



INTELLECTUAL PROPERTY UPDATES FROM INDIA

Intellectual Property Team

March, 2022

INTRODUCTION

2022 began with several interesting decisions and developments. At the top of the list is the High Court of Delhi's efforts in establishing the Intellectual Property Division and enforcing their rules, which we believe would greatly help make Delhi an even better jurisdiction to try intellectual property cases. Other High Courts with a Commercial Division (first-instance courts for commercial, including intellectual property trials) may

follow suit soon. We also track several decisions taken by the Supreme Court and the State High Courts dealing with the test of similarity in trademarks, the rights of patent holders towards the end of the term, trademark infringement in using recycled liquor bottles, domain name issues and several others.

We hope you enjoy reading this edition.



CASE NOTES

No copyright over the game of cricket

The Delhi High Court ("**Court**") in *Samir Kasal v Prashant Mehta & Ors*¹, dismissed an interim application to stay the Legends League Cricket ("**Tournament**"), just days before the Tournament was scheduled to begin.

Mr. Samir Kasal ("**Plaintiff**") in the instant case claimed that he had conceptualized a novel international cricket league format. In the said league, two teams made up of retired cricketers would play test cricket with two innings of 10 overs each. The Plaintiff's idea was to stage the league in non-cricket playing countries and exploit the interest in cricket of Indians residing in those countries. The Plaintiff claimed that he along with Mr. Prashant Mehta ("**Defendant No. 1**") began to work on his concept. Subsequently, Defendant No. 1 roped in Mr. Vivek Khushalani ("**Defendant No. 2**") as an investor in the said project. In the light of the same, the concept, format, and information regarding the league was disclosed to Defendant No. 2 in absolute confidentiality.

Soon after, the Plaintiff learnt from media reports that a similar international cricket league format was separately being organised by Defendant No. 2 along with other defendants (collectively "**Defendants**"). This suit was thus instituted by the Plaintiff on January 15, 2022, alleging that the Defendants misappropriated his original idea. The Plaintiff contended that the act of the Defendants amounted to breach of confidentiality, and infringement of copyright of the concept of a cricket league developed by him. In the backdrop of the same, the Plaintiff prayed for an interim injunction to restrain the Defendants from conducting the Tournament w.e.f. January 20, 2022.

Opposing the grant of interim relief, the Defendants argued that the Plaintiff's concept of a cricket league was only an idea and not a 'completed work', and, therefore, no claim of copyright is maintainable. The Defendants also argued that the T20 format of cricket was first introduced in the year 1997 and hence, the Plaintiff's idea to have two innings of 10 overs each was not an original idea. Also, neither the engagement of retired cricketers nor the hosting of a cricket league at a neutral location was new in cricket. The Defendants also claimed that the format of their Tournament was different from that of the Plaintiff's in terms of the number of overs, number of innings, number of teams, venues, business models and the league names. As regards confidentiality, the Defendants argued that there could be no confidentiality since all aspects of the Plaintiff's idea were already in public domain for years.

After hearing the submissions, the Court held that the concept claimed by the Plaintiff, as his idea does not fall within the ambit of 'work'² as defined in the Copyright Act, 1957. The Court further observed that the idea of the Plaintiff was not an original one. Hence, the Plaintiff cannot claim exclusive rights over it. The Court also noted that there were significant differences to establish that the format followed in the Tournament is not a copy of the Plaintiff's idea. The only similarity between the two formats is the game of cricket. Relying on the judgment delivered in the case of *R.G. Anand v Delux Films*³, the Court pointed out that several permutations and combinations in the format of playing the game of cricket have evolved over the years. No one can therefore claim a copyright to the game of cricket. The Court further rejected the Plaintiff's argument on breach of confidentiality since every element of the Plaintiff's idea already existed in the public domain in one form or another. In the light of the above, the Court concluded that the balance of convenience was in favour of the Defendants, and dismissed the interim application filed by the Plaintiff.

Supreme Court decides the dispute regarding the adoption of the 'Renaissance' trade mark

A three Judge Bench of the Supreme Court of India ("**Apex Court**") in *Renaissance Hotel Holdings Inc v B Vijaya Sai*⁴ ordered in favour of Renaissance Hotel Holdings and held that the words "RENAISSANCE" and "SAI RENAISSANCE" are phonetically as well as visually similar and thus, adoption and usage of the mark "SAI RENAISSANCE" amounts to infringement of the trade mark "RENAISSANCE".

The Appellant i.e. Renaissance Hotel Holdings ("**Renaissance**"/ "**Appellant**") had filed a suit in 2009 before the trial court to restrain the Respondent i.e. B. Vijaya Sai from using the trademark "SAI RENAISSANCE" or any other trade mark identical with the Appellant's trade mark "RENAISSANCE".

