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INTELLECTUAL PROPERTY LAW

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I INTRODUCTION

BY DECODING landmark rulings in the evolving domain of intellectual property (IP), this Survey captures key developments in India in the year 2023 encompassing a broad spectrum of IP related issues and highlighting ground-breaking judicial pronouncements that have modified and reshaped the Indian legal landscape in IP law. These judgments have brought clarity on concepts and new interpretations of various unresolved aspects of IPR statutes, particularly in the digital landscape. The survey year witnessed several significant first-of-its-kind rulings and revolutionary judicial pronouncements in various subsectors of IPRs in the domain of patent, copyright, design, confidential information and geographical indication.

II COPYRIGHT

Dynamic+ injunctions

In the ever increasing digital piracy era, dynamic injunctions were adopted by the judiciary in India in 2019¹ to protect existing copyrighted work from online infringement by mirror websites. As an add-on to dynamic injunctions, dynamic+ injunctions are devised to instantly protect any future work of a plaintiff from being infringed, and from being illegally streamed or hosted online, without necessary deliberations on the pressing issues surrounding the determination of copyright ownership in such future works. In order to keep pace with the hydra-headed nature of online copyright infringement, in August 2023, the Delhi High Court issued the first ever dynamic+ injunction order in *Universal City Studios*,² protecting the future works of the plaintiffs from copyright infringement by flagrantly infringing online locations (FIOLs), and ruled thus: “To keep pace with the dynamic nature of the infringement that is undertaken by hydra-headed websites, this Court has deemed it appropriate to issue this ‘Dynamic+ injunction’ to protect copyrighted works as soon as they are created, to ensure that no irreparable loss is caused to the authors and owners of copyrighted works, as

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1 The Delhi High Court ordered the first dynamic injunction in April 2019 in *UTV Software Communication Ltd. and Ors v. 1337X.TO*, 2019 SCC OnLine Del 8002.

2 *Universal City Studios LLC v. Dot Movies. Baby*, 2023:DHC:5842.

there is an imminent possibility of works being uploaded on rogue websites or their newer versions immediately upon the films/shows/series etc.”³ The suit was filed by a collective of six Hollywood studios to prevent unauthorised, unlicensed and illegal distribution of their copyrighted content made available on digital platforms by FIOs. The court also directed the Domain Name Registrar to lock and suspend the domain names of the infringing websites upon being intimated by the plaintiffs. ‘Dynamic+ injunction’ thus becomes the latest judicial remedy to keep up with the dynamic and hydra-headed nature of the online infringement actions, so that the copyrighted works are protected as soon as they are created, to ensure that no irreparable loss is caused to the owners of the copyrighted works as the infringing websites uploaded infringing versions immediately after the release. Apart from *Universal City Studios LLC. v. Dot Movies. Baby*, the court awarded dynamic+ injunction in *Universal City Studios LLC. v. Fztvseries. Mobi*.⁴ as well against rogue websites by considering the immense loss to the economic and moral rights of the plaintiffs.

Section 31 D and internet broadcasting

The High Court of Bombay, in *Wynk Ltd. v. TIPS Industries Ltd.*,⁵ held that section 31D of the Copyright Act on statutory licensing of broadcasting of literary and musical works does not include internet broadcasting or streaming within its scope. Section 31D which has been inserted by way of 2012 amendment allows broadcasting organizations which are desirous of communication to the public by way of broadcast or by way of performance or musical work after prior notice and royalty to the owner. As per the decision, (a) section 31D contemplates communication to public by way of broadcast of sound recordings alone, and not their commercial rental and/or sale,⁶ and (b) internet broadcasting organizations cannot enjoy the benefits of a statutory license under section 31D. The intention of the legislature while enacting Copyright (Amendment) Act, 2012, was to restrict section 31D to radio and television broadcasting organisations. For the court, the facts of the matter thus did not present an occasion for the application of the doctrine of *contemporaneoexpositio*. By rejecting the arguments on fair use, the court held that streaming does not have the protection of ‘fair use’ under sections 52(1)(a)(b) or 52(1)(b). The utilisation of TIPS Industries’ repertoire by Wynk without an established commercial agreement was thus an infringement of the copyright. In this landmark judgment which primarily addressed the applicability of statutory licensing to streaming or internet broadcasting, the court adopted strict interpretation being the section is an exception to the copyright holders ‘exclusive rights.’

3 *Id.*, para 20.

4 2023 SCC OnLine Del 7313.

5 MANU/MH/5030/2022.

6 The Bombay High Court, in *Warner/Chappell Music Ltd. v. Spotify* (2019) SCC 6469 (Bom) held in 2019 that allowing users to download a song from Wynk to their device for offline listening and enabling them to subscribe song amounted to rent and sale.

Stream ripping blocking

One of the latest trend in the music piracy is stream ripping which allows the pirate to obtain a permanent copy of audio and audio-visual content that is streamed online. Stream ripping not only infringes copyright but it also causes enormous negative economic impact in the music industry. *Sony Music Entertainment India Pvt. Ltd. v. Yt1s.Com*⁷ occasioned the first ever stream ripping being prohibited in India by the High Court of Delhi which restrained the defendants from copyright infringement via use of rogue websites. The court further directed the internet service providers to block mirror/redirect/alphanumeric websites. It is a welcome step, following similar decisions in multiple jurisdictions, to prevent online music piracy where law breakers bring new anti-circumvention methods to access and distribute copyrighted music.

Copyrightability of GUIs and Infringement in fantasy games

In the ongoing dispute of *Hulm Entertainment Pvt. Ltd. v. Fantasy Sports Myfab11 Pvt Ltd.*,⁸ the petitioner alleged substantial copying of its original trading and stock features along with the graphical user interface (GUI) of their fantasy sports mobile application “Exchange22”. Hulm’s app was an adaptation of its registered concept note as literary work. An injunction order initially granted was later modified. Subsequently, the Delhi High Court refused to grant relief to Hulm as the distinguishing features in the work were not enough for the plaintiffs to cross the threshold of idea expression dichotomy to claim originality for copyright protection in the gaming app. The court, in its detailed analysis found that concept note lacked originality. The court reiterated the following principles by referring to a large number of authorities:⁹

1. There can be no copyright in an idea, subject-matter, themes, plots or historical or legendary facts and violation of the copyright in such cases is confined to the form, manner and arrangement and expression of the idea by the author of the copyrighted work.
2. Where the same idea is being developed in a different manner, it is manifest that the source being common, similarities are bound to occur. In such a case the courts should determine whether or not the similarities are on fundamental or substantial aspects of the mode of expression adopted in the copyrighted work. If the defendant’s work is nothing but a literal imitation of the copyrighted work with some variations here and there it would amount to violation of the copyright. In other words, in order to be actionable the copy must be a substantial and material one which at once leads to the conclusion that the defendant is guilty of an act of piracy.
3. One of the surest and the safest test to determine whether or not there has been a violation of copyright is to see if the reader,

⁷ Available at: <https://indiankanoon.org/doc/53002482/>.

⁸ Available at: <https://indiankanoon.org/doc/70533302/>.

⁹ *Id.*, para 46.

spectator or the viewer after having read or seen both the works is clearly of the opinion and gets an unmistakable impression that the subsequent work appears to be a copy of the original.

4. Where the theme is the same but is presented and treated differently so that the subsequent work becomes a completely new work, no question of violation of copyright arises.

5. Where however apart from the similarities appearing in the two works there are also material and broad dissimilarities which negative the intention to copy the original and the coincidences appearing in the two works are clearly incidental no infringement of the copyright comes into existence.

6. As a violation of copyright amounts to an act of piracy it must be proved by clear and cogent evidence after applying the various tests laid down by the case-law discussed above.

7. Where however the question is of the violation of the copyright of stage play by a film producer or a director the task of the plaintiff becomes more difficult to prove piracy. It is manifest that unlike a stage play a film has a much broader prospective, wider field and a bigger background where the defendants can by introducing a variety of incidents give a colour and complexion different from the manner in which the copyrighted work has expressed the idea. Even so, if the viewer after seeing the film gets a totality of impression that the film is by and large a copy of the original play, violation of the copyright may be said to be proved.

