



# UPDATES

— *from the* —

# IP WORLD

August 2024 | Edition 2



## Table of Content

S.No.	Particulars	Page
	<b>JUDGEMENTS</b>	
I.	Delhi court orders Rs. 1.75 lakh in costs to Samsung in a Trade Mark infringement case	1
II.	Delhi Court Awards Adidas Over INR 39 Lakh in Landmark Trademark Infringement Case	2
III.	Delhi High Court Rules In Favour Of Nike In A Trademark Infringement Case Against Counterfeit Goods Dealer	3
IV.	Delhi High Court Issues Broad Injunction Against IP Infringements of "Tarak Mehta Ka Ooltah Chashmah"	4
V.	Delhi High Court orders Paramvah Studios to pay Rs 20 lakh for copyright violation	5
VI.	Delhi High Court put an end to a 23-year long legal battle between Lacoste and Crocodile International.	6
VII.	Delhi High Court passes a John Doe order to restrain trademark infringement of Shardul Amarchand Mangaldas.	7
VIII.	<b>INDIAN IP UPDATES</b>	8-9
IX.	<b>INTERNATIONAL IP UPDATES</b>	10-12

- **Delhi court orders INR 1.75 lakh in costs to Samsung in a Trade Mark infringement case**

In the case involving trademark infringement, Samsung India Electronics and Samsung Electronics (the Plaintiffs) filed a suit for unauthorized use of their registered trademark "SAMSUNG." The Plaintiffs sought a permanent injunction to prevent the Defendants from selling counterfeit "LEVEL U" and "UFLEX" headsets bearing the "SAMSUNG" brand without authorization.

Upon thorough examination of the case, it was established that the Defendants were indeed engaged in the sale of counterfeit products, which were deceptively similar to the Plaintiffs' genuine goods. The investigation revealed that the Defendants were offering these counterfeit products at significantly lower prices and without proper invoices, thereby misleading consumers and causing financial harm to the Plaintiffs.

Local Commissioners appointed by the court successfully recovered the infringing products from the Defendants' premises, further substantiating the claims of the Plaintiffs.

The district court of Delhi, therefore, found in favour of the Plaintiffs, confirming that the Defendants had infringed on the registered trademark "SAMSUNG" and had been passing off counterfeit goods as genuine Samsung products. As a result, the court issued a decree of permanent injunction against the Defendants, prohibiting them from further infringement activities. Additionally, the Plaintiffs were awarded the costs of Rs. 1,75,000.

The judgment upholds the significance of protecting registered trademarks and the severe repercussions for those engaging in the sale of counterfeit products.

**Case Name: Samsung India Electronics Pvt. Ltd. Vs. M/s Arvind Enterprises And Others**

[https://drive.google.com/file/d/1\\_bJ7IEeciqr2YNbnOBNYNv1FVrRWgz/view?usp=drivesdk](https://drive.google.com/file/d/1_bJ7IEeciqr2YNbnOBNYNv1FVrRWgz/view?usp=drivesdk)

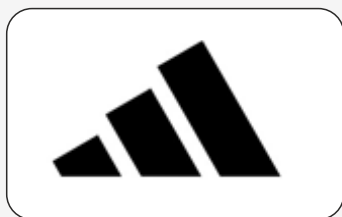
- **Delhi Court Awards Adidas Over INR 39 Lakh in Landmark Trademark Infringement Case**

Adidas AG (Plaintiff), a globally recognized sportswear brand registered in Germany, filed a lawsuit against Inder & Ors. (defendants), who were found to be manufacturing and selling counterfeit Adidas products in Delhi, India. The plaintiff claimed that the defendants were using trademarks identical to Adidas' registered marks, including the famous "three stripes" and "trefoil" logos, to deceive customers and profit unlawfully.

The company discovered that the defendants were selling counterfeit products bearing the Adidas trademarks during a market survey in September 2021. Subsequent investigations revealed that the defendants were distributing poor-quality imitations without proper invoices, thus damaging Adidas' brand reputation.

The defendants contested the suit, challenging the authority of the plaintiff's representatives and raising procedural objections. However, they failed to appear in court subsequently, leading to ex-parte proceeding. The Delhi district court reviewed the evidence, including testimony and reports from the plaintiff's witnesses, and found the defendants guilty of trademark infringement.

