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Newsletter | Issue 4 | April 2023



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## DELHI HIGH COURT SOLVES PATENT SPECIFICATION AMENDMENTS MYSTERY



Adv. Sphurti Dalodria



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**A**mending a patent specification is a legal process by which an applicant seeks to modify or change the content of their patent application after its filing.

The Indian Patents Act, 1970 provides provisions for the amendment of the claims, specifications and drawings of a patent application at various stages of the prosecution, including before and after grant.

The amendment process is guided by Section 59 of the Patents Act, which sets out the conditions and requirements for making amendments to a patent specification.

The amendment process plays a crucial role in determining the scope and validity of a patent and requires careful consideration of the original claims and complete specification, as well as the relevant legal precedents set by the courts. In this context, understanding the legal framework for amending a patent specification is crucial for ensuring the effective protection of intellectual property rights in India.

In several cases, the Indian Patent Office (IPO) had refused amendments citing provisions of section 59 of Patents Act, 1970 (Act). However, a plain reading of the provisions of section 57-59 of the Act provides that Applicants or Patentees are allowed to make amendments to their patent application at any time before or after the grant of the patent. The purpose of these amendments is to clarify the invention or distinguish it from prior art. But, the amendments must comply with the requirements and restrictions set forth in the Act and the Patents Rule, 2003 (as amended).

However, the IPO has never issued any clear guidelines for acceptable amendments, and amendments that do not meet these requirements of the Act. Section 59 defines the provisions

for amending the patent specification. According to Section 59 (1) of the Act, amendments can be made by way of disclaimer, correction or explanation. Furthermore, the amendments can be made to incorporate actual facts, and the amendments should be within the scope of a claim of the specification before amendments. As per Section 59 (2) of the Act, any amendment after the date of the grant of patent is allowed by the Controller if:

- (a) the amendment shall for all purposes be deemed to form part of the specification along with other documents related thereto;*
- (b) the fact that the specification or any other documents related thereto has been amended shall be published as expeditiously as possible; and*
- (c) the right of the applicant or patentee to make an amendment shall not be called in question except on the ground of fraud.*

During submissions of amendments, there is no clarity from the IPO which amendments are acceptable. Furthermore, some Controllers accept certain amendments, while others do not. There is no consistency in the consideration of amendments by the IPO. For example, the IPO objects to the addition of new claims. If the patent application discloses a method claim and the description supports a system that performs the claimed method, then the addition of system claims in amendments cannot be considered by the IPO. Additionally, if the applicant adds a technical portion from the description to the claims for clarity, some Controllers do not allow such amendments, only permitting claims with support from the originally filed claims. That means that applicants cannot add new claims which are not part of the original filed claims.

As per our observation, Section 59 clearly states that the amendments can be made by way of disclaimer, correction or explanation. If the amendments are fully supported by the description or drawings, then why such amendments are not considered by the Controllers of the Patent Office. Further,

the applicants cannot amend the original description of the Patent specification. The Patent Office had rejected such amendments under Section 59 of the Act. There is no limitation in Section 59 that confines the support of the amendments. In order to bring clarity by clearing confusion, Delhi High Court (DHC) has recently passed various orders.

## **DHC brings clarity on the amendments under Section 59 of the Indian Patent Act:**

Since applicants or patentees always had confusion about amendments to be carried out in the complete specification, including claims. There was no clear direction to the applicants or patentees for amending the claims. The addition of a new claim or extent of amendments to the original filed claims was always at the discretion of the Controller (IPO) for that matter.

There have been several cases where patent applications were rejected by the Controller of Patent under Section 59(1) of the Act.

In *AGC Flats Glass Europe SA v. Anand Mahajan 2009 (41) PTC 207 (Del.)*, the Id. Single Judge of this Hon'ble Court has clarified the legal position in relation to disclaimer vide amendment of claims. When the applicant seeks to narrow down or characterize the claims, ultimately limiting the scope of invention, the amendment ought to be ordinarily allowed. The only consideration that must be kept in mind is that the amended claims are not inconsistent with the earlier claims in the original specification. In the case of *Enercon (India) Limited vs. Aloys Wobben*, the IPAB had given finding that the scope of the claims had been widened by the addition of new terminology in the claims and therefore not allowable under Section 59 and Section 10(4) of the Indian Patents Act.

There are some recent judgments given by the Delhi High Court which throws clear light on the scope of amendments under section 59 of the Indian patent act. DHC has passed the fair judgments in the following two cases, wherein the decision was in the favor of Applicant and that provides more clarity on the nature of amendments that can be accepted in the claims of the complete specification.

**Nippon A&I Inc. v. The Controller of Patents, CS (COMM).IPD-PAT) 11/2022**  
Order dated July 5, 2022

### **Summary:**

DHC passed judgments in the matter of *NIPPON A&L INC. (Appellant) V. THE CONTROLLER OF PATENTS* (Respondent) on 5th July 2022. DHC had set aside the Controller's order for refusing the Patent application under section 59 and order the Patent office to reexamine the amended claims freshly on the ground of novelty, lack of inventive step, nonpatentability under Section 3(d) and 3(e) of the Act, in an expeditious manner. Accordingly, the Patent Office has recently examined the amended claims and granted the Patent application with amended claims. Briefly, as per the present judgment, there should not be any restrictions on the amendments, provided that the amendments do not broaden the scope of originally filed claims and the same is disclosed in the originally filed specification.

