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MIDDLE EAST – ASIA – AFRICA

# AVIP

Newsletter

Issue 19

July 2024

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By  
Divyendu Verma  
Global Head of Patents Practice

## DELHI HIGH COURT DEMANDS CLEAR JUSTIFICATION FOR REJECTIONS OF COMPUTER-RELATED INVENTIONS

The Delhi High Court, in the case of Microsoft Technology Licensing, LLC vs Assistant Controller of Patents and Designs [C.A.(COMM.IPD-PAT) 185/2022], emphasized the significance of Section 3(k) of the Patents Act, 1970. This section dictates that a patent must demonstrate a specific technical effect or enhancement beyond general computing processes when implemented on a general-purpose computer.

### Background

MICROSOFT TECHNOLOGY LICENSING, LLC appealed against the Controller's decision dated May 23, 2019, which refused their patent application (3304/DEL/2005) titled "Reversible 2-Dimensional Pre-/Post-Filtering for Lapped Biorthogonal Transform." The refusal was based on the claims falling under Section 3(k) of the Act, deeming them unpatentable.

### Arguments By Microsoft

Microsoft's counsel argued that the patent addresses inefficiencies in encoding 2D digital media data through a novel application of a one-dimensional lapped overlap operator. This method partitions the 2D data into macroblocks, applies a reversible 2D overlap operator, and uses a reversible 2D block transform, resulting in a highly efficient compressed bitstream. The counsel emphasized that this approach minimizes redundancy and is suitable for both lossless and lossy compression.

Additionally, Microsoft's counsel contended that the Controller erroneously relied on outdated 2016 CRI Guidelines, which required novel hardware for patentability in computer programs. These guidelines were replaced in 2017, eliminating the novel hardware requirement.



Image courtesy: [www.sciencenews.org](http://www.sciencenews.org)

### Respondent's Argument

The Respondent argued that the patent application merely involves a computer program in C-language, thus falling under Section 3(k) and being non-patentable. They claimed that if the technical contribution resides solely within the computer program, it is not patentable.

### Court's Analysis And Decision

The Court acknowledged that the invention enhances encoding and decoding efficiency using lapped transforms, addressing both technical and practical limitations. It noted that the Controller erred by applying the 2016 CRI Guidelines, which had been replaced by the 2017 Guidelines removing the novel hardware requirement. The Court cited previous cases, such as *Raytheon Company vs. Controller General of Patents and Designs and Lava International Ltd. vs. Telefonaktiebolaget LM Ericsson*, to establish that inventions improving system functionality and offering technical advancements are patentable, even if they incorporate algorithms or instructions.

The Court concluded that Microsoft's patent application integrates complex mathematical transformations into hardware components, enhancing digital media data compression. This integration significantly improves system performance and efficiency, thereby meeting patentability criteria.

### Conclusion

The Court ruled that Microsoft's patent application should be granted, as it satisfies the requirements of novelty and inventive step. It reiterated that inventions enhancing system functionality and solving technical problems can be patentable, even if they involve computer programs. The ruling highlights the importance of demonstrating a clear technical effect or enhancement to avoid rejection under Section 3(k) of the Patents Act, 1970.

## Our Take

It appears that the patent office may not always have the necessary expertise to accurately judge the nuances of technology and innovation. Decisions might sometimes rely strictly on rules and regulations rather than a comprehensive understanding of the subject matter. While adherence to rules is crucial, it is equally important to apply a thoughtful and informed approach, which requires specific skills, domain knowledge, and expertise that the patent examiner/ controller may lack.

If we follow the logic behind certain rejections, it could mean that patents improving existing software functionalities or creating new ones might be universally rejected simply because they utilize existing programming languages, such as C Language, on standard computers.

If this approach by the patent office were upheld, it could pose significant challenges by potentially rejecting any innovation that aims to enhance current systems. This could inadvertently hinder the grant of patents that contribute to technological advancements.

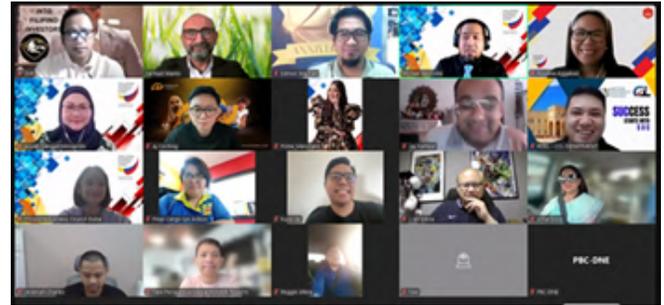
## INSIGHTFUL WEBINAR ON INTELLECTUAL PROPERTY PROTECTION HELD BY PHILIPPINES BUSINESS COUNCIL

On June 28, 2024, the Philippines Business Council hosted an enlightening webinar on intellectual property protection in Dubai, featuring an address by our Managing Partner, Sarmad Hasan Manto. The well-attended event provided valuable insights into the crucial aspects of safeguarding intellectual property (IP) and was met with enthusiastic participation from the members of the Council.



