

May 2023 / Issue-140



IPR

# amicus

An e-newsletter from  
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# Article

## De-blurring Section 59 of the Indian Patents Act 1970

*By Aashmeen Kaur, Eeshita Das, T. Srinivasan &  
Dr. Malathi Lakshmikumar*

The article in this issue of IPR Amicus examines a recent decision of the Delhi High Court, where the High Court has redefined the boundaries of permissible claim amendments for overcoming the objections on non-patentability especially Section 3(i) of the Patents Act, 1970, without jeopardizing the requirements of Section 59. The primary focus of this article is on the interpretation of Section 3(i) and Section 59 of the Act as provided by the High Court. Considering the facts of the case and the High Court's analysis of claim amendments, the authors conclude by stating that the Applicants can file claim amendments to overcome the non-patentability objections, such as Section 3(i) per the Indian Patent Law, keeping in view the boundaries of Section 58 and 59. They also note that this decision also clarifies that product claims cannot and must not be objected under Section 3(i) of the Act, since the said Section only refers to claims directed to a process.



# De-blurring Section 59 of the Indian Patents Act 1970

By Aashmeen Kaur, Eeshita Das, T. Srinivasan & Dr. Malathi Lakshmikumaran

## Introduction

This article examines the decision made by Hon'ble High Court of Delhi ('**High Court**') on an appeal<sup>1</sup> filed under Section 117A of the Patents Act, 1970 ('**Act**'). The appeal was filed by *Societe Des Produits Nestle Sa* ('**Appellant**') seeking to set aside an order passed by the Controller of Patents and Design ('**Respondent**') refusing the grant of the Appellant's Patent Application for lacking inventive step and for not being patentable under Section 3(i), Section 3(e), and Section 59 of the Act. The High Court after considering the facts of the case, decided that the assessment of the claimed invention by the Respondent was erroneous and directed that the Patent Application may proceed for a grant. The High Court has redefined the boundaries of permissible claim amendments for overcoming the objections on non-patentability especially Section 3(i) of the Act without jeopardizing the requirements of Section 59 of the Act. Therefore, the primary focus of this article is on the interpretation of Section 3(i) and Section 59 of the Act provided by the High Court.

## Facts of the case

The Appellant filed a Patent Application titled '*Composition for use in the Prophylaxis of Allergic Disease*' bearing an application number 201817040811 ('**Application**'), which is a National Phase Application arising out of PCT international Application No. PCT/EP2017/055680. A First Examination Report ('**FER**') was issued, wherein the Respondent objected to the lack of novelty and inventive step under Sections 2(1)(j) and 2(1)(ja) and non-patentability under Sections 3(e) and 3(i) of the Patents Act. The Appellant filed a response to the FER along with the amended claims, post which the Respondent issued a Hearing Notice, reiterating the objections raised in the FER. A hearing was conducted, and thereafter written submissions were filed by the Appellant.

The Respondent after reviewing the Appellant's written submission and claim amendments refused to grant the Application under Sections 2(1)(ja) and Section 3 of the Act. In addition, the Respondent cited Section 59 of the Act as a ground for refusing the application. With respect to the objection under

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<sup>1</sup> C.A.(COMM.IPD-PAT) 22/2022, I.A. 5588/2022 (stay), I.A. 5589/2022 (O-XI R-1(4) of CPC) and I.A. 16487/2022 (of waiver of costs)

Section 3(i) of the Act, the explanation provided by the Respondent was that the Appellant defined a method for 'treatment of human body' and the claims were therefore, not patentable, specifically stating that subject-matter protected by the original claim was a 'composition, when used in treatment' and therefore contained both 'composition' and 'method features'. With respect to Section 59 of the Act, the Respondent alleged that the amended claims filed by the Appellant were not permissible as they sought to confer greater scope of protection, in comparison to the originally filed claims, which Section 59 of the Act prohibits. The Respondent further alleged that the claims as originally filed conferred protection upon the compound only when it was in use so as to carry out the method of treatment, whereas the proposed amended claims would confer protection upon the composition whether or not it was in use and would therefore confer additional protection compared to the claims as originally filed. Thus, the Respondent asserted that the objection under Section 3(i) of the Act was maintained in view of the objection raised under Section 59 of the Act.

Aggrieved by the decision of the Respondent, the Appellant filed the appeal, seeking to set aside the refusal order issued by the respondent.

### ***The intersection between Section 59 and Section 3(i) of the Act***

While arguing the matter, the Appellant's counsel expressed that the as-filed claim 4, was directed towards a 'composition' and not towards a 'method of treatment', thus there was no change in the scope of the claims and the description. Secondly, the Appellant

submitted that the amendments in the claims were carried out to overcome the objections raised by the Patent Office in the FER and the Hearing Notice and the same were within the scope of the originally filed claims and therefore, permissible under Section 59 of the Act.

