

IPR – Infringement and Enforcement

Workshop for High Court Judges

4th April 2021

@National Judicial Academy, Bhopal

Justice Prathiba M. Singh

Delhi High Court

prathiba@pmsingh.in

IP ISSUES IN COMMERCIAL COURTS



INTELLECTUAL PROPERTY IN DAILY LIFE



INTELLECTUAL PROPERTY IN DAILY LIFE



**SEMICONDUCTOR
CHIPS**

**BRAN
DS**



**DESIGN
S**



**PATENTS IN
TECHNOLOG
Y**



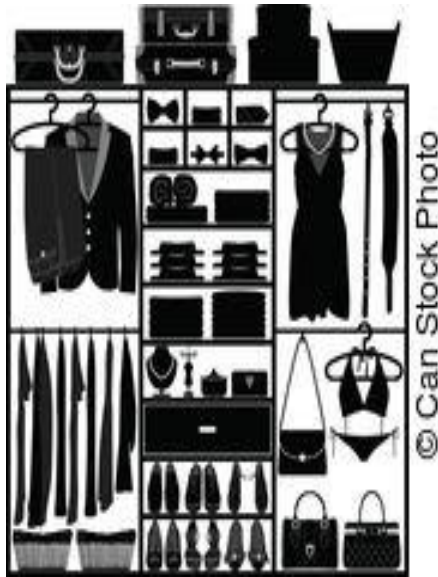
App Store



Google play

**COPYRIGHTS IN
'APPS'**

INTELLECTUAL PROPERTY IN DAILY LIFE



fabindia

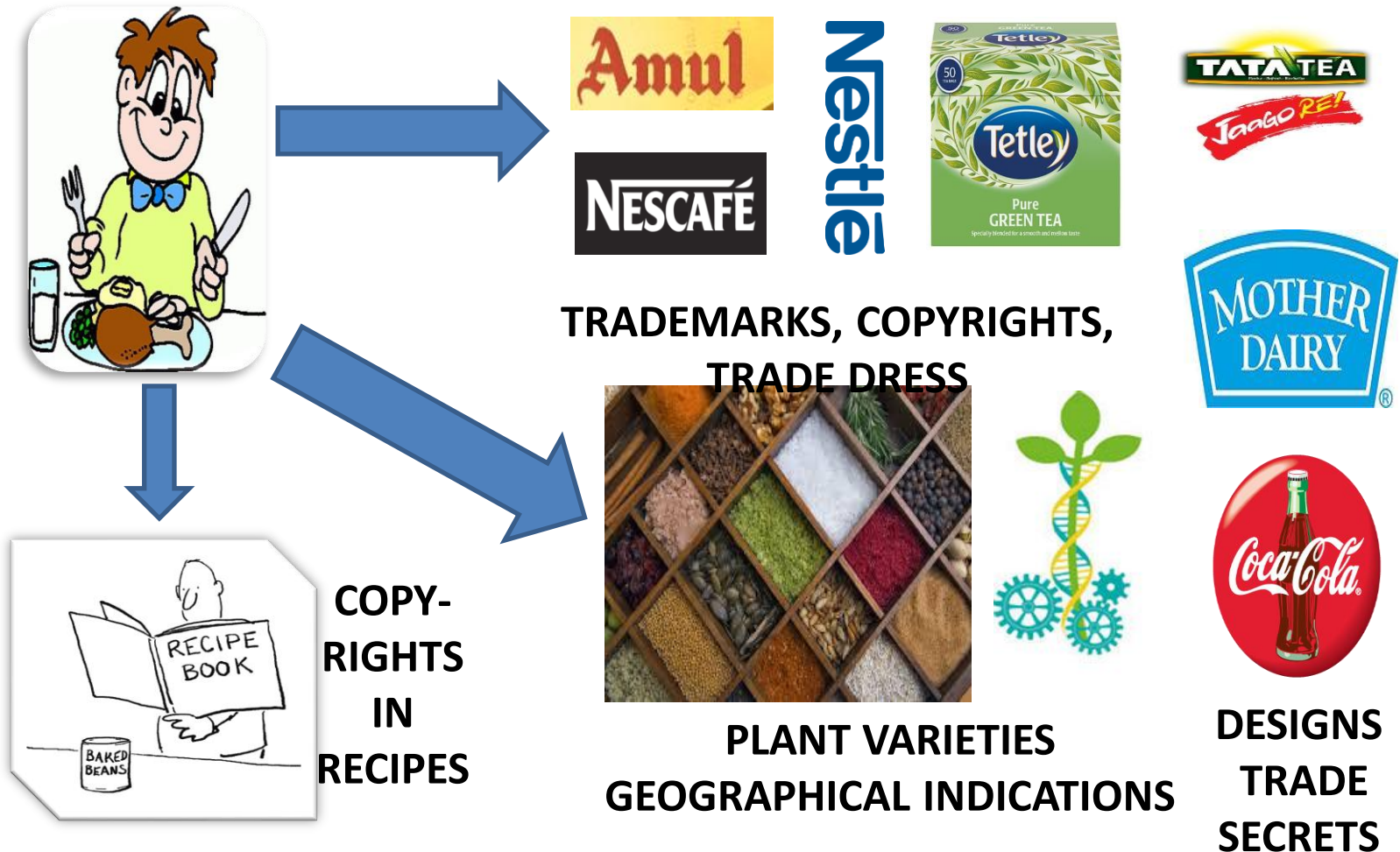
Calvin Klein

raymond

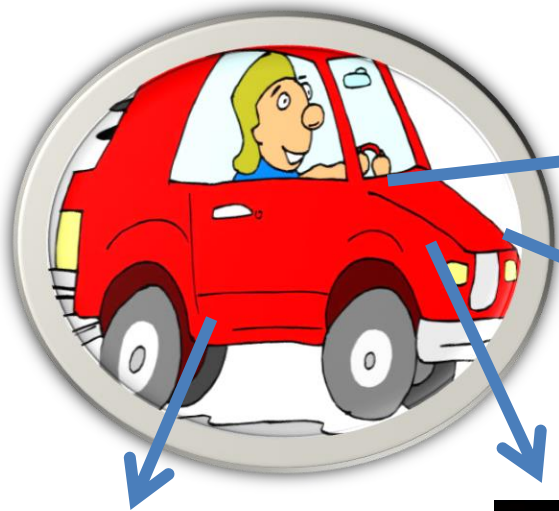
DESIGNS
TRADEMARK
S
COPYRIGHTS
GEOGRAPHIC
INDICATIONS



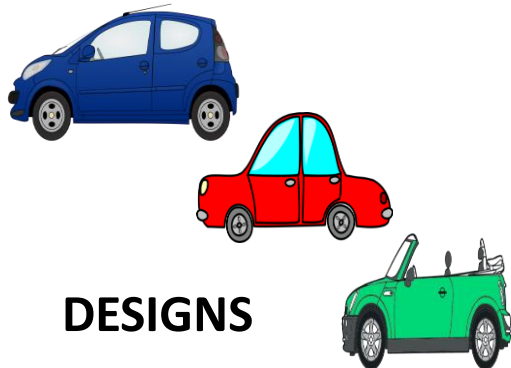
INTELLECTUAL PROPERTY IN DAILY LIFE



INTELLECTUAL PROPERTY IN DAILY LIFE



**COPYRIGHT IN MUSICAL WORKS
FM RADIO-COMPULSORY
LICENSING**



DESIGNS



**PATENTS IN
TECHNOLOGY**



HONDA

**TRADEMARKS, COPYRIGHTS
IN ARTISTIC WORK**

INTELLECTUAL PROPERTY IN DAILY LIFE



TRADEMARKS



TRADE DRESS



iOS



Linux

**COPYRIGHT IN
SOFTWARE**

INTELLECTUAL PROPERTY IN DAILY LIFE

