January-April 2024

Case Law Updates

Intellectual Property Attorneys & Advocates

Preface:

The year 2024 in India has already witnessed a series of landmark judicial decisions across the intellectual property (IP) landscape. These rulings, which have been highly anticipated by many, have created new legal precedents and have underscored India's strong commitment to promoting a favourable environment for the protection and enforcement of IP rights. The importance of this cannot be overstated, as it plays a critical role in fostering innovation, creativity, and economic growth.

The Indian courts have shown a willingness to take a strict view on violations of IP rights, with severe penalties imposed on infringers. These developments highlight the dynamic nature of the IP landscape in India and the need for all stakeholders to stay abreast of the latest changes.

This comprehensive compilation presents key insights into the most notable court decisions during the months of January-April 2024, encompassing a broad spectrum of IP-related issues. It includes landmark rulings on patentability disputes, interpretation and application of patent laws, interpretations of Plant Varieties and Farmer's Rights laws, domain law disputes, design infringement, copyright protection, and trademark disputes.

Keeping up-to-date with the latest developments in the field of IP is crucial for businesses, inventors, creators, and investors alike, allowing them to make informed decisions about the acquisition, management, and enforcement of their IP assets in India and to take advantage of the evolving IP landscape.

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CONTENTS

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TRADEMARKS

1. Legal Flavour: Biryani King Trademark Clash Ends with Ex Parte Injunction

Case: JRPL Riceland LLP vs Neeraj Mittal & Anr. [CS(COMM) 943/2023]

Forum: Delhi High Court

Order Dated: January 4, 2024

Order: This case was filed by the Plaintiff seeking an ex parte ad-interim injunction restraining the defendants from dealing with their impugned trademark "Biryani King" or any other trademark deceptively similar to the Plaintiff's trademark "Biryani King" in respect of rice or any other edible goods. The comparative representation of Plaintiff's product, which shows the mark "Biryani King" selling classic basmati rice, is represented below along with the defendants' impugned trademark, which also shows as "Biryani King XXXL" selling premium rice:

REPRESENTATION OF PLAINTIFF TRADEMARK/LABEL "BIRYANI KING"

TRUE REPRESENTATION OF DEFENDANTS' IMPUGNED TRADEMARK/LABEL "BIRYANI KING"

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While prima facie, it was clear from a perusal of the packaging of the Plaintiff's product and the defendants' product that the names used on both products are identical; it was also submitted that the colour scheme of both products is the same, i.e. green and gold.

The Plaintiff stated that the original owner of the "Biryani King" trademark was Shree Chamunda Trading Company. The trademark was assigned to Jain Rice Land Private Limited in 2012 and then to JRPL Rice Land LLP in 2021. The Plaintiff has applied for trademark registration in 2022, facing opposition from the defendants, who claim prior use. However, the Senior Counsel argues that the defendant's application for the trademark in 2023 mentions it is "proposed to be used," undermining their claim of prior use. The Plaintiff provides evidence of selling the rice product since 2005, supported by sales invoices, copyright registration, and website www.indiamart.com listings.

Under the circumstances, the Court opined that the Plaintiff had made out a prima facie case for the grant of an ex parte ad interim injunction regarding the trademark "Biryani King." The balance of convenience lies in favour of the Plaintiff, who was likely to suffer irreparable harm if the injunction, as prayed for, was not granted.

Accordingly, the Court restrained the defendants and its principal officers, employees, and agents from using Plaintiff's trademark "Biryani King" and/or any other mark deceptively like Plaintiff's aforesaid trademark and permutations/combinations thereof in any form or manner amounting to passing off, till the next date of hearing.

2. Overturning Refusal of Trademark Application for ‘VISA EXPERTS – PARTNERING LIFE CHANGING DECISIONS’

Case: Abhinav Immigration Services vs The Registrar of Trademarks [C.A.(COMM.IPD-TM) 1/2024 & I.A. 153/2024]

Forum: Delhi High Court

Order dated: January 04, 2024

Order: This appeal was filed by the plaintiff -Abhinav Immigration Services, under Section 91 of the Trademarks Act, 1999 is directed against the order dated 22nd September 2023 [hereinafter, "impugned order"], whereby the Registrar of Trademarks has refused Appellant's trademark application No. 4455124 in class 39 for the mark " " [hereinafter "subject mark"] in respect of services pertaining to arranging travel visas, study visas, visitor visas, student visas, job visas and travel documents for persons travelling abroad; visa and immigration consultancy and advisory services.

According to the impugned order, the Registrar had found the subject mark objectionable under Sections 9(1)(b) and 11(1) of the Trademarks Act. Objection under Section 9(1)(b) of the Trademarks Act, the Registrar considers the subject mark as descriptive of the kind, quality, intended purpose, etc., of the goods/ services to which the mark is to be applied.

The Court noted that the Appellant's application for registration of an identical mark in class 35 for "overseas recruitment, outsourcing services [business assistance], employment recruitment, employment consultancy,

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employment counselling, enrolling students in the educational programs of others" has been accepted by the Trademarks Registry, with the caveat that the mark must be used as a whole. The said application is currently opposed by Visa International Service Association, a third party. Further, the subject mark is a composite mark comprising a logo containing the words "VISA EXPERTS", followed by the phrase "PARTNERING LIFE CHANGING DECISIONS". It is not a simple wordmark but is a stylised device, which is required to be assessed as a whole. Applying this test, in the opinion of the Court, the presence of the phrase “VISA EXPERTS – PARTNERING LIFE CHANGING DECISIONS” would not render the subject mark descriptive of the characteristics of the applied goods/ services, as prohibited under Section 9(1)(b) of the Trademarks Act.

As far as the objection under Section 11(1) was concerned, the Court noted that one would have to refer to the Examination Report dated 15th June 2020, which cited several conflicting marks. Of these cited marks, it was pointed out that only one mark – trademark No. 1239069 "VISA" – is registered in the name of Visa International Service Association. The remaining applications have either been rejected or abandoned.

The Appellant drew the Court’s attention to communications dated 27th and 29th September 2023, which depict that Visa International Service Association (proprietor of conflicting trademark No. 1239069) has agreed to the Appellant's application proceeding forward in class 39, provided the word "VISA" is disclaimed in the subject mark. While this understanding could not be given effect as the subject mark was refused registration, these e-mail communications nonetheless indicate that Visa International Service Association does not object to the subject mark being brought on the register if there is a disclaimer of the word “VISA”. Appellant, on instructions, also submitted that he is agreeable to the imposition of restriction over exclusive rights in the word “VISA” contained in the subject mark.

The Court noted that in light of the above, the objection raised under Section 11(1) of the Trademarks Act also does not survive, and the subject mark deserves to be accepted and advertised.

Accordingly, the Court set aside the order dated 22nd September 2023 and directed the Trademark registry to process the registration of application

No. 4455124 in class 39 for the" ” mark. The Court further clarified that the subject mark should be read as a whole and shall not grant exclusive rights in any of the words "VISA EXPERTS – PARTNERING LIFE CHANGING DECISIONS", separately or individually.

3. Highway Hospitality Clash: Mannat Group's Legal Victory with Injunction

Case: Mannat Group of Hotels Private Ltd. vs M/S Mannat Dhaba & Ors [CS(COMM) 859/2023 & I.A. 24016/2023]

Forum: Delhi High Court

Order Dated: January 4, 2024

Order: This suit was filed by Mannat Group of Hotels (plaintiff) seeking an interim injunction against eating joints at Murthal on the Delhi-Chandigarh Highway.

The plaintiff claimed that the various Trademarks, including "MANNAT DHABA" and "MANNAT", and the logo had been registered under multiple classes, including 29, 32, 33, 35, 43, and 45, and had accordingly attained repute in the said marks, which are undoubtedly associated with the plaintiffs.

The appointed Local Commissioner placed on record his report observing that the Mannat Dhaba (Defendant 1) refused to cooperate, and despite many attempts, the owner was persistent in saying that MANAT is not similar to MANNAT. New MANNAT DHABA (defendant 2) informed that the Dhaba started around September 2022 and is in the process of rebranding the Dhaba as "MAHADEV DHABA". Thus, counsel for the plaintiff stated that no relief should be pressed against defendant 2. SHRI MANNAT DHABA (defendant 3) stated that the Dhaba was originally known as "DELIGHT AMBROSIA" but was rebranded to compete with defendant 2 and other similarly branded highway restaurants that opened in the vicinity. However, counsel for the plaintiff presented a communication showing the rebranding of the said Dhaba to "MANMEET DHABA" by defendant 3.

APNA MANNAT DHABA (defendant 4) cooperated in the execution of the Commission. The owner of defendant 4 stated that he had taken over Dhaba about 2-3 months back and retained the branding of MANNAT since it was popularly used by other Dhabas in the vicinity. He further stated that he was operating restaurants in Dehradun using the brand “GREASY GRILLZZ” and had also applied for registration for the brand “MANNATT”.

The Court noted that the plaintiff was able to make out a prima facie case for the grant of an ex parte ad interim injunction against defendants 1, 3 and 4). Thus, the Court granted an ad-interim injunction in favour of the plaintiff against each of the Defendants and their owners, partners, principal officers, employees, staff and all others acting for or on behalf of the Defendants.

4. Protecting the Reputation and Goodwill of Trademark Owners: The Dispute over "Khadi" Trademark

Case: Khadi And Village Industries vs Aayush Gupta and Others [CS(COMM) 6/2024]

Forum: Delhi High Court

Order Dated: January 5, 2024

Order: Recently, the Delhi High Court granted an interim injunction order against defendants who were found to be Khadi Earth (word and logo) for the same class of goods in which the plaintiff had prior rights and despite protocol in place, the defendants did not seek any permission/certificate from the plaintiff.

The plaintiff, Khadi and Village Industries Commission, a statutory body under the Khadi and Village Industries Commission Act, 1956, was established to promote and develop textiles. The trademark "**KHADI**" was adopted in September 1956, registered across several classes and has been recognised as a well-known trademark by the Trademarks Registry. The plaintiff is the registered proprietor of the marks **KHADI**, its word and logo depictions. This mark has been in continuous use for cosmetics, food, grocery products, etc., which are sold via its website, online and offline retail outlets, exhibitions, third-party e-commerce websites, etc. Any person who wishes to sell products under KHADI trademarks had to obtain a valid certificate from the plaintiff.

The defendants were manufacturing and selling products bearing marks - Khadi Earth and khadi EARTH through their website. One of the defendants has also applied for class 3 on a proposed to-be-used basis. A legal notice was addressed to the defendants to cease the use in November 2020. While no response was received from the defendants, product listings from the defendant's website were pulled down. Subsequently, in July 2023, the plaintiff found domain names www.khadiearth.info and www.khadiearth.online, UDRP complaints against which were decided in the plaintiff's favour.

In December 2023, the defendants were found selling cosmetic products on the website www.khadiearth.com, claiming to be the "best online Khadi store in India," and via e-commerce websites. Their products prominently displayed the impugned marks.

The plaintiff's counsel argued that the impugned products showcased deceptively similar marks incorporating the plaintiff's registered KHADI trademark, thereby creating a false association in the minds of customers.

The court conceded to the plaintiff's argument and granted an ex-parte ad-interim injunction against the defendants, restraining them from manufacturing and selling any products bearing impugned marks, suspending their website, www.khadiearth.com and removing online listings.

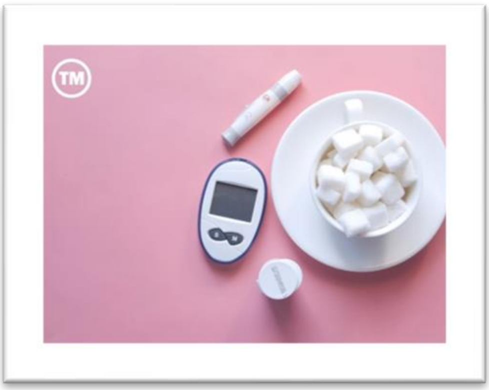
This order showcases that the Courts promptly recognise statutory and common law rights of the proprietor. Once a prima facie case is made out, the injunction order may follow to ensure that the owner/ proprietor doesn't face loss to its reputation and goodwill, which sometimes cannot be monetarily compensated. There should be no likelihood of association/link between the defendant's marks and the plaintiff's mark, as any such association negates the mandatory principle that a trademark must be an identifying factor indicative of the source of goods and services.

5. Trademark Triumph: Diabliss vs. Overra Foods – Removal and Rectification of infringing mark ‘DIABEAT’

Case: Diabliss Consumer Products Pvt Ltd. vs Overra Foods [C.O. (COMM.IPD-TM) 307/2022]

Forum: Delhi High Court

Order Dated: January 5, 2024



Order: This petition was filed by the petitioner Diabliss Consumer Products Pvt. Ltd. for removal of the trademark ‘DIABEAT’ bearing registration No.3664179 in Class 30 in the name of the respondent ‘OVERRA FOODS’ and rectification of the Register of Trademarks under Sections 57/125 of the Trademarks Act, 1999. The ‘DIABEAT’ mark had been registered in favour of respondent no.1 on its application dated 26 October 2017. The application for rectification was initially moved in 2018 before the Intellectual Property Appellate Board, and thereafter, pursuant to the amendment in the Act, it was transferred to this Court and converted into the present petition.

The petitioner has its registered office in Chennai and uses the mark 'DIABLISS' in relation to the petitioner's flagship product, which is a diabetic-friendly sugar. It is stated that the petitioner has been using the same method consistently and without a break since 2011. The mark is used to manufacture and distribute various other food products such as Diabliss Sugar, Diabliss Herbal Lemon Tea, Diabliss Mixed Fruit Jam, etc. The petitioner's exclusive website is www.diabliss.in, which provides extensive information about their products. In 2015, the petitioner adopted a distinctive trade dress for its product, Diabliss Sugar. It was stated that the petitioner had used the same consistently and without a break since then for its product.

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This mark/trade dress was created for the petitioner by M/s. Fifth Estate Communications Pvt. Ltd. and the petitioner were, therefore, the first owners of the copyright in the said trademark/trade dress. Copies of the petitioner's advertisements featuring the mark 'DIABLISS' along with the distinctive trade dress are also appended with the petition. The said mark was exclusively associated with the petitioner, both domestically and internationally, resulting from extensive sales and promotional activities. Trademark applications for 'DIABLISS' in class 30 have been applied and were opposed by respondent no.1 in 2018.

The petitioner stated that this was in the background of the fact that in 2016, respondent no.1 approached the petitioner through another associated concern for the distribution of the petitioner's product and agreement dated 10th October 2016 for the distribution of the petitioner's product in North India region had been executed. Pursuant to supplies being made through the distributor, monies were not paid by respondent no.1 for the said supplies, and the petitioner was constrained to communicate to them consistently for clearance of arrears.

Thereafter, it came to their knowledge in 2018, upon receiving a notice from respondent no.1 that a similar product with substantially the same trade dress and mark 'DIABEAT' was being manufactured and marketed by respondent no.1, pictures of petitioner's product and that of respondent no.1 are extracted below:

Petitioner's Product	Respondent no.1's product
	

Based on this dishonest use of the petitioner's mark and trade dress, a suit for infringement of copyright was filed by the petitioner against respondent no.1 before the High Court of Madras C.S. No.302 of 2018. The High Court of Madras was pleased to pass an injunction order dated 28th April 2018

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inter alia against respondent no.1, restraining them from using the trademark/trade dress 'DIABEAT'.

The petitioner stated that the said order was appealed by respondent no.1 before the Division Bench of the High Court of Madras by way of OSA No. 360 of 2018 and 361 of 2018 (respondent no.1 was appellant no.2 in the said appeals). The Division Bench of the High Court of Madras dismissed the challenge by respondent no via order dated 6th September 2018.1, It was further informed that the suit in the High Court of Madras was also decreed in favour of the petitioner herein vide order dated 28th February 2020.

The Court noted that apart from the observations and findings of the High Court of Madras, on perusal of the respective packaging adopted by petitioner and that by respondent no.1, it is quite evident that trade dress has been more than substantially adopted by respondent no.1.

The Court stated that it was quite evident from the facts and circumstances, including the distribution agreement, which were stated in the order of the High Court of Madras, that the respondent no. 1 was aware of the petitioner's trademark and trade dress in 2016 when they were appointed as distributors of the petitioner's products.

The Court stated that the application filed by respondent no.1 for registration of a trademark, including trade dress similar to that of the petitioner, was clearly a mala fide and dishonest attempt to cause confusion in the market and infringe the rights of the petitioner in their trademark/trade dress.

The Court held that the relief sought by the petitioner was to be allowed. Respondent no.2/Registrar of Trademarks is directed to effect removal of the said mark ‘DIABEAT’ bearing registration No.3664179 of respondent no.1, from the Register and the Registry’s website.

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6. ‘VERIZON’ vs. ‘VERIZONE’: Delhi High Court Grants a permanent injunction in favour of Verizon Trademark Services LLC

Case: Verizon Trademark Services LLC vs Verizone Broadband Services Pvt Ltd. [CS(COMM) 932/2023]

Forum: Delhi High Court

Order Dated: January 5, 2024

Order: This case was filed by the plaintiff seeking a permanent injunction for restraining infringement of their prior adopted and well-recognised trademarks 'VERIZON', and other marks containing, or comprising of, the trademark VERIZON (from now on collectively referred to as the "VERIZON Trademarks") along with other attendant relief.

It was stated that the plaintiff is part of the Verizon Group of Companies and among the world's leading providers of, inter alia, communications, entertainment, information technology, and security products and services. The Plaintiffs' group employs around 135,000 people worldwide, and they own and operate one of the most expansive end-to-end global Internet Protocol (IP) networks, serving more than 2,700 cities in over 150 countries, including India. The Plaintiffs' business operations are far-reaching, and their success is represented by the colossal revenue they generate, with revenues in the year 2022 alone ranging around USD 136.8 billion.

The plaintiff stated that the trademark 'VERIZON' is a coined trademark with registrations in more than 200 countries worldwide, including India.

The plaintiff's grievance was against the defendant's use of the mark VERIZONE and logo and email address verizone.broadband@gmail.com, which is deceptively similar to the plaintiffs' marks 'VERIZON'. The plaintiffs had stated that the defendant, Verizone Broadband Services Pvt. Ltd., was incorporated on 30th January, 2022. The defendant is promoting, marketing, and advertising its products and services through third-party online marketplaces such as www.justdial.com. The plaintiffs learned of the defendant's use of the said mark in the first week of December 2023.

The Non-appearance of the defendant, even after notices being served and considering the facts and circumstances, the Court opined that the plaintiffs had made out a prima facie case for grant of ex parte ad-interim injunction regarding trademarks and logos abovementioned. Balance of convenience lies in favour of the plaintiffs, who were likely to suffer irreparable harm if the injunction as prayed for was not granted.

Accordingly, the Court restrained the defendant and its principal officers, employees, and agents from using the mark 'VERIZONE' (currently being used by the defendant) and using the Plaintiffs' well-known and registered trademarks "VERIZON" and/or any other mark deceptively similar to plaintiffs' aforesaid trademarks and permutations/combinations thereof, including, in any form or manner, amounting to passing off, till the next date of hearing.

The Court further directed the defendant not to use the name 'VERIZONE' as part of their email address and take immediate steps to deactivate the said email address, and if necessary, use a different email address, which is in consonance with the directions passed above.

7. Distinctive Pharma Packaging Needed to Avoid Harm

Case: Dr. Reddys Laboratories Limited vs SGS Pharmaceuticals (P) Ltd [CS(COMM) 873/2023]

Forum: Delhi High Court

Order Dated: January 05, 2024

Order: In the recent case of *Dr Reddy's Laboratories Limited v SGS Pharmaceuticals (P) Limited*, the Delhi High Court granted relief to the plaintiff, Dr Reddy's Laboratories, by restraining the defendant from infringing on the registered trademark, trade dress, colour scheme, and distinctive packaging of the medicine Cyproheptadine sold by the plaintiff under the trademark Practin. The court found that the defendant was using identical packaging, colour scheme and trade dress to pass off their product as the plaintiff's product and ride on the goodwill and reputation of the plaintiff's product.

The plaintiff is a globally renowned pharmaceutical company that has existed since 1984 and has a worldwide presence. The trademark Practin, with its trade dress and colour scheme, was registered in 1986 by Wockhardt and assigned to the plaintiff via an assignment deed dated 9 June 2020.

The product has had an annual market value of between INR 350 and INR 600 million (USD 4.2 and USD 7.2 million) during the past five years preceding 2020. It enjoyed significant recall value in the market because of its unique appearance. Unlike the usual silver-coloured packaging used for most medicines, it was orange on one side and white on the reverse. This unique and distinctive packaging was copyright-protected and had acquired a distinct identity due to being in continuous use for three decades.

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In resisting the plaintiff's application, the defendant pointed out that it was not using the name Practin, the plaintiff's registered trademark. It sold its product under the trade name Cyproheptadine–4. Cyproheptadine is the scientific name of the salt that was the basic ingredient of the pharmaceutical product. The defendant claimed to have been using the name Cyproheptadine–4 since 2001 under a valid drug licence and, therefore, asserted its right to continue its sale.

However, the plaintiff's case revolved around the defendant using an infringing trade dress, colour scheme and deceptively identical packaging. The plaintiff argued that its application was in the interests of consumers who were likely to be misled into thinking the product of the defendant was that of the plaintiff. The defendant, on the other hand, claimed that because its medicine was a Schedule H drug and was sold only by pharmacists through a medical practitioner's prescription, the possibility of confusion by purchasers identifying the product of the defendant as that of the plaintiff was unduly exaggerated.

The court accepted the fact that the defendant held a drug licence for Cyproheptadine–4 and that the defendant had been selling the drug since 2001.

However, the court held there was no reason to sell Cyproheptadine–4 in packaging identical to that of the plaintiff's product, with the same colour scheme, trade dress and layout. This was especially so because the plaintiff used a unique bicolour scheme in the industry, created specifically to distinguish its products from the rest. The continuous presence of the product in the market since 1996 created considerable goodwill and brand recall, both of which had been protected by valid trademarks and trade dress and IP registrations.

The court granted an injunction against the use of identical packaging. The defendant was directed to submit details of distinct packaging that did not infringe the plaintiff's product through trade dress, colour scheme, layout, packaging, font, and overall appearance. Even if the defendant's product was a Schedule H drug, the possibility of being misled by identical packaging could not be discounted because the average consumer may be unable to differentiate the two products on plain viewing.

This decision emphasised two elements. First, as illiteracy was prevalent among probable consumers, the appearance of a product was significant. Second, there should be no possibility of confusion in the mind of the average consumer or purchaser of medicines. These are pharmaceutical products, and a higher degree of care must be taken to avoid any possibility of identical packaging. Even though the scientific name of the salt used in each medicine was the same, the court protected the plaintiff's intellectual property rights in its unique trade dress, colour scheme and layout.

8. Rectification Quest: Delhi High Court's Verdict on BAOJI Trademark Non-Use Allegations

Case: Rong Thai International Group Co. Ltd vs Ena Footwear Pvt. Ltd. [C.O. (COMM.IPD-TM) 100/2021]

Forum: Delhi High Court

Order Dated: January 05, 2024

Order: Recently Rong Thai International Group Co. Ltd. (*herein referred to as the **Petitioner***) filed a rectification petition before the Delhi High Court to seek cancellation of the trade mark 'BAOJI' in class 25, which was registered in favour of ENA Footwear Pvt. Ltd. (*herein referred to as the **Respondent No. 1***). The Petitioner alleged non-use of the mark by the Respondent, citing Section 47(1)(b) of the Trade Marks Act, 1999.

The Petitioner had claimed extensive use of the mark 'BAOJI' in various countries, including India, where they held a registration under Class 18. The Petitioner had also asserted that their application for registration under Class 25 for footwear was rejected due to the Respondent's existing registration. The Petitioner had contended that they only learnt about Respondent No. 1's registration of the impugned mark on 20th July 2017 upon receiving the examination report of the Registrar dated 1st July 2016.

The Petitioner has primarily relied upon an investigation report dated 11th November 2019, carried out by an independent investigator, stating that the said report confirmed that Respondent No. 1 was not using the impugned mark 'BAOJI', and even recorded the alleged statement of Mr. Rohit Sharma, Director of Respondent No. 1, that they did not manufacture any products under the mark 'BAOJI'. It was further contested that since more than five years had elapsed since the date of registration with no bona fide use by Respondent No. 1, the impugned mark is liable to be removed from the trade mark register in terms of Section 47(1)(b) of the Act.

Respondent No. 1 had contested the assertions put forward by the Petitioner, vehemently affirming their consistent use of the impugned mark 'BAOJI' since 2000 for footwear-related goods. They provided concrete evidence in the form of sales invoices from 2012 to 2022 to support their claim of ongoing commercial activity involving the mark. Furthermore, Respondent No. 1 challenged the credibility of the investigation report commissioned by the Petitioner, alleging bias and misrepresentation. By presenting these counterarguments, Respondent No. 1 sought to refute the allegations of non-use and uphold the legitimacy of their usage of the mark 'BAOJI'.

After careful consideration of the submissions from both parties and an analysis of Section 47(1)(b) of the Trade Marks Act, 1999, the Delhi High Court dismissed the Petitioner's claim. The Petitioner had failed to prove the alleged non-use of the impugned mark. The registration certificate for the impugned mark was issued in favour of Respondent No. 1 on 26th December 2013. This date had signified the official entry of the impugned mark into the register. The application for rectification in this case had been filed on 10th August 2020. Accordingly, the critical date for assessing the use of the mark had been set as 10th May 2020, three months before the filing of the rectification application.

The court had held that the sale invoices submitted as evidence had demonstrated Respondent No. 1's consistent engagement in transactions using the impugned mark from 2012 through 2022. This evidence established uninterrupted use of the impugned mark over a significant period, covering the relevant timeframe for assessing non-use. Additionally, the court noted that the investigation report, being a single self-sourced document, lacked the comprehensive perspective of multiple sale invoices. Consequently, the evidence of sustained use of the impugned mark by Respondent No. 1 outweighed the findings in the investigation report regarding non-use.

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9. Pouring Trouble: Unveiling Copyright Infringement in Tata Water Plus

Case: Tata Sons Private Limited & Ors vs Tushar Fulare [CS (COMM) 242/2022)]

Forum: Delhi High Court

Order Dated: January 10, 2024

Order: The Delhi High Court, through its decision dated January 10, 2024 (Tata Sons Private Limited & Ors vs Tushar Fulare CS (COMM) 242/2022), restricted Defendant Tushar Fulare from using the trademark ZINC WATER PLUS, trade dress, packaging and label 

, which was similar to Plaintiff's TATA WATER PLUS.

The Plaintiff, Tata Sons Private Limited, the parent company of the Tata Group, filed a copyright infringement suit against the Defendant, Tushar Fulare, for engaging in unauthorised use of the distinctive trade dress and packaging associated with the plaintiff's mineral water product, "TATA WATER PLUS", and for infringing the well-known trademarks "TATA" and "TATA WATER PLUS".

The plaintiff claimed it owns the well-known trademark "TATA" and various formative trademarks, including "TATA WATER PLUS" in classes 16 and 32. It has been permitted to use such mark through a trademark license agreement dated August 26, 2011. The plaintiff further contended that their mark, unique trade dress, and packaging had been uninterruptedly and continuously used, which has acquired secondary significance.

The plaintiff discovered the defendant's use of the impugned mark in February 2022 and conducted an independent investigation. The internet searches revealed the defendant's official websites, **www.immunitywaterplus.com** and **www.zincwaterplus.com**.

The physical investigation disclosed the defendant's involvement in manufacturing and supplying packaged water products, which bore similarity to the plaintiff's trademark and trade dress. The investigation also disclosed that the defendant's associations offered opportunities and business contracts with the plaintiff without their knowledge in exchange for money.

The Plaintiffs sought various reliefs, including a permanent injunction, damages, and rendition of accounts. The defendant did not file a written statement or lead evidence. The defendant stated that it has no objection to the suit being decreed against it, but no injunction should be directed with respect to the mark "ZINC WATER PLUS". Concerning the mark "ZINC WATER PLUS," they, however, argued, claiming it to consist of common and generic words that were widely used in the water packaging industry and lack of "ZINC WATER PLUS" registration by the plaintiff.

The plaintiff did not object to the said argument of the defendant agreeing to restrict its arguments to its trademarks "TATA", "TATA WATER PLUS", "TATA GLUCO+", and "HIMALAYAN. The plaintiff continued to emphasise that the use of the packaging adopted by the defendant should be injuncted, as it used the trade dress, artistic work and the unique and distinct packaging of the Plaintiffs' products.

The Court noted that since there was no reply filed to the allegations of the plaintiff, an admission of the plaintiff's claim in entirety was deemed, and accordingly, the Court did not find the need to delve into any other aspect. Considering the arguments of both the parties, the Court decreed in favour of the plaintiff, issuing a restraining order against the defendant for using the impugned mark and label 

, considering it as similar to that of the plaintiff's packaging. The Court further directed the defendant to remove all online and offline references to products bearing the Plaintiffs' marks from their websites and other third-party listings. The Court also awarded damages of INR 50,000 in favour of the plaintiff, along with the costs of the legal proceedings.

The Delhi High Court's decision upheld the plaintiff's rights, emphasising the imperative of safeguarding trade dress and labels from unauthorised use. It also highlights the importance of protecting well-known trademarks in India and reinforces the necessity for strong measures to maintain brand integrity and consumer trust.

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10. Delhi High Court grants Interim Injunction Against Infringing Use of “AAJ TAK” Trademark

Case: Living Media India Limited and Anr. vs Jay Jayeshbhai Tnak and Ors. [CS(COMM) 949/2023 & I.A. 26295/2023]

Forum: Delhi High Court

Order Dated: January 12, 2024

Order: In a recent legal dispute between **Living Media India Limited and Anr. And Jay Jayeshbhai Tank & Ors**., the Delhi High Court, granted an interim injunction against the defendant's unauthorised usage of the trademark "AAJ TAK". The plaintiff alleged trademark infringement and the unauthorised use of its intellectual property rights.

The plaintiff alleged that the defendant was utilising the trademark "AAJ TAK WATCH NEWS" on various digital platforms, including a YouTube channel, social media profiles, and domain names such as www.aajtakwatch.in and www.aajtakwatchnews.com.

The plaintiff claimed that the defendant's use of the mark was an infringement of its registered trademarks "AAJ TAK"/आज तक" and could potentially harm the brand's reputation. Additionally, the plaintiff argued that the defendant's actions could confuse consumers due to the similarity between the marks.

The court acknowledged that the plaintiff's trademarks, "AAJ TAK"/ आज तक" had been properly registered, and an application to declare them as well-known trademarks was also under consideration. Additionally, it was pointed out that defendant No. 1 had filed an application for a trademark

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similar to the plaintiff's mark, raising concerns about potential dilution and further infringement.

After analysing the arguments and examining the evidence presented, the court found that the plaintiff's case had substantial merit. It concluded that an ad interim injunction was necessary to prevent irreparable damage to the plaintiff's reputation and goodwill. The court also noted that the balance of convenience favoured the plaintiff in this case.

Hence, the court ordered the defendant to stop using the plaintiff's marks "AAJ TAK"/आज तक" on all digital media platforms, including websites and social media handles. Additionally, defendant No. 1 was directed to deactivate all social media profiles and domain names associated with the infringing mark. Failure to comply with these directives would lead to further actions, including suspension of domain names and deactivation of digital platforms.

Through its recent order, the Delhi High Court has demonstrated its dedication to safeguarding intellectual property rights and promoting fair competition in the digital sphere. By granting an interim injunction, the court has proactively protected the plaintiff's interests and upheld the integrity of registered trademarks. This decision serves as a valuable reminder of the importance of respecting IP laws and the consequences of failing to do so.

11. Hero Investcorp Challenges Delhi High Court Order on Trademark Dispute: A Legal Analysis

Case: Hero Investcorp Pvt. Ltd. v. V.R. Holdings [Special Leave Petition (Civil) Diary No. 46199 of 2023]

Forum: Delhi High Court

Order Dated: January 12, 2024

Order: This petition was filed by the plaintiff Hero Investcorp under Article 136 of the Constitution of India, challenging the order passed by the Delhi High Court in V.R. Holdings vs Hero Investcorp Ltd. The Court granted Hero Investcorp the liberty to raise all the objections, including those raised in the SLP, after the appeal was finally disposed of.

In its order dated 4-08-2023 passed by the Delhi High Court in V.R. Holdings v. Hero Investcorp Ltd., 2023, which was challenged in the instant matter, The Division Bench was dealing with the challenge against the dismissal of rectification moved by V.R. Holdings, referrable to Section 57 of the Trademarks Act, 1999.

The Delhi High Court Division Bench noted the fact that not only the arbitration proceedings but several other rectification petitions were pending before the Court, whose subject of contestation of proceedings was the rights of parties asserted to flow from competing interpretations of the FSA and TMNA.

While observing that staying on the impugned decision in V.R. Holdings v. Hero Investcorp Ltd., 2023 would neither revive the cancellation petition nor adversely impact the subsisting registration of the mark in favour of Hero Investcorp, to balance the interests of parties and ensure the adverse impact of the decision till the examination of appeal, the Court found passing of interim directions as appropriate and rejected the contention of V.R. Holdings being estopped from seeking interim protection. Thus, the Court had stayed the order dated 6-03-2023 in V.R. Holdings v. Hero Investcorp Ltd., 2023.

12. Delhi High Court Upholds Trademark Protection: Allied Blenders & Distillers vs. Hermes Distillery

Case: Allied Blenders @ Distillers Private Limited vs Hermes Distillery Private Limited [CS(COMM) 274 of 2021]

Forum: Delhi High Court

Order Dated: January 15, 2024

Order: This case was filed by the Plaintiff, Allied Blenders and Distillers (P) Ltd., under Sections 134 and 135 of the Trademarks Act, 1999, seeking an injunction against the defendant, Hermes Distillery (P) Ltd.'s labels.

Plaintiff is one of the leading manufacturers and sellers of alcoholic beverages under various trademarks, namely, 'OFFICER'S CHOICE', 'OFFICER'S CHOICE BLUE', 'OFFICER'S CHOICE BLACK', 'CLASS VODKA', etc. The products under the mark 'OFFICER'S CHOICE' were launched by the plaintiff in 1988, and in 2014, 'OFFICER'S CHOICE' was declared the largest-selling whisky in the world. The plaintiff submitted that it had been using the mark 'OFFICER'S CHOICE' in a distinctive design, colour scheme, layout, and get-up as its label, which had become uniquely associated with its products. The white base, red font style, and lettering of the logo were considered original artistic work under Section 2(c) of the Copyright Act of 1957. The plaintiff claimed to own the copyright subsisting in the artistic work underlying the label 'OFFICER'S CHOICE PRESTIGE WHISKY', duly registered in 2013.

Defendant Hermes Distillery (P) Ltd. is also engaged in blending and bottling liquor brands and allied products. The plaintiff discovered the defendant's activities in 2019 when 'PEACE MAKER PRESTIGE

WHISKY' with the impugned label was launched in small quantities in Haryana, Assam, and North Karnataka.

The plaintiff submitted that the positioning of brand names, font style and colour, product description, placement of marks, colour scheme, border design and central design element were almost identical. The defendant contended that there was no consistency in the plaintiff's marks, and it had been changing its labels from time to time. Further, the use of the colour combination red and white was common to the trade, and several other manufacturers used a similar combination of colours for their products. The defendant also submitted that this Court lacked territorial jurisdiction as it had not sold the impugned product under the mark' PEACE MAKER' in Delhi, nor had it acquired a license for its sale in Delhi, and neither the defendant nor the plaintiff had a registered or branch office in Delhi, nor were they conducting business there.

Comparison of plaintiff's and defendant's labels.

<table>
<tr><th>Plaintiff's "Officer's Choice" label</th><th>Defendant's infringing impugned label</th></tr>
<tr><td>
</td><td>
</td></tr>
</table>

The Court opined that though the labels were not identical, there were some clear elements of similarities between them, like (a) the use of the ribbon-like feature in the plaintiff's and defendant's labels; (b) placement of white window in red background; (c) placement of insignia/coat of arms; and (d) placement of other descriptive matter.

The Court relied on Parle Products (P) Ltd. v. J.P. and Co., Mysore, (1972) and S.M. Dyechem Ltd. v. Cadbury (India) Ltd., (2000), wherein the test for comparing the labels was not one of identity but of similarity. The Court further relied on Corn Products Refining Co. v. Shangrila Food Products Ltd., 1959 and opined that the plank of similarity had to be tested from that of a customer with average intelligence, imperfect collection, or a hazy recollection.

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The Court opined that considering the large scale of the plaintiff's products under the 'OFFICER'S CHOICE' mark, the defendant was obviously aware of the 'OFFICERS CHOICE' products and labels, and it was the overall combination of various elements that made the label confusingly and deceptively similar and not any specific single feature.

The Court further opined that "confusion need not be between products but could also be one of affiliations, sponsorship, or connection as well. A consumer might presume that the defendant's product was a differently priced product emanating from the plaintiff. Moreover, the Court must put itself in a realistic position to see how bottles were stacked on bar counters. These venues were typically not brightly lit and were usually dimly lit.

In such a setting, if a consumer ordered the plaintiff's product and the bartender served the defendant's product, owing to the broad similarity of the labels, the consumer might not even be able to tell that the product served was that of the defendant and not of plaintiffs. The test was not of the standard of a connoisseur but that of an ordinary consumer or layperson. Even the purchase at liquor outlets would include consumers who could be from varying strata of society and might not be able to discern fully the distinguishing features. Confusion as to affiliation or sponsorship was a clear possibility".

The Court relied on Skechers USA Inc vs Pure Play Sports, 2016 and opined that it was inclined to hold in the plaintiff's favour as, in the past, similar labels with different marks had already been injuncted. The Court found the following similarities in both the labels:

- The lower half of the label had a red background, and the upper half had a white background.
- There was a gold line between the upper and lower half.
- The lettering on the lower red half of the label was in white, and the lettering on the upper white half of the label was in red.
- The placement of the trademarks' OFFICERS CHOICE' (in the case of the plaintiff's label) and 'PEACEMAKER' (in the case of the defendant's label) were similar and covered a major portion of the upper white half of the label.

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- Both labels had an outer gold border.
- The use of certain insignia was also similar. The intricate differences could not be noticed in the emblem/insignia.

The Court opined that the overall appearance of the two labels was similar at first glance, constituting similar trade dress. Therefore, the two labels were deceptively similar as perceived by a person of average intelligence and imperfect recollection. The Court was convinced, prima facie, that there was a clear attempt to indulge in "smart copying", which would still be copying. The differences, in fact, showed that extraordinary effort had been put in by the defendant to identify the differences. The broad similarities were so obvious at first look, but the differences were nudged into oblivion.

The Court noted that the trademark application of the defendant was filed by one of its directors, a resident of Delhi, and the defendant was also carrying on business in Delhi and had a godown in Delhi. The Court relied on Indian Performing Rights Society Ltd. v. Sanjay Dalia (2015); Banyan Tree Holding (P) Ltd v. A. Murali Krishna Reddy, 2009; and Burger King Corporation v. Techchand Shewakramani, 2018, and held that at this stage, the Court was not inclined to uphold the objection of territorial jurisdiction and if required, an issue on jurisdiction could be framed at a later stage.

The Court opined that the defendant's label was clearly imitative of the plaintiff's label, and the use of the defendant's label would constitute a misrepresentation likely to result in passing off, which might or might not result in the sale of the product and it was well settled that even initial interest confusion was actionable. The Court further opined that irreparable harm would be caused if the interim injunction was not granted as the plaintiff's products were well-established products in the market, whereas the defendant's product had only been recently introduced under the impugned labels.

The Court thus restrained the defendant from manufacturing, selling, or offering for sale whisky or any other liquor products under the impugned label 

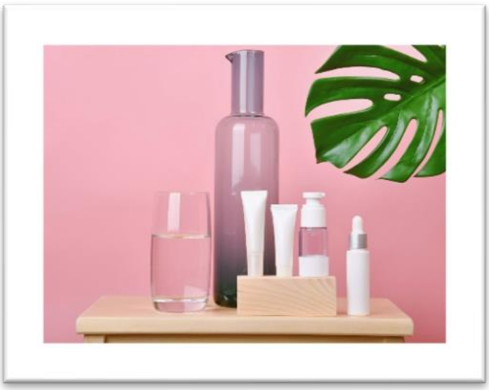
. The injunction did not preclude the defendant from using the red and white colour combination in a manner that would not cause any confusion or deception or be imitative of the plaintiff's mark/label 'OFFICER'S CHOICE'. The Court, after considering that the products were liquor products, gave thirty days to the defendant to exhaust the existing stock.

13. Trademark Squatting: Bane of a Legitimate Trademark Owner

Case: Volans Uptown LLC vs Mahendra Jeshabhai Bambhaniya [CS(COMM) 257/2023, I.A. 8234/2023]

Forum: Delhi High Court

Order Dated: January 15, 2024



Order: Trademark Squatting is a term that has evolved in this era. It is a tactic by unscrupulous entities wherein they apply for trademarks identical to the trademarks of well-known and renowned brands only to sell such trademark applications /registrations to legitimate owners at a higher cost. In general, 'squatting' means occupying a right or a property upon which the squatter has no legitimate right or claim.

In Trademark law, the squatter is very well aware of the existence of the prior trademarks of the renowned brands and still files for such trademarks only with the intent to sell them to the rightful and legitimate owners of those trademarks. Such exploitative tactics pose a significant threat to the integrity of the trademark law, underscoring the need for judicial intervention to protect and safeguard the rights of legitimate trademark owners.

In the recent judgement of *Volans Uptown LLC vs. Mahendra Jeshabhai Bambhaniya*, the plaintiff filed a *quia timet* suit before the Hon'ble High Court of Delhi seeking various remedies, including a permanent injunction against the defendant from passing off goods under the plaintiff's trademark "BOTANIC HEARTH" and its formatives. However, the defendant failed to appear before this Court, and the case proceeded *ex parte*. The factual matrix of this case was that the Plaintiff, i.e., Volans Uptown LLC, was engaged in manufacturing and selling cosmetic, skin and hair care products made from natural ingredients under the trademark "BOTANIC HEARTH".

They had registered the marks “BOTANIC HEARTH” and in 2017 in the United States and had filed applications for its registration in Canada and India. The plaintiff adopted the wordmark "BOTANIC HEARTH" in 2017, and this ownership extended to other forms or derivatives of the mark, including, *inter alia*, “BOTANIC HEARTH COSMECEUTICALS” and (*collectively as “Plaintiff’s marks”/ “said marks”*). The plaintiff was the exclusive owner and prior user of these marks and had been selling its products in various countries through e-commerce platforms, including its official website, www.botanichearth.com, since at least 2018, which was accessible by all. Its products have been available in India since at least 2020 on various e-commerce platforms such as Amazon India, Ubuy, etc., and continue to be so, demonstrating the demand and presence of its products/brand in India.

The plaintiff had also advertised, promoted, and marketed its products under the said marks in India, which had also been featured in Indian magazines and publications. The plaintiff further submitted that in September 2022, it learned that the defendant had filed a trademark application no. 5490886 for the mark “BOTANIC HEARTH” in class 3 on a “*proposed to be used*” basis, which incorporated the plaintiff's mark in its entirety.

Further, the plaintiff had also found out that the defendant was a habitual infringer and had filed over 160 trademark applications belonging to popular brands owned by third parties, some of which were UrbanBoAt', 'MATTEL GAMES', 'SIRONA', 'SUGAR COSMETIC', 'MINMAX', ‘TINKLE’ etc. The *modus operandi* of the defendant was to ride upon the goodwill and cachet enjoyed by internationally famous trademarks. In view of the same, the plaintiff had also sent a legal notice to the defendant asking it to cease and desist from using the impugned mark and assign the trademark application to the plaintiff. Later, the plaintiff received a call from the defendant's representative, who demanded approximately INR 18,00,000/- to relinquish rights in the impugned mark.

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It is pertinent to note here that the gap between the trademark application of the defendant and that of the plaintiff in India was merely a period of 3 months. During the conversation, it was also mentioned that the defendant had a similar arrangement concerning another trademark, 'UrbanBoAt', and significant details about the defendant's business operations were further disclosed. The defendant's representative also claimed that the defendant was a prominent figure in the e-commerce sector, selling sixty to seventy (60-70) thousand units daily, with a turnover of about INR 2 crores. He further revealed that the defendant manufactured various cosmetic and skincare products in China for sale in India and was establishing a manufacturing facility in Maharashtra.

This sequence revealed the *modus operandi* of the defendant, i.e., filing for registrations of well-known trademarks, including those owned by the plaintiff, to trade them or coerce legitimate owners into paying large sums of money. In case the owners refused such demands, the defendant would then capitalise on the established goodwill of the owners’ marks by selling counterfeit products on e-commerce platforms. It was also revealed that the defendant had not yet commenced using the mark “BOTANIC HEARTH”. However, it was learned that the defendant planned to start a manufacturing plant, which further gave rise to a credible apprehension that he intended to launch counterfeit products commercially.

Thus, the Court relied on *Jawahar Engineering Co. and Ors. vs Javahar Engineering Private Ltd.*, wherein it was decisively held that the actualisation of a threat was not a prerequisite for granting an injunction. The Court also emphasised that injunctive relief could be appropriately granted to forestall an injury 'likely to occur'. In light of the above facts and precedent, the Court granted an *ex parte ad interim* injunction in favour of the plaintiff by restraining the defendant from engaging in any activities that involved the direct or indirect use of products associated with the mark “BOTANIC HEARTH” and/or its formatives. Further, the Court held that the plaintiff was the prior user and adopter of the said marks. The Court also held that if the defendant were allowed to use the impugned mark(s), it would cause confusion amongst the public owing to the reputation of the plaintiff's brand and products.

Further, based on documents on record, including multiple trademark applications filed by the defendant for different renowned brands, the Court held that the defendant had a motive to engage in infringing / violative activities, thereby weakening the rights of such trademark owners. The Court also emphasised the fact that the defendant's strategy of filing trademarks identical to those of renowned and internationally recognised brands pointed to a deliberate practice of 'Trademark Squatting'. Thus, the plaintiff was awarded an injunction in its favour and the actual costs of the suit as well. The impugned mark was deemed as ‘Abandoned’ by operation of Section 21(2) of the Trade Marks Act, 1999, on February 6, 2024, as the Defendant failed to file any Counter-Statement in reply to the opposition filed by the Plaintiff.

14. Fine Words Butter No Parsnips, Nor Apparently Chicken

Case: Rupa Gujral & Ors vs Daryaganj Hospitality Private Limited [CS(COMM) 26/2024]

Forum: Delhi High Court

Order Dated: January 16, 2024

Order: On 16 January 2024, a hearing in the case of Rupa Gujral and Ors v Daryaganj Hospitality Private Limited and Ors saw the opening salvos in what could either be a lengthy campaign over culinary intellectual property or a mere skirmish in a marketing dispute.

The Delhi High Court was faced with opposing versions of the origin of two widely enjoyed dishes, Butter Chicken Masala and Dal Makhani. Moti Mahal is a well-known restaurant business, hosting many distinguished national and international guests. They brought the case against Daryaganj, claiming they were the original inventors. The claims to fame and the disputed status were prompted by Daryaganj's use of the tagline "By the Inventors of Butter Chicken & Dal Makhani". Moti Mahal, which used the branding "India's Famous Restaurant Since 1920", alleged that Daryaganj's wording was misleading and deceptive.

The hearing was for directions, but the court succinctly set out the rival claims. The plaintiffs claimed that their predecessor, Kundal Lal Gujral, was the inventor of the dishes. The defendants countered that their predecessor, Kundan Lal Jaggi, jointly with Kundan Lal Gujral, established the original Moti Mahal in Peshawar before partition. The defendant argued that the plaintiffs had no exclusive right to claim they created the dishes.

The plaintiffs submitted that their predecessor invented tandoori chicken and, upon realising that the large amounts of leftover meat could not be refrigerated, created a gravy or sauce made out of tomatoes to store the cooked meat and prevent it from drying out. The mixture had a buttery flavour and texture, causing the words "Butter" and "Makhani" to be used in the names. The plaintiffs claimed that Dal Makhani was also invented by Kundan Lal Gujral by cooking the buttery sauce with black pulses, a dish conceptually the same as Butter Chicken Masala.

The plaintiffs contended they owned the mark Moti Mahal and all marks used in their restaurants set up nationally and internationally since 1920. The plaintiffs alleged that the defendants were attempting to create a false sense of connection between themselves and the plaintiffs, as evidenced by the use of the name Daryaganj. This refers to the locality in which the plaintiffs' restaurant was set up. The plaintiffs also drew particular attention to certain allegedly deceptive content displayed on the defendants' website. This consisted of a photograph of Kundan Lal Gujral, which had been misrepresented as Kundan Lal Jaggi and an altered photograph of the plaintiffs' original restaurant in Peshawar.

As on the previous hearing date, the defendants said they had received notice only a week before the hearing date and had not filed a written statement. However, they contended that the case was misconceived and disclosed no credible cause of action. The defendants claimed the parties jointly established the restaurant, and there could be no exclusive right over the image used on their website.

This was particularly so when the defendants had cropped the name Moti Mahal appearing in the image to prevent confusion. The court acknowledged that the defendants had held out an olive branch by agreeing to take down the photo from their website within a week but without admitting any of the claims made by the plaintiffs alleging misrepresentation and deception.

In the trial, the court will no doubt have to assess voluminous circumstantial evidence. The case will determine the origin of Butter Chicken Masala and Dal Makhani so that the tagline can be attached to the name of the appropriate restaurant. It will be important to differentiate between the recipe, which forms part of the trade secret, and the banner under which the dishes will be sold for public consumption, which is part of the trademark. The court will have to determine the origin of the dishes by making findings of fact as to the establishment of Moti Mahal and Daryaganj and the relationship between their predecessors.

The court will have to decide whether to grant the plaintiffs sole rights to the use of the branding or to give the parties joint ownership. In the latter verdict, each could use the tagline.

15. Delhi High Court Grants Permanent Injunction in Favour of Su Kam Power Systems Limited

Case: Su Kam Power Systems Limited v Sukam Nextgen India Private Limited & Ors. [CS(COMM) 878/2022]

Forum: Delhi High Court

Order Dated: January 22, 2024

Order: In the recent legal battle between Su Kam Power Systems Limited and Sukam Nextgen India Private Limited & Ors., The Delhi High Court granted a permanent injunction in favour of the Plaintiff against trademark infringement, passing off, and copyright infringement.

Background:

The Plaintiff is part of the esteemed Sukam Group of companies. It has been manufacturing and trading inverters, solar power controllers, UPS, batteries, and other power backup solutions under the registered trademark "SU-KAM" since 1998. The Plaintiff's marks, consisting of copyrights and trademarks, have been diligently protected, leading to numerous awards and accolades for the company. Plaintiff has developed a solid domestic as well as international presence, even winning several awards nationally and internationally, such as "Africa's Most Reliable Inverter Brand".

Plaintiff's Allegations:

Plaintiff alleged that Defendant No. 1 adopted a mark " " that is a slavish imitation of Plaintiff's well-established marks , likely to cause confusion among consumers. In October 2022, Plaintiff learned about the defendant's use of the Impugned Mark on its website, www.sukam.co.in and online marketplace, along with modifications to the Plaintiff's Wikipedia page, raised concerns of dishonest adoption and potential misrepresentation. Upon investigation, it was found that on 24th March 2022, Defendant No. 1 had registered the aforesaid domain name, which, though not operational, shows the following homepage when opened:

Court Findings:

After careful consideration, the Court noted that the marks used by the Plaintiff and the defendant are nearly identical. However, there are a few notable differences between them. Firstly, the Plaintiff uses "SU-KAM," while the defendant uses "SUKAM" without a hyphen. Secondly, the defendant has added the phrase "Powered By NextGen" in a smaller font at the bottom of their mark. Finally, the defendant has used a darker shade of blue, but the overall colour scheme of blue and white remains the same.

The Court stated that the defendant's adoption of the impugned mark as part of its corporate/trade name appears deliberate and dishonest. The defendant has attempted to free-ride on the Plaintiff's past reputation and goodwill, especially considering the sale of similar goods by the defendant. By using the impugned mark, the defendant is not only infringing and passing off the Plaintiff's marks but also spreading false information online by misrepresenting themselves as a successor-in-interest of the plaintiff company. This is evidenced by the Wikipedia page where the sales, achievements, and accolades of the Plaintiff are shown to have accrued to the defendant. Further, Defendant No. 1 offers identical products for sale under the Impugned Mark on Defendant No. 5's website, an online B2B marketplace. It has also been argued that although Impugned Mark contains the symbol "®", the same is not registered, and thus, such use violates Section 107(1)(a) of the Trademarks Act, 1999.

Court’s Decision:

The Court, having found no defence from Defendant Nos. 1 and 2, the Court opined that no purpose would be served by directing Plaintiff to lead ex-parte evidence as the pleadings and accompanying documents sufficiently prove that Defendant Nos. 1 and 2 are misusing Plaintiff's Marks, entitling Plaintiff to protection. Therefore, exercising its power under Order VIII Rule 10 read with Order XIII-A Rule 3 of the Code of Civil Procedure, 1908, the Court is inclined to decree the suit based on pleadings and other material on record. Accordingly, the Court granted a permanent injunction against the infringement of trademarks, a permanent injunction against passing off and a permanent injunction against infringement of copyright. No relief of delivery up of the goods is being pressed. Additionally, the Court awarded Plaintiff nominal damages of INR 2 lakhs. It granted actual costs regarding the Commercial Courts Act, 2015 and Delhi High Court (Original Side) Rules, 2018, read with Delhi High Court (Intellectual Property Rights Division) Rules, 2022, recoverable from Defendant Nos. 1 and 2.

Conclusion:

This judgment is a significant victory for the Plaintiff, reinforcing the importance of protecting intellectual property rights. The Court's decision underscores the severity of infringement and the potential harm caused to the Plaintiff's reputation and consumers. It also highlights the legal consequences for those attempting to ride on the goodwill of established brands.

16. Starbucks vs Google: Court Orders Injunction and URL Suspension in Franchise Impersonation Lawsuit

Case: Starbucks Corporation and Anr. Vs. National Internet Exchange of India and Ors. [CS(COMM) 224/2023]

Forum: Delhi High Court

Order Dated: January 22, 2024

Order: The plaintiff- Starbucks Corporation filed this case seeking directions to defendant No.4 (Google LLC) to suspend the URLs listed in para 5(a) to (o) and seeking decree of permanent injunction for infringement of their 'STARBUCKS' mark and copyright in its logos , , and .

The plaintiff stated that the imposters are seeking information from general public to apply for Starbucks Franchise opportunities, which as noted above does not exist in India.

The Court has stated that the plaintiffs are entitled to the relief they seek in this application. This is because imposters are posting Google Forms to elicit information related to Starbucks franchises that do not exist in India. Additionally, they are seeking private information and data from the public, which is unacceptable. Defendant No. 4 has no issue with the relief sought as long as the URLs listed by the plaintiffs relate to the subject matter of the suit.

The plaintiffs have confirmed that the URLs mentioned in paragraphs 5(a) to (o) are only related to Google Forms that seek information about Starbucks Franchise, which doesn't exist in India. Consequently, the Court has directed the fourth defendant to suspend these URLs. To prevent repeated applications, the Court has permitted the plaintiffs to file an affidavit before the Court, listing any other URLs that link to Google Forms for inviting information from the public about the Starbucks franchise. The plaintiffs can also communicate these URLs to defendant No.4 via written or email communication. Defendant No.4 must then suspend these URLs as well, which are listed and filed by means of an affidavit before the Court and communicated to them.

The Court has directed that if defendant No.4 has any objections or reservations to any specific URL, they may respond to the plaintiffs and, if required, approach the Court for further adjudication and relief. Additionally, defendant No.4 has been ordered to provide the plaintiffs with user details of the registrants of the Google Forms listed above within two weeks via written or email communication. The information provided by defendant No.4 will be subject to their own internal policies and regulations.

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17. Victory Score of the Mark “Premier League”: Analysing the Decision of the Delhi High Court

Case: Premier SPG and WVG Mills (P) Ltd. v. Football Association Premier League Ltd. [C.A.(COMM.IPD-TM) 15/2023 & I.A. 12418/2023]

Forum: Delhi High Court

Order Dated: January 22, 2024

Order: The Single Judge Bench of the Delhi High Court on January 22, 2024, upheld the registration of the mark “**PREMIER LEAGUE”** in favour of *Football Association Premier League* in the case *of **Premier SPG and WVG Mills Pvt. Ltd vs Football Association Premier League Ltd. & Anr*** [C.A.(COMM.IPD-TM) 15/2023 & I.A. 12418/2023], and stated that monopoly cannot be claimed over the mark “Premier”, per se.

In this case, ***Football Association Premier League Ltd*** **(“Respondent”/“Applicant”)** filed an application for registration of the mark PREMIER LEAGUE (the **“mark”**) on a “proposed to be used basis” in Class 25 for clothing, headgear and footwear. The application was opposed by Premier **SPG and WVG Mills Pvt. Ltd.** (the **“Appellant”/ “Opponent”**) on the grounds that the mark was phonetically, visually, structurally and deceptively similar to the appellant's mark **‘PREMIER’**. which was conceived, coined and adopted in 1949, and registered in various classes from 1980 onwards.

The appellant claimed that they are part of the premier group with an international reputation for quality goods in the clothing industry built over the last 70 years. They are manufacturers, exporters, and marketers of yarn, clothing, and hosiery, including suits, shirts, ready-made garments, dhotis, textiles under various marks, etc. The appellant's house mark “PREMIER” and other formative marks such as , , . has been in prior continuous and extensive use in India since 1991.

On the other hand, the respondent’s mark was filed on a ‘proposed to be used’ basis in 2006 in class 25, which is relatable to the business of the appellant, and the respondent has not submitted any evidence to establish that there was wide and extensive use of the word “PREMIER”.

The respondent submitted that the respondent is a private company headquartered in London wholly owned by 20 member clubs that make up the football league and are the organising body of the ‘Barclays Premier League’. Each individual club works within the rules of football as defined by the Premier League. In connection with this business, the respondent owns and uses the distinctive ‘Premier League’ and other variants. The Premier League marks are marketed, advertised, and extensively promoted and have therefore achieved recognition amongst members of the trade and common consumers in public. The premier league marks have also secured registration in various countries of the world. In India, the respondent is the registered proprietor of the mark “Barclays Premier League” in class 25.

Moreover, there are numerous registrations, including the device that had been registered in class 25, such as ‘*Indian Premier League’, ‘Sri Lanka Premier League’, ‘Premier Golf League’, Badminton League’, and ‘Premier Sports’* which reflects that the word “premier” is a commonly used generic word, particularly in conjunction with sporting leagues around the world and therefore has acquired extensive use.

The Registrar of Trademarks rejected the opposition on February 2, 2023, and the mark was allowed to proceed for registration. It stated that there is no phonetic, visual, or structural similarity between the two marks. The only common feature between the two marks is the word ‘PREMIER’, which is a generic word, and no one can have a monopoly over the said word, nor can claim exclusivity on it. Disagreeing with the decision of the Registrar of Trademarks, the appellant filed an appeal before the Delhi High Court against the registration of the mark.

Analysis and Decision of the Delhi High Court

The Delhi High Court dismissed the appeal filed by the appellant against registration of the mark and allowed the Mark of the Respondent for registration. The Court stated that the device mark **'Premier'** and the device mark **'Premier League'** were not deceptively similar.

In order to come to this conclusion, the Delhi High Court, *inter alia*, analysed "the rule of anti-dissection" and the "identification of dominant mark" as referred to in the case of **South India Beverages v General Mills Marketing [2014 SCC OnLine Del 1953]**, wherein it was stated that the "the rule of anti-dissection" and the "identification of dominant mark" will have to be examined for comparison of composite marks. These principles were also referred to in the case of ***Vasundhara Jewellers Pvt. Ltd. vs Kirat Vinodbhai Jadvani and Ors [(2022) SCC Online Del 3370]****, and it was* held that *"it was not permissible to hold that two competing marks are deceptively similar by examining a portion of one mark and comparing it with the portion of another mark, if the composite marks viewed as a whole are dissimilar*".

Consequently, the Delhi High Court opined that the rules of anti-dissection apply to the two composite device marks being compared. Thus, the device mark of the respondent cannot be dissected to pluck out the word "PREMIER" and then compared with the appellant's registered mark. Also, the mere fact that the word "PREMIER" forms the dominant part of the respondent's mark does not necessarily give rise to a conclusion that the respondent's mark is deceptively similar to the appellant's mark. In the case of composite marks, the marks will have to be tested using an overall comparison.

The Court also relied on the case ***Pidilite Industries Ltd. v. Vilas Nemichand Jain, 2015 SCC OnLine Bom 4801***, wherein it was stated that "*mere evidence of invoices, financial figures, and sales is not enough to show distinctiveness, but what needs to be achieved is that the mark has* *acquired secondary meaning and displaced the primary descriptive meaning of the mark*”. Therefore, though the appellant’s mark has been registered and used by the appellant, it does not make the appellant’s mark distinctive. The distinctiveness of the appellant's mark lies in the arrangement of the various elements. The word ‘PREMIER’ is written in a particular style and fashion along with the flower device, whereas the respondent’s mark has a completely distinctive element using the lion wearing a crown and standing over a football, as well as using the word ‘LEAGUE’ along with ‘PREMIER’, which signifies the industry of football.

The Court agreed that the appellant's registered mark is a device mark and not a word mark, and the respondent cannot have a monopoly over the word 'PREMIER' considering that it is a word of general use and common to trade. Also, the word ‘PREMIER’ refers to the category of a league, a special kind of league which, in the context of football, has acquired worldwide recognition, goodwill and immediate recall.

In addition, the Court opined that an application in class 25 is for the purpose of selling merchandise and selling sports merchandise goods is a standard industry practice for premium sports brands. Thus, it is normal to protect the same. Further, the word ‘PREMIER’ was also contained in the respondent's earlier mark of ‘BARCLAYS PREMIER LEAGUE’ and subsisted on the trademark register for at least a period of 10 years. To claim distinctiveness over the mark, the appellant should have filed an opposition/rectification. However, no such steps were taken by the appellant.

The Court also took note of the extensive worldwide registrations of the respondent's trademark in various countries across continents, thereby reinforcing the respondent’s right of registration over the mark. The decision of the Court determines that exclusivity or monopoly cannot be claimed over words of general use and common to trade, and the “rule of anti-dissection” is pivotal for the comparison of conflicting composite marks.

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18. RAJSHREE vs RAASHEE: Trademark Dispute and Injunction Ruling

Case: Kamal Kant and Company LLP v. Raashee Fragrances India (P) Ltd. [CS(COMM) 680/2017]

Forum: Delhi High Court

Order Dated: January 23, 2024

Order: Plaintiff Kamal Kant and Company LLP filed the present suit against the defendant, Raashee Fragrances India Pvt. Ltd., seeking an injunction from using the mark 'RAASHEE'.

Plaintiff was engaged in the business of manufacturing and marketing pan masala, chewing tobacco, supari mixture, Zaffrani Patti, Zarda and other allied and cognate items since 1965, and these products were sold under the mark 'RAJSHREE' bearing registrations in classes 6, 29, 31 and 34. Plaintiff came across the trade mark application by a defendant in classes 34 and 31, respectively, for the mark 'RAASHEE' label and the mark was used in respect of similar business as that of Plaintiff, that is, zarda mix, pan masala including gutkha, zarda, safrani, khaini, mouth fresheners, scented supari, betel nuts, agricultural and other cognates, and allied goods. Defendants had been claiming user since 2009, and Plaintiff, upon coming across these trade mark applications, opposed the said marks. Though the company was live and active by the defendant, the mark 'RAASHEE' was abandoned by the defendant as of the date of filing of the suit. The Plaintiff, however, felt a reasonable apprehension in the use of the mark 'RAASHEE' by the defendant and, hence, filed the present suit.

