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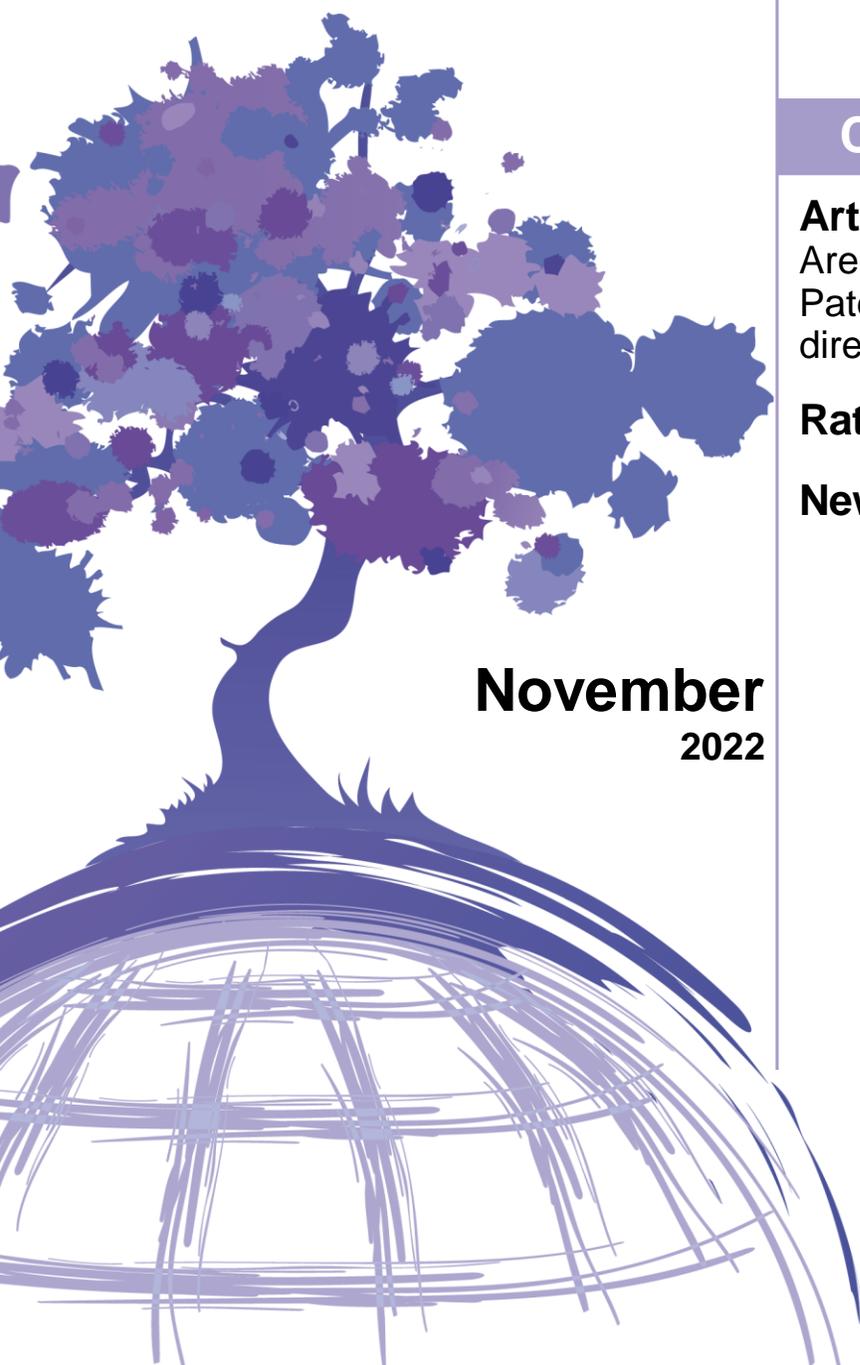
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**November**  
2022



## Article

### Are the time limits prescribed by the Patents Act, 1970, mandatory or directory?

By T. Srinivasan, P Mahalakshmi and Niharika Tiwari

#### Introduction

The issue in this article discusses on the prescribed timelines set under the Patents Act, 1970 ('Act') and the Patent Rules, 2003 ('Rules') and throws insights on the flexibility of timelines set forth under different orders. The Act and the Rules provides various time-limit at all stages of the Patent prosecution from the filing of the Patent Application till the completion of the tenure of the Patents such as filing the Application through National phase entry, submission of the various forms, working of patents and even under post-grant procedures. The prescribed time-limits should be followed strictly and any failure to meet the timelines would be pernicious to any person of interest.

