

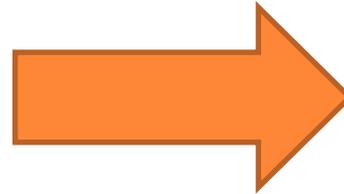
# INTELLECTUAL PROPERTY RIGHTS

REFRESHER COURSE  
FOR FIRST LEVEL COMMERCIAL COURTS  
AT  
THE NATIONAL JUDICIAL ACADEMY,  
BHOPAL

14<sup>th</sup> October 2017

PRATHIBA M. SINGH  
Judge, Delhi High Court  
[prathiba@pmsingh.in](mailto:prathiba@pmsingh.in)

# INTELLECTUAL PROPERTY IN DAILY LIFE



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Trademarks  
Designs  
Trade Secrets  
Trade dress



Copyrights-  
Authors  
Photographers



# INTELLECTUAL PROPERTY IN DAILY LIFE



**SEMICONDUCTOR  
CHIPS**

**BRANDS**



**DESIGNS**



**PATENTS IN  
TECHNOLOGY**



App Store



Google play

**COPYRIGHTS IN  
'APPS'**

# INTELLECTUAL PROPERTY IN DAILY LIFE



© Can Stock Photo



DESIGNS  
TRADEMARKS  
COPYRIGHTS  
GEOGRAPHICAL  
INDICATIONS



*fabindia*



Calvin Klein



# INTELLECTUAL PROPERTY IN DAILY LIFE



Nestlé



TRADEMARKS, COPYRIGHTS,  
TRADE DRESS

DESIGNS  
TRADE SECRETS



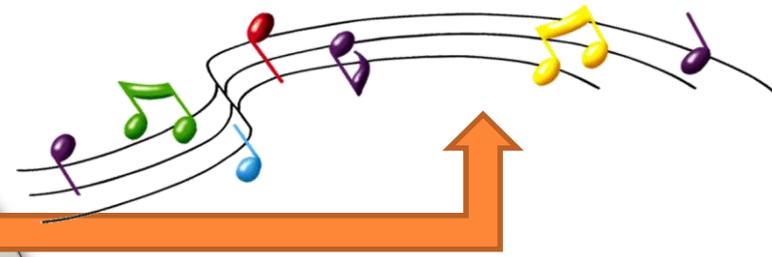
COPY-RIGHTS  
IN  
RECIPES



PLANT VARIETIES, GEOGRAPHICAL  
INDICATIONS



# INTELLECTUAL PROPERTY IN DAILY LIFE



**COPYRIGHTS IN MUSICAL WORK  
FM RADIO-COMPULSORY  
LICENSING**



**DESIGNS**



**PATENTS IN  
TECHNOLOGY**



**HONDA**

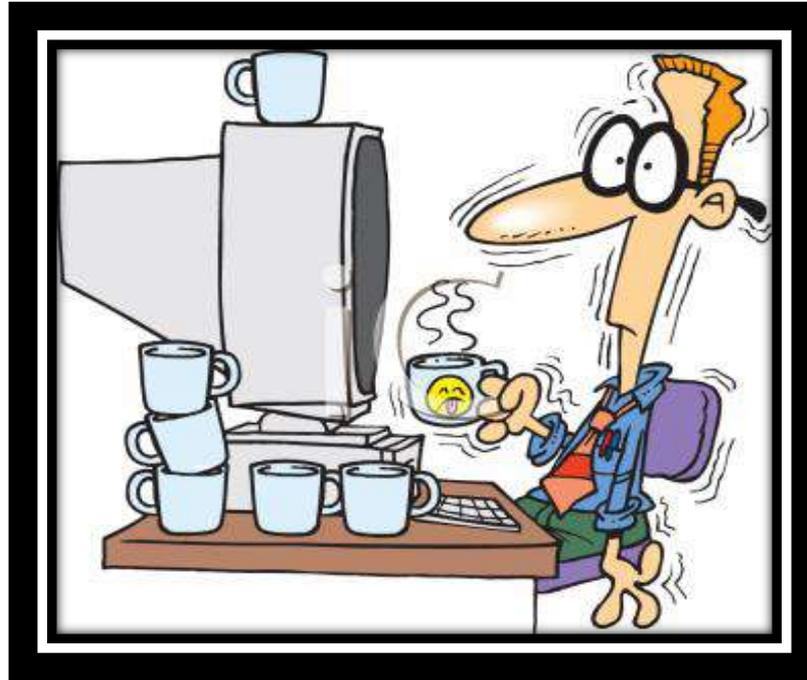
**SUZUKI**

**TRADEMARKS,  
COPYRIGHTS IN  
ARTISTIC WORK**

# INTELLECTUAL PROPERTY IN DAILY LIFE



TRADEMARKS



TRADE DRESS



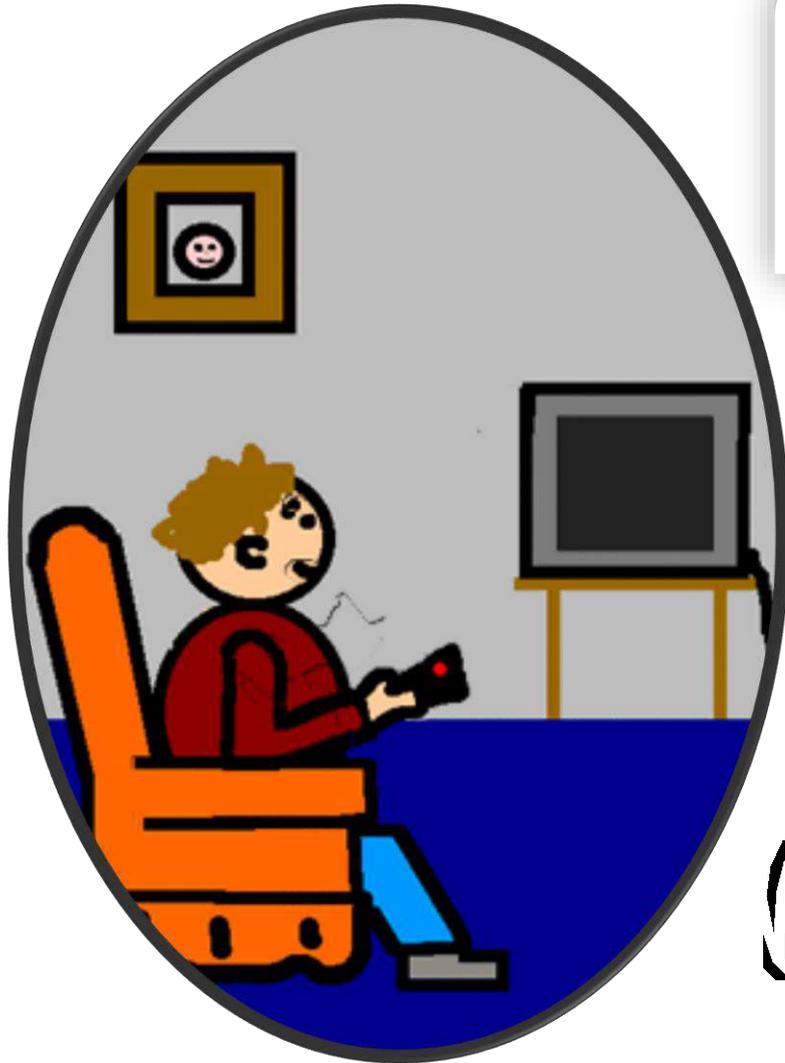
iOS



Linux

COPYRIGHTS IN  
SOFTWARES

# INTELLECTUAL PROPERTY IN DAILY LIFE

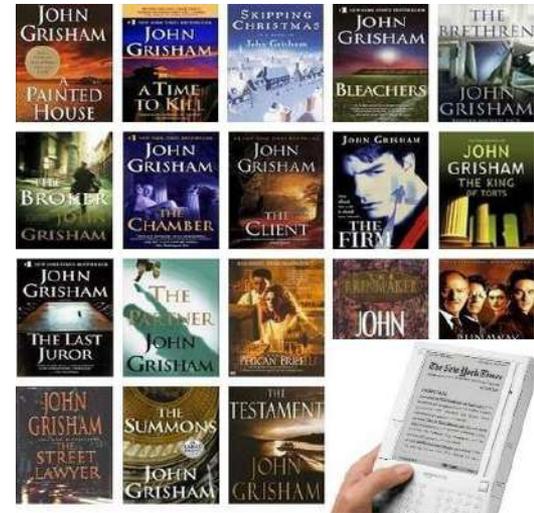


**BROADCASTING RIGHTS**

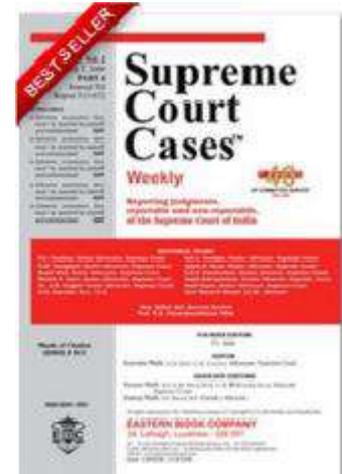
**COPYRIGHTS**



# INTELLECTUAL PROPERTY IN DAILY LIFE



**COPYRIGHTS IN  
BOOKS**





# Theme by WIPO: Innovation - Improving Lives

IPRs improve lives:

- Drugs,
- medical devices
- Telecommunication
- Transportation
- Textiles, GIs,
- Handlooms



