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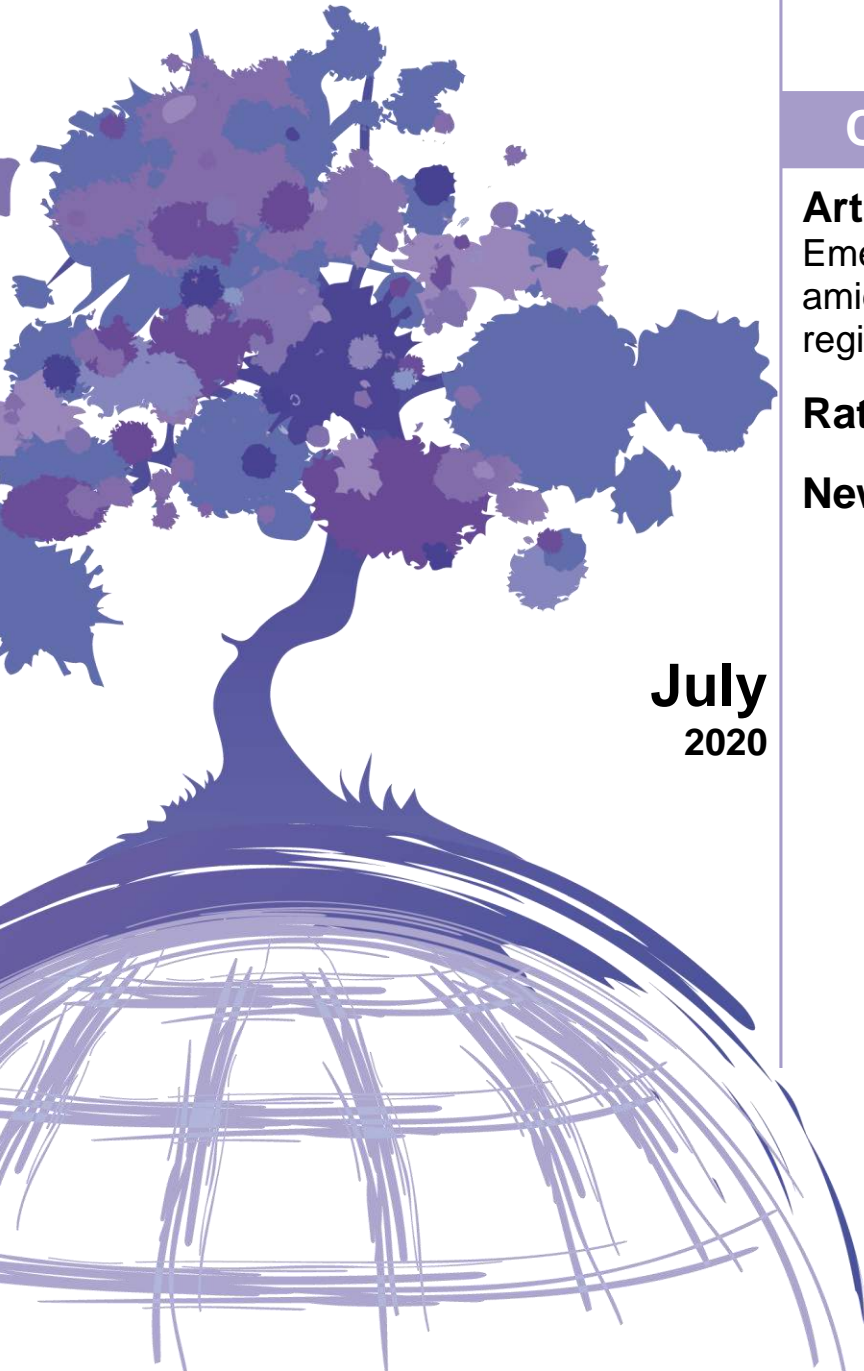
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Article

Emerging preferences in trademarks amidst COVID-19 – Analyses of registrability and other related issues

By **Anusha Das**

Since February 2020, the Covid-19 (also known as Coronavirus) pandemic has been the major talking point around the world and has resulted in many common words and phrases coming into existence. For instance, words like 'Covid', 'Coronavirus', 'Self-isolation', and 'Patient-Zero' are being widely used with reference to the pandemic. Consequently, such pandemic referenced words are being used as trademarks and are filed for registration at Trade Mark Registries worldwide. Since distinctiveness is one of the primary features that characterizes a trademark, individuals and companies seeking to use such marks are now caught in a race to get their marks registered. In this article, I have analyzed the various registrability issues pertaining with 'Covid' or 'Corona' referenced trademarks filed in India and other related issues that may pose difficulties in seeking the registration.

