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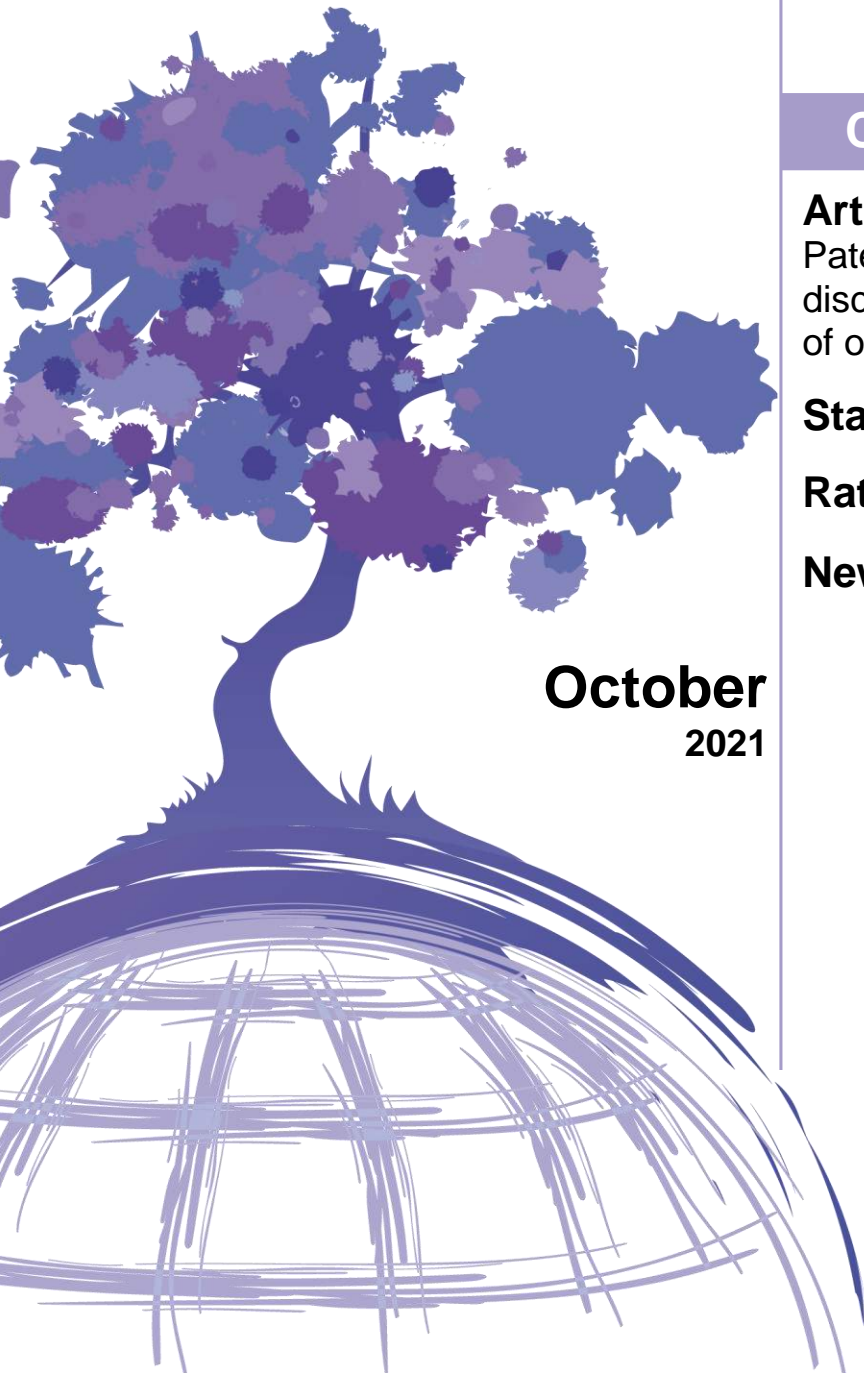
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Article

Patents – Delhi High Court rules on disclosure vis-à-vis invalidity on ground of obviousness

By Archana Viswanathan and Dr. Malathi Lakshmikumaran

Executive summary:

The Delhi High Court *vide* its recent judgement, while deciding the Applications under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 ('CPC'), restrained the defendants in two separate suits- Best Crop Science LLP and NATCO Pharma Ltd. ('Defendants') from **launching** Chlorantraniliprole ('CTPR'), an agricultural insecticide in the market, as it *prima facie* infringed the Plaintiff's, FMC Corporation's ('FMC') patents. FMC, in the said suits, alleged infringement of its **product patent** IN 201307 ('IN'307') and **process patent** IN 213332 ('IN'332').

