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- PROCEDURE TO RECORD CHANGE NAME OF PROPRIETOR OF A REGISTERED TRADE MARK
- MARK AS A WHOLE
- TIME BOUND ISSUANCE OF CERTIFIED COPIES BY THE TRADE MARK REGISTRY
- DELHI HIGH COURT RE-VISITS THE PROVISIONS OF SECTION 17 OF THE COPYRIGHT ACT
- CEASE UNTIL FURTHER NOTICE
- THE CHEQUERED SCARF DESIGN
- BLURRED LINES

Procedure to record change name of proprietor of a registered trade mark

The recordal of change in the name of proprietor of a trade mark is done by the Registrar of Trade marks. This name change usually results from (1) a typographical error in recordal of name; or (2) transfer/change in ownership of the Trade Mark by assignment. However, it is not possible to record a new proprietor's name unless the relevant documents have been put forth on record. In the case of *Kantaben Manibhai Patel v Premchandbhai Venidas Patel* decided by the High Court at Gujarat, the issue revolved around recordal of change in the name of proprietor by the Registrar of Trade marks.

In 2001, the Trade Mark "OCLEG" was filed for registration in Class 07, 09 and 11 by the Plaintiff (Ms. Kantaben). In the year 2005, the Respondent (Mr. Premchandbhai Venidas) filed TM-16 for change in the name of the applicant of the abovementioned trade mark in the three classes. The Trade Mark Registrar did not take into consideration the TM-16 filed by the Respondent and in 2006 registered the trade mark 'OCLEG' in classes 07, 09 and 11 in the name of the Plaintiff. Pursuant to the registration, the Respondent wrote a letter to the Trade Mark Registrar for considering the TM-16 filed by them prior to the registration; this letter was accompanied with partnership deed, retirement deed and extract from the Registrar of the firm to change the constitution of the firm. The Registrar accordingly recorded that Respondent was the proprietor of the trade mark "OCLEG". The Respondent had, in the year 2005 filed a civil suit against the Plaintiff alleging passing off, trade mark infringement; it was alleged that pursuant to the retirement deed, the Plaintiff no longer had any rights in the trade mark 'OCLEG'. The Plaintiff responded by stating that the retirement deed was concocted. In 2007, the Plaintiff filed a suit against the Respondent alleging passing off and infringement; the Plaintiff also filed an application for obtaining interim injunction.

The Plaintiff claimed that the Trade Mark Registrar did not have the right to record the Respondent as the proprietor of the trade mark 'OCLEG' in the specified classes after registration; it was necessary for the Respondent to have filed for rectification to record the name of a different proprietor. This was countered by the Respondent's counsel by

stating that the TM-16 Application had been filed prior to the registration of the trade mark and it was a mistake of the Registrar to not consider the TM-16 prior to registration. It was also submitted that for making such change, no other legal procedure was required to be followed. The Respondent's counsel further stated that the Plaintiff was aware of the change in proprietor's name and did not pursue any legal action; furthermore, the Plaintiff also delayed in pursuing its petitions against the Respondent. It was an admitted position that pursuant to filing the trade mark applications the Plaintiff entered into a partnership with the Respondent and was trading as M/s OCLEG Controls, later the Plaintiff retired from the partnership. It was claimed by the Respondent that pursuant to the retirement deed the Respondent became the owner of the trade mark 'OCLEG'.

The High Court decided that the change in name of the proprietor of the registered trade mark could not be made on the basis of TM-16, it was necessary to have heard the Plaintiff. However, the Court noted that the Plaintiff itself had not been vigilant to pursue her applications because of which the Respondent's name was recorded in the Register as the proprietor of the trademark since 2007 up to the time of hearing of the matter by this Court. The Court directed the Registrar to hear the matter afresh until then the Respondent will be considered as the proprietor of the trade mark 'OCLEG'.

Mark as a whole

At the time of adoption of a trade mark, it is advised that the mark adopted is unique and should have a quality of being easily recollected by the end users, this helps in creating a niche in the market for such brand. It is also possible that more than the word mark, it is the specific colour combination, the graphic features of a mark that add to the distinctiveness and recollection value of a trade mark, it is because of these factors that the principle of viewing a 'trade mark as a whole' has evolved in the trade mark laws.

Recently, in the case of *Dyna Roofs Pvt. Ltd. v Dura Roof Pvt. Ltd.*, the plaintiff filed two civil suits against the Defendant claiming infringement of its trade marks 'Dynarook' and 'Dynamalume' respectively. The Defendant was using the trade marks 'Durarook' and 'Duralume' respectively. The Plaintiff claimed that the Defendant's use of the above stated trade marks amounts to an act of infringement; it was also admitted by the Plaintiff that the only difference between the Plaintiff's trade marks and the Defendant's trade marks were the prefixes 'Dyna' and 'Dura'. The matters were heard by the District Judge, Guwahati and he held that the Plaintiff had established a prima-facie case of infringement by the Defendant in both the cases. These decisions were appealed before the Guwahati High Court where a stay was ordered against the injunction order passed by the Guwahati District Court.

