



cyril amarchand mangaldas  
ahead of the curve



Issue III | March 2025

## Index

- ▮ **Relief for Tropical Investment International Private Limited**  
Page 1
- ▮ **No notice issued in the contempt petition filed by Twenty Four Seven Retail Stores Pvt. Ltd.**  
Page 1
- ▮ **WIPO Report 2024**  
Page 2
- ▮ **Artificial Intelligence And The Authorship Conundrum**  
Page 7
- ▮ **US Copyright Office Grants Copyright to Composite AI Image**  
Page 11
- ▮ **Patents**  
Page 12
- ▮ **Trademark**  
Page 21

Dear Readers,

We at Cyril Amarchand Mangaldas are thrilled to present the March 2025 issue of IPrécis, our intellectual property newsletter.

India's continued ascent as an economic powerhouse is intrinsically linked to the growth and protection of intellectual property. The numbers speak volumes: 2022-23 saw a record 6,01,789 IP filings (a 5.94% increase year-on-year), and the Indian IP Offices generated a record revenue of Rs. 1,185.04 crore (an 8.39% increase). These figures, coupled with India's impressive global rankings – 6th in patent filings and 4th in trademark filings, and a remarkable 36.4% surge in industrial design applications in 2023 – underscore the increasing awareness and vital role of IP rights in fostering innovation and creativity.

IPrécis is a carefully curated roundup of significant events and cases in the IP sector, both in India and abroad, and its role is to keep these developments in mind. This edition of IPrécis also features some of the IP disputes successfully handled by our team.

A crucial area of focus is the intersection of AI and IP law. The increasing use of AI in creating inventions, designs, and creative works presents novel legal challenges. Questions surrounding ownership of AI-generated content and the eligibility of AI systems as inventors are at the forefront of this evolving landscape. India, along with other nations, is grappling with adapting legal frameworks to balance incentivizing human creativity, fostering technological innovation, and ensuring copyright law remains relevant in an AI-driven world.

Cyril Amarchand Mangaldas, India's premier full-service law firm, has an industry-leading and dedicated Intellectual Property Rights practice. Our class-leading practice specialists are always on top of the latest developments in the sector. It is in this light, we present the second issue of **IPrécis - a carefully curated** roundup of significant events/cases in the IP sector-both in India and abroad.

We hope you find **IPrécis** both informative and insightful. We value your feedback and welcome your comments at [cam.publications@cyrilshroff.com](mailto:cam.publications@cyrilshroff.com).

Regards,

CYRIL SHROFF

Managing Partner  
Cyril Amarchand Mangaldas

India's  
leading law  
firm



## Relief for Tropical Investment International Private Limited

Cyril Amarchand Mangaldas' Intellectual Property team secured a significant interim order from the Delhi High Court for Tropical Investment International Private Limited. The case involved a comprehensive scheme of infringement by multiple defendants, encompassing trademark and copyright violations, passing off, and unfair competition.

The team discovered that defendants were producing and selling nearly identical products under a deceptively similar name. The defendants had also copied our client's website, marketing materials, and even claimed ownership of our client's established brand.

CAM team swiftly filed and obtained an ex-parte ad interim injunction against the Defendants. This interim order restrained the defendants from continuing their infringing activities, including manufacturing, selling, and advertising the infringing products, and using a deceptively similar domain name.

In addition to the injunction, the Court appointed three Local Commissioners to conduct simultaneous searches and seizures. CAM team, along with the three Local Commissioners executed search and seizure at multiple locations across Delhi.

## No notice issued in the contempt petition filed by Twenty Four Seven Retail Stores Pvt. Ltd.

Twenty Four Seven Retail Stores Pvt. Ltd. & Anr. v. Godfrey Phillips India Limited [Delhi High Court-IA 5180/2025 and CCP(O) 20/2025 in CS(COMM) 1208/2024]

The Intellectual Property team at Cyril Amarchand Mangaldas appeared on behalf of the Defendant in the captioned matters.

The main suit in the captioned proceedings pertains to a matter of royalties that have been claimed by the Plaintiffs against the

Defendant, along with the injunction for the use of their trademarks under the "24Seven Brand". In the first hearing of the suit on 24.12.2024, the Plaintiffs allege that the Defendant had undertaken to not use the family of "24Seven Trademarks", that are the marks related to the "24Seven Brand".

In light of the aforesaid undertaking, the Plaintiffs filed the subsequent captioned application under Order XXXIX Rules 1&2 of the Code of Civil Procedure, seeking the interim injunction for the use of the mark "24HOURS" by the Defendant. It was alleged by the Plaintiffs that the Defendant had commenced operations of retail convenience stores in Delhi and Gurgaon under the mark "24 HOURS" despite the mark being registered by the Plaintiffs.

The captioned application listed before Hon'ble Justice Mini Pushkarna in the Delhi High Court on 27.02.2025. On behalf of the Defendant, submitted that the mark "24 HOURS" as registered by the Plaintiffs is descriptive in nature and is in no way related to the "24SEVEN Brand". It was further submitted that without prejudice to their rights and contentions, and without admitting to any infringement, the use of the mark "24 HOURS" has been stopped by the Defendant. Photographs evidencing the same were also handed over to the Court.

The Hon'ble Justice took note of the submissions and issued notice in the captioned application. The captioned Application has been listed for hearing on 21.03.2025. Subsequent to the hearing dated 27.02.2025, the Plaintiffs filed a contempt petition as well before the Hon'ble Delhi High Court. The primary grounds put forth in the Petition was that the Defendant has contradicted its undertaking to not use the "24 Seven Trademarks" that was recorded in the order of the Hon'ble Court dated 24.12.2024. The contempt petition was listed before the Hon'ble Justice Ms. Mini Pushkarna in the Delhi High on 03.03.2025. In the hearing, it was reiterated on behalf of the Defendants that the use of the "24HOURS" mark has been stopped without prejudice to their rights. The Hon'ble Justice took note of the submissions and re-notified the matter for 21.03.2025. No notice was issued in the contempt petition filed by the Plaintiffs.

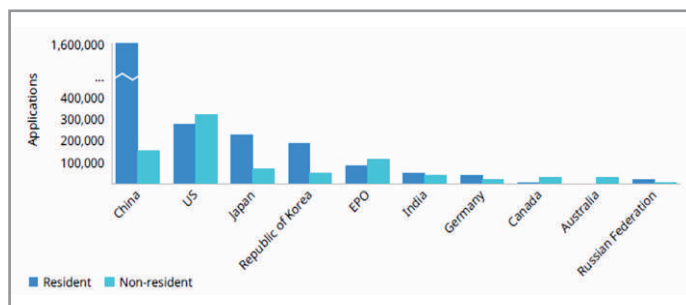
## WIPO Report 2024

The World Intellectual Property Organization (WIPO) provides a comprehensive analysis of global trends in intellectual property filings in its annual publication, the *World Intellectual Property Indicators* (WIPI) report. The 2024 report highlights the growth and evolution of patents, trademarks, and industrial designs across key global economies, with India standing out as a rapidly growing player in the global IP landscape.

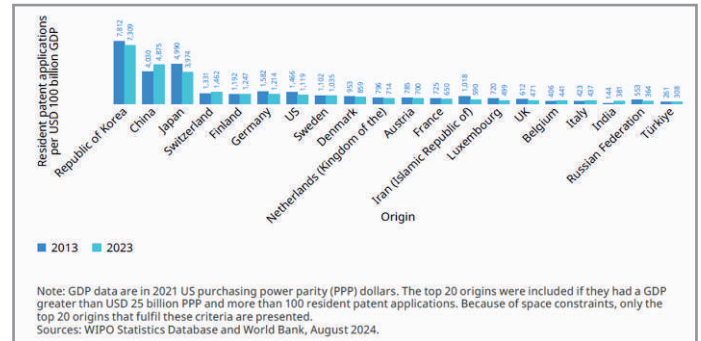
As per the 2024 report, India has secured a position in the global top 10 for patents, trademark, and industrial design filings. This marks a significant surge in IPR filings across different IPRs in India. In fact, patents and industrial design filings have doubled and trademark filings has increased by 60% between 2018 and 2023. The following are India's notable achievements as per the report:

### Patent

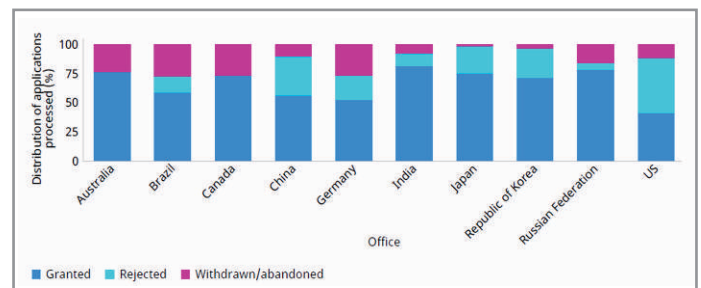
- ▮ In 2023, innovators worldwide filed 3.55 million patent applications, marking a 2.7% increase over 2022. A substantial rise in filings by applicants residing in China (at least 57,830 additional applications in 2023 compared to 2022), the Republic of Korea (+15,628), the United States of America (US) (+12,682), Japan (+9,040) and India (+8,734) were the main drivers of growth in 2023.
- ▮ India now ranks 6th globally in terms of patent applications, with 64,480 patent filings in 2023.
- ▮ For the first time, more than half (55.2%) of India's patent applications in 2023 were filed by residents, a significant milestone. Domestic filing, particularly in sectors such as healthcare, agriculture, and apparel, drove this growth.



- ▮ India's patent-to-GDP ratio – a measure of the economic impact of patent activity – also saw significant growth, indicating that IP activity is scaling alongside economic expansion. The ratio grew from 144 in 2013 to 381 in 2023.

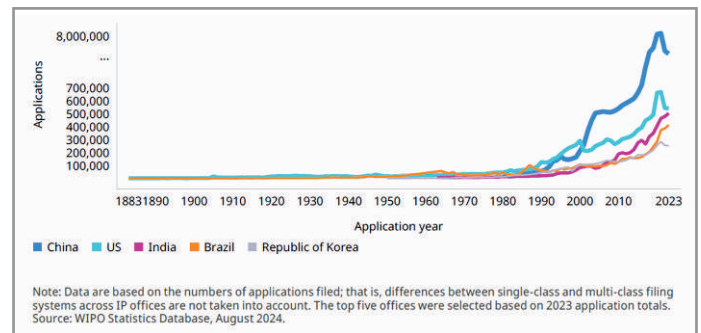


- ▮ India also saw a 149.4% increase in the number of patents granted in 2023, compared to the previous year. Approximately 80% of applications processed in 2023 were granted patents by India's IP office.

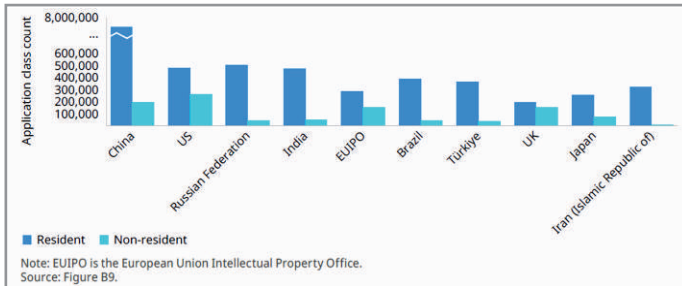


### Trademark

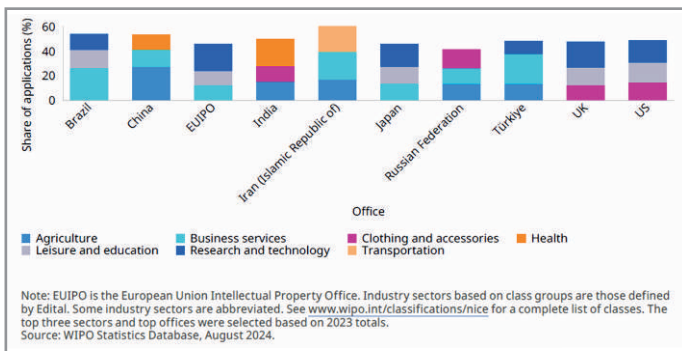
- ▮ India saw a 6.1% rise in trademark applications in 2023 and secured the fourth rank globally in trademark filings, with nearly 90% of these filings made by domestic entities. Key sectors include health (21.9%), agriculture (15.3%) and clothing (12.8%).



- ▮ Nearly 90% of India's trademark filings in 2023 were made by Indian residents, indicating a strong domestic focus on brand protection.

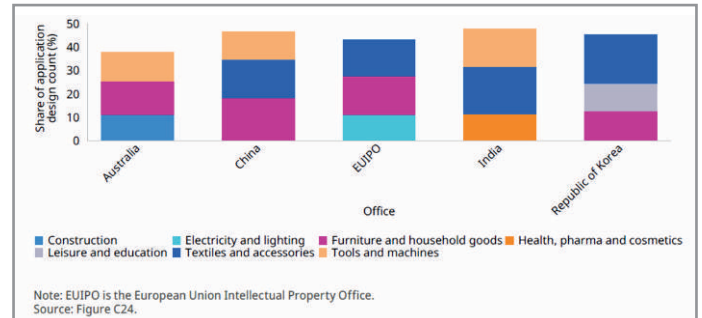
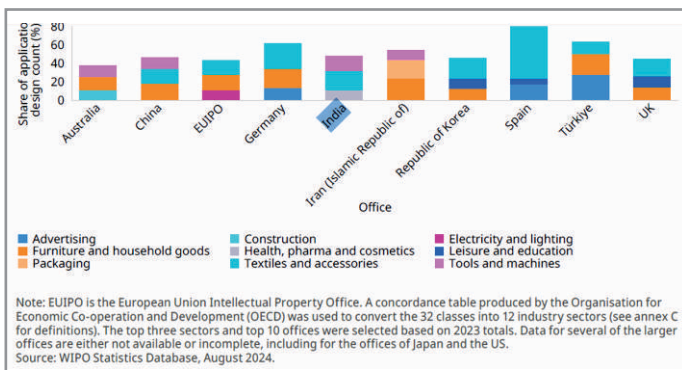


- India's trademark office holds the second-largest number of active registrations worldwide, exceeding 3.2 million. This indicates a highly active and competitive domestic marketplace.
- The largest proportion of trademark filings in India came from sectors such as health (21.9%), agriculture (15.3%), and clothing (12.8%). These figures highlight India's leadership in areas such as pharmaceuticals, food production, and fashion.



## Industrial Designs

- India's industrial design applications surged by 36.4% in 2023.
- The top three sectors include – textiles and accessories, tools and machines, and health and cosmetics. These made up almost half of all design filings.



- While countries such as China and the US continue to dominate in the patent and trademark space, India's rising figures in industrial design reflect its increasing competitiveness in product design and creativity.
- On November 22, 2024, WIPO member states approved a new Treaty that will streamline the process for designers globally to protect their designs domestically and internationally, while making it more affordable. This marks a significant advancement in empowering designers and fostering international collaboration in design.

All the Images in the above article are being used for illustrative purposes and no rights therein are claimed.

## Overview of IP trends in India

The Annual Report 2022-23, published by the Controller General of Patents, Designs, and Trade Marks (CGPTDM), highlights the key developments, achievements, and statistics in the field of intellectual property rights in India during the financial year. The report reflects the government's progress in fostering innovation, streamlining IP processes, and strengthening enforcement mechanisms. It provides valuable insights into trends in IP filings, applications and registrations, pendency at the IP offices, international cooperation, training programmes, etc., showcasing growing focus on intellectual property as a driver of economic growth and global competitiveness in India.

