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COMPREHENSIVE ANALYSIS OF RECENT AMENDMENTS TO INDIAN PATENT RULES, 2024

Introduction

The Draft Patent (Amendments) Rules, 2023, circulated for discussions and consultations, have now been officially notified on March 15, 2024, marking a significant milestone in the Indian patent landscape. Alongside the granting of 100,000 patents in the current fiscal year by the Indian Patent Office (IPO), these amendments address major concerns raised by patent filers. This article delves into a detailed analysis of the Patent (Amendments) Rules, 2024, examining key changes and their implications for stakeholders. From timelines to procedural requirements, these amendments aim to streamline processes, enhance transparency, and strengthen the Indian patent system.

Key Changes Introduced By The Patent (amendments) Rules, 2024:

1 Request for Examination (RFE)

Timeline Adjustment: The amendment reduces the due date for filing an RFE from 48 months to 31 months from the earliest priority date, effective March 15, 2024. For applications filed before March 15, 2024, the 48-month timeline remains applicable. This adjustment aims to expedite the examination

process, encouraging timely filings and reducing delays in patent grant.

2. Streamlined Submission of Form 3 for Corresponding Foreign Applications:

The revised rules simplify the requirement to submit Form 3 detailing corresponding foreign applications. Applicants now need to file Form 3 twice: initially with the Indian application or within six months, and subsequently within three months of the issuance of the First Examination Report (FER). Controllers are mandated to utilize accessible databases for reviewing information [as required under section 8(1)] on corresponding foreign applications. While the need for further updates remains unclear, missing the deadline for Filing FORM-3 attracts an extension period of up to 3 months with an extension fee.

3. FORM-27: Working Statement Requirements Modification:

Patentees are now mandated to file working statements once every three financial years, excluding the year of patent grant. The filing period for these statements has been clarified, reducing ambiguity and procedural hurdles. Furthermore, the format of Form 27, used for filing working statements, has been revised to eliminate the requirement for providing value or sales data accrued in India. These changes aim to reduce administrative burden on patentees and align reporting obligations with industry practices.

4. Facilitation of Divisional Applications:

The amendments allow applicants to voluntarily file divisional applications, allowing applicants to claim subject matter disclosed in earlier filings. This provision offers greater flexibility to applicants and streamlines the process of protecting related inventions through divisional applications. It clarifies that divisional applications can be filed even in cases where the original application was accompanied by a provisional specification or another divisional application.

5. Grace Period Provisions:

A significant addition to the amended rules is the introduction of grace period provisions under Rule 29A. This provision allows applicants to claim a grace period specified in Section 31, pertaining to anticipation of invention by public display, etc. To avail of the grace period, applicants are required to furnish appropriate documentation in accordance with Form 31, providing relief to applicants facing certain disclosure challenges.

6. Pre and Post-Grant Opposition Procedures Enhancement:

The amendments introduce provisions to enhance pre and post-grant opposition procedures. Under amended Rule 55A(3), if the Controller determines that no prima facie case is established in the representation submitted with the pre-grant opposition and notifies the Opponent accordingly, without a hearing request from the Opponent, the Controller must issue an order refusing the representation within one month from the notification date to the Opponent. However, if the Opponent requests a hearing upon notification, the Controller is obligated to conduct the hearing and subsequently issue an order either rejecting or prima facie accepting the representation within one month of the hearing, notifying the Applicant accordingly.

In cases where the Controller is convinced, from the outset, that a prima facie case exists in the representation, the Controller must communicate this to the Applicant within one month of receiving the representation, along

with the reasons for such prima facie acceptance.

The amended Rules also shorten the timeframe for the Applicant to file their statement and evidence supporting the application to two months from the date of notice. This is a reduction from the earlier three-month period stipulated in the previous Rules.

Furthermore, under the amended Rules, if a pre-grant opposition is filed for an application and notice is issued pursuant to amended Rule 55(3), the application will be subjected to examination under the expedited examination provision outlined in Rule 24C. This provision aims to accelerate the examination process for applications facing opposition, ensuring timely resolution of disputes.

Additionally, the procedural aspects outlined in sub-rules (2) to (4) of Rule 62 are applicable to the hearing procedure under Rule 55A, further streamlining the process and ensuring consistency in the application of rules.

These amendments reflect a concerted effort to enhance the efficiency and effectiveness of pre-grant opposition procedures, balancing the interests of both patent applicants and opponents while promoting fairness and transparency in the patent system.

7. Certificate of Inventorship Provision:

A new provision under Rule 70A allows inventors to request a certificate of inventorship in respect of a granted patent.



