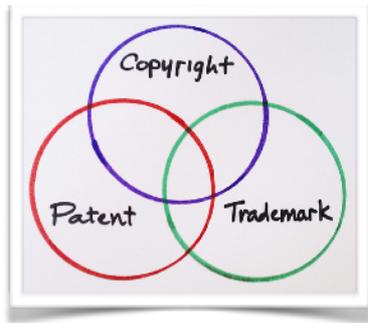


# INTELLECTUALIS

INTELLECTUAL PROPERTY RIGHTS COMMITTEE | SCHOOL OF LAW, CHRIST (DEEMED TO BE UNIVERSITY) | SEVENTH EDITION 2019-20



Source: China Law Blog, <https://www.chinalawblog.com/2016/07/china-trademarks-patents-and-copyrights-a-different-sort-of>

- Singer Beyoncé Knowles has claimed her daughter Blue Ivy is a "cultural icon" and that the name should be trademarked
- Actor also influential politician Rajnikanth has applied for registration of trademark of six television channels, out of which, two channels – Rajni TV and Thalaivar TV have been registered in the trademarks journal under class 38.



Source: Panitch Schwarz, <http://www.panitchlaw.com/knowledge-center/2018/11/waiting-to-enforce-your-trademark-rights/>

## WHAT'S IN A NAME?

### **Beyoncé's legal battle with wedding planning company for trademarking her daughter's name**

*-Amala Govindarajan, 1850340 and Lepakshi N Naik, 1850450*

A trademark is a type of intellectual property consisting of a recognizable sign, design, or expression which identifies products or services of a particular source from those of others. Trademarks were introduced in order to protect the rights of the producer/provider from being misrepresented in the market through substandard producers/providers mimicking their products causing losses, unfair competition and free raiding on another's reputation. It was also introduced in order to secure the interest of the consumer from being cheated by the fake producers/providers in the market. Thus, it was essential for there to be a mechanism

of identification and penalization to protect the interest of various parties. There are various types of Trademarks and it has become a new trend for famous individuals to trademark their personal names in order to prevent another person or organization from using their names to create a profit. The most recent case is Beyoncé's trademark battle for procuring a trademark for the name of her daughter Blue Ivy Carter.

In this case Blue Ivy, who is the eldest daughter of the two most famous performers in the world Beyoncé and Jay-Z has a very strong media presence and following. She has been well spoken off and covered by the media on several occasions. Blue Ivy since a very young age has obtained a popularity which has granted her name with a secondary meaning which is her identity.

Beyoncé has made continuous efforts in order to Trademark her daughter's name since her birth.

Trademarking personal names of people who are well known by the public has occurred several times. Sarah Palin has trademarked (more specifically a service Mark) her name under the category of "Educational and Entertainment services, namely, providing motivational speaking services in the field of politics, culture, business and values". In the same way Morgan Freeman has Trademarked his name under the category of "Entertainment services, namely, live, television and movie appearances by a professional entertainer". Trademarks are granted to personal names only when there is a business use of that particular name, these business use should be a specific category under the product and services list. Marking a particular name under one category prohibits any individual from using that name in the listed field and doesn't prohibit any individual from using it in another field.

This trademark issue has become contentious again due to the claim of Wendy Morales who runs a wedding planning company named Blue Ivy Events. To counter the same, Beyoncé states that her daughter is a cultural icon and has been mentioned and appreciated by various news portals and papers about the same. Beyoncé says Morales runs a "small business, with just three regional offices and a handful of employees", with weak online presence and poorly subscribed social media accounts. As she has such a widespread presence and appeal she could in the future use her own name to start a fashion brand, and this plea falls under the "intent-to-use" category of patents

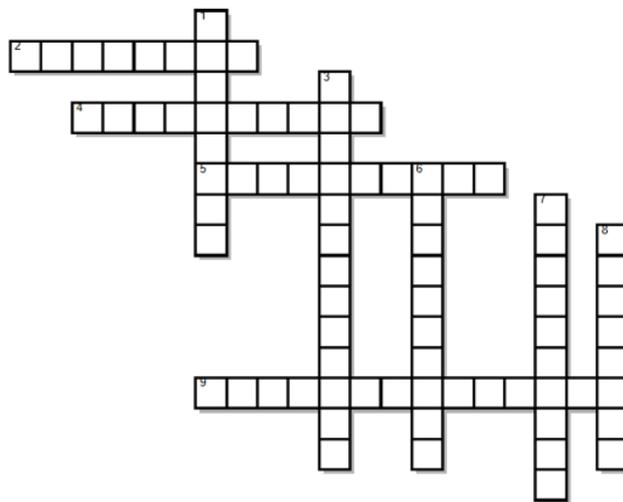


Source: Daily Mail Online, <https://www.dailymail.co.uk/tvshowbiz/article-7501879/Beyonce-declares-Blue-Ivy-Carter-cultural-icon-amid-legal-battle-trademark-daughters-name.html>

where an applicant must have a bona fide intent to use the mark in commerce for all goods or services specified in the application to patent. Morales countered this by saying that the accepted definition of a cultural icon is an artefact that is identified by members of a culture as representative of that culture,' such as apple pie, baseball, and the United States Flag.” Beyoncé and Jay-Z were denied the “Blue Ivy Carter” trademark back in October 2012, with the intention of using the name for a variety of products. The judge sided with Morales back then, and the case has continued on ever since.