On the discussion on idea/expression dichotomy and the doctrine of merger, the court observed that there can be no copyright protection where an idea can only be expressed in a limited number of ways; or even in the expression of that idea as that would confer monopoly on the idea and would be against the settled law. This doctrine of merger is particularly applicable with respect to games since they consist of abstract rules and play ideas. Though the decision did not explicitly rule GUIs as uncopyrightable, it demonstrates the legal complexities in copyrighting GUIs.

Street art is not public domain work

India has very limited copyright jurisprudence on street art. *St Art India Foundation v. Acko General Insurance*¹⁰ decided by the High Court of Delhi revolved around the use of plaintiffs' street art - artistic works titled '*Humanity*' in its advertisements. The plaintiffs projects aimed at urban regeneration activities and to make public spaces vibrant and interactive through public art and mural. The court categorically held that the advertisement of the defendant reproducing the mural was a violation of copyright as the plaintiffs' work was not a public domain work. The court has directed Acko General Insurance to take down all its

10 2023 SCC OnLine Del 7277.

social media posts using ‘*Humanity*’. The use of copyrighted work for commercial purpose does not qualify as fair dealing.

Copyright in screenplay

Cinematograph film has always been a fascinating copyright domain for industry, academia, lawyers and judiciary alike unfolding newer interpretations and statutory constructions. In *RDB and Co. HUF v. Harper Collins Publishers India Pvt. Ltd.*,¹¹ the High Court of Delhi addressed the issue, ‘if the author has been commissioned to write the screenplay of a movie by the producer, who owns the copyright over the screenplay, the author of the screenplay or the producer?’

The film in question was one of the masterworks of Bharat Ratna Satyajit Ray - *Nayak* released in 1966. By virtue of section 13 (4) of the Copyright Act, 1957 where a cinematograph film is based on a work in which separate copyright exists, the copyright existing in the cinematograph film shall not affect such separate copyright. The court construed screenplay of the film as a ‘literary work’ for the purpose of section 13(1)(a) for which a separate copyright would subsist.¹² It is to be noted that screenplay of a film, by no means is included in the definition of cinematograph film.

Regarding the novelisation, the court observed thus: Novelization of a screenplay does not involve either abridgement of the screenplay, or converting it into a version in which the story is conveyed by means of pictures in a form suitable for reproduction in a book; novelization is not adaptation under section 2(a).¹³ A novel is a ‘reproduction in material form’ of the screenplay.¹⁴ In the opinion of the court, the copyright in the screenplay of a work commissioned by the producer is not vested in the producer but in the author of the screenplay. Thus, the author of the screenplay has the right to issue a license to novelize the screenplay. The court categorically established faulty any presumption that assumes “all rights in the underlying works in a cinematographic film automatically vest in the producer of the film” is a faulty one.¹⁵ The first owner of the copyright in the screenplay (which is the author of the screenplay) of the film has the right to novelize the screenplay.¹⁶

The court also cautioned the parties to be borne in mind, before applying a decision as a precedent, the factual and legal matrix in which the decision was rendered.¹⁷ In the film copyright licensing landscape, the producers have to now make dedicated agreements to cover works that are not explicitly covered by section 17.

11 2023: DHC: 3551 (neutral citation), available at: https://www.livelaw.in/pdf_upload/judgementphp-473373.pdf (last visited on May 2, 2023).

12 *Id.*, para 60.20.

13 *Id.*, para 62.1.

14 *Id.*, para 62.2.

15 *Id.*, para 28.

16 *Id.*, para 62.3.

17 *Id.*, para 71.

License for copyrighted music and recordings

In *Phonographic Performance Ltd. v. Cornerstone Sports and Entertainment Pvt. Ltd.*,¹⁸ the High Court of Delhi ruled that One8Commune had infringed copyrights of the plaintiff by playing their copyrighted songs without a license. The court also stated while temporarily restraining the defendant that it would not be permissible to anyone to play copyrighted recordings without obtaining a prior license especially where the recordings are being played for commercial benefit. In *Phonographic Performance Ltd. v. Esteem Services*,¹⁹ the court reiterated its decision in *Phonographic Performance Ltd v. Canvas Communication*,²⁰ that obtaining of a licence from the owner of copyright in recordings which are proposed to be played is mandatory, irrespective of whether the owner is, or is not a copyright society. The court strictly warned the defendant from propagating any message to the effect that no license needs to be taken from PPL, before playing its copyrighted recordings.

Synchronization right and royalties

The High Court of Bombay in *Indian Performing Right Society Ltd. v. Rajasthan Patrika Pvt. Ltd.* and *Indian Performing Rights Society Ltd. v. Music Broadcast Ltd.*,²¹ noted that Copyright Amendment Act of 2012 have completely changed the legal framework concerning the rights of authors of original literary, dramatic, musical and artistic works. Subsequent to the amendment, authors of underlying work, by a legislative tool, have been prohibited from assigning or waiving their right to receive royalties for the utilization of their works in any form, under the third proviso to section 18 of the Copyright Act, other than for the communication to the public of such works along with the cinematograph film in a cinema hall. Hence they are entitled to receive royalties when the concerned synchronized work is made available to the public. According to the court, mere delay or alleged acquiescence on the part of authors shall not act as a ground to deprive them of interim reliefs, which they otherwise deserve, if a strong *prima facie* case is made out. In the matter at hand, the court had to consider an interim injunction application filed by the Indian Performing Rights Society against FM Radio Broadcast channels for unauthorised broadcast of the works of IPRS members. The judgment clarifies that by virtue of 2012 amendment, the FM radio stations are bound to compensate composers and lyricists for the copyrighted music they broadcast.

First license under section 32

The *Annual Survey* of last year has captured a significant development in *G. Karkhanis v. Kirloskar Press*²² wherein the High Court of Bombay has initiated the process of approving license, without the author's authorisation, under section

18 2023 SCC OnLine Del 7911.

19 CS(COMM) 723 of 2023, order dated 10-11-2023.

20 CS(COMM) 671 of 2021, order dated 31-07-2023.

21 2023:BHC-OS:3623.

22 2023 SCC ONLINE BOM 678.

32 to produce and publish translations of a literary work under the Indian Copyright Act for the first time in India. The High Court of Bombay in March 2023, granted India's first licence under section 32 to publish a translation of the literary work - "*The Spirit's Pilgrimage*" in Marathi as the translation of the work would indeed serve the interest of general public.

Other notable copyright decisions

The High Court of Karnataka in *Mangalore New Sultan Beedi Works v. State of Karnataka*²³ held that the civil and criminal actions envisaged under the Copyright Act as remedies in case of infringement are independent of each other and as such the statute provides for a dual framework in case of copyright violation.

Refusing an interim injunction against the film, *Shamshera* from OTT release, the High Court of Delhi in *Bikramjeet Singh Bhullar v. Yash Raj Films Pvt. Ltd.*,²⁴ observed that (i) copyright does not extend to ideas and themes, (ii) dissimilarities between the work outweigh the alleged similarities; and the similarities by themselves are not sufficient to presume copyright infringement,²⁵ and (iii) mere access alone cannot be a ground to presume copyright infringement and the plaintiff has to establish substantial similarity.

In *Humans of Bombay v. People of India*,²⁶ a matter alleging copyright infringement, passing off and unfair competition, the court restrained both the storytelling platforms from using each other's copyrighted work, though no copyright vests in the idea of a story telling platform and only the expression of the stories are protected. Humans of Bombay alleged infringement by the defendant by replicating their stories and copying creative expressions. The court restrained both the parties from using each other's copyrighted work: (i) commissioned photographs; (ii) literary works such as interviews scripts and original pieces written authors on the respective platforms; (iii) videos that may have been commissioned by the platforms themselves; and (iv) the manner of presentation of the stories published by the platforms in respect of a particular subject.²⁷

III PATENTS

Requirement of a plurality of invention and filing of divisional application

The language of section 16²⁸ of the Patents Act requires the plurality of inventions to be gathered from disclosures made either in the provisional or the complete specification. The precept 'what is not claimed is disclaimed' which is a relevant doctrine in infringement suits has no application to drafting of claims. As

23 2023 LiveLaw (Kar) 201.

