

Intellectual Property (IP) Glimpse of 2021:

Legislative updates

- Amendment of Copyright Rules, 2021
- Intellectual Property Appellate Board (IPAB) abolished by Ordinance
- Amendment of Patent Rules, 2021
- Delhi High Court, Intellectual Property Division Rules, 2021

Policy Update

- India's Patent Waiver initiative

Case law Update

- "Covishield" for Cutis or SII?
- Registration of Copyright Societies
- The game of "Pe"
- India's First Anti-anti suit Injunction
- Only Copyright Societies to issue licenses
- Trade Dress Infringement
- Copyright in Scientific Research Papers: Open to all or a paid luxury?
- Trademark in Real Estate
- Restricting the Counterfeiters
- Sony Pictures tussles with Copyright Infringers off the Sports field
- Raid, Seizure and injunction
- Disparaging reference to Competitor's product
- Well-known marks and cross-class protection
- India's Khadi gains Global recognition
- "And then there were none"

LEGISLATIVE UPDATES

Amendment of Copyright Rules, 2021¹

On 30th March, 2021, the Ministry of Commerce and Industry notified the amendment of Copyright Rules, 2013. Some of the major changes are enlisted herein below:

- a) Publication of Copyright Journals on the Copyright Office's website
- b) , If the source code is longer than 20 pages in Copyright applications for Software, the applicant can file the first and last 10 pages of the source code with no redacted part
- c) The Centre shall have to respond to the applications for Registration of Copyright Societies within 180 days as opposed to 60 days given previously

¹Copyright-Rules_Amendment_2021.pdf

- d) Copyright Societies to furnish an Annual Transparency Report within 6 months of the end of every financial year
- e) For the collection and distribution of royalty amounts, new Rules have been inserted to make the payments electronic and traceable at all levels
- f) The title of the Copyright Board has been replaced with ‘the Appellate Board’.

Intellectual Property Appellate Board (IPAB) Abolished by Ordinance²

During the month of February, the Tribunal Reforms (Rationalisation and Conditions of Service) Bill 2021 was proposed by the Finance Minister of India to abolish Intellectual Property Appellate Board (IPAB). The Tribunals Reforms Act, 2021, subsequently came into force on the 4th of April, 2021³. Later, through the Tribunals Reforms (Rationalization and Conditions of Service) Ordinance, 2021 IPAB was abolished. Therefore, the Appellate Board for Copyright, Patent, Trademark, Geographical Indication, etc have been replaced by the concerned Commercial Courts and High Courts. Along with IPAB, the Appellate Tribunal under the Cinematograph Act, 1952, the Airport Appellate Tribunal under the Airports Authority of India Act, 1994 and the Plant Varieties Protection Appellate Tribunal under the Protection of Plant Varieties and Farmers’ Rights Act, 2001 have also been abolished.

In furtherance to the same, the Department related Parliamentary Standing Committee on Commerce presented a report titled ‘Review of the Intellectual Property Rights Regime in India’⁴ in which the Committee observed “*that the abolition of a prominent appellate body of IPAB under the Tribunals Reforms (Rationalization and Conditions of Service) Ordinance, 2021 should be reconsidered in wake of its pivotal role in adjudication of IPR appeals and cases.*” The suggestions of the Committee are yet to be deliberated upon by the Parliament.

Patent Amendment Rules, 2021⁵

The Ministry of Commerce and Trade notified the Amendment to the Patent Rules, 2003 which came into force on 21st September, 2021. As per the amendment, “Educational Institutions’ were included in the category of applicants along with natural person, start-up and small entity. Additionally, via a notification dated 23rd September, 2021, educational institutions were granted a rebate of 80% on the fees of patent filing and prosecution⁶.

