

**INTELLECTUAL PROPERTY
&
INFORMATION TECHNOLOGY
NEWS BULLETIN
Vol.1 Issue 2 1st December , 2006**



Dear Reader,

It is my pleasure to place before you this issue of the IP & IT News Bulletin, which is dedicated to Indian Domain Name decisions. The summary of cases on domain names, given in this Issue, by Indian courts and WIPO Arbitration and Mediation Center, is designed to give you an insight into the decision-making process, especially the factors taken in to consideration by the Indian Courts for deciding Domain Name Disputes. Indian Courts have, despite the absence of any legislation, utilized the tool of common law principles and law of passing off, to prevent the menace of cyber squatters and to promote justice, in one of the most dynamic ways.

We are also extending an Invitation to regularly organised interactive Seminars on Intellectual Property and Information Technology Laws, aimed at better realization of the need to arm ourselves with the understanding of the intricacies as well as the simplicity of IP & IT Laws..

Besides Domain Names, we have also focused this issue on Industrial Designs and Designer Wear, Grant of International Patent via PCT route and Geographical Indications.

We hope you will find the News Bulletin useful.

Yours sincerely,
Vinay Vaish,
Partner

FOR PRIVATE CIRCULATION

**Interactive Seminar on Intellectual Property
Rights & Cyber Laws
AT NEW DELHI – GURGAON -MUMBAI**

INVITATION

We have planned regular interactive seminars on Intellectual Property and Cyber laws, covering a wide spectrum of issues related with this subject.

Rapid technological and scientific changes have resulted in the mushrooming of new ideas, applications based on these and new products. This has led to a growth in Intellectual Property and Information Technology laws, which are consequently constantly evolving fields. Recognizing this, we have decided to share and spread greater awareness about these issues, by holding informative and interactive seminars.

The duration of these seminars will be 2 hours, and the participation is by invitation only. To make these seminars interactive, the invitation is extended only to 20 delegates, each time.

The aim of these seminars is to give a practical view of the subject, enabling the participants to address their professional concerns in these fields.

In case you are interested in attending the interactive seminar conducted by us, please **send us an email or letter giving the particulars of your name, address, qualification, phone number, mobile number and email address.** We will accordingly intimate you about the Venue, Time and Place.

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INDIAN SCENARIO

DOMAIN NAMES

In the Indian legal framework there is no specific law or Act which deals with protection of domain names however, such cases are to be studied in the light and principles of the Trade Mark Act, 1999. The Civil and Criminal remedies available under the Trade Mark Act, 1999 for infringement and/or passing off of the trade mark are also applicable to domain name disputes.

Infringement and passing off are to be studied in the light of “likelihood of confusion” principles. However the principles applicable to trade marks cannot in their entirety be applicable to domain names.

SUMMARY OF INDIAN DOMAIN NAME CASES

Zee Telefilms Ltd. and Ors. Vs. ZEE Kathmandu and Ors. **2006 (32) PTC 470**

The Respondents were permanently restrained from using the word “ZEE” as a part of any domain name, as the plaintiff was a continuous user of the trademark ZEE, and it was held that adoption of the word ZEE by the respondent was malafide and with the intention to mislead internet users and take advantage of the plaintiff’s goodwill.

Yahoo! Inc. Vs. Akash Arora and Another **1999 (19) PTC201**

The Plaintiff www.yahoo.com alleged that by using a similar domain name, i.e. www.yahooindia.com, the defendants were indulging in deceit and “passing off”. Thus, by applying the doctrine of passing off, the court granted an interim injunction restraining the defendants from dealing in services or goods on the Internet or under the trademark / domain name <yahooindia.com>. It was held

that a domain name is entitled to equal protection against passing off as in the case of a trademark. This case of **Yahoo Inc.** set the principle that the use of domain names which are identical or deceptively similar to trademarks makes a prima facie case of passing off.

Rediff Communication Ltd. Vs. Cyber Booth and Another **2000 (20) PTC 209.**

In the above case plaintiff’s domain name was REDIFF. Defendant adopted RADIFF as a part of their domain name. The Court came to the conclusion that the defendant’s adoption of the domain name “RADIFF” was illegal and unlawful and the sole object of the defendants was to trade upon the reputation of the plaintiff. Considering the facts and applying the principles of passing off, the defendants were enjoined from using any domain name comprising the word “radiff”.

