The concepts of reputation and goodwill have evolved significantly. In earlier times, reputation was largely confined to physical marketplaces and local trading areas. However, with the advent of mass media, globalization, and digital marketing, the scope of reputation has expanded. Today, a trademark's reputation can transcend geographical boundaries, garnering recognition in multiple jurisdictions through social media, advertisements, and global trade. We must therefore, remind ourselves that the assessment in this case has to be in the context prevalent over two decades ago.

#### **V.II.I. *Goodwill and reputation of Lacoste***

131. The standard for assessing 'reputation and goodwill' is stringent. Therefore, the Court must meticulously assess the evidence presented to determine reputation and goodwill. Under the Indian Evidence Act, specifically, Section 101 to 104, the burden of proof lies on the Plaintiffs to provide concrete and credible evidence to prove the reputation of their trademark. At the final stage of the suit, courts require a higher standard of proof from the Plaintiffs, moving beyond *prima facie* considerations to a thorough examination of the facts. In the present case, the oral and documentary evidence presented by Lacoste does not establish their exclusive reputation and goodwill in crocodile device in the Indian market as on the date



of adoption of Annexure-A device by Crocodile International. A detailed analysis of the evidence presented, underpinning this conclusion is as follows:

*132.1 Non-conformity with Section 65B of the Evidence Act:*

132.1.1. As noted above, Plaintiffs have presented several pieces of documentary evidence, including printouts of articles published in print media, a market survey report on brand recognition, and photographs of their products and endorsements by celebrities adorning their branded apparels. These documents are central to establishing widespread recognition and reputation of the Plaintiffs' trademark within the Indian market. However, the manner of presenting these crucial evidences raises pertinent questions concerning the admissibility of electronic records and the necessary compliance with Section 65B under the Evidence Act. Evidently, at the time of producing Ex. PW 1/15 and Ex. PW 1/16 with the evidence by way of affidavit of PW1 filed on 03<sup>rd</sup> December, 2005, Lacoste did not submit a certificate under Section 65B of the Evidence Act.

132.1.2. According to the testimony of PW1, the press articles, advertisements and photographs contained in Ex. PW 1/15 were apparently originally printed in magazines and newspapers, and then scanned and stored as electronic records on a computer resource. Thus, as per PW1's own admission, this documentary evidence was presented as an electronic copy of the primary evidence (on a CD or as selective printouts on paper). This necessitated the submission of a certificate under Section 65B(4) of the Evidence Act when Ex. PW 1/15 and PW 1/16 were presented as electronic copies. This is because the digital scans stored on a computer are treated as electronic records, and the copies made therefrom are considered to be derived from electronic records. The absence of originals or certified copies of these



print articles impinges the evidentiary value of these copies. Without a Section 65B certificate, these documents cannot fulfil the threshold of reliability and authenticity required by law, significantly weakening the Plaintiffs' case. The Supreme Court of India, in a landmark case titled *Arjun Panditrao Khotkar v. Kailash Kushanrao Gorantyal*,<sup>26</sup> has elucidated on the mandatory nature of the compliance under Section 65B for producing electronic records in evidence. The Supreme Court has categorically ruled on the significance of the certificate under Section 65B(4). It has been held that for the deeming fiction regarding the admissibility of electronic record to take effect, all the conditions stipulated in Section 65B must be satisfied. A certificate under Section 65B(4) is *sine qua non* for admissibility of electronic evidence. Further, overruling the decision in *K. Ramajyam v. Inspector of Police*,<sup>27</sup> the Supreme Court held that oral evidence cannot substitute the mandatory requirement of law entailed in Section 65B(4) of the Evidence Act. An exception was created to this obligation in the cases of production of original document through the original owner of the computer device, who should prove the source and legitimacy of the information. This ruling underscores the necessity of adhering to procedural requirements to ensure that the evidence considered is genuine, reliable, and capable of substantiating the claims made. The statutory requirements contained in Section 65B for presenting electronic records are indispensable. This lack of certification coupled with the absence of original documents, renders Plaintiffs' evidence contained in Ex PW1/15 and Ex. PW 1/16 and the accompanying printouts to be inadmissible and ineffective in proving their trademark reputation.

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<sup>26</sup> (2020) 7 SCC 1.

<sup>27</sup> 2016 SCC OnLine Mad 451.



132.1.3. In the seminal judgment of *State of Karnataka v. T. Naseer and Ors.*,<sup>28</sup> concerning the admissibility of electronic evidence in criminal trials – a principle equally pertinent to civil matters – the Supreme Court, reiterating the view in *Arjun Panditrao (Supra)*, elaborated extensively on the mandatory nature of Section 65B of the Evidence Act. The Court unequivocally stated that electronic records must be accompanied by a certification detailing their production and affirming their authenticity to be admissible. Crucially, this certification can be submitted at any trial stage, provided the trial has not concluded, thus classifying the absence of an initial certificate as a curable defect. However, in the present case, the Plaintiffs have failed to produce such certification at any trial stage, highlighting a significant procedural oversight.

