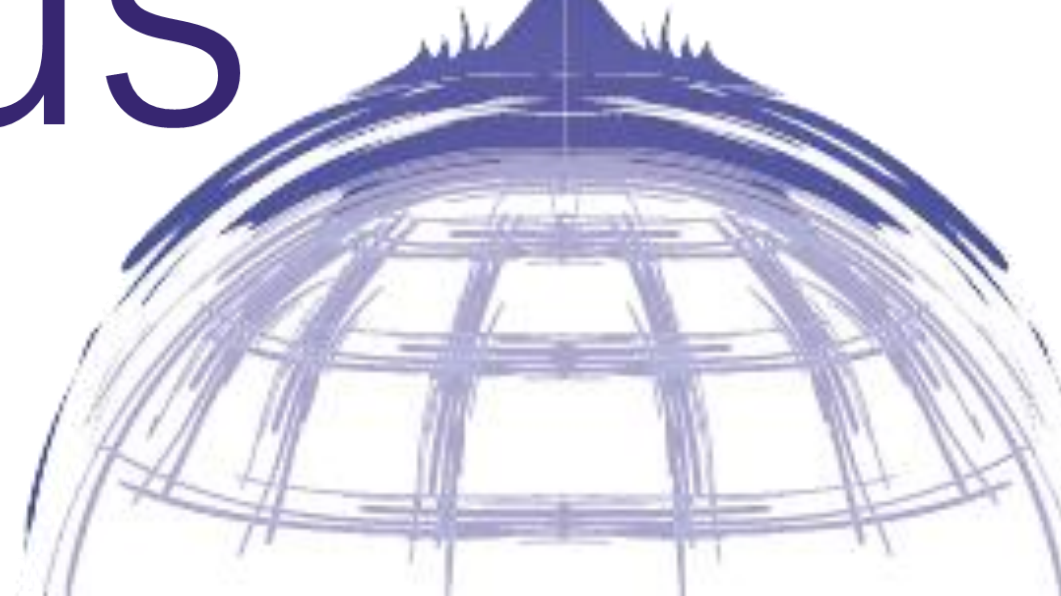


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# Article

## Trends in GI sector: An analysis

By Naina Gupta and Vaishali Joshi

In recent years Geographical Indications ('GIs') has emerged as one of the most important instruments for protecting the 'quality, reputation or other character of goods essentially attributable to their geographical origin'. Analysing the trends in the GI sector, the article in August 2023 issue of IPR Amicus discusses the background of the concept of GI and provides various statistics like GIs in force around the world and GIs in force by product category. It also highlights various issues like need for robust protection mechanisms both domestically and internationally, and for protecting technology used or method of production also, while safeguarding the name and place of origin. The authors also try to provide various suggestions for promoting and fostering the growth of GI in India. They discuss measures like establishment of common utility centres, R&D, technical and design inputs, felicitation and workshops, endorser-brand strategy, and provision for a comprehensive gifting catalogue featuring GI products.

# Trends in GI sector: An analysis

By Naina Gupta and Vaishali Joshi

## Introduction

In recent years Geographical Indications ('GIs') has emerged as one of the most important instruments for protecting the 'quality, reputation or other character of goods essentially attributable to their geographical origin'. It is a 'source identifier' and indicator of quality. It helps to promote goods of a particular region or country and is 'eligible for relief from acts of infringement and/or unfair competition'.

## Concept of Geographical Indication

The concept of GIs has its origins in the Paris Convention of 1983. Although the Convention did not *per se* use the term

'Geographical Indications,' Article 1(2) of the Convention referred to 'appellation of origin' and 'indications of source.'

Under the **TRIPS Agreement**, GIs have been referred to as indications identifying a product as originating from the territory of a member, or a specific region or locality within that territory, where a particular quality, reputation, or characteristic of the product is essentially linked to its geographical origin.<sup>1</sup>

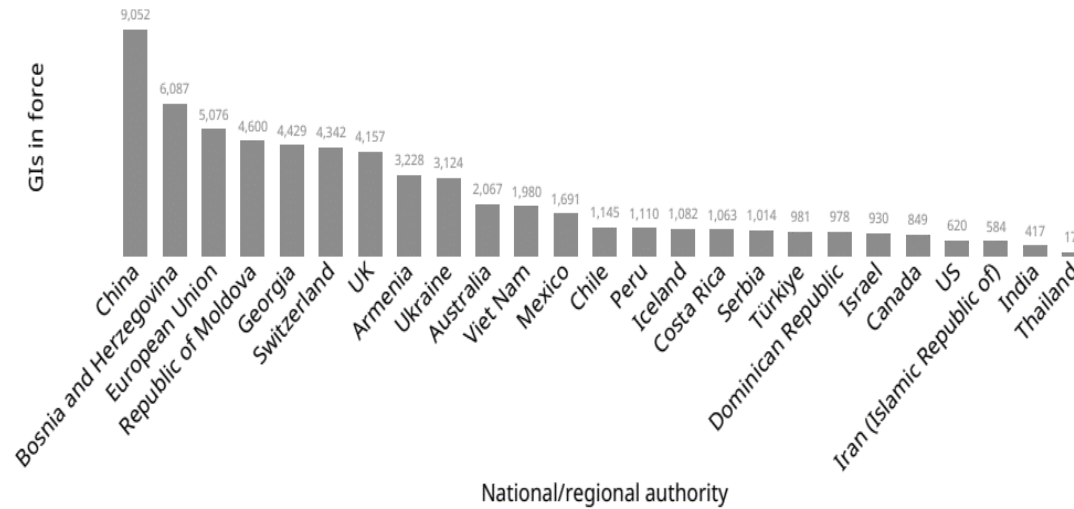
Section 2(e) of the **Indian Geographical Indications of Goods (Registration and Protection) Act, 1999**<sup>2</sup>, defines GIs in relation to goods as indications that identify agricultural, natural, or manufactured goods as originating or manufactured in a specific territory, region, or locality, where the quality, reputation, or other characteristic of the goods is essentially linked to their geographical origin.

