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REWIND

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PATENTS

Denial of Hearing Adjournment Request Results in Remand of the Application back to the Patent Office[1]

The Intellectual Property Appellate Board ("IPAB") referred back the patent application to the Patent Office for further prosecution and directed to provide fair hearing opportunity to the Applicant, Lifesaver IP Limited.

The Applicant within the legitimate limits, filed request for second adjournment under Rule 129 A of the Patents Rules, 2003 ("Rules") and was expecting the matter likely to be adjourned. The Controller instead of re-scheduling the hearing, issued an impugned order refusing the grant of patent due to non-compliance of the objections issued in the hearing notice, while denying the second adjournment request.

The Controller has a discretionary power to allow the adjournments filed under Rule129A of the Rules, however the legal provisions do not allow the Controller to pass an adverse order, without granting the applicant an opportunity of being heard.

The IPAB opined that the Controller did not act as per the statutory provisions and settled principles of natural justice by:

- arbitrarily deciding the request under the Rule 129A and passing the order of refusal;
- deciding the matter against the interest of the Applicant, without providing them a fair opportunity of being heard;
- not deciding the matter on the merits.

The IPAB also observed that it is significant in the interest of best justice that the inventors or applicants should be provided with the fair opportunity to defend the matters, within the legal limits provided by the law.

The Court Clarifies When Can a Pre-Grant Opposition be filed[2]

The division bench of the Bombay High Court ("Court") elucidated the correct interpretation of Section 25(1) of the Patents Act, 1970 ("Act") while holding that the action of filing a pre-grant opposition is time barred once the decision on grant of the patent has be delivered by the Patent Office. In the present case, a pre-grant opposition was filed by the Petitioner, Dhaval Diyora, against grant of the patent application filed by Pfizer Products Inc., eight days after the hearing proceedings before the Intellectual Property Appellate Board ("IPAB") were concluded. The Court noted that the scheme of Section 25(1) of the Act read with Rule 55 of the Patents Rules, 2003 postulates that both the requests i.e. request seeking grant of the patent and request for pre-grant opposition are to be heard by the Patent Office, simultaneously. The Court further observed that if, after the order of the IPAB,

[1] Lifesaver IP Limited V. Assistant Controller of Patents & Designs

[2] Dhaval Diyora V. Union of India

which is to be implemented by the Patent Office, the Patent Office entertains request for pre-grant oppositions, it may give rise to an endless series of such oppositions. Resultantly, the Court held that the right under Section 25(1) of the Act for third party pre-grant opposition starts when the patent is published and continues till the matter is decided by the Patent Office but no further. Emphasising on the rising tendency of filing of 'Benami Oppositions' which prevent the competitor from patenting its invention, the Court dismissed the petition with cost.

PCT Declaration Suffices as a 'Proof of Right'[3]

The Intellectual Property Appellate Board ("IPAB") clarified the position with regards to the legally accepted norms by which the requirements of filing 'Proof of Right' could be satisfied. The appeal was preferred by Dow Agrosciences LLC ("Appellant"), against the order of the Controller of Patents refusing the patent application on the sole ground of non-filing of Proof of Right document. Section 7(2) of the Patents Act, 1970 ("Act") specifies the need for filing 'Proof of Right' in case the application is made by virtue of assignment.

Notably, the Appellant had filed the patent application as a national phase claiming priority from the US Application. The Appellant submitted that it had already filed a declaration under Rule 4.17(ii) of PCT Regulation with PCT Request Form at the time of filing the PCT application. Hence as per Rule 51*bis* 2(ii) of the PCT Regulation, the designated office shall not require any document/evidence for entitlement of the applicant to apply for Patent, if declaration under Rule 4.17 (ii) is complied with PCT Request.

In view of the above the IPAB held that the legal requirement of filing 'Proof of Right' is met by filing of the declaration under Rule 4.17 (ii) of the PCT Regulation by the Appellant and further directed the Patent Office to grant the patent within 2 weeks of the issuance of the order.

Court Extends the Right of the Patentee to File for an Infringement Suit during Post-Grant Opposition Period[4]

The High Court of Delhi ("Court") while extending the scope of Section 48 of the Patents Act, 1970 ("Act") held that the right of a patent holder to file a suit for infringement would be maintainable even within one year of grant of patent. Differentiating itself from the Supreme Court's decision in the case Dr. Aloys Wobben and Anr. vs. Yogesh Mehra and Ors, the Court further held that the Plaintiff has certain rights as a patent holder under Section 48 of the Act which is not affected during the pendency of a post-grant opposition.