In a detailed judgement discussing whether an interim injunction should be granted against the Defendants, the Single Judge of the Delhi High Court rejected the challenge, to the validity of the suit patents raised by the Defendants, under several grounds.

The Court declined permission to the Defendants to manufacture and sell CTPR during the pendency of the suit. Finally, the Court opined that the Defendants failed to make a **credible challenge** with respect to the vulnerability of the suit patents.

Facts:

The suit patents in question, IN'307 and IN'332, are both held by FMC. IN'307 relates to the product Chlorantraniliprole ('CTPR') and is due to expire on 13 August 2022. IN'332 is

directed to the process of preparing CTPR. FMC also owns patent IN 204978 (IN'978), which was the impugned patent in the dispute. The compounds in Formula 1 of IN'307 were asserted to be a novel and inventive selection, in comparison to the claims in IN'978 which recite a Markush formula. FMC asserted that although CTPR falls within the scope of the numerous compounds, which is covered under the class of anthranilamides included in the Markush formula disclosed and claimed in IN'978 but, emphasized that CTPR is not specifically disclosed in IN'978. Therefore, no person skilled in the art would be able to synthesize CTPR based on the claim and disclosure in IN'978.

In October 2019, FMC learnt of the imminent launch by the Defendants, of a CTPR product. Thereafter, FMC sought a permanent injunction against infringement by the Defendants of the suit patents IN'307 and IN'332.

On the other hand, while the Defendants agreed that they proposed launching CTPR products in India, they claimed that IN'307 is an invalid patent which must be revoked, and therefore, their products do not infringe the suit patent.

FMC's initial submissions:

FMC asserted that IN'307 claims the actual and precise molecular structure and formula of CTPR, and the method of its preparation. Further, it mentioned that the presence of 3-substituted-2-pyridyl ring, with two substituents

on the phenyl ring, results in compounds with superior insecticidal activity, which was substantiated in the 'Biological Examples of the Invention', in the suit patent. Thus, the suit patents disclose novel anthranilic diamide insecticides which are ryanodine receptor activators.

It also placed reliance on the declaration filed with the U.S. Patent and Trademarks Office (USPTO), during the prosecution of US 7,232,836 (US'836), the US patent corresponding to Indian patent IN'307. The declaration refers to tests conducted to compare the compounds of the IN'307 with their closest compounds disclosed in IN'978, which demonstrated the superior insecticidal activity of the former. Thus, it was asserted that the CTPR is a novel and inventive molecule.

FMC also asserted that a person skilled in the art could not arrive at CTPR from Formula mentioned in claim 22 in IN'978 without human intervention, ingenuity, and application of hindsight knowledge.

Defendants' assertion:

The Defendants contended that CTPR was covered in FMC's earlier genus/Markush patent, IN'978; thus, the validity of the suit patents was questionable, and no injunction could be granted. The Defendants also pointed out that the IN'978 patent had expired on March 20, 2021, therefore IN'307 and IN'332 were invalid *per se*. Hence, the Defendants could not be restrained from commercializing CTPR.

Disclosure vis-à-vis invalidity on the ground of obviousness:

The Defendants assertion was primarily that the CTPR was disclosed by the genus patent, i.e., Claim 22 in IN'978. To support this, three contentions were relied upon, namely, (i) that Section 11(2)(b) of the Indian Patents Act, 1970

(the 'Act') creates a presumption of the existence of disclosure in a patent to which the priority date has been assigned, (ii) that the FMC had admitted, in their submissions, 'coverage' of CTPR by the genus patent; and reliance was made on the judgment of the Supreme Court in *Novartis*¹, wherein it was held that there can be no dichotomy, or distinction, between 'coverage' and 'disclosure' in a patent; and (iii) that the preferred embodiments for Claim 22 in the complete specification of IN'978, when applied to the Markush structure claimed therein, 'led to CTPR'.