## CROSSWORD

- Prateek Singh 1950122 & Khyati Kapoor 1950349



### ACROSS

- 2 The party who is selling or otherwise transferring ownership of a trademark.
- 4 A way of locating a word mark that is comprised of an alternative or intentionally corrupted spelling of an English word.
- 5 A treaty between Bolivia, Colombia, Ecuador, Peru, and Venezuela that includes an understanding on trademarks.
- 9 These are marks that cannot receive protection through the courts nor registration with the U.S. Patent and Trademark Office.

### DOWN

- 1 A type of trademark comprised of text.
- 3 This refers to an attribute of a product which may not be protected under trademark law.
- 6 It is the legal transfer of ownership of any property such as a trademark or copyright from one owner to another.
- 7 The overall image of a product used in its marketing or sales that is composed of the non-functional elements of its design, packaging, or labelling.
- 8 An international treaty dealing covering trademarks. Mercosur is also known as the Southern Common Market.

1 C	O	P	Y	R	I	G	H	T	
5 Y		3 A						2 R	
B		T		R				A	
E		E		E	A	T	A	4 D	
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S	A	T	A	D	A	T	E	7 M	
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6 E	N	C	R	Y	P	T	I	O	9 N
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1. Photographs are covered under which form of IP?
2. The word "Netflix" is protected under which form of IP?
3. What form of IP protection is extended to novel and non-obvious inventions
4. Information that has been translated into a form that is efficient for movement or processing
5. An electronic medium used to form a global computer network to facilitate online communication.
6. The cryptographic method which protects sensitive data by using an algorithm to transform information to make it unreadable for unauthorized users.
7. Data that describes other data.
8. Block chain is a distributed, decentralized, public \_\_\_\_\_.
9. \_\_\_\_\_ Classification is a system of classifying goods and services for the purpose of registering trademarks.
10. The global forum for intellectual property (IP) services, policy, information and cooperation.

## I.N.T.A COMES TO INDIA!

- Ankita Malik, 1750145

The International Trademark Association (INTA) conducted its Indian Annual Meet on the 23rd of September 2019, in New Delhi which was the first board meeting of its kind to be held in the country. The Annual Meet was followed by a Workshop on “Made in India: Evolving Trends in Brand Protection” on 25th September 2019 in New Delhi. This entire leadership meeting was significant for India in several ways. The International Trademark Association has focused its attention on its initiatives in the country where there have been annual high-level delegations to India for eight years now, along with ongoing collaboration with the government, regular educational programming, multiple advocacy endeavours etc.



The Indian trademarks arena has observed an evolution considering the advances in trademark protection and enforcement along with the adoption of digital tools affecting daily practice.



Moreover, with regard to the policy making, the wheels continue to move forward with the implementation of a forward-looking National Intellectual

Source: INTA, [inta.org](http://inta.org)

Property Rights Policy and the encouragement of innovation at the national level with which the nation is stepping into an exciting period where it is taking control of the way its IP is created, developed, and protected. Moreover, the India Global Advisory Council also met for its second in-person meeting of 2018 and discussed its objectives where several initiatives were proposed and advocacy opportunities identified, including advocating for customs coordination in South Asia and statutory damages for intellectual property rights (IPR) disputes in India.

The first session was revolving around the ‘Emerging Trends in Trademark Protection and Litigation in India’ where the panel discussed issues pertaining to a greater ease in filing and the leapfrogging of procedure timelines in the Indian Trademark Office, enabled by the digital platform. There was also debate around the establishment of commercial courts in India and the significant shift it has created in trademark protection and the specific protection offered to well-known marks under the Trade Marks Rules, 2017. The second session was regarding the need for a national IPR Centre in India where the focus was upon the Indian National Intellectual Property Rights (IPR) Policy of 2016 which was adopted to strengthen IP awareness, enforcement, commercialisation, and administration and to facilitate an environment of innovation.