# GENESIS OF INTELLECTUAL PROPERTY RIGHTS

## **Statute of Monopolies:**

British law, passed in 1623, that abolished the government-sponsored dominance by guilds of particular industries and vested the creator of intellectual property with the rights thereto.

## **Exclusive Jurisdiction:**

A federal court has exclusive jurisdiction over a case when federal courts may hear the case but state courts may not.

## **Contract Law:**

The series of statutory laws, case law and common law that governs the enforceability of agreements and promises between people.

## **Mutual Assent:**

The presence of an offer and an acceptance in the case of a contract. Mutual assent is a necessary element for most contracts to be enforceable

## **Consideration:**

The contract law doctrine which dictates that both sides of an agreement must suffer or agree to suffer a legal detriment for a contract to be enforceable (i.e., both sides must agree to give something up).

## **Misappropriation:**

The tort that applies when one party wrongfully uses information gathered by, or belonging to, another person for his or her own commercial purposes.

# GENESIS OF INTELLECTUAL PROPERTY RIGHTS

**1883: Paris Convention For The Protection Of Industrial Property**

**1886: Berne Convention For The Protection Of Literary And Artistic Works**

**1891 – Madrid Agreement**

**1893-Bureaux For The Protection Of Intellectual Property**

**1925- Hague Agreement Concerning the International Deposit of Industrial Designs**

**1967-World Intellectual Property Rights Organization (WIPO)**

**1970-Patent Cooperation Treaty**

**1974-WIPO joins the United Nations**

**1995-Agreement on Trade Related Aspects of Intellectual Property Rights**

# Post TRIPS

- Measures of Protectionism
- Climate deal – withdrawn
- UNESCO – withdrawn
- Build a wall
- So are we now seeing an age of more Bilateral rather than multilateral agreements



