



AUDIRI VOX

a client-centric ip practice

MIDDLE EAST – ASIA – AFRICA

AVIP

Newsletter

Issue 21

September 2024

In This Issue

- TRADEMARK REGISTRATION IN THE UNITED ARAB EMIRATES (UAE): TIPS FOR FOREIGN FILERS
- ARIJIT SINGH VS AI: SINGER WINS CASE AGAINST AI IMITATING HIS VOICE TO CREATE SONGS
- INDIAN PATENT OFFICE ISSUES FAQs TO BRING CLARITY ON THE FILING REQUIREMENTS OF FORM-27:
- IP UPDATES

TRADEMARK REGISTRATION IN THE UNITED ARAB EMIRATES (UAE): TIPS FOR FOREIGN FILERS



Sarmad Hasan Manto

Managing Partner - Audiri Vox

Cut and keep. If you are a business dealing with UAE, then this article could serve you for a long time to come!

United Arab Emirates (UAE) is the hub of business in the Middle East. The country is a union of seven emirates, namely, Abu Dhabi, Dubai, Sharjah, Ajman, Um Ul Quwain, Ras Al Khaimah and Fujairah. The country is also a member of the six countries alliance forming the Gulf Cooperation Council (GCC), enabling free movement of goods in-between the UAE, Saudi Arabia, Kuwait, Qatar, Oman and Bahrain. Ideally located in the Arabian Peninsula, UAE is an entrance to the Middle East from South and Central Asia. It also provides direct sea access to Africa, Europe, Australia and North America. Due to its geographic location, liberal government policies, numerous free trade zones, modern infrastructure, hassle-free repatriation of capital, security and friendly tax regime, it has come a long way since its inception. Today, UAE serves as a hub of cross-border trade between Asia, Africa, Middle East, Europe and North America.

It was in 1992 that the UAE government promulgated its first federal legislation concerning the protection of intellectual property rights. Through frequent changes in laws and policies, consistent training of staff, enforcement officials and judiciary, acceding to international conventions and treaties, collaboration with international enforcement agencies, and implementing electronic filing system, today, the UAE is at the forefront of intellectual property protection in the region.

Those familiar with the country would recall the time when it took almost two years to obtain registration of a trademark and seven to eight years to register a design or patent. The country has come a long way, and much to its credit, these time frames have decreased drastically. Today, a straightforward trademark registration takes around three months, and enforcement actions can be conducted almost immediately. Recordals of various types, including assignment, license, renewal, change of name and address, can be completed within a week.

The UAE trademark registration procedures include an examination on absolute and relative grounds, publication in the UAE Trademarks Journal, a thirty days (non-extendible) opposition period, followed by the issuance of the registration certificate.

A few take-home points for foreign associates and brand owners interested in seeking registration of trademarks in the UAE are as follows:

- a) Deadlines in the UAE are non-extendible.
- b) A power of attorney legalized from the UAE consulate is required to complete the application formalities. The deadline to file the legalized power of attorney related to new trademark applications is 30 days from the date of filing the application. As the power of attorney needs to be attested from the Ministry of Foreign Affairs, before it can be submitted to the Trademark Office, it should reach the UAE trademark agent a couple of days before the deadline.
- c) Multi-class filing is not possible in the UAE; hence, a separate application for each class needs to be filed.
- d) The UAE follows the NICE Classification of goods and services.
- e) The country is a signatory to the Paris Convention; hence, convention priority can be claimed within six months of the initial filing. A certified copy of the priority document is required for claiming priority.
- f) Absolute grounds check includes a check to ensure that the trademark meets the moral principles followed in the UAE. This means that the trademark should not have an adverse connotation or immoral depiction. Besides, the following trademarks cannot be registered in the UAE:

- A mark having no property or distinctive character or made of data being only the name

given by custom to goods or services or drawings and ordinary pictures of goods and services.

- Expressions, drawings, or marks breaching the public morals or violating the public order.
- Public emblems, flags, military and honour emblems, national and foreign decorations, coins, banknotes, and other symbols of the State, or other countries, or Arab or international organisations or one of their institutions, or any imitation thereof.
- Symbols of the Red Crescent or Red Cross and such other similar logos and the marks being an imitation thereof.
- Marks that are identical or like symbols having a religious nature.
- Geographical names and data if their use would create confusion as to the origin or source of the goods or services.
- The name, nickname, picture, logo or surname of a third party unless he/she or his/her heirs approve its use and registration.
- Particulars of honorary or academic degrees to which a registration applicant cannot prove legal entitlement.
- Marks that are liable to mislead the public or contain false information as to the origin or source of the goods or services, or as to their other characteristics, as well as trademarks that contain a trade name owned by others.
- Marks owned by physical or juristic persons with whom dealing is prohibited in accordance with the applicable legislation.
- A trademark that is identical or like another trademark previously filed or registered by a third party for the same or related goods or services, if the use of the trademark to be registered would create the impression that they are linked with the goods or services of the registered trademark owner or shall lead to harming their interests.
- Marks whose registration for some goods or services shall result in reducing the value of the goods or services distinguished by a previously registered trademark.
- Marks that constitute copies, imitations, translations, localisations, or any audio translation of a well-known trademark or part thereof, owned by others, for use in distinguishing goods or services identical or similar to those of the well-known mark.

