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# Article

## **Maneuvering the expedited routes of patent prosecution – IPO, EPO and USPTO**

*By Pooja Bawari, Archana Vishwanathan and Dr. Malathi Lakshmikumaran*

Despite the advantages bestowed by early patent grants, a single common program to expedite prosecution in all the jurisdictions is not available to the patent applicants who would like to strategize on expediting examination in multiple jurisdictions. Bearing in mind the existing provisions for expedited examinations, the article in this issue of IPR Amicus focuses on key routes available at the Indian Patent Office ('IPO') compared with the European Patent Office ('EPO') and the United States Patent and Trademark Office ('USPTO'). Elaborately discussing various provisions, schemes and programs, the authors note that the Patent Offices including IPO, EPO and USPTO have made considerable efforts in ensuring that the routes of expediting examination are made available to the applicants. According to them, the responsibility now lies on the Applicant to maneuver the routes with careful consideration in order to find the best outcome for its patent application.

# Maneuvering the expedited routes of patent prosecution – IPO, EPO and USPTO

By Pooja Bawari, Archana Vishwanathan and Dr. Malathi Lakshmikumaran

As is known, a patent accords a reward of exclusivity to the patent holder. Considering that a patent is only valid for a period of 20 years, receiving an early grant in a jurisdiction is crucial to patent applicants. It not only allows for a longer period of patent enforcement and potential revenue generation, but also provides an opportunity to accelerate the examination of corresponding applications in other jurisdictions.

Despite the advantages bestowed by early patent grants, it is notably true that a single common program to expedite prosecution in all the jurisdictions is not available to applicants while strategizing on expediting examination in multiple jurisdictions. Instead, applicants have to expedite examination individually in every jurisdiction or, at best, opt for the bilateral patent prosecution highway programs between patent offices to accelerate the patent process.

Bearing in mind the existing provisions for expedited examinations, this article focuses on key routes available at the Indian Patent Office ('IPO') compared with the European

Patent Office ('EPO') and the United States Patent and Trademark Office ('USPTO').

## Advancing examination of Indian patent applications at IPO:

Under Section 11B and Rule 24B of the Patents Act, 1970 ('Act') and the Patents (Amendment) Rules 2024 ('Rules'), the time period for requesting examination of a complete application using Form-18 is within 31 months from its date of filing or date of priority, for patent applications made on or after the commencement of the Rules, i.e., 15 March 2024. For the patent Applications that were filed before 15 March 2024, the timeline for filing a request for Examination is 48 months from the date of filing or date of priority.

### *Early queuing of the patent application:*

One possible route for early examination is simply to file the examination request close to the filing or priority date. This allows the application an early entry into the queue for examination as compared to the applications filed thereafter, as stated in Rule 24B 2(i) of the Rules.



***Express examination:***

An express request for examination under Rule 20(4)(ii) of the Rules is available, solely, to national phase application entering *via* the PCT route in India, by submitting at the IPO, a Form-18 along with the prescribed fee. This request initiates processing of the national phase application by the patent office before the expiry of the 31-month time limit from the date of priority of the PCT Application.

