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## Newsletter December 2015 Part-2

### **Welcoming Mr. O.P. Gupta, the Controller General of Patents, Designs and Trade Marks of the Indian Intellectual Property Office**

Mr. O.P. Gupta has been appointed as the new Controller General of Patents, Designs and Trade Marks. In the past Mr. Gupta has been associated with Maharashtra State Electricity Distribution Co. Ltd. as their Chairman and Managing Director.

Mr. O.P. Gupta is an Indian Administrative Service (IAS) officer of the 1992 batch and in his twenty three years of service he has held varied responsibilities in the capacity of 'Inspector General of Registration & Controller of Stamps – Maharashtra', 'General Manager – BEST', 'Vice Chairman and Managing Director of MSRTC', 'Collector of Amravati & Satara' and 'Chief Executive Officer of Akola Zila Parishad'. Interestingly, immediately on appointment Mr. Gupta has issued an order of placing on the Guidelines for Examination of Computer Related Inventions in abeyance. We can hope that considering his diversified experience the Indian Patent & Trademark office can expect some much needed reforms in the coming few months.

### **Dr. Mohan Dewan helps in keeping the pirates at bay**

The Navi Mumbai police department organized the 'Cyber Safety Week' from December 14-19 where they had invited experts in the field of cyber laws to educate students and netizens on various aspects of cyber-crimes. R.K. Dewan & Co.'s principal Dr. Mohan Dewan was invited to deliver a special lecture on combating Digital Piracy.

The menace of digital piracy has been on a rise; there is a surge in the cases filed for software counterfeiting, movie and music piracy. It is of utmost importance to educate people about such activities since many people are still unaware of the fact that downloading music/movies from websites, free of cost is an infringement of copyright. The event was a success in terms of creating awareness among the audience and there is a need for more such events to be organized in the future

### **Heartburn and dilution of mark**

Trademark law allows registration of colors as a mark if it can be shown that such color has obtained a secondary meaning in relation to the product. The registration of color as a mark provides a broad protection and the far reaching consequence of such protection was observed in the U.S. District Court's decision in the case of *Astrazeneca, Astrazeneca LP v Dr. Reddy's Laboratories Inc.* The Plaintiffs used the color purple since 1989, for their drugs treating severe heartburn and acid reflux, and obtained three trademark registrations covering the color purple and even the phrase "The purple pill". The Defendant started marketing its generic drug (to the Plaintiff's original drugs) in U.S. in September 2015. On October 28, 2015 it was alleged by the Plaintiff that the Defendant was marketing its generic capsule having two shades of purple and this was alleged to be a trademark infringement.

On comparison of the two products the court was of the opinion that even though the Defendant's color combination was not "identical" to that of the Plaintiff's, the Plaintiff's registration for a color would cover all shades of that color. It was held that there was similarity in the visual appearance of the two products and there was likelihood of confusion between the two. The Court opined that since drugs were Prescriptive in nature and not available Over the Counter the possibility of confusion would be slightly less. The reason being, that doctors are qualified individuals and would not make a mistake between a generic and an original drug. The Court also noted that since the Defendant's drug was made available (in the market) only in September 2015 it was difficult to assess any negative economic impact on the Plaintiff's drug market. However, the Court did agree that the two products were in direct competition with one another. The adoption of two shades of purple in Defendant's capsule was considered to be a part of defendant's aggressive marketing strategy thereby implying that they *'chose to test Plaintiff's trademark rather than honor it.'* Further, the Defendant's use of the color purple could create the false impression that they were not merely bio-equivalent but may be an authorized generic i.e. *a generic drug made or authorized by the brand name company.* This was seen as creating a confusion regarding the identity of source resulting in the dilution of the mark as well as the reputation of the Plaintiff should there be a case of lapse in quality or safety of the Defendant's drugs. Finally, it was observed that an irreparable damage would be caused to the Plaintiff if no order of injunction was passed in their favor.

The Court also found that it was in the interest of the public that there should be no confusion regarding the identity of two products (emanating from different sources). Therefore, a temporary restraining order was passed in favor of the Plaintiff.



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## Bond identity – James Bond special!

