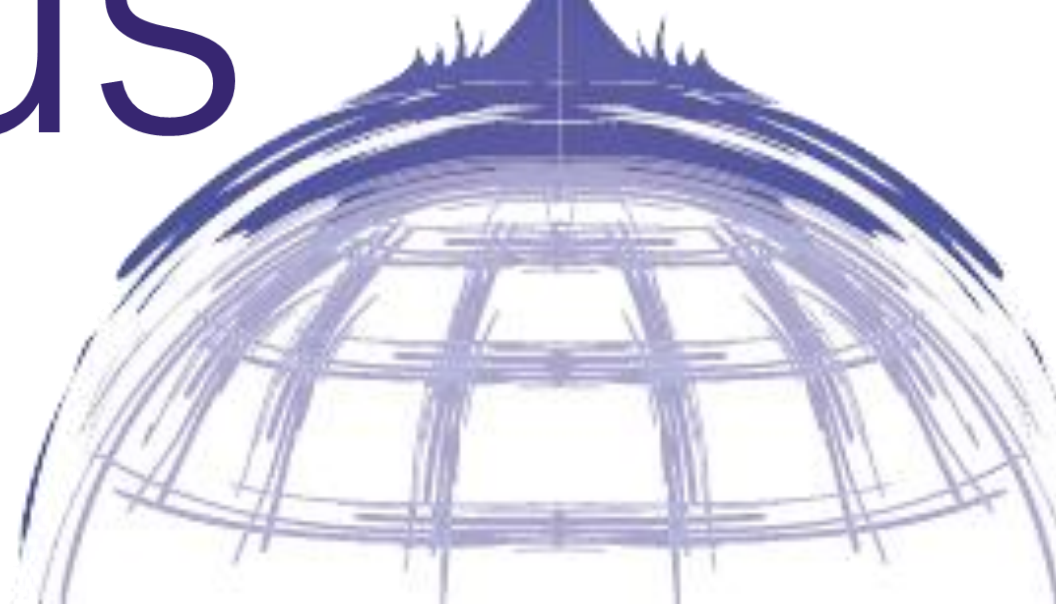


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# Article

## Toblerone saga – Sweet enough; but not Swiss enough

By Anushka Verma

The article in this issue of IPR Amicus discusses the application of the Swissness Act, 2017 which regulates the use of Swiss symbols or labels which associate the products and services with Switzerland. Talking about the criteria for Swissness and the effect of the Act on the famous chocolate brand which had to remove the iconic Matterhorn mountains from the packaging, the article notes that evocation is a huge factor when understanding consumer psychology. According to the author, while the Act does not refer to trademarks *per se*, it does find its basis in the concept of evocation. Observing that while the nations across the world use Geographical Indications to provide protection to the goods/services which are exclusively associated with their territories, the Swissness Act goes beyond and prevents anyone from using the Swiss emblems, or associate themselves with Switzerland. The author wonders whether all countries should enforce similar legislations, and will it lead to better products and services



# Toblerone saga – Sweet enough; but not Swiss enough

By Anushka Verma

Fans of the hugely popular show 'Friends' will vividly remember how Joey's eyes widened when he saw a Toblerone chocolate in one of the other character's bags. The distinctive Matterhorn Mountain on the packaging poking out of the bag, seemingly reflected in the conical structure of the chocolate, immediately brings to Joey's eyes the happiness one can only feel when one hears the words 'Swiss Chocolates'.

However, the iconic Matterhorn mountains have recently been removed from the packaging of the chocolates. This change has been brought about due to the application of the Swissness Act, 2017 ('Act'), which regulates the use of Swiss symbols or labels which associate the products and services with Switzerland. Over the course of years, products originating out of Switzerland have established themselves as premium-quality products. The readers may note Swiss watches, Swiss Knives, and Swiss Chocolates as prime examples; the goods themselves, regardless of the manufacturer, bring to the consumers' minds a certain level of poche and excellence attached to it. In its essence, the Act ensures that only such products or services which satisfy the conditions set out in the Act can use the symbols associated with Switzerland,

such as the Swiss Cross, the Swiss Alps, etc. or can use labels such as 'Swiss-made'.

## Criteria for Swissness:

Under the Act, the general qualifying criteria for foodstuffs<sup>1</sup> includes:

- (a) 80% of the weight of raw materials used in the recipe must come from Switzerland; and,
- (b) Essential processing steps must be undertaken in Switzerland.

Toblerone has been hit by the application of this Act, because of its decision to move the production and manufacturing of its 35 gm and 50 gm chocolates to Slovakia, as a cost-cutting measure. Moving the production out of Switzerland falls foul of the second criteria provided above, and accordingly, these chocolates are not Swiss enough to use the Matterhorn image.

