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INDIA IP UPDATE

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LEGISLATIVE UPDATE

Delhi High Court Intellectual Property Rights Division Rules, 2022 came into force w.e.f. 15 April 2022

Following the abolition of the Intellectual Property Appellate Board in 2021, the Delhi High Court established the Intellectual Property Division (IPD) to manage the increase in IP litigation. The Court had also undertaken an extensive public consultation process to draft the Intellectual Property Rights Division Rules ("the Rules") to govern the practice and procedure for the exercise of the Court's original and appellate jurisdiction, and other miscellaneous petitions under the various IP and related statutes.

After two rounds of public consultation, on 24 February 2022, the Delhi High Court published the Rules in the Delhi Gazette. In a gazette notification dated 11 April 2022, the Acting Chief Justice of the Delhi High Court appointed 15 April 2022 as the date on which the Rules came into force.

The Rules as published on 24 February 2022 are substantially the same as the draft published in December 2021 ("Draft Rules") for the second round of public consultation (this draft was previously discussed in-depth in IP Tome 2021), but for a few important changes. These are:

- **Litigation Hold Notice:** Rule 18 in the Draft Rules introduced the concept of Litigation Hold Notice ("LHN"). The LHN requires the recipient to preserve all documentary, tangible and electronic material relating to the subject matter of the litigation that has been instituted or may be instituted in the future. Failure to comply with such an LHN is punishable under the Rules with onerous penalties determined by the Court. However, there was a lacuna in the Draft Rules since it did not specify the time within which a party was required to initiate proceedings once it had issued an LHN. Thus, there was an apprehension that an unscrupulous party could cause inconvenience by issuing an LHN and not follow up by initiating proceedings, thereby compelling the LHN recipient to continue to comply with the onerous obligation to preserve large quantities of data and paperwork for the indefinite future. The Rules have now addressed this lacuna by stating that a party must initiate proceedings within one year of issuing an LHN, failing which the obligation on the LHN recipient to preserve evidence would cease to apply;

It was also clarified that for the purpose of this Rule, documentary, tangible, and electronic material to be preserved includes documents in tangible or electronic form. This includes letters, memos, internal and external correspondence, graphic representations of any kind, images, sounds, and data stored in any medium, and relating to the subject matter of the proceedings;

- **Appointment of law researchers for IPD benches:** The Draft Rules had provided appointment of law researchers by IPD judges themselves. The Rules have replaced such *ad hoc* mechanism with an institutional mechanism under which a Committee designated by the Chief Justice will appoint law researchers to a common pool for IPD. Individual law researchers will be picked from this pool and will be attached to the various IPD benches (and not to individual judges). The terms and conditions for appointment will be as per the Scheme for Engagement of Law Researchers in the High Court of Delhi dated 19.01.2018 as amended from time to time; and
- **Adjudication of claims under section 46 of the Information Technology Act, 2000:** The Rules also bring within the IPD's ambit any petition under section 46 of the Information Technology Act, 2000 alleging a contravention of the provisions of the Act or any rule, regulation, direction, or order made thereunder, where the claim for injury or damage exceeds INR 5 crores (about USD 650,000).

CASE LAW UPDATE

PATENTS

Parties are obliged to produce all documents in their possession relating to the suit for fair disposal: Delhi High Court

In 2020, Koninklijke Philips NV ("**Philips**") sued Vivo Mobile Communications Co. and others (collectively "**Vivo**") in the Delhi High Court. The suit, *Koninklijke Philips N.V. v. Vivo Mobile Communication Co. Ltd. & Ors.,* alleged infringement of Philips' standard essential patents (SEPs) relating to UMTS (3G), HSPA, HSPA+ and LTE mobile technologies. Philips sought a permanent injunction to restrain Vivo from manufacturing, assembling, importing, selling, offering for sale, advertising, including through third party websites, mobile phones and any future devices or models that would result in the infringement of the suit patents until Vivo procured a license from Philips on fair, reasonable and non-discriminatory (FRAND) terms. Philips also sought damages for past infringement.

