

**Legal Issues  
in**

***Critical Analysis of Evidentiary Issues in Selected IP Court-Judgements***

***Module 1 – BURDEN OF PROOF IN IP CASES***

## The Indian Evidence Act, 1872

### ❖ Section 101: Burden of proof –

- *“Whoever desires any Court to give judgment as to any legal right or liability dependent on the existence of facts which he asserts, must prove that those facts exist. When a person is bound to prove the existence of any fact, it is said that the burden of proof lies on that person.”*

### ❖ Section 102: On whom burden of proof lies –

- *“The burden of proof in a suit or proceeding lies on that person who would fail if no evidence at all were given on either side.”*

### ❖ Section 103: Burden of proof as to particular fact –

- *“The burden of proof as to any particular fact lies on that person who wishes the Court to believe in its existence, unless it is provided by any law that the proof of that fact shall lie on any particular person.”*

- ❖ The expression "burden of proof" is used in two senses –

Burden of persuasion	Burden of adducing evidence
Degree/quantum of evidence required to establish the case (preponderance of evidence)	Duty to adduce evidence in support of a particular assertion or fact

- ❖ The burden of proof, in the sense of the burden of adducing evidence to prove a particular fact, constantly shifts during the trial.
- 3
- ❖ The party on whom the burden of proof in the first instance lies may shift the burden to the other side, by proving facts giving rise to a presumption in his favour, or by showing an admission.

## Distinction between “Burden” and “Onus”

❖ *Addagada Raghavamma and Ors. vs. Addagada Chenchamma and Ors. [AIR 1964 SC 136]*

- *“There is an essential distinction between burden of proof and onus of proof; burden of proof lies upon the person who has to prove a fact and it never shifts, but the onus of proof shifts...The said circumstances do not alter the incidence of the burden of proof. Such considerations, having regard to the circumstances of a particular case, may shift the onus of proof. Such a shifting of onus is a continuous process in the evaluation of evidence.”*

## Burden of proof in Trademark Cases

- ❖ ***Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories [[1965] 1 SCR 737]***
  - “...In an action for infringement the onus (burden of proof) would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, identical or is deceptively similar.”
  
- ❖ **Shifting onus of proof - *The Indian Express Limited and Ors. vs. Chandra Prakash Shivhare 2016 (3) ABR 189***
  - Infringement suit filed against the Defendant publishing a newspaper titled ‘The Indian Express’ in Devnagari script.
  - Burden of proof placed on Plaintiffs to prove ownership and extent of use of INDIAN EXPRESS in India, and that the Defendant’s use was infringing.

5

## Burden of proof in Trademark Cases (Contd.)

- Once the Plaintiffs discharged their burden, onus placed on Defendant to prove that the Plaintiff's registration was restricted to a particular script/territory.

❖ Held –

- *“...once the Plaintiffs' witness attested to all this and, in addition, specifically to circulation in Madhya Pradesh, and there was no cross-examination of her on this, she could safely be said to have discharged the burden of proof; and the onus then shifted to the Defendant to show through cogent evidence that the Indian Express newspaper, in any language, was not circulated in Madhya Pradesh and Morena; that no one in Morena knew of it...”*

6

## Trademark Oppositions

### ❖ *Gupta Enterprises Vs. M/s Gupta Enterprises and Anr [AIR 1998 Delhi 232]*

- *“Where the opposition is based on the alleged registration of the trade mark or the use and reputation of the opponent's trade mark or on any other fact, the onus of establishing those facts lies upon the opponent. It is only when the opponent initially discharge his onus that the burden shifts to the applicant.”*

### ❖ *Metropolitan Trading Company v. Mohanlal Agarwal and Ors. MIPR 2008 (1) 24*

7

- *“the burden will be on the opponent to prove that by allowing registration there will be confusion or deception. We also observe that the initial onus of proof is upon the opponents to establish prior use of the trade mark. Once the opponents have proved the same then the burden shifts on to the applicant to prove that there will be no confusion or deception.”*

## Trademark Rectifications

- ❖ *Mandom Corp. and Ors. v. Fem Care Pharma and Ors. [ORA/293/2014/TM/MUM & ORA/126/2015/TM/KOL] –*
- *“It is well-settled that once an Applicant for Rectification pleads non-use of the trade mark based on cogent material, the Respondent No. 2 must specifically deny setting out the facts on which he denies non-use of the trade mark and produce at least some evidence. In failure to do so the burden of proving bonafide use as also bonafide intention to use is wholly on the Registered Proprietor/Respondent No. 2.”*