The third session was organised to analyse the requirement of graphical representation in the context of nontraditional marks and deliberate on the same and the last session titled ‘IPSO FACTO AI’ was regarding Artificial intelligence (AI) and blockchain which are two



Source: INTA, [inta.org](http://inta.org)

major technologies impacting the way all industries do business. These technologies even affect how IP offices do business and how trademark teams function on a daily basis. The panel mainly discussed the evolution of blockchain technologies, covering the first open-source code, rise in patent filings, importance of patent portfolio development, and implications for companies not

working directly in this space, and whether these technologies will bring about heavy licensing costs or more litigation.

The meeting followed by the workshop was a step forward for India’s trademark regime where various speakers brought different perspectives with regard to the evolving trends in trademark and brand protection.

### FIND THE WORDS!

*-Anirudh Vyas, 1950507*

E	T	H	U	S	T	R	U	S	T	Y	B	A	E	N	G
C	O	M	M	E	R	C	I	A	L	I	E	S	C	A	T
A	G	Y	E	J	A	F	X	D	R	G	M	E	N	T	F
B	D	N	D	T	N	H	X	V	A	D	T	N	E	R	V
A	R	O	V	U	S	G	H	E	E	Y	B	F	C	E	E
M	Y	I	Y	J	A	L	F	R	A	N	C	H	I	S	E
A	V	T	W	B	C	O	F	T	N	E	A	A	L	I	S
S	W	A	Y	H	T	U	F	I	T	G	N	X	V	D	G
T	O	R	T	X	I	D	A	S	A	D	N	A	T	U	A
E	B	T	R	T	O	E	Y	I	T	X	O	G	V	A	M
R	W	S	E	H	N	R	E	N	F	T	G	S	S	L	E
I	S	I	T	I	A	S	V	G	W	W	Y	R	H	F	S
O	T	G	S	W	L	A	N	H	A	M	W	F	A	G	B
A	G	E	O	G	R	A	P	H	I	C	A	L	W	Y	O
D	S	R	T	F	R	A	N	D	O	M	I	S	E	I	T

1. A trademark helps a business to differentiate its\_\_\_\_\_activities from the other activities.
2. Intellectual property law has three important divisions: substantive law, procedural law and \_  
law.
3. Comparative\_\_\_\_\_can be a powerful tool when it comes to making your product or service  
standout without infringing a trademark law.
4. \_\_\_\_\_ indication identify a good originating from a particular place, just like how a  
trademark identifies a good or service as originating from a company.
5. When you\_\_\_\_\_your business, a primary legal right that you will be granting is the license  
and right to use your trademark.

6. A trademark\_\_\_\_\_is basically an agreement in which a trademark owner permits someone else to use his trademark.
7. The ‘R’ symbol confirms that the trademark has gone through \_\_\_\_\_process.
8. The\_\_\_\_\_Act is the primary federal trademark statute of law in the United States.
9. \_\_\_\_\_goodwill is the legacy ability of a trademark to identify the source of a product after it is no longer produced.
10. \_\_\_\_\_goods are genuine branded goods obtained from one market that are subsequently imported into another market and sold there without the consent of the owner of the trademark.

#### LAST WEEK’S ANSWER

1. Patent protection is granted only in regions in which it has been applied for, hence making it \_\_\_\_\_
2. Commercialisation of patents is possible by \_\_\_\_\_ the patents.
3. The term of Patent violation
4. When patent protection ends, the invention enters the \_\_\_\_\_
5. Consideration/ Payment for licensing one’s Patent
6. What kind of patents can be protected?
7. Patent is an exclusive right granted to an \_\_\_\_\_
8. Main IP Treaty
9. The proprietor of the patent is the \_\_\_\_\_

E	B	J	L	P	I	N	N	O	V	A	T	I	O	N
O	A	R	C	E	I	T	U	M	O	W	F	S	O	I
A	B	Q	Z	K	X	N	A	O	T	R	Y	I	R	A
I	N	F	R	I	N	G	E	M	E	N	T	G	P	M
Y	D	Y	J	V	B	O	Q	D	A	N	L	V	E	O
T	Y	A	M	X	I	L	S	G	E	O	A	T	H	D
L	I	C	E	N	S	E	H	V	F	F	Y	U	T	C
E	E	X	W	C	X	G	N	I	U	G	O	K	P	I
V	K	W	E	P	U	O	V	M	A	B	R	H	F	L
O	L	W	C	N	C	N	O	R	X	F	U	S	T	B
N	M	A	H	S	U	O	I	V	B	O	N	O	N	U
A	L	A	I	R	O	T	I	R	R	E	T	M	L	P
O	D	R	B	Q	S	M	O	G	C	M	S	U	E	C
X	A	S	N	I	J	B	P	Y	X	L	E	E	A	B
P	K	Y	A	Z	A	X	I	N	V	E	N	T	O	R

-Sindhu A Gowda, 1650167

## CYBERSQUATTING AND TRADEMARK INFRINGEMENT

-Sandra Elizabeth George, 1850558

Cybersquatting is the act of using a domain name maliciously so as to gain from the goodwill and reputation of a well known trademark which does not belong to the cybersquatter, who then offers to sell the domain name to the rightful owner of the trademark for a price much higher than what he bought it for. The cybersquatter plays some ugly tricks like using the domain in a manner that would bring down the reputation of the trademark owner so that the trademark owner is left with no other choice than to buy the domain for the unreasonable price in order to save his hard earned reputation and goodwill.

