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# IP

# Update

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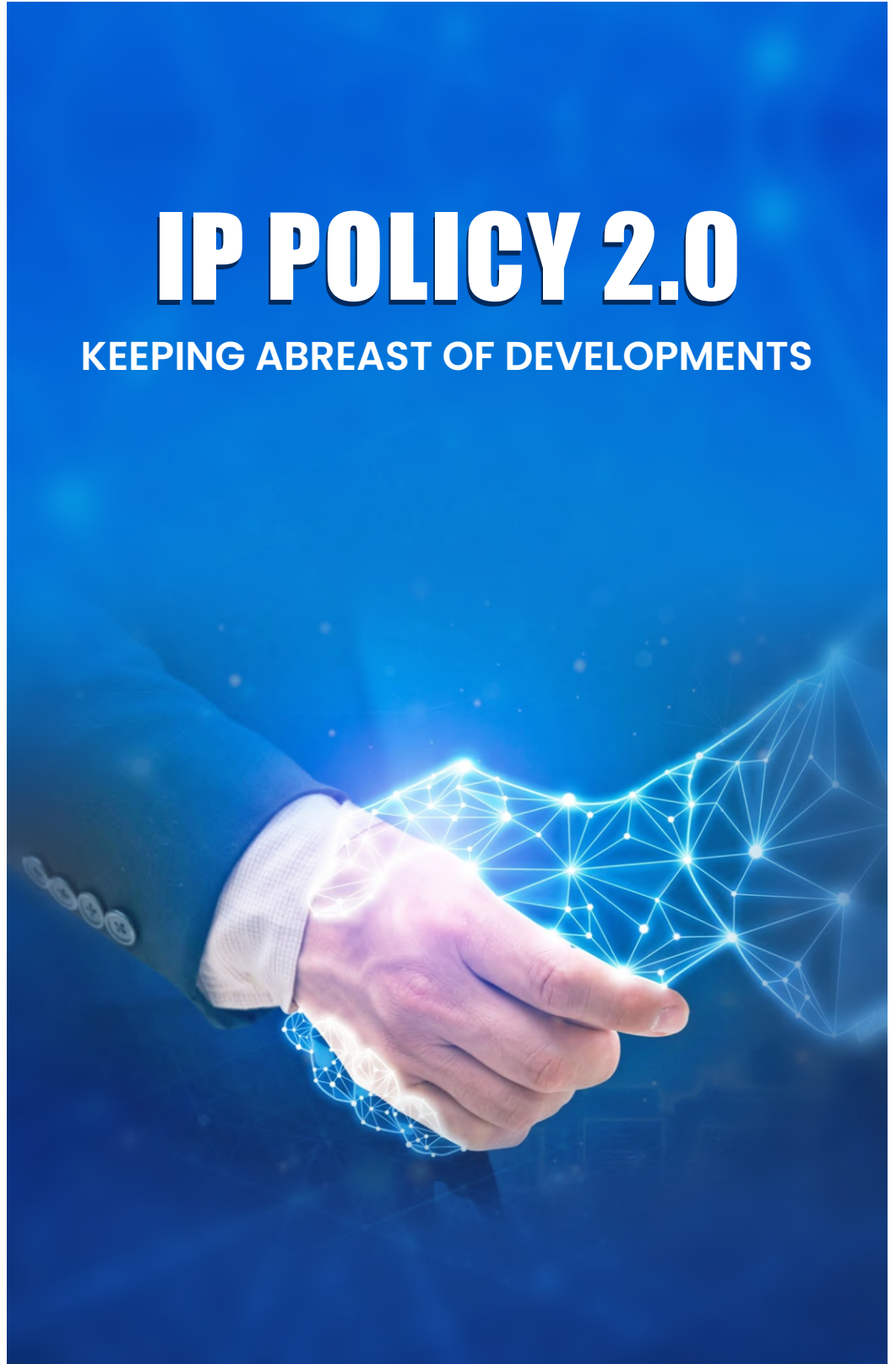
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# IP POLICY 2.0

## KEEPING ABREAST OF DEVELOPMENTS



IP UPDATE



**Narendra Sabharwal**

*Chairman, FICCI IPR Committee & Former Deputy  
Director General, WIPO*

Dear colleagues,

**W**e stand at the threshold of a new era driven by the transformative potential of artificial intelligence (AI) and other disruptive technologies such as Internet of Things, Machine Learning, Big Data, 3D Printing, Blockchain, Digital Media and Life Sciences, among others. Important questions are being raised about the application, management and regulation of these technologies, including their crucial interface with intellectual property rights (IPRS).

There is already a recognition of the pervasiveness of AI in diverse fields and the profound economic impact that it engenders. The recommendations of the recent Parliamentary Standing Committee Report on Commerce emphasise the need to revisit and fortify existing IPR legislations for harnessing the extensive benefits arising from AI and related technologies. The NITI Ayog's discussion paper on National Strategy on AI points out that applying stringent and narrowly focussed patent laws on AI applications will be a challenge given the AI related solutions development. The World Intellectual Property Organization (WIPO) also has taken a lead to study the interface between AI and related technologies and IPRS by engaging with group of experts and stakeholders from across the globe in conversations organised by WIPO. The outcome of two of such conversations is available as Reports.

I am taking the liberty to summarise below some of the observations made by me during the National IP Conference 2022, which are relevant to the issue at hand.

Ever since the inception of the IP system, ethical and moral issues have been raised in the context of intellectual property. These issues have included questions related to Private Rights vs. Public Good; monopoly and rent generation vs. competition and welfare optimisation; criteria for patentability particularly in the context of evergreening & computer related inventions, life sciences and ethical questions related to cloning of humans and plants as a whole.

Ethical implications continue to be raised in the areas of AI and other disruptive technologies, environment protection and

food security; protection of Traditional Knowledge (TK), Genetic Resources (GRs) and Folklore; fair use of copyrighted material for education and research; branding; data protection, confidentiality and privacy; and other IP related areas.

IP protection in healthcare has always been contentious. Easy access and affordability of vaccines, essential medicines, diagnostics and therapeutics for public health during the COVID pandemic became a huge global issue. It prompted countries like India and South Africa to seek waiver from the operation of certain provisions of the TRIPS Agreement. Even though the outcome of the proposal, after long and protracted negotiations, has been less than satisfactory, the debate helped to raise awareness about the inequity involved in the coverage of vaccines, medicines and healthcare facilities in large parts of the developing world.

As pointed out by Former Director General of WIPO, Dr. Francis Gurry, AI raises many ethical questions, and the answers are not yet clear. For example, the decisions that an automated car built around AI systems may have to take in a complex situation involving multiple persons involved in a road accident - which of those people will become the victims; or the ethical questions associated with AI-driven weapons systems; or with bias in data, which is collected from the real world which itself is biased. The life sciences also raise fundamentally important ethical questions, particularly in relation to genome editing and the extent to which bioengineering can and should be done.

