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For further information  
please contact us at:

15 Essex Road  
Paramus, NJ 07652 - U.S.A.  
Phone: 201 368 1222  
Fax: 201 368 0763  
e-mail: [ungriusa@ungriusa.com](mailto:ungriusa@ungriusa.com)

For further information  
please contact us at:

Avda. Ramón y Cajal, 78  
28043 Madrid- SPAIN  
Phone: (34) 91 413 6062  
Fax: (34) 91 413 6417  
e-mail: [ungria@ungria.es](mailto:ungria@ungria.es)

[www.ungria.es](http://www.ungria.es)

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# SELECTED INDIAN INTELLECTUAL PROPERTY CASES

Contributed by D.P. Ahuja & Co., Research Division  
Trademark Cases 2014 - 2015

## High Court and Supreme Court Decisions: 2014-2015

### 1. High Courts can now determine the validity of a trademark registration at the interim stage

*Lupin Ltd v Johnson & Johnson*  
23 December 2014, Bombay High Court

**Trademarks:** NUCYNTA v LUCYNTA; trademark infringement

**Background:** The present case involves a reference by the Single Judge to the full bench in deciding whether a court can go into the validity of a trademark registration at the interlocutory stage. There is a conflict among various decisions of the high courts which resulted in the reference. This decision of the Bombay High Court involves two trademark infringement suits.

**Facts:** The first suit had been filed by Lupin Ltd., an Indian pharmaceutical company against Johnson & Johnson, a US based pharmaceutical company, regarding the trademark LUCYNTA in relation to medicinal products. In or around June 2010, Lupin had adopted the mark LUCYNTA and filed an application for registration of the same on 20<sup>th</sup> August 2010, which was registered on 9<sup>th</sup> March 2012. In July 2012, Lupin received notice that Johnson & Johnson had filed a trademark passing off suit before the Delhi High Court. In the said suit, Johnson & Johnson had claimed prior rights in the mark NUCYNTA, which it had been using since 2008 in the international market, and alleged that the trademark was being passed off by Lupin through use and registration of the mark LUCYNTA. Johnson & Johnson's Indian application for registration of NUCYNTA was filed on 2<sup>nd</sup> September 2011, i.e., subsequent to Lupin's application for LUCYNTA. Lupin, in turn, filed the present suit for trademark infringement against Johnson & Johnson.

The second matter is an appeal (No.674 of 2012) before the Bombay High Court. Parle Products Ltd.,

had filed a trademark infringement suit (No.1171 of 2012) to enforce its rights in the GLUCO mark in respect of food and beverages against Shakti Bhog Foods Ltd. Shakti Bhog claimed that the trademark GLUCO was descriptive and no one could have monopoly over the same. Shakti Bhog also contended that in another suit filed by Parle Products before the Madras High Court, the High Court had examined the objection regarding validity of registration and refused to grant interim injunction to Parle Products. However, Parle Products was granted interim injunction by the Bombay High Court; consequently, Shakti Bhog filed the present appeal.

**Contentions:** Lupin Ltd., contended that the plea of invalidity of registration cannot be considered at the interlocutory stage as it will defeat the purpose of obtaining registration under the Trademarks Act, and in fact such defence has not been envisioned under the Act. Lupin claimed that registration grants a proprietor an absolute right in respect of the mark, and there is a presumption of validity of the registration, which obviates the necessity of proving proprietorship of the mark in every case. Also, the Intellectual Property Appellate Board (IPAB) has the exclusive jurisdiction for determination of validity of registration if and only if, a rectification petition has been filed, and a court does not have any jurisdiction to do so. Finally, Lupin argued that if such argument is accepted, then there will be no difference between a suit for trademark infringement and that for passing off.

On the other hand, Johnson & Johnson argued that the real question for determination is whether the obvious invalidity/unregistrability or fraudulent nature of the registered trademark ought to be a relevant factor when courts are deciding applications for interim injunction. Johnson & Johnson argued that there is no bar in the Act for a Defendant to raise such plea of invalidity or the Court from considering such issue at the interlocutory stage, and in fact, the language and

scheme of the Act, obliges the court to do so. It was argued that registration is a very strong evidence of validity and the burden of proof of showing that the trademark is invalid is extremely heavy and for this reason it has become a practice to grant injunction in face of infringement of a registered mark. However, this does not prevent a Defendant from challenging the validity of the registration at the interlocutory stage.

**Held:** After examining various provisions of the Act, High Court opined that the Act permits courts to consider the plea of invalidity of registration at the interlocutory stage. But the issue remains whether such consideration is to merely ensure that Defendant's plea is not frivolous or thoroughly hopeless or whether court can also consider if Defendant's plea is so strong that court should refuse injunction on the ground that the registration was obtained illegally or fraudulently. High Court ruled that in cases where the registration of trade mark is *ex facie* illegal, fraudulent or shocks the conscience of the Court, the Court is not powerless to refuse to grant an injunction, but for establishing these grounds, a very high threshold of *prima facie* proof is required. It is, therefore, open to the Court to go into the question of validity of registration of Plaintiff's trade mark for this limited purpose, to arrive at a *prima facie* finding.

## 2. Glaxo successfully prevents infringement of its BETNOVATE trademarks

*Glaxo Group Ltd and Anr v Indkus Drugs and Pharma Pvt Ltd*  
4 December 2014, Delhi High Court

**Trademarks:** BETNOVATE v BETO-VATE-N, BETO-VATE-GM, and BETO-VATE-C; trademark infringement

**Parties and Background:** Plaintiff No. 1 is a UK based pharmaceutical company, while Plaintiff No. 2 is its Indian subsidiary. Plaintiff No. 1 manufactures and markets various pharmaceuticals and medicinal products, which are sold in India through Plaintiff No. 2. Defendant is a private limited company engaged in the pharmaceutical business. Defendant manufactures and markets medicinal/

pharmaceutical preparations. Plaintiffs had instituted the present suit for permanent injunction *inter alia* seeking to restrain Defendants from infringing its registered trademark BETNOVATE.

**Contentions:** Plaintiffs adopted the mark BETNOVATE in 1963. Plaintiff No.1 is the registered proprietor of the mark BETNOVATE in India vide registration no.219258 in Class 5 dated 05.12.1963. Plaintiff's submitted that in March 2010, they became aware about the sale of skin care products under the trademark BETOVATE in a packaging that was virtually identical to the one used by the Plaintiffs in respect of their BETNOVATE products. On making further inquiries, it transpired that Defendants were manufacturing and marketing skin cream products under three variants, viz. BETO-VATE-N, BETO-VATE-GM, and BETO-VATE-C, all of which had clearly been copied from the Plaintiffs' trademark.

In the suit, Defendant did not appear before the court and the matter proceeded *ex-parte*. An *ex-parte* interim injunction order was issued on 7<sup>th</sup> March 2011. The matter was now before the High Court for confirmation of the *ex-parte* injunction order granted earlier.

**Held:** On examination of the evidence on record and after hearing the unchallenged testimony of the Plaintiffs, High Court was convinced that Defendant had not only adopted and used a deceptively similar trademark in respect of nearly identical products falling in the same class of the International Classification list, but that Defendant had also copied the product packaging used by Plaintiffs in relation to their products bearing the BETNOVATE mark. As such, High Court held that Plaintiffs are entitled to a permanent injunction in their favour and against Defendant. Given that Defendant chose to absent itself from the proceedings, High Court considered it to be a fit matter to award punitive damages and accordingly, directed that Plaintiffs are entitled to punitive damages to the tune of ₹ 1 lac (US\$ 1613) and also to the costs of the suit.

### 3. World Wrestling Entertainment enforces its WWE mark in India

*World Wrestling Entertainment, Inc. vs M/s Reshma Collection & Ors*  
15 October 2014, Delhi High Court

**Trademarks:** WWE v WWE; trademark counterfeiting and passing off.

**Parties and Background:** Appellant/Plaintiff is a US company engaged in the development, production and marketing of television programming, pay-per-view programming, live events and the licensing and sale of branded consumer products featuring its well known World Wrestling Entertainment (WWE) brand. The WWE scratch logo and “World Wrestling Entertainment” are registered trademarks of Appellant/Plaintiff worldwide including India. According to Plaintiff, Defendants are engaged in the business of manufacture and sale of various forms of garments and apparel, such as T-shirts, wrist bands, caps and other counterfeit goods and garments bearing the reproductions of the Plaintiff’s talents. Plaintiff had filed a suit for infringement of trademarks, copyrights and passing off etc., before the Delhi High Court. However, the Single Judge returned the complaint on the ground that Delhi High Court does not have territorial jurisdiction to entertain the suit. The present case is an appeal filed by Appellant/Plaintiff assailing the order of the Single Judge.

**Contentions:** Plaintiff admits that all Defendants reside in Mumbai and do not conduct any business within the territorial jurisdiction of Delhi High Court. However, Plaintiff conducts its business within the territorial jurisdiction of this court. Plaintiff’s claims that its programs are broadcast within Delhi and a host of merchandise including books etc are also available within the territorial limits of Delhi High Court. Based on the above, Plaintiff contends that Delhi High Court has the jurisdiction to entertain the present suit under the provisions of the Trade Marks Act, 1999. Plaintiff contends that the judicial interpretation applied by the Single Judge is flawed in as much as he did not take into account the new media of web-based business models where transactions are conducted over the Internet.

**Held:** The Division bench observed that Plaintiff makes an “invitation to offer” its products and services to consumers in Delhi, by placing them

on its website. When a customer based in Delhi, views the advertised products and makes a purchase request, it becomes an offer and when the transaction is complete and payment is received by Plaintiff, Plaintiff accepts such offer by a customer based in Delhi. Division Bench was of the opinion that since the offers are made by Delhi-based customers, and such offers are subject to confirmation/ acceptance of Plaintiff through its website, and the money would emanate or be paid from Delhi, it can be considered that to a certain extent Plaintiff is carrying on business within Delhi. Division bench ruled that Delhi High Court would have jurisdiction to entertain the suit and the Single Judge should not have returned the plaint.

### 4. High Court restrains Indian party from using VIRGIN as a trade-name

*Virgin Enterprises Ltd. & Anr. vs Virgin Paradise Airlines Training Pvt Ltd*  
25 November 2014, Delhi High Court

**Trademarks:** VIRGIN v VIRGIN; trademark and trade-name infringement and passing off.

**Parties and Background:** Plaintiff No. 1 is a UK based company, established in 1970 and member of the Virgin Group. Plaintiff No. 2 is a licensee of the Plaintiff No. 1. Plaintiff No. 1 is the proprietor of the trademark VIRGIN which was adopted in 1970, and Plaintiff No. 1 has several trademark registrations for the said mark in India. The present suit has been filed by Plaintiffs to prevent the violation of their trademark rights in VIRGIN by Defendant.

**Contentions:** Plaintiffs contend that they came across the Defendant company in May 2009 and despite several requests to Defendant to delete the expression “Virgin” from its corporate name, Defendant has not complied with such requests. Defendant did not appear before the Court and an ex-parte injunction order was issued against Defendant. The High Court then made a final adjudication of the dispute.

**Held:** High Court observed that despite issuance of the ex-parte injunction order, Defendant had not deleted the expression “Virgin” from its corporate name. High Court ruled that Defendant ought to be

restrained from use of Plaintiffs' trademark VIRGIN and accordingly issued a permanent injunction order restraining Defendant from doing so. Since Defendant chose not to appear before the High Court, High Court also directed Defendant to pay a sum of ₹ 1 lac (US\$ 1613) as punitive damages to Plaintiff.

### 5. Counterfeiting of SANDISK marked products prevented by Delhi High Court

*Sandisk Corporation vs. M/s. Shivji Electronics & Ors.*  
16 December 2014, Delhi High Court

**Trademarks:** SANDISK v SANDISK; trademark counterfeiting.

**Parties and Background:** Plaintiff is the world's largest dedicated provider of flash memory storage solutions under the house mark 'SanDisk'. Plaintiff designs, develops and manufactures data storage solutions in a range of form factors using the flash memory, controller and firmware technologies. Plaintiff holds two trademark registrations in India, one for its house-mark SANDISK and the other for SANDISK Logo. Defendants are wholesalers of electronic equipment, including flash drives and memory cards. Defendant No. 2 and Defendant No. 3 are partners who are running the business of Defendant No. 1. Plaintiff has filed the present suit seeking permanent injunction restraining Defendants from infringing the trademark "SanDisk" and passing off.

**Contentions:** In July 2012, Plaintiff came across counterfeit SANDISK products being marketed by Defendants. Plaintiff contended that Defendants' cards were cheap counterfeits made out of mere plastic and cut out in MicroSD card shape, bearing similar markings as on the Plaintiff's genuine products, including the Plaintiff's trademark SanDisk. Defendants' cards did not have any electronic components, and even the packaging of the cards was of extremely low quality and the print on the packaging was deceptively similar to the Plaintiff's original packaging bearing the Plaintiff's trade dress, layout and trademark SANDISK. An ex-parte interim injunction was issued. On receipt of the interim injunction order, Defendant appeared

before the High Court at first, however but thereafter stopped appearing, and consequently, the matter was proceeded ex-parte.

**Held:** In view of the substantial evidence of counterfeit products that were being sold by Defendants, High Court issued an injunction order restraining Defendants from dealing in products bearing Plaintiff's mark SANDISK. In addition, High Court awarded a sum of ₹ 5 lacs (US\$ 8065) as punitive damages to be payable by Defendants to Plaintiff.

### 6. Micromax fails to sustain injunction against Shenzhen Oneplus

*Micromax Informatics Ltd. vs. Shenzhen OnePlus Technology*  
16 December 2014 and 24 December 2014, Delhi High Court

**Trademarks:** CyanogenMod – trademark licensing dispute

**Parties and Background:** Plaintiff/Micromax is engaged in the business of manufacture, sale and marketing of consumer electronics, including smart-phones. Defendant No. 1/OnePlus is a Chinese entity, while the Defendant No. 2 and Defendant No. 3 (hereinafter Cyanogen) are US companies, who are engaged in the business of developing software for mobile devices and specialize in the modification of the Android operating system.

Micromax and Cyanogen entered into an agreement (which was to take effect from 26<sup>th</sup> September, 2014) whereby Micromax was granted a license for the purpose of integrating and distributing Core OS, Ambient Services and Applications as a critical part of the devices in India. Micromax intended to launch its smart-phones on 20<sup>th</sup> December 2014.

In August 2014, Micromax came to know that OnePlus was intending to enter the Indian market using Cyanogen's operating system software for which Micromax had exclusive rights. Micromax immediately requested Cyanogen to take preventive measures and Cyanogen promised to do so. However, OnePlus launched its smart-phones in India using the trademark CyanogenMod.



Aggrieved by OnePlus' actions, Micromax filed suit seeking permanent injunction and restraining OnePlus from using the trademark CyanogenMod and the relevant technology.

**Contentions:** OnePlus submitted that it had been granted a non-exclusive license to use Cyanogen's trademarks and software (OS labelled CM 11S) in the entire world except for Mainland China. Pursuant to such agreement, OnePlus launched its products in 16 countries and was set to launch its products in India on 2<sup>nd</sup> December. Prior to the India launch, OnePlus was informed by Cyanogen that the arrangement between them was terminated and it could not use the trademark CyanogenMod in India, since Cyanogen had an exclusive licensing deal with Micromax. OnePlus contended that it had made substantial investment towards the launch of its products and the sudden termination of its arrangement with Cyanogen was illegal and will cause irreparable injury to it.

Anticipating that Micromax or Cyanogen may initiate legal proceedings against it, OnePlus also filed a suit against Micromax wherein it sought an injunction restraining Micromax from instituting any suit against OnePlus.

Micromax claimed that the trademark licence agreement between OnePlus and Cyanogen, was of limited nature and subject to third party rights and such agreement was not applicable in India. According to Micromax, OnePlus was aware of the licence agreement between Micromax and Cyanogen, but still chose to launch its offending devices in India on 2<sup>nd</sup> December 2014 under the trademark 'CyanogenMod', to which Micromax had the exclusive rights as per the agreement with Cyanogen. Micromax claimed to have incurred major expenses for creation of a brand exclusivity for providing to Indian customers mobile phones with Cyanogen operating systems and Micromax would suffer irreparable harm and loss if the OnePlus is permitted to continue with their illegal acts in violation of the Agreement between Micromax and Cyanogen.

**Held:** The Single Judge examined the rival contentions and the documents on record and observed that OnePlus had a non-exclusive right flowing out of its agreement with Cyanogen. However, OnePlus could not enforce its rights in

India. On the other hand, the Single Judge noted Micromax had an exclusive right to the impugned trademark and the related technology in India. In such event, the Single Judge ruled that if interim orders are not issued, Micromax will suffer irreparable loss and injury. Accordingly, the Single Judge disposed off the injunction application finally, by restraining OnePlus from using the trademark and related technology in dispute.

Aggrieved by the decision of the Single Judge, OnePlus filed an appeal before the Division Bench. Division bench noted that the Single Judge had disposed off the application for interim injunction, without giving any opportunity to either OnePlus or Cyanogen to submit their response to either the plaint or the injunction application. Division Bench was of the opinion that a proper analysis of the rights granted by Cyanogen each to OnePlus and Micromax needs to be done and this is only possible after the completion of pleadings. With regard to the grant of interim injunction, Division Bench ruled that in the present case, Micromax had not been successful in making out a strong prima facie case. In view of the great parity between prices of the devices being sold by the rival parties, the balance of convenience is not in favour of grant of injunction. Accordingly, Division Bench set aside the order of the Single Judge and remanded the application, which was to be heard afresh.

## 7. High Court prevents infringement of the trademarks DEERE and Leaping Deer logo

*Deere & Co. & Anr. vs. S. Harcharan Singh & Anr. 5 December 2014, Delhi High Court*

**Trademarks:** DEERE and Leaping Deer Logo v SURINDERA and Leaping Deer logo; trademark infringement

**Parties and background:** Plaintiff No. 1 is one of the largest and leading agricultural and construction equipment manufacturer in the world including India primarily having four business segments namely agricultural equipment, commercial and consumer equipment, construction and forestry and finance. Plaintiff No. 1 is the proprietor of the JOHN DEERE mark and a Logo comprising the device of leaping deer in an unique green and yellow colour scheme.

In India, Plaintiffs have been using their trademarks since 1943. In October 2014, Plaintiffs became aware that Defendants are manufacturing and selling lookalikes of the Plaintiffs' farm equipment under their trading name/mark "SURINDERA" with a 'leaping deer logo' in green and yellow colour scheme. Accordingly, Plaintiffs filed a suit for permanent injunction to restrain Defendants from infringing Plaintiffs' trademarks, causing dilution of their trade marks, passing off their trade dress and unfair competition.

**Contentions:** Plaintiffs alleged that Defendants adoption of the leaping deer logo, and the green and yellow colour scheme and deceptively similar trade dress, is malafide and is bound to cause confusion in the minds of the consumers namely that the Defendants' agricultural vehicles are emanating from the Plaintiffs and thereby enabling the Defendants to pass off their agricultural equipments as those of Plaintiffs.

**Held:** High Court noted that under the Act, colour/colour combination can be considered as trademarks if these are distinctive and exclusively associated with any trader. If such colour/colour combination is registered, exclusive rights are granted under the Act to the proprietor to initiate infringement proceedings. If infringement is established, such proprietor can obtain injunction. High Court held that Plaintiffs have established a strong prima facie case, and issued the injunction against the Defendants.

## 8. Yahoo Tours restrained from infringing the well-known mark YAHOO

*Yahoo Inc. vs. Manoj Tulsani & Ors*  
4 December 2014, Delhi High Court

**Trademarks:** YAHOO v Yahoo Tours – Trade-name and trademark infringement.

**Parties and Background:** Plaintiff is a leading global Internet brand and communications, commerce and media company that connects people to their passions, their communities and world's knowledge by offering a comprehensive network of searching, directory, information, communication, shopping, electronic commerce and other online services to millions of users daily.

Plaintiff is the registered proprietor of the well-known trademark YAHOO.

Defendant No. 1 and Defendant No. 2 are operating a business of tours and travels under the infringing trade name "Yahoo Tours LLC", who also operate and carry on business through the infringing website www.yahootourism.com. Defendant No. 1 is the proprietor of Defendant No. 2. Plaintiff filed the present suit for the purpose of seeking permanent injunction restraining infringement of its registered trademark "Yahoo", passing off, dilution and tarnishment by the Defendants.

**Contentions:** Despite being notified of the suit, Defendants did not appear before the High Court. Accordingly, the matter proceeded ex-parte. Plaintiff stated that its trademark "Yahoo" has been used as a prominent part of the Defendants' trading name and such use amounts to infringement and passing off of the Yahoo trademarks. Plaintiff contended that Defendants have not offered any explanation for their adoption and Yahoo being a well-known trademark, Defendants cannot claim to be unaware of Plaintiff's rights in the said mark. Plaintiff argued that Defendants' use of Plaintiff's registered trademark additionally as a domain name aggravates the nature of violation in view of vast presence of the Plaintiff over the Internet.

**Held:** High Court was of the opinion that Plaintiff had successfully established a prima facie case and ruled that Plaintiff is entitled to a decree of permanent injunction.

## 9. COZOLE found to be deceptively similar to COSOME

*Merck KgaA & Anr. vs. Emil Pharmaceutical Inds. Pvt. Ltd.*  
28 November 2014, Delhi High Court

**Trademarks:** COSOME v COZOLE; Trademark infringement

**Parties and Background:** Plaintiff No. 1 is an old and reputed pharmaceutical company, engaged in the manufacture and marketing of a wide range of pharmaceutical and medicinal preparations. Plaintiff No. 2 is the Indian subsidiary of Plaintiff No. 1, who is the registered proprietor of the trademark

“COZOME” under registration No.147029 dated 20<sup>th</sup> January, 1951 in respect of pharmaceutical preparations. Defendant is also engaged in the manufacture and sale of pharmaceutical and medicinal preparations. In October, 2003, Plaintiffs came to know that Defendant had adopted a trademark “COZOLE” by virtue of publication of the trademark application filed by Defendant in the Trade Marks Journal. Plaintiffs have filed an opposition to such application and additionally, filed the present suit seeking permanent injunction restraining Defendant from causing infringement of trademark COSOME.