Therefore, representatives of Mondelez International, the company which produces the chocolates have confirmed that the new packaging will include a '*modernised and streamlined mountain logo that aligns with the geometric and triangular aesthetic.*'<sup>2</sup>

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<sup>1</sup> [https://www.ige.ch/fileadmin/user\\_upload/Swissness/e/Flyer\\_Swissness\\_en\\_web.pdf](https://www.ige.ch/fileadmin/user_upload/Swissness/e/Flyer_Swissness_en_web.pdf).

<sup>2</sup> <https://www.theguardian.com/world/2023/mar/05/matterhorn-mountain-toblerone-packaging-design-switzerland>

## Effect on Toblerone?

It is pertinent to note that evocation is a huge factor when understanding consumer psychology. Evocation means looking at a particular thing or a symbol, and associating it with a symbol, event, or thing in the past. One can look at it from the lens of trademarks law- for e.g., the term 'Haldiram' in India, on any food outlet, will immediately bring to the consumer's recollection the delectable food chain, and the reputation that comes along with it. For that matter if any good uses any iconic Indian monument/natural resource/place etc., it will immediately evoke a reference to India (even if the name itself is not used). If an 'Indianness Act' similar to the Swissness Act was enforced, the use of such images on the packaging, especially if the product itself is manufactured elsewhere, will also raise similar questions as the ones raised in Toblerone. The Swissness Act, 2017 can be considered in the same vein. While it does not refer to Trademarks *per se*, it does find its basis in the concept of evocation.

In the case of the Toblerone bars, their packaging has always immediately evoked a reference to Switzerland. Like the author earlier mentioned, whether it is a chocolate connoisseur or not, a person will be attracted to the chocolate because it is a 'Swiss Chocolate'.

While it can be argued that the change of packaging may act as a disadvantage to Toblerone, as losing the unique selling point of 'Swissness' may also lead a loss of consumer base, it can also be argued that the distinctive yellow of Toblerone combined with the

manner the term is written, and the shape of the chocolate itself, has acquired significant distinctiveness and goodwill; and the removal of the Matterhorn may not be a pivotal consideration for an average consumer. What remains of the chocolates is the legacy of its shape and taste. Chocolate lovers will still enjoy the bar, even if its heritage value may have decreased. It remains to be seen how the change will affect the brand.

## Conclusion:

Nations across the world have endeavoured to provide protection to the goods/services which are exclusively associated with their territories. This is mostly done under laws pertaining to Geographical Indication. However, Switzerland has gone one step beyond such laws, to protect itself from anyone who tries to imping its reputation by enacting laws such as the Act that prevents anyone from using the Swiss emblems, or associate themselves with Switzerland, if they are not associated with the Swiss soil and do not adhere to the Swiss quality.

Therefore, should all countries enforce similar legislations? Will it lead to better products and services? And ultimately, will it lead to the benefit of the consumers- who will have better options and an assurance that the products they buy are authentic? This is the food for thought here.

**[The author is an Associate (Trademarks) in IPR practice at Lakshmikumaran & Sridharan Attorneys, New Delhi]**



# Ratio Decidendi

- Computer program resulting in technical effect/contribution eligible for patent protection – Not covered under Section 3(k) by mere use of algorithms and computer-executable instructions – Delhi High Court
- Patents – Patentee not required to wait for a period of one year or for favourable culmination of post-grant opposition proceedings, before suing for infringement – Delhi High Court
- Copyright in screenplay of a film vests with the author and not the producer of the film – Delhi High Court
- Copyrights – Police cannot keep complaint pending just because parties fighting a civil proceeding on same fact matrix – Karnataka High Court
- Trademarks – Jurisdiction of court when cause of action arises at franchisee's place – Franchisee not a 'subordinate office' – Delhi High Court
- Trademarks – No power vested with Police to seal factory premises where incriminating articles situated – Bombay High Court
- Trademarks – Interim relief granted to user of the mark 'ARTIZE', against use of 'ARTIS' for similar goods – Delhi High Court

## Computer program resulting in technical effect/contribution eligible for patent protection – Not covered under Section 3(k) by mere use of algorithms and computer-executable instructions

The Delhi High Court has held that an invention should not be deemed a computer program *per se* merely because it involves algorithms and computer-executable instructions. According to the Court, rather, it should be assessed based on the technical advancements it offers and its practical application in solving real-world problems. The Court observed that if a computer-based invention provides a technical effect or contribution, it may still be patentable, and that technical effect or contribution can be demonstrated by showing that the invention solves a technical problem, enhances a technical process, or has some other technical benefit.

The case involved interpretation of words '*per se*' as in Section 3(k) of the Patents Act, 1970 which lists 'computer programs *per se*' as not patentable. The Controller in its impugned decision had held that the claims were implemented on computer and were computer-executable instructions/algorithms performed on a general-purpose computing device, and hence covered under the phrase 'computer programs *per se*' – thus not patentable.

