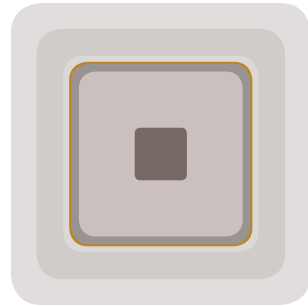
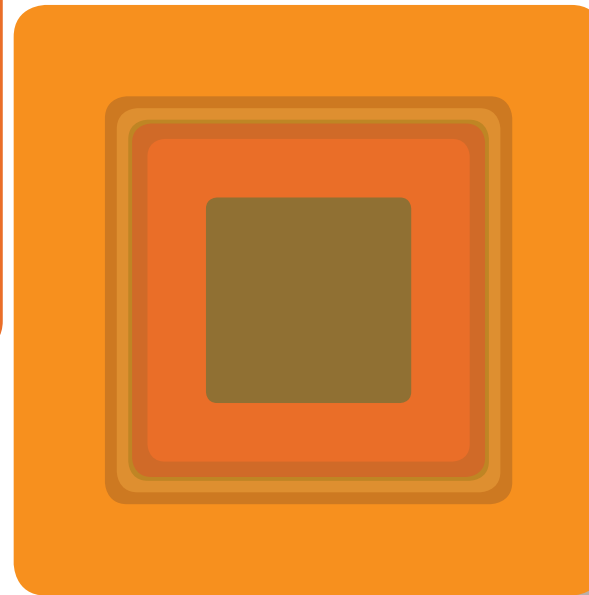
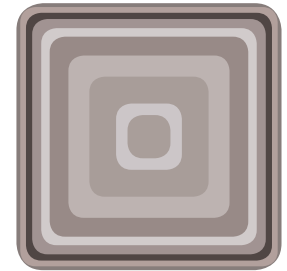























Newsletter



December 2013 - January 2014 Edition

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

CGPDTM publishes Classification of Goods & Services

Vide Public Notice dated 29 November, 2013, in terms of Section 8 of the Trade Marks Act, 1999 and Rule 22 of the Trade Marks Rules, 2002, CGPDTM has published classification of goods and services for the purpose of registration of trade marks. The classification consists of *Introduction (provides general guidelines for classification)*, *Class Headings*, *List of Classes with Explanatory Notes*, *Alphabetical List of Goods* and *Alphabetical List of Services*.

In view of the proviso to Rule 25(15) of the Trade Marks Rules 2002, trade mark agents/attorneys and applicants have been advised to adopt the names of goods and services corresponding to those given in the published classification, for the purpose of registration of trade marks.

CGPDTM publishes Guidelines for functioning under the Madrid Protocol

On 17 December, 2013, CGPDTM published the Guidelines for functioning under the Madrid Protocol (administered by World Intellectual Property Organisation) which came into effect in India from 08 July, 2013. [Please see our *April- May 2013 Newsletter*]

According to the said Guidelines, the Trade Marks Registry office of India will have two fold responsibilities under the Madrid Protocol:

- As an office of origin (Part A of the Guidelines)
- As an office of the designated contracting party (Part B of the Guidelines)

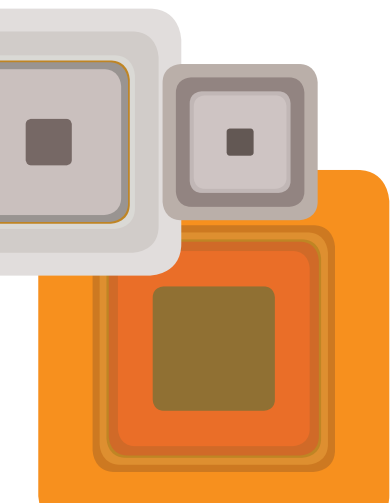
The Guidelines can be accessed at the following link:

http://ipindia.nic.in/Whats_New/guidelines_MadridProtocol_17December2013.pdf.

