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An e-newsletter from
Lakshmikumaran & Sridharan, India

April 2022 / Issue-127

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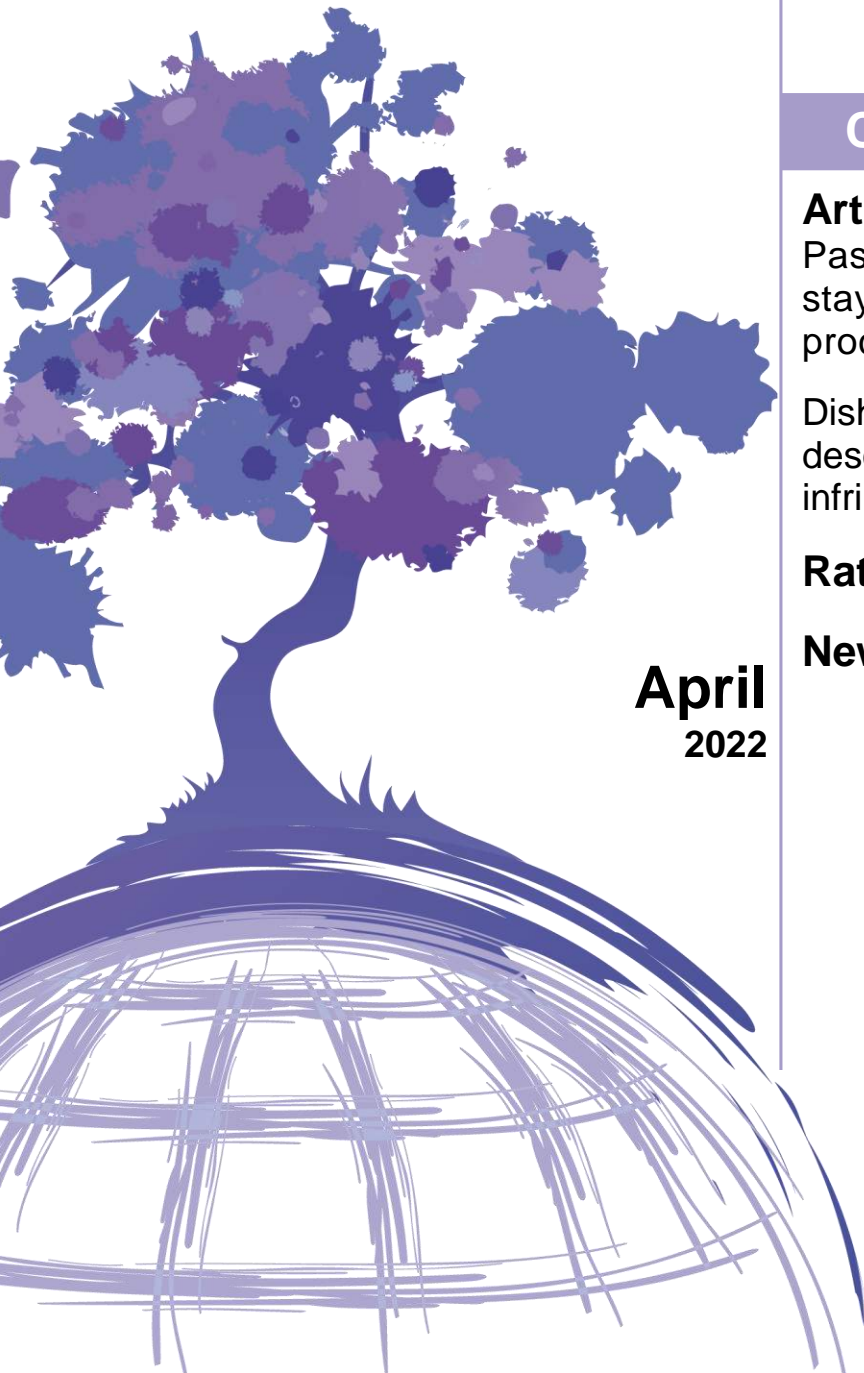
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Articles

Passing of an interim order during stay on a suit of infringement proceedings

By Raghav Sarda, Sidharth Shahi and Anushka Verma

Introduction:

Judicial systems across various jurisdictions aim to reduce multiplicity of judicial/quasi-judicial proceedings. It is done to ensure that the outcomes of such proceedings are not contradictory, giving rise to several rights vested in different parties, *albeit* concerning the same factual matrix. This principle has been duly incorporated in the Indian trademark regime as well. As per Section 124 of the Trade Marks Act, 1999 (**'Act'**), a suit for infringement of a trade mark must be stayed while a rectification proceeding in respect of any of the marks in the suit is pending before the Registrar of Trade Marks or the High Court.

