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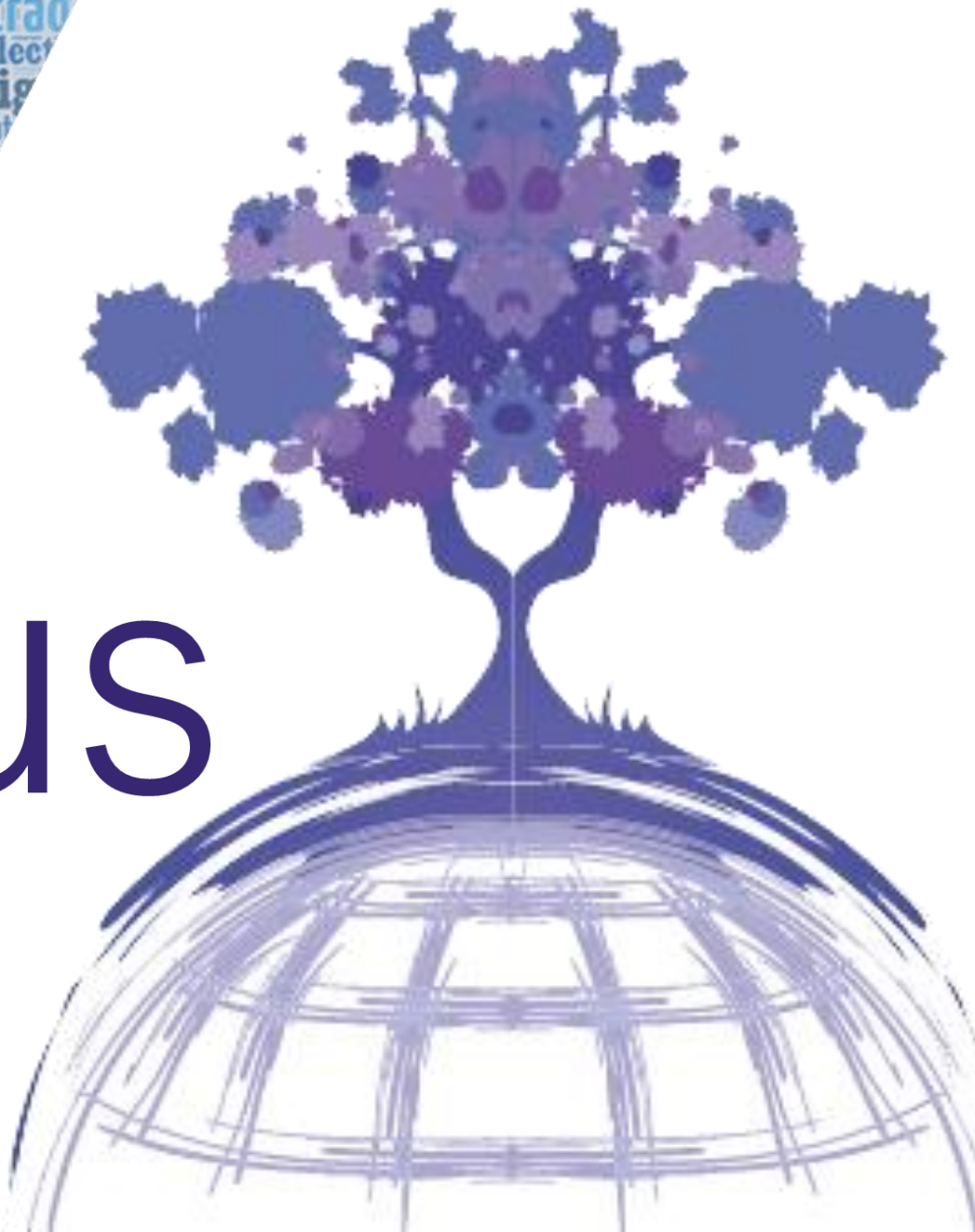

