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A new dimension

A trademark depicts the origin of the goods. Therefore proprietors across the world seek to register marks which are distinctive. An important consideration before zeroing upon a trademark is that, the mark should not be descriptive of the goods for which it is sought to be registered. A typical problem that arises in selecting a descriptive mark was observed in the recent decision of the General Court (European Union), in the case of Olympus Medical Systems Corp V Office of Harmonization of Internal Marks (OHIM).

Olympus Medical Systems Corp filed an application for registration of a community



trademark. The registration sought was for Medical and Surgical apparatus and instruments, comprising 3D processors, 3D light sources, LCD monitors and 3D medical endoscopes. This mark was rejected by the Trademark Examiner on the grounds that the mark was descriptive. This decision was appealed but was dismissed. The matter was again appealed before the General Court. The General Court accepted OHIM's contention that the distinctiveness of a mark had to be assessed according to

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the relevant public (consuming/using the goods) and the goods for which the mark is being sought to be registered. In the present case the logo/mark '3D' represented the three dimensional function of the goods. There was no distinctiveness involved. The Applicant's contention of the mark's figurative element being creative and not merely decoratively was rejected. The General Court upheld the OHIM's contention that the figurative elements of the mark applied for, reinforced the descriptive meaning of the word element, and hence the board was justified in rejecting the registration of the mark. The Appeal was dismissed with costs to be paid by the Applicant.

Proprietors need to be careful when they choose their mark as it will determine the level of protection that may be accorded to it. This decision is a classic example of the consequence of attempting to register a descriptive mark which lacks any distinctive element(s) and both are grounds for refusal of registration of mark.

'Lawyer'ly yours

We, at R.K. Dewan & Co. believe in spreading awareness about protection of IP rights and have constantly worked in this direction. Recently, a Mumbai based IPR law firm through its website was infringing our IP rights. This law firm had reproduced the contents of our website on their own webpage and projected it as their own content. The amusing part is that in their attempt to copy our content they forgot to change the name of the law firm from "RK Dewan"/ "RKD" to that of their firm.

When we became aware of this blatant infringement our rights we acted immediately and filed a Trademark and Copyright infringement suit before the Hon'ble Pune District Court on 13th January, 2016 and asked for an order of injunction against the infringers. The matter was heard on 21st January, 2016 and on the same day an ex-parte ad-interim injunction order was passed in our favor thereby injunctioning the other party from further infringing our IP rights. We sent the order of the Hon'ble Court to the other party on receipt of which the counsel for the other side approached us for a compromise. On 4th February, 2016 an order for permanent injunction against the infringing party was passed by the Hon'ble Court.

In less than a month's time our firm succeeded in obtaining a permanent injunction order against the infringer and also, a written assurance from the infringer stating that no such act of infringement will be committed by them in future. As IP attorneys and ourselves, content creators, we understand the value of Intellectual Property rights and the need to take immediate legal actions against such perpetrators of law. The Hon'ble Judge, upon the establishment of a case of infringement, immediately passed an order for ad-interim injunction thereby reflecting the positive approach of the judiciary in

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deciding IP related matters. This shows that our courts are warming up to the idea of protecting Intellectual Property rights; one can only hope that it gets better from here.

Defining boundary lines

Defining the powers and jurisdiction of specialized judicial bodies and the Courts is essential to ensure proper functioning of the legal system. Often there is an overlap between the powers of specialized judicial bodies and Courts; thereby creating ambiguity in legal proceedings. Section 124(1)(b)(ii) of the Trademark Act has been subjected to different interpretation by various Courts in the country. The Application for rectification of a mark before the IPAB deals with validity of trademark registration when a suit is pending before a civil Court. The question is whether prior approval of the Court is necessary in such cases. The Delhi High Court, in the case of Data Infosys Ltd & Ors vs Infosys Technologies Ltd., has made an attempt to define the powers of Courts and the IPAB.