The rationale behind said provision is to ensure that the decision in the infringement proceeding is only taken once the validity of the concerned mark in question is ascertained. In light of the same, the High Court of Delhi (**'Court'**), in an Order dated 6 January 2022, in *Hamdard National Foundation (India) & Anr. v. Sadar Laboratories Pvt. Ltd.*¹ has reiterated the principle encapsulated in Section 124, while also clarifying the scope of Section 124(5) of the Act.

Facts of the case:

Hamdard National Foundation (India) and Hamdard Dawakhana (**'Plaintiffs'**) are engaged in the business of Unani and Ayurvedic medicines, oils, syrups, and beverages. They have obtained registration for the trademarks

'Hamdard' and 'Rooh Afza', which they have been using for their products for over 100 years. The mark 'Rooh Afza' has been registered since as early as 1942, and the *sharbat* sold under said mark has a unique lay-out, getup and arrangement, which gives it a distinctive visual impression.

Sadar Laboratories (**'Defendant'**) is also engaged in the business of Unani medicines, syrups, and beverages. The Defendant has a registered trademark 'Sharbat Dil Afza', which was filed in July 2018, claiming use since 1949. In March 2020, the Plaintiffs were apprised of a syrup/sharbat being launched by the Defendant bearing the mark 'Dil Afza', the adoption of which, along with the alleged deceptively similar get-up of the product, contended by the Plaintiffs, was done with a *mala fide* intention to exploit their goodwill. The Plaintiffs additionally stated that it was due to an oversight that the Defendant's mark 'Dil Afza' was not opposed at the time of registration, and subsequently, filed an application for rectification before the Trade Marks Registry.

Pursuant to this, the Plaintiffs filed a suit for infringement on the ground that the Defendant was not only infringing the well-known trademarks 'Hamdard' and 'Rooh Afza' of the Plaintiffs but was also passing off its products as those of the Plaintiffs by using the mark 'Dil Afza', and a similar product design and get-up. In the suit, the Plaintiffs sought a relief seeking permanent injunction, restraining the Defendant from infringing their registered trademarks and

¹ 2022 (89) PTC 342 (Del).

seeking protection against disparagement, dilution and tarnishment of trademarks, and damage to reputation.

Arguments advanced:

- *On the well-known status of Plaintiffs' marks*

The Plaintiffs relied on *Unani Dawakhana v. Hamdard Dawakhana*², in which the Lahore High Court had observed that the trademark 'Rooh Afza' is a well-known trademark. In response to this, the Defendant contended that the judicial precedent was not applicable in the present case as it was based on an erstwhile statute and the present Act provides for certain pre-requisites to be met for a mark to be considered as 'well-known', which have not been met in the present case.

- *Whether the law contemplates granting an interim injunction under Section 124(5) of the Trade Marks Act, 1999*

The Defendant relied on Section 124(1)(b)(i) of the Act and stated that since the Plaintiffs had initiated a rectification proceeding against the Defendant's application for the mark 'Dil-Afza' before the Registrar of Trade Marks, the suit for infringement, and any subsequent action therein, must be stayed. The Defendant further brought to light the fact that since the relief sought in the interim application is fundamentally the same as that in the main suit, the Court cannot grant an interim injunction as that would essentially lead to a decision on the main suit. On the contrary, the Plaintiffs contended that the rule under Section 124(1) is not without exceptions. In certain cases, Section 124(5) allows an interim injunction to be granted.

