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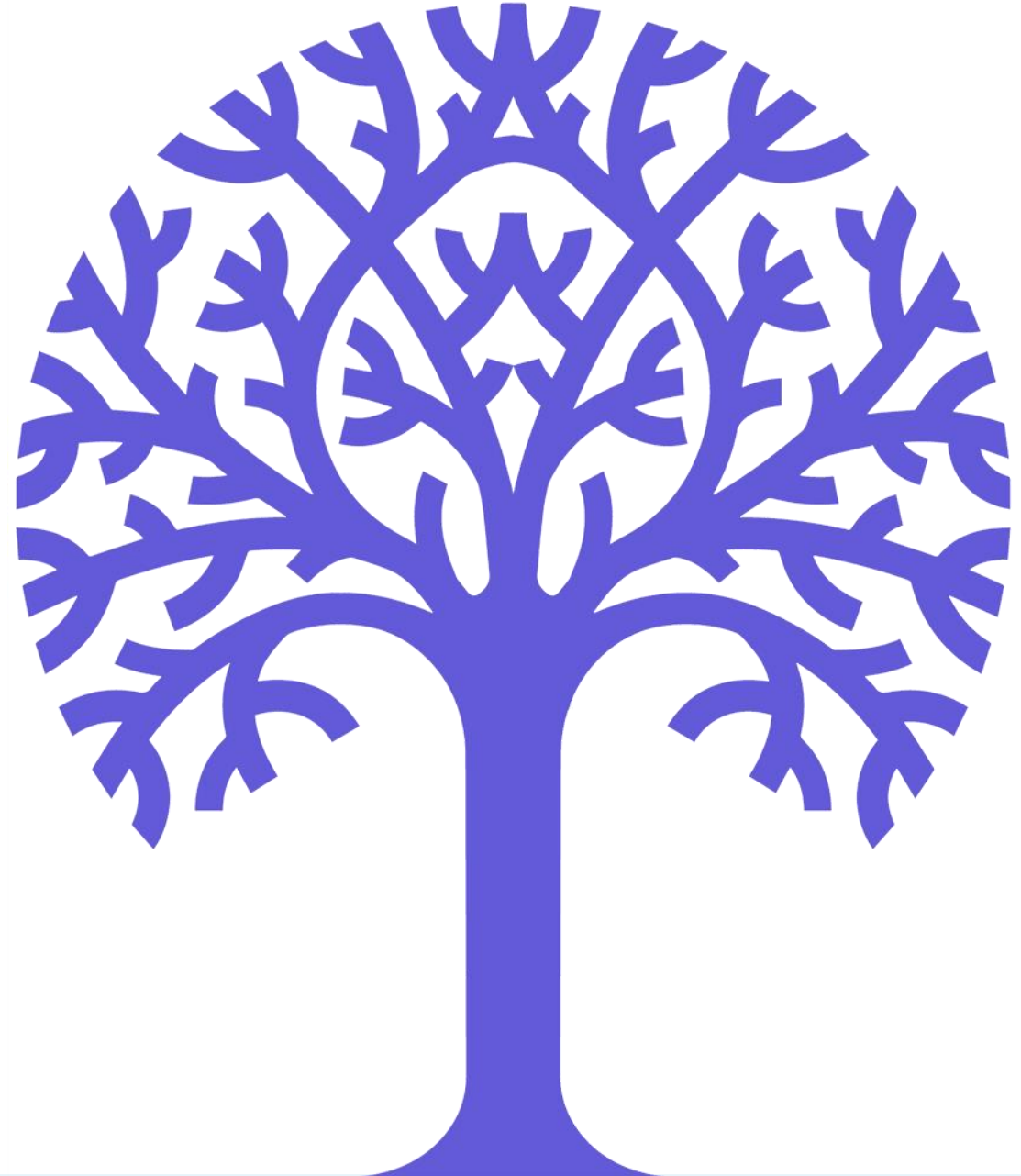
An e-newsletter from
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Table of Contents

Statute Update 3
Ratio Decidendi..... 5
News Nuggets..... 11





Statute Update

- Geographical Indications of Goods (Holding Inquiry and Appeal) Rules, 2024 notified

