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Newsletter | Issue 32 | August 2025

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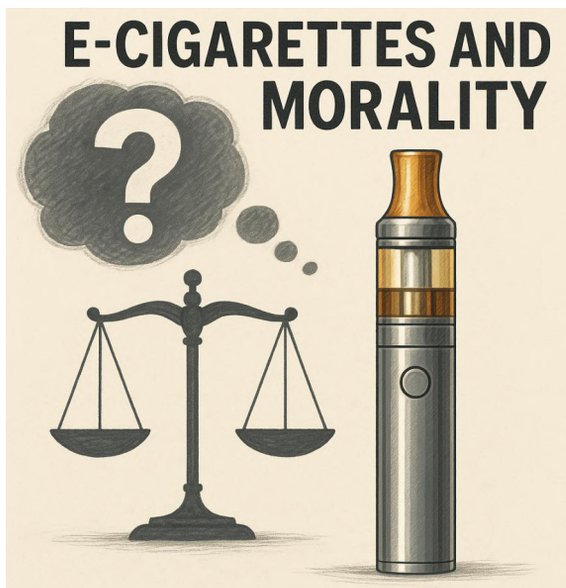
LANDMARK JUDGMENT CLARIFIES APPLICATION OF SECTION 3(B) OF INDIAN PATENTS ACT: ITC LIMITED V. THE CONTROLLER OF PATENTS, DESIGNS & TRADEMARKS

- By Divyendu Verma



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In a significant ruling, the **Calcutta High Court** in *IPDPTA No. 121 of 2023 - ITC Limited v. The Controller of Patents, Designs & Trademarks* - clarified the application of Section 3(b) of the Indian Patents Act, 1970—offering much-needed judicial guidance on the scope of morality and public order-based exclusions from patentability. The decision in *ITC Limited v. The Controller of Patents, Designs & Trademarks* is a landmark development, particularly in the context of tobacco and nicotine-related inventions, which have often faced blanket rejections at the Indian Patent Office.

What Does Section 3(b) Actually Say?

"An invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment" is not an **Invention within the meaning of the Act.**

This provision is intended to bar inventions that cause demonstrable harm to public interest or ethical values—not to prevent all innovation involving potentially controversial subject matter.

Background: Patent Office's Blanket Rejection

ITC Limited's patent application was rejected under Section 3(b), with the Patent Office asserting that the invention resembled an e-cigarette - products prohibited under the *Prohibition of Electronic Cigarettes Act, 2019.* The rejection cited the *ICMR White Paper on Electronic Nicotine Delivery Systems (ENDS),* along with provisions from the *Drugs and Cosmetics Act, 1940,* and general concerns regarding public health.

The Controller concluded that the invention, despite its technological differences, amounted to a public health threat and thus could not qualify as a patentable invention under Indian law.

The Applicant's (Appellant's) Argument

ITC Limited contended that the Patent Office had grossly misunderstood the invention. It clarified that the proposed device was **not electronic**, nor did it involve combustion. Instead, the device employed a chemical reaction - between nicotine and pyruvic acid - to produce an aerosol, thus offering a **combustion-free nicotine delivery system.** The invention was specifically designed as a harm-reduction tool, positioning itself as a safer alternative to traditional smoking methods.

High Court's Observations:

In a detailed and thoughtful judgment, the Calcutta High Court overturned the Controller's decision and directed a fresh examination of the application by a different officer, free from prior bias. In doing so, the Court set forth four key principles:

1) Section 3(b) Is Not a Blanket Ban

The Court emphasized that Section 3(b) must be applied with nuance. The mere association of an invention with a controversial product - like nicotine - does not render it unpatentable. What matters is the primary purpose and effect of

the invention, assessed through evidence rather than presumption.

2) No Automatic Disqualification for Nicotine-Related Inventions

The judgment made it clear that the Patents Act and the Manual of Patent Practice and Procedure do not bar patentability of inventions involving tobacco or nicotine. No previous court has read Section 3(b) to support such a blanket exclusion, and doing so would violate the text and spirit of the statute.

3) Regulatory Prohibition ≠ Patent Ineligibility

Relying on international norms such as TRIPS Article 27.2 and Paris Convention Article 4quater, the Court held that patentability must be judged independently of a product's legality in the market. Section 48 of the Indian Patents Act provides exclusive rights to a patentee but does not guarantee market approval or override regulatory restrictions. Therefore, a product may be patentable even if it cannot be commercially sold due to legal bans.

