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Editorial

Dear Friends & Colleagues,

As we welcome 2025, I extend my heartfelt wishes for a year filled with success, health, and happiness to each of you. May the New Year bring exciting opportunities and boundless growth for us all.

Reflecting on 2024, it has been a remarkable year for Audiri Vox and our newsletter, **AVIP**. Over the past year, we achieved significant milestones that underscore our unwavering commitment to excellence and innovation in the field of intellectual property. One of our proudest moments was our active involvement in the WIPO Diplomatic Conference to Conclude a Design Law Treaty (DLT) in Riyadh, Saudi Arabia. This historic event brought together global stakeholders to adopt a harmonized legal framework for protecting industrial designs. The treaty represents a transformative step in global IP frameworks, and we are honored to have contributed to this milestone.

AVIP has continued to serve as a valuable platform, offering in-depth insights, updates, and expert

commentary across IP jurisdictions, including the Middle East, Africa, India, Pakistan, and Sri Lanka. The enthusiastic reception and constructive feedback from our colleagues, clients, and subscribers have been both humbling and inspiring. Your trust fuels our drive to enhance and expand the value we provide.

This year's featured article delves into the significance of the Design Law Treaty (DLT), highlighting how it will simplify design registration processes and foster innovation on an international scale. It's a must-read for those eager to stay at the forefront of global IP developments.

As always, our dedicated team of legal professionals has remained steadfast in delivering comprehensive solutions across the spectrum of intellectual property, from trademarks and patents to copyrights, designs, and plant variety protection. We are immensely proud of our accomplishments in 2024 and remain committed to advancing our services to meet and exceed the expectations of our clients and peers in 2025.

Thank you for being an integral part of our journey. Your support and engagement make everything we achieve possible. We are excited to continue sharing valuable insights and expertise with you in the year ahead.

Here's to another year of collaboration, innovation, and success!

Sincerely,



Sarmad Hasan Manto

Chief Editor-AVIP
Managing Partner - Audiri Vox





Divyendu Verma
AUDIRI VOX, Dubai, UAE

THE RIYADH DESIGN LAW TREATY: A MILESTONE IN GLOBAL DESIGN PROTECTION

The WIPO Diplomatic Conference to Conclude a Design Law Treaty took place at the King Abdulaziz International Convention Center in Riyadh, Saudi Arabia, from November 11 to 22, 2024. This pivotal event brought together approximately 900 delegates, including representatives from 190 WIPO member states and multiple intergovernmental organizations. The conference marked the culmination of extensive negotiations on a proposed treaty aimed at supporting designers worldwide by simplifying and harmonizing the process of protecting industrial designs.

Over the course of 10 days of intensive discussions, the participating nations successfully adopted a unified legal framework for the protection of industrial designs. This treaty represents a major milestone in the evolution of International Intellectual Property (IP) systems, promising to streamline procedural formalities, reduce costs, and make design registration more accessible and consistent on a global scale. The adoption of the treaty underscores the international community's commitment to fostering innovation and creativity by providing robust support to designers.

OBJECTIVES AND SCOPE OF THE DLT

The DLT primarily focuses on procedural formalities associated with industrial design applications. Unlike substantive treaties, it does not define the legal concept of a "design" or the conditions for protection, leaving such

determinations to individual contracting parties. The overarching goal of the DLT is to facilitate easier, faster, and cheaper protection of designs across multiple jurisdictions. This is particularly advantageous for micro, small, and medium-sized enterprises (MSMEs) that often face challenges in navigating diverse IP systems. While large corporations have the wherewithal to fight anyone who copies their designs across the globe, the micro, small and medium sized enterprises don't have the financial resources to take on people who copy their designs, thus this treaty, if implemented honestly, has the potential to protect the IP of MSME's.

The treaty's scope extends to both national and regional applications and encompasses industrial designs that can be registered under applicable laws. Notably, the treaty aligns with existing instruments like the Patent Law Treaty (2000) and the Trademark Law Treaty (1994), furthering WIPO's mission of IP harmonization.

