



INTELLECTUAL PROPERTY UPDATES FROM INDIA

Intellectual Property Team

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INTRODUCTION

The year 2022 has been instrumental from the standpoint of Intellectual Property Rights. With numerous landmark developments in the field, the jurisprudence revolving around different aspects of IP rights has significantly evolved. The High Court of Delhi has been particularly vigilant in protecting and enforcing the rights of IP owners, as is evident from its ruling directing Amazon to take down listings of 'Rooh Afza' products or directing Telegram to disclose the details of channels/devices used in disseminating infringing content. One of the most interesting trade marks disputes of this quarter was inevitably the amicable settlement between 'Theos' and 'Theobroma' where Theos agreed to restrict its

operation within the National Capital Region, while Theobroma was allowed to expand its outlets across India. This newsletter edition also tracks interesting jurisprudence rendered by various courts in India with respect to trade mark infringement for non-competing businesses, Trade dress imitations amounting to passing off, and the use of map allowed as a part of the trade mark. Other intriguing snippets of this edition includes an unconventional decision by the Japan Intellectual Property Office on the registrability of the 3D shape of the 'Guitar Hotel' in Japan.

We do hope you enjoy reading this edition.



CASE ANALYSIS

The High Court of Delhi directs Amazon to take down listings of ROOH AFZA products.

Recently, in the case of *Hamdard National Foundation (India) and Ors. vs Amazon India Limited and Ors.*¹ the High Court of Delhi ("**High Court**") directed Amazon India Ltd. ("**Defendant No. 1**") to remove listings for those 'ROOH AFZA' products which were not originating from the Plaintiff ("**Plaintiff**" / "**Hamdard Group**").

It was argued by the Hamdard Group, that Defendant No. 2 i.e., M/s. Golden Leaf ("**Defendant No. 2**"), is a seller on Defendant No. 1's platform and is selling and offering for sale the product 'ROOH AFZA' on the said platform. The Hamdard Group suspected that the products sold by Defendant No. 2 were not genuine in nature. It was found by the Plaintiff that the said products were not manufactured by the Hamdard Group and in fact were being manufactured in Pakistan. Additionally, the said products do not comply with the requirements of the Legal Metrology Act, 2009, the Legal Metrology Rules, 2011, and the Food Safety and Standards Act, 2006.

After considering the facts of the case and the arguments advanced, the High Court ordered the Defendant No. 1 to remove all the products with the 'ROOH AFZA' mark which did not originate from the Hamdard Group. The High Court further directed that for the products that originate from the Hamdard Group, the Defendant No. 1 shall give notice to the respective sellers to confirm that the same originate from the Hamdard Group and if so, such listings shall be retained.

Moreover, it was observed by the High Court that since Defendant No. 1 claims to be an intermediary under the Information Technology Act, 2000, it shall file an affidavit clarifying as to whether the details of the sellers, including the place of manufacturing of the products, the complete address of the sellers, and the contact details are mentioned on the ROOH AFZA product listings, invoices, product labels etc. If the same are not available on the product listings, the Defendant No. 1 shall clarify as to in what manner consumers are expected to obtain such details from the Defendant No. 1's platform.

Additionally, the Hamdard Group was permitted to inform the Defendant No. 1 of any listings which they may come across in the future, in respect of 'ROOH AFZA' branded products which are not manufactured and sold by it so that the same can be immediately removed from the Defendant No. 1's platform within 48 hours of the intimation.

No infringement of trademarks when the marks are derived from the active ingredient of a drug: High Court of Delhi.

The High Court of Delhi ("**High Court**") in the case of *Sun Pharmaceutical Laboratories vs. Hetero Healthcare Ltd. and Anr.*², held that there is no infringement of trademarks when the marks are derived from the active ingredient of a drug, which is used to manufacture the products of both the parties to the dispute. Thus, in case of an action for passing off, the similarity between the competing marks is to be seen along with the fact whether there is a likelihood of deception or causing confusion.

The Appellant, Sun Pharmaceutical Laboratories Ltd ("**Sun Pharma**"), filed an appeal challenging an order dated April 29, 2022 ("**Impugned Order**"), wherein a Single Judge Bench of the High Court, by way of the Impugned Order, dismissed Sun Pharma's application for injunction. Sun Pharma had filed a suit against Hetero Healthcare Ltd. ("**Defendant**" / "**Respondent**") alleging the infringement and passing off of its trademark 'LETROZ' and seeking a decree of permanent injunction restraining the Respondent from using the trademark 'LETERO', in respect of the pharmaceutical products.

