



INTELLECTUAL PROPERTY UPDATES

April - June, 2024

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INTRODUCTION

As we proceed through the year, it is with great pleasure that we present the second edition of our Intellectual Property Newsletter for 2024. This quarter has witnessed a plethora of noteworthy developments, legal battles, and advancements within the realm of intellectual property (IP). Our objective is to provide you with a detailed overview of these pivotal events, which not only shape the legal landscape but also influence innovation, creativity, and cultural heritage on a global scale.

A prominent highlight of this quarter is the recognition of over 60 Indian products with Geographical Indication (GI) tags. This recognition underscores the significance of safeguarding India's rich cultural and traditional crafts, such as Banaras Thandai and Meghalaya Garo Textile weaving. These GI tags not only protect the unique characteristics of these products but also empower local artisans and communities, promoting economic growth and cultural pride. The declaration of 'Haldiram' as a well-known trade mark by the Delhi High Court marks a significant milestone in brand protection. This ruling not only solidifies the brand's standing within India but also reinforces its global recognition, demonstrating the

crucial role of robust trade mark protection in today's interconnected world. Moreover, the ruling by the Tokyo District Court that artificial intelligence (AI) cannot be considered an inventor under Japanese Patent Law initiates an essential discourse on the future of AI in innovation. As AI technology continues to advance, legal frameworks must adapt to address these new challenges, ensuring that the rights of human inventors are upheld while fostering technological progress.

These highlights represent only a portion of the significant IP events and rulings from this quarter. Our newsletter aims to provide you with comprehensive analysis and insightful commentary on these and other important developments. From landmark court decisions to groundbreaking regulatory changes, each article offers an examination of the evolving landscape of intellectual property rights.

We invite you to explore the wealth of information and insights presented in this edition. We value your readership and hope that you find this newsletter both informative and engaging. Happy reading!



SNIPPETS

OVER 60 INDIAN PRODUCTS RECEIVE GEOGRAPHICAL INDICATION TAGS

In a significant move to protect and promote India's rich cultural heritage, more than 60 products from across the country have been granted Geographical Indication ("GI") tags. The newly tagged products include the renowned Banaras Thandai,¹ traditional crafts from Assam like Asharikandi terracotta craft² and Jaapi bamboo headgear,³ as well as the Meghalaya Garo Textile weaving⁴ and Tripura's Pachra-Rignai traditional dress⁵. GI tags are awarded to products with specific geographical origins and characteristics linked to their location. With over 600 (six hundred) Indian products now bearing the GI tag, this initiative aims to safeguard the country's diverse cultural heritage while supporting the livelihoods of nearly 1,00,000 (one lakh) people directly involved in these traditional crafts.⁶

NCERT WARNS AGAINST UNAUTHORISED PRINTING AND SALE OF ITS TEXTBOOKS

The National Council of Educational Research and Training ("NCERT") issued an advisory to warn against the unauthorised publication of its educational materials.⁷ According to NCERT, some publishers are illegally printing NCERT textbooks under their own names without obtaining proper permission. This practice constitutes a violation of the Copyright Act, 1957 ("Copyright Act") and as per the advisory, NCERT will take legal action against any individual or entity engaging in such activities. The advisory emphasised that NCERT is the official body responsible for creating and distributing school textbooks and educational resources. It cautioned the public to avoid pirated textbooks as they may contain inaccuracies and contradict the principles of the National Curriculum Framework, 2023.⁸ NCERT urged individuals to report any instances of piracy via email and invited publishers to seek proper authorization for using NCERT's name by contacting the Publication Division in New Delhi or via email.

APPEALS COURT REVERSES PART OF NETFLIX'S COPYRIGHT WIN IN 'TIGER KING' CASE

In the case concerning the copyright infringement suit filed by Timothy Sepi and his company, Whyte Monkey Productions ("Plaintiffs") against Netflix, Inc. and Royal Goode Productions LLC ("Defendants"),⁹ the US Court of Appeals for the Tenth Circuit ("Appellate Court")

partially reversed a district court ruling ("Impugned Order") that favoured the Defendants. The Plaintiffs had claimed that the Defendants used clips from eight of its videos filmed at the Gerald Wayne Interactive Zoological Park, which appeared in the "Tiger King: Mayhem and Madness" series, without proper authorization.

The Impugned Order initially noted that the Plaintiffs did not own the copyright to seven of the clips, categorizing them as "works made for hire" under the US Copyright Act, 1976 and further found that the Defendants' use of an eighth clip was protected under the "fair use" doctrine. Aggrieved by the reasoning, the Plaintiffs filed an appeal where the Appellate Court upheld the Impugned Order to the extent of the ownership of the first seven clips were concerned. It, however, disagreed regarding the eighth clip. The Appellate Court noted that the District Court found it to be non-transformative and commercial. The Appellate Court concluded that the Defendants' use of the eighth clip did not significantly alter its original meaning and could negatively impact the market value of the Plaintiffs' work.

DELHI HIGH COURT DECLARES 'HALDIRAM' WELL-KNOWN

The Delhi High Court ("Court") declared the trade mark, 'Haldiram', as a well-known trade mark for food items, restaurants, and eateries, not only in India but also globally.¹⁰ The Court noted that the mark and logo have been used in the food industry since the 1960s and have achieved the status of a 'well-known mark'. The ruling came after Haldiram India ("Plaintiff") filed a suit seeking

1. Application Details, Banaras Thandai, accessible at: <https://search.ipindia.gov.in/GIRPublic/Application/Details/1000>.
2. Application Details, Assam Asharikandi Terracotta Craft, accessible at: <https://search.ipindia.gov.in/GIRPublic/Application/Details/980>.
3. Application Details, Assam Jaapi, accessible at <https://search.ipindia.gov.in/GIRPublic/Application/Details/979>.
4. Application Details, Meghalaya Garo Dakmanda Textile, accessible at <https://search.ipindia.gov.in/GIRPublic/Application/Details/1094>.
5. Application Details, Tripura Pachra/Rignai Textile, accessible at <https://search.ipindia.gov.in/GIRPublic/Application/Details/1071>.
6. The Week, accessible at <https://www.theweek.in/voices/columns/brijeshwari-gohil/2024/04/05/the-many-nuances-of-a-gi-tag.html>.
7. Press Release: Copyright Infringement in Educational Materials developed by NCERT, accessible at https://ncert.nic.in/pdf/announcement/notices/Press_Release_Copyright_Infringement-NCERT.pdf.
8. National Curriculum Framework for School Education 2023, accessible at https://www.education.gov.in/sites/upload_files/mhrd/files/NCF-School-Education-Pre-Draft.pdf.
9. Whyte Monkee Productions, et al v. Netflix, et al No. 22-6086; accessible at <https://www.govinfo.gov/app/details/USCOURTS-ca10-22-06086/context>.
10. Haldiram India (P) Ltd. v. Berachah Sales Corpn., 2024 SCC OnLine Del 2265.

protection of its trade mark and a ban on an imitator from Ambala City, Haryana, who was selling products under the mark 'Haldiram Bhujawala' ("**Defendant**"). The Court imposed a fine of INR 50,00,000 (fifty lakhs) as damages and INR 2,00,000 (two lakhs) as cost to be paid to the Plaintiff. The Court emphasised that the 'Haldiram's' brand, deeply rooted in India's culinary tradition, has established a presence within the national market and extended its influence globally, transcending geographical, cultural, and national boundaries.

