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SECOND LIFE OR SECOND OFFENCE? TRADEMARK LAW AND THE UPCYCLING OF LUXURY BAGS



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<https://www.businessinsider.com/>

What you're looking at isn't just clever DIY it's the quiet rebellion of upcycling culture, where yesterday's packaging becomes today's "it-bag." If cereal boxes and delivery mailers can be

reborn as statement accessories, imagine the narrative when luxury goods are refashioned. Suddenly, exclusivity meets creativity. Of course, brands might call it dilution, consumers call it innovation (with a side of budget consciousness). After all, why just consume a brand when you can remix it? This growing trend, however, raises a critical legal question: *where does creative reuse end and trademark infringement begin?*

Refashioning or upcycling involves the modification of authentic, legally purchased luxury goods to produce new or customized goods, while the original constituents are intact. Unlike counterfeiting, the original product is genuine. The process includes the conversion of handbags to wallets or clutches, leather to belts or cardholders, source materials to shoes, phone cases, or accessories.

Degrees of Alteration

Repair vs. Modification vs. Transformation

- **Repair** refers to restoring the original state of the product.
- **Modification** refers to making limited changes to the product without affecting its original identity.

- **Complete transformation** refers to completely disassembling the original product and making a new product.

It is important to note that legal implications depend on whether or not the original identity of the product is maintained.

The rise of the luxury resale and customization industry has significantly contributed to the popularity of upcycling. This is due to the increased awareness of consumers about the importance of sustainable and ethical consumption. This has led to the development of the *circular fashion economy*, in which products are reused, repurposed, and extended in their life cycle rather than being discarded. Upcycling has also contributed to this movement by reducing waste and utilizing the value of the luxury materials.

A new segment of independent designers and small business entities has specialized in luxury upcycling and customization. This is done through pre-owned luxury goods or directly through customer-owned goods to create customized products. This is attributed to consumer behavior that is increasingly personal and exclusive but is also surrounded by complex issues relating to trademarks and brand management.

COUNTERFEITING vs REFASHIONING

Aspect	Counterfeiting	Refashioning
Origin of Product	Fake	Genuine
Trademark Use	Unauthorized	Originally authorized, later reused
Nature of Activity	Imitation	Modification
Legal Risk	Always infringement	Context-dependent infringement

Counterfeiting involves the unauthorized reproduction of registered trademark on goods that are not genuine. Such products are created independently of the brand owner and falsely



presented as authentic, with the intent to deceive consumers. The infringement here is direct and clear, as both the product and the use of the mark lack legitimacy.

Refashioning, in contrast, begins with genuine, lawfully acquired luxury products. The original item is altered, repurposed, or transformed into a new product such as converting a handbag into wallets or accessories while often retaining the original trademark. Unlike counterfeits, the starting point is authentic; however, the end product is not one that the brand has manufactured or approved.

Despite the authenticity of the base product, trademark infringement can still arise in refashioning scenarios. This is because trademark law protects not only against fake goods but also against misleading commercial use of a mark. When refashioned goods are sold in the market bearing the original trademark, they may create a false impression of source, sponsorship, or endorsement by the brand owner.

Additionally, substantial alterations may disrupt the application of the exhaustion doctrine, as the product being sold is no longer the same as the one originally placed on the market. Consequently, even though refashioning differs fundamentally from counterfeiting, it can still infringe trademark rights where it results in consumer confusion, misrepresentation, or harm to the brand's identity.

LIKELIHOOD OF CONSUMER CONFUSION

In terms of refashioning or upcycling luxury goods, the doctrine of likelihood of confusion is essentially used as a benchmark to evaluate the legality of such actions. The basic product may be authentic, but the refashioning gives it a new commercial context. The key question is whether such refashioned goods, when they enter the market again, will cause confusion among consumers regarding their *source, origin, or affiliation*.

Refashioning blurs the line between genuine and newly created products. When a luxury bag is transformed consumers encountering the final product may assume that the brand owner has

authorized, endorsed, or commercially produced such items. This risk is particularly heightened where the original trademarks logos, monograms, or distinctive design elements remain visible on the refashioned product. Thus, even lawful ownership of the original item does not automatically extend to creating a marketable product that appears brand approved.

In determining whether refashioning leads to consumer confusion, courts focus on how the modified goods are positioned in the marketplace:

- **Marketing practices of the refashioner:** If the refashioner advertises products using the brand name or suggests any form of association (e.g., “reworked” or “designer-inspired” without clarity), it may create an impression of affiliation. Transparent communication such as clearly stating that the product is independently refashioned is crucial.
- **Presentation of the product in the market:** The continued display of original trademarks on newly created items can mislead consumers into believing that the brand itself manufactured or approved the product. The use of original packaging or tags further strengthens this assumption.
- **Consumer perception:** Although luxury consumers are generally more discerning, they also place significant reliance on brand identity and exclusivity. A refashioned product bearing intact brand insignia may therefore be perceived as part of the brand's official offerings, especially in resale or online marketplaces.