This provision acknowledges the contribution of inventors and allows them to establish their association with the patented invention.

8. Renewal Fee Concession and Fee Revisions:

The amendments introduce concessions and revisions in renewal fees, aiming to incentivize timely renewal of patents and promote electronic transactions. Patent holders can now avail a 10% reduction in renewal fees if paid in advance through electronic mode for a period of at least four years. Additionally, revised fees have been introduced for certain requests/applications to align fee structures with administrative costs.

It is important to note that 10% rebate is not available for back renewals (accumulated renewals) to be paid when a patent is granted. It is clarified that this concession is available only for renewals paid in advance.

9. Synergy with Design Act:

The syllabus for the Patent Agent exam has been amended to include the Design Act, 2000, and Design Rules, 2001. This amendment reflects the interconnectedness of patent and design laws and enhances the knowledge base of future patent agents.

10. Condonation of delay under amended Rule 138:

Notwithstanding anything contained in the rules, the time specified for doing any act or taking any proceeding thereunder may be extended or any delay may be condoned by the Controller for a period of up to six

months, upon a request. This extension can be granted for a period of up to six months upon request, provided that the request is submitted before the expiration of the initial six-month period. Importantly, such requests for extension can be made repeatedly within the designated six-month period.

11. Exceptions to the applicability of Rule 137:

Amended Rule 137(2) delineates specific scenarios where the provisions of the earlier Rule 137, now Rule 137(1), shall not be applicable. This provision offers clarity on instances where certain actions or amendments cannot be undertaken under the general provisions outlined in Rule 137(1). However, the said Rule shall not apply in the following cases:

- a) Extension of Time or Condonation of Delay under Rule 12(5) for filing Form 3:
- b) Rule 12(5) pertains to the extension of time or condonation of delay concerning the filing of Form 3. This exception restricts the application of Rule 137(1) in such cases.
- c) Clause (i) of Rule 20(4) and Rule 20(6): This exception relates to specific scenarios under Rule 20, which involves the filing of a national phase application beyond 31 months from the date of priority and the filing of an English translation of an international application beyond the prescribed time.
- d) Rule 21: Rule 21 pertains to the filing of a priority document and an English translation of the priority document beyond the prescribed time.

- e) Sub-Rules (1), (5), and (6) of Rule 24B: Rule 24B deals with the filing of a request for examination, response to the first examination report, and extensions related thereto beyond the prescribed time. This exception specifies scenarios where Rule 137(1) does not apply.
 - f) Sub-Rules (10) and (11) of Rule 24C: Rule 24C addresses the filing of responses to the first examination report and extensions related thereto beyond the prescribed time. This exception outlines instances where the general provisions of Rule 137(1) are not applicable.
 - g) Sub-Rule (4) of Rule 55: Rule 55 concerns the filing of a reply statement along with evidence to a pre-grant opposition beyond the prescribed time. Under this exception, Rule 137(1) does not apply in such circumstances.
 - h) Sub-Rule (1A) of Rule 80: Rule 80(1A) relates to the payment of renewal fees beyond the extended period of six months. This exception specifies scenarios where the general provisions of Rule 137(1) are not applicable.
 - I) Sub-Rules (1) and (2) of Rule 130: Rule 130 addresses the filing of a review of the Controller's decision and the filing of an application for setting aside a decision of the Controller passed ex-parte in review proceedings beyond the prescribed time. This exception delineates specific scenarios where Rule 137(1) does not apply.
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CONCLUDING REMARKS:

The amendments to Indian Patent Rules, 2024, mark a significant step towards enhancing the efficiency, transparency, and accessibility of the Indian patent system. By addressing key concerns of stakeholders and introducing procedural enhancements, these

amendments aim to foster innovation, protect intellectual property rights, and bolster confidence in the Indian patent regime. Moving forward, stakeholders must adapt to these changes and leverage the evolving patent landscape to drive innovation and economic growth in India.