24 Available at: <https://indiankanoon.org/doc/104724117/>.

25 *Id.*, para 51.

26 CS(COMM)646/2003 & I.A. 18030/2003.

27 Available at : <https://indiankanoon.org/doc/128396494/>.

28 *Id.*, para 30.

per the judgement in *Syngenta Ltd. v. Controller of Patents*²⁹ from the High Court of Delhi, a divisional application could only be filed if the parent application incorporated claims pertaining to multiple distinct inventions and a divisional application moved in terms of section 16 is maintainable provided the plurality of inventions is disclosed in the provisional or complete specification. This progressive judgement upholding the legislative intent on divisional applications clarifies that divisional applications are admissible not only based on explicit claims but also on disclosure within the provisional or complete specification of the patent. The court deviated from and overturned the ruling in *Boehringer Ingelheim*³⁰ which held that if the plurality of inventions is not contained in the claims of the parent application, the divisional application would not be maintainable.

Patentability of computer related inventions (CRIs)

After observing that there is a lack of clarity on the meaning of ‘technical effect’ and ‘contribution’ under 2017 CRI guidelines³¹ used by the Patent Office, in *Microsoft Technology Licensing v. Asst. Controller of Patents and Designs*,³² the High Court of Delhi held that Microsoft’s invention of using two cookies to provide user authentication instead of one, had a technical effect. As per the court, the controller’s rejection has resulted from misinterpretation of section 3(k) of the Patents Act, and an oversight of technical effect and contribution of the claimed invention, resulting in erroneous determination that the subject patent constitutes computer program *per se*.³³ As postscrip, the court also observed that “an invention should not be deemed a computer program *per se* merely because it involves algorithms and computer-executable instructions; rather, it should be assessed based on the technical advancements it offers and its practical application in solving real-world problems.” The court also advised Indian Patent Office to adopt a “more comprehensive approach when assessing CRIs, taking into account technical effects and contributions provided by the invention rather than solely focusing on the implementation of algorithms and computer-executable instructions.”

In *Raytheon Company v. Controller General of Patents and Designs*,³⁴ the High Court of Delhi further held that innovation in the field of artificial intelligence,

29 S: 16 - Power of Controller to make orders respecting division of application: (1) A person who has made an application for a patent under this Act may, at any time before the grant of the patent, if he so desires, or with a view to remedy the objection raised by the Controller on the ground that the claims of the complete specification relate to more than one invention, file a further application in respect of an invention disclosed in the provisional or complete specification already filed in respect of the first mentioned application.

30 2023:DHC:5225

31 *Boehringer Ingelheim International GMBH v. The Controller of Patents*, 2022 SCC OnLine Del 3777.

32 Revised Guidelines for Examination of Computer-related Inventions (CRIs), 2017.

33 MANU/DEOR/63610/2022.

34 Indian Patents Act bars from patentability computer program *per se*.

blockchain technologies and other digital products based on computer programs would not become non-patentable inventions merely because of that reason. Patent applications for products with in-built computer programs have to be examined to see if they result in a 'technical contribution; as the addition of the terms '*per se*' in section 3(k) was a conscious legislative step. Inventions demonstrating technical effect or a technical contribution are patentable even though they are based on a computer program.

FRAND terms are not a 'one way' street

Even though, standard essential Patents (SEPs) are explicitly covered in the Patents Act, 1970, the judiciary has long recognized SEPs, and have adjudicated claims for infringement, security, damages *etc.* surrounding SEPs. In *Intex Technologies (India) Ltd. v. Telefonaktiebolaget L M Ericsson*,³⁵ the High Court of Delhi evaluated the validity of the SEPs owned by Ericsson and Ericsson's fulfilment of FRAND (Fair, Reasonable, and Non-Discriminatory) commitments. Regarding the question, whether Ericsson's patents were SEPs, and, therefore, required to be licensed on FRAND terms, the court held that Intex could not avoid licensing fees by claiming the patents were not essential to industry standards while negotiating with Ericsson for a license. After analysing a number of decisions, the court observed thus:³⁶

It is not true that the implementer, who is often a large commercial entity itself having a global business presence, enters into any kind of negotiation with a Patentee 'blindly'. The implementer has to either accept the licensor's offer or give a counter offer along with an appropriate security in accordance therewith to prove its bonafides as in the interregnum it cannot freely sell its devices using such Standard Essential Patents. If no ad-hoc royalty is paid during the interregnum, such party benefits, to the disadvantage of other willing licensees, and gets an unfair competitive edge in the market. Accordingly, FRAND obligations have been interpreted to impose a burden not just on Standard Essential Patent holders, but on implementers as well. The Standard Essential Patents regime incorporates mutual reciprocal obligations on both the Essential Patent holder and the implementer. It is not a 'one way street' where obligations are cast on the Essential Patent holder alone. Consequently, the Standard Essential Patents regime balances the equities between the Patentee and the implementer and ensures a level playing field. The conduct of the parties during negotiations is one of the key factors to be kept in mind while assessing whether a potential licensor and licensee were a willing licensor or a willing licensee.

35 2023:DHC:6673

36 Neutral Citation Number: 2023:DHC:2243-DB.

This decision sheds lights on how the courts should approach disputes involving SEPs and the interpretation of FRAND obligations.

Patentability of diagnostic methods

The High Court of Madras in *The Chinese University of Hong Kong and Sequenom, Inc. v. The Assistant Controller of Patents and Designs*³⁷ examined the scope of section 3(i) of the Indian Patents Act which makes ‘processes that treat humans or animals for medicinal, surgical, or diagnostic purposes’ ineligible for patents. The suit was against the order of the Controller of Patents, rejecting the Chinese University of Hong Kong and Sequenom Inc’s application for a Non-Invasive Prenatal Screening Test (NIPT) for foetal genomic analysis. While examining whether section 3(i) is restricted to only *in vivo* tests practices on the human body, the court observed thus: The scope section 3(i) should not be unduly curtailed by limiting it to *in vivo* or definitive diagnosis. Its scope should not be unduly expanded by implying the words ‘relating to’ diagnosis. Determination of foetal fraction is related to diagnosis but is not diagnostic. The contention that the test may be used for sex determination under the PNDT Act is not relevant from a patent application evaluation perspective as PNDT Act prohibits sex selection and prescribes penalties in respect thereof. Whether a test is diagnostic is to ask the question whether the test is inherently and *per se* capable of identifying the disease, disorder or condition for treatment of the person. In the opinion of the court, if a screening test is capable of identifying the existence or non-existence of a disease, disorder or condition and/or the site, extent, severity or other aspects thereof for treatment of human beings, irrespective of whether the person concerned is symptomatic or asymptomatic, such screening test would qualify as a diagnostic test. If the screening test identifies the disease, disorder or condition albeit subject to confirmation by definitive tests, it would still qualify as “diagnostic” for purposes of section 3(i) because the provision does not use the qualifier “definitive”. If a diagnosis for treatment may be made, it would be ineligible for patent; whereas, if diagnosis for treatment cannot be made, it would be patent eligible.

Interpretation of sections 3(d) and 3(e)

The High Court of Madras, in *Novozymes v. Asst. Controller of Patents*³⁸ examined the import of sections 3(d) and 3 (e) of the Indian Patents Act. The Controller had rejected the patent application on the ground that the claimed invention pertained to a known substance under section 3(d) and the composition claims pertained to a substance obtained by the mere admixture of ingredients under section 3(e). Sections 3(d) and 3(e) bar patents on these grounds. The court clarified that while section 3(d) can be applied to all the known substances including biochemical like phytase, in the subject invention, there was an enhanced efficacy which precludes bar under section 3(d). Section 3(e) is restricted to compositions formed by aggregating known ingredients and can apply to composition claims containing new ingredients. If any of the ingredients of the

37 *Id.*, paras 71-73.