HISTORICAL CONTEXT AND DEVELOPMENT

The journey toward the DLT was long and complex. The idea was first proposed by Norway and Latvia in 2005 during the 15th session of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications. Over the next two decades, numerous discussions and negotiations were held to draft the treaty. A significant breakthrough came in July 2022 when the WIPO General Assembly decided to convene a diplomatic conference for the treaty's conclusion. The Riyadh conference in 2024 was the culmination of these efforts, with the active participation of both member states and observer organizations.

KEY PROVISIONS OF THE DLT

The treaty comprises 34 Articles and 18 Rules, which collectively aim to standardize and simplify the design registration process. Some of the notable provisions include:

- **Standardized Application Requirements (Article 4):**

The treaty establishes uniform requirements for design applications, including details about the applicant, a clear representation of the design, and the option for electronic submissions. This reduces administrative burdens for applicants navigating multiple jurisdictions. Additionally, applications may include information such as the identity of the

creator, a statement of assignment, and partial design details, where applicable.

- **Grace Period (Article 7):** The DLT provides a grace period of up to 12 months for filing a design application after public disclosure. This ensures that designers do not lose their rights due to early disclosure of their creations. Notably, the grace period applies to disclosures made by the creator, their successor in title, or as a result of abuse. For an MSME, often going to the market is the default way forward rather than first protecting their IP, as their resources are limited. Thus, this grace period protects their designs while they try to cash in the innovation done through their design.
- **Deferred Publication (Article 10 and Rule 6):** Applicants can request to delay the publication of their designs for at least six months from the filing date. This feature provides flexibility for designers in managing the timing of market entry and intellectual property strategies.
- **Relief for Time Limits (Article 14):** The treaty allows for extensions and reinstatements of rights in cases of missed deadlines. Contracting parties must provide mechanisms for extending time limits and reinstating rights if delays occurred despite due care or were unintentional.
- **Multi-Design Applications (Article 16):** Applicants can include multiple designs in a single application, provided that the designs belong to the same Locarno Classification. This provision significantly reduces administrative and financial burdens for applicants.
- **Digital Representation (Rule 3):** The treaty accommodates modern technological advancements by allowing designs to be represented through photographs, graphic reproductions, or other visual media. Representations can include views showing contours, shading for volume, or dotted lines to indicate non-claimed elements.
- **Correction and Addition of Priority Claims (Article 16):** The treaty ensures that applicants can correct or add priority claims within a prescribed time limit, even after substantive examination, under specific conditions.
- **Non-Recording of Licenses (Article 19):** The validity of a design registration and the associated protection are unaffected by the non-recording of licenses with the Office, safeguarding licensees' rights in infringement proceedings.

SIGNIFICANCE FOR INDIA IN THE CONTEXT OF THE DESIGNS ACT, 2000:

India, as a signatory to the Riyadh Design Law Treaty, stands to gain significantly by aligning its Designs Act,

2000, with the provisions of the treaty. This alignment could usher in procedural reforms that simplify design registrations, making them more accessible to designers and industries in the country.

The introduction of standardized application requirements under the DLT could streamline the Indian registration process. Currently, Indian applicants must navigate varying procedural requirements when seeking protection in multiple jurisdictions. The harmonization brought by the DLT would reduce administrative burdens and improve efficiency, particularly benefiting India's MSME sector, which forms the backbone of its economy.

India's robust design-intensive industries, such as textiles, jewellery, handicrafts, and automotive manufacturing, would find immense value in the treaty's grace period provisions. The 12-month grace period would allow Indian designers and companies to publicly showcase their innovations at trade fairs or exhibitions without losing their right to protection. This aligns well with the country's strategy to promote "Make in India" and "Design in India" initiatives.

Furthermore, the provision for multi-design applications can significantly reduce costs for Indian applicants. Under the current Industrial Designs Act, separate applications are often required for each design, increasing time and expenses. By enabling multiple designs in a single application, the DLT could lower these barriers, fostering greater innovation and creativity among Indian designers.

