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INTELLECTUAL PROPERTY CASES  
2015 - 2016

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# SELECTED INDIAN INTELLECTUAL PROPERTY CASES

Contributed by D.P.Ahuja & Co., Research Division

## Case Summaries of Trademark Decisions : 2015 - 2016 The Courts

### 1. Pepsico granted injunction in AQUAFINA trademark infringement suit

PEPSICO INC & ANR vs  
VOMARA DISTRIBUTORS & ORS  
7<sup>th</sup> January, 2015, Delhi High Court  
AQUAFINA v AQUAFIZZA

**FACTS:** Suit was filed by Pepsico against Vomara Distributors alleging infringement of its registered trade mark AQUAFINA, through use of a virtually identical trademark/trade dress/label/logo AQUAFIZZA in relation to an identical product, i.e. packaged drinking water.

**CONTENTIONS:** Defendants did not appear before the High Court and the matter proceeded ex-parte. Plaintiff contended that adoption of the near identical mark/logo was obviously dishonest and intended to deliberately confuse and establish a trade connection where none exists. Plaintiff contended that Defendant aimed to trade on the goodwill and reputation of its well known mark AQUAFINA. Plaintiff further contended that the manner in which Defendant had depicted the word AQUAFIZZA, i.e. by elongating the first and last 'A' in the mark AQUAFIZZA alongwith the representation of wedges placed above the word AQUAFIZZA was identical to the label AQUAFINA of Plaintiff. The word AQUAFIZZA was also written in an identical script, font and style.

**HELD:** The Court observed that on the basis of the averments made in the complaint and the un-rebutted evidence, Plaintiff had established that it was the registered proprietor of the trademark AQUAFINA and had the exclusive right to use the same. Defendant's mark AQUAFIZZA was structurally, visually and phonetically identical to Plaintiff's registered AQUAFINA mark, which was a clear violation of the rights of Plaintiff. Accordingly, a decree of permanent injunction

was issued in favour of Plaintiff and against Defendant.

### 2. Merck successfully prevents infringement of its NASIVION and NASIVIN trademarks

MERCK KGAA & ANR. VS. SHRIPAL  
MANGALCHAND JAIN & ANR.  
9<sup>th</sup> January, 2015, Delhi High Court  
NASIVION/ NASIVIN vs NOSYVIN

**FACTS:** Suit has been filed by Merck KGAA against Shripal Mangalchand and others alleging infringement of its registered trade marks NASIVION and NASIVIN, which had been violated through use of a virtually identical trademark NOSYVIN, the goods being pharmaceuticals.

**HELD:** The suit was heard ex-parte by the Court. Considering that Merck was the registered proprietor of the trademark NASIVION and NASIVIN, the Court was of the opinion that Defendant intended to usurp and take unfair advantage of the reputation associated with Plaintiff's registered marks. Therefore, the Court granted ex-parte interim injunction restraining Defendant from using the impugned mark NOSYVIN or any other mark deceptively similar to Plaintiff's NASIVION/NASIVIN marks.

### 3. Trademark Infringement suit filed by Sony dismissed on a super-technical ground

SONY KABUSHIKI KAISHA VS. SONY TRADE  
LINKS (INDIA) PVT. LTD. & ANR.  
14<sup>th</sup> January, 2015, Calcutta High Court  
SONY v SONY

**FACTS:** Plaintiff Sony Kabushiki Kaisha is a manufacturer of electronic goods and the registered proprietor of the trademark SONY. Plaintiff came to know that Defendant was

carrying on business under the name and style SONY TRADE LINKS (INDIA) PVT. LTD., and filed the present suit seeking injunction restraining Defendant from using the trademark 'SONY' or any other trademark deceptively similar thereto.

**CONTENTIONS:** Plaintiff claimed that Defendant's adoption and use constituted infringement of its registered mark SONY for which it has been granted exclusive rights. Defendant claimed that it does not manufacture any electronic goods and the trademark/trade name 'Sony' has been used by Defendant as a part of its family name. In addition, Defendant challenged the validity of the complaint filed by Plaintiff on the ground that the documents (Powers of Attorney) on which Plaintiff relied for verification of the complaint were not properly notarized as per the relevant Indian regulations.

**HELD:** The Judge was of the opinion that the notarial certificates issued in Japan were not valid in terms of the Notaries Act in India. Since there was no evidence that the Plaintiff had authorized the deponents in the complaint to file the suit on its behalf, the Judge was of the opinion that the suit was not properly instituted and Plaintiff had not successfully established its claims as the evidence filed was also not properly submitted. Accordingly, the suit was dismissed.

#### **4. Court upholds the WWE brand and awards punitive damages against Indian entity**

**WORLD WRESTLING ENTERTAINMENT, INC. v SAVIO FERNANDES & ORS**  
*19<sup>th</sup> January, 2015, Delhi High Court, Single Bench*  
**WWE v WWE**

**FACTS:** Plaintiff is an international integrated media and entertainment company principally engaged in the development, production and marketing of television programming, pay-per-view programming and live events, and the licensing and sale of branded consumer products featuring its highly successful WWE brand. Plaintiff provides live and televised wrestling and entertainment events to the public. Plaintiff also has a widespread digital presence and owns several domain names bearing the trademark WWE.

Plaintiff came across Defendant's websites [www.wrestlezoneindia.com](http://www.wrestlezoneindia.com) and [www.wrestlezone.co.in](http://www.wrestlezone.co.in), through which they were engaged in selling counterfeit apparel and merchandise bearing the registered trademark WWE and other copyrightable content of Plaintiff and claimed to be the 'WWE Merchandize Store'.

**CONTENTIONS:** Upon filing of the suit, Plaintiff was granted an ex-parte injunction in its favour, restraining Defendant from dealing in the WWE brand and other connected materials. In addition, the Court also granted Plaintiff's request for appointment of a Special Officer (Local Commissioner) to visit Defendant's premises and cause search and seize of any or all available counterfeit products. The findings of the Local Commissioner showed that 267 goods were counterfeit and infringing the trademark of Plaintiff. Defendant did not appear before the Court despite repeated summons and hence, the matter was proceeded ex-parte.

**HELD:** The Court held that the evidence filed by Plaintiff which was unchallenged clearly established Plaintiff's case of flagrant trademark and copyright infringement by Defendant with the dishonest intention of gaining illegal profits. Accordingly, the Court was of the opinion that Plaintiff was entitled to a decree of permanent injunction. Additionally, the Court also awarded punitive damages to the tune of Rs. 5 lakhs \*(US\$ 7350 approx.) and Rs.1 lakh \*(US\$ 1470 approx.) towards cost of suit, both payable by Defendant to Plaintiff.

#### **5. Lancome Parfums successfully prevents infringement of its brand name**

**LANCOME PARFUMS ET BEAUTE AND CIE v MR. NAVIN AND ANOTHER**  
*27<sup>th</sup> January, 2015, Delhi High Court*  
**LANCOME v LANCOME**

**FACTS:** Plaintiff is engaged in the business of manufacture, distribution and trade of a wide range of cosmetics, perfumery, skin care and toilet preparations all under the brand LANCOME. Defendant, Bharti International Cosmetics, also engaged in the business of trading of cosmetics, personal care and beauty products and other allied/related goods, had dishonestly adopted and used the Plaintiff's brand LANCOME. Plaintiff



filed the present suit against Defendant seeking permanent injunction restraining it from dealing in the trademark LANCOME or any other identical or similar mark in relation to business of cosmetics, personal care, beauty products and allied/related products.

**CONTENTIONS:** Plaintiff averred that Defendant's adoption and use of the trademark LANCOME was dishonest and constituted infringement of its registered and well-known mark. Defendant claimed that it had been granted a valid license to manufacture cosmetics by the licensing authority Drugs Control Department, which had been renewed on a regular basis. Additionally, Defendant claimed that it had been using the trademark LANCOME for a long time.

**HELD:** The Court observed that the Plaintiff had clearly established its proprietary rights over the registered mark LANCOME and that Defendant's trademark was identical to that of Plaintiff's trademark. With regard to Defendant's claim of having a valid licence, the Court ruled that the licence only permitted Defendant to manufacture the drug and does not in any manner entitle Defendant to infringe Plaintiff's registered mark. Accordingly, Delhi High issued a decree of permanent injunction in favour of Plaintiff and restrained Defendant from dealing in the trademark LANCOME in any manner.

## 6. BURGER KING granted preliminary injunction against misuse in identical logo

**BURGER KING CORPORATION vs. BURGER PLACE**

*3<sup>rd</sup> February, 2015, Delhi High Court, Single Bench*

**BURGER KING Crest and Logo v BURGER PLACE**

**FACTS:** The present suit had been filed by Plaintiff seeking permanent injunction restraining infringement of its trademark BURGER KING Crest and Logo by Defendant. Plaintiff is a US based company, and claims to be the second largest fast-food hamburger company. Plaintiff is the registered proprietor of the BURGER KING and Crescent Logo and had entered India through a joint venture.

In 2014, Plaintiff came across Defendant's

restaurant in the name and style of BURGER PLACE and was alarmed to notice that Defendant had adopted an identical Crescent design enclosing the mark BURGER PLACE.

**CONTENTIONS:** Plaintiff claimed that the Crescent Logo was identical and the colour combination was also the same. Since this was an ex-parte preliminary injunction proceeding, the Defendant was not present before the Court.

**HELD:** The Court held that Plaintiff had been able to establish a prima facie case and the balance of convenience was also in its favour. The Court was of the opinion that Plaintiff will suffer irreparable loss and injury if the ex-parte preliminary injunction was not granted. Hence, the Court issued a decree of ex-parte preliminary injunction whereby Defendant was restrained from dealing in the impugned Crescent Logo or any variety thereof.

## 7. BASF successful in preventing unauthorised use of its MAGNAFLOC trademark

**BASF SE VS. PREM COLOUR CHEM PVT. LTD.**

*4<sup>th</sup> February, 2015, Delhi High Court, Single Bench*

**MAGNAFLOC v MAGNAFLOC**

**FACTS:** Plaintiff is a world renowned manufacturer and service provider of chemicals for pharmaceutical and cosmetics industry and other varied industries. Plaintiff is the registered proprietor of the trademarks BASF derived from 'Baden Aniline and Soda Factory', the distinctive Quadrant Logo and the trademark MAGNAFLOC which is being used in respect of a range of synthetic flocculants and coagulants designed for a wide variety of mineral processing applications.

Plaintiff had entered into a contract with Defendant which was valid for two years ending in March 2012 and was renewed thereafter. However, in February 2012, Plaintiff received complaints regarding the low quality of its products bearing the MAGNAFLOC mark. On enquiry, it transpired that Defendant was selling low quality counterfeit products under the mark MAGNAFLOC and was misrepresenting itself as the authorized dealer of Plaintiff in respect of the said product, which was contrary to the

contract governing the parties. On Defendant's explicit assurance that such activity would not be repeated in future, the contract between the parties continued to be in place. But again in July 2014, Plaintiff found that Defendant was once again selling counterfeit products bearing its trademark MAGNAFLOC.

**CONTENTIONS:** Plaintiff contended that Defendant's intentions were obviously dishonest since the product labels on Defendant's counterfeit products mentioned that the products were manufactured in Singapore, whereas Plaintiff has never manufactured its MAGNAFLOC marked products there. Moreover, on comparison of the rival marks, Plaintiff argued that Defendant's trademark was similar in every way to Plaintiff's registered trademark.

**HELD:** The present hearing was in respect of Plaintiff's application for ex-parte preliminary injunction, hence, Defendant was not present before the Court. Based on the averments and the evidence on record, the Court was of the opinion that Plaintiff had prima facie established the case for trademark infringement. Accordingly, it issued an order for preliminary injunction restraining Defendant from directly or indirectly using Plaintiff's MAGNAFLOC, BASF and Quadrant marks/logos in any manner without obtaining prior permission from Plaintiff.

## 8. Indian Party restrained from using the trademark COMFORT INN

**CHOICE HOTELS INTERNATIONAL INC VS M SANJAY KUMAR AND ANR**

*9<sup>th</sup> February, 2015, Delhi High Court*

**COMFORT INN v HOTEL RAJ COMFORT INN**

**FACTS:** Plaintiff, Choice Hotels International Inc, originally set up as a non-profit organization is involved in the business of franchising, promoting and licensing high quality hospitality services in various countries. In India, Plaintiff has a joint venture company Choice Hospitality (India) Pvt. Ltd., as a master franchisee. Plaintiff is the registered proprietor of the trademarks COMFORT, COMFORT INN and variants thereof and has 11 hotels in India. Plaintiff found that Defendant was operating a hotel under the name HOTEL RAJ COMFORT INN.

Accordingly, the present suit has been filed by Plaintiff to protect and enforce its trademark rights in the marks COMFORT INN and variants.

**CONTENTIONS:** Plaintiff alleged that Defendant's adoption was dishonest with intent to encash upon the goodwill and reputation associated with its COMFORT INN trademarks. Plaintiff further submitted Defendant's adoption and use of the impugned mark amounted to infringement and passing off of its registered trademarks. Defendant claimed to have honestly adopted the trademark and submitted that Plaintiff did not have any trademark registration of its mark COMFORT INN in Class 42 and had relied upon its registrations for COMFORT INN in Class 16 and for COMFORT in Class 42 and hence, Plaintiff's trademark infringement suit was not maintainable. Additionally, Defendant claimed that it was not conducting its business within the territorial jurisdiction of the Delhi High Court and that there was inordinate delay in filing the suit.

**HELD:** The Court held that Plaintiff had successfully made out a case of trademark infringement and passing off. The Court observed that even though Plaintiff's mark consisted of ordinary words, it was distinctive in view of its long and continuous use in India. Regarding the issue of territorial jurisdiction, High Court observed that at the preliminary stage it needed to be concerned with only the averments in the complaint and final deduction can only be made after complete analysis of the evidence on record. Accordingly, the Court ruled it had territorial jurisdiction to try the case. Having prima facie established its case, Plaintiff was granted its request for preliminary injunction and Defendant was restrained from using the mark COMFORT INN. However, keeping in mind that Defendant had been using the mark for a considerable time, the Court granted Defendant six months of time to change its name.

## 9. Court upholds the SINGER trademark against the mark SINGAR

**THE SINGER COMPANY LIMITED & ANR. VS. SANJEEV GUPTA & ORS.**

*12<sup>th</sup> February, 2015, Delhi High Court*

**SINGER v SINGAR**

**FACTS:** Plaintiff is a company based in



Luxembourg and also has an Indian subsidiary. Plaintiff is the proprietor of the trademark SINGER which it uses in relation to sewing machines and a range of household appliances, including vacuum cleaners, juicer mixer, grinders, heaters, fans, irons, microwaves, television, etc. In January 2014, Plaintiff noticed a trademark registration for the mark SINGAR in relation to products in Class 11 for all kinds of electric fans, exhaust fans, cooler pump, fresh air fan, all-purpose fan, with user claim since the year 1993. Plaintiff's search for Defendant's products in the market yielded no results and accordingly, Plaintiff filed a petition before the Trade Marks Office for cancellation of the said registration. Defendant had filed a counter statement to such cancellation petition, however a copy of the same was not received by Plaintiff. Meanwhile, Plaintiff found that Defendant's products such as ceiling fans, mixers and juicers etc., bearing the SINGAR trademark were available in the market. Accordingly, Plaintiff filed the present suit for permanent injunction to restrain Defendant from infringement of its registered trademark and passing off.

**CONTENTIONS:** The Court heard the matter ex-parte as this was a hearing in relation to Plaintiff's application for ex-parte preliminary injunction and Defendant was not present before the Court. Plaintiff submitted that the impugned mark was near-identical to its registered mark and had been adopted with the sole intention of causing confusion and deception in the market and deriving illegal profits.

**HELD:** Based on the averments made in the complaint and the documents on record, the Court was of the opinion that Plaintiff was entitled to an ex-parte preliminary injunction in its favour. Accordingly, the Court restrained Defendant from using the deceptively similar mark SINGAR, but granted time of 4 weeks to delete the trademark from its products since it had been using the said mark for some time. The Court also granted Plaintiff's request for appointment of a special officer (Local Commissioner) to visit Defendant's premises and cause search and seize any and all infringing products bearing the impugned mark and thereafter, submit his report to the Court.

## 10. Court holds sale of branded products over Internet to be valid use of the Trade Mark and clarifies basis of trans-border reputation in a passing off matter

**LAVERANA GMBH & CO. KG. VS. MAC PERSONAL CARE PVT. LTD. & ORS.**  
*19<sup>th</sup> February, 2015, Delhi High Court*  
**LAVERA v LAVERA/MAC'S LAVERA**

**FACTS:** Plaintiff is carrying on business of manufacturing and marketing cosmetics and body care products and uses the trade name/trademark LAVERA in the course of its business. Plaintiff is the proprietor of the trademark LAVERA in many countries worldwide, and its application for registration of the trademark is pending in India. Plaintiff's products bearing the mark LAVERA are extremely popular and freely available in several online stores and the reputation associated with the LAVERA mark had spilled over into India as well.

In September 2010, Plaintiff came to know that Defendant had filed a trademark application for LAVERA and filed an opposition to the application when it was published in the Trade Marks Journal. Thereafter, Defendant filed another application for MAC'S LAVERA which was also opposed by Plaintiff. When Plaintiff also became aware that Defendant's were selling cosmetic products under the trademark MAC'S LAVERA, Plaintiff filed the present suit for trademark passing off. In the suit, the Delhi High Court granted Plaintiff an ex-parte preliminary injunction. Defendant filed its response to the complaint as well as an application to set aside the ex-parte order granting preliminary injunction.

**CONTENTIONS:** Plaintiff alleged that Defendant had dishonestly adopted an identical mark in relation to identical products for obvious purposes, i.e., to trade upon the goodwill associated with its well-known LAVERA mark. Plaintiff claimed that Defendant had no reason to adopt the said mark and had only added the initial MAC before its famous mark LAVERA. In response, Defendant claimed that Plaintiff was not the proprietor of the mark LAVERA either in common law or by virtue of the statutory provisions. Defendant averred that Plaintiff had

no goodwill or reputation and had failed to establish any of the elements of passing off. Defendant also claimed to be entitled to use the mark MAC'S LAVERA on account of honest adoption and concurrent user.

**HELD:** On the basis of the evidence available on record and the arguments placed by both parties, the Delhi High Court held that Plaintiff had been able to establish a strong case of goodwill and reputation and trans-border use of its mark LAVERA. The Court was of the opinion that the rival marks were indeed deceptively similar. The Court also observed that heavy burden lies on the applicant to establish honest adoption, when the applicant at the time of filing the trademark application was aware that another entity was already using the trademark for which it was seeking registration. The Court also noted that sale of a product bearing a trademark on the internet amounts to valid use of a trademark and thus Defendant's allegation of non-use of Plaintiff's mark was without substance. Accordingly, the Delhi High Court directed that the ex-parte preliminary injunction granted earlier to be made absolute and restrained Defendant from using the LAVERA mark for products in Class 3. Consequently, Defendant's application for setting aside the ex-parte preliminary injunction was dismissed.

Aggrieved by the decision, Defendant/Appellant filed an appeal before the appellate division of the Delhi High Court. The Division bench noted that there was an apparent contradiction in the order issued by the Single Judge. Division bench found that in one paragraph, after examination of the documents placed on record, Single Judge had stated that Plaintiff/Respondent had not placed sufficient material to establish reputation and goodwill in other countries. Thereafter, in another paragraph, after discussing all the relevant caselaws regarding transborder reputation, the Single Judge had abruptly held that Plaintiff had prima facie made out a strong case of goodwill and reputation, as well as transborder use of the trademark at issue. However, Division bench opined that the finding of the Single Judge that Plaintiff had not established transborder reputation was incorrect. According to the Appellate court, with the growth of Internet and modern methods of

communication it was easy to establish whether reputation has spilled over into India. But on the issue of having established reputation in the international market, High Court stated that certain pointers such as registrations in multiple jurisdictions, publications in international magazines, volume of sales etc., could be utilized by courts to decide whether the prima facie condition had been met. Division bench found that in the present case, Plaintiff had successfully established having an international reputation which had then spilled over to India and it would be entitled to an injunction against Appellant/Defendant since Appellant/Defendant was a dishonest adopter of the trademark. The appeal was consequently dismissed by the Division Bench of the Delhi High Court.

