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Case: *RENAISSANCE HOTEL HOLDINGS INC. V B. VIJAYA SAI AND OTHERS*
Authored by: Kiran Kirti Rath

Case Name and citation	<i>Renaissance Hotel Holdings Inc. v B. Vijaya Sai And Others</i> AIR 2022 SC 44:: 2022 (5) SCC 1
Decided by [Court]	Supreme Court of India
Judge/s Name	Hon'ble Justice L. Nageswara Rao, Justice B. R. Gavai, Justice B. V. Nagarathna
Date of Judgement/Order	19 th January 2022
Headnote	The court thoroughly discusses the legislative scheme of the trademark law concerning the requirement 'to prove likelihood of confusion' or 'the presumption of the likelihood of confusion in different hypothetical scenarios including when the trademark is identical and goods/services are similar, when the trademark is similar and goods/service are identical and when the trademark is identical and goods/services are also identical. The judgement also delves into the issue of trans-border reputation and honest industrial practice as a defence. The relevant provisions referred in the case are as follows: S. 29(2)(c), S. 29(3), S. 29(5), S. 29(9), S.30 and S. 30(1) of the Trade Marks Act, 1999
Issues addressed	The issue addressed are as follows: Whether the High Court's ruling, which reversed the Trial Court's judgement and determined there was no trademark infringement by the Respondent of the word 'RENAISSANCE', just? Sub Issues: a. Whether the respondents/defendants and the appellant/plaintiff cater to different classes of customers and whether there was likely to be confusion in the minds of consumers about the hotel of the respondents/defendants belonging to the same group as of the appellant/plaintiff? b. Whether respondent/defendant's usage of the trademark was is in accordance with honest practices in industrial or commercial matters under Section 30 (1) of the Trademark Act?
Brief facts	Since 1981 and since 1990 in India, Renaissance Hotel Holdings (the 'Appellant') has been a well-known hotel brand and one of the biggest hotel chains in the world. In India, the word 'RENAISSANCE' has been registered under Classes 16 and 42. The problem came to light when the appellant discovered that B. Vijaya Sai and Others (the 'Respondents') were operating two hotels in Bangalore and Puttaparthi, noting that they had imitated their design, signage, and use of the phrase 'RENAISSANCE', under the contested name 'SAI RENAISSANCE,' which indicated a relationship both the entities. In 2009, the Appellant requested, in the District Court, Bangalore for a permanent injunction against the utilization of the allegedly infringing trademark 'SAI RENAISSANCE' and any other marks that are confusingly similar to the Appellant' mark, 'RENAISSANCE.' Trial Court: On 21 st June 2012, after reviewing the provided evidence and arguments, the court issued a partial decree prohibiting the respondents from using the trademark 'SAI RENAISSANCE' or any other trademark that encompasses or otherwise bears a resemblance to the trademark 'RENAISSANCE,' as well as from using the same trademark to conduct business like that of the appellant/plaintiff. The court also rejected any claims for damages against the respondents/defendants. High Court: On 12 th April 2019, in response to the respondent's first appeal, Kerala High Court noted that the plaintiff had not established a reputation abroad to support its argument. Whether or not a trademark is used in India, the idea of trans-border recognition enables the protection of an international trademark there. The court additionally declared that the word 'SAI RENAISSANCE' is damaging to its distinctive character because there is a disparity in the quality of the hotels and no evidence to substantiate an unfair competitive advantage.

Arguments	<p>The Appellant argued, among other things, that: Sections 29(1), (2) and (3) of the Trade Marks Act of 1999 (the Act) state that infringement occurs when the respondent's mark and services are the same as or relatively close to the appellant's mark and services, applied to its case. If the competing marks and services are identical, there is a legislative presumption of the probability of confusion under Section 29(3) of the Act; When the High Court denied an injunction, it improperly applied Section 29(4)(c) of the Act. The High Court did not consider Section 29(5) of the Act, which provides for infringement when a respondent uses the infringing mark also as part of its trade name, and the Respondents were using the Impugned Mark as their hotel name. Section 29(4) of the Act is attracted when rival marks are identical or similar but the rival goods or services are not similar; in such a situation, there is a stronger argument for an appellant to establish a reputation in its mark.</p> <p>The respondents responded to the appellant by contending that 'RENAISSANCE' is a generic word from the dictionary and that no preferential rights could be granted to it. They added that the 'SAI RENAISSANCE' hotel, which opened in 2001, has been operating for the past 15 years. They used the title 'SAI RENAISSANCE' and used the dictionary word 'RENAISSANCE' after the name of Sri Shirdi Sai Baba since they are devotees of Sri Shirdi Sai Baba and think that Sri Puttparthi Sai Baba is the reincarnated Sri Shirdi Sai Baba.</p>
The reasoned decision by the court	<p>The court ruled in favour of Renaissance Hotel Holdings and stated that the phrases 'RENAISSANCE' and 'SAI RENAISSANCE' are comparable both visually and phonologically. The bench was comprised of L Nageshwara Rao, BR Gavai, and BV Nagarathna. The Supreme court ruled that the appellate court erred in its judgement and lacked sufficient cause to overrule the trial court's order.</p> <p>The quandary of the trademark is identical but not the products and services offered were also addressed by the court. The High Court did not need to intervene in the dispute to assess the character of the trademark because both trademarks, regarding goods and services, had been registered under Classes 16 and 42, according to the court.</p> <p>The High Court missed out on two interpretational principles, which the Supreme Court emphasized, <i>No component of the provision should be interpreted in isolation, and both the textual interpretation and the contextual interpretation must be balanced.</i> The High Court has solely taken into account clause (c) of subsection (4) of Section 29 of the aforementioned Act, even though the matter is covered by subsections (5) and (9) of that section. The prerequisites for the benefit under Section 30 of the Act were not taken into account by the inferior court. The court did not take into account how important it is to develop fair business practices. To fulfil the repute of a trademark in India, the court extensively interpreted the use of 'and' and 'or' in provisions. The Hon'ble Supreme court came to the assessment that the High Court had mistaken in its application of the requirements under S.29(4) of the Act because it had neglected to consider other provisions that applied to the facts of the case at hand as well as other laws. The Supreme Court overruled the High Court's decision and upheld the Trial Court's well-supported decision. As a result, it is anticipated that consumers will be confused when a defendant's trademark is identical to a plaintiff's registered trademark and their goods or services are the same. A clear breach of section 29 of the Act would exist if the same were done.</p> <p>Further, the court stated that the High Court has failed <i>'to take into consideration that to avail the benefit of Section 30 of the Act, apart from establishing that the use of the impugned trade mark was not such as to take unfair advantage of or is detrimental to the distinctive character or repute of the trade mark, it is also necessary to establish that such a use is in accordance with the honest practices in industrial or commercial matters. As such, we have no hesitation to hold that the High Court was not justified in interfering with the well-reasoned order of the trial court.'</i></p>
Link to the full judgement	<p>https://indiankanoon.org/doc/143185473/</p>

**Case: MOONSHINE TECHNOLOGY PRIVATE LIMITED V TICTOK SKILL GAMES
PRIVATE LIMITED AND ORS.**

Authored by: Saloni Neema

Case Name and citation	<i>Moonshine Technology Private Limited v Tictok Skill Games Private Limited And Ors.</i> MANU/DE/0308/2022
Decided by [Court]	High Court of Delhi
Judge/s Name	Hon'ble Justice Asha Menon
Date of judgement/Order	31 st January 2022
Headnote	The case dwells into Section 29(3) of the Trade Marks Act, 1999 concerning the presumption of confusion to the public and within the trade circle. The dispute revolves around the descriptiveness of the word 'Baazi' for games.
Issues addressed	The issues addressed are as follows: <ul style="list-style-type: none"> a. Whether the defendant had violated the plaintiff's registered trademark 'Baazi' by using the word 'Baazi' as part of the poker game's name as 'WinZo Baazi'? b. Whether defendants used the plaintiff's registered trademark 'Baazi' dishonestly and to take unfair advantage of reputation? c. Whether the word 'Baazi' is descriptive of games?
Brief facts	The plaintiff Baazi Group of Companies claims to be a leading and pioneer in the Indian gaming industry established in the year 2014. Over some time, the Baazi Group has established quality gaming products and provided experiences to its customers under the branding and registered trademarks. The plaintiff claims to have adopted the trademark 'Baazi' originally which were still valid, and had become the trading identity, corporate name and domain names of the 'Baazi Group'. The defendant 'WinZo Baazi' dishonestly started using 'Baazi' in respect of the services that they were providing and thus, passing off their services as those of the plaintiff.
Arguments	<i>Defendants asserted</i> that they had used the word "Baazi" descriptively in "WinZo Baazi" and contended that it is a general word in Urdu that means "game." Defendants further argued that the registered trademark laws should protect a trademark owner if they give a popular word a secondary meaning. Defendants asserted statutory defences in accordance with Sections 30(2)(a) and 35 of the Act with bonafide intention. <i>Plaintiff argued</i> that because the word "Baazi" cannot be connected to a gaming app, it is not a descriptive word. Furthermore, the defendant's dishonest purpose to use "Baazi" for its branding is demonstrated by the defendant's copying of the plaintiff's mark "TeamBaazi" while the case was pending.
The reasoned decision by the court	The court stated that the word 'Baazi' may mean 'betting' in Urdu but by referring to <i>Yorkshire Copperworks Limited v. Registrar of Trademarks</i> , it was observed that the more apt a word to describe the manufacturer's goods the less apt would it be to distinguish them, but that 'Baazi' is not a word apt to describe gaming services. The Hon'ble Court also observed that Defendant had used the exact word that had been trademarked by Plaintiff, and offered identical services. Therefore, the Court held that a prima facie case of infringement had been made out under Section 29(2)(c) read with Section 29(3) of the Trademarks Act, 1999. The Court presumed that confusion would occur amongst the public, and an injunction was required accordingly. The Court also rejected the defences put up under Sections 30 and 35 of the Act, as Defendant had failed to satisfy it that it was using the word 'Baazi' honestly in commercial matters or as a descriptive word.
Link to the full judgement	https://www.livelaw.in/pdf_upload/moonshine-v-tictok--408765.pdf

