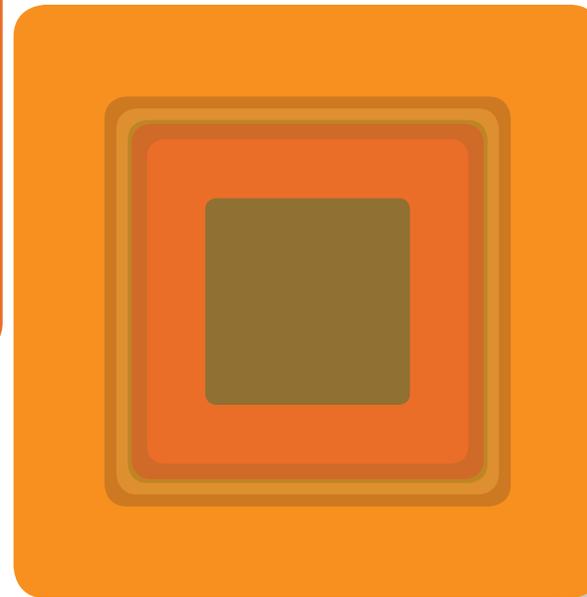


Newsletter



April - May 2014 Edition

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News from the Controller General of Patents, Designs and Trade Marks (CGPDTM)

Dynamic Trade Marks Utilities portal upgraded

We had covered the launch of the 'Dynamic Trade Marks Utilities' (DTU) portal by the Controller General of Patents, Designs and Trade Marks in our *October-November 2013 Newsletter*. The DTU was upgraded in May, 2014 to allow users to view trade marks and the flow of trade mark applications among the various stocks.

The stocks through which users may search are 'New Application Received', 'Awaiting Examination', 'Under Examination', 'Post Examination', 'Under Showcause Hearing', 'Published and Awaiting Opposition', 'Under Opposition', 'Under Registration Process' and 'Registered'.

16th Lok Sabha (House of the People) Elections

The General Election of 2014 for the 16th Lok Sabha was held in phases from April 7 to May 12, 2014 and the results were declared on May 16, 2014. The National Democratic Alliance led by the Bharatiya Janata Party (BJP) won a total of 336 seats and staked a claim to form the Government, while the BJP took 282 seats by itself. The Indian National Congress, leading party of the United Progressive Alliance (UPA) which was previously in power, managed to take 44 of the 58 seats won by the UPA. The outcome of these elections has given BJP and its allies the right to form the largest majority government since 1984. The clear majority gives the Government the power to implement reforms aimed at improving productivity and the business environment at a faster pace. The voters in these elections were young, literate and well-connected and will demand a greater accountability from the Government. The expectations are that the steady pace of implementation of policy reforms by the Government should yield a strong economic performance and enable the nation to achieve the desired GDP growth over the next 10 years.

Update on FDI Guidelines

Solicitor General on State Government's decision of policy reversal

Though the law ministry's opinion sought in February by the Department of Industrial Policy and Promotion (DIPP) on whether State Governments can reverse policy decisions after deciding to implement them is still awaited, the Solicitor General Mohan Parasaran in his statement to the press expressed his view that policy may not be changed on account of change in the Government. Further, he stated that Foreign Direct Investment is the Centre's subject and added, policy reversals of this nature will create imbalance and send out negative signals to foreign investors. The new Government is likely to appoint its team of law officers to represent it before the courts and render opinions on policy issues.

New Commerce and Industry Minister indicates that FDI in multi-brand retail may not be allowed

Ms. Nirmala Sitharaman, the new Commerce and Industry Minister has stated that allowing FDI in multi brand retail may affect medium and small sized traders and/or small farmers as they have not been adequately empowered. She has further stated that FDI will be allowed in other sectors where it is required for, “*job and asset creation, infrastructure and acquisition of niche technology and specialised expertise.*”

News from the Courts

Justice G. Rohini sworn in as the Chief Justice of the Delhi High Court

Hon'ble Ms. Justice G. Rohini, who was formerly serving as the judge of the Andhra Pradesh High Court, has been appointed as the Chief Justice of the Delhi High Court, a few weeks after the former Chief Justice of Delhi High Court, Justice N.V. Ramana, was sworn in as a judge of the Hon'ble Supreme Court of India. Justice G. Rohini, the first woman Chief Justice of the Delhi High Court, was sworn in on April 21, 2014.

Justice R.M. Lodha elevated as the Chief Justice of India

Hon'ble Mr. Justice R.M. Lodha has been appointed as the 41st Chief Justice of India, pursuant to the retirement of Justice P. Sathasivam who served as the Chief Justice of India for over seven months. Justice R.M. Lodha was sworn in as the Chief Justice of India on April 27, 2014 and will hold office till September 27, 2014.