Vivo denied infringement liability by arguing that they were not liable to make any payments to Philips since they had obtained the chipsets from Qualcomm and MediaTek. They further argued that, if there was any infringement of Philips' SEPs, Philips should have sued Qualcomm and MediaTek. Furthermore, if there was any agreement between Philips on the one hand, and Qualcomm and MediaTek on the other, pertaining to the suit patents, the rights would be exhausted once Qualcomm and MediaTek sold their chipsets containing the duly licensed technologies; Philips would then be foreclosed from claiming further downstream licenses from manufacturing entities like Vivo.

Based on the grounds taken by Vivo, Philips filed an application in the suit, to compel Vivo to produce the license agreements between them and their chipset suppliers, namely, Qualcomm and MediaTek. It was Philips' argument in the application that these documents would help to determine the truth in the claims of Vivo. Vivo opposed the application on several grounds, including that the license agreements were confidential, and that Philips' application be dismissed on the ground of irrelevance since it had not made the case that its patents were SEPs by mapping its patents to the established standards. Additionally, Vivo claimed that a licensor who seeks to license its SEPs on FRAND terms, is required to make disclosures to show that license terms demanded are fair; and that Philips had made no such disclosures.

The Court explained that to expedite the disposal of commercial suits, there is an obligation on the parties to produce all documents in their possession that would throw light on the subject matter of the suit and would assist in the fair disposal of the suit. The only precaution to be followed by the Court in exercising its discretion as provided under the law is to ensure that the applicant submitting the interrogatory is not on a roving or fishing inquiry.

The Court explained that Vivo has consistently claimed that the suit patents were incorporated into the chipsets and not the handsets. However, Philips claimed that the suit patents were incorporated into the handsets. The third-party license agreements executed between Vivo and Qualcomm and MediaTek would throw light on the dispute before the Court. However, the Court held that given the confidential and business-sensitive nature of the license agreements, a confidentiality club, as provided in the High Court of Delhi Rules Governing Patent Suits, 2022, will be constituted to examine the license agreements. The Court allowed Philips to nominate two experts and eight lawyers to the confidentiality club.

Delhi High Court permits Nokia to add additional infringing devices in its patent infringement suits

NOKIA / oppo

In 2021 and early 2022, Finnish telecommunications corporation Nokia Technologies Oy ("**Nokia**") initiated patent infringement suits, namely, *Nokia Technologies Oy v. Guangdong Oppo Mobile Telecommunications Corp. Ltd. & Ors.* and *Nokia Technologies Oy v. Vivo Mobile Communications Co. Ltd. & Ors.* against two Chinese mobile phone manufacturing companies, Guangdong Oppo Mobile Telecommunications Corp. Ltd. ("**Oppo**") and Vivo Mobile Communications Co. Ltd. ("**Vivo**"). Nokia alleged that various devices manufactured by Oppo including OnePlus 8T, Realme 8 Pro and Oppo Reno 5 Pro infringed its patents, IN 259932 "(Arranging Handover"), IN 264783 ("Method for Controlling the Graphical Display of a Portable Electronic Device"), and IN 266531 ("Reduce Interference in a Terminal Device Based on Information Type"). Nokia further alleged that iQOO 7, Vivo X70 Pro+, Vivo X60 Pro and a few other devices manufactured by Vivo infringed its patent, IN 259932.

Nokia also moved an application in the suit seeking the Court's permission to add further infringing devices and claims for infringement of additional claims in the suit patents at a later stage in the proceedings. Since the Indian Code of Civil Procedure bars a plaintiff from splitting claims and prayed-for reliefs, arising from the same cause of action, into multiple proceedings, this is an important step in patent infringement litigation. Failure to do so may bar Nokia from adding further infringing devices to the suit or from adding additional claims in the suit patent which are subsequently found to be infringed.

The Court noted that patent infringement suits are filed based on the claims and patents asserted in respect of devices which may be readily available on the date on which testing is done to check infringement; and that during the pendency of the suit, new models may be launched, or the patent holder may realize that additional claims in the suit patents are also infringed. In such cases, the filing of fresh suits or amendments will cause delay and complicate the adjudication of the suit. To avoid multiplicity of proceedings, there is a need to give some flexibility in terms of the addition of new devices which the patent holder claims as infringing upon the suit patent, or the addition of new claims based upon the infringement of additional claims in the suit patent. Hence, the Court allowed Nokia to add further devices and claims for infringement of additional claims in the suit patents by means of a separate affidavit with test reports.