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<sup>1</sup> Para 1 of the TRIPS Agreement

<sup>2</sup> Operationalises the structure required by Geographical Indications Goods (Registration and Protection) Rules, 2002

## How many GIs are in force worldwide?



In 2021, China held the highest number of GIs in force within its borders with a total of 9,052 GIs whereas India stands on 24<sup>th</sup> rank. (Fig.1<sup>3</sup>)

<sup>3</sup> Extracted from WIPO statistics data base, 2022

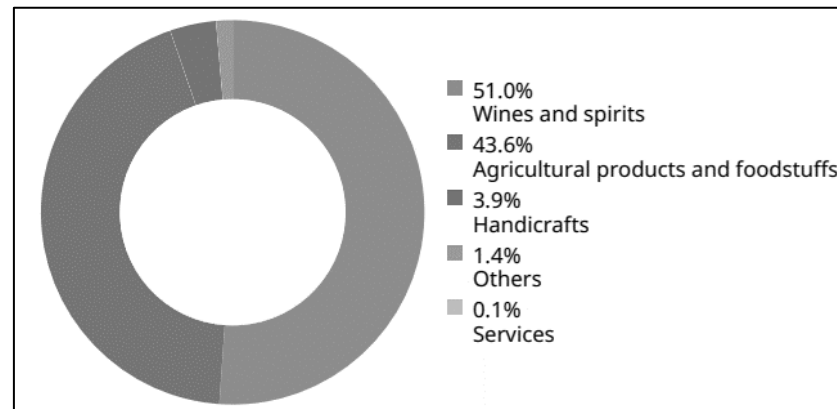
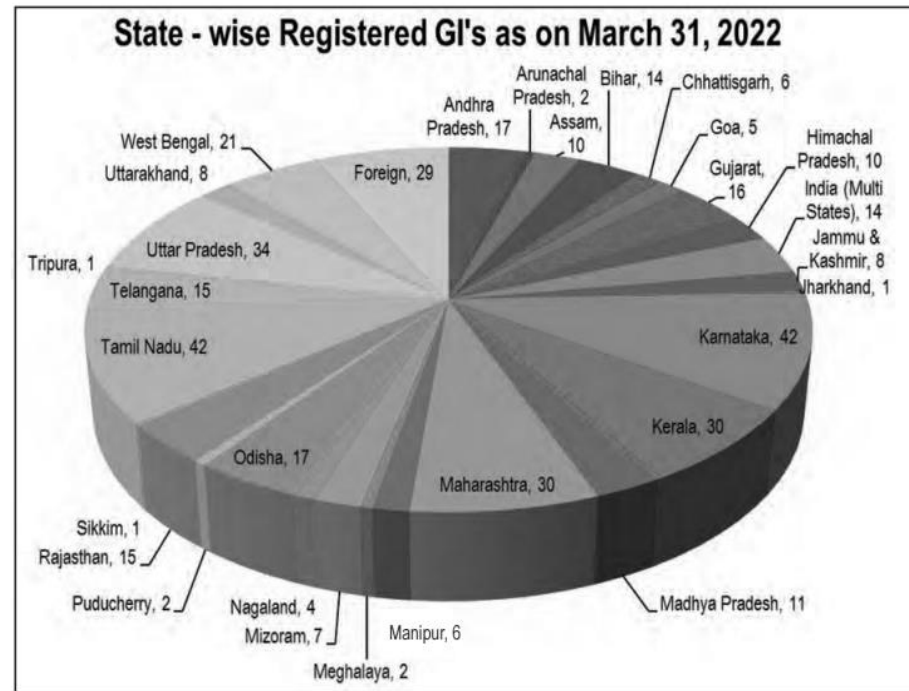
Geographical Indications in force by product category, 2022<sup>4</sup>

FIGURE 2.

<sup>4</sup> <https://www.wipo.int/edocs/pubdocs/en/wipo-pub-943-2022-en-wipo-ip-facts-and-figures-2022.pdf>, last visited 15 July 2023

The State-wise registered GIs in India are shown as under (FIGURE 3):<sup>5</sup>



<sup>5</sup> [https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Final\\_Annual\\_Report\\_Eng\\_for\\_Net.pdf](https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Final_Annual_Report_Eng_for_Net.pdf)

## GI Applications as per Section 2(F) of the GI Act, 1999 filed as on 31 March 2022

Year	2017-18	2018-19	2019-20	2020-21	2021-22
<b>Filed</b>	38	32	42	58	<b>116</b>
<b>Examined</b>	18	43	51	0	<b>46</b>
<b>Registered</b>	25	23	22	05	<b>50</b>