At first, the trial court had partially decreed the suit and restrained the Respondent from using the mark

¹ Samir Kasal v Prashant Mehta & Ors., CS(COMM) 39/2022

² Section 2(y) of the Copyright Act, 1957. "work" means any of the following works, namely:

(i) a literary, dramatic, musical or artistic work;
(ii) a cinematograph film;
(iii) a sound recording.

³ R.G. Anand v Delux Films, (1978) 4 SCC 118

"RENAISSANCE" or any deceptively similar mark thereto. However, it rejected the claim of the Appellant for damages. The Appellant thereafter filed an appeal before the High Court of Karnataka ("Karnataka HC"). In the said appeal, the Karnataka HC held that no evidence was produced by the Appellant to show that the Respondent was taking unfair advantage of its trade mark or that the use of the word "SAI RENAISSANCE" was detrimental to the distinctive character or reputation of the Appellant's trade mark. The Karnataka HC therefore held that there was no infringement of trademark, and it decided in favor of the Respondent by setting aside the decree passed by the trial court.

Aggrieved by the Karnataka HC's order, the Appellant approached the Apex Court, where the Karnataka HC's order was quashed and the trial court's decision was reinstated.

The Apex Court noted that subsection (2) of Section 29 of the Trade Marks Act, 1999⁵ [2] deals with those situations where the trade mark is identical or similar and the goods covered by such a trademark are identical or similar. The Court further noted that it is an undisputed fact that the Appellant's trade mark "RENAISSANCE" and the Respondent's mark "SAI RENAISSANCE" are both used for similar services i.e. hotels and allied services and hence, it was not open for the Karnataka HC to have entered into the discussion as to whether the Appellant's trade mark had a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to the registered trademark.

The Apex Court relied on the judgment in the case of *Rustom & Hornsby Limited v Zamindara Engineering Co.*⁶ to conclude that in an action for infringement, once it is found that the Defendant's trademark was identical with the Plaintiff's registered trademark, the Karnataka HC could not have gone into an inquiry whether the infringement is such as is likely to deceive or cause confusion. In an infringement action, an injunction would be issued as soon as it is proved that the defendant is improperly using the trademark of the plaintiff. The Court further noted that the use of the word "SAI RENAISSANCE" was phonetically and visually similar to "RENAISSANCE", and it would violate provisions of subsection (9) of Section 29 of the Trade Marks Act, 1999⁷.

Hence, it was held that the Karnataka HC was not justified in interfering with the well-reasoned order of the trial court.

Use of recycled bottles, bearing the trade mark BUDWEISER amounts to infringement and passing off

Recently, the Intellectual Property Division of the Delhi High Court, decreed a suit for trade mark infringement and passing off in favour of Anheuser-Busch LLC ("Plaintiff"), owner of trade mark 'BUDWEISER' which is used for beer and non-alcoholic beverages⁸.^[1]

The Plaintiff had filed a suit for infringement of trade mark and passing off. It was the case of the Plaintiff that the bottles of beer manufactured by it with the embossed word 'BUDWEISER' were being used by the Defendants by re-labelling them as 'BLACK FORT' and 'POWER COOL' which would create an impression on the mind of the consumer that defendants' product belong to the Plaintiff. The Plaintiff primarily sought permanent injunction from Court to restrain the Defendant from selling, exporting, importing and distributing the glass bottles with the embossed word 'Budweiser'. It was submitted by the Defendant that there was no deliberate attempt on its part to infringe the trade--mark of the Plaintiff or use the bottles of the Plaintiff. The bottles had come into the Defendant's system through *kabadiwalas* (recyclers), and therefore, entered the manufacturing line of the Defendant's Company. The impugned bottles were stray bottles of 'BUDWEISER' which may have been accidentally used by the Defendants. The Defendant also showed willingness to give an undertaking before

4 2022 SCC OnLine SC 61, decided on 19.01.2022.

5 A registered trademark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of (a) its identity with the registered trademark and the similarity of the goods or services covered by such registered trademark; or (b) its similarity to the registered trademark and the identity or similarity of the goods or services covered by such registered trademark; or (c) its identity with the registered trademark and the identity of the goods or services covered by such registered trademark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trademark.

6 Where the distinctive elements of a registered trade mark consist of or include words, the trademark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.

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the Court to the effect that the bottles of 'BUDWEISER' shall not be used by it for manufacture and sale of their own beer.

