



# 2021

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## WIPO- World IP Day 2021 and IP Initiatives of Singhania & Partners

The theme “**IP & SMEs: Taking Your Ideas to Market**” for World Intellectual Property Day- 2021 has been declared by World Intellectual Property Organization (WIPO). The aim is to encouraging innovation among SMEs with a focus on IP Protection, thus generating value for their businesses.

In order to take this derive further s Singhania & Partners LLP, initiated “**Small Scale Zone-2021**” and “**Women Claim-2021**” in the best interest of applicants/entities, particularly, small-scale businesses, start-ups, research institutes, universities and women innovators/applicant with regard to IP Services, in India.

Please write at [ipp@singhanian.in](mailto:ipp@singhanian.in) or [iptm@singhanian.in](mailto:iptm@singhanian.in) to know more about “Small Scale Zone-2021” and “Women Claim-2021”.

## PATENTS

### IPAB directs grant of patent for compound claims<sup>1</sup>

The order was passed by Intellectual Property Appellate Board (‘IPAB’) in favour of the Appellant, Allegro Pharmaceuticals, LLC. The patent application related to peptides for inhibiting cellular adhesion to Arg-Gly-Asp (the “RGD” tripeptide) binding sites and related treatments for disorders involving cellular adhesion to “RGD” tripeptide as filed by the Appellant with the Indian Patent Office. The Respondent, the Controller of Patents refused to grant the patent for the said invention to the Appellant on the single ground of Section 59 of the Patents Act, 1970.

The claims of the application were amended twice while the prosecution stages (responding to the Frist Office Action and with written hearing submission) to overcome the objections raised by the Respondent.

The refusal order stated that amendment in claims from “composition of matter” to “compound” is not allowed under Section 59 of the Patents Act, 1970 as it is beyond the scope of the present invention. While responding to the objection related to Clarity and Conciseness, the Appellant amended the claims to read the claim as:

Amended Claim 1	Before Amendment (Previous claim 11)
<b>A compound comprising</b> a	<b>A composition of matter comprising</b>

<sup>1</sup> [Allegro Pharmaceuticals LLC v. Controller of Patents](#)

<i>peptide, wherein the peptide comprises Glycine-Arginine-Glycine-Cysteic(Acid)-Threonine-Proline.</i>	<i>an RGCysteic Acid Peptide comprising Glycine-Arginine-Glycine-Cysteic(Acid)-Threonine-Proline.</i>
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The IPAB observed that the amended claims based on “compound” were within the scope, as the description of the invention clearly supports the “compound claims”. Therefore, the objection related to amendment raised by the Respondent was without reason. The IPBA also observed that claim set is also claiming “composition” in addition to “compound claim”, however both the terms cannot be used interchangeably in the present invention.

The IPAB advised amended claims set 1 to 2, within the scope of the invention however no new matter has been incorporated in the claims. The Respondent was directed to grant the claims set within 3 weeks from the date for filing by the Appellant.

### **IPAB issues directions for virtual hearing of pre-grant opposition<sup>2</sup>**

The Intellectual Property Appellate Board (‘IPAB’) while emphasising on the issue of ‘Benami’ oppositions, issued directions in order to prevent the deliberate attempt of

pre-grant opponents to drag the litigation indefinitely to delay the final outcome in the patent application. Accordingly, the division bench issued the following directions –

- The controller shall fix the hearings in such a way that he hears at least one party every day and finishes all pre-grant oppositions within 15 days;
- If the controller has heard all the opposing parties and has subsequently reserved the order, he shall go ahead with the pronouncement of order even if new pre-grant oppositions have been filed between the dates;
- For subsequent pre-grant oppositions, the controller shall make the opinion as whether any new grounds have been established and annotate whether the subsequent oppositions are maintainable or not;
- No pre-grant opposition shall be unduly accepted where the application for patent is not subsisting/pending at the Indian Patent Office;
- Persons filing the pre-grant opposition shall submit their valid Aadhar Card/Voter Id Card/ Passport/Driving Licence to authenticate his identity.

Notably, the Assistant Controller of Patents was directed to comply with the abovementioned directions within 3 months from the issuance of the order.

<sup>2</sup> [Novartis AG v. Controller of Patents](#)

## **The Draft Patent (Amendment) Rules 2021 notified<sup>3</sup>**

The Government of India has recently published the draft Patent (Amendment) Rules 2021 ('Draft Rules'). The Draft Rules are subject to inclusion of the definition of the 'eligible educational institution'. The defined educational institutes can claim reduced filing fee which is akin to Natural Person by filing relevant form along with evidence in this regard. Further, the eligible educational institution would be eligible for requesting the expedited examination.