Suave, smart and a super spy are the words used to define Bond, James Bond. This character has been in existence for almost six decades and continues to win the hearts of young and old alike. Author Ian Fleming is often referred to as the father of this super spy. However, as is the usual case the movie is not the exact representation of the book similarly, the cinematic James Bond might not bear resemblance to his literary representation.

In 1961 Kevin McLeory along with Jack Whittingham sued author Ian Fleming for plagiarizing their script 'Thunderball'. It was claimed by the former that they had metamorphosed the apparently 'violent and alcoholic James Bond' in the books to a beloved and marketable movie character. It was claimed that Ian Fleming collaborated with Mr. McCleory and Mr. Whittingham to produce a movie script. The result was the screenplay of 'Thunderball' (at that juncture no title had been assigned). It was claimed by McLeory that it was the first time SPECTRE (Special Executive for Counter intelligence Terrorism revenge and Extortion) was introduced along with the villain Ernst Stavro Blofeld. This script, it was alleged, was published by Ian Fleming as his next book 'Thunderball' and no credit was given to McLeory and Whittingham for the story. It was claimed that the script for the movie Dr. No had incorporated the characteristics of 'cinematic James Bond' as represented in script for Thunderball, this too was seen as infringement of copyright over character.

In 1963 Ian Fleming himself admitted that the novel included 'substantial parts of the copyright material in the film's scripts', he also accepted that there was use of substantial number of incidents and material from the script in the novel 'Thunderball'. This was followed by a settlement between Fleming and McLeory whereby certain rights in 'Thunderball' were assigned to McLeory.

In the coming years, SPECTRE became a regular feature in James Bond novels and movies. The antagonist Blofeld (debuting in Thunderball) the leader of SPECTRE, is an iconic character from the Bond books in fact, his appearance has been adopted by villains in popular movies like Austin Powers etc. Another interesting development is that the latest Bond movie has been titled 'SPECTRE' and we just narrated the legal background and origins to this name.

## Quantum of Solace-James Bond special!

Picture this – a luxury car is speeding down the road, sitting inside it is an attractive couple. The couple is being chased by a high-tech helicopter and suddenly, a man with a metallic hand/glove jumps on the roof of the car from the helicopter. The intruder makes an attempt to attack the couple in the car. The man in black tuxedo looks confident of escaping the threat. He makes a flirtatious turn towards the female and releases the detachable roof of the car and the aggressor is flung away. The couple happily speeds away from imminent threat. A horn driven music can be heard in the background of this entire scene.

Does this scene seem familiar? Or is it a clichéd scene from another action movie?

In 1992, Honda developed a car with a detachable roof design, to advertise this model they came up with different concepts. One such concept was termed as 'James Bob' (a pun on the name James Bond) which was later changed to 'Escape'. In 1994 when the advertisement was to be made, Honda gave instructions to the talent agencies to cast "*James Bond type actors/actress for what could conceptually be next James Bond film.*"

The advertisement was aired in October 1994, the Plaintiff's (copyright owners of James Bond movie/books) sent a notice to the ad makers to pull out the ad, or be ready to face the consequences. Minor changes were made by Honda following which the Plaintiff filed a suit before the District Judge of California (*Metro Goldwyn Mayer v American Motor Honda Co.*)

The Plaintiff claimed that there was substantial copying of their protected work by the Defendants. In order to assess this claim the Court in this case took into consideration two factors:

a) **Extrinsic factor:** This refers to the objective criteria of looking at the work i.e. factors like the plot, music, setting, pace, and characters in the story. It was argued by the Defendant's counsel that the advertisement was a typical scene from any action movie - '*Scènes à faire*', there can be no exclusivity granted for the same to James Bond movies alone. This argument of the Defendants was hit by film historian Casper's testimony; he stated that the protagonist, antagonist, hi-tech gadgets, exotic locales and mood were distinguished and that "*only James Bond films brings it together in a unique fashion.*" The Court agreed with this testimony and held that considering the overall impression left by a James Bond movie the Plaintiffs could claim exclusivity to such an action sequence.

— Character Copyright



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The Defendants claimed that there could be no copyright over the character James Bond. The Court applied the ‘Story being told’ test. This test assesses if the character in itself amounts to the story being told – in the absence of such character the story would be devoid of its original nature. It was quite obvious that James Bond, the character, has distinguished characteristics – dress code, license to kill, flirtatious streak, keeping cool under stressful conditions, subtle and dry sense of humor therefore fulfilling the requisites of the test. The Court did not find any merit in the Defendant’s claim.

