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AFTER BIG-B AND ANIL KAPOOR, JACKIE SHROFF CLAIMS OVER HIS PERSONALITY/ PUBLICITY RIGHTS: DELHI HIGH COURT



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A renowned Indian actor Mr. Jaikishan Kakubhai Saraf, fondly recognized as “Apna Bhidu”, AKA - JACKIE SHROFF has knocked the doors of High Court to protect his personality rights which were constantly being violated and infringed by the multiple defendants. Recently, Jackie Shroff filed a lawsuit seeking protection of his renowned name along with his pictures, voice, persona and other distinctive attributes of his personality against unauthorized and misuse on the internet.



image courtesy: www.koimoi.com

Jackie Shroff has starred in 220 films, in addition to several television episodes and online series since his debut in HERO (1983). His contribution to the Indian cinema has been honored with diverse renowned Awards along with

National Award - Hindi Cinema Gaurav Samman in 2017. Apart from this, he has been carrying considerable efforts, time, skills to cultivate the goodwill and reputation associated with his name “Jackie Shroff” and his slang “APNA BHIDU” in the entertainment industry. Subsequently, he also registered the trademark of words “BHIDU” and “BHIDU KA KHOPCHA” under class 25 and 41. Apart from the above, it is contended that, the names 'Jackie' and 'Jaggu Dada' are exclusively associated with Jackie Shroff.

Jackie Shroff's commercial endorsements capitalized on his personality, name, voice, image, likeness, mannerisms, gestures, and other distinguishing features. These qualities, over which he exercises exclusive control, are his 'Personality Rights' and 'Publicity Rights.' The illegal use of these qualities for commercial purposes not only violates his rights, but also dilutes his rigorously established reputation over the time. As a celebrity, the Jackie Shroff has 'Personality/Publicity Rights' over all aspects of his persona. In the above-mentioned suit, Jackie Shroff seeks protection of his Personality Rights/Publicity Rights, and various elements associated with his identity, including his name, voice, photograph, image, likeness, unique style of dialogue delivery, distinctive gestures, and mannerisms.

Jackie Shroff (Plaintiff) has noticed that his Personality and Publicity Rights have been infringed by several defendants on different instances which includes various e-commerce platforms, social media accounts, individuals and AI chatbots by using special attributes of plaintiff for the commercial purposes. Besides this they are also infringing copyright and trademarks of Jackie Shroff. Defendants were using platforms like YouTube and Instagram to sell animated images of plaintiffs, such as the famous “Anda Kadipatta” recipe by the plaintiff, which went viral. The defendants also sell merchandise featuring these images, including t-shirts, posters, and autographed posters. However, these platforms also publish derogatory compilations, distorted videos, overlay profane language, and use the trademark “Bhidu” in their name. Additionally, they host an unlicensed chatbot and offer ringtones and wallpapers featuring the plaintiff's image without authorization.

The Hon'ble court observed that out of all the defendants some of them have used the images, and few attributes of plaintiff were not derogatory or not tarnishing the

reputation of plaintiff. However, they have engaged substantial viewership and translated it into significant revenue. It was further observed that restraining such activities that represent a form of artistic expression and non-derogatory in nature might have far-reaching consequences for such young minds and vibrant community. Therefore, the court asked for the response from such defendants.

Moreover, the Hon'ble court has observed the derogatory and violative conduct from other defendants. Hence it is evident that plaintiff is entitled to an ex-parte ad interim injunction against such defendants. The Hon'ble Delhi High Court has strictly restrained them from using, selling, sharing or any activity that could harm the goodwill of the plaintiff and eventually infringe plaintiffs' personality rights.

Mr. Jackie Shroff has made out prima facie case of infringement and sought judicial interference to protect his personality rights from unauthorized commercial abuse.