Vulnerability of the suit patent IN'307 on the ground of anticipation by prior claiming:

The Defendants contended that Claim 1 of IN'307 fell within the scope of Claim 22 of IN'978 – which includes the claim for the CTPR compound. Therefore, IN'307 would be rendered vulnerable, even if Claim 1 of IN'307 included variants that were outside the scope of Claim 22 in IN'978. In this context, the Defendants concluded that the requirement of the complete construction of the claims in the suit patent and the genus patent, for examining the applicability of Section 13(1)(b) of the Act, is obviated in the present case because of the admission of the coverage of CTPR within Claim 22 of IN'978 by FMC.

The invalidity of suit patent on the ground of anticipation by prior publication and inventive step:

The Defendants based their allegation on the fact that CTPR was within the coverage of the Markush structure of the other related documents, namely, in US'424, US'357, and EP'508 patents, all of which were granted and published before the earliest priority date of IN'978. Hence, they arrived at the conclusion that the suit patent is also vulnerable as it lacks inventive step.

¹ (2013) 6 SCC 1

FMC's response to the defendants' contentions:

Disclosure vis-à-vis invalidity on the ground of obviousness:

FMC responded to the contentions of the Defendants by asserting that IN'978 covers millions of compounds. In any manner, such a Markush claim does not disentitle patenting of any selected compound, which is not recited in the claim, but falls within the scope of the Markush. Thus, if a specific compound is covered in a Markush structure that could nullify the patentability of the said compound, then the concept of genus and species patents would be rendered a nullity. Further, to support the fact that individual species patents which fall within the coverage of the genus patent may be granted, FMC placed reliance on several precedents, namely, *F. Hoffmann-La Roche Ltd v. Cipla Ltd*², *Eisai Co. Ltd v. Satish Reddy*³ and *Bristol Myers Squibb Holdings v. Emcure Pharmaceuticals Ltd*⁴.

'Coverage versus disclosure' conundrum

FMC also argued that the decision of the Supreme Court in the *Novartis*⁵ would not advance the case of the Defendants, in the first place, for the following reasons:

- The cited case deals with the patentability of the invention specifically in the light of Section 3(d) of the Act. However, the issue in the present case is on the vulnerability of the granted patent, and the onus is on Defendants to show that the patent is vulnerable to challenge.

- The Supreme Court proceeded on the basis that genus patent constituted prior art in *Novartis* case, whereas, in the present case, for Claim 1 of IN'307 or the CTPR molecule, IN'978 does not constitute prior art.
- There is no clear disclosure of CTPR in the genus patent of IN'978, and in the present case, CTPR, according to FMC, is neither claimed nor disclosed in IN'978.

Vulnerability of the suit patent IN'307 on the ground of anticipation by prior claiming:

Placing reliance on *Astrazeneca AB v. Emcure Pharmaceuticals*⁶, FMC sought to distinguish between that which is 'encompassed' in a claim and that which is claimed or covered thereby. Thus, FMC relied upon the fact that Section 13(1)(b) of the Act applies only where, on comparison of claims, the claim in the species patent is found to be identical to the genus patent. Hence, the individual species must be specifically claimed in the prior art.

The invalidity of suit patent on the ground of anticipation by prior publication and inventive step:

FMC opined that none of the referred documents pass the test of the prior art with regards to the disclosure of CTPR. As such, CTPR is not disclosed in any of these patents, namely US'424, US'357, and EP'508. The only road to arrive at CTPR from the disclosure of said documents is by cherry-picking based on hindsight analysis. Hence, FMC refuted the Defendants contention that the CTPR was published.

² Rendered in RFA (OS) 92/2012

³ 2019 (79) PTC 568 (Del)

⁴ Order dated 12th December, 2019 in CS (Comm) 684/2019

⁵ (2013) 6 SCC 1

⁶ 2020 (81) PPC 588

Court's view:

Disclosure vis-à-vis invalidity on the ground of obviousness:

The Court noted that the Defendants had accepted that Markush claims are patentable in their written submissions. Therefore, the Court opined that the Defendants cannot rely on Section 11(2)(b) of the Act and arrive at the conclusion that as Claim 22 in IN'978 was patented, there must be a presumption of disclosure of CTPR. It agreed with FMC's assertion, *per contra*, that Claim 22 in IN'978 claimed a Markush structure, which does not claim, teach or disclose CTPR, or the Markush structure claimed in Claim 1 of IN'307, even if CTPR may come within the coverage of Claim 22 in IN'978.