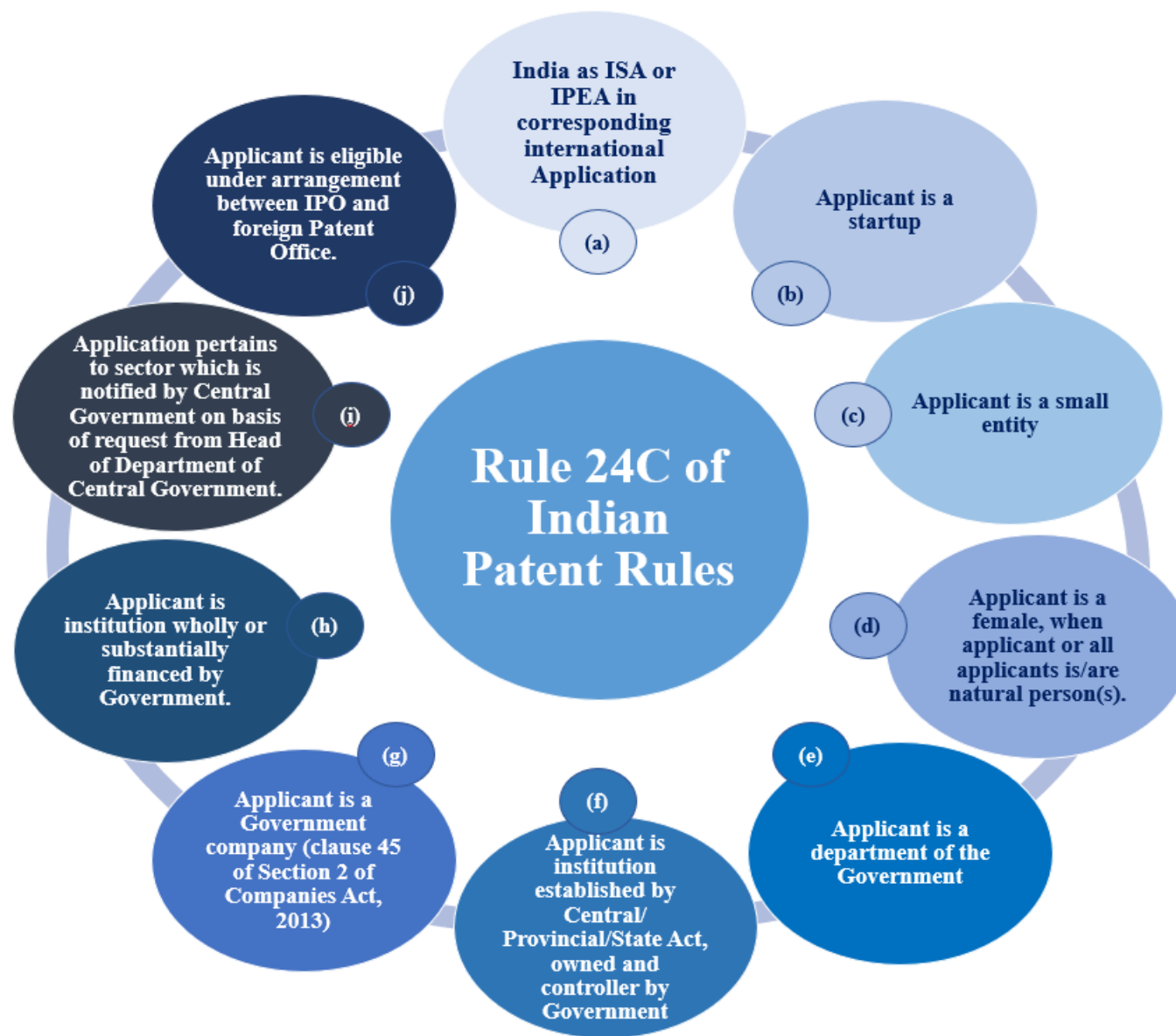
***Expedited examination:***

An expedited examination route is available in India under Rule 24C of the Rules introduced by the Patents (Amendment) Rules of 2017 and 2019. A request for expedited examination can be made using Form 18A only by electronic transmission, which places the patent application in a separate expedited examination queue in order of requests filed. The examination report is then prepared and issued in a period of around three months from the date on which said request is referred to the examiner, based on the provisions of sub-rule (6), (7) and (8) of Rule 24C of the Rules.

Considering that the IPO only takes cognizance of examination requests of published applications, as per Rule 24B (2)(i) of the Rules, requesting early publication becomes necessary if expedited examination is opted. Ordinarily, the publication of a patent application is made after 18 months from its filing or priority date. Therefore, if an applicant intends to expedite the examination procedure, the applicant would also be required to file a request for an early publication under Section 11A(2) of the Act and Rule 24A of the Rules using Form-9, allowing publication within 18 months. As stated in the proviso of Rule 24 of the Rules, the early publication will be made one month from the date of said request.

It is generally advisable to request early publication along with examination or expedited examination request, to ensure that the Controller refers the application to the examiner sooner.

A normal request for examination can be converted to an expedited request or the expedited request can be directly filed directly, if the applicant satisfies the provisions of Rule 24C of the Rules, based on the following grounds:



It can be noted that unlike US and EP, the expedited request at the IPO is not revoked under any specific circumstance, however in order for the request to be fruitful, the Applicants are advised to submit their response to the examination report(s) and/or hearing notice in an expeditious manner.

***Patent Prosecution Highway (PPH) under Rule 24C:***

Currently, provision under Rule 24C(1)(j) of the Rules is unavailable as IPO has no bilateral PPH agreement with any

foreign Patent Office. The IPO-JPO (Japan Patent Office) PPH pilot program concluded on 20 November 2022<sup>1</sup>.

***Examination fees:***

Considering the above listed routes for advancing the examination as made available by the IPO, the respective fee applicable (INR) is as follows:

Expedited routes	Acts and Rules	Form	e-filing		Physical filing	
			Natural person/ Startup/ Small entity/ Educational Institution	Large entity	Natural person/ Startup/ Small entity/ Educational Institution	Large entity
Early publication	Section 11(A)2, Rule 24A	9	2500	12500	2750	13750
Normal Examination	Section 11B, Rule 24B	18	4000	20000	4400	22000
Expedited Examination	Rule 24C(1)	18A	8000	60000	Not allowed	Not allowed
Converting normal to expedited examination	Rule 24C(2)	18A	4000	40000	Not allowed	Not allowed
Express Examination	Rule 20(4)(ii)	18	5600	28000	6150	30800

<sup>1</sup>  
[https://www.jpo.go.jp/e/system/patent/shinsa/soki/pph/japan\\_india\\_highway.html](https://www.jpo.go.jp/e/system/patent/shinsa/soki/pph/japan_india_highway.html)

## Advancing examination of applications at the EPO:

A single patent application before the EPO implies that any grant obtained on the patent application has the opportunity to be registered in 39 member States, 1 extension State and 5 validation states of the European Patent Organisation. Thus, the grant of an EP patent holds a crucial value to the applicant.