Accordingly, in the realm of refashioning, the likelihood of confusion operates as a critical threshold distinguishing permissible personal use or alteration from commercial practices that risk misrepresenting the origin and endorsement of luxury goods.

DOCTRINE OF EXHAUSTION (FIRST SALE DOCTRINE)

The **First Sale Doctrine**, also known as the **doctrine of exhaustion**, states that once a genuine trademarked product has been sold lawfully, the



trademark owner's control over that particular product is considered exhausted. As a result, the purchaser is free to resell, transfer, or otherwise use the product without infringing the trademark owner's rights.

This doctrine plays an important role in trademark law because it strikes a balance between the rights of trademark owners and the free flow of goods in the market. While trademark law protects a brand's identity and its source, these rights are not absolute and must also allow for lawful resale and secondary markets. The doctrine promotes competition and enhances consumer choice in the marketplace. At the same time, it preserves the ability of trademark owners to take action against counterfeit or infringing goods. Once a trademarked product is lawfully introduced into the market, the trademark owner's rights over that particular product may become exhausted. Under **Section 29 of the Trade Marks Act, 1999**, infringement occurs when a mark is used in a manner likely to cause consumer confusion, **except where the doctrine of exhaustion applies.**

For instance, if a consumer purchases a pair of **Nike shoes**, the company cannot prevent the buyer from reselling the shoes through a resale platform, gifting them, or selling them in a second-hand store because the goods were lawfully introduced into the market.



When Modification Goes Too Far

Section 30(4) of the Trade Marks Act, 1999 provides an important limitation. The trademark proprietor may oppose further commercial dealing where the condition of the goods has been altered or impaired after the sale. Examples of such situations include:

- Repackaging the product
- Removing original packaging
- Altering the goods
- Selling damaged or expired products under trademark

In such cases, the continued use of the trademark

may mislead consumers and harm the reputation of the brand.

Where goods are modified, repaired, or repackaged the applicability of the first sale doctrine often depends on **clear disclosure**. The reseller must inform consumers about the modifications made to the product in order to avoid misleading them. For example, in **Prestonettes, Inc. v. Coty**, the court held that the use of a trademark to identify a component within a modified product is permissible provided that the product is not falsely represented as the original item.



Consider a practical example. Suppose you own a luxury handbag, such as a *Christian Dior tote bag*, and you decide to transform it into a wallet. The main question here arises, *"Whether this would amount to a trademark infringement"* While the initial purchase is protected under Section 30(3), such transformation may involve substantial alteration of the original product.

However, **Section 30(4)** introduces an exception. The trademark owner can object to further sale if the condition of the goods has been altered or impaired after they were introduced into the market. Converting a Dior tote bag into a wallet may involve:

- Material changes to the original design and structure
- Creation of a new product using the existing trademark
- A result that may no longer reflect the quality or standard associated with the brand.



Determining how much alteration is permissible before a product becomes counterfeit remains a complex issue. Courts have held that significant modifications to certain products, such as **Rolex watches**, may constitute counterfeiting when essential components are replaced. However, the legal boundary is less clear for other luxury goods



like handbags or footwear. Minor repairs such as replacing a zipper or repairing a heel, raises questions about whether the product can still be considered authentic. Luxury brands often argue that even minor modifications may reduce product quality and harm brand reputation. Conversely, consumers and resale platforms contend that limited repairs should not remove a product's authenticity as long as its overall condition remains substantially intact.

As discussed above, a limited degree of modification or remodeling of trademarked goods may be permissible under the doctrine of exhaustion. However, a critical question arises: *"how much is too much?"* In other words, at what point does the alteration of a genuine trademarked product become so substantial that it amounts to trademark infringement or passing off? This issue was authoritatively addressed in **Kapil Wadhwa v. Samsung Electronics Co. Ltd.** where the Delhi High Court (Division Bench) held that India follows principle of international exhaustion, meaning once goods are lawfully placed on the market anywhere in the world, their resale in India cannot be restrained.

However, the court emphasized an important limitation that the goods must remain genuine and unaltered and if the condition of goods is changed or impaired, the trademark proprietor can object under Section 30(4). The principle used was *"Exhaustion protects resale only where the goods remain in their original condition."* A few principles established by court overtime are *material alteration test, quality control test, consumer confusion test and commercial reintroduction test* which help courts determine the limits on remodeling of a product and commercially reintroducing it. These tests reflect the underlying principle that exhaustion protects the resale of genuine goods, but not their transformation into materially different products.

RELEVANT CASE LAW ON REFASHIONED LUXURY GOODS

In the recent trademark dispute of *Louis Vuitton Malletier v. Repair Shop Operator* the Supreme

Court of South Korea has passed a judgement stating that refashioning luxury bags for personal use does not amount to trademark infringement.