OR



# 1883:PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY

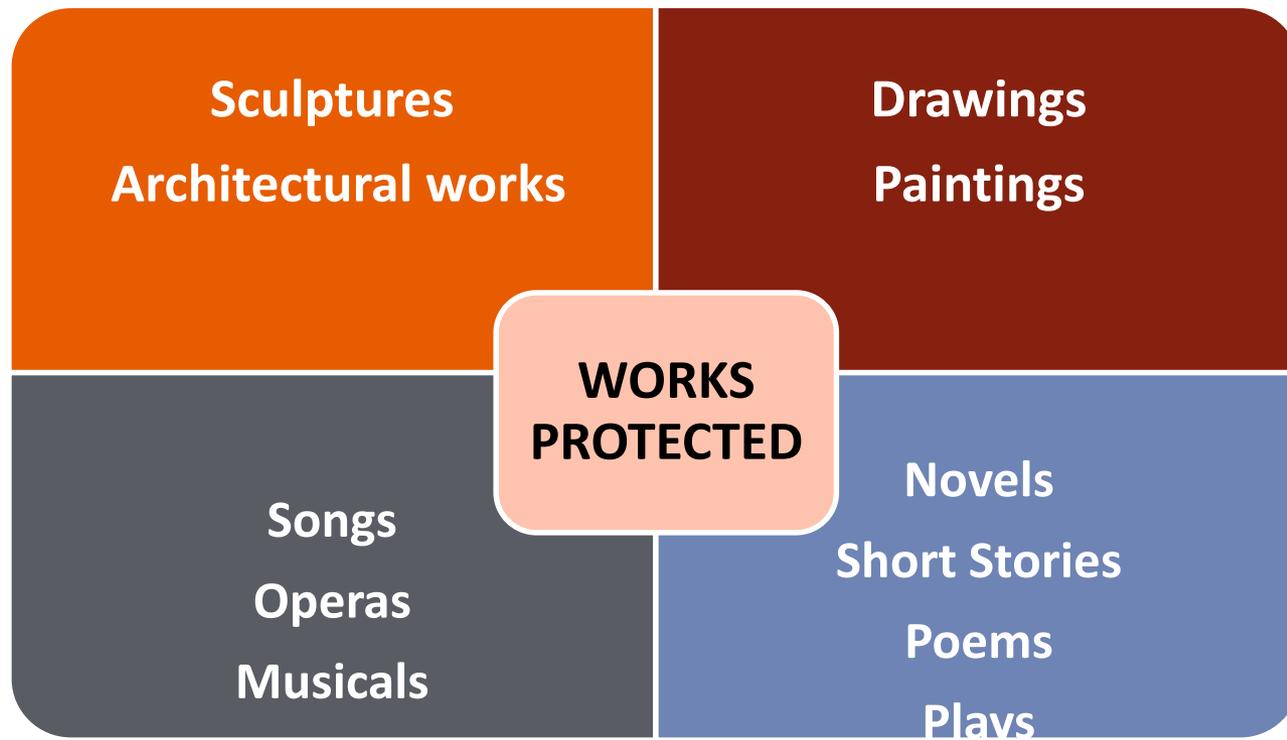
- FIRST STEP TO ENSURE PROTECTION OF INTELLECTUAL WORKS OF PEOPLE
- COVERED PATENTS, TRADEMARKS AND INDUSTRIAL DESIGNS
- REALISED THE NEED FOR INTERNATIONAL PROTECTION OF IP

## **REALISING THE NEED FOR PROTECTION**

*EXHIBITORS FROM OTHER COUNTRIES REFUSED TO ATTEND INTERNATIONAL EXHIBITIONS ON INVENTIONS IN VIENNA AS THEY WERE AFRAID THEIR IDEAS MIGHT BE STOLEN*

