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REBRANDING AND ITS RELATIONSHIP WITH TRADEMARK LAW: HOW TO ENSURE A PROPER USE AND AVOID NON-USE CANCELLATION



- By Ananya Sinha and Aqib Khan

Branding came into play when humans went from the hunter gatherer phase to the farming phase. As humans started domesticating animals, it became necessary for them to put a mark on the animals that belonged to them such that the animals could be identified and conflict avoided. Branding helped in detecting theft too. Animals were branded using hot branding rods that left a mark on their body.

When humans started to produce goods and services, some of them decided to brand their goods and services. Branding was thus born in the commerce world. Organizations who had a superior product of service and wanted people to buy their products and services started giving specific names and putting special marks on their products and services. This allowed customers to identify superior products and buy them over and over again thus benefiting the producer. In modern times organizations invest hundreds of millions of dollars to create a brand and propagate them across the world. As time went by and the world got more organized and laws came into existence, laws also came into existence to protect these brands and identification marks. Thus, trademarks were born.

Trademarks serve as a vital asset for any business, providing a means to distinguish goods and services from those of competitors.

Often times, companies have gone into rebranding their products and services. Some of the famous cases of branding and rebranding include that of Pepsi, a popular soda drink that emerged as a competitor to Coca Cola.

The brand Pepsi Cola has undergone several rebranding during its life. When a company decides to rebrand, it often involves altering or completely changing its trademarks. This

can lead to confusion if not managed properly, both for customers and within the legal framework of trademark law.

Rebranding a business can be the complete revamp of the brand identity, with updated logos, taglines, typography, or a brand refresh, with a lighter update and overall style. The goal of a rebrand can be used as a marketing strategy to appeal to a new target audience, to merge multiple products or brands, or expand services, to modernize the brand, or boost brand awareness.

Do you know that Mahindra & Mahindra, the Indian automobile and services company has undergone several rebranding during its life? It would be interesting to do a Google Search and learn about how Mahindra and Mohammed went on the rebrand itself into what we today know only as 'Mahindra'. If you do an image search for Mahindra Logo, it will reveal to you the various changes that the logo has undergone since its initial days.

Trademarks hold value as they assist customers in identifying and having confidence in a brand, and if the new logo or name deviates too much, it may not be as distinctive, or even worse, it might be mistaken for other brands.

When a brand undergoes rebranding, it might need to revise its trademark registration. If the logo or name alters significantly, the initial trademark may not safeguard the new brand, and the company might have to seek a new trademark.

Rebranding may lead to confusion among customers, particularly if the new appearance is similar to a competitor's logo. This may result in legal issues and diminish the trademark's capacity to distinguish itself in the marketplace. It can be more challenging to enforce a trademark while undergoing a rebrand. If the company fails to regularly update its marketing and branding materials or does not adequately protect the original trademark, it could forfeit some of its legal rights.

Rebranding can alter consumers' perceptions of a brand. If customers had loyalty to the previous branding, they may not recognize or feel as connected to the updated version, potentially damaging the brand's reputation and market standing. Clearly conveying the changes is crucial during a rebranding effort. Customers must grasp the new appearance, and the business should ensure the change doesn't confuse or isolate them. Thus, you will find that all rebranding continues to use elements, colors and designs of previous branding exercises.

If a business functions globally, it must ensure that the rebranding is represented in all its trademarks across different

nations. This can be complex and expensive, since each nation might demand new submissions or modifications to safeguard the trademark worldwide. Rebranding necessitates thorough planning to maintain the trademark's effectiveness, legal protection, and customer recognition.

INDIAN TRADEMARK LAW ON NON-USE

When an applicant seeks to register a trademark, they must clearly define the specific goods and/or services associated with the mark. This application can be based on an intention to use the mark in the future or on a claim of prior use, which must be substantiated by evidence demonstrating that the trademark was in use before the application date. The commercial use of a mark for the specified goods and/or services helps establish its reputation and goodwill. Proof of trademark usage can be provided when the goods are sold, or services offered prominently feature the trademark.