However, when there is some difficulty to meet these statutory timelines, there are certain provisions under which these timelines could be extended. Such power to grant extensions is entrusted with the Controller of Patents. However, some prescribed timelines are non-extendable and the delays are not curable even by the Controller of Patents.

This article comprehends the scenarios where the extension of breached timelines has been allowed and also the cases wherein the flexibility of the timelines were found not to be permissible.

#### Perspective

Different High Courts have given different views on whether the prescribed time limits as

stated in the Act and the Rules can be extended or not.

In *Nippon Steel Corporation v. Union of India* [2011 SCC OnLine Del 669] decided on 8 February 2011, the Delhi High Court decided a writ petition concerning the interpretation of Section 11-B(1) & (4) of the Act and Rule 24(B) of the Rules. The Petitioner's PCT (Patent Cooperation Treaty) application claiming priority from 9 February 2006, entered national phase within the prescribed timeline as per the Rules. However, as per Rule 24-B of the Rules, a Request for Examination (RFE) has to be made within 48 months from the date of priority or the date of filing of the application whichever is earlier i.e., by Feb 9, 2010. Due to a docketing error at the Petitioner's attorney's office, the deadline for filing RFE in India was missed and to rectify this error, the Petitioner's agent filed an application under Section 57(5) of the Act seeking to amend the priority date, disregarding the Japanese priority date 9 February 2006, and to change it to the international filing date of the PCT application i.e., 9 February 2007. This amendment would have extended the deadline for filing the RFE by four years (48 months) i.e., till 9 February 2011. However, the Assistant Controller of Patents and Design ('CoP') declined the application stating that such a request is time barred as the said application is deemed to have been withdrawn under Section 11B(4) of the Act due to non-filing of RFE within the prescribed period which was due on 9 February 2010.

Consequently, a writ petition was filed before the Delhi High Court in this matter.

The Petitioners contended that there was no limitation to file a request for amendment under Section 57(5) of the Act and once it was allowed, it would relate back to the date of application for grant of patent. Such an application for amendment could therefore be filed even in respect of an application for grant of a patent that was 'deemed to be withdrawn' in terms of Section 11-B(4) of the Act. The Petitioners contended that the provisions regarding the filing of RFE were only directory and not mandatory, and therefore, referring to Rule 137 and Rule 138 of the Rules, the Controller of Patents could have taken a liberal view and condoned the delay in the interest of justice.

The Respondents contended that once the deadline for filing RFE was missed by the Petitioners, there was no patent application existing in the eyes of law and a non-existing patent application could not be amended. They contended that the Court could not rewrite the time-limits set out in the Act or the Rules.

Since no RFE was filed before the expiry of the deadline in terms of Section 11-B(4) of the Act, the patent application stood withdrawn after 9 February 2010. The provisions of the Act and the Rules have to expressly reflect the legislative intent to permit relaxation of time limits, absent which such relaxation cannot be 'read into' the provisions by a High Court exercising powers under Article 226 of the Constitution. The provisions regarding the prescribed time periods in this case are mandatory and not merely directory. Merely because there is no time limit prescribed for filing an application for amendment of the priority date, it does not mean that such application can be filed even after a patent application ceases to exist in law. Once an application is deemed to have been withdrawn by an Applicant in terms of Section 11-B (4) of the

Act, the CoP cannot entertain an application for amending any portion of such application. Therefore, the Single Judge of the Delhi High Court affirmed the decision of the CoP and **declined the Petitioner's request for amendment of priority date and to restore their patent application.**