One of the common type of cybersquatting is typo squatting which profits from the typographical errors people usually tend to make. For this, common misspellings are studied and they make a domain name which is closely similar to the well known trademark, the only difference could be a single letter in the name. Such a variant of a popular trademark will send those people who wanted to search about the popular trademark to the cybersquatter's domain if they make a small typographical error, thus increasing the traffic to the cybersquatter's domain. The problem arises when the actual trademark owners are not able to use their trademark in their domain name as it is already registered as a domain name by a cybersquatter. In this manner, a cybersquatter violates the right of a trademark owner to use his trademark in the way he wishes, which is one of the primary right of any intellectual property rights owner – to utilise and benefit from his own invention. The trademark owner will then have to pay very high prices to buy from the impostor the domain name that is rightfully his.

### Mechanisms regulating cybersquatting

One of the main policy brought about by ICANN ( Internet Corporation for assigned names and numbers) for this problem of cybersquatting is Uniform Domain Name Dispute Resolution Policy (UDRP). From 1999, it has been used to resolve more than 20,000 disputes over right to domain names in an efficient and cost effective manner. Though India does not subscribe to UDRP, it has formulated IN Dispute Resolution Policy ( INDRP) in the lines of UDRP. It is a mandatory dispute resolution policy used in India with relevant references to the provisions of Indian IT Act, 2000. But, there is no

#### **Trademark on Liverpool – Rejected!**

**Liverpool FC had insisted that it needed the trademark on the word “Liverpool” in order to prevent the sale of inauthentic products I.e., unauthorized clothing to it's fans. But the Intellectual Property Office has rejected this application.**

legislation in India which explicitly provides for dispute resolution in cases of cybersquatting. Even the Trademarks Act, 1999 is inadequate to solve such kind of problems. But law regarding this has evolved over time through judgements in various cases. In the Delhi High Court case *Manish Vij v IndraChugh*, cybersquatting was defined as “an act of obtaining fraudulent registration with an intent to sell the domain name to the lawful owner of the name at a premium”.

### Conclusion

An urgent need for a new legislative provision regarding cybersquatting is felt as the current mechanisms need to be supported by a legislation for its proper implementation and effectiveness. The protection given against cybersquatters are inadequate while such malpractices are on rise. The trademark laws are not sufficient enough to deal with the infringements happening in the cyber space. The IT Act has also not been developed enough to include cybersquatting. In such a situation, Indian courts now fall back on the decisions of the American and English courts and their laws in order to give judgement. It is thus inevitable that a legislative provision be made in India regarding cybersquatting and the trademark issues that arise out of it in order to preserve the true essence of Intellectual Property rights and thus encourage innovation.

### References

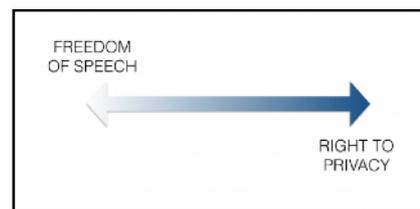
- Cyber-squatting and Trademark issues – Uniform Domain Name Dispute Resolution Policy, Pranjali Silimkar
- Cyber-squatting and Trademark infringement, Monica Kilian, Murdoch University Electronics Journal of Law

## **JURISPRUDENTIAL DEVELOPMENT IN TRADE MARK LAW, PRIVACY AND FREEDOM OF SPEECH**

*- Maria Grisha Borges, 1750557*

Trademarks are used to reflect the goodwill of the products and indicate supply-chain integrity. Essentially, trademarks are exclusive rights granted to a brand. This implies that trademarks are in fact privacy rights which are accorded protection through court sanctions. In a world obsessed with global interactions and conducive to growth, it is indeed rather difficult to restrict counterfeit goods on e-commerce platforms and pirate apps that make unauthorized use of a trademark. In this context, it is obvious that one would run an online search for infringements.

However, in the light of the new data protection laws in India and the rest of the world, trademark enforcement is met with a wave of privacy laws that intend to balance IP rights with fundamental rights such as freedom of speech and expression among others.



