



AUDIRI VOX

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MIDDLE EAST – ASIA – AFRICA

AVIP

Newsletter

Issue 4

June 2023

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Adv. Divyendu Verma

REVAMPING THE EVALUATION OF COMPUTER RELATED INVENTIONS: DELHI HIGH COURT'S CALL FOR A COMPREHENSIVE APPROACH

Recognizing the dynamic nature of Computer Related Inventions (CRIs) and the challenges they pose in determining their technical effects and contributions, the Delhi High Court has directed the Indian Patent Office to adopt a more comprehensive approach when assessing such inventions (c.f. *Microsoft Technology Licensing, LLC v. The Assistant Controller of Patents and Designs*; C.A. (COMM.IPD – PAT) 29/2022). In its judgment, the court emphasized the importance of considering the technical effects and contributions provided by an invention, rather than focusing solely on the implementation of algorithms and computer-executable instructions.



Courtesy: Image by Freepik

Justice Sanjeev Narula, sitting as a Single-Judge Bench, remarked, “*The Indian Patent Office must also provide examiners with indicators by citing an exhaustive list of worked examples related to patent eligibility. These practice hints will assist examiners in maintaining consistency by distinguishing eligible cases from ineligible ones.*”

This appeal focused on the interpretation of the phrase “computer program per se” in Section 3(k) of the Patent Act, 1970, which lists subject matter excluded from patentability. Microsoft Technology Licensing, LLC had filed a patent application for “methods and systems for authentication of a user for sub-locations of a network location”. However, the patent application was refused on the basis that it constituted “computer programs per se”, which is considered a non-patentable subject matter under Section 3(k) of the Act. The Assistant Controller concluded that the invention was merely a set of computer instructions or algorithms.

The Patent Office issued a First Examination Report (FER) raising objections based on lack of novelty, lack of inventive step, and non-patentability under Section 3(k) (computer program per se). Following a hearing, the Controller issued an order rejecting Microsoft's application under Section 15, deeming the claimed invention is non-patentable under Section 3(k) and citing other unmet requirements under the Act. Microsoft challenged this order before the Hon'ble Delhi High Court.

Section 3(k) includes the phrase “computer programs per se” and outlines the categories of subject matter not considered inventions under the Indian patent law. The Delhi High Court opined that summarily rejecting a patent application solely based on the fact that the claims are implemented on a computer and involve computer-executable instructions or algorithms is not the correct approach. The Bench held that the Controller had erred in overlooking the interpretation of “per se” under Section 3(k).

In its judgment, the Court emphasized that the assessment of whether a Computer Related Invention (CRI) should be granted a patent should focus on the technical effects and contributions provided by the invention, rather than solely on the implementation of algorithms and instructions. The Court recognized that Microsoft's invention offered a technique for authenticating users and improving security by

preventing unauthorized access to sub-locations on a network. Consequently, the court set aside the Assistant Controller's order and directed a re-examination of Microsoft's patent application within one month, taking into account the tests of novelty, inventiveness, and prior art.

The Court further recommended that the Patent Office/CGPDTM (Controller General of Patents, Designs, and Trademarks) establish signposts and take appropriate action to examine this issue promptly. As the Court further noted that the technical aspects of the invention, such as the use of cookies and two-factor authentication, were fundamental to the functioning of computer networks and extended beyond the user interface. Consequently, it would be incorrect to exclude the claimed invention on the basis of being limited to the user interface. These technical aspects provide a significant contribution to the technical field.

Further, the Court identified a misinterpretation of Section 3(k) by the Controller, who had focused solely on the implementation of the invention using computer-executable instructions and algorithms on a general-purpose computing device. This approach had neglected to consider the true technical nature and advancements provided by the invention.

According to the Bench, the claimed invention offered a novel and inventive technical solution to a security problem related to user authentication for accessing sub-locations within a network. It not only introduced a two-tier authentication process but also improved the user experience, which holds significant importance in the field of computer networks.

Setting aside the findings in the impugned order regarding Section 3(k), the Court concluded that the subject patent passed the first step and did not fall within the excluded categories. Further, as mentioned above, the Court ordered a re-examination of Microsoft's patent application with regard to objections on lack of novelty and inventive step in view of other cited prior art.

