



UPDATES

— *from the* —

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Table of Content

S.No.	Particulars	Page
	JUDGEMENTS	
i.	High Court Sets Precedent on Composite Trademark Protection in 'JUMBO' vs. 'HATHI' Dispute	1
ii.	Pidilite restrains Astral from infringing its Container Design	2
iii.	Delhi High Court Restrains Use of 'ALSITA' Trademark Due to Similarity with 'ALRISTA'	3
iv.	INDIAN IP UPDATES	4-6
v.	INTERNATIONAL IP UPDATES	7-8

- **High Court Sets Precedent on Composite Trademark Protection in 'JUMBO' vs. 'HATHI' Dispute**

The recent High Court ruling in the case of Girnar Food Beverages Pvt. Ltd. vs. The Registrar of Trade Marks & Anr. has set a significant precedent in Indian trademark law, particularly concerning the protection of distinctive elements within composite trademarks under Section 17 of the Trade Marks Act, 1999. The dispute involved the "JUMBO" mark used by Girnar Food and Beverages Pvt. Ltd. and the "HATHI MARKA UTTAM CHAI" mark used by Bicrampore T.E, both featuring elephant devices. The court found that Girnar had prior use and substantial goodwill associated with the "JUMBO" mark since 1985, while Bicrampore's claim of use since 1970 was unsubstantiated.

The court determined that the marks were deceptively similar, which could likely cause consumer confusion due to their shared use of elephant imagery. The judgment emphasized the importance of protecting the distinctiveness of composite trademarks, underscoring Section 17's role in preventing the monopolization of non-distinctive elements while safeguarding the integrity of distinctive brand features. This ruling not only fortifies the legal framework protecting well-known trademarks but also underscores the necessity of maintaining clear brand distinctions to prevent consumer confusion, setting a critical reference point for future trademark disputes in India.



(Plaintiff)



(Defendant)

Case Name: Girnar Food Beverages Pvt. Ltd. vs. The Registrar of Trade Marks & Anr.

https://drive.google.com/file/d/1rFFR1HjwFdRdesOtRC-3oSkccDYWhAw9/view?usp=drive_link

- **Bombay High Court restrains Astral from infringing on the Container Design of Pidilite**

In June 2024, the High Court of Bombay granted an interim injunction in favor of Pidilite Industries Limited ("Pidilite") in a design infringement case against Astral Limited claiming that Astral had copied the design of its M-SEAL PV SEAL containers, first introduced in tin in 2015 and later in Coex plastic in 2019. Pidilite argued that Astral's SOLVOBOND containers were deceptively similar to its own, sharing features such as shape, configuration, and the design of the caps.

Pidilite asserted that its container design, which is registered, was distinctive and visually appealing due to its unique shape and configuration. After examining physical samples from both companies, the Court found that the designs were largely identical. Although Astral acknowledged the similarity, they argued that Pidilite's design was not visually appealing and was merely a variation of existing designs. Astral also claimed that similar designs were published and registered before Pidilite and that Pidilite's prior patent application undermined the novelty of the design.

The Court rejected Astral's arguments, stating that Pidilite's design had a distinctive and unique appeal. It ruled that the differences pointed out by Astral were minor and did not significantly distinguish the designs, leading to the conclusion that the designs were substantially similar. The Court also confirmed that Pidilite's design was validly registered and not just a trade variant of other designs. The Court emphasized that combining known design elements could still result in a novel design, noting significant differences between the designs cited by Astral and Pidilite's design. Regarding the patent application, the Court noted it was irrelevant as it did not disclose the design and was published after the design filing date.

The Court concluded that Pidilite had established a prima facie case of design infringement, with the balance of convenience favouring Pidilite, and that not granting the injunction would cause irreparable harm to Pidilite's business. Consequently, the Court granted an interim injunction, preventing Astral from manufacturing, selling, or dealing in products that infringe upon Pidilite's registered design during the pendency of the lawsuit.

Case Name: Pidilite Indus. Ltd. v. Astral Ltd.