Corona/Covid related trademarks in India

As per the data available on the website of the Indian Trade Marks Registry, more than 150 'Corona'/'Covid' related trademarks have been filed in different classes post March 2020.

As expected, several pharmaceutical companies have filed trademark applications as they are developing medicines and vaccines to combat the virus. Majority of the applications have been filed on a proposed to be used basis

and under Class 5 of the Nice Classification with respect to medicinal and pharmaceutical preparations. As per the Trade Marks Registry website, Glensmith Labs was the first company to file a pandemic referenced trademark '**COVID-RELIEF**' on 5-03-2020. Bharat Biotech being one of the six companies working on the development of Covid vaccines was the next to file '**COVIDAC**' (12-03-2020) and '**COROFLU**' (19-03-2020) for their vaccines and medicinal preparations. Other early notable filings include '**COVIDIUM**' by Swiss Garner Life Sciences filed on 13-03-2020 and '**COVIDROXYL**' filed by Alkem Laboratories on 30-03-2020. Some of the other trademarks subsequently filed for medicinal and pharmaceutical preparations include '**FAVICOID 200**', '**COVIDANG-D3**', '**COROSHIELD**', etc.

It is interesting to note how some proprietors have strategically filed certain Covid/Corona referenced trademarks in other classes as well (Classes 3, 9, 10, 25, 28, 29, 30, 35 and 42) with the intention to create an impression that the goods and services sold under such trademarks may prevent consumers from contracting the virus. Few of the goods applied under such trademarks include sanitizers, cosmetics, bodywash, toilet cleaner, handwash, phenyl, soap, cleaning masks for the face, disinfectants, bleaching properties to be used for laundry purposes, polishing, scouring and abrasive preparations, masks, gloves, testing kits,

diagnostic kits, and surgical apparatus - the list is endless. Apart from the above, few trademark filings have also been made for completely unrelated goods, for example, 'COVID-19 MASK' has been applied for laptop bags, computer bags, mobile phone cases, covers, etc. Similarly, few filings containing the term 'CORONA' have been made for clothing, footwear and peculiarly for mouth fresheners. Such filings indicate nothing but opportunistic marketing on the part of the proprietors who are trying to benefit from the situation.

Registrability of Corona/Covid related trademarks in India

As per Section 9 and 11 of the Trade Marks Act, 1999, a trademark application can be refused registration on either absolute or relative grounds, respectively.

Section 9(1)(a) of the Trade Marks Act – marks not capable of distinguishing the goods of one person from those of another

Section 9(1)(a) of the Trade Marks Act, 1999 states that no mark is registrable unless 'it is distinctive and capable of distinguishing the goods or services of one person from those of another person'. The ability to distinguish the goods or services of one proprietor from those of others is an important aspect and requirement for registration of a trademark. Therefore, a trademark containing generic wordings lack such a character and are liable to be refused.

In current times, the term 'Corona'/'Covid' has become a household word in India and any mark having identical/ similar wordings may be objected under Section 9(1)(a) of the Trade Marks Act, 1999.

Section 9(1)(b) of the Trademarks Act 1999 - Descriptive in nature

As per Section 9(1)(b) of the Trade Marks Act, 1999, a trademark consisting of marks or

indications that may serve in trade to designate the characteristics of the goods or services shall not be allowed registration. Examples of such characteristics of the goods or services include kind, quality, quantity, intended purpose, values, geographical origin or the time of production of goods or rendering of the service or other characteristics of the goods or services. Thus, trademarks containing any pandemic referenced wording(s) applied for certain goods may be objected for having an indication towards the virus.

Section 9(2)(a) of the Trademarks Act 1999 - Likely to deceive the public or cause confusion

Section 9(2)(a) provides that any mark that creates deception or causes confusion in the minds of the public shall be denied registration. Considering the current situation, there is a strong likelihood that any trademark containing the term 'Corona' or 'Covid' or any deceptively similar mark may create confusion or deceive the public into believing that the goods or services provided under such marks provide cure or can be useful in providing protection from the virus, which in most cases may not be true.

