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Solicitors & Advocates

2024 Recap

Unpacking Key Developments in IP Law

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As we enter the new year, it's time to reflect on the key developments in intellectual property law over the past year. In this recap, we've curated insights to give you a comprehensive overview of the most notable changes and trends in the field.

A. Legislative Developments

I. Jan Vishwas Amendment to IP Laws

The Department for Promotion of Industry and Internal Trade (DPIIT) has announced that the provisions of the Jan Vishwas (Amendment of Provisions) Act, 2023, pertaining to patents, trademarks, geographical indications, and copyright laws, came into effect on August 1.

This Act amended existing statutes to decriminalise and rationalise offences, with the goal of strengthening trust-based governance and facilitating ease of doing business. As part of this initiative, amendments were made to 42 enactments included in the Schedule to the Act. Read our update to know about the changes made to the IP laws.

II. Patents (Amendment) Rules, 2024: A Look at Key Changes

On March 15, 2024, the Ministry of Commerce and Industry notified the Patents (Amendment) Rules, 2024, which introduced key changes to the 2003 Rules, including the provision for the issue of certificates of inventorship. The draft amendment rules in this regard were released in August 2023.

As per the amendment to Rule 12(2), significant relief has been provided to applicants prosecuting applications in foreign countries in respect of the same or substantially the same invention. Prior to the amendment, the applicant had to file the statement (with details of foreign applications) and undertaking (stating that he would keep the Controller informed of the detailed particulars in respect of foreign applications filed in the future) in Form 3 within six months from the date of filing. Then, subsequent information regarding the foreign applications had to be communicated to the Controller within 6 months of the date of filing the foreign application or the change in status (e.g., if the patent was published or granted in the foreign country).

While Rule 12(1A) remains unchanged, requiring the applicant to furnish details of existing foreign applications, the revised Rule 12(2) provides that subsequent information must be filed

within three months from the date of issuance of the first statement of objections. This applies to all types of applications, whether through regular or expedited examination processes.

Click here to access other key changes.

III. Jan Vishwas Amendment: DPIIT Notifies Trade Marks (Holding Inquiry and Appeal) Rules, 2024, and Geographical Indications of Goods (Holding Inquiry and Appeal) Rules, 2024

Pursuant to provisions introduced by the Jan Vishwas (Amendment of Provisions) Act, 2023, the Department for Promotion of Industry and Internal Trade (DPIIT) has notified rules for holding inquiry, imposing penalties, and preferring appeals under provisions of the trademark and geographical indications legislations. [1]

Draft rules in this regard were released for public consultation a month before the finalised rules were notified.

IV. Calcutta HC and Himachal Pradesh HC Notify IPD Rules, Karnataka HC Sets Up Sub-Committee to Draft IPD Rules

Here is a timeline of the evolution of IPD Rules in the year 2024:

- **June 20, 2024**: A sub-committee was constituted to draft rules for the establishment of the IP Division in the Karnataka High Court.

- **July 8, 2024**: Himachal Pradesh High Court Intellectual Property Rights Division Rules, 2022, have been notified. These Rules came into effect on October 9, 2024.

- **September 20, 2024**: Intellectual Property Rights Division Rules of the High Court at Calcutta, 2023, have been notified in the Kolkata Gazette. These Rules contain the provisions for IPR proceedings. Notably, Rule 29 envisages accessibility and reasonable accommodation for persons with a disability recognised under the Rights of Persons with Disabilities Act, 2016, for participating in any proceedings before the Intellectual Property Rights Division (IPRD) or the Intellectual Property Rights Appellate Division (IPRAD). Both the IPRD and IPRAD of the Calcutta High Court commenced operations on November 4, 2024.

[1] The Trade Marks (Holding Inquiry and Appeal) Rules, 2024, available here.
The Geographical Indications of Goods (Holding Inquiry and Appeal) Rules, 2024, available here.

V. Law Commission Presents Proposed Bill to Protect Trade Secrets

In March 2024, the 22nd Law Commission of India, through Report No. 289, recommended the introduction of sui generis legislation to protect trade secrets in India. The Law Commission Report also contains a proposed draft of the legislation, 'The Protection of Trade Secrets Bill, 2024.'

