



cyril amarchand mangaldas





## FOREWORD

This issue of *IP Simply* highlights the key developments in the Registry’s procedural practices. The automation of generation of registration certificates, issuance of first examination reports for design applications via email, amendment of Patent Rules, 2003 and the issue surrounding the mass scale abandonment of trade mark applications have been covered.

The information provided herein is designed to give the reader a brief idea about the aforesaid changes and the main substance of a few leading precedents.

Please feel free to send any feedback, suggestions or comments to [ipsimply@cyrilshroff.com](mailto:ipsimply@cyrilshroff.com).

Regards,  
**Cyril Shroff**  
*Managing Partner*  
[cyril.shroff@cyrilshroff.com](mailto:cyril.shroff@cyrilshroff.com)

| INDEX   | PG. NO. |
|---|---------|
| <b>NEWS UPDATES</b>   |         |
| • Issuance of Trade Mark Registration Certificates now fully automated                            | 2       |
| • Design applicants to receive First Examination Reports via e-mail                               | 2       |
| • Mass scale abandonment of trade mark applications   | 2       |
| • Amendment of Patent Rules, 2003   | 2       |
| <b>CASE LAW UPDATES</b>   |         |
| • <i>Blueberry Books and Ors v. Google India Private Ltd and Ors.</i> , 2016 (67) PTC 1 [Del][DB] | 3       |
| • <i>Toyota Jidosha Kabushiki Kaisha v. Deepak Mangal and Ors.</i> , 2016 (67) PTC 1 [Del][DB]    | 4       |
| • <i>Dish TV India Ltd. vs. Gulf DTH LLC</i> FAO(OS) 271/2016 Delhi High Court                    | 4       |

## **I. NEWS UPDATES**

### **A. Issuance of Trade Mark Registration Certificates now fully automated**

From August 1, 2016, the process relating to generation and issuance of registration certificates is fully automated. The Controller General informed all stakeholders vide public notice dated 28/07/2016, that registration certificates will be generated through an automated system and made available to the applicants/agents in respect of the following trade mark applications-

- (a) which were published in and after Trade Marks Journal No. 1720 dated 23/11/2015;
- (b) where no amendment request is pending disposal;
- (c) where copy of original application is available in the Registry's electronic database;
- (d) where no compliance is pending (such as fees, Power of Attorney, etc.); and
- (e) which have not been specifically prohibited for registration by the order of any court, IPAB or any competent authority.

Registration certificates will no longer be dispatched by post and will be sent to the applicant/agent on record at the email address in the official file and will also be uploaded on the online database. Further, applications which do not fall within the automated registration process will be processed under the earlier system, and will be dispatched by post.

It is advised that applicants/agents must provide or update their current email ids with the head office at Mumbai Registry or with the front office counter of the branch offices to facilitate expeditious transmission of registration certificates and take advantage of the automated system.

### **B. Design applicants to receive First Examination Reports via e-mail**

From September 5, 2016, First Examination Reports for design applications and subsequent office communications shall be sent via email to

the applicant/agent on record. This development is aimed at fastening the prosecution of design applications. All applicants/agents must provide their email ids in the "address for service" section in the application form.

### **C. Mass scale abandonment of trade mark applications**

The Trade Marks Registry unilaterally abandoned about 194,000 applications in the span of less than a month (in March-April) this year, creating panic amongst the applicants and their attorneys. Several complaints were lodged with the Registry and one IP Attorneys' Association even approached the Delhi High Court to obtain a restraint order against the Registry from abandoning applications without following the due process of law.

On July 11, 2016, the Registry issued a public notice stating that a total of 13062 examination reports were dispatched (during March and April 2016) and no reply/communication was received for 9578 applications, even after the expiry of more than 30 days. Applicants/agents were called upon to send scanned copies of their responses on or before July 31, 2016, failing which, the notice stated that the applications may be treated as abandoned.

In cases of erroneous abandonment, we advised clients to file responses to the examination reports once again via email. From our experience, in cases where replies were filed again, the status of the marks were changed from "abandoned" to "objected".

### **D. Amendment of Patent Rules, 2003**

The Indian Patent Rules, 2003 were recently amended by way of the Patents (Amendment) Rules, 2016 ("Rules"). The Rules became effective on May 16, 2016, three days after the new national IPR policy was announced. It is envisaged that the amended rules will have a

*“ Process relating to generation and issuance of registration certificates is now fully automated. ”*

“*The amended Rules will have considerable impact on patent filing and prosecution in India.*”

considerable impact on patent filing and prosecution in India. Importantly, the rules are based on increasing the role of technology in application procedures. Some of the salient features of the Rules are as under:

- a) Introduction of definition and qualification for maintaining status of start-ups;
- b) Inclusion of expedited examination of patent applications for start-ups;
- c) Patent agent to provide a mobile number registered in India;
- d) Filing of documents to be made by “electronic transmission” only. Original documents are required to be filed within a period of 15 days.
- e) Documents required to be sent to the Indian patent office shall be sent by way of “registered post” or “speed post”. Sending of documents by “courier service” is discontinued;
- f) Deadline to submit Power of Attorney is three months from the date of filing of application;
- g) Option for withdrawing application before examination is available and such applicant can also apply for refund of official fees;
- h) Provision for conducting hearings through video-conferencing or audio-visual communication devices.