## 11. Court grants "John Doe" injunctions in favour of Samsung Electronics

**SAMSUNG ELECTRONICS COMPANY LTD. & ANR. VS. AKHILESH TIWARI & ORS.**

*20<sup>th</sup> February, 2015, Delhi High Court*

**SAMSUNG GALAXY v SAMSUNG GALAXY**

**FACTS:** Plaintiff is a South Korean company and along with its Indian subsidiary, belongs to the Samsung Group of companies who are engaged in the business of manufacture and sale of a range of telecommunication devices such as mobile phones, tablets, hand-held devices, smart phones, GSM and CDMA Mobile phones, TVs, DVD players, home theatre systems, digital cameras, personal computers and laptops and white goods like ovens, refrigerators, microwaves, air conditioners, washing machines etc. Plaintiff is the registered proprietor of the trademark SAMSUNG GALAXY and its variants worldwide, including in India.

**CONTENTIONS:** Plaintiff discovered that Defendant were manufacturing counterfeit mobile phones batteries and affixing stickers of any brand, including the Plaintiff's brand name as desired by the purchaser/wholesale traders. Defendants No.3 to 50 are stated to be wholesale traders/retailers/importers based in Delhi, selling various counterfeit mobile phones and mobile accessories. Defendants No.51 to 90 were wholesaler traders/retailers/importers in Mumbai selling counterfeit mobile phones and mobile

phone accessories and Defendants No.98 to 110 are unnamed and unidentified wholesale traders/retailers in Delhi and Mumbai, stated to be engaging in the illegal activity of manufacturing and/or selling and marketing of counterfeit SAMSUNG GALAXY marked mobile phones and mobile accessories. Plaintiff also alleged that Defendants had cloned the International Mobile Station Equipment Identity or IMEI number - a unique number assigned to identify a valid device, used by government security agencies and government authorities to verify the legitimacy of the mobile device. Plaintiff claimed that Defendants have also copied the proprietary software belonging to Plaintiff and by selling the counterfeit products were causing irreparable damage to its statutory and common law rights. Since this was an ex-parte preliminary hearing, none of the Defendants were present before the Court.

**HELD:** The Court ruled that based on the averments and the evidence on record, Plaintiff was entitled to an ex-parte preliminary injunction. Accordingly, the Court granted a 'John Doe' order against Defendants restraining them from infringing Plaintiff's registered trademarks till the next date of hearing. In addition, the Court also appointed a number of special officers (Local Commissioners) for each zone (dividing the territories of Delhi and Mumbai into various zones) and directed them to visit the addresses of the various Defendants and cause search and seize the infringing goods and thereafter, submit their reports before the Court for further proceeding.

## 12. Johnson & Johnson succeeds in injuncting Lupin from using its LUCYNTA mark

**JOHNSON & JOHNSON v LUPIN LIMITED AND ANR and LUPIN LIMITED v JOHNSON & JOHNSON LTD & ANR**

*27<sup>th</sup> February, and 13<sup>th</sup> July, 2015, Delhi High Court*  
**NUCYNTA v LUCYNTA**

**FACTS:** Plaintiff, a US based pharmaceutical company along with its Indian subsidiary had filed the present suit for trademark passing off. In 2008, Plaintiff had adopted the trademark NUCYNTA in relation to its Tapentadol based drug, an opioid pain reliever. Plaintiff's trademark

application for registration of NUCYNTA was pending registration.

In March 2012, Plaintiff came to know of Defendant's drug for the treatment of oncology related ailment containing Tapentadol being sold under the mark LUCYNTA. Plaintiff found that Defendant had also filed a trademark application for LUCYNTA which had recently been granted registration.

**CONTENTIONS:** Plaintiff claimed that Defendant's trademark was an inherently dishonest adoption and is causing/likely to cause damage to Plaintiff's rights in the trademark NUCYNTA. Plaintiff's trademark NUCYNTA was well-known worldwide, which reputation had also spilled over to India. Plaintiff sought to restrain Defendant from using the trademark LUCYNTA. Defendant on the other hand, claimed that the suit was not maintainable since it was the registered proprietor for the trademark LUCYNTA. Defendant further submitted that it had been granted the necessary drug license and had introduced its product under the trademark LUCYNTA in October 2011. Defendant also stated that at the time of filing its trademark application, Plaintiff had knowledge of Defendant's mark, and despite such knowledge, Plaintiff did not oppose Defendant's trademark application and was thus estopped from filing the suit.

**HELD:** The Court noted that on the basis of the facts and evidence on record, it was evident that Plaintiff was first in terms of adoption. According to the Single Judge, Defendant had no explanation for adoption of a near identical mark. The Court noted that Plaintiff had initiated a cancellation action against Defendant's registered mark. The Court held that Plaintiff had successfully established a prima facie case in its favour and was entitled to a decree of interim injunction. Accordingly, during the pendency of the suit, Defendant was restrained from using the trademark LUCYNTA in respect of pharmaceutical preparations.

Aggrieved by the decision of the Single Judge, Defendant filed an appeal before the division bench of the Court. The appellate court noted that while Plaintiff is yet to launch its product in



India, Defendant had already commenced use of its trademark in India. Based on such observation, the Court ruled that the operation of the order issued by the Single Judge ought to be stayed till final hearing of the matter. Meanwhile, the Court division bench directed that Defendant/Appellant maintain full account of manufacture and sale of its products bearing the LUCYNTA mark and shall not endeavour to sell its products bearing the impugned mark outside India.

### 13. Court holds it is Possible to seek Injunction in a Trademark Infringement Suit Against a Sick Company

**FERRERO SPA & ORS VS VM SIDDIQ & ANR**  
*24<sup>th</sup> March, 2015, Delhi High Court, Single Bench*  
**TIC TAC v TIT BITS**

**FACTS:** Plaintiff, part of the Ferrero Group, had first adopted and used trademark TIC TAC for fresh breath mints and introduced the same in India in 1999. Defendant on the other hand, claimed to be in the business of manufacture and sale of mouth fresheners since 1984 under trademark TIT BITS. Plaintiff filed a suit for trade dress infringement against Defendant.

**CONTENTIONS:** Plaintiff submitted that Defendant had adopted a deceptively similar shape, design and overall get up and layout, and thereby, attempted to ride upon the vast goodwill and reputation of the Plaintiff's TIC TAC product. Defendant submitted that it was a sick company and was undergoing a scheme of rehabilitation. Defendant argued that Plaintiff's application for interim injunction qualified as an action of 'distress' and if implemented would adversely impact the rehabilitation scheme and amount to execution against Defendant, for which Plaintiff needs to seek prior permission from Board for Industrial and Financial Reconstruction (BIFR). Accordingly, Defendant requested for a stay of the infringement proceeding till such time Plaintiff obtain the permission from BIFR. Plaintiff rebutted Defendant's claims and stated that Defendant was attempting to mislead the Court since the suit sought to prohibit Defendant from use of the deceptively similar shape and design of the product and not the trademark per se. Plaintiff also stated that the rehabilitation scheme did not dictate or extend to the design, shape, overall get up and layout of the TIT BITS

mouth fresheners to be sold by Defendant.

**HELD:** The Court ruled that a temporary injunction as prayed by Plaintiff would not affect the business interests, or the implementation of the rehabilitation scheme of the defendants in any manner. The injunction sought by Plaintiff would only prevent its property rights from being infringed by Defendant. High Court observed that despite the injunction, Defendant would still be free to promote its mouth fresheners in a manner, which does not harm the goodwill, reputation and legal rights of Plaintiff. The Court, therefore, rejected Defendant's application for stay of proceedings.

### 14. ESONORM held to be similar to ECONORM

**BICODEX & ANR. VS. PHARMA SYNTH FORMULATIONS LTD. & ANR.**  
*25<sup>th</sup> March, 2015, Delhi High Court, Single Bench*  
**ECONORM v ESONORM**

**FACTS:** Plaintiff is an independent family owned French pharmaceutical company and markets its products in India under the trademark ECONORM. Plaintiff's mark ECONORM is used in relation to yeast 'Saccharomyces boulardii', which is a probiotic drug used to maintain intestinal flora and had been in use in India since 1998.

In November 2014, Plaintiff found that Defendant was manufacturing / marketing / selling 'Saccharomyces boulardii' (Lyophilized) sachets under the mark ESONORM. Aggrieved by this, Plaintiff filed the present suit for trademark infringement.

**CONTENTIONS:** This being a hearing for Plaintiff's application for preliminary injunction, Defendant was not present before the Court. Plaintiff claimed that Defendant's mark was identical/deceptively similar to its mark ECONORM and was likely to cause confusion and deception amongst the members of the trade and consumers. Plaintiff also submitted that the prefix of the word should be given due weightage and importance in cases where the suffix was common.

**HELD:** The Court observed that Defendant's act

of using a mark similar to Plaintiff's mark in relation to the same products, offends the statutory and common law rights of Plaintiff and causes dilution of Plaintiff's mark and amounts to unfair competition. The Court issued an ex-parte preliminary injunction order restraining Defendant from marketing/sale of pharmaceutical products under the mark ESONORM or its variants similar in any manner to Plaintiff's mark ECONORM and variants.

### **15. COBRA BEER successfully prevents unauthorised use of its trademarks**

**COBRA BEER PARTNERSHIP LTD. & ANR. VS. SUPERIOR INDUSTRIES LTD**  
*8<sup>th</sup> April, 2015, Delhi High Court*

**COBRA/KING COBRA/ICEBERG/ICEBERG GOLD**

**FACTS:** Plaintiff is a UK based company with an Indian subsidiary and registered proprietor of trademarks COBRA and KING COBRA which are used in relation to Beer and have been used in India since 2004 and 2006 respectively.

Plaintiff filed a suit against the Defendant claiming infringement and passing off of its COBRA and KING COBRA trademarks.

**CONTENTIONS:** Plaintiff claimed that Defendant was dishonestly using bottles of the plaintiffs bearing the trademarks COBRA, KING COBRA, ICEBERG and ICEBERG GOLD to sell its own product which amounts to an infringement of the registered marks. Defendant submitted that it manufactured beer under its own registered trademark SUPERIOR 50000 and it used distinctive labels which were prominently displayed on the products to indicate their trade origin. Defendant argued that it did not use the trademarks COBRA or KING COBRA in course of its trade, hence no case of infringement was made out.

**HELD:** The Court noted that Defendant was admittedly using the offending bottles which bore Plaintiff's trademarks. The Court was of the opinion that had Defendant's use been honest and no detriment was being caused to Plaintiff's interest, simple removal of Plaintiff's marks from the offending bottles would have been sufficient

remedy, but this was not such a case. Accordingly, the Court held that Plaintiff had succeeded in establishing a prima facie case of infringement of its trademarks COBRA and KING COBRA. Hence, the Court directed Defendant to stop using the trademarks COBRA and KING COBRA in relation to its products in any manner whatsoever.

### **16. HONEYWELL held a 'Well-known' Trade Mark**

**HONEYWELL INTERNATIONAL INC. VS. PRAVIN THORAT & ORS**  
*24<sup>th</sup> August, 2015, Delhi High Court*  
**HONEYWELL v HONEYWELL**

**FACTS:** Plaintiff is a US based company, whose business consists of four segments namely Aerospace, Automation and Control Solutions, Performance Materials and Technologies, and Transportation Systems. Plaintiff had adopted the trademark HONEYWELL in 1906 from the name of its founder, Mark Honeywell.

Plaintiff came to know that Defendant was using the trademark HONEYWELL as a conspicuous part of its trade name. Defendant was engaged in the manufacture and distribution of bakery and confectionery items. Defendant had also filed an application for registration of the stated mark. Plaintiff had sent a cease and desist letter to Defendant, however, Defendant had refused to accede to Plaintiff's request. Aggrieved, Plaintiff filed a trademark infringement suit against Defendant seeking to restrain it from using the trademark HONEYWELL.

**CONTENTIONS:** In the suit, the Court had earlier granted an ex-parte preliminary injunction in Plaintiff's favour. Defendant refused to accept the notices issued by the High Court and hence, the matter was proceeded ex-parte.

Plaintiff asserted that the trademark HONEYWELL is a well-known mark in India and submitted substantial evidence in favour of such statement. Plaintiff argued that Defendant's use of the trademark amounted to infringement and Defendant ought to be restrained from using the said mark.

**HELD:** On perusal of the documents on record, the Court held that the trademark HONEYWELL

was indeed a well-known trademark in India. The Court also opined that clearly Defendant had violated Plaintiff's rights vested in the HONEYWELL mark. Accordingly, the Court issued a decree of permanent injunction restraining Defendant from using the HONEYWELL mark or HONEYWELL as a part of domain name. The Court also awarded punitive damages of Rs.3 lakhs \* (US\$ 4410 approx.) payable to Plaintiff by Defendant and directed that Plaintiff is also entitled to costs of the suit proceedings.

### **17. GENTAC held to be deceptively similar to ZANTAC and ZINETAC**

**GLAXO GROUP LTD. & ANR. VS.**

**S.D GARG & ORS.**

*12<sup>th</sup> May, 2015, Delhi High Court*

**ZINETAC/ZANTAC v GENTAC**

**FACTS:** Plaintiff is a UK based pharmaceutical company and owner of trademarks 'ZINETAC' and 'ZANTAC', which were registered in the year 1985 and 1981 respectively. The trademarks are associated with a medicine containing 'Ranitidine Hydrochloride' which is used in the treatment of gastric ailments.

Plaintiff found that Defendant was reproducing Plaintiff's medicines under the deceptively similar mark GENTAC which amounted to infringement and passing off of its registered trademarks ZANTAC and ZINETAC.

**CONTENTIONS:** Plaintiff claimed that Defendant had wilfully adopted the deceptively similar trademark in order to create confusion and deception in the minds of the purchaser. Plaintiff also submitted that Defendant had in the past infringed another trademark BETNOVATE of Plaintiff by using the deceptively similar mark BETNOVATE and in the said suit, the Court had issued an injunction against Defendant.

Defendant on the other hand asserted that Plaintiff had no use of its trademark ZANTAC and it was a dummy registration. With regard to ZINETAC, Defendant claimed that Plaintiff had been unable to submit sufficient evidence. Hence, Defendant argued that Plaintiff cannot claim protection with regard to any of its marks. On the other hand, Defendant stated that its trademark GENTAC had

substantial goodwill in the market and argued that Plaintiff's products bearing the said marks did not have any reputation.

**HELD:** The Court noted that the product packagings of the two products were visually distinct. However, on taking into consideration the rival marks in their entirety, the High Court was of the opinion that Defendant's mark was deceptively similar to Plaintiff's marks. High Court also observed that Plaintiff had successfully established its rights in the trademarks ZANTAC and ZINETAC. The Court ruled that Plaintiff was entitled to a decree of injunction and restrained Defendant from using the deceptively similar mark GENTAC.

### **18. Indian entities injuncted from selling counterfeit products under the TOMMY HILFIGER Brands**

**TOMMY HILFIGER LICENSING BV VS.**

**AMIT DUGGAL & ANR.**

**TOMMY HILFIGER LICENSING BV VS.**

**ATIK UR REHMAN**

*20<sup>th</sup> May, 2015, Delhi High Court*

**TOMMY HILFIGER TOMMY, HILFIGER, HILFIGER DENIM, TOMMY GIRL and the FLAG Logo**

**FACTS:** Plaintiff is a company based in the Netherlands and claims to be one of the leading premium lifestyle and designer apparel brands in the world. Plaintiff is the proprietor of the trademarks TOMMY HILFIGER, TOMMY, TOMMY GIRL and FLAG Logo, all of which are registered in India in its favour.

In the first suit, Defendant was based in Ludhiana and engaged in manufacturing, marketing, supplying and trading in readymade garments, deodorants, fragrances, cosmetics and other allied products. Defendant had dishonestly adopted and started using the trademark/label TOMMY HILFIGER TOMMY, HILFIGER, HILFIGER DENIM, TOMMY GIRL and the FLAG Logo in relation to the said products. In the second suit, Defendant was based in Bangalore, also engaged in manufacturing, marketing, supplying and trading in readymade garments, deodorants, fragrances, cosmetics and other allied products under the TOMMY HILFIGER family of trademarks.



**CONTENTIONS:** The present hearing was for an ex-parte preliminary injunction and hence, Defendants were not present before the Court.

Plaintiff submitted that it became aware of Defendants' infringing activities in 2014 and filed a criminal complaint against both of them, as a result of which raids were conducted at Defendants' premises in Ludhiana and Bangalore respectively, and huge quantities of counterfeit products were seized.

Plaintiff came to know that despite such raids, Defendants had once again started soliciting business of selling counterfeit goods under Plaintiff's trademarks. Plaintiff found that Defendants were not only making retail sales, but was also supplying the counterfeit goods to various dealers/shopkeepers/retailers in different markets in New Delhi. Aggrieved by Defendants' activities, Plaintiff filed the present suit before the Court.

**HELD:** The Court after hearing Plaintiff's arguments and perusing the documents on record, was of the opinion that Plaintiff was entitled to a preliminary relief of ex-parte injunction against Defendants. Accordingly, the Court directed that Defendants cannot use Plaintiff's TOMMY HILFIGER, TOMMY, TOMMY GIRL and FLAG Logo trademarks in relation to their products till further proceedings. The Court also directed that Special Officers (Local Commissioners) shall visit Defendants' premises and seize any and all offending products, and submit their report before the Court.

## 19. Court prevents unauthorised use of the trademark KEYENCE

**KEYENCE CORPORATION VS. VACHHANI JALPA PANKAJ**

*29<sup>th</sup> June, 2015, Delhi High Court*

**KEYENCE v KEYENCE**

**FACTS:** Plaintiff is a developer and manufacturer of automation equipment and registered proprietor for the trademark KEYENCE in India. Plaintiff's mark KEYENCE has been in use since 1996 through its authorized distributor, Toshni-Tek International and through its Indian subsidiary Keyence Pvt. Ltd., since 2011.

In 2015, Plaintiff found out that Defendant had filed a trademark application for registration of the mark KEYENCE WATER SYSTEM. Upon further enquiries, Plaintiff found that Defendant was using the expression KEYENCE both as a trademark and part of its trade name and was additionally operating a website [www.keyencewatersystem.com](http://www.keyencewatersystem.com) in order to promote its products. Aggrieved, Plaintiff filed the present suit for trademark infringement and passing off.

**CONTENTIONS:** On the day of preliminary hearing of the suit, an ex-parte interim injunction was granted in favour of Plaintiff. Thereafter, despite being notified of the proceeding, Defendant failed to appear before the Court and thus, the matter proceeded ex-parte against Defendant. The Court made the earlier granted ex-parte injunction absolute till disposal of the suit proceeding. The Court also appointed a special officer (Local Commissioner) to visit Defendant's premises and seize the offending goods, if any.

When the Local Commissioner visited Defendant's premises, he found that Defendant had already changed its trade name to KEY ENVIRON PROJECTS. Defendant also gave a written undertaking to the Local Commissioner that it will not use Plaintiff's mark in the future.

**HELD:** Based on the written undertaking of Defendant and Plaintiff's submissions and evidence furnished on record, the Delhi High Court issued a decree restraining Defendant from using the trademark KEYENCE.

## 20. Audi's use of the TTRS brand challenged by Indian Entity

**RIKHAB CHANDRA JAIN AND ANR. V AUDI AG**

*21<sup>st</sup> July, 28<sup>th</sup> August, 2015, Delhi High Court*

**T.T v T.T.R.S.**

**FACTS:** Plaintiff is an Indian company and the registered proprietor of the trademark T.T. Plaintiff claims to be a corporation owning a fully integrated vertical chain from fibre to fashion and export textiles, agro-products, readymade garments, textile piece goods, hosiery items, yarns, edible foods, confectioneries, wind mill, sweets, hand tools, small machineries, cosmetic

items, medical products, surgical aids, band aids, electronic and electrical apparatus, agricultural implements, bags, building materials, etc.

Plaintiff filed the present suit against Defendant, the German automotive company Audi claiming infringement and passing off of its well-known mark T.T.

**FACTS:** Plaintiff claimed that in 2015, it came to know that Defendant is using its trademark T.T. to promote various products such as leather and imitations of leather goods made of animal skins, hides; products such as trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddler, games and playthings, model cars, gymnastic and sporting articles, decorations for Christmas trees etc.

On the date of preliminary ex-parte hearing of Plaintiff's injunction application, the Delhi High Court, issued an ex-parte injunction order restraining Defendant from using the T.T mark in any manner.

On being notified of the ex-parte injunction order, Defendant appeared before the High Court. Defendant submitted that it was the registered proprietor of the trademark TTRS for marketing Coupe Cars and its variants in India in Class 12, and the said mark has been in use worldwide since 1998 and in India since 2004. Defendant also submitted that Plaintiff's registration for T.T. in 7 classes were cancelled by the Intellectual Property Appellate Board (IPAB) and although Plaintiff had challenged the IPAB order before the Calcutta High Court, such cancellation order was not stayed by the Court. Defendant claimed that Plaintiff had not furnished complete facts before the Delhi High Court while praying for the interim injunction and hence the order stands vitiated.