During the webinar, Sarmad delivered an engaging presentation titled "The Need for Intellectual Property Protection: Do's & Don'ts." The discussion encompassed various forms of IP protection, including patents,

trademarks, industrial designs, and copyrights. Sarmad emphasized the importance of IP protection in fostering innovation and economic growth, outlining practical strategies for effectively commercializing intellectual property.

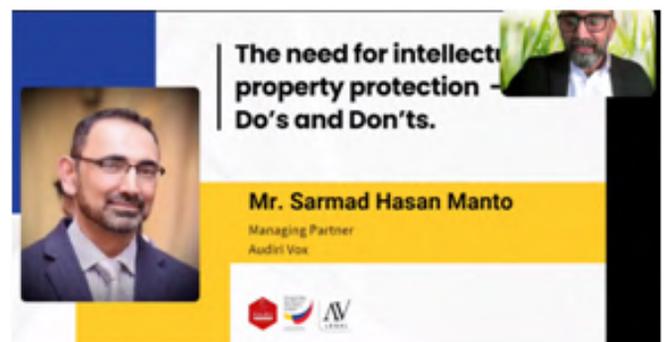


A key highlight of the presentation was the focus on the commercialization of IP, offering attendees actionable advice on leveraging their intellectual assets for business success. Sarmad's expertise and insights resonated with the audience, sparking a lively discussion and providing attendees with a deeper understanding of IP protection's critical role in today's competitive market.



We extend our heartfelt gratitude to the Philippines Business Council for organizing this informative webinar and to all participants for their active engagement. The event underscored the significance of robust IP protection and its impact on business development, reinforcing our commitment to supporting innovation and creativity.

For further details or personalized guidance on intellectual property protection, please feel free to reach out to us at [global@audirivox.com](mailto:global@audirivox.com).



## BEIJING IP COURT UPHOLDS NOVO NORDISK'S SEMAGLUTIDE PATENT, OVERTURNING CNIPA RULING

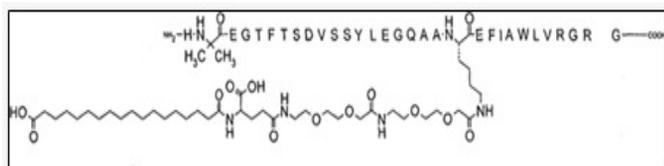


By  
Priti More  
Head of Life Science Department

In an unbelievable turn of event in China, the Beijing IP Court sided with Novo Nordisk, asserting that the original patent disclosure sufficiently supported the idea that semaglutide had a long duration of action.

On September 5, 2022, the China National Intellectual Property Association (CNIPA) declared one of Novo Nordisk's significant semaglutide patents (ZL 200680006674.6) in China invalid (Order No. 57950 of 2022). The challenge was brought by Hangzhou Zhongmei Huadong Pharmaceutical Co., Ltd. (Huadong), a Chinese pharmaceutical company that already markets a generic version of liraglutide (cheaper versions of blockbuster obesity drugs), another GLP-1 receptor agonist originally developed by Novo Nordisk.

The CNIPA argued that Novo Nordisk's patent lacked actual experimental data,



making it challenging to confirm that all the compounds exhibited the claimed surprising technical effects.

The contested claims involved a single compound (semaglutide), compositions containing the compound, and preparations of a medicament including the compound for treating various medical conditions (e.g., hyperglycemia, diabetes, IBD, etc.). The patent disclosure outlined a class of compounds effective as GLP-1 receptor agonists, detailing 22 specific example compounds, including semaglutide, along with their preparation methods and characterization data. While the patent described screening studies using db/db mice and minipigs, it did not specify which GLP-1 compound(s) were used.



image courtesy: [www.nbcwashington.com](http://www.nbcwashington.com)

During the invalidation process, all claims were rejected for lack of inventive step (Article 22.3) in light of the closest prior art, liraglutide. Despite the structural differences between semaglutide and liraglutide, the CNIPA contended that their similar structures and mechanisms of action would lead someone skilled in the art to expect similar behavior from semaglutide.

Contrarily, the Beijing IP Court sided with Novo Nordisk, asserting that the original patent disclosure sufficiently supported the idea that semaglutide had a long duration of action. The court highlighted paragraph [0534] in the specification, which stated:

*"[0534] In one aspect of the invention, the 'GLP-1 agonist' has a duration of action of at least 24 hours after administration to db/db mice at a dose of 30 nmol/kg."*

The Beijing IP Court interpreted "the GLP-1 agonist" to refer to the entire class of compounds, suggesting that all compounds (or at least the 22 examples in the specification) had a duration of action of at least 24 hours post-administration. The judge elaborated, "[a]lthough this technical effect is not specifically described as a technical effect of semaglutide, it can be reasonably inferred that semaglutide has this technical effect since it is a specific compound within the scope of protection of the general formula compound." Consequently, since Novo Nordisk only needed to demonstrate semaglutide's improved properties over liraglutide in one aspect (duration of action > 24 hours), the patent was upheld based on the admissibility of post-filing data.

This case is significant for several reasons, including the product's importance, the economic and legal implications of the decision, and the court's clarification of China's stance on post-filing supplemental data.

However, the case is not yet concluded. Huadong has appealed to the Supreme People's IP Court, while the CNIPA has not appealed the decision.