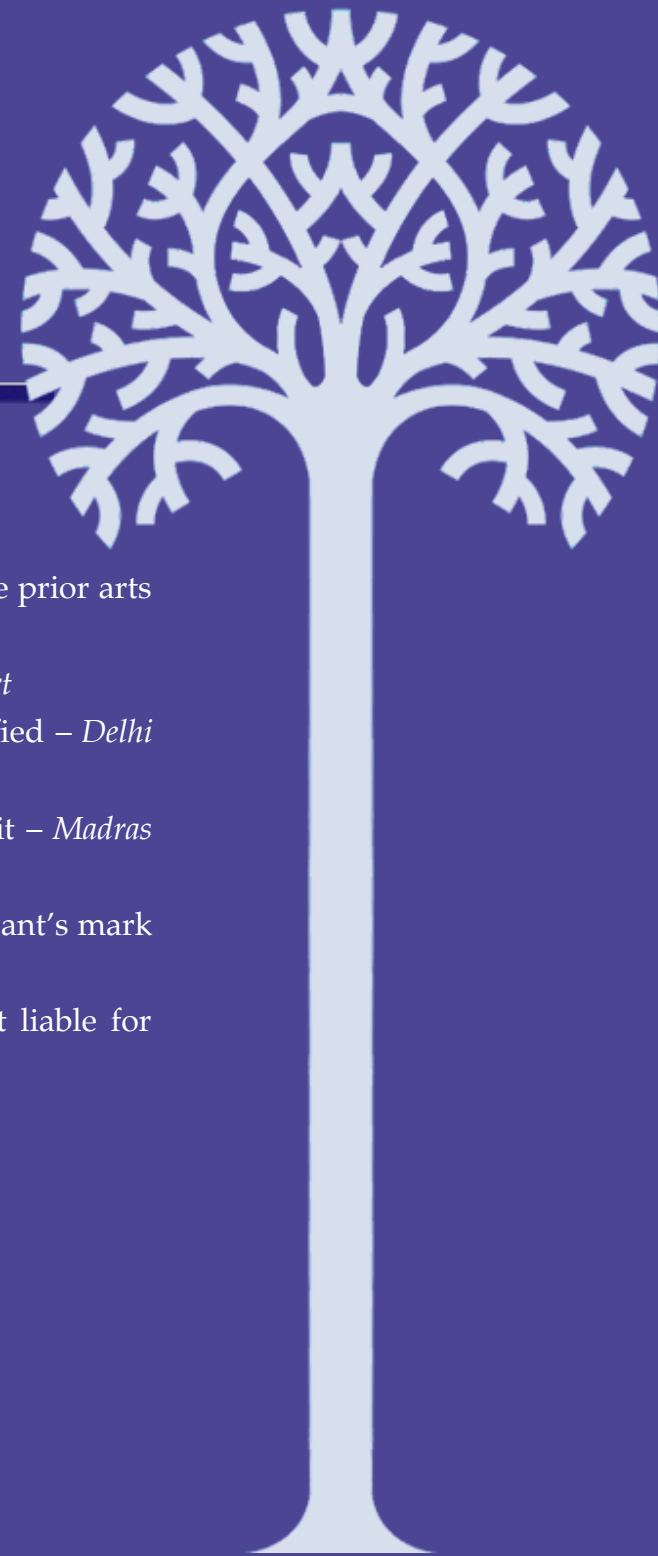
Geographical Indications of Goods (Holding Inquiry and Appeal) Rules, 2024 notified

Consequent to the notification of date of effect of Jan Vishwas (Amendment of Provisions) Act, 2023 (from 1 August 2024) in respect of certain IPR laws, the Department for Promotion of Industry and Internal Trade has on 16 August 2024 notified the Geographical Indications of Goods (Holding Inquiry and Appeal) Rules, 2024 ('GI Rules'). The new set of Rules provides for elaborate procedure of inquiry and appeal in case of alleged contraventions committed under Sections 38, 39, 40, 41, and 42

of the Geographical Indications of Goods (Registration and Protection) Act, 1999.

