

NATIONAL JUDICIAL ACADEMY, BHOPAL



Workshop for High Court Justices on Intellectual Property Rights (IPRs) [P-1247]

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Programme Report

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The National Judicial Academy (NJA) organized a two-day online Workshop for High Court Justices on Intellectual Property Rights (IPRs) on 10th & 11th April, 2021. The workshop deliberated on contemporary avenues and challenges in intellectual property rights that are required to be addressed for strengthening enforcement and combating economic crimes. Justices were acquainted with legal challenges evolving due to the shift in societal interface from physical to virtual space and litigation challenges faced by judges and parties in IPR disputes. The workshop provided a forum for participants to discuss, deliberate amongst themselves, share experiences, knowledge and best practices in exercise of jurisdiction.

Session 1

Contours of IP Legislations: The Overlaps

Scope of Discussion

- Overlap between Patents & Design
- Design vis-à-vis Copyright debate
- Overlap between Domain Name & Trademark
- Relationship between Trademark Rights & Unfair Competition

Speaker - Justice Prathiba M. Singh

Chair - Justice S. Ravindra Bhat

Dimensions acquired by Intellectual property Rights in today's world/ contemporary times particularly when we have entered the world of TRIPS and aligned our laws in consonance to trips and WTO mandate and yet there are certain flexibility which have afforded our society to adapt in our own unique way and preserve what is ours specially traditional rights and also in realm of geographical indications. The topic of IP and its overlaps is though provoking. There are three important IPRs including TMs Copyrights and Patents and there are others such as Designs which are subject matter of separate statute but whose concepts are similar to copyright law and to some extent patent. Then there is unwritten and codified common law of tort and passing-off. IPR law is society's endeavor to protect the results of labour of authors, inventors and creators. The main distinction between the three principle IPR subjects whereas

copyright protects the expression of an original idea in any form such as words, plays, novels, films, songs, works of art, software etc, trademarks protect acquired distinctiveness used to associate the products of marked owner or service with marked assurance of quality of that product; patents on the other hand are granted for inventions having practical utility which are new involves inventive step and not have been invented and are not obvious in previous literature. One should not confuse patents with discoveries. Judges and lawyers often come across intersections & overlaps in exercise of these rights. The effect of these overlaps are varied in different IPs. Example: a trademark is a distinctive mark associated with a product, article or service, it could be a word mark or a logo or a composite device, which could also be a subject matter of copyright. Similarly now trademarks includes shape marks like a distinctive shape chocolate, distinctive shape tablets this could be protected by both legal regimes both designs as well as shape trademarks. Actual provisions which prohibit or even prevent such protection in one law or the other Common instances are Sec. 11(3) of TMs Act, Sec 15 of the Copyrights Act. Often these overlaps do come up for scrutiny. When IPR regimes protective tenures, i.e when registration expires the IP owner then attempts to enforce other IP protections which may or may not be available. The concept of double dipping a cause of overlap. In India we have experience unique interface of overlaps including judgements of Delhi and Bombay High Courts which have tackled with this issue.

Various instances of overlaps were discussed at length Trademarks include overlaps with Copyright, designs, Passing Off, Unfair Comp.; Copyrights includes Overlap with TM and Designs; Designs includes overlap with TM, trade dress and Copyright; Patents – Overlap with plant varieties, semi-conductors, drugs and cosmetics, insecticides; Plant Varieties – Overlap with patents; Semi-conductor chips – Overlap with patents; Geographical Indications – Overlap with TM and Passing Off.

Robust judicial decisions on the subject were highlighted during the session which included *Mattel Inc. vs. Jayant Agarwalla*, IA No. 2352/2008 in CS(O S) 344/2008; *Microfibres Inc. vs. Girdhar And Co.* [2006 (32) PTC 157 (Del), *Microfibres Inc. vs. Girdhar And Co.* (DB) [(2009 (40) PTC 519 (Del.) (DB), *Ritika Private Ltd. vs. Biba Apparel Pvt. Ltd.* [CS(OS) No. 182/2011(Del.), *Tata Press vs. Mahanagar Telephone Nigam Ltd*, [1995 SCC (5) 139,

Hamdard Dawakhana vs. UoI, [1960 SCR (2) 671], *Havells vs. Amritanshu*, [CS(OS) 107/2015], *Hindustan Unilever Limited (“HUL”) vs. Emami Limited*, [2020 SCC OnLine Bom 764], *Mohan Lal vs. Sona Paint and Hardwares* [CS(OS) No. 384/2008], *Monsanto Technology LLC & Ors. vs. Nuziveedu Seeds Ltd. & Ors.* (1986) SCC1 642.

