

## Intellectual Property (IP) Glimpse of 2020:

- OTT now regulated by Indian Government
- Amendment of Patent Rules, 2005
- Amendment of Geographical Indications of Goods (Registration and Protection) Rules, 2002
- Nokia listed as a well-known Trademark
- Trademark Protection in a class to be limited to goods for which it is used
- Cross-border reputation is not automatic
- Descriptive term cannot be exclusively registered
- Trademark protection against social media influencers
- Statutory Protection of phonetically generic marks
- No exclusivity over the mark customary to trade
- Trade Dress and Copyright Infringement / Passing Off
- Dynamic Injunctions – Remedy to curtail mirror websites
- COVID related IP Cases

## OTT NOW REGULATED BY THE INDIAN GOVERNMENT

The OTT platforms (Over-The-Top platforms) which were largely unregulated for years in India have been brought under the ambit of Ministry of Information and Broadcasting (MIB). As notified in The Gazette of India on 10<sup>th</sup> of November, 2020, the Government of India (Allocation of Business) Rules, 1961 were amended to bring the Films and Audio-Visual programmes made available by online content providers & News and current affairs content on online platforms within the ambit of MIB.

## AMENDMENT OF PATENT RULES

The Patent (Amendment) Rules, 2020<sup>1</sup> which came into force on October 19, 2020 aims to streamline Form 27 Filings and Rule 21. Form 27 is the prescribed Form for Patentees and Licensees to furnish statements regarding the **working of their patent** in India. Rule 21 deals with the **filing of priority documents**. The highlights of the said Amendments are provided herein below:

- Patentee can file a single Form-27 in respect of a single or multiple related patents.
- Where a patent is granted to two or more persons, such persons may file a joint Form-27.
- The patentee is required to provide 'approximate revenue / value accrued'.
- Authorized agents are allowed to submit Form-27 on behalf of patentees.
- For filing Form-27, patentees will get six months, instead of the earlier limit of three months, from expiry of the financial year.
- Patentee will not be required to file Form-27 in respect of a part or fraction of the financial year.

<sup>1</sup> <https://pib.gov.in/PressReleaselframePage.aspx?PRID=1668081>

- If the priority document is available in WIPO's digital library, the applicant is not required to submit the same in the Indian Patent Office.
- Applicant will be required to submit verified English translation of a priority document, where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable or not.

## **AMENDMENT OF GI RULES**

The Ministry of Commerce and Industry (Department of Promotion of Industry and Internal Trade) notified amendments to the Geographical Indications of Goods (Registration and Protection) Rules, 2002 on 26<sup>th</sup> August, 2020. The amended rules will be known as Geographical Indications of Goods (Registration and Protection) (Amendment) Rules, 2020 (hereinafter referred to as “Rules”) vide notification G.S.R. 528(E)<sup>2</sup> published in The Gazette of India.

The key amendments are:

- For registration as an Authorized user, Form GI-3 must be filed along with a statement of case as to how the applicant claims to be the producer of the registered geographical indication (GI). The former Rules required a joint application by the applicant and the registered user.
- The fee for issuance of the registration certificate has been removed.
- The mandate to furnish priority date and appropriate office of GI Registry have been omitted.
- The mandate for submission of “unmounted representation of GI” to request for issuance of registration certificate as an authorized user has been omitted.
- The Fee for registration and renewal of an authorized used via Form GI-3 has been reduced to INR 10.

The amended Rules might be instrumental in easing the procedure with regard to GI registration.

## **NOKIA TO BE LISTED AS A WELL-KNOWN TRADEMARK IN INDIA**

In *Nokia Corporation v. Registrar of Trademarks*<sup>3</sup>, Nokia Corporation filed a representation before the Ld. Controller of Patents, Designs and Trademarks on 5<sup>th</sup> June, 2014 for inclusion of ‘Nokia’ in the list of well-known trademarks maintained by the Trademarks Office. The same was rejected by the Registry on 27<sup>th</sup> March 2017.

Nokia appealed before the Intellectual Property Appellate Board (IPAB) against the 2017 order of the Registrar of Trademarks. IPAB relied on the evidence and extensive documentation of Nokia’s global presence and market recognition since 1865. Nokia submitted evidence of its presence in over 140 countries, recognition of its mark as a well-known mark in numerous jurisdictions including in WIPO decisions along with statutory rights in 200 jurisdictions.

