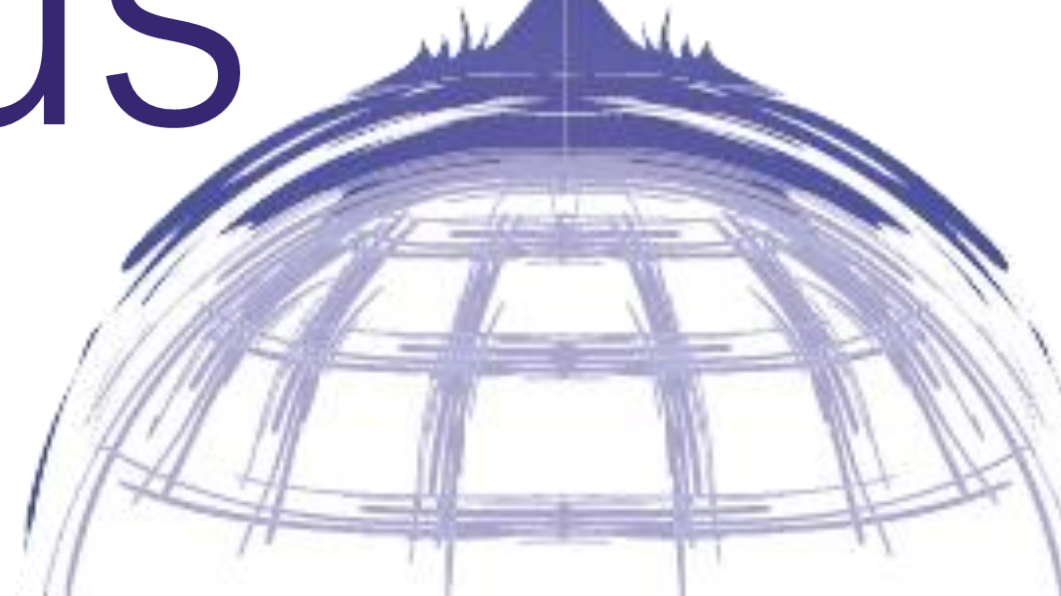


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Article

Patentability of Selection Inventions – Analysis of recent Delhi High Court decisions

By Gursimran Narula and Vindhya S Mani

The article in this issue of IPR Amicus analyses two decisions of the Delhi High Court which have adjudicated patentability of the species patent with respect to the genus patent as part of infringement proceedings. The Court in one of the case specifically disapproved the existence of dichotomy between the terms 'coverage' and 'disclosure', and stated that when a product is covered in the genus patent, the specific disclosure of the same is immaterial and the patentee cannot claim the same product in the species patent. However, granting interim injunction to the patentee who sought to enforce their species patent, the Court in a different decision acknowledged the distinction between 'coverage' and 'disclosure' and clarified that to 'disclose' the species patent, the genus patent must teach a person skilled in the art 'how to reach' the species patent. According to the authors, with the constitution of the IP Division in the Madras High Court, it will be interesting to see how other High Courts in the country adjudicate patentability of selection inventions.

Patentability of Selection Inventions – Analysis of recent Delhi High Court decisions

By Gursimran Narula and Vindhya S Mani

Patentability of 'Selection Inventions' has been a hotly contested issue in India, especially in the context of pharmaceutical inventions. A selection patent is one whose subject matter (compounds or compositions) forms part of a larger known class or Markush structure of compounds which is the subject matter of a prior patent. A selection patent, referred to as species patent, has a specific coverage while the prior patent, referred to as genus patent, has a broader coverage. Recently, two decisions of the Delhi High Court have adjudicated patentability of the species patent with respect to the genus patent as part of infringement proceedings.

First, the Single Judge in *Boehringer Ingelheim Pharma GmbH v. Vee Excel Drugs and Pharmaceuticals Pvt Ltd & Ors*¹, vide Order dated 29 March 2023, denied injunctive relief to the patentee, and held that a *prima facie* case for invalidity of the species patent is made out. The Court specifically disapproved the existence of dichotomy between the terms 'coverage' and 'disclosure' stating that when a product is covered in the genus patent, the specific disclosure of the same is immaterial and the patentee cannot claim the same product in the species patent. Interestingly, a co-ordinate bench in *Novartis AG & Anr v. Natco Pharma Limited*², vide Order

dated 9 January 2023, granted an interim injunction to the patentee who sought to enforce their species patent. The Court in *Novartis* acknowledged the distinction between 'coverage' and 'disclosure' and clarified that to 'disclose' the species patent, the genus patent must teach a person skilled in the art 'how to reach' the species patent. In other words, the absence of an enabling disclosure i.e., mere coverage would not suffice for purposes of disclosure.

