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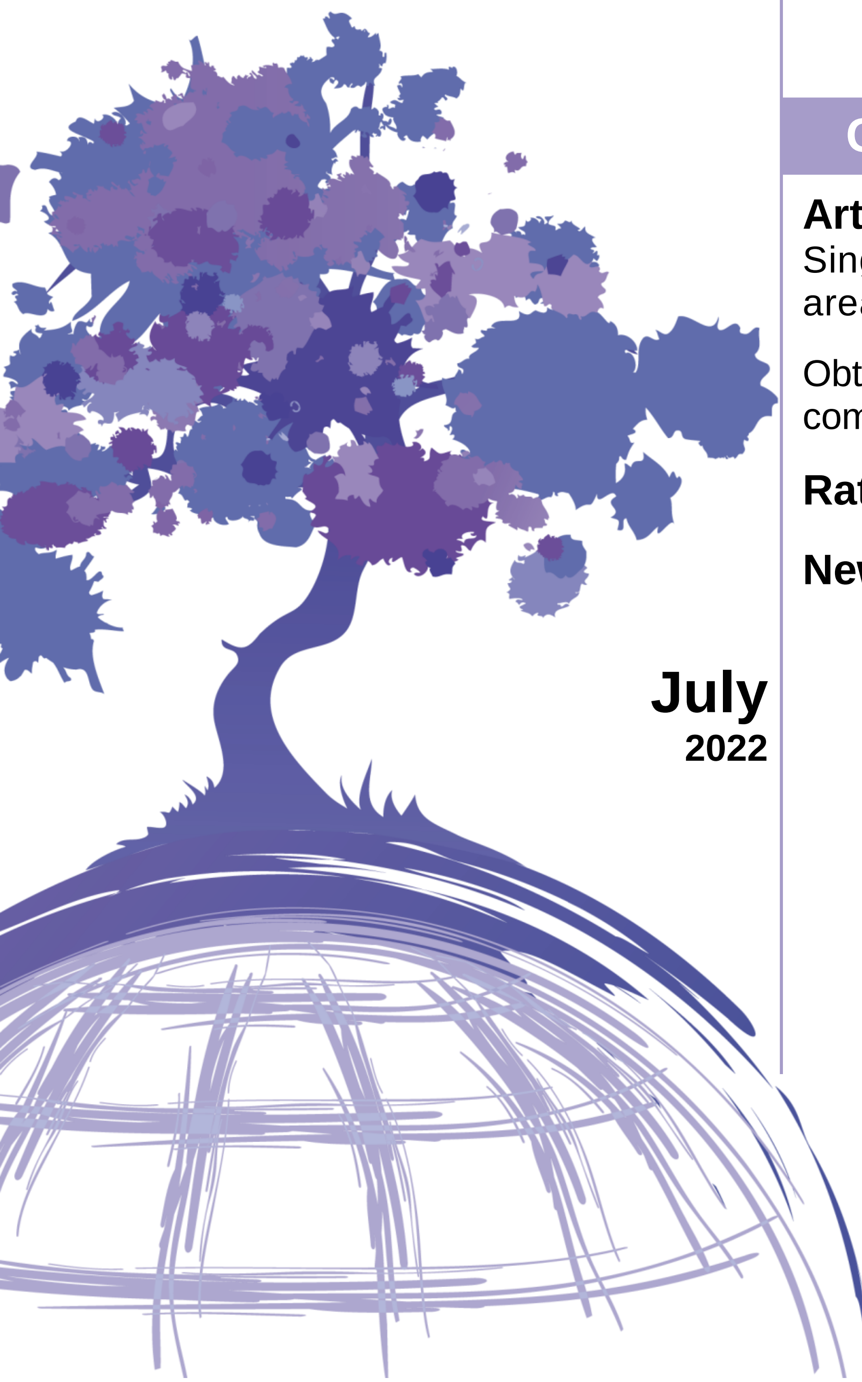

July
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Single colour trademarks – A 'grey' area

By **Anushka Verma and R. Rajalakshmi**

The trademark regime in India provides broad protection and covers unconventional marks such as shape marks, sound marks, image marks, combination of colours, etc. However, when it comes to single colour marks, the regime is far from colourful.