Supreme Court collegium recommends 4 names for elevation

The collegium of the Supreme Court has reportedly recommended Justice Adarsh Goel, Justice Arun Mishra, Mr. Rohinton Nariman and Mr. Gopal Subramaniam to be appointed as Judges of the Hon'ble Supreme Court of India. Justice Adarsh Goel and Justice Arun Mishra are Chief Justices of the Orissa High Court and Calcutta High Court, respectively. Mr. Rohinton Nariman and Mr. Gopal Subramaniam are eminent senior advocates of the Supreme Court. Both advocates were formerly Solicitor Generals of India.

Bayer moves the Delhi High Court, seeks restraint on export of Sorafenat by Natco

Bayer Corporation has filed a writ before the Delhi High Court seeking to restrain Natco Pharmaceuticals from exporting Sorafenat, the generic version of Bayer's patented drug Nexavar. Bayer also prayed for directions to the Customs Authorities to seize and confiscate consignments containing Sorafenat.

Natco had obtained compulsory license to manufacture and sell generic version of Nexavar from the Controller of Patents on March 9, 2012. The IPAB had also upheld the compulsory license granted by its order dated March 9, 2013. As per the terms and conditions of the compulsory license the drug can be made, offered for sale and sold only within India. Referring to the said condition, Bayer sought to restrain export of Sorafenat outside India. Natco submitted to the court that it has been selling the drug only within India and it cannot be held liable if there is sale of Sorafenat outside India by certain purchasers or retailers abroad. Natco however, requested the court to allow sending of samples of the active ingredients of Sorafenat abroad for experimentation and generation of clinical trial data and for submission to the Drug Controlling Authorities. The court has directed the Customs Authorities to ensure that Sorafenat is not exported. Further, Natco has been given liberty to seek court's permission to export the drug for clinical purposes.

JCB and Bull Machines: Delhi High Court restrains Competition Commission of India from passing any final orders on the investigation into JCB's abuse of dominant position

We had covered the order of the Competition Commission of India (CCI) directing investigation into abuse of dominant position by JCB India Pvt. Ltd. (JCB) in our *February-March 2014 Newsletter*. To recap, in 2011 JCB had initiated infringement proceedings before the High Court of Delhi against Bull Machines Pvt. Ltd. (Bull Machines) and obtained injunction against launch of Bull Machines' backhoe loaders 'Bull Smart' which caused their removal from the Excon 2011 Exhibition. After talks between the parties, JCB withdrew the application seeking *ex-parte* interim injunction 10 months after filing of the suit and the injunction was vacated on consent of the parties. Referring to the withdrawal and consequent vacation of injunction, Bull Machines had alleged before CCI that the infringement proceeding was initiated in bad faith, solely to prevent market access to Bull Machines' backhoe loaders 'Bull Smart'.

JCB challenged the aforesaid order of CCI before the High Court of Delhi on the ground that the investigation interferes with the jurisdiction of the court and would result in the court being placed under the supervision of CCI.

The court held that a substantial question of jurisdiction arises in the matter and referred to another order passed in a similar writ petition (Ericsson writ) filed by Telefonaktiebolaget LM Ericsson (Ericsson). The Ericsson writ was filed against CCI's investigation into an order of the court approving consent terms between Ericsson and Mercury Electronics (the informant before CCI in that case). The court in the said writ had restrained CCI or its Director General from passing any final order/report till the question regarding CCI's jurisdiction was decided. The investigation against Ericsson was allowed to proceed provided that no Ericsson official stationed abroad may be called by CCI without leave of the court. Thereafter, in the appeal from the said order

in the Ericsson writ, the court modified the order to the extent that Ericsson officials stationed abroad may be called for by the Director General, CCI on certain conditions. The stay on passing of any final order/report was not interfered with.

In the petition filed by JCB, the court has directed that the terms of the order passed in the Ericsson writ and the modifications made in the appeal shall apply to CCI's investigation into JCB. Consequently, CCI has been restrained from passing any final order/report, though it may carry on the investigation and call upon the officials of JCB, subject to the terms specified in the order.

Gujarat High Court quashes FIR for infringement of Copyright against spare parts dealer

A First Information Report (FIR) registered against an automobile spare parts dealer for infringement of copyright was quashed by the Gujarat High Court. The FIR was registered against Hasmukhbhai C. Panchal on the basis of a complaint made by an informant claiming to be an investigating officer of IPR Vigilance Indian Company. Hasmukhbhai C. Panchal moved the court for quashing and setting aside the FIR and contended that the provisions of the Copyright Act are not attracted to automobile parts and the First Informant was not authorised to make the complaint. Union of India submitted that the impugned FIR was for the alleged offences punishable under Sections 63 and 65 of the Copyright Act, 1957. None appeared for the First Informant despite being served.

