



Legally Rooted - Newsletter

October 2023 | Issue 02

Dear Readers.

Welcome to the 2nd Issue of Singh & Singh Law Firm LLP's Newsletter. We are delighted to present you with an overview of all the fascinating developments that have taken place in the realm of IP litigation over the last few months, since our last newsletter came out.

In this newsletter, we have covered the recent favourable judgment on patent and competition law issues that we helped obtain for our clients "Ericsson and Monsanto". We also examined other recent IP judgments and elucidated upon policy developments such as India's all new privacy legislation.

As always, our endeavour has been to present content on complex legal issues in a lucid and engaging manner.

In This Issue

Lead Story02

Singh & Singh Successfully Represents Ericsson and Monsanto in a Case Concerning Patent and Competition Law Dilemma. A brief on the landmark judgment on patent and competition law issues where we represented the successful appellants.

Judgments to Watch02

Some landmark judgments on intellectual property issues by the IP division of the Delhi High Court

The Digital Personal Data Protection Act, 202305

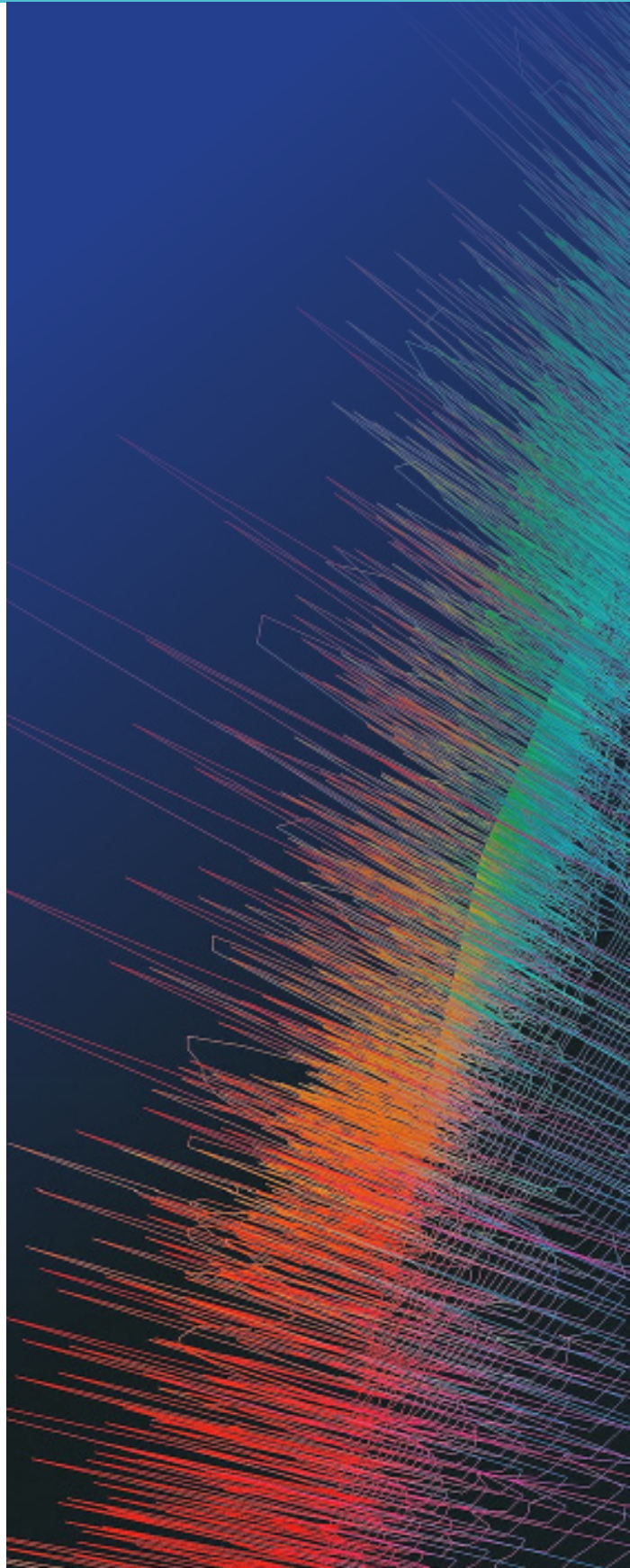
Singh & Singh Successfully Represents Ericsson and Monsanto in a Case Concerning Patent and Competition Law Dilemma

IP Tidbits06

Some interesting law and policy developments in IP and interrelated areas.

Firm Accolades07

Our humble achievements – rankings, awards, appointments etc. Thank you for your kind support.



