DuxLegis
Attorneys

IP AY ATTENTION

Gateway to IP World

Newsletter | Issue 13 | January 2024

In This Issue

DuxLegis
Attorneys

IPAY ATTENTION
Gateway to IP World

Editorial

Dear Esteemed Colleagues,

As we step into the boundless possibilities of 2024, DuxLegis extends warm wishes for a spectacular year ahead - filled with joy, prosperity, and unity across our global community.

This moment carries extra significance for all of us at DuxLegis as we joyously celebrate the first anniversary of our newsletter - "IPay Attention." Over the past year, our dedicated team has been on a mission to share insightful articles, updates, and expertise directly from the legal landscape in India. The overwhelmingly positive response from our esteemed colleagues worldwide has truly fueled our passion.

In tandem with this celebratory occasion, we are delighted to unveil a refreshed look for our newsletter, complete with a new cover image that welcomes 2024 as a leap year. This year, we embark on a journey symbolized by the Dragon year that signifies prosperity, productivity, and transformative energy. This change reflects our commitment to embracing positive change and setting the stage for an even more dynamic newsletter.

At the core of our accomplishments lies a team of seasoned lawyers and professionals committed to delivering comprehensive legal solutions. From Patents and Trademarks to copyrights, designs, and Plant Variety Protection, we take immense pride in the diverse spectrum of intellectual property areas we've covered. As we stand on the threshold of a new year, our commitment remains resolute – not just to meet but to surpass our own expectations.

To kick-start this promising year, our spotlight falls on a recent judgment from the Madras High Court regarding the Foreign Filing License requirements for Patent of Addition applications. Our featured article not only delves into the intricacies of this case but also provides a broader commentary on Patent of Addition within the framework of the Indian Patents Act, 1970.

In addition to our regular newsletter content, we are thrilled to announce new interactive features, including featuring IP case studies, webinars, expert interviews, and Q&A sessions with our legal luminaries. These initiatives are aimed at fostering a deeper understanding of complex legal matters and creating a dynamic platform for engagement.

As we continue this exhilarating journey, we express our sincere gratitude for your continued support and engagement. DuxLegis remains dedicated to sharing our knowledge, insights, and legal acumen with our valued clients and subscribers.

Here's to another year of collaboration, learning, and legal excellence!

Warm Regards,

Divyendu Verma
Managing Partner
DuxLegis Attorneys

Mobile: +91-8373980620
Phone:+91-22-46083609

902, Kamdhenu Commerz,
Sector - 14, Kharghar,
Navi Mumbai - 410210, India

info@duxlegis.com

www.duxlegis.com

DuxLegis Attorneys

IP AY ATTENTION
Gateway to IP World

LANDSCAPE OF PATENT OF ADDITION AND FFL REQUIREMENT IN INDIA

Priti More

Sahana Mabian

INTRODUCTION:

In the dynamic landscape of invention and innovation, the journey doesn't always end with the creation of a groundbreaking product or process. Oftentimes, the path to excellence involves continuous enhancements and modifications. In the realm of IP protection in India, the concept of a "Patent of Addition" plays a pivotal role in safeguarding these valuable improvements.

WHAT IS A PATENT OF ADDITION:

A Patent of Addition, as defined by the Indian Patents Act of 1970, is a specialized patent application crafted for the purpose of protecting modifications or improvements made to an existing invention that is already protected by a patent. This legal provision allows inventors to secure intellectual property rights not only for their original creation but also for subsequent enhancements that elevate the invention's functionality or address market feedback.

LEGAL FRAMEWORK: SECTIONS 54, 55, & 56:

The filing and prosecution of a Patent of Addition in India are particularly governed by Sections 54, 55, and 56 of the Indian Patents Act. These sections lay down the procedural intricacies and guidelines that inventors must adhere to when seeking protection for their advancements.