In today's digital era, safeguarding individual's personality rights has become crucial. Celebrities are getting aware than ever of their personality and publicity rights, and they get more concerned about unethical commercial use of their attributes. The courts are recognizing the importance of a regulatory framework or regulation for protecting personality and publicity rights from unauthorized use.

CONCLUSION:

There have been several cases where the Indian Courts have granted injunction in favor of the celebrities in order to protect their Intellectual Property Rights and mainly their Personality rights. The Indian Courts have been very vigilant in protecting the personality and publicity rights of the celebrities.

The Madras High Court in *Mr. Shivaji Rao Gaikwad v. M/S.Varsha Productions 2015 (62) PTC 351* passed an injunction in favour of the famous South Indian Superstar "Rajnikant" against the release of a film named "Main Hoon Rajnikant". The Hon'ble High Court held that the use of the name of the Superstar 'Rajnikant', violated his reputation and goodwill through wrongful means of using his name in the title and the content of the movie, which he has built through with his hard work, over the years.

Further, the Bombay High Court in *Sakshi Malik V. Venkateshwara Creations Pvt. Ltd) 31-COM IP L3510-2021*, where the Plaintiff namely, Sakshi Malik who

is a renowned Instagram Model and influencer, filed a defamation suit against the defendants for using her pictures in their Telugu language action film "V" where her portrait photo was used without her consent as indication of a 'prostitute'. The defendants were restrained from releasing their film which already gained a profit of INR 33 Cr. On OTT platforms. Though the said case was filed for defamation, Js. G.S. Patel, Hon'ble Judge of the Bombay High Court, also addressed the issue of the case in the terms of the Copyright and Personality Rights infringement.

Hence, the personality/publicity rights are needed to be protected in order to prevent individual(s) from commercially using an image/photo, name of a celebrity to gain and ride on the commercial goodwill and reputation established by the said celebrity over the years.

[**Note: Ms. Priyanshi Verma, co-author of this article, contributed significantly during her internship at DuxLegis Attorneys in the IP Department. This collaborative article is a product of our joint efforts and represents one of her completed projects during her internship with DuxLegis Attorneys.]

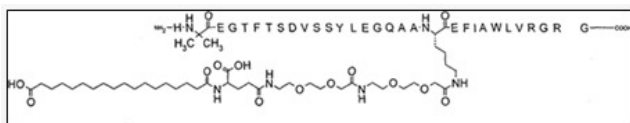
BEIJING IP COURT UPHOLDS NOVO NORDISK'S SEMAGLUTIDE PATENT, OVERTURNING CNIPA RULING



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In an unbelievable turn of event in China, the Beijing IP Court sided with Novo Nordisk, asserting that the original patent disclosure sufficiently supported the idea that semaglutide had a long duration of action.

On September 5, 2022, the China National Intellectual Property Association (CNIPA) declared one of Novo Nordisk's significant semaglutide patents (ZL 200680006674.6) in China invalid (Order No. 57950 of 2022). The challenge was brought by Hangzhou Zhongmei Huadong Pharmaceutical Co., Ltd. (Huadong), a Chinese pharmaceutical company that already markets a generic version of liraglutide (cheaper versions of blockbuster obesity drugs), another GLP-1 receptor agonist originally developed by Novo Nordisk.



The CNIPA argued that Novo Nordisk's patent lacked actual experimental data, making it challenging to confirm that all the compounds exhibited the claimed surprising technical effects.



image courtesy: www.nbcwashington.com

The contested claims involved a single compound (semaglutide), compositions containing the compound, and preparations of a medicament including the compound for treating various medical conditions (e.g., hyperglycemia, diabetes, IBD, etc.). The patent disclosure outlined a class of compounds effective as GLP-1 receptor agonists, detailing 22 specific example compounds, including semaglutide, along with their preparation methods and characterization data. While the patent described screening studies using db/db mice and minipigs, it did not specify which GLP-1 compound(s) were used.

