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INVALIDITY OF A REGISTERED DESIGN BASED UPON COPYRIGHT AND TRADEMARK CLAIMS

In a legal dispute concerning one of our clients, the validity of a Registered Community Design (RCD) came under scrutiny due to alleged infringement of copyright and trademarks. The invalidity applicant (our client) claimed ownership of a blueprint of a cigarette box and a portfolio of trademarks, including marks registered in Romania and Germany. The client argued that the contested design replicated their copyright and trademarks with minor alterations, failing to meet the requirements of novelty and individual character.

The client's arguments rested on a nuanced interpretation of relevant articles within the Community Design Regulation (CDR), particularly Article 25(1)(b) in conjunction with Articles 4(1) and 7. They contended that the contested design had been disclosed to the public before the RCD filing date, as evidenced by its publication in the German Patent and Trade Mark Office database.

Further analysis delved into the concept of individual character, a critical aspect of design protection. The applicant scrutinized the degree of freedom of the designer in developing the contested design, considering constraints imposed by technical functions or statutory requirements. They argued that the contested design lacked individual character as it failed to produce a distinct overall impression from the prior design.

The assessment of the overall impression between the designs was pivotal in determining their validity. The applicant highlighted significant similarities, particularly

in the graphical representation of the cigarette brand and the coat of arms on the packaging. They contended that minor differences in color and additional verbal elements did not diminish the dominant similarities between the designs.

Consequently, the Invalidity Division upheld the applicant's claim, declaring the RCD invalid under Article 25(1)(b) of the CDR. The division ruled that the contested design lacked individual character and failed to create a distinct impression from the prior design, stating that "In the Invalidity Division's view, the designer of the contested design was more than just inspired by the prior design, and he or she has not succeeded in creating a design with its own individual character. The informed user would not perceive the later design differently from the earlier one. The Invalidity Division concludes that the holder did not use the freedom available to the designer to depart from the prior design and to deliver the contested design a different overall impression from that of the earlier design." As a result, the holder of the contested design was held liable for the fees and costs incurred by the applicant in the proceedings.

This case serves as a poignant illustration of the intricate nuances involved in intellectual property disputes, particularly in the realm of design protection. It underscores the necessity for meticulous examination and evidence-based arguments to safeguard the rights of creators and ensure equitable protection for original work.

Furthermore, it underscores the multifaceted nature of design protection, encompassing elements of copyright, trademark, and design rights. By leveraging a comprehensive understanding of relevant regulations and legal precedents, stakeholders can navigate complex legal landscapes with confidence, ensuring fair resolution and upholding the integrity of intellectual property rights.

In conclusion, the case exemplifies the significance of novelty and individual character in determining the validity of a registered design. It underscores the importance of thorough examination and evidence-based arguments in intellectual property disputes, ensuring fair protection for original creations.

IP UPDATES

SAUDI ARABIA:

RECENT CHANGES IN TRADEMARK APPLICATION \ REJECTION PROCESS BY SAIP IN SAUDI ARABIA



The Saudi Authority for Intellectual Property (SAIP) has introduced a revised procedure for managing rejected trademark applications.

Previously, applicants facing a rejection had the choice to either appeal the decision or modify the trademark within a 10-day window. However, the updated policy eliminates this flexibility, mandating that applicants can now only appeal the rejection.

This adjustment is part of SAIP's broader strategy to streamline its operations and enhance the efficiency of its intellectual property management framework. It aims to promote more meticulous and accurate initial applications, potentially reducing administrative bottlenecks and improving the clarity of trademark registrations.

SAUDI ARABIA: EXTENSION OF INDUSTRIAL DESIGN PROTECTION DURATION TO FIFTEEN YEARS

Following the enactment of amended patents, industrial designs, integrated circuits, and plant varieties law No. 197 on September 19, 2023, by the Saudi Authority for Intellectual Property (SAIP), the validity period for industrial designs has been prolonged from ten (10) years to fifteen (15) years. Presently, the 11th annuity fees for active designs filed in 2013 must be paid by May 23, 2024, to avail of the extended protection period.