The most straightforward method to demonstrate commercial use is through documentation such as invoices, bills, purchase orders, and agreements that indicate the trademark is being utilized for the registered goods and/or services. Additionally, promotional materials related to the trademark may serve as secondary evidence of the applicant's intent to use the mark in connection with the advertised goods or services. If a trademark has been applied for or registered but has not been used, or has not been continuously used in commerce for a period exceeding five years and three months, it is considered not to be in active trade. Consequently, such a trademark may be subject to cancellation due to non-use, as outlined in **Section 47(1) of the Trade Marks Act, 1999**.

Further it says if a trademark has not been used in relation to specific goods or services, and another person is granted registration of a similar trademark for those goods or services, the High Court or Registrar may impose limitations on the first trademark's registration. These limitations could restrict the use of the original trademark in certain markets or for particular goods or services.

Indian trademark law allows for the cancellation of a trademark registration if, for a continuous period of five years from the date on which the mark was entered into the Trade Marks Register, there has been no bona fide use of the trademark for the goods/ services covered by the registration.

Hon'ble Courts have, over the years, through numerous judgements, settled the definition of "use" in relation to cancellation actions. Thus, a trademark is considered to be in use if it is used on goods (say on packaging or on the good itself) or in relation to services (say in promotional material relating to a service). However, "use" also encompasses actions other than actual sale of goods or rendering of services. For instance, it would be sufficient if a party can

demonstrate that it has taken a "preparatory step" to use the mark in India. For example, in the case **M/S J. N. Nichols Ltd v Rose and Thistle and Anr. AIR1994CAL43**, the Court laid down precedents in respect to interpretation of use of the mark. The Court held that mere pre-use advertisement without even the existence of the goods can be said to be a use of the mark.

All along, however, it has been clear that use made merely to preserve rights in a mark would be insufficient to ward off a cancellation action. Thus, use must be significant, commercial use of the mark on or in relation to the goods/ services. Given this, even a single incidence of commercial and bona fide use in India during the relevant period is sufficient to successfully defend a cancellation action against a trademark registration.

From the above, it is clear that *bona fide* proprietors can rest easily in the knowledge that their rights in their registrations cannot be invalidated without reason. Hence, businesses undergoing rebranding must be mindful of continuous and substantial trademarks to safeguard their rights.

Examples of successful and non- successful Rebranding:

In today's fast-paced business environment, rebranding has become a common strategy for companies looking to refresh their image, reach new audiences, or adapt to changing market conditions. However, while rebranding can breathe new life into a business, it also raises several legal considerations, especially concerning trademark law. Understanding the relationship between rebranding and trademark law is crucial for businesses to ensure proper use of their trademarks and avoid the risk of non-use cancellation.

Sometimes, rebranding companies start when the mark simply no longer fits later down the line. That is because companies, grow, change, and develop – they add new products and services and venture into new markets and industries (that's why Dunkin Donuts changed their name to Dunkin – because they do much more than just donuts).



A change of direction can also come from inside the business.

Companies may have undergone a shift in philosophy or wants to reposition itself in the marketplace. Whatever the reason, if brand name no longer reflects what is offer, this makes the case for rebranding.



If it feels like branding is a bit stale, it is not necessarily a bad time to think about a rebrand, but companies must

not make the decision to rebrand off a hunch alone.

It is especially important to know what consumers think about the branding before we tinker with it – not just because it might upset loyal customers, but because it could end up being a complete waste of time and money. Royal Mail changed its name to “Consignia” in an attempt to modernize its image, but due to poor consumer reception and competitor advantage, it reverted to the original name, costing the company £2.5 million in the process.



Bajaj has left a lasting impression on Indian

consumers, particularly through its iconic advertisement and jingle “*Bulandh Bharat ki bulandh tasveer, Hamara Bajaj!*” It created a sturdy base for itself in India with a range of products, founded in 1930 by Jamnalal Bajaj, this brand’s scooty was omnipresent in Indian households.