Given that the ‘Data Protection Bill,2018’ is largely modelled on the EU General Data Protection Regulation (GDPR), it is worthwhile to ascertain the impact of GDPR development in the Indian landscape. In an important judgement, the Court of

Source: MDIAL, <https://www.minterdial.com/2017/03/freedom-of-speech/>

Justice of the European Union (CJEU), in the case of *Eva Glawischnig-Piesczek v Facebook Ireland Limited* (October 3, 2019), the court held that ‘domestic courts may grant injunctions against intermediaries like Facebook to block identical or equivalent content or information’. While on the face of it, it may seem as a revolutionary initiation against online infringements, it also runs the risk of exaggerating the law. It has the potential of impairing legitimate content, inhibiting the access of knowledge and innovation including the risk of introducing ‘dolphins in the net’ caused due to impersonal automated filters. Without any standard of ‘equivalency’, lawful content, crucial archives of reputed social actors are left to single-handedly battle the bias of such filters. The example of the ‘Syrian Archive’ an NGO may be cited, videos testifying abuse were taken down because Youtube failed to recognize it. This restricts growth of legitimate trademark-holders and the resultant creativity and growth of business.

In the Indian paradigm, such views had already been in the pipeline with the dawn of the ‘Draft of Intermediary Guidelines 2018’.

Meanwhile, in the U.S Supreme Court in the case of *Iancu v. Brunetti* (June 24, 2019), held that trademark registration can’t be prohibited even if it is ‘immoral or scandalous’ as it violates the ‘First amendment’ rights. In its reasoning the court held that trademarks are protected by the principle of viewpoint neutrality. In the event that the government fails to run concurrent to such constitutional mandates, it would in a way indicate that the government is favouring certain views. In this regard, the Indian Trade Marks Act,1999 provides similar restrictions on free speech under Section 9 (2)(c).

On 6<sup>th</sup> September,2019, the Trade Marks Registry (TMR) of India issued a public notice, to several stakeholders regarding the display of ‘confidential, proprietary and personal information by the Trade Marks Registry’ which uploads application related details. The TMR proposes to

categorize information into two categories on the basis of visibility with respect to the degree of confidentiality of information.

The essence and beauty of IPR lies in its ability grow in the absence of unjust limitations. Such institutional approaches to IPR inhibit its growth and importantly dilapidate creativity and innovation. An economical approach over a standard-oriented approach should be adopted. The recent jurisprudential development in IPR policy follows the latter. Every injunction to take down content or prohibit registration, should be dealt with on a case-to-case basis to foster efficient resource allocation. It should be interesting to know how India intends to incorporate these latest global developments.

### **IMPORTANT RECENT CASES IN THE FIELD OF DEVELOPMENT OF TRADEMARKS AND COPYRIGHTS IN INDIA.**

*-Shefali Tasha Fernandes, 1750463*

#### **Navigators Logistics v. Kashif Oureshi**

In this case an employer alleged that a former employee was using their customer list to compete with them. With respect to copyright, the court held that the employer had failed to establish that the list was 'original' under the 'skill and judgment' standard espoused in *Eastern Book Company v D.B. Modak*. On grounds of confidentiality, the court held against the employer. It concluded that it is not possible to claim confidentiality in every customer list, since most details are available in the public domain. Therefore, the plaintiff must specifically establish the economic or commercial value of their customer list in order to protect it.

#### **Sanjay Kumar Gupta & Anr v. Sony Pictures Networks India P Ltd.**

Delhi High Court rejected the plea of copyright infringement against Sony Entertainment in relation to 'KaunBanegaCrorepati'. The appellants, in this case, had a concept termed "Jeeto Unlimited", where home viewers of a quiz show could participate live in a quiz show and were rewarded for answering correctly. It was alleged that, on presenting this concept to Sony, they were compelled to sign a consent letter which allowed Sony to use the concept without incurring any liability. The Court applied the '*scenes a faire doctrine*' stating that since the idea was to enable home viewers to simultaneously play along with contestants, some similarities were bound to arise, but upon scrutiny, crucial differences were found in concepts of the appellant and respondent. The Court held that there was no breach of confidentiality as the appellants had signed a consent letter authorizing Sony to use the concept.

### **Skechers USA v. Pure Play Sports**

Implications of Actual Costs and Taxation of Costs – A Notable and Welcome Change in the IP Regime

On May 15, 2018, a suit for trade dress infringement and passing off was decreed in favor of Skechers, in a summary judgment by a Single Judge of the Delhi High Court. The Court granted a summary judgment in favor of Skechers, the plaintiffs, despite there being no application filed by it for the same. The Court was of the opinion that it has the power to pass a decree in a suit summarily, if it is satisfied that nothing would come out of putting a party through the rigmarole of a trial along with costs.

### **Glenmark Pharmaceuticals Ltd. v. Curetech Skincare**

In the case of Glenmark Pharmaceuticals v. Curetech Skincare and Galpha Laboratories Ltd., the Bombay High Court awarded damages of an unparalleled amount of INR 1.5 Crore in view of the Defendant No.2, Galpha Laboratories being found guilty of habitual infringement of trademarks and copyrights. In this case, the plaintiff made an unusual choice and requested to transfer the entire amount of the exemplary damages to a charitable organization.



