



INTELLECTUAL PROPERTY UPDATES FROM INDIA

Intellectual Property Team

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INTRODUCTION

As we embark to the year 2024, we are pleased to present the first edition of our newsletter this year. In this instalment, we delve into a diverse array of legal disputes, scientific breakthroughs, and regulatory clarifications that have shaped the landscape of intellectual property rights. The courts worldwide have remained vigilant in safeguarding the rights of creators and brand owners. Notable adjudications from the Delhi High Court in the case of 'New Balance' stylized logo recognition emphasized the importance of recognizing and safeguarding transborder reputation enjoyed by international trade marks.

Additionally, the recent decision regarding live event broadcasting rights clarified the distinction between 'Live Rights' and 'Non-Live Rights', asserting that live broadcasting rights do not inherently constitute copyright. This ruling has significant implications for the taxation of foreign remittances related to live broadcasting rights, providing clarity to stakeholders in the broadcasting industry. The case, Rihanna v. Puma

underscores the importance of timely registration and protection of intellectual property rights, particularly in the digital age where social media platforms play a significant role in publicizing creative works.

Furthermore, the granting of geographical indication tags to unique products from Odisha clearly signifies the rich cultural heritage and diverse agricultural produce of the region and the protection accorded by well-shielded IP rights. This recognition not only preserves traditional knowledge but also enhances market competitiveness and promotes sustainable development. Amidst these developments, our newsletter aims to provide insightful analysis and commentary on the latest trends and issues in intellectual property law. From high-profile trademark disputes to regulatory clarifications on taxation and copyright, each article offers a nuanced perspective on the evolving landscape of intellectual property rights

So, without further ado, let's dive into this edition! We appreciate your readership and wish you happy reading!



SNIPPETS

RIHANNA'S SOCIAL MEDIA DILEMMA: HIGHLIGHTING THE VITALITY OF DESIGN SAFEGUARDING



The European Court of Justice (“**Court**”), on 6 March 2024, ruled that Puma cannot claim legal protection for a shoe design previously shared on Rihanna’s social media.¹ The Court’s decision comes in the wake of Puma’s attempt to register the design with the European Intellectual Property Office (“**EUIPO**”) two years after Rihanna, in her role as creative director, posted photos of the shoes. Notably, “novelty” and “individual character” are crucial under both the UK and EU design regimes, necessitating that the design must not have been publicly disclosed. The Court, accordingly, emphasized the significance of Rihanna’s Instagram post, noting its prior public disclosure effectively invalidated the design’s novelty and individual character, crucial for Puma’s Registered Community Design.

OPENAI SECURES INJUNCTION AGAINST TECH ENTREPRENEUR’S ‘OPEN AI’ WEBSITE

OpenAI, (“**Plaintiff**”) a leading organization in artificial intelligence research, successfully obtained an order²

from the United States District Court Northern District of California (“**Court**”) to block a tech entrepreneur’s website named ‘Open AI’ (“**Defendant**”). This decision came as a result of legal action taken by OpenAI to protect its brand and intellectual property rights. The Defendant, which shared a name similar to OpenAI, raised concerns of potential confusion among consumers and a potential dilution of the distinctive reputation of OpenAI’s brand. To address these concerns, OpenAI pursued legal recourse to prevent any unauthorized use of its name and to protect its reputation in the industry.

RESEARCHERS PATENT MOLECULE WITH POTENTIAL FOR ENHANCED SAFETY IN DIABETES MEDICATION

The United Institute of Pharmacy (“**UIP**”) announced the synthesis of a new active molecule aimed at enhancing anti-diabetic medication by significantly reducing side effects.³ This development suggests the molecule could surpass traditional medicines in effectiveness. The innovation was led by a six-member team: Alok Mukherjee, Shanti Bhushan Mishra, Nishi Gupta, Anil Kumar Singh, Shradhanjali Singh, and Amit Kumar Singh. Contrary to common adverse reactions associated with existing anti-diabetic drugs, such as gastrointestinal issues and liver inflammation, this molecule presents a promising reduction in such side effects. The Indian Patent Office granted the patent for this molecule, titled ‘*Synthesis of Amide Derivatives of Vanillic Acid: In Silico Evaluation Docked Against Antidiabetic Target*’, on 19 February 2024, marking a significant milestone in diabetic treatment research.