For example, some proprietors have filed for trademarks containing the terms 'Corona Preventive' and 'Corona Warrior' for food items. Such trademarks may create an impression that the goods covered under them have dietic or therapeutic substances that may help in providing cure or protection from the virus. Further, such trademarks may not only create confusion in the minds of the public but also add on to the misinformation existing in the society. Besides, dietic supplements are governed by the Food Safety and Standards Act, 2006 and sale of products bearing such trademarks falls under the category of 'misbranded food' for having 'false,

misleading or deceptive claims' and is a punishable offence. Likewise, of the use of similar trademarks for medicines and cosmetic products, may be in contravention of the Drugs and Cosmetics Act, 1940 for being sold as 'misbranded drugs' and 'misbranded cosmetics', respectively.

Section 11 of the Trade Marks Act 1999 - Objectionable in the light of marks already existing on the Register

There are many proprietors who have registered or applied for Corona/Covid formative marks in many classes prior to the outbreak of the virus. Section 11 of the Trade Marks Act, 1999 bars registration of identical/similar marks that may cause confusion in the mind of the public on the basis of an earlier existing trademark.

On a related note, it is also pertinent to mention that a proprietor may obtain rights over a trademark by being the first one to commercially use the trademark, even prior to registering the trademark. In such a case, industries that were allowed to or were able to operate in the early months of lockdown may get an advantage over the others who may not have been able to operate and thus commercially use *their* trademark. For instance, few companies have started sale of sanitizers¹² and protective gears under pandemic referenced marks. Given, the government's relaxed permission to distilleries and manufacturers for production of hand sanitizers to meet the increasing demand, it may be possible that multiple new proprietors may have started selling sanitizers under such marks without registration. This may lead to a surge in new filings and possible oppositions post the

publications of such marks in the journals by the Trade Marks Registry.

Impact on the already registered trademarks and registered company names

As of today, approximately around 50-70 trademarks containing the term 'Corona'/ 'Covid' or trademarks having visual or phonetic similarity to said words stand validly registered in different classes and over 50 company names containing the term 'Corona'/ 'Covid' are registered in India across all states. But, given the stigma associated with the words, not all company owners would appreciate having a linkage to the virus and may thus opt for rebranding their names fearing future losses. A similar approach was adopted by Tata Motors when it renamed its car 'ZICA' to 'TIAGO' before its launch to avoid any connection with the ZIKA virus outbreak that took place in 2015. Another interesting point to ponder here would be regarding the fate of the marks that have already secured registration. It may be interesting to see whether such registered marks are cancelled on the grounds of loss of distinctiveness³ or potential to cause confusion considering the change in situation. In normal circumstances, an action to cancel a registered trademark is initiated by an 'aggrieved person' under Section 57 of the Trade Marks Act 1999. Further, the Registry can also *suo moto* initiate cancellation proceedings against such registered trademarks under Section 57(4) of the Trade Marks Act 1999 read with Rule 100 of the Trade Marks Rules 2017. It would be interesting to see if cancellation of trademarks having any 'Corona'/ 'Covid' are taken up by the Registry.

¹ <https://www.indiamart.com/proddetail/corosafe-hand-sanitizer-22152556048.html>

² <https://www.shopclues.com/alcorub-hand-sanitizer-100-ml-instantsanitizer-149395523.html>

³ Geekay Enterprises Vs. Hemant Haricharan Goel 2012(50)PTC 156(IPAB)

Rise of fraud and phishing activities using Corona/Covid related domain names

Instances of fake coronavirus websites operating in India and worldwide have been in the news since March 2020. Delhi Police's cybercrime unit on 25-03-2020 shared on Twitter a list of 13 different links⁴ trying to scam in the name of coronavirus and cautioned users not to use the links. Further, India's nodal cyber security agency, Indian Computer Emergency Response Team (CERT-In) on 21-06-2020 has warned everyone against an imminent cyber attack and have cautioned users to refrain from clicking on emails coming from a particular account ncov2019@gov.in with the subject line 'Free COVID-19' testing⁵. Check Point Research, a global cyber threat intelligence provider while speaking to The Times of India confirmed that almost 20,000 new coronavirus related domains were registered globally including India in the first three weeks of May.⁶ While some of them may be for legitimate purposes to be used by governments, individuals, and corporates, most of these domains are probably malicious that may have been created for the purposes of outright fraud and phishing. In another instance, within minutes of the announcement of The Prime Minister's Citizen Assistance and Relief in Emergency Situations Fund on 28-03-2020 for the coronavirus outbreak and similar pandemic like situations in the future, 'half a dozen' similar sounding websites were created such as 'PM-care' etc.⁷