Case: PHONOGRAPHIC PERFORMANCE LIMITED V UNION OF INDIA & ORS

Authored by: Kiran Kirti Rath

Case Name and citation	<i>Phonographic Performance Limited v Union Of India & Ors.</i> AIR 2022 DEL 580:: (2022) 289 DLT 266
Decided by [Court]	High Court of Delhi
Judge/s Name	Hon'ble Justice Yogesh Khanna
Date of Judgement/Order	9 th March 2022
Headnote	<p>In two writ petitions submitted by Phonographic Performance Limited (PPL), a registered business entity that deals with sound recordings and broadcasting, the Delhi High Court decided on a protracted dispute between copyright societies and the Registrar of Copyrights ("Registrar").</p> <p>The relevant provisions referred in the judgment are as follows: S. 33(3A) & S. 78 of the Copyright Act, 1958 and R. 47 & R. 49 of the Copyright Rules, 2013.</p>
Issues addressed	<p>The issues addressed are as follows:</p> <ol style="list-style-type: none">Did the subordinate court that issued the contested order err by failing to adhere to the principles of natural justice?Is the Petitioner's application to be reregistered maintainable?
Brief facts	<p>The Petitioner, Phonographic Performance Limited, (PPL) was a registered copyright society, possessing or controlling the public performance rights of more than 350 music firms with 3 million worldwide and domestic sound recordings through the assignment of the copyright in a variety of sound recordings for transmission to the public in the areas of public performance and broadcast. By giving authors and artists a stronger negotiating position to commercialize their creative output, PIL defended their interests from expropriation by publishers and probable copyright violators.</p> <p>The Copyright (Amendment) Act of 2012 added Section 11(3A), which required all copyright societies to register for re-registration with the Registrar within a year of the new law's taking effect. The Copyright Rules, 2013 added, additionally, on March 14, 2013, Rule 47, requiring copyright societies seeking to re-register to submit an application in Form IX within two months.</p> <p>Within a year of the Copyright Amendment Act's passage in 2012 and two months of the passage of the Copyright Rules in 2013, the petitioner submitted an application for re-registration on 9th May 2013. As contended by the Petitioner, even with a mandate on the part of the respondent, the respondent was silent on any decision whatsoever by which the petitioner faced losses. Eventually, the petitioner started his business again and filed for withdrawal on 20th May 2014, to file a fresh application.</p> <p>On 20th November 2014, the respondent outrightly rejected their withdrawal request, conveying that their re-registration application was still under consideration and to wait accordingly.</p> <p>After waiting for the subsequent four years, on 11th January 2018, it started functioning again, all whilst keeping the court informed about its initiatives. However, on 24th May 2021, the petitioner received an order which rejected its re-registration application, stating that the application was withdrawn and PPL no longer is a copyright society.</p> <p>Aggrieved from such order, the petitioner requested the issuance of a writ of certiorari, a writ of mandamus, or any other directive to review and set aside the contested order as well as to decide the petitioner's request for re-registration.</p>

Arguments	<p>The petitioner contended that the observations made by the respondent in the impugned order are completely erroneous, incorrect, unreasoned, arbitrary, without application of mind and contrary to the principles of natural justice. It is alleged the respondent has arrived at a conclusion without considering and appreciating the complete facts and law and passed the impugned order, which is liable to be set aside.</p> <p>Arguments by the Respondents:</p> <p>Respondent 1, i.e., Union of India (the UoI), contended that the petitioner's case had no standing as there was no promise from the Central Government's part affirming their re-registration, filed in January 2018, which was already much late as strictly mentioned in the Copyright Rules, 2013. Additionally, the registration of Indian Performing Right Society Limited (IPRS) as a copyright society was valid as even though some directors were common in PPL, it complied with all the recommendations suggested by the Government. Further Respondent 2/The Recorded Music Performance Ltd. (RMPL) argued that the petitioner had withdrawn its application via its conduct as it had started acting as an author by taking and giving out licenses to various artists even though their application was pending. Moreover, the Government was well within its discretion when it did not accept their application for re-registration. Many cases were referred to by the respondent to support their contention.</p>
The reasoned decision by the court	<p>After considering numerous legal precedents and arguments put out by both the Respondents and the Petitioner, the Court ruled that Respondent 1 failed to apply his or her mind when he or she rejected the Petitioner's application without providing him or her a chance to be heard. Respondent 1 rejected the application without making a decision based on the applicant's merits. According to the Court, Respondent 1 should have taken into account the fact that the application for withdrawal was denied, the office memorandum, as well as correspondences showing that Respondent 1 was handling the Petitioner's application and that the Petitioner did not need to contact them regarding it.</p> <p>In addition to that, the court noted that IPRS submitted a withdrawal application alongside the petitioner's and that the Government unceremoniously denied the petitioner's request for re-registration in the impugned judgement, even though an investigation was ongoing against IPRS. No investigation ever existed into the petitioner's society. The Government assured the petitioner that its application for re-registration would not be denied, according to letters it sent to the petitioner.</p> <p>The court opined that it is incorrect to assume that under Rule 49, the principles of natural justice won't apply to the application of re-registration even though there is no separate rule for hearing on applications of re-registrations. But if such an application is rejected to register another society in its place, then the principles will apply to applications for re-registration as well. Despite the respondent's argument that the proviso to Rule 49(1) only applies to applications for registration and not re-registrations, the petitioner was a registered society before the amendment, and its application for re-registration was ongoing. Respondent no.1, being a quasi-judicial authority, was therefore required to give the petitioner a chance to be heard, particularly in the above-mentioned circumstances.</p> <p>Therefore, it was held that Respondent 1 is to re-consider the Petitioner's application as it was filed within the time and the same is to be conveyed to the petitioners. At the same time, the court set aside RMPL's registration as a copyright society at present.</p>
Link to full judgement	<p>https://indiankanoon.org/doc/196307224/</p>

Case: SHOLAY MEDIA ENTERTAINMENT AND ORS. V YOGESH PATEL AND ORS.

Authored by: Saloni Neema

Case Name and citation	<i>Sholay Media Entertainment And Ors. v Yogesh Patel And Ors.</i> Manu/De/1842/2022
Decided by [Court]	High Court of Delhi
Judge/s Name	Hon'ble Justice Prathiba M. Singh
Date of Judgement/Order	9 th May 2022
Headnote	The case presents one of the most interesting issues concerning the film industry relating to the copyright/trademark over the title of the film and whether such titles can enjoy a reputation to restrain others from using the title in the domain name or otherwise. One such title of the film discussed in this case is 'SHOLAY'.
Issues addressed	The issues addressed are as follows: a. Whether the rights in the mark 'SHOLAY' vest in the Plaintiffs? b. Whether the Defendants' conduct constitutes infringement and violation of statutory and common law rights in the mark 'SHOLAY'?
Brief facts	<p>The Plaintiff, Sholay Media and Entertainment (P) Ltd. and Sippy Films (P) Ltd. Filed a suit against defendants 1 to 8. The defendants had registered the domain name 'www.sholay.com', published a magazine using the mark/name Sholay and put on sale various merchandise, using scenes and names from the movie 'SHOLAY'. In addition, defendant 5 – Netangle.com Pvt. Ltd. a company registered by Defendants 1 to 3 as well. Defendants 6, 7, and 8 were controlling entities of the domain name 'Sholay.com'.</p> <p>The Film 'SHOLAY' has been described as a film which is a part of India's heritage and some of the dialogues used in the said film such as '<i>Jo dar gaya, samjho mar gaya</i>', '<i>Ai chhammia</i>', '<i>Arre o Sambha</i>', '<i>Kitne aadmi the?</i>' are part of colloquial language in the Hindi heartland. The mention of the word 'SHOLAY' immediately creates a connection with the movie 'SHOLAY'. Hence, the rights in the word 'SHOLAY' which is a registered trademark, have been recognised by the Courts in favour of the plaintiff.</p>