The Court held that the sale of any product with the recycled bottles of another manufacturer would result in infringement and passing off. Though the bottle itself may be a genuine bottle which may have been put by the Plaintiff originally in the market, after the contents are consumed and the bottle reaches the recycling cycle, the Defendant's use of such bottles which have the Plaintiff's trade mark embossed on them would cause confusion as to its source. While reaching this decision, the Court relied on an earlier decision passed by it in a similar fact situation, in *M/s. Allied Blenders and Distillers Pvt. Ltd. v Rangar Breweries Ltd.*^{9[2]} and the judgment passed by a Division Bench of the Bombay High Court in *Som Distilleries and Breweries Ltd. v SABMiller India Ltd.*^{10[3]}

In view of the undertaking given by the Defendant, the Plaintiff did not press for damages and the Court decreed suit in favour of the Plaintiff. The Court has also directed that in future, if any 'BUDWEISER' bottles are found by the Plaintiff to be emanating from the Defendants' factory, the Plaintiff shall immediately give notice of the same to the Defendants who shall take remedial measures immediately, failing which, the Plaintiff would be entitled to avail of its remedies, in accordance with law, including the claim of damages, which was sought in the present suit as well.

Delhi High Court injuncts websites from using 'DABUR' as part of their domain name.

The Intellectual Property Division of the Delhi High Court ("**Court**"), granted an ex-parte ad-interim injunction in favour of Dabur India Limited ("**Plaintiff**") in a suit for trade mark infringement and passing off filed by it¹¹.

The Plaintiff had filed a suit against certain websites and domain names i.e. <https://www.daburdistributor.com/>; <https://daburdistributorships.in/>; <https://www.daburdistributor.com/>; and <http://www.daburfranchisee.in/> which were using the trade mark 'DABUR' of the Plaintiff as a part of their domain name. It was the case of the Plaintiff that such websites have been created with the objective of using Plaintiff's identity to invite franchisees and distributors to register themselves as agents in order to attain the right to sell the products of 'DABUR'. In some cases, these websites were even charging fees from prospective franchisees.

It was also submitted by the Plaintiff that due to the 'privacy protect feature' offered by the domain name registrars, the details such as telephone number, address, and name of the domain name holder are unavailable on the database of domain name i.e. <https://www.whois.com/>. Thus, the Plaintiff requested the Court to pass a John Doe (orders which operate against even unknown defendants likely infringing the domain name, alternatively known in India as an *Ashok Kumar* order) order against such unidentified registrants of websites and also directed the Internet Service Providers ("**ISP**") to block such phishing websites.

The Court while ordering in favour of the Plaintiff observed that such unauthorized use of Plaintiff's trade mark is against the interest of the franchisees, distributors, and public in large who engages with such websites in the pretext of entering into the business with the Plaintiff and the same cannot be permitted.

Thus, the Court in the larger public interest ordered the domain name registrars i.e. Defendant No. 4 & 5 to immediately block the impugned domain names and the websites and restrain the registrants of these websites from transferring or creating third party interest on the said domain names. Further, the Hon'ble Court directed the Department of Telecom and Ministry of Electronics and Information Technology i.e. Defendant No. 2 & 3 respectively, to issue directions to all ISPs to block such websites and other unauthorized websites bearing the trade mark of the Plaintiff. The Court also questioned the 'privacy protect feature' which masks the details of the registrants and directed the domain name registrars to disclose their stand on the requirement of such feature and why the same shall not be disabled. The Court also gave the Plaintiff the liberty to approach the Court in case of any future infringement of their trade mark or to seek extension of the present injunction to the said domain and websites.

8 Judgment dated 14 March 2022 passed in ANHEUSER-BUSCH LLC v MR. SURJEET LAL & ANR CS (COMM) 1305/2018. Available at <https://indiankanoon.org/doc/142913955/>

9 [CS (COMM) 1213/2018] decided on 21st May, 2019]

10 [2013 (56) PTC 237 (Bom)]

11 Order dated March 3, 2022, passed in *Dabur India Limited v Ashok Kumar and Ors.*, CS(CoMM) 135/2022. Available at http://164.100.69.66/jupload/dhc/PMS/judgement/25-03-2022/PMS03032022SC1352022_122025.pdf

No enforcement rights over the word 'SUPER'!



In a recent judgement, the Delhi High Court ("**Court**"), in the matter of *Soothe Healthcare Private Limited v Dabur India Limited*¹² denied the grant of an interim injunction in favour of Soothe Healthcare Private Limited ("**Plaintiff**"). The Plaintiff had filed a suit against Dabur India Limited ("**Defendant**") seeking to restrain the Defendant from using the trade mark "SUPER PANTS".