The court ruled in favour of Adidas, noting that the evidence provided by the plaintiff, including the testimony of a local commissioner and the seizure of counterfeit goods, was uncontested and credible. The court held that the defendants had indeed infringed upon Adidas' trademarks and ordered them to pay damages of INR 24,00,000 and INR 15,00,000, respectively, for the harm caused. The court granted a permanent injunction, preventing the defendants from using Adidas' trademarks in the future. The plaintiff was also awarded costs for the suit amounting to INR 2,25,000.



*(Plaintiff's Mark)*

**Case Name: Adidas AG vs Inder and Ors.**

<https://drive.google.com/file/d/1Wyt3oAIB7ZmSC10AjUNLeyBTBP9fHrAR/view?usp=drivesdk>



- **Delhi High Court Rules In Favour Of Nike In A Trademark Infringement Case Against Counterfeit Goods Dealer**

Nike Innovate C.V., is the owner of the "NIKE" trademark and the iconic SWOOSH device. This distinctive logo and trademark are synonymous with high-quality sportswear and have become a symbol of athletic excellence worldwide. Nike Innovate C.V. took legal action against a local shop owner who was accused of distributing counterfeit goods bearing its famous "NIKE" trademark and SWOOSH logo. The plaintiff's lawsuit was initiated on the ground that defendant was involved in the unauthorized manufacturing, selling, and offering for sale of products that unlawfully used Nike's trademark and logo.

The Local Commissioner's report was instrumental in establishing the facts of the case. The report detailed that the defendant was indeed engaged in the production and distribution of counterfeit goods that prominently displayed the "NIKE" trademark and logo. This included a variety of items that were being sold as genuine Nike products but were, in fact, counterfeit.

The case was brought before the District Court of Delhi, where the issue was whether the defendant's actions constituted trademark infringement under the law. Nike Innovate C.V. sought legal redress not only to stop the unlawful activities but also to claim compensation for the damages caused by the counterfeit products.

The district court of Delhi ruled in favor of Nike Innovate C.V., affirming that the defendant's actions constituted trademark infringement. The ruling recognized the severity of the infringement and the harm caused to Nike's brand reputation and commercial interests.

**Case Name: M/S Nike Innovate C.V v. Sham Setia**

<https://drive.google.com/file/d/1-ZjOoV3U35PvQGxv854YqK7jHFz3ZDSj/view?usp=drivesdk>

## Judgements

- **Delhi High Court Issues Broad Injunction Against IP Infringements of “Taarak Mehta Ka Ooltah Chashmah”**

“Taarak Mehta Ka Ooltah Chashmah”, a beloved and long-running TV serial, has become an integral part of Indian pop culture. The show, renowned for its distinctive characters and engaging storylines, is a significant intellectual property owned by its producers.

The producer of the serial found numerous platforms including social media handles, YouTube channels, and websites that were illegally using the show's characters. The infringing activities ranged from unauthorized animations and AI-generated images to deepfakes and counterfeit merchandise. In some cases, inappropriate content featuring the show's characters was also being posted.

In response to these widespread infringements, the producers sought redress from the Delhi High Court. They presented a case demonstrating that the unauthorized use of their intellectual property not only infringed on their copyright and trademark rights but also inflicted substantial economic and personal damage.

The Delhi High Court responded by issuing a broad injunction, also known as a John Doe order. This omnibus order is designed to address not only the specific offenders identified in the case but also to broadly prohibit anyone from exploiting the show's intellectual property without permission. This type of order is particularly useful in cases where the infringers are numerous or not easily identifiable.

The order mandates that any online platform or individual using the characters or content of “Taarak Mehta Ka Ooltah Chashmah” without authorization must cease their activities immediately. It also requires the removal of any existing infringing content and prohibits the sale of counterfeit merchandise.