*Boehringer Ingelheim Pharma GMBH & Co v. Vee Excel Drugs and Pharmaceuticals Pvt. Ltd. & Ors*³

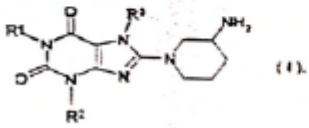
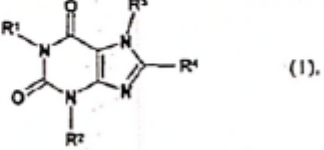
The Plaintiff (Boehringer) filed six suits against various drug manufacturers seeking injunction against manufacturing of Linagliptin, a drug to treat Type 2 diabetes for which the Plaintiff secured patents. The Plaintiff asserted their patents IN'227719 i.e., genus patent ('IN'719') and IN'243301 i.e., species patent ('IN'301') in two of the six suits i.e., CS(COMM) 239/2019 and CS(COMM) 240/2019. The Plaintiff filed four more suits i.e., CS (COMM) 236/2022, CS (COMM) 237/2022, CS (COMM) 238/2022 and CS

¹ 2023 SCC OnLine Del 1889

² 2023 SCC OnLine Del 106

³ Supra 1

(COMM) 296/2022 after the expiry of IN'719 on 21 February 2022. The Defendants in turn raised the defense of invalidity against enforcement of IN'301 on the grounds of double patenting and evergreening. The Defendants strenuously relied upon the disclosures in IN'719 to assert that IN'301 was disclosed in IN'719. The Defendants relied upon Plaintiff's response to the First Examination Report before the Indian Patent Office during the prosecution of IN'719, whereby the Plaintiff identified Linagliptin as one of the 371 examples possible from the claimed Markush formula in IN'719. On the contrary, the Plaintiff asserted that Linagliptin was specifically claimed only in IN'301 and the same was never claimed in IN'719, rather it was merely covered by the Markush structure of IN'719. The Single Judge disapproved the contention of the Plaintiff and held that the IN'301 was prior claimed in IN'719 relying upon the test of 'Substantial structural similarity' between the compounds claimed in IN'301 and IN'710 as shown below.

IN '301 [Suit Patent]	IN '719 [Genus Patent]
Claim 1 of the 301 patent is itself a genus/class of compounds approximately covering 22 alternatives (excluding isomers, tautomers etc.) of the following structure:	Claim 1 of the earlier 719 patent is also a genus/class of compounds but of a much larger size having the following structure:
	

⁴ 2021 SCC OnLine Del 3746

The Single Judge relied upon the Division Bench decision in *AstraZeneca AB and Ors v. Intas Pharmaceuticals Ltd and Ors*⁴ tracing the factual similarity with the matter at hand. The Court noted that like *AstraZeneca (supra)*, the present case also involves a simultaneous assertion of species and genus patents. Further, the Court observed that the Plaintiff in the present case also asserts that the selection invention was not disclosed by the genus patent where the genus patent claimed a Markush structure akin to *AstraZeneca (supra)*. The Court held that it has been settled in *AstraZeneca (supra)* that once a patentee claims infringement of an earlier genus patent in respect of a product, it necessarily follows that the said product was the subject matter of an earlier genus patent. It was held that if one of the permutations in the Markush patent includes the product in question, the said product would form part of the inventive concept of the earlier patent and cannot be claimed again as an inventive concept in a subsequent patent. The Court also heavily relied upon similarities in the 'Statement of working' i.e., Form 27 filed by the patentee in the genus and the species patent, noting that the said submissions made it amply clear that both the patents covered the same product.