Further, the Division Bench of the Delhi High Court in *Carlos Alberto Perez Lafuente v. Union of India & Ors.* [2019 SCC OnLine Del 7404] held observed that (i) there is a definite period of limitation provided for under the Patents Act, 1970 for filing of the Request for Examination; (ii) the Controller has no statutory authority to condone the delay if the 48 months' time period is not adhered to; (iii) there is a specific mandate in law (Rule 138 of the Patent Rules, 2003) that delay cannot be condoned. For the said reasons, the Court held that the writ petition was devoid of merits and did not warrant the Court to exercise its writ jurisdiction. Accordingly, the writ petition was dismissed. However, with respect to the submissions made in the said matter, that the term 'earlier' used in Rule 24B(1)(i) must be construed to be read as 'later', considering that Rule 24B(ii) – (iv) of the Patent Rules, use the phrase 'whichever is later' in respect of computation of time period for filing of a request and that normally the 'Date of priority of an application' would be earlier than the 'Date of filing of the application'; was favorably considered by the Court. Even though the Court discussed the interpretation of Rule 24B(1)(i) in great detail, to hold that the literal interpretation of the said rule does not provide for any such ambiguity, the Court nevertheless directed that a copy of the judgment be sent to the Ministry of Law & Justice, Government of India to examine whether there is an unintended/ inadvertent error in the use of the words 'whichever is earlier' instead of 'whichever is later' in Rule 24B(1)(i) and accordingly take remedial steps, if needed.

In contrast, in the case of *Iritech v. Controller of Patents* [2017 SCC OnLine Del 7983] decided on 20 April 2017, when the request for examination and a request *via* letter addressed to Controller of Patents was brought forth for the correction of a clerical error made within the 48 months prescribed period, the order deeming the application withdrawn was quashed by the Court. In this case, after the RFE was filed timely, the Applicant realized that there was an error in the application number and therefore the Applicant requested for its correction. However, this was not entertained by the Controller and the application was deemed to be withdrawn. Since, the Petitioner complied with the prescribed requirements as stated in the Rules and the Act, i.e., the request for examination was filed within the 48 month period and even the request for correction of the clerical error was made prior to the expiry of the period of 48 months and prior to the application for grant of patent being deemed to have been withdrawn. Thus, the order of the Controller was set aside, the error in the application number was to be corrected, the application was restored and was to be treated as pending.

In the case of *European Union represented by European Commission v. Union of India & Ors.* [2022 SCC OnLine Del 1793], two patent applications of the Petitioner were deemed to be abandoned under Section 21(1) of the Act. The said applications claimed priority from 15 June 2010, and 24 September 2010, respectively. The said applications entered the national phase on 21 December 2012, and 18 April 2013, respectively. The RFE was filed timely and thereafter First Examination Reports (FER) were issued by the Patents Office on 10 April 2018, and 29 June 2018, respectively. The European Law Firm, GEVERS had engaged a patent agent in India for moving the application to national phase. However, even after several emails were

sent by M/s. GEVERES to the Indian patent agent about the status of the application, they did not get any response from the said patent agent. The files of these applications were therefore moved by the Petitioner to another Indian firm (second patent agent) which then informed the Petitioner that the patent applications were deemed to be abandoned due to the non-filing of the FER within the stipulated time. The second patent agent then followed up on the FERs for the respective applications on 29 April 2019 and sent various emails to the patent office seeking a hearing however, no reply was received. Therefore, aggrieved by this, the Applicant filed a writ petition before the Delhi High Court seeking to set aside the order of abandonment. The Petitioners contended that the delay in filing the FERs was completely non-attributable to the Applicant. Despite continuous follow-ups, the first patent agent had not responded. Under these circumstances, the delay in filing the responses deserves to be condoned as the Petitioner's valuable rights in the patents will be completely lost due to the negligence of the first patent agent which was not the fault of the Petitioner. Further, the Petitioner has also filed the same patent applications in several jurisdictions and has been granted in many of these jurisdictions which shows that the Applicant could not have intended to abandon its application. They further contended that though the Controller may not have the power under Rule 138 (as they are expressly excluded) of the Act to condone delay in filing response to FER, however, while exercising writ jurisdiction under Article 226 and 227 the Court can, in exceptional circumstances, permit the Applicant to rectify the defect and restore the application. The Respondents contended that the prescribed time period as per the Rules has lapsed and the same cannot be extended thereafter. The timelines provided are mandatory in nature and not merely directive.