Dr. Reddy’s Laboratories Ltd. Vs. Manu Kosuri **2001(21) PTC 859**

The plaintiff had registered the domain name www.drreddys.com. The Defendants adopted the domain name drreddyslab.com. The Court held that the defendant’s acts of adoption of similar domain name were dishonest and malafide, and as such the defendant was liable for an action of passing off, since the domain name serves the same function as a trade mark.

Acqua Minerals Ltd. Vs. Pramod Borse **2001 (21) PTC 619**

The plaintiff was registered proprietor of the famous trade mark BISLERI for water. It was held that domain names are entitled to equal protection for an action of infringement if such a name is registered with the Registering

Authority under the Trade Marks Act. Injunction was granted in respect of domain name <bisleri.com>.

Info Edge India Pvt. Ltd. & Anr. Vs. Shailesh Gupta & Anr.
2002 (24) PTC 355

Plaintiffs domain name "NAUKRI.COM" , was deceitfully adopted by the defendants as "NAUKARI.COM" . Held, that the plaintiff was entitled for the injunction as both the domains were considered to be same , and defendant's adoption was considered as malafide by the court .

Sony Ericsson Mobile Communications AB Vs. Chen Shenglu

206 (33) PTC 597 (NIXI)

IN REGISTRY, NATIONAL EXCHANGE OF INDIA (NIXI)

Complaint was made w.r.t. the registration of Domain Name www.sonyericsson.co.in by the respondent in bad faith and being identical to the complainant's website / domain www.sonyericsson.com . The complainant is proprietor of the trademark and domain name incorporating the word Sony Ericsson - The complainant also owned the domain name sonyericsson.cn in China where the respondent is based. The complainant ,Sony Ericsson ,also registered its domain name in more than 100 countries. The allegations of likelihood of confusion and deception were made . It was held that the domain name of the respondent was identical to the trademark and domain name of the Complainant. The registration of country level domain in India by the Respondent based in China found to be in bad faith to cause confusion to the Internet users and to make such users to falsely believe that the disputed website is sponsored, endorsed or authorised by the complainant

Respondent failed to show any right or legitimate interest in registering the disputed domain name. It was directed that the complainant is entitled to the transfer of the disputed domain name www.sonyericsson.co.in .

CITICORP & Anr. Vs. Todi Investors & Anr.

2006 (33) PTC 631 (Del)

In the above mentioned case , the dispute was w.r.t. the domain name "citi.in" . The issue before the court was, whether Domain Name Dispute Resolution Policy providing mechanism for resolving such disputes , oust the jurisdiction of courts. It was held by court that the alternate dispute resolution policy in domain name matters does not take away the jurisdiction of the courts to adjudicate upon and decide domain name cases .

Mawana Sugars Limited Vs. Panalink Infotech Limited
2006 (32) PTC 537

The complainant company has been in the sugar producing and marketing business under the trademarks MAWANA and MAWANA SUGARS for the past 55 years. The complainant registered its domain names through the respondent, who illegally transferred the same to some third party during the pendency of the proceedings. It was held that it was a typical case of "**Cyberflying**", which means a phenomenon where a registrant of a domain name, when named as a respondent in a domain name dispute case, systematically transfers the domain name to a different registrant to disrupt the Policy.

Held that respondent failed to show any legitimate right in the domain names and transfer of the domain name without the

consent of the complainant was an action in bad faith. It was held that the respondent was involved in “CYBERFLYING”.

**Tata Sons Ltd v The Advanced Information
Technology Association
Case No. D2000-0049 of WIPO**

The dispute was regarding the registration of the domain name “tata.org” by the respondent. The complainant contended that they were the exclusive owners of the mark TATA. The dispute was regarding registration of the domain name “tata.org” by the respondents for illegal benefits. The complainants were the registered proprietors of the trademark TATA in India and the same was also registered in Bangladesh, Brunei, Kuwait, Malaysia, Nepal, Sabah, Singapore and Pakistan in favour of the complainants. It was held that the registration of the domain name was in bad faith, and consequently the said domain name was ordered to be transferred to the complainant.