However, the Court denied the application with regard to the other patents and ordered that if Nokia wishes to assert the infringement of other patents, it will be required to initiate separate suits that may be consolidated later at an appropriate stage.

Protection against infringement is equally forceful even towards the end of the patent term: Delhi High Court

In *Sotefin SA v. Indraprastha Cancer Society and Research Center & Ors*, a patent infringement case, the Delhi High Court examined and clarified several important facets of Indian patent law that had not been examined by Indian courts hitherto.

The suit patent IN 214088 titled, '*Carriage for the horizontal transfer of motor vehicles in automatic mechanical car parks*', is owned by Sotefin Patents SA . Sotefin SA ("**Sotefin**") is a wholly owned subsidiary of Sotefin Patents SA and the exclusive licensee of the suit patent since 2010. The invention, commonly known as a 'Dolly' or a 'Silomat Dolly' relates to a self-propelled carriage on wheels, for horizontal transfer of motor vehicles by lifting two or more wheels, in single or multi automatic mechanical car parks. The suit patent has been continuously used in India ever since its filing in 2002. It expired on March 13, 2022.

In December 2011, Sotefin entered a supply contract with the third defendant in the suit, Simplex Projects Limited ("**Simplex**"). Sotefin provided Simplex with a complete set of European style mechanical assembly and detailed drawings in relation to the suit patent, on a strictly confidential basis. The first defendant, Indraprastha Cancer Society & Research Centre ("**ICSRC**") is a not-for-profit public society and operates and manages the second defendant, Rajiv Gandhi Cancer Institute and Research Centre ("**RGCIRC**").

In 2017, Sotefin approached RGCIRC in response to a tender for an automatic car parking system, shared technical background of the 'Silomat Dollies' with them, and made them aware of the suit patent.

Later, in 2020, Sotefin learned that RGCIRC had obtained fire safety permission for its automatic multi-parking system, and that the fourth defendant (a subsidiary of Simplex), Simpark Infrastructure Private Limited ("**Simpark**") was handling the project. Sotefin also found that ICSRC had placed an order of supply and import of 14 'Smart Dollies' from a company named Nanjing Eli Parking Equipment Manufacturing Co. Ltd., located in China and these

Smart Dollies had been and were being installed at the premises of ICSRC and RGCIRC. Pictures of these 'Smart Dollies' resembling the 'Silomat Dollies' were found, and upon comparing the features of Claim No. 1 of the suit patent with these, Sotefin found that the machine used at RGCIRC site had all the elements of Claim No. 1 of the suit patent.

Aggrieved, Sotefin filed a suit against all four defendants, seeking a permanent injunction against infringement of its patent, contending that Simplex illegally transferred the technology and drawings of machinery related to the suit patent.

Based on the report submitted by scientific advisors appointed by the Court, Sotefin argued that this was a case of infringement since 17 of the 19 sub-elements between the respective dollies were common. Importation of 'Smart Dollies' by ICSRC was alleged to be a willful breach of contractual confidential obligations. The defendants disputed these claims, arguing that two essential elements were absent in the imported 'Smart Dollies', and contended that these 'Smart Dollies' must be compared to each of the claims of the suit patent. The defendants further tried taking refuge in 'parallel importation', reasoning that they had imported the 'Smart Dollies' to India and were, thus, exempted from liability. The defendants also argued that since the patent was to expire within a month from the date of the decision, no injunction should be granted in favour of the patentee.

The Court applied the standard tests for grant of injunction, namely, the establishment of the three essential ingredients - *prima facie* case, the balance of convenience and irreparable loss.

The Court observed that Sotefin, along with its group companies, has been vigilant in protecting its intellectual properties in foreign countries, and the suit patent has been in existence for almost close to 20 years in India without any third-party challenge to its validity at any stage, either at a pre-grant or post-grant stage. Asserting that it is the 'pith and marrow' of the invention claimed that is required to be looked into, the Court held that emphasis must be on mapping of 'essential elements'. The non-essential or trifling variations or additions in the product would not be germane, so long as the substance of the invention is found to be copied. The doctrines of purposive construction and of equivalence were also applied. Pertinently, the Court also held that mapping of one of the elements of the independent Claim No.1 is sufficient to constitute infringement.

