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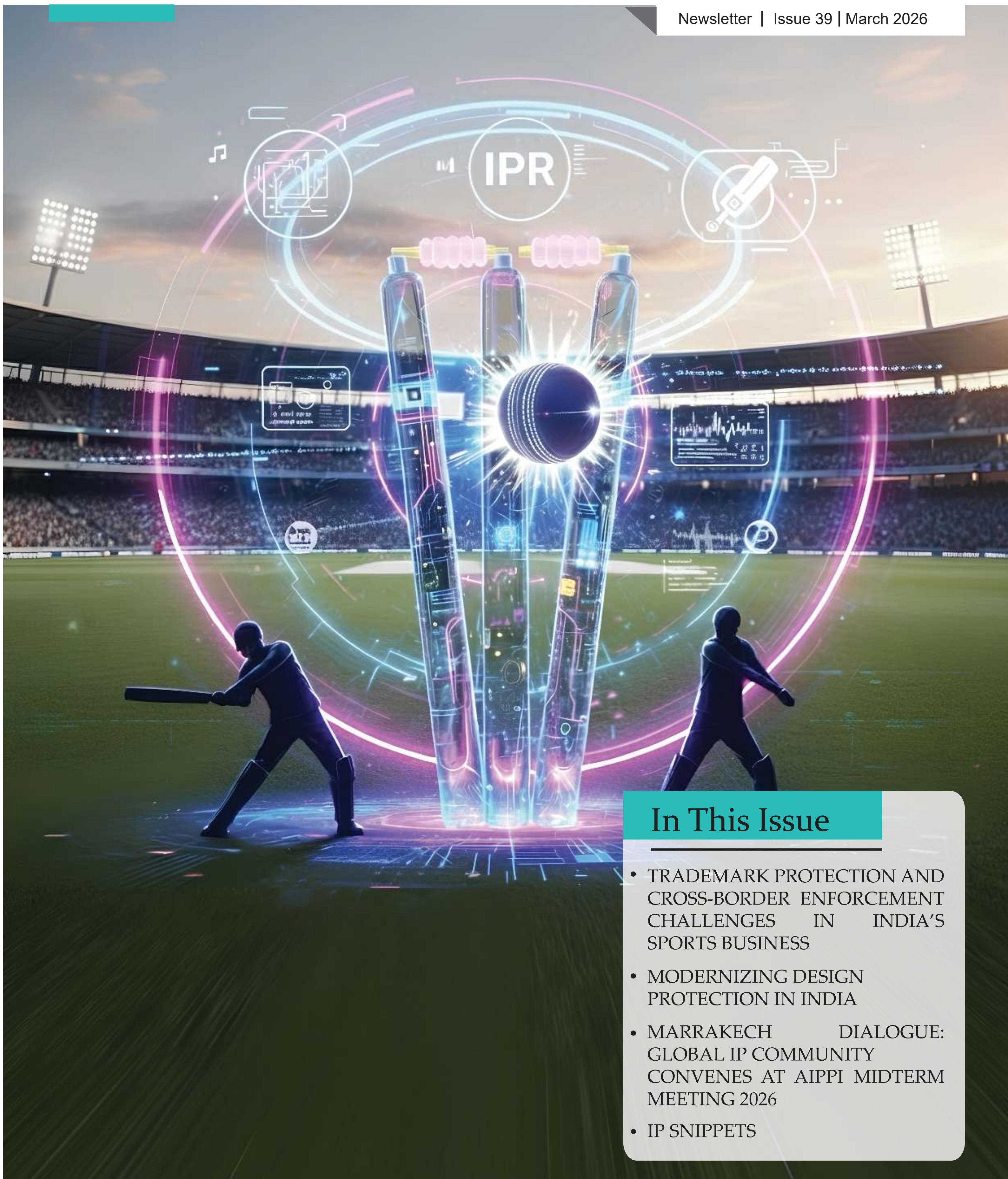

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TRADEMARK PROTECTION AND CROSS-BORDER ENFORCEMENT CHALLENGES IN INDIA'S SPORTS BUSINESS

Ananya A. Sinha

As the World Intellectual Property Organization (WIPO) marks World IP Day under the theme *"IP & Sport – Ready, Set, Innovate!"*, the spotlight extends beyond technology and innovation to the powerful role of trademarks in shaping the global sports economy. In modern sport logos, team names, colours, and insignia are not merely decorative elements, but they are commercial assets that drive merchandising, sponsorship, licensing revenue, and brand loyalty across borders. For sports franchises, leagues, and event organizers, trademark protection is central to safeguarding identity, maintaining consumer trust, and preserving commercial value. In rapidly evolving and expanding markets such as India, however, the enforcement of these rights presents complex legal and practical challenges.

When the logos, symbols, names, or distinctive colour combinations associated with a particular sports team are used without authorisation, such use may constitute trademark infringement under *Section 29 of the Trademarks Act, 1999.* This provision sets out the circumstances under which the unauthorised use of a registered trademark amounts to infringement. Under section 29, a registered trademark is infringed when a person without authority uses a trademark similar to, or it appears to be similar to registered trademarks good or services in a manner that it causes likelihood of confusion. Sports teams registered their names, logo, insignia and mascots to use on goods such as jerseys, caps, or accessories and if someone unauthorized reproduce the same it will amount to infringement.

On various occasions, the Indian courts have shown agreement with this belief as well that selling counterfeit products related to sports constitutes infringement of the registered trademark. There is no need to establish whether consumers have actually been misled. This is because registered trademarks enjoy legal protection. This means that since the mark is registered, the legal right belongs to the registrant for use in the area or industry for which it was registered. Violation of the mark is considered infringement on its own.