PRAYAGRAJ INSTITUTION BAGS PATENT FOR EARTH-FRIENDLY BANANA LEAF TEA POUCHES

Vinod Kumar Verma and Sanjog J, specialists from Sam Higginbottom University of Agriculture, Technology and Sciences, Prayagraj (“**SHUATS**”), have innovated a sustainable and health-conscious alternative to conventional tea bags by utilizing banana leaves. The research highlights a shift towards eco-friendly products by replacing traditional plastic fibers, known for their

1. Puma SE v European Union Intellectual Property Office; Case No. T-647/22; accessible at <https://curia.europa.eu/juris/document/document.jsf?jsessionid=9979C80A5A5B53614A439F34FF190C4D?text=&docid=283501&pageIndex=0&doclang=EN&mode=req&dir=&occ=first&part=1&cid=82062>.

2. OpenAI, Inc., v. Open Artificial Intelligence, Inc., and Guy Ravine; Case No.: 4:23-cv-3918-YGR; accessible at <https://www.courtlistener.com/docket/67666723/openai-inc-v-open-artificial-intelligence-inc/>.

3. The Times of India, Accessible at <https://timesofindia.indiatimes.com/city/allahabad/scientists-patent-molecule-for-potentially-safer-diabetes-drug/articleshow/108029247.cms>.

prolonged degradation period and contribution to microplastic pollution, with banana leaves. These leaves are treated through a meticulous process of cleaning, drying, perforating, and stitching to create tea bags. This method ensures the tea bags are fully biodegradable, addressing critical environmental concerns by preventing harmful residue and promoting quicker decomposition. This novel approach not only presents a healthier option compared to the prevalent plastic-infused tea bags but also aligns with environmental conservation efforts. Recognizing the significant impact of this invention, the Patent office has awarded it patent protection.

CALIFORNIA COURT PARTIALLY DISMISSES TWO LAWSUITS AGAINST OPENAI OVER BOOKS

A Federal Court in California, USA ("**Court**") partially dismissed copyright infringement lawsuits filed against OpenAI ("**Defendant**") by authors, including celebrities such as Sarah Silverman and Paul Tremblay ("**Plaintiffs**"), who argued that their works were unlawfully utilized to train ChatGPT.⁴ However, the Court ruled out several claims, such as vicarious copyright infringement, citing a lack of "substantial similarity" between the authors' books and ChatGPT's responses. Pertinently, OpenAI remains accused of unfair competition law violations. These proceedings were merged with another lawsuit featuring authors like Michael Chabon and Ta-Nehisi Coates and the case is currently pending before the Court.

UPCOMING MODIFICATIONS TO DISNEY'S TICKETING AND ADMISSIONS PROTOCOL

Walt Disney initiated a strategic enhancement of its ticket security measures to combat counterfeit tickets, as revealed in a patent application by Disney Enterprises Inc. This advanced move leverages a blockchain-based ticketing system, designed to digitally authenticate tickets with transaction terms embedded directly onto the blockchain, ensuring that the data remains immutable. The system also accommodates the printing of physical tickets, paired with digital verification capabilities, aiming to significantly curtail the prevalence of fake ticket incidents. Although Disney has not publicly disclosed specific details or a timeline for the deployment of this technology, the implementation of such a system is anticipated to substantially reduce the occurrence of ticket scams, thus boosting consumer confidence.

LAWSUIT ALLEGING COPYRIGHT INFRINGEMENT AGAINST SINGER-SONGWRITER TRAVIS SCOTT

On 25 January 2024, Dion Norman and Derrick Ordogne, ("**Plaintiffs**"), took legal action against Jacques Webster (*professionally known as Travis Scott*), Leland Wayne (*professionally known as Metro Boomin*), James Litherland (*professionally known as James Blake*), Sony Music Publishing, LLC, and Sony Music Holdings Inc., ("**Defendants**").⁵ This lawsuit stems from allegations of copyright infringement concerning the musical composition "Bitches Reply," which was authored and recorded by the Plaintiffs in 1991. The Defendants are accused of unauthorized utilization of this copyrighted work in their sound recordings, "Til Further Notice" and "Stargazing," which were distributed through various platforms and outlets. The Plaintiffs assert their copyright ownership of "Bitches Reply" and claim that the Defendants infringed upon their rights by reproducing, distributing, and creating unauthorized derivative works without obtaining permission. The Plaintiffs sought compensatory, statutory, and punitive damages, as well as attorney's fees and any other relief deemed just and proper by the Court.