India has seen consistent growth in IP filings across all categories. In 2022-23, total IP filings reached 6,01,789, a 5.94% increase from the previous year. The Indian IP Offices collectively generated a record revenue of Rs 1,185.04 crore in 2022-23, up 8.39% from the previous year, and limited their expenditure to Rs 252.05 crore. Revenues from the Patent Office were the highest, followed by the Trademarks Registry and then the Designs Office.

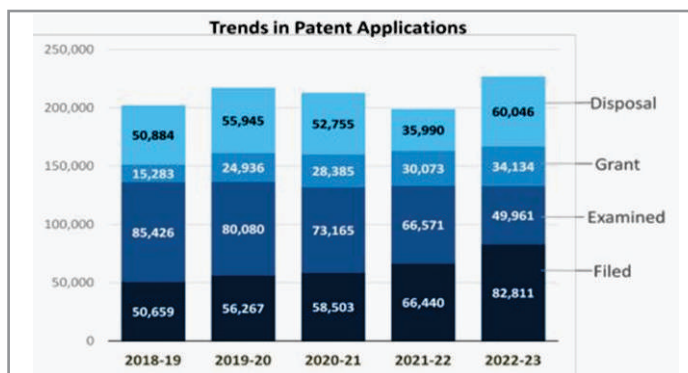


Last five year trend with respect to IP application filing:

Application	2018-19	2019-20	2020-21	2021-22	2022-23
Patent	50,659	56,267	58,503	66,440	82,811
Design	12,585	14,290	14,241	22,699	22,698
Trademark	3,23,798	3,34,805	4,31,213	4,47,805	4,66,580
Geographical Indications	32	42	58	116	211
Copyrights	18,250	21,905	24,451	30,988	29,466
Semiconductor Integrated Layout Designs (SCILD)	-	-	5	1	23
Total	4,05,324	4,27,309	5,28,471	5,68,049	6,01,789

### The Patent Office performs

In 2022-23, there were 82,811 patent applications filed at the Patents Office, marking a 24.64% rise, compared to the previous year. Indian applicants filed 43,301 patent applications, growing by 46.74% from the previous year. Almost every field of invention has shown a modest to high growth, especially the fields of computer science & electronics, communications, mechanical and electrical.



The above image is being used for illustrative purposes and no rights therein are claimed. All rights in the above image belong to the Office of the CGPTDM.

Image source: [https://ipindia.gov.in/writereaddata/Portal/IPOAnnualReport/1\\_114\\_1\\_ANNUAL\\_REPORT\\_202223\\_English.pdf](https://ipindia.gov.in/writereaddata/Portal/IPOAnnualReport/1_114_1_ANNUAL_REPORT_202223_English.pdf)

The number of patent applications filed by foreign applicants increased by 6.98% since 2021-22. The number of applications filed by foreign applicants in 2022-23 stood at 39,510.

The trend with respect to patent applications filed, examined, granted, and disposed off over the past few years by the Patents Office are given below:

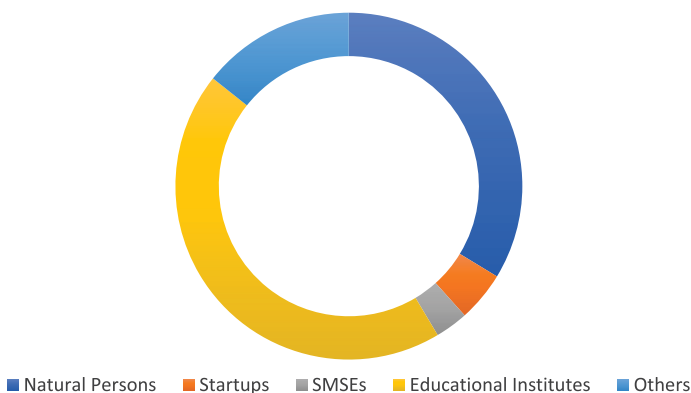
### Trends in Patent Applications

Year	2018-19	2019-20	2020-21	2021-22	2022-23
Filled	50659	56267	58503	66440	82811
Examined	85426	80080	73165	66571	49961
Granted	15283	24936	28385	30073	34134
Disposal	50884	55945	52755	35990*	60046

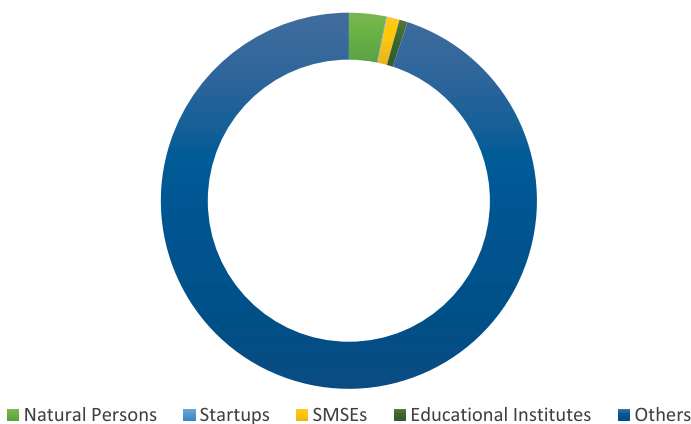
The above image is being used for illustrative purposes and no rights therein are claimed. All rights in the above image belong to the Office of the CGPTDM.

Image source: [https://ipindia.gov.in/writereaddata/Portal/IPOAnnualReport/1\\_114\\_1\\_ANNUAL\\_REPORT\\_202223\\_English.pdf](https://ipindia.gov.in/writereaddata/Portal/IPOAnnualReport/1_114_1_ANNUAL_REPORT_202223_English.pdf)

### Patent applications filed by Indian applicants across categories



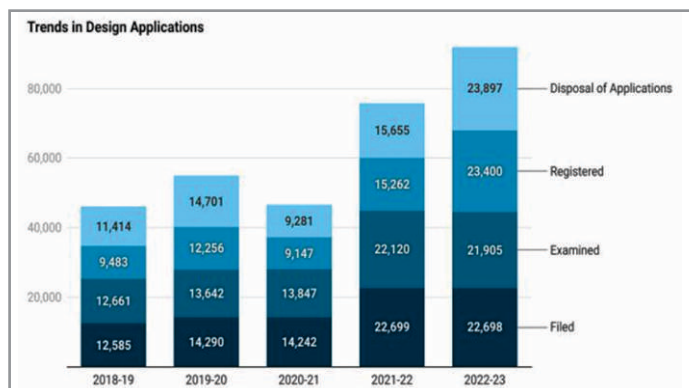
### Patent applications filed by Foreign applicants across categories



In recent years, the US, Germany, Republic of Korea, Switzerland and Ireland have been the top five countries from which foreign applicants have filed the highest number of patent applications in India. The applications filed include ordinary, convention and national phase applications.

### The Designs Office delivers:

In 2022-23, 22,698 design applications were filed in India. Registration and disposal of design applications increased by 53.33% and 52.65%, respectively, as compared to the previous year.



The above image is being used for illustrative purposes and no rights therein are claimed. All rights in the above image belong to the Office of the CGPTDM.

Image source: [https://ipindia.gov.in/writereaddata/Portal/IPOAnnualReport/1\\_114\\_1\\_ANNUAL\\_REPORT\\_202223\\_English.pdf](https://ipindia.gov.in/writereaddata/Portal/IPOAnnualReport/1_114_1_ANNUAL_REPORT_202223_English.pdf)

As many as 19,245 design applications were filed at the Designs Office in 2022-23 and Indians accounted for 85% of it. As many as 19,245 design applications were filed by Indians at the Designs Office in 2022-23, of the total 22,698 design applications filed during the period.

Sabyasachi Calcutta LLP, at 486 designs applications, filed the most design applications during the year.

The highest number of design application filed by foreign applicants here came from the US, China, Germany, Japan, Republic of Korea, Switzerland, the UK, France, Netherlands and Italy. Samsung Electronics Co. Ltd. filed the most number of designs applications in India in 2022-23.

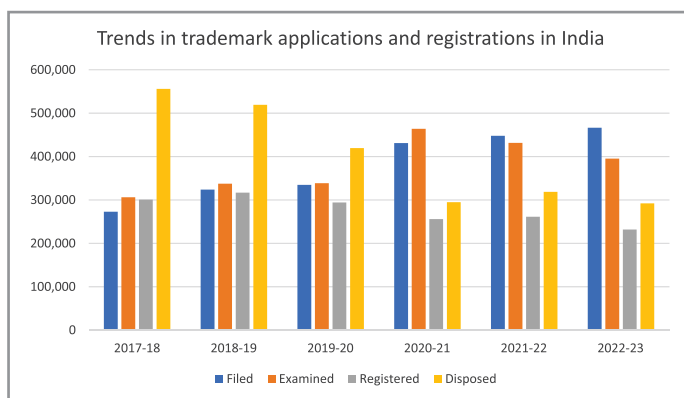
The classes of goods that saw the largest number of design applications filed by Indian applicants were clothing, transport, medical equipment, machines, etc. The classes of goods that witnessed the largest number of design applications filed by foreign applicants were recording and communication equipment, medical equipment, transport, packages and containers, watches, etc.

### The Semiconductor Integrated Circuits Layout Design (SICLD) Registry rallies:

In 2022-23, around eight SICLD applications were filed at the SICLD Registry, 10 applications were examined, three were advertised and two were registered.

### The Trade Marks Registry trailblazes:

In 2022-23, there were 4,66,580 trademark applications filed for registration of trademarks in India, out of which 4,53,325 applications were filed by Indians.



Foreign applicants filed 13,255 trademark applications in India. The US, China, Singapore, the UK, and the UAE were the top five countries from which foreign applicants filed the highest number of trademark applications.

Under the Madrid Protocol, around 14,366 trademark applications designated India and around 2,893 trademark applications were filed in India. The largest number of applications were received in respect of goods in class 5, covering pharmaceuticals, veterinary and sanitary substances, etc. Some other classes in which high volumes of trademark applications were filed in India include class 3 for perfumery and cosmetics, class 9 for electronic apparatus, class 25 for clothing and footwear, class 30 for coffee, tea, etc., class 35 for advertising and business functions, and class 41 for education, training and entertainment.

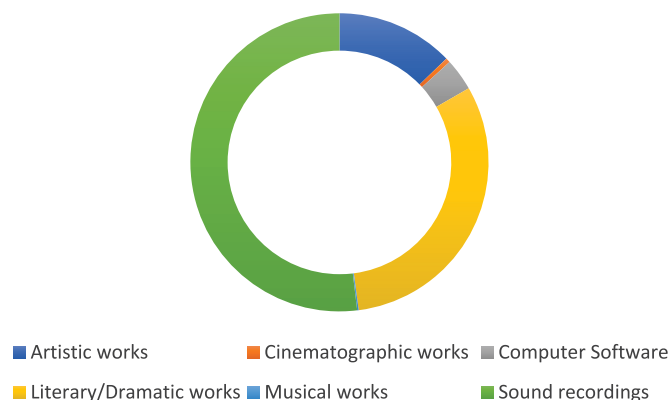
Around 59,613 trademark oppositions were filed in 2022-23 at the Trade Marks Registry, out of which 36,995 were resolved and disposed.

### The Copyright Office conquers:

In 2022-23, there were 29,466 copyright applications filed for registration of copyrights and around 24,896 were examined at the Copyright Office. Around 96% of the total copyright applications were filed online.

The highest number of copyright registrations were in respect of literary/ dramatic works, artistic works, sound recordings and computer software.

### Number of copyrights registered in 2022-23



The highest number of GI applications and GI Authorised User applications in 2022-23 were received for handicrafts, agricultural GIs, food, and so on.

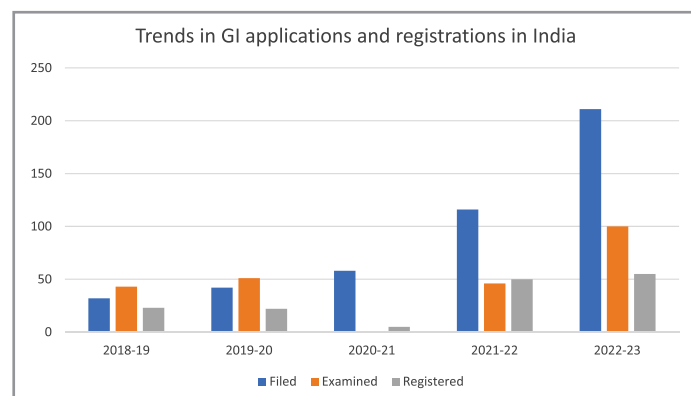
### Conclusion

India's IP landscape continues its upward trajectory, which is evidenced by consistent growth in filings and registrations for patents, designs, trademarks, copyrights, and GIs. While foreign applicants file IP applications across India IP offices in impressive numbers, the rise in Indian applicants and innovators is especially noteworthy as it showcases heightened awareness and an increase in home-grown innovation and IP creation. With more manpower and increased reliance on technology, the Indian IP offices can, with time, address issues of pendency of applications. India has been and continues to be a major generator of IP globally and by addressing existing challenges, India can solidify its reputation as a global innovation hub and IP powerhouse in the years to come.

### The Geographical Indications Registry grows:

In 2022-23, a total of 211 GI applications were filed in India, out of which 100 GI applications were examined, 82 were advertised, and 55 Geographical Indications were registered.

Additionally, the GI Registry received around 9,102 GI Authorised User applications in 2022-23, out of which 8,218 GI Authorised Users were registered.



## Artificial Intelligence And The Authorship Conundrum

### Introduction

The rise of generative artificial intelligence (AI) has sent ripples through the legal world, particularly in the realm of copyright law. Traditional notions of authorship, originality, and creative control are being challenged as AI systems demonstrate an increasing ability to produce outputs that mimic, and sometimes even surpass, human creativity. The US Copyright Office's recent report, 'Copyright and Artificial Intelligence, Part 2: Copyrightability,'<sup>1</sup> grapples with these challenges, providing a much-needed framework for analysing the copyrightability of AI-generated works. This blog post will delve into the key findings of the report, exploring its implications for creators, developers, and the future of copyright. Furthermore, we will examine the existing Indian position on AI and authorship, highlighting the unique challenges posed by the Indian legal landscape, with a particular focus on the Copyright Act, 1957, relevant case laws, and recent government statements on the matter.

### The US Copyright Office's Stance: Human Authorship as the Bedrock

The US Copyright Office's report firmly reiterates the foundational principle of US copyright law: **human authorship is a non-negotiable requirement for copyright protection**. This principle, rooted in the Constitution's Copyright Clause and consistently upheld by the judiciary, is presented as the bedrock upon which any analysis of AI-generated works must be built. The report draws heavily on landmark cases like *Feist Publications, Inc. v. Rural Telephone Service Co.*<sup>2</sup> (establishing the originality requirement), *Burrow-Giles Lithographic Co. v. Sarony*<sup>3</sup> (addressing the use of technology in creative works), and *Community for Creative Non-Violence v. Reid*<sup>4</sup> (clarifying authorship in commissioned works) to solidify this position.

The report explicitly addresses *Thaler v. Perlmutter*,<sup>5</sup> where the court affirmed the Copyright Office's refusal to register a work solely created by AI. This decision, currently under appeal, underscores the Office's commitment to the human authorship doctrine, even in the face of rapidly evolving technology.