After the perusal of complete specification relating to IN'978 and, specifically, Claim 22, the Court held that it could not find any 'teaching' which would 'lead' a person skilled in the art to Claim 1 of IN'307 or, further, to CTPR. The Court further held that it is apparent that the Defendants have cherry picked the substitutions at 'A', 'B', 'R1', 'R2', 'R3', 'J' and 'R7', as well as the radicals for substitutions at the various places on the 5- membered or 6-membered heteroaromatic rings (as per Para 102 of written submission), out of the myriad possibilities provided in Claim 22 in IN'978, so as to arrive at CTPR, or the Markush structure as defined in Claim 1 of IN'307. However, to enable a skilled person to arrive at CTPR, no reasoning or direction was provided by the Defendants, in terms of selecting these particular substitutions out of the several substitutions provided in the Markush claim in IN'978. Thus, on the basis of

*Herbert Markman v. Westview*⁷⁷, the major question focused upon by the Court was:

- *Why would a person skilled in the art make the substitutions on the Markush moiety disclosed in Claim 22 of IN'978, out of the several substitutions envisaged in the said claim?*
- *Does IN'978 teach or instruct a person skilled in the art to effect these particular substitutions in order to achieve the results, or advantages, which CTPR provides?*

The answer to the above questions would decide the case of infringement or even for making out a case of vulnerability. In the instant case, it was held that the assertion of the Defendants would not lead to an inference of infringement or even make out a case of vulnerability.

Also, the Court came to a conclusion that no teaching enables a person of skill in the art to synthesize CTPR from the disclosure provided in Claim 22 in IN'978. The rationale used by the Court was that since no effort was made for all the years during which IN'978 was in force, and FMC was the first to synthesize CTPR from the Markush claim, it was not possible to accept that the embodiments provided in Claim 22 in IN'978 would 'lead' a person skilled in the art to CTPR.

Further, the Court agreed to the principle that '*From the teachings in the genus patent, the person skilled in the art must be in a position to arrive, without unduly straining his imaginative and creative faculties, at the species patent, in order for the species patent to be invalidated on the ground of obviousness*'. And the Court categorically clarified that the element of

⁷⁷ 52 F. 3d. 967

directness must be there. *'The choice which the person skilled in the art would make, by way of substitutions on the Markush moiety or otherwise, must be apparent from the teachings in the genus patent, in order for the species patent to be treated as 'obvious'. A 'trial and error' approach would be antithetical to any suggestion of obviousness.'* Through this, the Court has put forward a test where a person of skill in the art arrives at the species patent from the genus patent without unduly straining his imagination. But this again will vary from case to case.

The Court held that the Defendants would have to establish not only that the substitutions on the Markush moiety, the effecting of which would be necessary to arrive at the suit patent are clearly disclosed in the prior art, but also, additionally, that the prior art contains the requisite teaching which would motivate the person skilled in the art to carry out the said substitutions.

'Coverage versus disclosure' conundrum:

The Court pointed out that the framers of the Patents Act did not envisage the 'claim' or 'coverage' of the claim to be identical to 'disclosure.' The Court thus observed that the Supreme Court *'has not held that coverage and disclosure are the same. Choosing its words with precision, the Supreme Court has held that there is no 'dichotomy' between 'coverage' and disclosure.'*

The Court most aptly mentioned that the Court has examined Claim 22 of IN'978, *vis-à-vis* the suit patent, and found that the claims of the suit patent were not disclosed or taught or obvious in view of the Claim 22 of IN'978. So, there would be no occasion for the Court to even forage through declarations or assertions made

by other patentees or even by FMC while applying for other patents.

It has to be also borne in mind that selection patents, so as to obtain additional or advantageous results, are valid. This position is made clear from *Merck Sharp & Dohme Corpn*⁸ and the judgment of a coordinate Single Bench of Delhi High Court in *Bristol Myers Squibb Holdings Ireland Ltd v. B.D.R. Pharmaceuticals International Pvt Ltd*⁹.

