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# IP

# Update

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## INDEX

- 02 CHAIR'S MESSAGE
- 04 ACTIVITIES
- 08 NEWS AND UPDATES
- 09 ARTICLES
- 14 POLICY RECOMMENDATIONS
- 15 FICCI IP FORUM
- 16 KEY JUDGMENTS
- 18 FICCI-IPEC



**SHARE, COLLABORATE, VACCINATE**



**Narendra Sabharwal**

*Chairman, FICCI IP Committee & Former Deputy  
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Intellectual property rights (IPR) protection is increasingly relied upon by most creators and innovators for new products, services and solutions, and IPRs continue to play a critical role as the world fights the widespread surging levels of the corona pandemic. The development of COVID-19 vaccines and treatments over the past year has been a key example of the triumph of innovative ideas. The extraordinary speed with which researchers, pharma and life sciences companies have risen to meet this challenge has been remarkable. There have been many innovative endeavours that facilitated the development of a range of inventive products, from therapeutics to diagnostics to delivery tools, which have helped to address healthcare and medical infrastructures and the socio-economic challenges brought on by the Covid crisis. While some entities have adapted and improved existing innovations, others have developed novel solutions to combat the pandemic. In India too, we have witnessed several remarkable innovations, particularly from Indian corporates including MSMEs and start-ups: from sanitization drones, digital stethoscopes to incredibly cheap portable ventilators and affordable Covid-19 test kits. As is known, India has energetically matched global research for development of new vaccines.

As the world confronts the global pandemic, the significant role played by collaborative efforts in patents and other areas of Intellectual property at the international, multilateral, and bilateral levels have assumed increasing importance. There is a lively debate worldwide on the need to rethink the global IP framework during the current, and any future, pandemic towards temporary waiver of IP rights on

Covid-19 vaccines, related technologies and essential drugs; and a call for collaborative partnership to scale up the development and distribution of vaccines, diagnostics and treatments. In normal circumstances, rights holders are justly granted protection over their IP against third-party use. However, with the world now facing an unprecedented healthcare crisis, the need of the hour is for the global community to come together, with the developed economies in particular making bold moves in exhibiting wisdom and enlightened leadership towards vaccine equity, to end the pandemic as quickly as possible.

In this context, it is encouraging that the joint proposal made by India and South Africa to WTO in October 2020, seeking temporary waiver for IP rights under Sections 1, 4, 5, and 7 of Part II of the TRIPS Agreement (covering copyrights, industrial designs, patents, and protection of undisclosed information) as related to the prevention, containment, and treatment of COVID 19, has gained support across several countries at WTO. In May 2021, a revised proposal was submitted by all the co-sponsoring countries which suggested that the waiver should be in force for at least three years from the date of the decision on the matter, stating that the duration must be practical for manufacturing to be feasible and viable. The suggestion has drawn support from a large number of countries, including the US, China and some EU member states, with an agreement to start text-based negotiations on the proposal. While the TRIPS waiver would lift the legal restrictions on manufacturing COVID vaccines (and possibly related technologies, diagnostics and drugs), India needs to ensure that the anticipated WTO directive on the proposal, expected before the year-end, should include facilitating clauses for easy and cost-effective technology transfer and trade related export relaxation of raw materials needed for the manufacture of the IPR waived products. Simultaneously, non-IP bottlenecks such as transfer of know-how, strengthening of supply chains, timely funding and investment to set up brown or green field production facilities and logistics will have to be focussed upon in various countries of the world.

The international community will also have to think hard as to what manner of legal, health, economic and trade related architecture will be necessary to replace IP free space to avoid any vacuum or disruption in attaining the objectives of TRIPS waiver. Some of the positive developments in this respect may be noted. The foremost is perhaps the initiatives taken by WHO and its partners in the Access to COVID 19 Tools (ACT) Accelerator and its global vaccine access programme, COVAX. WHO, UNICEF, World Bank and Gavi have made

assessments in over 140 countries for vaccine readiness and the financial support needed for vaccine roll out. WIPO has developed new tools and platforms to share COVID related technologies, research and publications. There are enough examples of voluntary licensing, open licensing, and joint ventures with tech and know how transfer.

Another positive development has been the statement made by the leaders of the recently concluded G-7 Summit that collaboration is the key against the Covid-19 challenges that transcend borders, and the commitment to collectively ensure one billion additional vaccine doses for international distribution over the coming year. One of the most significant recent developments has been the call made by four world organizations - IMF, WHO, World Bank and WTO - to plan for an estimated USD 50 billion to be spent to end the pandemic swiftly in developing countries, reduce infections and loss of life, accelerate the economic recovery and generate some 9 trillion dollars in additional output by 2025. In other words, a win-win situation both for developed and developing countries. The plan envisages bold moves by developed countries for financing, vaccine donation, and anticipatory investment and planning, and partnership by developing world.

Should the IP waiver in WTO be agreed upon, India ought to be ready to walk the talk as concerns its own IP regime. India will have to start considering making suitable changes in its domestic legal/IP framework to implement and enforce the TRIPS waiver. If the IP waiver proposal runs into some bottleneck, India will need to re-strategize on the use of its IP tools while, at all times, reinforcing its efforts to promote multilateral and bilateral cooperation in the field of public health to combat the pandemic.

Looking ahead, India should also take a cue from the recently announced U.S. Innovation and Competition Act. With a \$250 billion bill, one of the largest industrial bills in US history, it is a bipartisan effort of the US Senate to bolster scientific innovation and competitiveness towards ensuring that American industry remains competitive, with China emerging as one of the world's technological powerhouses. Notably, if a country like USA, normally considered the foremost in innovation globally, is realizing this opportunity as well as the need to accelerate their innovation and competitiveness drive in view of the new technologies and the disruptions that is being caused, India too should look at it as the right time to concentrate the country's efforts at ramping up its investment in R&D. India's current gross expenditure on R&D is 0.65% of its

gross domestic product (GDP), which is significantly lower than the 1.5-3.0% of GDP spent by the top 10 economies, with China and USA figuring at 2.4% and 3%, respectively. Building up substantially on investment in R&D will be key for India to become one of the largest economies; and increased investment from the private sector will be vital to achieve this goal. For India to innovate its way into the future as also to be pandemic-ready for any future eventualities, it would call for a major thrust on R&D by the public and the corporate sector. Although patent filings by Indian residents have witnessed a steady growth of late, their current share at 36% of total applications continues to be low, compared with an average of 62% in other large economies. Domestic firms must increase their share in total patents to a level commensurate with the country's status as a fast-growing dynamic economy. Despite India ranking 48th among 131 innovating countries in the Global Innovation Index (GII) 2020, a significant leap from 81st in 2015, the fact remains that the government contributes 63% to the gross domestic expenditure on R&D. The focus must also be on strengthening India's institutions and their business sophistication to improve the country's performance on innovation outputs.



## FICCI World IP DAY 2021

April 27, 2021

For developing economies, the small and medium sized businesses have been rightfully called the 'engine of economic growth' because when they flourish, the country's economy also grows. In India too, the MSMEs have developed into a dynamic sector, contributing substantially to socio-economic development; and facilitating entrepreneurship and large employment opportunities at comparatively lower capital cost. The driving force behind them is the large number of innovations that has led to productive investments and value-added exports. However, despite the importance of MSMEs, the awareness levels on IPR in this sector continues to be low. This mindset must change to enable the smaller businesses to exploit their intrinsic innovative abilities.



In order to discuss how India's resilient and innovative MSMEs can increasingly exploit their intellectual assets to achieve commercial success and market leadership, FICCI organized a webinar on the theme 'From Minds to Market: IP Exploitation by MSMEs' on 27 April 2021, to commemorate the World IP Day. The subject of the webinar was in keeping with WIPO's focus for the World IP Day 2021 on "the increasing importance of IP rights for small & medium businesses".