Taking note of legislative history of the provision, Statement of Objects and Reasons to the Patents (Amendment) Act, 2005, the Report of Joint Parliamentary Committee on Patents (Second Amendment) Bill, 1999, the parliamentary debates, etc., the Court observed that the said term [*per se*] was added to make it clear that 'computer programs as such' are non-patentable. It noted that the intent of the amendment was to allow grant of patents to Computer Related Inventions (CRIs) that involve a novel hardware component or provide a technical contribution to the prior art(s) beyond the program itself.

The High Court was of the view that the fact that the claimed invention involved a set of algorithms executed in a pre-defined sequential manner on a conventional computing device does not necessarily imply that it lacks a technical effect or contribution. The Court noted that it is possible that the invention provides a technical solution to a technical problem, and the computer program use is merely a means to achieve the technical solution. According to the Court, if the subject matter is implemented on a general-purpose computer, but results in a technical effect that improves the computer system's functionality and effectiveness, the claimed invention cannot be rejected on non-patentability as 'computer program *per se*'.

The patent in question provided for a technique for secure authentication of a user while accessing one or more sub-location(s) in a network address which effectively foils the attempts of a malicious user to gain access to network sub-location(s) by illegally obtaining cookies from another user.

On the facts of the case, the Court noted that the technical contribution of the invention in question was that it simplified user interaction with content received from feeds and enhanced the security of accessing sub-locations of network locations while streamlining the user experience. The Court in this regard also rejected the contention that since the invention was at the user-interface level, the same was not patentable. It observed that the technical solution [in the patent in question] went beyond the user-interface level, involves complex network-level communication protocols, and provided a technical effect and contribution that is patentable.

Setting aside the Order of the Controller, the Court also noted that 2017 Computer Related Inventions Guidelines, issued by Controller General of Patents, Designs and Trade Marks (CGPDTM), acknowledged the challenges and complexities surrounding the examination of CRIs, and underscored the need to focus on substance [underlying technical contribution] rather than the form.

It may be noted that the High Court further directed the Indian Patent Office/ CGPDTM to frame certain signposts in this regard, considering the Indian legal framework. It was of the view that providing examples of both patent-eligible and non-eligible inventions in the guidelines, as provided by the European Patent Office as well as United States Patent and Trademark Office, would be beneficial. [*Microsoft Technology Licensing, LLC v. Assistant Controller of Patents and Designs* – Judgement dated 15 May 2023 in C.A.(COMM.IPD-PAT) 29/2022, Delhi High Court]

## Patents – Patentee not required to wait for a period of one year or for favourable culmination of post-grant opposition proceedings, before suing for infringement

Distinguishing the Supreme Court decision in the case of *Aloys Wobben v. Yogesh Mehra* [(2014) 15 SCC 360] the Delhi High Court has rejected the contention that right of the Plaintiff-patentee, to hold the patent, would crystallise only on favourable disposal of the post grant oppositions filed against the patent and hence the right of the Plaintiff to file an infringement suit would only emerge thereafter.

The High Court, in this regard, agreed with Plaintiff that there is no provision under the Patents Act, 1970, which inhibits a patentee, to whom a patent has been granted, to forthwith sue for infringement, and which requires the patentee to wait for a period of one year from the grant of the patent, or, in the event any post-grant opposition has been filed within the said period, for the favourable culmination of such proceedings, before suing for infringement of the patent.

Further, applying the inversion test, as advocated in *Career Institute Educational Society v. Om Shree Thakur Educational Society* [2023 SCC OnLine SC 586], the Court also noted that para 19 of *Aloys Wobben* decision, as relied upon by the Defendant, was *obiter dicta*, as, even if the said para was to be removed from the judgment, its conclusion would remain unchanged.



Also, according to the High Court here, considering the decision of the Supreme Court in *CTR Manufacturing Industries Ltd. v. Sergi Transformer Explosion Prevention Technologies Pvt. Ltd.* [SLP (C) 34749-34751/2015] it would be hazardous to read para 19 of *Aloys Wobben* as proscribing the institution of an infringement suit during the pendency of post grant opposition proceedings instituted under Section 25(2) of the Patents Act.

Dismissing the application filed by the Defendant, seeking rejection of the suit, the Court also observed that the proviso to Section 11(A) of the Patents Act also manifests the statutory intent to confer on the holder of every granted patent, the right to proceed legally against infringement. [*Astrazeneca AB v. Westcoast Pharmaceutical Works Limited* – Judgement dated 15 May 2023 in CS(COMM) 101/2022, Delhi High Court]

## Copyright in screenplay of a film vests with the author and not the producer of the film

The Delhi High Court has held that in a case where the author of the screenplay of the film is engaged pursuant to a contract with the producer, against remuneration, copyright in the screenplay would vest with the author and not in the producer.