The court observed that the FIR did not mention anything about the author or owner of the work in question or in what capacity the First Informant had lodged the FIR. Further, neither did the FIR disclose if the spare parts are artistic work or any other work to which the Copyright Act applies, nor did it mention if the First Informant had acquired any rights under the Copyright Act. Counsel for Union of India also failed to show how the allegations levelled in the FIR relate to any of the provisions of the Copyright Act. Counsel for Union of India also failed to show how the allegations levelled in the FIR. Hence, the court held that on a bare perusal of the FIR no case was made out under the provisions of the Copyright Act and quashed the FIR and consequential proceedings.

Astrazeneca sues Glenmark, alleges infringement of patent for its anti-diabetes drug Saxagliptin

Astrazeneca AB initiated proceedings against Glenmark before the High Court of Delhi alleging infringement of its patent for the base compound Saxagliptin. Glenmark submitted categorically before the court that it is only exporting Saxagliptin and Saxagliptin monohydrate, the products involved in the petition, to various countries and neither have the same been launched in India, nor does Glenmark intend to do so till the next date of hearing. The court, upon hearing the parties, ordered Glenmark to be bound by its statement till the next date of hearing. Glenmark may therefore continue to manufacture the drug for regulatory submissions to other countries, however, the same may not be launched in India. On a later date, Glenmark sought an amendment in the previous order and the said order was modified and Glenmark's submission with respect to export of drugs was confined to Saxagliptin monohydrate.

Novartis sues again over the anti-diabetic drug Vidagliptin, files quia timet suits before the Delhi High Court

In our *February-March 2014 Newsletter* we had covered the interim injunction obtained by Novartis against Wockhardt for alleged infringement of its product patent in Vidagliptin. Novartis had based its suit on the RTI response, received on March 18, 2014 regarding pharmaceutical companies which have obtained regulatory approvals from the Drug Controller General of India for Vidagliptin.

Novartis has now moved against five other pharmaceutical companies namely Biocon Ltd., Glenmark Generics, Cadila Healthcare, Bajaj Healthcare, and Alembic Pharmaceuticals on the basis of the RTI response of March 18, 2014. The suit against Biocon Ltd. was listed on March 28, 2014 when Biocon Ltd. submitted that they will

not manufacture, sell or export the drug for commercial purposes till the next date of hearing. Similarly, in the suits against Glenmark Generics and Cadila Healthcare, the Defendants submitted that they have started manufacturing and exporting the drug, however, the same has not been launched in India and undertook that the drug will not be launched in India till the next date of hearing. Similar to the Biocon matter, no injunction was granted in these cases however, the court stated that Defendants are bound down by their statements.

Bajaj Healthcare and Alembic Pharmaceuticals were enjoined from manufacturing, importing, selling, offering for sale, exporting directly or indirectly or dealing in pharmaceutical products, compound or formulation or combination containing Vildagliptin alone or Vildagliptin in any other combination in violation of Novartis' patent till the next date of hearing.

Update on the United States Trade Representative Report – India not classified as “priority foreign country”

The United States Trade Representative (USTR) contrary to the request of the US Chamber of Commerce, has not named India as a priority foreign country in the “Special 301” Report. India continues to be placed on the Priority Watch List which comprises countries that, to the USTR, “present the most significant concerns regarding insufficient IPR protection or enforcement, or otherwise limited market access for persons relying on intellectual property protection.”

However, the US has decided to conduct Out-of-Cycle Reviews of India (the only country from Priority Watch List named for these reviews) along with Watch List countries Kuwait and Paraguay. The IP regime/s of countries are usually reviewed by USTR before every “Special 301” Report but, courtesy the Out-of-Cycle Reviews, the IP practice, policy and regime of India will now be reviewed periodically by the USTR to “enhance engagement” and “encourage progress on IPR issues of concern”. The then Commerce and Industry Minister Anand Sharma had categorically stated that India shall not submit to any investigations which go beyond the requirement of Trade Related Aspects of Intellectual Property Rights (TRIPS).

Pre-grant opposition filed by NATCO to grant of patent to Gilead's Hepatitis C drug sofosbuvir

It is learnt that Natco has filed a pre-grant opposition to the Hepatitis C drug sofosbuvir, to be marketed as Sovaldi, manufactured by Gilead Sciences Inc. In November, 2013 a USA-based advocacy group viz. the Initiative for Medicines, Access & Knowledge (I-MAK) had also filed a pre-grant opposition to grant of patent to sofosbuvir. The primary ground of opposition by I-MAK, as reported, was that the drug is not innovative enough at the molecular level. The pre-grant opposition filed by Natco is reportedly, on similar grounds of lack of inventiveness.