On the issue of whether the protection of the patent is any less forceful towards the end of its term, the Court held that if a patentee approaches for enforcement of its rights any time during the term of a subsisting patent, irrespective of the length of balance period, it would be the duty of the Court to enforce the same, giving the full benefit of Sections 48 and 108 of the Patents Act, 1970 ("Patents Act") and other provisions of law, without exception. In the opinion of the Court, if infringement has occurred during the lifetime of the patent, the infringing goods would not become kosher on the expiry of the patent; and that the monopoly granted to exploit the invention without competition, during the term of the patent, would apply in equal vigour, notwithstanding the fact that the patent is on its last legs.

The Court also clarified that the State will not permit importation of any product which violates an Indian patent, even if it is patented in any other jurisdiction. The intent of Section 107A of the Patents Act, necessarily implies that exemptions to patent protection under this provision are for the greater public interest at large. Further, any interpretation under the garb of Section 107A(b), which violates the rights of the Indian patentee, is impermissible.

The Court also noted that the doctrine of international exhaustion, as found in the Trade

Marks Act, 1999 was not intended to be incorporated under the Patents Act.

Discarding the proposition of the defendants that, since the award of damages is an adequate remedy, and an injunction should be refused, the Court held that the statutory rights of the patentee cannot be defeated, just because a plaintiff may be entitled to damages at the end of the trial.

Granting an interim injunction to Sotefin and restraining the defendants from, among other things, importing the Smart Dollies, the Court finally noted that the risk taken by the defendants was a calculated one; they were aware of the suit patent, yet they proceeded to import the Smart Dollies. This decision sets a milestone on many counts, including patent enforceability towards the end of its term, parallel importation, and the doctrine of equivalence.

CASE LAW UPDATE

TRADEMARKS

Inquiry of confusion is irrelevant in infringement actions once the marks are established to be identical

Renaissance Hotel Holdings Inc v. B. Vijaya Sai & Ors., was an appeal before the Supreme Court of India based on a decision of the High Court of Karnataka in Bengaluru ("High Court"). The appellant, Renaissance Hotel Holdings, Inc. ("**Renaissance**"), is a chain of luxury hotels owned by the multi-national giant Marriott International, Inc. Marriot has used the mark RENAISSANCE globally since 1981 and in India since 1990. The respondents, (collectively "**Vijaya Sai**"), who are relatively smaller entities, argued that they were operating two hotels under the name "SAI RENAISSANCE" in India since 2001.

In 2009, Renaissance sued Vijaya Sai to prevent their use of the mark RENAISSANCE before the District Court of Bengaluru which granted an injunction to Renaissance against Vijaya Sai for the use of the mark SAI RENAISSANCE in classes 9 and 42. Further, Vijaya Sai was also restrained from opening or operating a restaurant or hotel business under the mark RENAISSANCE or any deceptive variation thereof, including the domain name www.sairenaissance.com to pass off their services as that of Renaissance. However, Renaissance's claim for damages was rejected. Vijay Sai appealed to the High Court.

The High Court allowed Vijaya Sai's appeal and reversed the order of the District Court, holding that:

- Renaissance could not establish a case of trans-border reputation it enjoyed;
- Vijaya Sai's hotels are not 5-Star hotels like Renaissance's; and
- There was no evidence to show that Vijaya Sai was taking unfair advantage of Renaissance's marks or that their use of "SAI RENAISSANCE" was detrimental to the distinctive character or reputation of Renaissance's trademark.

Renaissance appealed to the Supreme Court. While quashing the High Court's judgment, the apex court, noted, *inter alia*, the following:

- Renaissance's mark was registered in both classes 16 and 42. Vijaya Sai's mark is identical to that of Renaissance's mark. Once a defendant's mark is found to be identical to that of a plaintiff's registered trademark, a court could not go into an enquiry of whether the infringement is likely to deceive or cause confusion. As such, it was not open for the High Court to inquire whether Renaissance's mark had a reputation in India, or whether the use of the mark without due cause gave Vijaya Sai unfair advantage, or is detrimental to the distinctive character or repute of the registered trademark; and

- The High Court, while dealing with the limits of the effects of a registered mark under Section 30 of the Trade Marks Act, 1999, failed to consider an important aspect, namely, whether Vijaya Sai's use is in accordance with the honest practices in industrial or commercial matters.

