

# IP NEWSLETTER

## Intellectual Property: Supporting Innovation to Meet Covid-19 Challenges

**T**he global response to the COVID 19 pandemic has been varied by country, region, and population dynamics. While some countries bore the brunt within a very short span, others have managed to slowdown the epidemic or flatten the curve. As for India, despite a strong response at the outset of pandemic, India continues to be second most impacted country by the crisis with cases beyond 10-million mark by end of December 2020, only behind the United States, but with stronger recovery rate of 95% and a relatively low 1.45% fatality rate.

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India's first national lockdown was initiated in March when tertiary care provision was increased, including access to specialist equipment such as ventilators, a move praised by WHO. Testing numbers also increased quickly, with India being among the first to roll out innovations like pooled testing. India has also been at the forefront of efforts to develop and manufacture a vaccine, both through domestic vaccine candidates and manufacturers such as the Serum Institute of India preparing production capacity for internationally developed vaccine candidates.



## CURRENT UPDATES

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Importantly, while the pandemic created disruption in our social and business life, it has also helped perceive the 'positives' coming out of these unprecedented times. The significance of intellectual property and innovation in our day-to-day life has been one such positive. Going ahead, it will be important to reflect on how countries and enterprises utilize IP during COVID-19 and post-pandemic, for economic revival. As innovation catalyzed by IP pervade all fields of economic activity, these may be regarded as important policy tools and strategies to combat the pandemic challenges as well as to revive economic growth. Industries too must reflect and achieve innovative ways of doing business in their future continuity plans and to increasingly generate IP assets. This would be particularly significant for India, keeping in view the goal of 'Atmanirbhar Bharat'.

Meantime, it has been heartening to see the present epidemic spurring governments, corporates, researchers and academia to think out of the box to find innovative and affordable solutions to manufacturing, testing and treatment. With a clear focus on affordability and low cost, India saw several outstanding innovations coming out from researchers, industries and more importantly from MSMEs and Startups - from sanitization drones, digital stethoscopes, and infection-proof fabric for hospitals to incredibly cheap portable ventilators and affordable Covid-19 test kits. These swift innovations at the heart of India's response to the pandemic has been a testimony to its age-old tradition of being creative and resourceful in the face of social crisis and resource constraints. The indigenously developed vaccine is another apt example of India's innovation potential.

The rising level of 'cooperation', 'collaboration' and 'accessibility' in these times of global crisis is another important positive emerging from the COVID-19 pandemic. The necessity for public-private partnership has never been felt so strongly as it has been over the last few months, and it gave reasons to stakeholders, including Governments, industries, communities to come together and join hands for better collaboration and partnerships in the field of IP and innovation for tackling the crisis. With the entire world eagerly looking forward to an effective vaccine that can help prevent the COVID-19 pandemic, there have been many instances of cooperation and collaborations among Indian and overseas pharma companies that have been found useful in the search for a coronavirus medicine. Some prominent examples, among them, have been

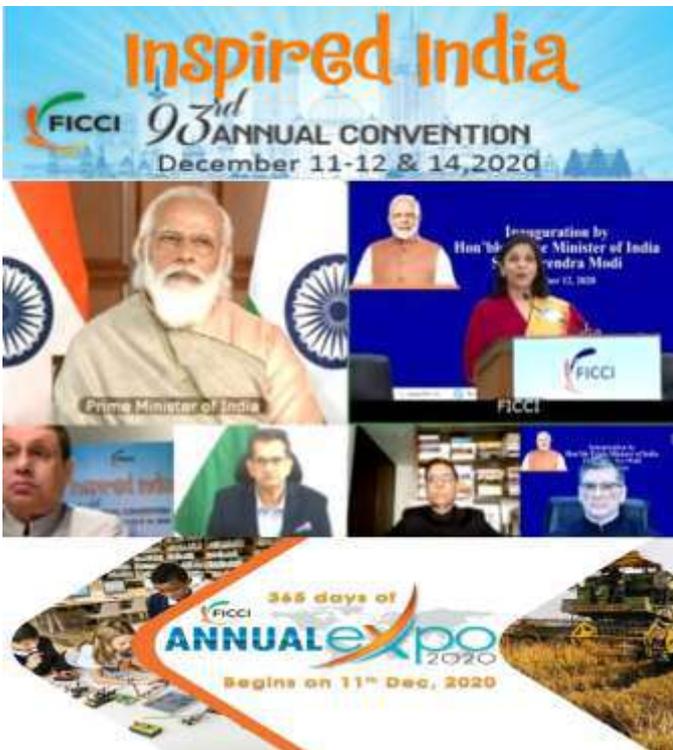
Serum Institute of India partnering with AstraZeneca for Oxford vaccine-Covishield, Bharat Biotech joining hands with ICMR for developing COVAXIN, Dr. Reddy's Labs partnering with Russian Direct Investment Fund (RDIF) for Sputnik V vaccine and Biological E tying up with US drug maker, Johnson & Johnson to manufacture its Covid-19 vaccine.

With the eagerly anticipated COVID vaccines now becoming available, the debate on whether IP protection will hinder their widespread availability vis-à-vis that a temporary waiver would jeopardize future medical innovation and make people vulnerable to other diseases, continues. While India, with its IP laws being post TRIPS vintage and in full compliance with international obligations, has been extra careful about invoking existing provisions, it is notable that many countries have recently empowered themselves to issue compulsory licensing. Besides, the fair deal provisions under the Indian copyright legislation for enabling teaching and research are considered as adequate for meeting urgent needs. In this context, while India will need to exercise caution and vigilance, much will depend upon the attitude of IPR holders who are expected to take a cooperative and humane view as the country confronts the present crisis.

As we move into 2021, IP and innovation will continue to be relevant both for combating COVID-19 and for reviving the Indian economy. International, institutional, industry, R&D and academia cooperation and partnership will be important especially for the medical and health sectors as well as other dynamic sectors of the economy. At the same time, several key areas would call for attention. The problem of counterfeiting, piracy and illicit trade that has seen a rising trend during the pandemic, compromising consumer safety, suppressing genuine economic activity, resulting in job losses and eroding revenue, will have to be tackled through increased stakeholder vigilance and stronger law enforcement. Further, enhanced focus is called for on managing the new disruptive technologies (AI, blockchain, IoT) and other 21st century innovations and to study implications of their development to ensure a balanced and harmonious evolution of IP laws and regulations in the future for exploitation of these technologies for the benefit of the society. Strengthening and modernizing the country's IP system and building an IP-stimulated innovation ecosystem will have to remain high on India's priority list in order to create the 'Atmanirbhar Bharat' ecosystem.



## FICCI Annual Convention 2020



**F**ICCI organised its 93rd Annual Convention & Annual EXPO 2020 on 11th, 12th and 14th December 2020. FICCI's Annual Convention, over the years, has been one of the most-awaited congregation of leadership from Government and Industry for cross fertilization of ideas with a high-powered audience, comprising policymakers, business leaders, media and academia, among others. The theme for this year's convention was "Inspired India". The Annual Convention coincided with the "FICCI Annual Expo 2020" – a unique initiative by FICCI, driven by the need of Indian businesses to remain connected while exploring new business opportunities.

Hon'ble Prime Minister of India, Shri Narendra Modi, while inaugurating the FICCI Annual Convention and FICCI Annual Expo 2020, said that while India had been through ups and downs in the year 2020, it was encouraging that conditions were rapidly improving. Despite many challenges at hand, he emphasized that the Government was ready with the solutions and a roadmap to take India forward and overcome these challenges. He also lauded FICCI for partnering with the Government and for its effective role in the process of nation building, including in the country's fight against COVID-19.

Speaking on the 'Atmanirbhar Bharat' program, the Prime Minister observed that the initiative is aimed at promoting efficiency in every sector of the economy, with the emphasis on re-energizing technology-based industries in which India possessed long-term competitive advantage. He also urged the industry to invest in rural areas including in agriculture as the investments in this critical sector would open up new opportunities for people in rural India.

Dr. Sangita Reddy, President, FICCI, while speaking about the broad range of reforms undertaken by the government, mentioned that the recovery in the coming year can be accelerated by focusing on a 5-point agenda, which included focus on the COVID-19 vaccine roll out and revitalization of the healthcare sector, implementation of the National Infrastructure Pipeline – a group of social and economic infrastructure projects in the country over a period of five years, continued focus on digital transformation of the economy, greater push to manufacturing through the Production Linked Incentive (PLI) Scheme implementation and further fiscal stimulus especially for those sectors that have a long recovery period. Dr. Reddy thanked the Prime Minister for the Government's laudable initiatives and assured FICCI's full commitment in working towards bringing the economy back on to the high growth path.

Mr. Uday Shankar, President-Elect, FICCI, in his address, said that the Government's reforms and PLI scheme along with the roadmap outlined by the Prime Minister were the basic foundations that will help India become a strong and thriving nation, bringing prosperity to its citizens. He assured the Prime Minister of FICCI's full support and cooperation in taking forward the reforms agenda of the Government in both industrial and agriculture sectors.

The 3-day event had hosts of luminaries from Union Ministers to bureaucrats, corporate honchos, world leaders to thought experts sharing their views on the 'Inspired India' theme, and on a range of topics including Atmanirbhar Bharat, AI and the new digital world, vaccine and healthcare transformation, leveraging ICT for economic recovery, capital funding for a US\$ 5 trillion economy and the concept of Edu-volution, among others.



## Become a Member !



- A Community of IP Professionals -

### BACKGROUND

- FICCI launched its unique initiative - FICCI IP FORUM in May 2020 to provide an interface for businesses to resolve their issues pertaining to intellectual property rights and also develop a pool of IP professionals whose knowledge and expertise will benefit the industry at large.

