



INTELLECTUAL PROPERTY NEWSLETTER

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INTRODUCTION

We are excited to bring you the latest edition of our newsletter, featuring key updates from the ever-evolving field of Intellectual Property (IP). This quarter has seen significant developments in judicial decisions, patent grants, and policy changes, all of which are shaping the future of IP protection. Courts across the country have continued to uphold the rights of brand owners, as evidenced by prominent cases such as the dispute around Indian Hotels Company Limited's trade mark 'Taj' and the trade mark 'Boroline' being declared as a well-known. Another notable highlight is Louis Vuitton being awarded costs amounting to INR 5,00,000 for copyright infringement, accenting the intellectual property rights in advertisement material available on the internet.

One particularly impactful decision from the Delhi High Court involved a longstanding trade mark dispute

between Lacoste and Crocodile International over the use of the crocodile logo. Further, in response to the growing impact of Artificial Intelligence across various sectors, the Bombay High Court took steps to protect the personality rights of renowned singer Arijit Singh against unauthorized use by AI platforms. Other key updates include the patent granted for Aadhaar Data Management Technology and the Goa High Court's decision to quash a state government circular that exempted hotels from obtaining copyright licenses.

We invite you to dive into this edition and explore these important updates. Thank you for your continued readership, and we hope you find this newsletter, both, insightful and enjoyable.



SNIPPETS

A PENDING APPLICATION FOR COMPULSORY LICENSE DOES NOT PROVIDE RIGHT TO CONTINUE INFRINGEMENT OF THE OWNER'S COPYRIGHT

In the case of *Phonographic Performance Ltd. v. Al-Hamd Tradenation*¹, the Delhi High Court ("**Delhi HC**") clarified that where a party has sought for a compulsory license and such application was pending, the alleged infringement (*identified before filing of the application of compulsory license*) cannot continue. Phonographic Performance Ltd. ("**PPL**") instituted a suit against ALHTN for using copyrighted content without payment of a license fee. Al-Hamd Tradenation ("**ALHTN**") argued that an application for compulsory license was filed due to the excessive licensing fees being charged by PPL, to which PPL claimed that there is no power under the law to challenge licensing fee.² Pursuant to arguments from both sides, the Delhi HC granted an interim injunction in favor of PPL and against ALHTN. ALHTN was restrained from using the copyrighted content since the compulsory license was not yet obtained and the requisite license fee due to PPL was not paid.

NON-COMPLIANCE WITH THE TRADE MARKS ACT WAS DEEMED AN IRREGULARITY NOT A GROUND FOR DISMISSAL

In a recent case before the Hon'ble Karnataka High Court ("**Karnataka HC**"), Manjunatha MS ("**MS**") filed a petition concerning a trade mark dispute.³ The main issue revolved around the alleged non-compliance with certain procedural requirements stipulated under the Trade Marks Act, 1999 ("**Trade Marks Act**"). MS contended that the complaint against him was deliberately filed under the wrong legal provisions, namely Section 63 of the Copyright Act, 1957, rather than the appropriate sections of the Trade Marks Act. He asserted that this misfiling enabled the police to circumvent the requirement of obtaining the opinion of the Registrar of Trade Marks before carrying out search and seizure operations. MS claimed that this constituted an abuse of the legal system by both the complainant, K R Nagendra, and the investigating officers. MS sought the dismissal of the proceedings, citing procedural irregularities and alleged malicious intent. The present petition was filed alleging that the said procedural requirement was not complied with and must be a valid ground for quashing the proceedings. The Karnataka HC held that non-compliance with Section 115(4) of the Trade Marks Act constituted an irregularity rather than

a ground for quashing infringement proceedings and dismissed the petition. In other words, the Karnataka HC classified these non-compliances as irregularities.

GROUND-BREAKING AADHAR DATA MANAGEMENT TECHNOLOGY RECEIVES PATENT PROTECTION

In a noteworthy development, the Indian government has granted a patent to Bengaluru-based company, SISA, for a pioneering system, Aadhar Data Discovery Engine, designed to manage Aadhaar data. The patented system introduces a novel approach to handling Aadhaar data, incorporating advanced encryption and secure data storage methodologies. The technology met the key requirements of a patent, which are, inventive step, novelty, and industrial applicability. According to Dharshan Shanthamurthy, CEO, the technology aims to help organizations in tourism, finance, banking, and alike to comply with the Unique Identification Authority of India protocols, while ensuring user data privacy, enhanced security protocols, and data confidentiality. The technology also masks any sensitive information of Aadhar holders. The ground-breaking technology furthers the Government's strategy to enhance the security of personal information of Aadhar card holders in India.⁴

ASIA NEWS INTERNATIONAL FILES COPYRIGHT INFRINGEMENT SUIT AGAINST PRESS TRUST OF INDIA FOR ALLEGED PLAGIARISM

Asia News International ("**ANI**") filed a copyright infringement suit against Press Trust of India ("**PTI**") before the Delhi HC.⁵ ANI alleged that PTI had copied its videos relating to the air-conditioning malfunctioning controversy from the Delhi-Darbhanga SpiceJet flight scheduled for June 19, 2024, amounting to copyright infringement, plagiarism, passing off, unjust enrichments, among others. ANI claimed that the alleged videos were posted by them on their X account and were subsequently, unauthorisedly used by PTI. A claim of INR 2 (two) Crore in damages has been allegedly claimed by ANI. Counsel appearing on behalf of PTI submitted

1. 2024 SCC OnLine Del 4938.