The dilemma

The Trade Marks Act, 1999 allows a '*device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or* ***combination of colours*** *or any combination thereof*' to be protected as trademarks. A literal interpretation of the statutory provisions would lead to a straightforward conclusion, that a single colour cannot be applied as a trademark. However, this may often contradict with another basic tenet of trademarks law, that when a mark functions as a source-identifier for the consumers, the same should be protected under law.

In this case, what happens if a mark such as a red-sole shoe, or a purple chocolate packaging brings to the consumers' minds a particular product? The aforementioned colours in relation to the goods would have brought to the readers recollection two distinct products- the famed Louboutin shoes, and the well-loved Cadbury chocolates. In such a case, the application of a single colour on the goods is serving a source-identifying function. Under the provisions of law, should such marks be granted protection?

But again, another argument raised against the protection of single colour marks is based on the 'Colour Depletion' theory, which states that if single colours are protected, it would eventually lead to a monopolization of all basic colours. Thereafter, any new entity which applies the colour in complete *bona fide* on their products/services shall be liable of infringement. This will lead to severe anti-competitive effects, and will thwart the purpose of the trademarks law, which is to recognize distinctive marks.

The judicial trends

The Indian judiciary has offered dissenting views on the question of single colour marks. A discussion on the protection of single-colour marks will be remiss without the mention of the red-sole Christian Louboutin shoes, which (in addition to the soles) had painted the IP fraternity red, with several judicial pronouncements on the validity of its red soles as trademarks.

In *Christian Louboutin* v. *Pawan Kumar*[1], the red-soles were recognised as a well-known trademark due to their long and extensive use in India and across the world. Thereafter, in *Christian Louboutin* v. *Abubaker*[2]*,* the previous decision was overturned on the ground, *inter alia*, that the provision in the Act for 'a combination of colours is *sine qua non*'. Finally, in *Christian Louboutin* v. *Ashish Bansal*[3]*,* the Court ordered in favour of Louboutin, holding that they have been successful in establishing that the defendants' use of the red sole amounted to an infringement,

[1] 2018 (73) PTC 403 (Del).
[2] 2018 (74) PTC 301 (Del).
[3] 2018 (75) PTC 353 (Del).

and free-riding on Louboutin's goodwill and reputation. In reaching this decision, the Court relied on factors indicating that Louboutin red-sole shoes have acquired distinctiveness due to their long and continuous use.

The red-soled Louboutins have traversed across the world seeking trademark registration, with some hits and misses. As recently as April 2022, a Japanese Court adjudicated that the presence of a brand in Japan for over 20 years was still insufficient to show that it had acquired secondary meaning in the public. This was partly due to the fact that the brand is a high-end luxury brand which is only affordable to a few people. Therefore, not enough people in Japan can identify the red-soles as source indicators of the brand. On the other hand, in 2012, a 2nd District Court in USA recognised the red-soles as distinctive and capable of distinguishing the Louboutin shoes from any other vendors'. The mark was protected based on its acquired distinctives in the market. Similarly, in 2018, Louboutin was successful in enforcing its rights over the red sole in European Union, as it was ascertained that the mark has become attributable to the brand.

Common link: way forward

Upon a perusal of the judicial trends across the world, one common link that can be drawn is the assessment of the acquired distinctiveness of the mark. Indeed, the aforementioned dilemma can be dealt with by answering one question: ***does the use of the single colour on the product/service carry a recall value for the consumers***?

The Manual of Trade Marks Law and Practice also recognises the position that a single colour may be registerable as a trade mark '*if it is very unusual and peculiar in a trade and is recognized by traders and consumers alike that it serves as a badge of origin for that class of goods*.' This means that the courts will *firstly,* have to purposively interpret the statute to not limit the protection of trademarks to 'combination of colours' only, and *secondly,* undertake an in-depth analysis of whether the single colour mark has acquired distinctiveness through its continuous use.