38 2023:MHC:4617.

composition independently satisfies the requirements for an invention under the Patents Act, a patent may be applied for and granted in respect thereof notwithstanding section 3(e).³⁹ There is nothing that limits the application of section 3(e) to a composition claim formed by the aggregation of known ingredients.

Tests for novelty and obviousness are different

The High Court of Calcutta in *Guangdong Oppo Mobile Telecommunication Corp. Ltd. v. The Controller of Patent*⁴⁰ held that the grounds of lack of novelty cannot work in tandem with the lack of inventive steps in opposing grant of any patent. The order of the patent examiner was challenged being non-speaking order and interchangeable use of the words ‘novel’ and ‘inventive’ without appreciating the meaning and content thereof in the impugned order. The court clarified that the tests for novelty and obviousness are different and cannot coexist in connection with the same document. Thus, an invention cannot be considered to involve an inventive step if it is obvious to a person skilled in the art whereas an invention would lack novelty if a single prior art document contains an enabling disclosure of the claimed invention. Any claim can pass the test of inventive step if it discloses a ‘technical advancement’ in comparison with the closest prior art and the features comprising inventive steps are not obvious to a person skilled in the art. The court held that the patent examiner’s rejection order based on lack of novelty and inventive step was not accurate and failed to establish how the prior art documents made the invention non-novel. The prior art document must comprehensively address the invention and mosaicking of prior arts is permitted only when a common thread links the claims with prior art apparent to a skilled person. The court also directed for fresh examination post amendments.

Pro-tem security order

In *Nokia Technologies Oy v. Guangdong Oppo Mobile Telecommunications Corp.*,⁴¹ a landmark judgement emphasising the necessity for SEP implementers to provide adequate security during licensing disputes, the division bench of the High Court of Delhi held that SEP holders are entitled to pro-tem security payment. Guangdong continued to use Nokia’s three SEPs integral to mobile communication technologies, beyond the expiration of their licensing agreement in 2021. After examining the obligations of SEP implementers during negotiation phases and FRAND terms, the court directed Oppo to deposit 23% of its Indian sales revenue post the 2018 agreement’s expiry. On appeal, the apex court refused to interfere with the high court’s decision. The high court also reiterated the ratio in *Intex Technologies (India) Ltd. v. Telefonaktiebolaget L.M. Ericsson*,⁴² that in case of patent infringement, relief can be granted “even if infringement of one patent is

39 Available at: <https://indiankanoon.org/doc/135802311/>.

40 Deviating from the decision of *Stempeutics Research Pvt. Ltd. v. Assistant Controller of Patent & Designs*, 2020 SCC OnLine IPAB 16.

41 Available at: <https://indiankanoon.org/doc/88225882/>.

42 Available at: <https://indiankanoon.org/doc/39407680/>.

prima facie established”.⁴³ The objective of pro-tem order was explained by the court thus: “This Court is further of the opinion that a pro-tem security order cannot be likened to an injunction order because unlike an injunction order it does not stop or prevent the manufacturing and sale of the infringing devices. The intent of a pro-tem security order is to either ensure maintenance of *status-quo* or to retain the courts’ power and ability to pass appropriate relief at the time of disposal of the injunction application.” This approach of the court balances the interests of right owners with the larger public interest, especially in Indian judicial system where matters take longer time for final disposal.

Appraisal of alternative methods for making unaffordable life saving medicines

In *XXX v. Union of India*,⁴⁴ the High Court of Kerala took *suo moto* cognizance of the unaffordability of the imported drugs Ribociclib and Abemaciclib used in last stages of breast cancer treatment. The court converted the matter into *suo moto* after the death of the petitioner who had petitioned the government to make drugs more affordable by allowing generic versions. The monthly cost of the medicines amounted to INR 63,480/. The court urged the Central Government to consider compulsory licensing of Ribociclib which was opposed by the patentees, Novartis and Eli Lilly on the ground that their sales have remained strong despite the pricing of these drugs. While the government refused compulsory licensing on the ground that breast cancer is not a matter of ‘national’ or ‘extreme’ urgency (the statutory grounds under section 92 for the Central Government to grant *suo moto* a compulsory license) it acknowledged the effectiveness of Ribociclib for breast cancer treatment. The court further directed the Union of India to collect data regarding persons suffering from different types of breast cancer from the Indian Council of Medical Research. The court directed the Central Government to apprise it regarding the alternative methods for making medicines affordable to breast cancer patients in India who could not afford expensive drugs.

Breast cancer has ranked number one cancer among Indian females. While resorting to compulsory license under section 92 is a complex legal issue with the risk of inviting reciprocal measures from foreign countries including Special 301 Report, the present case is a wakeup call for countries like India to think beyond compulsory license and devise mechanism to treatment support to cancer patients and alternative methods for making life saving medicines affordable. The matter is certainly an eye opener as to the exorbitant pricing of life saving patented medicines and the government should devise scheme for life saving medicines to make them available to the less advantaged sections through alternative methods.

Other notable patent decisions

Non-working of a patent is a valid reason not to grant an interim injunction, as through the mechanism of ‘working of patents,’ the patented inventions are

43 2023:DHC:2243-DB, *Available at*: <https://indiankanoon.org/doc/84641416/>.

44 The Competition Commission has earlier elaborated on the FRAND terms in the matter between the same parties: Case No. 76/2013, <https://www.wipo.int/wipolex/en/text/591243>.

made available and accessible to the public. In *Enconcore N.V v. Anjani Technoplast*,⁴⁵ while considering the issue of grant of an injunction for infringement of a patent which is not worked by the patentee, the High Court of Delhi refused to grant an interim injunction due to non-working of the patent.

The High Court of Delhi by broadening the permissible scope of amendment of claims in a patent application, ruled in *Allergan Inc v. The Controller of Patents*⁴⁶ that amendment of claims which merely adjusts the nature of the patent is not barred under section 59 (supplementary provisions as to amendment of application or specification) of the Patents Act. The court pronounced this ruling while considering the question of amending the original 'method of treatment' claims to 'composition' claims. Section 59(1)⁴⁷ mandates amended claims to be encompassed within the original scope of the claim. This does not interdict amendment that merely adjusts the nature of the invention claimed, such as amendment from a method to a composition, as long as the subject matter of the invention remains the same. The essence of the invention or its technical contribution has to remain consistent across the amended claims.

In *Agfa Nv v. The Assistant Controller of Patents*,⁴⁸ the court observed that as the number of patent filings in India are rapidly increasing, there is an imminent need to update the *Manual of Patent Office Practice and Procedure* so that examiners and controllers can get better guidance on dealing intricate matters when handling complex patents involving artificial intelligence, machine learning, agro-chemicals, pharmaceuticals and manufacturing method which have a large number of claims and involve multiple features which are interlinked to each other.

IV PATENTS ACT AND COMPETITION ACT

The Patents Act supersedes the Competition Act

Setting aside the decisions in *Ericsson v. CCI* and *Monsanto v. CCI*,⁴⁹ the High Court of Delhi in *Telefonaktiebolaget LM Ericsson (PUBL) v. Competition Commission of India*⁵⁰ held that Chapter XVI of the Patents Act, 1970 is a complete code in itself which overrides the Competition Act, 2002. The court held so while answering the question, when a patent is issued in India, and the patentee asserts such rights, can the Competition Commission of India (CCI) inquire into the actions

45 W.P. (C) No.18999 of 2022.

46 Available at: <https://indiankanoon.org/doc/82804251/>.

47 2023/DHC/000515.

48 S. 59(1): No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of disclaimer, correction or explanation, and no amendment thereof shall be allowed, except for the purpose of incorporation of actual fact, and no amendment of a complete specification shall be allowed, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed or shown in the specification before the amendment, or that any claim of the specification as amended would not fall wholly within the scope of a claim of the specification before the amendment.