The Bajaj Group has established itself as one of India's most successful family-owned diversified companies. Since its inception, the name "Bajaj" has become synonymous with reliability in India, serving as a foundation upon which various group companies have thrived over the years. Bajaj Auto Limited (BAL) stands as the flagship entity of the group and ranks among the world's foremost manufacturers of two-wheelers and three-wheelers. In 2010, after considerable deliberation, BAL decided to eliminate the family name "Bajaj" as part of a significant rebranding initiative. This announcement sparked a wave of skepticism from various stakeholders. Company officials viewed the rebranding as a strategic opportunity, reasoning that as the market evolves, brands must specialize and adapt their communication accordingly. The decision was largely influenced by the dilution of the family brand, which allowed for the rise of strong individual brands and a heightened emphasis on international markets. Although BAL became the first company in India to individually brand its motorcycles instead of relying on a parent brand, this move nonetheless attracted considerable scrutiny. Given that "Bajaj" is a heritage brand with deep emotional ties for consumers over the years, this rebranding case within a family-owned business raised important questions about the relationship between products and their brands. As innovative technologies started coming into the market, Bajaj restructured their marketing scheme and aimed to recapture its market share that was lost to Hero Honda. It produced a new pattern of a stylized 'B' with its logotype, all in blue.

While rebranding can rejuvenate a brand's image, it carries significant risks if not executed thoughtfully. A prime example is Jaguar's rebranding in November 2024, which, despite its boldness, faced substantial backlash.

THE PERILS OF REBRANDING: WHEN JAGUAR'S BOLD MOVES BACKFIRE:

While rebranding can rejuvenate a brand's image, it carries significant risks if not executed thoughtfully. A prime example is Jaguar's rebranding in November 2024, which, despite its boldness, faced substantial backlash.

Jaguar's rebranding aimed to position the brand as a modern, all-electric luxury automaker. The new identity featured a minimalist logo, a departure from the iconic leaping jaguar, and slogans like “*Copy Nothing*” and “*Break Moulds*”. However, the campaign's execution led to confusion and criticism. Promotional materials showcased models in futuristic outfits without any cars, leading to questions about the brand's focus. High-profile figures, including **Elon Musk**, publicly criticized the approach, questioning whether Jaguar still sold cars.



This rebranding effort highlights the importance of aligning a brand's new identity with its core values and customer expectations. A drastic departure from established branding elements can alienate loyal customers and create market confusion.

Lessons for Trademark Law and Brand Strategy

From a trademark law perspective, rebranding must be approached with caution:

- ✓ Ensuring that new logos and brand elements are distinct and registerable to avoid conflicts with existing trademarks.
- ✓ Maintain consistent and genuine use of the new branding in commerce to prevent abandonment claims.
- ✓ Consider the potential impact on consumer perception and brand loyalty when making significant changes.

Jaguar's experience underscores the necessity of balancing innovation with tradition. While rebranding offers opportunities for growth, it must be executed with careful consideration of legal implications and brand heritage to avoid missteps that could harm the brand's reputation and legal standing.

HOW TO ENSURE PROPER USE OF TRADEMARK DURING REBRANDING?

To guarantee that the new corporate identity is legally safe in all major markets and can be fully utilized without running the risk of infringement, trademark protection is essential during the rebranding process. Finding any prior trademark rights that would clash with the new name can be aided by doing availability searches and clearances; this should be done in the primary markets, which means that for a global effort like **Jaguar**, it might be necessary to do so in all significant

jurisdictions throughout the globe. Businesses may need to resolve disputes by negotiating coexistence agreements, resolving opposition processes, or initiating cancellation actions against unused marks in order to protect their intellectual property. When a whole new name is included in the rebrand, the difficulty increases. The more jurisdictions involved, the more difficult it is to secure rights.