In response, Plaintiff stated that its registration in all seven classes are subsisting. However, it admitted that none of those registrations relate to products in Class 12.

**HELD:** The Court noted that in view of the trademark registration for TTRS in favour of Defendant and its long use in India, the balance of convenience lies in favour of use of the said

mark. Accordingly, the Court modified its earlier injunction order and held that Defendant was not restrained from using the TTRS mark in relation to manufacture and sale of motor vehicles.

## 21. Trader of fake LOUIS VUITTON goods restrained

LOUIS VUITTON MALLETIER VS MR.MANOJ KHURANA & ORS.

20<sup>th</sup> August, 2015, Delhi High Court

LOUIS VUITTON/LV/Toile Monogram and the Damier pattern

**FACTS:** Plaintiff is a French company, and proprietor of the trademark LOUIS VUITTON. The name "Louis Vuitton" was used for the first time as the name of a company in 1854 and was derived from the name of its founder. The trademark is associated exclusively with goods of the plaintiff's manufacture. Plaintiff had filed the present suit claiming infringement and passing off of its trademarks LOUIS VUITTON and LV by Defendant.

**CONTENTIONS:** Plaintiff claims that Defendant is engaged in the sale of counterfeit products bearing its LOUIS VUITTON and LV marks. Plaintiff further stated that such unauthorised use of its trademarks will cause confusion in the market and dilution of the exclusivity attached to its trademarks. On the date of preliminary hearing, the Delhi High Court granted an ex-parte interim injunction in Plaintiff's favour.

Thereafter, Defendant appeared before the High Court and submitted its response. Defendant submitted that it was under the mistaken belief that its products were manufactured by Plaintiff.

**HELD:** The Court noted that only exclusive outlets of Plaintiff were authorized to sell original LOUIS VUITTON goods and hence the plea raised by Defendant was completely false. The Court was of the opinion that where LV goods were found to be sold outside the exclusive LV stores, an adverse inference is to be drawn under the Indian Evidence Act, 1872 that the goods are counterfeit beyond any doubt whatsoever. Accordingly, the Court issued a permanent injunction restraining Defendant from using the LV Logo, the Toile Monogram and the Damier

pattern in any manner. Defendant was also directed by the High Court to pay Rs.50000 \*(US\$ 735 approx.) towards costs of proceedings.

## 22. Court holds that Vitaplex had issued ‘Groundless threats of legal proceeding’ to Bata India

**BATA INDIA LIMITED v  
VITAFLEX MAUCH GMBH**  
*24<sup>th</sup> August, 2015, Delhi High Court*  
Nach Dr. Mauch/ by Doc Mauch

**FACTS:** The present suit has been filed by Plaintiff against Defendant, wherein Plaintiff seeks declaration that threats made by Defendant with respect to the shoes manufactured by it, which allegedly infringe Defendant’s trade mark or patent rights, are unjustified and wrongful. Defendant had sent a legal notice where it had claimed to be responsible for the brands Nach Dr. Mauch/ by Doc Mauch in India. Defendant also claimed to have a pending patent application for a five point configuration of pressure points in insoles of shoes, and a pending trademark application for the expression ‘5 Points’ Label. Defendant had alleged that Plaintiff was manufacturing and selling copies of its products which were similar in appearance and functionality. In the legal notice, Defendant had demanded that Plaintiff immediately cease production and sale of the offending products failing which Defendant would initiate legal proceeding and seek compensation.

**CONTENTIONS:** In the legal notice, Defendant had claimed that five pressure points/reflex points in the insoles of shoes amounted to a trade mark as also a patent, and that Plaintiff was violating such rights by showing six pressure points/reflex points in the insoles of its shoes manufactured and sold under its trademark Comfit. In the suit however, Defendant did not appear before the High Court and the matter proceeded ex-parte.

**HELD:** The Single Judge observed that the relevant sections in the Patent Act 1970 and Trade Marks Act 1999 indicate that in order to successfully claim infringement, there must be a granted patent or a registered trademark in favour of the person issuing the cease and desist notice. Since Defendant had not appeared before the High Court, there was no evidence as to whether

Defendant had a validly granted patent or a registered trademark in its name. Accordingly, High Court was of the opinion that Plaintiff could not be said to have infringed any granted patent or a registered trademark of Defendant and thus, the legal notice issued by Defendant amounted to a groundless threat for legal proceeding. High Court also stated that the ‘five pressure/reflex point’ could not be considered as a ‘trade mark’ since Defendant was selling its products under the marks ‘Nach Dr. Mauch’ and ‘by Doc Mauch’.

Based on the above observations, Delhi High Court restrained Defendant from issuing any groundless threats either through circulars or advertisement or by communication in any manner to Plaintiff, that Plaintiff was infringing or violating any patent or trade mark rights of Defendant with respect to the five pressure points/reflex points. High Court also declared that the threats made by Defendant to Plaintiff were groundless, unjustifiable and wrongful.

## 23. URBAN EAGLE held not similar to AMERICAN EAGLE

**RETAIL ROYALTY COMPANY VS PANTALOONS  
FASHION & RETAIL LIMITED AND ORS**  
*23<sup>th</sup> September, 2015, Delhi High Court*  
AMERICAN EAGLE and Eagle Device v  
URBAN EAGLE and Eagle Device

**FACTS:** The present suit had been filed by Plaintiff against Defendant, wherein Plaintiff claimed that Defendant had dishonestly adopted the trademark URBAN EAGLE AUTHENTIC OUTFITTERS which infringed their prior registered trademark AMERICAN EAGLE OUTFITTERS/AMERICAN EAGLE. At the initial stage of the proceeding, the Delhi High Court, although inclined to grant ex-parte interim injunction but in view of Defendant being one of the largest industrial groups of India, did not grant such injunction and instead directed Defendant to explain its adoption of the trademark URBAN EAGLE AUTHENTIC OUTFITTERS.

**CONTENTIONS:** Defendant appeared before the High Court and stated that it will cease use of the expression ‘AUTHENTIC OUTFITTERS’ from its trademark, and use only the expression URBAN EAGLE in respect of its products. However, Plaintiff was not agreeable to such a



proposal and argued that Defendant must cease use of the Eagle device and the expression URBAN EAGLE in its totality, as it constituted infringement of its trademark AMERICAN EAGLE.

**HELD:** The Single Judge noted that Plaintiff's mark was AMERICAN EAGLE and Plaintiff had no exclusive rights over the expression 'Eagle' per se. In view of the same, the Court found that the trademark URBAN EAGLE cannot be said to be similar to the AMERICAN EAGLE mark. Also, while comparing the two Eagle devices used by the rival parties, the Court was of the opinion that the Defendant's Eagle device could not be said to be deceptively similar to Plaintiff's Eagle device. On the issue of protection of public interest, the Single Judge noted that since the products were only clothing, public interest could not be a factor to grant interim injunction and in any case, Plaintiff could be suitably compensated in monies, if infringement was indeed proved at the final stage. Based on the above, the Court ruled that Plaintiff was not entitled to a grant of interim injunction against Defendant.

## 24. Supreme Court holds that 'first in the market' test should always enjoy pre-eminence

**NEON LABORATORIES LTD VS MEDICAL TECHNOLOGIES LTD. & ORS**

*5<sup>th</sup> October, 2015, Supreme Court of India*

**PROFOL v ROFOL**

**FACTS:** Plaintiff filed a trademark infringement suit against Defendant in which the Trial Court had granted an injunction in favour of Plaintiff. The decision was also upheld by the Single Judge of Gujarat High Court. Aggrieved by the decision, Defendant/Appellant filed an appeal before the Supreme Court.

Plaintiff/Respondent, was engaged in the manufacture and sale of pharmaceutical products and medicinal preparations, and had introduced the molecular preparation and generic drug Propofol in India. Plaintiff had also adopted the trademark PROFOL in order to market the said drug and had also applied for a trademark registration.

On coming to know that Defendant had

introduced the same generic drug in the market under the trademark ROFOL, Plaintiff filed the present suit claiming that the mark ROFOL is identical and deceptively similar to its mark PROFOL.

**CONTENTIONS:** Defendant submitted that it was the prior adopter of the trademark ROFOL since it had applied for trademark registration in 1992, although commenced use of the mark only in 2004. Defendant had also filed a trademark infringement suit before the Bombay High Court in 2005, and was granted an injunction only in 2012. Plaintiff had filed an appeal against the said injunction order, and the Bombay High Court had stayed the operation of the injunction order.

Plaintiff on the other hand, claimed that it had adopted and commenced use of the trademark PROFOL in 1998 through its predecessor and since 2000, after amalgamating with its predecessor.

**HELD:** The Supreme Court noted that on one hand, Defendant had a prior registered mark ROFOL in 1992, which had not been in use till 2004, and on the other hand, Plaintiff had commenced use of its mark PROFOL in 1998, had acquired substantial goodwill through such use and also applied for registration of its mark. Supreme Court stated that the issue that needed adjudication was whether prior registration of Defendant can obliterate the significance of goodwill that has been established by Plaintiff. Supreme Court analysed various provisions of the Act and observed that the Act protects prior user of a trademark from the proprietor who is not using its mark and also postulates that a trademark registration may be cancelled on account of non use for a period of five years. As such, Supreme Court was of the opinion that a trademark does not have a permanent right by virtue of its registration alone, but such right may be lost if it is not exercised within reasonable time. The Supreme Court held that Plaintiff had successfully established that it had commenced use of its trademark PROFOL much earlier than that of Defendant's use of ROFOL in the light of 'first in the market' test. Hence, Supreme Court ruled that the order of the trial court as well as the Gujarat High Court was reasonable and judicious and dismissed the appeal.

## 25. District Court dismisses infringement suit filed by L'Oreal for want of territorial jurisdiction

**L'OREAL v. HEENA KANGAN STORE & ORS**  
*12<sup>th</sup> October, 2015, Delhi District Court*  
**L'OREAL/L'OREAL PARIS**

**FACTS:** Plaintiff is a French company, engaged in manufacture, distribution and sale of a wide range of hair care, skin care, toiletries, and beauty products including perfumery preparations, essential oils, cosmetics, preparations for colouring and bleaching the hair, hair dyes and tints, preparations for waving and setting the hair, shampoos, hair sprays, non-medicated preparations for the care and beauty of the hair and of the skin, toilet soaps, dentifrices, sun tan preparations, personal deodorants and other allied/related products. Plaintiff is the proprietor of the trademark L'OREAL and its variants in Class 3.

Plaintiff came to know that Defendants, engaged in the trading of cosmetics, toiletries, hair care products and other allied goods, had adopted the L'OREAL mark in conjunction with the expression 'Paris', and were using the trademarks in relation to identical products. Aggrieved, Plaintiff filed the present suit for trademark infringement, passing off and counterfeiting.

**CONTENTIONS:** Plaintiff alleged that Defendants' actions constituted false representation and were intended to cause confusion in the minds of the purchasers regarding the trade origin of the products. Plaintiff claimed that Defendants were infringing its L'OREAL trademarks and were also infringing its copyright in the artistic features incorporated in the L'OREAL labels.

In the suit proceedings, Defendant Nos. 1, 2 and 5 appeared before the Delhi High Court and entered into a compromise with Plaintiff and the suit was accordingly disposed off against them. Plaintiff withdrew its case against Defendant No.3 and the matter proceeded ex-parte against Defendant No.4, who could not be notified of the suit.

**HELD:** On the basis of the evidence on record, the Delhi District Court held that Plaintiff was

not carrying on business within the territorial jurisdiction of the Court, either by itself or through its special agent whether in terms of Section 20 of the Civil Procedure Code or Section 134 of the Trade Marks Act, 1999. The District Court observed that three of the Defendants had entered into a compromise with Plaintiff and one Defendant was dropped from array of parties by Plaintiff. The suit survived only against Defendant No.4 and District Court returned the complaint to Plaintiff with the direction to present it before a competent court.

## 26. Court denies Anchor's request for amendment of suit against Colgate Palmolive

**COLGATE PALMOLIVE COMPANY AND ANR VS ANCHOR HEALTH AND BEAUTY CARE PVT. LTD**  
*19<sup>th</sup> November, 2015, Delhi High Court*  
**ALLROUND v 'ALL AROUND DECAY PROTECTION'**

**FACTS:** The present suit is an appeal filed by Appellant/Defendant against the order of the Single Judge of Delhi High Court granting an injunction in favour of Plaintiff/Respondent.

Anchor (Plaintiff) claimed that it had launched a toothpaste under the mark 'Anchor White Allround Protection' in 2005. In August 2007, Colgate launched its new "Strong Teeth" carton using the phrase 'All Around Decay Protection'. Anchor was aggrieved that Colgate had used the tooth device with bubbles around which was similar to the tooth device used by it in its "White Allround Protection". Anchor also alleged that Colgate was interfering with its business unlawfully and had instituted several suits against it and was also threatening its dealers. Anchor sought an injunction restraining Colgate from interfering with its legitimate business and imitating or copying features of its range of products including the term 'Allround Protection' and Tooth Device in the Colgate "Strong Teeth" Carton.

The suit was initially filed by Anchor as a suit for declaration and permanent injunction restraining tortious acts of unlawful interference by Colgate. During the pendency of the suit, Anchor obtained registration of the trademark 'ALLROUND' and accordingly, Anchor sought

to amend the suit to include prayers for relief of permanent injunction against infringement of registered trademark and passing off, in addition to tortious acts of unlawful interference.

**CONTENTIONS:** Anchor alleged that Colgate's use of the phrase 'All Around Decay Protection' amounted to infringement of its registered trademark ALLROUND and both trademarks were in relation to identical products. Anchor also claimed that Colgate's use was not only subsequent but also deliberate, in order to trade upon the reputation associated with Anchor's products.

In its defence, Colgate opposed Anchor's amendment application urging that the fundamental structure and cause of action of the suit was sought to be altered by Anchor through the proposed amendment, converting the complaint from a non-confusion suit into a "confusion" based cause of action. However, the Single Judge allowed the amendment holding that the law relating to amendment of pleadings ought to be construed liberally.

Aggrieved by the order of the Single Judge, Colgate filed an appeal before the Appellate Bench of the Delhi High Court. Colgate argued that despite the fact that law of amendment of pleading is construed liberally, Indian courts had prescribed well-recognised limitations on the seemingly wide power of permitting amendments. Allowing the amendment sought by Anchor would change the essential character of the proceeding, the suit which was initially defensive in nature involving trade dress violation and passing off, would change into an offensive infringement suit. Colgate also stated that Anchor had not divulged that it had applied for registration of the mark ALLROUND at the time of filing of the suit, and even after obtaining registration in 2008, Anchor waited till 2011 to seek the amendment.

Anchor argued that there was no change in the fundamental nature of the suit. The suit was premised on the violation of its mark ALLROUND. Anchor also submitted that there was no bar of limitation on a fresh suit based on infringement, and the amendment was intended to avoid multiplicity of proceedings. Also the

present suit was at the initial stage, the trial was yet to commence and hence, there was no likelihood of any prejudice being caused to Colgate.

**HELD:** The Division Bench was of the opinion that the Single Judge had erred in his decision in assuming that the essential character of the suit remain unchanged if the amendment was allowed. According to the appellate court, the original suit was in respect of trade dress protection where Defendant was alleged to have been using certain terms to describe its product, which could possibly be common to trade. However, post the amendment, the suit relates to infringement of a statutory right vested in the Plaintiff and all that was required was Plaintiff to prove a prima facie case of deceptive similarity, and infringement, which is an offence punishable by fine or prison term, was presumed. The Division Bench allowed the appeal and set aside the decision of the Single Judge and dismissed Plaintiff's amendment application.

## 27. Court restrains misuse of the SIEMENS trademark

**SIEMENS AG V SIEMENS CONSULTANCY SERVICES PVT LTD**

*9<sup>th</sup> October, 2015, Delhi High Court*

**SIEMENS v SIEMENS**

**FACTS:** Plaintiff is the registered proprietor of the trademark SIEMENS since 1952 in relation to a range of products in Class 9. Plaintiff's mark SIEMENS is well-known worldwide including India. Plaintiff also operates two websites [www.siemens.com](http://www.siemens.com) and [www.siemens.co.in](http://www.siemens.co.in) registered in 1986 and 2009 respectively.

Plaintiff came to know that Defendant had adopted the expression SIEMENS as a part of its domain name and website [www.siemensconsultancy.com](http://www.siemensconsultancy.com). On the website, Defendant has shown itself to be a technology, engineering, construction, manufacturing and financial services conglomerate, with global operations. Aggrieved, Plaintiff had filed this suit for trademark infringement.

**CONTENTIONS:** Plaintiff claimed that Defendant's actions amount to infringement and passing off of its trademark SIEMENS. Since this



was the preliminary hearing before Delhi High Court, Defendant was not present.

**HELD:** High Court ruled that Plaintiff had successfully established a case for trademark infringement and passing off. Accordingly, High Court granted an ex-parte interim injunction order whereby Defendant was restrained from using SIEMENS trademark for any purpose, including its trade name. Defendant was also restrained from using the domain name [www.siemensconsultancy.com](http://www.siemensconsultancy.com), and High Court directed Defendant to remove all the materials posted on the website containing the mark SIEMENS.

## 28. Court awards punitive damages of Rs.1 crore in a trademark counterfeiting suit

**CARTIER INTERNATIONAL AG & OTHERS VS GAURAV BHATIA & ORS**

*4<sup>th</sup> January, 2016, Delhi High Court*

**CARTIER, PANERAI, VACHERON CONSTANTIN, JAEGER LECOULTRE, PASHA, CABOCHON, OFFICINE PANERAI FIRENZE, MARINA MILITARE, LUMIOR**

**FACTS:** Plaintiffs are the proprietors of the trademarks CARTIER, PANERAI, VACHERON CONSTANTIN, JAEGER LECOULTRE, PASHA, CABOCHON, OFFICINE PANERAI FIRENZE, MARINA MILITARE, LUMIOR (suit trademarks) and have multiple registrations for the said marks in various countries including in India. Plaintiffs claim that the suit trademarks are well-known in India.

According to Plaintiffs, Defendants operate an e-commerce website [www.digaaz.com](http://www.digaaz.com) where they offer lifestyle and fashion products for sale at heavily discounted prices. Defendants' website [www.digaaz.com](http://www.digaaz.com) was found to be offering for sale and supplying counterfeit products bearing several registered trademarks of Plaintiffs. In addition to offering for sale and supplying counterfeit goods bearing the suit trademarks through their website, Defendants were providing the goods with model names identical to Plaintiffs' original product lines and collections. Plaintiffs sent cease and desist notices to Defendants, but despite receiving them, Defendants continued their infringing activities.

Aggrieved, Plaintiffs filed the present suit against Defendants seeking to restrain them from using the suit trademarks in any manner.

**CONTENTIONS:** Defendants did not appear before the Delhi High Court, hence the matter proceeded ex-parte. Plaintiffs submitted that Defendants' activities were causing widespread confusion and deception among customers which was evident from the number of consumer complaints on Defendants' website. Plaintiffs alleged that despite such complaints, neither did the Defendants offer any refund nor replace the products with originals. Plaintiffs further submitted that one such consumer filed a criminal complaint before the Cyber Cell of Chandigarh Police and after conducting their investigation, the Cyber Cell division conducted raids at Defendants' premises. Pursuant to such raids, several movable and immovable property belonging to Defendants were seized and sealed by the Cyber Cell division. Plaintiffs submitted that these properties were evidence that Defendants had amassed substantial profits from the illegal activities under the suit trademarks.

**HELD:** The Delhi High Court found that Plaintiffs had established a prima facie case of trademark infringement, passing off and counterfeiting. High Court observed that in view of the ample evidence that Defendants had amassed considerable illegal profits by trading off the reputation and goodwill associated with the suit trademarks, Plaintiffs were entitled to an award of damages of Rs. 1 Crore \*(US\$ 147050 approx.). Delhi High Court also issued a decree of permanent injunction, restraining Defendants from dealing in the suit trademarks in any manner.

## 29. MULTI CHERRY held not similar to CHERI

**INDCHEMIE HEALTH SPECIALTIES PVT. LTD. VS. INTAS PHARMACEUTICALS LTD. & ANR.**

*24<sup>th</sup> June, 2015, Bombay High Court*

**CHERI v MULTI CHERRY**

**FACTS:** Plaintiff manufactures and deals in pharmaceutical and medical preparations. Plaintiff is the registered proprietor of the trade mark 'CHERI', since of 14 May 1987, in respect of pharmaceutical preparations falling in Class 5.

