

National Judicial Academy, Delhi

Workshop for High Court Justices on Intellectual Property  
Rights (IPRs)

*Contours of IP Legislations: The Overlaps*

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# *Overlaps*

- Trade Marks – Overlap with Copyright, designs, Passing Off, Unfair Comp.
- Copyrights – Overlap with TM and Designs
- Designs – 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



# *COPYRIGHTS v. DESIGNS*

## **Industrial Design**



# *Statutory Scheme*

## Section 2(d) of the Designs Act, 2000

*Section 2. (d) “design” means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958 or property mark as defined in section 479 of the Indian Penal Code or any artistic work as defined in clause (c) of section 2 of the Copyright Act, 1957*

## Section 15 of the Copyright Act, 1957

*Section 15. Special provision regarding Copyright in designs registered or capable of being registered under the 3[\*\*\*]4[Designs Act, 2000 (16 of 2000)].—*

*(1) Copyright shall not subsist under this Act in any design which is registered under the Designs Act, 2000*

*(2) Copyright in any design, which is capable of being registered under the Designs Act, 2000 but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner of the copyright or, with his licence, by any other person*

# *Mattel Inc. v Jayant Agarwalla*

[IA No. 2352/2008 in CS(O S) 344/2008, decided on 17th September 2008]

- This case was filed by Mattel, owner of the famous ‘Scrabble’ board game. Claiming copyright over the board as an ‘artistic work’, Mattel sought a restraining order against an allegedly infringing electronic game titled ‘Scrabulous’.
- The Delhi HC extensively dealt with the overlap between the provisions of the Copyright Act and the Designs Act, 2000 and after an analysis of the provisions involved, held that since Mattel had not registered the board as a design and it had been produced in excess of fifty times, it lost copyright protection as well under Section 15(2) of the Copyright Act.
- The court held:



*“29. The objective of Copyright law is to protect the original literary, dramatic, musical and artistic works, cinematograph films, sound recordings, broadcasting rights and/or performers' rights. The object of Design Law, on the other hand, is protection of the features of shape, configuration, pattern, ornamentation, or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms by industrial process or means, whether manual, mechanical or chemical, separate or combined which in the finished appeal to and/are judged solely by the eye, but does not include any trade mark or property mark or artistic work.”*

*“31. Section 15 of the Copyright Act mandates that copyright subsists under the Copyright Act in any design, which is registered under the Designs Act, 1911 and in respect of designs capable of registration under the Designs Act, 1911, the copyright shall cease as long as any article to which the design has been applied has been reproduced more than 50 times by an industrial process by the owner of the copyright or his licensee. It cannot be disputed here that reproduction of the multicoloured game board has occurred more than 50 times, as also the alphabetical tiles. It is not also in dispute that there is no registration which has taken place under the Designs Act, 1911 (or under the Designs Act, 2000). In these circumstances, the defendants' objection that copyright cannot be claimed, is prima facie merited. For this reason too, it is held that the plaintiffs' copyright claims cannot be granted, at this stage.”*



# *Microfibres Inc. v Girdhar And Co.*

[2006 (32) PTC 157 (Del), decided on 13th January 2006]

- The Plaintiff, a US company, filed a suit against an Indian trader for infringing its copyright in various patterns on upholstery fabric, which, as the Plaintiff claimed, were artistic works.
- The plaintiff claimed exclusive rights in respect of the “work” in view of provisions of Section 14(c) of the Copyright Act and, copyright infringement by the Defendants. The Defendants on the other hand claimed that the subject matter sought to be protected was a “Design” and therefore could not be protected under Copyright law, and the Plaintiff had not registered their designs and so was aiming to protect it using the instrument of Copyrights
- The Delhi HC held that works created for the purpose of industrial application and replication would not qualify as ‘artistic’ works and would, therefore, be eligible for design protection.

