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# iprécis

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Dear Readers,

India has seen substantial growth in its intellectual property (IP) landscape in recent years. Indian IP authority, the Office of Controller General of Patents, Trademarks, Designs and GIs, granted 1,01,311 patents between March 15, 2023 to March 14, 2024, a significant increase from just around 6,000 patents a decade ago. The surge is also seen in patent filing, trademark registrations, and overall IP enforcement in the country and reflects India's commitment to protecting and fostering innovations.

As per statistics shared by the Ministry of Commerce & Industry, the fiscal year 2023-24 has seen various developments, including:

- Every 6 minutes one technology sought IP protection in India;
- Every working day, 250 patents were granted;
- A record-breaking number of copyright registrations, totalling to 36,378;
- The highest number of design registrations, totalling 27,819, alongside final disposal of 30,450 applications;
- The Trademarks Registry issuing examination reports within 30 days post receiving a trademark application.

In the litigation space as well, the recent past has seen several landmark judgments touching legal intricacies such as Standard Essential Patents (SEPs), patentability of inventions, infringement of personality rights, among others.

Cyril Amarchand Mangaldas, India's premier full-service law firm, has an industry leading and dedicated Intellectual Property Rights practice. Our class-leading practice specialists are always on top of the latest developments in the sector. It is in this light, we have launched **IPrécis** - a carefully curated quarterly roundup of significant events/cases in the IP sector in India.

We hope that you enjoy reading our newsletter as much as we have enjoyed preparing it and that you find it interesting, informative, and insightful. We sincerely look forward to receiving your feedback and comments at [cam.publications@cyrilshroff.com](mailto:cam.publications@cyrilshroff.com).

Regards,

CYRIL SHROFF

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# IP UPDATES

## 1. Federated Hermes Ltd. vs John Doe & Ors.

Federated Hermes Ltd. (**the Plaintiff**) sought to permanently restrain passing off through misuse of its trademarks by unknown persons (John Doe, i.e., **Defendant No. 1**) who were unauthorisedly using the trademarks to engage in fraudulent investment and stock-trading business activities. Through several WhatsApp groups such as “803 Federated Hermes”, “Federated Hermes – V87”, “Federated Hermes – VIP 02”, portals such as [www.fedhlive.com](http://www.fedhlive.com), [www.federatedhermes.w2app.me/](http://www.federatedhermes.w2app.me/), and mobile/web application “FHT” using Plaintiff’s name and logo, unknown persons were defrauding investors of significant amounts of money. Defendant No. 1 had been impersonating a Mr. Pankaj Tibrewal, an investment professional unconnected to Federated Hermes, as providing live stock market investing classes wherein they shared fraudulent investment information using Federated Hermes’ trademarks.

The Plaintiff came across several of Mr. Tibrewal’s social media posts on [www.twitter.com](http://www.twitter.com), which misused the Federated Hermes’ name/logo and created forged marketing material with the intention of misleading individual investors. The Plaintiff received a series of email communications from concerned investors indicating that WhatsApp groups could be accessed through links on other social media platforms. Within these groups, Defendant No. 1 was directing users to a counterfeit mobile app, FHT, providing “VIP accounts” claiming to have been given by Federated Hermes.

Several emails expressed concerns over the authenticity of these WhatsApp operations that declared the Plaintiff as registered with SEBI and RBI, and marketing material, using

Plaintiff’s name/logo, promising ten-fold returns. To have money deposited in the FHT app, users were required to take screenshots of the money transferred to a person claiming to be Mr. Tibrewal’s assistant. These payments were made to bank accounts that were switched frequently, and no demat account was assigned to the investor either. Additionally, despite Defendant No. 1’s FHT mobile app being delisted by Google Play Store, it continued to operated on links such as <https://federatedhermes.w2app.io/download>.

The Delhi High Court (**Delhi HC**) observed that the Plaintiff demonstrated a strong *prima facie* case, and if an *ex parte ad interim* injunction was not granted, it would suffer an irreparable loss. Balance of convenience also lay in its favour. Accordingly, it directed WhatsApp LLC (**Defendant No. 2**) to suspend/delete/block access to all infringing WhatsApp groups and registered accounts using those mobile phone numbers that were admins of these groups or were actively involved in perpetuating this fraud. They were further directed to disclose all particulars and details in their possession of the subscribers/users of the said accounts.

Bharti Airtel Limited and Vodafone Idea Limited (**Defendant Nos. 5 & 6**) were directed to disclose all particulars available with them, in respect to the subscribers corresponding to the aforementioned phone numbers. Saraswat Co-operative Bank Limited (**Defendant No. 7**) was directed to freeze Defendant No. 1’s bank account and disclose all particulars of account holders. The Delhi HC further ordered MeitY and DoT (**Defendant Nos. 3 & 4**) to issue necessary directions to telecom / internet service providers to block access to the websites hosted on the impugned domain names.

## 2. Sequoia Capital Operations LLC & Ors. vs John Doe & Ors.

Sequoia Capital Operations LLC (**Sequoia Capital**) alleged that **Defendant No. 1** was guilty of perpetrating fraud on the general public by creating a false association with Sequoia Capital. The Delhi High Court found that Defendant No. 1 was attracting unsuspecting customers using Sequoia Capital's registered trademarks, including "SEQUOIA" and "PEAK XV PARTNERS". The Court noted that the operators and group admins of WhatsApp and Telegram groups were not authorised to host a platform for offering financial trading. Such activities were considered illegitimate and fraudulent, intended to induce users to invest money, and had a bad impact on Sequoia Capital's standing.

The Delhi HC observed that Sequoia Capital had demonstrated a *prima facie* case, with the balance of convenience lying in its favour. The Court further noted that if *ex parte ad interim injunction* was not granted, Sequoia Capital would suffer an irreparable loss. Accordingly, the Delhi HC granted an *ex parte ad interim injunction* in favour of Sequoia Capital and restrained Defendant No. 1 from using the aforementioned marks.

## 3. Akshay Tanna vs John Doe & Ors.

The Plaintiff filed a suit against unknown persons, alleging violation of personality and publicity rights, dampening his reputation and goodwill. These unknown persons were alleged to have created social media groups, where they falsely claimed association with the Plaintiff. On these messaging platforms, these unknown persons misused the Plaintiff's reputation in the advisory sector by unauthorisedly impersonating and offering investment services to the public. A list of such social media profiles and links were identified in the application for urgent interim reliefs. The Plaintiff also submitted that he was contacted by investors intimating him of these social media profiles and messaging groups that falsely claimed association with him.

The Delhi High Court observed that the screenshots produced by the plaintiff clearly demonstrated that the defendants were fraudulently using the Plaintiff's identity and attempting to engage with the public on social media and messaging platforms. These unknown operators and groups were held to not be associated with the Plaintiff and were not authorised to offer investment related advice. The Court also held that they were misrepresenting to the public and eroding the Plaintiff's goodwill and reputation and, accordingly, granted an *ex parte ad interim injunction* in the Plaintiff's favour.