During the invalidation process, all claims were rejected for lack of inventive step (Article 22.3) in light of the closest prior art, liraglutide. Despite the structural differences between semaglutide and liraglutide, the CNIPA contended that their similar structures and mechanisms of action would lead someone skilled in the art to expect similar behavior from semaglutide.

Contrarily, the Beijing IP Court sided with Novo Nordisk, asserting that the original patent disclosure sufficiently supported the idea that semaglutide had a long duration of action. The court highlighted paragraph [0534] in the specification, which stated:

"[0534] In one aspect of the invention, the 'GLP-1 agonist' has a duration of action of at least 24 hours after administration to db/db mice at a dose of 30 nmol/kg."

The Beijing IP Court interpreted "the GLP-1 agonist" to refer to the entire class of compounds, suggesting that all compounds (or at least the 22 examples in the specification) had a duration of action of at least 24 hours post-administration. The judge elaborated, "[a]lthough this technical effect is not specifically described as a technical effect of semaglutide, it can be reasonably inferred that semaglutide has this technical effect since it is a specific compound within the scope of protection of the general formula compound." Consequently, since Novo Nordisk only needed to demonstrate semaglutide's improved properties over liraglutide in one aspect (duration of action > 24 hours), the patent was upheld based on the admissibility of post-filing data.

This case is significant for several reasons, including the product's importance, the economic and legal implications of the decision, and the court's clarification of China's stance on post-filing supplemental data.

However, the case is not yet concluded. Huadong has appealed to the Supreme People's IP Court, while the CNIPA has not appealed the decision.

WIPO: LAUNCHES NEW PLATFORM FOR DOMAIN NAME DISPUTES, INTRODUCES E-FILING OF COMPLAINTS

INTRODUCTION

WIPO (World Intellectual Property Organization) has recently launched a new website for Domain name disputes, in order to deal with and amicably resolve such disputes. But before further discussing the changes brought by the new website let's understand some basics around Domain names and their disputes.

WHAT IS A DOMAIN NAME?

A domain name in a simpler term is an internet address. It is a name, associated with a physical IP address on the Internet. A simple example of a domain name can be a web address ending with ".com" or ".in".

CYBERSQUATTING

Cybersquatting is a cybercrime which refers to the act of registering or using a domain name to profit from someone else's trademark, service mark, business name or personal names. Cybersquatting is also often referred to as Domain Squatting.

This often creates confusion amongst the customers and leads them to a different website than the one they originally wanted to access because the domain name of both seemed to be alike.

The motive of cybersquatting is to gain profit from diverting the reach of customers from either by ransoming the domain name back to the trademark owner or by using the domain name to divert business from the trademark owner to competitors.

UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (THE UDRP POLICY)

The ICANN (Internet Corporation for Assigned Names and Numbers) Board of Directors at its meetings on August 25 and 26, 1999 in Santiago, Chile, adopted the UDRP Policy, on the recommendations contained in the Report of the WIPO Internet Domain Name Process.

The Uniform Domain Name Dispute Resolution Policy (the UDRP Policy) sets out the legal framework for the resolution of disputes between a domain name registrant and a third party (i.e., a party other than the registrar) over the abusive registration and use of an Internet domain

name in the generic Top Level Domains or gTLDs (e.g., .biz, .com, .info, .mobi, .name, .net, .org), and those country code top level domains or ccTLDs that have adopted the UDRP Policy on a voluntary basis. Any person or company in the world can file a domain name complaint concerning gTLDs using the UDRP Administrative Procedure.

NEW UPDATES TO THE WIPO DOMAIN NAME WEBSITE

a) **New in-depth templates for complaint and response**

The template which was earlier provided by ICANN (Internet Corporation for Assigned Names and Numbers) for complaints and responses to be used by complainant and respondent respectively, has been updated in the new website and has provided the users with in-depth explanations and information about what all is required from both the parties to support their claims.