49 Available at: <https://indiankanoon.org/doc/108749286/>

50 2020 SCC OnLine Del 598.

of such patentee in exercise of its powers under the Competition Act, 2002. Apprising the legislative intent behind the Indian Patents Act, the court observed that the Patents Act is specifically designed to deal with matters concerning allegations of unreasonable conditions in licence agreements, abuse of one's status as a patentee *etc.* "While the Competition Act deals with these subjects generally, the Patents Act deals with these subjects specifically in the context of patents. The legislature, in its wisdom, after enacting the Competition Act, amended the Patents Act to introduce Chapter XVI and has chosen to keep the effect of the orders of the Controller in *personam*. It is not for this Court to comment on the propriety thereof, nor does this persuade us to permit exercise of powers by CCI contrary to legislative intent." The verdict that the Patents Act supersedes the Competition Act in matters related to allegations of unreasonable conditions in patent licence agreements, would certainly limit the intervention of the CCI in patent licensing disputes and the powers of the CCI to hear allegations against the monopolistic practices of the patentees.

V TRADEMARKS AND TRADE DRESS

Trademarks remain an active domain of IPR litigations in India. In 2023, various high courts in India pronounced crucial judgements regarding trademark infringement, rectification, registration, deceptive similarity, well-known marks, domain names, tradedress and cross border reputation. The ensuing part covers the most important decisions on trademarks.

Use of trademark as keywords

The High Court of Delhi in two significant cases, *viz., Google LLC v. DRS Logistics*⁵¹ and *Google LLC v. Makemytrip (India) Private Ltd.*,⁵² had to answer whether Google's ad-word programme allowing registration of trademarks by third parties as keywords/ search terms amounts to trademark infringement. It was held in the context of the given case, that keywords, unlike trademark, does not perform any source identifying functions and thus the use of trademarks as keywords without causing any confusion, dilution of the trade mark, is not infringement. The court further clarified that if the use does amount to 'use as a trademark' and an infringement, then the internet platform cannot claim protection as an intermediary under section 79 of the Information Technology Act, 2000 since it effectively sells these marks to the advertisers.

Transborder reputation

The survey year captures two important judgements from the High Court of Delhi on the trademark concept of transborder reputation. In *Toyota Jidosha Kabushiki Kaisha v. Tech Square Engineering Pvt.Ltd.*,⁵³ by holding that the petitioner company has completely failed to discharge the onus to show the reputation and goodwill of the mark 'ALPHARD' in India, the court emphasised a

51 2016:DHC:2599.

52 2023:DHC:5615-DB.

53 2023:DHC:8960-DB.

well settled proposition that the onus is on the applicant applying rectification to establish through evidence the trans-border reputation. Merely, the international usage of a trade mark (ALPHARD) by the petitioner company is not sufficient to prove the spill over of its transnational reputation in India. The order shows that rectification proceeding under the Trade Marks Act is altogether different from the passing off action or of opposition proceeding. Claim of transnational reputation requires corroboration on evidence and not mere assertions.

In *Bolt Technology Ou v. Ujoy Technology Pvt. Ltd.*,⁵⁴ the court while rejecting the passing off claims, made the following observations: “While technological advancements and precedents on the subject may have enabled us to do away with the requirement of a real market, the strength of transnational reputation acquired by a trademark would necessarily have to be established and tested on the metric of adequate evidence of substantial goodwill or reputation in the Indian market. The evidence led on this score clearly failed to adequately address the seminal test of a high level of familiarity with the mark amongst the concerned segment of our population - a pivotal factor when it comes to establishing cross border reputation.” Treating goodwill and reputation, in the context of transborder reputation, as distinct and separate claims, the court discerned thus:⁵⁵ “While determining and answering the question of whether there has been a spill-over of reputation and goodwill, the enquiry need not be confined to ascertaining the existence of a real market but the presence of the claimant through its mark within a particular territorial jurisdiction being sufficient. The presence of a mark in the market could well be established or proven on the basis of the extent of the promotion and advertisement of a well-known mark, the knowledge of the said mark amongst a sizable section of the concerned segment of the public and its reputation being found to have spilled over and be sufficiently grounded in the minds of consumers in India. A mere global reputation or asserted goodwill has neither been accorded a judicial imprimatur nor accepted as being sufficient by our courts to answer a claim of transborder reputation. In order to succeed on this score, it is imperative for the claimant to prove and establish the existence of a significant and substantial reputation and goodwill in the concerned territory. Unless a sizeable imprint of the presence of the mark is established amongst the consuming public, a claimant would not be entitled to protection. In fact, knowledge amongst a sizeable and noteworthy number of the concerned segment would be a *sine qua non* for proving reputation itself.”

Rights under sections 57 and 124 are independent rights

In *Anubhav Jain v. Satish Kumar Jain*,⁵⁶ it was held that the right to seek cancellation of a trade mark and rectification of the register under section 57 (to cancel or vary registration and to rectify the register) and section 124 (stay of proceedings where the validity of registration of the trade mark is questioned) of

54 Available at: <https://indiankanoon.org/doc/27487450/>.

55 Available at : <https://indiankanoon.org/doc/154832365/?type=print>.

56 *Id.*, paras, 112-113.

the Trade Marks Act are independent rights, which are both available for invocation by an interested party. Hence, the rights under section 57 to seek rectification of the register, is independent of the rights under section 124 which allows the defendant to seek remedy of rectification in an infringement proceedings. By refusing to accept certain authorities cited by the parties, the court also noted that a judgment of the Supreme Court (i) is to be read only as an authority for what it states, and not what may logically be seem to follow from it; and (ii) is not to be read as *Euclid's theorems*, but is to be understood in the background of the facts in which it was rendered.

The High Court of Delhi in *Dr. Reddy Labs v. Fast Cure Pharma*,⁵⁷ held the trademarks Razo and Razofast are identical and deceptively similar and hence presented a clear case of infringement and passing off. Relying on the judgement in *Girdhari Lal Gupta v. K. Gian Chand and Co.*,⁵⁸ the court further held thus: “A rectification petition could be instituted before any Court within whose jurisdiction the dynamic effect of the registration of the defendant’s trademark is felt. That would, however, be conditional on the petitioner establishing that it is in fact suffering the dynamic effect of the registration within such jurisdiction, either by actually accessing the impugned mark within such jurisdiction, or intending to do so, or, the impugned registration acting as an obstruction to the petitioner securing registration of its own mark. In each of these cases, the dynamic effect of the registration of the impugned mark would be felt by the petitioner and, therefore, the petitioner could institute the cancellation petition within the jurisdiction of the High Court within which he feels such effect.”

In *Fullstack Education v. INSEAD*,⁵⁹ the High Court of Delhi by setting aside the order of the single judge (INSEAD and INSAID are deceptively similar and hence merits cancellation of the impugned mark INSAID) held that a finding on rectification of a trade mark under section 57 needs to be conclusive and cannot be based on *prima facie* findings.

Scope of first sale doctrine

The Hershey Company v. Atul Jalan Trading As Akshat Online Traders,⁶⁰ addressed the allegations on trademark infringement including the acts of counterfeiting and resale of repackaged expired chocolates under the plaintiff’s trademarks, HERSHEY’S. The High Court of Delhi clarified that the ‘doctrine of first sale, applies only to the (i) resale of genuine, unaltered products, whose authenticity remains intact and does not confuse consumers about the origin of the goods and (ii) does not extend to goods that have been materially altered, as changes mislead the consumers and harm the plaintiff’s brand. Using trademark to deceive consumers about the product’s nature/quality is not within the ambit of the doctrine and such misrepresentation by the violators undermines the plaintiff’s

57 2023/DHC/000233.

58 C.O. (COMM.IPD-TM) 8/2023, pronounced on Sep. 4, 2023.

59 1977 SCC OnLine Del 146.