It may be noted that similar to the Trade Marks (Holding Inquiry and Appeal) Rules, 2024, the GI Rules also provide that both the authorities (adjudication and appellate authorities) may extend any period specified in these rules till such period as they may think fit, even though it is stated that the adjudicating officer *shall* complete the proceedings within 3 months from issuance of notice and the appellate authority is required to complete the proceedings *ordinarily* within 60 days of receipt of appeal.

Ratio Decidendi



- Patents – IPO must give reasons for not adopting foreign patent of same invention where same prior arts were tested – *Madras High Court*
- Patents – Specification contents – Sections 10(4) and 10(5) when not violated – *Madras High Court*
- Patent not deniable under Section 3(d) if ‘known process, machine, or apparatus’ is not identified – *Delhi High Court*
- Trademarks – Simultaneous and independent trial of rectification petition and commercial suit – *Madras High Court*
- Trademarks – Declaration as ‘well-known mark’ in other jurisdictions – Rectification of defendant’s mark in different class even if petitioner’s mark not ‘well-known mark’ in India – *Madras High Court*
- Copyrights – Goa Circular clarifying that performance of musical works at weddings is not liable for copyright infringement, quashed – *Bombay High Court*

Patents – IPO must give reasons for not adopting foreign patent of same invention where same prior arts were tested

The Madras High Court has allowed an appeal filed by a patent applicant in a case where the patent was refused by the Controller citing various alleged prior arts, even though the patent was granted by foreign jurisdictions while considering the same prior arts. Remanding the matter back to the Patent Office, the Court observed that when the very same invention was recognized and most of the prior arts cited against the present invention were already tested by foreign patent offices before granting patent, the IPO must refer to such patents granted abroad and give reasons as to why the same cannot be applied or adopted in India.

Observing that it was not disputed that the same invention which stood rejected by the Controller was granted patent in several foreign countries, the Court noted that there was no discussion in the impugned order about the foreign patents granted to the appellant.

Further, while remitting the matter for *denovo* scrutiny, the Court also noted that having referred to common general knowledge in the art, the Controller had not set out the source of said general

common knowledge. It also noted that the finding of the Controller that any person skilled in the art would be easily inspired by the combined teachings of prior arts to arrive at features in claim, were unsubstantiated.

[*TVS Motor Company Limited v. Controller of Patents* – Order dated 2 August 2024 in (T) CMA (PT) No.227 of 2023, Madras High Court]

Patents – Specification contents – Sections 10(4) and 10(5) when not violated

The Madras High Court has set aside the findings of the Controller regarding the patent application being violative of Section 10(4) and 10(5) of the Patents Act, 1970.

The Controller had in its order rejecting the patent had stated that the claims lacked clarity and ample disclosure and that the complete specification showed deficit support for the range of 50:50 to 90:10 and were therefore hit by Section 10(4). However, citing precedents, the Court noted that disclosure of 'at least one way' is sufficient as long as it is clearly indicated in the specification as would enable the person skilled in the art to carry out the invention. Examining the specification, the Court observed that it clearly disclosed adequate information which

would be sufficient to a person skilled in the art to carry out the invention without undue experimentation.

Regarding contentions of the Controller that the claims 1 to 19 were not supported by the description with working examples and thus violated Section 10(5), the Court noted that it is sufficient if the claims are fairly and not exactly based on the description. Appellant's submission that the statute does not require examples to be provided over the entire range claimed, was also accepted by the Court here.

It may be noted that contentions regarding Section 3(d), that the invention, '*a process of hydrolysis of lignocellulosic biomass*', was a mere use of a known process of hydrolysis, was also rejected by the Court while it observed that the fact that the invention claimed was never thought of earlier, though it is stated to be so obvious, itself carves out as a case for patent.

Further, distinguishing all the cited prior arts, the Court found itself difficult to sustain the findings of the patent office that the invention was obvious to a person skilled in the art. It also noted that the Appellant was granted patents for the same invention in as many as 23 jurisdictions. According to the Court, it was thus clear that the present invention was inventive, novel, had shown

benefits/advantages over the prior arts cited and hence, patentable.