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Obtaining statutory licence requires strict compliance with Copyright Rules

By **Gursimran Narula and Godhuli Nanda**

Introduction

Over the years, radio broadcasters and copyright owners i.e., music producers have been in a tussle before various courts and tribunals on various issues pertaining to music licensing. In the past year, radio broadcasters and music producers have been at crossroads with each other regarding compliance with certain rules prescribed for obtaining a statutory licence. In this regard, a radio broadcaster i.e., Next Radio Limited approached the Madras High Court challenging the constitutionality of Rule 29(4) of the Copyright Rules, 2013 ('**Copyright Rules**'). The said rule specifically pertains to the implementation of Section 31D of the Copyright Act, 1957 ('**Copyright Act**') which states that the broadcaster is required to send a prior notice of intention to the copyright owner for obtaining a statutory licence for broadcast of copyright protected musical works.

The Rule 29(1) of the Copyright Rules further provides an exception whereby the broadcaster has a window of twenty-four hours after the broadcast for sending the said notice in unforeseen circumstances. The radio broadcaster also contested that the time frame given by Rule 29(1) of the Copyright Rules is onerous, particularly for 'on-demand' music programmes which are unplanned. In an interim order[4] dated 2 August 2021 the Division Bench of the Madras High Court relaxed the said time period to fifteen days from the prescribed twenty-four hours. Further, this interim order was confined to the instant radio broadcaster and the specific copyright works intended to be exploited. On appeal the Supreme Court on 27 September 2021[5] set aside the said interim order passed by the Madras High Court on the basis that that timeline extension by the Madras High Court was an exercise of judicial re-drafting which was unwarranted, at the interlocutory stage. Soon after, the Delhi High Court was also faced with adjudicating various copyright infringement suits wherein the copyright owners alleged non-compliance to Rule 29(4)(i),(j) and (k) by the radio broadcasters while applying for the statutory licence and thus sought injunction against the radio broadcasters seeking to restrain them from broadcasting/communicating to the public and otherwise exploiting the copyright works through the FM radio channels/stations and infringing the copyright works. The Delhi High Court in its interim order[6] dated 9 November 2021 followed a literal interpretation of Rule 29 in the light of the Supreme Court ruling and held that it was necessary for the radio broadcasters to send the prior notice of intent to the copyright owner within twenty-four hours of the broadcast along with fulfilment of other conditions given under various sub-clauses of Rule 29. Accordingly, the Delhi High Court held that a *prima facie* case of infringement is made out and accordingly temporarily restrained the radio broadcaster from broadcasting/communicating to the public and/or otherwise exploiting the copyright works through the FM radio channels/stations without complying with Rule 29, especially, with Rule 29(4)(i)(j) and (k) of the Copyright Rules.

Recently, the Division Bench of the Madras High Court delivered the final judgement[7] dated 20 April 2022 in the *Next Radio* case wherein the Court upheld the constitutionality of the Rule 29(4). The present article examines the final judgment of the Madras High Court and traces its implications for statutory licensing regime in India.

Statutory licence for broadcast of musical works and sound recordings

Broadly the Copyright Act provides for two kinds of licensing arrangements: (i) voluntary licence and (ii) involuntary licence. While the voluntary licence is a mutually agreed arrangement between the parties, the involuntary licence is sanctioned to a licensee in certain specific situations where the statute does not envisage the licensee to be engaged in a tedious negotiation with the licensor. The Copyright Act further classifies involuntary licences into

[4] *Next Radio Limited* v. *Union of India* - 2021 SCC OnLine Mad 5607

[5] *Saregama India Limited* v. *Next Radio Limited and Others* - (2022) 1 SCC 701.

