



# 2021

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MAY ISSUE

## PATENTS

### **The High Court of Delhi Directs the Controller to Expedite the Pre-Grant Opposition Proceedings<sup>1</sup>**

Natco Pharma, one of the Petitioners in the present matter ("Petitioner"), filed a Pre-Grant Opposition ("Opposition"), in respect of a Patent Application filed by Novartis AG ("Respondent"). Instead of allowing the request of the Petitioner to cross examine the three expert witnesses whose evidence was filed by the Respondent during the Opposition Proceedings, the Controller of Patents ("Controller") reserved the order based on the merits. Thus, the aggrieved Petitioner approached the High Court of Delhi ("Court") through a writ petition.

The Court directed the Controller that opportunity be given to Petitioner to cross examine the three expert witnesses whose evidence had been filed by the Respondent during the Opposition Proceedings.

The Court further emphasized that no decision or views shall be passed or given by the Court regarding merits of the Patent Application, or any proceedings related to the said patent application.

Additionally, the Court stated that in the event the cross-examination order was not in the Petitioner's favour, the final order in the Patent Application must not be passed for a period of 10 days after the communication

of the said order to the Petitioner. However, in the event the decision was in the Petitioner's favour, the Controller must pass the appropriate order in accordance with the law.

## DESIGN

### **The High Court of Delhi Summarily Dismisses the Design Injunction Suit<sup>2</sup>**

The High Court of Delhi ("Court"), on application of Aashiana Rolling Mills Limited ("Defendant") under Order XIII-A of the Code of Civil Procedure, 1908 ("CPC"), summarily dismissed the design infringement suit filed by Kamdhenu Limited ("Petitioner"). The Petitioner had design registration for double ribbed surface pattern for steel bars. Initially a suit was filed before the District Court which was later transferred to this Court. The District Court passed the ex-parte order in favor of the Plaintiff and directed inspection of the Defendant's premises and seizure of infringing goods and packaging material and equipment along with the Defendant's business record. The Single Bench of the Court also withheld the injunction order of the District Court. The Defendant challenged the said order of the Court before the Division Bench, which set aside the previous order after considering the submissions of the Defendant that the registration of the design is invalid in view of the prior art publications.

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<sup>1</sup> [Natco Pharma Ltd. v. Union of India and Ors](#)

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<sup>2</sup> [Kamdhenu Ltd. v. Aashiana Rolling Mills Ltd.](#)

During the pendency of the matter before the Division Bench of the Court the Defendant filed an interlocutory application, sought dismissal of the suit without evidentiary proceedings in exercise of the Court's jurisdiction under Order XIII-A of the CPC, given that the matter was a commercial matter wherein Plaintiff did not have adequate chances of success.

The Defendant contended that the Plaintiff's product did not demonstrate novelty or originality in view of the prior disclosure in British Standard B500C (2005), German Standard (1984), Polish Standard (2006), etc. Therefore, the design was in violation of the originality requirement of the Design Act, 2000, and violative of Sections 2(d) and 4 of the Design Act, 2000. The Defendant also contended that the design is vulnerable to cancellation under Section 19 of the Designs Act, 2000 and such a violation can be used as a defense under Section 22 of the Design Act, 2000. Regarding the Plaintiff's claim of novelty, the Defendant relied upon the judgements of the High Court of Delhi in *Carlsberg Breweries A/S v. Som Distilleries and Breweries Limited* (2017) 70 PTC 413(Del), *B. Chawla and Sons v. Bright Auto Industries* AIR 1981 Del 95, *Crocs Inc. USA v. Liberty Shoes Ltd.* 2018 SCC OnLine Del 7107 [CS(COMM) 772/2016, and *Crocs Inc. v. Bata India Ltd.* (2019) 78 PTC 1 (Del).

The Plaintiff submitted that the novelty of the design was specific angles or placement of the ribs on the steel bars, however it was

countered by the Defendant that the design registration has not mentioned any angles but was in relation to the double ribbed surface pattern containing longitudinal and transversal ribs. The Defendant also contended that the novel feature was not noticeable by the eye, and further that it was merely a functional aspect of the design.

The Plaintiff relied upon the Supreme Court judgement in *Bharat Glass Tube Ltd. v. Gopal Glass Works Ltd.* (2008) 10 SCC 65, and submitted that the Plaintiff's claim cannot be rejected under Order XIII-A of the CPC and that determination of the dispute required adjudication upon evidence.

The Plaintiff further contended that mere conformity to universal standards does not negate the novelty of a design and that conformity to the British Standard should not prohibit registration of the design.

The Court highlighted that in the Certificate of Registration and the Endorsement of Novelty, the Plaintiff specifically mentioned that the novelty of the design was with respect to the surface pattern, and not any angles of the patterns. The Court accepted the Defendant's reliance upon the *Carlsberg, B. Chawla and Crocs* judgements to hold that the registered product was not new but merely a "different combination of familiar contrivances".

The Court accordingly held that the Defendant successfully established that the Plaintiff's design was a prior publication and

was in violation of Section 4 of the Designs Act, 2000 and that it was fit to invoke Order XIII-A of the CPC. Given that the conclusions of the Court were based on undisputed material already placed before the Court, the Plaintiff did not have reasonable prospects of success and so the Court entered a summary judgement and dismissed the suit.