The draft Bill defines trade secrets and the rights and responsibilities of their holders and includes provisions for compulsory licenses in cases of emergency or urgency. Further, the proposed Bill provides structured remedies for misappropriation of trade secrets, such as injunctions, damages/accounts of profits, and surrender/destruction of documents, objects, materials, substances, or electronic files.

Other significant provisions include the maintenance of confidentiality during court proceedings and remedies in case of groundless threats to legal proceedings.

VI. Draft Commercial Courts (Amendment) Bill, 2024

To strengthen the commercial dispute resolution ecosystem, the Department of Legal Affairs circulated a draft Bill to amend the Commercial Courts Act, 2015. The draft, inter alia, aims to update the legislation to incorporate all forms of electronic communications in court procedures, including video conferencing and e-filing.

The draft Bill proposes setting up commercial courts at the district level, including dedicated commercial courts and courts designated exclusively to deal with arbitration matters. The period of appeal to the commercial appellate court has also been extended by a further period of 30 days in cases of sufficient cause, justifying the delay. Further, an appeal shall only be filed after issuing prior notice to the other party. Changes pertaining to the list of witnesses have also been made, along with the insertion of an appendix providing a model for sharing the list of witnesses.

A new section is also sought to be inserted, providing a 90-day timeline for the disposal of applications for injunctions. A timeline has also been introduced through the addition of rule 10A in Order 21 of the Civil Procedure Code, 1908, which provides that all proceedings in an application for execution shall be disposed of within 12 months.

VII. Biological Diversity Rules, 2024 Notified

On October 22, 2024, the Ministry of Environment, Forest and Climate Change notified the Biological Diversity Rules, 2024, in supersession of the 2004 Rules. These came into effect on December 21, 2024.

The Rules set out the procedure for obtaining access to biological resources and the knowledge associated with them. Access may be restricted or prohibited if the request concerns threatened species, adversely affects the livelihood of local communities, or is for any of the other specified reasons. The new Rules also provide the procedure for registering and obtaining prior approval from the National Biodiversity Authority before the grant of IP rights.

Notably, the payment process has been streamlined by enabling online payments to the National Biodiversity Fund, replacing the previous requirement of physical payment through cheque or demand draft in favour of the Authority. Further, the Chairperson has been empowered to grant expedited approvals in emergencies and other extreme situations.

B. Administrative Developments

I. Following DPIIT's Directive, TM Applications Processed by QCI-hired Officers to be Revisited

Following DPIIT's directive, the Office of the Controller General of Patents, Designs and Trade Marks (CGPDTM) is revisiting trademark applications processed by officers hired through the Quality Council of India (QCI). This decision follows legal challenges to the validity of these outsourced officers' decisions.

The review will cover applications at various stages, including examination, PARM, show cause hearings, oppositions, and post-registration.

The Level-1 Officer will revisit applications in accordance with the Act and Rules, validate them, or recommend appropriate actions to the Level-2 Officer. The Level-2 Officer will decide whether to initiate the process per the Level-1 Officer's recommendations or validate the decision.

Additionally, the office order addresses concerns regarding monitoring work output, suitable arrangements in the TM module for processing applications, and other related matters.

Read our update to know more.

II. Section 31D's Statutory Licensing Not Applicable to 'Internet' Broadcasting

On August 21, 2024, the Department for Promotion of Industry and Internal Trade (DPIIT) officially rescinded Office Memorandum No. 14-35/2015-CRB/LU (IPR-VII), dated September 5, 2016. This action followed the Division Bench of the Bombay High Court's ruling in the case of *Tips Industries Ltd. vs. Wynk Music Ltd. & Anr*. (Commercial Appeal Nos. 424 and 425 of 2019).

The 2016 memorandum expanded the scope of Section 31D of the Copyright Act, 1957, extending statutory licenses for the "broadcasting" of literary and musical works and sound recordings to include "internet" transmissions, in addition to traditional TV and radio broadcasts. However, this expansion raised concerns regarding its legal validity, as many argued that the DPIIT lacked the constitutional authority to interpret statutory provisions, a role reserved for the courts.

The turning point came in 2019 when, during the interim injunction hearings in the Tips Industries case, the Bombay High Court ruled that Section 31D of the Copyright Act did not apply to internet broadcasting. The Court referenced the 227th Report of the Rajya Sabha Parliamentary Standing Committee on the Copyright (Amendment) Bill, 2010, noting that despite the presence of digital technologies like streaming and downloads when the Copyright Act was amended in 2012, the legislature intentionally did not include "internet broadcasting" in Section 31D.