Finally, the DLT's focus on digital representation aligns with India's digital transformation efforts. With an increasing emphasis on e-governance, the adoption of electronic submissions and visual media for design representations would modernize India's IP infrastructure, making it more user-friendly and internationally competitive.

ADDRESSING GLOBAL CONCERNS

One of the most debated aspects of the DLT was the inclusion of provisions related to Traditional Knowledge (TK), Traditional Cultural Expressions (TCE), and Biological/Genetic Resources (BGR). The African Group and several other delegations emphasized the need for mandatory disclosure of the origins of these elements in design applications. While this proposal was not incorporated into the main text of the DLT, it remains a critical issue for future discussions.

IMPLEMENTATION AND RATIFICATION

The treaty will enter into force three months after at least 15 member states ratify it. Given the precedent set by similar treaties, this process could take two to five years. Countries are expected to align their domestic laws with the treaty's provisions to facilitate smooth implementation.

SIGNIFICANCE FOR DESIGNERS AND INDUSTRIES

The DLT is poised to benefit designers worldwide by:

1. **Reducing Costs:** By harmonizing procedural requirements, the treaty eliminates redundancies and lowers the cost of obtaining design protection.
2. **Increasing Predictability:** Uniform rules make the registration process more transparent and predictable, fostering innovation.
3. **Expanding Access:** MSMEs and individual designers, who often lack the resources to navigate complex IP systems, will find it easier to secure design rights.

CHALLENGES AND FUTURE DIRECTIONS

While the DLT addresses many procedural hurdles, some issues remain unresolved. For instance, the treaty does not mandate substantive harmonization, leading to potential

disparities in design protection standards. Additionally, concerns about the treatment of TK, TCE, and BGR highlight the need for more inclusive international frameworks.

The treaty's success will largely depend on its adoption and effective implementation by member states. Further discussions and possible supplementary agreements may be needed to address the gaps left by the DLT.

CONCLUSION

The Riyadh Design Law Treaty represents a landmark achievement in global IP governance. By simplifying the procedural aspects of design registration, it paves the way for greater innovation and creativity. As countries begin the process of ratification and implementation, the treaty holds the promise of transforming the landscape of Industrial Design protection, ensuring that creators worldwide have access to robust and efficient legal mechanisms to safeguard their work.

*Note:** The author of the article was one of the negotiators in DLT proceedings concluded in Riyadh. He along with another colleagues represented INTA (International Trademark Association) during the Diplomatic conference.*





IP UPDATES



PATENTS CASES



**WATEROTOR ENERGY TECHNOLOGIES INC
(Petitioner) vs. UNION OF INDIA & ANR. (Respondent)**

CASE NO.: W.P.(C)-IPD-7/2024

DECIDED ON: December 9, 2024



The petitioner has filed an appeal against the respondent for abandoning the patent application under section 21(1) of the Patent Act. The petitioner based in Canada, had engaged the first patent agent in Canada who further appointed an Indian patent agent to handle their Indian patent application. Due to miscommunication between the patent agents, the petitioner missed the deadline for responding to the First examination report (FER). The petitioner submits that they never received any communication with respect to the FER and that they do not wish to go into the issue with respect to the negligence on the part of the First or the Second Patent Agent. The respondent no. 1 submitted that the communication regarding FER was passed on to the second patent agent, and the second patent agent must have passed it to the first patent agent.

The Hon'ble Delhi High Court observed and considered the fact that the petitioner had missed the deadline to file the FER response due to miscommunication by the patent agents. Therefore, the Hon'ble Court decided to set aside the abandonment order and to revive the petitioner's patent application. The Hon'ble Court ordered the patent office to update its web portal within 2 weeks to show the application as pending and also ordered the applicant to file the FER response within four weeks of the status update.