On May 08, 2016, it was clarified by the Patent Office that only the following documents are required to be submitted by the Patent Agent in original:

- (i) Authorization of Patent Agent or power of attorney;
- (ii) Proof of right to make an application ;
- (iii) Deed of assignment, Certificate regarding change in the name of the applicant, license agreement, etc ;

- (iv) Declaration regarding Inventorship ;
- (v) Priority document.

In cases where the first statement of objections was issued before May 16, 2016 for any application, the time period for putting such application for grant was 12 months. For all applications where statement of objections was issued post May 16, 2016, this time period is now 6 months.

Further, on June 14, 2016, the patent office clarified that the total number of requests which can be filed for expedited examination till the end of this year, i.e. December 31, 2016, is limited to 1000 requests.

## II. CASE LAW UPDATES

- *Blueberry Books and Ors v. Google India Private Ltd and Ors., 2016 (67) PTC 1 [Del][DB]*

Plaintiff filed this interlocutory appeal in the Division Bench of the Delhi High Court aggrieved by the order of a single judge accepting application of the Defendants- Google India, Research in Motion India Pvt. Ltd. (“RMIPL”) and Amazon, directing that they be deleted from the array of parties in this copyright infringement suit.

The Plaintiff published a book series titled “Moral Stories- Parts I, II and III”, each containing four stories, which were widely circulated in India and abroad. The suit alleged that in February 2012, Plaintiff discovered that some of its stories were made available by the Defendants for their users through an internet app titled “story time for kids” across several platforms and websites. The said app was designed by the 11th Defendant and it was alleged that the wordings of its stories’ were copied verbatim from the Plaintiff’s books.

During the proceedings, applications were filed by Google India, RMIPL and Amazon urging that that they be deleted from the array of parties, as the plaintiff did not enclose any infringement on their part. Google India and RMIPL pleaded that they were merely marketing arms and were not

engaged in any activity that amounted to infringement. Amazon contended that the plaintiff did not disclose a single instance of infringing activity occurring in India; the acts complained of took place outside India and there was no “targeting” of any user in India to confer jurisdiction on the court. Further, Amazon also contended that the Copyright Act does not have extraterritorial effect and sales through a web-based downloading app abroad, does not constitute cause of action over which the court can validly take cognizance.

The Division Bench held that the court has jurisdiction over the case as the Plaintiff is based and carrying on its business in Delhi. The Court observed that accepting Google India and RMIPL’s contention that they have no connection with the infringing works would mean a decision on merits that they are inter alia not responsible for infringement. Further, Section 20 of the Civil Procedure Code enables a plaintiff to sue a defendant either where it resides or carries on business or works for gain. Amazon’s argument imposes an additional requirement that the defendant should also carry on the particular activity that constitutes the cause of action. The Court stated that while Amazon may have valid defenses (such as being an intermediary under the Information Technology Act), however, since it is carrying on business within the jurisdiction of this Court and Plaintiff also resides here, jurisdiction cannot be denied. In view of the aforesaid, the single judge’s order was set aside, the appeal was allowed and the Defendants were directed to be arrayed as parties to the suit.

- *Toyota Jidosha Kabushiki Kaisha v. Deepak Mangal and Ors., 2016 (67) PTC 1 [Del][DB]*

The Delhi High Court upheld Toyota’s proprietary rights in its trade mark PRIUS by applying the well established test of “*first in the world market*” and recognizing the trans-border reputation of PRIUS even when the same had not been launched in India by Toyota.

Toyota was granted an ex parte ad interim injunction order restraining the Defendants from using their trade marks TOYOTA, TOYOTA INNOVA and PRIUS. However, the same was vacated by another bench, which was challenged

“*If a party is carrying on business within the jurisdiction of the court and plaintiff also resides there then jurisdiction connect be denied.*”

before the Division Bench. The Division Bench while directing the Defendants (manufacturers of spare parts) to maintain accounts of sales also laid down certain guidelines to ensure that the marks TOYOTA and TOYOTA INNOVA are used only as indicators that the Defendant’s products can be used in Toyota’s cars.