Arguments	<p>The <i>plaintiffs contended</i> that they have been using the word ‘SHOLAY’ in relation to cinematographic films, vinyl records, audio tapes and DVDs etc. and as a result of long, extensive and continuous use, the trade name ‘SHOLAY’ has acquired tremendous goodwill and reputation and is associated exclusively with the plaintiffs. They have also sought registrations for domain names such as esholay.com, esholay.com, esholay.net, esholay.com, esholay.net, sholayent.com and esholay.com, esholay.net, sholayent.com and sholaytwo.com. The plaintiffs contended that the defendants’ adoption of the mark was not bona fide but with a view to encash upon the reputation and goodwill of the plaintiffs. According to the Plaintiffs, such use constitutes infringement, passing off, dilution and tarnishment of the well-known mark ‘SHOLAY’.</p> <p>The <i>defendants’ justified</i> their use of the trade mark ‘SHOLAY’, primarily on the following grounds: That film titles are not entitled to protection; the defendants have applied for registration of ‘SHOLAY’ as a trade mark and incorporated a company with the name ‘SHOLAY’ before the plaintiffs applied for registration; there is no probability of confusion since ‘SHOLAY’ is a dictionary word, meaning ‘burning coal’ in the Hindi language;</p>
The reasoned decision by the court	<p>As far as the rights of plaintiff over the word ‘SHOLAY’ is concerned, the same has already been recognised in the earlier judicial decision dated 24th August, 2015 in <i>CS(OS) 1892/2006 titled Sholay Media and Entertainment Pvt. Ltd. and Anr. v. Parag Sanghavi and Ors.</i> as follows: <i>‘3. The plaintiffs are the copyright owners and administer all intellectual property in respect of 32 cinematograph films, including the iconic and eternal hit film ‘SHOLAY’.</i></p> <p>As far as the second issue is concerned the court held that <i>‘The manner of use of the word ‘SHOLAY’ by the Defendants, is not descriptive, but is a clear indication of an association with the Plaintiffs’ film.’</i></p> <p>It was further added that the offering of the CD and DVD of the film ‘SHOLAY’ on the website of the defendants show that the defendant’s adoption was, in fact, <i>mala fide</i> and dishonest. Moreover, the defendants had registered a series of domain names identical and deceptively similar to the name of the film ‘SHOLAY’, which cannot be justified. <i>Their use of identical domain names is nothing but an attempt to encash the goodwill enjoyed by the blockbuster movie ‘SHOLAY’ of the Plaintiffs.’</i></p> <p>Hence, the plaintiffs had a cause of action under Section 27 of the Trademarks Act, 1999. That <i>‘the mark ‘Sholay’ enjoys continued goodwill in India.’</i> Bench elaborated stating that, the mark ‘SHOLAY’ has already been recognised as a well-known mark. Thus, the mere earlier trademark applications or use as part of a corporate name would not vest any prior rights in favour of the Defendants. That the use of the mark ‘SHOLAY’ as part of domain names and company names, etc. is completely illegal and unlawful.</p> <p>The Court rejected the claims made by the defendants that the internet is only being used by educated persons and held that the adoption of the mark ‘Sholay’ was clearly with mala fide intention. It is a fit case for an award of cost of ₹25,00,000, to the plaintiff. The Court further directed the defendant to refrain from the use of the mark 'Sholay' on the internet or otherwise.</p>
Link to the full judgement	<p>https://www.livelaw.in/pdf_upload/pms09052022sc82016175556-419443.pdf</p>

From the pens of IPHolics

Case: *BRIGHT LIFECARE PVT LTD V VINI COSMETICS PVT LTD AND ANR*

Authored by: Manya Jain

Case Name and citation	<i>Bright Lifecare Pvt Ltd v Vini Cosmetics Pvt Ltd and Anr</i> CS(COMM) 144/2022 & I.A. 3585/2022
Decided by [Court]	High Court of Delhi
Judge/s Name	Hon'ble Justice Prathiba M. Singh
Date of Judgement/Order	7 th July 2022
Headnote	The case addresses an intriguing question of the protection of advertising campaigns/commercials under the intellectual property rights regime, particularly Copyright Law. In addition, what particularly constitutes infringement in cases of an allegation of copying of such commercials/campaigns?
Issues addressed	The issue addressed are as follows: <ol style="list-style-type: none">Whether an advertising campaign and its various elements be protected under intellectual property law? If so, in what manner?Whether the elements of the plaintiff's campaign constituted merely an idea or whether they constituted the expression of an idea?
Brief facts	<p>The plaintiff manufactures and trades food, nutraceuticals, and dietary supplements. One of its popular items is a protein supplement sold in a series of products under the MuscleBlaze (MB) trademark. In March 2018, 'MuscleBlaze' launched the 'ZIDDI HOON MAIN' advertising campaign. Words like 'ZIDD' and 'ZIDDI' are creatively used to convey the idea of a person who does not give up easily.</p> <p>Defendant No. 1 is a company that manufactures and markets pharmaceuticals, ayurvedic remedies, and cosmetic items under the house mark 'VINI.' Some of its brands are WHITETONE, OSSUM, and FOGG, which have a strong presence in the market.</p> <p>The plaintiff averred that in January 2022, they came across commercials for Defendant No. 1's 'REALMAN' deodorant that was conceptually and visually similar to his advertisements. Plaintiff claimed that the advertising resembled 'MuscleBlaze' conceptually and graphically.</p>
Arguments	<p>Plaintiff filed the complaint for violation of its rights in the trademarks 'ZIDD'/'ZIDDI' as well as copyrights in its cinematograph pictures. It was submitted that the following aspects comprised the 'ZIDDI' campaign:</p> <ol style="list-style-type: none">Various slogans and phrases include the word 'ZIDDI.'The distinctive writing style of the word 'ZIDDI' in black and yellow.To convey persistence and perseverance, the distinguishing aspects employed in the ads, such as the dark gym atmosphere and description of how the workout is done, were utilized. <p>The defendant argued that:</p>

	<ol style="list-style-type: none"> 1. The plaintiff and defendants are not rivals as their products deal in different fields and sectors. 2. The plaintiff cannot establish a monopoly over the word ‘ZIDDI’ as they have been used previously in films and other campaigns like A song in the film 'Mary Kom' that incorporates the term and title 'ZIDDI DIL' and A Parel-G product promo named 'ZIDDI CHORIYA’. 3. The case of <i>R.G. Anand v. Delux Films</i> (AIR 1978 SC 1613) was cited to demonstrate that there is no copyright for an idea and that there cannot be a breach of copyright in a cinematograph unless there exists theft of frames or particular pictures that form part of the film.
<p>The reasoned decision by the court</p>	<p>Regarding the issue that whether an advertising campaign and its various elements be protected under intellectual property law; The Court stated that <i>‘The settled legal position is that there can be no copyright in an idea but only in its expression...However, a mere idea behind the commercial is not protectable. Only the elements of expression incorporated in the commercial are protectable. Parties which manufacture and sell products expend enormous time, effort, energy and investment in creation of advertising campaigns...Thus, these campaigns and commercials are extremely thought out, deliberate and also determine the success/failure of a product. Even a ten second commercial involves enormous creativity and originality. Thus, an advertising campaign including commercials are undoubtedly protectable under intellectual property law.’</i></p> <p>In regard to the similarities between both the commercials, the Court held that:</p> <ol style="list-style-type: none"> a. The entire concept, look and feel of the expression ‘ZIDD’ and ‘ZIDDI’ being used by Plaintiff for its advertising campaign has been copied by Defendant No.1 in its advertisements for deodorants. b. There can be no monopoly over the word ‘ZIDD’ or the idea of using the word ‘ZIDD’, however, the portrayal can be different as there is a well-settled law that idea cannot be protected, only the expression can be protected. c. In the present case, Plaintiff has chosen a unique and creative way of using the ordinarily known words ‘ZIDD’ and ‘ZIDDI’ in a manner to portray how persons who consume Plaintiff’s product can persevere and face the challenges of life. There are distinct elements in the plaintiff’s advertisements that can be protected. d. The Court said that while distinctive elements in advertising campaigns can be protected by the court. The threshold for proving distinctiveness will be very high and it will grant an injunction against rivals only when there is a possibility of deception or confusion. <p>Therefore, Court held that the two impugned commercials which are evocative of and very similar to Plaintiff’s campaign are liable to be restrained in their present form, and defendants are asked to pull down the two impugned commercials from Youtube and other platforms where they are available for viewing by the public.</p>
<p>Link to the full judgement</p>	<p>https://images.assettype.com/barandbench/2022-07/5ca02472-5648-48c7-8dae-7cce51c15acb/Bright_Lifecare_Pvt_Ltd_v_Vini_Cosmetics_Pvt_Ltd_and_Anrr_1.pdf IP PRESS blog link: https://www.theippress.com/2022/07/12/can-advertising-campaigns-be-protected-under-intellectual-property/</p>