KOVE SECURES USD 525 MILLION VERDICT IN PATENT INFRINGEMENT LAWSUIT AGAINST AMAZON WEB SERVICES

Kove IO ("**Plaintiff**") won a USD 525 million (United States Dollar five hundred and twenty five million) patent infringement suit against Amazon Web Services ("**Defendant**") in the Northern District of Illinois¹¹. Plaintiff, a computer storage and data management company, sued the Defendant in 2018, claiming that they used their patented "hyper-scalable cloud storage" technology, initially patented in 1998, to manage its vast data storage needs. The jury found that Defendant had infringed three of Plaintiff's patents, which were essential for Defendant to offer its extensive cloud services. Despite Defendant denying the allegations, the jury determined that infringement had occurred, though unintentionally.. The verdict highlights the significant role of Plaintiff's technology in Defendant's cloud services, which are pivotal for their profitability. The lawsuit emphasized the importance of intellectual property protection in fostering innovation and industry growth.

THE BOMBAY HIGH COURT TEMPORARILY RESTRAINS A TRAMPOLINE PARK FROM USING 'MR. BEAN' TRADE MARK

Tiger Aspect Kids & Family Ltd ("**Plaintiff**"), a UK-based company, filed a suit against Mr. Bean Trampoline Park ("**Defendant**"), a sole proprietorship in India before the Bombay High Court ("**Court**").¹² The issue in the case premised on the infringement of its registered trade marks, copyright and for action on passing in relation to the renowned international brand 'Mr. Bean' owned by the Plaintiff and first broadcasted in January 1990.

Through trade mark registrations, and agreements across different jurisdictions, including India, and being

the producer of the show, films, and animated series, the Plaintiff claimed the ownership of the copyright and merchandising rights concerning the original artistic work, trade mark, design, and character of Mr. Bean. The Plaintiff argued that, despite receiving cease and desist notices, the Defendant continued to use its trade mark, artwork, and character for commercial gain. The Defendant's park was prominently marketed as 'Mr. Bean Trampoline Park,' implying a connection with the Plaintiff's brand. Additionally, the park included themed attractions and merchandise displaying Mr. Bean-related marks.

The Court, upon considering the factual matrix, found a strong *prima facie* case and granted *ex-parte ad-interim* injunction restraining the Defendant from infringing the Plaintiff's trade mark and copyright.

KARNATAKA HIGH COURT GIVES PERMISSION TO SCREENING OF MAIDAAN

The Karnataka High Court ("**Court**") on April 11, 2024, overruled an order passed by the subordinate court in Mysore, that had temporarily blocked the release of the Hindi film 'Maidaan,' starring Ajay Devgn, due to plagiarism allegations. The Court reversed the temporary injunction issued by the lower court. This injunction was originally granted because of alleged copyright infringement claims against the movie producer, Bayview Projects Private Limited. The decision came after Boney Kapoor ("**Plaintiff**"), representing Bayview Projects Private Limited, filed a writ petition challenging the lower court's order. The Plaintiff contended that the lower court's order lacked proper reasoning and did not adhere to the principles of granting a temporary injunction according to Order 39, Rule 3 of the Civil Procedure Code, 1908..

However, the Court allowed the screening of the movie and acknowledged the potential harmful effects of the temporary injunction on the global theatrical and OTT release of 'Maidaan,' especially given the delays the film has already faced due to the COVID-19 pandemic. This

11. Kove IO, Inc. v. Amazon Web Services, Inc., 1-18-cv-08175 (N.D. IL); accessible at https://www.govinfo.gov/app/details/USCOURTS-ilnd-1_18-cv-08175/USCOURTS-ilnd-1_18-cv-08175-1.

12. Tiger Aspect Kids & Family Limited v. Mr. Bean Trampoline Park, Commercial IP (L) No. 7983 of 2023 (Delhi HC).

13. Mr. Boney Kapoor vs Mr. C.R. Anil Kumar, WP No. 10837 of 2024 (Karnataka HC)

decision highlights the necessity of providing substantial evidence and following legal principles when seeking injunctions in copyright disputes.

SAMSUNG TO PAY USD 142 MILLION IN A WIRELESS PATENT CASE BY G+ COMMUNICATIONS

A Texas federal jury ("**Court**") has ordered Samsung Electronics ("**Defendant**") to pay G+ Communications ("**Plaintiff**") USD 142 million (United States Dollar one hundred and forty two million) for infringing patents related to 5G technology in its Galaxy smartphones¹⁴. The Court determined that Samsung owes \$61million (United States Dollar sixty-one million) for infringing one G+ patent and \$81 million (United States Dollar eighty one million) for another.

The Plaintiff, who owns patents deemed essential for compliance with 5G wireless standards, sued Defendant in the year 2022. The Defendant alleged that the Plaintiff had incorporated its patented technology into 5G-capable Galaxy smartphones without obtaining the necessary licenses. Defendant denied these allegations, argued the patents were invalid, and claimed that G+ failed to offer licenses on fair and reasonable terms as required by standards organizations.

Initially, a jury found Defendant had infringed two of the three patents in question and awarded \$67.5 million (United States Dollar six million seven hundred thousand five hundred dollars) in damages. However, after the retrial on damages, the Court determined the appropriate damages.

DELHI HIGH COURT DECIDES COPYRIGHT INFRINGEMENT SUIT IN FAVOUR OF BAKTIVEDANTA BOOK TRUST IN ISKCON

The Baktivedanta Book Trust ("**Plaintiff**") filed a lawsuit before the Delhi High Court ("**Court**") against an unknown Defendant to restrain it from selling copies of the Plaintiff's copyrighted books through its website, www.friendwithbooks.co, ("**Impugned Website**").¹⁵ The Plaintiff claimed infringement of its copyright under Section 14(a) of the Copyright Act and sought a permanent injunction in this regard. In February 2021, the Court had granted an *ex parte ad interim* injunction in favor of the Plaintiff, preventing the Defendant from reproducing or authorizing the reproduction of the books and artworks to the public. Subsequently, all the

references and content related to the copyrighted books, artworks, and sound recordings from all platforms were taken down from the Impugned Website. It is pertinent to note that while passing the above ruling, the Court interpreted Section 21 of the Copyright Act and opined that in order for relinquishment of a copyright, the said section provides for a prescribed form. Resultantly, the right to relinquish could only be extinguished by the renunciate, only if the person transferred or relinquished the right by a process known to law, and not otherwise. Since, in the present scenario, such relinquishment had not been executed by Srila Prabhupada (*original author of the copyrightable material*) of his copyright in his literary works, thus relinquishment had not certainly occurred.