Quick Response (QR) Code system introduced by the Indian Patent Office

In order to enhance transparency in the public-delivery system, the system of QR Code(s) has been introduced and henceforth the same will be printed on the Renewal Certificates of Patents issued by the Indian Patent Office (IPO). This will provide the applicants with the facility to verify the contents of the Renewal Certificate issued. In addition, the intimation regarding the issuance of Renewal Certificates shall also be made available to the applicant/agent on record immediately through email (this will be extended to SMS in due course). Therefore, to access this service, applicants/agents have been advised to include their mobile numbers and email addresses in the “address for service” at the time of filing of the documents. Further, Registered Patent Agents are required to update their address for service in the “Register of Patent Agents”.

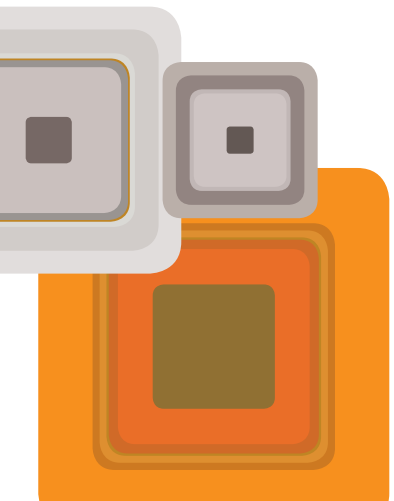
Additionally, *vide* public notice dated 10 January, 2014, the QR Code(s) system has been extended to Application Filing Receipts (AFRs) issued by the IPO.



Supreme Court upholds use of ‘Kohinoor’ rice by rival proprietor in the state of Uttar Pradesh

Recently, in *Satnam Overseas v. Sant Ram and Co.*, the Supreme Court decided the issue regarding the territorial limitation of the trade mark ‘Kohinoor’ on rice. The appeal was filed by Satnam Overseas (an Indian rice exporter major) to restrict its rival Sant Ram’s trade mark ‘Kohinoor’ to only six cities in the State of Uttar Pradesh.

Upholding the findings of the courts below, the said appeal was dismissed by the Supreme Court, on the reasoning that such a geographical restriction would create a lot of complications and litigations in respect of the exact boundary of a particular city or district. Therefore, disallowing pleas of geographical limitation, Sant Ram was allowed to retain and use the trade mark throughout the State of Uttar Pradesh.



Process Patent granted to Agricultural University in Haryana

Recently, Chaudhary Charan Singh Haryana Agricultural University (CCSHAU) in Hisar (State of Haryana), has been granted a patent on a technique for estimation of multi-residue in milk and milk products, which would be useful to the dairy industry and dairy businessmen.

The University had filed a total of 45 applications for patent in respect of its different technologies and the said patent is the tenth patent granted to the University so far.

Delhi High Court permits tendering affidavit in Ericsson v. Micromax patent law suit

On 06 December, 2013, the Delhi High Court delivered an order relating to an interlocutory application filed by Ericsson under Section 151 of the Civil Procedure Code, requesting the court to take on record two affidavits of Ericsson's executives along with claim chart mapping in a sealed envelope. [Please see our *April- May 2013 Newsletter*]

The court disallowed the affidavit which dealt with what transpired during the mediation proceedings on the ground that the relevant Rules governing mediation require the parties to maintain strict confidentiality. However, with respect to the other affidavit, the court concluded that the information disclosed therein was within the ambit of the plaint, read along with the documents filed with the plaint. Thus, the court permitted Ericsson to bring on record the second affidavit.

Whilst rendering its decision, the court summarised the position of law being that the plaint itself must set out with sufficient clarity, the specifications and the claims under the suit patent, the results they seek to achieve and in what manner the defendants have infringed the suit patents.

Iskcon sues Iscon over trade mark infringement

The International Society for Krishna Consciousness, a religious organisation popularly known as ISKCON, has filed a suit against “Iscon Mega Mall” and realty firm J P Infrastructure Pvt. Ltd., for using a similar name and logo.

In the said suit, Iskcon alleged infringement of its trade mark and sought to restrain the defendants. Consequently, the court issued notice and in response, the defendants filed an application demanding dismissal of the said suit. The realty firm argued that it had several residential, commercial and retail projects near the temple since the year 2000 and the plaintiff could not have been unaware of the use of the mark Iscon.