Case: NIPPON A & L INC. V THE CONTROLLER OF PATENTS

Authored by: Rohith Sharma GA

Case Name and citation	<i>Nippon A & L Inc. v The Controller of Patents</i> Citation – 2022/DHC/002434
Decided by [Court]	High Court of Delhi
Judge/s Name	Single Bench; Hon’ble Justice Pratibha M. Singh
Date of judgment/Order	5 th July 2022
Headnote	Patents Act, 1970 – Section 2(1)(ja) – <i>inventive step</i> – Section 15 – Section 59 – Scope of – Amendment of the Applications & Specifications – ‘ <i>product</i> ’ to ‘ <i>process</i> ’ patent – Section 57 & 58 of the Act – Scope of ‘Product’ and ‘process’ patent
Issues addressed	The issue addressed are as follows: <ol style="list-style-type: none"> a. What is the nature & scope of the unamended patent application? b. Whether the amendment of the application from ‘<i>product by process/product</i>’ to ‘<i>process</i>’ is permissible under Section 59 of the Act?
Brief facts	The appellant-applicant had filed a patent application No. 2013153727 in Japan for a ‘copolymer latex’ product and processed on 24 th July 2013. Thereafter, patent application No. 201617003704 dt. 2 nd February 2016 was filed vide WIPO PCT/JP2014/069608 as an international application. After due process of objections, amendments and hearing, the Deputy Controller of Patents rejected the patent application and amended claims vide order dt. 15 th March 2021, of the appellant on the grounds that, <ol style="list-style-type: none"> a. The amendment changed the very nature of the patent so claimed from ‘product claims’ to ‘method/process’ claims, hence contravening the provisions of Section 59 of the Patents Act. b. The amended claims lacked inventive step as u/s 2(1)(ja). Hence, the present suit has been filed, challenging the impugned order vide appeal.
Arguments	Appellant’s Arguments <ol style="list-style-type: none"> a. Endorsement of amended claims – The primary contention stressed the permissive amendment of the patent claims from ‘product by process’ to ‘process’ patent and that such amendment was in fact endorsed u/s 59 of the Act. Reference was placed upon the precedence of European Board of Appeals and Art. 123 of the European Patent Convention, 1973. b. Nature of amendment – The appellants asserted that the purpose of the amendment was by way of explanation, making the claims clearer and more definite. This was contented to be permissible in view of the precedent laid down in <i>Antacor Ltd. & Schweiger, Martin v. Controller of Patents</i>. c. The eclipse of clarity – The core argument of the appellants revolved around the fact that the complete specifications were objected due to the lack of clarity as to whether the patent was for product or process. Hence, the amendment addressed the lacuna by limiting the scope of the application to ‘process’ only. Defendant's Arguments

	<p>a. The limited scope of the initial specification – The defendants argued that the complete specification was merely for ‘copolymer latex’ as a product only and not the process involved thereof. Thus, casting it beyond the scope of Section 57 – 59 of the Act.</p> <p>b. Lack of novelty in product – In product-by-process claims, the applicant has the onus to show that the product defined in process terms, is not anticipated or rendered obvious by any prior art product. Thus, the appellants were allegedly barred from converting the product patent to process patent by omitting the proof of novelty of the product and the inventive step of the process itself.</p> <p>c. Limited scope of amendment – The core argument of the defendants focused on the bar on the extent of amendment as it cannot change the very scope of the application by converting its nature from ‘product’ to ‘product by process’ to ‘process’ patent.</p>
<p>The reasoned decision by the court</p>	<p>a. Scope of Unamended claims – The complete specifications were held to be in nature of a ‘product by process’ application as it related to a copolymer latex obtained by emulsion polymerization process. Therefore, the unamended claims were ‘product by process’ claims wherein the invention was defined by a product possessing various characteristics and manufactured using a specific process.</p> <p>b. Contours of Section 59 – Reliance was placed on various legal precedents in concurring that Section 59 of the Act gave scope for the amendments of the claims from ‘product by process’ to ‘process’ patent as long it, <i>Does not mutate the very invention which emerges from the amended application from that of the desired object in the initial specification;</i> <i>Is within the scope of the matter disclosed qua prior.</i> <i>Construction of specifications & amendments –</i> The amendments as under CH X of the act and the claims prior to grant ought to be construed more liberally rather than narrowly to ensure that the very object of the application is not defeated. Reliance, in this regard, was placed on the <i>Ayyangar Committee Report</i>. Pursuant to the above rationale, the Court allowed the present appeal only to the extent that the amended claims as on 24th January, 2021 are to be taken on record. The examination of the amended claims in light of Section 3(d) & (e) of the act were referred to the Deputy Controller of Patents to be disposed of expediently within a period of 6 months.</p>
<p>Link to the full judgement</p>	<p>http://164.100.69.66/jupload/dhc/PMS/judgement/06-07-2022/PMS05072022CAP112022_110420.pdf</p>

Case: **THEOS FOOD PVT. LTD. AND ORS. V THEOBROMA FOODS PVT. LTD.**

Authored by: Kadari Niharika

Case Name and citation	<i>Theos Food Pvt. Ltd. and Ors. v Theobroma Foods Pvt. Ltd.</i> MANU/DE/2747/2022
Decided by [Court]	High Court of Delhi
Judge/s Name	Hon'ble Justice Prathiba M. Singh
Date of judgment/Order	29 th July 2022
Headnote	This Landmark case is all about two booming companies phenomenal at confectionery and their settlement in trademark infringement, passing off action, unfair competition, dilution, blurring and damages claim.
Issues addressed	The issue addressed are as follows: <ol style="list-style-type: none">Is the defendant liable for trademark infringement because it uses the words 'Theos' or 'Theo's' in the prefix of some of its food items?Is the defendant liable for unfair competition against <i>Theos Food Pvt. Ltd</i> (plaintiff)?Whether the defendant's trade practices i.e., to use 'Theo's' or 'Theo's' amounts to trademark dilution?Is defendant liable for passing off action?Whether the service provided by the defendant under the name 'Theos' or 'Theo's' is the same for offline and online orders
Brief facts	Both the parties <i>Theos Food Pvt. Ltd.</i> and <i>Theobroma Foods Pvt. Ltd.</i> , have been two of the top private limited companies imparting exceptional service in bakery-related products like confectionery, patisseries, etc. The <i>Theos Food Pvt. Ltd.</i> (Plaintiff) oversees a chain of bakeries, restaurants, cafes, and lounges in the Delhi-NCR area under the mark 'THEOS' or 'THEO'S' and offers a wide range of products on its menu, including chocolates, cookies, a great collection of desserts and cheesecakes, hot and cold beverages, as well as other milk- and non-milk-based items. Whereas <i>Theobroma Foods Pvt. Ltd.</i> (Defendant) operates primarily from Mumbai, Maharashtra, and has an exclusive and indulgent range of offerings that includes brownies, cakes, desserts, chocolates, bread, and savory foods, and has since expanded to become a pan-India chain. Irrespective of their place of functioning, both parties sued each other for the adoption of the trademarks 'THEOBROMA,' 'THEOS,' and 'THEO'S' because their respective companies offer the same goods and services and share the beginning syllable 'THEO' in their brand names. There are two lawsuits filed: the commercial IP suit in the Bombay High Court, which is still pending, and plaintiff filed the current suit requesting a decree of permanent injunction against trademark infringement, unfair competition, passing-off action, blurring, dilution, rendition of accounts, and delivery and damages against the defendant in the High Court of Delhi.
Arguments	Petitioners claimed to have used the mark consistently and more in respect of product type and service under Class 30 and service of the restaurant under Class 43. The petitioners claimed that the mark 'THEOS' or 'THEO'S' was invented and incorporated by them in the year 2008, and to substantiate their claim, the same trademark registrations and applications were listed. It also claimed that these marks are stated to have gained valuable recognition and goodwill for the brand. Respondent claimed to be the first and authorised user of the trademarks 'THEOBROMA' under class 30 and 'THEOS' under class 43 with respect to similar services and product types since the launch of its first retail shop in Mumbai in 2004 under the trade name

	"THEOBROMA Food of the Gods.' As a substantiation, the respondent presented all its trade mark registrations and applications to the Hon'ble Court.
Reasoned decision by the court	On July 8, 2022, both parties got a window to reach an amicable settlement before deciding on the case's merits in the Hon'ble Delhi High Court. The following are the amicable settlement parties reached: <ul style="list-style-type: none"> a. The defendant is permitted to expand its network of stores using the name or mark 'THEOBROMA' throughout the country. However, as far as its products and services delivered under the mark or name 'THEOS' or 'THEO'S' are concerned, Plaintiff will restrict its activities to the Delhi-NCR region. b. The plaintiff must acknowledge the trademark 'THEOBROMA' and refrain from using it in any way. Whereas the defendant will likewise stop objecting to the plaintiff's use of the trademarks 'THEOS' and 'THEO'S'; c. Plaintiff will stop using the marks 'THEOS' and 'THEO'S' on its online menus, but they may continue to use them on its physical menus.
Link to the full judgement	https://images.assettype.com/barandbench/2022-08/f6f76d0f-a826-4262-b899-e71c120edcde/Theos_vs_Theobroma.pdf