*(Plaintiff's Mark)*

**Case Name: Neela Film Productions Private Limited v. Taarak Mehta Ka Ooltah Chashmah.Com & Ors.**

<https://drive.google.com/file/d/1-zjOoV3U35PvQGxv854YqK7jHFz3ZDSj/view?usp=drivesdk>

- **Delhi High Court orders Paramvah Studios to pay Rs 20 lakh for copyright violation**

MRT Music, a leading and well-respected music label known for its significant contributions to the film industry, found itself at the center of a legal battle involving unauthorized use of its music tracks. The crux of the dispute centered around the films "Yaya Ellide" and "Gaalimaathu," both of which were produced under MRT Music's label. The label's tracks, known for their popularity and successful soundtracks were protected by copyright.

The conflict emerged when Rakshit Shetty, a prominent film actor and producer, along with his production house, Paramvah Studios, was accused of unlawfully using MRT Music's tracks in their new production, "Bachelor Party." According to Naveen Kumar, a partner at MRT Music, the tracks from "Yaya Ellide" and "Gaalimaathu" were incorporated into the film without obtaining the necessary licenses or permissions. This action, according to MRT Music, not only infringed on their copyright but also potentially harmed their commercial interests and brand reputation.

The Delhi High Court delivered a decisive verdict in favor of MRT Music. The Court's ruling came after careful consideration of the evidence, including the failure of the defendants to provide a valid defense for their unauthorized use of the music tracks. The Delhi High Court found that Rakshit Shetty and Paramvah Studios had indeed infringed upon MRT Music's copyrights by using the tracks from "Yaya Ellide" and "Gaalimaathu" without proper licensing. Consequently, the defendants were ordered to pay a substantial sum of Rs 20 lakh as compensation to MRT Music.

**Case Name: M/S Mrt Music vs Paramvah Studios Private Limited & Ors.**

[https://drive.google.com/file/d/1lhjLmwPuiSCvVL\\_Mri1XovHHABpcNIN8/view?usp=drivesdk](https://drive.google.com/file/d/1lhjLmwPuiSCvVL_Mri1XovHHABpcNIN8/view?usp=drivesdk)

## Judgements

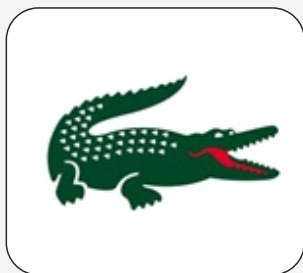
- **The Delhi High Court put an end to a 23-year long legal battle between Lacoste and Crocodile International**

In 2001, Lacoste initiated legal action in India against Crocodile International and its local subsidiary, Crocodile Products Private Limited, to protect its iconic crocodile logo, which was registered under Indian copyright law. Lacoste argued that Crocodile International's similar logo could confuse consumers into believing its products were affiliated with or endorsed by Lacoste, thereby diluting its brand and harming its reputation.

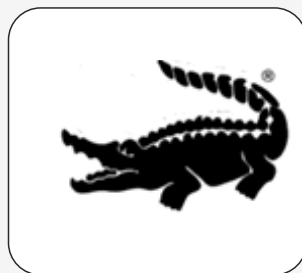
Lacoste's legal team highlighted the logo's status as a "well-known trademark" under Indian law and claimed the visual similarities between the logos could mislead customers. Conversely, Crocodile International asserted that both brands had coexisted peacefully in various Asian markets under prior agreements and maintained that their logo was distinct enough to avoid confusion.

The Delhi High Court ruled in favor of Lacoste, prohibiting Crocodile International from using the contested logo in any capacity that would infringe upon Lacoste's trademarks. The judgment underscored the significance of safeguarding well-known trademarks, noting that the resemblance between the logos could deceive consumers and infringe on Lacoste's rights.

The Delhi High Court also ordered Crocodile International to account for profits earned from the sale of products bearing the infringing logo since their launch in India in August 1998. A retired judge, Amar Nath, was appointed to review financial records to determine these profits. This ruling not only affirmed Lacoste's trademark rights but also set a precedent for the protection of distinct brand identities in India.