Infosys Technologies (Respondent) had filed a suit for trademark infringement against Data Infosys (Applicant). During the pendency of this suit, the Applicant's mark was registered by the Trademark Registrar. The Respondent filed for rectification of the registration of the mark before the IPAB, the Applicant petitioned the Court that the Respondent could not file an application for rectification of mark under S.124 (1) (b)(ii) without obtaining the prior permission of the Hon'ble Court. The Applicant cited *Astrazeneca UK Ltd. & Anr. vs Orchid Chemicals and Pharmaceuticals Ltd* (Astrazeneca case) to substantiate their claims. The Respondent, on the other hand, relied upon the Madras High Court decision in the case of *B. Mohamed Yousuff vs Prabha Singh Jaswant Singh & Ors* where it had been ruled that a right to file an application for rectification is a statutory right, conferred upon a party who is aggrieved by an entry made in the register. The Delhi High Court decided in favor of the Respondent's claims and overruled its previous decision in the *Astrazeneca* case. The Court ruled that, the IPAB's power of assessing the tenability of a plea for invalid trademark registration was not dependent upon the ruling of civil Courts. The Court further opined that, when a plea for invalid trademark registration is pending before the IPAB under Section 124(1) (i)(a) the suit before the Court (concerning the same matter) ought to be stayed until the decision of the IPAB. However, if there is no application for rectification before the IPAB when the suit is pending before the Court and a party to the infringement suit wishes to challenge it after the filing of the suit, it may do so within an allotted period of time. If a party does not file a rectification suit during the allotted time frame granted by the Court (under Section 124(1) (b)(ii)), such a party is barred from raising this plea.

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Aggrieved Adidas

The trademark laws in India provide bona-fide proprietors of marks two chances to prevent another party from benefitting from the registration of a deceptive/identical mark. The first chance occurs when the mark is advertised before registration, in the trademark journal. If this chance is not availed for any reason there is another lifeline. After registration is granted, a rectification application can be filed. A rectification application can be filed by an 'aggrieved person' alone whereas; an opposition can be filed by any person.

The definition of an 'aggrieved person' includes a party who is directly or indirectly affected by the registration of the mark. Recently the shoe company Adidas filed for rectification and removal of the mark 'RESPONSE', registered by another party (Respondent). Adidas claimed that it had ownership of the mark 'RESPONSE' for its shoes, in U.S.A and Germany. Adidas' case was that the Respondent had not renewed its mark since 2011. Further, the Respondent was not present for the proceedings before the IPAB thus, showing that the Respondent had no interest in pursuing the matter or defending its mark and thus justifying removal of the mark from the Register.

The IPAB rejected the rectification application on the grounds that to establish oneself as an 'aggrieved person' in an ex-parte hearing, the Applicant has to show their use and reputation by placing sufficient bills and invoices on record for the IPAB's perusal. It was held that Adidas had failed to show its use of the mark 'RESPONSE' and therefore, could not be considered to be as 'person aggrieved' as a result, they were unable to show confusion or deception in relation to the mark in the minds of the public. Therefore, IPAB dismissed the application. This interpretation of the term 'person aggrieved' by the IPAB was rejected by the Delhi High Court. The Court ruled that the term 'person aggrieved' was of a broad ambit and includes a party that had been refused registration of its mark due to prior registration of a similar mark by another proprietor or what mark was opposed. The IPAB's finding that 'even when the marks and goods are identical, there is no person aggrieved' was held to be contrary in law. The Court further observed that, though the IPAB had ruled that there was no evidence as to the use of the mark 'RESPONSE' by Adidas, it had simultaneously noted that the use, if any by Adidas, was after 2005. This finding was held by the Court to be contrary to facts and therefore, the IPAB's decision was set aside and the matter was remanded back to IPAB for re-consideration.

This interpretation by the Court is a breather for Adidas as well as many other parties that have applied for rectification of marks before the IPAB and are currently not using their mark in India.

