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THE SALIENT FEATURES OF COPYRIGHT LAW IN SRI LANKA – PART III



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Unlike the other types of Intellectual Property Rights, such as Trademarks or Patents, Copyrights have many intricate concepts and layers which need to be broken down and studied separately in order to grasp the entire learning of what copyright protection entails.

This article tries to, although not extensively, bring to light the areas of Substantial Part, Limitation of rights and the doctrine of Fair use as applicable to IPR

Substantial Part

The substantial part is what it sounds like, the most important component of a work. There's debate and confusion on what can be considered a substantial part of a work. "*what is worth copying is prima facie worth protecting*" (The dictum of Peterson J. in *University of London Press Ltd. V Universal Tutorial Press Ltd.*). When considering a work, whichever part of that work that is worth copying can be considered as the "Substantial Part" that would require legal protection.

In the event that the part taken out/copied from a work, is not significantly a major part of the work, for an example, such as one or two sentences off a piece of music or writing, a section of a picture etc. to rule out whether an infringement has been made or not, the assessment then is not on the quantity of the work that has been taken out or copied, but should be on a more qualitative approach.

Another type of copying in which substantiality may become relevant is altered copying, where the copying is done making modifications to the existing work. This is commonly found in translation of literal works and dramatization of a novel. If copyright existed in the original work, even if there is no word-to-word translation of the original, copyright infringement can be ruled as what must be ascertained is quality or quantity. The courts must delve into how much of the original author's skill and labor has the infringer absorbed into their work. Thus, one cannot get away by creating a copy that is framed differently or worded differently or implemented differently, as it is nevertheless based on an original work.

Limitation of Rights

The protection that is granted on copyrights by way of law is not something that is unrestricted and unlimited. The following restrictions or limitations are imposed by law on protected rights:

- Time bar – each protected right has a time limitation.
- The owner of the copyright has the ability to waive the rights.
- If an act is authorized by the owner, then it does not constitute an infringement of copyright.
- No work that is immoral, obscene, defamatory, blasphemous etc. shall be granted copyright protection.
- Fair use.

Doctrine of Fair Use

Of all the limitations surrounding a copyright, the doctrine of Fair Use can be considered as the most significant limitation. The Act (The Intellectual Property Act) does not clearly define as to what fair use entails but permits any act of fair use. The focus of fair use is directed towards the purpose for which copyright work is used; if the purpose is such that it can be considered as fair to use the work, which would have otherwise been an act of infringement had the purpose been something else.

Of course, without a clear definition and scope, this is open to interpretation, especially as what is considered as "fair" may simply be a matter of opinion.

As per Section 11(2) of the Act, certain factors which need to be considered in order to ascertain if an act is fair use or not, has been identified as follows:

- a) The purpose and character of the use. (For commercial gain, nonprofit, educational purposes etc.)
- b) The nature of the work which has copyrights
- c) When considering the entirety of the copyrighted work, the amount and the substantiality of the portion that has been used.
- d) The effect in terms of the value and potential market of the copyrighted work, due to the use of such work

As stated earlier, the Act identifies certain “Acts of fair use”. These have been specified under Section 12 of the Act. An unexhaustive summary of these Acts are as follows:

- a) **Private reproduction** - Reproduction of a lawful copy, by a physical person without the authorization of the copyright owner, exclusively for the purpose of personal/private usage, shall not constitute copyright infringement. If not for this no one will be able to buy and read anything that is protected under copyright.
- b) **Quotations** - This shall mainly be for published literal works which are often quoted in various forums, in literal reproduction or otherwise. However, in this instance it should be assessed that the reproduction does not exceed the extent justifiable for the purpose.
- c) **Teaching purposes** - A reproduction of a short part of a published work exclusively with the intention of using the same for teaching purposes and the reprographic reproduction for face-to-face teaching purposes. This is required as all human knowledge is incremental, based on events, writings, observations in the past.
- d) **Libraries and Archives** - A single copy of a work is allowed to be reproduced without the authorization of the owner, provided that the library or archive has satisfied themselves that the copy will only be used for educational purposes (study, research etc.)
- e) **Current affairs and information** - The purpose of such reproduction shall be purely to provide information to the general public. It is essential that as far as practicable, the source and name of the author is indicated.
- f) **Computer programs** - Reproduction in a single copy is permitted without authorization where it is for the use of the computer program with a computer, for the purpose and extent to which such computer program was obtained and for archival purposes. This is important as computer hardware is prone to fault and the software is licensed not to the computer but to the

person/organization that buys it. Thus, in the absence of this, the software company would force the owner of the license to buy the software again lest his authorized copy is destroyed along with his computer.

