



John Doe Order Granted for the Movie ‘Happy New Year’

The Producer of the movie ‘Happy New Year’ filed a suit [*Red Chillies Entertainments Private Limited v. Hathway Cable & Datacom Limited & Ors.*, Suit(L) No. 993/2014] in the Bombay High Court seeking John Doe order apprehending that, based on their previous experience, there is a likelihood of pirated copies of this film being released on different media, including Blu-Ray, CD, DVD, VCD etc., and even of the film being transmitted through the service of Defendants or through cable service operators.

The Order restrains any person from “*telecasting/broadcasting/distributing/putting on the cable TV network/disseminating/ reproducing or otherwise making available to the public, the film ‘Happy New Year’*” or “*from (i) making a copy of the said film, including a photograph of any image forming part thereof, (ii) to sell or give on hire, or offer for sale or hire, any copy of the said film, regardless of whether such copy has been sold or given on hire on earlier occasions, (iii) to communicate the film to the public in any manner whatsoever including by way of but not limited to telecasting and/or re telecasting the said film, or even otherwise dealing with the rights in the said film which vest exclusively in the Plaintiff, in any manner whatsoever.*”

Indian Patents Office Launches Online Tools to Obtain Real-time Information on Patent Applications

The Controller General of Patents, Designs and Trademarks has now launched online features to search information about patents. This also includes stock and flow facility which shows stock and flow of patent applications at different stages and locations on a real time basis on the official website of the Indian Patents Office.

The newly added features allow search of granted and published patents, access to examination reports, status of patent and other information regarding patent application on a real time basis.

These features include information about expired patents, disposed-of patent applications, first examination reports, published patent applications, refused/abandoned patent applications etc.

These features were already available for trademark applications and have now been extended for the patents applications as well. The added features are a big step towards boosting transparency at the Indian Patents Office.

Jurisdiction in E-Commerce IP Disputes – Selling of Goods Over Internet Amounts to “Carrying of Business” in the Jurisdiction of the Purchaser

The Plaintiff filed a suit [*World Wrestling Entertainment v. M/s Reshma Collection & Ors.*, CS(OS) 1801/2013] seeking permanent injunction based on alleged infringement of its copyright, infringement of its trademarks, passing off, dilution, rendition of accounts, damages and delivery up etc.

The learned Single Judge of the Delhi High Court passed an order whereby the plaint filed by the Plaintiff was directed to be returned to the Plaintiff under Order 7 Rule 10 of the Code of Civil Procedure, 1908, to be presented before a court of competent jurisdiction. The Plaintiff filed an appeal before the Division bench against this order.

The Plaintiff is, inter alia, engaged in the development, production and marketing of television programming, pay-per-view programming, live events and the licensing and sale of branded consumer products featuring its well-known World Wrestling Entertainment (“WWE”) brand. The WWE scratch logo and WWE are registered trademarks of the Plaintiff worldwide including India. The Plaintiff is also the owner of the copyright of the pictorial representations of WWE and WWE Wrestlers and the WWE scratch logo as they appear on various publicity materials and promotional merchandise of the appellant/ plaintiff. The Plaintiff also has trademark registrations in respect of various WWE talent names and talent slogans such as JOHN CENA, BATISTA, UNDERTAKER, TRIPLE H, RANDY ORTON etc.

The Plaintiff alleged that the Defendants, who are stationed at Mumbai, are engaged in the business of manufacture and sale of various forms of garments and apparel, such as T-shirts, wrist bands, caps and other counterfeit goods and garments bearing the reproductions of the Plaintiff’s registered trademarks and well-known WWE characters.

The learned Single Judge held that an essential part of the Plaintiff’s business, coupled with an element of control exercised by the Plaintiff, must exist in such a place where the Plaintiff claims to be “carrying on business” either on its own or through an exclusive agent. The learned Single Judge also observed that merely because of the e-commerce models, which have become prevalent, and because of the use of the internet as a medium for doing business, the tests, which apply for determination of issues, such as, when and where the contract is made or whether the vendor carries on business at the place where the merchandise may be sold, or service may be offered, would not change and would be the same as applicable to communications over the telephone and fax.

