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BEYOND THE SCREEN: NAVIGATING THE EMERGENCE OF METAVERSE IN INTELLECTUAL PROPERTY RIGHTS



By Ananya Sinha

Many games from the past, like *Tycoon City, New York*, allowed you to build virtual cities. This game, owned by Atari, gave you empty New York districts where you could build a lot of things and see the street come up. You could then walk the street. This game, from 2006, became highly popular and many similar games heralded the rise of a virtual world. Some of these became blockbusters and set the pace for development of virtual worlds, Metaverse is the natural progression of these games into their next phase. With advancements in technology, coming in of augmented reality, today technology can deliver a much-enhanced experience to users of such software. At the same time these new technologies throw up various challenges in the Intellectual Property Rights world.

We define the metaverse as a virtual setting that seeks to facilitate real-world activities and experiences, as well as create virtual experiences which are unique to the digital world. For example, watching a movie in a theatre with other people in a virtual environment sitting at home; attending a wedding in an avatar form, etc. are examples of how real-world activities can be experienced in the metaverse.

Metaverse is likely to provide a create-to earn offer, similar to the real world. For example, *Sandbox* and *Decentraland*, among the developers in the metaverse space, allow you to purchase digital real estate ('land'). Like in the real world, the price of these land depends on their 'location' within the platform. The purchaser can develop the land on their own or rent it out to other users.

Physical World Vs. Virtual World

The metaverse is not just another fancy term for video games, it is a whole new dimension of digital interaction. Unlike traditional games, where you are confined to a single platform, the metaverse allows you to transport virtual goods and avatars across different digital

landscapes. And it is not just about shifting spaces; it is about a persistent, ever-evolving universe that remains alive and bustling even when you are not logged in.

Take, for instance, Meta's ambitious Project Cambria. This innovative virtual headset is designed to bridge the gap between the digital and physical, translating your real-world facial expressions and eye movements into your virtual avatar's actions. It is like stepping into a 3D online world where your virtual presence is as expressive as your real one.

Virtual concerts have redefined live music experiences, with stars like Travis Scott, Ariana Grande, and Daler Mehndi performing in realms like *Fortnite* and *PartyNite*, captivating audiences in entirely new ways. Concert-goers are not just watching a performance; they are exploring dynamic, interactive scenes that offer a fresh perspective on the spectacle—be it from beside the artists or above the orchestra. This innovative approach hints at endless possibilities, potentially revolutionizing how we experience not just concerts but even operas and theatrical performances

Interplay Between IP and Metaverse

Intellectual property rights (IPR) are crucial for safeguarding ownership and use of virtual assets in the metaverse, such as music, designs, and characters. Without proper IPR protection, creators' risk having their work copied, reproduced, or stolen, potentially causing financial losses and damaging their reputations. Imagine that you are attending a wedding in the metaverse being held in a village in Punjab and a Daler-Mehndi song playing or a wedding being held in London, which has an Ed Sheeran song playing in a loop. This, although happening in the virtual world, would still be a copyright infringement on the IPR held by the artist. Therefore, ensuring robust IPR in the metaverse is essential for fostering innovation, creativity, and investment, thereby creating a fair and equitable digital environment for all participants.

A notable example is the case of GolfZone, a South Korean business that provided consumers with virtual golfing experiences by selling golf simulations of well-known golf courses. This online business endeavor led to a copyright infringement case involving the preservation of golf course designs. In a landmark decision, the Supreme Court upheld the copyright held by the physical golf course's designer, setting a crucial precedent for intellectual property issues pertaining to virtual reality.

TRADEMARK AND METAVERSE

A trademark is a symbol, design or name that a company puts on its products and that cannot be used by any other company. The emergence of metaverse was never anticipated when trademark regulation was introduced. Instead, it primarily focus on the identification and differentiation of physical goods and services that are offered for sale in the real and digital market(E-commerce).

Virtual Goods in Metaverse by brand Owners



<https://eon-media.com>

Despite the ongoing development of the concept of the metaverse as a three-dimensional immersive universe including interconnected realms, a number of companies are actively exploring the potential it holds. By offering special digital replicas of their products, or NFTs (Non-Fungible Token, like BitCoin, etc.), for sale through online games and marketplaces, brand owners have tried to engage with consumers in the metaverse. One way that brand owners are engaging with consumers in the metaverse is by partnering with pre-existing online networks to open their virtual stores. For example, **Nike** and **Roblox** worked together to create a virtual world called **Nikeland**, where visitors can play games and browse an online showroom featuring Nike shoes, apparel, and accessories. They can even claim a "free exclusive Nike cap and backpack" that they can carry around in Roblox. Several brands, including Tommy Hilfiger, Ralph Lauren, and Forever 21, have also revealed their collaborations with Roblox.



Famous K-POP group **Blackpink's** virtual avatars held a fan event on the avatar-based social media network, and 46 million users attended the event to receive digital

autographs from the group. The following month, SK Telecom launched its "**K-pop Metaverse Project**" on its augmented reality app Jump AR, which enabled fans to create their music videos based on girl group **Weekly's** music and dances.