The complaint and response template discusses in depth the definition of who is a complainant and who is a respondent. It further defines important topics such as language of the proceedings, mutual jurisdiction, payments and certification etc.,

The templates include all the steps that will be involved in resolving the domain name disputes.

b) **E-filing of complaints and responses**

The new website has now introduced the option to e-file the complaints as well as the responses by respective parties.

This was previously done by exchange of emails, which often times created chains of exchange of emails between the parties, leading to emails getting lost, going into spam or weren't received by one party or the other for unknown reasons. To tackle this situation, WIPO has now introduced the new features of e-filing the complaint and responses so the parties to the domain name disputes can easily submit their

- responses and attach evidence altogether while keeping track of everything on the website only.
- c) **Updated WIPO Guide to the UDRP**
With the introduction of the new website, WIPO has now also updated the guide to the UDRP process, which contains the list of most frequently asked questions such as scope of UDRP policies, role of registrar, how to file a complaint etc., with very detailed answers to such following questions.

SUMMARY

The introduction of the above-mentioned new features will certainly ease the process of filing the complaints and submitting the responses to the same. The model template provided by WIPO for complainant and respondents would solve the further confusion, if any, brought by the new changes. Overall, the new changes seem to be very beneficial for solving the domain name disputes.



IP SNIPPETS:

PATENT CASES:

HONEYWELL INTERNATIONAL INC (Appellant) vs. THE CONTROLLER OF PATENTS (Respondent)

Case Number: C.A.(COMM.IPD-PAT) 396/2022
Decided on: May 21, 2024

Honeywell

The present appeal has been filed by the appellant against an order for refusing the appellant's patent application no. 3150/DELNP/2010 titled "*Organic Fluorescent Compositions*". Objection were raised in the First Examination Report (FER) that the invention lacks inventive step under Section 2(1)(ja), and non-patentability under Sections 3(d) and 3(e) of the Patent Act. The appellant submitted the reply to the FER along with the amended set of claims, to which the hearing was fixed objecting to the amended set of claims under Section 3(e) of the Act. The appellant submitted written

submission along with the fresh set of amended claims from 'composition comprising a compound' to just 'the compound'. The respondent rejected the amended claims objecting that the claims were beyond the scope of the originally filed claims and non-patentable under section 3(e).

The appellant argued that respondent has not issued separate hearing for the objection regarding amended claims before refusing the claims being beyond the scope in view of section 59. The appellant also argued that the invention described both composition and compound, yet the respondent had wrongfully concluded and passed the impugned order. The respondent refused the same and stated that the specification of the invention indicated composition in subsequent para and, therefore the amendment to a compound could not have been allowed. The Hon'ble Delhi High Court observed that the amended claim was the subset of the original claim and that it does not contain any matter out of the original claim or specification. The Hon'ble Court set aside the impugned order and directed for fresh consideration of the subject application along with the proposed amendment by the appellant.

INCYTE HOLDINGS CORPORATION & ORS. (Plaintiffs) vs. ALEMBIC PHARMACEUTICALS LIMITED (Defendant)

Case Number: CS(COMM) 495/2024 & I.As. 31168-31173/2024
Decided on: May 30, 2024



The present suit has been filed as a quia timet action, by the plaintiff against the infringement of the Indian Patent No. IN269841 which protects the novel and inventive compound 'Ruxolitinib'. The plaintiff states that the drug 'Ruxolitinib' is a new chemical entity which has been given an International Non-Proprietary Name (INN) by the World Health Organisation (WHO). The plaintiff further states that the invented compound 'Ruxolitinib' is marketed and sold in India and many other countries under the brand name 'JAKAVI®' and the defendants are infringing by engaging in manufacture and sell of the same patented compound 'Ruxolitinib'. The defendant's states that they do not intend to commercialize any product containing the patented product 'Ruxolitinib' during the validity of the suit patent. And the defendants also requested the Court to protect their rights under Section 107A of the Patents Act, 19702, to use 'Ruxolitinib' for the purposes of research.