Mr Narendra Sabharwal, Chairman, FICCI IPR Committee & Former Deputy Director General, WIPO, in his welcome address, drew attention of the participants to how small and medium enterprises worldwide have been the driving force behind many innovations and the way successful SMEs have been able to reinforce an idea to create a product that consumers wanted, utilized IP rights to protect it and created value for their business. Underlining the inherent innovative abilities of India's small and medium businesses, Mr. Sabharwal emphasized that MSMEs must be encouraged and supported to increasingly adapt IP in business operations, especially considering the emerging technological developments.

Mr Rajendra Ratnoo, Joint Secretary, Department for Promotion of Industry and Internal Trade (DPIIT), and

Controller General of Patent, Designs and Trademarks, while addressing the delegates, said that the growth of the Indian economy was significantly dependent on the MSME sector and stressed on the need for the smaller enterprises to increasingly protect their innovative products by adopting IP strategies in their business operations. Informing that the Government has been taking necessary measures to spread awareness on the significance of intellectual property rights in protecting and monetizing creative inventions by Indian industry, Mr. Ratnoo also elaborated on the various initiatives and schemes that the Department for Promotion of Industry and Internal Trade (DPIIT) and other Government departments have been providing specifically to the MSME sector.

Mr G R Raghavendra, Joint Secretary, Ministry of Law and Justice, emphasized that India's thriving creative industry must become growingly aware of the Copyright law provisions like economic and moral rights, ownership and royalty provisions, the legal remedies, enabling them to benefit by monetization and distribution of their creative works. He also released a handbook 'COPYRIGHT 101' on the occasion developed by FICCI in association with Creative First and IPRMENTLAW, observing that it would serve as a useful guidebook for creators and content producers in the media and entertainment industry.

The webinar was addressed by several other senior policy makers, administrators, IP experts from the industry and the legal fraternity who deliberated on subjects ranging from the need for an increasingly robust IP ecosystem for India to become a knowledge economy, the important role of IP for the growth and success of MSMEs, the avenues available IPR commercialisation, the global best practices in IP strategies, IPR support for MSME policy and regulation, among others. The webinar was attended by over 150 delegates from India and overseas.

## Meeting with Parliamentary Standing Committee on Commerce & FICCI Presentation on 'Review of the Intellectual Property Regime in India'

At the invitation of the Rajya Sabha Secretariat, FICCI made a detailed presentation at a meeting of the Standing Parliamentary Committee on Commerce organised on 7 April 2021, to examine the intellectual property rights regime in India and to elicit FICCI's views on the subject. The meeting was attended by Members from both the Houses of Parliament and chaired by Hon'ble V. Vijayasai Reddy, MP (YSRCP).

Mr. Narendra Sabharwal, Chair, FICCI IPR Committee and Former Deputy Director General of WIPO, provided FICCI's



perspective on the topic of discussion through a detailed presentation covering the important aspects of IP, particularly those relevant for industry and business. Mr. Sabharwal also responded to the queries and observations of the Chairman and the members, including on India's IP administration and the necessity for further reforms in the area, recent performance of the various segments of IPRs including patents, copyright and related rights, trademarks, Industrial designs and GIs, the crucial role that industry, particularly MSMEs and start-ups, have in strengthening the country's IP regime, among others. The discussion also provided an opportunity to explain and elaborate upon the policy level suggestions contained in the note that FICCI had submitted prior to the interaction, as requested by Rajya Sabha Secretariat, presenting an overview of the Indian IP scenario, along with several policy level suggestions. Some of FICCI's propositions included undertaking a review of the IPR Policy and the need to keep IP laws under a dynamic review, carrying out a baseline survey of the important sectors of the industry, establishing a high level coordination mechanism for better enforcement, reviewing the decision to abolish IPAB (or instituting a suitable alternative mechanism), encouraging commercialization of IP, setting up an Institute of Excellence for IPRs, among others, which by and large were appreciated by the Committee.

FICCI was the only industry association invited Rajya Sabha Secretariat to share its viewpoints on India's the IP rights regime at the meeting of the Standing Parliamentary Committee on Commerce, on 7 April 2021.

## Meeting on 'Tackling IPR Challenges of Covid-19 and Necessary Government Initiatives'

**F**ICCI organised an interaction of its members on 10 May 2021 to discuss the steps required in the sphere of intellectual property rights to meet the extraordinary Covid-19 crisis that is confronting the country. The objective was to invite suggestions from FICCI members and associates on the immediate steps required in the IPR sphere to tackle the ongoing crisis; and forward the recommendations to the government for

its consideration. Mr. Narendra Sabharwal, Chair, FICCI IPR Committee, chaired the meeting.

### Key Observations during the meeting

- The focus ought to be on areas that need immediate as well as short-medium term solutions to tackle the crisis. Industry should also take steps on its own to meet some of the country's urgent needs not only in healthcare and medical sectors, but also in other segments of the economy. R&D activities, development of vaccines, drugs, equipment and healthcare infrastructure will obviously take precedence.
- With India's need for affordable and accessible healthcare becoming more crucial, all cooperative and collaborative approaches globally (and within the country) should be explored, especially in the backdrop of the growing support for India in the ongoing WTO discussions on the grant of temporary IP waiver.
- An evaluation of whether India's IP laws are coming in the way of finding solutions to the pandemic, in terms of transparency, facilitation, execution, ease of doing business etc. should be undertaken, and discussed for a balanced national and global viewpoint on the issues.
- The significant role of collaborative efforts in patents and other areas of IP at the international, multilateral, and bilateral levels will become even more important in the days to come. The emphasis on how IP can be shared in bringing out new technologies/solutions to address the pandemic problem will also become relevant. All such collaboration avenues e.g., putting patents, trade secrets, technologies, copyrights etc. in the public domain; licensing including patent pooling; joint ventures; creating new manufacturing facilities and ramping up production capacities; strengthening supply and distribution chains; and infrastructure development, should be explored and tried.
- India has been spearheading the IPR waiver discussions in the WTO through its diplomatic channels. The joint proposal for the IPR waivers, including a waiver from the implementation of certain articles on Patents, Copyright, etc. for a limited period to minimise barriers to manufacture/distribution of vaccines, medicines and equipment at affordable prices in India and other countries for domestic consumption and export, has gained support across several member countries of WTO. India and other sponsoring countries should now ensure that the expected WTO text-based negotiations on the proposal result in a consensus in WTO and a positive outcome.

- The waiving off of patents and other IP rights may not lead to an immediate increase in production/availability of vaccines. Unlike the generic drugs, which are chemicals and replicable more easily, vaccine manufacturing is a complex method and scaling up capacities involves the transfer of critical technical know-how, raw materials availability and the required infrastructure. It is also a long-drawn process, which may not be a solution to India's immediate needs.
- The option of using Compulsory License (CL) for the manufacture of vaccines or patented drugs should be carefully considered as there are other viable options available under the Patents Act. The Govt. may instead consider using provisions available under Sections 47, 48 and 100 to overcome the patent barriers. Going through this route will also be business-friendly and more acceptable to the global IP owners/developers. Nevertheless, if the option of CL is applied, it will be necessary to create a pragmatic model of appropriate compensation for innovators to ensure that the process of innovation continues to thrive.
- The manufacture of vaccines entails not only technology transfer but also making available the knowhow, essential infrastructure, raw materials and required manpower, which India does not presently have. In this backdrop, a practical option may be to facilitate the voluntary licensing of existing vaccines, like AstraZeneca, Covaxin, to select Indian companies to meet the country's growing requirements. For this purpose, existing drug manufacturers, both in public and private sectors, which have the required capacities and quality control measures in place, or where these can be ramped up quickly, should be identified for production of the existing vaccines. India will also have to be ready with the additional infrastructure and strengthen its distribution chain to make available the related essentials like injection devices, needles and syringes, vials, medical bottles, etc. For this, the Govt. should be ready to provide adequate funding support to the manufacturers.
- A key need here will be to ensure a transparent regulatory process including data protection during trials and approval process. A well thought out pricing policy for vaccines and drugs would also be necessary.
- The growing levels of counterfeiting, piracy, spurious drugs and products and illicit trade should be tackled with forceful application of all available laws and administrative vigilance. Full cooperation of industry and other stakeholders should be available in this process.