ALGERIA:

IMPLEMENTATION OF VAT RATE ON OFFICIAL FEES FOR IP SERVICES IN ALGERIA



Please be informed that the Algerian National Institute of Industrial Property (INAPI) has implemented a nineteen percent (19%) Value Added

Tax (VAT) rate on official fees related to Intellectual Property services, following a change in the government's tax system. Consequently, all applicable official fees have been adjusted to reflect this updated VAT rate, effective March 29, 2024, for both existing (pending) cases requiring further payments—although official fees are settled at the time of filing and no additional fees will be due for already initiated actions—and new IP cases.

LEBANON:

LEBANON: REVISION OF OFFICIAL FEES FOLLOWING BUDGET LAW NO. 324



In line with the enactment of Budget Law no. 324, published in the Lebanese Official Gazette on February 15, 2024, a revised fee structure for Intellectual Property Rights services has been introduced with immediate effect.

The new decision also encompasses additional regulations, with key highlights as follows:

Trademark protection duration has been reduced from fifteen (15) to ten (10) years. Consequently, all certificates issued henceforth will indicate a protection period of ten (10) years. However, trademarks registered or renewed before the implementation of this decision will retain the previous 15-year term until their subsequent renewal, after which they will transition to the 10-year term.

Penalty fees will be enforced for any delay exceeding two months in services related to license agreements.

The updated regulation will be applicable to both new and pending applications.

This adjustment in fees is viewed as a significant measure by Lebanese authorities to stabilize the value of the local currency against foreign currencies, amidst ongoing fluctuations in the Lebanese pound.

MOZAMBIQUE:

MOZAMBIQUE: REVISION OF OFFICIAL FEES



The Mozambican Industrial Property Institute (IPI) has recently revised its official fees following the implementation of Ministerial

Decree No. 154/2023, effective as of February 28, 2024. These adjustments encompass various services, including trademark registration, renewal, and legal procedures such as oppositions and responses to provisional refusals.

LIBYA:

LIBYA: CANCELLATION OF UNRENEWED TRADEMARKS



On February 25, 2024, the Director of the Libyan Trademarks Office issued official decision No. (335) of 2024, canceling all published

trademarks that were not renewed within the legal deadlines outlined in Article 1257 of Commercial Activity Law No. 23 of 2010. The relevant provisions

are as follows:

- The protection period for a registered trademark is ten years, renewable upon request of the owner for an identical period, with each renewal made within the final year of the protection period.
- Owners may request renewal within six months following the expiration date; failure to do so will result in the trademark being canceled ex officio by the trademark office.
- A canceled trademark may be re-registered exclusively in favor of its owner within three years from the cancellation date, following the prescribed conditions and registration procedure. This decision specifically targets trademarks published before 2021 (with trademark numbers below 22100), excluding those published in 2022, 2023, and 2024. The rationale behind this decision is that published trademarks are deemed virtually registered and must be renewed before the expiration of the 10-year protection period, regardless of whether a registration certificate was issued. Trademarks published in 2024 are exempt from this cancellation. The decision took immediate effect upon its issuance date.

LIBYA: IMPLEMENTATION OF NEW DOCUMENT SUBMISSION REQUIREMENTS STARTING MAY 1, 2024

On February 14, 2024, the Libyan Ministry of Economy & Trade issued an official circular outlining the following updates:

Power of Attorney (POA) validity for trademark prosecution actions is set to one year from the signing date.

All documents legalized abroad must undergo local attestation by the Ministry of Foreign Affairs and International Collaboration to validate consular legalization.

Submission of an extract of the applicant company's entry in the commercial register, certificate of incorporation, or any document confirming the legal existence of the applicant company is mandatory for filing new trademark applications. These documents must be issued within one year of initiating the trademark action and accompanied by their Arabic translation.

Applications for trademark assignment and other post-registration recordal actions must include the original required documents along with their Arabic translation. It is important to note that these updates will take effect

on May 1, 2024. Until then, trademark owners with existing powers of attorney and trade licenses with the trademarks office, especially those executed before May 1, 2023, are advised to utilize them. Otherwise, they will be required to execute a fresh set of documents as outlined above.