Considering the provisions of the Copyright Act, the Court was of the view that by operation of Section 13(4) of the Copyright Act, the copyright in the screenplay, as a 'literary work', which stands vested by Section 13(1)(a), cannot be affected by the separate copyright in the cinematograph film itself, which, unquestionably, vests with the producer.

In respect of owner of the copyright in screenplay, the Court relied upon Section 17 and held that author of the screenplay would be the first owner of the copyright therein. It, in this regard, held that all the proviso of Section 17 were not applicable. In fact, considering clause (c) of the proviso to Section 17, the Court observed that use of the expression 'contract of service', especially in the company of the word 'apprenticeship' in clause (c) makes it clear that the clause does not apply to cases of a contract between equals.

The dispute involved an assignment, by the heirs of the author (Defendants here) of the screenplay in the film 'Nayak', with respect to the right to novelize the screenplay, which would amount to 'reproduction of the work in any material form'. Dismissing the case of the Plaintiff-Producer of the film, the Court also rejected the plea regarding bearing of all expenses of the film by the Plaintiff. The Court, for this purpose, also distinguished various decisions of the High Courts and the Supreme Court.

It may be noted that the High Court, however, rejected the contention of the Defendant that since the increase of the term of the copyright was affected by an amendment in 1993 (by Copyright (Amendment) Act, 1993), which took place after the commencement of the copyright of the Plaintiff, the plaintiff would not be entitled to the benefit thereof. Relying on Section 3 of the 1993 Amendment, the Court ruled that where the copyright in the concerned work had not expired prior to the coming into force of the 1993 Amendment Act, the copyright holder would be entitled to the benefit of the amendment, which increased the life of a copyright from 50 years to 60 years. [*RDB and Co. HUF v.*

*Harpercollins Publishers India Private Limited* – Judgement dated 23 May 2023 in CS(COMM) 246/2021, Delhi High Court]

## Copyrights – Police cannot keep complaint pending just because parties fighting a civil proceeding on same fact matrix

Taking note of the fact that the Copyrights Act, 1957 provides for both civil remedy and criminal prosecution, in the case of an infringement, the Karnataka High Court has observed that the outcome of one does not depend upon the outcome of another, subject to all just exceptions. Further, observing that the object, nature & outcome of these proceedings – civil and criminal, are not the same, the Court was of the view that merely because a civil dispute is being fought between the parties, the criminal proceedings cannot be halted, *per se*, on that ground.

The High Court hence upheld the contention of the Petitioner that the police cannot keep the complaint pending on the ground that parties are fighting a civil proceeding on the same fact matrix.

Taking note of Kenny's 'Outlines of Criminal Law', 18th Edition, 1962, Cambridge University, and 'Criminal Law' by Smith and Hogan, 7<sup>th</sup> Edition, ELBS, the Court observed that the reluctance of the police to process the complaint may not be correct. The Petitioner had invoked the writ jurisdiction in respect of its FIR/complaint allegedly being kept in a cold storage presumably because of pendency of its civil dispute, wherein an order of temporary injunction had been secured against the accused.

Delhi High Court decision in the case of *Jay Prakash v. State* [2008 Cr.L.J.(NOC) 637 Del.], was also relied upon by the Court while it issued a Writ of Mandamus to the Respondent-police to undertake and accomplish the investigation in the subject offence within an outer limit of three months. [*Mangalore New Sultan Beedi Works v. State of Karnataka* – Order dated 31 May 2023 in Writ Petition No. 10870 of 2023 (GM-POLICE), Karnataka High Court]

## Trademarks – Jurisdiction of court when cause of action arises at franchisee's place – Franchisee not a 'subordinate office'

The Delhi High Court has rejected the contention that a franchisee is also a subordinate office, for the purposes of para 14 of the decision in *Ultra Home Construction Pvt. Ltd. v. Purushottam Kumar Chaubey* [(2016) 227 DLT 320 (DB)]. The Court in its earlier decision had held that if the plaintiff has a principal office at one place and a subordinate office at another, and the cause of action has arisen at the place where the subordinate office is situated, the suit will have to be filed before the competent court having jurisdiction over the subordinate office of the plaintiff.

Observing that a subordinate must be in a position of subordination and that disobedience, by a subordinate, of the direction of the superior, must amount to insubordination, the Delhi High Court held that administrative and managerial subordination is, therefore, the *sine qua non* for an office to be regarded as a 'subordinate office'. Further, observing that a

subordinate office is essentially an office which is in the nature of a branch, or another office of the principal office, over which the principal office exercises control, the Court found substance in the contention of the Respondent that commonality of managerial control is one of the well understood indicia of a subordinate office.

The High Court also observed that, on the other hand, the franchisee which is a separate legal entity, has no obligation, towards the franchisor, in excess of that which the franchise agreement envisages, and nor does the franchisor exercise any administrative or managerial control, over the franchisee, beyond the franchise agreement.