On 11-12-2023, an option to consider adding a prefix to the mark 'RAASHEE' was suggested to the defendant so as to distinguish itself from Plaintiff's mark, and the defendant had agreed to change the mark to 'मेरी

राशी' in Hindi and to 'MY RAASHEE' in English. The Court noted that this proposal was acceptable to Plaintiff so long as the defendant did not give undue prominence to the word 'RAASHEE' and did not copy the colour combination, get up, layout or the arrangement of Plaintiff's 'RAJSHREE' paan masala packaging.

The Court restrained the defendant from using the trade mark 'RAASHEE' or any other mark which was identical or deceptively similar to Plaintiff's mark 'RAJSHREE' in respect of pan masala, mouth fresheners, scented supari, betel nuts of zarda mix, pan masala like gutka, zarda, safrani and other chewing tobacco, khaini, tobacco products, tobacco raw or any other cognate and allied goods or services.

The Court held that the defendant was, however, free to use the two proposed marks, i.e., 

, so long as the said marks were used in a manner where the words 'MY' or 'मेरी' were of the same font, colour and size as the word 'RAASHEE'. Further, the defendant, while adopting the above two proposed marks, should, however, ensure that the packaging, get-up, and layout were not in any manner imitative of the Plaintiff's 'RAJSHREE' paan masala packaging. The Court held that a cost of Rs 50,000 should be paid to the Counsels for Plaintiff.

19. Shielding Brands and Protecting Consumers in Light of Section 30(4) of the Trademarks Act, 1999

Case: Seagate Technology LLC vs Daichi International [CS(COMM) 67/2024, I.A. 1791/2024]

Forum: Delhi High Court

Order Dated: January 24, 2024

Order: In this fast-paced world of trade and commerce, brands act as a lifeline of trust between businesses and consumers. However, when counterfeit products threaten to erode this trust, it is imperative on the part of Courts and the brand owners to safeguard both the brands and consumers. The recent case of Seagate Technology LLC Vs. Daichi International [CS (Comm.) 67/2024] sheds light on the important role of Section 30(4) of the Trademarks Act, 1999, in upholding brand integrity and consumer confidence.

Seagate, a leading player in the data storage industry, filed a legal case before the Hon'ble High Court of Delhi against the defendant, a Delhi-based firm accused of importing and rebranding end-of-life hard disk drives (HDDs) bearing Seagate's trademark. This illegal act of the defendant not only infringed upon Seagate's intellectual property rights but also deceived unsuspecting consumers who unwittingly purchased counterfeit products.

In response to this infringement act of the defendant, Seagate relied on Section 30(4) of the Trademarks Act, which empowers trademark owners to prevent further dealings of their goods if their condition has been altered or impaired after being put on the market. Relying upon precedent cases such as *Kapil Wadhwa vs Samsung Electronics Co. Ltd. 194 (2012) DLT 23 and Western Digital Technologies Inc. vs Amita Tanna [FAO(OS) (COMM)*

20/2016] of Hon'ble High Court of Delhi, Seagate argued that the defendant's actions violated the rights of Seagate.

Although Section 30 of the Trademarks Act relates to the fair and honest use of the trademark by any party, the essence of Section 30(4) also lies in its ability to protect brands and consumers alike. By prohibiting the unauthorised alteration or rebranding of goods, this provision ensures that consumers can trust the authenticity and quality associated with a trademark. In essence, it acts as a shield, guarding brands from dilution and consumers from deception.

Acknowledging the validity of Seagate's claims, the Hon'ble Court issued an ex-parte ad interim injunction, restraining the defendant from further infringing upon Seagate's trademark rights. Additionally, a Local Commissioner was appointed to assess the extent of the infringement and identify unlawfully imported products.

This case underscores the importance of robust trademark protection laws in maintaining a fair and transparent marketplace. Brands serve as source identifiers and reliability for consumers, guiding them towards trusted products in the market. However, when trademarks are misused or counterfeited, consumer trust is compromised, and brands suffer.

Section 30(4) of the Trademarks Act is one of the important sections that enable the brand owner to combat infringement and preserve brand integrity. In conclusion, the case between Seagate Technology LLC and the defendant highlights the crucial role of trademark protection laws in fostering a competitive yet trustworthy marketplace. It shields the brands, keeping them safe from infringers and copycats and making sure people can trust what they buy from the market without worries.

20. Protecting Brand Integrity: Ahuja Radios vs Counterfeit Electronics Dealers

Case: Ahuja Radios vs M/S. Rohini Electronics & Ors. [CS(COMM) 498/2019]

Forum: Delhi High Court

Order Dated: January 25, 2024

Order: This case was filed by the Plaintiff Ahuja Radios, seeking a permanent injunction restraining the Defendants from dealing in any products bearing Plaintiff's trademarks "AHUJA" and AHUJA device- " or any similar mark, amounting to infringement of its registered trademarks Nos. 136189, 313757; dilution or tarnishment, and passing off of Defendants' goods as those of the Plaintiff's; damages, rendition of accounts, delivery-up and other ancillary reliefs.

The Plaintiff, Ahuja Radios, was established in the year 1940 by Mr Amar Nath Ahuja and is engaged in developing, manufacturing, marketing and exporting electronic products, particularly Public Address Systems ('PAS') and audio equipment, under the trademark 'AHUJA'. Over time, Plaintiff has achieved undisputed market leadership and is India's number one provider of PAS and audio equipment, with a dealer network comprising over 400 authorised dealers/retailers selling Plaintiff's products.

The Plaintiff contended that as a cumulative result of innate distinctiveness, far-reaching business activities, extensive sales network, widespread promotion, and publicity given, the Plaintiff's mark has acquired the status of a well-known trademark and is instantly identified and recognised by both the members of trade and public as exclusively associated with the goods and business of the Plaintiff.

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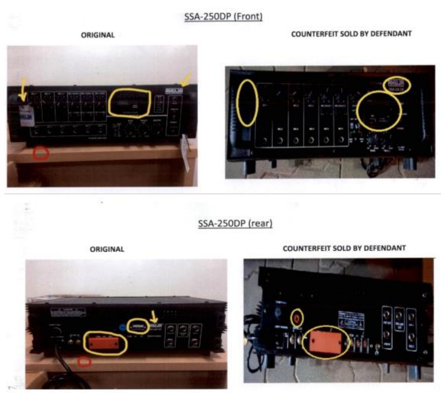
Defendant No.1, M/s. Rohini Electronics is the key supplier of the counterfeit products bearing Plaintiff's marks. Defendant Nos. 2-6, M/s M L Electronics, M/s Shiv Shakti Electronics, M/s DJ Mona Electronics, M/s Ajanta Electronics, and H.K. Sound Electronics, respectively, are engaged in selling counterfeit products bearing Plaintiff's marks. On a previous occasion, the Plaintiff had filed a suit bearing no. CS(OS) No. 2425 of 2014, in which the final decree was passed against Defendant No.6- H.K. Sound Electronics and a permanent injunction was granted. In addition to these Defendants, Plaintiff has also impleaded unidentified, or Ashok Kumar(s) engaged in the sale of counterfeit products bearing Plaintiff's marks.

In August 2019, the Plaintiff, through market sources, learned that counterfeit PAS and sound equipment bearing the Plaintiff's marks were being sold in Mumbai's wholesale markets. Upon conducting a survey, it was found that several entities were engaged in the sale of counterfeit products, and the Defendants in the present suit were specifically identified.

Plaintiff made some dummy purchases from Defendant No.1 and Defendant No. 6, and it was found that each of the Defendants was selling the impugned products at nearly 50% of the actual price of the corresponding genuine product sold by Plaintiff. This indicates that the products were an imitation and counterfeit.

Below is the pictorial chart comparing the Plaintiff’s products with the Defendants’ products, depicting the inconsistencies between the two products:



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AWM-490V2 (packaging)

The Court granted ex-parte, ad-interim injunction in favour of the Plaintiff on 12th August 2019; the same order also appointed 3 Local Commissioners to visit the Defendants' premises to inspect, seize and seal all goods bearing Plaintiff's marks. The Local Commissioners reported that the goods bearing Plaintiff's trademarks were found, which were then sealed and returned to the Defendants on Superdari.

Despite service, Defendants had chosen not to join the proceedings and proceeded ex-parte accordingly, as noted in an order dated 17th July 2023. Defendant No.2 denied their involvement in selling the infringing products and submitted that false and fabricated evidence had been filed. They claimed to be a victim of the circumstances cooked by Plaintiff.

The Court noted that the products sold by the Defendants bearing Plaintiff's marks are with the intention to profit off the significant goodwill and reputation of Plaintiff. It is apparent that the Defendants were deceiving the public into purchasing their counterfeit goods. The likelihood of confusion and deception is based on the identical nature of the two marks and the comparison of Plaintiff's products and packaging with Defendants' products and packaging found in paragraph 8 of this order. Defendants have made use of identical trademarks in relation to identical goods. It is obvious that there was a dishonest adoption by the Defendants, and a clear case for trademark infringement and passing off was made.

The Court stated that the Defendants had indulged in infringement of Plaintiff's trademark. Since the goods have been recovered from Defendant Nos. 1-4, it was also proven that the Defendants were indulging in the sale of counterfeit products. The survey conducted by Plaintiff also revealed that all the Defendants were involved in the sale of infringing products.

As already mentioned, Defendant Nos. 1 and Defendant Nos. 3-6 have not filed any defence to contest the suit. Therefore, the Court, in the exercise of its powers under Order VIII Rule 10 of CPC, is inclined to issue a decree in favour of the Plaintiff and against the said Defendants. As regards

Defendant No. 2, in the opinion of this Court, no purpose would be served by directing Plaintiff to lead ex-parte evidence as pleadings and accompanying documents prove that the said Defendants are misusing Plaintiff's marks, 1 entitling Plaintiff to protection.

Hence, the Court granted a permanent injunction in favour of the Plaintiff and restrained the defendants from using Plaintiff's registered trademarks "AHUJA" and AHUJA device- ” or any similar mark.

The Court directed Defendant No. 1-4 to deliver the goods which were seized by the Local Commissioner to the representatives of Plaintiff within four weeks from today.

The Court further awarded the damages in favour of Plaintiff, which shall be payable by Defendants No. 1-4 in the following manner/ breakup: Defendant No. 1 shall pay INR 30,000/-; Defendant No. 2 is liable to pay INR 64,000/- and likewise, Defendant No. 3 shall pay INR 22000/- and Defendant No. 4 shall pay INR 97000/-.

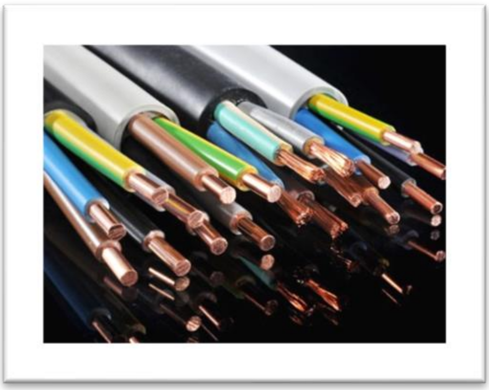
The Court held that Plaintiff is entitled to actual costs, in terms of the Commercial Courts Act, 2015 and Delhi High Court (Original Side) Rules, 2018, read with IPD Rules, 2022, recoverable jointly and severally from Defendant Nos. 1-4. The plaintiff shall file their bill of costs in terms of Rule 5 of Chapter XXIII of the Delhi High Court (Original Side) Rules, 2018, on or before 25th February 2024.

21. Gloster's Appeal Allowed to Exclude Trademark from the List of Assets in Insolvency Proceedings

Case: Gloster Cables Limited vs Fort Gloster Cables Limited [Comp. App (AT) (Ins) No. 1343 of 2019]

Forum: NCLAT Delhi

Order Dated: January 25, 2024



Order: In the recent matter of Gloster Cables Ltd v. Fort Gloster Industries Ltd. & Others, Hon'ble Mr. Justice Rakesh Kumar Jain heard an appeal filed by the aggrieved appellant - Gloster Cables Ltd, which was incorporated as Crest Cables Private Ltd in 1995 by the Modi Family and the Rathi Family, both having equal stakes in the company, which was set up to take over the assets of the sick company Sputnik Cables Pvt Ltd and commenced the business of manufacturing cables. In 2004, S. K. Bangur Group was included as an investor with equity participation and the name of the entity was changed from Crest Cables to Gloster Cables Ltd.

The Corporate Debtor, Fort Gloster Industries Ltd, the first Respondent in the present appeal, was incorporated in 1890 and owns the Trademark 'GLOSTER' duly registered in Class 9. The Second Respondent Gloster Limited was incorporated in 1923 and is in the business of Jute Products. A former employee of the Corporate Debtor filed an application bearing no. CP (IB) 61/KB/2018 under Section 9 of the Insolvency and Bankruptcy Code, 2016. The Resolution Professional, Respondent No. 3, had filed a Resolution Plan as shared by Respondent No. 2, which was duly approved by 73.21% of the members of the CoC.

While this plan was pending approval, the appellant, Gloster Cables Ltd, filed an application bearing no. CA (IB) 713/KB/2019 before the Kolkata

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Bench of National Company Law Tribunal seeking intervention to exclude the Trademark "GLOSTER" from the list of assets of the Corporate Debtor as the same was duly assigned to the appellant herein.

However, the application was dismissed by the Adjudicating Authority via order dated 19.09.2019, accepting all three objections regarding the assignment being hit by the ongoing IBC proceedings that had commenced before the registration of the mark in favour of the appellant herein.

Aggrieved by the impugned order, the appellant filed the present appeal before the National Company Law Appellate Tribunal Principal Bench, New Delhi, vide Comp. Appeal (AT) (Ins) No. 1343 of 2019. The Appellate Tribunal examined the arguments of all the parties afresh, and the first point was that the Corporate Debtor was referred to BIFR in 2001, and vide order dated 10.09.2001, the Corporate Debtor was instructed not to dispose of any assets (which includes the impugned Trademark GLOSTER) without approval from BIFR.

Since the assignment deed dated 20.09.2017 was executed after this order, it was alleged that the assignment would be null and void. Further, the appellant was aware of the Insolvency and Bankruptcy Proceedings that were underway and the consequent moratorium on any disposal of assets of the Corporate Debtor but still proceeded with the assignment of the Trademark GLOSTER. There were further allegations of undervaluation of the trademark in the said assignment deed executed on 20.09.2017. Lastly, the Registration Certificate with respect to the trademark GLOSTER was issued to the appellant on 27.09.2018, even though the CIRP was initiated on 09.08.2018. As such, the assignment and the registration were both hit by the IBC proceedings and were null and void.

The Counsel for the appellant clarified the above points by stating that the Corporate Debtor and the Appellant had executed a Technical Collaboration Agreement on 02.05.1995 by which the appellant was permitted to use the trademark GLOSTER for a period of 8 years at the cost of paying 2% royalty on the ex-works price of the products sold or leased. This technical collaboration agreement expired by efflux of time, and a new technical collaboration agreement was executed on 02.05.2003 granting the right to use for a further period of 5 years on payment of 1% royalty. On 29.07.2004, the arrangement between the Corporate Debtor and the appellant herein changed when a long-term exclusive license-to-use agreement was executed for an annual royalty of Rs 2 lakh and a consolidated license fee of Rs 3 crores. The new agreement was valid for 33 years and had an auto-renewal clause.

Thereafter, the appellant executed a loan agreement in favour of the Corporate Debtor on 10.11.2006 by way of hypothecation of the trademark GLOSTER. The loan amount of Rs 10 crores was repayable within 5 years, i.e. on or before 30.12.2011, failing which 15% interest will be charged on the loan amount. The deed of hypothecation of the trademark was executed on 31.01.2008, by which the trademark was hypothecated in favour of the appellant herein by way of first and exclusive charge.

Since the BIFR order of 10.09.2001 was already subsisting on date, the Corporate Debtor, on 15.07.2008, also executed a Supplementary Trademark Agreement by which the Trademark GLOSTER was assigned in favour of the appellant for a consideration of Rs 10 lakhs only. Further, it was stated in this agreement that the assignment would become effective without any further act or deed, i.e. actions or documentation, once the BIFR order dated 10.09.2001 gets discharged or vacated. Further, during the period 2008-2010, all parties before BIFR, including banks, were fully aware of the status of the transfer of exclusive rights and exclusive use of the trademark GLOSTER in favour of the appellant as per the disclosures made by Allahabad Bank (now Pegasus Asset Reconstruction Company) and that an additional amount of Rs 3 crores was paid by the appellant to the Corporate Creditor in lieu of these rights.

Thereafter, on 1.12.2016, SICA was repealed, and all references made to BIFR under SICA stood updated unless the company in question made a specific application to NCLT within 180 days of the repeal of SICA. However, no such application was made by any of the creditors of the Corporate Debtor, and the 180 days expired on 29.05.2017. Consequently, in terms of the Trademark Agreement dated 15.07.2008, the trademark stood assigned to the appellant herein. As a matter of abundant caution, on 20.09.2017, the appellant executed a Deed of Hypothecation with the Corporate Debtor to enable the record of the assignment of the trademark GLOSTER along with the associated goodwill in favour of the appellant in the records of the Trademark Registry.

Only after all these activities were over, that CIRP was initiated, an IRP was appointed on 09.08.2018, and a moratorium was imposed on any sale or transfer of assets of the Corporate Debtor. At this late stage, the trademark GLOSTER was already conclusively assigned and delivered to the appellant by the corporate debtor. The only thing that was left for the appellant to do was to get the assignment recorded in the Trademark Registry to show that they were the rightful owners of the mark. An application for the same was made on 25.08.2018 and the recordal of the name of the appellant in the trademark registry was affected on 17.09.2018.

Decision of the Appellate Tribunal

Consequently, the appeal was allowed, and the trademark GLOSTER was considered to be excluded from the list of assets of the Corporate Debtor on the date that the moratorium was announced, and IRP was appointed, i.e. on 09.08.2018. The Appellate Tribunal held that it is a mere recordal of the name that happened after the moratorium was announced on 09.08.2018 and not the actual transfer or assignment of the trademark by the Corporate Debtor to the appellant. The transfer of title was effected by the deed of assignment and not by recording the name of the appellant on the Trademark Register. The consideration was also not found to be inadequate at any stage, and as such, the Appellate Tribunal set aside the order of the Kolkata Bench of NCLT and allowed the appeal in favour of the appellant, thereby upholding the rights of the appellant to exclusive use and ownership of the trademark GLOSTER for due consideration paid to the Corporate Debtor much before the initiation of the CIRP proceedings.

22. Delhi High Court Grants Temporary Injunction in Favour of Havells

Case: Havells India Limited vs Azad Singh [CS(COMM) 53/2024]

Forum: Delhi High Court

Order Dated: January 25, 2024

Order: The Delhi High Court, in its order dated January 25, 2024, granted a temporary injunction in favour of the Plaintiff, Havells India Ltd ("plaintiff") and temporarily injuncted the Defendant, Azad Singh ("defendant"), from using in any manner the registered trademark "REO" belonging to the plaintiff.

Havells is a leading Fast Moving Electrical Goods Company dealing in a wide spectrum of products like cables & wires, motors, fans, modular switches, home appliances, etc. It holds the registered trademark 'REO'/ 'Reo' for its low-tension wires. Havells has also filed an application for the trademark 'REO' which is pending in classes 7, 9 and 11 and the mark 'REO' is well associated with the plaintiff's brand name and additionally submitted the copyright registration of their label:

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Havells was aggrieved by the adoption of an identical and deceptively similar trademark ‘REO-LT’/ ‘REOLT’ by the defendant, for which he has also filed an application for trademark registration in Class 9.

The plaintiff submitted that the defendant’s mark ‘REO-LT’/ ‘REOLT’ subsumes its mark ‘REO’ completely. The plaintiff submitted that the defendant has simply added the suffix of ‘LT’ in the mark, which is an abbreviation for "Low Tension", also used by the plaintiff to describe their wires as 'low tension' products and thus are descriptive. The plaintiff reproduced the comparison between the two competing marks as follows:

Plaintiff’s Trademark	Defendants’ Trademark
REO	REOLT

It was alleged that the defendant’s products are counterfeit and are not available in the open market. They are sold in a deceptive manner, creating an impression that he is associated with the plaintiff.

While determining trademark infringement/passing off, courts rely upon the ‘Triple Identity Test' to determine whether there might be a likelihood of deception among consumers. The three essentials that are required to be fulfilled for the applicability of this test are:

1. Whether both marks are similar or deceptively similar?
2. Whether both marks are used in relation to identical goods?
3. Whether the goods have identical trading channels?

The facts of the case squarely fall within the ambit of the test as the rival marks are deceptively similar, used in relation to identical goods and sold through identical trading channels.

‘Prior use’ of the mark is the most common defence used by defendants in a Trademark infringement proceeding. Section 34 of the Trademarks Act, 1999 provides that the proprietor or a registered user of a registered trade mark is not to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior to the use of the first-mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title of his or to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his, whichever is the earlier. In the present case, the plaintiff claims to have been using the mark “REO” extensively and continuously since the year 2012, while the defendant’s counsel, despite being given the opportunity to state the merits of the case, decided not to take any stance, citing lack of proper instructions.

Thus, the Court, after perusing the pleadings and documents, found that comparing the two marks shows that the defendant’s mark is an imitation of the plaintiff’s trademark and granted an injunction in favour of Havells, holding that the potential for misrepresentation and violation, of the plaintiff’s trademark rights is clear and present. The Court also observed that the addition of the descriptive abbreviation “LT”, signifying 'Low Tension' wires, as a suffix to “REO”, does little to distinguish the defendant’s mark from Havells’ mark and the minimal variation fails to alleviate the likelihood of confusion among consumers, further intensifying the need for injunctive relief. The Court further held that the balance of convenience also lies in favour of the plaintiff, as the defendant has not been able to demonstrate any use of the impugned trademark in relation to the goods, and irreparable loss would be caused to Havells in case the defendant is not injuncted from using the impugned trademark.

The defendant was accordingly restrained due to the temporary injunction order passed against him from using the trademark/tradename ‘REO-LT’ or any other mark deceptively similar to Havells’ mark ‘REO’.

23. Lotus Herbals Private Limited Alleges Infringement: 'Lotus Splash' Trademark Dispute

Case: Lotus Herbals Private Limited v. DPKA Universal Consumer Ventures Private Limited & Ors. [CS(COMM) 454/2023, I.A. 12308/2023]

Forum: Delhi High Court

Order Dated: January 25, 2024

Order: The plaintiff - Lotus Herbals Private Limited, claimed to have, in its repertoire, over 1000 skin, beauty and hair care products, all of which are sold under the house mark/trademark LOTUS. The use of the LOTUS mark is stated to have commenced in 1993. The plaintiff is aggrieved by the defendant's use of the name/logo "Lotus Splash" for the face cleanser/face wash manufactured and sold by it. The use of the name "Lotus Splash" for its product, according to the plaintiff, amounts to infringement of the plaintiff's registered "LOTUS" formative marks and also misrepresents the product of the defendants as having an association with the plaintiff.

The plaintiff accordingly issued a notice to the defendants. As the notice did not deter the defendants from continuing to use the mark, the plaintiff has instituted the present suit against the defendants, seeking a decree of permanent injunction, restraining them from using "Lotus" as part of the mark under which they sell their product. The present application, filed with the suit under Order XXXIX Rules 1 and 2 of the CPC, seeks an interlocutory injunction, pending disposal of the suit, restraining the defendants from continuing to use the impugned "Lotus Splash" Mark or any other mark which includes "Lotus" as a part thereof, pending disposal of the suit.

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Parties Contentions:

The plaintiff submitted that the plaintiff and the defendants are both using the mark “Lotus” – though, in the case of the defendants, in conjunction with the word “Splash” – for similar products, there is bound to be confusion in the minds of the public or a presumption of association between the marks of the plaintiff and the defendants. The plaintiff averred that when the defendants adopted the impugned “Lotus Splash” mark, they were well aware of the plaintiff's pre-existing registered "Lotus" formative marks.

The Defendants contended that they are entitled to the benefit of Section 30(2)(a) as “lotus” is a principal ingredient of the “Lotus Splash” product and is, therefore, indicative of its constituents. It was further submitted that Section 30(2)(a) does not refer to “use in the trademark sense”. Moreover, they submitted that they are also entitled to the benefit of Section 35. The defendants sell all the cosmetic products under the 82o E mark similarly. There is no want of bona fides. On each product, the 82o E mark prominently figures.

A comparative depiction of the products was provided to emphasise that the products are totally different in appearance:

Court’s ruling:

The Court noted that the aspect of infringement, in the facts of the present case, is restrained to Section 29(2)(a) and (b) of the Trademarks Act.

The Court observed that though the impugned “Lotus Splash” mark of the defendants is not registered, and the defendants have not sought registration thereof, it is clear that the products belong to the classes in which the word mark “Lotus” stands registered in favour of the plaintiff. There is the possibility of the consumer associating the defendant’s product with that of the plaintiff. Even a possibility of association is sufficient to constitute infringement.

The Court said that there is substance in the defendants that the defendants would be entitled to the protection of Section 30(2)(a) and that their use of the mark "Lotus Splash" cannot be regarded as infringing in nature. Since the mark "Lotus Splash" is, therefore, indicative of the characteristics of the goods they are used, the use of the mark cannot be regarded as infringing in nature. The Delhi High Court dismissed the application and held that no prima facie case for the grant of injunction was made out.

24. Appeal Fails Due to Lack of Confusion in Pictorial Representation or Phonetic Sound of Work Marks

Case: Sasken Technologies Ltd. v. Istar Development Pvt. Ltd. [MISCELLANEOUS FIRST APPEAL No.3951/2021(IPR)]

Forum: Karnataka High Court

Order Dated: January 28, 2024

Order: The Karnataka High Court, Bengaluru, heard an appeal filed by M/s Sasken Technologies Limited against the order dated 20.01.2021 passed in I.A. No. 1, 2 and 3 in O.S. No. 6500/2020 passed by the VIII Additional City Civil Judge (CCH-10). The plaintiff had approached the district court for an interim injunction to restrain the defendants from using "SALESKEN", which was deceptively similar to their registered mark SASKEN. The City Civil Judge had refused to grant an injunction in favour of the plaintiff. Hence, the aggrieved plaintiff had filed the present appeal even though OS No. 6500/2020 was not yet conclusively decided, and only the IA for interim injunction was disposed of.

Background:

The Plaintiff company was originally incorporated in 1989 in India as ASIC Technologies Pvt Ltd. In 2000, the plaintiff changed its name to SASKEN Communication Technologies Pvt. Ltd. Since 2000, they have been using the name SASKEN for technological and allied services, including hardware designing, software development, device testing, and application development and has in the past three decades earned the goodwill of a wide range of customers, many of which are reputed Fortune 500 companies. The plaintiff is a global leader in digital transformation services and has offices in Japan, USA, Germany, Finland, UK, China, Mexico and India.

The plaintiff's mark "SASKEN" is registered in several classes in India and foreign jurisdictions and has been registered since 2000, with continuous use since then.

In July 2020, the plaintiff came across the use of the mark SALESKEN by the defendant companies through a newspaper article. Further investigation revealed that the defendants had registered the mark in class 42 on 16.08.2019 on a proposed to-be-used basis for technological services. The plaintiff also learned that Defendant no. 2 had even included the word SALESKEN in its corporate name, i.e. SALESKEN TECHNOLOGIES PVT. LTD. Defendants 1 and 2 also operated a website called www.salesken.ai to offer technological services using artificial intelligence and data analytics.

As such, the plaintiff averred that there is considerable overlap in the area of operation as well as the nature of services rendered by the defendants and the plaintiff to confuse the minds of the customers due to the deceptive similarity of the words SASKEN and SALESKEN which are visually and phonetically similar and are offering similar services to identical customer base.

The plaintiff, therefore, filed O.S. No. 6500/2020 before the VIII City Civil Judge Bengaluru and sought an ad interim injunction against the use of SALESKEN by the Defendants. The defendants, on their part, entered appearance and denied all the allegations of the plaintiff. They clarified that their mark SALESKEN was registered in 2019 after due process by the competent authorities, and there is no room for confusion as the plaintiff is providing technological services while the defendant provides sales support services to enhance sales by use of Data analytics and Artificial Intelligence.

Also, the fact that the suffix KEN is used in both SASKEN and SALESKEN does not make the words phonetically identical. The customer base, as well as the nature of services, was different according to the defendant, and as such, there is no room for confusion between the two marks. As such, the defendant argued that the suit filed by the plaintiff was not maintainable. Both parties relied on a plethora of cases in support of their respective stance.

Decision of the Court

Based on the averments of both the parties, the trial court considered the issue in the light of the decided cases. It held that while the case was being admitted for hearing, the plaintiff had failed to make a prima facie case for the grant of ad-interim injunction. As such, although the case was admitted for hearing, no interim injunction was granted to restrain the use of the mark SALESKEM by the Defendants herein.

Aggrieved by the decision of the Trial court, the plaintiff filed the instant appeal vide Miscellaneous First Appeal bearing no. 3951/2021(IPR) before the Karnataka High Court, Bengaluru. Once again, the plaintiff reiterated the need for an ad-interim injunction against the Defendants to stop them from using the deceptively similar name SALESKEN and its derivatives and formative marks, which was riding on the goodwill earned by the plaintiff over the past three decades of using the mark SASKEN.

The court examined the issue at hand in detail in light of the decided case laws cited by both the parties and the trademark registrations furnished by both parties. Moreover, as explained by the plaintiff, SASKEN is derived from "SAS" for "Silicon Automation System" and "KEN" meaning "Knowledge". On the other hand, the defendant explained that SALESKEN is an acronym for "SYSTEM for APPROPRIATE LEAD ENGAGEMENT in SALES using KNOWLEDGE ENHANCING NUGGETS.

The court relied on the judgement of the Supreme Court as cited by the parties with respect to their respective stance and observed that in the matter of ***Cadilla Health Care Limited vs Cadilla Pharmaceuticals Ltd. 2001 (2) SCR 743,*** the Apex Court held that in deciding the issue of confusion the court must keep in mind the class of purchasers who are likely to purchase the goods bearing the marks, on their education and intelligence and the degree of care they will exercise in the purchase and use of the goods bearing the said marks. The same was also reiterated in examining the issue of confusion between Peter Scott whisky and Scotch Whisky in the matter of ***Khoday Distilleries Limited vs The Scotch Whisky Association & Ors 2008 (10) SCC 723.***

The court further cited the Apex court's judgement in ***Laxmikant Patel vs Chetan Bhai Shah 2002 (3) SCC 65*** wherein the Supreme Court clarified

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that injunction is necessary only if there is a probability of confusion among the marks in the ordinary course of business. Similarly, in ***Midas Hygiene Industries Ltd vs Sudhir Bhatia 2004 28 PTC 121 SC,*** the Supreme Court opined that an injunction is necessary if there is a threat of infringement and passing-off action. But there, the names LAXMAN REKHA and MAGIC LAXMAN REKHA were practically identical, and as such, the facts do not match the present case.

Further, in ***T.V. Venugopal vs Ushodaya Enterprises 2011 (4) SCC 45,*** the Supreme Court considered in detail the test of a common field of activity to a common class of customers in respect of common services offered by the plaintiff and the defendant. It held that only in case of such overlap of class of customers and services is there a likelihood of injury to the rights of the party who holds prior registration of the deceptively similar mark. However, in the instant case, no common class of services is being catered to a common class of customers as per the material put on record by both parties.

Thus, upon examining the records placed before the court, the judge reiterated that the logo, number of letters, and the manner in which SASKEN and SALESKEN are written are completely different. Further, the court held that as per Section 28(3) read with Sections 30 and 31 of the Trademarks Act, a registered owner of a trademark cannot be restrained from the use of the registered trademark by any other trademark owner till the matter is conclusively decided by the appropriate forum before which the dispute is pending adjudication.

As such, given that the visual depiction of the plaintiff's mark shows a red coloured prism with SASKEN written in capital letters and the mark of the defendant has ‘salesken' written in the lower case along with a square logo predominantly in black colour with a red colour tick mark in the left part of the black square. As such, there is no possibility of causing any confusion in the pictorial representation or the phonetic sound of the words. Based on the foregoing deliberations, the court dismissed the instant appeal, and no interim injunction was granted against the defendants, even by the Appellate Court. The court also held that during a hearing for the grant of a temporary injunction, the court could not hold a mini-trial and pre-empt the outcome of the dispute in the interim injunction stage.

25. Protecting Intellectual Property: SAP SE's Legal Battle Against Vtech Soft Solutions

Case: Sap Se vs Vtech Soft Solutions & Ors. [C.S. (COMM) 110/2020 & I.A. 3498/2020, I.A. 7098/2020]

Forum: Delhi High Court

Order Dated: January 29, 2024

Order: This case was filed by the Plaintiff- ‘SAP SE’ seeking a permanent injunction restraining infringement of trademarks and copyrights, passing off, unfair competition, delivery up, rendition of accounts, damages, etc.

Plaintiff – 'SAP SE', engaged in providing end-to-end software application solutions, is incorporated under the laws of Germany. It was established in 1972 and is the market leader in enterprise application software. It has extensive operations in India and has set up a wholly-owned subsidiary – SAP India Private Limited.

Plaintiff has been selling and distributing its products and services under the trademark ‘SAP’, which was coined, adopted and has been in use since 1972. Plaintiff is the registered proprietor of the mark ‘SAP’ and its formative marks such as ‘ ', 'SAP HANA', etc., in over 75 countries, including India.

Plaintiff first learnt about the infringing activities conducted by Defendant No. 1 in May 2019, whereby it was learnt that the said Defendant was offering pirated software with remote SAP server access through the website (“Impugned Website”) and unauthorised training on technical and functional modules on software such as SAP BASIS, SAP FICO, SAP

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HANA ADMIN, SAP HR-HCM, SAP BI-BW/BO, SAP Success Factors, SAP MM, SAP BODS etc.

In the last week of May 2019, Plaintiff's representative contacted Defendant No. 1 via email provided on the Impugned Website (info@vtechsoft.in) to enrol for Defendant No. 1's SAP BASIS Course and enquire about Defendant No. 1's infringing activities. The plaintiff's representative attended the demo session in the second week of June 2019 through the link shared by Defendant No. 1.

On 2nd August 2019, Plaintiff sent a cease-and-desist notice to Defendant No. 1 about copyright in SAP software and other confidential information, training, and educational materials and called upon the said Defendant to cease infringement of its copyright and trademarks through the online courses. As Plaintiff received no response to the C&D Notice, a follow-up letter was sent via e-mail and courier, asking Defendant No. 1 to comply with the requisitions stated in the C&D Notice and provide their response by 29th August 2019. However, no reply was received from Defendant No. 1.

Plaintiff noted that Defendant No. 1 had deactivated the website, and on 11th September 2019, a letter via e-mail and courier was sent to Plaintiff stating that Defendant No. 1 had deactivated the Impugned Website. However, Plaintiff found that the Impugned Website was reactivated in November 2019, whereby Defendant No. 1 continued to advertise SAP training on various courses.

The Plaintiff sent a final warning letter to defendant No. 1 on 16 December 2019, asking him to discontinue the impugned activities immediately. However, no reply was received. Thereafter, in January 2020, Plaintiff filed trademark and copyright violation complaints with Facebook, X (Twitter) and LinkedIn. Plaintiff submitted screenshots of Defendant No. 1's website and related social media accounts of Plaintiff's documents.

Repeat inquiries made in February 2020 disclosed that Defendant No. 1 actively infringed upon Plaintiff's trademarks and copyrights.

In the above circumstances, an ex-parte ad interim injunction was granted in favour of Plaintiff and against Defendant No. 1 vide order dated 16th March 2020. Subsequently, Plaintiff filed an Application under Order

XXXIX Rule 2A of CPC (I.A. No. 7098/2020) as Defendant No. 1 commenced offering SAP training through its newly created websites, i.e., <www.vtech-soft-solutions.business.site> and <https://vtechsoftsolutions.wordpress.com>, and promoting and advertising its infringing activities through third-party portals such as Twitter and YouTube. Plaintiff states that MarkMonitor Inc. and Automatic Inc. are the registrars of the new websites. On August 19, 2020, under the direction of the court, 2 websites of defendant No.1, i.e., www.vtechsoft.in and www.vtechsoft.co.in, were taken down.

However, now Defendant No. I have started unauthorizedly taking SAP classrooms and online and corporate training through its newly created website, www.vtech-soft-solutions. Business. The site promotes and advertises infringing activities on third-party portals, including Twitter and YouTube. Plaintiff also claims that in the second week of August 2020, it also came to Plaintiff's notice that Defendant is offering unauthorised SAP classrooms and online and corporate training through another newly created website, https://vtechsoftsolution.wordpress.com.

Since the identity of the persons allegedly committing contempt is not known to Plaintiff at this stage, the learned counsel for Plaintiff seeks leave to file an application to implead the Registrar of the website so as to find out the identity of the persons who got the website registered.

Plaintiff impleaded 33 Defendants, of which Defendant Nos. 4 to 31 were deleted from the array of parties as noted in orders dated 18th January 2022 and 31st October 2023, on the basis of undertakings given by their counsel that they would comply with all directions of the Court. Thus, the Suit is presently continuing against (a) Vtech Soft Solutions, (b) Ashok Kumar/ John Doe, (c) Automatic Inc., and (d) MarkMonitor Inc.

Despite service, Defendant No. 1 has neither appeared nor filed a written statement. The statutory period of 120 days for filing of written statements is already over.

The Court opined that no purpose would be served by directing Plaintiff to lead ex-parte evidence. The plaintiff has valid trademark and copyright registrations in its favour and is entitled to statutory protection, including the grant of an injunction for infringement. Based on the documents and the plaint, it is demonstrated that Defendant No. 1 has been dishonestly dealing in SAP products/ services comprising Plaintiff's trademarks and copyrights, including providing remote server access and pirated copies of Plaintiff's software. Defendant No. 1 has been operating by misrepresenting himself as a consultant/ trainer of SAP courses.

Even after repeatedly being put to notice of infringement of Plaintiff's rights, Defendant No. 1 has continued to engage in its unlawful activities. Their products/ services, which do not emanate from Plaintiff, are bound to create confusion and deception for customers, resulting in irreparable harm to Plaintiff's business and well-established goodwill and reputation. Therefore, the Court finds that Defendant No. 1 has committed infringement and passing off of Plaintiff's trademarks and copyrights.

The Court opined that Plaintiff has made out a case for a grant of decree of permanent and mandatory injunction. The Court was satisfied that the case was fit for rendering a summary judgment in terms of Order XIII-A of CPC, read with Rule 27 of the Delhi High Court Intellectual Property Rights Division Rules, 2022. Further, since there was no written statement(s) on behalf of Defendant No. 1, despite service, the Court is also empowered to pass judgment in terms of Order VIII Rule 10 of CPC. Hence, the Suit was decreed in favour of Plaintiff and against Defendant No. 1.

26. Invocation of Urgent Relief Not a Pretext to Circumvent Section 12A of the Commercial Courts Act, 2015: Allahabad High Court

Case: Pankaj Rastogi vs Mohd Sazid [FIRST APPEAL NO. 30 OF 2024]

Forum: Allahabad High Court

Order Dated: January 30, 2024

Order: The Commercial Courts Act was enacted in 2015 to improve efficiency and reduce delays in deciding commercial cases. In the course of three years, by way of an amendment to the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts (Amendment) Act, 2018, Section 12A was inserted, which provides for a compulsory pre-litigation mediation before the institution of a suit, where no urgent interim relief is contemplated in such suit.

The main aim and object of Section 12A, apart from de-clogging the docket of the court, is to ensure that before a commercial dispute is filed, the alternative means of dispute resolution are adopted and unnecessary litigations are avoided. The Supreme Court in Patil Automation Pvt. Ltd. and others v. Rakheja Engineers Pvt. Ltd. [(2022) 10 SCC 1] has ended the long pending controversy regarding whether section 12A is mandatory or directory while holding that it is a mandatory provision and any suit instituted while violating the mandate of section 12A must be rejected under Order VII Rule 11 of Code of Civil Procedure, 1908 (CPC).

However, soon the courts found themselves grappling with the attempts made by parties to bypass and evade the statutory pre-litigation mediation under section 12A, thereby making the provision otiose by contending that the Plaintiff is contemplating urgent interim relief, which in reality found to

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be without any basis. Finding itself in one such circumstance, the Hon'ble High Court of Allahabad, while upholding the pivotal nature of section 12A, has relegated the Plaintiff therein to a pre-litigation mediation process, thereby returning a finding that there is no urgent interim relief contemplated in the suit.

The Hon’ble High Court has relied upon the judgment of the Hon’ble Supreme Court in Yamini Manohar v. TKD Keerthi [2023 SCC Online SC 1382], wherein the Supreme Court has negated the proposition that the Plaintiff has the absolute choice and right to paralyse section 12A by making a prayer for urgent interim relief and has held that commercial courts are empowered to examine the nature and subject matter so as to ascertain if a suit contemplates and seeks an urgent interim relief or not.

Factual Background

The appeal before the High Court was preferred against an order dated 31.10.2023 whereby the District Court rejected the suit filed by the Plaintiff and allowed the application under Order VII Rule 11 of CPC of the Defendants on the ground that prayer for urgent interim relief is imaginary and section 12A cannot be bypassed. Before filing the said suit, the Plaintiff had earlier filed one suit against the same Defendants on the basis of the same cause of action without making any prayer for urgent interim relief, and the said earlier suit was withdrawn. Therefore, since the first suit was filed without any prayer for urgent interim relief, the learned District Court held the prayer of urgent interim relief in the second suit as “imaginary” and an attempt by the Plaintiff to bypass the mandate of pre-litigation mediation as per Section 12A of the Act. The counsel for the Plaintiff before the High Court argued that there is always an urgency in cases pertaining to trademarks. The counsel objected to the argument for the Defendants, who contended that on the factual matrix of the case, there is no urgency demonstrated by the Plaintiff, which is also evident from the fact that the Plaintiff filed the first suit without seeking any urgent interim relief.

Observation of the Hon’ble Court

The High Court observed that section 12A underscores the legislative intent to promote alternative dispute resolution mechanisms and reflects the broader global trend towards embracing consensual and collaborative approaches to conflict resolution instead of traditional litigation's adversarial nature. The High Court referred to Patil Automation *(supra)* and outlined that in the absence of a prayer for urgent interim reliefs, a suit cannot be instituted without mandatory compliance with section 12A of the Act, and the same can be rejected under Order VII Rule 11 of CPC. Therefore, while following the principles laid down by the Supreme Court in TKD Keerthi *(supra),* the High Court held, under the facts of the case, that since the Plaintiff did not show any urgency in the earlier suit, the second suit along with prayers for urgent interim reliefs was rightly adjudicated by the District Court to be imaginary and an attempt to bypass the mandatory provision of section 12A.

Conclusion

The object of the lawmaker in inserting section 12A in the Commercial Courts Act 2015, apart from de-clogging the courts, is surely for the advancement of justice and for securing the public good by avoidance of unnecessary litigation. The interpretation of section 12A by the High Court in the present case as well as by the Supreme Court in the case of TKD Keerthi *(supra)*, apart from furthering the intentions of the lawmakers, also empowers the Commercial Court to verify and examine, though to a limited extent, as to whether a suit contemplates any urgent interim relief or not. Thus, it can be safely inferred that there is no absolute or unfettered right upon the Plaintiff alone to decide whether to resort to the procedure under Section 12A.

27. Rajesh Sultania & Anr. vs Arun Kumar Murarka: Battle of Intellectual Property Rights

Case: Rajesh Sultania & Anr. v. Arun Kumar Murarka [CM(M)-IPD 8/2023 & CM APPL. 31052/2023]

Forum: Delhi High Court

Order Dated: January 30, 2024

Order: This petition under Article 227 of the Constitution of India, read with section 151 of the Code of Civil Procedure, 1908, challenges the order dated 18th March 2023, which dismissed the Petitioners' application under Order VII Rule 11 of the CPC. The application sought rejection of the plaint filed by Mr. Arun Kumar Murarka, the Respondent.

The Respondent's suit concerns trademarks "YEH KHILA YEH KHILA" and "TIN TIN," seeking a permanent injunction against the Petitioners for alleged infringement, passing off activities, and violation of copyright.

While Petitioners had initially raised a broad array of arguments, the scope of their challenge before the Court has been narrowed. Petitioners have precisely directed the challenge towards asserting that the Respondent's suit for trademark infringement is non-maintainable. This assertion was predicated because the Respondent did not possess the registration for the trademark "YEH KHILA YEH KHILA."

Petitioners' Contentions:

The Petitioner stated that the Respondent lacked standing to initiate the lawsuit as he was neither the owner nor the registered user of the trademark "YEH KHILA YEH KHILA." The Respondent's admission of being a permitted user, as stated in paragraph 7 of the response to the application

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under Order 7 Rule 11, indicated his lack of proprietorship or registered usage, rendering the lawsuit non-maintainable.

The Petitioner contended that the Trial Court's reliance on the decision in George V Records v. Kiran Jogini regarding sister concerns does not apply as the Respondent is an individual, not a corporate entity, and thus cannot be considered part of a single economic entity.

Respondent's Contentions:

The Respondent operates his business through two incorporated entities, namely Herumb Trade Private Limited and Murarka Exim Pvt Ltd. In M/s Herumb Trade Private Limited, the Respondent and Mr Amar Nath Murarka (his brother) are directors. Similarly, in Murarka Exim Pvt Ltd., the Respondent and Mr Ravi Shankar Murarka (his son) hold the positions of directors.

The trademark "YEH KHILA YEH KHILA" also comprises a label for which the Respondent, proprietor of M/s Tirupati Udyog, has a copyright registration. The Respondent claimed copyright ownership of the label incorporating the trademarks and is the registered proprietor of the trademark "TIN TIN," as demonstrated in the plaint.

Court's Analysis and Findings:

The Court considered the aforenoted contentions. Firstly, Petitioners rely only on a selective portion of Max Healthcare Institute Limited v. Sahrudya Health Care Private Limited. Notably, in the referenced decision, the Court ultimately dismissed an application under Order VII Rule 11 of the CPC. This dismissal came despite the plaintiff in the cited case not possessing registered or usage rights for the word mark "Max." The suit was adjudged maintainable because the plaintiff held registrations for six composite labels, which prominently incorporated the "Max" mark as an integral element.

Likewise, the Court noted that the Respondent alleged infringements concerning the trademarks "YEH KHILA YEH KHILA" and "TIN TIN," as well as the copyright of the label displaying these marks. Thus, the Respondent has dual status as the copyright holder of the label embedding the trademarks and the registered proprietor of the "TIN TIN" wordmark.

This dual ownership confers upon the Plaintiff a legitimate basis to initiate actions against copyright and trademark infringements. The essence of the Plaintiff's lawsuit, encompassing trademark infringement, passing off, and copyright infringement, signifies a multifaceted legal dispute. Thus, the Court finds that the Plaintiff's comprehensive claim, integrating multiple aspects of intellectual property rights violations, discloses a valid cause of action for infringement of copyright and trademark, alongside passing off.

The Court noted that the recent assignment of the trademark "YEH KHILA YEH KHILA" in favour of the Respondent further supports his ownership claims. The Court emphasised that rejecting a plaint under Order VII Rule 11 does not assess the viability of the cause of action but merely examines if it adequately discloses one. Consequently, the Court did not find any merit to entertain the petition, and accordingly, the same was dismissed along with pending applications.

28. Delhi High Court grants interim injunction to Tata Sons for marks TATA WATER PLUS' and 'TATA COPPER+'

Case: Tata Sons Private Limited & Anr vs Mohan Kumar Kotana [CS(COMM) 91/2024, I.A. 2223/2024, I.A. 2224/2024]

Forum: Delhi High Court

Order Dated: January 31, 2024

Order: This suit was filed by plaintiffs- Tata Sons Private Limited & Anr., seeking a permanent injunction restraining the defendant from the infringement of copyright, trademark, trade dress in the packaging, passing of dilution and other attendant reliefs of the plaintiffs' intellectual property rights. Plaintiff no.1 is Tata Sons Private Limited, while plaintiff no.2 is Tata Consumers Products Limited. Plaintiff no.1 is a promoter and principal investor holdings of the House of TATA, one of India's oldest and largest business conglomerates. The House of TATA has various businesses under its umbrella, and through its group of companies, subsidiaries and associate companies have ventured into various products.

This case was filed in relation to a mineral water product that was originally sold under **'TATA WATER PLUS'** and is now sold under **'TATA COPPER+'**. The trademark 'TATA' has been declared as a well-known trademark. The trademark 'TATA WATER PLUS' has been registered in Classes 16 and 32 vide registration dated 22nd July 2009, whereas the trademark 'TATA COPPER WATER' has been registered vide registrations dated 11th December 2017 and 17th January 2020 in Class 32.

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Plaintiffs have also applied for the device mark 'TATA COPPER+ WATER', i.e. bearing Trademark Application No.5756647 dated 09th January 2023 in Class 32. The plaintiffs stated that the trademark application has been accepted and advertised under the Trademark Registry and is pending registration.

The ‘TATA WATER PLUS’ product bearing the unique packaging was initially launched in the year 2012, and currently, the product is sold under 'TATA COPPER+' Water bearing the device mark .

The plaintiffs’ case was that their product had been specially developed to enhance the health and nutrition relating to water, which is packed with copper and zinc in a form that the body can easily absorb. The plaintiffs have been using the unique label in the distinct copper brown colour since 2012, with other features that are unique and distinct.

The plaintiffs stated that they are aggrieved by the marketing and sale of the defendant’s product ‘VIZAG GOLD’S COPPER+ WATER’ with the device mark .

The defendant is a proprietor of M/s Sri Sai Aqua Industries conducting business at D. No. 2-114, Adireddypalem, Sabbavaram, Anakapalli, Visakhapatnam, Andra Pradesh – 531035, India.

The plaintiff presented the products in Court and submitted that inter alia, the following unique features of the plaintiffs' product have been copied:

(i) The brown colour cap,
(ii) The copper brown label,
(iii) The use of the word “Copper+”,
(iv) The glandular disc using the background,
(v) The annular ring, which is used in the background,

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(vi) The human figure used next to the mark, etc.

Based upon the investigation conducted by the plaintiffs, it transpired that the factory of the defendant was spread across an area of 1600 square feet with 10 people working there. The investigator noticed about a thousand units of 1 litre and ½ litre bottles bearing the impugned marks of the defendant. The photographs of the factory have been appended by the plaintiff and extracted as follows:

The inquiries by the investigator revealed that the defendant has plans to expand the business beyond the local territory where they are situated. In fact, upon ordering the impugned product from New Delhi, the defendant dispatched their products to the investigator.

After hearing the plaintiff and looking at the evidence presented, the Court was satisfied that the plaintiffs had made out a prima facie case for the grant of an ex-parte ad interim injunction till the next date of hearing. Balance of convenience lies in favour of the plaintiffs, and the plaintiffs are likely to suffer irreparable harm in case the ad interim injunction, as prayed for, is not granted.

Accordingly, The Court passed an ex-parte ad interim injunction against the defendants till the next date of hearing on the following terms:

- The defendant and any other person acting on his behalf is restrained from manufacturing, selling, offering for sale, distributing, advertising, and/or in any manner dealing with the infringing product 'VIZAG GOLD'S COPPER+ WATER' bearing the trade

- dress 

or from dealing in any other product that may have a trade dress similar to that of the plaintiffs'.
- The defendant and any other person acting for and on his behalf are restrained from disposing of any of the infringing products that are available in their factory premises or with their stockists, if any.

The Court further appointed a Local Commissioner with the direction to carry out the following mandate:

a. Local Commissioner shall be accompanied by a representative of the plaintiffs as well as counsel for the plaintiff.
b. Local Commissioner shall visit the premises of the defendant located at D. No. 2-114, Adireddypalem, Sabbavaram, Anakapalli, Visakhapatnam, Andra Pradesh – 531035, India, prepare an inventory and seize all goods, packaging materials, promotional materials, banners, signage, carton, stationery bearing the trade dress 

or any other trade dress that is similar to the plaintiffs' trade dress. The said products shall, after the seizure, be returned on super dark to the defendant after taking an undertaking that the defendant shall not tamper with the sealed products.
c. The local commissioner shall demand disclosure of the whereabouts of other outlets and locations of the defendant where similar goods have been stocked. Upon receiving the information, visit the said premises and execute the directions in para (a) above.
d. Local Commissioner is permitted to take a photocopy/screenshot of all the books of accounts, including ledgers, cashbooks, purchases and sales records, etc., in physical and electronic form and place the same on the court record
e. To ensure unhindered and effective execution of this order, the Station House Officer ("SHO") of the local police station within whose jurisdiction the premises of defendant no. 1 lie is directed to

render all necessary assistance and protection to the Local Commissioner, if and when sought.

f. In the event the Local Commissioner finds the premises of defendant no. 1 locked, they may be permitted to break open the lock.
g. Local Commissioner shall serve a copy of this order along with a copy of the suit to the defendant.

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29. Unsubstantiated Allegations of the Plaintiff Lead to Dismissal of its Case

Case: Marico Ltd. & Anr vs J. K. Enterprises [CS/128/2004]

Forum: Calcutta High Court

Order Dated: January 31, 2024

Order: In the legal arena, intellectual property disputes, particularly those concerning trade mark infringement, often bring to light complex issues of ownership, brand reputation, and the enforcement of intellectual property rights. A recent case, ***Marico Ltd. & Anr. vs. J. K. Enterprises, decided on January 1, 2024***, provides a nuanced perspective on the legal implications of trade mark infringement. The case importantly explores the Court's exercise of discretion under Order VIII Rule 10 of the Code of Civil Procedure, 1908, which says that the Court is entitled to pronounce judgment against the defendant defaulting to file the written statement or to pass such other order as deemed fit, further underscoring the requirement to proving the allegations made by the Plaintiff through cogent documentary evidence.

Facts of the case

The case was originally filed by M/s Hindustan Lever Ltd. (original Plaintiff), a company engaged in marketing perfumed coconut oil under the trade mark 'NIHAR'. The word 'NIHAR' appeared on the labels and packages in a distinctive style, get-up, write-up and in a distinctive colour scheme. The original Plaintiff, who had been selling the product since 1995, transferred its rights in its trade mark 'NIHAR' to M/s Marico Ltd by way of an assignment deed together with goodwill in 2006. Subsequently,

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Marico Ltd. became the proprietor of the trade mark 'NIHAR' and is now the Plaintiff in the current case.

In 2004, the original Plaintiff learned that the Defendant had been selling coconut oil in plastic packets, which had deceptive similarity, trade-dress, get-up, colour scheme, and dimensions to that of the original Plaintiff. The original Plaintiff alleged that the Defendant is engaged in the sale of coconut oil with packaging and branding deceptively similar to 'NIHAR'. In 2009, the present Plaintiff came to know that Defendant has been marketing and selling double-filtered coconut oil 200ml jars bearing deceptively similar mark ‘Nihal’.

It was the finding of Plaintiff that the style, colour scheme and writing type of the packages of the coconut oil of the Defendant are deceptively and confusingly similar to that of the Plaintiff. The allegations such as mala-fide object to deceive and confuse the consumers and pass off their product as that of the Plaintiff were made against the Defendant. The suit sought various reliefs, including a permanent injunction and the destruction of infringing labels and packages.

In a noteworthy turn of events, the Defendants did not contest the suit despite being served with summons. As a result, the Court, in accordance with procedures, deemed the suit undefended. It was noted by the Court that the present Plaintiff derived its right, title, and interest with respect to the trademark in question by virtue of the deed of assignment executed by the original Plaintiff. The said deed of assignment and registration certificate of the trademarks, a genesis of Plaintiff’s right, title and interest, whereas the list of documents annexed to the plaint does not contain the certificate of registration and the copy of the deed of assignment for a reason best to the Plaintiff.

This Code of Civil Procedure in India provides the Court with discretionary power to pronounce judgment based on the contents of the plaint when a defendant fails to present a written statement. Interpreting the said provision, the Plaintiff's counsel argued that the Court should pronounce judgment solely on the basis of the plaint. In the opinion of the Plaintiff’s counsel, the Court must judge the contents of the plaint and documents on record as being of unimpeachable character and should not require any evidence to be led to prove its contents.

Court's Discretion and its decision

The Court examined the extent of discretionary power available to it under the procedure in case that these. The Court evaluated the Supreme Court's interpretations of Order VIII Rule 10, as evidenced in cases like Modula India vs. Kamakshya Singh Deo and Balraj Taneja & Anr. vs. Sunil Madan & Anr., highlighting the discretionary nature of the Court's power. The Court concluded there is discretionary power in the Court to pronounce judgment or to pass other appropriate orders. No straight-jacket formula can be put forth.

It is not a mechanical process to pronounce judgment mandatorily in the absence of a written statement. Everything depends upon the nature, character and merit of each case. It was the observation of the Court that it is discretionary for a Court, and it may require the Plaintiff to prove the facts averred in the plaint by evidence. This cannot be curbed or stopped at the instance or insistence of a Plaintiff who is not willing to adduce evidence.

That being said, it was again highlighted by the Court that the Plaintiff did not adduce any evidence once the Court required the facts to be proven. Since the allegations of the Plaintiff were not proved, the Court showed its inability to go into or consider the substantive issue involved and therefore, the Court considered its fit to dismiss the case as ‘not proved’.

Conclusion

The above case, unfolding against the backdrop of trade mark infringement accusations, not only sheds light on the intricacies of intellectual property conflicts but also delves into the nuanced application of procedural laws. The Court's verdict offers valuable insights into the complexities surrounding ownership, brand reputation, and the enforcement of intellectual property rights. Despite being undefended by the Defendant, a noteworthy aspect of the case was the Court's meticulous examination unveiled an evidentiary gap in the Plaintiff's key documentary evidence, which raised significant questions regarding the strength of the Plaintiff's case and the sufficiency of the evidence to support their assertions.

Ultimately, the Court's decision to dismiss the case as 'not proved' rested on the Plaintiff's failure to present any evidence when required to substantiate the facts. This underscores the Court's commitment to upholding evidentiary diligence and ensuring a fair and thorough evaluation of trade mark infringement claims.

This case serves as a significant precedent in navigating the complex legal terrain of trade mark disputes, emphasising the importance of thorough documentation, evidentiary diligence, and the nuanced exercise of discretionary powers by the Court. As the legal landscape continues to evolve, this verdict provides valuable guidance for practitioners, businesses, and stakeholders involved in trade mark disputes, urging a meticulous approach to both the legal and evidentiary aspects of such claims.

30. Delhi High Court Issues Permanent Injunction Order Against Usage of the Mark "Times Pro"

Case: Bennett Coleman And Company Limited vs Timespro Consulting LLP & Ors [CS(COMM) 723/2022, I.A. 12370/2023 & I.A. 12371/2023]

Forum: Delhi High Court

Order Dated: February 05, 2024

Order: In a recent dispute between ***Bennett Coleman and Company Limited vs Timespro Consulting LLP & Ors [CS(COMM) 723/2022, I.A. 12370/2023 & I.A. 12371/2023],*** the single Judge Bench of the Delhi High Court on 5 February 2024 passed a permanent injunction order in favour of the plaintiff restating the defendants from using **TIMES PRO"** as a trademark, domain name, email and on social media platforms which is identical or deceptively similar to those of the plaintiff's marks, business and services.

The plaintiff *inter alia* submitted that *Bennett Coleman and Company Limited* belongs to 'The Times Group', which started 184 years ago and publishes newspapers, journals, magazines and books. The Times Group comprises various independent companies involved in various businesses, such as event management, financial services, outdoor advertising, educational services, real estate, etc., with a combined annual turnover of over USD 700 million. The plaintiff has been using the trademark TIMES PROPERTY for its real estate business and publishing a dedicated supplement in the plaintiff's newspapers since 2001.

The plaintiff also obtained the domain name https://timesproperty.com to provide information on the sale, purchase, and renting of properties.

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The plaintiff is the registered proprietor of 'TIMES', 'TIMES PRO', 'TIMES PROPERTY' and TIMES formative trademarks for various goods and services, where 'TIMES' is an essential and dominant feature. The plaintiff's mark TIMESPRO' along with device 'TIMESPRO' have been registered since 2013, with the user in the mark 'TIMES' since 1838. On account of long, continuous and extensive use, the trademark TIMES has acquired formidable goodwill and reputation, signifying the source and origin of goods to the plaintiff. Thus, any use of the trademark 'TIMES' with or without any additions would lead to an association with the plaintiff's business due to its sales and promotions.

In addition, the plaintiff has been zealously protecting its intellectual property rights and has several injunction orders in its favour where the defendants in those cases have been restrained from using the word 'TIMES' with different suffixes. Therefore, the plaintiff claimed that the impugned mark "TIMESPRO", adopted by the defendants as a trade name, trademark and domain name on social media platforms, along with the word 'CONSULTING' in relation to real estate services, are identical to the plaintiff's business in real estate and the adoption of a deceptively similar mark for identical services is likely to confuse the consumers and members of the public.

Further, the plaintiff submitted that despite a legal notice and a cease and desist notice sent by the plaintiff calling upon the defendants not to use the impugned mark for real estate business, the defendants have continued with the company and have chosen not to respond to the notice. The use of the mark by the defendants aims to encash the formidable and stellar reputation of the plaintiff's trademarks. This is leading to irreparable harm and injury to its reputation, as well as blurring of the trademarks. Therefore, the plaintiff applied to permanently restrain the defendants from using the mark "TIMESPRO CONSULTING" and its formative marks and pay legal costs to the plaintiff. The defendants failed to appear before the Court and file the written submissions.

On 4 November 2023, the Court, upon examining the evidence presented by the plaintiff, found merit in the plaintiff's claims and granted an ex-parte ad interim injunction against the defendants until the next hearing date.

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Accordingly, the defendants and all those acting on the defendant's behalf were restrained from using the mark 'TIMESPRO CONSULTING' as a trademark, trade name, domain name, email, social media identifier or in any other manner that was identical or deceptively similar to the plaintiff's trademarks TIMES, TIMESPRO, TIMES PROPERTY & TIMES formative mark in relation to business purposes which were identical or similar to those of the plaintiff.

The Order of the Delhi High Court

Pursuant to the order dated 4 November 2023, the plaintiff filed an application seeking the pronouncement of a judgment and decree. Upon examining the averments and submissions of the plaintiff and the absence of appearance and written submissions by the defendants, the single Judge bench of the Delhi High Cout passed the following order in favour of the plaintiff:

1. The defendants, its partners, assignees in business, licensees, its franchisees and all persons claiming right through them are permanently injuncted from using the mark, trade name, domain name, email and on social media platforms in any manner or any other trade mark, tradename, domain name which is identical or similar to the plaintiff's trademarks "TIMES", "TIMESPRO", "TIMES PROPERTY" and TIMES formative marks in relation to any business, services, goods, domain name, email and all social media platforms or in any manner whatsoever amounting to infringement of plaintiff's registered trademarks.

2. The defendants, its partners, assignees in business, licensees, franchisees and all persons claiming right through them are permanently injuncted from using 'TIMESPRO CONSULTING' as a mark, trade name, domain name, email and on all social media platforms, in any manner or any other trade mark, trade name, domain name which is identical and similar to the plaintiff's trademarks TIMES, TIMESPRO, TIMES PROPERTY and TIMES formative marks in relation to any business, services, goods, domain name, email and social media platforms or in any manner whatsoever amounting to passing off of the defendant's business and services as those of the plaintiff.

3. Decree of mandatory injunction is also passed directing the defendants to surrender in favour of the plaintiff, the domain name “timesproconsulting.com” and email address “timesproconsulting@gmail.com” and/or any other domain name/email containing the mark which is identical or deceptively similar to plaintiff’s marks and its formative marks; or in the alternative to deactivate such domain names and email addresses.