QATAR: QATAR: ESTABLISHMENT OF NEW PATENT GRIEVANCE COMMITTEE



After a prolonged anticipation, the implementation of Minister of Economy and Trade Resolution No. (154) of 2018, dated May 1, 2018, to

form a grievances committee concerning decisions related to patent registration and licensing has finally materialized. The Ministry of Commerce and Industry (MOCI) has recently formed a new Grievance Committee tasked with reviewing appeals related to patent application decisions.

This significant development underscores Qatar's commitment to the global intellectual property community, instilling greater confidence among applicants seeking protection for their intellectual property rights in Qatar.

In addition to the formation of the Grievance Committee, the Minister of Economy and Trade has issued two separate circulars, outlined as follows:

Circular No. 2/2024 Regarding Patent Annuities Payment:

This circular stipulates that if the Qatari Patent Office fails to examine or issue any decision regarding a submitted patent application within a consecutive period of three years, the applicant or their representative agent may cease settling the annuities from the fourth year until the Patent Office issues its acceptance or grant decision. However, all outstanding annuities must be paid upon acceptance or grant, while the subsequent annuities can be paid in their respective years until the end of the protection period.

Circular No. 3/2024 Regarding Withdrawal and Amendment of Patent Application:

In accordance with Article 6 of Executive Regulation No. 153 of 2018 of Patent Law No. 30 of 2006, patentees are permitted to withdraw their applications at any time before a final decision of grant or rejection is issued. However, once a final decision is made, they forfeit the ability to recover their submitted documents or retrieve

the official paid fees. Additionally, patentees may amend their patent applications or submit supporting documents at any time before a final decision of grant or rejection is issued, provided that the amendments do not alter the essence or nature of the invention."

SUDAN:

SUDAN: RESUMPTION OF OPERATIONS BY THE TRADEMARKS OFFICE



resumed its regular activities following a closure period of nearly 10 months due to unrest in the country. Presently, the TM Office is accepting new trademark applications, renewals, recordals, and related filings. However, subsequent procedures such as examination of applications and supporting documents will be addressed once the trademark database has been updated.

Audiri Vox has been closely monitoring the situation at the Sudanese TM Office to ensure that all pending instructions received during the closure period are promptly addressed upon the resumption of normal operations. Consequently, comprehensive filing reports will be promptly shared with our clients and associates.



INDIA: TRADE MARKS CASES



GSK CONSUMER HEALTHCARE S.A.
(Petitioner) vs CELEBRITY BIOPHARMA LTD.
AND ANR. (Respondents)

Case No.: C.O. (COMM.IPD-TM) 154/2021
Decided On: March 22, 2024

Otrivin

Breathe your Best.

The present rectification/cancellation petition was filed by the Petitioner to remove the deceptively and phonetically similar mark of the Respondents.

The Petitioner submitted that "OTRINIR" is phonetically, structurally and visually similar to the Petitioner's mark "OTRIVIN", which is likely to cause confusion and deception amongst the general public and trade. The Petitioner is the prior adopter of the mark "OTRIVIN", which has achieved the status of a well-known mark on account of the Petitioner's extensive and continuous use. The Respondent asserted that they have used "OTRI" word which is generic and derived from the different

term as a prefix before word "NIR" originates from the name of the director NIRAJ KUMAR NIR. The Respondent further argued that the Court must apply the "anti-dissection rule", which requires marks to be compared in their entirety rather than segmented into parts.

In the present case, Hon'ble Delhi High Court observed that holistic comparison of "OTRIVIN" and "OTRINIR" reveals significant phonetic, structural, and visual similarities that are likely to cause confusion among consumers, who may mistakenly believe the products are associated or originating from the same source.

In view of the above analysis, the Court finds that the registration of the Impugned Mark violates Section 9(2)(a) and Section 11(1), 11(2) read with Section 18 of the Act, and is thus liable to be removed from the Register under Section 57 of the Act.

APL APOLLO TUBES LIMITED (Plaintiff)
vs M/S STEEL TRACK & ORS. (Defendants)

Decided On: CS(COMM) 488/2023, I.A. 13246/2023
Date of Decision: April 01, 2024

The present suit was filed by

APOLLO TMT



the Plaintiff against Defendants to restrain infringing and passing off of the mark "APOLO" and its formative versions.