Trademark Protection for Metaverse

There are several questions that arise as the metaverse expands and brand owners become more involved. When brand owners seeks IP protection for their virtual goods, they start with filing trademark for their virtual goods. The question that now arises is in which **NICE classification** their virtual goods belong to. Since "**Metaverse**" and "**NFTs**" are not terms that are expressly mentioned in the *NICE Classification*.

In order to register their trademark for virtual goods, brand owners primarily used the following categories: downloadable virtual goods (class 9), retail store services that feature virtual goods (class 35), entertainment services (class 41), online non-downloadable virtual goods and NFTs (class 42), and financial services that include digital tokens (class 36). However, as of right now, a footwear company that already possesses trademark rights under Class 25 in the real world must register digital shoes as a Class 9 good. This means that virtual goods are not classified in the same way as their physical counterparts, but rather under Class 9, along with software and other digital goods.

The USPTO made it quite clear in the *Yuga Labs LLC case* that virtual goods classified similarly to their physical counterparts would not be accepted. Under class 16, which deals with tangible paper items, the corporation first registered the mark **BAKC** for digital artworks under the description "*digital collectibles; digital collectables sold as non-fungible tokens.*" In its response to the application, the USPTO recommended that Yuga's goods be classified as belonging to Class 9 instead of Class 16, which is designated for items that are printed or made of paper.

The term "*digital collectibles*" is inclusive and covers an infinite number of products for which additional security is not necessary. To avoid confusion, the examiner suggested utilizing the description "*Digital collectibles like downloadable image files containing {indicate subject matter or field, e.g., trading cards, artwork, memes, sneakers, etc.} authenticated by NFTs*" in place of the original one. This would require further specification. In order to mitigate the impact of broad claims, the office requests the applicant to provide further details about the subject matter or the business field and to restrict the categorization to a specific digital commodity.

After getting your mark register in the specified **NICE Classification** you should consider licensing your IP to others in the metaverse. This provides you with additional income streams and helps ensure that your IP is used in a manner consistent with your wishes. Secondly, you should consider creating a terms of service agreement that governs the use of your IP in the metaverse. This agreement outlines the conditions under which others can use your IP and provides you with legal recourse if those conditions are violated. For example, in the case of **Bragg v. Linden Research, Inc.**, the US District Court for the Eastern District of Pennsylvania held that a user who created virtual objects within the virtual world Second Life did not own the copyright to those objects because the terms of service agreement governing the use of Second Life specified that Linden Lab, the company behind **Second Life**, owned all intellectual property created within the virtual world.

Hermès International v. Rothschild



(MetaBirkin)



(Birkin Handbag)

The legal conflict between Mason Rothschild, creator of the **MetaBirkin** NFTs, and Hermès, the French luxury brand known for the iconic **Birkin handbag**, is a landmark case in the realm of NFT and trademark law. The case set a precedent for future disputes involving trademark infringement and brand protection in the metaverse, highlighting the importance of enforcing intellectual property rights and upholding brand integrity in virtual environments.

In June 2023, a New York federal jury found Rothschild guilty of trademark infringement and cybersquatting, ruling that his digital art, which depicted Hermès' Birkin bags with colorful fur patterns, violated the brand's trademark rights. Rothschild's MetaBirkins NFTs, initially sold for \$450 each, were later traded on secondary markets for up to \$65,000, leading to Hermès seeking \$133,000 in damages.

Hermès, who introduced the Birkin bag in 1984, argued that Rothschild's work unfairly exploited its trademark and misled consumers about the source of the NFTs. Rothschild, on the other hand, defended his work as artistic expression protected by the First Amendment, comparing his case to Andy Warhol's Campbell's Soup cans. Despite Rothschild's argument that his NFTs were

commentary on luxury fashion and animal cruelty, the jury found that the work did not meet the threshold for First Amendment protection and that Rothschild's use of the **"MetaBirkin"** name was misleading.

COPYRIGHTABILITY IN METAVERSE

The **Berne Convention for the Protection of Literary and Artistic Works** mandates that the countries signatory to the convention should provide exclusive rights to authors irrespective of the medium the copyrighted work is expressed. This makes work published outside metaverse to be eligible to be protected in metaverse.



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

For instance, a digital reproduction of a painting (such as a JPEG) that is connected to an NFT is going to be regarded as a replica that the owner of the copyright has the sole authority to create or disseminate. The legal stance on the use of copyrighted works in the Metaverse is clear: participants must obtain proper permissions, either through licensing or assignment, for any copyrighted material utilized within virtual spaces.

The Indian Copyright Act, 1957(Act) give protection to computer program and software and since the metaverse is by itself a computer program/software it will enjoy the copyright protection under the Act. There are 2 types of metaverse **closed metaverse** and **open metaverse**. The platform owner in a closed metaverse is the legal proprietor of the platform and all of its components. The true difficulty lies in determining who is the rightful owner of the copyright for works produced in an open metaverse: the creators of the works themselves, whether via the avatar or another means, or the proprietors of the platform.