### AI as a Tool vs. AI as a Creator: A Crucial Distinction

A central theme of the report is the distinction between using AI as a tool to enhance human creativity and using AI as a



substitute for it. When AI functions as an assistive tool, akin to a sophisticated brush or a digital editing suite, the resulting work is generally considered copyrightable. The human author remains the primary creative force, guiding the process and making key expressive choices. The report provides examples of such assistive uses, including autotune in music, content-aware fill in image editing, AI for brainstorming, and AI-assisted outlining for writers. The core tenet here is that the human is still in control. This distinction also includes using AI to structure or create a preliminary outline for a human-authored literary work or referencing, but not incorporating, AI-generated output in the development of a human-authored work.

However, when an AI system makes core expressive choices without sufficient human control, the output is likely not copyrightable under current US law. This is where the complexities arise.

### The Problem with Prompts: Lack of Control and the 'Black Box'

The report delves deep into the role of prompts in interacting with AI systems. While acknowledging that prompts can be creative works by themselves, the Office concludes that based on the capabilities of currently available technology, prompts alone do not establish human authorship over the AI-generated output. The reasoning hinges on the following points:

1. **Prompts as Ideas:** Prompts are generally considered instructions that convey unprotectible ideas, not the specific expression of those ideas.

<sup>1</sup> U.S. Copyright Office, "Copyright and Artificial Intelligence, Part 2: Copyrightability", January 29, 2025 (<https://www.copyright.gov/ai/Copyright-and-Artificial-Intelligence-Part-2-Copyrightability-Report.pdf>).

<sup>2</sup> *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991).

<sup>3</sup> *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

<sup>4</sup> *Cmtty. for Creative Non-Violence v. Reid*, 490 U.S. 730, 737 (1989).

<sup>5</sup> *Thaler v. Perlmutter*, 687 F. Supp. 3d 140, 149–50 (D.D.C. 2023).



2. **Lack of Control:** Users, even with detailed prompts, currently lack sufficient control over how AI systems interpret and execute those prompts. The ‘black box’ nature of many AI models makes it difficult to predict or understand the AI’s decision-making process.
3. **Unpredictability:** Many AI systems produce varying outputs even with identical prompts, further demonstrating the lack of human control.
4. **Iterative Prompting:** The report finds that iteratively revising prompts does not fundamentally change the analysis. It is seen as ‘re-rolling the dice’ rather than exerting meaningful control over the output’s expressive elements.

The report uses analogies like joint authorship and derivative works to illustrate these points. In joint authorship, simply providing detailed instructions without influencing their execution is insufficient for authorship. Similarly, while modifications to AI-generated outputs can be copyrightable, the underlying AI-generated material remains unprotected, akin to the pre-existing material in a derivative work.

### Expressive Inputs and Human Modification: Pathways to Copyrightability

Despite the limitations on prompts, the report identifies two pathways through which AI-generated works might achieve copyright protection:

1. **Expressive Inputs:** When a human author inputs their own copyrightable work (e.g., an illustration, a piece of music) into an AI system, and that work is perceptibly reflected in the output, the human can claim authorship over that portion of the output. The scope of protection is analogous to that of a derivative work. The *Rose Enigma* case, where a hand-drawn illustration was used as an input, serves as a prime example.<sup>6</sup>
2. **Human Modification and Arrangement:** If a human significantly modifies an AI-generated output, adding original expression, those modifications can be copyrightable. Similarly, creatively selecting, coordinating, and arranging AI-generated material can result in a copyrightable compilation, as seen in the *Zarya of the Dawn* case.<sup>7</sup> The report highlights tools like Midjourney’s “Vary Region and Remix Prompting” as examples of features that can facilitate such human modification.

### The *Sui Generis* Debate

The US Copyright Office report also tackles the question of whether a new, specialised form of legal protection — a *sui generis* right — should be created specifically for AI-generated works. Proponents of this approach argue that it could be tailored to address the unique aspects of AI creations, such as the balance between human input and AI processing, the terms of protection, and who would hold the rights.

However, the report also acknowledges significant concerns about *sui generis* protection. Some argue that such protection may not serve the goals of copyright. It could potentially dilute the market for human-created works, incentivising a flood of AI-generated content and potentially devalue human creativity. It could overall lead to lower quality of work and art. Further, past experiences with *sui generis* regimes, like the Semiconductor Chip Protection Act, were met with mixed results, either quickly becoming obsolete or creating new uncertainties.

After careful consideration, the Copyright Office concludes that a case for *sui generis* protection has not been adequately made. The Office believes that existing copyright principles, with their focus on human authorship, are better suited to address the challenges of AI, and that creating a new category of rights could do more harm than good.

### The Indian Position: The Copyright Act, 1957, Judicial Interpretation, and the Government’s Stance

The Indian legal landscape, governed by the Copyright Act, 1957, faces similar challenges in the context of AI-generated works. The 161<sup>st</sup> Parliamentary Standing Committee Report recommended creating a separate category of rights for AI and AI-related works.<sup>8</sup> This points to the increasing awareness that the current legal framework may not be sufficient to address the specific challenges presented by AI.

However, the Indian government, specifically the Ministry of Commerce and Industry, opined last year that the existing legal framework is sufficient to protect AI-generated works.<sup>9</sup> In response to questions raised, Union Minister of State for Commerce and Industry, clarified that the existing Intellectual Property Rights (IPR) regime, including the Copyright Act, 1957, is well-equipped to protect AI-generated works. He asserted that there is no need to establish a separate category of rights for AI and related innovations. This response was based on the following points:

<sup>6</sup> *Rose Enigma*, VAu001528922 (Mar. 21, 2023).

<sup>7</sup> *Cancellation Decision re: Zarya of the Dawn*, VAu001480196 (Feb. 21, 2023).

<sup>8</sup> 161st Report “Review of the Intellectual Property Rights Regime in India”, (23rd July 2021)

<sup>9</sup> Press Information Bureau, Ministry of Commerce & Industry, Government of India. IPR regime is sufficient to protect the generative AI, No proposal to make separate laws for AI and related inventions: Shri Som Parkash. February 9, 2024 (<https://pib.gov.in/PressReleasePage.aspx?PRID=2004715>).

- ⌞ **Existing Legal Framework:** Copyright and related rights in India offer exclusive rights to legal entities for a defined period, adequately safeguarding rights through Copyright and Patent systems.
- ⌞ **International Obligations:** India, as a member of major international conventions, is already obligated to protect intellectual property rights.
- ⌞ **Section 52 Exceptions:** The Copyright Act, 1957, grants exclusive economic rights to owners, obliging users of Generative AI for commercial purposes to seek permission unless exceptions apply under Section 52 (fair dealing provisions).
- ⌞ **Enforcement by Rights Holders:** The responsibility for enforcing IPR lies with the rights holders, and there are civil and criminal remedies available for infringement.

### Authorship and Ownership Under the Act

Despite the government's assertion, legal experts have raised several concerns regarding the Act's applicability to AI:

- ⌞ **Section 2(d):** This section defines 'author'. Importantly, Section 2(d)(vi) states that in relation to any literary, dramatic, musical or artistic work, which is computer-generated, the person who causes the work to be created is the author. On a bare reading, this may include AI generated works. However, Indian courts have consistently maintained that only a natural person can be an 'author'. This creates a significant hurdle for AI-generated works, as AI is not a natural person.
- ⌞ **Section 17:** This section deals with ownership of copyright. While it allows artificial persons (like the government) to be owners in certain cases, it doesn't address AI. The lack of clarity on authorship and ownership extends to enforceability of rights. AI, not being a natural or juristic person, cannot enjoy the full benefits of the Act (like moral rights), nor be held liable for infringement under the current framework.
- ⌞ **Navigators Logistics Ltd. v. Kashif Qureshi:**<sup>10</sup> This case is crucial for understanding the Indian position on computer-generated works. The court rejected a copyright claim on a list compiled by a computer, emphasising the **essential requirement of human involvement in the creation process for copyright protection in India**.



### The 'Suryast' Case and the Problem of Perpetual Copyright

The 'Suryast' case, involving a work created by Ankit Sahni, using the RAGHAV AI Painting App, brought to light the issue of potentially perpetual copyright for AI-assisted works. Initially, Sahni attempted to register 'Suryast' in India and the US, listing both himself and RAGHAV AI as authors. In India, the Copyright Office **initially granted** registration, with the AI listed as a co-author.<sup>11</sup> However, post public debate, **the registration was withdrawn**, illustrating the unsettled nature of AI's role in authorship under Indian law. In the US, the Copyright Office **refused** registration, adhering to its stance that only human-authored works are eligible for protection.<sup>12</sup>

The case highlights a core problem: Section 22 of the Indian Copyright Act dictates that copyright lasts the author's lifetime plus 60 years. If AI were considered an author, the work could theoretically remain under copyright indefinitely, as AI has no lifespan. This directly contradicts the fundamental principle of a limited copyright term, designed to eventually enrich the public domain by releasing works from copyright restrictions. The differing outcomes of trying to register 'Suryast' in India and the US, underscore the international divergence in how copyright law is grappling with AI challenges.

### Judicial Standard of Originality: The 'Skill and Judgement' Test

The standard for determining originality in India, as established in the landmark case of *Eastern Book Company v. D.B. Modak*,<sup>13</sup> is of paramount importance when considering copyrightability of

<sup>10</sup> *Navigators Logistics Ltd. v. Kashif Qureshi*, CS(OS) No. 650 of 2011 (Delhi High Court).

<sup>11</sup> (Dairy no. 13646/2020-CO/A; RoC no. A-135120/2020).

<sup>12</sup> U.S. Copyright Office Review Board, Decision Affirming Refusal of Registration of Suryast (Dec. 11, 2023). (<https://copyright.gov/rulings-filings/review-board/docs/SURYAST.pdf>).

<sup>13</sup> *Eastern Book Company v. D.B. Modak*, (2008) 1 SCC 1.

AI-generated works. Indian courts have rejected both the “sweat of the brow” doctrine (mere effort) and the American “modicum of creativity” standard, opting instead for the Canadian “skill and judgement” test. In *Eastern Book*, the Supreme Court held that even additions like paragraph numbers, headnotes, and formatting to non-copyrightable court judgments could be protected if they demonstrated sufficient “skill and judgement”. This precedent is crucial for the AI debate as it establishes that copyright protection hinges not just on the existence of a tangible output, but on whether the author exercised skill and judgement in its creation, rather than engaging in a mere mechanical exercise. We are yet to see, how Court’s in India would apply this in respect of AI-assisted works. Would this mean that the degree and nature of human input will be scrutinised in respect of AI-assisted works. Inputting a prompt into an AI and accepting the output likely wouldn’t meet this standard, as it could be considered a “mere mechanical exercise”. It would be interesting to see if the courts would examine whether the human’s role involved significant skill and judgement in guiding the AI, selecting outputs, or modifying the AI-generated material, etc., thereby shaping the final work in a meaningful way.

### International Perspectives

The US Copyright Office report also highlights how other countries are grappling with AI and authorship. The report goes beyond a cursory overview, delving into the nuances of different legal frameworks and highlighting ongoing discussions in various jurisdictions.

For example, South Korea has taken the position that only a natural person can be an author and that copyright registration of AI outputs is not possible if a human did not contribute creatively.<sup>14</sup> An AI output may be registered if a human modified the output or creatively selected and arranged such outputs. Japan, similarly, takes a case-by-case approach, where the amount and content of instructions and input prompts, the number of generation attempts, selection from multiple outputs, and human modifications are considered.<sup>15</sup> In China, the Beijing Internet Court found that an AI generated image was copyrightable based on the human user’s selection of over 150 prompts and subsequent adjustments.<sup>16</sup> The report also

discusses the European Union’s position, where member states broadly agree that AI generated content may be eligible for copyright “only if the human input in the creative process was significant.”<sup>17</sup>

The UK is in a unique position, as its existing law already provides for protection of “computer-generated works”.<sup>18</sup> However, the application of this provision to modern AI systems is unclear, and the UK is actively consulting on potential changes. Other countries, such as Canada and Australia, acknowledge the lack of clarity in their current laws regarding AI-generated works and are considering policy changes.

### Conclusion

The US Copyright Office’s report and the ongoing debate in India highlight the urgent need to address the intersection of AI and authorship. The US report highlights the need for human authorship as the foundation, while the Indian legal system, guided by the Copyright Act, 1957, established judicial precedents, and the recent government pronouncements, presents a more complex picture. The ‘Suryast’ case, the ‘skill and judgement’ standard laid down in *Eastern Book Company*, and the essential requirement of human intervention emphasised in *Navigators Logistics*, along with the government’s insistence on the sufficiency of the existing regime, contribute to a multifaceted debate.

As AI technology continues its rapid evolution, both the US and India, along with other nations, must find ways to adapt their legal frameworks. The challenge lies in striking a balance between incentivising human creativity, fostering technological innovation, and ensuring that copyright law remains relevant and effective in a world increasingly shaped by artificial intelligence. The coming years will be critical in determining how we, as a society, choose to value and protect both human and artificial creativity. While the Indian government currently maintains that the existing legal framework is sufficient, the ongoing discussions and emerging case laws suggest that further legislative or judicial clarification may be necessary to adequately address the complexities of AI and authorship in the long term. The discussion must continue, informed by both legal principles and the practical realities of this transformative technology.

<sup>14</sup> Ministry of Culture, Sports and Tourism & Korea Copyright Comm’n, A Guide on Generative AI and Copyright, (2023), ([https://www.copyright.or.kr/eng/doc/etc\\_pdf/Guide\\_on\\_Generative\\_AI\\_and\\_Copyright.pdf](https://www.copyright.or.kr/eng/doc/etc_pdf/Guide_on_Generative_AI_and_Copyright.pdf)).

<sup>15</sup> Legal Subcommittee under the Copyright Subdivision of the Cultural Council, General Understanding on AI and Copyright in Japan (May 2024), ([https://www.bunka.go.jp/english/policy/copyright/pdf/94055801\\_01.pdf](https://www.bunka.go.jp/english/policy/copyright/pdf/94055801_01.pdf)).

<sup>16</sup> *Li v. Liu*, Beijing Internet Court Civil Judgment (2023) Jing 0491 Min Chu No. 11279.

<sup>17</sup> Council of the European Union, Policy questionnaire on the relationship between generative Artificial Intelligence and copyright and related rights – Revised Presidency summary of the Member States contributions, at 16–18 (Dec. 20, 2024), (<https://data.consilium.europa.eu/doc/document/ST-16710-2024-REV-1/en/pdf>).

<sup>18</sup> Copyright, Designs and Patents Act 1988, c. X, I, §§ 178, 9(3) (UK).



## US Copyright Office Grants Copyright to Composite AI Image

The intersection of AI and copyright law was recently highlighted by the copyright registration of "A Single Piece of American Cheese," an image created by Kent Keirse, CEO of the AI platform Invoke. The image, featuring a woman with mosaic-like characteristics, was made using AI and then significantly modified by Keirse through a process called "inpainting," adding around 35 AI-generated elements. The US Copyright Office initially denied the application, citing a lack of human authorship. However, Invoke successfully argued that Keirse's selection, arrangement, and coordination of the AI-generated components constituted sufficient human creative input. Copyright was granted for the composite image as a whole, but not for the individual AI-generated parts.

This case illustrates the developing legal standards for AI-generated content. The Copyright Office's decision is consistent with its recent guidance, which states that images edited or enhanced with AI can be eligible for copyright if there is enough human involvement in the creative process, and images generated solely from prompts without human input, are not. It emphasizes the importance of human authorship, even when using AI tools. It also relates to the ongoing discussion about using copyrighted works to train AI models, a topic currently being addressed in several lawsuits. The "A Single Piece of American Cheese" case provides an example for creators, showing a potential threshold for copyrighting works created with significant AI assistance, while recognizing the limitations in protecting the AI-generated parts themselves.