4) The Public Health Safeguard Stands

The Court was careful to note that granting a patent does not prevent government authorities from enforcing public health laws, such as the prohibition on electronic cigarettes. Patent protection and public regulation operate in distinct spheres, and the latter continues to apply regardless of patent status.

Conclusion

The Calcutta High Court **set aside the rejection order** and directed a fresh examination by a different officer, free from preconceived bias.

Why This Judgment Matters:

This judgment is a decisive pushback against arbitrary or overcautious use of Section 3(b) by the Indian Patent Office. It reminds the Indian Patent Office that it cannot take on the role of a moral or public health gatekeeper - especially in the absence of technical evaluation or sound legal basis.

It also has significant ramifications for innovators in sectors such as nicotine alternatives, medical devices, and regulated substances. The Court's recognition that **regulatory bans do not equate to patent ineligibility** helps align India's patent regime with international obligations and fosters a more innovation-friendly environment.

By directing a fresh and impartial re-examination of ITC's application, the Court has reinforced the importance of procedural fairness, statutory interpretation, and international compliance - a welcome move for India's evolving IP jurisprudence.

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INTERMEDIATE COMPOUNDS MUST SHOW THERAPEUTIC EFFICACY: DELHI HC IN ZERIA CASE

- By Priti More

C.A.(COMM.IPD-PAT) 452/2022
Decided on: May 27th, 2025

ZERIA PHARMACEUTICAL CO. LTD. (Appellant) THE CONTROLLER OF PATENTS (Respondents)

INTRODUCTION

In a recent ruling that reinforces India's stringent patentability standards in the pharmaceutical sector, the Delhi High Court dismissed the appeal filed by *Zeria Pharmaceutical Co. Ltd. (Appellant)* against the refusal of its patent application for a chemical intermediate compound. The Court upheld the findings of Indian Patent Office's (Respondent), that the claimed invention lacked inventive step under Section 2(1)(ja) of the Patents Act, 1970, and failed to meet the enhanced efficacy requirement under Section 3(d). The judgment reaffirms that even novel intermediates must demonstrate therapeutic efficacy to qualify for patent protection in India, and that process-related advantages alone are insufficient.

BACKGROUND:

The Appellant filed Indian Patent Application No. 3630/DELNP/2011 (a divisional application) titled ""A COMPOUND REPRESENTED BY FORMULA (5A)"" for an intermediate compound (Formula 5(a)), relevant to the synthesis of a previously patented drug. The Indian Patent Office refused the application in October 2016 on two grounds:

Lack of inventive step under Section 2(1)(ja), citing prior art documents and **non-patentability under Section 3(d)** due to failure to demonstrate enhanced therapeutic efficacy over known compounds. The Appellant has filed an appeal at the Delhi High Court against the refusal order passed by the respondent.

KEY ISSUES & RULINGS

The present judgment highlights 2 major issues present in the appeal filed by the Appellant. The requirement of therapeutic efficacy of the claimed intermediate compound and obviousness of the present invention by mere substitution of the single functional group.

Section 3(d): Therapeutic Efficacy Requirement

- The Hon'ble Court reaffirmed that Section 3(d) applies even to intermediate compounds. The plain swap of an ethoxy group (in prior art) for a methoxy group (claimed compound) is viewed as a derivative of a known substance, triggering the requirement of **enhanced therapeutic efficacy**.
- The Appellant's arguments that improvements in yield, reaction time, and purity should count were rejected by the Court. These process efficiencies cannot substitute for therapeutic benefit, which is the statutory standard in Indian patent law.
- The Appellant itself conceded that therapeutic efficacy data could not be generated for the intermediate compound. Consequently, the application was held ineligible under Section 3(d).

Section 2(1)(ja): Inventive Step

- The structural difference between the claimed and prior compounds, a single functional group substitution, was deemed obvious to a person skilled in the art. The prior art D2 already disclosed the methoxy variant generically, alongside the ethoxy derivative, making the specific selection predictable.
- The arguments provided by the Appellant that D1 "teaches away" from the invention were dismissed by the Court; absence of direct teaching is insufficient to establish non-obviousness.