- *Whether an interim injunction could be granted on the facts of this case*

It was contended by the Defendant's counsel that the Plaintiffs and Defendant have registration for their respective marks and therefore, a suit for infringement cannot be instituted taking into account Section 29 of the Act. The Defendant further contended that the term 'Afza' had become a common term used by many entities in the *sharbat* market and had not acquired a secondary meaning so as to be associated solely with the Plaintiffs. Further, there were significant differences in the packaging of the bottles, where the Plaintiffs' label contained flowers, the Defendant's label depicted fruits and showed the house-mark Sadar distinctively. Further, the Defendant has acquired its own reputation through the extensive and continuous use of its mark. It also contended that the Plaintiff has belatedly filed the present suit as it has been aware of the Defendant's reputation as both parties were members of the Unani Drug Manufacturers Association and were known to each other.

On the other hand, the Plaintiffs asserted that 'Rooh Afza' had obtained a secondary meaning and the Defendant obtained registration of their mark 'Dil-Afza' by deception as documents related to prior use of the mark were not submitted before the Registrar of Trade Marks. In addition to this, the Plaintiffs stated that on an overall comparison there were minor differences in the two labels, and the visual impression of the Defendant's product was substantially similar to cause confusion to the public.

Held:

The Court, at the outset, agreed with the Plaintiffs that they had acquired a vast reputation and goodwill with respect to their trademark 'Rooh Afza'. However, it categorically noted that this goodwill did not extend to the word 'Afza',

² 1930 SCC OnLine Lah 300.

neither had they applied for and/or obtained registration for only this word. Therefore, their exclusivity extended only to the complete name 'Rooh Afza', and not to either of the words constituting the mark. With regards to the Defendant's contention that the Plaintiff is barred from requesting interim injunction in view of Section 124(5), the court disagreed and confirmed that an interim order can be passed even if the infringement suit has been stayed in view of Section 124. However, the Court stated that in order to analyze whether an interim order can be passed under Section 124(5) of the Act, it is imperative to look at the question whether the use of the Defendant's mark would result in confusion to the consumers.

On this point, the Court stated the standard to be adopted while determining confusion arising in the mind is of a consumer of imperfect memory or recollection and of ordinary sensibilities. Turning to the factual matrix of the present case, it was held that in the context of a common consumer, the words 'Rooh' and 'Dil' do not denote the same thing. The Court relied on the case of *Cadila Laboratories Ltd. v. Dabur India Limited*³, to discuss the importance of prefixes in marks where the suffix is common. It reiterated that where the suffix is common, the prefix becomes the distinctive feature of the mark. Applying the same principle to this case, the Court noted that the prefix 'Rooh' and 'Dil' would not cause confusion due to their different meaning.

The Court further noted that since the Plaintiffs had failed to show that the word 'Afza' had acquired a secondary meaning denoting only their product 'Rooh Afza', it cannot be said that the Defendant's product 'Dil Afza' is passing off

as Plaintiffs' product and reputation. Lastly, the Court considered that the Plaintiffs' and Defendant's products bearing their respective marks had been co-existing in the market for a long time, the simultaneous use of the Defendant's mark shall not prejudice the Plaintiffs' business.

The Court observed that no case was made out for an interim order as per Section 124(5) of the Act and dismissed the present interim application, with a direction that a true account of sales of 'Dil Afza' syrup be maintained during the pendency of the suit. The Court further directed the stay of the suit of infringement, till the final disposal of the rectification application filed by the Plaintiffs, in light of Section 124(1)(b)(i) of the Trade Marks Act, 1999.

Conclusion:

While the Court reaffirmed the statutory principle enunciated in Section 124, an important aspect of the case is the applicability of Section 124(5). The Court re-emphasized that a stay of a suit of infringement proceedings does not automatically mean that an interim order cannot be passed. Consumer protection and avoidance of consumer confusion/deception lies at the heart of trademarks law. Therefore, even where there are ongoing rectification proceedings, the Court has clarified through its analysis in this case, that an interim order could be passed if the factual matrix indicates that consumer confusion is caused.

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³ 1997 SCC OnLine Del 360.

Dishonest use of a well-known and descriptive trademark amounting to infringement

By **Godhuli Nanda and Vindhya S. Mani**

Recently, while deciding an application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (**'CPC'**) in the case of *Moonshine Technology (P) Ltd. v. Tictok Skill Games (P) Ltd.*⁴, a Single Judge of the Delhi High Court *vide* an interim order dated 31 January 2022, reiterated that in a case for infringement, grant of injunction is necessary if it *prima facie* appears that the Defendants' adoption of the mark was itself dishonest. The Court held that once the Plaintiff has shown that the use by the Defendants is of the exact word i.e., the registered trademark of the plaintiff and that the goods or services are identical, the Court will necessarily presume that confusion would arise in the minds of the public or consumers as to the origin of the goods or services and accordingly, an interim injunction would have to be issued.