MUHAMMAD ALI BRAND PURSUES TRADE MARK APPLICANT TARGETING G.O.A.T

In a notable trademark dispute, Muhammad Ali Enterprises ("**Plaintiff**") has initiated opposition proceedings against Be the GOAT Games ("**Defendant**") over the use of the acronym "G.O.A.T." (Greatest of All Time), a term closely associated with the legendary boxer Muhammad Ali.⁶ GOAT USA Inc., another entity with vested interests, has also entered the fray with an opposition filing. The core of the contention lies in the claim of potential consumer confusion and brand dilution, with the Plaintiff arguing that the term "G.O.A.T." is intrinsically linked to their brand identity, thereby implying that the use of the same by the Defendant could mislead consumers and diminish the distinctive character of their trade mark. The Plaintiff's opposition is predicated on the belief that

4. Paul Tremblay, vs. OpenAI, Inc: Case Nos. 23-cv-03223-AMO; Accessible at https://storage.courtlistener.com/recap/gov.uscourts.cand.414822/gov.uscourts.cand.414822.104.0_1.pdf.

5. Norman et al v. Webster et al; Case Nos. 2:2024cv00240; Accessible at <https://dockets.justia.com/docket/louisiana/laedce/2:2024cv00240/267789>

6. Muhammad Ali Enterprises LLC v. Be the GOAT Games, LLC; Accessible at <https://ttabvue.uspto.gov/ttabvue/v?qt=adv&procstatus=All&pno=91289354+&propno=&qs=&propnameop=&propname=&pop=&pn=&pop2=&pn2=&cop=&cn=>

the acronym, by virtue of its association with Muhammad Ali, would lead consumers to mistakenly associate the Defendant's products with the Plaintiff. However, the dispute is further complicated by the acknowledgment of the term "Greatest of All Time" being utilized across various industries for a prolonged period, thus challenging the notion of exclusive trade mark rights over a widely recognized acronym.

DELHI ITAT CLARIFIES LIVE EVENT BROADCASTING RIGHTS NOT CONSIDERED 'COPYRIGHT', THEREFORE PAYMENTS ASSOCIATED CANNOT BE TAXED AS 'ROYALTY'

The Delhi Income Tax Appellate Tribunal (ITAT) ("**Court**"), in a ruling that favored the assessee ("**Appellant**"), determined that the payments made to foreign entities for the acquisition of live broadcast rights of sports events are not classified as "royalty" under section 9(1)(vi) of the Income Tax Act, 1961 ("**Act**").⁷ This judgment came as a reversal of the assessing officer's ("**Respondent**") initial classification of such payments as royalty, which necessitated a tax deduction at source under Section 195 of the Act. The Court elucidated the distinction between 'Live Rights' and 'Non-Live Rights', asserting that live broadcasting rights do not inherently constitute copyright. It was adjudicated that since the payments for live rights did not pertain to the utilization of any satellite or specific process, they should not be subject to taxation as royalty for the non-resident recipients. Consequently, the Appellant was absolved from the obligation of tax deduction at source for these foreign

remittances, thereby not being in default according to the tribunal's findings.

SIX ODISHA PRODUCTS GRANTED GEOGRAPHICAL INDICATION TAGS, RANGING FROM RED ANT CHUTNEY TO BLACK RICE

Six unique products from Odisha have been conferred with the Geographical Indication (GI) tag. The Lanjia Saura paintings,⁸ a testament to ancient tribal artistry, along with the Koraput Kala Jeera rice,⁹ acclaimed for its fragrant aroma and healthful properties, showcase the area's traditional expertise and farming customs. The Similipal Kai chutney,¹⁰ made from red weaver ants, embodies the unique dietary customs of the locale. Furthermore, the Nayagarh Kanteimundi Brinjal,¹¹ notable for its distinctive flavor and efficiency in cooking; Odisha Khajuri Guda,¹² a natural sweetener; and Dhenkanal Magji,¹³ a confection based on cheese, collectively accentuate the region's varied agricultural produce and culinary traditions.

7. Lex Sportel Vision Private Limited, New vs ITO, Ward Int. Taxation 2(2)(1), New on 26 December, 2023 ITA No. 2397/Del/2023.