For a patent application filed before the EPO, Article 94 of the European Patent Convention ('EPC') requires an applicant to request examination, failing which the application would be deemed withdrawn. Such examination request under Rule 70(1) EPC can be made any time before the expiry of six months from the mention of publication of European Search Report by the European Patent Bulletin.

Applicants are usually advised to file the request for examination along with the filing of patent application. In this case, the applicant is then invited by the EPO under Rule 70(2) EPC in response to the European Search Report to confirm if he desires to proceed with the application.

### *Express request into national phase prosecution:*

EPO provides the applicant of a PCT application an opportunity to file express request for early processing of the

corresponding national phase application. This request can be made by ticking the checkbox in Section 12.1 of EPO Form 1200 along with requirements for national phase entry under Rule 159 EPC, at any time within the 31-month period. Hence, the applicant can leap months, a year or even longer to have his application processed by the EPO as a designated state. Caution in making this request is that any changes recorded at the international phase post the EPO entry, would not be applicable to the national phase EP application.

Once the application enters EPO under express request, it is then processed as a 'regular' EP national phase application. The Applicant can make the request for examination and payment of examination fees along with the express request.

### *Waivers before the examination stage:*

*Waiving Rule 161/162 communication* – Rule 161/162 EPC communication invites the Applicant to make a response within six months from its issuance, with respect to (a) corrections or comments on the EP application in view of the objections raised in any of International Search Report (ISR), Supplementary ISR, or International Preliminary Report on Patentability (IPRP) established by the EPO as ISA or IPEA in the PCT Application; and/or (b) payment of excess claim fee



over 15 claims or amending the claims to reduce the number of claims to 15 or less.

To waive the right to this communication, the applicant is required to submit a response under (a) and/or (b) as mentioned above, upon entry before the EPO as direct application or national phase application, using Form 1200 (Section 12.2). This will cause non-issuance of Rule 161/162 EPC communication by the EPO, allowing the applicant to skip-forward to the next stage by six months.

In the case, where the waiver was not made along with the EP application, or it was found to be insufficient, the EPO will issue the communication under Rule 161/162 EPC. However, all is not lost, and the applicant can swiftly file the mandatory response to the communication with a request for waiver for the remaining time period.

*Waiver by virtue of selecting EPO as ISA* – A second waiver is solely available for EP national phase application, where in the PCT stage the EPO is selected as an ISA to render the ISR and written opinion. The ISR issued by the EPO at the international phase replaces the European search report of EP national phase, and as such, the EPO forgoes the entire search stage spanning twelve months.

*Waiver of Rule 70(2) Communication* – For EP application that are not by the PCT route, the Applicant may along with the application, examination request and associated fees, file Form 1001 to waive right under Rule 70(2) EPC. The waiver indicates that the applicant accepts the outcome of the European Search Report and would like to proceed directly to the examination stage, fast forwarding six months. The search report is then issued alongside the examination report under Article 94(3) EPC.

***Programme for accelerated prosecution of EP patent application (PACE):***

Additionally, the applicant may also request online using Form 1005, for accelerating search and/or examination under the program known as PACE. For applicability of PACE on the processing of a patent application, it should be duly noted by Applicants (i) to not withdraw the PACE request, (ii) to not request for any extension of time limit during the prosecution of the application, (iii) to not let the application be withdrawn or deemed to be withdrawn, (iv) to not have the application refused, and (v) to ensure payment of the renewal fees within stipulated time. This is because any action contrary to the above, if occurred, does not reinstate the patent application

under PACE, even when followed by the applicant's remedial action available under the EPC.

PACE request for an EP patent application can only be filed once for each stage of the prosecution, i.e., once for search and once for examination. The PACE programme is free of any official cost, requires no specific grounds or documentations for making the request. The request when made is accepted by the EPO, subject to the workload of divisions handling the search and examination. In such a case, the EPO requires Applicants with PACE for all or most of their patent applications, to limit their requests.

Once the patent application is under the consideration of the examination division, Applicants can file a PACE request at the EPO. Upon receiving said request, the EPO issues the next communication of examination result within three months. Subsequent communications are also issued within three months from the Applicant's response.

