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Compiled by: Adv. Sachi Kapoor & Adv. Aboli Kherde | Concept & Edited by: Dr. Mohan Dewan

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Tik Tok on the Clock!

The web-application TikTok created by a Chinese company– Byte Dance, was initially launched as 'Douyin' in September, 2016 in China. It was introduced in the overseas market as 'TikTok' only in 2018 and it spread like a virus with nearly 500 million+ users. The app is most popular amongst the youth. Recently, a PIL was filed at the Madras High Court by one Mr. S. Muthukumar of Madurai, requesting the Court to ban the app TikTok. The petitioner pleaded that the app contained pornographic content. This has led to social stigma and mental illness amongst youngsters.

The Madras High Court took cognizance of the matter and on April 4, 2019 observed that, the app was in fact largely being used by teenagers and was an addictive one. The Court also compared the app to the Russian app 'Blue Whale' which had reportedly led to multiple suicides all over the world. The Court went on to say that unrestricted access to the TikTok images and videos by predators could have severe consequences. Thus, keeping in view the dangers that the youngsters of the country are being exposed to, the Madras High Court directed a ban on the app as an *interim* measure, in addition to the following:

- The Government is directed to take measures to prohibit the public at large from downloading of TikTok;
- The Media is prohibited from telecasting the videos made using TikTok; and
- The Government has to answer whether the Union of India will enact a statute, like the Children's Online Privacy Protection Act, enacted by the United States, to prevent children from becoming cyber/online victims.

Investigations revealed that youngsters continue to access and download the application from indirect sources in spite of court orders, until Google's Play Store and Apple's App Store decided to delist the app. Further on April 16, 2019, the Madras HC appointed Snr. Adv. Arvind Datar as an independent counsel to assess the implications of TikTok. Meanwhile the proprietors of TikTok moved the Supreme Court pleading it to grant a stay on the Madras High Court's decision and further submitted that a ban on the app would lead to loss of jobs and financial losses. However, the SC declined to stay the High Court's decision and the ban continues.

Samoa: New Joinee to the Madrid Protocol

For businesses all over the world, brand equity and recognition have become vital aspects of product/ service value. To protect brands in the global market, the trademarks are required to be protected in multiple countries where the brand is prevalent. One can file applications for registration of the trademark in multiple countries individually, or apply through the Madrid System for trademark registration.

The Madrid System, as it is commonly known, is a system for streamlining the process of filing applications for trademark registration internationally. The Madrid System is based on 2 main documents, that is, the Madrid Agreement Concerning the International Registration of Marks of 1891 and the Protocol Relating to the Madrid Agreement (1989). It mandates the functioning of international filing of trademark applications in the Member Countries.

Samoa became the newest addition in the list of members of the Madrid Protocol on 4th of March, 2019. Canada also has accepted the Madrid Protocol System and will be a part of it from 17th of June, 2019.

Prior to this treaty, separate applications for the protection of trademarks were being filed individually in countries where the marks were desired to be protected. Further, these applications were required to be in accordance with the domestic laws of those countries and separate fees were to be paid in each country in its respective currency. Even after the registration was granted, it would be a difficult task to keep a track of their timely renewals. This process proved to be tedious and expensive.

The Madrid Protocol facilitated registration of a mark in almost 80% of the countries in the world including the European Union and African Intellectual Property Organization. Madrid Protocol allows individuals and corporations to register their trademarks in more than 110 countries through a simple process of:-

- filing a single application;
- in one language; and
- Paying fees through one currency.

The applicant can designate countries where it seeks to protect the trademark. After submission of application, it is for the designated countries to which a request has been made for protection of the mark, to decide whether a mark is eligible for protection or not in accordance with their domestic legislation. Madrid Protocol allows addition of new jurisdictions in the existing list of designated countries at any time the applicant may choose or if and when new jurisdictions subsequently join the Madrid Protocol.

However, for an application through the Madrid system if there is refusal, withdrawal or cancellation of the basic application or basic registration within 5 years of the registration date of the international registration leads to the refusal, withdrawal or cancellation of the international registration also.