The Court held that in cases where filing a response to FER is concerned the High Court may exercise its writ jurisdiction and grant extension in filing of the response to the FER on the ground that the Applicant did not have the intention to abandon its application. The Courts may in exceptional cases extend the deadline for the application to be put in order for grant after examining the factual matrix of each case and determining whether the Applicant in fact intended to abandon the patent or not. Factors like negligence by the patent agent, docketing errors, diligence of the Applicant etc., could be considered by the Courts before deciding the matter. Thus, the Court would have to examine the circumstances in the peculiar facts of each case. The Single Judge of the Delhi High Court relied on the decision of the same Court in *Ferid Allani v. Union of India & Ors.* decided on 25 February 2008, where the Court held that *'abandonment requires a conscious act on the part of Applicant which would manifest his expressed intention to abandon the application.'* The Court further held in this case that abandonment can never be presumed. In the present factual matrix, the Petitioners were diligent enough that they sent follow-up emails to the first patent agent and when the said patent agent failed to respond, they engaged the second patent agent. As the FER is usually intimated by the patent office to the patent agent on record, the Applicant was not aware of it. Furthermore, all the communication emails sent by the Applicant was within the stipulated six months plus three months period and if any of these emails were responded to, the FER would have been filed timely and would not have been time barred.

The Court also referred to the 161st **report of the Department Related Parliamentary Standing Committee on Commerce** on 23 July 2021, titled ***'Review of the Intellectual Property***

***Rights Regime in India'*** wherein the Committee took note of the enormous prejudice caused to the Applicants due to deemed abandonment provisions. The committee opined as follows:

*'The Committee opines that the abandoning of patents, without allowing hearing or petition, may demoralize and discourage patentees in the country to file patents. It recommends the Department that certain flexibility should be incorporated in the Act to make for allowance of minor errors and lapses to prevent outright rejection of patents being filed. Hence, a revised petition with penalty or fee may be permitted under the Act for minor or bona fide mistakes that had been committed in the filed patents.'*

Therefore, owing to the factual matrix in this case, the Court held that since the consequences of abandonment of an application are quite severe, the Applicant did not have an intention to abandon the application, the Applicant was conscious of the fact that the applications may be maturing examination, took initiative to keep in touch with the patent agent at all stages and as there is no fault attributable to the Applicant, the Court took a liberal approach to condone the delay and directed that the response to the FER shall be taken on record by the patent office and the applications shall be restored to their original position.

Therefore, it can be traced from the trend of decisions given by various High Courts that when it comes to condonation of delay in cases of filing reply to FERs within stipulated time and owing to the facts in each case, the Courts have adopted a liberal approach. In a similar case of *PNB Vesper Life Sciences Pvt. Ltd. v. Controller General of Patents, Designs & Trademarks* (W.P. 22253 of 2021), a decision of the Madras High Court passed on 14 March 2022, the Petitioner failed to respond to the FER within the stipulated time owing to a clerical error by the patent agent.

The Petitioner had been granted patents in various other jurisdictions. The Court gave the benefit of doubt to the Petitioner and held that it cannot see any reason as to why the Petitioner wouldn't pursue the objections of the patent office and they should not suffer owing to the error attributable to the patent agent. Therefore, the Court restored the application to its original position and the Petitioner could duly respond to the objections stated in the FER within the time as fixed by the Court.

In a recent decision dated 4 Nov 2022, in *Chandra sekar v. Controller of Patents & Designs/ Deputy of Controller of Patents and Designs* [2022 SCC OnLine Mad 5172], the delay in filing RFE for the Applications 8846/CHENP/2011 and 8907/CHENP/2011 was found to be a negligent error by the Indian Agent and not the unwillingness of the Applicant i.e., the Petitioner. The Petitioner of these Applications is from US and the US Attorney of the Petitioner handled these cases through an Indian Patent agent. The US Attorney contacted the Indian Agent regarding filing of RFE and the Indian Agent provided wrong due dates for filing RFE as 29 November 2015 and 30 November 2015 instead of the correct dates being 29 April 2013 and 5 May 2013 due to docketing error. The Indian agent then filed Form 18 and a Petition for Condonation of delay on 22 May 2013 with a prayer to condone the delay in filing Form 18. The Petitioner then filed a supplementary petition seeking condonation of delay disclosing true and correct reasons for non-filing of Form-18 within the prescribed period on 4 October 2013. The Petitions were dismissed for failing to adhere to the prescribed time-limits and the Petitioner further filed writ petitions challenging the impugned orders. The Courts

considering the facts the delay was due the negligent error by the Agent and that the Applicant was keen in continuing the Application, the valuable statutory rights of the Petitioner cannot be completely deprived of, allowed the writ petitions, and restored the Applications to their original position, allowing the Applications for Examination. It is pertinent to note that this decision did not refer to the earlier decision passed by the Delhi High Court concerning condonation of RFEs.

