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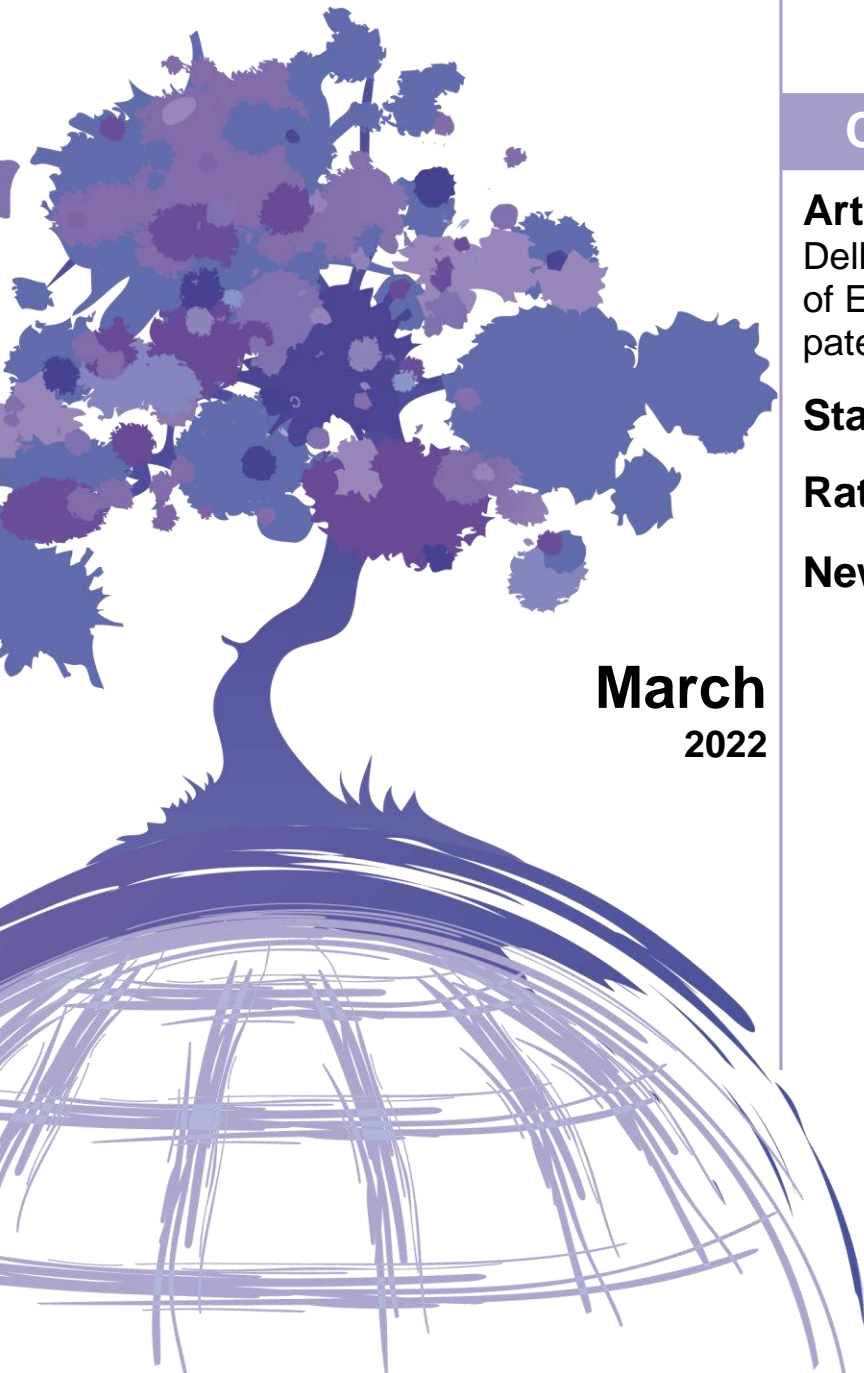
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Article

Delhi High Court expounds on Doctrine of Equivalence and parallel import under patent law