- g) **Importation for personal purposes** - Importation of a lawful copy, by a physical person without the authorization of the copyright owner, exclusively for the purpose of personal/private usage, shall not constitute copyright infringement.
- h) **Public display** - In such an instance the display should be made other than by way of a film, slide, television image etc. (no use of device or process) and the work that has been published or the original or copy that is displayed was sold or given away either by the author or the successor in title.
- i) **Performance or display** - Performance or display for educational purposes and display or performance through an apparatus commonly used in private homes for private viewing.

As mentioned at the onset of this article, copyright law has many legal aspects to it that requires to be studied and understood. We will further delve into the other general principles and concepts within copyright law in Sri Lanka, in our next issue.



TECHNICAL EFFECT TRIUMPHS: BLACKBERRY'S PATENT CLEARS SECTION 3(K) HURDLE IN INDIA



By Divyendu Verma
Global Head of Patents Practice

Earlier it was routine for Indian Patent Office to reject patent applications where it thought that a computer program based on algorithm and software did not constitute a major patentable process. It used the 3(k) provision of the patent act to reject anything that was seen as a mere software that had no technical effect. One such case that came up and the decision on it, has permanently changed how the patent office will now have to deal with such patent applications that claim technical effect. Read on.

Case: Blackberry Limited v. Controller of Patents and Designs (C.A. (COMM.IPD-PAT) 318/2022)

Court: Delhi High Court

Date of Pronouncement: 30th August 2024

Judge: Justice Pratibha M. Singh

Background: Blackberry Limited filed an appeal under Section 117A of the Indian Patents Act, 1970, against the refusal of its patent application 717/DEL/2009 for a method titled "Auto-Selection of Media Files". The Indian Patent Office had rejected the application under Section 3(k) of the Patents Act, which excludes software and algorithms as such from patentability.

Key Issues:

1. **Objection of Non-Patentability under Section 3(k):** The Indian Patent Office argued that Blackberry's invention was primarily a computer program and lacked any technical effect, rendering it non-patentable

as per Section 3(k).

2. **Blackberry's Argument:** Blackberry contended that the invention solved a technical problem by managing media content on devices based on memory availability and user preferences. They argued that this went beyond a mere algorithm and had a direct technical impact.

Court's Rationale for Rejecting Patent Office Objections: The Delhi High Court rejected the Patent Office's objections under Section 3(k) based on several grounds:

1. **Technical Effect and Contribution:** The court found that Blackberry's invention was not just a computer program but a technical solution that enhanced device functionality. By optimizing storage space and automating the selection of media files, the invention produced a concrete technical effect. The court emphasized that the invention improved user experience and device capabilities without manual intervention, which is a key factor in determining patentability under Section 3(k).
2. **Prior Art Assessment:** While the Indian Patent Office and the European Patent Office had refused similar applications based on prior art, the court differentiated Blackberry's invention from previous patents like US'765. The court noted that Blackberry's invention introduced novel features, such as the cache manager and the creation of a unified library system, which contributed to a technical advancement. These features were not present in the prior art, thereby affirming the novelty and inventive step of the patent.
3. **Impact on Device Functionality:** The court underscored that Blackberry's invention allowed devices to function autonomously with minimal user interference, thereby enhancing the operational capacity of the device. Such an enhancement went beyond mere software programming and thus qualified for patent protection.

Decision: The court directed the patent to be amended, limiting its scope to the technical features of "automatic selection" and "updating by a cache manager," while excluding abstract features. After this amendment, the patent was allowed to proceed for grant.

The Bench of Justice Pratibha M Singh held:

"Any invention which can increase the capability of a device to such an extent would not be hit by Section 3(k) of the Act. The argument of Mr. Harish V.