### **Conclusion**

Overall, it is the responsibility of the Patent agents and the Applicants to strictly adhere to all the deadlines and to have a clear understanding on the deadlines which can be extended and deadlines which cannot be extended in the prosecution of the Patent Applications. The prescribed time-limits are meant to protect the rights of the concerned parties and to seek remedy promptly. Also, it is to be observed that if such time-limits were to be prescribed for the exercise of any right, or any obligation, it would lead to a great amount of uncertainty and could be detriment to the rights of the interested parties.

Though under suitable circumstances the Courts are liberal in extending the timelines, the Courts also insisted that these provisions regarding the timelines relating to various stages of a patent application are mandatory and not merely directory and therefore can only be extended in special circumstances where sufficient reasons are afforded.

**[The authors are Director, Associate and Intern, respectively, in IPR practice at Lakshmikumaran & Sridharan, Chennai]**



## Ratio decidendi

### **Trademarks – International registration – Deemed protection under Section 35E(5) cannot be extended when opposition filed within time**

The Delhi High Court has held that in case of failure of the Registrar of Trademarks to notify its acceptance of extension of the trademarks under international registration (under the Madrid Protocol) where India has been designated to the International Bureau, a deemed protection cannot be extended to the trademark where the same has been opposed within the time for notice of opposition.

The Court in this regard rejected the contention that since the Registrar of Trademarks had failed to notify the International Bureau of its 'acceptance' within the prescribed time, as per the provisions of Section 35E(5) of the Trade Marks Act, 1999, it shall be deemed that the protection has been extended to the trademark.

The High Court noted that if the deeming provision could be invoked where the opposition to such international registration has been filed, it would be prejudicial to the opponent of such registration for no fault of his. It also observed that where any opposition stands filed within the time prescribed, the question of the Registrar of Trademarks communicating its 'acceptance' to the application without first deciding on the opposition filed, does not arise.

The Court for this purpose also noted that there is a marked difference in the language used in Article 5 of the Madrid Protocol and Section 36E(5). It observed that while in Madrid Protocol, it is the failure to communicate 'refusal' within the

time prescribed, which shall result in deemed extension of protection to the trademark, in Section 36E(5), it is the failure to convey 'acceptance' that leads to such deeming extension of protection.

Further, the Court also rejected the remedy of the Controller General to convert the opposition of the Petitioners to an application for cancellation. It was of the view that the right of the Petitioner to oppose the registration of the trademark cannot be negated by the inaction of the Registrar of Trademarks.

The Hon'ble Court set aside the order of the Controller and restored the oppositions to their original numbers.

The High Court also observed that if the slogan of 'Ease of doing business in India' is truly to be achieved, such act of negligence of the Controller is unpardonable. [*Allergan Inc. v. Controller General of Patents Designs and Trademarks – Decision dated 12 October 2022 in W.P.(C)-IPD 55/2021 and others, Delhi High Court*]

### **Commercial suit involving urgent relief – Pre-institution mediation – No requirement of application seeking exemption**

The Delhi High Court has held that it is not necessary for the Plaintiff to file an application seeking exemption from the provisions of Section 12A of the Commercial Courts Act, 2015, dealing with pre-institution mediation.

The Court in this regard observed that there is no provision under Section 12A that requires the Plaintiff to make any such application in a suit which involves urgent interim reliefs. The High

Court also noted that it has no discretion to exempt a Plaintiff from the applicability of the said section as it is not permissible for the Court to pass an order contrary to law. According to the Court, the question whether a suit involves any urgent interim relief is not contingent on whether the Court accedes to the Plaintiff's request for interim relief. It also held that the Plaintiff is the sole determinant of the pleadings in the suit and the relief sought.