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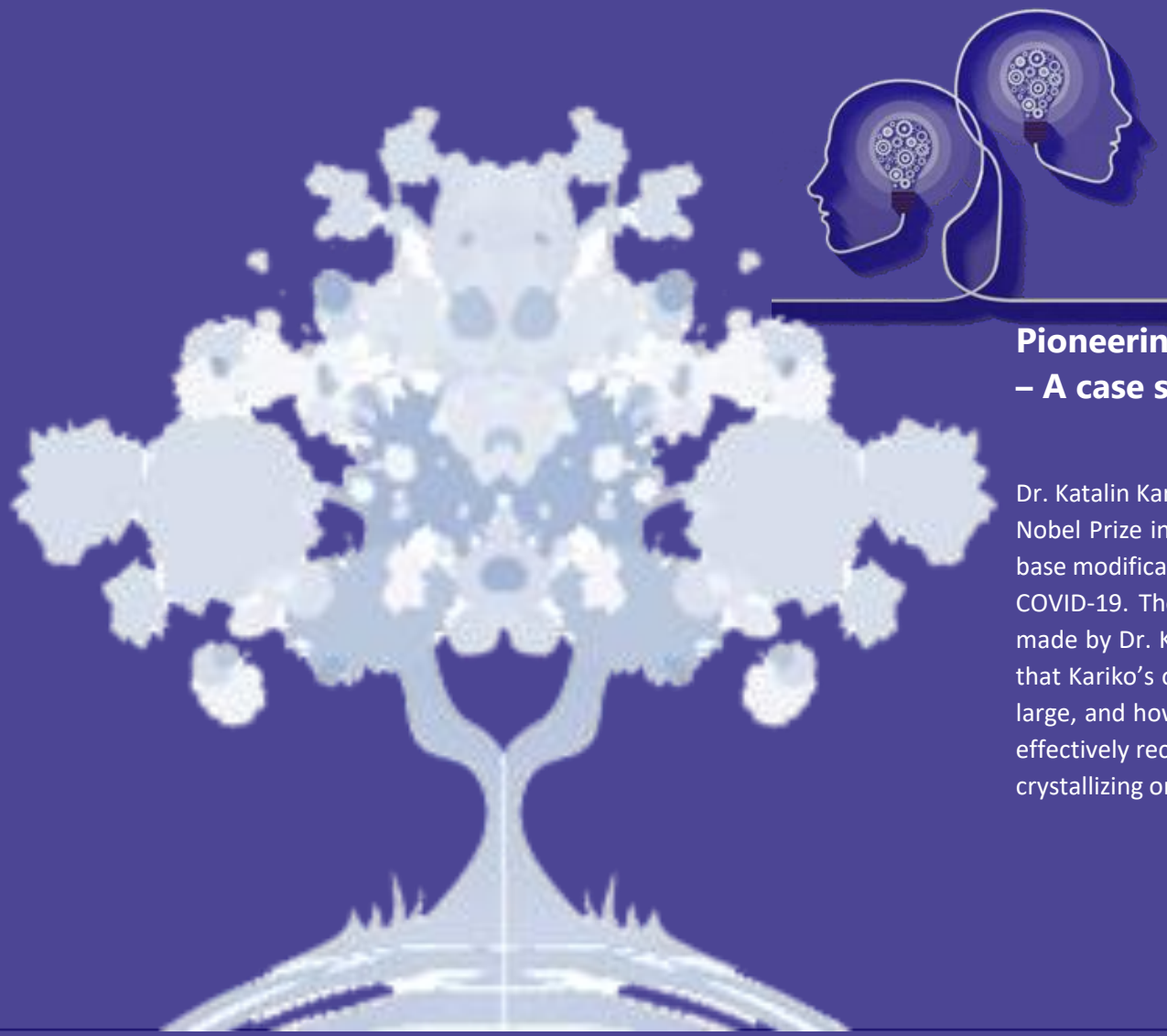

Article

Pioneering work in the field of mRNA-based innovations – A case study

By **Dr. Malathi Lakshmikumaran and Supriya Ramacha**

Dr. Katalin Kariko and Dr. Drew Weissman have been named the winners of the 2023 Nobel Prize in Physiology and Medicine for their innovations concerning nucleoside base modifications that enabled the development of effective mRNA vaccines against COVID-19. The article in this issue of IPR Amicus traces the various developments made by Dr. Katalin Kariko in the field of RNA based therapeutics. The authors note that Kariko's objectives aligned with BioNTech's mission to improve public health at large, and how their approach to exploit the full potential of the immune system to effectively recognise and combat external and internal threats has been successful in crystallizing on novel therapeutics for cancer and vaccines to combat Covid-19.