[*Versalis SPA v. Assistant Controller of Patents* – Judgement dated 23 August 2024 in (T) CMA (PT) No.2 of 2024, Madras High Court]

Patent not deniable under Section 3(d) if 'known process, machine, or apparatus' is not identified

The Delhi High Court has set aside the rejection of the patent by the Controller under Section 3(d) of the Patents Act, 1970, when there was no identification of the 'known substance and/or device'.

The High Court in this regard was of the view that though, as per the Controller, the subject matter of the application fell under the category, '*mere use of a known process, machine, or apparatus*' of Section 3(d), since Claim No.1 of the invention was the mere use or application of the device covered in Claim No.2, and no objection *qua* novelty was specified in the Controller's impugned order regarding Claim No.2, it was unclear as to what actually was the said 'known process, machine, or apparatus' involved in the subject application.

The Court in this regard also noted that no object regarding Section 3(d) was raised when the Hearing Notice was issued, and that the said 'process, machine, or apparatus' has to be

known before the priority date of the subject application, which was not the case here.

Further, remanding the matter back to the Controller, the Court also observed that there was no adverse observation on the novelty and inventive step of both Claim nos.1 and 2 and hence the Controller had acknowledged the novelty and inventive step of the claims.

[*Nippon Steel Corporation v. Controller General of Patents, Designs & Trademarks* – Judgement dated 29 August 2024 in C.A.(COMM.IPD-PAT) 323/2022, Delhi High Court]

Trademarks – Simultaneous and independent trial of rectification petition and commercial suit

The Madras High Court has opined that there can be a simultaneous and independent trial of the rectification petitions and the commercial suit subject to the rider that the rectification petitions shall be preferably heard and disposed of before the suit.

Rejecting the submission of joint trial of the rectification petition and the suit, the Court took note of the specific phraseology in Section 124(1)(b)(i) of the Trade Marks Act, 1999, according to which, in case the proceedings in rectification are earlier in point of time, stay of the suit pending disposal of the rectification petitions is mandated. However, the High Court was of the view

that it does not preclude the trial in the suit to be simultaneously proceeded with and at the time of hearing the arguments it would always be open to the Court to deal with the rectification petitions first which will consequently have a bearing on the decision in the suit.

The High Court in this regard noted that the rectification petitions as well as the suit raised common issues, including the validity of the assignment of the Intellectual Property Rights in violation of the terms of the mutual family agreement entered into amongst the brothers.

[*K.P.D. Rajendran v. G. Sundarapandian* – Order dated 2 August 2024 in (T) OP (TM) No.200 to 202 of 2023 & C.S. (Comm.Div) No.118 of 2022, Madras High Court]

Trademarks – Declaration as ‘well-known mark’ in other jurisdictions – Rectification of defendant’s mark in different class even if petitioner’s mark not ‘well-known mark’ in India

The Madras High Court has rejected the contention of the respondent/defendant that since on the date of the filing of the rectification petition, the petitioner did not enjoy the status of a ‘well-known mark’ in India, it cannot seek to cut across a

different class for rectification of the mark of the defendant. The Court in this regard noted that on the date of filing of the rectification petitions, the petitioner's status of a well-known mark had already been declared across various other jurisdictions, all over the world.

Further, considering the Explanation to Section 11 of the Trade Marks Act, 1999, the Court noted that where the 'earlier trademark' was entitled to protection as a well-known mark even on the date of the Application for registration, then subsection (2)(b) to Section 11 would kick in and the earlier trademark would be entitled to protection even if the goods are not similar, as in the present case.

Allowing rectification of defendant's mark LEGO CUTEHEART and LEGO COFFYBOND, used for confectionary products, the Court also noted that there was an almost identical adoption of the petitioner's mark LEGO (used for toys), including the style and to some extent even the colours by the defendant. It in this regard also observed that the target consumers of both the goods were children, where recapitulation to their favourite goods is mainly visual.