**BOEHRINGER INGELHEIM VETMEDICA
(Appellant) vs. THE CONTROLLER OF
PATENTS (Respondent)**

CASE NO.: C.A.(COMM.IPD-PAT) 225/2022

DECIDED ON: December 2, 2024

In the present case the appellant has filed an appeal against the respondent challenging the rejection of the patent application on the grounds of lack of inventive step under

section 2 (1) (ja) and lack of novelty under section 2(1)(j) based on prior arts. The appellant argued that the respondent had failed to consider the detailed submissions involving distinguishment of the subject application from the prior arts i.e., cited by the respondent. The respondent countered that the appellant has failed to provide any justification or grounds for distinguishing the subject invention from the prevailing prior arts.

The Hon'ble Delhi High Court found merit in the appellant's argument and noted that the respondent had failed to consider the submissions made by the appellant and wrongfully passed the impugned order without any proper justification. The Hon'ble Court concluded by setting aside the impugned order and remanding the matter back to the respondent for a fresh consideration, directing the respondent to consider all materials on record, and to pass a reasoned order within two months.

**SYNGENTA CROP PROTECTION AG (Appellant) vs.
ASSISTANT CONTROLLER OF PATENTS (Respondent)**

CASE NO.: C.A.(COMM.IPD-PAT) 63/2024

DECIDED ON: November 26, 2024



The current appeal has been filed by the appellant against the respondent for rejecting the patent application on the grounds that the claims fall within the scope of the words 'method of agriculture' under Section 3(h) of the Patents Act. The appellant amended the claims by deleting claim 11 and thereby maintaining claim 1-10. The appellant argued that the respondent had incorrectly applied section 3 (h) of the Patent Act to the method of 'treatment of plants' and highlighted the amendment carried out in section 3 (i) by removing 'treatment of plants' from non-patentable items. The respondent countered that they have correctly objected the present invention under section 3(h) of the Patents Act.

The Hon'ble Delhi High Court observed the following matter and stated that a method of treatment of plants would not fall under the purview of 'method of agriculture' as defined in Section 3(h) of the Patents Act. The Hon'ble court concluded, by remanding the matter back to the respondent for a fresh examination.

**SIGNAL PHARMACEUTICALS (Appellant) vs.
CONTROLLER OF PATENTS AND DESIGNS
(Respondents)**

CASE NO.: (T)C.M.A(P.T) No.145 of 2023

DECIDED ON: November 21, 2024

The appellant has filed an appeal against the respondent challenging the rejection of the appellant's patent application under section 3(d) of the Patent Act. The appellant argued that the respondent failed to address the technical effect and the submission made by the appellant. The appellant further argued that the respondent has refused the grant of patent by total non-application of mind, without giving any reasons as to why the invention does not satisfy the test of therapeutic efficacy. The respondent stated that the present invention lacks technical advancement and therefore the claimed invention is rightfully rejected under 3(d) of the Patents Act.

The Hon'ble Madras High Court observed the following matter and stated that the respondent did not provide sufficient reasoning for rejecting the appellant patent application. The Hon'ble Court also states that *"the respondent has also ignored the legal principles rendered by the Constitutional Courts on uniqueness and inventiveness."* The Hon'ble Court concluded for re-considering the appellant's patent application by taking into account the observations set out in the present judgment.

TRADEMARK CASES

INTER IKEA SYSTEMS BV (PLAINTIFF) vs. I KEY HOME STUDIO LLP AND ANR (DEFENDANTS)

CASE NO. - CS(COMM) 1143/2024, I.A. 48690/2024, I.A. 48691/2024, I.A. 48692/2024 & I.A. 48693/2024
DECIDED ON - December 18, 2024

Plaintiff, the globally renowned home furnishings brand, filed a suit against Defendants for trade mark infringement. Plaintiff alleged that the defendant's use of the mark

'IKEY'



including the domain

www.ikeyllp.com, was deceptively similar to plaintiff well-known mark

'IKEA.'



The Plaintiff argued that the Defendants' use targeted identical

goods, including home interior solutions, and was intended to ride on Plaintiff's goodwill and reputation. The Defendants, though served notice, did not appear in Court to present their arguments.