Sun Pharma's case has been that it manufactures a generic drug for second line treatment of advanced breast cancer containing an active ingredient 'LETROZOLE' under the trademark 'LETROZ'. There is also a similar drug (with LETROZOLE as the active pharmaceutical ingredient) being manufactured by the Respondent under the mark 'LETERO'.

While deciding the Appeal filed by Sun Pharma, the High Court noted that Sun Pharma cannot be allowed to monopolize the International Non-Proprietary Name ("**INN**") 'LETROZOLE'. The mark, 'LETROZ', is not similar to the trademark 'LETERO' merely because both the parties have adopted the initial letters of the INN 'LETROZOLE'. The High Court also noted the marked difference in the price of both the products being sold by Sun Pharma and Hetero. While Sun Pharma was selling its product at INR 187.80/-, the Defendant was selling it for INR 60/-. Additionally, the High Court observed that the colour scheme of the packaging and get up of "LETROZ" and "LETERO" were not similar. In the High

1. CS (COMM) 607 of 2022, order dated September 5, 2022.

2. FAO (COMM) 96/2022, judgment dated August 26, 2022.

Court's opinion, the mark adopted by Sun Pharma is nothing but the first six letters of the INN and thus, prima facie, there is a little possibility of confusion or deception in the mind of the purchaser of the drug.

The High Court also noted that there is a bleak chance of confusion for an oncologist, who is an expert and who prescribes the medicines for the treatment of breast cancer. An oncologist is not likely to get confused because the two drugs are being sold with a mark containing the same first three letters, that are, 'LET' when the same are admittedly derived from the INN 'LETROZOLE'; more so, when the same drug is being sold by not only the parties herein but also by many other companies, a majority of which selling the said drug contain the same first three letters 'LET'. Accordingly, the High Court held that there is no infringement of trademarks when they are derived from the active ingredient of a drug, which is used to manufacture the products of both the parties to the dispute.

High Court of Delhi directs Telegram to disclose the details of channels/devices used in disseminating infringing content.

The High Court of Delhi ("**High Court**") in the case of *Neetu Singh v. Telegram FZ LLC & Ors*³, directed the Defendant No. 1 i.e., Telegram FZ LLC ("**Telegram**") to disclose the details of the channels/devices used in disseminating the infringing content and also the mobile numbers, IP addresses, email addresses, etc., used to upload the infringing content and communicate the same to the Court.

In the instant case, the Plaintiff is a renowned author of books which are designed to train students aspiring to take various competitive examinations. The Plaintiff averred that on several channels on Telegram's platform, videos of the lectures delivered by Plaintiff are being uploaded on a daily basis and being made accessible to students at discounted rates. The Plaintiff also found that her books including the book titled '*Plinth to Paramount*' is being circulated in PDF format on Telegram channels.

It was also brought to the attention of the Court that the Telegram mobile application permits users to operate their businesses, either through a public channel or private channels. If they operate through private channels, the phone numbers or other details would not be visible. Thus, it is not possible to locate the owners of such channels. Such information is exclusively available

only with Telegram. Since Telegram also makes secret chats possible, the phone numbers cannot be traced, and the identity of the person(s) remains unknown.

Telegram argued that as per its privacy policy, any abuse of Telegram channels can be reported. Accordingly, after acquiring knowledge of the illegal dissemination of the Plaintiff's works, e-mails were sent to the e-mail addresses of the users operating the respective Telegram channels so that abuse can be reported. Upon receipt of the said notices some channels were taken down by Telegram, but some infringing channels continued to exist, and new channels came up almost on a daily basis.

The key issue before the High Court was whether Telegram can be directed to disclose the identity of the creators of the infringing channels, infringing the Plaintiff's copyrighted works. In this regard, Telegram opposed the sharing of data relating to the creators or users of the channels, as the said data is stored in Telegram's data servers in Singapore and the law of Singapore prohibits such disclosure. Moreover, as per Telegram, it being an intermediary under the Information Technology Act, 2000 none of the pre-conditions which permit the intermediary to disclose the identity of the users, as per the Intermediary Guidelines and Digital Media Ethics, 2021 ("**IT Guidelines**") were in the case.

