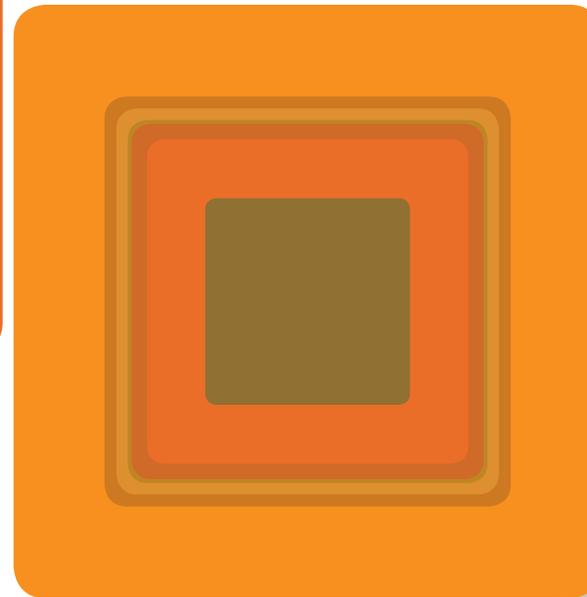
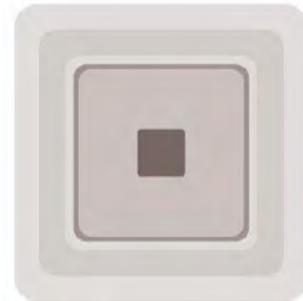


Newsletter



October-November 2013 Edition

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India starts functioning as International Searching Authority

Pursuant to the agreement, between the Indian Patent Office (IPO) and the International Bureau of the World Intellectual Property Organization (WIPO), which has come into force on 15 October 2013, the IPO starts functioning as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT). The said agreement shall subsist till the year 2017 unless terminated earlier.

As an ISA/IPEA, the IPO will be examining PCT applications and preparing and providing International Search Reports and International Preliminary Examination Reports to the applicants.

Being the only English-speaking nation in the Asian region to be recognized as an ISA/IPEA, it would mean that several international applications received by WIPO under the PCT would be sent to the IPO for search and preliminary examination. Besides international recognition, the new status would also generate revenue in the form of fees that would be provided to the IPO for functioning as an ISA/IPEA.

‘Dynamic Trade Marks Utilities’ portal launched

Following the launch of the ‘Dynamic Patent Utilities’ portal, recently the Controller General of Patents, Designs and Trade Marks has launched a ‘Dynamic Trade Marks Utilities’ (DTU) portal. The DTU portal will allow the public to see on real-time basis comprehensive information relating to examination of trade mark applications, show cause hearings, publications in the Trade Marks Journal, registrations of trade marks, otherwise disposal of applications (i.e. by way of abandonment, refusal etc.) and other notices issued month-wise or date-wise.

The portal can be accessed at ipindiaonline.gov.in.



Dasatinib compulsory licence rejected

The Controller General of Patents, Designs and Trade Marks has rejected a compulsory licencing application by Mumbai-based BDR Pharmaceuticals [please see our *August-September 2013 Newsletter*], to manufacture the generic version of patented anti-cancer drug *Dasatinib*. The rejection is on the ground that BDR Pharmaceuticals has not made any credible attempt to obtain a voluntary licence for the drug from the US-based Bristol Myers Squibb Company (patentee). Consequently, the domestic company has not satisfied the statutory requirement [Section 84 (6) (iv) of the (Indian) Patents Act, 1970] that the applicant must have negotiated in good faith for a reasonable period (not exceeding six months). Accordingly, as BDR did not make out a *prima facie* case, the application was dismissed at the threshold itself.

Trade mark 'Reddy' expunged from the Register

Recently, the Intellectual Property Appellate Board (IPAB) ordered for the removal of the trade mark 'Reddy' registered in favour of Reddy Pharmaceuticals Limited (respondent) pursuant to an application filed by Dr. Reddy Laboratories (applicant). As claimed, 'Dr. Reddy' was a mark adopted/used by Dr. Reddy Laboratories since 1984 (the application for the registration of the mark 'Dr. Reddy' was filed in 2001) and had acquired reputation and goodwill.

It is pertinent to note that Reddy Pharmaceuticals Limited was an agent of Dr. Reddy Laboratories for 10 years and this association was terminated on 1 April 2003. Subsequently on 17 April 2003, the respondent filed the application for registration of the impugned mark 'Reddy'. Though the respondent's application was filed subsequent to the applicant's application, the mark was registered in favour of the respondent in 2005 for 'medicinal and pharmaceutical preparations'.

