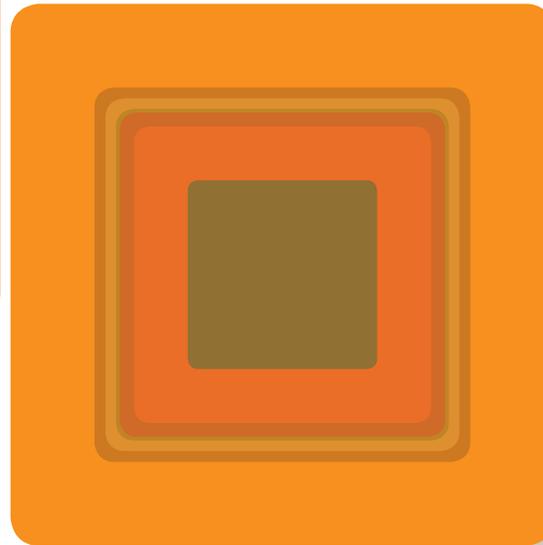
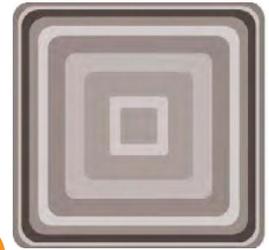


Newsletter



August – September 2015 Edition

Click to read in detail

-  [News from the Controller General of Patents, Designs and Trade Marks \(CGPDTM\)](#)
-  [Pfizer denied patent for Xeljanz](#)
-  [Lee Pharma rejected Compulsory License for Saxagliptin](#)
-  [IKYA wins over IKEA](#)
-  [‘Collector’s choice’ and ‘Officer’s Special’ deceptively similar to Officer’s Choice](#)
-  [Delhi High Court returns plaint of United Phosphorus Limited](#)



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

Clarification issued in respect of Designs Act and Rules by way of a circular

The Office of CGPDTM issued clarifications in respect of section 5(3) of the Designs Act ('the Act') and Rule 11(2) of the Designs Rules, 2001 ('the Rules').

Section 5(3) of the Act states that 'a design may be registered in not more than one class', while Rule 11(2) of the Rules reads as 'the application shall state the class in which the design is to be registered and the article or articles to which the designs is to be applied'. The aforesaid circular clarifies that an application can be made for any one or all the articles in that particular class, irrespective of the sub-classes therein. However, a separate application shall be made if same design is to be registered in more than one class of article.

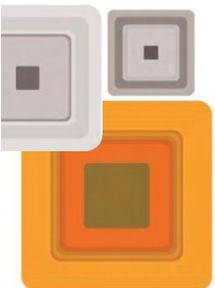
Trade Marks Examination, 2015

The Office of the CGPDTM has *vide* Public Notice of August 20, 2015, invited applications for registration as Trade Marks Agent under the Trade Marks Act, 1999. Eligible candidates will be called for Written Examination followed by an interview.

Guidelines for Examination of Computer Related Inventions

The Office of the CGPDTM has issued "Guidelines for Examination of Computer Related Inventions (CRIs)" in August, 2015 which shall be applicable with immediate effect. The Guidelines aim to foster uniformity and consistency in the examination of patent applications in the field of CRIs. Various provisions of the Information Technology Act, 2000, the Patents Act, 1970 and decisions of the learned Intellectual Property Appellate Board have been discussed by the Indian Patent Office to provide suggestions for the examination of patent applications.

However, in case of any conflict between the guidelines and the provisions of the Patents Act, 1970 or the Patents Rules, 2003 made thereunder, the said provisions and the Rules will prevail. Further, the guidelines are subject to revision from time to time based on interpretations by Court of law, statutory amendments and valuable inputs from the stakeholders.





Digital India Effect- Intellectual Property Office of India is on Twitter

The Office of the CGPDTM has launched a service on Twitter for stakeholders. Officials are now accessible on [@IPO_India](#) or [@IndianIPO](#) or [@CGPDTM](#). According to the CGPDTM, these accounts are only meant for knowledge sharing and no specific case related queries will be entertained.

Recruitment on Contract basis- Examiner of Trade Marks

In order to curb the backlog, recruitment drive for examiners was carried out at the Trade Marks Registry. The notice categorically mentioned that the positions are on contract basis for a period of one year only.





Pfizer denied patent for Xeljanz

As reported in the Economic Times, American drug maker Pfizer has been denied patent for certain isomers and stereoisomers of tofacitinib, a product it markets as Xeljanz for the treatment of rheumatoid arthritis. The base compound of the drug has been granted a patent. However, the follow-up improvement was not considered as an invention as prescribed by section 3(d) of the Patents Act, 1970.





Lee Pharma rejected Compulsory License for Saxagliptin

Lee Pharma Limited had applied for the grant of Compulsory License in June, 2015 for manufacturing and selling “Saxagliptin”, a patented drug of Astra Zeneca for diabetes on the following grounds:

1. The reasonable requirements of the public with respect to the patented invention have not been satisfied;
2. The patented invention is not available to the public at a reasonably affordable price; and
3. The patented invention is not worked in the territory of india.