Several eminent international experts such as Prof. Peter Singer and Prof. Jeroen van den Hoven have analysed this issue. They have advocated to keep an ethical eye on the scientific, technological and creative work that surround IPRS and to have responsible innovation policy by design. The answer is not to retard technological progress facilitated by IP, but to carefully manage it.

IP policy makers and administrators need to understand these complex developments and the underlying ethical, legal and economic issues during the formulation, regulation and management of IPRS. They will be called upon to embark on a collective journey, crafting a dynamic and adaptive framework that not only harnesses the transformative power of AI but also upholds and adapts to evolving principles of IPRS. In doing so, the aim is to unlock the immense potential of AI while fostering an environment that nurtures innovation, entrepreneurship, and inclusive growth.

The collaborative endeavours between India and WIPO have paved the way for significant advancements and cooperative initiatives during the recent visit of WIPO Director General, Daren Tang, to India. Several MOUs were signed between GOI and WIPO. One such landmark agreement pertains to the inclusion of India's collection of relevant judicial decisions in the WIPO Lex Judgments database. This integration augurs well for India's active engagement in the global IPR landscape and to contribute to and benefit from the collective wealth of jurisprudential wisdom. Additionally, the letter of intent to establish a Joint Master's degree in IP with the prestigious National Law University, New Delhi, represents a watershed moment in the pursuit of advancing expertise and knowledge in the domain of IP rights.

In a laudable move to bolster support for small and medium-sized enterprises (SMEs) in India, the launch of an India-customized version of WIPO's IP Diagnostics tool holds promise for addressing the specific needs and challenges faced by MSMEs. This tailored approach, coupled with the translation of the tool into India's six main languages, reflects a deep understanding of the diverse requirements and linguistic diversity that characterizes the Indian entrepreneurial lands.

FICCI, as a Permanent Observer at WIPO, has an interest in most programs of WIPO. We highlighted five concrete areas during the 'Industry Interaction' with WIPO for further strengthening WIPO-FICCI relationship. Firstly, to enhance its engagement with WIPO on Policy and Strategy development for an efficient management and utilization of IP at the national, enterprise and institutional levels. Secondly, to strengthen cooperation with WIPO for facilitating commercialization of IP assets, generation and management of clean, green and frontier technologies, technology transfer and entrepreneurship development.

Thirdly, to strengthen partnership with WIPO Academy for IP teaching, training and research. Fourthly, to explore WIPO's cooperation in creating respect for IP and learning from global best practices about IP enforcement and adjudication including Alternative Dispute Resolutions (ADRs). And finally, FICCI sought WIPO's support in comprehensively developing its capabilities in IP as a focal point for Industry and business for all round modernization of IP systems in India including attainment of SDGs, Development Agenda and Global IP issues. FICCI's interest extends to looking at new treaties and conventions administered by WIPO which may be beneficial to India.

In the above context, adopting and adapting best practices in IP policy and administration as well as benchmarking assume importance. Studying and emulating the best practices and experiences from among various countries, particularly from the advanced countries like USA, Japan, EU as also from China, ROK, Brazil, Singapore etc. and incorporating them into the work practices in India is the way forward to modernize it. The National IPR Policy provides has several recommendations to enhance international and regional cooperation and also foster collaborations among countries to further this aim.

There is an important need for careful benchmarking with globally accepted best practices. However, this must be done keeping in view what is appropriate and acceptable in the Indian context. I have always believed that for India, IP cannot be seen from the perspective of 'One-Size-Fits-All'. Hence the need for benchmarking after a careful evaluation and assessment of the global practices is imperative.

One of the best practices that has been found common in countries with developed IP systems is keeping under constant review the internal IP policies and legislation. Regardless of how quickly the technology landscape changes, for example under the impact of AI and related technologies, a country should keep under review its overall IP policy framework, laws and regulations and update them at regular intervals.

**As I mentioned in a high-powered Panel discussion during the recently held National IP Conference, 2023, in my view, the time is ripe for a review of the National IPR Policy 2016, and to articulate an updated Policy.**

Distinguished colleagues and friends,

As the year 2023 comes to an end, I would like to profusely thank you all for the cooperation and advice that you have rendered to FICCI IP Committee, and to me personally, on intricate and complex IP issues for a balanced and efficient development of IP System in India to benefit all stakeholders. Indeed, we can take satisfaction with the enormous progress which has been made during recent years in enhancing interaction and outreach with the government of India, our major trading partners and international organisations as well as the diverse IP community, in modernising the legal, administrative, judicial, enforcement and HRD related IP architecture in India. I cherish my friendship and cordial relations with each one of you.

I wish you all a very Happy and Successful New Year 2024.

Sincerely yours,

Narendra Sabharwal (IAS Retd.)  
Chair, FICCI IPR Committee  
Former DDG, WIPO





## FICCI Annual Convention and 96<sup>th</sup> Annual General Meeting

8-9 December, 2023

On 8 and 9 December 2023, FICCI's 96th Annual General Meeting (AGM) and annual convention prominently featured the theme "The World's Growth Engine," underlining India's substantial role in the global economy and its contributions across various sectors. This theme emphasised India's efforts in driving global growth, bolstered by ongoing reforms and a focus on improving the ease of doing business.



The AGM, organized at New Delhi's Vigyan Bhavan, was distinguished by the presence of dignitaries including Raksha Mantri Shri Rajnath Singh, Union Minister of Commerce & Industry, Consumer Affairs, Food & Public Distribution, and Textiles, Shri Piyush Goyal, and External Affairs Minister Dr S Jaishankar, and the Chief Economic Advisor, Dr V Anantha Nageswaran, among others. Additionally, a bevy of senior government secretaries, industry leaders, ambassadors, and senior representatives from other countries, along with thought leaders, participated in enriching discussions. These conversations centred on enhancing India's role as a vital cog in the global economic machine as well as the apparent challenges and opportunities that the country was faced with in its quest for growth and development.



Against the backdrop of dynamic global shifts, the AGM also provided a platform for insightful discussions, strategic planning, and the exchange of innovative ideas. With a focus on fostering economic growth, promoting sustainable development, and navigating the evolving business

environment, the event served as a crucial forum for forging partnerships and collaborations. The event also provided the opportunity to apprise FICCI's efforts in championing the interests of the Indian business community, contributing to policy advocacy, and driving initiatives that propel the nation's economic agenda forward, while underscoring commitment of FICCI's to catalysing positive change and influencing policy decisions that resonate across various sectors of the Indian economy.