KEY CONSIDERATIONS IN FILING A PATENT OF ADDITION:

a) Applicant: The applicant for the Patent of Addition must be the same as the applicant/patentee of the main patent application/patent. *(c.f. Section 54(1) of the Act)*
b) Filing Timeline: A Patent of Addition can be filed on the same date as the main application or at a later date or before the expiry of the main patent. *(c.f. Section 54(3) of the Act)*

WHY FILE A PATENT OF ADDITION:

a) **Ensuring Comprehensive Exclusivity:** Filing a Patent of Addition safeguards the exclusivity of the entire evolving technology spectrum owned by the innovator. This strategic move ensures that modifications or improvements over the main invention remain under the umbrella of protection.
b) **Consolidating Independent Patents:** As per section 54(2), in the scenario where the improvement or modification over the main application is a subject of an independent patent, and if the patentee is the same in respect of both the inventions, the Controller may, on request by the patentee, revoke the independent patent and grant the same as a patent of addition.
c) **Cost-Effectiveness and Synchronized Terms:** Filing a Patent of Addition proves to be cost-effective as it eliminates the need for separate renewal fees. Per Section 55(2), the term of a Patent of Addition aligns with that of the main patent, remaining in force as long as the main patent does and expiring concurrently.
d) **Immunity from Invalidation on Inventive Grounds:** Section 56 of the Act provides a crucial advantage – a Patent of Addition cannot be invalidated or revoked solely on the ground that the invention claimed in its specification lacks inventive step concerning the main application/patent. The disclosure in the main application becomes instrumental in determining the novelty of the Patent of Addition.
e) **Strategic Responses to Prosecution Outcomes:** If the main application/patent faces refusal during prosecution, the pending Patent of Addition is subject to refusal under Section 54(4). However, if the Patent of Addition is granted and the main patent is subsequently revoked, the patentee can make a request under section 55 (1) for the conversion of the granted Patent of Addition into an independent patent for the remainder of the main patent's term.

SIMILARITIES ACROSS JURISDICTIONS:

The concept of a Patent of Addition is not exclusive to India. Countries like Australia and the USA also incorporate similar provisions. In the USA, however, the Continuation-In-Part (CIP) patent application takes center stage. This application allows the addition of new subject matter not disclosed in the original patent application.

FILING OF CIP OR EQUIVALENT WITHOUT TAKING FOREIGN FILING LICENSE (FFL):

As per provision of Section 39 of the Indian Patents Act, 1970, the inventors or applicants who are resident of India cannot disclose the inventions outside India without seeking the prior permission from the Indian Patent office (IPO).

Every application whether it is an ordinary application or the Patent of Addition, the inventor who is residing in India should necessarily obtain a Foreign Filing License (FFL) for any invention before applying for a patent outside India, without applying the same patent in India. Failure to adhere to this provision results in abandonment of the Patent application or the revocation of the granted Patent. Further the Section 118 of the Indian Patents Act of 1970 states that if the patent application fails to comply with the clause of section 39, *"he shall be punishable with imprisonment for a term which may extent to two years, or with fine, or with both".*

If the invention pertains to defense purposes or atomic energy, the Controller shall not issue a permit without the prior consent of the Government of India. Granting a FFL brings several advantages, especially for companies operating from India, as they often target foreign markets where there is more potential than in India. Additionally, if a particular invention is not patentable in India, companies can file applications in foreign countries using the FFL.

WHAT HAPPENS IF THE INVENTOR FAILS TO OBTAIN THE FFL:

In case of patent of addition, the inventor needs a foreign filing license before filing a corresponding patent of addition application outside India. As per the Indian Patent Act, the applicant must apply for license at least six weeks before the intended filing date of the foreign application. And if the applicant fails to comply with section 39, it may result in grieve consequences.

JUDICIAL CLARIFICATION ON FOREIGN FILING OF PATENT OF ADDITION:

In a recent landmark judgment - *Selfdot Technologies (OPC) Pvt. Ltd. Vs. The Controller General of Patents, Designs & Trademarks [2023:MHC:5258],* the Hon'ble Madras High Court addressed the crucial aspect of obtaining permission for the foreign filing of a Patent of Addition. In this case, *Selfdot Technologies (OPC) Pvt. Ltd.* ("Appellant") filed a patent application in India and subsequently filed the corresponding application in United States. The Appellant further filed a U.S. Continuation-in-Part application (CIP) based on the main US patent. Both applications obtained approval from the USPTO. Following the grant of the CIP, the Appellant filed a Patent of Addition in India, leading to its refusal by the *Controller General of Patents, Designs & Trademarks* ("Respondent"). The refusal was grounded in an alleged contravention of Section 39 of the Patents Act, resulting in the application being deemed abandoned under Section 40. Subsequently, the Appellant lodged an appeal to challenge the refusal.

The Appellant contended that the *"Section 39 is not applicable because the main application was first filed in India".* The Respondent on other side contended that the Patent of Addition stands on a different footing than the divisional application. As additional matter can be disclosed in the complete specification of the Patent of Addition, there is requirement of separate permission under section 39, for filing the Patent of addition firstly outside India.