It also, in this regard, rejected the contention that since the franchisee is granted representational rights, it implies that the franchisee is a representative of the franchisor and is, therefore, its subordinate office. The High Court was of the view that the grant of representational right would in fact militate against the plea that the representative is a subordinate office. According to the Court, if the franchisee were a subordinate office of the franchisor, there would be no need to grant any representational right. The Court similarly rejected the plea that the franchisee, who is franchised the right to use a trademark, would be a subordinate office of the franchisor. [*S. S. Hospitality v. Sagar Ratna Restaurants Pvt. Ltd.* – Judgement dated 4 May 2023 in CRP-IPD 5/2023, Delhi High Court]

## Trademarks – No power vested with Police to seal factory premises where incriminating articles situated

The Bombay High Court has held that there is no power vested in the police, under Section 115 of the Trade Marks Act, 1999, to seal the factory premises where the incriminating articles are situated. The Court in this regard noted that the provisions of Section 115(4) permit the police officer to seize without warrant the articles/items which are enumerated in the said sub-section, however, there is no power vested with the police to seal the factory premises.

The Respondent-State had submitted that machinery being huge, it was not possible for the police officer to seize the same, and to secure the machinery while ensuring that the same is not used in the commission of offence, the factory premises was sealed.

Granting *ad interim* relief, the High Court also rejected the contention of the State that petitioner had an alternate remedy before the Judicial Magistrate. It, in this regard, observed that there was no seizure of the articles while the provisions indicate that the seized articles are required to be produced before the Magistrate. [*Mahendra Dattu Gore v. State of Maharashtra* – Decision dated 17 May 2023 in Criminal Application No. 496 of 2023, Bombay High Court]

## Trademarks – Interim relief granted to user of the mark 'ARTIZE', against use of 'ARTIS' for similar goods

Observing that the trademarks 'ARTIZE' of the Plaintiff and 'ARTIS' of the Defendant exhibit visual, phonetic, and structural similarities, the Delhi High Court has granted interim relief to the Plaintiff. The Court, on the question of deceptive similarity, observed that the conflicting marks were nearly identical and there was a high potential for the members of public to associate Defendant's 'ARTIS' with Plaintiff, furthermore as Plaintiff was utilising the 'ARTIZE' mark for a considerable period (since 2008) and was thus also the prior user and registrant of the mark. It noted that even the pronunciation of the two words 'ARTIZE' and 'ARTIS' was almost alike. It was also of the view that considering the degree of similarity of the marks and goods with which they were associated (sanitaryware), it was likely that Defendant's use of the mark 'ARTIS' could cause confusion amongst the consumers as to the origin of the goods, and that such confusion is likely to continue even if the 'ARTIS' is used with their house brand.

The Court further rejected the Defendant's contention that since the Plaintiff lacked registration of the mark 'ARTIZE' as a standalone wordmark, it cannot claim proprietary rights over the word 'ARTIZE' alone. It noted that the distinctiveness of the word 'ARTIZE' had been established through extensive use and promotion, with the distinctiveness extending beyond the specific device marks containing the word 'ARTIZE' and encompassing the word itself as a standalone trademark.

Defendant's argument that 'ARTIS' is only a sub-brand of the Defendant, applied to a particular range of products and is never used on a standalone basis, was also rejected by the Court while it observed that by using 'ARTIS', the Defendant intended it to act as a source identifier for a special segment of products, which use is purely in a trademark sense. It was of the view that the fact that it is a sub-brand or an individual brand was immaterial. The Court, for this purpose, also noted that the Defendant had applied for registration of the said mark before the EUIPO, specifically in respect of sanitaryware. Similarly, Defendant's arguments regarding delay and acquiescence were also rejected by the Court while it noted that mere absence of legal action by the trademark owner is not enough to establish acquiescence. The Court also observed that Plaintiff's earlier inaction was not necessarily a valid defence for Defendant's use of the mark.

Granting interim injunction, the High Court also held that the word 'ARTIZE' was not descriptive of the goods to which it was applied, and therefore, the Plaintiff could not be disentitled from restraining the use of 'ARTIS' by the Defendant. In the opinion of the Court, 'ARTIZE' was an inherently distinctive and fanciful mark, which was capable of functioning as a trademark. It was of the view that not every consumer in India would be aware of the linguistic origin of the term 'ARTIZE' (Art) and absence of widespread use thereof in sanitary ware industry further highlights its distinctiveness and makes it easier for consumers to associate it with Plaintiff's products. [*Jaquar Company Pvt. Ltd. v. Villeroy Boch AG* – Judgement dated 4 May 2023 in CS(COMM) 777/2022, Delhi High Court]





# News Nuggets

- Inventiveness not a pre-requisite for registration of a trademark, and mark not in common use by others do not lack distinctiveness
- Patents – Delhi High Court directs adjudicating authorities to pass reasoned and speaking orders
- Patents – Delhi High Court recommends Patent Office to update Manual for Practice
- Trademarks – Deceptive similarity between 'Golden Crown' and 'Golden Queen' leading to idea infringement
- Trademarks – Hospitals are allied and cognate to medical journals and periodicals
- 'NOW' is common to trade – Delhi High Court vacates its earlier ad-interim injunction order in favour of a media house