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Pioneering work in the field of mRNA-based innovations – A case study

By Dr. Malathi Lakshmikumaran and Supriya Ramacha

Dr. Katalin Kariko and Dr. Drew Weissman have been named the winners of the 2023 Nobel Prize in Physiology and Medicine for their innovations concerning nucleoside base modifications that enabled the development of effective mRNA vaccines against COVID-19.

Katalin Kariko's and Drew Weissman's invention based on modified mRNA technology is revolutionary in the field of RNA based therapeutics. Their main focus has been on RNA mediated mechanisms and their work has been instrumental in widening the therapeutic potential of mRNA. Kariko's work has accorded her various accolades including the prestigious Japan Prize, the Paul Ehrlich award, the Gairdner award, the Kovalenko medal, the Breakthrough prize and the Lasker prize.

Born in Hungary, Kariko's interest in RNA and modified nucleosides has been constant since her early years of research at the Biological Research Centre (BRC), Szeged. In 1985, she moved to the US, where she went on to work at the University of Pennsylvania (Penn) and hasn't looked back ever since. It was at Penn, with Dr. Elliot Barnathan, a cardiologist, where she demonstrated that successful introduction of mRNA into cells could be used to direct the expression of specific proteins of interest. With this initial break through, Kariko was determined to extend her work to gene therapy applications.

While her determination and persistence in exploiting RNA mechanisms have always been untiring and unwavering, her struggle in making a successful mark in the field has not been easy, especially at a time when RNA based therapeutics were considered unconventional. As is the case with many remarkable innovators, finding resources and support was a challenge. Even Kariko, who is now considered a pioneer and forerunner of advanced mRNA vaccine, was then moving against the tides with her revolutionary approaches. Securing funds and getting grants for continuing her research in an area that was considered new and far-fetched was unsurprisingly even more difficult. Her love for work and out-of-the-box thinking are what kept her moving forward in her pursuit of successful integration of RNA mechanisms in gene therapy based applications.

A huge breakthrough came in 2005, when Kariko, along with her colleague Drew Weissman, successfully developed modified mRNA molecules having reduced immunogenicity. This technology and various other modifications of RNA arising therefrom have been meticulously protected through a series of patents in multiple jurisdictions. One such PCT Application (*WO2007024708)* titled "*RNA containing modified nucleosides and methods of use thereof*" which was filed by the Trustees of the University of Pennsylvania (Penn), matured to granted patent in several jurisdictions, including the US and Europe. The main claim, in these patents, is directed

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towards an RNA molecule containing a pseudouridine residue. Kariko successfully showed that mRNA containing pseudouridine did not activate double stranded RNA (dsRNA)-dependent protein kinase (PKR). One of the reasons for the increase in translation efficiency was later demonstrated by evaluation of the translation efficiency of pseudouridine modified mRNA and unmodified mRNA in PKR knockout cells[1]. Kariko also found that RNA containing modified nucleosides such as s^2U, 5-methylcytidine (m^5C) or 6-methyladenosine (m^6A) showed a similar enhancement in translation of efficiency which could be furtherincreased by 10 folds on adding a Poly-A tail. Further, the application also includes the transcribed RNA molecule, gene therapy vector, invitro transcription kits, method of synthesis and double stranded RNA molecules containing the pseudouridine residue or a modified nucleoside.

While the *PCT* application was filed in 2006 (claiming priority from EP19168984.3A) and published in 2007, it was only later, through a series of experimental studies, that Kariko and her colleagues found that the increase in translation efficiency is attributable to the poor binding of modified mRNA to PKR, which in turn led to the inhibition in the activation of PKR. It was observed that unmodified mRNA strongly binds and activates PKR which led to a supersession in translation.

The inventor's modified mRNA was successfully applied to various gene therapies for treating various conditions such as cystic fibrosis, x-linked agammaglobulinemia, vasospasm, niemann-pick disease, prevention of organ rejection, restoration of hair growth, etc. The patent includes claims directed towards methods of treating anemia, vasospasm, decreasing an incidence of a restenosis of a blood vessel, increasing a hair growth from a hair follicle in a scalp, inducing expression of an enzyme in a cell, treating cystic fibrosis, X-linked agammaglobulinemia, adenosine deaminase severe combined immunodeficiency (ADA SCID), etc. using the modified RNA molecules.