COURT'S DECISION:

The Delhi High Court **upheld the Patent Office's (respondent) decision,** dismissing the appeal. The application failed both Section 3(d) (no enhanced therapeutic efficacy) and Section 2(1)(ja) (lack of inventive step).

CONCLUSION:

This judgment affirms that minor chemical changes to a known drug intermediate cannot qualify for a patent in India unless the applicant shows real therapeutic efficacy under Section 3(d). Simply improving aspects like process yield, purity, or ease of synthesis, even if helpful for manufacturing, is not enough.
It also closes a potential evergreening route where trivial intermediates are used to prolong commercial monopoly beyond expiry, denying patent protection even for manufacturing shortcuts unless therapeutic advantage is proved.

IP SNIPPETS:

PATENT CASES:

DOLBY INTERNATIONAL AB & ANR. (Plaintiffs) vs LAVA INTERNATIONAL LIMITED (Defendant)

CASE NO.: CS(COMM) 350/2024 with I.A. 9655/2024, I.A. 9658/2024, I.A. 9659/2024, I.A. 9660/2024 and I.A. 9666/2024
DECIDED ON: July 10, 2025

In the present suit the plaintiff has retrained the defendants from infringing the plaintiff's patented applications.

The plaintiff stated that they offered a Fair, Reasonable And Non Discriminatory (FRAND) license to the defendant, the defendants were continuously engaging and later refused licensing nor provided any counteroffer. Even after this the defendant continued selling the infringing device having plaintiff's Advanced Audio Coding (AAC) portfolio of patents without paying any royalties. The plaintiff argued that they have filed test reports of the infringing device which confirms presence of AAC compliant, further the defendant also failed to disclose usage of any alternate technologies in their infringing device.

The defendant countered that the plaintiff's 2-Series Patents have expired so they cannot charge royalty nor claim injunction for the use and other 3-Series Patents' are dependent on 2-Series Patents, so their existence cannot be defined individually. The defendant further stated that the plaintiff's did not make offer with good faith and the alleged FRAND royalty rate as pleaded was false and misleading.

The Hon'ble Delhi High Court observed the following matter and stated that the defendant was an 'unwilling licensee' during the negotiation procedure. The Hon'ble Court noted that all the plaintiff's patents were valid and subsisting during the negotiation period and the patents expired because the negotiation got delayed, the defendant cannot take wrong advantage of it. And as verified the defendant's infringing device implements the standards as captured on defendant's website and also in the evidence submitted by the plaintiff. The Hon'ble Court concluded by disposing of the present matter and directing the defendant to deposit a sum of INR 20,08,06,293.92 in a fixed deposit on an auto-renewal mode.

ALBEMARLE CORPORATION (Appellant) vs THE CONTROLLER OF PATENTS (Respondent)

CASE NO.: C.A.(COMM.IPD-PAT) 19/2022, I.A. 10452/2022 & I.A. 35045/2024
DECIDED ON: July 07, 2025

The appellant filed an appeal against the respondent for refusing the appellant's patent application under section 15 of the Patent Act. The appellant filed an auxiliary set of claims during the pendency of the present appeal by filing an application being *I.A. No. 35045/2024*. The respondent countered that such amendment of claims cannot be allowed at the stage of appeal.

The Hon'ble Delhi High Court observed that the appellant did not counter against the impugned order passed by the respondent but submitted an amended set of claims by reducing the scope. The Hon'ble Court further stated that the appellant had only reduced the scope of the earlier claims, and no new matter was included in the amended claims, so as per law if the amended claims addresses objections raised by the Patent Office or facilitate grant then such amendments are permissible. The Hon'ble Court concluded by allowing the auxiliary claim set filed by the appellant and hereby reviving the patent application for fresh consideration.

ORAMED LTD. (OA/14/2020/PT/KOL) (Appellant) vs THE CONTROLLER GENERAL OF PATENTS AND DESIGNS & ANR. (Respondents)

CASE NO.: IPDPTA/8/2022
DECIDED ON: July 04, 2025

In the present appeal the appellant challenges the respondent for rejecting the appellant patent application under the ground of lack of inventive step and patentability. The appellant argued that the respondent failed to refer the figures and the specification submitted by the appellant which holds all the technical data and there is also no reference of expert affidavit in the impugned order. The respondent argued that the hearing notice referred prior arts D1 to D4 and therefore they concluded the impugned order describing lack of inventive step in the appellant's patent application on the basis of the prior arts D1 and D4. The appellant further argued that the respondent failed to consider guidelines of the patent Office Manual regarding section 3(d) and 3(e), and thereon disregarded in passing the impugned order.