**b) Intrinsic factors:** This refers to assessing the overall look and feel of a work. It relies on two integral facts (1) Access to the original work, and (2) Substantial similarity in the works. The Defendant by their own admission had access to the Plaintiff’s works. Furthermore, there was substantial similarity in the two works. This is enumerated as follows:

— Car Chase Sequence = Spy who loved me

— Antagonist with metal hand = Dr. No

— Antagonist attacking from the roof of the car = Goldfinger

The assessment of these factors resulted in the Court deciding that there was a clear case of substantial similarity in the two works. The Plaintiff succeeded in their claim of copyright infringement and an injunction order was passed in their favor.

And once again James Bond (his distinguished traits) saved the day!

## Lessons from ‘Inventor of the Year’

Jay Walker is the 11th most patented living inventor in the world and this year was awarded as the ‘Inventor of the year’ by the Intellectual Property Owners Educational Foundation. His speech on the occasion drew attention on the core issues effecting the Patent Laws in the United States, we have analyzed his comments as applicable to Indian Patent regime as well; some of the key takeaways of his speech are:

— **Trolls vs. Non-Practicing Entities:** Mr. Walker in his speech stated that a troll cannot be equated with a Non-Practicing Entity (NPE); an NPE can include research and development companies, institutions, independent inventors etc. A major reason for patent trolls to flourish is the high costs involved in litigation and the smaller entities prefer to avoid litigation hence, end up making payments to the troll.

— **Complicated Patent Systems:** Mr. Walker in his speech stated that following the Supreme Court’s decision in *Alice Corp. v CLS Bank* the patentability of software in U.S.A. has fallen into a grey area. In India guidelines were issued to clarify when software can be patented but due to certain conflicting provisions between the guidelines and the Patent Act, the guidelines have been withdrawn. There is still a level of uncertainty when examining software for being granted patent. It is hoped that the revised guidelines will make it simpler for patent examiners to determine patentability of software.

— **Positive Impact of Patent Laws:** Mr. Walker in his speech stated that there is a notion that patents are money making tools alone. This applies to India as well, there is a notion that a patent right automatically refers to less accessibility particularly for pharmaceuticals. It is necessary for the industry players to educate the public that patents are intended to incentivize innovation and research which will further benefit the society.

The Indian authorities need to take note of Mr. Walker’s speech.

## To Stream or not to stream is the question

The online streaming of one’s favorite TV shows is one of the simple pleasures in life. The online streaming service technology works on the principle that while transmitting the information (digital content) the information is stored for infinitesimal period therefore; there is no unauthorized storing of information by the streaming service provider. This however does not mean that such service provider has steered clear from any possibility of copyright infringement; the U.S. District Court of Columbia was faced with such issue in the case of **Fox Television Stations Inc. v FilmOn X LLC**.

This suit was filed by producers of TV shows against FilmOn X LLC an online TV show streaming service. It was claimed that the Defendant was infringing the copyrights of the Plaintiffs by unauthorized streaming of the shows. The U.S. Supreme Court in the case of *Am Broad. Inc. v Areo, Inc.* held that the Copyright Act forbids unauthorized retransmission of copyrighted programs over the internet even if such transmissions rely upon the use of separate antennas and data streams.



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S.111 in the U.S. Copyright Act provides for 'compulsory copyright licensing' for the cable systems since it is impractical to expect that every cable operator would contact the copyright owner for the license for TV shows. In light of this provision and the *Areo* decision the Defendants argued that they were eligible for applying for compulsory licensing as a cable company. The Court held that the defendant did not fall in the category of cable system since a cable system comprises of physical facilities that '*receive and retransmit broadcast signals to paying subscribers through wires, cables, microwave, and other types of communication channels.*' It was quite evident that FilmOn X did not qualify under this definition of cable services because it relied on the internet, which is neither a tangible nor physical entity. Further, it was held that FilmOn X had also infringed the right of public performance of the Copyright owners by such unauthorized transmission.

This decision throws light on the stringent application of Copyright laws by the courts in U.S. The practice of illegal streaming affects the revenues of the entertainment industry and reduces the financial incentive to create new contents therefore, it is necessary for the courts to step in time and again and prevent such infringements.