The Plaintiff is a company involved in the business of manufacturing and marketing of personal hygiene, sanitary preparations, etc. since 2012. In 2020, it started manufacturing and dealing in baby diapers. The Plaintiff obtained trade marks such as "SUPER CUTESTERS", "SUPER CUTES" and "SUPER CUTEZ". In 2021, the Defendant started its business of baby diapers with the trade mark "SUPER PANTS". The Plaintiff contended that the Defendant's mark is deceptively similar to the Plaintiff's marks and therefore filed a suit for infringement and passing off.

The primary issue before the Court was to determine whether the word 'SUPER' is a descriptive/ laudatory word and whether it can attain distinctiveness in respect of the goods of the Plaintiff.

The Court observed that the word 'SUPER' had a dictionary meaning which means 'excellent or extremely good'. Further, the use of the word 'SUPER' by the Plaintiff on its packaging at several places has been in a laudatory manner, such as "Super Soft Feel", "Super Thin", "Super Bubble Technology", and "Super Absorbent", which suggests that the Plaintiff's products are extremely soft to the body and are highly absorbent. The use of the word 'SUPER' by the Plaintiff was clearly indicative of the high quality of products being sold by them. The Court therefore held that the word 'SUPER' is a descriptive word and is used in a descriptive manner by the Plaintiff. For these reasons the Court held that the

word SUPER is not a distinctive word and is not capable of distinguishing the goods of the Plaintiff from that of others. The Court also stated that Plaintiff cannot have exclusive rights over the word 'SUPER'.

Additionally, the Court also held that the packaging of the Defendant's products was sufficiently different from the Plaintiff's product. The use of the word 'DABUR', colour combination and overall elements distinguishes Defendant's products from Plaintiff's. Hence, there is no possibility of confusion or deception in the minds of the consumers in relation to the products of the Plaintiff and the Defendant. For the abovementioned reasons, the Court refused to grant interim injunction in this case. However, the main suit for permanent injunction is still pending before the Court.

Use of "KHADI BY HERITAGE" along with the "CHARKHA LOGO" in different forms held to be illegal

[*Khadi and Village Industries Commission v Raman Gupta and Ors*¹³.]

The Khadi and Village Industries Commission ("**Plaintiff**") instituted a suit before the Delhi High Court ("**Court**") against Raman Gupta and others ("**Defendants**"). The Plaintiff stated that it is the registered proprietor of various trade marks including the word "KHADI" in both Hindi and English languages and the "CHARKHA LOGO". The Plaintiff sold various products under its trade marks, including masks, hand sanitizers, PPE kits, etc. The Plaintiff alleged that the Defendants used the trading style, the corporate name, and the trade mark of "KHADI BY HERITAGE" along with the "CHARKHA LOGO" in different forms, on the products such as PPE Kits, hand sanitizers and fireballs. Further, the Plaintiff contended that the said trading style, the corporate name, and the trade mark, being used by the Defendant was deceptively similar to the Plaintiff's "KHADI" trade marks and the "CHARKHA LOGO". The Plaintiff further stated that the Defendants marketed and promoted its products through various websites such as www.khadibyheritage.com.

¹² CS(COMM) 18/2022 (March 03, 2022)

¹³ CS (COMM) 133/2022



The Court granted an *ex-parte ad interim* injunction and held that the use of the word "KHADI" by the Defendants was violative of the rights of Plaintiff in its registered trade marks. The Court further highlighted that the sale of medical products under the "KHADI" umbrella, without any property quality check, would be a major concern towards the general public/consumers, who are likely to be deceived basis the use of the word "KHADI". The Court also held that the use of the trade mark "KHADI BY HERITAGE" and "CHARKHA LOGO", by the Defendants on the websites, is likely to confuse the general public/consumers to believe that the Defendants are related to or associated with the Plaintiff. Accordingly, the Defendants were restrained from using their trade mark on the products and on the website. Additionally, the Court also directed the Domain Name Registrar to suspend the Defendants' domain names, from its server.

"Trucks24x7" deceptively similar to "CARS24" and the "24" formative marks

[The Global Car Group Limited v Jitender Narula - CS(COMM) 127/2022]

The Global Car Group Limited ("Plaintiff") instituted a suit before the Delhi High Court ("Court") against Jitender Narula ("Defendant") seeking to restrain the Defendant from infringing the Plaintiff's trade marks. The Plaintiff stated that it is the registered proprietor of the well-known brand "CARS24" and various other "24" formative marks. It was further submitted that the Plaintiff has been using and continues to use "24" formative marks in different, unique, and stylized forms. Further, in all these formative marks, the essential feature was the combination of the word with the

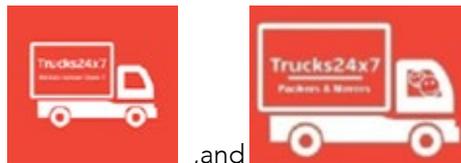
numeral "24". Thus, with respect to "CARS24", the Plaintiff has the exclusive right under Section 28 of the Trade Marks Act, 1999, to use the "24" formative marks.