8. Accessible at <https://search.ipindia.gov.in/GIRPublic/Application/Details/871>.

9. Accessible at <https://search.ipindia.gov.in/GIRPublic/Application/Details/814>.

10. Accessible at <https://search.ipindia.gov.in/GIRPublic/Application/Details/725>.

11. Accessible at <https://search.ipindia.gov.in/GIRPublic/Application/Details/739>.

12. Accessible at <https://search.ipindia.gov.in/GIRPublic/Application/Details/690>.

13. Accessible at <https://search.ipindia.gov.in/GIRPublic/Application/Details/724>.



LONG FORM

ANDHRA PRADESH HIGH COURT UPHOLDS FAIR USAGE IN ACADEMIC PUBLISHING

In a recent decision, The Andhra Pradesh High Court ("**Court**") has held that no copyright vests in mathematical and science textbooks. The Court also observed that 'educational use for the benefit of students and educational institutions' is covered under 'fair use' under the Copyright Act, 1957 ("**Act**"). This decision has been passed in a Writ Petition filed by Addala Sitamahalakshmi, the proprietor of Deepthi Publications House ("**Petitioner**").¹⁴ These petitions challenged a notification dated November 09, 2010, issued by the Andhra Pradesh Government ("**Notification**") which restricted private colleges from publishing their own books. The Notification also directed all private colleges to purchase books, as prescribed by CBSE and ICSE, from respondent no. 2 i.e. Telugu Akademi, a government-controlled body under the Higher Education Department. Through the Writ Petitions, the Petitioner also sought quashing of a criminal case initiated against them in 2011 for alleged piracy.

The legal issue revolved around the interpretation of copyright exceptions, particularly in educational contexts, and the delineation of copyrightable material under the Act. The Court held that academic publications, even those derived from copyrighted materials, fall under the exceptions outlined in Section 52 of the Act, thus exempted from copyright infringement claims when used for educational purposes. Additionally, the Court noted that textbooks incorporated into syllabus and guidebooks aiding problem-solving are considered under the ambit of fair use, aligning with the intent to facilitate education.

The Court also clarified the inherent nature of copyright, emphasizing that, according to the Act, it is a legislative right, distinct from natural or common law rights. This distinction is critical as it confines copyright protection to original works of creativity, explicitly excluding mathematical formulas and scientific concepts, which are rooted in facts and natural laws, thus non-copyrightable. This judgment will significantly impact the academic sphere, affirming that original works in these disciplines, while protected, do not cover the underlying principles of mathematics and science that are considered universal knowledge.

Resultantly, the Court absolved the Petitioner from copyright infringement accusations but also invalidated

governmental restrictions on textbook publishing by private colleges.

MAKEMYTRIP VS. GOOGLE INC – THE ADWORDS ISSUE REACHES SUPREME COURT

In a recent decision, the Supreme Court of India ("**Court**") dismissed the Special Leave Petition ("**SLP**") filed by MakeMyTrip India Pvt Ltd ("**Petitioner**") challenging the judgment dated December 14, 2023 passed by a Division Bench of the Delhi High Court ("**DB**") wherein it was held that registering trade marks as keywords cannot be considered infringement when there is no confusion or unfair advantage.¹⁵

It has been argued by the Petitioner before the Delhi High Court that the use of its trade mark by competitors in search engine keyword bidding could mislead consumers, thereby constituting an infringement of its trade mark rights. However, Google countered this by emphasizing the role of keywords in enhancing consumer choice and argued that such use does not inherently lead to consumer confusion.

The issue before the Court was whether the visibility of the Petitioner's and a competitor's name on the same search results page could mislead the consumer into believing they are the same or related businesses. Ultimately, the Court dismissed the SLP and upheld the DB's finding which had held that at the preliminary stage of legal proceedings, the use of a trade mark as a keyword in Google Ads does not, by itself, constitute use as a trade mark in a manner that is likely to cause confusion or deception among consumers.

DELHI HIGH COURT ISSUES DYNAMIC INJUNCTION AGAINST ROGUE WEBSITES STREAMING COPYRIGHTED CONTENT FROM STAR CHANNELS, INCLUDING HOTSTAR

The Delhi High Court ("**Court**"), delivered a landmark ruling in favor of Star India ("**Plaintiff**"), granting a dynamic injunction against 21 websites accused of illegally streaming content from STAR channels and the

14. Judgment dated February 21, 2024 in AddalaSitamahalakshmi vs State Of Andhra Pradesh; Writ Petition No.13251 of 2011 & Criminal Petition No. 4032 of 2011.