The Hon'ble Calcutta High Court observed the matter and stated that the respondent had failed to consider the specification of the invention as well as the affidavit of the expert as submitted by the appellant. The Hon'ble Court also noted that the respondent had failed to provide proper reasoning while rejecting the appellant's patent application. The Hon'ble Court concluded by setting aside the impugned order and remanding the application for fresh consideration by a different officer.

KROLL INFORMATION ASSURANCE, LLC (Appellant) vs THE CONTROLLER GENERAL OF PATENTS, DESIGNS AND TRADEMARKS AND ORS (Respondents)

CASE NO.: C.A.(COMM.IPD-PAT) 439/2022
DECIDED ON: July 01, 2025

The appellant has filed an appeal challenging the refusal of patent application for lack of inventive step under Section 2(1)(j), amendments being beyond the scope of the invention under Section 59, and invention relating to *'algorithm'* and *'computer program per se'* under Section 3(k) of the Patent Act. The appellant contended that the respondent errored while rejecting the patent application under section 59 as the amendments in the claims were already disclosed in the complete specification and the respondent ignored the technical aspect of the subject invention and just focused on software modules. The appellant further contended that the respondent failed to prove common general knowledge while addressing the subject patent application and relatively failed to consider technical advancement of the subject invention. The respondent contended that the appellant failed to demonstrate technical effect in the subject application, and they have also failed to validate if the scope of the amendments falls within the scope of the original claim.

The Hon'ble Delhi High Court analyzed that the respondent errored while accusing on the proposed amendment as the amendments are within the scope of the originally filed claims. The Hon'ble Court further noted that the respondent had rightfully rejected the subject patent application under section 3(k), as the appellant failed to demonstrate technical effect or advancement in the subject invention. The Hon'ble Court concluded by up-holding non-patentability under section 3(k) and maintaining the rejection of the subject patent application.

KABUSHIKI KAISHA TOYOTA JIDOSHOKKI (Plaintiff) vs LMW LIMITED (Defendant)

CASE NO.: CS(COMM) 881/2024
DECIDED ON: July 01, 2025

The present suit has been filed by the plaintiff restraining the defendants from infringing the patent bearing no. IN244759 (IN759) and IN394883 (IN883). The defendant in its written statement stated that they have stopped manufacturing and supply of the product infringing IN883. However, the defendant is still infringing the product, relating to patent no. IN759. The plaintiff accused defendant for intending to use and supply plaintiff's patented technology. The defendant countered stating that both IN883 and IN759 are invalid and should be revoked under Section(s) 64 and 107 of the Act, on the ground of lack of novelty and inventive step.

The plaintiff submitted that the defendant has been implementing technology as disclosed in the plaintiff's patent IN759 and the defendant also failed to disclose any alternate technology used by them which raises a claim of non-infringement as stipulated under *Rule 3(B)(vi)7* of the Delhi High Court Patent Rules, 2022. The plaintiff's argues that the defendant failed to provide any scientific material while questioning the validity of the patent. The plaintiff further states that *"..the plaintiff is likely to suffer irreparable harm, loss and injury to its intellectual property rights at the hands of the defendant..".* The defendants challenges the validity of the plaintiff's patents. The defendant further stated that the patent IN759 is expiring on 24 May 2025, and the defendant has been selling the said product since 2018, so the *balance of convenience* cannot fall in favor of the plaintiff for grant of an interim injunction.

The Hon'ble Delhi High Court observed that the patent IN759 has expired therefore the order restraining infringement cannot be maintained. The Hon'ble Court ordered the defendant to file an affidavit of one of its representative along with the proof disclosing the date of defendant's dealing with product alleging features of IN759 including products manufactured but yet to sell up to the date of expiry of IN759 for the purpose of inspection. The Hon'ble Court concluded by disposing the present matter.