As per the proposed amendments, the 'eligible educational institution' means which are established by a Central, Provincial or State Act and is owned or controlled by the Government and is wholly or substantially financed by the Government.

## **TRADEMARK**

### **MICHEAL HILL, with amended user, secures trademark registration in Class 14<sup>4</sup>**

Micheal Hill Franchise Pty Limited ('Appellant') had approached the Intellectual Property Appellate Board ('IPAB') against the refusal order issued by the Registrar of Trademark for the registration of

the mark "Micheal Hill" in Class 14. The Appellant had originally filed the trademark application on 'proposed to be used' basis which was later amended by the Applicant claiming user since 2007.

The Appellant contended that the mark shall be accorded the benefit of honest and concurrent use due to the mark's usage and cross border reputation. The IPAB noted that the Appellant has a long standing presence through its high impact advertisements and wide internet presence along with trademark registrations in over 8 other jurisdictions.

The Appellant had further submitted voluminous documents compelling the amendment application to be allowed and the benefit under Section 12 of the Trademarks Act, 1999 to be accorded to the Appellant.

Accordingly, the impugned mark with amended user was directed to be accepted by the Registrar of Trademarks.

### **Delhi High Court passes an ex-parte order against the infringing use by cosmetic conglomerate RSH Global Pvt. LTD <sup>5</sup>**

The Delhi High Court ('Court') passed an interim order against using, distributing, selling, importing, offering for sale and advertising

<sup>3</sup> [Patents \(Amendment\) Rules, 2021](#)

<sup>4</sup> [Micheal Hill Franchise PTY Limited v. The Registrar of Trademarks](#)

<sup>5</sup> [Beiersdorf AG v. RSH Global Private Ltd. & Anr](#)

cosmetic products especially body cream and lotion that are deceptively similar to mark "NIVEA" of Beiersdorf AG ('Plaintiff'). The Plaintiff had alleged that RSH Global Pvt. Ltd. ('Defendant') had commenced manufacture of "Joy Intense Moisture" moisturizing lotion, in a container, using a trade dress which was deceptively similar to that of the Plaintiff.



The Delhi High Court observed that till the Defendant started manufacturing the infringing products, the trade dress of the Defendant's products did not imitate or replicate any of the distinctive features which mark the trade dress of the Plaintiff's product. The Court was of the view that there is, prima facie, every likelihood of an unwary purchaser, of average intelligence and imperfect recollection, confusing the product of the Defendant with that of the Plaintiff. Hence, it was held that prima facie case of deliberate infringement was successfully made out by the Plaintiff.

### No monopoly over the mark "CORONIL"<sup>6</sup>

While setting aside the restraining order issued by the single bench of the Madras High Court ('Court'), a division bench of the Court observed that the use of the word "CORONIL" in the process of manufacture and sale of immunity boosting tablets will not be detrimental to the distinctive character and repute of the marks "CORONIL-92 B" and "CORONIL- 213 SPL" registered for chemical preparations.

Previously, the grant of injunction had been issued under Section 29 of the Trademarks Act 1999 on the ground that rights conferred by registration are exclusive to the proprietor only. However, the Appellants, Patanjali Ayurved Limited and Divya Yog Mandir Trust, had contested that Arudra Engineers Private Limited ('Respondent') lacked a prima facie case in this matter and had failed to prove even an existing packaging of the product mentioned. The Appellants further contended the basic nature of the mark 'CORONIL' had been derived from the word Covid/Corona which related to the disease it aimed to cure or provide a boost of immunity for through its tablets. Additionally, the Appellants further drew a distinction with the marks of the Respondent and stated that the mark 'CORONIL' was used by the Respondent in

<sup>6</sup> [Patanjali Ayurved Limited and Divya Yog Mandir Trust v. Arudra Engineers Private Limited](#)

relation to the term 'corrosion', which was a function of their product.

The Court noted that as per Section 17 of the Trademarks Act, 1999, the registered marks are composite marks containing of additional alpha numerals which are absent in the case of the unregistered mark "CORONIL" of the Appellant. Hence, since the marks of Defendant were registered with a disclaimer to the alpha numerals, namely "92 B" and "213 SPL" no monopoly could be claimed over the words 'CORONIL' by the Respondent. Thus the injunction and costs passed by the single bench of the Court against the Appellants were stood to be set aside.

## **COPYRIGHT**

### **IPAB grants copyright protection to Architectural Drawing<sup>7</sup>**

AAP KA AWAS LLP ('Appellant') had filed a copyright application for an artistic work of a blue print of low cost housing titled "AAP KI AAWAZ AFORDABLE HOMES" with a description of a two bedroom unit set. The Registrar of Copyrights had previously refused the application on the ground that copyright protection only subsists on original work which is artistic in nature and possess artistic skill or craftsmanship. Resultantly, the Appellant filed

an appeal before the Intellectual Property Appellate Board ('IPAB').