The premise of the Plaintiff's arguments that there was similarity in the 'suffix of the trademarks of the Plaintiff and Defendant, cannot be the grounds for grant of injunction. A trade mark has to be viewed as a whole and it has to be assessed whether there exists any phonetic or conceptual similarity between the trade marks. The matter has now been sent to the District Court for further adjudication. R.K. Dewan & Co. was the law firm advising and drafting the arguments for the Defendant in these suits.

Time bound issuance of certified copies by the Trade Mark Registry

The Indian trade mark registry is burdened with the surge in trade mark filing followed by prosecution of trade marks and then registration. It is for this reason that there is often delay in obtaining certain official records from the Trade Mark registry which may not be otherwise available. A similar situation arose in the case of *Registrar Of Trade Marks vs Kapoor Saws Manufacturing Co & Ors* ; and *Registrar Of Trade Marks vs Sonik Industries & Ors* where the district judge required certain official records from the Trade Mark Registry however, the same was not complied with. This was followed by an order under Order XVI rule 10 under which the Registrar was required to be present before the Court to produce the requisite records. The Registrar filed a revision application before the Delhi High Court claiming that pursuant to receiving the proclamation, the requisite documents had been provided to the Respondents and in accordance with Section 137 of the Trade Marks Act, 1999 , any document showing an entry in the trade mark register, if certified by the Registrar is an admissible evidence. Furthermore, Section 138 lays down that a trademark Registrar cannot be compelled to produce documents or be presented as a witness before a court to prove matters except in special cases. The Respondent argued that obtaining certified copies from the trade mark registry usually takes time thereby causing inconvenience to litigants. It was reasoned that this delay is the reason for courts to issue proclamation under Order XVI rule 10, asking the Registrar to be present before the Court as witness.

Justice Endlaw dismissed the revision application filed by the Trade Mark Registrar and issued the following guidelines to the office of the Trade Mark Registrar:

- (i) If not already in place, nominate one Nodal Officer of each branch to receive applications for certified copies and to issue certified copies.
- (ii) To, within two months of today, announce on the website of the Registrar of Trade Marks, the particulars i.e. name/designation, address, phone number/s and email address of the Nodal Officer responsible for accepting and entertaining applications for certified copy and to issue certified copies for each office of the Registrar of Trade Marks.
- (iii) To, within six months of today, make a provision, if not already in existence, for making online applications for certified copies.
- (iv) To, within six months of today, make a provision on the website of the Registrar of Trade Marks for disclosure of the status of the applications for certified copies including any deficiency or defect therein required to be remedied by the applicant and/or the date when it will be ready for collection.
- (v) To, till the aforesaid is functional, as an interim measure, make a provision for sending intimation, to the applicant/s for certified copies, of deficiencies / defects required to be rectified via e-mail, SMS and other modes of communication.

- (vi) To, endeavour to make provision for online payment of the fee and other charges if any for certified copies.
- (vii) To issue certified copies within one month of the receipt of a duly completed application.
- (viii) To indicate on the certified copy, whether it has been prepared from the original of the document or from a copy of the document.
- (ix) To explore the possibility of making an endorsement of „original seen and returned? on the copies on the record, originals of which are returned.
- (x) To ensure, that the certified copies are legible and wherever the original / copy on the record of the Registrar of Trade Marks has any colour other than black and white, the certified copy reflects such colour.
- (xi) To, if the documents of which certified copies is sought have been lost or misplaced, intimate the same to the applicant within one month as aforesaid of the application for certified copy having been made.

It is expected that these guidelines if implemented will be helpful to litigants across the country and will result in expedited receipt of certified documents from the Trade Mark Registry.

Delhi High Court re-visits the provisions of Section 17 of the copyright act

The Copyright Act, 1957 under Section 17 lays down that the author of the work shall be the owner of the work, subject to certain exception. One commonly prevalent exception is if the work is created in the course of one's employment; Section 17(c) lays down that if work is created during the course of one's employment, such work will be assumed to be owned by the employer unless there is an agreement to the contrary. This section however was re-visited recently by the Delhi High Court in the case of *Neetu Singh vs Rajiv Saumitra & Ors.*

In the abovementioned case, the Plaintiff had written the book "English for General Competitions -From Plinth to Paramount" and claimed that the Defendants were infringing her copyrights in the literary work and the artistic work on the cover of the book. The Defendants claimed that the Plaintiff, at the time of writing this book was a Director in Defendant No. 2 and therefore, by virtue of her employment, the copyrights in the work(s) created by her during such employment will vest with Defendant No. 2. The Plaintiff submitted that she had obtained copyright registration for her literary work and had recently changed the title of her work to 'English for General Competitions'. The Plaintiff further submitted that her books were marketed by Defendant No. 2; in 2015, she learnt that Defendant No.1 connived with Defendant No. 2 and was illegally selling her book "English for General Competitions –From Plinth to Paramount" at half the price of the Plaintiff's books.