## 4. Bennett Coleman and Company Limited vs Timespro Consulting LLP & Ors.

The **Defendants** had been using the trademark "TIMESPRO" and device "TIMESPRO", which were similar to the "TIMES" formative marks used by the Plaintiff. The **Plaintiff** had registered the trademark "TIMESPRO" with the device "TIMESPRO" in 2013 and used the mark "TIMES" since 1838. It had obtained registration for this trademark across several goods and services and had acquired an extent of goodwill and reputation, particularly considering the volume of its annual revenue and promotional expenses.

The Defendants failed to submit their written statement within the statutory period of 120 days. They did not appear on multiple dates. The Delhi High Court passed an *ex parte* interim injunction order against the Defendants permanently injunctioning them and their affiliates from using trademarks similar to the those of the Plaintiff's trademarks TIMES, TIMESPRO, TIMES PROPERTY, and TIMES formative marks, pertaining to any services, goods, business, domain name, social media platforms, emails or in any other manner that would amount to infringement of the Plaintiff's registered trademarks.

## 5. JB Chemicals and Pharmaceutical vs Vaddaman Innovation LLP

The Plaintiff, an established pharmaceutical company with a robust presence in the market, has used the trademark "ZECUF" since 1987 for an ayurvedic syrup designed to alleviate allergic cough. The company possesses valid registrations for the mark and has presented substantial evidence of significant sales. It discovered that the defendant was using a similar mark, "ZECOF," for a similar product, leading to a likelihood of confusion among consumers. Consequently, the Court issued an *ex parte interim injunction*, restraining the Defendant from employing the mark "ZECOF" to avert potential damage to the Plaintiff's brand.

## 6. Khadi and Village Industries Commission vs Ayush Gupta & Ors.

The Plaintiff, Khadi and Village Industries Commission, a statutory body promoting textile development, has used the trademark "KHADI" since 1956 for various products including cosmetics, food items, and handcrafted goods. This trademark is well known and protected by regulations requiring certification for its use. Despite issuing cease-and-

desist notices, the Defendants, including M/s Bo International and M/s Tanisi Ayurveda, had continued to market products under deceptively similar marks, such as “KHADI EARTH”, intending to mislead consumers. Additionally, the Defendants registered domain names like “www.khadiearth.info” and “www.khadiearth.online” and actively sold products bearing the impugned marks. The Court, recognising the Plaintiff’s prima facie case and the potential for irreparable harm, granted an interim injunction restraining the Defendants from using marks similar to “KHADI” and ordering the suspension of the domain name “www.khadiearth.com”.

## 7. Puma SE vs IndiaMART Intermesh Limited

Puma’s contention rested on the assertion that upon entering the search term “PUMA” on the platform, consumers would encounter various counterfeit products bearing the trademark, which not only infringed upon Puma’s registered trademarks but also led to the passing off of these counterfeit goods as genuine Puma products. The Plaintiff argued that IndiaMART’s platform was being exploited to peddle these counterfeit goods, resulting in consumer deception and brand dilution.

The Delhi High Court held that inclusion of “Puma shoes” as an option in the dropdown menu, accessible to sellers during their registration process on the IndiaMART platform, constituted trademark use under Section 29, Trade Marks Act, 1999. Although this option was visible only to sellers and not to consumers browsing the website, the Court deemed its provision as facilitating trademark infringement. While acknowledging Section 79 of the Information Technology Act, 2000, which shields intermediaries from liability for third-party content, the Court found that IndiaMART failed to qualify for safe harbour protection. This was due to its role in aiding trademark infringement through its platform. Ultimately, the Court concluded that Puma had presented a *prima facie* case of trademark infringement against IndiaMART. As a result, the Court granted an injunction in Puma’s favour, restraining IndiaMART from continuing to facilitate the sale of counterfeit Puma products on its platform.

## 8. The Hershey Company vs Dilip Kumar Bacha

The main issue revolves around determining which High Court has jurisdiction to hear cancellation/rectification petitions under Section 57 of the Trade Marks Act (TM Act). The Delhi High Court began by analysing the case of Dr. Reddy’s Laboratories Ltd. vs Fast Cure Pharma, which established that applications under Sections 47 and 57,

124(1)(ii) of the TM Act can be filed not only in High Courts where the Trade Mark Registry offices that granted the impugned registrations are located, but also before the High Courts within whose jurisdiction the dynamic effect of the impugned registration is felt by the petitioner.

However, in this case, the Delhi High court disagreed with the approach taken in the Reddy Case, which relied on the Girdhari Lal Gupta decision concerning the Designs Act, 1911. It emphasised that trademark law significantly differs from designs and patents, as highlighted in the Bombay High Court’s Lupin vs Johnson case. Additionally, the undefined term “High Court” in the TM Act, unlike the Patents Act, raises concerns about legislative intent and jurisdictional scope. Criticising the application of the “dynamic effect” principle and the proposed unique framework for handling rectification petitions, the Court held that a larger bench should consider the applicability of Girdhari Lal Gupta in the context of the Trademarks Act, 1999, post the Tribunal Reforms Act, 2021.

## 9. Burberry Limited vs M/s Petrol Perfume & Ors.

The Plaintiff alleged that the Defendants adopted deceitful practices in manufacturing and selling perfumes with marks very similar to that of the Plaintiff. After considering the submissions of both the parties, the Delhi High Court noted that while at first glance the Defendant’s impugned marks seemed to be sufficiently distinct, the comparison of products on which such marks are used exhibit “complete dishonesty” on part of the Defendants. Even though the impugned marks were registered, the Defendants’ usage of these marks with regard to identical goods as the Plaintiff’s perfumes led the Court to form a *prima facie* opinion that adoption of the impugned trademarks did not appear to be in good faith, but rather suggested a deliberate attempt to exploit the reputation and goodwill associated with the Plaintiff’s marks. Therefore, the Court *prima facie* found that the actions of the Defendants exhibited a *mala fide* intent to leverage the established market presence of the Plaintiff’s products to their advantage and, accordingly, restrained them from using the impugned marks. Referring to *S. Syed Mohideen vs P. Sulochana Bai* [(2016) 2 SCC 683], the Court noted that while there may not be an action for infringement due to the Defendants’ registration of the marks, the Plaintiff could still seek an interim injunction for passing off.

## 10. Baxter International Inc. vs John Doe & Ors.

The Plaintiff alleged that Defendant no. 1 was “perpetrating fraud” on the public by creating a false association with the Plaintiff. The Plaintiff had six trademark registrations in India



and alleged that Defendant, through their websites, were advertising schemes to make an earning and were using the Plaintiff's mark for the same. To ascertain the veracity of such claims, the Plaintiff investigator invested a sum of INR 300 in these schemes but did not receive the guaranteed payment. Such fraudulent activities were damaging the character and repute of the Plaintiff's mark.