*(Plaintiff's Mark)*



*(Defendant's Mark)*

**Case Name: Lacoste and Anr. v. Crocodile International Pte Ltd & Anr.**

<https://drive.google.com/file/d/IntpnB-ikiRR-uGkzoEwm15SU18kmlyQL/view?usp=sharing>

## Judgements

- **Delhi High Court passes a John Doe order to restrain trademark infringement of Shardul Amarchand Mangaldas**

A lawsuit was filed under the Trade Marks Act, 1999, and the Copyright Act, 1957, by Shardul Amarchand Mangaldas, seeking a permanent injunction against trademark and copyright infringement, passing off, and misappropriation of intellectual property rights. The plaintiff, a prominent law firm known for its registered "SAMCO" trademarks and associated copyrights, alleged that Defendant had engaged in unlawful activities by adopting and using marks identical to its own, specifically the name "Shardul Amarchand Mangaldas," and misappropriating the photograph of the firm's Executive Chairman, Dr. Shardul S. Shroff.

The plaintiff contended that several people were falsely representing itself as affiliated with the firm and issuing fake legal notices to third parties, alleging copyright violations under the guise of the firm's trademarks. This unauthorized use of the firm's well-known trademarks and the issuance of counterfeit legal communications prompted the plaintiff to seek an ex-parte ad-interim injunction.

The Delhi High Court responded by granting a John Doe order, which prohibited unnamed individuals or entities from infringing upon or misusing the firm's trademarks and intellectual property. Additionally, the court allowed the plaintiff to publish a public notice to inform the public about the false communications and the ongoing legal action.

This move aims to protect the firm's reputation and intellectual property while seeking to uncover and address any further illegal activities related to the case.



*(Plaintiff's Mark)*

**Case Name: Lacoste and Anr. v. Crocodile International Pte Ltd & Anr.**

[https://drive.google.com/file/d/18F\\_PajlAv7cXmIC6g14VJ0dQvcZntQYE/view?usp=sharing](https://drive.google.com/file/d/18F_PajlAv7cXmIC6g14VJ0dQvcZntQYE/view?usp=sharing)

- **Delhi High Court orders for cancellation of trademark "Andaaz-e-Nizaam"**

The Delhi High Court has ordered the cancellation of the trademark "Andaaz-e-Nizaam," previously granted to the food outlet in Nizamuddin, after a lawsuit by Indian restaurant chain "Nizam's." Justice Mini Pushkarna directed the Registrar of Trademarks to remove the trademark, registered in November 2021 for Mehruddin Ansari. Nizam's owner, Rajesh Chugh, argued that the trademark was deceptively similar to his long-established "Nizam's" brand. Ansari's counsel agreed to rebrand the outlet as "Daawat-e-Nizamuddin" or "Andaaz-e-Nizamuddin." The court has mandated Ansari to complete the rebranding within four weeks.

- **Giant Burger King loses a decade-long trademark dispute against Pune's Burger King.**

The District Court of Pune, Maharashtra has dismissed the lawsuit filed by Burger King Corporation, which sought a permanent injunction and ₹20 lakh in damages for trademark infringement against the Pune-based restaurant owners, Anahita and Shapoor Irani. The Court highlighted that the restaurant had been using the 'Burger King' name since 1991-92, whereas the U.S. company only entered the Indian market in 2014. It confirmed that the Indian owners had been using the trade name for their restaurant since around 1992.

- **Bangalore Tops Patent Application Rankings for August 2024.**

In the month of August, Bangalore led the country with the highest number of patent applications, filing 80 of the total 1,689. Chennai followed with 66 applications, while Hyderabad submitted 51. Pune and Delhi recorded 37 and 36 applications, respectively. Mumbai contributed 33 patents, and Kolkata was the lowest with 16 applications. This data reflects the regional distribution of innovative activities across major Indian cities, showcasing Bangalore's prominent role in the national patent landscape.

- **National Intellectual Property Awards 2024 Announced to Honor Top Achievers in IP Innovations.**

The Office of the Controller General of Patents, Designs and Trademarks has announced the National Intellectual Property Awards 2024. These awards aim to recognize and reward outstanding individuals, institutions, organizations, and enterprises for their contributions to IP creations and commercialization. The awards celebrate those who have significantly enhanced the IP ecosystem in India through their achievements. The awards will be presented to the awardees in an event to be organized by Intellectual Property Office (IPO) in the month of October, 2024.