Plaintiff has gained tremendous goodwill among the market and has proved it while claiming the right over the said mark. While the Defendants contended that they are using the impugned mark for the different goods though it falls under the same class and claimed that the Plaintiff filed the suit with the gross delay, and this shows that Plaintiff has accepted the use of the impugned mark by Defendants.

In the Hon'ble Delhi High Court's prima facie view, there is a remarkable similarity between the goods offered by the Plaintiff and the Defendants. It was further found that if no ad-interim injunction is granted in favour of the Plaintiff then it will suffer an irreparable loss; balance of convenience also lies in favour of the Plaintiff and against the Defendants. If Defendants are permitted to sell products under the Impugned Marks, it is likely to cause irreparable damage and injury to Plaintiff's business and reputation. Hence Hon'ble court restrained the Defendants from using, selling, advertising the goods under the said trademarks.

**HALDIRAM INDIA PVT. LTD (Plaintiff)
vs BERACHAH SALES CORPORATION &
ORS. (Defendants)**

Case No.: CS(COMM) 495/2019 & I.A. Nos.
12513/2019, 14284/2019, 2650/2021, 14468/2022
Decided On: April 02, 2024

The present suit has been filed by the plaintiff against the defendants for infringing its mark “HALDIRAM.”



Plaintiff's grievance was that defendants initially incorporated a company by the name 'Haldiram Restro Pvt. Ltd.' and when plaintiff conducted a search of the applications filed by defendants, it found that in 2018, Defendant 5, claiming to be the owner of Defendant 1 firm, Berachah Sales Corporation., applied for the 'HALDIRAM BHUJIAWALA' mark in class 43 for services for providing food and drink, temporary accommodation and for marks 'HALDIRAM'S' and 'HALDIRAM HOTELS'. On the other hand, the Defendants argued that there were 36 companies registered under the Companies Act, 2013 with similar names, many operating in the same industry. Since Haldiram did not object to these companies nor contest Berachah's use of the said mark, they argued their use of the name should not be restricted. The bench noted that considering numerous registrations and extensive usage of the mark by Haldiram, coupled with its goodwill, the court granted a permanent injunction in favor of Haldiram. Berachah was instructed to surrender all materials bearing the impugned marks for destruction within one week and further held, *“A decree of declaration declaring the mark 'HALDIRAM', as well as the Oval-shaped mark, as a 'well-known' mark in respect of food items as well as in respect of restaurants and eateries, is granted”*. The Hon'ble court ordered Trade Marks Registry.

**CROCS INC (Petitioner) vs THE REGISTRAR OF
TRADEMARKS NEW DELHI & ANR.
(Respondents)**

Case Number: C.O. (COMM.IPD-TM) 779/2022 &
I.A. 20390/2022
Decided On: April 08, 2024

The Petitioner had filed rectification/cancellation petition for removal of the trademark “CROCSCLUB”.



The Petitioner has claimed that its mark has gained substantial goodwill and reputation amongst the market and e-commerce platforms. Despite all attempts of service to Respondent no. 2, there is no appearance on behalf of Respondent no. 2. Since Respondent no. 2 has chosen not

to appear.

Hon'ble Delhi High Court observed that, it is undisputed that the petitioner's product using the trademark 'CROCS' has garnered absolute reputation in terms of its product. The court further observed the fact that petitioner's trademark is totally subsumed by the impugned trademark, the likelihood of confusion, plus the risk of association with the petitioner's trademark(s) and goods. Hence by considering the facts, Hon'ble Delhi High Court has ordered to remove the impugned trademark from the register of trademarks and accordingly update the same within 6 weeks of the order.

**MAMI LIMITED (Petitioner) vs HINDUSTAN
UNILEVER LIMITED (Respondent)**

Case Number: (CS COMM)/189/2024
Decided on.: April 09, 2024

The present petition has been filed by the Petitioner expressing concern about possible trademark infringement and passing off by the Respondent.