In conclusion, it was agreed that while extending its full cooperation to the Govt's efforts, FICCI will continue to

emphasise that innovation and creativity stimulated by IP tools will continue to play in the pandemic situation.

## Webinar on Computer Related Inventions: Evolution of the CRI Panorama in India

Patent regimes across the world have had to cope with the challenges of processing patent applications related to Computer Related Inventions (CRIs) and associated technologies. CRIs are those that involve the use of computers, computer networks or other programmable apparatus, and include inventions that have one or more features which are realized wholly/partially by means of a computer programme or programmes. Patent offices throughout the world, confronted with the issue of patentability of CRIs, have developed guidelines for examination of patent applications from these areas of technology to achieve uniform examination practices.

On 16 June 2021, FICCI organised a webinar on "Computer Related Inventions: Evolution of the CRI Panorama in India". The objective was to take a close look at the interplay between CRIs and Patent rights, the increasing prevalence and significance CRIs in the modern-day business world, and the other related aspects.



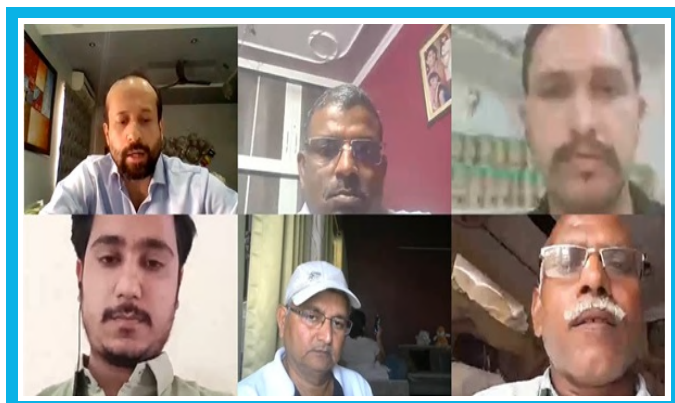
Ms. Gopi Trivedi, Senior Partner of Y. J. Trivedi & Co. was the principal speaker in the webinar. She made a detailed presentation on all the key components of patentability of Computer Related Inventions, including the processes to be adopted for appropriation of patent protection for CRIs, the policy guidelines of 2013 and 2017 for examining such inventions in India and the related conditions, the applicable sections in the Patents Act 1970, the excluded subject matters relating to CRIs, among other aspects. Elaborating extensively on the concepts like 'technical effect', 'technical advancement' etc., Ms. Trivedi also explained the different categories of CRIs as well as the various fields of technologies where such patents were possible, while apprising the participants on the trends in filing CRIs inventions in India and the country's



leading applicants in this field, along with case studies on important CRI patents that were either granted or rejected in India. The webinar was attended by around 100 participants consisting of industry representatives, law firms, advocates, IP professionals, researchers, academic institutions, law students, and other key stakeholders.

## Stakeholders Consultation Series on Promotion of Geographical Indications and Strengthening of India's GI Regime

**G**eographical Indications (GI), which are primarily agricultural, natural or manufactured product (handicrafts & industrial goods) originating from a certain geographical territory, are not only part of India's rich culture and collective intellectual heritage, but they can also supplement the incomes of the country's rural farmers, weavers, artisans and craftsmen across the country. The Govt. has taken several steps for promotion of Indian products registered as GIs through participation in trade fairs and other events to create awareness on these products, publicizing them through social media, involving State governments, UT administrations and other relevant organizations for facilitation of GI producers, among other initiatives. Although these steps have benefited the country's GI community, there is the need to for further assistance and support to empower the local craftsmen. These include putting in place a substantial national regulatory framework as well as providing free legal assistance to artisans to help them protect the age-old crafts, provide subsidy on purchase of raw materials to reduce the production cost and export subsidies so that they become competitive to access the global markets, build and strengthen producer organizations and institutional structures, among others.



FICCI, in partnership with Ernst & Young, has been organizing a series of stakeholder consultations on the promotion of GIs. This activity is a part of a Govt. of India project to prepare a report on 'Centrally-sponsored schemes required for promotion of Indian GIs', in which FICCI has partnered with EY. The objective is to conduct focused discussions among select experts and individuals working in the area to understand the current

issues and ground realities in the GI sphere, invite suggestions on removing existing gaps, and to work out a national strategy to achieve the desired socio-economic benefits of GI promotion and commercialisation.

Three such interactions were organised on 12th April, 15th April and 5th May 2021. During the discussions, several important issues and challenges in India's GI ecosystem came to light that were hindering realization of the potential benefits for the recipients. These include the absence of effective legal, enforcement and monitoring provisions; the problems arising due to lack of adequate awareness on GI provisions among the stakeholders themselves, the concerned Govt. officials, as well as of the public at large; the urgent need for effective enforcement of the GI rights in domestic and export markets; inadequate marketing and promotion of the products due to resource constraints and lack of expertise; prevalence of rampant infringement of GI products with negligible action by the concerned authorities, among others.

The need of the hour clearly is for a concerted effort by all the stakeholders: the Govt. departments, the producers and artisans, and the GI clusters from across the country to work together in ensuring that the Indian GI Act is made more comprehensive; and the existing provisions are effectively enforced. This will be important to meet the interest of artisans, craftsmen and to prevent their misappropriation through the support of appropriate institutions and policies along with necessary legal protection.

## Intellectual Property Division established in the Delhi High Court

The Delhi High Court established the Intellectual Property Division (IPD) to deal with all matters related to Intellectual Property Rights (IPR). The IPD deals with original proceedings, Writ Petitions (Civil), CMM, RFA, FAO on Intellectual Property Rights disputes, except those required to be dealt with by the Division Bench. The press release reads, "Based on the recommendations of aforesaid Committee, Hon'ble the Chief Justice has been pleased to direct creation of Intellectual Property Division (IPD) in this court to deal with all matters related to Intellectual Property Rights. The IPD so created, besides dealing with original proceedings, would also deal with the Writ Petitions (Civil), CMM, RFA, FAO relating to Intellectual Property Rights disputes (except those which are required to be dealt with by the Division Bench). This has been done to avoid multiplicity of proceedings and to avoid possibility of conflicting decisions with respect to matters relating to the same trademarks, patents, design etc."

## India put on Priority Watch List for IP Protection and Enforcement

The office USTR in its "Special 301 Report" has said that the trading partners of US including India will be subject to intense bilateral engagement in the coming years in regard to protection and enforcement of IPR. It cited that India has been less progressive in recent years in its development of IP sphere.

**Source:**  
[https://ustr.gov/sites/default/files/files/reports/2021/2021%20Special%20301%20Report%20\(final\).pdf](https://ustr.gov/sites/default/files/files/reports/2021/2021%20Special%20301%20Report%20(final).pdf)

## Ericsson and Samsung end patent licensing dispute

Ericsson and Samsung have entered into a confidential agreement. With this agreement, the two companies have ended a patent licensing dispute that hit Ericsson's first-quarter revenue. This also ends complaints filed by both companies before the United States International Trade Commission (USITC) as well as the ongoing lawsuits in several countries.

The cross-license agreement covers sales of network infrastructure and handsets from January 1, 2021

**Source:**  
<https://telecom.economictimes.indiatimes.com/news/ericsson-ends-patent-licensing-dispute-with-samsung/82451789>

## Eli Lilly grants 3 Indian Pharmaceutical companies Licence for Covid-19 drug

Three Indian medicine companies – Cipla, Sun Pharmaceuticals, and Lupin – have been granted royalty-free, non-exclusive voluntary licences to manufacture and distribute Baricitinib, which is used to treat Covid-19.

