



INTELLECTUAL PROPERTY UPDATES FROM INDIA

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INTRODUCTION

Dear Readers,

"We are pleased to present to you the latest edition of our newsletter covering updates on all things Intellectual Property. With intriguing shifts in the ever-evolving landscape of patents, trade marks, and copyrights, the newsletter traces the dynamic world of Intellectual Property and its fascinating intersections with fashion, tech, and media.

From safeguarding the rights in popular trade marks like Burger King, Blinkit and Theobroma to unravelling the otherwise muffled areas like Standard Essential Patents (SEP), this edition tracks a series of noteworthy decisions

taken by various Courts across the world. The High Court of Delhi has been particularly vigilant in protecting future works of owners from copyright infringement by issuing the "Dynamic+" Injunction order in the Universal City Studios LLC case. Simultaneously, it has addressed issues of prior use, transborder reputation and non-use, leading to vacation of interim injunction in the "E! Now" case. Other intriguing snippets include GI tags for products from various states across India and right of authors to receive royalty from radio channels.

We appreciate your readership and sincerely wish you a fruitful reading!"



CASE ANALYSIS

Q2 (APRIL 2023 – JUNE 2023)

THE COURT RESTRAINS BURGER KING FAMILY RESTAURANT FROM USING A SIMILAR MARK TO BURGER KING'S FAMOUS DEVISE MARK.

The High Court of Delhi ("**Court**") recently adjudicated in a case concerning the rectification petition for cancellation / removal of the device mark, 'BURGER KING'.¹ Burger King Co. LLC ("**Petitioner**") is registered proprietor of its device mark under class 43 since 2010 and has been carrying business as a fast-food chain. The Petitioner, after having earned wide acclaimed popularity worldwide, started operating their business in India in 2014.

In 2011, a mark with the same name Burger King Family Restaurant ("**Respondent**") applied for registration of the mark, 'BURGER KING FAMILY RESTAURANT' under class 43 ("**Impugned Mark**"). The Petitioner duly moved an application under Rule 41 of the Trade Marks Rules, 2017 ("**Trade Mark Rules**") under Form TM-58 to receive information when the application is published. However, to the contrary, the mark was advertised without informing the Petitioner and finally registered in favour of the Respondent.

Petitioner's Mark



Respondent's Mark



In view of the same, the Petitioner filed a suit against the Respondent for infringement in 2014. The Court passed an ex-parte injunction in favour of the Petitioner restraining the Respondent from using the trade mark 'BURGER KING FAMILY RESTAURANT' and further restrained the Respondent from obtaining the franchise of Burger King in the future.

The Petitioner averred that the Impugned Mark is similar to that of the Petitioner's well-known trade mark, 'BURGER KING'. It further noted that the suffix added to the Impugned Mark, i.e., 'Family Restaurant' is descriptive in nature and has been written in a very minute font size. Additionally, not only the name but also the services provided by both the entities were the same as registered under Class 43. Hence being a prior user, the registration should not have been granted in accordance with Section 11 of the Trade Marks Act, 1999. Further, the manner in which the Respondent coined the trade mark by putting a suffix clearly indicates that the Petitioner's name was adopted dishonestly in order to claim benefits through the trade mark earned by the Petitioner.

In view of the abovementioned arguments, the Court noted that the Petitioner has indeed made out a prima facie case in its favour and basis the factual matrix, it does appear that the Respondent dishonestly adopted the Impugned Mark in order to gain profit and cause harm to the reputation and goodwill of the Petitioner as the nature of the mark is such that it is likely to deceive the public by creating confusion in the minds of the people. Therefore, the Court vide order dated April 21, 2023, stayed the operations of the Respondent's mark till the final order. The next hearing is listed on November 20, 2023.

THE BOMBAY HIGH COURT HELD THAT THE INDIAN PERFORMING RIGHT SOCIETY WAS ENTITLED TO RAISE CLAIMS FOR ROYALTIES FROM COMPANIES OWNING RADIO CHANNELS LIKE FM TADKA AND RADIO CITY.

In a recent judgement by the Bombay High Court ("**Court**"),² the Indian Performing Right Society ("**Plaintiff**") entered into licensing agreements with Rajasthan Patrika Private Limited and Music Broadcast Limited ("**Defendants**"), who are engaged in the business of operating FM Radio Broadcasting Channels.

The Plaintiff filed the suit on grounds that the Copyright Amendment Act, 2012 ("**Amendment Act**") permitted authors of original work to receive royalties on each occasion that their work is utilized, for instance in this case, each time the recording is played by the Defendant

1. Burger King Co. LLC v. Virendra Kumar Gupta, 2023 SCC OnLine Del 2292.

2. Indian Performing Right Society Limited v. Rajasthan Patrika Pvt. Ltd., 2023 SCC OnLine Bom 944.

to the public. Whereas, the Defendants claimed that the Amendment Act is clarificatory in nature and does not provide the authors with any new substantive rights.

A Single Judge Bench of the Court held that the authors of the original work or underlying literary and musical works in sound recordings had no right to interfere with the right of broadcasters to communicate with the public. Aggrieved by this decision, the Plaintiff approached the Division Bench of the Court.

Subsequently, the Plaintiff found out about the various applications filed by radio broadcasters before Intellectual Property Appellate Board ("**IPAB**") and sought an intervention in the proceedings claiming to be an interested party. The IPAB passed an order fixing rates of royalties in proceedings for sound recordings as well as literary and musical works and thereby acknowledged the change in law following the Amendment Act. The Defendants filed an appeal claiming that no separate royalty was payable.

In September 2021, after the dissolution of the IPAB, the Defendants filed a case before the Intellectual Property Division ("**IPD**") of High Court of Delhi seeking revision in the statutory license fee. The Single Judge of the High Court of Delhi held that the Plaintiff would be within its rights to avail remedies available in law if the Defendants were non-compliant with the order passed by the IPAB.