60 Available at: <https://indiankanoon.org/doc/117195986/>.

reputation, deceives consumers, and poses risks to public health. By citing the critical issues of public safety and health, the court directed the police to conduct an investigation into the resale of re-packaged expired chocolates under the Hershey's trademark.

Other notable trade mark decisions

In *Dabur India Ltd. v. Dhruv Rathee*,⁶¹ the High Court directed Dhruv Rathee, a YouTuber to remove the allegedly disparaging parts of his video in which he critiqued Dabur's 'Real' packaged fruit juice. Though the matter has been settled wherein Dhruv Rathee agreed to remove all 'Real' trademarks, copyrighted content, labels, packaging and advertisements from the contested video, it raises serious concerns about creative and pragmatic ways to navigate IPR issues such as copyright and trademark with constitutional rights of freedom of expression; and to harmonise and balance creativity, freedom of expression and informed consumer choice in the social media age.

In *Burger King v. Swapnil Patil*,⁶² which involved misuse of the domain names and logos, the High Court of Delhi restrained fraudulent websites from using 'BURGER KING' mark under its logos under the guise of issuing franchise.

In *Burger King Corporation v. Ranjan Gupta* the defendants failed to establish their claim that the trademark BURGER KING is generic or common to trade. By rejecting the defendant's claim, the court observed that the plaintiff has been using BURGER KING since 1954 and holds registrations for the said mark in over 122 countries including India.

In *Tata Sia Airlines Ltd. v. Union of India*⁶³ the court emphasised the formal procedure of publication and inclusion of the well-known mark in the register by following the procedure envisaged under the rules. Application under Rule 124 of the Trade Marks Rules, 2017 is mandatory for inclusion of a mark in the list of well-known trademarks even after declaration of a mark as well-known" by the court.

Hindustan Unilever Limited v. Reckitt Benckiser (India) Private Ltd.,⁶⁴ addressed the issue whether the impugned advertisements (Harpic v. Domex) of the defendant disparage the product of the plaintiff. While marking a clear distinction between acceptable puffery and actionable disparagement in comparative advertising, the High Court of Delhi observed that it is not necessary that an advertisement must expressly and clearly mention the competitor's product. It would be impermissible if the disparaged product is likely to be identified as competitor's brand.

In *TTK Prestige Ltd. v Arjun Ram*,⁶⁵ a matter involving multiple IPR issues - design piracy, passing off and infringement issues in design and trademark and

61 Available at : <https://indiankanoon.org/doc/138999616/>.

62 Available at: <https://indiankanoon.org/doc/77092668/>.

63 MANU/DEOR/314513/2023.

64 2023:DHC:3659.

65 2023 SCC OnLine Del 2133.

trade dress imitation, the High Court of Delhi granted interim injunction by holding passing off, by the defendants, of the plaintiff's product, by using a design which is nearly identical, a trade dress for the mark which is almost identical and overall appearance of the pressure cooker, including deceptively similar manner in which the mark is affixed on the product.

VI INDUSTRIAL DESIGNS

Indian design law is undergoing transformation with unprecedented judicial approaches and innovative judicial interpretations expanding the design law jurisprudence. The following part covers important judgements from the survey year which unfolds the nuances of design law in general and its technological interface in particular.

Design registrability of GUI

Registration of GUI in India under the Indian Designs Act, 2000 was the prime issue before the High Court of Calcutta in *UST Global (Singapore) Pte Ltd. v. The Controller of Patents and Designs*.⁶⁶ The Controller of Designs had rejected the application on the ground that the design having a novel surface ornamentation display, appearing as the touch screen (GUI) was incapable of being registered as a design under the Designs Act: The GUI was only visible when the product was in an ON mode and hence there was no design when the product was in the OFF mode. Thus, a GUI does not qualify to be treated as a design of an article. Moreover, the GUI does not follow any industrial manufacturing process but was created by a software development process. By setting aside the order of the Controller and remanding the matter back for fresh consideration the court observed thus:⁶⁷

The design submitted by the appellant is a 2D design i.e. a design which possesses the dimensions of length and width but does not possess depth. The novelty of the same can be judged by the eye as soon as the device is turned on. There is no requirement to touch the device in respect of the design. The process of application of the subject design i.e. GUI on the finished article is a mechanical and manual process which falls within the definition of 'industrial process' mentioned in section 2(d) of the Designs Act 2000. A software developer develops a source code which creates the GUI. This source code is then embedded in the micro-controllers and micro-processors and is displayed in screen by illuminating pixels by electronic means. Therefore, the design is applied to the article by industrial process and means.

Screen displays and icons are recognised in India by the Design Rules (Amendment) 2019. According to the court, the rejection of the application was incorrect in the light of class 32 which was newly added by way of 2021 Amendment to the Design Rules that

66 Available at: <https://indiankanoon.org/doc/120001851/>.

67 Available at: <https://indiankanoon.org/doc/44587046/>.

covers graphic symbols, graphic designs, logos, ornamentation and surface patterns. The court further observed: “The finding that the GUI is visible only in ON mode or operating mode and hence not capable of registration is erroneous. The GUI in the present case is in-built. In-built ICONS are displayed in shops as well as in advertisements. Designs registered may be applied to any external or internal feature and are capable of registration if they appeal to the eye and enhance the aesthetic value of the product. Ordinarily, the design of a product is concerned with the external appearance of an article. However, the pertinent feature of visual appeal may in the case of certain articles be considered as features of a registrable design.”⁶⁸

The judgement, being first of its kind would certainly expand the registrability of GUI’s in India under the Design Act. The judgement has the potential to transform the digital landscape in the country encouraging creativity of IT based companies in advanced digital interfaces and graphical components. It keeps pace with the ever evolving advancements in technology.

Visual appeal is the ultimate test

The High Court of Delhi in *Jayson Industries v. Crown Craft*,⁶⁹ observed that visual appeal is the ultimate test of a valid design. Minor variations do not make a substantial difference in the design. If the differences between prior art and the suit design are merely trade variants, the suit design cannot aspire either to novelty or to originality. Emphasising on the crucial elements of novelty and originality in designs, the court iterated that it is not permissible to make a mosaic of a number of prior documents for the purpose of attacking novelty. If the attack on novelty is to succeed, the design must be disclosed in the single prior document.

Lack of novelty or originality has to be seen on the date of registration

In *Casio Keisanki Kabushiki Kaisha D/B/A Casio Computer Co. Ltd. v. Riddhi Siddhi Retail Venture*⁷⁰ which considered the shape and configuration of musical keyboard, the High Court of Delhi upheld interim injunction against manufacturing and selling of ‘Blueberry Nexus32’ keyboard which had copied Casio’s keyboard design. Emphasizing the likeness and close resemblance of the designs, the court found the design of the defendant’s keyboard to be an obvious imitation of Casio’s design. “By conjoint operation of sections 22(3) and 19(1) of the Designs Act, lack of novelty or originality can constitute a ground of defence against an allegation of design piracy where the lack of novelty or originality can constitute a ground for cancellation of the registration granted to the design.”⁷¹ While addressing the issue of design cancellation, the court stressed that the lack of novelty or originality has to be ascertained on the date when the design was

⁶⁸ *Id.*, para 10.

⁶⁹ *Id.*, para 8.

⁷⁰ Available at: <https://indiankanoon.org/doc/155873398/>.

⁷¹ 2023/DHC/000886

granted registration. If a design, when granted registration, does not suffer from lack of novelty or originality, subsequently it cannot be invalidated solely because multiple producers decide to copy the said design post registration.

Piracy

In the *Raring Corporation v. Neogie Engineering Works Pvt. Ltd.*,⁷² in a design infringement claim, the High Court of Calcutta ruled that adoption by the of strikingly similar 'sonic nozzle design' *prima facie* amounts to infringement. The plaintiffs were owners of registered design pertaining to the sonic nozzle used in dust collection and suppression equipment and the defendant could not prove that the design was merely functional or prior published.