FIGURE 4.<sup>6</sup>

As of 2023, two more Indian products, the Atreyapuram Pootharekulu sweet from Andhra Pradesh and the Dholak from Amroha, Uttar Pradesh, have been granted the Geographical Indication (GI) tag.<sup>7</sup>

### Goods wise break up of GI Applications as per Sec. 2 (f) of the GI Act, 1999 filed as on March 31, 2022

Goods as per sec. 2 (f) GI Act,1999	No. GI Applications Received	No. GI Applications Registered
Handicraft (including Textiles)	389	232
Agricultural	252	125
Manufactured	149	36
Foodstuff	61	25
Natural	10	2
<b>Total</b>	<b>861</b>	<b>420</b>

FIGURE 5.<sup>8</sup>

<sup>6</sup> ibid

<sup>7</sup> Sudeshna Dutta, Geographical Indication (GI) Tag 2023: State-wise list of GI Tags, 2023-06-16; <https://www.edudwar.com/geographical-indication-gitag/#:~:text=The%20Atreyapuram%20Pootharekulu%20sweet%20of,2023%20goes%20to%20over%20430>, last visited on 15 July 2023

<sup>8</sup> [https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Final\\_Annual\\_Report\\_Eng\\_for\\_Net.pdf](https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Final_Annual_Report_Eng_for_Net.pdf)



The enforcement and protection of GIs in India have been subject to critical analysis. As of October 2020, only six cases have been heard by the High Courts or the Supreme Court, highlighting loopholes in the GIs protection system. The primary hurdle lies in the fact that GI registration does not guarantee full benefits in terms of market exposure and prestige for the product. The lack of post-registration activities is a major concern, and there is a need for robust protection mechanisms both domestically and internationally, along with effective marketing strategies.

Another limitation of GI laws in India is that they only safeguard the name and place of origin, leaving the technology or method of production unprotected. This has led to an influx of cheaper machine-made imitations flooding the markets, undermining the value of authentic GI products. Many GI products are associated with boards or organizations that lack sufficient financial resources to fight legal battles against infringement, both within the country and abroad. Government support becomes crucial to enable producers to afford adequate protection.<sup>9</sup>

Additionally, the Government's efforts in promoting and advertising GI products, whether in domestic or international markets, have been limited. Promoting GI tagged products with full potential can strengthen availability of local products in wider market. This can ensure authenticity and quality standard of the products in the local region.

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<sup>9</sup> Abhishek Mishra, BRICS LAW JOURNAL Volume IX (2022) Issue 2, Paper Titled can geographical indications support the indian village economy impacted by the ongoing economic crisis caused by covid-19

However, the Government has taken several proactive measures to promote GI tags that has also resulted in advancing India's exports. According to a report by the textile ministry (2011), participation in 85 exhibitions across the country and 18 Buyer Seller Meets have resulted into orders worth INR 2.62 crore organised by APEDA (Agricultural and Processed Food Products Export Development Authority).<sup>10</sup> Apex trade promotion organisations such as FIEO (Federation of Indian Export Organisations) has acted as the crucial interface between Indian exporters, Central Government, State Governments, financial institutions, concerned stakeholders. The Department for Promotion of Industry and Internal Trade (DPIIT) has also come up with several initiatives to promote GI tag products. DPIIT organized and also supported the 'India Geographical Indications (GI) Fair 2022' through Export Promotion Council for Handicrafts (EPCH) to promote GI products in India and abroad.<sup>11</sup> DPIIT also recently set up a pavilion for GI products in India International Trade Fair (IITF).<sup>12</sup>

## Conclusion and suggestions

The real impact of GIs significantly depends on whether producers of the said products bearing the GI share the benefits or not. The major problem in India is that the traders and not the producers capture the largest share of economic benefits resulted from the GI. In India, Geographical Indications (GI) hold a crucial

<sup>10</sup> (texmin.nic.in)

<sup>11</sup> Ibid.

<sup>12</sup> Ibid.

position, intersecting three key domains: Intellectual Property, trade, and socio-economic policy. Undoubtedly, GIs offer several advantages, such as product quality, while also serving as a means to uplift underprivileged producers and artisans in the country. The socio-economic and public policy implications of GIs are important. However, realizing these benefits necessitates effective marketing and robust protection against counterfeit products in the market. To achieve this, Governmental support becomes imperative, extending beyond the mere registration of GI products. Particularly in developing nations like India, proactive measures by the Government are essential for promoting and fostering the growth of GI. Few examples of such measures are as follows:

**1) Establishment of common utility centres:**

This is important in all village clusters with a minimum number of (GI) producers requiring tools, machinery, or technical support for various processes. For instance, similar centres have been established, in Chanderi and Bagru. Producers' cooperatives in Bagru emphasize the urgent need for shared facilities like a waste treatment centre, requiring substantial investment to support the business. A prime example of such support is seen in Vazhakulam, Kerala, where Pineapple farmers benefit from the APEDA-funded Pineapple-Pack house, offering amenities like cooling chambers, sorting, and storage facilities.