132.1.4. It appears that the Plaintiffs realised this lacuna and sought to mitigate the situation. This becomes evident from their attempt to re-examine PW1. However, that effort, in the opinion of the Court, does not salvage the situation as Plaintiffs cannot be permitted to overcome the mandatory requirement of producing the necessary certification under Section 65B through re-examination of a witness. This impediment is further exacerbated by the fact that the scope of re-examination, as prescribed under Section 138 of the Evidence Act, is strictly confined to matters arising from the cross-examination. This principle was underscored during the recording of evidence on 20<sup>th</sup> January, 2007, where the Defendants’ counsel objected to the scope of re-examination, arguing that it extended beyond issues raised during cross-examination.

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<sup>28</sup> 2023 SCC OnLine SC 1447.



132.1.5. Joint Registrar’s permission to re-examine and observations made during re-examination: Permission to re-examine PW1 was granted under exceptional circumstances. The Plaintiffs’ counsel articulated the need to clarify certain issues that emerged during cross-examination. However, the Defendants’ counsel objected, contending that re-examination is not an inherent right and argued that appropriate permission from the Court had not been sought. It was emphasized that the necessity for re-examination had not been adequately explained or justified before the Court. In response, the Plaintiffs’ counsel submitted that clarifications were necessary due to language difficulties experienced by the witness. Given the urgency, as the witness was scheduled to leave India the same day, on 20<sup>th</sup> January, 2007, the Joint Registrar permitted the re-examination, albeit subject to subsequent approval by the Court.

132.1.6. Utilization of the permission to re-examine to introduce new evidence: Taking advantage of this allowance, the Plaintiffs’ counsel introduced evidence related to electronic records marked as Ex.PW1/15 and Ex.PW1/16, which had not been addressed during the initial cross-examination. This action was promptly challenged by the Defendants’ counsel, who argued that the Plaintiffs were effectively attempting to introduce new evidence under the guise of seeking clarifications. Indeed, such an expansion of the testimony of PW1 is not permitted in re-examination, especially in matters not previously broached during cross-examination. In *Simrin Singh v. Amrit Srinivasan and Anr.*,<sup>29</sup> this Court stressed that the scope of re-examination is restricted to “*explain the matters referred to in*

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<sup>29</sup> 2018 SCC OnLine Del 7177.



*cross-examination.*” However, this phrase cannot be construed widely so as to permit the witness to “*undo what has been achieved/ revealed in cross-examination.*” The Court held that re-examination in civil litigations must seldom be allowed and must be confined to clarifying the sense or meaning of the ambiguous or unclear expressions used by a witness in cross-examination, and to explain the motive behind the witness’ responses. Further, it was categorically held that lacunae in evidence led cannot be cured under the pretext of re-examination.

132.1.7. The testimony of PW1 during re-examination exceeded the bounds set by Section 138 of the Evidence Act, which permits re-examination only for clarifying issues explored during cross-examination, and not for introducing new evidence or matters unrelated to the original testimony. Here, the Plaintiffs’ attempt to embed additional evidence through the backdoor of re-examination undermines the integrity of evidential proceedings. Accordingly, the Court holds that the re-examination conducted on 20<sup>th</sup> January, 2007, aimed at providing information relating to the admissibility of electronic records stored in computers in the office of Plaintiff No. 1 situated in Paris, is inadmissible in law, being beyond the scope of Section 138 of the Evidence Act. Therefore, that part of the testimony of PW1 shall not be read in evidence.

132.1.8. Nonetheless, even if the Court were to consider the deposition of PW1 during re-examination, it becomes evident that the requirements stipulated under Section 65B(4) of the Evidence Act were still not satisfied. Section 65B(4) mandates that for an electronic record to be admitted as evidence, the person occupying a responsible official position in relation to the operation of the relevant device or the management of the relevant





activities, whichever is appropriate, must furnish a certificate identifying the electronic record and describing the manner in which it was produced. This certificate must also detail the particulars of the device involved in the production of the electronic record and affirm that the electronic record was produced by a computer during the regular course of activities. Additionally, the deponent must specify information related to conditions specified in Section 65B(2) of Evidence Act.

132.1.9. During the re-examination, PW1 failed to provide these essential details. Specifically, the witness did not describe the manner in which the electronic records were produced nor did he give particulars of any device involved in producing the electronic record. Furthermore, there was no discussion about whether the computers were operating properly at the time the records were created, a requirement under Section 65B(2) of the Evidence Act, which states that the information must be produced during the regular course of operations and that the integrity of the electronic records must be maintained. The significance of these omissions has been consistently underscored by judicial precedents, such as *Arjun Panditrao (Supra)* and *T. Naseer (Supra)*, where the Supreme Court has emphasized the critical nature of the Section 65B certificate. Therefore, in any proceedings where electronic evidence is sought to be produced, either a person occupying a responsible official position in relation to the device or a person in-charge of the management of the relevant activities, must produce a certificate that: (a) identifies the electronic record which contains the statement, (b) sets out the particulars of the computer device involved in production of the record, and (c) endorses the criteria enumerated in Section 65B(2).



132.1.10. The electronic records in PW1/15 and PW1/16 cannot be admitted as evidence because they lack the necessary authentication to ensure its reliability and authenticity. The absence of a proper certificate under Section 65B in the present case, combined with the inability of the witness to provide specifics about the creation of electronic records and maintenance significantly undermines the admissibility of the evidence. Considering that PW1 is not the original owner of the electronic devices on which the data was produced, his oral deposition regarding the process for recording and storing such information fails to meet the legal standard of demonstrating the admissibility of Ex. PW 1/15 and Ex. PW 1/16. Consequently, the Court cannot rely on electronic records lacking this crucial authentication, as it would compromise the evidentiary standards set forth by the Evidence Act. The portion of PW1's testimony relating to the electronic records cannot be considered in reaching a decision on the merits of the case.