But in the present case, no claim, no coverage, and no disclosure by FMC of CTPR is in the genus patent, i.e., Claim 22 of IN'978. After tedious and painstaking research, it was found that this combination of groups led to compounds with unexpected superior insecticidal activity compared to the insecticidal anthranilamides disclosed in IN'978. Thus, for the present case, there is no question of any dichotomy between claim, coverage and disclosure.

Vulnerability of the suit patent IN'307 on the ground of anticipation by prior claiming:

On the point of prior claiming, the Court pointed out that Section 13(1)(b) of the Act applies where a claim in the suit patent *'is claimed in any claim of any other complete specification.'* They asserted that any reference either to the scope of the claim or the coverage of the claim does not make any difference *vis-à-vis* Section 13(1)(b) of the Act. Also, the Court denied taking up the two concepts, namely 'scope' and 'coverage', relied upon the by Defendants which find no place in Section 13(1)(b) of the Act, and opined that the sequitur of any such coverage could not be that CTPR has been claimed in Claim 22 of IN'978. Hence, it

⁸ 2015 (63) PPC 257; FAO (OS) No. 190/2013

⁹ 2020 SCC OnLine Del 1700

was held by the Court that no *prima facie* case of invalidity of Claim 1 of IN'307, or CTPR, was established on the ground of anticipation by prior claiming.

The invalidity of suit patent on the ground of anticipation by prior publication and inventive step:

The Court held that neither of the referred patents claims or discloses CTPR. In fact, the Court emphasized that they relate to pharmaceutical patents, relating to pharmaceutical products for therapeutic administration. Therefore, the Markush claims of the referred patents cannot be said to 'teach' synthesizing of CTPR. The Court finally concluded that CTPR is not claimed or disclosed in these patents. Thus, *sans* any claim or disclosure of CTPR, it cannot be said that CTPR was published either in US'424 or US'357 (or, therefore, in EP'508). Regarding the inventive step, the Court agreed with the FMC's argument and held that there is no explanation given by the Defendants as to why, till CTPR was synthesized by FMC, no other manufacturer, including the Defendants, in spite of so many prior art documents being in existence in the public domain, made any effort for synthesizing CTPR.

Further, the Court relied on twin requirements to make out the case of 'teaching', i.e., *'the defendant would have to establish not only that the substitutions, on the Markush moiety, the effecting of which would be necessary to arrive at the suit patent are clearly disclosed in the prior art, but also, additionally, that the prior art contains the requisite teaching*

which would motivate the person skilled in the art to carry out the said substitutions', and held that the Defendants failed to satisfy such requirements, even based on the manifold grounds raised.

Takeaway points:

1. The Court clarified that the mere coverage in every case does not result in obviousness. It also confirmed that the patent applications related to selection inventions may be granted, provided they satisfy three conditions, the use of the selected members must result in either a substantial advantage or avoidance of a disadvantage, all the members must exhibit the advantage in question, and that the selection must be based on a quality of a special character peculiar to the selected group.
2. It was held that coverage and disclosure are distinct concepts. The Court correctly pointed out the suit patent involved an inventive step considering the prior arts. However, there has been a debatable justification given by Court that CTPR was manufactured from the Markush moiety claim by FMC and no other manufacturer/Defendants had made any effort to manufacture CTPR all these years during which IN'978 remained valid.

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Statute Update

Draft Delhi High Court Intellectual Property Rights Division Rules, 2021 proposed

Subsequent to the creation of Intellectual Property Division ('IPD') in the Delhi High Court to deal with matters relating to Intellectual Property Rights ('IPR') except cases to be dealt with by the Division Bench of the Delhi High Court, the Delhi High Court has recently issued draft Delhi High Court Intellectual Property Rights Division Rules, 2021. The Rules are with respect to practice and procedure for the exercise of original and appellate jurisdiction by the IPD of the High Court, and for other miscellaneous petitions arising out of specific statutes.

Interestingly, as per the draft Rules, cases pertaining to the Information Technology Act,

2000 dealing with the rights and liabilities of intermediaries, online market places, e-commerce platforms involving issues relating to any of the specified rights, shall be deemed to be within the purview of intellectual property rights. Further, it may be noted that the definition of Intellectual Property Rights also includes rights pertaining to data protection, data exclusivity and related matters.