The Madras High Court identified and noted that previously, the scope of section 39 was limited to invention for defense purposes or atomic energy and later when the scope of section 39 was expanded to all type of the inventions, the provisions of section 40 was not amended. Based on this the Hon'ble Court has concluded that *"the breach committed by the appellant qualify as a technical breach (involves a failure to adhere to procedural, administrative, or formal requirements outlined in laws, contracts, or regulations) and not a substantive breach, therefore did not trigger the deemed abandonment under section 40 of the Patent Act".* The Hon'ble Court further stated that legal constructs incorporated in Section 40 of the Act should not exceed their intended scope.

Thus, by setting aside the impugned order, the Hon'ble Court has remanded the matter for reconsideration with providing the liberty to the Controller to impose the appellant on the procedural violation by taking recourse to Rule 137 of the Patents Rules 2003, after providing a reasonable opportunity to the appellant.

CONCLUSION:

The decision from the Hon'ble Madras High Court, favoring the applicant of the contested patent application, has been positively received by the intellectual property rights (IPR) community. This ruling clarifies that obtaining prior permission from the Indian Patent Office for filing Patent of Addition outside India (such as CIP) is not mandatory and the Applicant can file the CIP without taking prior permission if the corresponding main patent application for the said CIP is first filed in India. However, there exists potential misuse and unauthorized disclosures. Addressing procedural violations through Rule 137 of the Patents Rules 2003 could incentivize individuals to disclose sensitive information outside India without prior permission from the Indian Patent Office.

Further, weakening of Section 39 may facilitate the direct disclosure of certain sensitive information falling within the purview of Section 35 of the Indian Patents Act, 1970. The discrepancy between the main patent application and the Patent of Addition could potentially escape the attention of the Government of India.

While the Hon'ble Madras High Court's decision clarifies a significant aspect of patent law, the potential for misuse raises questions about the balance between innovation facilitation and regulatory standards.

INDIA'S INNOVATION & PATENT LANDSCAPE: A DECADE OF REMARKABLE GROWTH FUELED BY INDIA UNIVERSITIES

By
Divyendu Verma

In the dynamic world of intellectual property, India has emerged as a beacon of innovation and progress over the last decade. A significant contributor to this growth story has been the pivotal role played by Indian universities, as evidenced by their prominent presence in the QS World University Rankings - Asia 2024.

The recent release of the 2023 World IP Indicators by WIPO (World Intellectual Property Organization head office in Geneva) further emphasizes the transformative journey of India's patent landscape. The statistics reveal a remarkable surge in patent applications, with a notable shift in the dynamics of resident and non-resident filings.
In 2022, the total number of patent filings in India reached an impressive 77,068, showcasing a robust upward trajectory. What sets this year apart is a pivotal moment in India's patent history – Indian residents filed more patents than their non-Indian counterparts for the first time in the history of patent filings in India. This shift is particularly striking, considering that in 2012, non-resident (Foreign Applicants) filings dominated at 78.26% and Indian Applicant filings were at 21.73%. Fast forward to year 2022, the Indian Applicant filings are now at 50.02% compared to Foreign Applicants filings at 49.97%. This also indicates for the first time in recorded history, filings by Indian Applicants have taken over the filings by foreign Applicants.

The growth is even more significant when we delve into the numbers. Resident patent applications in India witnessed a staggering 47% increase, soaring from 26,267 in 2021 to an impressive 38,551 in 2022. In contrast, non-resident filings grew by just 9%. This newfound dominance of Indian applicants underscores the maturing innovation ecosystem in the country, distinguishing itself among middle-income economies.
The role of Indian universities in fostering this innovation is underscored by their notable presence in global rankings. Seven Indian universities secured positions among the top 100, with a total of 15 universities making their mark in the top 200 of the QS World University Rankings - Asia 2024. This recognition highlights the academic institutions' commitment to research, development, and nurturing an environment conducive to

The collaborative efforts of Indian universities, coupled with a favorable policy environment and a growing emphasis on innovation, have led to a transformative decade for India's patent landscape. As the nation continues to evolve as a global hub for innovation, the role of academia remains central to sustaining this upward trajectory. However, the picture is not as complete and rosy as it looks like. When one peruses the QS World University Ranking completely and their scores allocated to top 100 universities, we can see there is lot of improvement required by the Indian Universities.
Here are key suggestions on how Indian universities can enhance their innovation ecosystem:

1. Strengthen Industry-Academia Collaboration:

- Encourage and facilitate collaborative projects with industry partners to address real-world challenges.
- Establish dedicated industry liaison offices to streamline communication and foster mutually beneficial partnerships.