### OBJECTIVE

- To create a consortium of legal professionals who are keen to support IP and encourage innovation, brand protection and creativity among various stakeholders.
- To strengthen the IP ecosystem in India and play an important and more comprehensive role in addressing existing and evolving issues in the area of IP in India.

### BENEFITS

- Engagement in IP Policy Advocacy
- Networking through various FICCI national & international seminar /conferences
- Speaking/participating opportunities in various FICCI Webinars:
- Enhanced Visibility for forum members
- FICCI IP Talks
- Several other Benefits

### KEY MEMBERS

- Ms. Archana Shanker, Anand and Anand
- Ms. Manisha Singh, LexOrbis
- Ms. Niti Dewan, R K Dewan & Co.
- Mr. Safir Anand, Anand and Anand
- Mr. Ameet Datta Saikrishna & Associates
- Mr. Essense Obhan, Obhan & Associates
- Mr. Pankaj Soni, Remfry & Sagar
- Ms. Sunita Sreedharan, SKS Law Associates
- Mr. Saif Khan, Partner, Anand and Anand
- Ms. Navneet Momi, Intellect Juris
- Ms. Madhu Rewari, Anand and Anand
- Mr. S. Parundekar, Brand Defence Consulting
- Mr. Naveen Varma, ZeusIP Advocates
- Mr. Sanjay Kumar, Perfexio Legal
- Mr. Suneet Sabale, Brainiac IP Solutions
- Mr. Shhaurya Sah, Sah & Mehrotra
- Mr. Rohan Rohatgi, RSR Legal Advocates
- Mr. Gaurav Choubey, Choubey & Co.
- Ms. Deepa Vohra Bahl, Lex Intelli
- Ms. Arpita Sawhney, Perfexio Legal
- Ms. Meenal Khurana, Perfexio Legal
- Mr. Mathews Verghese, Intl Advocare
- Mr. Yashvardhan Rana, Intl Advocare
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WEBINAR ON  
**IP Protection & Enforcement in Digital World**

September 24, 2020

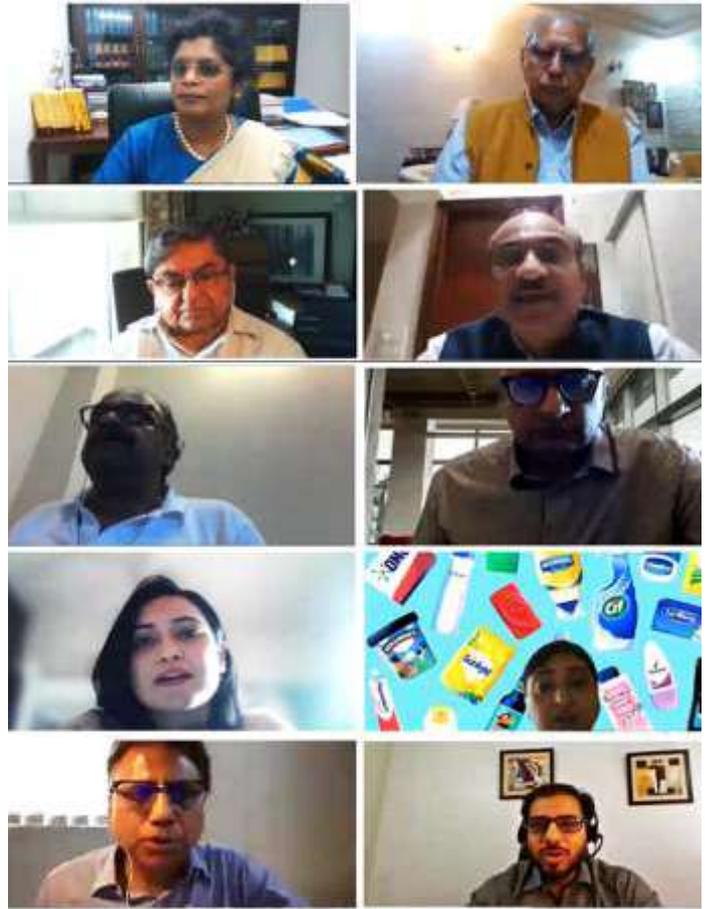
COVID-19 pandemic has not only disrupted business across sectors but also brought in the fundamental changes in the digital world. An untoward development, in the interim, has been the upsurge in intellectual property infringement activities that has been witnessed in the digital space.

In order to initiate a detailed discussion on this critical issue and explore possible remedies to address this growing menace, FICCI organized a webinar on “IP Protection & Enforcement in Digital World” on 24th September 2020. The deliberations underlined the current issues associated with protection and enforcement of intellectual property rights in the digital world including online piracy, intermediary liability, the jurisdiction issues associated with online infringement and the effective enforcement strategies that could be adopted by enterprises, brand owners and the other stakeholders to safeguard their valuable intellectual assets in the digital space.

Hon'ble Ms. Justice Prathiba M. Singh, Judge, Delhi High Court graced the occasion as the Chief Guest. Justice Singh, during her Keynote Address observed that the Intellectual Property in the digital world was not the same as it was seen earlier, and that efforts to curb online counterfeiting and piracy needed to be stepped to ensure that the relevance of IP was maintained in the online world. The digital space, she maintained has brought about two fundamental changes. The positive aspect has been the growth seen in the IP sector with the new and emerging technologies that have significantly enhanced the far-reaching impact of intellectual property, while the negative impact was the rampant and rapidly growing incidences of counterfeiting & piracy especially subsequent to the COVID-19 pandemic.

Mr. Narendra Sabharwal, Chair, FICCI IPR Committee and Former Deputy Director General, WIPO, in his opening address, expressed concern over alarming rise in IP infringements cases - both online and offline, coupled with the growing incidents of cybercrimes and online frauds fueling the unlawful activities. He also complemented the judiciary's stringent approach in protecting the interest of IP owners through supportive orders in legal disputes and restraining unscrupulous players from violating rights of IP owners. Mr. Jyoti Sagar, Managing Partner, K&S Partners, during his address, elaborated on the growing importance of the e-commerce and entertainment sectors in the context of the Indian economy, underlining that consumer behavior and markets were changing dramatically in the newfound world. He added that the fourth industrial revolution driven by the new technologies with disruptive features were further aiding the process of change and it was crucial for India's IP ecosystem to not only adapt to the evolving environ, but also to tap many new opportunities. Mr. Arun Chawla, Deputy Secretary General, FICCI, in his concluding remarks, said that despite the adverse impact of COVID-19 on businesses and the economy, increasing levels of innovation supported by intellectual property would be the key to fight the challenges posed by the pandemic.

The session included two interesting panel discussions on copyright & trademark with a number of prominent IP industry stalwarts in India, including Mr. Blaise Fernandes, President & CEO, Indian Music Industry (IMI); Mr. Uday Singh, Managing Director, Motion Pictures Association; Ms. Viji Malkani, Senior IP Counsel, Hindustan Unilever; Ms. Dhvani Rao, Head Legal Counsel-IP, Digital & HR Legal, Nestle; Mr. Rajendra Kumar, Counsel & Sr. Advisor & Mr. Prashant Gupta, Partner, K&S Partners. The webinar was attended by over 200 participants consisting of industry representatives, General Counsels, Legal & IP professionals, brand owners, trademark attorneys, law firms, legal experts, law institutes and other key stakeholders from IP community.





## ACTIVITIES

### WEBINAR ON

## Customs & IPR Protection in India

November 10, 2020

Counterfeiting is not restricted to any exclusive jurisdiction but is rampant worldwide and rising rapidly. It is a serious issue for the global economy, with mass production of infringing goods being carried out at one nation and being imported to other countries. In this backdrop, there is an increasing need to protect IP rights across borders to keep a close watch and take appropriate and timely action against imports that can potentially be infringing to IP owners.

With a view to deliberate on the effectiveness of the Customs remedies in India and how the IP rights holders can use them as a tool for IPR enforcement, FICCI organized a webinar on



“Customs & IPR Protection in India” on 10th November 2020. Mr. Dipankar Barkakati, Director, IPR Division, FICCI delivered the Welcome Address at the Opening Session followed by the presentations from eminent guest speakers from Zeus IP Advocates, including, Mr. Himanshu Deora, Senior Associate, Ms. Natasha Bali, Senior Associate and Mr. Aarohan Bansal, Principal Associate, ZeusIP Advocates. Mr. Himanshu Deora, during the initial presentation gave an overview of Customs registration and protection scenario in India. He also elaborated on the prominent case law of 'Parallel Import' (Samsung vs. Kapil Wadhwa) while illustrating in detail the related customs rules and regulations with respect to intellectual property. Ms. Natasha Bali, during the subsequent presentation, discussed about the customs registration procedures in India and other relevant aspects with respect to documents, timelines, associated costs etc. Mr. Aarohan Bansal, during his session, discussed about the customs enforcement process in India including related guidelines and requirements. He also touched upon the provisions given in Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, and how the IP right holders can prevent counterfeiting and infringing goods from surreptitiously being imported into the Indian markets while enforcing their rights. The webinar, knowledge partnered by 'ZeusIP Advocates', was attended by over 100 participants from various industry sectors including FMCG, Electronics, Pharma, Automobile, among other, apart from senior counsels, legal & IP professionals, trademark attorneys, brand owners, law firms, legal experts, law students from academic institutes and other key IP stakeholders etc.

### WEBINAR ON

## 3<sup>rd</sup> India-US IP Dialogue: Opportunities for US-India Collaboration

December 3, 2020

The global economy is now increasingly innovation-driven, powered by knowledge, creativity, and technology, each of which is supported by intellectual property and protection of IP rights. With India and the United States, two leading world economies becoming global strategic partners, it is in the interest of both countries to continuously engage in bilateral IP issues for mutual interest.

