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MADRAS HIGH COURT CLARIFIES THE EXPRESSION “DIAGNOSTIC” FOR APPLICABILITY OF SECTION 3(i)



Priti More



Sahana Mabian

CMA (PT) No. 14 of 2023 & CMP Np. 16669 of 2023
Decided on: October 12, 2023

**1. The Chinese University of Hong Kong &
2. SEQUENOM, INC. (Appellants) vs.
The Assistant Controller of Patents & Designs
(Respondent)**

INTRODUCTION:

In the present case the Madras High Court has passed an order in the matter of *The Chinese University of Hong Kong & SEQUENOM, INC. (Appellants) vs. The Assistant Controller of Patents & Designs (Respondent)*, examining if the claimed invention titled “Fetal Genomic Analysis From a Maternal Biological Sample” is eligible to be barred under section 3(i), considering that the invention is related to the diagnostic method.

BACKGROUND:

The appellant had filed an Indian patent application no. 4812/CHENP/2012 ('IN4812'), claiming the priority from multiple U.S. provisional applications. The appellants received the First Examination Report with multiple objections including objections under section 2(1)(j), 2(1)(ja), 3(i) and 10(5) of the patent act 1970 to which the appellant filed a response by deleting original claims 1-33 and thereby submitting amended set of claims 1-12. Further the hearing was scheduled where the appellant contended that the determination of the foetal fraction does not diagnose a disease, and hence the claimed invention is not a diagnostic method, to fall under non-patentable invention under section 3 (i) of Patent Act. The respondent examined the applicability of section 3 (i) to the application 'IN4812' and then concluded that the amended claims 1-12 cannot be patented under section 3(i) of the Patent Act because the claims of the said invention

qualify as a diagnostic method as it discloses a process of diagnosing a foetus suffering from genetic or other diseases.

CONTENTIONS BY THE APPELLANT:

The learned counsel had provided the following contentions on behalf of the appellant:

- The appellant submitted that the purpose of section 3(I) is to prevent grant of patent to the methods of diagnosis, i.e., performed by medical doctors on the patients thereby ensuring to adopt the best method of diagnosis and treatment. The appellant argued that the section 3(i) should confined the term “diagnostic” to “in vivo” diagnosis and does not encompass “in vitro” diagnosis methods.
- The appellant further referred to their previous communication with the Indian Permanent Mission which clearly indicates that the only diagnostic method that is practiced on the human body will be patient ineligible, therefore the term 'diagnostic' in section 3(i) should be constructed as limited to diagnostic method practiced on human body for the purpose of rendering them free of disease.
- The appellant had also placed reliance on Manual of Patent Practice and Procedure which states that “*methods of diagnosis practiced on the human and animal body is not patentable*”, simultaneously highlighting that the diagnosis undertaken “in vitro” as in 'IN4812' is patent eligible.
- The appellant submitted that the present invention, 'IN4812', carries out “in vitro” analysis of fragments of nucleic acid molecules taken from a biological sample containing both the foetal and maternal DNA, and the determination of the foetal fraction by following the process set out in the amended claims which includes using a computer programme and also the claimed invention is a non-invasive prenatal screening test (NIPT) which does not cover pathology.
- The appellant contended that the expression 'diagnostic' is applicable only if all the four method steps in diagnosis are carried out as relied upon order of the Enlarged Board of Appeal (the EBoA) in case No.G 0001/04 (the EBoA opinion). The Four method steps are as:

- (i) the examination phase involving the collection of data,
- (ii) the comparison of such data with standard/reference values,
- (iii) the finding of any significant deviation, i.e. a symptom, during the comparison, and
- (iv) the attribution of the deviation to a particular clinical picture, i.e. the deductive medical or veterinary decision phase.

The appellant, by referring to the impugned order of section 3(i) and the Manual of Practice and Procedure of the Patent Office, states that the claimed invention 'IN 4812' does not include clinical diagnosis i.e., the four method step out, therefore 'IN4812' is eligible to grant patent.