*“62. In order for the work of the plaintiff to qualify as an 'artistic work', it must fall within the definition of Sub-section (c) of Section 2 of the Copyright Act. A reading of the said provision would show that attempt of the plaintiff can only be to bring it within the concept of 'painting'. The comparison with the painting of M.F. Hussain would be otiose as the work in question, in the present case, is not a piece of art by itself in the form of a painting. There is no doubt that labour has been put and there is some innovativeness applied to put a particular configuration in place. Such configuration is of the motifs and designs which by themselves would not be original. The originality is being claimed on the basis of the arrangement made. What cannot be lost sight of is the very object with which such arrangements or works had been made. The object is to put them to industrial use. An industrial process has to be done to apply the work or configuration to the textile. It is not something which has to be framed and put on the wall or would have any utility by itself. The two important aspects are the object with which it is made (which is industrial) and its inability to stand by itself as a piece of art. In fact, it has no independent existence of itself.”*

*“64..... The legislative intent is also to be kept in mind which is to provide protection for a certain period of time for commercial exploitation. Thus, nature of protection is quite different for an artistic work under the Copyright Act which is for the lifetime of the author / creator + 60 years. This is not so in the case of commercial exploitation as under the Designs Act and the Patent Act the period is much lesser. In the present case, the configuration was made only with the object of putting it to industrial / commercial use.”*

*.....*

*“A perusal of the Statement of Objects and Reasons for introduction of the new Act, the handouts issued by the Design Office and the registrations made of textile fabrics both under the old Act and the new Act leave little manner of doubt that the protection for such configurations, designs or works (by whichever name it may be called) is provided under the Designs Act. It is, thus, apparently clear that in the context of the Indian Law, it is the Design Act of 1911 or 2000, which would give protection to the plaintiff and not the Copyright Act. The application of mind and skill is not being denied nor the fact that the defendants have copied the same, but that would still not amount to the works in question being labelled as 'artistic work' within the definition of Section 2(c) of the Copyright Act and, thus, the protection is not available under the Copyright Act.”*

# *Microfibres Inc. v Girdhar And Co. (DB)*

[(2009 (40) PTC 519 (Del.) (DB), decided on 21<sup>st</sup> January 2009]

➤ The decisions of the Single Judges in *Mattel* and *Microfibres* were taken up together on the question of law of the interplay between Section 2(c) and (d) of the Designs Act, 2000 and section 15 of the Copyright Act.

➤ The Court summarised the position on the overlap between copyrights and designs under the Act, holding as follows:

*“a. The definition of ‘artistic work’ has a very wide connotation as it is not circumscribed by any limitation of the work possessing any artistic quality. Even an abstract work, such as a few lines or curves arbitrarily drawn would qualify as an artistic work. It may be two dimensional or three dimensional. The artistic work may or may not have visual appeal.”*

*“b. The rights to which a holder of an original artistic work is entitled are enumerated in Section 14(c) of the Copyright act.*

*c. It is the exclusive right of the holder of a Copyright in an original artistic work to reproduce the work in any material form. For example, a drawing of an imaginary futuristic automobile, which is an original artistic work, may be reproduced in the three-dimensional material form using an element, such as a metal sheet.*

*d. The design protection in case of registered works under the Designs Act cannot be extended to include the copyright protection to the works which were industrially produced.”*

*“e. A perusal of the Copyright Act and the Designs Act and indeed the Preamble and the Statement of Objects and Reasons of the Designs Act makes it clear that the legislative intent was to grant a higher protection to pure original artistic works such as paintings, sculptures etc and lesser protection to design activity which is commercial in nature. The legislative intent is, thus, clear that the protection accorded to a work which is commercial in nature is lesser than and not to be equated with the protection granted to a work of pure art.*

*f. The original paintings/artistic works which may be used to industrially produce the designed article would continue to fall within the meaning of the artistic work defined under Section 2(c) of the Copyright Act, 1957 and would be entitled to the full period of copyright protection as evident from the definition of the design under Section 2(d) of the Designs Act. However, the intention of producing the artistic work is not relevant.”*