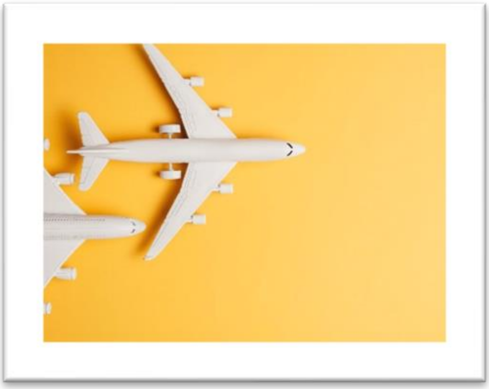
In conclusion, the Court observed that using the mark "TIMES PRO CONSULTING" by the defendants amounts to infringement of the plaintiff's registered trademarks, passing off the defendant's business and services. The domain names and emails adopted by the defendants are identical or deceptively similar to the plaintiff's marks and their formative marks. Consequently, the permanent injunction order was passed against the defendants, and the defendants have also been directed to pay legal costs of Rs. 1,50,000, to be deposited in favour of the plaintiff within a period of six weeks.

31. Legal Eagles Soar: A Deep Dive into the 'FLY HIGH' Trademark Dispute

Case: Frankfinn Aviation Services (Pvt.) Ltd vs Fly- Hi Maritime Travels Private [CS(COMM) 83/2024]

Forum: Delhi High Court

Order Dated: February 05, 2024



Order: Intellectual property is an essential aspect of commerce that represents innovation and creativity driving businesses forward. Trademarks, in particular, serve as unique symbols of a company's identity and reputation. However, with the increasing number of businesses and digital platforms, protecting trademarks has become crucial, leading to legal disputes aimed at safeguarding these valuable assets.

A recent case before the Delhi High Court sheds light on one such trademark dispute, offering insights into the complexities of intellectual property law and the pursuit of justice in commercial arenas. The case delves into the defendants' alleged infringement of the trademark 'FLY HIGH'.

The Plaintiff- Frankfinn Aviation Services (Pvt.) Ltd, a reputed organisation that imparts training in aviation, hospitality, travel management, and customer services. They have an extensive network of 'State of the Art' training institutes around India, which are run under the trademark and style of "FRANKFINN" and "FLY HIGH". The plaintiff is the proprietor of the trademark 'FLY HIGH' in India, registered under No. 1535614 in Class 41, for providing education and training services in aviation, hospitality, travel and customer care management.

The Plaintiff coined and adopted the 'FLY HIGH' trademark in 2004, although user details were claimed from 2007 when seeking registration. Since then, the mark has been continuously and extensively used to impart education and training in aviation, hospitality, travel, etc. As a result, the 'FLY HIGH' trademark has gained immense goodwill and reputation and has become distinctive of the Plaintiff's activities. Furthermore, the Plaintiff owns several domain names incorporating the 'FLY HIGH' trademark, including www.flyhigh.in.

The Plaintiff's grievance was the adoption of the mark FLY HI \ by the defendant, which is nearly identical/ deceptively similar to the Plaintiff’s registered mark.

Plaintiff contended that Defendants are utilising the Impugned Mark for services falling under Class 41, where Plaintiff holds statutory rights in the trademark 'FLY HIGH'. These services operate within the aviation and hospitality sectors and directly compete with the Plaintiff. Additionally, the Defendants operate a website, www.fly-hi.in, mirroring the Plaintiff's domain name, further exacerbating the potential for confusion.

Despite the Plaintiff's longstanding use of a similar mark since 2004, the Defendants have applied for registration of the Impugned Mark in Classes 16, 39, 41, and 43, claiming usage since February 2023. The Plaintiff opposed the Defendants' application in Classes 16, 39, and 43, pending adjudication before the Trademark Registry. Notably, the Registrar of Trademarks has objected to the Defendants' application in Class 41 due to the Plaintiff's existing trademark 'FLY HIGH', suggesting that the Defendants knowingly adopted the Impugned Mark despite awareness of the Plaintiff's rights.

Following a ‘Cease and Desist’ notice issued by the Plaintiff on November 20, 2023, the Defendants refused to cease the use of the Impugned Mark. Consequently, it was evident that the Defendants had purposefully and knowingly adopted the Impugned Mark to confuse the public and associate themselves with the Plaintiff’s renowned trademark, which holds significant goodwill and reputation.

The Defendants argued that they provided a detailed reply on December 6, 2023, delineating their distinct services. Defendant No. 1, FLY-HI Maritime Travels Private Limited, operates as a global travel management company specialising in air ticketing, Visa, insurance, and hotel services, distinct from the Plaintiff's focus on training within the travel, aviation, and hospitality sectors.

Moreover, Plaintiff has yet to engage in the mentioned services since the registration of their trademark. Hence, the Impugned Mark is easily distinguishable from the Plaintiff's registered trademark, and there is no overlap in services between the two parties. Consequently, the Defendants argue that there is no likelihood of confusion and, thus, no grounds for granting an injunction.

After thoroughly examining arguments from both sides, the court rendered an ad-interim injunction in favour of the Plaintiff. The court recognised the potential confusion in the public domain and the established goodwill associated with the Plaintiff's trademark, thereby issuing an interim order restraining the defendants from using any mark identical or deceptively similar to 'FLY HIGH.'

This Order by the Court is valid until the next hearing scheduled for July 11, 2024, prohibiting the defendants from utilising the impugned mark in any form, including domain names, to mitigate the risk of infringement, passing off, and dilution of the Plaintiff's rights. In essence, the case epitomises the judiciary's commitment to safeguarding intellectual property rights, underscoring the pivotal role of courts in resolving complex commercial disputes and upholding the sanctity of trademark protection laws.

32. Misrepresentation and Abuse of Process in Pharmaceutical Trade Dress Case: A High Court Review

Case: Alkem Laboratories Ltd vs Wings Pharmaceuticals Pvt Ltd & Anr. [FAO (COMM) 25/2024]

Forum: Delhi High Court

Order Dated: February 06, 2024

Order: Recently, in the case of Alkem Laboratories Ltd. as the Appellant and Wings Pharmaceuticals Pvt Ltd & Anr. as the Respondents in the High Court of Delhi, addressed allegations of trade dress infringement within the pharmaceutical industry.

The crux of the dispute centres around an ad-interim order issued by the Commercial Court on 16th January 2024, which appointed a Local Commissioner to seize goods allegedly infringing upon the trade dress of the Respondent's product, 'ORASORE'. The Commercial Court found the packaging of the Appellant's product, 'OROGARD', to bear significant visual and structural similarities to the Respondent's product, potentially leading to consumer confusion.

The Appellant, however, raised a serious accusation of misrepresentation against the Respondents. It claimed that the Respondents had presented outdated packaging to the Court, which had been discontinued since January 2022. According to the Appellant, the presentation of discontinued packaging was a strategic move to unfairly obtain the ad-interim injunction.

Upon examination of the packaging presented by both parties, the High Court found limited similarity, primarily noting a common pictorial depiction of a mouth showing ulcers. Such depictions are common in products that treat mouth ulcers, suggesting that this alone cannot conclusively establish trade-dress infringement.

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Furthermore, the Appellant highlighted a troubling issue: the Respondents' circulation of a publication falsely claiming a ban on the Appellant's product. The High Court observed that this publication constituted an abuse of the legal process, with the sole intention of tarnishing the Appellant's reputation.

The Court emphasised that the ad-interim order was provisional and did not warrant such public announcements. This action would disentitle the Respondents from any further interim relief if proven.

Despite the Local Commissioner's absence of seized goods, the High Court refrained from passing further orders at that stage. Instead, it directed the Appellant to address its grievances before the Commercial Court. Additionally, the Appellant was permitted to seek permission to sell its existing manufactured product stock.

The High Court emphasised the Commercial Court's responsibility to promptly address any applications submitted by the parties, ensuring a fair and expedited dispute resolution within two weeks.

The High Court's decision underscores the importance of fair representation and the severe consequences of misusing legal processes. It highlights the need for integrity in legal proceedings and the obligation of courts to ensure a swift and just resolution of disputes.

33. Balancing of Substantive and Procedural Laws in Trademarks Disputes

Case: TTK Prestige Limited vs Baghla Sanitaryware Private Limited [CS(COMM) 281/2021, I.A. 7377/2021 & I.A. 13421/2023]

Forum: Delhi High Court

Order Dated: February 07, 2024

Order: The Delhi High Court, in a recent case of '*TTK Prestige Limited vs Baghla Sanitaryware Private Limited'*, refused to entertain an application filed by TTK Prestige Limited ("**Plaintiff**") to place additional documents on record under Order XI Rule 1(5) of Code of Civil Procedure, 1908, as amended by the Commercial Courts Act, 2015.

The plaintiff filed a suit for infringement of its trademarks PRESTIGE and Prestige, its copyright of PRESTIGE LOGO, passing off and unfair competition against Baghla Sanitaryware Private Limited & Ors. ("**Defendants**") before the Delhi High Court on June 02, 2021. It was the plaintiff's case that the defendants were engaged in the manufacturing and sale of baths, kitchen fittings, and accessories and were misusing the plaintiff's registered trademark, PRESTIGE. The plaintiff later discovered that the Defendants had also obtained registration for the trademark PRESTIGE in Class 11.

The Court passed an ex-parte ad interim injunction restraining the Defendants from selling, offering for sale and advertising in any manner any sanitaryware, bath and kitchen fittings, kitchenware, cookware, etc., under the logo Prestige. The Defendants filed the written statement, and thereafter, replication was filed by the plaintiff. The Defendants then filed an interim application to place additional documents (invoices) on record, and the said application was allowed.

Thereafter, the plaintiff filed another application to place on record certain additional documents such as promotional materials, CA certificates showing sales and promotional figures, unaudited statements of sales and promotional expenses, etc., of the plaintiff's predecessor company.

The plaintiff submitted that the defendants had not filed any supporting documents with their written statement and filed them only after a year. The said application was allowed by the Court because the trial in the present matter had not yet commenced. They further submitted that it claimed the use of the trademark PRESTIGE since 1955.

Still, when filing the present suit, the documentary evidence proving such use before 2007 was not readily available, and only after the defendants filed their WS claiming use since 2005 did the plaintiff search for old records and discovered that the relevant documents formed a part of a disposed suit filed before the District Court, Tiz Hazari. Given the above and relying on Order XI Rule 1(5) of CPC, the plaintiff submitted that it satisfied the test of *reasonable cause*, and no prejudice would be caused to the Defendant if the application was allowed as trial had not commenced yet.

The defendants argued that the plaintiff's application was belated and mala fide, and that the plaintiff cannot be allowed to place additional documents on record two years after the filing of the replication without a valid reason. They further contended that negligence by the plaintiff in filing documents supporting its claim cannot satisfy the test of 'reasonable cause' under Order XI Rule 1(5) of CPC.

The Court viewed that the CCA's object was to ensure speedy disposal of high-value commercial suits and early resolution and that, with the advent of the CCA, deadlines and their elasticity had become strict and sacrosanct.

The Court's decision was based on its observation of a lack of diligence on the part of the plaintiff, as they failed to produce any additional documents despite several opportunities. The Court further held that the plaintiff, being a company of repute, should have been diligent about protecting its trademarks and that it would not pass muster with the DHC that the plaintiff had scrambled for some documents to prove the use of its house mark PRESTIGE for more than two years after the institution of the suit. The Court also held that no prejudice was caused to the plaintiff, as they filed voluminous documents along with their plaint and additional documents along with the replication.

The Court further observed that the issues in the Present Application were compliance, deadlines, and lack of reasonable cause. Thus, reasonable cause for non-disclosure of documents is not to be established for documents that are discovered after the filing of the plaint; that reasonable cause under Order XI Rule 1(10) of CPC as amended by CCA cannot be extended to negligence in filing additional documents before the Court but must necessarily refer to a cause that was beyond the control petitioner which prevented the petitioner from filing the additional documents along with the written statement.

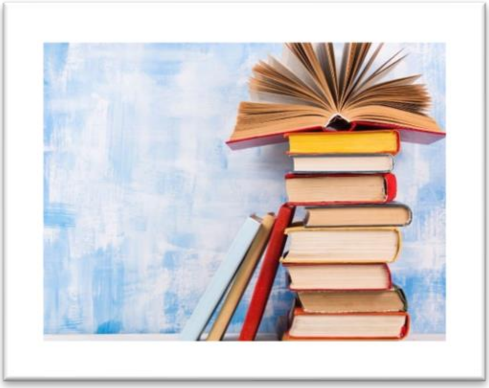
Further, the Commercial Division is not required to entertain or allow applications for late filing of documents without any reasonable cause established for the non-disclosure along with the pleading. Any inadvertent error in filing additional documents is not a reasonable cause for not filing additional documents along with the plaint. In view of this, the Court clarified that strict timelines must be adhered to in commercial suits, and parties intending to obtain an injunction in trademark disputes cannot be tardy in collecting their documents.

34. Infringing Scholastic Material Not Requiring Close Study

Case: Oswal Books And Learning Pvt Ltd vs Bokaro Students Friend Pvt Ltd And Ors [C.S. (Comm) No. 120/2024]

Forum: Delhi High Court

Order Dated: February 07, 2024



Order: In the recent case of Oswaal Books and Learning Private Limited v Bokaro Students Friend Private Limited and Ors, the plaintiff, Oswaal Books and Learning, applied for and was granted an urgent ex parte order preventing the defendant, Bokaro Students Friend, from selling pirated versions of their books and study materials.

The plaintiff is in the business of publishing educational books and study material for board exams conducted by the ICSE, CBSE and various states, as well as for other competitive examinations such as the JEE, the NEET, the CAT and the CLAT. It sells its books through a network of 16,000 bookstores across 500 districts. The plaintiff registered the trademark Oswaal Books, its logo and the name under which the books were sold. The plaintiff also claimed copyright in its study materials, sample question papers and solutions. The plaintiff claimed that it had provided answer keys to the questions in the study material through QR codes unique to each book.

Purchasers of the infringing study material contacted the plaintiffs, complaining that the QR codes were not functioning, and they could not access the answer keys. On investigating, the plaintiff found that unknown publishers were selling identical books with the same covers. However, such study material was defective, with blurred cover pages, QR codes that did not work or were missing and low-quality printing. The counterfeit books were clearly not the original high-quality materials of the plaintiffs.

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The plaintiff's name and goodwill were being tarnished by the circulation of the inferior books and study materials. The plaintiff suffered economic loss, and the students suffered from poor quality of study material. The samples submitted to the court showed that the infringing material showed a sufficiently superficial similarity that students would be duped into buying the counterfeit material, assuming it to be genuine.

The plaintiff's investigations led it to sources in Delhi, such as Bokaro Students Friend and Kashyap Book Depot, that were supplying the infringing copies. Many bookshops across various states were identified as selling counterfeit material. None of the suppliers and sellers had responded to the plaintiff's legal notices.

Aggrieved by the actions of the defendants, the plaintiff applied to the court for ex parte interim injunctions against the defendants. The plaintiff argued that the acts of piracy and counterfeiting were jeopardising the careers of students and causing the loss of goodwill, reputational harm and financial loss to the plaintiffs while channelling wrongful gain to the defendants.

After hearing the plaintiff and examining the pirated and original books, the court was satisfied that the plaintiff had made a good case for admitting the case and restraining the defendants. The court held that the balance of convenience was in favour of the plaintiff because of the loss being caused. There was an urgent need for injunctions pending the final hearing of the case against the defendants, who the court found were selling pirated versions of copyrighted study materials and sample question papers under the plaintiff's trade name, trade dress and colour scheme.

The court ordered the defendants be restrained from publishing, printing, offering for sale or advertising in any manner any product bearing the plaintiff's registered trademark, Oswaal Books, or any other mark that was deceptively similar or passed off as the plaintiff's products, infringing on their copyright in the study materials.

The court appointed local commissioners to enter the premises of the defendants with the police, by force, if necessary. The local commissioners were authorised and instructed to gather all infringing material at the various premises bearing the logo, trademarks and trade names of the plaintiff and the plaintiff's published and unpublished copyrighted study material. They were to make inventories, which, after being duly sealed and signed in the presence of the parties, would be released to the defendants as and when required by the court. The local commissioners were also instructed to obtain copies of the books of accounts, including ledgers, cash registers, stock registers and invoices. These will be used to assess the losses suffered by the plaintiff when the court comes to fix damages.

35. Delhi High Court Protects 'NOVA' Trademark: Grants Permanent Injunction Against 'NOVYA' Imitation

Case: Sterling Agro Industries Limited v ASR Trading Company [CS(COMM) 148/2019, I.A. 4158/2019]

Forum: Delhi High Court

Order Dated: February 07, 2024

Order: On February 7th, 2024, in the case of *Sterling Agro Industries Limited vs M/S ASR Trading Company & Ors. CS(COMM) 148/2019, I.A. 4158/2019,* the Delhi High Court granted a permanent injunction order in favour of Sterling Agro Industries Limited, restraining ASR Trading Company & Ors., using the mark NOVYA to sell 'Ghee and other dairy products' with packaging similar to that of Sterling Agro Industries Limited's NOVA trademark.

As far as the factual matrix goes, the Plaintiff, renowned for its premium dairy offerings bearing the distinctive trademark 'NOVA', has been a prominent figure in the industry since 1991. With numerous trademark registrations secured, the plaintiff has firmly established its brand in the market and adopted the trademark 'NOVA' in 1992 in relation to Ghee and other dairy products. However, in 2019, the plaintiff discovered that the defendants, a partnership firm, were marketing products under the strikingly similar name 'NOVYA', along with packaging resembling their own. Consequently, the plaintiff initiated legal proceedings, alleging infringement and passing off, and sought a permanent injunction against the defendants.

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The plaintiff demonstrated significant goodwill and recognition under the 'NOVA' trademark through years of continuous use and extensive advertising. Plaintiff's evidence of increasing sales figures and promotional activities supported their claims. The plaintiff alleged that the defendant's use of the mark 'NOVYA' amounted to passing off and infringement, given its close resemblance to the plaintiff's trademark and packaging. The Defendants contested the plaintiff's claims, contending that there were notable distinctions between the marks 'NOVA' and 'NOVYA.' They argued that their trademark application for 'NOVYA' covered various goods beyond those specified by the plaintiff's trademark. The defendants denied deliberate imitation or infringement, claiming they had not engaged in commercial activities under the 'NOVYA' mark.

During the proceedings, the Court observed and penalised the Defendants for false advertising and contemptuous conduct. The court observed that the Defendants' inconsistent representation and sporadic appearance in court indicated a disregard for legal obligations. Further, the court rejected the Defendants' defence of dissimilarity between the marks, finding a clear case of infringement and passing off due to visual and phonetic similarities, aiming to benefit from the Plaintiff's goodwill.

The Court remarked that *"The argument posited by the Defendants, asserting a distinction between 'NOVA' and 'NOVYA', does not hold up under judicial scrutiny. Their defence, predicated on the claim of dissimilarity between the marks, is fundamentally flawed. Visually and structurally, the two trademarks exhibit a level of similarity that far surpasses incidental resemblance, reflecting a near-identical composition in both appearance and phonetic sound. Such striking parallels not only starkly counter the Defendants' claims of differentiation, but also compellingly point towards a clear case of infringement. This congruence, in both visual form and phonetics, unequivocally undermines the Defendants' defence and proves infringement claim."*

The Court determined that the infringement was made blatantly clear by the Defendants' choice to use 'NOVYA' for identical goods, particularly milk items like Ghee, directly competing within the same class 29 where the Plaintiff holds a registration. This direct overlap in product categories highlights the lack of merit in the Defendants' claim of distinctiveness between the marks. Moreover, the imitation extends to the packaging used by the Defendants, which not only replicates the Plaintiff's trade dress but also signifies a deliberate tactic to deceive consumers and capitalise on the Plaintiff's established market presence. These actions undeniably indicate the Defendants' intention to imitate and benefit from the recognition and trust the Plaintiff has built over years of continuous use of their mark NOVA.

Consequently, the Defendants' claim of trademark distinctiveness is flat, revealing deliberate attempts to infringe upon and exploit the Plaintiff's trademark rights. The court ruled in favour of the Plaintiff, issuing a permanent injunction against the Defendants and awarding litigation costs. Furthermore, Defendant No. 3 was held guilty of contempt and ordered to pay a penalty to Plaintiff.

36. Delhi High Court Upholds 'LIBAS' Trademark Restraint: Encourages Amicable Resolution in Ongoing Legal Battle

Case: Purshotam Keshwani & Ors vs Nishant Mitrasen Mahimtura & Ors [CS(COMM) 825/2018]

Forum: Delhi High Court

Order Dated: February 08, 2024

Order: In the recent legal battle between Purshotam Keshwani and Ors. and Nishant Mitrasen Mahimtura & Ors., The Delhi High Court reaffirmed the validity of its previous order restraining the defendants from using the trademark 'LIBAS'. The Court encouraged the parties to resolve any disputes regarding alleged violations through mutual discussions.

Background

The plaintiff filed the application under Order XXXIX Rule 2A of the Code of Civil Procedure, 1908, alleging non-compliance with the order dated 13th February 2019, which restrained the defendants from using the 'LIBAS' trademark. The order was passed under the following terms:

- *"23. The defendants, during the pendency of the Suit, are restrained from directly or indirectly dealing with any products or other goods or services, including retailing under the trade mark 'LIBAS' and from using the word 'LIBAS' as part of any trade name and/or of cartons, packaging, label(s), dyes, blocks, part of email addresses, websites and/or in any other manner whatsoever."*

During further proceedings, the defendants assailed this order before the Division Bench of this Court in FAO (OS) COMM. 83/2019. The Court dismissed the appeal through an order dated 10th April 2019. After that, the defendants filed a Special Leave Petition in which an order dated 10th May 2019 was passed, which reads as follows:

- *"The petitioners have submitted a logo with RIYAZ GANGJI in bold (in large font size) and LIBAS under it in small font size. They will be permitted to use this for the goods until the Suit is finally decided. We are informed that the Suit has been stayed since a rectification application is also to be decided. The rectification application will be decided within three months from today, after which the Suit may be decided within six months thereafter. We make it clear that we are not deciding anything on the case's merits. All the contentions are left open to both the parties. This is a pro-tem arrangement until the Suit is finally decided. The special leave petition stands disposed of. Pending application stands disposed of."*

The defendants filed another clarification application before the Supreme Court concerning the order dated 10 May 2019. The Supreme Court issued an order on March 3, 2023, requiring the defendants to use a specific logo consistently across all platforms and to change their website name to "www.riyazgangjilibas.com" within four weeks. This issue arose regarding whether the February 13, 2019 order of this Court was subsumed in the order passed by the Hon'ble Supreme Court, where pro tem arrangement was directed.

Contentions of Parties

The plaintiff argued that based on the orders mentioned earlier, the pro tem arrangement specified by the Supreme Court pertained only to the use of 'RIYAZ GANGJI' in bold with 'LIBAS' in small font. However, the injunction issued by this Court on February 13, 2019, regarding the use of the standalone 'LIBAS' mark remained in effect. However, the defendants contended that the application under Order XXXIX Rule 1 & 2 of CPC could not subsist in view of the order passed by the Hon'ble Supreme Court.

Court's analysis and decision

After considering all the orders, the Court noted that it is quite clear that the order passed by this Court on 13th February 2019 is very much in operation, and the defendants continue to be restrained from using the trademark

'LIBAS' as part of trade name and/or of cartons, packaging, label(s), dyes, blocks, part of email address, websites and/or in any other manner whatsoever, including directly or indirectly dealing with products, goods or services under the said mark.

The Court stated that the clarification sought by defendants before the Hon'ble Supreme Court only led to a pro tem arrangement where RIYAZ GANGJI in bold (in large font size) with LIBAS being in the following form

RIYAZ GANGJI
LIBAS

was permitted to be used across the board:

Therefore, the defendants must adhere to the February 13, 2019, order, with limited exceptions permitted by the Supreme Court.

The Court noted that the remaining issue was whether there are any violations of the said order passed by this Court and whether there is any visibility of use by the defendants of the standalone mark 'LIBAS' in any form or manner for goods services trade name, packaging, label, dyes, blogs, email address, website or any other manner whatsoever.

The plaintiff filed an affidavit detailing alleged violations, and the defendants sought to respond. The Court further noted that both parties were willing to discuss visible misuse and committed to resolving any violations.

Hence, the Court held that if no agreement is reached, the matter will be addressed at the next hearing on May 28, 2024, focusing on compliance and settlement outcomes. If agreed upon, appropriate applications may be filed before that date.

37. Jurisdictional Certainty vis-a-vis the Powers of High Courts under the Trade Marks Act, 1999

Case: The Hershey Company vs. Dilip Kumar Bacha trading as Shree Ganesh Namkeen and Anrs. [C.O. (COMM.IPD-TM) 179/2023]

Forum: Delhi High Court

Order Dated: February 09, 2024

Order: The definition of the term High Court allows for certainty regarding the territorial jurisdiction of the High Courts. However, the Tribunal Reforms Act, 2021 (hereinafter referred to as TRA), read along with the Trade Marks Act, 1999 (hereinafter referred to as the Act), creates a lacuna regarding the identification of the appropriate High Court. The Delhi High Court adjudicated upon the delineation of the appropriate High Court when dealing with trade mark cancellation and rectification petitions.

Petitioners' Arguments

The Petitioners argued that there was no absence, and it was instead the intention of the Legislature to avoid inclusion of the definition. They contended that the Act did not envision limiting jurisdiction to only five High Courts and that jurisdiction can also be conferred by considering the dynamic effect of the registration. They referenced the Trade Marks Rules, 2017 (hereinafter referred to as the Rules), arguing that the term "the High Courts" is different from "Office" as delineated in Rule 4, with the latter establishing a clear territorial nexus, unlike the former.

The Petitioners referred to the procedural laws and stated that petitions under Section 57 have a civil nature and, therefore, jurisdiction must be considered in light of Section 20 of the Civil Procedure Code. They contended that the Act does not create the need for jurisdictional certainty for filing petitions under Section 57. The Petitioners highlighted that the convenience of the parties must be considered and that the term "person aggrieved" must be liberally interpreted, allowing the parties to approach the closest High Court.

Respondents' Arguments

The Respondents argued that since the Registrar must implement the order, the High Court must exercise jurisdiction over the Registrar. They stated that the statute must not be interpreted to allow multiple cancellation proceedings before various High Courts. They argued that the right to revoke is vested in the High Court exercising jurisdiction over the Appropriate Office. Therefore, there was no need for judicial intervention when Section 57 of the Act and Rule 4 were read together. They referred to the Statement of Reasons of the TRA and stated that the Act aimed to vest jurisdiction upon the High Courts, which had the authority to deal with section 57 matters, and not to vest power upon additional courts. They contended for consistency in interpreting the High Court between Section 57 and Sections 91 and 92 of the Act.

Submissions of the Advocates Assisting the Court

The first advocate submitted that Rules 4 and 5 indicate that the appropriate office remains unchanged except under extraordinary circumstances, which do not include changes in the location of the principal office or address of agents. He highlighted Rule 4, which allows the transfer of all matters to the appropriate office when enacting the 2017 Rules. He submitted that the High Court exercising jurisdiction over the Registrar should be deemed the appropriate High Court.

The second advocate submitted that the test must be substantial of the cause of action, which negates the concern of pendency or burden created by the courts. He submitted that infringement petitions may be filed before High Courts that do not exercise jurisdiction over the Appropriate Office, and the petition must be heard along with the suit. He submitted that "the High Court" refers to the High Court with territorial jurisdiction and not necessarily jurisdiction over the Appropriate Office.

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The third advocate submitted that the legislative intent aimed to alleviate hardship for the proprietor and should not be disregarded due to an omission. He stated that the absence of a definition was an oversight, and thus, the definition of the High Court under the 1958 Act must be applied in the present scenario.

Submissions of the Amici Curiae:

The first amicus submitted that there is a difference between the regimes and mechanisms of the various IP legislations, and therefore, definitions accorded for in one of the statutes cannot be substituted in another. He also contended that using "the", which signifies a definitive article, restricts the maintainability of cancellation petitions to a single High Court. He submitted that consideration must be given to the office where the trade mark was registered. He referred to the Supreme Court's obiter in various judgements.

He stated that the dynamic effect cannot be considered as it is not covered under Section 57 and, therefore, the territory where the order has been passed must be considered. He submitted that the same must be followed if a special statute laid down a procedure. He submitted that the literal and purposive interpretation of the statute led to the obvious understanding that the High Court referred to the High Court, which exercises control over registration. He submitted that an evident nexus exists between the High Court and the Appropriate Office intended to be created in the statute.

The second amicus evidenced his arguments by relying on the Ayyangar Committee Report, which recommended establishing a territorial nexus between the Registrar and the High Court. He also submitted that the definitions provided in other IP statutes cannot be applied in interpreting the 1999 Act. He submitted that an interpretation that leads to jurisdictional uncertainty would be antithetical to the Act's purpose and aims; therefore, any interpretation made must prevent potential mischief.

He submitted that the 1999 Act narrowed down the jurisdiction for appeals by channelling it into the five High Courts situated within the jurisdiction of the Intellectual Property Appellate Board and that the TRA did not change this position, which meant that the same High Courts would have power over appellate and cancellation proceedings. He submitted that there was consistency in the intention of the Legislature with regard to the territorial applicability, and therefore, there was no need for judicial intervention.

Judgment:

The Court observed that the omission of the definition of the High Court in the 1999 Act is peculiar, especially since the definition is provided in the Patents Act and the Design Act, leading to ambiguity regarding legislative intent. The Court held that the applicability of Girdhari Lal Gupta decision, which establishes a territorial nexus with the cause of action, to the 1999 Act requires consideration by a larger bench, as the decision was rendered by a Full Bench.

38. Delhi High Court Affirms Non-Extendible Trademark Evidence Deadlines

Case: Sun Pharma Laboratories Ltd vs. Dabur India Ltd. & Anr. [C.A.(COMM.IPD-TM) 146/2022]

Forum: Delhi High Court

Order Dated: February 09, 2024

Order: In an appeal filed by Sun Pharma in Sun Pharma Laboratories Ltd. vs Dabur India Ltd. & Anr., the Delhi High Court held that in a trademark opposition, the trademark registrar could not extend the deadline for filing evidence at their discretion. The Court held that the law requires a specific and non-extendible timeframe for this purpose.

In this matter, Sun Pharma appealed to the Delhi High Court after the Registrar, vide its order dated July 21, 2022, dismissed its opposition against Dabur due to delayed service of evidence. Sun Pharma submitted evidence to the trademark registry within the two-month limit, but service on Dabur was delayed by one day. During the hearing before the Registrar of Trademark, Dabur argued that Sun Pharma's evidence was barred by time, potentially leading to the opposition being deemed abandoned under Rule 50 of the 2002 Trade Mark Rules. The main issue before the Court was whether the period prescribed under the Trademark rules is mandatory or whether the Registrar enjoys discretionary powers to extend it.

Section 21 of the Trade Marks Act, 1999, along with the earlier Trade and Merchandise Marks Act 1958, requires that any evidence relied upon by both the opponent as well as the applicant may be submitted to the Registrar of Trademarks in the specified manner and within the specified timeframe.

These timeframe/deadlines are outlined in the 1959 Trade Marks Rules (for the 1958 Act) and the 2017 Rules, which replaced the 2002 Rules.

Under Rule 53 of the 1959 Rules, an opponent had to submit evidence within two months of receiving the counter statement; failure to do so led to the opposition being considered abandoned. Under Rule 50 of the 2002 Rules, the position was that apart from a two-month period, the Registrar could grant an extension of one month upon request.

Rule 45 of the current 2017 Rules eliminates this extension of one month. Therefore, under the 1999 Act and 2017 Rules, evidence must be filed within two months of receiving the counter statement. The Court stated that "the *position in the 2017 Rules becomes much more clear towards the elimination of delays - i.e., the feature of the 2002 Rules with regard to the service of the counter statement by the Applicant has been retained, the discretion vested with the Registrar has been taken away, and the period of extra one month has also been deleted."*

The Court also pointed out that Rules 106 of the 1959 Rules, 105 of the 2002 Rules, and 109 of the 2017 Rules, respectively, make it clear that an application for an extension of time can be filed before the Registrar in respect of such time periods for which no specific provision has been made in the Rules.

Rule 53(2) of the 1959 Rules stated that if an opponent did not take action within the specified time, their opposition would be deemed abandoned unless the Registrar decided otherwise. The Court viewed the phrase *"**unless the Registrar otherwise directs**"* as giving flexibility to the above rule. However, this phrase was removed from the corresponding provisions in the 2002 and 2017 Rules, indicating that the Registrar's authority to extend the time for filing evidence has been eliminated under the current rules.

In the past, the Delhi High Court's interpretation of Rule 50 of the 2002 Rules in **Sunrider Vs. Hindustan Lever (2007 SCC Online Del 1018)** emphasised the mandatory nature of the deadline extension, citing the use of the term "aggregate" in Rule 50 (1) and the absence of the phrase "unless the Registrar otherwise directs" seen in earlier rules. It stated, *"It is obvious that the Legislature wanted to make the provision mandatory and did not want to give any discretion to the Registrar in this connection. It is apparent that the delays be cut down in deciding the application for registration of a trade mark"*.

Similarly, in **Mahesh Gupta Vs. Registrar of Trademarks (2023 SCC Online Del 1324),** the Delhi High Court ruled that Rule 50(1) of 2002 Rules allowed the Registrar to extend the evidence filing period for only up to one month, as indicated by the phrase "*not exceeding one month*." The judgement stated that *"the learned Registrar could not, therefore, grant extension of more than one month beyond the period of two months from the date of service, on the opponent opposing the registration of a mark, of a copy of the counter-statement".* Additionally, Rule 105, which addresses discretionary extensions, was deemed irrelevant because it applies only when the statutory framework is silent on periods, which was not the case in this instance.

As per the Court, the term *"one month aggregate"* used in Rule 50 of the 2002 Rules, along with the removal of discretion *"unless the Registrar otherwise directs"*, stated in Rule 50(2), indicates that the prescribed time limit is mandatory. The shift from the 1959 Rules to the 2002 Rules and then to the 2017 Rules indicates that the discretion vested with the Registrar has been removed, and the time allotted for filing evidence has been shortened.

The Court also held that there was merely a delay in sending the copy of evidence to the Applicant (Dabur), and therefore, an opposition cannot be abandoned merely because of such delay in service of evidence (which was otherwise filed at the registry in a timely manner). The Court, therefore, ruled that the time period for filing evidence is fixed and non-extendible, and this decision emphasises that the purpose of the statute is to ensure that strict timelines are adhered to and that repeated extensions do not stall the trademark registration process.

39. No Exploitation of the Goodwill and Reputation of the Mark “Castrol”

Case: Castrol Limited vs Rajesh Kumar Tuteja, trading as Krishna International and Anr [CS(COMM) 616/2023]

Forum: Delhi High Court

Order Dated: February 12, 2024

Order: In a peculiar recent trademark dispute between ***Castrol Limited vs Rajesh Kumar Tuteja, trading as Krishna International and Anr [CS(COMM) 616/2023],*** the Delhi High Court recently held that the Defendants' registration of the mark "**Newcast Roi Racing**" is in bad faith. Both the registration and use of the mark by the Defendants demonstrate a deliberate attempt to capitalise on the goodwill and reputation of the plaintiff's mark **“CASTROL”.**

In this case, Castor Limited (“**Plaintiff**”) asserted that the plaintiff is a member of the British Petroleum group of companies. The plaintiff holds exclusive rights to numerous trademarks, including the prominent **“CASTROL”** mark and the device mark . The plaintiff's mark CASTROL serves as the plaintiff's signature and has been globally utilised since 1909 on a wide range of products, but most notably on engine oils and lubricants. The wide array of trademark registrations for the mark "CASTROL" and its variants worldwide, including India, underscores the plaintiff's brand identity and market presence. This extensive historical usage underlines the mark's significant heritage and its established association with the plaintiff in the minds of consumers worldwide.

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Furthermore, the plaintiff adopted distinctive packaging and labelling  that significantly enhanced the visual appeal and recognition of their products. Additionally, these labels and marks are the original artistic works of the plaintiff and are entitled to protection under the Copyright Act, 1957. In August 2023, the Plaintiff's Indian representative learned that Defendant No.1, Rajesh Kumar Tuteja, and Defendant No.2, Seema Tuteja, have a familial relationship and are collectively engaged in the business of manufacturing and marketing the sale of engine oil and lubricants bearing the impugned mark.

The plaintiff's grievance arises from the Defendants' usage of the impugned mark ***"newcast roi racing***" and the manner in which the impugned mark has been adopted on the label of the products sold by the Defendants. Defendant No.1, despite holding a valid registration for the mark "newcast roi racing," has been engaged in deceptive practices that undermine the integrity of trademark law. The defendants' adopted the trademark CASTROI on their product's label and packaging 

that is deceptively similar to the Plaintiffs' mark "**CASTROL**". The Defendants have craftily manipulated the presentation of their mark by strategically altering the typography, diminishing the prominence of "new" and unduly accentuating "Castroi," with "Racing" positioned less conspicuously. The Defendants muddled the distinction between the plaintiff's renowned "Castrol" mark and their mark "Castroi," both utilised for identical goods, i.e., engine oil and lubricants.

On 4th September 2023, the Court granted an ex-parte ad interim injunction restraining the Defendants from using the impugned marks and labels and appointed a Local Commissioner. The Local Commissioner made some significant seizures of the infringing products. Additionally, the plaintiff's investigation revealed that Defendant No.1 is a habitual infringer and is involved in selling counterfeit products of well-known marks such as 'HONDA' and 'AMARON'.

In addition, recognising the gravity of this infringement, a separate order for the cancellation of the defendant's mark has already been issued in a rectification petition C.O. (COMM.IPD-TM) 208/2023, and the Defendant No.1 had no lawful basis to defend the dishonesty inherent in his actions.

The defendants argued that the impugned marks were adopted without knowledge of the plaintiff's registration status. Using impugned marks and the container's design was undertaken without any intention to deceive the consumers or capitalise on the plaintiff's established reputation. The bottles and containers used by the Defendants are standard items readily available on platforms such as India Mart, indicating no deliberate effort to mimic the plaintiff's product presentation. In addition, the packaging of the Defendant's product and the containers contains a disclaimer mentioning that "*This Product is available. This is not a copy of CASTROL. We have this brand registered with the government. 100% legal".* The disclaimer serves as a clear indication that there was never any intention on the part of the defendants to suggest that their product was associated with or endorsed by the plaintiff.

The Order of the Delhi High Court

The Single Judge bench of the Delhi High Court observed and held:

i. The comparison of the plaintiff's mark and the Defendant's mark demonstrates that although the defendants' mark may seemingly appear distinct from the plaintiff's, it has been strategically presented in a manner that creates a deceptive similarity to the plaintiff's registered trademark. The defendants engaged in a calculated manipulation of their trademark's presentation, employing a strategic alteration of typography to mirror the plaintiff's established "CASTROL" mark closely. By diminishing the prominence of the word "new" and disproportionately emphasising "cast roi" with "racing" relegated to a less prominent position. The defendants have significantly obscured the distinction between the well-recognised "CASTROL" mark of the plaintiff and their mark "**Castroi,**" despite both being used for identical goods. This intentional shift in the

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visual representation induces confusion among consumers, eroding the distinction between the plaintiff's mark "**CASTROL"** and the Defendants' mark **"Castroi".**

ii. Since there is no objection to the grant of a decree of injunction, the suit is decreed in favour of the plaintiff, and the plaintiff shall also be entitled to destroy the infringing goods seized by the Local Commissioner in accordance with the law.

iii. The Defendants' deceptive strategies warrant an award of damages. The Defendants claim innocence and rely on a disclaimer asserting no affiliation with the 'CASTROL' trademark. The disclaimer appears to be a flimsy afterthought rather than a genuine effort to prevent confusion. Thus, the Defendants' actions suggest a pattern of behaviour aimed at capitalising on the plaintiff's goodwill and market position.

iv. The adoption of similar packaging and labels and the sale of products in bottles and containers of designs nearly identical to those used by the plaintiff. The plaintiff's assertion that Defendant No.1 is a habitual infringer, evidenced by their unauthorised use of other well-known trademarks such as 'HONDA' and 'AMARON', completes the narrative of deceit. The defendants' pattern of behaviour underscores their engagement in selling counterfeit goods and highlights a systematic intent to pass off their products as those of recognised brands, exploiting the goodwill and reputation those brands have cultivated.

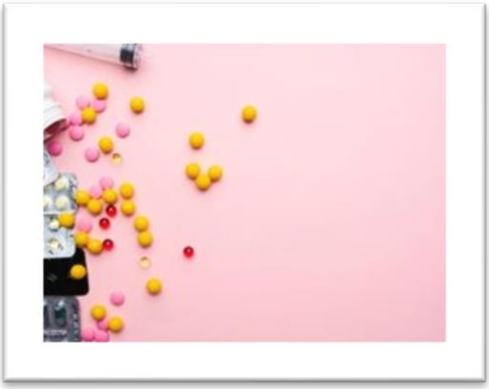
In light of the above analysis, the Court concluded that the Defendant's conduct not only warrants but also necessitates the imposition of both costs and aggravated damages. Thus, in addition to the order passed above, taking into account the entire facts and circumstances presented in this case, the Court awarded damages amounting to INR.5,00,000 in favour of Plaintiff and INR.7,00,000 (break of which is specified in the decision) towards the cost of litigation to be paid by Defendant No.1 to the plaintiff.

40. A RIX-Taker: The Standard of Care in the Pharmaceutical Sector

Case: GlaxoSmithKline Biologicals SA vs Human Biolife India Private Limited & Ors. [CS(COMM) 948/2023 & IA 26277/2023]

Forum: Delhi High Court

Order Dated: February 12, 2024



Order: In a significant reaffirmation of principles concerning trademark confusion and deception within the pharmaceutical domain, the Delhi High Court has recently revisited the benchmarks for evaluating potential confusion among pharmaceutical products. The Single Judge considered the phonetics, structure, and purpose of the goods in establishing infringement. The suit instituted by GlaxoSmithKline Biologics against Defendant 1, Human Biolife India Private Limited, who they claimed were allegedly infringing on Plaintiff's RIX range of marks by manufacturing and selling pharmaceutical products bearing the RIX mark.

Facts and Arguments

Human Biolife India engaged two other entities (Defendants 2 and 3) under contract for the manufacturing, packaging, and labelling of pharmaceutical products according to directives provided by Human Biolife. These entities argued that any trademark infringement claims against the products produced for Human Biolife should be solely its responsibility, given that the trademarks used were claimed to be owned by Human Biolife, which also agreed to indemnify them against any resulting liabilities.

On the day of the hearing, Defendants 2 and 3 did not oppose the prayer of the Plaintiff and Defendant 1 did not appear before the Court despite having been present before the Registry for Opposition proceedings and having registered marks in their favour in the suit. The Court chose to proceed ex parte and made note of the plaintiff's arguments and submissions.

The plaintiff referred to the various RIX-suffix marks that they were using in the development and supply of vaccines. However, the hearing was restricted to ROTARIX, AMBIRIX, CERVARIX and RIX marks, which form part of the extensive RIX portfolio of marks owned by the plaintiff. The details of the marks under contention during the hearing are represented in the table below.

PLAINTIFF’S MARK	**DEFENDANTS’ MARK(S)**
ROTA**RIX**	RUTORIX
ROTA**RIX**	DROTARIX
AMBI**RIX**	AMIRIX
CERVA**RIX**	CEFTARIX
RIX	ESOMRIX, CALCIRIX, MERORIXX, PIPTARIX, OFZORIX, FLUCORIX

The plaintiff stated that the use of the suffix RIX was inspired by a village in Belgium, “Rixensart," which also happened to be the location of the plaintiff's headquarters. The plaintiff stated that they used the suffix RIX in all their trademarks, which denoted vaccination products. As an industry standard, they combined RIX with the disease for which the vaccine provided immunity. The plaintiff submitted that “RIX” allowed their marks to be arbitrary.

The plaintiff referred to the following marks to buttress their submissions: VARILREX for Varicella, ROTARIX for Rotavirus, CERVARIX for Cervical Cancer, HAVRIX for Hepatitis A, TYPHERIX for Typhoid Fever, HIBERIX for Influenzae Type B and FLUARIX for common cold.

The plaintiff stated that seventeen RIX marks had been granted statutory protection since 1984 for various vaccine formulations and have been in circulation since the launch of the RIX range in 1986, which has consistently created new vaccine formulations, the latest being launched recently in 2023. The plaintiff arraigned Defendants 2 and 3 in the suit as companies manufacturing the products bearing impugned marks.

Observations and Findings

The Court observed that the Defendants' marks were deceptively similar to the plaintiff's marks, if not nearly identical. The Court observed that usage of the suffix RIX furthered confusion between the marks. The Court considered that under similar circumstances in 2007, the plaintiff had filed a suit and was granted an injunction in their favour. The Court also regarded the submissions made by the Defendants and noted that Defendant 1 was not contesting the suit, and Defendants 2 and 3 made no objections to the plaintiff's prayer.

In its consideration of the phonetic and structural similarities between the marks, the Court also noted that the goods were used in the pharmaceutical sector, which required a more stringent yardstick of measurement as laid down by the Supreme Court in Cadila Healthcare. The Court considered the goods, which were vaccines (Plaintiff) and injectables or transfusions (Defendants), and held that the phonetic and structural similarities, combined with the overlapping nature of the products, could lead to confusion and, by extension, fatal consequences for the recipient of the medication.

The Court observed that the subject matter also included a public interest perspective and held that the plaintiff would suffer harm if an injunction were not granted when the balance of convenience was clearly in their favour. The Court restricted the Defendant from manufacturing and selling directly or indirectly any products bearing the impugned marks.

41. Clover Infotech Pvt Ltd vs Clover Network Inc.: A Case of Trademark Rectification

Case: Clover Infotech Pvt Lt. Clover Centrum vs Clover Network Inc. [C.O. (COMM.IPD-TM) 461/2022]

Forum: Delhi High Court

Order Dated: February 14, 2024

Order: In a recent case, Clover Infotech Pvt Ltd filed a petition before the Delhi High Court to remove the respondent's mark 'CLOVER' registered under No. 2634773 on 15 December 2018. The respondent got the registration in Class 9 based on an application dated 28 November 2013.

The petitioner claimed to have a prior registered mark, granted on 31 March 2010, in Class 9, under application No. 1516524 dated 28 December 2006. The petitioner stated that they have been using this mark since 25 May 2000 for products related to computer interfaces, cables, computer software, hardware, accessories, etc. Another registration of Clover Infotech Device was granted to the petitioner under application No.1516522, dated 28th December 2006. The same was granted on 27th February 2012, with a user claim from 25th May 2000, in Class 42 (providing information technology services in the field of commodity, equity, forex and finance, etc.).

The Court noted that despite notifying respondent No.1 during hearings on August 18, 2022, and December 5, 2022, they didn't show up afterwards. The Court also confirmed that the respondent was properly served on August 3, 2023. Despite this, the respondent has not responded or represented itself in subsequent court proceedings.

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Given the respondent's lack of response, it's reasonable to accept the petitioner's claims as true since they haven't been contested.

The Court stated that It is evident from the facts stated above that the petitioner had a prior registration in 2010 with a user date of 2000, whereas the respondent's trademark was registered in December 2018 on a proposed to-be-used basis.

The Court held that, since the Respondent didn't contest the Plaintiff's claims and the Plaintiff has been using their mark since 2000 while the Respondent's use is only proposed, the Court believes the Plaintiff has a valid case for rectification of the register. The Plaintiff first noticed the Respondent's mark when opposing their registration application in Class 99. The petition is granted, the Respondent's mark will be removed from the register, and the Registrar's website will be updated accordingly.

This ruling not only underscores the importance of diligent trademark registration but also highlights the significance of timely and substantive responses in legal proceedings. The decision reaffirms the principle of protecting prior rights and ensuring fairness in trademark disputes. As a result, the Registrar's website will be updated accordingly to reflect this rectification.

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42. Remote Testimony in Intellectual Property Dispute

Case: Phillips 66 Company vs Raaj Unocal Lubricants Limited [CS(COMM) 281/2022]

Forum: Delhi High Court

Order Dated: February 15, 2024

Order: In a recent Legal battle between Phillips 66 Company as the Plaintiff and Raaj Unocal Lubricants Limited as the Defendant, the High Court of Delhi addressed the application filed by Phillips 66 Company (Plaintiff) seeking appointment of a Local Commissioner for recording the evidence of Plaintiff witnesses through video conferencing. The Court allowed allowing the application and issuing detailed directions for the remote testimony.

Phillips 66 Company, the Plaintiff, filled application seeking directions for appointment of a Local Commissioner to record the statement of Plaintiff witnesses - Mr. Stephen P. Meleen (PW1) and Mr. Craig Stone (PW2), remotely, via video conferencing mechanism. The Plaintiff highlighted that the Plaintiff's witnesses, residing in the United States of America, are professionals engaged with significant responsibilities in their law firm, rendering them unable to travel to India for cross-examination due to these professional commitments. Furthermore, the personal circumstances of Mr. Craig Stone, who has young children under his care. The obligation to look after his children, coupled with the logistical challenges and the substantial burden that international travel imposes, would make his physical presence for the proceedings exceedingly difficult.

The Plaintiff emphasised the practical difficulties faced by the witnesses in travelling to India, citing professional responsibilities and personal obligations. However, the Defendant opposed the application, underscoring their lack of prior consent to the request made in the application, deeming it essential for consideration. They highlight non-compliance with Chapter 3, Rule 6.2 of the High Court of Delhi Rules for Video Conferencing for Courts, 2021 ('VC Rules, 2021'), which requires discussing any proposal for video conferencing with all involved parties beforehand.

Additionally, the defendant argued for the traditional preference of in-person cross-examination, citing its ability to directly observe the witness's demeanour, which is crucial for credibility assessment. They assert that physical courtrooms foster transparency and fairness in examination. Practical challenges, like presenting documents during cross-examination, are also emphasised as better managed in person.

Court's Decision and Analysis:

After considering the arguments presented by both parties, the Court acknowledged the lack of compelling reasons presented by the Plaintiff for remote testimony. However, it emphasised the need to adapt to modern technological solutions while ensuring fairness in the trial process. The Court highlighted the sophistication of the legal community involved in intellectual property matters, demonstrating readiness for technological advancements.

The Court allowed the application and issued the following detailed directions:

- The examination of PW-1 and PW-2 will be carried out by video conferencing in accordance with the VC Rules, 2021.
- Mr Vinay Gupta, District and Sessions Judge (Retired), has been appointed as the Commissioner and will preside over the proceedings at the Court point for the recording of evidence. He will also determine the granular details of recording PW-1's and PW-2's testimony in accordance with the rules. PW-1 and PW-2 will be examined on the date and time fixed by the Commissioner in consultation with the Remote Point Co-ordinator.
- The Embassy of India in Houston, Texas, has requested that an official be appointed as the Remote Point Coordinator.

- The Deputy Registrar (Computers) is appointed as the Co-ordinator at Court Point for the technical aspects of video conferencing to conduct the evidence.
- The video conferencing facility available at the Delhi High Court will be treated as the Court Point as defined under Rule 2(5) of the Rules.
- The Coordinators must be physically present during the recording of evidence and perform all their duties as per the Rules.
- The encrypted master copy (with hash value) of the recording of the video conference shall be retained with the Commissioner.
- The remuneration of the learned Commissioner is fixed at ₹2,50,000/-, and in case the cross-examination is not conducted in five hearings, the Local Commissioner should be paid Rs. 50,000/- for each additional hearing.
- The Embassy may indicate the costs/charges/remuneration for the services of the Remote Point Coordinator.
- The Commissioner must forward a copy of this order to the Embassy of India (Houston, Texas), and take necessary steps for the recording of evidence of PW-1 and PW-2 as per this order. The VC Rules, 2021, must also be forwarded to the Embassy and the Remote Point Co-ordinator.

The Court's decision reflects a balanced approach towards integrating technology into the legal process while upholding the principles of fairness and efficiency. By allowing remote testimony in this intellectual property dispute, the Court has demonstrated its commitment to adapt to contemporary challenges without compromising the integrity of the trial process.

43. Judicial Victory: Louis Vuitton's Triumph Against Counterfeiters in Delhi High Court

Case: Louis Vuitton Malletier vs Jai Kumar Kashyap & Ors [CS(COMM) 131/2023, I.A. 4650/2023]

Forum: Delhi High Court

Order Dated: February 16, 2024

Order: In a recent decree by the High Court of Delhi, defendant nos. 1-3 were found guilty of counterfeiting products bearing the trademark of luxury brand Louis Vuitton. The case pertained to the unauthorised use of Louis Vuitton trademarks and logos on footwear by defendants Jai Kumar Kashyap & Ors.

The court's order, issued on February 16, 2024, followed an ex parte ad interim injunction granted on March 10, 2023, which restrained the defendants from various activities related to the manufacturing, advertising, and sale of products featuring Louis Vuitton trademarks, i.e., LOUIS VUITTON, or. The injunction was issued based on the prima facie case of counterfeiting and infringement presented by the Plaintiff, Louis Vuitton Malletier. Subsequently, defendant no. 3 filed an application seeking the de-sealment of goods inventoried and sealed by a Local Commissioner under the court's order.

Defendants nos. 1 and 3 stated that at defendant no. 1's premises, no counterfeit products were found, and defendant no. 3's premises, a thousand pairs bearing the trademark 'LEE VENTO' were found.

The Plaintiff, however, pointed out that alongside the mark 'LEE VENTO', there is a device mark used. This is an interlocking mark on the product 

that is deceptively similar to the Plaintiff's mark. Therefore, if these goods are released to defendant no.3, the said device mark should be obliterated in toto.

After deliberation, the court allowed the de-sealment of goods with certain conditions. It mandated that the device mark be obliterated from the products, leaving only the 'LEE VENTO' mark intact. Additionally, defendants nos. 1-3 agreed not to sell counterfeit products bearing Louis Vuitton's marks.

Furthermore, the court ordered the destruction of products bearing only the device mark, ensuring that they do not contribute to further infringement. Defendants nos. 1-3 were directed to provide information on the source of products featuring the interlocking mark within three weeks.

In light of the circumstances, the court decreed in favour of the Plaintiff, Louis Vuitton Malletier, against defendant nos. 1-3, with a joint or several payments of Rs. 1,00,000 as costs to the Delhi High Court Legal Services Committee. The decree serves as a significant step in combating counterfeiting and upholding the rights of intellectual property owners, reaffirming the judiciary's commitment to protecting trademarks and preventing unauthorised use in commercial activities.

44. TiE vs. TiE Global: Protecting Trademark Integrity

Case: Tie Inc vs Tie Global & Anr [CS(COMM) 152/2024]

Forum: Delhi High Court

Order Dated: February 19, 2024

Order: In a recent legal development, the plaintiff filed an application as part of the suit seeking a decree of permanent injunction. The Delhi High Court, till the next date of hearing, restrained defendant no.1, its proprietors, partners, directors, and all others acting on their behalf from selling, offering for sale, advertising, directly or indirectly dealing in any services under the trademark "TiE"/ "TiE Global"/ "THE INDIAN ENTREPRENEUR"/ and the impugned domain name, or any other mark which is deceptively similar with the plaintiff's mark "TiE"/ "TiE Global"/ "THE INDUS ENTREPRENEUR", so as to cause infringement / passing off of the plaintiff's registered trademark.

Background

The plaintiff is a non-profit corporation organised under the laws of the State of California, USA. It operates an organisation named TiE Global, with "TiE" standing for "THE INDUS ENTREPRENEURS." Its activities revolve around assisting entrepreneurs in various industries at all stages, from incubation to the entrepreneurial lifecycle.

The plaintiff claimed ownership of registered trademarks for "TiE," "TiE Global," and "THE INDUS ENTREPRENEUR" in multiple classes in India and abroad; the plaintiff presented extensive evidence of their usage and reputation. Further, the plaintiff obtained the registration of the domain name www.tie.org on April 27, 1995, and has been extensively and continuously using it. Another registration for the domain name www.tieglobalsummit.org was obtained on August 17, 2016, and it has been extensively used since then, demonstrating its extensive reach in India and globally.

However, in January 2024, Defendant 1 was found to be using the impugned marks ‘TiE’/ ‘TiE Global'/ 'THE INDIAN ENTREPRENEUR' and the impugned domain name. Therefore, the plaintiff contended that it attempted to dishonestly claim association with their well-known mark and entity.

The comparison between plaintiff’s mark and defendant no.1’s mark is given below:

Particulars	Plaintiff's Trade Marks	Defendant No. 1's Trade Marks
Trade marks	TIE	TIE
	TiE Global	Tie Global
	"THE INDUS ENTREPRENEURS"	"THE INDIAN ENTREPRENEURS"
Domain Name	https://tie.org/	https://www.tieglobal.in/
Services	Entrepreneurs' mentorship and support	Entrepreneurs' mentorship and support

Court’s analysis and decision

After considering the submissions and evidence presented by the plaintiff, the court found merit in their claims. The court opined that the balance of convenience lies in favour of the plaintiff, who will likely suffer irreparable harm if the injunction is not granted.

Hence, till the next date of hearing, The Court restrained Defendant no.1 from using, promoting, or advertising, directly or indirectly, the impugned trademarks "TiE”/ “TiE Global”/ “THE INDIAN ENTREPRENEUR”/ and the impugned domain name, or any other mark which may be identical to or deceptively similar to plaintiff’s trade mark “TIE”/

“TiE Global”/ “THE INDUS ENTREPRENEUR”, so as to cause infringement / passing off of the plaintiff’s registered trademark.

Consequently, the court directed defendant no.2, GoDaddy.Com LLC, to block/suspend access to the website www.tieglobal.in. Moreover, defendant no.2 was directed to provide complete disclosure of defendant no. 1's domain/account information.

This significant legal development underscores the importance of protecting intellectual property rights and preventing unauthorised trademark use, especially in the digital age, where online presence plays a crucial role in brand recognition and consumer trust. The court's granting of the ex parte injunction reflects its commitment to safeguarding the interests of rightful trademark owners and maintaining the market's integrity.

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45. Delhi High Court Upholds Injunction Against Minda Oils India Pvt Ltd for Trademark Infringement

Case: Minda Spectrum Advisory Limited & Ors vs Minda Oils India Pvt Ltd & Ors [CS(COMM) 51/2022]

Forum: Delhi High Court

Order Dated: February 19, 2024

Order: In the recent case of Minda Spectrum Advisory Limited & Ors. Versus Minda Oils India Pvt Ltd & Ors. at the Delhi High Court regarding the alleged injunction order and judgment violation. The court addressed the defendant's continued use of trademarks deemed similar to those of the plaintiffs despite earlier legal directives.

The case was filed by the plaintiff against trademark infringement by the defendants, particularly their use of the term 'MINDA' and its variants, as noted in the initial order dated 20 January 2022. The plaintiffs obtained an ex-parte ad interim injunction against the defendants, which was subsequently confirmed via a judgment on 20 September 2022.

The plaintiffs raised concerns over the defendants' non-compliance with the injunction order. They pointed out two key issues: the incorporation of 'MINDA' in the defendants' corporate name and the use of 'MINDUS' and 'MINDUS UTO' in their products, similar to those offered by the plaintiffs.

The defendants contended that they were willing to comply with the court's directives. They were ready to alter their corporate name and discontinue the use of 'MINDA' in any form expressed, including email IDs. Additionally, they assured that they would cease using 'MINDUS' or any similar mark.

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The Court acknowledged the defendants' commitment to compliance but criticised their actions. The court noted the registration of 'MINDUS' by a third party shortly after the order, suggesting potential bad faith. Moreover, the combination of 'MINDUS' with 'UTO,' previously addressed in the judgment, raised suspicions of an attempt to maintain associations with the impugned marks.

The court directed the defendants to promptly effect changes in their corporate name and product marks. They were instructed to refrain from using any mark deceptively similar to the plaintiff's trademark. An affidavit of compliance was mandated within the specified timeline.

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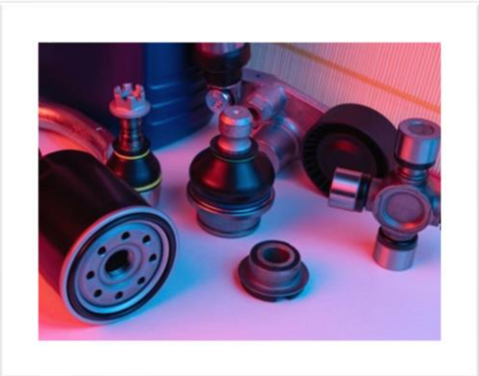
46. Delhi High Court Issues Ad Interim Injunction in Counterfeit Auto Parts Case

Case: Hero Investcorp Private Limited and Anr vs Diamond Autos [CS(COMM) 605/2022, I.A. 14143/2022]

Forum: Delhi High Court

Order Dated: February 20, 2024



Order: In a recent legal battle between **Hero Investcorp Private Limited and Anr vs Diamond Autos**, the Delhi High Court has issued a decree of ad interim injunction restraining a defendant from manufacturing, stocking, selling, or offering for sale products bearing trademarks identical or deceptively similar to those of the plaintiff's marks HERO”, Hero/ Hero and /.

The plaintiffs, Hero Invest Corp Private Limited and Hero MotoCorp Limited, leading manufacturers in the automotive industry, sought a legal remedy against the defendant, who runs a business selling auto parts in Ludhiana, Punjab.

On June 13th, 1966, plaintiff No. 2 filed an application under class 12 to extend its trademark 'HERO' for scooters, motorcycles, and their parts. The Registrar of Trademarks allowed the application, and since then, plaintiff No. 2 registered different trademarks under its name, including HERO”, Hero/ Hero and /.

It was alleged by the plaintiffs that the defendant was engaged in selling counterfeit auto parts, including Disk Clutch Friction, bearing marks identical to the plaintiffs' trademarks. They provided evidence demonstrating the deceptive similarity between their products and the defendant's, including packaging and other associated elements. A comparison of the plaintiff's product and that of the defendant is provided as follows:

Plaintiff's products:

PHOTOGRAPH OF THE ORIGINAL PRODUCT OF THE PLAINTIFF

PHOTOGRAPH OF THE ORIGINAL PRODUCT OF THE PLAINTIFF

Defendant's products:

PHOTOGRAPH OF INFRINGING PRODUCT OF THE DEFENDANT

PHOTOGRAPH OF INFRINGING PRODUCT OF THE DEFENDANT

Upon examining the evidence presented by the plaintiffs, the Court found merit in their claims and granted an ex-parte ad interim injunction until the next hearing date. The injunction prohibited the defendant and its associates from engaging in any activities involving the manufacturing, stocking, selling, or offering for sale of auto parts bearing the plaintiffs' trademarks or any similar trade dress under the trademark ‘HERO’ and/or any other mark identical or deceptively similar to it, and/or any other ‘HERO’ marks of the plaintiffs.

Additionally, the Court allowed the application filed by the plaintiffs and ordered the appointment of a Local Commissioner with a direction to visit the defendants’ premises and carry out the following mandate:

1. The Local Commissioner, along with counsel for the plaintiffs and a responsible representative of the plaintiff, will search and inspect the premises. They will seize products with the plaintiffs' trademark, logo 'HERO', and device marks. They will release the seized products on Superdari to the defendant.
2. The defendant must allow access to the premises. The execution of the commission should not disrupt the defendant's business except for the purposes of the commission. The commission should be executed peacefully.
3. The police are directed to provide necessary assistance and protection. If the goods are in any other location, they can execute the commission there too.
4. The Local Commissioners will communicate the order to the defendant and serve a copy of the order at the time of execution.