CONTENTIONS BY THE RESPONDENT:

- In response to the appellant, the respondent stated that nowhere in section 3(i) indicates that the diagnostic process should be limited to “in vivo” diagnosis and the parliament would have at least mentioned the exclusion of “in vitro” diagnosis from the section 3 (i) if they ever intended to do so.
- The respondent further argued that EBoA opinion of including all four method steps in the process of diagnosis is not binding on this Court as every method step involved in the process of diagnosis qualifies as a diagnostic method under Section 3(i).
- Following all the reasons, the respondent concludes that the claimed invention 'IN4812' cannot be granted under section 3(i).

COURT'S ANALYSIS:

Construction of Section 3(i):

SECTION 3(i): any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.

The above section 3(i) contains two limbs;

- (a) any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment of human beings; or
- (b) any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.

The first limb (a) deals with the human being and the second limb (b) deals with the animals. The second limb specifically address about treatment of animals to increase their economic values, which cannot be applicable for human beings and therefore both the limbs are distinct and self-contained and are also separated by the disjunctive 'or'. Correspondingly the contentions of the word 'diagnostic' in the first limb being confined to the treatment of human beings to render them free of disease (i.e., in second limb) is also rejected. Additionally, the word 'treatment' in the first limb should intended to be construed widely.

Expression “DIAGNOSTIC” in Section 3(i):

In medical science diagnosis is a method of identifying the existence or non-existence of disease, disorder or conditions, such identifications cannot be construed as a form of treatment. Further, the expression “any process for the diagnostic treatment of human beings” do not make complete sense unlike other forms of expressions like medicinal, surgical, curative, prophylactic, therapeutic i.e., dealt in the section 3(i) and also the word “process” at the beginning of the first limb is not compatible with the proposed word “methods” as both of them are similar in certain ways.

The expression “diagnostic” should not be construed in isolation rather it should be considered in association with the accompanying words/expressions of section 3(i) when read as a whole. The expression diagnostic should be confined to diagnostic processes that disclose pathology for the treatment of human beings.

The article 27(3)(a) of the **TRIPS** (Trade-Related Aspects of Intellectual Property Rights) Agreement clearly indicates that the diagnostic method should be for the treatment of humans or animals, but no further limitation or restriction is observed in the expression “diagnostic methods”.

The patent office manuals had placed narrow interpretation on section 3(i), the draft and final manual of 2005 clearly exclude patent eligibility only in respect of “in vivo” diagnostic methods. Further the 2019 manual differently defines the diagnostic methods as identifying the nature of the medical illness by investigating history and symptoms and by applying test, the 2019 manual also provided several examples for exclusion under section 3(i). The 2013 guidelines are also in identical language. The manuals of the patent office are basically an indicative of the manner of how the patent office has understood the provisions.

The Enlarged Board of Appeal (EBoA) prescribes the four method step test for assessing if the claimed invention

involves a diagnostic method to be patent ineligible. In “*in vivo*” diagnosis by devices i.e., especially performed under the supervision or consultations with doctors for example MRI, ultrasound etc., encompasses all four method steps, whereas “*in vitro*” the diagnosis method can be carried out without the supervision or consultation with doctors (which does not cover all the four method steps) and further the deductive phase is undertaken by the doctor. The claimed invention 'IN4812' would not be diagnostic for the purpose of section 3(i), if the process does not cover pathology.

SCREENING AND DIAGNOSIS:

There is a vast distinction between screening and diagnosis in medical literature. If the screening test identifies the existence or non-existence of a disease, disorder or condition subject to confirmation of the diagnostic test would qualify as “diagnostic” for the purpose of section 3(I).

Further if the person skilled in the art would not be in a position to diagnose the disease, disorder or condition, as the case may be on the basis of the process because the process is not designed to diagnose diseases, disorders or conditions, such process, whether labelled as screening or anything else, would not qualify as diagnostic for purposes of Section 3(i) of the Act.

ANALYZING THE PATENTIBILITY OF THE CLAIMED INVENTION

The Hon'ble Madras High Court examined the amended claims 1-9 of 'IN4812' submitted by the appellant and stated that the claimed invention 'IN4812' identifies the foetal fraction and as per medical literature the foetal fraction should not be less than 4% to enable further testing to identify chromosomal aberrations, so until that specific stage is attained, the pathology is not uncovered, nor is any treatment possible, rather IN4812 just provides an indicator for such testing. The Hon'ble Court further stated that the determination of foetal fraction is related to diagnosis but is not “diagnostic”. The Hon'ble Court rejects the objection under section 3(i) as untenable and proceeds the application 'IN4812' with amended set of claims 1-12 for grant.