Under the Act, if there is not a specific contract or platform terms saying otherwise, the person who creates a work (like a piece of art or writing) automatically owns the copyright for that work. This means that if you create something, you are the legal owner of it. For open metaverse, it makes sense for them to let users keep the copyright to their own creations. By doing this, the platforms owners can avoid being held responsible for any copyright issues related to those creations.

Figuring out who owns the rights to avatars (virtual characters in games) is tricky. It is not just about who designed or programmed them, but also how users interact with and customize them. While game developers might claim they own the avatars because they built the game, players can change avatars in many ways—like changing their appearance, backstory, or accessories.

When players customize avatars and these changes are recorded, such as in videos of gameplay, these avatars can be seen as having their own creative value. So, with the right approach, avatars might be recognized as original works that can be protected by copyright.

In a landmark case, the Hangzhou Internet Court addressed the legal status of digital avatars in China. **Mofa Company**, creator of the digital avatar “**Ada**,” sued a network company for copyright infringement and unfair competition. The court ruled in favor of Mofa, requiring the Defendant to address the infringement and compensate Mofa.

The primary issues included whether digital avatars like Ada are eligible for copyright protection and whether Mofa's economic interests are safeguarded under Chinese law. The court determined that digital avatars themselves do not receive copyright or neighboring rights, as they are considered tools of creativity rather than original authors. However, the court affirmed that **Ada's image and associated videos are copyrightable**. Mofa holds the copyrights for Ada's image and the videos featuring her, thanks to the use of a real actress, Xu, who was employed by Mofa. This decision provides clarity on the protection of creative works linked to digital avatars under current copyright laws.

JURISDICTIONAL CHALLENGES

The metaverse creates complex legal issues because it crosses borders and involves various legal systems. Deciding which legal system has authority (jurisdiction) depends on factors like where marketing occurs, how users interact, and where any harmful events happen in virtual spaces. In the metaverse, it is tough to identify who is responsible for legal issues because people often hide their identities and transactions are decentralized through NFTs and cryptocurrencies. This makes it challenging to figure out which court or legal system should oversee disputes. There is a need for a clear legal framework that can protect both the rights of the IP owners and the freedom of users to create and interact with virtual objects in the metaverse.

Different legal systems oversee jurisdiction in different

ways. In the EU, for instance, the **Brussels I Regulation** focuses on where the infringer is located or where the harmful event happened. There is some criticism of using "accessibility" (where infringing material can be accessed) as a basis for jurisdiction, but it is still a relevant approach for copyright issues in the metaverse. Overall, while navigating jurisdiction in the metaverse is tricky, the EU's focus on accessibility can help copyright holders pursue legal action in member states where the infringing content is available. Balancing these jurisdictional challenges with the need to protect legal rights is crucial as metaverse commerce grows.

CONCLUSION

The Metaverse is a new digital world that is changing how we think about intellectual property (IP) rights. We are still figuring out exactly how these changes will play out, but it is clear that the Metaverse has a lot of potential and will keep evolving. This article is a starting point to understand how the Metaverse affects IP rights, showing both current issues and the need for more study and adjustment. As the Metaverse grows, it brings exciting chances for creativity and innovation, but it also comes with new risks and challenges. As such, intellectual property law must adapt and evolve coordinated with the development of virtual worlds.

- 1 Yuga Labs INC., v. Ryder Ripps, 2:23-cv-00010-APG-NJK
- 2 Hermès v. Rothschild, 22-cv-384 (JSR)
- 3 Seagull Song, Chan PuiLing, The first digital avatar case in China, KING & WOOD MALLESONS (Mar. 2, 2024, 6:42 PM), <https://www.kwm.com/cn/en/insights/latest-thinking/the-first-digital-avatar-case-in-china.html>.

TECHNICAL EFFECT TRIUMPHS: BLACKBERRY'S PATENT CLEARS SECTION 3(K) HURDLE IN INDIA



By Divyendu Verma

Earlier it was routine for Indian Patent Office to reject patent applications where it thought that a computer program based on algorithm and software did not constitute a major patentable process. It used the 3(k) provision of the patent act to reject anything that was seen as a mere software that had no technical effect. One such case that came up and the decision on it, has permanently changed how the patent office will now have to deal with such patent applications that claim technical effect. Read on.

Case: Blackberry Limited v. Controller of Patents and Designs (C.A. (COMM.IPD-PAT) 318/2022)

Court: Delhi High Court

Date of Pronouncement: 30th August 2024

Judge: Justice Pratibha M. Singh

Background: Blackberry Limited filed an appeal under Section 117A of the Indian Patents Act, 1970, against the refusal of its patent application 717/DEL/2009 for a method titled "Auto-Selection of Media Files". The Indian Patent Office had rejected the application under Section 3(k) of the Patents Act, which excludes software and algorithms as such from patentability.