## THE CONSISTENCY TEST & ITS SIGNIFICANCE UPON GLOBAL TRADE



By  
Abdullah Hasan Manto  
Attorney at Law Audiri Vox

The Most Favored Nation (MFN) obligation stands as a cornerstone in the realm of global trade. Embodying the fundamental principles of non-discrimination and equitable commerce, the MFN promotes global economic growth through equalizing opportunities of trade. Article I:1 of the GATT 1994 establishes a four-tier test of consistency which requires *'any advantage, favour, privilege, or immunity granted by any member to any product originating in or destined for any other country shall be accorded immediately and unconditionally to the like product originating in or destined for the territories of all other members.'* This article shall comprehensively examine the consistency test by critically analyzing each of its elements and their significant impact on global trade.

The first element of the consistency test requires that the measure in question is 'covered' under Article I:1. The scope of these measures include both border related and internal measures concerning any product originated in or destined for another country. Although the range of measures covered under Article I:1 has been widely construed, this scope is not unlimited. In *EC-Commercial Vessels (DS301)* the panel clarified measures 'covered' were contingent upon the substantive legal content of relative provisions, excluding measures which fell outside certain obligations. Some concerns have emerged regarding the applicability of Article I:1 to safeguard measures, anti-dumping duties, and countervailing duties. Article II of the SG Agreement establishes that the MFN obligation generally covers safeguard measures, however, discriminatory use under specific conditions can be granted as seen in *India-Iron and Steel Products (DS518)*. In the case of anti-dumping duties, Article VI permits their imposition, even if inconsistent with Article I:1, with the requirement for non-discriminatory collection. Similar

provisions under the SCM Agreement permit certain countervailing duties. The wide array of measures covered under Art I:1 and limited exceptions are a critical element in maintaining the integrity of the MFN obligation and preventing discriminatory practices.



Image courtesy: [www.gtreview.com](http://www.gtreview.com)

The second requirement of the consistency test considers if the measure in question has allowed an 'advantage'. Article I:1 defines an advantage as *'any advantage, favour, privilege, or immunity granted by any member to any product.'* Consequently, the scope of what may justify an advantage has been widely construed in WTO jurisprudence with focus being placed on measures which enhance competitive opportunities or impact the commercial dynamics between products originating from different sources. Such a requirement plays a vital role in ensuring equality of trade opportunities amongst WTO members. In *EC-Bananas III (DS27)* the panel defined an advantage as a measure which created more 'favourable competitive opportunities' or influenced the 'commercial relationship amongst products of diverse origins.' The Appellate Body in *Canada-Autos (DS139/DS142)* added to the scope of an advantage by referring to it as a measure granting any advantage, by any member, for any like products, originating in or destined for any other country. This widened the scope of applicability to not only de jure but also de facto discrimination. Although certain doubts have emerged regarding a member's ability to compensate advantages, the panel in *US-MFN Footwear (DS18)* confirmed that the consistency test does not allow 'balancing' less advantageous treatment with more advantageous treatment. Notably, any advantage granted to any country must also be granted to all other members, however the MFN obligation does not require the same advantage to be granted to non member nations. Although this may have been significant in the past, considering that the WTO is currently comprised of 164 members and conducts 98% of global trade it no longer holds as much

importance. The significance of an advantage within the context of the consistency test can be seen in *Colombia-Ports of Entry (DS366)* where the panel concluded that Colombian custom regulations were inconsistent with the MFN obligation as they provided all members with an advantage over Panama. Consequently, Columbia was required to amend their custom regulations to equally affect all members. This depicts the importance of the consistency test in preventing discriminatory measures whilst ensuring an equal trade opportunity for all members. More recently, in *Brazil-Taxation (DS472)* the panel found Brazil to be in breach of their MFN obligation due to their tax reductions on vehicles imported from MERCOSUR nations. Such reductions granted an unfair advantage to vehicles imported from MERCOSUR nations over other WTO members, thus were inconsistent with the second element of the consistency test. The aforementioned disputes depict the instrumental role of the consistency test in upholding the WTO's core principles and preventing discriminatory advantageous treatment. Such principles play a vital role in promoting equitable opportunities of trade fostering global economic growth.



Image courtesy: [www.wto.org](http://www.wto.org)

The third tier of the consistency test only permits the MFN obligation to be applicable amongst 'like products.' The requirement of 'like products' is not only utilized by the consistency test in Article I:1 but also numerous other Articles of the GATT. In *Japan Alcoholic beverages II (DS8)* the appellate body indicated that the accordion of likeness stretches and squeezes dependent upon the specific provision and circumstance in which it is encountered. Consequently, what may be considered a like product under a certain GATT provision may not be considered a like product under another. Although like products are not directly defined in the GATT, numerous precedents have indicated what may constitute as a 'like product.' In *Spain-Unroasted Coffee (L/51315-28S/102)* the panel examined the physical characteristics, end use, and tariff regimes of other members as a criterion to

determine whether different blends of coffee constituted like products under Article I:1. In a present dispute the panel would also consider any other relevant factors such as consumer habits. Due to a lack of recent precedents defining like products within the context of Article I:1 it is useful to consider the numerous authorities under Article III. In *EC-Seal Products (DS401)* the appellate body regarded both Article I:1 and Article III as non-discriminatory measures enforcing equal competitive opportunities. Accordingly, the application of likeness would be similar in both provisions. In *Japan Alcoholic beverages II (DS8)* the panel suggested that 'like products' must be considered narrowly, but the category of the directly competitive or substitutable products is slightly broader. This meant that all like products were also directly competitive or substitutable whereas all directly competitive or substitutable products were not necessarily like products. This was confirmed by the panel in *Canada-Periodicals (DS31)* which held that like products must be narrowly construed as 'directly competitive or substitutable'. The narrowly construed definition of like products within the consistency test signifies the protection of non discrimination ensuring equal competitive opportunities.