2. The Copyright Act, No. 14 of 1957, § 31, India Code (1957).

3. Manjunatha M.S. v. State, 2024 SCC OnLine Kar 73.

4. Govt Grants Patent to Bengaluru Firm for First-of-its-kind System to Manage Aadhaar Data, The Print (22 Sept 2024), <https://theprint.in/tech/govt-grants-patent-to-bengaluru-firm-for-first-of-its-kind-system-to-manage-aadhaar-data/2165732/>.

5. CS(COMM) 543 of 2024.

before the Delhi HC, on the very first hearing in the matter, that PTI was willing to take down the impugned videos, without prejudice to PTI's rights and contentions. While the Delhi HC was inclined to refer the matter for mediation, ANI refused the same and instead, suggested the parties may talk amongst themselves.

DELHI HIGH COURT ORDERS FOR A FRAMEWORK TO REGULATE THE CONDUCT OF PATENT AND TRADE MARK AGENTS⁶

The Delhi HC has directed the Controller General of Patents, Designs, and Trade Marks to formulate a Code of Conduct for Patent and Trade Mark agents, in the backdrop of a petition filed against abandonment of a patent application. The Impugned Application was declared as abandoned for non-filing of response to First Examination Report issued by the Patent Office. The Delhi HC observed that there was enough evidence to prove that the petitioner was vigilant to follow up on the status of the application from the patent agent who had filed the application ("**Patent Agent**") however, the Patent Agent showed no diligence in communicating issuance of such First Examination Report to the Petitioner despite repeated follow-ups. The Delhi HC observed that the instant petition fell within the ambit of 'extraordinary circumstances' and therefore, set aside the abandonment order in question. Additionally, Delhi HC observed the negligence and misconduct of the Patent Agent and directed an inquiry against him. The Delhi HC also directed the said Code of Conduct to be notified by December 31, 2024.

BOMBAY HIGH COURT PROTECTS PERSONALITY RIGHTS OF FAMOUS SINGER ARIJIT SINGH AGAINST AI PLATFORMS

The Bombay High Court ("**Bombay HC**") issued an ex-parte injunction order in favor of the famous Indian singer, Arijit Singh ("**Singh**"), restraining certain Artificial Intelligence ("**AI**") platforms from using his image, voice, photo, manner of singing and any other attributable feature.⁷ Singh impleaded eight AI platforms and/or their owners / founders / managers / promoters / promoters as defendants in the suit proceeding. Singh alleged that the defendants have used AI tools to create content mimicking Singh's attributes, enable users to convert text and speech Singh's AI voice version mimic Singh's voice, vocal techniques and the like. Pursuant to arguments made by Singh, it was held that freedom of

speech and expression does not include exploitation of a celebrity's rights for commercial gain. The Bombay HC noted that such unauthorized use not only disables the person from having control over his own personality and its exploitation, but also facilitates manipulation in the market. Acknowledging celebrities being more susceptible to personality rights infringement, the Bombay HC granted an ad-interim injunction order against the defendants and directed the infringing content to be taken down.

BOROLINE DECLARED AS A WELL-KNOWN TRADE MARK IN INDIA

While granting a permanent injunction order in favour of GD Pharmaceuticals Pvt. Ltd. ("**GD Pharma**") in a trade mark dispute, the Delhi HC declared GD Pharma's trade mark 'Boroline' as a well-known trade mark under the Trade Marks Act.⁸ The suit was filed by GD Pharma in 2018 against Cento Products (India) ("**Cento**") who were using the mark 'Borobeautey' with a deceptively similar trade dress. The suit was decreed upon Cento proposing to adopt a new trade dress, giving up the iconic green colour trade dress altogether, and change the name of their product to a different name which did not have the prefix 'BORO'. Further, while considering GD Pharma's prayer for declaration of the trade mark 'Boroline' as a well-known trade mark, the Delhi HC observed that the mark, which has been in use since around 1929, met the qualifications laid down under the Trade Marks Act for such declaration and hence, shall be added to the list of well-known trade marks, upon GD Pharma completing the requisite formalities.

DELHI HIGH COURT PROTECTS IHCL'S "TAJ" TRADE MARK

On August 30, 2024, the Delhi HC ruled in favour of Indian Hotels Company Ltd. ("**IHC**") in a trade mark infringement case filed by it against an individual, Manoj ("**Manoj**").⁹ It was the case of IHC that Manoj has been making unauthorised use of its registered trade marks,

'TAJ', ', and '' ("**IHC's Marks**").

6. 2024 SCC OnLine Del 4585.

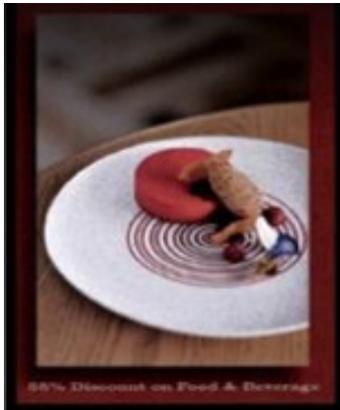
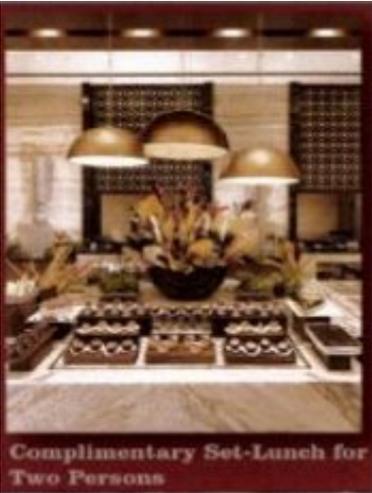
7. Arijit Singh v. Codible Ventures LLP, 2024 SCC OnLine Bom 2445.