[6] *Super Cassettes Industries Pvt. Ltd.* v. *Music Broadcast Limited & Ors*. - 2021 SCC OnLine Del 4900.

[7] *Next Radio Limited* v. *Union of India Through the Secretary Department for Promotion of Industry and Internal Trade & Ors.* - 2022 SCC OnLine Mad 1758.

compulsory licence and statutory licence. A compulsory licence is issued by the Commercial Court when it is satisfied that the copyright owner is withholding communication of the copyrighted work from the public. Whereas the statutory licence is obtained by the licensee based on the fulfilment of certain conditions laid down under Section 31D of the Copyright Act.

Section 31D of the Copyright Act specifically deals with statutory licence for broadcasting of literary and musical works and sound recordings. The said provision provides five mandatory requirements to be fulfilled by the broadcaster before communicating the copyright protected work to the public, by way of broadcasting. These requirements include: i) A prior notice to be sent by the broadcaster to the copyright owner stating its intention to broadcast the copyright protected work, mentioning the duration and territorial coverage of the broadcast; ii) A royalty payment to be paid by the broadcaster to the copyright owner as decided by the Commercial Court; iii) The names of the authors and the principal performers of the work must be communicated to the public with the broadcast; iv) No fresh alteration to any literary or musical work to be done, which is not technical in nature and necessary for purpose of broadcasting, other than shortening the work for convenience of broadcast; and v) The broadcaster shall maintain all such records, books of account, and render to the Copyright Owner such reports and accounts for inspection. Further, Section 78 of the Copyright Act provides for rule-making power of the Central Government whereby clause (1) of Section 78, provides for a general rule making power of the Central Government and clause (2) of Section 78, provides for specific rule making power of the Central Government. Clause (2)(c) of Section 78 further includes a sub-clause (CD) which deals with the Central Government's power to make rules for implementing statutory licensing under Section 31D of the Copyright Act. The said sub-clause (CD) specifies that the rules may be made only to prescribe the 'manner' in which prior notice may be given. Hence, Section 31D and Section 78 together act as enabling provisions for implementation of Rule 29 of the Copyright Rules.

The radio broadcaster's grievance

In this case, the Radio Broadcaster argued that the scope of Section 31D of the Copyright Act is limited to intimating the copyright owners about their intention to broadcast the copyright protected work, along with the duration and territorial coverage of the broadcast. Whereas the Rule 29(4) of the Copyright Rules goes beyond the scope of Section 31D of the Copyright Act, as it puts an onus on the broadcasters to provide additional details of the work. The radio broadcaster specifically resisted the strict application of Rule 29(4)(c), (d), (e), (f) and (j) which requires the Broadcaster to mention in the prior notice the work proposed to be communicated by broadcasting; the details of year of publication of such works; name, address and nationality of the owner of the copyright in such works; names of authors and principal performers of such works, and details of time slots, duration and period of the programme in which such works are included. The radio broadcaster further expressed difficulty in supplying specific time details in the prior notice for songs played/performed 'on-demand of the viewer' within period of twenty-four hours of the broadcast. The radio broadcaster sought relaxation in the time period of twenty-four hours for sending the notice of intention to the copyright owners subsequent to the broadcast. The radio broadcaster placed reliance on existing voluntary licence arrangements whereby as a matter of practice broadcasting details were being shared with the copyright owners on monthly basis. Further, it was argued by the radio broadcaster that the rule making power of the Central Government is limited to the 'manner' in which the notice is to be sent and does not extend to prescribe the 'conditions' such as specific time details.