By **Vindhya S. Mani**

In the recent case of *Sotefin SA v. Indraprastha Cancer Society And Research Center & Ors*¹ a Single Judge of the Delhi High Court granted an interim injunction by restraining the Defendants from making, selling, exporting, or from offering for sale, importing or in any manner directly or indirectly dealing with infringing products namely, 'Smart Dollies' that infringed the Plaintiff's patent IN214088 pertaining to a 'Carriage for the horizontal transfer of motor vehicles in automatic mechanical car parks'. The suit patent was related to a self-propelled carriage on wheels, for horizontal transfer of motor vehicles by lifting two or more wheels, in single or multi automatic mechanical car parks. It was commonly known as a 'Dolly' or a 'Silomat Dolly'. The Court applied the concept of Doctrine of Equivalence to arrive at the finding of a *prima facie* case of infringement and dismissed the exemption of parallel import under Section 107A(b) of the Patents Act, 1970 ('Act') asserted by the Defendants.

The suit patent was set to expire on 13 March 2022 and given the proximity of the expiry date of patent rights, the Defendants argued that the relief of interim injunction should not be granted and argued that damages post-trial would be an adequate remedy. The Court held that this would tantamount to defeating the patentee's monopoly rights. The Court held that if

infringement has occurred during the lifetime of the patent, the infringing goods would not become kosher on expiry of the patent. The Court also held that since an injunction is a statutory relief under Section 108 of the Act, the same cannot be denied merely because damages can be awarded at a later stage. The Court considered that the Defendants were aware of the suit patent and still proceeded to import the Smart Dollies and since the Plaintiff established the three essential ingredients viz., *prima facie* case, balance of convenience and irreparable loss, injunction should follow.

Factual background

In 2011, the Plaintiff entered into a supply contract with the Defendant No. 3 (Simplex Projects Limited) for the supply of fourteen patented 'Silomat Dollies' and entered into a separate agreement for supply of drawings of the automatic parking system to the said Defendant with necessary clauses to maintain confidentiality. In 2017, Defendant No. 2 (Rajiv Gandhi Cancer Institute and Research Centre, operated and managed by the Defendant No.1 (Indraprastha Cancer Society & Research Centre)) proposed a tender for an automatic car parking system for their site. The Plaintiff contends having shared technical background of the Silomat Dolly and informed Defendant No. 2 of the suit patent. In November 2020, the Plaintiff became aware of Defendant No. 2 obtaining fire safety permission for its automatic multi- parking

¹ CS(COMM) 327/2021; Delhi High Court Judgement dated 17 February 2022.

system. The Plaintiff also learnt that the Defendant No. 1 had placed an order of supply and import of 14 'Smart Dollies' for the project at Defendant No. 2's parking system from a company named Nanjing Eli Parking Equipment Manufacturing Co. Ltd., ('**Nanjing**') in China and this product was installed/ being installed at the premises of Defendants No. 1 and 2.

The Plaintiff after acquiring images of the Smart Dollies at Defendant No. 2's site, discovered the similarity between the Smart Dollies and the Plaintiff's Silomat Dollies and asserted that the Defendant No. 3 illegally transferred the technology and/ or drawings related to the suit patent to Defendant No. 4 and thereby enabled the importation of the Smart Dollies by Defendant No.1.

Post summons in the suit, the Court directed IIT Delhi to appoint experts in the relevant field to assist the Court in determining whether all the features of Claim 1 of the suit patent are found in the Smart Dollies. The key takeaways from the experts' report were:

- All elements of claim 1, i.e. 17 elements, except 2 elements, namely, the parts for supporting the wheels to be joined by means of hinges of horizontal axis perpendicular to its longitudinal axis and means of immobilizing the rear wheel were not found in the Smart Dollies.
- The claims in the suit patent and the Smart Dollies have identical input-output functions and both relate to dollies for cars.
- The Smart Dollies use hydraulic motors in lieu of electric motors, Optical measurement instead of optical limit switches and Motion triggered tire contact detector instead of pressure pads.

