



MONTHLY ROUNDUP

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BRIEF NOTE

JAN VISHWAS (AMENDMENT OF PROVISIONS) ACT, 2023: DECRIMINALIZATION OF IP LAWS

The Jan Vishwas (Amendment of Provisions) Act, 2023, effectual from on August 1, 2024, marks a significant shift in India's approach to IPR enforcement. This legislative change decriminalizes various offenses under key IPR laws, including the Patents Act, Trade Marks Act, and Geographical Indications of Goods Act. A brief overview and explanation of the key sections amended in various IPR laws:

The Patents Act, 1970:

1. Section 120: Increased penalties for unauthorized patent claims. The fine is now up to 10 lakh rupees with an additional 1000 rupees per day for continuing violations.
2. Section 121: The section is omitted. Thus, decriminalized the misuse of the term 'Patent Office' by removing imprisonment.
3. Section 122: Revised penalties for false entries in the register, removing imprisonment and introducing sales-based fines. (0.5% of the total sale or turnover or gross receipts, or 5 crore rupees, whichever is less)
4. Section 123: Increased penalties for unauthorized disclosure of information and introduced penalties of continuous offence. (further penalty of Rs.1000 for every day after the first instance during which such default continues).
5. New Sections 124A and 124B: Introduce adjudication processes and appeal mechanisms.

The Trade Marks Act, 1999:

1. Section 107: Replaced imprisonment with financial penalties for falsely representing trademarks as registered.
2. Sections 106, 108, and 109: Omitted, removing criminal penalties for various trademark-related offences.

Geographical Indications (Registration & Protection) of Goods Act, 1999:

1. Section 42: Replaced imprisonment with financial penalties for falsely applying geographical indications.
2. Sections 43 & 44: Omitted, removing criminal penalties for various GI-related offenses.

For detailed information refer to the notification here- [Read More](#)



NEWS UPDATES

PATENTS

Delhi High Court Clarifies Scope of Product-by-Process Patent Claims

The Delhi High Court's Division Bench has provided crucial clarity on product-by-process (PBP) claims in India through its judgment in *Vifor (International) Limited v. MSN Laboratories Pvt. Ltd.* The court ruled that PBP claims should be treated as product patents under Section 48(a) of the Patents Act, rejecting the notion that they should be limited to process claims. The decision emphasizes that PBP claims must define a novel and non-obvious product, not just a novel process. The court also established that the same criteria used to assess a product's inventiveness during patent examination should apply when judging infringement cases. To balance innovation and public interest, the court introduced a "rule of necessity," allowing PBP claims only when the product cannot be defined without referencing its manufacturing process. This landmark ruling aims to provide clearer guidelines for patent applicants and courts dealing with PBP claims in India.

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Case of IIT Madras v. The Controller of Patents and Designs on 11 June 2024.

Respondent No. 1 rejected the appellant's innovation, which involved doping potassium into ammonium perchlorate without the need for a catalyst or reactant. According to Section 3(a) of the Patents Act, the innovation was rejected because it was deemed frivolous, lacked an inventive step, lacked industrial competence, and used a known technique without creating a new product [Section 2(1)(ja) and 2(1)(ac)]. Potassium was obtained from the filtering material by ammonium perchlorate by means of dissolution, filtering, heating, and additional heating. The Court decided that it was a finding rather than an invention because it was deemed common knowledge, did not involve a new reactant, and did not produce a product that had not been discovered before.

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Case of West Bengal Chemical Industries v. M/S. GTZ (India) Pvt Ltd. on 25 June (Calcutta High Court).

West Bengal Chemical Industries, the petitioner, alleged that the respondents had violated their patented methods for producing ferric carboxy-maltose, a medicinal composition. The Court dismissed the petition, citing the patents' lack of novelty as evidence that the petitioner had not established a prima facie case for an interim injunction. It was brought to light that the patents in question covered known chemicals rather than novel goods, which undermined the petitioner's assertions of exclusivity under Sections 48(a) and (b) of the Patents Act.