The Plaintiff found out that in the month of September 2021, the Defendants were broadcasting songs belonging to the repertoire of the Plaintiff which was in contravention of Section 31D (5) of the Copyright Act, 1957 ("**Copyright Act**"). On October 6, 2021, a Single Judge of the IPD Bench of the High Court of Delhi directed the issuance of two public notices for underlying literary and musical works and for sound recordings. Considering this, the present suit was filed in 2022, where the Plaintiff sought an interim relief against the actions of the Defendants.

In the present suit, the Court granted an interim injunction and restrained the Defendant and anyone on their behalf from either engaging by themselves or authorizing, the public performance/communication to the public, of the Applicant's repertoire of literary and musical works, in any form or manner without paying royalties in consonance with Section 31D (5) of the Copyright Act, 1957.

BLINKHIT V. BLINKIT: KARNATAKA HIGH COURT SETS ASIDE INTERIM INJUNCTION ORDER AGAINST BLINKIT CITING NON-USE OF REGISTERED TRADE MARK BY BLINKHIT

On April 17, 2023, the Karnataka High Court ("**Court**") set aside an interim injunction order of the trial court, temporarily restraining the use of the trade mark 'Blinkit' by a famous online groceries delivery platform Blink Commerce Private Limited (Previously known as Grofers India Private Limited) ("**Appellant**"). The order was passed for alleged violation of the rights of a software services firm Blinkhit Private Limited ("**Respondent**"). The Respondent claimed to have registered its trade marks '**BLINKHIT**' and '**iBLINKHIT**' since 2016.

A Single Judge Bench of Justice S.R. Krishna Kumar observed that the foremost ground on which the trial court has granted temporary injunction ("**Impugned order**") is that the Respondent had obtained the registered trade mark much prior to the Appellant starting the use of the trade mark "**BLINKIT**" for its business. However, it is pertinent to point out that the profit and loss account statement and the balance sheet of the Respondent clearly indicated that no business was being carried out and no income was being generated by the Respondent under the trade marks '**BLINKHIT**' and '**iBLINKHIT**'

Furthermore, the nature of services allegedly carried out by the Respondent was completely different from the nature of business being carried on by the Appellant consequently, the Court stated "*mere obtaining registration of trade marks by the respondent-plaintiff to carry on business/service/activity which was completely different from the appellant-plaintiff cannot be made the basis to come to the conclusion that the respondent had made out a prima facie case for grant of temporary injunction. Viewed from this angle also, the impugned order passed by the trial court deserves to be set aside.*"

Hence, it set aside the Impugned Order and directed the trial court to dispose of the suit as expeditiously as possible, preferably within one year from the date of receipt of a copy of the order passed by the Court.

DESPITE NOT HAVING ANY STATUTORY RECOGNITION, OWNERS OF STANDARD ESSENTIAL PATENTS CAN SEEK INJUNCTIVE RELIEF IF THE INFRINGER IS AN UNWILLING LICENSEE: DELHI HIGH COURT.

A Division Bench of the High Court of Delhi ("**Division Bench**"), in a recent judgement dated March 29, 2023,³ adjudicated upon the dispute concerning Standard Essential Patents ("**SEP**") between the parties, Intex Technologies (India) Limited ("**Appellant**") and Telefonaktiebolaget L M Ericsson ("**Respondent**").

In terms of brief factual matrix, the Respondent tried to get the Appellant to license their SEP but ultimately failed since both the parties could not mutually decide upon each other's offer and counter – offer. Subsequently in the midst of the licencing negotiations, the Appellant filed a complaint before the Competition Commission of India ("**CCI**") in 2013 alleging the Respondent of anti-competitive behaviour and abuse of power. It further challenged the validity of the five of the Respondent's patents before the Intellectual Property Appellate Board ("**IPAB**"), which existed at the time. Upon consideration of the facts and the averments made by the Respondent, a conditional injunction was issued by the Single Judge of the High Court of Delhi ("**Learned Single Judge**") on March 13, 2015 ("**Impugned Order**") whereby the Learned Single Judge held that the Respondent's eight suit patents were prima facie valid, essential and that the Appellant had prima facie infringed these patents. The Learned Single Judge further noted that the act of filing of the complaint by the Appellant before the CCI and the IPAB clearly reflected the malafide intention to prolong the litigation between the parties to avoid paying the royalty. Respondent, too, filed an appeal seeking modification of the Impugned Order dated March 13, 2015, and subsequent modification order dated March 26, 2015, passed in the said suit whereby the learned Single Judge directed the Appellant to pay 50% (Fifty Percent) royalty at the interim stage and balance 50% (Fifty Percent) by way of a bank guarantee. The Respondent averred that direction be given should be to pay the entire royalty amount.

While adjudicating the parties claim in the present appeal, the Division Bench noted that it is the obligation of the 'Implementers' to not indulge in "hold out" situations and must not remain silent during negotiations. To continue using the SEP, they must either accept the SEP holder's offer or give a counteroffer along with

an appropriate security to prove that they are willing licensees. However, in the present case, the Division Bench ruled that the Appellant was evidently avoiding such negotiation and became an unwilling licensee and failed to satisfy the principle of law laid down by the Hon'ble Supreme Court in *Wander Ltd. & Anr. v. Antox India Pvt Ltd.*⁴ Consequently, the Division Bench noted that the suit patents were essential, had been infringed and the royalty sought by the Respondent was on fair, reasonable and non- arbitrary ("**FRAND**") terms.

DELHI HIGH COURT DENIES INJUNCTION TO TIMES GROUP FOR ITS PRIOR USE OF LOGO "NOW", "E-NOW", "E-NEWS NOW"

A suit was filed before the High Court of Delhi ("**Court**") by Bennet Coleman & Company Limited ("**Petitioner**") seeking to restrain E Entertainment Television ("**Respondent**") from adopting, and using the mark "**NOW**", "**E NOW**" and "**E NEWS NOW**" or any other mark which is identical or deceptively similar, either singly or in conjunction with the Petitioner's registered mark/channel name. The Petitioner, popularly known as the 'Times Group', principally runs print media since 1838, and is the flagship company of the Times Group Company. The Petitioner claimed to be the registered proprietor of the trade marks "TIME", "TIMES", and "NOW".