We had covered this application in our newsletter issue of June-July 2015 and had mentioned that Lee Pharma awaits response of the Controller.

The Controller, in August, 2015, turned down Lee Pharma’s application on all the three grounds emphasizing that substitutes to the drug are readily available in the market and Lee Pharma’s claim that requirements of public with respect to the patented invention are not being satisfied has not been proven.





IKYA wins over IKEA

As reported in the Economic Times, Qess Corp Limited successfully resisted the action initiated by the Swedish multinational, IKEA - which deals in furniture and home furnishings, to restrain the use of the mark 'IKYA- the Power of Being One' along with logo. IKEA had averred that the use of IKYA violated its rights vesting in the registered trade mark IKEA. The Court appears to have dismissed the plea for injunction on the ground that the nature of businesses was totally different. Further, the defendant had commenced using the mark in the country much before the furnishing giant.





‘Collector’s choice’ and ‘Officer’s Special’ deceptively similar to Officer’s Choice

The division bench of the Hon’ble High Court of Delhi heard and disposed of two appeals preferred by Shree Nath Heritage Liquor Pvt. Ltd (hereinafter referred to as Shree Nath) and M/s Sentini Bio Products Pvt. Ltd (hereinafter referred to as Sentini) against the Order of July 1, 2014 passed by the learned Single Judge confirming the *ex parte* injunction granted restraining them from using the marks ‘Collector’s Choice’ and ‘Officer’s Special’, respectively for their products; alcoholic beverages and, in particular, Indian Made Foreign Liquor during the pendency of the suit. The suits were initiated by Allied Blenders and Distillers Pvt. Ltd., a manufacturer of alcoholic beverages under various trade marks and labels, one of which is ‘Officer’s Choice’.

The respondent in the appeals, M/s Allied Blenders and Distillers Pvt. Ltd, claimed that ‘Officer’s Choice’ is one of its most popular trade marks and was adopted in the year 1988. It filed the suits against Shree Nath and Sentini claiming violation of its trade mark ‘Officer’s Choice’ on the ground of deceptive similarity. The respondent alleged that, being the prior owner and registered proprietor of the trade mark ‘Officer’s Choice’, it had exclusive rights in the said trade mark. The appellants’ trade marks ‘Collector’s Choice’ and ‘Officer’s Special’ conveyed the same idea as that of the respondent’s trade mark, ‘Officer’s Choice’ i.e. choice of a person holding an office of authority. Hence, there is likelihood of confusion amongst the consumers.

Both the appellants claimed that the respondent’s registration for ‘Officer’s Choice’, the word ‘Choice’ has been disclaimed and thus the respondent has no right in the said word. Shree Nath also laid emphasis on the fact that its product under the mark ‘Collector’s Choice’ has a distinctive packaging when compared with the respondent’s packaging. Also, as regards the respondent’s claim for copyright infringement, Sentini claimed that its label was original and registered under the Copyright Act. Further, since the respondent did not have separate registrations for the words ‘Officer’ and ‘Choice’, its rights were limited to the combination of two words.

The Court relied on *Registrar of Trade Marks v Ashok Chandra Rakhit*, while discussing the effect of the disclaimer of the word ‘Choice’ in two of the respondent’s trade mark registrations where it was held that statutory disclaimer will have no bearing if the respondent’s trade mark has acquired secondary meaning. In the present case, it was observed that the respondent had acquired the goodwill and reputation due to long use and sales under the trade mark, ‘Officer’s Choice’ and thus, the question of disclaimer is not relevant.

Further, to decide the question of deceptive similarity between the marks of Shree Nath and the respondent, the Court applied the test of semantic similarity and relied on *Corn Products v Shangrila Foods*, where the Supreme Court held that ‘Gluvita’ was likely to cause confusion with the mark ‘Glucovita’ as both conveyed the same idea of glucose and life giving properties of vitamins. Moreover, likelihood of confusion increases with increase in the passage of time and sequential consumption of the products. The Court also emphasized that it is likely that once a consumer is confused between the marks, ‘Officer’s Choice’ and ‘Collector’s Choice’, especially when it is likely that he consumes one subsequent to the other and after sometime, the person may confuse the experience associated with them.





The Division Bench reiterated the view taken by the Learned Single Judge that the use of the mark “Collector’s Choice” by Shree Nath for whiskey is likely to cause confusion with the respondent’s whiskey sold under the mark “Officer’s Choice” and dismissed the appeal without any order as to costs.

The Court went on to discuss the question of similarity between the marks of Sentini and the respondent’s marks viz “Officer’s Special” and “Officer’s Choice”. It was argued on behalf of Sentini that it uses the prefix “Sentini” and hence, its mark is sufficiently distinct from that of the respondent. The Court relied on *Laxmikant Patel v Chetan Bhai Shah* and rejected the above contention of Sentini on the ground that adding a prefix to an otherwise deceptively similar mark may still not distinguish the marks. It further observed that Sentini’s label had the same color combination, border, and the manner in which “Officer’s Special” is written across the label as the respondent’s label.