According to the High Court, under the provisions of the Copyright Act, 1957 ("**Act**") the copies of the Plaintiff's works, which were being circulated on Telegram channels, constituted infringing copies as defined under Section 2(m) of the Copyright Act. Pursuant to Sections 55 and 58 of the Act, the High Court directed seizure of the "infringing copies", as also of the "plates" (it was clarified by the High Court that the devices of the channel operators, which are permitting and enabling such dissemination and communication, would constitute "plates" within Section 2(t) of the Act and they would constitute "duplicating equipment") used for creating such copies.

The High Court further directed that merely because Telegram chose to locate its server in Singapore, the same could not be a ground to leave the Plaintiff completely remediless against the actual infringers, especially in order to claim damages and avail of other legal remedies in accordance with law. The High Court noted that in

3. 2022 SCC OnLine Del 2637, judgment dated August 30, 2022.

the present age of cloud computing and diminishing national boundaries in data storage, conventional concepts of territoriality could be strictly applied. It was emphasized by the High Court that dynamic evolution of law is essential to ensure appropriate remedies in case of violation of copyright and other IP laws.

Consequently, Telegram was directed to disclose the details of the channels/devices used in disseminating the infringing content, mobile numbers, IP addresses, email addresses, etc., used to upload the infringing material and communicate the same, as per the list of channels filed along with the application.

THEOS v. THEOBROMA: An Amicable Settlement

Recently, pending disputes between Theos Food Pvt. Ltd. and Theobroma Foods Pvt. Ltd have been amicably settled on August 24, 2022, before the High Court of Delhi wherein the parties agreed to co-exist within the specified territories.

Both the parties are leading businesses in the field of bakery related products, patisseries, confectionery etc.



However, Theos Food Pvt. Ltd. ("**Plaintiff**") is based in New Delhi, and Noida whereas Theobroma Foods Pvt. Ltd. ("**Defendant**") operates mostly from Mumbai, Maharashtra.

Both the parties sued each other for adoption of the marks "THEOBROMA", "THEOS", "THEO'S" and two suits were instituted before the High Court of Delhi and Bombay High Court. The said two proceedings are:

1. "Theobroma Foods Pvt. Ltd. v. Mr. Karan Narula"⁴ was pending before Bombay High Court. The suit was filed to seek an injunction restraining Theos from using the marks 'THEOBROMA', 'Theobroma' 'theobroma', 'theo', 'Theo', 'Theo's', 'Theos' and various other variant and derivatives thereof.

2. "Theos Food Pvt Ltd. V. Theobroma Foods Pvt Ltd."⁵ was pending before the High Court of Delhi. The instant suit was filed seeking permanent injunction restraining Theobroma from infringing the trade mark 'THEOS', 'THEO'S' and 'THEO'S PATISSERIE & CHOCOLATERIE', passing off, unfair competition, dilution etc.

In their amicable settlement, the parties have reached an agreement that (i) Plaintiff shall accept the mark "THEOBROMA" and will not use it in any manner possible. Whereas Defendant shall also no longer object to Plaintiff's using the marks 'THEOS'/ 'THEO'S'; (ii) Defendant shall be free to expand its outlets under the mark/name 'THEOBROMA' across the country. However, Plaintiff will limit its operations to the Delhi-NCR region, insofar as its goods and services provided under the mark/name 'THEOS'/'THEO'S' is concerned; (iii) Plaintiff will cease the use of the mark 'THEOS'/ 'THEO'S', from its online menus but can use it in their physical menus.

Additionally, the terms of the settlement also allow the parties to retain their respective registered trade marks, including the trade marks in contention.

Diageo vs. Great Galleon: Trade Dress imitation amounts to Passing Off, observes High Court of Delhi

In a suit for infringement of registered design and passing off filed by Diageo Brands and United Spirits Ltd. ("**Plaintiffs**") against Great Galleon Ventures Ltd. ("**Defendant**"), the High Court of Delhi restrained the Defendant from manufacturing, selling, offering for sale, importing, exporting, advertising, directly or indirectly dealing in the infringing products or any other product which had an identical/obvious or fraudulent imitation of the Plaintiffs' registered design or do any other act which would amount to infringement of the Plaintiffs' registered design⁶.

