



In This Issue

- TRADEMARK PRELIMINARY SEARCH – STRATEGY FOR TRADEMARK REGISTRATION
- CALCUTTA HIGH COURT PUBLISHED INTELLECTUAL PROPERTY RIGHTS DIVISION RULES AIMING TOWARDS DEVELOPMENT
- DUXLEGIS ATTORNEYS ATTENDED AIPPI ANNUAL CONGRESS 2024 IN HANGZHOU, CHINA
- DELIVERED A SESSION AS A KEYNOTE SPEAKER AT THE ANNUAL INTERNATIONAL CONFERENCE ON IPR IN GOA
- DUXLEGIS ATTORNEYS ATTENDED APAA ANNUAL MEETING 2024 IN MANILA, PHILIPPINES
- IP SNIPPETS

TRADEMARK PRELIMINARY SEARCH – STRATEGY FOR TRADEMARK REGISTRATION



- By Krutarth Sontakke

INTRODUCTION:

This article focuses on the most undervalued yet crucial part of the trademark registration process. Various business owners overlook this step of trademark preliminary search during the process and take risk of refusal of trademark application and opposition. As a trademark attorney, we suggest each of our clients to complete this step, some people take suggestions seriously and avoid jumping into the pool of risks and their trademark gets successfully registered.

Trademark Preliminary search or Clearance search plays a vital role while creating and building a brand. It starts before the announcement of the brand name; this ensures the use of the brand shall not be disputed on the basis of its name. It further ensures the smooth prosecution and registration process of a trademark.

BRAND CREATION AND IMPORTANCE OF SEARCH

In the ever-growing competition and evolving marketplace, it has become difficult for businesses to create a place for themselves. Branding is the tool which helps a business to differentiate itself from its competitors and create goodwill in the marketplace. A brand can be defined as a name, symbol or an imagery used by businesses to distinguish their products and services from other businesses. The brand name is an intangible asset of a business which attaches value to the products and services of it. While deciding the brand name/logo, one must go through the process of preliminary search of that brand name/logo to avoid unwanted compliance and risk of litigation. This applies not only to trademarks but also to the domain name. Most business enthusiasts often check

trademark or brand name availability but forget to check domain names. Hence it is necessary to conduct thorough search on the proposed brand name and its associated elements which eventually are going to affect its own brand identity.

Let's understand the best-case scenario to conduct the clearance search. Assume that "Provitics" is a proposed brand name with a creative logo. The mark/business owner must first search for the mark on their own and hire an expert/specialist and discuss the background, story, or idea behind choosing the mark along with the specifics of the goods and services and potential future expansion of the company under the proposed mark. This gives the expert an overall understanding of the mark and its existing offerings as well as potential future offerings. The lawyer will therefore conduct a general internet search, followed by searches for domain names, trademarks, government registrations and international domains. Last but not the least, the expert will utilize their own resources to determine whether the proposed mark or any mark that is similar to it is conducting business in the market or online with the same services. This is not the end of it. The lawyers and specialists evaluate the results appropriately, provide search reports, and offer comprehensive reviews of any legal and compliance issues. It allows the mark owner to make an informed choice about whether or not to adopt the suggested mark. Many a times, the brand owner may have a thought of a brand that is phonetically similar to an existing brand, if he goes ahead with such a brand, he may face problems later. Thus the legal team does work beyond the call of just searching for a brand, it will also advise you on such pitfalls that can happen due to similar looking, similar sounding brand names and brand marks.

IMPORTANCE OF SEARCH IN TRADEMARK REGISTRATION PROCESS

A brand can be identified primarily on Name and its Logo. The registration of trademarks has significant power and rights within it. The trademark protection is perpetual, and it is also important to make a note that the trademark has to be renewed every 10 years otherwise it lapses automatically. The trademark preliminary search is the first stage of the prosecution. This stage determines the existence of objectionable marks already on the trademark register as well as marks pending for registration.

For conducting trademark preliminary search, it is important to identify the class of the trademark with respect to its goods and services. There is an international system used to standardize framework for categorizing products and services worldwide. There are a total of 45 classes of trademarks out of which class 1-34 are for the Goods-based trademarks and class 35 to 45 are for service-based trademarks. It ensures that your trademark is protected under specific Goods or services. It also avoids conflicts with existing trademarks and ensures smooth compliance with international trade policies and quality standards.

Upon identification of appropriate classes, one can move ahead for preliminary search which is available at official website of IP India. The search for wordmark is conducted to determine deceptively similar, phonetically similar to the prior applied/registered trademarks. The WIPO established the Vienna Classification which originated from the Vienna Agreement (1973), to simplify the worldwide trademark search for unregistered/proposed logo trademarks. It is a standardized system that reduces the redundancy of trademark applications and provides codes for graphic/figurative elements under Vienna Codification which makes the logo search easy.