## National IP Conference 2023: Nurturing Growth of IP for Knowledge Economy

13-14 October, 2023

The National IP Conference 2023 organized on 13-14 October at Vigyan Bhawan, New Delhi, brought together eminent speakers including politicians, industry leaders and academicians to discuss the indispensable role of intellectual property in propelling India's knowledge-driven economy, and highlighted the challenges & aspirations within India's IP landscape. The extensive range of discussions included diverse facets from IP filings to inventions, while venturing into the complex realms of legality, ethics, and geopolitics.



The event was addressed by several dignitaries including Director General, WIPO, Mr. Daren Tang and Union Minister of Commerce & Industry, Mr. Piyush Goyal. DG WIPO, in his keynote speech, praised India's ascension in the GII rankings from

position 81 to 40 while pointing out that IP was a means to an end which must be viewed holistically. He expressed confidence that India will continue to draw on its vast potentials to accelerate its rise as an IP and innovation powerhouse. Shri Goyal, in his address, said that technology and ideas were the twin engines of growth, and emphasized the importance of transparency in the IP system and to embed a spirit of innovation and inquiry among the youth. The minister also highlighted the role of women in India's transformation and progress reiterating the Government's commitment to women-inclusive and women-led development.



A section of the participating Delhi Patent Office examiners and other guests

At the commencement of this week-long initiative, the head of the Delhi IP Office emphasized, "FICCI's training program was not merely a seminar; it served as a blueprint for the future of innovation in India." The series spanned multiple cities, concluding in Mumbai on 25 August. Each session aimed to expose examiners to a wide range of industry practices and advancements in Information and Communications Technology, as well as the Pharmaceutical and Biotechnology sectors. Eminent speakers addressed key topics such as the cutting-edge features of artificial intelligence, machine learning, 5G/6G technologies, and RNAi-based therapeutics.

It is evident that India's patent examiners bear the weighty responsibility of ensuring that applications meet a myriad of requirements before a patent is granted. Their proficiency in performing this task is directly tied to their comprehension of industry practices and technological forecasts. FICCI's training series sought to bridge this knowledge gap, instilling greater confidence in examiners and ultimately resulting in more precise and quality-driven patent approvals.



Mr. Narendra Sabharwal, Chair, FICCI IPR Committee and Former Deputy DG, WIPO, sharing his views on the occasion, brought attention to the global impact of counterfeit and pirated products on global trade, informing that the losses as a result were estimated at 460 billion dollars, and it was predicted to escalate to 1 trillion dollars in the near future. He also referred to the societal and criminal enforcement costs connected with smuggling and counterfeiting, projecting a staggering 4.2 trillion dollars and putting 5.2 million jobs at risk. Further, Mr. Sabharwal pointed out the prevalence of life-threatening counterfeit drugs, constituting 30% of sales in Africa, Asia, and Latin America which posed a serious threat to global health systems.

Other luminaries who addressed the forum included Judge, Delhi High Court, Hon'ble Ms. Justice Ms. Pratibha Singh, Member, Economic Advisory Council to PMI, Mr. Sanjeev Sanyal, Secretary, DPIIT, Mr. Rajesh Kumar Singh, Joint Secretary, DPIIT, Ms. Himani Pande, Controller General of Patents, Designs, and Trademarks (CGPDTM) Dr. Unnat Pandit, among others.

## FICCI Technical Training Programs for Patent Examiner

18-25 August, 2023

India's growing knowledge-based economy has long been in pursuit of a robust framework for IP rights. A crucial element in realizing this goal involves fortifying the country's patenting system, which has recently garnered renewed attention. From 18 to 25 August 2023, FICCI in collaboration with the Office of the Controller General of Patents, Designs, and Trademarks (CGPDTM), took a significant step in this direction. The collaboration resulted in training programs held across all four Indian IP Offices, specifically tailored to equip patent examiners for the challenges posed by emerging technologies and industry best practices.



Expert-speakers with some of the senior officials of the Chennai Patent Office

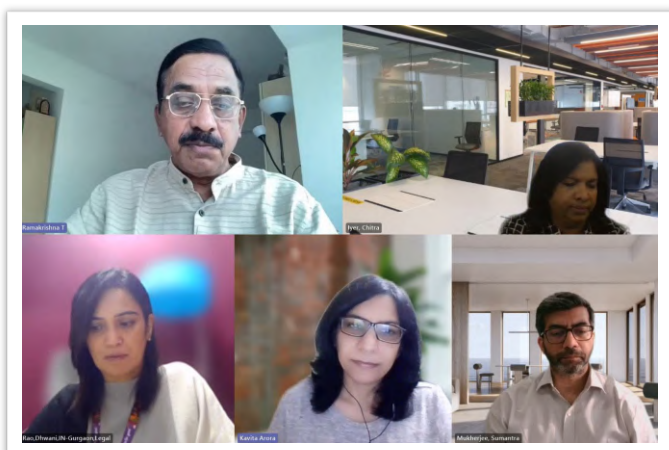
The program ended on a highly positive note, as reflected in the high levels of productivity and engagement observed throughout the sessions. The Heads of each Patent Office, who initiated the sessions in all the four venues, thanked the industry experts for volunteering their time and expertise to help patent examiners keep pace with state-of-the-art developments. In entirety, 356 participants were present, including 189 patent examiners and 167 controllers, constituting the essential framework of India's intellectual property infrastructure.



## Experts Meeting on Trade Secrets

20 November, 2023

While information is an asset for any business, trade secrets are often crucial for a company's survival. These include formulae, strategies, designs, client database or any information that is confidential in nature and needs to be kept a secret. However, unlike for other IP assets such as patents, trademarks etc, India currently does not have any legislation for trade secrets and these rights are enforced through contract law, principles of equity or by common law action for breach of confidential information, which is leading to uncertainty and adversely affecting the image of India's ecosystem for safeguarding trade secret rights. This is a key challenge that Indian industry faces when it comes to technology transfers especially through FDI as foreign companies become sceptical about working their trade secrets in India. Notably, India's IPR Policy as well as the Parliamentary Committee Report 2021 both endorse a separate legislation for securing trade secrets to make India an attractive global investment destination.



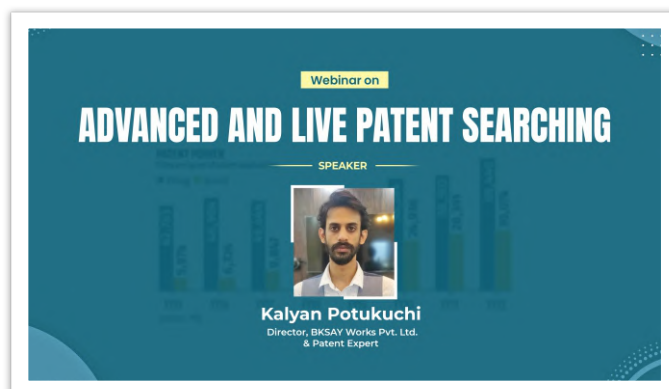
A meeting of the FICCI Expert Group on Trade Secrets was organised virtually on 20 November 2023, which is working on developing a white paper on "A Trade Secrets Framework for India". Comprising IP and legal experts from leading Indian companies, the Group is studying the relevant best practices being followed in statutes of various countries besides taking a comprehensive look at all key aspects, such as how trade secrets influence industrialisation and economic growth of nations, investment flows and, in particular, its pertinence to the Indian economy. The discussions also brainstormed on the flow of the first cut of the report and the revisions and refinements that were required before finalising it. The white paper aims to develop the broad contours of the kind of a law that India should have with regard to trade secrets and confidential commercial information, and subsequently make recommendations to the Government, for its consideration.