The Hon'ble Delhi High Court observed that Plaintiff's trademark, first adopted in 1943, is globally recognized and has been declared a well-known mark in multiple jurisdictions. The Hon'ble Court noted that the Defendant's mark 'IKEY' was visually, phonetically, and conceptually similar to IKEA, likely causing confusion among

consumers. The Hon'ble Court further highlighted the defendant's mala fide intent, as evidenced by its use of 'IKEY' prominently on its website and showroom for similar products.

The Hon'ble Court concluded that Plaintiff had established a strong prima facie case. Recognizing the potential for irreparable harm to Plaintiff's reputation, the Hon'ble Court granted an ex-parte interim injunction restraining the Defendants from using the mark 'IKEY' or any similar variant. Additionally, the Hon'ble Court directed suspension

MOTI MAHAL DELUX MANAGEMENT SERVICES PVT. LTD. & ORS. (Plaintiffs) vs. M/S. SRMJ BUSINESS PROMOTERS PVT. LTD. & ANR. (Defendants)

CASE NO. - CS(COMM) 1115/2024 & I.A. Nos. 48062/2024, 48063/2024, 48064/2024, 48065/2024 & 48066/2024
DECIDED ON - December 12, 2024

PLAINTIFFS' EARLIER, WELL-KNOWN REGISTERED TRADEMARKS	DEFENDANT NO. 1'S IMPUGNED MARKS
'MOTI MAHAL'	'MOTI MAHAL DELUX'
'MOTI MAHAL GROUP'	'MOTI MAHAL DELUX TANDOORI TRAIL'
'MOTI MAHAL MANAGEMENT SERVICES'	
'TANDOORI TRAIL'	

The plaintiff filed the present suit, asserting that the defendant, an ex-franchisee, continues to use the plaintiffs' trademarks despite the

expiration of the franchise agreement. Plaintiffs assert exclusive ownership of trademarks like "MOTI MAHAL" and "TANDOORI TRAIL," emphasizing their global recognition and legacy stemming from 1920. Plaintiffs highlight their trademarks' widespread registrations in India and internationally, reinforcing their exclusivity. Defendant allegedly continues operations under the marks "MOTI MAHAL DELUX TANDOORI TRAIL" and "MOTI MAHAL DELUX" despite the franchise agreement's termination and repeated cease-and-desist notices. Plaintiffs argue that the defendant's actions create consumer confusion. Unauthorized representations on platforms like Zomato and Justdial further exacerbate the infringement claims. The Hon'ble Delhi High Court gave directions to the defendants to remove reference of all the impugned marks from the impugned restaurant premises, from social media websites and stop using the impugned marks or any other mark, which is deceptively and/or confusingly similar to the plaintiffs' trademarks.

MANKIND PHARMA LIMITED (Plaintiff) vs. KINDMANS LABORATORIES LIMITED (Defendant)

CASE NO. - CS(COMM) 1085/2024, I.A. 47285/2024, I.A. 47286/2024, I.A. 47287/2024, I.A. 47288/2024, I.A. 47289/2024, I.A. 47290/2024 & I.A. 47291/2024
DECIDED ON - December 05, 2024

Plaintiff filed a suit against defendant for trade mark infringement seeking permanent injunction. The plaintiff contended that the trademark “**Kindman's**”

is almost identical and deceptively similar to the plaintiff's registered trademark **Mankind**. The trademark **MANKIND** was adopted by the plaintiff in the year 1986 and have acquired tremendous goodwill and reputation in India and globally. The plaintiff's trademark “**Mankind**” is also declared as a “Well-Known Trademark”. The plaintiff also has the registration for the trademark “**KINDMAN**” in classes 44 and 10.

The Hon'ble Delhi High Court observed a prima facie case in favor of the plaintiffs, that the plaintiff formative trademark “**KIND**” has a strong goodwill and reputation in pharma industry and consumer associate it with pharma goods. Defendant use of trademark “**Kindman's**” is mala fide ab initio. Such use attain illicit gains by riding upon the goodwill of plaintiff. The Hon'ble Court granted an ex-parte ad-interim injunction, restraining defendant from dealing in any goods and services under the impugned trademark “**Kindman's**” and any other trademark identical to or deceptively similar to plaintiff's registered trademark.