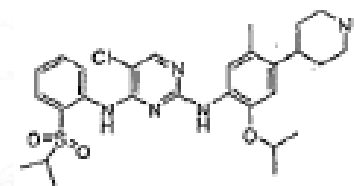
*Novartis AG & Anr v. Natco Pharma Limited*⁵

In this matter, the Plaintiff (Novartis AG) approached the Court seeking injunctive relief against the Defendant (Natco Pharma Limited) for Infringement of its Indian Patent No. IN 276026 ('IN'026'). The IN'026 concerned a drug named 'Ceritinib', having molecular formula C₂₈H₃₆ClN₅O (5-chloro-N²-{5-methyl-

⁵ Supra 2

4(piperidin-4-yl)-2-[(propan-2-yl)oxy]phenyl)-N⁴=[2-(propane-2-sulfonyl)phenyl]pyrimidine-2,4-diamine), which was developed by the Plaintiff as an alternative to an existing compound, Crizotinib, an Anaplastic Lymphoma Kinase ('ALK') inhibitor which was found to be effective in the treatment of lung cancer. It is known that ALK is an oncogene which promotes progression and metastasis of lung cancer. It is pertinent to note that the Defendant did not deny manufacturing of Ceritinib which was protected by IN'026 rather stated that IN'026 was *prima facie* invalid for lack of novelty and inventive step in view of its existing genus patents namely (i) Novartis' own patents IN 252653 ('IN'653') and IN 240560 ('IN'560'), (ii) AstraZeneca's patent US 7153964 ('AstraZeneca Patent') and (iii) Rigel Pharmaceuticals Patents US 8188276, US 8835430, US 9416112 and US 9018204 ('Rigel Patents').

The Plaintiff, on the other hand asserted that Ceritinib was novel and inventive as it was an ALK inhibitor which substantially reduced toxicity of already existing Crizotinib. The Plaintiff also emphasized the following three inventive features of IN'026 which were lacking in the prior art documents cited by the Defendant. The said features include: (i) the core novel pyrimidine moiety with two phenyl rings attached to the pyrimidine ring at its second and fourth position via amine groups, (ii) the phenyl group attached to the pyrimidine ring at the second position being tri-substituted and (iii) a substitution being a heterocyclic pyrrolidinyl, piperidinyl or an azetidiny ring, linked to the phenyl ring by a carbon-to-carbon linkage.



5-chloro-N²-(2-isopropoxy-5-methyl-4-(piperidin-4-yl)phenyl)-N⁴-[2-(propane-2-sulfonyl)-phenyl]-pyrimidine-2,4-diamine "

(Molecular structure of Ceritinib as claimed in Claim 4 of IN'026)

The Defendant submitted that the Markush structure under Claim 1 and Ceritinib compound claimed under Claim 4 of the species patent was encompassed in the Markush Claim 1 of IN'653. Further, the Defendant submitted that the compound Ceritinib was also a subject matter of IN'560. The Defendant also asserted that the species patent was covered and already claimed by AstraZeneca patent and Rigel Patents.

The Court dismissed the Defendant's challenge as to lack of novelty and inventive step of the species patent by placing reliance on *Pfizer Inc. v. Teva Pharmaceuticals*⁶ which held that '*a patent challenger however must demonstrate the selection of a lead compound based on its promising and useful properties, not a hindsight driven search for structurally similar compounds*'. The Single Judge held that the Defendant was unable to demonstrate that Claim 1 of IN'026 and Ceritinib i.e., claimed under Claim 4 of the species patent, was specifically claimed by any prior art document. The Court also observed that the Defendant is a person who has foreknowledge of the species patent, and the Defendant

⁶ 410 F.3d. 1358

has resorted to a hindsight analysis by cherry-picking substituents from prior art documents. It was further held that the Defendant could not demonstrate through the cited prior art documents about the key inventive feature of the suit patent i.e., the linkage between the heterocyclic ring with N² – phenyl by a carbo-carbon bond and thus was driven by a hindsight approach in identifying and selecting various substituents. The Court held that ‘Certinib’ certainly involved an inventive step over the prior knowledge i.e., ‘Crizotinib’ as ‘Certinib’ acted in ‘Crizotinib’ resistant cases and exhibited much longer effects than ‘Crizotinib’ in addition to reducing toxicity involved with ‘Crizotinib’. Lastly, the Court also endorsed the view that ‘Certinib’ was not synthesized before the grant of the suit patent through any other patent by any other person, which by itself is a strong indication towards the suit patent having been not disclosed in any prior publication.