A repair shop in Seoul accepted customer orders, disassembled pre-loved Louis Vuitton bags and transformed the same material into new bags and wallets and handed it back to the same owner with a small fee. Louis Vuitton sued the repair shop on the grounds that the shop had altered the goods that bared its trademark through the process and infringed their rights.

The Hon'ble Supreme Court of Korea ruled that where a tailor or service provider alters a product at the request of its lawful owner and subsequently returns the finished item solely for the owner's personal use, such activity does not amount to "use" of the trademark, which is a fundamental requirement to establish infringement. Furthermore, the mere charging of a fee for the service rendered does not, by itself, convert the activity into statutory "use" of the mark.

On the other hand, India's trademark act could spark controversy. If the same case were to be tried in India the decision of courts could have had differed. As mentioned earlier, the statute that governs Indian trademarks differs from the ruling give by the Supreme Court of Seoul. Particularly, the sections governing trademark infringement, i.e. **Section 30(4)**- The proprietor can legally intervene if the goods' condition has changed or been impaired, which includes:

- Re-packaging or re-labelling.
- Removal of barcodes or serial numbers.
- Damage to the physical quality of the product.

While refashioning may not always involve re-packaging or removal of serial identifiers but there can be other sorts of damages. This creates a grey area for the Indian trademark law as it requires the condition of goods to not change or be "IMPAIRED" but at the same time it also mentions "DAMAGE" to the physical quality of the product. So, the question would remain for the courts to decide, "Whether remodeling would constitute as damage?"



US Examination

In the United States, trademark protection is governed by the **Lanham Act**, which regulates trademark rights and enforcement. The **First Sale Doctrine's**, (doctrine of exhaustion) application becomes nuanced in cases involving refurbished or modified products, particularly where “**material differences**” may mislead consumers or where quality control standards are not maintained.

A key precedent in this area is the decision of the U.S. Supreme Court in *Champion Spark Plug Co. v. Sanders*, where the Court held that reconditioned spark plugs could be sold under the original trademark if clearly identified as refurbished. The Court emphasized that **adequate disclosure protects the trademark rights, noting** that a reduction in quality is not legally objectionable as long as the products are explicitly marketed as repaired or reconditioned rather than as new items.

The judgment established that:

1. refurbishing alone does not constitute infringement;
2. clear disclosure mitigates consumer confusion; and
3. consumers understand refurbished goods may differ in quality.

However, extensive reconstruction may make continued trademark use inappropriate.

Courts in the United States seek to balance trademark protection with the broader objective of safeguarding consumer interests. Although refurbishment may be permissible under certain circumstances, trademark proprietors are more likely to succeed in infringement claims where refurbishers fail to disclose alterations or where modifications significantly affect the quality or characteristics of the product. The “**material differences**” **standard**, however, is inherently fact-specific, requiring courts to evaluate the circumstances of each case individually, which may result in varying judicial outcomes.

A more recent decision by the **United States Court of Appeals for the Fifth Circuit** further clarified the

limits of the First Sale Doctrine in cases involving substantial modification of trademarked goods. In *Rolex Watch USA, Inc. v. Becker Time LLC*, Rolex challenged the sale of watches combining genuine components with aftermarket modifications. The court held that such customization went beyond repair since Rolex never produced those configurations, the goods were no longer genuine, and resale constituted infringement.

While the decision in *Rolex Watch USA, Inc. v. Becker Time LLC* arises from U.S. law, its reasoning closely aligns with the principles governing trademark exhaustion under the **Trade Marks Act, 1999**. Indian law recognizes the **Doctrine of Exhaustion** under **Section 30(3)**, which allows the resale of genuine trademarked goods once they have been lawfully placed on the market by the trademark proprietor or with their consent. However, this protection is not absolute as Section 30(4) excludes protection where “**the condition of the goods has been changed or impaired after they have been put on the market.**”

Indian courts have interpreted this limitation to mean that the resale defence applies only when the goods remain **genuine and substantially unaltered**. In *Kapil Wadhwa v. Samsung Electronics Co. Ltd.* the Delhi High Court recognized the doctrine of international exhaustion but clarified that the protection extends only to **unaltered genuine goods**. Similarly, in *Rolex SA v. Alex Jewellery Pvt. Ltd.*, the court noted that alterations that affect the identity or quality associated with the trademark may invite liability. Trademark law recognizes a **spectrum of distinctiveness**, categorizing marks as fanciful, arbitrary, suggestive, or descriptive (including deceptive marks). Fanciful and arbitrary marks are inherently distinctive and therefore receive strong protection without the need for additional proof. In contrast, descriptive marks must establish **secondary meaning**, demonstrating that consumers associate the mark with a particular commercial source. Courts rely on empirical evidence such as consumer surveys, testimony, media references, advertising, and sales data. Stronger marks receive broader protection. Additionally, digital marketplaces and AI tools are increasingly influencing the assessment of consumer behavior and trademark protection globally.