In this case, the Plaintiff offered gaming products under the brand name 'Baazi' and other 'Baazi' comprising registered trademarks. The Plaintiff claimed that the Defendants dishonestly started using 'Baazi' along with the term 'Winzo' in respect of similar goods and services. The Defendants argued that the term 'Baazi' was descriptive. The Court, however, agreeing with the Plaintiff held that the Defendant's use of the term 'Baazi' was dishonest. It was also observed by the Court that the Defendants failed to offer any substantial reason so as to justify their own use of the term 'Baazi'. The Court concluded that *prima facie* infringement existed and that continuous use of the mark 'Baazi' by the Defendants would cause confusion among the players about a probable connection between the

two parties, thus impacting the goodwill, reputation and distinctiveness of the registered trademark of the Plaintiff and causing irreparable loss.

Even though the law is quite clear on the fact that there will be no case of infringement in case a registered trademark is being used for descriptive purposes, proving a mark to be descriptive is not enough, a *bona fide* intention to use the mark for descriptive purpose will have to be additionally shown to assert a legitimate defence. It is pertinent to mention that certain marks *prima facie* appear to be descriptive. However, if such marks become distinct over time, the Court ensures that no one takes unfair advantage of the same. In the case of *Info Edge (India) Pvt. Ltd. and Anr. v. Shailesh Gupta and Anr.*⁵, the Plaintiffs used the trademark/domain name 'Naukri.com' to provide online classified recruitment and related services. The Plaintiffs alleged that the Defendants registered a domain name 'Naukari.Com' to lead innocent users, who mistakenly typed 'Naukari.com' instead of 'Naukri.com', to their website 'Jobsourceindia.com', which offered similar services as that of the Plaintiffs. The Defendants argued that the trademark 'Naukri.com' is a descriptive/generic mark and thus the Plaintiffs cannot have monopoly over the same. The Court pointed out that the Plaintiffs' mark had attained distinctiveness with the services offered under it despite being a descriptive mark. Further, the Defendants having purchased a domain name with a slight misspelling despite having another registered domain name establishes that it was done in bad faith. Thus, the Court issued an

⁴ 2022 SCC OnLine Del 296

⁵ 98(2002) DLT 499

interim order injunction the Defendants from using the domain name in question.

The approach by the Courts when it comes to descriptive and well-known trademarks where the classes of goods of an infringing trademark has been varied. For example, in the case of *T.V. Venugopal v. Ushodaya Enterprises Limited*⁶ the Defendant adopted the trademark 'Ashika's Eenadu' for manufacturing and dealing in incense sticks in Karnataka and later in Andhra Pradesh. However, the Plaintiff in the state of Andhra Pradesh was already using the mark 'Eenadu' for publishing a popular newspaper and running a TV Channel and hence, sought an injunction against the Defendant. The Defendant argued that the mark 'Eenadu', which means 'today' is a descriptive/generic word, therefore, a single entity cannot have a monopoly over the same. The Court in this case pointed out that the Plaintiff's mark has acquired distinctiveness due to an extraordinary reputation and goodwill in the state of Andhra Pradesh. Considering this, the Court further observed that permitting the Defendant to use the term 'Eenadu', though for different class of goods and services, will amount to subscribing to an attempt of the Defendant to dishonestly ride on the said goodwill and profit from deceiving the people to believe that the product under 'Ashika's Eenadu' belongs to the Plaintiff. On the contrary, in the case of *Cadila Healthcare Ltd. v. Gujarat Co-operative Milk Marketing Federation Ltd. & Ors*⁷, the Plaintiff was the registered proprietor of the trademark 'Sugar Free', a brand for sugar substitute products. The Plaintiff instituted a suit against the Defendants for the usage of the terms 'Sugar Free' in their frozen dessert. To which, the Defendants contended that their use of the terms 'Sugar Free' was *bona fide* and in a descriptive sense rather than a trademark sense. The Court

observed that the word Sugar-Free has attained secondary meaning in the sugar substitute market with a certain class of people. However, the Court concluded that the mark 'Sugar Free' cannot be construed to be distinctive or acquired secondary meaning concerning other products or with respect to a different class of people. In consideration of the above view, the Delhi High Court refused to grant an injunction against the Defendant to use the mark 'Sugar Free' to describe the nature of their product.