Snapshot of Amended Rules (2024) in comparison with old Rules:

The Patent (Amendments) Rules, 2024

S.No.	Rule No.	Rule Description	Old Rules	New Amended Rules
1.	12(1) & (2)	FORM-3 Requirements [Section 8(1)]	To be filed at the time of filing of Patent Application OR within 6 months from Application Filing Date and subsequent FORM-3 must be filed within 6 months from any foreign filing(s)	1. First FORM-3 at the of filing with details of all corresponding applications filed before the filing of the Indian application OR within 6 months from the date of filing of Application. 2. Second FORM-3 must be filed within 3 months from the date of First Examination Report (FER)
	12(3)	Prosecution History [Section 8(2)]	Search/Examination Report along with granted claims (if any), must be provided within 6 months from the date of First Examination Report (FER)	Controllers will utilize the public accessible and available databases for considering the information related to corresponding foreign application's search and examination report and/or granted claims. During Examination, the Controller may ask the Applicant to submit the fresh (updated) FORM-3 within 2 months. If any delay, it can be condoned up to 3 months on filing Request for Extension of time on FORM-4 with Fee.
2.	24B / 24C	Request for Examination	Must be filed within 48 months from the earliest priority date	Time limit is reduced to within 31 months from the earliest priority date
3.	13	Voluntary filing of Divisional Applications [Section 16]	No provision of filing of Divisional Patent Application Voluntarily	NEW SUB RULE 2A has been added into the Patent Rules, 2024 by which the Applicant may file one or more divisional applications including in respect of an invention disclosed in the previously filed provisional specification, complete specification or previously filed divisional application.

The Patent (Amendments) Rules, 2024

S.No.	Rule No.	Rule Description	Old Rules	New Amended Rules
4.	131	Filing of Working Statement [FORM-27]	Must be filed annually before the end of September month in respect of previous financial year	Patentee is required to file the FORM-27 once in 3 financial year. The deadline to file FORM-27 is within 6 months from expiry of 3 years [before September 30] and the Patent Office can condone the delay up to 3 months.
5.	138	Extension of Time U/R 138	Petition U/R 138 were allowed for maximum one month.	Now petition U/R 138 can be filed up to 6 months . Multiple request would be allowed in 6 months period.
6.	80	Renewal Fee Rebate	NO PROVISION OF REBATE	Amended Rule allow the patentee to 10% rebate in renewal fee payment if it is paid for at least 4 years in advance. It is important to note that 10% rebate is not available for back renewals (accumulated renewals) to be paid when a patent is granted. It is clarified that this concession is available only for renewals paid in advance.
7.	29A	Grace Period under sections 29, 30, 31, 32 and 33	NO PROVISION	New Rule 29A has been added into the Patent Rules, 2024 by which grace period will be allowed on filing of FORM-31 with fee.
8.	70A	Certificate of Inventorship	NO PROVISION	New Rule 70A has been added into the Patent Rules, 2024 by which inventor(s) can request for a certificate of inventorship in respect of a patent in force. A new Form 8A has been included in the Rules by which any inventor can apply to the Patent Office for issuance of a Certificate of Inventorship.
9.	55	Pre-grant Opposition	No time limit for Controller to dispose the Opposition U/R 55	Now the amended provisions provide the Controller to refuse or accept the opposition U/R 55 within one month.
10.	56	Post-grant Opposition - Opposition Board Report	To be submitted within 3 months	Amended Rule has reduced the submission time to 2 months.
11.		FORM-1	NO REQUIREMENT	Now FORM-1 has been amended to include the gender and age of the Applicant (in case of Natural Person) and Inventor(s).
12.		NEW FORMS		FORM 8A and FORM 31



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THE SALIENT FEATURES OF COPYRIGHT LAW IN SRI LANKA – PART - I

Introduction to Copyrights and the legislation in Sri Lanka

In the simplest sense, copyright means the legal right to copy. Under the Intellectual Property Law regime, copyrights are granted to owners of artistic, literal and scientific creations and those authorized by such owners with the exclusive right to reproduce the works of the owner.

It is said that the introduction of Copyright law in Sri Lanka occurred during the British rule but continued to be in existence in Sri Lanka long after the country obtained independence. In the current scenario, the Sri Lankan Copyright law is governed by the provisions coming under the Intellectual Property Act No 36 of 2003.

Copyright protection takes two forms. One is the protection of economic rights, and the other is the protection of moral rights. Economic rights include a list of activities that an author of a work can either exclusively by himself or authorize another person to carry out, which shall in turn allow the author to gain financial or economic benefits. Moral rights on the other hand exist independently of the economic rights of a work and an author shall have the right to the moral right of a work regardless of whether they no longer hold the economic right to such work. Moral rights grant the author the ability to oppose any deformation that may cause such work. While economic rights can be assigned to another person, moral rights shall always exclusively belong to the author. Further elaboration on economic and moral rights shall be discussed in future articles.