Compulsory registration of imported electronic goods not ultra vires the Constitution or a ban on parallel imports - Gujarat High Court

The Gujarat High Court rejected a writ petition challenging the “Electronics and Information Technology Goods (Requirement for Compulsory Registration) Order, 2012” and the notifications issued pursuant thereto by the Central Government in exercise of powers under the Bureau of Indian Standards Act, 1986 and the Rules made thereunder contending that the same were *ultra vires*, unconstitutional and violative of Article 19(1)(g) of the Constitution of India (right to carry on business) and an indirect ban on parallel imports. The petition was filed by Global Excess, a firm engaged in the business of importing electronic goods such as computers, printers and other accessories from various countries and selling them in India.

The petitioner argued that the aforesaid Order and the notifications have the effect of destroying parallel imports and hampering the business of importers such as the petitioner as the same mandate compulsory registration of the aforesaid products by getting them tested in Bureau of Indian Standards (BIS) recognized laboratory through a manufacturer or by a person duly authorized by such manufacturer by providing such technical specifications which only the manufacturer possesses. Therefore, the said order is discriminatory as manufacturers, who are multinational companies (MNCs), will have a monopoly in the field of import and sale and has effectively resulted in an indirect ban on the parallel import of the goods from 3rd July 2013 (the Order came into effect this day), which is otherwise permissible under the Patents Act, 1970. Petitioner further argued that parallel import is a mechanism which is helpful for providing commodities to the consumers at an international competitive price and the aforesaid Order is violative of the principles of natural justice as no opportunity of hearing was given to the petitioner and other similarly situated persons before introducing such a policy. It was argued on behalf of the Union of India that the Order was not sudden and due notice was given to all concerned. Further, the Order is equally applicable to imported as well domestically made electronic goods. At any rate, the Order covers only 15 categories of electronic items.

The court held that the Order is not discriminatory. It is applicable to the manufacturers of electronics and information technology goods irrespective of their nationality. The court held that any manufacturer is obliged to get electronics and information technology goods tested and registered with the BIS before marketing and selling the same in India. Therefore, a similar requirement for goods being imported, to ensure that they adhere to the standards prescribed in India, could not be said to be violative of Article 19(1)(g) of the Constitution. Further, the court found that the Order is in public interest as in the event of 'something going wrong' without testing and registration, the innocent consumer will suffer without anyone being held accountable. It was held that the Order does not completely ban parallel imports, which are permitted subject to certain restrictions like submitting the products for testing to the BIS recognized labs.

PIL filed in Gujarat High Court seeking directions against arrest of automobile spare parts dealer for infringement of copyright

Anil Sanghvi, an automobile spare parts dealer has filed a Public Interest Litigation before the Gujarat High Court seeking directions to police authorities to not arrest vendors for infringement of copyright and trade mark laws without following proper norms. Reportedly, the grievance of the petitioner is that dealers who sell local-made adaptable spare parts are arrested on the basis of FIRs without first obtaining opinion from the Registrar as stipulated under the Trade Marks Act, 1999 or conducting an inquiry about infringement of copyright. The court issued notices and allowed the request of the petitioner to add Authorities under the Trade Marks Act, 1999 as respondents in the matter.

Injunction restraining use of the domain namegroupon.in and Groupon Inc.'s mark Groupon confirmed

The High Court of Delhi confirmed the interim injunction obtained by Groupon Inc. against use of the mark GROUPON and the domain namegroupon.in by Value Net Ecommerce Pvt. Ltd. The plaintiff, Groupon Inc. is a US-based company engaged in the business of offering online customers daily discount vouchers on products and services under the mark GROUPON in USA since October, 2008. The plaintiff submitted that in September, 2010, it became aware that Mr. Mohan Rao, director of Value Net Ecommerce Pvt. Ltd. is the registrant of the domain namegroupon.in and immediately contacted him to purchase the said domain name. Mr. Rao refused to sell the domain name however suggested that he is ready to do business in India with plaintiff. The plaintiff was also informed by Mr. Rao that he had applied for and obtained registration for the mark GROUPON. Later Mr. Rao offered to sell the domain namegroupon.in to plaintiff for USD 5 million dollars which was rejected by the plaintiff and subsequently the suit was filed. Mr. Rao submitted before the court that he was the pro-

prietor of the mark GROUPON and the domain namegroupon.in since September, 2009 and was conducting the business of offering discount coupons under the domain namegroupon.in in India. The plaintiff, on the other hand submitted that it had not commenced or undertaken any business activities in India in September 2009 however, had announced its entry in India in January 2011 through a national daily.