The final stage of the consistency test necessitates that any advantage granted by a measure shall be accorded 'immediately and unconditionally' to all other like products, irrespective of origin or destination. While the condition of immediacy has a clear temporal connotation, the requirement of unconditional granting has undergone nuanced interpretation. In *EC-Seal Products (DS401)* the appellate body clarified the concept of unconditionally by suggesting that this requirement does not necessarily prevent nations from implementing any conditions to a measure, however, it expressly prohibits those conditions which incur detrimental consequences on the equal opportunities of like products from any member. Similarly in *US Tuna (DS381)* the appellate body referred to its observations in *EC-Seal Products (DS401)*, emphasizing upon the need to assess whether a measure modifies competitive conditions which ultimately harm like products originating from any other members. The emphasis on equal competitive opportunities, without necessitating a demonstration of actual trade effects, solidifies the preventive nature of the MFN obligation.

In conclusion, the four-tier consistency test of the MFN obligation under GATT is instrumental in safeguarding non-discrimination and equal trade opportunities among WTO members. The dynamic interpretation of terms



like 'advantage' and 'like products' demonstrates the adaptability of the consistency test to evolving trade dynamics. The fundamental objectives of the consistency test and its effect in application underscore the significance of adhering to the core principles of equal treatment in international trade. Despite certain debates and interpretational nuances, the test remains a robust mechanism for upholding the core principles of the WTO and fostering equitable growth of global trade.

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*Abdullah did his LL.B (Hons) from the Middlesex University and is currently an associate at Audiri Vox.*

*Abdullah's practice areas include transactional and contentious work in regulatory compliance, corporate governance, competition, business start-ups, takeovers, mergers and acquisitions, intellectual property, employment & HR. He actively assists local and foreign clients on intellectual property, business and technology start-ups, obtaining licenses & permissions, regulatory compliance, corporate governance, shareholders disputes, mergers & acquisition, drafting & negotiating a variety of agreements, including, franchise and licensing agreements, joint venture & shareholders' agreements and share purchase agreements.*

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## IP UPDATES

### FROM 'INSTABLOCK' TO 'LIVEBAN': UAE'S IP PROTECTION REVOLUTION



The UAE Ministry of Economy has announced significant strides in safeguarding intellectual property (IP) rights within the digital landscape. This progress stems from a newly implemented mechanism developed in collaboration with the Telecommunications and Digital Government Regulatory Authority (TDRA). The initiative aims to establish a secure environment for IP rights holders and promote awareness about accessing content through legitimate channels.

#### KEY IMPACT:

Central to this initiative is the “InstaBlock” program, which swiftly responds to reports of IP rights violations by blocking offending websites. Since its inception, the UAE has successfully blocked 1,117 websites found infringing on IP rights, marking a substantial increase from 62 websites in 2023. This surge underscores the efficacy of UAE strategies and technologies in combatting online piracy. Additionally, the introduction of the "LiveBan" service addresses live streaming copyright concerns promptly.

These efforts are designed to cultivate a secure and dynamic environment for creators, entrepreneurs, and innovators, bolstering the UAE's reputation as a global center for creativity and innovation. The mechanism forms part of a comprehensive IP protection framework comprising 11 initiatives aimed at stimulating innovation and creativity across the nation.

#### ENFORCEMENT:

In a related move to protect IP rights, the UAE has intensified its crackdown on illegal websites, shutting down more than 1,000 sites in recent months. This heightened enforcement is part of the Ministry of Economy's broader campaign to combat unauthorized multimedia content broadcasting.

#### COMMITMENT:

These concerted actions underscore the UAE's commitment to nurturing a secure and ethical digital ecosystem. By safeguarding the rights of content creators

and preserving the economic value of creative works, the UAE ensures a fair digital environment. This proactive approach not only supports creators but also reinforces the country's standing as a global leader in innovation and digital security.

For further information, reach out to Audiri Vox at [global@audirivox.com](mailto:global@audirivox.com).

### QATAR: QATAR - UPDATE: NEW POA REQUIREMENT



The Qatari Intellectual Property Protection Department has recently introduced new requirements for Powers of Attorney (POA) as outlined in Circular No. 5/2024 dated June 25, 2024. One of the key changes is that POAs legalized abroad by the Qatari embassy must now be further attested by the Ministry of Foreign Affairs of Qatar. Additionally, if the POA is not in Arabic, it must include a certified Arabic translation to meet the new standards.

Another significant update is regarding the notarization and validity period of POAs. Any POA that is older than three years now requires a stamp from either a notary public or the Ministry of Justice. These new requirements aim to enhance the authentication process and ensure the validity of legal documents used in Qatar.