## **Revamping the IP infrastructure in India**

The Department of Industrial Policy and Promotion is working towards reducing the backlog of Trademark and Patent Applications in the country. The Government data as on July 31, 2015 revealed that around 2.26 lakh patent applications are pending in the country, this triggered the Government's need to act immediately upon the issue. It was in this background that last month Draft Patent Rules were released for public review and this month the Draft Trademark Rules were released. Apart from these draft rules the DIPP has proposed immediate changes in the existing infrastructure, these are analyzed below:

### **Hiring Additional Patent Examiners**

DIPP has announced that 459 Additional Patent Examiners will be recruited to reduce the time taken for examinations. Under the current regime it takes around 5-6 years to obtain a patent approval; after the implementation of the proposed changes this time period is expected to be reduced to 15 months. This move might result in increase in patent filings in the country to initially 60,000 a year and later to 1 lakh in 2-3 years. The work relating to search on databases (to ensure novelty of patent) will be outsourced so that time can be spent on the examination process. Further, 263 patent examiners have been hired on a contractual basis to speed up the system. Additionally, the time taken to file reply by the applicant has been reduced to 6 months instead of 12 months.

### **No fees for withdrawing Patent application**

Currently, a patent applicant has to pay fees for withdrawal of application however; the draft patent rules (released last month) have proposed that no such fees will have to be paid. This move is inspired from the data that globally 15% patent applications get withdrawn, if the same is allowed free of cost in India it will result in reducing the backlog of applications.

### **Reducing Time for Trademark Approval**

The DIPP aims at reducing the time taken for examination of trademark to one month from the current practice of 13 months. It has been proposed that the time taken to grant approval for trademark should be reduced to 4 months from the current practice of 15-18 months.

These proposed changes prima-facie do not appear to be a knee jerk response to the huge backlog of applications. The government's Make in India and Digital India campaign rely heavily on a strong IP infrastructure and therefore, these changes instill confidence in the foreign investors as well as the local players who might succeed in getting their applications approved in lesser time.

Our summary of Draft Patent Rules can be accessed here:

["HTTP://WWW.RKDEWAN.COM/NEWSLETTERDETAILS.PHP?YY=201511#380"](http://www.rkdewan.com/newsletterdetails.php?yy=201511#380)

## **Draft Trademark Rules**

In order to increase efficiency of the Trademark Registry the Controller General has proposed new set of rules. The Draft rules have been published and the final modified rules are likely to come in force early next year. The salient features of the proposed rules are as follows:



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**I. Substantive increase in official fees** (in some cases the fees has been quadrupled): The fees for filing, renewal of marks has been proposed to be increase substantively.

**II. Increased use of digital resources such as e-mail:** The Draft rules have proposed to include service of documents via e-mails to be a reliable means of communication and serving of notice.

**III. Statutory provision for protecting well known trademarks:** The Draft rules propose that a party can apply for its mark to be designated as a well-known mark on the payment of a certain amount (as fees) to the Registrar.

**IV. Precise provision for handling Madrid filings:** The Draft rules have incorporated a new chapter to address rules specifically catering to marks registered through Madrid Protocol.

**V. Expedited processing of application:** The draft trademark rules suggest that even the procedures following the examination of the mark i.e. show cause hearing, publication of application, opposition etc. till the final disposal of the application would be dealt expeditiously.

The Draft Trademark Rules is open for suggestions and comments and can be accessed here:

[HTTP://WWW.IPINDIA.NIC.IN/IPACTS RULES/TMR AMENDMENT RULES 2015 19NOVEMBER2015.PDF](http://www.ipindia.nic.in/ipacts_rules/tmr_amendment_rules_2015_19november2015.pdf)

## Divided by religion, united by law

Religious teachings are intended for all to read and practice but can a proprietor seek to register the name of a holy book or a deity as a trademark exclusive for use? Apparently not, this issue cropped up before the Supreme Court in the case of *Lal Babu Priyadarshi v Amritpal Singh*.