The Plaintiff invoked the territorial jurisdiction of the Delhi High Court under Section 134(2) of the Trade Marks Act, 1999 and Section 62(2) of the Copyright Act, 1957. Both the provisions states that a suit for trademark/copyright infringement may be filed in a Court, within the local limits of whose jurisdiction, at the time of institution of the suit, the person instituting the suit, actually and voluntarily resides or carries on business or personally works for gain.

Insofar as the present case is concerned, it is not claimed by the Plaintiff that it resides or personally works for gain in Delhi. The Plaintiff has claimed that it has filed the instant suit before the Delhi High Court since it “carries on business” in Delhi because, according to it, its programmes are broadcast in Delhi; its merchandise and books are available for sale in Delhi; and its goods and services are sold to customers in Delhi through its website which can be accessed in Delhi over the internet.

The Division Bench also observed that to constitute “carrying on business” at a certain place, the essential part of the business must take place there. The necessary question therefore was that when a transaction takes place over the internet, where is the contract concluded?

The Court held that:

“[i]f the contracts and/ or transactions entered into between the Plaintiff on the one hand and its customers are being concluded in Delhi, can it not be said that the essential part of the business of the Plaintiff, insofar as its transactions with customers in Delhi are concerned, takes place in Delhi? The offers are made by customers at Delhi. The offers are subject to confirmation/ acceptance of the Plaintiff through its website. The money would emanate or be paid from Delhi. Can it not then be considered that the Plaintiff is, to a certain extent, carrying on business at Delhi? In our view, it would be so. Because of the advancements in technology and the rapid growth of new models of conducting business over the internet, it is possible for an entity to have a virtual presence in a place which is located at a distance from the place where it has a physical presence. The availability of transactions through the website at a particular place is virtually the same thing as a seller having shops in that place in the physical world. Let us assume for the sake of argument that the Plaintiff had a shop in Delhi from where it sold its various goods and services. In that case, it could not be denied that the Plaintiff carried on business in Delhi. This is apart from the fact that the Plaintiff may also have been regarded as having voluntarily resided in Delhi. When the shop in the ‘physical sense’ is replaced by the ‘virtual shop’ because of the advancement of technology, in our view, it cannot be said that the Plaintiff would not carry on business in Delhi.”

The Division Bench accordingly set aside the order of the Single Judge and restored the suit.

Delhi High Court Passes Directions to Address Pendency of Patent Applications

The Delhi High Court recently examined [*Nitto Denko Corporation v. Union of India & Ors.*, W.P.(C) 3756/2013] the issue of inordinate delay in examination of patent applications and passed following directions:

1. The Ministry of Commerce and Industry and other concerned Ministries to take urgent steps so that posts proposed in the plan scheme of Modernisation and Strengthening of Intellectual Property Offices (MSIPO) could be created within a period of 9 months to enable issue of first examination reports within reasonable time.
2. The Government to consider additional outlay apart from Rs. 309.6 crores already approved by the cabinet Committee under the 12th Plan for creation of further posts of Examiners and Recruitment/ Training of the newly recruited examiners.
3. The Government will further expedite the creation of posts sought under the 12th Plan in consultation with Department of Expenditure and Department of Personnel and Training within a period of 9 months.
4. The DIPP/Government may explore alternative methods of recruitment of examiners through UPSC, IITs or by using the second obtained through GATE/NET examination.
5. It is also directed that efforts should be made to ensure that the Flexible Complementing Scheme as approved by the committee is implemented at the earliest in consultation with other concerned departments specially Department of Personnel and Training and the Department of Science and Technology for immediate implementation in the Indian Patent Office in order to resolve the issue of attrition.

For private circulation only. The information provided in the Newsletter is for information purposes only and in no circumstances should be construed as a legal advice. Any queries that you may have can be directed at ip@wlg.co.in.