- Marks that constitute copies, imitation, translation, localisation, or any audio translation of a well-known trademark owned by others, or an essential part thereof, for use in distinguishing goods or services that are not identical or similar to those distinguished by the well-known trademark, if such use indicates that there is a link between those goods or services and the well-known trademark; and if the registration of such a trademark is likely to harm the interests of the owner of the well-known trademark.
- Marks that include the following terms or expressions: *Concession, Concessionaire, Registered, Registered, Drawing, Copyright, or other similar terms and expressions.*
- Any three-dimensional mark consisting of a shape resulting from the nature of the goods specified in the registration application or necessary to achieve a technical result; without any substantive elements that distinguish it from others.

Oppositions in the UAE can be filed on grounds of local and foreign registrations and use. To succeed in an opposition based upon an unregistered mark, it is essential that the mark is well-known among the UAE public. The 30 days opposition period is non-extendible. To file an opposition, the original power of attorney duly legalized from the UAE consulate is required at the time of filing.

Other deadlines, including appeal periods, whether before the Trademark Office, Committee or Court are non-extendible. Late payment of publication or registration fees results in a fine.

Registration of a trademark is granted for a period of 10 years and is renewable perpetually for similar periods. Late renewal with fine can be conducted within six months of the initial expiry date.

The UAE Law stipulates that any third party may request cancellation of a registered trademark by filing a cancellation petition before the Registrar; however, in practice, cancellation of a registered trademark can be sought through filing a cancellation action before the Court of First Instance on either of the following grounds:

- a) The trademark was not used for a period of five years from the date of its registration.

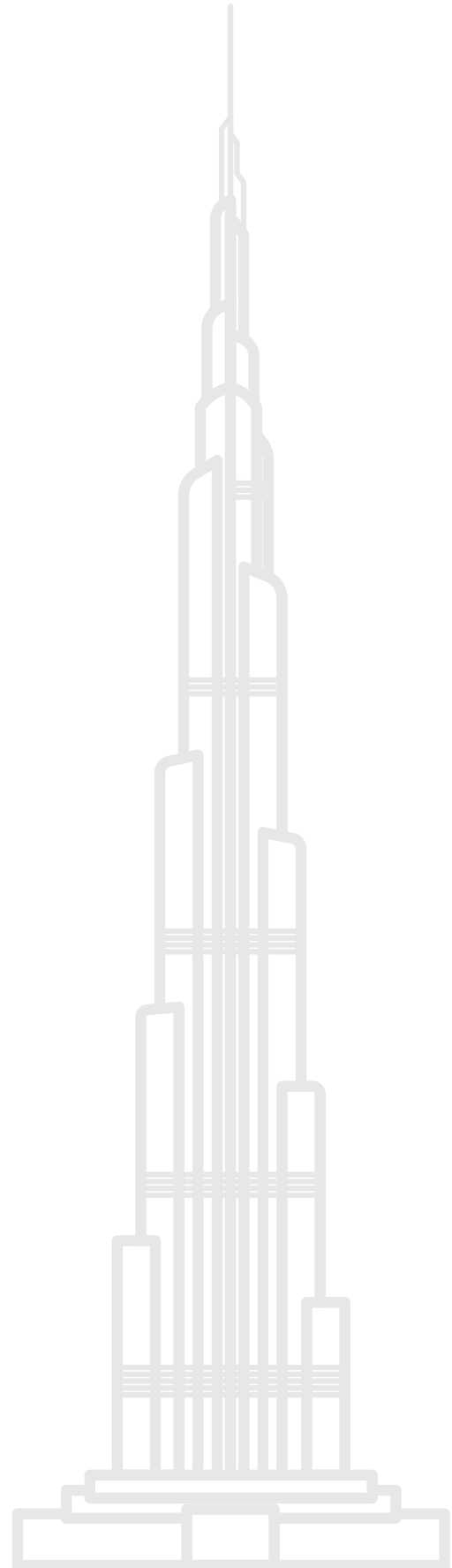


- b) The trademark was registered illegally. Such an action includes bad faith claims and is not struck by laches.