The Defendant’s claims of bonafide use of the trade marks TOYOTA INNOVA as a product descriptor were held to be baseless and the Court also came down heavily on them for not complying and following the guidelines laid down by the Division Bench. Defendant’s use of trade marks TOYOTA and TOYOTA INNOVA along with the logo thereof was found to be infringing as it was in the same style and font as used by Toyota with undue prominence given to the said marks in their packaging.

The Court also went on to hold that even though Defendant has obtained registration for the mark PRIUS in India and has been using the same in India prior to Toyota, Toyota’s claim for passing off is made out. The Court observed that in view of the fact that Toyota has used the said mark “*first in the world market*” and has tremendous worldwide goodwill and reputation for the said mark which has transcended borders and spilled over into India, it is entitled to the exclusive use thereof. The Court observed that confusion is inevitable because the marks are identical used in relation to identical and related products and having an identical market.

- *Dish TV India Ltd. vs. Gulf DTH LLC FAO (OS) 271/2016 Delhi High Court Decision dated October 24, 2016*

The Division Bench of the Delhi High Court while upholding the Single Judge’s order protected Gulf DTH’s exclusive broadcast rights of licensed content in the Middle East and North

American Region (MENA). Gulf DTH was the exclusive licensee of various content providers like New Delhi TV, Fox Channels, Discovery Communications etc. for the MENA Region whereas Dish TV India had obtained non-exclusive licenses for broadcast of content from the same content providers for the territories of India and Sri Lanka only. Dish TV India was violating the exclusive broadcast rights of Gulf DTH in the MENA region by misusing footprints of the satellites falling in those territories.

The Division Bench categorically stated that the content provider has the right to restrict the territory in which the broadcaster can broadcast the licensed content and it is for Dish TV India to ensure that the footprints falling in foreign territory are not misused. The Bench observed that *“A broken fence is not a licence to trespass.”* Dish TV India’s attempt to shift the blame of misuse of satellite footprints by a few unscrupulous end consumers who purchased set top boxes from India and took them to MENA Region was shot down by the Court on the following grounds:

- Dish TV India was operating through a network of dealers and distributors in the MENA region;
- Dish TV India had created a dedicated website for activation requests from the MENA Region;
- The serial number of the impugned set top boxes was in a series and not at random;
- Remittances were channeled to separate company Dish TV Singapore Pt. Ltd.; and
- Revenue of INR 157 crores had been generated from the MENA Region.

The Court also refused to accept Dish TV India’s offer to ensure that channels in which Gulf DTH had a right would not be downloaded by Dish TV’s purchasers. The Court observed that *“where there is prima facie strong evidence of a defendant misusing a broken fence the sweep of the injunction must be complete”* and the issue must be approached not with the span of Gulf’s

right but with reference to Dish TV having no rights in the MENA Region.

The issue of jurisdiction which was greatly agitated before the Single Judge was not raised in the Appeal. The Single Judge had taken the view that even if the rights of a copyright owner (or exclusive licensee thereof) are not exclusive to the Indian territory but are being infringed by an entity in India there is no reason that such copyright owner cannot seek relief in an Indian Court.

Dish TV India did not have its defense on record as its Written Statement in the suit was rejected for having been filed beyond the 120 days timeline provided in the Commercial Courts and Commercial Appellate Divisions of the High Courts Act, 2015. A separate appeal has been filed against the order rejecting the Written Statement. The Division Bench in its order gave a cue to Dish TV India that, if allowed to file a Written Statement, it may take the defense that what is downloaded by Dish TV consumers is not the broadcast which Gulf DTH receives in terms of advertisement breaks etc. thus negating copyright violation. However, what is debatable is that would mere insertion of advertisements change the content to the extent that two copyrightable contents are created.

“ *It is the duty of every person to carry on his business in such a manner that right of none is infringed. A broken fence is not a licence to trespass.* ”

**DISCLAIMER:**

This newsletter has been sent to you for information purposes only and is intended merely to highlight issues. The information and/or observations contained in this newsletter do not constitute legal advice and should not be acted upon in any specific situation without appropriate legal advice.

The views expressed in this newsletter do not necessarily constitute the final opinion of Cyril Amarchand Mangaldas and should you have any queries in relation to any of the issues set out herein or on other areas of law, please feel free to contact us on [ipsimply@cyrilshroff.com](mailto:ipsimply@cyrilshroff.com) or write to following coordinates:

**Cyril Shroff**

*Managing Partner*

[cyril.shroff@cyrilshroff.com](mailto:cyril.shroff@cyrilshroff.com)

**Ranjan Negi**

*Partner*

[ranjan.negi@cyrilshroff.com](mailto:ranjan.negi@cyrilshroff.com)

**Cyril Amarchand Mangaldas**

**Offices:** Mumbai, New Delhi, Bangalore, Hyderabad, Chennai and Ahmedabad