It is worth noting that the 161st Report of the Rajya Sabha Parliamentary Standing Committee indicated a legislative intention to include the internet and online streaming platforms under Section 31D. The Draft Copyright (Amendment) Rules, 2019, provided for the substitution of the words "by way of radio broadcast or television broadcast" with the words "for each mode of broadcast." This inclusion was ultimately omitted in the final Copyright Rules (Amendment) 2021, likely in consideration of the Tips Industries judgment.

In 2023, the Bombay High Court's Division Bench reaffirmed this position, clarifying that Section 31D's statutory licensing applied solely to linear broadcasting mediums and explicitly excluded non-linear, on-demand streaming services. The case concluded with a final settlement order on June 18, 2024, requiring Wynk to pay Tips Industries a full and final settlement of ₹12 crore.

III. Music at Marriage Functions: DPIIT Stays July 2023 Public Notice

The Department for Promotion of Industry and Internal Trade (DPIIT) has temporarily suspended its July 2023 public notice, which directed copyright societies to refrain from collecting royalties for playing music or performing other copyrighted works at marriage functions or other religious ceremonies.

Section 52(1)(za) of the Copyright Act, 1957, extends the exemption from copyright infringement for playing sound recordings during any bona fide religious ceremony, including a marriage procession and other social festivities associated with marriage.

While DPIIT, in its public notice dated August 27, 2019, took the view that utilisation of any sound recording in the course of a religious ceremony, including a marriage procession and other social festivities associated with marriage, did not amount to infringement and hence no license was required, the Punjab and Haryana High Court, while setting aside the 2019 notice in the case of *Novex Communications Private Limited v. Union of India and Ors.* (CWP No. 28758 of 2019 (O&M)) laid stress on the element of commercial gains.

In this case, the Court held that whether certain acts would fall within the exempted categories had to be decided according to the facts of each case, and there could **not** be a general interpretation of the provision given in the 2019 notice. The 2019 notice was also held to be violative of the doctrine of separation of power.

Despite the abovementioned decision, the DPIIT, on receipt of complaints from stakeholders regarding the alleged collection of royalties by copyright societies for the performance of musical works at marriage functions, proceeded to issue the July 2023 notice directing copyright societies to 'strictly refrain' from entering into acts in contravention of Section 52 (1) (za), to avoid any legal action.

The stay on the July 2023 public notice will be subject to the final decision of the Punjab and Haryana High Court in the case of the *Union of India and Anr. v. Novex Communication Private Ltd*. (LPA No.1127 of 2022), in which the above ruling of the Single Judge Bench is being challenged.



IV. Committee Constituted to Draft Code of Conduct for Patent and Trademark Agents

A special committee has been constituted to draft the code of conduct for regulating the conduct of patent and trademark agents. It comprises members nominated by the Department for Promotion of Industry and Internal Trade (DPIIT). Until this code of conduct is in place, the complaints against patent and trademark agents will be dealt with by the ad-hoc committee constituted by the Office of the Controller General of Patents, Designs, and Trademarks (CGPDTM).

Both the special committee and the ad hoc committee were established following the directions of the Delhi High Court in *Saurav Chaudhary v. Union of India and Anr*. [WP(C)-IPD 9/2023]; this case revolved around the professional misconduct of a patent agent who omitted to file the response to the First Examination Report (FER), resulting in the client's application being treated as 'deemed to be abandoned'.

V. Four New Miscellaneous Forms Included in Trademarks E-Filing System

The trademarks e-filing system now includes four new miscellaneous forms: the Letter of Withdrawal for Opposition (MIS-OW), Letter of Withdrawal for Rectification (MIS-RW), Reply to Notice under Section 19 of the Trade Marks Act, 1999 (MISR19), and Reply to Notice under Section 57 (MISR57).

The inclusion of these forms has streamlined the process for users to file applications and enabled the Trade Marks Registry to allocate and review them efficiently through the e-filing system. This represents a significant improvement over the previous method, which required submitting all documents via post or email.