The Plaintiffs and the Defendant are both manufacturers, sellers, distributors, and marketers of alcohol in India. The Plaintiffs are the proprietors of the trade mark "VAT-69", "BLACK & WHITE" and "BLACK DOG" in India and worldwide. The Plaintiffs are also the proprietors of the registered design, "HIPSTER" bottle for the products

4. Commercial IP Suit No.342 of 2016

5. 2022 SCC OnLine Del 2309

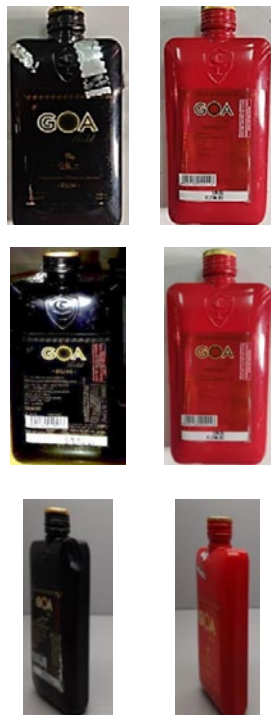
6. CS(COMM) 87 of 2021, order dated August 02, 2022

"Black Dog (Black Reserve)", "Black Dog (Golden Reserve)", "Vat 69", and "Black & White" ("**HIPSTER bottles**"). On the other hand, the Defendant is the manufacturer of the products under the brand, "GOA" and its variants, "GOA GOLD" and "GOA SPIRIT OF SMOOTHNESS". The Plaintiffs alleged that products of the Defendant sold under the mark "GOA" and its variants in 180 ml bottles were a "slavish and fraudulent imitation" of its registered design and a dishonest adoption of the trade dress and overall get up of their HIPSTER Bottles.

Plaintiff's Products



Defendant's Products



Before delving into the issues, the High Court of Delhi ("**Court**") observed that in order to succeed, at the interim stage, the Plaintiffs must prima facie demonstrate that they are the proprietors of a valid and subsisting design registration, and that the Defendant's bottle was an identical/similar/obvious imitation of their registered design. On the other hand, to deny the injunction, the Defendant must, on a prima facie basis, discharge the burden of proof that there was a strong ground to challenge or cancel the Plaintiffs' registered design made under Section 19 of the Designs Act, 2000 ("**Designs Act**").

The Court observed that there was no document which showed that any claim was laid on the ownership or proprietary rights of the Plaintiff in the design of the HIPSTER bottles. Therefore, there was no doubt that the Plaintiffs are the proprietors of the registered design.

The Court observed that it is trite law that for determining infringement of designs, the yardstick was 'visual effect', 'appeal to the eye of the customer' and 'ocular impression' of design, as a whole. The test was not to look out for subtle dissimilarities, but rather, to see if there was substantial and overall similarity in the rival designs.

While comparing the bottles of the Plaintiffs and the Defendant, the Court observed that the Defendant's bottles were remarkably similar to the HIPSTER bottles. The Court further observed that the Defendant had launched the design only in 2021, and therefore, the Plaintiffs are the prior user of the registered design since the year 2018. The Court concluded that the Plaintiffs have established a prima facie case in their favour and had successfully substantiated that the Defendant's product was an obvious and slavish imitation of their registered design.

The Court further held that none of the grounds for cancellation of Plaintiffs' registered design, namely, lack of originality, combination of known integers, lack of novelty, and the functionality aspect, were prima facie made out by the Defendant. The Court laid down that for a ground of design functionality to succeed, the Defendant must establish that the Plaintiffs' registered design was the only way possible to manufacture or create a given article, considering the functional requirements of the product.

After applying the ingredients to sustain the tort of passing off, and after a comparison of the trade dress as a whole, the Court was of the prima facie opinion that a case for passing off or imitation of the trade dress of the HIPSTER bottle is made out by the Plaintiffs.

Use of another person's well-known trade mark amounts to taking advantage of the goodwill that such a well-known trade mark enjoys.