SRINIVAS JEGANNATHAN (Appellant) vs THE CONTROLLER OF PATENTS (Respondent)

CASE NO.: (T)CMA(PT)/38/2023; (OA/61/2014/PT/CH)
DECIDED ON: July 01, 2025

The appellant has filed an appeal challenging the impugned order rejecting the appellant's patent application. The appellant contended that none of the cited prior arts teach, motivate or suggest the combination as disclosed in the present application, therefore it cannot be obvious to the person skilled in the art (PSITA). The appellant further contended that the respondents allegation of the amendments falling outside the scope of section 59 of the Patents Act, 1970 cannot be maintained, as the appellant modified the claims after the hearing based on the

interaction with the respondent. The respondent countered that they cannot be blamed for considering and rejecting the last amended claims based on the cited prior art as the appellant willingly amended the claims more than once and that they need to examine the last amended claims itself. The respondent also stated that they have lawfully rejected the claimed invention by thorough examination of the prior arts.

The Hon'ble Madras High Court analyzed the matter and stated that the impugned order failed to provide any reasoning as to how and why the appellant's patent application is obvious to a person skilled in the art on the basis of the prior arts cited. The Hon'ble Court further states that the objection raised under section 59 of the Patent Act holds no relevance as the appellant confined the claims to the original claims. The Hon'ble Court concluded by reconsidering the matter on the basis of original claims along with the complete specification submitted by the appellant and the reconsideration will be done by a different officer.

SHAPERON INC. (OA/6/2018/PT/KOL) (Appellants) vs THE CONTROLLER GENERAL OF PATENTS AND DESIGNS, MUMBAI AND ANR. (Respondents)

CASE NO.: IPDPTA/68/2023; IA NO: GA/1/2023
DECIDED ON: June 26, 2025

The present appeal has been filed by the appellant against the respondent for passing an impugned order. The appellant argued that the respondent issued an impugned order without considering or taking into account the submitted expert evidence of Dr. Seung-yong Seong as an affidavit. The respondent agreed that they passed the impugned order without referring to the expert evidence.

The Hon'ble Court noted that the impugned order had no mention of the affidavit submitted by the appellant, the respondent has not considered the expert evidence. The Hon'ble Court states that the perusal of such affidavit illustrates the effect and technical advancements of the subject invention, therefore the affidavit deserves consideration. The Hon'ble Court concluded by setting aside the impugned order and demanded afresh consideration of the appellant's patent application by taking into account the submitted affidavit.

TRADEMARK CASES

M/S SITA RAM IRON FOUNDRY AND ENGINEERING WORKS (Petitioner) vs HINDUSTAN TECHNOCAST (P) LTD. AND ANR. (Respondents)

CASE NO.: C.O. (COMM.IPD-TM) 150/2021
DECIDED ON: July 9, 2025

Petitioner filed a rectification petition against respondents seeking cancellation of the trademark **"BADAL"** registered in Class 07. This arose out of a trademark infringement suit (CS/10/2015) initiated by respondent against the petitioner over the use of **"GHANGHOR BADAL".** Petitioner argued that the mark **"BADAL"** was fraudulently assigned to the respondent, based on faulty documents and an invalid assignment chain. The mark was originally owned by a partnership firm, and the subsequent assignments lacked legal basis. Respondents, despite multiple opportunities, failed to file a reply.

The Hon'ble Delhi High Court observed that even in the absence of a reply, the burden of proving fraud lies on the petitioner. Allegations of fraud require specific evidence and cannot be presumed. The documents provided, including assignment deeds and partnership clarifications, did not convincingly prove any forgery or illegitimacy. Also, no other stakeholders from the original firm contested the respondent's claim to the mark. The Hon'ble Court dismissed the rectification petition, holding that the trademark **"BADAL"** has been in use since 1945 and no prima facie fraud was established by the petitioner. The petitioner failed to prove its case independently, as required by law.

MOHAN MEAKING LIMITED (Plaintiff) vs ESTON ROMAN BREWERY & DISTILLERY PVT. LTD. (Defendant)

CASE NO.: Commercial Suit No.07 of 2025
DECIDED ON: July 9, 2025

Plaintiff, a reputed and long-standing liquor manufacturer (notably of "**Old Monk Coffee**"), filed a suit against the defendant, alleging trademark infringement and passing off. The defendant was using the mark **"OLD MIST"** for a coffee-flavored rum, which the plaintiff claimed was deceptively similar to their own product. Plaintiff argued that **"OLD MIST"** closely resembled the registered trademark **"Old Monk Coffee"**.