[*LEGO Juris A/S v. Gurumukh Singh* – Judgement dated 13 September 2024 in (T) OP (TM) Nos.190 & 191 of 2023, Madras High Court]

Copyrights – Goa Circular clarifying that performance of musical works at weddings is not liable for copyright infringement, quashed

The Bombay High Court Bench at Goa has quashed the State of Goa Circular dated 30 January 2024 which had sought to clarify that no hotel or any Copyright Society shall insist upon any permission/NOCs for performance of musical works or other musical recordings for religious ceremonies/festivals including wedding/marriage events and other social festivities associated with marriage.

The Court in this regard noted that the Circular, though claimed to be informative in nature to make the citizens aware about the provisions of Section 52(1)(za) of the Copyrights Act, had the effect of distorting the provisions of Section 52(1)(za), as the Department had undertaken an interpretative exercise of adding words in the circular which are not part of Section 52 (1)(za).

According to the Court, the circular expanded the scope of Section 52(1)(za) and hence is bound to have consequences disturbing the balance which the Copyright Act seeks to achieve between the interest of the rights of the author/owner of the copyright and those claiming protection of Section 52(1)(za).

The High Court was also of the view that the question as to what act is not an infringement of a copyright is best left for adjudication by the competent forum which accords with the mechanism provided under the Act and is to be decided on case-to-case basis.

[*Phonographic Performance Limited v. State of Goa* – Judgement dated 13 August 2024 in Writ Petition No. 253 of 2024, Bombay High Court]



News Nuggets

- Patent for a device incorporating some computer application is not deniable under Section 3(k)
- Trademarks – Bombay High Court grants interim relief to Burger King
- Trademarks – Delhi High Court injuncts Italian firm from using 'Amuleti'
- Trademark in movie title – 'Aashiqui' prima facie is neither generic nor common to trade
- Disparagement – Bombay High Court grants interim relief against ads negatively portraying Horlicks Diabetes Plus
- Crayola trademarks the smell of its crayons
- Coffee-flavored lipstick – US coffee giant sued again for alleged concept theft
- Copyrights – Shein sues Temu over copyright infringement
- GI status granted to scotch whisky by Brazil
- 'Boroline' declared a well-known trademark

Patent for a device incorporating some computer application is not deniable under Section 3(k)

Observing that when the invention is a device which incorporates some computer applications for processing the data and thereafter displaying the same, the Madras High Court has held that the Patent Office ought not to reject the patent citing Section 3(k) of the Patents Act, 1970. Remanding the matter for reconsideration, the Court also noted that even the patent application was only in the field of mechanical engineering and not in the field of computers or mathematics, and that the very same invention was granted patent in Japan as early as on 9 January 2009. The High Court in *Kubota Corporation v. Deputy Controller of Patents and Designs* [Judgement dated 2 August 2024] was of the view that there was non-application of mind by the Patent Office. The dispute involved invention titled 'operation parameter display system for working vehicle fitted with working implement'.

Trademarks – Bombay High Court grants interim relief to Burger King

The Bombay High Court has recently granted interim relief to the US fast-food chain Burger King in a case involving use of the said mark 'Burger King' by a Pune based eatery. Earlier,

according to the news report available in *Economic Times* [here](#), the Pune District Court in its order dated 16 August had stated that the Pune eatery was using the mark since 1992, even before the US burger joint opened shop in India and that the US company failed to prove that the local food outlet had infringed its trademark. As per *Times of India* news report available [here](#), Burger King had argued that the local eatery's use of the name was damaging the company's brand.

Trademarks – Delhi High Court injuncts Italian firm from using 'Amuleti'

The Delhi High Court has issued an injunction prohibiting an Italian firm from using the mark 'Amuleti' found to be identical to Amul's and ordered the removal of the infringing products from its website. As per *Business Standard* news report available [here](#), Meta Inc. has also been instructed to block or remove the company's social media accounts promoting the products in question. The Italian firm was marketing cookies and chocolate-coated biscuits under the 'Amuleti' brand. As per reports, the plaintiff (Gujarat Cooperative Milk Marketing Federation which owns Amul brand) had argued that that the Italian firm Terre Primitive had 'blatantly' imitated the script, design, and overall presentation of Amul's logo, merely adding 'eti' to the mark.