In addition to the main points, it is recommendable to conduct pre-filing trademark searches to clear the mark before filing. Search results can be obtained within one day. It is also recommended to clear and register trademarks in English as well as Arabic language, as the official language of the UAE is Arabic. Although cross-searches are usually not conducted during examination, at times, conflicting marks registered in class 35 are cited against applications filed in other classes; hence, registering the mark in class 35 enhances protection and provides a valid cause of action in trademark vs trade name disputes.

Seeking local legal counsel for clearance, registration, divestiture and enforcement matters is suggested, as the laws and procedures in the UAE at certain points do not correspond with the laws and procedures of other countries.

Audiri Vox attorneys have decades of experience in handling contentious and non-contentious trademark matters in the UAE and will be pleased to answer any questions that you may have. Please feel free to write to us at global@audirivox.com.



ARIJIT SINGH VS AI: SINGER WINS CASE AGAINST AI IMITATING HIS VOICE TO CREATE SONGS



Divyendu Verma
Global Head of Patents Practice

Case Ref.: Arijit Singh vs. Codible Ventures LLP & others.
[INTERIM APPLICATION (L) NO.23560 OF 2024] Decision dated July 26, 2024

Generative AI can do many things, including creating deep fakes. These deep fakes take your style of singing, speaking, drawing, acting, painting and many other such personal traits and then using these as the base create fakes that are not the work of the original person. These fakes have the potential to destroy the reputation of the original person as well as profit from misuse of the brand equity developed by the original person after going through a painful and expensive period of struggle to establish himself in the minds of people.

Recently, one famous playback singer realized that some AI websites were using his voice to create songs that he had never sung and making money out of them too.

Alarmed at this, he went to court and sought a permanent restraining order on the misuse of his voice.

In this landmark judgment, the Bombay High Court has ruled in favor of plaintiff against the unauthorized use of his voice by AI tools. This case marks a significant precedent in addressing the issue of voice cloning by AI. This is one of the first judgments addressing the issue of voice cloning by Generative AI Tool and sets a significant precedent in India.



The court held that the unauthorized use of a celebrity's personality traits such as name, image, likeness, and voice for commercial gain constitutes a violation of their personality rights and right to publicity. The court was particularly concerned about the vulnerability of celebrities, especially performers, to unauthorized generative AI content.

The court further stated that making AI tools available that enable the conversion of any voice into that of a celebrity without their permission is a violation of the celebrity's personality rights. Such tools facilitate unauthorized appropriation and manipulation of a celebrity's voice, which is a key component of their personal identity and public persona. This form of technological exploitation not only infringes upon the individual's right to control and protect their own likeness and voice but also undermines their ability to prevent commercial and deceptive uses of their identity. The court emphasized that any unauthorized distortion, mutilation, or other modification, or dissemination of the plaintiff's performances / voice or video recordings thereof, causing prejudice/harm to his reputation, would amount to a violation of the plaintiff's moral rights in his performances under Sections 38-B of the India Copyright Act, 1957.

38B. Moral rights of the performer.— The performer of a performance shall, independently of his right after assignment, either wholly or partially of his right, have the right,—
(a) to claim to be identified as the performer of his performance except where omission is dictated by the manner of the use of the performance; and
(b) to restrain or claim damage in respect of any distortion, mutilation or other modification of his performance that would be prejudicial to his reputation.

This judgment sets a significant precedent in the legal landscape of personality rights and AI technology. It underscores the necessity for strict regulations to safeguard individuals against the unauthorized use of their voice and identity.

INDIAN PATENT OFFICE ISSUES FAQs TO BRING CLARITY ON THE FILING REQUIREMENTS OF FORM-27:

On March 15, 2024, the Ministry of Commerce and Industry announced the Patents (Amendment) Rules, 2024, which brought about notable changes to patent procedures in India. A significant update was made to Form 27, the working statement. Previously, patent holders had to submit this statement annually. The new rules have relaxed this requirement to once every three years, with the first statement due within six months after the end of the third financial year.

On August 27, 2024, the Office of the Controller General of Patents, Designs, and Trade Marks (CGPDTM) issued a set of FAQs to address questions regarding the timelines for Form 27 and the recent amendments. These changes aim to streamline processes and improve compliance, making it easier for inventors and businesses to navigate the patent system in India.



