



## IP NEWSLETTER

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### **John Doe Order Issued to Block Websites Broadcasting the 2014 India-England Cricket Test Series**

Star India Private Limited (“Star India”) filed a suit of copyright infringement before the Delhi High Court [*Star India Pvt. Ltd. & Anr. v. Haneeth Ujwal & Ors., CS(OS) No. 2243/2014*] and sought taking-down of over one hundred websites which illegally broadcast, re-transmit, host and stream the content of the 2014 India-England Cricket Test Series (“Test Series”).

Star India contended that they have exclusive Internet, Mobile and On-Demand Rights for the Test Series and any hosting, streaming, making available for viewing and/or communication to the public of the Test Series, as broadcast on its Channels by any means including the internet and mobile, by any of the named or unnamed Defendants-websites would be illegal and amount to violation of its broadcast reproduction rights protected under the Copyright Act, 1957.

Star India contended that it would not suffice to block individual URLs broadcasting the infringing contents, as the Defendants-websites can always broadcast the infringing content on an alternative URL.

The Court restrained the Defendants-websites from broadcasting the infringing contents and also directed the Defendant Nos. 50 and 51 (DoT and DEITY) “to ensure and secure compliance of this order by calling upon the various internet service providers registered under it to block access to the various websites”.

### **Use of Mark/Domain Name as Meta-tags held to be Passing-off**

The Plaintiff filed a suit seeking injunction against the Defendant [*People Interactive (I) Pvt. Ltd. v. Gaurav Jerry & Ors., Suit No. 622/2014*] from using the domain name ShaadiHiShaadi.com or any other word identical or confusingly similar to the Plaintiffs’ registered trademark Shaadi.com and Shadi.com.

The Plaintiff also submitted that a web analysis of the website hosted at ShaadiHiShaadi.com revealed that the Defendant have used the Plaintiffs’ proprietary mark shaadi.com and its domain name www.shaadi.com as part of the “meta-tags” therein. The Plaintiff’s analysis further showed that by illicitly plugging the Plaintiffs’ mark and domain name into its website’s web pages’ meta-tags, the Defendant has succeeded in diverting significant Internet traffic away from the Plaintiff to itself.

The Court observed that there could be no better evidence of passing off, confusion and deception. This is, plainly, hijacking the Plaintiff’s reputation and goodwill and riding piggyback on the Plaintiff’s intellectual property.

The Court held that the Defendant has plainly, hijacked Internet traffic from the Plaintiff’s site by dishonest and malafide use of the Plaintiff’s mark and domain name in the meta tags of the rival websites. The Court accordingly restrained the Defendant from using the Plaintiff’s mark in any manner, including in the form of meta-tags.

## **Design Registration in India – Practice and Procedure**

Unlike many other countries like United States who has utility model law for registration of designs, in India Design Registration is granted under the Designs Act, 2000 (“Act”). As per Section 2(d) of the Act, “Design” means only the features of shape, configuration, pattern, ornament or composition of lines or colors applied to any article, whether in two dimensions or three dimensions or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which the finished article appeal to and are judged solely by the eye, but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark or property mark or any artistic work as defined in Section 2(c) of the Copyright Act, 1957.

### **Who May Apply**

Any person claiming to be the proprietor of a new or original design not previously published in any country, and which is not contrary to public order and morality, may apply to the Patent Office for its registration.

### **Registrability of the Design**

(1) The design should be new or original, not previously published in India or in any other country by publication in tangible form or by use in any other way prior to the filing date, or where applicable, the Priority date of the application for registration.

(2) The design should be significantly distinguishable from known designs or

combinations of known designs. The design should not comprise or contain scandalous matter.

(3) The design should relate only to external features, i.e. shape, configuration, pattern or ornamentation only of an article. Thus, designs of industrial plans, layouts and installations are not registrable under the Act.

(4) The design should be applied to an article by any industrial process.

(5) The features of the design in the finished article should appeal to and are judged solely by the eye.

### **Drafting Design Specification**

The most important part of design specification preparation is ‘preparation of representation sheet’, which is filed in quadruplicate along with application.