- **The Calcutta High Court declares that employing contractual workers in the Patents and Trade mark office is unlawful.**

The Calcutta High Court has recently ruled that using contractual workers for certain legal tasks at the patents and trademarks office is illegal. This could put the validity of many patents and



trademarks in danger. Over the past two years, the Quality Council of India (QCI), a non-profit group, has hired contractual staff for this office. Normally, these roles are filled by officials from government agencies, universities, or other official bodies.

- **Bombay High Court Overturns Circular Exempting Wedding Music from Copyright Enforcement**

The Bombay High Court bench at Goa invalidated a January 30, 2024, circular from the Government of Goa that exempted wedding music from copyright infringement claims. Phonographic Performance Limited challenged this circular, arguing it obstructed their right to enforce copyright for music played at weddings. The Bombay High Court found that the circular overstepped Section 52(1)(za) of the Copyright Act, which only covers bona-fide religious ceremonies.

- **Bombay High Court Imposes ₹1 Lakh Costs on German Firm for 91-Day Delay in Patent Case**

The Bombay High Court has penalized German company AIC246 AG & Co. KG with a ₹1 lakh fine for a 91-day delay in filing a petition in a patent dispute. The company argued that the delay was caused by the time required to obtain instructions from Germany and the complexity of the case. However, the court found no merit in these arguments, emphasizing that the company failed to provide a satisfactory explanation for the prolonged delay. The court's decision underscores the importance of timely legal actions in patent disputes.

- **Delhi High Court Upholds G.D. Pharmaceuticals' "BOROLINE" Trademark; Issues Permanent Injunction Against "BOROBEAUTY"**

The Delhi High Court has declared G.D. Pharmaceuticals' trademark "BOROLINE" as well-known and issued a permanent injunction against M/S Cento Products (India) for using the deceptively similar mark "BOROBEAUTY." The ruling recognizes "BOROLINE," used since 1929 for antiseptic creams, as a well-known trademark due to its extensive use, popularity, and distinctiveness. The defendant has been ordered to cease using "BOROBEAUTY," adopt a new trade dress and trademark, and pay ₹2,00,000 in costs to the plaintiff.

- **CAFC Dismisses PTOT Appeal, Citing Insufficient Standing in Patent Dispute with Viavi**

The U.S. Court of Appeals for the Federal Circuit (CAFC) dismissed Platinum Optics Technology's (PTOT) appeal for lack of standing. PTOT challenged a PTAB decision that upheld Viavi Solutions' U.S. Patent No. 9,354,369. The CAFC, with Judge Claire C. Cecchi authoring the opinion, found PTOT's claims of future infringement speculative and insufficient to prove a concrete injury. PTOT's arguments about potential infringement and new products did not meet the standing requirements, so the court did not review the PTAB's decision.

- **CAFC Narrows Estoppel Regulation to New and Amended Patent Claims, Sparking Debate on Patent vs. Trademark Standards**

On July 26, 2024, the U.S. Court of Appeals for the Federal Circuit issued a precedential ruling in *Softview LLC v. Apple Inc.*, holding that an estoppel regulation under the America Invents Act applies only to newly issued or amended patent claims, not to existing claims. This decision contrasts with earlier rulings on Lanham Act trademark filings, where post-registration maintenance was considered acts of "obtaining" a registration. The Federal Circuit's inconsistent approaches to "obtaining" in patent and trademark contexts raise questions about reconciliation.

- **Starbucks Faces Third Lawsuit Over Alleged Theft of Coffee-Flavored Lip Balm Concept**

Starbucks faces a third lawsuit from Balmuccino, a company claiming the coffee giant stole its idea for coffee-flavored lip products. The complaint, filed in Manhattan federal court, follows two previous dismissals, including one in July 2023. Balmuccino, linked to Dr. Mehmet Oz's family, alleges it pitched the concept to Starbucks in 2018, but the company later launched similar products without compensation. The lawsuit seeks damages, arguing it is timely under New York law. Starbucks has not yet commented.