**Contentions:** No one appeared before the High Court on behalf of Defendant and accordingly, it was proceeded ex-parte. An interim injunction order was initially issued by the High Court restraining Defendant from using the impugned mark COZOLE. Plaintiffs contended that by use of the deceptively and confusingly similar trademark “COZOLE”, Defendant intends to deceive the trade and public into believing that those preparations emanate from Plaintiffs. Plaintiffs also argued that use of trademark “COZOLE” by Defendant amounts to an infringement of registration No.147029 (COSOME).

**Held:** High Court found that Defendant’s mark in respect of medical preparations “COZOLE” is phonetically and visibly similar to the registered trademark “COSOME”. High Court concluded that that Defendant’s mark is bound to create confusion in the mind of the public at large. Accordingly, High Court issued a decree of permanent injunction against Defendant restraining it from using the trademark COZOLE.

## 10. High Court stops Indian party from misusing the CITI mark

*Citigroup Inc. & Anr. vs. Citicorp Business & Finance Pvt. Ltd. & Anr*  
24 November 2014, Delhi High Court

**Trademarks:** CITI/CITICORP v CITICORP; Trade-name and trademark infringement

**Parties and Background:** Plaintiff No. 1 is a US based company, engaged in banking and financial services. Plaintiff No. 2 is the Indian subsidiary

of the Plaintiff No. 1. Plaintiffs’ services are provided under their world-renowned marks CITI, CITI & Arc Device, CITIBANK, CITIGROUP and a number of other well-known CITI family marks such as CITIBANKING, CITICARD, CITIDIRECT, CITIPHONE, CITIGOLD, CITISERVICE, etc. The trademark/trade name CITICORP was adopted in 1972 and has been used for more than four decades.

In January 2013, Plaintiffs came across Defendants’ website [www.citicorpbiz.com](http://www.citicorpbiz.com) and found that Defendants were not only using the registered trademark CITICORP as a domain name, but also as a part of their corporate name. On further investigation, it was revealed that Defendants were using the mark CITICORP in relation to taxation and financial services including services such as processing loans, equity markets, real estate financing, formation of private limited companies, direct & indirect taxation, company law, financial portfolio management, tax consulting, financial structure consulting, audit and other services related to accounting and taxation. Aggrieved, Plaintiffs filed the present suit for injunction and damages for infringement of registered trade mark, passing off and unfair trade competition against the Defendants in respect trademarks CITI and CITICORP.

An ex-parte interim injunction order was granted against Defendants. On receipt of the interim order, Defendants appeared before the High Court and submitted their response to the plaint as well as the application for interim injunction.

**Contentions:** Plaintiffs submitted that Defendants have been allegedly using the CITICORP mark for the past 15 years, but such use appears to have been on a limited scale restricted to the city of Kolkata only. According to Plaintiffs, it appears from Defendants’ website that Defendants have now decided to extend the scale of their activities throughout India, and for this reason registered the impugned domain name in May 2012. Plaintiffs contended that Defendants’ adoption and unauthorised use of the CITICORP mark amounts to infringement of their registered mark, passing off and unfair competition.

Defendants contended that the Delhi High Court does not have jurisdiction to entertain the suit as

Defendants' business operations are in Kolkata. Defendants further submitted that they were offering services relating to financial consultancy since 1994 and the present suit suffers from inordinate delay and has been filed only to harass the Defendants.

**Held:** Delhi High Court after examining the rival contentions held that the court has jurisdiction to entertain the suit as Plaintiffs' website is accessible in Delhi and therefore, Plaintiffs could be said to be carrying on their business within the territorial limits of the High Court. On the issue of delay, High Court observed that no material had been placed on record by Defendants in support of their claim of use of the CITICORP mark since 1994 and in any case, delay is not fatal in a suit for trademark infringement. High Court was of the opinion that Plaintiffs had made out a strong prima facie case of infringement and passing off of their trademarks and confirmed the interim injunction order granted earlier. In view of the fact that Defendants have been using the impugned mark for the past several years, High Court granted them six months to change their trademark/trade name.

### 11. Novartis succeeds against Cipla in trademark infringement case

*Novartis AG v Cipla Ltd.*  
17 November 2014, Delhi High Court

**Trademarks:** UNIBREZ v ONBREZ; trademark infringement

**Parties and Background:** Plaintiff, a Swiss pharmaceutical company filed the present suit against Defendant, an Indian pharmaceutical company. In the suit, Plaintiff sought to restrain Defendant from using the trademark UNIBREZ, which Plaintiff claims to be deceptively similar to its own trademark ONBREZ.

**Contentions:** Defendant submitted that it has decided to give up the UNIBREZ mark and proposed to adopt the trademark INDALFO instead. Plaintiff submitted that it had no objection to the settlement offer, provided it did not preclude Plaintiff from continuing its patent infringement proceedings against Defendant for the pharmaceutical product.

**Held:** In view of the settlement arrived at between the parties, Court issued the decree of permanent injunction as prayed by Plaintiff, restraining Defendant from using the UNIBREZ trademark or any other mark that may be deceptively similar to Plaintiff's registered mark ONBREZ.

### 12. Dow prevents counterfeiting of its products in India

*Dow International Technology Corporation & Ors. vs. Elixir Trading Pvt. Ltd*  
14 November 2014, Delhi High Court

**Trademarks:** DOW v DOWFLOW/DEWFLOW; Trademark infringement and counterfeiting

**Parties and Background:** Plaintiffs are the subsidiaries of Dow Chemical Company and part of the Dow Group. Plaintiff No. 1 is engaged in research and providing services such as licensing of IP rights. Plaintiff is the proprietor of the trademark DOW and its variants in India, including the mark DOW FILMTEC. Defendant is engaged in the business of manufacturing, marketing and trading of apparatus, components and machines for water purification and water supply including RO water components, membranes, etc. Plaintiff has filed the present suit

**Contentions:** Plaintiff contended that Defendant indulged in counterfeiting, by procuring original DOW FILMTEC membranes of 50 GPD configuration from the market and selling them as 75 GPD membranes. Further, Defendant obtain RO membranes from elsewhere and sold such inferior products by affixing fake DOW and DOW FILMTEC stickers, which carried Plaintiff's DOW and DOW FILMTEC marks along with the Dow diamond logo on RO membrane. According to Plaintiffs, Defendant is trying to pass off its inferior quality goods as and for those of Plaintiffs', and causing confusion and deception in the market. In addition, Plaintiffs alleged that Defendant sold booster pumps under the mark DOWFLOW which is deceptively similar to Plaintiffs' DOW mark and mislead consumers into believing that the said products are being manufactured by Plaintiffs or are associated with Plaintiffs in some manner.

Delhi High Court granted an ex-parte injunction

order restraining Defendant from selling its products under the DOW and/or DOW FILMTEC and/or DOWFLOW marks. In addition, High Court also appointed a local commissioner for search and seizure of the offending products. Accordingly, the local commissioner visited Defendant's premises and seized its products. Subsequently, the interim injunction order was made absolute till disposal of suit.

Defendant requested High Court for release of the seized goods and sought its permission for disposal of such goods under the trademark DEWFLOW. Plaintiffs objected to such request claiming that DEWFLOW was still similar to its DOW trademarks.

**Held:** High Court was of the opinion that the trademarks DEW/DEWFLOW was deceptively similar to DOW/DOWFLOW marks and in view of the interim injunction order already in place, Defendant's adoption of the trademark DEW was malafide. Accordingly, High Court refused Defendant's request to dispose off the seized goods.

### 13. High Court stops infringement of SIEMENS as trade-name

*Siemens Aktiengesellschaft & Anr. vs. Siemens Solutions*  
10 November 2014, Delhi High Court

**Trademarks:** SIEMENS v Siemens Solutions; trade-name and trademark infringement

**Parties and Background:** Plaintiff No. 1 is a German entity, dealing in wide range of products and services in relation to automation, building technology, consumer products, industry solutions, energy, financial solutions, healthcare, motors, drives and mobility, etc. Plaintiff No. 1 adopted the SIEMENS mark in 1847 and is the registered proprietor of the said mark in India. Plaintiff No. 2 is the Indian subsidiary and is involved in the promotion and development of SIEMENS trademark in India. Plaintiffs had filed the present suit for permanent injunction restraining Defendant from infringing the well known trademark SIEMENS and misuse of the trademark SIEMENS as a trading name.

**Contentions:** Plaintiffs claimed that Defendant is infringing their well-known trademark SIEMENS by using it as a trademark and trade name, in relation to services control automation solutions, refineries, distilleries, sugar plants, steel plants, cement plants, paper industries, textiles industries, water treatment & waste water treatment plants, dairy plants etc. automobiles, material handling, packaging, printing, airport baggage handling, monitoring solutions for power generation, power plants distribution and energy monitoring, substations, boilers, air, gas, water & electricity etc., which is tarnishing the reputation and goodwill associated with Plaintiffs' trademark and causing irreparable monetary losses.

Defendant did not appear before the High Court and was proceeded ex-parte. High Court issued an ex-parte injunction order on 11<sup>th</sup> October 2013, which was made absolute till disposal of the suit on 17<sup>th</sup> July 2014.

**Held:** High Court observed that Defendant is guilty of infringement of trademark and passing off its business and services as that of Plaintiffs. High Court also noted that Defendant has no justification to adopt and use the trademark, which amounted to infringement of legal rights of Plaintiffs. Accordingly, High Court ruled in favour of Plaintiffs, and issued a permanent injunction restraining Defendant from using the SIEMENS mark in any manner. Since Defendant did not appear before the High Court, High Court also awarded punitive damages of ₹ 3 Lacs (US\$ 4839) and ₹ 30,000 (US\$ 484) as costs towards counsel fees, to be paid by Defendant to Plaintiffs.

### 14. RBS prevails over Sharekhan in the MAXTRAD trademark dispute

*The Royal Bank Of Scotland Group PLC vs. Sharekhan Limited*  
7 November 2014, Delhi High Court

**Trademarks:** MAXTRAD v MAXTRADE; trademark infringement

**Parties and Background:** Plaintiff is a British part-nationalized banking and insurance company and offers a wide range of services such as

transaction banking, risk management, investment banking, private banking and asset management etc. Plaintiff claimed to be the proprietor of the trademark MAXTRAD which was first used in 1999 internationally and in India in 2004.

Defendant is engaged in the business of providing services in respect of financial consultancy, brokerage, stocks and bonds, capital investment, financial evaluation and management, securities and security consultancy. Defendant offers its services under the mark "MAXTRADE".

In November 2012, Plaintiff became aware of a trademark application for MAXTRADE filed by Defendant which was advertised in the Trade Marks Journal. Accordingly, Plaintiff filed the present suit seeking permanent injunction to restrain Defendant from passing off and engage in unfair competition, through use of the trademark MAXTRADE. An ex-parte injunction order was issued and upon receipt of such order, Defendant appeared before High Court. Defendant also filed an application for setting aside the ex-parte interim injunction order. Since Defendant had not complied with the directions set out in the ex-parte interim injunction order, Plaintiff filed an application for contempt of court.

**Contentions:** Plaintiff contended that Defendant's mark 'MAXTRADE' is visually and phonetically virtually identical to its mark 'MAXTRAD'. Plaintiff submitted that since Defendant was in the same trade as Plaintiff, it had adopted the mark MAXTRADE in order to benefit from Plaintiff's existing use and substantial reputation for the mark MAXTRAD.

Defendant claimed that the suit suffered from delay of over 6 months. Defendant also submitted that Plaintiff's trademark is not distinctive and is incapable of distinguishing its products from others. Defendant further claimed that the purpose and utility of the product marketed as MAX TRADE of the Defendant is completely different from the product of the Plaintiff under the mark MAXTRAD. The fields in which the products are being used are altogether different and there is a huge price difference in the said products. Therefore, there cannot be any confusion amongst Plaintiff's customers if and when they come across Defendant's product MAX TRADE.

**Held:** High Court was of the opinion that the issue of delay is not relevant in the present case. Moreover, since Defendant itself had applied for registration of an identical mark in relation to cognate and allied services, it is estopped from claiming that Plaintiff's mark is not distinctive. Accordingly, High Court made the earlier issued interim injunction order absolute till final disposal of the suit and dismissed Defendant's application for vacation of the interim injunction order. With regard to Plaintiff application for initiating contempt proceedings against Defendant, High Court issued a strict warning to Defendant and dismissed such application with permission to Plaintiff to file a fresh application if the situation so warrants.

### 15. High Court rules against Life Technologies in trademark dispute

*Life Technologies Corporation & Anr. vs Atz Lab Solutions India*  
29 January 2014, Delhi High Court

**Trademarks:** LIFE TECHNOLOGIES v Life Technologies; trademark infringement and passing off.

**Parties and background:** Plaintiff No. 1 is a global biotechnology tool company. Plaintiffs are dealing in goods and services primarily falling in classes 1, 5, 9, 16, 35, 37 and 42. Defendants are involved in the business of distributing and supplying third party (also competitors of the Plaintiffs) products in the fields of Discovery Biology, Immunology, Molecular & Environmental Biology, Stem Cells, Human Cytogenetics, Embryo Transfer, Tissue Culture and Plant Biology, some or all of which are similar/identical to the Plaintiffs' goods. Plaintiff No. 1 is the proprietor of the trademarks LIFE TECHNOLOGIES, LIFETECH, INVITROGEN, GIBCO and GIBCO BRL.

Plaintiff No. 1's predecessors had established an Indian subsidiary which is the Defendant No. 1 by its erstwhile name Gibco Brl (India) Pvt. Ltd. As its subsidiary Defendant No. 1 had a general licence to use Plaintiff No. 1's trademarks. Defendant No. 2 joined Defendant No. 1 as its Senior Manager. Defendant No. 1 (as the subsidiary of Plaintiff No. 1) registered several domain names comprising Plaintiff No. 1's marks GIBCO, GIBCO BRL and

INVITROGEN. Thereafter, Plaintiff No. 1 wished to have a distributor company in India, and towards this end, Defendant No. 3 company was established, with Defendant No. 2 as its promoter and the corporate name of Defendant No. 3 featured Plaintiff No. 1's mark LIFE TECHNOLOGIES. Defendant No. 3 was granted a limited license to use Plaintiffs' trademarks. In December 2002, Plaintiff No. 1 sold its shares in the Defendant No. 1 to Defendant No. 3 and Defendant No. 1 ceased to be a subsidiary of Plaintiff No. 1. With Defendant No. 1 no longer a subsidiary of Plaintiff No. 1, the general license which it had to use Plaintiffs' trademarks came to an end; however, being a subsidiary of Defendant No. 3 (who in turn was Plaintiff No. 1's licensee) it continued to use Plaintiff No. 1's trademarks.

In June 2005, Plaintiff No. 1 terminated the license agreement with the Defendant No. 3 and consequently, rights of both Defendant No. 3 and Defendant No. 1 to use Plaintiff's trademarks stood terminated. Plaintiffs assumed that the Defendant companies were defunct after the relationship ceased to exist.

However, in 2008, Plaintiffs found that Defendants are continuing their business operations in the same goods and had continued their use of Plaintiff No. 1's trademarks. Despite a legal notice, Defendants refused to cease use of Plaintiff's trademarks.

Hence, Plaintiffs had filed the present suit alleging infringement of their trademarks and seeking an injunction from the Delhi High Court to restrain Defendants from using their trademarks.

**Contentions:** Plaintiffs argued that Defendants' use of the suit trademarks lacked bonafide intent and was abuse of their position as a former employee and former distributor of Plaintiff No. 1. Plaintiffs are aggrieved by Defendants' continued use of the said marks, even after cessation of all business relationships between the parties. According to Plaintiffs, Defendants are not using the trademarks in relation to any products, but as a part of their corporate name, domain names and trading style, to attract consumers by creating confusion and deception.

Defendants admitted that there existed a former business relationship with Plaintiffs. However, Defendants submitted that creation of Defendant

No. 3 was an independent decision by Defendant No. 2 and there was never any permission granted by Plaintiff No. 1. Defendants also submitted that Defendant No. 1 did not have any licence to use Plaintiffs trademarks. Defendants claimed that Plaintiffs had ceased to use the LIFE TECHNOLOGIES marks, and rights to the trademarks in suit were acquired by Defendants through independent adoption and use. Defendants further alleged that it is Plaintiffs who are trying to infringe upon Defendants trademarks.

**Held:** The Single Judge was of the opinion that there was nothing on the record to show that the Defendant No. 3 was created with the permission of Plaintiff No. 1 or that the Defendant No. 1 had any sort of license to use Plaintiffs' trademarks. The Single Judge found Plaintiffs' claim that - when Defendant No. 1 was sold to Defendant No. 3, Plaintiffs did not transfer the domain names comprising Plaintiffs' trademarks to Defendant No. 3 - to be implausible, since Defendant No. 1 did not have any other assets which could be transferred pursuant to such sale. The Single Judge noted that Plaintiffs had not objected to Defendants' continued use of the suit trademarks in relation to their business for a considerable time. The Single Judge held that there was considerable delay in initiating the suit which disentitles Plaintiffs from claiming any interim relief.

Aggrieved by denial of injunction, Plaintiffs have filed an appeal before the division bench of Delhi High Court. The appeal is currently pending before Delhi High Court.

## 16. High Court rules FORLIFE similar to 4LIFE

*4Life Trademarks Llc & Anr. vs Aanchal Jain & Ors. 15 October 2014, Delhi High Court*

**Trademarks:** 4Life v FORLIFE; Trademark infringement and passing off.

**Parties and Background:** Plaintiff No. 1 is a US based company while Plaintiff No. 2 is its group company and Plaintiff No. 1 carries on its Indian operations through Plaintiff No. 2. Plaintiffs are world-renowned innovators, manufacturers and distributors of inter alia products related

to immune system support, like vitamins and nutritional and dietary supplements and certain related products and promotes and markets these products under the trade marks 4LIFE, 4LIFE TRANSFER FACTOR, 4LIFE TRANSFER FACTORPLUS, TRI-FACTOR, 4LIFE GLUTAMIN PRIME, 4LIFE TRANSFER FACTORCARDIO, 4LIFE TRANSFER FACTORBELLE VIE, 4LIFE TRANSFER FACTOR VISTA, RIOVIDA, RIOVIDA BURST & GLUCOACH. In India, Plaintiff No. 1 is the registered proprietor of the marks 4LIFE, 4 LIFE TRANSFER FACTOR & TRI- FACTOR.

Defendant No. 1 is the proprietor of the Defendant No. 2 entity, and Defendant No. 3 was allegedly the co-owner of Defendant No. 2. In January 2014, Plaintiffs found that Defendants were misusing Plaintiffs' 4LIFE brand by using a near identical mark FORLIFE mark and many/all of its variants like, FORLIFE TRANSFER FACTOR, FORLIFE TRANSFER FACTOR PLUS, FORLIFE GLUCOSAMINE, FORLIFE CARDIO CAPSULES, FORLIFE GLUCOACH, FORLIFE TRANSFER FACTOR VISTA, FORLIFE TRANSFER FACTOR BELLE VIE, FORLIFE TRANSFER FACTOR CLASSIC, FORLIFE TRANSFER FACTOR RIOVIDA BURST, FORLIFE TRI FACTOR POWDER, & FORLIFE TRANSFER FACTOR BELLE VIE DROPS in relation to identical products. Defendants were also using trade dress/packaging which were virtually identical to the trade dress/packaging of the products sold by Plaintiffs under their well known 4LIFE trademarks.

Aggrieved, Plaintiffs filed the present suit for trademark infringement and passing off against Defendants.

**Contentions:** Plaintiffs submit that Defendants have not only slavishly imitated Plaintiffs' registered trademarks, but had also used almost identical trade dress/product packagings and also identical words/phrases from the product descriptions used by Plaintiffs. Plaintiffs claimed that such blatant imitation constitutes violation of its rights and will create confusion and deception among consumers.

**Held:** High Court was of the opinion that Plaintiffs had been able to make out a strong prima facie case for the grant of an ex-parte ad-interim injunction in their favour. Balance of convenience also lies in favour of Plaintiffs and against Defendants.

Accordingly, High Court issued an ex parte interim injunction order against Defendants till the next hearing.

### 17. Christian Louboutin stops Indian entity from selling counterfeit LOUBOUTIN shoes

*Christian Louboutin SAS vs. Nakul Bajaj & Ors*  
26 September 2014, Delhi High Court

**Trademarks:** LOUBOUTIN v Louboutin; trademark counterfeiting

**Parties and Background:** Plaintiff is a French company, which derived its name from Mr. Christian Louboutin a famous designer, and is known for its high end luxury products. Plaintiff is especially well-known for its shoes for women with its distinctive "Red soles" and has also branched out into handbags and shoes for men. Plaintiff is the registered proprietor of the trademark CHRISTIAN LOUBOUTIN in India.

Defendant No. 1 and Defendant No. 2 are the owners/proprietors of Defendant No. 3, an entity involved in the business of offering products of luxury brands, including the products of Plaintiff for sale through its website www.darveys.com. In August, 2014, Plaintiff came to know about Defendants, through one of its customers in India who had received an invitation for an event, Bridal Asia, 2014 being organized in New Delhi, where Defendants exhibited/previewed various luxury brands including Plaintiff's brand.

Aggrieved, Plaintiff had filed the present suit for trademark infringement and passing off against Defendants to restrain them from using its trademarks in an unauthorized manner.