2. Promote Interdisciplinary Research:

- Create interdisciplinary research centers that bring together experts from diverse fields to tackle complex problems.
- Foster a culture that encourages researchers to explore collaborations beyond their traditional academic domains.

3. Invest in Research Infrastructure:

- Allocate resources for state-of-the-art research facilities and laboratories, fostering an environment conducive to cutting-edge research.
- Prioritize funding for research projects that have the potential for practical applications and technological advancements.

4. Enhance Intellectual Property Education:

- Integrate intellectual property (IP) education into the academic curriculum to raise awareness among students and faculty about the importance of protecting innovations.
- Organize workshops, seminars, and training sessions on IP management, patent filing procedures, and technology commercialization.

5. Incentivize Patent Filings:

- Recognize and reward faculty and students for successful patent filings and technology transfer initiatives.
- Implement policies that offer financial and non-financial incentives to encourage active participation in the patenting process.

6. Streamline Technology Transfer Offices:

- Recognize and reward faculty and students for successful patent filings and technology transfer initiatives.
- Implement policies that offer financial and non-financial incentives to encourage active participation in the patenting process.

7. Encourage Entrepreneurship:

- Facilitate the establishment of incubators and accelerators on campus to support budding entrepreneurs among faculty and students.
- Offer mentorship programs, funding opportunities, and networking events to nurture entrepreneurial spirit.

8. Align Research with Societal Needs:

- Encourage research projects that address pressing societal challenges, aligning academic endeavors with national development goals.
- Foster a culture of socially responsible innovation by emphasizing the potential impact of research on the well-being of society.

9. Global Collaboration Initiatives:

- Facilitate international collaboration programs, encouraging researchers to engage with global counterparts on joint projects.
- Leverage global networks for knowledge exchange and collaborative research ventures.

10. Continuous Evaluation and Adaptation:

- Regularly assess the effectiveness of existing programs and policies, making adjustments based on feedback and changing innovation landscapes.
- Stay informed about global best practices in university-industry collaboration and technology transfer.

By implementing these strategic measures, Indian universities can not only foster a culture of innovation but also significantly contribute to the nation's intellectual property landscape. As these institutions continue to evolve, their commitment to these suggestions will play a crucial role in propelling India further as a global hub for groundbreaking research and development.

Note: The article was originally written in Marathi (regional and working language of Maharashtra State in India) which was widely reported by Maharashtra's Leading Newspaper – Sakal. Here is the screenshots:

सकाळ

भारताची 'पेटंट' भरारी!

निमित्त

बौद्धिक संपदेच्या क्षेत्रात भारत देश हा नावीन्य आणि प्रगती यांचे प्रतीक म्हणून गेल्या दशकभरात उदयास आला आहे. या यशात सर्वात मोलाचे योगदान दिलेय ते भारतीय विद्यापीठांनी. अलिकडेच जाहीर झालेल्या 'क्यूएस वर्ल्ड युनिव्हर्सिटी रँकिंग- आशिया २०२४' या अहवालाने भारतीय विद्यापीठांच्या या योगदानावर मान्यतेची मोहोर उमटवली आहे. भारतात पेटंट अर्ज दाखल करण्याच्या क्षेत्रात एका अर्थाने भारतीयांनी विदेशी कंपन्या व संशोधक यांच्यावर मात केली आहे. हे आजवरच्या पेटंट इतिहासात पहिल्यांदाच घडले आहे.

वास्तव, तरीही चिंताजनक

भारतीयांची विदेशींवर मात

पहिल्या दहांत सात भारतीय विद्यापीठे

(पान ३ वर)