⁴ <https://www.theweek.in/news/india/2020/03/27/Beware-of-these-dangerous-coronavirus-websites-say-Delhi-Police.html>

⁵ <https://economictimes.indiatimes.com/tech/internet/cyber-attacks-in-india-surge-since-lockdown/articleshow/76591994.cms>

⁶ <https://timesofindia.indiatimes.com/india/4-lakh-corona-related-e-attacks-in-2-weeks/articleshow/75728726.cms>

⁷ <https://economictimes.indiatimes.com/tech/internet/cyber-chiefs-warning-as-hackers-target-pms-covid-fund/articleshow/74877953.cms?from=mdr>

Steps taken by other countries regarding examination of trademark filings related to the pandemic

United States of America

The USPTO *vide* an official notice⁸ dated 15-06-2020 has announced that it will accept petitions to advance the initial examination for trademarks used to identify qualifying COVID-19 medical goods and services. To qualify for this new program, the applicant must apply for one or more medical goods that is subject to U.S. Food and Drug Administration (FDA) approval for use in the prevention and/or treatment of COVID-19 or a medical service or medical research service for the prevention and/or treatment of COVID-19. Applicants who wish to avail this service are required to first file the application and then file a petition to the Director accompanied by an affidavit setting forth the Applicant's COVID-19 medical goods or services and an explanation of why the goods or services qualify for prioritised examination.

China

The China National Intellectual Property Administration ("CNIPA") has also taken prominent steps to take action against malicious filings related to the pandemic. CNIPA *vide* an official notice⁹ dated 27 February 2020 formulated guidelines for the Examination of Epidemic Prevention and Control Related Trademarks.

In the same notice, CNIPA specifically mentioned filings with respect to Vulcan Mountain Hospital, Raytheon Mountain Hospital and Doctor LI Wenliang. The two hospitals were constructed in Wuhan in just weeks after the pandemic broke out in China and were frontline hospitals fighting the epidemic. Dr. Li was the first doctor to warn

⁸ <https://www.uspto.gov/sites/default/files/documents/TM-COVID-19-Prioritized-Examination.pdf>

⁹ http://sbj.cnipa.gov.cn/gzdt/202002/t20200227_312227.html

about the emergence of the novel virus back in December 2019, he later died after contracting the virus. The CNIPA said that registrations creating confusion with the above names may cause significant social adverse effects and will be rejected according to law. They also stated that up to 27-02-2020 they had exercised control over nearly 1,000 trademark registration applications related to the pandemic.

On 4-03-2020¹⁰, the CNIPA published a detailed list of the 63 trademark applications rejected for being related to pandemic-related terms and on 5-03-2020¹¹ announced the rejection decisions against 37 'Li Wenliang'-related trademark applications.

By 18-03-2020¹², the CNIPA had rejected 328 trademark applications related to the pandemic.

Conclusion

In light of the above, now that the Indian Trade Marks Registry has slowly started to resume its operations after the nation-wide lockdown, it will be interesting to see if it also comes up with new guidelines for examination of similar pandemic referenced trademarks.

[The author is a Consultant in IPR practice in Lakshmikumaran & Sridharan, New Delhi]



Ratio decidendi

No passing off by use of words 'Magical Masala' allegedly similar to 'Magic Masala', both used for same food product

The Madras High Court has dismissed a suit for alleged passing off by the defendant by use of the words 'Magical Masala' which were similar to the words 'Magic Masala' used by the plaintiff for the same product (instant noodles). It held that even though there was phonetic similarity between the word 'Magic' used by the plaintiff and the word 'Magical' used by the defendant, nevertheless they were incapable of being monopolised as they were not only laudatory but also common to the trade.

The Court was of the view that neither the plaintiff nor the defendant can claim any monopoly over the expression 'Magic' or 'Masala' for they are common words in Indian culinary and Indian food industry and were also used by different manufacturers of different brands of 'Masalas'. It held that it was difficult to conclude that the defendant had copied the plaintiff's sub-brand 'Magic Masala' as it was never conceived as a brand or trademark by the plaintiff but was used to name the flavour only. It noted that the respective labels of the plaintiff and defendant were quite different in overall colour, scheme, get up, layout and trade dress, and that there was no scope to infer passing off from an ocular or visual comparison of the two labels.