VI. Office of CGPDTM's Websites to be Made Accessible to Persons with Disabilities

The Office of the Controller General of Patents, Designs, and Trade Marks (CGPDTM) is working to make its websites accessible to people with disabilities, following the guidelines issued by the Union of India.

This was conveyed via an affidavit filed on September 17, 2024, in the case of *Dr. Kalyan C. Kankanala v. Union of India and Ors*. [WP No. 21978 of 2021]. The writ petition sought a direction to the Office of the CGPDTM to make its websites and online procedures, including video conferencing, fully compliant with the accessibility guidelines set out in the website compliance matrix appended to the guidelines for government websites (2.0), 2019 edition.

During the pendency of the writ petition, the Office of the CGPDTM released the 'Guidelines for Accessibility and Reasonable Accommodations for Persons with Disabilities' in 2022. These guidelines are claimed to address the Petitioner's plea substantially.

The abovementioned affidavit stated that the Office of the CGPDTM had commenced preparing the scope of work for a tender to make the websites accessible to persons with disabilities in accordance with the guidelines issued by the Union of India. It added that the websites will be made accessible to persons with disabilities after receiving approval from the concerned authorities.

VII. Working Statements: FAQs on Form 27 Released

In view of the Patents (Amendment) Rules, 2024 and the amendments made to the provisions concerning statements of working (Rule 131), numerous stakeholders raised concerns regarding the varying interpretations of the amended Rule. This prompted the Office of the CGPDTM to release FAQs surrounding the specifics of Form 27.

VIII. Amendment of the Geographical Indications Act

The Department for Promotion of Industry and Internal Trade (DPIIT) issued a public notice on September 27, 2024, inviting comments and suggestions by October 10, 2024, regarding proposed amendments to the Geographical Indications of Goods (Registration and Protection) Act, 1999.

According to the latest list of registered Geographical Indications (GIs), there are 658 registered GIs in India.[2] Mr. Piyush Goyal, the Minister of Commerce and Industry, has set a target of 10,000 GIs by 2030. The public notice underscores the Government's commitment to strengthening the legal framework surrounding GIs in India.

IX. CGPDTM Launches Open House Helpdesk Portal

The Office of the CGPDTM launched the Open House Helpdesk Portal through its notice dated February 14, 2024. The portal serves as a single-window communication system to effectively resolve common issues faced by IP practitioners and applicants. The portal allows for the online registration of the concern as a "ticket", which is routed to the concerned officer/department, who then responds via the same portal. The portal also allows users to track the status of their complaints with regular updates.

[2] https://ipindia.gov.in/IPIndiaAdmin/writereaddata/Portal/Images/pdf/Registered_GI_of_India_31-12-2024.pdf

C. Case Laws

Copyright Law

I. Vodafone Idea Limited v. Saregama India Limited & Anr. (CS No.23 of 2018)

In a recent judgment, the Calcutta High Court held that the Copyright (Amendment) Act, 2012 conferred substantive rights on the authors of underlying works, who are now entitled to receive royalties on each occasion a sound recording is communicated to the public.[3] It was also made clear that the rights of the author in the underlying works could not be defeated by obtaining a license to exploit the sound recordings.

Click here to read our article on the development.

II. Arijit Singh v. Codible Ventures LLP and Ors. [Interim Application (L) No. 23560 of 2024 and COM IPR Suit (L) No. 23443 of 2024]

On July 26, 2024, the Bombay High Court granted an ex-parte ad interim injunction restraining AI platforms from violating the personality rights of renowned playback singer and composer Arijit Singh (the Plaintiff herein).

The Plaintiff alleged that the Defendants engaged in activities such as synthesising artificial sound recordings mimicking his voice, misrepresenting an association with him, selling merchandise featuring his name, image, and likeness, hosting platforms for creating and sharing GIFs, and registering infringing domain names. The Plaintiff contended that these acts not only infringed upon his personality rights but also jeopardised his career and livelihood by misleading fans and exploiting his reputation for commercial gain.

The Court iterated that in an action for protecting personality rights and the right to publicity, the Plaintiff's celebrity status had to be established, the Plaintiff had to be identifiable from the Defendant's unauthorised use, and such use had to be for commercial gain. Considering these factors, the Court was of the prima facie view that the Plaintiff had made out a strong case for the grant of ad-interim injunction. Further, it was held that the balance of convenience was in the Plaintiff's favour, and if the reliefs sought were not granted, the Plaintiff would suffer irreparable injury.