Further, the Court emphasized the need for the Indian Patent Office to adopt a more comprehensive approach when assessing CRIs. This approach should consider the technical effects and contributions provided by the invention, rather than solely focusing on the implementation of algorithms and computer-executable instructions.

Additionally, the Court highlighted the need for clarity in the CRI Guidelines which was last revised in 2017, and urged the Indian Patent Office to provide examples of both patent-eligible and non-eligible inventions within the guidelines. By incorporating such examples, the Court believed that the guidelines would offer reliable guidance to examiners and promote consistency in the examination of patents.

This ruling by the Delhi High Court has significant implications for the patentability of CRIs in India and signals the importance of considering the technical contributions and effects of such inventions. It also highlights the need for the Indian Patent Office to revisit and update the CRI Guidelines to ensure a fair and consistent approach to the examination of CRIs.

Case Reference: Microsoft Technology Licensing, LLC v. The Assistant Controller of Patents and Designs [C.A. (COMM.IPD – PAT) 29/2022], order dated May 15, 2023





Adv. Sphurti Dalodria

THE SIGNIFICANCE OF POSITION TRADEMARKS IN THE PHARMACEUTICAL INDUSTRY

Position trademarks play a pivotal role in safeguarding the unique identity of companies within the pharmaceutical industry. This distinctive form of trademark registration focuses on protecting the exact placement of a logo or design that sets a company's goods or services apart from others. Any alterations to the position can jeopardize the trademark's protection, highlighting the importance of maintaining consistency.



4998469 22/03/2021
[International Registration No. : 1594408]

An illustrative example of a registered position trademark is STADA's logo, a renowned pharmaceutical company. STADA secured trademark protection for the specific

positioning of its logo by applying under the European Union Trade Marks, listed as application no. 018172864. In India, it is registered as a device mark under the Trade Marks Act, 1999, with application no. IRDI- 4998469.

The description of the logo's position is as follows: "The mark consists of three surfaces abutting at one corner of rectangular packaging, each showing a red triangle, with two sides of the triangle lying on the edges that meet at the corner and the third side of the triangle being concave in the direction of the corner; in addition, on the larger area facing the viewer, the word 'STADA' is affixed to the lower right in blue capital letters and enclosed by red arcs; the dashed lines show the box-shaped packaging, which is only used to indicate the position of the red triangles and the word 'STADA' with red arcs."



By opting for a position trademark, STADA strategically registered its logo in a specific position, with defined shape and color. This approach empowers the company to assert exclusive rights over the visual representation of their brand. Position trademarks offer companies substantial benefits, ensuring the preservation of their distinct identity and reinforcing their brand's visual consistency.

As the scope of intellectual property continues to expand in India, registering a trademark's position emerges as a crucial aspect for safeguarding a company's brand identity. This practice not only protects the design itself but also safeguards the exclusive use of the specific and fixed position of the logo or design, providing companies with enhanced brand protection.



IP UPDATES

OVERTURNING TRADEMARK REJECTION: ESTABLISHING DISTINCTIVENESS AND ADDRESSING GEOGRAPHICAL NAMES IN INDIA

The appeal has been filed by the Abu Dhabi Global Market (appellant) against the refusal order of the device mark passed by the Registrar of Indian Trademark Registry (defendant).

The rejection was based on the grounds that the mark appeared to lack originality and failed to demonstrate distinctiveness through evidence of use.



The defendant argued that the term "ABU DHABI" was a geographical name, making the mark as a whole non-distinctive and unsuitable for monopolization. However, the Delhi High Court highlighted that the mark had been adopted in accordance with Federal Decree No. 15/2013, issued by the President of the UAE, which established a financial free zone named "ABU DHABI GLOBAL MARKET."

The Court further emphasized that evidence of use was not necessary to establish distinctiveness, as such an interpretation would hinder the registration of marks based on their proposed use. The Assistant Registrar's decision was deemed not only contrary to the statute but also a display of a lack of application of mind. Consequently, the Court ruled in favor of the appellant, quashing the refusal order passed by the Registrar. The application has been allowed to proceed for advertisement, enabling the trademark registration process to move forward.

This case serves as a significant precedent for trademark applicants in India, highlighting the importance of understanding distinctiveness requirements and the potential implications of geographical names. The decision reaffirms the principle that marks can be registered based on proposed use, eliminating the need for extensive evidence of prior usage.