- The supporting means in the Smart Dollies and suit patent have identical method of operation but the former uses hydraulic instead of electrical actuation, parallel guidance instead of double start helical cam and motion triggered limit switch instead of pressure sensors.
- The Smart Dollies does not have pressure sensors to detect proximity of wheel of the motor vehicle and a cable drum to detect movement of the carriage.

Each of the parties advanced their respective stance based on the above report of the experts. The Plaintiff contended that since 17 of the 19 elements of claim 1 of the suit patent were found in the Smart Dollies, infringement is made out. As per the Plaintiff the remaining two elements, i.e., hinges and means of immobilizing the rear wheel are non-essential since the claimed invention and the Smart Dollies perform the same function in substantially the same way. The Defendants on the other hand contended that the 2 missing elements are essential, *albeit* defining the said missing elements differently. The Defendants asserted these elements to be 'one or two pairs of supporting means' and 'means to detect presence of wheels'.

The Defendants also asserted that the Smart Dolly was protected by a patent and two utility patents in China by Nanjing. The Defendants asserted that the Smart Dollies are not related to the Silomat Dollies technology, and since both Dollies are separately and concurrently patented in China, it proves that the two inventions are different.

A few of the Defendants additionally argued that Nanjing was duly authorized under law in China to produce and sell the Smart Dollies and therefore, asserted that since parallel import goods are permitted, and the Smart Dollies are a patented product duly authorized under the law in

the state where it is being manufactured, the importation thereof would not amount to infringement under Section 107A(b) of the Act.

Analysis by the Court

The Court relied on the experts' report and narrowed the controversy to ascertaining whether the two missing elements *viz.* hinging, and immobilization of rear wheels are so essential that their absence would disentitle the Plaintiff to an injunction. In this regard, the Court reasoned that for patent infringement analysis, comparison of elements of the suit patent's claims is to be done with the claims of the infringing product. The Court noted that the pith and marrow of the invention is to be analyzed based on the doctrine of purposive construction and not merely literal construction. The Court relied on the Doctrine of Equivalence to examine if the substituted element in the infringing product does the same work, in substantially the same way, to accomplish substantially the same result.

With respect to the hinging element, the Court considered the comparison provided by the experts where, the hinges as claimed in Claim no. 1 of the suit patent work unidirectionally like an elbow joint in a human body, whereas the corresponding feature in the Smart Dollies acts as a shoulder joint, giving more room for multi-directional movement. The Court analyzed that a shoulder joint would cover the scope of an elbow joint and held that the additional feature incorporated in the Smart Dollies cannot be construed to be an essential element which could render the Smart Dollies to be substantially different from that the suit patent. With respect to the feature of immobilization of rear wheels, the Court held that the feature of immobilization at two sides does not have material effect upon the working of the invention.

In the light of the above analysis and relying on the fact that 17 of the 19 elements of Claim

No. 1 of the suit patent were found to subsist in the infringing product, the Court held that the Plaintiff successfully established a strong *prima facie* case of infringement.

On considering the argument under Section 107A(b) of the Act, the Court held that the words 'who is duly authorized under the law to produce and sell or distribute the product', do not mean that as long the imported product is patented - in any jurisdiction - it would fall within the ambit of Section 107A(b) of the Act. The Court held that the term 'patented product', in the light of the definitions of 'patented article', 'patent' and 'invention' under Section 2(1)(o), Section 2(1)(m) and Section 2(1)(j) of the Act respectively, would include only those products which are patented under the Indian Patents regime. The Court also held that patents are territorial in nature and therefore, unless otherwise mandated by law, a Chinese patent will not be recognized and protected in India, and the State will not permit the importation of any product which violates an Indian patent, even if it is patented in any other jurisdiction, thereby rejecting the Defendants' exemption under Section 107A(b). The Court also considered the Plaintiff's contentions that the Chinese patent and suit patent are entirely different and that the Defendants have made no attempt to demonstrate that their product conforms to the Chinese patent.