132.2. *Insignificance of affidavit dated 02<sup>nd</sup> December, 2005:*

132.2.1. Mr. Christian London [PW1] had filed an affidavit under Section 65B of the Evidence Act on 02<sup>nd</sup> December, 2005 concerning promotion of "LACOSTE" mark/ brand through certain computer-generated newspaper articles circulated in China, France, and the United States. However, this certificate pertains to a set of documents, which have not been tendered in evidence. Considering these deficiencies, the Court finds that the testimony regarding the electronic records does not meet the statutory requirements of Section 65B of the Evidence Act.

132.3. *The survey report [Ex. PW 1/16]:*



132.3.1. The Court now turns to the market survey reports produced in evidence by PW1 that purportedly establish the reputation and goodwill of Lacoste’s trademarks. Such survey reports typically provide direct evidence of brand recognition, consumer preferences, and the extent of consumer association of a trademark with specific goods or services. The strength of such reports in legal disputes lies in their ability to present empirical data directly reflecting the public perceptions and behaviours. The survey report presented by the Plaintiffs as Ex. PW 1/16, concededly, an electronic record apart from being unsupported by an affidavit under Section 65B of the Evidence Act, is problematic on several other fronts. Results of this survey reflect the public perception in July 2004. For Lacoste to prove that use of Annexure-A device amounts to passing off of their trademark, they must establish reputation in 1998, which is the professed date of adoption of the Annexure-A device. The report lacks any form of authentication as it is unsigned, and except for mention of “Sociovision Cofremca,” it does not specify the author. Further, there is lack of background documentation and data, which are crucial for verifying the methodology, sample size, and analysis techniques used in the survey to support the conclusions. This absence makes it difficult to evaluate the trustworthiness of the conclusions drawn, and immediately raises concerns about its credibility and reliability as evidence.

132.3.2. In the legal context, a document is considered “self-serving” if it is prepared unilaterally by a party to the litigation and is intended to be in favour of that party without cross-verification or external validation. Without the background documents detailing how the survey was conducted, the data collected, and the methodology employed, the report remains uncorroborated



and self-serving. This undermines its evidentiary value under Section 9 of the Evidence Act, which concerns the facts necessary to support a case, and Section 101, which places the burden of proof on the person who asserts a fact. Consequently, the market survey report – unsigned, unauthenticated, and without supporting documents – fails to meet the legal standards set by the Indian Evidence Act for admissibility of evidence. The absence of supporting background documents to substantiate the conclusions drawn in the survey further diminishes its probative value.

132.4. *The Chartered Accountant’s certificate [Ex. PW 2/5]:*

132.4.1. Now, we turn our attention to Exhibit PW 2/5, the Chartered Accountant’s certificate in respect of the turnover and promotional expenses of Plaintiff No. 2, through which the Plaintiffs seek to prove the reputation of the “LACOSTE” trademark and crocodile device. Indeed, this data is critical in proving the reputation of a trademark. High sales figures demonstrate market penetration and consumer acceptance, while substantial promotional expenses indicate an investment in building brand recognition and consumer trust. Together, these metrics provide a quantitative measure of the trademark’s reputation.

132.4.2. The Plaintiffs had also asserted these figures in the plaint, which were denied by the Defendants in their written statement. Under Section 101 of the Evidence Act, the burden of proof lies on the party who substantially asserts the affirmative of the issue. In the instant case, this means proving the reputation of their trademark through reliable, authentic, and substantiated evidence. Lacoste was required to prove the sales figures and promotional expenses which they sought to do through Ex. PW 2/5. Thus, the Court must



assess whether the Chartered Accountant's certificate suffices to prove the facts and consequently, conclusively establishes the trademark's reputation and goodwill.

132.4.3. Ex. PW2/5 summarizes financial data, but lacks detailed context and supporting documents, including invoices, receipts, and ledgers, that could provide a comprehensive view of Plaintiffs' commercial activities and support the figures and promotional expenses mentioned in the certificate. These detailed accounts would have enabled verification by the Court and cross-examination by the Defendants, thus ensuring the credibility of the evidence. Notably, the Plaintiffs did not summon the Chartered Accountant as their witness, but instead, sought to prove the authenticity of the financial data through PW2. However, PW2 is not a Chartered Accountant and his involvement in the payment and maintenance of Plaintiff No. 2's accounts has not been clarified in evidence. During his cross-examination on 28<sup>th</sup> January, 2016, PW2 admitted that the books of account of Plaintiff No. 2, licensee of Plaintiff No. 1, for the years 1993-94 to 2006-07 had not been produced. A *simpliciter* production of a statement of their advertising expenditures and annual turnover does not sufficiently discharge the Plaintiffs' burden to prove authenticity of these figures for the Court to conclusively rule on their trademark's reputation. It has been consistently held that even entries in the books of accounts are to be supplemented with persuasive supporting material, including testimonies of the persons involved. In numerous judicial pronouncements, referring to the provisions of Section 34 of the Evidence Act, the courts have consistently emphasized that statements of accounts do not disclose the relevant commercial dealings and cannot act as the sole basis



for proving a financial transaction.<sup>30</sup> The absence of these detailed accounts of commercial transactions prevents a granular view of the financial data, thereby limiting the transparency and thorough examination by the Court. This also hindered the ability of the Defendants to effectively cross-examine the evidence presented.