CONCLUSION:

Perusing through all the above matters, the Hon'ble Madras High Court acknowledged the inconsistency in granting patent to “*in vitro*” process by the Patent Office. Further, the Hon'ble Court considers supporting the inventors in such cutting edges areas without compromising on the public policy exclusion from patent eligibility and also suggested restricting the scope of the expression “diagnostic” in section 3(i) to “*in vivo*” process.

As after the amendments of claims, the only objection was on the basis of section 3(i), which has been cleared, therefore the Hon'ble Court ordered the following application 'IN4812' to proceed for grant with the amended claims 1-12.

TRADEMARK DILUTION: A POTENTIAL THREAT



-By Krutarth Sontakke

A trademark plays a crucial role in Brand Building, as it is the only face of the products or services and also reflects the quality of the product and services. It also creates a distinct image of a brand among the market so that an individual can differentiate the brand from the other competitors. It takes years of hard work and consistency to provide quality products and services which creates and maintains the reputation of that brand among the businesses. There are several risks that could damage a trademark reputation or an overall brand, includes – Passing off, Infringement, and Dilution of trademark.

The concept of trademark Dilution has gone through centuries, it was argued that “trademark protection should not be limited to addressing issues related to the deception of the public but should extend to preventing people from destroying the originality and uniqueness of the mark” as said by the renowned author Frank Schechter also known as the '*Father of Dilution*'. Trademark dilution is recognized and forbidden by Section 29(4) of the Act. It declares that any use of a mark that is identical to or similar to a registered trademark constitutes infringement and dilutes the original mark's distinctiveness.

The trademark dilution occurs when an unauthorized party uses a trademark in a manner that would tarnish or diminish the image of a well-known trademark. Trademark dilution deals with the weakening or diminishing of a famous mark's unique identity even if the consumer does not confuse the two products or services. There are 2 types of Trademark dilution which includes – Blurring and Tarnishing.

Blurring takes place whenever a well-known mark loses its distinctiveness or uniqueness as a result of duplicated marks that appear to be identical to the well-known mark, regardless of whether the products or services are similar.

When a third party uses a mark, it will blur the possibility that the mark will particularly function as a identifier of owner's product or services only and may hinders owners

ability to sell. For instance, if a business uses the “Amul” mark on a shoe, consumers may begin to associate the well-known “Amul” mark with the footwear brand. This may negatively impact on Amul's brand image.

Unauthorized use of well-known trademarks can cause **tarnishing** by seriously harming the brand reputation. Providing ill-quality product or services under the well-known trademark. For instance, “Bisleri”, which is one of the leading brands of packaged drinking water, its brand has been tarnished by so many other deceptively similar brands like Bilsleri, Bilseir, Bisferi, Bislari, etc. Each of these counterfeit uses colours and label styles of the original and passes itself off as the original. The consumer buys such counterfeit products thinking that they are buying the original only to be disappointed later. As these counterfeits have nothing at stake, any quality of water can be passed off as the original, hurting the reputation of the original via substandard quality, with the user not even being able to comprehend that he was deceived at the time of purchase itself.



There are a few exceptions where the infringing mark would not be considered as a dilution. This includes situations where advertising or promotional activities that allow consumers of a brand to compare goods or services are permitted and will not be actionable as trademark dilution. Such cases may fall under the ambit of descriptive or nominative fair use and hence, cannot be considered trademark dilution. In addition, marks are used to criticize, parody, news reporting, commentary, educational, and entertainment purposes.

An interesting example of trademark dilution can be seen in the case of **Dumb Starbucks**. In the case of Dumb Starbucks, the use of the word “dumb” in conjunction with the Starbucks brand could be considered tarnishment if Starbucks could prove that the prank harmed its reputation or associated the brand with inferior products.

Since the prank was for marketing purposes, the usual "non-commercial use" defense wouldn't apply, as the setup was ultimately revealed to be an advertising stunt funded by Viacom for Comedy Central. This case highlights how trademark dilution can impact even well-known brands through public perception, especially when the trademark is used in a way that could harm the brand's image.