[3] Vodafone Idea Limited v. Saregama India Limited & Anr. (CS No.23 of 2018), Saregama India Ltd v. Vodafone Idea Limited (CS No.155 of 2018), and Indian Performing Right Society Ltd. v. Vodafone Idea Ltd (CS No.210 of 2018); Judgment available here.

The Court also concurred that while freedom of speech and expression permits critique and commentary, it does not allow the unauthorised commercial exploitation of a celebrity's persona. Hon'ble Justice Chagla further acknowledged the vulnerability of performers, such as the Plaintiff, to unauthorised generative AI content.

This prevented the Defendants from exploiting the Plaintiff's personality rights in any medium, including physical formats and virtual environments such as the Metaverse.

Trademark Law

I. Sun Pharma Laboratories Ltd. v. Dabur India Ltd. & Anr. [CA(COMM.IPD-TM) 146/2022]

In a significant decision, the Delhi High Court has held that in a trademark opposition proceeding, the Registrar does not have the discretion to extend the deadline if the evidence in support of opposition is not filed within the prescribed period.

In this case, Sun Pharma Laboratories Ltd. (the Appellant herein), proprietor of the mark 'GLUCORED' in class 5, filed an opposition, under Section 21 of the Trade Marks Act, 1999, against Respondent No.1, Dabur India Ltd.'s trademark application for the mark 'DABURGLUCORID KP (Label)' in class 5. Though evidence in opposition under Rule 50 of the Trade Marks Rules, 2002, was filed with the Trade Marks Registry within two months from the date the counter-statement was served on the Appellant, a copy of the same was not served on Respondent No.1 (i.e., Applicant) within the prescribed time; it was received by Respondent No.1 three days after the deadline. Respondent No.1 then sought an extension of one month for filing evidence in support of its application, but no evidence was filed.

Subsequently, the Appellant wrote to the Registrar stating that Respondent No.1 had not filed the evidence under Rule 51 and to close the case and put the matter for hearing. After almost nine years, in August 2017, the Appellant again wrote to the Registrar requesting the latter to close the evidence and fix the matter for hearing. Thereafter, the Registrar passed an order in July 2022, holding that the opposition had to be treated as abandoned on account of the evidence in support of the opposition being time-barred (as per Rule 50(2)) and rejecting the application seeking a one-month extension for the filing of evidence under Rule 50 as it was filed after almost 15 years (as per Rule 50(3)).

In view of the facts of the case, the Court held that the opposition could not have been held as having been abandoned, with a direction to the Registrar to proceed to pass orders in the opposition proceedings on merits.

II. Abhi Traders v. Fashnear Technologies Private Limited and Ors. [CS(COMM) 180/2024]

In a copyright infringement case involving the sale of counterfeit products, the Delhi High Court reiterated that e-commerce platforms were obligated to ensure that sellers' complete details were available on the platforms.

The present suit was filed by Abhi Traders, a retailer selling apparel under the mark "IBRANA" through various e-commerce sites such as Meesho (Defendant No. 1's platform). A number of unauthorised sellers (Defendant Nos. 2 to 10) were found on Defendant No. 1's online platform advertising, publishing, and offering for sale garments that were complete copies of Plaintiff's garments. The sellers also misused photographs and images to which the Plaintiff owned rights.

As to the submissions against Defendant No.1, Plaintiff contended that Defendant No. 1 did not provide any contact information on its website at any point during the transaction process and also failed to disclose the names and addresses of Defendants No. 2 to 9 in the invoices generated subsequent to the purchase of counterfeit products.

Here, it is relevant to add that the obligation to publish seller details is contained in Rule 5(3)(a) of the Consumer Protection (E-Commerce) Rules, 2020; marketplace e-commerce entities are mandated to provide details of the sellers offering goods and services, in a clear and accessible manner, displayed prominently to its users at the appropriate place on its platform. These details include the name of their business, whether registered or not, their geographic address, customer care number, any rating or other aggregated feedback about such seller, and any other information necessary for enabling consumers to make informed decisions at the pre-purchase stage.

Holding that the Plaintiff had made a case for the grant of an ex-parte ad interim Injunction, the Court restrained Defendant Nos. 2 to 9 from copying or imitating any designs of the Plaintiff's clothing. The Court also directed that the sellers' geographic address be clearly displayed in the invoice published on the platform and that infringing URLs be taken down.