The IPAB quoted Article 16 of the TRIPS Agreement, 1994, that a well-known trademark was a mark that was widely known or recognized by the relevant section of the general public. It also cited the High Court of Delhi in

<sup>2</sup> [http://www.ipindia.nic.in/writereaddata/Portal/News/708\\_1\\_Notification-GI\\_amenmdent\\_rules.pdf](http://www.ipindia.nic.in/writereaddata/Portal/News/708_1_Notification-GI_amenmdent_rules.pdf)

<sup>3</sup> SR.No. 61/2017/TM/MUM

*Nokia Corporation v. Manas Chandra and Anr.*<sup>4</sup> wherein Nokia was considered to be well-known mark as per Section 29(4) of the Trademarks Act, 1999.

The IPAB opined that the Registrar had not taken into consideration the documents produced by the Appellant and that this failure on their part was unjust and unfair to the Appellant and also contrary to the Principles of Natural Justice and the mandatory provisions of the law. Thereby, IPAB directed the Respondent-Registrar to publish that NOKIA is a well-known trademark and set aside the impugned order.

## TRADEMARK PROTECTION IN A CLASS TO BE LIMITED TO GOODS FOR WHICH IT IS USED

The case ensued between *Mittal Electronics (Mittal) v. Sujata Home Appliances (p) Ltd. and Ors. (Sujata)*<sup>5</sup> wherein Mittal had filed a suit for infringement and passing off against the Respondent for use of the mark 'SUJATA' in Class 11 with the Delhi High Court. The Court had initially granted an ex-parte injunction in favour of Mittal.

Subsequently, Sujata filed an application to modify the interim order on grounds that Mittal had concealed the fact that they were not using the impugned mark for water purifiers, water filters and RO Systems and were merely squatting over the whole class. Sujata also revealed that they had been using the impugned mark since 2008 for the above-mentioned products.

On the revelation of these new facts, the Court referred to the Supreme Court's decision in the *Nadhini Deluxe Case*<sup>6</sup> wherein it was held that the registration of ***a trademark in a class is only limited to the goods and services for which it is registered and used and not for the entire class***. Thereby, as per the proviso to Order XXXIX Rule 4 of Code of Civil Procedure, 1908, the Court modified its interim order in the interest of justice Sujata was allowed to manufacture and sell water purifiers, water filters and RO Systems under the mark 'SUJATA' since Mittal was not using the mark 'SUJATA' for the said products.

## CROSS-BORDER REPUTATION IS NOT AUTOMATIC

The case *Keller Williams Realty, Inc. v. Dingle Buildcons Pvt. Ltd & Ors.*<sup>7</sup> was filed before Delhi High Court with regard to the use of trademark 'KW'. The Plaintiff 'Keller' prayed for a permanent injunction against the Defendants for infringing the trademark and passing off their services as that of the Plaintiff.

The Plaintiff Keller's mark KW was registered as of March 2012 on 'proposed to be used' basis whereas the Respondent Dingle had been using the same mark KW since April 2006 and had registered the mark in October 2016. Keller claimed relief against Dingle and the others stating that its reputation and goodwill in India was at stake because of these infringing marks. Having been incorporated and existed under the laws of the State of Texas, United States of America (USA) in 1983, with approximately 900 franchisees globally, it wished to assert its cross-border reputation. The Court rejected Keller's prayers on grounds that it had no business, customers, agents or franchisees in India and had not been instrumental in the establishment or operation of any real estate brokerage in India. The Plaintiff had not been able to prove that its international reputation and goodwill had spilled

<sup>4</sup> CS(OS) 1694/2015

<sup>5</sup> CS(COMM) 60/2020

<sup>6</sup> *Nandhini Deluxe vs. Karnataka Co-operative Milk Producers Federation Ltd.*, 2018 (9) SCC 183

<sup>7</sup> CS(COMM) 74/2019

over to India. Owing to that, the Plaintiff has not suffered any irreparable loss or injury. No injunction was granted in favour of the Plaintiff against the use of the marks by the Defendants.

## **DESCRIPTIVE TERM CANNOT BE EXCLUSIVELY REGISTERED**

In *Bharat Biotech International Ltd. v. Optival Health Solutions Pvt. Ltd.*<sup>8</sup>, the Delhi High Court held that “the mark 'ZYVAC-TCV' is not deceptively similar to the mark 'TYPBAR-TCV' and 'TCV' being an abbreviation of ‘*typhoid conjugated vaccine*’, is not capable of being registered as a trade mark. Bharat Biotech was the registered proprietor of the trademarks 'TCV' and 'Typbar-TCV' for a vaccine for Typhoid treatment and instituted a suit for trademark infringement against Optival Health Solutions Pvt. Ltd. for offering a Typhoid vaccine named 'ZYVAC-TCV'.