From the pens of IPHolics



Case: DS BIOPHARMA LIMITED V THE CONTROLLER OF PATENTS AND DESIGNS

Authored by: Vivek Basanagoudar

Case Name and citation	<i>DS Biopharma Limited v The Controller of Patents and Designs</i> 2022/DHC/003563
Decided by [Court]	High Court of Delhi
Judge/s Name	Hon'ble Judge Prathiba M. Singh
Date of Judgement/Order	30 th August 2022
Headnote	Delhi High Court rules that objections under Section 3(d) of the Patents Act are not maintainable unless the 'known substance' is first identified by the Patent Office
Issues addressed	Whether, if the Patent Office fails to identify the 'known substance', objections under Section 3(d) of the Patent Act, 1970 can be raised and thereby maintained to refuse a patent application?
Brief facts	<p>The Appellant, DS Biopharma Limited, filed an appeal before the Delhi High Court challenging an order rejecting its patent application for '<i>Compositions comprising 15 oxo epa Or 15 oxo dglc and methods of making and using same</i>'. The application first contained 1-26 claims which was objected by the Patent Office through a First Examination Report (FER) dated March 05, 2020 on the grounds of lack of inventive step and non-patentability under Section 3(i) of the Act.</p> <p>After cancellation of claims 7-26 and amendment with only claims 1-6 filed as a response to the FER, a hearing notice was issued by the Patent Office with an objection under Section 3(d) of the Patents Act. The appellant attended the hearing and through its written submissions, amended the relevant claims but the application was finally refused. Aggrieved by this decision, the appellant challenged the order on the grounds that the Patent Office failed to mention reasons for raising an objection under Section 3(d) of the Patents Act.</p>
Arguments	<p>The Appellant relied on <i>Fresenius Kabi Oncology Limited v. Glaxo Group Limited & Anr</i> and claimed that for an objection to be raised by a Patent Office under Section 3(d) of the Act, the 'known substance' must be identified, reasoning must be provided as to how and why the substance is a 'derivative' or 'new form' of the 'known substance' and valid grounds must be provided to assert that the 'known substance' and the claimed substance have similar efficacy.</p>

The reasoned decision by the court	<p>The Delhi High Court, relying on the <i>Fresenius Kabi case</i>, held that for an objection to be raised under Section 3(d) of the Act, the basic pre-condition would be the identification of the 'known substance'. It also opined that such 'known substance' could not be left to the Applicant for the deduction. Furthermore, even if not in detail, the 'known substance' has to be identified and the method through which the claimed substance constitutes 'new forms' must be specified by the Patent Office briefly.</p> <p>Since the Patent Office failed to identify the relevant 'known substance' in its objection, the Delhi High Court set aside the impugned order.</p>
Link to full judgement	<p>http://164.100.69.66/jupl/oad/dhc/PMS/judgement/12-09-2022/PMS30082022CAP62021_145645.pdf</p>



From the pens of IPHolics

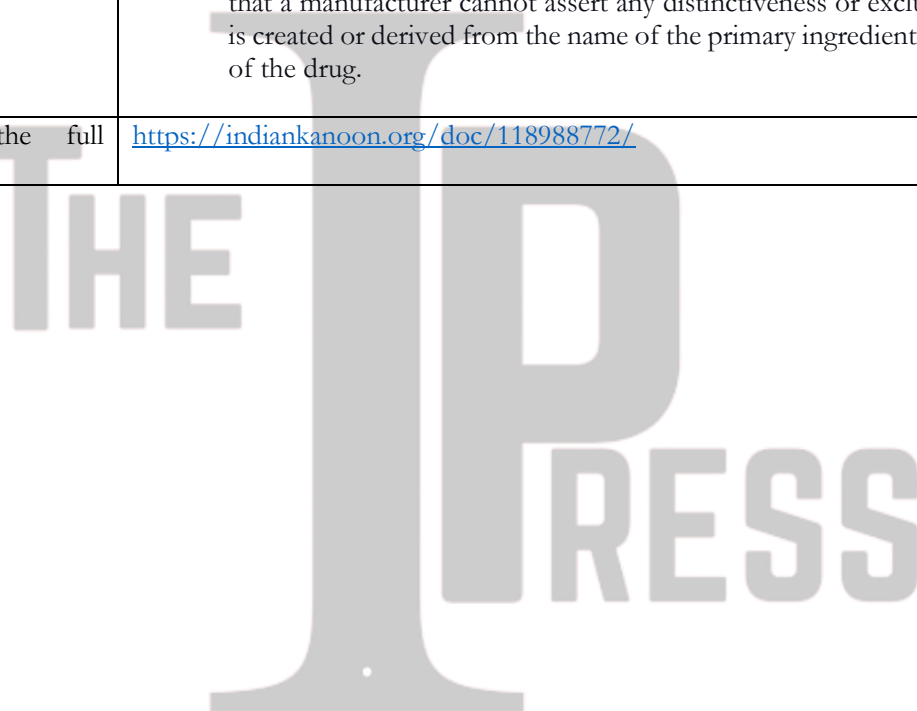


**Case: SUN PHARMACEUTICAL LABORATORIES LTD. V HETERO HEALTHCARE LTD.
& ANR.**

Authored by: Saloni Singh

Case Name and citation	<i>Sun Pharmaceutical Laboratories Ltd. V Hetero Healthcare Ltd. & Anr.</i> FAO (COMM) 96/2022, CM APPL. 29651/2022, CM APPL. 29652/2022 & CM APPL. 29653/2022
Decided by [Court]	High Court of Delhi
Judge/s Name	Hon'ble Justice Vibhu Bakhru & Justice Amit Mahajan
Date of judgement/Order	26 th August 2022
Headnote	This is an important decision on non-exclusivity over trademarks derived from medicine names. The High Court elaborates on Section 13 of the Trademark Act, 1999 and implies that the trademark generated or adopted from the INN does not grant the proprietor exclusive power to monopolize the INN or seek an injunction against others.
Issues addressed	The issues addressed are as follows: <ol style="list-style-type: none"> Whether the mark, 'Letroz', is similar to the trademark 'Letero'? Whether there is an infringement and passing off of 'Letroz' by Hetero HealthCare? Whether Sun Pharma has the legal right to use the name 'Letroz' solely and to forbid Hetero from using the mark?
Brief facts	Under Class 5 of the Trade Marks Act of 1999 (the Act), Sun Pharma has registered the mark 'LETROZ,' which refers to a medication used to treat advanced breast cancer. 'LETROZOLE' is one of its active ingredients. Sun Pharma sued Hetero Healthcare Ltd. ('Hetero') for using the mark 'LETERO' based on trademark infringement and passing off. Sun Pharma's interim plea for an injunction was denied by a single judge, who also ruled that both marks were derived from a generic name. Hence, no case is made out for a grant of injunction. Aggrieved by the order dated April 29, 2022, dismissing the interim injunction application ('Impugned Order'), Sun Pharma filed an appeal before the High Court against the Impugned Order.
Arguments	Sun Pharma's contentions: <ol style="list-style-type: none"> It is one of the biggest pharmaceutical firms in the world that produces generic medications. Since 2001, LETROZ has been a manufactured good. Due to trademark registration, it is legally permitted to use LETROZ exclusively and is thus eligible for an injunction. Since 2017, Hetero has been impersonating Sun Pharma's products utilizing LETERO to capitalize on the goodwill and reputation the company has built. Sun Pharma claimed that generic marks can also be secured through injunctive relief based on the rulings in Automatic Electric Limited v. R.K. Dhawan and Ajanta Pharma Limited v. Sunways (India) Pvt. Ltd. Hetero's submissions: <ol style="list-style-type: none"> Hetero argued that Sun Pharma does not possess exclusive rights to 'LETROZOLE,' an INN of salt, and is, therefore, ineligible to assert a monopoly, as both Hetero and Sun Pharma obtained their trademarks from this substance. Sun Pharma is also aware that Hetero has been using the mark. It has consented to it by Section 33 of the TM Act. The word LETTERS, a registered brand of Hetero, was created by fusing the last four letters of Hetero with the first two letters of the salt LETROZOLE. It combines the final four letters of Hetero in several trademarks. The list of INN published by the Office of the Controller General of Patents, Design and Trade Marks, Ministry of Commerce and Industry, Government of India ('Controller'), on which Hetero relied, demonstrates that LETROZOLE is an INN and cannot be registered. Section 13 of the TM Act provides that no word which is declared by the World Health Organization ('WHO') and notified

	in a prescribed manner by the Registrar of Trademarks as an INN can be registered as a trademark.
The reasoned decision by the court	<p>a. The ruling in Schering Corporation v. Alkem Laboratories Ltd. (“Schering”) was cited by the High Court and relied upon. As they were derived from the medicine TEMOZOLOMIDE, the sole judge in Schering declined to grant an injunction for the marks ‘TEMODAL’ and ‘TEMODOR’ against the defendant’s marks ‘TEMOKEM’ and ‘TEMOGET.’ The High Court ruled that the ratio in Schering is appropriate to the current facts in the case at hand.</p> <p>b. Any name that is confusingly similar to an INN on the WHO list is prohibited from being registered as a trademark under Section 13(b) of the TM Act. Therefore, Sun Pharma cannot be permitted to have a monopoly on INN-LETROZOLE.</p> <p>c. The marks ‘LETROZ’ and ‘LETERO’ are not similar because both have adopted the initial letters of LETROZOLE. Both the marks of Sun Pharma and Hetero are derived from the INN – LETROZOLE, which is descriptive of the active ingredient of the drug – LETROZOLE.</p> <p>d. The High Court also cited the ruling in Panacea Biotec Ltd. v. Recon Ltd. to rule that a manufacturer cannot assert any distinctiveness or exclusivity when a name is created or derived from the name of the primary ingredient used in the creation of the drug.</p>
Link to the full judgement	https://indiankanoon.org/doc/118988772/