The counter arguments provided by the counsel for the Respondents were that the body of the claims filed in response to the FER recited: '*for use in the prophylaxis of allergic disease in an offspring of a mammalian subject, comprising administration of the composition to said subject pre-pregnancy and/or during pregnancy and/or during lactation*' thereby, defining medicinal use in terms of the method of treatment/prophylaxis, which is a non-patentable as per Section 3(i) of the Act.

With respect to the objection on claim amendments, the Respondents' counsel submitted that the claims were amended from being '*purpose-limited*' product claims to 'pure composition', expanding the scope of the original claims and thus, contravened Section 59 of the Act. The Respondent alleged that the claims submitted along the written submission after attending the hearing, were amended by the Appellant to omit the phrase '*for use...*' to overcome the objection under Section 3(i) of the Act raised in the Hearing Notice. The High Court examined the facts of the case and provided an independent analysis of Section 3(i) and Section 59 of the Patents Act.

### ***The High Court's analysis of Section 3(i) of the Act***

At the outset, the High Court established that as per Section 3(i) of the Act any claim directed towards a process for the

prophylaxis or prophylactic treatment is not patentable. The High Court then referred to the judicial order passed in ***University of Miami v. Controller of Patents***<sup>2</sup> and pointed out that in said case also, while dealing with the ground of rejection under Section 3(i) of the Act, the erstwhile Intellectual Property Appellate Board (IPAB) clarified that the mere use of expression 'treatment' in the claim does not render a claim falling under Section 3(i) of the Act. Similarly, the expression '*composition for the treatment*' is only a way of defining the composition and in no way the claimed composition can be a method performed by a physician for treatment of disease. The High Court also relied on the road map laid down by **Manual of Patent Office Practice and Procedure ('Manual')**<sup>3</sup>, which gives guidance for examination with respect to exclusion of medical, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment.

Considering the above, the High Court stated that the previously filed claims were in respect of a composition and not towards a process of prophylactic treatment. The High Court specified that the expression '*composition comprising .... directed towards treatment*' was used only for defining the composition and not directed towards a method of treatment. The High Court thus concluded that since the claims on record were directed to a composition for use in treatment, the same did not fall under the ambit of Section 3(i) of the Act. Thus, there was no merit in the

decision of the Respondent to refuse the application under Section 3(i) of the Act.

### ***The High Court's analysis of claim amendments.***

The High Court primarily acknowledged that the Appellant filed amended claims on account of an objection raised by the respondent under Section 3(i) of the Act, in the Hearing Notice, whereby the original scope of the claims stood expanded, as instead of being a purpose-related claim, it became a general claim over the composition, which became the basis for the Respondent to reject the patent Application under Section 59 of the Act. The Respondent had further taken issue to the fact that during the proceedings, the Appellant had resorted back to the purpose-limited composition claims similar to the claims submitted in response to the FER, citing that there is no provision in the Act which permits the courts to allow any amendment at the stage of appellate proceedings.

The High Court relied on the Act and several judicial orders to point of some fundamental aspect related to amendments of a Patent specification and carved out some important points while considering the instant case:

- 1. A request for amendment can be made even after the grant of patent.***

The High Court stressed upon the fact that there is no provision in the Act, which specifically bars the amendment of a patent specification at the appellate

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<sup>2</sup> OA/33/2015/PT/KOL - *University of Miami v. Controller of Patents*

<sup>3</sup> Manual of Patent Office Practice and Procedure ('Manual') issued by the office of the CGPDTM on 26th November 2019

stage. Sub-section 3 of Section 57 of the Act clearly indicated that an amendment can be made even after the grant of patent.

**2. *An amendment to the specification can be allowed in the proceedings before the High Court.***

The High Court relied on sub-section (1) of Section 58 of the Act and stated that the High Court can allow an amendment to the specification in a matter before the High Court at the stage of revocation of a patent. Accordingly, there is no specific bar for the amendment even at a subsequent stage. The only requirement under the Act is that the amendment has to fulfil the requirements under Section 59 of the Act and the amended claims are consistent with the earlier claims in the original specification.