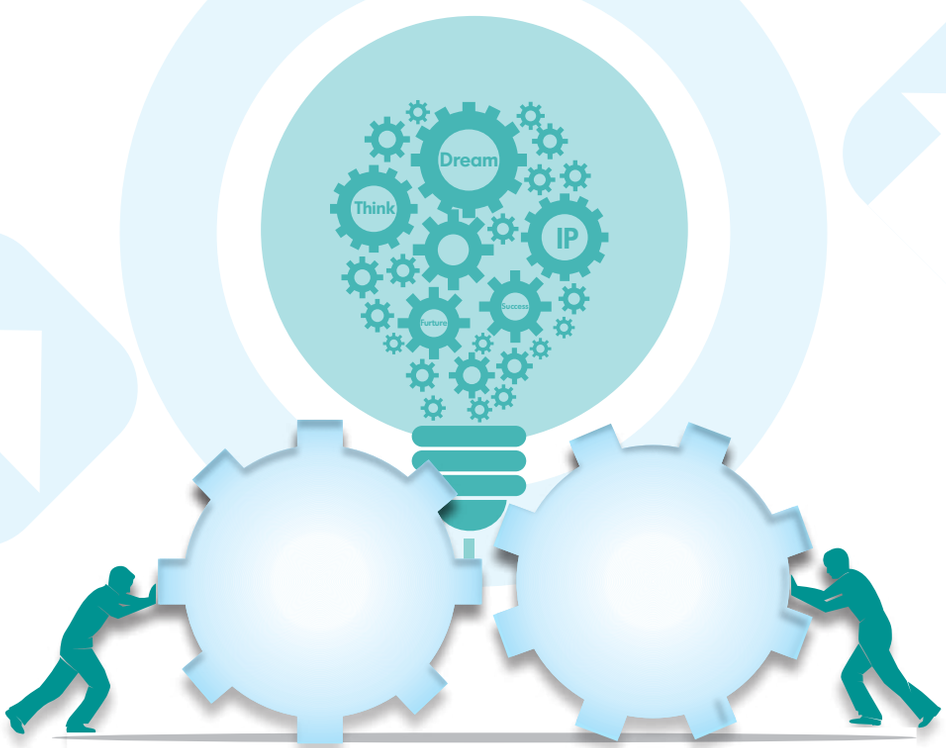
RECOGNITION

DuxLegis Attorneys is thrilled to announce that Adv. Sphurti Dalodria, Head of Patents Department, has been appointed as the National Chair of the Copyright Licensing Committee at Licensing Executives Society (LES) India.

Sphurti is a Trademark and Patent Attorney registered with the Bar Council of India. She has more than 10 years of experience in the field of IP. In this esteemed role, Sphurti will lead and contribute to shaping discussions and strategies around copyright licensing, further enhancing our commitment to intellectual property rights.

The LES India is a nonprofit association comprised of professionals engaged in transfer, use, development, manufacture and marketing of technology and Intellectual Property. The LES India is a part of LES International which is a UNO like body in the field of IPR and have a world-wide family comprises of 33 National and Regional societies, representing over 90 countries and 10,000 executives. The Copyright Licensing Committee provides information about copyright licensing and its impact on company activities around the world and how they are affected by local law provisions and court precedents.

LES
LICENSING EXECUTIVES SOCIETY INTERNATIONAL



IP SNIPPETS:

PATENT CASES:

OPTIMUS DRUGS PRIVATE LIMITED (Petitioner) vs UNION OF INDIA & Ors (Respondent)

Case Number: W.P.(IPD)/24/2023 and WMP(IPD)/6/2023
Decided on: December 12, 2023

In the present case, the patent has been granted for an invention entitled "An improved process for the preparation of Linezolid" to which "Synmed Labs Limited" (respondent) filed a post grant opposition along with the evidence. But the petitioner did not submit any evidence while filing the reply statement to the opposition. Further on, the respondent submitted additional evidence along with the rejoinder. The Opposition Board provided their recommendation on the submitted opposition and the evidence. Thereafter the petitioner filed expert affidavit, which was rejected by the Controller, hence the petitioner has approached the Hon'ble Madras High Court with writ petitioner. Meanwhile the Controller has allowed the filing of additional evidence. Hence the petitioner and respondent has filed further evidence. Thereafter the petitioner has again filed the amended claims and before considering these post grant amendments the Controller has scheduled the hearing. Thus, the Petitioner has approached the High Court to seek the directions for considering the post grant amendments and constitution of fresh opposition board.

The Hon'ble Madras High Court has considered all the arguments from both parties and stated that the additional evidence placed on record by both the parties should be considered by the opposition board. The Court directed to reconstitute the fresh opposition board and stated that *"the newly constituted Opposition Board shall examine the entire evidence and the amended claims of the petitioner and provide its recommendations within a maximum period of two months from the date of constitution of such board."*

PRIYA RANDOLPH & ROHIT CHATURVEDI (Appellants) vs THE DEPUTY CONTROLLER OF PATENTS AND DESIGNS (Respondent)

Case Number: OA/13/2018/PT/CHN
Decided on: December 20, 2023

The current appeal has been filed by the appellants in Madras High Court against the respondent for refusing the patent application (201641026786) on grounds of being deemed a business method under Section 3(k). Particularly, the patent application faced initial rejection, being labelled as a computer program per se during office action and subsequently as a business method during the Hearing proceeding.