Similarly, in the case of *A.D. Padmasingh Isaac and Another v. Sudali Aach Provisions*⁸, where the classes of goods could be said to be allied, the Court did not provide injunctive relief to the Plaintiffs. In this case, the Plaintiffs conceived, adopted, and registered the trademark 'Aachi' for manufacturing and marketing a variety of spices. The Plaintiffs objected to the usage of the word 'Aachi' in the Defendant's trademark 'Sudali Aachi Provision' for running a grocery store. The Defendant argued that the word 'Aachi', which means grandmother in the Tamil Language is a generic/*public juris* mark. Thus, the Plaintiffs cannot restrain them from using the term 'Aachi' in their trademark. The Court siding with the Defendant held that even though 'Aachi' is a descriptive registered mark, the same does not entitle the Plaintiffs to use the term 'Aachi' as a 'sword against anyone' who uses said term *per se* or in combination with *bona fide* intention.

It is clear that if a descriptive trademark accrues goodwill and reputation it cannot be infringed on a mere pretext that the mark is descriptive. The use of registered descriptive marks with dishonest intention and bad faith would be a just cause for the Court to restrain the Defendants on principles of equity. Thus, particularly in matters of interim injunction, the

⁶ (2011) 4 SCC 85

⁷ 2009 (41) PTC 336 (Del.) (DB)

⁸ 2022 SCC OnLine Mad 343

Plaintiff, in addition to establishing a *prima facie* infringement in case of descriptive trademarks, will also have to show dishonesty and bad faith in the adoption of such mark by the Defendant. A Defendant on the other hand cannot seek refuge in merely claiming the mark as being descriptive

but has to show *bona fide* adoption of such mark only for describing its goods and services.

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Ratio decidendi

Trademarks – Words ‘OM’ and ‘Logistics’ when cannot be monopolised

The Delhi High Court has vacated its earlier *ex parte* ad interim injunction in favour of the plaintiff, restraining the defendant from using ‘OM EXPRESS LOGISTICS’ or any other mark similar to the plaintiff’s mark ‘OM LOGISTICS LTD.’. The Court in this regard observed that the plaintiff could not be allowed to monopolize the use of the religious symbol ‘OM’. It also noted that the words ‘EXPRESS’ as well as ‘LOGISTICS’ were common words of the English dictionary and were used in a laudatory/descriptive manner in the present case where both the parties were engaged in the business of transportation and logistics. Further, observing that there were several registrations under Class 39 of names using the words/marks ‘OM’, ‘ॐ’ and ‘LOGISTICS’, the Court found merit in the submission of the defendant that the marks were common to trade and could not be monopolised.

The High Court, in deciding on passing off, noted that other than the words which were common to

trade, there was no other visual similarity (of logo, colour scheme or font) between the competing marks and hence there was no likelihood of confusion or deception. The Court also noted that there were several other prior registered owners using the same words in their names prior to the plaintiff.

In respect of infringement, the Court was of the view that registration alone would not give the plaintiff the exclusive right to use the trademark. It noted that the defendant had filed rectification petitions against the registration and that the defendant would also be entitled to invoke Sections 17 and 30(1)(a) of the Trade Marks Act, 1999. The Court also observed that acquired distinctiveness through long usage cannot be decided at this *prima facie* stage and can only be established at the stage of trial.

Vacating its earlier order on interim injunction, the Court also took note of the fact of concealment and suppression of facts and documents on the part of the plaintiff. [*Om Logistics Ltd. v. Mahendra Pandey* – Judgement dated 15 March 2022 in CS(COMM) 447/2021, Delhi High Court]

Every Single Judge Order, though may cause some inconvenience, is not a 'judgement' for filing appeal

The Supreme Court of India has reiterated that the question as to whether an order impugned would be a 'judgement' within the scope of Clause 15 of Letters Patent, for purpose of filing appeal thereagainst, would depend on the facts and circumstances of each case. The Court echoed that for an order to be construed as a 'judgement', it must have the traits and trappings of finality and must affect vital and valuable rights of the parties, which works serious injustice to the party concerned. It was of the view that each and every order passed by the Court during the course of the trial, though may cause some inconvenience to one of the parties or, to some extent, some prejudice to one of the parties, it cannot be treated as a 'judgement'.