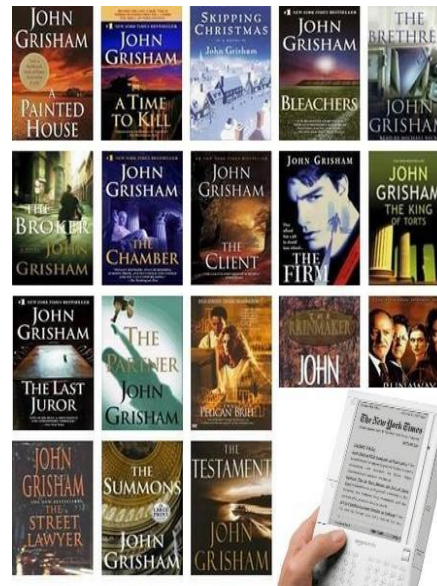


**BROADCASTING
RIGHTS**



COPYRIGHT

INTELLECTUAL PROPERTY IN DAILY LIFE



**COPYRIGHTS IN
BOOKS**

INTELLECTUAL PROPERTY PROTECTION IN THE DIGITAL AGE



- Determination of Jurisdiction
- Innovative Remedies to tackle Online infringement
- Intermediary Liability

JURISDICTIONAL ISSUES IN THE DIGITAL AGE

- ‘Place of business’
- Purposeful Availment of Forum Court
- Global Injunctions



JURISDICTION – RELEVANT PROVISIONS

Usually, suits are instituted

- in the place where the Defendant resides OR
- where the cause of action arose

However, Section 134 of the Trade Marks Act, 1999 & S. 62 of the Copyright Act, 1957: Suit can be filed where the **Plaintiff carries on business** – IP owner friendly provision

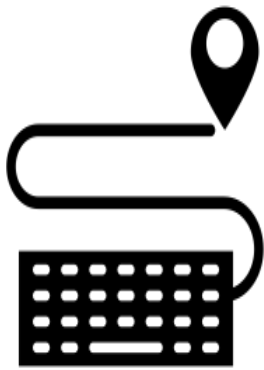
Burger King Corporation v. Techchand Shewakramani & Ors. [CS(COMM) 919/2016, decided on 27th August, 2018]

- ❖ Defendant using BURGER KING and HUNGRY JACK
- ❖ Suit filed in Delhi High Court. Defendant located in Mumbai
- ❖ Defendant published an advertisement calling for franchisees
- ❖ 'Purposeful availment test'



World Wrestling Entertainment Inc. v. M/s Reshma Collection[2014 (6) PTC 452 (Delhi High Court)]

- ❖ Plaintiff based in USA. No office in India
- ❖ Defendant based in Mumbai. Suit filed in Delhi High Court
- ❖ Court held: ***“Because of the advancements in technology and the rapid growth of new models of conducting business over the internet, it is possible for an entity to have a virtual presence in a place which is located at a distance from the place where it has a physical presence.*”**
- ❖ ***When the shop in the ‘physical sense’ is replaced by the ‘virtual’ shop because of the advancement of technology, in our view, it cannot be said that the appellant/ plaintiff would not carry on business in Delhi.”***



*Millennium & Copthorne Intl, Ltd. v.
Aryans Plaza Serv. Pvt. Ltd. & Ors.*
[CS(COMM) 774/2016, 5.3.2018]

- The Plaintiff – Millennium & Copthorne International Ltd., Singapore based;
- Protection sought for Plaintiff's trademark “MILLENIUM” by running a hotel and resort under that name. Defendant hotels located in Haryana. However, bookings could be made in the hotel through third party websites