## Inventiveness not a pre-requisite for registration of a trademark, and mark not in common use by others do not lack distinctiveness

Observing that though inventiveness is required for registration of a design or a patent, under the Designs Act, 2000 and the Patents Act, 1970, respectively, there is no corresponding provision in the Trade Marks Act, 1999, the Delhi High Court has held that inventiveness is not a pre-requisite for registration of a mark. Setting aside the decision of the Assistant Registrar rejecting the registration application, the Court also held that, contrary to the finding of the Assistant Registrar (which was termed as displaying complete non-application of mind), evidence of user of the mark is not required to establish distinctiveness.

The High Court further observed that it is difficult to conceive of any mark, which is not in common use by others, as being found to lack in distinctiveness. According to the Court, howsoever innocuous a mark may appear to be, if it is used only by one person, it would, in plain etymological terms, be distinctive.

Quashing the impugned decision of the Assistant Registrar, the Court in *Abu Dhabi Global Market v. Registrar of Trademarks* [Judgement dated 18 May 2023] also rejected the finding that the composite device mark contained the name of a place (Abu Dhabi) and hence was non-registrable under Section 9(1)(b) of Trade Marks Act, 1999. It, in this regard, observed that composite marks stand *ipso facto* excluded from the scope of said section, even if

part of such marks consist of marks which serve, in trade, to designate the geographical origin of the goods or services in respect of which the mark is registered.

## Patents – Delhi High Court directs adjudicating authorities to pass reasoned and speaking orders

Observing that there is apparently endemic problem in the office of the Controller of Patents and Designs, to reject patent applications by merely reproducing the objections issued to the proposed patentee, without even a word of reference to the reply of the patentee filed in response thereto, and totally without any application of mind whatsoever, the Delhi High Court has directed the adjudicating authorities under the Controller to pass reasoned and speaking orders. The Court has also directed that every order should deal systematically and sequentially with each objection that requires consideration and provide reasons as to why the objection is sustained or rejected. The High Court in this regard also stated that even the order granting the patent should briefly state why the applicant's reply to the Department's objection is accepted. According to the Court, this would facilitate any post-grant opponent, who seeks to oppose the grant of the patent, or seek its revocation, after the patent is granted. The Court in *Huhtamaki Oyj v. Controller of Patents* [Order dated 26 May 2023] however noted that the requirement of a reasoned and speaking order would obviously not apply if the patent, as sought, is granted, and there is no objection in the FER or hearing notice, or pre- or post-grant opposition thereto.

## Patents – Delhi High Court recommends Patent Office to update Manual for Practice

The Delhi High Court has recommended to the Office of the Controller General of Patents, Designs and Trademarks to update or revise the Manual of Patent Office Practice and Procedure. The Court was of the view that resultantly, the Examiners and Controllers could get better guidance on dealing intricate matters like objections of lack of clarity and succinctness of inventions. According to the Court, this would be particularly useful when dealing with complex patents involving Artificial Intelligence systems, machine learning functions, agro-chemicals, pharmaceuticals and manufacturing methods. The Judgement dated 3 June 2023 in *Agfa NV v. Assistant Controller of Patents and Designs*, also stated that it may also be appropriate to consider giving adequate technical and patent analytics trainings to Examiners and Controllers.

## Trademarks – Deceptive similarity between ‘Golden Crown’ and ‘Golden Queen’ leading to idea infringement

The Delhi High Court has held that there is deceptive similarity between the marks ‘Golden Crown’ and ‘Golden Queen’. The Court, in this regard, observed that eschewing from consideration the common and laudatory, ‘Golden’ part of the two marks, the remaining parts of the two marks, ‘Queen’ and ‘Crown’, convey cognate ideas, and that one cannot ignore the link between a

queen and her crown. According to the Court, there is also an element of idea infringement between the two marks, as they communicate similar or nearly similar ideas. Allowing the petition and directing the Registrar to remove the disputed mark, the Court in *Holyland Marketing Pvt. Ltd. v. Vijay Pal Vineet Kumar and Co.* [Order dated 8 May 2023] also noted that the trade dress of the two packages was also, at a bare glance, nearly identical.