RNA preparations comprising purified modified RNA for reprogramming cells are another pathbreaking innovation patented across multiple jurisdictions, including the US, Europe and Japan. With the discovery of the Yamanaka factors in 2006[2], the research fraternity was stirred with the innovative concept of reprogramming differentiated somatic cells to obtain induced pluripotent stem cells (iPSC). In 2007, successful reprogramming of human adult somatic cells using the Yamanaka factors was also reported. It paved the way for development of allogenic and personalized cell-based therapies. Sir John B. Gurdon and Shinya Yamanaka were awarded the 2012 Nobel Prize in Physiology or Medicine for the discovery that mature cells can be converted to stem cells. The delivery of the genes encoding the Yamanaka factors was popularly through lentiviral and retroviral delivery systems. It was crucial, at the time, to find alternative non-viral ways of delivery, as viral delivery was associated with risks of

[1] *Anderson BR, Muramatsu H, Nallagatla SR, Bevilacqua PC, Sansing LH, Weissman D, Karikó K. Incorporation of pseudouridine into mRNA enhances translation by diminishing PKR activation. Nucleic Acids Res. 2010 Sep;38(17):5884-92. doi: 10.1093/nar/gkq347. Epub 2010 May 10. PMID: 20457754; PMCID: PMC2943593.)*

[2] *Takahashi K, Yamanaka S. Induction of pluripotent stem cells from mouse embryonic and adult fibroblast cultures by defined factors. Cell. 2006 Aug 25;126(4):663-76. doi: 10.1016/j.cell.2006.07.024. Epub 2006 Aug 10. PMID: 16904174.*

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unpredictability and tumorigenicity[3]. With these advances in technology, Kariko and her colleagues were motivated to explore the possibilities of mRNA mediated cellular reprogramming.

Kariko's deep understanding of RNA mediated mechanisms and mRNA mediated immuno-stimulation culminated into the patented technology described in *WO2017036889*. Kariko's modified mRNA molecules, having reduced immunogenicity, demonstrated greater than 40-fold efficiency in delivering the reprogramming factors as compared to, then popular, lentiviral delivery systems. Key advantages achieved by the modified mRNA mediated delivery are that the RNA does not incorporate into the genome and its translation is instantaneous. Additionally, the lack of immunogenicity of the modified mRNA enables repeated delivery without the generation of inflammatory cytokines.

While the concept of *in vitro* transcribed mRNAs (IVT mRNA) as a new class of therapeutics was first developed in 1992, Kariko and her colleague's work solved the long existing problem of immunogenicity associated with IVT mRNAs which blocked the way for protein based therapeutic approaches. With the discovery of Pseudouridine modified IVT mRNA which paved way for many other future works, Kariko and her colleague were fuelled to explore alternative IVT mRNA technologies to be translated into vaccines. They further went on to find that IVT mRNA does not necessarily require the use of modified nucleosides for exhibiting low immunogenicity and increased translatability, and that the same could be achieved using mRNA constructs with low uridine and increased adenosine content. A PCT Application (WO2017036889A1), filed in 2016 by BioNTech, is a PCT application directed towards a method for reducing immunogenicity of RNA using mRNA having such modified nucleotide sequences.

Kariko's work with BioNTech started in 2013, where she was the vice president at RNA protein replacement therapies and went on to developing various technologies that were protected by BioNTech.

With the outbreak of Coronavirus in 2019, Kariko and her colleagues were determined to extend their findings on modified mRNA mediated efficient translation systems to develop a vaccine against SARS-CoV-2, famously called as mRNA vaccine. The mRNA based vaccine, claimed in the patent application *WO2021213924* filed in 2021 by BioNTech, was undoubtedly one of the significant achievements in protein-based approaches for vaccines against Coronavirus. The claims of this PCT Application are directed towards composition and methods for inducing an immune response against Coronavirus. The vaccine comprises a modified RNA encoding an immunogenic fragment of SARS-CoV-2 spike protein (S protein) for eliciting an immune response against the Coronavirus. Kariko's and BioNTech's innovations have also been protected using patent applications including *WO2019175356A1* directed towards 5'-cap-trinucleotide- or higher oligonucleotide compounds and their uses in stabilizing RNA molecules, expressing

[3] *Nakagawa M, Koyanagi M, Tanabe K, Takahashi K, Ichisaka T, Aoi T, Okita K, Mochiduki Y, Takizawa N, Yamanaka S. Generation of induced pluripotent stem cells without Myc from mouse and human fibroblasts. Nat Biotechnol. 2008 Jan;26(1):101-6. doi: 10.1038/nbt1374. Epub 2007 Nov 30. PMID: 18059259.*

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proteins and in therapy; *WO2021214204A1* describing RNA polynucleotides with a 5' Cap, a 5' UTR comprising a cap proximal sequence; and *WO2017182524A1* directed towards a method to remove double-stranded RNA (dsRNA) contaminants from single-stranded RNA (ssRNA) suitable for therapy, in addressing certain challenges that are associated with RNA based therapeutics.