#### ***Patent Prosecution Highway (PPH):***

Alternatively, a request made under Form 1009 at the EPO before the beginning of substantive examination of the EP patent application, allows the examination to be accelerated

under PPH program, provided that a corresponding application is considered allowable by the following foreign Patent Offices: Australia, Brazil, Canada, China, Colombia, Israel, Japan, South Korea, Malaysia, Mexico, Peru, the Philippines, Saudi Arabia, Singapore, and the United States<sup>2</sup>.

The requirements for making said request involve submitting at the EPO: (a) communication indicating allowance or grant received from any of the above listed Patent Offices; (b) voluntarily amended EP claims in line with the granted or allowed claims of that corresponding application; and (c) if required, translation of said documents.

The PPH request at the EPO is not accompanied with payment of any official fees. However, it should be noted that when compared to the PACE programme, PPH has the same accelerating effect. Opting for the PPH route, however, requires preparation and filing of documents which may incur added costs. It is also a common understanding that the above listed Patent Offices have their individual provisions of patentability, to which the Examiner at the EPO may not align his opinion while rendering decision on patentability in the EP patent application.

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<sup>2</sup> <https://www.epo.org/en/applying/international/patent-prosecution-highway>

Therefore, it is usually preferable for Applicants to opt for PACE over PPH.

### Advancing examination at USPTO:

USPTO accords multiple expedited examination programs which enables the Applicant to benefit therefrom an expedited grant of a patent application. The plausible ways to expedite examination, and consequently grant of a patent Application at the USPTO involves the following:

#### *Filing US application for the first time?*<sup>3</sup>

For a micro-entity applicant and the inventor(s) filing their first US application for patent, a pilot program of 'First-Time Filer' was introduced in March 2023, which has been extended till March 11, 2025, or grant of 1000 petitions by the USPTO since the launch of this program, whichever occurs earlier. A petition under this program can be filed at any time before the issuance of first Office Action. Once the application under this program gets docketed for examination, an office action will be issued within 28 days<sup>4</sup>.

<sup>3</sup> <https://www.uspto.gov/initiatives/first-time-filer-expedited-examination-program>

<sup>4</sup> [https://www.uspto.gov/initiatives/first-time-filer-pilot-program/first-time-filer-expedited-examination-pilot-program#type-browse-faqs\\_208685](https://www.uspto.gov/initiatives/first-time-filer-pilot-program/first-time-filer-expedited-examination-pilot-program#type-browse-faqs_208685)

To avail this opportunity, Applicants must electronically file a petition to make a special request under this program using Form PTO/SB/464 once the patent application is in complete form under 37 Code of Federal Regulations (hereinafter referred as "CFR") 1.51(b) before the USPTO. The Applicant must indicate in the petition: his certification of micro-entity status using Form SB/15A, the first filing status of the inventor(s), and the trained status of the inventor(s) on the basis of USPTO's patent application requirements. The request for this petition does not require payment of any official fee.

The program has its own limitations due its unavailability to inventor(s) with patent applications of the type: design, plant, child applications (continuation, continuation-in-part, divisional, and bypass), Convention application, and PCT national phase US application.

#### *Accelerated examination program:*

USPTO offers the option of a petition under paragraph (c) of 37 CFR 1.102 to the applicant for a patent application to be considered for an accelerated examination program<sup>5</sup>.

<sup>5</sup> <https://www.uspto.gov/web/offices/pac/mpep/s708.html>

An Applicant can “request a petition to make special” under 37 CFR 1.102(c), using Form PTO/SB/28 and without incurrance of any official fees, along with the evidence for the following grounds:

1. If the Applicant’s age is 65 or more, or the Applicant’s health is subject to conditions that would make him unavailable for the duration of normal prosecution; or
2. The invention of the patent application will materially:
  - (i) Contribute to improving the quality of the environment in terms of the restoration or maintenance of the basic life-sustaining natural elements, such as air, water, and soil;
  - (ii) Contribute towards the development or conservation of energy resources by (A) discovering or developing energy resources, or (B) enhancing the efficient utilization and conservation of energy resources; or
  - (iii) Contribute to the development of technology for countering terrorism.

#### ***Prioritized examination:***

Track one or prioritized examination program offered by USPTO under paragraph (e) of 37 CFR 1.102, allows the

Applicant of a non-provisional utility patent application having four or less independent claims, thirty or less total claims, with no multiple dependent claim, to fast-track examination of its patent Application by filing a request electronically at EFS-Web, Patent Center. However, the bar added here is that USPTO allows 15,000 requests per fiscal year under this route. The information of Track One filing rate can be obtained from <https://www.uspto.gov/dashboard/patents/special.html>.

This request can be filed along with the application or during filing of Request for Continued Examination (RCE). Track one request must be accompanied by fees associated with prioritized examination (37 CFR 1.17(c)), prioritized examination processing (37 CFR 1.17(i)(1)), and when filed along with the patent application, publication fees under 37 CFR 1.18(d) must be paid. Once the request for Track one is granted by USPTO, a final outcome of the examination is generally made within twelve months.