<sup>13</sup> Research study by Dr. Ruppel W Sharma and Ms. Shraddha Kulhari titled, 'Marketing of GI Products: Unlocking their Commercial Potential' <https://wtocentre.iift.ac.in/Papers/Marketing%20of%20GI%20Products%20Unlocking%20their%20Commercial%20Potential.pdf>, last visited 15<sup>th</sup> July, 2023

**2) R&D, Technical and Design Inputs:**

Regular upgradation and inputs in terms of technology, design, etc. become essential to improve productivity, to upgrade quality, introduce product innovations, etc. Further cooperation is needed to develop value added products in case of agricultural products. For example, Kerala University provides technical assistance to 7 agricultural GIs of the state and the farmers say that they adhere to the guidelines and processes defined by the University experts<sup>13</sup>. Central Coir Research Institute, Kerala CCRI<sup>14</sup> has also developed upgraded looms like a pneumatic loom called *Anupama* and another loom called *Anugraha* for making coir geo-textiles. CCRI has also helped in launching innovative products from coir, like an umbrella to obstruct UV rays, jackets, coco lawn, etc. Producers of Coir products report that they have witnessed 15-20% increase in sales after GI registration and assistance has played a key role in the process.

**3) Felicitation and Workshops:**

In addition to existing programmes where artisans are invited to attend workshops by designers in major cities, young designers should be encouraged to work as interns in village clusters where they can work with the artisans and give them tips on current design sensibilities and help them create a database of designs. With respect to some of the GI products

like Jute and Chikan products, Chanderi, Kota Doria, Chenapatna etc, NIFT students/ alumni are already involved. A course/project on relevant GI products should be introduced in the Universities.<sup>15</sup>

#### 4) **Endorser-Brand Strategy:**

A branding strategy is recommended to develop GI brand as an endorser brand. Endorser brands are usually corporate brands which provides credibility to the main brand.

Since an endorser GI brand will be promoted collectively or through a coordinating agency, it allows smaller producers to reap benefits even if they do not have the ability to invest in marketing their own brands. Endorser brand strategy can also be effective in case of well-established product brands because it adds another dimension to its existing associations. In the case of *Darjeeling tea*, several well-known brands of tea also use the Darjeeling tea brand as an endorser.<sup>16</sup>

- 5) Furthermore, a comprehensive gifting catalogue featuring GI products should be compiled and distributed to the Ministry of External Affairs and the Prime Minister's Office, and pertinent departments. This initiative must aim to facilitate the selection of distinctive gifts for foreign dignitaries. Each product may be accompanied by a concise description highlighting its unique attributes.<sup>17</sup>

The abovementioned measures if undertaken may give a boost to build up cross-cultural societies within the country which will not only promote the transfer of diverse GI products amongst the states and other parts of the world but will also contribute to building a better vibrant cultural society in the future.

**[The authors are Long-term Intern and Associate, respectively, in IPR Litigation practice at Lakshmikumaran & Sridharan Attorneys, New Delhi]**

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<sup>15</sup><https://wtocentre.iift.ac.in/Papers/Marketing%20of%20GI%20Products%20Unlocking%20their%20Commercial%20Potential.pdf>, last visited 15<sup>th</sup> July, 2023

<sup>16</sup>Ibid

<sup>17</sup>Ibid



# Statute Update

- Copyrights – Cinematograph Act, 1952 being amended to provide for strict punishment for piracy
- IPR laws – Certain provisions set to be decriminalised while penalty provisions being omitted for certain offences

## Copyrights – Cinematograph Act, 1952 being amended to provide for strict punishment for piracy

The President of India has on 4 August 2023 granted her assent to the Cinematograph (Amendment) Bill, 2023 which was passed by both the Houses of the Parliament last month. The Amendment Act amends the Cinematograph Act, 1952 to comprehensively curb piracy. According to the amendments (relevant for the purpose of copyrights) being made in Section 7 of the 1952 Act, strict punishment of minimum 3 months of imprisonment and fine of INR 3 lakh, which can extend upto 3 years of imprisonment and fine of 5% of the audited gross production cost, can be imposed in case of violation of the new Section 6AA and 6AB. Section 6AA addresses the issue of cam-cording in the theatres, while Section 6AB prohibits use or abetment in the use of infringing copy of any film to exhibit to the public for profit, at unlicensed place of exhibition or in a manner that amounts to infringement of copyright under the provisions of the Copyright Act, 1957.

## IPR laws – Certain provisions set to be decriminalised while penalty provisions being omitted for certain offences

The President of India has on 11 August 2023 granted her assent to the Jan Vishwas (Amendment of Provisions) Bill, 2023. The Act seeks to decriminalise some 183 provisions in the 42 Central Acts

administered by 19 Ministries/Departments. The Act provides for pragmatic revision of fines and penalties commensurate to the offence committed, establishment of Adjudicating officers and Appellate Authorities, and periodic increase in quantum of fines and penalties. Few amendments as being done in the Patents Act, 1970, Copyright Act, 1957, Trade Marks Act, 1999 and the Geographical Indications of Goods (Registration and Protection) Act, 1999 are discussed below.

**Copyright Act:** Section 68 of the Copyright Act, 1957 is being omitted. It provides for penalty for making false statements for the purpose of deceiving or influencing any authority or officer.

**Patents Act:** Under Section 120, fine of INR one lakh is being substituted for a penalty extending to INR 10 lakh. The provision also provides, in case of continuing claim, a further penalty of INR one thousand for every day after the first during which such claim continues. Section 120 provides for unauthorised claim of patent rights.