The court ruled in favour of the plaintiff noting that sufficient material had been placed on record to *prima facie* establish prior use as well as trans-border reputation of the mark. The court observed that globally, plaintiff was the prior user of the mark and its services were being offered on the internet. It was held that in the era of internet technology and presence of social networking websites, organizations can advertise their services and reach thousands of people all over the world instantaneously. The court further observed that plaintiff's services under GROUPON were featured in several international magazines and websites prior to September, 2009 when Mr. Rao acquired the impugned domain name and mark. Therefore, plaintiff's goodwill had spilled over into India prior to the defendants' adoption of the mark in question. The court concluded from the documents on record that even in September 2009, defendants had not commenced their operations, by which time plaintiff had already been covered by an Indian blog titled StartupDunia. The said blog suggested the idea of a "groupon clone" for Indian cities. The court referred to another web article of December 2009 which referred to a similar start up business in India by the name of MyDala as a "groupon clone". It was held that, "*a similar business in India being labeled as a "groupon clone" is evidence enough of the plaintiff's popularity and goodwill in India.*" The court appreciated the data provided by plaintiff which indicated that before the defendants actually sold their first coupon, the plaintiff's website had received 30,000 visitors with Indian IP addresses. The court further found that since plaintiff is known to operate from its domain namegroupon.com and country specific domain names such as www.groupon.sg in Singapore, www.groupon.ca in Canada, www.groupon.kr in Korea, www.groupon.jp in Japan amongst others, these domain names act as business identifiers and thus, there is an extremely high likelihood that the website of the defendants www.groupon.in will be misconstrued to be the plaintiff's website in India. In view of the fact that plaintiff had established a *prima facie* case and balance of convenience in its favour, the court enjoined defendants from using the impugned mark or domain name till the final disposal of the matter.

Delhi High Court grants relief to MTS against order by Advertising Standards Council of India.

Recently Sistema Shyam Teleservices (SST) which provides mobile telecom services under the MTS brand had launched an advertisement featuring the birth of a baby who immediately begins to use the internet on gadgets like mobile and tablet. The Advertising Standards Council of India (ASCI) had passed an order stopping airing of the advertisement, reportedly after receiving several complaints. ASCI had held that the advertisement was “gross and indecent” and “offensive especially to women”. SST approached the Delhi High Court seeking a stay on the order of the ASCI on the ground that it was a non-speaking, non-reasoned order passed in violation of principles of natural justice and Article 19(1)(a) of the Constitution. The court issued notice to ASCI and granted interim relief on the ground that SST would suffer irreparable harm and injury if the same was not granted.

Jones New York fails to prevent registration of the mark ‘JONES’ in the name of Vishnupriya Hosiery Mills – IPAB upholds Registrar’s order

The Intellectual Property Appellate Board (IPAB) upheld the order of the Deputy Registrar of Trade Marks, Chennai dismissing the opposition filed against trade mark ‘JONES’ (label). The Notice of Opposition was filed by Jones Investment Co. (JIC), owners of the trade mark ‘JONES NEW YORK’, against registration of the trade mark ‘JONES’ in the name of ‘Vishnupriya Hosiery Mills’ (VHM).

JIC had submitted before the Deputy Registrar that it is the registered proprietor of the trade mark JONES NEW YORK and has used it internationally in relation to a wide range of goods from clothing for men, women and children, hosiery, footwear, leather goods since the year 1966 and acquired international reputation. VHM submitted that its mark JONES is different and the goods in respect of which JONES NEW YORK is used are not sold in India. VHM had claimed to have been using JONES honestly and continuously since 1993. The Deputy Registrar, after considering the submissions and grounds raised by JIC, had dismissed the Notice of Opposition. Aggrieved by the dismissal, JIC filed an appeal before the IPAB seeking setting aside of the Deputy Registrar's order on the grounds that the Deputy Registrar failed to appreciate that JONES NEW YORK has transborder reputation, is registered in over 35 countries and that VHM had not shown substantial sales to establish its reputation in India. Further, in the present age of technology and communication VHM cannot claim ignorance of the international reputation vesting in JONES NEW YORK.

The IPAB noted that till date JIC had not used its trade mark JONES NEW YORK and despite having claimed use internationally since 1966, had brought evidence on record showing use only from 1997. Whereas, VHM had claimed use since 1993 and had proved the same by producing documents. The IPAB referred to the Deputy Registrar's finding that no evidence was produced by JIC to show use as on the date of application and that in the absence of JIC's products in the market there could be no confusion or deception to Indian consumers. IPAB also rejected JIC's argument that the sale figures of VHM, being in lakhs, were meagre and not sufficient to distinguish their goods. IPAB referred to the decision of the Hon'ble Supreme Court in *Milmet Oftho Industries & Ors vs Allergan Inc* where it was held that, "*multinational companies who have no intention of introducing their product in India should not be allowed to throttle an Indian company and the Indian company who has genuinely adopted the mark and developed product and it is first in the market cannot be prevented from using the mark*". In light of the said principles, noting that VHM had discharged its onus by establishing prior adoption and use of the mark JONES in India, the IPAB dismissed the appeal.