After evaluating the domain name being used, the Delhi High Court noted that Defendant no. 1 was taking advantage of the Plaintiff's standing in the market to induce consumers into investing money in their scheme and creating a sense of authenticity and association with the Plaintiff when none existed. These activities amount to infringement and passing off, as well as a copyright infringement because of the impugned domain name. The High Court granted an *ad interim ex parte* injunction against the Defendant no. 1, restraining them from using the Plaintiff's trademarks and communicating to the public the Plaintiff's cinematograph works as their own. Directions were also issued to other Defendants, like YouTube, WhatsApp, and the domain registrar, among others, to block/delete/take down the infringing content and suspend the impugned domain name.

#### 11. M/s P. M. Diesels P. Ltd. vs M/s Thukral Mechanical Works

This judgment settles a dispute dating back to 1985 and revolves around the trademark "FIELDMARSHAL" owned by M/s. Jain Industries, which was assigned to the Defendant. The Plaintiffs sought rectification of the mark being used by Defendant on the grounds that Jain Industries had falsely claimed ownership of the mark, which was registered without a genuine intention to use it, and that the use of said mark by the Defendant would lead to confusion among public in and within the trade.

The Delhi High Court ruled in favour of the Plaintiff, noting that prior use by the Plaintiff was a fact asserted by the Defendant themselves. Besides, the Defendant did not have documentation to prove prior use by Jain Industries. The High Court also noted the Defendant's misrepresentation and misconduct with respect to the insertion of the mark in original voices where it was not included. The High Court further stated that the Defendant's use of the said mark undoubtedly constituted passing off, because the mark was identical; the goods were identical, cognate, and allied; the customer class was identical; and the trade channels were identical. The High Court granted a permanent injunction in favour of the Plaintiff and ordered cancellation of the trademark assigned by Jain Industries to the Defendant.

#### 12. UTI Infrastructure Technology and Services Ltd. vs Extra Tech World & Ors.

The Plaintiff sought a permanent injunction and restraint order against the Defendants from infringing its copyrights and from engaging in acts of passing off in the marks subsisting in the Plaintiff's label by the defendant nos.1 to 4, in providing services relating to and in connection with the issuance of the Permanent Account Number (PAN) Card. The Plaintiff is authorised by the Income Tax Department for processing PAN card and PAN-related services.

The Bombay High Court noted that the Plaintiff's statutory rights were being infringed/violated and compromised by such dubious websites, and unknown persons were engaged in the fraudulent activity of imitating the applicant and its marks. The Court additionally stated that without a proper licence issued either by the applicant or the Income Tax Department, no person was entitled to benefit from its rights, which exclusively belonged to the Plaintiff. The Court

granted an *ad interim ex parte* order and injunction restraining the Defendants from infringing the Plaintiff's copyright "even without service, as it was impossible to track all the Defendants and effect service upon them". The Court also stated that the fake websites being active would cause irreparable damage and severe compromise the Plaintiff's valuable confidential data and pose a threat at the national level. The Court additionally ordered for the removal/takedown/deletion of unauthorised domains and websites, among other things.

### 13. Mother Dairy Fruit and Vegetable Pvt. Ltd. vs Moospring Dairy Farm Pvt. Ltd. & Anr.

The "Plaintiff" sought a permanent injunction restraining the Defendants from using the device mark or any other mark that was deceptively similar to the Plaintiff's mark. The Plaintiff, in operation since 1974, is a market leader in the branded milk segment, and they had adopted the impugned mark in 2017. The Plaintiff claimed copyright due to the unique distinctive elements in the SUPER-T trade dress.

The near-identical combination of orange and white colors in the packaging of both the parties, usage of the term "SUPER-T" and the placement of a cup and saucer were shown, among other things. The Delhi High Court was *prima facie* satisfied that the Plaintiff made a case for grant of *ex parte ad interim* injunction and that they were likely to suffer irreparable harm if the injunction was not granted. The High Court restrained the Defendants and all those acting on their behalf from using a trade dress identical or similar to that of the Plaintiff's mark.

### 4. Mr. Amrish Aggarwal Trading as M/s Mahalaxmi Product vs M/s Venus Home Appliances Pvt. Ltd. & Anr.

The primary issue framed by the Delhi High Court was whether the view expressed in *Sana Herbals Pvt. Ltd. vs. Mohsin Dehvi* that there is no requirement to stay a civil suit during the pendency of a rectification petition, even when initiated under Section 124 of the Trademarks Act should be sustained in light of Section 124(2). The issue arose from conflicting interpretations of the statutory provisions and the implications of the abolition of the Intellectual Property Appellate Board, IPAB. The High Court analysed Sections 124(1) and (2) of the Trademarks Act, 1999, and highlighted the statutory requirement for staying suit proceedings during the pendency of rectification actions. The High Court also referenced the Supreme Court's decision in *Patel Field Marshal Agencies*, equating a "tenable challenge" to a "triable issue" and emphasising the High Court's authority to

determine the validity of trademarks. The Court held that the aforementioned view in *Sana Herbals* case that it is not imperative to stay suit proceedings during the rectification petition pendency is incorrect and affirmed the necessity of staying suit proceedings until the final disposal of rectification proceedings. The High Court succinctly clarified the legal requirement for staying civil suit proceedings during the pendency of rectification petitions under the Trademarks Act, 1999, and emphasised the importance of avoiding conflicting decisions along with the need for a formal stay order to ensure procedural clarity.

### 15. Patent (Amendment) Rules, 2024

The Department for Promotion of Industry and Internal Trade (DPIIT) notified the Patent (Amendment) Rules 2024 on March 15, 2024, after taking stakeholder comments into consideration. These amendments are an impressive revamp of the Patent Rules and emphasise on simplifying processes for applicants and patentees, while expediting disposal.

The key highlights of the Patent (Amendment) Rules 2024 are as follows:

- ⌋ Form 3 to be submitted within three months from the date of issuance of FER, further extendable by three months.
- ⌋ Request for examination timeline reduced to 31 months from the earliest priority date.
- ⌋ Controller to first assess the maintainability of pre-grant oppositions.
- ⌋ Simplified Form 27 with objective response options for submission of working statement once every three financial year.
- ⌋ Possibility of extension of critical deadlines up to six months upon payment of additional fees. Summary of Patent (Amendment) Rule

For a detailed analysis please read here:

<https://www.cyrilshroff.com/wp-content/uploads/2024/03/Client-Alert-Patent-Amendment-Rules-2024.pdf> (Client-Alert-Patent-Amendment-Rules-2024.pdf (cyrilshroff.com))

### 16. Lava International Limited vs Telefonaktiebolaget LM Ericsson

In an extensive judgment, the Delhi High Court adjudicated in favour of Ericsson a patent infringement lawsuit concerning Standard Essential Patents (SEPs). The dispute was initiated

by Ericsson against Lava in respect of its eight patents integral to the standards for 2G, Edge, and 3G technology implementations. The Court examined numerous aspects in the judgment including patentability, exhaustion, the concept of standard essential patents, Fair, Reasonable, and Non-Discriminatory (**FRAND**) terms, damages, and costs. The Delhi High Court also directed Lava to pay INR 244 crore (approx. USD 29.9 million) along with 5 per cent annual interest to Ericsson for infringing upon its 2G and 3G patents. This ruling is considered one of the highest damages awarded in India for a patent infringement suit involving SEPs.