15. Makemytrip India Private Limited v. Booking.Com B.V. &Ors; CS (COMM) 268/2022 & I.As. 6443-47/2022.

Disney+ Hotstar OTT platform.¹⁶ The Plaintiff, comprising Star India and producers of television shows, films, and web series aired on its platforms, initiated legal action against these entities ("**Defendants**") for unauthorizedly distributing their proprietary content.

The legal contention centered around the unauthorized distribution of copyrighted content by the defendant websites, posing significant financial and reputational damages to the Plaintiff and the broader entertainment industry. The Court found that the Plaintiff had successfully established a strong prima facie case warranting both an ex-parte ad interim injunction and a dynamic injunction. This determination was critical in addressing the transient nature of digital piracy, where infringing websites frequently change domain names to evade legal actions.

In its decision, the Court highlighted the severe impact of digital piracy on content creators and distributors, acknowledging the Plaintiff's susceptibility to irreparable loss in the absence of legal intervention. To mitigate this, the Court ordered domain name registrars to lock, suspend, or deactivate domains and subdomains linked to the infringing activities. Additionally, internet service providers ("**ISPs**") were directed to block access to these sites, embodying a comprehensive strategy to stymie the proliferation of pirated content.

A crucial element of the judgment involved the Department of Telecommunications ("**DoT**") and the Ministry of Electronics and Information Technology ("**MEITY**"), tasked with ensuring ISP compliance with the injunction. Additionally, the lawsuits scope extended to a John Doe/Ashok Kumar order, facilitating action against unnamed entities contributing to copyright infringement.

The judgment not only mandates the immediate blocking of identified rogue sites but also establishes a precedent for dynamically addressing digital piracy. It enables the Plaintiff to promptly act against new infringing sites, ensuring an effective enforcement mechanism.

DELHI HIGH COURT CLARIFIES: LEGAL DATABASE SUBSCRIPTION DOES NOT IMPLY COPYRIGHT TRANSFER

In a recent case, the Delhi High Court ("**Court**") addressed a crucial issue pertaining to the taxation of subscription

fees paid by Indian subscribers to legal databases like LexisNexis.¹⁷ This matter emerged when an assessee, Relx Inc. (owner of LexisNexis) ("**Respondent**"), reported "nil" income following scrutiny assessment concerning the subscription fees garnered from Indian subscribers for accessing its legal database. Initially, the case was presented to the Income Tax Appellate Tribunal (ITAT), which ruled in favour of the Respondent, leading the IT Department ("**Appellant**") to file an appeal before the Court.

LexisNexis provides its users with access to a wide range of legal resources, including judgments, articles, legislation, and research materials crucial for legal professionals. The Respondent argued that the revenue from the subscription fees should be classified as "business income" and, due to the absence of a Permanent Establishment ("**PE**") in India, it should not be subject to taxation under Article 7 of the Double Taxation Avoidance Agreement ("**DTAA**").

The legal issue revolved around whether the subscription fees should be treated under Article 12(4)(b) of the DTAA, which concerns "fees for included services." The Respondent maintained that granting access to the database did not equate to a copyright transfer or constitute an "included service" since it did not entail the imparting of technical knowledge, skill, or processes. Contrarily, the Appellant, treated the income as stemming from technical consultancy, aligning it with Article 12(4) of the DTAA. Despite the Respondent's contention, the Dispute Resolution Panel supported the assessment, prompting an appeal to the Tribunal, which ultimately ruled in favor of the Respondent. It concluded that the income generated was indeed business profit, not taxable in India in the absence of a PE, primarily because there was no copyright transfer or provision of technical services as per Article 12(4)(b) of the DTAA.

Before the Court, the Appellant argued for the taxation of the income under Article 12 alongside Section 9(1)(vii) of the Income Tax Act, 1961, insisting on its categorization as technical service fees. However, the Court demarcated the line between copyright transfer and the mere granting of rights to use copyrighted material. It clarified

16. Star India Private Limited & Anr vs. Teriimeridooriyan.com & ors, CS(COMM) 163/2024, I.A. 4270/2024, I.A. 4271/2024, I.A. 4272/2024 & I.A. 4273/2024.

17. The Commissioner of Income Tax - International Taxation -3 vs. Relx Inc., ITA 630/2023.

that access to the LexisNexis database did not amount to a copyright transfer, as the Respondent retained copyright ownership, thus not constituting a transfer of copyright or technology application as specified in Article 12(4)(b) of the DTAA.