Shankar, ld. CGSC that the rejection by the EPO ought to result in rejection of subject patent - though extremely appealing, is not tenable... This Court has independently assessed the nature of the invention and is of the opinion that the bar under Section 3(k) of the Act would apply to the subject invention."

Impact on Indian Patent Law Jurisprudence: This case marks a significant development in how Indian courts interpret Section 3(k) of the Patents Act, particularly in relation to software patents. By recognizing the technical contribution of software-driven inventions, the court has clarified that innovations that provide a tangible technical effect or improvement in device functionality can be patentable, even if they involve algorithms or computer programs. This decision could set a precedent, encouraging more nuanced assessments of software-related patent applications in India. It may also influence the way the Indian Patent Office approaches future cases involving computer-implemented inventions, potentially leading to more grants in this field when technical effects are evident.

INDIA'S ROADMAP TO A US\$300 BILLION BIOECONOMY: BIO-RIDE SCHEME LAUNCHED BY GOI

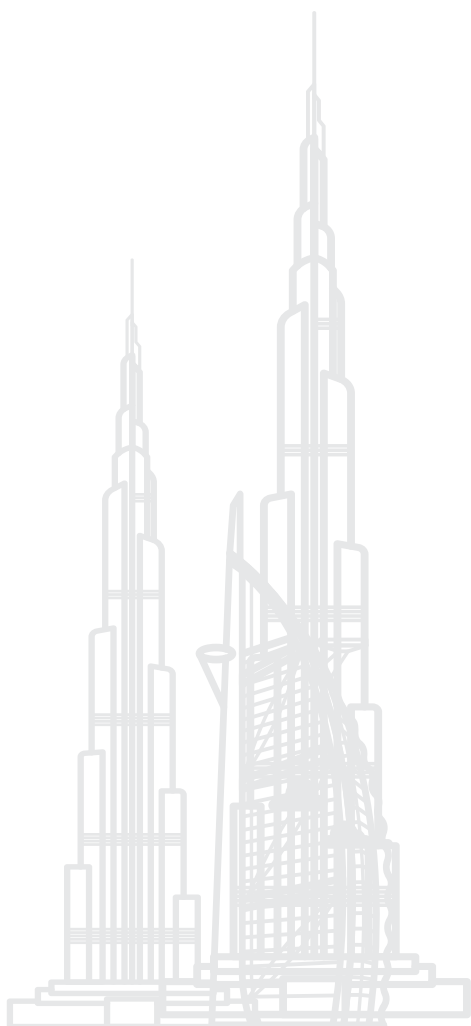
The Indian Union Cabinet, chaired by Prime Minister of India, has approved the "Bio-RIDE" (Biotechnology Research Innovation and Entrepreneurship Development) scheme on September 18, 2024. This initiative merges two pre-existing schemes under the Department of Biotechnology (DBT) to boost research, innovation, and industrial growth in biotechnology. The scheme has a proposed outlay of INR 9,197 crore (USD 1.1 billion) for the 2021-26 period.

The key objectives of Bio-RIDE are:

- **Fostering Innovation:** It will provide grants for cutting-edge research in areas like biopharmaceuticals, bioenergy, and synthetic biology.
- **Supporting Startups:** The scheme aims to nurture bio-entrepreneurship by offering seed funding and incubation to startups.
- **Encouraging Academia-Industry Collaboration:** It will facilitate cooperation between research institutions and industries to commercialize bio-based technologies.
- **Promoting Sustainable Biomanufacturing:** Aligning with India's green goals, it will encourage environmentally friendly manufacturing practices.

Additionally, the scheme introduces a new component on Biomanufacturing and Biofoundry, in alignment with the PM's "Lifestyle for the Environment" (LiFE) initiative to address climate change and promote the bioeconomy. Bio-RIDE will also support skill development in the biotechnology sector, helping India achieve its goal of becoming a \$300 billion bioeconomy by 2030.

This ambitious initiative contributes to India's vision of "Viksit Bharat 2047" by ensuring national growth in biotechnology research, innovation, and entrepreneurship.