Some critical points discussed in the summary of the judgment are as follows: -

1. On the aspect of invalidity under Section 3(k), the Court emphasised that those inventions that focus solely on algorithms, mathematical methods, business methods, or computer programs are not patentable. However, an invention that integrates these elements to transform the functionality of a system or device can be patentable if it meets all other requirements for patentability. If the invention results in a further technical effect that transforms or enhances the functionality and effectiveness of a general-purpose computer, the invention should not be rejected as a computer program.
2. The Court revoked Ericsson’s patent IN’034, as the Court considered it not-patentable. The Court noted that the specific mention of a “search algorithm block” implied that the algorithm was an essential part of the encoder’s design and functionality in the said patent. The indications that the invention is about a physical device that uses an algorithm as part of its operation make it clear that the technical advancement of the invention relies on algorithms at the heart of the solution. Therefore, there is merit in the counter-claim of the Lava that IN’034 is liable to be revoked. as it conforms to non-patentable subject matter in terms of Section 3(k) of the Patents Act.
3. Regarding the ground of lack of novelty, the Court, taking into consideration various decisions, relied upon a “Seven Stambhas Approach”, as a guidance for determining novelty:
  - i. Understand the claims of the invention
  - ii. Identify relevant prior art
  - iii. Analyse prior art
  - iv. Determine explicit and implicit disclosures



- v. Assess material differences while considering the entire scope of the claims
- vi. Verify novelty in light of comprehensive scope and specific combination of claimed elements
- vii. Documentation of the analysis and novelty determination

Based on the analysis, if the invention or any of its claimed elements is found in the prior art, the invention is not novel. Conversely, if the invention is not disclosed by the prior art, it is considered novel.

4. The approach acknowledges that novelty encompasses not just explicit novelty but also implicit novelty within a text. This approach aims to provide a structured framework for assessing novelty, ensuring a clear distinction between novelty and non-obviousness.
5. In the evaluation of the inventive step, the Court acknowledged that various established tests have been recognised in both Indian and elsewhere. These tests include the “Obvious to try” approach, “Problem/ solution” approach, the “Could-Would” approach, and the “Teaching Suggestion Motivation” (TSM) test.
6. Both Lava and Ericsson presented arguments about the qualifications, independence, and expertise of expert witnesses. However, the Court rejected the contentions of both the parties, in which the credibility of witnesses had been challenged and considered the evidence presented by all the witnesses on merits.
  - a. Ericsson argued that Lava’s experts did not have the necessary expertise in the field involving suit patents.

- b. As per the Court, this submission fails, because it does not take into consideration that a person skilled in the art is a person who possesses average knowledge and ability in the relevant field of technology. The person skilled in the art need not be an expert in the specific field of the invention.
  - c. Lava also questioned the credibility of Ericsson's expert witnesses as being interested witnesses, being full-time employees of Ericsson. As per the Court, their evidence could not be disregarded only on the ground that they are employees of Ericsson. The evidence given by them has to be tested on merits.
7. As regards the ground of sufficiency of disclosure in respect of invalidity under Section 64(1)(f), expert evidence was presented by both parties, in respect of the question of sufficiency of the suit patents. The Court concluded that the suit patents when read with the complete specifications, sufficiently describe the inventions, when viewed from the standpoint of a person skilled in the art.
  8. The Court carried out a detailed analysis on the question of the validity of the eight suit patents. The first patent asserted by Ericsson, i.e., IN 203034, was found to be invalid and liable to be revoked on the grounds of both non-patentable subject matter and lack of novelty.
  9. The remaining seven suit patents, IN 203036, IN 234157, IN 203686, IN 213723, IN 229632, IN 240471, and IN 241747 were held to be valid, after examination on merits in respect of subject matter eligibility, novelty, and inventive step.
  10. On the aspect of declarations filed with the SSOs, the Court recognised that the purpose of giving declarations of essentiality is to bind patent owners to the FRAND commitment, ensuring that essential technology for maintaining interoperability is not withheld.
  11. As regards the issue of the essentiality of the suit patents, the Court recognised that the fundamental principle of patent law dictates that once a patent is granted for a specific function or implementation method, another patent cannot be granted for the identical function or method. The Court further held that Ericsson has established the essentiality of its suit patents through claim charts demonstrating alignment with the relevant standard, which had not been rebutted by Lava, thus proving the essentiality of the suit patents.
  12. Lava placed reliance on the Doctrine of Exhaustion, a principle in patent law that limits the rights of patent holders after the first authorised sale/import of a patented product, to claim immunity from patent infringement. The Court observed that a person claiming this particular benefit of the Doctrine of exhaustion, must provide clear and convincing evidence that the product was purchased in a legitimate manner, i.e., where the patented product was sold by or with the consent of the patent holder, thereby exhausting the patent holder's rights to control the product's further sale or use. The Court held that Lava's reliance on the Doctrine of Exhaustion was untenable because of the admitted position that Lava neither possessed any agreements or indemnities from component suppliers nor carried out any due diligence.
  13. As regards the question of infringement of SEPs, the Court recognised the application of the two-step test for establishing infringement of SEPs, which involves mapping the suit patent(s) to the standards and showing that the implementer's device also maps to the standard. Consequently, on account of compliance of Lava's devices with the standards, infringement of the suit patents has been held to be an inevitable outcome.
  14. On account of the Test Reports placed on record by Ericsson showing compliance of Lava's devices with the optional standards, the onus fell on Lava to not just claim the use of alternate technology, but also demonstrate the same, which it has failed to do.
  15. With respect to FRAND, the Court observed that it represents a voluntary commitment by an SEP owner to an SSO, in which the SEP owner agrees to adhere to the SSO's IPR Policy and make standardised technologies available on FRAND terms to willing licensees. The essence of a FRAND license is that it be fair in its treatment of both parties, reasonable in its economic demands, and non-discriminatory in its application across different licensees. The FRAND protocol was established to balance equities and the legitimate interests of both the patent owner and the licensee, ensuring that neither party has unjust bargaining power in negotiations.
  16. The Court highlighted the necessity of negotiating FRAND rates in good faith, while holding that since SSOs do not assess patent validity or essentiality, alleged infringers have a right to challenge patents during or even after negotiations. At the same time, patent owners can seek legal remedies, including damages for past use, if infringers fail to respond in good faith to a FRAND offer.
  17. Court considered Lava an **unwilling Licensee** due to its failure to negotiate with Ericsson in good faith, consistently delaying licensing negotiations, and failing



to respond to offers or present any counteroffer. Additionally, Lava's lack of response to the Court's specific query on willingness to accept the same royalty rates as Micromax, further demonstrated its unwillingness to engage constructively in the licensing process.