TRADEMARK DILUTION AND BRAND REPUTATION

Refashioning or upcycling of luxury goods raises concerns beyond consumer confusion, particularly in relation to trademark dilution. Luxury brands derive value from their distinctiveness, exclusivity, and consistent brand image. When original products are dismantled and transformed into new items, especially for commercial sale, the mark may become disconnected from its original context. This can weaken the brand's unique identity and erode the aura of prestige carefully cultivated by the brand owner.

Trademark dilution in the context of refashioning typically manifests in two forms:

- **Dilution by Blurring:** Occurs when the distinct association between a trademark and its original good is weakened. For instance, converting a luxury handbag into multiple smaller accessories bearing the same logo may reduce the mark's singular connection with high-end handbags, thereby diminishing its exclusivity.
- **Dilution by Tarnishment:** Arises when the mark is used in a manner that harms the brand's reputation. If refashioned products are of inferior quality, poorly crafted, or presented in undesirable contexts, consumers may attribute this diminished quality to the original brand, thereby damaging its image.

Luxury brands place significant emphasis on maintaining strict control over their trademarks, product quality, and overall brand narrative. This control ensures uniformity in design, craftsmanship, and consumer experience elements central to luxury positioning. Refashioning, particularly by independent third parties, disrupts this control by introducing products that the brand has neither designed nor approved. Consequently, even well-intentioned upcycling practices may conflict with the brand's interest in preserving its *reputation, exclusivity, and perceived value* in the marketplace.

POSSIBLE LEGAL DEFENCES FOR REFASHIONING BUSINESSES

In disputes concerning the refashioning or

upcycling of luxury goods, businesses often rely on trademark law defences to argue that their activities do not amount to infringement. These defences aim to demonstrate that trademark use is either legally permissible or unlikely to mislead consumers.

The **Doctrine of First Sale (or exhaustion)** is frequently invoked. Once a trademark owner places a genuine product on the market through an authorized sale, the purchaser is generally free to resell or dispose of that item. This doctrine allows thrift stores, resale platforms, and retailers to trade in genuine branded goods such as luxury handbags, watches, clothing, or sneakers. For instance, resale platforms and stores like **VegNonVeg, Superkicks,** and **Culture Circle** sell authentic branded products that may not be directly available in India. Refashioning businesses may rely on the same principle by arguing that they lawfully acquired authentic luxury items and are merely dealing with goods already placed in the market.

Another possible defence is **nominative fair use**, which allows a person to use another's trademark where it is reasonably necessary to identify the product or to describe compatibility with it. This applies in contexts like commentary, comparative advertising, product reviews, or accessories. For example, a manufacturer of phone cases may refer to the device as an "iPhone-compatible case" to indicate compatibility without suggesting affiliation with **Apple**. Similarly, refashioning businesses may argue that mentioning the original luxury brand simply identifies the **source of the material used** not endorsement by the trademark owner.

A further defence is the use of **clear disclaimers and transparency** to prevent consumer confusion. Since trademark infringement and passing off largely depend on whether consumers are likely to be misled, explicit disclaimers can reduce confusion. Courts have recognized that clear disclosures may mitigate trademark concerns in certain circumstances. In **Calvin Klein Cosmetics Corp. v. Lenox Laboratories, Inc.**, the defendant sold a fragrance marketed as "our version of Obsession" and clearly stated that the product was **not authorized or endorsed by Calvin Klein**. The court held that such disclosures helped prevent consumer deception. Similarly, refashioning businesses



sometimes include statements such as “made from repurposed designer materials” or “not affiliated with or authorized by the original brand.” These disclaimers attempt to clarify that the modified product is not produced or endorsed by the trademark owner.

Another argument is that the modified item is a **new and independent product**, with the original luxury product merely serving as **raw material** used in the creation of a different commercial product. Refashioning businesses may contend that refashioning represents **creative transformation or upcycling**, producing a new item with a different function, design, or aesthetic identity.

However, the viability of this argument often depends on whether the trademark remains visible and continues to function as an indicator of origin. If the refashioned item prominently retains the original brand mark, consumers may still associate the product with the trademark owner, potentially leading to confusion. In such circumstances, courts may find that the transformation does not create a truly independent product but instead involves the continued commercial use of the trademark. Consequently, while “new product creation” aligns with sustainability and creative reuse, its legal success ultimately depends on whether the modification **removes the trademark’s source-identifying function** or continues to capitalize on the reputation of the original brand.

CONCLUSION

The growing practice of refashioning luxury goods sits at the intersection of **sustainability, creativity, and trademark protection**. On one hand, trademark law seeks to safeguard the reputation, goodwill, and source-identifying function of well-known brands. On the other, the secondary and refashioning markets promote **reuse, consumer autonomy, and circular fashion**, allowing products to evolve beyond their original lifecycle. Legal doctrines such as **exhaustion, nominative fair use, and the use of disclaimers** attempt to balance these competing

interests, but they also reveal the limits of traditional trademark frameworks when applied to modern resale and upcycling practices.