The Court's decision solidified the stance that subscription fees paid for accessing legal databases like LexisNexis are neither royalties nor fees for technical services under the prevailing tax laws.

JAVA JUSTICE: DELHI HIGH COURT HALTS SOFTWARE FIRM'S TRADE MARK MISUSE FOLLOWING ORACLE AMERICA'S ACTION

The Delhi High Court ("**Court**") recently adjudicated a trade mark infringement lawsuit involving Oracle America Inc. ("**Plaintiff**") against two software entities, JavaTpoint Limited and JavaTpoint Tech, ("**Defendants**").¹⁸ The legal dispute arose from the Defendants' alleged unauthorized use of the Plaintiff's 'JAVA' trade mark within domain names and service offerings. On 12 February 2024, a Single Bench of the Delhi High Court granted injunction in favor of the Plaintiff, explicitly barring the Defendants from using the 'JAVA' trade marks in any form.

Plaintiff contended that the Defendants' operations under the 'JavaTpoint' trade mark for software training services infringed its trade mark rights. The Defendants argued that JAVA, as a programming language, cannot be monopolized by the Plaintiff and, additionally, that the competing trade marks bear no resemblance. On the other hand, the Plaintiff explicitly stated its lack of intent to monopolize the JAVA trade mark, a stance supported by its publication of 'Third Party Usage Guidelines' on its website, which distinguish between permissible and impermissible uses.

After considering the case put forth by the parties, the Court held that the Defendants' use of the 'JAVA' infringed the Plaintiff's rights on its 'JAVA' marks under Sections 29(1) and 29(5) of the Trade Marks Act, 1999 ("**Act**"). The Court did not agree with the Defendants' argument that 'JAVA' as a programming language could not be granted protection under the Act. The Court ruled that the addition of 'TPOINT' as a suffix does not mitigate the fact that 'JAVA' constitutes a dominant element of the Defendants' trade mark, utilized in a commercial context. The Defendants' employment of

the logo transcends mere citation of the programming language for descriptive or pedagogical purposes. Furthermore, the Court noted that the Defendants' use of the term 'JAVA' within their domain name falls outside the scope of Plaintiff's defined acceptable use, thereby constituting an infringement of the trade mark.

Resultantly, the Court enjoined the Defendants from conducting Oracle-certified courses using the 'JAVA' trade mark and mandated that they, along with their affiliates, cease using 'JAVA' within their domain name 'javatpoint.com' and in association with their services. Furthermore, the Court also restrained the Defendants from using the 'JAVA' trade mark in their domain names and services.

DABUR VS DHRUV RATHEE: DISPARAGEMENT CLAIMS BY DABUR

In a significant legal dispute before Calcutta High Court ("**Court**"), Dabur India Limited ("**Petitioner**") initiated proceedings against Dhruv Rathee, a widely followed YouTuber ("**Respondent**").¹⁹ The crux of the contention revolved around a video titled '*Is Fruit Juice Healthy? The Harsh Truth*' uploaded by the Respondent, which as per the Petitioner disparaged its 'Real' packaged fruit juice brand.

The Court's involvement was sought after the Petitioner claimed that the video unfairly compared its 'Real' fruit juices with carbonated drinks and made derogatory claims about the health effects of consuming packaged fruit juices, specifically targeting 'Real' juice by partially blurring its logo and using promotional clips.

The Petitioner argued that the Respondent's video specifically targeted and denigrated its product, causing potential harm to its reputation and goodwill. Despite the Respondent's refusal to remove the video upon request, the Court found a strong prima facie case in favor of the Petitioner.

Initially the Court directed the Respondent to remove parts of the video allegedly disparaging 'Real' fruit juice, in violation of Section 29(9) of the Trade Marks Act, 1999. However, following non-compliance with this directive, the Court on March 24, 2024, mandated YouTube to

18. Oracle America Inc v. Sonoo Jaiswal, CS(COMM) 2/2024, I.A. 60/2024.

19. Dabur India Ltd. v. Dhruv Rathee, IA NO: GA/1/2023 CS/41/2023.

take down the video entirely. The Petitioner asserted that the video not only disparaged the 'Real' brand by making unfair comparisons but also made baseless health-related claims that consuming bottled fruit juice could lead to hair loss and other health issues, thereby damaging the brand's reputation.