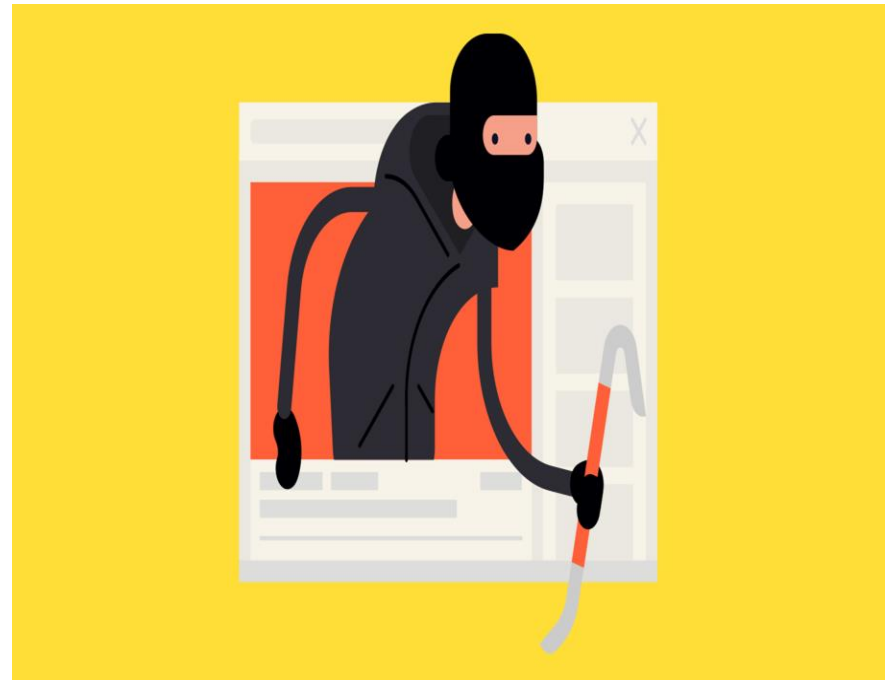
- Suit filed in Delhi High Court. Jurisdiction upheld **even if bookings done through third party websites – local population specific target.**

Juggernaut Books Pvt. Ltd v. Ink Mango Inc. & Ors. [CS(COMM) 421/2019, decided on 9th August, 2019]

- The Plaintiff – Juggernaut Books Pvt. Ltd. (Delhi based), was a publisher of books and e-books by various well-known authors through a web-based software which is accessible from computers and smart phones on its platform - 'www.juggernaut.in'.
- Defendant – a New York based company was using an identical domain name www.thejuggernaut.com
- The Court found that it had the jurisdiction to entertain this matter as the Defendants had purposefully availed of the Court's jurisdiction. The Court granted an interim **injunction** against the Defendants and also directed blocking of the Defendants' website.

NEW METHODS OF INFRINGEMENT

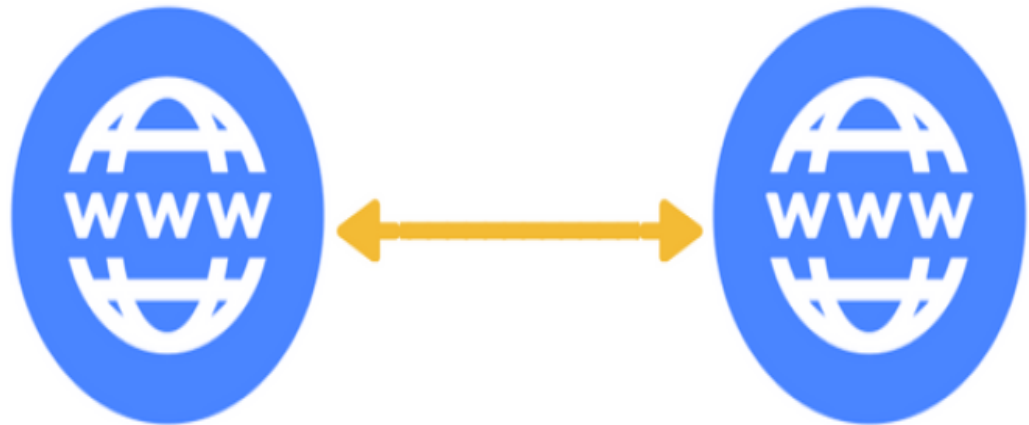
- Rogue Websites
- Cybersquatting
- Mirror Websites



INNOVATIVE REMEDIES

DYNAMIC INJUNCTIONS

- ❖ URL blocking not sufficient – STAR TV – Cricket matches
- ❖ Mirror websites, Rogue websites, Hydra-headed;
- ❖ Delhi High Court granted a dynamic injunction – extending to identical websites



INNOVATIVE REMEDIES

GEO-BLOCKING V GLOBAL INJUNCTION

Swami Ramdev & Anr. v. Facebook & Ors.