**3. *The High Court has similar powers as those granted by Section 15 of the Act to the Controller.***

The High Court mentioned that as per Section 15 of the Act, a Controller has been given the power to require an application to be amended to his satisfaction. Therefore, it is understood that if the Controller has been given the power to direct an amendment to the patent Application, the High Court, which is sitting in appeal over the decision of the Controller, should also have similar powers to direct

the patent Applicant to amend claims to its satisfaction. The High Court also made a reference to the recent judgement of the Supreme Court in **Ramnath Exports Pvt. Ltd. v. Vinita Mehta & Anr, (2022)**<sup>4</sup> which clarified that an appeal is a continuation of the proceedings of the original court. A similar position was also held in the matter of **AGC Flat Glass Europe SA v. Anand Mahajan and Ors.**<sup>5</sup>, where a Single Judge of the High Court allowed amendments to the claims of a patent specification when an interim injunction application was being considered, so long as the amendment was in conformity with Section 58 and 59 of the Act.

In this view, the High Court stated that in an appeal considering the issue of the grant of a patent, the High Court is entitled to the same powers as those of the Controller, which includes the power to amend the patent application. Further, since the appellate proceedings are challenging the refusal of grant of a patent, questions of facts need to be re-examined comprehensively and therefore, a liberal view has to be taken with regard to amendment of claims. Therefore, the Appellant resorting back to the previously filed claims is fully covered under Section 59 of the Act. Moreover, as the objection because of which the amendment was filed had been set aside, it was in the interest of justice to allow the amendment at appellate stage.

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<sup>4</sup> Ramnath Exports Pvt. Ltd. v. Vinita Mehta & Anr, (2022) 7 SCC 678

<sup>5</sup> Order dated 10th September 2009, in CS(OS) 593/2007 titled AGC Flat Glass Europe SA v. Anand Mahajan and Ors