THE TOKYO DISTRICT COURT RULES AI CANNOT BE A PATENT INVENTOR

The Tokyo District Court ("**Court**") has dismissed an American engineer's ("**Applicant**") claim concerning an AI-generated invention, ruling that inventors under the Patent Act, 1959 ("**Japanese Patent Law**")¹⁶ must be natural persons.¹⁷ The Court delivered the decision after the Patent Office rejected a patent application that named AI as the inventor. The Applicant argued that this rejection was illegal and sought its annulment. In 2019, the Applicant filed an international patent application for food containers and other products invented by AI named 'DABUS'. The Patent office required the application to be amended, stating that inventors must be natural persons. The Applicant refused, leading to the application's rejection.

The Court emphasized that the Japanese Patent Law assumes inventors are natural persons and noted that many other countries held the same view. Although the Court did not assess whether the invention met patent requirements, it acknowledged that a separate system might be needed for AI-generated inventions.

14. G+ Communications LLC v. Samsung Electronics Co Ltd, No. 2:22-cv-00078; accessible at <https://casetext.com/case/g-commcns-llc-v-samsung-elecs-co-1/>

15. Baktivedanta Book Trust India v. www.friendwithbooks.co, 2024 SCC OnLine Del 2805.

16. Patent Act, Act No. 121 of 1959 (Japan).

17. Tokyo District Court, Reiwa 5 (Gyo U) No. 5001, accessible at https://www.courts.go.jp/app/files/hanrei_jp/981/092981_hanrei.pdf.

COPYRIGHT INFRINGEMENT LAWSUIT FILED AGAINST MICROSOFT, OPENAI BY MAJOR US NEWSPAPER PUBLISHERS

8 (Eight) U.S. newspaper publishers, including the New York Daily News and Chicago Tribune, ("**Plaintiffs**") filed a copyright infringement lawsuit against Microsoft and OpenAI ("**Defendants**") in a New York federal court ("**Court**")¹⁸. They alleged that the Defendants had used their articles without permission or compensation to train AI products like Copilot and ChatGPT. The lawsuit claimed these AI models, developed using datasets that likely included the publishers' copyrighted content, could generate text that replicated their work. Additionally, the Plaintiffs argued that Microsoft's Bing search engine used their articles without proper attribution or links back to the original sources. This legal action followed a similar lawsuit filed by The New York Times against OpenAI earlier this year.¹⁹ The Defendants maintain that their practices are protected under the "fair use" doctrine of American copyright law.

QATAR'S ACCESSION TO THE MADRID PROTOCOL INTERNATIONAL TRADE MARK SYSTEM

The Madrid System, also known as the Madrid Protocol, facilitates registration of trade marks in multiple jurisdictions around the world. On May 03, 2024, the Government of Qatar deposited its instrument of accession to the Madrid Protocol – the governing Treaty of the Madrid System – with WIPO Director General, Daren Tang, which will be effectuated from August 03, 2024.²⁰

Qatar's recent accession to the Madrid Protocol marks a pivotal step in the nation's intellectual property landscape. As the 115th (one hundred and fifteenth) member state to join this international trade mark system and the (4th) fourth within the Gulf Cooperation Council, Qatar underscores its commitment to foster a robust environment for innovation and business development. This move not only benefits local brand owners in Qatar but also provides foreign businesses with an additional avenue to secure trade mark protection in the country. While individual territories remain subject to examination by national offices, the centralized application process simplifies administrative tasks and reduces costs associated with maintaining trade mark portfolios.

SONY MUSIC ISSUES WARNINGS TO TECH GIANTS FOR USE OF COPYRIGHTED MUSIC IN AI TRAINING

The American Japanese multinational company, Sony Music Group ("**Sony**") issued warnings to around 700 (seven hundred) AI developers and music streaming services.²¹ These warnings, contained in "opt-out" letters, instruct the recipients to stop using Sony's music and other content for AI training purposes without Sony's explicit permission. Sony is concerned that some developers may already be using its content illegally, particularly through practices like text and data mining. The letters further demand a detailed explanation from the companies on how they have accessed, reproduced, or extracted Sony's content. This content includes a wide range of materials such as musical compositions, lyrics, audio recordings, and related artwork.

In addition to the letters, Sony has also updated its website with a "*Declaration of AI Training Opt-Out*," explicitly prohibiting any form of data mining or web scraping of their content unless specifically authorized by Sony Music Entertainment or Sony Music Publishing.

DELHI HIGH COURT GRANTS DAMAGES TO CCAI IN A PATENT INFRINGEMENT DISPUTE

In a recent judgement before the Delhi High Court ("**Court**"), the Hon'ble Justice Jyoti Singh granted ₹217 crore (Indian National Rupee two hundred and seventeen crore) as compensatory damages for lost profits to the entity, Communication Component Antenna Inc. ("**Plaintiff**") in their patent infringement suit against Mobi Antenna Technologies ("**Defendant**").²² In the ruling dated May 16, 2024, the Court found the Defendants to be infringing the patent rights in Indian Patent No. IN240893, for an invention titled '*Asymmetrical Beams for Spectrum Efficiency*' in telecommunications antennas.

18. The New York Times Company v. Microsoft Corporation, 1:23-cv-11195, (S.D.N.Y.); accessible at <https://www.courtlistener.com/docket/68117049/the-new-york-times-company-v-microsoft-corporation/>.

19. The New York Times Company v. Microsoft Corporation (1:23-cv-11195), accessible at <https://www.courtlistener.com/docket/68117049/the-new-york-times-company-v-microsoft-corporation/>.

20. World Intellectual Property Organization (WIPO); accessible at <https://www.wipo.int/web/madrid-system/w/news/2024/qatar-joins-the-madrid-system>.

21. Sony Music Group, Business Segment Meeting 2024 presentation, relied on slide 15, accessible at https://www.sony.com/ja/SonyInfo/IR/library/presentation/business_segment_meeting/pdf/2024/Music_Global.pdf.

22. Communication Components Antenna Inc. v. Mobi Antenna Technologies (Shenzhen) Co. Ltd. & Ors., CS(COMM) 977/2016.

The Court held that the lost earnings from market share had to be used as the basis for paying the damages. As a result, it calculated that the Plaintiff lost 47,355 (forty seven thousand three hundred and fifty five) units of market share and made a profit of \$550 (United States Dollar five hundred and fifty) per unit. Hence, the Court determined that the lost earnings of the Plaintiff amounted to ₹2,17,47,78,375 (about ₹217 crores, or around US\$ 26.1 million). This ruling is an important ruling that suggests the strict stance taken by the Courts in protecting intellectual property rights and compensating right holders for their losses by awarding damages.