18. As regards damages, the Court recognised that Ericsson was entitled to receive the **damages calculated based on the loss of royalty/license fees** it would have received had Lava executed a FRAND license agreement at the commencement of its business operations. This approach aligns with legal precedents and ensures that the patent owner is compensated for the royalties they would have earned through licensing.
19. The Court also held that standard-compliant nature of the devices indicates that they implement the SEPs; therefore, damages were payable for all devices that comply with the relevant standards, not just the tested devices.
20. As regards Lava's contention that royalty should be calculated on the value of the chipset, the Court held that in mobile devices, where telecommunication network connectivity is the core functionality, the **calculation of royalties at the end-product level is the most appropriate approach**, aligning with industry practices, economic efficiency, and legal precedents.
21. As regards Lava's contention that royalty should be payable only for the eight suits patents and not the portfolio of SEPs, the Court held that licensing of the entire portfolio of SEPs is essential for ensuring interoperability in the telecommunications industry. The Court considered it **justified and balanced to require implementers to license the entire SEP portfolio**, as this approach facilitates smooth technological progression and upholds principles of fairness and proportionality. Further, the approach of licensing individual patents from a portfolio was held to be impractical due to potential administrative burdens, increased transaction costs, and legal complexities.
22. In assessing damages, **the Comparable Licensing approach** were recognised as the preferred method for determining FRAND royalty rates. This approach relies on FRAND rates negotiated between parties in similar circumstances, making it a reliable benchmark for determining royalties for a prospective licensee.
23. As regards the top-down approach advocated by Lava, the Court held that Lava had not provided requisite evidence/calculations to justify adopting a top-down

approach for licensing. Additionally, the Court also noted that Lava had admitted that it had not entered into any license agreements or paid any royalties in respect of the SEPs, further weakening its case for the adoption of the top-down methodology.

24. The Court noted that Lava has been unable to prove its allegations of royalty stacking and hold-up in its licensing negotiations with Ericsson. The necessity to provide concrete evidence of the licensor demanding higher royalty rates post-adoption of the standard to support such allegations was emphasised. No evidence of hold-up was presented, and Ericsson had made multiple offers over four years without receiving a counter-offer from Lava, indicating no occurrence of hold-up.
25. Based on the negotiation history, the Court held that Lava's approach to the licensing negotiations was characterised as a deliberate strategy of hold-out, where the implementer delays or avoids reaching an agreement. Such hold-out strategies result in the continuous use of patented technology without paying appropriate royalties, providing implementers with undue advantages and challenging the integrity of the FRAND framework.
26. The licensing agreements filed by Ericsson in sealed cover were adjudged to be comparable license agreements. The Court held that these agreements were made with entities similarly placed to Lava and nearly identical license rates were offered to Lava. These comparisons, combined with the fact that the rates offered to Lava were consistent with those accepted by other similarly situated entities, led the Court to conclude that the **rates offered by Ericsson to Lava fall within the FRAND range**.
27. On the aspect of limitation, the Court held that damages could be claimed from the date of publication of the patent application as the rights of the patentee originate from the date of publication. However, a suit for infringement could only be filed after the grant of the patent. Consequently, it was held that the period of limitation prescribed as per the Limitation Act would not be applicable, on account of *generalia specialibus non derogant*, i.e., special law would prevail over general law. Lava's attempt to benefit from Section 111 of the Patents Act, which limits damages if the defendant was unaware of the patent, was rejected by Court, as it observed that Ericsson had informed Lava of its infringing activities on November 1, 2011.



28. For calculation of damages and determination of FRAND rate, Ericsson's November 2015 offer to Lava, which was similar to that offered to another similarly situated entity was held to be the appropriate comparable license.
29. On account of the revocation of one out of eight suit patents, the royalty rates for the portfolio of patents for which license is required were adjusted by Court to reflect the actual strength of the portfolio. As a result, the Court determined the FRAND royalty rate applicable to Lava to be 1.05 per cent of the net selling price of the devices sold by Lava. The period for which royalties are payable was determined to be from November 1, 2011, to May 8, 2020.
30. Decree was passed in favour of Ericsson for the recovery of damages amounting to INR 244,07,63,990 (Two hundred forty-four crores seven lakhs sixty-three thousand nine hundred and ninety rupees only), along with interest at 5 per cent per annum from the date of judgment until the full realisation of the said amount. Actual costs were also awarded in favour of Ericsson.
31. Court also issued directions to the office of the CGPDTM to issue Certificate(s) of Validity of the seven suit patents found to be valid, i.e., IN 203036, IN 234157, IN 203686, IN 213723, IN 229632, IN 240471, and IN 241747.

### **17. The Regents of the University of California vs Controller General of Patents**

The Appellant filed an appeal under Section 117A of the Patents Act, 1970, against an order by the Assistant Controller of Patents and Designs rejecting patent application no.10336/DELNP/2013 under Sections 15 and 59(1) (refusal of amendment of claims) of the Patents Act. The Delhi High Court noted that amendment to an original application could only be through a disclaimer, correction, or explanation. Such amendments are to be tested on the following parameters: (a) whether it serves the purposes of incorporation of actual facts; (b) whether the effect of amendment allows matter not in substance, disclosed originally or shown in specification; and (c) whether the amended claims fall within the scope of original claims of the specification.

In this case, the appellant had filed an international application no. PCT/US2012/040455 titled "Blockade of Inflammatory Proteases with Theta Defensins". Upon objections of lack of inventive step and novelty, the Appellant amended the claims. Before the Delhi High Court, the primary issue was whether these amendments were in compliance with Section 59(1) of the Patents Act. The Court noted that the amendments<sup>1</sup> were only by way of an explanation to the original claims to incorporate actual facts and did not disclose anything not originally disclosed in the claims of

<sup>1</sup> The application was pertaining to "Blockade of Inflammatory Proteases with Theta Defensins". A total of 33 claims were made. The original version of Claim I read as "a method of marketing a drug composition, wherein the drug composition includes a 0-defensin, analog or derivative thereof, the method comprising: determining efficacy of the drug composition with respect to an anti-inflammatory effect in a human; and providing the drug composition to a marketplace to treat a chronic inflammatory condition.". The first amendment replaced "marketing" with "testing" and added several technical specifications to the method. The second amendment re-changed "testing" to "marketing" and added a caveat stating that the method of marketing does not comprise of any steps related with transactions of goods and services and wherein said method is restricted to evaluating synthetic cyclic tetradecapeptide mini-0-defensins for their potential to treat chronic inflammatory condition.

specification filed before the amendment. Therefore, the impugned order was set aside and the appeal was allowed. The Court remanded the matter to the patent office for *de novo* consideration.