Defendant had no registered trademark and was intentionally attempting to pass off its product by copying the plaintiff's label and packaging. The defendant had just been served notice, and the case is at an early stage. No reply from their side at this point.

The Hon'ble High Court of Himachal Pradesh observed that the products and packaging were strikingly similar, creating a high probability of consumer confusion. Also, noted the plaintiff's established goodwill and registered trademark status versus the defendant's lack of registration. The Hon'ble Court granted an interim injunction restraining the defendant from manufacturing, selling, or distributing the product "**OLD MIST Coffee Rum**" until further orders, finding a prima facie case of infringement and passing off in favor of the plaintiff.

RELIANCE RETAIL LIMITED (Plaintiff) vs ASHOK KUMAR & ORS. (Defendants)

CASE NO.: CS(COMM) 647/2025, I.A. 15197/2025
DECIDED ON: July 7, 2025

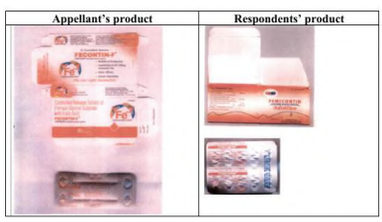
Plaintiff filed a suit against defendants for impersonating the plaintiff company using its trademark "**Tira,**

to scam customers via fake phone calls, WhatsApp messages, and UPI links. Plaintiff alleged large-scale consumer fraud using its brand name **Tira**, claiming infringement, passing-off, and irreparable harm to reputation. Defendants no representation; many defendants were unknown or government/technical intermediaries like DoT, NPCI, and WhatsApp.

The Hon'ble Delhi High Court found strong prima facie evidence of impersonation and consumer deception, stating the fraudulent use of "**Tira**" could not be permitted to continue and highlighted the organized nature of the scam. The Hon'ble Court restrained defendants from using the "**Tira**" mark or launching fraudulent schemes. Telecom operators, WhatsApp, and NPCI were directed to assist in identifying and disabling related fraudulent accounts.

MODI-MUNDIPHARMA PVT. LTD. (Appellant) vs SPECIALITY MEDITECH PVT. LTD. & ANR. (Respondent)

CASE NO.: RFA(OS)(COMM) 8/2023, CM APPL. 20433/2023, CM APPL. 34634/2023 & CM APPL. 42133/2023
DECIDED ON: July 1, 2025



The Appellant filed a case against the respondents for passing off and trademark infringement. The respondents adopted the trademark "**FEMICONTIN**" for use in pharmacy products, which was reportedly deceptively similar to the appellant's registered marks "**FECONTIN-F**" and the wider "**CONTIN**" family of marks. The appellant prayed for a permanent injunction, damages, and other reliefs on the basis that the adoption of "**FEMICONTIN**" infringed its trademark rights and damaged the reputation of its brand.

The respondents, however, averred that the mark "**FEMICONTIN**" was coined spontaneously and bona fide. They justified that "**FE**" stood for ferrous (iron), "**FEMI**" stood for female (the target group), and "**CONTIN**" stood for continuous drug release thus making the mark descriptive of the purpose and nature of the drug. They contended that "**CONTIN**" was not a neologism, and that the appellant had not been using "**CONTIN**" as an independent mark. The respondents claimed that there was no possibility of confusion among medical practitioners, given that the product was a Schedule H drug.

The Hon'ble Delhi High Court noted that, while the appellant was the registered proprietor of both "**FECONTIN-F**" and "**CONTIN,**" there was no independent commercial use of "**CONTIN**". The Hon'ble Court ruled that the use of "**CONTIN**" only as a suffix in different marks did not give exclusivity to the appellant over the word. Also noted that "**FECONTIN-F**" was largely descriptive "FE" for iron and "**CONTIN**" for a sustained release form. The Hon'ble Court also ruled that the visual and aural distinction between "**FEMICONTIN**" and "**FECONTIN-F**" negated any real likelihood of confusion. Finally, the appeal was dismissed. The Hon'ble Court upheld the earlier decision and held that the respondents' adoption of the mark "**FEMICONTIN**" was valid and not passing off. The appellant's passing off and trademark infringement claims were dismissed, and the application for injunction and damages was refused.