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TRADEMARKS

Tesla v. Tesla Power: EV Giant's Trademark Battle Heads to Mediation

Elon Musk's Tesla Inc. has filed a lawsuit against Tesla Power India Private Limited for trademark infringement, passing off, and unfair competition. The dispute centers on the defendants' use of "TESLA POWER" and "TESLA POWER USA" branding, which Tesla claims infringes on its trademark. Despite initial assurances from the defendants that they weren't manufacturing EVs, subsequent evidence suggested otherwise. The Delhi High Court, under Justice Mini Pushkarna, issued orders for the defendants to disclose their EV sales. As the case progressed, both parties expressed willingness to explore mediation. Consequently, the court has referred the matter to the Delhi High Court Mediation and Conciliation Centre, potentially paving the way for an out-of-court resolution to this high-profile trademark dispute.

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**Delhi High Court Grants Interim Relief to Domino's in Trademark Dispute with Donito's.**

The Delhi High Court has ordered Punjab-based food business MG Foods to stop using the trademark "Donito's," which was determined to be confusingly similar to "Domino's," as an interim remedy for Domino's Pizza. Dominos was granted an injunction based on the consideration of both potential irreversible injury and convenience, as noted by Justice Anish Dayal in her ruling in favour of the company. The court acknowledged the potential of consumer misunderstanding as well as the substantial goodwill connected to the Domino's trademark.

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SC dismisses MakeMyTrip appeal against Google over trademark.

In its lawsuit against Google, the online travel agency MakeMyTrip claimed that the Google Ads program violated its trademarks; however, the Supreme Court declined to provide remedy. charged Google of using sponsored links to favour Booking.com, a competitor. MakeMyTrip claimed that Google's Google Ads program violated its trademark. It said that Booking.com's advertisement category frequently appeared as the first result when its name was searched using the Google search box. In dismissing the appeal, the supreme court ruled that Booking.com is not infringing on MakeMyTrip's trademark.

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Fashion Giant 'Peter England' secures victory in Trademark Battle Against Delhi Shop

The Delhi High Court granted Aditya Birla Fashion and Retail Ltd. a significant win in their trademark infringement case. Justice Mini Pushkarna issued an interim injunction against a Delhi shop, prohibiting the use of the 'Peter England' trademark on signboards and business documents. The court found that Aditya Birla Fashion, which has held the 'Peter England' trademark since 1995, had established a prima facie case. The company argued that the defendant's unauthorized use of the mark on their storefront in Khanpur, Delhi, was deliberately misleading customers. This ruling underscores the importance of trademark protection in the competitive fashion industry and sets a precedent for similar cases.

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Case of Girnar Food & Beverages Pvt Ltd. v. The Registrar of Trademarks & Anr. on 18 June 2024 (Calcutta High Court).

Under the trademarks "JUMBO," "FIVE JUMBO," and the picture of five elephants, the appellant has been selling tea since 1985. All of these trademarks have been registered since 1989. The appellant discovered that respondent number two had submitted an opposition to the registrar's decision to reject the application for registration of the mark "HAATHI," which had been filed. The Court determined that Respondent No. 2 could only present documentation demonstrating the use of the "HAATHI" mark prior to 2002. The decision found that the certificate of registration granted to respondent no. 2 is recalled and the contested order of the Assistant Manager of Trade Marks is invalidated since the two marks are confusingly similar and serve the same class of consumers.

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COPYRIGHTS

Ilaiyaraaja's copyright claims challenged by Echo Recording before the Madras High Court.

Echo Recording Company has contended in a major legal battle before the Madras High Court that famous composer Ilaiyaraaja, unlike modern composer A.R. Rahman, did not retain copyrights from the film makers and hence cannot claim rights to the songs he created between 1970 and 1990. A division bench made up of acting Chief Justice R. Mahadevan and Justice Mohammed Shafiq heard Echo's appeal, which contested a single judge's ruling recognizing Ilaiyaraaja's unique rights over the 4,500 songs he wrote within the allotted time.

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Delhi HC: Pending Compulsory License Application No Defence for Copyright Infringement

In a significant ruling, the Delhi High Court's Justice Mini Pushkarna granted an interim injunction against Al-Hamd Tradenation, prohibiting the use of Phonographic Performance Limited's copyrighted sound recordings. The court clarified that merely filing an application for a compulsory license does not entitle the applicant to infringe on the copyright owner's exclusive rights. Despite Al-Hamd's pending application for a compulsory license, the court emphasized that until such a license is actually granted, the applicant must respect the copyright holder's legal protections. This decision reinforces the principle that copyright



infringement cannot be justified by a pending application, ensuring that copyright owners' rights remain protected throughout the licensing process. The judgment provides crucial guidance in balancing the interests of copyright holders and potential licensees in intellectual property matters.