**Source:**  
[https://www.business-standard.com/article/companies/eli-lilly-signs-licensing-pact-with-cipla-sun-lupin-for-covid-19-drug-121051100039\\_1.html](https://www.business-standard.com/article/companies/eli-lilly-signs-licensing-pact-with-cipla-sun-lupin-for-covid-19-drug-121051100039_1.html)

## College student granted copyright for eco-friendly face shield design

A SRM University, Andhra Pradesh's third year mechanical engineer was given copyright for its design application number 329364-001 of the eco-friendly face shield which is made from

bio-degradable substances. He filed the application last year on May 16 before Patent Office of Kolkata. It is affordable as well at a price of Rs. 15.

**Source:**  
<https://www.thehindu.com/news/national/andhra-pradesh/srm-student-gets-copyright-for-eco-friendly-face-shield-design/article34684465.ece>

## TRIPS Council will hold meeting on India's proposal on patent proposal on Covid-19 till July end

India and South Africa submitted proposal in October 2020 suggesting for the waiver of certain provisions of the TRIPS Agreement for WTO members. The first informal session will be on June 30, then on July 6, 14 and 20. They will discuss the scope and coverage of products whose waiver is proposed.

**Source:**  
<https://timesofindia.indiatimes.com/business/international-business/trips-council-of-wto-to-hold-series-of-meetings-till-july-end-on-patent-waiver-proposal/articleshow/83614203.cms>

## Sun Pharma acquired trademark rights and patent w.e.f May 28th, 2021 from AstraZeneca AB, Sweden

The drug company, Sun pharma, has acquired the right for Oxra, Oxramet and Oxraduo (diabetes drug) in India from AstraZeneca AB, Sweden. Further, it has acquired patent license to manufacture and commercialize dapagliflozin and dapagliflozin with metformin combination in India from AstraZeneca with effect from May 28th, 2021.

**Source:**  
<https://economictimes.indiatimes.com/industry/healthcare/biotech/pharmaceuticals/sun-pharma-acquires-rights-to-trademarks-of-three-diabetes-drug-brands-in-india-from-astrazeneca/articleshow/83033102.cms?from=mdr>

## The Tribunals Reforms (Rationalisation and Conditions of Service) Ordinance, 2021 abolishes the Intellectual Property Appellate Board (IPAB)

The ordinance, w.e.f April 4th, 2021, has abolished the IPAB. Under the Copyright Act, 1957 IPAB has been substituted by Commercial Courts, (means a Commercial Court constituted under section 3, or the Commercial Division of a High Court constituted under section 4, of the Commercial Courts Act, 2015) who would deal with appeals against the decision of the Registrar of Copyright. And under the Patent Act, 1970, The Trademarks Act, 1999, The Geographical Indications of Goods (Registration and Protection) Act, 1999 all appeals against the decisions of the Registrars along with the Controller of Patents would now be filed before the concerned High Courts.

The Ordinance has also abolished the Plant Varieties Protection Appellate Tribunal under the Protection of Plant Varieties and Farmers' Rights Act, 2001.

As on April 4, 2021, all appeals pending before the IPAB would be moved to the respective High Courts, while appeals filed under the Copyright Act, 1957 would be sent to the respective Commercial Courts.

**Source:**  
<https://egazette.nic.in/WriteReadData/2021/226364.pdf>



## Protecting Intellectual Property Rights in The Era of E-commerce



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#### Introduction

Technology has advanced to a point where it is rather easy to actually commit actual intellectual property rights' infringement to a greater extent than ever before. It had already been prevalent over the past few years, but the Covid-19 pandemic only brought more attention to the usage of e-commerce for everything, starting from groceries and daily essentials to medicines, clothes, and other household items. The entire aspect of intellectual property rights is often ignored in this area, however it is all of imminent importance and value in the overall protection of these businesses. The e-commerce market in India is ever-expanding, with websites like Amazon and Flipkart becoming the online version of supermarkets or malls; and we also have platforms like Grofers, Myntra, and Ferns N Petals attending to more specific consumer demands instead.

#### Concerns Regarding IP on E-commerce Websites

Websites are a major component of sales promotions, and the creation of user-friendly layouts is itself a competition amongst businesses. It is also a possibility that various components of a website may be owned by different people who designed it, individually. The e-commerce business may not have exclusive rights in that case. However, safeguarding any and every such interest must be a collective effort. The agreement as to ownership of such rights is usually reached upon by a contract between the creator of such content and the owner of the business.

The two primary aspects of any intellectual property are - owning such rights, if any, and non-violation of the rights of others. That is exactly the concern of any e-commerce website as well, and must be paid special attention because technology is so advanced these days that potentially sensitive data may also be unknowingly left unprotected and liable to be misused in terms of violation of intellectual property rights.

It is of utmost importance that the owner of what may potentially qualify as intellectual property not disclose it to the public before filing the requisite applications, and in fact, maintain that silence up until the rights are granted. Any move otherwise may act as a hindrance to achieving the criteria of most intellectual property having to 'not be in public domain.' For instance, in many countries, the disclosure of a trade secret immediately dissolves any legal protection whatsoever to such commercially valuable secrets.

To sum it all up, any content that a business owner places on their website must be verified by them on at least one of the following fronts -

- The content being exclusively their own
- If any content belongs to another individual they must obtain any and every requisite permission to use such content
- Such content or information is available for the general public to know or see
- Any use other than those stated above must be classified and qualify as 'fair use'

Additionally, it is required for an e-commerce website to ensure that if it is selling branded products or acting as a retailer in any case, they must ensure the authenticity of the brand and the supplier. In the absence of adequate steps taken by a retailer, they will be as much liable as a supplier in case fake goods are discovered being distributed and sent to the consumers.

#### The What and How of Enforcing Intellectual Property Rights

The simplest way to explain the protection of IP rights on a website - in this case, an e-commerce website - is to categorize a website's contents. Since IP laws have several heads like copyrights, patents, trademarks, designs, etc., it is certainly obvious that each of those laws would individually protect one or more of the components of a whole website.

- Any technical tool, including but not limited to the system that e-commerce is, or its search engine would be granted protection under the Patents Act, 1970, or the utility model.
- The Copyright Act, 1957 comes into the picture when the overall look of the website is considered. This would include any content - description of products via texts or videos, photographs of products, graphics, etc. - that is meant to be a visual for the consumer. Any sui generis database laws may also be applicable in these cases.

The two aforementioned laws also contribute to ensuring protection of rights related to the website's text-based HTML code and its parent software. The exact law applicable would depend upon the national laws of the territory in which the website is being accessed from or functioning.

- Any logos of or on the website, names of businesses and products, and domain names visible to a consumer and acting as the main identity of the e-business would mostly come within the ambit of protection via the Trademark Act, 1999 or the Designs Act, 2000.
- There is no specific law in India for trade secrets and their protection. Hence, confidential information related to the creation of exclusive aspects of a website that make it unique is usually secured under non-disclosure agreements.

## Case Studies

The National IPR Policy, regulating a lot of modern concerns with regards to protection of IPR in the country came up in 2016. Following it, courts around the country dealt with several cases filed on the basis of these new guidelines being violated. Trademark infringement was the most pertinent issue that came to light, as may be exhibited by the following cases -

- Flipkart Internet Private Limited v. www.flipkartwinners.com & Ors. Delhi [I.As.14229/2018 and 14232/2018]

E-commerce giant Flipkart has a trademark for its name and logo. It filed a suit in the Delhi High Court in 2018, seeking a permanent injunction against the proprietors of www.flipkartwinners.com. Flipkart contested that the usage of that URL was infringing upon the said domain-name trademark because it was deceptively similar and falsely lead the public to believing in the authenticity of the actually fake lucky draws that the URL led to. Since the information that was provided on the website itself was incomplete and mostly incorrect as well, there was no way for Flipkart to point out a single defendant in the suit.

Lack of a written statement, and the defendant's absence in court only meant that the decision was easily in favour of Flipkart, as a permanent restriction was imposed upon the defendants; the latter could no longer use the words 'Flipkart' in any context whatsoever - especially not in the ways which they were - leading up to the present case.