## Trademarks – Hospitals are allied and cognate to medical journals and periodicals

The Delhi High Court has held that ‘hospitals’ and ‘education services providing courses of instruction in medicine and health care’ would be allied and cognate to ‘medical journals and periodicals’ as all of them relate to the healthcare and medical education sector. In a case where the Plaintiff had obtained registration of the mark ‘MAYO CLINIC’ under Class 41 on 26 August, 2008, and the defendants began to use ‘MAYO’ for education purposes in the year 2011/2012, the Court was hence of the view that there was a prima facie case of infringement in terms of Section 29(2)(a) of Trade Marks Act, 1999. Granting interim injunction against the Defendant, the Court in *Mayo Foundation for Medical Education and Research v. Bodhisatva Charitable Trust* [Judgement dated 29 May 2023] was also of the prima facie view that the use of the mark in relation to healthcare services was completely arbitrary and distinctive.

## 'NOW' is common to trade – Delhi High Court vacates its earlier *ad-interim* injunction order in favour of a media house

The Delhi High Court has vacated its *ad-interim* injunction earlier granted in favour of the Plaintiff restraining the Respondent from starting any channel/ programme in India by the mark 'NOW' or any other mark deceptively similar to the mark 'NOW'. The Court in this regard noted that the Plaintiff in *Bennet, Coleman & Company Limited v. E! Entertainment Television LLC* [Decision dated 31 May 2023] was not the proprietor of the stand-alone trademark 'NOW'

nor prior user of the said mark in Class-38. It also observed that the stand-alone registration of the Plaintiff in Class-41 was of 18 September 2014 on the proposed to be used basis and had not been used till date. The High Court was hence of the view that the registration of 'NOW' simplicitor in Class-41 cannot be used to seek an injunction against the Defendant's mark 'E! Now' and 'E! News Now', more so when the Defendant's first use of 'E News Now' was since 30 September 2007. It also noted that though the Plaintiff had number of registrations with suffix and prefix 'NOW', it was a common word used by number of other entities, and common to trade as stated by Plaintiff itself in response to an examination report for 'Romey Now', and as disclaimed in different cases.



**NEW DELHI**

5 Link Road, Jangpura Extension, Opp. Jangpura Metro Station, New Delhi 110014  
Phone : +91-11-4129 9811

-----  
B-6/10, Safdarjung Enclave New Delhi -110 029  
Phone : +91-11-4129 9900  
E-mail : [lsdel@lakshmisri.com](mailto:lsdel@lakshmisri.com)

**CHENNAI**

2, Wallace Garden, 2nd Street, Chennai - 600 006  
Phone : +91-44-2833 4700  
E-mail : [lsmds@lakshmisri.com](mailto:lsmds@lakshmisri.com)

**HYDERABAD**

'Hastigiri', 5-9-163, Chapel Road, Opp. Methodist Church, Nampally  
Hyderabad - 500 001  
Phone : +91-40-2323 4924 E-mail : [lshyd@lakshmisri.com](mailto:lshyd@lakshmisri.com)

**PUNE**

607-609, Nucleus, 1 Church Road, Camp, Pune-411 001.  
Phone : +91-20-6680 1900  
E-mail : [lspace@lakshmisri.com](mailto:lspace@lakshmisri.com)

**CHANDIGARH**

1st Floor, SCO No. 59, Sector 26, Chandigarh -160026  
Phone : +91-172-4921700  
E-mail : [lschd@lakshmisri.com](mailto:lschd@lakshmisri.com)

**PRAYAGRAJ (ALLAHABAD)**

3/1A/3, (opposite Auto Sales), Colvin Road, (Lohia Marg), Allahabad -211001 (U.P.)  
Phone : +91-532-2421037, 2420359  
E-mail : [lsallahabad@lakshmisri.com](mailto:lsallahabad@lakshmisri.com)

**JAIPUR**

2nd Floor (Front side), Unique Destination, Tonk Road, Near Laxmi Mandir Cinema  
Crossing, Jaipur - 302 015  
Phone : +91-141-456 1200  
E-mail : [lsjaipur@lakshmisri.com](mailto:lsjaipur@lakshmisri.com)

**MUMBAI**

2nd floor, B&C Wing, Cnergy IT Park, Appa Saheb Marathe Marg,  
(Near Century Bazar)Prabhadevi,  
Mumbai - 400025  
Phone : +91-22-24392500  
E-mail : [lsbom@lakshmisri.com](mailto:lsbom@lakshmisri.com)

**BENGALURU**

4th floor, World Trade Center, Brigade Gateway Campus, 26/1, Dr. Rajkumar Road,  
Malleswaram West, Bangalore-560 055.  
Phone : +91-80-49331800 Fax:+91-80-49331899  
E-mail : [lsblr@lakshmisri.com](mailto:lsblr@lakshmisri.com)

**AHMEDABAD**

B-334, SAKAR-VII, Nehru Bridge Corner, Ashram Road, Ahmedabad - 380 009  
Phone : +91-79-4001 4500  
E-mail : [lsahd@lakshmisri.com](mailto:lsahd@lakshmisri.com)

**KOLKATA**

2nd Floor, Kanak Building 41, Chowringhee Road, Kolkatta-700071  
Phone : +91-33-4005 5570  
E-mail : [lskolkata@lakshmisri.com](mailto:lskolkata@lakshmisri.com)