### 18. ArthroGen GmbH vs Controller General of Patents, Designs & Trademarks

The Appellant filed an appeal against an order rejecting the invention as non-patentable under Sections 3(j) and 3(i) of the Patents Act. The invention pertained to, “a method of producing a protein enriched blood serum comprising of steps (a) collecting a blood serum; (b) mixing the blood serum and gold particles in a container; (c) incubating the blood serum and gold particles to produce protein-enriched body fluid serum; and (d) removing the gold particles from the protein enriched blood serum.” The Controller of Patents initially raised objections during the first examination report citing Sections 3(c), 3(d), 3(e), 3(f), and 3(j). The subsequent hearing notice also raised objections under Sections 2(1)(j), 3(i), and 3(b).

The Appellant submitted that Section 3(j) was not included as a ground for objection in the hearing notice. The Delhi High Court noted that the Appellant was not afforded an opportunity to contest the grounds under Section 3(j) of the Act and hence, there was an evident violation of principles of natural justice. Further, in relation to Section 3(i) (processes related to medical treatment for humans or animals, including diagnosis, therapy, or disease prevention), the Court noted that the controller did not accurately consider the distinction between a method of treatment and a method of producing a novel substance. The Court set aside the impugned order and remanded the matter to the patent office for *de novo* consideration.

### 19. Microsoft Technology Licensing LLC vs Asst. Controller of Patents

The Appellant filed a patent application for an invention titled “Discovery of Secure Network Enclaves”. This invention describes “a method of securing communications through operation of a computer system that encompasses plurality of host devices interconnected by a network, that are organized into enclaves”. Upon hearing, the claims were objected due to lack of inventiveness under Section 2(1)(ja), and claim 2 was objected as being indefinite under Section 10(4). The Delhi High Court noted that it is the onus of the controller to detail how the stipulations of Section 10(4) are being contravened. In this case, the absence of critical

analysis behind the objections rendered the impugned order deficient in legal substantiation.

In relation to the violations relating to lack of inventiveness, the Delhi High Court noted several procedural infirmities. Firstly, the prior art, D2, that was cited in the order rejecting the application was absent in the hearing notice, which, in turn, undermined the fairness and integrity of the examination process. Secondly, the objections raised relating to D1 and D2 were derived from the search opinion and examination report issued by the EPO, where the EPO subsequently granted the patent upon amendments. The Delhi HC was of the opinion that the Indian Patent Office did not duly consider the proceedings before the EPO. Accordingly, the Court allowed the present appeal petition and directed the respondent (Controller of Patents) to consider the matter afresh.

### 20. Eli Lilly and Company Private Limited vs Eskayef Pharmaceuticals Limited & Ors.

This case pertains to the infringement of Plaintiff’s Indian patent no. 297760, titled “Protein Kinase Inhibitors” (**suit patent**). The Plaintiff is a leading corporation engaged in the business of pharmaceutical products. The described protein kinase inhibitors are used in the treatment of cell proliferative diseases like cancer, and the claims covered the Drug product, Abemaciclib. The Plaintiff came to know that Defendant no. 1 was producing a generic version of Abemaciclib under the brand name Abeclib. The drug was listed on its website and other e-commerce websites.

The Plaintiff established that as per the documents pertaining to the suit patent, the chemical compound Abemaciclib was covered by the claims of the suit patent. There were no pre-grant or post-grant oppositions or revocation proceedings filed and/or pending against said suit patent. The suit patent was valid until December 15, 2029, and, despite that, the Defendants had launched a generic version of Abemaciclib. Additionally, the Plaintiff also alleged that the impugned drug had not been granted any regulatory approvals in India and was being imported from Bangladesh. The Delhi High Court held that the Defendants were *prima facie* infringing the Plaintiff’s statutory rights in the suit patent and bypassing the regulatory mechanism for pharmaceuticals products in India. The Court passed an *ex parte ad interim* injunction order against the Defendants. The Court also directed IndiaMART to delist and permanently remove the links/advertisements on its platform relating to the product “Abeclib”, which is manufactured by Eskayef Pharmaceuticals Limited.

## 21. SNPC Machines Private Limited & Ors. vs Mr. Vishal Choudhary

SNPC Machines Private Limited (**Plaintiff No. 1**) is the pioneer in revolutionising the brick-making industries by switching from the traditional manual process to an automated brick-making machine, which is claimed to be the world's first patented fully automated and mobile brick-making machine. The Plaintiffs alleged that the Defendant was manufacturing and selling machines similar to their machines. Accordingly, the Plaintiffs filed an application for seeking permanent injunction against the Defendant from manufacturing, using, selling, and importing brick-making machines protected under the Plaintiff's patent nos. 353483, 359114, 374814, and 385845 or other similar products.

The Defendant claimed differences on four accounts: (a) no steering, (b) no steered front wheels, (c) rear wheels not driven by motor, and (d) lack of a cabin that was integrated to the assembly and used as an operating and controlling place. The Delhi High Court noted that these four differences were part of a fundamental issue pertaining to the mobility and a mechanism to ensure the same. While on the one hand, there was an integrated cabin, on the other, the machine was required to be hooked up to a mobile vehicle. The Court instead considered the pith and marrow of the invention, which was to ensure brickmaking through mobility. The only difference was in relation to the Defendant severing the aspect of mobility for users to use their own vehicles, while the Plaintiffs' model had an integrated mobility. Hence, there were no fundamental changes as the innovation was same, i.e., to ensure continuous brick laying in an organised sequence. Accordingly, the Court granted an injunction in the Plaintiffs' favour.

## 22. Haryana Pesticides Manufacturers Association vs Assistant Controller of Patents and Design

The Petitioner filed a petition seeking to quash an order passed by the Assistant Controller of Patents and Designs in pre-grant opposition against an application for a patent titled "Weedicidal Formulation and method of manufacture thereof". The Petitioner, an association of pesticide manufacturers in Haryana, challenged the patent application by Crystal Crop Protection Limited. The dispute arose due to alleged failures in communication regarding the opposition hearings. While the Petitioner claimed to have updated their email address with the patent office in 2017, the Respondent continued to send notices to the old email address.

The Court delved into the sequence of events, emphasising the Petitioner's failure to update their email address with



the Patent Office since 2017, despite professional representation by a registered patent agent and an advocate. It highlighted the Petitioner's passive approach, waiting for notices rather than proactively ensuring their new email address was recorded. Furthermore, the Court discussed Form 30, which facilitates communication of address updates, and assessed whether the Petitioner had complied with proper procedures in this respect.

