

The Office of the Controller General of Patents, Designs and Trademarks released Guidelines for Examination of Computer Related Inventions in the beginning of this year. A set of guidelines was first issued in 2015, but was severely criticized. The said guidelines widened the scope of patenting of software beyond what has been provided under the patent law. The same were recalled then and have been re-issued recently. Separately, the Delhi High Court dealt with a case of cybersquatting and reasoned on the principles of personality rights (right to privacy and right of publicity – of famous personalities), which are evolving in India. Another case discussed the principles of territorial jurisdiction in suits of passing off. The important changes that we saw in the first quarter of 2016 are summed up herein.

LEGAL DEVELOPMENTS

Guidelines for Examination of Computer Related Inventions (CRI)

The Office of the Controller General of Patents, Designs and Trademarks ('IPO') released Guidelines for Examination of Computer Related Inventions ('CRI Guidelines'). The Guidelines have come into effect forthwith.

These Guidelines have been issued two months after the previous CRI Guidelines (issued in August 2015) were recalled. The Guidelines previously issued were put in abeyance following severe criticism from various stakeholders due to certain inconsistencies with the patent act. The old guidelines were broadening the scope of patentable subject matter by introducing a new term "technical effect" in order to further explain "technical advancement" under Section 2(1) (ja) of the Patents Act, 1970 (herein after the 'Act'). Essentially, such addition in the scope of patentable subject-matter would have allowed the patenting of software per se, which is actually not allowed in India.

The recently issued Guidelines are in line with the provisions of the Act and exclude mathematical methods, business methods, algorithms and computer programmes per se from the list of patentable subject-matter specifically included in the Act. Apart from clarifying general rules on patent requirements for CRIs, the Guidelines constitute rules of interpretation for patent examiners in order for them to examine claims included in patent applications pertaining to CRIs. One of the relevant paragraphs from the Guidelines is replicated below:

If the contribution lies in the field of computer programme, check whether it is claimed in conjunction with a novel hardware and proceed to other steps to determine patentability with respect to the invention. The computer programme in itself is never patentable. If the contribution lies solely in the computer programme, deny the claim. If the contribution lies in both the computer programme as well as hardware, proceed to other steps of patentability.

NOTABLE IP CASES

Tata Sons Limited and Another Vs. Aniket Singh

2016 (65) PTC 337 (Del)

In a recent judgement of the Delhi High Court involving cybersquatting, the rights to publicity / privacy rights of an individual were discussed.

In the above mentioned matter, the Defendant created and held domains www.cyrusmistry.co.uk and www.cyrusmistry.co ; and made a direct offer to the Plaintiffs, Tata Sons Limited and its Chairman, Mr. Cyrus P. Mistry, for sale of such domains. The Plaintiffs filed a suit for permanent injunction restraining infringement of right to privacy, right to publicity, damages, passing off, etc. against the Defendant before the Delhi High Court.

The court, taking note of the malafide intent of the defendant, passed an order of permanent injunction in favour of the Plaintiffs, also entitling them to the punitive compensation/costs of suit/counsel fee for a sum of Rs. 5 lac and against the Defendants.

The following discussions on right to publicity / privacy rights in the judgment are noteworthy:

1. *The name Cyrus P. Mistry, being the personal name of the plaintiff No. 2, immediately gets associated with the plaintiff No. 2 and no one else. Plaintiff No. 2's name carries enormous goodwill and reputation and is exclusively associated with him. In public perception, therefore, whenever the name of Mr. Cyrus Mistry is mentioned, it is immediately identified and related solely and wholly with plaintiff No. 2.*
2. *Such acts of the defendant amount to invasion of the right to publicity/privacy rights of Mr. Mistry, as well as passing off in right to protect his name, persona or anything emanating out of these as enshrined in Article 21 of the Indian Constitution.*
3. *On the face of it, the name "Cyrus P. Mistry" falls within the category of personal names that besides being a personal name has attained a distinctive indicia, connotation, character or identity of their own. Therefore, the said name due to its peculiar nature and distinctive name coupled with it gaining popularity*

in several fields, has become a 'well-known personal name', enabling plaintiff No. 2 to restrain others from using his name unjustifiably, in addition to his personal right to sue them for the misuse of his name

The principles of right to publicity / privacy rights are in developing phase in India, and the present judgment is an important one, where right to privacy and right to publicity have been explicitly discussed in a case concerning cybersquatting.

Piccadily Agro Industries Ltd. vs Ashok Narwal And Anr.

Decided on 14 March, 2016

A recent judgement of the Honorable High Court of Delhi threw light on the meaning and import of the explanation to Section 20 of the Civil Procedure Code in suits of passing off and upheld the principles founded by the landmark Patel Roadways Limited v. Prasad Trading Company (1991) 3 SCR 391 for the first time.

In the above mentioned matter, Plaintiff and Defendants were engaged in the common field of manufacturing and marketing of liquor, including country liquor. The Plaintiff is engaged in an extensive business of manufacturing and marketing country liquor under the trademark/artistic label "MALTA" prefixed with the expression 'Masti' throughout the State of Haryana. The Defendant no. 1, also located in Haryana, was an authorized dealer of the Plaintiff's products. The dispute between the Plaintiff and the Defendant no. 1 arose when he, along with the Defendant no. 2, had illegally and unlawfully adopted a deceptive trademark similar to that of the Plaintiff in relation to country liquor and started selling the same in Haryana. The Plaintiff filed a suit of passing off and sought reliefs against the Defendants in the Delhi High Court. The question that rose was, if Delhi High Court was the competent Court to address the matter.

The Plaintiff contended that since the second Defendant's books of account were kept at its registered office in Delhi and all their major decisions were taken in Delhi, the Delhi High Court has the jurisdiction to try the matter. The Plaintiff also argued that since the second Defendant had filed their application for the registration of the impugned trademark before the Registrar of Trademarks in Delhi, the Delhi High Court has the territorial jurisdiction to hear this case. The Court opined that the trademarks of the second Defendant were filed in Delhi as Haryana falls under the Jurisdiction of Delhi for the purpose of filing a Trademark Application and not by choice. Further in the opinion of the Court, it was irrelevant as to when and where the decision to manufacture and sale of liquor was taken by the second Defendant under the impugned brand.

Placing reliance on Patel Roadways, the Court concluded that Section 20 - which provides that "a corporation shall be deemed to carry on business at its sole or principal office in India or, in respect of any cause of action arising at any place where it has also a subordinate office, at such place", has been interpreted by the Supreme Court to mean that where a corporation has a subordinate office at a place - other than the place where the principal office of the corporation is situated, and the cause of action has arisen at that other place (and not at the place where the Registered Office of the Corporation is situated), then only the Court where the

cause of action arises and the corporation has a subordinate office, would have jurisdiction, and not the Court within whose jurisdiction the Registered Office of the Corporation is situated.

Thanks and Regards

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