Conclusion

It is important to note that the decisions of the co-ordinate benches in *Boehringer* and *Novartis* were with respect to different factual circumstances. In *Boehringer*, the Court relied upon admissions of the patentee with respect to Linagliptin, in the patentee’s response to the First Examination Report issued for the genus patent and considered the declaration under Form 27. In *Novartis*, admissions during the prosecution history were not in contention. The Court in *Novartis*, while assessing the challenge to the novelty of the species patent relied upon the finding of the

Controller of the Patents and subsequent affirmation of the erstwhile Intellectual Property Appellate Board (IPAB), that there is no structural similarity between the species and the genus patent.

However, it is noteworthy, that the co-ordinate benches appear to have taken divergent views with regards to interpretation of the expression ‘coverage’ and ‘disclosure’ in view of the Supreme Court’s observation in *Novartis v. Union of India*⁷ whereby the Apex Court noted that ‘We certainly do not wish the law of patent in this country to develop on lines where there may be a vast gap between the coverage and the disclosure under the patent’. The Single Judge in *Boehringer* rejected any differentiation between the expression ‘coverage’ and ‘disclosure’, noting that both the expressions meant the same thing. Whereas the Court in *Novartis* held that a ‘wide gap’ between coverage of a patent, and what is disclosed therein, was not to be encouraged. What matters is disclosure. If the claim in a specie patent is disclosed in the genus patent, the specie patent stands invalidated thereby. Disclosure must be enabling; it must enable a person skilled in the art to reach the invention claimed in the specie patent from the teachings in the genus patent.

With the constitution of the IP Division in the Madras High Court, it will be interesting to see how other High Courts in the country adjudicate patentability of selection inventions.

[The authors are Associate and Associate Partner, in IPR practice at Lakshmikumaran & Sridharan in New Delhi and Bengaluru, respectively]

⁷ (2013) 6 SCC 1.



Ratio Decidendi

- Trademarks – Prior use – Date of registration and not use, when relevant – Delhi High Court
- Designs – Differences with prior art – Differences in utility of product also to be considered – Delhi High Court
- Patents – Subject matter is patentable if there is synergistic combination or a working interrelation which produces a new and improved result – Delhi High Court
- Standard Essential Patent owners can pray for interim and final injunctive relief – Four-fold test for admission of infringement, as laid down in Nokia case, not as per law – Delhi High Court
- Trademarks – Confusion in use of acronym 'ICAI' – Mark infringing if 'initial interest confusion' present – Delhi High Court

Trademarks – Prior use – Date of registration and not use, when relevant


Taking note of Section 34 of the Trade Marks Act, 1999, the Delhi High Court has held that the relevant date for the purpose of establishing prior use, in the dispute, would be the 'date of registration' of the mark and not when the Plaintiff actually started using it. It noted that the Plaintiff had initiated the registration process on 16 June 2018 while the Defendants started the commercial operations using their mark in September 2018, which was though earlier than the Plaintiff's use in January 2019 but, was later than the date of registration of the Plaintiff's mark.

The Court hence answered in negative the question as to whether the rights of a registered proprietor, who acquired registration for a mark planned for future utilisation, can be nullified by someone who deployed a similar mark after the registration date, but prior to the date of actual use of the registered proprietor.

The High Court was also of the view that the Defendants' adoption and use of the impugned mark 'WORKNESTS' subsequent to Plaintiff's registration will not override the Plaintiffs' statutory rights. It observed that otherwise, it would result in anomaly and permit any person to start using a similar/ identical mark at any time after the registered proprietor's mark is advertised, and before registration is granted. According to the Court, a person who adopts deceptively similar or identical mark within this timeframe cannot be accepted as a prior user and accorded preferential rights.

In this dispute involving confusion among the marks (combination of a word mark 'worknest' and a symbol W)



and , which again had word 'Worknests', the High Court also held that the word 'WORKNEST' emerges as the distinctive feature, holding prominence, and thus, is a brand-identifier. The Court was hence of the view that the marks were identical, except with the difference of addition of the letter 'S' at the end of Defendants' mark, which was not sufficient for distinguishing the challenged mark from that of Plaintiffs'. According to the Court, dissimilarities in isolated facets of the marks, including the logos, were insignificant and immaterial. It also observed that the likelihood of confusion was further fortified by the fact that services offered by parties under their respective marks (renting of co-working spaces and other real estate services), were also identical.