The plaintiff agrees to the suit being disposed of by binding the Defendant statement and the plaintiff also do not wish to claim any monetary relief from the defendant. The rights of the defendants under Section 107A of the Act are protected as long as the conditions required under the said provision are fully complied with by the Defendants. Hence, the issue was resolved on consent terms and the request by the plaintiff for full refund of Court fees is accepted.

Indian Institute of Technology (IIT Madras) (Appellant) vs. (1) The Controller of Patents & Designs; (2) The Assistant Controller of Patents & Designs; (3) The Examiner of Patents & Designs (Respondents)

Case Number: (T) CMA (PT) No.52 of 2023 (OA/56/2020/PT/CHN)
Decided on: June 11, 2024



The current appeal has been filed by the appellant under the provision of Section 117A of the Patent Act, 1970 for rejecting the patent application no. 4032/CHE/2013 titled "METHOD OF DOPING POTASSIUM INTO AMMONIUM PERCHLORATE". The

Application was refused under Sections 2(1)(ja), 3(d) and 3(a) (i.e. invention is frivolous) of the Patents Act.

The appellant argued that the objection regarding Section 3(a) of the Patents Act, was introduced for the first time in the refusal order and the appellant has not given opportunity to respond to the objection. The appellant further argued that the invention is a mere new use of a known process and usage of the specific filtrate material as a reactant is itself a novelty in the invention, therefore objection of Section 3(d) cannot be a ground for refusal. Furthermore, the appellant argued that the use of filtering material by eliminating the use of external reagents that results in a new product originates an inventive step under Section 2(1) (ja) of the Patents Act, also the prior art D1 does not disclose or render the invention obvious. The respondent argued that the appellant has given an opportunity to respond in the hearing for the objection under Section 3 (a). Further, the respondent argued that the process involved in the invention is a conventional process and a part of common general knowledge, therefore the invention is excluded from patent protection under Section 3(d) and the steps involved in the invention cannot be said to constitute a technical or economic advancement under Section 2(1)(ja) of the Patents Act. The respondent concluded by submitting that that the claimed invention does not even satisfy the requirements

of an 'invention' under Section 2(1)(j) of the Patents Act.

The Hon'ble Madras High Court observed the following matter and stated that the respondent had not raised an objection on the ground of frivolousness Section 3(a) of the Patent Act in FER and hearing notice, it was directly issued for the first time in refusal order, therefore this specific order cannot be sustained, and the claimed invention is also susceptible of industrial applicability. Further the Court observed that the cited prior art D1 involves similar process, and the resultant product is also a variant of the one in D1 as compared to the appellant's invention, so the claimed invention is refused under Section 3(d) of the Patents Act and due to lack of experimental data and economic significance the claimed invention also lacks an inventive step under Section 2(1)(ja) of the Patents Act. Hence, the Hon'ble Court upheld the rejection of the appellant invention on the ground of Sections 3(d) and 2(1)(ja) of the Patent Act.

DESIGN CASES

PIDILITE INDUSTRIES LIMITED (Plaintiff) vs. ASTRAL LIMITED (Defendant)

Case Number: INTERIM APPLICATION (L) NO.13706 OF 2024 IN COMMERCIAL IP SUIT (L) NO.13638 OF 2024
Decided on: June 13, 2024



In the present case, the plaintiffs had filed an application to restrict the defendants from infringing plaintiffs design of Coex plastic containers used for storing products. The plaintiff claims to be the first in industry to make this transition to Coex plastic containers and design containers for the M-SEAL PV SEAL products that could be applied to different variants. The plaintiff alleged that the defendant is infringing the plaintiff's design, copyright and the defendant is also passing off their goods as the plaintiff's goods by imitating the plaintiff's brand /product, thereby misleading public. The plaintiff further argued that as per Section 2(d) of the design act, their design satisfies all the requirements of the definition of a design and is also a registrable design. The defendants argued against the protectability under Section 19(1)(e) of the Designs Act because it is not a design as defined under Section 2(d) as the plaintiff's design is not appealing to the eye. The defendant had also cited prior art questioning novelty or originality of the plaintiff's design.