The Track one route is also available for plant patent applications, by placing a request in paper, or electronically.

It should be noted that the prioritized examination under Track one is not available for PCT-national phase application before USPTO as designated or elected state. However, this

should not stop the Applicant from benefiting from the track one route. For a national phase US-application, the applicant can file a bypass-continuation application, wherein said bypass application claims either the benefit or the right of priority of the PCT application.

If the prosecution of the national phase US-application concludes in terms of issuance of Final Office Action, Notice of Allowance or any other action, the applicant can request Track one along with RCE to initiate the expedited continued examination.

Other applications that are not eligible under Track one prioritized examination are those related to design, reissue, provisional, or re-examination proceedings.

Applicants may lose the special status granted under Track one, if any of the following occurs:

- a. an extension petition is requested for filing a reply;
- b. claims are amended to include more than four independent claims, more than thirty total claims, or a multiple dependent claim;
- c. RCE is requested;

- d. notice of appeal is filed;
- e. suspension of action is requested;
- f. issuance of Final Office Action or Notice of Allowance;
- g. abandonment of the patent application; and
- h. completion of examination under 37 CFR 41.102.

### ***Patent Prosecution Highway (PPH):***

USPTO is also part of Global and IP5 PPH programs as well as bilateral PPH agreements, which allows the examination of the patent application before USPTO to be expedited if a grant or allowance of a corresponding application is received from the following foreign Patent Offices: Austria, Australia, Brazil, Canada, Chile, China, Colombia, Czech, Denmark, Estonia, Europe, Finland, France, Germany, Hungary, Iceland, Israel, Japan, South Korea, New Zealand, Nordic, Norway, Nicaragua, Malaysia, Mexico, Morocco, Peru, Poland, Portugal, Philippines, Romania, Singapore, Spain, Sweden, Saudi Arabia, Taiwan, United Kingdom, and Visegrad<sup>6</sup>.

The PPH request at USPTO can be made without incurring any official fee, by filing request Form SB/20GLBL for global PPH and Form SB/20<countrycode> for bilateral PPH as

<sup>6</sup> <https://www.uspto.gov/patents/basics/international-protection/patent-prosecution-highway-pph-fast-track>



available at USPTO before the beginning of patent examination. Additionally, along with the request, a copy of the allowable work product of corresponding Patent Office, an English translation thereof (if required), and an IDS listing the references cited by said corresponding Patent Office.

One must note that PPH expedited route is not available for US applications filed provisionally, towards reissue, those relating to plant or design, or subject to secrecy order.

Upon comparison with Track one, it should be noted that PPH request need not be made along with the filing of the patent application, and filing extensions in reply to Patent Office communications are allowed without the application losing the expedited status, however, it does not offer a 12-month final disposition of the patent application.

#### *Cancer Moonshot Pilot Program<sup>7</sup>:*

Efforts made by Inventor(s) and Applicant(s) towards the reduction in cancer mortality rate are recognized by the USPTO, offering an expedited review of applications for patent that are related to cancer technologies under the Cancer Moonshot Expedited Examination Pilot Program currently

available till January 31, 2025, or up to the grant of 1000 petitions under said program, whichever is earlier.

The petition is available for e-filed direct US application and PCT national phase US applications having up to 3 independent claims and 20 total claims<sup>8</sup>, and can be made before the issuance of office action under Form PTO/SB/465, free of official charges, and by fulfilling the requirement of eligible subject matter.

This route is unavailable to applicants of the patent application, where any one of the inventor(s) has already been named in nine patent applications made special under this petition.

#### **Conclusion:**

It can be said that the Patent Offices including IPO, EPO and USPTO have made considerable efforts over the years in ensuring that the routes of expediting examination are made available to the applicants of varying entity status, thereby enabling them to make effective choices in achieving early grant in a jurisdiction, and utilizing the provisions of PPH in