The Appellant is engaged in the business of manufacturing incense sticks and had applied to register the mark 'RAMAYAN' for its goods. The Appellant's registration was opposed by the Respondent who happened to be a dealer of the Appellant as well proprietor of the mark 'BADSHAH RAMAYAN' which was pending registration. The Respondent argued that the mark 'RAMAYAN' was reference to a religious book and no monopoly could be granted. The opposition was rejected by the Assistant Registrar of Trademarks. The Registrar held that the mark 'RAMAYAN' was not included in the list of prohibited marks hence, it was open for registration. The Respondent filed an appeal against this order before the IPAB. The IPAB set aside the Registrar's order. The Appellants filed a Special Leave Petition against the IPAB's orders.

The Supreme Court referred to previous case laws as well as the 'Eighth Report on Trademarks Bill', of the Parliamentary Standing Committee. The Court held that the underlying intent was that no marks of a religious nature should be permitted to be registered. The Apex Court further opined that if there had been an addition of a prefix or suffix to the mark 'RAMAYAN' then the word 'RAMAYAN' lost its significance as a religious book and could be considered for registration. It was noted that in the present case the Appellant was selling the incense sticks under the mark 'OM's RAMAYAN' and was using the pictures of Lord Rama, with his Brother Lakshmana and wife Goddess Sita. The use of images of deities as device implied that the Appellant was taking advantage of these images for the sale of its product and this is prohibited under law. The Court ruled that no one could register a mark named after any religious book such as, Guru Granth sahib, Quran, Bible etc. or a deity, even if the same has not been included in the list of prohibited marks. It was also held that the mark 'RAMAYAN' was common to the trade and the Appellant had failed to establish that the mark had attained a secondary meaning in relation to its goods.

The intent of the Supreme Court is quite clear – religious teachings and the names of deities belong to all, therefore no one can claim monopoly over the use of these names.

## When they met – Right to Information and Copyright

The RTI Act recognizes works protected by copyright to be one of the exceptions to disclosure of information, but does copyright always prevail upon the citizen's right to know? The Bombay High Court decided such a situation in the case of *Ferani Hotels Pvt. Ltd vs. State Information Commissioner, Municipal Corporation of Greater Mumbai & Ors*.

The Respondent and Petitioner had entered into an agreement for the development of a particular land and a Power of Attorney (PoA) was issued by Respondent in favor of Petitioner for the same purpose. Following which, Petitioner submitted certain development proposals –drawings, plans, etc. to the Municipal Corporation. At a later stage there was a fall out



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between the Respondent and Petitioner. The Respondent filed a suit against the Petitioner for getting a declaration that the development agreement and the PoA had been legally terminated. Simultaneously, the Respondent applied with Public Information Officer for the development plans to be made available under RTI.

The Petitioner's counsel argued that the Respondent was a business rival and making available such information would be against the interest of the Petitioner's business. Furthermore, such information was a trade secret and exempted from revelation under S. 8(1) (d) of the RTI Act. Similarly, the plan drawings were artistic works protectable under Copyright Act and exempted under S. 8(1) (j) if the revelation would serve no public interest. The application of the Respondent before the Public Information Officer failed, and through a series of appeals the Respondent approached the State Information Commissioner and obtained an order in its favor. The Petitioner aggrieved by the order of State Information Commissioner filed a writ petition before the Bombay High Court.

The High Court held that the documents in question were submitted by the Petitioner to the Municipal Corporation, which is a public authority. Furthermore, the plans were covered by RTI Act since availability of these documents assured transparency in the process of approval of plans by the Municipal Corporation. If these documents would be exempted under the Act it would encourage corrupt practices (and manipulation) in the approval process. The exemptions under S. 8(1) (d) & (j) were held to be not applicable as the plan had been sanctioned by the Municipal Corporation and the work was deemed to be a public record. It was held that mere disclosure of work would not imply copyright infringement. Additionally, Section 52(1) (f) of the Copyright Act states that reproduction of a work in a certified copy made or supplied under any law will not be considered as an infringement therefore, there was no copyright infringement in the present petition. The Writ Petition was dismissed.

The Bombay High Court's decision has set a precedent that public interest is not subservient to individual interests protected by Copyright Act or Trade Secrets.