**Contentions:** Plaintiff argued that Defendants are engaged in the business of selling counterfeit products bearing its well-known trademark CHRISTIAN LOUBOUTIN. Even if Defendants are selling grey market goods, Plaintiffs submitted that normal rules of grey market products are not applicable in the online retail market as the trademark proprietor is in no position to verify the authenticity or exercise quality control in relation to the said products. Plaintiff submitted that



Defendants are misleading consumers to believe that there exists some sort of formal arrangement between the parties while in reality no such relationship exists.

**Held:** High Court was of the opinion that Plaintiff had been able to make out a strong prima facie case for grant of ex-parte ad-interim order. According to High Court, in case interim injunction is not granted, Plaintiff will suffer irreparable loss and injury. Since the balance of convenience lies in favour of Plaintiff and against Defendants, High Court issued an order restraining Defendants from dealing in any goods under Plaintiff's registered trademarks either through their website or in any other manner.

### 18. High Court extends definition of 'use of trademark' in relation to trademark dispute

*Allergan Inc. & Anr. vs. Intas Pharmaceuticals*  
21 September 2014, Delhi High Court

**Trademarks:** BTX-A v BTXA; trademark infringement

**Parties and Background:** Appellant is a multinational pharmaceutical company, and is the proprietor of the registered trademarks for BOTOX and BTX-A in India. The mark "BOTOX" has been used in India continuously since 1992. Plaintiff had filed an application to register the trademark "BTX-A" in June 2002. Defendant is also a pharmaceutical company and is based in India.

In May 2002, Defendant secured permission from Drug Controller to import articles and products under the brand name "BTXA" into India. Despite a cease and desist notice from Plaintiff, Defendant launched its products under the BTXA mark in India on July 2003. Aggrieved, Plaintiff filed a suit for trademark infringement and passing off suit. In the suit, Plaintiff was successful in obtaining an ex parte interim injunction order against Defendant. Thereafter, Defendant filed an application for vacation of the ex parte interim injunction order, claiming that BTXA did not violate the mark BOTOX and it had adopted the BTXA mark earlier than Plaintiff. The Single Judge allowed Defendant's application and vacated the ex-parte interim

injunction. Plaintiff then filed a review petition and then an appeal against Single Judge's order vacating the interim injunction. Division bench partly allowed the appeal with respect to use of the BOTOX mark and permitted Plaintiff to withdraw rest of the appeal, with leave to pursue the review petition.

In the meantime, Plaintiff's application for BTXA was granted registration and Plaintiff filed an amended plaint and a fresh application for interim injunction. In the light of the changed circumstances, Plaintiff's review petition was disposed off stating that there will be a fresh hearing for grant of interim relief. However, the Single Judge dismissed Plaintiff's suit by holding that there was no use of the trademarks BTX-A by Plaintiff.

Aggrieved by the order of the Single Judge, Plaintiff filed the present appeal before the Division Bench of Delhi High Court. Plaintiff requested Division Bench to set aside the order of the Single Judge, and restore the suit and application for interim injunction. In addition, Plaintiff requested Division bench to restrain Defendant from using any mark similar to its registered marks BOTOX and BTX-A.

**Contentions:** Plaintiff urged that the Single Judge erred in observing that sales is a sine qua non to establish a case of passing off, which is established on use. According to Plaintiff, the term "use" is not restricted to sale of goods, but also extends to advertisement and publicity of the mark. It was argued by Plaintiff that BOTOX and BTX-A are used to refer to its products in medical journals, publications etc; and owing to such extensive usage, both the marks are associated with Plaintiff and none else.

Defendant alleged that Plaintiff had admitted that its BTX-A mark had not been used in India. Defendant pointed out that Plaintiff had not argued 'trans border reputation' in its plaint and it cannot be allowed to adduce evidence on such ground. Defendant argued that grant of registration does not ipso facto establish reputation and in order to establish a prima facie case for grant of equitable relief, Plaintiff had to establish that such reputation existed in India.

**Held:** Division Bench observed that although Plaintiff had not specifically pleaded 'trans

border reputation', its pleadings indicate that the claim of injunction was on the basis of trans border reputation. Furthermore, Division Bench noted that whether such trans border reputation actually exists can only be decided after the trial is complete. In any event, High Court stated that Plaintiff's arguments were not restricted to trans border reputation, but also its intention to enter the Indian market. Division bench further opined that the effect of the Single Judge's order was a declaration of non-use of a registered mark by the Court, which authority has been exclusively granted to the Registrar of Trademark and Intellectual Property Appellate Board (IPAB) under the Act. Division bench held that a decree of dismissal of suit in view of an admission is justified only in cases where the admission puts to rest the legal and factual contentions that arise in the suit, relating to its subject matter.

Holding thus, Division Bench restored the suit and the application for interim injunction. However, with regard to Plaintiff's request regarding injunction against Defendant, Division Bench said that this was not a judgement on merits of the case and hence, in order to obtain the injunction, Plaintiff has to establish its claims during the trial.

### 19. ROLEX held to be a 'well-known' trademark in India

*Rolex SA vs. Alex Jewellery Pvt. Ltd. & Ors.*  
21 September 2014, Delhi High Court

**Trademarks:** ROLEX v Rolex; trademark infringement

**Parties and Background:** Plaintiff is a distinguished and well-known manufacturer and distributor of premium quality watches, horological and chronometric instruments, atomic clocks, chronographs, watch bands, watch cases, watch chains, watch glasses and related products including products containing precious metals and stones and jewels. Plaintiff is the proprietor of the trademark ROLEX which was adopted in 1908. Plaintiff's Indian trademark registrations for ROLEX date back to 1949.

Defendant No. 1 carries on business of manufacturing and selling artificial jewellery under

the mark ROLEX. Defendant No. 2 and Defendant No. 3 retail the said artificial jewellery. Defendant No. 2 also carries on business in the name and style of ROLEX Jewellery House and had also registered the domain name www.rolexjewelleryhouse.com and operated a website under the said name.

Plaintiff found out about Defendants, when Defendants applied for registration of the mark ROLEX before the Trade Marks Registry. Plaintiff filed oppositions against Defendants' trademark applications and also sent them a legal notice. Since no satisfactory response was received from Defendants, Plaintiff filed the present suit for trademark infringement and passing off. An ex-parte interim injunction order was granted to Plaintiff by Delhi High Court. Defendants did not comply with the interim injunction order and Plaintiff was compelled to file a petition for contempt of court against Defendants. In the contempt proceeding, Court appointed local commissioners for search and seizure of Defendants' products under the ROLEX trademark. The contempt proceedings were however withdrawn when Defendants appeared before High Court and rendered an unconditional apology and undertook not to use Plaintiff's mark till disposal of the suit. Thereafter Defendants did not appear before the High Court and the matter proceeded ex-parte.

**Contentions:** Defendants explained its adoption of the ROLEX trademark in the following manner - ROL was adopted from 'rolled gold' the material used for manufacturing Defendant's products and EX from Alex name of the son of Director of Defendant No. 1. Plaintiff claimed that Defendants' use of the well-known mark is dishonest and the explanation for adoption is obviously false and fabricated. Plaintiff further submitted that despite being put to notice about Plaintiff's prior rights to the ROLEX mark, Defendants continued their infringing activities with impunity. Plaintiff submitted that Defendants' adoption of identical trademark in respect of cognate or allied products cannot be allowed and they must be restrained.

**Held:** High Court held that Defendants are not only guilty of infringement but are also guilty of passing off their products as and for those of Plaintiff's products. High Court issued a decree granting permanent injunction restraining Defendants from using the ROLEX trademark or any other mark

deceptively similar thereto. In addition, High Court directed Defendants to pay a sum of ₹ 5 lacs (US\$ 8065) as compensatory damages and a sum of ₹ 3 lacs (US\$ 4839) as punitive damages.

## 20. Timberland prevents sale of fake TIMBERLAND products over the Internet

*Timberland Company vs. Rohit Bajaj & Ors.*  
4 September 2014, Delhi High Court

**Trademarks:** TIMBERLAND v Timberland; trademark counterfeiting

**Parties and Background:** Plaintiff is engaged in the manufacture and marketing of branded apparel and footwear under the trademarks TIMBERLAND and TREE DEVICE since 1973. Defendant No. 1 Rohit Bajaj is the proprietor of the firm Rohit Fashions, which exports surplus garments bearing various brands after procuring them in bulk from commission agents/brokers; Rohit Fashions mainly exports to USA, Africa, Sri Lanka etc. and was willing to sell stocks to local buyers only in bulk.

In October, 2002 Plaintiff became aware of two websites [www.rohitfashions.com](http://www.rohitfashions.com) and [www.stockgarments.com](http://www.stockgarments.com), where Defendants were offering stock lot, surpluses and cancelled order of both branded and unbranded clothing from factories in India. Amongst the branded goods, Defendants were exporting and offering to sell to various countries goods under the well known trademarks of Plaintiff i.e. TIMBERLAND and TREE DEVICE.

Aggrieved, Plaintiff filed the present suit for trademark infringement and passing off against Defendants. In the suit, an ex-parte interim injunction order was granted and Defendants were restrained from using or dealing in the Plaintiff's trademarks in any manner. High Court also appointed Local Commissioners for search and seizure of the infringing products. The Local Commissioners visited Defendants' premises and a large number of counterfeit products bearing Plaintiff's trademarks were recovered. Despite being notified of the suit, Defendants did not appear before the High Court and the matter proceeded ex-parte.

**Contentions:** Plaintiff argued that Defendants were selling counterfeit products bearing Plaintiff's well-known trademarks and causing confusion among consumers by leading them to believe that such products are genuine and originate from Plaintiff. Plaintiff claimed that Defendants are causing dilution of the goodwill associated with its famous marks and garnering illegal profits.

**Held:** High Court was of the opinion that Plaintiff had successfully established trademark infringement and passing off, and is entitled to a decree of permanent injunction. High Court also awarded a sum of ₹ 3 lacs (US\$ 4839) as compensatory damages and a further some of ₹ 2 lacs (US\$ 3226) as punitive damages, to be paid by Defendant to Plaintiff.

## 21. High Court rules in favour of Diageo and prevents Khoday from adopting and using deceptively similar trademarks

*Diageo Brands B.V & Ors. vs. Khoday Breweries Ltd. & Ors.*  
3 September 2014, Delhi High Court

**Trademark:** Infringement and passing off of various trademarks.

**Parties and Background:** Plaintiffs are a group of companies or associated or affiliated companies of Diageo Plc., one of the world's most famous trade names in manufacturing, distribution, marketing and sale of alcohol beverages including wines, liquors, spirits, cordials, beers and other products under well known brands/marks such as JOHNNIE WALKER RED LABEL, JOHNNIE WALKER BLACK LABEL, JOHNNIE WALKER GREEN LABEL, JOHNNIE WALKER GOLD LABEL, JOHNNIE WALKER BLUE LABEL, CAPTAIN MORGAN, VAT 69, SMIRNOFF, BLACK & WHITE, BAILEYS, BELL'S, J&B and GUINNES and several others.

Defendant No. 1 to Defendant No. 4 are a part of a group of companies dealing in alcohol and beverage products similar to those of Plaintiffs and are under a common management. Defendants No. 5 to 14 are responsible for the management of Defendant No. 1 Defendant No. 4s' group of companies.

\* 1 US \$ = ₹ 62 approx.

Defendant No. 1 to Defendant No. 4 had filed applications for registrations of trademark, which according to Plaintiffs, are deceptively similar to their trademarks. It is stated by the Plaintiffs that the trademarks KHODEY BLACK & WHITE, VAT 999, GUDNESS, BOND'S GREEN LABEL, CAPTAIN WALKER, PETEWALKER, PETEWALKR and NOF adopted by the Defendants were found deceptively similar to the trademarks of the Plaintiffs and were wrongly registered by Defendants no. 1 to 4. Plaintiffs had earlier initiated two suits against Defendants and in both such suits Plaintiffs were granted interim injunctions. The Defendants are restrained in 1996 from selling, offering for sale, advertising, directly or indirectly dealing in whiskies under the mark VAT 999 or any other mark identical with or deceptively similar to the Plaintiff's trade mark VAT 69. A decree was passed in 2000 for perpetual injunction was also passed in favour of the Plaintiffs restraining the Defendants from using the trademarks JOL-E-WALKER, BON-E-WALKER, UNCLE WALKER and WALKER'S CHOICE which were confusingly similar to the trademark of the Plaintiffs' JOHNNIE WALKER in respect of their goods or any advertisement and promotional material. In addition, Plaintiffs had filed a number of oppositions against trademark applications filed by Defendants, and in most of the cases, the oppositions were allowed or the applications were abandoned. Plaintiffs alleged that despite the suit initiated in the year 2000 and not contested by Defendants, the predatory tactics of Defendants continued unabated in as much as in the year 2003, Defendants filed yet another application for registration of the mark PETER WALKER. As Defendants continued to adopt new trademarks which were confusingly similar to Plaintiffs' marks, Plaintiffs were constrained to file the present suit. Plaintiff no. 1 also addressed a cease and desist notice in 2009 to Defendants no. 2 and 3 setting forth all the relevant particulars, pertaining to Plaintiffs' right in their registered trademarks and calling upon Defendants to withdraw the pending applications filed by them.

**Contentions:** Plaintiffs alleged that Defendants being in the same trade and being well aware of Plaintiffs' trademarks had deliberately adopted virtually identical or deceptively similar marks, or marks having essential and prominent portions of Plaintiffs' marks, in respect of same or similar goods so as to cause confusion and deception in the

market and to make unjust profits for themselves by riding on the reputation of Plaintiffs. Plaintiffs prayed that Defendants be restrained from (i) using or attempting to use or (ii) asserting any right to use or (iii) applying to register or (iv) to maintain the applications, or (v) to register any of the trademarks JOL- E- WALKER, BON-E-WALKER, UNCLE WALKER and WALKER'S CHOICE.

Defendants denied that they are using deceptively similar marks or proposing to use similar or deceptively similar marks as that of Plaintiffs. Defendants argued that Plaintiffs had sought a blanket injunction to restrain Defendants from filing applications seeking registration of trademarks, which is not permissible and will preclude Defendants from applying for a trademark based on the subjective and biased evaluation of the Plaintiffs rather than that of the Registrar of Trade Marks.

**Held:** High Court ruled that Plaintiffs' prayer to restrain Defendants from using trademarks which are already registered cannot be allowed and directed Plaintiffs to initiate cancellation actions before appropriate authority.

On examination of the various trademarks adopted by Defendants, High Court observed that most of the said trademarks are deceptively similar to Plaintiffs' trademarks. High Court was of the opinion that Plaintiffs had established a strong prima facie case. Accordingly, High Court issued an injunction order restraining Defendants from using or asserting any right to use or passing off, any of the trademarks specified in the plaint namely KHODEY BLACK & WHITE, VAT 999, GUDNESS, BOND'S GREEN LABEL, CAPTAIN WALKER, PETEWALKER, PETEWALKR and NOF as belonging to Plaintiffs or any other marks owned by Plaintiffs, till disposal of the suit.

## 22. 's.OLIVER' prevails over OLIVE mark in relation to ready-made clothing

*Oliver Bernd Freier Gmbh & Co. Kg v Rasul Exports & Anr*  
5 February 2014, Delhi High Court

**Trademarks:** sOLIVER v OLIVE; trademark infringement

**Parties and Background:** Plaintiff is engaged in the business of manufacture and trade of a wide range of fashion and lifestyle products, including clothing and ready-made garments of all kinds and fashion accessory products like belts, shoes, bags, watches, eye-wear products and fragrances and skincare products. Since 1975, Plaintiff has been using the trademark “s.Oliver” in course of its trade. In India, Plaintiff had obtained registration of the “s.Oliver” mark in Class 25.

Defendant No. 1 is a sole proprietary concern of Defendant No.2 and together they are engaged in the business of manufacture and trade of clothing, ready-made garments including shirts and related goods. The Defendants are said to have adopted and using in the course of trade the trade mark “OLIVE” in relation to the impugned goods and business.

In April 2006, Plaintiff came to know about Defendant’s adoption and use of the OLIVE mark when they conducted a search of the records of the Trade Marks Registry. Despite sending a legal notice, Defendant refused to cease use of the mark. Hence, Plaintiff had filed the present suit for permanent injunction, restraining infringement, passing off etc. against Defendants.

**Contentions:** Plaintiff contended that Defendant’s adopted mark is deceptively similar and amounts to violation of its trademark registration. Plaintiff further claimed that Defendant had intentionally adopted the impugned mark to cause confusion and deception in the market and to pass off its goods as and for those of Plaintiff.

Defendant submitted that there is no deceptive or phonetic similarity and there exists no possibility of confusion between the two trademarks, since Plaintiff’s mark “s.Oliver” is a personal name characterized by an initial, whereas Defendants’ mark “OLIVE” is the name of a common fruit tree. Defendant stated that it had no knowledge of the use of the Plaintiff’s mark in India and the use claimed by Plaintiff in India is completely false.

**Held:** High Court ruled that Plaintiff had been able to make out a prima facie strong case for infringement of trade mark “s.Oliver” as it is a well-known trade mark, and the trade mark “OLIVE” of Defendant was deceptively similar to Plaintiff

mark “s.Oliver” and was being used also in relation to similar goods. High Court issued an order restraining Defendant from using the trade mark “OLIVE” in respect of clothing and ready-made garments.

### 23. MINDGYM is not descriptive or laudatory, holds High Court

*Mind Gym Ltd vs Mindgym Kids Library Pvt Ltd  
21 March 2014, Delhi High Court*

**Trademarks:** MIND GYM v MINDGYM; trademark and trade-name infringement and passing off

**Parties and Background:** Plaintiff is renowned internationally for its pioneering business that mainly focuses on education/training, personal and professional development, mind management, thought process training and development, psychological and behavioural analysis, motivation and the training and development of mind. Plaintiff is the proprietor of the trademark/trade name MIND GYM which was first adopted in 1999.

In August 2012, Plaintiff came across the website www.mindgym.in and found that Defendant is using the said trademark in relation to a kids library and exchange concept. This concept used a membership program where members could exchange books, toys, CDs and other learning resources through a number of franchisee outlets around the country. Further enquiries by Plaintiff revealed that Defendant had commenced operating a playschool in Bangalore under the name MINDGYM. Defendant was also in the process of launching its operations all across India through franchisees. Despite Plaintiff sending a legal notice to Defendant, Defendant refused to cease use of the MINDGYM mark. Aggrieved, Plaintiff filed the present suit against Defendant for trademark infringement and passing off. An ex-parte interim injunction order was issued in the suit. Upon receipt of the ex-parte order, Defendant appeared before the High Court and submitted its response to the plaint.

**Contentions:** Defendant claimed that the Delhi High Court did not have territorial jurisdiction to entertain this suit as it was not carrying on any business in Delhi. Defendant further claimed that

Plaintiff's trademark registration was wrongly granted and should be cancelled since the expression MINDGYM means exercise of mind and is highly descriptive and laudatory term in relation to any service or product related to exercise of mind. Defendant also claimed that Plaintiff had knowledge about Defendant since 2006 and the present suit suffers from delay and laches.

Plaintiff submitted that it was conducting its business within the territory of Delhi and therefore Delhi High Court did have jurisdiction. Plaintiff also submitted that Defendant itself had applied for registration of the mark MINDGYM and is now making contrary claims that the said mark is descriptive or laudatory. Plaintiff denied knowledge about Defendant's operations since 2006 and submitted that registration of a domain name with a 3<sup>rd</sup> party registrar does not amount to knowledge or awareness on Plaintiff's part.

**Held:** High Court held that it was established on record that Plaintiff is the registered owner of the trademark MIND GYM, thus Plaintiff has made out a prima facie case in its favour. High Court noted that the balance of convenience also lies in favour of Plaintiff and against Defendant who had failed to give any justification by using the same trademark and trade name. Accordingly, Delhi High Court issued an order allowing the interim order granted earlier to continue till the disposal of the suit and thus, restrained Defendant from using the trademark MIND GYM either as a part of its corporate name or as a trade mark or in any other manner. However, High Court allowed Defendant to use the name MINDGYMNASTICS as a trademark/ trade name as a single word, subject to the condition that it will not extend its business other than its existing business of library service which caters to kids only but not as domain name, in order to avoid confusion and deception.

## 24. Enterprise Holdings successfully enforces its trademark ENTERPRISE in India

*Enterprise Holdings, Inc vs Enterprise Auto Rentals*  
11 March 2014, Delhi High Court

**Trademarks:** ENTERPRISE v Enterprise Autor Rentals; trademark and trade-name infringement and passing off

**Parties and Background:** Plaintiff is a US based company and the largest car service provider in the world measured by revenue, employees and fleet. Plaintiff is the proprietor of the service mark ENTERPRISE, and had been using it in India since 2007. Defendant is a partnership concern, whose proprietors Mr. Gulwant Singh and Mr. Sandeep Singh were earlier working for Avis, which is a direct competitor of Plaintiff and is in the same line of business of vehicle rental services.

In October 2010, Plaintiff first became aware of Defendant from its website [www.enterpriseautorentals.org](http://www.enterpriseautorentals.org). When Plaintiff contacted Defendant, Defendant promised to stop using the mark, however, a follow up investigation indicated that not only had Defendant continued operating the website, it had also commenced use of the expression ENTERPRISE as a trademark. Aggrieved, Plaintiff filed the present suit for trademark infringement and passing off. In the suit, an ex-parte interim injunction order was granted to Plaintiff. Upon receipt of the injunction order, Defendant appeared before High Court and filed an application for vacation of the injunction.

**Contentions:** Plaintiff claimed that having worked in the business of vehicle rental services, Defendant was definitely aware of Plaintiff's trademark ENTERPRISE. Thus, the said mark was adopted deliberately in order to exploit the goodwill and reputation associated with the ENTERPRISE mark. Plaintiff claimed that Defendant's adoption of an identical mark in relation to identical services amounted to trademark infringement and passing off.