Appellate Board Overturns Refusal Order Taking into Account Procedural Bearings[5]

[3] Dow Agrosciences LLC V. The Controller of Patents

[4] CDE Asia Limited V. Jaideep Shekhar and Anr.

[5] Hettich-Oni Gmbh & Co. Kg V. Controller of Patents and Design

The Appellant, Hettich-Oni Gmbh & Co. Kg, had preferred the appeal against the order of the Patent Office refusing the patent application on grounds of lack of inventive step and non-submission of verification certificate for English translation of the corresponding PCT application.

The IPAB outrightly rejected the reasoning of the Patent Office that the prior art documents cited in the impugned order make the invention 'obvious' to a person skilled in the art. Additionally, the IPAB also noted that the Patent Office had disregarded Rule 28(7) of the Patent Rules by passing the refusal order on the date of hearing. The said Rule 28 (7), provides fifteen days from the date of hearing to the applicant to submit the written response.

The IPAB was of the view that such cases may be seen as 'implied bias' on the part of the Patent Office and should be avoided.

Resultantly, the IPAB directed the Patent Office to grant the patent on the basis of the claims on record to the Appellant, strictly within 2 weeks from the issuance of the order.

Court Rejects the Proposal of a 'Two-Tier' Confidentiality Club in an SEP Infringement Suit[6]

The Delhi High Court ("Court") rejected the Interdigital Technology Corporation ("Plaintiffs") proposal for seeking a "two tier Confidentiality Club", comprising an "outer tier" and an "inner tier" in an infringement suit against Xiaomi Corporation ("Defendant"). The "outer tier" documents and material can be accessed by the advocates, appointed experts and representatives of both the parties i.e. Plaintiffs and Defendants, whereas the "inner tier" documents can be accessed by advocates, (but not the in-house counsel), and experts appointed by the parties.

The Court recognised that while such Confidentiality Clubs exist in the foreign jurisdictions, however, the Plaintiff's request has to be assessed in the backdrop of "fair play jurisprudence" as it exists in India. Thereby the Court rejected the proposal on the following grounds:

a) permitting the constitution of such a Club would amount to granting blanket permission, to the Plaintiff, to keep certain documents accessible only to the technical experts, ex-house advocates, and attorneys of the parties and to not both the parties and their employees.
b) the statutory right of client-attorney privilege would be seriously breached if the client was unable to access the inner tier documents based on which it directs an advocate to act by only following instructions of her/his client.
c) by including license agreements in the "inner- tier" and away from the eyes of the Defendant, the two-tier Confidentiality Club would seriously impale the negotiating ability of the Defendant to compute Fair, Reasonable and Non-

[6] Interdigital Technology Corporation & Ors. V. Xiaomi Corporation & Ors

Discriminatory ("FRAND") terms for their usage of Plaintiff's SEPs.

However, the Court observed that such a Confidentiality Club may be if both the parties have agreed to the constitution of such two-tier Confidentiality Club.

Draft Science, Technology, and Innovation Policy Published[7]

The Ministry of Science & Technology, Government of India has released a Draft Science, Technology, and Innovation Policy, with an aim to emphasizing development of indigenous technologies and encouraging grass root innovations, by stakeholder-driven science, technology and innovation planning, information, evaluation and policy research in India.

The deadline for submission of comments by the stakeholders in 25 January 2021.

Second Phase of the Patent Prosecution Highway Announced

Recently, the second phase of Bilateral Patent Prosecution Highway has been announced between the Indian Patent Office and Japan Patent Office (JPO). The applications will be examined based on the prosecution history or documents of the corresponding jurisdiction. The guidelines[8] in this regard have been published on the website of Controller of Patents, Designs & Trademarks.

The Patent Rules Have Been Amended

The Government of India while exercising the powers conferred by Section 159 of the Patents Act, 1970, amended the Patents Rules 2003 through Patents (Amendment) Rules, 2020[9] and Patents (2nd Amendment) Rules, 2020[10].

The Patents (Amendment) Rules, 2020 is resulting in revision of the Form 27 for furnishing statement of working of the patented invention on commercial scale in India. The details of the related patents can be incorporated in a single Form and is required to be filed by September of every financial year instead of March.

Further, as per the Patents (2nd Amendment) Rules, 2020, reduction in the official fee applicable for the small entity has been observed. The official fee incurred by the applicants claiming small entity status is akin to Natural Persons.