Source: Glenmark Pharmaceuticals, <https://www.glenmarkpharma.com/contact-us>

Thus, the Court directed the payment of damages towards the Kerala Chief Minister Distress Relief Fund. This is most probably the largest order of exemplary costs in a trademark infringement case. The Galpha Laboratories' mark CLODID-B was alleged to be infringing the plaintiff's trademark CANDID-B. It was further alleged that Galpha Laboratories had even copied the word mark, artwork, color scheme, and trade dress of the plaintiff. Defendant No.1 Curetech Skincare is a contract manufacturer, who was manufacturing on behalf of Galpha Laboratories. Therefore, the Defendant No.1 was provided with the art-work, labels and the mark by Defendant No. 2 under a Contract Manufacturing Agreement. Interestingly, the defendants, in this case, accepted

## **DEVELOPMENTS IN IPR IN INDIA**

### **1.The Patent office takes measures to being a Smart Office**

The Indian Patent and Trademarks Offices have considered the need to build efficiency adapting technology to make prosecution quicker. Towards achieving this objective, both offices have now

started to provide option of conducting hearing through video conferencing. In addition to this, the Controller General of Patents, Designs and Trademarks has also invited tenders for the services artificial intelligence, Block chain,, IoT and ‘other latest technologies’, useful for Patent Processing system of IPO.

## **2. No protection will be given to Christian Louboutin ‘red colour’**

While Christian Louboutin had a favourable decision from European Court of Justice (ECJ), in similar circumstances, the High Court of Delhi dismissed its claim of exclusivity in the red colour for shoe sole on the ground that a single colour cannot be granted protection as a trademark. The ruling came in the context of a suit for trademark infringement and passing off filed by Christian Louboutin against a Mumbai based party, namely Abubaker&Ors., who were selling ladies footwear with the similar red soles. Interestingly, decision was in contrast to an earlier finding by another judge of the Delhi High Court holding ‘red sole’ of Christian Louboutin to be a well known mark. The judge primarily based its ruling on definition of a “mark” holding that a ‘mark’ under the Indian Trademark Act {Section 2(m)} categorically used the expression ‘combination of colours’. Thus a single colour does not qualify as a mark.

## **3. Amway obtains ‘John Doe’ order to curb unauthorised sale**

The ‘John Doe’ orders have been commonly granted by the Indian courts in case of online piracy in music, film and software industry. They have also been granted in case of counterfeiting of products where the problem is widespread and identity of traders could not be determined. This is the first time ‘John Doe’ orders have been granted in case of goods being sold outside the distribution chain where they were meant for direct sales. Amway while obtaining the orders argued that pursuant to investigation they have found a number of parties selling their products illegally and without authorisation after removing the unique codes placed on the lid of the product. In some case even without issuing invoice and not providing the benefit of Return/Refund Policy that is likely to harm their reputation.

## **4. Supreme Court of India (July 2018) - "Similar trademarks for different items not breach of law"**

The Supreme Court has held that when two distinctly different products are marketed by two different companies with deceptively similar trademark there is no infringement of law if This case of infringement had been going for a decade between Karnataka Cooperative Milk Producers Association which has been trading milk and milk products under the trademark

'Nandini' since 1985 and a group adopted the name 'Nandhini' for its restaurant and food products business since 1989. The matter then moved from the Trademark Registry to IPAB to High Court. The Hon'ble High Court had put restraints on the group from using the trademark "Nandhini". The matter was eventually filed before the Supreme Court in the year 2015. The bench consisting of A.K. Sikri and Ashok Bhushan distinguished the goods for which the deceptively similar trademarks were being used. The Court's decision was eased when the Restaurant group decided to give up its claim over "milk and milk products".

### **5. Court clarifies a combined Design Infringement and confirms that passing off action is permissible**

The issue of overlap between Design and Passing off has been clarified by the five judge bench of Delhi High Court in one of the recent judgement issued in the case titled Carlsberg Breweries versus Som Distilleries and Breweries Ltd. The suit was for infringement of a registered design as well as passing off in respect of bottle and overall get up of the "Carlsberg" mark. The primary issue was whether a composite suit joining the two causes of action – one for infringement of a registered design and the other for passing off of the plaintiff's goods bearing a deceptively similar get up is maintainable. The court allowed the joinder of the suit/s in such cases "on account of existence of common questions of law and fact between the two causes of action of infringement of a registered design and passing off, therefore to a considerable extent, the evidence of the two causes of action will be common. In such a situation to avoid multiplicity of proceedings there should take place joinder of the two causes of action of infringement of a registered design and passing off against the same defendant in one suit, otherwise multiplicity of proceedings will result in waste of time, money and energy of the parties and also of the courts."