The traditional website of conducting clearance search has very limited scope. It was known as public search (can be accessible at

<https://tmrsearch.ipindia.gov.in/tmrpublicsearch/>).

Recently, On September 18, 2024, the Hon'ble Union Minister of Commerce and Industry introduced Trademark Search Technology powered by artificial intelligence (AI) and machine learning (ML) can be accessible at

https://tmsearch.ipindia.gov.in/ords/r/tisa/trademark_search/dpiit-public-search. The key feature of Trademark Search Technology involves precise trademark identification with the help of advanced AI and ML, streamlining search processes for Indian and international business, and enhance protection capabilities for trademarks in a short time frame.

ADVANTAGES OF CONDUCTING SEARCH

Mentioned below are reasons why conducting a trademark search is of paramount importance:

1. **Legal Compliance:** A commitment to legal norms and regulations is frequently necessary for trademark registration. A thorough trademark search ensure that your trademark registration complies fully with all applicable legal frameworks and assists you in navigating the intricate details of intellectual property law.
2. **Avoiding conflict:** Registering a trademark without doing a thorough search is risky. Unconsciously infringing an existing trademark can lead to legal disputes, costly lawsuits, and damage to your brand's reputation. Trademark searches can help you identify potential conflicts and take steps to avoid them.
3. **Preserving Your Brand Identity:** A vital part of your brand identity is your trademark. It is your company's intellectual and visual expression. You may make sure that your brand identification is distinct and shielded from infringement or misuse by performing a worldwide trademark search.
4. **Brand Reputation:** The trademark that has been registered improves brand recognition. It encourages customers that your goods and services are authentic and that your company is a credible and reliable option. Customer loyalty and trust are increased as a result of this recognition.
5. **Competitive Advantage:** Possessing a registered trademark gives you a clear edge over competitors in a crowded industry. It distinguishes you from rivals who might not have made this essential measure. Being unique can improve your market position and draw in more consumers.

A trademark search is a crucial and significant step for any company, not just a formality. It gives you the information and defence you need to handle an aggressive business environment, safeguard your brand identity, and maintain legal compliance. The first and most important stage in creating a powerful and distinctive brand is committing the necessary time and energy to performing a trademark search.

RISKS SCENARIOS IF NOT CONDUCTED SEARCH

As we have seen that trademark searches are an important part of all stages of having a mark, the risks of failing to undertake them arise at each level. In summary, the three primary hazards of failing to do a thorough trademark search are the **refusal to register a new mark, infringements of your existing mark, and eventual revocation of an existing mark**. If you want to register a new mark, a trademark search will show you whether there are any rival marks that may clash with yours. Failure to do a proper search at this point may indicate that you are unaware of a significantly comparable pre-existing

registered trademark, resulting in your mark's refusal to be registered.

In order to be aware of possible infringements in the form of strikingly similar marks, searches are also required during the period of any currently registered trademarks. Potentially infringing competitor marks may evade detection if a trademark search is not carried out correctly with relation to monitoring your current marks. In addition to reducing your brand's exclusivity, failing to fully recognize potentially infringing marks can have a major negative impact on your brand's financial and commercial performance.

Another risk of not performing a thorough trademark search is revocation. Your mark may be subject to later revocation if it turns out that an earlier pre-existing mark existed, especially if a trademark search was done improperly or not at all before registration and your mark was registered. Thus, these searches should be carried out as soon as necessary because the risks of a delayed trademark search can occur at any point during a trademark's existence.

CONCLUSION:

A trademark search is a vital stage for individuals and businesses looking to secure their brand identity and ensure legal compliance. It involves thorough research to identify existing trademarks that may conflict with the one you intend to register. This process not only helps prevent costly legal disputes and brand confusion but also serves as the foundation for building a strong and distinctive brand. Whether done independently or with the help of legal experts, a trademark search is a vital tool in the competitive business world, particularly when contemplating global expansion. Investing in this process allows you to safeguard your brand, gain a competitive advantage, and lay the groundwork for a successful and distinct brand identity.