IP UPDATES**UAE:
UAE STRENGTHENS INTELLECTUAL
PROPERTY TIES WITH CNIPA**

In May 2024, the UAE Ministry of Economy signed a Memorandum of Understanding (MoU) with China's National Intellectual Property Administration (CNIPA),

marking a significant step toward enhancing collaboration in the field of intellectual property (IP).

The agreement focuses on developing the skills of IP professionals through joint training programs and seminars. It also facilitates the exchange of information on IP policies, legal developments, and enforcement strategies, helping both nations stay abreast of emerging trends and challenges. Furthermore, the MoU promotes joint research programs aimed at addressing new IP challenges, including the impact of digital technologies on IP protection.

This partnership underscores the shared commitment of the UAE and China to foster innovation and increase IP awareness among businesses and entrepreneurs.

**QATAR:
QATARI PATENT OFFICE RESUMES
ACCEPTANCE OF ANNUITY PAYMENTS
FOR PATENTS**

In reference to Circular No. 2/2024 issued by the Intellectual Property Rights Protection Department of the Qatari Ministry of Commerce and Industry, which previously

allowed applicants to defer annuity payments after the third year if their patent applications were still pending, there is an important update in this regard.

The Qatari Patent Office has now resumed the acceptance of annuity payments for all years, including for pending applications that have not yet been granted. Applicants are advised to promptly settle any outstanding annuity fees, regardless of the status of their applications.

Please note that the Qatari Patent Office has also confirmed that no refunds will be issued for incorrect or duplicate payments.

**QATARI TRADEMARK OFFICE LAUNCHES
INTEGRATED TRADEMARK DATABASE:**

The Ministry of Commerce and Industry in Qatar has announced the integration of its registered and published trademark databases into the Global Brand Database, managed by the World Intellectual Property Organization (WIPO). Although Qatar's trademark data has been accessible on the WIPO platform since the enforcement of the Madrid Protocol on August 4, 2024, this recent announcement aims to raise awareness and highlight efforts to enhance trademark accessibility for individuals and businesses in Qatar.

This integration allows users to easily search for trademarks via the Global Brand Database (wipo.int), offering streamlined access to trademark information relevant to both public and private sectors.

**KUWAIT:
KUWAIT LAUNCHES FIRST PHASE
OF .KW DOMAIN REGISTRATION**

The Communications and Information Technology Regulatory Authority (CITRA) has officially launched the first phase of the national domain (.kw) registration, known as the Sunrise Period, starting from September 23, 2024. This initiative marks a significant step towards bolstering Kuwait's digital infrastructure and aims to promote local businesses by strengthening their online presence.

In this initial phase, government entities, existing registrants of third-level domains (.com.kw, .net.kw, .org.kw), and trademark holders are invited to register their .kw domain names. This effort underscores the importance of enhancing Kuwait's digital identity and expanding the reach of local organizations.

After the Sunrise Period, the registration will enter the "Land Rush Period," lasting six months, during which domain names will be available at premium rates. Following this, the "General Availability" phase will begin, offering domains to the public at reduced registration fees compared to the second phase.

**LEBANON:
LEBANESE INTELLECTUAL PROPERTY OFFICE
FACES OPERATIONAL CHALLENGES**

The Lebanese Intellectual Property Office (IPO) is currently experiencing significant operational difficulties, including a shortage of staff.

For new trademark applications, there is a possibility of filing online if the Lebanese Trademark Office's (LTO) portal is functional.

As verbally confirmed by the IPO head, all filing deadlines have been extended starting from September 23, 2024, though a formal memo has yet to be issued.

We appreciate your understanding and patience during this period. For any inquiries or assistance, please feel free to reach out to us at global@audirivox.com

INDIA: TRADEMARK CASES



ADIDAS AG (Plaintiff) vs MOHD. IRFAN (Defendant)

CASE NUMBER.: CS (Comm.) No. 198/2023 CNR No. DLSH01-002377-2023
DECIDED ON : September 11, 2024

The plaintiff filed suit against the defendant for trademark infringement, passing off, and copyright violations. In this case, the plaintiff, which operates under the trademark