Madras High Court orders reinstatement of DoCoMo's erroneously withdrawn patent application

NTT DoCoMo (Docomo) had filed two patent applications relating to increase and decrease pattern of transmission rate in the field of telecommunications. The patent attorneys wrongly communicated the patent numbers and the patent number for increase pattern was mentioned as the patent number for decrease pattern and *vice-versa*. Docomo later withdrew the patent application related to the decrease pattern of the transmission rate. However, due to error of the erstwhile patent attorneys, the application for increase pattern was actually withdrawn.

For reinstatement of the erroneously withdrawn patent, Docomo moved an application under Rule 137 (Powers of Controller generally) of the Patents Rules, 2003 before the Controller. The Controller stated that it was unable to correct any irregularity relating to the withdrawal of the patent application or to revive/reinstate the patent under Rule 137 even in light of Section 78 (Power of Controller to correct clerical errors, etc) of the Patents Act, 1970. Docomo thereafter moved the High Court by filing a writ seeking reinstatement of its patent application. The Madras High Court held that the Controller has vast powers under Section 78 read with Rule 137 and cannot refuse to revive or reinstate the application on account of a clerical error committed by the erstwhile patent attorneys.

Teijin's patent restored by the Bombay High Court

The Bombay High Court allowed a writ petition in favour of Teijin Limited (Teijin) for restoration of its patent. Teijin's agents erred twice in paying the annuities of Teijin's patent. Firstly, the agents mentioned the incorrect patent number while paying annuities for the 3rd to the 9th year of Teijin's patent. Secondly, the annuities for the 11th year were referred as 10th year annuities which was recorded as such by the Patent Office.

A letter seeking correction of the error was sent by Teijin the very next day and it was assumed by Teijin that the letter was taken on record and the correction was made. However, when Teijin sought to pay the 12th year annuity, it was informed that its patent stood ceased.

Teijin's agents thereafter filed an application for restoration of patent. During the hearings, the Indian Patent Office (IPO) informed the agents that their errors could not be corrected and the patent stood ceased. Aggrieved by the IPO'S order, Teijin approached the court. Teijin sought to correct the IPO's record to show that annuities for its patent for the 3rd to the 9th year had been paid as also the annuities for the 11th year. Teijin prayed for restoration of its patent or, in the alternative, a direction to the IPO to proceed with the application for the restoration of the patent on merits and in accordance with law. Teijin referred to its letter seeking correction of error sent the very next day after paying the wrongly recorded annuity and argued that the patent office should have informed Teijin that no correction could be made at that stage so that Teijin had the opportunity to pay the annuity again. Respondents contended that writ was not maintainable as the order of dismissal was appealable and Teijin had an efficacious alternative remedy. Respondents also argued, *inter alia*, that the letter claimed to have been sent by Teijin for correction of the error was never received by them and they had to rely on their inward register for the same.

On the issue of maintainability, the court stated that the IPO's act of giving notice only to the agents of Teijin and not to Teijin itself was in breach of principles of natural justice and therefore, the writ petition was maintainable. The court, in light of respondent's claim of not having received the letter, stated that the benefit of doubt should be given to Teijin as several letters sent by Teijin were received by the office. The court observed that there appeared to be a communication gap between the parties and without recording a finding on whether the letter was actually received by the IPO or not, quashed and set aside the impugned orders and directed the Controller to restore the patent. The court gave a further direction to Teijin to give an indemnity to the IPO in terms of Section 62 of the (Indian) Patents Act, 1970 and to not file any suit or make any claim during the period from which the said patent was treated 'as ceased' till the order passed by the court and for a period of three months thereafter. It was observed by the court that despite having the power to exercise his discretion under Rules 129 and 137 of the Patents Rules, 2003, the Controller assumed an '*adversarial position*' and refused to entertain Teijin's applications. The court went on to state that it was equally the duty of Teijin's agents to keep track of the matter and ensure that steps were taken under the letter seeking correction.

Madras High Court – existence of copyright is a triable issue

Tractors and Farm Equipment Ltd. (TAFE) sought to restrain Standard Corporation India Ltd. (SCIL) from infringing its copyright in the artistic work in the drawings for its tractors, by substantially reproducing the same for manufacturing, selling and dealing with SCIL's STANDARD 348 tractors which were identical or deceptively similar to the TAFE's MF 245 DI tractors.

SCIL filed an application before the Madras High Court praying for dismissal of the suit on the ground that more than 50 reproductions of the tractors have been made from the drawings in question and the suit is therefore not maintainable in view of the statutory bar under Section 15(2) of the Copyright Act, 1957. It was further contended that no remedy for passing off action is maintainable in respect of Designs. The Single Judge observed that that the suit involved mixed questions of facts and law such as whether the drawings could be considered as artistic work under Section 2(c) and copyright existed in the same, whether the industrial drawings reproduced for manufacturing the tractor are aesthetic or functional or to some extent aesthetic having functional attributes and if any remedy for passing off action is maintainable in respect of Designs. It was held that the issues involved could not be decided without framing specific issues and evaluating the evidence led during trial. Hence, the application was dismissed.