The Defendant in the suit had contended though the provisions relating to pre-institution mediation are not applicable in suits involving urgent relief, the Plaintiff could not be the sole judge of determining whether the provisions of Section 12A are applicable. According to them, therefore, it was necessary for the Plaintiff to file an application seeking exemption from the provisions of pre-institution mediation.

The Court held that whether a suit involves any urgent interim relief is to be determined solely on the basis of the pleadings and the relief(s) sought by the Plaintiff. If a Plaintiff seeks any urgent interim relief, the suit cannot be dismissed on the ground that the Plaintiff has not exhausted the pre-institution remedy of mediation as contemplated under Section 12A(1) of the Commercial Courts Act, 2015. In the present case, indisputably, the Plaintiff has sought urgent interim reliefs. Thus, it is not necessary for him to have exhausted the remedy of pre-institution mediation as contemplated under Section 12A(1) of the Commercial Courts Act, 2015. [*Chandra Kishore Chaurasia v. R A Perfumery Works Private Ltd.* – Judgement dated 27 October 2022 in FAO (COMM) 128/2021, Delhi High Court]

### **Designs – Market survey cannot establish lack of novelty and originality**

Observing that the market survey would, at best, indicate that other products that resembled the subject design were available in the market, the

Delhi High Court has held that the market survey would not establish that the subject design lacked novelty and originality at the time when it was registered. The Court in this regard also observed that a design holder is not required to pursue the available remedies against all infringers in order to pursue its remedies against some infringers and that the rights of a proprietor of a registered design is not diluted merely because there are multiple infringers. Setting aside the decision of the Single Judge Bench, the Division Bench of the Court also found merit in the contention that the Single Judge could not have *suo moto* directed the parties to conduct a market survey.

The Court also rejected the reliance, in the impugned order, upon the letter produced from the Sales Manager of a Chinese manufacturer stating that the PVC strap used in the subject design was introduced seven to eight years ago. It noted that the same would be of little assistance in arriving at the *prima facie* finding as the Appellant (Plaintiff) had not claimed novelty in the design of the strap but in the shape, configuration and surface pattern of the footwear. The Court was also of the view that any letter or affidavit affirming the same, without any further material, would not be of much evidentiary value at the interim stage.

Further, the contention that the subject design was merely a trade variant was also rejected. The Court in this regard noted that though there are constraints with regard to footwear design, the decision in the case of *Crocs Inc USA v. Bata India Ltd.* cannot be read to mean that there can be no registrable design in respect of the footwear and that all designs would be merely trade variants, merely because they are fit to the shape of the foot. [*Relaxo Footwears Ltd. v. Aqualite India Ltd.* – Judgement dated 27 October 2022 in FAO(OS) (COMM) 145/2019, Delhi High Court]

## **Trademarks – Words ‘Fly High’ are descriptive of aviation sector – Use of words ‘Fly Higher’ as descriptor (and not trademark), for different services, not infringes trademark ‘Fly High’**

Observing that various airlines have been using the phrase ‘FLY HIGH’ or a variation thereof as part of their social media posts, advertising campaigns or even as a part of their Frequent Flyer Programmes and that on account of this usage, common to trade, Defendant had never sought registration of the phrase ‘FLY HIGHER’, the Delhi High Court has rejected the Plaintiff’s contention of use of deceptively similar trademark (FLY HIGHER) by the Defendant. The Court also found that ‘FLY HIGH’ was widely used, both in airline sector as well as with respect to coaching institutes pertaining to aviation sector including travel and tourism and that the Defendant was neither the only one nor the first user of the phrase ‘FLY HIGHER’.

Rejecting the plea of infringement of the mark ‘FLY HIGH’, the Court also observed that the Defendant and Plaintiff operated in an entirely different field and industry with Defendant operating a full-service airline under its well-known trademark VISTARA, while the Plaintiff was engaged in running a training institute under the FRANKFINN mark. Further, looking at the nature of services, channels of trade and class of customers, the Court was of the view that it was difficult to reach a *prima facie* conclusion that the services offered by the respective parties were not separate and distinct.