Despite arguments about the availability of post-grant opposition as an alternative remedy and adherence to principles of natural justice, the Court dismissed the petition. It concluded that the Petitioner had not taken sufficient steps to ensure proper communication and address update. The Court advised the Petitioner to pursue post-grant opposition if desired but refrained from commenting on the merits of the opposition to the patent.

## 23. GSP Crop Science Pvt Ltd vs Devender Kumar

This case involves the infringement of Indian Patent No. 384184 for a liquid composition of Pendimethalin and Metribuzin, for which GSP Crop Science Pvt. Ltd. (**Plaintiff**), a prominent player in the agrochemical industry, had secured the patent in December 2021. The patented product aimed to provide an innovative combination of active ingredients with enhanced efficacy and stability. The Plaintiff, having commercialised the product since 2020, discovered that the Defendant had launched a similar product called "Pendamic" in November 2023, which allegedly infringed upon their patent. Upon examining samples of the Defendant's product, the Plaintiff found a clear match between the ingredients listed on the label and the claims of their patent.

The Plaintiff's infringement analysis revealed several points of overlap between the Defendant's product and the

patented composition, such as the presence of Pendimethalin and Metribuzin within specified ranges, as well as the formulation being in the form of a suspension. Additionally, the Defendant had obtained a registration under Section 9(4) of the Insecticides Act, 1968, commonly known as a “me-too” registration, indicating awareness of the Plaintiff’s patented product.

The Court, after considering the Plaintiff’s arguments and evidence, found that the Plaintiff had established a strong *prima facie* case of infringement. The Defendant’s product, launched in 2023, was deemed to have infringed upon the Plaintiff’s patent, as evident from the overlap between the Defendant’s product and the patent claims. Moreover, the Court noted that failure to restrain the Defendant from selling the infringing products could cause harm and damage to the Plaintiff. Consequently, an *ex parte* ad interim injunction was granted in favour of the Plaintiff, restraining the Defendant from dealing in any infringing product until the next hearing.

#### 24. Optimus Drugs Private Limited vs Union of India

The Petitioner challenged a hearing notice dated August 9, 2023, and sought a fresh Opposition Board for post-grant opposition proceedings related to Patent No. 281489. The Petitioner filed an application in April 2016 for a patent titled “An improved process for the preparation of Linezolid”, granted on March 20, 2017. Post-grant opposition was filed by a competitor on March 6, 2018, along with evidence. The Petitioner did not submit evidence with the reply statement, but the competitor submitted additional evidence with a rejoinder in August 2018. The Opposition Board submitted recommendations on May 17, 2019. Subsequently, the Petitioner filed further evidence in June 2020, and the fourth Respondent filed additional evidence in March 2021. The Petitioner also filed a request for amendment of claims on February 03, 2023, notified in the Patent Office Journal on July 11, 2023, followed by the impugned hearing notice dated August 9, 2023. The Petitioner contended that the Opposition Board should issue fresh recommendations considering all evidence, including the amended claims.

The Court noted that both parties submitted evidence post the recommendations of the Opposition Board and held that it would be unjust to base a decision solely on earlier recommendations. Therefore, the Opposition Board should be reconstituted to consider all evidence. The Court also highlighted the need for expedited proceedings due to concerns that the Petitioner’s actions might aim to delay or disrupt the opposition proceedings. As a result, the Court directed the second Respondent to constitute a fresh

Opposition Board comprising different officers from the previous one.

#### 25. Vifor International vs MSN Laboratories Pvt. Ltd.

The patent of the Appellants was an invention used for intravenous treatment of iron deficiency and iron deficiency anaemia when oral iron preparations are rendered ineffective. The patent is principally a product claim and which can also be acknowledged as being a product-by-process claim. A single-judge bench of the Delhi High Court had in its order refused an injunction for patent infringement stating that the product claimed was limited by the process by which it was claimed. The High Court further stated that infringement would only happen if the Defendants created ferric carboxymaltose using the same process. Since all the Defendants were using processes different from that of the Appellants, an injunction was denied.

In this judgment, the Division Bench of the Delhi High Court ruled that the product-by-process claim under the Patents Act would necessarily have to be examined on the anvil of a “new and unobvious product”, irrespective of the applicant having chosen to describe the invention by referring to a process of manufacture. The Court noted that merely using process terms could not be termed to be limited to accept the drawn distinction between validity and infringement. Additionally, the Division Bench noted that “*as long as a product-by-process claim pertains to a product which is novel and has no parallel in the prior art, the mere fact that the patentee chooses to describe the invention more exhaustively by reference to process terms, the tests should remain unchanged.*”

For a detailed analysis please read here:

<https://www.cyrilshroff.com/wp-content/uploads/2024/02/Client-Alert-Vifor-Judgment-0802.pdf> (Client-Alert-Vifor-Judgment-0802.pdf (cyrilshroff.com))

#### 26. F. Hoffmann-La Roche & Anr. vs Zydus Lifesciences Ltd

**February 23, 2024**

Interim relief was sought in the infringement suit by the Plaintiffs. The suit pertained to the infringement of two patents regarding a monoclonal antibody biologic used to inhibit tumour growth. Both patents are related to Pertuzumab. The Plaintiffs, in the month of February 2024, came across recommendations of the Subject Expert Committee (Oncology) of the Central Drugs Standard Control Organization, which disclosed that the Defendants had applied for the grant of permission to manufacture new drug

formulation for the sale/distribution of Pertuzumab. After considering the submissions made by both sides, the Delhi High Court firstly noted that there is no Indian case law directly addressing the specific issue at hand. On examining the answers to certain queries raised by the High Court, it is determined that absence of claim mapping substantially restricted the Court from fully assessing the infringement allegations, and directed the Plaintiffs to carry out the claim mapping. The Defendant was also permitted to do the same. To determine the allegations of process infringement, the High Court intended to invoke Section 104A of the Patents Act, 1970. The High Court directed the Defendant to reveal the process employed by them to develop the formulation in a sealed envelope, to ensure preservation of sensitive information. The High Court will subsequently also assess the need for establishing a confidentiality club to manage the disclosed information, to ensure that access to such information is appropriately controlled and limited to authorised individuals. Both parties were directed to disclose the name and credentials of their respective experts in the field of biologic pharmaceuticals and related intellectual property issues. The High Court further stated that it would consider appointing an independent Scientific Advisor.

#### **March 13, 2024**

The Plaintiff's counsel clarified the intent behind the instant application seeking constitution of a confidentiality club was to preserve timelines for an expeditious decision on the interim application. The High Court directed the Defendant to file objections, if any, to the individuals as well as their own list of proposed members. Further deliberations on the matter will take place on the next scheduled hearing.