Short Notes:

The FAQs outlines specific scenarios and associated timelines for filing Form-27 based on the date of patent grant. Here's a detailed breakdown:

1. Patents Granted Before FY 2022-23

- **Scenario:** If a patent was granted before the financial year (FY) 2022-23.
- **Filing Requirement:**
 - For patents granted before FY 2022-23, Form-27 for the period FY 2023-24 would be due from April 1, 2024, assuming that the Form-27 for FY 2022-23 was filed on time.

• Deadlines:

- **Initial Window:** April 1, 2026 - September 30, 2026 (For filing Form-27 for FY 2023-24 to FY 2025-26).

- **First Extension:** Up to December 31, 2026 (By filing Form 4 under Rule 131(2)).
- **Second Extension:** Up to June 30, 2027 (By filing Form 4 under Rule 138).
- **Further Extension:** If the patentee/licensee failed to avail an extension under Rule 131(2), the deadline can be extended up to March 31, 2027, under Rule 138.

• Important Note:

If the patentee/licensee missed the deadline for submitting Form-27 for FY 2022-23 or earlier under the previous rules, they cannot file Form-27 for these lapsed periods by clubbing them with the new block of three years under the Patents (Amendment) Rules, 2024.

2. Patents Granted in FY 2022-23

- **Scenario:** For patents granted during FY 2022-23.
- **Filing Requirement:**
 - A three-year period begins from FY 2023-24.
- **Deadlines:**
 - **Initial Window:** April 1, 2026 - September 30, 2026.
 - **First Extension:** Up to December 31, 2026.
 - **Second Extension:** Up to June 30, 2027.
 - **Further Extension:** Up to March 31, 2027, if the earlier extension was not availed.

3. Patents Granted in or After FY 2023-24

- **Scenario:** For patents granted in or after FY 2023-24.
- **Filing Requirement:**
 - **Case 1:** For patents granted in FY 2023-24, the three-year period starts from FY 2024-25.
 - **Case 2:** For patents granted in FY 2024-25, the three-year period starts from FY 2025-26.
- **Deadlines:**
 - **Case 1:**
 - **Initial Window:** April 1, 2027 - September 30, 2027.
 - **First Extension:** Up to December 31, 2027.
 - **Second Extension:** Up to June 30, 2028.

- **Further Extension:** Up to March 31, 2028.

- **Case 2:**

- **Initial Window:** April 1, 2028 - September 30, 2028.
- **First Extension:** Up to December 31, 2028.
- **Second Extension:** Up to June 30, 2029.
- **Further Extension:** Up to March 31, 2029.

4. Patents Expiring in FY 2023-24 and FY 2024-25

- **Scenario:** For patents expiring during these financial years.
- **Filing Requirement:**
 - Patentees/licensees can only file Form-27 for the remaining period before the patent expires.

- **Deadlines:**

- **Patents Expiring in FY 2023-24:**

- **Initial Window:** April 1, 2024 - September 30, 2024.
- **First Extension:** Up to December 31, 2024.
- **Second Extension:** Up to June 30, 2025.
- **Further Extension:** Up to March 31, 2025.

- **Patents Expiring in FY 2023-24:**

- **Initial Window:** April 1, 2025 - September 30, 2025.
- **First Extension:** Up to December 31, 2025.
- **Second Extension:** Up to June 30, 2026.
- **Further Extension:** Up to March 31, 2026.

Published FAQs [Link:](#)

https://ipindia.gov.in/writereaddata/Portal/News/1001_1_Final_FAQs_Form-27_26thAugust2024.pdf



IP UPDATES

IRAQ: ADOPTION OF THE 11TH EDITION OF THE NICE CLASSIFICATION



In a recently concluded meeting at the Iraq Trademark Office (ITO), attended by IP agents from across Iraq, the ITO announced its plans to adopt the 11th Edition of the International Nice Classification of Goods and Services.

Although no formal announcement has been issued yet, the implementing regulations are expected to be released in January 2025.

It remains unclear whether the ITO will allow multiple classes in a single application or permit the use of sub-classes. Further details are anticipated once the regulations are officially published.

LIBYA: LIBYAN TRADEMARK OFFICE RESUMES FILING OF NEW TRADEMARK APPLICATIONS



The Libyan Trademark Office (TMO) has announced that it will resume accepting new trademark applications starting September 2, 2024. This decision comes following a Ministerial Decree authorizing the TMO to fully recommence its operations after a period of significantly limited capacity.

SAUDI ARABIA: SAUDI ARABIA AND INDONESIA FORGE PARTNERSHIP TO ENHANCE INTELLECTUAL PROPERTY FRAMEWORK



Saudi Arabia and Indonesia have signed a Memorandum of Understanding (MoU) to collaborate on strengthening their intellectual property (IP) ecosystems. The agreement was formalized on the sidelines of the World Intellectual Property Organization (WIPO) meeting in Geneva.