Analysis by the Court

The Court rejected the challenge raised by the Radio Broadcaster with regards to conflict between the Copyright Rules and the Copyright Act noting that the scheme of the statutory licence envisioned by the Copyright Act and the Copyright Rules aims to strike a balance between rights of copyright owners and the broadcasters. The Court observed that Section 31D requires mandatory requirement of prior notice to be sent to the copyright owners and the Copyright Rules prescribe the manner in which the notice is to be given. With regards to Rule 29(4) of the Copyright Rules, the Court noted that the said rule requires certain details to be furnished in the notice. For example, sub-clause (c) and (d) of the said rules require identification of the work and year of publication of the work which are merely basic information and cannot be said to be contrary to Section 31D. On the same lines, sub-clause (e) and (f) of Rule 29 of the Copyright Rules relate to details of the copyright owner and authors respectively which are again consequential information to governing provision and thus it was held that there is no conflict between the Rule 29(4) of the Copyright Rules and Section 31D of the Copyright Act. Further, with respect to Rule 29(4)(j) of the Copyright Rules, the Court noted that the said provision requires details of the time slots, duration and period of the propagation which are capable of being shared for pre-planned programmes. However, for unplanned programmes, the Broadcasters may rely upon Rule 29(1) which provides a compliance window of twenty-four hours after the broadcast. The Division Bench held that clause (2) of Section 78 which provides specific rule making power for Section 31D does not limit the general rule making power of the Central Government under clause (1) of the Section 78. Contrary to the arguments of the radio broadcaster, it was held by the Court that the Central Government can make any rule for the purposes of the Act and the said rule cannot be held as *ultra vires* when the rule making power was exercised as per the bounds of Section 78. Lastly, the Court observed that the radio broadcaster made no case for violation of any of their fundamental rights due to the Rule 29(4) of the Copyright Rules, rather the compliance of the said rules ensures that they could broadcast the copyrighted works.

Implications for statutory licensing

The provision of statutory licence under the Copyright Act has opened an avenue for the broadcasters desirous to broadcast copyright protected works without being compelled to enter into tedious negotiations with the copyright owners. The statutory licence ensures a win-win situation for the copyright owners and the broadcasters whereby the broadcasters can secure a licence by fulfilling five-fold conditions stipulated under the Section 31D of the Copyright Act. Thus, the strict compliance to Rule 29 of the Copyright Rules as prescribed by the Delhi High Court in *Super Cassettes* case[8], has now been reemphasised by the Madras High Court in *Next Radio* case[9]. The judgement of the Madras High Court imparts clarity on implementation of the statutory licences in India.

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[8] Supra 3.
[9] Supra 4.

Ratio decidendi

Sale of existing stock of alleged infringing goods – Appeal when maintainable against order passed in CPC Section 151 application

The Delhi High Court has rejected the preliminary objection in respect of maintainability of appeal against the order passed in an application under Section 151 of the Civil Procedure Code for the relief of selling the existing stock of alleged infringing goods. The Court in this regard noted that while the prayer for sale of existing stock was made in an application under Section 151 of CPC, the decision thereon was rendered as a part of the order under Order 39 Rule 4 of the CPC, thus treating the said relief as an ancillary and/or alternate interim relief. It noted that Order 43 Rule 1(r) of CPC provided that an appeal shall lie from an order under Order 39 Rules 1, 2 and 4.

Further, allowing the sale of the existing stock of the alleged infringing drugs, the Court noted that the subject product was a pain reliever and a 'Schedule-H' drug and there was no dispute on the quality of the Appellant's (Defendant's in original suit) product. Relying upon various precedents, the Court was of the view that even the public interest would be sub-served if the product of the Appellant was allowed to be sold in the market. The Appellant was, however, directed to file the entire account of sales of the existing stock sold from various locations, with dates of sales. [*Alkem Laboratories Ltd.* v. *Laborate Pharmaceuticals India Ltd.* – Judgement dated 17 June 2022 in FAO (COMM) 94/2022, Delhi High Court]

Injunction necessarily follows where infringement is established – Honest and concurrent use is no defence

The Delhi High Court has held that where a case of infringement is made out, an injunction has necessarily to follow, and that there is no defence available to the defendant to urge that the user, by the defendant, of the allegedly infringing mark, was honest and concurrent. The Court noted that honest and concurrent user by the defendant, of the infringing trademark is not statutorily envisaged as a ground on which the plaintiff, whose marks have been infringed, can be denied an injunction. It also noted that Section 135(1) read with Section 28(1) of the Trademarks Act 1999 guarantee the plaintiff of such protection. On the facts of the case, the Court observed that the defendant had no right to use the mark which in respect of its dominant part was identical to plaintiff's mark 'KEI'.