¹⁰ http://sbj.cnipa.gov.cn/tzgg/202003/t20200304_312498.html

¹¹ http://sbj.cnipa.gov.cn/tzgg/202003/t20200305_312520.html

¹² <https://www.hg.org/legal-articles/china-punishes-bad-faith-trademark-applications-regarding-coronavirus-55307>

The High Court held that though the adoption of the expression 'Magical Masala' by the defendant was inspired from the adoption of the expression 'Magic Masala' and success of the plaintiff, the plaintiff cannot claim any advantage. It noted that the defendant was using the word 'Magic' prior in time in respect of its various products and had around 75% market share in the concerned product (instant noodles). [*ITC Limited v. Nestle India Limited* – Judgement dated 10-06-2020 in C.S.No.231 of 2013, Madras High Court]

Trademarks 'LABEBET' and 'LULIBET' are phonetically, visually and structurally similar

In a case involving alleged infringement of the trademark 'LABEBET' of the plaintiff by the defendant's mark 'LULIBET' – both being used for pharmaceuticals, the Delhi High Court, after comparing the two marks as a whole, has held that the mark of the defendant was phonetically, visually and structurally, similar to that of the plaintiff. The Court was of the view that a person of average intelligence and imperfect recollection is likely to be deceived or confused. Relying on the Supreme Court decision in *Cadila Health Care Limited v. Cadila Pharmaceuticals Ltd.*, it was noted that if medicinal products are involved, the test to be applied would be stricter than it should be applied for non-medicinal products.

The Court rejected the plea of absence of confusion since plaintiff's drug was sold in the form of tablet/injectable form and the defendant's drug was sold as lotion/cream. It observed that both the drugs were sold through common retail shops and that similarity of the marks cannot completely rule out the possibility of deception or confusion. Delhi High Court decision in the case of *Kalindi Medicure Pvt. Ltd. v. Intas Pharmaceuticals Ltd.*, was distinguished. It may be noted that the defendant had also pleaded that its product contains the molecule Luliconazole and hence the prefix LULI, while the

plaintiff's mark 'LABEBET' was not a coined word but merely based on salt/molecule derived from active ingredient Labetalol.

The Court also held that non-opposition of the application of the defendant before the Trademark Registry does not mean that the defendant can continue to violate the trademark of the plaintiff in violation of the Trade Marks Act, specially Sections 28 and 29 thereof. Granting decree of permanent injunction, the Court also rejected the plea of delay. It stated that the delay would not be sufficient to deter grant of injunction in favour of plaintiff as it could not be said that the plaintiff stood by knowingly and let the defendant build up its business. [*Sun Pharma Laboratories Limited v. BDR Pharmaceuticals International Pvt. Ltd.* – Judgement dated 05-06-2020 in CS(COMM.) 757/2017, Delhi High Court]

Trademarks – No locus to file petition under Section 124 if no pleading made on invalidity of mark

The Madras High Court has held that a party who has not challenged framing or non-framing of the issue with regard to invalidity of registration of a trademark, in appeal or revision within the period of limitation prescribed or within a reasonable time and had allowed the matter to settle down, is estopped from raising additional issue of invalidity of the trademark by subsequent pleadings. Observing that the defendant had not raised any clear, valid material proposition as to the invalidity of registration of the trademark throughout his pleadings and in the petition seeking extension of time, the Court held that filing of a petition under Section 124 of the Trade Marks Act, 1999 itself was not maintainable. Principles of constructive res-judicata and abandonment of rights, were also invoked in this regard.

Observing that in the case, a civil suit came into being even before the statutory authority was

approached, it held that maintainability of rectification application was contingent on framing of an issue by the civil court as to the invalidity of the trademark, and if no such issue was framed, the only course available was to challenge the order of the Civil Court in appeal. The Court was also of the view that change of legal position will not entitle a party to raise an additional issue without specific pleading as to invalidity of the trademark registration. It also held that failure to raise objections as to registration and continuance of the trademark in the main as well as subsequent pleadings, even after filing rectification application, amounts to admission of validity of registration. Supreme Court decision in the case of *Patel Field Marshal* [2018 (2) SCC 112], was relied upon. [*M. Murali v. Sri Krishna Sweets Private Limited* – Judgement dated 27-05-2020 in CRP Nos.2463, 2464 and 2472 of 2019 & C.M.P.Nos.16163,16172 and 16179 of 2019, Madras High Court]

Civil Court's jurisdiction barred in copyright suit arising from insolvency resolution plan

In an interesting case of intersection of insolvency and copyright laws, the Delhi High Court has held that the suit for alleged infringement of copyrights, arising out of and/or is in relation to the insolvency resolution plan of a corporate debtor must be adjudicated by the NCLT and that the proceedings in the Civil Court are barred. The suit was dismissed as not maintainable before the High Court in view of Sections 230 and 231 read with Section 60(5) of the Insolvency and Bankruptcy Code, 2016. The dispute in the present case was between the copyright holder (plaintiff) and the company (defendant) which had acquired the corporate debtor to whom the engineering drawings

covered by the copyrights were supplied under a conditional and limited license for use.