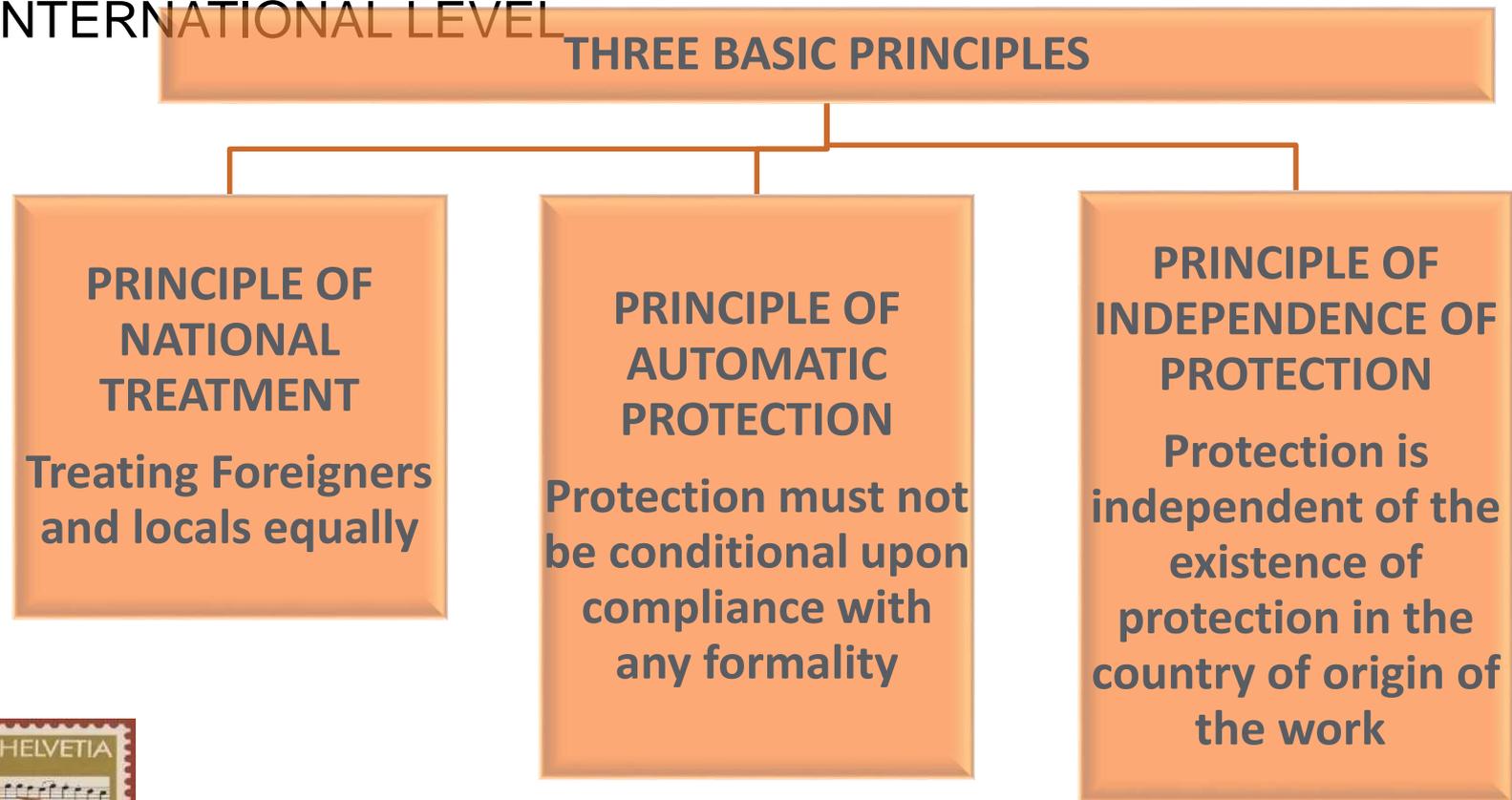
# 1886: BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS

- AGREED AFTER A CAMPAIGN BY FRENCH WRITER VICTOR HUGO AND HIS ASSOCIATION LITTÉRAIRE ET ARTISTIQUE INTERNATIONALE
- DEALS WITH PROTECTION OF WORKS AND RIGHTS OF THE AUTHORS



# 1886: BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS

- AIM - GIVE CREATORS THE RIGHT TO CONTROL AND RECEIVE PAYMENT FOR THEIR CREATIVE WORKS ON AN INTERNATIONAL LEVEL



# 1886: BERNE CONVENTION FOR THE PROTECTION OF LITERARY AND ARTISTIC WORKS

**Right to Translate**

**Moral Rights**

**Right to Perform in Public**

❖ General rule is that protection must be granted until the expiration of the 50th year after the author's death

**Right to Broadcast**

**Right to Recite**

**Right to Use Work as a Basis for Audiovisual Work**

**Right to make Adaptations & Arrangements**

**Right to make Reproductions**

**Right to Communicate to the Public**

## ❖ LIMITATIONS AND EXCEPTIONS ON ECONOMIC RIGHTS:

- Reproduction in Special Cases
- Use of Works by way of Illustrations for Teaching Purposes
- Use of Works for Reporting Current Events
- Ephemeral recordings for Broadcasting

## **1891 – MADRID AGREEMENT**

- One stop solution for registering and managing marks worldwide
- File one application, in one language, and pay one set of fees to protect a mark in the territories of up to 98 members
- Manage a portfolio of marks through one centralized system.

## **1893-BUREAUX FOR THE PROTECTION OF INTELLECTUAL PROPERTY**

The Secretariats for the Paris and Berne Convention together formed BIRPI to coordinate and allocate the necessary responsibilities to appropriately enact the Berne Convention's legislation and international copyright law.

# 1970-WORLD INTELLECTUAL PROPERTY ORGANIZATION

- BIRPI transformed to become a member state-led, inter-governmental organization known as the World Intellectual Property Rights Organization (WIPO)
- WIPO joined the United Nations in 1974 and became a specialized agency of the UN
- WIPO is now the global forum for intellectual property services, policy, information and cooperation
- All members of the UN are entitled to become members of WIPO

# (TRIPS AGREEMENT)

- Came into effect on 1 January, 1995
- Most comprehensive multilateral agreement on intellectual property
- It covers: Copyrights, Trademarks, Geographical Indications, Industrial Designs, Patents, Plant Varieties, Layout Designs of Integrated Circuits, Undisclosed Information like Trade Secrets.

**TRIPS**

Trade **Related Intellectual Property Rights**

# INTELLECTUAL PROPERTY RIGHTS IN INDIA



# BENEFITS & IMPORTANCE OF INTELLECTUAL PROPERTY RIGHTS

- INDIA HAS ALWAYS BEEN AN INNOVATIVE SOCIETY – BUT LACKS AWARENESS REGARDING THE IMPORTANCE OF INTELLECTUAL PROPERTY RIGHTS
- IP STIMULATES CREATIVITY AND INNOVATION
- IP RIGHTS ARE MARKETABLE FINANCIAL ASSETS AND AN ECONOMIC TOOL
- IP PROMOTES ADVANCEMENT IN SCIENCE AND TECHNOLOGY, ARTS, BIODIVERSITY, ETC.
- IP PROVIDES COMPETITIVE ADVANTAGE IN COMMERCIAL ACTIVITIES BY PREVENTING UNAUTHORIZED EXPLOITATION BY THIRD PARTIES

India's Pride Mangalyaan!