The plaintiffs were directed to bear the expenses associated with the Local Commissioner's fee of Rs. 1,50,000/-, travel, lodging, and other miscellaneous expenses incurred during the execution of the commission. The Local Commissioner was instructed to file a report within three weeks of executing the commission.

This ruling by the Delhi High Court highlights the significance of safeguarding intellectual property rights and preventing the sale of counterfeit products in the market. This decision acts as a warning to those involved in illegal practices and maintains the credibility of trademarks and copyrights in the automotive industry.

47. Ex-Parte Ad-Interim Injunction for Infringement of "TWO ELEPHANT BRAND" logo Made Absolute

Case: Kewal Krishan Bansal vs Puneet Chhabra [CS(COMM) 300/2023]

Forum: Delhi High Court

Order Dated: February 27, 2024

Order: Vide recent order dated February 27, 2024, the Delhi High Court (hereinafter referred to as "the Court") dismissed the application filed by Puneet Chhabra, Proprietor of Rama Wire (hereinafter referred to as the defendant, under Order XXXIX Rule 4 of Code of Civil Procedure, 1908 for the vacation of *ex-parte ad interim* injunction order granted in favour of Kewal Krishnan Bansal, Proprietor of M/s. VEE PEE Bansal and Company (hereinafter referred to as the plaintiff). While rejecting the application, the Court made the *ex-parte ad interim* injunction order dated May 11, 2023, absolute.

Facts of the Case

The plaintiff is the registered proprietor of the trademark under the Trademarks Act, 1999, in Class 6, registered from April 24, 1979, as well as the copyright registered for the artistic work from March 24, 1979. The plaintiff's mark was registered and renewed up to 1989 but was later removed for non-renewal. It was later renewed in the year 2019 and subsisted till date. The plaintiff submitted that the acronym VPC also figured on the plaintiff's pack, is an abbreviation for M/s. VEE PEE Bansal and Company. The trademark is registered with respect to goods like

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common metal and alloys, including materials such as bed joints and wire springs for furniture.

The plaintiff instituted trademark infringement and passed off proceedings against the defendant, alleging that it used a nearly similar mark, with the logo "TWO ELEPHANT BRAND" and the acronym VPC. The marks of the defendant are 

.

On May 11, 2023, the Court granted *ex-parte ad interim* injunction against the defendant, placing reliance on the precedents laid down by ***Laxmikant V. Patel v. Chetanbhai Shah and Midas Hygiene Industries (P) Ltd v. Sudhir Bhatia*** with an observation that a *prima facie* case of infringement, by the defendant, of the plaintiff's registered device mark as well as an attempt to pass off the goods of the defendant as those of the plaintiff by using a similar mark is made out and an injunction has necessary to follow even at the initial stage.

The defendant filed an application under Order XXXIX Rule 4 of the Code of Civil Procedure 1908, seeking vacation of the *ex-parte ad interim* injunction. The defendant contended that the plaintiff concealed the subsequent renewal of the plaintiff's registered trademark in 2019 after its removal in 2010. Further, the defendant also relied on its copyright registration of the artistic work 

, which was registered in his favour in 2018, and the trademark registration for the device , which was filed in 2011 and secured when the plaintiff's mark was abandoned for non-renewal. Lastly, the defendant alleged that the evidence adduced by the plaintiff to show the use of the trademark through invoices is fabricated, and reliance cannot be placed upon them.

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The plaintiff refuted all allegations and contended that lack of renewal is not relevant for the claiming user since, at the time of the suit's institution in 2023, the plaintiff's trademark was registered with a history of usage from 1979 and, additionally, a copyright registration from 1979. Further, the plaintiff also apprised the Court of having filed a rectification petition in relation to the defendant's copyright registration.

Legal Queries Raised in Proceeding

The Court, after hearing submissions from both parties and perusing evidence on record, was of the view that the application for vacation sought by the defendant cannot subsist in light of the plaintiff's copyright and trademark registrations since 1979, even if the same were not on the register from 2010 to 2019.

The Court made a stark observation that the defendant had, in fact, applied for registration of the same trademark in the year 2011 during the period of non-renewal of the trademark and also got registration of the copyright of the same artistic work in 2018 despite the prior trademark as well as copyright registration of the plaintiff. The Court held that since the defendant had adopted absolutely identical marks, their adoption could not be considered *bona fide*. With regards to the allegation of fabrication of evidence, it was held that such a question is not relevant for the purpose of interim injunction and shall be considered at the time of trial. Considering all facts, the Court made its *ex-parte ad interim* injunction order absolute. This case underscores the importance of the rights of prior users of a trademark. Interestingly, even though copyright subsists in itself, registration of copyright does favour a Plaintiff in such proceedings to tilt the balance of convenience in their favour.

48. Relief of Passing Off Against Registered Trademark

Case: Burberry Limited vs M/S Petrol Perfume & Ors [CS(COMM) 176/2024]

Forum: Delhi High Court

Order Dated: February 28, 2024

Order: A recent legal battle between Burberry Limited and M/s Petrol Burberry Limited vs. M/s Petrol Perfumes & Ors: Seeking Relief of Passing Off Against Registered Trademark Perfumes and other defendants serves as a poignant example of the ongoing struggle against counterfeiting and deceptive practices in the luxury goods market faced by a well-reputed brand. In this ever-evolving global commerce landscape, brand integrity is a cornerstone of success for companies seeking to establish themselves as leaders in their respective industries. Among the myriad challenges businesses face, protecting intellectual property rights, particularly trademarks, is paramount in safeguarding brand identity and consumer trust.

Background

The lawsuit revolves around the plaintiff's two perfumes, sold under marks 'MY BURBERRY' and 'MR. BURBERRY' and the alleged deceptive activities of the defendants in relation to the manufacture and sale of perfumes, with marks "My Petrol" & "Mr. Petrol". The plaintiff, Burberry Limited, hereinafter referred to as "Burberry", contends that the defendants have adopted deceitful practices and ridden over its goodwill and market reputation by manufacturing and selling perfumes and related products bearing their registered marks 'MY PETROL' and 'MR. PETROL' hereinafter also referred to as "impugned marks", closely resembling

Burberry's trademarks. Additionally, the defendants have adopted an identical trade dress, posing a significant threat to Burberry's brand identity.

Facts of the case

Burberry Limited, a distinguished private limited company headquartered in London, England, extends its business operations to India through its subsidiary, Burberry India Private Limited (hereinafter referred to as "Burberry"). Since its establishment in 2010, Burberry has been actively involved in the manufacturing, distributing, and selling of various products, including apparel, garments, eyewear, footwear, and fragrances. The plaintiff has established a strong presence in the global market with a portfolio of trademarks such as BURBERRY, BURBERRY EQUESTRIAN KNIGHT Logo, CHECK device, and various Burberry formative marks. Recognised as one of the world's leading lifestyle designer brands, Burberry consistently earned recognition among 'The 100 Best Global Brands' by Interbrand, an esteemed independent brand-ranking organisation.

The company designs, manufactures, sources, and sells products under the BURBERRY trademark/label worldwide through its physical stores, online platform www.Burberry.com, and various third-party wholesale outlets. The globally adopted trademarks ‘MY BURBERRY’ in 2014 and ‘MR. BURBERRY' in 2016 was consistently utilised by the plaintiff since its inception. With significant investment in advertising these products, it had a highly successful worldwide launch campaign. As a consequence, these marks MY BURBERRY and MR. BURBERRY have gained substantial goodwill and reputation and is among the plaintiff's most renowned and acclaimed fragrances.

The Defendants entered the market in 2019 intending to use the impugned marks on identical goods to create market confusion and diminish the value of the plaintiff's marks. It adopted the marks “MY PETROL” and “MR. PETROL”. The defendant replicated the trade dress of the plaintiff by use of similar trademarks "MY PETROL" and "MR. PETROL" on the trade body at the same place as the plaintiff's product with the marks "MY BURBURRY" and “MR. BURBERRY”, hence affecting the Intellectual Property rights of the plaintiff.

The defendant's product has an identical font, writing style, colour combination, overall appearance, presentation, surface pattern, manner of writing, and placement of objects. The shape and structure are also an exact imitation of the plaintiff's overall product. This blatant mimicry threatens to dilute Burberry's brand identity, mislead consumers, and capitalise on the plaintiff's established goodwill and reputation.

Contentions of the Parties

Counsel for the Plaintiff contended its injunction application against a defendant who has adopted impugned marks/labels/trade dress which are deceptively similar to two of the plaintiff's reputed perfumes sold under the mark **"MY BURBERRY"** and **"MR. BURBERRY"**. The plaintiff contended the defendant to be a habitual infringer of popular brands and showed copies of restrained orders in support.

Having goodwill, a high reputation, and financial highlights globally, the plaintiff emphasised investments in advertisements and revenue earned during previous years. The global presence and established reputation were damaged by the misrepresentation of the defendant through its product under impugned marks/labels/trade dress "**MY PETROL**" and "**MR. PETROL**" with respect to identical goods, which had caused a strong likelihood of confusion in the market.

Contrary to the contentions made by the plaintiff, counsel on behalf of the defendant represented it bonafide by emphasising the non-similarity between the prominent parts "BURBERRY" and "PETROL" of competing marks **"MY BURBERRY"**, **"MR. BURBERRY"** adopted by plaintiff **and** "**MY PETROL**", "**MR. PETROL**" adopted by defendant respectively. The counsel for the defendant concluded that no confusion was created in the market as purchasing customers are different.

It also pointed towards the aspect of the defendant's mark being a registered mark, unlike the plaintiff's unregistered mark, should not be injuncted; the allegation of habitual infringer was rebutted, alleging restrained orders were passed ex-parte, and they have reopened those proceedings. The defendant's contentions inclined to show delayed proceedings and acquiescence on the part of the plaintiff and narrated that the plaintiff knew about the defendant's existence in the market since 2019.

Court’s Decision

Despite the defendants' assertions of lawful registration of their marks, the Court identified their actions as passing off and violating Burberry's intellectual property rights, affecting Burberry's well-earned goodwill and reputation over the years. The presence of the registered trademark of Defendants could not make any difference. The legal battle at a preliminary stage was decided in favour of the plaintiff's mark "**MY BURBERRY**” and “**MR. BURBERRY**”, injuncting Defendants, their representatives or anyone acting on their behalf from using, selling, manufacturing, marketing, importing, exporting or dealing in any manner in the physical or online market place, under the impugned marks “**MY PETROL”** and **“MR. PETROL”** restricting from copyright infringement of Burberry’s labels, passing off, violation of common law rights, trade dress infringement, trade-name rights violation, and involvement in falsification, unfair, and unethical trade practices that can effect rights of Burberry till further orders after February 28, 2024.

The Court reached out to the above conclusion based on its prima-facie view that mere comparison of the products shows complete dishonesty on the part of the defendant as the choice of typography “**MY PETROL”/** and “**MR. PETROL”/** on perfumes is identical to Plaintiff’s **“MY BURBERRY”/** and **"MR.**

BURBERRY"/ , adoption of trade dress  by the defendant is identical to the plaintiff's adopted trade dress ; employing such deceptively similar labels prima facie shows mala fide on the part of the defendants. Relying on the Supreme Court's Judgment of **S. Syed Mohideen vs P. Sulochana Bai [(2016) 2 SCC 683],** the Court clarified that the plaintiff could seek an interim injunction on passing off, a broader common law right than action for Infringement**.** All ingredients of passing off were evident from the facts of the case. Hence, the Court injuncted the defendant's actions on the grounds of passing off and an evident unjust advantage accrued by the use of identical/ deceptively similar trade marks/labels/ trade dress of the plaintiff.

Conclusion

Burberry Limited's legal victory in this case sets a significant precedent for the importance of brand protection and enforcement. It reaffirms the company's commitment to maintaining its reputation as a global leader in luxury fashion. It serves as a beacon of hope for businesses facing similar challenges in safeguarding their intellectual property rights.

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49. Underlining the Importance of Using Distinctive and Unique Marks for Trademark Protection

Case: Wings Pharmaceuticals P. Ltd vs Khatri Healthcare P. Ltd. & Anr [CS(COMM) 17/2024 & I.As. 378/2024, 381-382/2024]

Forum: High Court of Delhi

Order Dated: March 4, 2024

Order: The Plaintiff is a renowned manufacturer of pharmaceutical and consumer healthcare products who asserted ownership of the trademark "JU NASHAK." The trademark has been in use since 2015, specifically for the company's anti-lice cream. The plaintiff claimed that the product had been marketed in a distinctive and attractive trade dress or carton packaging, which has undergone some changes over the years due to dynamic market conditions. However, the key features of the colour scheme and the original and unique elements, such as the girl and lice device and the shield device, have remained the same. It further claimed that the trade dress has gained significant recognition among consumers, who consider it highly distinctive.

The Plaintiff made an allegation against Defendant No. 1, claiming that they obtained registration for a similar mark "JUNASHAK" for anti-lice cream shampoo. The Defendants, who are well-versed in the pharmaceutical business, were cognizant of the Plaintiff's adoption and use of their trademark, along with their carton packaging and trade dress. Notably, other market competitors have adopted distinctive trade dress for their products. Conversely, the Defendants adopted the impugned mark and packaging after observing the success of the Plaintiff's product. Such deceptive adoption was tantamount to infringement, passing off, unfair trade practice, unfair competition, and dilution of the Plaintiff's trademark and copyright.

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The plaintiff further claimed that if the Defendants were not injuncted, they would experience irreparable loss.

The matter before the court pertained to the eligibility of the term "JU NASHAK" for trademark protection, considering its descriptive nature. Specifically, "जूँ नाशक"/"JU NASHAK" is a term that signifies "lice killer" in common parlance and is generally employed to describe an anti-lice shampoo, suggesting that the product is intended to counteract or eliminate lice infestations.

The Plaintiff argued that this term was eligible for trademark protection despite its descriptive character. However, the actual use of the term by the Plaintiff seemed to be purely descriptive. The Court also opined that the Plaintiff mainly used the trademark "HAIRSHIELD" and related devices for its products and only described the product as an "जूँ नाशक क्रीम वॉश" /"anti-lice cream wash" on the back of the product. The expression "JU NASHAK" appeared to be used in a manner that served a primarily descriptive function and did not reflect exclusive trademark usage. Therefore, the Plaintiff's reliance on "JU NASHAK" as a trademark appeared to be overstated, given its primarily descriptive nature.

The court emphasised that using a purely descriptive term, such as "जूँ नाशक"/ "JU NASHAK," as a trademark posed a fundamental challenge to its suitability as a trademark. While Defendant No. 1 had successfully obtained registration for the trademark "JUNASHAK," it was crucial to acknowledge that this registration did not automatically confer immunity from challenges concerning its capacity to serve as a trademark.

The Plaintiff's asserted reputation was primarily associated with "HAIRSHIELD" as opposed to "JU NASHAK". This was compounded by the presumption of validity of Defendant No. 1's registration, which placed the Plaintiff in a notably weakened position. Moreover, the descriptiveness of "JU NASHAK" in relation to the product's function further diminished the potential for exclusive association with the Plaintiff. Consequently, the grounds for injunctive relief at this interlocutory stage were significantly weakened.

The Court declined to grant an injunction in favour of the Plaintiff, citing that the term "JU NASHAK" primarily denotes the product's function of combating lice infestations. The Court further observed that the Plaintiff predominantly used the trademark "HAIRSHIELD" for its products, with "JU NASHAK" serving a descriptive function rather than indicating exclusive trademark usage.

In other words, the Court concluded that the term "JU NASHAK" was a descriptive term that accurately conveyed the product's function rather than identifying the product's source or origin. As a result, the Plaintiff could claim exclusive rights to this term as a trademark.

This ruling highlights the importance of selecting distinctive and unique trademarks that can adequately distinguish a product or service from others in the market. It also emphasises the significance of avoiding descriptive or generic terms that may not qualify for trademark protection.

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50. Court Battle over the Use of Generic Terms: The Trademark Infringement Dispute over "Dish"

Case: Prasar Bharti vs Dish TV India Limited [FAO(OS)(COMM) 267/2019]

Forum: High Court of Delhi

Judgment Dated: March 6, 2024

Judgment: The appellant, Prasar Bharti, also known as Doordarshan, is the public broadcaster of India, which has been providing free radio and television services to its subscribers since 2004, including direct-to-home (DTH) services. They filed an intra-court appeal against an order passed by the Single Judge on July 16, 2019. The order allowed the respondent's application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908, which restrained Prasar Bharti from adopting the trademark 'DD Free Dish' or any other mark incorporating the mark 'Dish', pending disposal of the suit.

The respondent is the holder of the trademark "Dish TV" and asserted that the term "Dish" was an indispensable and commanding part of their branding. Conversely, the petitioner submitted an application for the registration of the mark "DD Free Dish" but refrained from seeking registration for the standalone term "Dish". The respondent accused the petitioner of infringing upon their trademark rights by using the term "Dish". Consequently, the respondent initiated legal action to secure an injunction that prohibited the petitioner from using the term "Dish" in their mark "DD Free Dish". The respondent contended that the term "Dish" was inextricably linked with Direct-to-Home (DTH) services and was an integral component of their trademark, "Dish TV".

The appellant disputed the claim that their use of the term "DD Free Dish" was infringing the respondent's trademark rights, arguing that "Dish" was a generic term. The respondent argued that "Dish" was an essential part of their trademark "Dish TV", which has acquired distinctiveness through long-term use. They contended that the appellant's use of the term "Dish" created confusion among consumers and diminished the distinctiveness of the respondent's mark. In response, the appellant stated that they had not applied for registration of the standalone term "Dish" and that generic words can be combined for trademark registration. They further argued that the respondent was entitled to protection for their mark, not for the individual words comprising it.

After considering all the relevant facts, the Court noted that although the term “Dish” might be an integral part of the respondent’s mark, it was also a commonly used word in the context of DTH services. The Court observed that the appellant's use of the term "Dish" alongside "DD Free Dish" may not necessarily cause confusion among consumers, especially considering the distinctiveness associated with the appellant's mark. Furthermore, the Court examined previous judgments and legal principles related to trademark protection and has concluded that the mere presence of the term "Dish" does not automatically grant exclusive rights to the respondent. The Court highlighted the importance of considering the mark as a whole instead of breaking it down into individual components.

The Court opined that it was unable to accept that there was any likelihood of anyone being deceived or confused from the use of the word ‘Dish’ by the appellant in its composite mark ‘DD Free Dish’.

The court held that the respondent's claim for an injunction was not justified. It set aside the lower court's judgment and emphasised that the observations made in its order were provisional measures intended to decide on interim relief. The court clarified that the trial court should adjudicate the matter without being influenced by its provisional observations.

In reaching its decision, the court considered the arguments put forth by both parties. The appellant contended that the term "Dish" was generic and widely used in the relevant industry. The respondent, on the other hand, argued that the appellant's use of the term was likely to mislead consumers into believing that its products were associated with the respondent.

Ultimately, the court ruled in favour of the appellant, highlighting the generic nature of the term "Dish" and the lack of evidence indicating confusion among consumers. The court noted that the respondent had failed to provide any evidence demonstrating that consumers were likely to be confused by the appellant's use of the term in its trademark.

In conclusion, the court's ruling provided clarity on the issue of trademark infringement and the use of generic terms in trademarks. The decision emphasised the importance of providing evidence to support claims of infringement and cautioned against relying on provisional observations when making legal determinations.

51. Steaming Ahead: Safeguarding Brands in a Competitive Market

Case: Dolma Tsering vs Mohd. Akram Khan and Anr [C.O. (COMM.IPD-TM) 334/2021]

Forum: High Court of Delhi

Order Dated: March 3, 2024

Order: If you have ever strolled through the bustling streets of Delhi, chances are you've indulged in the delectable delights served up by 'Dolma Aunty Momos'. Their momos are a quintessential part of Delhi's Street food culture, enjoyed by locals and visitors alike.

In recent years, momos, a Tibetan delicacy, has soared in popularity across India, transcending regional boundaries to become a beloved street food snack enjoyed by people from all walks of life. From bustling city streets to quaint towns, momo stalls and restaurants have mushroomed, offering a diverse range of fillings and flavours to tantalise taste buds. The widespread popularity has not only fuelled the growth of countless momo businesses but has also highlighted the importance of brand protection in the fiercely competitive food industry.

A recent example of such protection comes from the case of **Dolma Tsering v. Mohd. Akram Khan and Anr C.O. (COMM. IPD-TM) 334/2021** in the Delhi High Court, where the Petitioner is the owner of famous establishment 'Dolma Aunty Momos' and has been selling momos and other products through her five shops in Delhi-NCR since 1994.

The Petitioner had come across Respondent No. 1's mark "DOLMA AUNTY MOMOS" and noted the eery similarity/ identicalness between his trademark and her own established brand, so much so that it even contained her own name, DOLMA. The Petitioner already owns the registration for 'Dolma Aunty Momos', in class 29, filed on April 20, 2022, with use claimed since January 1st, 1994 and has another application pending in class 43. A rectification petition seeking cancellation and removal of Respondent No. 1's trademark was filed by the Petitioner as it infringed upon the rights of the petitioner. The petition was initially filed with the Intellectual Property Appellate Board (IPAB) before being transferred to the Delhi High Court due to the abolition of the IPAB.

The Petitioner had set up a small shop in 1994 in Lajpat Nagar and claimed to be the first retailer of said Tibetan delicacies, which had become widely popular. To demonstrate continuous use, goodwill and reputation, she submitted photographs of her flagship shop at Lajpat Nagar, a list of accolades for the quality of goods and services, screenshots from food delivery platforms, various online articles where the said trademark was being used, and a registration certificate obtained under the Food Safety and Standards Act, 2006.

Considering Respondent No. 1 neither appeared nor responded to the petition filed, the Court was of the view that the impugned trademark should be cancelled and removed from the Trademarks Register and thus rectified.

The case serves as a poignant reminder of the importance of protecting and defending your trademarks, especially in the fiercely competitive Food Industry. By actively safeguarding your trademarks and taking swift action against passing off and infringement, you not only preserve the integrity of your brand but also maintain the trust and loyalty of your customers.

Failing to protect the trademark may lead to severe consequences, including consumer confusion, quality control concerns, health and safety risks and loss of sales and market share. The proactive approach ensures that your unique identity remains protected and saves your name from being exploited, allowing you to continue building and growing your business with confidence and longevity.

52. Balancing Trademark Rights: Delhi High Court's Analysis in Jindal Industries Pvt. Ltd. vs Defendants

Case: Jindal Industries Private Limited vs Suncity Sheets Private Limited and Anr [CS(COMM) 679/2023]

Forum: Delhi High Court

Order Dated: March 07, 2024

Order: In the recent case, the Plaintiff- Jindal Industries Pvt. Ltd., seeks an interim injunction restraining the defendants from using the mark , or 'JINDAL' per se, in any manner that would infringe the plaintiff's registered trademarks. The Delhi High Court opined that the right of a person to use her or his own name on her or his own goods could not be compromised; otherwise, it would compromise the right to use one's name as an identity marker, which would ex facie be unconstitutional. The Court thus held that the plaintiff's prayer for injunction therefore failed even on the sole anvil of Section 35 of the Trademarks Act, 1999, and no case of infringement or passing off was made out as the word mark 'JINDAL', and the logo , seen as whole marks, were neither identical nor deceptively similar.

Background

The plaintiff was the registered proprietor of the word mark 'JINDAL' since 2014, in Class 17; the word mark 'JINDAL' since 2007, in Class 6; and the word mark 'JINDAL COR' since 2007, in Class 6. Defendants used the composite mark by combining the initials of the wife of the Manager of SSPL with 'JINDAL', and the defendants ingeniously infringed

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the plaintiff's registered trademarks. Defendant 2, the wife of Nitin Kumar Jindal, the Manager of SSPL, applied for registration of the impugned mark as a sole proprietor of RN Jindal SS Tubes.

The plaintiff submitted that the defendant's mark was clearly similar, if not identical, to the plaintiff's registered 'JINDAL' word mark. The plaintiff's registered word mark had entirely been subsumed in the defendants' impugned mark, and 'JINDAL' was clearly the most prominent part of the impugned mark. Therefore, a prima facie case of infringement, within the meaning of Section 29(2)(b) of the Act, existed.

Defendants submitted that they could not be injuncted from using the impugned mark as 'JINDAL' was a common surname. It might be registerable but was not enforceable in view of Section 35 of the Act. The plaintiff's attempt was to entirely monopolise the use of the common surname 'JINDAL', either by itself or with any other words or images. This was clearly impermissible, inasmuch as the name of Defendant 2, who markets the product, was Rachna Nitin Jindal, and her use of the impugned mark was perfectly legitimate. The use of one's own surname as a trademark was prima facie bona fide.

A comparison of both marks is provided below:

Plaintiff's Mark	Defendants' Mark

Court's Analysis and Ruling

The Court opined that in view of Section 35, the plaintiff could not interfere with the use by Defendant 2 of her own name, provided, of course, the use was bona fide. The Court observed that Section 2(2)(b) of the Act ordained that "unless the context otherwise requires, any reference, in the Act, to the use of the mark shall be construed as a reference to the use of the printed or other visual representation of the mark". The Court thus opined that there was no reason for not extending the benefit of Section 35 of the Act to the use of the name in the form of initials either. Therefore, Defendant 2 would be entitled to the benefit of Section 35, in respect of the use, by her, of 'Rachna Nitin Jindal', or for that matter, 'RN Jindal' or even 'RNJ'.

The Court opined that in the impugned mark, the most prominent feature was, undoubtedly, 'RNJ' with the sun symbol alongside. The name below was the name of Defendant 2 herself, R.N. Jindal. The mark did not highlight or emphasise, in any manner, 'JINDAL' over 'RN'. It was not possible, therefore, to read the mark as 'JINDAL', ignoring the 'RNJ' or the 'RN' which preceded 'Jindal' in the small print. The Court also opined that to tear out from the impugned composite mark the word 'JINDAL' and allege, on that basis, that the mark infringed plaintiff's registered 'JINDAL' marks was not justified by any provision of the Act.

The Court relied on Amritdhara Pharmacy v. Satya Deo Gupta and opined that "the marks had to be compared as whole marks". Thus, the Court opined that the plaintiff's mark 'JINDAL' and the defendant 's mark were as alike as chalk and cheese. The benefit of Section 35 of the Act was certainly available to Defendant 1 as it was Defendant 1 who had applied for registration of the impugned mark as its proprietor.

The Court noted the plaintiff's contention that "the benefit of Section 35 of the Act would be available only if the name were used as a source identifier, and not if it was used 'in the trademark sense' or 'as a trademark', and opined that there was no such caveat, or condition, in Section 35 of the Act.

The Court opined that "it would stretch the limits of credulity, to hold that the use of 'JINDAL', by defendants, as a mere part of the total composite impugned mark , was likely to deceive a consumer of average intelligence and imperfect recollection that the goods of defendants, on which the mark was used, were those of plaintiff. The Court also opined that "Section 35 of the Act protected bona fide use of one's own name and proscribed any interference therewith. No exception was created in a case where the name was used as a trademark, or otherwise".

The Court stated that the way the defendants printed the impugned mark on their furniture was completely different from the manner in which the plaintiff used its JINDAL mark ; the goods were clearly distinguished.

The Court observed that "one who obtained registration of a common name, or surname, like 'JINDAL', as a trademark in his favour, did so with all the risks that such registration entailed. It was open to anyone, and everyone, to use his name on his goods, and, therefore, the possibility of there being several JINDALs looms large. Plaintiff could not, by obtaining registration for 'JINDAL' as a word mark, monopolise the use of 'JINDAL' even as a part and not a very significant one at that of any and every mark, even in the context of steel or SS pipes and tubes. The Trademarks Act, 1999, and the privileges it conferred could not be extended to the point where one could monopolise the use of a common name for goods, and, by registering it, foreclose the rest of humanity from using it".

The Court opined that "the right of a person to use her, or his, own name on her, or his, own goods, could not be compromised; else, it would compromise the right to use one's name as an identity marker, which would ex facie be unconstitutional".

The Court opined that the interpretation that "the use of one's name as an identity marker was permissible under Section 35 of the Act, but the instance it spilt over into trade mark territory, it was rendered impermissible" would mean to read a non-existent proviso into Section 35 of the Act and, in effect, would lead to rewriting the provision. The proscription under Section 35 of the Act was absolute and would extend to infringement and passing off actions. The restraint against interference with the bona fide use by a person of his own name was not dependent on whether the action was one for infringement or passing off.

The Court thus held that the plaintiff's prayer for an injunction, therefore, failed even on the sole anvil of Section 35 of the Act, and no case of infringement or passing off was made out as the word mark 'JINDAL', and the logo , seen as whole marks, were neither identical nor deceptively similar. Further, there was no prima facie likelihood of confusion or deception resulting from the use by defendants of the mark. Seen as a whole mark, it possessed several features of distinction vis-à-vis the bare word mark 'JINDAL' of the plaintiff, such as the bold and prominent 'RNJ' logo, the sun symbol, and the words 'RN JINDAL SS TUBES' prominently written below it.

53. Delhi High Court Orders Removal of 'BE THE BEER' Trademark: Victory for 'THE BEER CAFÉ' Chain

Case: BTB Marketing Pvt. Ltd. vs Deepshikha Singh and Anr. [C.O. (COMM.IPD-TM) 380/2021]

Forum: Delhi High Court

Order Dated: March 12, 2024

Order: This petition was filed to rectify the respondents' trade mark 'Be the Beer', registered on 5-10-2017 with effect from 23-3-2017 in Class 43. The Delhi High Court allowed the petition and ordered that the impugned mark 'BE THE BEER' of Respondent 1 should be removed from the register within four weeks.

Petitioner claimed to be the registered proprietor of the device and the word mark ‘THE BEER CAFÉ’/ THE BEER CAFE and The Beer Café in Class 43, with effect from 26-8-2010 and 20-6-2016, respectively. Petitioner claimed to be engaged in running a chain of food and beverage cafés under the brand name and style of 'THE BEER CAFÉ', having outlets spread across pan-India. The petitioner submitted that they operated more than 120 outlets all over India, and the said venture was founded in 2012 and posted the registration of the trademarks; the petitioner had been using the said marks continuously and extensively across the country.

The petitioner was aggrieved by the respondents' usage of the mark 'BE THE BEER' and thus sought rectification with respect to the respondent's impugned mark 'BE THE BEER'. The petitioner submitted that respondents were operating in the same industry of food and beverages and running cafes, and simply prefixing the word 'BE' was obviously causing deceptive

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similarity with their registered mark having a prior user. Besides a cease and desist, a notice dated 2-4-2018 was sent to the respondent, which was replied to by communication dated 16-4-2018.

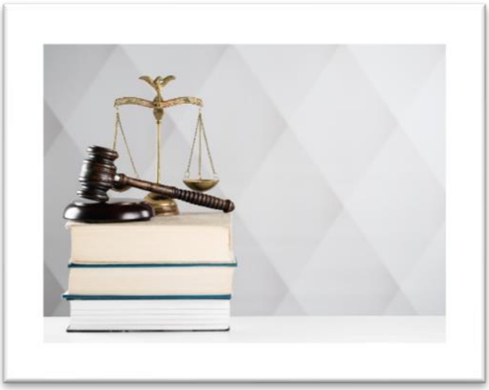
The Court opined that since no one had appeared on behalf of Respondent 1 before this Court and Respondent 1 had not responded, the petitioner's averments would stand admitted. The Court allowed the petition and ordered that the impugned mark 'BE THE BEER' of Respondent 1 should be removed from the register within a period of four weeks.

54. Analysing the Delhi High Court's Decision on Non-Working Trademark Registry Website

Case: Intellectual Property Attorneys Association (IPAA) vs The Controller General of Patents, Designs & Trade Marks & Anr. [W.P.(C)-IPD 49/2023]

Forum: High Court of Delhi

Order Dated: March 12, 2024



Order: The petitioner filed a petition seeking directions from the court to suspend the periods of limitation prescribed under the Trade Marks Act and Trade Mark Rules until the complete resumption of services of the website/portal of the Trademark Registry. Additionally, the writ petition was filed to set aside/withdraw the public notices issued on September 13, 2023, by respondent no.1. These public notices restricted public access to the website during normal working hours.

On January 8th, 2024, the court directed those two independent status reports to be filed - one by respondent no. 1 (Controller General of Patents, Designs & Trade Marks) and another by respondent no. 2 (Union of India through Ministry of Commerce and Industry). The Court recognised that the outdated system of managing intellectual property matters cannot handle the large number of international filings and investments. Therefore, it was expected that competent authorities would urgently and seriously address this issue so that solutions can be found and implemented as soon as possible.

The Controller General of Patents, Designs & Trade Marks issued a public notice on February 1st, 2024, announcing that the website, including the E-Register, would be available 24/7 without any time restrictions starting from February 1st, 2024. However, the petitioner argued that the website was still not functional, and it created difficulties for parties and their attorneys in complying with statutory deadlines.

In their application, the petitioner stated that a public notice was issued on March 5th, 2024, informing stakeholders that e-filing services and the payment gateway for Patents, Designs, GI and Trademarks would be unavailable due to maintenance activity. They also highlighted that stakeholders were facing difficulties in accessing various modules on the website, such as "First Examination Report", "Notice of Opposition", "Counter-Statement", and "Notice".

The stakeholders were facing significant challenges in monitoring their legal matters, as they could only review daily cause lists. Unfortunately, the hearing notices were being issued with links that were inaccessible, which further exacerbated the problem. Additionally, since March 4th, 2024, there has been an unavailability of e-filing services and payment gateways. These issues resulted in stakeholders being unable to make payments for various deadlines, leading to the loss of their valuable intellectual property rights.

The respondent brought to light a public notice dated March 6th, 2024, issued by the Controller General of Patents, Designs & Trade Marks, which stated that e-filing and payment gateway services had resumed. Additionally, the notice extended the deadline, which previously fell between March 4th, 2024, and March 6th, 2024, to March 11th, 2024. To this, the petitioner contended that the public notices were issued only after the instant application was served and access to various parts of the website and payment gateway was still unavailable. The petitioner provided screenshots of the payment gateway, which showed a time lag of 60 minutes to successfully complete the payment upon failure of the first attempt.

Considering all these facts, the Court deemed it fit to direct the Controller General of Patents, Designs & Trade Marks, or a senior designated officer to make a personal appearance or attend via video-conferencing on the next date of hearing. The purpose of such an appearance would be to apprise the Court of the measures that can be taken to preclude similar eventualities in the future. Furthermore, the officer must propose solutions for technical glitches in case any arise. The petitioner has been requested to furnish a comprehensive list enumerating the issues that have come to light in the recent past. Additionally, the petitioner was directed to suggest remedial measures.

For the issue relating to the inability to file or access documents/forms and pay the requisite fee when either the web portal or payment portal is non-functional, the petitioner suggested that an alternative facility be made available by the Controller General's Office. This facility would permit filing through e-mails and payment through an alternate payment system that is not dependent on the status of the web portal. The suggested alternative would serve as a solution to the problem by providing a means of filing and payment in the absence of the web portal.

The petitioner/association also suggested Standard Operating Procedures (SOPs) that can be implemented during the downtime of the web portal. To foster an effective and collaborative dialogue between the members of the Intellectual Property Bar, represented by the petitioner association, and the Controller General's Office, a virtual meeting was scheduled for March 15th, 2024.

The issue at hand concerns intellectual property rights, a domain in which time sensitivity is paramount. Even minor delays can potentially result in loss of these rights for holders of intellectual property. This case serves to underscore the pressing need for a more robust technological infrastructure at the CGPDTM office, given the rising number of IP filings in the country. Such an infrastructure is essential to ensure that the office can keep pace with the demands of the growing intellectual property industry.

55. Google vs. Goocle: Delhi High Court Halts Trademark Infringement

Case: Google LLC vs Mr. P. Rajesh Ram & Ors. [CS(COMM) 209/2024]

Forum: Delhi High Court

Order Dated: March 12, 2024

Order: This suit relates to the plaintiff's rights in the trademarks GOOGLE, , GOOGLE PAY, GPAY, and . The Delhi High Court restrained Defendants 1 to 5, or anybody acting on their behalf, from rendering, selling, offering for sale, advertising, broadcasting, or directly or indirectly dealing with any services under the marks 'GOOGLE', 'GEOGLE', 'GOOCLE', 'GIPAY', , , , , , , , , , , or any other trade mark in any language, representation or form, which was identical or deceptively similar to plaintiff's 'Google' and 'GPay' trademarks, and which amounted to infringement or passing off of plaintiff's 'Google' and 'GPay' trademarks.

Background:

Plaintiff, Google LLC, was the registered proprietor of the 'Google' trademarks in India in classes 9, 38, 42, 35, 16, 25, and 36 for computer hardware and software, advertising, books, manuals, and telecommunication services. The plaintiff also had multi-class registrations of 'GPay' trademarks with respect to smartphones, digital payment services, online retail services, etc. Plaintiff's registrations in India for the trade mark 'GOOGLE' and 'GPAY' date back to 1999 and 2015, respectively. The domain name/website 'www.google.co.in' was registered in the plaintiff's name on 23-6-2003.

In June 2023, the plaintiff discovered applications for registration of the marks , , and in Class 35 and for marks , in Class 36, all filed by Defendant 1. Plaintiff initiated a further investigation and found that Defendant 1 was a partner of Defendants 2 to 5, namely, Goocle Housing LLP, Goocle Tamil News LLP, GIPAY Online Service LLP, and Goocle Trade Payment LLP, which were incorporated in June-October 2022. Defendant 1 was also the owner of several domain names that either subsumed the plaintiff's 'GOOGLE' trade mark or contained a deceptively similar mark 'GOOCLE'. Further, Defendants 1 to 5 operate multiple accounts on several social networking websites using the username/handle, which incorporates the marks/ terms 'GOOCLE', 'GEOGLE', and 'GIPAY'.

Plaintiff submitted that Defendant 1 had used the terms 'GOOCLE', 'GOOGLE', 'GIPAY', and 'GEOGLE' that were deceptively similar to

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plaintiff's registered 'GOOGLE' and 'GPAY' marks, thus amounting to trade mark infringement.

Comparison of the defendants' marks with the plaintiff's marks.

Plaintiff's Marks	Defendants' Marks
GOOGLE	GOOGLE, GOOCLE, GEOGLE
GPAY	GIPAY
Google	Google Goocle

Court's Analysis and Decision:

The Court opined that the impugned trademarks 'GOOGLE', 'GOOCLE', 'GOOGLE' and 'GIPAY' were structurally and phonetically similar to the plaintiff's 'GOOGLE' and 'GPAY' trademarks, with the only difference being of replacement/addition of one alphabet. Prima facie, the impugned marks appear to be deceptively similar to the plaintiff's marks.

The Court noted that the defendants were utilising the impugned marks and domain names for online news, advertising, TV, banking, and payment services, which also corresponded to the plaintiff's scope of business operations and were likely to cause confusion among the consumers.

The Court agreed with the plaintiff's contention that in case of a typographical error in entering the concerned URL/domain name, a potential user could be misled to the impugned website, which did not emanate from the plaintiff. Such impugned marks were also detrimental to the distinctive character of the plaintiff's well-known trademark 'GOOGLE'. The use of the impugned marks thus prima facie constituted infringement of the plaintiff's registered trademarks.

The Court thus issued the following directions:

1. Till the next date of hearing, Defendants 1 to 5, or anybody acting on their behalf, were restrained from rendering, selling, offering for sale, advertising, broadcasting, or directly or indirectly dealing with any services under the marks 'GOOGLE', 'GEOGLE', 'GOOCLE', 'GIPAY', Go> Google Ads, Google Housing,

or any other trade mark in any language, representation or form, which was identical or deceptively similar to plaintiff's 'Google' and 'GPay' trademarks, which amounted to infringement or passing off of plaintiff's 'Google' and 'GPay' trademarks.

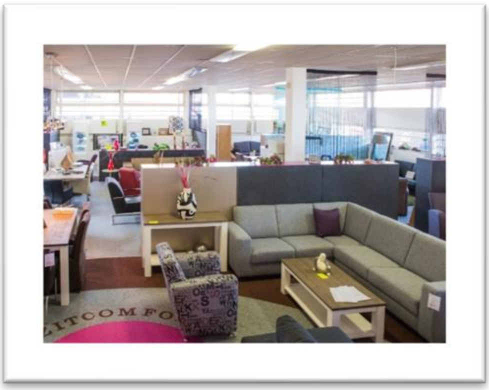
2. Defendants 1 to 5 or anybody acting on their behalf was restrained from rendering, selling, offering for sale, advertising, broadcasting, directly or indirectly dealing any services under the impugned trade name 'Goocle Housing LLP', 'Goocle Tamil News LLP', 'Gipay Online Services LLP', and 'Goocle Trade Payments LLP' or any other trade name which was identical or deceptively similar to plaintiff's 'GOOGLE' or 'GPAY' trademarks or trade name.
3. Defendants 1 to 5 shall also delete/take down the impugned online content, including their social media pages bearing the marks 'GOOCLE', 'GEOGLE', and 'GIPAY'.

56. Trademark Triumph: Delhi High Court Restrains Unauthorized Use of IKEA Marks

Case: Inter Ikea Systems BV vs. John Doe and Ors. [CS(COMM) 205/2024]

Forum: Delhi High Court

Order Dated: March 12, 2024



Order: In the recent case wherein the plaintiff's marks IKEA/ were being used to mislead people into investing significant sums of money on the pretext of securing a steady income from the plaintiff, the Delhi High Court restrained Defendants 1 and 2 and all persons acting on their behalf, from using plaintiff's registered IKEA/ trademarks and/or their variations, as a part of their domain names, websites, mobile applications, social media handle names/profiles credentials/description, promotional/business activities on digital or print media, bank accounts and/or any business papers etc. in any manner, that would amount to infringement and passing off of plaintiff's registered IKEA/ trademarks.

Background

Plaintiff Inter Ikea Systems BV was a part of the Inter IKEA Group, which included service companies and companies selling IKEA products to franchisees in markets. The plaintiff was the owner of the IKEA Concept and IKEA Retail System, which was franchised to specific retailers for the sale of affordable home furnishing products and accessories under the said

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trademarks. The mark and logo , along with its colour combination and trade dress, have been granted trademark registrations in various countries, including India. The domain name "ikea.com", which entails the plaintiff's trademark "IKEA", was registered in the plaintiff's favour on 29-7-1995 and has been accessible worldwide since 1998. On 14-2-2005, the plaintiff also registered the domain name "ikea.in", which was specifically accessible to the Indian public.

The plaintiff's grievance arises from the operation of the website "www.keiekae.store/ikea/" and the mobile application "IKEA" by Defendants 1 and 2 that were an imitation of the plaintiff's own website and mobile applications. Plaintiff first learnt of the impugned website and mobile application through a complaint received by an aggrieved consumer, and as per his account, Defendants 1 and 2 openly advertise the impugned website and mobile application as a money-making platform, guaranteeing returns up to 200% of the invested amount within 35 days.

In addition to the above, the victim was also made to join a WhatsApp group titled "IKEA-1011 WORKING GROUP" with about 150 other participants. However, when he started to question the legitimacy of the impugned website and application, he and his father were removed from the group, and the invested amount was never returned to them. In the process, the victim's father lost about Rs 20,000. Thus, the victim complained to the Cyber Cell Department in Pune.

The plaintiff took the services of an investigator, who confirmed the victim's information. The 'About Us' section and several articles on the impugned website mention information about the plaintiff and the IKEA products. The 'IKEA Story' section of the impugned website contains a URL directing the user to a mirror website that has lifted content from the plaintiff's website. Further, the impugned website displayed a Certificate of Authorization issued by a non-existent Department of Taxation and Electronic Information, which also contained the plaintiff's mark. Thus, the plaintiff submitted that Defendants 1 and 2 were running a

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pyramid scheme by misusing the plaintiff's name and trademark, IKEA/ .

Court's analysis and decision

The Court noted the impugned website and mobile application and opined that the images uploaded on the website and shared on the mobile clearly displayed the plaintiff's "IKEA" and registered trademarks without the plaintiff's consent. The Court also opined that consumers were being misled into investing significant sums of money on the pretext of securing a steady income from the plaintiff. Thus, the Court held that prima facie Defendants 1 and 2 had infringed the plaintiff's registered marks, which was detrimental to the plaintiff's goodwill and standing in the market.

The Court opined that the plaintiff had made out a prima facie case in their favour, and if an ex-parte ad interim injunction were not granted, the plaintiff would suffer an irreparable loss. Thus, the Court passed the following directions:

- Defendants 1 and 2, and all persons acting on their behalf, were restrained from using the plaintiff's registered IKEA/ trademarks and/or their variations as a part of their domain names, websites, mobile applications, social media handle names/profile credentials/description, promotional/business activities on digital or print media, bank accounts and/or any business papers etc. in any manner, that would amount to infringement and passing off of plaintiff's registered IKEA/ trademarks.
- Defendants 1 and 2, and all persons acting on their behalf, were restrained from using a layout/user interface on their website "www.keiekae.store" or any other website, which amounted to

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infringement of the plaintiff's copyright vested in the layout/user interface of their website "www.ikea.com".

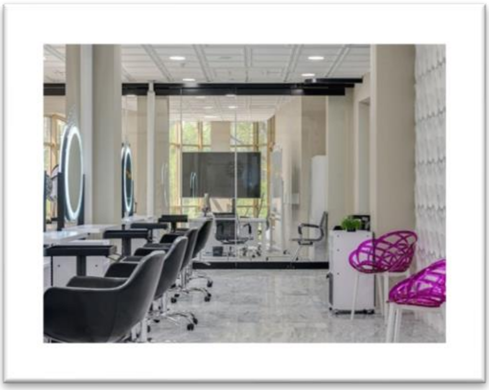
- Defendant 3 should suspend/block the domain name “www.keiekae.store”.

57. Geetanjali Trademark Infringement Case: Protecting Brand Integrity in the Beauty Salon Industry

Case: Geetanjali Studio Private Limited & Anr v. M/S Asm Traders & Ors. [CS(COMM) 233/2024]

Forum: Delhi High Court

Order Dated: March 18, 2024



Order: This recent case revolves around the Geetanjali Trademarks, namely "GEETANJALI", "GEETANJALI STUDIO", , , , and "UTOPIA BY GEETANJALI", used in the beauty salon services sector.

Mr. Prem Israni adopted the mark "GEETANJALI" in 1989 and established 'M/s Geetanjali Beauty Parlour'. After his demise in 1998, his son, Mr Sumit Israni and widow, Mrs. Neetu Israni, took over, renaming it 'M/s Geetanjali Salon'. Later, Mr. Sumit Israni expanded services under "GEETANJALI STUDIO" through a partnership firm.

The Geetanjali Trademarks were licensed to M/s Geetanjali Studio through a Franchise Agreement on 1st October 2018. In March 2021, M/s Geetanjali Salon and M/s Geetanjali Studio were taken over by Geetanjali Salon Private Limited [Plaintiff No. 2] and Geetanjali Studio Private Limited [Plaintiff No. 1] through Business Transfer Agreements dated 18th February 2021 and 17th March 2021, respectively. Additionally, the Geetanjali Trademarks were assigned and transferred by Mr Sumit Israni to Plaintiff

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No. 2 through the Business Transfer Agreement dated 18th February 2021, read with an Addendum dated 01st April 2023. Shortly after that, Plaintiff No.2 applied for the following trademark application under the Madrid System for International Trademark Protection in Australia, European Union, Canada, USA, UAE, and UK:

Trade Mark Application No.	Trade Mark	Class	Date of Application
1756060	GEETANJALI SALON	44	15.06.2023

The plaintiffs stated that they have maintained continuous usage of the Geetanjali Trademarks, establishing a significant presence with over 140 salons/franchises across India. They've invested in promotional activities through a dedicated website and social media platforms and received several awards, indicating their reputation and market standing.

Plaintiffs submitted that In April 2018, the Defendants approached the Plaintiffs to open a "GEETANJALI STUDIO" in Gurugram, Haryana. Accordingly, on 09th April 2018, the Plaintiffs entered into a Franchise Agreement with Defendant No. 1, which was executed between the predecessor of Plaintiff No. 1 and the Defendants. Under this Agreement, the Defendants were permitted to open and operate "GEETANJALI STUDIO", and the Defendants were also licensed to use 'GEETANJALI' trademarks on a non-exclusive basis. The Defendants were obligated to pay an initial franchise fee, which was to be periodically increased as per the terms of the Agreement.

From January 2023, the Defendants began to default on the payments specified under the Franchise Agreement. After repeated reminders, Defendants made part payments for January to March 2023 but failed to make any payments for April to June 2023. When the cheques issued by the Defendants in respect of their outstanding payments were dishonoured, and no payment was received, the Plaintiffs sent a legal notice dated 04th July

2023, thereby terminating the Franchise Agreement dated 09th April 2018 with immediate effect, calling upon them to cease and desist from using the "GEETANJALI" trademark and shut down GEETANJALI STUDIO operated by the Defendants.

After receipt of the said legal notice, on 06th September 2023, the Defendants made the payment of the due amount belatedly. However, they continued to operate the "GEETANJALI STUDIO", thereby infringing the registered "GEETANJALI" trademark of the Plaintiffs.

Plaintiffs sent legal notices demanding cessation of the use of their trademarks, but Defendants responded by adopting a similar mark, "GEETANJALI PALM", 

Contentions

Plaintiffs argued that Defendants' adoption of "GEETANJALI PALM" infringes upon their registered trademarks and amounts to passing off. They contend that the similarity in the marks would mislead consumers into believing that Defendants' services are associated with Plaintiffs' renowned brand.

Plaintiffs asserted that the Defendants' actions threatened their reputation and goodwill, causing irreparable harm. They argued that the Defendants' unauthorised usage dilutes the distinctiveness of their trademarks and undermines their market position.

Court's Decision

After considering the arguments and examining the evidence, the Court found that the Plaintiffs had made out a prima facie case in their favour. Hence, the Court granted an ex-parte ad-interim injunction restraining Defendants from using "GEETANJALI PALM" or any deceptively similar mark until the next hearing.

58. Eveready vs. KSC Industries: Delhi High Court Grants Interim Injunction Against Trademark Infringement

Case: Eveready Industries India Limited vs KSC Industries & Ors. [CS(COMM) 251/2024]

Forum: Delhi High Court

Order Dated: March 21, 2024

Order: This suit was filed by Eveready Industries India Limited, formerly Ever Ready Company (India) Limited, (Plaintiff) engaged in the business of rechargeable batteries, marketing dry cell batteries, flashlights and lighting products under the trademarks "EVEREADY" seeking interim injunction against KSC Industries (defendants). The Delhi High Court restrained the defendants from manufacturing, exporting, selling, offering for sale, advertising, or directly or indirectly, dealing with any goods/ packaging under the trademark/ label "EVERYDAY" or any other mark identical to or deceptively similar with the Plaintiff's trademark "EVEREADY" that would amount to infringement and passing off of the Plaintiff's registered trademark and copyright and unfair trade practice.

The plaintiff company has used the trademarks "EVEREADY" and another unspecified mark (likely redacted) since 1905 through its predecessor-in-interest. Over the years, Eveready has built substantial goodwill and a reputation for its products. The "EVEREADY" mark has become integral to the company's corporate identity and trade name. Eveready has obtained trademark registrations for various versions of the "EVEREADY" word and device marks across different classes. Additionally, the company asserts copyright in the artistic works embodied in its logos. These trademarks and copyrights represent significant assets for Eveready, reflecting the company's long-standing presence and dominance in the Indian market.

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The case arises from the defendant's alleged infringement of Eveready's trademarks. Eveready contends that the defendants' use of the mark "EVERYDAY" for electric gas lighters is deceptively similar to Eveready's "EVEREADY" trademark. Upon discovering the defendants' activities, Eveready initiated online searches and found evidence of the defendant's business operations and trademark application. The defendants were reportedly selling electric gas lighters on the e-commerce platform Amazon.in under the name "Eveready Gas Lighter." Eveready alleges that the defendant's use of the "EVERYDAY" mark aims to exploit Eveready's goodwill and reputation.

Eveready submitted that the defendants' adoption and use of the "EVERYDAY" mark constitute dishonesty and an attempt to capitalise on Eveready's market standing. They argued that the visual, phonetic, and structural similarities between the defendant's mark and Eveready's mark are likely to deceive consumers. Moreover, Eveready emphasised that their mark has been recognised as well-known, and thus, the defendants' use of similar marks for related goods should not be permitted. Eveready also alleged a violation of its copyright in the label/artwork associated with its products. The conflicting marks are as follows:

Plaintiff Mark:

Defendant Mark: 

The Court conducted a comparison between Eveready's mark and the defendant's mark and found prima facie evidence of similarity. The Court noted that the defendants' adoption of the "EVERYDAY" mark appears deliberate and aimed at riding on Eveready's reputation. The similarities between the marks, including their visual, phonetic, and structural aspects, are likely to confuse consumers. Additionally, the Court acknowledged Eveready's well-established goodwill and reputation in the market, emphasising the need to protect against infringement.

Thus, the Court granted an ad-interim ex-parte injunction restraining the defendants from manufacturing, exporting, selling, offering for sale, advertising, or dealing with any goods under the “EVERYDAY” mark or any mark deceptively similar to Eveready's trademark until the next hearing date on 20-08-2024.

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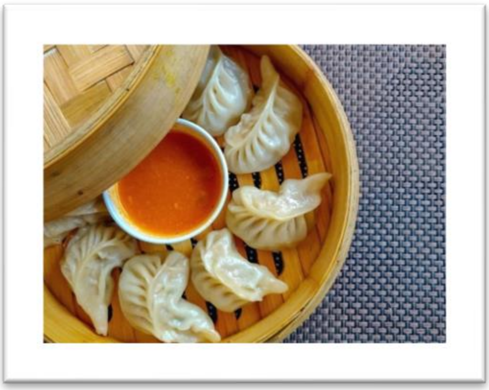
59. Wow Momo Foods vs Wow Punjabi - Delhi High Court Grants Ex Parte Injunction

Case: Wow Momo Foods Pvt Ltd V. Wow Punjabi [CS(COMM) 253/2024]

Forum: Delhi High Court

Order Dated: March 22, 2024



Order: This application was filed by the plaintiff- Wow Momo Foods Pvt. Ltd., seeking a permanent injunction restraining trademark infringement, passing off, unfair trade practice, rendition of accounts, and damages against the defendant, Wow Punjabi. The Delhi High Court passed an ex parte ad interim injunction against the defendant. Accordingly, the defendant and all others acting for and on their behalf were restrained from using, advertising, directly or indirectly dealing in any goods or services under the defendant's trademark 'WOW'/'WOW PUNJABI'/ or any other trade mark which was identical or deceptively similar to plaintiff's registered trade mark 'WOW'/'WOW! MOMO'/ .

Background

The plaintiff claimed to be registered proprietors of the marks 'WOW'/'WOW! MOMO'/ . The plaintiff submitted that it coined and adopted the trademarks 'WOW!'/'WOW! MOMO' in 2008 for providing products and services in the food industry. The plaintiff's house mark was

'WOW!', which formed the essential and significant feature of all the trademarks and their various marks

The plaintiff's grievance was against a defendant who was running a restaurant/outlet under the trademark ‘WOW’/’WOW PUNJABI’/ . The plaintiff submitted that the defendant had adopted the essential and dominant feature of the plaintiff's trademark, 'WOW', and the trade dress adopted was also identical with a yellow background, font style and the letter "O" filled with red colour.

On 12-12-2023, the plaintiff issued a cease-and-desist notice asking the defendant to restrain themselves from using the trademark 'WOW'/'WOW PUNJABI' or any other trademark deceptively similar to the plaintiff's trademark. A follow-up legal notice was sent on 23-1-2024; however, the defendant did not reply to the said legal notice, and hence, the plaintiff filed the present suit.

Comparison between plaintiff and defendant’s trademarks:

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	PLAINTIFF	DEFENDANT
Trade Marks	WOW! WOW! MOMO	WOW PUNJABI
Point of similarity	• WOW! being the essential dominant feature. • Yellow Background.	• WOW! being the essential dominant feature. • Yellow Background.

Court's analysis and ruling

The Court opined that the plaintiff had made out a prima facie case for the grant of an ex parte ad interim injunction, the balance of convenience lies in favour of the plaintiff, and the plaintiff was likely to suffer irreparable harm in case the injunction was not granted.

Thus, till the next date of hearing, the Court passed an ex parte ad interim injunction against the defendant. Accordingly, the defendant and all others acting for and on their behalf were restrained from using, advertising, directly or indirectly dealing in any goods or services under the defendant's trade mark 'WOW'/'WOW PUNJABI'/ or any other trade mark which was identical or deceptively similar to plaintiff's registered trade mark 'WOW'/'WOW! MOMO'/ .

60. Victory for A.O. Smith Corporation and A.O. Smith India Water Products Pvt. Ltd. in Trademark Dispute

Case: A.O. Smith Corporation and Anr. vs Star Smith Export Pvt. Ltd. And Anr. [I.A. 19011/2022 & I.A. 12253/2023 in CS(COMM) 532/2022]

Forum: Delhi High Court

Judgment Dated: March 22, 2024

Judgment: In a recent trademark dispute before the Delhi High Court, plaintiffs A.O. Smith Corporation and A.O. Smith India Water Products Pvt. Ltd. sought relief against defendants Star Smith Export Pvt. Ltd. The dispute centred around the alleged infringement of the plaintiff's trademark 'A.O. SMITH' by the defendants' use of the marks 'STAR SMITH'/'STARSMITH' / 'BLUE DIAMOND'/ / . The case involved complex arguments and a detailed examination of trademark law, resulting in a ruling in favour of the plaintiffs.

Submissions by Plaintiffs

The plaintiffs, A.O. Smith Corporation, a renowned US-based company, and its Indian subsidiary, A.O. Smith India Water Products Pvt. Ltd., asserted their rights in the mark 'A.O. SMITH', which they have been using internationally since 1874 and in India since 2006. The mark is associated with various products such as geysers, water heaters, purification systems, and boilers. With a substantial turnover of 3.5 billion dollars in 2021 and extensive presence in different Indian cities, the plaintiffs claimed significant goodwill and reputation in their mark.

The plaintiff reiterated the adoption of the mark 'A.O. SMITH' in the 19th century and its launch in India in the 2000s. Plaintiff no.2, the Indian subsidiary, was incorporated in 2006, and plaintiffs entered the Indian Water Heater market in July 2008. Plaintiff no.2 offers for sale its goods and services all over India through its website 'www.aosmith.india.com' and other e-commerce portals.

Its parent website 'www.aosmith.com' was registered in December 1994. Further, the products of plaintiff no.2 are available through large retail stores, including Croma, Vijay Sales, Reliance Digital and others, and it was stressed that the defendants' products are also available at the same stores. It was claimed that a search for 'A.O. SMITH' on popular search engines, such as Google, shows plaintiffs' products as the top result, and even a search for 'SMITH Water Heater' shows results of plaintiffs' products. Therefore, it was contended that 'SMITH' was the dominant aspect of their mark. Attention was drawn to various awards obtained by plaintiffs and registrations of the plaintiffs' marks.

The plaintiff applied the anti-dissection rule; reliance was placed on M/s. South India Beverages Pvt. Ltd. v. General Mills Marketing Inc. & Anr., 2014, to state that a particular element of a composite mark that enjoys greater dominance may be termed a dominant mark. The illustration provided was of the mark 'Golden Deer' wherein the Court held that the expression 'Deer' was arbitrarily adopted by the appellant concerning its product rice, having no connection or correlation and therefore, such arbitrary adoption of a mark relating to a product, with which it has no co-relation, is entitled to a very high degree of protection.

As per the plaintiffs, the mala fide intention of the defendants was evident from reference to a cease-and-desist notice dated 19th April 2022 issued to the defendants, to which a response was received on 21st April 2022. The defendant explained that the trademark 'STAR SMITH' was adopted because 'Smith' is their son's name and that 'SMITH' was a generic name.

As regards the contention of 'SMITH' being a generic name and there being various marks in that regard, it was contended by counsel for the plaintiff that the burden of proof was on the challenger and simply by providing registration details of other marks using 'SMITH', that burden would not be discharged. Reliance was placed on the Decision of Pankaj Goel v. Dabur

India Ltd., 2008 and Dr Reddy's Laboratories Ltd. v. Reddy Pharmaceuticals Ltd., 2004. The fact that the defendants had applied for registration of the mark in July 2020 on a proposed to-be-used basis in class 11 contended that mere application would not give them any right while placing reliance on Automatic Electric Ltd. v. R.K. Dhawan & Anr., 1999.

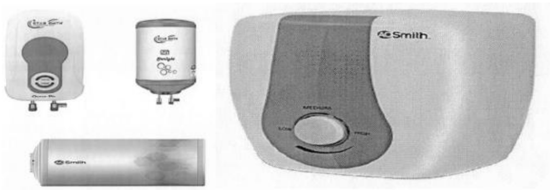
An abstract from the website narrating the company profile of defendants in 'About Us' was cited. It was stated that the defendants had started the Star Smith Export Pvt unit. Ltd.' "after conducting extensive market research and studying foreign technologies." According to the plaintiffs' counsel, this also supported their contention that the defendants had dishonestly adopted the mark.

Submissions by Defendants

The defendants, Star Smith Export Pvt. Ltd., had incorporated a company and filed a trademark application for 'STAR SMITH'/'STARSMITH' in August 2020. They also used the mark 'BLUE DIAMOND' for water heaters. This led to the plaintiffs' initiation of legal proceedings, alleging trademark infringement and seeking an injunction against the defendants' use of the disputed marks.

Defendants contended that plaintiffs were not entitled to an injunction, particularly on reading Sections 15 and 17 of the Trademarks Act, 1999. While Section 17(1) of the Act provided that registration would confer the proprietor rights in using the trademark "taken as a whole", Section 15 of the Act provided that there would be no right in the part of the mark unless registered.

Further, on a comparative analysis of both the marks i.e. , it was pointed out that not only was the look of the marks different, but they also had a different byline ('stronger than trust' used by defendants and 'innovation has a name' used by plaintiffs) and that the name in itself was very different. It was claimed that 'A.O.' was the dominant part of the plaintiffs' mark, not 'SMITH'. Further, the marks were affixed in a very different style, as was evident from the following pictorial representations:



Defendant stated that 'STAR ENTERPRISES' was incorporated in 1990 and manufactured electrical appliances; it was converted into 'AEROSTAR' in 2005 and later into 'STAR SMITH' in 2020. It was clarified that the said mark was not used for water purifiers at that time but for other electrical products like irons, T.V.s and fans. Importantly, it was claimed by the defendants that other entities were using the mark 'SMITH' in classes 7 & 11.

Reliance was placed by the defendant on various decisions, in particular on Phonepe Pvt. Ltd. v. EZY Services & Anr., 2021, where in para 13, the Court had adverted to Section 17(1) of the Act to reiterate that separate parts of the mark when not registered, will not confer an exclusive right on the proprietor of the composite mark; S.M. Dyechem Ltd. v. Cadbury (India) Ltd., (2000), where the Court has noted that plaintiff must prove that the essential features of the mark have been copied. Further, the onus to prove deception was on the plaintiff, and the ascertainment of a critical feature was not determined by an ocular test alone.

Submissions in rejoinder by Plaintiffs

Plaintiffs submitted that S.M. Dyechem (supra) was overruled by Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd., 2001 on the points that firstly, difference in essential features is more relevant; secondly, along with visual representation of the mark, phonetic resemblance is also to be considered; and thirdly, that deceptive similarity and likelihood of confusion is evident from the fact that a search for defendants' mark 'STARSMITH' on e-commerce platforms like Amazon, shows results for plaintiffs' 'A.O. SMITH' water heaters.

Court's Analysis and Decision

After reviewing submissions and evidence presented by the parties, the Court analysed several critical aspects of trademark law. Firstly, it examined the dominance of the 'SMITH' element in the plaintiffs' mark, dismissing the defendants' argument that 'A.O.' was the dominant part. Relying on established legal principles, the Court emphasised the dominant mark rule, which assigns greater prominence to a particular element of a composite mark.