132.4.4. The suit is at the final stage, where the Court requires concrete and comprehensive evidence to rule on the reputation of Plaintiff's trademark. While the Chartered Accountant's certificate is a valuable piece of evidence, it is not supplemented with detailed accounts and supporting documents to provide a complete and verifiable record of the Plaintiffs' sales and promotional activities. The Plaintiffs' reliance on such an incomplete report unfortunately, does not suffice to substantiate the claimed reputation of the trademark, thus impacting the strength of their passing off claim.

132.5. *Failure to produce translated versions of the documents:* Lastly, the Court must also note that Ex. PW1/15 also contains certain documents in French language, of which the Plaintiffs did not file translated copies. Those documents thus do not meet the evidentiary requirement for being admitted in evidence stipulated under Rule 5 of Chapter XIII of the Delhi High Court (Original Side) Rules, 1967 read with Section 162 of the Evidence Act, and are thus, disregarded.

133. *Conclusion:* To prevail in a claim of passing off, Lacoste was required to establish significant reputation and consumer recognition of their trademarks in India at the time when Crocodile International commenced the

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<sup>30</sup> Refer: *Chanradhar Goswami and Ors. v. Gauhati Bank Ltd.*, 1967 AIR 816, *Central Bureau of Investigation v. VC Shukla and Ors.*, AIR 1998 SC 1406, and *Deluxe Road Lines v. PK Palani Chetty*, (1992) 2 MLJ 481.



infringing activities. The evidence crucial for substantiating such a reputation presented by Lacoste, however, is markedly insufficient in this case. The Court has scrutinized the documents and other material submitted by Lacoste. The Chartered Accountant's certificate [Ex. PW 2/5] and electronic records [Ex. PW 1/15 and Ex. PW 1/16] are found lacking in several respects. Ex. PW 2/5, intended to demonstrate sales figures and promotional expenses indicative of market penetration and brand recognition, is not supported by detailed accounts, or corroborated by a competent witness. This absence of detailed financial data and the failure to substantiate the figures through primary documentation or a qualified witness who is competent to prove the same, significantly undermines the certificate's reliability and the authenticity of the claims based thereon. Moreover, Ex. PW 1/15 and Ex. PW 1/16, being electronic records, were not accompanied by the mandatory certificate under Section 65B of the Evidence Act, a statutory requirement that ensures the authenticity and reliability of such records. Without this certification, the Court cannot accept these records as valid evidence. Additionally, the attempted introduction of new evidence during re-examination, without proper procedural compliance, further detracts from the credibility of the evidence presented. Due to these evidentiary deficiencies, the Court finds that Lacoste has not successfully demonstrated that their trademarks had acquired a substantial reputation in India at the critical juncture when Crocodile International began using a similar mark.

134. The absence of convincing proof of reputation, a fundamental element of a passing off claim, renders Lacoste's assertions unsustainable. Therefore, based on the evidence and the law, the Court concludes that Crocodile International's actions do not constitute passing off of Lacoste's trademarks.




This decision is grounded in the principle that the onus to establish the key elements of passing off, particularly trademark reputation and consumer association, lies firmly with the claimant – a burden that Lacoste has failed to discharge to the requisite legal standard.

## **VI. Copyright violation**

135. Copyright protects original works of authorship, including literary, dramatic, musical, and artistic works, such as poetry, novels, movies, songs, computer software, and architectural designs. Copyright infringement occurs when someone copies, distributes, publicly performs, displays, or creates derivative works from a copyrighted work, without the authorization of the copyright holder. The primary concern in copyright law is to protect the rights of creators by granting them exclusive rights to use, reproduce, and distribute their works. The realm of protection offered under the copyright and trademark laws is distinctly defined. Copyright entitles an author to inhibit the imitation of their work in any medium, whereas trademark precludes unsanctioned use of an identical/ similar trademark on goods and services in trade as would cause consumer confusion, thereby eroding the proprietor's exclusive rights or associated goodwill. In examining the claim of copyright infringement asserted by Lacoste, the Court must remain wary of the demarcated peripheries of both copyright and trademark protection. The near resemblance in parties' contesting devices, which may yield consumer confusion or deception may not necessarily convey an infringement of copyright. Thus, it is essential to undertake an independent assessment of the Copyright Act, 1957, which governs protection of artistic works in India. Lacoste, having secured a copyright registration under No. A-62692/2002 for





their distinctive crocodile design “  ” [Ex. PW 1/10], asserts that the reproduction of this design by Crocodile International constitutes a substantial imitation, thus infringing upon their exclusive rights as the copyright holder.