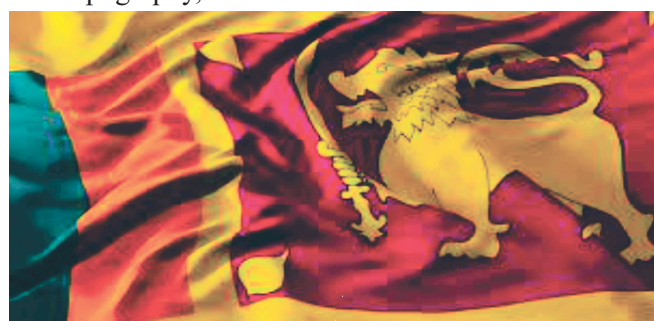
It must be noted that there is no formal registration process

in Sri Lanka for copyrights, as opposed to the likes of trademarks and patents. Protection granted for a work shall be in operation for the lifetime of the author and 70 years after their death.

Protected works

According to the Act, the following are accorded protection under the Act:

- Books, pamphlets, articles, computer programs and other writings;
- speeches, lectures, addresses, sermons and other oral works;
- dramatic, dramatic-musical works, pantomimes, choreographic works and other works created for stage productions;
- stage productions of works specified in paragraph © and expressions of folklore that are apt for such productions;
- musical works with or without accompanying words;
- audio visual works;
- works of architecture;
- works of drawing, painting, sculpture, engraving, lithography, tapestry and other works of fine art;
- photographic works;
- works of applied art; and
- illustrations, maps, plans, sketches and three-dimensional works relative to geography, topography, architecture and science.



Norms concerning the nature and scope of protected works

- Originality** – This does not make reference to a work being inventive. What it means is that the work should not be copied from another work and should be originated from the author of the work. However, a copy can derive protection when considering the degree of skill and talent that has been dispersed in making such a copy.

- ii. Expression of Idea – As provided under the Act, Copyright protection is not granted to “ideas” but the expression of those ideas. While distinguishing between the two are not easy the important aspect to be considered is to identify which elements the owner of a copyright shall be granted exclusive rights verses which elements can be used by third parties without the fear or infringement of the rights of the owner.
- iii. Mode or Form of expression – Protection is accorded irrespective of the mode or form of expression.
- iv. Content, quality and purpose – When assessing whether a work should be granted protection or not, the content, quality or the purpose for which such work is created is not considered.
- v. Formalities – There are no formal processes of registration in place as for trademarks or patents.
- vi. Fixation – The work need not be fixed into any material form and the mere creation of them is sufficient. However, as copyright protection is accorded to the “expression of ideas” rather than ideas themselves, it can be argued that fixation to a material form is essential.
- vii. Publication – Just as fixation, publication is not a requirement for a work to be granted copyright protection in Sri Lanka. However, in such situations where the author of a work is not a Sri Lankan national or resident or someone whose works are not granted any protection in Sri Lanka under the operation of any International Convention a work first published in Sri Lanka or 30 days after its publication in another country shall be entitled to the protection under the Act, regardless of whether the author of such work was a Sri Lankan national/resident or not.
- viii. Assessment of the entire work -When making an assessment on whether a work can be copyright protected, the entire work should be taken into consideration and should not be broken down into separate parts and each of those parts being assessed and concluded to mean that there can be no protection granted to a part.
- ix. Mere creation of expression – Protection is granted for a work based on the creation of it, regardless of the mode of expression, quality, content or purpose of the work.

Protected works

A derivative work is a piece of work that is based upon a single or several pieces of work that is already in existence. The protection granted to such work does not prejudice the rights granted to the work which was already in existence that was used to create the derivative work.

The following can be identified as derivative work:

- a) Translations, adaptations, arrangements and other transformations or modifications of works;
- b) Collection of works and collections of mere data (database), whether in machine readable or other form, provided that such collections are original by reason of the selection, coordination or arrangement of their content.

The area of copyrights is vast and ventures into various aspects, therefore the discussion on the area cannot be limited. In future articles we can approach the different topics which come under the area of copyright protection with further elaboration.

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Sanuji is an attorney-at-law admitted to practice before the Supreme Court of the Democratic Socialist Republic of Sri Lanka.

Sanuji's practice areas include transactional and contentious work in the fields of intellectual property, regulatory compliance, business start-ups, employment & HR. She actively assists local and foreign clients on intellectual property matters, business and technology start-ups, regulatory compliance, drafting & negotiating corporate agreements.

Sanuji has extensive work experience and is well-versed with the requirements and demands of legal practice. She handles contentious and non-contentious issues related to intellectual property rights as well as corporate and commercial legal matters. Her training and experience enable her to provide exceptional legal advice tailored in accordance with the client's requirements.