The trademark application for the mark TCV of the Plaintiff was registered for the goods ‘*typhoid conjugated vaccine formulations*’. The Court refused to grant injunction, since the registered trademark TCV - a descriptive term, was not exclusively associated with the plaintiff. The Court held that descriptive trademarks cannot be registered unless they have acquired a secondary meaning or are distinctly associated with the registered proprietor only.

## **TRADEMARK PROTECTION AGAINST SOCIAL MEDIA INFLUENCERS**

In *Abhijeet Bhansali v. Marico Limited*<sup>9</sup>, the Appellant posted a review video of Marico’s product ‘Parachute oil’ along with their trademark Parachute. The Respondent had initially approached the Court alleging that the Video contained disparaging remarks and that the Petitioner was an unauthorized user of the Respondent’s Trademark ‘Parachute’.

The Ld. Single Judge of Bombay High Court had restrained the Appellant and had ordered him to take down the video vide its judgment dated 15<sup>th</sup> January, 2020 (impugned order). The Appellant then appealed against the impugned order before the Division Bench of Bombay High Court on 28<sup>th</sup> January, 2020. This appeal aimed to answer questions of law that arise with the confrontation of freedom of speech and expression and dissemination of information vis-à-vis opinions expressed in non-commercial ventures.

On weighing all the dimensions and scrutinizing transcript of the video, the Court held that the Appellant’s video was not disparaging but a few words and expressions of the video must be deleted/alterd. The Video was not found to be misleading viewers. The Court thus put a stay on the impugned judgment on the aforesaid condition and pronounced its judgment on 14<sup>th</sup> February, 2020. A few other relevant and recent cases on commercial disparagement are:

- *Anhueser Busch LLC v. Rishav Sharma*<sup>10</sup>
- *Ashutosh Dubey v. Netflix Inc. and Ors.*<sup>11</sup>

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<sup>8</sup> CS(COMM) 1248/2018

<sup>9</sup> COMIP No. 596 of 2019

<sup>10</sup> CS(Comm) 288/2020

<sup>11</sup> MANU/DE/1008/2020

### STATUTORY PROTECTION OF PHONETICALLY GENERIC MARKS

In *Delhivery Private Ltd. Vs. Treasure Vase Ventures Pvt. Ltd.*<sup>12</sup> Delhivery filed a suit against Treasure for using the trademark “Deliver-e” which it claimed to be deceptively similar to its own mark “Delhivery”. Initially, an ex-parte interim injunction was granted in favour of the Plaintiff vide order dated July 03, 2020 (impugned order).

The Defendants then filed an application before the Delhi High Court to set aside the impugned order under Order XXXIX Rule 4 r/w Section 151 of Code of Civil Procedure, 1908.

The Court held that the two marks are phonetically similar to the generic English word ‘Delivery’ and therefore, stating that statutory rights cannot be granted for a phonetically generic word, it vacated its impugned order.

### NO EXCLUSIVITY OVER THE MARK CUSTOMARY TO TRADE

In *RB Health (US) LLC vs Dabur India Ltd.*<sup>13</sup> the plaintiff (Reckitt Benckiser) asserted that the defendant (Dabur) has committed tort of passing off broadly pivoted on the following 3 grounds-

1. The colour, smell, configuration, and shape of the soap bar.
2. The taglines used by the plaintiffs qua its products such as “be 100% sure”; “everyday protection against a wide range of unseen germs”; “germ protection for the whole family”; and “protection from 100 illness causing germs”.
3. The device of a sword and an overlapping plus + design on the product/packaging.

The representation of packaging for both RB and Dabur is:



14

On the first ground the Hon’ble court held that there is enough and more material to show that there are several soap bars in the market with similar features if not identical features. On the second and the third grounds the Hon’ble court held that neither the taglines nor the indications/signs are registered with the Trademark Authority.

<sup>12</sup> CS(Comm) 217/2020

<sup>13</sup> CS (Comm) 319/2020

<sup>14</sup> We do not claim any copyright in the image used. It has been used for academic and representational purposes only.

Since the competing products, like other products in the market, are hygiene- products, the taglines and indications/signs used by the plaintiffs appear to be “customary” in the “current language” of the trade for the purpose of designating hygiene-products which includes soap bars.