The sale of counterfeit sports goods can also be dealt with the common law principle of 'passing off,' which protects goodwill and reputation. Passing off arises through misleading representations and the traditional elements of damage recognized under Indian law and by the Hon'ble Courts. The sale of sports merchandise bearing indicia of teams or leagues misrepresents an official endorsement or association with the intellectual property owner.

It has been recognized in various Indian case laws that when there is existence of trademark registration, passing off remains a viable option for addressing the sale of counterfeit merchandise one the basis of likelihood of confusion and consumer deception.

Extent of Trademark Protection Available to Sports Teams and Leagues Against Counterfeit Goods

Sports teams and leagues are not only sporting bodies but also commercial brands. The protection

conferred to such entities under the Trademarks Act, 1999 is an important tool in curbing mass counterfeiting of merchandise and promotional materials. Registration of a trademark confers significant statutory rights however; registration alone is not always sufficient to completely prevent large-scale counterfeiting.

Under *Section 28(1) of the Act the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.*

In this manner, when a sports league registers its logo or team name under relevant classes (typically Class 25 for clothing, Class 35 for merchandising, etc.), it obtains statutory exclusivity over its use. Further, *Section 31* provides that *the original registration of the trademark and of all subsequent assignments and transmissions of the trademark shall be prima facie evidence of the validity thereby strengthening enforcement actions.*

- **Counterfeiting**

Counterfeiting generally falls squarely within *Section 29 (Infringement of Registered Trade Marks). A registered trademark is infringed when:*

An identical or deceptively similar mark is used in the course of trade, such use is in relation to identical or similar goods, and the use causes likelihood of confusion or association.

Counterfeiter typically copy or replicate similar or identifiable logos or team names for sports merchandise like jerseys, caps, scarves, accessories etc. This constitutes clear infringement under *Section 29(1) and 29(2).* Furthermore, if the sports team's trademark is considered a well-known trademark under Section 2(1)(zg) read with Section 11(2) of the Trademarks Act, 1999, then the protection afforded to the trademark goes beyond the similarity of goods or services and into the area of anti-dilution protection.

- **Meaning of "Use"**

Section 2(2)(c) make clear that *"use" of a mark in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods.* This broad definition ensures that:

- Printing logos on jerseys,
- Embroidering team names on caps, and
- Displaying marks on packaging or tags

all constitute trademark use.

Thus, counterfeit merchandise bearing sports marks clearly falls within actionable infringement.

- **Well-Known Mark Protection and Brand Dilution**

When a major national or international league attains well-known status, the protection extends beyond similar goods as per *Section 11(2).* Even if the use is on completely different products like electronics, toys, video games etc. the trademark owner can still stop them for unauthorized use even if the products are unrelated to sports. They may still restrain

- if the use is free-riding on the league's goodwill and reputation; or
- if the use weakens the distinctive character of that mark.

In this regard, even the use of an identical or similar trademark on completely different goods can be prohibited if such use amounts to unfair advantage of, or is detrimental to, the distinctive character or reputation of the earlier trademark. This is because of the doctrine of trademark dilution, as embodied in Section 29(4), which safeguards trademarks with reputation in India against "***free-riding***" (unfair advantage), "***blurring***" (reduction of distinctiveness), and "***tarnishment***" (reputation damage). Major sports leagues and teams brand value lies in their widespread public recognition, fan support, sponsorship, and extensive merchandise, when they get a recognition as a well-known mark it ensures that their commercial appeal and goodwill are not vulnerable to exploitation by third parties even in non-sports-related markets, accordingly it protects the overall economic and reputational integrity of the sports brand.

- **Civil and Criminal Remedies Against Counterfeiting**

Section 135 of the Trademark Act, 1999 gives power to the Hon'ble Courts to grant Injunctions (including ex parte injunctions), either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure. For sports entities, this allows immediate injunctions before tournaments, seizure and destruction of counterfeit jerseys, and recovery of profits from infringers. Criminal provisions under *Section 102 – 104 and 115* of Trademark Act, 1999 addresses large-scale counterfeiting. These sections include Falsifying and falsely applying trademarks, Penalty for applying false trademarks, trade descriptions, etc., Penalty for selling goods or providing services to which false trademark or false trade description is applied and Cognizance of certain offences and the powers of police officer for search and seizure. These provisions enable sports leagues to initiate criminal proceedings, conduct raids against infringers, and seize counterfeit goods.

- **Limitations**

Despite robust statutory protection, registration alone does not automatically eliminate counterfeiting because proactive monitoring and litigation are required for enforcement.

Online marketplaces and informal markets facilitate rapid distribution, and customs counterfeiting and international cooperation may be required to address cross-border counterfeiting. Thus, while registration is an initial requirement, effective protection requires continuous enforcement, licensing control, border measures, and strategic litigation.

- **Supplementary Protection - Interplay with Passing Off**

Section 27(2) protects the common law remedy of passing off and make sure to protect against misrepresentation that can damage the goodwill and reputation, which is particularly important for sports clubs, where success is closely tied to brand recognition and fan loyalty.

Challenges in Cross-Border Enforcement of Trademarks in Sports Merchandise

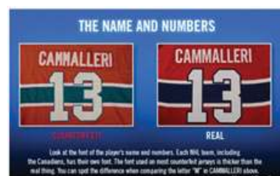
The globalization of sports leagues and the augmented growth of E-commerce have drastically expanded the market for sports merchandise. Still, this development has simultaneously increased cross-border counterfeiting. While national trademark law provides robust remedies, the regional nature of trademark law and the complex legal responsibility for online intermediaries establish significant enforcement challenges. The governing framework in India remains the Trade Marks Act, 1999, extended by international mechanisms such as the Madrid Protocol and domestic intermediary liability laws including the Information Technology Act, 2000.