India joined the Madrid Protocol in 2013 and amended its Trademarks Act, 1999 to include **Section 36 A to 36 G** to inculcate the provisions of the Madrid System into its domestic system and to align the Act with the Madrid System.

Patanjali obtains injunction against unauthorised exporters

Patanjali Ayurved Limited ("Patanjali") need not be introduced anymore for its desi products dominate Indian as well as international households. In the recent case of ***Patanjali Ayurved Limited v. Masala King Exports Trading Pvt. Ltd. & Ors***, the Delhi High Court observed that a re-seller, who buys branded products for further sale in the market, is obliged to sell them in the same condition as they were first sold to him. This is also known as the 'principle of first sale'.

Patanjali found that the products which were meant exclusively for the domestic market were being procured and illegally exported to various countries for sale. Patanjali came across instances where the exported products are tampered or altered. This posed a threat to the health of its consumers and also to the goodwill and reputation of brand- Patanjali in the international market. Patanjali issued letters and lodged a complaint with Custom Authorities to restrain such illegal export. However, the Customs Authorities have stated that the Intellectual Property rules do not apply to exports and no action has been taken on the complaint of the Plaintiff.

Patanjali filed a suit for infringement of its registered trademarks against 13 such parties. It stated that its entire export function is handled internally and no external export channel has been authorized by it.

Also, the packaging of products for export is different from that of the packaging of products for domestic sale, as the former is required to be in accordance with the regulating standards of that country. For instance, in the United States, the Food and Drug Administration (FDA) requires a far more detailed description of the products if the products are to be imported there.

Patanjali submitted to the court a representative table of products and its label from which a clear difference can be drawn between products made for domestic sale and other for the export. One example is as follows:

DESCRIPTION	FOR EXPORT	FOR DOMESTIC MARKET
PATANJALI DANT KANTI (FRONT VIEW)		



Patanjali contended that it may be exposed to unwanted legal actions from consumers using such products believing the altered and illegally exported products to be those of Patanjali.

The Court relied on the judgement of *Philip Morris* where the defendant illegally acquired and sold products bearing registered trade mark of the plaintiff. In the suit for infringement, the court had held that the plaintiff need not prove the difference in packaging or quality to constitute legitimate reasons. The sale of the product itself results in infringement of plaintiff's right and he is entitled to injunctive relief.

The same has been observed in this case where the defendants have procured Patanjali's products through illegitimate sources and sold them in the international market.

In view of the same an *ex-parte* injunction order was passed in favour of Patanjali. The defendants have been asked to file a written statement for the allegations made against them on the next date of hearing i.e. April 23, 2019 and until then they are restrained from selling goods bearing Patanjali's registered trademark or any mark identical or deceptively similar to it in the international market. It is also made clear that Defendants may continue to sell Patanjali's products in the domestic market.

Game of Phonetics!

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Recently, at the Indian Trademark Registry, the proprietor of the mark 'HITACHI' viz. Hitachi Ltd. filed an opposition



against the mark 'MITASHI', which is an assortment of the word 'MITASHI' with the slogan 'Endless Entertainment' with the face of a moustached human, filed by Maze Marketing. The Opposition was filed in January 2006. The Opponent contended that the marks 'HITACHI' and 'MITASHI' are phonetically, structurally and deceptively similar to one another, thus alleging that the applicant's mark was adopted in bad faith.


The Applicant's refuted stating that its predecessors have been carrying on business since the year 1992 and have originally conceived and adopted the applied mark. Further, the Applicant's submitted that the mark is a well-known one especially for audio/video games for children. The Applicant's further submitted that the opposition filed was frivolous and baseless.

The Registry took into consideration all the submissions and passed an order in favour of the Applicant and dismissed the Opposition stating that, the two marks were far from being phonetically or structurally similar.

The Applicants in the above mentioned proceedings were represented by R K Dewan & Co.

LinkedIn vs KinkedIn – No we are not kidding!

