



### **Court Grants Anti-Suit Injunction in favour of Burger King India Pvt. Ltd.**

Burger King India Pvt. Ltd. (“Plaintiff”) sought an anti-suit injunction against the Defendants restraining them from instituting proceedings against the Plaintiff before subordinate courts or authorities in India. Before filing of this suit, the Plaintiff had filed a suit before the same Court seeking, *inter alia*, permanent injunction restraining the infringement of trade mark BURGER KING against the Defendants. The injunction was granted in favour of the Plaintiff.

The Defendant thereafter filed an application before the Registrar of Companies (“ROC”) seeking an order directing a change of the corporate name of the Plaintiff under Section 16 of the Companies Act, 2013. ROC issued notice to the Plaintiff on the said application. The Plaintiff submitted before the Court that once the suit is pending before this Court where all the disputes of the parties are yet to be decided, the Defendants are not supposed to initiate further proceedings in different form connecting with the similar cause of action, particularly, by filing of an application under Section 16 of the Companies Act, 2013 before the ROC, Mumbai. It was further submitted that the Plaintiff apprehends that the Defendants may not disclose or inform another Court about the pendency of the proceedings with regard to the subject matter *inter se* pending. The Court agreed with the Plaintiff and directed that the parties to the suit shall maintain status quo with regard to any fresh legal proceedings and not to proceed any other matter, which is filed after filing this Suit.

### **IPR Think Tank Constituted to Draft the National Intellectual Property Rights Policy**

The Department of Industrial Policy and Promotion (DIPP) has constituted an IPR Think Tank to draft the National Intellectual Property Rights Policy and to advise the DIPP on IPR issues. The terms of reference of the IPR Think Tank includes:

1. To draft National Intellectual Property Rights Policy.
2. To identify areas in the IPRs where study needs to be conducted and to furnish recommendations in this regard to the Ministry.
3. To keep the Government regularly informed about the developments taking place in IPR cases which have an impact upon India's IPR Policy.
4. To advise the Government on best practices to be followed in Trademark Offices, Patent Offices and other Government Offices dealing with IPR in order to create an efficient and transparent system of functioning in the said offices.
5. To prepare periodic reports on best practice followed in foreign countries.
6. To highlight anomalies in the present IPR legislations and to advice solutions to the Ministry.
7. To give suggestions on the steps that may be taken for improving infrastructure in IP offices and Tribunals.

## **Non-Compliance with Section 8 of the Patents Act, 2005 does not lead to Automatic Revocation**

Section 8 of the Patents Act, 1970 (“Patents Act”) and Rule 12 of the Patents Rules, 2005 (“Patents Rules”) states that the applicant along with his application for a patent or subsequently within six months from the date of filing the application is required to file a statement furnishing the detailed particulars of the application, if any, being prosecuted by him in a foreign country for a patent in respect of the same or substantially same invention. It is also necessary for the applicant to file an undertaking that up to the date of grant of patent, he would keep the Controller informed in writing from time to time of the detailed particulars of the applications, if any, filed subsequently in a foreign country for a patent in respect of the same or substantially same invention, within six months from the date of such filing. Failure to disclose the above said information required by Section 8 is one of the grounds for revocation of the Patent under Section 64(1)(m) of the Patents Act.

In *Maj. (Retd.) Sukesh Behl & Anr. v. Koninklijke Philips Electronics* [FAO(OS) 16/2014, Order dated November 7, 2014], the Appellant filed a counter-claim for revocation of the suit patent under Section 64(1)(m) of the Patents Act for non-compliance of the provisions of Section 8. The Plaintiff admitted this but submitted that the omission being unintentional, clerical and on account of a bona fide error on the part of the Patent Attorney, it can be allowed to amend the specifications at any stage of the proceedings in terms of Section 58 of the Patents Act and therefore, invalidation of the Patent in question is not warranted. The Single Judge held that omission to comply with Section 8 of the Patents Act would lead to revocation of patent only if the information so withheld by the Patentee was material to the grant of the patent. The Defendant challenged this decision of the Single Judge before the Division Bench.