Conclusion

The instant case has brought to the fore concepts in patent law that Indian Courts have not examined yet, in much detail. While it is a welcome step that concepts such as Doctrine of Equivalence that are well-established in other jurisdictions are being applied, however, it appears that Indian Courts are yet to engage in claim construction or Markman hearings as conducted by the US Courts, in patent infringement matters. In the instant case, it

appears that the Court proceeded based on the tabular report of claim mapping as provided by the experts without first construing the scope of the claimed invention.

In the case of *Herbert Markman v. Westview* [52 F.3d 967 also 517 US 370], the Court held that an infringement analysis entails two steps: First step is to determine the meaning and scope of the patent claims asserted to be infringed. Second step is to compare the properly construed claim with the device accused of infringing. The first step is to be undertaken prior to indulging in a comparison or claim mapping with the infringing product. Further, infringement being a mixed question of fact and law, claim construction by the Court is essential to determine infringement. Once the claim construction is done and the scope of the invention determined, the Court can distinguish the questions of fact and engage experts to opine only on the factual questions.

In the instant case, while the Court considered the claim mapping undertaken by the experts, the Court appears to have failed to address the ground raised by the Defendants on the aspect of the claim feature 'one or two pairs of supporting means'. This is a feature of claim 1 of the suit patent and as per the experts this feature has different elements in the Smart Dollies. The Court does not seem to have considered this element in its analysis of essential elements.

Nevertheless, this decision is an indication that Indian Courts, especially the Delhi High Court with the newly constituted IP Division is set to augment the patent law jurisprudence in India by tackling more nuanced issues and concepts.

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Statute Update

Delhi High Court notifies Intellectual Property Rights Division Rules

Consequent to the creation of Intellectual Property Division in July 2021, the Delhi High Court has now on 24 February 2022 notified the Delhi High Court Intellectual Property Rights Division Rules, 2022.

The Intellectual Property Rights Division ('IPD') refers to the division in the Delhi High Court presided over by Single Judges to deal with the disputes and cases concerning IPR subject matter. IPR subject matter in this regard includes

matters pertaining to patents, copyrights, trademarks, geographical indications, plant varieties, designs, semiconductor integrated circuit layout-designs, traditional knowledge and all rights under common law, if any, associated therewith. Interestingly, cases pertaining to the Information Technology Act, 2000 dealing with the rights and liabilities of intermediaries, online market places, and e-commerce platforms involving issues relating to any of the aforementioned subject matters, shall be deemed to be within the purview of intellectual property rights.

Further, IPR subject matters or cases or proceedings or disputes include proceedings which were hitherto maintainable before the Intellectual Property Appellate Board ('IPAB') and all suits filed in which IPR subject matter is involved, either under the respective statutes or under common law including suits relating to breach of privacy and rights of publicity.

The new Rules in this regard also notify in Schedule I, the new forms/formats for filing appeals, applications, etc. Schedule II of the Rules prescribe the Court fee for different types appeals, applications, etc. While elaborate procedure has been prescribed for appeals, original petitions, writ petitions, civil miscellaneous main petitions, regular first appeal, first appeal from order, civil revision petitions and suits, the Rules diligently also deal with procedure for recording of evidence, discovery and disclosure, and preservation of evidence by parties.

Delhi High Court notifies Rules governing patent suits

The Delhi High Court has recently notified the High Court of Delhi Rules Governing Patent Suits, 2022 which along with the Delhi High Court

(Original Side) Rules, 2018 ('Rules'), shall also govern the procedure for adjudication of patent related actions. As per the new Rules notified on 24 February 2022, 'Patent Suit' means all suits which seek reliefs as provided for under Section 48, Section 105, and Section 106 of the Patents Act, 1970, including counter claims under Section 64, Section 108, Section 109, and Section 114 of the said Act. Rule 3 of the Rules provide for the content of pleadings in a plaint, written statement, counter claim, replication, etc.

Further, while Rule 4 deals with the documents to be filed along with the plaint and the written statement/counter-claim, Rule 5 covers first hearing of the suit. Procedure for first, second and third case management hearings are provided in Rules 8, 9 and 10 of the Rules.