This cooperation aims to create synergy and mutual benefits in managing and developing IP systems in both countries. Under the framework, the two nations will exchange expertise on challenges related to IP system development and the utilization of IP networks. The collaboration includes sharing strategies and best practices, particularly in leveraging advanced technologies such as artificial intelligence in IP management.

The agreement also encompasses information management, training, and the development of human resources, as well as the formulation of regulations and policies related to intellectual property. Additionally, both countries will work together to promote and raise awareness of the importance of IP rights.

This MoU underscores the commitment of Saudi Arabia and Indonesia to innovate and adapt to evolving international IP regulations and technologies, bringing significant benefits to both countries in developing and protecting their intellectual properties.

UAE:

UAE RECEIVES ITS FIRST SOUND MARK FILING: A MILESTONE IN INTELLECTUAL PROPERTY PROTECTION



In a significant development, the United Arab Emirates (UAE) has received its first-ever sound mark filing under the nation's robust trademark laws. This filing marks a pivotal moment in the evolution of intellectual property protection in the UAE, further solidifying its reputation as a leader in safeguarding non-traditional trademarks.

The UAE has long been recognized for its comprehensive approach to protecting various forms of intellectual property, including non-traditional marks such as three-dimensional shapes, colors, and now, sound marks. This latest milestone reflects the country's commitment to embracing and advancing the protection of innovative and non-conventional trademarks, in line with international best practices.

The introduction of sound marks into the UAE's IP framework opens new avenues for businesses to protect their brand identity in unique ways, catering to the evolving landscape of global commerce. This also demonstrates the UAE's proactive stance in adapting its legal frameworks to accommodate the changing dynamics of intellectual property in the modern world.



INDIA: TRADE MARKS CASES



KABUSHIKI KAISHA TOSHIBA (Plaintiff) vs
TOSIBA APPLIANCES CO. (Defendant)

Case No.: - CS(OS) 55/2006 & I.A. 784/2023

Decided On: – August 16, 2024

The present suit was filed by the plaintiff from restraining the defendant from using the mark “TOSIBA” which is phonetically similar to plaintiff mark “TOSHIBA.” The plaintiff argued that defendants use of the mark “TOSIBA” is dishonest and in bad faith. The defendant argued that their mark “TOSIBA” had an uninterrupted use of over 31 years in contrast to plaintiff’s mark which was registered merely on proposed-to-be-used basis and never has been used commercially since its registration in India. The Hon’ble Delhi High Court passed a decree for permanent injunction in favour of plaintiff restraining the defendant from using mark “TOSIBA” or any other mark deceptively similar to plaintiff’s mark.

LACOSTE & ANR. (Plaintiffs) Vs CROCODILE INTERNATIONAL PTE LTD & ANR. (Defendants)

Case No.: - CS(COMM) 1550/2016

Decided On: – August 14, 2024



The plaintiffs initiated the suit against the defendants for protecting their copyright and trademark rights. The

plaintiff alleges that the defendant is using the mirror image of their mark on the apparels produced by the defendants. The defendants argued that the plaintiff is breaching their prior agreement regarding co-existence of their mark in the Asian countries. The Hon’ble Delhi High Court issued a decree of permanent injunction in favour of the plaintiff and restraining the defendants from using the trademark in any other manner. The Hon’ble Court in view of infringement asked the defendants to render their statements of accounts of profit earned from the goods sold.

NEELA FILM PRODUCTIONS PRIVATE LIMITED (Plaintiff) vs TAARAKMEHTAKAOOLTAHCHASHMAH.COM & ORS. (Defendant)

Case No.: - CS(COMM) 690/2024, I.A. 36509/2024, I.A. 36510/2024, I.A. 36511/2024, I.A. 36512/2024, I.A. 36513/2024 & I.A. 36514/2024

Decided On: – August 14, 2024

The plaintiff had filed a suit for a permanent injunction for restraining infringement of copyright and trademark, misappropriation of publicity rights etc. The plaintiff argued that defendants are infringing the plaintiff’s rights by displaying, communicating to the public, hosting, utilizing content of the plaintiff Show Taarak Mehta Ka

Oolta Chashmah, every right concerning to which exclusively belongs to the plaintiff. Also, the defendant nos. 20 and 21 are publishing videos on YouTube, wherein, they are sharing sexually explicit and vulgar content using the name and image of the characters of the show. The Hon’ble Delhi High Court observed that the plaintiff has demonstrated a prima facie case for grant of injunction in its favour, and in case ex-parte ad interim injunction is not granted, plaintiff will suffer an irreparable loss. Accordingly, the Hon’ble Court ordered ex parte ad-interim injunction restraining the defendants from doing any activity that in any manner amounts to infringement or passing off, of the plaintiff’s copyrighted material or registered trademarks.

