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Gateway to IP World

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## In This Issue

- Foreign Filing Permission Around The World
- IP Snippets
- Recent IP Updates
- DuxLegis Attorneys hosts AIPLA “Women in IP” Global Networking Event

## FOREIGN FILING PERMISSION AROUND THE WORLD FOR FILING PATENT APPLICATION



Sarang Khadilkar



Ms. Priti More

If an inventor wishes to file a patent application in a foreign country, he/she typically must first obtain permission from his/her home country's patent office. This is known as a "foreign filing license" or "right to foreign file."

The requirement for a foreign filing license is based on the fact that, by filing a patent application in a foreign country, the inventor is effectively disclosing information that could be considered a trade secret. In order to protect the inventor's home country's interest in this information, the patent office may require that the inventor seek permission before filing abroad.

The process for obtaining a foreign filing license can vary from country to country. In some countries, the patent office will automatically grant a foreign filing license as long as certain conditions are met. In other countries, the inventor must apply for a license and may be required to provide certain information, such as a description of the invention, in order to be granted permission.

It's important to keep in mind that not all countries have similar patent laws, some countries will have different duration of the patent, some will not issue patents on certain subject matter, or even will have other different regulations, therefore, it is recommended to do a proper due-diligence before filing a request for foreign filing.

### INDIA:

In India, a patent foreign filing license is a permission granted by the Indian Patent Office (IPO) to an Indian resident or entity that allows them to file a patent application in a foreign country without violating certain restrictions on the export of sensitive technologies.

Under the Indian Patents Act, 1970, certain inventions

and technologies are subject to secrecy provisions that restrict their export without obtaining prior permission from the Indian government. The purpose of these provisions is to protect national security and prevent unauthorized access to sensitive technologies.

If an Indian resident or entity wants to file a patent application for an invention that contains such sensitive technology, they may need to obtain a patent foreign filing license from the IPO before they can export the technology to a foreign country.

To obtain a patent foreign filing license, the patent applicant must submit a request to the IPO along with certain information about the technology contained in their patent application. The IPO will review the request and determine whether to grant the license.

Once the license is granted, the patent applicant can file their patent application in a foreign country without violating Indian export regulations. However, it's important to note that obtaining a patent foreign filing license does not guarantee that the patent application will be granted in the foreign country where it is filed. The foreign country's patent laws and procedures will still apply, and the patent applicant will need to comply with them to obtain a granted patent in that country.

Below is the list of countries where the Foreign Filing Permission is mandatory. We have collated the data and summarized the requirements in below table:

<b>State(s)</b>	<b>Restrictions</b>	<b>Legislation and notes</b>
Armenia	Inventions made in the country	Law on Inventions, Utility Models and Industrial Designs, Article 77
Azerbaijan	Applications containing State secrets	Law of the Republic of Azerbaijan on Patents, Article 25
Belgium	Applications by residents	Applies to applications which may be of interest for national defence.
Bulgaria	Applications by residents	Applies to applications which have been classified by the defense authorities of Bulgaria as being of a confidential nature.
China	Inventions made in the country	Patent Law of the People's Republic of China, Articles 4 and 20, Implementing Regulations of the Patent Law of the People's Republic of China, Rules 8 and 9
Cyprus	Inventions made in the country	
Germany	Applications containing State secrets	Patent Law, Section 52 and Law on International Patent Treaties, Art. III Sec. 2
Denmark	Applications by residents	Applies to applications relating to war materials or the manufacture of war materials. Patents Act, Section 70 and the Consolidate Secret Patents Act
Spain	Applications by nationals and residents	Unless priority of an earlier application filed at the SPTO is claimed. Law No. 11/1986 of March 20, 1986 on Patents (as last amended by Law No. 14/2011 of June 1, 2011), Art. 122 and Royal Decree No. 1123/1995, Art. 3.
Finland	Applications by residents	Act on Inventions of Importance to the Defence of the Country (551/1967), Section 2
France	Applications by natural or legal persons having a residence or principal place of business in France	Unless priority of an earlier application filed at the INPI is claimed. Intellectual Property Code, Article L 614-18.
United Kingdom	Applications by residents	Applies to applications relating to military technology or whose publication might prejudice national security or safety of the public. For more details about applications relating to military technology or whose publication might prejudice national security. Patents Act 1977, Section 23
Greece	Applications by nationals	Unless priority of an earlier application filed at the OBI is claimed. Presidential Decree No. 16/1991 Implementing Regulations of the Patent Cooperation Treaty as ratified by Law No. 1883/1990, Article 3, par. 2 and Law No. 4325/1963 on the Inventions Concerning the National Defence, Art. 1 and 2.