## The Patents Act, 1970

### ❖ Section 104A - Burden of proof in case of suits concerning infringement. –

- *“(1) In any suit for infringement of a patent, where the subject matter of patent is a process for obtaining a product, the court may direct the defendant to prove that the process used by him to obtain the product, identical to the product of the patented process, is different from the patented process...”*

### 9 ❖ **Communication Components Antenna Inc. v. Ace Technologies Corp. [CS (COMM) 1222/2018]**

- *“In a patent infringement action, once the Plaintiff, prima facie establishes infringement, the onus shifts on the Defendants, to disprove the same. The complete silence by the Defendants shows that there is, in fact, withholding of relevant and crucial information from the court.”*

❖ ***Farbwerke Hoechst Aktiengesellschaft Vormals Meister Lucius & Bruning a Corporation and Ors. v Unichem laboratories and Ors. [AIR 1969 Bom 255]***

- Plaintiffs owned a Patent registration in respect of the manufacture of new sulphonyl-ureas, salts of those compounds and of an anti-diabetic preparation containing such compounds.
- Plaintiffs claimed that the Defendants had infringed their patent by manufacturing, preparing and selling pharmaceutical tablets manufactured according to the invention disclosed in its patent.
- The Defendants claimed that the said tablets had been manufactured by the application of the processes mentioned in another patent, under a licence granted to them.
- The Defendants argued that the Plaintiffs had led no evidence to show that the Defendants had produced their tablets by using the Plaintiffs' patented process.

❖ **Held-**

- *“though the general burden of establishing the case of infringement undoubtedly rests on the plaintiffs, ...the burden of proving a particular fact viz., the process by which Tolbutamide is being prepared by the defendants would be on the defendants, since that is fact "especially" within their knowledge within the terms of Section 106 of the Indian Evidence Act. It is impossible for the plaintiffs to know by what precise process Tolbutamide is being prepared by the defendants and it is precisely to that sort of a case that Section 106 is intended to apply.”*

## The Indian Evidence Act, 1872

- ❖ Section 106 –
  - *“When any fact is especially within the knowledge of any person, the burden of proving that fact is upon him.”*
- ❖ The provision is based on a consideration of the capability of parties to give evidence
- ❖ A party should not be forced to prove a fact not within its knowledge and which lies “especially” within the knowledge of the opposite party
- ❖ This provision has also been applied in Trademark infringement cases by Courts to place the burden of proving certain facts upon the Defendants -

11

❖ *Essel Propack Limited v. Essel Kitchenware Limited and Ors. [Suit No. 272 of 2010 and Notice of Motion No. 370 of 2010] -*

- *“whether the 1st Defendant actually had dealers in Mumbai and whether or not its products are or were available in Mumbai are matters specially within the 1st Defendant's knowledge within the meaning of Section 106 of the Evidence Act. It is only the 1st Defendant's witness who could depose to those facts. If the 1st Defendant has chosen not to lead evidence and chosen to keep back this information, then...an adverse inference must be drawn against the 1st Defendant for its failure to lead evidence in this regard.”*

## Presumption of certain facts

- ❖ Section 114: Court may presume existence of certain facts –
  - “*The Court may presume the existence of any fact which it thinks likely to have happened...*”
- ❖ ***The Farbwerke Hoechst judgment*** – *Presumption that the Defendant had used the Plaintiff’s patented process to produce its product.*
- ❖ ***M/s. Super Cassettes Industries Private Limited v. Nandi Chinni Kumar (Copyright case) [Telangana High Court, October 19, 2020]*** –
  - “*...it is the duty of the party to lead the best evidence in his possession...in case such material evidence is withheld, the court may draw adverse inference under Section 114...notwithstanding that the onus of proof did not lie on such party*”

## To summarize

### ❖ *Burden of proof lies on –*

- The person who seeks the Court's judgment based on facts he/she asserts
- The party which would fail if no evidence is submitted by either side

For a particular fact:

- The party which asserts a particular fact
- The party which especially has knowledge of the fact

# THANK YOU!

## Questions?

**Pranay Bali**, Senior Associate

15

© ALG India Law Offices LLP, 2020.

*Disclaimer: Views, opinions, and interpretations are solely those of the presenters, not of the firm (ALG India Law Offices LLP) nor reflective thereof.*

*This presentation hosted at: <https://www.algindia.com/wp-content/uploads/2020/12/Critical-Analysis-of-Evidentiary-Issues-in-Selected-IP-Court-Judgements.pdf>*