

Legal Issues in

Critical Analysis of Evidentiary Issues in Selected IP Court-Judgements

Module 2 – Issues related to Primary and Secondary Evidence

Relevant provisions of the Indian Evidence Act, 1872

- ❖ **Section 61:** Proof of contents of documents –
 - *“The contents of documents may be proved either by primary or by secondary evidence.”*
- ❖ **Section 62:** Primary evidence –
 - *“Primary evidence means the document itself produced for the inspection of the Court.”*
- ❖ **Section 63:** Secondary evidence –
 - *Certified copies, copies made from the original by mechanical processes, oral accounts of the contents of a document given by some person who has himself seen it, etc.*
- ❖ **Section 64:** Proof of documents by primary evidence –
 - *“Documents must be proved by primary evidence except in the cases hereinafter mentioned.”*
- ❖ **Section 65:** Cases in which secondary evidence relating to documents may be given.

Admissibility of Original Trademark Registration Certificate

❖ **B. Kishore Jain vs. Navaratna Khazana Jewellers 2008 (37) PTC 536 (Mad)**

- Plaintiff filed a suit for infringement seeking permanent injunction to restrain use of its registered mark 'KHAZANA'
- Plaintiff adduced the trademark registration certificate as evidence (Plaint Document No. 1)
- Objection raised by the defendant stating that the plaintiff was not entitled to file a suit on the basis of the registration certificate as it is not intended to be used in legal proceedings
- The defendant's contention was that the plaintiff should have instead filed a certificate of entry in the register under **Section 137(1) of the Trade Marks Act, 1999**

B. Kishore Jain vs. Navaratna Khazana Jewellers (Contd.)

❖ *“This certificate is not for use in legal proceedings”*

- The following is stated at the bottom of each Registration Certificate -

Registration is for 10 years from the date of application and may then be renewed for a period of 10 years and also at the expiration of each period of 10 years.

यह प्रमाणपत्र विधि कार्यवाहियों में प्रयोग के लिए या विदेश में रजिस्ट्रीकरण अभिप्राप्त करने के लिए नहीं है

This certificate is not for use in legal proceedings or for obtaining Registration abroad.

- This is based on Rule 62(2) of the (erstwhile) TM Rules, 2002 and Rule 56 of the TM Rules, 2017

❖ *Section 137 of the Trade Marks Act, 1999 –*

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- *“A copy of any entry in the register or of any document referred to in sub-section (1) of section 148 purporting to be certified by the Registrar and sealed with the seal of the Trade Marks Registry shall be admitted in evidence in all courts and in all proceedings without further proof or production of the original.”*

B. Kishore Jain vs. Navaratna Khazana Jewellers (Contd.)

❖ Held- Registration Certificate, being primary evidence, was admissible –

- *“I am unable to appreciate as to how and why a original certificate of registration cannot be admitted in evidence, if a mere certificate of entry in the register could be used in evidence...Section 137(1) enables the production of certified copies without insisting on production of originals. In other words, it is an enabling provision, providing for production of secondary evidence. Therefore, it cannot be interpreted to mean that the production of primary evidence is prohibited by the section”*
- *“Rule 62(2) does not flow out of any express provision contained in the Act, relating to such prohibition. Therefore, to hold that Rule 62(2) contains a bar against the production of the original certificate or registration, would militate against the very concept of primary and secondary evidence.”*

Later judgments on admissibility of Original RCs

❖ **Pidilite Industries Limited vs. Poma-Ex Products [2017 (72) PTC 1 (Bom)]**

- ❖ *“Section 137 does not place an embargo for the trial Court not to accept the true copies or copies generated through on line for consideration of interim prayer. Such prohibition is available only while admitting it in evidence and not for considering its evidentiary value at preliminary stage.”*

❖ **Amrish Agarwal vs. M/S Venus Home Appliances Pvt. Ltd. [2017 (72) PTC 98 (Del)]**

- *“in trade mark infringement matters the following documents ought to be necessarily filed along with the plaint: i. Legal Proceedings certificate (LPC) of the trade mark...ii. **If the LPC is not available, at the time of filing of the suit and urgent orders of injunction are being sought, a copy of the trade mark registration certificate, copy of the trade mark journal along with the latest status report from the website of the Trade Mark Registry. This should be accompanied by an averment in the pleadings that LPC is applied for.**”*

When secondary evidence may be given

❖ **Shanti Films and Ors. vs. Emgeeyar Pictures P. Ltd. and Ors. MIPR 2007 (3) 243**

- Plaintiffs filed a suit seeking permanent injunction to restrain infringement of copyright in three Tamil movies
- Plaintiffs had acquired world negative rights, 8mm, 16mm and TV rights of the said three movies by a Letter of Arrangement (LoA)
- Validity of the LoA challenged by the defendants
- The plaintiffs had submitted the notarised photocopy of the LoA available with them as secondary evidence

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Shanti Films and Ors. vs. Emgeeyar Pictures P. Ltd. and Ors. (Contd.)