Secondly, the Court scrutinised the defendants' adoption of the mark 'STAR SMITH' in 2020, raising concerns about potential dishonesty and an attempt to capitalise on the plaintiffs' goodwill. This analysis underscored the importance of prior adoption and extensive use in trademark disputes, highlighting the plaintiffs' substantial investment in building their brand reputation.

Furthermore, the Court evaluated relevant provisions of the Trade Marks Act of 1999 and previous judicial decisions to ascertain the principles of deceptive similarity and the likelihood of confusion. It rejected the defendants' arguments related to certain sections of the Act, emphasising the distinctiveness of the 'SMITH' mark and the potential for consumer confusion.

In its final ruling, the Court dismissed the defendants' application under Order XXXIX Rule 4 of CPC and upheld the injunction in favour of the plaintiffs. This Decision reflects the Court's commitment to protecting established trademarks and preventing consumer confusion in the marketplace.

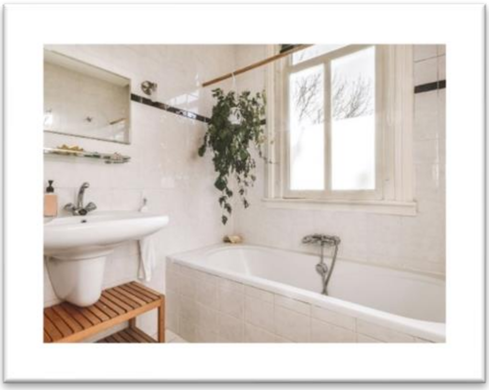
In conclusion, the Court's ruling favouring A.O. Smith Corporation and A.O. Smith India Water Products Pvt. Ltd. highlights the importance of prior usage, the dominance of some aspects in composite marks, and adherence to established principles of trademark law. It serves as a precedent for safeguarding brand reputation and preventing unauthorised use of trademarks in the commercial domain.

61. Registration - Inoculation against Infringement Claims?

Case: Jaquar and Company Private Limited vs Ashirvad Pipes Private Limited [CS(COMM) 670/2023, I.A. 18638/2023]

Forum: Delhi High Court

Judgment Dated: April 1, 2024



Judgment: The Delhi High Court considered and adjudicated on the rather peculiar instance of a registered proprietor alleging infringement by another registered proprietor. The Court considered the admissibility of the claim and decided upon its validity in light of the rights granted under Section 28 and Section 29 of the Trade Marks Act.

Facts:

The Plaintiff, Jaquar & Co Pvt Ltd, being the registered proprietors of ARTIZE and TIAARA (both having device variants), alleged that their marks were infringed by the defendant, Ashirvad Pipes Pvt. Ltd's registered ARTISTRY mark and unregistered TIARA mark. The Plaintiff filed a suit before the Single Judge, praying for an injunction against the Defendant. The Plaintiff had also filed a rectification petition for the removal and cancellation of the Defendant's ARTISTRY mark before filing the suit.

The Plaintiff submitted that they were the prior user of ARTIZE and TIARA since 2008 and 2016 respectively. The Plaintiff alleged that the usage of the impugned marks in allied and cognate goods was an indication of the malafide adoption of the marks by the Defendant. The Plaintiff asserted that the Defendant was intending to create a false association by using the impugned marks.

The Defendant submitted that they were the registered proprietors and, therefore, there can be no claim for infringement, and at most, a claim for passing off could be alleged. They submitted that the mere existence of a prior mark did not ipso facto assume malafide adoption on their part. They relied on the Pianotist test and the judgement in Lakshmandhara to state that a mark must be considered in consonance with all the surrounding factors and that the class of consumers for luxury goods were discerning consumers. They claimed that the petition was not maintainable because the Plaintiff's rectification application was pending and stated that the civil court must find valid grounds to doubt the validity of the mark permitting the Plaintiff to plead infringement.

The Plaintiff replied stating that infringement must be assessed on the basis of initial interest confusion since a consumer must be not seen as though having the opportunity to compare the marks side by side. They further submitted that the judgement in Raj Kumar Prasad allowed for an injunction to be sought against a registered mark if the Plaintiff pleaded invalidity of the Defendant's mark.

The Defendant asserted that the claim for infringement was made on the sole ground of priority of the Plaintiff's mark. They stated that although rectification petitions were filed, the Plaintiff was required to file an application under Section 124 of the Act for the court to find that valid ground exists to challenge the validity of the Defendant's mark, which would, in turn, give way to an allegation of infringement. They stated that since such an application was not filed, the Plaintiff could at most allege passing off.

Analysis of the Case

The Court noted that the validity of the Plaintiff's registration was not a pre-requisite for an infringement claim and that only the requirements under the section needed to be satisfied. The Court caveated the statement by stating that the validity of the Plaintiff's registration was a necessary requirement for obtaining relief against infringement. The Court considered the judgment in Raj Kumar Prasad to understand the legal implications and possibility of a registered mark being infringed by another registered mark. The Court observed that Section 28(3) and Section 124(1), when read together, permitted a suit for infringement against a registered mark. The

Court also noted that they were empowered to grant interlocutory orders in the intermediate period between the filing of the suit and receipt of findings against the validity of the infringing mark.

The Court delved into the similarities between the marks and held that usage of a device does not divert from the phonetic similarities between the words, which are the prominent part of the marks. The Court noted that the arguments on consumers of luxury goods being discerning consumers when the marks were phonetically similar, and the trade dress used had identical colour combinations was deeply flawed and required evidence. The Court stated that a consumer was one of average intelligence and imperfect memory, and therefore, marks must be analysed from this perspective. The Court went on to test initial confusion and held that a consumer does not have the opportunity to compare infringing marks side by side; hence, if, at first glance, a consumer begins to wonder about the probability of an association between the infringing and infringed mark, the deceptive similarity was established.

The Court held that there was deceptive similarity between the marks and that the conditions under Section 29(1) and 29(2)(b) were satisfied. The Court noted that prima facie, there was ample evidence in support of the validity of the Plaintiff's mark, and therefore, the Plaintiff was eligible for relief under Section 28. The Court granted an injunction in favour of the Plaintiff.

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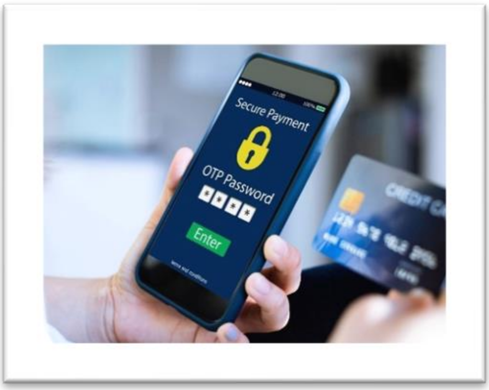
62. Delhi High Court Halts Fraudulent Exploitation: Razorpay vs. Deceptive Associates

Case: Razorpay Software (P) Ltd. v. John Doe [CS(COMM) 269/2024]

Forum: Delhi High Court

Order Dated: April 2, 2024



Order: Plaintiffs alleged that Defendant 1 was perpetrating fraud on the public by creating a false association with them, resulting in grave financial losses to the public. Delhi High Court restrained Defendant 1, and all persons acting on their behalf, from using plaintiffs' trademarks or logos, including, 'RAZORPAY', Razorpay or Razorpay and/or any deceptive variants thereof which were identical and/or similar to plaintiffs' "Razor" trademarks in any manner, thereby amounting to infringement or passing off of plaintiffs' trademarks.

Background

The plaintiffs were payment gateway service providers specialising in developing application programme interfaces for various financial products and other digital financial services, such as payment and payroll processing. Plaintiff 1, Razorpay Software (P) Ltd., was incorporated in 2013, and Plaintiff 2, its group company, was established in 2014. since 2013, plaintiffs have offered a fast, affordable, and secure way for end-to-end online payments under the trademark 'RAZORPAY'.

Plaintiff 2 obtained registrations for the trademarks 'RAZORPAY', 'RAZORPAY X', 'RAZORPAY CAPITAL', Razorpay,

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, , and several other formative variants thereof, in classes 9, 35, 36, 38 and 42, in respect of electronic payment and financial transaction services, design and development of computer hardware, business administration, and telecommunications. Plaintiffs jointly operated the domain name “www.razorpay.com”, which was registered in the name of Plaintiff 2.

In January 2024, plaintiffs received multiple complaints against a financial scam operated by Defendant 1 on the pretext of providing the consumers a job with plaintiffs. As per the account of one of the aggrieved persons, the modus operandi of Defendant 1 was that an unsuspecting consumer was first approached on the WhatsApp platform by Defendant 1, falsely representing themselves as a recruiter of "Razor Company Ltd." and offering a part-time job with the said company for extra income. No such company existed as per the information available on the Ministry of Corporate Affairs website.

During the investigation, plaintiffs received information regarding the operation of the website "https://www.razorrq.vip/" that incorporated 'RAZOR' in the domain name and displayed the trademarks and on the webpage, which was identical/deceptively similar to plaintiffs' 'Razor' marks. The user interface of the plaintiffs' original website was imitated using this domain name. Plaintiffs also found the domain names "https://www.razorrw.vip", "http://razorrm.vip/", and "http://razorrt.vip" with similar design and manner of use of plaintiffs' trademarks. However, the same were currently inoperative.

Analysis, Law, and Decision

The Court opined that prima facie Defendant 1 was unauthorizedly using plaintiffs’ trade mark “RAZORPAY”/ or parts thereof in conjunction with their mark "RAZORPAY" to lure members of the public into remitting significant amounts of money on the pretext of securing a job with plaintiffs and earning returns. Defendant 1 was misrepresenting

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themselves as being employed or associated with plaintiffs and targeting unwary persons.

The Court noted that to render an impression of authenticity, Defendant 1 was also circulating a forged Guarantee Agreement that mentioned plaintiffs' trademarks, trade name, registered address, Corporate Identity Numbers, and signatures of their founder. The impugned domain names, Telegram channels, and WhatsApp accounts used the registered Razor marks without the plaintiff's consent and had even emulated the make and design of the plaintiffs' website, which further accentuated the likelihood of confusion among the target public.

Thus, the Court thus passed the following directions:

- Defendant 1 and all persons acting on their behalf were restrained from using plaintiffs' trademarks or logos, including "RAZORPAY" Razorpay or Razorpay and/or any deceptive variants thereof which were identical and/or similar to plaintiffs' "Razor" trademarks in any manner, thereby amounting to infringement or passing off of plaintiffs' trademarks.
- Defendants 2 to 5 Domain Name Registrars were directed to block/suspend access to the respective domain names.
- Defendant 7, Meta Platforms INC, was directed to block/remove the Facebook pages available at various URLs.
- Defendants 9 and 10, Ministry of Electronics and Information Technology and Department of Telecommunications and Ministry of Communications and Information Technology, respectively, were directed to issue necessary directions to the telecom service providers and internet service providers to block websites hosted on the impugned domain names.
- Defendant 6, WhatsApp LLC, and Defendant 8, Telegram FZ-LLC, were directed to block/delete unauthorised WhatsApp accounts and Telegram channels/groups, respectively.

63. Use of Identical Mark by Subsequent Registered Proprietor is Passing-Off

Case: M/s P M Diesels Pvt Ltd vs M/s Thukral Mechanical Works & Others [C.O. (COMM.IPD-TM) 667/202]

Forum: Delhi High Court

Order Dated: April 2, 2024

Order: Recently, the Delhi High Court disposed of two civil suits, one rectification petition and 10 writ petitions against the trademark registrations filed by PM Diesels for registering the mark FIELDMARSHAL in 10 Indian languages. In a dispute that had been simmering for the past 40 years, the earliest suit filed with respect to the disputed trademark "FIELDMARSHAL" was instituted vide suit no. 2408/1985 titled M/s P M Diesels Pvt Ltd vs M/s Thukral Mechanical Works. Thereafter, cross-suits were filed, and multiple proceedings were initiated over the years to claim ownership of the trademark FIELDMARSHAL.

Background

The earliest registration of the word mark FIELDMARSHAL in favour of the plaintiff is vide Registration no. 224879 dated 16th October 1964. P M Diesels claims continuous use since May 1963. In 1982, the Plaintiff company M/s P M Diesels Pvt Ltd had filed for registration of the trademark FIELDMARSHAL as a word mark, a logo containing the alphabets FM and as a stylised mark which was duly advertised in the trademark journal in May 1982 mentioning description of goods as Diesel engines not used in land vehicles and parts thereof, including electric motors and pumps included in class 7 and claimed continuous use since 1965. The plaintiff furnished numerous documents to substantiate these claims.

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The plaintiff learned of using the mark FIELDMARSHAL in 1982 and sent a cease-and-desist notice to the defendant. However, as the defendant continued to use the mark, the plaintiff eventually instituted suit no. 2408/1985 titled M/s P M Diesels Pvt Ltd vs M/s Thukral Mechanical Works against the defendant to assert their right over the mark FIELDMARSHAL.

In the meantime, the defendant vide Assignment deed dated 30th May 1986 obtained the mark FIELDMARSHAL, which was earlier registered by M/s Jain Industries on 13th May 1965 with a user claim since January 1963, i.e. prior to the date of use claimed by PM Diesels. Based on this assignment, the name of Thukral Mechanical Works was recorded as the lawful owner of the mark FIELDMARSHAL in the records of the Trademark Registry and was upheld by the Registrar of Trademarks, the courts and IPAB in subsequent proceedings over the years.

The plaintiff moved a cancellation petition to remove the defendant's marks on the grounds that the defendant cannot prove the use of the mark since 1963 while the plaintiff has evidence to demonstrate continuous use. The mark FIELDMARSHAL may have been registered by Jain Industries but was not used, and the company was defunct. The purchase of the mark by the defendant was motivated by the intent to claim the use of FIELDMARSHAL to benefit from the goodwill and reputation that the mark had in the market by the continuous efforts of the plaintiff since 1963. The plaintiff was aggrieved when the defendant also opposed the applications for registration of FIELDMARSHAL in Indian languages.

Analysis of the Case

All the above writ petitions, civil suits, and rectification petition were disposed of by the Delhi High Court by order dated 2nd April 2024 to resolve the long-standing dispute between the parties. The learned Judge examined all the evidence on record and summarised the stand of the parties in her judgement to clarify that while the defendant had purchased the mark from the erstwhile registered owner, Jain Industries, in effect, the defendant had failed to establish continuous use of the mark FIELDMARSHAL before 1988.

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On the contrary, the evidence on record clearly shows the use of the mark by the plaintiff since the 1960s. Numerous extracts of advertisements from leading newspapers in regional languages and invoices from different dealers, manufacturers, distributors, etc., established extensive continuous use of the mark by the plaintiff concerning centrifugal pumps and diesel engines. Thus, the argument given by the defendant that the plaintiff's use of the mark FIELDMARSHAL is limited only to diesel engines does not stand scrutiny.

Further, the defendant has admitted that they have no documentary evidence to substantiate the use of the mark by their predecessor in interest, M/s Jain Industries, who were primarily a dal and flour mill and not into the manufacture or sale of centrifugal pumps. The name FIELDMARSHAL is mentioned only at the base of one flour mill machine and does not suggest that the machine itself was being sold. The evidence on record also suggests that while the defendant was selling centrifugal pumps, the use of the name FIELDMARSHAL was not found on any documents before the 1980s that show names such as Varun, BMS or DPF, which was also substantiated by dealers, distributors and agents operating in the market.

The plaintiff learned of the alleged existence of duplicate centrifugal pumps under their brand name in the early 1980s and initiated requisite legal action. As such, despite some unsubstantiated claims by both parties, the plaintiff cannot be said to have acquiesced to a willingness to co-exist with the defendant. Moreover, after the plaintiff filed the case to stop passing off duplicate FIELDMARSHAL centrifugal pumps, the defendant approached the proprietors of M/s Jain Industries in 1986, which was defunct and purchased the trademark as per the assignment deed dated 30th May 1986. Since the mark was not being used by Jain Industries, the argument of continuous use cannot be accepted.

The plaintiff has successfully established consistent prior use of the mark with substantial exports to countries like Sudan, Iraq, Iran, Syria, Thailand, West Germany, etc., as well as domestic sales, as evidenced by the statements of accounts and advertisements in several languages, such as Tamil, Telugu, Urdu, Punjabi, Bengali, and English, in addition to brochures from the 1970s depicting FIELDMARSHAL centrifugal pumps.

Since the initial suit filed by the plaintiff was for passing off, the concept of cognate and allied goods is ingrained in it, even if the words are not expressly mentioned. The farmer who purchases the FIELDMARSHAL brand of diesel engine and centrifugal pumps is likely to assume the submersible pump or other allied goods are also manufactured by PM Diesel since not just the class of products but the trade channels and the end user are also identical.

Moreover, the learned single Judge also took note of the fact that the defendant had filed an application for registration of the mark FIELDMARSHAL in 1983 for centrifugal pumps, which they eventually withdrew in 1987 as they could not furnish sufficient documentary evidence of use and the mark was being opposed by the plaintiff.

Thus, having pursued the matter for 40 years, the plaintiff can in no way be said to be guilty of delay, laches, or acquiescence as it has diligently pursued several legal proceedings that include oppositions, rectifications, cancellation petitions, suits for passing off, writ petitions, etc.

Moreover, mere registration of the mark by Jain Industries without use does not create goodwill in their favour. The goodwill is generated by extensive continuous use, as demonstrated by the plaintiff. Reliance was placed on the decision of the Supreme Court in N.R. Dongre vs Whirlpool (1996) 5 SCC 714 and Neon Laboratories vs Medical Technologies Ltd (2015) 10 SCR 684, wherein it was held that the use of an identical mark by a subsequent registered proprietor would still constitute passing off. The adoption of the mark FIELDMARSHAL by the defendant is, therefore, not honest concurrent use, and in fact, the timing of the assignment of the mark by Jain Industries itself creates doubt regarding the intention of the defendant.

Decision of the Court

Based on the foregoing analysis, a permanent injunction was granted against the defendant for using the mark FIELDMARSHAL, and the cross-suit filed by the defendant was dismissed. The registration of the mark FIELDMARSHAL bearing no. 228867 dated 13th May 1965 in class 7, which the defendant has obtained by assignment from Jain Industries, was ordered to be cancelled and removed from the register of trademarks. All the ten writ petitions filed by PM Diesel against the defendant for registering their mark in regional languages were also allowed, with instructions from the trademark registry to issue registration certificates to the plaintiff within one month of the date of the order. The court also recognised the substantial cost incurred by the plaintiff in this prolonged legal battle and granted the actual cost of litigation to be paid to the plaintiff by the defendant.

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64. Protecting Intellectual Property in the Fashion Industry

Case: M/S Reflect Sculpt Private Ltd. & Anr vs Abdus Salam Khan [CS(COMM) 278/2024]

Forum: Delhi High Court

Order Dated: April 03, 2024

Order: In a recent ruling by the Delhi High Court over an injunction application filed by Plaintiffs against the Defendant, infringement of their intellectual property rights in the fashion industry was alleged. Under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, the Court granted an ex-parte ad-interim injunction in favour of the Plaintiffs, restraining the Defendant from manufacturing, selling, advertising, or promoting counterfeit garments, which were deemed to be replicas or substantial imitations of the Plaintiffs' original artistic works.

Plaintiff No. 2, Gaurav Gupta, a renowned international fashion designer known for his distinctive sculpture-like garments, embroidery techniques, and unique draping styles, began his career 18 years ago after studying at a prestigious art institute in London. He holds copyright in his sketches, which serve as the basis for the handcrafted garments produced by Reflect Sculpt Private Ltd. Plaintiff No. 2 also holds exclusive publicity rights for his name 'GAURAV GUPTA' and has applied for trademark registration. The Plaintiffs, through significant marketing efforts, have established a strong reputation for their designs, which prestigious platforms and celebrities like Beyonce and Aishwarya Rai Bachchan have endorsed.

The Plaintiffs alleged that the Defendant is manufacturing and selling counterfeit garments, replicating the Plaintiffs' unique designs under the name 'Designer Salam Studio.' Defendant's activities extend to social media, including YouTube and Instagram, where he promotes his products using Plaintiff's mark 'GAURAV GUPTA'. This infringement on the Plaintiffs' copyrights, registered designs, and trademark rights has led to filing the present suit to safeguard their statutory rights.

Court's Observations and Ruling

Upon considering the submissions made by the Plaintiffs, the Court noted the striking similarities between the Defendant's products and the Plaintiffs' original designs. It found that the Defendant's actions constituted a blatant replication of the Plaintiffs' artistic works, thereby infringing their copyrights and registered designs. Additionally, the Court deemed the Defendant's use of the Plaintiff's trademark 'GAURAV GUPTA' in advertisements an infringement under the Trade Marks Act.

In light of the prima facie case made by the Plaintiffs, the Court granted an ex-parte ad interim injunction to prevent further harm to the Plaintiffs' interests. The injunction restrained Defendant from manufacturing, advertising, or selling counterfeit garments resembling Plaintiff's designs. Furthermore, the Defendant was prohibited from using the Plaintiffs' trademark in any promotional activities.

To preserve evidence of infringement, the Court appointed Mr Rakesh Kumar Sharma as the Local Commissioner to visit the Defendant's premises and seize any impugned products. The Local Commissioner was tasked with conducting a search, seizure, and inventory of infringing materials, with assistance from the Plaintiffs and their counsel.

Conclusion

The Court's order signifies a robust protection of intellectual property rights in the fashion industry. By granting the injunction and appointing a Local Commissioner, the Court has taken decisive steps to safeguard the Plaintiffs' creative works and trademarks from unauthorised use and exploitation. This ruling underscores the importance of upholding intellectual property laws to foster innovation and creativity in the fashion sector.

65. Kubota Corporation vs. Kaira Agros - A Case of Trademark Infringement and Passing Off

Case: Kubota Corporation vs Kaira Agros & Ors [CS(COMM) 273/2024]

Forum: Delhi High Court

Order Dated: April 03, 2024

Order: The Plaintiff, Kubota Corporation, was founded in 1890 and is now headquartered in Japan. The Plaintiff is engaged in manufacturing, distributing, and selling various goods, including, inter alia, agriculture goods—such as cultivator machines for rice cultivation—and construction equipment—such as power shovels for construction purposes.

Plaintiff has been using several logos and trademarks for their products; over the years, Plaintiff's products have gained enormous reputation and goodwill globally, and Plaintiff has steadily expanded their global operations. In 2012, they established the "Kubota Identity", a global corporate principle, and adopted a new brand statement logo/ trademark For Earth, For Life Kubota. Furthermore, Plaintiff secured several registrations in India under the Trade Marks Act, 1999.

The Plaintiff's Indian subsidiary, founded in 2008 as Kubota Agricultural Machinery India Pvt. Ltd. (KAI), has emerged as a major player in the Indian agricultural machinery industry. KAI has launched several products, such as tractors, rice transplanters, combine harvesters, power tillers, and implements and attachments. The Plaintiff asserted that they have copyright concerning the product catalogues, drawings, and images of these products.

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Defendant No. 1-Kaira Agros, through its proprietor – Mr. Rajagopal Vasantha (Defendant No. 2), is engaged in similar goods, business and services as that of Plaintiff, i.e., manufacturing of farming and agricultural equipment such as rice transplanters, harvesters, etc. Defendant No. 2, a former employee of Plaintiff, is alleged to have dishonestly connived with Defendant No. 1 and misused Plaintiff's confidential information, including but not limited to the industrial drawings of Plaintiff's agricultural equipment/ machinery, such as rice transplanters.

Submission by Plaintiff:

Plaintiff submitted the Defendants' use of the trademark ‘ ’, comprising of the tagline "For Nature, For Future" placed along with the Defendants' mark ‘Kaira’, is deceptively similar to the Plaintiff's trademark ‘ ’ and is highly likely to create confusion, thus amounting to infringement. While Plaintiff has no objection to the Defendants' use of their trademark/ tradename ‘Kaira’, however, Plaintiff's grievance pertains to the tagline "For Nature, For Future', which is deceptively similar to the Plaintiff's tagline, "For Earth, For Life". Furthermore, the deceptive similarity between the two marks is accentuated by the use of a similar tagline in conjunction with the Defendants' mark 'Kaira', which deploys a similar colour combination and placement of the elements. Such stark resemblances between the two marks risk causing confusion among consumers and within trade circles, potentially leading to erroneous beliefs of association with Plaintiff's brand. This constitutes an infringement of the Plaintiff's registered mark. To demonstrate the deceptive and conceptual similarities between the two competing marks, reliance is placed on the following comparison chart:

Plaintiff Company's Trademark	Defendant No.1's Impugned Mark
For Earth, For Life Kubota	For Nature, For Future Kaira

The Plaintiff stated that the Defendants' device mark ' 

', embossed on Defendant No. 1's combine harvester, is deceptively similar to the Plaintiff's trademark ' 

'. The Defendants' use of a similar colour scheme and an overlapping 'tick' mark clearly evidences dishonesty on the part of Defendant No. 1. Because these marks are used in respect of an identical category of goods, such use amounts to an act of passing off. A side-by-side comparison of the marks is represented as follows:

Plaintiff Company's Trademark	Defendant No.1's Impugned Trademark
	

Plaintiff further submitted that Defendant No. 1's product catalogue accompanying their rice transplanter, when compared to Plaintiff's, is a blatant imitation and an exact replica. It was further submitted that Defendant No. 1's intent to pass off their products as that of the Plaintiff is also evident from the fact that Defendant No. 1 has represented images of the Plaintiff Company's Ride-On rice transplanter of the Plaintiff company on their Indiamart page as well as on their website, which also amounts to infringement of the Plaintiff's copyright in the image of their Ride-On rice transplanter.

Moreover, Defendant No. 1's website and Indiamart page also depict Plaintiff's trademark/ trade name 'Kubota', further corroborating Plaintiff's infringement and passing off claims. In support of the aforenoted submissions, reliance is placed on screenshots of Defendant No. 1's website and Indiamart page.

Based on the various aforenoted acts of infringement and passing off, Plaintiff asserted that the Defendants have clearly attempted to ride upon Plaintiff's well-established goodwill and reputation. He argued that the manner of infringement and passing off, as elaborated above, is clearly indicative that Defendant No. 2, a former employee of Plaintiff, had access to the confidential information of Plaintiff, which they have now utilised for the manufacture of lookalike products. Such duplication could not have been possible without access to the confidential information comprising of the Plaintiff's drawings of the products in question. Defendants are thus guilty of infringement under Sections 29(4) and 29(2)(c) of the TM Act, infringement under Section 55 of the Copyright Act, 1957, and passing off.

Court's Analysis and Ruling

The Court considered the Plaintiff's contentions and stated that the marks For Earth, For Life Kubota a For Nature, For Future Kaira re prima facie deceptively similar, emphasising ecological responsibility and a commitment to a better future. Their parallel structure and interchangeable terms could lead to consumer confusion, especially given their shared industries. Since the Plaintiff's mark is registered, the Defendants' use of the impugned mark amounts to infringement.

Similarly, the marks HARVESKING CONTRAC KING employ a similar stylised font and colour scheme, increasing the likelihood of confusion among consumers. The suffix "KING" in both marks could imply

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a relationship between the brands, constituting misrepresentation likely to harm the Plaintiff. Therefore, the Defendants' use of the impugned mark prima facie amounts to passing off. Additionally, the Plaintiff has demonstrated copyright breach in their photographs and catalogues.

The Court concluded that the Plaintiff has made out a prima facie case in their favour, with failure to grant an ex-parte ad-interim injunction resulting in irreparable loss to the Plaintiff and the balance of convenience favouring them over the Defendants.

Thus, the Court granted an ex-parte ad-interim injunction in favour of the Plaintiff until the next hearing under the following terms:

- The Court restrained the defendants from using the tagline 'For Nature, For Future' and the impugned device mark. However, they may use the mark 'Kiara' as a standalone.
- The Court further restrained the defendants from using any word mark, trademark, or label identical or deceptively similar to the Plaintiff's trademark 'Kubota' about combined harvesters.
- The Defendants were further directed to immediately remove any reference to the Plaintiff's trademark 'Kubota' from their website, Indiamart page, and any other promotional material.
- Defendants were restrained from using images of the Plaintiff's products and specified catalogues in relation to their goods.

The Court further appointed a Local Commissioner to visit the Defendants' premises, seize infringing materials, and conduct photography/videography. The Plaintiffs will bear the Local Commissioner's fee and related expenses. The Local Commissioner must file a report within four weeks.

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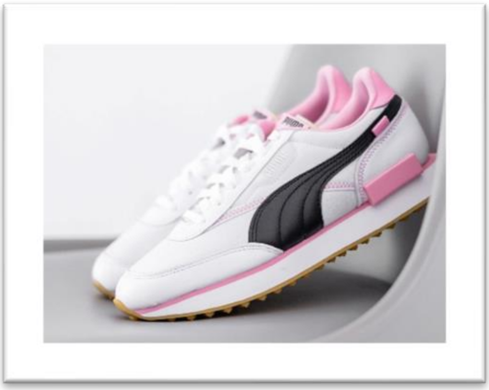
66. Understanding the Legal Battle: Puma SE vs Ashok Kumar Trading As R.K. Industries

Case: Puma SE vs Ashok Kumar Trading as R.K. Industries [CS(COMM) 616/2022]

Forum: Delhi High Court

Order Dated: April 04, 2024



Order: In the realm of trademark infringement and legal battles, the case of Puma SE versus Ashok Kumar Trading as R.K. Industries stands as a testament to the importance of protecting intellectual property rights. This article delves into the key aspects of the judgment delivered by the Delhi High Court on April 04, 2024, shedding light on the facts, issues, arguments, legal analysis, and precedent considerations involved.

The case between Puma SE, a German company, and Ashok Kumar, trading as 'R.K Industries', serves as a quintessential example of trademark infringement and the subsequent legal recourse sought by the aggrieved party. Puma SE, a stalwart in the realm of sports apparel and footwear, initiated legal proceedings against the defendant, alleging infringement of its well-established trademark 'PUMA' and associated logos.

Puma SE, a global entity with over 70 years of history, boasts a significant presence in the sports apparel market, catering to athletes and enthusiasts alike. The 'PUMA' brand, coined in 1948, has garnered widespread recognition and endorsement from renowned personalities such as Pele and Diego Maradona, further solidifying its stature as a premier sports brand. With operations spanning more than 20 countries and a workforce exceeding 10,000 employees, Puma SE's global sales for the year 2019 surpassed 5500 million euros, underlining its formidable market position.

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The legal foundation of Puma SE's claim lies in its extensive trademark registrations, including the earliest registration in India dating back to 1977. The 'PUMA' mark, along with its variants and associated logos, enjoys protection across various classes, including class 18 for leather articles and class 25 for clothing and footwear, further fortifying the statutory rights associated with the mark.

The crux of the matter revolves around the defendant's alleged production and sale of counterfeit products bearing Puma's trademarks. A field investigation conducted by the plaintiff revealed the defendant's illicit activities, wherein counterfeit garments, including t-shirts and track pants emblazoned with the 'PUMA' mark and leaping cat device, were being manufactured and distributed. Affidavit evidence provided by the plaintiff's brand protection manager substantiated the counterfeit nature of the products through a sample purchase and subsequent analysis, highlighting discrepancies in design and labelling inconsistent with genuine Puma merchandise.

Upon scrutiny of the physical products and supporting documentation, the Court concluded that the defendant's products were indeed counterfeit, lacking essential labelling information and packaging standards synonymous with authentic Puma products. This prima facie evidence bolstered the plaintiff's case for granting an ex-parte ad interim injunction, aiming to halt further infringement and mitigate the damage to Puma SE's goodwill and financial interests.

The defendant's failure to respond to the summons and file a written statement compounded the legal complexities, leading the plaintiff to seek a decree under Order VIII Rule 10 and Order XIIIA of the Code of Civil Procedure.

Despite being served through substituted service, the defendant failed to appear or defend the case. The plaintiff provided evidence through affidavits and physical examination of the counterfeit products, demonstrating the defendant's infringement of Puma's trademarks.

The Court meticulously analysed the legal principles governing trademark infringement, emphasising the significance of protecting intellectual property rights. It referred to previous judgments to establish the standards for granting damages and injunctions in cases of trademark infringement. The Court highlighted the distinction between first-time infringers and repeated infringers, outlining the corresponding remedies and damages.

The bench of Justice Anish Dayal referenced several precedents, including Koninlijke Philips and ors v. Amazestore, Puma SE v. Ashok Kumar (2023 SCC OnLine Del 6764) and Hindustan Unilever Limited v. Reckitt Benckiser India Limited (2014 SCC OnLine Del 490), to elucidate the principles governing damages, injunctions, and punitive measures in trademark infringement cases.

The significance of this case extends beyond the immediate legal dispute, shedding light on the pervasive issue of trademark infringement in today's market landscape. It underscores the imperative for robust enforcement mechanisms and proactive measures to safeguard intellectual property rights, not only for established brands like Puma SE but also for fostering a fair and competitive business environment.

Moving forward, the judgment rendered in favour of Puma SE sets a precedent for stringent enforcement of trademark laws, emphasising the judiciary's commitment to upholding the rule of law and protecting the interests of rights holders. It serves as a deterrent against unlawful activities that undermine the integrity of well-known brands and reaffirms the value of intellectual property as a cornerstone of innovation and economic growth.

In conclusion, the case epitomises the challenges and consequences associated with trademark infringement while underscoring the necessity for vigilance and accountability in preserving the integrity of iconic brands like Puma. As businesses navigate an increasingly globalised marketplace, adherence to trademark laws and ethical business practices remains paramount to fostering trust, innovation, and sustainable growth in the competitive arena of sports apparel and beyond.

67. Striking a Balance: Delhi High Court's Stance on Discovery in Trademark Litigation

Case: Rajesh Jain v. Amit Jain & Another [CS(COMM) 838/2016]

Forum: Delhi High Court

Order Dated: April 4, 2024

Order: In a recent case before the High Court of Delhi at New Delhi, a significant ruling was made in the matter of CS(COMM) 838/2016, where the Plaintiff filed an appeal against the order dated February 20, 2024, which denied their application seeking discovery and production of documents from the Defendants. The Plaintiff contended that the documents in question were crucial for establishing the Defendants' defence regarding the reputation and goodwill of their trademark in question.

The Plaintiff argued vehemently against the finding of the Joint Registrar, contending that the absence of supporting documents in the Defendants' written statement warranted the Plaintiff's right to seek discovery. He relied on the precedent set by the judgment in Shri M.L. Sethi v. Shri R.P. Kapur to assert that the relevance of documents should be assessed based on their ability to shed light on the controversial matter.

However, despite the Plaintiff's arguments, the Court remained unconvinced. The Court clarified that the Defendants have the burden of proof to establish their defence, and the absence of documentary evidence places this burden squarely on them. As the Plaintiff's suit was for trademark infringement and passing off, the burden of proof to establish infringement and passing off rested with them, as per Section 101 of the Evidence Act.

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The Court highlighted the principles guiding the decision-making process in such cases, emphasising that the documents sought must be necessary and relevant to the suit's stage. The Joint Registrar's decision underscored the importance of considering the stage of proceedings and the relevance of documents to the matter in controversy. It was noted that the Plaintiff's application sought documents primarily to counter the Defendants' earlier plea, which had already been decided years ago.

Given these considerations, the Court found no grounds to interfere with the Joint Registrar's decision. However, it affirmed the Plaintiff's right to utilise the absence of documents to support their contentions at the appropriate stage of the proceedings.

In conclusion, the judgment clarified the principles governing the discovery and production of documents in legal proceedings, emphasising the necessity for relevance and timeliness. While the Plaintiff's appeal was disposed of, the ruling reaffirmed the parties' rights and obligations in establishing their respective cases before the Court.

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68. The Legacy of AMUL: A High Court Decision

Case: Kaira District Cooperative Milk Producers Union Ltd. & Anr. v. D N Bahri Trading as the Veldon Chemical and Food Product & Anr. [C.O. (COMM.IPD-TM) 165/2023 & I.A. 11129/2023]

Forum: Delhi High Court

Order Date: April 08, 2024

Order: Recently, the Delhi High Court decided a rectification petition filed under Sections 47 and 57 of the Trade Marks Act, 1999, by the society Kaira District Cooperative Milk Producers Union Ltd. The Court stated that the trademark 'AMUL' has acquired huge significance and that its protection would transcend all classes, having been declared a well-known mark.

Brief Facts

The rectification petition was filed under Sections 47 and 57 of the Trade Marks Act, 1999 by the petitioner society against the respondent, i.e., D N Bahri Trading, seeking rectification of the Register of Trade Marks by removing the respondent's registered trademark. The petitioner claimed rights in the trademark 'AMUL' in the word mark and various other device marks and formative marks. It further claimed that it is a well-known trademark, as it was declared in 2011.

In view of the above facts, the High Court noted, "To seek rectification of a mark, the petitioner must be able to show that any of the grounds under Sections 9, 11, 47 or 57 of the Act are made out. Without having to draw a comparison with an earlier registered mark, grounds under Sections 9 and 47 of the Act are available to a petitioner to claim that the impugned mark ought not to have been registered on absolute grounds and, if registered, can be removed for reason of non-use. In this case, it is striking that respondent

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no.1 has produced no document whatsoever which would prove their use since 1957, as claimed."

The Court added that there is not a sliver of documentation, photograph, advertisement, invoice, or other visual or documentary proof to support their assertion that they were indeed using the said mark on some goods.

"Notwithstanding the above, the rectification petition must also be assessed based on other grounds. It would be difficult not to acknowledge, countenance and recognise the huge, significant, unique reputation, goodwill and continuous use that the petitioner has in the trademark 'AMUL'. Not only is the coined word 'AMUL' distinctive for the acronym for Anand Milk Union Ltd. but also has been recognised as a well-known trademark in 2011, therefore getting protection across all classes", it observed.

Furthermore, the Court noted that the word 'AMUL' had been registered since 1956 in other classes, as well as various families of marks, both word and device, in relation to 'AMUL'.

"Regarding respondent no.1's contention of different goods, this Court does not find any merit in the said submission for the reason that the category of goods in which impugned mark has been registered includes mineral and aerated water and other non-alcoholic drinks along with fruit drinks and fruit juices. The AMUL range of products is large and expansive, and as shown by petitioner’s counsel, includes the ‘AMUL tru’ drinks as well, aside from other drinks”, it said. Accordingly, the High Court allowed the rectification petition.

69. Preserving Trademark Integrity: Delhi High Court's Landmark Ruling in Crocs Inc. vs. Registrar of Trademarks

Case: Crocs Inc vs The Registrar of Trademarks New Delhi & Anr [C.O. (COMM.IPD-TM) 779/2022 & I.A. 20390/2022]

Forum: Delhi High Court

Order Dated: April 08, 2024

Order: In a recent development on April 8th, 2024, in the case of *Crocs Inc. vs. the Registrar of Trademarks New Delhi & Anr. C.O. (COMM.IPD-TM) 779/2022 & I.A. 20390/2022*, the Delhi High Court granted rectification in favour of *Crocs Inc*. The Plaintiff diligently filed a rectification/cancellation petition under Sections 47 and 57 of the Trade Marks Act, 1999, seeking the removal of the trademark **'CROCKSCLUB'** in class 25 registered in favour of the respondent.

As far as the factual matrix goes, despite persistent and repeated attempts to serve notice on the respondent, including service on their trademark agent, no appearance before the Court has been made on behalf of the respondent. With no challenge to the petitioner's case, the Court was left to evaluate it solely on the substantial evidence provided. The petitioner's counsel emphasised the registration of the mark 'CROCS' in different forms, such as words, designs, and shapes, including registration in class 25, which solidified their argument.

The Plaintiff's counsel also presented evidence, including invoices dating back to 2007, demonstrating substantial sales of the petitioner's products, particularly footwear, across multiple locations in India, articles and online presence showing reputation and goodwill or registration of their domain name since 1996. The petitioner showcased the use of the trademark 'CROCS CLUB' in conjunction with their product, Crocs Footwear, with accompanying visual evidence. Additionally, the use of 'CROCS CLUB' on prominent social media platforms like Facebook and Instagram.

The Court acknowledged previous cases where rectification was granted in favour of the petitioner when the respondent didn't appear. The petitioner based their arguments on Sections 11(1), 47, and 57 of the Act, focusing on the lack of use of the impugned trademark by the respondent and the similarity between the marks. Given the well-established reputation of the petitioner's 'CROCS' products and the resemblance between the marks, the Court, in light of the evidence provided, ordered the removal of the 'CROCKSCLUB' trademark from the Register of Trade Marks. The Registrar of Trade Marks was directed to execute the removal within six weeks from the date of the order. This court decision represents a significant triumph for the petitioner, affirming their legal entitlements and emphasising the critical importance of safeguarding their brand from potential confusion or association with similar trademarks.

The High Court of Delhi's decision in the case of Crocs Inc. vs. Registrar of Trademarks exemplifies a balanced approach to rectifying trademark registrations to safeguard against dilution and misrepresentation in the marketplace. It reflects a commitment to upholding the principles of fairness, equity, and protection of intellectual property rights in commercial disputes.

70. Dominos IP Holder LLC & Anr v. M/S Domino Pizza & Ors

Case: Dominos IP Holder LLC & Anr v. M/S Domino Pizza & Ors [CS(COMM) 303/2024, I.A. 8133/2024]

Forum: Delhi High Court

Order Dated: April 09, 2024

Order: In the ever-evolving landscape of intellectual property rights, clashes over trademarks are not uncommon. One such clash that has garnered attention is the legal battle between Dominos IP Holder LLC & Anr and M/S Domino Pizza & Ors. This case, currently unfolding in the halls of justice, pits two giants in the pizza industry against each other, raising crucial questions about brand identity, market competition, and the protection of intellectual property.

The Background

Dominos IP Holder LLC (**Plaintiff 1**), a heavyweight in the global pizza arena, has diligently cultivated its brand since 1996 in India, crafting a reputation synonymous with quality and reliability. Teamed up with Jubilant Food Works Limited (**Plaintiff 2**), the company has solidified its position as a market leader, serving up piping-hot pizzas to discerning tastes worldwide. On the other side of the legal battlefield stands M/S Domino Pizza & Orson Wells (**Defendant 1**), a newer entrant with its own vision for capturing a slice of the pizza pie market.

At the heart of the dispute lies the contention over trademark infringement and unfair competition. Dominos IP Holder LLC alleges that M/S Domino Pizza & Orson Wells has engaged in practices that not only mimic their

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branding but also create confusion among consumers. The Plaintiff contends that Dominick Pizza not only used the name "DOMINICK PIZZA" but also replicated the Plaintiff's registered trademarks, specifically "CHEESE BURST" and "PASTA ITLAIANO," for their own food offerings, thus faces accusations of capitalising on the goodwill and reputation built by Dominos over the years.

The pre-litigation mediation was also attempted by the Plaintiffs on **4 April 2022,** which had to be closed as a non-starter as Defendant 1 failed to attend the mediation sessions. However, as a consequence thereon, Defendant 1's website, www.dominickpizza.com, was pulled down. In these circumstances, the plaintiffs were under the impression that Defendant 1 was discontinuing its activities.

It was only in June/July 2022 that the Plaintiffs came to know that Defendant 1 was continuing its activities over the online food ordering platform Zomato. The plaintiffs have also placed on record a complaint by a customer, Nitin Warikoo, on Google reviews, on which the customer complained of having been confused between Defendant 1 and the Plaintiffs because of the use of a deceptively similar name. As a result, the Plaintiffs have filed a suit seeking permanent injunctions and damages.

On August 29, 2022, the Court granted an ex-parte interim injunction against Defendant 1, thereby quickly stopping them from using the disputed trademarks and logos, emphasising the possible damage to Respondent's brand reputation. Defendant 2, GoDaddy, being the Domain Name Registrar of www.dominickpizza.com and www.dominickpizzas.com was also directed to block/suspend the said domain names. The Defendants, seemingly aware of the compelling evidence against them, opted not to attend the court proceedings. Considering the lack of cooperation, the Plaintiffs requested a summary judgment to streamline the legal process and save the court's resources.

Delhi High Court's Insightful Observation

The Delhi High Court, in its comprehensive judgement, thoroughly examined the evidence and legal precedents. Relying on the landmark case of ***Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*** and ***K.R. Chinna Krishna Chettiar v. Shri Ambal and Co,*** the court emphasised that when the similarity between marks is evident, no further evidence is required to establish infringement.

The court examined the potential by citing the Pianotist Test for confusion arising from Dominick Pizza's utilisation of trademarks such as "CHEESE BURST" and "PASTA ITALIANO." Although there are some slight differences, the general impression of these marks is remarkably similar to Domino's trademarks. This could potentially confuse consumers and pose a real risk. The court found that the Defendants deliberately chose the mark "DOMINICK," which clearly demonstrated bad faith to free ride on the already established Dominos. This historical reference was seen as a smart move to link the infringing entity with the well-known and respected Domino's brand, which helped to make the case against Dominick Pizza even stronger.

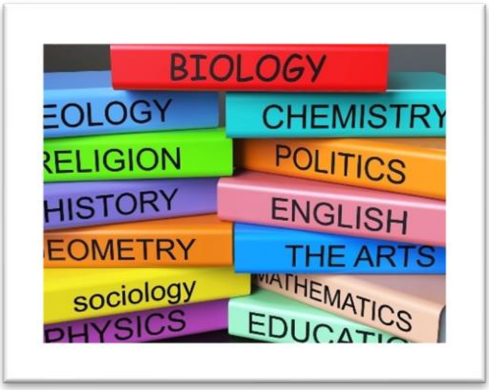
The court issued a permanent injunction against Dominick Pizza, prohibiting them from using the infringing marks in a range of activities such as advertising, selling, marketing, and any use in packaging, menu cards, and advertising materials. This extensive injunction was designed to safeguard the interests of Domino's and avoid any additional confusion among consumers. The court ruled that Defendant 1 must pay the significant litigation costs of ₹6,57,564.20, emphasising the seriousness of the infringement.

71. Rachna Sagar Pvt Ltd vs Sovereign Mercantile Pvt Ltd & Ors: Trademark Dispute Analysis

Case: Rachna Sagar Pvt Ltd vs Sovereign Mercantile Pvt Ltd & Ors [C.S. (COMM) 304/2023]

Forum: Delhi High Court

Order Dated: April 9, 2024



Order: This case was filed by the Plaintiff seeking inter-alia permanent injunction restraining the Defendant Nos. 1-3 from passing off the trademark "RACHNA SAGAR" and their device mark " ". In I. A 9200/2023, upon finding a prima facie case, the court vide order dated May 12, 2023, granted an ex-parte ad-interim injunction in favour of the Plaintiff restraining Defendants No.1 and their directors (including Defendants No.2-3) from using the marks "RACHNA SAGAR"/" ". Defendants No1-3 have filed I.A. 17021/2023 seeking vacation of the ad-interim ex-parte injunction order.

Plaintiff's Contentions

The Plaintiff was incorporated as a company on January 1, 1996, and is now engaged in publishing school textbooks. Plaintiff conceived and adopted the tradename/ mark "RACHNA SAGAR" and device mark " " in 1996 as an essential feature to be used in connection with their business of publication of books. With 27 years of extensive use of the said trademarks

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through widespread advertisements, the Plaintiff's marks have gained a formidable reputation in the market. Plaintiff also has an online presence and operates through their website- www.rachnasagar.in.

The plaintiff applied for registration of the device mark "RACHNA SAGAR" on November 29, 2021, bearing application no. 5226218, in class 16, and the same is pending registration. Nonetheless, the Plaintiff is the registered proprietor of the trademark " TOGETHER WITH CBSE PARIKSHA " registered on November 27, 2007, bearing registration no. 1624801 in class 16. The plaintiff also has an independent common law right concerning the trademark " ", as the same has been used by the plaintiff since 1996.

The plaintiff contended that Defendant No.1, a company operating in a similar business domain, has registered a mark " " under questionable circumstances, prompting the Plaintiff to file a rectification petition. Plaintiff alleged that Defendant No.1's registration is based on forged documents and lacks authentic evidence of prior usage.

The plaintiff further contended that, given the overlapping nature of their businesses, this could lead to confusion and deception among consumers and industry members.

Defendant's Contentions

Defendant No.1 asserted ownership of the Impugned mark, benefiting from a statutory presumption of its validity. They argued that the mark was honestly adopted and held seniority due to its use by predecessors dating back to 1995. "Rachna Sagar" was initially used by a family-run company, Rachna Prakashan Pvt. Ltd., incorporated in 1995, where Mr. Mukesh Gupta played a pivotal role. Under Mr Gupta's direction, the mark gained significant recognition through published works and subsequent expansions into partnerships and corporations, including Sovereign Mercantile Pvt. Ltd. and May Flower Avantika Publication Pvt. Ltd. It was contended that all entities using the mark did so with Mr Gupta's authorisation.

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Defendant No.1 challenges the Plaintiff's claims by highlighting inconsistencies in their actions. They point out that Plaintiff, in response to objections during trademark application, asserted that their mark was distinct from Defendant No.1's, suggesting no likelihood of confusion. This contradicts the Plaintiff's current stance of alleging confusion and deception. Additionally, Defendant No.1 questions the validity of Plaintiff's evidence, arguing that Plaintiff failed to demonstrate substantial use of the "Rachna Sagar" trademark in the relevant period and that the term was primarily used as a tradename, not a trademark.

Defendant No.1 asserted lawful adoption and continuous usage of the Impugned mark since 1995, backed by Mr Mukesh Gupta's involvement across various entities. They challenged the Plaintiff's assertions of confusion and deception while questioning the foundation of the Plaintiff's passing off claim due to alleged deficiencies in demonstrating goodwill and reputation associated with the "Rachna Sagar" trademark.

Court’s Analysis and Decision

The Court examined both parties' arguments. Despite lacking official registrations, Plaintiff claims common law rights over the trademark " " due to continuous use since 1996, alleging passing off by Defendants Nos. 1-3. While acknowledging the deceptive similarity between the two logos, the Court scrutinised their designs.

The Court noted that the Plaintiff's logo, with its unique stylised 'r' and distinctive colour scheme, has gained distinctiveness over time. In contrast, Defendants No.1-3's logo bears a striking resemblance, potentially leading to consumer confusion, especially as they operate in similar markets.

The Court stated that Defendants Nos. 1-3 asserted the use of the Impugned mark since 1995, supported by digital copies of books. However, the Court questioned the authenticity of these copies and highlighted the lack of original printed books, casting doubt on Defendants' claims of continuous use and succession and emphasising the necessity of concrete evidence to establish trademark rights. Additionally, discrepancies arise as the evidence provided belongs to entities other than Defendant No.1, further weakening their case.

On the other hand, the Court noted that the Plaintiff presented evidence of their prior use of the trademark, including invoices and original books bearing their mark. This, coupled with their registered trademark since 2007, challenges Defendants' claim of prior use.

The Court concluded that the Defendants' adoption and use of the Impugned marks amount to passing off, confirming the injunction order while awaiting further trial proceedings for a definitive conclusion.

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72. Shield of Passing Off when Both Trademarks are Registered

Case: Malcom India Limited vs. Shanthi Udyog Weldsafe Pvt. Ltd and Ors [CS(COMM) 85/2024 & I.A. 5877/2024]

Forum: Delhi High Court

Order Dated: April 10, 2024

Order: In a suit filed by Malcom India Limited, the Delhi High Court explored the legal complexities regarding passing off and trademark infringement, focusing on Section 28(3) of the Trade Marks Act, 1999. The Plaintiff, Mallcom India Limited, is primarily engaged in the business of manufacturing safety shoes under the trademark “TIGER,” for which they secured several registrations as early as 2010. The Plaintiff alleged that the Defendant had obtained registration for their trademark “CDTIGER” / CD TIGER in a dishonest and unlawful manner by adopting the dominant elements of the trademark, making it deceptively similar to the Plaintiff’s prior registered trademark “TIGER”. The comparison is as shown below:

Plaintiff’s mark	Defendant’s mark
TIGER (wordmark) TIGER TIGER	CD TIGER

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The Plaintiff contended that in spite of the stylisation and addition of the letters "C" and "D", the overall impression created by the Defendant's trademark is, in essence, the same, which would create confusion amongst consumers as they identify the trademark "TIGER" as the Plaintiff's, making it a fit case for infringement and passing off. The Defendant, in response, took the shield of honest adoption and claimed that letters "C" "D" was bonafidely adopted as it represents the initials of the Defendants father, and that "Tiger" was an homage to the Defendant's roots in West Bengal. They further claimed that the word TIGER is a commonly used term and has become generic, a defence that was also used by Plaintiff in their own submissions to the Registry.

With respect to the issue pertaining to deceptive similarity, the Hon'ble Court held that the dominant element of the Plaintiff's trademark- "TIGER" is entirely present in the Defendant's subsequently adopted trademark. Hence, it is likely that consumers will mistakenly associate the Defendants' products with the Plaintiff's, which could potentially cause confusion and dilution of the Plaintiff's trademark. The mere addition of the letters "C" and "D" will not improve the overall resemblance that it creates.

Section 28(3) – Proprietors of registered trademarks do not have exclusive rights against each other.

In the present case, despite the Defendant holding a registration for their trademark, the Plaintiff has sought trademark infringement and passing off on the basis of prior adoption. Considering the same, the provision under Section 28(3) of the Trademarks Act,1999 would be invoked. The provision is as follows:

(3*) Where two or more persons are registered proprietors of trade marks, that are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor*.

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A reading of Section 28(3) provides that if two registered marks are identical or deceptively similar to each other, the registered proprietors will not have any exclusive rights against each other, and both proprietors will be equally entitled to use the mark. The Court, as directed by this provision, recognised the registration secured by the Defendant.

Therefore, the claims of trademark infringement by the Plaintiff would not hold. However, the mere registration of a trademark does not immunise the registered proprietor from passing it off. In support of this, there have been instances wherein the Courts have acknowledged the common law remedy of passing off available even to a registered proprietor against another registered proprietor of a similar or identical mark.

The Hon'ble Court had unambiguously acknowledged that the Plaintiff is the prior registered proprietor of the trademark "TIGER", which was supported with evidence by way of expenditure on marketing and invoices from as early as 2006 they had furnished before the Hon'ble Court. In light of the same, the Hon'ble Court held that the arguments put forth by the Defendant was not maintainable and that the Defendant ought to have exercised due diligence and a thorough market search before employing the trademark "CD TIGER".

The Hon'ble Court concluded that Plaintiff, being the prior adopter of the trademark, has earned goodwill and reputation due to the continuous and extensive usage over the years, thereby making the subsequent adoption of Defendant's trademark *malafide* and dishonest. It was held that all the elements of the trinity test for passing off are met and that should an injunction not be granted, it would cause irreparable damage to the reputation of the Plaintiff's mark, as it is deceptively similar and will, in all likelihood, cause confusion amongst consumers.

In conclusion, the case highlights the issues involved in trademark disputes, especially involving both trademarks that are registered, the importance of prior registration and the burden of proof in order to establish a strong case for passing off. Consequently, the injunction Order was passed against the Defendant and was directed to restrain from selling, marketing, and dealing in products bearing the registered trademark "CDTIGER", and any use thereof would amount to passing off. They were also directed to deplete the existing stock within 4 weeks of issuance of the Order and take down their domain name www.cdtiger.com.

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73. Hershey's vs Atul Jalan - Scope of '*First Sale*' Doctrine in Trademark Infringement

Case: The Hershey Company vs Atul Jalan [CS(COMM) 780/2023, I.A. 21399/2023, I.A. 21401/2023, I.A. 24575/2023]

Forum: Delhi High Court

Order Dated: April 15, 2024

Order: Hershey's sought an injunction as they alleged that Atul Jalan had been selling expired Hershey's chocolates by re-packaging them, which presented a considerable risk to public safety and health. The plaintiff alleged that Atul Jalan had knowledge of the trademarks as well as the packaging of the brand but was still blatantly copying them. They also misrepresented the chocolates as their own. The Court found that the nature of the allegation was serious and granted an interim order in favour of the plaintiffs, along with which they appointed Local Commissioners to seize the expired goods.

Via the interim order, they also directed the Food Safety and Standards Authority of India (FSSAI) to conduct a thorough inspection of perishable goods and ensure that they were not sold further. The Court observed that if the goods were sold, they would cause irreparable damage to the company's prestige and to the public at large.

The Local Commissioners found various expired products of Hershey's chocolates and confectionaries which had not been returned. The defendant did not have the license issued by FSSAI to sell or resell Hershey's products. Moreover, the defendant was hesitant and uncooperative, did not share crucial information like the source of products and financial transactions, and had discrepancies in the history and scope of their

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business, especially concerning selling food items.

The condition of the products that were found was worn and torn, and their manufacture and expiry dates had either been altered or covered. They found several discrepancies in the pricing of the packages and found that some had their prices altered. In some packages, only the manufacturing dates were present. The packaging had been re-taped, and many had the same lot numbers for different batches of Hershey's chocolates. The stock of expired products was egregious, and chemicals had been used to wipe off details of the products/ chocolates. Upon asking the defendants, Mr. Atul Jalan and Mr. Mridul Jalan, if they knew that these labels were false and were affixed on top of the original label- they maintained their claim that they had no idea about the same, and sold whatever they received from the unidentified supplier- "AS- IS".

The FSSAI intervened, and the Deputy Director/Central Licensing Authority, FSSAI, took action to seal the defendant's premises due to the large quantity of expired stock and unlicensed operation. Under the Food Safety and Standards Act, an order was made to ensure that none of the products left the unlicensed premises.

Several boxes were found at the second premises, all expired. Some of these boxes were on display, and the others remained unopened. It was also found that the products had new information labelled, including MRP, expiration date, and manufacturing date. This premise was also being operated without a license post, and a show-cause notice was served to the store manager. A discrepancy with respect to the invoices was also found, which indicated that some products had already been sold or were missing. The summary report of the Local Commissioner showed that the stock of the expired products with the defendant was not limited to Hershey's, but it included other brands as well.

The Court, via another order on 10th November 2023, provided a special mandate to the officers of the Department of Food Safety, GNCTD, and FSSAI, which authorised them to seize all expired products, seal the premises in case a large quantity of expired products was found, and directed them to furnish a report within a week after visitation of the premises. The Court further asked that a complaint be registered with the local police station and issued a non-bailable warrant. These Non-Bailable

Warrants were then suspended via another order, and the Counsel for the defendant undertook that his client, Atul Jalan, would be present for all the hearings henceforth. The Court directed Atul Jalan to provide details of the source from where they procured these expired products so that any third party involved in similar practices could be investigated and booked.

The Court found that while the present suit was only related to Hershey's, it showcased a bigger problem involving the sale of expired products with new and fake expiry dates running systematically and rampantly. It also appeared that many of the sales and purchases of such expired products were happening on e-commerce platforms, and FSSAI could not file cases and take them up urgently. This was beyond the scope of the present commercial suit but required urgent consideration. Hence, the Court also directed the Crime Branch of the Delhi Police to conduct a detailed investigation into the matter and place the findings in front of the Court.

What remained shocking amidst all this was the stand of the Defendants; they opposed the injunction, claiming that the seized goods were legitimately purchased from a third party. To support this, they submitted invoices as evidence of such purchases. Moreover, they argued that any compliance issues, such as the presence of expired or relabelled products, should be attributed to the supplier rather than to the defendant themselves.

Court's Verdict

While confirming the ad interim injunction, the Court made certain scathing remarks/ observations regarding the defendant and its conduct. At the outset, the Court believed that the defendant's stand of unknowingly purchasing infringing goods from a third party does not absolve them of liability and legal consequences arising from the fact that the counterfeit goods were found at their premises. To defend their position effectively, they must establish the legitimacy of their sources and demonstrate that they conducted due diligence both before and after acquiring the goods to mitigate their liability.

The burden of proof rests squarely with the defendant to ensure their supply chain is transparent and accountable. Simply possessing an invoice is insufficient, especially when confronted with compelling evidence of product tampering and expiry date falsification. The Court went on to state that their attempt to redirect liability to the third-party supplier from whom they allegedly purchased the products would be of no avail as the use of the plaintiff's trademark on altered products would prima facie constitute infringement, as the same falsely suggests that the expired product is produced and sold by the plaintiff.

The Court further elucidated the “first sale” doctrine, under which subsequent sales of the unaltered, genuine articles typically do not constitute trademark infringement because they do not introduce any confusion regarding the origin of the product. However, if a reseller alters a genuine article in a way that could mislead consumers, such as by changing expiration dates, then this would undeniably create confusion about the source and quality of the goods.

Such actions can be seen as creating a "materially different" product, which can fall outside the protection of the first sale doctrine and infringe upon the trademark. In these cases, consumers might believe they are buying a product that is backed by the original manufacturer's reputation and assurances when, in fact, they are not. Such misrepresentation has the potential to damage the plaintiff's brand reputation while also deceiving consumers and endangering public health. Such circumstances justify the grant of an injunction to prevent further misuse of the plaintiff's trademark and protect consumer safety.

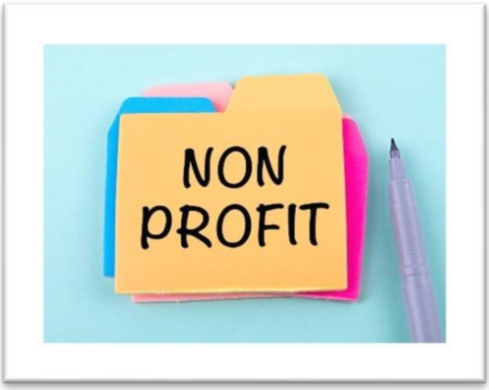
The multi-faceted approach taken by the Court in this particular case is remarkable, to say the least. As the suit progressed and shocking details regarding the misconduct of the Defendants came to light, the Court did not shy away from taking *suo moto* action and involving the relevant agencies along with enforcement authorities to ensure that the perpetrators were reprimanded for their wrongdoings, especially since their acts could have an effect on the health and safety of the consumers at large.

74. In Defence of Identity: Heifer Project International's Legal Victory

Case: Heifer Project International v. Heifer Project India Trust, [CS(COMM) 542 of 2018]

Forum: Delhi High Court

Order Dated: April 23, 2024



Order: Heifer Project International- Plaintiff filed a present suit seeking a permanent injunction against the defendants, thereby preventing them from using any trademarks and logos that were deceptively similar or nearly identical to the plaintiff. Delhi High Court opined that the present case was a classic 'triple identity' instance.

The impugned trademarks, as were the areas of operation, and the segments of the public they targeted were nearly identical. Therefore, the defendants' use of these nearly identical and deceptively similar marks was certain to cause deception and confusion among the public.

Thus, the Court opined that the defendants' continued utilisation of the 'Heifer' mark post-revocation constituted a clear violation of the plaintiff's intellectual property rights. Accordingly, the Court granted a decree of permanent injunction restraining Defendant 1 or any other person acting for and on their behalf from infringing the plaintiff's trade mark or any part thereof and/or any other name that was deceptively similar to the trade mark 'Heifer' and/ or the leaping device / or any other deceptively similar trade mark.

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Background

In 1953, the plaintiff was incorporated as a non-profit corporation under the Arkansas Non-profit Corporation Act of 1993. Originally, the plaintiff was incorporated under the laws of the State of Indiana, USA and was the surviving corporation following a merger between HPI, Inc. and Heifer Project International, Inc. in 1997. The plaintiff conducted several projects in over 51 countries, including India, and carried out various charitable projects, including disaster rehabilitation, environmental protection, peace, etc.

In 1953, the plaintiff adopted a unique and uncommon word, 'Heifer', as its corporate name and continued to use the same uninterruptedly in connection with its trade names, corporate name, and trademarks. Subsequently, Plaintiff adopted two trademarks, 'Heifer International' and 'Heifer Project', regarding its activities. Further, they adopted a device mark of a leaping cow, which was placed in the left-hand top corner of the 'Heifer International' trade mark and a pictorial mark having the shapes of several animals, namely a cow, a goat, etc., in an oval device ' ' was also used jointly with 'Heifer International' (collectively referred as 'plaintiff's marks').