Kariko's objectives aligned with BioNTech's mission to improve public health at large. BioNTech's operational excellence and Kariko's expertise amalgamated into achieving various innovative immunotherapeutic platform technologies. Their approach to exploit the full potential of the immune system to effectively recognise and combat external and internal threats has been successful in crystallizing on novel therapeutics for cancer and vaccines to combat COVID-19. With Kariko's illustrious achievements, and her decade long association with BioNTech, she still continues to share her extensive experience and knowledge by taking on the role of an external consultant with BioNTech.

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Ratio Decidendi

- Patents – Explanation to Section 3(d) is not applicable to enzyme/biochemicals – Madras High Court
- Patents – Improved thermostability gives 'enhancement of the known efficacy' of substance – Madras High Court
- Patents – Determination of foetal fraction is related to diagnosis but is not 'diagnostic', and hence is patentable – **Madras High Court gives elaborate decision clarifying on scope of word 'diagnostic' in Section 3(i)**
- 'Appropriate Office' under Patents Rule 4 is not dispositive of jurisdiction of High Court under Article 226 of Constitution – Madras High Court
- Patents – Divisional Applications – Disclosure of plurality of inventions in provisional or complete specification is sufficient – Delhi HC Single Bench decision in *Boehringer Ingelheim* overruled – Division Bench of Delhi High Court
- Trademark 'Vajirao & Reddy' is not deceptively similar to 'Vajiram' or 'Vajiram & Ravi' – No likelihood of confusion between 'Vajiram' and 'Vajirao', despite structural similarities – Delhi High Court

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(i) Patents – Explanation to Section 3(d) is not applicable to enzyme/biochemicals

(ii) Patents – Improved thermostability gives 'enhancement of the known efficacy' of substance

Relying on the principal of *ejusdem generis* in the construction of the expression 'and other derivatives of known substance', as it appears in Explanation to Section 3(d) of the Patents Act, 1970, the Madras High Court has held that the said Explanation was inapplicable to the claimed invention, which was for variants of phytase, i.e. an enzyme/biochemical.

The Court in this regard noted that the enumerated derivatives [in the Explanation] fell within the scope of a common genus, namely, derivatives of synthesized chemicals, and that derivative forms of biochemicals [as in the present case] were distinguishable from the derivatives of synthesised chemicals, including those listed in the Explanation to Section 3(d). According to the Court, the above finding was also in consonance with the decision of the Division Bench of the High Court in *Novartis AG* v. *Union of India* [Manu/TN/1263/2007].

The Court also noted that the Explanation does not apply to Section 3(d) in entirety, as underscored by its undoubted inapplicability to the third limb of Section 3(d), which deals with known processes, known machines and known apparatuses.

It may be noted that the Court further observed that even if application of the Explanation was excluded and appellant may claim that phytase variants are new forms of a known substance, it would still require to pass the filter of 'result in the enhancement of known efficacy of that substance' prescribed in the substantive provision *de hors* the Explanation.

Improved thermostability is 'enhanced efficacy'

The Court, on the question of enhanced efficacy also, upheld the assertions of the appellant that the claimed invention results in improved thermostability and that such improved thermostability should be construed as an enhancement of the known efficacy of the product phytase. The High Court in this regard observed that since increased thermostability precludes denaturation and enables production, storage, and sale in pellet form, it enhances the known efficacy of the enzyme in aiding digestion especially when used in animal feed. The Patent Office had contended that thermostability is an inherent or at least desirable characteristic of phytase and hence enhanced thermostability is insufficient to establish enhanced efficacy.

The High Court also observed that there is nothing in the text of Section 3(d) that limits such enhancement to any specific type of efficacy, or which supports the interpretation that enhancement of known efficacy of the substance should be restricted to engineering or prospecting variants of phytase with inherently greater enzymatic activity over the reference phytase.