- MakemyTrip (India) Private Limited v. Pravasi Guide Private Limited & Ors. [I.A.No.200/2019]

The Delhi High Court entertained another case in 2019 from MakeMyTrip (MMT), the online travel agency. They claimed that 'Pravasi Guide', another company had been wrongfully using a deceptively similar domain name 'www.makemyprav aas.com' and it was also associated with travel arrangements to be made online. MMT claimed that since the year 2000, they had been creating a brand reputation for themselves and their business was greatly recognized. They certainly had registered trademarks for the logo and domain name, which Pravasi Guide was infringing upon.

The Delhi High Court ruled in favour of MMT and passed an ex-parte permanent injunction against Pravasi Guide and their usage of the said domain and/or logo because it was deceptively similar to MMT's well-known and registered trademark in that same area of work.

- In July 2019, the Delhi High Court dealt with the grey area of e-commerce platforms selling products of direct sellers. Suits had been instituted by companies like Amway, Oriflame, and Modicare claiming that there was unauthorized sale of their products on e-commerce giants like Amazon, Flipkart, Snapdeal and others. In recent times then, it had been a very recurring question before the Court as to whether these e-commerce platforms could be considered as pure intermediaries in cases like these. The interim injunction ruling in favour of seven such claimants was returned by the ruling of the Hon'ble Court.

To be more specific, the Court noted that the defendants that is, the e-commerce giants were not only liable for trademark infringement but also the 2016 Direct Selling Guidelines as well as tortious interference with the Claimants' contractual relationships with their direct sellers. These platforms were asked to adhere to the due diligence requirements under the IT Act so as to keep up with their access to safe-harbour protections.

The need of the hour is user education pertaining to filing patents and trademarks to protect the startup's intellectual property. Brands have to actively participate in discussions with IP law firms at every phase of development of the service or product, be it ideation, production, execution or growth phase. Despite all the challenges, the future, however, seems promising as more and more companies realize the importance of IPR and pitfalls of trademark violation.

## Conclusion

Unfortunately, most people assume that content available on the internet is free to be used further in any format whatsoever. The only way to protect one's rights in this context is to create awareness; in that e-commerce websites must clearly point out that intellectual property seen on there are exclusively for the use of the said business and may not be used further without license or assignment. In that way, infringement suits may be avoided.

Overall, registrations of all eligible intellectual property become extremely relevant in light of technological advancements. The 'Terms and Conditions' of accessing and viewing a website as it is must be made clearer to users and be informative, in that the user should be very clear about the limitation on usage of information available on the said website.

*The author was assisted by Stuti Aastha.*

**Disclaimer:** This article contains the views of the author alone.

## Endnotes

### Bare Acts

- The Indian Copyright Act, 1957
- The Patents Act, 1970
- The Trade Marks Act, 1999
- The Designs Act, 2000

### Online Resources

- WIPO-WASME Special Program on Practical IP Issues, (Jun 10, 2021, 06:00p.m.), [https://www.wipo.int/edocs/mdocs/sme/en/wipo\\_wasme\\_ipr\\_ge\\_03/wipo\\_wasme\\_ipr\\_ge\\_03\\_13-main1.pdf](https://www.wipo.int/edocs/mdocs/sme/en/wipo_wasme_ipr_ge_03/wipo_wasme_ipr_ge_03_13-main1.pdf)
- Intellectual Property and E-Commerce: How to Take Care of Your Business' Website, WIPO Magazine, (Jun 10, 2021, 03:43 p.m.), [http://www.wipo.int/export/sites/www/sme/en/documents/pdf/business\\_website.pdf](http://www.wipo.int/export/sites/www/sme/en/documents/pdf/business_website.pdf)

## Tribunals Reforms Ordinance – 2 Fast 2 Furious?



### Rohan Rohatgi

Member, FICCI IP FORUM and  
Partner, RSR Legal

On April 4, 2021, the Tribunals Reforms (Rationalization and Conditions of Service) Ordinance, 2021 was promulgated by the President of India. Vide the Ordinance, the Intellectual Property Appellate Board (“IPAB”) established under Section 83 of the Trade Marks Act, 1999 (“TMA”) stands dissolved. All the powers that the IPAB drew from the TMA, the Patents Act, 1970, the Geographical Indication of Goods (Registration and Protection) Act, 1999 and the Copyright Act, 1957 now stand transferred to the jurisdictional High Court or the Commercial Courts, as applicable.

While the Tribunals Reforms (Rationalization and Conditions of Service) Bill, 2021 had been introduced in the Lok Sabha on 13 February 2021, and was pending consideration and passing, the Ordinance was promulgated. The Ordinance seems to have been promulgated in haste, without giving proper consideration to various issues that would arise by the dissolution/abolition of the IPAB, and without consultation with the stakeholders.

Few of the issues that arise in relation to the TMA are as follows:

- Whether the provisions of the Commercial Courts Act, 2015 would be applicable to original rectification petitions being filed before the High Courts under Sections 47 / 57 of the TMA or appeals?
- In the absence of the framing and notification of the prescribed rules by the High Courts, what rules should the applicants follow in the interim in relation to proceedings under the TMA before the High Court?
- How to determine jurisdiction of the High Courts in rectification/cancellation petitions and appeals?

We deal with these issues below:

### 1. Applicability of Commercial Courts Act, 2015

As per Section 2 (1) (xvii) of the Commercial Courts Act, 2015 (“CCA”), commercial dispute means a dispute arising out of intellectual property rights relating to registered and unregistered trademarks. While the original rectification petitions as well as appeals relating to rectification applications and opposition proceedings arising from the orders of the Registrar of Trademarks can be said to be commercial disputes arising out of intellectual property rights relating to registered and unregistered trademarks under this sub-section, the specific requirement of Specified Value under Sections 7<sup>1</sup> and 16<sup>2</sup> of the CCA negates the applicability of the Act to such petitions and appeals.

In rectification petitions and appeals relating to rectification applications and opposition proceedings arising from the orders of the Registrar of Trade Marks, there is no question of a Specified Value since there is no monetary damages/compensation sought, unlike in a suit for infringement and passing-off of trade marks. It has been held by the Hon'ble High Court of Judicature at Bombay in *Bharat Bhogilal Patel vs. Leitz Tooling Systems India Pvt. Ltd.*<sup>3</sup> that “The amendments introduced to the CPC by the Commercial Courts Act are only applicable to Commercial Disputes of a Specified Value and not Commercial Disputes not of a Specified Value such as the present suit.”

Based on the above, it is apparent that the provisions of the CCA would not apply to the rectification petitions and appeals relating to rectification applications and opposition proceedings arising from the orders of the Registrar of Trade Marks. With respect to the appeals from the orders of the Registrar of Trade Marks in relation to applications, these should lie to the Appellate Division of the jurisdictional High Court.

### 2. The Applicable High Court Rules

The Ordinance has amended Chapter XI, which has been substituted to read as APPEALS. Under Section 91 and Section 97 of the TMA, among other sections amended in the Act, the appeal or an application under Section 57 shall be in the prescribed form.

As per the newly inserted Section 2(1)(s), which defines the meaning of the word “prescribed” which in relation to proceedings before a High Court means prescribed by the rules made by the High Court.

With the dissolution of the IPAB and in the absence of the High Court Rules, a pertinent question that arises is what rules should the applicant or the appellant follow till the time the prescribed rules are framed by the High Courts?

The amendment to the TMA has turned the clock back to the pre-2003 era wherein the IPAB did not exist, and all the powers vested with the High Court. Section 110 of the then applicable Trade and Merchandise Marks Act, 1958 (“TMMA”) stated that the High Court may make rules consistent with the Act as to the conduct and procedure of all proceedings under the Act. Most of the High Courts framed rules under Section 110 of the TMMA to regulate the proceedings under the Act.