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Case of Colgate Palmolive Company & Anr vs Nixi & Anr on 26 June, 2024 (Delhi High Court).

In order to stop defendants from impersonating the Colgate Group and defrauding job seekers, the plaintiffs filed a lawsuit in which they sought permanent injunctions to stop trademark and copyright infringement and passing off. One of the defendants' domain names and email addresses was <http://www.colgatepalmoliveindia.in>. The pertinent bank accounts, emails, and domain names have already been barred and frozen by the court. In spite of this, the defendants registered <http://www.colgatepalmolive.work>, another domain, to carry with their fraudulent activities. In order to help the plaintiffs, the court granted interim orders directing GoDaddy.com LLC to furnish information about the registrant and owner of the domain name www.colgatepalmoliveindia.in.

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OTHER IP

Delhi High Court upholds personality rights of Aap Ki Adalat fame, Rajat Sharma.

A recent injunction from the Delhi High Court forbids Mr. Ravindra Kumar Choudhary from using any images, videos, or the name Rajat Sharma in any way, including as a trademark, logo, business style, domain name, social media posts, audio-visual content, or in conjunction with any services. The purpose of this action is to guard against any violation of the journalist's right to privacy. The person posing as a political satirist was directed by the High Court to stop using "Jhan Diya TV" and "Baap Ki Adalat." These titles were seen to be confusingly similar to the news channel India TV of journalist Rajat Sharma and his well-known show "Aap Ki Adalat."

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Delhi High Court Mandates Code of Conduct for IP Agents, Tackles Misleading Advertising

The Delhi High Court, in the case of Saurav Chaudhary v. Union of India, has called for a comprehensive code of conduct for Patent and Trademark Agents. This landmark ruling addresses the growing concerns over professional negligence and misconduct in the IP sector. The court directed the Controller General of Patent, Design and Trademark to draft and implement this code by December 31, 2024. Additionally, the judgment tackles the issue of misleading advertisements in IP services, mandating that all promotional materials must include the registered Agent's name and registration number. The court also ordered the formation of an ad-hoc committee to handle complaints against IP agents. This decision marks a significant step towards enhancing accountability and professionalism in India's intellectual property landscape.

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Karnataka High Court Pioneers Academic Involvement in IP Division Rule-Making

The Karnataka High Court has taken a progressive step in intellectual property jurisprudence by forming a sub-committee to draft rules for a new IP Division. Announced on June 20, 2024, this initiative follows similar developments in Delhi, Madras, and Calcutta High Courts, which emerged after the dissolution of the Intellectual Property Appellate Board in 2021. What sets Karnataka's approach apart is the inclusion of Professor Dr. Arul Scaria from NLSIU Bangalore alongside the Registrar (Judicial) in the sub-committee. This unique collaboration between judicial and academic expertise aims to create comprehensive and well-informed IP Division rules. The move potentially sets a new benchmark for IP jurisprudence in India, combining practical legal knowledge with academic insights.

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Bombay High Court: Pidilite granted temporary relief in M-Seal PV container dispute

Astral Ltd., a listed business with its headquarters in Ahmedabad, has been directed by the Bombay High Court to discontinue selling its Solv bond solvent cement solutions in containers similar to Pidilite Industries' M-Seal PV Seal. Pidilite filed a pass-off and infringement action and asked for an injunction to stop more harm. Pidilite was granted temporary relief by the court, emphasizing how important it is to protect intellectual property rights.

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Case of Pocket FM Private Limited vs Novi Digital Entertainment Private Ltd and Anr. on 13 June, 2024 (Delhi High Court).

The plaintiff, who adapts literary works into audio formats, acquired exclusive rights to “Yakshini” from Mr. Anand Usha Borkar in 2023 and published it as an audio series. They had engaged with Defendant No.1, who refused to sign a Non-Disclosure Agreement but provided a Release Form. The plaintiff alleges Defendant No.1’s “Yakshini” series on Hotstar OTT is similar to theirs, misrepresenting an affiliation and copying unique elements like characters Aghori and the Blue Sun. They claim damages of Rs.2,00,01,000/- and seek an interim injunction to prevent the release of Defendant No.1’s series. However, the Court noted the plaintiff’s delayed response and lack of evidence, favoring Defendant No.1.

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