SHRI RAJESH CHUGH (Petitioner) vs MEHRUDDIN ANSARI & ANR. (Respondents)

Case No.: - CS(COMM.IPD-TM)28/2024 & I.A. 3613/2024

Decided On: – August 05, 2024

The petitioner filed a suit against respondent no.1, seeking the removal of the trademark ANDAAZ-E-NIZAAM, claiming it



was deceptively similar to their registered trademark NIZAM’S. The petitioner argued that ANDAAZ-E-NIZAAM was phonetically and visually similar to their mark and had been used since 1978. The respondent admitted to no longer using ANDAAZ-E-NIZAAM and agreed to rebrand as DAAWAT-E-NIZAMUDDIN or ANDAAZ-E-NIZAMUDDIN. The Hon’ble Delhi High court observed that the trademark ANDAAZ-E-NIZAAM had been abandoned and was no longer in use. Consequently, the Hon’ble Court ordered the cancelation of ANDAAZ-E-NIZAAM’s registration and directed the Registrar of Trademarks to update the records accordingly.

CALVIN KLEIN TRADEMARK TRUST (Plaintiff) vs MR. SUNNY SACHDEVA TRADING AS M/S HACHE SHIRTS & ORS. (Defendant)

Case No.: - CS(COMM) 914/2022 & I.A. 22315/2022
Decided On: – August 02, 2024

The plaintiff had filed a suit for a permanent injunction against the defendant for trademark infringement, copyright violation, and dealing in counterfeit Calvin Klein products. Plaintiff argued that the defendants were selling counterfeit goods under the Calvin Klein brand,

infringing on their registered trademarks and copyrights. Despite being served and expressing an initial desire to settle, the defendants failed to file a written statement. The Hon'ble Delhi High Court observed that the defendants were indeed found with infringing goods, as confirmed by a Local Commissioner's report. Consequently, the Hon'ble Court decreed in favour of plaintiff, imposing costs of 35,000 on the defendants and authorizing plaintiff representatives to take possession of the seized counterfeit goods.

CHARLES AND KEITH INTERNATIONAL PTE LTD
(Petitioner) vs **AMBUD SHARMA & ANR** (Respondents)

CASE NO. - C.O. (COMM.IPD-TM) 322/2023 & I.A. 25301/2023

DECIDED ON – August 01, 2024

The petitioner filed a petition seeking the removal of the respondent's mark  registered in Class 09 for

breathing masks. The petitioner argued that their marks “

CHARLES & KEITH, CHARLES & KEITH, CHARLES & KEITH  and 

was well-known and prior in use, while the respondent's registration was on a 'proposed to be used' basis and not in actual use. The respondent agreed to cancel the registration, stating no interest in the goods. The Hon'ble Delhi High court observed that the petitioner's mark was established and that the respondent had no objection to the cancellation. The Court ordered the cancellation of the respondent's mark in Class 09 and directed rectification of the trademark register accordingly.

UNDER ARMOUR INNOVATE C.V. (Plaintiff) vs ARMARIO CLOTHING AND ACCESSORIES AND ESSA KAZIM FAZAL ALI ABIDI (Defendant)

Case No.: - CS(COMM.) /389/2019

Decided On: – July 30, 2024

The plaintiff had filed a suit against the defendant initially using the “John Doe” principle, to stop trademark infringement and passing off of counterfeit goods under



the "UNDER ARMOUR" label. The defendants did not file a written statement or challenge the claims. The plaintiff argued that their trademark “UNDER ARMOUR” with the punchline “I WILL” is well-known and that the defendants' use of similar marks causes consumer confusion and damages their reputation. The Hon'ble Delhi district court, after

considering the evidence, observed that the defendants were engaged in illegal activities and granted a permanent injunction in favour of plaintiff, restraining the defendants from using the infringing trademarks. The Hon'ble Court suggests that the defendants' failure to participate in the case deprived the plaintiff of the benefit of rendition of accounts. Thus, the Hon'ble Court leans towards awarding damages in light of the overall circumstances.