## Patents

### 1. *Regeneron Pharmaceuticals vs Controller of Patents and Designs - October 22, 2024, Madras High Court*

The appeal was filed under Section 117-A of the Indian Patents Act, 1970, seeking direction to set aside the impugned order issued by the Respondent Controller and to grant patent in respect of the appellant's application in accordance with the provisions of the Act and the Rules. The appellant's application was rejected by the Respondent under Section 15 of the Act, holding that the amendment sought in the Patent Application, could not be allowed under Section 59 of the Act as it would amount to change in the entire scope of the invention and that the amended claims attracted Section 3(b) of the Act and thus could not be permitted.

The Appellant submitted that there had been no change in the specifications or the substances that had been disclosed and therefore the amendment sought by it did not fall under the ambit of Section 59 of the Act. It further submitted that in the reply to the examination report, concerning Section 3(b) of the Act, the Appellant had specifically made a statement that the invention would be for the benefit of humankind and not the contrary. As per the Appellant, this statement had been completely ignored by the Respondent while rejecting its claim.

The Court accepted the Appellant's submission that the claim's rejection under Section 59 of the Act was misplaced as no substantive changes were made to the specification or the substances disclosed. In the present case, the Appellant had originally claimed the patent of the mouse, cell and the usage of mouse. However, by the amended claim, the

Appellant sought patent to the method of making a genetically modified mouse, an antigen binding protein, a targeting vector, a nucleic acid construct. The Court held that there was no change in the specification or the substances disclosed, and the Respondent had erred in considering only the original claim and the amended claim de hors the complete specification.

The Court also held that since the Appellant had made a statement that the genetic modification, as per the invention, would benefit humankind, the Respondent ought to have engaged with such statement and offered a reasoned stance. Therefore, the Court decided in favour of the Appellant and remanded the matter back for re-examination.

### 2. *F Hoffmann La Roche AG & Anr. V. Zydus Lifesciences Limited - various orders including the orders of July 9, 2024; October 9, 2024, etc. - Delhi High Court*

The Plaintiff, F Hoffmann La Roche AG, filed a suit seeking a quia timet injunction against the Defendant, Zydus, from selling and distributing "Sigrima", which it alleged was a bio-similar version of its "Perjeta", containing "Pertuzumab". The Plaintiff contended that the Defendant's product infringed upon its patents IN 268632 and IN 464646.

The Court in its initial few hearings did not grant interim injunction to the Plaintiff. However, vide an order dated July 9, 2024, the Court expressed its disapproval of the Defendant's conduct — the Defendant had received conditional approval from the Central Drug Standard Control Organization on April 4, 2024, but had failed to disclose this development to the Court in subsequent April and May 2024 hearings. The Defendant also did not disclose that it had already signed a commercial licensing agreement with Dr.

Reddy's Laboratories to market its infringing product "Sigrima". The Court observed that the non-disclosure raised transparency and fairness concerns as it deprived the Plaintiff and the Court of critical information regarding the launch of the allegedly infringing product. The Court further observed that if the Defendant was allowed to sell the allegedly infringing product, it could alter the market and disadvantage the Plaintiff. Therefore, finding the balance of convenience in favour of the Plaintiff, the Court issued an injunction, restraining the Defendant from marketing or selling "Sigrima" until the next hearing.

However, *vide* a judgment dated October 9, 2024, the Court dismissed the Plaintiff's application seeking interim injunction against the Defendant. The Court held that the Plaintiff had failed to provide adequate "claim mapping" to prove its patent infringement claim. It observed that because the Plaintiff had failed to "claim-map" the infringing product "Sigrima" with their patents, an interim injunction cannot be granted to restrain the Defendant from selling the alleged bio-similar. Therefore, the Court refused to issue an interim injunction while also vacating the earlier injunction dated July 9, 2024.

Notably, the Court also passed an order on the same day, whereby it extended the previous injunction dated July 9, 2024, and suspended the operation of aforementioned judgment for two weeks. The Court observed that since the temporary injunction had been in operation for the last three months, it was in the interest of justice that the Plaintiff be granted two weeks' time to seek appropriate legal relief against the judgment vacating the injunction.

Thereafter, the Defendant challenged the order dated October 9, 2024 (extending the previous injunction of July 9, 2024, for two weeks), before a division bench of the High Court, which allowed the appeal and set aside the impugned order. The Division bench held that since the Single Judge bench had vacated the interim injunction dated July 9, 2024, *vide* its judgment dated October 9, 2024, it could not have allowed the judgment to remain suspended for two weeks and the injunction to be extended for the same period of time.

At the same time, the Plaintiff challenged the judgment dated October 9, 2024 (vacating the injunction), before a Division bench of the High Court, contending that the Single Judge bench erred while vacating the interim injunction. The Division bench noted that the learned Single Judge had, at more than one place in the impugned judgment, observed that it was not proposing to go into the validity of the order dated July 9, 2024, and had categorically negated the prayer for vacation of that order, observing that it need "*not to be*

*gone into*". However, the Division bench observed that while framing the penultimate direction, the Single Judge bench had done the opposite and vacated the July 9, 2024, order. Therefore, the Division Bench, *vide* an order dated October 16, 2024, set aside the Single Judge bench's October 9, 2024, judgment and sent the matter back to be considered and examined afresh.

Thereafter, while considering the matter afresh, the Single Judge bench noted that the Defendant had filed a Special Leave Petition (SLP) before the Hon'ble Supreme Court of India against the Division Bench order dated October 16, 2024. In light of this, the single judge, *vide* an order dated November 5, 2024, deferred the proceeding, while also observing that the earlier interim injunction dated July 9, 2024, shall continue in the meantime.

The Defendant filed an SLP, challenging the Division Bench order dated October 16, 2024, however, the Supreme Court disposed of the SLP, with directions to the concerned Single Judge bench to decide the matter expeditiously.

Thereafter, *vide* an order dated November 21, 2024, a Division bench of the High Court set aside the Single Judge bench order dated November 5, 2024, which had reinstated the earlier interim injunction dated July 9, 2024. The Division bench observed that the injunction dated July 9, 2024, was an *ad-interim injunction*, meaning that it remained in force only till the next hearing, unless extended by a subsequent order. It further observed that the Single Judge bench judgment dated October 9, 2024, had vacated the injunction and though the said judgment was set aside by a Division bench order dated October 16, 2024, the matter was sent back to the Single Judge bench to be considered afresh. Therefore, the *ad-interim* injunction dated July 09, 2024, no longer remained in existence and, therefore, could not have been extended by the November 5, 2024, order.

### 3. **Comviva Technologies Limited v Assistant Controller of Patents and Designs - November 12, 2024, - Delhi High Court**

The Delhi High Court, while hearing an appeal against an order of the Controller of Patents and Designs, which refused a patent grant, distinguished between a technical method and a business method while examining technical contributions/ effects of an invention. In the impugned order, the Controller refused a patent application titled "Methods and Devices for Authentication of an Electronic Payment Card using Electronic Token", on the ground that the claimed invention falls under Section 3(k) of the Patents Act, categorising it as a business method and a computer programme, *per se*.

Counsel for the Respondent, while reiterating the findings of the impugned order, submitted that the subject application refers to authentication of electronic payment cards, which helps in improving security of financial transactions, thus assisting in the performance of such transactions. The invention disclosed in the subject application provides for a secure electronic payment method to the user. Hence, it was argued that the subject application is non-patentable by virtue of it falling under “business method”, under Section 3(k) of the Patents Act. Moreover, the said authentication process would be considered as a financial activity, which is non-patentable as per clause 4.5.2 of the Guidelines for Examination of Computer Related Inventions, 2016.

The Appellant, assailing the impugned order, submitted that the Controller (Respondent) had failed to appreciate that even a computer-related invention, which demonstrates a “technical effect”, or a “technical contribution”, is patentable, even though it may be based on a computer programme. Moreover, the subject application relates to authentication of financial transactions and not financial transactions per se.

The court perused the arguments on two essential aspects upon which the patent was refused under Section 3(k) of the Patents Act: (i) that it is in the nature of a business method and (ii) that it is a computer programme per se.

For the first ground of refusal, the Court looked at the Guidelines for Examination of Computer Related Inventions, 2017, issued by the Patent Office, where the term “business method” has been defined under clause 4.5.2. Upon a perusal of the same, the court held that the Claims shall be treated as “business method” only if they are essentially about carrying out a business/ trade/ financial activity/ transaction. The use of words such as “business”, “sales”, “transaction”, “payment”, by themselves are not relevant to conclude that the invention is a business method.

The Court further considered *Opentv INC v. The Controller of Patents and Designs*, which made the following observations:

““73. Thus, the only question that the Court or the Patent Office, while dealing with patent applications involving a business method, needs to consider is whether the patent application addresses a business or administrative problem and provides a solution for it. 74. In order to judge whether a particular patent application seeks to patent business methods or not, at the outset, the following aspects ought to be considered – (i) whether the invention is primarily for enabling conduct or administration of a particular business, i.e., sale or purchase of goods or services; (ii) whether the

purpose of the invention is to claim exclusivity or monopoly over the manner of doing business; (iii) whether the invention relates to a method of sale or purchase of goods or services or is in fact a computer programme producing a technical effect or exhibiting technical advancement. If it is the latter, it would be patentable, but not if it is the former.”

The Court also considered *Priya Randolph v. Deputy Controller of Patents and Designs*, which held that “in e-commerce transactions, a claim would be construed as a “business method” only if in substance it is for a “business method””.

Applying the rationale of these cases to the present one, the Court concluded that the subject application is not addressing a business problem, it is addressing the security of a transaction. It further held that the inventive step in the subject application does not lie in the business concept, but lies in the technical process as disclosed in the application. In fact, authentication in the invention is done before the actual financial transaction begins. Therefore, the aforesaid subject application would not relate to a financial transaction and is not a business method.

Moving to analysing the second ground of refusal, that is, on account of the invention being a “computer programme per se”, the court held that the impugned order fails to take into account that the subject application, even if based on computer programme and communication, would be patentable as it has resulted in technical advancement in contactless payments, where contactless payments were vulnerable to unauthorised transactions if the transaction card got stolen or compromised. It recognised that existing solutions, like one-time passwords (OTPs) or dynamic security codes, are susceptible to problems such as mobile phone cloning, visibility of security codes, etc. The Appellant, through the subject application, has tried to overcome such limitations by providing a technical solution to a technical problem, i.e., how to prevent unauthorised transactions using electronic payment cards. Therefore, the claimed invention was held as not being a “computer programme per se”, hence, not falling under the Section 3(k) list of exclusions.

The court, thus, set aside the impugned order and directed the Patent Office to proceed with granting the patent.

This case reaffirms the Bombay High Court’s position in *Priya Randolph*, that the invention should in substance be a business method to fall under Section 3(k) of the Act. Even if the purpose of the invention relates to a business activity, Court is required to delve into the manner of implementation of the invention and peruse if its implementation results in a technical process instead of a business concept.



#### **4. *BASF SE v The Deputy Controller of Patents and Designs - November 2024 - Madras High Court***

The Madras High Court, while hearing an appeal under Section 117A of the Patents Act, 1970, quashed an order that the Controller of Patents and Designs had passed. BASF SE, the Appellant in this case, had filed a Divisional Application under Section 16 of the Patents Act, 1970, following the grant of its parent patent application. The Controller rejected the Divisional Application on the ground that the timing of the grant of the parent patent preceded the filing of the Divisional Application, even though the divisional application was filed on the same day as the grant of the parent application. This timing, according to the Controller, rendered the Divisional Application to not be in accordance with Section 16 of the Act.

The Appellant, on the other hand, contended that the application was rejected on incorrect grounds as it was practically impossible for the Appellant to determine the exact timing of the grant and make the filing of the application before the grant. As per the Appellant, the fact that the Divisional Application was filed on the same day as the grant of the parent patent application should have been considered sufficient to meet the requirement of Section 16 of the Act.

Further, the Appellant argued that the impugned order was passed in violation of the principles of natural justice, as the hearing notice issued by the Controller did not mention lack of distinctiveness as an objection. However, in the impugned order, one of the reasons for refusing patent grant in respect of the Divisional Application was that the claims are not distinctive in comparison to the claims of the parent patent applications. The absence of objection in the hearing notice denied the Appellant the opportunity to present an

explanation on the matter during the hearing, prior to the issuance of the order rejecting the application.

The High Court considered these submissions and held that the Respondent had violated the principles of natural justice while passing the impugned order. Moreover, the Court held that the order was passed by total non-application of mind. The Court held that it is an admitted fact that the Divisional Application was filed on the day the patent on the parent application was granted, and it was impossible for the Appellant to know the exact timing when the patent would be granted. Therefore, the court proceeded to quash the impugned order and the appeal was disposed of by remanding the matter back to the Respondent for fresh consideration of the Divisional Application filed by the Appellant on merits.

The Court also acknowledged the practical difficulty in knowing the exact timing of the grant of patent and held that it is sufficient to file a divisional application on the same day as the day of grant of parent application to meet the requirement of Section 16 of the Act. Further, through this judgement, the court has reinforced the significance of the principles of natural justice in patent proceedings. The failure to include the reason for refusing the patent grant in the notice of hearing was deemed a substantive omission, which deprived the Appellant of reasonable opportunity to provide an explanation, resulting in the final order being issued without adhering to the principles of fair hearing.

#### **5. *ITW GSE Aps & Anr. vs Dabico Airport Solutions Pvt Ltd & Ors. - July 4, 2024, Delhi High Court***

The Plaintiffs, in this case, were suppliers of Pre-Conditioned Air (PCA) units and sought an interim injunction against the Defendant. The Plaintiffs argued that the Defendants had



won tenders and were selling PCA units, with specifications matching its own and read onto its registered patent bearing number IN 330145, the suit patent. The suit patent was granted on January 24, 2020.

The Plaintiff argued that the technical contribution of the suit patent was a PCA unit, having at least two refrigeration systems, each system having a VFD controlled compressor, connected to a central controller. This allowed individual compressors to run at different speeds, thereby managing the best and most efficient compressor speed mode. Without the suit patent, multiple refrigeration circuits will operate as per fixed capacity, irrespective of their requirement, which could range from extreme hot in airports like Dubai to extreme cold in airports like Finland or seasonal variations in airports in countries like India. It also allows cooling management if one refrigeration circuit fails, by varying the capacity of other circuits.

The Plaintiff further submitted that while the suit patent was neutral to modularity, its other patent (IN '952) was a modular arrangement in which the refrigeration modules could be removed and readjusted in a modular process. The Plaintiff claimed infringement of the suit patent by mapping its claims on various pieces of information of the Defendants PCA unit, as could be gleaned from the various Brochures of the Defendants' PCA units.

The Defendant on the other hand focussed on the fact that despite the Plaintiffs claim that its suit patent was non-modular, the essential features of the claim related to modularity, which is not a feature present in the Defendant's unit, which is integrated and not modular. It was further argued that the suit patent is invalid on the grounds of lack of inventive step under Section 64 (1)(f); double patenting under Section 64 (1)(j), non-compliance with Section 8 as per Section 64 (1)(m); and not patentable under Section 64 (1)(k), read with Section 3(d) and 3(f) of the Patents Act.

### Claim Construction

To determine infringement, the Court went into construing the claims. The Court held that a bare perusal of claim 1 of the suit patent shows that the claim is for a PCA unit comprising a housing, with a blower, and a plurality of refrigeration systems. Each of the refrigeration systems comprises at least one compressor, at least one condenser, at least one expansion valve, at least one evaporator, and at least one VFD, which in turn is controlled by a central controller. In itself, claim 1 does not speak of modularity. Modularity essentially involves using a modular system, in that, sets of components can be attached or detached, without disturbing the other components. Importantly, the other patent granted to the Plaintiff, being IN

'952, with the same priority date, seems to specifically advert to modularity.