Further Section 121 providing for imprisonment and fine for wrongful use of the words 'patent office', will be omitted once the date of effect of the provisions of the Amendment Act are notified. Section 122 imprisonment and fine in case of refusal or failure to supply information to the Central Government under Section 100(5) or to the Controller under Section 146, is also being amended to revise the quantum of penalty and for doing away with the provisions for imprisonment. Similarly, penalty provisions have been revised in Section 123 of the Patents Act.

It may be noted that the latest changes also provide for insertion of new Sections 124A and Section 124B providing for Adjudication of penalties, and appeal against such adjudication, respectively.

**Trade Marks Act:** Section 107 of the Trade Marks Act, providing for penalty for falsely representing a trademark as registered, is being amended to do away with the provisions for imprisonment to bring in provisions for imposition of penalty instead.

Further, Section 106, providing for penalty for removing piece goods, etc., contrary to Section 81; Section 108, providing for penalty for improperly describing a place of business as connected with the Trade Mark Office; and Section 109 providing for penalty for falsification of entries in the register, are being omitted.

Here also, just as provided in the Patents Act, provisions are being brought for Adjudication of penalties and for appeal against such adjudication.

**Geographical Indications of Goods (Registration and Protection) Act:** Section 42 of the said Act, providing for penalty for falsely representing a geographical indication as registered, is being amended to do away with the provisions for imprisonment and fine. Instead, provisions are being brought in for imposition of penalty of a sum equal to one-half per cent. of the total sales or turnover, as the case may be, in business or of the gross receipts in profession as computed in the audited accounts of such person, or a sum equal to five lakh rupees, whichever is less.

Section 43 relating to penalty for improperly describing a place of business as connected with the Geographical Indications Registry; and Section 44 relating to penalty for falsification of entries in the register, are being omitted.

Here also, provisions are being brought for Adjudication of penalties and for appeal against such adjudication.



# Ratio Decidendi

- Use of trademarks as keywords in Google Ads Programme when infringes rights of owners of trademarks – No infringement if trademark used as a keyword, in absence of any confusion, dilution, or compromise of the mark – Delhi High Court
- Trademarks 'GLUCO-C++' and 'GLUCO-D++' are deceptively similar to marks 'GLUCON-C' and 'GLUCON-D' – Delhi High Court holds marks of both Plaintiff and Defendant as not descriptive – Delhi High Court
- Patents – Maintainability of suo motu Divisional Application – Requirement of plurality of inventions in parent application whether mandatory? – Delhi High Court's Singl-Judge Bench refers issue to Division Bench
- 'Vasundhra' and 'Vasundhara' – Trademark Section 35 benefit available even in case of part of the name – High Court rejects plea of passing off – Delhi High Court
- Patents – Post grant opposition – Only documents filed along with supporting affidavit to be considered as 'evidence' under Rule 57 – Delhi High Court

## Use of trademarks as keywords in Google Ads Programme when infringes rights of owners of trademarks – No infringement if trademark used as a keyword, in absence of any confusion, dilution, or compromise of the mark

The Division Bench of the Delhi High Court has upheld the findings of the Single-Judge Bench of the Court that the use of trademarks as keywords in the Ads Programme by an internet search engine amounts to 'use' under the provisions of the Trade Marks Act, 1999 and thus, may constitute infringement. The Court has also affirmed the view that the search engine is not entitled to the defence of an intermediary under Section 79 of the Information Technology Act, 2000.

Observing that Section 2(2)(c)(i) of the Trade Marks Act is couched in wide terms and any reference to the use of a mark in relation to goods is not only limited to use in any visual form but also 'in other relation whatsoever' to such goods, the Court rejected the contention of the search engine that such use of a keyword/trademark does not give rise to any actionable claim under the Trade Marks Act because, being invisible, its use cannot be construed as a use of a mark.

The Division Bench in this regard also observed that the words of Section 2(2) do not control the width of Section 29(6) and thus, if any action falls within the scope of Section 29(6), the same would necessarily have to be construed as use of the mark, for ascertaining whether the trademark is infringed in terms of Section 29. The Court also stated that it is not necessary that the registered trademark physically appears in an advertisement for the same to be used 'in advertising' and that the use of a trademark as a keyword to trigger display of an advertisement of goods or services would, in plain sense, be 'use' of the mark in advertising.

Further, it may be noted that the Division Bench also found no infirmity with the reasoning of the Single Judge in considering the use of trademarks as keywords analogous to using the same as meta-tags, for the limited purposes of examining whether use of a trademark, which is not visible may infringe the trademark. The Court also did not *prima facie* accept the view that use of trademarks as keywords in the Ads Programme was use only by the advertisers and not by the search engine. The High Court found it difficult to accept that whilst the search engine was selling keywords for use in its proprietary software, it does not use it.

It may however be noted that the Court held that use of a registered trademark as a keyword, in absence of any confusion, dilution, or compromise of the trademark, would not amount to infringement of the trademark. According to the Court, if the Ad or link displayed does not lend itself to any confusion, grievance regarding use of its trademarks as keywords in the Ads programme is not actionable. The Court in this regard also observed that identifying customers,



who may be looking for goods or services of a particular brand, for offering them alternatives is not unfair, as every advantage drawn by use of a trademark cannot be termed as drawing, unfair advantage of the trademark, without cause.