Defendant claimed that the Delhi High Court had no jurisdiction to entertain the suit. Defendant further mentioned that Plaintiff's registration pertained to the mark E-ENTERPRISE and not ENTERPRISE. Also, Defendant submitted that its use of the trademark was since 2010 and is prior to that of Plaintiff, whose trademark application for registration of ENTERPRISE mark has been filed on the basis of proposed use. In addition, Defendant submitted that the word ENTERPRISE is a generic and descriptive word, existing in the dictionary and cannot be monopolized by a single entity.

**Held:** High Court ruled that Defendant's services

were being offered within the territory of Delhi and consequently, Delhi High Court did have jurisdiction to entertain the suit. High Court also observed that Defendant had failed to establish any 3<sup>rd</sup> party use of the ENTERPRISE mark and hence, the claim of publici juris had not been established. On the issue of Defendant's use of the mark since 2010, High Court ruled that Defendant had continued use of the mark, despite being notified by Plaintiff of its prior rights in the ENTERPRISE mark. High Court opined that mere delay cannot deprive a registered proprietor of its statutory rights. Based on the above observations, High Court issued an order confirming the interim injunction order granted earlier, pending disposal of the suit. In addition, High Court dismissed Defendant's application for vacation of the ex-parte interim injunction order.

## 25. Confusion over the Internet - High Court rules in favour of Groupon Inc

*Groupon, Inc vs Mohan Rao And Another*  
19 March 2014, Delhi High Court

**Trademarks:** GROUPON v Groupon/Groupoff; trademark and domain name infringement

**Parties and Background:** Plaintiff is a US based company, which offers online audiences daily discounts on products and services under the brand GROUPON through its website www.groupon.com which features daily deals on products and services in more than 40 countries. The trademark GROUPON was adopted by Plaintiff's predecessors in 2002.

Defendants through their website www.groupon.in are engaged in an identical business of offering discount coupons. Defendants have a trademark registration for the GROUPON mark in Class 35, against which Plaintiff had filed a cancellation action. Additionally, Defendants own two other domain names www.groupoff.com and www.groupoff.in.

Plaintiff had filed the present suit to restrain Defendants from using the trademark and domain name GROUPON or any other deceptively similar mark. An ex-parte interim injunction order was granted to Plaintiff at the initial stage of the suit.

Defendant had filed an application for vacation of the said ex-parte interim injunction order.

**Contentions:** Plaintiff claimed that Defendants commenced their business operations in 2011, after news reports of Plaintiff's entry into India were published. Plaintiff further alleged that Defendants were interested in conducting business with Plaintiff in India and was therefore well aware of Plaintiff's trademarks. Plaintiff submitted that Defendants wilfully adopted the GROUPON marks in order to exploit Plaintiff's goodwill and reputation.

Defendants claimed that they registered the domain names comprising the GROUPON marks much prior than Plaintiff in 2009 when no registration was granted to Plaintiff for the said mark anywhere in the world. Defendants further submitted that they are the registered proprietors of the said mark in India. Defendants claimed that the ex-parte injunction is preventing them from exercising their statutory rights granted validly under the Act.

**Held:** High Court observed that Plaintiff's business operations were primarily on the Internet through the website www.groupon.com. Also, Court noted that Plaintiff is known to operate country specific variations of the domain name. As such, Defendants' website www.groupon.in could be misconstrued by consumers to be the India-specific website of Plaintiff. High Court ruled that Plaintiff had successfully established a prima facie case, which warrants that the interim injunction order granted earlier be confirmed till disposal of the suit. High Court also dismissed Defendant's application for vacation of the ex-parte injunction order.

## 26. Parallel Imports of MARLSBORO cigarettes - High Court rules against Indian retailers

*Phillip Morris Products S.A & Anr Vs. Sameer & Ors*  
10 March 2014, Delhi High Court

**Trademarks:** MARLSBORO v MARLSBORO; trademark counterfeiting and parallel imports

**Parties and Background:** Plaintiff No. 1 is a Swiss company and Plaintiff No. 2 is its Indian subsidiary. Plaintiffs are a world-renowned tobacco company. Plaintiff No. 1 is the proprietor of the trademark

MARLSBORO and Roof device which was adopted in 1955. In India, Plaintiff No. 1 is the registered proprietor of the MARLSBORO mark in relation to products in Class 34.

In May 2010, Plaintiffs became aware that various retailers, in the Fort and Colaba area of Mumbai, were indulging in the sale, stocking and distribution of counterfeit as well as grey market versions of Plaintiffs' products, both of which, according to Plaintiffs, were unauthorised and violative of its intellectual property rights. Plaintiffs conducted a detailed investigation and purchased 23 samples from 19 retailers. Analysis of the first 20 samples purchased from Defendant No. 2 to Defendant No. 5 revealed that they were grey market products which were not meant for sale in India. While examination of the second batch of 3 samples purchased from Defendant No. 1 showed that they were counterfeit products. Hence, Plaintiffs filed the present suit claiming infringement and passing off of its MARLSBORO marks. At the initial stage of the suit, an ex parte injunction order was issued restraining Defendants from using Plaintiffs' MARLSBORO marks. Despite service of the said ex-parte orders, none of the Defendants appeared before High Court and consequently, the suit proceeded ex-parte. High Court had also directed appointment of two local commissioners who filed their reports after visiting Defendants' premises and conducting search and seizure of the offending products.

**Contentions:** Plaintiffs submitted that the goods seized from Defendants are either counterfeit or contraband and are infringing its statutory rights in the MARLSBORO marks. Plaintiffs contended that the infringing products sold by Defendants incorporate all the visual elements of Plaintiffs' cigarette packets, bearing the suit trademarks. Plaintiffs claim that the infringing products so sold are of an inferior quality, materially altered in terms of packing, and thereby, dilute the brand equity of the Plaintiffs' trademarks.

**Held:** With regard to the grey market goods being sold by Defendants under the MARLSBORO marks, High Court was of the opinion if such goods were genuine products of the Plaintiffs, either meant for sale outside India or in duty free shops and have been lawfully acquired by Defendants, then Plaintiffs' rights in the MARLSBORO marks cannot

be said to have been infringed. However, since Defendants have not appeared before the court, it is not possible to determine whether such products have been lawfully acquired by Defendants. Under the circumstances, the defence of Section 30(3) of the Trade Marks Act 1999 cannot be applied in the present case. High Court ruled that sale of the impugned cigarettes by Defendants amount to infringement of Plaintiffs' trademarks and as such, Plaintiffs are entitled to injunctive relief. High Court also directed Defendant No. 1 to pay ₹ 10,000 (US\$ 161) and the other Defendants a sum of ₹ 5000 (US\$ 81) each to Plaintiffs as damages.

## 27. PIROCIN held to be confusingly similar to CROCIN by High Court

*Smithkline Beecham Ltd & Anr v Hanish K Ajmera & Anr*  
10 January 2014, Delhi High Court

**Trademarks:** CROCIN v PIROCIN; trademark infringement

**Parties and Background:** Plaintiffs are engaged in the manufacture and sale of a wide range of pharmaceutical products worldwide, including in India. Plaintiff No. 1 is the proprietor of the trademark CROCIN which is used in relation to paracetamol tablets which was adopted in 1982.

In 2010 Plaintiffs came to know about the sale of analgesic and anti-pyretic tablets by Defendants under the mark PIROCIN which was virtually identical to Plaintiffs' well-known and registered mark CROCIN. In addition to copying Plaintiffs' mark, Defendants had also copied the phrase 'The effective relief from pain - gentle on stomach' used by Plaintiffs in relation their products under the CROCIN brand. Plaintiffs filed the present suit for trademark infringement against Defendants. In the initial stage of the suit an ex-parte interim injunction was granted in favour of Plaintiffs. Defendants had filed an application seeking vacation of the ex-parte injunction order.

**Contentions:** Plaintiffs asserted that Defendants had simply substituted the letters 'C' in their mark and replaced them with 'PI' and the impugned mark was deceptively similar to their well-known trademark. Plaintiffs also argued that the two rival



marks are virtually identical. The two products with rival marks were used for identical purposes i.e. both provide relief from pain, the class of consumers directly overlap and the channel of trade was also identical.

Defendants on the other hand contended that the ex-parte injunction is liable to be vacated because Plaintiffs have concealed material facts from this Court. Defendants are preparing ayurvedic medicine which material fact has not been stated in the plaint. Defendants further argued that the expression CROCIN is not an invented word and appears in the dictionary and means saffron. Further, Defendants argued that there are many medicines ending with the alphabets "CIN, owned by proprietors who are prior adopters than Plaintiffs.

**Held:** High Court observed that in an action for infringement where Plaintiff is able to show that Defendant's mark is likely to deceive either due to visual, phonetic or otherwise similarity, and the court reaches a conclusion that there is imitation, no further evidence is required to be established that Plaintiff's rights have been violated. High Court disagreed with Defendants that there are any dissimilarities between the rival marks and was of the opinion that there was a very close phonetic similarity between the two trademarks PIROCIN and CROCIN, and both medicines are used for the same ailment i.e. relieving the pain, both are analgesics and soft on stomach, and there was not much variation in the prices of the two strips. Accordingly, High Court issued an order, confirming the interim injunction granted earlier to continue till disposal of the suit and dismissed Defendants' application for vacation of the ex-parte interim injunction.

## 28. Coca Cola prevails over Indian entities in trademark dispute

*The Coca-Cola Company & Anr. Vs. K.M Salim*  
4 March 2014, Delhi High Court

**Trademarks:** SPRITE/THUMS UP/FANTA v BRIGHT/FUNS UP; trademark and trade dress infringement and passing off

**Parties and Background:** Plaintiff No. 1 is a

US based company and is the world's leading manufacturer, marketer and distributor of non-alcoholic beverage, concentrates and syrups used to produce nearly 400 beverage brands. Plaintiff No. 2 is the Plaintiff No. 1's Indian subsidiary. Plaintiff No. 1 is the owner and registered proprietor of several well known trade marks inter alia SPRITE, THUMS UP, FANTA, COCA-COLA, COKE, DIET COKE, MINUTE MAID, LIMCA, Mr. PIBB, KINLEY, MAAZA, POWERADE and SUNFILL etc. Plaintiff No. 1's mark SPRITE is registered in India since 1961, whereas THUMS UP is registered since 1973.

In December 2008, Plaintiffs came to know that Defendant was violating several trademarks such as SPRITE, THUMS UP and FANTA marks. Plaintiffs sent a legal notice to Defendant to cease use of the offending trademarks, however, despite making some progress in the negotiations, Defendant ultimately did not comply with Plaintiffs' requests and continued use of the said marks. Aggrieved, Plaintiffs filed the present suit for trademark infringement and passing off. In the suit, Defendant did not appear before the High Court despite being notified of the suit and was proceeded ex-parte. Plaintiffs filed an application for pronouncement of judgment against Defendant on account of his failure to contest the matter.

**Contentions:** Plaintiffs submitted that firstly, Defendant had adopted and was using a mark BRIGHT which is confusingly and deceptively similar to Plaintiff's registered mark SPRITE and secondly, he had also adopted and put to use a mark FUNS UP which is confusingly and deceptively similar to Plaintiff's mark THUMS UP. Further, Defendant was using the mark BRIGHT with a trade dress which is confusingly and deceptively similar to the trade dress of products bearing the mark SPRITE. For his product FUNS UP, Defendant had copied distinctive elements of FANTA that comprises the unique colour combination and the distinctive style of writing FANTA. Plaintiffs asserted that such acts of Defendant amounted to infringement of the registered trade marks SPRITE and THUMS UP, passing off and the copyright in the SPRITE and FANTA labels of Plaintiff No. 1. Plaintiffs further argued that it was clear that Defendant had deliberately adopted various elements of the Plaintiff No. 1's brands to give an impression to the consumers that he is connected to Plaintiffs.

**Held:** On examination of the materials placed on record by Plaintiffs, High Court agreed that Defendant had indeed infringed Plaintiff No. 1's SPRITE and THUMS UP marks and indulged in passing off of the SPRITE and FANTA labels. High Court allowed Plaintiffs' application for pronouncement of judgment on accounts of Defendant's failure to contest the suit and restrained Defendant from infringing and passing off Plaintiffs' SPRITE, THUMS UP and FANTA labels or any other trademark, in any manner.

### 29. High Court rules AMAFORTAN confusingly similar to ANAFORTAN

*Abbott Healthcare Pvt. Ltd. Vs. Raj Kumar Prasad & Ors*  
25 April 2014 and 10 September 2014, Delhi High Court

**Trademarks:** ANAFORTAN v AMAFORTAN; trademark infringement

**Parties and Background:** Plaintiff is a pharmaceutical company and a wholly owned subsidiary of the US based Abbott Laboratories. Plaintiff is the current proprietor of the trademark ANAFORTAN which is used in relation to 'Camylofin Dihydrochloride with Paracetamol'.

Defendant No. 1 is the sole proprietor of the concern Birani Pharmaceuticals, and is said to be carrying on business as a marketer of pharmaceutical and medicinal preparations. Defendant was marketing a drug containing 'Camylofin Dihydrochloride with Paracetamol' in the form of tablets under the brand name AMAFORTEN.

In July 2012, Plaintiff came to know about Defendant's use of the impugned mark and also found that Defendant had obtained registration of the said trademark. Aggrieved, Plaintiff filed the present suit for trademark infringement and passing off.

**Contentions:** Plaintiff alleged that the impugned mark was phonetically, visually and structurally similar to Plaintiff's registered trademark. Defendant had also copied the colour of the strip and packaging of the Plaintiff's product. Even the outer packaging was a substantial reproduction

of Plaintiff's packaging, which amounted to infringement of Plaintiff's copyright. Plaintiff further submitted that the two medicines in question had the same formula and compound, and both were for treatment of abdominal pain and intestinal colic. Hence, Plaintiff submitted that confusion and/or deception in the market was bound to arise.

Defendant submitted that the suit is the abuse of process since Defendant is the registered proprietor of the impugned mark. Defendant also challenged the territorial jurisdiction of the Delhi High Court to try the suit claiming that its products are not available in Delhi. Defendant also alleged Delhi High Court did not have the pecuniary jurisdiction.

**Held:** The Single Judge held that Delhi High Court had the territorial jurisdiction to try the suit, since Plaintiff carried on its business within Delhi. Further, Single Judge observed that it had pecuniary jurisdiction to try suits which are valued over ₹ 20 lacs (US\$ 32258), and in this case, Plaintiff claimed damages of ₹ 20,00,100 (US\$ 32260). Finally, Single Judge stated that a suit for trademark infringement can also lie against a registered proprietor of an identical or similar trademark. Given that Plaintiff is much prior in terms of adoption and use of its mark and Defendant is late entrant and in view of the fact that Defendant's mark is confusingly and deceptively similar to Plaintiff's trademark, the Single Judge held that Plaintiff will suffer irreparable injury if Defendant's infringing acts are allowed to continue. Accordingly, the Single Judge restrained Defendant from using the impugned trademark.

Aggrieved by the decision of the Single Judge, Defendant filed an appeal before the Division bench of Delhi High Court. The sole question before the Division bench was whether a registered proprietor of a trademark can sue another registered proprietor of a trademark alleging deceptive similarity. Plaintiff submitted that it had filed a rectification petition against Defendant's registered mark. Division bench observed that Defendant was obviously subsequent in entering the market and had deliberately not mentioned when it commenced use of the impugned mark. On analysis of the relevant provisions of the Act, Division bench ruled that the Single Judge had correctly applied the legal principles and there was no infirmity in the impugned decision and dismissed the appeal.

### 30. KIT-KAT prevail in trademark dispute

*Societe Des Produits Nestle,S.A. & Anr. vs. Montu Sadhu & Ors*  
4 July 2014, Delhi High Court

**Trademarks:** KIT KAT v KET KET/KITKET; trademark infringement

**Parties and Background:** Plaintiffs are part of the Nestle group and are world's biggest food and beverage company. Plaintiffs are the proprietor of the trademark KITKAT which was adopted in 1935 and had been used extensively internationally since 1937. Products under Plaintiff's KITKAT marks were available in India since 1940s and the trademark is registered in India since 1942.

Defendant No. 1 Montu Sadhu is trading as Montu Confectionery, Defendant No. 2. Defendant No. 3 Mrs. Putul Sadhu is the wife of Defendant No. 1 and is trading as Defendant No. 4 Putul Trading Company. Defendants were involved in manufacturing and selling substandard and spurious confectionery including candies, toffees etc. under the impugned trade marks KETKET & KIT-KET. In December 2012, Plaintiffs came to know of Defendants' infringing activities. Aggrieved by such actions, Plaintiffs filed the present suit complaining of trademark infringement and passing off. Defendants did not appear before the court despite being notified and the case proceeded

ex-parte. An ex-parte interim injunction had been granted in favour of Plaintiffs in the suit.

**Contentions:** Plaintiffs alleged that Defendants' trade marks KETKET & KIT-KET were an outright imitation of Plaintiffs' well-known trade mark KITKAT. In addition, Plaintiffs claimed that Defendants had deliberately written KETKET & KIT-KET in an identical manner within a white oval device having a red border with white outline contiguous thereto. Thus, Plaintiffs alleged that Defendants actions amounted to misrepresentation and misappropriation of their goodwill in the trade mark KITKAT and its packaging.

**Held:** Delhi High Court was of the view that Defendants' trademarks were deceptively similar to Plaintiffs' well-known trademark KITKAT. In addition, High Court observed that use of the words KETKET & KIT-KET by Defendants was likely to dilute the distinctive character of Plaintiffs' trademark KITKAT and the same was likely to erode the goodwill and reputation of Plaintiffs among their existing as well as potential customers in the market. On the basis of above, High Court confirmed the ex-parte interim injunction granted earlier and decreed the suit in favour of Plaintiffs. High Court also awarded damages of a sum of ₹ 5 lacs (US\$ 8065) to be paid by Defendants to Plaintiffs.



# SELECTED INDIAN INTELLECTUAL PROPERTY CASES

Contributed by D.P. Ahuja & Co., Research Division  
Patent Cases 2014 - 2015

## High Court and Supreme Court Decisions: 2014-2015

### 1. No Novelty hence no infringement rules High Court in Sweatex Patent case

*Venkatraman Das v. VNS Innovations Pvt. Limited and Anr.*  
March 19, 2014, Madras High Court

**Issue:** Infringement of patent relating to Disposable Armpit Perspiration Pad

**Parties and Background:** Plaintiff is the original inventor of the patent relating to Disposable Armpit Perspiration Pad. Defendant No. 1 is alleged to be the manufacturer of identical perspiration pads under the trade mark SWEATEX in China and is selling the offending products through Defendant No.2 in India.

Plaintiff filed suit to restrain the Defendants from infringing its Registered Patent by manufacturing and selling Disposable Armpit Perspiration Pad under the Trademark SWEATEX.

**Contentions:** Plaintiff's invention comprises an oval shaped perspiration observing membrane mounted on a moisture proof bearer element. It is used to observe the armpit perspiration and at the the same time, to reduce the damage to the garment. The Plaintiff obtained Patent Registration No.181248 dated 21<sup>st</sup> May,1993 and the same was periodically renewed.

Defendant claimed that Plaintiff's invention is not new and has been known for many years. Hence, the patent ought to be revoked. It further submitted that Defendant No. 2 is not its dealer, but had merely approached it for a dealership arrangement. Accordingly Defendant No. 1 had sent six pieces of the product to Defendant No. 2 as samples and it does not qualify as commercial sale. Further, Defendant argued that its product is different from the products envisaged under Plaintiff's patent and hence it has not infringed Plaintiff's patent.

**Held:** Court examined the specifications under the patent and found that there was no novelty in

Plaintiff's patent. Court found that although Plaintiff had claimed that its product is an improvement over the earlier products, but the utility of its patented product had not been stated. Additionally, Court observed that the patent had also expired since filing of the suit, and therefore, Plaintiff had no case. With regard to the counter claims, Court observed that since the patent was registered at the time of filing of the suit, the suit cannot be termed as malicious and Defendant cannot be awarded any damages. The High Court dismissed both the suit and the counter claim.

### 2. Teva's petition for infringement of Glatimer patent returned for want of jurisdiction by Delhi High Court

*Teva Pharmaceutical Industries and Ors. vs Natco Pharma Limited*  
February 28, 2014, Delhi High Court

**Issue:** Infringement of patent relating to acetate

**Parties and Background:** 2007 Suit:

In 2007, Teva Pharmaceuticals Industries Ltd. ('Teva'), Yeda Research and Development Co. Ltd. ('Yeda') and Regent Drugs Ltd. ('RDL') filed a suit against Natco for a permanent injunction to restrain it from infringing Indian Patent No.190759 and selling or offering for sale, exporting, marketing, commercialising or registering glatiramer acetate under the mark 'Glatimer' or any other mark. In the said suit, Natco that "the process employed by them for producing glatiramer acetate marketed under the name of Glatimer is entirely different from the process patented by the Plaintiffs. In addition, Natco filed a counter-claim seeking invalidation of Plaintiff's patent.

2012 suit:

In 2012, Teva, Yeda and Teva API India Limited ('Teva India') filed a suit against Natco praying

for a permanent injunction to restrain Natco from infringing the Plaintiff's patent 190759. In this suit, Plaintiff referred to the affidavit filed by Natco in the 2007 suit which referred to an arrangement between Natco and Mylan Laboratories to develop and launch glatiramer acetate in India and the US. Following such information, Plaintiff's filed a suit against Natco and Mylan in the US District Court, Southern District of New York for infringement of its US patents. The US Court upheld Plaintiff's claims of infringement. In the present 2012 suit in India, Plaintiff's claimed that Natco's act of manufacturing the glatiramer acetate product for sale in the US and elsewhere amounted to a clear infringement of the Indian Patent No. 190759 and was, therefore, liable to be restrained by a permanent injunction.