The Court though held that the dispute falls within the ambit of Section 60(5) of IBC, as the same arises out of and/or is in relation to the insolvency resolution plan, it noted the plaintiff's contention that in the absence of an assignment or a license in writing by the plaintiff, the defendant (company which acquired the corporate debtor to whom the licence for use was given by the plaintiff) did not automatically have a right on the assets of the plaintiff which were not even the assets of the corporate debtor. The Court however found the suit not maintainable because of the absence of the necessary parties i.e. the corporate debtor.

The High Court however rejected the defendant's plea of lack of territorial jurisdiction. It observed that though neither the plaintiff nor the defendant may be residing or working for gain in Delhi, since the copies of the plaintiff's purported work were put on the web portal and circulated to the public including the public in Delhi, it would give rise to cause of action at Delhi. It observed that in a suit alleging infringement of the copyright, the cause of action would arise in the forum state where the infringement of the copyright in terms of the Copyright Act would take place. Supreme Court's decision in the case of *Oil & Natural Gas Commission v. Utpal Kumar Basu*, was distinguished by the Court while it held that cause of action was uploading the drawings on the computer systems at Delhi and disclosure of the drawings of the plaintiff to the public which all amounts to infringement of the plaintiff's copyright giving rise to cause of action under Section 20 of the Copyright Act. [*GE Power India Ltd. v. NHPC Limited* – Judgement dated 26-06-2020 in CS (COMM) 140/2020, Delhi High Court]

Trademarks – Importance of prior registration; Interim relief when similar suit by defendant pending in another Court

Observing that whether or not the plaintiff was the prior user of the mark, it was admittedly the prior registrant of the mark, for the class of goods for which the mark was being used, the Delhi High Court has held that the same is a very strong indicator in favour of the plaintiff and against the defendant. The Court also reiterated the position that even if the plaintiff, on account of being sick, at one stage did not use the mark, the same would not show an intent of the plaintiff to abandon the mark so as to allow another to stop it from using the mark. It observed that since the time of registration and claimed user, the plaintiff was using the mark 'JINDAL', while the defendant, though earlier was using the marks 'Y.R. Jindal' and 'Jindal Co.', it, without any explanation, dropped the prefix and suffix to the word 'JINDAL', to make its mark identical to that of the plaintiff. Granting the interim relief, the High Court directed the defendant to not use the mark 'JINDAL' till the disposal of the suit, but to use the same in conjunction with the acronym 'Y.R.' which was indicative of the faction of the Jindal family from which the goods originated.

Relying on Section 10 of the Code of Civil Procedure, the Court stayed the proceedings in this suit, awaiting the outcome of the suit instituted by the defendant against the plaintiff at Hyderabad. It however was of the view that that an interim arrangement ought to be made to ensure clarity in the mind of consumers and others dealing with the plaintiff and the defendant and to prevent chaos from prevailing in the market by perpetuating the deception of the customers for more time, till the trial in the Hyderabad suit is concluded and various issues

arising for adjudication are adjudicated. [*Shree Ganesh Rolling Mills (India) Ltd. v. Jindal Rolling Mill Ltd.* – Judgement dated 10-06-2020 in CS(COMM) 360/2016, Delhi High Court]

Domain name registrar cannot block access to domain name – Can only be asked to suspend registration till end of registration period

In a case involving prayer for directions to the domain name registrars for 'continued suspension of domain name registration' and 'blocking of access' to some fraudulent domains, the Bombay High Court has held that a domain name registrar cannot 'block access' to a domain name and can only be asked to suspend the registration till the end of registration period.