### **27. Baxalta Incorporated vs the Controller of Patents**

The Appellant's patent application was refused under Section 15 of the Patents Act, 1970, on the ground of lack of novelty and inventive steps under Sections 2(1)(j) and 2(1)(ja) of the Patent Act, 1970, respectively. The Appellant filed an instant application, seeking leave of the Delhi High Court to submit an auxiliary claim set as an additional document, to restrict the scope of claims. The application was allowed by the High Court along with directions to the Respondent to look into the auxiliary claim set, uninfluenced by any observation made in the impugned order, for the purpose of taking a final view regarding the patentability of the invention.

### **28. Alimentary Health Limited vs Controller of Patents and Design**

The main issue in this case is the refusal of the subject patent application, which involves a formulation of the probiotic bacterium *Bifidobacterium longum* designated as NCIMB 41676 (Ah1714), under Section 15 of the Patent Act, 1970, based on the lack of inventive step. The subject patent application claimed a formulation using the *Bifidobacterium longum* strain at concentrations exceeding  $10^6$  colony-forming units per gram, combined with an ingestible carrier. The claims were amended and limited to 13 claims from the original set of 38 claims. The Controller denied the application citing Sections 3(c) and 3(d) of the Patent Act, 1970, stating that the strain and its use in the composition of probiotics were known in the prior art. The Appellant argued that the formulation involving *Bifidobacterium longum* (NCIMB 41676) was unique due to its distinct immunomodulatory effects, setting it apart from the prior art. The Appellant also claimed that the strain provided significant therapeutic advancements over the prior art, particularly in terms of cytokine modulation and gastrointestinal health benefits. Taking note of the arguments propelled by both parties, the Delhi High Court overturned the Controller's decision to deny the patent and emphasised the need for a detailed comparative analysis of existing knowledge and the claimed invention when assessing inventive step. The High Court found inadequacies in the Controller's order, necessitating a fresh examination. The Court also highlighted the importance of avoiding hindsight bias in assessing inventive step and noted that the invention represented a non-obvious leap in probiotic science.

### **29. Priya Randolph vs Deputy Controller of Patent and Design**

The Madras High Court set aside a refusal order passed by the Deputy Controller of Patents and Designs in appeal proceedings. The Court held that mere involvement of a business method in an invention does not render it unpatentable under Section 3(k) of the Indian Patents Act, 1970. The High Court examined the subject matter under the appeal and CRI Guidelines with respect to business method. The High Court construed from the CRI Guidelines that merely because claims are related to e-commerce in some way, does not automatically categorise the invention as business method. The claimed invention, in substance, is required to be a business method for exclusion from

patentability under Section 3(k). It was held that the nature and the essence of the invention is pivotal in such cases. It was noted by the High Court that the claims are aimed at solving the aforesaid technical problem by employing the components as claimed in Claim 1, that is, software, hardware, and firmware. It was concluded that the invention provides technical contribution to improve data privacy and cannot be held as being merely a business method. Consequently, the impugned refusal order was set aside and remanded for reconsideration.

For detailed discussion, you may refer to the cam blog: “Scope of business method inventions under Section 3(k)” (Scope of business method inventions under Section 3(k) | India Corporate Law (cyrilamarchandblogs.com))

### 30. University Health Network vs Adiuvo Diagnostics Pvt. Ltd.

Adiuvo Diagnostics Private Limited (**Writ Petitioner**), a Chennai-based company has patented its technology (Patent IN323440). University Health Network (**Respondent**) filed a patent application before the Delhi patent office (9067/DELNP/2010) against which a “pre-grant opposition” was filed by the Writ Petitioner claiming “*lack of novelty, lack of inventive step, non-patentable subject matter and insufficient disclosure*”. Although the application was filed by the Respondent at the Delhi Patent Office, and it was the “appropriate office” as per Rule 4 of the Patent Rules, it was allotted for examination to Ms. Mahalakshmi Balasubramaniam, Controller of Patents, Chennai. The Controller, therefore, conducted the enquiry from Chennai, including conducting, physical hearings in Chennai on various dates.

The Madras High Court held that irrespective of the “appropriate office”, the High Court would have territorial jurisdiction for maintaining a writ if part of the cause of action arose within its jurisdiction. Firstly, the cause of action arose in Chennai because if the Appellant is granted the patent, then the Petitioner’s business, considering the patents he holds, would be affected. Secondly, the Petitioner is a patent-holder with a patent in Chennai, which is a major reason for the Writ Petitioner in Chennai to oppose the grant of impugned patent via the writ petition. Lastly, on considering the geographical area in which the rights of the

parties play out, Chennai stands in a better footing than Delhi.

For detailed discussion, you may refer to cam blog “Cause of action for a Writ Petition in Patent Suit stands independent of ‘Appropriate Patent Office’ Determination under Patent Rules” (Cause of action for a Writ Petition in Patent Suit stands independent of “Appropriate Patent Office” Determination under Patent Rules | India Corporate Law (cyrilamarchandblogs.com)).

### 31. Selfdot Technologies (OPC) Pvt. Ltd. vs Controller General of Patents, Designs & Trademarks

Section 39 of the Patents Act requires a person resident in India to obtain a written permit (foreign filing license) from the Controller before making an application for a patent outside India. If an Indian resident files a patent application outside India without obtaining the said permit, then that person is liable for penalty under Section 118 of the Patents Act. In the present case, the Appellant had filed a patent application before the Indian patent office (the parent invention), followed by a PCT application, and an application before the US Patent office. Subsequently, in relation to the US application, a continuation-in-part (CIP) (US equivalent to Patent of addition) application was first filed before the US authority, without seeking prior written approval under Section 39. Thereafter, a corresponding patent application was filed as a patent of addition to the parent application before the Indian Patent office. The Indian Patent office rejected the patent of addition application on grounds of contravention of Section 39. The Appellant approached the Madras High Court in an appeal against this order. The High Court allowed the appeal and was of the opinion that the Appellant did not intend to circumvent the provisions of Section 39 and that there was credibility in the assertion of bona fide belief that permission under Section 39 was not necessary when filing a CIP (or patent of addition) application as the parent application was first filed in India.

For detailed discussion, you may refer to cam blog “‘Technical Breach’ not a contravention of Section 39 of the Patents Act?” (‘Technical Breach’ not a contravention of Section 39 of the Patents Act? | India Corporate Law (cyrilamarchandblogs.com))



### **International Trademarks Association (INTA) 2024 Pre-Annual Meeting reception in New Delhi hosted by CAM**

CAM hosted INTA's Pre-Annual Meeting reception in New Delhi in collaboration with International Trademarks Association. Justice Manmohan Singh (retd.) Delhi High court was the keynote speaker for the event.

Our Partner (Head-Intellectual Property) Swati Sharma moderated a panel discussion on "IP Management & Risk

Management" at the reception. The panel included Chirag Gupta of Vistara – TATA SIA Airlines Ltd., Radhika Kolluru of Penguin Random House, Megha Babar of Syngenta, and Atika Prasad of Wahl Clipper Corporation. Our partner Revanta Mathur, who was also the compère of the event, co-ordinated the event.

Following are some glimpses of the event.





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