



“COLLECTOR’S CHOICE” held deceptively similar with “OFFICER’S CHOICE”

The Plaintiff filed a suit [*M/s Allied Blenders & Distillers Pvt. Ltd. v. Shree Nath Heritage Liquor Pvt. Ltd.*, CS(OS) No. 2589/2013] for permanent injunction against the Defendant alleging that the mark “COLLECTOR’S CHOICE” is deceptively similar with the mark “OFFICER’S CHOICE”.

The Plaintiff claimed that it is engaged inter alia in the business of manufacturing and marketing of alcoholic beverages including Indian Made Foreign Liquor. It coined and adopted the trade mark “OFFICER’S CHOICE” in the year 1988 and is the registered proprietor of the mark since 2007.

The Plaintiff alleged that the Defendant is also engaged in the business of blending, manufacturing, producing, bottling and selling alcoholic beverages and is selling whisky under the mark “COLLECTOR’S CHOICE” which is conceptually identical and deceptively similar to its trade mark “OFFICER’S CHOICE”.

The Defendant submitted that the trade mark registrations claimed by the Plaintiff do not give the Plaintiff any exclusive right over the use of the word “Choice”; the registrations granted to the Plaintiff are conditional i.e. the registration is subject to the condition that the Plaintiff shall not claim any rights on the words “Choice” or “Whisky”. The Defendant further submitted that

the Plaintiff cannot claim monopoly rights over the common dictionary word “Choice” and it is open to all traders to adopt such word and use the same in such a manner that their trade mark is distinguishable from the other trader’s mark.

The Court held that the customer’s/ consumer’s memory is likely to mix “Officer” with “Collector”, the possibility of trademark “OFFICER’S CHOICE” of the Plaintiff being remembered/recalled as “COLLECTOR’S CHOICE” cannot be ruled out. A Collector is the highest point of officialdom/authority in a district and with whom nearly every citizen of that district comes in contact with or knows of. For a resident of a district who may not in his entire life time be stepping out of that district (and of which there is a large number), the Collector is the only officer and to them the other authorities in the country hold no meaning. The possibility of a customer/consumer of the alcoholic product of the plaintiff remembering the product of the Plaintiff as Collector’s Choice cannot be ruled out. Not only so, even if the customer remembers the mark “OFFICER’S CHOICE”, he can be easily fooled into buying a superior product of the same manufacturer or another product of the same manufacturer and is likely to again be fooled by the association between ‘Officer’ and ‘Collector’.

The Court accordingly extended the *ex parte* interim injunction obtained by the Plaintiff in 2013 till the suit is finally decided.

Indian Patents Office issued revised Guidelines for examination of pharmaceutical patents

The Indian Patents Office has issued (on August 12, 2014) revised Guidelines for examination of pharmaceutical patents to help Examiners and the Controllers of the Patent Office in achieving uniform standards of patent examination and grant. The scope of the Guidelines is as under:

“The present guidelines are prepared with the objective that the Guidelines will help the Examiners and the Controllers of the Patent Office in achieving consistently uniform standards of patent examination and grant. The guidelines set out below contain, where feasible, certain illustrations. These illustrations are not intended to exhaust the manner in which the relevant guidelines are to be applied in practice. Examiners are requested to examine applications on a case-to-case basis, without being prejudiced by the specific illustrations being provided herein. In case of any conflict between these Guidelines and the Patents Act, 1970 and the Rules made thereunder, the provisions of the Act and Rules will prevail.”

Some of the Guidelines are discussed hereunder.

Prior Art Search

The Guidelines provide that while conducting a prior art search, the Examiner should design/frame a comprehensive search strategy by combining various search parameters including key words, IPC, compound searches, etc. and thorough search should be carried out in patent as well as non-patent databases.

When the patent specification disclose International Non-proprietary Names (‘INN’) of

the pharmaceutical substances involved, the Examiner should search the prior art on the basis of such INNs as well. In case it is found that the Applicant claims the second use/indication in the form of a product claim of an already known pharmaceutical compound/new form of a known substance or compound, the examiner should follow the same methodology and ask the Applicant to inform the INN of the said pharmaceutical substance. If the Applicant does not inform the INN even on the request, the examiner should try to find out the INN and use the same in the search strategy.

Novelty

The Guidelines provide that while assessing novelty (as distinct from inventive step), it is generally not permitted to combine separate items of prior art together. It is also not permissible to combine separate items belonging to different embodiments described in one and the same document, unless such combination has specifically been suggested or essentially linked to one another. A generic disclosure in the prior art may not necessarily take away the novelty of a specific disclosure. A specific disclosure in the prior art takes away the novelty of a generic disclosure.