## **New Controller General walks the talk**

In a bold and courageous move the newly appointed Controller General, Mr O.P. Gupta, has issued an order on 14th December 2015 stating that the guidelines for 'Examination of Computer Related Inventions (CRIs)', which was released in August 2015, are to be kept in abeyance until the discussion with the stakeholders is complete. The guidelines were released with the intent of removing any doubts over patentability of software in India but they left a grey area. Some contestable issues in the new guidelines were as follows:

— **Mathematical Formula:** S. 3(k) of the Indian Patent Act, 1970 expressly excludes mathematical formulas from being patentable invention. The guidelines side steps from this stance and allows room for patenting of mathematical formulas in the form of encoding/decoding, encryption and decryption. Thereby creating confusion between the Patent Act and the guidelines on CRI's.

— **Broad criteria's of Patentability:** The guidelines prescribe broad criteria for determining the patentability of computer programs these are:

- Novel hardware;
- Novel hardware with a novel computer programme, or
- A novel computer programme with a known hardware which **goes beyond normal interaction with such hardware and affects a change in the functionality and/or performance of the existing hardware.**

This issue has not been adequately explained in the guidelines and there is room for clarification.

— **Example 8.4** in the guidelines cites an example of Computer related invention that can be patentable "*a computer implemented method comprising: identifying one or more person names in a set of one or more documents, with each identified person name more likely to refer to a single person in a profession than other person names in the document; identifying descriptive language from one or more documents, based on the identified names; and identifying within one or more documents other person names that refer to persons in the profession, based on one or more portions of the identified descriptive language.*" This example is arguably a business method and according to the Patent Act it cannot be eligible for a patent.





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After their release the Controller received objections from some stakeholders following which the order for staying the application of the guidelines was issued. This is a welcome move since it gives the stakeholders an opportunity to get their concerns heard and resolved by the Concerned Authority. Also, a further revision will enable Patent Examiners to determine the patentability of Computer related inventions without any ambiguity; a uniform examination process will lead to more certainty for the Applicants of Computer Related Inventions.

## **Early bird catches the worm**

Time is of the essence is not a mere boiler plate clause in a contract, it communicates a very important principle in the legal world –slightest delay can incur extra-legal expenditures. A recent example of this is the case of *Colgate Palmolive Company and Anr. v Anchor Health and Beauty Case*.

In 2007 Anchor filed a suit against Colgate alleging that Colgate had started selling its product in a new carton using a tooth device and using the phrase “*White Allround Protection*” similar to Anchor’s cartons consisting of the phrase “*All Around Decay Protection*”. The suit was titled for “*restraining tortious acts of unlawful interference*” against Colgate. In 2008, the mark “Allround” was registered in the name of Anchor with the trademark registry but this was not mentioned in the suit until 2011 when Anchor sought to amend the application and changed the nature of the suit to one for “*restraining infringement of registered trademark/passing off....*” This amendment application was allowed by the Hon’ble Single Judge at the Delhi High Court and this order was contested by Colgate before the Division Bench.

The Division Bench reversed the decision of the Single Judge. The suit was initially filed for similarity in trade dress but if the amendment was allowed it would escalate to a suit for infringement of trademark. The Court held that the Plaintiff had let 3 years pass before applying for the impugned amendment and this was seen as a clear case of sleeping over one’s rights. The effect of allowing the amendment would mean that the Respondent would be charged for infringing the Plaintiff’s rights since 2005 which was unacceptable. There have been various Supreme Court judgments rejecting such material alteration and this decision correctly applies these precedents.

## **‘TA’ ‘TA’ to the cyber squatter**

Mimicry is the best form of flattery but mimicry in trademark laws comes with a heavy price. The Law of Trademarks extends to the digital space as well in the form of domain names. Recently the renowned TATA group found itself embroiled in a suit with such a cyber-squatter. In 2011 the Defendant created domain names <http://www.cyrusmistry.co.uk> and <http://www.cyrusmistry.com>. Mr Cyrus Mistry is the present Chairman of the TATA Group. In February 2012, the Defendant contacted the Plaintiffs for the purchase of the aforementioned domain names from him, lest it be sold to parties that could disparage the reputation of the Plaintiffs. The parties agreed to settle the issue amicably. The talks failed when the Defendant did not co-operate and cited frivolous technical issues involved in transferring the domain name to the Plaintiffs. The Plaintiffs filed a suit against the Defendant pursuant to which the Defendant again proposed to sell the domain names to the Plaintiffs for a considerable sum; this offer was not considered by the Plaintiffs. The matter was brought before the Delhi High Court for consideration.