From the pens of IPHolics



Case: DR. REDDYS LABORATORIES LIMITED & ANR V THE CONTROLLER OF PATENTS & ORS

Authored by: Vivek Basanagoudar

Case Name and citation	<i>Dr. Reddys Laboratories Limited & Anr v The Controller of Patents & Ors, Thyssenkrupp Rothe Erde Germany GmbH v. The Controller of Patents & Anr and Elta Systems Ltd v. The Controller of Patents</i> 2022/DHC/004746
Decided by [Court]	High Court of Delhi
Judge/s Name	Hon'ble Justice Prathiba M. Singh
Date of Judgement/Order	10 th November 2022
Headnote	Delhi High Court addresses jurisdictional concerns regarding revocation petitions and appeals filed under the Patents Act, post-enactment of the Tribunal Reforms Act 2021.
Issues addressed	Whether, post-enactment of the Tribunal Reforms Act 2021 and abolishment of the Intellectual Property Appellate Board (IPAB), all High Courts possess the requisite jurisdiction to entertain revocation petitions and appeals under the Patents Act 1970?
Brief facts	<p>The aforementioned cases were transferred from the IPAB to the Delhi High Court and issues of maintainability were raised in the following manner –</p> <p>Dr. Reddy's Laboratories Limited case – A patent application was filed in the Delhi office by Boehringer through the Patent Cooperation Treaty (PCT) and was thereafter granted. The plaintiffs filed a revocation petition before the Delhi High Court which was countered by two suits of infringement by Boehringer in the Himachal Pradesh High Court. An objection was raised against the maintainability of the revocation petition filed before the Delhi High Court.</p> <p>Thyssenkrupp case – The plaintiffs filed a revocation petition against IMO Holding GmbH before the Chennai IPAB office. Uncertain about the outcome post the Tribunal Reforms Act, the plaintiffs filed another revocation petition in the Delhi High Court which was responded to by the defendants through a countersuit claiming rejection of the petition on the grounds of lack of jurisdiction.</p> <p>Elta Systems case – Elta Systems filed a PCT national phase application at the Mumbai office. A video conferencing hearing was conducted by the Assistant Controller from Delhi and eventually resulted in the refusal of the patent application by the Delhi office. The plaintiffs appealed the refusal order before the Delhi High Court and the issue at hand is whether the suit would be maintainable before the High Court of Delhi or Bombay.</p>

<p>The reasoned decision by the court</p>	<p>The Delhi Court first reiterated that revocation petitions are original proceedings under the Act whereas appeals are continuations from previous rulings.</p> <p>With regard to Section 64 of the Act dealing with revocation petitions, the Court opined that the static effect of the design registration has to be considered, thereby implying, the High Court under whose territorial jurisdiction the Patent Office granting registration is located. Another consideration would be the dynamic effect (relied on <i>Girdhari Lal Gupta v. K. Gian Chand Jain & Co</i>) as per which in case of cancellation, the person interested whose commercial interest is affected, the location of such commercial interest would deem that relevant High Court worthy of entertaining the subject matter.</p> <p>To summarise, the place of the grant of patent, the place where the infringement suit is filed and the place of ‘commercial interest’ of the person interested which may be affected are all potential jurisdictions for revocation petitions to be filed.</p> <p>With regard to Section 117A of the Act dealing with appeals passed by the Patent Office, the Court held that any challenge to such order passed would be entertained by the High Court in whose jurisdiction such office is located.</p> <p>Dr. Reddy’s Laboratories Limited case – The revocation petition was held to be maintainable since it was filed before the infringement suits and the office of grant was the Delhi patent office, thereby providing the Delhi High Court with the relevant jurisdiction.</p> <p>Thyssenkrupp case – The revocation petition was dismissed as a prior petition was filed before the IPAB Chennai office which was then transferred to the High Court of Madras.</p> <p>Elta Systems case – The appeal was dismissed. The plaintiff was instructed to approach the High Court of Bombay since the application was filed in the Mumbai Patent Office and therefore, the appeal against refusal of such application would also lie before the same jurisdiction.</p>
<p>Link to the full judgement</p>	<p>http://164.100.69.66/jupload/dhc/PMS/judgement/10-11-2022/PMS10112022COP32021_182330.pdf</p>

**Case: NOKIA TECHNOLOGIES OY V GUANGDONG OPPO MOBILE
TELECOMMUNICATIONS CORP LTD & ORS**

Authored by: Kadari Niharika

Case Name and citation	<i>Nokia Technologies Oy v Guangdong Oppo Mobile Telecommunications Corp Ltd & Ors</i> MANU/DE/4891/2022
Decided by [Court]	High Court of Delhi
Judges Name	Hon'ble Justice C. Hari Shankar
Date of judgement/Order	17 th November 2022
Headnote	This Landmark case states what patents can be constituted as SEP & its factors of infringement.
Issues addressed	The issues addressed are as follows: <ul style="list-style-type: none"> a. Whether the asserted suit patent constituted a SEP? b. Whether Oppo's technology infringed the SEP? c. Whether Nokia was prepared to license its SEP for a FRAND royalty rate? d. Whether Oppo refused to accept the license at the stated FRAND price?
Brief facts	Nokia is the holder of several patents, three of which are the subject of the current dispute. These are Indian Patent No. 300066 (IN'066) titled 'Additional Modulation Information Signaling for High-Speed Downlink Packet Access,' Indian Patent No. 269929 (IN '929) titled 'Method Providing Multiplexing for Data Non-Associated Control Channel,' and Indian Patent No. 286352 (IN '352) titled 'System and Method for Providing AMR-WB DTX Synchronization.' In Nokia's opinion these three lawsuit patents are Standard Essential Patents (SEPs), In its current case, Nokia seeks the court to order Oppo to deposit a sum that, in its estimation, would reflect the royalty, at FRAND rates, in exchange for which Oppo may be given a license to utilize the patents at issue. Nokia thus claims to be entitled to this sum.
Arguments	Plaintiff: <ul style="list-style-type: none"> a. Plaintiff claimed that by paying a price at FRAND rates, Oppo had acquired a license from Nokia for the use of Nokia's SEPs and that this license had expired in 2021. b. Also alleged that Defendant is using its SEPs c. The defendant must deposit an amount that would represent royalty at FRAND terms Defendant: <ul style="list-style-type: none"> a. Oppo contends that the measure of damages, to which a patent holder would be entitled against an infringer is, it is well settled, to be computed based on the loss of revenue that the patentee suffers b. The defendant also has contested the maintainability, as well as the merits in this case c. Oppo further submits that in litigations involving SEPs, the plaintiff is required to demonstrate, if it has been able to establish that the patents are indeed SEPs and that the defendant was using the said patents in its devices, that <ul style="list-style-type: none"> (i) the royalty rates at which the license was being offered by the plaintiff were FRAND and (ii) the defendant was unwilling to take a license at such rates. Any examination of whether the rates at which licenses were offered by the plaintiff were FRAND would require the Court to examine third-party licensing agreements.
The reasoned decision by the court	The Delhi High Court rejects Nokia's petition to have Oppo pay royalties to Nokia following Order 39 Rule 10 CPC, The Hon'ble court did not accept that there had been an unambiguous acknowledgement that the relevant patents were SEPs or that the Plaintiff's requested royalty rate was on FRAND grounds and were based on the communications between the parties. The court specifically noted: –

	<p>77. <i>It becomes clear, from a reading of the aforesaid passages from the pronouncement in Unwired Planet that, before arriving at a decision that a defendant, accused of having infringed SEPs owned by the plaintiff, is required to take a license from the plaintiff on payment of royalty at a particular rate, the Court has to satisfy itself, in the first instance, that (i) the asserted suit patent is in fact a SEP, (ii) the technology used by the defendant infringes the SEP, (iii) the royalty rate at which the plaintiff is willing to license its SEP is FRAND, and (iv) the defendant is unwilling to take the license at the said FRAND rate. Unless all these four factors coalesce, the Court cannot call upon a defendant to pay any amount as royalty to the plaintiff for obtaining a license from the plaintiff for exploiting the suit patents.</i></p> <p>78. <i>There is, both jurisprudentially and etymologically, a clear distinction between an admission and an offer. Amounts offered during negotiations unequivocally cannot be treated as admitted unless, in the communications relating to such negotiations unequivocal admission of liability is found to exist.</i></p>
Link to the full judgement	http://164.100.69.66/jupload/dhc/CHS/judgement/22-11-2022/CHS17112022SC3032021_174929.pdf