COPYRIGHT CASES

PRIME DIAMOND TECH & ORS. (Plaintiff) vs SONANI JEWELS PVT. LTD. & ORS. (Defendants)

CASE NO.: Special Civil Application Nos. 9066 & 9073 of 2025
DECIDED ON: July 7, 2025

Plaintiff filed a copyright infringement suit against defendants, alleging that former employees misused confidential information and trade secrets relating to HPHT technology for treating diamonds. The plaintiff claimed the defendants replicated proprietary designs and misused confidential information accessed during employment. Defendants argued that the Court Commissioner exceeded the inspection scope and collected unrelated and confidential business data from their devices.

The Hon'ble Gujarat High Court noted that both parties raised serious objections to sharing each other's trade secrets. The Commercial Court erred in allowing advocates to access such confidential information without due reasoning or safeguards. The Hon'ble High Court quashed the Commercial Court's order dated 25.06.2025 and rejected both parties' applications for access to each other's confidential material. Emphasized that revealing trade secrets defeats the purpose of copyright protection and instructed the trial to proceed swiftly as per Supreme Court directions.

T.N.K. GOVINDARAJU CHETTY & CO. PVT. LTD. (Plaintiff) vs BUVANA SARAVANAN, SHANTI SARAVANAN, AND SUDHAKAR CINE ARTS (Defendants)

CASE NO.: C.S.(Comm.Div.) No.129 of 2024
DECIDED ON: June 30, 2025

Plaintiff in the present suit the defendants alleging infringement of copyright in four classic Tamil films: ***"Padagotti, PaadhaKanikkai, Panathottam, and Gowri Kalyanam".*** Plaintiff claimed ownership through a chain of titles from original rights holder Velumani to Devi Films, which later merged with the plaintiff. Defendants despite the transfer, claimed rights via public notices and assignments, though they failed to appear in court (set ex parte).

The Hon'ble Madras High Court upheld the plaintiff's documentary evidence, including High Court-approved amalgamation orders and ownership acknowledgments. It found no rebuttal from the defendants. The suit was decreed in favor of the plaintiff. The Hon'ble High Court granted permanent and mandatory injunctions and ordered the defendants to pay ₹3,00,000 in costs. The claim for ₹5,00,000 in damages was denied due to lack of proof of actual loss.