The Court considered this act of cyber-squatting by the Defendant as an infringement of personality rights of Mr. Mistry. It was held that personality rights are recognized in India as a part of right to privacy. The Defendant was held to be guilty of the tort of passing off. The Court took a stringent view of the fact that the Defendant was fully aware that should the domain name be misused it would tarnish the reputation of the individual as well as the organization represented by him. The Plaintiff demanded that punitive damages be paid to them in this case since the Defendant continued to infringe Mr Mistry’s personality rights and would have put the TATA group in to peril if the domain name would have been misused. The Court was satisfied with the Plaintiff’s arguments and ordered for INR 5 lacs to be paid as punitive damages to the Plaintiff. Further, the domain name was ordered to be transferred to the Plaintiff.

## **District Court’s tough stance**

Wise people learn from the mistakes of others, to repeat the same means to invite trouble. Recently, Parle Products filed a suit against Central Burner Industries for:

1. Trademark infringement;
2. Infringement of artistic work under Copyright Act; and



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### 3. Passing off

The Defendants were using the mark 'Parle' and Parle (logo) for selling their gas burners. R.K. Dewan and Co. was arguing on behalf of the Plaintiff in the present case and the Court agreed with the Plaintiff's contention that the Defendants were encashing on the reputation of the Plaintiff for selling their products and therefore, an order was passed restraining the Defendants from using the marks Parle and Parle (logo) for their goods and packaging materials. An Anton Piller order was also passed in favor of the Plaintiff and two Local Commissioners were appointed for seizure of infringing goods from the premises of the Defendants. The Local Commissioners upon the orders of the Court visited the premises of the Defendants and seized 80 boxes and one piece of Parle Burner, each box contained 10 pieces of burners therefore in total 801 pieces of Parle Burner were seized. These products are to be produced as evidence as and when required by the Court.

The District Court's willingness to issue an Anton Piller order in this case shows that the Indian judiciary is willing to send out a strong message to infringers and the public at large to not take liberties with the existing law.

## Putting a leash on copycats

While it is seemingly easy to copy works from another, in the long run it is always better to create your own work. Originality of content is the *prima-facie* requirement of copyright law; it respects the creativity involved in creating a work. It has been an established principle since *EBC v DB Modak* that 'sweat of the brow' doctrine is no longer the criteria to claim copyright; the work has to qualify for the 'skill and judgment' test as well i.e. there must be certain amount of skill and judgment involved in creating a work, it cannot be a mechanical process. Also, it was held that the additional comments like head notes or summary of a judgment will qualify as a copyrightable work under the 'skill and judgment' test. In spite of this clear decision of the Indian Supreme Court, history repeated itself when [www.casansaar.com](http://www.casansaar.com) was alleged to be copying editorial comments and headnotes to cases from Taxmann's publications.

The Editorial comments and case headnotes are considered as 'literary works' under Section 2(o) of the Copyright Act, 1957. It was claimed by Taxmann that the works were a result of the skill and judgment exercised by their team/staff and hence, liable to be protected under S. 13(a) and 14 of the Act. Further, Taxmann submitted as evidence, two case laws where the editorial comments and headnotes had been allegedly copied by the Defendants. On examination of the evidence the Delhi High Court reached the conclusion that there was a prima facie case of copyright infringement and the defendants were restrained from infringing the copyright of the Plaintiffs and the infringing content was ordered to be removed from their website.

## New movie, old story

It has recently been reported that Director Ashutosh Gowariker's upcoming movie 'Mohenjodaro' has found itself in a plagiarism controversy. Filmmaker Akshaditya Lama has sent a legal notice to Director Ashutosh Gowariker. He has alleged that the script of the movie Mohenjodaro is similar to his script with the same name which he had completed in 1995 and discussed with his friend Jaswinder Saluja, an associate of Ashutosh Gowariker, who had shared the story with Mr. Gowariker.

Akshaditya Lama has claimed that his script has been registered online with the Ministry of Human Resources and Department of Higher Education under the Copyright Act. He claims that he has also registered his script with the Film Writers Association. These allegations have been refuted by the lawyers of the reputed director. The outcome of this allegation remains to be seen.

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