Potential Impacts of Rebranding on Trademark Use:

- **Confusion and Dilution:** If a rebranding involves a new name, logo, or other key elements, there's a risk of consumer confusion if the old trademark is still in use or if the new trademark is too similar to the old one. The challenge intensifies when the rebrand involves a completely new name. Securing rights increases in the difficulty the more jurisdictions are involved, and the company may need to accept that the chosen name cannot be used in certain regions.
- **Need for Trademark Alteration/Renewal:** The alteration of Trademark is given under Section 59 which lays down the following conditions for the alteration of Trademark: If the public search for the trademark has to be done again then the alteration will not be allowed by the ministry, It is allowed in case the name of the business is to be changed, in case the address of the Business is to be changed, if any new license registration has been taken or given up, and if there is any change in the usage and control which arises mostly in case of a collective trademark
- **Maintaining Goodwill:** There are many reasons or grounds that may lead a company to adopt a rebranding strategy. One of the main situations is when there is a negative perception or connotation associated with the trademark. In this case, rebranding is used to present a new image that allows the company to regain consumer confidence, disassociating itself from said negative perceptions. Another reason may be a structural change in the organisation, such as a merger or acquisition. In these cases, the aim is to make it clear to consumers that the trademarks belong to the same group or that they have some connection or association.

Strategies for Navigating Rebranding Trademarks:

- **Thorough Trademark Search:** Trademark protection is crucial during a rebranding process to ensure that the new commercial identity is legally secure in all principal markets and can be fully leveraged without infringement risks. Before rebranding, conduct a thorough search to ensure that the new trademark is available and does not infringe on any existing trademarks.
- **Trademark Registration:** A registered trademark helps establish a unique identity in the market. By protecting a

business name, logo, or slogan, it is ensured that no competitor can legally imitate brand identity even after rebranding. Register the new trademark to protect the brand identity and prevent others from using it.

- **Clear Communication:** Communicate the rebranding to stakeholders, including customers, partners, and employees, to manage expectations and reduce confusion.
- **Continuous Monitoring:** Carefully monitor the marketplace to detect any unauthorized use of trademarks and take immediate action if infringement is detected.
- **Legal Counsel:** Seek legal advice from a trademark attorney to ensure that the rebranding process is compliant with trademark laws and to protect the brand's interests.

Conclusion

To conclude, rebranding is a strategic move that must be executed with legal foresight. A well-planned transition, including trademark continuity, not only safeguards intellectual property but also maintains consumer trust.

In today's dynamic market landscape, rebranding serves as a crucial tool for businesses to remain competitive, relevant, and aligned with evolving consumer expectations. However, such a transformation must be executed with a comprehensive understanding of trademark law. From modifying logos and names to complete identity overhauls, rebranding can potentially disrupt the legal protection of a company's intellectual property if not properly managed. It is essential for businesses to update their trademarks, accordingly, ensure continuity of use, and avoid confusion that may arise with consumers or in the marketplace. Trademark non-use laws, particularly under **Section 47 of the Indian Trade Marks Act, 1999**, underline the importance of active and bona fide use of trademarks, thereby linking legal compliance with the success of rebranding efforts.

Ultimately, rebranding is not merely a creative or marketing decision—it is a legal undertaking that requires detailed planning and execution. Companies must invest in prior use documentation, comprehensive trademark searches, and clear communication strategies to avoid legal pitfalls and safeguard their brand equity. Real-world examples, such as Bajaj and Royal Mail, highlight both the risks and rewards associated with rebranding. By aligning strategic business goals with the legal requisites of trademark law, businesses can ensure a smooth transition that strengthens brand identity, retains consumer loyalty, and preserves trademark rights across jurisdictions.

REPORT ON AIPLA WOMEN IN IP GLOBAL NETWORKING EVENT

The AIPLA Women in IP Global Networking Event, held on 3rd and 5th April 2025 at Varanasi and Mangalore, was a tremendous success. It brought together industry leaders, professionals, and intellectual property experts to discuss the evolving role of women in the fields of innovation, collaboration, and intellectual property.

The event convened on April 3, 2025, in Varanasi initiated with the thought-provoking discussions on the theme of "Innovation and Collaboration." A focal point was the exploration of women's vital contributions in advancing innovation and cultivating collaborative work environments, enriched by insights from various pioneering leaders.

On 5th April 2025, the AIPLA Women in IP Global Networking Event took place at Hotel The Ocean Pearl, Mangalore. The event brought together industry leaders, professionals, and IP experts to discuss the evolving role of women in innovation and intellectual property.

