



INDIA

MARKET OVERVIEW

AT A GLANCE

Intellectual Property Office

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India's pharmaceutical industry has been making headlines for many years, but in 2012 it took centre stage with several high-profile patent cases. In March, India issued the country's first compulsory licence, allowing Natco to legally manufacture and sell a low-cost generic version of Bayer's patented cancer drug Nexavar at a fraction of the cost. The compulsory licence was granted on the grounds that the drug made available by Bayer was only affordable to a very small number of patients.

A series of patent cancellations also grabbed headlines, namely the revoking of Pfizer's patent on cancer drug Sutent and Roche's patent on Pegasys, a hepatitis medication. Britain's AstraZeneca was also refused patent protection by the IPAB for its cancer drug, Gefitinib.

The general consensus is that the Indian government is trying to increase healthcare access by making cheaper generic drugs available to a wider population, with the lack of innovation as the cited reason for patent revocations. Nevertheless, multinational pharmaceutical companies are increasingly concerned that these decisions undermine IP rights in India. With the likelihood of more compulsory licences in the future,

practitioners expect to see more patent litigation.

On the trade mark side, it has been another year of talk and little progress on accession to the Madrid Protocol. The Trade Mark Office has managed to reduce the substantial backlog from the previous year, but administrative delays are still expected until the entire backlog is cleared. One practitioner notes: "We have been talking about India joining the Madrid Protocol for several years now and with the backlog at the trade mark office, realistically, I do not think India will be joining this year."

One of the major changes to the Trade Marks (Amendment) Act 2010 is Section 23(i), stating that the registration process for a mark is to be completed within 18 months of application filing, bringing India in line with Madrid Protocol requirements. Given the current situation at the Trade Mark Office, this presents a huge challenge.

The most notable trade mark case in 2012 concerned the principle of international exhaustion and the notion of parallel imports. The Delhi High Court Divisional Bench's ruling in the *Samsung Electronics v Kapil Wadhwa* case held that the principle of international exhaustion of trade marks

applies, and that legitimate goods purchased in a different jurisdiction may be sold in India without violating the brand owner's trade mark.

The Copyright (Amendment) Act 2012 finally came into effect in June, signalling a new era of extended rights for artistic work, cinematographic films and sound recordings. The Act now declares authors as owners of royalty rights, which cannot be assigned to producers, as was the practice till now. It will benefit lyricists, composers and people with disabilities, and extend to unpublished work. It is now compulsory for radio stations and broadcasters to pay royalties every time they air a recording.

Tier 1 and tier 2 firms

Delhi-based **Amarjit & Associates** offers expertise in all areas of intellectual property and is known for its contentious practice, particularly trade mark and copyright litigation. Headed by managing partner Amarjit Singh, this firm has an international reach with offices in New York and Zurich.

Highly respected managing partner Pravin Anand of **Anand and Anand** is a renowned figure in the contentious field. As one of the largest IP firms in India with over 80 professionals, this firm represents multinational corporations from a diverse range of industries. Offering a full range of IP services, the firm is one of the leading firms for contentious issues with Anand leading a team of skilful litigators that includes senior partner Safir Anand.

The firm is representing several pharmaceutical giants on the validity of their drug patents in India. One such case is Novartis versus Union of India at the Supreme Court, where on behalf of Novartis Anand and his team faced off against 10 opposing firms for nearly over two months. The judgment is pending.

In a similar case, the firm is representing

Roche in a patent infringement case against local drug manufacturer Cipla over a patented anti-cancer drug marketed as Tarceva. The decision is on appeal before the Division Bench of the Delhi High Court.

De Penning & De Penning is one of the oldest IP law firms in India with a history dating back over 150 years. With offices in Chennai, New Delhi, Calcutta and Mumbai the firm is widely recognised as a trade mark specialist. Clients range from Fortune 500 companies, research institutes and universities to individuals, both domestic and foreign.

The firm's large number of IP attorneys combined with its specialist experience ensures it is able to handle a high volume of work across all areas of intellectual property.