Ultimately, the core issue lies in determining **when transformation becomes exploitation**, whether refashioning represents a legitimate creative reuse of a lawfully purchased product, or an impermissible commercial use of a brand’s reputation. As luxury resale and customization continue to expand globally, courts will increasingly be required to reconcile intellectual property rights with emerging consumer trends and sustainability goals. In this evolving landscape, the law must carefully navigate between protecting brand identity and allowing innovation within secondary markets. The question that remains, however, is: **when a luxury product is transformed into something new, is it truly an infringement of a trademark or simply the beginning of a second life for the product?**

Cases:

1. Rolex Watch USA, Inc. v. BeckerTime LLC 91 F.4th 776 (5th Cir. 2024)
2. Kapil Wadhwa v. Samsung Electronics Co. Ltd. (2013 (53) PTC 112 (Del) (DB))
3. Rolex SA v. Alex Jewellery Pvt. Ltd. (2009 (41) PTC 284 (Del))
4. Calvin Klein Cosmetics Corp. v. Lenox Laboratories, Inc. 815 F.2d 500 (8th Cir. 1987)
5. Champion Spark Plug Co. v. Sanders, 331 U.S. 125 (1947)
6. Prestonettes, Inc. v. Coty. 264 U.S. 359 (1924)

*[**Note: Ms. Tamanna Khunteta, co-author of this article, made a significant contribution during her internship at DuxLegis Attorneys in the Trademark & Copyright Department. This article is a collaborative effort and represents one of her completed projects during her internship with the firm.]*





AIPLA WOMEN IN IP LAW COMMITTEE GLOBAL NETWORKING EVENT 2026 | BENGALURU

DuxLegis Attorneys is proud to have hosted the **AIPLA Women in IP Law Committee Global Networking Event 2026** at the prestigious Acharya Campus, Bengaluru, on April 16th — bringing together some of the finest minds in intellectual property, academia, and industry under one roof.



The event drew an exceptional gathering of IP practitioners, legal professionals, academics, researchers, and students, creating a vibrant and intellectually stimulating platform for meaningful exchange and professional connection.



We were honoured to be joined by **Prof. (Dr.) V. Lokesha** as Chief Guest and **Prof. (Dr.) C. K. Marigowda** as Guest of Honour, whose gracious hospitality and thoughtful perspectives on mentorship, innovation, and women in STEM set an inspiring tone at the event.

Our three incredible speakers stole the show: **Dr. Thriveni J.** took us through her leadership journey deeply motivating our upcoming generation in the room. **Ms. Puspita Agarwal** of Craft Delights showed us how passion, when backed by hard work, can build something truly beautiful and meaningful. **Ms. Bhavya Gangaiah** shared her story of rising from a small town to becoming a respected IP professional — the kind of story that makes you want to dream bigger.



Each speaker brought depth, authenticity, and invaluable perspective to the evening's theme: *"Rooted in Real: Women in IP Redefining the Narrative."*

DuxLegis Attorneys extends its sincere gratitude to the **American Intellectual Property Law Association (AIPLA)** and the **Women in IP Law Committee** for curating a global platform that empowers local IP communities. Our heartfelt thanks also to Acharya Campus, our esteemed speakers, and every participant who contributed to making this edition truly memorable.

The event came to a close on an uplifting note with a high tea and networking session, where participants had the chance to engage, share insights, and build valuable professional connections. It highlighted the crucial contributions of women in intellectual property, innovation, and collaboration, while



fostering a strong sense of unity and encouragement.

Overall, the Bengaluru AIPLA Women in IP Law Global Networking Event 2026, proved to be a great

success. We look forward to hosting more such platforms that promote collaboration, exchange of knowledge, and the growth of women in intellectual property and beyond, as we continue to strengthen the IP community—one meaningful conversation at a time.





IP SNIPPETS:

PATENT CASES:

NEC CORPORATION (Appellant) vs ASSISTANT CONTROLLER OF PATENTS AND DESIGNS (Respondents)

CASE NO.: C.A.(COMM.IPD-PAT) 486/2022
DECIDED ON: 28th March, 2026

The appellant filed an appeal challenging the impugned order passed by the respondent, refusing the appellant's subject application under the ground of lack of inventive step under section 2(1) (ja) of the act. The appellant argued that the subject application is not anticipated by 'prior claiming' in view of the prior arts. The appellant states that the respondent did not even apply ant test for the assessment or novelty and inventive step of the present invention. The respondent countered that the appellant failed to provide any arguments regarding 'prior claiming', and from the publication it was clear that invention was related to the subject matter of the 'prior claiming'. Also, the subject application does not have any inventive step considering the prior arts independently.