Aggrieved by the order, SCIL filed an appeal before the Division Bench of the Madras High Court. The Division Bench note that the civil suit was not rejected by the Single Judge, *in limine*, in view of the triable issues which had arisen for the consideration of the court and held that SCIL had not shown sufficient cause or reason for the court to interfere with the order and dismissed the appeal.

Sonu Nigam sues Mika Singh over violation of personality rights

Music artist Mika Singh was recently sued by singer Sonu Nigam before the Bombay High Court for acting in violation of Sonu Nigam's personality rights. Both artists were roped in to perform at the Mirchi Music Awards 2013. Allegedly, at the instance of Mika Singh, an advertising company published advertisements on hoardings depicting him in relation to the Mirchi Music Awards which also comprised a photograph of Sonu Nigam. Reportedly, these hoardings, unrelated to the original hoardings put up by the organisers (for which permission had been obtained), had been put up without seeking Sonu Nigam's permission and showed a puffed up image of Mika Singh along with a smaller image of Sonu Nigam. Sonu Nigam therefore, filed a suit against Mika Singh claiming that his image was used without his explicit consent. It was contended that Sonu Nigam's copyright, image rights and/or personality rights in his photograph comprised in the impugned advertisement were violated by the unauthorised publication. It was further claimed that the impugned advertisement disparaged, besmirched and tarnished Sonu Nigam's image, goodwill and reputation and was defamatory. The matter was settled between the parties and the court passed a consent order directing Mika Singh to pay INR 10 lakhs, to be deposited in various charities, as damages.

Belated filing of additional documents by Mylan accepted by the IPAB: No ground for review

Mylan Laboratories Limited had approached the Intellectual Property Appellate Board (IPAB) seeking revocation of a patent of OSI Pharmaceuticals (OSI) on the ground of *inter alia* non-disclosure and non-furnishing the information required under Section 8 of the Patents Act . The said revocation petition is pending before the IPAB. Mylan had thereafter filed a miscellaneous petition requesting the IPAB to allow filing of certain additional documents which were related to non-disclosure and non-furnishing of the required information under Section 8 by OSI. The petition was allowed as it was found by the IPAB that the documents were essential for

rendering justice and the filing thereof could not be refused merely because of delay. The IPAB also allowed OSI to rebut the documents.

OSI filed a review petition against the order. OSI contended that the order was flawed as it allowed filing of documents belatedly without specifying any reason. The IPAB did not accept the contention and stated that the documents were taken on record with an opportunity to the opposite side to file its response to the documents. Moreover, the order clearly stated that the documents filed were still subject to proof, admissibility and reliance and shall be examined in accordance with law. The Board found no error in its order and the review petition was dismissed.

Copyright in industrial drawing of 'Teeth Cutting Machine' lost once the machine has been used to produce more than 50 combs

Jagdamba Impex (Jagdamba) filed an appeal before the High Court of Delhi against a trial court order obtained by Tristar Products Private Ltd. (Tristar) restraining Jagdamba from using a machine which it used for manufacturing of combs. Tristar had obtained the said order on the ground that the machine for manufacturing combs used by Jagdamba is a copy of the machine made for Tristar from the drawings over which Tristar has a copyright under the Copyright Act, 1957.

The High Court allowed the appeal on the basis of the provisions of Section 15(2) of the Copyright Act. The court found that since, more than 50 combs had been manufactured using the TCM by Tristar, no rights could be claimed with respect to the drawings under the Copyright Act, 1957. The judgement does not however, indicate if copyright was being indirectly claimed in the combs or that the case was of a three dimensional depiction of a two dimensional drawing of an object which qualified for protection under the Designs Act.

Infringement action against another registered proprietor and Section 124 of the Trade Marks Act, 1999

LT Foods Limited (LT Foods) had filed a suit against Heritage Foods (India) Limited (HFIL) seeking to restrain HFIL from using the mark 'Heritage'. In the said suit, HFIL filed a composite application under Order 7 Rule 10 and Order 7 Rule 11 of the Civil Procedure Code, 1908, seeking return and rejection of the plaint, respectively. The Single Judge allowed relief under Order 7 Rule 11 on the basis of the finding that HFIL also holds registration for the identical mark 'Heritage' and therefore, no suit for infringement would lie against HFIL in terms of Section 28 (3) of the Trade Marks Act, 1999. On the issue of jurisdiction raised under Order 7 Rule 10, the Single judge was pleased to return the plaint on the basis of the finding that as far as passing off is concerned, courts in Delhi would not have jurisdiction as no part of cause of action had arisen within the jurisdiction of the court. This order of the Single Judge was challenged by LT Foods.