“adidas,” etc. alleges that the defendant is unlawfully selling products bearing similar marks that are confusingly similar to the plaintiff's trademarks, thereby infringing on their rights and misleading consumers. The plaintiff conducted a market survey that revealed the defendant was selling these counterfeits. The defendant argued that the products seized did not belong to him and that the plaintiff's claims were baseless. The Hon'ble Delhi District Court found discrepancies, noting that significant details related to damages were only mentioned in the affidavit, not in the plaint. The plaintiff's valuation of Rs. 5,00,000 for trademark infringement was deemed insufficient, leading to the decision that the suit was not properly valued. The original infringing products was not produced in court, weaken the plaintiff's claims. The Hon'ble Court concluded that the plaintiff failed to prove the infringement due to the lack of original products and supporting evidence. Consequently, all claims were denied, leading to the dismissal of the suit without any awarded relief, and no costs were assigned.

GUJARAT CO-OPERATIVE MILK MARKETING FEDERATION LTD & ANR. (Plaintiffs)vs TERRE PRIMITIVE & ORS. (Defendants)

CASE NUMBER. : CS(COMM) 768/2024 & I.A.
Nos. 38737/2024, 38738/2024 & 38739/2024
DECIDED ON : September 09, 2024

The Plaintiffs filed a suit against defendant no. 1, an Italian company, for using trademark deceptively similar to **Amul**. The plaintiffs argue that defendant no. 1's marks, 'Amuleti'/ **Amuleti** and similar variations, are likely to confuse consumers and harm the well-known 'AMUL' brand, which has been in use since 1958. The defendant contends that their use of the mark is distinct and not intended to mislead. However, the Hon'ble Delhi High Court observed that the similarities between the marks could confuse consumers and dilute the plaintiffs' brand reputation. The Hon'ble Court granted an injunction favoring the plaintiffs, restraining the defendant from using the impugned marks, and ordered the removal of related online content and materials.

AMBA SHAKTI STEELS LTD. (Appellant) vs SEQUENCE FERRO PRIVATE LIMITED (Respondent)

CASE NO. : FAO (COMM) 41/2024 & CM No.12834/2024
DECIDED ON : September 03, 2024

In the present case, the appellant filed an appeal challenging an order passed by the learned Commercial Court. The appellant sought to restrain the respondent from using the trademark “**AMMAJI**” The appellant



contended that given the visual and phonetical similarities between both marks “**AMBA**” and



would mislead the customers into thinking that appellant product is associated with respondent product. The appellant has used and promoted its mark for a very long time and has established strong goodwill in the market. The Hon'ble Delhi High Court, by allowing the appeal, set aside the Commercial Court's order. The Hon'ble Court granted the interim injunction, restraining the respondent from using the “AMMAJI” mark or any deceptively similar trademark until the final disposal of the suit. The Court ruled that the appellant had established a prima facie case of potential confusion among consumers, which would harm the appellant's goodwill.

**VISHESH FILMS PRIVATE LIMITED
(Plaintiff) vs SUPER CASSETTES INDUSTRIES
LIMITED (Defendant)**

CASE NUMBER : CS(COMM) 68/2024, I.A. 1797/2024,
I.A. 3979/2024
DECIDED ON : September 02, 2024

The plaintiff filed the suit against the defendant for violating their proprietary rights in the renowned film franchise “Aashiqui,” and also assert the right over the trademarks “Aashiqui,”

and “Aashiqui Ke Liye,” 

The Plaintiff argued that their rights in the well-known Aashiqui film franchise were being violated by the defendant. The defendant also applied to register the title “Tu Hi Aashiqui,” gives the perception that the new film was part of the franchise, leading to inevitable confusion and a violation of plaintiff trademark rights. The Hon'ble Delhi High Court has restrained defendant from using titles “Tu Hi Aashiqui,” “Tu Hi Aashiqui Hai” and “Aashiqui” in respect of an upcoming film. The Hon'ble Court said that plaintiff mark “Aashiqui” is registered under the Trade Marks Act, 1999 and that it is crucial to protect titles of expressive works that become part of a series and have the potential of acquiring distinctiveness. The Hon'ble Court said that the “Aashiqui” title is not just an instance of isolated use, but rather, has become part of a recognized film series, with two successful instalments released in 1990 and 2013.