The Hon'ble Delhi High Court observed the following matter that the subject application failed to satisfy the requirement of inventive step under section 2(1) (ja) of the Patent Act, 1970. The Hon'ble Court also stated that the subject matter was obvious and had no difference in technical features when considering the prior arts. Therefore, the Hon'ble Court upheld the respondent's decision to finalize the refusal of the subject application.



PRESIDENT AND FELLOWS OF HARVARD COLLEGE (Appellant) vs CONTROLLER GENERAL OF PATENTS DESIGNS AND TRADEMARKS (Respondent)

CASE NO.: C.A.(COMM.IPD-PAT) 493/2022
DECIDED ON: 28th March, 2026

The appellant filed an appeal against the respondent for rejecting the appellant's patent application under Sections 3(j), 3(e), 10(4) and 10(5) of the Patent Act. The appellant states that the 'non-native' cells are well defined in the specification and are also novel and inventive and do not occur in nature. The appellant clarifies that the subject application solves the technical problem of the prior art and constitutes patentable subject matter, therefore is excluded from the prohibitions of section 3(j) of the Act. The respondent states that microorganisms isolated from nature cannot be considered to be patentable under section 3(c). The respondent countered that section 3(j) prohibits patentability of an animal or plant as a whole. The respondent also states that in the subject application the terminology 'native', 'non-native', and 'gene expression profile that is different' is unclear.

The Hon'ble Delhi High Court observed that the amended claims alter the nature of the claims from a composition to a non-native pancreatic β cell, and the same should have been addressed by the controller. The respondent considered the original claims while objecting to the subject application and passing an impugned order. The Hon'ble Court concluded by setting aside the impugned order and directed fresh consideration of the subject application in view of the amended claims.



SCIPHARM SARL (Appellant) vs ASSISTANT CONTROLLER OF PATENTS AND DESIGNS AND ANR (Respondents)

CASE NO.: C.A.(COMM.IPD-PAT) 159/2022
DECIDED ON: 27th March, 2026

The present appeal was filed against the respondent by the appellant for rejecting their patent application under the ground of non-patentability under Section 3 (i) of the Patents Act, 1970. The respondent stated that the deletion of original method claim referring to "obtaining the sample containing Haematopoietic



Stem Cells” was an essential part of the subject application, this essential part involves surgical method which is prohibited under section 3(i) of the Act. The respondent further states that if the appellant agrees to delete claim no. 1 of the subject application, the objection may be considered to be resolved, and the matter can be considered further with the amended set of claims.

The Hon’ble Delhi High Court examined the matter and permitted the appellant to amend the subject application by deleting claim 1 and retaining claims 2-5 for further consideration. The Hon’ble Court directs the respondent to consider the amended set of claims of the subject application and decides the matter on merits uninfluenced by any observations made in this order.



TRADEMARK CASES

DELHIVERY LIMITED (Plaintiff) vs ASHOK KUMAR AND OTHERS (Defendants)

CASE NO.: CS (COMM) 61/2026

DECIDED ON: 6th April 2026

In the present suit, the plaintiff filed an action seeking injunction against the defendants for infringement of trademark, copyright and passing off in respect of its mark “DELHIVERY / **DELHIVERY**”.

The plaintiff argued that the defendants were abusing its trademarks and proprietary materials by preparing counterfeit franchise offers, documents, emails, and domain names, and thus defrauded innocent members of the population and cashed in the goodwill and reputation of the plaintiff.

The Hon’ble Delhi High Court observed that the plaintiff had established a prima facie case, and that the balance of convenience lay in favour of the plaintiff. The Hon’ble Court also believed that such activities could not be done without restraint because it would cause irreparable harm to the goodwill and reputation of the plaintiff as well as to the general population.

As such, the Hon’ble Court granted the injunction in favour of the plaintiff and ordered the defendants not to use the mark of “DELHIVERY” in any form including in emails, domain names, franchise documents, agreements, etc. in any manner, which constituted infringement, copyright violation and passing off. The Hon’ble Court also instructed intermediaries and interested parties to reveal KYC information, close bank accounts, block telephone numbers, and shut down infringing domain names by the defendants. Thus, the interim application was allowed and injunction granted in favour of the plaintiff.



SANGEETHA CATERERS AND CONSULTANTS LLP (Plaintiff) vs M/S RASNAM FOODS PVT LTD AND OTHERS (Defendants)

CASE NO.: C.S (COMM DIV) NO. 116/ 2023

DECIDED ON: 25th March 2026

In the present suit, the plaintiff filed a suit before the Hon’ble Madras High Court seeking permanent injunction for trademark infringement and passing off, restraining use of the marks “GEETHAM”, “GEETHAM VEG / **geetham**” and “SANGEETHAM”, alleging similarity with its established marks “SANGEETHA / **Sangeetha**” and “SANGEETHA VEG RESTAURANT”. The plaintiff contended that the defendants, being former franchisees, dishonestly adopted similar marks and trade dress to mislead consumers.