The draft Rules also elaborately deal with procedures for appeals, original petitions, writ petitions, civil miscellaneous main petitions, civil revision petition, etc. It may be noted that the IPD may maintain a panel of experts to assist the Court which panel may be reviewed from time to time.



Ratio decidendi

Passing off – Misrepresentation occurs only when plaintiff's prominent feature embodied in defendant's product to lead to relevant connection

The Karnataka High Court has held that 'material misrepresentation' occurs when the central or prominent feature of plaintiff's goods/service is embodied in the defendant's product in such a way that the public may be led to believe that there is or may be a relevant connection between the two parties. In a case involving alleged passing off and copyright infringement in the

trade dress or get up (packaging) of noodles, the High Court dismissed the appeal against the order of the Trial Judge dismissing the applications filed by the plaintiff for grant of temporary injunction.

The High Court was of the view that before proceeding to consider if the defendant's wrapper was deceptively similar to that of the plaintiffs', first the distinctive features in the plaintiff's wrapper should be identified and then existence of similar features in the defendant's wrapper

should be examined through the eyes of a hypothetical purchaser. Further, the Court observed that in passing off actions based on 'get up', the plaintiff must show that deception is likely, notwithstanding the absence of his own brand name on the defendant's goods and the likely presence there of the defendant's brand name and perhaps other distinguishing matter. It also observed that the plaintiff had taken contradictory stands as regards the distinctiveness of its goods in respect of the same wrapper.

Taking note of the advertisements and the circumstances of the sale of the product (noodles), the Court observed that the features which can be said to be 'distinctive in law' were essentially, the brand 'Sunfeast Yippee' and to a lesser extent, the sub-brand 'Magic Masala', and not the orange-red colour scheme of the packaging. The Court in this regard drew difference between 'distinctiveness in fact' and 'distinctiveness in law'. Regarding circumstances of sale, the Court considered the e-commerce mode and the physical shops (comprising of both purchase through sales assistant and self service). It also observed that plaintiff's wrapper could not be said to have achieved distinctiveness in the 'red-orange colour scheme'. The Court also answered in favour of the defendant, the question as to whether defendant's wrapper could be said to have infringed the copyright that existed in the packaging of the plaintiff's wrapper. [*ITC Limited v. CG Foods (India) Private Limited* – Judgement dated 28 September 2021 in Commercial Appeal No. 105/2021, Karnataka High Court] **[For principles summarised by the Court, see News Nuggets]**

Trademarks – Anti-dissection rule not imposes complete embargo for considering constituent elements

The Delhi High Court has held that rule of 'anti-dissection' under Section 17(2)(b) of the Trademarks Act, 1999 does not impose a complete embargo upon consideration of the constituent elements of a composite mark. In a dispute involving alleged infringement of the marks 'Woodland' and 'Woods' by use of the mark 'Woodley' by the defendant, the Court held that what must be seen is whether the two marks are structurally and phonetically similar and cause deception in the minds of consumers. It rejected the defendant's plea that the plaintiffs cannot say that the mark 'Woodley', merely because it uses the word 'Wood', infringes the trade mark of the plaintiffs. Comparing the two marks, the High Court found the two marks structurally and phonetically similar and thus likely to cause confusion. It noted that 'Wood' was a dominant feature of the mark of the plaintiffs, though it was not the registered trade mark.

Confirming its earlier interim order for injunction, the High Court also rejected the defendant's plea that the customers of the plaintiffs would not be confused as the products of the defendant deal with a different segment. The Court was of the view that there was no reason to believe that the customers of the plaintiffs will not get confused because of the price difference. Rejecting the plea that while customers of the plaintiffs' product were rich and educated whereas the customers of the defendants' product were not and hence there was no scope for confusion, the Court observed that both the parties were in the field of men's readymade garments and hence the stated customers of the goods of the defendants

cannot be said to be poor. It observed that such a class would normally not be buying readymade garments from the stores. [*Avtar Singh v. Sakshi Srivastava* – Decision dated 4 October 2021 in CS(COMM) 385/2020, Delhi High Court]

a) Broadcasting of copyrighted material – Supreme Court sets aside Madras HC’s interim order relaxing provisions of Rule 29(4)

b) Court cannot supplant terms of the provision through judicial interpretation by re-writing statutory languages

The Supreme Court of India has set aside the interim order of the Madras High Court wherein the High Court had substituted a statutory rule made in exercise of the power of delegated legislation with a new regime and provision which the High Court considered to be more practicable.