Key Issues:

1. **Objection of Non-Patentability under Section 3(k):**

The Indian Patent Office argued that Blackberry's invention was primarily a computer program and lacked any technical effect, rendering it non-patentable as per Section 3(k).

2. **Blackberry's Argument:** Blackberry contended that the invention solved a technical problem by managing media content on devices based on memory availability and user preferences. They argued that this went beyond a mere algorithm and had a direct technical impact.

Court's Rationale for Rejecting Patent Office Objections: The Delhi High Court rejected the Patent Office's objections under Section 3(k) based on several grounds:

1. **Technical Effect and Contribution:** The court found that Blackberry's invention was not just a computer program but a technical solution that enhanced device functionality. By optimizing storage space and automating the selection of media files, the invention produced a concrete technical effect. The court emphasized that the invention improved user experience and device capabilities without manual intervention, which is a key factor in determining patentability under Section 3(k).
2. **Prior Art Assessment:** While the Indian Patent Office and the European Patent Office had refused similar applications based on prior art, the court differentiated Blackberry's invention from previous patents like US'765. The court noted that Blackberry's invention introduced novel features, such as the cache manager and the creation of a unified library system, which contributed to a technical advancement. These features were not present in the prior art, thereby affirming the novelty and inventive step of the patent.
3. **Impact on Device Functionality:** The court underscored that Blackberry's invention allowed devices to function autonomously with minimal user interference, thereby enhancing the operational capacity of the device. Such an enhancement went beyond mere software programming and thus qualified for patent protection.

Decision: The court directed the patent to be amended, limiting its scope to the technical features of "automatic selection" and "updating by a cache manager," while excluding abstract features. After this amendment, the patent was allowed to proceed for grant.

The Bench of Justice Pratibha M Singh held:

"Any invention which can increase the capability of a device to such an extent would not be hit by Section 3(k) of the Act. The argument of Mr. Harish V. Shankar, Id. CGSC that the rejection by the EPO ought to result in rejection of subject patent – though extremely appealing, is not tenable... This Court has independently assessed the nature of the invention and is of the opinion that the bar under Section 3(k) of the Act would apply to the subject invention."

Impact on Indian Patent Law Jurisprudence: This case marks a significant development in how Indian courts interpret Section 3(k) of the Patents Act, particularly in relation to software patents. By recognizing the technical

contribution of software-driven inventions, the court has clarified that innovations that provide a tangible technical effect or improvement in device functionality can be patentable, even if they involve algorithms or computer programs. This decision could set a precedent, encouraging more nuanced assessments of software-related patent applications in India. It may also influence the way the Indian Patent Office approaches future cases involving computer-implemented inventions, potentially leading to more grants in this field when technical effects are evident.

INDIA'S ROADMAP TO A US\$300 BILLION BIOECONOMY: BIO-RIDE SCHEME LAUNCHED BY GOI

The Indian Union Cabinet, chaired by Prime Minister of India, has approved the "Bio-RIDE" (Biotechnology Research Innovation and Entrepreneurship Development) scheme on September 18, 2024. This initiative merges two pre-existing schemes under the Department of Biotechnology (DBT) to boost research, innovation, and industrial growth in biotechnology. The scheme has a proposed outlay of INR 9,197 crore (USD 1.1 billion) for the 2021-26 period.

The key objectives of Bio-RIDE are:

- **Fostering Innovation:** It will provide grants for cutting-edge research in areas like biopharmaceuticals, bioenergy, and synthetic biology.
- **Supporting Startups:** The scheme aims to nurture bio-entrepreneurship by offering seed funding and incubation to startups.
- **Encouraging Academia-Industry Collaboration:** It will facilitate cooperation between research institutions and industries to commercialize bio-based technologies.
- **Promoting Sustainable Biomanufacturing:** Aligning with India's green goals, it will encourage environmentally friendly manufacturing practices.

Additionally, the scheme introduces a new component on Biomanufacturing and Biofoundry, in alignment with the PM's "Lifestyle for the Environment" (LiFE) initiative to address climate change and promote the bioeconomy. Bio-RIDE will also support skill development in the biotechnology sector, helping India achieve its goal of becoming a \$300 billion bioeconomy by 2030.

This ambitious initiative contributes to India's vision of "Viksit Bharat 2047" by ensuring national growth in biotechnology research, innovation, and entrepreneurship.

JAN VISHWAS (AMENDMENT OF PROVISIONS) BILL, 2023: AMENDMENTS IN THE PATENT ACT, 1970



By Priti More

The **Jan Vishwas (Amendment of Provisions) Bill, 2023** was introduced in the Indian Parliament with the goal of promoting ease of doing business by reducing the burden of compliance on businesses and citizens. The bill focuses on decriminalizing minor offenses and simplifying laws across various sectors, by converting fines from imprisonment terms for certain violations and reducing the discretionary powers of officials.

