

# Trade Marks - India Updates

## Finally the Madrid Protocol

The Madrid Protocol came into force on July 8, 2013. India is the 14th of the G-20 economies to accede to the Madrid Protocol. This now makes it possible for Indian businesses to protect their marks in multiple jurisdictions by filing a single application with one set of fee. As on April 9, 2014 Indian Trade Marks Registry received over 90 International applications, forwarded 70 applications to WIPO and WIPO approved 28 International applications.

## Intellectual Property Appellate Board (IPAB)

The India group of the Asian Patent Attorneys Association has been successful in getting directions from the Delhi High Court for setting of a permanent place for IPAB in Delhi.

## PepsiCo Vs Youngistan

The Bollywood film titled Youngistan faced some trouble just before its release from PepsiCo Inc that claimed trade mark and copyright infringement based on its famous slogan 'YEH HAI YOUNGISTAN MERI JAAN'. However, the parties were able to reach an amicable out of court settlement where the makers of the film Youngistaan have acknowledged PepsiCo Inc's rights to YOUNGISTAN. Additionally, the filmmakers were asked to carry a disclaimer on the title credits of the movie, theatrical trailers and end slate in all their official digital media communications.

## Kingfisher brand for Sale

SBICAP Trustee Co. Ltd, a wholly owned subsidiary of SBI Capital Markets Limited, India's leading Investment bank, floated an expression of interest for parties wishing to acquire trade marks of Kingfisher Airlines, which has been grounded since October 2012. The marks include FLY KINGFISHER(label), FLY KINGFISHER, FLYING MODELS, FLY THE GOOD TIMES, FUNLINER, KINGFISHER and the FLYING BIRD (device). It remains to be seen whether the value attached to the marks will help recover an amount close to the US Dollars 1.2 billion owed to creditors by the grounded airlines.

## Enforcement Directorate takes on IP Violators

A criminal complaint filed by Steel Authority of India Limited (SAIL) with State Police against two businesses for infringing its trade mark SAIL resulted in an investigation by the Enforcement Directorate of the Central Government. The Enforcement Directorate is responsible for administration of Foreign Exchange and Money Laundering laws. Inquiry initiated by the Directorate revealed that these companies sold their goods at inflated rates (using the reputation of the SAIL mark) and apparently were laundering huge sums of money. The Enforcement Directorate seized assets worth US Dollars 1.2 million from these firms. It is probably the first instance where violators of the Trade Marks Act have been booked under the Prevention of Money Laundering Act.

## TITAN MONTBLANC JV

After a successful tie up with Starbucks, Tata has now signed up with Montblanc. Titan which is the world's 5th largest wrist watch manufacturer entered into a JV with the Richemont owned luxury goods brand- Montblanc, to open single brand retail outlets in India. Earlier, Montblanc had presence in India through an exclusive distributor.

## Cadbury loses ECLAIR

Cadbury lost its Eclairs marks due to non-use. In a case initiated by ITC Ltd, the IPAB ordered removal of three trademarks - CHOCOLATE ÉCLAIRS, ORANGE FLAVOURED CHOCOLATE ÉCLAIRS AND CHOCOLATE ECLAIRS POP from the Register of Trademarks due to non-use. Though the marks were registered in India claiming a use date of 1972, surprisingly, Cadbury failed to submit any evidence to show the use of the marks.

## Britannia refused registration for SNAX

Britannia Industries Ltd.'s claim for registration of the mark SNAX for biscuits was refused by the IPAB on the ground of the phonetic similarity to the word 'snacks' which means "a light, casual or a hurried meal, a small amount of food eaten between meals." Britannia is the registered proprietor for the composite mark BRITANNIA SNAX. Britannia claimed that the mark was adopted in 1965 and had been in use for 40 years. However, IPAB accepted PepsiCo.Inc's contention that the mark 'Snax' is a variant of the dictionary word Snacks and is descriptive.

## The Indian Singers' Rights Association (ISRA) formed

The ISRA has been formally registered with the Government of India under Section 33 of the Copyright Act, 1957 to act as a copyright collection society for singers. Singers are entitled to receive a royalty each time their songs are used for commercial purposes other than for the communication to the public along with the film in a cinema hall.