# BENEFITS & IMPORTANCE OF INTELLECTUAL PROPERTY RIGHTS

- IP PROTECTION PROVIDES A GUARANTEE WITH RESPECT TO THE SAFETY AND QUALITY OF GOODS
- IT ENABLES TECHNOLOGY TRANSFER – LICENSING, ASSIGNMENT
- IP IS AN INTANGIBLE ASSET THAT HELPS SMEs GET FINANCING – LOANS, INVESTMENTS etc.

Application	2012-2013	2013-2014	2014-2015	2015-2016
PATENT	43,674	42,951	42,763	46,904
DESIGN	8,337	8,533	9,327	11,108
TRADEMARK	1,94,216	2,00,005	2,10,501	2,83,060
GI	25	75	47	14
<b>TOTAL</b>	<b>2,46,251</b>	<b>2,51,564</b>	<b>2,62,638</b>	<b>3,41,086</b>

Annual report for 2015-16 by The Office of the Controller General of Patents, Designs, Trademarks and Geographical Indications India

# TRADEMARKS

- ❖ Trademarks are distinctive marks of authenticity that distinguish goods and services of a particular merchant from others
- ❖ Trademarks act like a trust mark and reminds the customer of the satisfaction from the previous purchase
- ❖ It is an assurance of quality
- ❖ It creates an emotional appeal to products/services – building a valuable brand
- ❖ Unauthorized parties can use a mark and damage the reputation and businesses
- ❖ Registering Trademarks protects businesses appropriately against competition – by registering a TM one builds a barrier to entry around one's brand



# TRADEMARKS – Recent developments

- ❖ 500 Pending opposition/rectification matters referred to mediation and conciliation with the consent of parties (February 2016)
- ❖ 100 new Trademark examiners have been appointed
- ❖ India joined the Madrid Protocol for the International Registration of Marks (July 2013)
- ❖ The Trademarks office has recruited 203 new Trademark Agents (15<sup>th</sup> March 2016)
- ❖ Indian Trademarks Office initiated E-Registration Certificates whereby the entire process of generation and dispatch of registration certificates will be automated

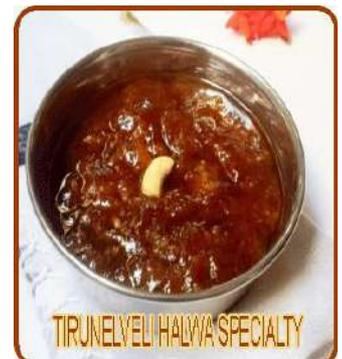
# TRADEMARKS – Recent developments

- *S. Syed Mohideen v. P. Sulochana Bai*, 2016 ( 66 ) PTC 1 ( SC )  
Passing off right is a broader remedy than that of infringement.



# ***S. Syed Mohideen v. P. Sulochana Bai, (2016 (66) PTC 1(SC))***

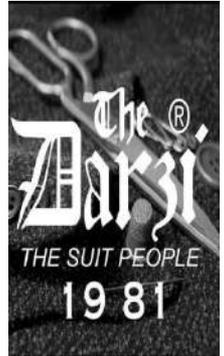
- A Halwa shop from Tirunelveli in Tamil Nadu called 'Iruttukadai Halwa' fought right till the Supreme Court to protect its brand
- Respondent -registered owner of trademark '*Iruttukadai Halwa*'. Appellant opened a shop in the name of '*Tirunelveli Iruttukadai Halwa*'.
- Supreme Court observed that:
  - ❑ Rights conferred by registration are subject to the rights of the prior user of the trademark.
  - ❑ Passing off rights are considered to be superior to that of registration rights
  - ❑ Registration merely recognizes the rights which are already pre-existing in common law and does not create any rights
  - ❑ The latter user of the mark/name or in the business cannot misrepresent his business as that of business of the prior right holder



# Case laws: Trade marks

## SUNIL MITTAL & ANR v. DARZI ON CALL (CS(COMM) 1381/2016):Translations and Descriptive Trademarks

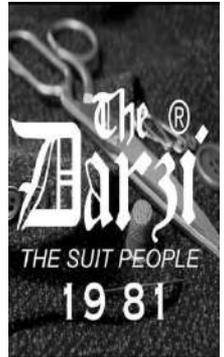
- The Plaintiffs claiming to be the registered proprietors of a label containing the words 'The Darzi: The Suit People, 1981' sued the Defendants to prevent them from using the word/mark 'Darzi'.
- **Findings of the Court:**
  - ❑ **Descriptive Trademarks:** 'Darzi' being an Urdu word, undoubtedly not common. Distinction had to be drawn between *'the use of a word as descriptive of services provided under a trademark, and the use of that word in the trademark itself'*. *If a person, for the first time, starts using a word that had previously only been used as descriptive of services, as a trademark – that innovation to use it as a mark was deserving of trademark protection.*
  - ❑ **Test of area of usage:** *the test was not only of whether a word is understood at a particular place, but also whether it is generally used at that place as descriptive of the services rendered. While Darzi was used in the spoken language as descriptive of the vocation of a tailor, it was not used to designate the service of tailoring.*
  - ❑ **Translations:** *If a product is marketed in a particular area or place under a descriptive name and has gained a reputation thereunder, that name which distinguished it from competing products, it will be protected against descriptive use.*



# Case laws: Trade marks

SUNIL MITTAL & ANR v. DARZI ON CALL (CS(COMM) 1381/2016): **Essential features and 'litigation as a business'**

