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An e-newsletter from
Lakshmikumaran & Sridharan, India

November 2021 / Issue-122

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November
2021



Article

What's in domain?

By Pulkit Doger

Technological globalization, on account of its international, economical, and accessible character, has forced businesses to shift their business models from physical markets to electronic commerce (e-commerce) portals. In such a scenario, domain names, i.e., the user-friendly form of websites' IP addresses, form an integral part of businesses as their identifiers in the realm of e-commerce. In other words, a domain name can be used to uniquely identify an entity and can function as a source identifier on the world wide web.

Anatomy of a domain name

A domain name consists of two parts, the first part is the unique name adopted by an entity known as the Second-Level Name and the second part which comes after said unique name is called Top-Level Domain. For example, in 'google.com', 'google' is the Second-Level Name and '.com' is the Top-Level Domain.

Registration of domain names

The .IN Registry, that has been created by the National Internet Exchange of India ('NIXI') accredits registrars that register domain names. The registrars are accredited through an open process of selection on the basis of a transparent eligibility criteria.¹ Additionally, a domain name can also be registered with registrars accredited by the Internet Corporation for Assigned Names and Numbers (ICANN), a community-driven non-profit organization that promotes the concept of 'One World, One Internet' that is dedicated towards coordinating domain names and keeping

the internet secure, stable, and interoperable.² These authorities issue or register domain names on a 'first come first serve' basis, sans a thorough conflict check.

It is also of note that the definition of 'mark' under Section 2(1)(m) of the Trade Marks Act, 1999 includes the term 'name' and, therefore, Second-Level 'Names' of the domain names are registerable under the Trade Marks Act, 1999, given that the purpose of a trademark and a domain name are also similar in nature, i.e. source identification.

Dispute resolution in India

As far as India is concerned, there is no specific legislation which explicitly deals with dispute resolution of domain names.³ However, given the overlap with trademarks, said disputes are majorly covered by the Trade Marks Act, 1999 under the laws relating to passing off and infringement. Additionally, complaints can also be filed under the .IN Domain Name Dispute Resolution Policy (INDRP).

A. .IN Domain Name Dispute Resolution Policy

The .IN Domain Name Dispute Resolution Policy (the 'INDRP') sets out the regulatory framework for resolution of dispute(s) between a domain name Registrant and the Complainant, arising out of the registration and use of an .IN domain name. Any person who considers

¹ <https://www.registry.in/about/in-registry>

² <https://www.icann.org/resources/pages/welcome-2012-02-25-en>

³ Satyam Infoway Ltd vs Sifynet Solutions Pvt Ltd, AIR 2004 SC 3540



that a registered domain name conflicts with his/her legitimate rights or interests may file a complaint with the .IN Registry for one or more of the following reasons:

- (a) the Registrant's domain name is identical and/or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and
- (b) the Registrant has no rights or legitimate interests in respect of the domain name; and
- (c) the Registrant's domain name has been registered or is being used in bad faith.

Upon filing of the complaint, an Arbitrator is appointed from the list of empanelled arbitrators maintained by the Registry. The Arbitration Proceedings are conducted in accordance with the Arbitration & Conciliation Act, 1996 and relevant laws thereunder along with the INDRP Policy and Rules. The remedies available to a complainant pursuant to any proceeding before an Arbitrator are limited to praying for the cancellation of the registrant's domain name or the transfer of the registrant's domain name registration to the complainant. Costs as may be deemed fit may also be awarded by the Arbitrator. However, the implementation of such award of cost is not supervised or controlled by .IN Registry.⁴ It is also pertinent to mention here that said arbitration proceedings are required to be completed within a time frame of 60 days from the commencement of said proceedings. However, an extension of 30 days may be granted where reasonable cause exists.

B. Trade Marks Act, 1999

As stated herein above, domain names are covered under the definition of a mark as provided under the Trade Marks Act, 1999. If a domain name is registered as a trademark under the Act, then the aggrieved party may institute an action under Section 29 of the Trade Marks Act, 1999 which deals with infringement of registered trademarks. However, in the event a domain name is not registered under the Trade Marks Act, 1999, the aggrieved party can still institute an action for passing off which is a common law remedy.

Here it would not be out of context to divulge into the judicial point of view with respect to domain names. It is a settled principle of law that disputes pertaining to domain names can be tried under the Trade Marks Act, 1999. The judicial system of our country has time and again relied on the principles of Trade Marks Law, such as the use of the mark, the goodwill and reputation accrued by the mark, the mal-intent involved, and the loss incurred, to adjudicate the disputes related to domain names.