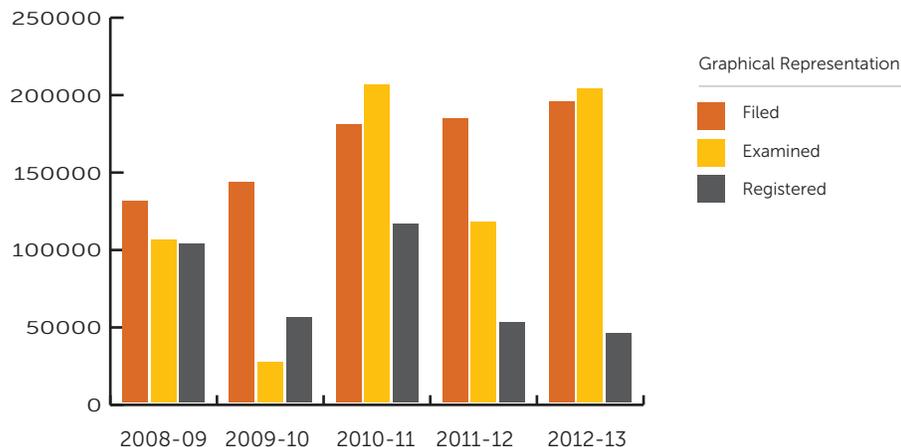
## Marrakesh Treaty

India signed and ratified the Marrakesh Treaty (that carves out a fair use exception for the visually impaired and persons with print disability). To put it simply, the treaty allows the waiver of copyright restrictions so that books are available in formats such as Braille, large printed text and audio books.



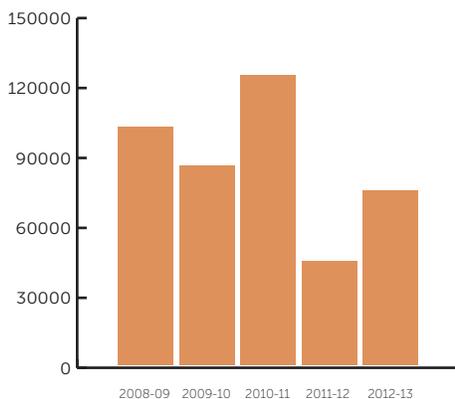
## LAST 5 YEARS AT A GLANCE\* TRADE MARK APPLICATIONS

	2008-09	2009-10	2010-11	2011-12	2012-13
<b>FILED</b>	1,30,172	1,41,943	1,79,317	1,83,588	1,94,216
<b>EXAMINED</b>	1,05,219	25,875	2,05,065	1,16,263	2,02,385
<b>REGISTERED</b>	1,02,257	54,814	1,15,472	51,735	44,361



## TRADE MARKS PUBLISHED

YEAR	TRADE MARKS PUBLISHED
2008-09	1,02,234
2009-10	85,724
2010-11	1,24,250
2011-12	44,770
2012-13	74,871



## TRADE MARK OPPOSITIONS/RECTIFICATIONS FILED AND DISPOSED DURING 2012-13

Trade Marks Registry	Oppositions/Rectifications filed	Oppositions/Rectifications Disposed off
Mumbai	3240	1716
Kolkata	996	1136
Chennai	2633	1520
Delhi	4414	2278
Ahmedabad	1818	1187
<b>TOTAL</b>	<b>13,101</b>	<b>7,837</b>

\* Source: Annual Report of the Office of Controller General of Patents, Designs, Trademarks and Geographical Indications 2012-13.

## CLASSWISE HIGHEST FILED TRADE MARKS 2012-13

Class	Goods and services	Applications filed	% of Total filing
5	Medicinal, Pharmaceuticals, veterinary and Sanitary substances etc.	31942	16.45
35	Advertising, business management, business administration, office functions	15330	7.89
25	Clothing including Boots, and Slippers	10498	5.41
41	Education; providing of training, entertainment, sporting and cultural activities	10372	5.34
9	Scientific, Nautical, Surveying and Electrical apparatus etc.	9419	4.85

# About

LexOrbis is a full service intellectual property boutique law firm located in New Delhi, India.

At LexOrbis our approach is to find practical and commercially realistic solutions suited to the needs of our clients. We offer comprehensive IP services and representation to a large number of leading global corporations, hi-tech Indian companies, small and medium enterprises, research institutions, universities and public sector organizations.

We believe in adding value to the clients IP portfolios by acting not just as solution providers, but as strategic partners, be it procurement, protection or enforcement of all forms of IP.

We provide out of the box solutions. To enable this, we constantly make an effort to understand, think creatively and keep pace with latest technological developments in our clients areas of proficiency.