The plaintiff also held the copyright of these artistic creations, which extended globally and also within India. Further, the plaintiff registered four 'Heifer' trademarks with the Indian Trade Mark Office, ensuring comprehensive protection of its intellectual property. The said marks were granted registration during the pendency of the present suit.

Defendant 1 was a non-profit charitable trust formed on 24-12-1992, with its headquarters in New Delhi. It operated under the name 'Heifer Project—India Trust' but was widely recognised as 'Heifer Project India.' In 1997, Defendant 2 became associated with Defendant 1 after assuming the role of 'Country Director—India' and was simultaneously appointed as the 'Managing Trustee'.

Plaintiff granted Defendant 1 permission to utilise the 'Heifer' and 'Heifer Project' names and associated logos. This authorisation was contingent upon a broad agreement that Defendant 1 could employ these trademarks and logos if they operated harmoniously and cooperatively with the plaintiff's mission and facilitated the plaintiff's activities within India. In return, Defendant 1 was obligated to regularly report on the progress and financial details of the projects financed by the plaintiff.

It was contended by the plaintiff that in 2002, Defendant 2 began to deviate from his contractual obligations, showing a marked reluctance to adhere to the plaintiff's basic requirements for reporting and accountability. Thus, his contract to serve as the Country Director for India was not extended beyond 30-06-2003. However, Defendant 2 maintained his role as Managing Trustee, during which he directed the trust's operations in a whimsical and arbitrary manner.

On 09-10-2003, Defendant, through its letter, notified Defendant 1 that it would be suspending all project funding in India. Plaintiff explicitly instructed Defendant 1 to cease the use of the 'Heifer Project' trade mark, trade name, and logo. Defendants were further instructed to return all materials, cash, and other properties belonging to the plaintiff. However, despite these instructions, the defendants persisted in their use of the plaintiff's marks.

Thus, the plaintiff contended that the defendants were infringing their registered trademarks and illegally usurping the enormous goodwill and reputation built by them since 1953. Further, the defendants had no right to use/apply for the registration of the impugned marks or to carry on any business activities thereunder.

Analysis, Law, and Decision

The Court observed that the pleadings and documents in the present case unequivocally established the plaintiff as the rightful owner and proprietor of the 'Heifer' trade mark, trade name, and corporate identity, encompassing logos and other associated marks. Further, the Court noted the objective of Defendant 1, which specifically entailed Defendant 1 working in harmony and cooperation with the plaintiff and facilitating its working in India. The Court opined that given the plaintiffs' uncontested trade mark rights and the objectives outlined in Defendant 1's trust deed, it was clear that Defendant 1's use of the plaintiff's trade marks without explicit permission constituted an infringement of those trade mark rights.

Further, regarding the defendants' reliance on their FCRA license as proof of their autonomy, the Court opined that there was sufficient evidence to show that a relationship with the plaintiff was established from the very inception of Defendant 1, and it continued for a stretch of time. Thus, the Court opined that even if it was accepted that Defendant 1 was an independent legal entity, this did not negate the fact that a relationship existed between the plaintiff and Defendant 1, which could be characterised as a licensor and licensee, specifically concerning the lawful use of the plaintiff's trademarks.

The Court opined that the present case was a classic instance of 'triple identity'. The impugned trade marks were nearly identical, as were the areas of operation and the segments of the public they targeted. Therefore, the defendants' use of these nearly identical and deceptively similar marks was certain to cause deception and confusion among the general public. The Court opined that the defendants had persistently engaged in activities that unlawfully exploited the plaintiff's reputation and goodwill. This defiance violated the agreement and also misled the public and relevant stakeholders regarding the nature of the defendant's affiliation with the plaintiff.

The Court opined that the defendants further compounded their infringement by falsely representing their relationship with the plaintiff. They insinuated to the public and stakeholders that they remained affiliated with the plaintiff, thereby undermining the plaintiff's brand/trade mark. The Court opined that the defendants lacked any legal right or justification to use contested marks or apply for registration of identical marks for conducting any business activities.

The Court opined that it was unequivocally clear that the defendants were engaged in the infringement of the plaintiff's trade mark, trade name, and corporate identity. Thus, the Court opined that the defendants' continued utilisation of the 'Heifer' mark post-revocation constituted a clear violation of the plaintiff's intellectual property rights. Accordingly, the Court granted a decree of permanent injunction restraining Defendant 1 or any other person acting for and on their behalf from infringing the plaintiff's trade mark or any part thereof and/or any other name that was deceptively similar to the trade mark 'Heifer' and/ or the leaping device / or any other deceptively similar trade mark.

The Court directed Defendant 1, or anyone acting on their behalf, to hand over to Plaintiff all goods, visiting cards, letterheads, packaging and promotional material, catalogues, stationery and any other material bearing the impugned trademarks or any other deceptively similar trade mark. Further, Defendant 1 should recall all the products, marketing, promotional and advertising materials bearing the impugned marks or any other deceptively similar trade mark.

The Court also directed Defendant 1 to deliver to the representatives appointed by the plaintiff the destruction of all products, labels, signs, prints, packages, moulds, visiting cards, letterheads and advertisements in its possession or control bearing the plaintiff's marks. The Court awarded the plaintiff nominal damages of Rs. 3,00,000 and directed Defendant 1 to pay this sum.

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1. Infringed Melody: Nivedita Joshi Seeks Justice for 'Palko Ke Palne'

Case: Nivedita Joshi vs Abhishek Ray & Anr. [CS(COMM) 1/2024]

Forum: Delhi High Court

Order Dated: January 4, 2024

Order: This case was filed by the plaintiff- Nivedita Joshi, seeking an ex parte ad-interim injunction against the defendants; the plaintiff's case was that she had penned the lyrics of the song 'Palko Ke Palne' which featured as a part of a film 'Life's Good'. Defendant No. 1 is the music composer of the soundtrack of the said film, which was produced by Defendant No. 2. The plaintiff is a renowned personality who has contributed to the arts and the cultural realm in India.

Her poems have been used for lyrics of various other music albums in collaboration with eminent personalities. It was her case that in 2011, she had penned the lyrics of this song and shared the same with defendant no.1, who requested her to complete the remaining song and mentioned that the said song would fit with the theme of an upcoming film, 'Life's Good'. She was initially informed that the movie was to be released in 2011; however, it could not be produced due to the financial constraints of the film producer. No written agreement was entered into between the plaintiff and defendant No. 1.

In November 2022, the plaintiff chanced upon a video link on YouTube, which was shared by defendant no.1 via WhatsApp communication. The link showed the said song being featured as a part of the said film, the same film mentioned by defendant no.1 in 2011. It was discovered that the said film had been produced by defendant no.2 and came as a shock to the plaintiff since she had not been informed about her lyrics being finally used in the film; that too, after about a decade.

Legal notice was sent to both defendants on 6 December 2022; defendant no.1 responded on 8 December 2022; however, defendant no.2 did not submit any response to it.

The plaintiff filed for a pre-litigation mediation petition, Petition No.422/2023, on 44 October 2023 before the Delhi High Court Mediation & Conciliation Centre. Defendant No. 1 appeared, though the mediation session was not successful. It was noted that defendant no.2, despite being served, did not appear in the mediation proceedings.

The plaintiff contended that she is the author and first owner of the literary work, i.e., the lyrics of the song and therefore, is protected under Section 14(a) of the Copyright Act, 1957 ("the Act"). By using the lyrics as part of the said song, which has now been disseminated through a cinematograph film and independently on music channels, the defendants are jointly liable for infringing the plaintiff's copyright.

Defendant No. 1 contended that they had indeed commissioned the artist, i.e., the plaintiff, for lyrics of the said song and had incorporated it as part of the musical work produced by them; and thereafter, in their agreement with the film producer – defendant no.2, had supplied it for being used in the cinematograph film. Defendant No. 1 stated that this arrangement had been without any monetary consideration for the reason that the engagement was based on the understanding that the plaintiff would be provided with a larger canvas for her work and would gain promotional benefit.

The Court observed that Without prejudice to the rights and contentions of the parties, it is prima facie clear that – firstly, the lyrics of the said song had indeed been penned by the plaintiff; secondly, the said song has been produced by defendant no.1; thirdly, the said song has been used in the above-mentioned cinematograph film produced by defendant no.2; fourthly, the said film indeed had a theatrical release and additionally the said song is being promoted and disseminated through various music channels and other media; and lastly, the said song does credit the lyrics to the plaintiff.

The Court held that the rights of the plaintiff had to be adjudicated through this suit; it would be apposite if the royalties which are being received by defendant no.2 and by any other party on their behalf may be preserved, subject to the outcome of the present suit.

Accordingly, The Court directed defendant no.2 and any person authorised on their behalf to maintain proper accounts of all royalties received on account of dissemination of the said song through all possible media.

The Court also directed the defendants to ensure that the said song, through its dissemination, continues to credit the plaintiff for the lyrics of the song in order to preserve her moral rights in the said work.

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2. TV9 vs. YouTube: Copyright Clash in the Digital Arena

Case: Associated Broadcasting Company Ltd. vs Google LLC & Ors. [CS(COMM) 9/2024]

Forum: Delhi High Court

Order Dated: January 5, 2024

Order: The plaintiff in this suit is in the media and broadcasting services business. It operates several television channels and digital platforms in India under the name and style of "TV9". As part of their digital footprint, the plaintiff carried their digital content, among other things, on YouTube, which is a platform operated by defendant no.1. (Google LLC). Through these digital channels, the plaintiff uploads various news videos on a bouquet of subjects.

Between 2020 -2023, the plaintiff carried certain news programs on the said digital channels relating to various events of natural disasters, viz., the Laura Hurricane in the United States, the ongoing Israel-Hamas war, heavy snowfall in the United States, New York floods, and the 2023 Chinese Balloon incident in the United States etc. The plaintiff used some on-ground footage from online material for the said purpose.

In December 2023, the plaintiff received strike notices from defendants nos. 2 to 5 regarding various videos that had been uploaded on the said digital channels, on the basis that the videos uploaded by the plaintiff contained footage of which defendant nos. 2 to 5 own copyright. The plaintiff responded to these strike notices, and various communications were exchanged between them and defendants nos. 2 to 5 and their legal representatives. Defendant no.1 removed the said videos of the plaintiff from YouTube, as per the plaintiff.

Subsequently, the plaintiff learned that defendants nos. 2 to 5 have initiated copyright infringement proceedings in the United States courts. Thus, the plaintiff approached the Court against an imminent threat of their digital channel being removed from YouTube, potentially on account of a decision that may be taken by the Courts in the United States or otherwise by defendant no.1. Any removal of the said digital channel from YouTube, as per the plaintiff, will naturally cause huge damage to them, considering they are in the business of news dissemination.

Defendant No. 1 stated that presently, the plaintiff's digital channel on YouTube has not been removed, although some infringing videos have been removed by Defendant No. 1 and some by the plaintiff. In view of the above, the Court held that there is no urgency to pass protective orders in favour of the plaintiff at this stage.

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3. Judicial Precision: Delhi High Court Halts Unauthorized Dental Products in Ex-Parte Injunction

Case: Huwais IP Holding LLC & Anr vs Waldent Innovations Private Ltd. [CS(COMM) 8/2024]

Forum: Delhi High Court

Order Dated: January 5, 2024

Order: This case was filed by the Plaintiff under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 ("CPC") seeking an order for temporary injunction restraining the Defendants from using the Plaintiff's copyrighted works and any other activity amounting to copyright infringement of the Plaintiffs copyrighted works.

Plaintiff nos. 1 and 2 are companies that own trademarks and copyrights, respectively, in products developed by Dr Salah Huwais, a practising and well-renowned periodontist in Michigan, United States of America. Dr Salah Huwais invented the osseodensification and osteotomy procedure, in which a universal drill can employ a unique and proprietary bur attachment for dental implants. Dr. Salah Huwais is the inventor of the "Densah® Bur technology" and has been granted patents worldwide for the procedure.

Plaintiff No. 1 is a company that owns the trademarks, and Plaintiff No. 2 regularly publishes various types of informative content, such as brochures, catalogues, manuals, etc., on both online and offline platforms regarding the said procedure utilising the Densah Burs Technology. In respect of this, certain marks, "VS8", "VT5", and "VT8", were adopted in respect of dental products, and the said marks have been registered in numerous jurisdictions across the world, including India, the United Kingdom, the United States of America, China, Japan, etc.

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In April 2021, plaintiffs learnt about the allegedly illegal activities on the defendant's website, www.waldent.com, where the latter had displayed dental burs for sale, advertisement and promotion, which were the exact replica of the dental burs manufactured by the plaintiffs using their proprietary technology. The said products were listed as "Waldent Universal Osseodensification Burs Kit" ("impugned products"). The plaintiffs contacted the defendants with infringement notices, under which the listing of the impugned products was taken down.

Subsequently, plaintiffs again found a listing of the impugned product on an e-commerce platform, namely, DentalKart and various social media platforms. Pursuant to a demand notice dated 9th June 2021, an email was sent by the defendants acknowledging receipt of the notice and confirming that they have removed the listing of the impugned product. The same was followed by another notice by the plaintiffs dated 30th June 2021 regarding the availability of the impugned product on an e-commerce platform – Dentisthub. The defendants again complied with the request and provided a declaration on 13th August 2021 acknowledging the plaintiffs' rights.

Subsequently, there were further incidents in October 2021 of listing the impugned products on the e-commerce website Dentist Hub India, and the defendants were directed to take down the same. In March 2023, another listing of the impugned product was found on defendant no. 1's own website 'www.waldent.com'. Consequently, plaintiffs wrote to the defendants on 10th March 2023, reminding them of their declaration executed by them and requesting them to remove the listing. Defendants replied through an email dated 17th March 2023 stating that they are removing it from the website.

However, since it was not removed, another communication was sent on behalf of the plaintiffs, to which a response was received on 2nd May 2023 from the defendants stating that they had recently removed the impugned product from their website and assuring that they were taking the matter seriously. The email stated that "our team conducted a thorough review of our website, and they identified the item in question as potentially problematic. As a result, we have taken the necessary step to remove it from our website."

Despite this exchange of communication and undertaking given by the defendants, the plaintiffs pointed out listings of the impugned products on www.surgeonmart.com and www.medisavehealth.in. Furthermore, the description of the impugned products on www.surgeonmart.com mentioned that "Dr. Huwais in 2013 developed a non-extraction technique, with specially designed burs and increase bone density by expanding an osteotomy site".

After hearing the Plaintiff, the Court opined that the plaintiffs had made out a strong prima facie case for the grant of ex-parte ad-interim injunction in their favour; the balance of convenience also lies in their favour considering that the defendants, despite their acknowledgements, had not taken steps to remove the listings for the impugned product. The conduct of the defendants will naturally cause irreparable harm to the plaintiffs.

Accordingly, the Court restrained the defendants, its Directors, their agents, affiliates, partners, stockists, representatives, etc., from using the plaintiffs' registered marks and/or any other mark identical or deceptively similar to the plaintiffs' aforesaid trademark and any permutations/combinations thereof, in any form or manner, amounting to infringement and passing off, till the next date of hearing. The Court further directed the defendants, their directors, promoters, etc., to remove the listings of the impugned product from their website or any other media on which the same had been listed.

Defendants are further restrained from directly or indirectly copying, communicating, reproducing, launching, manufacturing, supplying, distributing and/or dealing in any manner whatsoever in connection with the distinctive shape of the Densah Burs and Densah Bur Kits and/or any shape identical with or deceptively similar to the distinctive shape thereof and/or any other activity amounting to passing off of their goods/services as that of the plaintiffs' till the next date of hearing.

4. Delhi High Court Restricts Singer 'Bohemia' from Producing Sound Recordings with Third Parties Without Prior Approval from Saga Music

Case: Saga Musica Private Limited vs Roger David and Ors. [CS(COMM) 44/2024]

Forum: Delhi High Court

Order Dated: January 16, 2024

Order: The Plaintiff filed this application under Order 39 Rule 1 and 2 of the Civil Procedure Code, 1908, in respect of the suit filed by the Plaintiff seeking, among other things declaration that the Plaintiff had rights, title and interest in the literary works, musical works, sound recordings and cinematographic film created/produced by Defendant 1 with exclusively and collaboration with any party during the term of agreement dated 15-12-2019 and addendum dated 05-01-2021, and permanent injunction restraining defendants and all other persons acting on his behalf and for him from infringing the copyright which accrued to the benefits of Plaintiff by virtue of the above-mentioned agreements.

The Plaintiff is the owner of a music label, "Saga Music", a company incorporated in India that claimed to be a music brand in the Punjabi music and film industry and enjoyed substantial goodwill and reputation in the market. Defendant 1 was a singer, songwriter and music composer working under the screen name "Bohemia" in the Punjabi Music Industry and a resident of the USA. Defendants 4, 5, 6, 7, and 8 were other music producers/studios that Plaintiff alleged to be in violation of the above-mentioned agreement and had produced certain sound recordings and albums with Defendant 1 and disseminated the same.

Plaintiff submitted that as per the agreement dated 15-12-2019, titled "Exclusive Talent Engagement Agreement", Defendant 1 had agreed to work with Plaintiff for future projects on terms and conditions as stated in the agreement. The agreement's terms provided that Defendant 1 would be exclusively engaged with Plaintiff for 45 months, and during the said term, he must perform, sing, and act for Plaintiff exclusively and not for any third party/parties worldwide.

Further, the agreement stated that if any third party wished to engage Defendant 1, it would contact Defendant 1, who would, in turn, contact Plaintiff, and the deal would be routed through Plaintiff only. Further, Plaintiff would manage any performance in the world by Defendant 1 during this term, and the revenues would be mutually distributed between the parties as agreed. Defendant 1 agreed that Plaintiff would be the sole and exclusive owner of all Intellectual Property Rights, including copyright in the songs and performances of Defendant 1, which he would perform during the term of the aforesaid agreement.

An Addendum was executed between the parties, which altered certain deliverables and payment terms. However, the essential agreement relating to Intellectual Property Rights remained unchanged. It was stated in the plaint that Defendant 1 failed to abide by the terms and conditions of the agreement and failed to make any performance or deliver any sound recording or visual recording to Plaintiff, despite an advance payment having been made to Defendant 1.

There were various incidents of breach by Defendant 1 of the express terms of the agreement, including not updating Plaintiff regarding his musical tours and releasing multiple audio songs on YouTube Channel. Defendant 1 continued to release songs by collaborating with other labels, particularly Defendants 4, 5, 6, 7, and 8, without taking written approval from Plaintiff or routing the deal through Plaintiff. Plaintiff, therefore, lost the ability to monetise the performances despite categorical clauses in their favour in the agreement.

On 27-08-2021, Defendant 1 served a legal notice to Plaintiff claiming that Plaintiff did not perform his part of the agreement and was supposed to make payments to Defendant 1, which have not been paid. Therefore, Plaintiff's counsel submitted that there was no basis for lack of performance on Plaintiff's part, whereas, on the other hand, there were serious and continued breaches by Defendant 1.

It was further submitted that Defendant 1, with an implied reference to Plaintiff, was posting defamatory content relating to his contract with Plaintiff on social media, which invited adverse comments specifically targeted at Plaintiff. It was contended that despite non-performance on his part of the agreement by Defendant 1, Plaintiff was subjected to disparagement and adverse comments, which had caused him irreparable harm in the music industry. The Court opined that Plaintiff had made out a prima facie case for ex-parte ad interim relief as the balance of convenience lies in favour of Plaintiff and irreparable damage would be caused in case certain directions were not passed in Plaintiff's favour.

Thus, the Court restrained Defendant 1 from engaging with third parties/entities to make any sound recording/cinematographic film/musical work created by Defendant 1 and any performance by Defendant 1 without the prior written approval of Plaintiff. The Court further restrained Defendants 1, 2, and 3 from posting, uploading, sharing, e-sharing, and publishing or causing defamatory, disparaging, misleading posts against Plaintiff on any social media or digital platform.

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5. PPL Refuses to Consent to the Use of Sound Recordings at Wedding Parties

Case: Canvas Communication vs Phonographic Performance Limited [CS(COMM) 77/2024]

Forum: Delhi High Court

Order Dated: January 25, 2024

Order: In the recent case of Canvas Communication vs Phonographic Performance Limited, the Plaintiff, relying on the notification issued on 24.07.2023 by the Department for Promotion of Industry and Internal Trade (DPIIT), filed an application seeking a decree of declaration declaring that the use of sound recording does not amount to infringement of the Defendant's Copyright.

The Plaintiff is an event management company for the purpose of its business had applied for a No Objection Certificate (NOC) requesting the Defendant for the use of its sound recordings, to which the Defendant refused. Correspondingly, the Plaintiff approached the court stating that playing music at wedding functions would not amount to copyright infringement as the same is exempted under Section 52(1)(za) of the Copyright Act, which also includes within its ambit "a marriage procession and other social festivities associated with marriage". Furthermore, according to the Plaintiffs, the "Cocktail Party" and "Sangeet" qualify as "social festivities associated with a marriage" and are thus protected by the exemption.

The Defendant, in its defence, referred to a judgment by a Single Judge of the High Court of Punjab and Haryana in **Novex Communications Private Limited v. Union of India and Anr**, where a similar notification dated

27.08.2019 was quashed. The Senior Counsel for the Defendant argued that the exemption was only for bona fide religious ceremonies, which, in his perception, does not include associated wedding functions: Pre-wedding sangeet and cocktail party.

The Court, after hearing the contentions of both the parties, ordered Plaintiff to deposit 1 Lac Rupees on account of Defendant for the purpose of balancing the equities. Defendant, on the contrary, stated that the said amount should be paid to Defendant instead of being deposited in the Court and would pay the interest if Plaintiff succeeds in the suit.

The Counsel for Plaintiff also asserted the cost of legal proceedings subject to final adjudication. The confirmation letter for issuance letter shall be issued by the Defendant post deposit being made by the Plaintiff.

6. Phonographic Performance Limited vs Apparel Group India Private Limited: Interim Injunction for Copyright Infringement

Case: Phonographic Performance Limited vs Apparel Group India Private Limited [CS(COMM) 147/2024]

Forum: High Court of Delhi

Order Dated: February 16, 2024

Order: The Plaintiff-Phonographic Performance Limited, filled this application seeking an interim injunction against the defendants and all those acting on their behalf from exploiting, using the Plaintiff's copyrighted works in repertoire available on the Plaintiff's website https://www.pplindia.org/songs at any of its premises including but not limited to the list of outlets which have been made a part of the documents of the present suit, which amounts to infringement of the Plaintiff's copyright.

The Plaintiff is one of the oldest collecting organisations in the world, and it was initially known as the Indian Phonographic Industry (IPI). The Plaintiff is engaged in issuing licences for public performance/communication to the public of sound recordings based on exclusive rights granted to it by its member record labels, i.e., owners of copyright in sound recordings.

The Plaintiff asserted ownership and control over the public performance rights of 350+ music labels, encompassing more than 4.5 million international and domestic sound recordings. As the country's oldest and largest collecting society, the Plaintiff represents approximately 80% to 90% of all sound recordings ever created in the country. The ownership of

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copyright in sound recordings was established through assignment deeds executed by member companies under Section 18 of the Copyright Act of 1957.

Additionally, the Plaintiff holds a significant share of the total sound recordings in international and domestic music, representing major record labels. With nonstop licensing activities since 1941, the Plaintiff was a registered Copyright Society under Section 33 of the Act. After the amendment to the said Act, it has re-registered itself since 2014 and is conducting the business of licensing under Section 33(1) of the Act.

Furthermore, the Plaintiff issues licenses under Section 30 of the Act for communication/public performance and facilitates licensees' use of its entire repertoire. The list of sound recordings for which Plaintiff has copyright is available on Plaintiff's website, https://www.pplindia.org/songs, which provides express notice of Plaintiff's rights in the sound recordings to any legitimate user.

The Plaintiff's grievance was against the defendants, who were playing the sound recordings for which the Plaintiff owns rights at various stores.

Plaintiff discovered that the defendants were exploiting the sound recordings owned by Plaintiff in their various premises; Plaintiff sent an email on 16th May 2023. The plaintiff and defendants communicated from May 2023 to November 2023, but then the defendants stopped responding and did not take a license from the Plaintiff. On 25th January 2024, Plaintiff's representatives found that the defendants continued using sound recordings of Plaintiff at its premises.

Plaintiff contended that by seeking to exploit Plaintiff's copyrights without any licence and in an unauthorised manner, defendants are indulging in acts of infringement. He pointed out various previous orders of this Court where the Plaintiff's rights had been protected and injunction orders had been passed inter alia in CS (COMM) 811/2023, CS (COMM) 812/2023, CS (COMM) 813/2023, CS(COMM) 763/2023, CS(COMM) 764/2023, CS(COMM) 765/2023, CS(COMM) 671/2021 etc.

In view of the above, the Court was satisfied that the Plaintiff has made out a prima facie case for the grant of an ex-parte ad interim injunction. The Court stated that the balance of convenience lies in favour of the Plaintiff;

the plaintiff is likely to suffer irreparable harm in case the injunction, as prayed for, is not granted.

Accordingly, till the next date of hearing, the Court passed an ex-parte ad interim injunction against the defendants. Defendants, their directors, partners or proprietors, and any other person working for and on their behalf are restrained from exploitation/ use of Plaintiff's copyrighted works in the repertoire available on Plaintiff's website https://www.pplindia.org/songs at any of its premises, including but not limited to the list of outlets that has been made a part of the documents of the present suit, which amounts to infringement of Plaintiff's copyright.

7. Legal Battle Unravelled: The Story Behind 'Dear Jassi'

Case: T-Series v. Dreamline Reality Movies, Mohali [FOA No. 6386 of 2023]

Forum: High Court of Punjab and Haryana

Order Dated: February 22, 2024

Order: In the recent legal clash between **T-Series and Dreamline Reality Movies, Mohali [FOA No: 6386 of 2023]**, an appeal was filed by T-series challenging the order dated November 23, 2023, passed by the Additional District Judge, Ludhiana, restraining them from producing, telecasting, selling, or releasing the movie 'Dear Jassi' till the final decision. The High Court of Punjab and Haryana at Chandigarh set aside the impugned order, vacating the stay on the release of the said film since Dreamline Reality Movies could not prove a prima facie case in their favour.

T-series intended to produce a film, "**Dear Jassi**," about the life story of Jaswinder Kaur Sidhu @ Jassi. For that purpose, T-series purchased the book's rights from a Canadian writer, Mr. Fabian Dawson (writer), for an authorisation fee of about 5000C$. At the time when T-series intended to release the movie "Dear Jassi", Plaintiff no. 1 claimed to have purchased the rights to produce the film from Respondent no. 5 Sukhwinder Singh @ Mithu, the husband of Jaswinder Kaur, filed a suit for injunction against appellants from exhibiting the film.

The respondents claimed that Dreamline Reality Movies entered into an agreement with Jaswinder Kaur's husband before the appellants produced the film. Since the husband's story was also involved in the film, T-Series could not make a film without his permission. Dreamline Reality Movies claimed to have a copyright over the story of Jaswinder's husband. While

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the suit was still pending, an application for an interim injunction restraining T-Series from exhibiting the film was also filed, which was allowed and impugned in the case.

Contentions of the Parties

The Appellants claimed that they had obtained the legal rights to the film from the original owner of the intellectual property rights of the book, which inspired the film. They argued that since the story of Jaswinder Kaur was already well-known and had been the subject of several movies, the information they used in their film was already in the public domain. Additionally, they obtained the rights specifically from the author of the book. Further, they argued that the respondents had no right to claim copyright over common human behaviour already in the public domain. To support their argument, they cited Section 13 of the Copyright Act of 1957, which states that copyright protection exists only for completed intellectual works. The Appellants also pointed out the delay in raising objections, as the film was already completed before any objection was made.

In response, Respondent No.1 argued that the film depicted the life story of Jaswinder Kaur, the wife of Respondent No.5. They claimed that the film involved some parts of Respondent No.5's life story as well, for which they had obtained permission through a prior contract. They contended that while some parts of Jaswinder Kaur's life were public knowledge, the details of her relationship and the love story with respondent No.5 were not and thus required permission. They argued that only they had the right to make the film, as they had purchased the life story rights from respondent No.5. They defended the timing of the lawsuit filing, stating there was no delay, and countered the argument that copyright extinguishes with the death of the person by stating that respondent No.5 was still alive.

Court's Ruling

The Court stated that the Copyright Act of 1957 defines various terms such as 'artistic work', 'author', 'cinematograph film', 'infringing copy', 'producer', and 'work'. The Act also specifies the works in which copyright subsists and the meaning of copyright. The Court clarified that in order to claim copyright over any material, it must qualify as an existing work created with intellectual effort and creativity. A mere idea or fact, without any effort by a person to convert it into a work, cannot be considered a 'work' that can be copyrighted. Copyright infringement only occurs when there is a reproduction, copying or performance of a 'work'. Therefore, the Court opined that no infringement can be claimed unless a pre-existing work is created by the person claiming copyright by investing his creativity, intelligence or effort. In this context, Sukhwinder Singh's life story alone doesn't qualify for copyright as he had not created any work.

Dreamline Reality Movies claimed to have purchased rights to produce a film based on Sukhwinder Singh's story, but the Court considered this ineligible for copyright protection. On the contrary, T-Series claimed the right to make a movie based on a book containing Jaswinder Kaur's story, which incidentally included parts of Sukhwinder Singh's life. The Court affirmed T-Series' legal right to produce such a film, noting that the story of Jaswinder Kaur, including her tragic murder, had already been widely documented in court records and media publications, rendering it part of the public domain.

The Court cited legal precedents, namely Krishna Kishore Singh v. Sarla A. Saraogi and Ramgopal Varma v. Perumalla Amrutha and found no prima facie case favouring Dreamline Reality Movies. Additionally, the Court highlighted that the lawsuit sought to restrain T-Series from producing a film based on Jaswinder Kaur's story, not Sukhwinder Singh's. Since Jaswinder Kaur had passed away without leaving any published or unpublished works, her legal heirs could not claim copyright over her story.

Furthermore, the Court examined the assignment of rights claimed by Dreamline Reality Movies from Sukhwinder Singh. It clarified that under Section 18 of the Copyright Act, only existing copyright in an existing work could be assigned, which was not the case here.

The Court also addressed Sukhwinder Singh's right to privacy, asserting that he lacked celebrity or publicity rights that could be commercially exploited. It emphasised that the right to privacy encompasses aspects intrinsic to one's existence and unique personal choices but does not extend to every aspect of personality. Consequently, the Court allowed T-Series' appeal and overturned the trial court's order dated 23-11-2023.

In this matter, the judiciary's decision to set aside the injunction against T-Series and allow the release of 'Dear Jassi' signifies not only a victory for creative freedom and intellectual property rights but also a precedent-setting ruling that defines the boundaries of copyright protection in the realm of biographical stories.

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8. Delhi High Court Grants Relief to Yash Raj Films in Bikramjeet Singh Bhullar vs Yash Raj Films Pvt Ltd & Ors.

Case: Bikramjeet Singh Bhullar vs Yash Raj Films Private Limited & Ors [CS(COMM) 483/2022, I.A. 14869/2022, I.A. 1127/2024 & I.A. 1972/2024]

Forum: Delhi High Court

Order Dated: February 22, 2024

Order: In a recent copyright infringement suit filed by Bikramjeet Singh Bhullar (hereinafter referred to as "the Plaintiff") against M/s Yash Raj Films Private Limited (hereinafter referred to as "the Defendant"), the Delhi High Court (hereinafter referred to as "the Court") vide its order dated February 26, 2024, directed the Registrar General of the Court to release INR One Crore earlier deposited by the Defendant along with interest accrued in favour of the Defendant.

The instant suit was filed by the Plaintiff seeking an injunction against the Defendant from making, producing, distributing, broadcasting, communicating to the public, adapting, telecasting, exhibiting in theatres, and/or on television and/or online platforms (including any 'OTT platform' or other streaming platforms), the impugned film titled "*Shamshera*", or any part(s) thereof, or any other similar work, so as to amount to infringement of Plaintiff's copyright in the literary work '*Kabu na chhadein Khet*' (hereinafter referred to as "the Plaintiff's work").

The plaintiff's work was conceived around 2006, which he set out in writing. It is stated to be a fictionalised period drama set around the 18th Century. In the year 2008, Plaintiff's work condensed into a short cinematography film having a runtime of 10 minutes, written and directed

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by the Plaintiff, wherein the story created by the Plaintiff was set in the 19th Century. In October 2008, the film was screened at the Spinning Wheel Film Festival, Toronto, under the title 'Kabu na chain *Khet*'. Plaintiff continued to flesh out the work further and wrote a full-fledged story/script/screenplay, which was then registered with "The Film Writer's Association".

The suit was filed on the premise of the trailer of the impugned film, which was released on YouTube, and thereafter, upon theatrical release, Plaintiff alleged that the impugned film was copied and plagiarised as it has substantial similarities with Plaintiff's work. The Defendant sought relief from the Court for the release of the film on the OTT platform, citing that it would lead to a breach of contractual obligations with third parties and that it would likely face irreparable injury.

On the other hand, if the Plaintiff succeeds, it can always be monetarily compensated. However, the Plaintiff opposed the release of the film on OTT on the grounds of infringement of copyright subsisting in its literary work by making a substantial reproduction as well as breach of confidence as Defendants No. 2, 5 and 6 admittedly had access to Plaintiff's entire literary work, which was evident from the host of correspondence placed on record by the Plaintiff.

The Court vide its order dated August 18, 2023, balanced the equity between the parties by allowing the Defendant to release the impugned film on the OTT platform on condition of depositing INR One Crore with the Registrar General of the Court and in the event of failure to deposit by the date fixed by the Court, an injunction would operate on its release.

However, vide judgment dated October 10, 2023, the Court held that there were more dissimilarities between the script of the impugned film and Plaintiff's work, and the similarities were insufficient to constitute copyright infringement. Therefore, the court rejected the interim relief, passed an order in favour of the Defendant and dismissed the application made by the Plaintiff under Order XXXIX read with Rules 1 & 2 of the Civil Procedure Code, 1908.

The Court, while rejecting the interim injunction in its judgement dated October 10, 2023, reiterated what has been held by the Hon'ble Supreme

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Court in *R.G. Anand v. Delux Films and Others ((1978) 4 SCC 118),* that there is no copyright in ideas and copyright can only be claimed in the expression of the ideas as also that there must be a substantial similarity between the two rival works for the Plaintiff to claim copyright infringement. However, in the present case, the ideas in the script of the Plaintiff cannot be given copyright protection, more so in the stock elements. A comparison of the script and the impugned film does not leave an impression that one is a substantial copy of the other.

After the dismissal of the interim injunction by the Court, the defendant submitted that since no prima facie assessment was made in favour of the plaintiff, the amount deposited by the defendant should be released. The Defendant filed an application for the formation of a confidentiality club formation in terms of Rule 19 of the Delhi High Court Intellectual Property Rights Division Rules, 2022 (‘IPD Rules’) and submitted that the revenue of the impugned film 'Shamshera' should not be disclosed in public and should be allowed to file in a sealed cover to protect the interest of the Defendant in the event, the Plaintiff was not successful in the suit.

The Court accordingly, after hearing all parties, directed the Registrar General of the Court to release the amount of INR One Crore deposited by the Defendant along with interest to the Defendant and constituted a Confidentiality Club to gain access to contents of the figures filed in sealed cover. The Court further held that since the revenues of the impugned film will have a bearing at the time of assessment of damages if the suit is determined in favour of Plaintiff.

9. Protecting Intellectual Property Rights in E-Commerce: A Case Study of Copyright Infringement and Consumer Protection

Case: Abhi Traders vs Fashnear Technologies Private Limited [CS(COMM) 180/2024]

Forum: High Court of Delhi

Order Dated: February 29, 2024

Order: The present suit was filed by the plaintiff, Abhi Traders, for copyright infringement and passing off, and other reliefs, including damages against defendants who were advertising, publishing, and offering for sale the garments, which were a complete copy of the plaintiff's garments and were also misusing the photographs and images in which plaintiff owned rights. The Delhi High Court held that the plaintiff had made a case for the grant of an ex-parte ad-interim injunction, and it was also in the interest of the consumers that such look-alike products were not permitted to be sold. The Court thus prohibited Defendants 2 to 9, along with any other sellers showcasing their products on the Meesho.com platform, from reproducing, copying, publishing, or imitating any designs of the plaintiff's clothing. This injunction also extended to the prohibition against reproducing any images related to the plaintiff's products, including photographs.

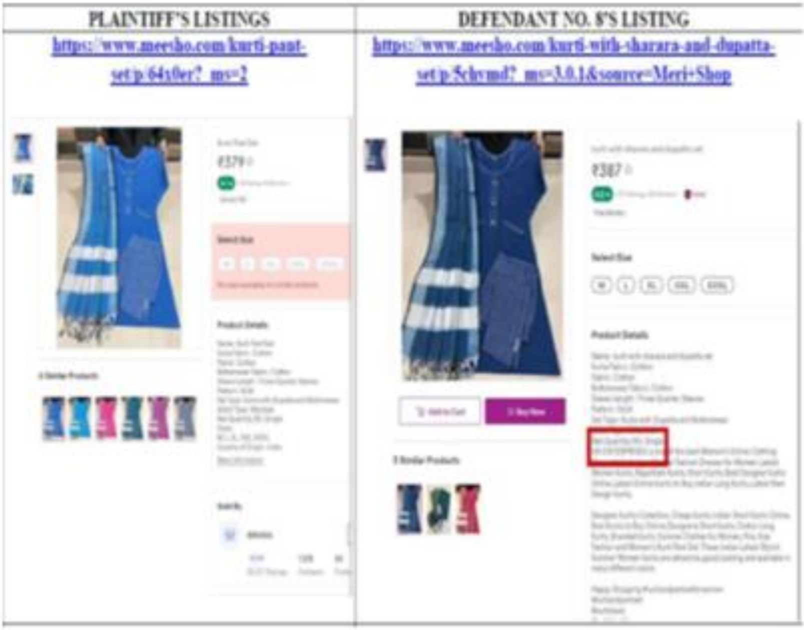
Background

The plaintiff was a retailer of clothing items for men and women, selling it under the mark "IBRANA" . They offered for sale and advertised their goods on various E-Commerce platforms like Flipkart and Defendant 1's platform 'www.meesho.com' ('Meesho'). The said products were advertised and promoted through photographs over which the plaintiff's copyright subsisted. Defendant 1, Fashnear Technologies (P) Ltd, was the company that runs 'www.meesho.com'. Defendants 2- 9 were alleged to be unlawful and unauthorised operators who used the plaintiff's copyrighted pictures and photographs and sold their counterfeit goods on the online platform owned, managed, and administered by Defendant 1.

The plaintiff submitted that it was the sole manufacturer, promoter, marketer, and seller of the products listed under its copyrighted pictures, and therefore, the question of genuine reselling or authorised reselling did not arise. It was also submitted that it did not authorise Defendants 2 to 10 to use any photographs of its products over which they had copyright. The repeated misuse of the plaintiff's copyrighted photographs, published on Defendant 1's platform, showed that Defendants 2 to 10 were riding upon the goodwill and reputation of the plaintiff and making unauthorised gains.

Plaintiff submitted that Defendants 2 to 10 were not only replicating the plaintiff's products but were also using identical photographs for marketing purposes and deliberately pricing their goods lower to inflict financial harm on the plaintiff. Despite the inferior quality of Defendants 2 to 10 products, their external appearance was remarkably similar to that of the plaintiff's offerings, creating a deceptive semblance of equivalence that misleads consumers.

Plaintiff submitted that Defendant 1 was under an obligation to publish contact details of all sellers on its platform under Rule 5(3)(a) of Consumer Protection (E-Commerce) Rules, 2020 ('2020 Rules'). Defendant 1 provided no contact information on its website during the transaction process. The omission of essential contact information, combined with the failure to respond to legitimate requests for transparency regarding the entities involved in the sale of counterfeit goods, suggested that Defendant 1 was complicit in the activities of Defendants 2 to 9. Such conduct contravened the legal obligations incumbent upon e-marketplaces and implicated Defendant 1 in aiding and abetting other defendants in their infringing activities. Thus, Defendant 1's operations violated the regulatory framework established for e-commerce platforms, disqualifying it from availing itself of the specific immunities provided under Section 79(1) of the Information Technology Act, 2000.



Court's Analysis and Decision

The Court opined that a prima case was established as the defendants were egregiously exploiting the plaintiff's product images, listing visuals, and product designs for their financial gain, leveraging the plaintiff's reputation. Such sellers were unequivocally not entitled to replicate the plaintiff's photographs, images, or product designs, thereby harming the plaintiff.

The Court acknowledged the pivotal role of e-commerce platforms in offering new opportunities for small designers and enterprises. However, it opined that these platforms needed not to be exploited to facilitate the imitation of products and the infringement of intellectual property rights. The production of look-alike products and the misuse of product images that infringe upon the plaintiff's copyrights undermine the integrity of fair trade and competition, warranting intervention to protect the plaintiff's lawful interests.

The Court opined that the E-Commerce platform was also required to ensure that complete details of the sellers were available on the platform so that the consumer was aware of the sellers from whom the product was purchased

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and the entity listing the product. The 2020 Rules, notified on 23-7-2020, imposed an obligation on the e-commerce platform to give the full geographic address, customer care number, rating, and other feedback about the seller to enable consumers to make informed decisions at the pre-purchase stage.

The Court held that the plaintiff had made a case for the grant of an ex-parte ad-interim injunction, and it was also in the interest of the consumers that such look-alike products were not permitted to be sold. The Court opined that irreparable harm would be caused if the injunction was not granted, as on online platforms and marketplaces, it was extremely easy for sellers to proliferate the images and continue to dupe customers.

The Court thus prohibited Defendants 2 to 9, along with any other sellers showcasing their products on the Meesho.com platform, from reproducing, copying, publishing, or imitating any designs of the plaintiff's clothing. This injunction also extended to the prohibition against reproducing any images related to the plaintiff's products, including photographs. The Court directed Defendant 1 to reveal all the available details of the sellers, including the address, mobile numbers, email addresses, total sales made by the sellers, GST details, and payments made to the sellers since the time listings were put up.

10. Delhi High Court Orders Takedown of Copyrighted Content: Crackdown on Rogue Cyberlocker Websites

Case: Warner Bros. Entertainment Inc. & Ors vs Doodstream.Com & Ors [CS(COMM) 234/2024 & I.A. 6322/2024]

Forum: High Court of Delhi

Order Dated: March 18, 2024

Order: This application was filed by plaintiffs seeking a decree of permanent injunction against Defendants 1 to 3, its operators, owners, partners, and all others acting for/on their behalf in any manner facilitating uploading, hosting, streaming, reproducing, distributing, making available to the public through their platforms/websites any cinematographic work/content/programme in relation to which plaintiffs own the copyright and other attendant reliefs.

The Delhi High Court directed rogue cyberlocker websites to take down all listings of copyrighted content of Plaintiffs 1 to 8, i.e., Warner Bros. Entertainment Inc., Amazon Content Services LLC, Columbia Pictures Industries, Inc., Disney Enterprises, Inc., Netflix US, LLC, Paramount Pictures Corporation, Universal City Studios Productions LLP, and Apple Video Programming LLC.

Plaintiffs were amongst the leading entertainment companies known for creating, producing, and distributing motion pictures and cinematograph films, which constituted plaintiffs' protected works under the Copyright Act of 1957, over which they had exclusive rights. Plaintiffs submitted that no other entity could, without license and authorisation from them, upload, stream, disseminate, or communicate their content in any manner whatsoever through any transmission platform, including the internet.

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Plaintiffs' grievance was against Defendants 1 to 3, Doodstream.com, doodstream.co, and dood.stream respectively, who claimed that they were 'rogue cyberlocker websites'. Plaintiffs submitted that these rogue cyberlocker websites provided an infrastructure specifically designed to incentivise hosting, uploading, storing, sharing, streaming, and downloading of copyrighted material unauthorizedly ('illegal content'). Defendant 4 was the 'server' of Defendants 1 to 3, which facilitated the storing and dissemination of illegal content. The plaintiff submitted that these rogue cyberlocker websites had created platforms that allowed users to sign in and create their own dashboards through which they were permitted to upload content. The said content then became part of a 'library of content', which allowed a global search to access it by other viewers. The plaintiffs stated that a massive amount of infringing content, on which they had exclusive rights, was uploaded by users on the defendants' websites.

The Court, after noting that the defendants were ready to comply with the complete takedown in the entirety of plaintiffs' infringed material exhaustively and completely from their platforms, issued the following directions:

- Defendants 1 to 3, 5, and 6 should take down all listings of plaintiffs' infringing contents, which will be communicated to them in writing/email through counsel for plaintiffs. This communication would be inter-se counsel, i.e., from plaintiffs' counsel to defendants' counsel so that it was responsibly received and promptly executed;
- Defendants 1 to 3, 5, and 6 should disable all features that allowed the regeneration of links and reuploading of infringing content post takedown inter alia the features like removal of the "generate link" and "disable download link (protected option)" tabs; and
- Defendants 1 to 3, 5, and 6 should file an affidavit disclosing revenues generated, duly certified by Chartered Accountant, from the time of launch of said websites till date. The Court allowed plaintiffs to monitor the takedown of their infringing listings, which they had communicated in the past and would communicate hereinafter to defendants.

11. Dynamic Injunctions Preventing Rogue Websites from Streaming IPL Matches

Case: Viacom 18 Media Private Limited vs John Doe & Ors [CS(COMM) 254/2024]

Forum: High Court of Delhi

Order dated: March 22, 2024

Order: Viacom 18 Media (P) Ltd. is a company that owns the media rights for various sporting events, including football, badminton, hockey, MotoGP, and domestic and international cricket matches organised by the Board of Control for Cricket in India (BCCI). It also operates several general entertainment channels and regional channels like Colors, Sports 18 1 SD, Sports 18 1 HD, Sports 18 Khel, MTV, MTV Beats, and Nick. The company also owns and operates the online video streaming platform 'www.jiocinema.com' and the mobile application 'JioCinema'.

In June 2022, Viacom 18 entered into an agreement with BCCI for exclusive digital media rights (for the Indian sub-continent) and television rights (for overseas) in relation to IPL Events for a period of five years, from 2023 to 2027. The agreement also granted Viacom 18 broadcast reproduction rights.

It was claimed by the Plaintiff, Viacom 18, that Defendants 2 to 7 were rogue websites that were hosting illegal and pirated content; Defendants 8 to 13 were Domain Name Registrars ('DNRs') of the domain names where the rogue websites were being hosted.

The plaintiff expressed concerns that during the IPL Events, which are renowned as some of the most popular sporting events globally, various websites, including Defendants 2 to 7, may disseminate and communicate

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cricket matches and segments thereof on digital platforms without authorisation. The plaintiff argued that numerous rogue websites may create mirror sites to continue broadcasting the IPL Events illicitly, even if the original sites were blocked or taken down. To address these concerns, the plaintiff requested a dynamic injunction to protect its work and prevent unauthorised dissemination or broadcast of matches or parts thereof in the IPL Events.

As per the Court's observation, the plaintiff has acquired the digital broadcasting rights for specific events by investing a considerable amount of funds. Any unauthorised dissemination, telecasting, or broadcasting of these events on different websites and digital platforms could create a significant risk to the plaintiff's revenue streams. These illegal activities could also devalue the plaintiff's extensive investment in obtaining these rights.

The broadcast content, including its footage, commentary, and other composite elements, was fully safeguarded under the Copyright Act of 1957. Any unauthorised use of these elements not only affects the financial returns but also infringes upon the copyright protections accorded to the broadcast content. The court opined that the issue of rogue websites engaging in the piracy of copyrighted content presents a recurring threat, particularly in the lead-up to the imminent IPL Events. These websites have shown a proclivity to illegally broadcast copyrighted works, underscoring the urgency to proactively block their access to such content. As such, judicial intervention is necessary to prohibit these rogue websites from disseminating or communicating any portions of the cricket matches/IPL Events without proper authorisation or licensing from the plaintiff.

The court ruled that the plaintiff had presented sufficient evidence to receive an interim injunction. This was due to the fact that T20 IPL matches are short in duration, and any delay in blocking access to illegal websites could result in significant financial losses for the plaintiff. Such a delay could also cause an irreparable breach of their broadcast reproduction rights. Therefore, it was essential to take swift action to prevent such infringements in order to preserve the plaintiff's investment in broadcasting rights and maintain their copyright protections.

The court issued a restraining order against Defendants 2 to 7 to prevent them or any person acting on their behalf from sharing, hosting, streaming, screening, distributing, or making available for viewing or downloading any part of the IPL Events on any electronic or digital platform without proper authorisation. Additionally, the court directed the Domain Name Registrars (DNRs) to lock and suspend the websites of Defendants 1 to 7.

The DNRs were also directed to provide complete details of Defendants 2 to 7, including email addresses, mobile numbers, contact details, and KYC details. The ISPs/TSPs involved were instructed to block the websites of Defendants 2 to 7 and issue necessary directions for blocking these websites. If any further websites are discovered that are illegally streaming and communicating content over which the plaintiff has rights during the IPL Events, the plaintiff was given the right to communicate the details of such websites to the Department of Telecommunications (DoT) and the Ministry of Electronics and Information Technology (MeitY) for the issuance of blocking orders.

12. Copyright and Renunciation: Legal Implications of a Sanyasi's Literary Works

Case: The Bhaktivedanta Book Trust India vs Www.Friendwithbooks.Co [CS(COMM) 88/2021 & I.A. 78/2023]

Forum: Delhi High Court

Order Date: April 5, 2024

Order: The Plaintiff filed this application under Order XIIIA of the Code of Civil Procedure, 1908 ("CPC") seeking summary judgment in favour of the Plaintiff and against the Defendant. The issue being considered for this application is whether a sanyasi (renunciate) is entitled to own copyright in literary works of his creation.

The Plaintiff, Bhaktivedanta Book Trust India, is a public charitable trust registered under the Bombay Public Trusts Act, 1950. It is engaged in printing, publishing, and distributing books, writings, and speeches of His Divine Grace A.C. Bhaktivedanta Swami Prabhupada ("Srila Prabhupada"), the author/settlor of the Plaintiff Trust.

The Plaintiff claimed that Srila Prabhupada relinquished his worldly possessions, became a sanyasi in 1959, and set out to America in 1965. He established the 'International Society for Krishna Consciousness' ("ISKCON") in the year 1971 in Bombay under the Bombay Public Trusts Act, 1950. Throughout his lifetime, Srila Prabhupada delivered thousands of lectures and wrote innumerable letters and books about his teachings, essentially translations and explanations of ancient Vedic texts and those of the Bhagavad Gita. These books were used as the primary medium to propagate ISKCON, which eventually became a worldwide movement.

Plaintiff Trust was established by a deed of trust dated 30 March 1972 and registered with the Charity Commissioner. Srila Prabhupada was also one of the first three trustees of the Trust. Vide a deed of confirmation dated 15 January 1975, the settlor (Srila Prabhupada) ratified the contents of the trust deed, and the copyright in the works authored by him was assigned to the Plaintiff Trust.

Srila Prabhupada passed on in November 1977. The Plaintiff Trust went on to edit and format his manuscripts, writings, and speeches and publish them as books. The books published by the plaintiff Trust include over 70 volumes based on the writings of Srila Prabhupada. These publications achieved huge renown and success, particularly in their reach across the world, and several hundred versions of the translations of the same are currently being disseminated.

During an anti-piracy sweep, as claimed by Plaintiff, carried out on the internet in December 2020, it transpired that certain websites, such as that of Defendant, www.friendwithbooks.co, were carrying complete copies of some of the books in which copyright vests in Plaintiff Trust. Not having authorised any third party, including the Defendant, to reproduce the books, store them in an electronic format, communicate them to the public, or create sound recordings, Plaintiff filed the instant suit seeking a decree of permanent injunction restraining the Defendant from infringing their copyright under Section 14(a) of the Copyright Act, 1957.

In February 2021, this Court granted an ex parte ad interim injunction restraining the Defendant, its directors, proprietors, principal officers, servants, agents, assignees, representatives, and all others acting for and on its behalf from engaging in or authorising the reproduction of the Plaintiff's books and artworks in any material form, including the storing thereof in the electronic medium, communicating the books (including by way of sound recordings) and artworks to the public, issuing copies of the Plaintiff's books and artworks through any website including the one at www.friendwithbooks.co, or doing any other act amounting to infringement of Plaintiff's copyright in their books and artwork.

Subsequently, pursuant to notice, counsel for the Defendant appeared and stated on instructions that, in compliance with the injunction order, the Defendant took down all references and content relating to the Plaintiff's books, artworks, and sound recordings from all possible media, digital or otherwise, including from their website www.friendwithbooks.co. The statement was taken on record by the Court on 15th February 2024, and the ad interim order of 22nd February 2021 was, therefore, made absolute.

Consequently, the plaintiff pressed this application seeking summary judgment. While counsel for the Defendant had no quarrel or dispute about the relief sought in the suit being awarded in favour of the Plaintiff, a fundamental objection was raised in that a sanyasi, as Srila Prabhupada was, could not own copyright in his works since post renunciation, there could be no ownership of property, as renunciation is akin to a civil death.

This issue requires some deliberation on the respective submissions made by counsel for the Plaintiff and Defendant.

Submissions on behalf of Plaintiff:

The Plaintiff argued that there exists no legal prohibition barring a sanyasi from owning private property, including intellectual property. He contested the notion of 'civil death' in relation to renunciates, clarifying that it typically applies to intestate succession scenarios. Rajagopal referenced legal precedents, such as Swami Dr. Kishore Dass Ji v. State and Anr, to support the claim that renunciates can indeed own and bequeath property. Furthermore, The Plaintiff highlighted a decision by the Madras High Court in Sulamangalam R. Jayalakshmi and Anr. v. Meta Musicals & Ors, which rejected the argument that renunciation by a swami negates copyright ownership, asserting that copyright is governed solely by statutory provisions. He concluded by emphasising that Srila Prabhupada's assignment of copyright to the Plaintiff Trust during his lifetime solidifies the continuation of his rights even after embracing sanyasa.

Submissions on behalf of Defendant:

The Defendant, however, stated that Srila Prabhupada’s situation was not akin to that of a swami in a monastic order and, therefore, the transmission of rights from a sanyasi cannot be acceptable under law. He conceded, however, that there was no statutory bar relating to the extinguishment of rights upon renunciation by a swami.

Court’s Analysis and Conclusion:

After hearing counsel for both parties and reviewing the evidence, the Court determined that the issue must be evaluated purely within a legal framework rather than through a simplistic understanding of renunciates' rights. Neither counsel cited any law prohibiting renunciates from holding property, leading the Court to rely on judicial interpretation.

A renunciate relinquishes possessions, rights, or claims, akin to the legal concept of "relinquishment," which has implications in property, testamentary, contract, and intellectual property law. Individuals acquire property during their lifetime through various means, and the question arises regarding relinquishing property rights within the recognised legal framework.

Section 21 of the Copyright Act outlines the procedure for relinquishing copyright, but there's no evidence of Srila Prabhupada executing such a relinquishment. Instead, he assigned his rights to the Plaintiff Trust during his lifetime, which aligns with Sections 18 and 19 of the Copyright Act.

The Court reviewed legal precedents, including decisions from the Supreme Court and High Courts, which affirm the rights of ascetics to hold property and copyright. These decisions reject the notion that renunciation automatically extinguishes property rights. The Court emphasised that property rights are only extinguished through a legal process, which didn't occur in this case.

Given the Defendant's acceptance of the injunction and the existence of copyright in Srila Prabhupada's works, the Court found no grounds for the Defendant's defence. The Court ruled in favour of the Plaintiff Trust, decreeing the suit accordingly under Order XIIIA of CPC. The Court granted the Plaintiff's application with no further evidence to be presented and compliance with procedural requirements.

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13. Legal Battle Royale: The MYA Copyright Conundrum

Case: Mohd Shakir vs Gopal Traders and Anr [C.O.(COMM.IPD-CR) 699/2022]

Forum: Delhi High Court

Judgment Date: April 8, 2024

Judgment: The Delhi High Court, in a recent Judgment, dismissed a rectification/ cancellation application for the artistic work 

Mohd Shakir ("**the Petitioner**") filed an application under Section 50 of the Copyright Act, 1957 ("**the Act**") for the rectification/cancellation of the artistic work titled "**MYA**" 

("**impugned mark**") registered under No. A-120894/2017 with authorship claimed by Mr. Amit Gupta, Ms/ Gopal Traders, against Ms/ Gopal Traders ("**Respondent No. 1**"). The matter was initially filed before the Intellectual Property Appellate Board and was subsequently transferred to the Delhi High Court ("**DHC**").

The Petitioner herein claims to be the originator, owner, inventor, proprietor and creator of the label mark/artistic work 

and also an applicant of the pending device mark 

filed in Class 34 dated September 06, 2022.

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Respondent No. 1 is the registered proprietor of the device mark under no.1521433 in Class 31 for *scented supari, sweet supari, mouth fresheners, pan masala and pan chutney* claiming use since April 01, 2010; and in Class 35 for *services relating to distribution, trading and marketing of paan, sweet supari, smoking articles etc*.; and in Class 39 for *transportation, packaging and storage of smoking articles, hukka, pre-rolled smoking cones, cigar, cigarettes, tobacco products, etc*. Respondent No. 1 is also an applicant/ proprietor of several variants of the trade mark MYA against which objections/rectifications have been filed by the Third Party.

The third party is Mr. Youssef Anis Mehio of Al Zarif, Rachid Nakhle Street, Mehio Building, Beirut, Lebanon and Mya International Sal Off Shore of Zarif-Rashid Nakhleh, Str-Mehio Bldg-Beirut ("**Third Party**") who, since 2005, is the registered proprietor of the device trade mark MYA, in classes 18 and 34 in Australia, EU, China, Lebanon & Indonesia. In India, the third party's mark in Class 34 claiming user since June 05, 2006, is pending registration. The said mark is registered in Australia.

The Petitioner essentially claimed that the impugned mark (applied for copyright registration, by Respondent no.1 on June 06, 2017, claiming first publication of the mark in India in 2010), was not the original work of the Respondent No. 1 but was that of the Third-party.

The Petitioner claimed that Respondent No. 1 is infringing and had blatantly copied the third party's prior adopted, prior used and registered mark, artwork .

The Petitioner claimed that in the Examination Reports of the trade mark applications of Respondent No. 1, the Third Party's mark MYA had been cited wherein Respondent No. 1 had taken a stand that its marks are not deceptively similar and were not being worked in India. The Petitioner claimed that neither had Respondent No. 1, in its defence, mentioned that it was the originator, owner, creator or proprietor of the impugned artwork nor had it served any notice under Rule 16(3) of the Copyright Rules, 1958, upon the Third party who had a valid interest in the work.

The Petitioner stated that in view of the Berne Convention, copyright registration is protected worldwide through its member countries and is valid throughout all the territories. Further, the Petitioner pointed out the difference between trade mark and copyright and stated that a trade mark protects the user and not the creator and is territorial in nature whereas copyright registration transcends boundaries.

However, on January 21, 2021, Respondent No. 1 filed a criminal complaint under Sections 63 and 68A of the Act read with Section 420 of the Indian Penal Code,1860 ("IPC") against the Petitioner on the basis of the impugned registered copyright subsequent to which the FIR was registered.

It is the Petitioner's case that in view of the FIR filed against him whilst relying upon judgments and as per Section 50(b) of the Act, which provides for an application by any aggrieved person for rectification of the register before the High Court to expunge any entry wrongly made in or remaining on the register, that the Petitioner is the *"aggrieved person"* and that the impugned mark should be rectified/cancelled. It is also the Petitioner's case that in view of Sections 13(1)(a) 17(a) of the Act, as well as the Third Party Registrations that were mentioned in the oppositions filed by the Third Party against Respondent No.1's trademark applications, there existed no originality in the impugned mark and that Respondent no.1 cannot claim originality in the said work.

Submissions of the Respondent

It is the Respondent's case that the present petition was not maintainable as the Petitioner did not have a locus and was not an aggrieved person. The Respondent further contended that pursuant to its copyright application, and in view of Section 45 proviso of the Act read with Rule 24(3) of the Trade Mark Rules, 2002, the Registrar conducted a search for any identical/similar marks subsisting on the register of trade mark and upon no result being obtained, the Registry issued a search certificate thereby resulting in the subsequent registration of artistic work in the name of Respondent No. 1.

Respondent No. 1 further contended that the Petitioner, in its opposition against the Third-party's registration applications, had taken a stand that the

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mark adopted by the Petitioner is an inherently and highly distinctive trade mark that has been openly, extensively and continuously used and that the Petitioner was also originator, owner, inventor, proprietor and creator of artistic work of copyright titled: 'THE MYA' under Copyright Act. Considering that the Petitioner itself was claiming ownership, Respondent No. 1 contended that the Petitioner was estopped from claiming that the Third Party is the author of the artistic work and that such contrasting and conflicting statements would not entitle the Petitioner to relief.

Respondent No. 1 further contended that the Petitioner, in its reply to the Examination Report dated September 22, 2020, had stated that the Petitioner's mark was different from Respondent No. 1's mark, thereby implying that Respondent No. 1, who had been using the word and device mark MYA and other formative marks since 2010, was the original adopter of the artistic work. Respondent No. 1 contended that the Petitioner adopted MYA in 2019 and had admitted that Respondent No. 1 was the earlier adopter. Respondent No. 1 further submitted that no identical or deceptively similar marks were cited by the Registry in its Search Report and certificate.

Respondent No. 1 also contended that the Third Party was a not party to the present proceeding and that the Petitioner was merely agitating the present issue on behalf of the Third Party. In view of the above, the Petitioner was estopped from objecting to the impugned mark as the Petitioner itself had adopted a mark MYA in a similar manner as well as opposed several applications of the Third party. Respondent No. 1, whilst relying upon judgments, contended that the Petitioner cannot approbate and reprobate considering they had claimed ownership of the said artistic work and now state that the artistic work is of the third party.

Submissions of the Rejoinder

The Petitioner contended that the adoption in 2010 by Respondent No.1 was dishonest as the Third Party had a 2006 prior registration and that Respondent No. 1 had given a contrary reply that it was using its mark since 2019 and the same was not being marketed in India. The Petitioner also relied upon the Ganga Vishnu judgment differentiating between the objection and intention of the Copyright Act and the Trademarks Act and that it was in the interest of the public to have a wrongful entry removed, and that if the mark continued to remain on the register, it would curtail or limit the legal right of the aggrieved person.

The Petitioner also relied upon Mohd. Naseer wherein, it was held that since petitioner and respondent were in the same trade and respondent had launched criminal proceedings against petitioner alleging violation of his mark, the same was enough for petitioner to assail the existence of the registration of their artistic work.

Court Analysis and Order

The Court opined that it was ex-facie clear and incontrovertible that an application under Section 50 of the Act can only be filed by a *person aggrieved* and that rectification can only follow in three situations, namely (a) entry wrongly omitted; (b) entry wrongly made or remaining on the register; and (c) correction of an error or defect in the register. The present case of the Petitioner fell under Section 50(b) entry wrongly made or remaining on the register.

