



INTELLECTUAL PROPERTY



THE IP ODYSSEY

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TRADEMARK TAPESTRY

PHONEPE LOSES TRADEMARK BATTLE IN MADRAS HIGH COURT

The Madras High Court on 22nd August 2023 decided on the appeal filed by PhonePe to set aside an order vacating the ad-interim injunction granted in its favor. The court while deciding the appeal emphasized on the inconsistent claims taken by the Plaintiff regarding the origin of the "Pe" mark. PhonePe argued it coined the "PhonePe" mark in 2015, with the "Pe" element as a unique identifier deserving automatic protection. DigiPe contended that "PhonePe" and "DigiPe" catered to different services. It was further stated that the Plaintiff provides its services to businesses/merchants by enabling them to accept payments and services from its customers for the products and services on their platform. Whereas the Defendants "DigiPe" App facilities services only to merchant establishments and the same is not used by an individual customer. DigiPe also argued "PhonePe" was a generic term, not a descriptive one and if it is taken as descriptive, the same cannot have acquired distinctiveness. PhonePe's admission admitted that "CardPe" was the prior user and adopter of the "Pe" formative mark and that it didn't originate the "Pe" formative mark was inter alia inconsistent statements, factored into their appeal's dismissal. The Division Bench made observations that the different operational scopes of both companies and that the Plaintiff was forum shopping. The case was dismissed by Madras High Court for failing to establish a strong case and withholding essential facts from other High Courts. PhonePe's inconsistent legal positions and differing business operations played a significant role in their defeat at the Madras High Court.

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PROCEEDINGS RENDERED RES JUDICATA BEFORE THE HON'BLE DELHI HC ON IPAB'S CANCELLATION OF IMPUGNED TRADEMARK

In this matter before the Division Bench of Delhi HC, Sun Pharma sought an interim injunction against Mylan Laboratories over an anti-cancer drug. The contention put forth was that the Plaintiff's registered mark 'OXIPLAT' was phonetically similar to the Defendant's registered mark 'SOXPLAT'. The interim application was rejected by the Division Bench stating that since the

anti-cancer drug is sold on the prescription of a doctor, the chemist would be aware of the phonetic similarity and that there is no likelihood of confusion. Thereafter, the Plaintiffs sought cancellation of Defendant's registered trademark while the Defendants sought cancellation of the Plaintiff's registered trademark. IPAB held that the marks were deceptively similar and by the virtue of prior adoption and use by Plaintiff, it cancelled the Defendant's trademark. This rendered the present proceedings res judicata as Defendants gave up the mark SOXPLAT since the said judgment of the IPAB has not been challenged by the Defendants, the Defendants can no longer use the mark 'SOXPLAT'. The Hon'ble Court observing the aforesaid disposed the suit and keeping in mind the conduct of the Defendant, the court awarded costs of Rs. 5 lakhs to the Plaintiffs.

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DELHI HIGH COURT REJECTS SUN PHARMA'S INTERIM INJUNCTION APPLICATION AGAINST FINECURE'S ANTI-ACIDITY DRUG DESPITE FINDING TRADE MARK INFRINGEMENT

The Delhi High Court addressed a crucial aspect of trademark law, challenging the assumption that trademark ownership automatically guarantees relief against infringement. Sun Pharma alleged trademark infringement by Finecure's product "PANTOPACID," claiming it resembled their "PANTOCID," both containing the same salt preparation. Notably, the court noted a substantial delay on Sun Pharma's part in seeking injunctive relief, as they had been aware of Finecure's use of "PANTOPACID" since 2009. Finecure's defense argued that the prefix "PANTO" was not an exclusive trademark, emphasizing its common usage in the trade for products like pantoprazole. The court declined an interlocutory injunction but mandated Finecure to maintain separate accounts for earnings related to the "PANTOPACID" mark to ensure transparency. This case underscores that merely possessing a registered trademark does not automatically guarantee relief against infringement, highlighting the necessity of establishing a valid claim beyond ownership.

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COURT DENIES STAY IN TRADEMARK CASE, EMPHASIZING FORMALITY IN CHALLENGING VALIDITY.