Also, observing that *prima facie* the element of likelihood of confusion or members of the public or trade associating the services offered by the Defendant as emanating from the Plaintiff, was lacking in the present case, the High Court held that thus, even assuming that Defendant was using FLY HIGHER as a trademark or even as a mark, ingredients of Sections 29(1) and (2) were

not satisfied. Rejecting the case of passing off, the Court also held that the Defendant does not need to encash on Plaintiff’s reputation to operate its airlines and the manner in which the phrase FLY HIGHER was used does not appear to be with an intent to deceive, misrepresent or confuse members of the public. [*Frankfinn Aviation Services Private Limited v. Tata SIA Airlines Ltd.* – Judgement dated 28 October 2022 in CS(COMM) 54/2022, Delhi High Court]

## **Trademarks – Registrar cannot condone delay beyond period prescribed in Rule 119 for filing review**

The Delhi High Court has held that the Registrar of Trademarks has no power to condone the delay beyond the period prescribed in Rule 119 of the Trademarks Rules, 2017 dealing with application for review of Registrar’s decision. The Court observed that Section 127(c) of the Trade Marks Act, 1999 states that the application seeking review should be made in the ‘prescribed manner’ while the manner prescribed for making such an application is in Rule 119. Accordingly, if the application is not filed in the ‘prescribed manner’, that is, including within the period prescribed for filing of such an application, the same cannot be entertained by the Registrar, as the said condition and prescription is mandatory.

The High Court also rejected the contention that Section 131 (relating to extension of time) would vest an unbridled power with the Registrar to condone the delay even beyond the period prescribed in Rule 119. It noted that though Section 131 empowers the Registrar to extend the time for doing any act, provided the time period is not expressly provided in the Act, the period prescribed under Rule 119 has to be considered as one prescribed in the Act itself. [*MS Aman Engineering Works v. Registrar Trademarks* – Decision dated 4 November 2022 in CM(M)-IPD 5/2021 & CM 16168/2020, Delhi High Court]

## Patents – Territorial jurisdiction for revocation applications and appeals clarified

Answering the question as to in which High Court would revocations petitions, which are filed purely as original proceedings, be maintainable, the Delhi High Court has held that the expression ‘*High Court having territorial jurisdiction in that State or Union Territory*’, in case of revocation petitions would have to be decided on the basis of both the static effect and the dynamic effect of the grant of the patent. According to the Court, though undoubtedly, the High Court in whose jurisdiction the patent was granted would be one of the fora which would have jurisdiction, the place where the commercial interest of the applicant is affected would also be a relevant consideration to determine jurisdiction.

However, in case of appeals, the High Court rejected the plea that the concept of cause of action ought to be merge into Section 117A of the Patents Act, 1970 in order to determine the High Court before which appeals would be maintainable. The Court was of the view that merely holding of hearing virtually by the Controller, who is in Delhi, and passing of the impugned order by the Delhi Patent Office, while the appropriate office in respect of such an application continues to remain in Mumbai, cannot vest jurisdiction in Delhi High Court to entertain an appeal. According to the Court, the concept of cause of action cannot be pleaded to vest jurisdiction in other High Courts i.e., other than the one in the territorial jurisdiction of which the appropriate office is located. [*Dr. Reddys Laboratories Limited v. Controller of Patents – Judgement dated 10 November 2022 in C.O.(COMM.IPD-PAT) 3/2021, Delhi High Court*]



## News Nuggets

### Patents – No deemed abandonment in case of fault of patent agent

The Delhi High Court has reiterated that a patent or patent application cannot be deemed to be abandoned and/or lapsed if no intent to surrender/withdraw the patent/application has been expressed by the patent owner/applicant. Looking up the facts and the documents on record, including the affidavit filed by the patent agent, the Court in *Bry-Air Prokon Sagl v. Union of India* [Decision dated 17 October 2022] ruled that there was no intent on part of

the Petitioners to abandon their patent applications, and thus, they cannot suffer due to the fault of the patent agent. Accordingly, the Court ordered to restore patent applications to their original position and the Petitioners were permitted to file their response to the First Examination Reports.