The Plaintiff came across the domain name of the Defendant in July, 2021 and issued a cease-and-desist notice. The Plaintiff alleged that the Defendant started using the trade mark "Trucks24x7" (word),



in December, 2021, thereby infringing the rights of the Plaintiff, as the same is deceptively similar to the Plaintiff's registered trade marks. The Plaintiff further alleged that the Defendant by using the mark "Trucks24x7" clearly intended to piggyback ride on this reputation of the Plaintiff.

The Court accepted that the balance of convenience lies in favor of Plaintiff, and they have their trade mark rights protected under relevant provisions of Trade Marks Act, 1999. Accordingly, the Court restrained the Defendant from offering its services, advertising its services or listing on social media accounts and e-commerce websites, under the infringing trade mark "Trucks24x7" (word),



The Court also restrained the Defendant from using its domain name <http://www.trucks24x7.in/>, stating that the same is deceptively and conceptually similar to Plaintiffs' registered trade marks "CARS24", and the other "24" formative marks.

The Delhi High Court examines whether patent protection is less forceful towards the end of the term¹⁴.

A Single Judge of the Delhi High Court ("**Court**") has granted an injunction to Sotefin Patents SA (formerly Sotefin SA) ("**Sotefin/the Plaintiff**"). Sotefin is the patentee of IN 214088 ("**suit patent**"), over the carriage system of transferring motor vehicles in automated car parks (known as the "**Silomat Dolly**"). Indraprastha Cancer Society ("**Defendant**") runs the Rajiv Gandhi Cancer Institute, which is a prominent cancer hospital in New Delhi. In 2017, the Plaintiff and Defendant had entered into negotiations over a tender floated by the Defendant for building an automated car parking, during which the Plaintiff had shared technical details of the Silomat Dolly with the Defendant. The Defendant allegedly later shared these details with a company based in the People's Republic of China and had the same manufactured by them. On examination and consultation of reports prepared by technical experts, the Court found that there did exist a case of infringement, as the technology was covered by the claims in the suit patent.

The Court dealt with an interesting question of law—would damages (in place of an injunction) be adequate compensation for a patentee whose patent term is about to expire? In this case, the term of the suit patent expired on March 13, 2022, less than a month after the proceedings. The Court found that there was clear evidence of infringement *prima facie*, more than enough to warrant an injunction. Even so, the Defendants argued, only compensation for infringement would be adequate, given the imminent expiry of the term and that the injunction would no longer be in force upon such expiry.

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The Court held, relying on US and UK decisions¹⁵, that the expiry of the suit patent is irrelevant for the purposes of relief if the infringement occurred during the term.

The Court also relies on the bare language of Section 53(4)¹⁶ to demonstrate that the patent is entitled to full protection during its lifetime, and any infringing product would continue to remain under injunction even after the expiry as the infringement took place during the life of the suit patent. Furthermore, a defence under Section 107A(b) (import of the patented product by someone lawfully authorised to sell and distributed) also not accepted, as the Chinese company which had manufactured the infringing technology (with minor changes) did not have the necessary patent, or a licence from the Plaintiff.

In considering whether a *prima facie* case of infringement exists, courts are likely to take a view at the infringing technology overall, instead of comparing individual claims. In the present case, although the Defendant's technology had 2 components that were not a part of the specifications of the Plaintiff's claims, the Court held that that by itself did not mean that the Plaintiff's technology was not being infringed. Courts are also unlikely to deny relief if they find that the infringement took place during the lifetime of the patent.

Notification of the Patent Suit Rules

The Delhi High Court has notified the "High Court of Delhi Rules Governing Patent Suits, 2022" (the "**Rules**"). The Rules will govern all suits filed under the Patents Act 1970 ("**Act**") in the High Court's newly formed Intellectual Property Division. As the Delhi High Court has become a preferred jurisdiction for the institution of patent litigation by parties, these Rules seek to improve adjudication of these disputes.

The Rules' salient features include:

- **Directions as to pleadings:** The Rules direct that plaintiffs should include history of the technology, international corresponding applications, prosecution history, precise claims, the details of the licences

¹⁴ *Sotefin SA v Indraprastha Cancer Society*, IA 8543/2021 in CS(COMM) 327/2021.