The Court, thus concluded that Sentini’s label for “Officer’s Special” is deceptively similar to the label of the respondent for the purpose of infringement and passing off and dismissed its appeal.





Delhi High Court returns plaint of United Phosphorus Limited

United Phosphorus Limited, the plaintiff, filed the present suit for permanent injunction to restrain the defendants from marketing, selling, distributing, advertising, export offering for sale and in any manner, directly or indirectly dealing in any product that infringes the claims of the plaintiff's patents.

Two applications were disposed of simultaneously by the High Court of Delhi in the present suit. The first application was for impleadment under Order I Rule 10(2) of the Code of Civil Procedure (CPC) filed by the plaintiff and another filed by defendant no. 2 under Order VII Rules 10 and 11 of the CPC for return/rejection of the plaint.

The plaintiff sought to implead Coromandel International Limited having an office in Delhi as defendant no. 3. It was submitted that Sabero, defendant no. 2 is a subsidiary of Coromandel International Limited, and many of its products were being marketed by the proposed defendant no. 3 who has an office at Delhi. The plaintiff also submitted various documents in support of its contention such as a copy of the annual report for the year 2012-2013 of the proposed defendant no. 3 which showed that the company had completed acquisition of 42.22% equity shares of Sabero, defendant no. 2. Other documents were also filed as evidence to show that the business of Sabero was connected with Coramandel. Further, the plaintiff submitted that defendant no. 2 had amalgamated with the proposed defendant no. 3 and it is a proper and necessary party. Moreover, Coramandel has an office in Delhi and once it is impleaded as a party, the objection with regard to territorial jurisdiction would fail. The plaintiff also wished to implead DVA Agro Paraguay SRL as defendant no. 4, who has an office in Paraguay.

The defendants, *inter alia* based their arguments on various contentions such as defendant no. 2 is not using the office of Coramandel; Coramandel is manufacturing and marketing Acephate 75% based on its own license; the petition for sanctioning the scheme of amalgamation of the proposed defendant no. 3 was filed subsequent to filing of the present suit and the petitions were pending to date and the scheme of amalgamation was not sanctioned. Thus, defendant no. 2 and the proposed defendant no. 3 are two separate entities in the eyes of law and the jurisdiction of the Hon'ble Court cannot be invoked based on the presence of the holding company.

In the other application before the Hon'ble High Court of Delhi, defendant no. 2 prayed for rejection of the plaint on the ground that the Court lacks territorial jurisdiction. The defendant no. 2 argued that neither the plaintiff nor defendant no. 2 carry on their business at Delhi within the jurisdiction of the Court. The plaintiff has its registered office at Mumbai, whilst the defendant no. 2 is based in Gujarat and does not own, manage or run any office or place of business at Delhi. Further, the infringement of product patent cannot lie at Delhi as defendant no. 2 is not selling Acephate at Delhi or anywhere in India as the license granted to defendant no. 2 itself is only in respect of export and not for sale in India. Also, section 20 (c) of the Code of Civil Procedure is not applicable as defendant no. 2 does not have any branch office at Delhi. Defendant no. 2 further submitted that it is not aware of Mr. Ajay Garg, who has been arrayed as defendant no. 1.





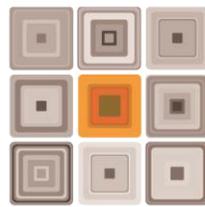
It was categorically stated in the written statement by defendant no.2 that defendant no. 1 is neither an employee of defendant no. 2 nor defendant no. 2 has any dealings whatsoever with defendant no. 1.

Defendant no. 2 averred that the plaintiff has invoked jurisdiction of this Court based on a third party website viz www.tradeindia.com which is accessible in the forum state. Defendant no. 2 placed reliance on *Banyan Tree Holding (p) ltd v A. Murli Krishna Reddy and Another* and argued that in order to establish that the defendants purposefully availed of the jurisdiction of the Court, the plaintiff would have to prove that the defendants were engaged in some commercial activity in the forum state by targeting their website specifically at customers within that state. It was held in the *Banyan Tree Holding (P) Ltd* case that mere hosting of a website, which can be accessible from anywhere within the jurisdiction of the Court is not sufficient and mere posting of an advertisement by the defendant depicting its mark on a passive website which does not enable the defendant to enter into any commercial transaction with the viewer in the forum state cannot satisfy the requirement of giving rise to a cause of action in the forum state. As regards the website relied upon by the plaintiff, the Court held that the website is neither an interactive website, nor documents have been placed to show that any commercial transactions have been carried out.

The Court, after reviewing the submissions and contentions of both the parties, opined that since no part of cause of action has arisen within the territorial jurisdiction of the Court and the defendants do not carry out their business or work for gain within the territorial jurisdiction of the Court, the plaint shall be returned to be filed in the appropriate Court of jurisdiction.

Given the decision of the Hon'ble High Court on jurisdiction, it opined that the application of the plaintiff for impleadment would also be decided by the appropriate Court of jurisdiction.





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