CALCUTTA HIGH COURT PUBLISHED INTELLECTUAL PROPERTY RIGHTS DIVISION RULES AIMING TOWARDS DEVELOPMENT



-By Sahana Mabian

Following to the Delhi High Court and Madras High Court, the Calcutta High Court has also published the rules in the Official Gazette called as "*The Intellectual Property Rights Division Rules of the High Court at Calcutta, 2023*" to deal with the matters relating to Intellectual Property Rights (IP/IPR) subject matter. Although the Calcutta Intellectual Property Rights Division (IPD) Rules have many similarities when compared with the Delhi and Madras IPD rules yet there are few notable differences. Initially draft rules were published by the High Court at Calcutta and after incorporating a few changes the finalized version of IPD Rules were published. This Intellectual Property Division (IPD) Rules made by the Calcutta High Court are according to the section 129 of the Code of Civil Procedure, 1908 and Clause 37 of the Letters Patent, 1865 and the powers conferred under the various Intellectual Property Statutes and also as amended by the Tribunal Reform Act 2021.

ESTABLISHING INTELLECTUAL PROPERTY DIVISION:

The Calcutta High Court has also established a separate Intellectual Property Rights Division (IPRD) having two or more benches consisting of single judges and Intellectual Property Rights Appellate Division (IPRAD) having one or more benches and comprising two judges, which shall handle Intellectual Property subject matter i.e., transferred from the Division Bench. Hence, the Calcutta High Court has built an assorted approach for handling appeals, i.e., the IPRAD shall hear all appeals against the orders that are passed by the IPRD unlike the Delhi and Madras High Court having expectations for matters that are reserved for the Division Bench under the Section 13 of the Commercial Courts Act, 2015.

SPECIAL PROVISIONS FOR IPR PROCEEDINGS:

- All the IP related subject matter suits and/or proceedings, including appeals, will be transferred to the IPRD and IPRAD which and will be renumbered by the IPD Department in accordance with Schedule I to the rules, accordingly the list and subsequently the warning list shall be prepared and published every week from the effective date. The IPRD shall proceed with the matter from the stage at which it was transferred and accordingly consider the matter by passing off necessary directions.
- On the first day listing the IPRD may prescribe a new timeline or issue further directions as may be necessary for a speedy and efficacious disposal of such proceedings.
- All IP subject matter proceeding or any other matters of writ petition, revision petition and review petition pending on the effective date shall be transferred to the IPRD and IPRAD, all the matters are renumbered as per Schedule I by the Department. The same shall be filed and heard by the IPRD and IPRAD after the effective date.
- All the applications and appeals mentioned under Rule 2(a) should be in accordance with the forms as prescribed in Schedule II to the respective rules along with all the evidence/documents. For most of the IP related matters the reply time is approximately between 45 days-90 days for applications under the Patents Act 1970, Protection of Plant Varieties and Farmers' Rights Act, 2001, and Semiconductor Integrated Circuit Layout Design Act, 2000 as per Calcutta IPD rule 12(g), thereby maintaining flexibility in reply time of the IP matters, whereas the Delhi IPD rules provide a timeline of 60 days for reply or also as directed by the Court and the Madras IPD rules has a timeline of 30 days or as per the Court order for response.
- As per rule 15 (a) the pleadings/documents should be filed electronically in a PDF format with enablement of Optical Character Recognition (OCR) as per Rule 15 (a).
- Following the High Court at Calcutta Commercial Courts Practice Direction, 2021, the timeline for serving the copy of the pleading should be at least four working days before the date fixed for listing of the proceedings while the Delhi IPD rules direct to serve the copy at least two working days before the listing.

THIRD PARTY INTERVENTION:

Anybody who is interested in proceeding before IPRD or IPRAD can apply under rule 20(a) to intervene and/or be impleaded stating the nature of its interest, accordingly the IPRD or IPRAD may refuse or grant such leave after the

hearing. The pleadings and documents that are required to be filed in such cases must be supplied within 48 hours after a written request is received or within the time i.e., fixed by the IPRD or IPRAD, such timelines are not specifically mentioned in Delhi or Madras IPD rules.

TRANSLATIONS AND TRANSLITERATIONS:

All the documents must necessarily be in English language when used in proceeding before the IPRD or the IPRAD as the cases shall be received by the Department, unless when accompanied with the English translation that is certified by the translator of the Court as per rule 26 (a) or when a translation is generated using an online software can also be filed carrying the possibility that such online translation can be rejected if found inaccurate by the opposite/other party as per rule 26(b).