However, on 29 February 2024, the Court accepted the Respondent's proposal to blur the images mirroring Petitioner's 'Real' Juice packet in the disputed video.

DELHI HIGH COURT ENLISTS LARGER BENCH TO REVIEW JURISDICTION OF HIGH COURTS REGARDING CANCELLATION PETITIONS UNDER THE TRADE MARKS ACT

The Delhi High Court ("**Court**") will be adjudicating on the matter concerning its jurisdiction over rectification and cancellation petitions under the Trade Marks Act, 1999 ("**TM Act**").²⁰ The matter has been set for a hearing on 10 May 2024, with the Court inviting submissions from the involved parties.

The matter revolves around the jurisdictional scope for entertaining rectification petitions under Section 57 of the TM Act. The petitioners argued, relying upon the *Girdhari Lal Gupta v. K. Gian Chand Jain*²¹ ("**Girdhari Lal Gupta Case**") under the Designs Act, 2000 that jurisdiction might extend to any High Court experiencing the "dynamic impact" of the contested registration. In contrast, the respondents disputed this interpretation, suggesting that the precedent from the *Girdhari Lal Gupta* case, which did not contemplate the establishment or dissolution of the Intellectual Property Appellate Board (IPAB), should not dictate jurisdiction under the TM Act. They posit that the lack of a defined 'High Court' in the Tribunal Reforms Act, 2021 ("**TRA**") results from an oversight, urging the court to maintain the continuity of the legal framework established under the 1958 Act and the subsequent TM Act.

The Court's decision to escalate this matter to a larger Bench highlights the complexity and significance of the jurisdictional questions posed, especially in light of amendments introduced by the TRA. The larger Bench will deliberate on three critical issues: the relevance of the *Girdhari Lal Gupta* precedent within the context of the TM Act as amended; the determination of High Court jurisdiction under Section 57 of the TM Act, predicated on the location of the Trade Mark Registry issuing the

disputed trade mark; and the interpretation of 'the High Court' within Sections 47, 57, and 91 of the TM Act. The matter has been set for a hearing on 10 May 2024, with the Court inviting submissions from the involved parties.

DELHI HIGH COURT TO ADJUDICATE OWNERSHIP DISPUTE REGARDING THE ORIGINS OF BUTTER CHICKEN AND DAL MAKHANI RECIPES

In a notable trade mark dispute, the Delhi High Court ("**Court**") is presiding over a case between Moti Mahal ("**Plaintiff**") and Daryaganj ("**Defendant**"), both of whom claim association with the culinary legacy of butter chicken and dal makhani.²² The Plaintiff initiated a suit against the Defendant, alleging that the Defendant's use of the "DARYAGANJ" name misleads the public into believing there is a connection with the Plaintiff's predecessor's original "MOTI MAHAL" restaurant. Moreover, the Plaintiff contested the Defendant's modification and use of a historical image from the first Moti Mahal restaurant on their website. The Defendants countered this by asserting a joint heritage in the establishment of the original Moti Mahal, claiming equal rights to the disputed photograph, yet agreed to remove the image to address the Plaintiff's concerns.

The legal dispute deepened with the filing of a defamation suit by Defendant against Plaintiff, stemming from an article published by the Wall Street Journal, which portrayed Defendant in a derogatory manner amidst the ongoing contention over the invention of butter chicken and dal makhani. The Respondent highlighted the reputational damage inflicted by the term 'cheats' used in the article. Conversely, the Plaintiff emphasizes the efforts made to rectify the situation, including reaching out to co-editors for clarification on the context of the quotes attributed to them. Despite these efforts, the integrity of the published story was upheld by the editorial team.

The Court has directed the Plaintiff to file an affidavit detailing their attempts to dissociate from the defamatory statements, with a subsequent listing for a hearing on 29 May 2024.

20. *The Hershey Company vs. Dilip Kumar Bacha, Trading as Shree Ganesh Namkeen & Anr, C.O. (COMM.IPD-TM) 179/2023.*

21. *Girdhari Lal Gupta v. K. Gian Chand Jain, AIR 1978 Del 146.*

22. *Rupa Gujral &Ors. Vs. Daryaganj Hospitality Private Limited &Ors., CS(COMM) 26/2024.*

MADRAS HIGH COURT MANDATES RECONSTITUTION OF PATENT OPPOSITION BOARD FOLLOWING POST-RECOMMENDATION EVIDENCE FILING

In a significant development within the Indian Patent Law framework, the Madras High Court ("**Court**") was approached by Optimus Drugs Private Limited ("**Petitioner**") concerning a patent granted for an invention titled "An improved process for the preparation of Linezolid."²³ The patent, awarded on 20 March, 2017, became the subject of a post-grant opposition filed by a competitor on 5 March, 2018. Central to the dispute was the submission and consideration of evidence in response to this opposition, governed by Rule 59 of the Patents Rules, 2003.