Lastly, on the question of exemption under Section 79 of the Information Technology Act, the Court held that limitation of liability under Section 79(1) of the IT Act is lifted if an intermediary fails to expeditiously remove or disable access to the material on receiving actual knowledge that the information controlled by the intermediary is being used to commit an unlawful act. The Court in this regard observed that *prima facie*, the search engine was an active participant in use of the trademarks of the proprietors and was selecting the recipients of the information of the infringing links. [*Google LLC v. DRS Logistics (P) Ltd. & Ors.* – Judgement dated 10 August 2023 in FAO(OS)(COMM) 2/2022 and Ors., Delhi High Court]

## Trademarks 'GLUCO-C++' and 'GLUCO-D++' are deceptively similar to marks 'GLUCON-C' and 'GLUCON-D' – Delhi High Court holds marks of both Plaintiff and Defendant as not descriptive

The Delhi High Court has passed an interim order restraining the Defendants from using the mark 'GLUCO-C++' and 'GLUCO-D++' by reason of them being deceptively similar to the Plaintiff's marks

'GLUCON-C' and 'GLUCON-D'. The Court observed that the words 'GLUCO-C++' and 'GLUCO-D++' constituted the essential features of the mark which were prominently displayed in much larger lettering and font than the word 'Prolyte' used before them. It, hence was of the view that the same clearly demonstrated the Defendant's intention to project 'GLUCO-C++' and 'GLUCO-D++'. Following the Supreme Court decision in the case of *Heinz Italia v. Dabur India Ltd.* [(2007) 6 SCC 1], the High Court held that *prima facie*, the Defendants' marks 'Prolyte Gluco-C ++' and 'Prolyte Gluco-D ++' infringed the Plaintiff's registered marks 'GLUCON-C' and 'GLUCON-D', especially as they were used for identical products.

Further, the High Court also rejected the contention of the Defendant that as the Plaintiff had disclaimed exclusivity over the suffixes 'C' and 'D', the aspect of infringement would have to be examined only by comparing the prefixes 'Glucon' with 'Gluco'. The Court was of the view that the disclaimer of exclusivity in respect of the suffixes 'C' and 'D' does not mean that while comparing the marks of the Plaintiff and the Defendants, the said suffixes would be left out of consideration.

Also, the Court stated that extrapolating the name 'GLUCON-D' to understand it to refer to a product combining glucose and Vitamin D would require imagination, thought and perception. According to the Court the name could be said to *suggest* the presence of Glucose and Vitamin D, and it cannot be said to *describe* it. The High Court in this regard also noted that Section 9(1)(b) forbids description and not suggestion. It hence rejected the Defendant's

plea that the marks 'GLUCON-C' and 'GLUCON-D' were descriptive and hence ineligible for registration by virtue of Section 9(1)(a) and (b) of the Trade Marks Act, 1999.

Benefit of Section 30(2)(a) of the Trade Marks Act, 1999 was also denied to the Defendant while the Court observed that the same is available only if the entire mark is used in a descriptive fashion. It, in this regard noted that the Defendant had initially tried to argue that their marks were not 'GLUCO-C++' and 'GLUCO-D++' but 'Prolyte GLUCO-C++' and 'Prolyte GLUCO-D++'. The Court also observed that the benefit of Section 30(2)(a) has to be examined on the basis of the mark *per se*, and not on the basis of the mark seen in the backdrop of recitals contained on the pack on which the mark is used.

However, while addressing the issue of passing off, the Court was of the view that the difference in appearance of the packs of both parties was sufficient to negate at a *prima facie* stage any possibility of the defendants being able to pass off their product as that of the plaintiff. It also in this regard noted that since the present trade dress of the Plaintiff was not registered, infringement of the same cannot be sustained. Further, it may be noted that the Court though found that the use of the two-battery motif was imitative, according to the Court, that by itself, cannot justify a finding of likelihood of confusion in the mind of a customer, especially as the two-battery motif was not reflected on the face of the packs but either on their rear or side panels. [*Zydus Wellness Products Ltd. v. Cipla Health Ltd. & Anr.* – Decision dated 3 July 2023 in CS(COMM) 115/2023, Delhi High Court.]

## Patents – Maintainability of suo motu Divisional Application – Requirement of plurality of inventions in parent application whether mandatory?

Differing with the views of the coordinate Bench in the case *Boehringer Ingelheim International GMBH v. Controller of Patents*, the Single-Judge Bench of the Delhi High Court has referred to Division Bench the questions as to (i) whether the requirement of plurality of inventions being contained in the parent application, in order for a Divisional Application to be maintainable, apply even where the Divisional Application is filed by the applicant *suo moto*, and not on the basis of any objection raised by the Controller? and (ii) whether the plurality of inventions have to be reflected in the claims in the parent application or is it sufficient if the plurality of inventions is reflected in the disclosures in the complete specifications accompanying the claims in the parent application.

The High Court in this case was of the opinion that requirement of the parent application containing a plurality of inventions is not applicable where the divisional application is filed *suo motu* by the applicant, without any objection raised by the Controller. The Court, in this regard, noted that Section 16(1) of the Patents Act, 1970 has a comma after the words 'if he so desires', but there is no such comma after the words 'the objection raised by the Controller'. It was also of the view that such a construction would bring Section 16(1) in tune with the parallel provision in Article 4(G) of the Paris Convention for Protection of Industrial Property.