INTELLECTUAL PROPERTY AUTHORITIES OF UK AND US ENTER INTO AN MOU REGARDING STANDARD ESSENTIAL PATENTS

The UK Intellectual Property Office (“UKIPO”) and the US Patent and Trade Mark Office (“USPTO”) signed a Memorandum of Understanding (“MoU”) to work together on Standard Essential Patents (“SEPs”).²³ SEPs are patents that are declared essential to a particular technical standard, and they are often licensed on fair, reasonable and non-discriminatory terms.

The MoU, signed up by Intellectual Property Office Chief, Adam Williams and USPTO Director, Kathi Vidal, shall remain valid 5 (five) years from the day of signing. It aims to allow both offices to work together on matters concerning SEPs, including work like conducting outreach activities and raising awareness for issues surrounding SEPs. Vidal noted that the collaboration would help the United Kingdom and the United States of America work towards benefiting all businesses in both the countries, especially small and medium-sized enterprises and those wishing to enter the market. The MoU will also regulate exchange of information for policy matters, educate enterprises, examine ways of improving transparency and discuss means to incorporate additional jurisdictions.

SHARP CORPORATION & BEIJING XIAOMI MOBILE SOFTWARE CO. LTD ENTER INTO A CROSS-PATENT LICENSING AGREEMENT

Sharp Corporation (“Sharp”), a leading Japanese cell phone vendor, and Beijing Xiaomi Mobile Software Co. Ltd. (“Xiaomi”), a leading Chinese cell phone vendor, have entered into a cross-patent licensing agreement for wireless communication technologies.²⁴ This agreement

marks the end of a litigation filed by Sharp against Xiaomi in China in September 2022. Sharp executives stated that they could not disclose the specific contents of the cross-licensing agreements due to the signing of a confidentiality agreement, but the use would be based on fair and reasonable terms. The agreement was said to promote cooperation between the two, as well as benefit technological innovation and market expansion. It will also benefit Sharp’s market position in wireless communication technology.

Sharp had already licensed SEPs for wireless communication technologies to many telecommunication equipment and automotive companies in Japan, United States of America, Europe, China and South Korea. Apart from Xiaomi, Sharp had similar cross-license agreements with a variety of other companies, including OPPO, Vivo and Huawei.

PATENT REGISTRATION GRANTED TO A DEVICE THAT MEASURES VOLTAGE WITHOUT DIRECT CONTACT

A patent registration was granted to the College of Engineering (CET), Thiruvananthapuram and Indian Institute of Technology (IIT), Madras for designing a novel invention, a device that could measure voltage variation without any contact. It also guaranteed a high level of accuracy without the requirement of detaching the insulation from live wires. The Indian Patent Office issued the collaborative patent as “An instrumentation system with a fully non-intrusive probe for AC voltage measurement.”²⁵

This non-contact voltage tester, apart from accurately measuring voltage and proposing a comparatively low-risk approach as opposed to older methods, was also capable of connecting to Internet of Things (IoT) devices, smart energy metres, smart home systems and maintaining industrial machinery. It also aimed at enhancing the efficiency and increasing the safety standards across various area.

23. Accessible at <https://www.uspto.gov/about-us/news-updates/uspto-and-uk-ip-office-agree-collaborate-policies-related-standard-essential>.

24. Sharp Corporation’s press release, accessible at <https://global.sharp/corporate/news/240524-a.html>

25. The Hindu, accessible at <https://www.thehindu.com/news/national/kerala/cet-iit-madras-bag-patent-for-inventing-non-intrusive-voltage-measuring-device/article68222063.ece>.

LUXEMBOURG GENERAL COURT RULES AGAINST SOCIÉTÉ DU TOUR DE FRANCE IN TRADE MARK DISPUTE

After the European Union Intellectual Property Office (“**EUIPO**”) allowed FitX, a Germany based gym chain to register a trade mark for a figurative sign ‘Tour de X,’ (“**Impugned Mark**”) the French company, Societe du tour de France raised a grievance in relation to its exclusive right to use the expressions ‘Tour de France’ or ‘Le tour de France’ and the Impugned Mark infringing the same.²⁶

The Luxembourg General Court (“**Court**”) upheld EUIPO’s decision to grant the trade mark registration and dismissed the infringement challenge stating that the only similarity that exists between both the marks, was the phrase ‘Tour de,’ which does not undermine the distinctiveness of either of the marks. The Court also opined that though there may exist a similarity in the goods and services offered by both companies, it would not lead to a situation of deceptive similarity or cause confusion amongst the public.

ALASKA AIRLINES LOSES APPEAL REGARDING PAYMENT TO VIRGIN GROUP

The Court of Appeal in London (“**Court**”) reaffirmed the decision of the London High Court (“**High Court**”), directing Alaska Airlines (“**Appellant**”) to pay a sum of 8 (eight) million pounds “minimum royalty” annually to the Virgin Group (“**Respondent**”), pursuant to the trade mark license agreement between the Respondent and Virgin America Inc., a subsidiary which was acquired by the Appellant in 2016.²⁷ The High Court reasoned that the agreement provided Alaska Airlines the right to use the Virgin Group Trade mark in exchange of a flat fee and could not be circumvented merely on the grounds of the Appellant not currently using the trade mark. Alaska Airlines appealed the decision on the grounds that by paying the stipulated amount for a trade mark, they did not have any intention of using was not reasonable. As such, they sought to do away with the obligation all together. Keeping in mind the established principles of contracts and intellectual property laws within the United Kingdom and internationally, the Court ruled that the payment was still required to be paid considering the agreement mandated the same even if Alaska stopped using the branding.

26. Société du Tour de France v EUIPO - FitX (Tour De X), T-604/22, accessible at https://curia.europa.eu/juris/document/document_print.jsf?mode=req&pageIndex=0&docid=287047&part=1&doclang=EN&text=&dir=&occ=first&cid=9973019.

27. Virgin Aviation TM Limited & Anr. V. Alaska Airlines Inc, [2024] EWCA Civ 622, accessible at https://www.oeclaw.co.uk/images/uploads/judgments/Virgin_Aviation_Ltd_v_Alaska_Airlines_Inc.pdf.



LONG FORM

DELHI HIGH COURT PROHIBITS FOOD OUTLETS FROM USING 'DOMINO' & 'DOMINOZ' MARKS, DIRECTS REMOVAL FROM SWIGGY AND ZOMATO PLATFORMS

The Delhi High Court ("**Court**") granted temporary injunction against eight food outlets ("**Defendants**") in Delhi from using the marks Domino, Domino's, Dominon, Dominoes, Dominoz, Dominoz, and Domain's ("**Plaintiff's Marks**") following a trade mark infringement lawsuit filed by the well-known international pizza chain Domino's Pizza ("**Plaintiffs**")²⁸. The Plaintiff alleged that the Defendants had unauthorizedly adopted trade marks which were identical or deceptively similar to the Plaintiff's Marks.