NOTORIOUS CASES ON DILUTION OF TRADEMARK IN INDIA:

1. BMW v DMW:

According to the Court, the defendant has used the key aspects of the plaintiff's mark. There is a significant visual and linguistic resemblance. The trademark was being dishonestly used in respect of similar goods and thus, resulting in passing off and free riding. As a result, the defendant's mark DMW is likely to deceive and cause confusion, establishing a case of dilution.

2. BATA INDIA PRIVATE LIMITED VS PYARELAL:

In this case, the plaintiff initiated a dilution case against the defendant. The legal issue centered on, whether the defendant's use of the mark "Batafoam" constituted dilution, thereby disparaging upon the plaintiff's recognized trademark "Bata". Even though the defendants focused on a different product, it still harms the reputation and goodwill of plaintiff's mark. Hence the injunction was granted.

In conclusion, a brand may suffer from trademark dilution just as much as it would from trademark infringement. Trademark dilution rights are somewhat less well-known than infringement, yet they can nonetheless be enforced just as severely, if not more so, to safeguard a brand's distinctiveness. Gaining an understanding of trademark dilution can be challenging but important for businesses, how it occurs, and ways to prevent it. By registering trademarks, tracking their use, and going to court can prevent trademark dilution and also protect their reputation and goodwill.

AROHAN-2024: DELIVERED LECTURE ON IP CAREER INSIGHTS FOR STEMM GRADUATES



Mr. Divyendu Verma, the Global Head of IP Patents, Audiri Vox, recently taken an insightful lecture on career opportunities in Intellectual Property (IP) for graduates from STEMM (Science, Technology, Engineering, Mathematics, and Medicine) in the AROHAN-2024 webinar organized by Directorate of Collegiate and Technical Education under the Higher Education Department of the Government of Karnataka.

AROHAN-2024 is an educational initiative organized by the **government engineering colleges**, showcasing commitment to excellence in education and innovative practices. The program consists of a series of lectures and seminars aimed at exposing students to the latest trends, challenges, and opportunities in various technical fields. The Arohan-2024 program features expert speakers from diverse areas such as intellectual property law, artificial intelligence, core engineering disciplines, and mechanical engineering. The objective is to provide students with insights into emerging career pathways, industry trends, and the importance of innovation in today's economy.

The Lecture aimed to shed light on the diverse and dynamic career paths available within the IP sector, specifically for individuals with a strong technical background. The Lecture also delved into various career paths, from working in law firms to in-house roles at tech companies, startups, and research institutions. Attendees were introduced to the roles of patent agents, IP consultants, and even non-legal roles such as technology transfer officers. Our Managing Partner Adv. Divyendu Verma emphasized that the demand for IP professionals, especially those with technical expertise, is on the rise as companies across industries seek to safeguard their innovations.

Overall, the lecture provided a comprehensive overview of how STEMM graduates can build a rewarding and impactful career in IP, contributing to the innovation ecosystem while expanding their professional horizons.

CONDUCTED SESSION ON CAREER OPPORTUNITIES IN INTELLECTUAL PROPERTY



Adv. Divyendu Verma, the Managing Partner of DuxLegis Attorneys, visited two esteemed institutions in Karnataka, and conducted an insightful session on career opportunities in Intellectual Property (IP) for graduates from STEMM (Science, Technology, Engineering, Mathematics, and Medicine): **The Mangalore Institute of Technology and Engineering (MITE), Mangalore on September 28, 2024** and **The Acharya Institute of Technology (AIT), Bangalore on September 28, 2024**. The session aimed to shed light on the diverse and dynamic career paths available within the IP sector, specifically for individuals with a strong technical background.

In today's knowledge-driven economy, the protection of intellectual assets is critical, and those with a STEMM background are uniquely positioned to contribute to this field. The session highlighted how professionals in these fields can leverage their technical expertise in the IP world, particularly in areas like patent, trademark, and IP portfolio management. These professionals often play a key role in identifying innovative technologies and helping companies to protect IP assets through patents,

trademarks, and other forms of intellectual property rights.