[CS (OS)27/2019, 23rd October, 2019 (Delhi High Court)]

- ❖ Defamatory Content on Google platform.
- ❖ Global injunction sought for removal of all links;
- ❖ Google agreed for GEO-BLOCKING
- ❖ Reliance placed on Google Vs. Equustek – Canadian and US decisions
- ❖ Delhi High Court directed – if the defamatory material was uploaded from India, Indian courts can grant global injunctions.
- ❖ For uploads from outside India, the court ordered platforms to ensure that they use appropriate geo-blocking measures, so that users from India (Indian IP addresses) were unable to access the content.

INNOVATIVE REMEDIES

JOHN DOE ORDERS; DOMAIN NAME PROTECTION

The Court granted dynamic injunctions against rogue websites for infringing the well known trademarks

SNAPDEAL – an ecommerce website.

AMUL – Milk products mark.



The Court granted injunctions against all of the websites including certain John Doe Defendants in this case.

INTERMEDIARY LIABILITY

- ❖ Safe Harbour Provision under Indian Law: Section 79 of Information Technology Act, 2000
 - ❖ *Exemption from liability of intermediary in certain cases. -*
 - ❖ *Notwithstanding anything contained in any law for the time being in force but subject to the provisions of sub-sections (2) and (3), an intermediary shall not be liable for any third party information, data, or communication link made available or hosted by him.*

MySpace Inc. v. Super Cassettes Industries Ltd. *[236 (2017) DLT 478 (Delhi High Court)]*

- ❖ Infringing copyrighted content;
- ❖ My Space being an Intermediary has a 'take down obligation'
- ❖ The Court differentiated between **active and passive** **interm**



Christian Louboutin SAS v. Nakul Bajaj and Ors.

[2018(76) PTC 508 (Delhi High Court)]