The High Court of Delhi ("**Court**") recently restrained Shenzen Coloursplendour Gift Co Ltd. ("**Defendant**") from manufacturing and/or selling keychains and baggage tags which were identical to TATA SIA Airlines

Limited's and Vistara Airlines's ("**Plaintiff**") well-known VISTARA trade marks.⁷

In July 2020, the Plaintiff learnt that the Defendant was selling keychains and baggage tags bearing the VISTARA trade marks with the same aubergine and gold colour-combination as that of the Plaintiff, on the chinese e-commerce website AliExpress, and without the authorization of the Plaintiff. Despite AliExpress being based in China, the website contained several listings, by the Defendant, of the infringing keychains and baggage tags which were eligible for shipping to India. This suit was therefore instituted by the Plaintiff seeking inter alia a decree of permanent injunction restraining the Defendant from advertising, offering any goods or services, using or registering corporate names, domain names, or listings on social media platforms as also e-commerce websites which bear the Plaintiff's registered VISTARA trade marks and/or along with relief against passing off, dilution, tarnishment and unfair competition. None had entered appearance for the Defendant.

Plaintiff's Tags



Defendant's Tags



Placing reliance on *TATA SIA Airlines Limited v. M/s Pilot18 Aviation Book Store*⁸, in which the word mark of the Plaintiff, for 'VISTARA' was declared to be a well-known trade mark, the Court noted that the unauthorised use of the VISTARA trade marks by the Defendant not only amounts to infringement and passing off of the well-known VISTARA trade marks of the Plaintiff but would also cause dilution thereof. It is also likely to cause deception and confusion in the minds of the unwary consumer.

More importantly, the Court observed that airports are an incredibly critical junction of not only travel but also of trade and commerce; and any lapse in security, especially by permitting the sale of flagrantly infringing goods by the Defendant, would be turning a blind eye to obvious wrongdoings of the Defendant.

Further, considering the fact that the Plaintiff is the registered proprietor of the VISTARA trade marks and none had entered appearance for the Defendant, the Court opined that the Defendant had no justification for the adoption of an identical trade mark, as that of the Plaintiff, for sale of their goods.

In light of the above, the Court granted permanent injunction in favour of the Plaintiff. Further, in view of the object and mandate of the Commercial Courts Act, 2015; the Delhi High Court (Original Side) Rules, 2018; and the Delhi High Court Intellectual Property Division Rules, 2022, the Plaintiff was granted damages and costs quantified at Rupees 20 Lakh (approximately USD 2500).

Rejection of patent application due to lack of inventive step: Detailed reasoning should be provided by the Controller of Patents

A Single Judge Bench of the High Court of Delhi ("**Court**") in the case of *Gogoro Inc vs The Controller of Patents And Designs & Anr.*⁹ reiterated that while rejecting an application for lack of inventive step, discussion on prior art, the subject invention and manner in which the subject invention would be obvious to a person skilled in the art is mandatory. This case pertains to an appeal filed by Gogoro Inc ("**Appellant**") against the order of The Controller of Patents ("**Controller**") rejecting its patent application relating to a power charging system on the ground that it lacked inventive step. As per the Appellant, the Controller cited three prior art references but failed to explain how a person skilled in the art would arrive at the claimed invention. The Court while relying on the judgment in *Agriboard International LLC. v. Deputy Controller of Patents & Designs*¹⁰ held that merely arriving at a bare conclusion that the subject invention lacks inventive step would be contrary to Section 2(1) (ja) of the Patents Act, 1970 which defines "inventive step". The Court further held that in the absence of such an analysis as required under Section 2(1)(ja), the decision of the Controller becomes unreasoned. The Court has thus set aside the order of the Controller and has also allowed the Appellant to file amendments to its patent claims and asked the Controller to examine the patent application once again expeditiously.

8. CS(COMM) 156 of 2019, order dated 05.08.2019

9. C.A.(COMM.IPD-PAT) 25/2021; Order dated August 24, 2022

10. C.A.(COMM.IPD-PAT) 4/2022; judgment dated March 31, 2022

SNIPPETS

Using a trademark for non-competing businesses still amounts to trademark infringement

The Calcutta High Court ("**Court**") on September 01, 2022, passed a judgement in the case, Kaira District Cooperative Milk Producers Union Ltd. Vs. Maa Tara Trading Co,¹¹ wherein the Kaira District Cooperative Milk Producers Union Ltd. ("**Plaintiff**") sought perpetual injunction against Maa Tara Trading Co. ("**Defendant**") for duping the Plaintiff's trade mark, 'AMUL' to sell candles in Kolkata, West Bengal.