Delhi High Court: Intellectual Property Rules, 2021

In pursuance to the Tribunal Reforms Act, 2021, the Delhi High Court framed its Intellectual Property Rules, 2021 and published⁷ the draft of the same on October 8, 2021 for public comments⁸. On the same lines, Delhi High Court also published the draft of Delhi High Court Rules Governing Patent Suits, 2021 on October 9,

²IPAB-GazetteNotification-29June2021.pdf (dpiit.gov.in)

³act.pdf (dor.gov.in)

⁴Review of the Intellectual Property Rights Regime in India.pdf - Google Drive

⁵758_1_Patents__Amendment__Rules__2021.pdf (ipindia.gov.in)

⁶<https://pib.gov.in/PressReleasePage.aspx?PRID=1757202>

⁷PublicNotice_ZY7EJQHTR3S.PDF (delhihighcourt.nic.in)

⁸PublicNotice_X4LAEENM3MJ.PDF (delhihighcourt.nic.in)

2021⁹ for public comments¹⁰. The Final Rules for both the matters shall be published after consideration and deliberation on the comments received from the public by December 17, 2021.

POLICY UPDATES

Patent Waiver initiative and India

India and South Africa jointly introduced a proposal for waiver from certain provisions of the TRIPS Agreement for the prevention, containment and treatment of COVID-19 on October 2, 2020¹¹ to the World Trade Organization (WTO). In May, 2021 a revised proposal was submitted to the WTO with 62 co-sponsors including India, African Group, Egypt, Indonesia and South Africa¹². Since then, approximately 120 countries have supported the proposal¹³, including the United States of America¹⁴. The patent waiver proposal was scheduled to be discussed at the 12th Ministerial Conference which was to be held from 30th November, 2021 to December 3rd 2021 in Geneva but the same was postponed due to the new variant scare¹⁵.

CASE LAW UPDATES

“Covishield” for Cutis or SII?

In the case of *Cutis Biotech (Cutis) v. Serum Institute of India (SII)*¹⁶, Cutis filed a suit against SII seeking interim injunction against use of the trademark “Covishield”. The District Court of Nanded rejected Cutis’ application. Cutis then moved on to appeal against the same under the judicature of the Bombay High Court. The Court relied on the facts that neither of the parties were registered proprietors of the mark Covishield and that Cutis had been unable to prove its claim of prior use. Moreover, SII’s use of the mark “Covishield” was more evident than that by Cutis. The Court also held that the use of the mark was different for the parties as the Plaintiff used it for hand sanitizers etc. whereas the Defendant used it for vaccines which were not sold over the counter but were purchased by the Government of India. Keeping all the above mentioned facts in mind, the Bombay High Court refused to grant injunction against Serum Institute of India¹⁷.

Registration of Copyright Societies¹⁸

The Central Government recognized M/s Recorded Music Performance Limited (RMPL) as a Copyright Society under the Copyright Act, 1957 for ‘Sound Recording Works’ via order dated 18.06.2021 by the

⁹ Microsoft Word - Patent Suit Rules_09.12.2021.docx (delhihighcourt.nic.in)

¹⁰ PublicNotice_R42ELBFU0B0.PDF (delhihighcourt.nic.in)

¹¹ directdoc.aspx (wto.org)

¹² directdoc.aspx (wto.org)

¹³ India-SA to revise WTO proposal, US wants patent rights waived ‘only’ for Covid vaccines (theprint.in)

¹⁴ Statement from Ambassador Katherine Tai on the Covid-19 Trips Waiver | United States Trade Representative (ustr.gov)

¹⁵ wto: WTO puts off key Geneva meet over variant concerns - Times of India (indiatimes.com)

¹⁶ *District Court, Nanded Suit No. 1/2020*





¹⁷ Appeal from order No. 53 of 2021

¹⁸ PublicNotice51.pdf (copyright.gov.in)

Department for Promotion of Industry and Internal Trade (DPIIT) under the Ministry of Commerce and Industry.