This matter has been re-notified on March 19, 2025, considering the submission that Plaintiff, along with Defendant Nos. 2 to 9, are currently exploring the possibility of arriving at a settlement.

III. Burger King Corporation v. Anahita Irani & Anr. [IA No. 11936 of 2024 in Commercial First Appeal (ST) No. 23989 of 2024]

On August 26, 2024, the Bombay High Court issued a stay on the Pune District Court's ruling from July 2024, which had dismissed the Burger King Corporation's suit against the owners of Pune-based restaurants alleging infringement of its registered and well-known trademark.

Click here to read our article on this development.

IV. Panchhi Petha Store v. Union of India and Ors. [WP(C) 773/2019]

In a decision dated November 11, 2024, the Delhi High Court held that the Regional Director does not have jurisdiction to decide ownership of a trademark while deciding an application under Section 15 of the Companies Act, 2013.

In this case, the Petitioner submitted a request to change the name of Respondent No. 4, Panchhi Petha Pvt. Ltd., and sought its removal from the Register under Section 16(1)(b) of the Act, claiming to be the proprietor of the trademarks, "Panchhi" and "Panchhi Petha Store". This Section permits a registered trademark owner to petition for a company's name change if it is as identical or too nearly resembles their registered trademark. However, the Regional Director dismissed the application, remarking that the Petitioner was not the owner of the trademark in question.

Both parties claimed ownership and rights over the mark "Panchhi" and have engaged in various legal proceedings, including against each other, regarding the impugned trademark and other intellectual property-related rights. The impugned order refers to these disputes; however, it goes on to give a finding of ownership of the mark.

It was observed that the said provision was intended to prevent consumer confusion. The Regional Director, while deciding an application under Section 16, could not examine the marks as the Intellectual Property Division of a Court would or even decide the ownership of a mark. Thus, the Delhi High Court set aside the impugned order.

I. Vifor International Ltd. v. MSN Laboratories (P) Ltd. [FAO(OS) (COMM) 159/2023 & CM APPL. 39177/2023]

The Delhi High Court allowed an appeal against a single judge's order dismissing an interim injunction application for infringement of patent IN' 536, which covers the intravenous treatment of iron deficiency anemia, known as Ferric carboxymaltose (FCM). The patent contains a claim in the 'product-by-process' format.

The learned Single Judge relied on the contention that since the plaintiff's claim was liable to be construed as a 'product-by-process' claim, it would stand limited to the process alone. The Defendants argued that since the primary claim within the said Patent (IN' 536) was a 'product-by-process' claim, their use of a different process to produce the same outcome cannot amount to infringement.

However, the learned High Court accepted the Plaintiff's contention that in the "product by process" format of drafting patent claims, which is a well-accepted practice under Indian patent law and in all major foreign jurisdictions, process terms are used to identify and describe the novel and unobvious product being claimed without limiting the scope of the claim to said process terms.

The Court made a clear distinction between a 'product-by-process' claim, a 'pure process' claim and a 'pure-product' claim. Product-by-process claims, although employing process terms, are fundamentally concerned with an inventive product, and the reference to a process is only to help explain the novel attributes of a new product unknown in the prior art. Hence, a product-by-process claim would necessarily have to be examined on the anvil of a new and unobvious product, irrespective of whether the applicant has chosen to describe the invention by referring to a process of manufacture.

The mere adoption of the product-by-process format would not result in a novel product being downgraded to Section 48(b) of the Act. It would inevitably have to be tested on principles enshrined in Section 48(a).

However, the Court pointed out that the question of patentability was to be examined and evaluated independently of the allocation of an INN to a chemical formulation. Conferral of an INN could not be construed as irrefutable evidence of an invention. It could be viewed as corroborative of an assertion that a patentable product had been obtained. The infringement appeal was, therefore, allowed, and the order dismissing the prior application was set aside.



II. Genomatica Inc v. Controller of Patents and Designs [CMA(PT) No.4 of 2023]

The Madras High Court set aside an order by a Controller rejecting a patent application, holding that a Controller must not consider claims abandoned by an Appellant through an amendment. The Hon'ble High Court further clarified that when a set of claims is amended, the amended claims get superimposed on the previous set of claims. Therefore, it was not permissible for the Controller to read something which was not before them.