The IPAB held that the respondent deliberately adopted the impugned mark to deceive the public and could not draw support on the basis of honest and concurrent use. Further, it was concluded that the Registrar of Companies erred in registering the (respondent's) name as this was in contravention of S. 20(2) of the Companies Act, 1956 which prohibits the use of someone else's trade mark as part of a corporate name.

Ranbaxy gets regulatory nod for anti-malaria drug

Recently, the Indian drug regulator Drug Controller General of India (DCGI) has given its approval to Ranbaxy Laboratories Ltd. to market the drug *Synriam* for treating malaria caused by *Plasmodium vivax* parasite. The said drug was launched in April 2012 and Ranbaxy had received the regulator's approval for marketing the drug only for treating *Plasmodium falciparum* malaria in 2011.

The recent approval makes *Synriam* one of the few therapies in the world that successfully treats both, *Plasmodium vivax* as well as *Plasmodium falciparum* malaria.

Cadbury's trade mark "Eclairs" removed from Register

In a ruling on 31 October 2013, the Intellectual Property Appellate Board (IPAB) rejected three "Eclairs" trade mark registrations on the basis of non-use. However, the rectification application, with respect to the fourth trade mark "Eclair Pop", was dismissed as infructuous as the mark had already been removed from the Register owing to non-renewal. The instant case was initiated by rival ITC Ltd. which is an Indian multi-business conglomerate.

The IPAB concluded that there is no evidence to prove that Cadbury has been using the three trade marks in question over the contentious period and the registration alone will not help them to prove the use.

Police remove pictures of Jagermeister bottles in anti 'drink and drive' campaign

German company Mast-Jagermeister SE, which engages in the production and distribution of herbal liqueur worldwide, recently filed a writ petition before the Madras High Court in respect of its trade mark infringement. The case revolves around the usage of the company's registered trade mark 'Jagermeister' in a 'don't drink and drive' campaign by the Tamil Nadu (TN) Police.

The campaign depicted bottles of Jagermeister (with their labels) next to the scene of a fatal accident. Mast-Jagermeister SE had requested the TN Police to remove the signage, but no action was taken. Consequently, the writ petition was filed and before the court, the TN Police agreed to remove the signage.

The decision reinforces the principle that a registered trade mark is exclusive to the proprietor and any use without authorisation would tantamount to infringement.

Delhi High Court upholds 'Bloomberg' rights

On 11 October 2013, the Delhi High Court passed an interim order in *Bloomberg Finance Lp v. Prafull Saklecha & Ors.*, on the subject of dilution of trade marks. The suit was filed by Bloomberg Finance to restrain the defendants from using the mark 'Bloomberg' as a part of their trade name, operating in the fields of construction and realty, food, entertainment, etc.

In the instant case, the plaintiff, a multi-national financial news corporation operating in India through its subsidiary/associate, claimed that in India, the plaintiff was using the mark 'Bloomberg' since 1996. Further, the plaintiff contended that the use of the mark by the defendants constituted infringement and passing off, thereby diluting the brand 'Bloomberg'.

The High Court concluded that the plaintiff had established *prima facie* the essential elements of passing off and consequently, the defendants were restrained from using the mark.

‘Vagabond’ trade mark dispute: Decision in favour of Swedish apparel firm

The Intellectual Property Appellate Board (IPAB) decided a trade mark dispute in favour of Swedish apparel firm Vagabond Skor Varberg AB (applicant) and against Italian firm Vagabond SPA. Initially, the latter opposed the attempt of the applicant to register the mark “VAGABOND” on the ground that it enjoyed trademark registration over the same mark (Registration No. 551738) in India. Subsequently, the applicant moved the IPAB seeking removal of the said trade mark “VAGABOND” in Class 25 of Vagabond SPA and Carrera SPA (which was officially recorded as a subsequent proprietor) from the Register of Trade Marks.

The applicant sought the removal on the premise that Vagabond SPA did not have the *bona fide* intention to use the impugned mark and that the registration precluded the genuine proprietor from seeking statutory protection under the Trade Marks Act, 1999. The applicant submitted a list of 41 countries wherein the trade mark ‘Vagabond’ had been registered along with the respective registration certificates and the International Registration under the Madrid Protocol among other documents as evidence to corroborate its case.