The Hon'ble Bombay High Court decision lies in favour of plaintiff. The Hon'ble Court referred to Section 2(d) of the Designs Act defining design "*design*" means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye" as per the observation the design must appeal to the eye as a whole. The Hon'ble Court also found substantial difference while comparing the plaintiff's design with the prior art. The Hon'ble Court concluded that plaintiff had made out a prima facie case for grant of ad-interim reliefs, if the plaintiff's application is not granted then the defendant would continue to use the design causing loss and harm to the plaintiff. Hence, the Court restrained the defendant from infringing the plaintiff's right in the registered design by any form and granted an interim injunction in favour of plaintiff.

The Hon'ble Bombay High Court relying on test established in **Cadila Health Care Ltd.** (Supra) by Supreme Court, held that Defendants and Plaintiff's drugs are both anti-diabetic medications and might sound similar to physicians phonetically as several times the names of medicines are either told to them on call or written in handwriting, which is hard to understand, hence this would be very harmful to public health. Hence, ad-interim relief was passed in Plaintiff's favor.

DOMINOS IP HOLDER LLC & ANR. (Plaintiffs) vs. M/S MG FOODS & ANR. (Defendants)

Case No.: CS(COMM) 517/2024, I.A. 31610/2024
Decided On: May 31, 2024



The present suit is filed by Plaintiffs seeking decree of permanent injunction restraining Defendant No.1 and all those acting for and on their behalf from promoting, selling, marketing, packaging any product or material using, depicting and displaying in any manner in the marks,



"DONITO'S", or any other mark which is identical or deceptively similar to the plaintiffs' registered trademarks. Plaintiffs have been the first and prior adopter of the mark "DOMINO'S" since the year 1965, and now conduct operations in more than 90 countries, with over 20,500 stores. The Plaintiffs' initial adoption of the said mark is arbitrary, as it has no meaning or significance in relation to pizza or fast-food restaurants, whereas Defendant No.1 is operating in various regions of Punjab with six outlets located at Jalandhar, Nakodar, Goraya and Mehatpur using the impugned mark.

Defendant No. 1 also applied for registration of the impugned mark which was Accepted and Advertised in the TM Journal and was further opposed by the Plaintiffs.

The Hon'ble Delhi High Court held that the Plaintiffs were successful in making a *prima facie* case for grant of an ex-parte ad interim injunction till the next date of hearing. Balance of convenience also lied in favor of the Plaintiffs. The Court further ordered them to take down all the listings on YouTube and LinkedIn using the impugned mark by Defendant No. 1.

TRADE MARKS CASES

GLENMARK PHARMACEUTICALS LTD. (Applicant /Plaintiff) vs. GLECK PHARMA (OPC) PVT LTD. & ORS. (Respondents /Defendants)

Case No.: INTERIM APPLICATION (L) NO. 30450 OF 2023 IN COMMERCIAL IP SUIT (L) NO.30149 OF 2023
Decided On: June 13, 2024.




The Plaintiff is seeking ad-interim relief through this suit against the defendants for infringing its registered trade mark and passing off.


Plaintiff is a company engaged in the business of inter alia manufacturing, marketing and selling pharmaceutical and medicinal preparations. One of the Plaintiff's products is an anti-diabetic drug sold under the registered trade mark "ZITA-MET, Plaintiff has also applied for and secured trade mark registration for the word mark "ZITA-MET" and ZITA-MET formative trade marks in Class 5 and has been continuously using the said since 2013.