In view of the above, the Court opined that in the present case, the Petitioner had to prove two things, namely that he is a '*person aggrieved'* and that the entry in the copyright register was '*wrongly made*'. The Act, however, provided no definition of the *person aggrieved,* and the Court, whilst placing reliance on the decision of Ganga Vishnu Raheja, observed that as per the Trade Marks Act, a person aggrieved was one against whom infringement action is taken or threatened and also relied on judgments that held that *locus standi* had to be ascertained liberally. The Court held that, in the present case, the Petitioner is an *aggrieved person* on account of the infringement action taken by Respondent no.1. With regard to *wrongly made*, the Court opined that the Petitioner's reliance on the third party trade mark registrations was unsustainable as the third party was not a party to the present proceeding nor was any attempt made by the Petitioner to make the third party a party to the present proceeding. The Court held that:

> *"In the absence of the third party, on whose registrations petitioner seeks to rely upon for asserting that the copyright in favour of respondent no.1 does not exist, there can be no incontrovertible*

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> *evidence which petitioner can rely upon to prove that the artistic work in which the copyright is registered, was originally authored by the third party or was otherwise rightfully claimed by the third party. Merely relying upon trademark registrations in favour of the third party received in Australia and other countries cannot be undisputed evidence of the fact that the original author or legitimate owner of the copyright in the said artistic work is the third party and no one else. Accepting petitioner's submissions in this regard would amount to rectifying the copyright register on the basis of extraneous and unverified evidence.*"

The Court further opined that reliance on the Berne Convention was not in favour of the Petitioner as the Berne Convention simply attempts to bind all contracting parties to allow seamless protection of copyright and to guarantee rights in protected works. The Berne Convention provides the author of a work to protect its rights irrespective of territorial boundaries. The Court held that in the present case, if, as per the petitioner, the original author in the said artistic work was the Third Party, then it would be up to the Third Party to assert its rights, and the same would be assessed based on the evidence produced by the Third Party.

The Court was also of the view that the Petitioner was standing in multiple boats as the Petitioner had filed oppositions to both the Third Party and Respondent No.1's Indian trade mark applications, and in turn, the Third Party has filed oppositions or rectifications against the Petitioner and Respondent No. 1's applications. The Court was of the view that the inter se slugfest between Petitioner, Respondent no.1 and third party with respect to the mark 'MYA' through oppositions and rectifications could not serve to distil out an inviolable conclusion that the original authorship in the artistic work was that of the Third Party. Therefore, the impugned registrations ought to be rectified and expunged from the copyright register.

The Court further agreed with Respondent No.1's reliance on the judgment of Raman Kwatra regarding the approbation and reprobation by the Petitioner in light of their own trade mark registrations with a similar artistic work.

The Court further held that Section 48 of the Act did not prevent any other party from asserting that they are the original authors of the artistic work and that the register of copyrights is only prima facie evidence of particulars entered therein. It would be, therefore, for the third party or any other party that claims authorship to assert their rights and not for the petitioner to take the crutches of a third party's position, that too presumed and in their absence. Accordingly, the petition was dismissed.

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14. Balancing Rights: Delhi H.C.'s Ad Hoc Arrangement in PPL vs Pass Code Hospitality

Case: Phonographic Performance Limited vs Pass Code Hospitality Private Limited & Ors. [C.S. (COMM) 267/2024, I.A. 7255/2024]

Forum: Delhi High Court

Order Date: April 10, 2024

Order: In a recent development in the case of Phonographic Performance Limited (PPL) versus Pass Code Hospitality Private Limited & Ors., the Delhi High Court issued an interim order on April 10, 2024, about using copyrighted sound recordings.

The plaintiff, Phonographic Performance Limited, sought permanent injunctions against the defendants, restraining them from using copyrighted works on the plaintiff's website and playing sound recordings at their Food and Beverages (F&B) outlets/restaurants without proper licensing. PPL claims ownership of copyrights in song recordings in its repertoire and issues licenses under Section 30 of the Copyright Act, 1957, to communicate its sound recordings to the public.

The dispute arose when the defendants allegedly exploited sound recordings owned by the plaintiff without obtaining appropriate licenses. Previous legal proceedings in May 2022 resulted in an interim injunction in favour of the plaintiff, followed by a settlement agreement in December 2022. However, disagreements emerged during the license renewal process, leading to the present suit.

The Court heard the contentions of parties where the plaintiff argued for the liberty to determine license rates for their sound recordings. On the other side, the defendant contended that the proposed license fee increase was

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unreasonable and not legitimate, citing statutory provisions and concerns about monopolistic practices.

After considering the arguments from both parties, the Court devised an ad hoc arrangement to address the immediate need for access to sound recordings while preserving the rights and contentions of both sides. The key provisions of the arrangement include a deposit of ad hoc license fee by the defendant, issuance of a temporary license by the plaintiff, and the retention of a balance amount in an interest-bearing fixed deposit.

This interim solution, although unique to the circumstances of the case, aims to balance the equities between the parties and ensure access to sound recordings pending further judicial proceedings.

The Court has scheduled the next hearing for July 19, 2024, allowing time for additional submissions.

The decision underscores the importance of copyright protection in the digital age and the complexities involved in licensing arrangements, particularly in the entertainment and hospitality sectors.

15. Landmark Intellectual Property Case: Bulgari S.P.A. vs. Prerna Rajpal

Case: Bulgari S.P.A vs. Prerna Rajpal. [CS(COMM) 341/2024]

Forum: Delhi High Court

Order Dated: April 23, 2024

Order: The Delhi High Court has delivered a significant verdict in Bulgari S.P.A. vs. Prerna Rajpal, registered as C.S. (COMM) 341/2024. The case involved alleged copyright infringement and passing off in the luxury jewellery domain.

Background

Bulgari S.P.A., an esteemed Italian luxury brand renowned for its exquisite jewellery, watches, fragrances, and accessories, filed a suit against Prerna Rajpal, trading as 'The Amaris Flagship Store,' alleging infringement of their intellectual property rights. The dispute primarily revolved around Bulgari's iconic collections, namely "SERPENTI" and "B.ZERO1," and a specific product, the "Serpenti Ocean Treasure Necklace."

Plaintiff's Contentions

Bulgari S.P.A. asserted its exclusive rights over the trademark "SERPENTI" and its derivative variations, along with the copyright in the intricate design of the Serpenti Ocean Treasure Necklace. The plaintiff contended that Prerna Rajpal's store substantially replicated Bulgari's designs, infringing upon their copyright and trademarks.

Defendant's Response

In her defence, Prerna Rajpal acknowledged drawing inspiration from Bulgari's designs but denied any similarity between the contested products.

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However, she assured the removal of SERPENTI-related designs from her platform.

Court's Observations and Order

The court found merit in Bulgari's claims, establishing a prima facie case of copyright infringement and passing off against Prerna Rajpal. The similarity between the contested products and the defendant's acknowledgement of inspiration from Bulgari's designs strengthened the plaintiff's case.

Recognising the potential irreparable harm to Bulgari's brand reputation, the court granted interim injunctions against Prerna Rajpal and her associates. They were restrained from manufacturing, marketing, or selling products resembling Bulgari's copyrighted design and trademarks until further notice.

Conclusion

This ruling sets a precedent for the stringent protection of intellectual property rights, particularly in the luxury goods sector. It underscores the significance of originality and brand integrity, sending a clear message against unauthorised imitation and infringement.

The Bulgari S.P.A. vs. Prerna Rajpal case represents the judiciary's commitment to upholding intellectual property rights and fostering innovation in the commercial landscape. As the legal battle unfolds, it reflects the evolving dynamics of trademark and copyright protection in the digital age, shaping the future trajectory of brand ownership and creative expression.

PATENTS

1. Writ Jurisdiction of a High Court Not Dependent Upon Where the 'Appropriate Patent Office' is Situated

Case: University Health Network v. Adiuvo Diagnostics Pvt. Ltd. [Writ Appeal No.3076 of 2023]

Forum: Madras High Court

Order Dated: January 03, 2024

Order: In the case of *Filo Edtech Inc. vs Union of India & Anr [C.A.(COMM.IPD-PAT) 30/2023]*, the Hon'ble Delhi High Court held that the seat of the High Court for filing an appeal would be based on the location of the appropriate office as defined in Rule 4 of the Patents Rules, 2003 (as amended). The filing of an appeal is a right of action as stipulated in the Patents Act under Section 117A(2) of the Patents Act, 1970 and therefore, the seat of the High Court will be governed by the definition of appropriate office as defined in Rule 4(2) of the Patents Rules which uses the expression "in respect of any proceeding under the act". It is well settled that the location where the patent application is filed is the appropriate office for that application, irrespective of where that application was examined and the hearing was conducted.

This is also clear from the proviso of Rule 28(6), which states that if a hearing is conducted through video conferencing, such a hearing shall be deemed to have taken place at the appropriate office. However, a writ proceeding is not stipulated under the Patents Act, and therefore, a legal issue arises as to which High Court will have jurisdiction to entertain a writ

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petition arising on any issue concerning any proceeding before the patent office.

For example, in the case of pre-grant opposition, when the opposition is dismissed, the Opponent has no remedy to file an appeal against the dismissal of its pre-grant opposition than to file a writ petition. In this circumstance, what will be the seat of the High Court to invoke writ jurisdiction if the patent application was filed in one office, whereas the hearing was conducted by a controller of another office? This question was settled by a division bench of the Madras High Court in the case of **University Health Network vs Adiuvo Diagnostics Private Limited [Writ Appeal No.3076 of 2023]**.

Brief Facts of the Case

The Appellant in the above case filed a writ appeal under Clause 15 of Letters Patent to set aside the order of the learned Single Judge, dated 27.09.2023, passed in W.M.P.(IPD). No. 7 of 2023 in W.P.(IPD). No. 23 of 2023. The Appellant in this writ appeal is the fourth respondent in the writ petition filed by the respondent in the present writ appeal. The respondent/writ petitioner is a company based in Chennai and claims to be into creating platform technologies in the field of Optoelectronics. The respondent/writ petitioner had filed a pre-grant opposition against the Appellant’s patent application no. 9067/DELNP/2010, which claims a patent for a device and method for fluorescence-based imaging and monitoring. The said patent application was filed at the Delhi patent office.

However, this application was allotted to a controller located in Chennai for examination. The pre-grant opposition in this application was filed in Delhi by the respondent/writ petitioner. However, the pre-grant opposition was also assigned to the same Controller. The Controller examined the pre-grant opposition and conducted enquiry from Chennai, including physical hearings in Chennai on various dates. After the conclusion of the hearing, the Controller dismissed the opposition and granted the above patent application a patent no. 439474 on 19.07.2023.

Aggrieved by this order of the Ld. Controller, the respondent/writ petitioner filed a writ petition of Certiorarified Mandamus, challenging the orders dismissing the opposition as well as a grant of patent and with a consequential prayer to remand the matter for hearing the pre-grant opposition application afresh for violation of the principle of natural justice for the reason that the impugned order did not consider the expert evidence of the writ petitioner. It is also silent about the detailed written submissions filed by the writ petitioner.

The Hon’ble single bench had admitted the writ petition and held that since the petitioner and the fourth respondent were competitors in the market, granted an ad-interim order restraining the fourth respondent from prosecuting the petitioner based on Patent No.439474, provided that the petitioner uses devices and methods for fluorescence-based imaging and monitoring, based on its patent. During the proceeding in the writ petition, the Appellant/respondent no. 4 had raised an issue of non-jurisdiction of this High Court on the ground that since the patent in question was filed in Delhi, the appropriate office for this patent application is Delhi.

Therefore, the Delhi High Court is the correct forum to entertain this writ petition. However, the Hon'ble single bench rejected this argument and held that since a part of the cause of action arises in Chennai, this Court has jurisdiction to hear this writ petition. The Hon'ble Single bench held that the jurisdiction of this Court under Article 226 of the Constitution of India is not dependent upon where the 'appropriate patent office' is situated. Therefore, Rule 4 of the Patents Rules is not dispositive of the jurisdiction. Aggrieved by the decision of the Hon'ble single bench, the Appellant filed a writ appeal before the division bench of this Hon'ble Court.

Issue before the Division Bench

The issue before the division bench was whether the Writ Petition before this Court was without territorial jurisdiction considering the fact that the appropriate office for the subject patent application was Delhi, and the subject pre-grant opposition was filed before the Delhi patent office. The Delhi High Court would only be the convenient forum, and the action of the writ petitioner amounts to forum shopping.

Applicable RULE/LAW and Submission of the Parties

Section 2(1)(i) of the Patents Act, 1970 (hereinafter "the Act") gives the relation of the High Court with respect to a State or Union Territory. Rule 4 of the Patents Rules, 2003 (as amended) defines what is an appropriate office. Rule 28(6) of the Patents Rules states that a patent hearing may also be held through videoconferencing, which shall be deemed to have taken place at the appropriate office. Article 226(2) states that the power conferred by clause (1) to issue directions, orders or writs to any Government, authority or person may also be exercised by any High Court exercising jurisdiction in relation to the territories within which the cause of action, wholly or in part, arises for the exercise of such power, notwithstanding that the seat of such Government or authority or the residence of such person is not within those territories.

The Appellant submitted that the appropriate office, as per Rule 4 of the Patents Rules, is only the Delhi office. An automated system makes the allotment for administrative exigency, and as per Rule 28(6) of the Patents Rules, the hearing is deemed to have taken place only in Delhi. The Appellant further relied on the case of *Dr. Reddy's Laboratories vs The Controller of Patents [(2014) 5 LW 289 (DB)]* and *Filo Edtech Inc vs Union of India and Anr*, contending that a mere hearing at Chennai alone would not confer jurisdiction on the Madras High Court. The Appellant further claimed that the defect of jurisdiction strikes at the very authority of the Court to pass any order [Kiran Singh and Ors. vs Chaman Paswan and Ors (AIR 1954 SC 340)].

The writ petitioner/respondent contended that this Court has territorial jurisdiction as part of the cause of action that arose in Chennai. This Court cannot be termed an inconvenient forum and further submitted that the most critical parts happened only in Chennai, i.e., the hearing. The writ petitioner/respondent contended that when both the writ petitioner and the fourth respondent (Appellant) and their attorneys and agents have an office in Chennai, and the matter has been filed and entertained in Chennai, it cannot be said that the Madras High Court is an inconvenient forum.

Decision of the Court

The Hon'ble Court, after hearing both parties, held that since the instant matter was filed under Article 226 as a writ petition, the jurisdiction of the High Court will be based on the provision of Article 226(2), which states that any high court exercising jurisdiction in relation to the territories within which the **cause of action, wholly or in part**, arises. The Hon'ble division bench differentiated between the nature of the suit instituted and held that

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since the party has sought a remedy through a writ petition, therefore, irrespective of the location of the 'appropriate patent office', this Court would have territorial jurisdiction to entertain the matter if the part cause of action arose within its jurisdiction.

The Hon'ble division bench held that the writ petitioner has a patent and is conducting business in Chennai. The same is an integral part of the reason for the writ petitioner to oppose the grant of the patent. On the contrary, the fourth respondent is based in Canada and, through its attorney, is filing the application in India. Therefore, it cannot be said that the primary geographical area where the rights of parties play out is Delhi and that jurisdiction is artificially vested in Chennai.

If the geographical area in which the rights of parties play out is to be considered, then Chennai stands on a better footing than Delhi. The Hon'ble division bench further held that the main contention of the writ petitioner was that their expert evidence affidavit and written submission furnished post to a hearing held in Chennai was not considered; therefore, it cannot be contended that no part of the cause of action arose within the Jurisdiction of this Court. The Hon'ble division bench further clarified that deeming the provision of Rule 28(6) and definition of Appropriate office as per Rule 4 (2) of the Patents Rules is for specific purposes such as for filing of an appeal.

On the issue of forum conveniens, the Hon’ble division bench held that (i) the Appellant/fourth respondent is located in Canada and has filed the Patent Application through its attorneys; (ii) the writ petitioner is located in Chennai; (iii) both sides learned counsel and patent agents are having their offices also at Chennai, and therefore, there is no ground as why this Court should exercise restraint on the ground of forum conveniens. The Hon'ble division bench went on to state that with the advent of technology, in the times of quick and instant communication and virtual hearings, the ethos relating to forum conveniens and prejudice to the parties have all to be recalibrated. The Hon'ble division bench, in view of the above reasoning, dismission the present writ appeal.

Conclusion

On the issue of forum conveniens, one crucial factor that should have been considered for foreign companies is the address of service. In the instant matter, the Appellant filed a request for a change of agent and address of service on May 05, 2022, wherein they mentioned their address of service in Delhi. Also, the address of service of the agent of the Opponent is in Delhi. Even if a minuscule part of the cause of action arises within the jurisdiction of a Court, a Writ petition would be maintainable before the said Court. However, this is not the singular factor and the doctrine of forum convenient must be considered. The concept of forum conveniens means that it is obligatory on the part of the Court to see the convenience of all the parties before it [Sterling Agro Industries Ltd. vs Union of India & Ors. (2011 SCC OnLine Del 3162)].

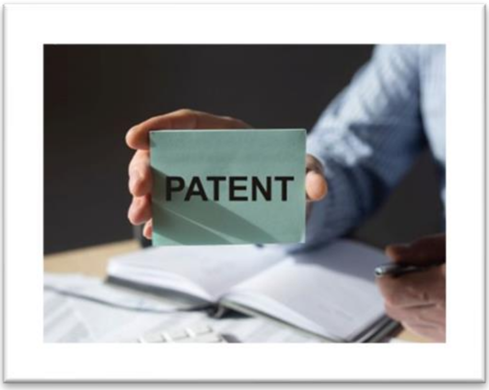
Therefore, if this factor of address of service of the Applicant and Opponent had been considered, it would have settled all the considerations for the principle of forum conveniens. Rule 4(2) of the Patents Rules uses the expression "**shall not ordinarily be changed**". The use of "ordinarily" in Rule 4(2) raises the question of in what circumstance the appropriate office, once decided, can be changed, is still to be answered. However, it is clear now that the jurisdiction of a High Court under Article 226 of the Constitution of India is not dependent upon where the 'appropriate patent office' is situated, and therefore, Rule 4 of the Patent Rules is not dispositive of the jurisdiction.

2. Can Informal Communication to the Patent Office amount to Formal Acceptable Notice

Case: Haryana Pesticides Manufactures Association v. Asst. Controller of Patents and Designs [W.P.(C)-IPD 45/2023 & CM 150/2023]

Forum: Delhi High Court

Order Dated: January 08, 2024



Order: *De*lhi High Court, in the matter titled **Haryana Pesticides Manufactures Association ('petitioner') vs Assistant Controller of Patents and Designs, Patent Office, Delhi** ('respondent'), recently gave a verdict on a critical issue of whether an informal communication sent to the Patent Office amount to a formal acceptable notice.

An Indian Patent Application titled "*Weedicidal Formulation and Method of Manufacture Thereof*" was filed by the applicant in 2010 before the Patent Office. Subsequently, after the publication of the said patent application, a pre-grant notice of opposition under Section 25(1) of the Patents Act, 1970, was filed by the petitioner challenging said patent application.

The petitioner claimed that a letter was addressed to the Controller of Patents in 2017 intimating the change in his email address. Further, on the pre-grant opposition filed by the petitioner, a hearing was scheduled by the Patent Office in October 2020, in which the petitioner claimed that the notice of hearing was served only to his old email address.

The petitioner further claimed that he sought adjournment for hearing from his new email address, for which he received intimation regarding rescheduling of hearing on both his old and new email addresses.

Thereafter, he sought a second adjournment for a hearing from his new email address; however, for a second adjournment request, the petitioner claimed that he received the hearing notice only on his old email address.

Thus, the petitioner claimed that the revised notice of hearing was received only at his old email address and that the email address by that time had become non-functional; therefore, for the aforesaid reasons, the petitioner could not attend the hearing. Later, he discovered the rejection of the opposition ex-parte in September 2023 after inquiring about the Patent Office.

Observation by the Court

The Hon'ble Court held that although the petitioner communicated to the Patent Office regarding the change in email address, the same was done by addressing a mere generic letter to the Controller of Patents (without reference to the impugned patent application), and hence, was not done formally. The Hon'ble Court also held that although there is no form prescribed, the Patent Rules do include Form 30, which is "*to be used when no other form is prescribed*", and said Form does allow an applicant/patentee/other to communicate address, including email, telephone number, mobile and fax number along with the purpose of the request, details of the request and signatures of the person applying.

The Court further held that no steps were taken by the petitioner since 2017 or even after 2020 till 2022 (a long span of two years) to ensure that the petitioner's old email address was excluded. Moreover, the Court pointed out that as the petitioner is represented through a registered patent agent and an advocate, it was to be ensured that the records were updated in all manners possible and by whatever mode acceptable to the Patent Office. The Hon'ble Court further observed that the petitioner chose to await notice from the office of the Controller of Patents rather than being diligent in inquiring into the matter and ensuring that his new email address was placed on record for this impugned patent.

The Hon'ble Court observed that the petitioner could have moved for a post-grant opposition in January 2023 or even in September 2023 (when they found out about the rejection of their opposition and grant of patent).

Conclusion

The Hon'ble Court emphasised the relevance of Form 30 of the Patents Act and explained that where there is no specific form provided for change of address or change of email or any other miscellaneous purpose, Form 30, which is generic in nature, must be used. Any informal communication or communication in the Form of a general letter or email may not be binding on the Patent Office. For a communication to the Patent Office to be binding, it should be in the specific Form provided under the Patents Act, and in case no particular form is provided, then it must be in Form 30 of the Patents Act.

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3. The Interplay of Infringement and "Me Too" Registration

Case: GSP Crop Science Pvt. Ltd vs Devender Kumar [CS(COMM) 55/2024 & I.A. 1383/2024, I.A. 1384/2024]

Forum: Delhi High Court

Order Dated: January 19, 2024

Order: In an infringement suit, *GSP Crop Science Pvt. Ltd ('plaintiff') vs Devender Kumar ('defendant')* against the defendant's unauthorised use of the plaintiff's patent, the Delhi High Court, in its order dated 19th January 2024, granted interim relief to the plaintiff based on the infringement analysis (as supplied by the plaintiff) and "me too" registration of the defendant's product.

The plaintiff owns the suit patent (IN 384184) for "Liquid Composition of Pendimethalin and Metribuzin." The patent relates to a liquid formulation comprising Pendimethalin (ranging from 10 to 40% w/w) and Metribuzin (ranging from 1 to 10% w/w) as active ingredients along with inert excipients, wherein Pendimethalin to Metribuzin is in the ratio of 1:1 to 25:1.

The plaintiff asserted that the patented formulation provides a convenient combination dosage form of the active ingredients that have increased efficacy, stability and bio-equivalence to the corresponding free combination of the same active ingredients.

The plaintiff also obtained a registration for formulations of Pendimethalin 35% + Metribuzin 3.5% under Section 9(3) of the Insecticides Act, 1968, which are used in its commercialised product, 'Platform'. In November 2023, the plaintiff learned that the defendant had launched a product called 'Pendamic', which is an imitation of the plaintiff's novel and innovative

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product. After acquiring and scrutinising samples of the defendant's product, the plaintiff discovered that the label on these products, setting out the ingredients used therein, clearly matches the claims of the suit patent. To support its argument, the plaintiff presented the infringement analysis of the defendant's infringing product, wherein the comparison suggested that the use of active ingredients in the impugned product directly falls within the claims of the suit patent.

The plaintiff also argued that the defendant's infringement is further substantiated by their acquisition of a registration under Section 9(4) of the Insecticides Act, 1968. Such registration, commonly known as a "me-too" registration, is only granted when a First Registration already exists under Section 9(3) of the said Act.

This, as per the plaintiff, is effectively an admission of the fact that the defendant was aware of the suit patent and that the defendant's product comprises a formulation that is identical to the suit patent. Moreover, it was stressed that the defendant could not deny being aware of the suit patent as the plaintiff's product clearly carries a 'Patented' notice on the label, alerting any viewer to the fact that the plaintiff's product 'Platform' is patented.

On considering the plaintiff's contentions and also analysing the infringement analysis as provided by the plaintiff, the High Court held that the plaintiff had established a **strong *prima facie* case** to demonstrate infringement of the suit patent. The Court further noted that the defendant's product was stated to have been launched *only* in the year 2023, as evidenced by the packaging of the product.

Therefore, the **balance of convenience** also lies in favour of the plaintiff. Finally, it was noted that if the defendant is not restrained, the sale of the allegedly infringing products is **likely to cause harm** and damage to the plaintiff. Thus, by applying the standard of the triple test, the Court granted an *ex-parte* ad interim injunction in favour of the plaintiff.

The decision strengthens the enforcement of patents in the agrochemical sector. The term "me too" refers to products that closely resemble or imitate existing products on the market. Infringement occurs when these "me too" products violate the intellectual property rights of the original product. In this case, the plaintiff's analysis demonstrated a case of direct (literal) infringement by one-to-one mapping between the features of the impugned product and the suit patent. The "me too" registration of the defendant's product further added weight to the plaintiff's infringement case.

4. Dispensing with Advance Service for Overarching Consideration of Justice, Equity or Public Interest

Case: Incyte Holdings Corporation & Ors vs Tiba Pharmaceutical Pvt Ltd [CS(COMM) 81/2024]

Forum: Delhi High Court

Order Dated: January 29, 2024

Order: Often, in a commercial suit, the plaintiff always moves an application for an exemption and does not affect an advance service on the defendant. Most of the time, the only region stated in that said exemption application is that the plaintiff has filed an application under Order 39 Rules 1 and 2 of CPC for an interim injunction. It is essential to understand here the underlying public interest in the process of advance service to the defendant. A contested order passed by a court does no prejudice to either side and also substantially insulates the Court from making errors, either of facts or of law. But what could be all situations and circumstances in which the exemption from advance service to the defendant is justified.

Rule 22 of Delhi High Court IPD Rules, 2022 (hereinafter "the IPD Rules") casts an obligation on the party approaching a court to serve the respondent at least two working days in advance an advance copy of the matter along with intimation of the likely date of listing. This requirement may be dispensed by the Hon'ble Court only if the facts and given circumstances of that case warrant and, of course, on an application by parties. As per the IPD Rules, it is the discretion of the Court to dispense with an advance service based on the facts and circumstances of each case.

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Also, as per Rule 6 of High Court Of Delhi Rules Governing Patent Suits, 2022, an advance service to the defendant is not mandatory if the party approaching the Court is seeking an ex-parte relief.

A corollary to both of the Rules mentioned above is if the party approaching the Court is able to satisfy the Court why advance service is not mandatory, he will be successful in getting relief of ex-parte injunction. Therefore, the question is, in what circumstances can a court dispense with the requirement of an advance service to the defendant? The exemption from advance service is allowed only in exceptional situations where there is an overarching consideration of justice, equity or public interest. The onus to prove the existence of such an exceptional situation is on the plaintiff. For example, the situation could be that if an advance service is effected to the defendant, an irreparable injury would be caused to the plaintiff. This kind of situation generally arises in the case of quia timet action. In the case of *Fletcher v. Bealey* [28 Ch.D. 688 (1885), Mr. Justice Pearson explained the law as to actions quia timet as follows:

> *"There are at least two necessary ingredients for a Quia timet action. There must, if no actual damage is proved, be proof of imminent danger, and there must also be proof that the apprehended damage will, if it comes, be very substantial. I should almost say it must be proved that it will be irreparable because, if the danger is not proved to be so imminent that no one can doubt that, if the remedy is delayed, the damage will be suffered, I think it must be shown that, if the damage does occur at any time, it will come in such a way and under such circumstances that it will be impossible for the plaintiff to protect himself against it if relief is denied to him in a Quia timet action*".

In intellectual property cases, a quia timet situation may arise when the defendant is infringing either a patent right, a trademark, or a registered design and is going to flood the market with the infringing products in the near future. So, in those circumstances, if the plaintiffs effect an advance service to the defendant, the defendant will certainly flood the markets, and it will be practically impossible to call off the infringing goods from the market even by any injunction.

This situation would severely prejudice the Plaintiffs, as the defendant would then misleadingly assert that their product is already available in the market. Moreover, it was held that even in the event that the Court grants an injunction after hearing the defendant, recall of such infringing products from the market would be an arduous task. However, the onus lies on the plaintiff to satisfy the Court with evidence (market survey, etc.) that there is a strong apprehension that if advance service is effected, the plaintiff will suffer irreparable damage.

Another hypothetical case would be a case in which the defendants, as prior employees or associates of the plaintiff, are alleged to have poached confidential material of the plaintiff with the intent of using it for unlawful means. In House of Diagnostics LLP & Ors. vs House of Pathology Labs Private Limited [CS(COMM) 869/202], it was held that where such material is contained on the servers of the defendants, if advance service of the plaint is directed to be served on the defendants, there is a live danger of the defendants compromising the said data or erasing it altogether.

Exemption from advance service to the defendant is not a rule but rather an exception, and it should be sought only in that situation where there is a strong apprehension that if the defendant is made aware of the instant suit, the defendant will take an action which will cause an irreparable injury to the plaintiff which may not be cure even some interim relief in the form an injunction is granted. On the other hand, advance service to the defendant is based on the principle of Audi alterum partem. The test to find whether an advance service is required in a particular case or not is whether the plaintiff has avoided such injury by not effecting an advance service.

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5. Amendments under Section 59(1) of the Patents Act, 1970 to Pass Rigours of Six Benchmarks

Case: The Regents of The University of California vs Controller General of Patents, Design and Trademark & Anr. [C.A.(COMM.IPD-PAT) 143/2022]

Forum: Delhi High Court

Judgment Dated: February 05, 2024

Judgment: The Delhi High Court, in its recent decision dated February 5, 2024, succinctly summarised the key benchmarks and parameters which amendments under Section 59(1) of the Patents Act, 1970 (hereinafter referred to as "the Act") need to qualify for them to be allowed. The observation of the Court came in the appeal filed by The Regents of The University Of California (hereinafter referred to as "the Appellant") that challenged the decision of refusal of their patent application (hereinafter referred to as "the subject application") by the Controller General of Patents, Designs & Trademarks (hereinafter referred to as "the Controller of Patents") vide its order dated February 18, 2021(hereinafter referred to as the "impugned order").

The subject application at the time of issuance of the First Examination Report ("FER") was initially objected to on the grounds of lack of novelty under Section 2(1)(j), lack of inventive step under Section 2(1)(j)(a) and non-patentable subject matter under Section 3(i) and Section 3(k) of the Act. To overcome the objections, the appellant amended the claims to be more definitive and restrictive in their scope and incorporated technical features implicitly covered under the dependent claims. However, maintaining all objections earlier raised in FER, the subject application received a hearing notice. To further overcome the objections, the appellant submitted an amended set of claims. However, the subject application after the hearing was refused, disallowing the amended claims under Section 59(1) of the Act.

Section 59 of the Act provides as follows:

"*Section 59: Supplementary provisions as to amendment of application or specification. —*

(1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation. No amendment shall be allowed except for the purpose of incorporating actual fact. No amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment."

The appellant's counsel submitted that the impugned order passed by the Controller of Patents was arbitrary and arose out of a wrong and incorrect interpretation of the provisions of Section 59(1) of the Act relying upon the following grounds:

i. Amendment of claims was done by way of correction, explanation and disclaimer as permitted under the Act.

ii. The scope of amended claims was narrower and was a subset of the original specification in claims.

iii. Amended claims were already disclosed in the original claims and specification, both implicitly and explicitly.

iv. The scope offered by the originally filed description should be read along with the claims and examples.

v. Amended claims were clearly derived by merging features of multiple dependent claims of the original specification, which did not enlarge the scope of the claims. Support for claims in the description must be seen from the perspective of a person skilled in the art and processes, one having common knowledge, and one who can identify the inventions and substance in line with the phrase “not in substance” used in Section 59(1) of the Act.

vi. The Controller of Patents failed to apply the test for added matter and appreciate that from the perspective of a skilled person, nothing new was discernible from the amendments.

vii. Additional words from the unamended specifications are permissible to offer a clear explanation as permitted under the Act.

viii. Renumbering and introducing new numbering and rewording technical features to impart definiteness and conciseness cannot be construed to take away or change the inherent scope of the originally filed claims.

While the counsel representing Controller of Patents submitted in support of the impugned order primarily relying on four legs of arguments:

i. That the claims to "a method of marketing", which was part of the preamble, was non-specific and could not have been acceptable;

ii. Use of the word “obtaining” as part of an independent claim did not emanate from the original claim and, therefore, could not be allowed under Section 59(1) of the Act;

iii. Some parts of the independent claim added additional specifications that were not found in the initially filed claim and

iv. Certain expressions in the independent claim were also beyond the scope of the initially filed claim.

The impugned order was passed on the premise that although the preamble of amended claims was the same, certain parts of the independent claim were not disclosed in the originally filed claims and also are not as such disclosed anywhere in the specification. Thus, the impugned order disallowing the amendments under Section 59(1) of the Act held that the scope of amended claims is beyond the scope of claims as originally filed, and it also describes matters not in substance disclosed or shown in the specification.

The Court interpreted the scope of Section 59(1) of the Act and observed that amendments to the original application can only be made through Disclaimer, Correction, or Explanation.

Additionally, the proposed amendments are to be tested against the following parameters:

- The amendment should serve the purpose of incorporation of actual facts;
- The effect of the amendment should not allow matter not in substance, disclosed originally or shown in the specification;
- The amended claim of the specification should fall within the scope of the original claim of the specification.

In light of the above, the Court that the appellant at the time of amendment was merely reverting to the original expression used in the original claims that were not outside the scope of the original claims and were simply mirroring the same. The Court gleaned through the specification and original claims to observe that the scope of the claim involved the method of determining the efficacy of the said compound and, therefore, the use of the expression "method of marketing", which mirrored the original claim could not be considered, in any manner whatsoever, to be outside the scope and purview of Section 59(1) of the Act.

For determining the scope of dependent claims, the Court reiterated the decision in ***F. Hoffmann-La Roche Ltd. v. Cipla Ltd. 2015 SCC OnLine Del 13619***, which held that "*where claims are 'dependent' it incorporates by reference 'everything in the parent claim and adds some further statement, limitations or restrictions*."

Since the appellant clarified that the phrase "obtaining" did not mean that they would be manufacturing but only procuring the compound from existing sources and finally testing it, the same was acceptable.

Since the parts of Claim 1 objected to by the Controller of Patents already formed part of the original claims and specifications, the Court held that the amendments made by the appellant only served as an explanation to the original claims, amounting to the incorporation of actual facts, and does not

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disclose any matter which was not initially disclosed in the claims of specification filed before the amendment and thus allowed the same.

The impugned order was set aside with an observation that it was not an accurate analysis or a correct conclusion, and by allowing the appeal, the subject application was remanded back to be examined afresh along with the amendments. This decision of the Court paves the way for the correct interpretation of Section 59 of the Act and, thereby, is bound to provide clarity to the scope of amendments that can be allowed during the prosecution of a patent application before the Patent Office.

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6. Patent Infringement: Import or Local Manufacture?

Case: AstraZeneca AB & Anr. vs Azista Industries Pvt Ltd & Ors. [CS(COMM) 106/2024]

Forum: Delhi High Court

Order Dated: February 06, 2024

Order: In an infringement suit, *AstraZeneca AB & Anr. ('plaintiffs') vs Azista Industries Pvt Ltd & Ors. ('defendants')*, the Delhi High Court, in its order dated 6th February 2024, granted interim relief to the plaintiffs based on their submissions that the defendants were engaged in clandestine operations, acting in concert to manufacture, smuggle, and sell unlawful drugs that were infringing versions of the plaintiffs' patented drug in India.

The suit patent (IN 297581) relates to the plaintiffs' drug comprising Osimertinib, a second-line treatment for non-small cell lung cancers with underlying mutations in a protein known as the Epidermal Growth Factor Receptor. Osimertinib is the International Nonproprietary Name (INN) assigned by the World Health Organisation to the plaintiffs' compound. Osimertinib is protected by the suit patent, which was granted in 2018 and is valid till 2032. Plaintiffs have the exclusive right to manufacture, use, offer for sale, import, or sell Osimertinib in India.

Plaintiffs uncovered the *modus* used by defendants for infringing activities. Plaintiffs asserted that defendant no. 2 (Azista Bhutan Healthcare) manufactured Osimertinib in Bhutan under the brand OSITAB, and defendant no. 1 (Azista Industries Pvt. Ltd.) was involved in the marketing and selling of impugned drugs within India. As import-export data of defendants over the last few years revealed no imports of the impugned drug, and because the patent for compound Osimertinib is not registered in

Bhutan, plaintiffs argued that it *appeared* that the drugs were manufactured locally in India. In contrast, the packaging of these drugs mentioned the place of manufacture as Bhutan.

The plaintiff averred that the sale of the infringing drugs in India was being promoted through doctors and medical practitioners by defendant nos. 3-5 (Hetero Group). Undated prescriptions without letterheads have been produced in this regard. It was also stated that defendant no. 7 (IndiaMART), an e-commerce marketplace, was facilitating the advertisement and sale of infringing drugs by third parties. These drugs are not meant for sale on online websites and require a prescription by a registered medical practitioner.

Plaintiffs evidenced that defendant no. 8 (Hegde & Hegde Pharmaceutical LLP). Defendant no. 9 (Celute Lifesciences Pvt Ltd) were the third-party entities that engaged in the supply and sale of infringing Osimertinib on the merchant platform operated by defendant no. 7. Drugs were also readily available at retail outlets/ pharmacies such as those of defendant no. 6 (Mor Chemists Banjara Hills). Apart from this, several unidentified persons facilitating the smuggling of drugs across the Indo-Bhutan border and inland supply/ distribution have been impleaded as *John Does*.

Plaintiffs placed on record copies of three previous orders of the Delhi High Court protecting their suit patent. Plaintiffs appraised the Court that there was no pre-grant opposition to the suit patent. Out of two post-grant oppositions, one was subsequently withdrawn, and the other is pending.

The defendant nos. 1-5 denied the allegations made in the plaint as false and incorrect and assured that they would not deal with any infringing drug until the suit patent is valid and subsisting. However, it was clarified that defendant No. 2 manufactures OSITAB in Bhutan, which does not infringe the suit patent. It was also explained that the *only* ‘import’ the aforesaid defendants were aware of were the ones made in terms of Rule 36 of the Drugs and Cosmetics Rules, 1945, which stipulates that the import of small quantities of drugs that are otherwise prohibited can be imported for personal use, subject to certain conditions.

Copies of two permits granted by the licensing authority (CDSCO) have been produced to support the submissions. Defendant No. 2 further assured that no export of OSITAB shall be made to India except under the regulatory permission granted under Rule 36. While denying the allegations, defendant No. 8 undertook appropriate action to remove the listings on the website of defendant No. 7.

On examining the contentions of both sides, the Court found a *prima facie* case in the plaintiffs' favour, a balance of convenience tilting in favour of the plaintiffs, and irreparable loss would be caused if an *ex-parte* ad interim injunction is not granted. Accordingly, defendants nos. 6 and 9 are restrained from infringing activities directly or indirectly in relation to the suit patent. The Court also directed defendant No. 7 to delist and delete all listings on its platform that advertise and offer for sale infringing versions of Osimertinib under the brand OSITAB.

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7. Product-By-Process Claims Must Be Examined on Standards of Novelty and Non-Obviousness

Case: Vifor (International) Ltd. v. MSN Laboratories (P) Ltd. [FAO(OS) (COMM) 159/2023 & CM APPL. 39177/2023]

Forum: Delhi High Court

Order Dated: February 07, 2024

Order: The Division Bench of the Delhi High Court, consisting of Justices Yashwant Varma and Dharmesh Sharma, stated in the case of Vifor (International) Limited & Anr. vs. MSN Laboratories Pvt Ltd, Corona Remedies Pvt Ltd, and Dr Reddy's Laboratories Ltd that the evaluation of a product-by-process claim under the Patents Act should be grounded on the notion that the product in question must be unique and not readily apparent to others. It holds true irrespective of whether the applicant has defined the invention via a manufacturing process.

The plaintiff/appellant contended that their patent 221536, commonly known as IN'536, was predominantly a product-by-process claim for Ferric Carboxymaltose (FCM), a substance engineered to meet the requirements of a non-toxic, quickly sterilising intravenous iron therapy in a variety of clinical contexts. In an effort to obtain relief, the plaintiff petitioned for a provisional restraining order that would forbid MSN Laboratories Limited from employing an alternative process to manufacture a product that is comparable to FCM. The Honourable Single Judge denied the petition for an interim injunction on the grounds that the plaintiff's patent protection was limited to the process of acquiring the product, not the product itself.

Subsequently, the plaintiff/appellant filed an appeal with the Division Bench, contending that the patent defined a process rather than a product and, thus, should not be limited to the particular manufacturing method specified in the patent. With respect to their patented product, the plaintiff, acting as the appellant, filed a lawsuit against MSN Laboratories Pvt Ltd, Corona Remedies Pvt Ltd, and Dr Reddy's Laboratories Ltd.

The Court's decision established that the mere use of process-related terms does not inherently limit or offer a valid justification for distinguishing between validity and infringement. Even if the applicant is obligated to provide a product-by-process claim due to unforeseen circumstances, there is no justification for restricting the extent of protection. In the case, the Court saw that for a product-by-process claim to be deemed genuine, it must exhibit novelty and inventiveness, in contrast to a simple process.

The Court emphasised that using the product-by-process format alone does not automatically reclassify a new product as falling under Section 48(b) of the Act; instead, the product must adhere to the standards outlined in Section 48(a). The patentees' rights are outlined in Section 48 of the Patents Act. Specifically, Section 48(a) states that patentees possess exclusive jurisdiction over any third party attempting to manufacture, distribute, import, or utilise the patented product in India. In a similar fashion, patentees are granted the same rights under Section 48(b) when the patent relates to a particular process.

Additionally, the Court underscored the improperness of restricting or abbreviating a product-by-process claim for the purpose of complying with Section 48(b) of the Patents Act. The Court ruled that a product-by-process claim remains eligible for protection under Section 48(a) of the Act so long as it pertains to a novel and inventive product that is not previously recognised in the art. The Court also said that the process language used to describe an invention shouldn't change the standards for figuring out whether it is new or patentable if the claim is for a unique, original, and different product from previous designs.

In its decision, the Court said that previous decisions and guidelines on product-by-process claims all agree that process terms should not be considered when figuring out novelty. Instead, the Court noted that people should focus on the product's unique qualities. The Court emphasised that the use of a novel manufacturing process does not inherently confer novelty on a product. Furthermore, the Court emphasised that a product-by-process claim amalgamates the conventionally distinct classifications of process patents and product patents.

The Court said that the Single Judge's decision was clearly wrong because it didn't understand the scope of product-by-process claims and made it sound like different rules apply to infringement cases. After reviewing the case's facts and circumstances, the Court determined that Vifor has the right to prosecute its claim for the deposit of a percentage of sales at the opportune time, pending the outcome of any ongoing litigation. Therefore, the panel granted the appeal and reversed the judge's decision.

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8. Identifying the Scope of Patent Claims Still Remains Mystified

Case: Techpolymers Industria E Comercio LTDA v Deputy Controller of Patents and Designs [(T)CMA(PT)/180/2023]

Forum: Madras High Court

Order Dated: February 08, 2024

Order: Post abolition of IPAB in April 2021, High Courts with whom the jurisdiction for appeals against the decisions of the Controller of Patents lies have delivered several judgments that are helping in the evolution of IP Jurisprudence in India. A recent judgment from Madras High Court in the case of Techpolymers Industria E Comercio LTDA vs Controller of Patents and Designs, while deciding an appeal against the Controller's order rejecting a patent application under Section 2(1)(ja) and 59(1) of the Patents Act, has demonstrated adoption of a simplified approach to adjudicate the matter.

The Court, for deciding the rejection based on Section 2(1)(ja), has opined that the Controller has not considered the explanations advanced by the appellant and is thus short of his responsibility and, therefore, rejection founded on the ground of Section 2(1)(ja) fails. While deciding the rejection based on Section 59(1), the Court has opined that the Controller has focused more on English and words used therein and has not focused on the specifications regarding the invention, thus pronounced failure of ground under Section 59(1).

Akin to most patent matters, the scope of claims is a central pivot in adjudicating on the question of Section 59(1) of the Patents Acts, and the Court seems to have oversimplified the effect on the scope of claims of

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amendments adopted to overcome objections of non-patentable subject matter.

Section 59(1) of the Patents Acts states that "*No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment*."

It is well-established that the language of claims defines the metes and bounds of the scope of protection and should essentially be given a technical reading and meaning. Patent Law by P. Narayanan states that "*The words of the claims (when themselves correctly construed) provide the prima facie boundary of protection*."

In *Vifor International Ltd vs Dr Reddy's Laboratories Limited*, [2024: DHC: FAO(OS) (COMM) 159/2023 & CM APPL. 39177/2023] case Court has set aside its single bench judgment and has drawn and acknowledged the existence of a distinction between the expression "obtained by" and "obtainable by" language embodied in the claim, which is a product by process claim to infer the difference in scope of protection afforded by different claim language and decide upon infringement of protected subject matter.

In contrast, the Court, in its judgement in *Allergan Inc vs The Controller of Patents* [2023:DHC:000515, C.A.(COMM.IPD-PAT)22/2021], in relation to Section 59(1) has emphasised a purposive interpretation of provisions. Using a much-liberalised approach to determine the scope of claims, the Court held that the claim amendments from "a method for treating an ocular condition" claim to "an intracameral implant" (product) are permissible, which as per literal interpretations of Section 59(1) were identified to be as non-permissible by the Controller.

Taking cues from *Allergan Inc Vs. The Controller of Patents*, Court in the case of Techpolymers Industria E Comercio LTDA, has said that "*When this Court carefully read both the original claim as well as the amended claim, all it finds is that the original claim uses the word 'use of lubricated polyamide' whereas, the amended claim conveys the idea that it relates to a method of using the same substance.*"

The Court further said that "*the Controller to understand that beyond the choice of words which an applicant for patent may consider appropriate, it has to look into the substance of the claim. Section 59 is not intended to be used for the wrong understanding of the language employed by an applicant, since an applicant will also be a person of science and long of language*."

Looking into the substance of the invention, the Court could not find anything therein that may indicate that the amended claim has a scope different from the scope of the original claim, despite that the original claim recited "*Use of a lubricated polyamide for the preparation of articles by injection moulding, characterised in that: the polyamide is a polyamide of type 6 or 66 and has a viscosity index* ….., which merely recites a use without any active, positive steps delimiting how this use is practised, is changed to recite "*a method of preparing an article, the method comprising injection moulding the article using a lubricated polyamide wherein…*", which encompass a method of preparation of an article by reciting an active, positive step, i.e. injection moulding.

Emerging jurisprudence in India has thus clearly expanded the flexibility of claim amendments that the applicants may adopt under Section 59(1) of the Patents Act to deal with circumstances arising before them due to various reasons during the prosecution of a patent application. Nonetheless, a critical thought to ponder upon is whether the evolving jurisprudence is propagating a position where different parameters for evaluating the scope of claims are applied when adjudicating on different issues under different provisions of the Act, *viz.*, a different approach when the scope of the claim is to be identified for adjudicating on the issue of Section 59 and a different approach when the scope of the claim is to be identified for adjudicating on infringement issues. Does this mean that different provisions of the Act require different perspectives to evaluate the same concept?

To summarise, linguistic simplification may be applied to decipher the true technical meaning of a claim while adjudicating on issues requiring identification of scope, but with a caution that applied linguistic simplification does not alter the scope of the claim, which is the central pivot to decide the contention.

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9. Mere Juxtaposition of Prior Arts Not Sufficient to Establish Obviousness!

Case: NHK Spring Co Ltd vs Controller Of Patents And Designs [C.A.(COMM.IPD-PAT) 296/2022]

Forum: Delhi High Court

Order Dated: February 08, 2024

Order: The Delhi High Court, in this case, examined the importance of the Patent Office manual and reported cases in the determination of the Inventive step. The Court observed that *"The Patent Manual advises against fragmentary analysis of claims or inventive parts, advocating for a holistic view to truly gauge the inventive step".* This appeal was filed against the rejection of an Indian Patent application(4098/DELNP/2015) titled ***"SUSPENSION AND COMPRESSION COIL SPRING FOR SUSPENSION"***.

The Appellant/Applicant, NHK SPRING CO LTD, filed an appeal under Section 117A of the Act against the order of the Controller dated March 31, 2022, for the refusal of the patent on grounds of 'lack of inventive step'. The Appellant's Counsel contended that the impugned order did not disclose adequate reasoning as to how the ground of obviousness was made out in respect of the prior arts cited in the order. Further, the Counsel submitted that the same prior arts were also cited before the Trial and Appeal Board in a similar application for the subject patent in Japan (Appeal 2018-9502 from an order of the Japanese Patent Office; Japanese Patent Application No. 2017- 11550), and the board had thoroughly examined the same prior arts before eventually granting the patent at the appellate stage.

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In this case, the Court found the relevance of the guidelines in ***The Manual for Patent Office Practice and Procedure dated November 26, 2019 ("Patent Manual")*** to determine an inventive step. Additionally, the Court cited ***Windsurfing International v. Tabur Marine [1985] RPC 59***, which lays down the steps to be followed for the determination of the inventive step:

(i) identifying the inventive concept embodied in the patent;
(ii) imputing to a normally skilled but unimaginative addressee what was common general knowledge in the art at the priority date
(iii) identifying the difference, if any, between the matter cited and the alleged invention; and
(iv) deciding whether those differences, viewed without any knowledge of the alleged invention, constituted steps which would have been obvious to the skilled man or whether they required any degree of invention."

Further, the Court relying on the judicial precedent set by the Court in the case ***Bristol-Myers Squibb Holdings v. BDR Pharmaceuticals International 2020 [SCC OnLine Del 1700]*** observed that while a mosaic of prior art documents may be done in order to claim obviousness, however, while doing so, it must also be demonstrated that the prior art exists, but how the person of ordinary skill in the art would have been led to combine the relevant components from the mosaic of prior art.

The Court then held that *"The mere citation and juxtaposition of prior arts do not suffice to establish obviousness"*. The Court observed that in the refusal order, the Controller has not disclosed how he arrived at a decision relating to a lack of inventive step in view of the cited prior art, concluding that "*The Assistant Controller of Patents has only noted the disclosures made in the prior art D1 and the contents of the alleged invention. No discussion or inference follows on this point before the Controller advances to discuss the other prior art, D2, D4 and D5. It is thus apparent that the Assistant Controller's analysis falls short of the nuanced examination mandated by both the Patent Manual and judicial precedents. The decision inadequately addressed the crux of the inventive step by primarily focusing on the prior arts D1-D5 without delving into the synthesis of these teachings* *or their collective impact on a person skilled in the art. The mere citation and juxtaposition of prior arts do not suffice to establish obviousness"*.

Further, the Court opined that "*While the Assistant Controller of Patents and Designs has noted the inventions cited in the prior arts and the claims made in the alleged invention, however, in the opinion of the Court, **no attempt has been made to disclose how the teachings given therein would be obvious to a 'person skilled in the art' to conclude that the alleged invention lacks an inventive step**".*

In view of the lack of proper reasoning in the refusal order, the Court found this case fit to be remanded and for reconsideration.–Therefore, on the aforementioned analysis and reasoning, the Court remanded the matter and directed that the Assistant Controller shall not be prejudiced by any observations made in the impugned order, and the proceedings shall be conducted afresh by taking into account the judicial precedents with regard to the substance of the matter.

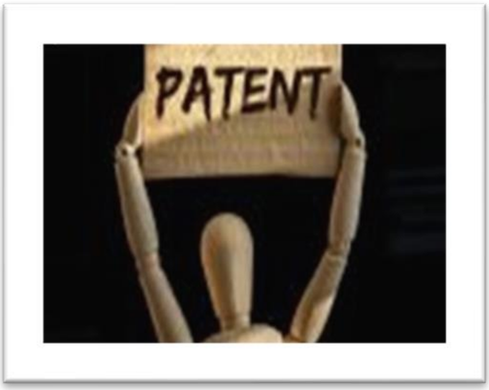
In this case, the Court reiterated that the Controller should give proper reasoning for the refusal on the grounds of obviousness. Merely focusing on the prior arts without delving into the synthesis of these teachings or their collective impact on a person skilled in the art, the decision of refusal is insufficient to adequately address the crux of the inventive step. The mere citation and juxtaposition of prior arts do not suffice to establish obviousness. While remanding back the case, the Court urged the Controller to thoroughly examine the cited prior art and give adequate reasons as to how the ground of obviousness is made out in respect of the prior arts to establish the ground of refusing the patent application due to lack of inventive step/non-obviousness. This case highlights the need for proper reasoning before any patent application is refused.

10. Analysis of Delhi High Court's Judgment in Man Truck Bus Se vs Assistant Controller of Patents and Designs

Case: Man Truck Bus SE vs Assistant Controller Of Patents & Designs [C.A.(COMM.IPD-PAT) 16/2022]

Forum: Delhi High Court

Order Dated: February 09, 2024



Order: It is a well-established legal principle that an order shall be a reasoned and speaking order, i.e., it shall clearly explain the reasoning for arriving at a decision. The Courts have recently been continuously emphasising this requirement, particularly in appeal matters filed against refusal orders issued by the Indian Patent Office (IPO). One such judgement was in *Man Truck Bus Se vs Assistant Controller of Patents and Designs* that came before the Hon'ble High Court of Delhi. This judgement further deals with the validity of the citation of new prior art documents by the IPO during the Hearing of a patent application and also acknowledges the relevance of the prosecution history of the corresponding foreign applications during the Indian prosecution.

This matter was basically an appeal filed under Section 117A of the Patents Act against the refusal order issued by the Assistant Controller of Patents and Designs (respondent) for patent application number 1241/DEL/2009, titled "*Particle separator and method for separating particles out of an exhaust stream of an internal combustion engine*".

The appellant argued that the impugned order effectively duplicated the reasoning for the relevance of D1-D4 from the First Examination Report (FER), which indicates non-application of mind by the Controller while issuing the impugned order. The narration given for D1-D4 in the first part and the later portion of the impugned order are also identical, reaffirming this notion.

For the cited prior arts, the appellant argued that while documents D1-D4 were cited in the FER and the Hearing notice, document D5 was cited only during the Hearing by the Controller. This was strongly objected to by the appellant, citing the violation of the principles of natural justice *qua* the appellant. However, D5 was still relied upon in the impugned order for rejecting the patent application.

The appellant also cited the decision in *Perkinelmer Health Sciences Inc & Ors V. Controller of Patents*, where this Court held that the Controller was not permitted to raise new grounds of objection at the Hearing. It is unacceptable and violative of the principles of natural justice that the applicant was not provided with a reasonable opportunity. This is regardless of whether the applicant provided a submission for any new document cited during the Hearing.

Moreover, the impugned order does not have any analysis to establish the obviousness of the invention and was therefore unreasoned. To further augment their arguments, the appellant cited *Agriboard International*, where the Court held that the Controller must analyse the existing knowledge and how the persons skilled in the art would move from the existing knowledge to the subject invention. If such analysis is not presented, the rejection of the patent application would be contrary to the provision of Section 2 (1)(j) of the Patents Act, 1970.

Regarding the foreign prosecution history, the appellant argued that the Controller did not consider the grant of the corresponding applications in other jurisdictions when arriving at their decision. The prior art documents D1, D3, and D5 had already been considered and rejected by the US Patent Office while granting the corresponding US Patent No.7850934B2. This fact was also brought to the attention of the Controller through the appellant's submission, but the Controller did not consider this while passing the impugned order. The appellant also cited *Otsuka Pharmaceutical Co. Ltd. v. The Controller of Patents*, where the Court held that the Controller should have considered the grant of the corresponding foreign applications in arriving at their decision.

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On the other hand, the respondent argued that the application was refused based on the cited prior art documents D1-D5. None of these documents were mentioned in any other jurisdiction where the patent had been granted. The respondent also argued that the prior arts were relevant for examination by the IPO, and grants in other jurisdictions may not be relevant for consideration.

It does not automatically entail that the application in India would also be granted since patent rights are territorial, and the patentability criteria are unique to the jurisdiction. Regarding the citing of D5 only during the Hearing and in the impugned order, the respondent submitted that the Controller had rightly relied upon D5 to conclude that a technical person skilled in the art could come up with the invention.

Before getting into the details of the present matter, the Court, in their order, enunciated the learnings from the relevant case laws referred by both parties. The Court then stated that the absence of any discussion and analysis before rejecting the patent application violates principles of natural justice. This was reiterated by this Court in *Auckland Uniservices Limited v. Assistant Controller of Patents*. The Court also relied on *F. Hoffman-La Roche* and *Agriboard International*.

In the present case, the Court noted that the FER and the Hearing notice had cited 4 prior art documents, D1-D4, for the ground of lack of inventive step. The appellant had also argued in their response to the FER that the corresponding European and US patents have been granted with claims of substantially the same scope as those filed in India after considering D1, D3, and D4.

Moreover, document D5, considered by the Controller in arriving at his decision in the impugned order, was not cited in any office actions. In this document, the Controller cited D5 during the Hearing, which was recorded by the appellant in their Hearing submission. In fact, while the appellant provided their arguments against D5 in the hearing submission, they also protested the citing of this new document at such a late stage of the proceedings.

Coming to the impugned order, the Court observed that the Controller had not provided any additional analysis in response to the appellant's

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arguments for D1-D4. The analysis of D1-D4 in the impugned order is a mere repetition from the FER, without any addition or supplementation whatsoever. Although the Controller did articulate three features of the claimed invention in the impugned order, he did not address D1-D4, particularly in response to the arguments presented by the appellant for these documents in their submissions to the IPO. Moreover, while D5 was not even cited in the FER or the Hearing notice and was cited only during the Hearing, the Controller relied on it in arriving at this decision in the impugned order.

Considering this, the Court held that the impugned order is erroneous as it does not provide sufficient analysis of D1-D4 to establish that the present invention is obvious. Further, D5 appears to form the basis of the conclusion of the Controller in the impugned but was never cited in the FER or the Hearing notice. Therefore, it violates the principles laid down in *Otsuka Pharmaceutical Co.*, *Agriboard International*, and *PerkinElmer Health Sciences*, where it was reiterated that the Controller's order could not be unreasoned. If it does provide reasons, it still cannot circumvent communicating the objection of prior art in the Hearing notice. The Court acknowledged that not providing any such opportunity would put the appellant at a severe disadvantage at the stage of Hearing.

The Court, without going into the merits of the issues arising out of D1-D5, held that the impugned order is vitiated as the Controller did not cite document D5 in the Hearing notice and did not even provide sufficient analysis for documents D1-D4 therein. The Court consequently set aside the impugned order and remanded the matter to the IPO for further consideration. The Court further directed that the Controller may also consider the prosecution history of the appellant's corresponding patent applications in other jurisdictions.

This judgement reiterates the importance of giving the applicant a reasoned and speaking order by the IPO. Especially in an adverse order, the applicant must be provided with sufficient details and an explanation of the reason for the refusal of the application. Moreover, this judgement reaffirms that the responsibility of giving adequate opportunity to the applicant to respond to an objection cannot be ignored under any circumstances. The Controller cannot raise a new objection during the Hearing, regardless of whether the applicant provides arguments in their submission. Further, the Court acknowledged the importance of granting the corresponding foreign applications in the Indian prosecution.

As this judgement addresses multiple pressing issues that the applicants face, it may serve as a guiding light for the applicants in successfully addressing these issues while prosecuting their applications before the IPO. More importantly, such encouraging judgements by the Courts, along with the vigorous efforts being made by the IPO in smoothening the overall process, would act as a strong motivation for the applicants to file more in India, in turn developing a robust, firm, and comprehensive IP framework in the country.

11. Prior Art Alone Not Sufficient to Refuse a Patent!

Case: Intercontinental Great Brands LLC vs Assistant Controller Of Patents And Designs [(T)CMA(PT) No.182 of 2023]

Forum: Madras High Court

Order Dated: February 09, 2024

Order: The High Court of Madras, while admitting an appeal relating to the refusal order dated November 21, 2016, passed by the Controller in respect of patent application No.1122/CHENP/2007, filed by the appellants, in Intercontinental Great Brands LLC and Friesland Campina Nederland B.V. vs Assistant Controller of Patents and Designs, Government of India (respondent), remanded the case back for reconsideration and order transfer the case to other Controller of Patents and Designs.

The appellants filed an appeal under Section 117-A of the Patents Act, 1970, to set aside the order dated November 21, 2016, passed by the respondent, in which the respondent refused to grant a patent to the appellant's invention. The order of refusal to grant the patent was broadly based on the requirement of the hearing notice not being met by the appellants' submissions.

The application was related to a soluble foaming composition, particularly a foaming protein-free composition to be added into beverages such as coffee, soup and specific categories of food products, which can produce froth or foam. The Controller issued the first examination report (FER) after the appellants applied for a request of examination, cited four documents D1-D4 raising objections concerning the obviousness to the person skilled in the art under section 2(1)(ja), section 3(e), nature of independent claims, and section 10(4) of the Patent Act, 1970.

The respondent objected that the invention is a mere discovery of a scientific principle of the formulation attracting section 3(e), and it is not explained adequately how the invention is not apparent to the person skilled in the art inviting section 2(1)(ja). The respondent objected that out of five independent claims, 1, 18, 21, 26, and 37 in the patent application, claims 21 and 26 are extended characterisations of claims 1 and 18 and chose not to treat them as independent claims. Moreover, the respondent asserted that the invention is not disclosed sufficiently and adequately in the application as required under section 10(4).

The appellants responded to the first examination report (FER) and made several amendments to the claims, retaining the total number of claims that were filed originally. The respondent was dissatisfied with the response to FER and issued a notice of hearing, citing documents D1-D4 again. After the hearing, the appellants filed the written submission, amending the claims a second time but keeping the number of claims the same as filed originally. Unsatisfied with the hearing and written submission, the Controller refused the grant of patent to the applicant's invention.

The appellants moved to the court to set aside the impugned order passed by the Controller and submitted to the court that this invention was already patented in several countries. It was filed in India in 2006 with 46 claims, 5 of which were independent claims and the rest dependent claims. The application was filed with the first claim incorporating inventive features such as "a foaming powdered protein-free soluble composition" and "less than 1% protein."

The learned counsel for the appellants argued that the cited prior art documents D1 and D2 in FER contain a high percentage of protein. In contrast, the appellant's foaming composition is essentially protein-free, involving less than 1% protein. The learned counsel further asserted that the prior art D3 discloses a gasified coffee glass, etc., prepared by forming a mixture of 3% to 12% water and 88% to 97% of coffee-derived solids, etc., and D4 relates to an aromatic agent to be added to a foaming agent. Both documents D3 and D4 have little relevance to the invention. Over the objection regarding the independent nature of claim .21 and claim 26, the learned counsel argued that claim 21, in essence, deals with a food product composition and claim 26 deals with a powder form of foaming composition, whereas 1 and 18 deal with foaming composition. While the composition remains the same, the product form through which the composition is expressed is still different. The learned counsel alleged that the Controller did not appreciate the explanation provided by the applicants and remained stuck to the cited documents. Additionally, the Controller did not explain why the patent application was refused.

After carefully weighing the submissions, the court found that "*the Patent Controller has not held himself with an opportunity to consider the submissions or the explanations provided by the appellant to the prior arts even though they are filed before him. In other words, the* ***Patent Controller appears unifocal and seems to have focused only on the prior arts*** *and not the explanations offered against them. This necessarily requires to be rectified, which implies that this matter has to necessarily go back to the Patent Controller.”*

The court further ordered that, as this patent application has only two years of shelf life left, the patent offices shall dispose of it within four months. In this case, the Controller held a unifocal view, considering only the prior arts. He did not appreciate the submissions and explanations offered by the applicants against the prior art. The court also transferred the matter back to the respondent. The court's decision reiterates that the Controller is required to appreciate all the submissions and explanations submitted by the applicant against the cited prior art when any patent application is refused. A unifocal view of the Controller on prior art is insufficient to support the reasons for refusal.

12. Refusal of Patent: Lack of data on efficacy and changing scope of claims

Case: Ovid Therapeutics, Inc. vs Assistant Controller, Patents and Designs. [C.A.(COMM.IPD-PAT) 28/2023]

Forum: Delhi High Court

Order Dated: February 09, 2024

Order: The Delhi High Court in ***Ovid Therapeutics, Inc*** **vs Assistant Controller of Patents and Designs, Patent Office decision dated February 09, 2024,** held that a patent application is not eligible for grant due to the expansion of the scope of the claims and the absence of enough data to demonstrate significant enhancement of therapeutic efficacy.