❖ The Court's findings-

- The plaintiff had dispatched the original Letter of Arrangement to the defendant
- Notarized photocopy of the LoA was adduced by plaintiff only because the original was not forthcoming from the defendant

❖ Held-

- *“The earlier communication had been sent...the original letter of arrangement was enclosed therewith...When the original is not forthcoming from Emgeeyar Pictures, Karpagam Circuit is entitled to mark the notarised xerox copy available with it as secondary evidence as per Section 65 of the Evidence Act...In the above facts and circumstances, Ex.P18 marked as secondary evidence is accepted by this Court.”*

Exemption from filing Original documents

❖ **Aktiebolaget Volvo v. R. Venkatachalam, (2009) 160 DLT 100**

- Plaintiffs filed the suit for infringement and passing off and sought permanent injunction in relief
- Plaintiffs applied for permission to rely on the photocopies and to produce the originals only for inspection at the time of admission/denial of documents
- Plaintiffs contended that original documents are required in various litigations globally and hence it is not possible to file the same in the instant matter
- The defendants contested the application by pleading that the plaintiffs are not entitled to seek exemption from filing the original documents under the provisions of CPC (under **Order 7 Rule 14 and Order 13 Rule 1**)

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Relevant provisions of the Code of Civil Procedure, 1908

- ❖ **Order 7, Rule 14:** Documents relied on in Plaint. - Production of document on which plaintiff sues or relies-

“(1) Where a plaintiff sues upon a document or relies upon document in his possession or power in support of his claim, he shall enter such documents in a list, and shall produce it in court when the plaint is presented by him and shall, at the same time deliver the document and a copy thereof, to be filed with the plaint.”

- ❖ **Order 13, Rule 1:** Original documents to be produced at or before the settlement of issues

*“(1) The parties or their pleader shall produce, on or before the settlement of issues, all the documentary evidence of **in original** where the copies thereof have been filed along with plaint or written statement.”*

Aktiebolaget Volvo v. R. Venkatachalam (Contd.)

- ❖ Issue in consideration – *“Whether it is permissible in law to permit a party to a civil suit to file only photocopy of the document and exempt such party from placing the original document on the file of the court, and merely to give inspection thereof to the opposite party at the time of admission/denial of documents...”*
- ❖ Single Judge’s preliminary analysis-
 - Courts overburdened with large amount of litigation and the resultant paperwork puts a strain on the limited manpower and infrastructure
 - Insistence on filing originals may go against expediency, efficiency and a gradual move towards e-filings.
 - Valuable original documents are always vulnerable to loss/damage
 - *“...if the provisions of the codified law so permit, it would be expedient to, where the court finds that the original document is such, the loss or damage whereto could cause irreparable loss or inconvenience to a litigant, to allow filing of photocopy thereof only, with a condition on the party to produce the original for inspection as and when required.”*

Aktiebolaget Volvo v. R. Venkatachalam (Contd.)

❖ Held-

- Order 7, Rule 14 of CPC only mentions “*documents*” and not “*originals*” and accordingly, photocopies are also covered under the provision
- Even at the stage of proof, the requirement is only of production of the original for inspection of the Court and not of filing of the original in the Court
- The scheme of the relevant legislative provisions permits production of originals for inspection only and filing of copies only
- There is no impediment to granting the plaintiff’s application
- The aforesaid should not be understood as laying down that in all cases the filing of photocopies is enough

Mehracosmetics v. Ram Kumar Gulati & Ors. (2017) 69 PTC 419

❖ Facts-

- Plaintiff filed the suit seeking a permanent injunction to restrain passing off by the defendant
- Defendants contended that the plaintiff, having not filed any original documents till now, is precluded from doing so and therefore cannot lead any evidence
- Defendants contended further that the plaintiff has not filed or pleaded any particulars of use of the trademark and the photocopies of the bills are also forged

❖ Held-

- *“Attention of the senior counsel is also drawn to the judgment in Aktiebolaget Volvo v. R. Venkatachalam...where it has been held that it is not incumbent to file the original documents once the photocopies thereof have been filed and the originals can be produced at the stage of proof during the recording of evidence.”*

THANK YOU!

Questions?

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