In August 2020, the Plaintiff came across the impugned trade mark application filed by Defendant No.1 before the Trade Marks Registry for the impugned trade mark "XIGAMET" in respect of Class-5, on proposed to be used basis. Defendant No.1 claimed that theirs and Plaintiff's products are aurally different and are prescription drugs hence would cause no problem to consumers.

INDEPENDENT NEWS SERVICE PRIVATE LTD & ANR. (Plaintiffs) vs. RAVINDRA KUMAR CHOUDHARY & ORS. (Defendants)

Case No.: CS(COMM) 498/2024, I.A. 31295/2024
Decided On: May 30, 2024

 This application has been filed under Order XXXIX Rules 1 and 2 of CPC as part of the accompanying suit seeking a decree of permanent injunction restraining defendants and all those acting for and, on their behalf, from using the mark/logo'

mark/logo'  (the impugned mark) and "Baap ki Adalat" or any other trademark/logo deceptively similar to the trademark/logo of the plaintiff viz.

 and AAP Ki Adalat' and other attendant relief. Plaintiff no.1 company was incorporated in the year 1997 by its Chairman and Editor-in-Chief Rajat Sharma, who is plaintiff no.2, whereas defendant no.1, who is a self-proclaimed political satirist creating and publishing various video audio content on social media. Plaintiffs are aggrieved by the deceptively similar impugned mark, being used by defendant no.1, including one of the principle and popular programs "AAP KI ADALAT". Plaintiffs presented a list of their registered trademarks, cases held in their favor and an evaluation of similarity between defendants broadcasting compared to the Plaintiff's.

The Hon'ble Delhi High Court held in favor of the Plaintiff, as the balance of convenience lied with them and also, Plaintiffs having established a *prima facie* case for grant of ex parte ad-interim injunction.

KUTBUDDIN KANORWALA (Appellant/Plaintiff) vs. ZAKIR HUSSAIN KANORWALA & ORS. (Respondents/Defendants)

Case No.: S.B. Civil First Appeal No. 404/2022
Decided On: May 23, 2024

The appellant-plaintiff in the present suit has two registered trademarks, namely, "Upkar Spices" having registration No.1034169 & "ZK" having registration No.481894 which are registered under Class 30, whereas the respondent-defendant is having a registered trade mark "ZK" registered under Class 35 with the registration No.2276741.

Since the registered trade mark "ZK" of the appellant-plaintiff was being misused by the respondent/defendant, therefore, a suit was preferred by before the learned trial court for infringement and passing off. During the proceedings, the defendant filed an application under

Sections 28(3), 29, and 30 (2) (e) of the Trade Marks Act, 1999, which was allowed by the Additional District Judge, leading to the dismissal of both the suits and the counterclaim. The Respondent also filed an opposition against the Appellant, which is still pending.

The Hon'ble Rajasthan High Court, upon appeal, reversed the lower court's decision, emphasizing that the distinct nature of the trade mark classes. The court noted that the appellant held valid registrations under Class 30 (goods) whereas the respondent's registration was under Class 35 (services).

The Hon'ble Court further acknowledged that trade marks in different classes do not infringe upon each other's exclusive rights, the Court effectively narrowed the application of Section 28 (3) of the Act to scenarios within the same class.

KRBL LIMITED (Plaintiff) vs. JOHN DOE & ORS. (Defendants)


Case No.: CS(COMM) 416/2024
Decided On: May 20, 2024



The Plaintiff in the present suit is seeking an ad-interim ex-parte injunction against Defendant No. 1, unauthorized websites allegedly perpetrating financial fraud on the general public using the Plaintiff's registered trademark.

The Plaintiff is amongst the leading global manufacturers and sellers of rice and allied products such as, quinoa, chia seeds, and flax seeds etc. under the trademark "INDIA



GATE/  BASMATI RICE The wordmark "India Gate" registered in Class 30 has been in use since 1979 and is also a well-known trademark as recognized by the Trade Mark Registry.