- **Global Supply Chains and Jurisdictional Hurdles**

As counterfeit goods often transit through multiple jurisdictions, this global nature of supply chains complicate enforcement efforts making it difficult to track and intercept the counterfeit goods. These goods are manufactured in one country, channel through several intermediary jurisdiction and then distributed in entirely different markets. This break-up complicates attempts to identify the source of infringement and decide which courts have jurisdiction. Variations in national trademark laws, enforcement standards, and levels of cross-border cooperation further hinder effective action. Furthermore, organized criminal networks often manipulate these global trade systems by using complicated shipping routes, shell companies, free trade zones, and small parcel distribution networks to escape detection. Therefore, rights holders and enforcement authorities seeking to track, intercept, and suppress illicit trade encounter extensive legal and practical hurdles due to the cross-border passage of counterfeit goods.

- **Lack of Harmonized International Legal Framework**

Sports merchandise such as fake jerseys, fan accessories, and footwear bearing the marks of leagues like



https://sports.yahoo.com/blogs/nhl-puck-

the Indian Premier League, FIFA, or the National Basketball Association creates significant inconsistencies in how this counterfeit sports merchandise is addressed across jurisdictions. A foremost challenge in the cross-border enforcement of trademarks in sports merchandise is the lack of harmonized international legal framework to combat counterfeiting.

In reality, a sports brand owner can have very effective trademark protection and border protection in one jurisdiction, but very weak remedies, procedural hurdles, or customs action in another. Some countries have harsh criminal sanctions for counterfeiting, while others view it mainly as a civil issue, thereby weakening its deterrent value. Variations in burden of proof, valuation of damages, and detection of famous trademarks increase the difficulty of enforcement. As counterfeit sports goods may transit various countries before reaching the market, especially via the internet, such discrepancies establish loopholes that counterfeiters are quick to exploit. Addressing these challenges requires stronger international cooperation, greater harmonization of legal standards, and coordinated action between governments, sports organizations, rights holders, and international institutions.

- **Digital Challenges – E-Commerce counterfeiting**

Contrary to conventional markets, the online nature of sports goods counterfeiting involves anonymous vendors, global logistics, and quick re-posting of the counterfeit sports goods, making the whole process much more complex for enforcement. While the intermediaries are granted conditional safe harbour under the *Information Technology Act, 2000*, the primary difficulty in enforcement still lies with the brands. In this context, the *Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007* were introduced to enable customs authorities to with hold clearance of the counterfeit imported goods. However, their efficacy in the current e-commerce environment is limited. The small cost and individual shipment of e-commerce platforms make it challenging to identify and intercept, hence reducing the efficacy of border protection measures in stopping large-scale smuggling of counterfeit sports goods into the country.

<u>Recommendations For Strengthening Trademark Protection through Custom Act, 1962 & IPR Enforcement Rules, 2007</u>

The enforcement framework under the *Customs Act, 1962* read with the *Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007* can efficiently address the challenge of cross-border counterfeit goods. Under *Section 11* of the Customs Act, the Central Government is empowered to prohibit import of goods infringing intellectual property rights, while *Sections 110 and 111(d)* authorize seizure and confiscation of such infringing consignments.

The 2007 Rules use this power by allowing right holders including sports teams and leagues to record their registered trademarks with Customs authorities (*Rule 3*), upon which customs officials may suspend clearance of suspected counterfeit goods at the border (*Rules 6–8*). Once suspension occurs, the importer and right holder are notified, and if infringement is confirmed, the goods may be confiscated and destroyed under official supervision. This mechanism is particularly crucial in the e-commerce era, where counterfeit sports jerseys and merchandise enter the country through fragmented small consignments.

Through active registration of their trademarks with the Customs department, meeting the necessary bonds, and engaging in verification processes within the required timelines, sports organizations can make border control a preventive tool for enforcement, hence preventing the massive importation of counterfeit sports equipment before they reach the local market.

<u>The Threshold at which Ambush Marketing crosses from Permissible Competitive Conduct into Actionable Trademark Infringement</u>

Ambush marketing occupies a legally sensitive space between legitimate competitive advertising

and unlawful commercial exploitation of another's trademark. In the Indian context, where no specific anti-ambush legislation exists, the dividing line is drawn primarily under the Trademarks Act, 1999 and the common law doctrine of passing off. The threshold is crossed when a marketing campaign moves beyond generic reference or cultural commentary and begins to create a likelihood of confusion, false association, unfair advantage, or dilution of the distinctive character of a protected sports mark.

The decision in ***ICC Development (International) Ltd. v. Arvee Enterprises (2003)*** illustrates this distinction. During the 2003 Cricket World Cup, Arvee Enterprises promoted Philips products using slogans such as ***"Philips: Diwali Manao World Cup Jao"*** and ***"Buy a Philips Audio System, win a ticket to the World Cup 2003."*** Although the ICC alleged ambush marketing, the Hon'ble Delhi High Court held that mere use of the generic expression *"World Cup"* did not constitute trademark infringement, absent use of registered logos or sufficient confusion. The Hon'ble Court acknowledged the commercial harm to sponsors but emphasized that ambush marketing per se is not unlawful unless statutory elements of infringement or passing off are satisfied.

Similarly, in ***Royal Challengers Bengaluru v. Uber Moto (2025),*** the Hon'ble Delhi High Court refused interim relief where an advertisement contained humorous cricket references involving a player but did not use the official Royal Challengers Bengaluru logo or falsely claim sponsorship. The Hon'ble Court characterized the advertisement as permissible sports commentary and cultural banter rather than trademark infringement. This ruling reinforces the principle that indirect references, parody, or comparative advertising do not automatically amount to actionable infringement unless they create a clear false association.

The threshold is therefore crossed when:

- The impugned campaign uses identical or deceptively similar registered marks (logos, team names, event insignia),
- The use suggests official sponsorship, endorsement, or affiliation,
- The conduct causes likelihood of confusion among the relevant public, or
- The campaign exploits the reputation of a well-known mark, resulting in dilution or unfair advantage under Section 29(4).