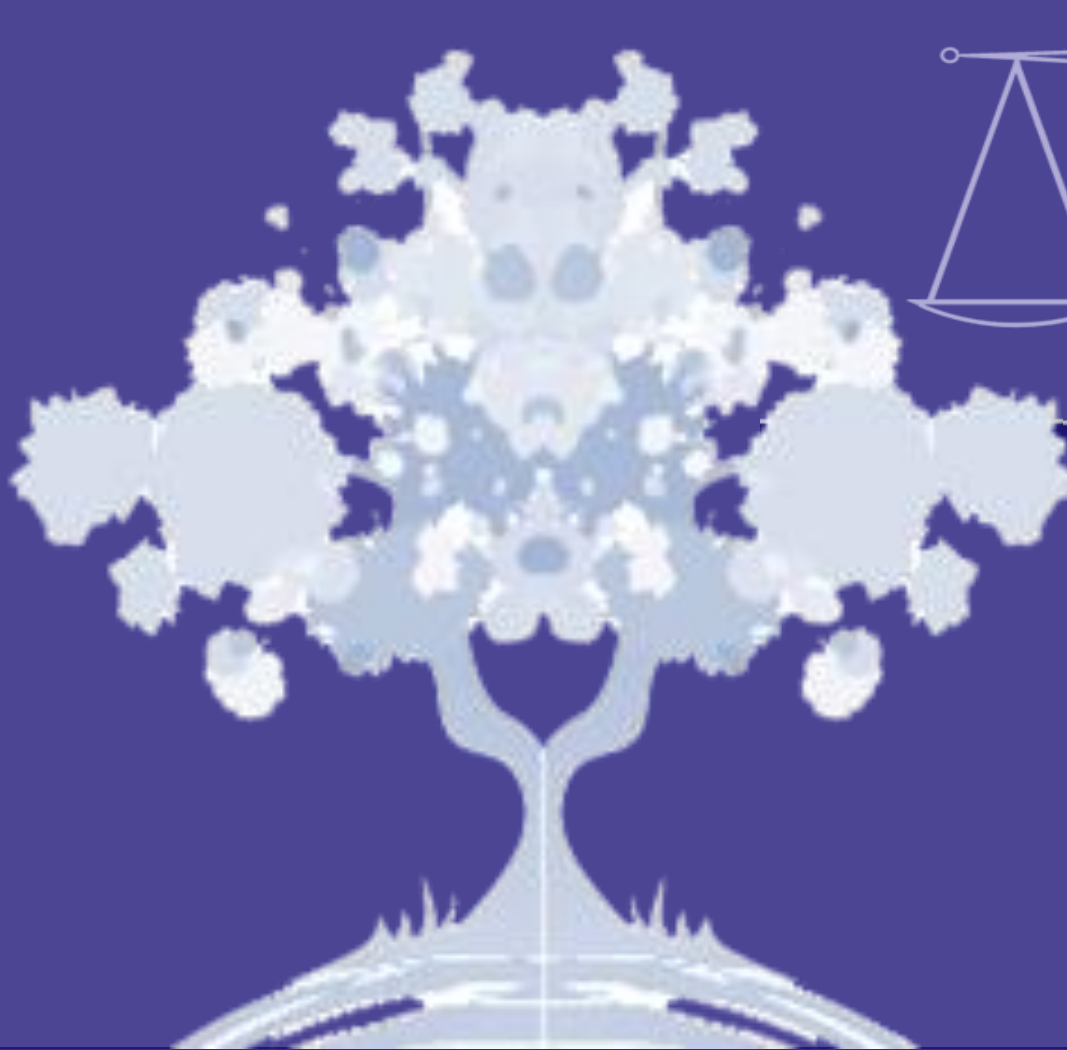
## Conclusion

Considering the High Court's decision, it is now clear that the Applicants can file claim amendments to overcome the non-patentability objections, such as Section 3(i) of the Act per the Indian Patent Law, keeping in view the boundaries of Section 58 and 59 of the Act. Further, this decision also clarifies that product

claims cannot and must not be objected under Section 3(i) of the Act, since the said Section only refers to claims directed to a process.

**[The authors are Patent Analyst, Senior Patent Analyst, Director and Executive Director, respectively, in IPR practice at Lakshmikumaran & Sridharan Attorneys]**





# Ratio Decidendi

- Copyrights – Original drawings used to industrially produce an article will fall under ‘artistic work’ and be entitled to copyright protection – Delhi High Court
- Trademark squatting would amount to ‘bad faith’ under Section 11(10)(ii) of the Trade Marks Act, 1999 – Delhi High Court
- Trademarks – Allied and cognate goods, even if falling under different Classes, cannot be held to be dissimilar goods for injunction – Delhi High Court
- Trademark ‘Street Armour’ infringes mark ‘Under Armour’, both used for sportswear – Word ‘Armour’ is neither descriptive nor common to trade – Delhi High Court
- Use of celebrity names, images for satire, parodies, news, etc. not falls foul to tort of infringement of right of publicity – Delhi High Court

## Copyrights – Original drawings used to industrially produce an article will fall under ‘artistic work’ and be entitled to copyright protection

In a dispute involving copyright in respect of their original drawings, the Delhi High Court has reiterated that even if the original drawings are used to industrially produce an article, they would continue to fall within the meaning of the artistic work defined under Section 2(c) of the Copyright Act, 1957 and would be entitled to the full period of copyright protection.

The High Court in this regard noted that the Division Bench of the Court in the case of *Microfibres Inc. v. Girdhar and Co. and Anr.* [2009 SCC OnLine Del 1647] had held that an original ‘artistic work’ is different from a ‘design’ and that the original drawings/ ‘artistic work’ can lead to a ‘design’. In other words, a ‘design’ may be derived from the original drawings.

The Defendant’s contention that the drawings of the Plaintiffs constituted ‘design capable of being registered’ under the Designs Act, 2000 and as the Plaintiff had already supplied more than 21,00,000 fastening sets and 50,00,000 elastic rail clips in various projects, no copyright subsisted in the drawings of the Plaintiffs as per Section 15(2) of the Copyright Act, 1957, was thus rejected by the Court.

The Court noted that a ‘design’ in respect of a finished product was yet to emerge in the present case, and therefore, no ‘design’

capable of registration under the Designs Act had come out on the basis of the Plaintiffs’ drawings. It also noted that the drawings of the Plaintiffs were relating to fastening systems, which are mere mechanical devices that had functional utility. The Court was of the view that by no stretch of imagination it could be said that the concerned drawings reflected a product, which, in its finished state, would have any visual appeal.

The High Court also rejected the contention of the Defendant that that once the drawings of the Plaintiffs got approval from the Ministry of Railways and were annexed to the approval letter, they became a part of the catalogue of the Ministry and any third party can make a bid based on the aforesaid drawings. The Court also found no merit in the submission of the Defendants that no copyright subsists in the drawings of the Plaintiffs since no registration was obtained in respect thereof. It, in this regard, noted that registration is not a prerequisite to seeking protection from infringement under the Copyright Act.

Granting interim injunction, the Court also burdened the Defendant with costs of INR 1,00,000 to be paid to the Plaintiffs. [*Pandrol Ltd and Anr. v. Patil Rail Infrastructure Pvt. Ltd. and Ors.* – Judgement dated 13 March 2023 in CS(COMM) No.602/2022, Delhi High Court]

## Trademark squatting would amount to ‘bad faith’ under Section 11(10)(ii) of the Trade Marks Act, 1999

The Delhi High Court has held that when plainly read, it is clear that the intent and purpose of Section 11(10)(ii) of the Trade Marks Act,

1999 is to disentitle registration of a mark, the request for registration of which is tainted by bad faith. The Court in this regard noted that though the provision is worded in a somewhat open-ended fashion, requiring the Registrar to, while registering a mark, 'take into consideration' the bad faith of the applicant, it does not expressly state that the existence of bad faith would disentitle the applicant to registration. In this regard, the Court observed that statutory provisions have to be interpreted in a purposive manner, and cannot be regarded as mere superfluity.