NIAMCC Acquires the Status of International Depository Authority

National Agriculturally Important Microbial Culture Collection (NAIMCC), India has acquired the status of International Depository Authority ("IDA") under the Budapest Treaty[11]. Now, the Indian Jurisdiction has 3 IDAs including Microbial

[7] Draft Science, Technology, and Innovation Policy
[8] Patent Prosecution Highway
[9] Patents (Amendment) Rule, 2020
[10] Patents (2nd Amendment) Rule, 2020
[11] BUDAPEST Notification No. 338

Type Culture Collection and Gene Bank (MTCC) and Microbial Culture Collection (MCC). As per the Indian Patents Act ("Act"), in case a biological material described in the specification for patents is not available to the public and cannot be described adequately as per the provisions of the Act, such material should be deposited with the IDA on or before the date of filing of the application.

TRADEMARK

Appellate Board declares 'NOKIA as a well-known mark in India[12]

The Intellectual Property Appellate Board ("IPAB") overturned the decision of the Registrar of Trade Marks ("Registrar") which concluded that trademark, "NOKIA", of the leading telecommunication company Nokia Corporation ("Appellant") does not meet the requirements set out under Section 11(6) of the Trademarks Act, 1999 ("Act"). The IPAB has observed that the trademark "NOKIA" is protected in over 200 jurisdictions and the use of the mark has helped the Appellant in generating over billions of Euros. Owing to the extensive, exclusive, continuous and long-running use of the mark "NOKIA" since 1865, the Delhi High Court and Bombay High Court on multiple occasions have not shied away from recognising the mark "NOKIA" as a well-known mark. Presently, "NOKIA" has been recognised as a well-known mark in multiple jurisdictions including Taiwan, Greece, Romania, Indonesia, Benelux, Hong Kong, Turkey, Czech Republic, Lithuania, China, Finland & Bulgaria.

Combination of Descriptive Words may be Protected as a Trademark[13]

The Bombay High Court ("Court") has held that descriptive words commonly used in the trade may be protected as a trademark. The Court observed that individual words in a given case may be descriptive but their peculiar combination may create a unique appearance or identity on its own. Hence, a person may obtain successful registration and further prevent the use of identical or deceptively similar marks by others despite the inclusion of descriptive words.

In the present case Sky Enterprise Private Limited ("Plaintiff") was engaged in the business of manufacturing and marketing masala powder, spices, condiments, seasonings etc. The Plaintiff had trademark registrations for word marks "Star Zing White Chinese Pepper Masala" and "Star Zing Black Chinese Pepper Masala" which the court observed to be valid and subsisting. The Plaintiff had instituted infringement proceedings against Abaad Masala ("Defendant") for use of the marks "Star King White Chinese Pepper Masala" and "Star King Black Chinese Pepper Masala". The Court held that the balance of convenience weighs in the favour of the Plaintiff as the Plaintiff not only has registrations for the

[12] Nokia Corporation V. The Registrar of Trademarks

[13] Sky Enterprise Private Limited V. Abaad Masala

trademarks "White Chinese Pepper Masala" and "Black Chinese Pepper Masala", but has been actually using and advertising the said marks for marketing its goods. Accepting the argument of the Plaintiff, the Court held that the words due to its longstanding use created a second identity of the trademark which suggesting the source of the goods as the Plaintiff.

Delhi High Court grants ad-interim injunction against use of the mark "DMW"[14]

The Delhi High Court ("Court"), while reinterpreting the term "deceptive similarity", restrained the Indian e-rickshaw manufacturer, Om Balajee Automobile (India) Pvt. ("Defendant") from using its mark "DMW". An infringement suit was filed by German Automobile Company BAYERISCHE MOTOREN WERKE AG (BMW) ("Plaintiff") seeking a permanent injunction restraining the Defendant from manufacturing, exporting or otherwise dealing with goods including E-rickshaws, bearing DMW marks.

The Court while passing a favourable order for the Plaintiff observed that though different products are offered by the Defendant, albeit under the same class (Class 12), E-Rickshaws are goods somewhat similar to automobiles. Additionally, the Court acknowledged that the only difference between the two marks was the first letter and even then, the letters 'B' and 'D' were visually and phonetically similar. Lastly, the Court also remarked that, given the well-known nature of the mark 'BMW' it is unfathomable that the Defendant was unaware of the existence of the marks. Consequently, the Court passed an *ad interim* injunction restraining the Defendant, its officers, agents etc. from manufacturing, exporting, importing or offering for sale, advertising or in any manner dealing with goods bearing the mark 'DMW' or any other mark which is deceptively similar to the BMW mark(s).