The Court further held that the specifications and description of the patent are necessary for interpreting and understanding the claims. However, the specifications cannot broaden the claim. As stated above, the monopoly that the Patents Act grants is in respect of specific claims and not the preferred embodiments. As stated above, the Court believed that the claim, along with the specifications, seems to focus on the application of the VFD to the compressor, the variable controlling factor, and the overall central controller. The plurality of refrigeration systems as claimed, does not in itself assert modularity and, therefore, the claims would have to be seen as granted and it would be improper to read a critical limitation into the claims. Thus, the Court's construction of claims was in favour of the Plaintiff.

Further, the Court also found infringement of the Suit patent as at least *prima facie*, the Court found that the specifications of the Defendant's product, as evident from the Operation Manual and certain tenders, does map to the suit patent claims. More importantly, the Defendants restricted their non-infringement argument during submissions to the claim of non-modularity, and the Court finds the Suit patent to be applicable to non-modular systems as well. The Court, therefore, at least *prima facie*, accepted the claim mapping submitted by the Plaintiffs.

The Court also, contrary to the Defendant's claim, held that the Defendants were unable to establish whether the specific technical features of the suit patent were indeed present in prior art and whether the combination of these features was obvious to someone skilled in the field. The Court found that the specific combination of features in the suit patent was not present in prior art, and thus the patent was held to be *prima-facie* novel and non-obvious. The Court also stated that prior arts brought into focus by the Defendants, namely D2, D6 and D14 are used to combine different elements to somehow demonstrate lack of inventiveness. This is what is termed as mosaicing of unrelated documents, which is not permissible in inventive step analysis, unless the documents are inter-linked or cross-referenced.

The Court determined that it is settled law that while mosaicing prior arts may be allowed, the party claiming obviousness must prove not only the existence of prior arts, but also how a person of ordinary skill in the field would be motivated to combine the relevant components from the mosaic of prior arts. In the present case, as per the Court, the Defendants have failed to establish how, even upon mosaicing of the different prior arts cited, a person skilled in the art may be able to take obvious steps leading to the inventive concept in the suit patent. Defendants have failed to substantiate their claim that the inventive concept in the suit patent would be obvious to a person skilled in the art. Therefore, the Court held that, at the interim

stage, no case for invalidity on the ground of lack of inventive step has been made out by the Defendants.

Hence, the Court held that the Plaintiffs have made out a *prima facie* case for interim injunction, and the grounds stated for irreparable harm and balance of convenience are also in its favour. The Court granted an injunction. Considering that the Defendants have already won certain tenders with airports in India, the Court did not displace the same, since this may affect third party rights and may also cause loss to the State Exchequer.

#### 6. **Zero Brand Zone Pvt. Ltd. vs The Controller Of Patents & Designs – July 5, 2024 – Madras High Court**

The Appellant filed a Patent Application for grant of patent for an invention titled ‘Eco-friendly lamp made up of composition based on panchagavya with the combination of leaves used in traditional herbal medicine’. There was a pre-grant opposition filed against it and the application was rejected after the hearing. Thereafter, the Appellant filed an appeal against the order denying the grant of patent under S. 3(p) of the Patents Act. The Appellant argued that, despite using certain organic items in the invention, the manufacturing of a single-use lamp with these ingredients qualifies as an invention.

The Appellant contended that since the single-use lamp was made from cow products and a mixture of leaves from neem, lemon and peepal trees, it is a new product and not a known substance, and hence, clause (d) of Section 3 is not applicable. The Appellant further insisted that it was a first of its kind product, using a combination of these ingredients, and therefore the rejection was invalid.

The Court noted that the Patents (Amendment) Act, 2002, had inserted clause (p) in Section 3, and this clause was enacted in terms identical to the Patents (Second Amendment) Bill, 1999. The Joint Parliamentary Committee Report on the Patents (Second Amendment) Bill, 1999, which recommended the above amendment, contained the following reason for the amendment: “A new clause (p) has been added to protect the country’s traditional knowledge from being patented.”

The Court further noted that the expression “traditional knowledge” is not qualified by “per se”, unlike the expression “computer programme per se” in Section 3(k). Thus, as per the Court, it is evident that the object and purpose of inserting clause (p) was to prevent the creation of monopoly over traditional knowledge, including by aggregating the known properties of traditionally known components.

The Court held that the question to be answered, therefore, is whether the combination of certain known components in specific proportions, for the production of a lamp, falls outside the scope of clause (p). This, in turn, depends on

whether known properties of these components have been aggregated in the claimed invention. In the impugned order, the controller referred to the expression “panchagavya” in ayurveda, as referring to five substances derived from the cow, namely, urine, milk, ghee, curd and dung. Reference was also made to traditional knowledge – the use of cow dung cake, cow ghee and cow butter as fuel and the use of neem and lemon leaves as insect repellents. The Court held that even assuming that uses of urine, milk and curd from the cow were not known, as contended by the Appellant, since one of the known properties of other ingredients is their use as fuel, the claimed invention would fall within Section 3(p).

The Respondents contended that the claimed invention was liable to be rejected in view of prior art documents D1 to D3. According to the Respondents, all the ingredients used in the claimed invention are known ingredients, which form part of traditional knowledge. D1 contains most of the ingredients in the claimed invention. By referring to prior art D3, it was pointed out that D3 deals with a lamp made of substantially the same ingredients as the claimed invention. Therefore, it was submitted that the claimed invention would be obvious to a person skilled in the art on the basis of prior art D3.

The Court held that the claimed invention makes use of ingredients that are not only traditionally known but known to have carbon neutral effects. Therefore, the reduced carbon footprint due to the usage of these ingredients in the lamp is merely incidental and is because of known properties of the ingredients used therein. Once the ingredients fall within the scope of traditional knowledge, working on optimum ranges and proportions is a matter of routine experimentation and cannot be construed as inventive. Moreover, the invention claimed did not show any technical advancement. A person skilled in the art would not consider such composition as a new invention. Considering these factors, the Court upheld the impugned order.

#### 7. **Signal Pharmaceuticals vs Deputy Controller Of Patents And Designs November 21, 2024, Madras High Court**

The appeal was filed under Section 117-A of the Patents Act, 1970, against an order passed by the Respondent Controller refusing to grant patent in favour of the Appellant for its invention “mTOR kinase inhibitors for oncology indications and disease associated with the mTOR/P13K/AKT Pathway”, on grounds of lack of inventive step as per Section 2(1)(ja) of the Act and was not patentable under Section 3(d) of the Act.

The Appellant challenged the impugned order primarily on the ground that it was a non-speaking order, with regard to the Appellant’s invention process as claimed in its patent application and the amendments made thereafter. According to the Appellant, the impugned order reflected clear lack of

reasoning or even consideration of the Appellant's contentions. The Appellant submitted that its invention was a technical advancement, which may satisfy the inventive step requirement of Section 2(1)(ja) of the Act.

The Court held that on a *prima facie* consideration of the impugned order, it was clear that the Respondent had ignored the clear gap between the amended claims and the prior art document. Further, the Respondent has failed to consider the written submissions of the Appellant, and had also rejected the amended claims without sufficient reasons. The Court observed that a significant technical advancement was sufficient to satisfy inventive step required under Section 2(1)(ja) of the Act. It referred to the case of Novartis AG and stated that in case of a medicine that claims to cure a disease, the test of efficacy could only be therapeutic efficacy. It held that the Respondent did not explain why the Appellant's claimed invention did not satisfy the test of therapeutic efficacy. Therefore, the Court quashed the order and remanded the matter for reconsideration.

#### 8. **Macleod Pharmaceuticals Ltd. Vs The Controller of Patents and Anr., Delhi High Court**

In its recent judgment dated January 15, 2025, in C.O. (COMM.IPD-PAT) 38/2022 *Macleod Pharmaceuticals Ltd. Vs The Controller of Patents and Anr.*, the Delhi High Court (DHC) tackled some rather tricky, but interesting questions, which have surfaced time and again in heavily contested patent infringement and invalidation proceedings in recent years, particularly in the pharmaceutical space.

Sections 64 and 107 (1) of the [Indian Patents Act, 1970 \(Patents Act\)](#), are two provisions that the defendant can press into service in a patent infringement suit. Section 64 has a wider scope than Section 107 in terms of its invocation, as is evident from their respective wordings. Whereas the latter provides for pleading invalidity of a patent or patent claim only as a defence in a suit for infringement, the former may lead to the cancellation/ revocation of a patent by the High Court, when invoked by:

1. any person interested or by the Central Government, standalone through a petition; or
2. a defendant in a suit for the infringement of said patent through a counter-claim filed therein.

From an intellectual property (IP) practitioner's perspective, the key question is whether the consequences of invocation of Sections 64 and 107 are the same, i.e., whether a court's finding of invalidity of asserted patent claims in a patent infringement suit is on par with such a finding, and consequential relief which may be granted in a revocation



petition or in a counter-claim filed in a patent infringement suit.

The Learned Single Judge of the IP Division of the DHC in *Macleods (supra)* grappled with this and other related questions, differentiating between the effect of invocation of Sections 64 and 107 and laying out the consequences in terms of maintainability of a revocation petition, seeking to invalidate a patent that had already expired.

#### **Brief Facts of the Case**

Macleods Pharmaceuticals Ltd. (**Petitioner**) is engaged in manufacturing and marketing diverse pharmaceutical products, whereas Boehringer Pharma (**Respondent**), a German company, had a registered patent No. 243301 for an anti-diabetic drug called 'LINAGLIPTIN' (**Subject Patent**). The petitioner filed a revocation petition under Section 64 of the Patents Act, before the DHC on February 17, 2022, challenging the Subject Patent (**Revocation Petition**), to which the Respondent retaliated by filing a suit for infringement of the Subject Patent against the petitioner before the High Court of Himachal Pradesh (**Himachal Suit**).

During the Himachal Suit, the Petitioner, in its written statement, raised a defence of invalidity of the claims against it in the suit, invoking Section 107 in the process. Meanwhile, the Petitioner's Revocation Petition remained pending before the DHC despite several attempts by the Respondent to have it dismissed.

In the meantime, the term of the subject patent expired on August 18, 2023.

In the instant order, the Delhi High Court addressed an application from the Respondent to dismiss the Revocation Petition, arguing that the Petitioner had already claimed patent invalidity in its written statement in the Himachal suit.

## Arguments Raised by the Parties

The Counsel for the Respondent/ Applicant argued that a written statement pleading invalidity of the Subject Patent under Section 107 and action under Section 64 are on par and seek the same relief. There is, therefore, no distinction between a declaration of invalidity rendered in an infringement suit, counter-claim, or a revocation petition, and that it is a finding *in rem*, preventing the patentee from enforcing its patent against others.

The Counsel for the Petitioner responded as follows:

- ⌞ The defence under Section 107 in an infringement suit has a different legal and practical consequence from a revocation petition/ counter-claim perspective under Section 64. The former can be raised selectively *qua* only the asserted claims of the patents, which if found to be invalid, would not automatically result in patent revocation. However, success in the latter action causes the entire patent to be removed from the Register of Patents (**Register**) “as if it had never existed”. Reliance was placed on Sections 114 and 115 of the Patents Act.
- ⌞ Moreover, while any court hearing a patent infringement suit may make a finding of invalidity of patent claims under Section 107, only a High Court is vested with the power to issue an order revoking a patent.
- ⌞ Section 64 provides a standalone right, which can be exercised at any point of time, whether or not a suit has been filed, independent of whether the patent subsists or has expired.
- ⌞ If the claim of the patentee for damages survives even after the expiry of the patent, the cause of action to file a revocation petition after the expiry of the patent shall also survive.

## Court’s Analysis and Findings

The Court thus had to consider two critical questions:

- ⌞ whether a revocation petition is maintainable if the same petitioner takes a defence of invalidity under Section 107 of the Patents Act, in an infringement suit filed by the patentee; and
- ⌞ whether a revocation petition can be filed or sustained (if filed already) after the expiry of the patent term.

On both questions, the Court ruled in favour of the Petitioner.

## On Question (i)

The Court held that the Revocation Petition was maintainable, noting that the scope and effect of a petition under Section 64 of the Patents Act is entirely different from that of a defence of invalidity under Section 107.

At the outset, the Court noted that while the power to adjudicate a revocation petition or a counter-claim seeking revocation of a patent filed pursuant to Section 64 was vested only with a High Court, the question of invalidity of patent claims under Section 107 may be adjudicated even by a District Court.

The Court further relied on the divergence between Sections 151(1) and 151(2), which prescribe separate consequences for validity/ invalidity decrees in a revocation petition and an infringement suit, respectively. Indeed, a successful order pursuant to the former provision leads to the removal of the patent from the Register; however, by itself, success in the latter would not result in the removal of the patent from the Register unless the successful defendant takes additional steps.

The Court noted that this distinction was reflected even in the Petitioner’s own prayers in the Revocation Petition before the DHC and the written statement in the Himachal Suit. While in the former case, the Petitioner asks for removal of the patent from the Register, in the latter, the Petitioner only seeks a declaration that the patent is “*liable to be revoked and removed from the Register of Patents*”. Under Section 58(1) of the Patents Act, in any proceeding seeking the revocation of a patent, if a High Court were to find a patent to be invalid, it can, instead of revoking the patent, allow the patentee to amend the complete specification and keep the patent alive. It cannot, however, give such a direction when invalidity has been raised as a defence in an infringement suit.

The Court further held that just like any other proceeding, a finding of invalidity under Section 107 in a patent infringement suit *inter se* will have an *in personam* effect, binding only the parties thereto, but would not affect the patentee’s ability to assert the patent against third parties. On the contrary, the revocation of a patent under Section 64 would operate *in rem*, and the patentee would not be able to assert the revoked patent against any third party.

The Court also clarified the position on maintainability of a revocation petition when an infringement suit has been filed, noting that the choice lay with the party to either file a standalone revocation petition or a counter-claim in an existing suit.



### On Question (ii)

The Court firstly noted that Section 64 was not bound by any limitation, and as such, no limitation could be read into the section. Thus, the mere expiry of the patent could not bar the filing of an action under Section 64.

Further, and more importantly, noting that mere expiry of the Subject Patent would not have caused the Himachal Suit for patent infringement to become infructuous insofar as the claim for damages is concerned, the Court reasoned that success in the Revocation Petition would mean revocation of the Subject Patent; therefore, the Himachal Suit would have to be dismissed. Thus, there existed a valid cause of action in favour of the Petitioner to pursue the Revocation Petition and that it would not become infructuous even after expiry of the Subject Patent.

### Conclusion

The *Macleods (supra)* judgment has far-reaching consequences for all stakeholders in patent litigation since it clarifies the fate of proceedings in respect of expired patents.

In patent infringement litigation over the past two decades, a patentee's zeal to enforce its patents is seen fading away upon the expiry of its patent. An expired patent cannot be enforced in fresh suits against third parties, and the underlying IP is no longer viable for out-licensing.

Similarly, in cases where a patent expires while revocation petitions seeking its invalidation are still pending, such petitions are mostly dismissed as 'infructuous'.