Recently, a suit⁵ was instituted by Living Media India Limited before the High Court of Delhi wherein it was claimed by the plaintiffs that they are aggrieved as the defendants are using their trademark 'AAJ TAK' as a part of their domain name. Accordingly, as per the interim injunction orders dated 24 September 2020 and 6 September 2021, the Court has held that the balance of convenience appears to be in favor of the plaintiffs and the defendants

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<https://www.registry.in/IN%20Domain%20Name%20Dispute%20Resolution%20Policy%20%28INDRP%29>

5 Living Media India Limited & Anr vs. www.news-aajtak.co.in & Ors.

were directed to block/suspend the websites/domain names and also take down any infringing material and/or trademarks/trade devices deceptively similar to the plaintiffs' trademarks from various social media platforms administered by them including Facebook, Twitter, Instagram, LinkedIn and YouTube.

Given the above, it can be safely said that the judiciary is dealing with domain name infringement cases under the purview of the Trade Marks Act, 1999 and, accordingly, reliefs are being granted to the parties in whose favour the balance of convenience lies. It is also noteworthy that the Judiciary has observed that the only distinction between domain names and trademarks is the scope of protection. While domain name registrations are applicable universally, trademark registration and protection are limited to the national jurisdiction of a country. However, it may be only a matter of time that this distinction slowly withers away with the emergence of the principle of cross-border reputation in the current digital age.

Conclusion

Domain names can act as source identifiers and should be meted out a similar treatment as that meted out to trademarks. However, currently, domain names are allotted on a 'first come, first serve' basis without a thorough check, which may lead to conflicting or deceptively similar domain names being registered. While even the registration under the Copyright Act, 1957, for works that can be applied to goods and services, is subject to a Search Certificate being obtained from the Trade Marks Registry, no such mechanism exists for domain names. In other words, for copyright on a work that can also be used for goods and services (as trademarks), a clearance must be obtained from the Trade Mark Registry to ensure that the work does not conflict with existing trademarks. However, domain names are exempt of any such requirement. Disputes regarding domain names are only going to multiply in the coming years and there is the need for a mechanism for assessing domain names being registered to prevent duplicity of domain names and minimize confusion and deception amongst the relevant consumers. **[The author is a Joint Partner in IPR Team at Lakshmikumaran & Sridharan Attorneys, New Delhi]**



Ratio decidendi

Copyrights – Commonality of arrangement of known elements must be demonstrated for infringement

The Bombay High Court has reiterated that if a copyright is claimed in the arrangement or

assembly, it must be shown that that the arrangement has been substantially copied. According to the Court, it will not be helpful to say that known elements have been put together in some form, and that those elements also feature in the other work. The High Court was of the view

that it is not the commonality of known elements in an idea/expression contest that is determinative but, commonality of the arrangement of known elements must be demonstrated.

In a dispute involving alleged infringement of rights of plaintiff (writer) in a movie made by the defendants, the Court observed that a Mumbai chawl, a hospital, a research centre, polluted or poisoned water, villains who seek power, land and control, and zombies - in themselves do not lend themselves to any form of monopolization. Plaintiff's argument that the 'overall impression and especially the visual impression' in the defendant's film is so close to plaintiff's conceptualization that an injunction must necessarily follow, was thus rejected. Petitioner's claim that milieu of the two works — chawls and towers, were similar, was rejected by the Court observing that these were tropes. The Court observed that if a film is set in or anywhere around Mumbai, chawls, towers and slums are inescapable. It was of the view that similarly, the existence of a research or medical institute and, toxicity and water poisoning was not the kind of thing that could sustain a claim of originality.

The High Court in this regard also held that incidental co-incidences are not copyright infringements which are established only by clear and cogent evidence. It also observed that mere similarity does not always imply copying or infringement.

Dismissing the Interlocutory Application for interim relief, the Court also rejected the Plaintiff's arguments of breach of confidence (as the idea about the film was communicated in circumstances of confidence to the defendant). It observed that for a cause of action in breach of confidence to succeed there must be precision, originality and completeness, all of them together. Drawing distinction between copyright and confidence, the Court also observed that the

plaintiff failed the *prima facie* test by failing to present a clear and unambiguous identification of the proprietary, original material other than that which was copyright protected and said to be confidential. It observed that the statement that defendant's film utilized plaintiff's materials and elements contained therein without the latter's permission, was too generalized and ambiguous to support a grant of an injunction in equity. [*Tarun Wadhwa v. Saregama India Ltd.* – Judgement dated 20 October 2021 in Commercial IP Suit (L) No. 4366 of 2021, Bombay High Court]

Patent in pharmaceutical composition – 'Comprising', an open-ended term – Subsequent steps cannot affect earlier patent

The Delhi High Court has granted interim relief in a case where the plaintiff had plead that all combinations comprising of Valsartan and Sacubitril were within the scope of the suit patent. Defendant's plea that the suit patent covered only physical/heterogeneous mixture of the two components and not a single molecule by way of a supra-molecular complex, was thus rejected. The Claim I of suit patent IN 229051 was a pharmaceutical composition comprising of (i) Valsartan or a pharmaceutically acceptable salt; (ii) Sacubitril or a pharmaceutically acceptable salt; and a composition of pharmaceutically acceptable carrier.