\* (INR 1 = US\$ 68 approx.)

In June 2011, Plaintiff came across a product CHERRY FOL being marketed by Defendant. Plaintiff sent a cease and desist letter, and in response, Defendant agreed to desist from using the mark. In January 2014, Plaintiff again came across a product bearing the mark MULTI CHERRY which was launched by Defendant. Plaintiff sent a cease and desist letter, but Defendant refused to comply and defended its use of the mark MULTI CHERRY in relation to multivitamin syrup. Aggrieved Plaintiff filed the present suit before the Bombay High Court, alleging trademark infringement and passing off.

**CONTENTIONS:** Plaintiff claimed that Defendant's use of the MULTI CHERRY mark amounts to infringement and passing off of its well-known mark CHERI. In its defence, Defendant submitted that during prosecution of its trademark application, Plaintiff had agreed to limit its application to pharmaceutical preparations by deleting medicinal preparations from the specification of goods. Defendant contended that its product was a dietary supplement, and thus, Plaintiff cannot restrain Defendant from using the mark MULTI CHERRY on the basis of its registration for CHERI which is restricted to pharmaceutical preparations.

**HELD:** The Bombay High Court was of the opinion that Plaintiff's trademark CHERI being a phonetic equivalent of the word 'Cherry' is obviously descriptive and incapable of distinguishing its products, and it was for this reason that the Registrar had sought to restrict the product description of the trademark application to only pharmaceutical preparations. High Court further stated that if Plaintiff received protection for a narrow class of goods, it could not be permitted to extend such protection to other goods, such as medicinal or dietetic substances adopted for medical use or meant for general well being.

Plaintiff's claim that under the 1999 Act, a registered trade mark is infringed by use of the mark in relation to not only identical goods but also in case of similarity of the goods or services covered by such registered trade mark, was not accepted by the High Court. The Court observed that such argument is flawed, since in the present

case, registration was granted to Plaintiff for a narrow set of goods and so, 'similarity' must also be construed narrowly. The Court stated when there was no restriction in the goods covered by Class 5, it was possible to include a health supplement or nutritional food supplement as a similar good even if it is not meant for therapeutic use. But in the present case, where the words 'medicinal preparations' were deliberately omitted because 'Cherry' as a fruit has medicinal values and for a dietetic substance adopted for medical use, could be a descriptive term, it was unfair, according to The Court, to include a health supplement or nutritional food supplement, as a similar good for trade mark protection. In consideration of the narrow class of goods for which Plaintiff had registration and that Defendant's goods were dissimilar from that of Plaintiff with reference to such narrow class, the Court ruled that no case had been made out for infringement of Plaintiff's mark 'Cheri' and dismissed Plaintiff's application for interim injunction.

### 30. Court rules ZARA "well known" mark

**INDUSTRIA DE DISEÑO TEXTIL SA VS ORIENTAL CUISINES PVT. LTD. AND ORS**  
*19<sup>th</sup> May, 2015, Delhi High Court*  
**ZARA v ZARA TAPAS BAR**

**FACTS:** Plaintiff is engaged in the manufacture, design, sale and distribution of fashion and related lifestyle products in various classes of International Classification of Goods and Services under the trademark ZARA. Plaintiff had coined, conceived and adopted ZARA as its trademark in 1975 and opened its first ZARA shop 38 years ago in A Coruna, Spain. In India, Plaintiff carries out its commercial operations through its associate company, Inditex Trent Retail India Private Limited, a joint venture between the Plaintiff and Trent Limited, a well known Tata Group Company.

In 2005, Plaintiff came across Defendant's application for the trademark ZARA TAPAS BAR in Class 16 and it immediately opposed the registration of the said mark. By end 2012, Plaintiff came across other trademark applications for the same mark filed by Defendant, and Plaintiff opposed each of the applications on the

basis of its prior registered and well-known mark ZARA. Defendant proposed to confine its use of the said mark to only restaurant services and other allied goods, and never to seek protection in respect of products of Plaintiff's interest i.e., in Classes 24 and 25. However, such offer was not acceptable to Plaintiff and Plaintiff filed the present suit against Defendant claiming trademark infringement and passing off.

**CONTENTIONS:** Plaintiff contended that Defendant was using its mark ZARA in conjunction with the generic expression TAPAS BAR, which is a dining concept of Spanish origin. Plaintiff claimed that the independent expression ZARA in isolation does not inherently provoke a Spanish feel, the expression has no meaning in Spanish language and is neither a popular nor a common name in Spain. As per Plaintiff, any Spanish association of the expression ZARA is solely attributable to the popularity and goodwill acquired by Plaintiff worldwide, being a company originally of Spain. Plaintiff claimed that owing to Defendant's use of the name ZARA TAPAS BAR, there is a strong likelihood of unwarranted association between Plaintiff and the Defendant in the minds of the existing and potential consumers.

In response, Defendant asserted that Plaintiff had misrepresented and concealed material facts, and thus, approached the High Court with unclean hands. Defendant claimed that multiple parties in India as well as abroad are using the mark ZARA. Defendant also alleged that there was major delay in filing of the suit, since Plaintiff was aware of its use of the mark since 2002. In addition, Defendant claimed that the mark ZARA was neither coined and conceived by Plaintiff and Plaintiff intended to monopolize the register by seeking protection in respect of products and services which are beyond its core class of activity.

In the suit, at the initial stage, an ex-parte interim injunction was granted to Plaintiff and Defendant was restrained from using the mark ZARA as a trademark, trade name, corporate name, domain name or in any other manner whatsoever.

Thereafter, Defendant filed an application for setting aside the ex-parte interim injunction order and consequently, High Court modified the injunction, and allowed Defendant to use the composite mark ZARA TAPAS BAR until further orders.

**HELD:** The Single Judge observed that the evidence on record clearly showed that Defendant was using the expression ZARA in a much bigger font than the rest of the expressions TAPAS BAR, and on many occasions the expression ZARA was used in isolation. The Single Judge was of the opinion that the manner in which Defendant used its mark was deceptively similar to Plaintiff's mark ZARA. Regarding the absence of plausible explanation behind Defendant's adoption of the ZARA mark, the Single Judge was of the opinion that it could not be assumed that Defendant's adoption was honest. High Court stated that use of the ZARA mark by third parties could not be a ground for refusal of injunction. With regard to Defendant's argument of delay, Judge opined that once Plaintiff had filed oppositions against Defendant's trademark applications, the delay of three years in filing the suit will neither amount to acquiescence nor will it disentitle Plaintiff from a relief of interim injunction. The Single Judge ruled that Defendant's allegations of suppression of facts and concealment was not acceptable since it was a mere misstatement of facts, and unless such misstatement is malafide, Plaintiff will not be disentitled from claiming interim injunction. Further, the High Court stated that consumers in India cannot be unaware of Plaintiff's products, given its widespread use and marketing tactics. The Judge observed *inter alia*, that 'The Plaintiff has placed on record host of documents to show that ZARA was a well known mark and had transborder reputation'.

Based on the above observations, the Delhi High Court issued a decree of interim injunction restraining Defendant from offering any products and services under the trademark ZARA and ZARA TAPAS BAR and from using the mark ZARA as a trademark, trade name, corporate name, domain name or in any other manner. ■



## Case Summaries of Trademark Decisions : 2015 - 2016 Intellectual Property Appellate Board (IPAB)

### 1. Extension of time allowed to file counter statement.

*Heinz Italia Inc. v Stokely Van Camp Inc.  
[ORA/147/2011/TM/DEL, Order No.33 of 2015]*

A rectification application had been filed by Heinz Italia (Heinz) against a registered trademark owned by Stokely Van Camp (Stokely). Stokely had filed a request for extension of time to file the counter statement to the rectification application. Stokely argued that the delay in filing the counter statement was not wilful as in a related proceeding before the Delhi High Court, the Court had opined that Heinz had filed the rectification without first obtaining leave of the court and hence, the rectification was liable to be dismissed and Stokely was under the impression that in view of the High Court's decision, Heinz will not continue with the rectification proceedings. On the other hand, Heinz argued that copies of rectification application were already sent to Stokely and that Stokely was aware of the same. In spite of the fact, there is a delay of about three years in filing of the counter statement and Heinz argued that the application ought to be rejected.

The Intellectual Property Appellate Board (IPAB) was of the opinion that Stokely being a foreign party, it was natural for a foreign entity to take some time to review the rectification application and contact its attorneys for instructions. IPAB held that Stokely had provided sufficient cause to explain the delay and no prejudice is expected to be caused to Heinz if such extension of time was granted. On that basis, IPAB allowed Stokely's application for request for extension of time to file the counter statement.

### 2. Non-production of relevant materials cannot be a ground to merit a review

*Xerox Corporation v B. V. Elango Himachalopathy and Registrar of Trade Marks.  
[ORA/201/2009/TM/KOL, Order No.10 of 2015]*

Respondent, B. V. Elango Himachalopathy had filed a number of rectification applications against trademark registrations owned by Xerox before

the Intellectual Property Appellate Board (IPAB). A number of the rectifications were dismissed, but three of them were allowed. Xerox filed a review petition only in respect of one of the trademarks in class 16 which was ordered to be removed by IPAB. Xerox contended that during the rectification proceedings, the main contention of the applicant for rectification was that the mark XEROX had become common. According to Xerox, the issue relating to non-use of the XEROX mark in respect of Class 16 products arose only at the final stages and at that time it was unable to submit documents showing use since 1960s despite its best efforts, but only produced documents from 1983 till date.

IPAB stated that nothing prevented Xerox from producing the additional documents at the final hearing of the rectification proceeding. IPAB ruled that non-production of relevant materials cannot be a ground to merit a review, since it does not tantamount to an error apparent on the face of the record as the impugned order was issued on the basis of documentary evidence placed on record by the parties. IPAB refused to interfere in the order already issued and dismissed the review petition.

### 3. In the matter of condoning delay, "probable cause" should be construed liberally

*Cluett Peabody & Co. Inc. v Super Threads India and Asst. Registrar of Trade Marks [COD.NO.3/2014 IN SR.NO.345/2013/TM/CH, Order No. 24 of 2015]*

Cluett Peabody filed a petition for condonation of delay of 13 days in filing an appeal before the IPAB against an order by the Registrar of Trade Marks refusing its opposition against the registration of application filed by Super Threads. Applicant contended that it was a foreign entity based in USA and after receipt of the order, there were further discussions and deliberations between its US and Indian attorneys which consumed some time and resulted in the delay. Cluett Peabody submitted that delay was neither wilful or wanton. On the other hand, Super Threads argued that it had been subjected to great hardship and harassment as it is trying to obtain

registration of its mark since 1995. Super Threads submitted that the reason for delay was unacceptable and was done with a view to protract the proceedings further.

IPAB noted that as a foreign entity, it was natural for Cluett Peabody to discuss and deliberate the matter with its attorneys and such exercise is expected to take time. IPAB relied on a number of judicial precedents laid down by the Supreme Court as well as different High Courts which held that in a matter of condoning delay, “sufficient cause” should be construed liberally and the matters are to be decided on merits with the object to render substantial justice. IPAB found that Cluett Peabody had not only assigned valid reasons but also shown sufficient cause to condone the delay. Accordingly, the application for condonation of delay in filing the appeal by Cluett Peabody was allowed.

#### 4. Delay condoned but costs imposed

*Home Box Office Inc. v Ogilvy & Mather Ltd. And Registrar of Trade Marks [ORA/337/2013/TM/MUM, Order No. 76 of 2015]*

The present matter relates to an application for condonation of delay filed by Ogilvy & Mather, Respondent in relation to the filing of a counter statement in response to the rectification application filed by Home Box Office Inc. Respondent had earlier been granted an extension of time to file the counter statement, but the counter statement was not filed within such extended period and Respondent has now made a fresh request for extension of time before the IPAB. At the hearing, Respondent submitted that the parties were involved in negotiations and after that failed, Respondent had prepared the counter statement which awaited the sanction of respondent-company and the delay was caused as a result of the same. Applicant for rectification, on the other hand, claimed that the negotiations had concluded much earlier and it could not be used to explain the long delay in filing the counter statement.

IPAB relied on a number of judicial precedents by the Supreme Court and the various High Courts, all of which stated that the expression ‘sufficient cause’ should be given a liberal construction. Accordingly, IPAB held that no prejudice will be caused to the applicant for

rectification if the delay in filing the counter statement is condoned. However in view of Respondent’s conduct, IPAB imposed a cost of Rs. 10,000 \*(US\$ 150 approx) to be payable by respondent to a charitable trust.

#### 5. Assignee allowed to be impleaded as a party

*Hygienic Research Institute Private Limited v Solvay Pharmaceutical Marketing and Licensing AG and Dy. Registrar of Trade Marks [M.P. NO.64/2013 IN OA/51/2009/TM/MUM, Order No. 122 of 2015]*

The present application has been filed by Galderma SA who claimed to be the assignee of the trademark in dispute. Galderma submitted that the main proceedings is an appeal filed by Hygienic Research against the order of the Registrar refusing its opposition against the impugned trademark. The impugned mark was assigned by the original applicant Duraco SA to Galderma SA. Duraco SA had subsequently changed its name to Solvay Pharmaceutical Marketing and Licensing AG. Galderma asserted that after the opposition had been dismissed by the Registrar, it had filed necessary applications to bring its name to the record as the present applicant, which had been allowed by the Registrar. Galderma stated that despite the same, the present appeal had been filed against Solvay Pharmaceutical and not Galderma. Consequently, Galderma requested the Intellectual Property Appellate Board to be substitute its name in the place of Solvay Pharmaceutical. Hygienic Research argued that Solvay Pharmaceuticals had participated in the opposition by filing the counter statement etc. Hygienic Research further contended that once there is an assignment of a trade mark by its applicant during pendency of an opposition proceedings, then applicant loses its right to maintain any petition and in the instant case, since only Solvay Pharmaceutical participated in the proceedings and the applicant for registration of trade mark, as such Galderma has no say in the matter and it cannot be impleaded or substituted as respondent.

IPAB noted that the assignment of the subject mark has been done in favour of Galderma and the records of the register had also been updated accordingly. IPAB also noted that Hygienic Research was aware of the assignment even



before the order which is being assailed in the present appeal was issued. In view of the above, IPAB held that Galderma was a necessary party to the present appeal and impleaded them as respondent.

## 6. Appeal dismissed based on finding that goods were dissimilar

*Koninklijke Philips Electronics NV v Kay Kay Home Appliances Pvt Limited and Anr. [OA/78/2004/TM/DEL, Order No.157 of 2015]*

Appellant had challenged the order of the Deputy Registrar dismissing its opposition against Respondent's application for registration of PHILIPS in Class 11 for hurricane lanterns. Respondent was not present before the Intellectual Property Appellate Board (IPAB) and the matter proceeded ex-parte. Appellant's main ground in appeal was PHILIPS was a well-known trademark and argued that if Respondent's mark is allowed to be registered it will cause confusion in the market as Appellant also deals in lighting goods and apparatus.

IPAB noted that Appellant's products are operated exclusively through electricity, whereas Respondent had specifically averred that it is exclusively dealing in Hurricane lanterns which are to be used for lighting and uses kerosene. IPAB was of the opinion that use of Respondent's products would be negligible in today's age and therefore the likelihood of confusion is extremely low. IPAB noted that the products of Appellant are totally different from Respondent and the consumers are also different. In addition, IPAB observed that Appellant had admitted that it is not manufacturing similar goods like Hurricane Lantern manufactured by Respondent. On the basis of above, IPAB held that there were no grounds for interfering with the decision of the Deputy Registrar and dismissed the appeal.

## 7. Irregularity found in Registrar's order and appeal allowed

*Qualcomm Incorporated V Immobiliengesellschaft Helmut Fischer GmbH + Co. Kg [OA/5/2008/TM/KOL, Order No.169 of 2015]*

The present appeal has been filed in relation to a request for amendment of date of use in the opposition filed by Appellant against the

trademark application filed by Respondent. Appellant had claimed prior use in the opposition and the amendment request on Form TM-16 was filed thereafter by Respondent claiming itself to be the prior user. According to Appellant, while deciding on the amendment request, the Deputy Registrar had gone into the merits of the case, which would cause grave prejudice to Appellant as fair process requires both parties to be provided an opportunity to be heard. In the appeal, Appellant prayed that the order allowing the amendment request be set aside. Respondent claimed that the request for amendment of use was filed much prior to the date of opposition and about four months after the application for registration was filed.

IPAB observed that there was no irregularity in filing of the amendment request by Respondent. However, IPAB noted that the impugned order had serious infirmities as the Deputy Registrar had gone into the merits of the case regarding prior use of the trademark. IPAB was of the opinion that fair process requires that after the amendment, the application ought to have been published and an opportunity ought to have been provided to both parties to put forth their respective claims and thereafter, a decision ought to have been arrived at by Registrar. Consequently, IPAB set aside the portion of the order that included Registrar's observations on prior use of the mark and directed that the application be advertised again with the amended date of use and the matter ought to proceed in accordance with law by affording both parties an opportunity to put forth their claims.

## 8. Rectification of ELBAIK mark allowed on grounds of non-use

*Abdul Rasheed and Ors. v El Baik Food Systems Co., S.A. [ORA/273 & 274/2009/TM/DEL, Order No. 212 of 2015]*

Applicants had filed two rectification applications for removal of Registered Proprietor's registered trademarks ELBAIK (Hat Device) and ELBAIK (Label) in class 29 and class 42 on grounds of non-use and lack of bonafide intention to use. Applicants claimed that Registered Proprietor had not continuously used the said marks since registration of the marks in 2006 and 2007 respectively. Applicants claimed that they were the proprietor of the trademark AL-BAKE which



they had been using continuously since 2001 and their application for registration of AL-BAKE was pending. Applicants submitted that Registered Proprietor had filed a suit for trademark infringement and passing off against them in the civil court of Kozhikode, in which an interim injunction was granted which restrained Applicants from using their mark AL-BAKE. Applicants had filed an appeal against the civil court's order before the Kerala High Court, which was pending. Registered Proprietor claimed that it was the prior use of the mark ELBAIK and had used the marks in India prior to registration. After registration, although there were no physical outlets for its product under the ALBAIK marks in India, Registered Proprietor claimed that substantial section of the people in India were aware of the name and fame of its products. Registered Proprietor claimed that the rival marks were similar and in respect of identical goods, which had been recognized by the civil court of Kozhikode and the injunction was granted in its favour.

IPAB noted that Registered Proprietor had not used the registered marks in India and had made only a feeble attempt to claim that it had bonafide intention of using its marks but had not produced

any substantial evidence to support such claim. According to IPAB, Applicant's mark AL-BAKE was distinguishable from ELBAIK of Registered Proprietor and IPAB was of the opinion that the issue of confusion would only arise if the marks in question were being used. IPAB also observed that the argument that the rectification applications were premature since the period of five years from the date of registration had not elapsed cannot be considered since Registered Proprietor had categorically stated in its counter statement that it had no physical presence in India. IPAB observed that use of the trademarks in foreign jurisdictions will not aid in the rectification action against such mark based on non-use. IPAB was of the view that applicants were entitled to invoke section 47 (1)(a) of the Act at the time of preferring the applications, and they were entitled to place reliance on 47(1) (b) of the Act as the period of five years had lapsed as on date of adjudication of the rectification proceedings, and Registered Proprietor had miserably failed to establish even its bonafide intention to use the impugned trademark. Accordingly, IPAB allowed the rectification applications and directed removal of the impugned registered marks from the register. ■

## Case Summaries of Copyright Decisions : 2015 - 2016 The Courts

### 1. Carrying on business through exclusive reseller is not sufficient to confer territorial jurisdiction

**THE FOUNDRY VISIONMONGERS LTD. VS SATYANARAYANA REDDY S & ANR.**

*3<sup>rd</sup> September 2015, Delhi High Court*

**FACTS:** Plaintiff had filed the present suit claiming infringement of its copyright in various software programs with the principal program being titled NUKE. Plaintiff's software programs are used with respect to picture film, animation, commercials, and broadcast post-production. Plaintiff alleged that Defendants were violating Plaintiff's Copyright by using the software programs without obtaining the requisite licence from Plaintiff.

**CONTENTIONS:** Defendants were both based in Hyderabad. Plaintiff had invoked the territorial

jurisdiction of the Delhi High Court claiming that it was conducting its business through its exclusive reseller who was based in Delhi and within the territorial jurisdiction of the Delhi High Court. The Delhi High Court had to determine whether the presence of an exclusive reseller within the territorial limits of the court was sufficient to determine that the Plaintiff was also carrying on business within the territorial jurisdiction of the High Court. Plaintiff argued that at the preliminary stage, the contents of the complaint must be considered to be true and once that is done, Plaintiff had to be considered to be carrying on business in Delhi through its exclusive reseller.