The event began on a ceremonial note with the lighting of the lamp by our esteemed speakers, marking the start of a day full of insightful discussions and meaningful networking opportunities. Our host, Sahana Mabian, welcomed the attendees and introduced the distinguished guests. Then our Managing Partner and Chair of the India Committee- AIPLA, **Adv. Divyendu Verma**, and **Mr. Chandra Kant**, Head of Business Development, facilitate the speakers with mementos as a token of appreciation for their participation in the event.

Following the formal facilitation, the speakers took their seats, and the stage was set for the enriching sessions that followed. Each speaker shared their valuable insights on a different key aspect of women's roles in intellectual property and innovation. They spoke about *Gender Equity in Women in IPR*, *enlightens us on Challenges Women Face in Innovation and Collaboration with Respect to Intellectual Property and Ways to Overcome Them*. *Shared their views on the Leading Role of Women in Transforming Innovation Through Collaboration and Networking in Science and Technology* and some shared the story of the person who inspired her to become the woman she is today, along with the challenges she faced along the way and the advancement of women in today's society.

After the speaker sessions, the event transitioned into an engaging panel discussion on the topic "*Leadership Performance in Innovation & Collaboration and Participation of Women Leaders in Fortune 500 Companies*." This session generated an interactive and thought-provoking

conversation. The panellists shared their experiences and insights into how women leaders are making an impact in Fortune 500 companies, particularly in innovation and collaboration.

The discussion became increasingly dynamic as the audience actively participated, posing questions and sharing their views. There were moments of agreement, as well as constructive disagreements, which allowed for rich problem-solving and idea exchange. The discussion provided a platform for deep reflection on how the participation of women leaders can be further enhanced in top global companies.

The event wrapped up on a high note with a high tea and networking session, offering attendees a chance to connect, exchange ideas, and build lasting professional relationships. The event not only highlighted the importance of women in the fields of intellectual property, innovation, and collaboration but also created an inspiring atmosphere of unity and empowerment.

In conclusion, the Mangalore AIPLA Women in IP Global Networking Event was a significant success. It provided a meaningful platform for discussions on gender equity, innovation, and the transformative roles women play in various sectors. We look forward to hosting more such events that foster collaboration, knowledge sharing, and the advancement of women in intellectual property and beyond.







IP SNIPPETS:

PATENT CASES:

ABBVIE BIOTHERAPEUTICS INC & ANR. (Appellant) VS ASSISTANT CONTROLLER OF PATENT DESIGNS (Respondent)

CASE NO.: C.A.(COMM.IPD-PAT) 44/2023 & I.A. 23895/2023
DECIDED ON: April 16th, 2025



The appellant has filed an appeal against the respondent challenging the rejection of the appellant's patent application on the grounds of section 2(1)(j), 3(i) and 59(1) of the Patent Act. The appellant contended that the amended claims directing 'anti-cMet antibody-drug conjugate (ADC)' are disclosed in the specification and claims therefore the same can be accepted under section 59(1) and also the objections under section 2(1)(j) and 3(i) of the Act should be waived off. The respondent counter argued that the appellant seeks to convert the original set of method claims into product claims and the amendments made were also beyond the scope under section 59(1). The respondent further stated that the original set of method claims fall under excluded subjected matter under section 3(i) and lack of industrial application under section 2(1)(j).

The Hon'ble Delhi High Court upheld the impugned order passed by the respondent. The Hon'ble Court stated that the amended set of claims removes limitation by amending claims beyond the scope of originally filed specification and claims, thereby affecting the patentability under section 59(1). Also, the original set of claims are excluded under section 3(i) of the Act and also lacks industrial applicability under section 2(1)(j) of the Act. The Hon'ble Court concluded by dismissing the present appeal.