The issue that arises here is that with the repeal of the TMMA, will the rules framed under Section 110 of the TMMA by the High Courts still be applicable today? To answer this, a closer look is required at Section 159 (2) of the TMA relating to repeals and savings, which states as follows:

*Without prejudice to the provisions contained in the General Clauses Act, 1897 (10 of 1987), with respect to repeals, any notification, rule, order, requirement, registration, certificate, notice, decision, determination, direction, approval, authorisation, consent, application, request or thing made,*



*issued, given or done under the Trade and Merchandise Marks Act, 1958 (43 of 1958) shall, if in force at the commencement of this Act, continue to be in force and have effect as if made, issued, given or done under the corresponding provisions of this Act.*

At the commencement of the TMA, the High Court Rules framed under Section 110 of the TMMA were in force. While there were no corresponding provisions equivalent to Section 110 till the promulgation of the Ordinance, however, various provisions of the Act now require the High Courts to frame prescribed rules in relation to rectifications and appeals. Therefore, it could be interpreted to mean that till the time prescribed rules are framed by the High Courts, the existing rules framed under Section 110 of the TMMA would continue to be applicable.

### 3. Jurisdiction

Under the TMMA, Section 3<sup>4</sup> clearly spelt out as to which High Court would have jurisdiction to hear appeals as well as rectification petitions. Additionally, Sections 108 and 109 laid down the procedure for application for rectification before a High Court and Appeals.

However, the present Ordinance has failed to provide any such clarification. In such circumstances, the appeals and rectification petitions should be guided by the principles of Section 20 of the Code of Civil Procedure, 1908.

While appeals would lie to the High Court within the limits of whose appellate jurisdiction, the office of the Trade Marks Registry is situated. For example, appeals from the Delhi Trade Marks Registry would lie to the Delhi High Court.

With respect to the original rectification petitions, the jurisdiction would have to be on the ground of where the defendant carries on business or cause of action arose. Accordingly, the jurisdiction would lie with at least two High Courts, one where the Defendant's address as available on the Register of Trade Marks is situated or to the High Court within whose jurisdiction the Trade Marks Registry is located (which would mean that part cause of action has arisen there).

**Disclaimer:** This article contains the views of the author alone.

## COVID and India's Proposal for Waiver of WTO Trips Provisions



### Prashanth Shivadass

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#### Introduction

In the wake of the COVID 19 pandemic, there has been a dire need for medicines, vaccines and other technologies that can be used to control the spread. In order to meet growing demands, various pharmaceutical companies have entered into a race for manufacture of vaccines. These vaccines can be patented and monopolized by them to recoup investments made towards research and development of these vaccines. Given the mild collapse of the infrastructure, there has been an increasing concern about the costs associated with these vaccines, bringing to the fore the age-old tension between the rights of an intellectual property holders and public health and welfare.

There are several reports about IP rights hindering or potentially hindering the timely provision of affordable medical products to the patients.<sup>5</sup> To overcome this hinderance, several WTO members/signatories, have brought amendments to their domestic patent laws to fasten the process of issuing compulsory licenses to vaccine manufacturer. However, many developing countries may face institutional and legal barriers while using flexibilities available under the Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement) as the process of import and export of pharmaceutical products is a lengthy and cumbersome process.

Many countries have spoken out for sharing the technology and know-how and to expediate the process of manufacture of medicines and vaccines and for deployment of such vaccines to contain the virus. Countries like India and South Africa supported by other developing countries have proposed to waive the implementation, application and enforcement of Sections 1, 4, 5, and 7 of Part II of the TRIPS Agreement or to enforce these Sections under Part III of the TRIPS Agreement.

This article addresses two legs i.e., the need for the waiver and potential barriers to implement such waiver.

#### Is there a Need for Waiver?

The TRIPS Agreement was structured to address minimum standards for regulating different forms of Intellectual Property for all member states despite their individual and respective domestic laws. The Doha declaration on the TRIPS Agreement and Public Health, clarified the scope of the TRIPS Agreement with respect to promoting access to medicines for all. Paragraph 6 of the Doha declaration specifically addressed the issue on how WTO Members could make use of 'compulsory licensing' when they lack spread or there is insufficiency in the manufacture of pharmaceuticals. Many Least Developed Countries (LDC) and some developing countries are unable to produce active ingredients or formulations due to the lack of technology, skills or human resources. Introduction of Paragraph 6, in this regard, eased this difficulty faced by many member states.

The TRIPS Agreement adequately deals with the issue of 'access to essential medicines during public health crisis' under Articles 7, 8 and 31. The current virus is a classic example of how these provisions can be put to adequate use. Article 7 not only

encourages promotion of technologies but also provides for transfer of technical knowledge which is helpful in socio-economic welfare of the members. Further, Article 31(b) of the TRIPS Agreement articulates the requirements for obtaining compulsory license by permitting a member to use a patent without authorization of the right holder in cases of national emergency or in circumstances of extreme urgency. The relevant portion of Article 31(b) is extracted hereunder:

*“such use may only be permitted if, prior to such use, the proposed user has made efforts to obtain authorization from the right holder on reasonable commercial terms and conditions and that such efforts have not been successful within a reasonable period of time. This requirement may be waived by a Member in the case of a national emergency or other circumstances of extreme urgency or in cases of public noncommercial use. In situations of national emergency or other circumstances of extreme urgency, the right holder shall, nevertheless, be notified as soon as reasonably practicable. In the case of public non-commercial use, where the government or contractor, without making a patent search, knows or has demonstrable grounds to know that a valid patent is or will be used by or for the government, the right holder shall be informed promptly...”<sup>6</sup>*

The flexibility to compulsorily license provided by the TRIPS Agreement, which has also been imported into the domestic laws of member countries, can be used to expediate the accessibility of medicines, vaccines and other related technology during the present crisis.

In addition to the above, the World Health Organization has launched 'WHO COVID-19 Technology Access Pool (C-TAP)' having partnered with the Costa Rican government, wherein 40 member states have co-opted to share knowledge, intellectual property and data necessary for the cure of Covid-19.<sup>7</sup> The intent is to scale-up the production of vaccine by sharing information, knowledge, technology and other resources.

Despite these steps, countries like India and South Africa, supported by many other developing countries and LCDs, have additionally proposed a waiver of Section 1 on copyright and related rights, Section 4 on Industrial designs, Section 5 on Patents, and Section 7 on the protection of undisclosed information under Part II of the TRIPS Agreement or to enforce the same under Part III of the TRIPS Agreement in light of Covid related innovations instead of issuing compulsory licenses.

The common aim of these member states through the above proposal is to secure access to high quality, safe, efficacious, and affordable vaccines and medicines to all. It is argued by the proponents that the vaccine manufacturing facilities of these countries remain unutilized because of the IP barriers which could not be addressed by the existing TRIPS flexibilities, resulting in insufficient vaccines.

Recently, USA announced its limited support for the “TRIPS Waiver” which was earlier proposed by India and South Africa. This waiver involves a temporary suspension of certain parts of the TRIPS Agreement in order to produce and use all the technologies used for the treatment of Covid-19 without the fear of infringement of IP rights. It was however suggested that this measure be bound by time.

## Potential Barriers

Lawrence Gostin, director of the O'Neill Institute for National and Global Health Law at Georgetown Law, stated that though there is a necessity for waivers, it will take months before the proposal is actually effected. In the interim, manufacturers will not have the right to produce vaccines, making such delayed waivers, infructuous. Other barriers include poor health care systems and infrastructure, lack of other affordable medicines. Further, contrary flexibilities available under the TRIPS Agreement like compulsory licensing and parallel imports can prove to be a barrier as the intention behind both are the same. These flexibilities allow countries with low or no manufacturing capacity of medicines to import from the developed countries or to obtain permission to use a patent without authorization of the right holder in cases of national emergency or in circumstances of extreme urgency.

On the other hand, it can be argued that even if compulsory licensing is made available, it will still have many complexities at various levels. Rwanda is one such example wherein a generic medicine manufacture was unable to produce an equivalent generic medicine for Rwanda. The Canadian government had issued a compulsory license for domestic use of the medicine in Rwanda. However, given that the country lacks the manufacturing capacity, the compulsory license granted is of very limited use.