From the pens of IPHolics



Case: ITC LIMITED V CENTRAL PARK ESTATES PRIVATE LIMITED & ANR

Authored by: Chanda Shashikant

Case Name and citation	<i>ITC Limited v Central Park Estates Private Limited & Anr.</i> 2022/DHC/005190
Decided by [Court]	High Court of Delhi
Judge/s Name	Hon'ble Justice Prathiba M. Singh
Date of judgement/Order	14 th November 2022
Headnote	ITC Limited's 'BUKHARA' is declared a well-known mark under Section 2(zg) and 11(2) of the Trade Marks Act, 1999.
Issues addressed	The issues addressed are as follows: a. Whether usage of the mark 'BALKH BUKHARA' by the defendants, infringed on the rights of the plaintiff's mark 'BUKHARA'? b. Whether the mark 'BUKHARA' has sufficient attestation to be declared as a well-known mark, despite the refusal of the same in US Courts?
Brief facts	<p>The plaintiffs, ITC Limited, have been in the hospitality and restaurant business since 1975 with a large number of active global hotels. The mark 'BUKHARA' was adopted for its ITC Maurya Hotel, New Delhi in the 1970s. Having built its reputation from the ground up, several celebrities and important persons visited the plaintiff's hotels worldwide and hence, their claim for a well-known status.</p> <p>The defendants, Central Park Estates Private Limited, used the 'BALKH BUKHARA' mark for their restaurant in Gurgaon. Furthermore, the marks 'BALKH BUKHARA RESTAURANT' and 'BALKH BUKHARA' logos were registered on a proposed-to-be-used basis.</p> <p>The plaintiff was made aware of such marks as well as similar designs, logos, fonts, interiors, and seating arrangements which led to the matter being taken up before the Delhi High Court.</p> <p><i>From the pens of IPHolics</i></p>

Arguments	<p>With regards to infringement, no arguments were discussed in the judgement as the parties had amicably reached at a settlement. However, documents such as the following were submitted as evidence - Extracts from Eazydiner, Zomato, JustDial, and TripAdvisor websites of the Defendant's use of the mark; Documents about Defendants' trademark registrations; Comparative images of the Plaintiff's and Defendants' impugned marks.</p> <p>ITC Limited relied on Section 2(zg) of the Trade Marks Act, 1999 to claim for well-known status of its 'BUKHARA' mark. It submitted the following for the court's consideration -</p> <ul style="list-style-type: none"> (i) Documents related to the registrations of the mark; (ii) Extracts from their website showing the restaurant BUKHARA as its 'awardwinning culinary brand'; (iii) Extracts from websites showing various renowned chefs such as Mr. Alfred Prasad having worked at the restaurant; (iv) Photographs and news reports of various dignitaries and celebrities, including Mr. Bill Clinton, Mr. Tony Blair, Ms. Theresa May, Mr. Donald Trump, Mr. Arnold Schwarzenegger, and Mr. Roger Federer, at the restaurant; (v) Certificate of Chartered Associate, Om Nath Mehra & Associates, dated 1st November, 2022, showing revenue generated by the restaurant between the Financial Years 1978 to 2023 (Upto September, 2022); (vi) Invoices of the restaurant bearing the mark BUKHARA since 2013-2023; (vii) Documents evidencing awards, media certificates, etc. received by the restaurant; (viii) Various newspaper articles starting from 1983 highlighting the restaurant.
The reasoned decision by the court	<p>The Court, while deliberating about the reliefs regarding the defendant's actions, decreed the suit in the following manner as amicably agreed to by both parties - The Defendants and all others acting for and/or on their behalf shall stand restrained from using the mark 'BALKH BUKHARA' or any other mark which is identical or deceptively similar to the Plaintiff's mark 'BUKHARA' for their restaurant, hotel, or other hospitality related services. Furthermore 'BUKHARA' was to be removed from display boards, restaurants, websites, and any other places before 31st December 2022.</p> <p>After discussing various statutory provisions such as Section 11(2) and 29(4) [Well-known mark protection in the Act], precedents such as <i>Daimler Benz Aktiengesellschaft v. Hybo Hindustan, NR Dongre v. Whirlpool Corporation & Anr</i>, followed by international conventions and reputed scholarly works like the TRIPS Agreement and McCarthy on Trademarks and Unfair Competition, the Delhi High Court, ruling differently from US Courts, declared 'BUKHARA' to be a well-known mark as the same is largely associated with Indian cuisine and has been regarded worldwide as a chain of great reputation.</p> <p style="text-align: center;"><i>From the pens of IPHolics</i></p>
Link to full judgement	<p>http://164.100.69.66/jupload/dhc/PMS/judgement/29-11-2022/PMS14112022COT7632022_125131.pdf</p>

Case: NOVARTIS AG & ANR. V ZYDUS HEALTHCARE LIMITED & ANR.
Authored by: Rohith Sharma GA

Case Name and citation	<i>Novartis Ag & Anr. v Zydus Healthcare Limited & Anr.</i> 2022/DHC/005462
Decided by [Court]	Delhi High Court
Judge/s Name	Hon'ble Justice C. Hari Shankar
Date of judgment/Order	12 th December 2022
Headnote	Rejection of Plaint – <i>Quia timet</i> – Scope of Order VII Rule 11 of the CPC – Cause of Action – Rule 2(e) and Rule 3(A)(ix) & (x) of Delhi High Court Patent Rules, 2021 – Process Patents & Patent Infringement – Interpretation – ‘to the extent possible’
Issues addressed	The issues addressed are as follows: a. When can the provision of <i>Quia timet action</i> be employed? b. What constitutes a ‘cause of action’ for the purpose of OVII R11 of CPC? c. Whether a <i>Quia timet suit</i> can be rejected under OVII R11 of CPC?
Brief facts	The plaintiffs (<i>Novartis Ag & Anr.</i>) hold the patent IN 229051 in respect of a novel NEP Inhibitor drug (drug to treat cardiovascular conditions) which is a combination of drugs Valsartan and Sacubitril. The defendants (<i>Zydus Healthcare Ltd. & Anr</i>) had filed for a trademark (August 2021) under the name ARXN, on proposed to use basis, for pharmaceutical use in preparations of Valsartan and Sacubitril for cardiovascular purpose. The defendants further made two applications viz. IN 2655MUM2015 and IN 201621044625, and alleged to having obtained drug manufacturing license from the Central Drugs Standard Control Organisation (CDSCO). The plaintiff filed an application seeking permanent injunction on the defendants from proposedly manufacturing the said drug as it would infringe the patent and commercial interests of the plaintiffs. In seriatim, the defendants filed the present IA under Order VII Rule 11 of the Code of Civil Procedure, 1908 (CPC) for the rejection of the plaint filed. <i>The instant case is pursuant to the LA 6051/2022 filed by the defendants.</i>

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Arguments	<p>Applicant – Defendants’ Arguments</p> <ol style="list-style-type: none"> a. Illusory Cause of Action – Primary contention is that the quia timet suit by the plaintiffs had been with no express disclosure of a cause of action, through misstatement of material facts, which is merely an attempt to mislead the eyes of law, incidentally challenging the maintainability of the suit; b. Procedural Lacuna – The commercial courts act mandated that the plaintiffs to have filed the alleged patent applications filed by the defendants, under Rule 2(e) and Rule 3(A)(ix) & (x) of the Delhi High Court Patent Rules, 2021 had not been complied with. Hence, the failure of mapping of infringing patent application. <p>Plaintiffs Arguments</p> <ol style="list-style-type: none"> a. Valid Cause of Action – The filing of the trademark and patent applications by the defendants was sufficient cause as the plaintiffs holding the patent had reasonable grounds to challenge the applications based on the factual apprehension of probable infringement and on grounds of imminent threat to the patent holder’s transact. b. Lack of scope under Order VII Rule 11 CPC – The plaintiff-defendants contented that the rejection application under clause (a) of Rule 11 warrants mere examination of the plaint on the ground of <i>cause of action</i> but is restrained from delving into subject beyond its scope. Hence, the applicants are barred by law from averting the scope of Order VII Rule 11 of CPC and reaching beyond what is permissible.
The reasoned decision by the court (Ratio)	<ol style="list-style-type: none"> a. <i>Sufficient Cause of Action</i> – The court adhered to the guidelines of <i>Teva Pharmaceutical Industries v. Natco Pharma Ltd.</i> to determine the prerequisites of a <i>Quia Timet</i> suit and held the present cause of action has sufficient. b. <i>Scope of Order VII Rule 11 of CPC</i> – The rejection application under clauses (a) and (d) has to be decided on the basis of the assertions and allegations in the plaint alone, without referring to the defence of the defendant. Doing so would defeat the fundamental principles of the said provision. c. <i>Interpretation of the DHCP Rules</i> – The court relied upon the rationale in <i>Rani Kusum v. Kanchan Devi</i> in treating the rules of procedure, where sanctions are not prescribed, as directory and not mandatory. <p>In light of the aforementioned rationale, the application for the rejection of the plaint stands dismissed.</p>
Link to the full judgement	<p>http://164.100.69.66/jupload/dhc/CHS/judgement/12-12-2022/CHS12122022SC6812021_170023.pdf</p>

Case: *KHADI & VILLAGE INDUSTRIES COMMISSION V BOARD OF TRUSTEES, MUMBAI KHADI, AND VILLAGE INDUSTRIES ASSOCIATION*

Authored by: Kadari Niharika

Case Name and citation	<i>Khadi & Village Industries Commission v Board of Trustees, Mumbai Khadi, and Village Industries Association</i> MANU/MHOR/56706/2022
Decided by [Court]	High Court of Bombay
Judge/s Name	Hon'ble Justice Manish Pitale
Date of Judgement/Order	14 th December 2022
Headnote	A well-known case of granting relief for infringement and passing-off of registered trademarks and its variants like word mark, device mark, and label mark
Issues addressed	Whether the defendant's trade practices i.e., to use of KHADI and CHAKRA amount to passing off?
Brief facts	The plaintiff, Khadi and Village Industries Commission, a statutory Commission has approached this Court by filing this suit and application against the defendant, Board of Trustees, Mumbai Khadi, and Village Industries Association for interim reliefs in the context of its registered trademark 'KHADI' and its variants i.e., word mark, device mark, and label mark for allegedly violating and passing off its registered trademarks "KHADI" and "Charkha" or any deceptively similar mark to sell any goods under that name or in any other way that would constitute passing off and for the recovery and possession of the premises of the defendant.