## Webinar on Advanced and Live Patent Searching

2 December, 2023

FICCI hosted a webinar on "Advanced and Live Patent Searching" on 2 December 2023 which was presented by Mr. Kalyan Potukuchi, CEO and Director, BKSAY Works Pvt

Ltd. The session enabled a comprehensive exploration of the patent basics, the various steps involved in patent searching, and a detailed explanation of the key criteria and essential components of the patent landscape. The key topics he touched upon included the relationship between invention and the subject matter, the concept of prior art, the types and terms of patent searches, the key feature of patent drafting, the strategies adopted in developing searches, the contents of search report etc. Mr. Potukuchi also presented a practical demonstration of how patent searching is carried out effectively, and showcased the various cutting-edge software tools that are integral to the searching process, while guiding the participants through the intricacies of utilizing these tools.

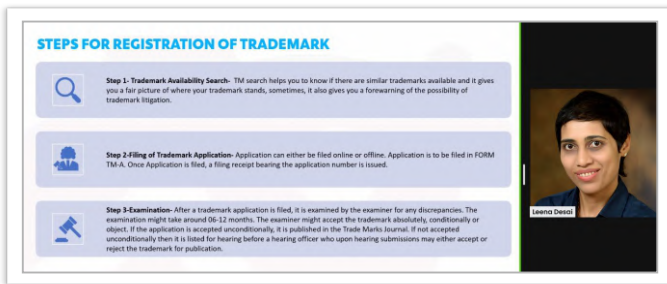


The presentation provided the attendees a practical and firsthand experience in how patent searches are carried out and patent databases can be efficiently navigated. Overall, the webinar served as a constructive platform to understand the entire patent application procedure as well as to gain practical knowledge of how the process is to be carried out.

## Webinar on An Overview of Trademarks, Trademark Search and Registration Procedure

14 December, 2023

On 14<sup>th</sup> December 2023, FICCI organized another experience-based webinar on Trademarks and the related search and registration procedures, which was presented by Ms. Leena Desai, Legal Consultant (Data Privacy & IP), Hindustan Unilever Limited. The focus of the session was to provide the participants with practical experience of the intricacies in the process of trademark search and registration and the various steps involved therein, while also giving a comprehensive overview of trademarks, including its history and evolution, the types of trademarks, the related international laws e.g. the Madrid Protocol which enables filing of trademarks in multiple countries worldwide by way of a single application, the TRIPS Agreement - the international legal agreement among all WTO member nations that stipulates the minimum standards for the regulation of different forms of intellectual property by national governments. Valuable insights were also discussed on the importance of trademarks for industry and businesses, and how this form of intellectual property helped corporates to establish a robust and distinct brand identity.



was conducted, which help understand if there were similar trademarks available enabling the filer to know where a trademark stands, and at times also forewarning of the possibility of trademark litigation. The session provided a comprehensive understanding of how a search is conducted before a trademark is registered to avoid potential conflicts with existing trademarks, subsequent legal issues, reputational damage and chances of refusal for registration of the trademark.

FICCI's webinars form a part of its ongoing activities towards advancing awareness on intellectual property among various stakeholders as well as the to foster the utilization of IP rights by Indian business and industry.

What set this webinar apart was the unique experience that Ms. Desai brought to the participants. She not only elucidated the theoretical aspects of trademarks, but also shared her practical experiences, presenting a firsthand look into how trademark searches were conducted in real-world scenario. By logging on to the IP Office website <https://ipindia.gov.in/>, she took the participants through the entire process of how online search

## Unveiling the Developments in India's Intellectual Property Tapestry



**Ms. Manisha Singh**

Partner, Lexorbis



**Ms. Shivi Gupta**

Assistant Manager, Lexorbis

India's intellectual property sector has experienced remarkable growth and progress in the year 2023, which is expected to impact the country's innovation and economic growth significantly. In the past year, there have been several major legislative developments in India's intellectual property landscape, including proposed amendments to the Patent Rules, the establishment of the IP Division at the Delhi and Madras High Court, and the introduction of new policies for the Indian space and deep tech start-up sectors. These developments are expected to provide greater clarity and transparency in the intellectual property system, making it easier for innovators and businesses to protect their ideas and inventions.

Following the establishment of the Intellectual Property Division and the announcement of IPD Rules by the High Court of Delhi, the High Court of Madras also created an Intellectual Property Division to handle disputes and cases related to IPR. This division is presided over by a single-judge bench and a division bench. The Madras High Court has also notified the "Madras High Court Intellectual Property Rights Division Rules, 2022", which govern and regulate the proceedings before the IP Division. The IPD Rules came into effect on April 5, 2023, and the IPD had its first sitting on April 13, 2023, after its inauguration on April 12, 2023.

The Scheme for Startups Intellectual Property Protection (SIPP) is a vital initiative by the Government of India to promote and safeguard the intellectual property rights of startups and innovators in the country. The scheme focuses on raising awareness among startups about the importance of intellectual property rights and providing them with the necessary assistance to protect their patents, trademarks, and designs in India and abroad. The scheme was launched in 2016 on a pilot basis and was extended until March 31, 2023. The scheme has now been modified and extended for three years until March 31, 2026. Certain aspects of the scheme have been modified effective April 1, 2023, based on the experience gained from its implementation.

The Indian government also published the Indian Space Policy 2023 to increase the involvement of non-governmental entities (NGEs) in end-to-end space activities and provide them with a level playing field. The policy aims to enhance the country's space capabilities by encouraging advanced research and development in the space sector and promoting space-related education and innovation. The policy document defines the roles and responsibilities of the different entities and organisations involved in the space sector.

The Union Cabinet approved the National Research Foundation (NRF) Bill 2023 on June 28, 2023. This bill seeks to reshape India's

research landscape and promote scientific innovation to new heights. Its objective is to create groundbreaking discoveries and ensure that India is at the forefront of global research excellence across various domains. Once enacted, this bill will revolutionise India's research ecosystem by creating opportunities for transformative advancements in science and technology.