The Petitioner started using the logo "**E Now**" for entertainment, and film review shows, since October 13, 2008, where "E" stood for Entertainment, and "NOW" signified a connection with the brand of the Times Group. The Petitioner decided to launch a new logo of "E Now" and applied for the registration of the trade mark. It is pertinent to note that the Petitioner had been using the logo "E Now" since 2008, and the "**Now**" mark was per se registered, and it is a prominent feature of the Petitioner's mark. The present suit is limited to trade mark Class 38 and Class 41 which deals with "television broadcasting services", and television based-entertainment services" respectively.

On the other side, the Respondent is an American pay television channel owned by NBC Universal Cable Entertainment Group Division of NBC Universal

3. Intex Technologies (India) Ltd. vs. Telefonaktiebolaget L M Ericsson (PUBL), 2023/DHC/2243.

4. Wander Limited. & Another. v. Antox India Pvt Ltd., 1990 (Supp.) SCC 727.

Media LLC. It is a global media, and entertainment conglomerate with presence in different countries. It runs various programs, shows, and activities under the mark "E!" and E! formative marks such as "**E! Entertainment**", "**E! Online**", "**E! News**", "**E! HD**", etc. Further, the Respondent has used the name E! News Now" for a digital/ online news segment/ bulletin around the year 2007, and "E! Now" online television is also in existence. The Respondent argued that the earliest registration of the mark "NOW" by the Petitioner was July 31, 2008, which was after the date use of "E! News Now", and therefore, the "NOW" marks and labels have been wrongly registered.

The Court noted that the Petitioner is not the proprietor of the standalone mark of the "NOW" nor the prior user

of the mark under Class 38. Further, the registration of the Petitioner under Class 41 is from September 18, 2014 on the proposed-to-be-used basis which has not been used till date. Thus, the registration of "NOW" in Class 41 cannot be used as an injunction against the Respondent for Respondent's mark "E! Now" and "E! New Now" and the Respondent's first use of "E-News Now" is since September 30, 2007. The Court further noted that though the Petitioner had several registrations with the suffix and prefix "NOW", it was a common word and was used by several other entities, and hence the Petitioner cannot be permitted to claim the word used by it as a prefix or suffix has acquired a distinction. Therefore, the Court noted that the Respondent, as a prior user of mark "E" or "E!" with "NOW" and "E NEWS NOW", could not be enjoined in the instant case.



Q3 (JULY 2023 – SEPTEMBER 2023)

DELHI HIGH COURT REJECTS PEPSICO INDIA'S APPEAL CHALLENGING REVOCATION OF REGISTRATION FOR USING A POTATO VARIETY IN MAKING LAY'S CHIPS

In a recent judgment⁵, the High Court of Delhi ("**Court**") affirmed the order dated December 03, 2021 ("**Impugned Order**") passed by the Protection of Plant Varieties and Farmers Rights Authority ("**Authority**"), which revoked the registration of Pepsico India Holding ("**Appellant**") concerning a potato variety utilized in the production of Lay's chips.

The Appellant is involved in the business of producing, distributing, and selling a range of products, including savoury snacks and food items like potato chips marketed under the brand names 'LAY'S' and 'Uncle Chipps'. The Appellant had obtained registration for the FL-2027 variety of potato as an 'extant variety.' However, the Appellant had erroneously marked FL 2027 as a 'New Variety' in the application form, with a commercialization date of December 17, 2009 in India. In response, the Respondent, who is a farmer activist, filed an application under Section 34 of the Protection of Plant Varieties and Farmers Rights Act, 2001 ("**Act**"), seeking to revoke the granted registration for FL 2027. The Impugned Order ultimately revoked the registration for FL-2027, citing Section 34(a), (b), (c), and (h) of the Act.

In the Appeal before the Court, the Appellant argued that the Authority overstepped its powers granted by Section 34 of the Act by re-evaluating the facts, asserting that the powers of the Registrar under Section 20 of the Act were not of an administrative nature. The Appellant further contended that the Authority failed to acknowledge that the technical errors in the application should not be held against them, especially when there was no deliberate concealment of critical information. Given the absence of any public interest concerns in this case, the Appellant asserted that the Authority made an error in revoking the registration.

While upholding the impugned Order of the Authority, the Court held that no ground for interference was made out by the Appellant, as even otherwise, the application for registration was deficient for its failure to provide necessary documents required under Section

16 read with Section 18(3) of the Act and Rule 27 of the Protection of Plant Varieties and Farmers' Rights Rules, 2003. The Court observed that an applicant seeking registration under the Act must be put to strict and vigilant compliance with the requirements of the Act, Rules, and Regulations, failing which it opens itself up to revocation of the registration granted. The Court also held that Section 34 empowers 'any interested person' to file an application which encompasses a public-spirited citizen also. Thus, the Court while upholding the Impugned Order, dismissed the Appeal.

THE VALIDITY OF TRADE MARK REGISTRATION MUST BE ESTABLISHED BEFORE SEEKING RELIEF AGAINST INFRINGEMENT- HIGH COURT OF DELHI

Recently, the High Court of Delhi ("**Court**") in the case of *Sun Pharma Laboratories Ltd v. Finecure Pharmaceuticals Ltd & Ors.*⁶ held that the remedies provided under Section 28 of the Trade Marks Act, 1999 ("**Act**") are subject to the mandatory conditions for the registration of trade mark being fulfilled.

In this case, Sun Pharma Laboratories Limited ("**Plaintiff**") approached the Court contending that Finecure Pharmaceuticals ("**Defendant**") had infringed its registered trade mark "PANTOCID" by adopting a similar mark- "PANTOPACID" for its products. The Plaintiff argued that this act of the Defendant had caused confusion in the minds of the consumer and diluted the distinctiveness of its mark "PANTOCID" whereas the Defendant asserted that its "PANTOPACID" mark was distinct, and consumers in the pharmaceutical sector exercised caution while choosing products. The Defendant further emphasized its established usage and significant market presence under the "PANTOPACID" mark.