136. Copyright protection to an artistic work is aimed at protecting expressions of creativity of the author, allowing them the exclusive rights to commercially benefit from its reproduction. This protection however, does not extend to the idea for conception of the work in question. It is the originality in the depiction and representation of the artistic elements, and not in the novelty of concept, that is safeguarded by the Copyright Act. The idea-expression dichotomy in copyright law has given rise to the ‘merger doctrine,’ recognized in the celebrated decision of *Herbert Rosenthal Jewellery Corporation v. Kalpakian*.<sup>31</sup> This principle posits that when an idea and its expression are so entangled inasmuch as they are indistinguishable, a creator cannot be accorded monopoly over the idea which forms the foundation for its creative expression. Simply put, when the manner of expression of a concept is restricted, the Courts will not confer exclusive rights on the idea itself.<sup>32</sup>

137. In the case at hand, the underlying concept of both conflicting works is identical – both are graphical representations of a ferocious crocodile in an aggressive stance. The portrayal of a fierce crocodile invariably includes common features such as a tail, limbs, an open mouth with pointed teeth,

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<sup>31</sup> 446 F.2d 738 (1971).

<sup>32</sup> Refer: *Mattel, Inc & Ors. v. Mr. Jayant Agarwalla and Ors.*, 2008 SCC OnLine 1059.



scales, and claws. Therefore, this abstract will certainly have limited ways of expression, where the author's creativity can be illustrated from the unique and artistic manner of meticulously crafting the constituent elements. In this context, both parties' crocodile designs are artistic works imbued with unique elements that distinguish it as a copyrighted creation, entitled for legal protection.

138. The crocodile devices of Plaintiff No. 1 and Defendant No. 1 are independent creations, flowing from the same abstract. Both parties have convincingly elucidated their narratives of having opted for an artwork of a crocodile, initially intended for commercial use in territories of origin. In these circumstances, the Court is unable to draw an inference of 'copying' of Plaintiff No. 1's design by Defendant No. 1. Similarities between the two designs, arising from the same underlying idea with limited means of manifestation, cannot constitute infringement of Lacoste's copyright. In the case of *Allen v. Academic Games League of Am.*,<sup>33</sup> the Court held that "*ideas contained in a copyrighted work may be freely used so long as the copyrighted expression is not wholly appropriated.*" The impugned artistic work "



" exhibits novel independent artistic qualities that do not support Lacoste's allegations of imitation of their design, as the creator was at liberty to draw from the general idea of a crocodile.

139. Therefore, given the convergence of the idea and execution in Lacoste's artistic expression, applying the merger doctrine, the Court does not find a case for copyright infringement by Crocodile International.

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<sup>33</sup> 89 F.3d 614 (9<sup>th</sup> Cir. 1996).



**Finding on issue No. 4**

140. In light of the explicit territorial scope of the 1983 Agreement, there is no evidence of a binding co-existence agreement, enabling the use of the Annexure-A device by Defendants in India. Therefore, issue No. 4 is answered in favour of the Plaintiffs, and against the Defendants.

**Finding on issue No. 11**

141. In view of the evidence presented and the parties' concurrence, it is evident that the parties entered into a co-existence arrangement on 17<sup>th</sup> June, 1983. However, as noted above, the 1983 Agreement envisioned a harmonious co-existence of the parties within the five territories explicitly delineated in Article I of the Agreement, and as such, do not entitle Defendants to use the Annexure-A device in India.

142. Insofar as the 1985 Letter is concerned, the Defendants have failed to establish a mutual arrangement between Plaintiff No. 1 and Defendant No. 1, which facilitates the use of the Annexure-A device in India. The 1985 Letter is a unilateral communication, and Plaintiffs cannot be held bound thereby. As such, they are not precluded from objecting to the use of Annexure-A device in India. Furthermore, given the consistent stance of Plaintiffs protesting the use of Annexure-A device by Defendants in Korea, the reciprocal understanding, if any, does not cover the Annexure-A device in the Indian territory.



143. Consequently, issue No. 11 is decided in favour of the Plaintiffs, holding that the parties never executed a co-existence agreement for Annexure-A device in India.

**Finding on issue No. 8**




144. Keeping in view the established jurisprudence of trademark law consistently recognized by the courts in India, the striking resemblance in the

overall characteristics of the Plaintiffs' emblem “  ”/ “

 ” with the Annexure-A device “  ,” and Plaintiffs' established prior use in India, it is held that use of Annexure-A device by the Defendants infringes the Plaintiffs' trademark rights. However, given the failure of Plaintiffs to prove their reputation in India, a case for passing off of the Plaintiffs' trademarks is not made out.

145. As regards the issue of copyright violation, the creator of the artwork “

 ” independently conceptualized the device, deriving from a generic idea having restricted means of expression. In view of the foundational idea of a crocodile, which can be expressed in a limited manner, the Court holds that Defendants' artwork does not violate Plaintiffs' copyright.

146. Issue No. 8 is answered in the above terms.

**ISSUE NO. 6- WHETHER THE PLAINTIFFS ARE NOT ENTITLED TO ANY RELIEF AS THEY ARE GUILTY OF CONCEALING (SIC) VITAL FACTS AND DOCUMENTS?**

**OPD**

147. The onus of proof for this issue is on the Defendants. They relied on the contemporaneous documents exhibited as DW 1/22 to DW 1/46 to argue that Lacoste has concealed vital facts and documents by not referring to these



letters. As admitted by the Defendants in paragraph No. 6 of their written submissions dated 08<sup>th</sup> March, 2024, all these letters pertained to historical events which were put to rest upon the subsequent mutual understandings between the parties. In any case, as detailed hereinabove, these documents are photocopies, and have not been proven in accordance with law and no case has been made out for leading secondary evidence *qua* them. Additionally, these exhibits are irrelevant to the present proceedings as they do not pertain to use of Annexure-A device in India.