COURT FEES:

Even though most of the fee's structure notified in Delhi and Madras IPD rules are similar to the Calcutta IPD rules yet there are a few changes that are to be highlighted:

- For an appeal against the decisions from the Trademark registry under section 91 the Calcutta IPD rules has mandated a Court fees of INR 5,000 whereas the Delhi and Madras has imposed a Higher fees of INR 10,000.
- For a Petition or Complaints filed under Section 19A of the Copyright Act, 1957 with respect to assignment of the Copyright Act, the Calcutta IPD rules have a Court fees of INR 10,000 whereas the Delhi has a lower fees of INR 5,000.
- Also, for a Petition or Application under Section 27 of the Geographical Indications of Goods (Registration and Protection) Act, 1999, the Calcutta IPD rules have higher fees of INR 10,000 in comparison with the Delhi and Madras having fees of INR 5,000.
- Additionally, the Calcutta IPD rules have specified a fees for the Semiconductor and Integrated Circuits Layout Act and also Information Technology Act, i.e., INR 10,000 for Petition/Application and INR 5,000 for appeal, which is not disclosed in the Delhi and Madras IPD rules.

CONCLUSION

The Calcutta IPD rules have addressed specialized features on IP subject matters by imbibing efficient resolutions and extending/managing timelines as per the identified issues. The IPD rules have also provided accessibility and reasonable accommodation for people with disabilities for the purpose of participating in proceedings before the IPRD or the IPRAD. The Calcutta IPD rules have also impacted on the overall process/ procedures of handling the IP subject matter, thereby developing and enhancing IPD rules.

DUXLEGIS ATTORNEYS ATTENDED AIPPI ANNUAL CONGRESS 2024 IN HANGZHOU, CHINA

From October 19-22, 2024, Team DuxLegis, led by our Global Head of Patents Practice, Adv. Divyendu Verma, along with Mr. Chandra Kant, Director of Business Development at DuxLegis, had the privilege of attending the AIPPI (International Association for the Protection of Intellectual Property) Annual Congress held in Hangzhou, China. This prestigious event brought together thought leaders, experts, and professionals from around the world to discuss the most pressing challenges and innovations shaping the field of intellectual property.



This year's congress placed significant emphasis on the transformative role of **Artificial Intelligence (AI)** within the IP landscape. Key sessions explored AI's potential to revolutionize patent examination, copyright management, and trademark enforcement, sparking engaging discussions on the ethical, legal, and regulatory complexities posed by AI. In particular, the congress addressed how AI intersects with data protection and privacy laws, fuelling conversations on creating frameworks that balance technological innovation with robust legal safeguards.

Following the AIPPI Annual Congress, DuxLegis was honoured to be invited to a local event organized by leading Chinese firms, with support from UNIDO and the Chinese government. This half-day conference offered a unique platform for collaboration, and our Global Head of Patents, Adv. Divyendu Verma, shared his insights on the IP ecosystem in India and Data Privacy Law in India. The event was extraordinary, and we were thrilled to contribute to the conversations on IP laws, furthering cross-regional dialogue and understanding.



This recent trip to China has undoubtedly been one of our most memorable, highlighting the importance of global collaboration and staying informed on the latest technological and policy shifts in IP. We are excited to bring the insights gained back to our team and clients, reinforcing our commitment to navigating the evolving IP landscape.



DELIVERED A SESSION AS A KEYNOTE SPEAKER AT THE ANNUAL INTERNATIONAL CONFERENCE ON IPR IN GOA

Ms. Priti More, Associate Partner and Head of the Patent-Life Science Department at DuxLegis Attorneys, recently served as an esteemed keynote speaker at the 9th Annual International Conference on IPR and Professional Development Program. The event, organized by the Goa Centre for Excellence in Intellectual Property (G-CEIP) in collaboration with Goa College of Pharmacy (GCP), took place on November 12-13, 2024, at the New Durbar Hall, Raj Bhavan, Dona Paula.



This year's conference, themed *"Sustainable Prosperity: Role of IPR,"* brought together expertise from leading domestic and international pharmaceutical industries alongside academic professionals from pharmaceutical colleges. The platform facilitated a vibrant exchange of knowledge between industrial leaders and researchers, fostering collaboration and innovation in the field.



Ms. Priti More delivered a thought-provoking session on the topic *"Challenges to Patentability of Pharmaceutical Inventions in India"* at the conference. She highlighted the key obstacles faced by inventors and pharmaceutical companies, both domestic and international, in securing patents for their innovations in India.

Drawing on positive judgments from various High Courts, Ms. More provided actionable strategies and practical guidelines for overcoming these challenges. Her insightful presentation resonated strongly with the audience and was highly appreciated for its depth and clarity.