### **Case details**

The appellant has filed a national phase entry of international application PCT/JP2014/069608 in India bearing application no. 201617003704 dated 2nd February 2016, seeking patent protection for a “copolymer latex” product and process. The Application was examined by the Patent office (Respondent) and issued the First Examination report, objections relating to inventive step under Section 2(1) (ja) of the Act, non-patentability under Sections 3(d) & 3(e) of the Act were raised by the Patent Office. The appellant replied to the examination report along with an amended set of claims. The Respondent issued a hearing notice under section 14 of the Act.

One of the objections made in the hearing notice was that claims 1, 2, 4 and 6 were not properly drafted and the scope for which protection was sought was not clear. Appellant's agent attended the hearing and filed written submissions encapsulating the oral arguments along with a fresh set of amended claims. The Respondent has refused the Patent application on the ground that “the new set of claims was beyond the scope of the original claims. The original claims were 'product claims' relating to 'copolymer latex' which were now sought to be amended/converted by the Appellant to 'method/process' claims. The amendment from 'product claims' to 'process claims' was not supported by the description” and the amended claims lack the inventive step. The Appellant filed an appeal against the said order, and this present decision was rendered as a result.

### **Court proceeding:**

The Id. counsel appearing for the Appellant has relied upon Article 123 of the European Patent Convention, 1973 (hereinafter 'EPC') and the decision of the European Board of Appeals in *Konica/Sensitizing [1994] EPOR 142* to argue that whenever product by process claims is amended and the applicant restricts the claims to only the process, the said amendment can be allowed in terms of Article 123 of EPC. He also relies upon the decision of the Asst. Controller of Patents, Patent Office, Kolkata in *Antacor Ltd. & Schweiger*,

*Martin* dated 18th July, 2017. As per the said decision, the amendment of 'product by process' claims to 'process only' claims, under similar circumstances, for making the claims clearer and more definite was held to be permissible. Id. Counsel for the Appellant also relies upon the decision in *The Polymer Corporation's Patent [1972] RPC 39* to argue that amendments by way of an explanation, which turn ambiguous claims to clearer claims, ought to be permitted.

The Id. counsel appearing for the Respondent has made a two-fold submission before the Court:

*“Product by process claims are primarily product claims and are tested for novelty and inventive step qua the product and not the process. The Appellant, by removing the product related claims and converting them into process claims, is changing the very nature of the claims which is impermissible. It is his submission that when a 'product by process' claim is deemed to be in effect a 'product' claim, the conversion of a product claim to process claims is impermissible under Section 59 of the Act. Thus, he submits that the present application has been rightly disallowed by the Patent Office.”*

*“The original claims as filed by the Appellant were not actually 'product by process' claims and they were merely 'product' claims and the focus of the claims as originally filed was only a product, namely, 'copolymer latex'. In the originally filed claims there are no details about the process in which exclusivity is claimed. He, further, submits that the language in the specification cannot be used to change the claims of the patent from one subject matter to another.”*

### **Findings of the court:**

The Court had referred to the case of *Konica/Sensitizing [1994] EPOR 14*. In this case, the European Technical Board of Appeal had categorically held that the conversion and the change in category of 'product by process' claims to 'process' claims is clearly admissible under Article 123 of the European Patent Convention. The Court further mentioned that the Indian Patent Office had itself wanted clarification as to whether protection was pursued for a product or process and could not therefore hold the view that process was originally disclaimed. Thus, the objections under Section 59(1) of the Act were held not sustainable.

The court has finally stated that *“the Applicant is amending and narrowing the scope of the claims and not expanding the same. The process sought to be claimed in the amended claims has been clearly disclosed in the patent specification. The said process is not sought to be added newly by way of an amendment. The amendment is, thus, within the scope of the patent specification and claims as originally filed. In the opinion of the Court, the amended claims of the Appellant satisfy the conditions of Section 59(1) of the Act as specified above. Thus, the objection under Section 59(1) of the Act is not sustainable.”*

## **Allergan Inc v. The Controller of Patents, C.A. (COMM.)IPD-PAT) 22/2021**

Order dated January 20, 2023

### **Summary:**

Delhi High Court (DHC) in *Allergan Inc (Appellant) v The Controller of Patents (Respondent)*, on January 20, 2023, ruled on the allowability of claim amendments under Section 59 of the Patents Act. DHC has set aside the Indian Patent Office's refusal order. The Patent office had rejected a patent application on the grounds that the amended claims did not fall wholly within the scope of the originally filed claims. Amendment was related to converting claims directed to a method for treating an ocular condition using an intracameral implant into a product claim, specifically for the intracameral implant itself.

### **Background of the case:**

The Appellant had filed a national phase application numbered as 7039/DELNP/2012 on 13th August 2012, entitled as “INTRACAMERAL SUSTAINED RELEASE THERAPEUTIC AGENT IMPLANTS” with 20 claims drafted as method claims. On 6th November 2017, the Indian Patent office has issued an examination report with an objection that the Claims in the patent application were not patentable as they related to the method of treatment of human beings/animals, in respect of which Section 3(i) of the Patents Act, 1970 (the Patents Act) forbore grant of patent. As a reply to this examination report, the Appellant has amended the claims, reducing the number of claims from the earlier 20 to 5. The Appellant has amended the claims as “an intracameral implant”. Based on a reply to the examination report, the respondent issued a personal hearing, which reiterated several of the objections contained in the FER and the objection that the amended claims for “intracameral implants” has not been claimed either in the WIPO claims or while entering in the national phase. The respondent then refused the Patent application on the ground that “the amendments of the present invention the set of amended claims does not fall within the scope of the as originally filed claims as per the any clauses of the section 59 (1) of the Patents Act, hence as the amended sets of claims are not allowable u/s 59 of the Act, it is of the opinion that there is no need to discuss the rest of the objections/sections with respect to the hearing notice for the present invention”.