After hearing the contention of the parties, the Court held that the right to claim exclusivity over a trade mark and seek relief against infringement, as outlined in Section 28(1) of the Act depended on the validity of the trade mark registration. The Court clarified that the term "if valid" in Section 28(1) indicates that the proprietor must establish the registration's validity to enjoy exclusivity and protection against infringement.

5. Pepsico India Holdings Private Limited v. Kavita Kurungati, CA (COMM. IPD-PV) 2/2022.

6. Sun Pharma Laboratories Ltd v. Finecure Pharmaceuticals Ltd & Ors., 2023 SCC OnLine Del 4932.

The Court emphasized that even if a Plaintiff proves trade mark infringement, its eligibility for seeking/obtaining relief is tied to the validity of the registered trade mark, as per Sections 28(1) and 29 of the Act. During the interlocutory stage, the Plaintiff is required to establish a prima facie case, and the Defendant bears a heavier burden to counter this evidence. However, if the Defendant presents a strong case against the Plaintiff's prima facie evidence, the Court must consider it. In such situations, for the Plaintiff to succeed in obtaining relief against infringement, they must effectively present counter attacks on the trade mark's validity.

While refusing to grant injunction in favour of the Plaintiff, the Court noted that despite being aware of the use by the Defendant of the impugned "PANTOPACID" mark since 2009, the Plaintiff failed to take any steps till 2023 to injunct such use, during which time the Defendant has also grown into a formidable market player. Keeping such circumstances in view, the Court held that the balance of convenience would, clearly not justify bringing the use by the Defendant of the "PANTOPACID" mark to a complete halt at such a belated stage.

HIGH COURTS HAVE TERRITORIAL JURISDICTION TO ENTERTAIN RECTIFICATION PETITION BASED ON DYNAMIC EFFECT OF TRADE MARK REGISTRATION: HIGH COURT OF DELHI

Recently, the High Court of Delhi ("**Court**") in the case of *Dr. Reddy's Laboratories Limited v. Fast Cure Pharma*⁷ was confronted with an interesting question of law - whether a petition under Section 47 or 57 of the Trade Marks Act, 1999 ("**Act**") for rectification of a trade mark would lie only before the High Court having territorial jurisdiction over the office of the Trade Marks Registry where the impugned mark was registered, or the same could be filed in another High Court?

The Court observed that Section 124(1)(ii) of the Act comes into play where there is no ongoing rectification proceeding when a trade mark infringement lawsuit is initiated. In such cases, if either the Petitioner or the Respondent raises the argument that the opposing party's trade mark is invalid, Section 124(1)(ii) will become operational, and the Court must assess the validity of this argument. If the Court deems the argument valid, it is obligated to introduce the issue of trade mark invalidity and postpone the proceedings for three months to allow the concerned party to seek rectification from the High Court.

The Court also made a noteworthy observation regarding the term "High Court," emphasizing that the Act does not provide a specific definition for it. Consequently, the Act does not expressly exclude any High Court from exercising jurisdiction under either Section 47 or Section 57 of the Act. In other words, there is no statutory prohibition against any High Court exercising authority under these sections.

Furthermore, the Court pointed out that the Act contains only one provision, Section 57, which deals with the rectification of the Register of Trade Marks by removing a registered mark. Consequently, any petition for rectification referred to in Section 124(1)(ii) must be filed exclusively under Section 57, and no other provision is applicable. The Court said that since the Petitioners, in each of the rectification petitions, were experiencing the dynamic effect of the registration of the impugned trade mark within the jurisdiction of the Court, the rectification petition would, therefore, be maintainable before it.

DELHI HIGH COURT EXPANDS THE SCOPE OF DYNAMIC INJUNCTIONS AND ISSUES ORDER AGAINST ROGUE WEBSITES⁸

Recently, Universal City Studios ("**Plaintiffs**") filed a suit for copyright infringement against various rogue websites which were permitting the viewing, streaming, accessing, and downloading of the Plaintiff's content without any license or authorisation.

Although it has become a common procedure for the Courts to issue "Dynamic Injunction" orders in cases involving rogue websites to stop unauthorised streaming of online content/cricket matches/movies, this time, the Court went a step ahead to protect the interest of Plaintiff and issued a "Dynamic + Injunction" order. Such an order protects copyrighted works as soon as they are created, to ensure that no irreparable loss is caused to the authors and owners of copyrighted works, as there is an imminent possibility of works being uploaded on rogue websites or their newer versions immediately upon the release of films/shows/series etc.

The Court also noted that the dynamism of the injunction, by itself, in one country or another may not, however, be sufficient to protect copyright owners. There is an

7. *Dr. Reddy's Laboratories Limited v. Fast Cure Pharma*, 2023 SCC OnLine Del 5409.

8. *Universal City Studios LLC and Ors v. DotMovies.Baby and Ors.*, 2023:DHC:5842.

imminent need to evolve a global consensus in this regard, in as much as despite Internet Service Providers (“ISPs”) blocking rogue websites, such websites can be accessed through VPN servers, and other methods to which the long arm of the law cannot extend.

The Court has observed that any injunction granted by a Court of law ought to be effective in nature. The injunction ought to also not merely extend to content which is past content created prior to the filing of the suit but also to content which may be generated on a day-to-day basis by the Plaintiffs.

PATENT INFRINGEMENT LAWSUIT AGAINST DELL AND MICROSOFT STAYED BY US DISTRICT COURT

Polaris Power LED Technologies (“Plaintiff”) has filed a lawsuit against Dell Technologies, Inc., and Microsoft Corporation’s (“Defendants”) for implementing automatic brightness control software in Dell and Microsoft computers, which as per the Plaintiff, infringes its patent. The Patent & Trade mark Office (“PTO”) has passed a decision ordering re-examination of all the claims at issue in this case. Thereafter, PTO issued its First Office Action, rejecting nine of the twelve asserted claims as obvious over the prior art, and confirming three of the twelve claims as patentable.