Court Rejects Granting Protection to the Phonetically Generic Trademark "Delhivery"[15]

A trademark infringement suit was instituted by Delhivery Private Limited ("Plaintiff") against the use of the mark "DELIVER-E", before the Delhi High Court ("Court"). While vacating a previously imposed *ex parte* injunction against the use of the mark 'DELIVER-E', the Delhi High Court refused to grant the Plaintiff any relief, and observed from the submissions of the Plaintiff that the mark 'DELIVER-E' is deceptively similar to the mark "DELHIVERY", which suggests the genericness of the mark "DELHIVERY".

The Court accepted the argument of the Defendant, Treasure Vase Ventures Private Limited, that both marks are an adaption of the dictionary term "DELIVERY" and that both the parties are engaged in similar services, hence the Plaintiff would not be permitted to

[14] Bayerische Motoren Werke AG V. Om Balajee Automobile

[15] *Delhivery Private Limited V. Treasure Vase Ventures Private Limited*

exercise any monopoly on the market through its registered mark "DELHIVERY".

WIPO Notifies the 11th Amendment to the NICE Classification

On November 24th, World Intellectual Property Organization ("WIPO") notified the latest version of classes which has now come into effect since January 1, 2021. The 2021 version of the eleventh edition (11-2021) of the NICE Classification includes handful of changes which can be accessed from the WIPO's website.

With the advent of the NICE Agreement, a classification of goods and services was introduced with a total of 45 Classes (Goods : 1-34, Services : 35-45). This classification helps the applicants to identify and categories their goods or services into different heads of Classes. Originally, the WIPO would come up with an update on these categories every 5 years. However, since 2013 this seems to have become an annual custom.

DOMAIN NAME DISPUTES

Delhi HC Grants *ex parte* Anti-Suit Injunction to HT Media Limited against Brain Link International, Inc. Infringing Use of Domain Name[16]

The Delhi High Court ("Court") granted HT Media Limited ("Plaintiff") an *ex parte*, anti-suit injunction in the proceeding initiated by Brainlink International Inc. ("Defendant") before United States District Court in relation to the disputed domain name www.hindustan.com ("Disputed Domain Name"). The Defendant is engaged in the business of providing IT related support services to its customers.

The Court while deciding the present matter, referred the position previously adopted by the Supreme Court in *Modi Entertainment Network & Another V. W.S.G. Cricket Pvt. Ltd.* which held that the following aspects must be satisfied in order for any court to exercise its discretion to grant an anti-suit injunction –

(a) the defendant, against whom injunction is sought, is amenable to the personal jurisdiction of the court;

(b) if the injunction is declined, the ends of justice will be defeated and injustice will be perpetuated; and

(c) the principle of comity respect for the court in which the commencement or continuance of action/proceeding is sought to be restrained.

The Court examined that since 2000, the Defendant had not used the disputed domain name and hence the sole motive for registering the Disputed Domain Name was to profiteer from passive holding amounting to a passive case of cyber-squatting. Bad faith was also evident on part of the Defendant, as the price offered by the Defendant to sell the domain name increased from USD 1 Million to USD 3 Million when approached by the Petitioner. The Court also observed that the Defendant is

[16] HT Media Limited and Ors. vs. Brainlink International Inc. and Ors

also capable of selling the Disputed Domain Name to the competitors of HT Media Limited which is capable of tarnishing the goodwill of the leading publishing company.

Resultantly, the Court held that a cause of action arose under Section 20 (c) of CPC and thus an order of interim injunction was granted in favour of the Plaintiff restraining the Defendant from or creating any third party rights using the Disputed Domain Name.

WIPO Witnesses an Unprecedented Increase in Cybersquatting Complaints during the Covid-19 Pandemic

The World Intellectual Property Office ("WIPO") Arbitration and Mediation Centre, from January through October 2020, handled over 3,400 cases or an 11% increase over the same period during 2019. By November 30, 2020 the WIPO Arbitration and Mediation Centre had registered its 50,000th cybersquatting case covering almost 91,000 domain names, and involving parties from over 180 countries. Owing to the significant shift towards a more digital world, online consumption habits have changed significantly so much so that cybersquatters are finding an increasingly target-rich environment. Thus, WIPO acts as a time-tested tool against infringing use of domain names and further avoids expensive court litigation especially in cases of cross border disputes.