As per Rule 16, summary adjudication may be considered by the Court in cases where the remaining term of the patent is 5 years or less; a certificate of validity of the said patent has already been issued or upheld by IPAB, High Court or Supreme Court; if the defendant is a repeated infringer of the same or related patent; and if the validity of the patent is admitted and only infringement is denied.



Ratio decidendi

Copyrights – Difference in number of horses would not make a qualitative difference to allow registration as original artistic work

In a case involving rectification of a copyright, the Delhi High Court has directed the Registrar to

cancel the copyright registration for the artwork titled 'Sports Polo' and having the image of four horses with riders. The Court in this regard noted that the arrangement of the tilted horses as well as the colour scheme of the logo left no doubt that the Respondent had in bad faith copied the registered trademarks of the petitioner – 'Polo

Sports' having a 'horse with a person riding it while flinging his club to hit a ball in the sport of polo'.

Holding the artistic works in the logo of the respondent as almost an imitation of the trademarks of the petitioner, the Court stated that the respondent using four horses as against the petitioner using one would not make a qualitative difference. It further noted that the respondent was also using the word marks 'Sports' and 'Polo' of the petitioner. It was hence held that the respondents work was not an original artistic work for the purposes of registration under the Copyright Act, 1957. The High Court also noted that the mark of the petitioner was earlier recorded as a well-known mark and was being widely used in the market for a variety of products since 1967.

Further, the Court noted that the Copyright Authorities failed to conduct an exercise as per Section 45(1) of the Copyright Act, according to which the application seeking registration must be accompanied by a certificate from the Registry of Trademarks to the effect that no trademark identical and/or deceptively similar to such artistic work has been registered under the Trademarks Act. [*The Polo/Lauren Company L P v. Sandeep Arora* – Judgement dated 1 February 2022 in C.O.(COMM.IPD-CR) 4/2021, Delhi High Court]

Trademark 'CASINOS PRIDE' not infringes marks 'BLENDERS PRIDE' and 'IMPERIAL BLUE' but there is *prima facie* case of passing off

The Delhi High Court has held that though the mark 'CASINOS PRIDE' of the defendant, used in respect of a whiskey, *prima facie* does not infringes the marks 'BLENDERS PRIDE' and 'IMPERIAL BLUE' of the plaintiff, respectively, because of the proscription contained in Section 17 of the Trademarks Act, 1999 and for want of imitation of a sufficient number of prominent

essential features, there is *prima facie* case of passing off. The Court noted that the superimposition of the 'CASINOS PRIDE' label on a specific trade dress had the possibility of making the unwary customer believe that the defendant's mark was a cheaper product from the plaintiff's brewery.

On alleged infringement of the mark 'BLENDERS PRIDE', the Court noted that the plaintiff cannot claim exclusivity over the 'PRIDE' part of the mark as it was hit by Section 17(2)(b), because it is not distinctive in nature. It also noted that 'PRIDE' was a word of common usage and cannot be treated as being capable of distinguishing the product of the plaintiff from that of any other manufacturer of whisky. Observing that the right of the plaintiff, under Section 17(1) would be to the 'BLENDERS PRIDE' mark as a whole, the Court also rejected the plea that the word 'PRIDE' was dominant and hence overcomes the vigour of Section 17. It noted that the test of discerning the dominant part in a mark is, essentially, a 'plain glance' test.

In respect of alleged infringement of the mark 'IMPERIAL BLUE', the Court noted that the plaintiff did not possess any registration in respect of the colours used in its 'IMPERIAL BLUE' mark, or in any individual part of the design, including the dome shape. It was of the view that any claim to exclusivity would again infract Section 17(2) and that the individual elements of the plaintiffs registered marks, such as the blue colour, the golden dome, or the arrangement of letters on the label, or even the shape of the bottle, had not acquired secondary meaning. Rejecting the plea of copying of essential elements, the Court noted that the most essential feature in any label would be the name of the product. It observed that the arrangement of letters and overall appearance was not deceptively similar, especially where the names of the products were completely dissimilar.