Imitating shape and configuration with insignificant trade variations is piracy of design. In *TTK Prestige Ltd. v. KCM Appliances Pvt. Ltd.*,⁷³ the defendant had borrowed the idea of the central depressed portion of the lid for collection and evaporation of froth, thereby resulting in spillage control, from the idea devised by the plaintiff. The container of the defendants' Impex Dripless Pressure Cooker was similar in shape to the container of the plaintiff's design. The shape of the lid of the pressure cooker forming subject matter of the suit design was also similar to the shape of the defendant's cooker. Barring superficial differences in shape, there is no substantial difference between the two lids. It was held that copying the depression in Prestige's pressure cooker amounts to *prima facie* design infringement.

VII PERSONALITY RIGHTS, CELEBRITY RIGHTS AND PUBLICITY RIGHTS

*Anil Kapoor v. Simply Life India*⁷⁴ decided by the High Court of Delhi addressed the issue of misuse of a personality's name and other elements of celebrity's persona. The suit was filed by the well-known Indian actor Anil Kapoor, seeking protection of his own name, image, likeness, persona, voice and various other attributes of his personality against misuse of all hues over the internet. According to the court, the plaintiff's name, likeness, image, persona, etc., deserves to be protected, not only for the plaintiff's own sake but also for the sake of his family and friends who would not like to see his image, name and other elements being misused, especially for tarnishing and negative use. While granting injunction, the court observed that the defendants are infringing his personality rights as well as right to privacy. If injunctions not granted in such cases, it would lead to irreparable loss/harm to the plaintiffs and their family, not only financially but also with their right to live with dignity. The court's observations are worth noting:⁷⁵

Fame can come with its own disadvantages. This case shows that reputation and fame can transcend into damaging various rights of a person including his right to livelihood, right to privacy, right to

⁷² *Id.*, para 36.

⁷³ Available at : <https://indiankanoon.org/doc/39358231/>.

⁷⁴ Available at : <https://indiankanoon.org/doc/2773745/>.

⁷⁵ MANU/DEOR/248558/2023.

live with dignity within a social structure, etc. There can be no doubt that free speech in respect of a well-known person is protected in the form of right to information, news, satire, parody that is authentic, and also genuine criticism. However, when the same crosses a line, and results in tarnishment, blackening or jeopardises the individual's personality, or attributes associated with the said individual, it would be illegal. There can be no justification for any unauthorised website or platform to mislead consumers into believing that they are permitted to collect fee by incorrectly portraying that they can bring the Plaintiff as a motivational speaker. Using a person's name, voice, dialogues, images in an illegal manner, that too for commercial purposes, cannot be permitted. The celebrity's right of endorsement would in fact be a major source of livelihood for the celebrity, which cannot be destroyed completely by permitting unlawful dissemination and sale of merchandise such as t-shirts, magnets, key chains, cups, stickers, masks, etc. bearing the face or attributes This is a digitally signed order.

The court while restraining more than fifteen defendants from utilising Anil Kapoor's name, likeness, image, voice, personality and other aspects of his persona for commercial gains, violating his rights, directed the defendants to immediately suspend the cybersquatted domainnames <http://www.anil Kapoor.in>, <http://www.anil Kapoor.net> and <http://www.anil Kapoor.com>.

It is to be also noted that the Department of Consumer Affairs, aiming to prevent and regulate the use of 'dark patterns' employed by online platforms, advertisers, and sellers and to protect consumers dark patterns, had notified Guidelines for Prevention and Regulation of Dark Patterns, 2023 in November 2023 under section 18 of the Consumer Protection Act, 2019 covering thirteen dark patterns - false urgency, basket sneaking, confirm shaming, forced action, subscription trap, interface interference, bait and switch, drip pricing, disguised advertisements and nagging, trick wording, SaaS billing and rogue malwares.⁷⁶ Dark patterns include practices on the internet that are deceptive in nature in order to mislead and trick the consumers, and subvert or impair their decision-making skills, which is violative of consumer rights. The pervasive use of dark patterns in the digital landscape has implications not only for consumer protection laws but also for IPR laws.

'Non- descendability' of publicity rights

Whether the right to privacy and the right to publicity are mirror images of one another? The High Court of Delhi in *Krishna Kishore Singh v. Sarla A Saraogi*⁷⁷ clarified that celebrity rights are merely a sub-species of personality rights. The constitutional scheme which guarantees equality as a cherished

⁷⁶ *Id.*, paras 38 to 40.

⁷⁷ Press Release by Ministry of Consumer Affairs, Food and Public Distribution. <https://pib.gov.in/PressReleasePage.aspx?PRID=2026257>.

preambular goal to individuals does not permit to recognize an *extrabundle* of rights which would be available for enjoyment only to celebrities. The law cannot allow itself to be a vehicle to promote celebrity culture. While rights which ensure because of the special personal achievements of individuals are to be sedulously protected and deserve recognition; rights which emanate from one's personality and persona, would be available to one and all, and not only to celebrities. While disposing of an interim injunction application filed by late actor Shushant Singh Rajput's father to restrain the defendant from using the name or likeness of the late actor, the court held that the right to publicity of the late actor extinguished with him. The right to privacy also extinguishes with the man.

VIII GEOGRAPHICAL INDICATIONS

Suits on geographical indications (GI) are not frequent in India being the very legislation on GI itself has been a post TRIPS development. The High Court of Madhya Pradesh in a notable judgement - *Scotch Whisky Association v. J.K. Enterprises*,⁷⁸ held that the registered proprietor of a GI can institute a suit against infringement of the GI without impleading an authorised user (AU).⁷⁹ The suit filed by Scotch Whisky Association against the use of 'London Pride' alleged infringement by associating J K Enterprises' whisky with Scotch Whisky. Deciding on the maintainability of the suit, the court held that the GI Act did not intend to restrict the right to institute a suit against infringement to both authorised user and the registered proprietor and rather it can be instituted by either of them. The court also observed that the interpretation of any provision of the Indian GI Act must be in tune with the objectives and commitments made under TRIPS by India at the international fora.

IX CONFIDENTIAL INFORMATION AND TRADE SECRETS

The survey year unfolds couple of decisions appertaining to confidential information. The High Court of Delhi granted an *ex parte* interim injunction in *Markets and Markets Research Pvt. Ltd. v. Meticulous Market Research Pvt. Ltd.*,⁸⁰ wherein the plaintiffs, who engaged in the business of quantified research and market intelligence by using confidential and proprietary research methodologies to generate market-specific reports for high-profile corporate and institutional clients, alleged copying of the format and contents of their confidential market research reports by the defendants and thus infringing their copyright. The defendants were restrained from advertising, selling, marketing, publishing *etc.* of the plaintiffs' impugned reports or any substantially similar table of contents. Though the order relies on the plaintiffs' assertion regarding the confidentiality of their data but does not provide any analysis for treating the same as confidential.

78 2023:DHC:4631.

79 2023 SCC Online MP 5352 : MANU/MP/3597/2023.

80 Any person claiming to be the producer of the goods in respect of a registered GI can apply for registering him as an authorised user of such GI. Only AUs are allowed to use the registered GIs.

Ecomax Solutions Pvt. Ltd. v. Energeo Building Solution LLP,⁸¹ encapsulated the boundaries of patent infringement, the importance of inventive step and the seriousness of protecting confidential information. The suit was ruled in favour of the defendant. According to the court, knowledge once learned cannot be unlearned as the confidential information of the plaintiff came into the possession of the defendant through the emails of the plaintiffs themselves. It highlights the importance of maintaining and enforcing the confidentiality by the plaintiff themselves.