- ❑ **Essential feature of the mark:** When the similarity between the two marks is being judged, the test has to be looked at from the angle of human interactions in a particular society/city, and cannot be abstract. *"What has to be applied is the test of human beings and not a test as laid down in the law books in relation to a different society."*
- ❑ **Goodwill and reputation:** Dishonesty on part of the Defendants and their attempt to ride on the goodwill of the Plaintiffs, as well as steal their market, and pass off their goods/services as the Plaintiffs prejudiced both the Plaintiffs and the world at large.
- ❑ **Litigation as a business:** *It is not expected of a proprietor of a trademark to, instead of carrying on business under the trademark, make litigation a business by continuously being on the prowl for every use of that trademark, howsoever insignificant and inconsequential may be, and to take legal proceedings to prevent such use. A proprietor of a trademark is not expected to commence legal proceedings if it remains unaffected by use of the same trademark by others.*





- Trade mark EXIDE
- US company coined it – Its British subsidiary started using it
- British company set up an Indian company
- US company was told under Competition law not to sell outside US
- Indian Company obtained registration
- After economy opened – Can Indian company stop the US company from using Exide in India?
- Single Judge held YES
- Division Bench held that US Company can use the mark EXIDE
- Matter settled in the Supreme Court.

# Case laws: Trade marks



## **Prius Auto Industries Ltd & Ors. v. Toyota Jidosha Kabushiki: Trans-border reputation redefined**

- On 8th July, 2016 a Single Judge of the Hon'ble Delhi High Court awarded permanent injunction against the defendant restraining them from using, in relation to auto parts and ancillaries, the mark **PRIUS** and other registered trademarks of the plaintiff. The Court also awarded damages to the tune of rupees 1 million.

# Case laws: Trade marks



- **The Division Bench's reversing the decision observed that:**
  - ❑ Acquiring trans-border reputation is essentially a question of fact and therefore, it requires the evidence to be considered.
  - ❑ Evidence has to be prior to April 2001 – when the Defendant adopted;
  - ❑ The circulation of publications in India mentioning the launch of the hybrid car “**Prius**” by Toyota, including those from the year 1997, although involving the awareness of the relevant sections of the public and trade limited to the automotive sector, was not ***news of explosive nature*** that would catch the attention of all and sundry.
  - ❑ There being no advertisements published by Toyota for its car Prius in India, coupled with the fact that not all cars marketed by Toyota under different trade marks acquire a global reputation.
  - ❑ Further, since internet penetration as of the year 2001 being low in India, the weight of the evidence leans in favour of the view that by ***April 2001*** Toyota had not established a global reputation in its trade mark Prius which had entered India
  - ❑ Since the defendant had been selling their products under the mark **PRIUS** for nearly ten years when the suit for injunction was filed, the test to be applied is of “evidence of actual confusion” and not “*likelihood of confusion*”

# Leading cases: Copyright



## Department Of Electronics And Information Technology v. Star India Pvt. Ltd. : Combating Online Piracy

- As many as 73 websites which were illegally streaming “pirated” videos of cricket matches were banned by the Court
- **Observations by the Court:**
- *Rogue websites are indulging in rank piracy and thus prima-facie the stringent measure to block the website as a whole is justified because blocking a URL may not suffice due to the ease with which a URL can be changed..*
- *It would be a gargantuan task for the respondent to keep on identifying each offending URL and especially keeping in view that as and when the respondent identifies the URL and it is blocked by the ISP, the rogue website, within seconds can change the URL thereby frustrating the very act of blocking the URL..*
- *It was the “duty of the government” and its agencies to “assist in the enforcement of court orders”*

# TRADEMARKS – Recent developments

- *Intellectual Property Attorneys Association v. The Controller General of Patents, Designs and Trade Marks,*

W.P.(C) 3067/2016 & CM APPLs. 12987-12988/2016

The Delhi High Court stayed the orders of abandonment passed by the Respondent on or after 20th March 2016 and directed the Respondents not to treat any trademark application as abandoned without proper notice being given to the effected party under the Trademarks Act

IPR

AA

**INTELLECTUAL PROPERTY RIGHTS**

**ATTORNEY ASSOCIATION**



**INTELLECTUAL  
PROPERTY INDIA**

# TRADEMARKS – Recent developments

- *Cartier International Ag & Others v. Gaurav Bhatia, 2016(65)PTC168(Del)*  
Court took a strict stand against piracy & counterfeiting and ordered for exemplary damages of Rs 1 crore (approximately USD 147,000) in favour of the Plaintiff.



A screenshot of the Digaaz website homepage. The website features a dark header with the Digaaz logo and navigation links for MEN, WOMEN, JUST LANDED, FENS, and PASSPORT HOLDERS. A large promotional banner is displayed, offering up to 20% off storewide with the code "TWENTY20". The banner includes a man sitting on a globe and a globe itself. The text on the banner reads: "UPTO 20% off STOREWIDE!!", "Use Code 'TWENTY20'", and "Hurry Only For Today!!". At the bottom of the banner, it says "PAY USING CREDIT/DEBIT CARD, NET BANKING &amp; GET ADDITIONAL 5% DISCOUNT!". Below the banner are buttons for "SHOP MEN" and "SHOP WOMEN".

# TRADEMARKS – Recent developments

➤ *ITC Limited v. Britannia Industries Limited*, 2016(68)PTC11(Del)

Britannia restrained from violating rights of ITC in packaging/trade dress of 'Sunfeast Farmlite Digestive-All Good' biscuits by allegedly using a deceptively and confusingly similar trade dress for 'Nutri Choice Digestive Zero' biscuits. Division Bench held that colours cannot be monopolised.



# TRADEMARKS – Recent developments

➤ *Data Infosys v. Infosys Technologies*, 2016(65)PTC209(Del)

Prior permission of the Court in a pending infringement suit is not necessary for filing a rectification petition before the Intellectual Property Appellate Board.