While the Jan Vishwas Bill primarily focuses on easing regulatory compliances, it also touches upon several acts across multiple sectors, including **patent laws**. One of the notable amendments under this bill relates to **The Patents Act, 1970**.

The amendments are summarized below:

Section 120

This section deals with the unauthorized claim of Patents rights, wherein if a person falsely represents that any article sold by him is patented in India or is the subject of an application for a patent in India, he will be liable to the penalty. Previously a fine which may extend to one lakh rupees was imposed, now with this amendment the penalty has been increased to ₹10 lakh, and a further penalty of ₹1,000 for every day in case of continuing claim.

Section 121

The section related to the punishment for wrongfully using the words "patent office" has been omitted.

Section 122

As per the section 122 (1) if the person fails or refuse to furnish the information to the Controller or the Central Government, the penalty which may extend to ten lakh

rupees was imposed, this amendment has further reduced the penalty to ₹1,000 for every day after the first during which such refusal or failure continues.

The offence of "furnishing false information" under Section 122(2) has been decriminalized. Previously, offenders could face imprisonment of up to six months. However, under the new provisions, offenders will now be subject to a financial penalty. This penalty will be:

- 0.5% of the total sales, turnover, or gross receipts as per the audited accounts, or
- ₹5 crore, whichever is lower.

Section 123

The amendment to Section 123 increases the penalty for practicing as an unregistered patent agent in violation of Section 129. Now, offenders can face a fine of up to ₹5 lakh. Additionally, for continued violations, a further penalty of ₹1,000 will be imposed for each day the default persists after the first day. Before the amendment, the fine for a first offence was capped at ₹1 lakh, with a maximum of ₹5 lakh for subsequent offences.

Section 124

The amendment introduces Sections 124A and 124B, which establish provisions for the adjudicating officer to conduct inquiries and impose penalties. It also outlines the procedure for appealing the officer's orders, providing a mechanism to challenge those decisions through an appeal process.

Through the amendment, two new clauses have been added to Section 159(2) after clause (xiii). These clauses empower the Central Government to make rules regarding the procedure for conducting inquiries and imposing penalties under Section 124A, as well as the form and manner for filing appeals under sub-section (2) of Section 124B.

DUXLEGIS ATTORNEYS PARTICIPATES IN INDUSTRY-ACADEMIA MEET & STARTUP-ECOSYSTEM EXPO 2024



DuxLegis Attorneys proudly took part in the **Industry-Academia Meet & Startup-Ecosystem Expo 2024**, organized by the Centre for Invention, Innovation & Incubation (CIII) Satara at YCIS, Satara on September 24, 2024. As part of this prestigious event, DuxLegis was invited to set up a booth, where we engaged with attendees to discuss the Intellectual Property Rights (IPR) ecosystem in India, with the goal of fostering a collaborative environment for academia, industry, and start-ups.

This event highlighted the importance of industry-academia collaborations, and we are grateful to CIII Satara for their efforts in bringing together stakeholders that contribute to the development of the startup ecosystem. We believe that such interactions play a key role in building strong ties between academia, industry, and the startup community, ultimately fuelling innovation and growth.

At DuxLegis, we remain committed to supporting and collaborating with CIII Satara as well as to the other institution, engineering college and university to protect and make their business successful and look forward to

future partnerships that contribute to the evolution of a thriving and innovative ecosystem. Together, we can build a more prosperous and forward-thinking future.





IP SNIPPETS:

PATENT CASES:

AXCESS LIMITED (Appellant) vs. CONTROLLER OF PATENTS AND DESIGNS (Respondent)

CASE NUMBER: C.A.(COMM.IPD-PAT) 288/2022
DECIDED ON: September 13, 2024

The current appeal has been filed by the appellant challenging the impugned order passed by the respondent regarding refusal of the appellant's patent application under Section[s] 59(1), 3(d) and 3(e) of the Patent Act. The appellant argued that the amended claims fall within the scope of the originally filed specifications and claims and therefore the respondent's conclusion regarding Section 59(1) of the Act is contrary to the facts on record. The respondent in the impugned order held that the amendments made by the appellant to a product claim is beyond the scope of the original claims and complete specification as disclosed by the appellant.

The Hon'ble Delhi High Court examined the appellant's patent application and identified that the amended claims in the latest complete specification filed by the appellant to the initial claims are well within the scope of the original PCT claims. The Hon'ble Court also states that the respondent did not consider the newly amended claims to the complete specification of the appellant. The Hon'ble Court concluded by remanding the matter back to the controller for de novo consideration and issuing a fresh hearing notice.