On July 24, 2023, the Department of Promotion of Industry and Internal Trade (DPIIT) issued a public notice in response to complaints from stakeholders and the general public. The notice clarifies that no music license is required to perform or communicate any literary, dramatic, musical or sound recording work at any religious ceremony, including marriage ceremonies. This exception is given under Section 52(1)(za) of the Copyright Act, 1957.

Earlier this year, the Indian government also announced its decision to lay down an action plan and blueprint for promoting and institutionalising intellectual property financing in India. This step aims to improve the country's finances by leveraging IP rights vested in patents, trademarks, designs, copyrights, etc. The strategic blueprint and action plan will be formulated under the Department for Promotion of Industry and Internal Trade (DPIIT), which is the nodal department for the administration of the IP regime in India.

The Cinematograph (Amendment) Bill, 2023, which comes in furtherance of the Cinematograph (Amendment) Bill, 2021, received the nod from Lok Sabha on July 31. The bill proposes some key changes to the Cinematograph Act, 1952, with respect to the certification of films, copyright coverage, the menace of piracy, and the extent of governmental control over the Central Board of Film Certification (CBFC).

The draft Patent Rules were presented recently to introduce critical changes to the Indian patent regime in order to streamline and modernise patent procedures. To foster a more inclusive and supportive IP ecosystem, the CGPDTM in India has sought input and suggestions from IP stakeholders to revise the current IP manuals.

India is looking forward to acceding to critical international agreements administered by WIPO, namely the Strasbourg Agreement concerning the International Patent Classification (as amended in 1979), the Geneva Act of the Hague Agreement concerning the International Registration of Industrial Designs (adopted in 1999), and the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (adopted in 2015). This move will harmonise India's overall Designs, Patents and GI protection system.



India's National Deep Tech Startup Policy is a well-rounded approach to boosting and nurturing deep tech startups in the country. The policy elucidates the concept of deep tech startups and underscores the need to attract and retain talent in this field. It also proposes various initiatives like scholarships, fellowships, and tax incentives to attract and retain talent in the deep tech sector.

It would not be wrong to claim that India has made significant strides in its approach to intellectual property rights during the

past year. The country is shifting towards a more positive outlook on IP rights through various legal reforms and initiatives. This transformation is expected to profoundly impact the country's IP landscape, resulting in increased protection, enforcement, and commercialisation of intellectual property. Overall, these developments represent a significant step forward for India's innovation ecosystem and are a promising sign for the future of IP rights in the country.

**Disclaimer:** *This article contains the views of the authors alone.*



## Many Shades Beyond the Normal Trademark: The Power of Certification Trademarks in India and Beyond



### Ms. Lakshmidevi Somanath

Partner, Intellectual Property,  
Surana and Surana International Attorneys

Many a time we come across marks such as *India Organic*, *Tea Board*, *Coffee Board*, *Silk Mark*, etc on the goods we purchase. These are called Certification Trademarks. Certification Trade Marks essentially act as seals of approval, indicating that goods or services bearing the mark meet specific criteria or quality standards. Certification Trademarks are not used by the owner of the mark but licensed by the owner to others who meet certain predefined standards.

In India, per Section 2(1)(e) of the Trade Marks Act, 1999, a Certification Trade Mark means a mark capable of being used on the goods or services which are certified, in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified.

Under Section 72 of the Trade Marks Act, 1999, individuals or entities seeking the registration of a certification mark are mandated to submit an application that includes draft regulations governing the criteria for authorizing the use of such a mark and outlining its permissible applications.

These regulations must include the following:

- A comprehensive overview of the applicant and the nature of their commercial enterprise.
- Explicit details concerning the applicant's infrastructure, such as research and development facilities, office locations, and technical personnel resources.
- A demonstration of the applicant's competence to oversee and administer the certification scheme, clarifying the source of their authority to certify the quality and authenticity of the goods or services in question.
- A disclosure of the financial mechanisms established by the applicant, particularly emphasizing the methods for revenue generation, which may encompass membership fees, licensing agreements, or royalties, accompanied by an approximation of the annual revenue figures.
- A formal commitment from the applicant, stipulating a categorical prohibition of discrimination against any party meeting the criteria outlined in the regulations.
- A precise enumeration of the specific characteristics or attributes that the certification mark shall signify in the certified goods or services, clearly articulating the qualities that warrant certification.
- An elucidation of the methodology for monitoring the utilization of the certification mark within the boundaries of India, coupled with a delineation of the dispute resolution mechanisms to be invoked in the event of any contentious issues.

The Trademarks Registry reserves the authority to request supplementary information. Additionally, the applicant is obligated to provide a statement of case, on the legal grounds upon which their application is founded.

Again, certification marks, when subjected to examination, the Indian Trademarks Registry diligently considers several parameters:

- **Competency of the Applicant for Certification:** the competence and capability of the applicant to certify the specified goods or services. This entails an intricate assessment of the applicant's aptitude and proficiency in conducting the certification process.
- **Public Benefit Implications:** the potential public advantages and consequences arising from the registration of the certification mark.
- **Technical and Procedural Adequacy:** This includes a rigorous appraisal of whether the draft regulations submitted by the applicant adhere to the requisite standards and have been satisfactorily filed.

Furthermore, the distinctiveness of a certification mark hinges upon the mark's inherent capacity to demarcate and denote the certified attributes of the goods or services in question from those that remain uncertified.

### Infringement of Certification Trade Marks

Pursuant to Section 75 of the Trade Marks Act, 1999, a Certification Trade Mark is considered to be infringed when:

- The said certification mark is employed by a party other than its registered proprietor or an authorized user, as prescribed by the regulations, within the context of commercial activities.
- A mark that bears identical or deceptive similarity to the certification mark is used concerning goods or services for which it has been officially registered.
- The use of the mark is executed in a manner that is liable to be misconstrued as being employed as a conventional trade mark.

Should the above conditions be satisfied, a civil suit can be initiated under Sections 75, 78, 134, and 135 of the Act.

There is no case in India yet where the question of the infringement of a certification trade mark has been comprehensively examined by the courts. In *Tea Board, India v. ITC Limited*, (C.S. No. 250 of 2010, 4 February 2019, Calcutta High Court), since ITC Limited was using the word DARJEELING for services different from the goods for which the certification trade mark was obtained. Consequently, the Court held that the use of the protected term for hospitality services instead of tea did not constitute an infringement. The Court determined that the "Darjeeling lounge" within the 5-star hotel was exclusively accessible to high-end clientele, and these discerning consumers were unlikely to be misled into believing that the food and beverages served in the lounge originated from the Darjeeling district.

Had both parties been dealing in the same classes of goods, the implications would have been different.

### Legal Complexities of Multiple Usage

The utilization of Certification Trademarks by the multiple authorized entities, in accordance with the parameters established by the regulations, can give rise to a spectrum of challenges and potential risks, affecting both the owner of the Certification Trademark and the industry at large.