After this development, the Defendants moved a motion seeking stay of the infringement suit. The Court held that for determining whether a stay during the pendency of the PTO proceedings is proper and a district Court will consider three factors: (1) whether the stay will unduly prejudice the non-moving party; (2) whether the proceedings before the Court has reached an advanced stage, including whether discovery is complete and a trial date has been set; and (3) whether the stay will likely result in simplifying the case before the Court.

After examining the facts and background of the case, the Court found all three factors to weigh in favour of staying this case until the conclusion of the PTO’s proceedings.

FASHION GIANT SHEIN FACING COPYRIGHT INFRINGEMENT LAWSUIT FOR VIOLATING RICO ACT, 1970



Shein, a prominent online fashion retailer, is facing a lawsuit in a California Federal Court which accuses the Company of engaging in “egregious” copyright infringement, potentially constituting racketeering. The lawsuit, filed on behalf of three designers (“Plaintiffs”) alleges that Shein produced and sold exact copies of copyrighted graphic designs, amounting to a violation of the Racketeer Influenced and Corrupt Organizations Act, 1970 (“RICO Act”).

The Plaintiffs contend that Shein, which is the world’s largest fashion retailer with annual sales of nearly USD 30 billion (Thirty Billion), has consistently engaged in a pattern of copyright infringement as a part of its strategy to introduce approximately 6,000 new items daily. The designers argue that Shein’s actions have caused substantial damage to their businesses, including diversion of trade, loss of profits, and harm to their reputations.

Despite accusations of copyright infringement, Shein is known to respond by claiming low sales and blaming third-party organizations for the alleged theft. The lawsuit further highlights challenges in pursuing legal action against Shein due to its decentralized and ever-changing corporate structure. The designers are seeking legal recourse under the RICO Act to address the alleged misconduct. This lawsuit adds to the list of difficulties Shein has faced, including allegations of labor violations, and forced labor concerns.

PLAYING SONGS IN MARRIAGES DOES NOT CONSTITUTE COPYRIGHT INFRINGEMENT AND NO ROYALTY CAN BE CHARGED THEREON: DPIIT

On July 24, 2023, the Department of Promotion of Industry and Internal Trade ("**DPIIT**") issued a significant public notice addressing complaints about copyright societies collecting royalties for playing musical works at events, particularly marriage functions. The notice strongly cautioned the public against complying with such demands, asserting that such royalty collection infringed upon Section 52 (1) (za) of the Copyright Act, 1957 ("**Act**"). Importantly, this provision explicitly exempts religious ceremonies, including marriage-related events, from copyright infringement.

Under the Act, a public performance license is mandatory for playing music in any format in public places or commercial establishments. The royalties obtained through these licenses go to music creators and publishers. Violating this requirement can result in penalties of up to Rs 2 lakhs in fines or three years of imprisonment. However, concerns arose about these societies issuing legal notices and charging exorbitant fees, especially for special events. Despite legal challenges, some Courts refused to restrain them from such practices.

LAW STUDENT GOT AN AD-INTERIM INJUNCTION AGAINST COPYRIGHT INFRINGEMENT BY COLLEGE'S PROFESSOR

A second-year law student ("**Plaintiff**") at CMR University, Bangalore has obtained an ad-interim injunction in a copyright infringement lawsuit against two professors ("**Defendants**") from Lloyd Law College in Noida. The Plaintiff alleged that her research paper was published in a Canadian journal under the names of the two Defendant professors without her authorization.⁹

To address the issue, the Plaintiff had initially issued a legal notice, demanding an 'unconditional apology' and an acknowledgment of her exclusive ownership of the article. Additionally, she contacted the journal to have the plagiarized work removed. Unfortunately, both attempts proved unsuccessful, compelling her to file the current lawsuit.

The Plaintiff argued that this paper was presented by her in a conference organised by Lloyd law college and claimed that her research paper qualified as a 'literary work' under Section 2(o) of the Copyright Act, 1957, conferring exclusive rights upon her for the material. She asserted that the Defendants' actions constitute an infringement of her rights, constituting a violation of Section 57 of the Copyright Act, 1957.

While granting the injunction in favour of the Plaintiff, the Court has imposed the condition that the Plaintiff will compensate the Defendants for their actual costs if the lawsuit does not succeed. This case underscores the importance of safeguarding intellectual property rights in academic and research contexts.

DELHI HIGH COURT RULED 'NOVAKIND' AND 'MANKIND' DEEMED CONFUSING IN PHARMACEUTICAL CONTEXT¹⁰

The High Court of Delhi ("**Court**") ruled on the potential confusion between the trade marks "Novakind" and "Mankind" when applied to pharmaceutical products. Mankind Pharma Limited ("**Plaintiff**") initiated a case against Novakind Bio Sciences Private Limited ("**Defendant**"), contending that the use of "Novakind" infringed on their registered trade mark "Mankind".

The Court highlighted the ambiguity created by the "KIND" suffix in both the names. Given that this suffix isn't customarily linked with pharmaceutical goods, an average customer might mistakenly associate one product with the other. It stressed the critical nature of such distinctions, especially in the pharmaceutical industry, where even slight mix-ups could have significant implications.

An interim injunction, issued on April 20, 2021, ("**Injunction**") had previously prevented Novakind from employing the "Kind" suffix. The Injunction has now been made absolute and effective until the case is fully resolved. The ruling underscores the importance of distinct and clear trade marking, especially in sectors as vital as pharmaceuticals, where clarity can have direct health related implications.

9. Aathira Mannath A. v. Lloyd Law College, OS.No.4789/2023.

10. Mankind Pharma Ltd. v. Novakind Bio Sciences Private Limited., 2023 SCC OnLine Del 4806.

BOMBAY HIGH COURT DIRECTED VIDEO SHARING PLATFORM TRILLER TO PAY USD 300,000 TO ZEE ENTERTAINMENT FOR USE OF COPYRIGHTED MUSIC ¹¹

The Bombay High Court ("**Court**") recently ordered the video-sharing platform, Triller, ("**Defendant**") to pay Zee Entertainment Enterprises Limited ("**Plaintiff**") unpaid dues of USD 300,000 (Three Hundred Thousand Dollars) (approximately INR 2,44,26,480 (Two Crore Forty Four Lakhs Twenty Six Thousand and Four Hundred and Eighty) for the use of its copyrighted music. The Court underscored Defendant's history of legal controversies in the U.S. and raised concerns about the potential disposal of its Indian assets to evade liabilities.