#### **A. Statement of Novelty**

It is required that the registrant should give statement as to novelty of the Design, requested for registration under the Act. Novelty in respect of designs is absolute. To be novel, the article should not have been available or published in India or in any other country. Novelty in India in respect of designs is lost only if the product is published, sold or used within India or in any other country prior to the date of filing

#### **B. Statement as to Disclaimer**

When a design is likely to represent a trademark or perform a functional/mechanical aspect, a disclaimer as to its use is required to be given without prejudicing rights of other persons.

### C. Preparing Representation Sheet

Representation means the exact representation of the article on which the design has been applied. It should be prepared on white A4 size paper of durable quality but should not be prepared on cardboard or should not be mounted on other paper.

The following points should be considered while preparing a representation.

1. A brief statement of novelty, claim of features of design, which is new and original, are required to be mentioned on each set of representation sheet.
2. The article must be shown in isolation and features of the design must be clearly and accurately visible.
3. The article shown in the drawing should be consistent with the name of the article mentioned in the application form.
4. The figure shown should be of sufficient scale in order to visualize all the details of the features of the design applied to the article.
5. The figure should be shown in upright position with respect to top and bottom position of the sheet.
6. No descriptive matter or denoting the components by reference letter/numerals should be included other than showing the particular portion of the article where novelty resides.
7. No dimensions or engineering symbol etc. should be mentioned in the representation sheet.

### Stating Classification

Designs are required to be categorized, in separate classes in order to provide for

systematic registration. An International classification of Industrial Designs according to the Locarno Agreement (thirty two classes) was introduced in the Designs Rules, 2001.

### Procedure

The application is examined by the Patent Office, and objections (if any) are communicated to the Applicant. The applicant should meet the official objections and put the application for Design in order for acceptance within 6 months (extendable on making a petition under Rule 47 of the Design Rules) from the date of application. There is no provision for opposition of the application. When an application for registration of a design is in order it is accepted, and on acceptance a Certificate of Registration is issued to the applicant. The particulars of the application and the representation(s) is (are) published in the official gazette and the registration is recorded in the Register of Designs.

The duration of the registration of a design is initially ten years from the date of registration (date of registration is the date of application), which may be extended by further period of 5 years.

### Cancellation

The registration of a design may be cancelled on any of the following grounds:

- (a) That the design has been previously registered in India or in any other country, or
- (b) That it has been published in India or in any other country prior to the date of the registration, or
- (c) The design is not new or original, or
- (d) The design contravenes the provisions of Act.

## **CGPDT Upholds Restrictions on Change in User Date at Pre-Registration Stage**

The Trade Mark Registry issued Office Order No. 16 pertaining to the Pre-Registration Amendment Section, which stated:

*“No request for amendment shall be allowed which seeks substantial alteration in the registration of trademark. The substantial amendment in the trademark, proprietor details, specification of goods/services (except deletion of some of the existing items), statement as to the use of the mark shall not be permitted.”*

The aforesaid clause was challenged by Intellectual Property Attorney Association (IPAA) before the Delhi High Court and a representation for recalling of the aforesaid clause was also made before the Controller General of Patents, Designs and Trade Marks (CGPDT).

The IPAA argued that the aforesaid clause is beyond the intention of the Legislature, as Section 22 (of the Trade Marks Act, 1999) allows the Registrar to permit corrections in the application any time before an application is accepted.

The CGPDT noted that Section 22 is often misused by the Applicants wherein they seek amendment as an afterthought by way of request on form TM-16 with the ulterior motive of trading upon the bona fide use of trademarks by rivals in trade.

The CGPDT further observed that:

*“In the past, it has been found that after receiving the office objections for acceptance of the application for the registration of a trademark, applicants filed a request for amendment in the trademark application seeking to incorporate the prior date of use of the trademark....In such circumstances, an application seeking to incorporate the prior date of use of the trademark in the original application after receiving office objections can hardly be taken as an application to rectify a clerical error.”*

The CGPDT also held that it is inconceivable that a trader would not know about the period since when his trademark has been used at the time of filing of application and he would examine the evidence of the same at a later stage. The change in statement of use at a late date would adversely affect the bonafide rights of continuous use of the trademark by rivals in trade, the balance of convenience lies in the trader filing a fresh application if he wishes to claim a change in the statement of use.

The CGPDT vide its Order dated July 23, 2014 upheld the clause under challenge. The Writ Petition filed by the IPAA before the Delhi High Court challenging the aforesaid clause in the Office Order is currently pending.

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