The application for dismissal of the suit was rejected by the court recently. The main suit is still pending.

Global Patent Filings exceed 1 Million mark in 2012: WIPO Report

Recently, the World Intellectual Property Organization (WIPO) released its 2013 edition of the World Intellectual Property Indicators which provides a wide range of indicators covering various areas of intellectual property. The said report draws on data from national and regional Intellectual Property offices, WIPO, the World Bank and UNESCO.

In 2012, for the first time, the total number of patent grants issued world-wide exceeded the one million mark and an estimated 8.66 million patents were in force across the globe. Patent filings saw a growth of 9.2% in 2012, the highest in two decades. The number of filings for industrial designs grew by 17%, which is the highest growth on record.

China topped the ranking for both the source (filings by China) and the destination (filed in China) for patents, utility models, trademarks and industrial designs. On the other hand, India reported a 3.9% growth in patent filings.

Bristol-Myers Squibb signs License Agreement with Medicines Patent Pool

The Medicines Patent Pool (MPP) and biopharmaceutical company Bristol-Myers Squibb have signed a Licensing Agreement to increase access to a key HIV Medicine “Atazanavir”. The MPP is a United Nations backed organisation that offers a public-health driven business model that aims to lower the prices of HIV medicines and facilitate the development of better-adapted HIV medicines in the developing countries.

This Agreement will allow manufacturers worldwide to produce more affordable versions of Atazanavir, and to combine it with other medicines to make treatment easier and more accessible in developing countries. It is estimated that the said Agreement is likely to benefit 110 developing countries across the globe. These countries represent 88.5% of people living with HIV/AIDS in developing countries.

Trade mark dispute: Lavasa v. Lavasa

In the case of *Lavasa Corporation Limited (LCL) v. Lavasa Visuals Private Limited (LVPL)*, the Bombay High Court granted an injunction against LVPL for the use of the mark LAVASA.

LCL filed a suit for infringement of its registered mark ‘LAVASA’ and passing off by LVPL, which was using the mark as a part of its corporate name.

The court concluded that LVPL’s contention that the mark LAVASA is common is flawed as no evidence of any nature had been put forth to show that it is a commonly used word in India. Further, the defense, that LVPL’s turnover is meagre compared to that of LCL’s, was considered to be unacceptable. The court also held it is clear that the plaintiff’s mark has become a well known mark and the defendant would most certainly had been aware of the same whilst adopting its corporate name. Therefore, the court restrained LVPL from using the mark ‘LAVASA’ and directed it to amend its corporate name.

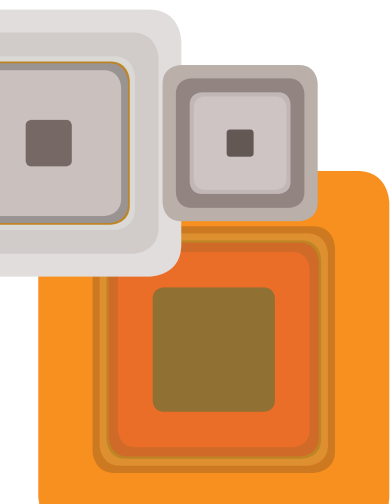
Delhi High Court rejects claims for copyright /trade mark protection of Yoga

On 10 January, 2014, the Delhi High Court declined to grant interim relief and rejected the copyright and trade mark protection claims by the Institute for Inner Studies (a Philippine company) being asserted against several defendants who are teaching Pranic Healing in India. Pranic Healing is a form of yoga which aims to heal ailments in the body by using “energy”.

Observing that yoga exercises/Pranic Healing techniques are not scripted and that there is no certainty in their performance, the court held that they cannot be called dramatic works or performances under the copyright law. Consequently, the Institute had failed to make out a *prima facie* case of copyright infringement.

In addition, assessing the claims that in 2001 the trade mark “Pranic Healing” was registered, the court held that the term is not distinctive and appears to be generic in nature as the technique has been taught for centuries in India. Further, the court opined that the expression Pranic Healing is incapable of performing the function of the trade mark and the trade mark registration secured by the plaintiff is *prima facie* inconsequential. Therefore, the claims of trade mark infringement were also rejected.