MANGALAM ORGANICS LTD. (Plaintiff) vs PATANJALI AYURVED LTD. & ORS. (Defendants)

Case No.: – I.A. (L) NO. 4586 OF 2024, I.A. (L) NO. 22226 OF 2023, COMM IPR SUIT (L) NO. 21853 OF 2023

Decided On: – July 29, 2024

In the present suit the plaintiff seeks enforcement of the ex-parte ad-interim order. The plaintiff argued that despite being aware of the order, the defendant continued selling impugned products in violation of the Hon'ble Court's directive. The Plaintiff has provided evidence of ongoing sales and requests punishment for contempt, including simple imprisonment for the defendants. The defendant in the affidavit in reply stated that as soon as he became aware of the injunction order he stopped its sales team from selling and supplying the product. The Hon'ble Bombay High Court found the respondent in wilful contempt of Court for violating the ex-parte ad-interim order and directed the respondent to make payment of Rs. 50,00,000/- Rs. and 4,00,00,000/- within a period of two weeks and failing to make payment will result in civil imprisonment. Accordingly, the interim application is disposed.

SAJ FOOD PRODUCTS PVT LTD (Petitioner) vs. M/S PARLE BISCUITS PVT LTD (Respondent)

Case No. - IA No.GA-COM/2/2024 In IP-COM/16/2024

Decided On – July 19, 2024

Petitioner mark:



Respondent mark:



The petitioner under the brand “BISK FARM,” sought an ad interim injunction against the respondent for using the mark “TOP GOLDSTAR,” which allegedly infringes on the petitioner's established mark “TOP

GOLD.” The petitioner argued that the respondent's mark is confusingly similar and unfairly exploits their reputation. The Hon'ble Calcutta High Court found that the petitioner's mark had been used extensively since 2005 and was well-protected under trademark and copyright laws. The Hon'ble court observed that the respondent's use of a similar mark could cause irreparable harm to the petitioner. Consequently, the Hon'ble Court granted an injunction restraining the respondent from using “TOP GOLD” or “TOP GOLDSTAR” but allowed the use of “TOP” without “GOLD.”

PATENTS CASES

BASF SE (Appellant) vs. JOINT CONTROLLER OF PATENTS AND DESIGNS AND ORS (Respondents)

Case Number: IA No. GA-COM/1/2024 In IPDPTA/5/2024

Decided on: August 05, 2024



The current appeal has been filed by the appellant against an order passed by the respondent, the respondent then raised an objection that the appellant failed to file the appeal in accordance with Rules 8, 9 and 10 of Part-12A of Chapter XXXVIII of the Rules under the Patents Act, 1970. The appellant submitted that they have filed an appeal enclosing certified copies along with an application praying for condoning the delay of 14 days and the same was listed before the court under the heading "New Motion" enabling the Court to consider the application for condoning the delay. The appellant has filed the appeal being IPDPTA/5/2024 on the same date i.e., on 19th June, 2024 as filing an application being GA-COM/1/2024 and after the filing the department had listed the matter under the heading "New Motion" before the Court on 28th June, 2024.

The Hon'ble Calcutta High Court observed the following matter and finds that the appellant has not violated any rule as objected by the respondent. The Hon'ble Court states that the appellant has submitted sufficient cause to explain the delay in preferring the appeal beyond the prescribed time. Hence, the Hon'ble Court concluded that the stand taken by respondent cannot be sustained, disposing GA-COM/1/2024 and admitting the appeal being IPDPTA/5/2024.

Novartis AG & Anr (Petitioner(s)) vs. Natco Pharma Limited (Respondent(s))

Case Number: 16237 OF 2024

Decided on: August 02, 2024



In the present case, the special leave petition has been filed

against the judgment of the Division Bench. The Divisional Board has set asides parts of a judgment of the Single Judge granting an interim injunction restraining the respondent in a patent infringement suit. The Supreme Court noted that the appeal was heard by the Division Bench between November 2023 and 7 March 2024 wherein the patent was expired on 21 May 2023 so it was unnecessary for the Division Bench to enter upon a detailed review on merits, as it did in the course of its judgment since the injunction had already been issued by the Single Judge which would cease to have practical relevance once the patent is expired.

The Hon'ble Supreme Court observed the following issue and set aside the judgement of the Division Bench and the Single judge and stated that neither of the two orders will be cited as precedent in any other case. Hence, the Hon'ble Court issued an order of disposing of the special leave petition.

STAR SCIENTIFIC LIMITED (Appellant) vs. THE CONTROLLER OF PATENTS AND DESIGNS (Respondent)

Case Number: C.A.(COMM.IPD-PAT) 20/2024

Decided on: July 30, 2024

The present appeal has been filed by the appellant w.r.t the rejection of the patent application by the respondent under Section 15 of the Patent Act. The respondent had rejected the appellant's patent application as the appellant failed to attend the hearing without any prior instructions. The appellant argued that the application cannot be considered as abandoned just because of not attending the hearing as the appellant had also sent an email as directed by the respondent explaining the reason for not attending the hearing. The respondent alleges that the appellant is misleading the Court, and that the appellant has failed to provide relevant proof for the given explanation. The Hon'ble Delhi High Court observed that the respondent did not analyze or assign any specific reason

for refusing the grant of patent. The Court disagrees with the respondent as the appellant had already filed a detailed reply to the FER and the appellant has also requested for disposal of the patent application. The Hon'ble Court concluded stating that such a decision has to be made by a reasoned and Speaking Order and further directed the respondent to consider the matter afresh.