148. In view of the above, the Court finds that there has been no concealment of any significant fact by Lacoste. Crocodile International has failed to show any relevant fact or document in relation to the trademark in issue which has been concealed by Lacoste, disentitling them from the desired reliefs. Hence, this issue is decided in favour of Plaintiffs.

**ISSUE NO. 3- WHETHER THE SUIT SUFFERS FROM GROSS AND UNEXPLAINED DELAY AND IS HIT BY LACHES AND ACQUIESCENCE?** **OPD**

149. The onus of proof was on Crocodile International as they have objected to the maintainability of the present suit on the ground of delay, laches, and acquiescence. However, no arguments, either oral or written, were presented to the Court on this issue. Additionally, there has not been any substantial cross-examination on this aspect. Nevertheless, the Court has reviewed the available pleadings and evidence to decide this issue.

150. The cause of action narrated in the plaint occurred in 1999 when Plaintiffs came to know of Defendants' use of Annexure-A device, which has been alleged to be deceptively and confusingly similar to Plaintiffs' crocodile device. Crocodile International, on the other hand, denied the cause of action



and have objected to the maintainability of the suit, alleging that the impugned mark has been used on their products in India since 1998, and has been openly advertised since 1997. Thus, they contended that it is inconceivable that Lacoste did not learn of their business operations earlier. Lacoste's silence for all these years, according to Crocodile International, echoes their acquiescence to the development, growth, and expansion of business operations of Defendants. They further relied on letter dated 18<sup>th</sup> December, 1998 [Ex. DW 1/45] of Plaintiff No. 1, expressing their concern, at the use of crocodile device by Defendant No. 1 in India.

151. In evaluating Crocodile International's objection, it must first be noted that Ex. DW 1/45, being a photocopy, has not been duly proved in trial. Further, it is important to consider the established jurisprudence on delay, laches, and acquiescence. The principle of laches requires not just a mere delay in filing the suit, but also that the delay must cause some detriment to the Defendant. For acquiescence to apply, it must be shown that the Plaintiff actively represented that they would not assert their rights or that they stood by while their rights were infringed upon, resulting in the Defendants being misled to their detriment.<sup>34</sup> In this case, the alleged delay of three years is not considered excessive, especially in the context of trademark and copyright disputes which often involve complex considerations and necessitate thorough investigation before litigation. Furthermore, Lacoste's timely legal notices, marked as Ex. PW 1/4 to Ex. PW 1/7, which have been admitted by the Defendants, and subsequent lawsuit indicate a proactive stance rather than passive acquiescence.

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<sup>34</sup> See: *Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia and Ors.*, (2004) 3 SCC 90 and *Hindustan Pencils Private Limited v. M/s India Stationary Products and Co.*, 1989 SCC OnLine Del 34.



152. The Court finds that the Plaintiffs acted within a reasonable timeframe upon becoming aware of the infringement, issuing a legal notice promptly followed by institution of the lawsuit. There is no evidence to suggest that their actions misled Crocodile International or allowed them to believe that their use of the impugned mark was unchallenged. Therefore, the objection on the grounds of delay, laches, and acquiescence lacks merit.

153. The issue is accordingly decided in favour of Plaintiffs and against Defendants.

**ISSUE NO. 7- WHETHER THE PLAINT IS LIABLE TO BE DISMISSED ON ACCOUNT OF IT BEING FICTITIOUS WITH AN INTENTION OF THWARTING THE LEGITIMATE BUSINESS OF THE DEFENDANT?** **OPD**

154. In their written statement, Crocodile International alleged that the present suit is fictitious and has been filed with the intention of thwarting their legitimate business operations. However, they have failed to substantiate this allegation with any concrete evidence or detailed arguments. The burden of proof rested on the Defendants to demonstrate that Lacoste's claims are baseless and that the suit was filed with a malicious intent. In the absence of any such submission or evidence, this claim remains unsubstantiated.

155. In assessing the Defendants' allegation that the suit is fictitious, it is essential to consider the legal standards for such a determination. A suit can be deemed fictitious if it is based on false claims or lacks any genuine legal basis, typically aimed at harassing the other party. In the case at hand, the Plaintiffs have provided ample evidence supporting their legal rights and the infringement by the Defendants. The suit is grounded in well-documented claims of trademark and copyright violations, and there is no indication of



malicious intent to harass or unjustly interfere with the Defendants' business operations. The Plaintiffs' actions, including the issuance of legal notices and the filing of the suit, are consistent with their legal rights and obligations to protect their intellectual property. These actions are standard practice in the enforcement of rights in trademark and copyright and do not indicate any fictitious or malicious intent.

156. Thus, given the afore-noted and the lack of any concrete evidence from Defendants to prove the fictitious nature of the lawsuit, the Court finds no merit in the Defendants' allegation. Accordingly, issue No. 7 is decided in favour of the Plaintiffs and against the Defendants.