As a result of this refusal notice, the appellant filed an appeal with the Delhi High Court.

### **Court proceeding:**

During the court proceedings, the appellant has submitted that

- The learned Controller has not examined the aspect of patentability of the claims of the appellant as amended.
- The reason for rejection provided in the hearing notice and the refusal order are not identical.
- There are differences in the patentability regime in different countries. The present application has filed the priority application in US, where the method of treatment claims is patentable subject matter but the same is not patentable in India. And, it would be impractical to expect that the claims in the original PCT application, as filed would be patentable in every designated country.
- The amendment cannot be held to be beyond the scope of the original claims because the original claims as well as the complete specification contain the support for the composition claims as amended and it could not be considered non-permissible under Section 59 of the Act, the respondent submitted that while examining the permissibility of an amendment seeking to amend the claims as originally applied for, the authority, or the court would have to examine the amended claims with the original claims. The complete specifications accompanying the original claims are entirely immaterial in such consideration. The amendment cannot be allowed merely because the amended claims fall within the scope of the pre-amended complete specifications (except, possibly, where the amendment was by way of a correction of the claim).

### **Finding of the court:**

After hearing both sides, DHC ruled that the interpretation of section 59 by the learned controller was incorrect. The subject patent contains a large part of the complete specifications dealing with implants and their compositional constitution. The claims and complete specification in a patent must be read together and as a whole. They cannot be treated as two distinct parts of one document, and the claims have to be understood in the light of the complete specifications. DHC has set aside the impugned order passed by the respondent. The amended claims of the appellant are to be returned to the learned Controller for a fresh consideration of their patentability.

### **Conclusion:**

From the above-discussed case law, it can be observed that the Delhi High Court is providing a clear idea about the amendments that can be carried out as per section 59 of the Patents Act. The trend of allowing amended claims by adding subject matter supported by the originally filed complete specification is being set by the DHC. The above decisions from the DHC provide a

consistent practice that can be followed by the Patent office when considering amendments under section 59 of the Act.

From “*Nippon A & I Inc. V. The Controller of Patents*” decision, it is clear that the applicant can amend / restrict the claims provided that the amendments do not broaden the scope of originally filed claims and the same is disclosed in the as filed patent specification.

The judgment in *Allergan Inc v The Controller of Patents* seems to be a benchmark/landmark judgment for the cases of PCT national phase applications. The Applicant can amend the claims as per the Patent regime followed by India, provided that the amendment is supported by the complete specification and falls within scope of the originally filed complete specification. In such cases, the Patent office must examine the amended claims for the other aspect of the patentability.

## COMPUTER-IMPLEMENTED INVENTION - HUAWEI EP PATENT REJECTED BY EPO BOARD OF APPEAL

By Divyendu Verma & Sphurti Dalodria

This matter is in relation to the European Patent Application related to Signal Processing Method and Device by Huawei Technologies Co, Ltd (China). The EPO's examining division had rejected the patent application for lack of inventive step as it considered that the claimed features of the main claim and the second auxiliary claim related to a non-technical, purely mathematical method applied to abstract data. Huawei appealed before the EPO Board of Appeal.



Here are a few examples:

1. T 489/14 (Pedestrian simulation/CONNOR) - In this case, the EPO considered a patent application related to a computer-implemented method for simulating pedestrian movement. The EPO rejected the application, finding that the invention related to a mathematical method and did not involve a technical effect.

2. T 0489/18 (Learning from rejection/IBM) - In this case, the EPO considered a patent application related to a computer-implemented method for training machine learning models. The EPO granted the patent, finding that the invention involved technical features that went beyond the mathematical algorithms used in the machine learning process.

3. G1/19 (Patentability of computer-implemented simulations) - This case was a referral to the Enlarged Board of Appeal of the EPO, which was asked to clarify the patentability of computer-implemented simulations. The Enlarged Board of Appeal concluded that simulations that represent technical systems or processes and solve a technical problem are patentable, even if the simulation itself is based on a mathematical method.

These cases demonstrate that the patentability of computer-implemented inventions can be a complex and evolving area of law, and that the distinction between technical features and mathematical methods can be crucial in determining patentability.

Therefore, it is important for the applicants to work with experienced patent attorneys who can provide guidance on how to draft patent applications that meet the technical requirements for patentability.



EPO Board of Appeal (T 2792/18) is decided that the method is a mere automation of an intrinsically non-technical mathematical transformation method by means of a known electronic device. Therefore, the subject-matter of claim 1 of the main request does not meet the requirements of Article 56 EPC and dismissed the Huawei's appeal in its entirety.

This decision again highlighted the importance of carefully drafting patent applications for computer-implemented inventions to ensure that they meet the technical requirements for patentability.

There are several recent cases that have dealt with the patentability of computer-implemented inventions and the distinction between technical features and mathematical methods.