DUXLEGIS ATTORNEYS ATTENDED APAA ANNUAL MEETING 2024 IN MANILA, PHILIPPINES

The team of DuxLegis had an honor of participating in the 76th Council Meeting of the Asian Patent Attorneys Association (APAA 2024) held in the dynamic city of Manila, Philippines from November 18-21, 2024. Our Managing Partner, Adv. Divyendu Verma, and Associate Partner, Ms. Priti More, has represented the firm in this esteemed gathering which brought together intellectual property professionals from across the Asia-Pacific region and beyond, providing an invaluable platform for exchanging insights, fostering collaborations, and building stronger networks.



As a member of copyright standing committee, Mr. Divyendu has provided valuable insights about the recent copyright matters decided by the Indian Courts. The copyright committee members had significance discussion on the topic “Generative AI and Copyright Infringement” where the committee members have engaging dialogues on Generative AI Inputs in Training Data and Copyright Infringement; AI-Generated Outputs and Copyright Concerns. The Committee has explored several questions, such as the circumstances under which training AI models using datasets infringes copyright, whether utilizing copyrighted works from a single owner for machine learning (ML) constitutes infringement, and how the inclusion of copyrighted works from multiple owners affects the legality of AI training processes.



On exploring the charms of Old Manila, the team had an elegant evening of fine dining, introducing the Indian cuisines to our small group of foreign friends and colleagues.



Connecting with a diverse group of delegates, including international observers, and reconnecting with friends and foreign affiliates made the experience truly enriching and rewarding. The event was a success, featuring engaging academic sessions, interactive workshops, and insightful roundtable discussions.





IP SNIPPETS:

PATENT CASES:

COMVIVA TECHNOLOGIES LIMITED (Appellant) vs ASSISTANT CONTROLLER OF PATENTS & DESIGN (Respondents)

CASE NO. C.A.(COMM.IPD-PAT) 492/2022
DECIDED ON: November 12, 2024



The current appeal has been filed by the appellant against the respondent for refusing the appellant's patent application under section 3(k) of the Patent Act. The appellant submitted that the respondent failed to appreciate the 'technical effect' or 'technical contribution' of the computer-related invention even though such inventions are patentable, also the proposed invention is the technical process to secure authentication. The respondent counter argued that the appellant's invention falls under 'business method' which is not patentable under section 3(k) of the Patent Act and also the authentication process in the invention is considered as financial activity which is also not patentable as per clause 4.5.2 of the Guidelines for Examination of Computer Related Inventions, 2016.

The Hon'ble Delhi High Court observed that the appellant's patent application was wrongfully refused by the respondent under section 3(k) of the Patent Act claiming to fall into category of 'business method' and 'computer programme per se'. The Hon'ble Court stated that the invention provides a technical solution to a technical problem, specifically enhancing the security of electronic payment transactions and thus setting aside the impugned order and by proceeding the appellant's patent application for grant.

IDEMIA IDENTITY & SECURITY FRANCE (Appellant) vs 1. THE CONTROLLER GENERAL OF PATENTS AND 2. ASSISTANT CONTROLLER OF PATENTS & DESIGNS (Respondents)

CASE NO. (T) CMA (PT) NO.198 of 2023 and (T) CMP (PT) NO.21 OF 2023
DECIDED ON: November 12, 2024



The present appeal has been filed by the appellant against the order passed by the

respondent refusing the grant the appellant's patent application under section 3(k) of the Patent Act. The appellant submitted that the said invention involves technical contribution and therefore is patentable. The respondent counter argued that the appellant's invention has adopted 'mathematical formula' and 'business method' which cannot be patentable as per section 3(k) of the Patent Act.

The Hon'ble Madras High Court observed that the respondents did not consider the contentions presented by the appellant regarding the technical contributions of the appellant's invention and its practical application and the respondents also failed to consider that the invention is not based on a set of rules and not an algorithm and the Court further observed that the order is a non-speaking order. The Hon'ble Court concluded by remanding the matter back for fresh consideration by considering the observation that has been set out in this judgement.

REGENERON PHARMACEUTICALS, INC (Appellant) VS CONTROLLER OF PATENTS AND DESIGNS. (Respondents)

CASE NO. (T)CMA(PT) NO.191 of 2023
DECIDED ON: October 22, 2024

The applicant has filed an appeal against the respondent challenging the rejection of the appellant's patent application under section 59 and section 3(b) of the Patent Act. The appellant argued that the patent application specifying genetic modification is for the benefit for mankind, therefore it cannot be rejected under section 3(b). The appellant also submitted that the amendments of claims were based on the specification and the substances that have already been disclosed. The respondent argued that no material was submitted pertaining benefit to mankind by genetic modulation, also the amendments made by the appellant falls within the mischief of section 59.