8. G.D. Pharmaceuticals Pvt. Ltd. v. Cento Products (India), 2024 SCC OnLine Del 5678.

9. Indian Hotels Co. Ltd. v. Manoj, 2024 SCC OnLine Del 6177.

Further, IHC also contended unauthorised use of its copyrighted content and photographs available on

its official website under the trade name, 'Taj Iconic Membership' on its brochures, signages, website etc.

IHC's Copyrighted Material	Manoj's infringing content
  <p>25% Discount on Food & Beverage On dine-in & take-away at participating restaurants across hotels for upto 30 periods.</p>   <p>Complimentary Set-Lunch for Two Persons For one time, at participating All-Day Dining restaurants across hotels.</p>	  <p>50% Discount on Food & Beverage</p>  <p>Complimentary One Night Stay</p>  <p>Complimentary Set-Lunch for Two Persons</p>
<p>Source: Judgement dated 30 August 2024</p>	

In response to the aforementioned contentions, there was no written statement filed by Manoj nor was any appearance entered on its behalf to defend his actions. Resultantly, the Delhi HC noted that Manoj was not only guilty of infringement of IHC's marks and photographs but also guilty of indulging in criminal activities of impersonation, which resulted in defrauding a jeweller. The Delhi HC found that Manoj's use of IHC's Marks is likely to mislead the consumers and draw association of Manoj's business with that of IHC. Resultantly, it awarded INR 10 (ten) lakh in damages and INR 5 (five) lakh in costs to IHC and issued a permanent injunction to prevent further unauthorised usage of IHC's Marks.

INDIAN GOVERNMENT CONSIDERS STRICTER PENALTIES FOR MISUSE OF NATIONAL EMBLEMS

The Union Government is contemplating certain amendments to the Names and Emblem (*Prevention of Improper Use*) Act, 1950 ("**Names and Emblem Act**"), to increase fines and introduce imprisonment for violators.¹⁰ The Names and Emblem Act prohibits use of Names and Emblems (*as defined under the Act*) for trade, business or profession or in the title of any patent or in any trade mark, design or any name or emblem specified in the schedule of the Names and Emblem Act.

Under the existing legal framework, the penal liability for any violation for improper use of certain emblems and names is merely INR 500 (five hundred) per penalty.¹¹ As per the publicly available sources, the Consumer Affairs Ministry has proposed raising the fine to INR 1 (one) Lakh for first – time offenders. Subsequently, for repeated misuse, the violators could face penalties of up to INR 5 (five) Lakh and a six – month jail term.

DPIIT WITHDRAWS MEMORANDUM THAT EXTENDED SCOPE OF STATUTORY LICENSING TO INTERNET TRANSMISSIONS

On August 21, 2024, the Department for Promotion of Industry and Internal Trade ("**DPIIT**") officially revoked its office memorandum dated September 05, 2016 ("**Memorandum**").¹² As per the Memorandum, the applicability of Section 31D of the Copyright Act, 1957 ("**Copyright Act**") was expanded to include 'internet transmission' for statutory licensing of broadcasting literary and musical works and sound recordings.

The above move comes pursuant to the decision passed by the Hon'ble Bombay HC in the case of *Tips Industries Ltd. v. Wynk Music Ltd.*¹³ where Tips and Wynk agreed on a license allowing Wynk Music to exploit Tips repertoire until October 2016 and in the absence of a written agreement later, Tips insisted Wynk to discontinue using the same and pay for usage during extension period. After prolonged negotiations on the minimum guaranteed amount, the parties could not come to a consensus resulting in Tips demanding royalty of INR 2.83 (two point eighty-three) crores against the exploitation of copyright. Aggrieved with the same, Wynk invoked Section 31D of the Copyright Act to assert its rights as a 'broadcaster'.

In 2023, a division bench of the Bombay HC ruled that Section 31D of the Copyright Act is restricted to traditional non-internet-based radio and television broadcasting and performances only and cannot be applied to any internet-based offering and on-demand streaming services. The case concluded with a final settlement order on 18 June 2024, requiring Wynk to pay Tips Industries a full and final settlement of INR 12 (twelve) crore.

INDIAN FILM-MAKER SOHAM SHAH FILED A SUIT AGAINST NETFLIX AND THE SQUID GAME DIRECTOR

On 13 September 2024, an Indian Filmmaker, Mr. Soham Shah ("**Shah**") filed a suit against Netflix ("**Defendant 1**") and Squid Game Director, Hwang Dong-hyuk ("**Defendant 2**") (together, "**Defendants**") before the United States District Court for the Southern District of New York.¹⁴

10. Press Trust of India, Govt Mulls Stricter Penalties for Misuse of National Emblems, Names, PTI News (24 Sept. 2024), accessible at <https://www.ptinews.com/story/business/govt-mulls-stricter-penalties-for-misuse-of-national-emblems-names/1770319>.