- **Eminem's Publisher Challenges Spotify and Music Modernization Act in Constitutional Lawsuit**

Eminem's publisher, Eight Mile Style, has filed a lawsuit against Spotify, challenging the constitutionality of the Music Modernization Act (MMA). The lawsuit claims that the MMA unlawfully eliminates the ability to recover profits, statutory damages, and attorneys' fees for past copyright infringement, violating the Takings Clause of the Fifth Amendment. Eight Mile seeks Spotify's profits, potentially amounting to \$36.45 million, and requests a judicial declaration that the MMA's retroactive provisions are unconstitutional, alleging they benefit private companies at the expense of copyright holders.

- **Cox Communications Appeals to Supreme Court Over Copyright Case Threatening U.S. Internet Access**

Cox Communications has petitioned the U.S. Supreme Court to review a crucial copyright infringement case brought by Sony Corp. and other music industry groups. The case, which holds Cox liable for its customers' alleged copyright violations, could force internet service providers (ISPs) to terminate service based on unproven claims, fundamentally changing how ISPs manage their networks. Cox argues that such rulings threaten internet access for all Americans, especially in rural areas. The company seeks to protect users' privacy and prevent the unintended consequences of cutting off entire households or businesses from the internet due to individual actions.

- **Nike Sues New Balance and Skechers Over Alleged Infringement of Flyknit Technology**

Nike has filed patent infringement lawsuits against New Balance and Skechers, accusing them of using its Flyknit technology without authorization. The lawsuits, filed in federal courts in Massachusetts and California, allege that both companies have wrongfully used Nike's Flyknit material, which is designed to make shoes lightweight and strong. Nike seeks to block the sale of the allegedly infringing products and is pursuing damages. Similar cases against Puma and Adidas were previously settled, while a case against Lululemon is ongoing.

- **6-Year-Old Khaleesi Denied Passport Over Game of Thrones Trademark Dispute**

A six-year-old girl's Disneyland trip hit a snag when her passport application was rejected due to her name, inspired by a Game of Thrones character. Khaleesi Holloway's mother, Lucy, told the BBC that the UK Passport Office claimed the name infringes on a trademark owned by Warner Brothers for the popular fantasy series. In the show, Emilia Clarke's character, Daenerys Targaryen, is titled Khaleesi, meaning queen.

- **Munich Court Rules in Favor of Cubatabaco in Trademark Dispute Over "Habanos" GI**

The Munich Higher Regional Court ruled in favor of Cubatabaco, Cuba's state-owned tobacco company, in its lawsuit against Swiss cigar brand Davidoff. Cubatabaco accused Davidoff of infringing on the "Habanos" geographical indication (GI) by marketing cigars made outside Cuba using terms like "Cuban seed." The court rejected Davidoff's argument that "Habanos" had become a generic term, emphasizing that the term still holds a specific geographical reputation associated with Cuban cigars, thus warranting protection under German law.

- **Intel Faces Lawsuit for Copyright Infringement Over AI Software Use**

AI software developer Anaconda has sued Intel, accusing the tech giant of unauthorized use of its AI development software after the license expired. Anaconda alleges that Intel ignored repeated renewal offers and continued using the software without permission, violating copyright laws. While the software is free for individuals and small businesses, large

corporations require a commercial license, making Intel's actions a significant infringement.

- **OpenAI Shifts Strategy: Aggressively Files Patents for AI Innovations, Moving Away from Trade Secrets**

OpenAI, known for its trade secret approach, is now aggressively pursuing patents. Despite its previous reputation, the company has filed and accelerated eleven patents this year, focusing on key AI innovations like ChatGPT. The rapid grant of these patents suggests OpenAI plans to enforce its IP or use it strategically in negotiations. This shift highlights a departure from its earlier strategy, aligning more with traditional tech industry practices of patent protection, contrary to its previous stance on transparency and collaboration.

- **Paris Central Division Upholds UPC Jurisdiction Over Patent Dispute Despite Parallel German Proceedings**

The Paris Central Division of the UPC has ruled it has jurisdiction over a patent dispute despite parallel German proceedings. In the case of *Mala Technologies v Nokia*, the court rejected arguments that EU *lis pendens* rules or transitional provisions should prevent UPC proceedings. The court affirmed that the UPC can assert jurisdiction even if similar cases are pending in national courts before the transitional period, leading to the dismissal of Mala's preliminary objection and requests for stay or extension.