*Glow &
Handsome*



The Petitioner is a prominent entity in the skincare industry and has had a strong brand presence for a long time. It is alleged by the Petitioner that the Respondent's use of the mark “Glow and Handsome” constitutes infringement of the petitioner's mark “Fair and Handsome”. “Glow and Handsome” is deceptively similar to the petitioner's registered mark. “Handsome” being a prominent, leading, and essential feature of the petitioner's mark, has also acquired distinctiveness and a secondary meaning. On the contrary, the Respondent contended that the mark “Handsome” is purely descriptive and incapable of any distinctiveness. “Handsome” is a generic term also used by other competitors in the industry. In any event, “Handsome” is not exclusively identified with the petitioner and the petitioner has never used the mark “Handsome” as a standalone mark. The Court observed that the respondent's adoption of the mark “Glow and Handsome,” despite being aware of Emami's brand, suggested an intentional attempt to capitalize on Emami's goodwill. The Court emphasized, “Words and terms which are prima facie descriptive may in certain circumstances by use and reputation acquire a secondary distinctive meaning before they are monopolized.” Hence despite the absence of infringement, the Court ruled in favour of the petitioner on the grounds of passing off, granting them relief in the form of an injunction against respondent.

Mallcom (india) Limited (plaintiff) vs Shanti Udyog Weldsafe Private Limited & Ors. (defendants)


Case Number: CS(COMM) 85/2024 & I.A. 5877/2024
Decided on: April 10, 2024

The present suit was filed by the plaintiff against the defendants for seeking protection for its marks.

The Plaintiff contended that the Impugned mark was registered in a dishonest, wrongful, and unlawful manner, arguing that it is identical or deceptively similar to their registered trademark “TIGER”. This alleged infringement violates the Plaintiff's long-established trademark rights in the field of safety shoes, thereby potentially misleading consumers and diluting the Plaintiff's brand.

The Hon'ble Delhi High Court observed that the Plaintiff had not only applied for, but also secured registration of the trademark “TIGER” well before the Defendants began using it. This prior registration necessitated that the Defendants should have conducted a thorough search of the trademark register before adopting any mark incorporating the word 'TIGER.' Thus, the plea of honest adoption of arbitrary term 'TIGER' for safety shoes cannot be accepted.

In addition to the above, the Hon'ble Court directed Defendants to takedown the website hosted on the domain name www.cdtiger.com. Further, considering the fact that Defendants' mark was registered since 2014, the court permitted Defendants to reduce their existing stock of goods, which are fully manufactured, bearing the mark

“CD TIGER/ ”, within four weeks, and to file an affidavit giving complete details of stock, including batch numbers, of the goods manufactured, within two weeks. It clarified that no further manufacturing shall be undertaken under the impugned mark.



PATENT CASES:

SULZER MIXPAC AG (Appellant) vs.
ASSISTANT CONTROLLER OF PATENTS
AND DESIGNS (Respondent)

Case Number: C.A.(COMM.IPD-PAT) 19/2021
Decided on: April 05, 2024

In the present appeal, the appellant had filed an appeal at Hon'ble Delhi High Court w.r.t the rejection of the patent application by the respondent on the ground of lack of novelty and inventive step under Section 2(1)(j) of the Act. The present application bearing application no. 1329/Del/2012 entitled “STATIC MIXER”. Objections were raised in the First Examination Report (FER) citing four prior art documents D1-D4 to which the appellant submitted the detailed response. Following to which hearing was fixed maintaining the objection, subsequently written submission was filed by the appellant along with amended claims further to which the respondent rejected the invention.

The Appellant argued relying upon a prior art EP1426099B1 and differentiating that the subject invention introduces multiple installation bodies in series, which are connected with the common bar elements running through all the installation bodies and connecting them together. The respondent argued by stating that the appellant is comparing the subject invention with EP1426099B1 and not with their own cited prior arts D1-D4. The respondent also argued that the inventiveness claimed by the Appellant is also disclosed in the prior art documents D1-D4. The Appellant had also argued that the European Patent Search Report categorizes the prior art documents D1-D4 in Category A, defining them as state of art not considered as prejudicial for novelty and inventive steps in the European jurisdiction and, therefore, ought not to have been considered in India itself. To which the respondent argued that the patent search reports are meant for guidance to a patent applicant and are not precluded from being considered and cited as prior art for a patent application.