It was claimed that the adopted trade marks were being utilized to run imitator brand outlets on various online food delivery platforms. The Plaintiffs also alleged that these food outlets were exploiting the search results generated when users typed in the initial letters of Plaintiff's Marks, such as "Dom," "Domi," "Domin," and "Domino." According to the Plaintiffs, these imitator brands were unfairly benefiting from the confusion created and goodwill associated with their established marks. These marks were displayed in a way identical to the Plaintiff's Marks on online platforms operated by Zomato and Swiggy.

The Court held that the Defendants had used the trade marks that were *prima facie* identical and deceptively similar to the Plaintiff's Marks, being used for identical goods and services, namely pizzas and their online delivery. The Court noted that given these contested marks were linked to food products broadly marketed and consumed by various demographic groups, the likelihood of misrepresentation could significantly affect consumers. The Court applied a more rigorous standard in assessing the potential impact of such misrepresentation on public perception and the integrity of the Plaintiffs' brand identity. The facts and circumstances indicated a deliberate attempt by Defendants to mislead the public into thinking there was an affiliation or connection with the Plaintiff.

MADRAS HIGH COURT ORDERS RECONSTITUTION OF THE OPPOSITION BOARD IN TATA MOTORS' OPPOSITION TO ASHOK LEYLAND'S PATENT

The case between Ashok Leyland Ltd.'s ("**Appellant**") and Tata Motors ("**Respondent**") before the Hon'ble

Madras High Court ("**Court**") concerned with the grant of patent no. IN387429, which was opposed by the Respondent citing prior publication, public use, non-patentable subject matter, obviousness, and insufficient disclosure under Section 25(2) of the Patents Act, 1970 ("**Patents Act**").²⁹

Subsequently, the Controller of Patents constituted an Opposition Board to examine the opposition proceeding. As a matter of procedural compliance, both parties submitted documents and expert affidavits, which the Board reviewed before issuing its report in October 2023. During the pendency of the said opposition proceeding, the Appellant filed a writ petition before the Intellectual Property Division of the Hon'ble High Court of Madras ("**IP Division**") assailing improper review of the expert evidence during examination and requested the IP Division to quash the said report. The IP Division, after hearing, dismissed the writ petition, stating that the Opposition Board's recommendations were not binding on the Controller, who could independently review the evidence during the final hearing.

Aggrieved by the dismissal of the writ petition, the Appellant filed an appeal before the Division Bench of the Court. Pursuant to perusal of the documents placed on record and arguments of the parties, the Division Bench of the Court set aside the IP Division's order, instructing the Controller to reconstitute the Opposition Board to re-evaluate the evidence and provide fresh recommendations in accordance with Sections 25(2) and 25(3) of the Patents Act. The Court emphasized that the Board must thoroughly examine the documents, including the evidence, and offer "reasoned" recommendations for each ground of opposition. The Court clarified that the procedure adopted by the Opposition Board could not be reviewed judicially, except to ensure compliance with the statutory requirements.

TESLA FILES TRADE MARK INFRINGEMENT SUIT AGAINST TESLA POWER INDIA³⁰

Tesla Inc. ("**Plaintiff**"), a leading player in the electric vehicle ("**EV**") market, initiated legal proceedings against the Gurgaon-based company, Tesla Power India Pvt. Ltd

28. Dominos IP Holder LLC & Anr v. Ms Domino Pizza & Ors, CS(COMM) 303/2024 (Delhi HC).

29. Ashok Leyland Limited v. The Controller of Patents & Designs & Anr., W.P.(IPD) No.1 of 2024 (Madras HC)

30. Tesla INC. v. Tesla Power India Private Limited & Ors, CS(COMM) 353/2024.

("Respondent"). The case, filed in the Delhi High Court ("Court"), centred around allegations of trade mark infringement. The Plaintiff claimed that the Respondent was unlawfully using the 'Tesla' trade mark, which was causing confusion among consumers. The Court, responding to Plaintiff's claims, imposed an interim order restraining the Respondent from promoting any EV-related products under the Tesla name.

The Plaintiff contended that the Respondent's use of the Tesla name had led to significant consumer confusion, harming its business interests. According to the Plaintiff, the Respondent's advertisements, which position it as an EV company, had misled consumers into believing there was an affiliation between the two entities. This confusion, the Plaintiff argued, had resulted in consumers purchasing the Respondent's batteries under the mistaken belief that they are associated with the globally recognized Tesla brand, leading to numerous consumer complaints directed at the Plaintiff.

However, during the proceedings, the Court also took a critical view of the Plaintiff's claims. The Court noted that the Plaintiff had been aware of and in correspondence with the Respondent regarding this trade mark issue since 2020, and yet had not taken any immediate legal action since then. The Court stressed the importance of allowing the Respondent, which had been operating for four years, a fair opportunity to defend its position rather than summarily restraining them from continuing its business.

The Respondent defended itself by clarifying that it did not manufacture EV batteries but specialized in selling lead-acid batteries for conventional vehicles and inverters. It also mentioned that its advertisements involving the Tesla trade mark were part of a strategic partnership with e-Ashwa, a company engaged in the sale of EV products. The Respondent emphasized that this partnership is integral to its business and insisted that it has served over a million customers in India.

The Court has referred the case to mediation after both parties agreed to attempt a settlement through this route. A senior mediator from the Delhi High Court Mediation and Conciliation Centre will take up the matter which has already started on July 18, 2024. If the mediation fails, a bench of the court will hear the case on September 18, 2024.

BOMBAY HIGH COURT UPHOLDS TRADE MARK OWNERS' RIGHT TO RENEW DESPITE DELAY

The Bombay High Court ("Court") has ruled that the Registrar of Trade Marks ("Registrar") cannot refuse to renew a trade mark solely on the grounds of delay if the mark has not been removed from the register and no notice under Section 25(3) of the Trade Marks Act, 1999 ("Trade Marks Act")³¹ were issued.

Section 25(3) of the Trade Marks Act states that if a trade mark has not been renewed and the Registrar has not received an application for renewal within the prescribed period, the Registrar shall remove the trade mark from the Register. However, before removing the mark, the Registrar must issue a notice to the proprietor, providing them with an opportunity to renew the trade mark.

The case in question involved 3 (three) trade marks owned by Motwane Private Ltd. ("Petitioner"), which had inadvertently remained on the Register despite a lapse in renewal. When the Petitioner sought to renew these trade marks, the Registrar refused, citing the delay in the renewal process. The Court observed that the trade marks had not been removed from the Register, and no removal notice had been issued under Section 25(3) of the Trade Marks Act and hence, the Registrar's refusal to renew the trade marks citing delay was not justified.

This judgement provides much-needed clarity on Section 25(3) of the Trade Marks Act and serves as a reminder to the Registrar to adhere to the prescribed procedures when dealing with renewal and removal of trade marks.