The court, however, temporarily forbid defendants from reproducing the contents of the books and the trade literature, brochures, CD-Roms etc. used by the plaintiff or using the same at the time of teaching or imparting training of Pranic Healing in their workshops.

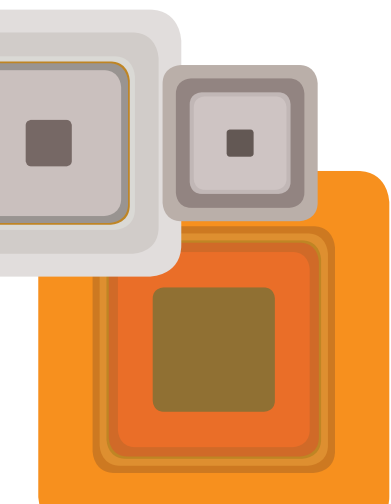


IPAB expunges 7 trademarks of TT Industries from the Register

The Intellectual Property Appellate Board (IPAB) has ordered the removal of trade mark “TT” registered in seven classes by Kolkata-based TT Industries. The said order was passed on rectification petitions filed by Taegu Tec, a South Korea-based manufacturer of metal cutting tools and accessories.

The South Korean firm alleged that TT Industries does not manufacture any of the products and has not sold or marketed a single product under the impugned mark falling in those classes, despite obtaining registrations.

The IPAB observed that even the best global brand cannot conceive of a business plan to use its trade mark universally for all goods/products. Further, it was concluded that the impugned mark is merely a two letter loose monogram and the respondent cannot expropriate one of the 26 alphabets all to himself against genuine business competitors seeking protection for unrelated goods. Therefore, the IPAB ordered the removal of seven “TT” trademarks registered in different classes.



IPAB orders to remove Swarovski's "Crystal Glamour" trade mark

The Intellectual Property Appellate Board (IPAB) has issued an order to remove the trade mark "Crystal Glamour" from the Trade Marks Register. The order came pursuant to the rectification application filed by Crystal Knitwear, a Tirupur-based apparel manufacturer which owns the trade mark "Crystal" in Class 25. The impugned mark "Crystal Glamour" had been applied for and registered by Austrian crystal jewellery and fashion accessories major Swarovski Aktiengesellschaft, in respect of Class 25 for clothes.

Crystal Knitwear claimed that it had adopted the trade mark "Crystal" in 1971 and has spent a huge amount in promoting and popularising the said mark. Further, it alleged that having full knowledge of its trade mark "Crystal", Swarovski applied for and obtained the registration of the impugned mark in Class 25. Additionally, it contended that the impugned mark was not used for a period of five years in respect of the goods for which the mark was registered by Swarovski.

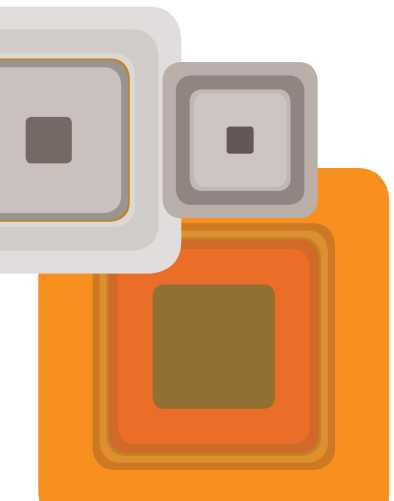
Subsequently, during the course of hearing, Swarovski informed the IPAB through a letter that the registration of the impugned mark had lapsed long ago and that it was not interested in reviving its registration. Therefore, the IPAB did not feel the necessity to go into the merits of the case and ordered removal of the impugned mark from the Register.

Applicability of the principle “proof of the right” to convention applications

Recently, the Intellectual Property Appellate Board (IPAB) in *NTT DoCoMo Inc. v. The Controller of Patents and Designs*, rendered a decision in respect of a patent application which was refused to proceed further by the Indian Patent Office (IPO).

The applicant, a Japanese company, with a priority application from the Japanese Patent Office (the convention country), had applied for a patent in India in the year 2006. However, the patent application was rejected by the IPO on the basis of lack of proof of the right. Consequently, the applicant challenged the rejection.