<https://indiankanoon.org/doc/63420132/>

- **Bombay High Court Grants Injunction to Glenmark Pharmaceuticals in Trademark Dispute Over Anti-Diabetic Drugs**

The Bombay High Court granted an ad-interim injunction to Glenmark Pharmaceuticals Ltd. against Gleck Pharma (OPC) Pvt. Ltd. The court determined that Gleck Pharma's "XIGAMET" mark was phonetically and structurally similar to Glenmark's "ZITA-MET" mark, both used for anti-diabetic medications, creating a high probability of consumer confusion.

Glenmark, engaged in manufacturing and selling pharmaceutical products, has marketed "ZITA-MET" since 2013, originally using the molecule sitagliptin before switching to teneligliptin and metformin in 2015. They hold a registered trademark for "ZITA-MET" in Class 5. In 2020, they discovered Gleck Pharma's trademark application for "XIGAMET" and later issued a cease-and-desist notice. However, Gleck Pharma filed a lawsuit in the Srinagar Court, resulting in a temporary injunction against Glenmark, preventing interference with Gleck's use of "XIGAMET."

The Bombay High Court, referencing previous rulings, including the Cadila Health Care Ltd. case, emphasized the stricter standard needed for assessing confusion between medicinal products. The court concluded that the marks "XIGAMET" and "ZITA-MET" were too similar, potentially leading to dangerous confusion, and rejected Gleck Pharma's arguments regarding the different packaging and prescription-only status of the drugs.

Given the potential health risks from confusing the two products, both of which treat the same condition, the court ruled in favor of Glenmark, granting the injunction to prevent Gleck Pharma from using the "XIGAMET" mark.



(Plaintiff)

Case Name: Glenmark Pharmaceuticals Ltd. v. Gleck Pharma (OPC) Pvt. Ltd

https://drive.google.com/file/d/1gy3vr7c7DE-q_133oSpBm2EhSepHIVcB/view?usp=sharing

- **Delhi HC restrains local firms from using the 'ADIDAS' mark**

The Delhi High Court issued a permanent injunction in July against a company using a similar name to Adidas AG, following a trademark infringement lawsuit filed by the German sports and apparel company. The court, presided over by Justice Sanjeev Narula, also awarded Adidas Rs 14.22 lakh in damages, including Rs 3 lakh in nominal damages and Rs 11.22 lakh for litigation costs incurred over the past 13 years.

The defendants, who were marketing products under the 'ADIDAS' brand, argued that their adoption of the trademark was "bonafide and honest." They claimed that the name 'ADIDAS' was derived from a personal connection, combining 'ADI' (a term of endearment for an elder sister in the Sindhi community) and 'DAS' (meaning devotee), reflecting a deep admiration held by Keshav Tulsiani, a partner/director in the defendant companies, for his elder sister.

The defendants also challenged the court's jurisdiction, asserting that they did not reside or conduct business within the Delhi area and that there was a delay in filing the lawsuit. They argued that their usage of the trademark in all uppercase letters differentiated it from Adidas AG's lowercase branding. However, the court found that it had jurisdiction, citing the operations of the defendants' wholly-owned subsidiary, ADIDAS India Marketing Pvt. Ltd, in New Delhi.

Regarding the delay claim, the court noted that the defendants failed to provide evidence to support their claim of using the mark since 1987. The court ruled in favor of Adidas AG, stating that the defendants' use of an identical mark, combined with the similarity in goods (textiles and garments), likely caused confusion. The court emphasized that the word 'Adidas,' being a coined term with no inherent linguistic meaning, has a high degree of distinctiveness and warrants broad protection under trademark law.

- **SC asks Crompton and V-Guard to 'Settle it out'**

The Supreme Court has encouraged Crompton Greaves Consumer Electricals and V-Guard Industries to settle their trademark dispute over the use of the name 'PEBBLE' out of court. V-Guard claims exclusive rights to the 'PEBBLE' trademark for its water heaters, while Crompton has been using the same name for electric irons since October 2020.

Justices Sanjiv Khanna and Sanjay Kumar suggested that Crompton consider changing the name to avoid unnecessary litigation, noting that the matter might not warrant such a legal battle. The court acknowledged a request from the companies' lawyers for time to explore a settlement and scheduled the next hearing for the following week.

Crompton has challenged a Delhi High Court order temporarily prohibiting the company from using the 'PEBBLE' name for its electric irons. Crompton's lawyers argued that their product name includes the prefix 'CROMPTON,' distinguishing it from V-Guard's registered mark and serving as a product identifier.