The Hon'ble Delhi High Court` observed the matter and stated that the prior art documents cited by the respondent rightly reveals and teaches the subject invention. The Court also states that the Appellant did not provide any data or comparative assessment w.r.t the prior art document D1-D4 and the comparison was done only with the prior art EP1426099B1. The Hon'ble Court

further concludes that patent jurisprudence is territorial in nature and patent applications have to be considered on their own merits within every jurisdiction.

GOOGLE LLC (Appellant) vs. THE CONTROLLER OF PATENTS (Respondents)

Case Number: C.A.(COMM.IPD-PAT) 395/2022
Decided on: April 02, 2024

The current appeal has been filed by the appellant w.r.t the rejection of the patent application, bearing application no. 5429/DELNP/2007 titled 'Managing Instant Messaging Sessions on Multiple Devices'. on the grounds that the invention lacks novelty and inventive step, and is not patentable under Section 3(k) of the Act..

The Appellant argued that respondent's objections were based on the teaching of only one prior art document (i.e., D1) in which the two main features of the subject patent application were not disclosed. The Appellant also stated that the present application has been granted in USA and Canada. The respondent argued that the Appellant was attempting to obtain a monopoly on the features of receiving of a preference and also the conscious preference of the user to trigger the instant messaging feature i.e. not to mirror the same content in two devices, these functionalities are clearly disclosed in the prior art document. The Court had further discovered that the Appellant has suppressed information about the abandonment of the corresponding European Patent application.

The Hon'ble Delhi High Court observed the following matter and stated that the comparison of the subject patent application to the prior art D1 clearly establishes the lack of inventive step and the patent application is also obvious to a person skilled in the art. The Court rejected the grant of patent application with a view of lack of inventive step. The Hon'ble Court also considered the submissions made by the Appellant regarding the abandonment of the present application before EPO and discovered the fact that the Appellant in the present appeal had not only presented wrong facts to the Court, but also failed to disclose the information regarding the refusal of the EU parent application as also of the divisional application which was filed consequently. The Court further concluded by dismissing the present appeal with a cost of Rs. 1 lakh upon the Appellant. Of which 50% of the costs shall be deposited with the office of CGPTDM and the remaining 50% shall be paid to the Id. CGSC.

Case Number: FAO (COMM) 65/2024 &
CMAPPL. 21504-05/2024
Decided on: April 10, 2024

The present appeal has been filed by the appellant for declining the request to restrain the respondents from infringing the appellant's registered designs. The appellant's application under Order 39 Rule 1 & 2 of the Code of Civil Procedure, 1908 (hereafter the CPC) has not been rejected, however his request for ad interim order to the aforesaid effect was not acceded to. The appellant had also filed the application for appointment of the local commissioner under Order 26 Rule 9 of the CPC.

The appellant had filed registered designs in respect of Solar Panel Trolleys (hereafter SPT) and the appellant had claimed that the respondents were fabricating similar SPTs. The appellant had also set out the images for comparison of his SPT constructed in accordance with the registered design with the similar SPT fabricated by the respondents. The appellant had previously filed a police complaint against respondent no. 1 for infringing the appellant's design and to which the respondent no.1 had given an undertaking that he would not infringe the appellant's registered designs. The learned Commercial Court had noted all the points placed on record by the appellant and also that no cease-and-desist notice was issued to respondent no.2. The ad interim order sought by the appellant was also denied on the ground that the appellant did not place any proof establishing that the design manufactured and sold by the respondent no.2 to 6 were not registered. The learned Commercial Court had also noticed that the invoices placed on record by the appellant in respect of the SPTs sold by the respondents did not mention the design or details.

The Hon'ble Delhi High Court observed the following matter and stated they were unable to accept that the ad interim order could be denied on the basis that the appellant did not place any proof indicating that the respondents design were not registered, even though the appellant had provided details of their registered design and there was no material to indicate that any of the SPTs manufactured by the respondents were based on the design registered in their favour. The Court concluded by stating the learned Commercial Court to consider the matter afresh and in particular the application for the appointment of the local commissioner without issuing any notice to the respondents.

DESIGN CASES:

PARDEEP KUMAR PROPRIETOR OF T.G.
SOLAR PUMP (Appellant) vs. PRAKASH
ENTERPRISES & ORS. (Respondents)



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