*“g. This is precisely why the legislature not only limited the protection by mandating that the copyright shall cease under the Copyright Act in a registered design but in addition, also deprived copyright protection to designs capable of being registered under the Designs Act, but not so registered, as soon as the concerned design had been applied more than 50 times by industrial process by the owner of the copyright or his licensee.*

*h. In the original work of art, copyright would exist and the author/holder would continue enjoying the longer protection granted under the Copyright Act in respect of the original artistic work per se.*

*i. If the design is registered under the Designs Act, the Design would lose its copyright protection under the Copyright Act. If it is a design registrable under the Designs Act but has not so been registered, the Design would continue to enjoy copyright protection under the Act so long as the threshold limit of its application on an article by an industrial process for more than 50 times is reached. But once that limit is crossed, it would lose its copyright protection under the Copyright Act. This interpretation would harmonize the Copyright and the Designs Act in accordance with the legislative intent.*”

# *Ritika Private Ltd. v. Biba Apparel Pvt. Ltd.*

[CS(OS) No. 182/2011(Del.) decided on 23<sup>rd</sup> March 2016]

➤ Plaintiff filed this suit claiming copyright in various drawings and sketches which are created by the plaintiff for dresses being sold under the trade name/brand RITU KUMAR. It is pleaded that there is originality in the garment prints and sketches created by the plaintiff for the dresses/garments. It is pleaded that ensembles of the plaintiff are so designed that each component, such as sleeves, front and back panels etc are delineated and are coordinated with unique features.

➤ The suit was filed by the Plaintiff claiming injunction and restraint against the Defendant from reproducing, printing, publishing, distributing, selling, offering etc. of prints or garments which are colourable imitation or substantial reproduction of the Plaintiff's prints and garments.





*“Since a drawing, a sketch or a design is used for creation of dresses, then, once the dresses cross 50 numbers, no copyright can subsist in the drawing and sketch under the Indian Copyright Act because of the language of Section 15(2) of the Indian Copyright Act. The Hon'ble Division Bench of this Court in **Microfibre's case (supra)** has noted that the legislature intended to give lesser period of protection to a copyright when from the copyright a design is created which is applied for commercial purposes.*

.....

*“Section 15(2) of the Indian Copyright Act uses the expression "capable of being registered" i.e. it is capable though not actually so registrable as a design because of the definition of design under the Designs Act excluding copyrighted artistic work. Legislature has consciously used the words "capable of being registered" meaning thereby the possibility of a copyrighted sketch or drawing or artistic work being also capable of being registered as a design though excluded from the definition of design. The legislature deliberately used the word capable in Section 15(2) of the Indian Copyright Act. Therefore, it is not necessary that a drawing or a sketch or a design must fall within the definition of design under the Designs Act and only then can it be said that it will fall under Section 15(2) of the Indian Copyright Act, inasmuch as, such an argument overlooks the expression "capable of being registered" deliberately so used under Section 15(2) of the Indian Copyright Act.”*

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# Overlap Between Trademark and Unfair Competition

# Comparative Advertisements - Just to Start Things Off!

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# Statutory Framework – Constitutional Treatment

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- **Article 19(1)(a)** of the Constitution of India reads as : *Protection of certain rights regarding freedom of speech, etc.—(1) All citizens shall have the right— (a) to freedom of speech and expression ’*
- In *Hamdard Dawakhana v. UoI, [1960 SCR (2) 671]*, the Supreme Court held Advertisements to be a form of speech, but its true character is reflected by the object which it serves. It is only when an advertisement is concerned with the expression or propagation of ideas, that it can be said to relate to freedom of speech.
- In *Tata Press v. Mahanagar Telephone Nigam Ltd, [1995 SCC (5) 139]*, the Supreme Court held that Advertising is beneficial to consumers, leading to greater public awareness in a free market economy. An advertisement giving information regarding a life saving drug could be of general importance to the public. As such, ‘commercial speech’ was held to be a part of freedom of speech and expression.