The Court further held that trademark squatting would certainly amount to 'bad faith' within the meaning of Section 11(10)(ii) of the Trade Marks Act, even though as an individual phenomenon it does not find especial mention in the Trade Marks Act.

Earlier, the Court observed that the act of the Respondent in registering the BPI SPORTS word mark, which, to his knowledge and awareness, was registered in the name of the Petitioner in the USA and in which the Petitioner had global repute, constituted 'trademark squatting'. It noted that the Respondent was the importer of the Petitioner, and it was in his capacity as such importer that the Respondent was actually using the mark BPI SPORTS which, later, the Respondent registered in its own favour, for identical goods. The Court was hence of the view that the case would fall within the scope of marks which are 'wrongly remaining on the register' within the meaning of Section 57(2) of the Trade Marks Act.

Directing removal of the impugned mark from the Register of Trademarks, the Court, in this case pertaining to Section 57 application by the Petitioner, also noted that since the Respondent

was absent in appearance and reply, the allegations must be treated as admitted. [*BPI Sports LLC v. Saurabh Gulati* – Judgement dated 27 April 2023 in C.O. (COMM.IPD-TM) 16/2021, Delhi High Court]

## Trademarks – Allied and cognate goods, even if falling under different Classes, cannot be held to be dissimilar goods for injunction

The Delhi High Court has held that *prima facie*, 'MONSOON HARVEST FARMS' of the Plaintiff and 'WINGREENS MONSOON HARVEST' of the Defendant, are deceptively similar to each other, and that the addition of the word 'WINGREENS' to the marks of the Defendant is not sufficient to bring about a distinction in the two marks.

In a case where the Plaintiff had registered its marks for edible oils, raw and unprocessed agricultural, horticultural products, and fresh fruits and vegetables etc., while the Defendant dealt in processed food items like millet-based nutrition bars, cookies, muesli etc., the High Court was of the *prima facie* view that the goods of the Plaintiff and the Defendant were allied and cognate products. The Court noted that the Plaintiff and the Defendant were under the food industry, and that the goods of the parties would be normally sold through the same supply chain to the same customers.

Relying on various precedents, the High Court also observed that due to the Plaintiff expanding into the selling of processed food items, which could be considered as a natural trade progression of its already existing field of business, *prima facie*, there would be

confusion in the mind of the average consumer who is likely to mistake the goods of the Defendant bearing the impugned mark with those of the Plaintiff or as originating from the Plaintiff.

The Court also rejected the contention of the Defendants that goods in question were dissimilar since they fell under different classes. It was of the view that the goods being allied and cognate goods, merely because they fell in different Classes for the purposes of grant of registration, they cannot be held to be dissimilar goods for the purposes of an injunction. The High Court, in this regard also held that once the goods of the Plaintiff and the Defendant are allied and cognate, the exception carved out in Section 34 of the Trade Marks Act, 1999 would not apply.

Finding that there was a *prima facie* case of infringement under Section 29(2)(b) of the Trade Marks Act and passing off against the Defendant, the Court restrained the Defendant from using the impugned mark. [*Preetendra Singh Aulakh v. Green Light Foods Pvt. Ltd.* – Judgement dated 2 May 2023 in CS(COMM) 509/2020, Delhi High Court]

## Trademark 'Street Armour' infringes mark 'Under Armour', both used for sportswear – Word 'Armour' is neither descriptive nor common to trade

The Delhi High Court has held that when viewed in entirety, the mark 'Street Armour' of the Defendant has to be regarded as *prima facie* infringing the mark 'Under Armour' of the Plaintiff within the

meaning of Section 29(2)(b) of the Trade Marks Act, 1999. The Court, in this respect, noted that there is every possibility of confusion, or at the very least, of a feeling that there could be an association between the two marks, more so as the marks were used for identical goods. It noted that the use, by the Defendant, of a closely similar manner of abbreviating its name as 'STRT ARMR', *vis-à-vis* Plaintiff's 'UNDR ARMR', use of similar font, and the use of almost imperceptibly small font size for 'STREET', would also fortify this impression. Further, relying on the Supreme Court decision in the case of *Amritdhara Pharmacy v. Satyadeo Gupta*, where the competing marks were 'AMRITDHARA' and 'LAXMANDHARA', the Court observed that an unwary purchaser of average intelligence and imperfect recollection, who has once purchased sportswear bearing the Plaintiff's UNDER ARMOUR would, on later coming across the Defendant's STREET ARMOUR, have a vague recollection that he had purchased a similar piece of sportswear on a previous occasion with a similar name.