# No Monopoly Over Names of Hindu Gods

- Ld. Single Judge of the Bombay High Court refused to grant an interim injunction for infringement/passing off of the plaintiff's "LAXMI" mark.
- Observations:
  - ❑ Plaintiff and defendant both had different and unique labels containing the word "LAXMI".
  - ❑ "LAXMI" is both a common female name and the name of a Hindu deity, and therefore cannot be monopolized.
  - ❑ Plaintiff cannot be allowed to extract the common word used in the label and claim exclusivity over it.
- In appeal, the Division Bench agreed with Single Judge:
  - ❑ Differences between marks enough to distinguish the two marks in the minds of the consumer of average intelligence and imperfect recollection
  - ❑ Names of Hindu Gods are not exclusive and cannot be monopolized by one party.



# Recent Developments

## Trade Marks Registry

- Speeding up of registrations
- The number of forms for applications brought down from 74 to just 8 making the entire process much more simple and hassle free.
- Promoting e-filing Online filing has become compulsory for determining a well-known Trademark. Even for certification or transmission of an international application one needs to apply online
- Registration of sound marks are now mentioned in the Trademark Rules 2017
- The fees for registration have been increased but concessions have been provided to Start Ups, Individuals and Small Enterprise
- A proper Process for the Determination of “Well Known Mark” has been established now trade mark holders do not need to go through a trade mark infringement dispute in court for their mark to be declared as a well known mark just an application to the registrar for the status needs to be given
- Filing to registration now takes less than ONE YEAR



# COPYRIGHTS

Copyright protection gives an exclusive right to do or authorize to do certain acts with respect to the following works:

**Literary**



**Musical**

**Artistic**



**Cinematographic  
Film**

**Sound Recording**

**Dramatic**

**Computer Program**

# COPYRIGHTS

- Copyright benefits the author – prevents unlawful reproduction or exploitation by others
- It is the protection or reward of the efforts of the author – need not be meritorious or creative
- It encourages people to create original work by rewarding exclusive rights
- Protection is only given to Expression and not Ideas
- Protection is Automatic

## *Examples of copyright:*

- \*books, brochures and newspapers
- \*theatrical works
- \*oral presentations
- \*choreographic works
- \*music (with or without words)
- \*drawings, paintings, buildings and sculptures
- \*designs
- \*photographic works
- \*computer programs

## copyright

[ 'kopi, raɪt ]

1. the exclusive right to make copies, license, and otherwise exploit a literary, musical, or artistic work, whether printed, audio, video, etc.



# COPYRIGHTS-RECENT Developments

- ❑ Transferred from Ministry of Human Resource Development (MHRD) to Department of Industrial Policy and Promotion (DIPP)
- **Department of Electronics and Information Technology v. Star India Private Ltd., 2016 SCC OnLine Del 4160**

The Delhi High Court ordered the blocking of 73 websites and directed the Department of Electronics and Information Technology to assist in the enforcement of the orders passed on online piracy issues.

Question before the Court:

Whether URL only should be blocked or entire website should be blocked

URL :

[http://www.nja.nic.in/Academic\\_Calendars/Academic%20Calendar%20\(2017-18\)Final\(09-09-2017\).pdf](http://www.nja.nic.in/Academic_Calendars/Academic%20Calendar%20(2017-18)Final(09-09-2017).pdf)

Website:

<http://www.nja.nic.in/>

# The Chancellor, Masters & Scholars of The University of Oxford & Ors. Vs. Rameshwari Photocopy Services & Anr.



- Suit filed by three publishers against DU and a photocopy shop was dismissed.
- It was held that unauthorized making and distribution of course packs does not amount to copyright infringement as it falls within the ambit of Section 52(1)(i) of the Copyright Act
- permits reproduction of works by teachers or students in the course of instruction.

# The Chancellor, Masters & Scholars of The University of Oxford & Ors. Vs. Rameshwari Photocopy Services & Anr.

- On appeal, a Division Bench of the Court held that:
  - ❑ Fairness determined on the touchstone of 'extent justified by the purpose' without considering the extent of material used – qualitative or quantitative
  - ❑ So much of the copyrighted work can be fairly used which is necessary to effectuate the purpose of the use i.e. make the learner understand what is intended to be understood.
  - ❑ Argument that there will be adverse impact on the market of the Copyrighted work – rejected on the grounds that the student will not be a potential customer of 30-40 reference books

# PayTM v. Unicommerce

## Copyright and Data mining



- Seller uploads his wares, inventories
- Seller periodically checks the position of sales, quantity available, orders placed, payments received
- For that he has to login to each of the e-commerce websites several times in a day.
- If a seller has his wares in several market sites, then the sheer effort of logging in and out of these websites involves huge manpower, time and expenditure.
- So he uses the services of the Defendant which is nothing but an Interface.



- Seller creates an ID and a login with the Defendant;
- Seller provides to the defendant his login and other credentials which he has with ebay, Amazon, Snapdeal and PayTM etc.,
- Defendant provides a software system and interface as an AGGREGATOR;
- Defendant, through his work force aggregates all the data about the seller from different market websites
- It is presented on one Palatte for the Seller
- This is convenience for the Seller
- No data theft is involved
- Defendant is authorised by the Seller to access ONLY the SELLER'S data
- The Defendant does not access any other data which is not authorised
- The Seller has the OPTION to use or not to use the defendant's services.
- The Seller can continue to access each site with his own credentials without going through the defendant.

# PayTM v. Unicommerce

- Interface between data protection laws, copyright and rights of IP owners
- leading E-Commerce management software company, Unicommerce eSolutions Pvt Ltd and a mobile e-commerce/wallet services company, Paytm.
- Paytm alleged that Unicommerce was extracting, using and manipulating Paytm's proprietary copyright information, being the log in details of their sellers/merchants by displaying the same on its website to the commercial disadvantage of Paytm.
- Unicommerce said it was only an aggregator;
- there was no extraction or manipulation as alleged by Paytm as the sellers themselves authorize Unicommerce to access their contents and information and provide them with a comprehensive dossier of their transactions alone, on different platforms.