In light of the facts and the law, the IPAB rejected the applicant’s contention regarding non-applicability of “proof of the right” to a conventional application. However, in view of Section 15 of the (Indian) Patents Act, 1970, the IPO opined that an opportunity in the interest of justice shall be provided to the applicant for filing an amended application with the required documents. Thus, the IPAB remanded the application to the IPO.



Oppositions allowed: APEDA directed to file fresh GI Application for Basmati

In a recent decision passed on 31 December, 2013, the Geographical Indications (GI) Registry allowed six oppositions by Madhya Pradesh-based parties to the Basmati GI application filed by the Agricultural and Processed food products Export Development Authority (APEDA), an export promotion organization under the Ministry of Commerce & Industries, Government of India. APEDA's GI application covered only the states of Punjab, Haryana, Delhi, Himachal Pradesh, Uttarakhand and parts of Uttar Pradesh and Jammu and Kashmir.

In the instant case, the main ground of opposition of the parties was that there was no rational basis for including certain states and excluding others, particularly exclusion of the State of Madhya Pradesh. Further, no scientific nation-wide survey had been undertaken by APEDA to identify Basmati-cultivating areas in India before moving the said GI application.

Allowing the oppositions, the GI Registry directed the applicant to file an amended GI application including the uncovered area, with the map of the region clearly demarcating the areas of production.

2014 International Intellectual Property (IP) Index: India ranks last

Despite the current decade being called India's "decade of innovation", the country has been ranked at the bottom of the list of 25 countries in terms of its Intellectual Property (IP) environment. According to the 2014 International Intellectual Property (IP) Index by the US Chamber of Commerce's Global Intellectual Property Center, India's percentage score has fallen from 25 per cent in 2012 to 23 per cent. According to the report, the continued use of compulsory licences, patent revocations, and weak legislative and enforcement mechanisms are factors leading to the deterioration of the IP environment in India.

Most high-income economies have robust national IP environments in place and the weakest are in the lower-middle-income countries such as Vietnam, Indonesia, Thailand and India.

Indian Patent Office revokes Pfizer's patent on Detrol

Recently, the Indian Patent Office (IPO) has revoked Pfizer's patent on *Detrol*, a drug used to manage overactive bladder symptoms. The patent on the drug was challenged by Ranbaxy Laboratories.

Pfizer had two patents on *Detrol*, the first patent (211539) was filed in August, 1999 and the second (229260) three months later in November, 1999.

Though Pfizer's second patent has been revoked by the IPO, the first patent on *Detrol* is still valid. The IPO observed that the invention claimed in the revoked patent was found to be 'prior claimed' and it did not involve any technical advancement compared to the existing knowledge.

3M v. Venus Safety: Ex parte injunction granted

Recently, the Delhi High Court passed an injunction order *ex parte* in *3M Innovative Properties Company v. Venus Safety and Health Pvt Ltd*. In this case, the plaintiff (3M) is the patentee of an adaptable respiratory device for protection against air pollution. Allegedly, the defendants started manufacturing and marketing a respiratory device that infringed the plaintiff's patent.

The court compared the photographs and features of the two products and acknowledged the patent registration for the plaintiff's product in several countries. These facts, along with the fact that the plaintiff had obtained its patent in India in 2007, which had not been challenged, led the court to find that *prima facie* the plaintiffs have made out a case of infringement and accordingly, a preliminary injunction was granted.

Passing off in respect of pharmaceutical products: MUCOSOLVAN v. MUCOSOLVIN

The plaintiff, Boehringer Ingelheim Pharma GmbH & Co. KG, is a German pharmaceutical company which started business in 1885. It adopted the mark MUCOSOLVAN in 1975 and had been continuously using the mark internationally since 1979 in respect of cough syrups. The plaintiff enjoyed substantial goodwill and reputation in the world market, however, the product was yet to be introduced in India at the time of suing the defendants. Also, an application for registration of the plaintiff's mark is pending with the Trade Marks Registry. The defendants had commenced use of the mark MUCOSOLVIN on their range of cough syrups in the year 2011.