However, upholding the plea of passing off, the Court noted that the coincidences between the products were too many. It noted that the defendant's mark was used in the form of white colours on a blue background, similar to the colour combination in which the plaintiff packaged and marketed its whisky. Further, the defendant's product also contained a golden dome shaped design, which was present on the plaintiff's label while the shape of the defendant's bottle was also identical to that of the plaintiff. The High Court also observed that it was open to the plaintiff to show that, by combining distinctive features of different marks of its goods, the defendant was seeking to create an overall picture of association between the products of the defendant and the plaintiff. [*Pernod Ricard India Private Limited v. Frost Falcon Distilleries Limited* – Judgement dated 2 March 2022 in CS (COMM) 94/2021, Delhi High Court]

Ex-parte ad-interim injunction against unknown persons not permissible

The Delhi High Court has dismissed the appeal filed against a Trial Court Order declining to grant an *ex-parte* ad interim injunction and appoint a Local Commissioner in a case where the defendants (alleged infringers) were not known.

The Trial Court had instead directed summons to be issued to the defendant. The High Court rejected the plea that when the identity of the infringers of the registered trademarks of the appellant, viz. 'HUGO BOSS', 'BOSS', 'HUGO' and other BOSS/HUGO formative marks for its products was unknown, there was no occasion for the Trial Court to have directed issuance of summons. Reliance in this regard was placed by the Court in its decision in the case of *Januki Kumari J.B. Rana v. Ashok Kumar* [2017 SCC OnLine Del 7533].

All decisions as relied by the appellant were distinguished by the Court observing that there were other known defendants and only one of the defendants was named as 'Ashok Kumar' to represent all other unknown infringers of trademark. The appellant had pleaded that till the Local Commissioner went to the addresses given, the identity of the infringers would not be known and it is only once the person(s) from whose premises counterfeit products were seized would come to the court, the suit would proceed against them and summons served to them. [*Hugo Boss Trade Mark Management GMBH v. Ashok Kumar* – Judgement dated 23 February 2022 in FAO-IPD 5/2022, Delhi High Court]



News Nuggets

Trade mark 'STANDARO' deceptively similar to mark 'STANDARD'

The Delhi High Court has confirmed its earlier *ex parte* interim order against use of the mark 'STANDARO' along with a triangular logo which according to the Court was deceptively

similar to that of the prior mark 'STANDARD' of the plaintiff. The Court noted that both were written in the same font, the same colour and in uppercase, and a reader may end up reading the word 'STANDARO' as 'STANDARD'. It also noted that the triangular

logo used by the defendant [REDACTED] was deceptively similar to that of the plaintiff's [REDACTED] logo. Confirming its earlier order, the Court also noted that packaging and the trade dress also, where also the aforesaid marks/logos and blue and white colour scheme were used, show a great degree of similarity. Holding that there was *prima facie* case of infringement and passing off considering the overall similarity, the Court noted that there was likelihood of confusion being caused in the mind of consumers. The Court in *Havells India Limited v. L Ramesh* [Judgement dated 24 February 2022] also rejected the defendant's contention that the plaintiff was no longer using the aforesaid trademarks. It noted that the marks were still registered in favour of the plaintiff who was free to use them whenever it desires.

Review not maintainable when error is on account of alleged misunderstanding of pleadings

Observing that the grievance of the petitioners/defendants were fundamentally that the Court had fallen into error on account of the misunderstanding of the pleadings, the Delhi High Court has held that review would not be maintainable. Relying upon Supreme Court's decision in the case of *Kamlesh Verma v. Mayawati* [(2013) 8 SCC 320] which had summarised the principles governing review petitions, the Court observed that the same relief, as sought while arguing the main matter, was sought in this review petition, namely, the rejection of the prayer of the respondent to produce the documents. Observing that throughout, the emphasis of the petitioner was on the erroneous understanding of the pleadings of the parties, which, had resulted in erroneous conclusions, resulting further in erroneous decisions, the High Court held that

a rehearing is not possible to correct all these 'errors'. The High Court in *Koninklijke Philips N.V. v. Vivo Mobile Communication Co. Ltd.* [Order dated 15 February 2022] reiterated that such a re-hearing and re-appraisal of the material on record including pleadings would fall within the scope of an appeal and not review.