Session 2

Essence of Time in IP Litigation: Judicial Approach

Scope of Discussion

- Issues relating to awarding Injunctions as primary relief
- Case Management

Speaker - Justice Prathiba M. Singh

Chair - Justice S. Ravindra Bhat

The session commenced by emphasizing that for handling IPR matters judges need not have expertise in the subject, rather all that is essential is an involved mind with the target to learn and acquire incremental knowledge. The approach of a judge plays a significant role in delivering timely justice. For judges, presiding over IPR matters, comprehending the essence of time is all the more momentous. Therefore, the insinuation of injunctions in IPR is all the more imperative. Various forms of remedies available for IPR matters like- *Ex-parte injunction*, *Ad-interim injunction* and *permanent injunction* were discussed at length. It was highlighted that in the judgment of *Laxmikant V. Patel v. Chetanbhai Shah and Ors.* (2002) 3 SCC 65 the Supreme Court emphasized the need for passing ex-parte and interim injunction wherever a case of infringement or passing off is made out for the reason that the conflict of IPR is not just between the plaintiff and defendant but it also involves a third party, which is the consumer or the user. Hence, the court has to step in for not just protecting rights of the IP owner but also, those of the consumer or user. Subsequently, some of the innovative procedures for keeping the essence of time in place, as developed by Indian courts through various case laws was discussed. Emphasis was placed on *Anton Piller Order*, which is more

like Order 26 Rule X of the CPC, i.e., an order for appointing a local commissioner. The only difference is when it is converted into a *John Doe Order* (against unknown defendants), that it becomes a bit different. Subsequently, various innovative remedies like dynamic injunctions, John Doe Orders, geo-blocking, global injunction and domain name protection were discussed with the help of case laws. The judges were cautioned that sometimes *John Doe Orders* are essential when judges are dealing with rogue behavior, however to use this indiscriminately on a daily basis becomes fraught for the entire system.

Session 3

Impact of Commercial Courts Act, 2015 on IP Litigations

Scope of Discussion

- Pecuniary Jurisdiction
- Interplay between Commercial Courts Act and Arbitration and Conciliation Act, 1996
- Measuring the prospective impact on CPC

Speakers - Justice M. Sundar, Mr. Vyapak Desai & Ms. Gowree Gokhale

Chair - Justice Sanjay Kishan Kaul

The session involved deliberations on three aspects mainly pecuniary jurisdiction, interplay between Commercial Courts Act and Arbitration and Conciliation Act, 1996 and measuring the prospective impact on Civil Procedure Code. It was highlighted that intellectual Property disputes are included as a commercial dispute and the 2018 Amendment have widened the scope of commercial courts including cases of lower value of commercial nature. With regard to pecuniary jurisdiction three aspects were pointed out i.e. reduction in removing distinction between ordinary and commercial dispute, resolution made in commercial dispute by reducing the value and, corresponding overhaul. It was suggested that court management, procedural innovation and clarity with clear guidelines are very important. The difference between pecuniary value and specified value defined under Sec 2(1)(i) r/w Sec 12 of Commercial Courts Act was emphasized upon. On interplay between Commercial Courts Act and

Arbitration Act, Sec. 10 of the Commercial Courts Act and Sec 2(1)(e), Sec. 10, Sec. 11, Sec. 14, Sec. 17(2), Sec. 27, Sec. 29, Sec. 34, Sec. 37, Sec. 46 & Sec. 50 of the Arbitration & Conciliation Act was highlighted. A reference was made to following judgements *Kirtikumar Futarmal Jain vs. Valencia Corporation* [2019 SCC Online Guj 3972]; and *Gaurang Manguesh Suctancar vs. Sonia Gaurang Suctancar*, [LD-VC-CW-88-2020]. Some other areas which were discussed at length included interlocutory applications, early neutral valuation, Ordinance to strike down IPAB, disputes that may and may not be referred to commercial courts, appeals, multiplicity of proceedings in different High Courts, appealable orders. It was mentioned that following disputes but not referred to Commercial courts included:

1. Rectification of trademark
2. Revocation of patents and
3. Cancel or vary the registration of geographical indication

It was suggested that issues pertaining to Sec 21 of the Commercial Courts Act should be done away with to avoid multiplicity since commercial court Act is there for IP litigation. It was pointed that three provisions of CPC made inapplicable to Commercial Courts included Order XIII Rule 1, Order VII Rule 14, and Order VIII Rule 1A.