Further, observing that the marks and the rival goods were similar, the Court opined that electrical fans, geysers, and water immersion rods, in respect of which defendants were using the mark were similar to the goods (electric wires and cables, etc.) in respect of which the plaintiff's word mark and the device mark were registered. According to the Court, both fell within the ambit of the expression 'other kinds of electrical and electronic instruments' as contained in the registration granted to the plaintiff and even otherwise, 'similar goods' within the meaning of Section 29(2) of the Trademarks Act, 1999. Finding *prima facie* case of infringement, the Court observed that the plaintiff had not only priority of registration but also priority of user *vis-à-vis* the defendants. It restrained the defendants from using the impugned mark in relation to subject goods or instruments. [*KEI Industries Ltd.* v. *Raman Kwatra* – Judgement dated 17 May 2022 in CS(COMM) 9/2021, Delhi High Court]

Producer's copyright in cinematograph films extends to dubbing rights – Separate and independent right exists in remade film

The Delhi High Court has held that owners of copyright in a cinematographic work will have the right to both sub-title and dub their work. The Court was dealing with the question as to whether dubbing the Telugu film (remake of original Malayalam film) in Hindi by the defendant constituted an infringement of the rights of the plaintiff (who himself had received remaking and dubbing rights from the original maker of the film in Malayalam) under the Copyright Act, 1957.

The Court vacated its earlier *ex-parte* injunction order against the defendant which barred them from releasing the Hindi-dubbed version of its Telugu remake of the Malayalam film. It observed that the plaintiff, no doubt, had a right to remake the Malayalam film in the Hindi language as well as dub the same or the new film in any language, however, the defendant had admittedly dubbed the remade Telugu film in Hindi, which does not *prima facie* infringe the plaintiff's right.

While it was the case of the Plaintiff that only restricted rights were assigned to the Defendant No. 1, i.e., to remake and dub the Malayalam film in Telugu language only and it did not include the right to dub in any language, the case of the Defendants was that there subsisted a separate and independent copyright in the remade Telugu film and Defendant No. 1 was the owner of that copyright having the right to exploit the film in all formats, including dubbing the same in any language.

The Court held that under the provisions of Section 14(a)(iv), the author of a work has a right to make a cinematograph film and Section 14(d) provides the rights that the author would have in the said film which *inter alia* include the right to communicate the film to the public. Citing the case of *Thiagarajan Kumararaja* v. *Capital Film Works (India) Pvt. Ltd.*, the Court reiterated that dubbing would fall within the ambit of the expression 'communicating to the public' while interpreting the expression 'otherwise enjoyed' in Section 2(ff) of the Act. [*JA Entertainment Pvt Ltd* v. *MS Sithara Entertainment & Ors.* – Judgement dated 11 July 2022 in CS(COMM) 191/2022, Delhi High Court]

Patents – Amendment to claims before grant of patent to be construed liberally – Court allows amendment from 'product by process' to 'process' claim

The Delhi High Court has observed that amendments to a patent specification or claims prior to the grant is ought to be construed liberally. The Court in this regard took note of the Ayyangar Committee Report which intended to give broader and wider permissibility for amendment of claims and specification prior to the grant and restrict the same post the grant and advertisement thereof. It was hence of the view that if the standard as contemplated by the Ayyangar Committee Report is applied to Section 59 of the Patents Act, 1970, amendments to a patent specification or claims prior to the grant ought to be construed more liberally rather than narrowly.