**HELD:** The Single Judge observed that the exclusive reseller in question was a completely separate legal entity, over which Plaintiff had no control. In order to exercise territorial jurisdiction

within Delhi, Plaintiff had to have some control over the entity who was actually carrying on the business within Delhi. The Single Judge ruled that the cause of action having arisen in Hyderabad where the Defendants reside and there being no evidence of infringement within Delhi, the suit had to be returned and placed before a competent court.

## 2. SAP successfully prevents Indian entity from infringing its software copyrights

*Sap Aktiengesellschaft & Anr. vs Appson Consulting India (P) Ltd  
27<sup>th</sup> July 2015, Delhi High Court*

**FACTS:** Plaintiff is the proprietor of a range of ERP software which help businesses to reduce costs and ensure maximum utilization of available resources. Plaintiff's products are not available off the shelf or through authorized resellers. Also, the software products are not bundled with any computer hardware vendors as an Original Equipment Manufacture. Plaintiff has purpose-specific versions of its software. It enters into license agreement with its customers for specific use and the license agreements expressly prohibits the software from being used in any other manner or for any other purpose. Plaintiff had filed the present suit against Defendant claiming infringement of its copyright in its proprietary software.

**CONTENTIONS:** Plaintiff claimed that Defendant was infringing its software and violating its exclusive rights in the software by imparting training programme of the Plaintiff's software in an illegal and unauthorized manner. At the initial stage, an ex-parte interim injunction was granted to Plaintiff.

Plaintiff claimed that it came across Defendant in 2008. Plaintiff found that it had not entered into any agreement with Defendant allowing them to offer training programs in its software. Plaintiff submitted that it had also lodged a criminal complaint against Defendant.

Defendant did not appear before the High Court despite being notified and the matter proceeded ex-parte.

**HELD:** The Court considered the arguments and the evidence submitted by Plaintiff, which remained unchallenged. On that basis, the Court issued a decree of permanent injunction restraining Defendant from dealing in Plaintiff's proprietary software in any manner. The Court also awarded punitive damages of Rs. 3 Lakhs \*(US\$ 4400 approx.) to be paid by Defendant to Plaintiff.

## 3. Bollywood Producer forced to concede Author's copyright over screenplay

*Jyoti Kapoor And Anr vs Mr.Kunal Kohli And Ors  
19<sup>th</sup> May 2015, Bombay High Court*

**FACTS:** Plaintiff is a professional film and screen writer who had conceptualized the story and theme of a new and original screenplay for a romantic comedy under the working title 'R.S.V.P.'. After registering her plot and story with the Film Writers' Association (FWA), Plaintiff approached the Defendant, a director of repute for production of a cinematographic film based on the screenplay. However, the parties could not arrive at an agreement and the negotiations failed. Thereafter, Plaintiff approached another production house (2nd Plaintiff), who agreed to produce the feature film and commenced working on the project. It was at this stage that Plaintiff came across newspaper articles about a new film to be launched by Defendant. From the articles, Plaintiff found that Defendant had utilized her original screenplay for making his movie. Plaintiff immediately filed a complaint about plagiarization and infringement of her copyright in the screenplay before the FWA and also sent Defendant a cease and desist letter. An arbitration proceeding commenced under a joint dispute settlement committee of Indian Motion Pictures Producers Association ("IMPPA") and FWICE (Federation of Western India Cine Employees) However, Defendant refused to sign the arbitration agreement claiming that he was not the producer of the film and did not disclose the name of the producer. The joint committee of IMPPA and FWICE issued a non-cooperation directive against Defendant, who despite such directive, went on with the production of the movie. Aggrieved, Plaintiff approached the Bombay High Court seeking an injunction against the release of Defendant's film

based on her original screenplay.

**CONTENTIONS:** Plaintiff claimed that Defendant had made unauthorized use of her original screenplay to produce the film, 'Phir Se', without Plaintiff's consent. Plaintiff claimed that the screenplay was disclosed to Defendant under circumstances of confidence, and complained that Defendant was guilty of both breach of confidence and infringement of copyright. Defendant claimed that he had commenced working on the feature film even prior to his meeting with Plaintiff and claimed that the film 'Phir Se' is not an infringing copy of the screenplay or script of 'R.S.V.P.', as there were various dissimilarities between the respective screenplays of 'Phir Se' and 'R.S.V.P.', vis á vis the setting, the treatment and the climax etc. With regard to the similarities in the plot, or characters or dramatic conflict were not attributable to the use of the confidential information shared by Plaintiff with the Defendant, but was based on public knowledge or what is available in public domain and over which the Plaintiff cannot claim any right.

**HELD:** The Bombay High Court was of the opinion that the script of R.S.V.P could be considered as new and unique and was capable of being protected both as copyright and confidential information. The matter being at the interim stage, Bombay High Court found that on a preliminary basis, Plaintiff had an arguable case that Defendant had actually used or caused to be used the screenplay/script of 'R.S.V.P.' shared with him by Plaintiff, for producing the film 'Phir Se'. Based on such finding, The Court issued the order for preliminary injunction as requested by Plaintiff.

Both parties subsequently filed appeals before Supreme Court against the order of the Bombay High Court. However, during the proceeding, the parties were able to arrive at a settlement whereby Defendant agreed to a) acknowledge Plaintiff in the credits of the film 'Phir Se' by stating 'Story Idea : by Jyoti Kapoor', b) Defendant agreed to pay a sum of 25 lakhs \*(US\$ 36700 approx.) to Plaintiff and c) Defendant also agreed to withdraw a defamation suit filed against Plaintiff before the City Civil Court in Dindoshi, Mumbai. In view of the above, Plaintiff on her part agreed

not to make any further claim regarding the film 'Phir Se'. Accordingly Supreme Court took on record the settlement between the parties and disposed off the appeals. The suit before the Bombay High Court was also dismissed as a part of the settlement.

#### 4. IIFW obtains injunction against Youtube over illegal broadcast of MASTERCLASS

*Indian Independent Filmmakers Worldwide Association (IIFW) v Youtube LLC  
Bombay High Court*

**FACTS:** Plaintiff is an association of independent film makers formed with the object of promoting, supporting and nurturing independent cinema by filmmakers of Indian origin anywhere in the world. In 2010, Plaintiff created a concept of a not for profit project, the "IIFW MASTERCLASS" as an initiative to share knowledge acquired by reputed film makers over their professional journeys with aspiring film makers and film enthusiasts. The first season of IIFW MASTERCLASS was recorded and televised as a cinematographic film on the National Geographic TV channel. The series being successful, Plaintiff recorded a second season and tied up with several TV channels, producers, advertisers etc. for broadcast of the second season. Plaintiff also obtained permission from the Federation of Indian Chambers of Commerce & Industry (FICCI), under whose auspices the "MASTERCLASS" was conducted, which confirmed that no filming or broadcasting by any other entity was to be allowed during the session of IIFW MASTERCLASS. However, Plaintiff found that an infringing copy of the first episode of the second season of the MASTERCLASS, which had been launched at the FICCI FRAMES 2015, had been illegally uploaded and broadcast over Youtube website.

**CONTENTIONS:** Plaintiff contended that the recording of the first episode of Season 2 of MASTERCLASS which was available on Youtube constituted infringement of its copyright in the cinematographic work of MASTERCLASS. Defendant was not present before the High Court despite being notified of the suit, and the case was proceeded ex-parte.

\* (INR 1 = US\$ 68 approx.)



**HELD:** The High Court held that Plaintiff had successfully made out a case for copyright infringement and issued an ex-parte preliminary injunction against Defendant.

### 5. Suit dismissed due to misjoinder of Defendants and causes of action and non payment of separate Court fees

*Microsoft Corporation & Anr. vs Sujan Kumar & Ors  
23<sup>rd</sup> December 2015, Delhi High Court*

**FACTS:** The present suit had been filed by Microsoft, a US based software company against five parties who were allegedly involved in the violation of Plaintiff's copyright in its software. The five defendants were five separate legal entities entirely different from each other, wherein each Defendant was said to infringing Plaintiff's copyright independently.

**CONTENTIONS:** Plaintiff defended its filing of a single suit against five parties under the following grounds – (a) Defendants are sister companies and are under same management (b) Defendants operate out of the same address and (c) Plaintiff had sought appointment of a Local Commissioner whose function would be to take custody of hardware containing Plaintiff's software illegally used by Defendants and if such prayer is granted, confusion and difficulty would have been caused with respect to these seized hardware in case separate suits were filed, unless and until the defendants are joined together in one suit.

**HELD:** The Single Judge observed that from the memo of parties it was evident that Defendants were completely separate companies and therefore, different legal entities. The averments by Plaintiff alleging violation of copyrights were vague as it did not provide sufficient information as to which Defendant was violating which

software of Plaintiff and the basic cause of action was that Defendants were violating Plaintiff's copyrights in its software. According to the High Court, joinder of causes of action is allowed provided that if separate defendants are joined in one suit with their separate causes of action, then common questions of law and fact arise with respect to the defendants who are joined in one suit. The Single Judge opined that merely because Defendants were under the same management or are sister concerns or are operating from the same address cannot mean that there are common questions of law and facts. Judge stated that common questions of law and facts were connected with the averments regarding the causes of action and Plaintiff's rights and violation thereof by Defendants, none of which were specifically spelt out in the complaint. Judge noted that joinder of causes of action and defendants is not complete unless it is stated as to which would be the common questions of facts and law relevant to each of the defendants who are joined in the suit, and a pleading which simply reproduces the legal language of the relevant provisions, i.e., Order I Rule 3 and Order II Rule 3 CPC, cannot mean that requirements of law stands complied with. Delhi High Court found Plaintiff's reasoning for filing of a common suit to be utterly frivolous. High Court observed that joinder of causes of action also results in loss of revenue as parties instead of paying separate court fees for each suit were filing a single suit against multiple parties and paying a single amount of court fee which was not permissible.

Accordingly, Delhi High Court dismissed the suit on the ground of mis-joinder of Defendants and causes of action and also because separate court fee had not been paid with respect to each Defendant and each cause of action as is the norm. ■

## Case Summaries of Patent Decisions : 2015 - 2016 Intellectual Property Appellate Board (IPAB)

### 1. Patentee must be given opportunity of being heard

*Hindustan Unilever Limited v The Controller of Patents & Designs, Mumbai and Ors  
[OA/74/2012/PT/MUM, Order No.142 of 2015]*

Appellant Hindustan Unilever Limited, was the

proprietor of Patent No.198316. An application for revocation of the said patent was filed by Eureka Forbes Ltd. The Assistant Controller allowed the revocation application, which was appealed by Appellant before the Intellectual Property Appellate Board (IPAB). The main

ground of appeal as stated by Appellant was that the Asst. Controller had not furnished a copy of the Board of Examination recommendations or objections either to Appellant or Respondent and Appellant was prevented from replying to the objections/ recommendations and the impugned order was issued in violation of natural justice. The IPAB ruled that the provisions of the Patent Act were clear that a patentee had to be given an opportunity of being heard in respect of the recommendations of the Opposition Board. IPAB held that the impugned order had resulted in a grave miscarriage of justice and set aside the order of the Asst. Controller.

## 2. Application for condonation of delay for filing appeal allowed

*Gilead Sciences Inc, USA v The Assistant Controller General of Patents & Designs and Anr. [S.R. No. 32/2011/PT/DEL, Order No. 7 of 2015]*

Petitioner, Gilead filed an application for condonation of delay of twenty months for filing an appeal against the order of the Patent Controller dated 23/03/2009 in Indian Patent Application No. 396/DEL/1996. Gilead submitted that in 2009 when the application for condonation of delay was filed, there was legal uncertainty regarding appeals against pre-grant oppositions as there is no specific provision under the Patent Act providing for such an appeal. Accordingly, Gilead had filed a review petition against the impugned order on 24<sup>th</sup> May 2009. However, the Delhi High Court had, in the meantime ruled that as per provisions under the Patent Amendment Act, 2005 orders passed in relation to pre-grant oppositions under section 25(1) were relatable to an order passed by the Controller under section 15 which is appealable.

The review petition filed by Gilead was finally rejected on 4<sup>th</sup> November 2010, and Gilead, therefore, argued that the period for calculating the time for filing the appeal should commence from the date of rejection of the review petition and thus, the appeal filed by Gilead was within the period of limitation. However, if the limitation period is calculated from the date on which the impugned order was issued, then there was a delay of 20 months, which Gilead requested the

IPAB to condone since there was a justified reason for such delay.

On the other hand, respondent - Meditab Specialities Pvt. Ltd., argued that the delay in filing appeal was due to negligence, since Gilead did not file the appeal immediately after the Delhi High Court issued the decision, but waited for one year for filing the appeal. Thus, respondent contended that there was no valid reason for the delay, and accordingly, the appeal filed ought to be rejected for being filed beyond the limitation period.

The IPAB observed that even after the Delhi High Court clarified the legal position, the IPAB was not entertaining appeals against pre-grant oppositions at that relevant time and it was only after the IPAB issued an order in 2010 regarding maintainability of appeals against pre-grant opposition decisions, that the legal position was clarified. The IPAB was of the opinion that the delay cannot be held against Petitioner in this case, and allowed the application for condonation of delay in filing the appeal.

## 3. Period of limitation for filing appeal to be continued from date of receipt of the order

*Microsoft Corporation v The Assistant Controller General of Patents & Designs [Sr. No.350/2014/PT/DEL, Order No.86 of 2015]*

Petitioner Microsoft Corporation's appeal was filed beyond the limitation period of three months under Section 117(A) of the Patent Act, 1970. Petitioner submitted that they had to wait for a copy of the order and had filed the appeal within three months of receipt of the order. The IPAB had to decide whether the prescribed time limit of 3 months for filing an appeal from the date of the decision under Section 117A(4) was to be construed as from the date of the receipt or communication of the order or decision. IPAB held that the principle of construing the period of limitation contemplated under Section 117A(4) had to be construed as three months from the date of communication or receipt of the order. Accordingly, the appeal was held to be not barred by limitation and maintainable.



#### 4. IPAB allows additional documents as evidence

*Wockhardt Ltd v Novartis AG and Controller of Patents [ORA/21/2013/PT/CH, Order No. 49 of 2015]*

Wockhardt had filed an application for revocation of Patent No.212815 granted in the name of Respondent, Novartis. In the revocation proceeding, Wockhardt filed a petition requesting the Controller to accept additional grounds for revocation as well as additional documents as evidence. Novartis filed an application requesting the Controller to reject Wockhardt's application for additional grounds and evidence. Wockhardt alleged that Novartis had filed a patent infringement suit against Wockhardt. During the suit proceeding, Wockhardt came to know that Novartis had suppressed material facts about filing of patents involving the active ingredient Vildagliptin which were not informed to the Patent Office under **Section 8** of the Patent Act. Wockhardt wished to rely on such information and evidence, and argued that the impugned patent ought to be revoked. Novartis argued that a fresh pleading by an applicant for revocation was not permissible under the applicable legal provisions.

IPAB however, decided to take the additional documents on record holding that they were already in the public domain, but stated that such additional documents were accepted on the condition that reasonable opportunity was to be provided to Novartis to respond to the allegations

of revocation for non-compliance of the provisions of **Section 8** of the Act.

#### 5. Patent Applicant to be allowed to furnish further documents to satisfy patentability requirements

*Janssen Pharmaceutica N.V. v Controller General of Patents and Designs [OA/34/2011/PT/DEL, Order No. 84 of 2015]*

The present case relates to an appeal filed by Janssen Pharmaceutica against the order of the Controller refusing Patent Application No.2821/DELNP/2005 on the grounds under **Section 3(d) and 3(e)** of the Patents Act, 1970. Appellant argued that the Assistant Controller has proceeded on misconception and ignored the materials produced by Appellant and arrived at the wrong conclusion that the provisions under **Section 3(d) and 3(e)** of the Act were applicable to the claims made by Appellant.

Upon examination of the matter, the IPAB found that the Controller had acknowledged the novelty and inventive step of the subject invention and also held that the cited prior art citation was irrelevant to the proceeding. Despite that, the Controller had chosen to refuse the patent application under **Section 3(d) and 3(e)** of the Act. IPAB held that the Controller was duty bound to furnish the exact gist of the objections to Patent Applicant and in the event of any deficiency, it was incumbent that an opportunity was provided to the Patent Applicant to furnish further

#### Section 8

Information and undertaking regarding foreign applications

(1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application or subsequently within the prescribed period as the Controller may allow—

(a) a statement setting out detailed particulars of such application; and

(b) an undertaking that, up to the date of grant of patent in India, he would keep the Controller informed in writing, from time to time, of detailed particulars as required under clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.

(2) At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of a patent made thereon, the Controller may also require the applicant to furnish details, as may be prescribed, relating to the processing of the application in a country outside India, and in that event the applicant shall furnish to the Controller information available to him within such period as may be prescribed.

#### Section 3

The following are not inventions within the meaning of this Act,—

(d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

(e) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance



specification or documents to satisfy the requirements contemplated under the Act involving patentability of the invention.

## 6. Extension filed before amendment of Rule, allowed

*Tryton Medical Inc. v Controller General of Patents and Designs*

*[OA/10/2014/PT/DEL, Order No.79 of 2015]*

Tryton Medical filed this appeal against the order dated 2<sup>nd</sup> July 2013 of the Patent Controller refusing its petition for condonation of delay and extension of time for filing the National Phase Application beyond the prescribed period of 31 months. Tryton contended that the prescribed period of 31 months expires on 2<sup>nd</sup> February 2012 if it is calculated from the International Application date ie. 2<sup>nd</sup> July 2010 (in USA) and as a result there is a delay of 8 days in filing the National Phase application. Applicant submitted that delay was caused unintentionally as a result of a docketing error by its Patent Agent, and requested that the Controller exercise his power to extend the prescribed time period by one month granted under Rule 138. IPAB agreed with the Applicant that the Controller did have the power to extend the prescribed time limit of 31 months by a further period of 1 month under Rule 138 and found that in the impugned order, the Controller had omitted to assign any reason for overlooking Rule 138. IPAB noted that Rule 138 underwent an amendment on 15<sup>th</sup> October 2013 and presently no further extension is available once the prescribed period of 31 months is over. However, in the present case, the pre-amended Rule 138 was applicable and hence, IPAB allowed the appeal and directed the Controller to examine the patent application in accordance with law.

## 7. Controller's objection found based on figment of imagination

*Pfizer Inc. v Controller General of Patents and Designs*

*[OA/30/2011/PT/DEL, Order No.85 of 2015]*

Pfizer filed the instant appeal against the order of the Patent Controller refusing its application No.1154/DEL/1997 for the grant of patent for the compound "Ziprasidone mesylate trihydrate". Pfizer submitted that the application was objected to by the Controller based on the provisions of

**Section 3(d)** of the Act and the said objections were responded to by Pfizer through substantial documentary evidence. Thereafter, the Controller refused the application on the basis of objections under **Section 3(d) and 3(e)** of the Act. Appellant submitted that the subject invention was in respect of the molecule "Ziprasidone mesylate trihydrate". However, the Controller held that the closest prior art compound as "Ziprasidone mesylate monohydrate", which compound was non-existent and such prior art was not available. Appellant contended that since the Controller had considered the wrong prior art compound while refusing the application, the entire order is vitiated due to the non-application of mind and misconception. IPAB agreed with Appellant's contention that the prior-art compound was a figment of the Controller's imagination as a result of which the order was vitiated. IPAB also noted that the Controller had not considered any of the materials furnished by Appellant to show that the product in question had enhanced efficacy and was, therefore, not hit by the provisions of Section 3(d) of the Act. Accordingly, IPAB allowed the appeal and set aside the impugned order of the Controller and directed the Controller to examine the matter afresh and pass orders on merit within 5 months.

## 8. Controller's order found to contain procedural lapses

*Cima Labs Inc. v Controller General of Patents and Designs*

*[OA/2/2013/PT/KOL, Order No.38 of 2015]*

Cima Labs filed the instant appeal against the order of the Patent Controller rejecting its patent application No.1818/KOLNP/2006. Appellant submitted that there were a number of procedural lapses and non-consideration of dependant claims by the Controller and argued that the impugned order ought to be set aside and the application ought to be considered afresh.