- **Dilution of Quality Standards:** The primary objective of a Certification Trademark is to maintain and uphold specific quality standards. However, if the authorized users fail to adhere rigorously to these standards, it can result in a dilution of the mark's intended significance. This, in turn, diminishes the value and trustworthiness associated with the mark.
- **Erosion of Brand Equity:** The misuse or misrepresentation of a Certification Trademark can harm the reputation and brand equity of the owner. Consumers might associate subpar quality products or services with the Certification Trademark, which can erode the owner's credibility and standing in the market.
- **Dispute Resolution Challenges:** If disputes between the owner and authorized users arise, the resolution process can be complex and time-consuming, potentially leading to legal conflicts that disrupt the industry's operations.
- **Protection and Enforcement:** The owner of the Certification Trademark must be vigilant in monitoring and enforcing the proper usage of the mark by authorized entities.

### Protecting Certification Trade Marks Beyond India

The effective propagation of a Certification Trade Mark obtained in India to international jurisdictions by the owner necessitates

a strategic and meticulous approach, considering the complexities of global trademark protection and regulatory variations across different countries.

Countries around the world protect Certification Trade Marks under their law. Examples are:

- United States: 15 U.S.C. § 1054 of the Lanham Act
- Canada: Trademarks Act R.S.C., 1985, c. T-13
- United Kingdom: Section 50 of the Trade Marks Act 1994
- Australia: Section 170 of the Trade Marks Act 1995
- European Union: EU Certification Mark Regulation (Regulation (EU) 2017/1001)

Indian origin owners of certification trademarks in India such as *India Organic, Tea Board, Coffee Board, Silk Mark*, etc should register their certification trade marks in other jurisdictions too. The Agricultural and Processed Food Products Export Development Authority of India is actively pursuing trademark rights in Australia for the term "BASMATI" with the aim of preventing its usage for rice produced outside of India. The application for the trademark "BASMATI" has been declined, with the Registrar's decision currently under appeal before the Federal Court.

A vigilant and proactive approach, combined with robust regulatory frameworks, is imperative to maintain the integrity of Certification Trademarks and preserve their value to the industry and consumers.

**Disclaimer:** This article contains the views of the author alone.





## Become a Member !



### BACKGROUND

- FICCI Launched its unique initiative - FICCI IP FORUM - in May 2020 to provide an interface for businesses to resolve their issues pertaining to intellectual property rights and also develop a pool of IP professionals whose knowledge and expertise will benefit the industry at large.

### OBJECTIVE

- To create a consortium of legal professionals who are keen to support IP and encourage innovation, brand protection and creativity among various stakeholders.
- To strengthen the IP ecosystem in India and play an important and more comprehensive role in addressing existing and evolving issues in the area of IP in India.

### BENEFITS

- Engagement in IP Policy Advocacy
- Networking through various FICCI national & international seminars/conferences
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## Battle against Apple won by Cypriot gaming company

In a recent press release from Apella, it was announced that the European Union Intellectual Property Office (EUIPO) upheld a decision on December 14, rejecting Apple Inc.'s claims against video game developer Apella Games. Apella Games, founded and based in Cyprus since 2020, filed a trademark application on March 17, 2021, for its name, which is the English transliteration of the ancient Greek term "Apella," referring to the people's assembly in ancient Sparta. The company's logo features a round design with the letter 'A' encased by an ancient warrior helmet and a meander motif associated with ancient Greece. Apple had objected to Apella's trademark application in June 2021, claiming potential confusion with its own trademark.

However, Apella's legal team, led by Ms. Yanna Raevskaya of Prospectacy Ltd's legal department, successfully argued that Apple failed to demonstrate how Apella Games' registration would harm its market image. The EUIPO dismissed the appeal, highlighting the visual differences between the two marks and stating that professional consumers would not likely be confused. Ms. Raevskaya accused Apple of attempting to monopolize certain words and letters, emphasizing that Apella Games poses no threat to Apple's reputation or business. Apple has the option to challenge the decision before the General Court of the European Union within the next two months.

Source: <https://in-cyprus.philenews.com/insider/business/cypriot-company-wins-trademark-battle-against-apple/>

## Music Publishers Sue AI Company Anthropic Over Song Lyrics

Music publishers Universal Music, ABKCO and Concord sued artificial intelligence company Anthropic in Tennessee federal court on Wednesday, accusing it of misusing an "innumerable" amount of copyrighted song lyrics to train its chatbot Claude.

The lawsuit said Anthropic violates the publishers' rights through its use of lyrics from at least 500 songs ranging from the Beach Boys' "God Only Knows" and the Rolling Stones' "Gimme Shelter" to Mark Ronson and Bruno Mars' "Uptown Funk" and Beyonce's "Halo."

Source: <https://www.usnews.com/news/technology/articles/2023-10-18/music-publishers-sue-ai-company-anthropic-over-song-lyrics>

## Google To Defend Generative AI Users from Copyright Claims

In October 2023, Google said that it will defend users of generative artificial-intelligence systems in its Google Cloud and Workspace platforms if they are accused of intellectual property violations, joining Microsoft, Adobe and other companies that have made similar pledges.

Major technology companies like Google have been investing heavily in generative AI and racing to incorporate it into their products. Prominent writers, illustrators and other copyright owners have said in several lawsuits that both the use of their work to train the AI systems and the content the systems create violate their rights.

Source: <https://www.reuters.com/technology/google-defend-generative-ai-users-copyright-claims-2023-10-12/>

## Revolutionizing IP Financing: IP Valuation Rules to Amplify Funding Opportunities for MSMEs

The Department for Promotion of Industry and Internal Trade (DPIIT) is working towards the establishment of a comprehensive valuation framework for intellectual property

to streamline its funding through innovative financial instruments. This strategic endeavour aims to support businesses, particularly micro, small, and medium enterprises (MSMEs), as well as startups possessing valuable intellectual property, in their quest for alternative avenues for raising capital. It aligns with the objective of the National Intellectual Property Rights (IPR) Policy, to recognize IP rights as valuable intangible assets.

With the knowledge of valuation, MSMEs can strengthen their negotiating position during strategic decisions.

Source: <https://economictimes.indiatimes.com/small-biz/sme-sector/how-msmes-can-boost-funding-from-ip-valuation-rules/articleshow/105488744.cms>

## India's Bold Move: Proposing 5-Year Patent Waiver for COVID Diagnostics and Therapeutics at WTO

India, Pakistan, South Africa, and five other nations have collectively put forth a proposal for a global patent waiver for Covid-19 diagnostics and therapeutics over a five-year period. The submission to the World Trade Organization (WTO) was presented on behalf of 65 members recently. In the submission, the members underscored the ongoing significance of diagnostics and therapeutics in the comprehensive battle against the pandemic.