The Court in this regard observed that word 'Armour' when used in the context of clothing, especially in the context of sportswear, cannot, by any stretch of imagination, be treated as descriptive in nature. It noted that Sportswear is not armour, nor is it armorial in nature. According to the Court, it might have been possible to advance an argument that the clothing in respect of which the mark 'ARMOUR' was being sought to be used was protective, and hence the mark was suggestive in nature. However, even here it noted that the sports apparel on which the Plaintiff's marks were used were not protective, and hence word 'ARMOUR' when used for such apparel, cannot be regarded even as suggestive.



Defendant's reliance of the dictionary meaning of word 'armour' (to mean special clothing), and hence the descriptive nature, was also rejected by the Court while it observed that the aspect of whether a particular mark is descriptive, or not, cannot be decided by referring to dictionaries, but by the test of common parlance. The High Court in this regard also rejected the contention that the initial provocation for use of the term 'UNDER ARMOUR', at the time when the said mark was initially coined, was relevant. It held that the nature of the use to which the mark is being put at this point of time, was to be seen.

Further, the Court also rejected the plea that the word 'Armour', was 'common to the trade'. Relying on Division Bench decision in the case of *Pankaj Goel v. Dabur India*, the Court observed that mere citing of a multitude of marks, which are available on the Register of trademarks and which include, as a part or as the whole thereof, 'ARMOUR', cannot make out a case of the mark being common to the trade. [*Under Armour, Inc. v. Aditya Birla Fashion & Retail Ltd.* – Judgement dated 20 April 2023 in CS(COMM) 41/2023, Delhi High Court]

## Use of celebrity names, images for satire, parodies, news, etc. not falls foul to tort of infringement of right of publicity

In an interesting case involving infringement of right of publicity, the Delhi High Court, after relying on number of foreign judgements, has held that use of celebrity names, images for the purposes of lampooning, satire, parodies, art, scholarship, music,

academics, news and other similar uses would be permissible as facets of the right of freedom of speech and expression under Article 19(1)(a) of the Constitution of India, and would not fall foul to the tort of infringement of the right of publicity. It may be noted that the Court also added that the right of publicity cannot be infringed merely on the basis of a celebrity being identified or the Defendant making commercial gain.

The High Court was hence of the view that the use of the name and/or the image of a celebrity along with data with regard to his on-field performances by the online fantasy sports (OFS) platforms is protected by the right to freedom of speech and expression under Article 19(1)(a) of the Constitution of India, and does not infringe the common law right of publicity. It also, in this regard, noted that protection under Article 19(1)(a) extends to commercial speech as well. The Court therefore held that even if the Defendants are using players' names, images and statistics for commercial gain, this would be protected under Article 19(1)(a). The High Court also noted that the Defendant did not use actual photographs of the players but used artwork of the players on its NFT enabled Digital Player Cards, contained creative elements that distinguish them from the actual image of the players in question.

Dismissing the application for interim injunction, the Court noted that violation of the right of publicity in India has to be considered on the touchstone of the common law wrong of passing off.

The Court further noted that OFS operators use information of all players available in public domain for the purposes of identification of the players for playing the game, and that this obviates any possibility of confusion that a particular OFS platform is being

endorsed by a particular player or has an association with a particular player. Regarding the availability of information in public domain, the Court also noted that the information which is available in public domain cannot be owned by anybody, including the players themselves, and therefore, such publicly available

information cannot be the subject matter of an exclusive license by the player in favour of a third party. [*Digital Collectibles Pte Ltd. v. Galactus Funware Technology Private Limited* – Judgement dated 26 April 2023 in CS(COMM) 108/2023, Delhi High Court]



# News Nuggets

- 'PhonePe' and 'PostPe' – No phonetic and structural similarity which would confuse the target consumer
- Goodwill or reputation of brand cannot be established on basis of how quickly it shows on Google search
- Filing of additional documents by Plaintiff when not permissible
- Trademarks – Higher degree of protection to 'Kind' family of marks
- Trademark – Deceptive similarity – Assertions in counter-statement by Plaintiff when can lead to denial of interim relief
- Trademarks – Prima facie case of infringement of mark 'Officer's Choice' by mark 'Green Choice'