The appellants contended that their invention was not merely a business method but a technical solution contributing to enhanced privacy and data protection in e-commerce. On this, the Respondent maintained the business method classification under Section 3(k).

The Hon'ble Court scrutinized Section 3(k) and the recent updated CRI Guidelines, emphasizing that a claim must substantially be categorized as a business method. It observed that while the appellant's invention might find application in a business context, its primary nature pertained to a technical process involving hardware and software for data privacy, thereby not qualifying as a business method per se. Accordingly, the Hon'ble Court set aside the impugned order, remanding back the matter to the Patent Office for reconsideration with a deadline of 4 months.

ABBVIE INC. (Appellant) vs THE DEPUTY CONTROLLER GENERAL OF PATENTS, DESIGNS & TRADE MARKS (Respondent)

Case Number: (T) CMA (PT) No.150 of 2023 (OA/61/2020/PT/CHN)
Decided on: December 20, 2023

This case presented before Hon'ble Madras High Court (CMA (PT) No.150 of 2023) provides a detailed analysis of the technical aspects of Section 3(d) of the Indian Patents Act, 1970 in determining the patentability of the claimed invention.

The appellant contested the decision of the Deputy Controller of Patents & Designs, who had refused a patent for the compound RTA408, particularly in its polymorphic forms. The appellant sought the setting aside of the impugned order and the grant of a patent concerning Indian Patent Application No. 7096/CHENP/2015. The appellant argued that the polymorphic forms of RTA408 demonstrated notable technical advancements, including enhanced stability, solvent-free characteristics, and superior anti-inflammatory, anti-oxidative, and anti-proliferative properties.

The respondent countered by invoking Section 3(d) of the Patents Act, asserting that the claimed invention represented a new form of a known substance. The known substance, according to the respondent, encompassed compounds like TX63682. The respondent contended that the alleged polymorphic forms lacked inventive merit and failed to exhibit significant improvements in efficacy.

The Hon'ble Madras High Court, in its judgment, ruled that Section 3(d) was not applicable as RTA-408 was not a known substance before the priority date of the claimed invention. Moreover, the Court acknowledged the technical advancements put forth by the appellant regarding the polymorphic forms, deeming claims 1-6 to have merit. However, the composition claim (claim 7) was rejected under Section 3(e) due to the absence of evidence demonstrating synergy between the ingredients. Consequently, the Hon'ble Court directed that Patent Application No. 7096/CHENP/2015 should proceed towards grant based on claims 1-6, with the exclusion of claim 7.

SELFDOT TECHNOLOGIES (OPC) PVT. LTD. (Appellant) vs CONTROLLER GENERAL OF PATENTS, DESIGNS & TRADE MARKS (Respondent)

Case Number: (T)CMA(PT)/61/2023 (OA/11/2021/PT/CHN)
Decided on: November 28, 2023

The current appeal has been filed by the appellant against the respondent for rejecting the appellant's patent application no. 201843023004 on the ground of contravention of Section 39 of the Patents Act, 1970 (the Patents Act). The appellant had previously filed the patent application no. 2822/CHE/2014 in India thereafter filed the same application as a PCT application, the corresponding application in USPTO. The appellant later decided to file the patent of addition without obtaining permission under section 39 of the Patent Act and the appellant has obtained the grant for both US application. Therefore, the appellant has filed the Patent of addition in India, which was rejected by the respondent under section 40 stating that the patent applicant contravened Section 39 of the Indian Patents Act, 1970. The appellant argued that the permission under Section 39 was not required for this Patent of addition as the main application was firstly filed in India, and also the invention was not relevant for defence purposes or related to atomic energy to be eligible for refusal under Section 40 of the Patents Act, 1970. The respondent submitted that the mandate of Section 39 of the Patents Act is clear, and it does not admit any exception for a patent of addition.
The Hon'ble Madras High Court observed the following issue and noted that previously the scope of section 39 was limited to inventions relevant for defence purposes or related to atomic energy and later when the scope of section 39 was expanded, the provision of Section 40 was not amended, therefore *"the breach committed by the appellant would, at worst, qualify as a technical breach but would not trigger the deemed abandonment under Section 40 of the Patents Act".* The Court directed the respondent to reconsider the patent application by imposing the procedural violation by taking recourse to Rule 137 of the Patents Rules 2003 or any other applicable provision, after providing a reasonable opportunity to the appellant.