¹⁵ See *Clark v Wooster*, 119 US 322 (1886) (U.S. Supreme Court) and *Merck Canada v Sigma Pharmaceuticals*, [2013] RPC 2 (England and Wales Patent County Court)

¹⁶ s 53(4), Patents Act 1970: "Notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection."

granted, etc. Likewise, the written statement filed by the Defendants should include a response to the claims chart, details of the case of non-infringement etc. of importance is the stipulation that if the Defendant is prepared to take a licence, the quantum of royalty is to be specified, and this is without prejudice to a defence of non-infringement/invalidity. The Rules also mandate that counterclaims alleging invalidity of the suit patent must include relevant prior art documents demonstrating the lack of novelty or inventive step, and specify the grounds taken under Section 64 of the Act.

- **Confidentiality clubs:** After the principle was recognised by the Delhi High Court in several decisions and ultimately finding sanction in the Original Side Rules 2018, confidentiality clubs (permitting only select persons on either side to access privileged legal documents) now finds sanction in the Rules. Additionally, the concept of an “external eyes only” club, which strictly limits access to only the external legal team (i.e., not in-house counsel), also finds mention, but there appear to be no guiding principles for the establishment of that club. Previously, “external eyes only” clubs were not permitted by the Court, the same having been considered against the principles of natural justice.
- **Hot-tubbing:** Expert evidence may be led through the hot-tubbing method (where experts for either side are called to jointly depose and put forth their evidence in a manner to highlight only the areas where they disagree).
- **Filing of briefs:** Parties will now be required to file multiple briefs, including a claim construction brief, an invalidity brief demonstrating the prior art (if the defendant makes an invalidity claim), brief of the damages sought etc. to assist the Court.
- **Summary proceedings:** Summary proceedings have been prescribed for cases where:
 - o The remaining term of the patent is 5 years or less. Given the fact that trials in Indian courts take years, this is a welcome move; in any circumstance, courts will provide injunctive relief to plaintiffs even if the term expires, as long as the infringement occurred during the term;
 - o The validity of the patent is admitted, and only the infringement is denied;
 - o Where a certificate of validity has already been

granted to the patent by a High Court or the Supreme Court; and

- o Where the Defendant is a repeated infringer of the same patent.

All in all, the Rules are a welcome change which incorporates best practices followed in patent suits in common law jurisdictions and have already been recognised in Indian judgements. However, the enforcement of these rules is the key factor, as it has often been seen that added rules make filings quite difficult; especially if the Registry has little clarity on the same. On the other hand, the mandated filings of these briefs and customised pleadings is likely to prove quite beneficial to judges adjudicating these suits.

Re-registration of Copyright Societies: A Dilemma¹⁷

In the beginning of March, 2022, Yogesh Khanna J of the Delhi High Court (“**Court**”) ruled on the crucial issue of re-registration of copyright societies, specifically of Phonographic Performance Limited (“**Petitioner**”), in compliance with the 1994 Amendment to the Copyright Act, 1957 (“**Act**”).

The Petitioner was a copyright society that facilitated the license, use and royalty collection of sound recordings, prior to the amendment to the Act. As a consequence of the amendment, no individual/entity could carry on the business of issuing licenses, except with the assent of the Central Government. Thus, all registered copyright societies were to re-register themselves, under Section 33 (3) of the Act. The Petitioner had promptly filed for re-registration. However, on account of several delays in determining its status as a copyright society, the Petitioner filed a request to withdraw its application with leave to re-apply at an appropriate stage. However, this withdrawal request was rejected by the Government (“**Respondent No. 1**”), stating that the Petitioner’s application for re-registration was still under consideration. After exchange of several correspondences between the Petitioner and Respondent No. 1, Respondent No. 1 in May, 2021 passed an order, rejecting the Petitioner’s application (“**Rejection Order**”). The rejection was on account of (i) the withdrawal request filed by the Petitioner earlier and (ii) because the fresh application was filed beyond the prescribed limitation period.

17 2022 SCC OnLine Del 722

The Court ruled in favour of the Petitioner, holding that the Rejection Order passed by Respondent No. 1, without providing the Petitioner an opportunity to be heard, amounted to non-application of mind. Additionally, the Court was of the view that the Respondent No. 1 had not decided the application on merits but had dismissed it on the technicality that the Petitioner had filed the fresh application only in June, 2018. Additionally, the Court held that Respondent No. 1 ignored correspondence exchanged so far, including a 2016 office memo that had indicated that the application for re-registration by the Petitioner was still under review and was well within time. The Court directed Respondent No. 1 to reconsider the application of the Petitioner for re-registration on merits as being filed on time.