Diving deeper into the background, the Plaintiff and the Defendant entered into a Record Music License Agreement on October 13, 2020. According to this agreement, the Defendant was granted permission to use Plaintiff's copyrighted music from July 01, 2020, to June 20, 2021. In return, the Defendant was to pay USD 600,000 (Six Hundred Thousand) in four quarterly installments. However, the Defendant defaulted on its third and fourth installments, despite continuously using the licensed music. The Plaintiff, in response, sent multiple reminder notices and even a legal notice, demanding the outstanding amount, inclusive of 18% (Eighteen Percent) per annum interest.

In the Court's observation, it was noted that:

- The Defendant did not dispute its utilization of works licensed by Plaintiff.
- The Court dismissed Defendant's contention that the lawsuit was premature, emphasizing that the pending dues had been overdue for more than six months.
- The Court also pointed out the fact that Plaintiff refrained from pushing for interim reliefs until June 2023, possibly to allow room for settlement discussions.

Highlighting Defendant's potential attempt to sidestep its financial commitments, the Court remarked, "The Defendant has not produced any material to show its ability or capacity to repay the admitted debt." The Court eventually ruled in favour of the Plaintiff, instructing the Defendant to pay a penalty of INR 2.5 Lakhs (Two Lakhs Fifty Thousand) in addition to the outstanding amount.

DELHI HIGH COURT SETTLES THE THEOS V. THEOBROMA TRADE MARK INFRINGEMENT SUIT¹²

The High Court of Delhi ("**Court**") has decreed the Theos-Theobroma trade mark infringement suit with certain clarifications upon being approached by the parties stating that they were unable to file the settlement agreement in view of certain pending disputes. This comes after the Court had, in July 2022, passed an order setting the terms on which the parties had agreed to amicably settle the dispute, and had sought time to file a joint compromise application elaborating on the terms. The terms of the settlement included, *inter alia*, Theos restricting its business activities under the trade mark "THEOS" to the Delhi-NCR region and Theobroma restricting its use of the mark "THEOS" / "THEO'S" with respect to selected five food items offered by it.

It was clarified that though Theos was to restrict its operations under the brand "THEOS" to the Delhi-NCR region, it could file oppositions and take action against any misuse of identical or similar marks in any territory within India against any third party, except Theobroma. Additionally, the Court clarified that if Theos intended to expand its commercial activities beyond this region, whether through physical stores or online, it must do so under a mark/name which was neither identical nor deceptively similar to Theobroma. The Court also reiterated the five food items with respect to which Theobroma could use the mark "THEOS" / "THEO'S", in both physical and QR menu cards used at the physical outlets of Theobroma.

MADRAS HIGH COURT PROTECTS THE FAMOUS FOOD CHAIN, 'SANGEETHA' BY UPHOLDING THAT THE BONAFIDE USE OF CERTAIN NAMES DOES NOT EXTEND TO THE NAMES OF SPOUSES OF THE PERSON WHO ADOPTS THE TRADE MARK

The Hon'ble Madras High Court ("**Court**") in a recent judgement, *Sangeetha Caterers and Consultants v. New Sangeetha Restaurant*¹³, restrained the restaurant chain, New Sangeetha Restaurant ("**Defendant**"), which was infringing upon the trade marks of the famous and prior existing Sangeetha Caterers and Consultants ("**Plaintiff**").

11. Zee Entertainment Enterprises Ltd v. Triller Inc, 2023 SCC OnLine Bom 1916.

12. Theos Food Private. Limited. And Others v. Theobroma Foods Private. Limited., 2023 SCC OnLine Del 6077.

13. Sangeetha Caterers and Consultants v. New Sangeetha Restaurant, 2023 SCC OnLine Mad 4477.

The Plaintiff had been running a number of restaurants under its trade marks namely 'Sangeetha with Veena Mark', 'SVR Sangeetha', 'SVR Sangeetha Veg Restaurant' and 'Sangeetha Veg Restaurant with Veena Mark' in Class-42. Upon coming to know about the Defendant's business operations under the similar trade mark, i.e., New Sangeetha Restaurant ("**Impugned Mark**"), the Plaintiff immediately issued a cease and desist notice dated August 23, 2013 asking them to stop using identical/deceptively similar marks. The Defendant replied by claiming that the Impugned Mark was a common name and refused to comply with demand made by the Plaintiff.

The Court, perusing the arguments from both the sides, took note of Section 35 of the Trade Marks Act, 1999 ("**Act**") which stated that the registered owner of a trade mark is not entitled to interfere with bona fide use by any person of the following names: a) His own name b) His place of business c) Name of his predecessors in business d) Name of the place of business of his predecessors e)

Any bona fide description of the character of quality of goods or services. Thus, the Court said that the protection available under Section 35 of the Act, was not available to the names of the spouses of the person, who adopt the trade mark.

Further, the Court noted that the only difference in the rival marks was the prefix - 'NEW' added by the Defendant. Albeit, the rival marks may not be deemed 'identical' but upon an overall comparison, the use of the word, 'SANGEETHA', in bold letters by both parties, was bound to cause confusion in the minds of the public of average intelligence and imperfect recollection. Consequently, the Court held that the continued usage of the Impugned Mark by the Defendant tantamount to infringement of the registered trade mark of the Plaintiff and directed the former to surrender all unused offending materials like bill books, name board, packing materials and other stationery articles bearing the Impugned Mark for destruction.