Section 8 of the Patents Act states as under:

*Section 8. Information and undertaking regarding foreign applications.—(1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title from him, he shall file along with his application or subsequently [within the prescribed period as the Controller may allow—*

*(a) a statement setting out detailed particulars of such application; and*

*(b) an undertaking that, up to the date of grant of patent in India, he would keep the Controller informed in writing, from time to time, of detailed particulars as required under clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.*

Section 64 of the Patents Act states as under:

*Section 64. Revocation of patents.—(1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may, be revoked on a petition of any person interested or of the Central Government by the Appellate Board or on a counter-claim in a suit for infringement of the patent by the High Court on any of the following grounds, that is to say—*

*(a) to (l) ... ..*

*(m) that the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has furnished information which in any material particular was false to his knowledge;*

The Appellants submitted that the expression “shall” in Section 8(1) of the Patents Act casts a mandatory duty upon an applicant for a patent to furnish the information about prosecution of the similar application abroad and failure to furnish such information would straightaway attract the revocation provisions of Section 64(1). Pointing out that Section 64(1) opens with the words ‘subject to the other provisions contained in this Act’, Appellants further contended that the exceptions contained in Sections 34 and 58 of the Patents Act are not applicable to Section 64(1) and, therefore, the exercise of power of revocation under Section 64(1) does not involve the element of discretion. While seeking to draw a distinction between the two parts of Clause (m) of Section 64(1), i.e., (i) failure to disclose the information required by Section 8 and (ii) disclosure of / furnishing false information, it was also contended that the question whether the information is material to the grant of the patent is relevant only for the purpose of the second part but not for the purpose of the first part.

The Court held that the fact that the Plaintiff filed the details of the corresponding foreign application on 31.08.2004 is not in dispute, however, the same is not the complete information and according to the Plaintiff, the omission to furnish a part of the information, which is stated to be not material to the grant of the suit patent, was not deliberate. That being so, it cannot be straightaway concluded that the Plaintiff had failed to comply with the mandatory provisions of Section 8(1) of the Patents Act. As rightly held by the learned Single Judge, the said question can be answered only at the conclusion of the trial.

The Court further held that it is no doubt true that it is mandatory to comply with the requirements under Section 8(1) of the Patents Act and non-compliance of the same is one of the grounds for revocation of the patent under Section 64(1)(m) of the Patents Act. However, the fact that the word “may” is used in Section 64(1) itself indicates the intention of the legislature that the power conferred thereunder is discretionary. The mere fact that the requirement of furnishing information about the corresponding foreign applications under Section 8(1) is mandatory, in our opinion, is not the determinative factor of the legislative intent of Section 64(1). The language of Section 64(1) is plain and unambiguous and it clearly confers a discretion upon the authority/Court while exercising the power of revocation. The Court accordingly held that though any violation of the requirement under Section 8 may attract Section 64(1)(m) for revocation of the patent, such revocation is not automatic.

## **Delhi High Court Passes John Doe Order in favour of Sandisk**

The Plaintiff submitted that there are certain unknown persons, who were initially selling counterfeit products with the identical name SanDisk, SanDisk Logo and with an identical packaging from Daryaganj, Old Delhi, and after passing of injunction orders they have changed their modus operandi and they are now selling counterfeit products through makeshift Sunday markets at Daryaganj, Old Delhi. It was further submitted that during investigation, it is found that large numbers of stalls are set up all across the pavements at Daryaganj to sell the counterfeit SanDisk Micro SD Memory Cards with an identical packaging, as that of the Plaintiff.

The Plaintiff also filed photographs along with the plaint to show how in the Daryaganj market the products are being sold in large quantities on the floor. It was also submitted that it is impossible to identify the names of such persons as they are primarily fly-by night operators, they sell counterfeit products and thereafter vanish to avoid the orders of injunction.

The Plaintiff therefore prayed for an ex parte ad interim injunction on the ground that common unwary customers are being misled on account of the illegal activities of such persons, who are selling counterfeit products with the mark of the Plaintiff SanDisk, when it is found that the product is not only substandard but in fact cannot put to any use, which tarnishes the reputation and image of the Plaintiff. The Plaintiff also prayed for a John Doe order to effectively take action against the unknown infringers.

The Court held that it is a fit case for grant of ex parte ad interim injunction, and held that “[t]he unnamed and undisclosed persons arrayed as ‘John Doe/s’ are restrained from manufacturing, selling, offering for sale, advertising, directly or indirectly, dealing in counterfeit products, which are identical to the products bearing the plaintiff’s Trade mark SanDisk and logo marks and the ‘Red Frame’ logo, with identical product packaging, product get-up, colour scheme, layout, overall look and feel as that being used by the plaintiff.” The Court also appointed Local Commissioners to seize and take into possession the counterfeit memory cards bearing the Plaintiff’s SanDisk word and logo marks and/or the Red Frame logo with or without the product packaging, and also make a list of particulars of those persons with their identification proof, if possible, found in possession of such counterfeit products.

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