Along with this issue, the Court also simultaneously heard the related writ petition regarding the validity of registration of Recorded Music Performance Limited ("**Respondent No. 2**") as a copyright society for sound recordings. This is particularly of relevance as it is

against the proviso to Section 33(3A) of the Act that only allows for registration of one copyright society for one category of work. The Court in the interim order passed in June, 2021 had directed the Respondent No. 1 to not take any adverse action against the Petitioner. The Court also instructed the Respondent No. 1 to take into consideration that if the Petitioner succeeded, its original application for re-registration shall stand revived. As a logical corollary to the invalidity of the Rejection Order, the Court, in this case, held that the order granting Respondent No. 2 registration as a copyright society would have to be set aside basis that it was subsequent in time to the Petitioner's application.

At the time of writing this article, the Division Bench comprising of Rajiv Shukdher and Poonam Bamba JJ has stayed Khanna J's order, subject to final determination of the appeal. The Division Bench took into consideration the fact that the society had been functioning for quite some time as a copyright society, prior to the impugned order. The final outcome is awaited.¹⁸

18 CM Misc. No 16964-69 of 2022 in LPA 243/2022



SNIPPETS

Drop the word 'GLEN' if not from Scotland!

Scotch Whiskey Association ("**SWA**"), a UK based organization, filed a case in 2013 against German distillery Waldhorn to stop the distillery from using the word 'Glen' on its whiskey bottle 'Glen Buchenbach'. SWA stated that the term 'Glen' implies a drink of Scottish origin and asserted breach of Article 16(a)–(c) of EU Regulation No 110/2008¹⁹. Use of the term 'Glen' was therefore considered misleading, since 'Glen Buchenbach' is produced by the Waldhorn distillery in Berglen, situated in the Buchenbach valley in Swabia (Baden-Württemberg, Germany). In 2019, Hamburg Regional Court passed an order asking the distillery to change its whiskey name. However, the distillery filed an appeal against the order. Finally, after the nine long years, on January 20, 2022, the Hanseatic Higher Regional Court in Hamburg rejected the appeal filed by the distillery thereby upholding the original order of the Hamburg Regional Court. The Court stated that the distillery would not have had 'Glen' incorporated to its name if not for the reputation and quality of Scotch and therefore it is a misuse of the GI.

The SWA has registered 'Scotch Whiskey' as a GI in India. Even prior to this registration, SWA has enforced its rights in India against usurpers who sought to use terms and images evocative of Scotland on their product labels. Pursuant to the decision of the Hanseatic Higher Regional Court in Hamburg SWA issued a public statement stating "*The SWA has consistently taken action in our global markets to prevent the use of Scottish indications of origin on whisky which is not Scotch Whisky. This is vital to protecting Scotland's national drink and is a deterrent to those who seek to take advantage of the quality reputation of Scotch Whisky and potentially mislead consumers,*" said Alan Park, SWA director of legal affairs.

Indian IP Office Issues Accessibility Guidelines For Persons With Disabilities

The Office of Controller General of Patents, Designs & Trademarks ("**CGPDTM**") has issued the Guidelines for Accessibility and Reasonable Accommodations for Persons with Disabilities on March 04, 2022. The Rights of Persons with Disabilities Act, 2016 ("**Act**") requires Government and private establishments to provide information, communications and documents in formats that are accessible to persons with disabilities. These guidelines are therefore issued with the aim to

ensure that CGPDTM takes all possible steps to make its website, facilities, documents, services, systems and processes accessible to every person.

The CGPDTM acknowledges that the IP Offices under may not be full accessible to all persons with disabilities. Therefore, they will endeavour to install screen readers, audio speakers and braille printers that can be accessed upon request. A nodal officer shall also be appointed who will assist all persons with disabilities who have requested such assistance.

The Act also mandates establishments to provide reasonable accommodations to persons with disabilities. Therefore, the CGPDTM will also provide appropriate accommodations based on the request of a person with disability. A nodal officer will also be appointed who will coordinate such requests.

This step taken by the CGPDTM is highly lauded as a step in the right direction.