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Dear John Doe

The year 2015 witnessed the Indian film industry becoming vigilant about preventing the piracy of their movies. This vigilance in Bollywood led to a couple of John Doe orders passed against the copyright infringers. It seems that this trend of obtaining John Doe orders is here to stay in 2016 as well as the Delhi High Court recently passed the order against potential copyright infringers in a civil suit filed by Balaji Motion Pictures Limited. The film producers were under the apprehension that their forthcoming release 'Kya Kool Hai Hum 3' would be made available online by various miscreants despite the work being protected under the Copyright Act, 1957. The film producers impleaded the Telecom Regulatory Authority of India (TRAI) as a defendant in the suit due to the fact that various cable operators are governed by TRAI and it is because of lack of implementation of the existing provisions of the Copyright laws by the Government Authority that such infringements are continuously committed.

The Delhi High Court passed the order restraining around 300 entities from making available to the public, the movie 'Kya Kool Hai Hum 3' unless a prior authorization was obtained from the movie producers. Interestingly, the High Court has instructed the Government Authorities to ensure 'compliance of the order.' The concept of copyright owners themselves seeking remedies through courts to prevent infringement in itself shows that there is a major lack of will to implement copyright laws and it is time that this concern is addressed by the Indian Government. More so, the film industry as a whole suffers significant losses because of rampant piracy. It has become imminent for Government Authorities to: 1) introduce initiatives to create IP awareness across the country; and 2) Ensure strict enforcement of the existing laws to deter individuals from committing such infringing acts. Such a move will not only advance the interest of IP owners but also benefit the government's ongoing 'Make in India' and 'Digital India' initiatives.

Basmati wars

Basmati rice is exclusively grown in Indian sub-continent and India is the largest exporter of Basmati in the world. In the past, the Indian government was involved in a bitter patent war with the U.S.PTO over the grant of patent on Basmati rice to a U.S. Company –RiceTec. While the Indian government succeeded in getting the patents covering Indian Basmati revoked, it could not prevent the U.S. Company from using the trademark 'Texmati' which is deceptively similar to 'Basmati'. The Indian public has learnt a lesson from this past experience and therefore, an attempt was made by Agricultural and Processed Food Products Export Development Authority ('APEDA') to protect Basmati rice as a Geographical Indication (GI) for the regions where it is being grown in India.

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This attempt of the APEDA was met with stiff opposition from the State of Madhya Pradesh and the Basmati Growers Association, Pakistan. The State of Madhya Pradesh filed an opposition on the grounds that the Application for Basmati as a GI had excluded 13 territories of Madhya Pradesh (M.P.) where Basmati rice is grown. It was claimed that this exclusion would hamper the interests of the farmers of these regions. The IPAB took into consideration this plea of the State of M.P and stated that APEDA's application would be reconsidered with the view of inclusion of regions of M.P among regions enjoying protection under GI Act.

The application of Basmati Growers Association, Pakistan (BGA) stated that Basmati rice was grown in both India and Pakistan. It is pertinent to mention that Basmati Growers Association suffered an order of rejection from the Registrar of Trade Marks, Pakistan to register BASMATI as a collective mark. The IPAB Bench dismissed the appeal filed by BGA as there was no justification for them to intervene and interfere in the proceedings initiated by APEDA in respect of getting GI Tag for BASMATI rice covering the areas within the territory of India. Furthermore, the Bench was of the opinion that no steps were taken by BGA to substantiate their claim in respect of BASMATI in their own country, Pakistan. Accordingly, APEDA's application was allowed and the appeals by the oppositions were dismissed.

India –Pakistan Courtroom showdown

India-Pakistan showdowns, whether in sports or political relations, are always newsworthy. This time there was a change in the battleground and the reason for the showdown was the claim over 'BASMATI' rice as Geographical Indication (GI) by both the countries. The Indian body Agricultural and Processed Food Products Export Development Authority ('APEDA') filed an application for protection of BASMATI rice as a GI for certain regions in India this, was opposed by the Basmati Growers Association, Pakistan (BGA).