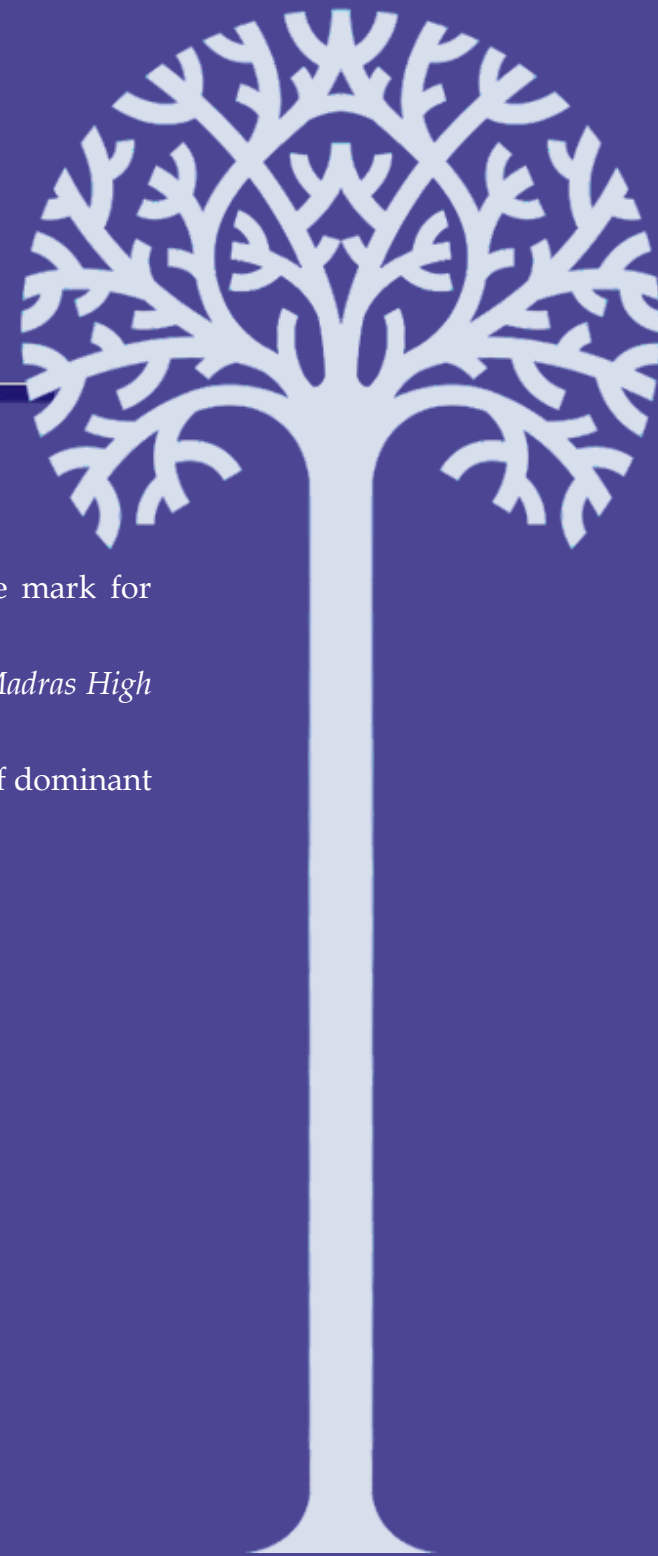
<sup>7</sup> <https://www.uspto.gov/patents/initiatives/patent-application-initiatives/cancer-moonshot-expedited-examination>

<sup>8</sup> <https://www.federalregister.gov/documents/2022/12/09/2022-26776/cancer-moonshot-expedited-examination-pilot-program>

obtaining grants in other jurisdictions. The responsibility now lies on the Applicant to maneuver the routes with careful consideration in order to find the best outcome for its patent application.

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# Ratio Decidendi



- Trademark application is in ‘bad faith’ when applicant has no genuine intention to use the mark for goods/services for which protection sought – *UK Supreme Court*
- Trademark – Service of documents by Registrar – Rule 18(2) to be purposively interpreted – *Madras High Court*
- Trademark – Use of dominant feature for identical goods, though with a prefix, is fatal – Rule of dominant feature is not antithetical to principle of anti-dissection – *Delhi High Court*

## Trademark application is in 'bad faith' when applicant has no genuine intention to use the mark for goods/services for which protection sought

The UK Supreme Court has upheld the decision of the High Court wherein the High Court had found that the respondent (as before the SC) had applied for the specified trademarks in part in 'bad faith'. The High Court had observed that the trademark specifications included goods and services in relation to which the respondent had never intended to use the marks, and that the categories of goods and services were so broad that the respondent could not have intended to use the marks across their breadth. The UK Court of Appeal had earlier set aside the 'bad faith' decision of the High Court.

The Supreme Court thus answered in positive the central issue litigated before it, which was whether a registration of a trademark can be invalidated in whole or in part on the basis that the application to register the mark was made in bad faith because the applicant did not, at the time the application was made, have a genuine intention to use the mark in relation to some or all of the goods or services for which it sought protection.

The Supreme Court for this purpose accepted that the reputation and goodwill attaching to a business involved in supplying goods/services under a mark may render that mark more distinctive and confer on the owner a broader degree of protection than might otherwise be the case and may also be some indication of the wider ambitions of the owner for its future trade. However, the Court was of the view that this does not justify applying to register a mark in respect of goods or services which that applicant or owner has never had any intention to supply or provide.

The Apex Court thus disagreed with the finding of the Court of Appeal that having a reputation meant that it was permissible for the business to apply to register a mark in respect of categories or sub-categories of goods or services which it never had any intention (even conditionally) to sell or supply.

