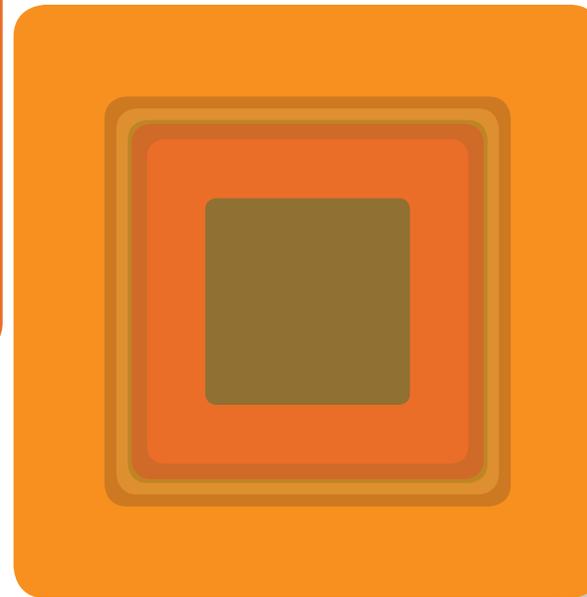


Newsletter



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## *Hike in Indian Patent Office Fee: Draft Patent (Amendment) Rules, 2013*

The Department of Industrial Planning and Promotion (DIPP), Ministry of Commerce and Industry, Government of India has recently issued a notification with respect to the amendment of Patent Rules, 2003, by the draft Patent (Amendment) Rules, 2013. The said draft rules propose to raise the fee levied for filing and prosecuting patents before the Indian Patent Office. Additionally, the said draft rules provide an incentive to applicants for electronic filing by levying an additional fee of 10% on any filing done on paper.

Comments and suggestions on the draft rules were invited from stakeholders and have been published in the Gazette of India. The said draft rules are expected to be tabled in the upcoming monsoon session of the Parliament.

## *IPAB rejects Monsanto's method patent application*

On 5 July, 2013, the Intellectual Property Appellate Board (IPAB) denied grant of patent to Monsanto Inc. for a method of producing plants which can withstand harsh environmental conditions.

Monsanto Inc. filed the application for patent in India on 1 May, 2006 for a 'recombinant DNA molecule for enhancing stress tolerance in plants, recombinant plants and methods thereof'. The application initially claimed (i) recombinant DNA (rDNA) molecule encoding a specific cold shock protein (CSP) (ii) steps for inserting the rDNA into plant cells and (iii) transgenic plants expressing CSP. Later, Monsanto Inc. restricted the scope of the application to 'a method of producing a transgenic plant with increased heat tolerance, salt tolerance or drug tolerance' and the claims on CSP, responsible for the cold tolerant properties and the resultant stress-resistant plants, were excluded.

The Controller of Patents refused registration on the basis of lack of inventive step and that the subject matter is ineligible in terms of Sections 3(d) and 3(j) of the (Indian) Patents Act, 1970. Subsequently, the IPAB concurred with the Controller's decision against grant of patent to Monsanto Inc.



## *Merck granted ex-parte injunction against Aprica Pharma for its anti-diabetic drug*

In a patent infringement suit instituted by U.S drug-maker Merck, the Delhi High Court passed an ex-parte/ preliminary injunction order against India's Aprica Pharmaceuticals, which tried to market generic versions of the drug *sitagliptin* (marketed by Merck as Januvia and Janumet).

Granting the *ex-parte* injunction, the Court concluded that a *prima facie* case on merits has been made out by Merck and balance of convenience lies in its favour. Further, it was held that in case injunction is not granted to Merck and Aprica Pharma is able to launch its product, irreparable loss and injury would be caused to the former which cannot be compensated in terms of money.

## *Indian Patent Office publishes 'Statements of Working'*

For the first time, the Indian Patent Office has made available online all the 'Statements of Working' filed by patentees for the year 2012. This has been hailed as a positive development as one will be saved from the trouble of seeking information relating to patents in India.

Under Section 146(2) of the (Indian) Patents Act, 1970, all patentees are required to submit information in Form 27 ('Statement Regarding the working of the Patented Invention on Commercial Scale in India') i.e. whether the patent is being worked or licenced or being worked through importation or domestic manufacture.

## ***Trade mark AYUR to be removed from Register: IPAB***

Disposing four petitions filed by M/s. ITC Ltd. against M/s. Three-N Products Pvt. Ltd., the Intellectual Property Appellate Board (IPAB) passed an order for the removal of the mark 'Ayur' from the Register of Trade Marks. ITC filed these petitions for rectification pursuant to a suit, filed by Three-N-Products, restraining them from using the marks 'Ayurvibha', 'Ayurvar', 'Ayurbhog' or any other marks with the word 'Ayur' as a prefix or suffix.

ITC argued that the mark 'Ayur' is not a well-known mark and *per se* generic. On the contrary, Three-N-Products claimed that it has been engaged in the manufacture of cosmetic products under the trade mark 'Ayur' since the year 1984 and that the mark 'Ayur' is an invented word.

Relying on pertinent High Court judgments and its earlier order in *Hindustan Unilever Ltd v. Three-N-Products*, the IPAB held that the words 'Ayu' or 'Ayur' cannot be said to be invented words. Further, it was observed that 'Ayur' is a generic word and in public interest, it cannot be monopolized by anyone. Additionally, it was held that the words 'Ayu' or 'Ayur' cannot claim to have acquired secondary significance when there are so many traditional connotations signifying healthy long life, etc.

Conclusively, the IPAB directed the removal of trade mark 'Ayur', which is registered in the name of Three-N-Products, from the Register of Trade Marks.

## *Trade mark CHAMPION continues to exist on the Register*

The Intellectual Property Appellate Board (IPAB), in the case of *M/s Gillette India Ltd. v. M/s Harbans Lal Malhotra & Sons Pvt. Ltd.*, dismissed its rectification petitions, allowing the Respondent to retain the ownership of the trade mark CHAMPION. The appellant, an Indian subsidiary of U.S. based ‘The Gillette Company’, was seeking removal of two separate registrations for the trade mark CHAMPION (for razor blades and safety razors, falling in Class 8) from the Register of Trade Marks in India.

The IPAB rejected Gillette India’s argument that the term “champion” was used extensively as a laudatory term for brand imagery in television commercials worldwide and was therefore *public juris*, meaning that the Respondent could not claim a monopoly over it. Further, the IPAB raised questions over the intent of Gillette India, as it was only after the unsuccessful attempt to buy out the Respondent in 1996 that the company decided to use the word CHAMPION for its brand. It was held by the IPAB that the word “champion” might *prima facie* be laudatory, but could qualify for registration if and when it acquired secondary meaning. In addition, the IPAB observed that any attempt by an entity to oust a trademark owner is opposed to fair trade practices and international commercial behavior. As a result, both cancellation petitions were dismissed without costs.



# *Justice P Sathasivam is the new Chief Justice of India*

Hon'ble Mr. Justice P. Sathasivam has been appointed as the 40th Chief Justice of India, pursuant to the expiry of the tenure of Justice Altamas Kabir who served as the Chief Justice of India for over nine months. Justice Sathasivam was sworn in on 19 July, 2013 and will hold office till 26 April, 2014.



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