**VIVO MOBILE COMMUNICATION CO LTD. (Plaintiff)
vs MR JITENDRA KUMAR TIWARI TRADING
AS MAA VAISHNAVI CHEMICALS (Defendant)**

CASE NUMBER : CS(COMM) 510/2021
DECIDED ON : August 29, 2024

The present suit was filed by the plaintiff seeking permanent injunction restraining the infringement of its registered trademark  against the



defendant. The plaintiff argued that the defendant mark does not only have identical word element ‘VIVO’ but also have the identical and deceptively similar font, color, manner of writing etc. and the plaintiff has been using its “VIVO” marks continuously, extensively and uninterruptedly in respect of its products and/or related services. The Hon'ble Delhi High Court observed that the

plaintiff had prior and continuous use of the mark “VIVO” and that the defendant mark was deceptively similar, causing consumer confusion and can also result in dilution of the ‘VIVO’ mark. Accordingly, the decree of permanent injunction was passed in favor of the plaintiff.

**MOUNT EVEREST BREWERIES LIMITED
(Appellant/Petitioner) vs EXCISE COMMISSIONER
MADHYA PRADESH AND OTHERS (Respondents)**

CASE NUMBER : WRIT APPEAL No. 1852 of 2024
DECIDED ON : August 27, 2024



(Respondent's label)




(Appellant's label)

The petitioner filed a writ appeal challenging the order of Excise Commissioner and the order passed in writ petition No.31110 of 2023. The Appellant/petitioner argued that the respondent registered label “VASCO 60000 EXTRA STRONG BEAR” is similar and based on the artistic label of the petitioner brand “MOUNT 6000 SUPER STRONG BEER”. The respondent dishonestly copied the entire label, even the 6000 numeral artistic features. The Hon'ble Indore High Court observed that the red colour background, black strip, and unique colour combination of golden, red and brown colour and especially the words “6000” used by the respondent is exactly the same and deceptive to the registered label of the petitioner. The Hon'ble Court was of the opinion that there is similarity and resemblance between the label of petitioner and respondent. Therefore, the Hon'ble court allowed the writ appeal and set aside the order of Excise Commissioner, and the order passed in writ petition No. 31110 of 2023.

**DKH RETAIL LIMITED (Plaintiff)
vs MR. JAY (Defendant)**

CASE NUMBER : CS Comm 4418/21
DECIDED ON : August 27, 2024



The plaintiff filed a suit against the defendant for infringement of trademark and copyright, seeking a permanent injunction, damages, and destruction of counterfeit goods. The plaintiff, known for its brand ‘SUPERDRY’  claimed


 claimed

that the defendant was distributing goods bearing falsified 'SUPERDRY' trademarks, leading to confusion and damage to the brand's reputation. The plaintiff contended that defendant's products were substandard and counterfeit, which could harm its market presence. Defendant, however, did not appear in court or respond to the claims. The Hon'ble Delhi District Court observed that defendant's use of the 'SUPERDRY' mark was indeed infringing and confusingly similar to the plaintiff's registered trademarks. The Hon'ble Court decreed in favor of the plaintiff, granting a permanent injunction against defendant, ordering the destruction of seized counterfeit goods, and awarding damages of Rs. 3,00,000.

CASTROL LIMITED (Plaintiff) vs MOTOGULF INDIA PRIVATE LIMITED & ORS. (Defendants)

CASE NUMBER : CS(COMM) 900/2023 &
I.A. 25474/2023, I.A.3217/2024, I.A. 7020/2024
DECIDED ON : August 23, 2024

The present suit was filed by the plaintiff seeking permanent and mandatory injunction to restrain the defendant from using the mark  in its word as well as device form. The plaintiff argued that the defendant has copied the overall colour combination and structural scheme of plaintiff's  mark. The

plaintiff had no objection to the use of the word mark 'COASTAL' however the defendant shall not be allowed to use the device mark. The Hon'ble Delhi High Court on the basis of plaintiff contention and defendant agreeing to not use the mark " issued permanent injunction in favor of the plaintiff. As the defendant were found to be carrying infringing activities, the Hon'ble Court ordered the defendant to pay a cost of ₹3,00,000/- to the plaintiff.