NRIPENDRA KASHYAP ESCO CORPORATION (Appellant) vs ASSTT. CONTROLLER OF PATENTS AND DESIGNS (Respondent)

Case Number: C.A.(COMM.IPD-PAT) 209/2022
Decided on: November 24, 2023

The current appeal has been filed by the appellant in Delhi High Court against the respondent for refusing the divisional patent application for lack of plurality of invention. The refusal order has been issued under Section 16 of the Patents Act, stating that claim 1-4 in divisional application does not relate to claim 1-10 of the parent application. The appellant argued that the respondent did not raise this issue in the first examination report (FER) nor in hearing notice. The respondent counter argued that such practice of raising the objection during the hearing is common in Indian Patent office and the appellant has given an opportunity to respond to this objection.
The Hon'ble Court observed the following issue and noted that such procedure is not sustainable in law and stated that *"If any additional objections arise during the course of hearing, the patent office would, at the very least, have to set out the said objections in writing and grant the patent applicant an opportunity to respond, in writing, thereto."* The Court concluded by assigning the application to a competent Assistant Controller for *de novo* adjudication and to give an opportunity of hearing to the appellant.

TRADEMARKS CASES:

CABLE NEWS NETWORK (Plaintiff) vs CITY NEWS NETWORK AND OTHERS (Defendants)

Case No.: CS(COMM) 272/2021& I.A. 7235/2021
Decided On: December 04, 2023

The suit has been filed by the plaintiff against the defendant for the infringement of its trademark. The plaintiff alleged that the defendant is using a similar trademark which can potentially deceive its viewers. The plaintiff has a registered trademark for his trade as 'CNN'.
Defendant operates a public website with the label "CNN City News Network". The Hon'ble Delhi High Court observed that the acronyms "Cable News Network" and "City News Network" are bound to result in confusion in the eyes of an ordinary person. The plaintiff is thus entitled to a permanent injunction against the defendant to stop the use of the trademark. The Hon'ble Court further mentioned that any similarity in marks that can result in confusion and misrepresentation in the eyes of the public is bound to scrutiny.

FRANKFINN AVIATION SERVICES PRIVATE LIMITED (Plaintiff) vs TATA SIA AIRLINES LTD. (Defendant)

Case No: CS(COMM) 54/2022, I.As. 1795/2022, 3651/2022 & 3652/2022
Decided On: December 04, 2023

In the present suit, the plaintiff claimed protection of rights in its trademark 'FLY HIGH'. The plaintiff is engaged in the business of training staff for airlines and uses the marks 'FRANKFINN' and 'FLY HIGH'. The plaintiff was aggrieved by Tata Sia Airlines for using the mark 'FLY HIGHER'. An interim order was passed, according to which it was found that the defendant was not using 'FLY HIGHER' as a trademark but is only using it as a common usage of the said expression. Considering this as a petty issue, the defendant made a proposal by way of an email dated 26th July 2023 to the plaintiff, containing two conditions: the defendant will not file an application for registration of the mark 'FLY HIGH' or 'FLY HIGHER'; and the plaintiff agrees that use of 'FLY HIGH 'and 'FLY HIGHER' by the defendant for the purpose of advertising does not result in trademark use. The Hon'ble Delhi High Court directed that the defendant to not to claim any trademark rights in the expression FLY HIGH and FLY HIGHER nor shall it file any applications for registering it as a trademark. The defendant shall not oppose the trademark FLY HIGH of the plaintiff. The defendant is free to use FLY HIGH and FLY HIGHER in a non-trade mark sense as also as a part of keywords, advertising campaigns and hashtags. The decree acts in 'personam' and not in 'rem'. Hence, the Hon'ble Court passed the decree on the relevant terms agreed between the parties.