UCB PHARMA GMBH & ANR. (Appellant) vs THE CONTROLLER OF PATENTS AND DESIGNS (Respondent)

CASE NO.: IPDPTA No. 117 of 2023 (OA/1/2020/PT/KOL)
DECIDED ON: April 08th, 2025



The appellant has filed an appeal against the respondent for rejecting the appellant's patent application on the ground of lack of inventive step under Section 2(1)(j) of the Patents Act. The appellant argued that none of the prior art cited by the

respondent provide any kind of suggestion to an artisan compared to the solution offered in the appellant's invention. The appellant further argued that the respondent had cited new prior arts at the time of the hearing, which is not acceptable, and it was also wrongfully justified by the respondent.

The Hon'ble Calcutta High Court analyzed the current matter and stated that the appellant should be priorly intimated before the hearing regarding the new objections or prior arts cited and considered by the respondent. The Hon'ble Court concluded by setting aside the impugned order and remanded the matter back to the different Controller for fresh consideration.

BTS RESEARCH INTERNATIONAL PTY LTD (SR/55/2020/PT/KOL) (Petitioner) vs THE CONTROLLER GENERAL OF PATENTS & DESIGNS, MUMBAI & ORS. (Respondent)

CASE NO.: IPDPTA 56 OF 2023
DECIDED ON: April 03rd, 2025



In the present case, the petitioner had challenged the respondent for rejecting the petitioner's patent application under Section 3(j) and 3(c) of the Patents Act, 1970. The petitioner contended that the subject invention related to tri-hybrid cell is produced by an artificial process using genetic engineering techniques and not by using any biological process for production or propagation of plants and animals. Therefore, the present invention cannot fall within the scope of section 3(j) and section 3(c) of the Patent Act. The respondent countered that the subject invention are stem cells and are capable of developing into an organisms, also the applicability of section 3(j) has been adequately reasoned and explained while rejecting the subject invention.

The Hon'ble Calcutta High Court observed the following matter and stated that the subject invention does not deal with artificial process and genetic manipulation is a technical process which falls outside the mischief of section 3(j). The Hon'ble Court also stated that the rejection under section 3(j) is unsubstantiated and fundamentally misinterpreted by the respondent and the respondent has also ignored the technical intervention or human step in the subject invention, and baselessly rejected the subject invention under section 3(c). The Hon'ble Court concluded and directed the patent office to consider the matter afresh, ensuring that the matter is reheard by a different Controller.

KEMIN INDUSTRIES, INC. (Appellant) vs THE CONTROLLER OF PATENTS (Respondent)

CASE NO.: CMA(PT).No.46 of 2024
DECIDED ON: March 18th, 2025



The present appeal has been filed by the appellant against the respondent for rejecting the appellant's patent application on the grounds of Section 2(1)(j), Section 3(i) and Section 3(d). The appellant argued that the cited prior art fails to disclose the combination of the four main chain degrading enzymes as in the appellant's invention, satisfying all the requirements of section 2(1)(ja). Also, the appellant has employed more than one new reactant, therefore the appellant's invention is patentable under section 3(d). The appellant further contended that the invention do not teach a method of treating animals but rather focuses on a method of supplementing an animal feed, therefore the appellant's invention cannot be excluded under section 3(i).

The respondent counter argued that the cited prior arts discloses the appellant's invention and the appellant's invention also make use of a known process. Further the appellant's invention discloses a process for treating animals to increase their economic value. Therefore, the claimed invention cannot be patentable under Section 2(1)(j), Section 3(i) and Section 3(d).

The Hon'ble Madras High Court observed that the cited prior arts do not disclose the combination of four enzymes as disclosed in the claimed invention, also the method illustrated in the invention do not aim for treating animals. Further, the claims also deploys more than one reactant. Therefore, the claimed invention constitutes inventive step under Section 2(1)(j) and cannot be excluded under Section 3(i) and Section 3(d). The Hon'ble Court concluded by setting aside the impugned order and ordered the claimed invention to proceed for grant.

TRADEMARK CASES

DIAGEO SCOTLAND LIMITED (Appellant) vs. PRACHI VERMA & ANR. (Respondents)

CASE NO.: C.A. (COMM.IPD-TM) 7/2025
DECIDED ON: 16th April 2025

The present appeal was filed by the appellant challenging the order dated 01.10.2024 passed by the Assistant Registrar of Trade Marks, which dismissed its opposition to the registration of the mark "CAPTAIN BLUE" by respondent no.1.