COPYRIGHT

Mere apprehension of likelihood sufficient to grant ad interim injunction in a Copyright infringement suit[17]

The Delhi High Court ("Court") has granted an *ad interim* injunction against use of the Chetak label on the Agribiotech Industries Limited's ("Defendant") product as it was deceptively similar to the registered Officers Choice label and Officers Choice Blue label of Allied Blenders and Distillers Pvt. Ltd. ("Plaintiff").

It was contented by the Plaintiff that the Defendant has copied the look and feel of the label pasted on the Plaintiff's product, thereby violating the Plaintiff's copyright in that label and has been passing off its goods as those of the Plaintiff. However, it was contended by the Defendant that since the Plaintiff operates through its subordinate office in Rajasthan, the Court lacked in territorial jurisdiction to adjudicate the matter.

While relying on Section 62 of the Copyright Act, 1957 and judicial practice, the Court held that in intellectual property actions, the mere apprehension of the likelihood of the Defendant launching the allegedly infringing product within the territorial jurisdiction of the Court, would confer the necessary jurisdiction. The Court subsequently, proceeded to adjudicate the matter on merits and accordingly ordered an ad interim injunction, therefore restraining the

[17] Allied Blenders and Distillers Pvt. Ltd. V. Agribiotech Industries Limited

Defendant from using the impugned 'Chetak' label by any means.

Dainik Jagran Sues Telegram for circulation of their 'e-papers'[18]

Jagran Prakashan Limited ("Plaintiff") filed a suit impleading Telegram FZ LLC ("Defendant") and submitted that the users of the instant messaging application have been creating channels on platform of the Defendant wherein the e-newspapers of the Plaintiff are being uploaded in a PDF format on a daily basis. The Plaintiff claimed that with the help of such channels, Defendant is not only permitting availability of current editions of the e-paper but also users subscribing to the channels of the Defendant can download all the previous editions of the e-paper published in the past, which is otherwise available to a user only if he subscribes the e-paper subscription from the Plaintiff.

The High Court of Delhi ("Court") was of the view that the exemption under Section 79 of the Information Technology Act, 2000 cannot be granted to the Defendant as it failed to conduct a due diligence on being informed about the misuse. Considering the obvious liability on part of the Defendant, the Court directed the Defendant to disclose the basic subscriber information/identity of those who are engaged in reproducing, adopting, distributing, transmitting and disseminating the e-newspapers of the Plaintiff and further directed the Defendant to take down/block the Telegram Channels cited by the Plaintiff within 48 hours of the receipt of the order.

Disney secures injunction against malicious websites[19]

Disney Enterprises Inc. ("Plaintiff") initiated an action for copyright infringement before the Delhi High Court ("Court") against certain rogue websites ("Defendants") which were down-streaming the copyrighted work of the Plaintiff, without any prior permission, amounting to digital piracy.

The Court by way of an *ex-parte ad interim* injunction directed the Defendants to restrain from hosting, streamlining, reproducing, distributing, or making available to the public or communicating to the public, any cinematograph film or content belonging to the Plaintiff on their websites. Similarly, the Court also directed the concerned Internet Service Providers to block access to such rogue websites and mirror/redirect/alphanumeric websites of such rogue websites.

Copyright Protection Subsists in Theme, Plot and Story Line of Literary Works[20]

The Bombay High Court ("Court") held that the copyright protection extends to the plot and storyline of the plaintiff's own collection of short stories in Urdu titled "Singardaan". The Court noted that the defendants web series,

[18] Jagran Prakashan Limited V. Telegram FZ LLC & Ors

[19] Disney Enterprises, Inc. & Ors V. Kimcartoon.To & Ors

[20] Shamoil Ahmad Khan vs Falguni Shah & Ors

also known as "Singardaan" contains similarities of fundamental or substantial nature in respect of expression adopted in copyright of the plaintiff. The Court stripped the two stories of its embellishments, its description of the mood, the motivations and the tribulations of its characters and their actual actions and was consequently of the view that there is an arguable case of piracy.

Further, the Court was of the view that instead of granting a temporary injunction against exhibition of the web series, interest of justice would be served better the suit itself is set down for trial and the Defendants are asked to maintain accounts of the profits made from the web series from the date of publication of the web series till date and during the pendency of the suit, render them to the Court as and when demanded in the course of the trial. However, the Court restrained further adaptation or use of the web series in a different format.

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