The court also held that Dabur does not intend to misrepresent that the soap bar manufactured by it originates from the plaintiff. The packaging boldly bears the mark “Dabur”. Therefore, the court dismissed the injunction suit by the plaintiff and held in favor of the defendant.

**TRADE DRESS AND COPYRIGHT INFRINGEMENT / PASSING OFF**

In Parle Product vs. Future Consumer Group<sup>15</sup>, Parle moved to the Bombay Court claiming infringement of the copyright and trade dress in respect of its products and packaging "MONACO", "HIDE & SEEK" and "KRACKJACK" against *Future Consumer* who were marketing their products under the names "CrackO" "Peek-a-Boo" and "Cracker King" with packaging very similar to that of Parle.

The Hon’ble Bombay High Court held that defendants have blatantly copied Plaintiffs’ Packaging / labels and stated, “*it is apparent that Defendants must have had Plaintiffs’ products before them while designing the impugned packaging. The similarity in the rival packaging/labels cannot be a matter of coincidence.*”

The representation of packaging for both Parle and Future Group is:

PLAINTIFFS' PRODUCTS	DEFENDANTS' IMPUGNED PRODUCTS
<p>MONACO</p> 	<p>CrackO</p> 
<p>HIDE &amp; SEEK</p> 	<p>PEEK-A-BOO</p> 
<p>KRACKJACK</p> 	<p>KRACKER KING</p> 

16

The court held that the Future Group has violated the Trademarks of Parle’s products in packaging, and passed an ad-interim injunction against it.

<sup>15</sup> Commercial IP Suit (L) No. 4130 of 2020

<sup>16</sup> We do not claim any copyright in the image used. It has been used for academic and representational purposes only.

## DYNAMIC INJUNCTIONS - REMEDY TO CURTAIL MIRROR WEBSITES

Increasing online Copyright piracy is a daunting problem for rightful owners of the content. These ‘hydra headed’ rogue websites are the ones that infringe the owner’s rights by resurfacing over and over again as a redirecting, mirror or alphanumeric website.

To tackle the aforesaid problem, Delhi High Court utilized the remedy of ‘Dynamic Injunctions’ in order to avoid the cumbersome Court procedures against these resurfacing websites. The saga of Dynamic Injunctions in India began from Delhi High Court’s landmark judgement on April 10, 2019 in the case *UTV vs. 1337x.to and Ors.*<sup>17</sup> As per this remedy, the aggrieved would need to approach the Joint Registrar of Delhi High Court for the extension of the injunction that has already been granted against similar websites that contain the same content as the original website.

Recently, *Dynamic Injunctions* have rescued a lot of leading companies to protect their copyright over their content including in the following matters:

- Snapdeal Private Limited vs. Snapdeallucky – Draws.org.in & Ors.<sup>18</sup>
- Disney Enterprises, Inc. & Ors. Vs. Kimcartoon.to & Ors.<sup>19</sup>
- Living Media Limited & Anr. vs. www.news-aajtak.co.in& Ors;<sup>20</sup>

## COVID RELATED IP CASES

COVID-19 has been the highlight of the year 2020. There have been several IP cases related to COVID matters. Some of those are:

- **Sasson FAB International Pvt. Ltd. v. Sanjay Garg and Registrar of Trademarks**<sup>21</sup>: The IPAB held that N95 for masks is a generic term and cannot be granted registration and/or protection as a trademark under the trademark laws.
- **Cutis Biotech v. Serum Institute of India Pvt. Ltd.**<sup>22</sup>: The Nanded Civil Court of Maharashtra issued a notice to Serum Institute of India in a passing off suit seeking to restrain Serum from using Cutis Biotech’s trademark "COVISHIELD" or "COVID-SHIELD" or any other identical or similar name for its proposed Corona vaccine. The Plaintiff had filed for registration of the trademark COVISHIELD on April 29, 2020 (Application No. 4493681; user claim: proposed to be used) whereas the Defendant filed for COVI SHIELD on June 06, 2020 (App. No. 4522244; user claim: proposed to be used).

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<sup>17</sup> CS(Comm) 724/2017

<sup>18</sup> CS (comm) 264/2020

<sup>19</sup> CS (Comm) 275/2020

<sup>20</sup> CS (Comm) 395/2020

<sup>21</sup> M.P. No. 143/2020 IN ORA/171/2020/TM/DEL

<sup>22</sup> CNR No.: MHND010025372020