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IP UPDATES

PATENT CASES:

Novozymes A/S (Appellant) Vs. Assistant Controller of Patents and Designs (Respondents)

**Case Number: (T) CMA (PT) No.92 of 2023
(OA/18/2017/PT/CHN)
Decided on: 19 March, 2024**

The current appeal has been filed by the appellant w.r.t the rejection of the patent application by the respondent. The appellant had filed present application as a National Phase Application, bearing application no. 650/CHENP/2009 titled *"Enzyme Granules for Animal Feed"*. The Patent application was refused by the respondent on the ground that the claims do not qualify as an invention under Section 2(1)(j) of the Patents Act, 1970 and that they are not patent eligible under Sections 3(d) and (e). The appellant argued that the respondent acknowledged that claim 1 to 6 were novel and claim 7 was not novel and lack of inventive step on the basis of prior art D8 and D9. The appellant also argued that claim 6 is a new substance so Section 3(d) of the Patents Act also is inapplicable. The Hon'ble Delhi High Court observed the following matter and stated that claim 7 lacks specificity and the respondents has acknowledged claim 1 to 6 to be novel, so if claim 6 is novel then it cannot be considered as known substance therefore section 3(d) of the Patent Act is not applicable. The Hon'ble Court concluded by proceeding Application No.650/CHENCP/2009 to grant on the basis of current claims 1-6, which were filed with the written submissions and claim 7 as amended in the manner indicated *supra*.

Ashok Leyland Limited (Petitioner) vs. The Controller of Patents & Designs (Respondents 1) Tata Motors Ltd. (Respondents 2)

**Case Number: W.P.(IPD) No.1 of 2024 and
WMP.Nos.1 & 2 of 2024 Decided on: 15 March, 2024**

In the present case, the petitioner defends its patented invention titled *"Multi-Axle Vehicle Configuration having Heavy Duty Lift Axle"*. Respondent 2 had filed post grant opposition against the petitioner's patented invention under Section 25(2) of the Patents Act to which the petitioner filed a reply statement along with the two evidence. The matter was then placed before the

Opposition Board constituted under Rule 56 of the Patent Rules by the Controller and the Opposition Board came out with its recommendations (OBR). The petitioner argued that the Opposition Board failed to consider the evidence and that the OBR was cut copy paste of the written statement of the second respondent and the reply statement of the petitioner, making an incomplete OBR. The petitioner further argued that the OBR is a foundational document when the Controller takes up the matter for hearing and it can affect the balance sheet of the petitioner's company. The second respondent stated that the Opposition Board had considered the evidence but without reference to the names of those who have given the evidence, and that the OBR has only a recommendatory value so the Court may not preempt the Controller on how to weigh the OBR.

The Hon'ble Madras High Court observed the following matter and stated that the Opposition Board is a statutory creation, and they are required to consider all the materials that the parties are required to produce under Rule 57 to Rule 60 of the Patent Rules. However, the Court states that *"it may not be appropriate for this Court, in exercise of its jurisdiction under Article 226 of the Constitution to examine the adequacy of such recommendations."* The Court further states that if while hearing the Controllers determines that the OBR presented by the Opposition Board has failed to consider the evidence then the Controller may reconstitute the Opposition Board and to require such Board so constituted to make its recommendations.

NIRANJAN ARVIND GOSAVI AND ORS (Plaintiffs) vs. INNOVATIVIEW INDIA PRIVATE LIMITED (Defendant)

**Case Number: CS(COMM) 214/2024
Decided on: 13 March, 2024**

In the present case, the plaintiffs restricted the defendants for infringing plaintiffs patent bearing no. IN 336205 related to the field of offline authentication of data and the individual represented in the machine-readable barcode. Plaintiff's objection arose in context of an e-tender floated by the National Testing Agency ("NTA") for selection of agency for providing enhanced QR Code Solution with encoded texts. The plaintiff submitted their bid believing that the nature and scope of work specified under the e-tender can be achieved by using method/technology/process of the subject patent. The defendant being one of the bidders was itself an evidence that the defendant was infringing the patent.

The defendants argued claiming that they had their own technology implemented, although they had not applied for a patent. The defendants also submitted that even if the plaintiff's patent was valid, they would be protected from infringement claims under Section 47 read with 156 of Patents Act, 1970, stating that both the government and the contracting agency will be insulated from a claim of infringement. The plaintiff disapproved stating that while the government can use the patent for its own purpose, an infringer can still be enjoined.

The Hon'ble Delhi High Court observed the following matter and declined immediate injunction but allowed plaintiffs to inform the National Testing Agency (NTA) about the patent issue.