*[SkyKick UK Ltd. and another v. Sky Ltd. and others – Judgement dated 13 November 2024, [2024] UKSC 36]*

## Trademark – Service of documents by Registrar – Rule 18(2) to be purposively interpreted

Giving purposive interpretation of Rule 18(2) of the Trademark Rules, 2017, the Madras High Court has, in the circumstances of

the case, answered in negative the question as to whether it would suffice for the purpose of complying with the requirements of said Rule if the Trade Mark Registry had dispatched the email notice to the e-mail address given by the applicant in his trademark application seeking for registration of a trademark.

Setting aside the trademark application abandonment order (as the applicant-appellant had failed to file counterstatement), the Court observed that while the appellant submitted that he had not received the notice, the Trademark Registry, excepting for producing despatch details and opposition details, had not placed on record any other proper acknowledgment from the appellant for having received the notice in the opposition petition.

The High Court in this regard also noted that the applicant had filed counterstatements in other three opposition petitions pertaining to three different applications for trademark registration. According to the Court hence, the applicant should not be left high and dry, when he categorically contends that he has never received notice.

The applicant was thus deemed to have not received the notice from the Trademark Registrar.

It may be noted that Rule 18(2), which pertains to service of documents by the Registrar, stipulates that any communication or document sent by the Registrar shall be deemed to have been served at the time when the letter containing the same would be delivered in the ordinary course of post or at the time of sending the e-mail.

[*Samsudeen A v. Registrar of Trade Marks* – Judgement dated 7 November 2024 in C.M.A(TM) No.10 of 2024, Madras High Court]

### **Trademark – Use of dominant feature for identical goods, though with a prefix, is fatal – Rule of dominant feature is not antithetical to principle of anti-dissection**

The Delhi High Court has granted interim relief against use of the mark 'Alder Biochem' by the defendant in a case where the plaintiff/petitioner was the prior user of the label mark 'Biochem'. The Court in this regard noted that the prominent, essential and dominant feature of the plaintiffs' mark was the word 'BIOCHEM', which was being used by the defendant for identical goods, i.e., pharmaceutical products. It was reiterated that the rule of dominant feature of a trademark is not antithetical to the principle of anti-dissection and that upon a



comparison of the competing marks as a whole, the defendant's mark is clearly infringing, since it prominently uses the dominant and essential part of the registered mark of the plaintiffs.

Granting interim relief, the Court also reiterated that when a label mark is registered, it cannot be said that the word mark contained therein is not registered, and that the word contained in the label mark is also worthy of protection.

The Court was also of the view that the rival marks were no doubt structurally, phonetically and visually, deceptively and/or confusingly similar to each other. According to the Court, confusion is bound to take place as the rival marks are

used in respect of similar goods, i.e., pharmaceuticals, and the trade channels as well as the purchasing public/target consumer are likely to overlap.

Defendant's submission that the word 'Biochem' is common to the trade was rejected by the Court while it observed that nothing was put on record by the defendant on usage of the mark 'BIOCHEM' by the third parties on pharmaceutical products.

*[Zydus Healthcare Limited v. Alder Biochem Private Limited – Judgement dated 13 November 2024 in CS(COMM) 516/2023, Delhi High Court]*



# News Nuggets

- Trademarks – No structural or phonetical similarity between 'Brufen' and 'Mebufen'
- Trademarks – Distinctiveness in combination of generic words
- Trademark 'Jan Aushadhi' – Use of 'Jan Aushadhi Sangh' enjoined; damages ordered
- Amendment to plaint after registration of mark to include case of infringement, permissible
- Copyright infringement – Publishers sue Artificial Intelligence firm
- Trademark – EU IPO rejects registration of figurative mark 'BOSSPOWERL'
- 'Shorts' – Google wins trademark suit filed by Shorts International
- Patents – Preliminary injunction granted against launch of LEQSELVI in USA

## Trademarks – No structural or phonetical similarity between ‘Brufen’ and ‘Mebufen’

The Delhi High Court has held that there is no structural or phonetical similarity between the rival marks ‘BRUFEN’ and ‘MEBUFEN’. Upholding the impugned order by the Trademark Registrar, refusing the opposition to registration of the mark ‘MEBUFEN’ by the proprietor of the mark ‘BRUFEN’, the Court noted that the marks were quite dissimilar, and no confusion was being caused while pronouncing the said marks by a person of average intelligence. The Court in this regard also noted that the rival marks have different prefixes i.e., ‘BRU’ and ‘MEBU’, which are strikingly dissimilar. It was also held that the petitioner (the one who filed opposition) cannot claim exclusivity over ‘FEN’, the common suffix used in both marks, as the same was derived from the chemical element ‘IBUPROFEN’ which is used in both medicines. The High Court in *Abbott GMBH v. Registrar of Trademarks* [Decision dated 22 October 2024] distinguished Bombay High Court decision in *Boots Company PLC* and Delhi High Court decision in *Glenmark Pharmaceuticals*.