MADRAS HIGH COURT ASSERTS INHERENT POWER TO TRANSFER TRADE MARK RECTIFICATION APPLICATIONS

The Madras High Court ("Court") has affirmed its inherent power to transfer trade mark rectification applications pending in a Trade mark Registry ("the Registry") outside its territorial jurisdiction.³² The ruling emphasises the Court's authority to consolidate proceedings and prevent conflicting decisions from different forums dealing with

32. Nippon Paint Holdings Co. Ltd. & Anr. v. Suraj Sharma & Anr., C.S.(Comm. Div.) No.7 of 2024 (Madras HC).

the same subject matter. The case in question involved Nippon Paint Holdings Co. Ltd. ("**Petitioner**"), which sought to transfer a rectification petition filed before the Registry in New Delhi to the Court. The respondents opposed the transfer application, arguing that the Court lacked territorial jurisdiction over the Registry in New Delhi.

However, the Court observed that the Trade Marks Act had deliberately omitted the definition of "High Court," indicating the legislature's intention not to curtail the powers of the Court. The Plaintiff argued that under Rule 14 of the Madras High Court Intellectual Property Rights Division Rules, 2022 ("**Rules**"), the Court had the power to consolidate all proceedings and hear them together. They also contended that since a part of the cause of action, i.e., the infringement of their trade mark, took place within the Court's jurisdiction, the Court could hear the case, and there was no express statutory bar preventing the Court from hearing the rectification petition. The Court agreed with the view taken by a single judge of the Delhi High Court in *Dr. Reddy's Laboratories Ltd. vs. Fast Cure Pharma & Ors.*,³³ which applied the dynamic effect principle. In the present case, the court noted that a decision rendered in the infringement suit filed before the Court would have a bearing on the rectification application before the Registry in New Delhi and vice versa.

Applying the rule of harmonious construction, the Court observed that the interest of justice would be served by consolidating both proceedings instead of allowing the pleas to continue parallelly. It was thus concluded that the Court had an inherent jurisdiction to transfer the rectification proceedings pending before the Registry in New Delhi to itself and as such, allowed the transfer application.

MOTORCYCLE PATENTS FILED BY OLA ELECTRIC

Ola Electric, a prominent Bengaluru-based manufacturer, made significant advancements in its plans to diversify its product offerings by filing multiple patents for new electric motorcycle designs.³⁴ The patent documents revealed three distinct patent applications submitted by Ola Electric, each representing different designs for electric motorcycles. These patents were published in the latest Indian patent journals and illustrate varied interpretations of Ola's previously showcased M1 Cyber Racer concept motorcycle. Brief details for each patent is as follows:

- i. The first patent describes a motorcycle characterized by the thinnest tires and a basic alloy wheel design, suggesting it could be the most cost-effective model among the trio. It features a hub-mounted motor on the rear wheel, a basic box-section swingarm, and twin shock absorbers. The design language is akin to a motor bike with sharp creases and a flat, single-piece seat, indicative of a focus on simplicity and affordability.
- i. The other two patents detail sportier models that, while sharing core components such as the swingarm, powertrain, suspension, faux fuel tank, and wheels, differ in specific design elements. One model features a single-seat configuration with a taller, flatter handlebar, which lends it a more aggressive posture. The other model adopts a dual-seat layout with a lower, clip-on style handlebar, likely catering to a more traditional sport-touring audience.

Additional distinctions include differences in the battery cooling systems and front-end design. One model integrates the battery cooling into a faux sump guard with a small trapezoidal bodywork at the bottom of the battery pack. The other features a more layered and edgy front aesthetic. Both models were equipped with RSU telescopic front forks and a flat-tracker-like headlight assembly.

SONY FACES TRADE MARK LAWSUIT OVER "MLB THE SHOW" FEATURE

Program 15 ("**Plaintiff**"), an entity known for hosting the Future Star Series—a developmental program for amateur baseball players—has filed a trade mark infringement lawsuit against Sony Interactive ("**Defendant**"), alleging unauthorized use of its "Future Stars Series Program" trade mark in Defendant's video game "MLB the Show".³⁵ The game, which had included this feature since 2017, is said to infringe the Plaintiff's trade marks established in 2016, leading to consumer confusion between the real-world series and the virtual game content. The Plaintiff argued that the Defendant's game not only infringed their trade mark but also benefitted financially by selling in-game items like virtual

33. *Dr. Reddy's Laboratories Ltd. vs. Fast Cure Pharma & Ors.*, CS(COMM) 436/2021.

34. Financial Express, accessible at <https://www.financialexpress.com/auto/bike-news/ola-electric-files-patents-for-upcoming-electric-motorcycle-gets-3-variants/3482770/>.

baseball cards and player packs under the Future Stars branding. These items reportedly feature real players who have participated in the Future Star Series, thus directly associating the game's content with the Plaintiff's brand and potentially misleading consumers about the relationship between the two entities.

The legal proceedings were initiated in the U.S. District Court for the Southern District of Texas. The Plaintiff has recently escalated the case by filing a motion to compel the Respondent to produce documents and respond to discovery requests, asserting that the Respondent had not adequately cooperated with procedural requirements. The Plaintiff's legal actions emphasize the alleged damages from trade mark dilution and the unjust enrichment the Respondent had gained from leveraging the established reputation of the Future Stars brand. With a trial scheduled for February 2025, this case highlights significant legal challenges in trade mark protection within the digital and virtual marketplaces, setting a potential precedent for how intellectual property rights are enforced in increasingly digital contexts. The outcome of this lawsuit may have broad implications for trade mark rights and advertising strategies in digital entertainment and sports industries.

DELHI HIGH COURT GRANTS DYNAMIC+ INJUNCTION AGAINST ONLINE COPYRIGHT INFRINGEMENT

The Delhi High Court ("**Court**") granted a dynamic+ injunction to Universal Studios and other unnamed streaming platforms ("**Plaintiffs**") to combat copyright infringement against 26 (twenty six) infringing websites ("**Defendants**"). This action was prompted by concerns over these websites illegally distributing copyrighted content, including movies and shows. The Plaintiffs claimed ownership of various copyrighted works protected under the Copyright Act. The infringing websites violated the Plaintiffs' exclusive rights by distributing their content without authorization.³⁶

The dynamic+ injunction, employed by the Court, goes beyond targeting specific infringing websites. Acknowledging the "hydra-headed" nature of online copyright infringement, the Court empowered Universal Studios to proactively address future attempts at infringement. This included outlining measures for enforcement, mandating domain name registrars and ISPs to block access to identified infringing websites

promptly, and also providing registrants' details and Know Your Customer (KYC) information. The Department of Telecommunication and the Ministry of Electronics and Information Technology have been tasked with ensuring compliance from all ISPs. The ruling was based on two key findings: Universal Studios presented sufficient evidence to establish a *prima facie* case of copyright infringement, and the potential harm to the Plaintiffs outweighed any inconvenience to the infringing websites if the injunction wasn't granted. This sets a significant precedent for copyright protection in India's digital landscape, showcasing the Court's commitment to safeguarding intellectual property rights. The decision strengthens the legal framework and acts as a deterrent to online piracy, thereby protecting content creators' rights.