In the Indian IP enforcement landscape of just 10 (ten) years ago, when damages for past use of intellectual property were hard to prove and even harder to recover from judgment-debtors, pursuing revocation petitions did not make commercial sense once the threat of an injunction had been extinguished through the expiry of the patent in suit. However, recent times have seen faster-moving patent litigation, thanks in part to procedural amendments and the growing awareness of the value of IP



rights. This has resulted in substantial damages being awarded, even in cases where the patent in suit has expired years before verdict delivery. The possibility of having to pay damages for past use of a "dead" patent has made it imperative for defendants to be able to question the very basis for a finding of patent infringement and a consequential claim of damages.

The judgment carries crucial implications for defendants in patent infringement suits, inasmuch as it permits them to not only simultaneously institute proceedings under Section 64 and present a defence under Section 107, seeking different reliefs in both, but also incentivises diligent prosecution of revocation petitions even after the expiry of the patent in question. The question "*whether the patent-in-suit was ever a validly granted patent?*" is more important than ever, and the answer as provided by the DHC in *Macleods (supra)* gives defendants a fighting chance in their quest to avoid substantial damages.

From the patentee's perspective, the silver lining lies in the fact that *Macleods (supra)* clarifies that even an order declaring invalidity of asserted claims of a patent does not invalidate the patent itself or efface it from the Patent Register altogether. In fact, it leaves the door open for the remaining claims of the same patent to be asserted against third parties.



## Trademark

### 1. Kamal Kumar Hirawat vs Maruti Poly Films & Ors. — July 5, 2024, (Calcutta High Court)

The Petitioner claimed that they had been using the trademark “FIGHTER” since 1995. The Petitioner had also registered the said trademark to gain statutory protection. They alleged that the Respondent was engaged in unauthorised use of the trademark “FITTER”. The Petitioner came to know of such unauthorised use in January 2024 from the official website of the Trademarks Registry, where the Respondent had applied for registration of a deceptively similar trademark “FITTER”, both in device form as well as a wordmark in class 17 in respect of identical goods, including adhesive taps.

The Petitioner opposed the above stated application and argued that the Respondent had deliberately adopted the deceptively similar trademark “FITTER” by replacing the two letters “GH” with the letter “T” to create a false impression among ordinary customers that the products that they are purchasing under the impugned mark belong to the Petitioner.

The Calcutta High Court, after perusing the documents placed before it, held that the Petitioner is a prior user of the mark “FIGHTER” and that allowing the Respondent to continually use the term “FITTER” would cause further loss and damage to the Petitioner. Therefore, the Court restrained the Respondent from passing off their adhesive tapes under the trademark “FITTER” or any other mark that is either identical with and/ or deceptively similar to the Petitioner’s registered mark “FIGHTER”.

### 2. ITC Limited vs Elora Tobacco Company Limited & Ors. — July 5, 2024 (Madras High Court)

The Plaintiff alleged that the Defendants are infringing the Plaintiff’s well-known trademark “Gold Flake” by using the mark “Gold Impact” in respect of identical goods. They moved an application for amendment of plaint wherein they sought to add other infringing marks discovered after execution of local commission, which included “Forever Gold” and “Gold Forever” cigarettes.

The Madras High Court allowed the application to amend the plaint, considering that the Defendants had neither appeared nor filed a written statement and will, therefore, not be prejudiced because of the amendment. Further, it was noted that such amendment at this stage will prevent multiplicity of proceedings in this matter.

### 3. A.P. Møller Mærsk A/S & Anr vs Maersk Pharma Private Limited — July 9, 2024 (Delhi High Court)

The Plaintiff sought protection for their well-known trademark and corporate name ‘MAERSK’, which they use in providing services across various industry sectors, such as Pharmaceuticals, Healthcare, FMCGs, Retail, Fashion & Lifestyle, Automotive, Chemicals and Technology. It was claimed that the Plaintiff came across the Defendant’s company, which had incorporated the Plaintiff’s registered trademark ‘MAERSK’ as a prominent and dominant part of its company name, i.e. Maersk Pharma Private Limited. To prevent confusion in the minds of consumers, the Plaintiff sought an injunction against the Defendant’s planned use of its trademark.

The Court observed that the Plaintiff was not only the prior adopter of the trademark 'MAERSK', it was also the prior registrant of the same, and the said registrations were valid, subsisting as they had been renewed from time to time. Therefore, it is likely that both members of the trade and members of the general public would associate and identify the said trade name and the trademark 'MAERSK' with only the Plaintiff. Further, it was noted that since the Defendant dealt with pharmaceutical products, it was the Court's duty to tread with utmost care, caution and prudence, be more watchful and vigilant for overall public good and stop the far-reaching negative impact. Therefore, the Court was inclined to grant an injunction.

#### 4. **Quality Services and Solutions Pvt. Ltd. vs QSS Inspection and Testing Pvt. Ltd. — July 9, 2024 (Bombay High Court)**

The Plaintiff alleged infringement of its trademark "Quality Services and Solutions" and the "QSS" logo by the Defendants. The Defendants were former employees and franchisee of the Plaintiff and had entered into an MOU wherein limited rights were granted to them to use the trademark.

The Defendants argued that since the Plaintiff knew of the use of the impugned mark, their claim is barred by the principles of acquiescence and waiver. The Defendants also argued that both parties have independent businesses comprising different clientele. Resultantly, there would be no likelihood of confusion between the services provided by either parties.

The Court observed that *prima facie*, having entered into a MOU, the Defendants derived the authority to use the trade name and logo thereunder. However, the Defendants will also have to discharge a very heavy onus for establishing that there was acquiescence on the part of the Plaintiffs. Further, while the Defendants' using the trademark was initially "permitted", (while they were still employed by the Plaintiff) the use of the trademark after the termination of association between the parties cannot be said to have been permitted and thus will not amount to acquiescence. Therefore, the balance of convenience tilted in favour of the Plaintiff and the Court granted an interim injunction as prayed for.

#### 5. **Nexus Solar Energy Pvt. Ltd. v. Nexus Power Systems — July 9, 2024 (Delhi High Court)**

The Appellants filed an appeal against a commercial Court's impugned order, which *prima facie* found the Appellant's trademark to be deceptively similar to the Respondent's registered trademark under Section 29(4). The Appellants submitted that:

- a) Such order falls foul of the Anti-Dissection Rule; and
- b) Section 29(4) of the TM Act would be inapplicable for two reasons: i) the Commercial Court had found that the Respondent (Plaintiff in the suit) had neither produced financial statements in support of its claims regarding sales, nor had it produced any material to substantiate that it had spent huge amounts on advertisements. Further, the conclusion that the Respondent's trademark has a reputation in India was based solely on an assumption that the said assertion had not been denied and ii) the Commercial Court had also found that the goods were identical so Section 29(4)(b) would not be satisfied.

The Court noted these submissions and found merit in the contention that if the goods are identical, Section 29(4) of the Act would be inapplicable. All the clauses are required to be cumulatively satisfied and, in this case, sub-clause (b), requiring the competing goods to be dissimilar, would not be satisfied. Accordingly, the court stayed the impugned order.

#### 6. **M/s Jindal (India) Ltd. v. M/s Rawalwasia Steel Plant Pvt. Ltd. — July 9, 2024 (Delhi High Court)**

The Plaintiff in this case was a registered proprietor of the trademark "JINDAL", with the device map of India and a copyright in the 'artistic work' associated with the impugned mark. The Plaintiff claimed that the mark had become distinctive of its goods and services since they had been using the mark consistently since 1952 and have also had it registered. It was alleged that the Defendant had infringed their registered trademark/ writing style/ colour combination rights in "JINDAL", and "JINDAL with the device of map of India". It was also submitted that the Defendant had applied for the impugned trademark "HINDJAL HISAR" on April 14, 2023, on a "proposed to be used" basis.

Despite email exchanges between the parties, the Plaintiff urged that injunctive relief was necessary as the Defendant had not appeared despite service and no procedure had been followed to withdraw their application from the Trade Marks Registry. Therefore, the Court granted an interim injunction, observing that the identical and deceptively similar trademark of the Defendant will cause great damage to the Plaintiff, in case, no interim relief is granted.

#### 7. **Emami Ltd. v. Dabur India Ltd. — July 11, 2024 (Calcutta High Court)**

The Petitioner moved an application seeking an ad interim order to restrict the Defendant from publishing their advertisement, which while comparing the effectiveness of

the two products, portrayed the Petitioner's products in bad light, claiming it to be ineffective as against its own product. They further submitted that advertisements in electronic media have an enormous impact and the impugned advertisement, seeking to show the Petitioner's product in bad light, would seriously affect the Petitioner's goodwill and reputation, which the Petitioner had generated in relation to its talcum and prickly heat powder, which was manufactured and marketed under the marks "Dermi Cool" and "Navratna" for over 25 years.

The Petitioner urged that the advertisement constitutes infringement of their trademark under Section 29(8) of the Trademark Act as it "wrongfully disparages" the Petitioner's product "through deliberate, false, and malicious misrepresentation". The Court, upon a perusal of the submissions, found a *prima facie* case in favour of the Petitioner and issued an interim order restraining the Defendant from publishing the advertisement till the next date of hearing.

#### 8. The Indian Hotels Company Limited vs Manoj — August 30, 2024 (Delhi High Court)

The Plaintiff adopted the mark "TAJ" for the hospitality industry in 1903 and obtained a registration for the image of the Taj Mahal Palace Hotel in 2016. They allege that the Defendant has unauthorisedly used their mark, as well as various content and photographs available on their website as a part of its business name, domain, and website.

The Court noted that there is no justification or plausible reason for adoption of the registered trademark "TAJ" by the Defendant. The Plaintiff has no connection or association with the Defendant and has not authorised them to use their mark, logos, photographs, and content. It was being used by the Defendant to promote their own business with the trading style being 'Taj Iconic Membership'.

Pertinently, the Court also observed that in addition to infringing Taj's marks and photographs, the Defendant also committed criminal acts by impersonating the Plaintiff and defrauding a jeweller into giving him more than ₹51 lakh worth of gold coins. Hence, permanent injunction was passed in favour of the Plaintiff.

#### 9. Ms Deen Dayal Anand Kumar Saraf v. Paras Agarwal Ta Ms Purushottam Agarwal — August 6, 2024 (Delhi High Court)

The Defendants moved an application seeking to vacate an injunction order passed in favour of the Plaintiff on grounds of non-disclosure of essential details by the Plaintiff while seeking an injunction. The Plaintiff had sought a permanent injunction to restrain the Defendants from selling or dealing

with products under the marks "MD Payal", "MD Star", and an injunction was granted on account of the Plaintiff holding registrations for these trademarks in Class 14. The Defendant, in this case, contended that their lack of response against a Cease & Desist notice issued by the Plaintiff, was concealed and suppressed.

The Court analysed the precedents placed before it and in accordance with the findings in *S.P. Chengalvaraya Naidu v. Jagannath* and *Canon Kabushiki Kaisha v. B. Mahajan*, held that non-disclosure of material facts had a vitiating effect on the order obtained on the strength of such non-disclosure. Ultimately, the court vacated the injunction as prayed for by the Defendant. Thereafter, an appeal was preferred before the Division Bench of the High Court, which set aside the aforesaid order on account of it being unable to accept that the Plaintiff had derived any benefit or could derive any benefit, from non-disclosure of the C&D notice or the Defendant's reply to the same, and the matter was remitted to the Single Judge for consideration on merits.

#### 10. Vivo Mobile Communication Co Ltd v. Mr Jitendra Kumar Tiwari Trading as Maa Vaishnavi Chemicals — August 29, 2024 (Delhi High Court)

The Plaintiff alleged that the Defendant had adopted the trademark "VIVO" and had also copied an identical and/ or deceptively similar font, colour, manner of writing, stylisation, get up, etc., leading to confusion among consumers and thus sought a permanent injunction against them.

The Plaintiff discovered the infringing act when the Defendant filed a trademark application for the identical mark. The Plaintiff sent a cease-and-desist notice to the Defendant, despite which, it continued using the impugned mark. The Court noted that the Plaintiff had gained extant reputation and goodwill due to its significant presence in the market and extensive advertising. It further held that the Defendant's use of the "VIVO" mark was dishonest and constituted infringement. The Court also declared "VIVO" to be a well-known mark and granted a permanent injunction against the Defendants, while also imposing costs to the tune of Rs 3,01,000.

#### 11. Neela Film Productions Private Limited v. Taarakmehtakaooltahchashmah.Com & Ors. — August 14, 2024 (Delhi High Court)

The Plaintiff, Neela Film Productions, filed a case against various Defendants, including website operators, e-commerce platforms, and YouTube channels, who were allegedly infringing on the Plaintiff's intellectual property



rights associated with the show, “Tarak Mehta ka Oolta Chashma”. It was argued that the Defendants were exploiting their brand by unlawfully using its name, characters, and other proprietary elements, commercially, without their consent. The infringing activities, as averred by the Plaintiff, included the sale of merchandise such as t-shirts and mugs, the creation of AI-generated images, and the distribution of videos, some of which contained explicit content that had the potential to tarnish the show’s goodwill and reputation.

The Delhi High Court, considering the circumstances, noted that a strong *prima facie* case was made out in favour of the Plaintiff and the continued use of the Plaintiff’s mark would cause irreparable damage to its reputation. Accordingly, the Delhi High Court issued a broad *ex-parte ad-interim* injunction against the Defendants, including websites, e-commerce platforms, YouTube channels and ‘John Doe’ parties, restraining them from infringing the copyright and trademark of the makers of the show.

#### 12. G.D. Pharmaceuticals Private Limited v. M/S Cento Products (India) — August 7, 2024 (Delhi High Court)

The Plaintiff submitted that the use of the trademark “BOROLINE” and distinctive product packaging/ trade dress in relation to its creams, had established them in the market and they occupy an eminent position when it comes to antiseptic creams.

In December 2018, the Plaintiff, through its market sources and network of distributors and agents, discovered products similar to its brand being sold in certain markets under the mark ‘BOROBEAUTY’. It was submitted that this mark was deceptively similar to the Plaintiff’s mark. The Defendant had imitated the Plaintiff’s iconic trade dress of a distinct dark green tube ending in an octagonal black cap that has come to be recognised with the Plaintiff’s product.

The Court noted that the Plaintiff’s trademark “BOROLINE” qualifies to be a well-known trademark. It has attained the status of a household name, and is one of the oldest trademarks, preceding India’s independence, and has been in continuous use. It further considered the considerable amounts invested for advertising and promotion by the Plaintiff for its products under the impugned trademark. Therefore, the Court issued a decree of permanent injunction favouring the Plaintiff.

#### 13. Louis Vuitton Malletier v. [www.haute24.com](http://www.haute24.com) — August 21, 2024 (Delhi High Court)

The Petitioner, Louis Vuitton Malletier, sought permanent injunction and damages against the Defendants upon

discovering that the Defendants had been offering for sale/ selling products on their website using certain photographs and images, without authorisation, the copyright of which, vests with the Plaintiff.

Accordingly, the Delhi High Court issued an order injunction the Defendants from using such photographs, images and promotional material. It further directed the Defendants to conspicuously display on their website that the goods sold by them were certified pre-owned goods of the Plaintiff. The court also imposed a cost on the Defendants to the tune of Rs. 5 lakh.

#### 14. Phonographic Performance Ltd. v. State of Goa and Anr. — August 13, 2024 (Bombay High Court)

The Goa Government issued a circular stating that no permission or no objection certificate was required to use sound recordings in religious ceremonies. It was also stipulated that demanding such authorisation constituted a violation of Section 52(1) (za) of the Copyright Act, which provides that sound recordings can be used without authorisation for religious ceremonies, including marriages in a *bona fide* manner.