Section 3(e) – Effect of absence of word 'known'

Further, declining to read the adjective 'known' into Section 3(e) of the Patents Act, 1970 and place it before the noun 'components'

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therein, the Court held that if any of the ingredients of the composition independently satisfies the requirements for an invention under the Patents Act, a patent may be applied for and granted in respect thereof notwithstanding Section 3(e). [*Novozymes* v. *Assistant Controller of Patents & Designs* – Judgement dated 20 September 2023 in (T) CMA (PT) No.33 of 2023, Madras High Court]

Patents – Determination of foetal fraction is related to diagnosis but is not 'diagnostic', and hence is patentable – Scope of word 'diagnostic' in Section 3(i) clarified

Allowing the appeal of the patentee, the Madras High Court has held that determination of foetal fraction is related to diagnosis but is not 'diagnostic' to include in the coverage of Section 3(i) of the Patents Act, 1970 and thus exclude from patent eligibility. The Patent Office in this case had denied the grant of a patent holding that the invention entitled 'Fetal Genomic Analysis From a Maternal Biological Sample' was a process of diagnosing that the foetus is suffering from genetic or other diseases.

The Court was of the view that if it is concluded that a diagnosis for treatment may be made, even if such diagnosis is not definitive, it would be patent ineligible, whereas, if diagnosis for treatment cannot be made, it would be patent eligible. According to the Court, for a test to be diagnostic, the question which is required to be asked is whether the test is inherently and *per se* capable of identifying the disease, disorder or condition for treatment of the person.

The High Court, in this regard, also stated that if the person skilled in the art, including a medical doctor, would not be in a position to diagnose the disease, disorder or condition, as the case may be, on the basis of the process because the process is not designed such, such process, whether labelled as screening or anything else, would not qualify as diagnostic for purposes of Section 3(i).

On the facts of the case, the Court deliberated upon the basic science behind non-invasive prenatal testing and observed that in the present case the biological sample is drawn from the pregnant female subject, the nucleic acid molecules in such biological sample are tested with a view to identify the foetal fraction, i.e. the proportion of cell free foetal DNA in the biological sample. It noted that medical literature indicates that the foetal fraction should be not less than 4% to enable further testing to identify chromosomal aberrations, such as chromosomal aneuploidies, and until that stage is reached, pathology is not uncovered and, consequently, treatment is not possible. The Court hence held that the claimed invention was *per se* incapable of identifying the existence or otherwise of a disease, disorder or condition and further testing would be required for such purpose.

It may be noted that the Court though held that the expression 'diagnostic' in Section 3(i) extends both to *in vitro* and *in vivo* diagnosis, it was of the view that there is a case to consider options such as restricting the scope of the expression 'diagnostic' in Section 3(i) to *in vivo* processes and counter balancing by providing for compulsory licensing. The Court in this regard also noted that

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the Patent Office has granted patents to *in vitro* processes and there is inconsistency.

While allowing the patent to proceed for grant, the High Court also gave its findings on different other aspects of Section 3(i). **A detailed analysis of the Madras High Court decision is available here.** [*Chinese University of Hong Kong* v. *Assistant Controller of Patents & Designs* – Judgement dated 12 October 2023 in CMA (PT) No.14 of 2023, Madras High Court]

'Appropriate Office' under Patents Rule 4 is not dispositive of jurisdiction of High Court under Article 226 of Constitution

The Single-Judge Bench of the Madras High Court has held that the jurisdiction of a High Court under Article 226 of the Constitution of India is not dependent on where the 'appropriate office' is situated as regards a patent application. According to the Court, Rule 4 of the Patents Rules, 2003 is not dispositive of the jurisdictional question when the petition is filed under Article 226 of the Constitution of India. It may however be noted that the High Court also observed that 'appropriate office' is not irrelevant and is one aspect to be weighed in the balance along with all other relevant considerations.

Rejecting the challenge to the jurisdiction of the Court, the Madras High Court observed that while the concerned patent application was filed before the Delhi Patent Office, the Controller who was assigned the matter, right from the stage of examination of the patent application to deciding the grant, was from the Chennai Patent office. It was hence of the view that it cannot be concluded that no part of the cause of action arose within the jurisdiction of the Court. Principles enunciated in in *Kusum Ingots & Alloys Ltd.* v. *Union of India,* [(2004) 6 SCC 254] and *Sanjos Jewellers and Others* v. *Syndicate Bank and Ors.* [2007.4.L.W. 473] were relied upon.