11. The Copyright Act, No. 14 of 1957, § 3, India Code (1957)

12. Office Memorandum, No. 14-35/2015-CRB/LU (IPR-VII), 5 Sept. 2016, Copyright Office, Govt. of India, https://copyright.gov.in/Documents/Office_Memorandum/Office_Memorandum_dated_21_08_2024.pdf.

13. *Tips Industries Ltd. v. Wynk Music Ltd.*, 2019 SCC OnLine Bom 13087; *WYNK Ltd. v. TIPS Industries Ltd.*, 2022 SCC OnLine Bom 11807.

14. Soham Shah v. Netflix, Inc., Netflix Worldwide Entertainment, LLC, and Hwang Donghyuk, Case 1:24-cv-06925-RA; complaint accessible at <https://business.cch.com/ipld/ShahNetflixComp20240913.pdf>.

As per the complaint filed, Shah claimed that the show, *Squid Games*, is loosely based and resembles one of his 2009 released Indian movie, "Luck". The show in question involves a group of people who partake in life-threatening activities for financial awards, which increase as people die during the games. Shah claims that this plot is identical to the 2009 movie in terms of its screenplay, characters, plot, themes, expression of characters. Shah further mentioned that upon the release of the show, the viewers of his film rushed to the Internet to note the many similarities between the two works.

While the case is still sub judice, Defendants have categorically rejected all such claims of plagiarism by Shah and has asserted that the *Squid Games* is Defendant 2's own creation. The main point of contention for Shah is that Defendant 2 conceptualized the idea at around the same time that Shah began working on the script of the movie "Luck" in the year 2006. Shah has sought for permanent injunction on the release of the upcoming season of the show and damages.

HC QUASHES GOA GOVT'S CIRCULAR EXEMPTING HOTELS FROM TAKING COPYRIGHT LICENSE

In the case of *Phonographic Performance Ltd. v. State of Goa and Ors.*, the Goa bench of the Bombay HC addressed a petition filed under Article 226 of the Constitution¹⁵. *Phonographic Performance Ltd.* ("PPL") sought the quashing of a circular dated January 30, 2024 ("Circular"), issued by the State of Goa, which stated that performances of musical works at religious ceremonies, including weddings, do not violate the Copyright Act.

The Bombay HC held that the Circular extended the scope of Section 52(1)(za) of the Copyright Act, which allows certain acts during bona fide religious ceremonies to not be considered copyright infringement. The Court determined that the Circular, by interpreting this provision, overstepped the authority of State of Goa, as interpretation of the law is the domain of the courts.

The Bombay HC concluded that the Circular interfered with the enforcement mechanism for copyright societies, thus rendering it illegal. As a result, the Circular was quashed and set aside for being beyond its lawful scope.

CCI – NO EVIDENCE OF P&G USING THE INFORMANT'S PATENTED GREEN TECHNOLOGY IN WHISPER ULTRA CLEAN

In *Rajiv Rai Sachdev v. Procter & Gamble Hygiene and Health Care Limited and The Procter & Gamble Company, USA*, the Competition Commission of India ("CCI") examined allegations of abuse of dominant position under Section 4(2)(c) of the Competition Act, 2002 ("the Competition Act") against Procter & Gamble Hygiene and Health Care Limited and The Procter & Gamble Company, USA ("P&G").¹⁶ Rajiv Rai Sachdev ("Informant"), who holds patents on a green technology for dyeing textiles, claimed that P&G's misused his technology without consent. He had submitted his innovation to P&G's "PG Connect + Develop" program, but P&G declined collaboration.

In 2021, P&G launched "Whisper Ultra Clean" sanitary pads with herbal oil, which the Informant alleged used his patented ideas. The Informant claimed this amounted to abuse of dominance, resulting in a denial of market access.

The CCI, while analysing the matter, defined the relevant market as the "market for disposable sanitary pads in India." However, it found that P&G did not hold a dominant position in this market, as other competitors, such as Johnson & Johnson, held significant shares. Furthermore, no evidence supported claims that P&G had used the Informant's technology or restricted his market access.

Consequently, the CCI dismissed the allegations and closed the case under Section 26(2) of the Competition Act.

DELHI HC ORDERS CANCELLATION OF 'ANDAAZ-E-NIZAAM' TRADE MARK FOLLOWING LEGAL CHALLENGE BY RESTAURANT CHAIN

In the case of *Rajesh Chugh v. Mehruddin Ansari & Anr.*, the Delhi HC addressed a suit seeking removal/rectification of the trade mark 'ANDAAZ-E-NIZAAM', registered under the name of Mehruddin Ansari ("Respondent No. 1") for being deceptively similar to the trade

15. *Phonographic Performance Ltd. v. State of Goa*, 2024 SCC OnLine Bom 2713.

16. *Rajiv Rai Sachdev v. Procter & Gamble Hygiene and Health Care Limited and The Procter & Gamble Company, USA*, CCI Case No. 39 of 2023

17. *Rajesh Chugh v. Mehruddin Ansari & Anr.*, 2024 SCC OnLine Del 5354.

mark 'NIZAM'S' owned by Rajesh Chugh ("Chugh").¹⁷ Chugh, a provider of food and drink services, has been using the trade mark 'NIZAM'S' since 1978, claiming exclusive rights and registration in multiple classes. The Respondent No. 1 registered 'ANDAAZ-E-NIZAAM' in Class 43, prompting Chugh to file for rectification under Section 57 of the Trade Marks Act.