Noting that the inventive concept of the suit patent was a pharmaceutical composition that 'comprised' of combination of Valsartan and Sacubitril, the Court also noted that as per the defendant, their product was a mixture of Valsartan and Sacubitril, though was a supra molecular complex made with Valsartan and Sacubitril anions with sodium ions and water molecules. Court's earlier decision in the case of *F. Hoffmann-La Roche Ltd. v. Cipla Ltd.*, which

noted that the term 'comprising' is open ended, was relied upon.

Defence, that the plaintiff themselves in a subsequent patent application (IN 4412) had pleaded that the present suit patent does not cover a supra molecule containing Valsartan and Sacubitril, was also rejected by the High Court. It observed that merely because the plaintiff has filed an application for registration of a supra molecular complex of the two components, it does not modify or change the position *vis-a-vis* interpretation of Claim I of the suit patent. The Court was of the view that subsequent steps by plaintiff cannot remove what is patented earlier nor can it include something that was excluded earlier.

Reliance by the defendant on the opinion of the Expert Scientific Adviser that the defendant's product described as a complex was not encompassed or subsumed by Claim 1 of the suit patent, was also rejected by the Court. It observed that view of the Scientific Adviser is not binding on the Court. [*Novartis AG v. Natco Pharma Limited* – Judgement dated 28 October 2021 in CS(COMM) 62/2019 and Ors., Delhi High Court]

Statutory licensing – Broadcaster to comply with terms and conditions of Section 31D read with Rule 29(4)

In a case involving statutory licence under Section 31D of the Copyright Act, 1957 read with Rule 29 of the Copyright Rules, 2013, the Delhi High Court has held that *prima facie*, the broadcaster-defendant must comply with the terms and conditions of the statute. Restraining the defendant from broadcasting/communicating to the public and/or otherwise exploiting the plaintiff's copyright works through its FM Radio, the Court rejected the plea that literal compliance of Rule 29(4) is neither feasible nor required. Relying upon Supreme Court decision in the case of *Saregama India Ltd. v. Next Radio Limited*, it

held that at interlocutory stage it cannot rewrite the provisions of Rule 29(4). It observed that once the defendants shifted to the statutory license scheme (from the voluntary licence regime) for broadcasting, *prima facie*, they would have to comply with the terms and conditions of the statute.

The High Court in this regard noted that defendant had not complied with Rule 29(4)(i) and (j) of the Rules as they had not given the names of the programmes and their time slots, duration and period in which the works were to be included. Non-compliance of Rule 29(4)(k) was noted inasmuch as the defendant had paid an *ad-hoc* sum without giving the breakup. [*Super Cassettes Industries Pvt. Ltd. v. Music Broadcast Limited* – Decision dated 9 November 2021 in CS(COMM) 90/2021 and Ors., Delhi High Court]

Trademarks – No scope of confusion when trade channels catering to different consumers are different

The Delhi High Court has declined to grant injunction in favour of the plaintiff using the mark AMPM for designer clothes and jewellery, and against the defendant who were using the mark AMPM-Designs for the services of interior designing. The Court in this regard observed that there was no scope for confusion as the plaintiff and the defendant were in different trade channels, catering to consumers who have different expectations and demands. It also noted that the skills that one needs for designing clothes and/or accessories are not necessarily the same, like those required to design physical spaces.

The High Court also observed that there was lack of material on record, to even suggest that, there have been instances of initial interest confusion. The Court noted that plaintiff could not establish that it had the necessary goodwill/reputation in the services offered by the defendant and that

the use of the impugned mark for interior design and lighting solutions by the defendants has led to or is likely to result in damages on account of misrepresentation made by defendants, concerning the origin of services offered by them.

It also observed that merely because the plaintiff claimed to be the prior user of the trademark AMPM, it would not be enough, at the interim stage, to injunct the defendants from using the impugned mark.