The Plaintiff claimed that the book is a verbatim copy of the plaintiff's book under identical title and the graphic representations of two mountains has also been copied by the defendants in toto with a slight colour variation. The Defendants claimed that the Plaintiff as director was working for the company, however, the Plaintiff stated that she did not enter into a contract of service with Defendant No.2 and in the absence of such contract, under Section 17 the plaintiff's copyright in the work continued to vest with her. The Plaintiff further submitted that there was no evidence on record to show that Defendant No.2 was the employer of the Plaintiff and therefore, she would continue to be the owner of the copyright in the work. The Court heard the matter and ruled that the director of a company may be considered as an employee of the company but the same would depend upon the terms of employment of the director which may be penned down in the Articles of Association. In the present case there was no document to show that the Plaintiff was an employee of Defendant No.2. Therefore, the Plaintiff had the copyright in the work and the Defendants' activities would amount to infringement of her copyright.

This decision will result in stricter employee contracts between a company and its directors to ensure that there are no loopholes at the time of claiming copyright in the director's works. It will be interesting to note the outcome of this decision in the companies.

Cease until further notice

It has become a common practice that prior to release of a film there are claims of copyright infringement of an earlier script and usually the Bombay high court has held a firm stance that in the event there is a genuine case an injunction may be granted however, the litigation cannot be means for the party filing the suit to unjustly enrich. This month, Ajay Devgn starrer 'Baadshaho' found itself in legal trouble over a copyright infringement claim. The suit was filed by Trimurti Films Pvt Ltd (Plaintiff) against Super Cassettes Industries Pvt Ltd (Respondent) claiming that the latter had used the song 'Keh Doon Tumhe' without obtaining prior permission.

The Plaintiff claimed that the said song was a part of its 1975 movie 'Deewar'. The Plaintiff claimed that the copyright in the movie along with the song vest with it alone. The Plaintiff further stated that in 1974 it granted Universal Music Media Pvt. Ltd. (then Polydor of India Ltd.) rights to make and sell gramophone records of the songs of the film Deewar and the mechanical reproduction rights for the limited purpose of making and selling gramophone records. The Plaintiff claimed that the right to use the sound recordings or the underlying works including lyrics and the tune for any other purpose whatsoever continued to vest with it. The Respondent argued that while the Plaintiff was correct in claiming rights in the lyrics and music composition of the song, it was to be noted that the Plaintiff had assigned its rights in the sound recording to Universal Music and the Respondent obtained its rights from Universal Music Media Pvt Ltd.

Justice Sriram, upon hearing the arguments of the Plaintiff and the Respondent concluded that the primary issue to be decided in the present case was whether assignment of sound recording rights also amounts to eventually vanquishing rights in the musical composition. The counsel for the Respondents argued that the Plaintiff's rights

would be infringed if a book was published with lyrics of the song in question or if the same musical composition was used for another song. It was ruled that the Plaintiff had assigned only sound recording rights to Universal this assignment however could not be considered as an assignment of the underlying lyrics and musical score in the film and therefore, the Respondent could not have obtained rights to use the same for its movie 'Baadshaho'. Therefore, the Respondents have been restrained from releasing the film with the song 'Keh Doon Tumhe' however, the Respondents may release the film without that song.

This is an interesting case which dealt with the difference between musical works and sound recordings, the two being independent rights under the Copyright Act, 1957. It has become a practice in Hindi film industry to re-make old song, however it is important that prior to re-making such songs permission should be sought from the original right holders to avoid expensive litigation and even more expensive outcomes such as injunction.

The Chequered Scarf Design

The novelty of a design is an important criterion for obtaining a registration from the Controller of Patents and Designs. The novelty criterion may be hit by the argument that the design applied for registration/registered was anticipated by prior known designs. Recently, in the case of *T.K Shawl Industries Pvt. Ltd. v Controllers of Patents & Designs & Ors* the Kolkata High Court decided when a design can be stated to be anticipated by prior known designs.