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<p>Arguments</p>	<p>Plaintiff contended that:</p> <ol style="list-style-type: none"> a. The plaintiff alleges that by using the impugned marks, the defendant has indulged in infringement and passing-off. b. The registered trademark 'KHADI' of the plaintiff is included in the list of well-known trademarks by the office of the Registrar of Trademarks c. Sub-sections (4) and (5) of Section 29 of the Trademarks Act, 1999, to contend that when a person, not being a registered proprietor, uses a mark as part of their corporate name, it amounts to infringement of the registered trademark. It was submitted that therefore, not only is the defendant prevented from selling any products using the name 'Khadi,' but it can also not use the word in its corporate name <p>Defendant contended that:</p> <ol style="list-style-type: none"> a. It was not selling any products called, labeled, or described as 'KHADI' and on an undertaking that the defendant would not sell any 'KHADI' product without a certificate from the plaintiff b. Claims made on behalf of the plaintiff, based on the elaborate certificates of registration for a trademark, label mark, and device mark, were all no consequence c. The material on record indicated that the defendant was a prior user and hence protected under Section 34 of the Trademarks Act further submitted that the definition of 'khadi' given in Section 2(d) of the Act, concerned only cloth and no other product.
<p>The reasoned decision by the court</p>	<p>There can also be no serious dispute about the fact that the impugned marks, being used by the defendant, contain the word 'KHADI' and depiction of 'Charkha,' which is like the device mark of the plaintiff, depicting the 'Charkha'.</p> <p>On the face of it, the defendant cannot dispute that the prominent, essential, fundamental, and substantial features of the registered trademarks of the plaintiffs are copied in the impugned marks of the defendant. This would ordinarily satisfy the requirement of demonstrating a prima facie case as regards infringement and passing-off.</p> <p>Given the above, the interim application is allowed in terms of prayer clauses (a) and (b), which read as follows:</p> <ol style="list-style-type: none"> 1. Use of Plaintiff's registered trademarks "KHADI" and "Charkha" or any deceptively similar mark to sell any goods under that name or in any other way any other mark which, amounts to an infringement of the Plaintiff's registered trademarks; 2. Manufacturing, selling, offering for sale, advertising, directly or indirectly providing any kind of goods and/or services under the trademark 'KHADI' either as a word or as a part of any of its trademark, trade name, or logos including but not limited to the logo, and/or any mark identical or deceptively like the Plaintiff's KHADI trademarks and Charkha logos in a manner as may amount to passing off the Defendant's goods, services and business as those of the Plaintiff's.
<p>Link to full judgement</p>	<p>https://images.assettype.com/barandbench/2022-12/13f70229-b7c9-43aa-bea9-53abd3233076/Khadi_Village_Industries_Commission_v_Board_of_Trustees_Mumbai_Khadi_and_Village_Industries_Asso.pdf</p>

Case: L'OREAL V REGISTRAR OF TRADEMARKS

Authored by: Manya Jain

Case Name and citation	<i>L'Oreal v Registrar of Trade marks</i> C.A.(COMM.IPD-TM) 119/2021
Decided by [Court]	High Court of Delhi
Judges Name	Hon'ble Justice Sanjeev Narula
Date of judgement/Order	8 th December 2022
Headnote	The court had to address the registrability of L'oreal's mark 'Pillow Proof Blowdry' as to whether it is distinctive in character when assessed overall, in relation to the product i.e. a shampoo.
Issues addressed	Whether the L'oreal's mark 'Pillow Proof Dry' is registrable or not?
Brief facts	Appellant applied for the mark/label viz. "PILLOW PROOF BLOWDRY" in Class 03 to be used in relation to shampoos, gels, powders, etc. The trademark was refused registration stating that it is devoid of any distinctive character by the registry via objection letter dated 17th November 2014. The reply was filed by the appellant asserting that subject mark was distinctive and capable of registration and relied upon international registrations obtained from WIPO for an identical mark to which application was refused by the Registry. Hence, appellant filed the present appeal.
Arguments	<p>Appellant contended that:</p> <ol style="list-style-type: none">The mark has been in use since 2013 in relation to goods falling in Class 03 – continuously, openly and without any interruption or interference and the goods under the subject mark are identified as exclusively originating from Appellant's source.Identical mark is duly registered in U.S.A. under registration number – '4530867' and in Canada under registration number – 'TMA891524'.Subject mark has already become distinctive and is associated with Appellant, its business and goods/services on account of its long, continuous, extensive and exclusive use thereof, which is sufficient to overcome the objection of descriptiveness. <p>Respondent contended that the subject mark is descriptive and was rightly refused.</p>
The reasoned decision by the court	<p>The impugned orders do not disclose any reasons for the refusal of registration, except for mere reference to Section 9/11 of the Trademark Act, 1999 (the Act). Three popular English words with dictionary definitions make up the subject mark. When combined, they do not, however, provide a clear indicator of the product to which they are applied or intended to be applied. The subject mark being a random combination of three words could not have been refused under Section 9 of the Act.</p> <p>Further, impugned orders do not specify any ground for rejection under Section 11 of the Act and no earlier trade mark deceptively similar or identical to the subject mark has been cited in the Examination Report.</p>

	<p>Therefore, <i>‘Trademark registry is directed to proceed with the registration of the application for subject mark and order dated 16th August, 2019 and refusal order dated 26th June, 2018 are set aside. The rights in subject mark shall be restricted to combination of all the three words “PILLOW PROOF BLOWDRY” used together’.</i> The court clarified and asked for a disclaimer in the trademarks journal that the subject mark shall not be granted with any exclusive rights in the words, “Pillow”, “Proof” or “Blowdry”, separately or individually.</p>
Link to the full judgement	<p>https://indiankanoon.org/doc/71385464/</p>



From the pens of IPHolics



LIST OF GI TAGS OF 2022
Compiled by: Chanda Shashikant

1. ALIBAG WHITE ONION

State: *Maharashtra; Sr. No: 424 & App. No. 685*

This Maharashtrian variety, known for its sweet tinge and immunity-boosting element was granted registration in 2022. This white onion owes its unique sweet taste, shape and colour to the climatic and geographical characterises of Alibaug soil.



2. ATTAPPADY AATTUKOMBU DOLICHOS BEAN

State: *Kerala; Sr. No: 425 & App. No. 686*

[Attappady Aattukombu Avara] The Attappady region of Palakkad is also known for an anthocyanin rich bean that is beneficial for cardiovascular diseases and diabetes treatments. It is also conducive to organic cultivation owing to its aversion to pests and insects



3. ATTAPPADY THUVARA (Attappady red gram)

State: *Kerala; Sr. No: 426 & App. No. 687*

Seeds known to be rich in proteins, carbohydrates, fibre and minerals such as calcium and magnesium, the Attappady Thuvara are characterised by their larger size in comparison to other red gram and white coat.



4. MITHILA MAKHANA

State: *Bihar; Sr. No: 427 & App. No. 696*

Mithila Makhana is a special type of aquatic plant fox nut which cultivated in Mithila, Bihar, knowing for its versatile and healthy use as a snack, ingredient in sweets and salads.



5. TANDUR REDGRAM

State: *Telangana, Sr. No. 428 & App. No. 706*

A native form of pigeon pea grown in the rainy region of Tandur. It contains 22-24% protein and is great in taste, cooking quality and enhanced storage quality, all of which are attributable to the fertile black soil and huge deposits of Attapulgitic clay mineral of the Tandur region.



6. LADAKH RAKTSEY KARPO APRICOT

State: *Ladakh, Sr No. 429 & App. No. 729*

Raktsey Karpo, a type of apricot unique to the region of Ladakh, can be distinguished by its distinct sweetness, colour and white Kernel. A white seed coat of this apricot has not been reported elsewhere and is largely known for its significantly higher sorbitol.



7. ONATTUKARA SESAME (ONATTUKARA ELLU)

State: *Kerala, Sr No. 430 & App. No. 736*

Onattukars Sesame is a traditional crop of Kerala known for its health benefits. Its antioxidant-rich nature aids in fighting free radicals that destroy body cells. Furthermore, it contains large amounts of unsaturated fat which is beneficial for heart patients.



8. KODUNGALLUR SNAP MELON (KODUNGALLUR POTTUVELLARI)

State: *Kerala, Sr No. 432 & App. No. 752*

Originating from Kerala, it is commonly referred to as "Snap melon" and is used as the primary ingredient in a juice commonly consumed for refreshment in summers.



9. KANTHALLOOR VATTAVADA GARLIC (KANTHALLOOR VATTAVADA VELUTHULLI)

State: *Kerala, Sr. No. 431 & App. No. 749*

A type of garlic grown in select areas in Kerala, known for its outstanding flavour and pungency, it is also known for its health benefits, such as effectiveness against bacterial infections and in controlling blood sugar.