SINGH & SINGH SUCCESSFULLY REPRESENTS ERICSSON AND MONSANTO IN A CASE CONCERNING PATENT AND COMPETITION LAW DILEMMA

The Hon'ble Delhi High Court, vide its judgment dated 13.07.2023 has quashed the CCI investigations into allegations of abuse of dominant position against Ericsson and Monsanto emanating from acts of exercising patent rights under the Patents Act, 1970. Key findings are as under

- a) The question whether a patent license will cause adverse effect on competition within India or will amount to abuse of dominant position is not reserved for CCI alone.
- b) Under the Competition Act, the CCI can examine anti-competitive agreements and abuse of dominant position affecting market conditions generally. However, since the Competition Act itself exempts the CCI from looking into reasonable conditions forming part of a license granted by a patentee, that is indicative of the legislature's intention to keep that assessment within the exclusive domain of the Patents Act.
- c) Patents Act is a complete code providing for all mechanisms for determination of unreasonable conditions being imposed by a patentee in grant of a license.
- d) The subject matter relevant to the dispute is anti-competitive agreements and abuse of dominant position by a patentee in exercise of their rights under the Patents Act, which is outside the realm of enquiry of the CCI.
- e) In this respect, the Patents Act being the special statute dealing with patents, the provisions thereof will prevail over those of the Competition Act on the issue of exercise of rights by a patentee under the Patents Act.
- f) If there is inter se settlement between parties, the CCI proceedings cease immediately as the very reason for initiation of the proceedings stood resolved.

JUDGMENTS TO WATCH

Patents

A. No Presumption of Validity Attached to A Granted Patent - Bayer Healthcare LLC v. NATCO Pharma Ltd., 2023 SCC OnLine Del 3921

On 05.07.2023, the Hon'ble Delhi High Court once again held that there is no presumption of validity attached to a granted patent, and that an old patent cannot be put on a higher pedestal than a recently granted one. REGORAFINIB, the drug that formed the subject matter of the dispute, is used for the treatment of metastatic cancer. The court clarified that the threshold for a defendant at the stage of interim injunction, is to prove vulnerability of the suit patent, as opposed to conclusive invalidity of the same, relying on the established principles of Roche Vs Cipla. On the basis of the admissions made by the plaintiffs, including the averment in the plaint itself – stating that REGORAFINIB is only “technically covered” in the genus patent – the court was inclined to refuse injunction, with a direction to the defendants to maintain complete accounts of manufacture. The Judgment falls in line with the earlier DAPAGLIFLON and LINAGLIPTIN line of judgements, which hold that a party cannot be allowed to renege out of its own admissions.

Trademarks

B. Disclaimer on a part of a mark does not bar the entire mark to be asserted for infringement - Zydus Wellness Products Ltd. v. Cipla Health Ltd., 2023 SCC OnLine Del 3785

A trade mark dispute arose between Zydus and Cipla, both renowned pharmaceutical and wellness Indian brands, with respect to infringement of Zydus' mark Glucon D/Glucon -C by Cipla' s mark Prolyte Gluco – D++/ Prolyte Gluco – C++ .

Holding Cipla's marks to be infringing Zydus' marks, the Court held that once a contention regarding invalidity of the Plaintiff's mark has been raised by the Defendant, the court has to take a view regarding the same at a prima facie stage. The validity of a trade mark can be challenged at the stage of interim injunction since Section 28(1) provides the rights of the registered proprietor of the trademark but qualifies the same with the words 'if valid', thus opening an avenue for the Defendant to challenge the validity of the mark in the defence itself. Another noteworthy observation of the court is regarding the effect of disclaimers in registered trademarks, since Zydus' Glucon -D/Glucon C had 'D' and 'C' disclaimed. The court held that the presence of a disclaimer does not mean that the disclaimed part should be omitted from the infringement inquiry, but that the proprietor cannot claim exclusivity on the disclaimed part.

DEFENDANTS' PRODUCTS	PLAINTIFF'S PRODUCTS
	
	

Designs

C. Designs Act protects an idea to be applied to an article and not an idea in Vacuo - Jayson Industries v. Crown Craft (India) (P) Ltd., 2023 SCC OnLine Del 3750



A mug, a tub and a bucket formed the subject matter of a design dispute recently adjudicated by the Hon'ble Delhi High Court.

The judgment succinctly puts across the legal position to be followed for adjudication of design infringement. The Court finds that a design is to be judged solely by the eye; the test is essentially ocular/visual, however ocular/visual appeal is not to be confused with "attractiveness". What matters is, whether the design is unique.

Further, an idea which is not intended for temporal manifestation cannot be protected. What the finished article would look like is primordial to the issue. The court also clarified that in order to destroy novelty,

1. The prior art should be published in respect of an article, Mere publication of the pattern, not applied to an article, is insufficient.