Israel	Applications by nationals and residents	Applies to applications the subject of which is weaponry or ammunition, or which is otherwise of military value. Patents Law, 5727-1967, Article 98
India	Applications by residents	Unless a written permit has been granted following a request on Form 25 and payment of INR 4,000 (INR 1,000 for individuals) or unless an application for a patent for the same invention has been made in India and at least 6 weeks have elapsed without a notice from Controller prohibiting publication or communication of the application.  Patents Act, Section 39.
Italy	Applications by residents	Unless the international application claims the priority of a national application filed in Italy more than 90 days previously and such application has not been made subject of the official secrets regulation. Industrial Property Code (Legislative Decree No. 30 of February 10, 2005, Article 198(1))
Republic of Korea	Applications by residents	Applies to applications which may be of interest for national defence. Patent Act, Art. 41
Luxembourg		Only applies to applications which may be of interest for national defense.
Malaysia	Applications by residents	Patents Act 1983 (Act 291), Section 23A
Norway	Inventions made in the country Applications by residents Inventions owned by residents	Applies to applications relating to military technology or whose publication might prejudice national security Patents Act, Section 71 Act on Inventions of Importance to the Defence of the Realm (Act No. 8 of June 26, 1953 as last amended on January 1, 2002)
Portugal	Applications by residents	Industrial Property Code, Article 91
Russian Federation	Inventions made in the country	Civil Code of the Russian Federation, Article 1395
Sweden	Inventions made in the country Applications by residents Inventions owned by Swedish companies	Applies to applications concerning defense inventions. The Defense Inventions Act, Section 4
Sweden	Applications by residents	Patents Act, Section 34
Turkey	Applications by residents	Applies to applications concerning a subject of significance for national security. Decree-Law No. 551 Pertaining to the Protection of Patent Rights, Article 128

United States of America	Inventions made in the country	Title 35, United States Code, Patents, Sections 181 and 184-188. See also 37 CFR 5.11-5.20. For more details about applications for foreign filing licenses. For using ePCT-Filing to prepare a request form package for upload to EFS-Web, see the article in the PCT Newsletter, May 2016 (No. 05/2016).
Vietnam	Applications by residents	Unless written authorization from the National Office of Industrial Property (Viet Nam) has been obtained or unless an application for a patent for the same invention has been filed at that Office.



## IP SNIPPETS:

### PATENT CASES

#### **BIOMONETA RESEARCH PVT LTD (Appellant) vs CONTROLLER GENERAL OF PATENTS DESIGNS AND ANR (Respondent)**

Case Number: C.A.(COMM.IPD-PAT) 297/2022  
Decided on: 13th March, 2023

BIOMONETA RESEARCH PVT LTD had filed an appeal in the Delhi High Court against the CONTROLLER GENERAL OF PATENTS DESIGNS AND ANR to set aside the refusal order issued under section 15, refusing the Indian Patent application No. 201741016833, filed on 12th May, 2017 by the appellant. The patent application was refused by the respondent on the ground that the claimed subject matter of the subject patent does not constitute an invention under Section 2(1)(j) of the Act. The Court has set important points on the synergistic combination or a working interrelation of the known components. The Court found that the claimed system had some new features and is an improvement in the method, which has brought in greater efficiency, despite the components being present in the prior art. The Court also considered that the subject invention addressed various disadvantages in the prior art. The Court believed the subject invention is not a mere addition to a well-known combination, but it has some new features and is an improvement in the method which has brought in greater efficiency. The court's observation that 'when a set of old results are combined in a new and profitable manner, a patent can be granted' is remarkable. Accordingly, the impugned order was set aside, and the patent application was directed to proceed for grant.