AUDERTEC SOLUTIONS LLP (Appellant) vs. CONTROLLER GENERAL OF PATENTS, DESIGNS AND TRADE MARKS & ANR. (Respondents)

**Case Number: C.A.(COMM.IPD-PAT) 3/2021
Decided on: 01 March, 2024**

The present appeal has been filed by the appellant against the refusal order issued by the respondent for patent application no. 202011011938 titled "a method and system for detecting road anomalies". The order holds the subject patent to be lacking an inventive step only vis-à-vis the prior art D-2. The appellant argued by presenting the distinguish between D-2 and the subject patent that the features of D-2 are unique to the subject patent and cannot be said to be either anticipated or obvious from D-2.

The Hon'ble Delhi High Court observed the following matter and stated that complete specification of D2 patent has envisioned a system for detecting road anomalies which is largely similar to that envisioned by the subject patent. The Court further states that "*these observations correctly encapsulate the principle of obviousness, and the indicia of an inventive step, vis-à-vis prior art, as a requirement of a valid patent*". The Court concluded that the subject patent is invalid on the ground of obviousness and lack of inventive step compared with the prior art D-2.

KUDOS PHARMACEUTICALS LIMITED & ORS. (Plaintiffs) vs. NATCO PHARMA LIMITED (Defendant)

**Case Number: CS(COMM) 29/2023, I.A. 907/2023
Decided on: 01 March, 2024**

NATCO PHARMA LIMITED (Plaintiffs) vs. KUDOS PHARMACEUTICALS LIMITED & ANR. (Defendant)

**Case Number: C.O.(COMM.IPD-PAT) 1/2023,
I.A. 153/2023**

In the present case, the plaintiff restricted the defendant for infringing plaintiff's patent bearing no. IN 228720 (IN' 720) titled "*Phthalazinone derivative*". The plaintiffs were granted patent by the Indian Patent Office (IPO) on 10 February 2009. In claim 1 of plaintiff's patent, they had assigned an IUPAC name for the compound as "Olaparib". The defendant allegedly manufactured and sold its own generic version of Olaparib under the brand name BRACANAT. The defendants had not filed any pre or post grant opposition with respect to the IN' 720 and the defendant also filed C.O. (COMM.) IPD-PAT 1/2023 after the IN' 720 was instituted by plaintiff i.e., during the 19th year of patent's life. The plaintiff argued for permanent injunction restraining defendant from manufacturing or selling or otherwise dealing with any product with Olaparib, either under the brand name BRACANAT or otherwise. The plaintiff also argued that the defendants wrongfully contend that Olaparib was disclosed in IN'218 and that the patent IN'720 is valid and capable of being granted.

The Hon'ble Delhi High Court observed the following matter and stated that the defendants have been exploiting the patent IN' 720 by manufacturing and selling Olaparib in the 19th year of the life of the patent. The Court further states that there is also no case of invalidity on any of the grounds contained in Section 64 of the Patents Act as claimed by the defendants. The Court further concluded by restraining defendants from manufacturing and selling, or in any manner, dealing with Olaparib, under any brand name until the plaintiff's patent continues to remain alive and subsisting.

SAINT GOBAIN ABRASIVES INC & ANR. (Appellants) Vs. CONTROLLER OF PATENTS (Respondent)

**Case Number: C.A.(COMM.IPD-PAT) 20/2021
Decided on: 26 February, 2024**

The current appeal has been filed by the appellant w.r.t the refusal order issued by the respondent refusing the patent application no. 2458/DELNP/2013 under section 2 (1) (ja) and under Sections 59/57 of the Act

claiming that new features have been added in the original set of claims. The appellant argued that the respondent has not performed proper analysis of the prior arts and also that the amended claims do not introduce any new fact or describe a matter which was not, in substance, disclosed or shown in the specifications before the amendment.

The Hon'ble Delhi High Court observed the following matter and stated that the prior arts do not teach a specific combination of the three binders as is required by the applicant-appellant's claims. The Court further states that *"the amended claims was effectively to rationalise consolidation of various parts of the original claims and nothing new has been claimed in order to expand the original claim which is precluded by Section 59 of the Act."* The Court concluded by directing the respondent to re-hear the appellant in relation to their submissions and to institute a de novo notice of hearing in the said matter to the appellant within the next four weeks.


TRADEMARKS SNIPPETS

PIDILITE INDUSTRIES LTD. (Petitioner) vs. SANJAY JAIN & ANR (Respondents)

Case No.: C.O. (COMM.IPD-TM) 371/2022
Decided On: March 22, 2024



The present rectification has been filed by the plaintiff for the removal/cancellation of the impugned mark

“” from the registrar of trademarks.