Upon detailed consideration of the matter, IPAB found that the Controller had not considered the entire claims made by Applicant coupled with the objections raised at the hearing. IPAB also noted that the objections raised in the first examination report were not found in either the second examination report or the hearing notice. IPAB held that once objections have been raised in an

examination report and Applicant had responded to the same, the absence of the objections from the second examination report would mean that the objections had been waived. However, the Patent Controller had examined the application with respect to the same objections and rendered his findings which has vitiated the entire proceeding. IPAB set aside the order and directed the Controller to hear the matter afresh.

## 9. Controller's order found violating principles of natural justice

*Lupin Ltd v Controller General of Patents and Designs [OA/56/2012/PT/MUM, Order No.127 of 2015]*

Lupin filed the present appeal against the decision of the Controller refusing its Patent Application No.1500/MUMNP/2006 filed on 6<sup>th</sup> December 2006. Appellant contended that the Patent Controller had failed to consider the subsequent amendments to the claims filed by it and thus the order was liable to be set aside. IPAB noted that although the Controller had referred to the subsequent amendments in the impugned decision, but from a reading of the entire order, it appeared that there was no consideration of such amended claims. Holding that the order violated the principles of natural justice, IPAB set aside the order and directed the Controller to consider the matter afresh vis à vis the amended claims and issue a reasoned decision within 6 months.

## 10. Matter remanded to the Patent Controller to allow Applicant to present its case

*Tibotec Pharmaceuticals Ltd. V Controller General of Patents and Designs [OA/24/2011/PT/DEL, Order No.82 of 2015]*

Tibotec Pharmaceuticals had filed the present appeal against the order of the Controller refusing its patent application No.2122/DELNP/2006 filed on 19<sup>th</sup> April 2006 in respect of an invention titled "A Process for preparing compound of formula 6 (3R, 3AS, 6AR) Hexahydrofuro [2, 3-B]Furan-3-yl (1S, 2R)-3-[(4-aminophenyl) sulfonyl] (i s o b u t y l) a m i n o ] - 1 - b e n z y l - 2 - hydroxypropylcarbamate." The Controller had rejected the application relying on three prior art disclosure, holding that the present invention is obvious and lacking in inventive merit. Appellant's grounds of appeal were based on

mainly two issues (a) that its patent application was not vitiated by lack of inventive step and the prior art cited by Patent Controller were not in relation to the present invention, and (b) violation of natural justice owing to procedural lapses. Appellant submitted that the first examination report mainly contained some procedural objections and none of the prior art were cited either in the examination report or in the first hearing notice. It was only in the second hearing notice that the prior art were cited which deprived the Appellant from responding to such citations.

IPAB noted that the Appellant was not provided any opportunity to respond to the objections which were raised suddenly and thus, the order was against the principles of natural justice. IPAB also noticed that some of the prior arts cited were not even mentioned in the subsequent hearing notice but were revealed only in the order under challenge. IPAB remanded the matter to the Patent Controller with the direction that the Applicant ought to be afforded reasonable opportunity to present its case and directed the Controller to issue orders on merit in accordance with law within 5 months.

## 11. Controller's order refusing divisional application, set aside

*National Institute of Immunology v Controller General of Patents and Designs [OA/21/2011/PT/DEL, Order No.83 of 2015]*

The present case involves an appeal against the order of the Controller refusing the grant of Patent under Application No.264/DEL/2005, Sub Divisional Application out of its parent Application No.346/DEL/2001. The Controller had refused the patent application on two grounds - (1) the subject application is invalid as it is derived from a divisional application No.346/DEL/2001 which itself is a divisional application derived from Parent Application No.0008/DEL/1997; (2) the subject application is time barred as per Section 16(1) of the Patents Act, 1970. Appellant submitted that the patent application no. 0008/DEL/1997 was filed in 1997 and its first examination report was issued in 1999 and second examination report was issued in February 2001. In March 2001, Appellant had filed the first divisional application no. 346/DEL/2001. In June 2002, patent no. 186770 was granted on the basis



of application no.0008/DEL/1997, by which time the first divisional application had already been filed. Thereafter, the second divisional application no. 264/DEL/2005 (present application) was filed in February 2005. The first examination report in respect of the second divisional application was issued in September 2006, response to the same was filed in August 2007, and the hearing in respect of the said application was held in September 2007. Appellant submitted that subsequent to the hearing held in respect of the second divisional application, in March 2008, patent no.IN-217322 in relation to the first divisional application (346/DEL/2001) was issued. Appellant also asserted that the second divisional application was filed only because Controller raised the objection that the claims under the first divisional application revealed multiplicity of distinct inventions.

IPAB opined that the Controller's finding that the second divisional application was filed after the grant of the first divisional application (parent patent application to the second divisional application) was patently wrong as proved by the facts of the case. Also, IPAB noted that the second divisional application was necessitated due to the objections raised by the Patent Office in respect of the first divisional application. The IPAB set aside the impugned order and directed the Controller to consider the second divisional application on merits and issue orders in accordance with law within 5 months.

## 12. Controller's order set aside and matter remanded for fresh consideration

*R.P. Scherer Technologies, Inc. v Controller General of Patents and Designs  
[OA/32/2011/PT/DEL, Order No.81 of 2015]*

Appellant filed an appeal against the order of the Controller refusing its patent application No.1993/DELNP/2004. Appellant challenged the order on two grounds – (a) the Controller had not considered a Pharmacokinetic study submitted by Appellant demonstrating bio-equivalence between the vinorelbine soft gel and the comparable dose as an intra-venous injection; and (b) Controller had failed to divulge the prior art on the basis of which the patent application was refused under Section 3(d) of the Act.

IPAB found that both grounds of challenge were prima facie established upon reading the impugned order. Accordingly, IPAB set aside the order and remanded the matter to the Controller for fresh consideration and directed him to issue order on merits within 5 months.

## 13. Controller's order refusing patent in pre-grant opposition, set aside

*Council of Scientific and Industrial Research v Hindustan Lever Limited and Assistant Controller of Patents and Designs  
[OA/37/2013/PT/DEL, Order No.133 of 2015]*

Appellant/CSIR challenged the order issued by the Controller refusing the grant of patent application no.1219/DEL/2004 for "Iodizing Agent and process for preparation thereof", pursuant to a pre-grant opposition filed by respondent – Hindustan Lever, who later informed the IPAB that they were not interested in pursuing the opposition as they had ceased to have any commercial interest in the subject invention. The patent application was opposed for being anticipated by prior art, for being publicly known before the priority date, for not involving any inventive step, not being an invention, not disclosing the invention sufficiently and for being non-compliance of the provisions of Section 8 of the Act. Appellant submitted that the impugned order was unreasonable, arbitrary and did not consider the evidence submitted by Appellant.

On detailed analysis of the materials on record, IPAB concluded that the invention in question was different from the cited prior art and as such the process is novel, inventive and non-obvious. Accordingly, IPAB set aside the impugned order and directed the Controller to grant the patent as claimed by the Appellant in its application no.1219/DEL/2004 within a period of 2 months.

## 14. Patentee has no locus standi to interfere in proceedings for grant of compulsory licence

*Lee Pharma Ltd. v Astrazeneca AB  
[CLA 1 of 2015]*

Lee Pharma (Applicant) filed a request seeking grant of a compulsory license for manufacturing and selling the compound SAXAGLIPTIN which



is protected by Patent No.206543 owned by Bristol-Myers Squibb (BMS). The patent had been assigned by BMS to Astrazeneca AB. The grounds for seeking the compulsory license were (a) reasonable requirements of the public were not being met; (b) patented invention was not available to public at reasonably affordable price; and (c) patented invention was not being worked in India.

At the preliminary stage, the Controller refused to grant Applicant's request holding that, (i) there were other substitutes for SAXAGLIPTIN and in the absence of relevant information how SAXAGLIPTIN was a better treatment option from such substitutes and information about the quantum of such substitutes in the market, it was not possible to hold that reasonable requirements of public had not been met, (ii) comparison of the price points at which Astrazeneca was selling SAXAGLIPTIN and the price points at which Applicant sought to offer the product were not sufficiently disparate to hold that the patented product was not being offered to public at reasonably affordable rates; and (iii) manufacture is not a necessary precondition for working of a patent and on this ground only it could not be held that the patent was not being properly worked in India.

Subsequent to the initial refusal, Applicant filed a request for hearing. Respondent also filed a request seeking intervention in the proceedings. Both parties were present on the date of hearing and submitted their arguments before the Controller

Respondent's request for intervention was refused by the Controller holding that there was no provision in the Patent Act which required the Patentee to be heard before a final determination is reached regarding the application for compulsory license. The Controller was of the opinion that if and when such decision is issued, the patentee or any other person may file a notice of opposition to application for compulsory license. Controller held that prior to such determination, patentee had no locus standi to intervene in the proceedings and Astrazeneca's request for intervention was not maintainable and dismissed.

With regard to Lee Pharma's application, after considering the arguments, Controller held that the Applicant had failed to make out a case for grant of compulsory license and could not establish any of the grounds mentioned in Section 84(1) of the Act. Accordingly, Lee Pharma's application for grant of compulsory license for SAXAGLIPTIN was rejected by the Controller. ■

## Case Summaries of Patent Decisions : 2015 - 2016 The Courts

### 1. Glenmark successfully challenges Symed's Process Patent Infringement Claim

*Glenmark Pharmaceuticals and Anr. v Symed Labs Ltd.  
5<sup>th</sup> February 2015, Delhi High Court*

**FACTS:** Symed Labs had developed an economical, safe and commercially viable process for preparation of *Linezolid* involving novel intermediates and had been granted two patents (IN '062) and IN213063 (IN '063). Symed filed a suit against Glenmark claiming that it had manufactured Linezolid in a manner which resulted in the infringement of its two granted patents. Glenmark deals in the manufacture and supply of both active pharmaceutical ingredients (APIs) and finished doses forms of various pharmaceutical formulations.

**CONTENTIONS:** In December 2012, Symed learned that Glenmark was manufacturing Linezolid in finished dosage forms. Symed collected samples of the product being manufactured and sold by Glenmark, and on testing them, found that the samples contained PHPFMA and Zodiac-4. According to Symed, the presence of the novel intermediates CHFA, Zodiac-4 and PHPFMA is indicative of the fact that the Linezolid was manufactured using the process patented by it since there was no possibility of these intermediates being formed if the prior art processes were being used. Glenmark contested the suit claiming that the processes as well as the intermediates claimed in the suit patents were not novel and had been known in the pharmaceutical industry for a long time prior to the Symed's alleged development

of the process or the intermediates.

**HELD:** The Single Judge of Delhi High Court granted an interim injunction order restraining Glenmark from dealing in and the production of Linezolid in any manner so as to result in the infringement of the suit patents IN '062 and IN '063.

Glenmark filed an appeal against the above order before the Appellate Bench of the Delhi High Court. In the appeal, Glenmark urged two issues mainly – (a) that prior commercial use of the product before filing of the process patents would not entitle the patentee to injunction, subsequently; and (b) Single Judge had not gone into the applicability of Section 104A(1)(b) raised by it, which states that the onus was on Patentee/Plaintiff to prove that the product of the Defendant/Appellant was identical to the product of the plaintiff/respondent, and had been directly obtained from the patented process.

The Appeal Court held that in the impugned order there was no discussion on the applicability of Section 104(A), and there was also no prima facie finding that the two products were identical. Regarding the presence of the novel intermediates as proved by the lab tests, the Appellate Bench observed that the lab reports in question indicated the presence of 3 intermediates i.e., CHFA, Zodiac-4 and PHPFMA. However, the Appellate Court observed that the processes patented under IN '062 and IN '063 only result in Linezolid API with two of the markers in each case, namely, and ZODIAC-4 in the case of IN 213063 and CHFA and PHPFMA in the case of IN 213062, which indicated that the processes used were different.

## 2. Writ petition seeking to restrict division of patent applications dismissed

*The Delhi Network Of Positive People vs Union Of India & Ors  
7<sup>th</sup> May 2015, Delhi High Court*

**FACTS:** The Petitioner, Delhi Network Of Positive People filed a Public Interest Litigation to secure the rights of patients living with HIV/AIDS and to ensure ease of access to medicines such as Anti-retrovirals (ARVs) which can help

treat HIV. The ARVs are patented medicines and multi-national companies who own the patents had adopted the practice of filing multiple patent applications relating to a single medicine, which puts such medicine out of reach to people suffering from HIV/AIDS. In a bid to prevent multiple patenting, Petitioner had been filing pre and post grant oppositions against the patent applications to ensure that such medicines remain unpatented. However, Petitioner observed that multi-national companies had adopted another practice to keep the patent applications pending, by filing a divisional patent application based on an earlier filed patent application, which results in the patent over a particular medicine remain active over a longer period of time (evergreening).

**CONTENTIONS:** Petitioner sought a number of directions from the Delhi High Court to prevent abuse of process in filing of divisional patent applications such as (a) Patent applicant to file a declaration at the time of filing a divisional application that the parent application discloses multiple inventions not constituting one single inventive concept and that the claims of the divisional applications are not identical to that of the parent applications; (b) Controller General not to examine and process divisional patent applications on merits until the existence of jurisdictional fact and their maintainability as divisional patent applications are first determined; (c) Controller General to reject all divisional applications with claims identical to that of the parent applications, without hearing the applicant on substantive issues of patentability; (d) Controller General to identify patent applicants who have abused the process and take action against them; and, (e) Controller General to ensure that in every patent application there is an undertaking that there is no other application filed in respect of the same inventive concept and in the event of the divisional applications, Controller has to decide without issuing notice whether claim is related to same inventive concept and if so, to reject such an application.

In response, the Controller of Patents stated (i) that there is no provision in the Act that prohibits any person from filing a divisional application at the Patent Office; (ii) that under Section 11B when a request for examination is made in respect of any patent application, the same is referred by

Controller for making report and the issue of allowability or refusal of said application is considered based on the report of the said examination; (iii) that the amendments already carried out to the Patents Rules pursuant to the representation of the Petitioner are sufficient to address the concern of the Petitioner; (iv) action has also been initiated with respect to the specific complaints filed by the Petitioner; and, (v) that out of the 17 divisional patent applications, 16 have been either refused or abandoned or withdrawn and only one divisional patent application had proceeded to grant of patent.

**HELD:** The High Court noted that Petitioner sought to prevent the abuse of the process of law which would only be possible if the Patent Rules were amended. The High Court ruled that the court cannot in its power of judicial review either legislate or give directions to legislate and such powers have been granted exclusively to the Central Government. The High Court further noted that Petitioner while mentioning instances of the abuse of process had not made any reference to any particular divisional application nor had it made the Patent Applicant a party to the writ proceeding. The High Court ruled that although there was considerable merit in the Petitioner's requests, it cannot operate in vacuum. The Court disposed the writ petition with a direction to the Controller General to treat the writ petition as a representation and take the decision whether amendments to the Patent Rules were necessary or to take appropriate steps to remedy the issues highlighted by Petitioner.

### 3. Glenmark restrained from infringing Merck's Sitagliptin Patent

*Merck Sharp & Dohme Corporation & Anr vs Glenmark Pharmaceuticals Ltd  
7<sup>th</sup> October 2015, Delhi High Court*

**FACTS:** The Plaintiff, Merck Sharp and Dohme Corporation (Merck) is a global research driven company dedicated inter alia to development of medicine for addressing unmet medical needs. Plaintiff invented the molecule SITAGLIPTIN (International Non-proprietary Name) which was commercially sold as JANUVIA and JANUMET used for the treatment of Type-2 Diabetes. When Defendant, Glenmark had started distributing SITAGLIPTIN and SITAGLIPTIN

PLUS METFORMIN under the brand names ZITA and ZITA-MET, Plaintiff filed a suit for injunction alleging patent infringement and seeking to restrain the defendant from dealing in any product infringing the plaintiffs patent for SITAGLIPTIN.

**LITIGATIVE HISTORY:** The suit was filed before the Delhi High Court on 1<sup>st</sup> April 2013, where both parties were present and the matter was argued at length. The Learned Single Judge noted that Plaintiff's patent was in respect of the molecule SITAGLIPTIN and Defendant's product was a combination of SITAGLIPTIN and phosphate. Plaintiff had claimed such combination was still an infringement of its patent since the patent claims contained combination forms within its purview. However, the Single Judge found that Plaintiff had filed separate patent applications for SITAGLIPTIN in combination with phosphate form in USA and India claiming that the new form was different from the original patent for SITAGLIPTIN, and based on such revelation, the Single Judge refused to grant interim injunction.

Plaintiff filed an appeal against the Single Judge's order before the Appellate bench of the Delhi High Court. On appeal, the Appeal Court found that the obligation of disclosure on the applicant under Section 8 of the Patent Act was in relation to all patent applications outside India and not within India. Appeal Court also observed that refusal to grant interim injunction on the basis of a supposed violation of S.8 was too drastic. The Appeal Court held that Plaintiff had prima facie succeeded in showing that its patent for SITAGLIPTIN was valid and that Defendant had infringed it through use of its product ZITA, and set aside the order of the Single Judge. The Court, however, allowed Defendant to sell its products which were already in the market, but restrained it from making any further sale or distribution of the offending product.

Aggrieved, Glenmark filed an appeal before the Supreme Court against the injunction order issued by the division bench of Delhi High Court. The Supreme Court observed that public interest will be best served if Glenmark is allowed to sell its existing stock of ZITA and ZITAMET in order to satisfy market needs. The Supreme Court also



directed the parties to complete their pleadings expeditiously and trial court to hear the matter as soon as possible.

#### **CONTENTIONS IN THE PRESENT CASE:**

In the trial court, the case was heard by the Single Judge for final determination. Based on the rival contentions, evidence of technical experts and the material on record, the Single Judge found that Plaintiff's patents for SITAGLIPTIN were valid and had been infringed by Defendant. On the issue on non-disclosure under S.8, the Single Judge observed that the power to revoke a patent is discretionary and there was no need to exercise such power in this case since the non-disclosure was not found to be deliberate. Finally, the Single Judge restrained Defendant from dealing in *Sitagliptin Phosphate Monohydrate* or any other salt of SITAGLIPTIN in any form, alone or in combination with other drugs infringing the suit patent no. 209816 of Plaintiff.

#### **4. Interim injunction awarded to Bristol-Myers Squibb in patent infringement suit against BDR Lifesciences and BDR Pharma**

*Bristol Myers Squibb v J D Joshi and Anr*  
29th June 2015, Delhi High Court

**FACTS:** Plaintiff is a leading biopharmaceutical company dedicated to discovering, developing and delivering innovative medicines for treatment of serious diseases. Plaintiff is the proprietor of the patent for DASATINIB (International Non-proprietary Name) used in the treatment of adults with chronic, accelerated, or myeloid or lymphoid blast phase chronic myeloid leukaemia (CML), particular form of acute lymphoblastic leukaemia (ALL) called Philadelphia chromosome positive (Ph+) ALL. Plaintiff had filed two suits for infringement of its patent for the DASATINIB molecule.

**CONTENTIONS:** In the first suit against BDR Lifesciences, when Plaintiff came to know that Defendant had applied to the DCGI (Drug Controller General of India) for the marketing approval for DASATINIB, Plaintiff filed a patent infringement suit and was granted an ex-parte interim injunction.

During the pendency of the suit, in 2012,

Defendant wrote to Plaintiff requesting a voluntary license for manufacture and marketing of DASATINIB. When Plaintiff requested Defendant for further details in order to evaluate its request, Defendant was not responsive and obtained a manufacturing license for DASATINIB from the Food and Drug Control Administration, Maharashtra. In addition, Defendant also applied for a compulsory license before the Controller of Patents and started advertising and offering DASATINIB tablets for sale on its website through its sister concern. Plaintiff was apprehensive that Defendant intended to circumvent the interim injunction granted in the first suit and accordingly, filed a second suit, requesting a *qua timet* action against Defendant.

In response, Defendant submitted that BDR Pharmaceuticals and BDR Life Sciences are part of the same group company and are engaged in manufacture of Active Pharmaceutical Ingredients and finished formulations. Defendant challenged the suit patent claiming that it was obvious in view of prior art and lacked utility, and thus, Plaintiff was not entitled for injunction. Defendant also argued that its application for voluntary license was not a bar to its arguments against validity of the patent in a suit for infringement.

**HELD:** Upon evaluation of the rival arguments and the evidence on record, the Single Judge of the Delhi High Court concluded that Plaintiff's patent was valid and the defences raised by Defendant against validity of the patent require further study which cannot be done at the present stage of deciding on the injunction application. The Judge noted that Defendant was yet to launch its products in the market, therefore the balance of convenience was in favour of Plaintiff. With regard to Defendant's arguments that the patented product was not available to public, High Court observed that such arguments form grounds for request for compulsory licence which cannot be imported as a defence in an infringement suit. Based on the above, Single Judge ruled that the interim injunction order granted in the first suit shall also operate in the second suit since the Defendants in both suits were connected parties, and shall continue to operate during the trial. Single Judge made it clear that Defendant was

free to file for fresh applications for grant of compulsory license of the impugned product.