#### **Curbing Public Access to Documents**

**The trade mark registry has received several complaints from shareholders against public display of confidential information of members. The TMR proposes to classify documents into two categories:**

- a) publicly accessible documents**

### **6.PPH: Patent Prosecution Highway**

Patent Prosecution Highway, as the name suggests, brings fast track prosecution of patents. PPH has been followed in many Patent Offices as bilateral or trilateral agreements. One such trilateral agreement is also followed jointly by European Patent Office (EPO), the Japan Patent Office (JPO) and the United States Patent and Trademark Office (USPTO) as Trilateral-PPH. It helps

speedy prosecution and examination of a patent application in one country, if it has been accepted or granted by a country which is part of that agreement. India is also taking steps in order to avail benefits of this concept. The same is evident from the agreement signed between Japan and India on October 29, 2018, to start a pilot program of Japan-India Patent Prosecution Highway (PPH) in the first quarter of the fiscal year 2019, after making the necessary amendments in the Patent Rules. Implementing Patent Prosecution Highway in India will increase the number of patent filings in India, as it will increase the efficiency and prosecution timeline for patent applications.

**7.NBA opens window to pursue pending issues/matters under the Biological Diversity Act, 2002 (BD Act), for the patent applicants**

To facilitate and enhance implementation of the Act in public interest towards meeting the objectives of the BD Act, namely, conservation of biological diversity, sustainable use and fair and equitable sharing of benefits from commercial use, the Central Government has directed the Authority to take decisions within a period of 100 days from the date of issuance of this Office Memorandum, including course of action for matters related to past. These directions shall come into force with immediate effect.

**CASE: MR. A D PADAMSINGHISSAC & M/S AACHI MASALA V. AACHI CARGO CHANNELS (P) LTD.**

- *Karthika Nair 1650452*

CITATION: AIR2014Mad2

QUORUM: Satish K. Agnihotri and M.M. Sundresh, JJ.

WORD/MARK ARGUED TO BE GENERIC: Aachi, a Tamil word which is translated to mean grandmother.

ARGUMENTS OF THE APPELLANTS: The submission of the appellants was with respect to being the registered proprietor and therefore having the exclusive right to use the word “Aachi” and that the respondents cannot use the word regardless of being in a completely different service/business. In pursuance of this they relied on two judgments- Caterpillar Inc., Illinois USA, V. Jorange and another (O.S.A. No. 166/1997 in C.S. No. 785 of 1996 decided on 01.10.1997); and Daimler Benz Aktiegeseellschaft and another V. Hybo Hindustan (AIR 1994 Delhi 239).

ARGUMENTS OF THE RESPONDENT: The learned counsel appearing for the respondent has submitted that admittedly the appellants and the respondent are operating in two different and distinct fields having no connection whatsoever with each other. There is no similarity of goods

manufactured and the service rendered by the parties. There is no likelihood of causing any confusion in the minds of the public that the business of the respondent is that of the appellants.

DECISION OF THE COURT: The opinion of the court was that, in a suit for infringement, the Courts are primarily concerned with the label as a whole which may also contain the name. The label reflecting the masalas and spices of the appellants has nothing to do with the service being rendered by the respondent as cargo operators. Therefore, on this ground they refused to grant injunction in favor of the appellants.

To discuss the scope and ambit of sections 28, 29 and 30 of the Trademarks Act, 1999, the court relied on the case of Orchid Chemicals & Pharmaceuticals Ltd., v. Wockhardt Limited (2013) 3 CTC 841 where each of the sections were discussed. With respect to section 28, its applicability relies on two conditions- "subject to other provisions of the Act" and subject to its "validity". Section 29 which deals with infringement of a registered trademark by an unregistered proprietor makes it clear through its text that it is meant to be used against the person, who is not entitled to use the said trade mark under "law". This is required to constitute an infringement. Lastly, a perusal of Section 30 of the Act would show that Section 29 of the Act is subjected to it. Therefore, Section 30 of the Act is an overriding provision to Section 29.

The reason the Madras High Court discussed the three provisions in the Orchid Chemicals case was to apply it to the facts to determine whether "METOPROLAL", a chemical component, is a "publici juris". The court found out that there are number of registered proprietors having the prefix "METO". All of them are identified with the common name, in view of the chemical component. Hence, it is not as if the respondent has infringed the said word "METO". It is already in the public domain, even much prior to the application of the appellant. Applying the said facts when we read Section 29 of the Act, it can be concluded that the limits on effect of the registered trade mark under Section 30 of the Trade Marks Act, 1999, would apply with all force.

In the case on hand, the bench concurred with the single judge that the word "Aachi" in Tamil means "grandmother". Such term is in common use throughout the State of Tamil Nadu.