## IP SNIPPETS:

### DOLBY INTERNATIONAL AB (Appellant) vs THE ASSISTANT CONTROLLER OF PATENTS AND DESIGNS (Respondent)

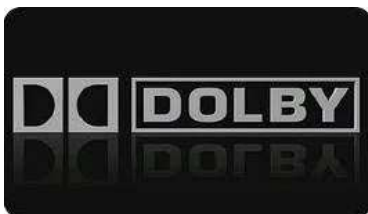
Case Number: C.A.(COMM.IPD-PAT) 10/2021 and I.A. 13552/2021 Decided on: 14th March, 2023

In the present case, the respondent i.e., the Assistant Controller of Patent and designs has refused the Patent application number 6570/DELNP/2009 filed by the Appellant. The Appellant has filed an appeal against this refusal order. While observing the impugned order the Delhi High court has noted that the order passed by the respondent lacks the proper reasoning and most of the part of order is just a copy pasted matter from FER and hearing notice. The Hon'ble high court stated that the "refusal order is most unsatisfactorily drawn up and it is hardly possible to treat it as written or drafted". The reason for refusal was

as submitted only in single sentence.

While giving the decision, the DHC states that "A patent is meant to be a recognition of the innovative step that has been put into a crafting of an invention. Inventions increment the state of existing scientific knowledge and, thereafter, are of inestimable public interest. Any decision, whether to grant or refuse a patent has, therefore, to be informed by due application of mind, which must be reflected in the decision. Orders refusing applications for grant of a patent cannot be mechanically passed".

The matter has been remanded back to the Indian Patent office, but the matter would not be decided by the officer who has passed the impugned order.



### TAPAS CHATTERJEE (Appellant) vs THE ASSISTANT CONTROLLER OF PATENTS AND DESIGNS (Respondent)

Case Number: C.A.(COMM.IPD-PAT) 18/2022 & I.A. 3580/2022 Decided on: 10th March, 2023

In the present case, the Appellant has filed an appeal before the Delhi High court impugning the order of the respondent no. 1 refusing the patent application No.



201911036748 of the appellant. The Patent was refused on the grounds mentioned under Section 3(d) and lack of inventive step under Section 2(1) (ja).

The DHC has provided the interpretation of section 3 (d) in view of "known process". The DHC is of opinion that " a patent can be granted in respect of a "known process" only when such a "known process" results in a new product or employs at least one new reactant. There is a material difference between the terminology "discovery of a new form of a known substance" and "mere use of a known process". In the case of discovery of new form of a known substance, the patent can be granted only if the said new form results in enhancement of the known efficacy of the substance, whereas there is no such provision for enhancement of known efficacy in respect of known processes. Therefore, the scope for patentability of processes is narrower than substances."

The invention of present case does not involve use of new reactant or does not result in production of new product, thus the order given by the respondent is correct.

Further DHC stated that the subject patent application does not appear to be constituting a technical advancement over prior arts, which would be non-obvious to a person skilled in the art hence the refusal on ground of lack if inventive step is justified.



## TRADEMARK CASES:

### WINZO GAMES PRIVATE LIMITED (Appellant) Vs. GOOGLE LLC & ORS (Respondent)

Case Number: CS(COMM) 176/2022 Decided on: 14th February, 2023

The Delhi High Court held that displaying a warning prior to downloading is in the nature of a disclaimer and does not result in a trademark infringement. The warning is a security feature so as to protect consumers from any possible malware. In this case, the defendants are not using the plaintiff's trademarks 'in the course of trade', which is a sine qua non for trademark infringement/tarnishment action. The users can continue to download and install the APK files by clicking on the option of 'Download anyway'. The APK



files/applications like that of the plaintiff are not part of the 'Google Play' ecosystem and therefore, the same do not undergo the various security checks and measures.

**PIDILITE INDUSTRIES LIMITED (Appellant)  
VS. CHIRIPAL INDUSTRIES LIMITED  
(Respondent)**

Case Number: Interim Application (I) No. 12828 Of 2021  
With Leave Petition (I) No. 12825 Of 2021  
In Commercial Ip Suit No. 452 Of 2021  
Decided on: 09th March, 2023



The plaintiff has filed the present suit and application for interim reliefs in the context of its registered trademarks and copyrights concerning its various products in the business of construction material, chemical products and additives. The plaintiff claims that the defendant has infringed and also committed torts of passing off pertaining to the marks in which plaintiff claims proprietary rights. The plaintiff alleged that the defendant's marks 'Heat-Tik', 'LWP+', 'Mr. Engineer' and 'Tikawoo' were deceptively similar to their trademarks and house marks, including HEATX, FEVICOL, LW+, LW, DR. FIXIT and an artistic depiction showing two elephants, in the backdrop of Sunset, pulling in the opposite direction. The High Court of Judicature at Bombay held that the artistic depiction showing two elephants in the backdrop of Sunset, pulling in the opposite direction was not similar to the 'Tikawoo' logo having a Rhino with a sunset. The Hon'ble Court also held that 'Dr. Fixit' and 'Mr. Engineer' were not similar. However, the Hon'ble Court held that the 'Heat-Tik', 'LWP+' of the defendant were similar to the plaintiff's 'Heat X' and 'LW+' and 'LW'. The Hon'ble Court states that the comparison of the marks actually shows there is deceptive similarity. The Hon'ble Court held that accepting the contention pertaining to common to trade, the defendant would have to pass the stringent test of demonstrating extensive use of the said mark.