In a recent decision, the Delhi High Court denied an application for a stay of proceedings under Section 124(1)(ii) of the Trademark Act. The suit was filed by the Plaintiff, Central Park Estates Pvt. Ltd seeking an ex parte ad-interim injunction to restrain the Defendant from using the mark CENTRAL PARK registered in 2005. Further, an application was filed by Defendant praying that the present suit be adjourned by three months in order to enable them to file a substantive proceeding challenging the marks asserted by the Plaintiff in the plaint. The Court emphasized that when challenging the validity of a trademark, all requirements specified in the provision must be met. It was argued that, even without prior pleading, the proceedings should be stayed because they raised the issue of trademark invalidity in Court. The court dismissed this argument, stating that invalidity is a complex matter involving both fact and law, and it must be formally pleaded. Simply arguing the invalidity of a registered trademark in court, without prior written pleading, is insufficient.

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DELHI HC GRANTS PERMANENT INJUNCTION RESTRAINING MASCOT HELATH SERIES FROM USING 'ROSUDAY' IN PHARMACEUTICAL TRADE DISPUTE

The Delhi High Court has issued an injunction in favour of USV Pvt. Ltd, prohibiting Mascot Health Series Pvt Ltd and Anr. from using the "ROSUDAY" mark for its rosuvastatin tablets which treats high cholesterol levels or any other pharmaceutical preparations. The Defendant in its reply had advanced only three contentions (i) no similarity between packs (ii) phonetically dissimilar and (iii) Plaintiff cannot claim monopoly since the trademark ROSEDAY was derived from the name of the compound constituting Active Pharmaceutical Ingredient namely rosuvastatin. The court held that when two marks are so phonetically similar, other ancillary features regarding the manner in which the marks are depicted on respective packs/strips, and the like, recede into insignificance. In view of the aforesaid the Hon'ble Court ordered a decree of permanent injunction restraining the defendants as well

as others from manufacturing, selling, advertising or in any manner using the mark ROSUDAY. Further it ordered that the Defendant shall be liable to pay damages of Rs. 2 lakhs by way of crossed cheques.

Source: 2023:DHC:557 USV PVT LTD. v. MASCOT HEALTH SERIES PVT. LTD. AND ANR. (01.08.2023)

DELHI HIGH COURT REJECTS A RECTIFICATION PETITION SEEKING REMOVAL OF THE RESPONDENT'S MARK "HARPIC DRAINXPRT" FROM THE TRADEMARK REGISTER.

The Delhi High Court rejected a rectification petition seeking removal of the respondent's mark "HARPIC DRAINXPRT" from the Register of Trade Marks. RSPL argued this similarity could confuse people and link the two brands. RSPL insisted that the Trademark Act rules were violated. However, the Court was of the opinion that the rival marks are not confusingly similar. The Court clarified that the manner of use of the rival marks is irrelevant in the rectification petition as during the registration of the mark, the Registrar does not call for the manner of actual use of the mark. Furthermore, the Court disagreed with RSPL's argument that "XPRT" was the dominant part and it ruled that ignoring a significant part of "DRAINXPRT" would be unreasonable. It also clarified that the principle of "essential and dominant part" falls under the purview of Section 17 in infringement actions and not Section 11. Emphasizing the importance of "HARPIC" and rejecting the claim of confusion, the Court ultimately, dismissed the petition and highlighted the need for a balanced approach to trademark protection and fair competition.

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DELHI HIGH COURT REVERSES DECISION ON DABUR-EMAMI PACKAGING DISPUTE, SETS ASIDE ORDER GRANTING RELIEF TO EMAMI

The Delhi High Court, under the leadership of Justice Yashwant Varma, has delivered a significant verdict by overturning a prior ruling issued by a single judge. The previous ruling had mandated Dabur Ltd to cease the sale of its Cool King Thanda Tel hair oil in response to a trademark infringement lawsuit brought by Emami India, related to their Navratna hair oil. Earlier this month, Justice C. Hari Shankar, in a single-judge bench, had granted interim relief to Emami. In his decision, he asserted that Dabur had consciously emulated critical aspects of Emami's Navratna hair oil, seemingly with the intent of capitalizing on Emami's reputation established since 1989. With the division bench's recent decision, Dabur is now permitted to continue marketing its Cool King Thanda Tel hair oil while the trademark infringement case unfolds. This legal battle has stimulated considerable discourse within the industry, raising questions about the realms of trademark protection and equitable competition in the market.