JOHNSON AND JOHNSON PTE. LTD. (Plaintiff) vs MR. ABBIREDDI SATISH KUMAR AND ORS. (Defendants)

Case No: CS(COMM) 801/2023 & I.A. 22015/2023, I.A. 22016/2023
Decide On.: December 07, 2023

The present suit has been filed by the plaintiff against the defendant for using a similar mark and similar trade dress to its registered marks, under which the defendant manufactures and sells fruit drinks in similar flavours as to the plaintiff. The plaintiff has a proprietary ownership of the marks 'ORSL'. The plaintiff asserted that they are using the marks consistently and have gained considerable goodwill along with great sale volume in the market. The Hon'ble Delhi High Court observed that the defendant has not only adopted the mark of the plaintiff, but they have imitated and copied the trade dress of the plaintiff. There is a clear similarity between the trade dresses of the products of the defendants and the plaintiff. The similar packaging and imagery used shows the intention of the defendant to confuse the consumer. All the necessary conditions for the grant of an injunction are fulfilled and hence the Hon'ble Court restraints the use of the said mark by the defendant and orders to stop any further circulation of the goods with the said mark.

CALVIN KLEIN TRADEMARK TRUST & ANR. (Plaintiffs) vs M/S GURU NANAK INTERNATIONAL & ORS. (Defendants)

Case No: CS(COMM) 75/2020 & I.A. 1318/2023
Decided On: December 08, 2023

The present suit was filed by two plaintiffs, namely Calvin Klein and Tommy Hilfiger, seeking permanent injunction restraining infringement of trademarks and copyright. The plaintiffs alleged that the defendants were counterfeiting their products and using their registered logos and labels. The Hon'ble Delhi High Court had granted an ex-parte ad interim injunction. A commissioner was appointed by the Hon'ble Court to execute a commission on the defendant's premises. The commissioner has seized substantial number of counterfeit products of Calvin Klein and Tommy Hilfiger. The Hon'ble Court said that the infringement indulged by the defendant was deliberate and calculated and thus is liable to pay damages to the plaintiff. The plaintiff was allowed to seize and destroy the counterfeit products.

GOOGLE LLC (Appellant) vs. MAKEMYTRIP (INDIA) PRIVATE LIMITED AND ORS. (Respondents)

Case No: FAO(OS) (COMM) 147/2022 & CAV 155/2022 & CM Nos. 27148/2022 & 27149/2022
Decided On: December 14, 2023

The appellant had filed the appeals impugning an ad interim order dated 27.04.2022 passed by the learned Single Judge in IA No. 6443/2022. The respondent had filed the present suit for the permanent injunction restraining infringement of its trademarks, passing off, dilution of goodwill, unfair competition and rendition of accounts of profits/damages etc. The respondent alleged that its competitor Booking.com has used its trademarks as keywords in Google Ads search engine, thus infringing its trademark. The question before the Court was whether the use of the trademarks of other companies as keywords in Google Ads infringe the trademarks' right of the proprietor. The Hon'ble Delhi Court observed that Booking.com and MakeMyTrip are popular websites, and that the chances of confusion between these two are less. The Hon'ble Court said that a

third party is allowed to pay for advertisement purposes by way of associating itself with a keyword of another party, as long as the other party is in the same line of business or industry and has a distinctive character and reputation of itself. Hence, the Hon'ble Court set aside the appeal. According to the order, a third-party trademark may be utilized in the bidding process for Google's AdWords advertising system as long as it does not confuse or deceive users regarding sponsored links and display ads.

COPYRIGHT CASE:

KOHLI SPORTS PRIVATE LIMITED (Plaintiff) vs ASHI SPORTS (Defendant)

Case No: CS(COMM) 858/2023I.As. 23949/2023, 23950/2023, 23951/2023 & 23952/2023
Decided on: December 01, 2023

The plaintiff has filed the present suit seeking permanent injunction restraining passing off, infringement of copyright, unfair trade practices, rendition of accounts, damages, etc. The plaintiff manufactures and sells helmets for cricket players since 2014 under the mark 'SHREY'. The plaintiff has great reputation in the industry. The plaintiff alleged that the defendant has copied the entire design of the plaintiff's cricket helmets as well as replicated the website of the plaintiff. The Hon'ble Delhi High Court observed that the documents given by the plaintiff to show the preference of the helmet is above par. It can be seen that the helmet is preferred internationally. The fact whether the helmet has a distinctive shape, so as to be protected as a shape trademark needs to be considered. The defendant shall take down its website and change its contents. The Hon'ble Court directed the parties to mediation.

902, Kamdhenu Commerz, Sector - 14, Kharghar, Navi Mumbai - 410210. MH, INDIA
+91 22 46083609 / +91 83739 80620
info@duxlegis.com

www.duxlegis.com

Editorial Board

This Newsletter is published by DuxLegis Attorneys from 902,Kamdhenu Commerz, Sector 14, Kharghar, Navi Mumbai, Maharashtra,India on 9th January, 2024.