Trademark in movie title – ‘Aashiqui’ *prima facie* is neither generic nor common to trade

The Delhi High Court has restrained a film production company Super Cassettes Industries Limited from using the titles ‘Tu Hi Aashiqui’ or ‘Tu Hi Aashiqui Hai’ for an upcoming movie by granting an interim injunction in favor of another production company Vishesh Films. The High Court in this regard observed that the word ‘Aashiqui’ was *prima facie* not a mere descriptive term but rather a distinctive mark that suggests a specific brand of romantic films, capable of being protected under trademark law.

Noting that films are more than the sum of their parts, being intricate stories where no single word can serve as a comprehensive descriptor, the Court held that a single word like ‘Aashiqui’, which may suggest a theme of romance, cannot be said to exhaustively describe the full spectrum of a film's narrative, which might include love, but also violence, hatred, jealousy, crime, and a myriad of other human emotions and experiences. Defendant's argument that the word ‘Aashiqui’ was common to trade was also rejected by the Court in its decision dated 2 September 2024.

On the question of deceptive similarity, the Court noted that the word ‘Aashiqui’ when used in the title of a film, is immediately

recognizable to the public as being associated with the highly successful romantic film series where the Defendant partnered with the Plaintiff.

Disparagement – Bombay High Court grants interim relief against ads negatively portraying Horlicks Diabetes Plus

The Bombay High Court has recently directed a company to stop circulating its advertisements that allegedly disparage Hindustan Unilever's Horlicks Diabetes Plus. As per *Economic Times* news report available [here](#), the petitioner had argued before the court that the company's product although partially blurred is still clearly visible and identifiable as the product that the protagonist in the advertisement pushes away to replace it with the latter's product.

Crayola trademarks the smell of its crayons

US company Crayola has been granted a trademark for the smell of its crayons. As per *Hindustan Times* new report available [here](#), the trademark documents state that the smell is a ‘slightly earthy soap with pungent, leather-like clay undertones’. According to the company's CEO, ‘that Crayola smell, there's a connection between the smell and childhood memories that is very

powerful.’ The company had shared examples of its own crayons as well as competitors to verify the distinctiveness.

Coffee-flavored lipstick – US coffee giant sued again for alleged concept theft

The US coffee giant Starbucks has been sued again by Balmuccino LLC for allegedly stealing the concept for coffee-flavored lipstick and lip gloss. As per news available on *Economic Times* [here](#), The filing followed a Seattle Federal Court’s July 2023 dismissal of an earlier version of the lawsuit on procedural grounds, the second such dismissal. The suit alleges that Starbucks ‘stole’ Balmuccino’s fully developed concept for lip balms by launching its ‘S’mores Frappuccino Sip Kit’ in April 2019.

Copyrights – Shein sues Temu over copyright infringement

The Chinese e-commerce fast-fashion retailer Shein has sued its rival Temu, in US, for alleged copying of products. As per *Economic Times* news report available [here](#), Shein alleges that Temu ‘encourages’ its sellers to infringe the intellectual property rights of others and sell counterfeit or sub-standard goods. It may be noted that the news also highlights the fact that number

of copyright infringement lawsuit have been filed against Shein also by H&M, Dr. Martens, Ralph Lauren, Levi Strauss, Puma and Adidas.

GI status granted to scotch whisky by Brazil

Scotch whisky has gained protected status in Brazil. As per *The Drinks Business* news report available [here](#), Scotch whisky’s new status in the country, known as a Geographical Indication (GI), will help stop bootleg products being labelled ‘Scotch Whisky’. Interestingly, the report also highlights that Scotch whisky is the first foreign product to be granted Denomination of Origin status in Brazil since 2019.

‘Boroline’ declared a well-known trademark

The Delhi High Court has declared ‘Boroline’ as a well-known trademark under Section 2(1)(zg) and Section 11(2) of the Trade Marks Act, 1999. The Court in *G.D. Pharmaceuticals Private Limited v. Cento Products (India)* [Decision dated 7 August 2024] noted that ‘BOROLINE’ has attained the status of a household name, and is one of the oldest trademarks, which has been in continuous use, preceding the independence of India. It also took note of the fact that the trademark was conferred with the award of ‘Superbrands’ for number of years.

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