The Hon'ble Madras High Court rejected the respondent's objection under section 59 to reject the appellant's claim as the respondent had only considered original claim and the amended claim not including the complete specification. Further the Hon'ble Court rejected the respondent's reasoning on questioning benefit to mankind as this reasoning is against the respondent's own statement of facts. The Hon'ble Court concluded by directing the respondent to reconsider the appellant's patent application and to provide a reasonable opportunity to the appellant.

COPYRIGHT CASE

ANI MEDIA PVT LTD (Plaintiff) Vs OPEN AI INC & ANR (Defendants)

CASE NO. - CS(COMM) 1028/2024 with I.A. 45300/2024, I.A. 45301/2024, I.A. 45302/2024, I.A. 45303/2024 and I.A. 45304/2024
DECIDED ON - November 19, 2024

Plaintiff, a prominent news agency, filed a suit against defendants, alleging infringement of copyright in its content. The plaintiff contended that defendants AI model, ChatGPT, had stored and utilized plaintiff copyrighted works without authorization for training purposes and for generating user responses. Plaintiff argued that defendants' use of its content for training and response generation constituted copyright infringement. It sought an injunction to prevent defendants from accessing or using their work and demanded a halt to such practices. Defendants argued that they had blocklisted Plaintiff domain (www.aninews.in) in October 2024, ensuring that the domain would be excluded from future training. Defendants also raised the question of territorial jurisdiction, given its servers are located in the USA. The Hon'ble Delhi High Court identified novel legal issues, including:

- Whether storing and using ANI's copyrighted data for training ChatGPT infringes copyright under the Copyright Act, 1957.
- Whether OpenAI's use qualifies as "fair use" under Section 52 of the Copyright Act, 1957.
- Whether Indian courts have jurisdiction over a case involving foreign servers.

Given the case's complexity and the lack of established jurisprudence in India, the Hon'ble Court appointed two Amici Curiae-Advocate Adarsh Ramanujan and Dr. Arul George Scaria-to assist in examining these issues. This case marks the first of its kind in India, addressing the intersection of AI and copyright law.

TRADEMARK CASES:

ZYDUS HEALTHCARE LIMITED & ORS. (Plaintiffs) vs ALDER BIOCHEM PRIVATE LIMITED (Defendant)

CASE NO. - CS(COMM) 516/2023, I.A. 14145/2023 & I.A. 3116/2024
DECIDED ON - November 13, 2024

The Plaintiffs filed the present suit against the defendant, alleging trademark infringement. Plaintiffs allege that



constitutes visual, phonetic, and

AlderBiochem

structural similarity, leading to confusion with plaintiffs' mark “



” The Plaintiff claimed that the defendant's use of the mark is identical and deceptively similar to their registered trademark “**BIOCHEM**”. Plaintiffs argued that this similarity could mislead consumers and harm their goodwill, especially in the pharmaceutical sector, where precision is critical. Plaintiffs asserted ownership of the trademark “**BIOCHEM**,” coined in 1959, and continuously used since then with over 500 pharmaceutical products. The defendant argued that “**ALDER**” is the primary trademark and “**BIOCHEM**” merely indicates pharmaceutical focus. The defendant also claims “**BIOCHEM**” as a generic term widely used in the pharmaceutical industry, citing numerous companies using similar names. The Hon'ble Delhi High Court found that the Plaintiffs demonstrated a *prima facie* case of infringement. The Hon'ble Court noted that “**BIOCHEM**” is the dominant feature of the Plaintiff's trademark and is being used by the Defendant for similar goods (pharmaceutical products). The Hon'ble Court emphasized the risk of confusion in the pharmaceutical sector, where such errors could have life-threatening consequences. The Hon'ble Court issued an interim injunction in favor of plaintiffs, restraining defendants from using the trademark “



” or any similar marks.

BRITANNIA INDUSTRIES LTD (Plaintiff) vs DESI BITES SNACKS P LTD & ORS. (Defendants)

CASE NO. - CS(COMM) 983/2024 & I.A. Nos. 44302/2024, 44303/2024, 44304/2024 & 44305/2024
DECIDED ON - November 07, 2024



The plaintiff filed a suit against the defendants for infringement of its registered trademark “**GOOD DAY**.” The defendants were found to be selling products such as “Soan Papdi” and food items like “Papad” under the mark “**GOOD DAY**,” which is identical to the plaintiff's well-known trademark. Plaintiff contended that its “**GOOD DAY**” mark, registered since 1986, has acquired immense goodwill in the food industry. The defendants' use of the identical mark constitutes trademark infringement, passing off, and unfair competition, causing harm to the brand's reputation and misleading consumers.