REDUCTION OF OFFICIAL FEES IN OMAN



The Ministry of Commerce, Industry, and Investment Promotion has taken a significant step towards supporting Intellectual Property (IP) by announcing a reduction in official fees

for various IP services. This welcome development includes a reduction in fees for obtaining a copy of the patent after grant and trademark-related services such as publication fees for trademark applications, renewal fees, trademark assignment recordal applications, trademark licensing, and checking trademark records. These fee reductions came into effect on May 28, 2023, providing relief and encouragement to individuals and businesses engaged in IP-related activities.

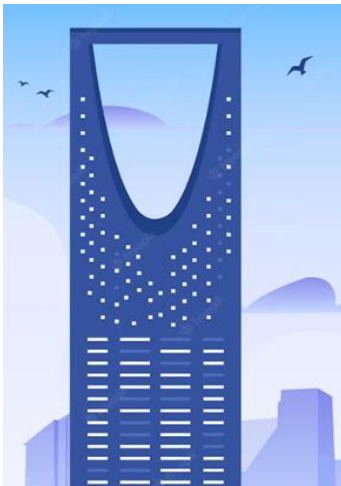
SUBMITTING LEGALISED POA FOR TRADEMARK RENEWAL IS NOT REQUIRED IN UAE:



The Ministry of Economy has simplified the trademark renewal process in the

UAE by removing the requirement of submitting legalized POA. Now, the Ministry of Economy is accepting the trademark renewal applications without a legalized Power of Attorney (POA). Before this, the legalized POA was compulsory at the time of submitting the trademark renewal applications.

CANCELLATION ACTION FOR NON-USE OR BAD FAITH TRADEMARK REGISTRATION IN SAUDI ARABIA:



In case of initiating a cancellation action for non-use or bad faith trademark registration, an initial letter shall be sent to the trademark registrant through an electronic platform of the Ministry of Justice if the information of the trademark registrant is available on the platform, otherwise the letter shall be delivered through a Saudi local law office.

The trademark registrant has to respond within 15 days from the date of receipt of the letter, and after which the cancellation action can be settled. If the trademark registrant fails to respond within the time limit, the cancellation action can be initiated.

RESUMING OPERATIONS OF IP MATTERS BY LEBANESE MINISTRY OF ECONOMY AND TRADE:



After a temporary disruption due to a civil strike by its staff and administration, the Lebanese Ministry of Economy and Trade has successfully resumed operations

for all Intellectual Property (IP) matters from the second week of May, 2023.

LIBYA TRADEMARK OFFICE RESUMES ITS OPERATIONS:



From May 28, 2023, the Trademark Office of the Ministry of Economy and Trading has resumed full operations. Previously, since November 2022, the Trademark Office had been functioning at a limited capacity, processing only IP cases for Libyan citizens and organizations while

temporarily freezing services for foreign applicants. In addition, a new regulation has been implemented, introducing additional requirements for trademark applications. Now, applicants must submit a legalized power of attorney and a company registration document along with their application. It is important to note that the late filing of these documents will only be permitted for applications claiming priority. In such cases, the legalized documents must be submitted within forty (40) days from the date of the application. These measures aim to enhance the efficiency and transparency of the trademark registration process and ensure compliance with the new regulations.



AUDIRI VOX ATTENDED THE INTA ANNUAL MEETING 2023 IN SINGAPORE

The INTA (International Trademark Association) Annual Meeting is a prestigious event that brings together intellectual property professionals from around the world. This report provides an overview of our experience attending the INTA Annual Meeting 2023 in Singapore, representing our firm Audiri Vox. The conference took place from May 16th to May 20th, 2023, and offered a unique opportunity to connect with industry experts, expand professional networks, and gain insights into the latest trends in trademark law and practice.

Attendees:

We had the privilege of attending the INTA Annual Meeting along with our colleagues from Audiri Vox. We were eager to participate in the various sessions, engage in meaningful discussions, and contribute to the intellectual property community.



Representation:

As representatives of Audiri Vox, we joined the event with a strong sense of responsibility to actively contribute and showcase our expertise in trademark law and brand protection. We aimed to promote our firm's commitment to excellence and establish valuable connections with professionals from around the globe.