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DELHI HC RESTRAINS WOW MOMO FOODS FROM USING WOW! CHINA BISTRO TRADEMARK

The Delhi HC granted an injunction in favor of Foodlink F and B Holdings to restrain the Defendant's use of the mark "WOW! CHINA BISTRO" it being deceptively similar to the Plaintiff's registered "CHINA BISTRO" mark. The Defendant contended inter alia that the since the words "CHINA" (on account of being a country) and "BISTRO" (on account of being publici juris) are not individually registrable, the Plaintiff could not claim exclusivity over the composite mark "CHINA BISTRO". The Court dealt with the issue of disclaimers inserted while registering trademarks. The view taken by the Hon'ble Court in the instant case was that "the mere insertion of disclaimers with respect to the words "CHINA" and "BISTRO" in the registrations granted to the plaintiff for the composite marks CHINA BISTRO would not disentitle the plaintiff from claiming exclusivity for the composite mark" .observed that However, the court held that the mark did not lack in distinctiveness and enjoined the Defendant from using

the impugned mark as a trademark label, device, trading style, trade name, logo, keyword, meta tag, domain name, or in any other manner, identical or deceptively similar fashion. The Court decided the same in favour of the Plaintiff while observing that where a mark is registered, at a prima facie stage, the plaintiff is entitled to the benefit of Section 31(1)17 of the Trade Marks Act. The court would, therefore, presume, unless it is demonstrated to the contrary by the defendant, that the mark is valid.

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DELHI HC RESTRAINS HI TECH ARAI FROM USING "HTA" OR "ARS-HTA" MARKS IN AN INFRINGEMENT SUIT

The court has issued an injunction against Defendants' unregistered use of the "HTA" or "ARS-HTA" on packaging with concentric circles mark in respect of oil seals for vehicles. It was seen that the words mark along with the device mark was registered with the Plaintiff which later came to be infringed by Defendants. The Court held that the products of the plaintiff and defendant, were identical with "HTA" embossings. The Court further held that a customer, even if of above average intelligence and recollection unlike the unfortunate gentleman of average intelligence and imperfect recollection who generally inhabits these precincts would be unlikely to distinguish one from the other. Even if one were to assume that the defendant's products are not ordinarily available in the market, as they are "assembly line" inputs then, at the time of purchasing the Plaintiff's product, even as a replacement part, the customer is likely to wonder whether the part is actually of the Defendant, which would amount to "reverse confusion". The court reiterated that the only circumstance in which an unregistered user can escape an injunction is by proving the impugned mark pre-dates the use as well as the registration, which was not true in the instant matter. The court held that since a man of average intelligence would be unlikely to distinguish one mark from another, it was pertinent that injunction be granted.

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'DYNAMIC+ INJUNCTION' GRANTED BY THE DELHI HIGH COURT IN RESPECT OF ROGUE WEBSITES

Delhi HC granted an ex parte ad interim injunction against the Defendants, who are all rogue websites, from in any manner streaming, reproducing, distributing, making available to the public and/or communicating to the public any copyrighted content of the Plaintiffs including future works of the Plaintiffs, in which ownership of copyright is undisputed, through their websites identified in the suit or any mirror/redirect websites or alphanumeric variations thereof including those websites which are associated with the Defendants' websites either based on the name, branding, identity or even source of content. The Plaintiffs filed a suit against various websites which were permitting the viewing, streaming, accessing and downloading of such content without any license or authorisation from the Plaintiffs. The Court while deciding the instant case inter alia considered the view taken by the Bombay High Court in Applause Entertainment Pvt Ltd vs. Meta Platforms Inc., 2023 SCC OnLine Bom 1034. The Court while granting injunction stated that In a usual case for copyright infringement, the Court firstly identifies the work, determines the Copyright of the Plaintiff in the said work, and thereafter grants an injunction. However, owing to the nature of the illegalities that rogue websites indulge in, there is a need to pass injunctions which are also dynamic qua the Plaintiffs as well, as it is seen that upon any film or series being released, they may be immediately uploaded on the rogue websites, causing severe and instant monetary loss. To keep pace with the dynamic nature of the infringement that is undertaken by hydra-headed websites, the Delhi High Court has deemed it appropriate to issue a 'Dynamic+ injunction' to protect copyrighted works as soon as they are created, to ensure that no irreparable loss is caused to the authors and owners of copyrighted works, as there is an imminent possibility of works being uploaded on rogue websites or their newer versions immediately upon the films/shows/series etc. Further, it provides liberty to Plaintiffs to implead any mirror/redirect/alphanumeric variations of primary infringing websites as a party to the suit and such injunction shall become operational against the said websites and qua such works when the need so arises.