The objective of the submission is to address intellectual property barriers, encourage production, and improve accessibility to crucial Covid-19 tools. This initiative is expected to empower developing countries to expand and diversify production and enhance accessibility without encountering intellectual property (IP) hindrances. Commerce and Industry Minister Shri. Piyush Goyal had previously urged timely discussions on extending patent waivers concerning the production and supply of Covid-19 diagnostics and therapeutics during the G20 Summit in India. Both India and South Africa had also raised discussions on therapeutics and diagnostics within the framework of this waiver during the G20 meetings.

Source: [https://www.business-standard.com/india-news/india-seeks-5-yr-patent-waiver-for-covid-diagnostics-therapeutics-from-wto-123120600256\\_1.html](https://www.business-standard.com/india-news/india-seeks-5-yr-patent-waiver-for-covid-diagnostics-therapeutics-from-wto-123120600256_1.html)

## The Great Indian IP Feast 2.0: Where Creativity, Innovation, and Intellectual Prowess Converge

In New Delhi, the intellectual hub of India, Gallery 1AQ concluded its curtains on December 2, 2023, for the second edition of The Great Indian IP Feast, which served as a celebration of India's intellectual excellence. The focus was on the progression from ideas to brands through craftsmanship and innovation. A series of engaging panel discussions added depth to the event, exploring topics ranging from building brands through IP, the intersection of food and IP, the significance of IP in preserving heritage, and a thought-provoking discussion on IP and Technology. A significant aspect of the event was its focus on start-ups pushing the boundaries on IP rights, with over 30 start-ups showcasing how they are expanding their IP in novel ways, creating musical logos, reinventing consumption patterns for products like tomato ketchup, and innovating in various niche areas. Safir Anand, IPR lawyer and Senior Partner at Anand & Anand, who played host to the event, captured the essence of the occasion by stating, "The Great Indian IP Feast is more than just an event; it's a tribute to the creativity that defines India and an acknowledgment of the remarkable journey from ideas to intellectual properties."

Source: <https://www.business-standard.com/>

## DPIIT's Groundbreaking Move: Unwrapping the Future with Draft Amendments to Geographical Indications Rules

The Draft Geographical Indications of Goods (Registration and Protection) (Amendment) Rules, 2023, has been unveiled by the Department for Promotion of Industry and Internal Trade (DPIIT) for public scrutiny. The proposed modifications include alterations to the fee structure for specific applications and requests governed by the Geographical Indications Act. Notably, a substantial reduction in fees is observed, particularly for filing applications and renewing authorized users, indicating a potential incentive for producers and grassroots agriculturists to actively pursue Geographical Indications protection. Among the changes are the application fee for registering a geographical indication, reduced from Rs. 5000/- to Rs. 1000/-, the authorized user registration fee decreased from Rs. 500/- to Rs. 10, and the renewal fee for an authorized user reduced from Rs. 1000/- to Rs. 10. Furthermore, the application fee for additional protection to certain goods has been amended from Rs. 25,000/- to Rs. 12,000/-.

Source: <https://www.lexology.com>

## WIPO Diagnostics Launch: Elevating Success in the WIPO-India Alliance

The WIPO IP Diagnostics - Indian Adaptation is a joint endeavour between WIPO and the Government of India, facilitated by the Office of the Controller General of Patents, Designs, and Trademarks (CGPDTM). Union Minister of State for Commerce and Industry, Government of India, Mr. Som Parkash, officially launched it at the National IP Conference 2023 organized on 13 October 2023, in the presence of Director General, WIPO, Mr. Daren Tang, Secretary, DPIIT, Mr. Rajesh Kumar Singh, Principal Economic Advisor, Government of India, Mr. Sanjeev Sanyal, Joint Secretary, DPIIT, Ms. Himani Pande, and other dignitaries. This adaptation tailors the WIPO IP Diagnostics to the Indian context, enabling SMEs and MSMEs to self-assess their IP assets before seeking professional advice. The user-friendly tool will soon be accessible in multiple Indian languages within the next few months.

Source: <https://www.wipo.int/ipdiagnostics-assessment/india/en>

## ChatGPT's AI Symphony: Navigating Legal Harmonies in Indian Copyright Challenges

The introduction of ChatGPT has reignited discussions about the intersection of AI-generated content and copyright, highlighting several challenges. Existing copyright laws do not seem adequately equipped to provide copyright registration or protection for AI-generated works in India, nor do they explicitly acknowledge AI as an author. Even ChatGPT itself acknowledges the complexity of content ownership under Indian law when it comes to AI-generated materials. The legal framework in India lacks specific provisions addressing the ownership of AI-generated content.

Two years ago, the Parliamentary Standing Committee recommended the creation of a distinct category of rights for Artificial Intelligence and related innovations, addressing their protection as intellectual property rights. In June of this year, Minister of State for Electronics and Information Technology, Mr. Rajeev Chandrasekhar, expressed the government's intent to regulate artificial intelligence to safeguard "digital citizens."

It is evident that numerous issues arise when attempting to fit AI-generated content within the copyright framework, including questions regarding ownership of such intellectual property. As for whether AI-generated content can be copyrighted, existing copyright laws stipulate that the first owner of copyright in a work is the author. India's Copyright Act of 1957 does not specifically address AI-generated works or recognize AI as an author. One key constraint in copyright protection for AI works is that they must be original and creative to qualify for copyright protection.

Source: <https://www.businesstoday.in/technology/news/story/chatgpt-ai-content-all-about-legal-challenges-pertaining-to-copyright-under-indian-law-399393-2023-09-22>



## **Dr. Reddys Laboratories Ltd. v. The Controller of Patents and Ors. (Delhi High Court)**

3 August, 2023

The order sought to address the question of whether a revocation petition can be regarded as a suit for the purpose of Section 10, CPC. A revocation petition was filed by the petitioner against the respondent's Empagliflozin patent and parallelly, the respondent had filed an infringement suit against the petitioner before the Himachal Pradesh High Court. The present application was moved by the respondent before the Delhi High Court seeking a stay of the proceedings in the revocation petition. The Court relied on earlier decisions of the Supreme Court and especially *Raju Jhurani v. Germinda Pvt. Ltd.* and held that a revocation petition cannot be regarded as a suit. It further clarified that merely because the petitioner has sought a decree in the revocation proceedings, it does not mean that the instituted petition is a suit.

## **VR Holdings v. Hero Investocorp Ltd. & Anr. (Delhi High Court)**

4 August, 2023

The issue at hand pertained to the viability of a Letters Patent Appeal against an order to rectify the trademark register, issued under Section 57, Trademarks Act 1999. The respondents contended that although this matter was raised before a coordinating bench in the case of *Resilient Innovations v. Phonepe Pvt. Ltd. and Anr.*, no determinations on the restriction on letters patent appeals under Section 13 of the Commercial Court Act were rendered in that instance. The Court ruled that despite the coordinating bench's omission to discuss the impact of Section 13, its conclusion remained valid. The Court noted that the Trademark Act, 1999, does not explicitly exclude the applicability of the appeal provision outlined in Clause 10 of the Letters Patent. Furthermore, it clarified that the special powers exercised by a Commercial Court or the Commercial Division under the Trademark Act should not be equated with the original civil jurisdiction bound by Section 13(2) of the Commercial Courts.