On 3 December 2020, FICCI in association with U.S. Chamber of Commerce (USCC) organised the third edition of “IP Dialogue: Opportunities for US-India Collaboration” through a virtual session. The deliberations brought together experts and thought leaders from both the countries, including officials from the Department for Promotion of Industry & Internal Trade (DPIIT), Government of India, U.S. Department of State, U.S. Patent & Trademark Office (USPTO) and Office of the U.S. Trade Representative (USTR), stakeholders from industry, academia and the legal fraternity to discuss the bilateral IP issues of mutual interest. The interaction revolved around a range of topics e.g. the significance of innovation and public-private partnership in addressing the ongoing pandemic challenges, dealing with trademark and copyright enforcement issues, IP licensing & commercialisation and the growing relevance of trade secrets in the digital age.

Mr. Narendra Sabharwal, Chair, FICCI IPR Committee, in his introductory address, observed that the “India-US IP dialogue has proved to be extremely fruitful in deliberating bilateral and global issues on intellectual property, while at the same time reaffirming the resolve on both sides to identify and explore pragmatic solutions to challenges and concerns”. He

underlined how innovations supported by IP would be the key to mitigating the COVID-19 challenge by way of strengthening healthcare systems, fostering science and technology development, and managing accessibility and affordability of healthcare. Further, he added that there is a need to re-ignite the engine of economic recovery and growth in both the countries through IP-led innovation.

Mr. Rajendra Ratnoo, Joint Secretary, DPIIT, provided the opening remarks on behalf of the Government of India, while other senior officials from DPIIT, Copyright Office, and Intellectual Property Appellate Board (IPAB) gave remarks during the subsequent sessions. Mr. Matt Murray, Deputy Assistant Secretary, U.S. Department of State, Bureau of Economic and Business Affairs, gave the opening observations on behalf of the U.S. Government, while several other senior U.S. Government officials, including Mr. John Cabeca, IP Attaché for South Asia, also shared their insights in the ensuing sessions.

The dialogue assumed greater significance in wake of the recent Memorandum of Understanding signed between Department for Promotion of Industry & Internal Trade (DPIIT), Government of India and the United States Patent and Trademark Office (USPTO), Department of Commerce of the USA, on intellectual property cooperation between both the countries. While India has a robust and balanced IP system which keeps in view national development priorities and concerns while conforming to international commitments, the National IPR Policy 2016 lays down a comprehensive road map for the overall development of India's IP system. FICCI is committed to explore areas of cooperation and partnership that will further facilitate a favorable innovation and IP ecosystem in India, while addressing IP concerns of the business community on both in India and the U.S. to boost bilateral trade and economic relations. Focused bilateral interactions periodically, like the India-US IP Dialogue, provides the much-needed occasion for constructive engagement on a range of IP issues of interest to India and the US, and help further strengthen Indo-US economic partnership.



## FICCI at World IP Forum 2020

December 18-19, 2020

**F**ICCI participated in the World IP Forum (WIPF) 2020 as 'Knowledge Partner' held virtually on 18 & 19 December 2020. WIPF over the last few years has been an important global event on Intellectual Property committed to knowledge sharing and exchanging ideas, besides providing opportunities for business networking with visionary entrepreneurs and industry experts on IP from around the world. The theme for this year's conference was 'Intellectual Property in Atmanirbhar Bharat: Innovate, Protect & Promote'. The two-day conference focused on recent developments in IP and its growing significance for meeting corporate objectives in the emerging business environment.

Mr. Narendra Sabharwal, Chair, FICCI IPR Committee, during his address at the Inaugural session, underlined the role and importance of intellectual property rights during COVID-19 pandemic and its relevance for India's economic revival keeping in view the goal of 'Atmanirbhar Bharat'. Pointing out 6 major imperatives for the IP sector in the current pandemic, Mr. Sabharwal observed that creativity and innovation catalyzed by IP pervade all fields of economic activity and endeavor and hence would be a key policy tool and strategy to not only combat the COVID-19 challenges but also to bring back the economy on the recovery path. All industries, businesses and IP stakeholders should remain innovative and rethink new ways of doing business in their future enterprise continuity plans and focus on generating IP assets, he opined. On whether IP rights may pose an obstacle in fighting the pandemic, he added that while the Indian IP laws did



## ACTIVITIES



provide for available flexibilities during national emergencies, in line with the TRIPS provisions, much depends on whether IP owners take a humane and cooperative view during this crisis. He also advocated the need for the current IP laws to be revisited in view of the recent developments, including in the areas of trade secrecy, public-funded research and traditional knowledge. As regards the IPR policy, he said that these may be evaluated to identify the scope of its implementation and possible gaps in view of the new and expected disruptive technologies. International cooperation and partnership will be another important imperative in successfully confronting the crisis and post-pandemic phase, he submitted. Expressing concern on the growing cases of counterfeiting, online piracy and cybercrimes during pandemic, he underlined the need for fully enforcing laws against such illegal activities. On the priority areas towards further improving India's IP ecosystem, Mr. Sabharwal's suggestions included conducting an IP audit across all relevant industry segments to assess and evaluate the existing potentials in specific sectors; an Economic Impact Study for copyright industries; Stepping up promotion of IP awareness among stakeholders; inclusion of IPR in education curriculum; continued modernization of IP offices focusing on efficiency, quality and service orientation, and setting up of a Central Coordination Empowered Body for enhanced and effective IP enforcement.

Among the eminent speakers addressing the WIPF 2020, there were several members of the FICCI IPR Committee who shared their insights on topical IP issues, knowledge and experiences litigations and related aspects, the latest trends and changes occurring in different global jurisdictions, etc.

### WEBINAR ON

## SEP & FRAND Licensing: Recent Global Developments

December 22, 2020

Standard Essential Patents (SEPs) and their licensing under Fair, Reasonable and Non-Discriminatory (FRAND) terms have been a subject of intense debate in the global IP market in recent years with courts and regulatory authorities taking a much closer look at the issues surrounding them while developing frameworks for resolving SEPs disputes and determining license terms. There have been recent developments in key markets including EU, China and US with respect to SEPs & FRAND licensing due to which the legal position of this topic is continually evolving and, therefore, needs to be communicated to larger stakeholders in India as well.

FICCI, in association with NIPO, organized a Webinar on 'SEP & FRAND Licensing: Recent Global Developments' on 22nd December 2020. The webinar discussed about the Standard Essential Patents (SEPs) and their licensing under FRAND terms in view of the recent global developments in key jurisdictions including US and the European Union. The webinar also touched upon the role of Standard Development Organizations (SDOs) and the recent judicial pronouncements in the US regarding FRAND royalties and what would be a suitable model for India given the current legal framework while dealing with the matters related to SEP & FRAND licensing.

Mr. Dipankar Barkakati, Director, IPR Division, FICCI delivered the Welcome Address at the Opening Session followed by the panel discussion having presence of eminent speakers from Government, Industry and academia which included, Mr. AK Mittal, Advisor, Network Systems & Technologies, Telecommunications Standards Development Society, India (TSDSI), Mr. Yashwant Panwar, Head-PFC, TIFAC, Ministry of Science & Technology, Govt. of India, Mr. Jim Harlan, Director-



Standards & Competition Policy, InterDigital, Mr. Yogesh Pai, Coordinator-IPR, National Law University-Delhi & Co-Director, CIIPC and Mr. Saurabh Anand, Senior Associate, K&S Partners. The webinar was attended by large participants from Industry, corporates, IP experts, senior IP practitioners, patent litigators, academicians, patent attorneys, young IP professionals, patent counsels, researchers and other key IP stakeholders.

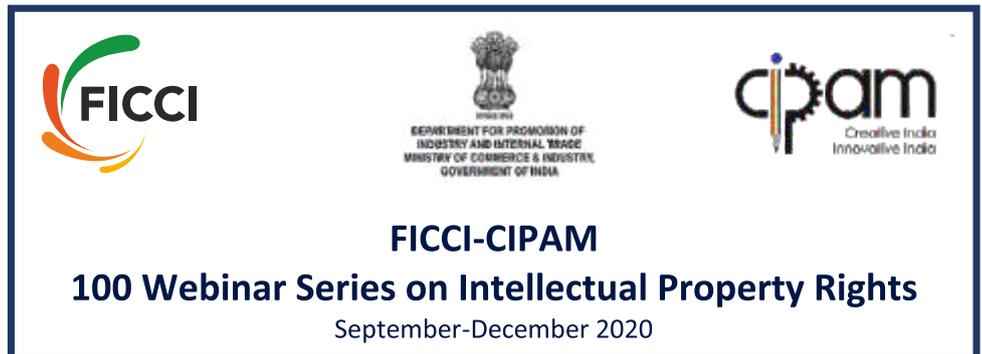


## FICCI-CIPAM

# 100 Webinar Series on Intellectual Property Rights

September - December 2020

With a view to raise IP awareness among stakeholders in the country and to get them involved in deliberations across diverse topics on Intellectual Property, fulfilling one of the key objectives laid down in the National IPR Policy, Federation of Indian Chambers of Commerce and Industry (FICCI) along with Department for Promotion of Industry and Internal Trade (DPIIT), Government of India and Cell for IP Promotion and Management (CIPAM) had joined hands to launch the “100-Webinar Series on Intellectual Property” in March 2020.