On the aspect of *forum conveniens,* the Court held that since most of the critical events relating to the prosecution and adjudication of the application for grant took place in Chennai, the facts necessary to decide the case would be readily and conveniently accessible in Chennai. The Court reasoned that based on the facts of the matter, it cannot be concluded that the Madras High Court was an inconvenient forum for the adjudication of the instant writ petition. [*Adiuvo Diagnostics Private Limited* v. *Union of India and Ors.* – Judgement dated 27 September 2023 in WP(IPD)/23/2023, Madras High Court]

Patents – Divisional Applications – Disclosure of plurality of inventions in provisional or complete specification is sufficient – Delhi HC SB decision in *Boehringer Ingelheim* overruled

The Division Bench of the Delhi High Court has held that that a Divisional Application moved in terms of Section 16 of the Patents Act, 1970 would be maintainable provided the plurality of inventions is even disclosed in the provisional or complete specification that may have been filed. Court's Single Bench

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decision in the case of *Boehringer Ingelheim International GMBH* v. *Controller of Patents* [2022 SCC OnLine Del 3777], which had held that if the plurality of inventions is not contained in the claims of the parent application, the Divisional Application would not be maintainable, was thus overruled.

The Court for this purpose observed that the significance of the provision using the expression 'disclosed in the provisional or complete specification' cannot be ignored. It noted that according to the Manual of the Patent Office Practice and Procedure, 'claims may not be included in the Provisional Specification' and hence Divisional Application could not be possibly filed when only a provisional specification has been submitted, in case the decision in *Boehringer Ingelheim* is taken as correct. Further, observing that Section 16(1) does not employ the expression 'disclosed and claimed' or 'claimed' in the latter part of that provision, the Court held that there is no justification to read Section 16 as prescribing that plural inventions must be found or stand reflected in the claims. It, in this regard, also approved the view that Section 16(1) corresponds and seeks to accord statutory recognition to Article 4G of the Paris Convention.

The Division Bench was also of the opinion that the filing of a Divisional Application either *suo moto* by the applicant or while meeting an objection raised by the Controller, would have to be answered on identical lines. It was hence of the view that whether the Divisional Application is filed *suo moto* or to remedy an objection raised by the Controller, it is maintainable in either situation, subject to the plurality of inventions being evidenced from the disclosures made in either the provisional or the complete specification.

It may be noted that the Court in this case also observed that the precept of 'what is not claimed is disclaimed' has no application to the subject of divisional filing and claim drafting. **A detailed analysis of the Delhi High Court decision is available here.** [*Syngenta Limited* v. *Controller of Patents and Designs* – Judgement dated 13 October 2023 in C.A.(COMM.IPD-PAT) 471/2022, Delhi High Court]

Trademark 'Vajirao & Reddy' is not deceptively similar to 'Vajiram' or 'Vajiram & Ravi' – No likelihood of confusion between 'Vajiram' and 'Vajirao', despite structural similarities

The Delhi High Court has held that trademark 'VAJIRAO & REDDY' is *prima facie* not deceptively similar to 'VAJIRAM' or 'VAJIRAM & RAVI' and has no potential of misleading the intended segment of the public into confusing the two entities or assuming an association. The Court observed that while the differences between the two marks were amplified chiefly by the divergent second components – 'RAVI' and 'REDDY', the uniqueness of each organization's logo, as well as the defendant's inclusion of the word 'institute' in their registered device mark, further enhanced the dissimilarities. The Court in this regard also did not subscribe to the view that similarity in the expression 'VAJI' contained in both names could mislead consumers due to the general tendency to focus on the initial syllable of a wordmark.

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Further, the Court was also of the view that there is no likelihood of confusion insofar as comparison of 'VAJIRAM' with 'VAJIRAO' is concerned, despite the structural similarities. It noted that the target consumers intended to be influenced by the trademarks comprise of well-informed civil services aspirants, who are not only cognizant of the multiple coaching centres engaged in the trade, but also their respective reputations in the market. The High Court in this regard also took note of the absence of demonstrable goodwill and reputation in the 'VAJIRAM' mark.