In contrast, generic references to sporting excitement, cultural commentary, humorous advertising, or non-deceptive promotional offers tied to an event without misrepresentation remain within the realm of permissible competitive conduct. Indian Courts have consistently maintained a high evidentiary threshold before restraining advertising speech, thereby balancing commercial exclusivity with freedom of trade and expression.

Thus, the dividing line lies not in the creativity of association, but in its legal effect: when marketing ceases to be clever competition and begins to misappropriate protected goodwill in a manner that deceives consumers or dilutes trademark value, it transforms from ambush marketing into actionable trademark infringement.

Conclusion

The Trademarks Act, 1999 provides a robust framework to combat counterfeiting through infringement actions, well-known mark protection, anti-dilution remedies, and both civil and criminal enforcement mechanisms. The common law remedy of passing off further strengthens protection against misrepresentation and unauthorized commercial exploitation. However, registration alone is not enough - effectiveness depends on vigilant and strategic enforcement. Border measures under the Customs Act, 1962 and the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007 offer critical preventive safeguards, but require proactive engagement by rights holders. Ultimately, protecting sports brands demands more than statutory rights; it requires coordinated enforcement, cross-border cooperation, and consistent judicial support to preserve brand integrity and commercial value.

MODERNIZING DESIGN PROTECTION IN INDIA

The Indian Design Office has emerged as one of the fastest growing office for highest number of design registration and securing place among top 10 design office. The existing Designs Act, 2000 is primarily oriented towards physical products and does not adequately address modern digital and virtual designs. To align with such rapid growth in design intensive sectors like fashion and clothing, automobiles, packaging, electronics, jewellery etc., the Design Act amendment has been proposed. In 2024, India signed the Final Act of the Riyad Design Law Treaty (DLT), which aims to simplify design registration by inculcating relaxed procedural formalities and reduced documentation requirements. The proposed amendments aim to modernise design protection, enhance ease of doing business and align Indian law with International best practices. The Hon'ble Prime Minister articulated his vision of *"Design in India, Design for the World"*.

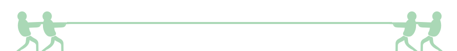
Key Proposed Amendments:

1. **Virtual Designs Protection:** Proposes clear and extended protection for virtual designs independent of any physical carrier. The definition of "design" and "article" has been clarified and updated to include items for protection in physical or non-physical form, including GUIs, icons, graphic symbols, typefaces, augmented reality graphical user interfaces, and other virtual products.
2. **Design–Copyright Interface:** Clarification of the overlap between design and copyright law by limiting copyright protection for registrable but unregistered designs to a fixed term of 15 years, thereby preventing long-term copyright monopolies.
3. **Full Grace Period:** Introducing 12-month grace period for prior disclosures made by the applicant would not destroy novelty. This is intended to replace the limited 6-month exhibition-based exception currently available under Section 21 of the Designs Act and to align Indian law with Article 7 of the Riyadh Design Law Treaty (DLT), which provides for a 12-month grace period.
4. **Deferred Publication:** Applicant can request deferment of publication of a registered design for up to 30 months from the filing or priority date to protect commercial confidentiality and reduced risk of pre-launch copying.
5. **Statutory Damages:** The proposal introduces statutory damages by understanding the nature and gravity of the "wilful infringement" and the scale of business of the infringer. Maximum compensation amounts to up to 50 lakhs for first infringement where actual damage is difficult or impractical and enhanced penalties for repeated infringement are also contemplated.
6. **Term of Protection:** The Concept Note proposes restructuring the term of protection of design into three successive periods of 5 years each (5+5+5), allowing renewal based on continued commercial relevance.
7. **Multiple Designs in single application:** Allows filing of multiple designs in a single application, reducing filing costs and administrative effort for applicants. Also allows examiners to examine the related designs together.
8. **Division of Applications:** Introducing divisional application to allow applicant to split a pending design application into one or more separate design application. This prevents blocking of an entire application and risking valuable design rights.
9. **Introduction of a Chapter on International registrations under Hague:** Introducing a dedicated chapter in the Design Act to facilitate international registration of designs under the Hague System. The Hague Agreement creates a simplified mechanism to enable Indian applicant to secure design protection in multiple jurisdiction through a single international application.
10. **Accession to Riyadh Design Law Treaty:** India accedes to the Riyadh Design Law Treaty (DLT) and amend the Designs Act to align with its procedural requirements. The DLT provides a closed list of filing requirements, permits multiple designs in a single application, allows a 12-month grace period, enables deferment of publication,

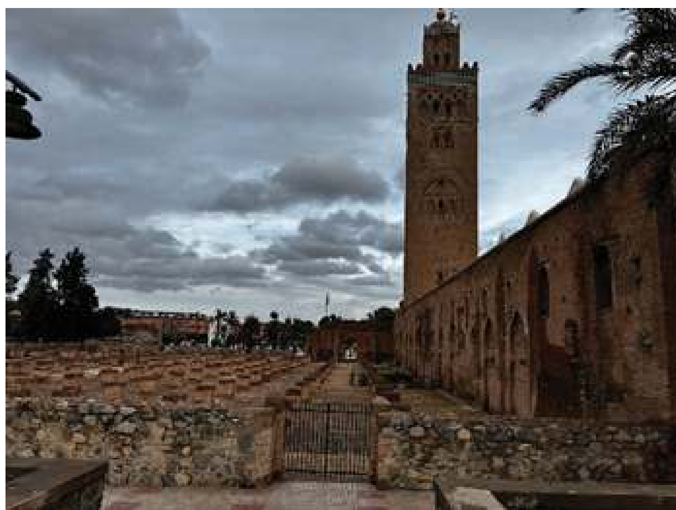
introduces time-relief and reinstatement measures for missed deadlines, simplifies renewal and recorded procedures, and permits correction or restoration of priority claims.