In January 2024, the Plaintiff received multiple complaints from consumers bringing to their knowledge a fraudulent investment scheme being run by Defendant No. 1 using the Plaintiff's trademark "INDIA GATE." The defendant no.1, forged distributorship agreements in the name of the Plaintiff, created fake links, YouTube channels, WhatsApp and telegram channels and a fake website, using the Plaintiff's well known trade mark and fake information and customer support email IDs, in order to promote their fraud schemes to innocent consumers, who lost a lot of money to Defendant No. 1 believing them to be the Plaintiff.

The Hon'ble Delhi High Court held in favor of the

Plaintiff, as *prima facie*, such use of the Plaintiff's well-known mark is detrimental to its distinctive character thus, constitutes infringement under Section 29(4) of the Trademarks Act. The Court further ordered the Defendants to block all the channels of YouTube, WhatsApp and Telegram as well as the fake websites.

SANJAY GUPTA AND ORS. (Petitioner) vs. ANIL UDYOG (Respondent)

Case No. : C.O. (COMM.IPD-TM) 106/2022
Decided On: May 20, 2024

The Petitioner in the present suit filed a rectification suit against the respondent for removal of impugned trademark from the Trade Mark Registry registered in the name of the Respondent No. 1.

Petitioner has been using the trade mark "Shiv Ganga" in Class 03 since 01st January 1974 for use of product Camphor, Isoburnoil and other products, whereas Respondent No. 1 has a same registered trademark "Shiv Ganga", though in Class 01 but for use of same products as Petitioner which is, Camphor.

The Respondent No. 1 got the mark registered only in 2017 and produced no clear and cogent evidence of their use of the impugned trademark in the said class 01.

The Hon'ble Delhi High Court observed that the trademarks and goods are identical as well as trade channels are the same, apart from this the respondent no.1 has not filed any reply and no one appeared on his behalf. Hence, the petitioners' averments are unrebutted and have to be accepted.


Therefore, the Hon'ble Court held that the present rectification petition be allowed, and the impugned trademark will be removed from the Register of Trade Marks.

M/S VANS INC. USA (Petitioner) vs. FCB GARMENT TEX INDIA (P) LTD. AND ANR. (Respondents)

Case No. : C.O. (COMM.IPD-TM) 161/2021
Decided On: May 02, 2024



The petitioners originally filed the rectification/cancellation based on deceptive similarity of Respondent's impugned trade mark(s) "IVANS" and "IVANS NXT" with Petitioner's well-known trademark

"VANS/ " further seeking removal of the said impugned trade marks (s) from the Trade Mark Register under IPAB (Intellectual Property Appellate Board), the said petition was transferred to Delhi High Court in 2021, pursuant to abolition of the said Board.

Petitioner "VANS" is a known brand amongst skateboarders for their sporting items mainly shoes, since 1970s in USA, their products in India were only launched in 2011 for which they sought registration of the trademark "VANS" in 1992 on proposed to be used basis which was only accepted in 2005, whereas the Respondent no. 1 only deals with men's apparels throughout India and have claimed prior use since 1999. Petitioner has also been granted status of "Well-known trademark" in India vide Journal No. 2144 dated 19th February, 2024.

The Hon'ble Delhi High Court held that, while the petitioner had applied in 1992 and the respondent no.1 had applied in 2002, the petitioner had not launched the products in the market till 2011. Therefore, the actual user in the market would have to be considered as per the "FIRST IN THE MARKET" test established in Neon Laboratories (supra) case by the Supreme Court.

The Court further noted that, petitioner filed the cancellation petition 16 years after registration of respondent no.1's mark and did not oppose the said impugned trade mark even once in the past. Hence, rejecting the petition, concluded that declaration of a well-known trademark cannot give an automatic, unbridged, and unmitigated right to a proprietor to apply for rectification of all the marks which have subsisted on the Register for years prior and in different classes.



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