Rejecting the application for grant of interim injunction restraining the defendants from trading under the mark 'VAJIRAO' or 'VAJIRAO & REDDY', the Court also noted that record lacked any material that would lead the Court to firmly conclude that the defendants had misrepresented their marks as being associated with the plaintiff. According to the Court, rather, the evidence showed that the defendants were using their marks without any protest from the plaintiff for an extended period, dating back to 2005 and have hence accrued significant goodwill, substantiated by student testimonials and success metrics furnished on record. It, in this regard noted that concurrent advertisements in the same publications on multiple occasions proved that the plaintiff had adequate notice of the defendant's alleged passing off activities. [*Vajiram & Ravi IAS Study Centre LLP* v. *Vajirao & Reddy Institute Pvt. Ltd.* – Judgement dated 14 September 2023 in CS (COMM) 43/2019, Delhi High Court]

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News Nuggets

- Stay of civil suit during pendency of rectification petition whether required after abolition of IPAB? – Question referred to Division Bench
- Copyrights – Right in public performance of a song is incapable of exploitation without rights in underlying works
- Trademark passing off – Provisions of Section 124 of the Trade Marks Act, 1999 are not applicable

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Stay of civil suit during pendency of rectification petition whether required after abolition of IPAB? – Question referred to Division Bench

The Single Bench of the Delhi High Court has referred to the Division Bench the question as to whether the view by the Coordinate Single Bench in *Sana Herbals* [2022 SCC OnLine Del 4482], that, after the abolition of the IPAB, there is no requirement of staying a civil suit during pendency of the rectification petition, even where the rectification petition is instituted under Section 124 of the Trade Marks Act, can sustain, in view of Section 124(2).

The Court in the present case [*Amrish Aggarwal* v. *Venus Home Appliances Pvt. Ltd.*, Order dated 27 September 2023] sought to differ with the view of the earlier Coordinate Bench which had held that as the power to decide a rectification proceeding now vests with the High Court, "there is no requirement of staying the infringement suit" pending disposal of the rectification proceeding, and both proceedings can be consolidated and decided together. The present Court found this finding directly contrary to Section 124(2), which the Legislature had consciously chosen to retain the statute even after the power of rectification was restored to the High Court, consequent on abolition of the IPAB. The Court also found the earlier decision on the Coordinate Bench contrary to a Division Bench decision in the case of *Puma Stationer* [(2010) 43 PTC 479] which specifically holds that, once a rectification petition is filed, stay of the pending suit, at least *qua* infringement, is mandatory. The Court was also of the view that the stay of depending infringement suit, on a rectification petition being filed under Section 124(1)(ii), does not require any judicial order.

Copyrights – Right in public performance of a song is incapable of exploitation without rights in underlying works

The Delhi High Court has observed that the right in a public performance of any song would itself be incapable of exploitation without the rights in the underlying works. In a case where the Defendant had entered into multiple agreements in respect of the same song with different parties, the Court observed that having signed the 2014 Agreement with Sony Music, *prima facie*, no rights could have been assigned in the underlying works to the Plaintiff No. 2 *vide* Copyright Assignment Agreement in 2022, as it did not own rights in the underlying works then. Defendant's contention that since 2014 Agreement had already assigned the underlying works to Sony Music, the only rights assigned to the Plaintiff No. 2 were the rights *qua* a live concert and nothing more, was thus rejected by the Court in *Saga Music Private Limited* v. *Satinder Pal Singh Sartaaj* [Decision dated 25 September 2023].

Trademark passing off – Provisions of Section 124 of the Trade Marks Act, 1999 are not applicable

The Delhi High Court has observed that Section 124 of the Trade Marks Act, 1999 would only apply where a suit has been filed for infringement, and would clearly have no application in a suit for

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passing off. Section 124 provides for stay of proceedings where the validity of registration of the trademark is questioned.

In this case involving filing of trademark rectification petition in cross suits, the Court observed that in the first suit, where the petitioner had alleged both infringement and passing off, the Court had held (*vide* a different judgement) that no infringement action lied against the defendant, as both the parties are registered proprietor of almost identical trademarks. It also noted that the defendant had neither pleaded that the registrations granted to petitioner's trademarks were invalid, nor raised any defence under Section 30(2)(e). The second suit, as filed by the defendant in the first suit, was premised only on passing off.

It may be noted that the Court in *Marie Stopes International* v. *Parivar Seva Santha* [Judgement dated 20 September 2023] also observed that in terms of Rule 26 of the Delhi High Court Intellectual Properties Rights Division Rules, 2021, the rectification proceedings are to be consolidated with civil suits and decided together. Contention that rectification petitions were not maintainable because no application under Section 124 was filed and no issues were framed in respect thereof in the connected suits, was hence rejected.

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