#### **BOEHRINGER INGELHEIM PHARMA GMBH & CO. KG (Appellant) vs VEE EXCEL DRUGS AND PHARMACEUTICALS PRIVATE LTD. & ORS (Respondent)**

Case Number: CS(COMM) 239/2019 & CCP(O) 82/2019, I.A. 6797/2019 (O-XXXIX R-1 & 2 of CPC), I.A. 9272/2019 (O-VII R-11 of CPC), I.A. 2042/2020 (u/S 151 CPC), I.A. 2044/2020 (u/s 151 CPC)  
Decided on: 29th March, 2023

The Appellant has filed an appeal against the refusal order passed by the Assistant Controller of Patents and Designs for rejecting a patent application without providing proper reasoning for refusal. The Court said that it was unable to understand how the conclusion was

drawn as the reasons for dismissing the application were merely a word-for-word replication of appellant claims and therefore no reasoning was noticeable from the paragraph. The Court found that the decision was without merit and was an arbitrary approach by the controller towards Appellant and thus the refusal order was quashed and set aside. The Court asked to re-consider the patent application by transferring the case to another controller and provided the time of three months to abide by the same. Here the Court has emphasised that the order needs to be supported by well balanced and well-articulated reason since patentability of invention is a serious matter and can have severe consequences on the part of the inventor.

#### **CAMBRIDGE ENTERPRISES LTD (Appellant) vs THE CONTROLLER GENERAL OF PATENTS (Respondent)**

Case Number: IPDPTA/101/2023  
Decided on: 23rd March, 2023

The Appellant had filed an appeal against an order issued by the Controller General of Patent, in which the Patent application was refused providing the reasons that the Indian national phase application was filed beyond the period of 31 months from the date of priority. The Appellants contended that the order was erroneous as the application was filed on June 5, 2009 and not on June 15, 2009, as considered by the Controller.

Regardless of providing the documents such as the official filing receipt issued by Patent office as well as the internal noting made by Patent office on their note-sheet, both of which would prove that the subject patent application was duly filed on 05/06/2009 within the statutory deadline of 31 months which ended on 08/06/2009, the respondent had issued the refusal order. Thereafter, it was accepted by the Respondent that the said date, i.e., June 15, 2009, was recorded incorrectly and reflects a mistake on part of the Patent office, it being a computer-generated error. The Court ordered the patent application of appellant to be processed expeditiously in accordance with law and within three months from the date of order and to make corrections in the records as to filing date.



## TRADEMARK CASES:

#### **LOREAL INDIA PVT. LTD (Appellant) vs RAJESH KUMAR TANEJA TRADING AS INNOVATIVE DERMA CARE AND ANR (Respondents)**

Case Number: C.O. (COMM.IPD-TM) 497/2022  
Decided on: 23rd March, 2023

A petition has been filed on behalf of the appellant seeking removal of impugned trademark "CLARIWASH" in the name of respondent from the Register of Trademarks. The Delhi High Court observed that the Registry erroneously issued the Examination Report for the mark



“CHARIWASH” instead of “CLARIWASH” filed by the respondent. Again, the Registry issued a Trademark Registration Certificate in favour of the respondent, wherein the mark of the respondent was wrongly shown as “CHARIWASH”. After requesting for rectification of clerical error, a correct Trademark Registration Certificate was issued in favour of the respondent for the mark “CLARIWASH”. The Court stated that if the Registrar has committed an error and issued a faulty examination report, the respondent cannot be faulted for the same. Therefore, it cannot be the ground for removal of the registration. Further, the appellant's registered mark “CLARI-FI” was not similar to the respondent's mark. The Court stated that it does not create any confusion in the public. It is a settled position of law that while comparing the marks, the marks have to be seen as a whole and cannot be broken into their individual components. Also, the Court observed that the appellant has not filed any application for registration of the mark “CLARIWASH” till date. Therefore, the Court dismissed the petition.