SNIPPETS

DELHI HIGH COURT INJUNCTS ROGUE WEBSITE FROM PIRACY OF COPYRIGHTED CONTENT AHEAD OF THE ICC WORLD CUP 2023¹⁴

The High Court of Delhi ("**Court**") while dealing with a suit filed by Star India Private Limited and Novi Digital Entertainment Private Ltd. ("**Plaintiffs**") has issued injunction against nine rogue websites, restraining them from screening or disseminating any portion of the ICC World Cup cricket matches on electronic or digital platforms. The World Cup 2023 is scheduled to be held in India from October 05, 2023 to November 19, 2023 and is telecasted on Star Sports' channels as well as the OTT platform 'Disney+ Hotstar'.

The Court observed that the rights of these events were procured by the Plaintiffs after investing substantial monies and hence any such piracy would cause substantial damage to the Plaintiffs' revenue. It was reasoned by the Court that these websites have indulged in piracy of copyrighted content in the past and were likely to do so again, which necessitated the injunction order.

DUA LIPA FACING A USD 20 MILLION COPYRIGHT CLAIM OVER THE RECORDING OF HER SONG, LEVITATING¹⁵

A musician named Basko Kante ("**musician**") has issued a notice to the British-Albanian singer, Dua Lipa, ("**singer**") alleging copyright infringement. The musician has accused the singer of unauthorisedly using recordings of his talk box, an instrument that makes the vibration feel like musical instrument, in her song, Levitating. The musician has alleged that the singer had rights for using the talk box recordings in their original form, but not the remixed. He has also stated that he tried to amicably resolve the issue but had to resort to the legal route when the signer did not show any willingness to cooperate.

DELHI HIGH COURT CALLS FOR STRICT COMPLIANCE WITH PATENT RULES¹⁶

In a suit filed by Akebia Therapeutics Inc. ("**Petitioner**") in relation to procedural irregularities in post-grant opposition, the High Court of Delhi ("**Court**") has directed the Controller General of Patents, Designs, and Trade Marks to ensure strict adherence to the provisions under the Patents Rules, 2003 ("**Patent Rules**"). The Petitioner contended that the documents filed in support of the opposition lacked an affidavit as

per Rule 57 of the Rules, which deprived the Petitioner of filing their evidence. Upon perusal of the submissions of each party, the Court quashed the recommendations of the Opposition Board in light of the non-adherence to the Patent Rules. The Opposition Board was directed to reconsider the matter after taking into account the correct procedure laid down under the law.

EUROPEAN PARLIAMENT APPROVES REGULATION FOR NON-AGRI GEOGRAPHICAL INDICATIONS¹⁷

The European Parliament has adopted the Regulation concerning protection of Geographical Indications ("**GI**") for non-agricultural products, including craft and industrial products. Up until now, only wine, spirit drinks and agricultural products enjoyed the benefit from EU-wide GI protection however, this move establishes a novel, EU-wide *sui generis* system for safeguarding GIs, extending to products like ceramics and knives.

DELHI HIGH COURT RULES ON ADMISSIBILITY OF AI GENERATED DATA¹⁸

The High Court of Delhi ("**Court**") denied relying on ChatGPT responses in a suit filed by French luxury company, Christian Louboutin, against a partnership firm involved in the manufacture and sale of shoes allegedly in violation of its unique "red sole" shoes design. The Court emphasized that the accuracy and reliability of AI generated data is still a grey area and at best, such a tool can be utilised for a preliminary understanding or for preliminary research. It was held that chatbots like ChatGPT cannot substitute human intelligence or human element in adjudicatory process, and hence, responses by ChatGPT with respect to Plaintiff's reputation could not be the basis of adjudication of legal or factual issues in a court of law.

14. Star India Private Limited v. Jio Live.TV, 2023 SCC OnLine Del 6095.

15. Bosko Kante v. Dua Lipa, 2:23-cv-06186, (C.D. Cal.).

16. Akebia Therapeutics Inc. vs. Controller General of Patents, Design, Trademark and Geographical Indications, & Ors, 2023 SCC OnLine Del 4841.

17. European Parliament legislative resolution of 12 September 2023 on the proposal for a regulation of the European Parliament and of the Council on geographical indication protection for craft and industrial products and amending Regulations (EU) 2017/1001 and (EU) 2019/1753 of the European Parliament and of the Council and Council Decision (EU) 2019/1754 (COM(2022)0174 – C9-0148/2022 – 2022/0115(COD)).

18. Christian Louboutin Sas and Anr. V. Shoe Boutique – Shutiq, 2023 SCC OnLine Del 5295.

GRANT OF THE GEOGRAPHICAL INDICATION TAG

The following have been granted the Geographical Indication ("GI") tag in India:

- **Jammu & Kashmir** - Rajouri Chikri Woodcraft, Anantnag's Mushqbudji rice, Bhaderwah Rajma and Ramban Sulai Honey
- **Arunachal Pradesh** - Khaw Tai (Khamti Rice) and Yak milk product 'Yak Churpi'
- **Odisha** - Koraput Kalajeera Rice
- **West Bengal** - Three varieties of mangoes originating from Malda region, namely 'Lakshmanbhog,' 'Fajli,' and 'Himsagar'
- **Rajasthan** - 'Jalesar Dhatu Shilp', Udaipur Koftgari Metal Craft, Bikaner Kashidakari Craft, Jodhpur Bandhej Craft and Bikaner Usta Kala Craft
- **Goa** - Mankurad Mango and Goan Bebinca
- **Uttar Pradesh** – Agra Leather footwear and Jalesar metal craft
- **Odisha** – Koraput Kalajeera Rice'
- **West Bengal** – Malda Mango varieties, i.e., 'Lakshmanbhog', 'Himsagar', and 'Fazli.

CANVA RESTRAINED BY THE DELHI HIGH COURT FROM MAKING AVAILABLE ITS "PRESENT AND RECORD" FEATURE AMID A PATENT INFRINGEMENT SUIT.