**Contentions:** Natco filed three applications in response to the 2012 suit. First, it requested the Court to return the plaint for want of jurisdiction. Secondly, it prayed for rejection of the plaint and thirdly, it requested that the proceedings in the 2012 suit ought to be stayed pending adjudication of the 2007 suit.

With regard to the want of jurisdiction, Natco claimed that it does not carry on any business within the jurisdiction of this Court and thus, no part of the cause of action has arisen within the jurisdiction of this Court.

**Held:** The Court decided to first take up the issue of want of territorial jurisdiction of Delhi High Court. On examination of the arguments of both sides, Court observed that the present suit had been filed by Plaintiff under an apprehension that the product manufactured by Natco, infringed its Indian Patent No. 190759 and would be exported by Natco to the US. Court observed further that Plaintiff sought to justify filing the 2012 suit by claiming that the earlier 2007 suit pertained to the GA (glatiramer acetate) - first product, sold in India, and the present suit pertains to the separate and distinct GA (glatiramer acetate) -second product made in India for export to the US and other countries. Thus, in the second suit (filed in 2012) Plaintiff claims infringement of its process patent involved in the manufacture of glatiramer acetate. Court stated that in case of infringement of a process patent, the pleas of infringement have to be specific and found that there is no averment that the process patent i.e. Indian patent No.190759 is being practised/infringed by

Natco within the jurisdiction of this Court. High Court ruled that since the suit concerns a process patent, the pleadings as regards the product being sold in Delhi or elsewhere, or the possibility of it being launched in Delhi or elsewhere cannot justify the jurisdiction of the Court. Accordingly, Court returned the plaint to Plaintiffs for presentation to the appropriate court.

### 3. Revocation or counter-claim; parties must choose one option in patent related disputes holds Supreme Court

*Dr. Aloys Wobben And Another vs Yogesh Mehra And Others*  
2 June, 2014, Supreme Court.

**Issue:** Infringement of patent relating to wind turbines.

**Parties and Background:** Appellant, Dr. Aloys Wobben is a scientist-engineer based in Germany and is also engaged in the manufacture of wind turbines. The manufacturing process of wind turbines is carried out by Enercon GmbH Wobben Properties GmbH, which has acquired the rights and interests in all registered and pending patents and designs belonging to Dr. Wobben through an assignment agreement. In India, Dr. Wobben had been carrying out the manufacturing process through a joint venture partnership named Enercon India Ltd., with Respondents Yogesh Mehra and Ajay Mehra.

Enercon India was operating under technical know-how license agreements granted by Dr. Wobben, last of which was issued in June, 2006. The June 2006 license agreement was terminated by Dr. Wobben owing to non-fulfillment of contractual obligations under the license agreement. Despite termination of the license agreements, the respondents continued to use Dr. Wobben's patents. Enercon India filed 23 revocation petitions before the IPAB praying for revocation of the patents granted to Dr. Wobben. Aggrieved, Dr. Wobben filed about 19 patent infringement suits before the Delhi High Court. Respondents also filed 'counter claims' challenging the validity of the patents, on which the infringement suits were based.

**Contentions:** Respondents contended in the revocation petitions before IPAB (Intellectual Property Appellate Board), are exactly similar to the arguments placed by Respondents in the “counter claims’ filed at the Delhi High Court, against Appellant’s patent infringement suits.

Appellant argued that in case where a Defendant in a patent infringement suit has raised a ‘counter claim’ seeking revocation of the patent, the validity of the challenge be determined only at the hands of the High Court, i.e., while dealing with the “counter-claim”. Further IPAB would (after the filing of the “counter-claim” in the “infringement suit”), cease to have the jurisdiction to adjudicate upon the validity of the patent.

The Court observed that Section 64(1) of the Patents Act vests liberty to raise a challenge to a patent in three different circumstances. Firstly, on a petition by “any person interested”. Secondly, on a petition of the Central Government. In case of the above two circumstances, the petition for revocation would lie before the IPAB. Thirdly, by way of a “counter-claim” in a suit for infringement of a patent. The third case is adjudicable only by the jurisdictional High Court. Thus, a “person interested” may question the validity of the granted patent either by a revocation petition before the IPAB or through a “counter claim” as a Defendant to a patent infringement suit.

Appellant argued that the use of the word “or” in Section 64(1) demonstrates, that the liberty granted to any person interested to file a “revocation petition”, to challenge the grant of a patent to an individual, cannot be adopted simultaneously by the same person, i.e., firstly, by filing a “revocation petition”, and at the same time, by filing a “counter-claim” in a suit for infringement. Thus, the concerned person must choose between the above two remedies, since adoption of both remedies may result in one finding in the revocation petition and a different finding in a “counter-claim proceeding”.

The Supreme Court accepted the argument of the Appellant as being the correct legal interpretation of Section 64 of the Act. The following were the conclusions arrived at by the Court:

a) if “any person interested” has filed proceedings under Section 25(2) of the Patents Act, the same would eclipse all similar rights available to the very

same person under Section 64(1) of the Patents Act, i.e., the right to file a revocation petition or the right to file a counter-claim as a Defendant in a patent infringement suit.

b) If a “revocation petition” is filed by “any person interested” under Section 64(1) of the Patents Act, prior to the institution of an “infringement suit” by the patentee against him, such person would be disentitled in law from seeking the revocation of the patent through a “counter-claim” in the infringement proceeding.

c) Where in response to an “infringement suit”, the Defendant has already filed a “counter-claim” challenging the validity of a patent (on the basis whereof the “infringement suit” has been filed), the Defendant cannot thereafter, in his capacity as “any person interested” assail the concerned patent, by way of a “revocation petition”.

In the present matter, Appellant’s grievance was that in the infringement suits and corresponding counter-claims, the Delhi High Court is at the stage of framing of issues. However, despite the proceedings before the High Court, Respondents were pursuing the revocation petitions before the IPAB, where in 6 cases the patents have been revoked by the IPAB. Appellants prayed that the Respondents’ actions amounted to abuse of the judicial process and was causing undue hardship to the Appellants.

**Held:** The Supreme Court held that the remedy which will have to be adopted by the concerned parties, is dependent upon the date of institution of proceedings under Section 25(2) of the Patents Act, the date of institution of a “revocation petition” under Section 64(1) of the Patents Act, as also, the date of institution of a counter-claim in an “infringement suit”, under Chapter XVIII of the Patents Act.

The Court further stated that for convenience, it would be open for parties to accept one of the remedies, out of the plural remedies, which they would have to pursue in the different cases, pending between them, to settle their dispute. Having consented to one of the available remedies, it would not be open to either of the consenting parties, to seek redressal from a forum in addition to the consented forum.

#### 4. High Court issues directions to Patent Office regarding international filing dates of PCT applications

*Kaushik And Anr vs Union Of India And Ors*  
23 December 2013, Delhi High Court

**Issue:** Procedural rules relating to filing of PCT applications

**Background:** Puneet Kaushik, the petitioner, filed a PCT application, first filed for the invention in India, on 14 September 2012 before the Indian Patents Office, New Delhi branch. The petitioner's grievance is that despite having submitted the international PCT application, the Patents Office has not given international filing date of the said application.

**Contentions:** The petitioner prayed to the court to issue directions to the Patent Office to (a) grant the international filing date as 14<sup>th</sup> September, 2012 to the petitioner's international application and take the same of record by assigning an international application number; and (b) to declare that a PCT application filed in India at the Indian Receiving Office (RO/IN) would not require a prior permission under section 39 of the Patents Act, 1970; and (c) declare the Indian Receiving Office (RO/IN) as the competent receiving office when an Indian resident/ national is an application of the PCT application filed at RO/IN for at least one of any contracting states.

In response, Patent Office/Respondents, submitted that the petitioner had not filed an international application for patent under PCT but rather filed an application for permission for filing outside India under Section 39 of the Patent Act on Form-25. Patent Office also submitted that a resident of India cannot file an application outside India without obtaining the aforesaid permission. Patent Office further claimed that filing of request of Form-25 is different from filing of international application under PCT since they are dealt with by two separate counters in the office. The application under Section 39 at the General Cash Counter and PCT Counter application in PCT Division. It was also mentioned that the documents filed in the PCT Section of the Patent Office do not go to EDP Section and come directly to RMID-4 (Record Management and Information Dissemination - 4) Section and the documents filed in EDM Section

relating to Form-25 under PCT and Permission u/s 39.

**Held:** After analysing the scheme of the PCT, Court held that the practice adopted by Patent Office, is correct and an international application must necessarily be accompanied by a request under Section 39 of Patents Act unless such permission has already been obtained or an application for a patent for the same invention had been made in India not less than six weeks before the international application is made. Court found that the petitioner was granted the written permit under Section 39 only on 27<sup>th</sup> September, 2012, though the international application was delivered in the Patent Office on 14<sup>th</sup> September, 2012. Hence, Court stated that since the written permit in terms of Section 39 was mandatory for such an application, the international application even if complete in all other respects cannot be given a filing date earlier than the date on which the written permit in terms of Section 39 was issued.

On the issue of whether the petitioners had submitted only an application under Section 39 of Patents Act by filling up Form 25 or they had also simultaneously submitted an application to the Indian Patent Office on 14<sup>th</sup> September, 2012, Court noted that the Patents Office found several deficiencies in the documents of the petitioners due to which the request made by them cannot be treated as a PCT international application. But the Court found that apart from the written permit under Section 39 which was granted on 27<sup>th</sup> September 2012, none of the other deficiencies were so serious.

Accordingly Court directed Patent Office to grant 27<sup>th</sup> September 2012 as the international filing date in respect of the PCT application submitted by the petitioners on 14<sup>th</sup> September, 2012 and assign an international number to the application subject to petitioners submitting the copies of specifications in required number, and paying the requisite fee/late fee, within the time stipulated by Patents Office.

**Appeal Court decision:** Unhappy with the decision of the first instance court, Petitioner filed an appeal. In its decision dated 19 December 2014, the Division bench observed that the fact that Petitioner had in fact filed a PCT application cannot be disputed since a permission request under Form-

25 was filed. As per the High Court, Section 39 will then automatically apply and Patent Office could not have accepted such application without the requisite permission. High Court further observed that on 14<sup>th</sup> September 2012, the PCT application was not complete, since the permission was granted only on 27<sup>th</sup> September 2012. The Division Bench opined that Single Judge was correct in holding that filing date can only be accorded once the requisite permission was granted namely on 27<sup>th</sup> September, 2012. Accordingly, Division Bench stated that the reasoning adopted by the Single Judge was correct and dismissed the appeal by holding that Petitioner's request to date back the filing date to be on 14<sup>th</sup> September 2012 cannot be accepted.

### 5. Revocation is not automatic in case of violation of Section 8 of Patents Act, holds High Court

*Maj. (Retd.) Sukesh Behl & Anr. vs Koninklijke Phillips Electronics*  
7 November 2014, Delhi High Court

**Issue:** Procedural issues relating to filing of patent applications

**Parties and Background:** Appellants herein are the original Defendants in the patent infringement suit. The said suit was filed by the respondent/Plaintiff to restrain Defendants from infringing its essential DVD Video/DVD ROM Disc Patents, in particular Indian Patent with registered No.218255. Defendants filed their written statement which included a counter claim for revocation of the patent in suit, under Section 64(1)(m) of the Patents Act, 1970 for non-compliance of the provisions of Section 8. After filing of the written statement, Plaintiff's patent attorney wrote a letter to the Controller of Patents that certain details regarding the corresponding foreign filings were not submitted during the prosecution of the patent no. 218255. Plaintiff's attorney mentioned that an updated list of foreign filings comprising 3 pages were received from Plaintiff, but some information which was printed on the reverse of the first page were inadvertently omitted while submission of the same before the Indian Patent Office. In response, Defendants claimed that Plaintiff's attorneys' letter to the Controller amounted to suppression of vital

information and same being in violation of Section 8, a decree ought to be passed in their favour by allowing the counter claim and revoking the patent in suit. The Single Judge dismissed such application, ruling that there was no admission as to withholding of information being deliberate or that there was wilful suppression of such information. Single Judge stated that the matter can only be decided after examination of the evidence and parties have to await the conclusion of trial. Aggrieved by the decision, Defendants filed an appeal.

**Contentions:** Defendants submitted that Plaintiff on its own wrote the letter to the Controller more than four years after the grant of patent. It claimed that the letter constitutes an unequivocal admission regarding non-compliance of the statutory provisions of Section 8. Defendants contended that the expression "shall" in Section 8(1) of the Patents Act casts a mandatory duty upon an applicant to furnish information about prosecution of a similar application abroad and failure to furnish such information would straight-away attract the revocation provisions of Section 64(1). Thus, Defendants claimed that they are entitled to a decree for revocation of the suit patent as set out in its counter claim. Plaintiff on the other hand claimed that the power of the Single Judge under Order XII Rule 6 CPC is only discretionary and, therefore, Single Judge is justified in the facts and circumstances of the case in declining to pass a judgment as sought by the Defendants.

**Held:** The Division Bench observed that the fact that Plaintiff had filed details of the corresponding foreign application on 31<sup>st</sup> August, 2004 is not in dispute, however, such information was not complete. Division Bench noted that according to Plaintiff, the omission to furnish a part of the information, which was claimed to be not material to the grant of the suit patent, was not deliberate. In such case, Appeal Court ruled that it cannot be straight-away concluded that Plaintiff had failed to comply with the mandatory provisions of Section 8(1) of the Patents Act. Division bench opined that the Single Judge had rightly held that the question can be answered only at the conclusion of the trial. Division Bench also observed that that the language of Section 64(1) which deals with revocation of patents, is plain and unambiguous and it clearly confers a discretion upon the authority/Court while exercising the power of revocation. Accordingly,



Division Bench ruled that though any violation of the requirement under Section 8 may attract Section 64(1)(m) for revocation of the patent, such revocation is not automatic.

## 6. High Court rules that appropriate office for patent applications cannot be shifted by parties through agreement

*Bharat Bhogilal Patel vs Union of India and Ors. 8 October 2014, Madras High Court*

**Issue:** Whether forum conveniens affects the appropriate office exercising jurisdiction over patent applications

**Parties and Background:** Aditi Manufacturing Company, the fourth respondent, had challenged writ petitions filed by Bharat Bhogilal Patel, the Applicant, on the ground that the Madras High Court did not have territorial jurisdiction to try and entertain the writ petitions. The writ petitions were filed by Mr. Patel for judicial review of the orders passed by the Intellectual Property Appellate Board (IPAB).

According to Patent Rules 2003, for filing patent applications, the appropriate Patent Office is the one within whose territorial limits the applicant normally resides or has his domicile or a place of business or the place from where the invention actually originated. Since, Mr. Patel resided in Mumbai, the appropriate patent office was the one at Mumbai. Accordingly, Mr. Patel had filed two Patent Applications on 21<sup>st</sup> September, 1998 in respect of An Improved Laser Marking and Engraving Machine and “A Process of Manufacturing Engraved Design Articles on Metals or Non-Metals”, which patents were subsequently granted and entered into the register.

Aditi Manufacturing Company (AMC) filed revocation applications before the High Court of Gujarat at Ahmedabad against Patent Nos.188787 and 189027 granted in favour of Mr. Patel. Aggrieved, Mr. Patel sought transfer of the applications to Bombay High Court. However, with the IPAB having been constituted in the year 2007, the applications were transferred by the Gujarat High Court of Gujarat to the IPAB Circuit Bench at Mumbai. It is the case of the Petitioner,

in view of the urgency of the matter expressed by the Petitioner and the Circuit Bench at Mumbai not having adequate time, as per consent of parties and their counsel, the hearing of these applications was scheduled by the IPAB at Chennai, where the Bench held regular proceedings.

**Contentions:** As per AMC, the only basis for Mr. Patel invoking the jurisdiction of Madras High Court was because the hearing of the two patent revocation applications had taken place at Chennai. AMC claimed that the hearings were held at Chennai only as a matter of convenience to expeditiously conclude the matters since IPAB did not have frequent sittings at Mumbai. On the other hand, Mr. Patel argued that the patent revocation applications were heard at Chennai by consent of both parties and decided only at Chennai. On such basis, Mr. Patel argued that Madras High Court had the territorial jurisdiction to try and entertain the writ petitions.

**Held:** The High Court ruled that the arrangement to hear the matters at Chennai and not at Mumbai where the IPAB did not have regular seatings, was only as a matter of convenience as the parties were desirous of expeditious adjudication of the dispute. Court held that such an arrangement of convenience cannot shift the venue of litigation from Mumbai to Chennai. Court invoked the principle of forum conveniens and dismissed the writ petitions with liberty to file the writ petitions before the Mumbai High Court.

## 7. A well reasoned order is essential when refusing injunction application holds High Court

*Salzer Electronics Limited vs S.G.Controls & Switchgear (P) Ltd 9 June 2014, Madras High Court*

**Issue:** Infringement of patent relating to Integral Cam operated rotary switch

**Parties and Background:** Appellant/Plaintiff had filed two suits against Defendants, one for infringement of its registered patent under No.198122 in respect of “INTEGRAL CAM OPERATED ROTARY SWITCH” and another for passing off the said products in same or similar

trade dress, colour scheme, getup and layout or in any other manner. The Single Judge at the trial court refused to grant Plaintiff's prayers by holding that it had not established a prima facie case in favour of grant of injunction and dismissed the applications.

**Contentions:** Appellant/Plaintiff argued that Defendants had not given any explanation whatsoever as to how and why the registered patent is hit by prior art or on any ground under Section 64 of the Patents Act, 1970. Plaintiff also argued that once Single Judge observed that a counter claim was filed in the suit and it is a matter fit for trial, it was not open for him to conclude that the patent obtained by Plaintiff is not a new invention and several manufacturers are using the similar design, in the absence of ascribing of valid and justifiable reasons to that effect.

Respondent argued to the contrary, that the Single Judge had rightly dismissed the applications for interim injunction as the patent, does not disclose any inventive step and only put the available prior art in a different language. Respondent submitted that there is no disclosure in the specification about the novelty claimed by the Appellant/Plaintiff and therefore, it cannot be considered that the patent is granted for the novelty in issue. Also, there is no novelty in the assembling, as the description of the invention in the specifications, gives only the method of assembling the cam operated rotary switches, which is universally followed by all the manufacturers. In addition, Respondent submitted that the patent being of very recent and having regard to the working of the patent for short period no presumption can be drawn as to the prima facie validity of the patent.

**Held:** The Division bench observed that the Single Judge came to the conclusion that the subject matter of dispute between the parties, is a matter fit for trial. However, in the impugned order, he did not spell out the divergent stand taken by the parties nor did he discuss the merits and demerits of the claims of the parties. The Division bench set aside the impugned order, without expressing any opinion on the merits of the case as the order was shorn of necessary details.

## 8. Prior use of 4D Technology by Defendant, Plaintiff refused injunction by High Court

*Sandeep Jaidka vs Mukesh Mittal & Anr.*  
9 May 2014, Delhi High Court

**Issue:** Infringement of patent involving device producing 4D effects

**Parties and Background:** Plaintiff is an innovator in the field of electronics and has invented a novel system, i.e. device which produces heating, cooling and aromatic effects corresponding to the scene appearing in a movie, commonly known as 4D effects. Defendant No. 1 is owner of a 4D Theatre located called "funvilla" located within a mall, while Defendant No. 2 is the manufacturer and supplier of 4D Theatre equipment, who supplied the infringing 4D theatre equipment to Defendant No.1. The present suit was filed by Plaintiff against the Defendants for permanent injunction restraining infringement of its registered patent bearing No.231895 relating to such 4D effects. Both Defendants had filed their initial response, but the Defendant No. 1 stopped appearing before the Court and was moved ex-parte, while Defendant No. 2 continued to contest the suit and filed a counter-claim requesting revocation of the patent.

**Contentions:** Defendant argued that the subject of Plaintiff's patent is neither an invention nor is it an innovation attributable to Plaintiff. The device in the said patent is prior art and there is no valid ground on which the said device or the process could be granted patent. Defendant also submitted in its counter-claim that the patent ought be revoked as the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed.

In response, Plaintiff submitted that its patent is not a subject of any prior art or invention in the public domain and it represents a complete advancement in technology which requires no manual intervention and all signals as desired in a movie are digitally encoded. Plaintiff also denied that Defendant's alleged infringing device is different from that of the Plaintiff's patent.

**Held:** With regard to grant of injunction in relation to patent infringement suits, Court observed that it is now well settled that if patent has not been

sufficiently exploited in India and there is no user of the said patent in commercially viable form in India, Court may tilt the discretion in the interim stage in favor of the Defendant. The Court noted that in the present case, firstly, the subject patent has not been commercially exploited by Plaintiff yet and secondly, in another suit involving infringement of the same patent by another party, Plaintiff had not pressed for any interim injunction as the trial in that suit had been expedited. In addition, Court noted that Defendant had been manufacturing and supplying the equipments in dispute for a long time and an injunction will cause more injury to Defendant than Plaintiff who is yet to commercialize the patent. Considering all these factors, Court refused to grant interim relief but directed that the trial be expedited and ordered Defendant to furnish statements of account till the matter is finally decided.

### 9. Controller of Patents has the power to correct any irregularity in patent application holds Madras High Court

*NTT DoCoMo Inc. Vs. Assistant Controller of Patents and Designs*  
28 March 2014, Madras High Court

**Issue:** Procedural issues relating to filing patent applications

**Parties and Background:** NTT Docomo had filed two patent applications in relation to two innovations - (a) Application No. 4851/CHENP/2007 titled as "Transmission Rate Control Method, Mobile Station and Radio Network Controller", which is in respect of notifying an increase pattern of transmission rate increased in response to RG(UP) and (b) Application No.4814/CHENP/2007 titled as "Transmission Rate Control Method, Mobile Station and Radio Network Controller", which in respect of notifying a decrease pattern of transmission rate decreased in response to RG(DOWN). These two patent applications were based on the International patent application numbered as PCT/JP06/306523 dated 29<sup>th</sup> March, 2006 claiming priority of Japanese patent application number 2005-096539 filed on 29<sup>th</sup> March, 2005. While communicating the filing to NTT Docomo, its erstwhile attorneys had erroneously referred to the applications with the application numbers interchanged, namely,

application No.4851/CHENP/2007, originally meant for increase pattern of transmission technology, was shown as the patent application for decrease pattern of transmission technology and No.4814/CHENP/2007, originally meant for decrease pattern of transmission technology, was shown as the patent application for increase pattern of transmission technology.