Copyrights – YouTube Channel is similar to a company owned exclusive showroom

In an interesting case of ownership of a YouTube channel, the Delhi High Court has held that the defendant in the suit had no right to pull down the videos of the plaintiff after the last Agreement came to an end because the uploading of the videos of the plaintiff on its own behalf could not conceivably result in copyright violations. On ownership, the Court rejected the contention that the creation of the channel was akin to the setting up of an exclusive showroom. It was the defendant's case that once the agreement for posting the contents on the channel came to an end, the channel would continue just as in the case of an exclusive showroom for a product, such as, shoes, clothing, etc. and hence once the agreement comes to an end, the brand moves out, but the premises remain with the owner. The Court in *Frankfinn Entertainment Company Pvt. Ltd. v. Unisys Infosolutions Pvt. Ltd.* [Judgement dated 2 March 2022] however held that the view is not apposite and that the channel having an absolutely different purpose would rather be more similar to a company-owned exclusive showroom, owning the premises as well as the stocks.

Trademarks and law of inheritance

The Delhi High Court has confirmed its earlier view of *prima facie* infringement of trademark 'MOTI MAHAL' by the defendant who was the

son of the plaintiff. The Court in this regard observed that Section 6 [as it existed prior to the 2005 amendment] of the Hindu Succession Act would only be applicable if the original owner (father of plaintiff) of the trademark had interest in a Mitakshara coparcenary property or the property of HUF. The High Court also noted that even if the trademark was an ancestral/coparcenary property of the original owner, since he had left behind a female Class-I heir, being plaintiff no. 3, in view of the proviso to Section 6, the interest of the original owner in the coparcenary property would devolve by intestate succession and not by survivorship. As the defendant was found to have no right in the aforesaid trademark under the succession laws, reliance by the defendant on Section 24 of the Trade Marks Act, 1999 [relating to joint ownership] was also rejected.

No exclusive right over laudatory word ‘super’ even if ‘super cutes’ registered

The Delhi High Court has dismissed an application for interim relief in a dispute involving petitioner’s ‘SUPER CUTESTERS’, ‘SUPER CUTES’ and ‘SUPER CUTEZ’, used in respect of baby diapers, and the defendant’s ‘SUPER PANTS’ for the same product. The Court observed that the word ‘super’, which was used in a laudatory/descriptive manner was not an essential/distinctive part of the trademark of the plaintiff, and therefore, the plaintiff cannot have an exclusive right or monopoly over the right to use the said word. It also noted that

the word ‘super’ was devoid of any distinctive character and was not capable of distinguishing the goods of the plaintiff. The High Court in *Soothe Healthcare Private Limited v. Dabur India Limited* [Judgement dated 3 March 2022] also noted many dissimilarities between the marks and the trade dresses.

IPD suits – No separate application required for exemption from entering pre-institution mediation when urgent interim relief sought

The Delhi High Court has directed that in suits filed before the Intellectual Property Division (‘IPD’), wherein applications for interim injunction are filed and urgent interim relief is sought, leave seeking exemption from entering into pre-institution mediation and settlement with the Defendant must be presumed in view of the language of Section 12A of the Commercial Courts Act, 2015. As per Section 12A, if a suit does not contemplate any urgent interim relief, it cannot be instituted unless the party suing has exhausted the remedy of exploring mediation at the pre-litigation stage. According to the Court, a separate application would not be required where ever urgent interim relief is being sought by the Plaintiff. The Court in *Upgrad Education Private Limited v. Intellipaat Software Solutions Private Limited* [Order dated 28 February 2022] however also observed that even if urgent interim relief is sought by the Plaintiff but the Court is of the opinion that the parties ought to be relegated to mediation, an order referring the matter to mediation can always be passed.

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