### QATAR - CHANGE IN PRACTICE: CLARAFICATION ON ACCUMULATED RENEWALS FOR PATENTS



Following our update on June 5, 2024, concerning official circular No. 2/2024 on patent annuity payments, we inform you of a supplementary circular issued by the Intellectual Property Department of the Ministry of Commerce and Industry.

Previously, guidelines permitted patent applicants or their representatives to defer patent annuity payments if the examination process exceeded three consecutive years for both national and PCT applications. These deferred annuities were payable upon issuance of either an acceptance or grant decision. However, the new communication supersedes this provision. To streamline administrative processes and ensure thorough examinations, the department now mandates that patent annuity payments cannot be made if no acceptance or grant decision is issued within three years from the filing date, meaning no action has been taken regarding the patent. This revision aims to enhance the efficiency of the examination process and ensure comprehensive patent examination reports.

**QATAR – REDUCTION IN OFFICIAL FEES FOR VARIOUS SERVICES**



The Ministry of Commerce and Industry in Qatar has announced Ministerial Decision No. 60 for 2024, which introduces reduced fees for certain services within the commerce, industry, business development, and consumer protection sectors. This initiative aims to foster economic growth, attract investment, and enhance the business climate in the country. The new fees will come into effect the day after their publication in the official gazette.

This decision is based on a thorough assessment of the business environment and the needs of investors by the Ministry. The fee reductions apply to a wide range of services, including commercial registration, licenses, corporate services, investment business services, auditors, intellectual property rights, patents, and industrial development licenses.

**SAUDI ARABIA:  
SAUDI ARABIA: STRENGTHENING IP COLLABORATION WITH JAPAN**



Saudi Arabia and Japan have recently enhanced their cooperation in the field of intellectual property (IP) through a bilateral meeting between the Saudi Authority for Intellectual Property (SAIP) and the Japan Patent Office (JPO) on June 2, 2024. This meeting expands upon the 2019 Memorandum of Cooperation (MOC), which initially targeted collaborative efforts in patent examination, human resource development, and raising public awareness about IP rights.

The updated MOC now includes measures aimed at strengthening IP enforcement, with the objective of promoting innovation and economic growth in both nations. These measures will encompass joint training programs for IP enforcement officers, the creation of shared databases to monitor IP infringements, and public campaigns designed to educate businesses on protecting their intellectual property.

Saudi Arabia is committed to developing a robust IP system and recognizes the critical role of intellectual property in driving the country's economic development.

**BAHRAIN:  
BAHRAIN JOINS PATENT PROSECUTION HIGHWAY AGREEMENT WITH CHINA**



The Ministry of Industry and Commerce (MOIC) of Bahrain has entered into the Patent Prosecution Highway (PPH) pilot program with the China National Intellectual

Property Administration (CNIPA), marking a notable advancement in fostering innovation and expediting the patent examination process.

According to the MoU, the China-Bahrain PPH pilot program commenced on May 1, 2024, and will continue for five years until April 30, 2029. This program allows applicants who receive a positive ruling on patent claims from either MOIC or CNIPA to request accelerated prosecution of corresponding claims in the other office during the examination stage, leveraging the work already completed by the other office.

**GHANA:  
GHANA: IMPLEMENTS THE ARIPO ARUSHA PROTOCOL**



Ghana has officially ratified the ARIPO Arusha Protocol for the Protection of New Varieties of Plants, joining Rwanda, São Tomé e

Príncipe, and Cape Verde. The ratification sets the stage for the Protocol's implementation on November 24, 2024, strengthening the legal framework for safeguarding plant breeders' rights in the region.

Adopted in 2015, the Arusha Protocol aims to protect new plant varieties and promote agricultural innovation through a comprehensive intellectual property framework. ARIPO (the African Regional Intellectual Property Organization) harmonizes IP laws across its 21 member states, enhancing regional cooperation and economic development. Ghana's ratification underscores the critical role of robust IP protection in advancing agriculture and supporting the innovations of plant breeders.

**ARIPO:  
ARIPO SIGNS PPH AGREEMENT WITH CHINESE PATENT OFFICE:**



The African Regional Intellectual Property Organization (ARIPO) and the China National Intellectual Property Administration (CNIPA)

have launched a bilateral Patent Prosecution Highway (PPH) pilot program, effective from June 8, 2024, for a five-year trial period. This program allows for accelerated examination of patent applications. If an application's claims are deemed patentable by CNIPA,



the applicant can request an expedited examination at ARIPO, and vice versa.

Applicants can request accelerated examination in China if their corresponding ARIPO patent application has one or more claims deemed patentable by ARIPO. This opportunity is open to all applicants with an ARIPO patent application, not just Chinese or African applicants. Similarly, Chinese applicants can request accelerated examination at ARIPO if their Chinese application has one or more claims deemed patentable by CNIPA.

Since the inception of the first PPH pilot in November 2011, CNIPA has established PPH cooperation with patent examination agencies in 32 countries or regions.

basis. Defendant No.1 claimed that theirs and Plaintiff's products are aurally different and are prescription drugs hence would cause no problem to consumers.