In UKIPO in 2017, a web services provider viz. JK Solutions filed an application for registration of the mark 'KinkedIn' (Does that ring a bell?) for *"agency services for arranging personal introductions, computer dating services and video dating services"* - primarily online dating services. Well, yes, as you rightly guessed, LinkedIn Ireland Unlimited

Company, being the proprietors of the marks 'LinkedIn' and  filed an opposition against the proposed mark stating the obvious, that the marks had an uncanny similarity and are likely to confuse any person easily.

LinkedIn stated that they have been operating since 2003 and have built a strong reputation by creating one of its kind professional social networking sites. Further, having a parallel site named 'KinkedIn' is likely to tarnish the reputation and goodwill earned by LinkedIn. There was evidence produced before the UKIPO that, the Applicant's Instagram page displayed a page with the heading "Kinkedin.one" above the tag line *"Like LinkedIn..... nah.... not really"*.

The UKIPO earlier this month, agreed with the arguments put forth by LinkedIn and held that, the use of the Applicant's mark is likely to cause confusion amongst the public at large and thus refused the registration of the mark 'KinkedIn'. Further, the Applicant was ordered to pay LinkedIn a sum of £1200.

New Trademark Law in Myanmar

Myanmar recently passed the Myanmar's Trademark Law ("TML") providing a codified framework for the protection of trademarks in the country. Myanmar till date did not have special laws specifically dealing with intellectual property,

hence the newly enacted law (Myanmar recently also passed a new patent legislation) has paved way to a plethora of changes to Myanmar's IP framework, making IP protection more formal and uniform.

Earlier, the process of recording ownership of trademarks in Myanmar was vested with the general law of registration of properties and the registration of trademarks was governed by the common statute for registration of properties i.e. the Deeds Registration Law 2018. With the advent of the new law related to trademarks, Myanmar Intellectual Property Office ("**MIPO**") will be established which shall execute a formal trademarks registration process. Aligning itself with the global trend, Myanmar will now shift from a 'first-to-use system' for claiming trademark ownership to a 'first-to-file system'. Some of the main features of this new law include provisions for registering well-known marks; recognition to various types of marks such as trademarks, collective marks, certification marks, 3D marks (shapes and packaging), geographical indications; acceptance of priority claims, series marks applications and multi-class applications; filing documents either in English or Myanmarian language; increased penalties for infringement cases etc.

It is anticipated that by the introduction of the new law, the process of trademarks registration, prosecution and litigation would be expedited and streamlined.

Can Creation Of Parodies Be Exempted From The Purview Of Intellectual Property Violations?

"My Other Bag" (hereinafter referred to as "MOB") is a US brand which manufactures and sells eco-friendly cotton tote bags. On these bags of MOB, imprints of various designer bags such as Louis Vuitton ("LV"), Prada, Mulberry, etc. are displayed without authorisation from the brand owners. LV asserted that use of its designs on MOB's bags led to trademark and copyright infringement, dilution of trademarks and false designation of origin leading to unfair competition.



Image of LV's bag: the imprint of the bag is in use since 1896; alongside is an image of MOB's bag provided for comparison

The trademarks that LV is specifically referring to is the "Toile Monogram design" which features the letters L & V interlocked with one another and 3 distinct flowers adopted by the company in 1896! LV alleged that, MOB had used their trademarks to create designs that are likely to confuse the public at large and make them believe that the MOB products emanate from LV. In spite of LV's attempts at settlement, MOB was found to not only continue selling

infringing products but also began manufacturing additional infringing products. LV prayed to the Court for preliminary injunction in addition to being awarded monetary damages.

LV's prayer for permanent injunction was refused by the District Court on the grounds that the use of the image on MOB's bags was a mere parody and thus did not amount to trademark infringement. LV appealed, however the Second Circuit Court ruled against it based on 3 primary reasoning's:

1. the caricature drawings and replacing Louis Vuitton's famous interlocking "L" and "Vs" with interlocking "M," "O" and "B" created a stark difference;
2. the consumer market for both the brands was poles apart; and
3. Louis Vuitton was unable to produce convincing evidence that MOB's products caused confusion amongst consumers.

In an appeal to the Supreme Court, the court concurred with the views of the lower courts and concluded that MOB's bags were mere parodies and thus came under the ambit of 'Fair Use'.