2. The next question would be what shape or pattern is disclosed by the prior art. The prior art must contain clear and unmistakable directions to make the article.

Items	View	Pictures
Bucket	Perspective	
	Front and back	

Copyright

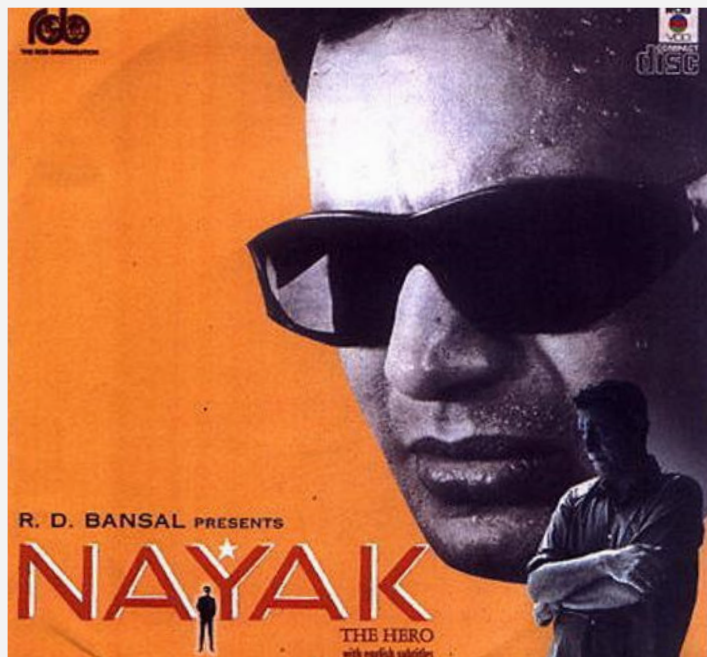
D. Universal City Studios LLC & Ors. Vs. Dotmovies.baby and Ors. CS(COMM) 514/2023

This fascinating order was passed by J. Prathibha Singh of The Delhi High Court on 9th August, 2023. The Plaintiffs who had approached the Hon'ble Court were prominent studios such as Netflix, Disney, Warner Bros, Columbia Pictures, Paramount Pictures and Universal City Studios. Their grievance was that certain rogue websites were streaming and sharing access to the Plaintiffs' Copyrighted content, without any authorization. The learned single judge issued a dynamic injunction against the infringers. A dynamic injunction is a unique remedy. It is an injunction which operates not only against the main rogue website that is infringing upon a copyright, it even extends to mirror websites. In this case, the Hon'ble Court deemed such an injunction to be necessary, since the hydra-headed rogue websites were coming out with mirror versions at the snap of a finger. The Hon'ble Court further clarified that the Plaintiffs could implead any new mirror websites by filing applications for impleadment and that the injunction would also operate against such impleaded parties.

E. Late Satyajit Ray is the owner of the screenplay of the movie Nayak - RDB & Co. v. Harpercollins Publishers India (P) Ltd., 2023 SCC OnLine Del 3046

This copyright dispute regarding ownership of the screenplay of the movie Nayak, written by Bharat Ratna awardee Late Satyajit Ray, was recently adjudicated by the Hon'ble Delhi High Court. The defendant had published the novelized version of the screenplay of the film Nayak and was going to launch the book shortly. The defendant contended that the defendant only used the screenplay of the film, which was literary work,

the copyright of which vested with Satyajit Ray. The Defendant argued that the rights of the Plaintiffs were limited to the cinematographic films, and a cinematographic work does not alter the rights of the underlying works, which remains with the authors. Any assignment of such work has to be done by way of a separate deed. The court held firstly that a screenplay is an original literary work, under S 13 of the Act. Further, none of the clauses of S 17 were attracted, and in order to decipher who owns the copyright, S 14 would be instructive, according to which, the author is the first owner. Thus, the copyright in the screenplay was held to belong to Satyajit Ray.



THE DIGITAL PERSONAL DATA PROTECTION ACT, 2023

A. India's first complete legislation on privacy is finally here. It received presidential assent on 11th August, 2023, after being passed by both Houses of Parliament. The need for a law on privacy was first expressed by the Hon'ble Supreme Court of India, in the case of Justice KS Puttaswamy & Anr. Vs. Union of India, in 2017. This was the same case in which the court upheld privacy as a fundamental right.

Interestingly, the Government of India told the Supreme Court of India in a different matter filed by two Indian students against WhatsApp in 2017 (Karmanya Singh Sareen & Anr. vs. Union of India & Ors.), focusing on personal data protection and digital privacy specifically, that they would bring a data protection law into force by Diwali of 2017^[1].