Conclusion

The proposed amendments modernise India's design law by making it technology-neutral, business-friendly, and internationally aligned. These reforms are expected to strengthen protection for designs and support innovation-led growth by introducing a structured framework for filing and maintaining the design protection.



MARRAKECH DIALOGUES: GLOBAL IP COMMUNITY CONVENES AT AIPPI MIDTERM MEETING 2026



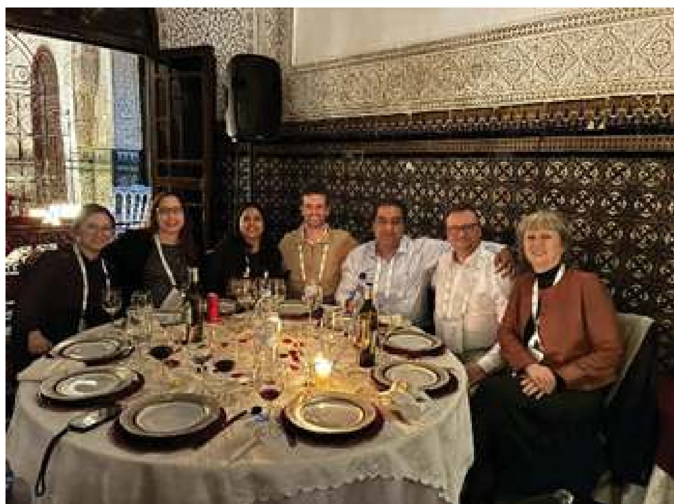
The AIPPI MidTerm Meeting 2026, held on 5-6 February 2026 in Marrakech, Morocco, brought together intellectual property professionals from across the globe for two days of committee work, policy discussions, and networking. The meeting served as an important platform for AIPPI members to exchange views on evolving developments in patent, trademark, and copyright law, as well as the broader impact of emerging technologies on the global IP landscape.

Our Managing Partner – Mr. Divyendu Verma has attended the MidTerm meeting on behalf of DuxLegis. Before the formal sessions began, Marrakech already offered a memorable start to the gathering. Mr. Verma had the pleasure of playing a couple of golf rounds with fellow IP attorneys, which turned out to be a wonderful experience. The relaxed setting provided an excellent opportunity to reconnect with colleagues and build new professional relationships. These informal interactions often prove just as valuable as the formal sessions, reflecting the strong sense of community within the AIPPI network.

Once the MidTerm Meeting commenced, the focus shifted to the organization's Standing and Study Committee meetings, where members worked on ongoing research projects and policy initiatives. These committees play a central role in AIPPI's mission of promoting the development and harmonization of intellectual property laws worldwide.

The discussions covered a wide range of issues, including developments in patent protection, amendments in Designs Law, trademark

enforcement, copyright challenges, and the growing influence of AI and digital platforms. Delegates shared insights from their respective jurisdictions, highlighting both common challenges and differing approaches to IP regulation and enforcement.



Particular emphasis was placed on the importance of international collaboration and harmonization of IP frameworks, an area where AIPPI has historically played a significant role. The exchange of practical experiences among practitioners, in-house counsel, academics, and policymakers enriched the discussions and helped identify areas where further policy development may be needed.

Beyond the committee sessions, the meeting also offered numerous opportunities for networking and informal exchanges among delegates. Marrakech proved to be an exceptional host city, with its rich cultural heritage, vibrant atmosphere, and warm hospitality adding a unique dimension to the event.

The AIPPI MidTerm Meeting in Marrakech once again highlighted the value of bringing together the global IP community to discuss emerging challenges and share perspectives from different jurisdictions. Events like these not only advance AIPPI's substantive work but also strengthen the professional relationships that underpin international cooperation in intellectual property.

As the organization moves forward with its ongoing studies and prepares for upcoming meetings, the conversations and connections formed in Marrakech will undoubtedly contribute to shaping the future discourse on global intellectual property policy.

IP SNIPPETS:

PATENT CASES:

YANGTZE MEMORY TECHNOLOGIE CO LTD (Petitioner) Vs UNION OF INDIA & ANR. (Respondents)

CASE NO.: W.P.(C)-IPD 10/2025
DECIDED ON: 05th February, 2026

In the present case, the petitioner filed a writ petition against the grant order of their patent application which closed an opportunity to file a divisional application.

The petitioner sent an email to the respondent explaining the circumstances of not being able to file divisional application and also made a detailed representation seeking re-opening of the window for filing the divisional application. However, the respondent stated that due to insufficient provisions, procedures, and IT infrastructure, they won't be able to accept the divisional application. The respondent countered that the petitioner had ample of opportunities to file a request for divisional application before the said application was proceeded to grant. The petitioner initially had no intent to file divisional application before granting the patent. The respondent states that the patent act do not permit post-grant division of application nor is there any exercise of discretionary power by the Controller.

The Hon'ble Delhi High Court observed and stated that the divisional application is to be filed before the grant of the parent application and therefore the petitioner contending violation of the principle of natural justice is invalid. As per section 43, when a patent application satisfies all the objection, the application must expeditiously proceed towards grant and there is no provision to communicate a notice to the applicant indicating grant of their patent before granting the same. The Hon'ble Court concluded by dismissing the present petition.

UPL LIMITED

(Appellant) Vs HARYANA PESTICIDES MANUFACTURES ASSOCIATION & ANR. **(Respondent)**

CASE NO.: IPDPTA No.116 of 2023
DECIDED ON: 05th February, 2026

The appellant filed an appeal for rejecting appellant's patent application based on the pre-grant opposition filed by the respondent no. 1 under section 25(1) of the Act. The appellant argued that the respondent 2(Controller) failed to deal with the prior art cited by the respondent 1 during the pre-grant opposition yet rejected the invention on the ground of lack of inventive step. The appellant further argued that the respondent 2 also failed to provide two separate hearing for section 14 and 25(1) before passing the impugned order. The respondent 2 countered that the impugned order is adequately reasoned and no separate hearing was necessary. Further, the respondent 1 states that the appellant's invention is mere admixtures of known ingredients resulting in obvious aggregation and no synergistic effect.