Comparative advertisement: Calcutta High Court on the need for being "comparison positive"

Dabur and Baidyanath are two mainstream Indian brands in the Ayurvedic products category. A common product that they manufacture, sell and compete for is Chyawanprash, an Ayurvedic health supplement made up of a blend of various herbs and spices.

Baidyanath ran advertisements in October and November 2021 claiming that, while their Chyawanprash contains 52 Ayurvedic herbs, the Chyawanprash sold by other brands "contain only 42 ingredients", or were either deficient in Ayurvedic ingredients, or not made with the right formula, or adulterated with vegetable oil, and hence do not provide any health benefits.

This prompted Baidyanath's business rival Dabur, who has a 63% market share in the product, to file a suit (*Dabur India Limited v. Shree Baidyanath Ayurved Bhawan Pvt. Ltd.*) at the Calcutta High Court. Dabur sought a permanent injunction restraining Baidyanath from broadcasting these advertisements that disparaged Dabur's goodwill, reputation, and product 'Chyawanprash'. While the advertisements did not specifically refer to Dabur as a brand in its comparison, the packaging of the compared product shown in the advertisement and referred to as 'ordinary' and 'incomplete', resembled Dabur's packaging, which is widely recognized. In the past, Dabur had successfully prevented third parties from generic disparagement of its Chyawanprash product, as it was able to establish that being the owner of a lion's share of the market, the comparison was aimed at Dabur.

The Court pointed out that the intent behind comparative advertisements is to persuade the consumers to give preference to one of the competing products. Such advertisements either expressly or subtly make a claim that the product of the advertiser is a better choice, which is permissible in law. However, the Court specifically remarked that a comparative advertising campaign should be 'comparison positive', which is to say that the comparison should be by way of valuable information to help the consumers and promote competition. After considering all the arguments, Baidyanath was injuncted from running the advertisement in its existing form based on the following observations:

- Baidyanath referring to other Chyawanprash in the market as "ordinary" or "incomplete" amounts to negative comparison, which is not protected as commercial speech under the law;
- Such comparison is based on false information by Baidyanath's own admission that its product has qualities of "52 ingredients" and does not contain "52 herbs";
- The comparison of 42 ingredients, is malicious and slanderous as all the Chyawanprash products in the market are having at least 47 ingredients as

per the Drugs and Cosmetics Act, 1940. Hence, a comparison with a fictitious number that is lesser than the minimum requirement, insinuates that those products are not in compliance with the Drugs and Cosmetics Act, 1940. Such a comparison is slanderous and mischievous, and accordingly, amounts to disparagement so long as the reference to "42 ingredients" remains;

- The comparison of the number of ingredients made in the advertisement falls under the ambit of "negative comparison", which is to be restricted immediately in such cases of disparagement;
- A modified version of the video advertisement, as instructed by the Court, was allowed to be telecast conditionally after removing the disparaging portions.

Delhi High Court on marks with similar meanings: Rooh Afza v. Dil Afza

Source: https://www.legaleraonline.com/

Rooh Afza, a sharbat (Asian botanical sweetened concentrate) brand owned by the plaintiffs, Hamdard National Foundation & Hamdard Dawakhana also trading as Hamdard Laboratories (India) (collectively "**Hamdard**"), is over 100 years old with a registration for "Rooh Afza" going back to 1942. On the other hand, Dil Afza, a brand for a similar product by the defendant Sadar Laboratories Pvt. Ltd. ("**Sadar**") was registered recently in 2018, with an apparent claim of use since 1949 (though documents filed by Sadar in the trademark application show that the use is only since 1976).

The question that arose for consideration in *Hamdard National Foundation & Anr. v. Sadar Laboratories* was whether the use of the name DIL AFZA by Sadar infringed on the rights of ROOH AFZA'S name by Hamdard and amounted to passing off. 'Rooh', 'Dil', and 'Afza' are Urdu words meaning spirit, heart, and increasing/adding respectively.

Hamdard argued that ROOH AFZA is a well-known mark recognised by the High Court of Lahore way back in 1930. Sadar, on the other hand, argued that the brand name HAMDARD has the reputation of a well-known mark and not ROOH AFZA. Sadar further argued that the word AFZA has become very common in the sharbat trade. It also argued that the marks DIL AFZA and ROOH AFZA are distinguishable in and of themselves, besides the fact that Sadar's mark DIL AFZA had already been in the market since 1949. Hamdard disputed Sadar's claim that its mark has been in use since 1949.