A National Phase Application titled "*Methods of Increasing Tonic Inhibition and Treating Secondary Insomnia*" was filed arising out of a PCT Application claiming a priority from a US patent application. The national phase patent application was filed with 1-28 claims directed towards "*A method of increasing tonic inhibition of neurons in a subject comprising administering to a human subject with a neurodegenerative disease, a neurogenetic disorder, or a central nervous system disorder a pharmaceutical composition comprising an effective amount of 4,5,6,7-tetrahydroisoxazolo(5,4- c) pyridine-3-ol (THIP) or a derivative thereof and a pharmaceutically acceptable carrier or excipient to increase tonic inhibition of neurons of the subject*…."

Subsequent to the filing of the patent application, a First Examination Report (FER) was issued by the Indian Patent Office, raising objections over the lack of novelty, inventive step, and non-patentability under Section

3(i) and Section 3(e) of the Indian Patents Act, the ground of insufficiency of disclosure and definitiveness. In response to the examination report, the Applicant amended the claims and limited the scope of claims to recite a composition having a specific range of the claimed compound. The Indian Patent Office issued a hearing notice, and subsequently, a reply was submitted by the Applicant, in response explaining the daily dosing and extended improvement of the composition. Also, a declaration by the inventor was submitted to establish the synergistic effect of the ingredients of the composition.

However, pursuant to filing the submission of the written submission, the patent application was refused by the Ld. Controller on the grounds: (i) non-patentability under Section 3(d), Section 3(e); (ii) lack of inventive step under Section 2(1)(ja); (iii) insufficiency of disclosure; and (iv) broadening the scope of claims in violation of Section 59 of the Patent Act, 1970. Thus, an appeal against the order was filed by the Applicant.

The key issue that arose before the Hon'ble Court was as follows: - "***Whether the amended claims are within the scope of original claims***?

The second issue was "***Whether the claimed composition results in enhanced therapeutic efficacy***."

The Court held that while the originally filed claim 1 was worded as a method claim, it was, in fact, a composition claim. Further, the Court held that the limitation that existed in an original claim with respect to the neurodegenerative disease does not exist in the amended claim. Accordingly, "*amended claim 1 has disclaimed the earlier broadly claimed feature by defining the necessary amount of composition that is to be used; overall, the amended claim is not within the scope of the originally filed claims as the limitation with respect to a specific class of diseases, i.e., neurodegenerative diseases has been removed*". Thus, the Court held that the amendment in a claim with respect to the reference to a specific disease for which the composition is intended broadens the scope of the claim.

Further, the Court observed that the composition claimed in the amended claim is a derivative and is merely a '*known substance*' under Section 3(d) of the Indian Patents Act unless and until significant enhancement of therapeutic efficacy is demonstrated. The Court held that although the

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Applicant laid reliance on a press release for Phase 2 STARS Trial of OV101, which was also freely accessible, the results of Phase 3 trials available with the Applicant, have not been placed on record, which was necessary to determine the efficacy of the composition. The Court further found that the publicly available results of the phase 3 trials reflect that the composition for which the subject patent is sought lacks therapeutic efficacy. Therefore, the Court held that there was insufficient data to demonstrate a significant enhancement of therapeutic efficacy.

In this case, the Court held that this patent application is not eligible for the grant due to the expansion of the scope of the claims and the absence of enough data to demonstrate significant enhancement of therapeutic efficacy as required under Section 3(d). Additionally, the complete specification ought to contain the requisite data or references demonstrating the enhancement of efficacy of the subject invention for which a patent is sought if it is found to fall under section 3(d).

However, if there is any additional data, such as data from clinical trials, which becomes available only after the filing of the patent application, such data should be produced by the Applicant and may be considered by the Patent Office as well as the Court.

13. InterDigital vs Oppo: A Legal Analysis of the Indian SEP Dispute

Case: Interdigital Technology Corporation & Ors vs Guangdong Oppo Mobile Telecommunication Corp. Ltd. & Ors. [CS(COMM) 692/2021, I.As. 11485/2022, 21356/2022 &4065/2023]

Forum: Delhi High Court

Order Dated: February 21, 2024

Order: The ongoing case between InterDigital, a US-based technology and licensing company specialising in wireless and video technology, and Chinese smartphone manufacturer Oppo underscores the complexities surrounding Standard Essential Patents (SEPs) and Fair, Reasonable, and Non-Discriminatory (FRAND) licensing terms within the evolving intellectual property (IP) framework in India.

The case sheds light on the intricate interplay of technology, intellectual property law, and commercial interests, as well as the need for clear and consistent regulatory frameworks to ensure that SEPs are licensed fairly and reasonably. Given the critical role of SEPs in driving innovation and growth in the telecommunications industry, it is essential to strike a balance between the protection of intellectual property rights and the promotion of competition and consumer welfare.

As such, the case between InterDigital and Oppo highlights the importance of robust and transparent licensing practices that promote the development and dissemination of new technologies while safeguarding the interests of all stakeholders involved.

Background and Allegations

InterDigital possesses a significant portfolio of patents related to cellular communication technologies, including 3G, 4G, and emerging 5G standards. These patents are considered Standard Essential Patents (SEPs), which means they are indispensable for any device seeking to comply with the industry's agreed-upon technical standards.

In the present case, InterDigital contended that several Oppo smartphone models were infringing upon its SEPs. The lawsuit filed by InterDigital alleged that Oppo had been utilising InterDigital's patented technologies without securing an appropriate licensing agreement.

Understanding SEPs and FRAND

Standard Essential Patents (SEPs): SEPs are patents covering technologies fundamental to the implementation of an industry standard. Standard Essential Patents (SEPs) enable patent holders to exert significant influence in the market due to the mandatory nature of their technology for compliance, which can have significant implications for market competition and innovation.

FRAND Terms: To prevent the abuse of market dominance of Standard-Essential Patents (SEPs), patent holders are bound by a legal obligation to license their patents on Fair, Reasonable, and Non-Discriminatory (FRAND) terms.

However, the interpretation of FRAND terms has been the subject of much debate and litigation, with no commonly accepted definition of "fair and reasonable" royalties. The determination of FRAND royalties is complicated by several factors, including the nature of the patented technology, the value of the patent in relation to the standard, and the commercial implications of the license.

The Delhi High Court's Role

The Delhi High Court emerged as the primary legal battleground in this dispute. Some of the key rulings by the Court are as follows:

Interim Injunction (2022): The Court issued an interim injunction against Oppo, threatening a potential sales ban on Oppo devices within India if the company failed to enter into a FRAND-compliant licensing agreement with InterDigital.

Royalty Deposit and Penalty (2023): The Court directed Oppo to deposit a sum representing royalties on past sales with the Registrar General. This amount was ordered to be held in an interest-bearing fixed deposit. Additionally, a penalty of ₹500,000 (around USD 6,000) was imposed on Oppo due to attempts to delay the proceedings.

Legal Implications and Considerations

The InterDigital vs. Oppo case offers valuable insights for legal practitioners and technology stakeholders:

Defining FRAND: Courts play a substantial role in interpreting what constitutes "fair and reasonable" licensing terms in SEP disputes. The outcome of this case will contribute to the ongoing determination of FRAND parameters.

Enforcement of IP in India: This case demonstrates India's willingness to enforce the rights of SEP holders and underscores the country's developing IP jurisprudence.

Negotiation Leverage: SEP holders possess a certain degree of bargaining power during licensing negotiations. However, their leverage is subject to legal limitations imposed by Fair, Reasonable, and Non-Discriminatory (FRAND) obligations, which aim to prevent SEP owners from engaging in anti-competitive practices.

Ongoing Developments and Impact

The legal dispute between InterDigital and Oppo is presently ongoing, with the potential for further appeals and rulings. The ultimate decision reached by the Court will have significant implications for the negotiation of Standard Essential Patent (SEP) licensing agreements within India and on a global scale, given the interconnectivity of the technology market. As such, it is essential to keep abreast of developments in this case, particularly in view of the potential ramifications for businesses operating in the technology sector.

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14. Analysing the Delhi High Court's Judgment in Microsoft Technology Licensing LLC vs Assistant Controller of Patents

Case: Microsoft Technology Licensing LLC v. Asst. Controller of Patents [C.A.(COMM.IPD-PAT) 26/2022]

Forum: Delhi High Court

Order Dated: February 21, 2024

Order: It is evident that the IP framework of the country is currently undergoing a significant transition. Among other factors, this could primarily be attributed to the emergence of India as one of the key markets for global industries, which is further substantiated by the increasing number of patent applications being filed in India in the last few years and the Indian government's vigorous efforts to smoothen and strengthen the overall ecosystem.

While the Indian Patent Office (IPO) and the applicants are also navigating their fair share of challenges to adapt to the evolving ecosystem, the principles of natural justice still form one of the fundamental pillars of the entire examination proceedings and cannot be dispensed with under any circumstances. This was reiterated in one of the recent judgments by the Hon'ble High Court of Delhi in the matter of *Microsoft Technology Licensing LLC vs Assistant Controller of Patents*.

This judgment addresses three points, i.e., the validity of a ground of refusal that was not raised in any office action, the validity of the ground of lack of inventive step that is based on a prior art document that was cited in the First Examination Report (FER) but not in the Hearing notice, and consideration of the foreign prosecution history by the IPO while deciding on the grant of an application.

This matter was an appeal filed under Section 117A of the Patents Act against an order dated November 30th, 2021, which was issued by the Assistant Controller of Patents and Designs (Respondent), rejecting the appellant's patent application 9642/DELNP/2011 for an invention titled "*Discovery of Secure Network Enclaves*". The respondent refused the application on two grounds:

i) lack of inventive steps in the invention and

ii) indefiniteness of claim 2, violating Section 10(4) of the Act.

On the ground of indefiniteness of claim 2, the appellant argued that the respondent did not raise this ground in the FER or the Hearing Notice. Only in the impugned order did the appellant learn about this objection. This is a clear violation of the principles of natural justice, as the appellant was never provided with an opportunity to address this objection during the Hearing.

The appellant then argued that while the Controller, in the impugned order, relied on the prior art documents D1 to D3 to arrive at the conclusion of lack of inventive step, analysis and claim mapping in the impugned order are provided only for D1. Moreover, D2 was not even cited in the hearing notice, which led the appellant to believe that the respondent is convinced of the appellant's arguments provided against D2 in their response to the FER and has therefore not cited D2 in the hearing notice. The appellant, accordingly, did not offer arguments to D2 in the Hearing submission.

The appellant also discussed the history of the foreign prosecution of the application and informed the Court that both D1 and D2 were cited by the European Patent Office (EPO) during the prosecution of the corresponding EP application. In fact, the appellant's arguments presented before the EPO were found persuasive, and the patent was subsequently granted.

On the other hand, the respondent defended the impugned order by submitting that there is no infirmity therein.

After hearing both parties, the Court first enunciated the provisions of Section 10(4) by stating that the sub-section stipulates that the specification must fully and particularly describe the invention, its operation or use, and the method by which it is to be performed. It also requires the disclosure of the best method of performing the invention. Therefore, compliance with the detailed requirements of Section 10(4) is indispensable for patent applications.

The Court also reiterated the obligation of the IPO to clearly articulate any deficiency identified in the patent application in the FER or the Hearing notice. This provides the applicant with a fair opportunity to address the deficiencies suitably. The Court, therefore, held that the conclusion that a specified claim violates Section 10(4) without a detailed exposition of the non-compliance specifics is not legally tenable. The absence of such critical analysis or specific rationale renders the impugned order deficient in legal substantiation on this matter.

On the grounds of lack of inventive step, the Court acknowledged that D2 was not cited in the Hearing notice but is considered by the respondent in the impugned order to justify the lack of inventive step. The appellant, therefore, never got an opportunity to address D2 during the Hearing or in the Hearing submission. Moreover, D3 was not cited in either the FER or the Hearing notice but is cited in the impugned order. The Court remarked that such procedural irregularities undermine the fairness and integrity of the examination process, being violative of principles of natural justice.

Regarding the consideration of foreign prosecution history, the Court acknowledged that the objections relating to D1 and D2 raised in the FER and the Hearing notice were derived from the office actions issued by the EPO during the prosecution of the corresponding EP application. The Court also noted that the EPO thereafter granted the patent. In fact, the pending claims in India were similar to the granted claims in the EPO.

The Court, therefore, remarked that while the IPO is mandated to conduct an independent examination of the patent applications, the grant of the patent in other jurisdictions does warrant due consideration. This is more critical in such cases where the objections mirror the examination reports of other jurisdictions, at least because the grant indicates that the appellant's amendments effectively addressed the objections based on D1 and D2 to the satisfaction of the EPO, suggesting a level of inventiveness and patentability that met the criteria set forth by an established patent authority. This context could have been instrumental in the respondent's decision-making process, offering a perspective that the deficiencies could indeed be fulfilled through claim amendments.

The Court, however, clarified that it does not suggest that the IPO align its decisions with those of the EPO by default. Rather, successful amendment and approval of the claims by the EPO could provide valuable context for a comprehensive examination process by the respondent. The Court, therefore, set aside the impugned order dated November 30th, 2023, and remanded the matter to the respondent for *de novo* consideration.

This judgment by the Delhi High Court reiterates that the IPO cannot refuse a patent application without a reasoned and speaking order and on grounds not presented before the applicant during the examination proceedings. Also, while the foreign prosecution history is not binding, it shall be considered by the IPO, at least in the context of a comprehensive examination of the Indian application. This judgment shall serve as a guiding beacon for the IPO to issue clear and detailed office actions and reasoned orders. From the applicant's perspective, this shall aid the applicants in prosecuting their applications before the IPO more effectively.

15. Understanding the Infringement of Patents by Biosimilars

Case: F- Hoffmann -La Roche Ag & Anr vs Zydus Lifesciences Limited [CS(COMM) 159/2024]

Forum: Delhi High Court

Order Dated: March 13, 2024

Order: In an interim relief action in an infringement suit relating to biosimilars of Pertuzumab, a monoclonal antibody biologic, the Delhi High Court in CS(COMM) 159/2024 [*F-Hoffmann -La Roche & Anr. ('plaintiffs') vs Zydus Lifesciences Ltd. ('defendant')*], have directed the contesting parties to present before the court the material relevant for understanding not only the intricacies of patent law but also scientific principles that are foundational for the biologic and its biosimilar (similar biologic) contender. While adjudicating the plaintiff's application for interim relief, the issue before the Court was the precise determination of whether the defendant's biosimilar development encroaches upon the plaintiff's patent rights or innovator reference biologic. In its order dated 23rd February 2024, the Court outlined a procedural framework that included the submission of claim mappings by parties, process disclosure by the defendant along with setting up of a confidentiality club, the assistance from parties' experts along with possible use of 'hot-tubbing', and the prospect of appointing an independent scientific advisor.

Background

Plaintiffs filed a suit for infringement of two patents (*'suit patents'*), both pertaining to a monoclonal antibody biologic ('Pertuzumab') used to inhibit tumour growth. One suit patent (IN 464646) relates to the ***process*** for making a composition comprising Pertuzumab and one or more variants. The other suit patent (IN 268632) relates to an aqueous pharmaceutical ***formulation*** comprising Pertuzumab and certain excipients. In February 2024, the plaintiffs became aware that the defendant had sought regulatory permission to manufacture a 'New Drug Formulation' for the sale or distribution of Pertuzumab. It was also revealed that the defendant had applied for permission to conduct clinical trials for their product as a similar biologic to that of the plaintiffs' Pertuzumab, and the said application categorically mentioned the plaintiffs' product, which is covered by suit patents as the reference biologic.

Arguments

The plaintiffs argued that a biosimilar is ***nearly*** identical to its reference biologic, and a biosimilar product is similar in terms of quality, safety, and efficacy to an already approved reference biologic product based on comparability. By claiming their product to be biosimilar to that of the plaintiffs' product, the defendant admits that both products are identical in all important parameters. The defendant's biosimilar closely mirrors the plaintiffs' patented product and thereby infringes the formulation suit patent.

Since no methodology for the production of the biosimilar has been disclosed, the plaintiffs also apprehended that the defendant's process employed is identical to their process, thereby infringing on the process suit patent. Moreover, the plaintiffs produced the defendant's patent application (No. 2021079337) relating to formulations of Pertuzumab. In such circumstances, plaintiffs brought a *quia timet* action as they strongly apprehended the imminent threat of the launch of the infringing biosimilar product. It was also submitted that the defendant had filed an unsuccessful pre-grant opposition to the process suit patent and was already aware of the plaintiffs' rights.

Per contra, the defendant argued that no urgency was disclosed in the plaint to warrant the grant of an *ex-parte ad interim* injunction. The defendant further emphasised that the plaint did not disclose any claim mapping to demonstrate that the defendant's product would be infringing upon the suit patents. Rather, the plaintiffs' case rests on an untenable ***proposition*** that a similar biologic is identical to its reference biologic product and therefore amounts to infringement.

Court's Analysis

At the outset, the Court discussed the regulatory pathway for biosimilars. Referring to 'Guidelines on Similar Biologics', the Court noticed that an abbreviated review process underscores the fundamental principle that a biosimilar, by leveraging the exhaustive data of its reference biologic (innovator's product), can offer similar therapeutic benefits (quality, safety, and efficacy) without repeating the extensive clinical trials conducted for the innovator reference product.

Biosimilars are designed to be ***highly similar*** to the reference product but ***not identical***. However, the Court further observed that the regulatory guidelines focus on the approval process and do not directly address patent issues. Therefore, the Court held that the determination of infringement must begin with understanding the scope of the patent(s) held by the reference biologic. If the biosimilar utilises or embodies any aspect (including formulation and manufacturing process) that is patented by the reference biologic, only then could there be a case for patent infringement.

As the innovator reference biologic is protected under the suit patent (IN'632) and the similar biologic is encapsulated by claim 1 in the defendant's patent application No. 2021079337, the Court is required to discern whether the formulation disclosed in the defendant's patent application is a variant of Pertuzumab, different from the plaintiffs' formulation patent, which is also "*pharmaceutical formulation comprising Pertuzumab*". Therefore, as the first procedural step, the Court directed the plaintiffs to carry out the said claim mapping for infringement analysis. The defendant was also permitted to do the claim mapping.

The Court acknowledged the dual aspect of biologic's intellectual property – its molecular structure and the sophisticated processes required for its reliable, safe, and consistent large-scale manufacturing within living systems. The regulatory guidelines for biosimilars stress the importance of process validation as well as the demonstration of a manufacturing procedure that is both highly consistent and robust. In scenarios where the host cell line utilised in the production of the reference biologic is publicly disclosed, there is a strong preference for employing the same host cell line in the manufacturing of similar biologics.

As the plaintiffs have a process patent (IN'646) and are also in the dark about the specific processes used by the defendant in making their biologic product, the Court intended to invoke Section 104A of the Patents Act. Under this provision, when a patent covers a process for obtaining a product, the burden of proof shifts to the defendant to demonstrate that its method for creating an identical product diverges from the patented process, subject to certain prerequisites.

Therefore, the Court directed the defendant to reveal its process for developing the biosimilar for which drug approval/ licensing has been sought. However, the aforesaid information will be submitted in a sealed envelope to preserve sensitive information. The Court will also subsequently assess the need to establish a confidentiality club to manage the disclosed information and ensure that access to such information is appropriately controlled and limited to authorised individuals.

Decision

The Court issued several directions to crystalise the legal and technical facets of the case. Parties were required to provide all pertinent case laws and jurisprudence related to medical and patent matters concerning biologics, extending to both domestic and international precedents. To facilitate an organised examination of expert opinions, each party was directed to disclose the names and credentials of their respective experts in the field of biologics and related IP issues. The Court may employ 'hot-tubbing' for simultaneous questioning of experts from both sides in an open-court format, allowing for a direct comparison of their insights. The Court will also consider appointing an independent scientific advisor to provide neutral expert analysis on the nuances of biologics production and patent protection.

Conclusion

The outcome of this case will for sure lay down the rules and principles for dealing with infringement action in cases where the court is called upon to adjudicate the infringement action against Biosimilars that are designed to be highly similar to the reference product (infringing) but not identical. The direction of the court in this case would encourage the participation of experts and Hot tub discussions.

In particular, the hot-tubbing protocol (concurrent evidence) will save considerable court time and crystallise areas of agreement and disagreement more effectively than traditional cross-examination (sequential evidence).

The court would also devolve into regulatory guidelines that permit innovation/ development within the framework of existing biologics by adhering to stringent standards. In the case of an IP dispute, the Court would decide whether such biosimilar development infringes upon the originator’s patent rights. The *quia timet* action allows the innovator of the reference biologic to take preemptive measures against potential infringement. The procedural steps suggested by the Court in this case will offer a comprehensive adjudication of the interim application.

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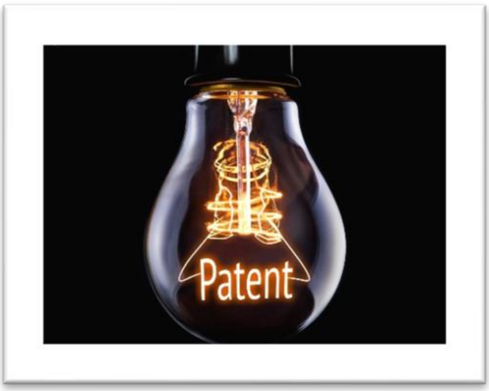
16. Analysing the Judgment in Ashok Leyland Ltd. vs The Controller of Patents & Designs and Tata Motors Ltd.

Case: Ashok Leyland Limited vs The Controller of Patents & Designs and Anr. [W.P.(IPD) No.1 of 2024]

Forum: Madras High Court

Order Dated: March 15, 2024



Order: During the prosecution of a patent application, third parties are provided with an opportunity to object to the grant of a patent through pre-grant and post-grant opposition. These opposition proceedings involve several intricate steps to be taken at various stages by the Indian Patent Office (IPO), the opponent, and the applicant/patentee. As these proceedings are critical in deciding the fate of the patent application or the granted patent, it is essential that the involved parties perform their duties effectively to ensure a systematic and productive conclusion of the proceedings.

The Hon'ble High Court of Madras recently issued a judgement in a Writ petition filed in a post-grant opposition matter, commenting on the relevance of the recommendation of the Opposition Board while reiterating the duties of the Controller deciding on the opposition representation. This matter was basically a Writ Petition filed under Article 226 of the Constitution of India for issuance of a Writ of Certiorarified Mandamus, challenging the recommendations of the Opposition Board in the post-grant opposition proceedings.

The opposition proceedings were initiated by Tata Motors Ltd (Respondent 2) against a patent of Ashok Leyland Ltd. (petitioner), bearing number

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IN387429 and titled Multi-Axle Vehicle Configuration having Heavy Duty Lift Axle.

In particular, the writ petition was filed with the following prayer:

a) to call for the records of the recommendations passed by the Controller of Patents & Designs (Respondent 1) on the Opposition proceedings,
b) to call for the recommendation of the Opposition Board,
c) to quash the recommendation of the Opposition Board, and
d) to direct the respondent 1 to consider the documents filed by the petitioner and the respondent 2 for considering the matter afresh by reconstituting a new Opposition Board for providing a fresh recommendation.

During the opposition proceedings before the IPO, the respondent 2 filed evidence from their experts, Dr. Anoop Chawla and Mr. Amit Kumar Gupta, to further substantiate the arguments in their written statement of the opposition. In response, the petitioner filed a reply statement, which was also supported by the evidence from their experts, Dr. S. Ramamurthy and Dr. Sathya Prasad Mangalaramanan.

The Opposition Board thereafter shared their recommendation on the opposition representation, following which the respondent 1 scheduled a post-grant Hearing in this case for February 7th, 2024. The petitioner filed this writ petition before the scheduled Hearing.

Before the Court, the petitioner argued that the Opposition Board simply copy-pasted the opponent's and petitioner's arguments from their written statement and reply statement, respectively, as reasoning in their recommendation. Moreover, the Opposition Board has not considered the expert evidence filed by both parties, and their recommendation is, therefore, incomplete.

Since the Opposition Board's recommendation forms the foundation of the opposition proceedings, an incomplete recommendation would significantly hamper the entire proceedings. The petitioner also relied on Cipla Ltd. Vs. Union of India and others, arguing that the Hon'ble Supreme

Court, in this case, emphasised that the Opposition Board needs to consider the evidence produced by both the parties in arriving at their recommendation.

The petitioner acknowledged that they may have an opportunity to address the flaws in the Opposition Board's recommendation during the hearing before the Controller, and they may also require him to consider the evidence that is overlooked by the Opposition Board.

However, they also emphasised that if the Controller is unconsciously influenced by the incomplete recommendation, the economic ramifications of an adverse order would be severe for the petitioner. Therefore, the Opposition Board's recommendation must be set aside at this stage only, and a new Opposition Board may be constituted to make a fresh recommendation.

On the other hand, the Respondent 2 argued that the Opposition board has indeed considered the evidence submitted by both the parties, but without referring to the names of the experts. To substantiate their arguments, respondent 2 submitted a table highlighting the portions of the recommendation that referred to the expert evidence filed by both parties.

In order to establish the application of mind, the respondent 2 highlighted that while they had objected to the grant of the patent on 5 grounds in their written statement, the Opposition Board has found only one of those grounds to be valid in their recommendation, dismissing the other 4 grounds. This indicates that the Opposition Board has applied their mind in arriving at their recommendation and it is not a mere cut-copy-paste job.

The respondent 2 further argued that the recommendation is not binding on the Controller and both the parties can discuss the evidence with the Controller during the Hearing. Therefore, a mere allegation that the recommendation is incomplete is not sufficient to invite interference of this Hon'ble Court in judicial review. Hence, this petition is not maintainable as the Controller is dutybound to take an independent call on the issue before him.

The respondent 2 concluded by iterating that the petitioner's apprehension is not based on what has happened but is based on what is likely to happen. After hearing both the parties, the Court identified the primary issue to be how far this Court can interfere with the Opposition Board's recommendation in the judicial review?

The Court remarked that once the materials filed by both the parties under Rules 57 to 59 are furnished before the Opposition Board, it is up to the Opposition Board to decide on the extent to which such material is considered and appreciated for arriving at the recommendation. In this case, since these materials involve complex issues of scientific applications, it may not be appropriate for this Court to examine the adequacy of such recommendation in the exercise of its jurisdiction under Article 226 of the Constitution.

The Court further acknowledged that this recommendation by the Opposition Board is only a recommendation, which is not binding on the Controller. It is up to the Controller to decide on the qualitative merit of the recommendation. This recommendation will be one of the many materials to be considered by the Controller during the post-grant opposition Hearing. Hence, the petitioner will have an opportunity to expose the alleged inadequacy of the recommendation before the Controller during the scheduled Hearing.

The Court accordingly found it inappropriate to pre-empt a decision on the quality of recommendation in the judicial review and held that the responsibility of determining the reliability of the recommendation had been assigned to the Controller by the statute. If the Controller does believe that there are inadequacies in the recommendation, the Controller may reconstitute the Opposition Board for a fresh recommendation. The Court, therefore, dismissed the petition.

This judgement clarifies that the Opposition Board's recommendation shall not be treated as the conclusion on the merit of the invention. It merely acts as a suggestion to the Controller for deciding on the opposition representation. In effect, this judgement enunciates the huge responsibility being assigned to the Controller in deciding on the opposition

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representation, which eventually decides the fate of a patent application or the granted patent.

Owing to the increasing IP awareness in the country, the number of post-grant oppositions being filed at the IPO are also increasing. Therefore, this judgement from the Hon'ble Madras High Court could be instrumental in the patentees and the opponents formulating their strategy in the opposition proceedings, at least from the perspective of addressing the Opposition Board's recommendation.

17. Delhi High Court Refuses to Vacate Interim Injunction Granted in Favour of Novartis for Compound Ceritinib

Case: Novartis Ag vs Nacto Pharma Limited & Anr. [CS(COMM) 229/2019]

Forum: Delhi High Court

Judgment Dated: April 09, 2024

Judgment: In a recent judgment passed on 09 April 2024 by Hon'ble Delhi High court, an important position of law was discussed regarding vacation of interim relief granted by the Court. Natco Pharma has filed IA 4636/2023, to vacate the interim relief granted to Novartis by judgment dated 09 January 2023.

Novartis, through IA 6384/2019, approached the court to obtain an order to restrain Natco Pharma from exploiting their patented invention covered under Indian Patent no, IN 276026 (IN'026). The patent IN'026 relates to "Novel Pyrimidine Compounds and Composition as Protein Kinase Inhibitors", and specifically, it relates to the active compound "Ceritinib". The major reasons why the Court has granted interim relief to Novartis are as follows:

1) the Court observed that a markush claim in a genus patent could said to disclose only those compounds which could be synthesised by person skilled in the art. The disclosure is required to enable it in nature. Thus, obviousness from prior art was the determinative criterion on which the court would ascertain whether the claim in the species patent was obvious from the teachings in the genus patent.
2) Further, the Court also stated that the fact that the genus patent has remained in existence for a number of years, the species patent was

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not synthesised by anyone, prima facie indicated that the specie patent was not obvious from the teachings in the genus patent.

3) the Court also observed that for obviousness, Natco had cherry-picked selected radicals from the several substituents to arrive at the molecular structure of Ceritinib. However, no specific averment has been made to support choosing the selected substituent from the several substituents suggested in the prior art. The submission made by Natco that there is no distinction between coverage and disclosure was rejected by the Court.
4) the Court held that if the claim in the suit patent is obvious to a person skilled in the art from the teachings of the complete specification, only then can the patent be regarded as vulnerable to invalidity on the grounds of anticipation and obviousness.
5) Novartis contended that over other drugs that act as ALK-inhibition therapy, Ceritoinib possessed the advantage of fewer side effects, which itself constituted an inventive step, as the suppression of adverse side effects is a matter of vital importance in chemotherapy.
6) Natco's submission that Novartis is bound to submit X-ray diffraction pattern was found by the Court as without substance in view of Division bench judgement in the matter of Merck Sharp & Dohme Corporation v. Glenmark, which has held that at the stage of adjudication under Order XXXIX Rules 1 and 2 of the CPC, the court cannot examine X-ray diffraction patterns.
7) Natco also placed the reliance on the fact that while applying for Patent Term Extension (PTE) for US'592 patent, Novartis has stated that the patent claimed Ceritinib. The Court observed that it was stated that Ceritinib was covered by the Markush claim in US'592.
8) Natco also sought reliance on the fact that while obtaining NDA for ZYKADIA, the brand name under which Ceritinib is sold, Novartis has mentioned all the prior art documents referred by Natco. The court observed that it was done to comply with the U.S.C. § 355(b)(1).

Keeping in view all the above factors the Court was of the opinion that the prime facie the patent seems valid thus interim relief was granted in favor of the patentee Novartis and Natco Pharma was restrained, pending disposal of the suit, from exploiting the patent IN'026, or manufacturing or selling Ceritinib without obtaining a license from Novartis.

Natco, in the present matter, approached the Court to vacate the interim order. The interim injunction was not contested on merit; rather, the only ground raised by Natco was that Novartis had filed a divisional application no. 5338/DELNP/2014, with respect to some of the claims of IN'026. As per Natco's argument, Ceritinib was claimed as a compound 66 in the claims of divisional application. Natco's submission was that since the divisional application was finally refused, it was incumbent on Novartis to disclose the same. It was also the fact that it was finally refused, as it would have seriously impacted the outcome of the interim injunction.

It was contended by Natco that since the compound was claimed in the divisional application and the same has been refused, the compound is now available to the public. Also, it was argued that since the refusal of the application was under section 15, it has to be treated as a decision on merits.

Novartis argued that they chose not to prosecute the divisional application further, thus, it was abandoned, and this should not be treated as rejection on merits. Also, it was submitted by Novartis that, as per law, the parent patent could invalidate the divisional application and not *vice-versa*. Further, Novartis also submitted that suppression and concealment cannot be used as a ground for seeking vacation of interim order.

After considering all the facts and circumstances, the Court came to the analysis that the order passed in the divisional application clearly states that the applicant has informed that they do not wish to pursue the application further. Thus, the divisional application cannot be considered as refused on merits. The Court held that the decision not to pursue the divisional application cannot estop the patentee from contesting the grounds on which the validity of the patent was sought to be assailed by the defendant.

The Court also held that even if it is considered that the order under section 15 is order on merits, it goes without saying that the decision of Controller is not binding on this court. The opinion of the Controller can hardly be cited as grounds for High Court to revisit its decision.

Regarding order XXXIX Rule 4, the Court held that though there is an averment in the present application that it has been necessitated owing to a change in circumstances, the averment is not supported by any material whatsoever. The abandonment of divisional application cannot constitute a ‘change in circumstances” within the meaning of order XXXIX Rule 4 of the CPC.

The Court categorically held that there could be obviously no question or revisiting the decision merely on the basis of the submission made by Natco regarding the divisional application and its outcome. The court also concluded that the suppression of a fact that, if disclosed, would alter the outcome of the case, which can be regarded as a material fact, would justify a revisitation of the order of interim injunction. The court, while refusing the present application filed by Natco, held that refusal of the divisional application does not, either in fact or in law, extinguish the suit patent. The compound Ceritinib is covered under the suit patent; thus, until and unless the suit patent is invalidated, it remains valid, and any exploitation of Ceritinib would amount to infringement of the suit patent.

This judgment by the Hon’ble Delhi High Court has once again established strong jurisprudence in favour of the innovators. This judgement would send a good signal globally that India gives due respect to the innovator's rights, and just on the basis of public interest, the rights of the patentees would be jeopardised. This would definitely encourage the innovators to secure their intellectual property in India. We expect more such judgments from the courts, which would send a strong message to the public at large that infringement of intellectual property rights may not be tolerated by Indian courts.

DESIGNS

1. Design Infringement and Passing Off: TTK Prestige Ltd vs Arjun Ram & Anr.

Case: TTK Prestige Ltd vs Arjun Ram & Anr. [CS(COMM) 915/2022]

Forum: Delhi High Court

Order Dated: January 31, 2024

Order: The Plaintiff- TTK Prestige Ltd, filed this case seeking a judgment decree as the defendants had failed to appear. The Plaintiff referred to an order dated 19th October 2023, where the Court granted an ad interim injunction.

The defendants had previously appeared on multiple dates, as recorded in para 9 of the said order. Despite this, subsequent attempts to serve the defendants were unsuccessful, indicating a lack of response from the defendants.

The Court's order dated 19th October 2023 granted an ad interim injunction and subsequent attempts to serve the defendants through their counsel. Paragraphs 12 and 13 of the order highlight the Court's efforts to contact the defendants, which yielded no response or appearance on behalf of the defendants. Considering the defendants' repeated non-appearance and lack of response, the Plaintiff sought a decree in compliance with Order VIII Rule 10 of the Code of Civil Procedure, 1908.

The Court referred to its previous order dated 19th October 2023, where it adjudicated various aspects of infringement alleged by Plaintiff. The Court found that the defendants had replicated distinctive features of the Plaintiff's product, establishing prima facie cases of design piracy and trademark infringement.

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The Court noted that the defendant's trade dress was almost identical to the Plaintiff's , leading to a prima facie case of passing off. The defendants' actions were seen as potentially deceiving consumers and infringing on the Plaintiff's rights.

Considering the defendants' continued non-appearance, the Court decided to grant a decree in favour of the Plaintiff. The conclusions drawn by the Court in the previous order formed the basis for the decree.

The Court clarified that no decree or injunction was pressed against the defendant's use of their trademark "PARISTONE" unless used deceptively. Permanent injunctions were decreed against the defendants for engaging in specific activities related to manufacturing, selling, or using trade dress similar to Plaintiff's .

Hence, the Court passed a decree for permanent injunction restraining the defendants, their associates, dealers and agents, and all acting on their behalf from manufacturing, selling, offering for sale, exporting, advertising or directly or indirectly dealing in any manner (including online through websites or other shopping portals or offline) in pressure cookers (in any size or variation) bearing the impugned design or any other design being an obvious imitation of the Plaintiff's Design Registration No. 324727-001.

The Court further restrained the defendants, their associates, dealers and agents, and all acting on their behalf, from manufacturing, selling, offering for sale, exporting, advertising or directly or indirectly dealing in any manner (including online through websites or other shopping portals or offline) in pressure cookers or any other identical or similar/ cognate and allied goods using label/trade dress/ packaging or any other label/packaging/ trade dress which may be identical and or deceptively similar to the Plaintiff's packaging/label/ trade dress which is likely to cause confusion and deception amongst the consumers and amount to passing off.

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2. Delhi High Court Remands Case Involving Alleged Design Infringement

Case: Pardeep Kumar, Proprietor Of T.G. Solar vs Prakash Enterprises & Ors [FAO (COMM) 65/2024 & CM APPL. 21504-05/2024]

Forum: Delhi High Court

Order Dated: April 10, 2024

Order: In a recent development, the Delhi High Court has issued an order remanding the case of Pradeep Kumar, the proprietor of T.G. Solar Pump, versus Prakash Enterprises & Others. The appellant, Pradeep Kumar, filed an appeal against an order dated 19.03.2024 passed by the learned Commercial Court in C.S. (COMM) No.184/2024. This order declined the appellant's request for an ad interim injunction restraining the respondents from infringing its registered designs as outlined in the plaint.

Pradeep Kumar alleged infringement of his registered designs concerning Solar Panel Trolleys (SPT) by Prakash Enterprises and others. The appellant claimed to hold nine registered designs for SPTs, asserting that the respondents were manufacturing similar SPTs. The appellant presented images of his SPTs constructed according to the registered design alongside those allegedly fabricated by the respondents.

It's noted that respondent No. 1 had previously been accused of infringement and had undertaken not to infringe upon the appellant's registered designs. However, the other respondents did not provide such an undertaking, and no cease-and-desist notice was issued to respondent No. 2.

The Commercial Court denied the ad interim order primarily because the appellant failed to demonstrate that the designs of SPTs manufactured and sold by the respondents were not registered. Additionally, the Court observed that invoices provided by the appellant did not mention design details, and no photographs of the allegedly infringing SPTs were submitted.

However, the High Court found the Commercial Court's reasoning insufficient. It noted that the appellant had provided details of their registered designs and highlighted the lack of evidence suggesting that the respondents' SPTs were based on registered designs.

The High Court, therefore, set aside the impugned order and remanded the matter to the Commercial Court. The Court directed the Commercial Court to reconsider the appellant's request to appoint a local commissioner without issuing any notice to the respondents. The case is scheduled to be heard again on 23.04.2024.

This decision by the Delhi High Court marks a significant development in the ongoing legal battle over alleged design infringement. The remand order provides an opportunity to further examine the evidence and underscores the importance of procedural fairness in intellectual property disputes.

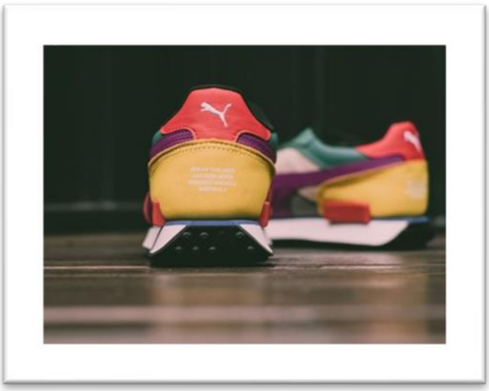
DOMAIN NAMES

1. Trademark Turmoil: PUMA's Legal Battle Against Counterfeits on IndiaMART

Case: Puma Se vs Indiamart Intermesh Ltd [CS(COMM) 607/2021]

Forum: Delhi High Court

Order Dated: January 3, 2024



Order: This suit was filed by PUMA SE (plaintiff) against the website www.indiamart.com owned by IndiaMART IndiaMESH Ltd. for displaying various counterfeit goods bearing fake "Puma" marks, put up by third-party sellers for purchase.

Puma SE is one of the world's leading manufacturers of sportswear and accessories. It uses distinctive logos, which are its source identifiers. "PUMA" is registered in the plaintiff's name as a word mark. The defendant IndiaMART IndiaMESH Ltd ("IIL") operates the website www.indiamart.com. Merchandise from various manufacturers is available on the said website.

The website allows a consumer to enter a search option in the space provided. The plaintiff's grievance is that if one enters, in the said space, the search word "PUMA", various counterfeit goods bearing fake "Puma" marks, put up by third-party sellers, are displayed for purchase. These goods also bear the plaintiff's registered trademarks.

The plaintiff submitted that most of the goods that various sellers put up as genuine PUMA sportswear or allied products are, in fact, counterfeits. IIL's IndiaMart e-commerce website is, therefore, being used to peddle counterfeit goods of the plaintiff. Using the plaintiff's registered trademarks

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on such counterfeit goods amounts to infringement within the meaning of Section 29 of the Trademarks Act, 1999. It was alleged that by using the said marks, the goods on which they are used and sold on the IndiaMart e-commerce platform are also, therefore, being passed off as genuine goods of the plaintiff.

The plaintiff's grievance against IIL, the sole defendant in the suit, is that IIL is aiding, abetting, and facilitating such infringement and passing off. IIL does no prior verification before accepting a seller registered on its website as peddling the goods of a particular reputed brand. The result is that IIL's IndiaMart platform is used to market counterfeit goods, in the bargain defrauding customers, infringing the plaintiff's registered trademarks, and passing off the counterfeit goods as the plaintiff's goods.

By not conducting any verification of the seller's credentials and by providing "Puma shoes" as a drop-down option that the seller can choose while registering himself as a dealer in a particular product or product range, it is alleged that IIL is facilitating infringement and passing off by sale of counterfeit products. He alleges this amounts to aiding and abetting infringement and passing off.

The Court noted that it is a settled principle of law that the expression "in advertising" is not synonymous with "in an advertisement". For a registered trademark to be regarded as having been used "in advertising", therefore, it is not necessary that the registered trademark must feature in an advertisement. Thus, using a trademark as a keyword to trigger the display of an advertisement for goods or services would amount to using the trademark in advertising.

Therefore, in the present case, the use of the plaintiff's registered trademark as one of the drop-down choices available to the seller at the time of registration with the IndiaMart platform would also amount to "use" of the trademark within the meaning of Section 2(2)(b) and 2(2)(c)(i). Section 2(2)(b) clarifies that any reference in the Trademarks Act to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark.

The Court observed that though the "Puma shoes" option provided in the drop-down menu is visible only to the seller at the time of registering himself with the IndiaMart platform and is not visible to the consumer who visits the website with intent to purchase goods, and though it is provided only at the "backend" of the registration process, the providing of the option itself constitutes "use of a mark" of the plaintiff, within the meaning of the Trade Marks Act.

IIL does not include all brands in its drop-down menu but only selects brands of reputed manufacturers. There is a conscious participation by IIL in determining the drop-down choices. Thus, a prima facie case of infringement within the meaning of Section 29(1), (2) and (4) of the Trademarks Act exists.

On the aspect of safe harbour, the Court observed that Rule 3(1)(b)(iv) of the IT Rules requires every intermediary to make reasonable efforts to cause users of its computer resource not to host, display or upload any information that infringes any patent, copyright, or other proprietary rights. Having been cautiously inserted, this requirement must be given a strict interpretation. Strict adherence and compliance with the requirements are mandatory.

Rule 3(1)(b)(iv) of the IT Rules has to be read alongside Section 79 of the IT Act. While sub-section (1) of Section 79 insulates an intermediary from third-party information, data or communication links made available or hosted by it, subsection (2) sets out the circumstances in which this protection would be available and sub-section (3) sets out the circumstances in which this protection would not be available. Both these provisions prima facie against IIL in the present case.

The Court further observed that Section 79(2) stipulates the three circumstances in clauses (a), (b) and (c) thereof, in which Section 79(1) would apply. Of these, clauses (a) and (b) are separated by the conjunction "or", whereas there is no conjunction between (b) and (c). One presumes, however, that clauses (b) and (c) are also to be deemed as having been separated by the conjunction "or".

This indicates that it is not necessary that all three clauses (a) to (c) must simultaneously apply for Section 79(1) to apply and that Section 79(1) would apply if any one of the three clauses (a) to (c) of Section 79(2) is applicable. In the present case, however, none of the three clauses (a) to (c) of Section 79(2) applies. Thus, As IIL has, therefore, prima facie aided the commission of the unlawful act of counterfeiting and infringement, it cannot claim the benefit of safe harbour under Section 79(1).

Thus, the Court held that the plaintiff has been able to make out a prima facie case of infringement by IIL of the plaintiff's Puma trademark as would justify it to an injunction as sought.

2. Why Well-Known Marks Need That Extra Protection

Case: Infiniti Retail Ltd. v. Croma-Share [CS(COMM) 838/2022 & I.As. 20435/2022, 863/2023]

Forum: Delhi High Court

Order Dated: January 19, 2024

Order: A well-known trade mark deserves protection against unauthorised use across all categories of goods and services. It flows from its exalted reputation, and its unauthorised use has the potential to cause confusion and deception to mislead the public and members of trade. An unscrupulous entity may also misuse a well-known trade mark to defraud the public and obtain an undue commercial advantage.

In a recent case decided on January 19, 2024, by the Delhi High Court, protection against misuse of a well-known trademark was awarded to the plaintiff, namely, Infiniti Retail Limited, the proprietor of the well-known and registered trademark CROMA. As the defendants, M/s Croma-Share & Ors., did not appear before the court despite being summoned, the matter was heard *ex-parte*. It was the case of the plaintiff that they owned trademark registrations for the marks CROMA, cromā, INFINITI RETAIL, infiniti retail ltd, and their formatives. The plaintiff offered a wide range of electronics, consumer products, household and kitchen appliances, mobile phones, computers, audio and video products, cameras, grooming and wellness products, etc., at more than 260 stores spread across India as well as through their website www.croma.com. The plaintiff's goods and services were first launched in 2006 and garnered significant goodwill. Its mark CROMA / cromā, a coined term, had been declared a "well-known trademark" by the Trade Marks Registry on February 24, 2020. In November 2022, after receiving several complaints, the plaintiff discovered that the defendants were operating the websites "www.croma-share.com", "www.croma-2.com", "www.croma-1.com", and www.croma-3.com with the modus operandi to defraud people by taking money under the pretext of recruiting them for part-time jobs with "CROMA"/ the plaintiff company. The job description required the recruitees to shop online to help increase sales in return for a commission along with a refund of the principal amount.

The process was divided into different levels, requiring the recruitees to pay increasing amounts of money for each subsequent level, from Rs. 180/- to Rs. 42,000/-. When the recruitees asked the defendants for proof of authenticity, the defendants supplied false and fabricated employee IDs, corporate registration in Belize, communications bearing the plaintiff company's letterheads purportedly signed by the plaintiff's CEO, etc.

The court, on December 5, 2022, while issuing summons, passed an *ex-parte* ad-interim injunction restraining the defendants from infringing the plaintiff's CROMA marks through instances such as misuse of the trademark or registering corporate names, domain names, including the impugned websites viz. www.croma-share.com, www.croma-2.com, www.croma-1.com and www.croma-3.com or listings on social media and e-commerce websites.

The court observed that the impugned websites depicted the plaintiff's CROMA mark and solicited personal information and money from the consumers/recruitees. As the domain names fully incorporated the plaintiff's CROMA mark, the unsuspecting public was deceived into believing they were securing a lucrative job offer at the plaintiff's company, thereby falling prey to the defendants' ploy.

The court noted that the likelihood of confusion was evident and that the defendants' activities amounted to infringement and passing off of the plaintiff's CROMA marks. The court also acknowledged the submissions of the plaintiff that since the impugned websites also emulated the terms and conditions of use, privacy policy, etc., displayed on the plaintiff's website, www.croma.com, it amounted to infringement of the plaintiff's copyright vested therein.

The court held and observed that since the plaintiff had a high standing in the market and its CROMA mark also enjoyed a well-known status, the impugned activities of the defendants were causing irreparable loss to the goodwill and reputation of the plaintiff. Thus, the plaintiff was entitled to a permanent injunction as sought. The court also ordered that the impugned websites be permanently blocked and the UPI IDs and mobile numbers of the defendants, as mentioned in the plaint, be permanently suspended and disabled.

Trademarks are part of the unique identity of proprietors and their products and services, and they should be protected. Building a reputation that the courts will protect takes much time, resources, and investment. The courts' protection for well-known trademarks will encourage their proprietors to expand their business activities and safeguard against misuse and fraud.

PLANT VARIETY AND FARMER'S RIGHTS

1. Registration of a Plant Variety Cannot be Revoked Until the Errors are Fundamental, Deliberate or Intentional

Case: PepsiCo India Holdings (P) Ltd. v. Kavitha Kuruganti [LPA 590/2023 & CM APPL. 42282/2023]

Forum: Delhi High Court

Order Dated: January 09, 2024

Order: PepsiCo, Inc., a renowned American multinational food, snack and beverage corporation, applied for registration of its potato variety FL-2027 on February 18, 2011, with the Protection of Plant Varieties and Farmers' Rights (PPV&FR) Authority (hereafter "the Authority") to secure its intellectual property rights in India. On February 01, 2016, a certificate of registration was issued by the Authority.

On June 17, 2019, Kavita Kuruganti, a famous farmers' rights activist, filed an application for revocation of registration on the ground that registration was based on incorrect application details and was granted to a person not eligible for protection, also the grant of registration not being in the public interest. After hearing both parties, the Authority revoked the registration of the plant variety registration of PepsiCo., under section 34(a), (b), (c) and (h) of the PPV&FR Act.

Being aggrieved by the order of the Authority, PepsiCo filed an appeal against the order at the Delhi High Court. The learned single judge upheld the revocation. PepsiCo preferred the present appeal to the Division Bench of Delhi High Court.

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Key Issues

In the present case, the key issues before the Court were whether the submission of incorrect information relating to the date of first sale of the candidate variety by PepsiCo, as well as its failure to provide the requisite documentation at the time of registration, are appropriate ground for revocation of its registration under section 34 (a), (b) & (c) of the PPV&FR Act. Also, whether the act of PepsiCo for instituting various suits against farmers is not in the public interest, therefore, the certificate of registration granted is liable to be revoked under clause (h) of Section 34 of the PPV&FR Act.

Decision of Learned Single Judge

In the impugned judgement, the learned single judge held that as the certificate for registration was ultimately granted under the 'extant' category,' therefore the appellant PepsiCo could not have been held guilty of having obtained the registration by providing incorrect information on the category of candidate variety in the application form and thus it could not be a ground to revoke the registration under section 34 (a) of the Act.

However, since the applicant had made a *bona fide* mistake by providing an incorrect date of commercialisation of the variety, the learned single judge in the impugned judgement held that the date of the first sale of the variety is important and material information for the application. It is the duty of the applicant to provide correct information in the application, failing which it opens itself up to revocation of the registration granted under section 34 (a) of the Act.

Also, PepsiCo, during the prosecution of the application, did not file any document that it is authorised to file the application as an assignee; therefore, the learned single judge in the impugned judgement upheld the revocation of registration granted under section 34 (b) of the PPV&FR Act. Regarding section 34 (c) of the PPV&FR Act pertaining to the issue of the assignment deed not being signed by the breeder and being insufficiently stamped, the learned single judge in the impugned judgement held that the appellant PepsiCo filed the amended application without rectifying the error therefore, the application filed by the appellant contains deficiencies and the

Authority, under section 34 (b) and (c) of the Act, was justified in revoking the registration granted.

Regarding section 34 (h) of the PPV&FR Act pertaining to the issue that PepsiCo had instituted various suits against innocent farmers, the learned single judge in the impugned judgment decided the issue in favour of appellant PepsiCo and decided that mere filing of litigations by the appellant-respondent against the farmers cannot be construed that registration not being in public interest therefore the PPV&FR Authority erred in revoking the registration under section 34 (h) of the PPV&FR Act.

Court Analysis

In the present case, two cross-appeals were filed by PepsiCo India Holdings Pvt. Ltd. (hereafter "the appellant-respondent") and Kavita Kuruganti (hereafter "the respondent-appellant") against the learned Single Judge judgement dated July 05, 2023. After hearing both the parties and based on the review of the impugned judgement of the learned single judge, the Court observed that as per paragraph 48 of the impugned judgement, there did not appear to be any dispute that FL 2027 was an extant variety.

Also, in paragraph 57 of the impugned judgment, it was observed that PepsiCo had nothing to gain by representing FL 2027 as a new variety. In view of the above, the Court observed that the appellant-respondent could not be held guilty of having obtained the registration by furnishing an incorrect declaration on the category of candidate variety. It was a clerical error noticed by the Registrar, and registration was granted in the correct category.

Therefore, this is decided in favour of the appellant-respondent. After examining the records of the PepsiCo application, the Court observed that the prescribed rigorous registration process was followed before the granting of registration. In view of the above, the principal issue for consideration before the division bench is the scope and intent underlying section 34 and identifying the circumstances that would warrant the power of revocation being invoked, as exercised by the Authority.

After a close reading of Section 34 (a)-(e) of the PPV&FR Act, the Court establishes that these clauses are concerned with the inherent invalidity of the grant and specify grounds that would have a material and foundational impact on the validity of the grant. Therefore, the Court decided that section 34 power is neither intended to be exercised nor would it be attracted at the slightest infraction. Section 34 (a) and (b) would be merited when the Authority finds that circumstances and facts evidence that registration could not have been granted at all. Section 34 (c) says that the breeder has failed to provide the information and documentation that would have a material bearing on the grant itself.

In view of the above, the power of revocation would thus be confined only to situations where it is found that the grant has come to be made in favour of a person or variety that was ineligible or where a variety that was otherwise not entitled to be registered has been accorded protection. To substantiate its decision on the issue of incorrect information furnished by the appellant-respondent, the Court referred to the Delhi High Court Division Bench judgment in *Koninklijke Philips Electronics N.V. vs Maj. (Retd) Sukesh Behl & Anr.* (CS (OS) No. 2206 of 2012), where it was held that revocation is not automatic, and it would follow only if the Court believed that omission to furnish the information was deliberate.

In the present case, although PepsiCo had repeatedly ticked the box meant for the new variety, it had clearly communicated in response to the Registrar's letter dated June 09, 2011, that it was seeking registration of FL-2027 under the extant category. Therefore, the Court concurred with the findings of the learned single judge that registration was not liable to be revoked under section 34 (a) of the PPV&FR Act.

The Court disagreed with the conclusion drawn by the learned single judge that incorrect disclosure of the date of the first sale of candidate variety would materially affect the grant and observed that PepsiCo would not derive any benefit in making a deliberate or conscious declaration of the date of first sale as December 17, 2009, as the variety is still eligible for registration and it would also not affect the term of protection.

Therefore, this issue is also decided in favour of the appellant-respondent. Further, the Court observed that section 2(j) and section 15(3)(a)(ii) pertain to novelty clauses with respect to new varieties and are not relevant to extant varieties. Therefore, the Court disagrees with the possibility of PepsiCo having made declarations with respect to the first sale, bearing in mind the language in which Section 2(j) of the Act stands couched. Also, the Court is not satisfied with the submission of respondent-appellant that the absence of a formal assignment by FLNA in favour of PepsiCo was fatal to the application.

The Court observed that section 16(1)(c), read with clause (e), empowers the assignee of the breeder, FLNA in the present case, to authorise PepsiCo to seek registration of FL2027 under the Act, thus obviating the requirement of the original breeder signing the application. In view of the above, the Court decides that neither the application nor the ultimate grant suffers from fundamental misdeclaration or a failure to provide information as required by the provisions of the Act read along with the Rules.

Therefore, the revocation of registration under sections 34(a), (b), and (c) is not sustainable and is liable to be quashed. Also, the respondent-appellant failed to discharge the burden that suits filed by the appellant-respondent are intimidatory or vexatious. Therefore, revocation under section 34 (h) is also unsustainable and liable to be quashed.

Decision of Division Bench

The Division bench of Delhi High Court consisting of Justice Yashwant Varma and Justice Dharmesh Sharma had decided that the learned single judge in the impugned judgement rightly concluded that the mistake of styling the candidate variety as new variety is remediable and not fatal since the Registrar itself had decided to process the application under extant category. The Court also affirmed the impugned judgement in so far it negatived the challenge based on section 34 (h).

However, the Court does not uphold the view of the learned single judge pertaining to the incorrect mention of the date of the first sale as well as a conclusion drawn on the ineligibility of PepsiCo to apply for registration and non-submission of relevant documentation. The appeal of PepsiCo is allowed, and the impugned judgment and order dated July 05, 2023, is set aside to the extent mentioned above.

Consequentially, the order of the Authority dated December 03, 2021, and the letter issued by the Authority on February 11, 2022, is also annulled. The application for renewal of registration made by the appellant-respondent dated January 28, 2022, shall stand restored and will be proceeded by the Registrar in accordance with the prescribed law.

Conclusion

In the present case, the division bench of Delhi High Court decided that a registration certificate issued under the PPV&FR Act is liable to be revoked under section 34 of the Act only if the error noticed is fundamental, deliberate, or intentional. Accordingly, in future, the Authority should use such discretionary powers only if the deficiencies pointed out go to the very root of the registration and cloud the eligibility of the applicant.

The examination process of the application at the Registry of the Authority should be done diligently to avoid such clerical errors, and the applicant must follow the prescribed procedures to comply with the requirements of the Act. Also, the Authority should take effective measures to promote the enforcement of plant breeders' rights granted under the Act and should create awareness among the farmers about the provisions of the Act. It would help promote plant variety registration in India so that improved crop varieties would reach the farmers and ultimately boost the agricultural economy of India.

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2. Resurrection of Section 24(5) of the Plant Varieties Act

Case: PepsiCo India Holdings (P) Ltd. v. Kavitha Kuruganti [LPA 590/2023 & CM APPL. 42282/2023]

Forum: Delhi High Court

Order Dated: February 22, 2024

Order: Section 24(5) of the Protection of Plant Varieties and Farmers' Rights Act, 2001 ["PPVFR Act"] has been a contentious clause in intellectual property law. Even before the registration of plant variety, the said provision enables an applicant to seek injunctive relief and damages against any abusive act committed by any third party. In *Prabhat Agri Biotech v. Registrar of Plant Varieties* (2016:DHC:7792-DB), a Division Bench of the Delhi High Court has held this provision to be ***ultra vires*** as it confers unguided and uncanalized power on the authority. Later, this judgment of the Division Bench was **stayed** by the Supreme Court in *Pioneer Overseas Corp. v. Kaveri Seed Co. Ltd.* (SLP(C) 19195/2017). Recently, a Single Bench of Delhi High Court ['Court'] in ***UPL Limited v. Registrar & Anr.*** (2024:DHC:1913) elucidated the ramifications of the Supreme Court's stay on the High Court's declaration of the provision as *ultra vires*, concluding that Section 24(5) has **not** been **erased** from the statute.

Relevant Law & Facts

Section 24(5) of the PPVFR Act in dispute is reproduced as follows:

> *"24. Issue of certificate of registration.—*
>
> *(5) The Registrar shall have power to issue such directions to protect the interests of a breeder against any abusive act committed by any third party during the period between*

filing of application for registration and decision taken by the Authority on such application."

The appellant (UPL Limited) had applied for registration of its hybrid *Raadhika* Okra varieties. Further, the appellant in its application u/s 24(5) stated that Respondent No. 2 by commercialising varieties *Bindu*, was abusing the commercial interest of the applicant's varieties and, therefore, reliefs of injunction, damages, and rendition of accounts were sought against Respondent No. 2. By way of the impugned order, the Registrar of PPVFR Authority (Respondent No. 1) has rejected the appellant's application by holding that an application under Section 24(5) is maintainable only upon grant of plant variety registration and not while the application for registration is still under consideration. The Registrar also stated that legally, the interest of a breeder cannot be enforced. Only a right can be enforced. Upon hearing the parties, the Court provided the following insights:

Court's Analysis

A. Literal interpretation of statutory provision

The Court addressed the first issue as to whether the Registrar could have rejected an application under Section 24(5) of the PPVFR Act on the ground that it was premature as there was no registration of the plant variety. The Court held that a **plain reading** of the provision and the expression *"during the period between the filing of an application for registration and decision taken by the Authority on such application"* explicitly provides that Section 24(5) of the PPVFR Act vests the Registrar with the power to issue directions during the period between the filing of an application for registration and the rendering of a decision.

Thus, the reasoning of the Registrar in the impugned order was held to be contrary to the mandate of the statute. The Court further observed that the Registrar's rationale in the impugned order diverged from the Registrar's stand in the pleadings submitted before the Supreme Court in connected Civil Appeals No. 19653-19654/2017, wherein Section 24(5) was interpreted as an interim measure (during the period commencing from the application till the final decision on the application). Therefore, the Court concluded the Registrar's decision to be fundamentally flawed.

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B. Legal implications of Supreme Court's stay

The Court next turned to the central issue as to whether the Supreme Court's stay in *Pioneer Overseas (supra)* nullified the effect of the Division Bench's declaration of Section 24(5) of the PPVFR Act as *ultra vires*. Citing an Apex Court's precedent and a few High Courts' judgments on the legal effect of a stay order, Respondent No. 2 argued that the Supreme Court's stay merely suspends the execution or enforcement of the Division Bench's decision without erasing its findings or reasoning. Respondent No. 2 further contended that the reasoning set forth by the Division Bench would still apply to the extent that Section 24(5) continues to be unconstitutional and, therefore, has no legal effect.

However, the Court did not find these arguments compelling. Rather, the Court emphasised the need for a nuanced case-by-case examination when assessing the effect of a stay order. The Court held that the rationale behind imposing a stay depends on the nature of the dispute and is often tailored meticulously to fit the unique circumstances of each case. Whether a dispute involves individual parties or raises questions of wider legal or constitutional significance would be a pertinent factor in understanding the implications of any stay granted.

Applying the aforesaid principle in the instant case, the Court noticed that the Division Bench's decision in *Prabhat Agri Biotech (supra)* **specifically addressed the constitutional validity** of Section 24(5) of the PPVFR Act as below:

> *"40. ...the danger of abuse of the provision itself and the attendant (likely) long-term injury to innocent breeders, farmers, and those in the business of development of hybrids and plant varieties far outweighs its benefits, in view of the unguided nature of the power, which is ... contrary to Article 14 of the Constitution of India. Section 24(5) ..., is, therefore, declared void. ..."*

When the Supreme Court intervened and issued a stay on the operation of the Division Bench's judgment, the Court noted that the **precise determination** of the constitutionality of Section 24(5) had been **put on hold by the Supreme Court's interim stay order,** which was issued without any specified conditions or limitations. It indicates the Supreme Court's intention to suspend the effect and operation of the Division Bench's declaration of unconstitutionality.

Thus, the Respondent's argument regarding the continued precedential influence of the Division Bench's judgment despite the stay would essentially negate the Supreme Court's intent behind issuing the stay. Such a perspective, as per the Court, would undermine the stay's practical effect, suggesting that the Supreme Court's interim measure is without substantive legal consequence.

Decision

In light of the above analysis, the Court finally deduced that the Division Bench's declaration of Section 24(5) as *ultra vires*, while not wiped from existence, would still have no legally binding effect on this Court, given the stay granted by the Supreme Court. Consequently, the Court set aside the Registrar's impugned order, restored the appellant's application under Section 24(5), and directed the Registrar to decide the same on merits per law.

Conclusion

The Court cautioned that a *one-size-fits-all* approach to interpreting the effects of a stay should be avoided. In the instant dispute, the Single Bench clarified that the most logical interpretation of the Supreme Court's interim order is to view it as a temporary stay on the Division Bench's declaration, thereby **maintaining the *status quo* of Section 24(5)** until the Supreme Court provides a conclusive judgment. In effect, the Court revived the enforceability of Section 24(5) of the PPVFR Act.

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