US Patents and Trademarks Office Appellate Board Ends CRISPR Gene Dispute, Rules in Favour of Broad Institute

An appellate panel of the US Patents and Trademarks Office ("**USPTO Panel**") has ruled on a long-running dispute on patent ownership over the CRISPR gene editing technology. While a team of Prof. Jennifer Doudna (of the University of California, Berkeley, ("**UCB**") and Emmanuelle Charpentier (University of Vienna) jointly shared the 2020 Nobel Prize in Chemistry for discovering the CRISPR gene editing technology, the USPTO Panel ruled that the team (through the UCB) were not the first inventors of the "reduced to practice" form. In their opinion, that honour went to Dr Fang Zheng of the Broad Institute (a consortium between the Massachusetts Institute of Technology and Harvard University). The patent had been filed in 2012, at which time the USPTO granted patent to the first inventor, rather than the first to file (the latter is the international practice). It is expected that the UCB may explore their legal options, including an appeal to the US Court of Appeals for the Federal Circuit.

¹⁹ EU Parliament and Council Regulation 110/2008 deals with geographical indications in spirit drinks.

High Court of Delhi Fines Trade Mark Registrars INR 1 Lakh Each For Concealment of Facts; Directs Intellectual Property Office to Expeditiously Dispose of Opposition Applications²⁰

The Intellectual Property Division of the High Court of Delhi ("**Court**") has fined an Assistant Registrar and a Deputy Registrar of Trade Marks INR 1,00,000 (one lakh) each for concealing facts in a writ petition before the Court. The Petitioners, Dr Reddy's Laboratories Ltd. had challenged the decision of the Controller General disallowing them from filing oppositions to trade mark applications, on the grounds that they were filed after the 4-month objections period prescribed under Section 21 of the Trade Marks Act, 1999. The petitioners contended that they were covered by the Supreme Court of India's orders in *Suo Motu Writ 3 of 2020 (In Re: Cognizance for Extension of Limitation)*²¹ which suspended limitation during the Covid-19 pandemic. The Court agreed and noted that several other parties had been permitted to oppose after expiry of the four-month period. Singh J has also directed the Controller-General's office to prepare a proposal, for expediting the disposal of over 2 lakh opposition applications pending with the Registry.

Ed Sheeran wins copyright battle over 'SHAPE OF YOU'

Ed Sheeran along with co-writers Johnny McDaid and Steven McCutcheon ("**Claimants**") were accused by Sami Chokri and Ross O' Donoghue ("**Defendants**") of copying certain part of lyrics from their song "Oh Why" in the Claimants' 2017 chartbuster "Shape Of You".

The dispute began in May, 2018 when the Claimants initiated the proceedings seeking declaratory relief that they had not infringed the Defendants' copyright. In July, 2018, the Defendants filed a counter claim against the Claimants for copyright infringement and damages.

The question that arose was whether acts of copyright infringement were committed, especially when the claim for copying did not extend to the entire song. During the course of the proceedings in the counter claim, the Claimants admitted that a minor part of their song sounded similar to that of the Defendants. That being said, the Claimants argued that the melody of many songs are similar to each other and, such melodies being a "commonplace", the Defendants cannot have any claim of copyright.

After an 11-day trial, the England and Wales High Court ("**Court**") ruled in favour of the Claimants stating that "*Listening to the sounds as a whole ... the two phrases play very different roles in their respective songs.*" Additionally, handing down his judgement, the Court stated that Claimants had "*neither deliberately nor subconsciously copied*" the Defendants' song.

Interestingly, in a video posted on Instagram after the verdict, Ed Sheeran stated "*it's really damaging to the song writing industry. There's only so many notes and very few chords used in pop music. Coincidence is bound to happen if 60,000 songs are being released every day on Spotify. That's 22 million songs a year and there's only 12 notes that are available*".

Dua Lipa accused of Copyright Infringement

Recently, Dua Lipa and her Warner Records song writing team, have the subject of two claims of copyright infringement, one from the members of reggae band Artikal Sound System, and the second from songwriters L. Russell Brown and Sandy Linzer. Both these lawsuits pertain to Dua Lipa's renowned and successful song "Levitating". Artikal Sound System has sued before a Los Angeles Federal District Court, while the songwriters L. Russell Brown and Sandy Linzer have filed before a New York Federal District Court. The suits have been filed within weeks of each other.

Artikal Sound System claims that there are substantial similarities between the song "Levitating" and their 2017 commercially released song "Live Your Life". Similarly, Brown and Linzer allege that Dua Lipa's song "Levitating" is substantially similar to their songs "Wiggle And Giggle All Night" and "Don Diablo."

While the proceedings are at a preliminary stage, these lawsuits are one to keep eyes on, given the enormous success and popularity of Dua Lipa and her songs.

²⁰ *Dr Reddy's Laboratories Ltd v Controller General of Patents, Designs and Trade Marks, W.P.(C) IPD 4/2022, Delhi High Court*

²¹ *Suo Motu Writ 3 of 2020*

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