**TATA SIA AIRLINES LIMITED (Appellant)  
vs VISTARA BUILDTECH LLP &  
ANR (Respondent)**

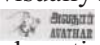
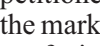
Case Number: CS(COMM) 116/2023  
Decided on: 3rd March, 2023



In this case, the petition is filed by the petitioner against the defendant regarding the use of the marks and The word mark "VISTARA", the device mark and the colour combination mark belong to the petitioner. The petitioner has the commercial aviation industry in collaboration between Tata Sons Pvt Ltd and the Singapore Airlines Ltd, under the mark VISTARA. The impugned marks were used by the defendants in connection with commercial properties. The petitioner seeks an injunction against the defendants using the impugned marks, as the marks infringe the registered trademarks of the petitioner and are likely to lead an unsuspecting consumer to believe that defendants' activities have some association with the plaintiff. The Hon'ble Delhi High Court restrained defendants from using the mark 'VISTARA' in any manner till the next date of hearing in a plea filed by the petitioner.

**TWENTIETH CENTURY FOX FILM  
CORPORATION (Appellant) vs  
THE REGISTRAR (Respondent)**

Case Number: C.A.(COMM.IPD-TM) 162/2022, I.A.  
21666/2022 (Section 151 of the CPC) and I.A. 21667/2022  
(Order XLI Rule 27 of the CPC)  
Decided on: 27th February, 2023

In the present case, the Senior Examiner of the Trade Marks Registry, New Delhi rejected the trademark application of the petitioner's mark **AVATAR** in Class 14, for —Alarm clocks; bracelets; busts of precious metal; charms; clocks; earrings; jewellery etc. As per the Examiner, the mark was visually and phonetically similar to the mark **AVATHAR** and . However, the petitioner stated that the mark was phonetically and visually different. The overall impression of the cited marks is also different, and the goods related to the cited marks were also different from that petitioner's mark. The only ground on which registration of the mark of the petitioner has been refused is that it is deceptively similar to the mark  and that the similarity was likely to result in confusion. The cited mark consists of the word —AVATHAR in English and Tamil, with the sketch of the face of a lady and this mark was registered as a whole, not individually. This mark has to be compared as a whole so there is no possibility of confusion. Therefore, the Hon'ble Delhi High Court is of the opinion that the senior examiner erred in merely emphasising the phonetic similarity between 'AVATHAR' and 'AVATAR', without recognising the fact that the cited mark was a composite device mark containing a sketch, as well as the word AVATHAR written in two languages, compositely registered, with no registration of its individual parts or elements. The Hon'ble Court passes an order to the defendant to advertise the mark.

**M/S. M.L. BROTHERS LLP (Appellant) vs UMA IMPACT PRIVATE LIMITED & ANR (Respondent)**

Case Number: CS(COMM) 132/2019 & I.A. 3577/2019  
Decided on: 19th January, 2023

In this case, the plaintiff restrained the defendant from using, selling, and manufacturing electronic goods as it was similar to the plaintiff's U-BORN packaging and products. They were also restrained from using the expression "BORN TO WIN" for identical class of products as it was found to be a similar to plaintiff's tagline – "BORN TO BE FREE". The plaintiff stated that the defendant motives was to capitalize on the plaintiff's well-established reputation and goodwill. The Hon'ble Delhi Court stated that in order to bring and succeed in a common law action of passing off, plaintiff must satisfactorily prove the three essential elements. It must first establish goodwill or reputation attached to its goods or services; second, it must prove that defendants are guilty of intentional or reckless misrepresentation, which is likely to lead to public belief that goods and services offered by Defendants are that of Plaintiff's; third, plaintiff must also demonstrate that Defendants' misrepresentation has resulted in loss or damage to Plaintiff. For this, the plaintiff has not presented any evidence for these elements. The Hon'ble court has dismissed the case.

**TTK PRESTIGE LTD (Appellant) K K AND COMPANY DELHI PVT LTD & ORS (Respondent)**

Case Number: CS(COMM) 864/2022  
Decided on: 20th February, 2023

In this case, the Hon'ble Delhi High Court observed that the use of the trademark 'PRESTIGE' by the defendant in respect of 'gas stoves' is likely to cause confusion in the market as the public at large would associate the said products of the defendant with the plaintiff. A prima facie case of infringement as well as passing off is made out on behalf of the plaintiff. The plaintiff claimed that the use of the mark "Prestige" by the defendants was an infringement of their trademark and causing confusion among customers, leading to loss of business. The Delhi High Court held that the defendant had failed to provide evidence to prove that it had actually sold its goods using the impugned marks other than two newspaper advertisements and a few trade enquiries, establish use of the impugned trademark prior to the registration granted in favour of the plaintiff, and being a 'continuous user' of the trademark.