**ISSUE NO. 9-WHETHER THE DEFENDANT IS LIABLE TO BE PROSECUTED AND NON-SUITED ON ACCOUNT OF USE OF THE SYMBOL ® WITH A VIEW TO MISREPRESENT THE MEMBERS OF THE TRADE AND PUBLIC THAT THE 'CROCODILE DEVICE' IS A REGISTERED TRADE MARK IN INDIA? OPP**

157. The onus to prove this issue is on the Plaintiffs. Lacoste had pointed out that Crocodile International affixed the '®' symbol over the Annexure-A device to cause a misperception that the device is registered in India. Thus, they contended that Crocodile International is liable to be prosecuted under the Trade Marks Act, 1958.

158. The Defendants, in the written statement, have acknowledged their mistake, stating that the error occurred purely due to oversight. They clarified that since the Annexure-A device has been registered in numerous countries where their products are exported, the use of the symbol in some batches was an inadvertent error, not intended to deceive the public. Further, the Defendants claimed that even prior to the institution of the present proceedings, they promptly undertook steps to remove the '®' symbol from





the goods. Moreover, Defendant No. 2 has consistently mentioned the registration number for Annexure-A device issued in Singapore, in all press releases in India.

159. The Defendants' explanation indicates that their mistake was genuine. They acknowledged their fault and undertook remedial steps to recall the products with the symbol '®' and prevent its occurrence in future. The Plaintiffs have not been able to prove any malice on the part of Defendants during cross-examination of DW1 or DW2. In the opinion of the Court, the Defendants cannot be non-suited due to this unintentional error. Nonetheless, if this lapse warrants prosecution, it falls within the remit of the Registrar of Trademarks or any other authorized officer, as per Section 89 of the Trade Marks Act, 1958. Thus, the appropriate course for the Plaintiffs would be to approach the Appropriate Authority to seek redress for the alleged misrepresentation.

### **Finding**

160. In view of the Defendants' acknowledgement and their prompt corrective measures, the Court answers this issue in favour of the Defendants.

### **RELIEF**

161. In view of the foregoing discussion, a decree for permanent injunction is issued in favour of the Plaintiffs and against the Defendants, restraining them, or anybody acting on their behalf, from manufacturing, selling, offering for sale, advertising, or in any other manner using the trademark depicted in Annexure-A to the plaint that would amount to infringement of the Plaintiffs' registered trademarks.



162. In view of the findings of infringement of Plaintiffs' registered trademarks, the Defendants must account for the profits made from the sale of goods bearing the Annexure-A device impugned in the suit. Accordingly, they shall, within six weeks from today, render their statement(s) of accounts of profits earned from the sale of goods under the Annexure-A device, commencing from August 1998 till the date of cessation of use.

163. Mr. Amar Nath, District and Sessions Judge (Retd.) [Contact No.: +91-9958697030] is appointed as a Local Commissioner to go into the Defendants' accounts of profits earned from the sale of goods under the Annexure-A device, commencing from August 1998 till the date of cessation of use.

164. The Defendants shall file their affidavit(s) by way of evidence (examination-in-chief) within six weeks from today and furnish their books of accounts and all other information as required by the Local Commissioner.

165. The fee of the Local Commissioner is fixed at Rs. 3,00,000/- besides the out-of-pocket expenses, subject to revision if the proceedings so demand. The aforesaid sum shall be paid by the Plaintiffs in advance.

166. The Local Commissioner shall fix the dates for recording of the statement(s) in consultation with the counsel for the parties.

167. The commission be concluded within four months from the date of first appearance. The Report of the Local Commissioner be submitted within four weeks from the date of conclusion of recording of evidence.

168. Additionally, the Plaintiffs are entitled to actual costs recoverable from the Defendants, in terms of the Commercial Courts Act, 2015 and Delhi High Court (Original Side) Rules, 2018 read with Delhi High Court Intellectual Property Division Rules, 2022. Plaintiff shall file their bill of costs in terms



of Rule 5 of Chapter XXIII of the Delhi High Court (Original Side) Rules, 2018 on or before 14<sup>th</sup> September, 2024. As and when the same is filed, the matter will be listed before the Taxing Officer for computation of costs.

169. The suit is partially decreed in the above terms. Decree sheet be drawn up.

170. Decree for the amount so determined from the accounts of profits shall follow after the consideration of report of the Local Commissioner.

171. List after the proceedings before the Local Commissioner are concluded.

**SANJEEV NARULA, J**

**AUGUST 14, 2024**

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**APPENDIX-A****EXHIBITS OF THE PLAINTIFFS REFERRED IN THE JUDGEMENT**

<i><b>Exhibit Number</b></i>	<i><b>Description of the document</b></i>
Ex P-1	Arbitral award dated 15 <sup>th</sup> Aug 2011
Ex P-2	Judgement of Beijing Higher People's Court
<b>Documents tendered by PW1</b>	
Ex PW1/2	Use of Annexure-A device.
Ex. PW 1/8	Agreement dated 17 <sup>th</sup> June, 1983.
Ex. PW 1/10	Copyright registration of Plaintiff No. 1 bearing No. A-62692/2002.
Ex. PW 1/11	LPC for Plaintiff No. 1's Trademark No. 400265.
Ex. PW 1/12	LPC for Plaintiff No. 1's Trademark No. 400267.
Ex. PW 1/14 (colly)	Plaintiff No. 1's trademark registrations for "LACOSTE" and "Crocodile device."
Ex. PW 1/15	CD containing information regarding notoriety of the Plaintiff's trademarks, printouts of event brochure, articles on founders etc.
Ex. PW 1/16	CD containing survey reports regarding awareness of Lacoste's trademarks in India and few other countries.
Ex. PW 1/17	Certified copies of orders in suits instituted by the Plaintiffs against third-parties.
Ex. PW1/ D2	Consent letter dated 22 <sup>nd</sup> August, 1985.
<b>Documents tendered by PW2</b>	
Ex PW 2/4	User Agreement between the Plaintiffs.
Ex PW 2/5	CA certificate certifying the sales and promotional figures for goods bearing 'Lacoste' and the 'crocodile device' between 1993-94 to 2006-07