**Bennett Coleman & Co Ltd. v Long Distance
Telephone Company
(Cases No. D2000-0014 and 2000-0015 of WIPO)**

The complainant was the publisher of the famous Indian newspaper “The Times of India”. The dispute was regarding the domain name “thetimesofindia.com” which had been registered by the respondent and the complainant held the domain name “timesofindia.com”. It was held that respondent’s registration and use of the domain name “thetimesofindia.com” was in bad faith. Hence, the said domain name was transferred to the complainant.

**Satyam Computer Service Limited vs. Vasudeva
Varma Gokharaju:
(Case No. D2000-0835 of WIPO)**

The complainant is the flagship company of the Indian information technology giant, Satyam Group of companies. The complainant’s trademark SATYAM in relation to software services was for the first time adopted and used in the year 1987, and its application for registration of the trademark / word SATYAM and the corporate logo was pending in India. The respondent had registered the domain names “satyam.net” and “satyam.org” in 1999 and 1998 respectively. Held, that the said domain names were identical to the complainant’s trademark SATYAM and that the respondent has no rights or legitimate interest in respect of the domain names and the same were transferred to the complainant.

PARALLEL IMPORT OF GENUINE GOODS

**Court in the case of
Samsung Electronics Company Ltd. & anr.
Vs.
G. Choudhary & Anr.
2006 (33) PTC 425 (Del.)**

In the above case court held that under Section 30 of the Trade Marks Act, 1999 import of even genuine goods must be by or with the consent of the registered proprietor of the trademark. In this case the defendants were importing goods from China. The goods are genuine goods and bore the trademark of the Plaintiff “**Samsung**”. The Indian law is liberal in permitting parallel imports of genuine goods bearing registered trademarks. However, in view of Sec. 30 of the Trade Marks Act, 1999 interim injunction was granted against the Defendants.

INTERNATIONAL PATENT
VIA
PATENT COOPERATION TREATY (PCT)
ROUTE

The PCT was concluded in 1970, amended in 1979, and modified in 1984 and 2001.

The PCT is an international treaty, administered by the World Intellectual Property Organization (WIPO), between more than 125 Paris Convention Countries. This treaty makes it possible to seek patent protection for an invention simultaneously in each of a large number of countries by filing an "international" patent application instead of filling several separate national or regional patent applications.

Such an application may be filed by anyone who is a national or resident of a PCT Contracting State. It may generally be filed with the national patent office of the Contracting State of which the applicant is a national or resident or, at the applicant's option, with the International Bureau of WIPO in Geneva. If the applicant is a national or resident of a Contracting State which is party to the European Patent Convention, the Harare Protocol on Patents and Industrial Designs (Harare Protocol), the revised Bangui Agreement Relating to the Creation of an African Intellectual Property Organization or the Eurasian Patent Convention, the international application may also be filed with the European Patent Office (EPO), the African Regional Industrial Property Organization (ARIPO), the African Intellectual Property Organization (OAPI) or the Eurasian Patent Office (EAPO), respectively.

The international patent application, provided that it complies with the minimum requirements for obtaining an international filing date in accordance with Article 11 of the PCT, has the effect of a national patent application in all PCT Contracting States.

Briefly, an outline of the PCT procedure includes the following steps:

Filing: You file an international application, complying with the PCT formality requirements, in one language, and you pay one set of fees.

International Search: An "International Searching Authority (ISA)" (one of the world's major patent Offices) identifies the published documents which may have an influence on whether your invention is patentable and establishes an opinion on your invention's potential patentability.

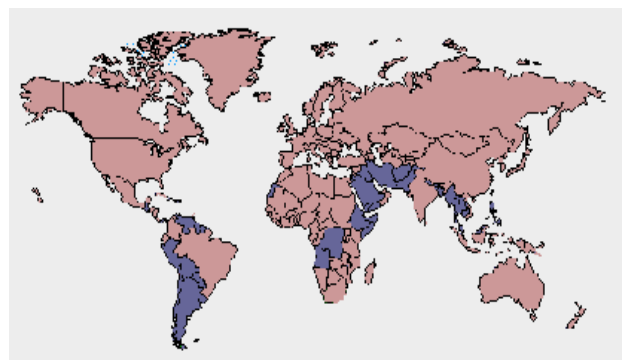
International Publication: As soon as possible after the expiration of 18 months from the earliest filing date, the content of your international application is disclosed to the world.

International Preliminary Examination: an "International Preliminary Examining Authority (IPEA)" (one of the world's major patent Offices), at your request, carries out an additional patentability analysis, usually on an amended version of your application.