NIPPON STEEL CORPORATION (Appellant) vs. THE CONTROLLER GENERAL OF PATENTS, DESIGNS & TRADEMARKS & ANR. (Respondents)

CASE NUMBER: C.A.(COMM.IPD-PAT) 323/2022
DECIDED ON: August 29, 2024



NIPPON STEEL

The current appeal has been filed by the appellant against the respondents for rejecting the appellant's patent application under the ground of Section 3(d) of the Patent Act. The appellant argued that the respondent did not raise any objection w.r.t. the Section 3(d) of the Act in the hearing notice, whereas the respondents mentioned a general objection qua Section 3 of the Act, thereby failing to give appellant a fair opportunity to represent its case. The appellant further argued that the respondents failed

to analyze the technical aspect of the patent application. The respondents submit that the claimed application did not introduce any special technical impact or functional relationship, therefore patentability of the use/application falls within the scope of Section 3(d) of the Act as the "Invention not patentable".

The Hon'ble Delhi High Court observed that the respondents acknowledge the novelty and inventive step of the claims of the invention, therefore it cannot be presumed to be a "known process, machine, or apparatus" without its identification as objected by the respondents. The Hon'ble Court further states that the impugned order is unclear as how the claims of the subject application fall under Section 3(d) of the Act. The Hon'ble Court concludes to reconsider the matter afresh by granting a hearing to the appellant along with the notice by clearly delineating the objections.

NOVENCO BUILDING & INDUSTRY A/S (Plaintiff) Vs. XERO ENERGY ENGINEERING SOLUTIONS PRIVATE LTD. & ANOTHER (Defendants)

CASE NUMBER: OMP No.540 of 2024 in;
COMS No.13 of 2024
DECIDED ON: August 28, 2024

The defendants have filed an application under Order, VII, Rule 11 (C) read with Section 151 of the Civil Procedure Code praying for rejection of the plaint on the ground that the plaint is barred by law as the plaintiff was required to comply with Pre-Institution Mediation as enunciated under section 12-A (1) of the Commercial Courts Act, 2015. The plaintiff argued that the defendant no. 1 was infringing the patent and design of the plaintiff, the plaintiff had also served a cease-and-desist notice upon defendant no. 2 yet the defendants continued to infringe the patent as well as design of the plaintiff, therefore this urgency necessitated the plaintiff in filing of the suit without going for Pre-Institution Mediation And Settlement. The defendants countered that the plaintiff has bypassed the Pre-Institution Mediation And Settlement remedy and directly filed the Civil Suit even though they had enough time, which however does not issue any urgent relief and therefore the plaint is liable to be rejected.

The Hon'ble Himachal Pradesh High Court observed the following matter and did not find any urgency involved in the present suit. The Hon'ble Court further concluded by allowing the application and rejecting the plaint that the plaintiff cannot file a Civil Suit without restoring to the Pre-Institution Mediation And Settlement.

HENDRICKSON USA, L.L.C. (Appellant) vs. THE CONTROLLER OF PATENTS AND DESIGNS (Respondent)

CASE NUMBER: CMA(PT)/37/2023
DECIDED ON: August 27, 2024



The present appeal has been filed by the appellant against the respondent for rejecting the appellant's patent application under novelty and inventive step ground. The appellant argued that none of the cited prior arts D1-D3 discloses peening of areas beyond the stress affected zone or heat affected zones (HAZ) as in the appellant's patent application. The respondent countered that welding and shot peening are part of common general knowledge which is also disclosed in the prior arts and that the claimed invention does not satisfy the twin requirements of technical advance and non-obviousness under Section 2(1)(ja) of the Patents Act, 1970.

The Hon'ble Madras High Court remands the matter for limited purpose of examining whether the claimed invention qualifies as an invention under the Patents Act in view of undertaking peening beyond the boundary of stress concentration. The Hon'ble Court concludes by examining the matter afresh by the different officer and providing a reasonable opportunity to the appellant.

BRISTOL-MYERS SQUIBB HOLDINGS IRELAND (Plaintiff) vs. M SWARNALATHA & ORS (Defendant)

CASE NUMBER: IA No. GA-COM/1/2024
In IPDPTA/5/2024
DECIDED ON: August 05, 2024

The present suit has been filed by the plaintiff against the defendants for restraining infringement of plaintiff's Indian Patent No. IN 203937 that claims and covers dasatinib. The Court had previously restricted defendant no. 1-3 from infringing plaintiff's patent (i.e., a product dasatinib) till the expiry of the term of the patent, yet the defendant no. 5-7 manufactured and released the dasatinib product in the Indian market. The plaintiff submits that defendant no. 7 has connection with the other defendants and even after valid services defendant no 7 did not appear before the court which terms that he is guilty of launching the infringing product. The defendant no 1-3, 5 and 6 submits that they have not used infringing product commercially during the subsistent of the patent of the plaintiff and also denies having any connection with the defendant no. 7.

The Hon'ble Delhi High Court noted that the defendant no 1-3, 5 and 6 did not launch any dasatinib containing product till the expiry of the suit patent, whereas the defendant no. 7 had launched the impugned product under the brand name DASA SPL. The Hon'ble Court concluded by imposing the cost of Rs. 5,00,000/- against the defendant no. 7 in favour of DHCBA Employee Welfare Fund.