Further, the Court observed that ‘Abandonment’ requires a conscious act on the part of the applicant, which would manifest the intention to abandon, and no presumptions can be drawn in this respect. The Court was of

the view that deemed abandonment leads to serious impact on the valuable rights of the patent applicant. It noted that this is compounded by the fact that under the statutory scheme, no appeal is provided against an order of deemed abandonment of the application for a patent under Section 21 of the Patent Act, 1970.

### **Copyrights – Invocation of Section 64 by police is non-application of mind**

The Delhi High Court has held that invoking of Section 64 of the Copyright Act, 1957 by the police in the FIR is nothing, but a sheer non-application of mind by the police. The Court in *Maheshbhai @ Kanbhai Haribhai Sojitra v. State of Gujarat* [Order dated 14 September 2022] observed that Section 64 is not an offence, but the power envisaged to the police or the Investigating Officer to seize the material, if any infringement is found. According to the Court, there cannot be any FIR (First Information Report) for this. Section 64 envisages power of police to seize infringing copies.

### **Trademarks – ‘GLOW-GETTER’ as a composite mark cannot be rejected in Sections 9 and 11**

The Delhi High Court has held that the combination ‘GLOW-GETTER’ as a composite mark cannot be rejected in Sections 9 and 11 of the Trade Marks Act, 1999, as the same does not directly describe the kind, quality, etc. of the products concerned (cosmetics here). In a case where the mark ‘GLOW-GETTER’ was sought to be registered in respect of cosmetic and beauty care products, the Court in *Visage Beauty and Healthcare Pvt. Ltd. v. Registrar of Trademarks* [Decision dated 3 November 2022] allowed the appeal against the rejection of the registration by the Registrar of Trademarks.

It however stated that the word ‘GLOW’ per se may be a word which may be used by various third parties in respect of cosmetics and hence no exclusive rights in the word ‘GLOW’ per se shall vest in the Appellant.

### **Patents – Scope of submission of written submissions post hearing**

In a case involving non-filing of written submissions and later filing of amended claims post hearing, the Delhi High Court has held that the filing of written submissions and relevant documents under Rule 28(7) of the Patents Rules, 2003 cannot be used as a tool to reopen the entire debate. The Court observed that the purpose of Rule 28(7) is to bring the matter to a closure rather than to reopen the consideration of the patent application. According to the Court, it is meant as a sort of primer of the submissions made, and discussions agreed upon during the course of hearing. As per the provisions of the Rule 28(7), in all cases of hearing, written submissions and the relevant documents, if any, shall be filed within fifteen days from the date of hearing. However, considering that the patent rights are valuable rights and the order impugned was not a reasoned order, the Court in *FMC Corporation v. Controller of Patents* [Decision dated 19 October 2022] remanded the matter to the Controller for fresh decision.

### **Trademarks – Benefit of Section 35, covering bona fide use of own name, when not available**

Observing that the Defendant initially started its business under the name ‘DIAMEZ’ and later on changed as ‘NEENA & RAVI RAKYAN’, and the fact that the business was commenced from the adjoining premises, the Delhi High Court has held that this is sufficient to reach a conclusion that the Defendants were not entitled to the benefit of Section 35 of

the Trade Marks Act, 1999. The Court observed that the *bona fide* use in terms of Section 35 would mean an honest use by a person of his own name without any intention to deceive and without any intention to ride on the popularity or goodwill of a registered mark. The Plaintiff in the case *Varun Gems v. Precious Jewels* [Judgement dated 6 October 2022] had a valid registration in respect of the label 'RAKYAN'S FINE JEWELLERY'.

### **Territorial jurisdiction of Court – Spill over of advertisement not material**

In a case where both the Plaintiff and the Defendants in the suit were admittedly carrying on their business only within the State

of Uttar Pradesh and merely because in the course of their business, the Defendants in the suit had advertised their products in the print as also in electronic media, which may have a spill over circulation in Delhi (which also had not been proved by the Plaintiff), the Delhi High Court has held that it cannot be said that the Trial Court at Delhi would gain jurisdiction to entertain the suit of trade mark infringement and passing off against the Defendants in the suit. The High Court in *Vivek Purwar v. Hari Ram and Sons* [Decision dated 2 November 2022] also noted that mere filing of an application before the Registrar of Trademarks would not vest jurisdiction in the Trial Court at Delhi to entertain the suit.

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