# Statutory Framework - Role of the Trademarks Act, 1999

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- Section 29(8) of the TM Act, 1999 states ‘*A registered trademark is infringed by any advertising of that trademark if such advertising- takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or is detrimental to its distinctive character; or is against the reputation of the trademark.’*
- Section 30(1) of the TM Act, 1999 states ‘*Nothing in section 29 shall be construed as preventing the use of a registered trademark by any person for the purposes of identifying goods or services as those of the proprietor provided the use-is in accordance with honest practices in industrial or commercial matters, and is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trademark.’*

*Reckitt & Colman India Ltd. v. M.P. Ramchandram & Anr.*, [C.S. No.31 of 1996), Calcutta High Court, 22nd June, 2010]

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- A producer can declare his goods to be the best, or even better than his competitors even if the statement is untrue. But, while making such comparison he cannot state that his competitor's goods are bad, even if that is true. He cannot make any statement which might lead to disparagement of his competitor's goods.



# *Pepsi Co. v. Hindustan Coca Cola Ltd.*

[2003 (27) PTC 305 Del, High Court of Delhi, 1st September 2003]

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- “*Bacchon Wala Drink*”
- An advertisement is considered to be defaming if it is undervaluing, bringing discredit or dishonor upon the competitor’s product.



# *Havells v. Amritanshu,*

[CS(OS) 107/2015, High Court of Delhi, 15th March 2015]

- The test of honest use is an objective test which depends on whether the use is considered honest by members of a reasonable audience.
- Failure to point out a competitor's advantages is not necessarily dishonest
- In comparative advertising, a certain amount of disparagement is implicit
- Competitors can certainly compare but cannot mislead. For any advertisement to be considered misleading, two essential elements must be satisfied. First, misleading advertising must deceive the persons to whom it is addressed or at least, must have the potential to deceive them. Secondly, as a consequence of its deceptive nature, misleading advertising must be likely to affect the economic behavior of the public to whom it is addressed, or harm a competitor of the advertiser.





# *Hindustan Unilever Limited (“HUL”) v. Emami Limited,*

[2020 SCC OnLine Bom 764], High Court of Bombay, 6th July 2020]

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- Generic disparagement is done without direct reference to the product of the plaintiff and only a reference to the entire class of products in its generic sense (in which plaintiff’s product lies).
- Nobody could disparage a class or genre of a product within which a complaining plaintiff falls and raise a defense that the plaintiff has not been specifically identified.



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# Overlap Between Domain Names and Trademarks

# Relation Between Domain Name And Trademark

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- Domain name serves as an online trademark, indicating quality and acting as a repository of the goodwill of an organisation.
- A domain name serves the same purpose online, which a trademark serves in the offline business transactions. It helps the customers identify the source of goods/services provided by the owner of such goods and services.
- Importance of domain names:
  - Promotion of business and building up of customer base online and offline by way of advertising on the web.
  - Establishment of the credibility of the website and the business on the internet.
  - Easy access to customers and prospective customers.

# Domain Name v. Trademarks

- Domain name holds importance as there can be only one user of a domain name unlike the trademark law where there can be two or more users of a same or similar trademark for various classes of goods and services under the honest concurrent use if such use does not amount to infringement or causing confusion or dilution.
- But this kind of provision is not applicable in the case of domain names since the domain registration system follows the "first come, first served" policy. So, once a person registers a domain name similar to a trademark, any other person using a similar mark is denied registration of another domain name similar to that trademark.



# .IN Domain Dispute Resolution Policy

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- INDRP, an Indian variant of ICANN's Uniform Domain Name Dispute Resolution Policy (UDRP), is one of the most popular choices for resolving .IN domain name disputes. More than 800 cases have been resolved since it came about, providing for effective and speedy dispute resolution mechanism.
- As per the terms of the .IN Registry, a domain name registrant is required to submit to mandatory arbitration proceedings in relation to complaints received by the registry for abusive registration.
- The grounds to be proven by the Complainant under the INDRP are:
  - (i) the Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
  - (ii) the Registrant has no rights or legitimate interests in respect of the domain name; and
  - (iii) the Registrant's domain name has been registered or is being used in bad faith.