TRADEMARK CASES:

ADIDAS AG (Plaintiff) vs MOHD. IRFAN (Defendant)

CASE NUMBER.- CS (Comm.) No. 198/2023 CNR No. DLSH01-002377-2023
DECIDED ON - September 11, 2024

The plaintiff filed suit against the defendant for trademark infringement, passing off, and copyright violations. In this case, the plaintiff, which operates under the trademark





"adidas," etc. alleges that the defendant is unlawfully selling products bearing similar marks that are confusingly similar to the plaintiff's trademarks, thereby infringing on their rights and misleading consumers. The plaintiff conducted a market survey that revealed the defendant was selling these counterfeits. The defendant argued that the products seized did not belong to him and that the plaintiff's claims were baseless. The Hon'ble Delhi District Court found discrepancies, noting that significant details related to damages were only mentioned in the affidavit, not in the plaint. The plaintiff's valuation of Rs. 5,00,000 for trademark infringement was deemed insufficient, leading to the decision that the suit was not properly valued. The original infringing products was not produced in court, weaken the plaintiff's claims. The Hon'ble Court concluded that the plaintiff failed to prove the infringement due to the lack of original products and supporting evidence. Consequently, all claims were denied, leading to the dismissal of the suit without any awarded relief, and no costs were assigned.

GUJARAT CO-OPERATIVE MILK MARKETING FEDERATION LTD & ANR. (Plaintiffs) vs TERRE PRIMITIVE & ORS. (Defendants)


CASE NUMBER. - CS(COMM) 768/2024 & I.A. Nos. 38737/2024, 38738/2024 & 38739/2024
DECIDED ON - September 09, 2024


The Plaintiffs filed a suit against defendant no. 1, an Italian company, for using trademark deceptively


similar to . The plaintiffs argue that defendant no. 1's marks, 'Amuleti' /  and similar variations, are likely to confuse consumers and harm the well-known 'AMUL' brand, which has been in use since 1958. The defendant contends that their use of the mark is distinct and not intended to mislead. However, the Hon'ble Delhi High Court observed that the similarities between the marks could confuse consumers and dilute the plaintiffs' brand reputation. The Hon'ble Court granted an injunction favoring the plaintiffs, restraining the defendant from using the impugned marks, and ordered the removal of related online content and materials.

AMBA SHAKTI STEELS LTD. (Appellant) vs SEQUENCE FERRO PRIVATE LIMITED (Respondent)

CASE NO. - FAO (COMM) 41/2024 & CM No.12834/2024
DECIDED ON - September 03, 2024

In the present case, the appellant filed an appeal challenging an order passed by the learned Commercial Court. The appellant sought to restrain the respondent from using the trademark “” The appellant

contended that given the visual and phonetical similarities between both marks “ and


 would mislead the customers into thinking that appellant product is associated with respondent product. The appellant has used and promoted its mark for a very long time and has established strong goodwill in the market. The Hon'ble Delhi High Court, by allowing the appeal, set aside the Commercial Court's order. The Hon'ble Court granted the interim injunction, restraining the respondent from using the “AMMAJI” mark or any deceptively similar trademark until the final disposal of the suit. The Court ruled that the appellant had established a *prima facie* case of potential confusion among consumers, which would harm the appellant's goodwill.

VISHESH FILMS PRIVATE LIMITED (Plaintiff) vs SUPER CASSETTES INDUSTRIES LIMITED (Defendant)

CASE NUMBER - CS(COMM) 68/2024, I.A. 1797/2024, I.A. 3979/2024
DECIDED ON - September 02, 2024

The plaintiff filed the suit against the defendant for violating their proprietary rights in the renowned film franchise “Aashiqui,” and also assert the right over the trademarks “Aashiqui,”


“Aashiqui Ke Liye,” 

and . The Plaintiff argued that their rights in the well-known Aashiqui film franchise were being violated by the defendant. The defendant also applied to register the title “Tu Hi Aashiqui,” gives the perception that the new film was part of the franchise, leading to inevitable confusion and a violation of plaintiff trademark rights. The Hon'ble Delhi High Court has restrained defendant from using titles “Tu Hi Aashiqui,” “Tu Hi Aashiqui Hai” and “Aashiqui” in respect of an upcoming film. The Hon'ble Court said that plaintiff mark “Aashiqui” is registered under the Trade Marks Act, 1999 and that it is crucial to protect titles of expressive works that become part of a series and have the potential of acquiring distinctiveness. The Hon'ble Court said that the “Aashiqui” title is not just an instance of isolated use, but rather, has become part of a recognized film series, with two successful instalments released in 1990 and 2013.