Chugh discovered the Respondent No. 1's registration in January 2024 and argued that 'ANDAAZ-E-NIZAAM' is deceptively and phonetically similar to 'NIZAM'S'. The Respondent No. 1 proposed operating under alternative names 'DAAWAT-E-NIZAMUDDIN' or 'ANDAAZ-E-NIZAMUDDIN', to which Chugh consented.

The Delhi HC accepted the Respondent No.1's undertaking to change its trade name. Consequently, the Delhi HC directed the Respondent No. 1 to take appropriate steps to change their business name. Under Section 47 of the Trade Marks Act, the Delhi HC ordered the Registrar of Trade Marks to remove/cancel the registered mark 'ANDAAZ-E-NIZAAM' and rectify the Trade Marks Register. The Delhi HC accordingly disposed off the petition.

CHAHAT FATEH ALI KHAN FACES LAWSUIT FOR 'DEFAMING' NUSRAT FATEH ALI KHAN

A legal notice was served to Chahat Fateh Ali Khan ("Chahat"), a UK resident, accusing him of defaming the legacy of the late Pakistani qawwali singer, Nusrat Fateh Ali Khan ("Nusrat"), offending the people of Faisalabad, Pakistan, and violating the Copyright laws.¹⁸ The notice claimed that Chahat falsely represented himself as a relative of Nusrat and damaged the musician's legacy through a controversial singing style that provoked anger among fans and residents of Faisalabad, Nusrat's hometown.

The notice demanded that Chahat issue a public apology on social media within 15 (fifteen) days. It outlined key accusations: first, defamation, alleging that Chahat's controversial performances tarnished the reputation of Nusrat; second, offending the residents of Faisalabad, who were deeply disturbed by Chahat's singing style; and third, copyright infringement, claiming that Chahat violated the Copyright laws by using Nusrat's name and musical style without proper authorization.

Furthermore, the notice sought INR 180 (one hundred and eighty) million in damages as compensation for the harm caused to Nusrat's legacy. It warned that if Chahat did not comply within the given timeframe, the matter would be escalated to a court of law.

18. Chahat Fateh Ali Khan Served Legal Notice for 'Defaming' Nusrat Fateh Ali Khan, Express Tribune (1 July 2024), <https://tribune.com.pk/nusrat-fateh-ali-khan>.



LONG FORM

DELHI HIGH COURT IN A LANDMARK DECISION ENDS A TWO-DECADE LEGAL TRADE MARK SHOWDOWN BETWEEN LACOSTE AND CROCODILE INTERNATIONAL

In a landmark decision, the Delhi HC on 14 August 2024, passed a permanent injunction against Lacoste ("Lacoste"), a well-known French company recognized for its crocodile logo.¹⁹ Lacoste filed a lawsuit against Crocodile International Pte. Ltd. ("Crocodile International"), a Singapore-based company, alleging trade mark infringement and passing off. Lacoste claimed that Crocodile International's use of a similar crocodile logo on their products was likely to cause confusion among consumers and dilute Lacoste's brand identity. Lacoste argued that their crocodile logo was a well-established and distinctive trade mark globally, including in India. They contended that Crocodile International's use of a similar logo constituted trade mark infringement and passing off, as it could mislead consumers into believing that there was an association between the two brands. Crocodile International countered that their logo was distinct and had been in use for a significant period. They argued that there was no likelihood of confusion among consumers and that their logo did not infringe upon Lacoste's trade mark rights. Crocodile International also relied upon a mutually agreed agreement between the Parties signed in 1983 ("Agreement"), which allowed mutual co-existence of the logos in the markets of various jurisdictions. Lacoste claimed that this did not extend to India.

The Delhi HC examined the visual similarities between the two logos and the overall impression they created.



The Delhi HC also considered the reputation and recognition of Lacoste's trade mark in the market. The key factors analyzed included:

- The distinctiveness of Lacoste's crocodile logo.
- The likelihood of consumer confusion due to the similarity of the logos.
- The intent behind Crocodile International's use of a similar logo.

The Delhi HC ruled in favor of Lacoste, finding that Crocodile International's logo was deceptively similar to Lacoste's well-known crocodile logo. Delhi HC held that the use of a similar logo by Crocodile International was likely to cause confusion among consumers and amounted to trade mark infringement and passing off. Consequently, the Delhi HC granted an injunction restraining Crocodile International from using the disputed logo on their products.

THE COURT PROTECTS SAREGAMA'S COPYRIGHT OVER NAYA DAUR SONG - UDI JAB JAB ZULFEIN

*In the case of Saregama India Ltd. v. Emami Ltd.*²⁰, Saregama India Ltd. ("Saregama") filed an application against Emami Ltd.²¹ ("Emami") for an interim injunction. The Delhi HC directed Emami to deposit INR 10 (ten) Lakhs with the Registry of the Delhi HC within two weeks. This was deemed an interim arrangement, with the Delhi HC to consider upon further hearing whether the amount to be deposited should be varied.