Subsequently, NTT Docomo decided to withdraw its patent application relating to decrease pattern of transmission technology as it had become redundant, while retaining the patent application relating to increase in pattern of transmission technology. Accordingly, NTT Docomo instructed its erstwhile attorneys to withdraw its Indian Patent Application No.4851/CHENP/2007 believing in good faith that the same relates to the decrease pattern of transmission rate decreased in response to RG(DOWN). However, owing to the error committed by the patent attorneys in interchanging the patent application numbers, patent application no. No.4851/CHENP/2007 for increase pattern of transmission technology was withdrawn.

The mistake came to NTT Docomo's notice when it changed its patent attorneys, and the files were being transferred from its previous attorneys to its current attorneys. Petitioner's current patent attorneys immediately filed a request to revive/reinstate patent application No.4851/CHENP/2007, along with a proper explanation about the erroneous withdrawal of the said application.

However, the Controller of Patents refused such request and held that the Petitioner's request cannot be taken on record, as there was no provision under the Patent Act, 1970 or the Rules by which the said patent application can be revived or reinstated. Aggrieved, NTT Docomo filed the present writ petition against the order dated 14<sup>th</sup> December, 2012.

**Contentions:** Petitioner/NTT Docomo argued that Controller failed to appreciate that the patent application had been mistakenly withdrawn by its erstwhile patent attorneys owing to a clerical error. Petitioner added that the Controller had wrongly proceeded that the application itself ceased to exist, therefore, the request of the petitioner for revival of the patent application No.4851 cannot be acted upon. Petitioner contended that under

Section 78 of the Patents Act, it was contended that the first respondent has got enormous power to correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any manner which is entered in the register.

On the other hand, Respondent argued that there is no provision under the Patents Act, 1970 or the Rules framed thereunder enabling the Controller to revive/reinstate the petitioner's application, after the withdrawal of the petitioner's application, since the matter was already published and the notice of withdrawal was made public through the official communication.

**Held:** The High Court ruled that a careful reading of Section 78 unequivocally indicates that the Controller of Patent has got the power to correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or any clerical error in any matter which is registered in the register. Court also observed that the power given under Rule 137 of the Patent Rules, 2003 also makes the issue conspicuous that any document, for the amendment of which no special provision has been made in the Act may be amended by specifically stating that any irregularity in procedure which, in the opinion of the Controller, may be obviated without detriment to the interests of any person. The Court reasoned that *Nippon Steel Corporation v. Union of India*, (Delhi High Court 2011), relied on by Respondents was inapplicable due to two reasons, namely (1) an amendment sought to disregard the Japanese priority date and to change the application with an idea to extend the deadline for filing the Request for Examination (RFE) on the ground that a docketing error occurred in the office of the attorney of the petitioner therein, was rejected on the ground that the request was hit by limitation; and (2) once the amendment was allowed, it would relate back to the date of the application for the grant of patent and it was also found that the request for amending the priority date was with a view to indirectly get the time for RFE extended. In the subject case, the Court held that the only ground mentioned in the application for rectifying the clerical error was due to the bona fide and inadvertent mistake committed by the petitioner's erstwhile attorneys in interchanging the patent application numbers.

## 10. Exclusive licensee may file suit for infringement of patent, rules High Court

*Sergi Transformer Explosion Prevention Technologies Pvt Ltd vs Kumar Pratap Anil & Ors*  
16 April 2014, Delhi High Court

**Issue:** Infringement of patent relating to 'method and device for preventing/protecting electrical transformer against explosion and fire'

**Parties and Background:** Plaintiff has filed the present suit against Defendants seeking permanent injunction restraining infringement of registered Indian Patent No.189089 in respect of "Method and Device for Preventing/Protecting Electrical Transformer against Explosion and Fire". Plaintiff filed the suit as the exclusive licensee of the suit patent, while the original owner had been impleaded as a proforma Defendant in the suit. Defendants are engaged in the business of manufacture and marketing of engineering and electronic products including transformers.

**Contentions:** Defendant No. 2 filed an application for rejection of plaint contending that Plaintiff is not an exclusive licensee of the suit patent. Defendant alleged that another company, namely Sergi Holding together with the original owner of the suit patent, had instituted an infringement suit in Kolkata against them in February 2006 claiming to be the exclusive licensee of the suit patent. Defendants claimed that the present Plaintiff's exclusive licence dated August 2006, granting the licensee status to Plaintiff from January 2006, was a back-dated document and it was never brought to the knowledge of Patent Office prior to March 2010, i.e., filing of the present suit. Defendant's argued that the licence was an invalid document and was made fraudulently. Additionally, Defendant alleged that Plaintiff had failed to disclose as to how the products of Defendant No. 2 are infringing the Plaintiff's suit patent and therefore, the suit is liable to be rejected/dismissed for non-disclosure of cause of action.

Denying Defendants' contentions, Plaintiff submitted that steps to register the licence agreement at the Patent Office were taken prior to filing of the suit and non-registration of licence does not render it void since the original patent owner is a party to the suit as a proforma Defendant.

**Held:** High Court observed that under the Patents Act, the validity of the licence agreement as evidence is to be considered by the Court after the said document is recorded in the Patent office. Court further observed that there is no specific bar in filing the suit for infringement of patent by exclusive licensee against an infringer, if the licence is not registered in the patent office. According to High Court, an option has been given to the Court or Controller in appropriate cases to pass speaking orders by granting exemption to the Plaintiff who is exclusive licensee. In the present case, since the application for recordal of licence agreement was pending before the Patent Office, and the benefit of the licence agreement will only accrue when the said document was registered, High Court ruled that Defendant's objections to the licence agreement will have to be considered at the time when such application is being decided by Patent Office. High Court further ruled that the suit cannot be dismissed at this stage, and directed the Patent Office to issue its orders regarding recordal of the licence agreement within six months and adjourned the suit proceedings till such time.

### 11. Vringo successfully prevents ZTE from infringing its patent relating to mobile communication system

*Vringo Infrastructure Inc. & Anr. vs Indiamart Intermesh Ltd. & Ors*  
5 August 2014, Delhi High Court

**Issue:** Infringement of patent 'a method and a device for making a handover decision in a mobile communication system'

**Parties and Background:** Plaintiff No. 1 is engaged in innovation and development of telecommunication technologies and intellectual property, while Plaintiff No. 2 till recently, developed and distributed mobile application products and services through partnerships with handset manufacturers and mobile network operators.

Defendant No.3, ZTE Telecom India Pvt, Ltd., is the Indian subsidiary of ZTE Corp, Defendant No.4 and Defendant No.2, Mr. Xe Dejun is the CEO of Defendant No.3. Defendant Nos. 3 and 4 are involved in the manufacturing and selling of

telecommunications equipment and devices such as mobile handsets, dongles, tablets, infrastructure equipment and devices, etc. Plaintiffs alleged that Defendants have infringed their patent No.IN 200572 (hereinafter referred as IN '572) titled as 'a method and a device for making a handover decision in a mobile communication system'. The patent originally in the name of Nokia Corp., had been assigned to Plaintiffs in 2006. In the suit, an ad interim injunction order was granted in favour of Plaintiffs and the High Court was to decide on the confirmation of the said interim injunction order.

**Contentions:** Plaintiffs claimed that Defendants are infringing the suit patent by manufacturing, importing, selling, offering for sale infrastructure equipment including Base Station Controller examples of which are Base Station Controllers bearing Nos.ZTE ZXG10 IBSC and ZTE ZXG10-BSCV2. Plaintiffs submitted that Defendants infringement of their patent was evident and they had also filed an affidavit of Mr. Rejis J Bates, an expert who had categorically stated that Defendants had infringed Plaintiffs' patents.

Plaintiffs stated that they notified Defendants about the suit patent by way of a letter dated 25<sup>th</sup> September, 2012 and requested that Defendants seek appropriate licence for using the suit patent, however Defendants did not approach Plaintiffs for licence of the said patent and instead continued their infringing actions.

Defendants claimed that the technology used by them for the purpose of manufacturing, importing and selling the Base Station Controller is different than the one adopted by Plaintiffs. Defendants alleged that Plaintiff's had filed the suit after considerable delay since, Nokia Corp., had not complained about Defendants' products and Plaintiffs were aware of Defendants' technology since 2002. Defendants further stated that the affidavit of Mr. Bates cannot be taken into consideration, since Mr. Bates had admitted that he had no special knowledge about the patent or its violation and thus, the affidavit cannot be taken as conclusive evidence of infringement of the patent. In addition, Defendants had filed a counter-claim for revocation of the patent since it was not innovative in nature.

**Held:** The Single Judge after hearing the

submissions of both parties, held that Plaintiffs have not been able to establish a prima facie case, and the issue of infringement cannot be decided without a proper examination of the evidence. Judge observed that Plaintiffs had failed to provide any information in the plaint about commercial exploitation of the suit patent, and in such cases, balance of convenience is against grant of injunction. With regard to the affidavit filed by Mr. Bates (filed by the Plaintiff), the Single Judge held that he cannot be considered to be a Scientific advisor or expert since he did not have any special technical knowledge about the telecommunication or the technology in question nor did he have any degree in science, telecommunication or engineering dealing in telecommunication and electronics., Judge opined that it was pertinent to note that the original patentee, Nokia Corp., had not complained against Defendants and held that the balance of convenience was not favour of Plaintiffs and vacated the interim injunction order granted earlier. Finally, High Court issued certain directions such as (a) suit to be expedited and completed within 6 months; (b) local commissioners appointed for recording evidence; (c) Customs authorities to track and report import consignments of ZTE to Plaintiffs for inspection and inventorization; (d) Defendants to submit a bank guarantee of ₹ 5 crores (US\$ 806,450) and provide details of their sale of CDMA devices in India and revenues earned from them and submit record of accounts with an undertaking to pay any amounts as determined by Court, and (e) a panel of 3 scientists from well known educational institutes to be appointed to examine the technologies of the rival parties and submit their report to High Court for consideration.

Aggrieved by the decision of the single judge, Plaintiff filed an appeal and raised three specific issues for setting aside the Single Judge's observation namely that (a) Mr. Regis J. Bates is not a scientific advisor; (b) that Plaintiff's predecessors also ought to have complained about Defendant's actions, and (c) working of a patent has to be established in the plaint and averments in the rejoinder cannot be taken into consideration.

At the outset, Appellate Court stated that observations in ad-interim or interim orders in relation to the backdrop facts noted are never treated as conclusive and final. Then, it observed

that with regard to the first issue, a person could be an expert in an area of specialised knowledge by experience and he or she need not hold a degree in the field of specialised knowledge. A person can also become an expert by virtue of one's avocation or occupation. Appellate Court then opined that the Single Judge had rightly observed that in cases of injunction where a Plaintiff has permitted a situation to exist for a long period of time, its discontinuation is not warranted unless a prima facie case of a very strong nature is made out. With regard to the issue that details commercial exploitation of the suit patent not being mentioned in the plaint, Appellate Court observed that if a court grants an opportunity to a Plaintiff to file a replication, the same has to be treated as a pleading. However, if a fact is pleaded for the first time in a replication, Defendants if they so desire, have a right to file a sur-rejoinder. In view of the above observations, High Court dismissed the appeal.

## 12. High Court grants injunction in favour of Plaintiff in patent infringement case

*CTP Environment SAS vs Sentro Technologies Ltd & Ors*  
10 October 2014, Bombay High Court

**Issue:** Infringement of process patent relating to cleaning of furnaces without furnace closure

**Parties and Background:** Plaintiff is a French company. Defendant No. 1 is an Israeli company, with a place of business in Mumbai, and Defendant No. 2 is the majority shareholder of the Defendant No. 1. Plaintiff filed a patent infringement suit claiming infringement of its Indian process Patent No. 236532 relating to novel method of cleaning furnaces even while these continue to run and operate, i.e., a process of furnace cleaning without furnace closure, the patent was granted on 5th June 2009. Plaintiff claimed that Defendants were using a process that was identical or substantially similar to the process claimed by the Plaintiff in the patent.

In 2007, Defendant No. 2 approached Plaintiff and expressed an interest in developing a market in Israel with people interested in the Plaintiff's patent. Parties entered into a collaboration agreement dated 6<sup>th</sup> February 2008 with effect from 15<sup>th</sup> May 2007, which required Plaintiff to disclose

the particulars of the working of the suit patent to Defendant No. 2. The collaboration agreement came to an end on 15<sup>th</sup> May 2011. In June 2014, Plaintiff discovered that Defendant No. 2 through its company 1<sup>st</sup> Defendant were approaching existing and potential customers of the Plaintiffs and offering a service styled as “online chemical cleaning” of furnaces and boilers. Plaintiff also found that Defendants were also offering the infringing services through their website. Aggrieved, Plaintiff filed a suit for patent infringement before the Bombay High Court. Plaintiffs tried to send notice of the filing of the suit to Defendants, however Defendant company was not found at the addresses. Defendant did not appear before the Court and were proceeded ex-parte.

**Contentions:** Plaintiff submitted that the Defendant No. 1 was incorporated in 2011, by which time the process patent was already granted in favour of Plaintiff. In support of its claims of patent infringement, Plaintiff had submitted details from Defendants website and information obtained from brochures and videos. In addition, Plaintiff also filed an expert opinion of Dr. C.S. Mathpathi, an Assistant Professor in the Department of Chemical Engineering of Institute of Chemical Technology, Mumbai, who compared the information on the two rival processes and concluded that there is a high likelihood that the Defendants’ process is the same or substantially similar to the patent in question.

**Held:** Bombay High Court found that Plaintiff had successfully established an overwhelming prima facie case of infringement even at the interim stage. High Court observed that it cannot be a matter of coincidence that Defendants’ claims to the process all arise as soon as the collaboration agreement ended. Hence, High Court ruled that in view of the circumstances of this case, interim injunction must be issued as balance of convenience is in favour of Plaintiff.

### 13. High Court grants pro tem relief in patent dispute between Ericsson and Xiaomi

*Telefonaktiebolaget LM Ericsson v Xiaomi Technology & Ors*  
8 December 2014, Delhi High Court

**Issue:** Infringement of patents relating to AMR, 3G and EDGE technologies

**Parties and Background:** Plaintiff is the registered owner of eight patents (five AMR patents, two 3G patents and one EDGE patent) involving 3 technologies in the field of telecommunications pertaining to 2G and 3G devices. Plaintiff had initially invited Defendant to use its Standard Essential Patents (SEPs) qua GSM/GPRS/EDGE/WCDMA technology by obtaining a licence. However, instead of obtaining such licence, Defendant launched its infringing devices in India in July 2014. Aggrieved by Defendant’s actions, Plaintiff had filed the present suit for permanent injunction and restraining infringement of its rights in the registered patents by Defendant.

**Contentions:** In an ex-parte hearing, Plaintiff contended that Defendant had wilfully infringed Plaintiff’s patents and are selling the infringing products in India. Plaintiff also referred to two earlier cases, where Plaintiff’s said patents were upheld and protected.

**Held:** High Court held that in the facts and circumstances of this case, Plaintiff had successfully established a prima facie case for grant of injunction. Accordingly, High Court issued interim injunction orders restraining Defendant from infringing the suit patent and also appointed two local commissioners to inspect Defendant’s premises, and inspect and collect documents regarding import and sale of the infringing products. Court also directed Customs authorities to not allow import of the infringing products into India, and to intimate Plaintiff whenever a consignment is imported. High Court also directed Defendant to submit details of its sale of the infringing products and accounts.

Aggrieved by the interim injunction order, Defendant filed an appeal before the division bench of Delhi High Court (Xiaomi Technology and Anr. v Telefonaktiebolaget LM Ericsson). Defendant requested the division bench to issue a pro tem interim order (as distinct from an ad-interim order which has to be passed after hearing the parties on merits and keeping in view the principles relating to the grant of an interim injunction) in view of the sweeping interim injunction order issued by the single judge.

In the appeal, Defendant contended suppression of material facts by Plaintiff. Defendant submitted that the chip containing the technology of Plaintiff is being sourced by them from Qualcomm Incorporated. Defendants sent an email to Qualcomm enquiring whether they had any right to in turn permit Defendants to use the chip as a licensee of the Plaintiff. Qualcomm responded that it had a licence from Ericsson to use the patented technology and the 3G standards are CDMA standards or applications under the licence agreement and accordingly, any implementation of 3G technology by Defendant in their devices which implement a Qualcomm chipset, is a licensed implementation and does not infringe at least Plaintiff's 3G related patents.

Division Bench ruled that since the relief in the appeal was restricted to a pro tem order and since decision of single judge affected finances of Defendant and Plaintiff can be compensated if finally the infringement is upheld, it directed that as a pro tem measure, Defendants are permitted to import and sell the devices containing chipsets sold to it by Qualcomm.

#### 14. Novartis granted injunction by High Court in Vildagliptin patent dispute against Wockhardt

*Novartis AG and Anr v Wockhardt Ltd*  
5 March 2014, Delhi High Court

**Issue:** Infringement of pharmaceutical patent relating to Vildagliptin

**Parties and Background:** Plaintiff is the owner of patent no.212815 which relates to the drug containing the active pharmaceutical ingredient (API) vildagliptin and vildagliptin in combination with Metformin Hydrochloride. Plaintiff has been selling the pharmaceutical product under the brands VYSOV and VYSOV-M in India since 2008 and internationally since 2007.

In September 2013, Plaintiff received a notification from the Intellectual Property Appellate Board that Defendant had filed a revocation petition against its registered patent. Upon filing an application under the Right to Information Act, Plaintiff received information from the State Drug Controller

that Defendant has been granted permission to manufacture and sell the patented product in May 2013. Aggrieved, Plaintiff filed the present suit for patent infringement seeking to restrain Defendant from infringing its registered patent.

**Contentions:** Plaintiff argued that although Defendant is yet to launch the product in India or abroad, they are in the process of doing the same. Plaintiff submitted when Defendant commences manufacture and sale of the product, such action would be direct violation of S.48 of Patents Act, and Plaintiff will suffer irreparable loss and injury if Defendant is not restrained.

**Held:** High Court held that Plaintiff had successfully established a strong prima facie case and the balance of convenience is in its favour as it will suffer undue hardship if Defendant is not restrained. Accordingly, High Court directed that Defendant is restrained from manufacturing, importing, selling, offering for sale, export directly or indirectly dealing in pharmaceutical products, compound or formulation or combination containing Vildagliptin alone or Vildagliptin with Metformin Hydrochloride in combination or Vildagliptin in any other combination of in-violation of Indian Patent No.212815 of Plaintiff.

#### 15. Glenmark undertakes not to launch Saxagliptin in India

*Astrazeneca AB and Anr v Glenmark Generies Ltd and Anr*  
21 March 2014, Delhi High Court

**Issue:** Infringement of pharmaceutical patent involving saxagliptin

**Parties and Background:** Plaintiff had filed a suit against Defendants claiming infringement of its patent involving a pharmaceutical product with the active ingredient Saxagliptin and Saxagliptin monohydrate.

**Contentions:** On the date of hearing, Defendants submitted that although they are exporting Saxagliptin and Saxagliptin Monohydrate, the alleged infringing products to various countries, the said products have not been launched in India nor do Defendants intend to launch them in India



till the next date of hearing. In addition, Defendant requested for time to respond to Plaintiff's application for interlocutory relief.

**Held:** In view of the undertaking, High Court dismissed the application for interim injunction and directed that Defendants shall be bound by their statement till next date of hearing. High Court subsequently modified its order that Defendants' statement shall confine to the export of Saxagliptin Monohydrate only.

### 16. Novartis granted injunction against Bajaj Healthcare in vildagliptin patent dispute

*Novartis AG and Ors. v Alembic Pharmaceuticals Ltd.*  
16 April 2014, Delhi High Court

**Issue:** Infringement of pharmaceutical patent relating to Vildagliptin

**Parties and Background:** Plaintiff is the owner of patent no.212815 which relates to the drug containing the active pharmaceutical ingredient (API) vildagliptin and vildagliptin in combination with Metformin Hydrochloride. Plaintiff has been selling the pharmaceutical product under the brands GALVUS and GALVUS-MET in India since 2008 and internationally since 2007. The said patent was registered in 1999 and is valid till 2019.

In March 2014, Plaintiff filed an application under the Right to Information Act, and received information from the State Drug Controller that Defendant has been granted a permission to manufacture and sell the patented product. Aggrieved, Plaintiff filed the present suit for patent infringement seeking to restrain Defendant from infringing its registered patent.

**Contentions:** Plaintiff argued that although Defendant is yet to launch the product in India or abroad, they are in the process of doing the same. Plaintiff submitted when Defendant commences manufacture and sale of the product, such action would be direct violation of S.48 of Patents Act, and Plaintiff will suffer irreparable loss and injury if Defendant is not restrained.

**Held:** High Court held that Plaintiff had

successfully established a strong prima facie case and the balance of convenience is in its favour as it will suffer undue hardship if Defendant is not restrained. Accordingly, High Court directed that Defendant is restrained from manufacturing, importing, selling, offering for sale, export directly or indirectly dealing in pharmaceutical products, compound or formulation or combination containing Vildagliptin alone or Vildagliptin with Metformin Hydrochloride in combination or Vildagliptin in any other combination in contravention to the Indian Patent No.212815 of Plaintiff, except for the acts exempted under S.107(A) of the Act.