The 100 Webinar Series, a joint initiative by FICCI & CIPAM, has been able to garner much appreciation since its inception as well as active participation from various stakeholders in spreading awareness and disseminating information about the intellectual property rights and the key role that IP would play in strengthening India's economic ecosystem. The speakers partaking the webinar-series are experienced IP professionals, academicians, researchers, company secretaries and other related experts who have been engaged with growth and development of intellectual property rights in India. Since its launch in March 2020, the webinar-series productively conducted 25 webinars so far covering a wide range of IP topics, with several more planned in the coming months. Following is the list of webinars completed during the last quarter, and the subjects covered:

- **Intersection of IP in the Pharmaceutical Industry, 7 September 2020**
- **IP Valuation: Approaches, Issues and Concerns for Business Enterprises, 23 September 2020**
- **Important and Landmark Judgments in IP, 27 November 2020**
- **Important and Landmark Judgments in Competition Law, 4 December 2020**
- **Patent Commercialization Strategies for Startups, Innovators and Entrepreneurs, 21 December 2020**
- **Do's and Don'ts of a Trademark Litigation in India, 29 December 2020**
- **Conundrum on Cognizability of the Offence of Copyright, 30 December 2020**



# Parallel Imports & Exhaustion of Rights



### VIJI MALKANI

Co-Chair – FICCI IPR  
Committee & Sr. IP, Brand  
Protection & Foods Counsel  
Hindustan Unilever Limited

It is no secret that consumers love imported foreign goods especially imported brands, imported shoes, bags, clothes, watches, perfumes, cosmetics and the like. Imported goods/imported brands are more appealing due to status, quality, reputability and the perceived value as in most cases these are not available or launched in the importing country (IC) or are offered at a higher price in the IC, propelling their demand. This consumer patronisation leads to parallel imports (PI) of goods creating disputed issues in the IP field.

Making a striking balance between the interest of the trademark owners and the consumers has always overwhelmed the judiciary deciding IP issues. Parallely imported goods are genuine goods or non-counterfeit goods that are legitimately acquired from the rights holder and subsequently sold at lower prices through unauthorized trade channels in the same or a different market. Also known as grey imports, there is nothing grey or illegal about PI except that such imports are not authorized by the right holder (RH). A simple example of PI is given below:

Mr. A imports a branded cosmetic from Bangladesh (available at INR 500/-) into India (available at INR 1000/-) and makes a good profit out of its sale in India. Mr. A has not committed any illegal act, rather he has lawfully acquired products sold in one country by the RH under a certain brand/trademark and sold it in another country at a profit.

In order to understand PI, one needs to comprehend the concept of Exhaustion of Rights (also known as the First Sale Doctrine). Simply put, 'Exhaustion' in relation to IP rights refers to a "limit" to IPR in relation to sale of product. For example, once a RH sells in a particular jurisdiction a good/goods in which the RH owns the trademark, the RH cannot then prevent the resale of that product in that jurisdiction. The trademark rights in the product are deemed to have been "exhausted" by such first sale. This occurs because the title in the goods has passed on to the purchaser and the title of the trademark owner in such goods has been exhausted after the sale.

### LEGAL AND JUDICIAL POSITION ON PI

The provisions of the Trademarks Act, 1999 (TMA) that are

relevant to the discussion are Section 29 (infringement of trademarks) and Section 30 (limits on effect registered trademark). Section 30 (3) provides for exhaustion of trademark rights, i.e. the trademark owner cannot forbid further sale by a person of goods legally acquired by him in any market. The legal question that must be decided by the Indian courts is whether TMA recognizes international or national exhaustion of rights based on the interpretation of the term 'market' in the above sections.

As the situation stands today in India, PI is permitted as they are considered non-infringing due to the landmark judgement of the Division Bench (DB) of the Hon'ble High Court of Delhi which in an appeal filed in Kapil Wadhwa and Ors. Vs. Samsung Electronics Co. Ltd. (Samsung case) on 3rd October 2012 held that the term 'market' in Section 30(3)(b) of the TMA means 'international market' meaning that India follows international exhaustion. Up until this judgement, PI was considered an infringement under Section 29 of TMA. The DB observed that there is no law which stipulates that goods sold under a trademark can be lawfully acquired only in the country where the trade mark is registered and that Trademark Law does not regulate the sale and purchase of goods, rather it controls the use of registered trademarks. An appeal against the order of the DB is pending before the Supreme Court as on date.

The DB imposed certain conditions requiring the appellant to prominently state that the goods have been imported, and that after sales service and warranty is not provided by the RH and but by the Buyer. In the subsequent case of Western Digital Technologies Inc. vs. Mr. Ashish Kumar & Anr. the Defendant agreed to comply with similar conditions.

### CONCLUSION

While PI is beneficial to the consumers as it prevents trade monopoly by making available trademarked goods at different prices, no assurance as to quality or after sales service/warranty is provided by the RH in the IC. It is concerning for RHs as their ability to act against the PI which otherwise would have constituted infringement is restricted. It is imperative that a proper balance is attained between promotion of free trade and competition, and interest of RHs. One way of achieving this would be to impose reasonable restrictions on PI by requiring the importer to comply with conditions of disclosure as required in Samsung and Western Digital case. India could also adopt best practices from other countries like the US by following the material differences approach which prohibits the sale of parallely imported goods if such goods are materially different from the goods that the trademark owner has authorized to be put on the market in that country. In the meantime, Supreme Court's decision in the pending appeal in Samsung case will be the litmus test for parallel imports.



# Trademark Commercialization Strategies for Entrepreneurs and Business Owners



## YASHVARDHAN RANA

Member – FICCI IP Forum, and Associate, Inttl Advocare

### INTRODUCTION

Commercialization is the process of turning products and services into a commercially viable value. Branding is a central component of any thriving modern market economy and has become an inalienable feature of some of the largest corporations. Developing a brand is the first step. After that, you need to protect and enforce it. Lastly, you need to commercialize it, whether that takes the form of growing your consumer base, charting out a licensing or franchise model, or selling the brand to a third party.

Trademarks - do just that - they help in distinguishing your company and its products and services from those of others, making it easily identifiable with customers and earning their trust and, ultimately, attracting and retaining a large chunk of them. There is no better effective communication tool than an image, brand name, or tagline that succinctly conveys so much information than a trademark. They tend to paint a universally acceptable story about your reputation, the quality you offer, your uniqueness, along with other attributes. Essentially, as your business reputation grows, your brand and trademarks become more and more valuable. And even though they make you money, they require minimal investment – which is why any business owner or a budding entrepreneur should take the plunge!

While MSMEs do understand trademarks, but their understanding on 'branding' and the importance of protecting it with trademarks and converting it into an easily transferrable asset is often lacking. SMEs that intend to export their products should consider legal protection of their trademark in their export markets in order to have exclusivity.

### LET'S MAKE SOME MONEY! — STRATEGIES TO ADOPT

#### a) Get Creative

Try to devise a catchy and distinctive name, slogan or a logo. Keep in mind that it should not be easily confused with another brand or a company. Successful brands tend to be the ones that are made of words and logo in a fanciful way that portray their business and describe the goods and services in state-of-the-art and noteworthy ways. Brand globally – think locally! This should be the mantra.

#### b) Conduct a trademark search

This can be an arduous task and it is often recommended to hire an attorney to do that job for you. This is essentially done to ward off any potential infringers or to check whether there are any pre-existing marks in the Trademarks Register. Searches can be undertaken – initiating with a basic internet search which can go all the way upto conducting a full clearance search to analyze and assess the risk to adopt/use and register the proposed trademark and giving an in-depth and analytical legal opinion on the availability and registrability of a trademark.

#### c) Seek registration and make it legal

Having a registered trademark gives you an identifiable asset for the goodwill built up in your company brand. The greater the value that your customers attribute to your business and the stronger the brand loyalty that exists, the better.

By virtue of open, long, continuous, and extensive use, trademarks become factually distinctive over a period of time and can acquire secondary significance in relation to the products or services for which they are used. Lastly, try registering all your marks that you intend to use in important regions in all relevant classes, along with multiple translations and transliterations.

<sup>1</sup><https://economictimes.indiatimes.com/small-biz/legal/how-trademarks-can-work-as-assets-for-msmes/articleshow/70509011.cms?from=mdr>



## **d) Monitor the market**

Market analysis should be the criterion to initiate before launching your product such as - trademark value, monitoring of trademark publications, size of the potential market, customer's purchasing power in that given sector, competitor's size and potential, infrastructure and logistical issues, domestic legal framework, etc. Subsequently, an IP audit should be performed once you're done analyzing the market in order to be in a better position to strategize future activities and developments. Do this exercise periodically!

## **e) Licensing your trademark**

In business language, a licence allows the licensor (enterprise or a business owner) to make money from its intellectual asset by charging the licensee in return for its use. Licensing plays a vital role in companies' commercialisation strategies, since there are significant advantages of trademark licensing, thus, creating a win-win situation for both parties.

## **f) Co-branding with another company**

It allows both parties to take advantage of each other's goodwill and brand reputation. It is a good way to attract more consumers and enhance your sales. Examples of this kind of joint venture include Nike and Apple working together on products for athletes or branding for a common sporting event.

## **g) Financing and raising capital through securitization**

Companies that plan in advance and register their trademarks in time, may find themselves in a better position to place such an intangible asset as collateral in order to guarantee their loans. Nowadays, investors place their trust and pay attention to the trademark portfolio before investing their funds. In short, if you own a trademark, you may be able to use it as collateral to get a loan from your bank.

## **h) Marketing and Publicity**

You can use your trademark to grow the reputation of your business, the geographical reach or the intensity of market presence. The more people who know or recognize your brand, the more valuable it is, the better the sales conversion rate and the higher the likelihood of securing investment into your business. Use of various social media

channels, advertising, and marketing campaigns, print and media publication, registering your sub-brand as a domain name, etc. are some of the options to consider.