The Hon'ble Bombay High Court relying on test established in Cadila Health Care Ltd. (Supra) by Supreme Court, held that Defendants and Plaintiff's drugs are both anti-diabetic medications and might sound similar to physicians phonetically as several times the names of medicines are either told to them on call or written in handwriting, which is hard to understand, hence this would be very harmful to public health. Hence, ad-interim relief was passed in Plaintiff's favor.

**DOMINOS IP HOLDER LLC & ANR. (Plaintiffs)  
vs. M/S MG FOODS & ANR. (Defendants)**

**Case No.: CS(COMM) 517/2024, I.A. 31610/2024  
Decided On: May 31, 2024**



The present suit is filed by Plaintiffs seeking decree of permanent injunction restraining Defendant No.1 and all those acting for and on their behalf from promoting, selling, marketing, packaging any product or material using, depicting and displaying in any manner in the marks,



“DONITO's”, or any other mark which is identical or deceptively similar to the plaintiffs' registered trademarks.

Plaintiffs have been the first and prior adopter of the mark “DOMINO'S” since the year 1965, and now conduct operations in more than 90 countries, with over 20,500 stores. The Plaintiffs' initial adoption of the said mark is arbitrary, as it has no meaning or significance in relation to pizza or fast-food restaurants, whereas Defendant No.1 is operating in various regions of Punjab with six outlets located at Jalandhar, Nakodar, Goraya and Mehatpur using the impugned mark.

Defendant No. 1 also applied for registration of the impugned mark which was Accepted and Advertised in the TM Journal and was further opposed by the Plaintiffs. The Hon'ble Delhi High Court held that the Plaintiffs were successful in making a prima facie case for grant of an ex-parte ad interim injunction till the next date of hearing. Balance of convenience also lied in favor of the Plaintiffs. The court further ordered them to take down all the listings on YouTube and LinkedIn using the impugned mark by Defendant No. 1.

## INDIA: TRADE MARKS CASES



**GLENMARK PHARMACEUTICALS LTD.  
(Applicant /Plaintiff) vs. GLECK PHARMA  
(OPC) PVT LTD. & ORS. (Respondents /Defendants)**

**Case No.: INTERIM APPLICATION (L)  
NO. 30450 OF 2023 IN COMMERCIAL IP SUIT  
(L) NO.30149 OF 2023  
Decided On: June 13, 2024**



The Plaintiff is seeking ad-interim relief through this suit against the defendants for infringing its registered trade mark and passing off. Plaintiff

is a company engaged in the business of inter alia manufacturing, marketing and selling pharmaceutical and medicinal preparations. One of the Plaintiff's products is an anti-diabetic drug sold under the registered trade mark “ZITA-MET, Plaintiff has also applied for and secured trade mark registration for the word mark “ZITA-MET” and ZITA-MET formative trade marks in Class 5 and has been continuously using the said since 2013.

In August 2020, the Plaintiff came across the impugned trade mark application filed by Defendant No.1 before the Trade Marks Registry for the impugned trade mark “XIGAMET” in respect of Class-5, on proposed to be used



**INDEPENDENT NEWS SERVICE PRIVATE LTD & ANR. (Plaintiffs) vs. RAVINDRA KUMAR CHOUDHARY & ORS. (Defendants)**

Case No.: CS(COMM) 498/2024, I.A. 31295/2024  
Decided On: May 30, 2024



This application has been filed under Order XXXIX Rules 1 and 2 of CPC as part of the accompanying suit seeking a decree of permanent injunction restraining defendants and all those acting for and, on their behalf, from using the

mark/logo '  (the impugned mark) and "Baap ki Adalat" or any other trademark/logo deceptively similar to the trademark/logo of the plaintiff viz.



इंडिया टीवी and "AAP Ki Adalat" and other attendant relief. Plaintiff no.1 company was incorporated in the year 1997 by its Chairman and Editor-in-Chief Rajat Sharma, who is plaintiff no.2, whereas defendant no.1, who is a self-proclaimed political satirist creating and publishing various video audio content on social media. Plaintiffs are aggrieved by the deceptively similar impugned mark, being used by defendant no.1, including one of the principle and popular programs "AAP KI ADALAT".

Plaintiffs presented a list of their registered trademarks, cases held in their favor and an evaluation of similarity between defendants broadcasting compared to the Plaintiff's.

The Hon'ble Delhi High Court held in favor of the Plaintiff, as the balance of convenience lied with them and also, Plaintiffs having established a prima facie case for grant of ex parte ad-interim injunction.

The Hon'ble court further acknowledged that trade marks in different classes do not infringe upon each other's exclusive rights, the court effectively narrowed the application of Section 28 (3) of the Act to scenarios within the same class.

**KRBL LIMITED (Plaintiff) vs. JOHN DOE & ORS. (Defendants)**

Case No.: CS(COMM) 416/2024  
Decided On: May 20, 2024



The Plaintiff in the present suit is seeking an ad-interim ex-parte injunction against Defendant No. 1, unauthorized websites allegedly perpetrating financial fraud on the general public using the Plaintiff's registered trademark.

The Plaintiff is amongst the leading global manufacturers and sellers of rice and allied products such as, quinoa, chia seeds, and flax seeds etc. under the trademark "INDIA



GATE/ The wordmark "India Gate" registered in Class 30 has been in use since 1979 and is also a well-known trademark as recognized by the Trade Mark Registry.