The Appellant (T.L Shawl Industries Pvt Ltd.) had filed a suit for cancellation of registered design No. 252082, for a 'scarf'. The following is the representation of the registered design



It was claimed that the design registered was capable of being anticipated by prior known designs. The Appellant stated that it was also engaged in similar line of activities as the design registrant and therefore, registration of this design. The Appellant also furnished on record copies of its invoices and shipment details of shawls of similar designs being exported to different countries, all dated prior to the registration date of the scarf design. It was further

claimed that the design lacked novelty since the surface pattern applied to the impugned design was nothing but combination of already known designs. The Deputy Controller of design when presiding over the cancellation petition perused the evidence on record and reached a finding that none of the documents and/or invoices referred to the impugned design shows any prior publication of the design. The Deputy Controller also examined other documents to decide if the registered design could be considered as devoid of newness. A reference was made to the decision in the case of *ITC Limited v Controller of Patents & Designs* where it was held that an idea may be potentially capable of registration but it has to be reduced into a visible form to be identified with. Furthermore, he also referred to the case of *Anuradha Doval v The Controller of Patents & Designs & Ors.* it was held that for a document to be considered as prior publication, *"then a reader of it, possessed ordinary knowledge of the subject, must from his reading of the document be able, at least, to see the design in his mind's eye and should not have to depend on his own originality to construct the design from the ideas which the document may put into his head."*

The High Court heard the matter and observed that the invoices and shipment details attached by the Appellant were pertaining to sale of shawls which is a different article from scarfs and fall under different class of goods under the Design Act, 2000. Therefore, the cancellation petition was dismissed. A perusal of the design in question shows that the same is quite simple and per se doesn't appear to be distinctive however, the lack of evidence by the Appellant to challenge the distinctiveness, was the primary reason that the design continues to be on the register. The evidence to be recorded has to be done with utmost diligence so that all the incriminating documents are put forth before the Design Controller. In the absence of such evidence, the design will continue to be registered much to the dismay of proprietors claiming that the registered design was anticipated by prior known designs.

Blurred Lines

The controversy regarding protection of works under Copyright Act, 1957 or the Designs Act, 2000 is unending. Lawyers across the country have argued on various occasions on the definition of designs under Designs Act, 2000 and hence, owners of such artistic works despite having commercialized the work more than fifty (50) times can continue to seek protection of their work under Copyright Act, 1957. However, things were a little confusing when in the case of *Holland Company LP and anr vs S.P. Industries* the Plaintiff sought protection of its engineering drawings under the copyright act.

The Plaintiff claimed that it was the owner of the Intellectual Property rights vested in the Automatic Twist Lock (ATL) and it had supplied such locks to the Indian Rails. The Plaintiff claimed that the design of the ATL and its components are the original artistic works and the copyright in the same vest with the Plaintiff alone. It was the case of the Plaintiff that Eastern Railway, Sealdah Division floated a tender for carrying out the repairs, replacement of spare parts and service, including overhauling and replacement of defective part of ATL devices and the Defendant was successful in obtaining this tender even though the plaintiff also participated in the same. The Plaintiff stated that the Defendant lacked the requisite know-how for repairing the ATL locks and could only do the repairing if it had access to the know-how of the Plaintiff. The Plaintiff further states that the Defendant could easily obtain this information vide the

Publication of the Indian railways, published with the consent of the Plaintiff titled as “The Technical pamphlet for inspection & maintenance of Automatic Twist Locks (ATL) Devices Fitted on Container Flat Wagon” issued by Research Designs and Standards Organization, Ministry of Railways. It contains the said detailed drawings and this document can easily be procured by making payment of Rs.2300/-. It was submitted that the Defendant being in the same trade, aware of such publication copied the drawings of the Plaintiff from this document and also procured the Plaintiff's product and spare parts and prepared the drawings for manufacturing the ATL devices and its spare parts, by using reverse engineering and/or by copying the said drawings. The Plaintiff also claimed that the ATL device consists of these assembly parts which can be manufactured only by the plaintiffs since the plaintiffs have proprietorship rights over it. The Defendant argued that the Plaintiff's engineering designs ought to be protected under the Designs Act, 2000 since the Plaintiff has commercialized more than fifty (50) copies of the same. The Defendant further stated that the Defendant was merely engaging in activities specified in the tender of the Eastern Railways and was not by itself manufacturing the ATL. The Defendant also submitted that the Plaintiff cannot claim proprietary right over the drawings with an intent to keep the other competitors out with a view to maintain monopoly more so when the plaintiffs participated in the bid process and lost the contract.

The arguments were heard by the Court and it was decided that the ATL design could be covered within the ambit of definition of a design; the designs act specifically protects the features of shape, configuration, pattern, ornament or composition of lines or colors applied to any article whether in 2D or 3D form by an industrial process or means. It was correctly noted that the act does not anticipate that it is the design by itself that is commercialized, it is the application of the design by use of an industrial process which is sought to be protected. Furthermore, upon registration of design, the owner can also claim copyright over the same subject to the Designs Act, 2000.