Granting injunction in favour of the Plaintiff, the Court also rejected the Defendant's plea of *bona fide* and honest use. [*Worknest Business Centre LLP v. Ms Worknests* – Judgement dated 21 March 2023 in CS(COMM) 406/2020, Delhi High Court]

Designs – Differences with prior art – Differences in utility of product also to be considered

The Delhi High Court has held that in examining whether the differences between the suit design and prior art are sufficient to impart novelty to the suit design, or are merely in the nature of

trade variants, the Court must keep in mind two important factors – First, is the reason for which the Controller of Designs has, while granting certification to the suit design, regarded the suit design as novel, and second, is the purpose to which the article is to be put.

According to the Court, the extent to which the differences in prior art and the suit design would make a difference to the utility of the product has also to be borne in mind, even though the definition of 'design', in Section 2(d) of the Designs Act, is not with respect to the utility of the product to which the design pertains, but reflects, instead, the features of the design which appeal to the eye. It, further in this regard observed that where a design is utilitarian, it is possible that the differences *vis-a-vis* prior art, though minor on a visual inspection, may be substantial where the utility of the product is concerned.

Rejecting the contention of the Defendant that the suit design was merely a trade variant of the prior art, the Court also observed that in the absence of evidence to the contrary, a certificate of granting registration to a design must be treated as *prima facie* evidence of validity of the design, though the Designs Act does not contain any provision analogous to Section 31 of the Trade Marks Act deeming registration of design to be *prima facie* proof of its validity. [*Sirona Hygiene Private Limited v. Amazon Seller Services Private Limited* – Judgement dated 14 March 2023 in CS(COMM) 503/2022, Delhi High Court]

Patents – Subject matter is patentable if there is synergistic combination or a working interrelation which produces a new and improved result

The Delhi High Court has held that the subject matter is patentable if there is a synergistic combination or a working interrelation which produces a new and improved result. In the opinion of the Court, the subject patent, involving air decontamination assembly, was not a mere addition to a well-known combination, but had some new features and were an improvement in the method which had brought in greater efficiency. The question before the Court was whether the combining of the features in one prior art on the one hand along with features in the other 2 prior arts was obvious to a person skilled in the art.

Allowing the grant of patent for an invention of an air purification filter that attracts the pathogens to a filter media, binds them, chemically ruptures their cellular enclosures and destroys the pathogens, while using biocide coated polymeric microfibers in a filter media along with a voltage generator, the Court observed that the subject invention had made various modifications over the existing devices/apparatus in terms of providing specific electric fields, specific gap between the conducting plates and use of multiple plates within a decontamination unit. The High Court noted

that though the fundamental principles on which the decontamination device worked may be the same, the fact that the increased electric field resulted in reduction of the airborne bacterial load and that too with low power consumption and in a compact manner, would make the subject device not obvious to a person skilled in the art.

The High Court also observed that secondary considerations by themselves may not qualify an invention to become patentable but when a set of old results are combined in a new and profitable manner, a patent can be granted. [*Biomoneta Research Pvt. Ltd. v. Controller General of Patents Designs – Judgement dated 13 March 2023 in C.A.(COMM.IPD-PAT) 297/2022, Delhi High Court*]

Standard Essential Patent owners can pray for interim and final injunctive relief – Four-fold test for admission of infringement, as laid down in Nokia case, not as per law

A Division Bench of the Delhi High Court has held that Standard Essential Patent owners, who file lawsuits, can pray for interim and final injunctive relief if an infringer is deemed by a Court to be an 'unwilling licensee,' often as indicated by the use of 'stalling' and other opportunistic bargaining and litigation tactics. The Court also observed that there is no prohibition in Indian law against a Standard Essential Patentee from seeking an injunction. Observing that there was near uniformity of judicial opinion in multiple

jurisdictions, on the issue, the Court noted that if Standard Essential Patent owners are flatly precluded from seeking injunctions, then infringers would have little reason ever to agree to, or negotiate in good faith, a licence with a Standard Essential Patent owner. The High Court hence rejected the argument that it should not grant an injunction or pass a direction to pay, since the Standard Essential Patent owner's only interest is in obtaining reasonable royalties, an interest which can be fully recognised by an award of damages at the end of the trial.