Observing that the Single Judge granted two weeks' time to the defendants to file affidavit-in-opposition and postponed the issue of grant of ad-interim injunction by three weeks, the Court held that there was no adjudication with regard to the rights of the respondent-plaintiff to get an ad-interim injunction during the pendency of the suit. Setting aside the Division Bench decision against the said Single Judge Order, which had allowed the appeal and granted interim relief in case of trademark infringement, the Apex Court was of the view that Single Judge decision could not be treated as a 'judgment' inasmuch as there was no conclusive finding.

The Supreme Court in this regard also observed that though Single Judge at one place observed that *prima facie*, 'SHYAM' being a part of the business name of the appellants-defendants, no injunction should be passed to restrain them from using the said word on their packaging, it had also clarified that all the observations made

in the said order were *prima facie* and would have no relevance at the time of considering and deciding the said application after exchange of affidavits. [*Shyam Sel and Power Limited v. Shyam Steel Industries Limited* – Judgement dated 14 March 2022 in Civil Appeal No. 1984 of 2022, Supreme Court]

Tag line 'Vitalizes Body and Mind.' is descriptive and laudatory in respect of energy drink – No prima facie infringement by use of tag line 'Stimulates Mind. Energizes Body.'

The Delhi High Court has held that the tag line 'Vitalizes Body and Mind.', used by the plaintiff, is *prima facie* of descriptive/laudatory character, and ought not to have been granted registration in view of Section 9(1)(b) of the Trade Marks Act, 1999. It observed that the tag line had a direct reference to the quality, intended purpose, values and other characteristics of the plaintiff's product – energy drink. Use as a sentence on the product was held by the Court as evidence of use in a descriptive manner.

Rejecting the allegation of infringement by use of the tag line 'Stimulates Mind. Energizes Body.', by the defendant, which was alleged to be similar to that of the plaintiff, the Court noted that the defendant was also using the four words in a descriptive/laudatory manner and aimed to describe the features and quality of its drink. The Court also rejected the contention that the defendants were using the tag line in a manner that is likely to be taken as being used as a trademark.

Further, observing that the products of the plaintiff and defendants were of the same kind, viz. energy drinks, the Court held that descriptive or laudatory taglines in respect of these products have necessarily to communicate the same idea. It was of the view that it cannot be said that the adoption of the impugned mark by the

defendants was not *bona fide*. The defendant was held entitled to the benefit of Sections 30(2)(a) and 35 of the Trade Marks Act.

The interim injunction was declined after the Court also noted that the defendant was using the tagline for 5 years. It was also of the view that the question as to whether the tag line had acquired distinctiveness and secondary meaning,

was to be dealt with only at trial. The High Court also rejected the contention of passing off while it observed that no confusion or deception would be caused to the customers of both the parties in respect of their products. [*Red Bull AG v. Pepsico India Holdings Pvt. Ltd.* – Judgement dated 6 April 2022 in CS(COMM) 1092/2018, Delhi High Court]



News Nuggets

Trademark infringement – Absence of expert testimony not material

The Delhi High Court has set aside the order of the Trial Court where in the lower court had disapproved the case of infringement and passing off in absence of expert testimony. The Court noted that unlike in a criminal case, in a case of infringement of registered trademarks or of passing off, similarity of the marks used is to be considered and there is no call to have an expert witness to testify to the use of an identical or similar trademark. The Trial Court had returned a finding that the appellant/plaintiff had failed to prove that the goods seized by the Local Commissioner were counterfeit products as no expert was examined nor any other evidence was produced. The High Court in *Burberry Ltd. v. Aditya Verma* [Judgement dated 29 March 2022] noted that the proof required was not of whether there was counterfeiting, but of infringement by use of the registered trademarks unauthorizedly. It was of the view that had the products been not counterfeit, even then, if the trademarks used

were to mislead the public regarding the origin of the products, a case for injunction is made out.