In the instant case, a patent application was filed for 'Non-Natural Microbial Organisms with improved Energetic Efficiency' that contained 72 claims, including four independent claims. The application resulted in a First Examination Report (FER), with objections backed by six prior art references. The applicant filed revised claims, reducing the total number of claims to 70, cancelling one independent claim, and leaving three independent claims intact. The Controller again issued a hearing notice with the same objections. In response, the applicant filed written submissions, further amending and reducing the number of claims from 70 to 68, of which only one was its independent claim.

The Controller rejected the application, citing that the last amendments made to the claims exceeded the specifications and, hence, could not be considered under Section 59 of the Act. The controller then relied on the earlier set of claims and rejected them under Sections 10(4) and 10(5) of the Act.

The appeal against the Controller's order was allowed by the Madras High Court, citing that the refusal under Section 59 was invalid as no objection under the Section was mentioned in the hearing notice, and a fresh hearing notice should have been issued after the final amendments. The Court further noted that the Appellant's submission of amended claims

signified they were no longer relying on earlier claims, and the Controller should not have decided based on superseded claims without offering another hearing.

III. Novartis AG v. Natco Pharma Limited and Anr. [LPA 50/2023]

A division bench of the Delhi High Court, while setting aside the revocation of a patent, held that the patent examination process is separate and independent of opposition proceedings. In the instant case, Novartis AG had filed a National Phase Patent Application in India, which encountered numerous pre-grant oppositions. After hearings regarding the pre-grant oppositions and the prosecution of the application, the Controller directed Novartis to amend its application. Novartis carried out the amendments, and the patent was granted.

Natco filed a writ petition in the Delhi High Court, challenging the grant of the patent, as they were one of the pre-grant opponents, and claimed that the amendments were made without affording them an opportunity to be heard. The patent was revoked. Subsequently, Novartis appealed to the division bench of the Delhi High Court, wherein it was clarified that the process of substantive examination of a patent application and a pre-grant opposition proceeding are two separate and independent proceedings and that the opponent has no right to intervene in the substantive examination procedure. The pre-grant opposition representation merely aids the Controller in a holistic examination of the patent application. Those representations do not absolve the Controller from examining the application and being satisfied that the patent is liable to be granted.

The Court also pointed out that Rule 55 cannot be interpreted as seeking to either accord a participatory role upon the objector in the examination process or conferring a right to be heard in the course thereof.

D. Other Updates

- WIPO adopts the GRATK Treaty and Riyadh Design Law Treaty.
- The Central Government registered the Screenwriters Rights Association of India (SRAI) as a Copyright Society under Section 33(3) of the Copyright Act, 1957.
- New AI-ML-based trademark search technology announced.
- Apex Court will determine if provisions of the Patents Act, 1970, will prevail over those of the Competition Act, 2002.[4]

[4] Competition Commission of India v. Telefonaktiebolaget LM Ericsson (PUBL) [SLP(C) No. 12209/ 2024]

- Patent application: Non-appearance does not eliminate the need for reasoned order.
- AI on trial: ANI Media vs. OpenAI.
- 'INFOSYS' trademark: An injunction was issued against use in the corporate name of Southern Infosys Limited.
- Delhi HC: "well-known" status does not confer absolute rights on proprietors to seek rectification of pre-existing similar marks.[5]
- Reverse passing off: Delhi HC issues directions for sale of refurbished hard disk drives.[6]
- Azure trademark invalidity pleading: Microsoft files appeal.

Concluding Thoughts

As seen above, the year 2024 has been marked by several legislative, administrative and judicial developments in intellectual property law. These changes showcase ongoing efforts to digitise processes, update existing laws, clarify procedural rules, and safeguard artists' rights. The growing trend of High Courts establishing dedicated IP divisions underscores the recognition of the unique challenges in handling IP cases. Additionally, initiatives aimed at protecting the rights of persons with disabilities are paving the way for a more inclusive and equitable IP ecosystem.

[5] M/s. Vans Inc. USA v. FCB Garment Tex India (P) Ltd. and Anr. [CO(COMM.IPD-TM) 161/2021]
[6] Seagate Technology LLC v. Daichi International [CS(COMM) 67/2024]

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