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AI-CREATED ART FACES COPYRIGHT HURDLES.

In the midst of a 100-day writers' strike, concerns have surged about studios turning to AI for scriptwriting. But a recent legal verdict stands firm: Intellectual property law remains clear—copyrights are reserved for human-made creations, and this isn't changing. A federal judge upheld the U.S. Copyright Office's decision that AI-created art lacks copyright protection. The case, involving Stephen Thaler, challenges AI-generated works' eligibility for registration. Copyright law hasn't stretched to shield works crafted solely by AI without human involvement.

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PLAGIARISM IN EDUCATION: AUTHOR FIGHTS BACK IN COURT.

An educationist, teacher and author of "Essentials of Artificial Intelligence" for classes VII to XII, Mr. Kartik Sharma has filed a lawsuit wherein he alleges that certain authors have copied portions of his book word-to-word. Justice Pratibha M. Singh has summoned the accused authors for the next hearing. The Court has also issued an order allowing Mr. Kartik Sharma to approach e-commerce platforms if they discover any copies of his book being sold illegally. This enables him to request the removal of infringing content from these platforms.

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PATENT PULSE

FEDERAL CIRCUIT'S VERDICT AND JUDGE'S DISSENT IN AN APPEAL FILED BY INCEPT AGAINST THE DECISION OF THE PATENT TRIAL AND APPEAL BOARD.

This case revolves around two patents related to improved methods of treating cancer owned by Incept LLC. Palette Life Sciences had filed a petition asserting that the claims made by Incept are unpatentable as anticipated by, or obvious in view of, the prior art, including the "Wallace" patent. Incept appealed after the Patent Trial and Appeal Board found the claims unpatentable based on the prior art, particularly the "Wallace" patent. The Federal Circuit upheld the Board's decision. Regarding anticipation, Firstly, they claimed the Board's analysis relied too heavily on anticipation, but the Federal Circuit found the Board's motivation-to-combine findings well-founded. Second, Incept argued that Wallace taught away from biodegradable compositions, but the Federal Circuit disagreed, citing Wallace's mention of potential biodegradable segments. Third, Incept's complaint about the Board not separately analyzing dependent claims was dismissed as Palette had identified relevant prior art, and Incept hadn't argued their patentability separately. Finally, Incept claimed the Board set a high standard for showing commercial success as evidence of no obviousness, but the Federal Circuit saw no reversible error. Judge Newman dissented, disagreeing with the majority on anticipation and the handling of commercial success evidence. She wanted a remand to address anticipation of dependent claims and to consider the evidence of commercial success in the obviousness determination.

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CHARTING THE COURSE OF IP EVOLUTION: CGPDTM INVITES STAKEHOLDER INPUT FOR MANUAL AND GUIDELINE REVAMP.