The Petitioner, in this case, sought to quash this circular. It was argued that the circular broadens the scope of Section 52(1)(za), which is beyond the executive powers of the government. Moreover, the circular unnecessarily interferes with the enforcement mechanism already provided under the Act. Further, the interpretation of the scope of ‘religious ceremonies’ under the Copyright Act was to be undertaken on a case-to-case basis and a blanket regulation as issued under the circular was not warranted. Accordingly, the circular was quashed by the Bombay High Court.

#### 15. Marico Limited v. John Doe Ashok Kumar — August 7, 2024 (Bombay High Court)

The Plaintiff claimed that it was a reputed and well-established entity, which was also a leading player in India’s Fast Moving Consumer Goods (FMCG) segment, with well-known and prestigious brands such as “parachute”, “parachute advanced jasmine”, “hair & care”, “nihar” and “livon”, under its portfolio. It was alleged that the Defendants, who had no association with the Plaintiff, had registered domain names using the impugned trademark and were using it to defraud job seekers by collecting money under the pretence of offering jobs.

The Court took note of the submissions and recognised the need for passing an *ex-parte ad-interim* relief. Ultimately, the said injunction was granted, restraining the Defendants from infringing and passing off the Plaintiff’s trademarks.



#### **16. Disposafe Health And Life Care Limited vs Registrar Of Trade Marks — August 16, 2024 (Delhi High Court)**

The Appellant filed this appeal, praying to set aside an order dated November 29, 2023, and to also direct the Trade Mark Registry to accept application no. 3933703 and advertise the trademark ‘DISPOWAY’ in the Trade Marks Journal. It was submitted that although the Respondent had purported that a hearing notice was given to it (the Appellant), it received no such notice, and was thus unable to attend the hearing before the Registrar.

The Delhi High Court noted that there was no proof on record to show that the Appellant had received the said notice. Consequently, the Court was inclined to allow the appeal and remand the matter back to the Registrar of Trademarks, for giving an opportunity of hearing to the Appellant.

#### **17. Mangalam Organics Ltd vs Patanjali Ayurved Ltd — July 29, 2024 (Bombay High Court)**

The Plaintiff filed an interim application to seek directions against the Respondent for enforcement of an *ex parte ad interim* injunction issued against the Defendant, which restrained them from using a trade dress and carton packaging for camphor products that was identical and/ or deceptively similar to the Plaintiff’s said cone shape trade dress and artistic packaging. The Plaintiff alleged continued non-compliance by the Respondent with the said order.

Despite tendering an apology and stating that such sale, which infringes upon the said rights of the Appellant, will be stopped immediately, non-compliance with the directions became evident as the impugned products were still being offered for sale on the Respondent’s website on July 8, 2024,

and screenshots showing listing of the impugned product on the website was presented before the Court.

The Respondent claimed the alleged sale to be inadvertent and issued an unconditional apology. However, the Court did not accept the Defendant’s claim of inadvertent breach, noting the significant lapse of time and continued non-compliance. Considering these circumstances, an order to pay Rs. 4 crore to the Plaintiff was passed by the Court.

#### **18. Amba Shakti Steels Ltd. vs Sequence Ferro Private Limited — September 3, 2024 (Delhi High Court)**

The Appellant filed this appeal against an order passed by a Commercial Court, which had dismissed its application seeking injunction. The Appellant has alleged infringement of its registered trademark, its copyright, and passing off in this case, along with seeking a decree of permanent injunction, restraining the Respondent from using the trademark “AMMAJI”, or any other trademark deceptively similar to the Appellant’s trademark “AMBA” and “AMBA SHAKTI” in relation to their business of steel bars, ingots, and allied and cognate goods.

The Delhi High Court noted that the Respondent’s use of the trademark ‘AMMAJI’ was deceptively similar to the Appellant’s registered trademarks, including ‘AMBA’. It further observed that the Commercial Court, while rendering the impugned order, had erred by focusing on the individual elements of the two marks rather than considering the overall commercial impression of the competing marks. The Court noted that there was striking similarity between the marks, which *prima facie* projected the same commercial impression. Undeniably, there was also phonetic similarity

between the competing marks. The literal meaning of the words 'AMBA' and 'AMMA' are the same. In fact, they are synonyms. The suffix 'JI' is added to names as a mark of respect and does not alter the meaning of the words. Taking these factors into account, the Court was pleased to grant an interim injunction in favour of the Appellant.

**19. Kentucky Fried Chicken International Holdings LLC v. Muhammad Ali. M And Ors. —September 5, 2024 (Delhi High Court)**

The Plaintiff filed a suit seeking permanent injunction to restrain the Defendants from infringement of trademarks, rendition of accounts, damages, delivery up and from passing off the Plaintiff's registered and well-known trademark 'KFC', 'Kentucky Fried Chicken', contending that the Defendants were selling their food products in a packaging/ trade dress, which imitates the packaging/ trade dress used by the Plaintiff for its food products. It was further submitted that American Fried Chicken, which is the full form of the mark AFC, also forms part of some of the word marks of the Defendants, and is conceptually similar to the Plaintiff's prior trademark, Kentucky Fried Chicken. Furthermore, the font used by the Defendants while writing AFC in their Logo and products was identical to the font used by the Plaintiff to write KFC on their product packaging. The Defendants, it was alleged, were aware of the confusing nature of the impugned marks with the Plaintiff's KFC marks, however, still proceeded to adopting a conflicting mark to take advantage of the well-established goodwill and reputation vested in the Plaintiff's KFC trademarks.

The Plaintiff buttressed their claims by presenting evidence of its trademark registrations, extensive marketing campaigns, including endorsements by celebrities, to showcase that their red and white mark had acquired distinctiveness in the eyes of consumers.

The Court, after a perusal of the submissions and evidence, observed that a *prima facie* case was being made out, and not granting an injunction at this stage would cause irreparable damage to the Plaintiff. Thus, recognising that the balance of convenience tilted in favour of the Plaintiff, the Court granted an ad-interim injunction, restraining the Defendants from using the impugned mark or any similar marks.

**20. Vishesh Films (P) Ltd. v. Super Cassettes Industries Ltd. — September 2, 2024 (Delhi High Court)**

The Plaintiff filed a suit seeking to restrain the Defendant from releasing any sequels of Aashiqui, in particular, the third part, tentatively titled "Aashiqui 3"/ "Tu Hi Aashiqui"/ "Tu Hi Aashiqui Hai", without the Plaintiff's express consent.

It was alleged that their proprietary rights in the renowned film franchise "Aashiqui" are being violated by the Defendant, despite the existence of joint ownership under the agreements executed between the parties.

The Defendant, on the other hand, while admitting joint ownership over the Aashiqui Franchise, categorically denied any intention of producing another instalment of the Aashiqui Franchise or creating any derivative works based on the cinematographic films Aashiqui and Aashiqui 2. They asserted that the title of their proposed movie "Tu Hi Aashiqui"/ "Tu Hi Aashiqui Hai" is not similar to the Plaintiff's registered trademark or a sequential title, and therefore, there is no possibility of public confusion. The Defendant further undertook that their film, under the aforementioned titles, will be entirely distinct from the films in the Aashiqui Franchise; it shall have no sequential linkage, nor will it be a continuation/ adaptation/ derivative of the previous films.

The Court noted that permitting the Defendant to use a deceptively similar title, especially in light of public anticipation of a third sequel, would constitute infringement of the Plaintiff's trademark as it has the potential to mislead consumers, diluting the brand identity of the Aashiqui Franchise and causing consumer confusion. The Delhi High Court, therefore, issued an interim injunction, preventing T-Series from releasing any films under any titles incorporating 'Aashiqui'.

**21. Koteswar Chemfood Industries Pvt. Ltd. vs. Sachdeva and Sons Industries Pvt. Ltd. —September 17, 2024 (Delhi High Court)**

The Petitioner filed the present petition under Sections 46, 47, 56, 57 and 125 of the Trademarks Act, 1999, seeking rectification/ cancellation of the trademark PRIME, bearing registration no. 1258793, registered in the name of Respondent no.1 in class-30, as being deceptively similar and identical to the trademark of the Petitioner, i.e., PRIME. It was argued that the Defendant had not used the trademark for any other goods in class 30, except rice.

It was noted by the Court that these facts clearly indicate that the mark of the Petitioner, i.e., PRIME and mark of the Respondent no.1, i.e., "PRIME", are registered in Class-30 for similar goods, i.e., salt. Thus, the impugned trademark, in relation to the same class of goods, would deceive and cause confusion, as the goods in question are the same. Further, there is deceptive similarity between the marks of the Petitioner and the Respondent no.1. Further, the Court found that since the Defendant had registered the trademark (on a "proposed-to-be-used") only till January 1, 2024, and the same had not been renewed thereafter, the Court proceeded

to direct rectification of the Defendant's trademark registration.

## 22. Saregama India Limited vs The New Digital Media and Anr — September 11, 2024 (Calcutta High Court)

In a continuing copyright dispute between the parties, the Defendant moved an application to produce certain documents for cross-examination.

The Plaintiff, however, objected to it, arguing that the documents in question had not been disclosed previously, either in the list of documents or in the Judges' Brief of documents. The plea, basis which these documents are called for, was also not present in the written statement. As such, the plea itself would be alien to the suit. All these documents were, therefore, extraneous to the suit.

The crux of the issue, in this case, was whether discovery and production of some documents that were neither in the pleading nor disclosed hitherto by the Defendants could be allowed.

The Court dismissed the Plaintiff's objections, considering them to be merely on technicalities and consequently allowed them to be produced solely for the purpose of cross-examination. It was reiterated that the documents could be used for the limited purpose of cross-examination to impeach the witness's credibility and not to substantiate a new defense. Moreover, those documents must not be used to set up a defence case or in support of pleadings in the written statement.

## 23. Gojo Industries Inc vs The Registrar of Trademarks and Anr — September 17, 2024 (Calcutta High Court)

The Appellant filed the present appeal under Section 91 of the Trademarks Act, 1999, against the order passed by the Hearing Officer of Trade Marks Registry, dated March 31, 2023. Counsel for the Appellant relied on the judgment passed by this Court in *Visa International Ltd. Vs. Visa International Service Association & Anr*, being IPDTMA/82/2023 with GA-COM/1/2024, dated August 2, 2024, wherein it was held that the "*The Registrar dealing with an application under the Trade Mark Act is a quasi-judicial and delegation of power under sub-section (1) of Section 3 of the Act are not empowered to pass quasi-judicial orders.*" He submitted that in the present case, the same officer had passed the impugned order, being a Hearing Officer of the Trade Marks Registry.

The Court considered these submissions and accordingly set aside and quashed the impugned order. The matter was remanded back to the Registrar of Trademarks, Kolkata, for a

fresh hearing, by either himself or any competent officer other than the Officer who had passed the impugned order and to pass reasoned and speaking order by giving an opportunity of hearing to all the parties of the objection, within a period of one year from the date of receipt of the copy of this order.

## 24. Radico Khaitan Ltd vs M/S Raina Beverages & Ors. — September 26, 2024 (Delhi High Court)

The Plaintiff sought a permanent injunction against the Defendant to protect its trademark "Magic Moments Remix," and its associated trade dress. It was argued that despite a previous court order against the Defendants, they continued to infringe the products in non-compliance with the directions.

The Court observed from the averments made in the plaint and the evidence on record that the Plaintiff has been able to prove that it is the registered proprietor of the mark "Magic Moments Remix" and has a copyright over the trade dress of the mark "Magic Moments Remix", including the dancing figures represented on the bottles of its products. The trade dress has been used by the Plaintiff since 2008, and is also registered in its name. The Plaintiff was able to demonstrate and prove its goodwill and reputation in respect of the same. The comparison of the two products categorically shows that the bottles are identical in terms of colour combination and arrangement of letters, marks and figures. Further, there were striking similarities between both the products as they featured identical colour combinations like a black cap and ribbon, similar logo styles, dancing figures on both bottles and the placement of flavour indicators, demonstrating a clear case of copyright infringement and passing off. The Court found the Defendants to be habitual infringers and accordingly granted a permanent injunction.

## 25. M/S SKR Food Products v. The Controller General of Patents, Designs & Trade Marks — October 14, 2024 (Madras High Court)

The Petitioner via this writ petition sought the issuance of a writ of mandamus, to direct the Respondents number one and two to receive the Petitioner's notice of opposition either by way of electronic / online mode or physical copies. The Petitioner was the registered proprietor of the trademark "JUBILEE DIAMOND" but one of the Respondents had filed an application for registration of the same mark in his favour. Thereafter, an opposition was filed by the Petitioner. However, since the opposition was not instituted within the prescribed time period, it was not considered by the Trade Marks Registry.



The Court upheld the order, dismissing the application of the Petitioner to file for opposition beyond the period prescribed and held that the Petitioner was at liberty to file an appeal before the Appellate Board under Section 91 of the Trade Marks Act, 1999.

**26. Pravesh Narula vs Raj Kumar Jain Trading — October 29, 2024 (Delhi High Court)**

An application was filed by the Plaintiff to amend the plaint, arguing that the fact of registration of trademark is a subsequent fact that arose during the pendency of the proceeding and was necessary to be included in the plaint to claim appropriate relief and avoid multiplicity of proceedings. It was further contended that amendment of the plaint can be done at any stage, even after the trial had commenced if it was necessary for proper adjudication of the matter.

The Defendant, on the other hand, opposed the application, arguing that issues have already been framed by the Court and that such amendment will be equal to adding a new cause of action, which by its own lack of diligence was not done before. The Court perused these submissions and noted that the power to amend pleadings is broad in scope and can be allowed at any stage to determine the real controversy between the parties. It further observed that it was necessary for the Court to take note of subsequent facts and shorten litigation, accordingly. Thus, holding that there is no impediment in allowing the present application, the Court directed the amended plaint to be taken on record.

**27. Grey Matters Educational Trust vs Examiner of Trademarks — October 23, 2024 (Delhi High Court)**

The Appellant challenged the impugned order passed by the Respondent wherein its trademark application for “Planet E School” was refused. They argued that the trademark of the Appellant is entirely different from the cited marks, and the same is neither identical nor deceptively similar to other cited marks. Moreover, their mark was different visually, phonetically, and structurally, from the other cited marks.

The Respondent, on the other hand, submitted that there are other registrations for marks incorporating “Planet”, which already exist. One of the cited marks is also with respect to educational services, so there would be a clear case of confusion, if the mark of the Appellant is allowed to be registered as the cited marks are identical/ similar to the goods covered under the application of the impugned trademark.

The Court observed that the trademark applied for by the Appellant for registration is distinctive from other marks,



when considered in its entirety. The anti-dissection rule is a well-established principle of trademark law that requires trademarks to be viewed as a whole, rather than being broken down into individual parts. Further, it was noted that merely because the word “Planet” is a generic term, the mark of the Plaintiff when taken as a whole, cannot be refused. The mark of the Appellant is a combination of the words, “Planet”, “E” and “School”. When seen independently, the said words are generic, however, when the said words are combined, it becomes inherently distinctive owing to their unique character. When viewed as a whole, the mark of the Appellant is distinctive and capable of distinguishing the goods or services of one person from those of another. Therefore, objection under Section 9 of the Act is not sustainable. Therefore, order of the Registry was set aside, and the Appellant was allowed to proceed with registration (being limited to Punjab).

**28. Cosmos Premises Pvt. Ltd. v. Novex Communications Pvt. Ltd — October 21, 2024 (Bombay High Court)**

The Petitioner assailed a Magistrate’s order in which the restaurant was held liable for playing songs assigned to Novex, unauthorisedly at an event.