JACK DANIELS PROPERTIES, INC. (Petitioner) vs. M/S MANGLAM KRUPA & ANR. (Respondents)

CASE NO. - C.O. (COMM.IPD-TM) 249/2024 & I.A.

47050-47052/2024

DECIDED ON - December 04, 2024

The petitioner, a global proprietor of the trademark “**JACK DANIEL'S**” **JACK DANIEL'S**, filed a petition under Section 57 of the Trade Marks Act, 1999, seeking cancellation of the respondent's registered mark. The petitioner contended that the impugned mark, registered on a “proposed to be used” basis, was deceptively similar to their widely recognized and extensively used trademark, “**JACK DANIEL'S**,” which enjoys goodwill and reputation globally and in India since 1997. The respondent's adoption of the mark was alleged to be mala fide, attempting to exploit the goodwill of “**JACK DANIEL'S**.” The petitioner claimed the mark could cause confusion, deception, and harm to their reputation, violating Sections 9(2)(a) and 11 of the Trade Marks Act, 1999.

The Hon'ble Delhi High Court acknowledged the petitioner's prima facie case, emphasizing the potential for confusion and harm due to the respondent's mark. The Hon'ble Court observed that the balance of convenience favored the petitioner, and that irreparable harm would be

caused if the mark's operation was not stayed. The Hon'ble Court stayed the registration of the respondent's mark until the next hearing and directed notices to be served to the respondents.

LENOVO (SINGAPORE) PTE. LTD. (Petitioner) vs. RPD WORKSTATIONS PRIVATE LIMITED and THE REGISTRAR OF TRADEMARKS (Respondents)

CASE NO. - OP(TM) No.60 of 2024

DECIDED ON - December 03, 2024

The petitioner, a global leader in laptop manufacturing and proprietor of the renowned “**THINK Family of Marks**” (e.g., **THINKPAD**, **THINKBOOK**), filed a petition seeking cancellation of the trademark “**THINBOOK**” registered by the first respondent. The petitioner alleged that the mark was phonetically, structurally, and conceptually similar to their trademarks, causing confusion among the public and diluting their brand's reputation. Petitioner's Argued that the “**THINBOOK**” mark was deceptively similar to their established trademarks, creating a false association with their **THINK Family of Marks**. The first respondent's actions were alleged to be *mala fide*, aiming to ride on the goodwill of the petitioner's brand.

The Hon'ble Madras High Court recognized the petitioner's long-standing reputation in India and abroad. The Hon'ble Court held that “**THINBOOK**” was deceptively and phonetically similar to the petitioner's marks, likely to mislead the public into believing an association. The Hon'ble Court also noted non-application of mind by the Trademark Registry in granting the impugned registration. The Hon'ble Court ruled in favor of the petitioner, directing the cancellation and removal of the “**THINBOOK**” trademark from the Register of Trademarks within four weeks.

DR DEVI PRASAD SHETTY & ANR. (Plaintiffs) vs. MEDICINE ME & ORS. (Defendants)

CASE NO. - CS(COMM) 1053/2024 & I.A. Nos. 46360/2024,

46361/2024, 46362/2024, 46363/2024, 46364/2024 & 46365/2024

DECIDED ON - November 28, 2024

Plaintiffs filed a suit against several defendants, including unknown parties operating social media platforms. The plaintiffs alleged misuse of plaintiff no. 1 persona, name, likeness, and infringement of plaintiff no. 2 registered trademarks

The impugned content, allegedly created for commercial gain, included doctored videos and misleading health advice, threatening the plaintiffs' reputation and public trust. The plaintiffs contended that the unauthorized usage diluted their goodwill and misled the public. They further highlighted that the misuse not only violated plaintiff no. 1 personality rights but also infringed their intellectual property. The defendants, including Google LLC and Facebook, were accused of facilitating the dissemination of such content. Some defendants claimed willingness to comply, while others remained unidentifiable.