G.D. PHARMACEUTICALS PRIVATE LIMITED (Plaintiff) vs M/S CENTO PRODUCTS (INDIA) (Defendant)

CASE NUMBER : CS(COMM) 53/2019 & I.A. 2215/2021
DECIDED ON : August 07, 2024



(Defendant's label)



(Plaintiff's label)

The plaintiff filed a suit against the defendant for infringement of trademark and copyright, seeking a permanent injunction, damages etc., against the defendant. The plaintiff argues that the defendant has adopted the mark "BOROBEAUTY," which is used and represented in a manner which is deceptively similar to plaintiff's use of its registered trade mark "BOROLINE." The plaintiff also pleaded for the mark to be declared "well-known." The defendant offered to change its trade dress and share his intent to not even use the prefix 'BORO.' Accordingly, the Hon'ble Delhi High Court issued a decree of permanent injunction in favor of the plaintiff and directed the defendant to change its trade dress and trademark. The Hon'ble Court is also of the view that the plaintiff's trademark qualifies as a well-known mark due its extensive and uninterrupted use. The Hon'ble Court ordered the defendant to pay a cost of ₹2,00,000/- to the plaintiff.

PATENTS CASES

AXCESS LIMITED (Appellant) vs. CONTROLLER OF PATENTS AND DESIGNS (Respondent)

CASE NUMBER: C.A.(COMM.IPD-PAT) 288/2022
DECIDED ON: September 13, 2024

The current appeal has been filed by the appellant challenging the impugned order passed by the respondent regarding refusal of the appellant's patent application under Section[s] 59(1), 3(d) and 3(e) of the Patent Act. The appellant argued that the amended claims fall within the scope of the originally filed specifications and claims and therefore the respondent's conclusion regarding Section 59(1) of the Act is contrary to the facts on record. The respondent in the impugned order held that the amendments made by the appellant to a product claim is beyond the scope of the original claims and complete specification as disclosed by the appellant.

The Hon'ble Delhi High Court examined the appellant's patent application and identified that the amended claims in the latest complete specification filed by the appellant to the initial claims are well within the scope of the original PCT claims. The Hon'ble Court also states that the respondent did not consider the newly amended claims to the complete specification of the appellant. The Hon'ble Court concluded by remanding the matter back to the controller for de novo consideration and issuing a fresh hearing notice.

**NIPPON STEEL CORPORATION (Appellant) vs.
THE CONTROLLER GENERAL OF PATENTS,
DESIGNS & TRADEMARKS & ANR. (Respondents)**

**CASE NUMBER: C.A.(COMM.IPD-PAT) 323/2022
DECIDED ON: August 29, 2024**



The current appeal has been filed by the appellant against the respondents for rejecting the appellant's patent application under the ground of Section 3(d) of the Patent Act. The appellant argued that the respondent did not raise any objection w.r.t. the Section 3(d) of the Act in the hearing notice, whereas the respondents mentioned a general objection qua Section 3 of the Act, thereby failing to give appellant a fair opportunity to represent its case. The appellant further argued that the respondents failed to analyze the technical aspect of the patent application. The respondents submit that the claimed application did not introduce any special technical impact or functional relationship, therefore patentability of the use/application falls within the scope of Section 3 (d) of the Act as the "Invention not patentable".

The Hon'ble Delhi High Court observed that the respondents acknowledge the novelty and inventive step of the claims of the invention, therefore it cannot be presumed to be a "known process, machine, or apparatus" without its identification as objected by the respondents. The Hon'ble Court further states that the impugned order is unclear as how the claims of the subject application fall under Section 3(d) of the Act. The Hon'ble Court concludes to reconsider the matter afresh by granting a hearing to the appellant along with the notice by clearly delineating the objections.