The Hon'ble Delhi High Court observed that the plaintiff established a *prima facie* case of trademark infringement. The identical nature of the mark and its use by the

defendants without authorization indicated a deliberate attempt to ride on plaintiff's goodwill. The Hon'ble Court highlighted the potential for consumer confusion and irreparable damage to the plaintiff's reputation. The Hon'ble Court passed an *ex parte ad interim injunction* in favor of the plaintiff, restraining the defendants from manufacturing, selling, or marketing their products under the mark "GOOD DAY" or any deceptively similar trademark.

MARICO LIMITED (Plaintiff) vs ALPINO HEALTH FOODS PRIVATE LIMITED (Defendant)

CASE NO. - CS(OS) 872/2024, I.A. 43856/2024, I.A. 43857/2024, I.A. 43858/2024, I.A. 43859/2024 & I.A. 43860/2024
 DECIDED ON - October 29, 2024



Plaintiff filed a suit against Defendant to seek a permanent injunction restraining Defendant from publishing advertisements that allegedly disparaged oats as a food category. Plaintiff claimed that Defendant advertisements, which compared oats to non-edible substances like lime powder ("choona"), cement, and adhesive, were defamatory, misleading, and damaging to the reputation of Plaintiff product. Plaintiff alleged that Defendant falsely conveyed that oats were unhealthy, inedible, and unsuitable for consumption, thereby eroding consumer trust and goodwill. Defendant argued that its advertisements were merely comparative and within the permissible bounds of commercial speech. The Hon'ble Delhi High Court noted that the advertisements were prima facie disparaging, with Defendant employing derogatory terms and comparisons (e.g., likening oats to lime powder and construction materials). The Hon'ble Court observed that the ads went beyond permissible puffery and targeted oats as a category, potentially causing irreparable harm to plaintiff. The Hon'ble Court emphasized that generic disparagement, even without naming a specific brand, was actionable. The Hon'ble Court passed an *ex-parte ad-interim injunction* in favor of plaintiff. Restraining Defendant, its agents, and representatives from publishing or sharing the impugned advertisements or any similar content disparaging oats as a food category.

MANKIND PHARMA LIMITED (Plaintiff) vs AQUAKIND LABS LLP & ORS. (Defendants)

CASE NO. - CS(COMM) 958/2024 & I.A. Nos. 43437/2024, 43438/2024, 43439/2024, 43440/2024, 43441/2024, 43442/2024 & 43443/2024
 DECIDED ON - October 25, 2024

Plaintiffs Trademark	Defendants Trademark
	

Plaintiff filed a suit against Defendants seeking a permanent injunction to restrain the defendants from infringing its trademarks by using the trademark "AQUAKIND," which is deceptively similar to Plaintiff well-known trademark "MANKIND" and its "KIND" formative trademarks. Plaintiff Contented that the trademark "MANKIND" was adopted in 1986 and registered in 1995. The plaintiff has an extensive portfolio of over 300 trademarks with the suffix "KIND," all of which have garnered goodwill and reputation in the pharmaceutical industry. The defendants' use of "AQUAKIND" is dishonest and aimed at riding on the goodwill of the plaintiff's well-known trademarks, causing dilution and confusion. Defendants Contented their adoption of "AQUAKIND" was independent and justified by documents submitted during the opposition proceedings. They argued there was no intention to infringe or mislead consumers. The Hon'ble Delhi High Court observed that the plaintiff's trademarks had acquired substantial goodwill and reputation over the years, making them well-known in the pharmaceutical industry. The defendants' use of "AQUAKIND" for similar goods was creating a high likelihood of confusion and deception among consumers. The Hon'ble Court granted an *ex parte ad interim injunction* restraining the defendants from using "AQUAKIND" or any name deceptively similar to the plaintiff's trademarks "MANKIND" and its "KIND" family of marks.

SKECHERS SOUTH ASIA PVT. LTD. & ORS. (Plaintiffs) vs WARDRODE & ORS. (Defendants)

CASE NO. - IA (L) NO. 33060 of 2024 in COMMERCIAL IPR SUIT (L) NO. 32860 of 2024
 DECIDED ON - October 24, 2024



Plaintiffs filed the present suit against multiple Defendants for manufacturing and selling counterfeit goods bearing Skechers' trademarks and artistic works. Plaintiffs alleged that the Defendants had "bodily lifted" Skechers' trademarks and artistic works using them dishonestly to market counterfeit goods. The Hon'ble Bombay High Court found a strong *prima facie* case in favor of the Plaintiffs. The Hon'ble Court observed that the Plaintiffs owned valid and subsisting trademarks and copyrights, which the Defendants had dishonestly imitated. The counterfeit goods were clear reproductions of Skechers' trademarks and artistic works, likely causing confusion among consumers. Granting ex-parte relief was necessary to prevent the Defendants from removing or distributing the counterfeit goods. The Hon'ble Court issued an *ex-parte ad-interim injunction* restraining

the Defendants from using **Skechers'** trademarks and artistic works. A Court Receiver, along with Additional Special Receivers, was appointed to search the Defendants' premises, seize the counterfeit goods, and take an inventory.