A notice of opposition was served upon APEDA and accordingly the due procedure of filing counterstatement to opposition; following which, the BGA was directed by the Assistant Registrar of Geographical Indications to file evidence in support of opposition. There was a delay on behalf of BGA in filing the evidence in support of opposition, this fact was admitted by BGA itself. The APEDA filed an interlocutory petition contending that BGA had not filed the evidence within the stipulated time period under Rule 44 of the GI rules, 2002. It was also claimed that the affidavit filed by BGA was not in compliance with the prescribed format and therefore, the Opposition filed by BGA ought to be dismissed as 'abandoned'. It was further stated by APEDA that compliance with rule 44 of the GI rules was a mandatory requirement and non-compliance would result in the opposition being considered as abandoned. The APEDA succeeded in its claims

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against BGA before the Assistant Registrar of GI and hence an appeal was filed by BGA against APEDA before the IPAB.

The IPAB compared this provision of the GI rules with the Trademark Act rules since, the procedure for filing an opposition to an application for registration (of trademark and Geographical Indication) is similar. Rule 50 of the Trade mark rules is similarly worded as rule 44 of the GI rules and due to this reason the IPAB took into consideration interpretation of various Indian courts pertaining to strict compliance with rule 50.

The IPAB upon referring to various decisions concluded that the compliance under rule 50 of the trademark rules (hence, also rule 44 of the GI rules) was mandatory and if the evidence of opposition was not filed within the prescribed time the application would be deemed to be abandoned. The IPAB further ruled that the GI act was a special act and therefore it was necessary for parties to be vigilant about their rights and procedure to be followed under the Act. Since, the BGA had failed in adhering to the time frame prescribed under the rules it was only correct that the opposition be deemed as abandoned. The order of the Assistant Registrar was upheld by the IPAB. This means that for now, Pakistan has missed an opportunity to oppose the Indian GI application for Basmati rice, it remains to be seen if this order of IPAB is challenged further by BGA.

Eyes for infringement

The principles of trademark law in India permit any trader to adopt a mark that consists of numerals. But are the principles of likelihood of confusion for word marks applicable to numerals as well? The Delhi High Court had to recently decide on these lines in the case of *Mona Aggarwal & Anr vs. Glossy & Piantis Pvt. Ltd. & Anr.*

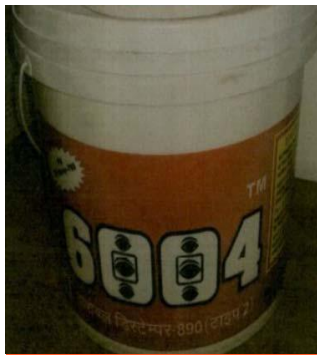
In this case the Plaintiff i.e. Glossy Colour Paint Pvt. Ltd, claimed that it had prior use over the mark “1001” because of its adoption since 1946, it was also claimed that the mark was distinctive because of the unique presentation of the number ‘1001’ with the zeroes having eyes. Furthermore, the mark was used in relation to paints, distempers, varnishes, etc. There was a clear disconnect between the mark and the goods (thereby establishing the distinctiveness of the mark).

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[Respondent's Trademark]

The Respondent claimed that it had adopted the impugned mark “6004” since 2011 and the color scheme, get-up and packaging in respect of its trademark for similar line of goods was coincidental.



[Appellant's Trademark]

The learned Single Judge Bench after comparing the two trademarks and applying the test of “a man of average intelligence with imperfect recollection” observed that prima facie the mark of the Respondent was indeed deceptively similar to that of the Plaintiff. The similar ‘Eye Device’ and the color combination were likely to confuse the consumers. As a result an order was passed, restraining the Respondent from making use of the impugned trademark for any further trade purposes. The Respondent filed an appeal. At the same time the Respondent proposed to alter. The Plaintiff continued to object to the Respondent’s mark and claimed that the numeral ‘6004’ of the Respondent’s mark would still be considered as deceptively similar to its ‘1001’ mark and as a result would cause confusion.

The Court assessed the case and held that one party’s adoption of a numeral as a trademark for its products does not in itself bar another party from adopting different numerals as a trademark for their goods. The Respondent was granted the leave to alter. The Court directed both parties to the suit, to proceed to trial. The Court’s move of permitting alteration of the Respondent’s trademark is a step in the right direction, as it will prevent continuing infringement on one hand and yet allow a trader to legitimately trade in its goods.