The Petitioner argued that as they did not submit evidence alongside their reply to the opposition, the competitor, in turn, was not entitled to file additional evidence. Despite this, evidence from both parties was submitted after recommendations from the Opposition Board were received. The Petitioner contended that the Opposition Board must now re-evaluate the additional evidence and issue revised recommendations. This led to the filing of a writ petition seeking the abashment of the ongoing post-grant opposition proceedings and a directive for the Controller of Patents and Designs ("**the Controller**") to establish a new Opposition Board for fresh evaluation.

Justice Senthilkumar Ramamoorthy ruled in favor of reconstituting the Opposition Board with new members, distinct from those who participated in the initial board. This newly formed board was instructed to review all submitted evidence and the Petitioner's amended claims, providing its recommendations within two months from its constitution. Furthermore, the Controller was directed to expedite the hearing in the opposition proceedings.

The Court recognized that both parties had been allowed to submit evidence subsequent to the initial recommendations of the Opposition Board, which necessitated the placement of this new evidence before the Opposition Board as per the Patents Rules, 2003. Given that additional evidence had been accepted by the Controller following a previous writ petition by the Petitioner, and this evidence was not merely publication-based, the Court highlighted the importance of this evidence being considered in the Opposition Board's

recommendations. Asserting the principles of natural justice, the Court reasoned that it would be incongruous for the Controller to rely on the Opposition Board's recommendations from May 2019 without accounting for the newly submitted evidence. To avoid any potential confirmation bias and ensure a fair re-evaluation, the Court deemed it necessary for the Opposition Board to be reconstituted, thereby ensuring that both parties' submissions are duly considered in the opposition process.

DELHI HIGH COURT RULES DISH TV CANNOT ASSERT SOLE OWNERSHIP OF 'DISH' TERM, INELIGIBLE FOR PROTECTION UNDER TRADE MARKS ACT

The Delhi High Court ("**Court**") adjudicated a trade mark dispute between Prasar Bharti ("**Appellant**") and Dish TV India Limited ("**Respondent**").²⁴ The issue before the Court was the Respondent's assertion of exclusive rights to the term "Dish" within their trade mark, juxtaposed against the Appellant's usage of the same term in "DD Free Dish." This dispute was set against the order passed by the Single Judge in July 2019 ("**Impugned Order**"), which temporarily restrained the Appellant from using "DD Free Dish" or any similar mark incorporating "Dish," providing a three-month period for rebranding and customer notification.

The central legal question revolved around whether the word "Dish," employed by both parties in their respective trade marks, could be monopolized by the Respondent under the Trade Marks Act, 1999. The Appellant contested the Impugned Order, arguing for the generic nature of "Dish" and its non-infringing use within "DD Free Dish." The Respondent, on the other hand, maintained that "Dish" formed an essential, distinctive part of their trade mark "Dish TV," alleging potential consumer confusion and dilution of their mark due to the Appellant's usage.

A division bench of Justices Vibhu Bakhru and Amit Mahajan adjudicated on the appeal. They concluded that "Dish," while a component of the Respondent's mark, is a commonly utilized term within the context of Direct-to-Home (DTH) services, not warranting exclusive rights

23. Optimus Drugs Private Limited v Union of India, W.P.(IPD)/24/2023 and WMP(IPD)/6/2023.

24. Prasar Bharti vs Dish TV India Ltd., FAO(OS)(COMM) 267/2019.

due to its generic nature. The Court emphasized the visual and conceptual dissimilarity between the marks, noting the distinctiveness and long-standing association of "DD" with the Appellant, reducing the likelihood of consumer confusion. Furthermore, the Court criticized the single judge's application of anti-dissection rule and principles of natural justice, highlighting the necessity

to view trade marks in their entirety and the absence of consumer confusion evidence.

Ultimately, the Court overturned the Impugned Order, elucidating that the Respondent's claim for an exclusive right over "Dish" within their trade mark was unfounded, particularly in the absence of confusion or deception among the consuming public.



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