In respect of blocking of access to specific domain names, it observed that it is entirely unworkable to ask a domain name registrar to 'block access' to a domain name and that only an internet service provider (intermediaries who provide internet connectivity) can be requested to not honour access requests to a particular domain name or URL. The Court also opined that any direction to block access to domain names in overseas servers can be easily circumvented by masking the originating country IP of the user with the help of any commonly available Virtual Private Network ('VPN') products, thus failing the India-specific access restrictions imposed on domestic internet service providers. According to the Court, '*other than lulling an applicant into a completely hollow and faux sense of safety and giving some ill-informed government functionary an entirely unwarranted sense of power or authority, blocking access achieves next to nothing*'.

The Court was also of the view that prayer for 'continued suspension' of domain name registration is also technically incorrect as the entire process of registration itself is entirely

automated and machine-driven. It noted that no domain name registrar can put any domain name on a black list or a block list. The Court observed that once the present registration is suspended, the suspension will continue until the end of the registration period plus the cooling-off period and that once the domain name is released from

registration by one domain name registrar, any person can then get a registration through any other registrar or even the very same registrar. [*Hindustan Unilever Limited v. Endurance Domains Technology LLP* – Order dated 12-06-2020 in Interim Application No. 1 of 2020 in LC-VC-GSP-24 OF 2020, Bombay High Court]



News Nuggets

Trademarks – Statements in media regarding evaluating legal action, amount to threat

The Bombay High Court has directed the Defendant (M/s. Emami) to give at least 7 clear days prior written notice to the Plaintiff (M/s. HUL) before initiating any legal proceedings in any Court or claiming any interim or *ad interim* reliefs against the Plaintiff as threatened in the statements issued / made on behalf of the Defendant against the Plaintiff's use of the trademark 'GLOW & HANDSOME'. The Single Judge observed that the Plaintiff having filed its trademark application in September 2018 and subsequently on 25-06-2020 for the disputed mark, were *prima facie* the prior adopter of the said mark. It noted that the Defendant had adopted the mark for the first time on 25-06-2020 and had not commercially used it till date of hearing (06-07-2020). The Court in the case *Hindustan Unilever Limited v. Emami Limited* also noted that the statements made by the Defendant (on evaluating legal action) and published in various newspapers did amount to a threat, however whether they were unlawful or groundless will have to be decided after hearing both the sides.

ISKCON is a 'well-known' trade mark in India

ISKCON is a 'well-known' trade mark in India within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999. While holding so, the Bombay High Court observed that the trademark enjoys a personality that is beyond the mere products/services rendered thereunder and the recognition, reputation and goodwill of the said trademark is no longer restricted to any particular class of goods or services. The Court also noted that the mark has wide acceptability and its popularity extends even beyond India. Further, observing that the plaintiff was using the mark continuously and had taken several actions against infringers in the past, the Court in the case *International Society for Krishna Consciousness (ISKCON) v. Iskcon Appaeral Pvt. Ltd.* [Order dated 26-06-2020] held that the mark 'ISKCON' satisfied the requirements and tests of a well-known trademark as contained in Sections 11(6), 11(7) and other provisions of the Trade Marks Act, 1999.

Taking suit for trial while keeping interim relief application pending

In a case where the plaintiff had sought for interim relief and the defendant had also filed an application for interim injunction restraining the plaintiff from commenting in any media on the dispute between the parties, the Division Bench of the Madras High Court has upheld the Order of Single Judge directing for appointment of an individual Scientific Advisor to assist the Court. The Court in its judgement dated 04-06-2020 in the case of *Sun Mobility Private Limited v. Arumugam Rajendra Babu* rejected the plea of the defendant/appellant that since the Scientific Advisor may take time to submit a report, till such time, the applications seeking interim injunction be kept pending and the suit be taken up for trial. The defendant had also pleaded that if in the meantime a report is filed, it shall be taken into consideration for the purpose of deciding the suit. The Court however held that it is open to the appellant to approach the Single Judge seeking such prayer.

Combination of a generic word with .com when not generic

The Supreme Court of the United States has rejected the contention of the US PTO that combining the generic word like 'booking' with '.com' yields a generic composite. Concurring with the Judgement of the District Court as well as the Appellate Court in this case, the Supreme Court held that a term styled 'generic.com' is a generic name for a class of goods or services only if the term has that meaning to the consumers. The Court noted that the consumers, according to lower court determinations which remained uncontested by the PTO, did not perceive the term 'Booking.com' to signify online hotel-reservation services as a class. According to

the Court, in such circumstances, a 'generic.com' term is not generic and is eligible for federal trademark registration. Rejecting the PTO's contention that adding '.com' to a generic term, like adding 'Company', conveys no additional meaning that would distinguish one provider's services from those of others, the Court in the case *United States Patent and Trademark Office v. Booking.com B. V.* [Judgement dated 30-06-2020] observed that a 'generic.com' term might also convey to consumers a source-identifying characteristic as only one entity can occupy a particular internet domain name at a time. It was also held that competitive advantages, do not inevitably disqualify a mark from federal registration.