## 'PhonePe' and 'PostPe' – No phonetic and structural similarity which would confuse the target consumer

The High Court of Bombay at Goa has held that there is no phonetic similarity between the two marks – 'PhonePe' of the Plaintiff and 'PostPe' of the Defendant, for the Plaintiff to claim that a strong *prima facie* case is made out to grant interim reliefs. Rejecting the interim relief, the Court agreed with the findings of an earlier decision of Delhi High Court (involving PhonePe and BharatPe) that the claim of the Plaintiff that the suffix 'Pe' has acquired distinctiveness and secondary meaning to the extent that the consuming public now invariably associates the same with only the services provided by the Plaintiff, is a matter for trial. It also observed that when the remaining parts of the marks i.e., 'Phone' and 'post' are compared, there is no *prima facie* case made out by the Plaintiff about similarity between the two. The Court in *PhonePe Private Limited v. Resilient Innovations Private Limited* [Order dated 6 April 2023 in Commercial IP Suit No. 160 of 2022] further noted that the words, 'phone' and 'post' have distinct dictionary meanings with no possibility of confusion between the two. It also observed that there was *prima facie* distinction between the nature of services provided by the rival parties.

## Goodwill or reputation of brand cannot be established on basis of how quickly it shows on Google search

The Delhi High Court has held that the mere fact that the particular result may pop up on a Google search being done of a particular search thread cannot, without any other data, suffice to establish good will or reputation of a brand, especially *vis-à-vis* other brands. According to the Court, it cannot, even *prima facie*, gauge the market repute of a brand on the basis of how quickly it shows up on a Google search, as much would also depend on the search thread that is fed in. The High Court in *Under Armour, Inc. v. Aditya Birla Fashion & Retail Ltd.* [Judgement dated 20 April 2023] hence rejected the argument of the Plaintiff, to vouchsafe its reputation, that on a Google search being done of the word 'ARMOUR', the Plaintiff's site was one of the first results which popped up.

## Filing of additional documents by Plaintiff when not permissible

The Delhi High Court has held that in a commercial suit, the Plaintiff cannot be permitted to file additional documents at any stage of the suit on the ground that the same are in response to the case set up by the Defendant in the written statement. The Court in *Saregama India Limited v. ZEE Entertainment Enterprises Limited* [Decision dated 28 April 2023] was of the view that permitting a party to file additional documents at any stage would make a complete mockery of Order XI of the CPC as applicable to



commercial suits. It noted that the whole object of the aforesaid provisions of the CPC pertaining to commercial suits would be defeated if a party is permitted to file additional documents at any stage of the suit. Rejecting the application, the High Court also observed that the documents sought to be filed by the Plaintiff were towards presumption of ownership of copyright in the works that was the subject matter of the present suit and that the aforesaid documents ought to have been filed by the Plaintiff along with the plaint.

## Trademarks – Higher degree of protection to ‘Kind’ family of marks

Observing that the Petitioner had several registrations granted in its favour with the prefixes to the word ‘KIND’ and hence, had developed a family of marks with the word ‘KIND’ as an essential part of the Petitioner’s trademarks, the Delhi High Court has held that although, the word ‘KIND’ is not related to the products being sold by the petitioner, but due to its long and extensive usage it has come to be exclusively associated with the petitioner and this would entitle the petitioner to a higher protection for the ‘KIND’ family of marks. In a dispute involving trademark ‘NIKIND’ of the Respondent and trademark ‘NIMEKIND’ of the Petitioner, the High Court in *Mankind Pharma Limited v. Arvind Kumar Trading* [Decision dated 18 April 2023] was of the view that merely changing the first part of the mark by use of the distinguishing family name (i.e., ‘KIND’ in the present case) or characteristic is likely to cause confusion both in trade and in the mind of public, more so as the

nature of the goods of the Petitioner and the Respondent were identical i.e., medicines for human purpose.

## Trademark – Deceptive similarity – Assertions in counter-statement by Plaintiff when can lead to denial of interim relief

Observing that the issue of whether there exists or does not exist, an element of confusion or deceptive similarity, is essentially an issue of fact, the Delhi High Court has denied interim relief to the Plaintiff in a case where the Plaintiff itself, in a counter-statement in response to a Section 57 application by the Defendant, had asserted that not only that there was no possibility of confusion between the marks of the Plaintiffs and the Defendants, but that, in fact, at least at that point of time, there did not exist any such confusion in the market at all. Further, noting that the reply was filed on oath, and was affirmed by verification by the partner of the Plaintiffs, the Court in *MS Lightbook v. Pravin Shriram Kadam* [Judgement dated 24 April 2023] held that it cannot lie in the mouth of the Plaintiff, therefore, to contend that the marks of the Plaintiffs and Defendants are deceptively similar.