The appellant is the registered proprietor of the trademarks "CAPTAIN" and "CAPTAIN MORGAN" and has been using these marks extensively in India since 2006. The "CAPTAIN MORGAN" brand reported sales of approximately USD 6.48 million in India in 2023. Respondent no.1 had applied for registration of "CAPTAIN BLUE" on a "proposed to be used" basis for alcoholic beverages.

The Hon'ble Delhi High Court held that the respondent no.1's mark "CAPTAIN BLUE" was deceptively similar to the appellant's registered "CAPTAIN" family of marks and would likely cause confusion among consumers. The Hon'ble Court noted that the appellant had established prior rights and reputation in the "CAPTAIN" marks, while respondent no.1 had failed to demonstrate bona fide adoption or use of the impugned mark.

Hence, the Hon'ble Court set aside the Registrar's order and directed the removal of "CAPTAIN BLUE" from the Register of Trade Marks, upholding the appellant's exclusive rights in its well-known "CAPTAIN" trademarks.

MANKIND PHARMA LIMITED (Petitioner) vs. PREET KAMAL GREWAL AND ANR. (Respondents)

CASE NO.: C.O. (COMM.IPD-TM) 279/2022
DECIDED ON: 2nd April 2025

The present petition has been filed seeking the removal of the impugned trademark 'KINDPAN' registered in the name of the respondents, arguing that it infringes upon the petitioner's established trademark rights.

The petitioner has been using the trademark 'MANKIND' since 1986 and holds the trademark 'KIND' for medicinal and pharmaceutical preparations. The petitioner is recognized as a leading player in the pharmaceutical industry, with significant annual turnover and goodwill.

The Hon'ble High Court found that the respondents failed to appear in the proceedings, leading to the admission of the petitioner's claims. The trademark 'MANKIND' and the 'KIND' family of marks are not distinctive, and the registration of 'KINDPAN' would likely cause confusion and dilute the distinctiveness of the petitioner's marks. A decree was granted in favor of the petitioner, directing the removal of the impugned trademark 'KINDPAN' from the Trade Marks Registry, affirming the petitioner's rights as the prior adopter and user of the 'KIND' family of marks.

ADIDAS AG (Plaintiff) vs. SANDEEP VOHRA (Defendant)

CASE NO.: CS Comm. No.828/2024

DECIDED ON: 02nd April 2025

The present suit was filed by Adidas AG, seeking a **permanent injunction** restraining the defendant from infringing its registered trademarks "Adidas", "Three Stripes", and "Trefoil" logo, along with reliefs for passing off, copyright violation, damages, and delivery-up of counterfeit goods.

The plaintiff is the registered proprietor of the aforementioned trademarks in India and worldwide. Investigations revealed that the defendant was **manufacturing, stocking, and selling counterfeit Adidas products**, including shoes bearing identical/deceptively similar marks, through his premises in Delhi and an Instagram handle (@epickickx).

The Hon'ble Court held that the defendant had **slavishly copied** Adidas' registered and well-known trademarks, causing **brand dilution and monetary losses**. A **Local Commissioner's** seizure of **1,680 counterfeit shoes** further established the infringement. The Hon'ble Court emphasized the defendant's **blatant infringement** and upheld Adidas' rights, reinforcing strict action against counterfeiters.

CHANDRA SHEKHAR SABOO & ORS. (Plaintiffs) vs. SHIV CHARAN SHARMA & ORS. (Defendants)

CASE NO.: CS (COMM.)/335/2019

DECIDED ON: 2nd April 2025

The present suit has been filed seeking relief of permanent injunction restraining the defendants from infringing the trademarks and copyright of the plaintiffs, passing off their goods as that of the plaintiffs, along with other ancillary reliefs.

The plaintiffs have been using 'PUKHRAJ' trademark since 1963 and 'EMERALD' trademark since 1979. The plaintiff no.2 is the registered proprietor of the trademark 'PUKHRAJ' and plaintiff no.3 is the registered proprietor of trademark 'EMERALD' under different classes in India whereas Defendants 1 to 3 were using the impugned trademark 'PANNA PUKHRAJ'.