Patents – Teaching enabling skilled person to make some product and not all within the scope of claim not passes 'sufficiency' test

The United Kingdom's Supreme Court has held that, in a case involving product patent, if the teaching enables the skilled person to make only some of the types of product within the scope of the claim, it does not pass the 'sufficiency' test where the invention would contribute to the utility of all the products in the range, if and when they could be made. The Court was of the view that 'sufficiency' requires substantially the whole of the range of products within the scope of the claim to be enabled to be made by means of the disclosure in the patent. It observed that the contribution to the art is to be measured by the products which can be made at the priority date, and not by the contribution which the invention may make to the value and utility of products, the ability to make which, if at all, lies in the future. The Supreme Court in its

Judgement in the case *Kymab Ltd. v. Regeneron Pharmaceuticals Inc.* [Judgement dated 24-06-2020] allowed the appeal against the Judgement of the Court of Appeal which had held that the invention should be regarded as sufficiently enabled across the range if it can be seen that it will in due course benefit all products in the range, provided that, as at the priority date, the teaching in the patent enables at least one type to be made immediately.

Trademarks – Non-raising of plea of invalidity in written statement, fatal

In a suit for infringement and passing off, where the defendant did not raise the plea of invalidity of the trademark in his written statement, the Delhi High Court has held that the defendant having not done so, cannot wait for years to move an amendment. The Court

did not find any infirmity in the order passed by the Trial Court to the extent that too much water has flown under the bridge since the inception of the suit. Noting that evidence of both the parties already stood concluded, the Court in the case *Apex Shoe Company Pvt. Ltd. v. Baldev Singh* [Judgement dated 22-06-2020] was of the view that permitting an amendment at this stage would completely put the clock back and would be contrary to the mandate of Order 6 Rule 17 of the Civil Procedure Code. The defendant had pleaded that they had no opportunity to raise the issue of invalidity as, admittedly due to the fluctuating legal position on Section 124 of the Trademark Act, they had to withdraw the petition for cancellation filed before the IPAB, and thus the invalidity plea was not adjudicated at all.

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

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

CHENNAI

2, Wallace Garden, 2nd Street
Chennai - 600 006

Phone : +91-44-2833 4700

E-mail : lsmds@lakshmisri.com

BENGALURU

4th floor, World Trade Center
Brigade Gateway Campus
26/1, Dr. Rajkumar Road,
Malleswaram West, Bangalore-560 055.

Ph: +91(80) 49331800

Fax:+91(80) 49331899

E-mail : lsblr@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

AHMEDABAD

B-334, SAKAR-VII,
Nehru Bridge Corner, Ashram Road,
Ahmedabad - 380 009

Phone : +91-79-4001 4500

E-mail : lsahd@lakshmisri.com

PUNE

607-609, Nucleus, 1 Church Road,
Camp, Pune-411 001.

Phone : +91-20-6680 1900

E-mail : ls pune@lakshmisri.com

KOLKATA

2nd Floor, Kanak Building
41, Chowringhee Road,
Kolkatta-700071

Phone : +91-33-4005 5570

E-mail : lskolkata@lakshmisri.com

CHANDIGARH

1st Floor, SCO No. 59,
Sector 26,

Chandigarh -160026

Phone : +91-172-4921700

E-mail : lschd@lakshmisri.com

GURUGRAM

OS2 & OS3, 5th floor,
Corporate Office Tower,
Ambience Island,

Sector 25-A,

Gurugram-122001

phone: +91-0124 - 477 1300

Email: lsgurgaon@lakshmisri.com

PRAYAGRAJ (ALLAHABAD)

3/1A/3, (opposite Auto Sales),
Colvin Road, (Lohia Marg),

Allahabad -211001 (U.R)

phone . +91-0532 - 2421037, 2420359

Email:lsallahabad@lakshmisri.com

KOCHI

First floor, PDR Bhavan,
Palliyil Lane, Foreshore Road,
Ernakulam Kochi-682016

Tel: +91 (0484) 4869018; 4867852

E-mail: lskochi@lakshmisri.com

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