Crompton also contended that 'PEBBLE' is a common English word and that the High Court's decision effectively gave V-Guard a monopoly on the term across all product categories, which they argued is not legally permissible. They pointed out that V-Guard's annual sales of Rs 31.49 crore do not establish a significant reputation that would justify exclusive rights to the name.

V-Guard, meanwhile, asserted its exclusive rights to the 'PEBBLE' trademark, stating it has been using the name for water heaters and geysers since 2013, in addition to selling various electric products under the 'V-GUARD' house mark and other trademarks since 1977.

- **Trademark infringement: Patanjali asked to deposit Rs 50 lakh for breach of HC order**

On July 8, the Bombay High Court ordered Patanjali Ayurveda to deposit ₹50 lakh in response to an alleged violation of an interim order prohibiting the sale of its camphor products, following a trademark infringement suit filed by Mangalam Organics Ltd. The court had initially restrained Patanjali from selling these products on August 30, 2023. Despite the order, Patanjali continued selling the camphor products, which led to the current legal action.

Patanjali Ayurved admitted to violating the court's order in an affidavit dated June 2, 2024, in which Rajneesh Mishra, a director at Patanjali, acknowledged selling camphor products worth ₹49,57,861 after the injunction. The court, led by Justice R. I. Chagla, noted that Patanjali had admitted to the breach, stating that such actions could not be tolerated. The judge ordered Patanjali to deposit ₹50 lakh within a week, warning of further action for contempt of court if the breach was not addressed.

The court also instructed Mangalam Organics Ltd. to submit an affidavit detailing the specific breaches by Patanjali. The case is scheduled for further hearing on July 19.

- **Delhi High Court Calls for Regulation of Trademark and Patent Agents**

The Delhi High Court has called for the regulation of trademark and patent agents in India, citing numerous complaints about their practices. Justice Prathiba M Singh noted the critical role these agents play in handling trademarks and patents and highlighted the absence of a regulatory authority overseeing them. Although there are qualifications for patent agents, they are not regulated by the Bar Council of India or the Advocates' Act, 1961.

The court directed the Central government to outline how the Controller General of Patents, Designs, and Trade Marks (CGPDTM) will regulate these agents, with a report due before the next hearing on November 9. This directive followed a petition to restore a patent application, which was abandoned due to a lack of response from the patent agent. The court has asked the agent to explain the situation in an affidavit. The outcome of this case could have significant implications for intellectual property law in India.

- **Delhi High Court sends Tesla vs. Tesla Power trademark case to mediation**

The Delhi High Court has directed Tesla Inc and Tesla Power to attempt mediation to resolve their trademark dispute. The mediation will start on July 18, and if it does not succeed, the case will be heard by the court on September 18.

Tesla Inc's lawyer, Chander Lall, expressed doubts about the effectiveness of mediation, arguing that Tesla Power is unlikely to give up its brand. On the other hand, Tesla Power's lawyer, J. Sai Deepak, indicated a willingness to engage in mediation.

Tesla Inc, the American electric vehicle manufacturer co-founded by Elon Musk, filed a lawsuit on May 2 against Tesla Power India Pvt Ltd, accusing it of trademark infringement and misleading customers by suggesting a connection with its electric vehicles. Tesla Inc. claims this has led to customer confusion and potential harm to its reputation as it prepares to enter the Indian market.

Tesla Power was also accused of failing to follow court orders and continuing to sell e-scooters on IndiaMart, with some customers alleging fraud. It countered by stating that "Tesla" is not a unique trademark, citing its use by various companies in India and other countries.

On May 30, Tesla Power reported that it had complied with a court order by instructing its partners to remove the Tesla logo from its e-scooters and clarified that it does not intend to market its products under the Tesla brand.

- **US Supreme Court bars 'Donald Trump too small' trademark**

The U.S. Supreme Court reversed a lower court's decision that had ruled in favor of Steve Elster, who sought to trademark the phrase "Trump Too Small" for use on T-shirts. The case involved a provision in a 1946 federal trademark law prohibiting the registration of a trademark that uses a living individual's name without their written consent. The central issue was whether free speech protections for criticism of public figures outweighed concerns over the rights of those individuals, specifically regarding former President Donald Trump.