The plaintiff alleged passing-off because the two marks were visually, phonetically and structurally similar, and the defendants used the impugned mark on the same goods which would injure the plaintiff's reputation. Further, the plaintiff claimed that MUCOSOLVAN was a coined word and inherently distinctive. On the contrary, the defendants claimed that the plaintiff could not claim any reputation in India over its mark because it had never used the mark in India. In addition, the defendants contended that the plaintiff had been aware of their product as early as 2011, yet it filed a suit only in 2013 which amounts to acquiescence and the plaintiff was therefore barred from instituting the suit on the ground of delay.

The court invoked the test for passing off for pharmaceutical preparations laid down in *Cadilla Health Care v. Cadilla Pharmaceuticals*. It observed that the competing marks were composite marks with a close degree of resemblance due to only one letter being different in each mark. Therefore, in the instant case, the two marks were held to be deceptively similar.

Further, the court observed that the plaintiff was the prior user of MUCOSOLVAN owing to its worldwide use compared to the defendant's pan-India use much later in 2011. Therefore, in its order dated 16 December, 2013, the Delhi High Court concluded that the plaintiff had been able to establish a *prima facie* case that the defendants' adoption of MUCOSOLVIN was dishonest and accordingly, the interim injunction was confirmed in plaintiff's favour.

Ambit of Section 28(3) of the Trade Marks Act: A. Kumar Milk Foods v. Vikas Tyagi

In this case, the plaintiff was the registered proprietor of the mark SHRIDHAR for 'milk products, edible oil, milk, ghee etc.' under Class 29. The defendants were also the registered proprietors of the mark SHREEDHAR but for 'atta, maida etc' under Class 30. The plaintiff found out that the defendants had started using the mark SHREEDHAR for various dairy and milk foods falling under Class 29. Therefore, it sought to restrain the defendants from using the impugned mark in relation to goods falling under Class 29 and was, at this stage, not concerned with the defendants' use of the mark SHREEDHAR for goods falling under Class 30.

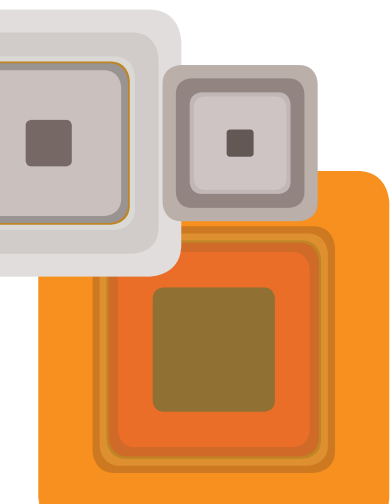
The court opined that the legislative intent was to extend the protection of the registered mark in respect of goods for which the registration was granted. The Act and Rules envisage classification of goods and require the proprietors to register under specific classes. Further, Section 28(3) of the Trade Marks Act, 1999 cannot be interpreted in a manner contrary to the scheme of the Act and the Rules. In other words, Section 28(3) would not permit an infringement action being brought by one registered proprietor against another only where two conditions are satisfied: that the two registered marks are identical or nearly resemble each other; and that they are in respect of the same class of goods and services. Therefore, the court decided in favour of the plaintiff and an interim order restraining the defendants was granted.

MONTINAL trade mark dispute: Innova Cap Tab restrained

Recently, the Bombay High Court passed an order restraining pharmaceuticals' manufacturer Innova Cap Tab and its affiliate from making and marketing any medicinal preparation under the trade mark MONTINA-L.

In 2002, the trade mark MONTINA was registered in favour of Aristo Pharmaceuticals for medicinal and pharmaceutical preparations. Subsequently, the said mark was renewed in the year 2012 for a period of 10 years. In addition, in August 2013, Aristo Pharmaceuticals started selling its products under the trade mark MONTINA-L.

Consequently, the court concluded that the mark subsists in favour of the plaintiff and held that if the defendants adopted an identical mark and, in any case, deceptively similar to the plaintiff's mark then in the face of its presence in the Register of Trade Marks, the defendants did so at their own risk and cannot claim any equity on the basis of such a user.





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