While the Court recognized that ROOH AFZA is a well-known mark, it still ruled in favour of Sadar and declined an injunction against Sadar. The Court noted that though 'ROOH AFZA' as a complete word may have become synonymous to sharbat produced by Hamdard, the same cannot be said about 'AFZA'. While ruling so, the Court added that even if Sadar's sharbat has been produced only since 2020, no case has been made to restrain it from marketing the same under the mark DIL AFZA. The Court further recognized that the mark DIL AFZA had been in use at least since 1976 in the class of goods relating to Unani and Ayurvedic medicines and that the two trademarks have coexisted in the market harmoniously without any misunderstanding or confusion in the minds of the public.

It is to be noted that Hamdard had filed an application for rectification with the Trademark Office on the grounds that Sadar did not disclose complete details to the Registrar. The Court, therefore, after declining the interim injunction, stayed the suit pending the final disposal of the rectification application filed by Hamdard and directed Sadar to maintain a true account of sales of 'Dil Afza' sharbat during the pendency of the suit and to submit to the court, a quarterly report and account thereof, till the disposal of the suit.

Recycled bottles by defendant bearing plaintiff's marks: Delhi High Court finds infringement and passing-off

In *Anheuser-Busch LLC v. Mr. Surjeet Lal & Anr.*, the plaintiff Anheuser-Busch LLC ("**Anheuser-Busch**") was concerned about the recycled use of its empty beer bottles by the defendants, Surjeet Lal & M/s. SOM Distilleries and Breweries Ltd., (collectively, "**Lal**").

Lal is also in the same business (as Anheuser-Busch) of manufacturing and sale of beer, under its marks 'BLACK FORT' and 'POWER COOL' It was the case of Anheuser-Busch that Lal was recycling beer bottles embossed with its mark "BUDWEISER" and re-labelling them as 'BLACK FORT' and 'POWER COOL', and that such use amounted to infringement and passing-off. Lal argued that their company uses recycled bottles to sell their products and that Anheuser-Busch's bottles accidentally crept into the stream of recycled bottles used by them. Accordingly, Lal pleaded that the use was honest. Additionally, Lal was willing to give an undertaking to the effect that bottles of 'BUDWEISER' shall not be used by it for the manufacture and sale of their beer.

After hearing the submissions of both the parties, the Court noted that the use of recycled 'BUDWEISER' beer bottles for the products being sold under the mark 'BLACK FORT' and 'POWER COOL' by Lal would clearly constitute use of the mark in the course of trade. Further, the fact that these were recycled bottles would not make a difference as far as the questions of infringement or passing-off are concerned. The Court noted that Lal's use of recycled bottles, which have Anheuser-Busch's trade mark 'BUDWEISER' embossed on them, would cause confusion as to the source. While injuncting Lal, the Court further ordered them to conduct random checks and inspections to limit the scope of any infringement being caused. Lal also gave an undertaking to weed out Anheuser-Busch's bottles during recycling and to also include a disclaimer on its products that it uses recycled bottles. On its part, Anheuser-Busch agreed not to press for damages.

No monopoly can be claimed over descriptive words, religious symbols, or names of deities

PLAINTIFF'S USAGE	DEFENDANT'S USAGE(S)
OM LOGISTICS LTD. Making Business Simple (a)	EXPRESS LOGISTICS SPECIALIST IN ROAD, TRAIN & AIR CARGO SPEED - SAFETY - SECURITY (b) OM EXPRESS LOGISTICS (c)

This order arose from an application to vacate an *ex parte* injunction in a trademark dispute (*Om Logistics Ltd. v. Sh. Mahendra Pandey*) before the Delhi High Court. The injunction had restrained the defendant Mahendra Pandey ("**Pandey**"), who had been using the mark 'OM EXPRESS LOGISTICS' in respect of identical business of providing logistic services, from using the mark "OM LOGISTICS" owned by the plaintiff Om Logistics Ltd. ("**OLL**").