### 17. Novartis granted injunction against Glenmark in vildagliptin patent dispute

*Novartis AG v Glenmark Generics Ltd.*  
16 April 2014, Delhi High Court

**Issue:** Infringement of pharmaceutical patent relating to Vildagliptin

**Parties and Background:** Plaintiff is the owner of patent no.212815 which relates to the drug containing the active pharmaceutical ingredient (API) vildagliptin and vildagliptin in combination with Metformin Hydrochloride. Plaintiff found that Defendant has been granted a licence to manufacture and sell the infringing product and filed the present suit for patent infringement seeking to restrain Defendant from infringing its registered patent.

**Contentions:** On the date of hearing, Defendants submitted that the Defendant has got a licence for manufacture and marketing and has commenced manufacture and export of the drug Vildagliptin. However, Defendant has not launched the said drug in the Indian market. Defendant undertook that it shall not launch the said drug in the Indian market till the next date of hearing.

**Held:** High Court took into consideration Defendant's undertaking and directed it to place on record the documents evidencing the export of the drug Vildagliptin already made and to furnish all documents regarding its manufacture and sale of the said drug in the future. On a submission made by Defendant that such document may contain

confidential financial information, High Court ruled that such documents may be filed by Defendant in a sealed envelope and shall not be made accessible to Plaintiff except with leave of court. High Court further directed Defendant to maintain statement of account which is to be furnished to Plaintiff.

### 18. High Court rules in favour of Novartis in patent dispute with Cadila Healthcare

*Novartis AG v Cadila Healthcare Ltd.*  
16 April 2014, Delhi High Court

**Issue:** Infringement of pharmaceutical patent

**Parties and Background:** Plaintiff filed a suit for patent infringement against Defendant.

**Contentions:** On the date of hearing, Defendant requested for time to respond to Plaintiff's application for interlocutory relief. Defendant also submitted although it has obtained permission to manufacture the pharmaceutical product, till the next date of hearing, Defendant shall not manufacture for marketing purposes and shall not market in India or abroad any product, that infringes the patented product of the Plaintiff.

**Held:** High Court took into account Defendant's undertaking and directed that the suit proceeds further by setting dates for submission of pleadings by both parties.

### 19. High Court directs Patent Office to restore Teijin's lapsed patent

*Teijin Ltd v Union of India and Ors*  
10 February 2014, Bombay High Court

**Issue:** Procedural issues relating to filing of patent applications

**Parties and Background:** Petitioner a Japanese Corporation, filed a patent application in India (No. IN/PCT/1999/00014/MUM) on 17 December 1999 based on International Patent Application Number PCT/JP/99/02126 dated 21 April, 1999. Patent was registered on 24<sup>th</sup> July 2007 under number 207883

and the due date for payment of accumulated 3<sup>rd</sup> to 9<sup>th</sup> year annuities patent was 24<sup>th</sup> October 2007. On 22<sup>nd</sup> October 2007, Petitioner's patent attorneys forwarded payment of the 3<sup>rd</sup> to 9<sup>th</sup> year annuities at the Mumbai Patent Office and requested them to issue a renewal certificate. However, in the communication, petitioner's attorneys erroneously mentioned the patent number as 208225, which error was rectified by the attorneys on 23<sup>rd</sup> October 2007, i.e., prior to the deadline of 24<sup>th</sup> October 2007. Thereafter, the 10<sup>th</sup> year annuity and 11<sup>th</sup> year annuity in respect of the subject patent was paid on 4<sup>th</sup> March 2008 and 17<sup>th</sup> March 2009 respectively, which was accepted and acknowledged by the Patent Office. However, by mistake, in the correspondence for payment of 11<sup>th</sup> year annuity, petitioner's attorneys referred to it as the 10<sup>th</sup> year annuity. When the payment of 12<sup>th</sup> year annuity was made on 30<sup>th</sup> April 2010, Patent Office refused to accept the renewal fee stating that the patent had expired on 21<sup>st</sup> April 2009 owing to non-payment of 11<sup>th</sup> year annuity. Petitioner filed an application for restoration of the patent within the deadline of 21<sup>st</sup> October 2010. In response, Patent Office informed the petitioner that its request for taking on record renewal fee for 3<sup>rd</sup> to 9<sup>th</sup> year paid for the Patent No.208225, as payment being made for renewal of Patent No.207883 and also to take on record renewal fee for the 10<sup>th</sup> year for the said Patent could not be accepted and that Patent No.207883 had expired.

Aggrieved by the Controller's decision, Petitioner filed the present writ petition before the Bombay High Court.

**Contentions:** Petitioner argued that the Patent Office was wrong in holding that the subject patent had expired. It claimed that despite its request for correction of the error in the patent number in filing the 3<sup>rd</sup> to 9<sup>th</sup> year annuities, Patent Office did not do so and neither did they inform the petitioner about the same. In addition, petitioner claimed that Patent Office having accepted the 10<sup>th</sup> year annuity, cannot now claim that the patent had expired. Petitioner claimed that Controller had adequate discretionary powers to correct such errors and act judiciously.

On the other hand, it was submitted on behalf of the Controller of Patents that the Patent Office never received Petitioner's request for correction of the patent number. It was claimed that Petitioner had

an alternative remedy of filing an appeal against the impugned decision. In addition, it was argued that under the Act, an exclusive right has been granted to the patentee. In case of failure of patentee to comply with the prescribed time limits, penalties in the nature of 'abandonment', 'withdrawal', 'lapse' etc. are imposed by the statute and in such a case right gets accrued to the public.

**Held:** Bombay High Court observed that it could not be conclusively established whether or not Petitioner's request for correction of the patent number was received by the Patent Office. High Court ruled that taking into consideration the peculiar facts and circumstances of the case, this is a fit case where direction should be given to the Controller to restore the Patent. High Court also directed the Petitioner to give an indemnity to the Controller of Patents and state that the Petitioner shall not file any suit or make any claim during the period from which the said Patent was treated 'as ceased' till the order passed by this Court and after a period of three months thereafter.

## 20. High Court asks Controller to re-evaluate Gilead's patent

*Gilead Pharmasset LLC v Controller of Patents*  
30 January 2015, Delhi High Court

**Issue:** Procedural issues relating to pre-grant oppositions against patent applications

**Parties and Background:** The present writ petition assails the order issued by the Controller of Patents refusing the patent application of Petitioner. Petitioner filed a patent application under no.6087/DELNP/2005 titled as "A (2'R)-2'-DEOXY-2'FLUORO-2'-C-METHYL NUCLEOSIDE" at the Delhi Patent office, on 27/12/2005. Two pre-grant oppositions were filed on behalf of Natco Pharma Ltd., and Delhi Network of Positive People (DNP+), New Delhi, Initiative for Medicines, Access & Knowledge (IMAK), Inc, USA.

**Contentions:** Petitioner claimed that in issuing the refusal order, the Controller had taken into account the objections raised by the Opponents. This was evident from the fact that, not only the grounds taken in opposition and documents cited

were considered, while passing the impugned order, but even, the typographical errors contained in the notices of opposition got incorporated in the said order. Petitioner argued that the fact that the documents and materials relied upon by Opponents were available to the Controller, created a bias against Petitioner and led to refusal of the application. Petitioner submitted that Controller before issuing his order ought to have heard the Petitioner qua the objections raised by the Opponents, and having failed to do so, the impugned order completely breaches the principles of natural justice.

Respondent on the other hand, challenged the maintainability of the writ petition. It was argued that although there were pre-grant oppositions filed against the subject patent application, Controller did not consider the opposition while issuing the impugned decision. The impugned order was issued on the basis of Section 14 and 15 of the Act and not under Section 25. The procedure under these provisions are completely different from the procedure to be followed in a pre-grant opposition proceeding. Therefore, there was no necessity of hearing the petitioner regarding the objections raised by the Opponents.

**Held:** High Court examined the impugned order and concluded that there was every possibility of the Controller being influenced by the materials placed by the Opponents. High Court was of the opinion that the Controller ought to have appointed a hearing under both Section 14 and Section 25 and heard the rival parties. Accordingly, High Court remanded the matter to the Controller for fresh hearing.

## 21. Symed successfully obtains injunction against Glenmark in Linezolid case

*Symed Labs Ltd. vs Glenmark Pharmaceuticals Ltd. and Anr.*  
19 January 2015, Delhi High Court

**Issue:** Infringement of pharmaceutical patent involving Linezolid.

**Parties and Background:** Plaintiff is the proprietor of two patents IN213062 and IN213063 involving novel processes to manufacture

and develop the pharmaceutical component Linezolid. Defendant No. 1 is an Indian company, dealing in the manufacture and supply of both active pharmaceutical ingredients (APIs) and finished dosage forms of various pharmaceutical formulations while Defendant No. 2 is its subsidiary. Plaintiff had filed the present suit to restrain Defendants manufacturing, selling, offering for sale, advertising or directly or indirectly dealing in the product Linezolid manufactured in any manner that amounts to infringement of its specified patents.

**Contentions:** In December 2012, Plaintiff came to know that Defendants were manufacturing Linezolid under the brand name LIZOLID. Plaintiff purchased samples of Defendants products, and upon analysis thereof, found them to contain several key intermediates in the Linezolid manufacturing process that were covered by the suit patents. Thus, Plaintiff contended that Defendants are infringing its patents.

On the other hand, Defendants denied having used Plaintiff's process in manufacturing Linezolid. Defendants argued that the key intermediates claimed in the suit patent are not novel and alleged that the patents obtained by Plaintiff are liable to be revoked. Towards this end, Defendants also filed a counter-claim. Defendants also challenged the jurisdiction of the court, stating that they were not manufacturing the offending products within the territory of Delhi but were only distributing them, there.

**Held:** High Court observed that the simplest way to determine whether a process patent has been infringed is to compare the rival processes. Although Defendants have denied using Plaintiff's process, High Court noted that they have disclosed the process used by them. Thus, the presence of the key intermediates in Defendants' product is a very strong indicator of infringement. In addition, High Court noted that Plaintiff's patent was granted in 2007 and has been subsisting since then. On the basis of the above considerations, High Court held that Plaintiff had established a prima facie case and issued an order of injunction restraining Defendants from manufacturing Linezolid in any manner that constitutes infringement of the suit patents.

## 22. Cipla restrained from infringing Novartis' patent involving Indacaterol by High Court

*Novartis AG and Anr. v Cipla Ltd.  
9 January 2015, Delhi High Court*

**Issue:** Infringement of pharmaceutical patent involving Indacaterol

**Parties and Background:** Plaintiff No. 1 in the present matter is Novartis AG, a Switzerland based pharmaceutical company, while Plaintiff No. 2 Novartis Healthcare Pvt. Ltd., is Plaintiff No. 1's Indian subsidiary. Plaintiff No. 1 is the proprietor of patent No. IN 222346 which covers a new chemical entity and compound **Indacaterol** (International Non-Proprietary Name) as well as its maleate salt, namely **Indacaterol Maleate**. Lupin Ltd., is marketing the **Indacaterol** products in India under a distribution and co-promotion agreement with Plaintiff No. 2. Plaintiffs claim that Defendant is infringing its stated patent and filed the present suit seeking an injunction to restrain Defendant from doing so.

**Contentions:** Defendant submitted that the requirement of the public with respect to the patented invention have not been satisfied. Defendant submitted that it has filed a representation for compulsory licensing under Section 66 of the Act. Defendant alleged that Plaintiff imports small quantities of the patented product and is guilty of unjust enrichment through monopolization of the said product through multiple patents. Defendant argued that on this ground, the suit patent ought to be revoked. In addition, Defendant argued that public interest is an important consideration in the grant of an injunction and injunctions ought to be refused where patents have not been worked in India.

Plaintiff in its rejoinder asserted that the fact that Defendant has requested for compulsory licensing of the suit patent, indicates that the suit patent is valid. According to Plaintiff, this amounts to admission by Defendant that there is infringement and it is sufficient for the purpose of disposal of the injunction application. In addition, Plaintiff submitted that there no obligation in law that the Plaintiff must manufacture the patented drug in India. Plaintiff submitted that the patent is already being worked and the patented drug is made

available to fulfil the requirement of the public and that alone is sufficient.

**Held:** High Court conducted a detailed analysis of the rival contentions and judicial precedents. As per the High Court, the main issue was whether an injunction ought to be refused for infringement of a patent, which is found to be otherwise valid, only in view of a likelihood that public interest may suffer. High Court was of the opinion that issue of public interest can be effectively remedied by the authorities in charge of deciding Defendant's application for compulsory licence. High Court noted that alternative solutions such as payment

of royalties till the conclusion of trial, does not help the patentee and it suffers even though it has been granted exclusive rights under the Act. High Court held that a court cannot encourage infringement of a patent, which is otherwise found to be valid and where the infringement has been established and there is no credible defence to such infringement. Accordingly, High Court granted an interim injunction, restraining Defendants from dealing in any pharmaceutical product **Indacaterol** or **Indacaterol Maleate**, either alone or in combination with any other compound or API or in any other form which may amount to infringement of Indian Patent No.222346 of Plaintiff No. 1.



# SELECTED INDIAN INTELLECTUAL PROPERTY CASES

Contributed by D.P. Ahuja & Co., Research Division  
Copyright & Designs Cases 2014 - 2015

## High Court and Supreme Court Decisions: 2014-2015

### 1. Microsoft takes action against counterfeiters

*Microsoft Corporation & Anr vs Prithviraj & Anr.  
2 May 2014, Delhi High Court*

**Issue:** Copyright infringement of software

**Parties and Background:** Plaintiff No. 1 is a US based company while Plaintiff No. 2 is its Indian subsidiary. Plaintiff No. 1 is engaged in the development, manufacture, licensing, and support of a range of software products for various computing devices. Plaintiff No. 2 provides marketing, promotion, anti-piracy awareness campaigns and channel development support to Plaintiff No. 1 and its affiliates.

In July 2010, Plaintiffs received information that Defendants were engaged in infringing Plaintiffs' copyrights, trademarks and other intellectual property rights by carrying on the business of unauthorized Hard Disk Loading of the Plaintiffs' software on the branded computer systems sold by Defendant to his customers.

Aggrieved by Defendants actions, Plaintiffs filed the present suit against them for copyright infringement and passing off. In the initial stage, Plaintiffs' application for appointment of Local Commissioners for search and seizure of the infringing products was granted by the Court. The report submitted by the Local Commissioner was also placed before the Court for consideration. Despite being notified of the suit, Defendants did not appear before the High Court and the matter proceeded ex-parte.

**Contentions:** Plaintiffs contended that computer programs are an outcome of concentrated human skill, labor and ingenuity as any other copyrighted work, and since they are vital components of advanced information processing technology, it is imperative that illegal trade activities of traders like Defendants be strictly restrained and the dangerous growth of computer software piracy be

stemmed.

**Held:** High Court heard the arguments placed by Plaintiffs and also examined the documents placed before the Court as evidence. The report submitted by the Local Commissioner showed that the laptops offered by Defendants did not carry any certificate of authorization or license. High Court also noted that Plaintiffs had successfully established its ownership of the copyrights in the computer programs in issue and Defendants through its actions had violated such copyright. Accordingly, Delhi High Court ruled that Plaintiffs were entitled to a decree of permanent injunction against Defendants. High Court also awarded damages of a sum of ₹ 16 lacs (US\$ 25806) payable by Defendants to Plaintiffs.

### 2. High Court restrains Indian entity from infringing Tekla's software

*Tekla Corporation & Anr vs Survo Ghosh & Anr  
16 May 2014, Delhi High Court*

**Issue:** Copyright infringement of software

**Parties and Background:** Tekla Corporation, Finland and its Indian subsidiary Tekla India Pvt. Ltd., had filed a suit against Defendants: Defendant No. 2 - Caliber Tech Solutions Pvt. Ltd. And Defendant No. 1 - Mr. Survo Ghosh. Plaintiffs had claimed their copyright in the software program Tekla Structures had been infringed by Defendants, as they had installed the program in an unauthorized manner, instead of obtaining license from Plaintiffs.

In the suit, an ex-parte interim injunction was granted and Defendants were restrained from using unlicensed/pirated versions of Plaintiffs' software. In addition, High Court also appointed a Local Commissioner to visit the premises of Defendants in order to verify any infringement of the stated software in the past by Defendants.

**Contentions:** In response, Defendants submitted that they were not contesting the suit in so far as Plaintiffs' relief for permanent injunction are concerned.

However, in response to Plaintiffs' claims for damages, Defendants raised the defense of 'copyright misuse'. Defendants argued that the terms of use of Tekla Software of Plaintiffs and their conduct during the course of the license term amounts to misuse of their monopoly provided by their copyright. According to Defendants, Plaintiffs were charging an unreasonable fee (in addition to license fee) and forcing their licensees to accept unreasonable conditions. By doing so, Defendants claimed that Plaintiffs had overreached their rights in the copyright and which amounted to copyright misuse.

Plaintiffs argued to the contrary that the plea of copyright misuse is not available under the Indian statute and there has not been any misuse of the copyright by Plaintiffs in the present case. Plaintiffs also argued that any party dissatisfied with the quantum of fees charged by Plaintiffs in respect of their software, is free to approach the Registrar of Copyrights for compulsory license. Finally, Plaintiffs argued that the end-user agreement of Plaintiffs' software does not mandate that the user has to compulsorily avail of the training or maintenance services, and such services are optional.

**Held:** High Court ruled that under the Indian legal framework, the defense of "misuse of copyright" by the holder is not available, either in an action for infringement of copyright or in an action for damages for infringement of copyright. In view of Defendants no contest to claims of infringement of copyright, High Court issued a decree of permanent injunction against the Defendants.

### 3. High Court holds Videocon guilty of infringing Whirlpool's design for washing machines

*Whirlpool Of India Ltd vs Videocon Industries Ltd*  
27 May 2014, Bombay High Court

**Issue:** Infringement of design of washing machines.

**Parties and Background:** Plaintiff is the Indian

subsidiary of US based company, Whirlpool Corporation. One of the world's leading manufacturers of home appliances globally including manufacture and sale of washing machines. Plaintiff is the proprietor of two design registrations which are valid and subsisting.

In June 2012, Plaintiff came across a washing machine being manufactured by Defendant, which had virtually the same and/or similar design and features of shape and configuration as Plaintiff's product and the said designs registered by Plaintiff. Aggrieved, Plaintiff filed the present suit for design infringement and passing off.

In the suit, an interim injunction was granted by the Single Judge. Defendant challenged the interim injunction order before the Division Bench, which was rejected. Prior to the suit, Defendant had filed an application for registration of the design, which was granted after the Division Bench issued its decision in the appeal. Therefore, Defendant filed a Special Leave Petition (SLP) before the Supreme Court stating that a suit for infringement of design could not lie since Defendant had obtained registration of the design and also that an action for passing off could not lie in respect of a registered design. Plaintiff claimed that such questions had not arisen before the Bombay High Court since Defendant had obtained registration subsequently. The Supreme Court deferred hearing of the SLP holding that it would be appropriate to let the Bombay High Court decide on these issues first.

**Contentions:** Before the Bombay High Court, the following issues required adjudication: (a) whether a suit for infringement of design can lie against a registered proprietor (b) whether Plaintiff had established a prima facie case for infringement. (c) whether Defendant was guilty of passing off of Plaintiff's design.

On the first issue, Plaintiff submitted that on examination of the provisions of the Act, it would be clear that an action for infringement of design can lie against a registered proprietor of design. On the other hand, Defendant submitted that the suit filed by the Plaintiff against the Defendant alleging infringement of the Plaintiff's registered design is not maintainable since the Defendant too is the registered proprietor of its design.

On the second issue, Plaintiff claimed Defendant's product is a complete copy of its product as Defendant's washing machine had replicated the exact and novel combination of the distinctive circular wash area, the compact right aligned control panel and the unique rectangular drying area from outside.

In addition, Defendant also copied the distinctive color scheme and/or two tone combination that was employed by Plaintiff. Consequently, the rival products were visually indistinguishable, on an initial look. Defendant on the other hand asserted that the registered design of its washing machine is substantially different from the registered design of the Plaintiff's washing machine. Defendant also claimed that there is lack of novelty in the Plaintiff's design and the design is a combination of known designs.

**Held:** Bombay High Court examined the provisions of the Designs Act, 2000 and held that a plain reading of Section 22 of the Act and sub-sections (1) to (3) thereunder indicates that a suit for infringement of a registered design lies against any person, including a registered proprietor.

High Court observed that a comparative analysis of the features of the rival products, it is conclusively established that Defendant has slavishly/brazenly copied/imitated Plaintiff's design which clearly satisfied the tests for infringement.

With regard to Defendant's claim of lack of novelty in Plaintiff's design, High Court observed that on comparison of the documents placed on record by Defendant in support of its claims with Plaintiff's design, there were absolutely no similarities. High Court held that a Defendant who claims that its design is novel cannot allege that the prior identical design lacks in novelty. High Court ruled that Defendant was guilty of infringement of Plaintiff's design and ought to be restrained.

On the issue of passing off, Defendant argued that there is no possibility of misrepresentation, deception and/or confusion and/or passing off, since nobody buys a washing machine by reference to its shape or appearance. However, High Court ruled that to an ordinary potential customer who has an imperfect or hazy recollection, and who associates or identifies the Plaintiff's washing machine with

reference to its distinctive and novel design, there is every likelihood that he or she will attend such demonstration in the belief that the product being shown or demonstrated is the Plaintiff's product and purchase the same under this misconception.

Bombay High Court held that Defendant was guilty of both infringement and passing off of Plaintiff's design and allowed Plaintiff's application for interim injunction.