# PayTM v. Unicommerce

- The Hon'ble Court passed an order and recorded Unicommerce to the statements made in Court, most pertinent one being that, it shall not use the data derived from the sellers for itself, and that the same shall be made available exclusively to the sellers when they access Unicommerce website.
- Unicommerce also submitted that they are merely accessing the site of Paytm as the representative of its customers who are sellers of Paytm, upon their authorization and not crawling into the site of Paytm as alleged.

# Cricket matches



- Sports Broadcasting Signals Mandatory sharing with Prasar Bharti Act, 2007
- Star alleged that they have copyright in the cricket matches. They paid Rs. 3000 crores for the rights
- DD telecasting on cable TV has killed their market. They can only share for terrestrial and DTH network
- Supreme Court held that DD can only show on DD National and DTH – Cannot retransmit on Cable TV

# GEOGRAPHICAL INDICATION



- GI registration provides legal protection to goods in national and international markets
- Prevents unauthorized use of the GI and gives the right to sue for infringement
- Legal protection promotes exports and provides financial benefits
- Term: 10 years – can be renewed



# DARJEELING TEA – GI

*...the champagne of teas*

- ❖ 87 Tea Estates – more than 1 lakh workers – 8 to 9 million kgs produced every year – 70% exported
- ❖ Well-known for flavour and quality – recognition all over the world
  - ❖ Quality, reputation and characteristics – attributable to Geographic Origin – cannot be replicated anywhere else



1986 – Darjeeling logo created and registered in various countries including UK, USA, Canada

1999 – Darjeeling certified TM Protection Scheme

2004 – Registered as GI

Various Legal victories due to Registration as GI

# KASHMIR PASHMINA

**Known all over the world for its soft, strong, light texture & excellent insulation**

**Handwoven Pashmina Shawls of Kashmir – accredited with GI mark in 2008**

**Mark imprinted in the form of a label – assurance of testing and quality**

**Done to restore the Handicrafts industry in Kashmir and the economic prosperity of artisans**



# ONLINE MARKET PLACES AND ON INTERMEDIARIES



- Online shopping
- Is AMAZON, SNAPDEAL or FLIPKART liable for a counterfeit being sold on the websites?
- Courts of Judicature have recognized that online market places are not expected to sit in judgment over the legality or unlawfulness of the impugned content in a takedown notice
- Intermediaries cannot evaluate the legality of its content.

# Landmark cases: Intermediary liability

## **Shreya Singhal v. Union of India**

- The Supreme Court declared Section 66A of the Information Technology Act as unconstitutional
- Court construed Section 79 of the IT Act in such a manner that removal of content online may only occur if an adjudicatory body issues an order compelling intermediaries to remove the content
- Interpretation of Section 79 shields intermediaries from liability unless they fail to comply with an order directing them to remove the illegal content, rather than merely a private party request
- Transparency standards should apply to blocking orders and all website blocking orders should be made public

# ONLINE MARKET PLACES AND ON INTERMEDIARIES



- Supreme Court read down 'actual knowledge' under section 79 of the Information Technology Act to mean that there has to be a court order directing the intermediary to expeditiously remove or disable access to the impugned content.
- In lines with the said ruling in the matter of Shreya Singhal vs. Union of India, Courts have ruled in favour of online shopping sites exempting them from liabilities arising out of trademark/copyright infringement committed by third party infringers.
- Their main responsibility is to TAKE DOWN the infringing product

# Landmark cases: Intermediary liability

## **Avnish Bajaj Vs. State (The Bazeed case)**

- Mr Bajaj, Chief Executive Officer of US-based auction portal ebay's Indian subsidiary Baazee.com, was arrested after a video clip containing objectionable matter showing two Indian teenagers was offered for sale at Baazee.com
- His liability stemmed from the fact that his website was allegedly publishing prohibited electronic content under existing laws in India
- The court observed that “by not having appropriate filters that could have detected the words in the listing or the pornographic content of what was being offered for sale, the website ran a risk of having imputed to it the knowledge that such an object was in fact obscene”, and thus it held that as per the strict liability imposed by Section 292, knowledge of the listing can be imputed to the company. The judgment however did not declare Avnish Bajaj guilty.

# Arbitrability of Intellectual Property Disputes



- Legal claims arising from IP licensing and other commercial transactions are essentially “in personam” disputes- Nothing exists under Indian law which ousts such disputes from arbitration
- Arbitration can avoid parallel litigations and has inherent advantages in dealing with commercial disputes in respect of flexibility, confidentiality & finality
- IP arbitrations are rare because IP disputes frequently do not involve a preexisting contractual relationship. Arbitration, however, requires a contractual agreement to arbitrate

# Arbitrability of Intellectual Property Disputes: Case Law

- **Eros International Media Limited v. Telemax Links India Pvt. Ltd.**
  - The Bombay High Court on an application under Section 8 of the Arbitration and Conciliation Act, 1996, held that IP disputes arising out of an agreement are arbitrable if such agreement contains an arbitration clause. The Court passed the order in favour of Telemax and held that:
    - Provisions of the Copyright Act and the (Indian) Trade Marks Act, 1999 (Trademarks Act) do not oust the jurisdiction of an arbitral panel;
    - Although IP rights are special rights, they are still a species of property rights and share much with their more tangible cousins to whom acts such as the Sale of Goods Act, 1930 or the Transfer of Property Act, 1882 apply; and
    - Eros' action is in personam as it is seeking a particular relief against a particular defined party.