

Dear Friends

We have pleasure in sending you the January issue of our Newsletter. This issue features some of the current developments from the Indian Courts on important Copyright and Trademark issues.

TRADEMARK:

Bombay High Court restrains a registered proprietor of a mark at the ad-interim stage itself.

The Bombay High Court in a recent decision has restrained a registered proprietor from using the registered trademark. A suit was filed for infringement and passing off of the trademark NOVA. The mark NOVA Cream Brillantine was used since several decades and was registered in Classes 3 and 5 inter alia for hair styling gel and as a pain balm. The packaging of the Plaintiff comprised of a square shaped carton with green and black coloured checkered design. The packet mentioned that the product was an ideal nourishing moisturizer for the skin nourishing, healing and invigorating it and regular use kept the skin soft, smooth, beautifully radiant and prevents wrinkles, dryness, cracked skin, itching, etc. That is was a tonic for the skin. It also mentioned that Nova Cream Brillantine was also an ideal dressing for the hair.

In contrast, the Defendant's product was a water based hair styling gel. The Defendants used the mark "Ospra My Lucky Star Nova" hair styling gel. The said label came to be registered in Class 3 for hair styling gel after it was advertised in the Trade Mark Journal in 2004. The Defendants also had copyright registration of the said label, which was obtained after obtaining the requisite certificate from the Trade Mark registry that no similar trade mark was registered or was pending. The said mark was used in respect of the said goods since 2003-04. The Defendants product was sold in plastic bottles with the said label.

The Plaintiff had in or around October, 2010, filed a Rectification petition before the Registrar of Trade Marks to rectify the said mark, which petition was pending. The suit was filed in or around September, 2011.

The court held that although the words "Ospra my lucky star Nova" have been used, it would make no difference to the question of deceptive similarity. The words "Ospra my lucky star Nova" are of no significance in considering the application of deceptive similarity. On the question of delay the court held that because the Defendants sales were small, the court could not conclude that the Plaintiffs would have been aware of the same. Finally on the issue of added material the court held that since the word NOVA was prominently written on the product, the added material would not be sufficient to distinguish the two rival products. The court did not grant any order on infringement but held that the use of the mark Nova by the Defendant amounted to Passing Off and therefore restrained the Defendants from using the same.

Hitherto, courts were slow in granting ad-interim relief against parties who had used the trademarks for a considerable period of time and where there was some delay on the part of the Plaintiff in approaching the Court.

For the full decision see: <http://bombayhighcourt.nic.in/data/original/2011/S279511241111.pdf>

IPAB HEARINGS:

The Intellectual Property Appellate Board whilst hearing cases in Mumbai, will now sit in the High Court premises. This is a boon to several lawyers and counsel who predominantly practice in the High Court and have their offices close by. Earlier, the hearings were held at the office of the Registrar of Trade Marks at Antop Hill, which was extremely inconvenient.

COPYRIGHT:

The Music Broadcast Private Limited recently filed a suit against the IPRS seeking a declaration that IPRS is not entitled to claim any royalty when the sound recording is communicated to the public.

The main question in dispute was whether IPRS was entitled to claim royalty in respect of literary or musical work embodied in the sound recording, when the 'sound recording' was communicated to the public.

Justice S J Vazifdar upheld the rights of the music companies over the song recording as against the composers and lyricists of the song. The court has inter alia held that when a composer or author agrees to have his musical work (underlying work) which is included into a sound recording, he thereafter loses his exclusive right of public performance or broadcast of that underlying work to the producer when the sound recording is used for those purposes. Hotels and Radio Stations that used to pay large amounts of royalty to the composers and lyricists every time they played their songs are rejoicing.

For the full decision see: <http://bombayhighcourt.nic.in/data/judgements/2011/OSS227006.pdf>

PATENT:

BAYER'S may be forced to grant a compulsory license of its patented anti-cancer drug to NATCO, if it fails in its Opposition to the grant of the Compulsory License application. Natco has filed an application before the Patent Office for Compulsory License of Bayer's drug, interalia, on the ground that the drug is not available at affordable prices to the public. Natco has indicated that it will offer the same product at a fraction of the price charged by Bayer. The Controller has observed that a *prima facie* case for the grant of compulsory license in respect of Indian Patent Number 215758 has been established by Natco. Bayer is now required to file its Notice of Opposition to the grant of the Compulsory License. Natco had earlier challenged Novartis's life saving Glivec cancer drug. The battle for Glivec is now in the final stages.