**AKTIEBOLAGET VOLVO & ORS (Appellant) VOLVO WHITE PAINTS INDUSTRIES & ORS (Respondent)**

Case Number: CS(COMM) 198/2022 & I.A. 4963/2022 (O-XXXIX R-1 & 2 of CPC)  
Decided on: 07th February, 2023

The Hon'ble Delhi High Court passed a summary judgement in favour of the Plaintiff restraining the defendants from using deceptively similar plaintiff's marks "Volvo". In this case, the present suit has been filed by the plaintiff seeking relief of permanent injunction restraining the defendants from infringing the trademarks, passing off their goods and other ancillary reliefs. Plaintiff no. 1, AB Volvo, plaintiff no. 2, Volvo Trademark Holding AB and plaintiff no. 3, Volvo Car Corporation, have their core business in transportation and an automotive sector, manufacturing spare parts, accessories and ancillary parts for vehicles all under the trademark "VOLVO". Whereas the defendants are engaged in the business of manufacturing, dealing, selling/supplying products like wall putty, tile adhesive, LWC, Gypsum plaster etc., under the trade name "Volvo White Paints Industries". The packaging of the products of the defendant no. 1 also bears the marks, VOLVO White Wall Putty, VOLVO White Tile adhesive, VOLVO White LWC, etc.



which infringes the plaintiff's registered and well-known trademark "VOLVO". During proceedings, two Local Commissioners were also appointed by the Hon'ble Court to seize and inventorize the infringing goods bearing the mark "VOLVO". The defendant has used the infringed mark to take the advantage of the goodwill, name and reputation of the plaintiff.

**ASTRAL LTD (Appellant) vs ASHIRVAD PIPES PVT LTD (Respondent)**

Case Number: CS(COMM) 309/2022, I.A. 8856/2022 (O-XI R-1(4) of CPC), I.A. 9750/2022(O-XI R-1(10) of CC Act), I.A. 12468/2022(u/s 124 of Trade Mark Act) and I.A. 19036/2022(O-XI R-1(4) of CPC)  
Decided on: 23th February, 2023

The Delhi High Court observed that the usage of the distinctive house marks of the parties negates any possibility of deception or confusion in the marks. The Hon'ble Court also observed that at the interlocutory stage, the plaintiff cannot claim monopoly over the words 'CPVC' or 'PRO' either individually or in conjunction with each other/other words and these registrations cannot be relied upon by the plaintiff in the present suit for infringement. Further, it is a settled position of law that generic, laudatory and descriptive marks cannot be monopolized by anyone unless a case is made out in respect of mark acquiring distinctive character or of its well-known status. Additionally, the fact that conditions were imposed on the plaintiff by the Registry, against the use of generic terms like 'CPVC PRO' and 'CPVC CHEM PRO', is clearly indicative of the fact that the plaintiff cannot monopolize the terms 'CPVC' or 'PRO', individually or in conjunction with each other. Therefore, the plaintiff has failed to make out a prima facie case for grant of interim injunction.

## RECENT IP UPDATES

### NEW TRADEMARK LAW IN MYANMAR EFFECTIVE FROM APRIL 01, 2023



The Intellectual Property Department (IPD) of Myanmar recently announced that the second phase of the "soft opening period" for the new trademark law will commence on April 01,

2023. Trademark applications filed during the soft opening period must be supported by a declaration of ownership and/or evidence of use prior to April 01, 2023. Now, trademark owners can pay the official fees for their earlier-filed applications during the soft opening period

### NEW IP MINISTER IN UK FOR SCIENCE, INNOVATION AND TECHNOLOGY



Viscount Camrose has been appointed Parliamentary Under Secretary of State in the newly formed Department for Science, Innovation and Technology, with responsibility for intellectual property.

He has been given an important role in the UK government's efforts to promote science,

innovation, and technology. His specific responsibilities include intellectual property and artificial intelligence. The UK government is hoping to make the country a top destination for startups, inventions, and development, and they believe that progress in AI will be key to achieving this goal. With Viscount Camrose's appointment, it seems that the UK is taking steps to prioritize these areas and position itself as a leader in the field of innovation.

### BCI ALLOWS REGISTRATION OF FOREIGN LAWYERS AND LAW FIRMS IN INDIA



By a notification dated March 10, 2023, the Bar Council of India (BCI) has issued rules for registration and

regulation of foreign lawyers and law firms in India. According to the rules, foreign lawyers will have a limited area of work. They will be allowed to advise their clients on foreign and international laws only, and for this purpose, they must be registered under the BCI. They will not be permitted to appear in any Court, Tribunal, Board, before any Statutory or Regulatory Authority or any other forum that is legally entitled to take evidence on oath and/or has the trappings of a court.

The entry of foreign lawyers will be on a reciprocal basis only, which means that lawyers from only those countries will be permitted in India where Indian lawyers are also permitted to practice. The BCI has implemented these rules to enable foreign lawyers to handle diverse international law and international arbitration matters in India in a well-defined, regulated, and controlled manner. A foreign lawyer or foreign law firm may apply for registration along with the registration fee and a guarantee amount. This application and fee may also be submitted online. The registration will be valid for a period of five years only, and the foreign lawyer and/or law firm will be required to renew it by filing an application for renewal within six months before the expiry date. The security deposit is returnable to the foreign lawyer or Foreign Law Firm when they voluntarily terminate foreign law practice in India, or when the registration expires or is permanently cancelled.