Given the facts of the case, the IPAB held that the registered mark was a blatant copy of the applicant’s trade mark and accordingly, the impugned mark be expunged from the Register.

IKEA protects its brand name

Recently, Swedish retail giant and globally recognised brand IKEA received regulatory clearance for entry into India. It is pertinent to note that IKEA has its trade mark registered in India for over 15 years now and has 45 registrations for different categories of products and services. In order to protect its brand name, goodwill and reputation in India, the retail giant sent a legal team to initiate trade mark infringement cases against over two dozen businesses in India that have been selling products/services such as furniture, modular kitchen and packaging material under same name or names sounding similar to IKEA. Injunction orders have already been sought against 15 parties located in Delhi, Mumbai, Hyderabad, Bangalore and Chandigarh.

Comparative Advertising: Hindustan Unilever Ltd. (HUL) and Reckitt Benckiser (India) Ltd.

Recently, the High Court of Calcutta delivered a judgment in a dispute relating to four advertisements published by the two parties. This is the third matter between the said parties on the issue of comparative advertising.

The first impugned advertisement is an advertisement in the print media which portrays Dettol Kitchen Gel killing 100% more germs than the leading dish wash of the day. The second impugned advertisement is a television advertisement having a similar theme, with the significant difference that instead of leading dish wash, the Dettol product is being directly compared with VIM dish wash. The third impugned advertisement shows Lifebuoy Soap as having 100% germ removal capacity while Dettol Antiseptic Liquid was shown to have close to none. The fourth impugned advertisement shows an antiseptic liquid as unsafe for children and consequently for washing utensils while stating that 'VIM' is safe owing to its natural ingredients.

The court observed that Section 30 of the Trade Marks Act, 1999 permitted comparative advertisements to the extent that they promote the trader's own product and prohibits lowering the reputation of the rival trader's trade mark. Therefore, the court issued injunctions against all the impugned advertisements as they constituted prohibited comparative advertising which went beyond the permissible limit of puffing up one's own products.

John Abraham's production house permanently restrained from using 'Hamara Bajaj'

The Bombay High Court has restrained Bollywood actor John Abraham's film production house J.A. Entertainment Pvt Ltd, from using the movie title 'Hamara Bajaj', a popular tagline associated with the auto firm Bajaj Auto Ltd. Apparently, the movie derives its title from the story of the film which revolves around the life of a certain character named 'Sanjay Bajaj'.

By a consent order, the High Court granted a permanent injunction against J.A. Entertainment from using 'Hamara Bajaj' as a movie title, also restraining it from using the mark 'Bajaj' and the words 'Hamara Bajaj' anywhere in the contents of the proposed film or elsewhere in relation to the film.

Trade mark 'Nirma' struck off from metal products category

The Intellectual Property Appellate Board (IPAB) has ordered the removal of trade mark 'Nirma' for the proposed metal products (Class 6) of the Gujarat-based detergent maker Nirma Chemical Works.

The said IPAB order came in response to an appeal filed by Mumbai-based Nirmal Industrial Controls (applicant) as its application, for the trade mark 'Nirmal' in Class 6, was opposed essentially on the ground of deceptive similarity with the registered trade mark 'Nirma' in the same class.

Further, the IPAB held that none of the documents submitted by Nirma Chemical Works demonstrate any proof of use of the impugned trade mark for any of the goods for which it was registered in the said class and therefore the mark be struck off from the Register in respect of "metal products" classification.

Temporary injunction granted in respect of trade mark 'Writer'

The Bombay High Court has ruled in favour of Mumbai-based logistics firm 'P.N. Writer & Co.' (plaintiff) in the matter of trade mark infringement and passing off against its competitors 'Writer Packers & Movers Pvt Ltd' (defendant).

In the instant case, the plaintiff had submitted that it has a trade mark in the term 'Writer' and provides its services through its divisions, Writer Relocations and Writer Information Management Services. Further, the plaintiff submitted that as the defendant was infringing on its trade mark, it had served a cease and desist notice on the defendant in August 2012. Consequently, the plaintiff did not come across the defendant's services under the said trade mark. As a result, the plaintiff did not sue for infringement of its trade mark. However, the plaintiff started receiving emails from the customers of the defendant's services complaining about their quality which evidenced that the reputation of the plaintiff was being damaged grossly.

The court concluded that there was indeed an obvious deceptive similarity between the said trade mark and the trade names of the plaintiff and the defendant. Since a *prima facie* case of trade mark infringement and passing off was made out, temporary injunction was issued against the defendant restraining it from employing the trade mark 'Writer'.