AB INITIO TECHNOLOGY LLC (Appellant) vs. ASSISTANT CONTROLLER OF PATENTS AND DESIGNS (Respondent)

Case Number: C.A.(COMM.IPD-PAT) 26/2021

Case Number: C.A.(COMM.IPD-PAT) 447/2022

Decided on: July 30, 2024

The appellant has filed the present appeal against the respondent for rejecting the appellant patent application under Section 3(k) and Section 16(1) of the Patent act. The respondent rejected the patent application under Section 3(k) as claims do not disclose any constructional of structural features rather represents an algorithm and under Section 16(1) and 16(3) of the Act, as there is no distinct invention compared to granted claims of the parent application. The appellant argued that the subject application contains "technical effects". The respondent refuted the appellant's contention and claimed that the whole process did not affect the internal functioning of a computer.

The Hon'ble Delhi High Court observed the following issue and stated that the claimed invention has intended technical use and technical applications without limiting the claim by specifying one particular use, therefore, the objection of non-patentability under Section 3(k) cannot sustain. The Hon'ble Court also stated that the objection was taken in respect of only one of the subject applications, and not both subject applications, therefore objection under Section 16(1) does not sustain. The Hon'ble Court concluded by remanding the matter for fresh consideration on the aspect of Section 2(1) (ja) of the Act and directed that a de novo hearing notice may be issued examining the matter afresh within a period of three months.

mitsui chemicals inc (Appellant) vs. CONTROLLER OF PATENTS (Respondent)

Case Number: C.A.(COMM.IPD-PAT) 196/2022

Decided on: February 23, 2024

The current appeal has been filed by the appellant w.r.t the rejection of the patent application by the respondent under Section 59(1) and section 3 (h) of the Patents Act, 1970. The appellant submitted the amended claims while filing the FER response as well as SER response for the objection under Section 3(h) of the Act. The respondent has rejected the amendments citing Section 59 of the Act. The Hon'ble Delhi High Court observed the following matter and stated that the respondent has made error while assessing the amended claims and the order lacks any substantive analysis or justification explaining precisely why the specific subject matter of the claims falls squarely within the ambit of Section 3(h) of the Act. The Hon'ble Court hence concludes stating to reconsider the matter, the matter is remanded to the respondents for de novo consideration, providing the hearing to the appellant and the decision shall be rendered within a period of four months from the date of conclusion of hearing.



COPYRIGHT CASE

M/S.BHARANI PICTURES PRIVATE LIMITED (Plaintiff) vs. NARNE MEDIA SOLUTIONS PVT.LTD. (Defendant)

Case No.: - (Comm.Div.) No. 181 of 2023

Decided On: – July 02, 2024

The plaintiff filed a civil suit against the defendant under the Copyright Act, seeking a declaration of ownership and permanent injunction to prevent copyright infringement of their films. The plaintiff claimed exclusive rights to the films and alleged unauthorized telecasting by the defendant. The defendant was set ex-parte due to non-appearance. The Hon'ble Madras High court found the plaintiff's claims substantiated by evidence, noting the defendant's infringement and failure to respond. The suit was decreed in favour of the plaintiff, granting all requested reliefs including a permanent injunction and damages of 25,00,000 with interest.





309 Churchill Tower Business Bay, P.O. Box 415116 Dubai-United Arab Emirates
+971 4 582 6655
global@audirivox.com



www.audirivox.com

Editorial Board

Sarmad Hasan Manto
Attorney at Law
Managing Partner

Divyendu Verma
Attorney at Law
Head of Patents Dept.

Vindo Chand
Content Editor

Nilesh B.
Designer

Disclaimer: This publication is intended to provide information to clients on recent developments in IPR industry. The material contained in this publication has been gathered by the lawyers at Audiri Vox for informational purposes only and is not intended to be legal advice. Specifically, the articles or quotes in this newsletter are not legal opinions and readers should not act on the basis of these articles or quotes without consulting a lawyer who could provide analysis and advice on a specific matter.

© 2023 Audiri Vox

This Newsletter is published by Audiri Vox at 309 Churchill Tower Business Bay, P.O. Box 415116 Dubai-United Arab Emirates 5th September, 2024.