# Domain Name Protection

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- The domain names as trademarks or service marks are registered and protected at the entire global level supremely by only one organization which is ICANN [Internet Corporation for Assigned Names and Numbers] along with the national and international protection under the directly concerned national Trademark Law and diverse International Trademark Treaties of the world.
- To meet this vital objective, the ICANN with support of the WIPO (World Intellectual Property Organization) prescribed the following two strong and strict measures --- a rigorous and censorious system of registration of domain names with accredited registrars [by ICANN] and an efficient and efficacious dispute resolution policy, named as the Uniform Domain Name Disputes Resolution Policy (UDNDR Policy).
- In India, a proactive approach has been taken towards managing .IN domain name disputes, introducing the .IN Domain Name Dispute Resolution Policy (INDRP) in 2005, which has proved helpful in quickly resolving domain name disputes concerning .IN Country Code Top Level Domains (ccTLDs).
- The Indian Trademarks Registry is open to grant registration to generic domain names as trade marks. However, the enforceability of these registrations is another story altogether.

# *Bigtree Entertainment Pvt. Ltd vs. Brain Seed Sportainment*, [CS(COMM) 327/2016, High Court of Delhi, 13th December 2017]

- First, the Court held that the existence of domain names using the prefix ‘BOOKMY’, both prior and subsequent to the Plaintiff’s mark, ‘BOOKMYshow’ indicated that the prefix was descriptive.
- Second, the Court held that the words ‘BOOKMY’ was not an arbitrary coupling of words, but rather a phrase describing the particular activity that the Plaintiff and others were engaged in.
- Third, the Court held that, because the Defendant had led evidence suggesting that the prefix ‘BOOKMY’ was in use by other companies, and the Plaintiffs had not led evidence to show that ‘BOOKMY’ is only associated to the Plaintiff’s trademark, the Plaintiff was unable to prove that the prefix had obtained distinctiveness or a secondary meaning, in order to accord it protection.
- Accordingly, the Court dismissed the application for injunction against usage of ‘BOOKMYsport’ and ‘BOOKMYevent’.



# *People Interactive (I) Pvt. Ltd. vs. Vivek Pahwa & Ors.*

[Suit No. 846 OF 2015, High Court of Bombay, 14th September, 2016]

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- *The Court observed that even if people associate “shaadi.com” with the plaintiff, the same is not true for the word “shaadi”.*
- *The defendant’s arguments under Sections 30(2) and 35 of the Trademarks Act, 1999 were also accepted by the court. Both “shaadi.com” and “secondshaadi.com” were held to be descriptive marks, which commonly describe the nature of their services.*
- *This case runs contrary to the Delhi High Court judgment of Yahoo Inc. v. Akash Arora & Anr., [(1999) DLT 285, 19<sup>th</sup> February, 1999], which held that a domain name is never merely an address and is entitled to equal protection as trademark. This case stated that the domain name is primarily an address, which may, in addition enjoy protection as a mark.*





# *Citi Corp v. Todi Investors*

[CS(OS) No. 462/2005, High Court of Delhi, 12th October 2006]

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- The Court observed that there is no explicit ouster of the jurisdiction of the civil court and the case is pleaded on an implied bar. The court stated that *'the INDRP is neither a statute nor an act, and an arbitrator's status under the INDRP is that of neither a judge nor a judicial officer; he or she has only a limited mandate to adjudicate on the three questions referred to in the policy and it cannot adjudicate the validity of trademarks.'*
- Therefore, in the light of Section 134 of the Trademarks Act, 1999 which mandates that only a District Court/District Judge is empowered to adjudicate suit for infringement of a trademark or of passing off and also that the relief claimed by CITI Corp can only be adjudicated in a suit rather than the INDR Tribunal can adjudicate upon due to its greater scope in comparison to insufficient machinery of the INDR Policy.
- The Tribunal was held to be not a forum which can provide adequate and effective machinery for the redress of the substantive relief claimed for "infringement of trademark" and "passing off" which includes infringing the use of CITI in any manner or form either as a domain name or as a trademark or trade name or on the website as well as the rendition of accounts.