National Phase: after the end of the PCT procedure, you start to pursue the grant of your patents directly before the national (or regional) patent Offices of the countries in which you want to obtain them.

List of all the PCT Contracting States

Welcome to the World of PCT



The countries marked up in blue are the Non-PCT Contracting States

All PCT Contracting States are bound by Chapter II of the PCT relating to the international preliminary examination.

COPYRIGHT ACT VS. DESIGNS ACT VS. DESIGNER CLOTHES

A Case Study of

Bunty aur Babli , Urmila Matondkar -Tarun

Tahiliani – Neeta Lulla Controversy



From **Bunty and Babli** to Tarun Tahiliani's latest controversy over the "copying" of a lemon yellow saree, one of the designer's creation, which was first seen on Urmila Matondkar and then on Mumbai-based designer Neeta Lulla as a self-creation , the buzz all over is about the infringement of copyright acquired by designers over their creations.

The recent Lulla-Tahiliani controversy is only the tip of an ice berg. It could have been only due to the ignorance of Neeta Lulla's embroiderer. The fashion industry invests huge amounts of money in making new designs and creations every new season, only to be misappropriated by retailers and ready-to-wear apparel makers. The fashion designers, who rightly ought to have ownership over their original creations, do not have a valid legal recourse because their original designs are not registered. The retailers and ready-to-wear apparel makers come out with inexpensive and affordable knock-offs of the original designs and the public is only too happy to buy the knock offs as the infatuation with designer clothes and accessories has led to an insatiable urge to possess the latest in fashion trends.

There are a lot of misconceptions surrounding such controversies. First and foremost, any garment designed by a person does not fall under the purview of the Copyright Act and shall not be entitled to protection under the same. Copyright under the Copyright Act, 1957 and the Designs Act, 2000 have different relevance. Designs Act , 2000 is applicable to Articles of clothing , husbandry , Textile Piece Goods , Artificial and Natural Sheet Material , Furnishing (Class 02, 05, 06 of the Third Schedule of Design Rules , 2000) , unlike the Copyright Act, 1957 , which is applicable to Artistic Work, Literary Work , Dramatic work ,Musical Work, Photographs, Cinematograph film and Software. From the spectrum of tools for the protection of Intellectual Property, the most closely relevant to the fashion industry is that of the protection of Industrial Designs, simply referred to as Designs. Designer clothes and accessories are entitled to protection under the Design's Act 2000, provided such designs are registered under the said Act. The registration is available for a total period of fifteen years.

This means that a designer shall not be, ipso facto, entitled to protection for his work until and unless the same is registered under the Design's Act, 2000. Only on such design or work, which is registered, can the creator bring an action against the infringers. The owner of a registered design can recover from a pirate, a sum not exceeding twenty-five thousand rupees, recoverable as a contract debt, or a suit for recovery of damages and injunction against repetition. Thus, registering a design of apparel is mandatory and helps in deterring others from copying it, and also helps to fight unscrupulous competitors who do so.

Registering a design helps the fashion designer to prevent others from misusing or exploiting the new or original aspects of the dress or any accessorizing article. The designers, in practice, can register their original and new designs on a case-to-case basis. The fashion and clothing industry makes huge investments to create new and imaginative designs but because of the short life span of fashion and its trends, not many owners of the original designs make use of the available law on designs, which is for all practical and legal purposes is the sole remedy. The imitation of styles and designs as a friction area is caused by the mass production of inexpensive and affordable knock-offs of the works of designers and fashion houses by retailers. Fashion trends are the assimilation of ideas, which arise, evolve through sharing, expand and increase in popularity through exposure and alter in imitations. Fashion designers can protect original designs by registering them, but the ownership over creative ideas is not practically possible. In some countries and regions, such as the United Kingdom and the European Union, the law offers protection for unregistered designs for a relatively short term, but in India for protection Registration under the Designs Act is mandatory. The registering of all new or original designs sounds like an expensive and weighty process,

especially in the light of the short span of life that fashion trends have. But it is a good practice, to register designs on a case-to-case basis. Fashion trends are inspired by the ideas of the pioneering fashion designers and there is no law against wearing a design, which is similar to one worn by a fashion icon to a public place, but the least that can be done is protection of coveted Designer wear so as to restrain unscrupulous competitors from copying some of the most innovative creations.