Trademarks ‘MAGIC MOMENTS’ and ‘EVENING MOMENT’ are deceptively similar

The Delhi High Court has held that the marks ‘MAGIC MOMENTS’ and ‘EVENING MOMENT’ are deceptively similar in view of the fact that the essential feature ‘MOMENT’ was being used in toto by the Defendants, for the same product - whiskey. The Court noted that the words ‘MAGIC MOMENTS’ were arbitrary words used for the Plaintiff’s products and that the use of the word ‘EVENING’ was not sufficient to distinguish the two products due to the very nature of the product which is usually consumed in evening times. The High Court in *Radico Khaitan Limited v. Sarao Distillery (OPC) Pvt. Ltd.* [Judgement dated 28 March 2022] also stated that the use of the word ‘MOMENT’ in the Defendant’s mark could lead consumers to connect the said product to the Plaintiff as it could be easily perceived that the Defendant’s product was

another addition to the Plaintiff's product-stable. It noted that the focus would be on the word 'MOMENT' which was the dominant part of the impugned mark.

Copyrights – Private copying exception applies to cloud storage for private purpose

The Court of Justice of the European Union has held that the 'private copying' exception under the European Union's Copyright Directive applies to the storage in the cloud of a copy of a protected work for private purposes. The Court was of the view that the objectives would be undermined if the exceptions and limitations to copyright protection were interpreted in such a way as to exclude digital media and cloud computing services. The CJEU in this regard also noted that the saving of a copy of a work in storage space in the cloud constitutes a 'reproduction' of that work and that the 'upload' of a work to the cloud consists in storing a copy of it. It may be noted that the fact that the server belongs to a third party was held as not decisive by the CJEU in *Austro-Mechana Gesellschaft zur Wahrnehmung mechanisch-musikalischer Urheberrechte Gesellschaft mbH v. Strato AG* in its Judgement dated 24 March 2022.

Trademarks – Use of recycled bottles of another manufacturer will amount to infringement and passing off

Sale of any product with the recycled bottles of another manufacturer would result in infringement and passing off. Holding so, the Delhi High Court has observed that though the bottle itself may be a genuine bottle which may have been put by the Plaintiff originally in the market, after the contents are consumed and the bottle reaches the recycling stage, the

Defendant's use of such bottles which have the Plaintiff's trade mark embossed on them would cause confusion as to its source. The Court in *Anheuser-Busch LLC v. Surjeet Lal* [Decision dated 14 March 2022] also observed that such use would constitute 'use in the course of trade' and the fact that the bottles were recycled bottles would not make a difference insofar as the question of infringement or passing off is concerned.

Hearing before Trademarks Registry – Delhi High Court asks CGPDTM to devise proper mechanism

The Delhi High Court has asked the Controller General of Patents, Designs & Trade Marks ('CGPDTM') to devise a proper mechanism for holding show cause hearings. The Court directed to publish the cause list on daily basis, with serial numbers for the applications to be taken up, preferably with morning and afternoon slots, if required. It also directed for utilising a platform with an open link which permits more individuals to join a hearing at a time and for matters be called serial number-wise. In this case *Pawandeep Singh v. Registrar of Trademarks* [Order dated 23 March 2022] where the trademark was refused without granting a hearing (the counsel was kept waiting in the waiting room) even though the order captured that the hearing took place, the Court also directed that there should be removal of templates from the order statements such as 'hearing took place before me' which may vary on case-to-case basis. Further, the Court also directed that some extra space should be made available in the order for Senior Examiners to put their brief reasons for allowing or refusing the application.

No confusion between test kits OMISURE and medicine OMIPURE

The Delhi High Court has held that RT-PCR test kits 'TATA MD CHECK RT-PCR OMISURE' would not be confused in any manner with the 'Omeprazole' tablets or capsules of the Plaintiff sold under the mark 'OMIPURE'. Observing various differences, including the fact that Plaintiff's product was sold across the counter to the customers whereas the Defendant's product was of a specialised nature used only in laboratories and was not sold over the counter to general public, the Court was of the opinion that the sale of the test kit for the purpose of diagnosis of the omicron variant of Covid-19 would not cause any confusion in the market or even association between the Defendant's product and the Plaintiff's mark, latter being used for capsule/tablet for gastro-resistant intestinal ailments. The High Court in *Mankind Pharma Limited v. Tata Medical and Diagnostics Limited* [Order dated 30 March 2022] also observed that the chances of blurring were negligible since the plaintiff's mark was not extensively used (with no sales for 9 years in between) while the sales figures of defendant's product showed considerable volumes.