## Trademarks – Distinctiveness in combination of generic words

Observing that merely because the word ‘Planet’ is a generic term, the mark ‘Planet E School’ taken as a whole, cannot be rejected, the Delhi High Court has set aside the order of the Trademark Registry rejecting the application for registration of trademark ‘Planet E School’ for providing educational services. The Court in this regard also noted that the mark was a combination of the words, ‘Planet’, ‘E’ and ‘School’, and though when seen independently, the said words are generic, when the said words are combined, it acquires distinctiveness and a unique character. It was hence reiterated in *Grey Matters Educational Trust v. Examiner of Trademarks* [Judgement dated 23 October 2024] that when viewed as a whole, the mark is distinctive and capable of distinguishing the goods or services of one person from those of another person.

## Trademark ‘Jan Aushadhi’ – Use of ‘Jan Aushadhi Sangh’ injuncted; damages ordered

The New Delhi District Court has issued permanent injunction against use of the name ‘Jan Aushadhi Sangh’ by an organisation in Madhya Pradesh. ‘Jan Aushadhi’ is a registered trademark of Pradhan Mantri Bhartiya Janaushadhi Pariyojana (PMBJP) of the

Department of Pharmaceuticals, Government of India. According to the Press Release dated 16 October 2024 of the Ministry of Chemicals and Fertilisers, as available [here](#), the Court has ordered the violator and its proprietors, partners, etc. restraining them from using the said mark 'Jan Aushadhi' in any manner. The Court in this regard also ordered damages of INR 10 lakh in favour of the Government department.

### Amendment to plaint after registration of mark to include case of infringement, permissible

In a suit involving alleged infringement of copyright in the packaging containing the mark, the Delhi High Court has allowed an application to amend the plaint to include case of infringement of the trademark after the mark got registered subsequent to the closure of plaintiff's evidence in the present trial. Rejecting the defendant's plea of bar under Order VI Rule 17 CPC, the Court reiterated that if an amendment is necessary for deciding the real controversy between the parties and for arriving at a just conclusion, such amendment can be allowed even at a later stage. Allowing the application, the Court in *Pravesh Narula Trading v. Raj Kumar Jain Trading* [Judgement dated 29 October 2024] also noted that the cause of action for infringement and passing off actions are based on same set of facts.

### Copyright infringement – Publishers sue Artificial Intelligence firm

The Wall Street Journal and the New York Post have filed a lawsuit in a US court recently against Artificial Intelligence ('AI') company Perplexity AI, alleging massive copyright infringement and trademark violations. As per a *ET Legal World* news report available [here](#), the lawsuit alleges that unlike the business model of a traditional internet search engine, Perplexity's business model does not drive business toward content creators, but on the contrary, it usurps content creators' monetization opportunities for itself.

### Trademark – EU IPO rejects registration of figurative mark 'BOSSPOWERL'

The EU Intellectual Property Office ('EU IPO') has rejected a trademark application from a Chinese electronics firm for the figurative mark 'BOSSPOWERL', finding that it was 'free riding' on the reputation of luxury fashion house Hugo Boss's earlier marks. As per *Global Legal Post* news item, as available [here](#), the opposition filed by Hugo Boss was based on its earlier EU Trade Mark registrations for the word marks 'BOSS' and for a figurative BOSS mark. The news in this regard states that the EU IPO also ruled that "*Visually and aurally, the signs coincide in the*

*distinctive component 'BOSS' and its sound. They differ in the weak at best component 'POWER' and the not particularly distinctive letter 'L' (and their sound)''.*

## **'Shorts' – Google wins trademark suit filed by Shorts International**

Google has won a trademark lawsuit filed by Shorts International over the word 'Shorts' used in YouTube's short video platform. As per *ET Legal World* news report available [here](#), Shorts International, which runs a television channel devoted to short films, sued the tech giant last year, accusing the latter of infringing its trademark over the word 'Shorts'. The UK High Court decision has also stated that none of Google's uses of the word 'shorts' would lead to any likelihood of confusion as to the origin of the platform. The news report also states that the Court was of the view that Google and YouTube's use of the

word will not cause damage to the distinctive character or repute of (Shorts International's) trademarks.

## **Patents – Preliminary injunction granted against launch of LEQSELVI in USA**

The U.S. District Court has on 1 November 2024 granted a preliminary injunction delaying the launch of LEQSELVI by Sun Pharma, due to a patent infringement lawsuit filed by Incyte Corporation. According to the *ET Legal World* news report available [here](#), due to the injunction, Sun Pharma has been stopped from launching LEQSELVI until a subsequent favorable court decision or until the expiry of the patent in lawsuit, whichever is earlier. The news report also states that the US FDA had earlier on 25 July 2024 approved LEQSELVI (deuruxolitinib) 8 mg tablets for the treatment of adults with severe alopecia areata.



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