**APPENDIX-B**  
**EXHIBITS OF DEFENDANTS REFERRED IN THE JUDGEMENT**

<i>Exhibit Number</i>	<i>Description of the document</i>
<b>Documents tendered by DW1</b>	
DW 1/16 (colly)	List of saurian marks of Defendant No. 1.
DW 1/17	Material showing commercial use of Annexure A device.
DW 1/18	Letter of Plaintiff No. 1 dated 21 <sup>st</sup> Jan 1983
DW 1/19	Defendant No. 1's C&D notice dated 16 <sup>th</sup> July, 1980 to Plaintiff No. 1's licensee in Singapore.
DW 1/20	Response to C&D letter dated 30 <sup>th</sup> July 1980.
DW 1/21	Letter dated 09 <sup>th</sup> December, 1980 of Plaintiff No. 1.
DW 1/22	Letter dated 10 <sup>th</sup> February, 1983.
DW 1/23	Letter dated 13 <sup>th</sup> February, 1984.
<b>Contemporaneous documents</b>	
DW 1/24	Letter dated 10 <sup>th</sup> February, 1989.
DW 1/25	Letter dated 13 <sup>th</sup> February 1989.
DW 1/26 (colly)	Letter dated 6 <sup>th</sup> March 1989 addressed by Defendant No. 1 to Plaintiff No. 1 and responses dated 13 <sup>th</sup> March, 14 <sup>th</sup> March, and 23 <sup>rd</sup> March, 1989.
DW 1/27 (colly)	Letter dated 15 <sup>th</sup> June, 1990 addressed by Defendant No. 1 to Plaintiff No. 1 and reply thereto dated 22 <sup>nd</sup> June, 1990.
DW 1/28	Letter dated 16 <sup>th</sup> August, 1990.
DW 1/29	Letter dated 20 <sup>th</sup> September 1990.
DW 1/30	Letter dated 28 <sup>th</sup> September, 1990.
DW 1/31	Letter dated 8 <sup>th</sup> January, 1991.
DW 1/32	Letter dated 1 <sup>st</sup> February, 1993.
DW 1/33	Letter dated 16 <sup>th</sup> September, 1993.
DW 1/34	Letter dated 24 <sup>th</sup> February 1994.
DW 1/35	Letter dated 18 <sup>th</sup> May, 1994.
DW 1/36	Letter dated 29 <sup>th</sup> March, 1995.
DW 1/37	Letter dated 6 <sup>th</sup> April, 1994.
DW 1/38	Letter dated 25 <sup>th</sup> July, 1995.
DW 1/39	Letter dated 28 <sup>th</sup> July, 1995.
DW 1/40	Letter dated 02 <sup>nd</sup> August, 1995.
DW 1/41	Letter dated 07 <sup>th</sup> April, 1997.
DW 1/42	Letter dated 13 <sup>th</sup> November 1997.
DW 1/43	Letter dated 02 <sup>nd</sup> February, 1998.
DW 1/44	Letter dated 28 <sup>th</sup> May, 1998.
DW 1/45	Letter dated 18 <sup>th</sup> December, 1984.
DW 1/46	Letter dated 24 <sup>th</sup> December, 1998.



DW 1/47 to DW 1/79	Consent letters exchanged between the parties, permitting use/ registration of their respective trademarks in various territories.
<b>Judicial precedents</b>	
DW 1/80	Letter dated 22 <sup>nd</sup> August, 1985.
DW 1/81 to DW 1/90	Defendant No. 1's registrations across the world for crocodile device, including Annexure-A device.
DW 1/91	Plaintiff No. 1's trademark application No. 893320 for the word trademark "Crocodile" in India.
DW 1/92	Order by Divisional Court of Yangon, Myanmar dated 07 <sup>th</sup> Mar, 2001.
DW 1/93	Order of High Court of Western Province Holden in Colombo, Sri Lanka dated 03 <sup>rd</sup> Dec 2013.
DW 1/94	Order of Director General of Intellectual Property, Sri Lanka dated 10 <sup>th</sup> Sep 2012.
DW 1/95	Order dated 29 <sup>th</sup> Dec 2010 of the Supreme People's Court of People's Republic of China.
DW 1/96	Order dated 12 <sup>th</sup> October, 2012 of Court of Appeal of Paris.
DW 1/97	Order dated 20 <sup>th</sup> May, 2014 of Supreme Court of France.
<b>Documents tendered by DW2</b>	
DW 2/6	Caution notice issued by Defendant No. 2 in Hindi on 27 <sup>th</sup> April, 1998.
DW 2/ P3	Caution notice in Deccan Herald on 05 <sup>th</sup> December, 1995.