Similarly, the Court also rejected the plaintiff's plea that the mark AMPM was a well known mark. It noted that there were no survey reports of relevant sections of public placed on record which would, at least, *prima facie* show that the plaintiff's mark had attained a status of well-known and/or reputed mark. Pointing out absence of various materials, the Court observed that a mark may have a reputation and maybe well known but it still falls short of a well-known mark. [*AMPM Fashions Pvt. Ltd. v. Akash Anil Mehta* – Judgement dated 9 November 2021 in CS(COMM)No.272/2020, Delhi High Court]

Territorial jurisdiction to injunct foreign company not present in India – Mere accessibility and interactivity of website are not sufficient

The Delhi High Court has held that it *prima facie* has no territorial jurisdiction to issue any injunctive direction to the defendants, who are located outside India with, admittedly, no physical Indian presence, or injunct the use, by them, of their 'Tata Coin/\$TATA' mark.

Relying upon a decision in the case of *India TV*, the Court observed that mere accessibility of the website of the overseas defendants, by persons located within the jurisdiction of the Court, is not sufficient to clothe the Court with jurisdiction to act against the defendants. According to the Court, interactivity of the website is, in such a case, essential and the extent to which the

website would be interactive is also relevant as mere interactivity would not suffice.

Observing that something more substantial, indicating purposefully directed activity, by the defendants to persons located within the territorial jurisdiction of the Court, is necessary, the High Court held that a conscious attempt or overt intent by the defendants to target the Indian market was absent in the present case. According to the Court, 'intent to target' is a mandatory governing consideration, the satisfaction of which is a *sine qua non* for the Court to exercise jurisdiction.

Considering the facts of the case, the Court noted that targeting of India as a customer base for crypto currency market was not indicated by the mere fact that the 'India Development and Relief Fund' was one of the charities which the defendants intended to contact, to aid relief groups and alleviate disaster impact. Similarly, it was held that posting of some queries on Twitter by persons in India, or the fact that defendant website had 50 visitors from India every day, cannot indicate any intent on the part of the defendants to target the Indian market. Further, the Court could not find any intent, covert or overt, to target customers in Delhi, from the various social media accounts of the defendants.

The High Court in this regard also rejected the 'effect' theory while it observed that mere fact that the defendants' crypto currency could be purchased by customers located in India and that, as a result, the plaintiff's brand value may be diluted, cannot, justify the Court interfering with the defendants' activities, or with its brand or mark. It stated that the very applicability of the 'effect' doctrine across sovereign boundaries may itself be a matter for debate. [*Tata Sons Private Limited v. Hakunamatata Tata Founders & Ors.* – Judgement dated 26 October 2021 in CS(COMM) 316/2021, Delhi High Court]



News Nuggets

Comparative advertisement when may amount to denigrating competitor's trademark

The Madras High Court has reiterated that any advertisement under the guise of free flow of commercial information if directly or indirectly is denigrative to the rival products then such advertisement is bound to be restricted. Relying upon the earlier decision of the Court in *Hindustan Unilever Limited v. Reckitt Benckiser (India) Limited*, which had laid down certain governing principles in this regard, the Court granted the interim injunction, directing the defendant to withdraw/stop forthwith from displaying the impugned advertisement through any mode.

The dispute involved alleged disparagement of the plaintiff's trademark 'NIMYLE' used for herbal floor cleaners by the defendant who was displaying a comparative advertisement, comparing the plaintiff's product with its chemical floor cleaner. The Court observed that the word 'herbal' was visibly shown to the viewers by the demonstrator (in the advertisement) and the voice over stated that the herbal product in the bottle (which was identical to the bottle of the applicant) will not kill 99.9% germs. The Court in *ITC Limited v. Reckitt Benckiser (India) Pvt. Ltd.* found the depiction and statements as disparaging in nature, thus denigrating the competitor's product. It also noted that prima facie the statement was without scientific support.

Royalties for broadcasting sound recordings and literary & musical works in sound recordings – Delhi High Court invites suggestions

The Delhi High Court has invited suggestions on the rate of royalties to be fixed/revised for the broadcast of 'sound recordings' and the underlying works viz. 'literary and musical works' in 'sound recordings' through FM radio. Suggestions are to be emailed to ipd-copyright@dhc.nic.in by any owner of copyright or any broadcasting organization or any radio broadcaster or any other interested person. The High Court's IP Division is required to fix/revise the royalties under Section 31D of the Copyright Act, 1957, read with Rule 31 of the Copyright Rules, 2013 upon an application in this regard filed by Indian Performing Rights Society Limited.