It may be pertinent to mention herein that the re-registration of Phonographic Performance Limited India (PPL) as a Copyright society under the amended laws is pending before the government¹⁹. The Copyright Act requires the Copyright Societies to re-register within a stipulated time frame. The re-registration application was initially moved by PPL on 09.05.2013. However, by another communication dated 20.05.2014, PPL notified the Registrar of wishing to withdraw the application to re-register which was rejected by the Registrar on 20.11.2014. Relying on the rejection, PPL applied for the re-registration with an amended application on 11.01.2018 which was rejected by the registrar for being filed after the stipulated time frame and also stating that the previous application had been withdrawn. Further, the Delhi High Court in *PPL v. Union of India*, ordered the registrar to reconsider PPL's application of registration. The Court's attention was drawn to the proviso to Section 33(3) of the Copyright Act and Rule 49 of the Copyright Rules, which provide that an application for registration may be rejected inter alia on the ground of existence of another copyright society registered under the Act for administering the same right or set of rights in the specific categories of works. The Court thus stated that in the event the Government is considering any other application for registration in the interim, the applicant will also be informed of the pendency of this matter and the contents of the order²⁰.

The Game of "Pe"

The Plaintiff had prayed for an injunction in the case of *PhonePe Private Limited v. Ezy Services. (BharatPe)*²¹ against the Defendant for the alleged infringement of Phonepe's marks by Bharatpe. The Plaintiff's marks "Phonepe", , **Phoneपे** or , and other formative marks were in use in respect of an online payment portal. The Defendants' marks are ,  and other related formative marks for providing a single QR code on the basis of which UPI based systems, including that of PhonePe, work. The Court held that both the marks were composite marks and they cannot be dissected by segregating the suffix "Pe" and thus the Plaintiff could not claim exclusivity over the suffix "Pe". The Court further held that "Pe" is descriptive in nature being a misspelled version of the English word "Pay". The Delhi High Court therefore denied PhonePe's request to grant an injunction against BharatPe²².

India's first Anti-anti suit injunction

In the case of *Interdigital Technology Corporation (Interdigital) v. Xiaomi Corporation (Xiaomi)*²³, the former filed a suit against the latter on account of alleged infringement of SEPs without appropriate licenses. Interdigital claimed for a permanent injunction against Xiaomi or offered to license its patents to Xiaomi in conformity with FRAND terms. In addition to the present suit, Xiaomi filed a SEP royalty-rate setting suit before the Wuhan Court in China. Consequently, Xiaomi approached the Wuhan Court again to restrain Interdigital from prosecuting the present case before Delhi High Court. The Delhi High Court relied on the fact

¹⁹ PPL V. Union of India, Delhi High Court; WP (C) 5735/2021

²⁰ delhihighcourt.nic.in/dhcqrydisp_o.asp?pn=118036&yr=2021

²¹ CS(COMM) 292/2019

²² Microsoft Word - PhonePe v Ezy Services (3).doc (livelaw.in)

²³ CS(COMM) 295/ 2020, 296/2020; Delhi High Court

that cause of action arose in India as the proceedings were precisely about the infringement of six specific Indian Patents and granted an Anti-anti-suit injunction against the orders of the Wuhan Court for not conforming to the principles of Comity and granted its first anti-enforcement injunction in favour of Inter digital. Eventually, the parties mutually agreed to withdraw the suit on 15.11.2021.

Only Copyright Societies to issue licenses

In the cases of *M/s Novex Communications Pvt. Ltd. v. DXC Technology Pvt. Ltd.*²⁴ and *M/s Novex Communications Pvt. Ltd v. Cognizant Technologies Solutions India Pvt. Ltd.*²⁵, the common plaintiff to both the suits was engaged in the business of protection of copyright subsisting in sound recording of various film songs, in their capacity as an assignee, licensee or authorised agent of various copyright holders. The issue raised by the plaintiff was that the defendants without obtaining the requisite license from the plaintiffs by paying fees, played songs at the events conducted by them. The Defendants argued that the plaintiff was neither a copyright society nor a member of copyright society, and therefore cannot grant any license or claim license fee in terms of section 33 of the Copyright Act, 1957.