DP Ahuja & Co is a dedicated full-service IP law firm specialising in patent and trade mark prosecution and litigation. The firm's strength is in patent drafting, patent prosecution and technology infringement analysis in the pharmaceutical, software, electronics and telecommunications industries.

Besides prosecution and litigation, the firm also focuses on IP management by advising clients on branding and product labelling.

In addition to intellectual property, **Intl Advocare** also focuses on information technology and consumer protection law. Under the guidance of managing partner Hermant Singh, its focus is on IP protection and enforcement and has been involved in many infringement and passing off cases. Singh is a registered patent agent and also specialises in unfair competition law, consumer protection law and cyber law.

He is supported by senior partner Prietika Singh who heads the trade mark, copyright and design prosecution team.

K&S Partners is one of largest patent filers in India which is reflected in its tier 1 status for both patent prosecution and contentious work.

SURVEY RESULTS

PATENT
PROSECUTION**TIER 1**

K & S Partners
Remfry & Sagar
S Majumdar & Co

TIER 2

Anand and Anand
D P Ahuja & Co
De Penning & De Penning
Krishna & Saurastri Associates
Lakshmi Kumaran & Sridharan
Subramaniam Nataraj & Associates

TIER 3

Aditya & Associates
Groser & Groser
Kan & Krishme
Khaitan & Co
Lall Lahiri & Salhotra
LexOrbis IP Practice

TIER 4

Amarchand & Mangaldas & Suresh A
Shroff & Co
Chadha & Chadha
HK Acharya & Co
Khurana & Khurana Advocates & IP
Attorneys
Mohan Associates
Obhan & Associates
R K Dewan & Co
Zeus IP

TIER 5

Inttl Advocare
L S Davar & Co
SKS Law Associates

PATENT
CONTENTIOUS**TIER 1**

Anand and Anand
K & S Partners
Remfry & Sagar
Singh & Singh

TIER 2

Lakshmi Kumaran & Sridharan
Lall Lahiri & Salhotra
Saikrishna & Associates
Subramaniam Nataraj & Associates

TIER 3

Amarchand & Mangaldas & Suresh A
Shroff & Co
De Penning & De Penning
HK Acharya & Co
Kan & Krishme
Khaitan & Co
Krishna & Saurastri Associates
LexOrbis IP Practice
Obhan & Associates
S Majumdar & Co

TIER 4

Aditya & Associates
Amarjit & Associates
Chadha & Chadha
D P Ahuja & Co
Inttl Advocare
Khurana & Khurana Advocates & IP
Attorneys
Mohan Associates
Perfexio Legal
Sushant M Singh & Associates

SURVEY RESULTS

TRADE MARK PROSECUTION

TIER 1

Anand and Anand
Remfry & Sagar

TIER 2

De Penning & De Penning
Krishna & Saurastri Associates
Lall & Sethi Advocates
Lall Lahiri & Salhotra

TIER 3

D P Ahuja & Co
Inttl Advocare
K & S Partners
Kan & Krishme
R K Dewan & Co

TIER 4

Aditya & Associates
Amarjit & Associates
Chadha & Chadha
Fidus Law Chambers
Khaitan & Co
Lakshmi Kumaran & Sridharan

Legasis Partners
LexOrbis IP Practice
Luthra & Luthra
Ranjan Narula Associates
S S Rana & Co
Sushant M Singh & Associates
YJ Trivedi & Co
Zeus IP

TIER 5

Amarchand & Mangaldas & Suresh A
Shroff & Co
Ascentials
HK Acharya & Co
IP Gurus
Jehangir Gulabbhai & Bilimoria &
Daruwalla
Khurana & Khurana Advocates & IP
Attorneys
LS Davar & Co
Mohan Associates
Mulla & Mulla & Craigie Blunt & Caroe
Obhan & Associates
Saikrishna & Associates

Peers recognise the firm's patent prosecution expertise.

D Calab Gabriel is an important member within the firm, practising as an advocate and patent attorney for over 20 years. He has extensive experience in filing, prosecution and enforcement of patents and has advised the Government of India on various IP issues. He is actively involved in coordinating the patent prosecution and patent litigation aspects of the firm.