Relying upon the Practice and Procedure Manual, 2018, the Appellant claimed that architectural drawing, as a drawn expression of the architect's original thoughts, expressed using technical signs, symbols and graphical representations together form an instruction to build a structure as a result, architectural drawings or plans are copyrightable subject matter. Citing Section 2 (c) of the Copyright Act, 1957, the Appellant further contended that that building plans are covered under 'artistic work', and such a work is not required to possess 'artistic quality'. Additionally, it was also brought to the attention of the IPAB that in the past the Copyright Office has issued 11 such registrations to similar artistic work. In view of the above submissions, the IPAB held that a mere layout apartment/home which is devoid of any artistic skill or craftsmanship is entitled for protection as an artistic work under the Copyright Act.

More importantly, the IPAB observed that concept of 'modicum of creativity' requires that there should be *de minimis* creativity and that the drawing in form of a diagram is capable of artistic qualities even if it may not look so to a layman. Therefore, the IPAB held that the Appellant's blue print shall be given copyright protection so long as the applicants, in such cases, submit the affidavit stating that they are the original authors of

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<sup>7</sup> [AAP KA AWAS LLP v. The Registrar of Copyrights](#)

the work and such dimensions are not available prior in the industry.

## **GENERAL**

### **Supreme Court refuses extension of term for the Chairman of Intellectual Property Appellate Board<sup>8</sup>**

In a plea to extend the tenure of the Intellectual Property Appellate Board ('IPAB') Chairperson Retd. Justice Manmohan Singh, the Supreme Court of India ('Supreme Court') clarified that a vice-chairperson or the senior-most member of the board may act as chairperson in the event of a vacancy to that position, or in the event of the incumbent's inability to function in the post.

The Supreme Court noted that technical members appointed, possess practical legal experience of ten to fifteen years and are hence legally trained and qualified to hold the position in case the tenure of the chairperson is not extended. Additionally, relying on the parliamentary intention of the provisions of the Trademarks Act, 1999, the Supreme Court held that the 5 years tenure of the chairperson prescribed under the Finance Act is merely to indicate the potential maximum age and tenure limits. Resultantly, the 3 years tenure of the chairperson fixed by the Central Government would take

precedence over the 5 years limit prescribed under the Finance Act.

Accordingly, the Supreme Court rejected the plea stating that the tenure limits set for the 19 different tribunals (including the IPAB) under the Finance Act, would not have any bearing on the circumstances of the case.

*Disclaimer: IPTimes.Law has been shared with the intent to provide a general overview of the IP developments in India. This should not be taken as a substitute for any legal advice in a specific situation (which can only be given after being formally engaged and familiarizing ourselves with all the relevant facts).*

*However, should you have any queries, require any assistance, or clarifications, with regard to anything contained in this newsletter please feel free to contact us at [iptm@singhania.in](mailto:iptm@singhania.in) or [ipp@singhania.in](mailto:ipp@singhania.in).*

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<sup>8</sup> [The International Association for Protection of Intellectual Property v. Union of India](#)

## **About Us**

*Singhania & Partners LLP (estd. 1999) is one of the leading full-service law firms in India headquartered in New Delhi and branch offices in Bangalore and Hyderabad. We are recommended by Chambers and Partners, Legal 500 and Asialaw in different practice areas. Our firm provides legal services in Corporate and Commercial, Mergers & Acquisitions, Dispute Resolution (Litigation & Arbitration), Employment, Infrastructure, Intellectual Property, and Project Finance. We are sole Indian member of TerraLex Inc. (USA), which is a global network of 600 law offices, more than 19,000 attorneys in 100+ countries. Singhania & Partners was set up by Mr. Ravi Singhania who is the youngest lawyer to be felicitated with the "National Law Day Award" for Corporate Laws (2006) by erstwhile Prime Minister Dr. Manmohan Singh. He is a board member in CRISIL Ltd., Asset Care Enterprise and Indian subsidiaries of some Fortune 500 companies. He is also a governing board member of Indian Council of Arbitration. Singhania & Partners clients include large and medium Indian and Foreign businesses, multinational corporations, and Fortune 500 companies. We also advise Ministries, Government Authorities, and Public Sector Undertakings. We are particularly strong in Infrastructure (Roads & Highways, Railways, Ports & Shipyards), Aerospace, Defense, Energy and Natural Resources (Power, Oil & Gas), Banking & Financial Services, Food Processing and Packaging, Education, Healthcare, Real Estate, and Information Technology.*



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