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# Overlap Between Designs and Trade dress/ Passing Off

# *Mohan Lal v. Sona Paint and Hardwares*

[CS(OS) No. 384/2008, High Court of Delhi, 15th May 2013 – 3 judge bench]

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- The Plaintiffs in the case were registered owners of designs (mirror frames) and claimed that the Defendants infringed upon their registered designs. The Plaintiffs sued for infringement as also passing off. One of the issues in the case was whether a composite suit with both these remedies was maintainable?

- Findings:

- 1) *“Having regard to the definition of a design under Section 2(d) of the Designs Act, it may not be possible to register simultaneously the same matter as a design and a trademark. However, post registration under Section 11 of the Designs Act, there can be no limitation on its use as a trademark by the registrant of the design. The reason being: the use of a registered design as a trademark, is not provided as a ground for its cancellation under Section 19 of the Designs Act”*



# *Mohan Lal v. Sona Paint and Hardwares*

[CS(OS) No. 384/2008, High Court of Delhi, 15th May 2013 – 3 judge bench]

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- 2) *“The cause of action in the infringement suit under the Designs Act could be different from that which obtained in a passing off action. The fundamental edifice of a suit for infringement under the Designs Act would be the claim of monopoly based on its registration, which is premised on uniqueness, newness and originality of the design. Whereas, the action for passing off is founded on the use of the mark in the trade for sale of goods and/or for offering service; the generation of reputation and goodwill as a consequences of the same; the association of the mark to the goods sold or services offered by the plaintiff and the misrepresentation sought to be created by the defendant by use of the plaintiff's mark or a mark which is deceptively similar, so as to portray that the goods sold or the services offered by him originate or have their source in the plaintiff. It is trite to say that different causes of action cannot be combined in one suit”*
- 3) *“Having regard to the nature of the two actions, in our opinion, the two actions cannot be combined. Though as indicated, at the beginning of discussion of this issue if the two actions are instituted in close proximity of each other the court could for the sake of convenience try them together, though as separate causes, provided it has jurisdiction in the matter.”*
- 4) *“A plaintiff could institute a suit for infringement of a design against a defendant, who was also a holder of a registered design. The expression "any person" found in Section 22 of the Designs Act would not exclude a subsequent registrant as, according to us, no such words of limitation are found in said Section.” The plaintiff would be entitled to institute an action of passing off in respect of a design used by him as a trade mark provided the action contains the necessary ingredients to maintain such a proceeding.*

# *Carlsberg Breweries v. Som Distilleries and Breweries*

[CS(Comm) No. 690/2018, High Court of Delhi, 14th December 2018 – 5 judge bench]

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- This case involved a reference to the larger bench, upon the issue of whether composite suits in cases of passing off and design infringement could be entertained by the Court

- Holding:

- *“On account of existence of common questions of law and fact between the two causes of action of infringement of a registered design and passing off, therefore to a considerable extent, the evidence of the two causes of action will be common. In such a situation to avoid multiplicity of proceedings there should take place joinder of the two causes of action of infringement of a registered design and passing off against the same defendant in one suit, otherwise multiplicity of proceedings will result in waste of time, money and energy of the parties and also of the courts.”*





## *Monsanto Technology LLC & Ors. v. Nuziveedu Seeds Ltd. & Ors.*

Bt cotton technology;

Defendant was a licensee and contracts were terminated;

Single Judge has decided that Plant Varieties Act and Patents Act do not conflict;

Single Judge, remanding the issue of validity of patent to trial, however permitted the farmers to license the cotton from Monsanto

Single Judge passed *ad-interim* injunctions in this respect



## *Monsanto Technology LLC & Ors. v. Nuziveedu Seeds Ltd. & Ors.*

Order of the Single Judge was appealed against by both parties:

- Monsanto challenged reinstatement of license and
- Nuziveedu challenged rejection of their arguments on the question of validity

Division Bench, vide judgment dated 11<sup>th</sup> April, 2018 ruled in favour of Nuziveedu Seeds

The Court declared the patent of Monsanto invalid as Section 3(j) of the Patents Act prohibited grant of patents for plants, plant varieties or seeds.