The Hon'ble Calcutta High Court observed the following matter that there has been serious procedural infirmity while passing the impugned order. As separate hearing under section 14 and 25(1) should have been granted to the appellant, since the objection raised in the FER and pre-grant opposition were different. Also, the impugned order do not specifically indicate the portion of the order dealing with exactly which section. Therefore, on the ground of procedural infirmity and violation of the principles of natural justice, the Hon'ble Court directed to remand the matter for fresh hearing

JFC STEEL CORPORATION (Petitioner) Vs THE CONTROLLER OF PATENTS & DESIGNS (Respondent)

CASE NO.: COMMERCIAL MISCELLANEOUS PETITION NO.52 OF 2025
DECIDED ON: 03rd February, 2026

The petitioner filed a petition challenging the impugned order passed by the respondent refusing the petitioner's patent application. The petitioner alleged that the respondent failed to examine the said application's novelty or inventive step and rejected solely on the ground of non-compliance with Section 10(4) of the Patents Act, 1970.

The Hon'ble Bombay High Court analyzed the matter and noted that the impugned order lacks findings on the aspect of novelty or inventive step. And the respondent rejected the application entirely on the basis of failure to meet the requirement of sufficiency of disclosure under Section 10(4) of the Patents Act, 1970. The Hon'ble Court observed the inadequacy of the reasoning in the impugned order. Therefore, the Hon'ble Court concluded that the impugned order cannot be sustained and directed for fresh consideration of the said application by a different Controller.

M/S CORAL DRUGS PRIVATE LIMITED (Appellant) Vs THE ASSISTANT CONTROLLER OF PATENTS AND DESIGNS AND ANR (Respondents)

CASE NO.: C.A.(COMM.IPD-PAT) 20/2023 & I.A. 13519/2023
DECIDED ON: 29th January, 2026

The appellant filed an appeal against an impugned order passed by the respondents for refusing the appellant's patent application on the ground of lack of inventive step under section 25(1) (e) of the Patents Act, 1970. The appellant submitted an affidavit of appellant's representative along with the annexure A(amended claims) which was taken on record and the same were furnished before the respondent 1 and respondent 2(pre grant opponent) to seek instruction on whether they have any objection. The respondent 1 and 2 jointly state that they would have no objection if the Hon'ble Court accepted the amended claims in terms of annexure A as submitted by the appellant.

The Hon'ble Delhi Court observed that as proposed by the appellant, deletion of claims would not constitute an amendment contrary to section 59 as it narrows the scope of the claims without introducing any new matter. The Hon'ble Court further stated that the auxiliary claims are not broadening the scope of the earlier claims and therefore it complies with section 58(1) and 59 of the Patents Act, 1970. The Hon'ble Court concluded by accepting the auxiliary claims and remanding the matter for a *de novo* consideration confined to the amended claims.

FRESENIUS KABI ONCOLOGY LTD (Appellant) Vs THE ASST CONTROLLER OF PATENTS AND DESIGNS (Respondent)

CASE NO.: C.A.(COMM.IPD-PAT) 91/2024
DECIDED ON: 23rd January, 2026

The appellant has filed an appeal challenging the impugned order passed by the respondent for refusing the appellant's divisional patent application. The respondent has passed the impugned order solely under the ground that the application lacks merit and do not meet the requirement of section 16 of the Patents Act, 1970, as the parent application having same technical features has been refused by the Patent Office. The appellant argued that the respondent has *illegally and arbitrarily* refused the said patent. The respondent accordingly countered the appellant's submission and supported the impugned order.

The Hon'ble Delhi High Court observed that the parent application has been granted during the pendency of this appeal. Therefore, the reason given for the rejection of the divisional patent application is no longer valid. The Hon'ble Court concluded by disposing the appeal and directing the respondent to reconsider and reexamine the said divisional patent application.

INCYTE HOLDINGS CORPORATION & ORS.

(Plaintiffs) Vs INTAS PHARMACEUTICALS LTD

(Defendant)

CASE NO.: CS(COMM) 67/2026, I.As. 1977/2026, 1978/2026, 1979/2026, 1980/2026, 1981/2026 & 1982/2026
DECIDED ON: 23rd January, 2026

In the present case, the plaintiff restricted the defendant from infringing plaintiff's patent application. The plaintiff submits that the defendant is listed as a supplier of "Ruxolitinib" on a third part website. Even though the defendant has not yet launched the product in the market, but they might launch "Ruxolitinib" infringing the plaintiff's patented compound. The defendant clarified that they have no intent on commercializing any product containing "Ruxolitinib" during the validity of the said patent but reserve their right to use it for research.

The Hon'ble Delhi High Court accepted the defendant's undertaking binding to use the "Ruxolitinib" for research purpose only and not commercially manufacture launch, import, export or deal the patent compound. The Hon'ble Court concluded by disposing the present suit and directing the registry to refund 50% court fees in plaintiff's favour.