C. K. CHANDRAN (Petitioner) vs MANJU (Respondent)

CASE NO. - OP (FC) NO. 591 OF 2024
DECIDED ON - October 10, 2024

The petitioner filed the present suit over the use and ownership of two shop rooms in Changan cherry. The petitioner first filed the case in the Family Court, Kottayam, seeking a permanent injunction to prevent the respondent from entering the shop rooms. The respondent, in turn, filed a counterclaim, arguing that the shops operate under the name "CALLUNA," which is her registered trademark. The Family Court passed an order, granting an injunction against the petitioner. The maintainability of the order was questioned in this original petition. Petitioner argued that the Family Court failed to consider whether the counterclaim and the injunction sought were valid under the Trademarks Act. Trademark suits are commercial disputes, which can be adjudicated only by commercial courts.

The Hon'ble Kerala High Court observed that the Family Court failed to address the maintainability of the counterclaim, particularly as it extended beyond the original petition to other shops not mentioned in the case. Also, the Family Court did not adequately consider whether the injunction against the petitioner under the Trademarks Act was valid. The High Court set aside the Family Court's order concerning the injunction granted under. The case has been remanded to the Family Court for reconsideration. The Family Court has been directed to reevaluate the maintainability and scope of the counterclaim. Also, consider all objections raised by the petitioner, including whether the injunction under the Trademarks Act is valid for shops not mentioned in the original petition. The Family Court must issue a fresh order within one month after providing an opportunity for both parties to present their arguments.

GAMESKRAFT TECHNOLOGIES PRIVATE LIMITED & ANR. (Plaintiffs) vs JOHN DOE & ORS (Defendants)

CASE NO. - CS(COMM) 855/2024 & I.A. Nos. 41000-41002/2024
DECIDED ON - October 01, 2024



The present suit has been filed seeking permanent injunction against the defendant for trademark and copyright infringement. Plaintiffs asserted that their trademarks are the unique combination of words such as "Rummy" and "Culture" as distinctive. Plaintiffs alleged unauthorized use of these marks, replication of website content, and unfair competition, causing damage to their reputation. The Hon'ble Delhi High Court noted that the plaintiffs established a *prima facie* case for infringement and passing off. The court emphasized that the combination of "Rummy" and "Culture" is distinctive to the plaintiffs and any unauthorized use of the marks or replication of their website content could mislead users and harm the plaintiffs' goodwill. It also found the balance of convenience in favor of the plaintiffs and observed that they would suffer irreparable harm if relief was not granted. Interim relief granted in favor of the plaintiffs.

RADICO KHAITAN LTD (Plaintiff) vs M/S RAINA BEVERAGES & ORS (Defendants)

CASE NO.- CS(COMM) 508/2016 & I.A.
Nos. 5866/2016, 9685-9686/2016
DECIDED ON - September 26, 2024



The plaintiff filed the present suit against Defendants for trademark and copyright infringement based on the defendants' use of a deceptively similar trade dress and packaging for their alcoholic beverages. Plaintiff asserted exclusive ownership of the registered trademark "Magic Moments Remix" and copyright over its trade dress, including distinctive elements like color schemes and dancing figures on the bottles. The plaintiff accused the defendants of copying its trade dress, misleading consumers, and riding on its goodwill and reputation. The defendants initially appeared but later defaulted in filing their written statements and ceased participating in proceedings. The Hon'ble Delhi High Court found overwhelming similarities between the trade dress of the plaintiff's products and the defendants' impugned products. The Hon'ble Court noted identical elements in design, packaging, and branding, concluding that the defendants had intentionally infringed the plaintiff's trademark and copyright. The Hon'ble Court emphasized that the defendants' conduct was willfully dishonest, particularly since they continued infringing despite prior injunctions in related cases. Given the defendants' non-participation and obvious infringement, The Hon'ble Court determined that the plaintiff had established a clear case of trademark and copyright infringement as well as passing off. The Hon'ble Court granted a decree of *permanent injunction* in favor of plaintiff, restraining the defendants from using any trade dress, device, or artistic work similar to the "Magic Moments Remix" trademark.



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