The Court also observed that the amendment in the present case of the claims was by disclaiming the product portion of the 'product by process' claims, in view of the objections raised by the Patent Office itself. Holding as incorrect the argument of the Respondent that the 'process' was originally disclaimed, the Court noted that the objection of the Patent Office itself was that there was no clarity as to whether the claim was for a product or for a process.

The High Court in this regard also stated that so long as the invention is disclosed in the specification and the claims are being restricted to the disclosures already made in the specification, the amendment ought not be rejected, especially, at the stage of examination prior to grant. Considering the facts of the case, the Court observed that the petitioner was in fact narrowing the scope of the claims and not expanding the same, and thus the amended claims satisfied the conditions of Section 59(1). [*Nippon A&L Inc.* v. *Controller of Patents* – Judgement dated 5 July 2022 in C.A.(COMM.IPD-PAT) 11/2022, Delhi High Court]

News Nuggets

Patents – Post-grant oppositions are to be decided in an expeditious manner

Observing that as per the legislative scheme the post-grant oppositions must be decided in an expeditious manner, the Delhi High Court has stated that there is no scope for parties being given repeated opportunities to file affidavits in evidence, documents, additional documents, etc. The Court was of the view that the Patent Office and the parties must strictly adhere to the scheme of the Patents Act, 1970 and the Patent Rules, 2003. The High Court in this regard noted that from the date of the grant of the patent, the intention of the legislature is to ensure that the post grant opposition is filed within a period of one year and within 12 to 18 months thereafter, the Patent Office is to conclude the proceedings in the post-grant opposition. Further, it also directed the Controller General of Patents, Designs and Trade Marks (CGPDTM) to ensure that the names of the members constituting the Opposition Board are clearly mentioned on the cover page and the recommendations are duly signed by the members of the Opposition Board. The Court in the case *Novo Nordisk A S* v. *Union of India* [Judgement dated 5 July 2022] also reiterated that the opponent is given an option of filing the evidence and Rule 57 and that the same is not mandatory.

Delay in filing written statements when not condonable

Observing that the delay in filing of the written statement can be condoned by the Court 'for reasons to be recorded in writing', the Delhi High Court has noted that such reasons cannot be presumed by the Court but are to be provided by the defendants. The Court in this regard was of the view that the defendant cannot take its own sweet time to supply such reasons to the Court and that the Court is not to await endlessly for the same. Dismissing the appeal, the Court in *3M Company* v. *Vikas Sinha* [Decision dated 5 July 2022] observed that the appellants, already having been warned that their delayed written statement would not come on record for there being no application seeking condonation of delay in filing of the same, were not expected to await the return of the written statement by the Registry of the Court.

Non-filing of response to FER in stipulated time when condonable

In a case involving non-filing of the reply to the First Examination Report (FER) within the stipulated time, where the applications were thus 'deemed to have been abandoned', the Delhi High Court, exercising its writ jurisdiction, has directed the Patent Office to take on record the response to the FER. The High Court in this regard observed that the judicial opinion in respect of responses to FER or other deadlines suggested that if the applicant did not have an intention to abandon and if the Court is convinced that there was a mistake of the patent agent and the applicant is able to establish full diligence, the Court ought to be liberal in its approach. Observing that the mistake of the patent agent would be similar to the mistake of an advocate, the Court reiterated the position (in respect of mistake by advocate) that the litigants ought not to suffer. The Court in *European Union* v. *Union of India* [Order dated 31 May 2022] also noted that the applicant had no intention to abandon the application and had in fact taken all measures possible to prosecute the applications.

Trademarks – Word 'Super' is descriptive and laudatory

The Division Bench of the Delhi High Court has upheld the *prima facie* decision of the Single Judge that Dabur's mark -Dabur Baby Super Pants and packaging does not infringe Soothe's trademarks ('Super Cutesters', 'Super Cute's' and 'Super Cutez') and also does not have the effect of passing off their goods as those of Soothe. The rivals marks were being used for same goods – baby diapers. The Bench in this regard upheld the view that the word 'Super' is descriptive and laudatory. It also noted that different companies were using the word 'Super' in the same trade and in respect of several other goods and services, and that there was no other similarity in packaging of both the products. The Court in *Soothe Healthcare Private Limited* v. *Dabur India Limited* [Judgement dated 11 July 2022] also observed that 'Super' was not a separately registered mark and that the plaintiff cannot *prima facie* claim that the word 'Super' had acquired a secondary meaning or a distinctive character when used in a particular product of Soothe, i.e., diapers.