The Court held that firstly, Cosmos restaurant is not a separate legal entity and cannot be made an accused. Secondly, there were no specific allegations against them in the complaint and yet the Magistrate had passed the order. It was observed that apart from merely mentioning that the persons were directors/ managers of the accused company, no specific averments were made against them, to state or imply that they were responsible for the management of the business of the said restaurant, as on the date of the alleged offence.

Accordingly, the Court set aside the Magistrate's order on the ground that there was non-application of mind since the role of the accused and their consequent liability was not averred in the complaint itself, yet the order was passed.

### 29. **Monster Energy Company vs The Registrar of Trademarks — November 7, 2024 (Madras High Court)**

The Appellant filed an application challenging the order passed by the Respondent, refusing to register the Appellant's trademark "SUPER FUEL", on the ground that it is identical to the registered trademark, "FUEL". The Appellant contended that its trademark is "SUPER FUEL", and it proposes to register it under Class-32 as a non-alcoholic beverage, including carbonated drinks and energy drinks, etc. Considering the fact that the trademark referred to in the impugned order pertains to different products, the Appellant argued that there is total non-application of mind on the part of the Respondent while passing the impugned order, refusing to register the Appellant's trademark.

The Court agreed with the submissions advanced by the Appellant. It also noted that unless and until the Appellant is permitted to publish its trademark "SUPER FUEL" in the Trade Marks Journal, the question of rejecting the Appellant's application at this stage by the Respondent does not arise. The Court, therefore, quashed the impugned order and directed the Respondent to permit the Appellant to publish its trademark "SUPER FUEL" in the Trade Marks Journal.

### 30. **M/S M.H. One Tv Network Pvt. Ltd. vs M/S Mh 7 News and Anr — November 20, 2024 (Delhi High Court)**

The Petitioner, alleging deceptive similarity of the Respondent's trademark with MH One Network's mark, sought cancellation of the registered trademark of the Respondents. They argued that the Respondent's mark would cause confusion, especially in light of the similar nature of business activity that both the parties are engaged in.

The Court noted that the Petitioner has used this mark extensively and gained goodwill. The deceptive similarity of the Respondent's mark would lead to consumer confusion and damage the earned reputation of the Petitioner, putting the Respondent at an unfair advantage.

The Court applied the Triple Identity Test (similar mark, services, and consumers), and held that the services provided by both the parties are of similar nature, i.e., transmission of various entertainment programmes. Further, the target consumer is also similar, i.e., watching Entertainment and News Channels. Thus, the Triple Identity Test, i.e., similar mark, similar services for which the mark has been registered

and similar consumers, is satisfied. Thus, the Court directed cancellation of the Respondent's trademark "MH7".

### 31. **Ab & T Lifestyle Spaces LLP vs The Registrar of Trade Marks — November 21, 2024 (Madras High Court)**

The Appellant filed this appeal challenging the impugned order of the Respondent (Registrar), refusing registration of its trademark ARC – A GATEWAY TO YOUR FUTURE" on the ground that the said mark is objectionable under Section 11(1) of the Trademarks Act, 1999, and also on the ground that the Appellant's Trade Mark has not acquired distinctiveness by way of long use, as mentioned in the proviso to Section 9 of the Trade Marks Act.

The Appellant challenged the order on the grounds of violation of the principles of natural justice and arbitrariness, by arguing that similar device marks have been allowed to be registered by the Respondent and therefore, there cannot be any discrimination with regard to the Appellant's trademark alone.

The Court held that it is settled law that only through speaking orders and by adhering to the principles of natural justice, the Respondent can refuse granting trademark registration. However, in the instant case, as seen from the impugned order, it is a non-speaking order, and the Respondent has not adhered to the principles of natural justice. Therefore, the Court quashed the order, directing the Respondent to publish the Appellant's mark in the Trade Marks Journal.

### 32. **Philip Morris Brands Sarl vs M/S Rahul Pan Shop & Ors. — November 26, 2024 (Delhi High Court)**

The Plaintiff filed a suit seeking permanent injunction, restraining the Defendants from infringing its trademark and copyright. It was contended that the Plaintiff held a registration for the trademark 'MARLBORO'. They asserted that they had spent a considerable amount of money in promoting and advertising its products bearing the 'MARLBORO' trademarks and the promotional expenses of the Plaintiff for the said products were presented before the Court. In March 2023, the Plaintiff came across the counterfeit 'MARLBORO ADVANCE COMPACT' cigarette packs sold by the Defendants no.1 and 2. Thereafter, the Plaintiff asked its investigators to purchase 20 packs of the counterfeit products. From this investigation, it emerged that Defendants no. 3 and 4, through Defendant no.5, were supplying the said counterfeit products to Defendants no.1 and 2.

It was averred that all the counterfeit cigarette packs purchased by the Plaintiff, through its investigator, bore the same code “OXO WUA KH1 546”, whereas the genuine cigarette packs of the Plaintiff bore/ bear unique codes. This unique code is printed during the manufacturing process, and is different on every pack. The comparison of the two products categorically showed that the cigarette packs are identical in terms of colour combination and arrangement of letters, marks and figures. Hence, it was evident to the Court that the Defendants had replicated the contents, colour scheme, the ‘MARLBORO’ trademarks and ‘ROOFTOP’ device of the Plaintiff’s packaging.

Accordingly, a clear case of infringement of trademark and copyright was made out as the Defendants had taken unfair advantage of the reputation and goodwill of the Plaintiff’s trademarks/ artistic works and have also deceived unwary consumers of their association with the Plaintiff by dishonestly adopting the Plaintiff’s registered marks without any plausible explanation. Therefore, the Plaintiff established a case of passing off as well. The Defendants did not participate in the proceedings despite service. Ultimately the Court passed a decree of permanent injunction in favour of the Plaintiff.

### 33. Metro Brands Ltd. v. Nice Shoes LLP — November 18, 2024 (Bombay High Court)

Application was filed seeking an injunction to restrain the Defendants from infringing the Applicant’s registered trademarks, i.e., the ‘MOCHI’ marks, using the impugned mark ‘DESIMOGHI’ and/ or any other marks identical or deceptively similar to the registered mark of the Applicant. The Applicant contended that they were the owners and the registered users of the ‘MOCHI’ marks, which had been in extensive use since 1977. Resultantly, the mark had become well-known among members of the public, who had come to identify it with their products. However, in August 2022, they come to know of the existence of a website “www.desimochi.com”, that sold footwear using the impugned mark, ‘DESIMOGHI’. It was argued that the impugned mark was identical and/ or deceptively similar to Applicant’s ‘MOCHI’ marks.

The Bombay High Court stated that *prima facie*, the Applicant had established that there had been “open, continuous, and extensive use” of the ‘MOCHI’ mark, which had in fact become well-known among members of the public in India and globally. Therefore, the Court proceeded to grant temporary injunction, restraining the Defendants from infringing the Applicant’s registered trademarks, i.e., the ‘MOCHI’ marks using the impugned marks and/ or any other mark identical and/ or deceptively similar to the said registered marks of Applicant.

### 34. Ricaria Support Services Private Ltd. vs The Registrar Of Trade Marks — November 19, 2024 (Madras High Court)

An appeal was filed in this case, challenging the order dated February 07, 2024, passed by the Respondent under Section 11 of the Trade Marks Act, refusing to register the Appellant’s Trade Mark “MARS BY GHC” applied in class 5, i.e., Pharmaceuticals, Medical and Veterinary preparations, etc. The Appellant argued that there would be no likelihood of public confusion because the Appellant’s mark viz., “MARS BY GHC” were intended for a broader spectrum of products, including pharmaceuticals, medical and veterinary preparations, sanitary preparations for medical purposes, dietetic food and substances, adapted for medical or veterinary use, among others, whereas the cited mark under the impugned order viz., “MARS” involves pharmaceuticals and medicinal preparations, which involves prescription-only pharmaceutical items.

The Court noted that the Respondent’s order was non-speaking as it failed to specify which category of Section 11 applied. It also ignored the Appellant’s willingness to modify the mark’s size to enhance the source, “GHC”. The Court, thereby, quashed the impugned order, directed the mark to be published in the Trade Marks Journal, and allowed opposition petitions to be filed and adjudicated per merits.

### 35. Samsudeen A vs The Registrar Of Trade Marks — November 7, 2024 (Madras High Court)

The question that arises for consideration in this appeal is whether it would suffice for the purpose of complying with the requirements of Rule 18(2) of the Trade Marks Rules, 2017, if the first Respondent had despatched the email notice to the e-mail address given by the Appellant in his trademark application. The Appellant contended that he never received the opposition notice of the second Respondent and the time to file counter-statement would only begin post the receipt of the notice. The Court, through a purposive interpretation of Rule 18(2), held that the Appellant had not received the notice and that the first Respondent had failed to provide proper acknowledgment of receipt. The Appellant was, hence, permitted to file a counter-statement within three weeks.

### 36. Beerco Ltd vs The Registrar of Trade Marks — November 5, 2024 (Madras High Court)

The Appellant challenged the Respondent’s order, wherein the Registrar had refused to register the trademark “BeerCo” in class 32. It was challenged on two grounds: i) It is a non-speaking order, with regard to the contentions of the Appellant raised before the Respondent and, ii) The Appellant had obtained several prior registrations, which

include the word BeerCo and having obtained those trademark registrations, the Respondent ought not to have refused to register the Appellant's trademark "BeerCo" in class 32.

The Appellant contended that they had adopted an inherently distinctive mark with *bona fide* and honest intentions. However, the Respondent, i.e. Registrar, had failed to consider the honest adoption of the mark and proceeded to pass a non-speaking order, while erroneously applying Section 9(1)(b) of the Trade Marks Act, 1999. Considering these factors, the Court allowed the appeal and quashed the impugned order.

### 37. Ganesh Grains Ltd. vs Dharmendra Kumar Gupta – November 22, 2024 (Delhi High Court)

The Plaintiff filed a rectification petition under Section 57, read with Section 47(1) 4 of the Trade Marks Act, 1999, seeking cancellation/ removal of the Defendant's trademark "GANESH HARA MATAR". The Petitioner began its business under the trademark "GANESH" in the year 1936 through its predecessor partnership firm "Ram Gopal Ram Ratan". They applied for the first trademark application in the 1950s and has since obtained over 85 trademark registrations in its favour for the mark "GANESH" and its formative variants. The goodwill and reputation of the Petitioner was evidenced via the sales turnover and promotional expenditure for its business under the trademark "GANESH". The Defendant did not appear for the hearing despite service, nor did he file any invoices or any other documents evidencing the use of the impugned mark either.

The Court held that the adoption and use of the impugned mark by the Respondent, which is very similar to the trademark 'GANESH' of the Petitioner, was likely to create confusion in the market. It was held that not only was the trademark of the Respondent confusingly/ deceptively similar to the Petitioner's prior adopted/ registered trademark 'GANESH' or its formative marks, but the nature of the goods of the Petitioner and the Respondent were also identical, i.e., edible food products falling in class 30. Therefore, it was held that the impugned mark had been adopted by the Respondent dishonestly, to benefit from the established goodwill and reputation of the Petitioner. Consequently, the impugned trademark of the Respondent was directed to be removed from the Register of Trademarks.

### 38. Kent RO Systems Ltd. & Anr v. Suresh Kumar & Ors. – September 11, 2024 (Delhi High Court)

The Plaintiff, an established company engaged in manufacturing and selling a diverse range of home electronics like water purifiers under its well-known trade

mark "KENT", alleged that several water purifier systems being sold by the Defendants, under infringing marks like "NEW AQUA GRAND+", have the same shape as the Plaintiff's patented water purifier design. The Plaintiff further alleged public confusion and deception because the Defendants were copying Kent's design and selling them on e-commerce platforms.

Based on the facts of the case, the Court held that the Plaintiffs had been able to make out a *prima facie* case for the grant of an *ex-parte ad-interim* injunction, that the balance of convenience lied in their favour and that if the Defendants were not stopped, then there was a likelihood of the Plaintiffs suffering irreparable harm, loss and injury. The Court restrained the Defendants from selling the infringing products and directed the e-commerce platform to remove the concerned products and share information of the sellers.

### 39. Arijit Singh vs Codible Ventures LLP and Others – July 26, 2024 (Delhi High Court)

It was alleged that various Defendants were involved in infringing acts, including, creating and maintaining AI tools to modify and synthesise the Plaintiff's voice, falsely associating their events with the Plaintiff's name and image/ likeness, sale of merchandise bearing the Plaintiff's name, caricature and likeness, creating and maintaining platforms to store, create, search and share GIFs in respect of the Plaintiff and lastly, registering websites with domain names that wholly contain the Plaintiff's name in their address. It was contended that the Defendants' infringing acts amounted to dilution and tarnishing of the Plaintiff's personality rights, as well as his right towards exclusive commercial exploitation of the same.

The Delhi High Court reaffirmed the position of law that celebrities are entitled to have facets of their personality, such as name, image, likeness, voice and signature, protected against unauthorised third-party commercial exploitation. Consequently, the Court granted the prayers sought in the interim application by granting ad-interim dynamic injunctions without notice to certain Defendants to prevent their evasion of the order.

This case underscores the significance of protecting personality rights, particularly aspects of personality such as name, face, image and likeness, voice and signature that can be reproduced, stored and distributed through AI tools and platforms extensively in this modern day and age. The Court affirms the valuable rights that celebrities possess with regard to their personality, as held in *Anil Kapoor vs Simply Life India*, as well as the necessity to give dynamic injunctions in cases of this nature, applying *Applause Entertainment Private Limited vs Meta Platforms Inc.*



## List of Contributors

**Swati Sharma**

Partner (Head – Intellectual Property)  
[swati.sharma@cyrilshroff.com](mailto:swati.sharma@cyrilshroff.com)

**Revanta Mathur**

Partner  
[revanta.mathur@cyrilshroff.com](mailto:revanta.mathur@cyrilshroff.com)

**Gitika Suri**

Director - Patents  
[gitika.suri@cyrilshroff.com](mailto:gitika.suri@cyrilshroff.com)

**Rohin Koolwal**

Principal Associate

**Sandeep Pandey**

Principal Associate

**Andri Shukla**

Senior Associate

**Sannat Chandna**

Senior Associate

**Akshit Singla**

Associate

**Aryaman Vachher**

Associate

**DISCLAIMER:**

This newsletter has been sent to you for informational 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 on the issues reported herein and should you have any queries in relation to any of the issues reported herein or on other areas of law, please feel free to contact at [cam.publications@cyrilshroff.com](mailto:cam.publications@cyrilshroff.com).

This newsletter is provided free of charge to subscribers. If you or anybody you know would like to subscribe to Iprécis please send an e-mail to [cam.publications@cyrilshroff.com](mailto:cam.publications@cyrilshroff.com), include the name, title, organization or company, e-mail address, postal address, telephone and fax numbers of the interested person.

If you are already a recipient of this service and would like to discontinue it or have any suggestions and comments on how we can make the newsletter more useful for your business, please email us at [unsubscribe@cyrilshroff.com](mailto:unsubscribe@cyrilshroff.com).

**Cyril Amarchand Mangaldas**  
Advocates & Solicitors

**100+** years of legacy

**1000** Lawyers

**Over 200** Partners

Peninsula Chambers, Peninsula Corporate Park, GK Marg, Lower Parel, Mumbai – 400 013, India  
**T** +91 22 6660 4455 **F** +91 22 2496 3666 **E** [cam.mumbai@cyrilshroff.com](mailto:cam.mumbai@cyrilshroff.com) **W** [www.cyrilshroff.com](http://www.cyrilshroff.com)  
Presence in Delhi-NCR | Bengaluru | Ahmedabad | Hyderabad | Chennai | GIFT City | Singapore | Abu Dhabi