### INAUGURATION OF INTELLECTUAL PROPERTY DIVISION (IPD) FOR MADRAS HIGH COURT



The writ petitions were filed by the petitioners, M/s. Galatea Limited, seeking a writ of Mandamus to direct the first respondent (The Registrar General High Court of Judicature at Madras,

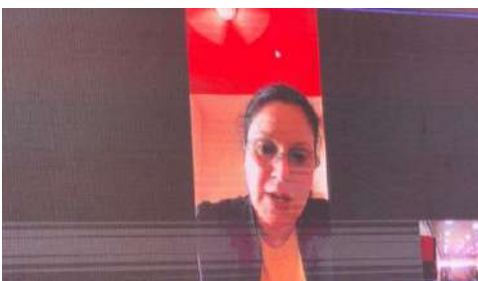
Chennai) to consider the representation of the petitioner dated 28.07.2022, to frame Rules to transfer pending cases from the former Intellectual Property Appellate Board, Chennai and to register petitioner's case bearing No. OA/1/2021/PT/CHN, which was pending for decision before the former Intellectual Property Appellate Board, Chennai, as on 04.04.2021 and list it before the appropriate Bench of this Hon'ble Court. In an order dated March 07, 2023, the respondent has stated that he has already addressed the Government to notify the Madras High Court Intellectual Property Rights Division Rules, 2022 in the official Gazette and is awaiting notification from the State Government. The respondent is also prepared to inaugurate the Intellectual Property Division within a week of the date of such notification by the Government. The Court has granted a week's time to the Government to issue notification with the IPD Rules, except with the rule related to court fees. The Court has directed the first respondent to make necessary arrangements to inaugurate the IPAB Division of this Court once the Rules are notified in the official Gazette.

## DUXLEGIS ATTORNEYS ALONG WITH LES INDIA & LOKJAGAR FOUNDATION JOINTLY ORGANISED “IP & START UP CONCLAVE-2023” AT AKOT, INDIA

We are thrilled to announce the successful completion of our "IP & START UP CONCLAVE-2023" at Akot, India. DuxLegis Attorneys, a leading Intellectual Property (IP) law firm collaborated with LES India & Lokjagar Manch, to conduct the Conclave at Akot, a deep rural part of the state of Maharashtra.



Divyendu Verma, National Chair of TDM Committee of LES India & Managing Partner of DuxLegis Attorneys, Sphurti Dalodria, Managing Associate of DuxLegis Attorneys, Adv. Richa Pandey, President LES India & Pramod Chunchuwar, Director of DuxLegis Attorneys addressed the conclave and workshop on IP & Start Up Ecosystems in India. From overseas, Paa S Jallow, Director of DuxLegis IP LLC Washington DC, Sarmad Hasan Manto, Managing Partner of Audri Vox, Dubai and Heena Sharma, IP Attorney at Alfred Mann Foundation, Log Angles, USA addressed the gathering online.



The conclave was attended by more than 400 participants which includes youths and women self help group members. The women largely from Agriculture background asked many queries about start ups and shared their business ideas.



Divyendu Verma explained the Start UP Policy of Government of India and Maharashtra State Government in detail. LES India President - Adv. Richa Pandey explained the importance of LES and benefits of LES in Start UP Ecosystem in India. She also explained concepts of Designs, Trademarks and Patents in simple words.

“Generally, such conclaves are held at Metros. The conclave will help boosting rural economy, which is currently largely dependent on agriculture and will help to create alternatives of income generation,” told Anil Gawande of LokJagar Manch.



“We are excited about this initiative and look forward to working with rural communities across the Maharashtra state as well as India to promote IP awareness and education. We believe that everyone deserves to benefit from the protection of their intellectual property, regardless of where they live,” told Adv. Divyendu Verma of DuxLegis Attorneys.



**Success Stories for participants:**  
 Successful start up founders were felicitated in this event. Sameer Joshi, Founder & Chairman Transcender Services Pvt. Ltd, Ajinkya Kottawar, President Dnyan Foundation, & Naman Komre, Mumbai based software expert and CEO of NEVO Mobiles Pvt. Ltd were felicitated at this Conclave. They all shared their success stories which inspired the participants.



Event was widely covered by local media and we are very thankful to them as well as Lokjagar manch to provide much needed local support to make this event success.



Few press coverage is attached with the report:

**स्टार्टअप अंतर्गत शेतकऱ्यांच्या पंखांना बळ मिळेल**  
**अनिल गावडे : अकोटात पहिले स्टार्टअप कॉन्क्लेव्ह उत्साहात**

**शेतीकडे युवकांनी वळणी काढची गरज**

अकोटा येथील शेतकरी संघात, शेतीकडे वळणी काढण्यासाठी युवकांना प्रोत्साहित करणारे पहिले स्टार्टअप कॉन्क्लेव्ह उत्साहात आयोजित करण्यात आले. यावेळी अनेक शेतकरी, युवक, महिला, विद्यार्थी, शिक्षक, तसेच स्थानिक प्रशासनाचे अधिकारी उपस्थित होते. यावेळी अनेक शेतकरी, युवक, महिला, विद्यार्थी, शिक्षक, तसेच स्थानिक प्रशासनाचे अधिकारी उपस्थित होते. यावेळी अनेक शेतकरी, युवक, महिला, विद्यार्थी, शिक्षक, तसेच स्थानिक प्रशासनाचे अधिकारी उपस्थित होते.

**विदेशातील उद्योजकांचे ऑनलाइन मार्गदर्शन**

अकोटा येथील शेतकरी संघात, शेतीकडे वळणी काढण्यासाठी युवकांना प्रोत्साहित करणारे पहिले स्टार्टअप कॉन्क्लेव्ह उत्साहात आयोजित करण्यात आले. यावेळी अनेक शेतकरी, युवक, महिला, विद्यार्थी, शिक्षक, तसेच स्थानिक प्रशासनाचे अधिकारी उपस्थित होते. यावेळी अनेक शेतकरी, युवक, महिला, विद्यार्थी, शिक्षक, तसेच स्थानिक प्रशासनाचे अधिकारी उपस्थित होते.