The Hon'ble Delhi High Court observed a prima facie case in favor of the plaintiffs, emphasizing the substantial harm caused by the misuse of plaintiff no. 1 persona and the trademarks' infringement. The Hon'ble Court acknowledged plaintiff no. 1 status as a public figure and the extensive goodwill associated with plaintiff no. 2, noting that unauthorized use could tarnish their reputation. The Hon'ble Court granted an interim injunction restraining the defendants from further misuse of plaintiff no. 1 and plaintiff no. 2 persona and the trademarks respectively. Platforms like Google and Facebook were directed to block infringing content and disclose details of the accused parties. This ruling underscore the judiciary's commitment to safeguarding intellectual property and personality rights.

NEW BALANCE ATHLETICS INC. (Plaintiff) vs. ASHOK KUMAR & ORS. (Defendants)

CASE NO. - CS(COMM) 104/2023 & I.A. 3739/2023
DECIDED ON - November 27, 2024

The plaintiff, a globally renowned company owning the trademarks "NEW BALANCE" and the "



logo, filed a suit against the defendants, including operators of the website www.luxurytag.in, alleging trademark infringement, passing off, and unfair competition. The suit was initiated when it was discovered that the defendants were selling counterfeit products bearing the plaintiff's trademarks. Despite notices, the defendants failed to appear or submit a written statement. The plaintiff contended that they have been using the "NEW BALANCE" mark since 1951 and the "



" logo since 1970s, establishing significant global goodwill. They argued that the defendants admitted to selling counterfeit goods on their website, targeting the same consumer base. The defendants' actions were deemed a clear case of infringement and unfair competition.

The Hon'ble Delhi High Court observed that the

defendants' admissions and absence of defense highlighted their culpability. Hon'ble Court noted that counterfeiting wears away brand value and misleads consumers, describing it as a serious economic offense. Citing similar precedents, the Hon'ble court emphasized the need for strict action against counterfeiters. The suit was decreed in favor of the plaintiff. The Hon'ble Court permanently restrained the defendants from using the plaintiff's trademarks and awarded actual litigation costs of ₹14,51,670 to the plaintiff, payable by the defendants within eight weeks.

METRO BRANDS LTD. (Plaintiff) vs. NICE SHOES LLP & ORS. (Defendants)

CASE NO. - LA (L) No.14867 of 2024 in COM IPR Suit (L) No.14360 of 2024

DECIDED ON - November 18, 2024

Plaintiff, a leading footwear retailer, filed a suit against Defendants alleging trade mark infringement and passing off. The Plaintiff contended that the Defendants' use of the mark 'DESIMOCHI' and the domain www.desimochi.com was deceptively similar to its well-known

'MOCHI' "  "

mark, in use since 1977, for identical goods and services. The Plaintiff argued that such usage was likely to confuse consumers and harm its reputation. The Defendants countered that their website operated as a shoe aggregator and that the prefix 'DESI' in 'DESIMOCHI' distinguished their mark from the Plaintiff's trade mark.

The Hon'ble Bombay High Court observed that the Defendants' adoption of 'DESIMOCHI' demonstrated dishonesty, noting that the addition of the generic prefix 'DESI' did not remove the actionable similarity between the marks. It emphasized that the core element 'MOCHI' of the Plaintiff's trade mark remained intact in the Defendants' version, thereby causing a likelihood of consumer confusion. The Hon'ble Court further held that such dishonest use could tarnish the Plaintiff's goodwill and reputation.

Acknowledging the Plaintiff's strong prima facie case, the Hon'ble Court granted an injunction restraining the Defendants from using the 'DESIMOCHI' mark or any deceptively similar variant. Additionally, it declared the Plaintiff's 'MOCHI' trade mark as a well-known mark under Section 2(1)(zg) of the Trade Marks Act, 1999.



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