The dispute before the High Court concerned the constitutional challenge to Rule 29(4) of the Copyright Rules, 2013. The High Court, in its interim order, while maintaining the requirement of a prior notice under Section 31D of the Copyright Act, 1957, re-fashioned the Rule by stipulating that details pertaining to the broadcasts, particularly the duration, time slots and the like, including the quantum of royalty may be furnished within fifteen days of the broadcast or performance.

The Supreme Court in this regard was of the view that delegated legislation can, if it results in a constitutional infraction or is contrary to the ambit of the enacting statute, be invalidated, however, the Court in the exercise of judicial review cannot supplant the terms of the provision through judicial interpretation by re-writing statutory language. It noted that the High Court, in its interim order, while modifying the operation of Rule 29 by stipulating that the particulars which

are to be furnished in the notice may be furnished within a period of fifteen days after the broadcast, converted the second proviso into a ‘routine procedure’ instead of an exception. The Apex Court hence held that the exercise by the High Court amounted to re-writing. [*Saregama India Limited v. Next Radio Limited & Ors.* – Judgement dated 27 September 2021 in Civil Appeal Nos 5985-5987 of 2021, Supreme Court]

a) No confusion between ‘Le-Vel’ and ‘Level’, being used for different goods

b) No similarity between goods even if distribution channels overlap

The European Union’s General Court has upheld the decision of the EU’s Board of Appeal which had held that by reason of lack of similarity between the goods and services provided by the new mark ‘Le-Vel’ applied for and the mark ‘Level’ which was already in existence, there cannot be any likelihood of confusion on the part of the relevant public. The Court in this regard noted that the likelihood of confusion presupposes both - that the marks at issue are identical or similar and that the goods or services which they cover are also identical or similar. It held that the conditions are cumulative.

While holding so, the EU Court noted that the new mark was in respect of Class 3 (perfumery; polishing, scouring and abrasive preparations; and flavouring for beverages) and Class 35 (retail and online retail store services), while the earlier mark covered pharmaceutical and sanitary preparations in Class 5 of the Nice Agreement concerning the International Classification of Goods and Services. The Court rejected the plea that perfumery goods can be used as alternative therapies as it noted that EUIPO can take in account only the list of goods or services as it stood in the application for the concerned mark and that the application did not specify that the goods were intended for medical use.

Interestingly, the EU Court also held that even if certain specific perfumes are sold in pharmacies and the distribution channels of perfumery goods were to overlap with those of certain pharmaceuticals under the earlier mark, this would not lead to a finding that they are similar. Similarly, the fact that both the goods consisted

of chemical or biological substances was also held as not sufficient to establish relevant similarity. [*Laboratories Ern SA v. European Union Intellectual Property Office* – Judgement dated 15 September 2021 in Case T-331/20, European Union General Court]



News Nuggets

Passing off in ‘get up’ or packaging – Karnataka High Court summarises principles

The Karnataka High Court has summarised the principles which must guide the Courts in an inquiry into an action for passing off in respect of ‘get up’ of the product or service. The High Court was of the view that similarity in essential features (those which help in identification of source) and not in unessential features, is what amounts to misrepresentation.

Laying down the steps, the Court stated that at first the fine distinction between the meaning of ‘distinctiveness’ in law’ and ‘distinctiveness’ in the everyday sense should be used in filtering out the essential features from the unessential. According to the Court, the Courts should then study the extent of distinctiveness among the essential features of the plaintiff’s goods in a relative sense. Further, the Courts should conduct the test of ‘deceptive similarity’, i.e., inquire if the defendant has adopted the essential features so identified so as to lead persons of average intelligence into accepting goods of defendants as that of the plaintiff.