On the second question, the High Court again differed with the view as held in *Boehringer Ingelheim*. It, in the present case, was of the view that the application could not have been rejected solely on the ground that the plurality of inventions was not specifically contained in the claim, and only in the disclosure contained in the complete specifications. The Court in this regard noted that a provisional application is not required to contain claims, and that Section 16(1) permits a divisional application to be filed even in respect of an invention disclosed in the provisional specification filed in respect of the parent application. [*Syngenta Limited v. Controller of Patents and Designs* – Decision dated 26 July 2023 in C.A.(COMM.IPD-PAT) 471/2022, Delhi High Court]

### ‘Vasundhra’ and ‘Vasundhara’ – Trademark Section 35 benefit available even in case of part of the name – High Court rejects plea of passing off

In an interesting dispute between the two registered trademarks in the same class for jewellery – ‘Vasundhra’ (of the Plaintiff) and ‘Vasundhara’ (of the Defendant), the Delhi High Court has rejected the Plaintiff’s plea of passing off. The Court though noted that the marks were phonetically identical, it observed that apart from the difference in the spellings of the marks, the manner and style of writing was also completely different. It also noted that the Plaintiff itself in its reply to the Examination Report, had stated that there was no similarity and therefore, the same would not create any confusion in the minds of consumers.

Further, the Court relied upon a Supreme Court decision in the case of *Precious Jewels* and was of the view that there is no absolute proposition of law that the benefit of Section 35 of the Trade Marks Act would be available only in respect of full name. The High Court also observed that there was nothing in the language of Section 35 to suggest that the defence is available only in respect of the full name. *Prima facie* allowing the benefit of Section 35, the Court also noted that the Defendant was nothing but an extension or an alter ego of Ms. Vasundhara Mantri, who was trading in her name since 2001 and now holds 99.09% share in the Defendant LLP. [*Vasundhra Jewellers Pvt. Ltd. v. Vasundhara Fashion Jewellery LLP & Anr.* – Judgement dated 19 July 2023 in CS(COMM) 161/2022, Delhi High Court]

### Patents – Post grant opposition – Only documents filed along with supporting affidavit to be considered as ‘evidence’ under Rule 57

The Delhi High Court has quashed the recommendations of the Opposition Board in respect of a post-grant opposition to a patent. The Respondent here, had in the post grant opposition, filed documents, unaccompanied by any supporting affidavit, and the Court was hence of the view that the same do not constitute ‘evidence’ as envisaged in Rule 57 of the Patent Rules. The Court in this regard observed that hence the Opposition Board could not have taken the said documents into consideration. Quashing the recommendations of the Opposition Board, the Court also noted

that Respondent having not filed any evidence under Rule 57, the Petitioner was also denied the opportunity of filing reply evidence under Rule 58.

The Court for this purpose observed that recommendations which are crucial, or which have great persuasive value and which, therefore, tilt the scales in favour of one party or the other, have to be returned only after strict compliance with the procedural rules

stipulated in that regard. According to the Court, any failure to ensure such compliance has, in built in it, prejudice, and no separate prejudice needs to be shown by the party against whose interest the failure to observe the statutorily prescribed procedure has operated. [*Akebia Therapeutics Inc. v. Controller General of Patents, Design, Trademark and Geographical Indications* – Judgement dated 9 August 2023 in W.P.(C)-IPD 32/2023, Delhi High Court]



# News Nuggets

- Trademarks – No appeal maintainable under Section 91 against administrative panel decision of WIPO
- Trademarks – Costs when to be imposed on the Defendant
- Copyrights – Territorial jurisdiction of Court – Section 62 provides additional forum
- VERIZON granted well known trademark status

## Trademarks – No appeal maintainable under Section 91 against administrative panel decision of WIPO

The Delhi High Court has held that appeal under Section 91 of the Trade Marks Act, 1999 is not maintainable against an administrative panel decision of the World Intellectual Property Organization (WIPO). The Court in *Ashwa Ghosh v. Vizrt Ag* [Decision dated 19 July 2023] observed that neither the impugned order was not passed by the Registrar of Trade Marks, nor was the Administrative Panel of the WIPO the Registrar. It noted that Section 91 of the Trade Marks Act provides for an appeal against orders passed by the Registrar under the Trade Marks Act.

## Trademarks – Costs when to be imposed on the Defendant

Observing that the Defendant had not contested the matter, but compelled the Plaintiff to file the present suit, by not agreeing to give up the infringing mark, despite being put to notice, the Delhi High Court has held that the Plaintiff is entitled to receive actual costs. The Court in *Whitehat Education Technology Private Limited v. Vinay Kumar Singh* [Decision dated 2 August 2023] also found the Defendant's mark 'WHITEHAT SR', to be almost identical to the Plaintiff's mark 'WHITEHAT JR'. It in this regard also noted that the writing style of the letter 'W' by the Defendant was also identical to the Plaintiff's writing style.

## Copyrights – Territorial jurisdiction of Court – Section 62 provides additional forum

Following the decision of the Division Bench of the Delhi High Court in the case of *Ultra Home Construction Pvt. Ltd. v. Purushottam Kumar Choubey* which itself had followed the Supreme Court decision in the case of *Indian Performing Rights Society Ltd. v. Sanjay Dalia*, the Single-Judge Bench of the Delhi High Court has reiterated that Section 62 of the Copyright Act provides an additional forum for institution of a suit alleging infringement of copyright, over and above the forum which, by operation of Section 20 of the Civil Procedure Code, would have jurisdiction in the matter. The Court in *Yashoda Thakore v. Kuchipudi Dance Centre and Ors.* [Judgement dated 12 July 2023] also dismissed the Petitioner's contention that the decision in *Ultra Home Construction* was *per incuriam*, as it was contrary to the Explanation to Section 6 of the Commercial Courts Act, 2015, which it does not notice.