Krishna & Saurastri has a solid reputation for providing the complete range of IP services. Headquartered in Mumbai and with offices in

Ahmedabad, Bangalore, New Delhi and Pune, the firm's clients include multinationals and Indian corporations.

The firm's professionals have expertise in pharmaceuticals, biotechnology, engineering and electronics. Widely recognised for its trade mark expertise, the firm has represented Merck and Charak Pharma in trade mark infringement and passing-off cases. Partners Manish Saurastri, Sunil Krishna and advocate Rahul Dhote handle the firm's high profile cases.

Lakshmikumaran & Sridharan is a large and well-established law firm specialising in

SURVEY RESULTS

TRADE MARK
CONTENTIOUS**TIER 1**

Anand and Anand
Lall & Sethi Advocates
Lall Lahiri & Salhotra
Singh & Singh

TIER 2

Inttl Advocare
Remfry & Sagar
Saikrishna & Associates

TIER 3

Amarjif & Associates
K & S Partners
Krishna & Saurastri Associates
Ranjan Narula Associates
R K Dewan & Co
WS Kane & Co
YJ Trivedi & Co

TIER 4

Aditya & Associates
Amarchand & Mangaldas & Suresh A
Shroff & Co

tax, international trade and intellectual property across seven offices. The IP practice has experienced rapid growth in recent years and is well known for its patent work, especially in life sciences and plant variety protection. Dr Malathi Lakshmikumaran is director of the firm's life sciences practice and is highly regarded in this field. One peer notes: "I have huge respect for Dr Malathi for the work she has done in life sciences." She successfully represented Bayer in challenging the notion of novelty of parental lines under the Protection of Plant Varieties and Farmers' Right Act.

D P Ahuja & Co
De Penning & De Penning
Fidus Law Chambers
IP Gurus
Kan & Krishme
Khaitan & Co
Legasis Partners
Luthra & Luthra
Mason & Associates
S S Rana & Co
Sushant M Singh & Associates
Zeus IP

TIER 5

Jehangir Gulabbhai & Bilimoria & Daruwalla
Khurana & Khurana Advocates & IP Attorneys
LS Davar & Co

In 2012, the firm recruited KS Ramanujan as director as well as several patent analysts as it looked to build on its growing patent and trade mark portfolio practice, which boasts as clients leading national and international corporations such as Tata Consultancy Services, Merck, Alcatel Lucent, SAP and Bharti Airtel.

The firm's copyright practice led by Rahul Beruar is quickly gaining a reputation for protecting copyright holders after several successful copyright cases, the first representing SAP in getting a damages award of Rs 3,000,000 (\$55,000), and the second

involving Shiv Khara's copyrighted work *You Can Win*.

Lall & Sethi is a boutique intellectual property firm with a strong focus on trade marks and copyright. The firm's in-house litigation team led by partner Chander Lall has been acknowledged by clients and peers alike. Well known for its litigation practice, the bulk of its workload remains trade marks though the firm has recently ventured into patent work. It has been busy with trade mark and copyright infringement work and on its strength in these fields, it retains its top-tier status.

As one of the fastest growing IP firms in India, **Lall Lahiri & Salhotra** continues to gain an impressive list of clients that includes ExxonMobil, Roche, Heinz, Reckitt Benckiser and Reed Elsevier. This full service firm handles both contentious and non-contentious matters, but has really made an impact on trade mark contentious work.

In 2012, the firm successfully represented AP Moller-Maersk in a trade mark infringement case where the defendant used the word Maersk in its company name. In another trade mark infringement case it successfully represented New America Trading at the Delhi High Court in a case involving the phrase NAI. The plaintiff had terminated the licence agreement and the defendant continued to use the trade mark despite the termination.

Recently, the firm recruited a number of senior associates from rival firms such as Anand and Anand and Lakshmikumaran & Sridharan.

Luthra & Luthra is only one of a few general practice law firms in India to be ranked in the top tiers for intellectual property. The IP practice is fully integrated into the firm's multidisciplinary practice.