## Trademarks – Prima facie case of infringement of mark ‘Officer’s Choice’ by mark ‘Green Choice’

The Delhi High Court has held that in view of the strength of the mark ‘Officer’s Choice’, degree of deceptive similarity with ‘Green

Choice', identity of products (whiskey), identity of trade channels and commonality of consumer base, likelihood of confusion amongst unwary purchasers with average intelligence with imperfect recollection, the Plaintiff has made out a *prima facie* case of infringement under Section 29(2) of the Trade Marks Act, 1999. The High Court in this regard rejected Defendant's argument that what is adopted is the mark 'Choice' and no injunction can be granted as the mark 'Choice' is generic and common to trade and

common to register, with some 104 marks cited by them. The Court in *Allied Blenders and Distillers Pvt. Ltd. v. SNJ Distillers Private Limited* [Judgement dated 19 April 2023] noted that Plaintiff brought on record that out of the 104 cited marks, 75 were registered by the Plaintiff, 17 showed no evidence of use as per online records, 9 were invalid and 3 had been opposed by the Plaintiff.

**NEW DELHI**

5 Link Road, Jangpura Extension, Opp. Jangpura Metro Station, New Delhi 110014  
Phone : +91-11-4129 9811

-----

B-6/10, Safdarjung Enclave New Delhi -110 029

Phone : +91-11-4129 9900

E-mail : [lsdel@lakshmisri.com](mailto:lsdel@lakshmisri.com)

**CHENNAI**

2, Wallace Garden, 2nd Street, Chennai - 600 006

Phone : +91-44-2833 4700

E-mail : [lsmds@lakshmisri.com](mailto:lsmds@lakshmisri.com)

**HYDERABAD**

'Hastigiri', 5-9-163, Chapel Road, Opp. Methodist Church, Nampally  
Hyderabad - 500 001

Phone : +91-40-2323 4924 E-mail : [lshyd@lakshmisri.com](mailto:lshyd@lakshmisri.com)

**PUNE**

607-609, Nucleus, 1 Church Road, Camp, Pune-411 001.

Phone : +91-20-6680 1900

E-mail : [lspune@lakshmisri.com](mailto:lspune@lakshmisri.com)

**CHANDIGARH**

1st Floor, SCO No. 59, Sector 26, Chandigarh -160026

Phone : +91-172-4921700

E-mail : [lschd@lakshmisri.com](mailto:lschd@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](mailto:lsallahabad@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](mailto:lsjaipur@lakshmisri.com)

**MUMBAI**

2nd floor, B&C Wing, Cnergy IT Park, Appa Saheb Marathe Marg,  
(Near Century Bazar)Prabhadevi,

Mumbai - 400025

Phone : +91-22-24392500

E-mail : [lsbom@lakshmisri.com](mailto:lsbom@lakshmisri.com)

**BENGALURU**

4th floor, World Trade Center, Brigade Gateway Campus, 26/1, Dr. Rajkumar Road,  
Malleswaram West, Bangalore-560 055.

Phone : +91-80-49331800 Fax:+91-80-49331899

E-mail : [lsblr@lakshmisri.com](mailto:lsblr@lakshmisri.com)

**AHMEDABAD**

B-334, SAKAR-VII, Nehru Bridge Corner, Ashram Road, Ahmedabad - 380 009

Phone : +91-79-4001 4500

E-mail : [lsahd@lakshmisri.com](mailto:lsahd@lakshmisri.com)

**KOLKATA**

2nd Floor, Kanak Building 41, Chowringhee Road, Kolkatta-700071

Phone : +91-33-4005 5570

E-mail : [lskolkata@lakshmisri.com](mailto:lskolkata@lakshmisri.com)

**GURGAON**

OS2 & OS3, 5th floor, Corporate Office Tower, Ambience Island, Sector 25-A,  
Gurgaon-122001

phone: +91-0124 - 477 1300 Email: [lsgurgaon@lakshmisri.com](mailto:lsgurgaon@lakshmisri.com)

**KOCHI**

First floor, PDR Bhavan, Palliyil Lane, Foreshore Road, Ernakulam Kochi-682016

Phone : +91-484 4869018; 4867852

E-mail : [lskochi@laskhmisri.com](mailto:lskochi@laskhmisri.com)

**NAGPUR**

First Floor, HRM Design Space, 90-A, Next to Ram Mandir, Ramnagar,  
Nagpur - 440033

Phone: +91-712-2959038/2959048

E-mail : [lsnagpur@lakshmisri.com](mailto:lsnagpur@lakshmisri.com)

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