The suit was initiated to restrain Emami from using the musical and literary works of the song 'Udi Jab Jab Zulfein' for advertising its product, Emami Kesh King Anti Hairfall

19. Lacoste v. Crocodile International Pte. Ltd., 2024 SCC OnLine Del 5591.

20. CS(COMM) 535/2024.

21. CS(COMM) 535/2024.

Shampoo, without a license from Saregama. Saregama claimed it was the assignee of all rights, including musical, literary, and sound recording rights, in the song from the film 'Naya Daur'. These rights were assigned to Saregama by BR Films, the original producer of 'Naya Daur', through an agreement dated October 17, 1955. BR Films confirmed these rights in a letter dated May 31, 2007, and the Indian Performing Right Society Limited also confirmed Saregama's ownership in a certificate dated November 09, 2023. Emami approached Saregama for a license for the song's lyrics and musical composition and requested ownership documents, to which Saregama provided a response with the details of the license fee. Since the ownership details were confidential and not disclosed by Saregama, Emami sent a letter challenging Saregama's rights and seeking to locate the legitimate copyright owner. Saregama relied on Sections 22, 27, 51, and 55 of the Copyright Act, to claim its rights and argued that under Section 14(a) of the Copyright Act, it had an exclusive right to reproduce or make any sound recording of its works. Saregama contended that Emami's actions amounted to infringement and that it approached the Delhi HC immediately upon discovering the advertisement in June 2024. Emami countered that the agreement dated October 17, 1955, only assigned sound recording rights to Emami, which had expired.

The Delhi HC analysed the matter and issued a notice to Emami, directing them to file a reply within four weeks and a rejoinder within two weeks thereafter, and directed Saregama to submit documents and an affidavit regarding the amounts charged for similar licenses. The rejoinder was filed by the Saregama and Emami has been given the opportunity to file the response. The matter is pending. The matter is scheduled to be listed before the Joint Registrar (Judicial) on October 21, 2024, and before the Delhi HC on January 14, 2025.

THE DELHI HIGH COURT DIVISION BENCH DIRECTS THE SINGLE JUDGE BENCH TO REVISIT THE TRADE MARK BATTLE OF PHARMA'S IN THE MANKIND PHARMA V. MERCYKIND PHARMA CASE

The Division Bench of the Delhi HC has directed a revisit of the order dated 06 July 2018 by a Single Judge Bench of the Delhi HC in the matter of *Mankind Pharma v. Mercy Kind Pharma*²², where in the Single Judge Bench refused to grant a temporary injunction against Mr. Chandra Mani Tiwari ("**Chandra**").

The case is found in the backdrop of the incorporation of the company "Mercykind Pharmaceuticals Private Limited" by Chandra who was initially working as a Marketing Manager with Mankind Pharma Limited ("**Mankind**"). After Chandra's departure from Mankind, the aforementioned company was incorporated January 17, 2015. He then applied for the registration of "Mercykind Pharmaceuticals" and began using the same on the products. This led to the institution of the said suit. It has been contested by Mankind that the name is deceptively similar to Mankind Pharmaceuticals, which had 157 (one hundred and fifty-seven) trade marks using "Kind" registered to it.

Mankind also put on record that its revenue is almost INR 4,000 (four thousand) crores and the company's turnover was INR 7,000 (seven thousand) crores and continued use of the name by Chandra might tarnish the brand's value in the market. Trade Mark Law is a three-pronged sword. It aims to protect the registered trade mark holder from commercial exploitation, protect the consumers from deceptive brands in the market, and protect the goodwill of the brand in the market. While denying the temporary injunction to Mankind, the learned Judge held that applying the suffix to the name of the manufacturers would not constitute infringement under Section 29 (6) of the Trade Marks Act holding that the products were not being named using the disputed trade mark.

Taking a look at some cases adjudged by the Delhi HC in similar matters, we see *Bayerische Motoren Werke AG v. Om Balajee Automobile (India) Private Limited*²³, where the Delhi HC held that if a trade mark had a degree of visual and phonetic resemblance i.e., essential features of a trade mark, such a usage would be dishonest adoption. The Delhi HC passed an ad-interim injunction to BMW in the aforementioned case and restrained Om Balajee Automobile from conducting business under the infringed trade mark.

The Delhi HC urged the Single Judge Bench to revisit the matter under the purview of "dishonest adoption" by a former employee keeping in mind the similarity of the two names and the possibility of confusion they may cause in the minds of the consumers of the product.

22. 2024 SCC OnLine Del 5491.

23. 2020 SCC OnLine Delhi 484.

DELHI HIGH COURT AWARDS INR 5 LAKHS TO LOUIS VUITTON IN A COPYRIGHT INFRINGEMENT LAWSUIT

Delhi HC ordered an online e-commerce platform, Haute 24 ("**Haute**"), to pay INR 5 (five) lakhs in costs to the famous luxury brand Louis Vuitton ("**LV**") in a copyright infringement suit²⁴. LV had filed the lawsuit alleging unauthorized use of the copyrighted photographs, images and promotional material by Haute. It was also contended by LV that this copyrighted material was used by Haute on its website with respect to goods which it did not consider as genuine. LV alleged that the copyright material unauthorisedly used by Haute was commissioned work, for which LV owned the copyright. The Delhi HC's decision in this matter underscored the importance of protecting intellectual property rights and served as a warning to entities engaging in the sale of counterfeit goods.

Haute operated an online e-commerce platform where it contended to sell new (and genuine) as well as "pre-owned" goods of LV. Noting that genuineness of the products was not an issue raised before the Delhi HC, the Delhi HC concerned itself with only the use of the copyrighted promotional material.

Relying on the judgment passed by the Delhi HC in *Bright Lifecare Pvt. Ltd. v. Vini Cosmetics Pvt. Ltd. & Anr.*²⁵, the Delhi HC acknowledged that advertisements can be protected under copyright law, given that they are distinct enough for the public to associate it with the advertiser alone. Copyright in such original, artistic works was recognised by the Delhi HC.