The plaintiff contended that their mark “FEVIKWIK” and its variation has obtained the protection under trademark law along with the status of Well-Known mark. The petitioner contended that the essential feature of the impugned mark is similar and deceptively similar to the petitioner's mark which can cause likelihood of confusion on the part of public and association with the petitioners registered trademarks.

The Hon'ble Delhi High Court observed that the common and dominant part of this mark is 'FEVI' which is suffixed with a sub-brand depending on the nature of the product and that the recall, therefore, of a customer is on the basis of the 'FEVI' family of marks and not the sub-brand forming part of the suffix. The Court concluded the fact that respondents registered device mark has the word 'KWIK' as part of 'KWIKHEAL' would not stop the respondent from claiming commonality in the word KWIK. It is

acceptable that a part of a distinctive mark may have a common element and comparisons are therefore insulated from a portion of the mark applying the 'anti-dissection Rule'. The Hon'ble court further ruled that the petition for rectification has to stand on its own legs and not take the crutch of the Bombay High Court's prima facie findings in a suit for infringement/passing off against the respondent's earlier packaging, now superseded by a new device/packaging. Accordingly, the Hon'ble Court dismissed the rectification petition.

SMITH CORPORATION AND ANR. (Plaintiffs) vs. STAR SMITH EXPORT PVT. LTD. AND ANR. (Defendants)

Case No.: I.A. 19011/2022 & I.A. 12253/2023 in CS(COMM) 532/2022 A.O
Decided On: March 22, 2024



The present suit was filed by the plaintiff against the defendants, alleging trademark infringement

for the mark “AO SMITH”/

The Plaintiffs have been using the said marks since very long internationally and in India since 2006 specialized in geysers, water heaters, purification systems, boilers, and related equipment. In contrast to this, the defendant contended that the existence of other entities using the term 'SMITH' in classes 7 & 11.

After reviewing the evidence of the above contentions, the Hon'ble Delhi High Court determined that the defendant's use of the terms 'STAR SMITH' and 'BLUE DIAMOND' constituted trademark infringement. The court underlined that the defendants' prior use of 'Aero Star' and 'Star Enterprises' demonstrated a preference for the 'STAR' element over the 'SMITH' component. As a result, the addition of 'SMITH' in conjunction with 'STAR' in 2020 appeared to be a prima facie dishonest adoption, aimed at leveraging on the plaintiffs' goodwill and causing market confusion, particularly for identical goods. Hence, the Delhi High Court order restrain the defendants serves as a warning of the legal consequences of infringing on existing trademarks and engaging in deceptive marketing activities.

GOOGLE LLC (Plaintiff) vs MR. P. RAJESH RAM & ORS (Defendants)

Case No.: CS(COMM) 209/2024
Decided On: March 12, 2024




GOOGLE LLC (Plaintiff) vs MR. P. RAJESH RAM & ORS (Defendants)

Case No.: CS(COMM) 209/2024
Decided On: March 12, 2024



The present suit has been filed by the plaintiff against defendants for infringing its trademarks “Google”, “Google”, “GOOGLE PAY”, and “G Pay”

The plaintiff presented their registered trademarks highlighting the history of it. The plaintiff further mentioned that it has gained the tremendous reputation all over the world and has been declared as a Well-Known Trademark. The plaintiff contended that defendants have been using similar marks attempted trademark infringement, particularly in the context of domain names, where it amounted to typo-squatting and creating confusion among consumers.

Plaintiff’s Trademarks	Defendant’s Trademarks
GOOGLE	GOOOOGLE
	GOOCLE
	GEOGLE
GPAY	GIPAY
	
	

The Hon'ble Delhi High Court noted that the defendants were using this marks and domain names for providing services which already overlaps the plaintiff's services. The sole purpose of using these impugned marks was to create confusion among the market. In addition to this, in case of typographical errors in entering the concerned URL's may mislead the potential user to the impugned websites. Hence the Hon'ble court opined that the impugned marks and websites and structurally, phonetically and identically similar to the plaintiff's registered well-known marks. The Hon'ble court ruled in favor of plaintiff and restrained defendants from using the impugned marks till the next date of hearing.

BTB MARKETING PVT. LTD. (Petitioner) vs. DEEPSHIKHA SINGH AND ANR. (Respondents)

Case No.: C.O. (COMM.IPD-TM) 380/2021
Decided On: March 12, 2024



The present petition was filed by the petitioner for rectification of respondent's mark “BE THE BEER”.