Some other cases referred during the course of session were *Kandla Export Corporation & Anr vs. OCI Corporation & Anr*, (2018)14SCC715; *Simplex Infrastructure Limited vs. Union of India*, (2021) SCC OnLine SC 233; *Govt. of Maharashtra vs. Borse Brothers Engineers & Contractors Pvt. Ltd*, (2021) SCC OnLine SC 233; *M/s. Aachi Masala Foods (P) Ltd. vs. Eastern Condiments Pvt Ltd*, C.S. No. 511 of 2018; *Fun N. Fud vs. GLK Associates*, 2019 SCC OnLine Guj 4236; *B. Kishore Jain vs. Navaratna Khazana Jewellers*, 2008(37)PTC536(Mad), *Bajaj Auto Ltd. vs. TVS Motors Co. Ltd.*, (2009) 9 SCC 797.

Session 4

Case Law Jurisprudence on IP Laws as evolved by Indian Courts

Scope of Discussion

- Landmark Judgments: Patents Law
- Landmark Judgments: Copyrights
- Landmark Judgments: Trademarks

Speakers - Justice M. Sundar & Mr. Pravin Anand

Chair - Justice Sanjay Kishan Kaul

The session commenced by accentuating that the IP regime in India over the past one and a half decade has seen crucial transformation in IP laws owing to the case law jurisprudence as evolved by the Indian courts. The discussion focused on Patent law because the field is relatively new and less explored, and also for the reason that innovation is critical to our economy and patents are an important aspect of innovation. It was highlighted that the last 15 years have seen cardinal revolution in IP laws owing to the last stage of amendments to Patents Act, 1970 in 2005 in compliance to TRIPS. Thereafter, pharmaceuticals and agro-chemical patents started getting granted for products. There was a sudden surge in patent litigation, since many changes came up post 2005. In the case *Franz Xaver Huemer vs New Yash Engineers*, AIR 1997 Delhi 79, which was related to textile loom, the division bench of the Delhi High Court took the view that, a foreign patent which is granted in India but has not been worked in India, interim injunction to such a plaintiff should not be available in India. The proposition of the *Franz Xaver Huemer case* raised the question that if, interim injunction cannot be granted and if consequently, the plaintiff does not get damages at the end of the trial, then there will be no point in having the patent system. Subsequently, when pharmaceutical patents started getting granted and enforced one of the pioneering cases that came up was *Bristol Myers Squibb Company & Ors Vs. Dr. Bps Reddy & Ors*, 2013 SCC OnLine Del 4129. The case was related to an anti-cancer drug. The defendant in this cases did not start marketing of the product but had regulatory approvals and based on that a *Quia Timet*

Action was filed that there is a reasonable apprehension that the products will be marketed and a *status quo* order was passed by the court. The *status quo* order in effect operated like an injunction. In due course of time more orders of this kind were passed at the stage of regulatory approval as *Quia Timet Actions* which slowly brought in the culture of interim injunctions.

Some pharmaceuticals, agro and life science cases that were discussed included *Novartis vs. Union of India*, (2013) 6 SCC 1, *F. Hoffmann La Roche Ltd. and Anr. vs. Cipla Ltd.*, MIPR 2016 (1) 0001, *Merck Sharp and Dohme Corporation and Ors. vs. Glenmark Pharmaceuticals*, MANU/DE/0852/2015, *Bayer Intellectual Property GMBH & Anr. v. Alembic Pharmaceuticals Ltd.* [CS(COMM) No.1592/2016], *Monsanto Technology LLC & Ors Vs. Nuziveedu Seeds Ltd & Ors*, CS (Comm) 132/2016 High Court of Delhi and the *Astrazeneca* line of cases were also discussed. Telecom and Software cases like- *Koninklijke Philips Electronics N.V. vs. Bhagirathi Electronics and Ors.* 2018 SCC OnLine Del 9793, *Telefonaktiebolaget LM Ericsson (PUBL) vs. Competition Commission of India* 2016 (66) PTC 58 (Del), *Interdigital Technology Corporation And Ors. vs. Xiaomi Corporation I.A.* 8772/2020 In CS (Comm) 295/2020: Delhi High Court were deliberated upon. Thereafter, some trademark cases like- *Hindustan Unilever Ltd. vs. Reckitt Benckiser India Limited* 207 (2014) DLT 713, *Amazon Seller Services Pvt. Ltd. vs. Amway India Enterprises Pvt. Ltd. & Ors.* 2020 SCC OnLine Del 454, *Whatman International Limited vs. P Mehta & Ors.* 2019 SCC OnLine Del 6856 were also discussed.

Effect of the abolition of Intellectual Property Appellate Board [IPAB] also formed part of the discussion. The session concluded by accentuating that there is a lot of uncertainty in many IP areas and with our rich jurisprudence in diverse fields it is quite certain that the judiciary will lead the way in making India an “IP Super Power.”