After hearing both parties, the Delhi HC ruled in favour of LV, noting that Haute's actions amounted to clear infringement of LV's intellectual property rights. Haute has been enjoined from using the copyrighted promotional material of LV, in any form whatsoever. In addition to this injunction, the Delhi HC also directed Haute to prominently display on their website that LV's goods sold by them were certified pre-owned goods. It was observed that luxury brands like that of LV invest substantially to create promotional material which would align with their brand image and concept and hence, unauthorised use of the same would not only amount to infringement but can even be damaging for the brand's image.

BOMBAY HIGH COURT GRANTS TEMPORARY RELIEF TO BURGER KING - RESTRAINS PUNE RESTAURANT FROM USING THE BURGER KING MARK

The Bombay HC granted interim relief to the US-based international burger giant Burger King Corporation ("**Burger King**") in a trade mark dispute with a Pune-based food joint operating under the same name. The dispute dates back to 2008 when Burger King allegedly discovered a trade mark application filed for 'Burger King' by the owners of the Pune-based joint ("**Irani**"). Subsequently in 2011, Burger King initiated suit proceedings against Irani before a District Court ("**District Court**"), alleging infringement of trade mark and passing off. Vide an order date 05 March 2011, the District Court passed ad-interim ex-parte order enjoining Irani from using the trade mark 'Burger King'. Pursuant to this order, Irani dropped 'King' from their branding and continued business under the name 'Burger' alone.

Tables turned this year when the District Court dismissed Burger King's application for permanent injunction noting that Irani had been using the trade mark 'Burger King' well before Burger King entered the Indian market. It was also noted that there was considerable difference in the logos being used by both parties. The District Court held that Burger King failed to prove a case against Irani and that there was no evidence to prove infringement or actual damage caused to Burger King owing to Irani's use of the mark.

In response to this order passed by the District Court ("**Impugned Order**"), Burger King was quick to file an appeal before the Bombay HC, also seeking an interim relief in the matter. It was argued on behalf of Burger King that the Impugned Order was flawed, submitting that Burger King now operates over 400 (four hundred) outlets in India, with 6 (six) outlets in Pune itself. On the contrary, Irani argued that the local business had built a reputation of its own under the trade mark owing to several years of use, and had even resumed use of the same pursuant to passing of the Impugned Order. Noting that the interim application would require a detailed hearing, the Bombay HC ordered the District Court's earlier order confirming injunction against Irani to operate till further orders²⁶.

The appeal and interim application are pending adjudication before the Bombay HC.

24. Louis Vuitton Malletier v. www.haute24.com & Ors., 2024 SCC OnLine Del 5817.

25. 2022) 92 PTC 135.

THE GUJARAT HIGH COURT SET ASIDE INJUNCTION ORDER RESTRAINING USE OF THE MARK 'UNISON'

In a recent case between Unison Pharmaceuticals Pvt. Ltd. ("Unison") and Unison Health Check Up and Diagnostics LLP ("UHCD"), the Gujarat High Court ("Gujarat HC") delivered a judgment in favor of UHCD. The Gujarat HC set aside the interim injunction previously granted by the Commercial Court on May 18, 2024,²⁷ which had restrained UHCD from using the trade mark 'UniSN'.

Unison claimed that the usage of the mark, 'UniSN' would harm the well-established goodwill of the company and cause confusion in the minds of the people who would associate it with Unison's mark, 'UNISON'. The Commercial Court, after examining the similarities between the two trade marks, held that there were significant phonetic similarities which could cause confusion among the consumers and subsequently passed an injunction prohibiting its use. The said decision was appealed on the grounds that their trade mark was registered under Class 44 for health check-up and diagnostics unlike Unison's which was registered under Classes 5 and 10 (*pertaining to medical and pharmaceutical goods*). UHCD in their appeal also stated that their trade mark was a unique name incorporating the names of its founders, making it distinct from Unison's.

The Gujarat HC asserted the need to examine the trade marks on various grounds, not limited to its visual and phonetic similarities. This included the classes under which they were registered, the consumer base it seeks to attract and the nature of goods and services. The Gujarat HC analysed this under the purview of Sections 28, 29, and 31 of the Trade Mark. In doing so, the Gujarat HC also relied on the cases of *Renaissance Hotel Holdings Inc. v. B. Vijaya Sai*²⁸ and *FF. Hoffmann-La Roche & Co. Ltd. v. Geoffrey Manner & Co.*²⁹ and opined that the legislative scheme of the law does not lay down any test for similarity and hence this is dependent on the facts and circumstances of each case. They held that 4 factors must be considered when deciding similarity:

- i. That two words must be similar both by their look and by their sound.
- ii. The goods to which they are to be applied;
- iii. The nature and kind of the customers who would be likely to buy those goods.

- iv. All the surrounding circumstances must be considered and further that what is likely to happen, if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.³⁰

The Gujarat HC in perusing the facts and circumstances of the present case basis the factors laid in judicial precedents held that the Commercial Court had erred in applying only the phonetic test, without considering all surrounding circumstances and set aside the interim injunction passed against UHCD, thereby allowing them to continue using the trade mark 'UniSN'.

THE TESLA TUSSLE – THE DELHI HIGH COURT REFERRED THE TRADE MARK DISPUTE TO MEDIATION.