Defendants have filed an appeal against the decision of the Single Judge before the appellate division of the Delhi High Court, which is currently pending.

### 5. Single Judge's order of return of complaint due to lack of territorial jurisdiction, set aside

*United Phosphorus Ltd. vs. Ajay Garg & Anr.*  
28<sup>th</sup> May 2015, Delhi High Court

**FACTS:** Plaintiff had filed the present suit for permanent injunction restraining infringement of Indian Patent Nos.190476 and 202013 against the Defendant. In the suit, an ex-parte interim injunction was issued restraining the Defendant from dealing with the products covered by the suit patents. Defendant filed an application for rejection of the complaint on the ground of lack of territorial jurisdiction.

**CONTENTIONS:** Defendant argued that neither Plaintiff nor Defendant carried on their business within the jurisdiction of the Delhi High Court. Further, Defendant was not selling the impugned product i.e., Acephate, either in Delhi or anywhere in India but only exported the product outside India. Also, Defendant did not advertise its products through its website. Further, Defendant argued that the suit patents were filed, granted and sealed in Bombay outside the jurisdiction of the Delhi High Court. In response, Plaintiff submitted that it had made substantial arguments in the plaint and filed documents to establish that Defendant was carrying on business in Delhi and for the purposes of deciding the present application, only allegations made in the complaint are to be considered and jurisdiction being a mixed question of fact and law should be decided at trial.

**HELD:** On examination of the documentary evidence filed by Plaintiff and its submissions in the complaint, the Single Judge noticed that a number of discrepancies and contradictory statements had been made by Plaintiff. The Single Judge also noted that the ex-parte injunction granted earlier also directed appointment of a Local Commissioner, but Plaintiff did not request

the High Court to direct such Local Commissioner to visit Defendant's addresses in Delhi. The Single Judge ruled that Plaintiff had deliberately tried to mislead the Court and mere reading of the complaint and the documents would show that the Delhi High Court had no territorial jurisdiction since no part of the cause of action had arisen within the territorial jurisdiction of the High Court. Accordingly, the Single Judge directed that the complaint was to be returned to be filed in the appropriate court of jurisdiction.

Aggrieved by the decision of the Single Judge, Plaintiff filed an appeal before the appellate bench of the Delhi High Court. On consideration of the arguments placed by both sides, the Appeal Court held that the averments made in the plaint had to be taken on a demurrer and thus, without looking at the defence of defendants, Appeal Court held that the plaint ought not to have been returned inasmuch since there were enough averments in the plaint to indicate that the Delhi High Court had jurisdiction. Accordingly, both the suit and the application for injunction application filed by Plaintiff, and the application for vacation of injunction order by Defendant were restored. Appeal Court further directed the Single Judge to dispose of the applications for injunction and vacation of injunction expeditiously. The matter is currently pending before the Single Judge.

### 6. Bayer files writ to prevent Natco from exporting products manufactured under compulsory license

*Bayer Corporation vs Union Of India And Others*  
12<sup>th</sup> August 2015, Delhi High Court

**FACTS:** Bayer Corporation is the proprietor of Indian Patent No. 215758 for a pharmaceutical product titled "Carboxyaryl Substituted Diphenyl Ureas". Natco Pharma Ltd., was granted a compulsory licence on 09.03.2012 under Section 84 of the Patents Act, 1970 for manufacturing the pharmaceutical product covered under the patent held by the Bayer Corporation, subject to certain terms and conditions, including that the said licence be used solely for the purpose of making, using, offering for sale and selling the drug covered by the Patent for the purpose of treating HCC (Hepato Cellular Carcinoma) and RCC (Renal Cellular Carcinoma) in human

beings, within the territory of India. Bayer filed a writ petition alleging that Natco was exporting its product “*Sorafenat*” outside India (to China) in violation of the terms of the compulsory licence and requested a direction from the Delhi High Court for confiscation and seizure of the consignments for export containing product covered by compulsory licence including “*Sorafenat*” manufactured by Natco. The Single Judge granted Bayer’s request in part and directed that Natco should not export *Sorafenat*, but at the same time, allowed Natco to seek permission from High Court to export the said drug for clinical purposes, after obtaining permission from the Drug Controlling authority. Accordingly, Natco had sought permission to export “*Sorafenat*” on two occasions, both of which were granted by the Single Judge. Aggrieved by such orders, Bayer filed an appeal before the Appellate Bench of the Delhi High Court.

**HELD:** The issue before the High Court was whether Natco who is holding a compulsory licence for *Sorafenat*, subject to the condition that it shall be used for the purpose mentioned therein within the territory of India, can claim the benefit of Section 107-A of the Patents Act for exporting its product to a country outside India. The Appellate Bench was of the opinion that the original writ petition filed by Bayer was in respect of the same issue, hence instead of hearing the appeal, it was appropriate that the writ petition was disposed off expeditiously within a particular time frame. Accordingly, Delhi High Court Appellate Bench, issued directions to that effect while specifically directing that Natco would not export product “*Sorafenat*” to China for any purpose whatsoever till the disposal of the writ petition.

## 7. Threat of infringement can also constitute a ground for grant of injunction in a suit for patent infringement

*Shilpa Medicare Limited vs  
Bristol-Myers Squibb Company And Ors  
30<sup>th</sup> July 2015, Delhi High Court*

**FACTS:** Bristol-Myers Squibb (BMS) filed a suit for patent infringement against Appellant Shilpa Medicare and Natco Pharma, to restrain them from infringing its patent for DASATINIB

which is used in the treatment of adults with chronic, accelerated or myeloid or lymphoid blast phase *chronic myeloid leukemia* (“CML”) with resistance or intolerance to prior therapy, including *imatinib*, as well as, in the treatment of a particular form of *acute lymphoblastic leukemia* (ALL) called *Philadelphia chromosome-positive*(Ph+) ALL. Shilpa Medicare is a bulk drug manufacturer, which produces, sells and offers for sale and export, bulk Active Pharmaceutical Ingredients, fine chemicals, intermediates, herbal products and specialty chemical products to various pharmaceutical companies within the domestic and global markets.

**CONTENTIONS:** BMS alleged that the Shilpa Medicare had tied up with Natco and intended to manufacture and sell DASATINIB. BMS had filed a separate infringement suit against Natco, in which, the Court had issued an injunction preventing Natco from dealing in the offending product. BMS was apprehensive that Natco in collaboration with Shilpa Medicare would continue to infringe the suit patent. Shilpa filed an application for rejection and return of the complaint on the ground that the Delhi High Court lacked territorial jurisdiction to entertain the suit. In response, BMS submitted that a part of the cause of action had arisen within Delhi as Shilpa has a host of consumers/buyers etc., in Delhi as well as commercial arrangements with companies such as Natco who in turn sell/offer/distribute products within Delhi. The Single Judge refused to reject the complaint, and aggrieved by such order, Shilpa Medicare filed an appeal before the Appellate bench.

In the appeal, Defendants claimed that the apprehension on the basis of which the suit had been filed by BMS was vague and there was no substantial causal connection between the Defendant-Shilpa Medicare and the forum in which the action was brought against it. BMS, however, argued that when injunction is sought, it is not necessary that the threat should have become a reality before the injunction, and injunction can even be sought when the threat is yet to materialize.

**HELD:** The Division Bench opined, that on the preliminary issue of jurisdiction, the Court must



restrict its examination to the complaint and the documents enclosed with it. Relying on various judicial precedents, the Division Bench ruled that if the submissions in the complaint are assumed as correct, then the threat perceived is also correct, and such apprehension of threat would definitely grant the Court with the territorial jurisdiction to entertain the suit. In the present case, the complaint stated that Shilpa intended to supply oncology APIs which could include infringing products in the future and this submission was sufficient to constitute cause of action within the territorial jurisdiction of the Delhi High Court. Thus the Division Bench upheld the order of the Single Judge and dismissed the appeal.

## 8. IPAB's power to accept and decide on Miscellaneous Petitions, upheld

*Novartis AG v Union of India*  
28<sup>th</sup> July 2015, Madras High Court

**FACTS:** Novartis AG is a company, carrying on business of research, development, manufacturing and marketing of Pharmaceutical preparations. Petitioner/Novartis is the proprietor of Patent No.212815 titled N-Substituted 2-Cyanopyrrolidines which pertains to the pharmaceutical product and New Chemical Entity (NCE), assigned the International Non-Proprietary Name (INN) *Vildagliptin*.

Novartis had filed a patent infringement against Wockhardt before the High Court of Delhi [CS(OS) No.646 of 2814] and in the suit, an order of interim injunction was granted, restraining it from dealing in *Vildagliptin*, in any manner.

Wockhardt Limited had filed an application for revocation of the subject patent before the Intellectual Property Appellate Board (IPAB). In the revocation proceedings, Novartis was due to file its Counter Statement, when Wockhardt filed a miscellaneous petition requesting IPAB to take on record additional documents. In response, Novartis also filed a miscellaneous petition questioning the maintainability of Wockhardt's petition. By a common order, IPAB allowed the petition filed by Wockhardt and simultaneously rejected Novartis's petition.

Aggrieved by the IPAB order, Novartis filed a writ petition before the Madras High Court

requesting that the High Court call for the records of the revocation proceeding and quash the IPAB order for being illegal, arbitrary and unreasonable.

**CONTENTIONS:** Novartis submitted that IPAB had accepted the additional documents filed by Wockhardt under the Trade Marks Rules, which was impermissible since IPAB (Patent Procedures) Rules 2010 had been framed which did not permit raising additional grounds apart from the grounds initially raised in the application for revocation. Novartis argued that when the Rules mandate the manner in which an act has to be performed, it has to be performed in that manner alone and in no other manner. On the other hand, Wockhardt submitted that IPAB has been vested with powers to regulate its own procedures, and on examination of the provisions of the Patent Act, Trade Marks Rules as well as the IPAB (Patent Procedures) Rules 2010, it was found that said provisions allowed filing of miscellaneous petitions, and there was no specific bar on the powers of IPAB on this account. Wockhardt also argued that the grounds that were additionally pleaded were within the purview and scope of the grounds raised in the revocation application and substantive right of a party cannot be taken away or curtailed by hyper technicalities.

**HELD:** The Madras High Court after examination of the provisions of the IPAB (Patent Procedures) Rules 2010, found that the said Rules defined a Miscellaneous Petition and was of the opinion that the Rules having defined a Miscellaneous Petition, it cannot be stated that a Miscellaneous Petition is not maintainable before the Tribunal. With regard to the provisions of the Patent Act, the High Court observed that merely because there is no mention of a Miscellaneous Petition in the provisions of the Patents Act by itself would not mean that the IPAB is denuded of jurisdiction for entertaining a Miscellaneous Petition. With regard to Wockhardt's plea that the additional documents were available in the public domain but they had been unaware of it, High Court observed that curtailing Wockhardt from producing such documents on such a hyper-technical plea will be in violation of natural justice. Accordingly, Madras High Court ruled that the order passed by the IPAB was valid and did not call for any interference.

## 9. Writ petition challenging Controller's decision that Petitioner's patent application was deemed to be abandoned, allowed

*S. M. Anand Vel vs Union Of India  
20<sup>th</sup> July 2015, Madras High Court*

**FACTS:** Petitioner sought to quash an order dated 9<sup>th</sup> March 2012, passed by the Patent Controller by which its Patent Application No.2519/CHE/2007 was found to be not in order and Petitioner was directed to put it in order within the prescribed time under the Patent Act, which time had expired on 30<sup>th</sup> November 2011, and therefore, Petitioner's patent application was deemed to be abandoned.

**CONTENTIONS:** Petitioner claimed that the Controller's decision was in effect a rejection of its patent application, which can only be done under Section 14 and Section 15 of the Act, and only after hearing Petitioner, can the Controller pass a speaking order as per Section 15 of Act. Petitioner further stated that its patent application cannot be deemed to have been abandoned, when the examination reports issued during the prosecution of the patent application contained two sets of fresh objections and not the same objections.

**HELD:** The Madras High Court ruled that the issue in the present case is identical to the issues that arose in the decisions of Delhi High Court in *FERRID ALLANI V. UNION OF INDIA (UOI) AND OTHERS [200S (37) PTC 44S(Del)]* and *TELEFONAKTIEBOLAGET LM ERICSSON (PUBL) V. UNION OF INDIA AND OTHERS* in (W.P.(C)No.9126 of 2009) dated 11.03.2010. Accordingly, Madras High Court in keeping with the decision rendered by the Delhi High Court, allowed the writ petition and remanded the matter back to the Controller of Patent for fresh consideration and for issuance of a reasoned order under Section 15 of the Patent Act and Petitioner to be given an opportunity to be heard before passing such order.

## 10. Best IT restrained from importing mobiles that infringe Ericsson's patents involving 2G, EDGE and 3G technologies

*Telefonaktiebolaget LM Ericsson v  
Best IT World (India) Pvt Ltd  
2<sup>nd</sup> September 2015, Delhi High Court*

**FACTS:** Plaintiff is the proprietor of patents relating to three technologies, in the field of telecommunications pertaining inter alia to 2G, EDGE and 3G devices (mobile handsets, tablets, dongles etc.) In November 2011, Plaintiff approached the Defendant and informed about the ownership of a portfolio of Standard Essential Patents (SEPs) relating to inter alia 2G and 3G technology and disclosed Plaintiff's willingness to discuss a licensing arrangement on FRAND (Fair, Reasonable, and Non-Discriminatory) terms, which will be beneficial to both the parties. However, Defendant did not enter into any licensing arrangement nor did it agree to sign a non-disclosure agreement so that commercial discussions could commence between parties. In view of Defendant's refusal to enter into a licensing arrangement, Plaintiff filed a patent infringement suit before the Delhi High Court.

**CONTENTIONS:** Defendant argued that Plaintiff must provide all details and documents and satisfy Defendant as to whether these are SEPs and whether Defendant is guilty of infringement, if any. In the absence thereof, Defendant was not ready to enter into any licensing arrangement nor was it ready to sign the non-disclosure agreement. Plaintiff submitted that it had already provided details of its suit patents to Defendant and Defendant is making random claims simply as dilatory measures. Plaintiff pointed out that Defendant had filed a complaint against Plaintiff before the Competition Council of India (CCI) and in its complaint, Defendant had provided substantial details of Plaintiff's patents and therefore, Defendant cannot now claim that it did not have the necessary information.

**HELD:** The Delhi High Court noted that prima facie, it appears that Defendant was aware of Plaintiff's patents. It further observed that Plaintiff had filed substantially similar patent infringement suits against third parties and a

number of interim reliefs had been granted by the High Court in those suits. Single Judge was of the opinion, if a similar order is issued in the present suit and the Defendant is later found to have not infringed Plaintiff's patents, such interim orders will not have caused any injury to the Defendant. Accordingly, Single Judge restrained Defendant from importing any mobile devices that were infringing the suit patents.

By an order dated 29<sup>th</sup> October 2015, the Delhi High Court noted that the parties had entered into a Global Patent License Agreement dated 20<sup>th</sup> October, 2015 and by virtue of the same, defendant had accepted a worldwide non-transferable and non-exclusive patent license. Accordingly, the suit was disposed of.

### **11. Intex found guilty of infringing Ericsson's SEPs and directed to pay royalty as per FRAND arrangement**

*Telefonaktiebolaget LM Ericsson vs  
Intex Technologies (India) Ltd  
13<sup>th</sup> March 2015, Delhi High Court*

**FACTS:** Plaintiff is the proprietor of patents relating to three technologies, in the field of telecommunications pertaining inter alia to 2G, EDGE and 3G devices (mobile handsets, tablets, dongles etc.) Plaintiff came to know that Defendant was importing and selling products which infringed its afore-stated patents and accordingly, it approached Defendant for entering into a FRAND licensing arrangement of its Standard Essential Patents (SEPs). However, the negotiations failed to progress despite Plaintiff's repeated attempts. Owing to the non-cooperative attitude of Defendant, Plaintiff filed a patent infringement suit against Defendant claiming that its mobile handsets/devices infringed its Standard Essential Patents (SEPs) involving the 2G, EDGE and 3G technologies.

**CONTENTIONS:** Plaintiff alleged that Defendant on one hand continued to negotiate with Plaintiff regarding the FRAND license but on the other hand initiated multifarious proceedings against Plaintiff, including a complaint before the Competition Council of India (CCI) and revocation proceedings against the suit patents before the Intellectual Property Appellate Board (IPAB). Plaintiff alleged that

Defendant had taken contradictory stands - in the complaint before the CCI it had submitted that Plaintiff's patents were valid and essential as a result of which Defendant is being compelled to seek a license from Plaintiff, whereas before the IPAB, Defendant had challenged the validity of five SEPs of Plaintiff.

Defendant submitted that it had challenged the validity of Plaintiff's suit patents before the IPAB as well through the counter-claim filed in the present case. According to Defendant, the High Court must decide on the issue of validity of the patents first, since the question of infringement arises only if the suit patents are found to be valid.

**HELD:** The Single Judge rejected Defendant's challenges to the suit patents under Section 8 and Sections 3(k) and 3(m) of the Act and held that Defendant's challenges are not serious enough to refuse injunction. With regard to Defendant's claims of invalidity of patent, Single Judge noted that Defendant had admitted the validity of patents before the CCI in its complaint regarding abuse of dominant position by Plaintiff. The High Court was of the opinion that a prima facie inference of validity of the patents can be drawn from the material on record and since there was no credible defence raised by Defendant. The Single Judge ruled that Defendant had infringed Plaintiff's suit patents and issued an interim injunction order restraining Defendant from infringing Plaintiff's suit patents in any manner. High Court additionally directed Defendant to pay royalty amounts as decided on another suit filed by Plaintiff against Micromax, with 50% of the royalty amount to be paid to Plaintiff directly while the rest of the royalty amount was to be deposited before the High Court. The High Court further directed that this licensing arrangement was to continue for every six months till the final disposal of the suit.

It appears that cross appeals have been filed by both parties against the order of the Single Judge and such appeals are currently pending before the Appellant Division of the Delhi High Court.



## 12. Interim injunction granted in favour of Hindustan Unilever in a suit for patent infringement

*Hindustan Unilever Limited vs Marvellous & Anr  
28<sup>th</sup> September 2015, Calcutta High Court*

**FACTS:** Petitioner, Hindustan Unilever, had invented a biocide cartridge for use in a water purification device having an automatic water flow shut off mechanism at end-of-life and its use in a gravity fed water purification device. Petitioner had also obtained a patent for the said invention. Plaintiff found that Defendants were using similar products which had the same technical device which was protected by Plaintiff's patent. Accordingly, Plaintiff filed a patent infringement suit against Defendant before the Calcutta High Court.

**HELD:** The High Court noted that the infringing devices greatly resembled the device in respect of which Plaintiff had its patent and the mechanism of the rival products also appeared to be same. Since Plaintiff had obtained a patent which granted it the right to prevent any other party from using the said technology dishonestly, the Court issued an interim injunction order restraining Defendant from using the patented device in any manner. The Court also appointed a Special Officer as per Plaintiff's request to take inventory of Defendant's business in relation to the offending products.

## 13. Registration is not a pre-condition for validity of assignment of patent

*Sergi Transformer Explosion Prevention Technologies Pvt Ltd v CTR Manufacturing Industries Ltd And Ors  
8<sup>th</sup> October 2015, Delhi High Court*

**FACTS:** Plaintiff is the exclusive licensee in respect of Indian Patent No. 189089 titled "Method and Device for Preventing/Protecting Electrical Transformer against Explosion and Fire". Pursuant to a tender floated by North Delhi Power Limited (NDPL), Plaintiff became aware that Defendants had submitted a technical bid in which Defendants had offered to supply products to NDPL that infringed Plaintiff's suit patent. Accordingly, Plaintiff filed the present suit against the Defendants seeking permanent injunction restraining them from infringing the registered Indian Patent No. 189089.

**CONTENTIONS:** Defendant filed an application for rejection of the complaint contending that the Plaintiff was not an exclusive licensee of the suit patent and as such, Plaintiff had no right to sue Defendants under Section 109 of the Act. Defendants submitted that Plaintiff could not be an exclusive licensee as another company, SERGI Holding had instituted a patent infringement suit in Kolkata against Defendant in 2006, claiming that SERGI Holding was the exclusive licensee of the suit patent and had the sole authority to use the suit patent.