The Biden administration argued that the law is a valid condition on a government benefit and does not unlawfully restrict free speech, as it applies regardless of the viewpoint expressed. Elster contended that allowing public figures to trademark positive messages while disallowing critical ones amounts to viewpoint discrimination.

Elster's 2018 application featured the phrase "Trump Too Small" and an accompanying mocking hand gesture, referencing a debate exchange between Trump and U.S. Senator Marco Rubio during the 2016 Republican presidential primary. The U.S. Patent and Trademark Office rejected the application, but the U.S. Court of Appeals for the Federal Circuit sided with Elster, asserting that his First Amendment rights to criticize public figures outweighed the government's interest in protecting their privacy and publicity rights.

The Supreme Court's recent history includes striking down two trademark laws over free speech concerns, including cases involving the band The Slants and the brand "FUCT." The decision on Elster's case awaited the Supreme Court's ruling. Trump, currently a frontrunner for the Republican nomination in the upcoming presidential election, has not commented on the case.

- **Big Mac battle: McDonald's loses burger trademark for E.U. in battle with Irish rival**

The EU General Court recently ruled that McDonald's has lost its trademark for the Big Mac across the 27-nation bloc, siding with Irish fast food chain Supermac in a lengthy legal dispute. The court found that McDonald's did not provide sufficient evidence that it had genuinely used the Big Mac name for chicken sandwiches, poultry products, or restaurant services over five years. The ruling allows Supermac, based in Galway, to expand into other EU countries. The conflict began when Supermac sought to register its name in the EU, prompting McDonald's to object, claiming consumer confusion due to its existing Big Mac trademark.

In 2017, Supermac requested the EU Intellectual Property Office to cancel McDonald's Big Mac trademark, arguing that the name had not been used for certain categories not directly related to the burger. The regulator partially agreed, leading to McDonald's appeal to the EU General Court.

The court stated that McDonald's failed to prove the Big Mac trademark's genuine use for the contested categories. Supermac's Managing Director, Pat McDonagh, hailed the decision as a significant win for small businesses against trademark bullying by large corporations.

While Supermac does not sell a Big Mac sandwich, it offers a similar item called the Mighty Mac. McDonald's, which can appeal to the European Court of Justice, expressed confidence that the ruling does not impact its rights to use the Big Mac trademark and reaffirmed its commitment to serving its customers across Europe.

- **World's biggest music labels sue over AI copyright**

Major record labels, including Sony Music, Universal Music Group, and Warner Records, are suing two AI start-ups, Suno and Udio, for alleged massive copyright infringement. They accuse these companies of unlawfully using their music to generate similar works and are seeking \$150,000 (£118,200) in damages per instance of infringement.

Suno, based in Massachusetts, launched its first product last year and claims over 10 million users. The company, which has a partnership with Microsoft, recently raised \$125 million from investors and charges a subscription fee for its service. Udio, also known as Uncharted Labs and based in New York, released its app in April and gained attention for creating the parody track "BBL Drizzy" amid a feud between artists Kendrick Lamar and Drake. Udio is backed by prominent venture capital firms, including Andreessen Horowitz.

The lawsuits, announced by the Recording Industry Association of America, are part of a broader wave of legal actions from various industries challenging AI firms' use of copyrighted material. Suno did not comment on the lawsuit, while Udio stated on its blog that it is not interested in reproducing existing content.

- **Kanye and Summer's estate reach copyright settlement**

Kanye West and the estate of Donna Summer have resolved a copyright dispute over the unauthorized use of Summer's 1977 hit "I Feel Love." In February, Bruce Sudano, Summer's husband, filed a lawsuit against West, accusing him of using an unapproved sample from the song on his album "Vultures 1." The estate claimed that West went ahead with the sample despite their previous denial of his request.

According to the estate's lawyer, Alien Music, representing West, sought clearance for the sample on January 31, just a week before the album's release. The lawsuit argued that West used recognizable parts of the song despite the estate's explicit denial and rejection of the proposed use. The estate emphasized their desire to avoid any association with West's controversial history.

West has faced significant criticism in recent years for remarks considered far-right or anti-Semitic.