The Court relied on the test laid down by the Hon'ble Supreme Court in the case of *Cadila Health Care v. Cadila Pharmaceuticals*¹², on deceptive similarities and thus found the Defendant to be liable for infringement of the Plaintiff's registered trade mark under the Trade Marks Act, 1999. Further, the Plaintiff was also held liable for the tort of passing off. It was observed that the Plaintiff has been a registered proprietor of the trade mark 'AMUL' since 1958 and has garnered invaluable goodwill and immense reputation not only in India but across the globe. Hence, it was held that the Plaintiff's well-known trade mark 'AMUL' requires a broader scope of protection, be it in a non-competing domain.

Trade Mark dispute to register 3D shape of the "Hard Rock Guitar" in Japan.

The Guitar Hotel ("**Hotel**"), owned by the Seminole Hard Rock Hotel & Casino, Hollywood, in Florida, USA is the first of its kind hotel in the world, shaped as a guitar. The Seminole Tribe of Florida ("**Applicant**") applied for registration of its 3D mark with the Japanese Patent Office ("**JPO**") as per class 41 (Education and Entertainment) and 43 (Hotel and Restaurant) under the Madrid Protocol.¹³

The application was initially rejected for 'lacking distinctiveness' and not falling under the ambit of Class 41 and 43 was later allowed for registration. The JPO upon perusing the arguments of the Applicant in respect of the Hotel's eccentric design and unique features that can be easily distinguished, concluded that anything that is not foreseeable to the consumer with regard to the services in question would in itself be held as inherently distinctive, and would be considered a source indicator. Thus, on August 08, 2022, the JPO reversed the decision made earlier and registered the 3D shape of a guitar.

Use of the map of India permitted as a part of the Trade Mark

Jindal Industries ("**Appellant**") filed a Trade Mark Application in respect of Class 17 (NICE Classification), for the mark, . The Senior Examiner of Trade Marks ("**Examiner**") passed an order on March 19, 2019, for prohibition and objection of the mark under Section 9(2) of the Trade Marks Act, 1999 ("**Trade Marks Act**").



Pursuant to this order, the Appellant requested for grounds of decision, and on July 14, 2020, the Examiner provided that the mark was objected under Section 9(2) of the Trade Marks Act, and its use was prohibited under the Emblems and Name (Prevention of Improper Use) Act, 1950 ("**1950 Act**").

The present appeal arose against the impugned orders passed by the Examiner. The Appellant made the following submissions against the impugned orders of the Examiner:

- The use of the map of India had been permitted by the Survey of India in favour of the Appellant, vide letter dated February 08, 1994.
- There were other registrations granted in favour of the Appellant which used a similar device for the mark, wherein the map of India was depicted.
- The 1950 Act did not prevent the use of the map of India or the outline of the map of India.

The Single Judge of the High Court of Delhi ("**Court**") made the following observations, holding that the grounds for refusal provided by the Examiner were completely unsustainable:

- The 1950 Act did not prevent the use of the outline of the map of India.

11. 2022 SCC OnLine Cal 2516

12. 2001 (2) PTC 541 SC

13. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid, June 27, 1989, WIPO Doc. MM/DC/27 Rev. (1989)

- The Survey of India had already given its “no objection” in favour of the Appellant for use of the mark with the outline of the map of India.
- There were various other trade mark registrations bearing the outline of the map of India.
- The use of the outline of the map of India signified that the product originated from India, and therefore, was not violative of Section 9 of the Trade Marks Act nor the 1950 Act.

The Court conclusively set aside the impugned orders of the Examiner, and the application of the mark was directed to proceed for registration.

Mithila Makhana awarded Geographical Indication (GI) tag by Government of India

The Government of India recently awarded Geographical Indication (“GI”) tag to Bihar’s Mithila Makhana (Foxnut) under Class 29 (food products). Mithila Makhana is the fifth product from the state of Bihar which has received the GI tag. Prior to this, Bhagalpur’s Jardalu Mango, Katarni Dhaan (rice), Nawada’s Maghai Paan and Muzaffarpur’s Shahi Litchi have been recognised.

Bihar harvests around 80% of India’s total makhana supply. As per the GI Registry certificate, Mithila Makhana has been registered in the name of Mithilanchal Makhana Utpadak Sangh and the districts of Darbhanga, Muzaffarpur, Champaran, Begusarai, Madhubani, and Katihar among other districts have been defined as the geographic location for the production of Mithila Makhana. The attribution of the GI tag to Mithila Makhana is expected to benefit over five lakh farmers get a maximum price for their premium produce.



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