The defendants argued that “GEETHAM” was independently coined, not deceptively similar, and that after modifying their trade dress and issuing public disclaimers, no confusion remained. The Hon’ble Madras High Court held that although “SANGEETHA” had acquired distinctiveness, the defendants’ mark “GEETHAM” was not deceptively similar, and thus no infringement was made out. However, the Hon’ble Court found passing off for the period between 01.06.2022 and 02.11.2023, as the defendants used identical trade dress and operated from the same premises, creating consumer confusion. Post modification of trade dress and public



clarification, no further passing off was established. Accordingly, the suit was partly decreed, granting injunction for the earlier period, directing rendition of accounts and payment of profits and costs, while dismissing remaining claims.



BARDANA SUPER HI-TECH AGRO TONIC PVT. LTD. (Plaintiff) vs AMCONS IPL (AGRO INDUSTRIAL EXPANSION) PVT. LTD. AND OTHERS (Defendants)

CASE NO.: CM/1440/2026 IN CS(OS) 1/2026
DECIDED ON: 25th March 2026

In the present suit, the plaintiff sought permanent injunction against the defendants for trademark, trade dress and copyright infringement and passing off, restraining use of the mark "SUPER AGRO-TECH" "SUPER HI-TECH AGRO TONIC" "HI-TECH AGRO TONIC" "BARDANA SUPER HI-TECH AGRO TONIC". The plaintiff alleged that it had used its marks since the 2000s, as well as a trade dress featuring a distinctive apple theme, and that the defendants had used a similar mark in a deceptively similar manner and packaged the same agricultural products, which caused confusion and diversion of trade and loss of goodwill. It has also been claimed that even after the defendants receiving legal notices, they still proceeded with the infringing acts and because of the continuous damage, immediate interim relief was necessary. Thus, they could not be excused from pre-institution mediation of the Commercial Courts Act Section 12A.

The Hon'ble High Court of Jammu and Kashmir and Ladakh noted that the case pertained to a continued infringement and repeated cause of action, and that it merited the dispensation of pre-institution mediation. The Hon'ble Court believed that the plaintiff had a prima facie case and its balance of convenience and probability of irreparable harm in case of non-relief was in favour of the plaintiff. To that end, the Hon'ble Court rejected pre-institution mediation and granted interim injunction to prevent

the defendants from using the impugned mark or any other deceptively similar trade dress as well as misrepresenting their goods as belonging to the plaintiff.



PARLE PRODUCTS PRIVATE LIMITED (Appellant) vs THE REGISTRAR OF TRADE MARKS & ANR. (Respondents)

CASE NO.: C.A.(COMM.IPD-TM) 49/2025 & I.A.19990/2025

DECIDED ON: 10th March 2026

In the present appeal, the appellant had challenged the decision of the Registrar of Trademarks granting registration of the mark "20-20" in favour of the respondent for food products. The Appellant claimed that it had commenced use of the mark prior to the respondent and, therefore, should be recognized as the rightful proprietor based on the "first in the market" principle and also asserted that the respondent's prolonged non-use amounted to abandonment of the mark.

In response, the respondent submitted that it had filed its trademark application of 27th September 2007 one week prior to the appellant's application and had diligently prosecuted the application until its eventual registration in 2025. The respondent argued that priority should be determined by earlier filing date rather than subsequent commercial use.

The Hon'ble Delhi High Court observed that both parties had applied for a trademark on a "**proposed to be used**" basis, meaning that neither had actually used the trademark at the time of filing. In such circumstances, the Hon'ble Court held that priority is to be determined by the date of application, and not by subsequent use in the market. After contradictory claims of the appellants the Hon'ble Court stated "*This is a classic case of a party approbating and reprobating at the same time. This is impermissible in law*".

Therefore, the Hon'ble Court dismissed the



Appellant's appeal and upheld the trademark registration in favour of the respondent, affirming **that earlier filing date beats later commercial use** when both parties had applied on a proposed-use basis under the Trademark Act.



COPYRIGHT CASES

PHONOGRAPHIC PERFORMANCE LIMITED (Applicant) vs LTC HOSPITALITY PRIVATE LIMITED AND OTHERS (Respondents)

CASE NO.: I.A. (L) NO. 33355 OF 2025 IN COMMERCIAL IP SUIT (L) NO. 32410/2025
DECIDED ON: 7th April 2026

In the present suit, the applicant sought injunction against the respondents for copyright infringement, restraining them from publicly performing or communicating sound recordings without obtaining a valid license. The applicant argued that the sound recordings are copyrighted by the owner and it has the exclusive right to license under Section 30 of the Copyright Act, 1957. They claimed that even after the license expiry/ non-renewal, the respondents still played the sound recordings of the applicant at their premises and used commercially, which was confirmed by a visit to their premises by a representative and affidavit evidence.