The High Court also held that the four-fold test as laid down the Single Judge Bench of the Court in the decision *Nokia Technologies OY v. Guangdong Oppo Mobile Telecommunications Corp. Ltd. & Ors.* was contrary to law. According to the Division Bench, the Single Judge in *Nokia v. Oppo* set an impossibly high bar for admission in a case of Standard Essential Patent infringement, i.e., there has to be an unequivocal admission on (i) essentiality and validity of the suit patents (ii) fact of utilization (iii) fact that such utilization, absent payment of liability, would amount to infringement (iv) that the royalty rate proposed by the Plaintiff was FRAND. The Court observed that if there was an unequivocal admission on all four counts, there would be no necessity to file a suit for infringement at all and otherwise also, same would mean seeking/passing of a final decree at the interim stage. In the opinion of the Court, the four-fold test casts an onerous burden upon the Standard Essential Patentee and that too at the interim stage itself. [*Intex Technologies (India) Ltd. v. Telefonaktiebolaget L M Ericsson – Judgement dated 29 March 2023 in FAO(OS) (COMM) 296/2018, Delhi High Court*]

Trademarks – Confusion in use of acronym 'ICAI' – Mark infringing if 'initial interest confusion' present

In an interesting case where the Institute of Chartered Accountants of India sought an injunction against the Institute of Cost Accountants of India (Defendant) from using the 'ICAI' acronym in any manner whatsoever, the Delhi High Court has held that the case justifies *prima facie* finding of likelihood of confusion on the part of the public, by the use of ICAI mark (acronym) by the Defendant, by operation of Section 29(3) read with Section 29(2)(c) of the Trade Marks Act, 1999.

Observing that 'confusion', despite being the most omniscient concept in the Trade Marks Act, is not defined therein, the Court proceeded on basis of initial interest confusion, and held that if because of the use of the impugned mark by the Defendant, the initial interest of the person viewing the mark is kindled, the mark is infringing in nature. According to the Court, it is immaterial that even shortly thereafter the viewer is disabused of the said initial impression. It, hence, was of the view that it (initial interest) would

suffice as 'confusion' within the meaning of Section 29(2) of the Trade Marks Act.

Noting that the Plaintiff and the Defendant were using identical marks, i.e., ICAI, in respect of identical services, namely the imparting of education and providing of training, the Court held that in the absence of any other distinguishing feature, the marks by themselves are bound to create confusion in the perception of the observer who observes them.

The High Court in this regard also rejected the contention of the Defendant that the Plaintiff deserves to be non-suited on the ground of delay or acquiescence. It also observed that Section 30(1) does not apply as the Defendant does not seek to contend that, by using the impugned ICAI acronym, it is seeking to identify the services provided by it as those provided by the Plaintiff. It was held that the case fell within the four corners of Section 29(2)(c) read with Section 29(3) of the Trade Marks Act, and hence the prayer for interim injunction has necessarily to be allowed. [*Institute of Chartered Accountants of India v. Institute of Cost Accountants of India* – Judgement dated 21 March 2023 in CS(COMM) 271/2021, Delhi High Court]



News Nuggets

- No abandonment of trademark under Section 21(2) in absence of evidence of notice of opposition being served on applicant
- Trademark rectification proceedings – Civil contractual rights can be examined
- Alternative remedy – Mere delay or expense cannot constitute justifiable ground for Court to entertain writ petition
- Trademarks – No deceptive similarity merely by having Sun in the backdrop
- 'FECONTIN-F' and 'FEMICONTIN' are not deceptively similar, either visually or phonetically

No abandonment of trademark under Section 21(2) in absence of evidence of notice of opposition being served on applicant

In a case where there was no proof of any service of the notice of opposition to the registration of trademark of the Appellant-Applicant, having been effected on the Appellant in the manner envisaged by the Trade Marks Rules, 2017, the Delhi High Court has held that invoking of Section 21(2) of the Trade Marks Act, 1999 was not correct. Section 21(2) deems an Applicant, who has applied for registration of a trademark, to have abandoned the application, if he fails to file a counterstatement in response to the notice of opposition within two months from the date of receipt, by him, of such notice of opposition. The Court in *Purushottam Singhal Proprietor Ms. Prime Cable Industries v. Registrar of Trade Marks* [Judgement dated 20 March 2023] opined that in view of the severe consequence of the inaction envisaged by Section 21(2), the provision must be strictly construed. According to the Court, there must be positive evidence of (i) service of notice on the applicant, seeking registration of a trademark, of the copy of the notice of opposition and (ii) failure, by the applicant, to send a counterstatement, in response to the opposition, within two months therefrom.