Other barriers include free trade agreements between countries like Mexico, Chile, Malaysia, Peru, Vietnam, etc. which were formed for a Trans-Pacific Partnership. These agreements prevent national drug regulatory authorities from registering and allowing sale of generic medicines that are under patent protection, otherwise also known as the patent-linkage system.

Further, many countries will need to amend their national laws in a very short period of time in order to avail the benefit of this proposal, which will pose as a bigger barrier.

## Conclusion

Covid-19 is clearly an emergency and a global crisis, with uncertainties and increasing death toll. A waiver of TRIPS obligation may not provide expeditious remedy to this crisis. However, this can act as a catalyst for rethinking the current IP policies adopted by the member states during such unprecedented public health emergencies.

*The author is the founder of Shivadass & Shivadass (Law Chambers). He was assisted by Ms. Rachna Pise, Associate. The contents and comments of this document do not necessarily reflect the views/position of FICCI or Shivadass and Shivadass (Law Chambers) but remain solely of the author(s).*

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**Disclaimer:** This article contains the views of the author alone.

<sup>1</sup>Jurisdiction of Commercial Divisions of High Courts: All suits and applications relating to commercial disputes of a Specified Value filed in a High Court having ordinary original civil jurisdiction shall be heard and disposed of by the Commercial Division of that High Court.

<sup>2</sup>Amendments to the Code of Civil Procedure, 1908 in its application to commercial disputes: (1) The provisions of the Code of Civil Procedure, 1908 (5 of 1908) shall, in their application to any suit in respect of a commercial dispute of a Specified Value, stand amended in the manner as specified in the Schedule.

<sup>3</sup>2020 (82) PTC 458 (Bom)

<sup>4</sup>High Court having jurisdiction.

<sup>5</sup> See e.g. <https://www.bloomberglaw.com/news/articles/2020-03-20/world-war-ii-style-production-maycarry-legal-risks-for-patriots>; <https://eu.courier-journal.com/story/news/2020/04/03/beshear-calls-3-mrelease-patent-n-95-respirator-amid-pandemic/5112729002/>

<sup>6</sup> See TRIPS Agreement, Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299; 33 I.L.M. 1197 (1994), [http://www.wto.org/english/docs\\_e/legal\\_e/27-trips.pdf](http://www.wto.org/english/docs_e/legal_e/27-trips.pdf) [hereinafter TRIPS Agreement]; Samira Guennif & Julien Chaise, Present Stakes Around Patent Political Economy: Legal and Economic Lessons from the Pharmaceutical Patent Rights in India, 2 ASIAN J. WTO & INT'L HEALTH L. & POL'Y 65, 67 (2007).

<sup>7</sup> <https://www.who.int/initiatives/covid-19-technology-access-pool> (Last accessed on 10th May 2021)

## Stringent Measures against Fraudulent Websites of Tyrecompanies

In the increasingly digitalised economy, the domain names not only serve as an on-line trademark, but also signifies product quality and the goodwill of an organization. However, cybersquatting and hijacking of internet domain names are becoming a growing concern for various industry sectors.

The Automobile Tyre Industry is one such sector that has been increasingly facing the menace of cybersquatting, particularly so in the wake of the second wave of the Covid-19 crisis. In view of the pandemic situation and the resultant thrust on the online/e-commerce, several fraudulent websites have appeared that take advances through online transfer to remote/unknown accounts, and trick prospective trade representatives into taking up dealerships of tyre companies by making advance deposits that are managed by fraudsters.

With the Indian tyre industry already confronted with multiple pandemic-related challenges, the rising instance of fraudulent websites is further impacting the operations of this sector due to the negative publicity/image that such unlawful operations tend to garner. Although companies are adopting remedies against such cybersquatting activities e.g., action under Domain Name Resolution policies, filing civil suits and criminal complaints, none of these remedies address and resolve the industry concerns in entirety.

FICCI had represented to the Govt. that this serious issue faced by the Indian tyre manufacturers should be taken up with the concerned authorities, including the National Internet Exchange of India (NIXI). It was suggested that necessary amendments should be brought in the ".in Domain Name Dispute Resolution Policy (INDRP) Rules" and in the policy for .IN Internet Domain Name Registration for the benefit of the industry at large.

The following specific suggestions were proposed:

- NIXI may take a minimum set of KYC documents from the registrant of website,
- As in the case of Custom's recordal, provision for registration of a brand name/trademark with NIXI may be started. Accordingly, NIXI should intimate such trademark/brand name owners as and when any website is registered with the same or similar brand name/trademark.

FICCI also submitted a list of fake website IDs to the Government that were operating in the name of some leading tyre companies.

**An Update:** CIPAM has meanwhile confirmed that all the identical fake websites have been taken down by NIXI.



## Become a Member !



### BACKGROUND

- FICCI Launched its unique initiative - FICCI IPFORUM in May 2020 to provide an interface for businesses to resolve their issues pertaining to intellectual property rights and also develop a pool of IP professionals whose knowledge and expertise will benefit the industry at large.

### OBJECTIVE

- To create a consortium of legal professionals who are keen to support IP and encourage innovation, brand protection and creativity among various stakeholders.
- To strengthen the IP ecosystem in India and play an important and more comprehensive role in addressing existing and evolving issues in the area of IP in India.

### BENEFITS

- Engagement in IP Policy Advocacy
- Networking through various FICCI national & international seminar/conferences
- Speaking/ participating opportunities in various FICCI Webinars:
- Enhanced Visibility for forum members
- FICCI IP Talks
- Several other Benefits

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## **Phonepe Private Limited vs Ezy Services & Anr. April 15<sup>th</sup> 2021**

The Delhi High Court has dismissed an interim injunction to Plaintiff 'PhonePe' against the Defendant's 'BharatPe', in a trademark infringement. The High Court rejected PhonePe's plea on the ground that a claim of infringement can only be brought with respect to the whole trademark and not merely a part thereof. A composite trademark, cannot be divided, its exclusivity is only with respect to the entire mark as a whole not its parts. And merely misspelling 'Pay' as 'Pe' does not grant the Plaintiff exclusivity over the suffix/word.

## **M/s Replika Press Private Limited vs Mr. Sanjay Kumar, April 16<sup>th</sup>, 2021**

The Delhi High Court held that the plaintiff had a prima facie case in its favour and awarded an ex-parte ad interim injunction. The defendant is restrained from interfering with the plaintiff's use of MIS software, which the defendant had devised and developed while working for the plaintiff, in any manner.

## **Google v. Oracle April. 18<sup>th</sup>, 2021**

The Supreme Court of United States overturned the Federal Circuit Appeals Court ruling, six to two in favour of Google. The court held Google's copying of the Java SE API, which included only those lines of code that were needed to allow programmers to put their accrued talents to work in a new and transformative program, was a fair-use of that material as a matter of law. Justice Stephen Breyer, stated that "to allow enforcement of Oracle's copyright here would risk harm to the public", it will create a lock, limiting future creation of new programs. Dissenting Justice Clarence Thomas wrote that allowing fair use simply because it allows new products to be created effectively redefines the idea and "That new definition eviscerates copyright.". Judgement had no final finding on copyrightability and is limited only to the 'fair use' doctrine.

## **Mankind Pharma Limited vs Novakind Bio Sciences Private, 20<sup>th</sup> April, 2021**

The court in its order held that the defendant's use of the suffix "KIND" for its pharmaceutical product, therefore, prima facie, infringes on the plaintiffs' registered trademark and has the harmful prospect of misleading or deceiving the public into believing the defendants' products are the plaintiffs'. Under the Section 17(2) (b) and Section 32 of the Trademarks Act, 1999, the plaintiff's products, it had attained distinctiveness by use of the said suffix. Thus, the defendant is restrained from further manufacturing, either on its own behalf or through any job worker, marketing or clearing, for sale in the market, any pharmaceutical product, bearing the "KIND" suffix or which may in any other way infringe the registered trademarks of the plaintiff.