The Court after referring to various legislations and judgments observed “*it is not in dispute that the plaintiff in the two suits is in the business of issuing licenses for on ground performance rights in various sound recordings, and that they do not fall within the meaning of a copyright society under Section 33.*”²⁶ Court held that Plaintiff is statutorily barred from issuing license therefore the relief of injunction and damages claimed in the two suits cannot be granted and the plaintiff in each suit is directed to pay Rs. 1,00,000 each to both the defendants.

Alleged infringement of Trade Dress

In the cases of *Britannia Industries Ltd. v. ITC*²⁷ and *Intercontinental Great Brands LLC v. Sumo Biscuits Pvt. Ltd.*²⁸, the Delhi High Court dealt with matters of Trade Dress infringement.

In the former case, the Court observed that the packaging of the Plaintiff’s goods and that of the Defendant are not so similar so as to be likely to result in deception or confusion. The distinguishing features counterbalance the similarities and negate any possibility of confusion, for instance the brand names of both the Parties, i.e., “Sunfeast Farmlite Digestive” and “Britannia Nutri Choice Digestive” and the mere representation of biscuits with sheaves of wheat below them was considered to be totally insufficient lead to confusion or deception. Consequently, the Court denied grant of injunction against the Defendant and Britannia’s application was rejected.

²⁴ CS(COMM) 407 of 2020; Madras High Court

²⁵ CS(COMM) 413 of 2020; Madras High Court

²⁶ 621685 (tn.gov.in)

²⁷ CS(COMM)553/2020; Delhi High Court and 554/2020

²⁸ CS(COMM) 286/2021;



Copyright in Scientific Research Papers: Open to all or a paid luxury?

The Delhi High Court faces the dilemma of deciding the extent of accessibility of research papers in the case of *Elsevier Ltd. (Plaintiff) and Ors. v. Alexandra Elbakyan and Ors. (Defendant)*²⁹. The Plaintiff approached the Court alleging that the Defendant has been infringing their Copyright in relation to various medical journals, articles and other scientific papers that are available on the Plaintiff's website by providing the same on the Defendant's website free of cost in some form or the other since the year 2011. In furtherance to the same, the Delhi High Court allowed applications for intervention from the Society for Knowledge Commons, the Delhi Science Forum and a group of scientists from various fields. The Plaintiffs have prayed for a dynamic injunction against the Defendants on the alleged "rogue websites". The understanding between the two parties that no new articles or publications in which the Plaintiff have copyright will be uploaded or made available by the Defendant via the internet, shall be upheld by the Defendant during the pendency of the suit.

Trademark in Real Estate

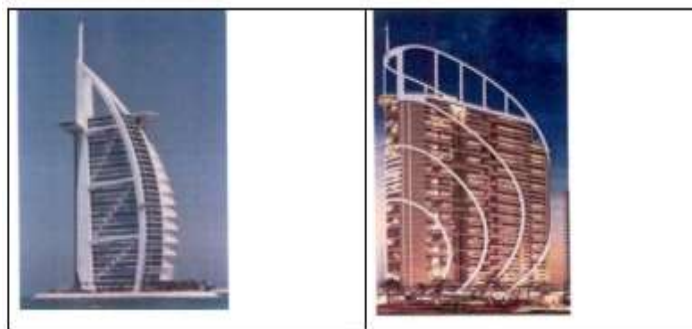
In the case of *Jumeirah Beach Resort LLC v. Designarch Consultants Pvt. Ltd.*³⁰ the Delhi High Court protected the rights of the Plaintiff connected to their Flagship Hotel – Burj Al Arab during the pendency of the proceeding by granting an *ad interim injunction* against the Defendant. The Court relied on the Plaintiff's claim that the Plaintiff's is a well-known mark. The Court also observed that *prima facie*, the Defendant's trademarks are deceptively similar to the marks of the Plaintiff and that the essential features of the trade mark of the Plaintiff have *prima facie* been copied.