NIPPON STEEL CORPORATION (Appellant) Vs THE CONTROLLER OF PATENTS (Respondent)

CASE NO.: C.A.(COMM.IPD-PAT) 10/2025
DECIDED ON: 24th December, 2025

The appellant filed the present appeal against the respondent for rejecting the appellant's patent application, failing to meet the requirements under section 7(2), 6(1)(b) and 6(1)(c) of the Act. The appellant states that they had filed the declaration in Form 1 along with the Employer-Employee (EE) agreement as a proof of right highlighting transfer of IPR during the tenure of employment with the appellant. Therefore, the documents filed satisfies the statutory obligations under Section 7(2) of the Act. The appellant argued that Section 6(1)(c) is inapplicable, relating to legal representatives of a deceased person, since the employee's Intellectual Property Rights (IPR) is vested in the company under the EE agreement. Under Section 6(1)(b), the Appellant is entitled to apply for the patent. The respondent states that the appellant failed to inform the Delhi Patent Office about the demise of the inventor till the hearing and they also failed to file the death certificate in respect of the same. Further, the respondent countered that the appellant failed to provide valid proof of right or assignment, therefore the objections raised under Sections 6(1)(b), 6(1)(c) and 7(2) of the Act is correct.

The Hon'ble Delhi High Court analyzed the matter and stated that the employment agreement between the employer and employee, which is also signed by the deceased inventor is an acceptable document to comply with requirement under section 7(2). The Hon'ble Court further states that respondent's observation in the impugned order is incorrect. The Hon'ble Court allowed the present appeal and set aside the impugned order and directed the respondent to grant the subject patent.

EDWARD CHARLES TROPPI SMYTHE (Petitioner(s)) Vs 1. THE CONTROLLER GENERAL OF PATENTS DESIGNS AND TRADE MARKS 2.JOINT CONTROLLER OF PATENTS AND DESIGNS AND 3.UNION OF INDIA (Respondent(s))

CASE NO.: WP (IPD) No. 12 of 2025
DECIDED ON: 18th December, 2025

The petitioner filed a writ petition for directing the respondent to accept and process the petitioner's request for examination. The petitioner states that the Indian patent agent errored while calculating the deadline for filing the request for examination, due to which the time period to file the request was lapsed and the petitioner's application got abandoned. The petitioner further states they shouldn't be deprived of pursuing the patent application because of the mistake caused by their Indian Patent agent.

The Hon'ble Madras High Court considered the nature of the petitioner's invention and also the fact that they did not intend to abandon the patent application. Hence, the Hon'ble Court allowed the writ petition and directed the respondent to accept the petitioner's request for examination and process their patent application.

TRADEMARK CASES

7–ELEVEN, INC. (Appellant) vs RAVI FOODS PRIVATE LIMITED & ORS (Respondents)

CASE NO.: (T) CMA (TM) NOs.110&157 of 2023
DECIDED ON: 11th February 2026

In the present appeals the appellant challenged the order of the Deputy Registrar of Trade Marks dated 18.07.2014 concerning registration of the mark **"Big Bite"**. The appellant, operating the global convenience store chain under the **"7–Eleven"** brand, claimed prior international adoption and continuous use of the **"Big Bite"** mark since 1988 and sought registration in India. It was contended that the respondents had adopted the identical mark in 2004 with mala fide intention to ride upon the appellant's international goodwill. The third respondent asserted prior use in India and relied upon continuous commercial sales since 2004.

The Hon'ble Madras High Court observed that while trans-border reputation is recognized in law, the appellant failed to establish actual confusion in India despite the respondent's long-standing use. Relying on the principles laid down in Toyota Prius and other precedents, the Hon'ble Court held that prior user in India carries significant evidentiary weight. Accordingly, the appeals were dismissed, and the Registrar's order was upheld.

SATYA PAUL (Petitioner) vs ALKA INDUSTRIAL CORPORATION AND ANR.(Respondents)

CASE NO.: C.O. (COMM.IPD-TM) 651/2022
DECIDED ON: 9th February 2026

In the present petition the petitioner sought cancellation of the registered mark **"AiC ARUN"** in Class 7. The petitioner claimed prior adoption and long-standing registration of the mark **"ARUN"** since 1962 in respect of sewing machines and allied goods. It was contended that the impugned mark was deceptively similar, with **"ARUN"** constituting the dominant and essential feature. The addition of the prefix **"AiC"** was argued to be insufficient to distinguish the marks. The respondents contended that **"ARUN"** was a common personal name and *publici juris*, and that the composite mark was structurally different.

The Hon'ble Delhi High Court observed that the petitioner had established extensive goodwill, continuous use, and valid subsisting registrations. Applying to the test of deceptive similarity and likelihood of confusion, the Hon'ble Court held that the dominant part of the impugned mark was identical to the petitioner's mark. The Hon'ble Court concluded that the registration was wrongly remaining in the Register and was liable to be removed. Accordingly, the rectification petition was allowed.

THUKRAL MECHANICAL WORKS (Appellant) vs PM DIESELS PRIVATE LIMITED & ANR. (Respondents)

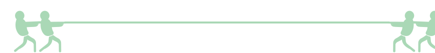
CASE NO.: LPA 320/2024, CM APPL. 23753/2024
DECIDED ON: 6th February 2026

In the present appeal, the appellant challenged the long-standing trade mark war with respondent. The dispute concerning the mark **"FIELD MARSHAL / FIELDMARSHAL"** in respect of centrifugal pumps and allied goods under class 7. The dispute arose between appellant, claiming rights through assignment from *Jain Industries* (previous registered proprietor since 1965), and respondent, which had been using the mark since early 1960's for diesel engines and later in 1975 for centrifugal pumps.

The appellant contended that being the assignee of registered trade mark, it was entitled to statutory exclusivity and to restrain the respondent from use of the impugned mark. The respondent, on the other hand, asserted prior user rights and long-standing goodwill in the mark, arguing that registration without bona fide use could not defeat its superior common law rights. The crucial issue before the Hon'ble Court was, whether statutory rights arising from registration could prevail over prior user rights acquired through continuous commercial use and goodwill. The matter involved rectification proceedings in earlier Hon'ble Supreme Court findings, and parallel suits for infringement and passing off.