### **TRADEMARK**

#### **The High Court of Delhi Grants ex-parte Injunction against Use of Mark “KHADI”<sup>3</sup>**

Khadi and Village Industries Commission, (“Plaintiff”) was formed in 1957. The Plaintiff adopted and used the mark “KHADI” and its associations such as the “Khadi Chakra Symbol” continuously since 1956, prior to its formation. The High Court of Delhi (“Court”) observed that by virtue of the same, the Plaintiff is the sole and exclusive proprietor of the mark “KHADI”. The Court further recognized that the marks of the Plaintiff not only act as identifiers but also as symbols of purity and authenticity. Furthermore, associated enterprises that carry out manufacture and production of the Plaintiff's products are subject to the provisions of the Khadi Mark Regulations, 2013, in order to ensure veracity and authenticity of the products and ventures and to further certify

the authorized Khadi Institutions and affiliates.

The Plaintiff submitted that Khadi Design Council of India and Ors., (“Defendant”) held events such as ‘National Khadi Designers Awards, 2019’, ‘Miss and Mrs. India Khadi, 2021’ and ran e-commerce websites such as ‘www.paridhaanam.com’ which was seen to be analogous to the Plaintiff's e-commerce website, ‘www.ekhadiindia.com’. The Court noted that all of the advertisement material of the Defendant was marketed and worded in such a way that giving an impression of being organized by the Plaintiff or an agency carrying out similar business activities as that of the Plaintiff. Consequently, the Plaintiff filed an ex-parte injunction application restraining the Defendant from using “KHADI” or other marks associated with the Plaintiff, which the Court granted. The Court noted that the use of logos analogous to that of the Plaintiff's by the Defendant, or even the use of mark “KHADI” especially in a manner to attribute association with the Plaintiff enterprise, establishes a prima facie case in the Plaintiff's favour. The Court also established that the balance of convenience lies in the favour of the Plaintiff and that an irreparable loss would be caused if an ex-parte interim injunction is not granted to the Plaintiff restraining the Defendant from their infringing /passing-off activities.

<sup>3</sup> [Khadi and Village Industries Ltd. v. Khadi Design Council of India and Ors.](#)

### The High Court of Delhi Grants an ad-interim injunction for Passing-Off of a Trademark<sup>4</sup>

A case was filed by Kulvinder Singh Kohli ("Plaintiff"), before the High Court of Delhi ("Court"), seeking an ex-parte injunction to restrain Monsendeep Kaur ("Defendant") from using the mark "Pamoist". The remedy sought was for passing off, as the mark had not been registered.

The Plaintiff had set up a Non-Profit Organisation, 'Pamoist Charitable Trust' in 2008, for charitable purposes. Additionally, since 2011 the Plaintiff has been independently using the mark "Pamoist", with full knowledge of the members of the said trust, without any objection. The mark was used by the Plaintiff for videos pertaining to religious preaching, spiritual readings etc., on various social media platforms like Facebook, Twitter and YouTube. Notably, in February, 2021 the Pamoist Charitable Trust was dissolved and all the assets of the property were transferred to "Pamoist International" which was founded and chaired by the Plaintiff.

On September 19, 2020, the Plaintiff filed for registration of the mark "Pamoist" under various classes. However, an opposition notice was filed by the Defendant, the daughter of the patron-in-chief of the Pamoist Charitable Trust, claiming equal rights over the mark "Pamoist". The Court observed that the Defendant has not been

able to establish any usage with respect to the unregistered mark, hence has no interest on the mark.

Accordingly, the Court held that a prima facie case had been established by the Plaintiff. As a result, the Defendant was restrained from using the mark "Pamoist" or any other mark similar to it in respect of any goods and services as claimed by the Plaintiff, till the next date of hearing of the suit. However, the Court observed that the Registrar of Trademarks was free to adjudicate upon the opposition notice filed by the Defendant against the applications of the Plaintiff as per law, uninfluenced by any observations of the Court, in the said matter.

### The High Court of Delhi Restrains the Defendant against Illegal Capitalization of Brand's Reputation<sup>5</sup>

Zed Lifestyle Pvt Ltd ("Plaintiff") filed a petition before the High Court of Delhi ("Court") regarding infringement and passing-off of its mark under the Trade Marks Act, 1999. The Plaintiff alleged that Hardik Mukeshbhai Pansheriya ("Defendant") has been using the mark "BEARDO", which has been registered by the Plaintiff as a word and device mark, with 18 different registrations involving various pictorial representations, under classes 3, 5, 18, 21, 25, 35, 41 and 44. In contrast, the Defendant

<sup>4</sup> [Kulvinder Singh Kohli & Anr v. Monsendeep Kaur](#)

<sup>5</sup> [Zed Lifestyle Pvt. Ltd. v. Hardik Mukeshbhai Pansheriya](#)



had secured trademark registrations of the word mark "BEARDO" only in classes 7 and 11.