Pandey argued before the Court that OLL obtained the injunction by making misleading and false claims and by suppressing material facts. It was Pandey's main argument that the terms 'OM' and 'LOGISTICS' are commonly used expressions in the trade, and that no one can claim monopoly over terms like 'OM' (a religious symbol) which have religious significance. Pandey demonstrated through evidence that there were prior users of identical marks even in the same services as OLL. Further, Pandey pointed out that when several conflicting marks containing 'OM' and 'LOGISTICS' were cited during the prosecution of OLL's application, OLL argued that these marks are distinguishable and dissimilar. This fact was suppressed by OLL in the suit and in its application for an interim injunction. On the contrary, in the suit, OLL claimed exclusivity against Pandey. Hence, Pandey argued that OLL cannot be allowed to approbate and reprobate.

The Court upheld Pandey's arguments and vacated the injunction after noting that OLL was guilty of concealment of material facts. The Court also held that there can be no exclusivity regarding religious symbols and names of deities and, therefore, OLL could not be allowed to monopolize the use of the religious symbol 'OM'. The Court cited prior decisions which held that monopolies cannot be claimed in respect of word marks 'KRISHNA' (for dairy products) and 'GANESH' who are among the most popularly worshipped Hindu Gods. Additionally, the Court held that the word 'LOGISTICS' is inherently descriptive and incapable of distinguishing the services of OLL. Moreover, the records of the Trade Marks Registry indicated that there are several registrations under the same class of names using the words and marks 'OM' and 'LOGISTICS' and, hence, are common to trade and cannot be monopolized. The Court also held that there was no visual similarity between OLL's and Pandey's marks other than the mere words 'OM' and 'LOGISTICS', and that colours and fonts used were also dissimilar. Hence, there was no case of passing off. The Court also noted that, regarding OLL's claim that its mark has acquired distinctiveness through long usage, acquired distinctiveness can only be established at the trial stage and cannot be decided at the *prima facie* stage.

CASE LAW UPDATE

Copyrights

Delhi High Court says none can seek copyright over a game format

The Delhi High Court's recent decision in the case *Samir Kasal v. Prashant Mehta & Ors.* delved into the question of copyrightability of game formats in the sport of cricket. The plaintiff, Samir Kasal ("**Kasal**"), claims to be a well-known personality in sports, entertainment, and related industries. Kasal claims that he had conceptualized a unique game of cricket where two teams of retired legendary cricket players would compete in a game of cricket in a format similar to that of T-20, but with a twist that each team would have two innings, like a test match, of 10 overs each. In early 2018, Kasal disclosed the said format to defendants, Prashant Mehta & Ors (collectively, "Mehta"), in confidence and elementary discussions commenced between Kasal and Mehta. Kasal, however, claims that due to the Covid-19 pandemic, no tournament could be organized in 2020 and 2021.

In late 2021, Kasal claims to have learned from media reports that Mehta was about to host a T-20 cricket league named *"Legends League Cricket"* with various teams of retired players. Kasal issued a legal notice to Mehta and instituted the instant suit for copyright infringement and breach of confidentiality a few days before the tournament. Mehta argued that there was no contract, nor was there any completed work in which infringement was being claimed. As such, Mehta argued that there was no prima facie case in favour of Kasal.

Having heard the parties, the Court noted that Kasal was trying to assert rights in his concept of a competitive cricket league, where retired international cricketers were to play at neutral venues. The Court was unable to agree that there was any work because thoughts, without being expressed in a material form could not form a literary work. Furthermore, in the Court's view, none of the features of Kasal's concept reflected original thought because such ideas had been developed into game formats in the past as well.

The Court also relied on the principles laid down in the Supreme Court's judgment in *R.G Anand v Deluxe Films* which held that where the same idea is developed in a different manner, owing to a common source, similarities are bound to occur. In such a case, the courts should determine whether such similarities are on fundamental or substantial aspects of the mode of expression adopted in the copyrighted work. Noting that the fundamental similarity in this case is the game of cricket itself, the Court held that none could claim copyright in the game of cricket. Even assuming that Kasal's format is exclusive, the Court held that the differences in the respective formats were sufficient to establish that there was no copying of any ideas or concepts.

As for confidentiality, the Court held that Kasal, after sharing the idea, never followed up with Mehta and that confidentiality, as asserted, cannot be permitted to continue indefinitely. Nor was there any implied contract, as disclosed in the documents, entailing mutual obligations between the parties.

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