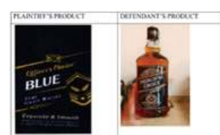
The Division Bench identified the controversy as a classic ***"Kerly impasse"*** a situation where a registered proprietor who had not used the mark confronts a prior user who has subsequently built substantial goodwill through commercializing it. The Hon'ble Court also analysed the scope of rectification for non-use, the legal effect of assignment of an unused mark, and the interplay between infringement and passing off claims.

The Hon'ble Delhi High Court recognized respondent as the prior user of the **'FIELDMARSHAL'** mark, it ultimately declined to grant exclusive statutory rights to either party. The appeal was allowed, resulting in dismissal of respondent's registration claims and a position where neither side retained enforceable exclusivity for centrifugal pumps. The judgment provides detailed guidance on conflicts between statutory trademark rights and common law passing off principles.



ALLIED BLENDERS AND DISTILLERS LIMITED (Plaintiff) vs BATRA BREWERIES AND DISTILLERIES PRIVATE LIMITED & ORS (Defendants)

CASE NO.: CS(COMM) 551/2023
DECIDED ON: - 4th February 2026



In the present commercial suit, the plaintiff sought a decree of permanent injunction restraining the defendants from infringing its registered trademark "Officer's Choice" by adopting and using the mark "Principal Choice / Principal Choice Premium Whisky" in respect of alcoholic beverages (Class 33).

The plaintiff contended that "Officer's Choice", adopted in 1988, is a well-known trademark with long-standing and continuous use, extensive registrations and substantial goodwill. The defendants had applied for registration of "Principal Choice Whisky" on a proposed-to-be-used basis however, failed to file a written statement and were proceeded ex parte.

The Hon'ble Delhi High Court held that the plaintiff's mark has acquired distinctiveness and secondary meaning through uninterrupted and extensive use over decades. The impugned mark "Principal Choice" was found to be phonetically, visually, and structurally similar, with "Choice" constituting the dominant and essential feature. The Hon'ble Court noted similarity in overall trade dress and held that the defendants adoption lacked bona fides and was

likely to cause confusion and deception among consumers. Accordingly, the suit was decreed, and permanent injunction was granted in favour of the plaintiff.

PARUL RUPARELLA AND ANR. (Appellants) vs CAMME WANG AND ANR. (Respondents)

CASE NO.: APO-IPD/1/2026, IA NO: GA-COM/1/2025
DECIDED ON: 4th February 2026

In the present appeal, the appellants challenged the order refusing interim injunction in a suit concerning the trademark **"PL SUPREME."** The appellants, Indian importers and registered proprietors of the mark in India, alleged infringement by the respondents, who were foreign manufacturers of goods bearing the same mark. The appellants contended that registration conferred exclusive statutory rights under **Sections 28 and 29** of the Trade Marks Act, 1999. The respondents asserted that they were the original manufacturers and prior users of the mark internationally, and that the appellants were merely importers of goods manufactured by them. It was further argued that **Section 30** of the Act provides only a defense to infringement and does not confer proprietary rights upon an importer.

The Hon'ble Calcutta High Court held that trademark ownership ordinarily vests in the first user, and in cases of foreign manufacture, a presumption arises in favour of the manufacturer unless rebutted. The appellants failed to demonstrate independent goodwill or consumer association of the mark with themselves in India. Accordingly, the Hon'ble Court found no *prima facie* case in favour of the appellants and dismissed the appeal

COPYRIGHT CASES

UNION OF EUROPEAN FOOTBALL ASSOCIATIONS (Plaintiff) vs LIVETV.SX & ORS. (Defendants)

CASE NO.: CS(COMM) 106/2026
DECIDED ON: 5th February 2026

In the present suit, the plaintiff seeking protection of its exclusive broadcast and copyright in the UEFA Champions League 2025–26 matches. The plaintiff alleged that the defendants' websites, including **"LIVETV.SX",** were illegally streaming and communicating the matches to the public without authorization, thereby infringing its statutory rights under the Copyright Act, 1957.

The plaintiff argued that it holds exclusive rights to broadcast and commercially exploit the tournament in India and that the defendant websites were rogue platforms engaged in systematic piracy. The defendants did not appear before the Hon'ble Court and were proceeded *ex parte.* The plaintiff further submitted that unauthorized live streaming during an ongoing tournament causes immediate and irreparable financial loss and dilutes the value of exclusive media rights.

The Hon'ble Delhi High Court observed that the defendant websites were prima facie rogue websites engaged in copyright infringement. Considering the urgency and balance of convenience, the Hon'ble Court granted an *ex parte ad interim injunction* restraining the defendants from streaming or communicating the matches to the public and directed domain name registrars and internet service providers to block access to the infringing websites.

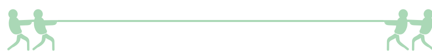
JIOSTAR INDIA PRIVATE LIMITED (Plaintiff) vs GHD SPORTS & ORS. (Defendants)

CASE NO.: CS(COMM) 89/2026
DECIDED ON: 30th January 2026

In this present civil suit, the plaintiff seeks protection of its broadcasting and media rights against the defendants who were operating unauthorized streaming platforms under various names. The plaintiff alleged that the defendants were illegally streaming copyrighted sports content and misusing marks associated with the plaintiff's platform, thereby infringing its statutory rights and causing dilution of goodwill.

The plaintiff argued that it holds exclusive rights in relation to the broadcast and digital dissemination of sports content and that the defendants were dishonestly exploiting its content through mobile applications and websites. The defendants did not appear before the Hon'ble Court despite service and were proceeded against *ex parte.*

The Hon'ble Delhi High Court observed that a *prima facie* case of infringement and unlawful streaming was made out. Considering the balance of convenience and irreparable injury, the Hon'ble Court granted interim injunction restraining the Defendants from streaming, reproducing, or communicating the Plaintiff's content to the public, and also directed blocking of the infringing platforms.



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