#### **INFINITI RETAIL LIMITED (Appellant) vs M/S THE CROMA THROUGH ITS PROPRIETOR & ORS (Respondent)**

Case Number: CS(COMM) 577/2020  
Decided on: 28th March, 2023

“Croma” electronic store is known by a large group of public throughout India. Also “Croma” is a well-known trademark. In this case, the respondents display, sell and offer for sale counterfeit consumer electronics under the appellant’s mark “Croma” on the online platform and are using the registered name illegally. The appellant’s website is www.croma.com, whereas the defendant's impugned, fake, counterfeit website’s name was www.thecroma.in. It is a clear case of infringement and passing off where the intention of the defendant is to create confusion and deceive customers to believe that the impugned website was owned and operated by the appellant or associated with appellant. The Delhi High Court has ordered the defendant to transfer the domain name “www.thecroma.in” to the appellant, within two weeks, subject to plaintiff complying with the requisite formalities.

#### **KAIRA DISTRICT COOPERATIVE MILK PRODUCERS UNION LTD & ANR (Appellants) vs REGISTRAR OF TRADEMARKS & ORS (Respondents)**

Case Number: W.P.(C)-IPD 14/2021, CM 2/2021, CM APPL. 29905/2020 & CM APPL. 2062/2021  
Decided on: 22nd March, 2023

The Delhi High Court has dismissed a writ petition filed by the appellant under Article 226 of the Constitution of India seeking issuance of writ of mandamus to the Registrar of Trade Marks to withdraw the acceptance of trademarks identical with or deceptively similar to the associated “AMUL” trademarks, quash publication, cancel registration, and pass a reason order before accepting or advertising the marks that are identical or similar to the registered AMUL marks. The Court noted that the Trademark Act provides appropriate and adequate avenues for a person to oppose the registration of a mark during the pendency of the application for registration as well as seek rectification of the register by cancelling or varying the registrations granted in respect of any particular mark, and also seek for extension of time to oppose published marks.

#### **JMD HERITAGE LAWNS PRIVATE LIMITED (Appellant) vs MR ANKIT CHAWLA PROPRIETOR SADDA PIND RESTAURANT (Respondent)**

Case Number: CS(COMM) 673/2022 & I.A. 5843/2023  
Decided on: 10th April, 2023



The appellant is the owner of the trademark and runs “Cultural Living Museum” under the trademark name, along with restaurant and boarding services. It also has a wordmark registration of words 'SADDA PIND' in its name and runs a website, by the same name as the wordmark name. The

defendant who runs restaurant services was found out by the petitioner using the same trademark in Rajasthan. The appellant asked the defendant to cease the use of the trademark. The defendant refused to adhere and termed the situation as coincidental because of which the petitioner filed a court case in Delhi High Court for infringement of trademark. The Court has granted an ex parte injunction against the defendant. The defendant at the end changed the name of the restaurant, thereby not infringing the trademark of the appellant. The Court ordered to change the impugned mark and held it to be in violation of the interim orders passed by it. Accordingly, the Court imposed Rs 2,00,000 as costs on the defendant.



## COPYRIGHT CASES

### **UNIVERSAL CITY STUDIOS LLC & ORS (Appellant) vs FZMOVIES.NET & ORS (Respondent)**

This application was filed by Universal City Studios LLC.; Warner Bros. Entertainment Inc.; Columbia Picture Industries, Inc.; Netflix Studios, LLC.; Paramount Pictures Corporation and Disney Enterprises, Inc. in the Delhi High Court urging for stop on pirated websites hosting copyrighted contents of various platforms of appellant illegally and without authorised permissions from them in India. The case has been filed under section 51 (When copyright is infringed) of the Copyright Act, 1951 before High Court of Delhi. The Court has ordered ISP (Internet Service Providers) to block such websites hosting copyrighted content with immediate effect and have favoured appellant that any such similar violation of copyright, they may approach registrar by submitting affidavit for speedy order and redressal. It is important to note that violation of copyright is a civil as well as criminal offence. Chapter 13 of the Copyright Act, 1952 lays down provisions for penalties. Offence of infringement of copyright is punishable with imprisonment for a term which shall not be less than six months, but which may extend to three years and with fine which shall not be less than fifty thousand rupees, but which may extend to two lakh rupees depending on the severity of violations.