From 2017 to 2023, bills were drafted and floated on privacy, committees were constituted and deliberations were held on the subject. It has finally become law now, in 2023. The older rules that were in force, applying to sensitive personal data, called the SPDI rules, have now been repealed.

Below, we provide some key highlights from the Act:

B. Introduction and Applicability:

The "introduction" section of the fresh statute starts on a positive note. It says that the Act recognises both the right of individuals to protect their personal data and the need to process such personal data for lawful purposes. The Act applies to the processing of personal data within India in digital form or in non-digital form digitized subsequently. It also applies to personal data outside the territory of India, if such data processing is related to goods or services that are being offered to persons in India.

Footnotes:

¹<https://timesofindia.indiatimes.com/india/data-protection-regime-will-be-in-place-by-diwali-centre-tells-sc/articleshow/58250402.cms>

C. Key Definitions under Act:

The Act defines persons whose personal data is being taken for processing as data principals.

Data fiduciaries are entities which collect personal data and process the same, either themselves or through Data Processors.

D. Grievance Redressal and Dispute Resolution Mechanisms:

The data fiduciaries must have data protection officers and grievance redressal mechanisms in place. The Act also provides for a Data Protection Board, whose officers shall be appointed by the Central Government. This board shall act as a forum to decide upon complaints related to data issues under the Act.

Appeals against its orders shall go before the Telecom Dispute Settlement Appellate Tribunal (TDSAT).

E. Consent and "Consent Manager":

The Act says that in order to collect a data principal's personal data, the data fiduciary must send them a notice, to obtain consent, which must be free and informed. The Act also introduces a new, unique concept, called the "Consent Manager", through whom Data Principals can give, manage, or withdraw their consent.

F. Rights of Data Principals:

(i) They have the right to withdraw consent given to process their data.

(ii) They can ask the data fiduciary for a summary of personal data that is being processed or parties that data has been shared with. They have the right to ask for the erasure, correction, completion or updation of their data.

(iv) They have the right to seek redressal of their grievances and to make complaints for any violation of law or breach by the data fiduciary.

G. Obligations of Data Fiduciary:

(i) They must have reasonable security safeguards in place for data.

(ii) In case of a breach of data, they must inform the data principal and Board.

(iii) They must erase personal data, upon the data principal withdrawing consent, or as soon as they find out that the specific purpose for which the data was collected is no longer being served.

(iv) They must publish information about their data protection officers and grievance redressal mechanisms.

(v) They must obtain prior, verifiable consent, from the guardians of children or disabled persons to process their data. However, they cannot process any data of children which may have any detrimental impact on them, or track or monitor the behaviour of children to direct targeted advertisements at them.

(vi) The data fiduciaries may disclose data if they are required to do so under any law to any state agency or in the interest of security and sovereignty of the country.

H. Penalties

The Act provides for a schedule of penalties for breach of different provisions. The maximum penalty provided is for INR 250 Crore.

IP TIDBITS

Section 6 of the Commercial Courts Act, 2015 cannot exclude the applicability of Section 62 of the Copyrights Act, 1957 – Delhi High Court in *Yashoda Thakore v. Kuchipudi Dance Centre*, 2023 SCC OnLine Del 4064

The Jan Vishwas (Amendment of Provisions) Bill, 2023 seeks to decriminalize a total of 183 provisions found in 42 Central Acts that are administered by 19 Ministries/Departments. The main objective is to ensure that citizens, businesses, and government departments operate without the fear of imprisonment for minor, technical, or procedural defaults. – The Bill has been passed by Lok Sabha on 27.06.2023 and Rajya Sabha on 02.08.2023.

Draft Patent Rules, 2023 have been proposed for streamlining of the examination process of grant of patents. The said Rules have been opened for public comments, and the finalised Rules are yet to be tabled before the Parliament for approval.

FIRM ACCOLADES



Bitika Sharma

Partner



Sudeep Chatterjee

Partner



Saya Choudhary Kapoor

Partner






COMMITTEE MEMBERS

2024-25



Sudeep Chatterjee
Partner
Enforcement
Committee



Mohit Wadhwa
Associate Partner
Anti Counterfeiting
Committee

CONTRIBUTING FIRM ATTORNEYS:

VRINDA PATHAK, VRINDA BAGARIA, UTSAV MUKHERJEE

CONTRIBUTING FIRM TRAINEES:

ANUSHKA PALIWAL



SINGH & SINGH

Address

New Delhi

C-139, Defence Colony
New Delhi - 110024
India



Contact

singhandsingh.com
email@singhandsingh.com
T +91 11 - 4987 6090
T +91 11 - 4982 6000 to 6090