Trademark 'Doctor PAN' is not publici juris

In a dispute involving use of mark 'Doctor PAN' and 'Doctor PAN-D' by the defendants allegedly infringing the 'PAN Family of Marks' adopted and used by the plaintiff since 2000, the Delhi High Court has restrained the defendants from using the marks. Relying on its earlier decision in the case of *Himalayan Drug Company v. SBL Ltd.*, the High Court rejected the Defendant's plea that the mark 'Doctor PAN' was '*publici juris*'. Noticing that the plaintiff was using the PAN set of marks since the year 2000, the Court observed that the defendants who had started manufacturing the impugned product would have to show that

the word 'PAN' was generic and unprotectable in law. The Court in *Alkem Laboratories Ltd. v. Dr. Reddys Laboratories Ltd.* [Order dated 12 October 2021] also noted that the defendants themselves had applied for registration of the impugned mark and hence *prima facie* cannot claim that the mark has become *publici juris*.

Use of even earlier mark of another party when fatal

The Delhi High Court has held that the defendant cannot contend that it can use a mark which is confusingly similar to the earlier mark of the plaintiff, with which the public continues to associate the plaintiff's product even after the plaintiff's mark has changed, or which would result in an association in the minds of the public between the product of the defendants and the plaintiff. The Court in *Bacardi and Company Limited v. Bahety Overseas Private Limited* [Judgement dated 12 November 2021] also noted that if the Defendant uses its mark in such a way as to lead the public to believe the existence of association between the Defendant's and Plaintiff's mark, the tort of infringement, *ipso facto* stands committed – confusion or no confusion. The marks 'BREEZER' of the plaintiff and defendant's mark 'FREEZ' were also held to be phonetically similar.

Territorial jurisdiction of Court – Offer of physical services in location

Distinguishing the Division Bench decision in the case of *Banyan Tree Holding (P) Ltd. v. A. Murali Krishna Reddy*, the Delhi High Court has *prima facie* rejected the contention of non-availability of territorial jurisdiction. It observed that as per the plaint and the defendant's website, the defendant was offering physical services of collection of samples in Delhi, which will then be flown over to the location of

the laboratory of the defendant. The Court noted that it was not an internet-based transaction that was being made and that the case did not involve any trap transactions. Observing that the services were being physically offered in Delhi, the High Court in *Dr Reddys Laboratories Limited v. Dr Reddy Pathlabs Private Limited* [Order dated 9 November 2021] was of the *prima facie* view that a part of cause of action as per the plaint had arisen within the territory of Delhi.

Mark BURJNOIDA can be used for ongoing project though injunction granted against use of BURJBANGALORE, BURJMUMBAI, BURJDELHI, etc.

The Delhi High Court has passed an injunction order restraining the defendants from in any manner using the trade mark BURJBANGALORE, BURJMUMBAI, BURJDELHI, BURJGURUGRAM and BURJGURGAON or any other similar trade mark till the pendency of the present suit. However, noting that the defendants claimed to have been around for the last 10 years as far as the mark BURJNOIDA is concerned, the Court passed no restrictions in using the mark BURJNOIDA for the residential project which is under construction.

The High Court in *Jumeirah Beach Resort LLC v. Designarch Consultants Pvt. Ltd.* [Order dated 9 November 2021] observed that the marks of the defendant *prima facie* appeared to be deceptively similar to the marks of the plaintiff 'BURJ AL ARAB', with the essential features of the trade mark of the plaintiff have *prima facie* been copied. Defendant's plea that the plaintiff cannot expropriate the word BURJ which is used in common language, was also rejected.

WTO set to extend moratorium on non-violation and situation complaints in IP

The WTO members have on 5 November 2021 agreed on a draft ministerial decision on so-called non-violation and situation complaints in the area of intellectual property (IP). The decision is expected to be adopted at the WTO's 12th Ministerial Conference (MC12) to be held in Geneva shortly. The TRIPS Council would be asked to continue its discussions on this issue and to make recommendations to the 13th WTO Ministerial Conference.

Non-violation and situation complaints refer to conditions when members should be able to bring WTO dispute complaints where they consider that another member's action, or a particular situation, has deprived them of an expected advantage under the TRIPS Agreement, even though no obligation under the Agreement has been violated. It may be

noted that as per WTO's website, members have historically differed on whether such non-violation cases are feasible in intellectual property.

Inventive step – Admissibility of post filing data – Question referred to EBA

The European Union's Board of Appeal has on 21 October 2021 referred to the Enlarged Board of Appeal, an interesting question concerning admissibility of post filing data for inventive step.

The Technical BoA (interlocutory decision T 116/18) refers whether, if for acknowledgement of inventive step the patent proprietor submits evidence to prove technical effect, but, this evidence is not made public before the filing date of the patent (post-published evidence), should the post-published evidence be disregarded on the ground that the proof of the effect rests exclusively on the post-published evidence?

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