## **Cutis Biotech V. Serum Institute Of India Pvt. Ltd., 20<sup>th</sup> April, 2021**

The applicant has to establish goodwill attached to the good, the respondent's acts are likely to deceive the public; and the applicant is likely to suffer damage or has suffered. These three principles are the Classical Trinity of passing off test. The court held that there is no likelihood of confusion as the consumers and trade channels are different. Also, Covishield as a vaccine to counter coronavirus has become widely known by respondent and a temporary injunction will cause confusion and disruption in the vaccine administration having large scale ramifications.

## **Prateek Chandragupt Goyal V. State Of Maharashtra And Ors, April 20<sup>th</sup>, 2021**

The court held that the Plaintiff has not violated Sec 103 of the Trademarks Act, 1999 for using the Trademark of Sakal Times in his stories and constituted nominative fair use of Sakal Media Group's trade mark under Section 30(1)(a) and (b) of the Act. They quashed the FIR against the Plaintiff and further said the articles might be subject matter of an injunction suit at the behest of Sakal Media Group due to the contents of the said articles.

## **Tata Sons Private Limited vs Dinesh Kumar, April 28<sup>th</sup>, 2021**

The Delhi High Court held that usage of the mark TATA by the defendant prima facie amounts to infringing the mark of the plaintiff, and granted an ex-parte injunction restraining defendants from manufacturing, selling, offering for sale, supplying, advertising, directly or indirectly dealing in any business unauthorisedly using the plaintiff's well-known trademark TATA and permutation / combinations thereof or using any other mark which is deceptively similar to the plaintiff's mark TATA.

## **The Goodyear Tire and Rubber Company v. Deva Nand Sukhia, May 3<sup>rd</sup>, 2021**

The court held that the plaintiff had made prima facie case that the trademark of the defendant is identical to that of the plaintiff. Further, it has established that GOODYEAR is a well-known trademark.

## **Interdigital Technology Corporation V. Xiaomi Corporation, May 3<sup>rd</sup>, 2021**

The court looked at the issue of anti-injunction. Anti-enforcement injunctions are of two types where the enforcement is to be enjoined or where the injunction is sought of an anti-suit injunction order by a foreign court. The last category is under which the present case falls. There is presently no precedent on such matter and referring anti-enforcement injunctions as anti-anti-suit injunction is a misnomer. The important element in anti-suit injunction is oppressive or vexatious proceedings. The court, thus, looked at whether the plaintiff can seek restraint against enforcement of the Wuhan court and for enjoining defendant from prosecuting anti-suit application.

## **M/S Kamdhenu Limited V. M/S Aashiana Rolling Mills Ltd., 12<sup>th</sup> May, 2021**

The court while deciding first looks at the test of 'real prospect of success'. The court rejected the contention that the international publication and published standards will not constitute prior publication of design. The standards cited by defendant are a detailed list of elements of the design. It would have been a different case where the standard was not an element of design or some other feature.

## **M/s J.K. Cement Limited v. Union of India, 17<sup>th</sup> May, 2021**

The court has passed interim injunction in favour of the trademark of the cement company of the plaintiff. The court noted that the notification of the Bureau of Indian Standards is in fact restricting the petitioner's right in relation to its trademark as according to it, which would lead to cancellation.

## **Red Bull Ag V. Bakewell Biscuits Private Limited, May 18<sup>th</sup>, 2021**

The court has held that Plaintiff has succeeded in making a prima facie case in its favour against the defendant for infringement of its well-known trademark of Red Bull.

The plaintiff was granted an ex parte injunction prohibiting the defendant from using the Red Horse Label.

## **Bajaj Finance Ltd. v. Registrant of WWW.BAJAJ-FIN-SERVE.OR, May 18<sup>th</sup>, 2021**

The court held that domain names deceptively similar or identical to "BAJAJ Finance" or "BAJAJ Finserv" and are infringing the rights of the plaintiff while passing an order against Defendant restraining them from using the trademarks 'BAJAJ FINANCE' and 'BAJAJFINSERV' or any other trade mark / name deceptively similar to the same and directed the defendants who were domain registrars to take down domain names.

## **Fmc Corporation V. Best Crop Science Llp, 19<sup>th</sup> May, 2021**

The court pointed out that once the allegedly infringing products will be in the market, there cannot be stay against it and if there is, the exercise would be illusory in nature. Even if there is a single day's infringement that is principally considered incalculable. Thus, the defendant cannot be permitted to release their infringing products in the market at this stage when the rejoinder is still pending in the proceeding on the same matter happening.

## **Bennett Coleman v. WhatsApp Inc And Ors, May 21<sup>st</sup>, 2021**

The court held that the Plaintiff has made out a prima facie case and granted an interim injunction in favour of the plaintiffs and against the defendant against the unauthorized transmission and dissemination of the plaintiff's Times of India e-newspapers by the defendant on platforms such as WhatsApp and Telegram. The plaintiff being exclusive owner of the copyright in the said literary work therefore possesses all rights to it in any material forms. Defendants are illegally circulating copies of e-newspaper owned by the plaintiff which violate the rights of the plaintiff.

## **Sun Pharmaceutical Industries v. M/s Wings Biotech, May 24<sup>th</sup>, 2021**

The plaintiff has registered the trademark REVITAL while the defendant has come up with ONEVITAL. These are medicinal products. The trade mark, trade dress, packaging of the defendant is similar to that of the plaintiff and are restrained through ex-parte injunction since a prima facie case is made out.

## **Raaj Unocal Lubricants Limited V. Apple Energy Private Limited, May 25<sup>th</sup>, 2021**

There can only be two situations where the Indian citizen can get benefit when jurisdiction exceeds to a sovereign territory, these are Section 13 of CPC and in grant of anti-suit injunction. The Supreme Court has said that though anti-suit injunctions are the specie of injunction but they had to be granted sparingly because they interfere with the exercise of the jurisdiction of another court. Thus, the important thing is that the case is to be made that the proceedings are oppressive or vexatious to the plaintiff in the other court. Only then, can injunction be claimed and restrain defendant.

## **Black Diamond Track Parts Private Ltd. v. Black Diamond Motors Private Ltd., 28<sup>th</sup> May, 2021**

The court said that the respondent should not indulge in forum shopping as there already is huge pendency and arrears. The case is of the separation of family leading to separation of business with different names with using the same trademark that sowed the said seeds. It is not appropriate to restrict one party as it will lead to irreparable loss and since there is possibility of confusion being eliminated.

## **Khadi & Village Industries Commission v. Khadi Design Council of India, 28<sup>th</sup> May, 2021**

The High Court granted an ex parte interim injunction restraining the defendants, their partners, servants, representatives, agents and all others acting for and on their behalf are restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly providing any kind of goods and/or services under the trademark 'KHADI', either as a word or as part of its tradename or logo, and/or any mark identical or deceptively similar to the Plaintiff's registered KHADI trademarks and Charkha logos, that may amount to infringement and/or passing off of the Plaintiff's registered trademarks.

## **Reddys Laboratories Limited v. West-Coast Pharmaceutical Works Ltd., 28<sup>th</sup> May, 2021**

The Delhi High Court held that defendant must be allowed to file a response in this case before the application for ad interim relief is taken up. The plaintiff had attempted to restraint the defendant's use of the 'OMES' mark in light of the plaintiff's 'OMEZ' mark.

## **Merck Sharp And Dohme Corp & Anr vs Yms Laboratories Private Limited, May 31<sup>st</sup>, 2021**

The Delhi High Court held that the plaintiffs have made out a prima facie case on merits and thus granted an ex parte ad interim injunction as, if not granted in favour of the plaintiffs, it will cause irreparable harm and injury to the plaintiffs. The defendants, their directors, employees, officers, servants, agents are restrained from manufacturing, using, selling, distributing, advertising, exporting, offering for sale and in any other manner, directly or indirectly, dealing in any product that infringes the subject matter of the plaintiff's Indian Patent No. 209816 including SITAGLIPTIN or any other pharmaceutically acceptable salts.





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