**GURGAON**

OS2 & OS3, 5th floor, Corporate Office Tower, Ambience Island, Sector 25-A,  
Gurgaon-122001  
phone: +91-0124 - 477 1300 Email: [lsgurgaon@lakshmisri.com](mailto:lsgurgaon@lakshmisri.com)

**KOCHI**

First floor, PDR Bhavan, Palliyil Lane, Foreshore Road, Ernakulam Kochi-682016  
Phone : +91-484 4869018; 4867852  
E-mail : [lskochi@laskhmisri.com](mailto:lskochi@laskhmisri.com)

**NAGPUR**

First Floor, HRM Design Space, 90-A, Next to Ram Mandir, Ramnagar,  
Nagpur - 440033  
Phone: +91-712-2959038/2959048  
E-mail : [lsnagpur@lakshmisri.com](mailto:lsnagpur@lakshmisri.com)

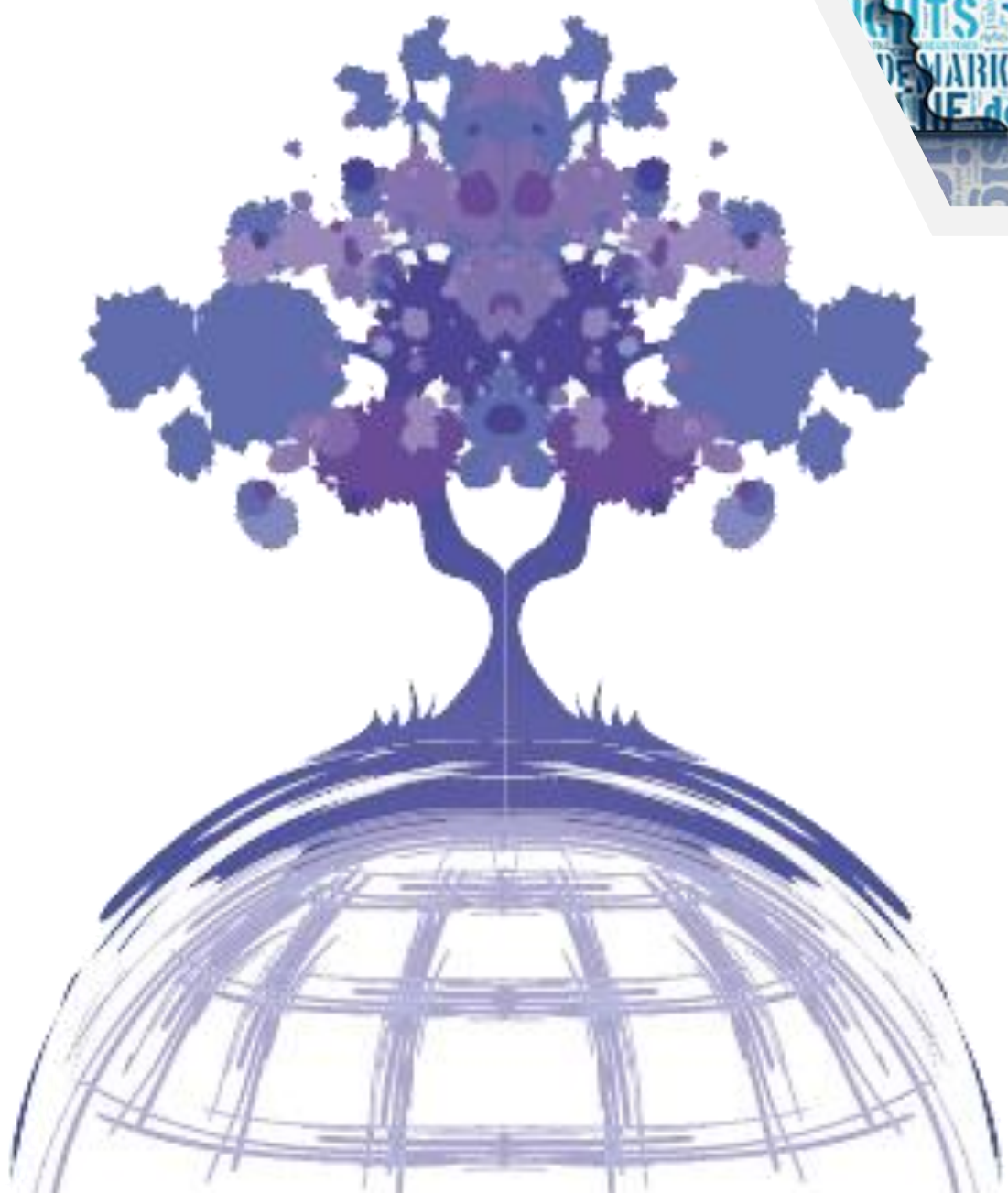
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