The High Court of Bombay in *Rochem Separation Systems (India) Pvt. Ltd. v. Nirtech Private Limited*⁸² underscored the importance of specific details in examining confidentiality claims. A party must clearly describe the information over which it is claiming confidentiality without which, the allegations against the defendant cannot be examined. Other orders pertaining to protection of confidential information are *Henry Harvin India Education LLP v. Abhishek Sharma*⁸³ and *Epikindifi Software v. Edison Ramesh*,⁸⁴ both from the High Court of Delhi. In *Henry Harvin*, the court restrained the respondents who were previously been employed by the petitioner from infringing upon the petitioner's copyright in the content curated for their module. The court opined that there were significant similarities in the content, and thus the respondents' use of databases constituted violation of trade secrets. In *Epikindifi Software*, the court restrained the defendants from downloading, uploading, copying, replicating any sensitive personal information and confidential information of the plaintiff's customers.

X MISCELLANEOUS

Reasoned and speaking orders

Reasoned orders or speaking orders are essential component of natural justice and an important concept of administrative law in order to minimise arbitrariness of quasi-judicial authorities and to ensure fairness and to uphold right to judicial review. In a plethora of cases, the High Court of Delhi highlighted the importance of passing reasoned orders while criticising the quasi-judicial authorities for passing orders without engaging with the issues. The court has remanded several such matters back to the Registry for fresh consideration reiterating that non-speaking orders violate the principles of natural justice.

In *Dolby International AB v. The Assistant Controller of Patents and Designs*,⁸⁵ by recapitulating that reasoned orders are the most fundamental requisites of an adjudicating order, the court observed thus:⁸⁶ "The officer adjudicating the claim for registration of a patent must bear in mind the fact that the life of a patent is reckoned from the date when the application is made, and not

81 Available at: <https://indiankanoon.org/doc/196963261/>

82 2023 SCC OnLine Del 2059.

83 2023:BHC-OS:8770.

84 Available at: <https://indiankanoon.org/doc/197968313/>.

85 Available at: <https://indiankanoon.org/doc/91724615/>.

86 2023/DHC/001854.

from the date when the patent is granted. Unreasonable delay in grant of a patent results in reduction of the residual life of the patent, which can itself be a serious disinclination for inventors who seek to invent new and innovative methods, products or processes... Needless to say, the matter would not be decided by the officer who has passed the impugned order.”

Similar rulings in patent and trademark matters addressing the issue of lack of reasoning supporting the final decisions and court’s insistence on ‘reasoned and speaking orders’ include *Perkinelmer Health Sciences Inc. v. Controller of Patents*,⁸⁷ *Rosemount Inc. v. Deputy Controller of Patents*,⁸⁸ *Grupo Petrotex S.A. De C.V. v. Controller of Patents*,⁸⁹ *SK Geo Centric Co. Ltd. v. The Controller of Patents*⁹⁰ and *Shell Brands International AG v. The Registrar of Trade Marks*.⁹¹ As the court was not in a position to examine the impugned order on merits since it lacked supporting reasoning, emphasising due application of mind, the court had to send the matter back for fresh consideration, even in situations where nearly three-quarters of the twenty-year patent term have expired already.⁹²

Need to supervise and govern patent and trademark agents

In *Saurav Chaudhary v. Union of India*,⁹³ which highlighted the negligence of a patent agent resulting in abandonment of a patent application in India, the High Court of Delhi underscored the lack of a regulatory body for patent and trademark agents, and emphasised the need to supervise and govern them.

XI CONCLUSION

Year 2023 is remarkable for Indian IPR regime with landmark judicial, legislative and administrative initiatives. The survey year added significance to Indian IPR landscape by the following notable legislative and administrative developments though some may have counterproductive implications: (a) Making it the second high court after High Court of Delhi with a dedicated IP Division to adjudicate IP disputes, the High Court of Madras inaugurated its IP Division; (b) Patent Amendment Rules, 2023 were framed; (c) to curb film piracy, the Parliament passed Cinematograph (Amendment) Act, 2023; (d) Ministry of Information and Broadcasting devised an institutional mechanism of appointing non-judicial nodal officers to receive complaints relating to copyright infringement and instruct digital platforms to remove pirated content;⁹⁴ (e) Parliament passed Jan Vishwas Act, 2023 decriminalizing several offences under IPR statutes such as Copyright Act, the Patents Act, the Trade Marks Act and the Geographical Indications Act and

87 *Id.*, at paras 10 and 12.

88 Available at: <https://indiankanoon.org/doc/181472988/>.

89 2023:DHC:2981

90 2023:DHC:2999

91 C.A.(COMM.IPD-PAT) 241/2022.

92 2023:DHC:2955

93 *Blackberry Ltd. v. Assistant Controller of Patents and Designs*, C.A.(COMM.IPD-PAT) 301/2022, decided on Mar. 22, 2023.

94 W.P.(C)-IPD 9/2023, decided on Sep 1, 2023.

Biological Diversity (Amendment) Act, 2023;⁹⁵ (f) the Department of Biotechnology, Ministry of Science and Technology notified the ‘DBT Intellectual Property Guidelines’ to regulate ownership, transfer and commercialization of IP from DBT-funded (extra-mural and intra-mural) institutions;⁹⁶ (g) The Ministry of Consumer Affairs notified Guidelines for Prevention and Regulation of Dark Patterns, 2023⁹⁷ which have IPR implications; and (h) Central Government registered M/s CINEFIL Producers Performance Ltd. as a copyright society under section 33(3) of the Copyright Act, 1957.⁹⁸

From the judicial front, the survey year witnessed many seminal and unconventional decisions reflecting the steadfast commitment of the judiciary in redefining the IP legal terrain in an evolving digital era marked with rapid technological development. Dynamic+ injunctions have emerged up as a new judicial remedy in copyright infringement cases from *Universal City Studios LLC v. DotMovies.Baby*.⁹⁹ In *Raytheon Company v. Controller General of Patents and Designs*,¹⁰⁰ the High Court of Delhi held that innovation in the field of artificial intelligence, blockchain technologies and other digital products based on computer programs would not become non-patentable inventions merely because of that reason. The prior art document must comprehensively address the invention and mosaicking of prior arts is permitted only when a common thread links the claims with prior art apparent to a skilled person as held in *Guangdong Oppo Mobile Telecommunication Corp. Ltd. v. The Controller of Patent*.¹⁰¹ The court advised Indian Patent Office to adopt a “more comprehensive approach when assessing CRIs, taking into account technical effects and contributions provided by the invention rather than solely focusing on the implementation of algorithms and computer-executable instructions” in *Microsoft Technology Licensing v. Asst. Controller of Patents and Designs*.¹⁰² In a significant ruling in *UST Global (Singapore) Pte Ltd. v. The Controller of Patents and Designs*,¹⁰³ the High Court of Calcutta held any external or internal feature of an article having appeal to the eye is registrable under the Design Act. The court ruled further that GUI is capable

95 Available at: <https://mib.gov.in/sites/default/files/Nodal%20Officers%20for%20issues%20of%20notifications%20to%20intermediaries%20for%20removing%20internet%20links%20showing%20pirated%20films%20under%20the%20Cinematograph%20Act%201952%20-%20Accessible.pdf>.

96 Available at: <https://egazette.gov.in/WriteReadData/2023/247815.pdf>.

97 Available at: <https://dbtindia.gov.in/sites/default/files/uploadfiles/DBT%20IP%20Guidelines%202023%20final.pdf>

98 Available at: <https://consumeraffairs.nic.in/sites/default/files/file-uploads/latestnews/Draft%20Guidelines%20for%20Prevention%20and%20Regulation%20of%20Dark%20Patterns%202023.pdf>.

99 Available at: <https://www.cinefilindia.com/>.

100 *Supra* note 2.

101 *Supra* note 34.

102 *Supra* note 40.

103 *Supra* note 32.

of design registration in India. In *Scotch Whisky Association v. J.K. Enterprise*,¹⁰⁴ the High Court of Madhya Pradesh upheld the independent right of registered proprietor of a GI to institute infringement suit of GI without impleading AU. The survey year is thus remarkable in Indian IPR history as it also presented noteworthy decisions on confidential information and geographical indications which are otherwise less litigated IPR domains in India.

¹⁰⁴ *Supra* note 67.

¹⁰⁵ *Supra* note 77.