The Division Bench stated that an infringement action may lie against another registered proprietor if the conditions as stipulated in Section 124 of the Trade Marks Act, 1999 are satisfied. The suit was restored as far as the infringement action was concerned and was directed to be placed before the Single Judge for deciding if the conditions under Section 124 are satisfied. On the issue of jurisdiction, the court noted that the plaint refers to a cease and desist notice sent by HIFL which stated that goods under the mark 'Heritage' were being sold by HIFL through the length and breadth of the country. The Division Bench therefore, found that in light of the averments in the plaint, the court had territorial jurisdiction in respect of passing off action also. Hence, considering the settled legal position that in deciding an application under Order 7 Rule 10 the plaint must be taken as it is and the averments made therein must be accepted as true, it was held that the plaint could not have been returned. The court restored the plaint even in respect of passing off action and placed it before the Single Judge for further adjudication.

P&G restrained from using the marks ALL-AROUND PROTECTION and ALLROUNDER

Anchor Health and Beauty Care Pvt Ltd. (Anchor) had approached the Delhi High Court seeking injunction against use of the marks ALL-AROUND PROTECTION and ALLROUNDER by Procter & Gamble Manufacturing (Tianjin) Co. Ltd. (P&G) and others. Anchor claimed to be the registered proprietor of the mark ALLROUND in India since 2008 and had alleged that P&G had infringed its rights in the said trade mark by launching its products under the marks ORAL-B ALL-AROUND PROTECTION and ORAL-B ALL ROUNDER.

P&G contended that the mark ALLROUND is generic and descriptive and was not liable to be registered. Further, it was argued that though the registered mark of Anchor is ALLROUND, the standalone mark ALLROUND has never been used, instead the expression ALLROUND PROTECTION has been used by Anchor and therefore, Anchor is not entitled to claim exclusive rights or any equitable relief in respect of the standalone mark ALLROUND.

The Single Judge rejected P&G's contention that Anchor's mark is generic and descriptive, especially in light of the fact that P&G had itself applied for registration of the mark ALLROUNDER in India and obtained registration of the mark ALL-AROUND PROTECTION in the USA. The contention of P&G that the mark ALLROUND is not being used alone and hence Anchor is not entitled to any relief was also found to be without merits. The Single Judge held that Anchor has been using the mark ALLROUND PROTECTION and it cannot be claimed that there is non-use of the registered trade mark ALLROUND. The Single Judge found that the broad and essential features of the P&G's marks ALL-AROUND PROTECTION and ALLROUNDER are same as Anchor's mark ALLROUND and injuncted P&G from using ALL-AROUND PROTECTION/ ALLROUNDER or any other mark deceptively similar to the Anchor's trade mark ALLROUND till the disposal of the suit.

Aggrieved by the order of the Single Judge, P&G filed an appeal before the Division Bench of the court on the basis that the Single Judge erred on several grounds. It was argued that P&G could not be denied the statutory defences envisaged under Section 9 solely because it had applied for registration of the mark ALLROUNDER in India and obtained registration in the United States of the mark ALL-AROUND. It was submitted that P&G had mistakenly applied for ALLROUNDER in India and obtained registration of the trade mark ALL-AROUND

PROTECTION in the United States and is willing to give an undertaking to withdraw/surrender the same. Further, P&G stated that the packaging of the products was different and there was no possibility of confusion.

The Division Bench rejected the contention of P&G that the mark ALLROUND was not registrable. It was noted that neither the Registrar of Trade Marks nor anyone else raised an objection under Section 9 at the time of registration of the mark and when neither the Registrar in India nor the office in USA raised an objection to P&G's marks, the same could not be *prima facie*, considered to be descriptive. It was observed that Anchor is using ALLROUND PROTECTION on and in relation to its products as a slogan or tagline, which are important in branding and advertisement campaigns and the reason why P&G is claiming that ALLROUND PROTECTION is descriptive is only because the same has been used for a considerably long time as a tagline/slogan by Anchor. The Division Bench pointed out that the word ALLROUNDER is used in relation to cricket and if the same has now begun to be associated with toothpaste, it is on account of the long usage. The argument that use of ALL-AROUND PROTECTION does not constitute use of the registered mark due to addition of the word PROTECTION was also rejected. The Division Bench observed that P&G had itself registered its mark ALL-AROUND PROTECTION in the USA, disclaiming the word PROTECTION and this amounts to admission that use of the word PROTECTION as a suffix to ALL-AROUND does not negate use of the mark. The Division Bench was also not impressed with P&G's statement that it had applied for ALLROUNDER in India and obtained registration of the trade mark ALL-AROUND PROTECTION in United States in error and is ready to withdraw the same as no statements of this nature had been made in the written statement or pleaded on oath. The appeal was dismissed.



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