#### 4. Copyright in industrial drawings are lost once application for registration of design has been filed, holds High Court

*Holland Company Lp & Anr vs S.P. Industries  
20 May 2014, Delhi High Court*

**Issue:** Copyright vs Design rights in industrial drawings

**Parties and Background:** Plaintiff No. 1 is a US based company and a pioneer in the railways supply industry for car/wagon components. Plaintiff No. 1 has the copyright over industrial drawings of its product and mechanical parts thereof namely Automatic Twist Locks system for securing a cargo container to a support such as a deck of a vehicle or a second container with which the first container is to be stacked. Plaintiff No. 2 Sanrok Enterprises, is the exclusive licensee of Plaintiff No. 1 in India for manufacturing, selling, marketing and servicing Plaintiff No. 1's Automatic Twist Lock and its spare parts.

In December, 2012, Plaintiff No. 1 learned that Eastern Railway, Sealdah Division had granted a contract to the Defendant for carrying out the repair / replacement of spare parts and service which includes overhauling and replacement of defective parts of Automatic Twist Lock devices supplied by Plaintiffs to the Eastern Railways.

Plaintiffs filed the present suit for infringement of its intellectual property as Defendant accepted the contract from Eastern Railways claiming to be the manufacturer and supplier of Plaintiffs' original spare parts when it is not possible to manufacture without using the Industrial Drawings of Plaintiffs.

**Contentions:** Plaintiffs claimed that the industrial



drawings were a public document published by Indian Railways under permission from Plaintiffs and Defendant had copied the industrial drawings and manufactured the spare parts of Automatic Twist Lock devices through reverse engineering. Plaintiffs further claimed that Defendant's products were bound to be of inferior quality since they do not have the requisite technology to manufacture the products.

Defendant on the other hand claimed that the drawings are not artistic work under Copyright Act but amounts to designs under the Designs Act. Defendant submitted that since Plaintiffs had claimed to have manufactured similar products, no copyright in such drawings exist after its reproduction more than 50 times by an industrial process as provided under the Copyright Act.

**Held:** High Court observed that if Plaintiffs' arguments were to be accepted, then not only Defendant had to be restrained but Indian Railways also had to be restrained from awarding the contract to any party other than Plaintiffs for manufacture and repair of the said products. However, High Court observed no such embargo was placed on Indian Railways when Plaintiffs first supplied the products. Moreover, despite arguing that the industrial drawings were covered by copyright, Plaintiffs had also submitted that they had applied for registration of the design. In such case, High Court ruled that once an application for design had been made, no rights under Copyright Act can survive. Hence, High Court ruled that Plaintiffs had neither established prima facie case nor was the balance of convenience in their favour and therefore Plaintiffs' application for interim injunction was refused.

## 5. No copyright can exist in pranic healing techniques rules High Court

*Institute For Inner Studies & Ors. vs Charlotte Anderson & Ors.*  
10 January 2014, Delhi High Court

**Issue:** Infringement of copyright in pranic healing techniques and literary works

**Parties and Background:** Plaintiffs are a group of companies headquartered in Philippines and

established by Master Choa Kok Sui (hereinafter referred to as Master) to spread Pranic Healing, Arhatic Yoga, Inner Teachings and Practices globally. Plaintiffs claimed the intellectual property rights in the Pranic Healing Techniques/ Modern Pranic Healing Techniques.

Plaintiffs claimed that Defendants were conducting courses, issuing certificates and selling material (books, audio, video) without due authority from the Plaintiffs, in violation of licensing agreements which had been terminated or which had expired over time respectively. Plaintiffs filed the present suit to restrain Defendants from carrying out activities of spreading Pranic Healing teachings, techniques or conducting seminars, workshops, training programs etc. without authorization from Plaintiffs. In the suit, an ex-parte interim injunction was granted in favour of Plaintiffs and Defendants were restrained from conducting any seminars, workshops or courses in which involved Master's teachings.

**Contentions:** Plaintiffs alleged that Defendants are conducting trainings without authorization from Plaintiffs, authorizing Pranic healing and Arhatic Yoga instructors who are not qualified and do not follow the guidelines established by Master, publishing reading materials in the form of books, CDs etc., which are identical to the reading materials published by Plaintiffs etc. Through their activities, Plaintiffs alleged that innocent consumers were being confused and deceived into assuming that there was some relationship between Defendants and Plaintiffs.

Defendants argued that the concept of Pranic Healing and techniques thereunder are all pre-existing in the public and Plaintiffs cannot claim any intellectual property over the same. Further, Defendants claimed that the Pranic Healing techniques and concepts are neither covered under 'artistic works' under Copyright Act, nor can they be granted trademark protection under the Trade Marks Act.

**Held:** High Court observed that prima facie, the issue of copyright claims over the techniques of pranic healing appear to be untenable. However, with regard to the books, CDs and other printed materials over which Plaintiffs had claimed copyright, it was noted by High Court apart from

Defendant No. 1 who claimed joint authorship of some of the works, rest of the Defendants had agreed not to use such materials. High Court while accepting Defendant No. 1's claim of joint authorship of 9 titles, issued directions restraining Defendants from using any copyrighted materials of the Master.

With regard to the trademark claims over 'Pranic Healing', High Court ruled that such mark is both descriptive and non distinctive and Plaintiffs' pleas for injunction on the basis of proprietorship of trademarks cannot be accepted. Thus, High Court allowed Defendants to practice the Asanas of Pranic Healing or Modern Pranic Healing techniques or impart training, practice, sessions, teachings, conduct workshops, in their respective institutes without using the literature of Plaintiffs.

## 6. An idea or concept cannot be copyrighted holds High Court

*Reckitt Benckiser (India) Ltd. & Anr vs Dabur India Ltd.*

31 October 2014, Delhi High Court

**Issue:** Infringement of advertising concept/idea

**Parties and Background:** Plaintiffs are members of the Reckitt Benckiser Group PLC and are engaged in the business of various consumer and healthcare products including antiseptic liquid, toilet care products, surface care products, pharmaceuticals, insecticides and food products. Plaintiffs are the owner and manufacturer of the non-prescription drug for heartburn and gastro-oesophageal reflux disease under the brand GAVISCON. Plaintiffs had conceptualized the concept of fire fighting and commenced use of the FIREMAN Device in relation to promotion and advertisement of their GAVISCON products. The storyboard of Plaintiffs' conceptualized script is that the fire-fighters, which are replicas of the FIREMAN DEVICE, who are treating the heartburn and other gastro-oesophageal reflux diseases by sprinkling GAVISCON on the oesophagus and the stomach walls. Plaintiffs are copyright owners of the FIREMAN Device and is also the registered proprietor of the FIREMAN Device mark.

Defendant is involved in manufacture and sale of

ayurvedic and non-prescription medicines. In May 2014, Plaintiffs found that Defendant had launched a new product known as Pudin Hara Fizz and had used an identical advertisement as the one used in relation to Plaintiffs' GAVISCON product. Aggrieved Plaintiffs had filed the present suit for copyright and trademark infringement and passing off.

**Contentions:** Plaintiffs alleged that Defendant had slavishly imitated the entire concept of their advertisement, including the FIREMAN elements and substituted them with the deceptively similar title FIRE BRIGADE. Plaintiffs submitted that due to long usage of the FIREMAN script in relation to their GAVISCON products, consumers relate the fire-fighting action with antacid and anti-reflux effect of GAVISCON and Defendant was illegally riding on Plaintiffs' goodwill and reputation associated with the advertisement.

In response, Defendant submitted that its product Pudin Hara Fizz was launched in 2010, much prior to Plaintiff's GAVISCON products. Also, Defendant claimed that firstly, there were no similarities in the two television commercials and thus there is no violation of the copyright of Plaintiffs in any manner. Secondly, Plaintiffs cannot claim any exclusivity or copyright on the idea of a fireman.

**Held:** High Court observed that prima facie, the devices used by Defendant in its advertisement do not appear to be similar to the FIREMAN device used by Plaintiffs. Moreover, Plaintiffs' use of FIREMAN device is mostly outside India and there was not sufficient evidence to establish spillover reputation of Plaintiffs' advertisement in India and there existed a possibility that Defendant had come up with its concept independently. High Court also stated that a concept or theme in an advertisement cannot be monopolized under the guise of copyright. High Court held that there was no copyright infringement and refused to grant the injunction as prayed for by Plaintiffs.

## 7. Candy Crush owner successfully prevents Indian Hotel from infringing its copyright

*King Com Ltd v Apeejay Surrendra Park Hotels Limited*  
12 June 2014, Bombay High Court

**Issue:** Infringement of copyright in artistic work

**Parties and Background:** Plaintiff is a Malta-based company engaged in creation and offering digital games on various digital platforms. One of its most popular products, widely available on various digital platforms is the game known as "CANDY CRUSH SAGA". Plaintiff is the proprietor of the trade mark Candy Crush Saga/Candy Crush whose pictorial representation comprises a square with a red and white striped candy type border, and within that border is a blue background panel on which three types of candies are represented.

Defendant is a company engaged in the hospitality business. Plaintiff found that Defendant had issued advertisements of a musical event on the Internet and in the advertising materials, Defendant had not only used Plaintiff's trademark CANDY CRUSH but also reproduced Plaintiff's copyrighted representation of candies. Aggrieved, Plaintiff had filed the present suit for trademark and copyright infringement.

**Contentions:** Plaintiff submitted that it had no objection to the musical event itself, but sought to prevent Defendant from using CANDY CRUSH or any other copyrighted materials. The matter was proceeded ex-parte as there was no representation on behalf of Defendant.

**Held:** Bombay High Court observed that prima facie, Defendant's use of the copyrighted material is completely unauthorized and illegal. High Court held that Plaintiff had made out a strong case for grant of injunction and accordingly issued directions restraining Defendant from infringing any of Plaintiff's copyrighted materials in any manner pending final adjudication of the dispute.

## 8. SAP obtains injunction against Indian entity in copyright dispute

*SAP AG v Microbase Technologies*  
27 August 2014, Delhi High Court

**Issue:** Infringement of copyright in software

**Parties and Background:** Plaintiff is a German company and the owner of a software relating to packaged ERP (Enterprise Resource Planning) solutions that enables organizations in the documentation, planning and deployment of resources available to them in the most efficient manner, for achieving maximum productivity. Plaintiff No. 2 is Plaintiff No. 1's Indian subsidiary, and is responsible for the sales of SAP solutions, implementation, post-implementation support, training and certification of its customers and partners in India. Plaintiff No. 1 is the sole copyright owner of the software developed and marketed under the SAP brand.

Defendant is an entity engaged in the business of providing ERP/eCRM services to its clients and also provides training programs in SAP ERP software. In October 2008, Plaintiffs came to know that Defendant had been making offers for providing training in Plaintiffs' software, although Plaintiff had not entered into any agreement with Defendant for providing training services for SAP programs. Plaintiffs found that Defendant had been offering training services in SAP programs in an unauthorized manner. Plaintiffs filed a criminal complaint, and search of Defendant's premises revealed that Defendant was using pirated/infringing versions of Plaintiffs' software. Aggrieved, Plaintiffs filed the present suit for copyright infringement against Defendant. In the suit, despite being notified, Defendant did not appear and therefore the matter proceeded ex-parte.

**Contentions:** Plaintiffs submitted that only specific Education Partners who had entered into agreements with them were authorized to conduct training for Plaintiffs' SAP programs. Defendant's actions of offering unauthorized training services coupled with use of pirated versions of SAP software amounted to copyright infringement.

**Held:** On the basis of the evidence on record and submissions made by Plaintiffs which remained unchallenged, Delhi High Court issued an ex-

parte injunction restraining Defendant from directly or indirectly reproducing/using/installing any infringing/unlicensed/pirated copies of Plaintiffs' software.

### 9. Indian entity restrained by High Court from using pirated versions of Microsoft's software

*Microsoft Corporation and Anr. vs. Rajeev Trehan & Anr.*  
3 July 2014, Delhi High Court

**Issue:** Infringement of copyright in software

**Parties and Background:** Plaintiff No. 1 is a US based company, while Plaintiff No. 2 is its Indian subsidiary. Plaintiff No. 1 is engaged in the development, manufacture, licensing, and support of a range of software products for various computing devices. Plaintiff No. 1 being the owner of the software such as MICROSOFT WINDOWS Series, MICROSOFT OFFICE Series, MICROSOFT VISUAL STUDIO etc., it also owns the copyright in the various software.

In November 2007, Plaintiffs received information that Defendants were engaged in infringing Plaintiffs' copyrights by carrying on the business of unauthorized Hard Disk Loading of the Plaintiffs' software on the branded computer systems sold by the Defendants to their customers.

Aggrieved by Defendants' actions, Plaintiffs filed the present suit for copyright infringement and passing off. Despite appearing before the Delhi High Court initially, Defendants subsequently failed to appear, and hence were proceeded ex-parte.

**Contentions:** Plaintiffs claimed that they had acquired a personal computer from Defendants and upon analysis, it was found that the software used in the computer were unlicensed/pirated versions of Plaintiffs' software. Plaintiffs contended that computer programs were an outcome of concentrated human skill, labor and ingenuity, and since they are vital components of advanced information processing technology, it is imperative that the illegal trade activities of traders like Defendants be strictly restrained and the dangerous growth of computer software piracy be stemmed. Plaintiffs also claimed that had suffered substantial monetary loss on account of illegal distribution of

their software by Defendants.

**Held:** High Court held that on the basis of the evidence placed on record and Plaintiffs' arguments, it was abundantly clear that Defendants had in fact infringed Plaintiffs' copyrights in the said software. High Court accordingly issued a decree restraining Defendants copying, selling, loading hard disks, or offering to public the pirated/unlicensed versions of Plaintiffs' software, in any manner. On the issue of damages, Court held that since Defendants had willfully stayed away from the proceedings, they were directed to pay a sum of ₹ 5 lacs (US\$ 8065) as damages to Plaintiffs.

### 10. V2 Corp granted partial relief in design dispute by High Court

*V2 Corp vs. Innovative Techpack Limited*  
22 September 2014, Delhi High Court

**Issue:** Infringement of registered designs in Jars

**Parties and Background:** Plaintiff No. 1 is the owner of design rights in respect of a registered design of a "JAR". Plaintiff No. 2 is engaged in the business of designing, manufacturing, marketing and selling plastic products including bottles, caps, jars and containers etc. The designs are owned by Plaintiff No. 1 which are licensed to Plaintiff No. 2 who has expanded the business internationally and exports the products manufactured as per the said designs, to other countries. The novelty in both the designs of the "JAR" reside in the shape, configuration and surface ornamentation of the "JAR" which adds a distinct visual appeal to the products which are different from other jars available in the market.

In May 2014, Plaintiffs found that Defendant had slavishly imitated the designs owned by Plaintiff No. 1. Plaintiffs sent a legal notice to Defendant, but Defendant refused to comply to Plaintiffs' requests. Aggrieved, Plaintiffs filed the present suit for design infringement. In the initial stage of the suit, an interim ex-parte injunction was granted in favour of Plaintiffs. Upon receipt of the ex-parte injunction order, Defendant appeared before High Court and filed an application for vacation of the said ex-parte order.

**Contentions:** Plaintiffs alleged that Defendant

had blatantly copied both the designs of Plaintiffs in entirety including the shape, configuration and surface ornamentation in which the novelty is claimed and by doing so, Defendant was guilty of causing design infringement of the “JAR” of Plaintiffs.

In response, Defendant submitted that both Plaintiff No. 2 and Defendant supply the ‘Jars’ to a common customer being Perfetti Van Melle, and the said ‘Jars’ are manufactured according to specifications of Perfetti. Defendant further claimed that ‘Jars’ of identical shape and configuration were available in the market for many years and Defendant itself had been manufacturing the Jars comprising the impugned design for a long time. Defendant alleged that Plaintiffs were attempting to stifle competition as it will not be able to supply the Jars to Perfetti. Defendant further submitted that the Jar designs were created by a Japanese entity, from whom Defendant acquired such design. Defendant alleged that Plaintiff No. 1’s design registration was liable to be canceled as it is neither new nor original.

**Held:** Upon comparative analysis of the Jars manufactured by rival parties and evidence on record, High Court ruled that certain parts of the designs registered by Plaintiff No. 1 was already available in public domain and therefore no novelty or originality could be attributed to such portions. Accordingly, High Court allowed Defendant to use certain features of Plaintiff No. 1’s registration which was not novel, but restrained them from using parts of the design in which novelty was present.

### **11. Whirlpool fails to restrain Godrej and Samsung from manufacturing refrigerators with bottom drawers**

*Whirlpool of India Ltd. vs. Samsung India Electronics Pvt. Ltd.*  
13 February 2014, Karnataka High Court

**Issue:** Infringement of registered design of refrigerators with bottom drawers

**Parties and Background:** Plaintiff is an Indian company and a subsidiary of Whirlpool Corporation of USA. One of the products designed and developed by Plaintiff is the ‘refrigerator with

bottom drawer’ and the design is a new concept which has completely changed the look of the product. Plaintiff had obtained registrations for the designs in relation to the bottom drawer, fascia of the bottom drawer, and fascia of the refrigerator.

Plaintiff had filed two suits – one against Godrej & Boyce Manufacturing Company Limited and other against Samsung India Electronics Pvt. Ltd.

**Contentions:** Plaintiff claimed that Godrej had started production of refrigerator with bottom drawer fabricating/copying the design registered by Plaintiff which is fraudulent. Plaintiff also alleged that owing to Godrej’s deceptive design, sale of Plaintiff’s product had diminished which caused financial loss. Godrej on the other hand denied all claims of design infringement and submitted that Plaintiff is guilty of suppression of material facts. Godrej submitted that it is the proprietor of a registered design for manufacture of refrigerator with bottom drawer and as such entitled to manufacture such refrigerators with bottom drawers. Godrej further claimed that Plaintiff’s design ought to be canceled as refrigerators with bottom drawers were available in the international market much prior to Plaintiff’s design registration.

With regard to the suit against Samsung, Plaintiff contended that Samsung was manufacturing and selling a similar product refrigerator with bottom drawer which design was identical to the design registered by Plaintiff. Samsung denied Plaintiff’s claims of design infringement and sought to dispel such allegations through a comparative table providing the differences in the rival designs. In addition, Samsung also claimed that Plaintiff was not the first entity to design a refrigerator with a single door and bottom drawer and placed several documents in support of such contention.

**Held:** High Court observed that based on the evidence on record, Plaintiff could not claim to be the pioneer of the design of a refrigerator with a bottom drawer. Further, High Court noted that a visual examination of the rival designs of Plaintiff and both Defendants did not show any similarities although the underlying concept of a bottom drawer was same in all cases. Since the designs utilized by Defendants were not similar, High Court ruled that Plaintiff could not establish infringement and therefore was not entitled to an injunction. ■

# Anatip

## AN OVERVIEW OF TRADEMARK REGISTRATIONS IN ASIA

- By Anatip Pte. Ltd., Singapore

COUNTRY	MULTI-CLASS APPLICATION	PRIORITY CLAIM	CLASSIFICATION	POWER OF AUTHORITY
AFGHANISTAN	POSSIBLE	POSSIBLE	International Classes 1 to 45	Legalised
BANGLADESH	<b>NOT POSSIBLE</b>	POSSIBLE	International Classes 1 to 45	Simple Signature
BHUTAN	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature
BRUNEI	POSSIBLE	POSSIBLE	International Classes 1 to 42	Not required
CAMBODIA	<b>NOT POSSIBLE</b>	POSSIBLE	International Classes 1 to 45	Notarised
CHINA	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature
HONG KONG	POSSIBLE	POSSIBLE	International Classes 1 to 45	Not Required
INDIA	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature
INDONESIA	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature
JAPAN	POSSIBLE	POSSIBLE	International Classes 1 to 45	Not required
LAOS	<b>NOT POSSIBLE</b>	POSSIBLE	International Classes 1 to 45	Notarised
MACAU	<b>NOT POSSIBLE</b>	POSSIBLE	International Classes 1 to 45	Notarised
MALAYSIA	<b>NOT POSSIBLE</b>	POSSIBLE	International Classes 1 to 45	Not required
MAURITIUS	POSSIBLE	POSSIBLE	International Classes 1 to 45	Legalised
MYANMAR	POSSIBLE	<b>NOT POSSIBLE</b>	International Classes 1 to 45	Legalised
PAKISTAN	<b>NOT POSSIBLE</b>	POSSIBLE	International Classes 1 to 45	Notarised
PHILIPPINES	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature
SINGAPORE	POSSIBLE	POSSIBLE	International Classes 1 to 45	Not required
SOUTH KOREA	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature
SRI LANKA	<b>NOT POSSIBLE</b>	POSSIBLE	International Classes 1 to 45	Simple Signature
TAIWAN	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature
THAILAND	<b>NOT POSSIBLE</b>	POSSIBLE	International Classes 1 to 45	Notarised
VIETNAM	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature

# INTELLECTUAL PROPERTY SERVICES IN ASIA

AFGHANISTAN

BANGLADESH

BHUTAN

BRUNEI

CAMBODIA

CHINA

HONGKONG

INDIA

INDONESIA

JAPAN

LAOS

MACAU

MALAYSIA

MAURITIUS

MYANMAR

NEPAL

PAKISTAN

PHILIPPINES

SOUTH KOREA

SRILANKA

TAIWAN

THAILAND

VIETNAM



# Anatip

## Trademark & Design Filings in Asia

Level 10,  
55 Market Street,  
Singapore 048941

Tel: + 65 65213194  
+ 65 65213196  
Fax: + 65 65213154

Email: [patents@anatip.com](mailto:patents@anatip.com)  
[trademarks@anatip.com](mailto:trademarks@anatip.com)  
Website: [www.anatip.com](http://www.anatip.com)



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***dp ahuja &co.***

14/2, Palm Avenue, Calcutta 700019, INDIA

Telephone: +91 33 40177100 • Facsimile: +91 33 40082269

patents@dpahuja.com • trademarks@dpahuja.com • litigation@dpahuja.com