Conference Highlights:

The INTA Annual Meeting in Singapore proved to be an exceptional gathering of intellectual property professionals. The event provided a platform for knowledge-sharing, networking, and collaboration. Here are some noteworthy highlights:

Intellectual Property Professionals: The conference attracted a diverse range of IP professionals, including attorneys, trademark agents, in-house counsels, government officials, and industry leaders. The opportunity to interact with such a varied group allowed for insightful discussions and the exchange of ideas.



Global Networking: The INTA Annual Meeting served as a melting pot of professionals from different countries, providing an invaluable opportunity to expand our professional networks. We met with like-minded individuals from various jurisdictions, fostering connections that will undoubtedly enhance our global reach and collaborations.

Educational Sessions: The conference offered a comprehensive program with numerous educational sessions covering a wide range of topics in trademark law and practice. Renowned experts shared their insights, providing valuable updates on current industry trends, emerging issues, and best practices. These sessions equipped us with the latest knowledge and strategies to navigate the evolving landscape of trademark law.

Engaging Discussions: The INTA Annual Meeting facilitated engaging discussions through panel discussions, interactive workshops, and Q&A sessions. We actively participated in these conversations, sharing our perspectives, and gaining insights from experienced professionals. These discussions fostered a sense of community and provided a platform for intellectual exchange.

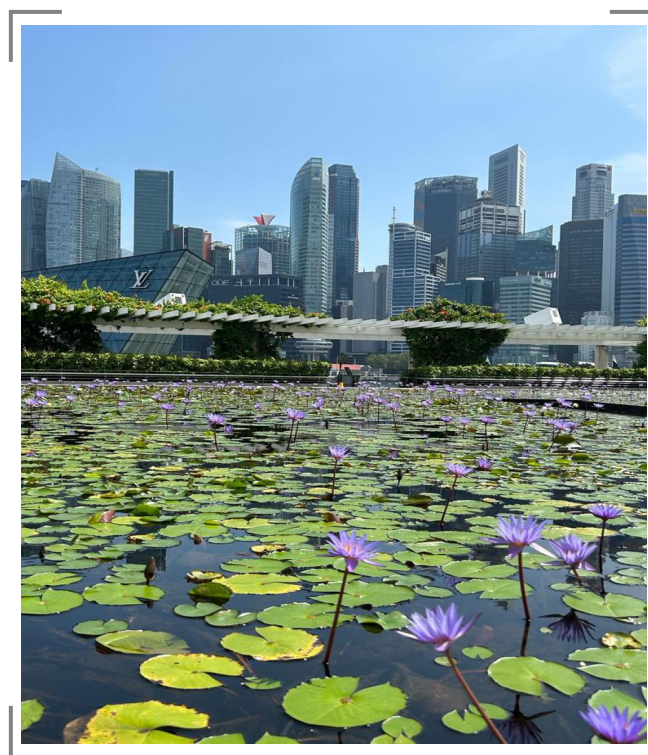
Strengthening Relationships: One of the most rewarding aspects of the conference was reconnecting with old friends and colleagues from previous INTA events. We also had the pleasure of making new connections, strengthening existing relationships, and exploring potential collaborations. The INTA Annual Meeting served as an ideal platform for building lasting professional connections.

Looking Forward:

As we wrap up an incredible experience at the INTA Annual Meeting in Singapore, we are already eagerly looking forward to the next Annual Meeting. The INTA community has become an essential part of our professional journey, and we anticipate the next gathering with great enthusiasm. The upcoming Annual Meeting in Atlanta presents a promising opportunity to continue our professional growth, expand our network, and contribute to the intellectual property community.

NEXT YEAR IN ATLANTA:

Attending the INTA Annual Meeting 2023 in Singapore was an enriching and memorable experience. The conference provided a unique platform to connect with intellectual property professionals from around the world, expand our knowledge, and foster meaningful relationships. We return to Audiri Vox with renewed inspiration, armed with valuable insights and connections that will undoubtedly contribute to our ongoing success in the field of trademark law. The INTA Annual Meeting is a must-attend event for anyone passionate about intellectual property, and we eagerly await the next gathering in Atlanta.





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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 June, 2023.