VIVO MOBILE COMMUNICATION CO LTD. (Plaintiff) vs MR JITENDRA KUMAR TIWARI TRADING AS MAA VAISHNAVI CHEMICALS (Defendant)

CASE NUMBER - CS(COMM) 510/2021
DECIDED ON - August 29, 2024

The present suit was filed by the plaintiff seeking permanent injunction restraining the infringement of its registered trademark  against the

defendant. The plaintiff argued that the defendant mark  does not only have identical word element 'VIVO' but also have the identical and deceptively similar font, color, manner of writing etc. and the plaintiff has been using its “VIVO” marks continuously, extensively and uninterruptedly in respect of its products and/or related services. The Hon'ble Delhi High Court observed that the plaintiff had prior and continuous use of the mark “VIVO” and that the defendant mark was deceptively similar, causing consumer confusion and can also result in dilution of the 'VIVO' mark. Accordingly, the decree of permanent injunction was passed in favor of the plaintiff.

MOUNT EVEREST BREWERIES LIMITED (Appellant/Petitioner) vs EXCISE COMMISSIONER MADHYA PRADESH AND OTHERS (Respondents)

CASE NUMBER - WRIT APPEAL No. 1852 of 2024
DECIDED ON - August 27, 2024



(Respondent's label)



(Appellant's label)

The petitioner filed a writ appeal challenging the order of Excise Commissioner and the order passed in writ petition No.3110 of 2023. The Appellant/petitioner argued that the respondent registered label “VASCO 60000 EXTRA STRONG BEAR” is similar and based on the artistic label of the petitioner brand “MOUNT 6000 SUPER STRONG BEER”. The respondent dishonestly copied the entire label, even the 6000 numeral artistic features. The Hon'ble Indore High Court observed that the red colour background, black strip, and unique colour combination of golden, red and brown colour and especially the words “6000” used by the respondent is exactly the same and deceptive to the registered label of the petitioner. The Hon'ble Court was of the opinion that there is similarity and resemblance between the label of petitioner and respondent. Therefore, the Hon'ble court allowed the writ appeal and set aside the order of Excise Commissioner, and the order passed in writ petition No. 3110 of 2023.

**DKH RETAIL LIMITED (Plaintiff)
vs MR. JAY (Defendant)**




CASE NUMBER - CS Comm 4418/21
DECIDED ON - August 27, 2024

The plaintiff filed a suit against the defendant for infringement of trademark and copyright, seeking a permanent injunction, damages, and destruction of counterfeit goods. The plaintiff, known for its brand 'SUPERDRY' 極度乾燥(しなさい) **Superdry** claimed

that the defendant was distributing goods bearing falsified 'SUPERDRY' trademarks, leading to confusion and damage to the brand's reputation. The plaintiff contended that defendant's products were substandard and counterfeit, which could harm its market presence. Defendant, however, did not appear in court or respond to the claims. The Hon'ble Delhi District Court observed that defendant's use of the 'SUPERDRY' mark was indeed infringing and confusingly similar to the plaintiff's registered trademarks. The Hon'ble Court decreed in favor of the plaintiff, granting a permanent injunction against defendant, ordering the destruction of seized counterfeit goods, and awarding damages of Rs. 3,00,000.

CASTROL LIMITED (Plaintiff) vs MOTOGULF INDIA PRIVATE LIMITED & ORS. (Defendants)

CASE NUMBER - CS(COMM) 900/2023 & I.A. 25474/2023, I.A. 3217/2024, I.A. 7020/2024
DECIDED ON - August 23, 2024

The present suit was filed by the plaintiff seeking permanent and mandatory injunction to restrain the defendant from using the mark  in its word as well as device form. The plaintiff argued that the defendant has copied the overall colour combination and structural scheme of plaintiff's  mark. The plaintiff had no objection to the use of the word mark 'COASTAL' however the defendant shall not be allowed to use the device mark. The Hon'ble Delhi High Court on the basis of plaintiff contention and defendant agreeing to not use the mark “  issued permanent injunction in favor of the plaintiff. As the defendant were found to be carrying infringing activities, the Hon'ble Court ordered the defendant to pay a cost of ₹3,00,000/- to the plaintiff.

G.D. PHARMACEUTICALS PRIVATE LIMITED (Plaintiff) vs M/S CENTO PRODUCTS (INDIA) (Defendant)

CASE NUMBER - CS(COMM) 53/2019 & I.A. 2215/2021
DECIDED ON - August 07, 2024



(Defendant's label)



(Plaintiff's label)

The plaintiff filed a suit against the defendant for infringement of trademark and copyright, seeking a permanent injunction, damages etc., against the defendant. The plaintiff argues that the defendant has adopted the mark “BOROBEAUTY,” which is used and represented in a manner which is deceptively similar to plaintiff's use of its registered trade mark “BOROLINE.” **The plaintiff also pleaded for the mark to be declared “well-known.”** The defendant offered to change its trade dress and share his intent to not even use the prefix 'BORO.' Accordingly, the Hon'ble Delhi High Court issued a decree of permanent injunction in favor of the plaintiff and directed the defendant to change its trade dress and trademark. The Hon'ble Court is also of the view that the plaintiff's trademark qualifies as a well-known mark due its extensive and uninterrupted use. The Hon'ble Court ordered the defendant to pay a cost of ₹2,00,000/- to the plaintiff.



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