The petitioner was using device mark “ The Beer Café

and wordmark “THE BEER CAFE” since June 2016. The respondent was using the trademark “BE THE BEER” from 2017. The respondent used a visual representation of the mark "BE THE BEER" for their café. The petitioner stated that both of them operate in the same industry, and that although just prefixing the term "BE" by respondent in the impugned mark does not establish any differences, it clearly shows deceptive similarity with their registered trademark having a prior user. Furthermore, no one has appeared on behalf of respondent no.1 either before IPAB or Hon'ble Delhi High court.

The Hon'ble Delhi High Court, taking the facts into consideration presented by petitioner allowed the petition as the petitioner is prior user and the respondent's mark was showing deceptive similarity. The Hon'ble court ordered that within a period of 4 weeks, the impugned mark shall be removed from the Register of Trade Marks and the same shall be updated accordingly.

DOLMA TSERING (Petitioner) vs. MOHD. AKRAM KHAN AND ANR (Respondents)

Case No: C.O. (COMM.IPD-TM) 334/2021
Decided On: March 06, 2024



The present rectification petition was filed by the petitioner seeking cancellation and removal of the respondent no. 1's trademark “DOLMA AUNTY MOMOS”. The present application was initially filed before Intellectual Property Appellate Board (IPAB) however post abolition of IPAB, it has been transferred to Hon'ble Delhi High court.

The petitioner has claimed that she has been engaged in the business of selling the Tibetan Delicacy 'Momos' and other like products since 1994 and as of now ran five

shops across Delhi-NCR. She was the first retailer of said Tibetan delicacies and has gained massive reputation in her food products. Furthermore, no one has appeared on behalf of respondent no. 1.

In view of abovementioned facts, Hon'ble Delhi High Court has proceeded with ex-parte and passed an order according to which the trademark of respondent no. 1 has been cancelled and removed from the Trade Marks Register and website of Registrar of Trade Marks be updated within a period of four weeks.

WOW MOMO FOODS PRIVATE LIMITED (Plaintiff) vs WOW PUNJABI (Defendant)

Case No.: CS(COMM) 253/2024, I.A. 6781/2024, I.A. 6782/2024, I.A. 6783/2024, I.A. 6784/2024 & I.A. 6785/2024

Decided On: March 03, 2024



In the present suit, the application has been filed seeking permanent injunction restraining infringement of trademark, passing off, unfair trade practice, rendition of accounts, and damages against the defendant.

The plaintiff has contended that it is a registered proprietor of trademark "WOW/WOW! MOMO" and



it has gained tremendous reputation and goodwill in the market. The defendant is running restaurant under trademark "WOW/WOW PUNJABI"/



Moreover, the defendant has not replied to any cease-and-desist notice.

By considering the facts and contentions presented by the plaintiff, the Hon'ble Delhi High court has satisfied that the plaintiff has made out prima facie case for grant of an ex parte ad interim injunction accordingly the defendant and all other acting on their behalf are restrained from using, Moreover, the defendant has not replied to any cease-and-desist notice.

By considering the facts and contentions presented by the plaintiff, the Hon'ble Delhi High court has satisfied that the plaintiff has made out prima facie case for grant of an ex parte ad interim injunction accordingly the defendant and all other acting on their behalf are restrained from using, advertising, directly or in directly under impugned mark or any other trademark which is deceptively similar plaintiff's registered trademarks.

HERO MOTOCORP LIMITED & ANR. (Plaintiffs) vs. PAWAN KUMAR TRADING AS MS PARI ENTERPRISES & ORS. (Defendants)

Case No.: CS(COMM) 90/2024

Decided On: February 05, 2024



The present suit was filed by the plaintiff to protect their registered trademarks from infringing activities by the defendants. The defendant has been using an identical and deceptively similar mark to sale potash alum bars.

The plaintiff has prior registrations of the mark "HERO" in India and in other jurisdictions around the world and the defendant neither has any registration for the impugned mark nor any pending applications for registration. Upon sending many summonses and service notices, defendants did not appear before the court.

The Hon'ble Delhi High Court observed that upon comparing the Plaintiffs' HERO Marks with the Impugned Marks, is of the prima facie opinion that the defendants have copied the identical trademarks of the Plaintiffs. Therefore, their adoption of the Impugned Marks is without cause and clearly with a mala fide intent to take unfair advantage of the Plaintiffs' HERO Marks, which have additional goodwill and reputation. Such bad faith adoption and use by the Defendants is likely to cause immense damage to Plaintiffs' reputation and would be detrimental to the distinctive character of Plaintiffs' HERO marks. The Hon'ble Delhi High Court proceeded to consider ex-parte and has ordered that till the next date of hearing defendants are restrained from using the impugned mark.





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