The High Court of Delhi ("**Court**"), recently, restrained Canva, an Australian multi-national graphic design platform, from making available its "present and record" feature in India after a patent infringement suit was filed by RxPrism Health Systems Private Limited ("**Plaintiff**"). As per the Plaintiff, it developed a novel and innovative system and a method for 'creating and sharing interactive content' and filed an Indian patent application, which was duly granted. Upon learning of use of the same feature, "Show & Tell" by Canva Pty Limited ("**Defendant**"), the Plaintiff brought a suit for infringement. Upon ascertaining the contentions, the Court noted that the working of the Defendant's 'Present and Record' feature when compared with the claims in the Plaintiff's patent application would demonstrate that almost all the same steps therein are present in the Defendant's product, thus, prima facie, establishing a case of patent infringement.

CASIO SECURED FIRST-EVER 3-DIMENSIONAL TRADE MARKS FOR ITS G-SHOCK WRISTWATCH IN JAPAN



The Japan Patent Office has recently granted a 3D trade mark registration for the distinctive design of the initial model within the G-Shock line of durable wristwatches. Remarkably, this marks the first instance in Japan where a 3D trade mark has been officially registered solely for the shape of a wristwatch, devoid of any accompanying logos or text.

The G-Shock brand, which made its debut in 1983, has enjoyed widespread popularity, with Casio selling over 140 million units in more than 140 countries. In a previous attempt made in 2021, Casio sought to secure a 3D trade mark for the product's shape but was met with a refusal, as the authorities believed it lacked distinctive characteristics setting it apart from other merchandise. Subsequently, the company's claim was re-evaluated following a survey of 1,100 participants aged 16 and above, revealing that approximately 66% (Sixty Six Percent) of participants associated the images presented with "Casio" or "G-Shock".

GLOBAL PHARMACEUTICAL COMPANIES, BRISTOL MYERS SQUIBB AND ASTRAZENECA SETTLED PATENT INFRINGEMENT LAWSUITS FOR USD 510M.

AstraZeneca has reached a settlement agreement with Bristol-Myers Squibb ("**BMS**") amounting to USD 510 million (Five Hundred and Ten Million) to resolve a series of patent-infringement lawsuits. BMS had initiated three distinct legal actions alleging that AstraZeneca's pharmaceuticals, Imfinzi and Imjudo, infringed upon patents held by BMS covering its PD-1 inhibitor Opdivo and CTLA-4 agent Yervoy.

Specifically, Opdivo and Imfinzi are both classified as PD-1 inhibitors, while Yervoy and Imjudo, are anti-CTLA-4

antibodies. The legal dispute commenced in March 2022 with eight Opdivo patents, and later extended to an additional suit filed by BMS in April of the same year. Subsequently, in January 2023, BMS filed a third lawsuit, centring on Yervoy and Imjudo. The U.S. District Court for the District of Delaware had scheduled a trial for April 2024. However, AstraZeneca, in its second-quarter earnings report, disclosed a global settlement agreement with BMS and Ono Pharmaceutical, comprehensively resolving all the patent disputes associated with Imfinzi and Imjudo, amounting to USD 510 million (Five hundred and Ten Million). This resolution represents a prudent legal course of action, serving to mitigate time and legal expenses for both parties involved.

GOVERNMENT'S STARTUPS IPR SCHEME TO BOOST INNOVATION

Union Minister Jitendra Singh announced the 'StartUps Intellectual Property Rights Protection' scheme during the 'National Intellectual Property Festival'. This initiative, aimed at fostering innovation and entrepreneurship, provides startups with an 80% (Eighty Percent) rebate in patent filing and a 40% (Forty Percent)-50% (Fifty Percent) rebate in filing fees under the new Trade Marks Rules, 2017. Additionally, the government has reduced fees for the registration of Industrial Designs for small entities. Singh emphasized coupling this effort with India's traditional knowledge, thereby giving startups a distinct advantage and competitive edge globally.

CGPDTM SEEKS PUBLIC INPUT ON IP MANUALS AND GUIDELINES

The office of the Controller General of Patents, Design and Trade marks ("**CGPDTM**") has issued a public notice on August 30, 2023, seeking feedback from stakeholders regarding the revision of Patents, Designs, Trade Marks, Geographical Indication, and Copyright Manuals and Guidelines. These manuals play a vital role in standardizing the implementation of statutes and rules. While the Patent Manual was recently revised in 2019, other manuals, such as the Trade Mark and Copyright Manuals, have remained unchanged since their introduction in 2015 and 2018, respectively. The public notice follows the recent unveiling of the draft Patent (Amendment) Rules, 2023 ("**Draft Amendment Rules**") by the Department for Promotion of Industry and Internal Trade. The deadlines for submitting comments on the

draft amendment rules and the manuals are September 22, 2023, and October 15, 2023, respectively.

LIVE TRANSCRIPTION OF EVIDENCE ALLOWED BY DELHI HIGH COURT IN PATENT LAWSUITS

The High Court of Delhi ("**Court**"), in *Communication Components Antena Inc. v. Rosenberger Hochfrequenztechnik GmbH & Co. Kg. & Ors.*¹⁹, discussed the procedure for a patent infringement trial to facilitate an expeditious proceeding. The matter was governed by Rule 16 of the High Court of Delhi Rules Governing Patent Suits, 2022, which allows the Court to proceed with summary adjudication to expedite the matter if *inter alia* the patent has a less than 5-year term left. In the instant case, the patent term was expiring in 2027 (*which is less than 5 years*) and hence the Court proceeded with summary adjudication. One of the prominent directions coming out of this judgment is recordal of evidence presented during the trial – which meant allowing live transcription of the same.

Following are a few major directions issued pursuant to the discussion:

- Duration of cross-examination of the technical witness of each party was restricted to one and a half hours;
- Duration of the cross-examination of the non-technical witness was restricted to one hour;
- Evidence presented during the trial shall be recorded before the Court, therefore allowing the live transcription of the same;
- Cost estimate for the transcription shall be exchanged between the parties, and the final cost shall be borne by both the parties; and
- Presence of up to 2 personnel from the transcription agency in the Court was allowed to perform the live transcription of the proceedings.

While recordal of evidence has been allowed, there is no clarity on whether these transcripts would be available for public access.

19. *Communication Components Antena Inc. v. Rosenberger Hochfrequenztechnik GmbH & Co. Kg. & Ors.* MANU/DE/4318/2023

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