The Plaintiff contended that upon the search of "BEARDO" on the amazon.in website, the results showed the Defendant's products in addition to the Plaintiff's products. These products had no resemblance with the Plaintiff's products, and nowhere on the products was the word mark or trademark "BEARDO" mentioned. The products manufactured by the Defendant included distilled water for batteries, inflatable air pumps for toy balloons and toilet cleaner fluid. The Court observed that the words "Sold by Beardo Store" were also found towards the lower part of the webpages advertising the Defendant's products on the e-commerce portal. It was argued that the Defendant was seeking to capitalize on the goodwill of the Plaintiff by falsely representing to the public that their products are sold by the "Beardo Store" on their website.

The Court held that the Defendant possessed registration of the "BEARDO" word mark only in respect of items such as LED lighting apparatus, mixers, machines, etc. which were not manufactured or sold by the Plaintiff and that there was no prima facie validity applied to the Defendant, in respect of the items other than the ones in respect of which the Defendant had registrations. Moreover, given that the Defendant's products such as "BEARDO Distilled Water"

and "BEARDO New Two Nozzles High Power Electric Balloon" are being sold by Amazon, even while the word "BEARDO", or any representation thereof is not being found on the products themselves indicated that Defendant was prima facie illegally capitalizing on the Plaintiff's reputation.

The Court granted an ex-parte ad interim relief to the Plaintiff and restrained the Defendant from using the "BEARDO" mark or any mark identical or deceptively similar, except those in respect of which the Defendant possessed trademark registrations in Classes 7 and 11.

### **The High Court of Delhi Issues an ex-parte Injunction against Use of Mark "SAMU"<sup>6</sup>**

Alkem Laboratories Ltd. ("Plaintiff") registered the trademark "SUMO" under Class 5 in 1998, adopted a unique trade dress for the same in 1999 and registered affiliated trademarks "SUMOFLAM", "SUMOCOLD", "SUMOGEL" in 2018. The Plaintiff submitted that in December, 2020, it came across the mark "SAMU", adopted by SGS Pharmaceuticals Pvt. Ltd. ("Defendant"), with a trade dress for its tablets similar to that of the Plaintiff's.

<sup>6</sup> [Alkem Laboratories Ltd. v. SGS Pharmaceutical Pvt. Ltd.](#)

Plaintiff's Products Packaging	Defendant's Product Packaging
	

In December, 2020, the Plaintiff sent a legal notice to the Defendant and on January 04, 2021, the Defendant replied to the notice denying all allegations, stating that the registration for the trademark "SAMU" was secured in 2001 by the Defendant and had been manufacturing the impugned product for the past year and a half.

The Delhi High Court ("Court") observed that a bare perusal of the both the products show that the Defendant's products, bearing the mark "SAMU" and the trade dress is deceptively similar to that of the Plaintiff's trademark "SUMO" and trade dress. Further, the composition of the products of both the parties state 'Nimesulide and Paracetamol' tablets. Accordingly, the Court has issued an order of restraint against the Defendant for using the mark "SAMU" or any other mark that is identical or deceptively similar to the trademark of the Plaintiff "SUMO", till the next date of hearing.

## COPYRIGHT

### **The High Court of Delhi Orders Suspension of WhatsApp Accounts upon Infringement of Rights Leading to Violation of its User Terms<sup>7</sup>**

Zee Entertainment Enterprises ("Plaintiff") filed a suit before the High Court of Delhi ("Court") seeking permanent injunction, rendition of accounts and damages for the infringement of its exclusive rights in the recently released film 'Radhe: Your Most Wanted Bhai'.

The Plaintiff operates a digital entertainment streaming service called 'ZeePlex'— a premium movie-on-demand service where the users could rent/gain access to premium films and movies. After the release of the film, exclusively on the Plaintiff's platform, on 13th May 2021, the Plaintiff was made aware of the circulation of several video clips, on several social media platforms, including 'WhatsApp', being made and/or sold for illegal and unauthorized viewing, download and storage to public at large by individuals using the apps. The Plaintiff argued that the Defendants were directly infringing the Plaintiff's copyright under Section 51(a) (i) of the Copyright Act, 1957 and were also breaching the terms of service of Whatsapp LLC ("User Terms"), who was also made a party to in the present suit as Defendant no.

<sup>7</sup> [Zee Entertainment Enterprises v. Tejendra Modi and Ors.](#)

9. The Court found that Defendants no. 1 to 8 were evidently breaching the User Terms by illegally sharing copies of the film and Defendants nos. 4 and 8 were ex facie violating the User Terms since they were providing copies of the film on the receipt of payment. Thus, the Court decided that the balance of convenience lay in the Plaintiff's favor and an irreparable loss would be caused if an injunction was not granted. Thus, the servants, relatives, agents or any representative acting on behalf of any of the Defendants were restrained from unauthorized storing, reproducing, communicating, disseminating, circulating, copying, selling, offering for sale or making available copies of the film or any other portion thereof, through WhatsApp or any other means or modes, until the next date of hearing. The Court also directed Defendant no. 9 to suspend the WhatsApp accounts of Defendants' nos. 4 and 8 within 24 hours from the receipt of request from the Plaintiff due to the breach of the User Terms.

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