The session also delved into various career paths, from working in law firms to in-house roles at tech companies, startups, and research institutions. Attendees were introduced to the roles of patent agents, IP consultants, and even non-legal roles such as technology transfer officers. Our Managing Partner Adv. Divyendu Verma elaborated on the problem-solution approach, demonstrating how this method is applied in legal, technical, and everyday contexts to break down and solve complex challenges and emphasized on the demand for IP professionals, especially those with technical expertise, is on the rise as companies across industries seek to safeguard their innovations.

Overall, the session provided a comprehensive overview of how STEMM graduates can build a rewarding and impactful career in IP, contributing to the innovation ecosystem while expanding their professional horizons.



IP SNIPPETS:

PATENT CASES:

KYTAB LIMITED (Appellant) vs. THE ASSISTANT CONTROLLER OF PATENTS & DESIGNS (Respondent)

CASE NO.: (T) CMA(PT). No.200 of 2023
[OA/SR.118/2020/PT/CHN]
DECIDED ON: 26 September 2024

The present appeal has been filed by the appellant against the respondent for rejecting the appellant's patent application under Section 3(i) of the Patent Act. The appellant argued that the claimed invention discloses a process for the generation in non-human mammals of antibodies that comprise a human immunoglobulin variable region and further provides non-human animal models for the generation of such antibodies, therefore it does not fall within the scope of the Section 3(i). The respondent countered that the claimed invention is not in respect of specific bodies but rather discloses a method of administering antigens in transgenic mice, that qualifies as a method of treatment of animals, which is patent ineligible under section 3(i).

The Hon'ble Madras High Court observed the following issue and stated that the claimed invention does not intend to treat the mice or to increase the economic value, rather it intends to generate non-murine antibodies, which does not qualify as products of mice. The Hon'ble Court further concluded by rejecting the impugned order objecting the appellant's patent application under section 3(i) and hence proceeded the patent application for grant.

BIOTYX MEDICAL (SHENZHEN) CO. LTD (Appellant) vs. ASSISTANT CONTROLLER OF PATENTS AND DESIGN (Respondent)

CASE NO.: (C.A.(COMM.IPD-PAT) 403/2022
DECIDED ON: 20 September 2024

The present appeal is issued by the appellant against the respondent for refusing the appellant's patent application under Sections 2(1)(j), 13(1)(b) and 2(1)(ja) of the Act. The appellant argued that the cited prior arts were irrelevant and the reasons were unclear on how the cited prior arts can be combined to provide a clear identifiable and actionable roadmap to motivate a PSITA to reliably arrive at the appellant's patent application (i.e., present invention). The respondent defended that the sufficient reasons have been provided for refusing appellant patent application qua inventive step under section 2(1)(ja).

The Hon'ble Delhi High Court analysed that the respondent failed to refer to the five-step test promulgated by the Hon'ble Division Bench of this Court in *Hoffmann-La Roche Ltd. & Anr.* (supra) while examining the inventive step in the present application. The Hon'ble Court further states that the impugned order lacks a proper methodology and insufficient scientific reasoning, thereby highlighting the need of more detailed and reasoned analysis of the inventive step. The Hon'ble Court concluded by remanding the appellant's patent application for limited consideration of the inventive step and clearly specifying/analysing the inventive step before granting hearing to the appellant.

GENMAB A/S (Appellant) vs. THE ASSISTANT CONTROLLER OF PATENTS AND DESIGNS (Respondent)

CASE NO.: (T) CMA(PT). No.134 of 2023
[OA/01/2017/PT/CHN]
DECIDED ON: 06 March 2024

The current appeal has been filed by the appellant challenging the impugned order passed by the respondent regarding that the antibody claimed in the appellant's patent application is the discovery of a naturally existing molecules/substance, therefore the patent is ineligible under Section 3(c) of the Patents Act. The appellant contended that only the products i.e., directly isolated from nature are patent ineligible under Section 3(c), whereas any genetically modified microorganisms or nucleic acid having novelty, inventive step and industrial applicability cannot be excluded from patent eligibility. The respondent contended back that the claimed invention is in respect of antibodies which occurs in nature and therefore the claimed invention is not patent eligible under Section 3(c) of the Patents Act.