## **i) Franchising**

Franchising is a special type of licensing, enabling the replication of the owner's business concept in another location by providing continuous support and training to the recipient. In a franchise relationship, a company (franchisor) provides operational support, marketing support and training to the franchisee along with a license to use its brand name on a prescribed fee, either on a lump-sum basis or on continuing royalties.

## **j) Joint Ventures**

A strategic alliance or partnering with other companies is not only a necessity but is an efficient way to save time and money. This may include joint marketing agreements and trademark licenses under which the parties share advertising expenses and market products under a common logo.

## **k) Sell or Assign your trademark**

You may transfer or assign your rights in a trademark by way of an agreement in writing after adhering to certain guidelines such as the territorial extent, ownership, profit component, governing law, records, ascertaining that there are no pending disputes before any court, tribunal, etc. — in return for a lump sum amount.

## **CONCLUSION**

Since strong branding is fundamental to a company's identity, laying out a well-thought-out plan is critical to building and enhancing the company's corporate reputation and to protect it from unscrupulous third parties who may try to mislead consumers by using identical or confusingly similar trademarks. Long and consistent commercial use of well-crafted marks in accordance with strategic planning will ensure sustainable competitiveness over time in the marketplace. It would not only enhance the goodwill of a company but also its share value. To successfully achieve such objectives, a company should retain an experienced trademark attorney with a global perspective in mind in congruence with your goals, objectives, strategies and tactics.



# Patenting System: A Tool for Earning Profits and Not Just a Formality



## SUNEET SABALE

Member – FICCI IP Forum &  
Founder & CEO,  
Brainiac IP Solutions

The patenting system was introduced to India by Britishers in the 18th century, and the Indian patent law came into force in the year 1970. In the year 1998, India signed the Paris Convention and the Patent Cooperation Treaty (PCT), and the amended Patent Act was passed in the year 2005. From 2001 onwards, we have seen many Indian companies starting to file patents, and the numbers further increased after 2006. The majority of the well-known companies started their patenting activities during this period. A gradual rise in the number of patents filed per year was seen for a few years. During the initial period, when patents were still not granted, there were no extra cost involved in maintaining the patents. As the cost for maintaining the patents rose, however, the number of patents filed per year also reduced substantially in past few years.

Most of the companies started filing patents as a formality without understanding the value that could be added to the company by way of a strategic and robust R&D with equally effective patents and patenting strategies. At that time, most of the professionals also did not have adequate experience in the IP domain. KPOs were actively working on patent drafting, analytics and portfolio management for the foreign companies, but most of them had no experience on strategies and creation of strong patent portfolios which would help them in the return on investments. It is important for R&D and patenting strategies to be consistent to gain maximum benefits from each of the activities, and the useful inventions have to be backed by a good patent portfolio to minimize competition.

In the last few years, the granted patents have become a considerable burden to these companies, as 70 per cent of the budget allotted for patents is utilized for maintaining these patents. Still, the decision-makers have failed to take corrective actions due to lack of vision, conviction and in the absence of good precedents to follow. Besides, the patenting system takes some time to show its results. If the corrective measures are taken, it will take at least

five years to show its effect by way of market capitalization. So, patience is needed. Many companies have either stopped filing patent as they find it challenging to justify ROI, while few companies are still filing patents, by reducing the cost on overall patenting.

Mostly, these companies have hired in-house professional to reduce cost. However, when there is no one knowledgeable enough to validate the expertise and review the work of these inhouse professional, achieving targets becomes difficult. The only objective achieved is cost reduction. These companies at times also hire firms offering their services at the cheapest cost, or by obliging firms to agree to their cost. This is another big mistake, which further harms their patent portfolio. All companies operate for profits, and if an enterprise believes that they have been able to effectively negotiate without understanding the desired outcome, it will be damaging for the overall ecosystem due the cyclic effect that such decisions may have. It is important to set the expectation first to understand if the quoted cost is realistic or not.

In the next few years, we may see a further reduction in the number of patents or revamping of patenting strategies if the focus continues to be on cost-reducing. However, the emphasis should be on building strong patent portfolios and the need is to shift focus on achieving the expected results. Intuitive decision making, working based on statistics and identifying the right firm with adequate expertise and experience is what will make a big difference and show desired results for business leaders and the service providers.

As regards the patenting strategies, even having a good patent portfolio may not ensure adequate market capitalization unless a few litigation suites are fielded to show the presence and aggression of an enterprise against the infringers. The bad precedent set by a case between two Indian automobile manufactures reduced trust on patent professionals. However, it is important to note that failure is not always from one side but is a collective responsibility from which we need to learn and improvise.

Over the years, the number of patents filed by foreign companies in India has been on the rise, with 70 per cent of the patents emanating from foreign companies. This means that if, in the near future, if domestic companies are unable to increasingly develop robust patent portfolios, it will become challenging for enterprises to launch innovative products in the market that are also competitive. Therefore, it is critically important for Indian enterprises to learn and master this patenting tool.



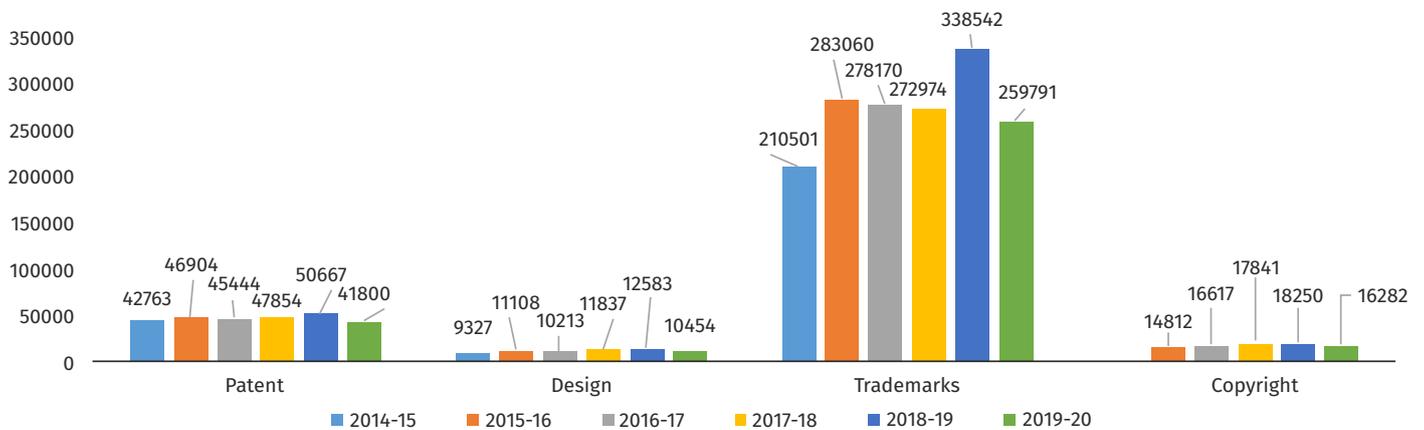
# RECENT IP TRENDS

## IP Registrations in India: Changing Landscape

The Indian IP scenario is undergoing a positive transformation. The office of the Controller General of Patents, Designs, and Trademarks (CGPDTM) is making relentless efforts to improve the current IP landscape in India. CGPDTM is committed towards making the Indian IP ecosystem suitable for innovation and technological growth. Accordingly, the office has taken various initiatives to enhance efficiency, uniformity and consistency in processing of IP applications and stepping up efforts to provide a balanced and transparent IPR framework in the country. The improvement in IP administration, digital reforms and re-engineering of IP procedures has resulted in improved performance, decreased pendency and higher rates of disposal of IP applications. As a result, there has been a constant increase in IP filings for various IPRs during last few years which is an encouraging sign for the overall growth and development of the IP sector in India.

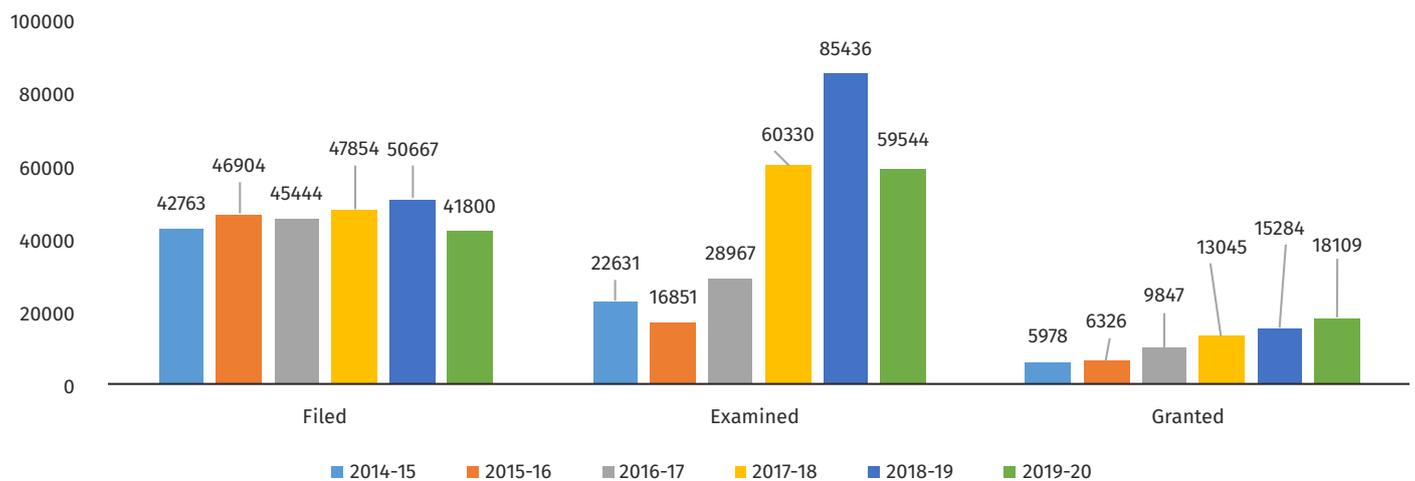
Some key indicators are listed below:

### IP Registrations in India - Last 5 Year Trends



- There has been a consistent growth of key IP parameters over the last few years, indicating the rising level of IP awareness

### Patent Registrations in India - Last 5 Years Trends



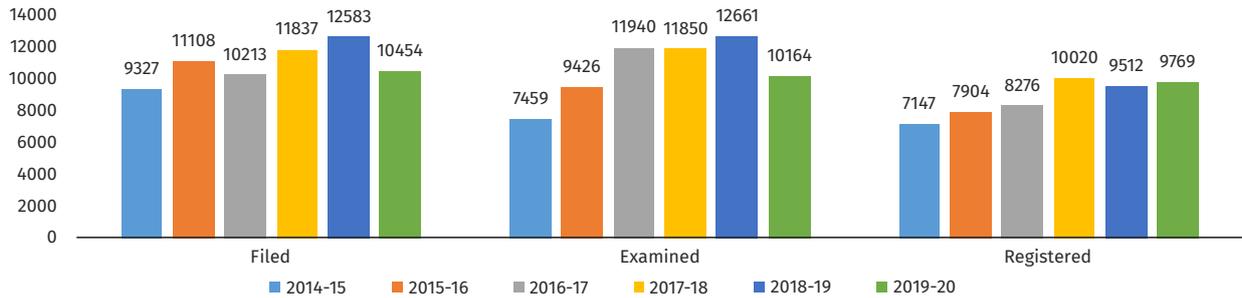
- The filing of patents applications witnessed a positive improvement in last few years due to procedural reforms brought through Amendment in Patents Rules.

\*Source: DPIIT Annual Report 2019-20

\*Figures for FY 2019-20 are updated till 31-Dec-19

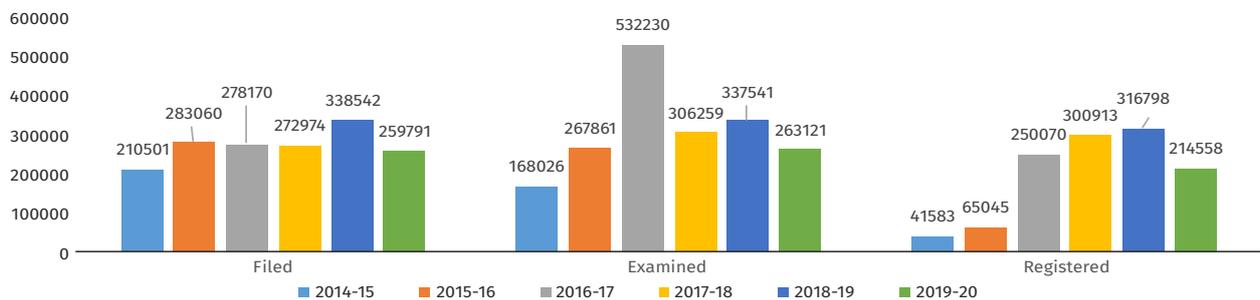


## Design Registrations in India - Last 5 Years Trends



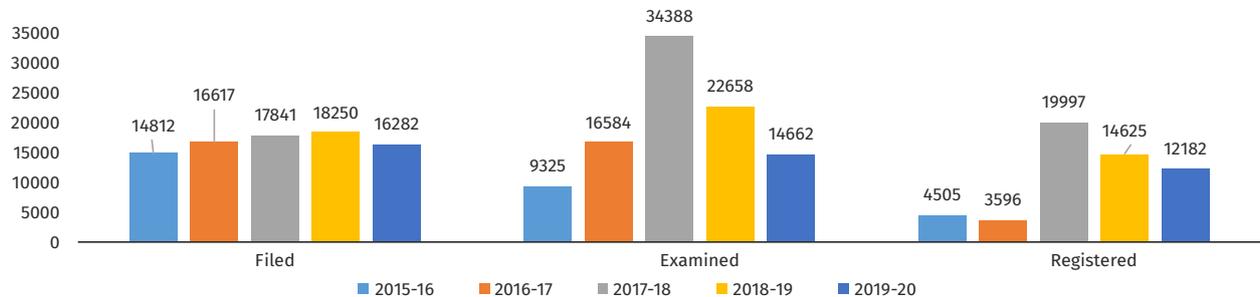
- Design registrations saw an upward trend in last 5 years due to several initiatives, including the upgradation of e-filing facility for new design applications.

## Trademarks Registrations in India - Last 5 Years Trends



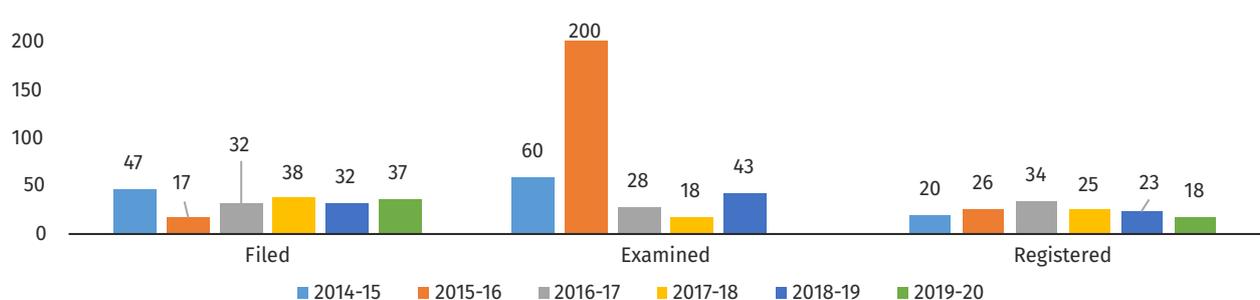
- Trademark registrations continue to grow on the back of improvement in Trademarks Rules and streamlining and simplifying of trademark procedures.

## Copyright Registrations in India - Last 5 Years Trends



- Copyright registrations saw improvement due to strengthening of Copyright Office through digitization, re-engineering of registration processes and manpower augmentation.

## Geographical Indication Registrations in India - Last 5 Years Trends



- GI registrations showed decent trends. With Government's continued thrust on GI marketing and promotion, the trend is expected to improve further in coming years.

\*Source: DPIIT Annual Report 2019-20

\*Figures for FY 2019-20 are updated till 31-Dec-19



## National

### **Delhivery Pvt. Ltd. v Treasure Vase Ventures Pvt. Ltd.<sup>2</sup>**

The Delhi High Court, on 12th October 2020, while hearing a trademark infringement suit by Delhivery against Deliver-E, formed a prima facie opinion that the mark 'DELHIVERY' was a phonetically generic word and thus cannot be registered so as to seek the benefit of statutory rights. The Plaintiff stated that it had been continuously and extensively using the trademark 'DELHIVERY' since the year 2011 for its logistics, transportation, management, etc. and had 27 registrations in its name. The plaintiff relied on extensive sales and recognitions/awards to contend that the mark had acquired secondary meaning. Defendant claimed that the mark DELIVER-E was inspired from the use of electric vehicles delivering goods and services and their adoption of the mark was honest, since the term DELIVER-E was an extension of, and had been inspired by, the mark SMART-E, that was being used since 2014.

The court while vacating the ex-parte interlocutory injunction it had granted earlier, observed that the Plaintiff's attempt was to read 'DELHIVERY' as 'DELHI' and 'VERY', thus asserting that the mark was different from the generic word 'delivery'. Remarking that 'DELHIVERY', when pronounced in a routine manner, meant 'delivery', the Court opined that 'DELHIVERY' was phonetically a generic word thus cannot be registered so as to seek the benefit of statutory rights.

### **GE Power India Limited v. NHPC Limited<sup>3</sup>**

A single judge bench of the Delhi High Court, on 26th June, 2020 refused to grant an interim injunction, in a case, where the suit for alleged copyright infringement arose out of an insolvency resolution plan of a corporate debtor. The court was of the opinion that such cases must be adjudicated by the NCLT, and that the proceedings in the Civil Court are barred. The suit was dismissed as not maintainable before the High Court in view of Sections 230 and 231 read with Section 60(5) of the Insolvency and Bankruptcy Code, 2016.

<sup>2</sup>Delhivery Private Limited v. Treasure Vase Ventures Private Limited, MANU/DE/1862/2020 (India).

<sup>3</sup>GE Power India Ltd. vs. NHPC Limited; MANU/DE/1305/2020 (India).

<sup>4</sup>Gujarat Cooperative Milk Marketing Federation Ltd. and Anr. v Amul Franchise In and Ors, CS(COMM) 350/2020 (India).

The plaintiff had alleged that the defendant notoriously disclosed and published, highly confidential designs and drawings, which belonged to the plaintiff, without having any right to do the publish or possess the same in the absence of a license granted by the plaintiff. The defendant on the other hand took the plea that the terms of the assignment did allow for a limited right that they had, with respect to the work in question, and they had simply exercised their right of fair dealing under Section 52(1)(a) of the Copyright Act.

The court in its verdict clarified that such a right is available only for private or personal use and does not apply to the commercial activity for which the defendant published the work. Further, it added that Section 52(1)(x) of the Copyright Act is applicable only to architectural drawings or plans that are used for reconstruction of a building or structures "originally constructed" and therefore stipulates that the building or structure with the said drawings was made with the consent or license of the owner of the copyright in such drawings and plans. However, since the plaintiff could not show that any copyright vested in the drawings, the Court held that it did not have a prima facie case for granting an interim injunction.