Sometimes the prior art may inherently disclose the subject matter of an invention. A patent is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention. The prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating prior art. It is not necessary that

inherent anticipation requires that a person of ordinary skill in the art at the time would have recognized the inherent disclosure. But it is necessary that the result is a necessary consequence of what was deliberately intended in the invention.

Inventive Step

The Guidelines provide a method of objectively analysing the inventive step:

- (a) Identify the inventive concept of the claim in question;
- (b) Identify the “person skilled in the art”;
- (c) Identify the relevant common general knowledge of the person skilled in the art at the priority date;
- (d) Identify what, if any, differences exist between the matter cited as forming part of the “state of the art” and the inventive concept of the claim;
- (e) Viewed without any knowledge of the alleged invention as claimed, do those differences constitute steps which would have been obvious to the person skilled in the art or do they require any degree of inventive ingenuity?

Prior art for determining inventive step constitutes any “existing knowledge”. In other words, inventive step is determined vis-à-vis any matter published in any document anywhere in the world or any use before the priority date of the application. Unlike the novelty, mosaicking of prior art documents is permissible in the context of inventive step.

Industrial Applicability

The Guidelines provide that the specification should disclose the usefulness and industrial applicability of an invention in a distinct and credible manner unless the usefulness and

industrial applicability of the invention is already established, either in explicit or in implicit manner. The patent specification must disclose a practical application and industrial use for the claimed invention wherein a concrete benefit must be derivable directly from the description coupled with common general knowledge. Mere speculative use or vague and speculative indication of possible objective will not suffice.

Sufficiency of Disclosure

The Guidelines provide that the complete specification shall fully and particularly describe the invention and its operation or use and the method by which it is to be performed and it should also disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection.

If the invention relates to a biological material which is not possible to be described in a sufficient manner and which is not available to the public, the application shall be completed by depositing the material to an International Depository Authority (IDA) under the Budapest Treaty. The deposit of the material shall be made not later than the date of filing of the application in India and a reference of the deposit shall be given in the specification within three months from the date of filing of the patent application in India.

While assessing the sufficiency of disclosure, it must be ensured that the best method for performing the invention is described so that the whole subject-matter that is claimed in the claims, and not only a part of it, must be capable of being carried out by a skilled person in the relevant art without the burden of an undue amount of experimentation or application of inventive ingenuity.

Amendment in Trade Marks Rules, 2002

The Trade Marks Rules, 2002 has been amended with effect from August 1, 2014 vide Trade Marks (Amendment) Rules, 2014. The Amendment seeks to increase the official fee for filing trademark application and expedited examination.

The official fee for filing of application to register a trade mark for a specification of goods or services included in one class has been increased from Rs. 3,500 to Rs. 4,000.

The official fee for filing fee for expedited examination has been increased from Rs. 12,500 to Rs. 20,000.

The Trade Marks Office has issued notification dated August 7, 2014 stating that the increased official fee is effective from August 1, 2014. All applicants who have filed trademark application or request for expedited examination from August 1, 2014 onwards are supposed to pay the deficit fee on or before September 30, 2014. The Registrar would not act in the matter until the deficit fee is paid by the applicant. The payment of deficit fee after September 30, 2014 would result in shifting of filing date to the actual date of payment of deficit fee.

India launches ‘.Bharat’ domain names in seven regional languages

India has finally launched the ‘.Bharat’ domain names in seven regional languages, including Hindi, Konkani and Marathi. The website owners can now choose not only ‘.in’, but also from .भारत (Devnagiri), .భారత్ (Telugu), .بھارت (urdu), .ভারত (Bangla), .ભારત (Gujrati), .இந்தியா (Tamil), .ਭਾਰਤ (Punjabi) etc.

International Corporation for Assigned Names and Numbers (ICANN) has delegated IDN in seven Indian Languages to NIXI.

The launch of the ‘.Bharat’ Domain Names would increase the penetration of the Internet through the use of local languages and help penetrate local content since only a segment of Indian population is English.

To avoid cybersquatting, the IN Registry has launched a ‘sunrise period’ for Indian registrants holding Indian trade marks (from August 15, 2014 to September 15, 2014), overseas registrants holding Indian trade marks (from September 1, 2014 to September 15, 2014) and existing registrant holding ASCII domain name .in (from October 1, 2014 to October 31, 2014).

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