In January 2024, the Plaintiff received multiple complaints from consumers bringing to their knowledge a fraudulent investment scheme being run by Defendant No. 1 using the Plaintiff's trademark "INDIA GATE." The defendant no.1, forged distributorship agreements in the name of the Plaintiff, created fake links, YouTube channels, WhatsApp and telegram channels and a fake website, using the Plaintiff's well known trade mark and fake information and customer support email IDs, in order to promote their fraud schemes to innocent consumers, who lost a lot of money to Defendant No. 1 believing them to be the Plaintiff.

The Hon'ble Delhi High Court held in favor of the Plaintiff, as prima facie, such use of the Plaintiff's well-known mark is detrimental to its distinctive character thus, constitutes infringement under Section 29(4) of the Trademarks Act. The court further ordered the Defendants to block all the channels of YouTube, WhatsApp and Telegram as well as the fake websites.

**M/S VANS INC. USA (Petitioner) vs. FCB GARMENT TEX INDIA ( P) LTD. AND ANR. (Respondents)**

Case No. : C.O. (COMM.IPD-TM) 161/2021  
Decided On: May 02, 2024



The petitioners originally filed the rectification/cancellation based on deceptive similarity of Respondent's impugned trade mark(s) "IVANS" and "IV ANS NXT" with Petitioner's well-known trademark



"VANS/ " further seeking removal of the said impugned trade marks (s) from the Trade Mark Register under IPAB (Intellectual Property Appellate Board), the said petition was transferred to Delhi High Court in 2021, pursuant to abolition of the said Board.

Petitioner "VANS" is a known brand amongst skateboarders for their sporting items mainly shoes, since 1970s in USA, their products in India were only launched in 2011 for which they sought registration of the trademark "VANS" in 1992 on proposed to be used basis which was only accepted in 2005, whereas the



Respondent no. 1 only deals with men's apparels throughout India and have claimed prior use since 1999. Petitioner has also been granted status of "Well-known trademark" in India vide Journal No. 2144 dated 19th February, 2024.

The Hon'ble Delhi High Court held that, while the petitioner had applied in 1992 and the respondent no.1 had applied in 2002, the petitioner had not launched the products in the market till 2011. Therefore, the actual user in the market would have to be considered as per the "FIRST IN THE MARKET" test established in Neon Laboratories (supra) case by the Supreme Court.

The court further noted that, petitioner filed the cancellation petition 16 years after registration of respondent no.1's mark and did not oppose the said impugned trade mark even once in the past. Hence, rejecting the petition, concluded that declaration of a well-known trademark cannot give an automatic, unabridged, and unmitigated right to a proprietor to apply for rectification of all the marks which have subsisted on the Register for years prior and in different classes.

## PATENTS CASES

HONEYWELL INTERNATIONAL INC (Appellant)  
vs. THE CONTROLLER OF PATENTS (Respondent)

Case Number: C.A.(COMM.IPD-PAT) 396/2022  
Decided on: May 21, 2024

**Honeywell** The present appeal has been filed by the appellant against an order for refusing the appellant's patent application no. 3150/DELNP/2010 titled "Organic Fluorescent Compositions". Objection were raised in the First Examination Report (FER) that the invention lacks inventive step under Section 2(1)(ja), and non-patentability under Sections 3(d) and 3(e) of the Patent Act. The appellant submitted the reply to the FER along with the amended set of claims, to which the hearing was fixed objecting to the amended set of claims under Section 3(e) of the Act. The appellant submitted written submission along with the fresh set of amended claims from 'composition comprising a compound' to just 'the compound'. The respondent rejected the amended claims objecting that the claims were beyond the scope of the originally filed claims and non-patentable under section 3(e).

The appellant argued that respondent has not issued separate hearing for the objection regarding amended claims before refusing the claims being beyond the scope in view of section 59. The appellant also argued that the invention described both composition and compound, yet

the respondent had wrongfully concluded and passed the impugned order. The respondent refused the same and stated that the specification of the invention indicated composition in subsequent para and, therefore the amendment to a compound could not have been allowed.

The Hon'ble Delhi High Court observed that the amended claim was the subset of the original claim and that it does not contain any matter out of the original claim or specification. The Hon'ble Court set aside the impugned order and directed for fresh consideration of the subject application along with the proposed amendment by the appellant.

INCYTE HOLDINGS CORPORATION & ORS.  
(Plaintiffs) vs. ALEMBIC PHARMACEUTICALS  
LIMITED (Defendant)

Case Number: CS(COMM) 495/2024 &  
I.As. 31168-31173/2024  
Decided on: May 30, 2024



The present suit has been filed as a *quia timet* action, by the plaintiff against the infringement of the Indian Patent No.

IN269841 which protects the novel and inventive compound 'Ruxolitinib'. The plaintiff states that the drug 'Ruxolitinib' is a new chemical entity which has been given an International Non-Proprietary Name (INN) by the World Health Organisation (WHO). The plaintiff further states that the invented compound 'Ruxolitinib' is marketed and sold in India and many other countries under the brand name 'JAKAVI®' and the defendants are infringing by engaging in manufacture and sell of the same patented compound 'Ruxolitinib'. The defendant's states that they do not intend to commercialize any product containing the patented product 'Ruxolitinib' during the validity of the suit patent. And the defendants also requested the Court to protect their rights under Section 107A of the Patents Act, 19702, to use 'Ruxolitinib' for the purposes of research.