## VERIZON granted well known trademark status

The Delhi High Court has declared that the mark VERIZON is a well-known trademark when used in the context of providing telecommunication services, within the meaning of Section 2(1)(zg) read with Section 11(6) of the Trade Marks Act, 1999. The Court in this regard perused the material on record namely the fact that Plaintiff have five world class facilities across Chennai, Hyderabad, Bengaluru, and claims to hold over 100 patents in India. It has also been part of multiple CSR initiatives and has received various awards and accolades. The Plaintiff had also submitted that they

have been in the Indian market for 23 years with one of the earliest Indian trademark registrations dating back to 3 June 2000, and that the revenue generated by them in the FY 2021 to 2022 was to the tune of INR 7866 million. They had also submitted that the trademark 'VERIZON' is registered in India in 15 classes and is also

registered in 200 countries. The Plaintiff in *Verizon Trademark Services LLC v. Vikash Kumar* [Order dated 11 July 2023] had also placed on record 24 orders passed by the Court protecting Plaintiffs' rights in VERIZON as a trademark.

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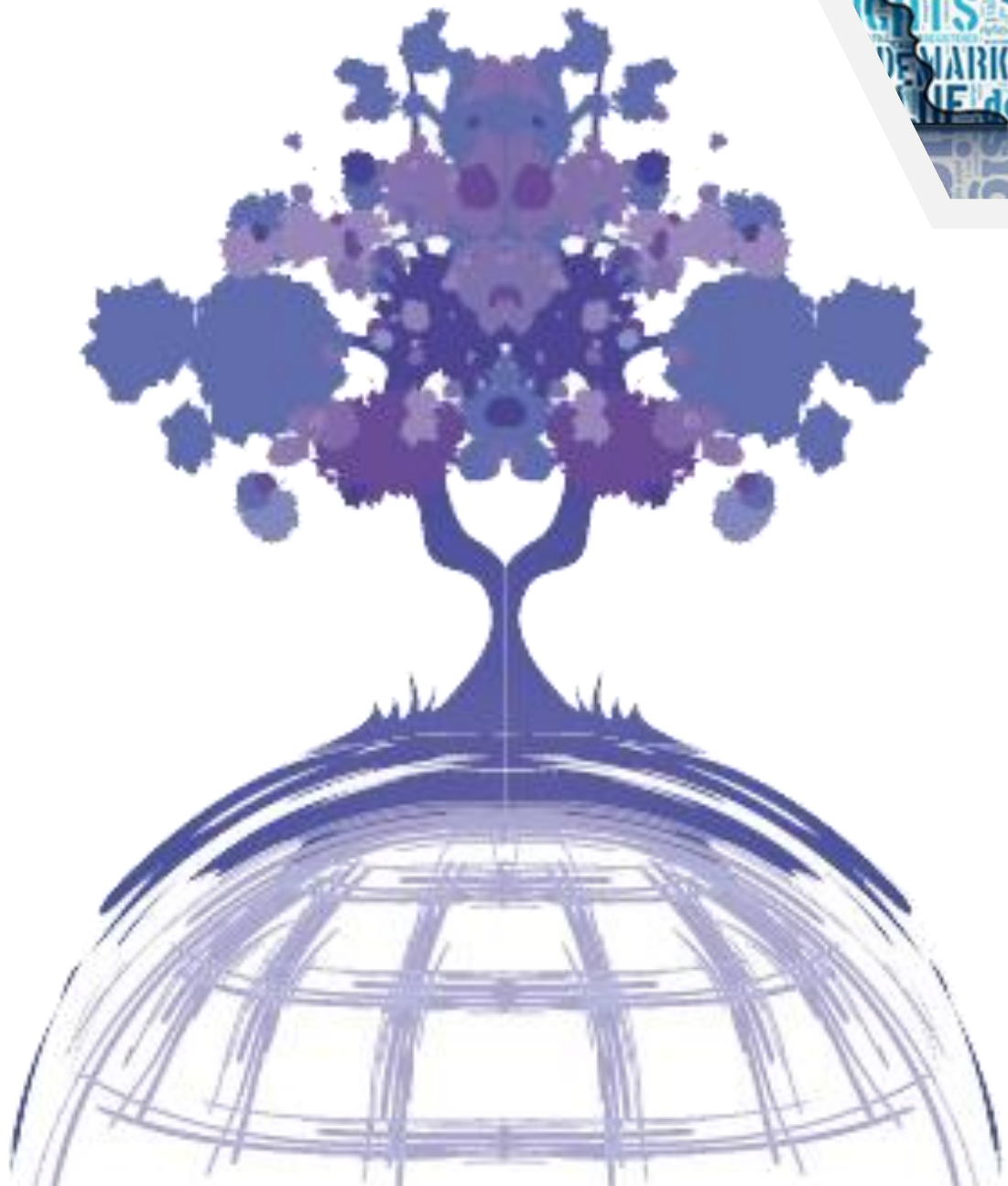
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