The Hon'ble Madras High Court found that the impugned order passed by the respondent under section 3(c) and lack of inventive step cannot be sustained and are overruled. The Court concluded that a synthetic version of a rarely occurring substance may not be excluded from patent eligibility, subject to meeting the non-obviousness and other patentability criteria. Hence, the Hon'ble Court directed to proceed towards granting the claimed invention on the basis of the submitted claims during written submission and by refile the claims after renumbering.

DESIGN CASE

1.MR. R. ARUN; 2. MR. M. DINESH; 3. M/S. ESPOIRS SOLUTIONS (Petitioners) Vs. 1. M/S.INTEGRAY HEALTH CARE PRIVATE LIMITED; 2. Mr. Vijayakumar Irusappan; 3.Mr.Sabrinathan Irusappan; 4.The Deputy Controller of Patents & Designs (Respondent)

CASE NUMBER: OP (PT) NO.2 OF 2024 & (PT) A. NO.2 OF 2024
DECIDED ON: 02 August 2024

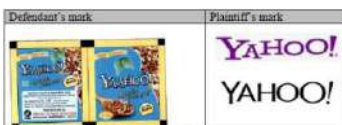
In the present case, the petitioner has filed an original petition under Section 19 read with Section 4 of the Designs Act, 2000, to cancel the registration of the first respondent which was granted by the fourth respondent. The petitioner submitted that, originally the Design office was only in kolkata but presently it is in Chennai as well, and both the petitioner and the respondent are in Chennai, so it would be improper and unfair to direct petitioner to go to kolkata for cancellation of the Design in the present case. The respondent submitted that the Court cannot act as a Controller and decide on cancellation of registration of the Design, therefore the original petition should be dismissed as not being maintainable.

The Hon'ble Madras High Court observed and stated that the original petition filed before this Court is not maintainable and that the petitioner has to approach Controller having jurisdiction and canvass all its objections there. The Hon'ble Court dismissed the Original petition, granting liberty to the petitioner to move the jurisdictional Controller.

TRADEMARK CASES:

YAHOO INC. (Plaintiff) Vs OMKAR COTTAGE INDUSTRIES (Defendant)

CASE NO. - CS(COMM) 909/2022 & I.A. No. 7654/2024
DECIDED ON - October 23, 2024



The present suit has been filed seeking permanent injunction against the defendant for using the trademark “YAAHOO! Mouth Freshner”. The plaintiff has used the trademark “YAHOO!” continuously since 1994 and has also been recognized as a well-known mark by the Hon'ble Court. The ‘YAHOO!’ trademarks have been used by the plaintiff in connection with a wide variety of goods and services. The defendant claimed that they had been using the mark “YAAHOO! Mouth Freshner” for their mouth freshener product for the last 9 years. The Hon'ble Delhi High Court noted that

the plaintiff's trademarks have been used by the defendant in a deceptively similar manner. The use of the “YAAHOO!” trademark by the defendant is a violation of the plaintiff's exclusive rights on their trademark. By doing so, the defendant is piggy back riding on the goodwill and reputation of the plaintiff. The defendant's dishonesty and mala fide intention are shown by the fact that it has used the infringing trademark even after the Trademark Registry rejected its trademark application for it. Thus, suit is decreed in favour of the plaintiff.

M/S ABBOTT GMBH (Appellant) Vs REGISTRAR OF TRADEMARKS & ANR (Respondents)

CASE NO. - C.A.(COMM.IPD-TM) 9/2023
DECIDED ON - October 22, 2024

In the present suit the appellant the proprietor of the trademark “BRUFEN,” opposed the registration of the mark “MEBUFEN” by the respondent No. 2, asserting potential confusion because of the similarities between the two marks. The Registrar of Trademarks denied appellant opposition, leading to this appeal. Appellant argued that “MEBUFEN” and “BRUFEN” are deceptively similar and may confuse consumers, as both marks relate to pain relief products containing ibuprofen. Respondent No. 2 countered that “BRUFEN” and “MEBUFEN” differ structurally, visually, and phonetically, sharing only the suffix “FEN,” which derives from “ibuprofen” and is commonly used in pharmaceutical trademarks. The Hon'ble Delhi High Court found no structural or phonetic similarity between “BRUFEN” and “MEBUFEN,” noting the distinct prefixes “BRU” and “MEBU.” The Hon'ble Court concluded there was no likelihood of confusion and dismissed the appeal, upholding the Registrar's order.