The Court, however did give Monsanto 3 months to seek protection of its invention under the Plant Varieties Act



## *Monsanto Technology LLC & Ors. v. Nuziveedu Seeds Ltd. & Ors.*

This judgment went up in appeal to the Supreme Court where the following order was passed:

- There was no reason to pass a summary judgment on the validity of the patent at the interim stage;
- The validity of the patent is something which is subject matter of trial and must be proved in accordance with law;

The Bench restored the injunction passed by the Ld. Single Judge in favour of Monsanto, and remanded the matter for trial.



## *Shogun Organics Ltd. vs. Gaur Hari Guchhait and Ors.* (DHC - 2019): Overlap between Patents and Insecticides Act

- Plaintiff filed suit for permanent injunction for infringement of Patent IN-236630 (IN '630) relating to a "*Process for manufacturing d-trans Allethrin*" used as an active ingredient in mosquito repellents and other mosquito control products.
- Defendants selling d-trans Allethrin in India themselves and through various distributors, retailers, etc.
- Plaintiff suspected process of the Defendants identical to that of the Plaintiff-Plaintiff conducted tests found there were various marker compounds & specific impurities unique to the Plaintiff's process, isomer content also similar to that of the Plaintiff's product.

- Defendant argued that process of Plaintiff is disclosed to Insecticide authority

**Held:** Plaintiff's patent is not pre-published/lacking novelty in view of the registration no. granted to the Plaintiff as Defendants did not lead any evidence to establish prior publication or lack of novelty and the Plaintiff having led evidence of its witness and due to the orders passed in the pre-grant opposition and the IPAB.

*“The Plaintiff obtained its registration for D-trans Allethrin under Section 9(3) of the Insecticides Act in 1997, and the Defendant obtained its registration under Section 9(4) in 2007. The application by the Defendant was made in 2006. There is no doubt that the Defendants’ approval is subsequent to that of the Plaintiff and is under Section 9(4) What is however, not established on record is as to which was the process that was being followed by the Plaintiff and the Defendants, which was disclosed to the authorities under the Insecticides Act. In the absence of any details as to the process which was disclosed by both parties to the Insecticides Authority, it cannot be held that the mere fact that the Defendants’ registration is a follow-on registration under Section 9(4) would lead to the inference that there is an infringement of patent.”*

The Division Bench upheld the judgment of the Single Judge:

*“...there is no substance in the contention of the original defendants that the process for manufacturing d-trans Allethrin was known to the public at large because of its registration under Sections 9(3) and/or 9(4) of 1968, Act. In fact, there is nothing under the 1968 Act which requires the applicant to disclose the manufacturing process in detail, like the requirement under the 1970, Act. We have perused Form-1 under the First Schedule of the Insecticides Rules, 1971 enacted under the 1968, Act which does not require the disclosure of the process of manufacturing of the product. Nonetheless, even if the original defendants had disclosed the manufacturing process, it does not tantamount to the manufacturing process being disclosed to the whole world. In the light of Section 30 of the Patents Act, as also Section 26 of Patents and Designs Act, 1911, neither the original plaintiff nor the original defendants were required to disclose the method of manufacturing for the registration of their product under the 1968, Act.”*

# Bayer Vs. UOI – Patent Linkage

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Bayer had a granted patent for a pharmaceutical product

Defendant applied for approval to the Drug Controller. Form 44 of the Drugs & Cosmetics Act, relied upon –Patent status of the Drug.

Injunction sought in writ jurisdiction.

SJ held India doesn't recognise Patent Linkage.

DB upheld.