GEOGRAPHICAL INDICATIONS

A geographical indication is a sign used on goods that have a specific geographical origin and possesses qualities or a reputation that are due to that place of origin. In recent years, geographical indications (GIs) has emerged as one of the most important instruments of protecting the quality, reputation or other characteristics of goods, which are essentially attributable to their geographical origin. Geographical indications have proved to be very valuable as it identifies the source of the product and is an indicator of quality. Most commonly, a geographical indication consists of the name of the place, which is the origin of the goods, such as "Darjeeling" (India) for tea, "Stilton" (England) for cheese, "Swiss" (Switzerland) for chocolate, "Roquefort" (France) for cheese etc.

Agricultural products typically have qualities that are derived from their place of production and are influenced by specific *local factors*, such as climate and soil. The use of geographical indications is not limited to agricultural products. They may also highlight peculiar qualities of a product, which are due to *human factors*, such as specific manufacturing skills and traditions.

Geographical indications (GIs) is an invention of the Trips-Related Intellectual Property Rights (TRIPS) Agreement, which came into effect from January 1, 1995. The TRIPS

Agreement prescribes minimum standards of protection of geographical indications and additional protection for wines and spirits. Articles 22-24 of Part II, Section III of the TRIPS Agreement prescribes minimum standards of protection of geographical indications that World Trade Organization (WTO) members must provide. Geographical indications owe its origin to the Paris Convention, 1883. Although, the Convention does not use the expression “Geographical Indications”, Article 1 (2) of the Convention used the terms “appellation of origin” and “indications of source”. The scope of these expressions has been delineated by the Lisbon and the Madrid Conventions.

The Indian judiciary has played a significant role in protecting geographical indications. India has taken legislative measures by enacting the Geographical Indications of Goods (Registration and Protection) Act, 1999, which came into effect on 15th September, 2003 along with the Geographical Indications of Goods (Registration and Protection) Rules, 2002.

Geographical indications may be used for a wide variety of products, such as Basmati Rice, Darjeeling Tea, Kangra Tea, Alphonso Mango, Alleppey Green Cardamom, Coorg Cardamom, Kanchipuram Silk Saree, Kohlapuri Chappal etc. Geographical indications require protection because they are understood by consumers as denoting the origin and quality of the products. Many of them have acquired valuable reputations, which if not adequately protected, would be misappropriated by dishonest commercial operators. False use of geographical indications by unauthorized parties is detrimental to the consumers and the legitimate users. The former are deceived into buying products which are, in fact, worthless imitations. While for the latter, valuable business is taken away from them and the established reputation for their products is damaged.

Registration of Geographical Indications

An application for the registration of a geographical indication is to be made in triplicate accompanied by five additional representations of the geographical indications, in the prescribed form, viz.,

1. **Form GI-I:** An Indian application to register a geographical indication in any one class.
2. **Form GI-I:** An application to register a geographical indication in any one class from a convention country.
3. **Form GI-I:** A single application to register geographical indications for different classes of goods.

India – Identifying Products for Geographical Indications

In an effort to identify products that are region-specific and that could be registered, Minister of State for Commerce, Shri Jairam Ramesh, recently held discussions with various Commodity Boards under the Ministry in June 2006. During these discussions, it was decided that the Coffee Board would register Monsooned Malabar variety that is exclusive to the Malabar region from Kozhikode to Mangalore. The Spices Board have also identified 61 varieties, out of which the Tellicherry Pepper and Malabar Pepper are in the process of being registered. On the contentious issue of Basmati Rice, India and Pakistan are holding dialogues for the joint filing of the geographical indication before the US and European agencies while simultaneously, the domestic application for geographical indication will be filed by Agriculture & Processed Food Products Export Development Authority (APEDA) will be considered.

TRADE MARK JOURNAL

Indian Trade Mark Registry has made available following journals to the Public:-

Journal	Date of Publication	Date of Availability
1348	16-07-2006	11-09-2006
1349	01-08-2006	27-09-2006
1350	16-08-2006	10-11-2006

It may be noted that Opposition can be filed on Form TM-5, against the Registration of Trade Mark published in the Trade Marks Journal, within three months of the Date of Availability to the public. An extension of one month can be taken for filing opposition on Form TM-44.

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