The Hon'ble Bombay High Court noted that the applicant had established a prima facie case and since the respondents had not yet appeared or rebutted the case, the evidence presented by the applicant was to be accepted at this stage. The Hon'ble Court, therefore, found that the unlawful broadcast of the applicant's copyrighted works constituted infringement and ad-interim injunction restraining the respondents against publicly performing, or communicating the sound recordings without license, and this injunction shall prevail until the next date of hearing.



HOME BOX OFFICE, INC. (Plaintiff) vs MOVIEBOX.PH & ORS. (Defendants)

CASE NO.: CS (COMM) 358/2026
DECIDED ON: 6th APRIL 2026

In the present suit, the plaintiff instituted an action seeking ex parte ad-interim injunction against the defendants for infringement of copyright, restraining them from hosting, streaming, reproducing, distributing or communicating to the public the plaintiff's cinematographic works, including the series "Euphoria" and its upcoming season.

The plaintiff argued that it had exclusive rights in the said works and that the defendant websites were rogue websites that were involved in unauthorized dissemination and piracy of the content of the plaintiff, thus causing a significant financial loss and loss of the commercial value of the said works especially at the most critical time, release. It was also argued that this infringement was systematic and it was likely to continue to grow via mirror and redirect websites.

The Hon'ble Delhi High Court observed that the plaintiff had established a prima facie case, and that the balance of convenience lay in favour of the plaintiff, as denial of relief would result in irreparable injury. In this regard, the Hon'ble Court allowed ex parte ad-interim injunction to restrain the defendants and all the related entities to infringe the plaintiff copyright. The Hon'ble Court also instructed domain name registrars to freeze infringing domains and reveal information, internet service providers to block access to such sites and allowed dynamic injunction of newly identified infringing sites. Thus, the interim application was allowed and injunction granted in favour of the plaintiff.



M/S MRT MUSIC (Plaintiff) vs PARAMVAH STUDIOS PRIVATE LIMITED & ORS (Defendants)



CASE NO.: CS(COMM) 680/2024
DECIDED ON: 28th March 2026

In the present case, plaintiff instituted suit alleging that the defendants illegally used two of its Kannada songs "NYAYA ELLIDE" and "OMME NINNANU" in the Kannada film "BACHELOR PARTY" without obtaining a license.

The plaintiff gained exclusive copyright ownership by virtue of Assignment Deed from Master Recording Company "Sangeetha" and asserted that the use by the defendant is not incidental or minimal. The defendants retaliated that the songs were used for merely 7 and 31 seconds respectively in incidental scenes, they also challenged the ownership of plaintiff and asserted that they lacked authority to issue licenses under Section 33 of the Copyright Act.

The Hon'ble Delhi High Court noted the plaintiff's prima facie ownership and affirmed that defendants had deliberately chosen the songs to further the films narrative, making the use descriptive rather than merely brief, thereby rejecting the minimal defense. It also held that Section 33 does not restrain individual copyright owners from licensing their own works. And granted an interim injunction restraining the defendants from exploiting the Original Works, while also directing to pay ₹20,00,000, which was already deposited by the defendants to remain with the Court and additional ₹5,00,000 penalty.



DESIGN CASES

NEC CORPORATION & ORS. (Appellant) vs THE CONTROLLER OF PATENTS AND DESIGNS AND ANR. (Respondent)

CASE NO.: IPDAID/21/2024, IPDAID/22/2024,
IPDAID/1/2025, IPDAID/2/2025, IPDAID/3/2025
DECIDED ON: 09th March 2026

The appellants filed multiple appeals challenging the rejection of their Graphic User Interface (GUI) design registration application by the respondent. The appeals raise a common question "**Whether the graphic user interface (GUI) satisfies the criteria of a design making it eligible for registration under the act?**"

The appellants urged that the respondent had interpreted the definitions of "Article" and "Design" narrowly. They further asserted that the word "any" preceding "industrial process" under section 2(d) makes manual, mechanical or chemical processes merely indicative and not exhaustive, encompassing electronic and digital. They argued that neither permanence nor tangibility is mandated by the statute. The respondent countered that GUIs lack physical permanence, exist only when a device is powered on, cannot be manufactured or sold independently, and already enjoy protection as artistic works under the Copyright Act making design registration unnecessary and overlapping.

The Hon'ble Court delivered a landmark Judgement highlighting that under section 2(d) of the Designs Act 2000 nowhere contains express exclusion for GUIs. Permanence is not a statutory requirement; visibility of a design during normal use suffices. "Industrial process" must be interpreted progressively to accommodate digital and electronic means. On dual protection, the Hon'ble Court clarified that the existing statutory frameworks between the Designs Act and the Copyright Act are adequate which prevents overlapping of statutes.

The Hon'ble Court ruled in favour of the appellants and set aside all orders and remanded the matters for reconsideration to the controller establishing that GUIs are registrable designs in India, assessed on a case-by-case basis.





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