Supreme Court's extension of limitation period owing to Covid-19 applicable to Trade Marks Opposition Proceedings

The Delhi High Court has directed all the officers at the Office of the Controller General of Patents, Designs, and Trade Marks ('CGPDTM') to adhere to the Order of the Supreme Court dated 19 January 2022 in *Cognizance for Extension of Limitation*. The Apex Court had directed that the period of 15 March 2020 to 28 February 2022 is to be fully

excluded for the purpose of calculation of limitation under all enactments and statutes, both before judicial and quasi-judicial bodies, in view of the Covid-19 pandemic. The High Court in this regard also noted that CGPDTM Public Notice dated 18 January 2022 records that the period of limitation shall be computed in accordance with the said Order of the Supreme Court.

Further, in respect of trademark registration certificates issued during the said pandemic period, the High Court in the case *Dr. Reddy's Laboratories Limited & Ors. v. Controller General of Patents, Designs, and Trademarks & Anr.* [Order dated 21 March 2022] directed that the registration certificates shall stand suspended till the oppositions already filed or filed by 30 May 2022 are decided by the office of the CGPDTM.

Patents – Lack of inventive step – Points to be considered by the Controller

The Delhi High Court has laid down three points that the Controller needs to consider before rejecting an invention for lack of inventive step. According to the Court, the Controller must consider the invention disclosed in the prior art, the invention disclosed in the application under consideration, and the manner in which subject invention would be obvious to a person skilled in the art. The Order in the case *Agriboard International LLC v. Deputy Controller of Patents and Designs* [Dated 31 March 2022] further states that arriving at a bare conclusion that the subject invention is lacking inventive step, without a discussion on the mentioned three elements, would not be permissible unless it is a case where the same is absolutely clear.

Eveready is a 'well known trade mark'

The Delhi High Court has held that the mark 'EVEREADY' fulfils the criteria of being a 'well known trade mark' under Section 2(1)(zg) of the Trade Marks Act, 1999. The Court in this regard noted that its sales figures from the year 1981-82 to 2007-08 totalled more than INR 12,450 crore with advertisement figures of more than INR 465 crore. It also noted that the use of the mark 'EVEREADY' was reported in various judgements, since 1930 and was

being used extensively and continuously. The Court in *Sanjay Chadha Trading as Eveready Tools Emporium v. Union of India* [Judgement dated 17 February 2022] was of the view that the mark had gained immense goodwill and reputation. Under Section 11(2) of the Trade Marks Act, the registration is not to be granted in respect of a trade mark which is identical with or similar to an earlier well known trade mark and the use of the later mark is detrimental to the distinctive character or repute of the earlier trade mark.

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Phone : +91-172-4921700
E-mail : lschd@lakshmisri.com

GURUGRAM

OS2 & OS3, 5th floor,
Corporate Office Tower,
Ambience Island,
Sector 25-A,
Gurgaon-122001
Phone : +91-124-477 1300
E-mail : ls gurgaon@lakshmisri.com

PRAYAGRAJ (ALLAHABAD)

3/1A/3, (opposite Auto Sales),
Colvin Road, (Lohia Marg),
Allahabad -211001 (U.P.)
Phone : +91-532-2421037, 2420359
E-mail : lsallahabad@lakshmisri.com

KOCHI

First floor, PDR Bhavan,
Palliyil Lane, Foreshore Road,
Ernakulam Kochi-682016
Phone : +91-484 4869018; 4867852
E-mail : lskochi@lakshmisri.com

JAIPUR

2nd Floor (Front side),
Unique Destination, Tonk Road,
Near Laxmi Mandir Cinema Crossing,
Jaipur - 302 015
Phone : +91-141-456 1200
E-mail : lsjaipur@lakshmisri.com

NAGPUR

First Floor, HRM Design Space,
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Nagpur - 440033
Phone : +91-712-2959038/2959048
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