²⁹CS(COMM) 572/2020; Delhi High Court

³⁰CS(COMM) 124/ 2021; Delhi High Court

IP FERVOUR

Plaintiff's Prior BURJ Marks	Defendants' Impugned Marks
BURJ/Burj Al Arab/BURJ AL ARAB	THEBURJ/BURJNOIDA/Burj Noida
www.burjalarab.com	www.burjnoida.com



The Defendant was restrained from using the marks “BURJBANGALORE”, “BURJMUMBAI”, “BURJDELHI”, “BURJGURUGRAM” and “BURJGURGAON” for future real estate projects since the Plaintiff was able to make a clear prima facie case in favour of its mark “BURJ”. However, the court also held that it would not be appropriate to restrain the defendant from using the trade mark “BURJNOIDA” since the Project has already been under construction since 2010³¹.

³¹jan09112021sc1242021132840-403700.pdf (livelaw.in)

Restricting the Counterfeiters

The Bombay High Court has taken a strict stand against the Counterfeiters in cases such as *Hindustan Unilever Limited v. Vansh Cosmetic and Anr*³². and *Prince Pipes & Fittings v. Prince Platinum Pipes & Fittings*³³.

In the case of *Hindustan Unilever Limited v. Vansh Cosmetic and Anr.*, the Court observed that the similarity between the Plaintiff's mark "LAKME" and the Defendant's marks and packaging could not have been a matter of coincidence and therefore, there was an overwhelming prima facie case in favour of the Plaintiff for the infringement of their Trademarks and Copyright and not granting them relief would cause them irreparable loss, harm and injury.

In the case of *Prince Pipes & Fittings v. Prince Platinum Pipes & Fittings*, the Defendant also undertook on record to refrain from using domain name that infringes the rights of the Plaintiff, i.e., www.princeplatinumplastindia.com along with the impugned trademark "PRINCE/ PRINCE PIPES" and other deceptively similar marks.

In both the cases, the Bombay High Court appointed a Court Receiver as receiver of the Defendants' counterfeit goods that infringe the Plaintiffs' rights including the goods already manufactured bearing marks that are deceptively similar to that of the Plaintiff's marks including any advertising material, labels, pamphlets, etc.

Sony Pictures tussles with Copyright Infringers off the Sports field

For Tokyo Olympics 2020, Sony Pictures (Sony) acquired exclusive rights to broadcast the games in India, Pakistan, Sri Lanka, Nepal, Bangladesh, Bhutan and Maldives from the International Olympics Committee. The Delhi High Court granted the injunction in favour of Sony Pictures restricting approximately 47 'rogue' websites.

In another instance, Sony Pictures filed a suit against a group of defendants for reproducing, making available, distributing, broadcasting, etc. of the cricket matches of India's tour of England and Sri Lanka³⁴. The Delhi High Court granted the injunction in favour of the infringing websites and portals along with several Multiple System Operators and cable operators. The Court also ordered the ISPs to block the infringing websites.

Raid, seizure and injunction

In the case of *Ferrero Spa & Ors. (Plaintiff) v. M.B. Enterprises (Defendant)*³⁵, the Defendant's premises was raided by the Food Safety Officers from the Office of the Food & Drug Administration, Thane in October 2021. The Officers found incriminating evidence of manufacture of hazelnut cocoa spread under the Plaintiff's mark NUTELLA. On receiving the notice of the said seizure of goods, the Plaintiff informed the Officers that the Defendant was in no way connected to the Plaintiff and had been illegally manufacturing the goods under their

³² COMMIP 15634/2021; Bombay High Court

³³ COMMIP 5286/2021; Bombay High Court

³⁴ CS(COMM) 289/2021; Delhi High Court

³⁵ CS(COMM) 593/2021; Delhi High Court

trademark and then moved to Court for the present case. The Court, therefore, keeping in mind the findings of the FDA Officers, granted an ex-parte injunction against the Defendants.

Disparaging reference to Competitors' product

A suit was filed in the Delhi High Court by Reckitt Benckiser India Private Limited (Plaintiff) seeking a permanent injunction to restrain Hindustan Unilever Limited (Defendant) from telecasting or broadcasting five advertisements for its toilet cleaner DOMEX which allegedly was tarnishing the goodwill and reputation of the Plaintiff and its products under the mark HARPIC³⁶. While examining the comparative advertising principles, it was observed by the Court that any advertisement issued must not be untrue, misleading, unfair, or deceptive.