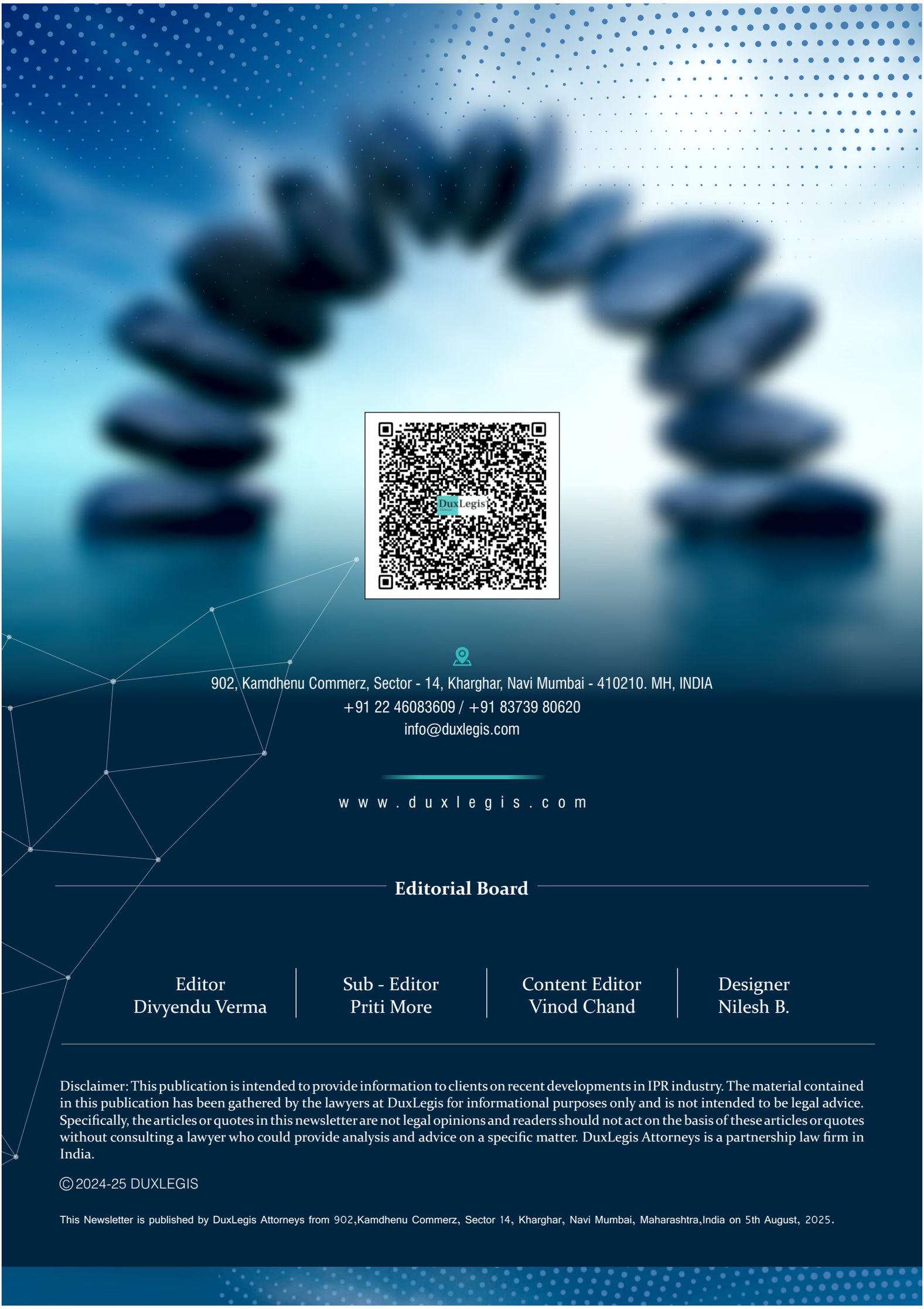
GEOGRAPHICAL INDICATION

ASOCIACION DE PRODUCTORES DE PISCO A.G. (Petitioner) vs UNION OF INDIA & ORS. (Respondents)

CASE NO.: W.P.(C)-IPD 17/2021, CM 139/2022 & CM 59/2023
DECIDED ON: July 7, 2025

The Petitioner a Chilean producers' association, filed a writ petition against the Respondents, challenging the IPAB's 2018 order that granted exclusive GI registration of the word **"PISCO"** (without prefix) to Respondent No. 4. The petitioner claimed shared and legitimate GI rights over **"Chilean PISCO".** Petitioner has a historical and legally recognized claim over **"PISCO"**, both countries use the term for different beverages. The term should be **"Peruvian PISCO"** and **"Chilean PISCO"** to avoid consumer confusion. IPAB misapplied trademark principles in a GI case. Respondent No. 4 has exclusive and historical rights to **"PISCO".** The IPAB rightly removed the prefix "Peruvian" as prefixing is impermissible in GI law.

The Hon'ble Delhi High Court rejected IPAB's reasoning that petitioner use was dishonest or misappropriate. Hon'ble Court clarified that GI law does not consider concepts like "prior use" or "dishonest adoption" (relevant in trademark law). The Hon'ble Court found that **"PISCO"** is also geographically and culturally identified with Chile. Therefore, denying Petitioner use was legally incorrect. The Hon'ble Court emphasized the principle of coexistence of homonymous GIs, as allowed under Section 10 of the GI Act and TRIPS. The Hon'ble Court set aside the IPAB's 2018 order and restored the Registrar's 2009 order, thereby reinstating the GI in favor of **"Peruvian PISCO"** (not **"PISCO"** standalone). Further directed that the petitioner's GI application for **"Chilean PISCO"** be processed in accordance with law, thereby allowing both countries to use the term **"PISCO"** with appropriate prefixes, ensuring no confusion to consumers.



902, Kamdhenu Commerz, Sector - 14, Kharghar, Navi Mumbai - 410210. MH, INDIA
+91 22 46083609 / +91 83739 80620
info@duxlegis.com

www.duxlegis.com

Editorial Board

This Newsletter is published by DuxLegis Attorneys from 902,Kamdhenu Commerz, Sector 14, Kharghar, Navi Mumbai, Maharashtra,India on 5th August, 2025.