Gilead's patent request for hepatitis C drug opposed in India

American biotechnology company Gilead Sciences' patent application on hepatitis C drug *sofosbuvir* has been opposed at the Indian Patent Office by New York's Initiative for Medicines, Access & Knowledge (I-MAK).

The pre-grant opposition was filed at the (Kolkata) Patent Office and the ground of opposition is that it is an "old science, known compound". According to Section 3(d) of the (Indian) Patents Act 1970, a fresh bout of patent protection is forbidden for a new form of a known or existing substance. In addition, the said opposition aims to ensure that an affordable generic version of *sofosbuvir* can be produced to help the millions of people in developing countries access the drug.

IPAB orders regarding patents of Kibow Biotech

The Intellectual Property Appellate Board (IPAB) has revoked a patent (no. 205478) of US-based biotech firm Kibow Biotech Inc in India, titled 'Prebiotic and Probiotic Compositions and Methods for their Use in Gut-Based Therapies'. The revocation order came in response to the application filed by domestic company La Renon Health Care (applicant).

Earlier, Kibow Biotech had filed a suit before the Madras High Court alleging infringement of impugned patent in order to curb the competition in the market from the applicant. In response, the applicant moved the IPAB for revocation of impugned patent. Consequently, in its order (no. 261/2013), the IPAB revoked the impugned patent on the basis that the claim is obvious and, therefore cannot be deemed to be an "invention".

In addition, on the same day and in a separate order (no. 262/2013), the IPAB dismissed revocation application filed by La Renon Health Care, against a patent granted to Kibow Biotech for the invention "compositions for augmenting kidney function" (patent no. 224100).

‘Zedex’ v. ‘Zecodex’: IPAB rules in favour of Wockhardt

The Intellectual Property Appellate Board (IPAB) has revoked the trade mark ‘Zecodex’ in the name of Gujarat-based Kamaron Laboratories on an appeal filed by pharmaceutical giant Wockhardt Ltd. on the basis that the mark is deceptively similar to the trade mark ‘Zedex’.

The applicant Wockhardt adopted the trade mark ‘Zedex’ in the course of its business and obtained registration for the same in class 5 (pharmaceutical products) in the year 1983. Besides, the applicant had also been using the trade mark Bro-Zedex since 1988.

The IPAB held that the marks are similar phonetically and are likely to cause confusion and deception to the public. In addition, it was observed that in case of medicinal products, the confusion and deception will not only result in monetary loss but also be a great hazard to one’s life. In such circumstances, the impugned trade mark is hit by Section 11 of the Trade Marks Act, 1999. Therefore, the application for rectification was allowed with a direction to the Registrar to cancel the trade mark ‘Zecodex’ registered in class 5.



Biocon gets regulatory approval for biosimilar Trastuzumab

Biotechnology major Biocon has received market authorisation from the Drug Controller General of India (DCGI) for its biosimilar *Trastuzumab*. The drug, which is being developed jointly by Biocon and the US generic drug maker Mylan Inc., is used for the treatment of breast cancer. The said biosimilar will be marketed in India under the brand name CANMAB and is expected to be available to patients in India by 2014.

Trastuzumab is a medicine originally developed and patented by Swiss pharmaceutical giant Roche Holding AG which sells the drug in world markets, including India, under the brand name 'Herceptin'. DCGI's approval comes three months after Roche relinquished its Indian patent on 'Herceptin'. (Please see our *August-September 2013 Newsletter*)

The approval is an extremely important milestone for Biocon as it is the first biosimilar version of 'Herceptin' to be accorded regulatory approval.

“Saint–Titan” trade mark dispute

The Intellectual Property Appellate Board (IPAB) has remanded, a trade mark dispute between Titan Industries (a leading Indian manufacturer of watches) and Bangalore-based Saint Watches Pvt. Ltd., to the Deputy Registrar of Trade Marks for considering one more ground raised by Saint Watches.

In its appeal before the IPAB, Titan contended that the decision of Deputy Registrar was erroneous as Saint's logo was not invalidated despite the logo consisting of Titan's registered trade mark. In addition, the goods were the same in respect of which the marks were used by the two companies (i.e. watches).

Refusing to enter into the merits of the case, the IPAB held that the Deputy Registrar had erred owing to the non-consideration of the ground that the Notice of Opposition by Titan was barred by limitation (Section 21 of the Trade Marks Act, 1999). Therefore, the matter was remanded.



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