Furthermore, the streamlined process of adding new infringing websites to the injunction and the potential extension to future copyrighted works by Universal Studios enhanced the effectiveness of this order. This demonstrated the Court's adaptability to evolving challenges in the digital realm and its willingness to utilize innovative measures to combat copyright infringement. Overall, the dynamic+ injunction represents a crucial step towards maintaining a fair and equitable online environment for intellectual property rights.

BOMBAY HIGH COURT GRANTED AN INJUNCTION IN FAVOUR OF PIDILITE INDUSTRIES LIMITED REGARDING LW/ LW+

The Bombay High Court ("**Court**") recently passed an injunction order granting interim relief to Pidilite Industries Limited ("**Plaintiff**") that restricted Dubond Products Pvt. Ltd. ("**Defendant**") from manufacturing, distributing or selling its product due to it being deceptively similar to Plaintiff's registered trade mark and trade dress of their waterproofing product line, Dr. Fixit LW/LW+.³⁷

It was contended by the Plaintiff that the Defendant's marks, LW with or without HYDRBUILD/ HYDROTITE ("**Impugned Marks**") were infringing the Plaintiff's trade mark registrations in addition to also infringing

35. Program 15 Sports, LLC v. Sony Interactive Entertainment, LLC, 4:2023cv03199.

36. Universal City Studios Productions LLLP v. Movies123.LA, 2024 SCC OnLine Del 3852

37. Pidilite Industries Ltd. v. Dubond Products India Pvt. Ltd., 2024 SCC OnLine Bom 1390.

the Plaintiff's registered copyrights in the label and artistic works used for its product line. On the other hand, the Defendant claimed to have been using the Impugned Marks since 2009 and that the Plaintiff could not solely claim exclusivity over the terms 'LW/ LW+' as they were descriptive in nature, i.e., an acronym to 'Liquid Waterproofing' which was common to various businesses.

The Court upheld the contentions of the Plaintiff whilst relying on the various principles associated with the doctrine of prior use. The Court was of the view that the Plaintiff's marks were in use much before the Impugned Marks came into the picture. It was also opined by the Court that the Plaintiff's marks were 'well known' marks and had been granted judicial protection and recognition in several instances. In addition to this, it was also highlighted by the Court that minor changes such as frequently modifying the prefixes or suffixes of a mark or packaging did not translate to a distinguishable trade mark. Further, it was held by the Court that there was a lack in the proof submitted by the Defendants which evidenced continuous and substantial use of the Impugned Marks. Lastly, it was held by the Court that the Impugned Marks were deceptively similar to the Plaintiff's marks.

DELHI HIGH COURT DISMISSES FORGERY CASE AGAINST COLGATE PALMOLIVE COMPANY

The Delhi High Court ("**Court**") passed a judgment quashing a forgery case as also an order of the District Magistrate passed in this case ("**Impugned Order**"), against Colgate Palmolive Company and its office bearers ("**Petitioners**")³⁸. The case was filed against the Petitioners by Anchor Health and Beauty Care Pvt. Ltd. ("**Anchor**") alleging forgery of trade mark registration documents presented before the District Magistrate. The District Magistrate had, vide the Impugned Order, issued summons against the Petitioners after ascertaining prima facie evidence of forgery however, the Court was of the opinion that the District Magistrate lacked jurisdiction to take cognizance of the matter.

The petition seeking dismissal of the Impugned Order pertained to the ongoing trade mark dispute between Anchor and Colgate Palmolive Company ("**Colgate**") regarding use of red and white trade marks on their respective dental care products, a suit which had been dismissed in the past. Colgate attempted to re-institute the same alleging a fresh cause of action on the basis

a registration certificate, the veracity of which was questioned by Anchor. Resultantly, Anchor proceeded to file a case against Colgate under various sections of the Indian Penal Code, 1860 for offences *inter alia* forgery.

The Court dismissed the Impugned Order noting the Trade Marks Registry's lack of denial towards issuance of the certificate of registration and reasoned that the alleged discrepancies pointed out by Anchor were attributable towards possible errors made by Trade Marks Registry, rather than a case of intentional forgery committed by Colgate. It was held that an inquiry under Section 340 of the Code of Criminal Procedure, 1973 sought by Anchor could not be separated from the application filed before the Magistrate, the Court decreed that the District Magistrate did not have the appropriate jurisdiction to take cognizance of the matter and found in favour of the Petitioner, whilst it dismissed the Impugned Order.

DELHI HIGH COURT RESTRAINS SOUTH AFRICAN FIRM FROM USING A TRADE MARK SIMILAR TO INDIAN LAW FIRM



On May 29, 2024, the Delhi High Court ("**Court**") passed an order restraining a law firm based out of South African, namely, Singh and Singh Attorneys ("**Respondent**")

38. Colgate Palmolive Company and Others v. State of NCT of Delhi and Another, 2024 SCC OnLine Del 4196.

from using the trade mark 'Singh and Singh' or any other such trade mark, which seemed to be deceptively similar to that of law firm based out of India - Singh and Singh Law Firm LLP ("**Petitioner**").³⁹ The said injunction order was based on the fact, that the two firms names, their domain names, their social media accounts and primary logos were not only identical but were also used to provide an 'identical service' and meant to target a similar demographic.

The Court further reasoned that in the increasingly internet-driven world, prominent law firms such as Singh and Singh Law Firm LLP possess a global identity and reputation from the formidable presence not only in India, but also in South Africa. The Court reasoned that the use of both trade marks simultaneously, could lead to potentially disastrous consequences with regards to causing significant confusion to potential clients in both nations and furthermore, leading to the clients potentially being misled with regards to the identity of the firm.

In view of the above, the Court found that a *prima facie* case was made out by the Plaintiffs and restrained the Respondent from using any trade mark / trade name/ service name/ trading style, either identical to, or deceptively similar to Plaintiffs' marks/ names/ logos. The Court further directed the Ministry of Electronics and Information Technology ('MEITY') along with the Department of Telecommunications (DoT) to block access to the Respondent's website within India, until further notice so as to ensure that potential clients are not mislead believing one firm to be another.

DELHI HIGH COURT UPHOLDS THE NOTION THAT COPYRIGHTS CANNOT BE GRANTED TO IDEAS AND GENERIC TERMS

This Delhi High Court ("**Court**") case, once again, upheld the premise that copyright protection can only granted to creative works, not ideas or generic terms.⁴⁰ In this case, the bone of contention was concerning the phrase 'Coming Soon,' where an individual, Mr. Rajan Aggarwal alleged that HMD Mobile India Private Limited ("**HMD**") promoting the launch of Nokia products through a clip with the phrase 'Coming Soon' was infringing his copyrighted work 'Advertisement' which used the phrase 'Coming Soon' in the logo ("**Impugned Copyright**").