The Office of the Controller General of Patents, Design, and Trademarks (CGPDTM) has just released a public notice that's bound to pique the interest of stakeholders. The CGPDTM is inviting comments from all stakeholders to revamp the Patents, Designs, Trademarks, GI, and Copyright Manuals and Guidelines. These manuals and guidelines play a crucial role in simplifying the implementation of statutory provisions and rules by officers, providing valuable insights into the office's operations. Notably, the need to revise the Patent Manual was recently emphasized by the Delhi High Court in *AGFA v. Asst. Controller of Patents*. The Court underlined the necessity of updating this manual, highlighting its significance in the intellectual property landscape. While the Patent Manual received a facelift in 2019, the other manuals haven't seen much attention. The Trademark Manual, for instance, was last updated as a "draft" in 2015, leaving stakeholders wondering about a final version. Similarly, Copyright Manuals from 2018 remain untouched, and the Design Manual, introduced before 2012, lacks a revision date. The GI Manual hasn't seen updates since 2011. This public notice follows closely on the heels of the draft Patent (Amendment) Rules, 2023 released by the DPIIT. These rules will bring changes to patent prosecution timelines. Earlier this year, the Commerce Minister announced plans to amend the Patent Act. These efforts seem to signal a step toward involving the public in shaping the future of intellectual property regulations.

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DESIGNS UNVEILED

DELHI HIGH COURT REJECTS DEPENDENCE ON ARTIFICIAL INTELLIGENCE IN RED SOLE SHOES CASE.

In a recent ruling, the Delhi High Court emphasized the irreplaceable role of human intelligence and compassion in the legal process. The Court rejected ChatGPT responses in a case involving Christian Louboutin's iconic "red sole" shoes. Christian Louboutin filed a suit asserting their registered trademark for "Red Sole Shoe" in India. They presented ChatGPT responses to support their reputation claims. The defendant had copied essential features of Louboutin's footwear, leading to a settlement. The defendant agreed not to replicate designs, with penalties for breaches. The Court imposed costs on the defendant for misrepresentation, unauthorized use of celebrity images, and selling the shoes in high-end malls. The Court held that "The above responses from ChatGPT as also the one relied upon by the Plaintiffs shows that the said tool cannot be the basis of adjudication of legal or factual issues in a court of law. The response of a Large Language Model (LLM) based chatbots such as ChatGPT, which is sought to be relied upon by Id. Counsel for the Plaintiff, depends upon a host of factors including the nature and structure of query put by the user, the training data etc. Further, there are possibilities of incorrect responses, fictional case laws, imaginative data etc. generated by AI chatbots. Accuracy and reliability of AI generated data is still in the grey area. There is no doubt in the mind of the Court that, at the present stage of technological development, AI cannot substitute either the human intelligence or the humane element in the adjudicatory process. At best the tool could be utilised for a preliminary understanding or for preliminary research and nothing more".

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FIRM HIGHLIGHTS



BOMBAY HIGH COURT REFUSES TO STAY RELEASE OF HINDI FILM DREAM GIRL 2

The Bombay High Court on August 22 refused to stay the release of the Hindi film Dream Girl 2 in a copyright infringement suit filed against the movie by an individual. Advocates Rahul Dhote, Anushree Rauta, Shwetank Tripathi, Vidit Desai, Umang Sheth and Radhika Mehta briefed by ANM Global appeared for Balaji Telefilms.

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EX-PARTE AD-INTERIM INJUNCTION ORDERS FOR INFRINGEMENT

Our Client Pralshar Bio Products Pvt. Ltd is an agro based company engaged in research and development of various chemicals and bio extracts for increasing crop yield, as well as agricultural bio extracts and chemicals that (a) stimulate seed germination, (b) fasten growth of cotyledon leaves, induce growth of roots, (c) further break up seed dormancy, (d) increase seed germination percentage, (e) influence vigorous & hardy growth as well as abundant flowering & fruiting in case of fruits & vegetables.

We have recently obtained ex-parte ad-interim injunction orders for infringement of our Client's registered trademark and copyright in Courts of Goa against 5 (five) infringers.



ANM Global strongly supports Indian Institute of Technology, Bombay through Eureka as their legal partner! We are excited to be playing a part in this transformative journey for startups, supporting their legal needs along the way!

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SHWETANK TRIPATHI JOINS ANM GLOBAL AS ASSOCIATE PARTNER IN IP PRACTICE

Khaitan & Co's Senior Associate Shwetank Tripathi has left the firm to join ANM Global as an Associate Partner in the firm's Intellectual Property Rights (IPR) practice. Tripathi is a 2012 graduate of the Dr. RML National Law University, Lucknow.

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