In a recent case before the Hon'ble Delhi HC, Elon Musk's Tesla Inc. ("Tesla") filed a trade mark infringement suit against a Gurugram based entity, Tesla Power India ("TPI"). It was the Tesla's case that TPI is using similar trade marks, i.e., 'TESLA POWER', 'TESLA POWER USA',

''. Tesla further averred that TPI entered in the same category of business and had been advertising under the trade mark, TESLA leading to confusion and deception. Resultantly, the present lawsuit was brought in by Tesla seeking permanent injunction and damages for passing off, infringement and unfair competition to restrain TPI from using its trade mark in the course of trade.

TPI stated that their business dealt with lead acid batteries which were used for inverters and UPS devices and did not manufacture EV's and had no intention of doing so. They also affirmed before the Delhi HC that they would refrain from advertising anything related to EV's. However, an investigator's affidavit presented before the Delhi HC revealed the image of an EV available for sale and related brochures by TPI, which they claimed to be of their partner company who deals in e-scooters.

26. Burger King Corpn. v. Anahita Irani, 2024 SCC OnLine Bom 2786

27. Commercial Trade mark Suit No.13 of 2023, Commercial Court, Ahmedabad (18 May 2024).

28. 2022) 5 SCC 1.

29. 1969) 2 SCC 716.

30. Ibid.



The Delhi HC, in pursuance of these findings directed TPI to disclose the number of EVs sold and all relevant documents. TPI, in a subsequent hearing in July 2024, expressed their desire to amicably mediate the matter via a sur-rejoinder, to which Tesla seemed amenable. The Delhi HC in response to this consensus between the parties has referred the matter to the Senior Mediator of the Delhi HC Mediation and Conciliation Centre.

BOMBAY HIGH COURT GRANTS TEMPORARY RELIEF TO HINDUSTAN UNILEVER IN ADVERTISEMENT DISPUTE

The Bombay HC granted ad-interim relief to Hindustan Unilever Limited ("HUL"), a major FMCG company, in its plea against Abbott Laboratories and others ("Abbott"), for allegedly disparaging HUL's product, Horlicks Diabetes Plus.³¹ The bench, led by Justice R.I. Chagla, found that HUL had established a strong prima facie case for the issuance of interim relief, with the balance of convenience favouring HUL. The Bombay HC emphasized that without this relief, HUL would suffer irreparable damage to their product's reputation, which could not be compensated financially.

HUL argued that Horlicks Diabetes Plus is a high-fiber nutritional drink designed for blood sugar management and holds a valid trade mark. The dispute arose when

HUL discovered, in August 2024, an advertisement for Abbott's product, Ensure Diabetes Care. This advertisement was allegedly circulated widely across WhatsApp groups, including pharmacists, chemists, healthcare professionals, and general family circles throughout India.

HUL claimed that the advertisement featured a blurred image of Horlicks Diabetes Plus, which was pushed aside and replaced by Ensure Diabetes Care, thereby implying that HUL's product was inferior or ineffective. Concerned about the implications of this portrayal, HUL's legal team reached out to Abbott for clarification but received no substantial response.

The Bombay HC, finding merit in HUL's plea for interim relief, noted that the continued circulation of the impugned advertisement would result in irreparable harm to HUL's reputation, which monetary compensation could not adequately remedy. Consequently, the Bombay HC issued an interim order restraining Abbott from further circulating or broadcasting the contested advertisement until further proceedings.

The case is scheduled for a final hearing on October 07, 2024.

31. Hindustan Unilever Limited v. Abbott Laboratories & Ors., Commercial IPR Suit (L) No. 27527 of 2024.

DELHI HIGH COURT GRANTS AD INTERIM INJUNCTION TO RPFAS TECHNOLOGIES AGAINST FRAUDULENT USE OF 'MUDREX' TRADE MARK

The Delhi HC granted an ad interim injunction restraining multiple fraudulent websites from using the trade mark 'Mudrex', favoring RPFAS Technologies Private Limited ("**RPFAS**").³² RPFAS argued that these websites registered infringing domain names incorporating the 'Mudrex' mark and operated fake websites inviting the public to invest, thereby illegally collecting money without authorization.

RPFAS contended that unknown individuals, referred to as John Doe/Ashok Kumar ("**John Doe**"), misused the 'Mudrex' trade mark to run fraudulent businesses under RPFAS's name. These activities not only deceived the public but also caused reputational damage and financial loss to RPFAS. RPFAS, a leading Virtual Digital Asset exchange, asserted its exclusive rights over its marks, which are protected under copyright, patent, and

trade mark laws. It had issued advisories via social media and emails to warn users of potential scammers.

The Delhi HC held that RPFAS established a prima facie case for granting an injunction. The Delhi HC noted that the infringing activities of John Doe had led to illegal profits and were detrimental to RPFAS's goodwill. The balance of convenience favoured RPFAS, as RPFAS stood to suffer irreparable harm if the relief was not granted.

As a result, the Delhi HC ordered an ad interim injunction preventing John Doe, their associates, and any linked entities from using RPFAS's trade marks or deceptively similar marks in connection with any goods or services. The injunction aims to curb further trade mark infringement and prevent passing off. Additionally, John Doe were directed to take down the infringing websites within 48(forty-eight) hours.

The matter is scheduled for the next hearing on December 16, 2024.

32. RPFAS Technologies Private Limited v Ministry Of Communications And Ors, CS(COMM) 712/2024.



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