Clients range from small start-up companies to large national and multinational corporations. Large clients include Abbott Laboratories, Microsoft, Dell, Reed Elsevier,

United Breweries and the government of India's Ministry of Commerce.

Apart from prosecution work the IP practice advises on licensing and franchising transactions. One of the firm's many strengths is its litigation practice, and it has represented clients in patent infringement and revocation, and trade mark passing off cases. Gayatri Roy is the standout professional in the IP department.

Neel Mason of **Mason & Associates** leads a small dedicated team in Delhi specialising in trade mark and copyright. This year the firm's copyright practice moved up from tier 3 to tier 2 following its work in several of the biggest music copyright cases. A peer notes: "Mason & Associates has been doing a lot of copyright related work recently and Neel [Mason] is slowly making a name for himself." The copyright sector is expected to be very active following the amendment to the Copyright Act passed June last year, and many predict protracted battles between lyricists and radio broadcasters over the payment of royalties.

Remfry & Sagar is one of the stand-out firms in India's IP sector with a long history dating back to the 1820s. A full-service IP firm with offices in New Delhi and Chennai, it has 31 professionals in the patent department, 39 in the trade mark department and three lawyers. The firm has thousands of clients that span the globe. With a sizeable amount of inbound trade mark and patent work, the firm cements its status as a tier 1 firm for both patent and trade mark prosecution.

On the client front, the firm boasts an impressive list with household names such as Sony, American Express, BP, Red Bull, Pfizer and AstraZeneca.

One of the firm's top cases in 2012 was the longstanding litigation between the Financial Times and Times Publishing House, which started in 1993 and continues today. The firm is representing the Financial Times in a claim of trade mark infringement against Times

Publishing House, over three registrations by the Financial Times and one by Times Publishing over the trade marks Financial Times and FT. Following a series of trade mark cancellations by the Intellectual Property Appellate Board and Registrar of Trade Marks, a judgment on an appeal was delivered in April by way of common order, cancelling both parties' marks. However, both parties have challenged the IPAB's order and issued a writ. The order has been stayed pending disposal of the writs.

Saikrishna & Associates has a renowned IP litigation practice led by managing partner Saikrishna Rajagopal. The firm's strength lies in trade mark and copyright, with Microsoft, Pfizer and Walt Disney amongst its clients. Rajagopal is also considered a leading figure in anti-piracy notably in the software industry. He is joined by ex-Luthra & Luthra partner Ameet Datta who will focus on media, entertainment and technology. The firm now has six partners and a total of 42 lawyers.

Boutique firm **S Majumdar & Co** practices all areas of intellectual property. Experienced in IP litigation, the firm handles both civil and criminal cases and its expertise ranges from pharmaceuticals and electronics to engineering. With the main office in Calcutta the firm serves other clients from its Delhi, Mumbai and Hyderabad offices. Founder and namesake Majumdar is well respected by peers.

Known for handling high profile contentious cases, Prathiba Singh from **Singh & Singh** is a recognised figure in the litigation field. Peers and clients are full of praise with one client noting: "We have been using Singh & Singh for nearly 10 years and the service has been outstanding. Prathiba is excellent and has hands-on experience in copyright law."

The firm has been making headlines representing local drug manufacturer Cipla in its patent infringement cases against Novartis and Roche, matters that have gripped India

SURVEY RESULTS

COPYRIGHT

TIER 1

Anand and Anand
Lall & Sethi
Saikrishna & Associates

TIER 2

Amarjit & Associates
Lall Lahiri & Salhotra
Luthra & Luthra
Mason & Associates
Remfry & Sagar
Singh & Singh

TIER 3

Amarchand & Mangaldas & Suresh A Shroff & Co
D P Ahuja & Co
DePenning & DePenning
Krishna & Saurastri
Lakshmi Kumaran & Sridharan
Mulla & Mulla & Craigie Blunt & Caroe
Nishith Desai Associates
Sushant M Singh & Associates
WS Kane & Co