The plaintiff agrees to the suit being disposed of by binding the Defendant statement and the plaintiff also do not wish to claim any monetary relief from the defendant. The rights of the defendants under Section 107A of the Act are protected as long as the conditions required under the said provision are fully complied with by the Defendants. Hence, the issue was resolved on consent terms and the request by the plaintiff for full refund of Court fees is accepted.



Indian Institute of Technology (IIT Madras) (Appellant) vs. (1) The Controller of Patents & Designs; (2) The Assistant Controller of Patents & Designs; (3) The Examiner of Patents & Designs (Respondents)

Case Number: (T) CMA (PT) No.52 of 2023  
(OA/56/2020/PT/CHN)  
Decided on: June 11, 2024



The current appeal has been filed by the appellant under the provision of Section 117A of the Patent Act, 1970 for rejecting the patent application no. 4032/CHE/2013 titled “METHOD OF DOPING POTASSIUM INTO AMMONIUM PERCHLORATE”. The Application was refused under Sections 2(1)(ja), 3(d) and 3(a) (i.e. invention is frivolous) of the Patents Act.

The appellant argued that the objection regarding Section 3(a) of the Patents Act, was introduced for the first time in the refusal order and the appellant has not given opportunity to respond to the objection. The appellant further argued that the invention is a mere new use of a known process and usage of the specific filtrate material as a reactant is itself a novelty in the invention, therefore objection of Section 3(d) cannot be a ground for refusal. Furthermore, the appellant argued that the use of filtering material by eliminating the use of external reagents that results in a new product originates an inventive step under Section 2(1) (ja) of the Patents Act, also the prior art D1 does not disclose or render the invention obvious. The respondent argued that the appellant has given an opportunity to respond in the hearing for the objection under Section 3 (a). Further, the respondent argued that the process involved in the invention is a conventional process and a part of common general knowledge, therefore the invention is excluded from patent protection under Section 3(d) and the steps involved in the invention cannot be said to constitute a technical or economic advancement under Section 2(1)(ja) of the Patents Act. The respondent concluded by submitting that that the claimed invention does not even satisfy the requirements of an 'invention' under Section 2(1)(j) of the Patents Act.

The Hon'ble Madras High Court observed the following matter and stated that the respondent had not raised an objection on the ground of frivolousness Section 3(a) of the Patent Act in FER and hearing notice, it was directly issued for the first time in refusal order, therefore this specific order cannot be sustained, and the claimed invention is also susceptible of industrial applicability. Further the Court observed that the cited prior art D1 involves similar process, and the resultant product is also a variant of the one in D1 as compared to the appellant's invention, so the claimed invention is refused under Section 3(d) of the Patents Act and due to lack of experimental data and economic significance the claimed invention also lacks an inventive step under Section 2(1)(ja) of the Patents Act. Hence, the Hon'ble Court

upheld the rejection of the appellant invention on the ground of Sections 3(d) and 2(1)(ja) of the Patent Act.



## DESIGN CASE

Pidilite Industries Limited (Plaintiff) vs. Astral Limited (Defendant)

Case Number: INTERIM APPLICATION (L) NO.13706 OF 2024 IN COMMERCIAL IP SUIT (L) NO.13638 OF 2024  
Decided on: June 13, 2024



In the present case, the plaintiffs had filed an application to restrict the defendants from infringing plaintiffs design of Coex plastic containers used for storing products. The plaintiff claims to be the first in industry to make this transition to Coex plastic containers and design containers for the M-SEAL PV SEAL products that could be applied to different variants. The plaintiff alleged that the defendant is infringing the plaintiff's design, copyright and the defendant is also passing off their goods as the plaintiff's goods by imitating the plaintiff's brand /product, thereby misleading public. The plaintiff further argued that as per Section 2(d) of the design act, their design satisfies all the requirements of the definition of a design and is also a registrable design. The defendants argued against the protectability under Section 19(1)(e) of the Designs Act because it is not a design as defined under Section 2(d) as the plaintiff's design is not appealing to the eye. The defendant had also cited prior art questioning novelty or originality of the plaintiff's design.

The Hon'ble Bombay High Court decision lies in favour of plaintiff. The Hon'ble Court referred to Section 2(d) of the Designs Act defining design “*design*” means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye” as per the observation the design must appeal to the eye as a whole. The Hon'ble Court also found substantial difference while comparing the plaintiff's design with the prior art. The Hon'ble Court concluded that plaintiff had made out a prima facie case for grant of ad-interim reliefs, if the plaintiff's application is not granted then the defendant would continue to use the design causing loss and harm to the plaintiff. Hence, the Court restrained the defendant from infringing the plaintiff's right in the registered design by any form and granted an interim injunction in favour of plaintiff.



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This Newsletter is published by Audiri Vox at 309 Churchill Tower Business Bay, P.O. Box 415116 Dubai-United Arab Emirates on 8th July, 2024.