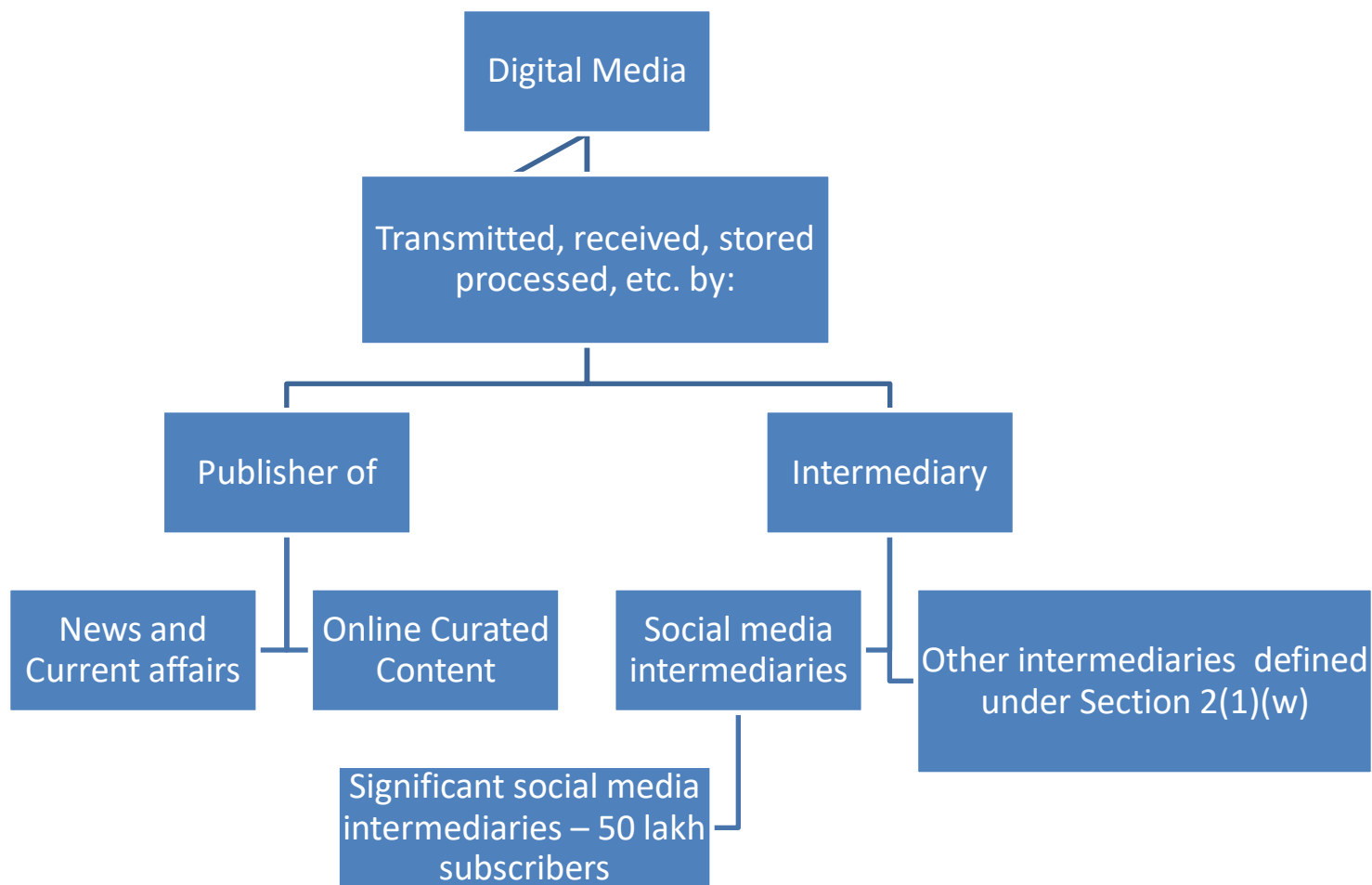
Court laid down 26 elements - determining whether the website has services contemplated in Section 2(w) [definition of intermediary] of the IT Act, 2000 and whether the website is “*conspiring, abetting, aiding or inducing and is thereby contributing to the sale of counterfeit products on its platform.*” Some of the key elements:

- ❖ Identification of the seller and providing details of seller
- ❖ Providing reviews or uploading reviews of products
- ❖ Providing assistance for placing a booking of product
- ❖ Packaging the product with own packing instead of original packing
- ❖ Favourable arrangements with various sellers
- ❖ Arranging for exchange of product if there is a customer complaint

Intermediary guidelines 2021

- The Central Government, by notification dated 25.02.2021 notified the Information Technology (Intermediary Guidelines and Digital Media Ethics) Rules, 2021 in supersession of the Information Technology (Intermediary Guidelines) Rule, 2011.
- By their very nomenclature, the Intermediary Guidelines, 2021 are much broader in scope than their 2011 counterpart. The 2021 Guidelines are applicable to social media and online media intermediaries and other entities which are defined under it as also under Section 2(1)(w) of the Information Technology Act, 2000.

Rules applicable to:



Intermediary guidelines 2021

- **Part 2 – Due diligence obligations of intermediaries**
- To publish Rules & Regulations, Privacy policy and the user agreement
- They have to inform all users not to Host, display, upload, modify, publish, transmit, share, etc.
 - any information which belongs to another person,
 - infringes any patent, trademark, copyright or other proprietary rights,
 - violates any law for the time being in force, or
 - impersonates another person, amongst other things

Intermediary guidelines 2021

- Upon receiving a court order or information from the appropriate government
- The information has to be taken down
- If it is violative of any law
- Affects sovereign interest, relations with foreign states etc.,