DHARMA PRODUCTION PRIVATE LIMITED (Appellant) vs BHALLARAM CHOUDHARY (Respondent)

CASE NO. - D.B. Civil Misc. Appeal No.2784/2024
DECIDED ON - October 10, 2024

In the present case, the appellant filed an appeal against the order dated October 8, 2024, where an *ad interim injunction* was issued against appellant, preventing the release of their film "Jigra" in response to a trademark infringement claim by the respondent, who alleged violation of his registered trademark rights related to education and entertainment. The appellant contended that they had obtained trademark registration for "Jigra" and argued that naming a movie does not constitute a trademark violation since they are not trading in goods or services under that name. On the contrary, the respondent maintained that his trademark rights would be infringed if

the film were released, as it could adversely affect his business interests.

The Hon'ble Jodhpur High Court observed that *prima facie*, the name "Jigra" does not infringe upon the respondent's trademark rights, emphasizing that Dharma Production is not engaged in any trade associated with that name. It was noted that any potential violation could be remedied through monetary compensation if necessary. Consequently, the Hon'ble court stayed the operation of the injunction order until the next hearing.

MASTER ENTERPRISES PVT LTD. (Petitioner) vs JAY KAY COIR FOAM PVT LTD (Defendant)

CASE NO. - CS(COMM) 698/2023
DECIDED ON - October 08, 2024

The plaintiff filed a suit against the defendants for permanent injunction against trademarks and copyright infringement. The plaintiff sought protection against the defendants' use of the mark 'POWRNYM', which it argued was confusingly similar to its registered trademarks 'NIMYLE' and 'JOR-POWR'. The plaintiff argued that it had acquired exclusive rights to the trademarks 'NIMYLE' and 'JOR-POWR' through several agreements and had invested significantly in promoting these marks. It contended that the defendants' use of the mark 'POWRNYM' constituted confusion among consumers.

The Hon'ble Delhi High Court observed that the plaintiff had established a *prima facie* case for an *ex-parte ad interim injunction*. The Hon'ble Court noted that the defendants had knowingly adopted the mark 'POWRNYM' after assigning their rights in the 'NIMYLE' and 'JOR-POWR' trademarks to the plaintiff. The Hon'ble Court emphasized that allowing the defendants to continue using the impugned mark would likely cause irreparable harm to the plaintiff and create confusion in the minds of consumers.

KOTESHWAR CHEMFOOD INDUSTRIES PVT. LTD. (Petitioner) vs SACHDEVA AND SONS INDUSTRIES PVT. LTD. AND ANR. (Respondents)

CASE NO. - C.O. (COMM.IPD-TM) 375/2021
DECIDED ON - September 17, 2024

The present petition was filed by the petitioner against respondent no.1 seeking the rectification/cancellation of the trademark "PRIME". The petitioner claims that the trademark is deceptively similar to their trademark "PRIME," which they have used for iodized salt. The petitioner contended that he has been using the trademark "PRIME" since 1995 and has built significant goodwill and the registration of respondent no.1's mark is invalid.

The Hon'ble Delhi High Court noted that respondent no.1 failed to appear in court despite being aware of the proceedings. The mark "PRIME" creates a likelihood of confusion among consumers due to the similarity and the overlapping nature of goods. The Hon'ble Court emphasized that a layperson's perception of the marks is critical in assessing similarity and potential confusion. Thus, the Hon'ble Court ordered the rectification of respondent no.1's trademark registration for "PRIME" to delete any registration pertaining to salt and spices.

MERRYVALE LIMITED (Plaintiff) vs JOHN DOE AND ORS (Defendants)

CASE NO. - CS(COMM) 678/2024
DECIDED ON - August 12, 2024

In the present suit, the plaintiff filed a suit against the defendants for using the mark 'BETWAY' without permission. The plaintiff sought to restrain the defendants from using the mark, alleging that they misrepresent themselves as associated with the plaintiff to deceive consumers. The plaintiff argued their extensive global presence and marketing efforts, highlighting the registration of the 'BETWAY' trademark and the emergence of websites misleadingly claiming to be successors of the plaintiff. The defendants, however, contended that their use of the mark was permissible.