### **Gujarat Cooperative Milk Marketing Federation Ltd. and Anr. v Amul Franchise In and Ors.<sup>4</sup>**

In a massive development pertaining to the protection of originality of the brands, the Delhi High Court, through its judgement dated 28th August, 2020, has laid down a landmark precedent, holding that domain registrars such as GoDaddy, Big Rock, Freenom among others could no longer sell or offer for sale, domain names with the well-known trademark "Amul" as a suffix or prefix in any combination.

The plaintiffs had contended that they had received countless complaints from across the country that their well-known mark was being exploited by fraudulent websites, which were impersonating and deceiving the public by creating an impression that they were the authorized representatives of the plaintiffs. The defendants included (i) the fraudulent websites; and (ii) the registrars who authorized the domain names. Further, the plaintiffs also contended that the domain name registrars who, despite having received multiple take-down notices, registered these fake websites, made them available to the public at large, and took no affirmative



action against the defendant-websites. Infringers operated through fake websites and offered bogus business opportunities. The defendants on the other hand, argued that they were merely offering services and lacked any technological algorithm to filter out any website or domain name, with the term “AMUL”, so as to prevent the sale of such domain names. The court observed that the domain name registrars contain website filters to ensure that illegal and/or obscene words would not be available for sale, and subsequently, defendants' argument could not be accepted. The court made it clear that domain registrars also have responsibilities to curb the aforementioned problem.

The court in its verdict held that the plaintiffs were able to make out a prima facie case in their favour, providing sufficient indication of the irreparable loss that, both, the plaintiffs and public would suffer, and by fulfilling the balance of convenience test, the court granted the plaintiffs a partly ex-parte, ad-interim injunction. Further, the court also instructed the banks to freeze the bank accounts of the fake entities and provide details of the account holders.

## **Jagran Prakashan Limited v. Telegram FZ LLC & Ors.<sup>5</sup>**

A single judge bench of the Delhi High Court, on 29th May, 2020, passed a breakthrough judgement, to protect the commercial rights of the media houses, and address the issue of intermediary liability in case of illegal and widespread distribution of news on social media platforms, thereby also addressing the liability of the administrator of the groups as well as the social media platforms acting as intermediaries themselves.

The plaintiff is a leading publishing house, having sales and reputation, across various countries around the world. Plaintiff offers a paid, subscription-based service to its subscribers, allowing them to access its E-Paper on its website, [www.jagran.com](http://www.jagran.com). However, the terms and conditions of this service does not allow downloading or circulation of these E-Papers in any form. The contentions of the plaintiff are that Defendant No. 1, i.e. Telegram FZ LLC, allows for .pdf copies of its E-Papers to be uploaded on various channels, run by the users of its application, thereby also allowing for reproduction, adoption, distribution, transmission and dissemination of the e-paper. Further, the defendants also acted in violation of Section 79 of the Information Technology Act, read with Rule 3 sub-rule 4 of the Information Technology (Intermediaries Guidelines) Rules, 2011, since it failed to exercise its liability as an intermediary, thereby not exercising due diligence despite constant reminders, and hence failing to pull down the channels within the stipulated time, i.e. 36 hours.

The court addressing the plaintiff's contentions noted that the Plaintiff has made out a prima facie case in its favor and the balance of convenience also rests with it. The court, while granting an ad-interim injunction in favor of the plaintiff, directed the defendant to take down/block the telegram channels or any other similar channels infringing rights of plaintiff with 48 hours of receipt of its order, and disclose the basic subscriber information/identity of the users/owners of the channels.

## **Mittal Electronics vs Sujata Home Appliances (P) Ltd.<sup>6</sup>**

The Delhi High Court, on 9th September, 2020, while dealing with a one-of-a-kind case, addressed the impact of suppression of material facts by either of the parties and Doctrine of Clean Hands. Mittal had filed a suit for infringement and passing off against Sujata contending that Sujata had allegedly infringed its rights in the mark “SUJATA” and “SUJATA Star” in class 11. The Court granted an ex-parte injunction in Mittal's favour. However, the court modified its ex-parte interim injunction granted previously, on account of the defendants bringing to light, the fact, that the plaintiffs had concealed the fact that Defendant No.1 too owned the mark 'SUJATA', under Class 11 (Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying ventilating, water supply and sanitary purposes) for use over water filters, water purifiers and RO systems.

The court relied upon Nandhni's case and stated that the registration of a mark in a certain class does not necessarily give rights to the proprietor over the entire class. It only gives rights with respect to said good or service which were being sold/provided under the mark. Further, the court also highlighted the Doctrine of Clean Hands, thereby relying on Kishore Samrite v. State of Uttar Pradesh & Ors., reminding the litigants of their obligations while approaching the court stating, “the people, who approach the court for relief on an ex parte statement, are under a contract with the court that they would state the whole case fully and fairly to the court and where the litigant has broken such faith, the discretion of the court cannot be exercised in favor of such a litigant.” The court thus, disposed off its applications granting injunctions in favor of that Plaintiff and against the Defendants, thereby allowing the Defendants to continue to manufacture and sell under the Impugned Mark.

<sup>5</sup>Jagran Prakashan Limited vs. Telegram FZ LLC and Ors.; MANU/DE/1190/2020 (India).

<sup>6</sup>Mittal Electronics vs. Sujata Home Appliances (P) Ltd. and Ors.; MANU/DE/1695/2020 (India).



### International

#### **Unwired Planet International Ltd. and Anor v. Huawei Technologies (UK) Co. Ltd. and Anor & Conversant vs. ZTE and Huawei<sup>7</sup>**

The UK Supreme Court laid down new standards in global FRAND litigation through its judgements in these two cases. The ruling, given out on 26th August, 2020, followed the equally important decision of the German Federal Court of Justice on *Sisvel v Haier*, whereby it set new standards for SEP and FRAND claims in Germany. FRAND is the acronym for fair, reasonable and non-discriminatory. It generally arises in antitrust cases where an owner of intellectual property rights (IPR) refuses to grant a license or refuses to grant a license on FRAND terms. The court addressed three primary issues concerning jurisdiction, the meaning and scope of the term, “FRAND”, the applicability of Article 102 of the Treaty on the Functioning of the European Union.

The court clarified that under European Telecommunications Standards Institute's (ETSI) IPR Policy the court has jurisdiction to determine a global FRAND license, even without the consent of the parties involved. Hence, the English courts do have jurisdiction to try such cases, as no alternative forum was available. Addressing the second issue, the court was rather conservative while describing the scope of the term, “FRAND” a SEP (Standard Essential Patent) holder has to offer a royalty rate reflecting the value of the SEPs being licensed, and that rate does not cease to be FRAND simply because the SEP holder has previously granted a license on more favorable terms. The court thus rejected the concept of 'hard-edged' non-discrimination. Moving on to the third issue, the court examined when does Article 102 of the TFEU require specific conduct around injunctive relief. The UKSC upheld the lower courts' interpretation of the CJEU's Judgment, agreeing that the only mandatory condition in the *Huawei v ZTE* framework is the requirement for the SEP holder to notify or consult with the alleged infringer before bringing a claim for an injunction. The remaining steps in the framework are not a “mandatory protocol” but compliance gives the SEP

holder a “safe harbor” against a finding of abuse of dominance under Article 102 TFEU. Thus, in conclusion, the judgment confirms that English courts may set the terms for global FRAND licenses to portfolios of declared standard essential patents.

#### **Constantin Film Verleih GmbH v YouTube LLC, Google Inc.<sup>8</sup>**

The European Court of Justice (ECJ), Fifth Chamber, via a judgement dated 9th July, 2020 gave a landmark ruling, whereby it held that the IP address of users of YouTube and Google who upload illegal and infringing videos or files, is not part of the 'address' in the sense of the relevant EU directive, nor is the user's email address and telephone number. The German Company Verleih GmbH, had bought an action before the German courts against YouTube and Google, the parent company of YouTube. YouTube refused to disclose the IP addresses, e-mail addresses and telephone numbers of its users to Constantin, even though these users had demonstrably infringed Constantin's intellectual property rights by illegally uploading videos that had been viewed tens of thousands of times. The German Court further referred the said case to the ECJ to interpret the term “addresses”, within the meaning of German Copyright Law (§ 101 (2) sentence 1 no. 3 UrhG) and EU Directive (Article 8(2)(a) of Directive 2004/48).

The ECJ was of the opinion that in order to protect the personal data of its member states and their citizens, the term 'address' must be given its everyday meaning, which is just a postal address, and therefore if the term is used without further clarification (as is the case here) it does not refer to email, telephone or IP addresses, and where the EU legislature has intended to refer to email or IP addresses it has done so expressly by qualifying the word 'address'. The CJEU reiterated that Article 8(3)(a) of the IP Enforcement Directive gives Member States the option to grant right-holders the right to receive fuller information, so long as a fair balance is struck between the various fundamental rights involved (i.e. Article 17(2) on the protection of intellectual property and Article 8 on the protection of personal data of the Charter of Fundamental Rights of the European Union) and compliance with the other general principles of EU law, such as the principle of proportionality.

<sup>7</sup>Unwired Planet International Ltd. and Anor v Huawei Technologies (UK) Co. Ltd. and Anor; MANU/UKSC/0011/2020 (United Kingdom).

<sup>8</sup>Constantin Film Verleih GmbH v YouTube LLC and Google Inc.; C-264/19 (European Union).