Therefore, such a word, which is of general use, cannot be a monopoly of the appellants alone be used in any other product than the one they are doing business.

ANALYSIS: Trademark law protects marks of a proprietor in order to distinguish their product or service from that of others'. However not every mark falling within section 2(m) of the Trademarks Act, 1999 can be protected. A word which is general or generic and is used in common parlance cannot be trademarked because granting protection to such words under the Act would mean that the proprietor has the monopoly over that word which is used by all. Hence, a generic term unlike arbitrary, suggestive or even a descriptive mark which has gained secondary meaning, cannot be registered. It can so happen that an arbitrary or fanciful mark may become generic due to unregulated use and consequent dilution of the mark such as Xerox or Dettol.

Proprietors give generic terms to their brand which makes it vulnerable to infringement even if they have been given registration under the Act. It is easy to determine whether words like “Krishna” can be protected as in the case *Bhole Baba Milk Food Industries Ltd v. Parul Food Specialities (P) Ltd* (Delhi High Court), because it is so common and cannot acquire a secondary meaning hence cannot be accorded the same protection an arbitrary mark would get. But what happens when a proprietor uses a word mark which is generic in another language but not in English? This was what was dealt in brief by the Madras High Court in the Aachi case where the appellants used “Aachi” for masala and spices whereas the respondents used “Aachi” for cargo services. The word Aachi means grandmother in Tamil and is a common word in Tamil. In my opinion, the court was right not to grant injunction in favor of the appellants because even though the word is registered, a common word or phrase cannot be monopolized by one. If it is already in public domain then it cannot attract section 29 of the Act.

It may be noticed that different jurisdictions have different take on this issue. The Madras High Court relies on a strict interpretation of the law and does not allow suits for infringement for generic words even if they are translated, as long as it is generic in that language and has not acquired a secondary meaning. The court looks at whether the word is in public domain by checking how many such registrations already exist. Delhi High Court on the other hand is more liberal in this matter as can be seen in the case of *Sunil Mittal v. Darzi on Call*, 2017. This

particular revolved around the word “Darzi” which was used by two proprietors in the same business that is of tailoring. The court held that the disputed word is not generic to the trade and enjoined the defendants. They came to this conclusion by looking at the territorial nature of the business and the word generally used at that place. The business is undertaken in Delhi, considering this, in my opinion, the court has erred in its decision because “Darzi” is tailor in Hindi/Urdu. The court also did not look at the mark as a whole and considered only the word even though the way it is written and the logo with the word are completely different from each others’. The court did not consider section 9(1)(c) which clear lays down that for a generic mark there cannot be registration under the Act.

The Supreme Court in T V Venugopal v. Ushodaya Enterprise, (2011) Vol 4 SCC 85, also took a similar view when the question put forth was regarding the term “Eenadu”. The plaintiff used the word for incense sticks whereas the respondents used it for newspapers printed in Telugu. Eenadu means “this land” or “our land” in Kannada, Tamil and/or Malayalam. The court reached its conclusion that the word is generic and only the respondents are allowed to use the word by relying on how much imagination does it take by a consumer about qualities characteristics, effects, purpose or ingredient of the product or source.

The primary difference between the Delhi High Court case and the Madras High Court case is that in the former instance, the proprietors undertake the same service so there may have been a likelihood of confusion. However, the Madras High Court case involves two completely different services. But, in the case of Eenadu it was clear to the court that there exists a secondary meaning to the common word at least in Telugu speaking states. But if common words are given protection then it goes against the absolute grounds laid down under Section 9(1)(c). In my opinion, the decision of the Madras High Court in the Aachi case, upholds the whole purpose and objective of section 28 to 30 of the Act unlike the above two cases.

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# INTELLECTUALIS

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INTELLECTUAL PROPERTY RIGHTS COMMITTEE | SCHOOL OF LAW, CHRIST (DEEMED TO BE UNIVERSITY)  
SEVENTH EDITION 2019-20

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## STUDENT EDITOR'S NOTE

The Intellectual Property Rights Committee presents to you the seventh edition of their Newsletter 'Intellectualis'. The theme for the seventh edition is 'Trademarks' and comprises of literary and non- literary works which will give an opportunity to our readers to open the recesses of their minds in the domain of Intellectual Property Rights.

We would like to extend our gratitude to the student body of School of Law, CHRIST (Deemed to be University) for their overwhelming response to the newsletter. We would also like to thank our Chairpersons Dr. Avishek Chakraborty and Dr. Aradhana Satish Nair for constantly supporting us and guiding us through the drafting of this newsletter.

We hope that you enjoy reading our newsletter every month!

Neeraja Seshadri  
28th November, 2019

Intellectual Property Rights Committee,  
School of Law, CHRIST (Deemed to be University), Bengaluru.

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