The Single Judge accordingly issued a direction that Plaintiff's application for taking on record the license agreement before the Patent Office was to be heard and decided expeditiously and adjourned all pending applications, including Plaintiff's injunction application as well as Defendants' application for rejection of the complaint, till such time the Controller issued his decision registering the exclusive license agreement. Aggrieved by the order of the Single Judge, both parties filed appeals before the Delhi High Court Appellate bench.

In the appeal, Plaintiff contended that there is a licence agreement between the plaintiff and the patentee and the suit has been based on the said licence agreement. Defendants alleged that the license agreement is not a genuine document and denied that Plaintiff is an exclusive licensee of the original inventor of the patent.

**HELD:** The Appellate Court examined the provisions of the Patent Act relating to assignments and concluded that post 2005 amendment of the law, for a license to be valid, registration is not mandatory and the license agreement is valid since the date of its execution. The Appellate Court further noted that the license agreement was executed in 2006, while the application for registration of the license agreement was filed at the Patent Office in March 2010, and the present suit was filed in August 2010. The High Court was of the opinion that while dealing with an application for rejection of complaint, the Court must only look into the submissions made in the complaint and not the defence set up by Defendant in its written statement. The Appeal Court ruled that at even at the prima facie stage, Section 69(5) empowers

the Court, for reasons to be recorded, to take into consideration an unregistered assignment as a document of title and the Single Judge had erred in adjourning the pending applications. Accordingly, the Appeal Court remanded the matter back to the Single Judge and directed him to decide whether to admit the unregistered licence agreement and to decide on the applications accordingly. However, Appeal Court did not interfere with Single Judge's directions to the Controller for expeditious disposal of the registration of licence agreement or his dismissal of Defendant's application for rejection of the complaint.

It appears that an appeal before the Supreme Court filed by CTR against the afore-stated decision of the Delhi High Court is currently pending.

#### **14. Injunction granted in favour of CTR and against Sergi**

*CTR Manufacturing Industries Ltd vs Sergi Transformer Explosion Technologies Pvt Ltd  
23<sup>rd</sup> October 2015, Bombay High Court*

**FACTS:** The Plaintiff is the proprietor of Indian Patent No.202302 for "A SYSTEM AND METHOD FOR PREVENTING AND/OR DETECTING EXPLOSION AND/OR FIRE OF ELECTRICAL TRANSFORMERS". Plaintiff had filed a patent infringement suit against Sergi Transformers claiming infringement of the said patent.

**CONTENTIONS:** CTR claimed that Sergi's own product used under a licensing arrangement was a commercial failure and thus, Sergi resorted to using products that infringe CTR's patent. CTR claimed that its patented product contained two essential features, which were not present in Sergi's patent but were present in the offending product being manufactured and sold by Sergi in violation of CTR's patent. Sergi denied all allegations of infringement and asserted that its products are completely different from that of CTR's products. Sergi also contended that CTR's patent was invalid and the patent was covered by prior art. Sergi also alleged that the complaint filed by CTR had crucial omissions which were deliberate, and designed to persuade the High Court to grant an interim injunction.

**HELD:** The Learned Single Judge examined the various documents and evidence placed on record by both parties and concluded that prima facie, Sergi's challenges to CTR's patent were not proved. The Single Judge opined that once it is found that there is a validly granted patent, i.e., that there is prima facie inventiveness and novelty, and the defence of mosaicing fails, then it is always necessary to compare the patent (or patented device) to the device said to be an infringement. If the latter adds merely non-essential or superfluous elements, or makes trifling variations, the charges of piracy and infringement are not deflected. On examination of the offending product and CTR's patent, the Judge noted that the offending product was indistinguishable from Plaintiff's patented product. With regard to Sergi's allegations of omissions, Judge opined that the an accidental omission of something immaterial did not fit the parameters of 'deliberate and material suppression'. Finding for the Plaintiff, Single Judge ruled that Sergi had entirely abandoned its patent and had adopted CTR's patent. Accordingly, Single Judge issued an order for injunction restraining Sergi from infringing CTR's patent in any manner.

An appeal filed by Sergi against the order of the Single Judge before the Bombay High Court Appellate Division has been accepted and is currently pending. In the meantime, the Appeal Court has stayed the operation of the interim order granted by the Single Judge and allowed the Appellant to continue to manufacture and deal in transformers, while maintaining an account of its sales which it needs to submit to the High Court from time to time.

#### **15. Patent infringement suits where validity of patent had been challenged shall not be transferred to jurisdictional subordinate commercial courts**

*Novartis AG and Anr v Cipla Ltd  
27<sup>th</sup> November 2015, Delhi High Court*

**FACTS:** Plaintiff, Novartis had filed a suit against Cipla/Defendant claiming that Cipla is infringing its patent which covers a new chemical entity and compound INDACATEROL (International Non-Proprietary Name) as well as its maleate salt, namely INDACATEROL

Maleate. Defendant had in response filed a written statement and a counter-claim, both of which challenge the validity of the suit patent.

In October 2015, the President of India had promulgated the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Ordinance, 2015 according to which, all commercial disputes involving intellectual property shall be adjudicated by Commercial Court constituted under the Ordinance, provided that the specified value of such suit exceeds Rupees One Crore \*(US\$ 147000 approx), but does not exceed Rupees Two Crores \*(US\$ 294100 approx), other than those relating to commercial disputes the specified value of which is not less than Rupees One Crore \*(US\$ 147000 approx) pending before the Delhi High Court (Original Jurisdiction) and which were to be transferred to the subordinate court having jurisdiction. However, an exception to the said rule was commercial disputes filed in High Courts having original jurisdictions, which were to be heard and disposed off by the commercial division of the High Court.

**CONTENTIONS:** Plaintiff submitted that the present suit involved infringement of patent which had to be heard by the commercial division of the Delhi High Court and was not to be transferred to the jurisdictional subordinate courts as per the provisions of Patent Act and the exceptions mentioned under the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Ordinance. Plaintiff contended that Commercial Division of the High Court had jurisdiction to hear and dispose of intellectual property matters as defined in the Ordinance irrespective of their pecuniary value i.e. intellectual property matters needs not be of a "Specified Value" to be heard and disposed of by the Commercial Division of the High Court.

**HELD:** The Delhi High Court was of the opinion that the High Court is deemed to be a District Court as per definition in Section 2(4) of the CPC, 1908 and will have the power to try the matters. Single Judge also noted that the exceptions provided under the Ordinance as well as the provisions of the Patent Act mandated that once the validity of a patent is challenged, the suit must be heard by the commercial division of the High

Court which has the Ordinary Original Civil Jurisdiction irrespective of their pecuniary value. Accordingly, Single Judge directed that the suit will not be transferred to the jurisdictional subordinate court.

## 16. Cipla's Erlolcip found infringing Roche's Tarceva Patent

*F. Hoffman-La Roche Ltd & Anr v Cipla Ltd  
27<sup>th</sup> November 2015, Delhi High Court*

**FACTS:** Plaintiff (Roche) is the proprietor of an Indian patent IN '774 in relation to the Erlotinib Hydrochloride molecule which had demonstrated breakthrough capabilities as an Epidermal Growth Factor Receptor (EGFR) inhibitor which spiked survival benefit in cancer including non-small cell lung cancer (NSLC) patients. The marketable form of the molecule comprised polymorph A and B, and further research revealed that polymorph B was more thermodynamic and had enhanced efficacy. Although Roche's patent application for polymorph B of Erlotinib Hydrochloride was granted in USA (US '221), similar application filed in India was rejected (DEL '507).

Roche came across media reports that Cipla intended to launch generic versions of Roche's drug covered by IN '774. Roche filed a patent infringement suit against Cipla before the Delhi High Court in 2008. Roche's request for interim injunction against Cipla was refused by the Single Judge in March 2008. Roche filed an appeal against the refusal order of the Single Judge, which was also dismissed by the Appellate Bench of the Delhi High Court. Aggrieved, Roche filed a Special Leave Petition (SLP) before the Supreme Court which was also denied. Hence, the suit continued to trial. After conclusion of the trial, the trial court dismissed the claim of injunction as requested by Roche against Cipla and the counter-claim of Cipla challenging the validity of the patent of Roche. Aggrieved by the decision of the Single Judge, both parties filed two separate appeals before the Appellate bench which was decided by a common judgment.

**CONTENTIONS:** One of the main grounds of Cipla's defence against Roche's claim of infringement was that inventions are required to be product specific; where products have to have

\* (INR 1 = US\$ 68 approx.)



commercial manifestation. Cipla argued that infringement was relatable to “the product” which is patented and not to any “substance” (as understood in Section 3(d) of the Act). Accordingly, Cipla contended that the “product” covered by Roche’s patent and the “product” that Roche was trying to enforce against Cipla were not the same. In addition, Cipla sought revocation of Roche’s patent based on Section 8 of the Patent Act and further claimed that the suit patent was obvious. Finally, Cipla challenged the suit patent on the ground that Roche lacked title to the patent.

**HELD:** The Appeal Court found that the claims covered by Roche’s IN ‘774 patent were substantially broad and not limited to any polymorphic version of Erlotinib Hydrochloride, but to Erlotinib Hydrochloride itself. High Court concluded that since Cipla’s product was one particular polymorphic form of the Erlotinib Hydrochloride compound (Polymorph B), it will clearly infringe Roche’s IN ‘774 patent. High Court rejected Cipla’s claim for revocation under Section 8 and Section 64 of the Act as there was no failure of substantial compliance by Roche. On the issue of obviousness, High Court ruled that the onus was on Cipla to show prima facie obviousness whereafter the burden would have

shifted to Roche. However, High Court was of the opinion that Cipla could not establish prima facie that the suit patent was obvious. Consequently, the action of Cipla seeking invalidity of the suit patent on the ground of obviousness failed. Regarding lack of title, High Court stated that the suit patent could not be held invalid on this ground as it was not a ground of revocation under Section 64.

The appeal court upheld the decision of the Single Judge so far the counter-claim by Cipla seeking revocation of suit patent was rejected. Appeal Court set aside the Single Judge’s refusal to grant injunction as prayed by Roche against Cipla but did not award the injunction since Roche’s patent was due to expire in March 2016 and there was no interim injunction against Cipla (Cipla had continued to sell the infringing product). Instead, Appeal Court directed Cipla to submit complete details of its accounts and profits gained as a result of such sale, and based on such evidence, the Single Judge of the trial court was directed to issue appropriate orders regarding damages. Appeal Court also awarded costs of proceedings of Rs. 5 Lakhs \*(US\$ 7350 approx.) payable by Cipla to Roche. ■

## Case Summaries of Design Decisions : 2015 - 2016 The Courts

### 1. Faber-Castell’s crayon designs held distinctive

*Faber-Castell Aktiengesellschaft and Anr vs Cello Pens Pvt. Ltd. And Anr  
3<sup>rd</sup> September 2015, Bombay High Court*

**FACTS:** Plaintiff had marketed a set of 24 crayons in luscious colours, of a distinctive type and in unique packaging since 2010 in India. Plaintiff claimed that Defendant had copied every single aspect of its product and thus infringed the copyright and design in the product packaging of the crayons manufactured by Plaintiff, and filed the present suit alleging design infringement.

**CONTENTIONS:** Plaintiff claimed that its product has a unique and novel shape, namely triangular or three-sided shape of the 24 crayons in the package, and the presence on all three faces

of the crayon’s shank of two parallel lines of tiny protuberances or raised dots. The crayons are packaged in two subsidiary recessed trays facing each other and set in a larger outer container. Additionally, it is also possible to sharpen and erase the crayons, which Plaintiff claimed to be a distinctive feature. Plaintiff claimed that the combination of all these facets in the particular manner and presentation goes beyond the merely functional, and was instead entirely aesthetic, novel and unique to Plaintiff and no one else.

Defendant on the other hand alleges that Plaintiff was guilty of suppression of fact of prior publication of designs of this very nature in respect of writing instruments and crayons. This suppression was material, according to Defendant, because each of the elements to which Plaintiff referred to was purely functional and was

\* (INR 1 = US\$ 68 approx.)

not a 'capricious' addition. In view of the fact of prior publication, Defendant claimed that Plaintiff's allegations of infringement of design or passing off thereto, cannot be sustained. Defendant further submitted that unless the features themselves are shown to be artistic embellishments bereft of any functional element, no protection can be granted. It claimed that mere copying of a shape or the mere replication of Plaintiff's tray, crayon, triangular shape, sharpened point or erasable quality was not sufficient in itself.

**HELD:** On examination of the rival products, the Single Judge was of the opinion that it was not possible to distinguish Defendant's product from that of Plaintiff's, except for Plaintiff's logo on one side of the crayon, which is not visible when the crayons are turned to another side. Also, the Judge found that the embellishments on the crayon did not appear to be functional and instead appeared to be an artistic element unique to Plaintiff. In view of the above, the Court issued an order of injunction restraining Defendant from using Plaintiff's design/features of shape/configuration etc., for its products in any manner.

## 2. Symphony succeeds in restraining infringement of its designs for air coolers

*Symphony Ltd v Wim Plast Ltd and Ors.*  
17<sup>th</sup> March 2015, Gujarat High Court

**FACTS:** Plaintiff filed a suit claiming infringement of its designs of air coolers by Defendant. The designs were owned by Mr. Achal A. Bakri who had assigned his designs to the Plaintiff. Before the trial court, Plaintiff's prayer for interim injunction was refused, and hence this appeal was filed before the Gujarat High Court.

**CONTENTIONS:** Plaintiff alleged that Defendant had slavishly imitated its designs of air coolers and invited the Single Judge's attention to the product brochures of the rival parties to point out the similarities in the designs of Defendant's products when compared with Plaintiff's products. Plaintiff further alleged that adoption of Plaintiff's registered designs by Defendant in respect of its products amounted to infringement of its design rights. Plaintiff further contended that Defendant had not yet commenced

sale of the products but was obviously intending to do so since it had published a number of brochures and had started to advertise and market its products, all of which feature imitations of Plaintiff's designs. It was further submitted by Plaintiff that Defendant used to manufacture air coolers of Plaintiff as per Plaintiff's requirements based on die and designs supplied by Plaintiff.

**HELD:** After comparison of the designs on products manufactured by Defendant to the registered designs of Plaintiff and on consideration of Plaintiff's arguments, the Court stated that *prima facie* it appears that Defendant had imitated Plaintiff's registered designs. As Defendant was yet to commence sale of its products, the Court issued a preliminary injunction restraining Defendant from marketing the infringing products.

## 3. Eicher Goodearth succeeds in restraining infringement of its registered designs

*Eicher Goodearth Pvt Ltd vs  
Krishna Mehta & Ors*  
29<sup>th</sup> June 2015, Delhi High Court

**FACTS:** Plaintiff is a company running renowned chain of retail stores and galleries showcasing and selling unique lifestyle products with exclusive design, style, pattern, quality and standard. Plaintiff claims to be the original creator, inventor and owner of various designer collections titled SERAI, PERIYAR, VRINDAVAN, BALIMYNAH, LOTUS, ROSE PRINCESS and FALCON (hereinafter "Plaintiff's designs") and have been using the same on a wide range of products. Defendant was working as a Design Consultant with plaintiff company on retainer basis for a period of 2 years. In 2012, Defendant left Plaintiff-company and started selling identical patterns in relation to identical range of products on the website [www.indiacircus.com](http://www.indiacircus.com). Aggrieved, Plaintiff filed the present suit seeking injunction against Defendant.

At the preliminary stage, Delhi High Court granted an interim injunction restraining Defendant, from dealing in any kind of products with motifs, logos, patterns and designs which

were obvious and fraudulent imitation of Plaintiff's motifs, logos, patterns and designs.

**CONTENTIONS:** Plaintiff submitted that it is the original creator, inventor and owner of various designer collections (Plaintiff's designs) and have been using the same on a wide range of products. Plaintiff also submitted that it is the registered owner of such designs under the Designs Act, 2000. Plaintiff submitted that in the period when Defendant was employed with Plaintiff's company, Defendant had no rights in any of the art-work, motifs, patterns, designs that he worked upon as all such rights therein vested with Plaintiff. Plaintiff alleged that Defendant, in using the same in respect of identical products range as that of the plaintiff, committed gross violation of Plaintiff's rights.

Defendant argued that the designs in question were inspired by works of art available since centuries and the same are not original designs as claimed by Plaintiff. Defendant further argued that the registered designs were in public domain prior to the date of claim of Plaintiff and the products have been previously published.

**HELD:** The Single Judge noted that it is a well settled law that even though a design is old in itself but if it is applied to a new article on which it has never been previously applied, then the said design needs to be protected. The Judge opined that the expression "original" includes designs which though old in themselves but were new in their application. The Judge was of the opinion that as far as similarity of rival products were concerned, Defendant's designs were similar to Plaintiff's registered designs. The Judge also noted that Defendant's use was subsequent to the use of Plaintiff and apart from the argument that the designs were prior published, Defendant had failed to produce any document to establish that such designs were used prior to Plaintiff. Delhi High Court ruled that the product used by Defendant in relation to the said designs were almost same as the products of Plaintiff and Defendant had failed to offer any explanation for adoption of similar designs. Accordingly, High Court made the preliminary injunction order absolute which restrained Defendant from dealing in designs similar to Plaintiff's registered designs in relation to similar business.

#### 4. Court rules Whirlpool's designs lack novelty, refuses injunction

*Videocon Industries Ltd v Whirlpool of India  
2<sup>nd</sup> February 2015, Madras High Court*

**FACTS:** Whirlpool, manufacturer of a range home appliances, had designed a household refrigerator with bottom drawer, fascias and base and had been granted six different design registrations including one titled 'refrigerator with bottom drawer'. In December, 2010, Whirlpool came across refrigerators with similar bottom drawers being sold by Videocon. Whirlpool filed an suit before the Madras High Court alleging design infringement by Videocon.

The Single Judge was of the view that Whirlpool's product and Videocon's product appeared to be similar and upheld the interim injunction granted earlier. Aggrieved by the said order, Videocon filed the present appeal before the Appellate Bench of the Madras High Court.

**ARGUMENTS:** Whirlpool claimed that its product designs were original and novel and Videocon's products infringed its designs as they were substantially similar. Videocon, on the other hand, claimed that the designs of bottom drawer of a refrigerator were well within public knowledge and Whirlpool cannot claim exclusivity.

**HELD:** The Appellate Court concluded that in order to claim originality, there must be exercise of intellectual activity resulting in a design which is entirely new and not a mere trade variation of a previous design. The Court was of the opinion that the working world was at liberty to take ordinary trade variants for use in any particular instance and nothing can prevent an ordinary workman from using or not using trade knowledge of such kind. Accordingly, the Appellate Bench was of the belief that the Single Judge had merely looked into the physical appearance of the rival products without going into the issues of novelty, originality and trade variants which factors ought to have been considered, as have been relied upon by courts on various occasions. The appeal was allowed and the interim injunction granted by the Single Judge was set aside. ■

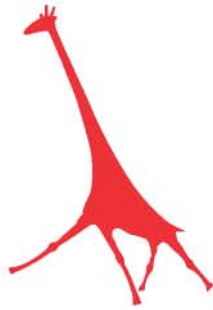


# Anatip

## AN OVERVIEW OF TRADEMARK REGISTRATIONS IN ASIA

By Anatip Pte. Ltd., Singapore

COUNTRY	MULTI-CLASS APPLICATION	PRIORITY CLAIM	CLASSIFICATION	POWER OF AUTHORITY
AFGHANISTAN	NOT POSSIBLE	POSSIBLE	International Classes 1 to 45	Legalised
BANGLADESH	NOT POSSIBLE	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	NOT POSSIBLE	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	POSSIBLE	POSSIBLE	International Classes 1 to 45	Notarised
MACAU	NOT POSSIBLE	POSSIBLE	International Classes 1 to 45	Notarised
MALAYSIA	NOT POSSIBLE	POSSIBLE	International Classes 1 to 45	Not required
MALDIVES	POSSIBLE	NOT POSSIBLE	International Classes 1 to 45	Not required
MAURITIUS	POSSIBLE	POSSIBLE	International Classes 1 to 45	Legalised
MYANMAR	POSSIBLE	NOT POSSIBLE	International Classes 1 to 45	Legalised
PAKISTAN	NOT POSSIBLE	POSSIBLE	International Classes 1 to 45	Notarised
PHILIPPINES	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature
SOUTH KOREA	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature
SRI LANKA	NOT POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature
TAIWAN	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature
THAILAND	NOT POSSIBLE	POSSIBLE	International Classes 1 to 45	Notarised
VIETNAM	POSSIBLE	POSSIBLE	International Classes 1 to 45	Simple Signature



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