The Hon'ble Delhi High Court observed that the defendants' use of the 'BETWAY' trademark was likely to cause confusion among consumers, posing a risk of irreparable harm. Thus, the Hon'ble Court issued an *ex parte interim injunction*, restraining the defendants from using the 'BETWAY' mark or any similar variations, ruling in favor of the plaintiff.

HIMALAYA WELLNESS COMPANY & ORS. (Plaintiffs) vs WIPRO ENTERPRISES PRIVATE LIMITED (Defendant)

CASE NO. - CS(COMM) 118/2023 & I.A. 4329/2023
(O-XXVI R-4, 9 & 10 of (CPC), I.A. 4330/2023 (O-XI R-1(6) of CC Act)
DECIDED ON - July 12, 2023

In the present suit, the plaintiffs, renowned manufacturers of ayurvedic products since 1930, filed suit against the defendant for permanent injunction, alleging infringement of their registered trademark 'EVECARE'. They claimed the defendant's similar mark, used for feminine hygiene products, causes confusion in the market. The plaintiffs emphasized their longstanding goodwill and extensive use of the 'EVECARE' mark in pharmaceutical preparations, contrasting it with the defendant's relatively new entry in the cosmetic sector. The

defendant contended that their mark was adopted bona fide, following a trademark search indicating no conflicts. The Hon'ble Delhi High Court observed a *prima facie* case of passing off in favor of the plaintiffs, highlighting the significant market presence and prior use of plaintiffs product compared to the defendant's recent launch. The Hon'ble Court restrained the defendant and all associated parties from using the mark 'EVECARE' or any deceptively similar marks, thus ruling in favor of the plaintiffs.

COPYRIGHT CASES:

**SAGA MUSIC PRIVATE LIMITED (Plaintiff) As
KARMA ENTERTAINMENT (Defendant)**

CASE NO. - CS(COMM) 174/2022 & I.A. 4429/2022
DECIDED ON - October 01, 2024

The plaintiff filed a suit against the defendant. The defendant signed two Content Assignment Agreements, assigning all rights, including copyright, of two sound recordings, "Black Suit" and "Suit Lahore Da," to the plaintiff for a consideration of Rs. 24,50,000 and Rs. 16,50,000, respectively. The plaintiff paid Rs. 25,76,000 royalties in advance, but the defendant failed to deliver the content, breaching the agreement. The plaintiff claimed ownership of the sound recordings due to the Assignment Agreements, asserting copyright infringement by the defendant's failure to deliver. Despite reminders, the defendant neither delivered the content nor contested the suit in court. The Hon'ble Delhi High Court ruled in favor of the plaintiff, affirming their copyright ownership and issuing a permanent injunction against the defendant to prevent copyright infringement. The court also ordered the defendant to refund the advance payment of Rs. 25,76,000 with 12% interest and awarded Rs. 3,00,000 in costs to the plaintiff.

**R. C. PLASTO TANKS AND PIPES PVT. LTD.
(Appellant) vs GANESH GOURI INDUSTRIES &
ANR (Respondents)**

CASE NO. - RFA(OS)(IPD) 1/2023,
CM Nos.39/2023, 40/2023 & 42/2023
DECIDED ON - August 05, 2024

The appellant, a company dealing in water storage tanks under the "Plasto" trademark, sought removal of the respondent's copyright registration for a label titled



"Gauri Aqua Plast" arguing that it was deceptively similar to its own "

PLASTO label. The respondent, also in the water tank business, had previously agreed in a Hon'ble Nagpur Court settlement not to use marks deceptively similar to "Plasto" or the appellant's Tagline "PLASTO HAI TOH GUARANTEE HAI." The appellant argued that the respondent's label resembled their own in design and color, violating the earlier settlement and infringing on their copyright. The respondent countered that the labels were distinct and that their label's elements, such as the 'Aqua Plast' prefix and unique graphical features, differentiated it from the appellant's label. The Hon'ble Delhi High Court upheld the prior decision, finding that the labels were not identical, with the only common element being the word "PLAST," which is derived from "plastic." The Hon'ble Court ruled that the Copyright Act protects expressions of ideas, not generic elements like color or shape, and dismissed the appeal, affirming the respondent's label as sufficiently distinct.



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