Word 'Healthskool' is distinctive enough for registration in Class 10

The Delhi High Court has allowed an appeal against the decision of the Senior Examiner rejecting the application for registration of the mark 'Healthskool' in Class 10. The Senior Examiner had rejected the application under Section 9(1)(b) of the Trademarks Act on the ground that the mark was descriptive and not distinctive enough as it designates the intended purpose, value, geographical origin, etc., of the goods and services applied for. However, while taking note of the general rules for distinctiveness, the Court in *Disruptive Health Solutions Private Limited* v. *Registrar of Trade Marks* [Order dated 8 July 2022] opined that the mark was distinctive enough to proceed for advertisement. It held that just because some portion of the mark may have some reference or indication as to the products or services intended for, the same may not be liable to be rejected straightaway.

It was also held that the merits of the marks would have to be considered along with the extent of usage and other registrations.

Domain Name Registrars to create mechanism for IP owners to seek cancellation of infringing domain names

The Delhi High Court has opined that time has come for Domain Name Registrars (DNRs) to create a mechanism by which any trademark owner who has an objection to the registration granted to any domain name, can approach the said DNR and seek cancellation/transfer of the said domain name. The Court in its decision dated 13 July 2022 [*Snapdeal Private Limited* v. *Godaddycom Llc*] also stated that the same ought to be fairly considered through the mechanism which ought to be independent and impartial, for e.g., through an Ombudsman, and if the cancellation/suspension/transfer as sought is not agreed to, then the IP owner can avail of its remedies in accordance with law. The Court in its interim order also stated that there ought to be a mechanism where the abuse policy is not merely dealing with suspension/locking but is able to cancel/transfer the infringing domain names.

Facebook, a well-known mark – Court permanently restrains use of 'Facebake' and 'Facecake'

While awarding nominal damages, the Delhi High Court has permanently restrained the defendants from using the marks 'facebake' and 'facecake'. The Court noted that though there was some distinction between the marks of the plaintiff ('Facebook') and of the defendants, the overall visual representation adopted by the defendants depicted the *mala fide* intent of the defendants in obtaining unfair advantage by use of the mark similar to that of the plaintiff, leading also to dilution of the plaintiff's mark. It also held that the plaintiff in *Meta Platforms, Inc.* v. *Noufel Malol* [Order dated 6 July 2022] was able to make the test as set out in Section 11(6) and Section 11(7) of the Trademarks Act as also by the Court in *Tata Sons* for it to be declared as a 'well-known trade mark' as defined under Section 2(1)(zg) of the Act.

Trademark disparagement – Defendant to convincingly show correctness/truth in advertisement

The Division Bench of the Bombay High Court has upheld the interim order passed by the Single Judge in a case of alleged disparagement of trademarks in specific advertisements of soaps of the defendant/appellant. The Court in this regard noted that defendant could not convincingly show the correctness (or 'truth') of even the solitary factor on which its entire advertisement campaign hinged, *viz.,* pH value in soaps. It observed that the defendant could not show the correctness of its claim that pH values related to anything 'safe' or 'ideal' or 'unsafe' or 'not ideal' or that the pH values affected 'sensitive' skin or that there was some universal skin, sensitive or otherwise. The appellant/defendant in this appeal *USV Private Limited* v. *Hindustan Unilever Ltd.* [Judgement dated 13 July 2022] had pleaded truth in the advertisement which showed that pH of 5.5 was ideal for skin and that the products of the plaintiff had higher pH which was bad for sensitive skin.

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