## INTRODUCTION OF ONLINE GAMING IN INFORMATION TECHNOLOGY ACT

The ministry of electronics and information technology (MEITY) has introduced the regulations for online gaming in the Information Technology Act effective from April 06, 2023. The definition of “online game” has been defined which means that a game that is offered on the Internet and is accessible by a user through a computer resource or an intermediary. The amendments also include definitions of online gaming intermediary, online gaming self-regulatory body, online real money game, permissible online game, and permissible online real money game. Further, rules have been added for verification of users, Grievance Redressal Mechanism, Prohibition on providing Financing and enabling Third-Party Financing, Designation of self-regulatory bodies, Verification of online games; suspension/revocation of verification, etc.



## RECENT IP UPDATES

### **CGPDTM WITHDRAWS PUBLIC NOTICES DATED FEBRUARY 06, 2023 AND MARCH 27, 2023**

A writ petition filed before the Delhi High Court by Intellectual Property Attorneys Association, challenging the Trademarks registry notice dated February 06, 2023 and March 27, 2023, wherein the list of trade mark applications were abandoned. The Controller of Patents undertakes to withdraw the two impugned Public Notices and revert all the applications in respect of whom the notices have been issued to their original status, within a period of ten days.

## Women must be treated as human beings, say experts

### DuxLegis Attorneys hosts AIPLA “Women in IP” Global Networking Event

**AIPLA Women in IP Global Networking Event** hosted by DuxLegis Attorneys saw four women achievers from various fields motivating and inspiring participants to set and achieve higher goals in life. The event was held at Navi Mumbai, India and coordinated worldwide by American Intellectual Property Law Association (AIPLA) and Women in IP on April 27, 2023.

Spurthi Dalodria, representative of AIPLA Organiser of the event, informed about AIPLA and “Women in IP Law” and spoke on behalf of Divyendu Verma, Managing Partner of DuxLegis Attorneys.

Following the theme of the programme, 'Own Your Voice!', DuxLegis had invited women achievers Dr. Sonali Rode, former Joint Director of Higher Education and Professor, Elphinston College, who was Chief Guest on the occasion; Dr. Padmaja Rajguru, CEO of K P Industries and Founder of Da Auraa, Luxurious Leather Brand; Dr. Gargi Rajvanshi,

Assistant Vice President, Legal Risk Management and Sunita Nerale, Founder of Caravan Sakhi & CEO of Sunita Tours and Travels to speak about their inspiring and unique experiences.

While speaking at the function, Dr. Rode emphasised the need for treating women as human beings. The thought that women should not confine themselves to womanhood, but rather their goal should be to achieve being treated as human beings was the sentiment maintained by the guests. Speakers shared challenges faced by them as women and offered tips on how to overcome them.

Speakers offered floral tributes to great social reformer and pioneer of women's education in India Krantijyoti Savitribai Phule. Priti More, Coordinator introduced key speakers. Pramod Chunchuwar, Director of DuxLegis Attorneys delivered a vote of thanks on the occasion.



Chief Guest  
Dr. Sonali Rode  
addressing the event  
(in the centre),  
Key speakers  
Dr. Padmaja Rajguru  
(Right) & Sunita Nerale  
(Left)



Chief Guest & Key Speakers offered floral tribute to Savitribai Phule



Sunita Nerale explained her journey from a retired government employee to developer of Caravan Sakhi



Dr. Padmaja Rajguru speaking at the event



Dr. Gargi Rajvanshi, key speaker addressing the Event

The distinguished invitees at the event



The distinguished invitees at the event





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