## **Sun Pharma v. Mylan Laboratories Ltd. (Delhi High Court)**

2 August, 2023

The Delhi High Court issued a summary judgment, enjoining the defendant from using the 'Soxplat' mark and ruling in favour of the plaintiff. The conflicting marks were initially registered in favour of the plaintiff ('Oxiplat') and the defendant ('Soxplat'). However, following a 2020 IPAB order that annulled the defendant's registration for 'Soxplat', the defendant ceased using the aforementioned mark. Consequently, the plaintiff sought a summary judgment in the case. While delivering the current order, the Court noted that no interim injunctions were initially granted to the plaintiff, and the defendant promptly discontinued the use of the mark after the IPAB order. Nevertheless, in the "interest of the plaintiff," the Court awarded costs amounting to INR 5 lakhs.

## **Societe Das Products Nestle S.A. v. Kit Kat Food Products & Anr (Calcutta High Court)**

31 July, 2023

Concluding a legal conflict that spanned over two decades, the Calcutta High Court ruled in favour of the plaintiff, issuing a permanent injunction to prohibit the defendant from utilizing the "Kit Kat" mark. The defendant had applied the "Kit Kat" mark in connection with Chanachur and other snacks, asserting that the products of both parties were dissimilar. Despite the defendant's argument, the Court, basing its decision on the evidence presented by the plaintiff and a previous IPAB order addressing the same dispute, determined that the defendant's

mark was deceptively similar, leading to the issuance of the current order.

## **Ravi Manchanda v. The Registrar Of Trade Marks (Delhi High Court)**

3 August, 2023

The Delhi High Court granted an appeal challenging a non-speaking order that had rejected a trademark application. The order in question merely indicated, "where the application is refused a request may be made in form no TM-M along with the prescribed fee to communicate in writing the grounds of decision and materials used by the Registrar in arriving at his decision to refuse the said application. The said request on form TM-M should be tendered within 30 days of receipt of the order of refusal." While scrutinizing the aforementioned order, the Court amusingly notes, "The part of the above communication which is supposed to contain the 'order' is, therefore, gloriously blank" and "inasmuch as there is no order at all, passed by the Senior Examiner of Trade Marks, I am really at a loss as to what to set aside.

## **Puma Se v. Girish Vohra and Anr. (Delhi High Court)**

27 July, 2023

The disagreement revolved around the defendant replicating the plaintiff's RS-X 3D trade dress for sports shoes. After evaluating the evidence on record, the Court affirmed that the plaintiff had established its goodwill and reputation in the Indian market, presenting a case of passing off due to the likelihood of confusion. Given the defendants' absence and failure to submit a written statement, the Court ruled in favour of the plaintiff, ordering the defendants to pay punitive damages of INR 50,000 each.

## **Whitehat Education Technology v. Vinay Kumar Singh (Delhi High Court)**

2 August, 2023

The Delhi High Court issued a summary judgment, prohibiting the defendants from utilizing the contested mark "Whitehat Sr." and ruled in favour of the plaintiff. The plaintiff sought the summary judgment after referencing an email from the defendant expressing its intention not to use the disputed mark. The Court, drawing on the Supreme Court's decision in *Uflex Ltd. v. Govt. of Tamil Nadu*, reaffirmed that "costs should ordinarily follow in commercial matters and should serve the purpose of curbing frivolous and vexatious litigation." Consequently, the Court imposed a cost of INR 9,24,000 on the defendant.

## **Foodlink F & B Holdings India Pvt. Ltd. v. Wow Momos Foods Pvt. Ltd. (Delhi High Court)**

3 August, 2023

The dispute revolved around the defendant's adoption of the contested mark "Wow China Bistro," alleged to be deceptively similar to the plaintiff's "China Bistro" mark. The defendant initially used the mark "Wow! China" but modified it to "Wow! China Bistro" in 2019. The Court noted that the two marks exhibited deceptive similarity, creating a likelihood of confusion. Additionally, the argument was presented that the plaintiff had disclaimed exclusivity for the terms "China" and "Bistro" in the initial application, and such disclaimers should extend *mutatis mutandis* to subsequent applications for later marks. However, the Court rejected this argument, emphasizing that disclaimers are specific to the associated registrations and do not automatically extend to future registrations.

## **Ms. Sabu Trade Private Limited v. The Registrar Of Trade Marks (Bombay High Court)**

2 August, 2023

The crux of the disagreement revolved around the inquiry of whether the Trademark Registry possesses the authority to implement "typographical corrections" in registered trademarks. In the case at hand, the plaintiff's initially registered mark was designated as "Sago Preparations." However, a representation by the 3rd Respondent prompted the Registrar of Trademarks to introduce a comma between the two terms, thereby transforming it into "Sago, Preparations." In response, the Court, expressing concern over the potential for continued alterations, remarked, "At this rate, we are at risk of lapsing into a comma." Consequently, the Court issued an injunction, restraining the 3rd Respondent from utilizing the modified "Sago, Preparations" mark until the proceedings resume on the next hearing date.

## **Himalaya Wellness Company and Ors. v. Abony Healthcare Limited and Ors (Delhi High Court)**

17 October, 2023

The current legal action has been initiated by Himalaya Wellness Company, alleging that the defendants have infringed on the registered mark Liv.52, owned by Plaintiff 2 Himalaya

Global Holdings. The plaintiff contends that the defendants' use of the mark "Liv.55 DS" for a similar liver tonic, accompanied by a trade dress closely resembling that of the plaintiff, including a distinctive orange border, central white strip, and green lower half of the bottle/package, amounts to infringement. The court, presided over by Justice C. Hari Shankar, noted that when there is prima facie evidence of a conscious imitation of the plaintiff's trade dress, the presumption is that the plaintiff has successfully confused consumers. In such cases, the court is mandated to focus on similarities rather than dissimilarities. The court highlighted that consumers of average intelligence and imperfect recollection might associate "Liv.55 DS" and "Liv.999" with "Liv.52." Regarding infringement, the court emphasized that the actual sale of defendants' products is not a prerequisite; if the defendant's mark is deceptively similar and likely to cause confusion, infringement under Section 29 of the Trade Marks Act is established. The court granted a permanent injunction, prohibiting the defendants from using the marks "Liv.55" or "Liv.999" and adopting a trade dress deceptively similar to that of the plaintiff. The court also instructed the defendants to pay costs, with the calculation referred to the Taxation Officer.



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