## India, US sign MoU on Intellectual Property Cooperation

Department for Promotion of Industry and Internal Trade (DPIIT), Ministry of Commerce and Industry signed a Memorandum of Understanding (MoU) on 2nd December 2020, in the field of Intellectual Property Cooperation with the United States Patent and Trademark Office (USPTO). Dr. Guruprasad Mohapatra, Secretary, DPIIT and Mr. Andrei Iancu, Under Secretary of Commerce for Intellectual Property & Director, United States Patent and Trademark Office (USPTO) conducted a virtual signing ceremony for the same. The Union Cabinet in its meeting dated 19.02.2020 gave the approval for signing the MoU with USPTO in the field of IP Cooperation. The two side will draw up Biennial Work Plan to implement the MoU which will include the detailed planning for carrying out of the co-operation activities including the scope of action.

## Delhi High Court Proposes Rules Governing Patent Suits, 2020.

The Hon'ble High Court of Delhi vide its public notice dated October 09, 2020, notified that the Court is in the process of framing Rules under Section 158 of the Patents Act, 1970. The Court has also released a draft of the proposed "The High Court of Delhi Rules Governing Patent Suits, 2020" and has requested members to provide their comments/suggestions on the same. The Rules shall govern the procedure for adjudication of all patent suits in accordance with the provisions under the Patent Act, 1970, and the Code of Civil Procedure, 1908 (CPC) as amended by The Commercial Courts Act, 2015. The Rules shall govern all patent suits and actions and the procedure set out in these Rules over the Delhi High Court (Original Side) Rules, 2018, insofar as they are inconsistent with the same.<sup>9</sup>

## India, Denmark ink pact to increase cooperation on IPRs.

India and Denmark, on September 26th, 2020, signed a Memorandum of Understanding (MoU) to increase cooperation in the area of intellectual property rights (IPRs) by exchanging best practices and collaborating in training programs. The MoU comes in the wake of the Covid-19 pandemic and could be substantial in fostering cooperation between the countries and exchanging information and best practices on processes for disposal of applications for patents, trademarks, industrial designs and Geographical Indications, as also for protection, enforcement and use of IP rights. The MoU was signed between DPIIT and Danish Patent and Trademark Office, Ministry of Industry, Business and Financial Affairs, Kingdom of Denmark.<sup>10</sup>

Justice Manmohan Singh's tenure as IPAB's Chairman extended for three more months by Supreme Court until December.

A three-judge bench of the Supreme Court, on 16th September 2020 extended Justice Manmohan's Singh tenure as the Chairman of the IPAB for three more months. The bench passed this order while hearing a batch of petitions concerning appointments to the Tribunals and the difficulties, the Tribunal Rules, 2020 might face. The order came in light of the post of the chairman being vacant since September 21, 2019, which had led to various obstacles in the functioning of the IPAB.<sup>11</sup>

## India and South Africa demand waiver of certain provisions of Intellectual Property for Covid-19 therapeutics.

Countries like India and South Africa are facing certain limitations in accessing technologies for producing medicines for COVID-19 even for a medicine like remdesivir, which is being used to help patients and is not a cure for the viral infection. A few Indian companies were granted voluntary licences by the originator company, Gilead Sciences, but these have two limitations. One, the prices at which the product is currently available in India are relatively high, and two, the medicine cannot be exported to other countries. A waiver from the application of patent provisions of the TRIPS agreement would enable the availability of medicines for COVID-19 at affordable prices as patent monopoly can then give way to a competitive marketplace.

## US & EU block India & South Africa's move for an IPR waiver for Covid Vaccines

The US, European Union, the UK and Switzerland, along with Brazil, have not supported India and South Africa's proposal for temporary IPR waiver for COVID vaccines at the WTO, despite receiving backing from the World Health Organization, and several other developing countries including China, Thailand, Pakistan, Indonesia and Turkey, the two main blocks have opposed the move. The proposal is still on the table though and needs to be ratified by the WTO TRIPS Council by the end of this year.

## India enters top 50 in the Global Innovation Index in its 2020 iteration.

India has joined the group of top 50 countries in the Global Innovation Index for the first time, moving up four places to the 48th rank and keeping the top position among the nations in central and southern Asia. Switzerland, Sweden, the US, the UK and the Netherlands lead the innovation ranking, and the top 10 positions are dominated by high-income countries. WIPO, in its official statement acknowledged India becoming the third most innovative

<sup>9</sup>[http://delhihighcourt.nic.in/writereaddata/Upload/PublicNotices/PublicNotice\\_G35K9Q0PX99.PDF](http://delhihighcourt.nic.in/writereaddata/Upload/PublicNotices/PublicNotice_G35K9Q0PX99.PDF).

<sup>10</sup><https://www.thehindu.com/business/Industry/india-denmark-ink-pact-to-increase-cooperation-on-iprs/article32702722.ece>.

<sup>11</sup>In Re: Appointment of Judicial Members in the Armed Forces Tribunal v. Ministry of Defence & Anr., Writ Petition(s) (Civil) No(s). 857/2016. (India)



lower middle-income economy in the world, thanks to newly available indicators and improvements in various areas of the GII. India ranks in the top 15 in indicators such as ICT (Information and Communication Technology) services exports, government online services, graduates in science and engineering, and R&D-intensive global companies.<sup>12</sup>

### **Revised Patent Rules in India effective from 19 October, 2020.**

The key amendments that have now been introduced are related to the working Statement regarding the working of Patented Invention in India as required under Form 27 and changes to the provisions of filing of Priority documents under Rule 21 of the Rules. As per the Rules, the Statement regarding working of Patents under Rule 131 (1) which was earlier required within three months from the calendar year commencing immediately after the calendar year in which the patent was granted, have now been changed to within six months from the expiry of financial year commencing immediately after the financial year in which the patent was granted. The Rules also allow patentee to file single form for multiple patents, provided all of them are related patents the approximate revenue / value accrued from a particular patented invention cannot be derived separately from the approximate revenue/value accrued from related patents, and all such patents are granted to the same patentee(s). Further, if a Patent is granted to two or more persons, all such person can file the statement of working jointly. However, each licensee of a patent is also required to File Form 27 individually.

### **Digitization amid COVID-19 | Centre likely to amend The Copyright Act**

The Copyright Act, 1957, provisions for rights of creators in areas such as artistic works, drama, films, literature, music and sound. It was last amended in 2012 to protect intellectual property rights (IPR) of Indian artists in line with the World Intellectual Property Organization (WIPO) Treaty on Copyright and the WIPO Treaty on Performances and Phonograms. The Centre has reached out to the creative industry seeking their inputs as it considers amending the Copyright Act due to accelerated shift to online platforms and digitization amid the COVID-19 pandemic.

### **WIPO Launches New Free Database of Judicial Decisions on Intellectual Property from Around the World.**

The World Intellectual Property Organization (WIPO), on

<sup>12</sup>India now in top 50 countries in global innovation index for the first time - The Financial Express

<sup>13</sup><https://www.wipo.int/pressroom/en/articles/archive.html>

<sup>14</sup><https://www.gov.uk/government/news/intellectual-property-after-1-january-2021>

24th September 2020, launched WIPO Lex-Judgments, a new database providing free-of-charge access to leading judicial decisions related to IP law from around the world. WIPO Lex-Judgments will contribute to informing and strengthening courts' analyses and reasoning, as well as to discerning both converging and contrasting national approaches to common IP questions. In addition, WIPO Lex-Judgments would also provide information on the judicial structures for IP disputes in participating member states. This would allow users to appreciate the spectrum of structures that include generalist and specialist courts, as well as administrative entities that carry out quasi-judicial functions, and their diverse features that respond to the technical nature of IP disputes, from around the world.<sup>13</sup>

### **UKIPO publishes information on changes to UK IP laws from 1st Jan 2021, as the country gears up for post-BREXIT era.**

As UK descends towards the end of its transition period, post BREXIT on 31st December 2020, the UK Intellectual Property Office (UKIPO), on 28th October, 2020, announced that there would be changes to UK's Intellectual Property Law to ensure the smooth departure from EU IP systems. UK attorneys would no longer be able to represent clients on new applications or new proceedings at the EU Intellectual Property Office (EUIPO). UK trademark owners will need to appoint an EEA attorney to represent them on new applications and proceedings before the EUIPO.<sup>14</sup>

Further, the UKIPO specifically laid down guidelines, demonstrating the various changes to the country's IP rights. From 1 January 2021, subject to legislative implementation, only an address for service in the UK (which for these purposes includes the Isle of Man), Gibraltar or the Channel Islands will be accepted for new applications and new requests to start contentious proceedings before the IPO. The change will apply across all the registered IP rights (patents, trademarks and designs).

### **Daren Tang is the new WIPO General Director, INTA appoints Tiki Dare as its President for 2021.**

Daren Tang, a national of Singapore, officially assumed his functions as Director General of the World Intellectual Property Organization on October 1, 2020, starting a six-year mandate at the helm of the Organization. WIPO's member states on May 8, 2020, appointed Mr. Tang by consensus as the Organization's next Director General, following his nomination by the WIPO Coordination Committee in March 2020. The International Trademark Association (INTA), on 19th November, 2020 also announced the election of Ms. Tiki Dare as the 2021 President of the Association and the Chair of its Board of Directors.



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The FICCI IPR Division is intensively involved with addressing the issues pertaining to protection and enforcement of Intellectual Property Rights in India. It has taken decisive steps in raising the levels of awareness about Intellectual Property Rights amongst the citizens of India. In this regard, FICCI's constructive contributions span various capacity building exercises and training programs for the industry, the judiciary, the law enforcement agencies and other IP stakeholders in the country. Further, the IPR division is a platform for continuous interaction between the industry and the Government with a view to providing an interface for businesses to resolve their issues pertaining to IPRs. Most importantly, FICCI is also instrumental in offering substantive and comprehensive inputs and feedback to the Government on policy-related matters.

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