HMD approached the copyright office in order to redact the copyright registration held by Mr. Aggarwal. Through

the inspection, HMD found that there was an objection raised by the Deputy Registrar of Copyrights as to the copyrightability of an idea in the Discrepancy Report ("**Report**"), to which Mr. Aggarwal had not responded. In furtherance to the same, HMD filed an interlocutory application before the Court, questioning the originality and copyrightability of the Impugned Copyright, and claimed the work to be an idea, which was not eligible for copyright protection under the Copyright Act, 1957.

The Court, whilst relying on the principles laid down in the case of **Informa Markets India Private Limited v. M/s 4 Pinfotech and Anr.**,⁴¹ held that Mr. Aggarwal could not produce any evidence responding to the objection raised by the Deputy Registrar of Copyrights. Though the copyright registration was granted, the Court held that the Impugned Copyright was vague, abstract and generic. Further, it was also opined by the Court that the phrase 'Coming Soon' was widely used by various companies and was available in the public domain and no copyright was to be granted in relation to the same.

The Court held that the objection was rightfully raised by the Deputy Registrar of Copyrights in the Report and ordered for the registration of the Impugned Copyright to be redacted from the Copyright Register within 4 (four) weeks of the said order.

CALCUTTA HIGH COURT UPHOLDS THE CONSTITUTIONAL VALIDITY OF SECTION 53 OF THE PATENTS ACT, 1970

The constitutional validity of Section 53 of the Patents Act, 1970 ("**Act**"), which lays down the term of a patent, was upheld by the High Court of Calcutta ("**Court**"), reinstating that the said term of 20 (twenty) years began from the date of application and not the date of grant of such patent⁴². It was contented by the Petitioner that the provision under question was contradictory to the rest of the provisions of the Act, arguing that rights associated with a patent only come into effect after its grant. The Petitioner relied on Section 11A(7) of the Act which provided for limited patent rights from the date of publication of the application until its grant.

39. Singh and Singh Law Firm LLP & Anr. v. Singh and Singh Attorneys & Ors. CS(COMM) 466/2024

40. HMD Mobile India Private Limited v. Mr. Rajan Aggarwal and Anr., C.O. (COMM.IPD-CR) 1/2024.

41. Informa Markets India Private Limited v. M/s 4 Pinfotech and Another, C.O. (COMM.IPD-CR) 695/2022.

42. Gunjan Sinha @ Kanishk Sinha and Another v. The Union of India and Another, WPA No. 8961/2023.

On the other hand, the Respondent, i.e., Union of India, contended that Section 11A and Section 53 of the Act were to be read distinctly as they provided for the rights of the owner at different stages of registration of a patent. Further, it was also contended that the term laid down under the Act was in line with the international obligations of India under the Agreement on Trade Related Aspects of Intellectual Property Rights (“**TRIPS**”) where it had been provided that the term of patent lasted for (20) twenty years from the date of filing of such application for the registration of a patent and as such there was no time that was lost by the applicant.

The Court upheld the contentions of the State and highlighted its international obligations under TRIPS, holding that the decisions made by the State were well within the legislative competence. It was held that rights accorded to a granted patent were statutory rights and not fundamental rights, and as such these rights did not violate any constitutional principles. The writ petition was accordingly dismissed, and it was held that there was no legislative incompetence or irrationality associated with either of the provisions of the Act.

DELHI HIGH COURT GRANTS INJUNCTION IN FAVOUR OF DOMINOS

The leading Pizza chain, Dominos IP Holder LLC & Jubilant Food Works Limited (“**Plaintiff**”) filed a suit for trade mark infringement against a Punjab based entity, MG Foods & Anr (“**Defendants**”) before the Hon’ble Delhi High Court (“**Court**”).⁴³ The Plaintiff sought an *ex-parte interim* injunction to restrain the Defendant from operating under the mark Donito’s (“**Impugned Mark**”) in respect of its food products like Pizza and Burger. It was the case of the Plaintiff that the identical nature of goods / services offered by the Defendant under the Impugned Mark in regions such as Jalandhar, Nakodar, Goraya and Mehatpur, was likely to cause consumer deception and severely impact its hard-earned goodwill / reputation.

Plaintiff’s Mark



Defendant’s Mark



The Plaintiff informed that the use of the Impugned Mark was discovered when it came across a YouTube video where #Dominos was linked with #Donitos. The Plaintiff further argued that it held the exclusive right to use and restrain the use of its registered trade marks, including ‘Domino’s’ and ‘Domino’s Pizza’ since 1965 and is widely recognized globally.

The Court, after perusing the documents placed of record and the arguments, found that a strong prima-facie case was made out in favour of the Plaintiff. Consequently, the Court granted an *ex-parte ad interim* injunction. It further instructed the Defendant to remove all references to its device marks from its website and further ordered all social media platforms to take down listings of Defendant’s products under the Impugned Mark within a period of 1 (one) week from the said order. The Defendant also stands restrained from advertising, promoting, selling and packaging any of their products under the Impugned Mark in question, or any other mark that was identical or deceptively similar to the Domino’s registered trade marks. The next date of hearing in the matter is on October 15, 2024.

DELHI HIGH COURT PASSES AN ORDER IN THE MAX FRESH TRADE MARK DISPUTE

Two leading tiffin box and utensil manufacturers, Shree Vallabh Metals (“**SVM**”) and CELLO Household Private Limited (“**CELLO**”) had been in a dispute over the ‘MAX FRESH’ trade mark.⁴⁴ The dispute began with CELLO products being sold under the trade mark ‘CELLO MAX FRESH,’ which infringed on the registered trade mark of SVM, who obtained the registration for the same in 2010 from the Trade Mark Registry. SVM claimed that they had been selling their products under the trade mark,

43. Dominos IP Holder LLC & Anr. v. M/s MG Foods & Anr., CS (COMM) 517/2024.

44. M/s Shree Vallabh Metals v. M/s Cello Plastic Industrial Works & Ors., CS(COMM) 747/2023.

including exporting them to various other companies. CELLO had also filed for registration of the trade mark, but was not granted the same.

In October 2023, the Delhi High Court ("**Court**") granted an injunction against CELLO for any further manufacturing of the products under MAX FRESH, until 31 March, 2024 to get rid of existing stock. However, in April – May 2024, SVM had purchased these tiffin boxes from an e-retail website and found that these products continued to be manufactured from November 2023 to March 2024. They consequently filed a contempt application before the Court for violation of the October 2023 injunction order.

In an order passed on May 24, 2024, the Court permitted the Authorized Representative of SVM to visit the CELLO factory to inspect the unsold goods which still contained the MAX FRESH trade mark. The Court also requested the counsel of the SVM to take instructions on whether the suit can be resolved. This was based on the statement of the chief operating officer of CELLO, who stated that they were willing to stop manufacturing products under the trade mark MAX FRESH, and comply with the permanent injunction if SVM was willing to give up its claim for damages and costs. The matter is scheduled for August 09, 2024 for further hearing.



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