The High Court in this case *ITC Limited v. CG Foods (India) Private Limited* [Judgement dated 28 September 2021] also laid down steps for this test of deceptive similarity. It stated that the Court must first, construct the hypothetical purchaser and then do the comparative appreciation based on the rules/factors from the perception of the hypothetical purchaser. **For detailed news item click [here](#).**

Design claim is limited to article of manufacture identified in the claim

The United States Court of Appeals for the Federal Circuit has reversed the decision of the Patent Trial and Appeal Board which had held that the claimed design is not limited to the particular article of manufacture identified in the claim. Holding that a design claim is limited to the article of manufacture identified in the claim and it does not broadly cover a design in the abstract, the Court noted that the [US] Patent Act permitted the grant of a design patent only to whoever invents any new, original and ornamental design ‘for an article of manufacture’. The Court in its decision dated 4 October 2021 [In RE: *Surgisil, L.L.P.*] also noted that Patent Office’s examination

guidelines also state that a design is inseparable from the article to which it is applied and cannot exist alone. The rejection of the claim covering an 'ornamental design for a lip implant' was earlier affirmed by the Board observing that the design was anticipated by a Dick Blick catalog disclosing an art tool called a stump.

Confusing and deceptive similarity between 'ALDIGESIC P' and 'ALGESIC P'

Noting that the trade dress used by the defendants was practically identical to that used by the plaintiff, the Delhi High Court has granted *ad interim* relief in a case involving alleged infringement of the plaintiff's trademark 'ALDIGESIC P' by the defendant using the mark 'ALGESIC P' in respect of pharmaceuticals. Finding that a clear-cut case of confusing and deceptive similarity existed, the Court noted that the way the mark 'ALGESIC-P' figured on the defendant's packaging was also visually similar to that of the plaintiff. According to the Court, there was also *prima facie* likelihood of an unwary customer of imperfect recollection and average intelligence to assume the products as same. The High Court was also of the view that the defendant, marketing its product under the brand name 'ALGESIC-P', could hardly be held to contend, at least at *prima facie* stage, that the plaintiff's mark 'ALDIGESIC P' was invalid and, on that ground, contest the prayer for injunction. Contention that plea of invalidity of the plaintiff's registration could be urged by the defendant solely because the defendant's mark was yet unregistered, was also rejected by the Court.

Dispute after 3½ years of defendant's registration – No injunction at interim stage against defendant without opportunity to respond

The Delhi High Court has declined to injunct the defendant at the interim stage, more than three years after the defendant's mark had been registered and more than 4½ years since the date the defendant was using the mark (if the claim of user was correct), without affording the defendant an opportunity to respond to the application. The dispute in the case *Dr. Reddys Laboratories Limited v. Fast Cure Pharma* [Order dated 14 September 2021] involved alleged infringement and passing off of the plaintiff's mark RAZO by the defendant's mark RAZOFAST used in respect of similar pharmaceutical product.

Passing off by a registered trademark – Suit maintainable

Reiterating that the relief in passing off, being a common law remedy, is always available even against the registered proprietor, the Bombay High Court has granted interim relief against use of the marks SSH or SH or MARINE or D3 or D3-Gold or SAATHICOL by the defendant. The Court in the case *Pidilite Industrial Ltd. v. Saathi Advisors Pvt. Ltd.* [Order dated 22 September 2021] observed that the law is not that a suit against a registered proprietor will not lie or is not maintainable. Plaintiff's reputation, goodwill, volume of sales, etc. were also considered by the Court while granting interim relief.

'Namkeen' is allied and cognate product to 'Gajjak' and 'Rewari'

Observing that '*namkeen*' is an allied and cognate product to '*Gajjak*' and '*Rewari*', the Delhi High Court has allowed relief to the plaintiff in a case where the predecessor to the

plaintiff was found by the Trial Court to be the prior user and registered owner of the mark with regard to 'Gajjak' and 'Rewari'. The Court was of the view that Section 29 of the Trademarks Act, 1999 would be *prima facie* applicable. As far as alleged non-user of the mark by the Plaintiff No. 1 was concerned, the

Court in the dispute *Gulab Oil and Food (Ahmedabad) Pvt. Ltd. v. Madhu Gupta* [Judgement dated 16 September 2021] noted that the Trial Court had held that the Plaintiff No. 1, by permitting the Plaintiff No. 2 (of whom she is one of the Director) to use the mark, does not cease to be owner thereof.

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