**NOVENCO BUILDING & INDUSTRY A/S (Plaintiff)
Vs. XERO ENERGY ENGINEERING SOLUTIONS
PRIVATE LTD. & ANOTHER (Defendants)**

**CASE NUMBER: OMP No.540 of 2024 in;
COMS No.13 of 2024
DECIDED ON: August 28, 2024**

The defendants have filed an application under Order, VII, Rule 11 (C) read with Section 151 of the Civil Procedure Code praying for rejection of the plaint on the ground that the plaint is barred by law as the plaintiff was required to comply with Pre-Institution Mediation as enunciated under section 12-A (1) of the Commercial Courts Act, 2015. The plaintiff argued that the defendant

no. 1 was infringing the patent and design of the plaintiff, the plaintiff had also served a cease-and-desist notice upon defendant no. 2 yet the defendants continued to infringe the patent as well as design of the plaintiff, therefore this urgency necessitated the plaintiff in filing of the suit without going for Pre-Institution Mediation And Settlement. The defendants countered that the plaintiff has bypassed the Pre-Institution Mediation And Settlement remedy and directly filed the Civil Suit even though they had enough time, which however does not issue any urgent relief and therefore the plaint is liable to be rejected.

The Hon'ble Himachal Pradesh High Court observed the following matter and did not find any urgency involved in the present suit. The Hon'ble Court further concluded by allowing the application and rejecting the plaint that the plaintiff cannot file a Civil Suit without restoring to the Pre-Institution Mediation And Settlement.

**HENDRICKSON USA, L.L.C. (Appellant) vs. THE
CONTROLLER OF PATENTS AND DESIGNS
(Respondent)**

**CASE NUMBER: CMA(PT)/37/2023
DECIDED ON: August 27, 2024**



The present appeal has been filed by the appellant against the respondent for rejecting the appellant's patent application under

novelty and inventive step ground. The appellant argued that none of the cited prior arts D1-D3 discloses peening of areas beyond the stress affected zone or heat affected zones (HAZ) as in the appellant's patent application. The respondent countered that welding and shot peening are part of common general knowledge which is also disclosed in the prior arts and that the claimed invention does not satisfy the twin requirements of technical advance and non-obviousness under Section 2(1)(ja) of the Patents Act, 1970.

The Hon'ble Madras High Court remands the matter for limited purpose of examining whether the claimed invention qualifies as an invention under the Patents Act in view of undertaking peening beyond the boundary of stress concentration. The Hon'ble Court concludes by examining the matter afresh by the different officer and providing a reasonable opportunity to the appellant.

BRISTOL-MYERS SQUIBB HOLDINGS IRELAND (Plaintiff) vs. M SWARNALATHA & ORS (Defendant)

CASE NUMBER: IA No. GA-COM/1/2024 in
IPDPTA/5/2024
DECIDED ON: August 05, 2024

The present suit has been filed by the plaintiff against the defendants for restraining infringement of plaintiff's Indian Patent No. IN 203937 that claims and covers dasatinib. The Court had previously restricted defendant no. 1-3 from infringing plaintiff's patent (i.e., a product dasatinib) till the expiry of the term of the patent, yet the defendant no. 5-7 manufactured and released the dasatinib product in the Indian market. The plaintiff submits that defendant no. 7 has connection with the other defendants and even after valid services defendant no 7 did not appear before the court which terms that he is guilty of launching the infringing product. The defendant no 1-3, 5 and 6 submits that they have not used infringing product commercially during the subsistent of the patent of the plaintiff and also denies having any connection with the defendant no. 7.

The Hon'ble Delhi High Court noted that the defendant no 1-3, 5 and 6 did not launch any dasatinib containing product till the expiry of the suit patent, whereas the defendant no. 7 had launched the impugned product under the brand name DASA SPL. The Hon'ble Court concluded by imposing the cost of Rs. 5,00,000/- against the defendant no. 7 in favour of DHCBA Employee Welfare Fund.

ANNOUNCEMENT:

EXCITING NEWS!



DIVYENDU VERMA

We are thrilled to announce that **Mr. Divyendu Verma**, Global Head of the Patents Department at Audiri Vox, has been appointed by the **International Trademark Association (INTA)** to represent them at the historic **Diplomatic Conference for the conclusion and adoption of the Design Law Treaty (DLT)**. The event will take place from **November 11-22, 2024**, in Riyadh, Saudi Arabia.

This is a prestigious milestone for our firm, and we are proud of Mr. Verma's continued contributions to the global IP landscape.



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