The court in its decision determined that the Defendant's first out of the five advertisements merely said that DOMEX was a superior option and did not degrade, disparage, or misrepresent the plaintiff's goods. Concerning the remaining four advertisements, the court found that the shape of the bottle used by the Defendant in these advertisements, claiming such bottle to be an ordinary toilet cleaner without providing any proof or evidence of such statement or depiction, was deceptively similar to the Plaintiff's registered mark. As a result, the court determined that these advertising intended to degrade, denigrate, and malign the Plaintiff's product and issued an order prohibiting the Defendant from posting these four commercials.

Well-known marks and cross class protection

In the case of *Britannia Industries Ltd. v. Good day Oral Care*³⁷ the Delhi High Court ruled in favour of the Plaintiff and granted an *ad interim* injunction against the Defendant for use of the mark "Good Day" and related formative marks for oral care. The Court relied on IPAB's acknowledgment of the Plaintiff's mark as being well-known and therefore, a cross-class protection was granted to the Plaintiff's marks. Consequently, the Court restricted the partners, proprietors, companies, sister concerns, directors, executives, as the case may be, its officers, servants and agents, assignees or anyone else acting for/and on their behalf from launching, selling (physically or on online platforms), manufacturing, advertising/ marketing (in all media whatsoever, including but not limited to electronic media, social media, broadcast media and/or print media), offering for sale (physically or on online platforms) or in any manner dealing in goods, including but not limited to toothpastes and/or such allied and/or cognate goods bearing the impugned mark "GOOD DAY" and its related formative marks along with suspension of the domain name incorporating the impugned mark, www.gooddayoralcare.com.



³⁶ CS(COMM) 340/2021

³⁷ CS(COMM) 572/2021

India's Khadi gains Global recognition³⁸

The Khadi and Village Industries Commission (KVIC) has added Bhutan, UAE and Mexico to the list of countries where the brand Khadi is recognized. It was already a registered Trademark in 6 countries including Germany, UK, Russia, China and EU. In addition to these, KVIC's applications are pending in about 40 more countries including USA, Italy, Japan and Brazil.

Geographical Indication Tags awarded in 2021³⁹

In the year 2021, approximately 46 new Geographical Indication (GI) tags have been granted including to Sojat Mehndi (Rajasthan), Judima (Assam), HarmalChilli (Goa), Mau Saree (UP) from within the Country and Toscano (Italy), Chios Mastiha (Greece), Zateckychmel (Czech Republic) and Muchener Bier from abroad, to name a few.

And Then There Were None

In the case of *Agatha Christie Limited v. Registrar of Trademarks*⁴⁰ the Plaintiff filed an application for the registration of trademark for the most famous work and one of the top selling books of Agatha Christie, "AND THEN THERE WERE NONE", under classes 9, 11 and 41 at the Indian Trademark Office.

After the preliminary examination, the Registrar raised the objection that the said mark was non-distinctive and as such was not capable of distinguishing the goods or services of one person from those of others. A hearing was appointed in the matter before the Registrar and even after hearing the contentions of the Plaintiff, the said mark was refused.

The Plaintiff then filed an appeal before the Delhi High Court against the Registrar's order. The Court while allowing the appeal and quashing the impugned order of the Registrar observed that "*the right to register a mark under which one intends to provide good or services is a valuable right, partaking of the character of Article 19(1)(g) of the Constitution of India. Any decision not to allow registration of a mark has, therefore, to be informed by reasons which should be apparent on the face of the decision*".

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³⁸<https://pib.gov.in/PressReleasePage.aspx?PRID=1734415>

³⁹Microsoft Word - Year wise GI Application Register 12-11-2021 - new.doc (ipindia.gov.in)

⁴⁰C.A.(COMM.IPD-TM) 10/2021

⁴¹A special thanks to our interns Md. Maaz Alam and Sakshi Choudhary for their contribution towards this Newsletter.