The Hon'ble Court held that the defendants have dishonestly adopted the plaintiffs' registered trademarks 'PUKHRAJ' and 'EMERALD' (which means 'PANNA' in Hindi) and the products of the said defendants bearing the impugned marks are being used for identical goods. Hence, a decree of permanent injunction was passed in favour of the plaintiffs

as they were successful in establishing a clear case of infringement and passing off.

UNDER ARMOUR INC. (Petitioner) vs. ASHWANI & ANR. (Respondents)

CASE NO.: C.O. (COMM.IPD-TM) 150/2023

DECIDED ON: 6th March 2025

The present rectification petition was filed seeking cancellation of trademark registered in the name of respondent no.1, on grounds of deceptive similarity and bad faith. The impugned mark "AU"  with an interlocking design was alleged to infringe upon the well-known 'UA'  and 'UNDER ARMOUR' trademarks of the petitioner.

The Petitioner is globally recognized for its sportswear and accessories and holds registered rights to the 'UA' mark internationally and in India since 2004. The petitioner alleged that the respondent's impugned mark was deceptively similar to its own stylized 'UA' logo, and that the respondent intended to ride on the goodwill and reputation of the petitioner's brand.

Despite being served and given multiple opportunities, the respondent failed to file a reply or appear before the Hon'ble Court. Upon comparing the marks, the Hon'ble Court observed that the respondent's mark was a deliberate imitation, using the interlocking style to mislead consumers. The Hon'ble Court held that this act amounted to infringement, deception, and passing off, reiterating that deceptive similarity in logos or device marks, especially in overlapping industries, warranted cancellation if it created confusion in the minds of consumers.

LOREAL S.A. (Plaintiff) vs. ASHOK KUMAR AND OTHERS (Defendants)

CASE NO.: CS(COMM) 474/2021, I.A. 12603/2021, I.A.

12608/2021, I.A. 12609/2021 & I.A. 47983/2024

DECIDED ON: 4th March 2025

The present suit has been filed seeking relief of permanent injunction restraining the defendants from infringing the trademark and copyright of the plaintiff, passing off their goods and services as that of the plaintiff, along with other ancillary reliefs.

The plaintiff has been using the trademark 'L'Oreal' and its various stylized marks since 1900. The plaintiff's goods are sold in approximately 130 countries, including India, where they enjoy significant goodwill. The defendants are engaged in fraudulent activities, impersonating the plaintiff's employees and misleading consumers through a rogue website under the domain name www.lorealglobal.in

The Hon'ble Delhi High Court held that the defendants had copied the plaintiff's registered and well-known trademark 'L'Oreal' and other formative marks. The products bearing the impugned marks were used for identical services, leading to confusion among consumers. A decree of permanent injunction was passed in favor of the plaintiff, as they successfully established a clear case of trademark infringement and passing off.

COPYRIGHT CASE

PHONOGRAPHIC PERFORMANCE LIMITED (Plaintiff)
vs. AZURE HOSPITALITY PRIVATE LIMITED & ORS.
(Defendants)

CASE NO.: CS(COMM) 714/2022

DECIDED ON: 3rd March 2025

The present suit was filed seeking relief of permanent injunction restraining the defendants from infringing the copyright of the plaintiff in sound recordings by publicly performing them without license, along with other ancillary reliefs.

The plaintiff is the assignee of public performance rights for over 4 million sound recordings from various music labels. The defendants operate 86 restaurants/bars (including 'Mamagoto' and 'Dhaba') where they were found playing the plaintiff's copyrighted sound recordings without authorization during July-October 2022.

The Hon'ble Delhi High Court held that the defendants' unauthorized use of the plaintiff's copyrighted works constituted infringement under Section 51 of the Copyright Act. The Hon'ble Court rejected the defendants' contention that the plaintiff required copyright society registration under Section 33, affirming its rights as an assignee-owner under Section 30. The Hon'ble court granted an interim injunction restraining the defendants from exploiting the plaintiff's sound recordings pending final suit adjudication.



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