**यावारी स्टार्टअपसाठी नऊ मूलमंत्र आवश्यक**

अकोटा येथील शेतकरी संघात, शेतीकडे वळणी काढण्यासाठी युवकांना प्रोत्साहित करणारे पहिले स्टार्टअप कॉन्क्लेव्ह उत्साहात आयोजित करण्यात आले. यावेळी अनेक शेतकरी, युवक, महिला, विद्यार्थी, शिक्षक, तसेच स्थानिक प्रशासनाचे अधिकारी उपस्थित होते. यावेळी अनेक शेतकरी, युवक, महिला, विद्यार्थी, शिक्षक, तसेच स्थानिक प्रशासनाचे अधिकारी उपस्थित होते.

**लोकमत**

**अकोटात 'स्टार्ट-अप' परिषदेत युवकांना मिळाले उद्योगाचे धडे!**  
**विदर्भातून पहिल्या परिषदेचा मान मिळाला अकोटला!**

लोकमत न्यूज नेटवर्क अकोटा : लोकजागर मंच, इवसलेजीस अटर्नॅज व एलईएस इंडिया यांच्या संयुक्त विद्यमाने दि. ११ मार्चरोजी अकोटा येथील युनयुनवाला अतिथी भवनात जिल्हातील पहिली 'स्टार्ट-अप कॉन्क्लेव्ह-२०२३' परिषदेचे आयोजन केले होते. या परिषदेत युवकांना आंतरराष्ट्रीय पातळीवरील उद्योजकांनी मार्गदर्शन करीत उद्योजक होण्यावर भर देण्याचा सल्ला दिला.

या परिषदेच्या प्रास्ताविकामध्ये लोकजागर मंच संस्थापक-अध्यक्ष अनिल गावडे यांनी शेतकरी हा नुसता शेततातील मजूर न राहता, तो एक यशस्वी उद्योजक होणे गरजेचे आहे. लोकजागर मंचच्यावतीने आतापर्यंत १५० ते २०० विविध कार्यक्रमां राबवून शेतकऱ्यांना यासंदर्भात मार्गदर्शन केल्याचे त्यांनी सांगितले.

त्यानंतर प्रमोद चंचूवार, अजिंक्य कोतावर यांच्यासह विदेशातील उद्योजक इवस लेझीसच्या रिचा पांडे, अमेरिकेचे डेविस लेझीस, दुबईचे शरवाद हसन आदींनी ऑनलाईन मार्गदर्शन केले. दुसऱ्या सत्रात यशस्वी स्टार्ट-अपसाठी आवश्यक असलेल्या ९ मूलमंत्रसंदर्भात महत्त्वाची माहिती आंतरराष्ट्रीय पुरस्कारप्राप्त उद्योजक समीर जोशी यांनी दिली.

याप्रसंगी नमन कोभरे, दिवेन्दु वर्मा, स्फूर्ती दलोदिया, ज्येष्ठ पत्रकार प्रमोद चनचूवार, सीमा जोशी आदींचे लोकजागर मंचचे अध्यक्ष अनिल गावडे यांनी स्वागत केले. यावेळी अकोटा विभागातील उद्योजक आदित्य आसकरकर, शरद महाटे, संदीप चव्हाळे, कृष्णाल वर्मा, संदीप चौधरी, अक्षय शेंगेकार, राहुल जायले यांचा सत्कार करण्यात आला. या कार्यक्रमाचे अध्यक्ष म्हणून संतोष झुनझुनवाला, तर प्रमुख अतिथी आशिष राठी, महेंद्र तरडेजा, माजी नगराध्यक्ष पुष्पलोक चौधरे, प्रशांत वहाडे, लोकजागर मंच जिल्हाध्यक्ष मनीष भांबूरकर मंचावर उपस्थित होते. कार्यक्रमाचे प्रास्ताविक अनिल गावडे, संचालन निखिल भाड, आभार मनीष भांबूरकर यांनी केले. या परिषदेत युवक-युवती, विद्यार्थी, महिला पुरुष, उद्योजक सहभागी झाले होते.

**दिव्य मराठी**

**अकोला सिटी 14-03-2023**

**दिव्य मराठी विशेष • अकोट येथे 'स्टार्टअप'च्या कार्यक्रमात मान्यवरांची उपस्थिती, मार्गदर्शन आंतरराष्ट्रीय उद्योजकांनी केले ऑनलाइन-ऑफलाइन मार्गदर्शन**

अकोटा येथील शेतकरी संघात, शेतीकडे वळणी काढण्यासाठी युवकांना प्रोत्साहित करणारे पहिले स्टार्टअप कॉन्क्लेव्ह उत्साहात आयोजित करण्यात आले. यावेळी अनेक शेतकरी, युवक, महिला, विद्यार्थी, शिक्षक, तसेच स्थानिक प्रशासनाचे अधिकारी उपस्थित होते. यावेळी अनेक शेतकरी, युवक, महिला, विद्यार्थी, शिक्षक, तसेच स्थानिक प्रशासनाचे अधिकारी उपस्थित होते.



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This Newsletter is published by DuxLegis Attorneys from 902, Kamdhenu Commerz, Sector 14, Kharghar, Navi Mumbai, Maharashtra, India on 5th April, 2023.