TIER 4

Aditya & Associates
Legasis Partners
LS Davar & Co
Mohan Associates
Neolegal Associates
Solomon & Roy
Zeus IP

REGIONAL

SURVEY RESULTS

AHMEDABAD

RECOMMENDED FIRMS

Regional - Ahmedabad
 HK Acharya & Co
 Parker & Parker
 YJ Trivedi & Co

BANGALORE

RECOMMENDED FIRMS

A V Nathan Associates
 Holla Associates
 Krishnamurthy & Co
 Universal Legal

CHENNAI

RECOMMENDED FIRMS

DePenning & DePenning
 Mohan Associates
 Puthran & Associates
 Rights & Marks
 Selvam & Selvam
 Surana & Surana

KOLKATA

RECOMMENDED FIRMS

Anjan Sen & Associates
 D P Ahuja & Co
 D Sen & Co
 Daswani & Daswani
 LS Davar & Co
 S Majumdar & Co
 S S Datta & Associates

with the outcome likely to have a huge impact on drug patents and patients in India. *Novartis v Cipla* is pending before the Supreme Court of India, while in the *Roche* case the single judge of the Delhi High Court dismissed Roche's claim.

On the trade mark side, the firm represented DuPont in an infringement case against DuPont Hydro Industries, with the latter using the DuPont mark for its goods. The firm secured an ex-parte injunction and the case is pending.

Subramaniam Nataraj & Associates managing partner Hari Subramaniam leads a practice widely recognised for its patent work. Although offering the full range of IP services it is the patent prosecution work that is the stand-out feature, with a focus in biochemistry and pharmaceuticals. Subramaniam is a respected IP practitioner who has been contributing to India's IP sector for many years.

Other notable firms

The engineering and mechanical expertise at **Aditya & Associates** is a factor in the continuing growth of the firm. While trade mark and copyright work is slowly increasing, it is the patent work that is driving growth. The firm has an equal portion of domestic and international clients ranging from start-ups to SMEs to individual entrepreneurs.

The firm has been active in windmill and solar energy patents and has formed close ties with IP practitioners in the EU, US, Brazil, China and Australia. Vipul Bhuta and Mayuri Khobragade successfully helped Sony Entertainment and SAB Entertainment defend a copyright infringement and piracy claim brought by a plaintiff claiming to be a writer of one of Sony's and SAB's television serials.

IP Gurus is a relatively new firm based in New Delhi offering the complete range of services in both contentious and non-contentious fields. Trade marks is one of the

firm's strengths, having secured a preliminary injunction on behalf of some of the UK's most successful young fashion brands and successfully representing a large French truck manufacturer in a trade name dispute. The firm also has offices in Switzerland and Singapore, though the Delhi office is managed by Sujata Chaudhri.

The full-service IP practice at **Khaitan & Co** is one of the largest within general commercial law firms in India. The firm has close to 30 IP lawyers and attorneys in four offices located in Mumbai, Delhi, Calcutta and Bangalore. The firm's general litigators and corporate partners assist the IP team in disputes, sales, purchasing and licensing matters, while a dedicated team of specialists drafts patents across the engineering, science and technology sectors.

The team successfully represented Mahindra & Mahindra in bringing a trade mark infringement and passing off action against M and M Auto Industries over the M and M mark, which was similar to the former's mark M & M. The Bombay High Court

granted an interim order of infringement and passing off, restraining the defendant from using the infringing mark. The defendant was also ordered to remove mandm from its domain name.

IP remains the focus of **Obhan & Associates**, though the firm also has corporate and M&A, real estate and litigation practices. Recognised for its all-round IP services, it is the patent work that draws the most attention. Firm founder Essense Obhan leads a team of specialists in the chemical, biotech, electronic and nanotechnology sectors. Newly recruited Anupam Pandey heads the trade mark, copyright and entertainment practice.

The firm successfully represented Tata Chemicals in a patent revocation proceeding before the Intellectual Property Appellate Board against a patent granted to Hindustan Unilever. The issue was the applicability of Section 8 of the Patent Act and whether failure to disclose information as to foreign prosecution of a patent was grounds for revocation.