Trademark rectification proceedings – Civil contractual rights can be examined

The Delhi High Court has rejected the contention that in trademark rectification proceedings, the Court or the authority adjudicating

the matter cannot examine civil contractual rights. Observing that the submission was in the teeth of Section 18 of the Trade Marks Act which requires any application for registration of a mark to be made by the proprietor of the mark, the Court noted that examination of the existence or otherwise of proprietary rights would, in most cases, involve examination of contractual provisions. According to the Court, a person questioning the validity of the registration of the mark in favour of another, can always base the challenge on the lack of proprietary rights of such other person to the mark which stands registered in his favour. The High Court in *V.R. Holdings v. Hero Investcorp Limited* also observed that Section 57 of the Trade Marks Act does not, in any manner, fetter or restrict the scope of inquiry or investigation which the Court, approached under the said provision, is empowered to undertake.

Alternative remedy – Mere delay or expense cannot constitute justifiable ground for Court to entertain writ petition

The Delhi High Court has held that the Court while entertaining writ jurisdiction under Article 226 of the Constitution must not presume too easily that the reliefs provided under the statute are inadequate or not efficacious. Further, according to the Court, mere delay or expense, cannot constitute justifiable ground for the Court to provide succour under Article 226. In this case the trademark oppositions filed by the petitioner were pending, and the Petitioner, while seeking a direction to the Registrar to withdraw the acceptance of various trademarks, had contended that opposition proceedings take considerable time. Relying on

Supreme Court decision in the case of *Varimadugu Obi Reddy v. B. Sreenivasulu*, the Court in *Kaira District Cooperative Milk Producers Union Ltd. v. Registrar of Trademarks* [Judgement dated 22 March 2023] observed that exhaustion of the alternative remedy, classically and etymologically, cannot be said to have taken place either before the alternative remedy has been availed, or even while the alternative remedy is pending. According to the Court, even in such cases, the appropriate remedy for a writ court to grant would only be to expedite the alternative remedy proceeding, and not to arrogate, to itself, the jurisdiction of the authority in *seisin* thereof.

Trademarks – No deceptive similarity merely by having Sun in the backdrop

The Delhi High Court has held that, *prima facie*, there is no deceptive similarity between the words 'DR. FIXIT' and the words 'MR. ENGINEER'. The Court also observed that it cannot be said that merely because the Defendant has also used the image of a man with a construction helmet, it would lead to a conclusion in the mind of the consumer that the registration obtained by the Defendant in respect of its mark can be said to be *prima facie* fraudulent or unsustainable. In respect of another trademark, the Court observed that merely because Sun was shown in the background of the image of a Rhino in the impugned mark of the Defendant, it cannot be said that there is either deceptive similarity or a case of slavish copying of the registered trademark of the Plaintiff or artistic work in the trademark of the Plaintiff, which consists of two elephants pulling in the opposite direction with Sunset in the background. The Court in *Pidilite Industries Limited v. Chiripal Industries Limited* [Judgement dated 9 March 2023]

however found that the registered trademark of the Plaintiff HEATX and the impugned mark HEAT-TIK of the Defendant could *prima facie* give rise to confusion. Similarly, *prima facie* case was found in favour of the Plaintiff in respect of the marks LW and LW+. The proceeding was concerned with trademarks and house marks of the Plaintiff, including HEATX, FEVICOL, LW+, LW, DR. FIXIT and an artistic depiction showing two elephants, in the backdrop of Sunset, pulling in the opposite directions.

'FECONTIN-F' and 'FEMICONTIN' are not deceptively similar, either visually or phonetically

The Delhi High Court has held that the marks 'FECONTIN-F' and 'FEMICONTIN' are not deceptively similar, either visually or phonetically. Further, observing that the use of the latter mark by the Defendant was a *bona fide* adoption of the mark, the Court also noted that the mark 'FECONTIN-F' of the Plaintiff was descriptive of the pharmaceutical product itself (iron supplement and is used by female patients normally during pregnancy). The Court in *Modi-Mundipharma Pvt. Ltd. v. Preet International Pvt. Ltd.* [Decision dated 23 March 2023] noted that 'FE' relates to iron, which is an ingredient of the Plaintiff's product, while CONTIN is being used in relation to the products with Continuous Drug Delivery system, that is where the drug will have a continuous effect in the body for a longer duration. Dismissing the suit, denying any relief to the Plaintiff, the Court also observed that the Plaintiff had failed to prove any confusion being caused by the use of the mark of the Defendant.

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