This article attempts to summarize some of the recently reported cases on intellectual property law to enable the readers understand how the courts have applied principles of the law to actual IP disputes. The cases are chosen from the cases reported in ‘The Patents and Trade Marks Cases’, a leading case law reporter on intellectual property laws. In this article, the cases reported in the months of February and March 2007, are covered.

**Keywords:** Trade slogan, novelty, mosaicing

The concepts we read in intellectual property law acquire better clarity when understood in the context of application of the law by the court to a set of facts in the real life dispute. However, many of the readers of this magazine are scientists and do not get to read the regularly reported cases. The attempt in this article is to summarize some of the recently reported cases to enable the readers understand how the courts have applied principles of the law to actual IP disputes. Obviously, it is neither practical nor necessary to narrate all of the reported cases. Some cases are chosen on the basis of certain principle. To ensure that readers do not get distracted, the issues other than the main principle being explained in the judgment are left out. This narration is intended only to kindle the interest of a knowledge seeking mind to go through the full text of the cases and is not intended to be a definitive statement of law or a complete summary of the judgments involved.

**Trademark Cases**

**Trade Slogans**

Short and catchy phrases or sentences which many enterprises use in their advertisements are almost ubiquitous in the advertising world. These are generically called trade slogans. To what extent trade slogans can be protected is one of the issues involved in *Gomzi Active v Reebok India Co & Anr* [2007 (34) PTC 161 (SC)]. Many readers might have noticed the advertisement of Reebok featuring the theme line ‘*I am what I am*’. This catchy phrase is at the centre of the controversy in that case.

The Plaintiff, Gomzi, contends that the trade slogan, ‘*I am what I am*’ is its creation, used on garments since 1998 in its own distinctive style. They charged the defendant, Reebok of stealing or pirating this trade slogan. They asserted that they were the first to use the slogan and therefore, they alone can claim rights over the said slogan as a trademark.

Before the Trial Court, at the preliminary stage before trial, the plaintiff sought *ad interim* injunction against the defendant, Reebok’s use of the slogan. The Court, based on the documents and pleadings before it including certain magazine advertisements issued by the plaintiff in 2002, had found that the plaintiff adopted and used the slogan ‘*I am what I am*’ before the defendant, which had started its use only in 2004. The Court held that the use of the slogan by Reebok is likely to create confusion in the minds of the public and granted a temporary injunction prohibiting the use of the slogan by Reebok. The Court also held that trade slogans are not registrable under the Trademarks Act, 1999 and hence the plaintiff is not entitled to injunctive relief under the Trademarks Act but is entitled only to the relief of passing off.

The matter came up in appeal before the High Court of Karnataka. The defendant, Reebok contended that the plaintiff had not proved that the
slogan had acquired a distinctive character, hence cannot claim passing off. Further, they also claimed that the slogan does not fall under the category of intellectual property. The plaintiff respondents submitted cross objections before the High Court challenging the finding that the slogan is not a registrable trademark under the Trademarks Act. They pleaded that the definition of trademark under the Trademarks Act, 1999 will involve even a set of words.

The High Court observed that an action for passing off will lie wherever the defendant company’s mark is calculated to deceive or divert the business from the plaintiff or to create confusion in the market. For passing off action to succeed, the plaintiff has to demonstrate that the disputed mark has acquired a distinctiveness, which leads to the conclusion that the use of the mark will induce the public to believe that the goods belong to plaintiff. The High Court held that the trade slogan ‘I am what I am’ is in the nature of a generic phrase and it cannot be prima facie concluded that it has acquired a distinct character vis-à-vis goods produced by the plaintiff. It cannot be stated that the consumers of the plaintiff are misled in identifying their products that they originated from Reebok. Both plaintiff and defendants have different trade names and different and distinct trademarks. The High Court did not find a prima facie case of passing off and vacated the injunction granted by the Trial Court.

Gomzi appealed to the Supreme Court. The Court refused to reverse the order of the High Court stating that grant of interim protection in this case before leading of evidences would not be proper. But it directed early disposal of the suit, as expeditiously as possible, preferably by the end of April 2007. The defendant, Reebok, was also directed to maintain separate accounts in respect of impugned transactions.

**Comment**

One thing is certain. The last word in this controversy has not been heard, yet. If at the interim stage the case is fought up to the Supreme Court, the final decision of the Court may also be subject to such challenges. One may also notice that the Indian court system is not as slow as often alleged to be, as the suit filed in the above case in 2005 got an interim order without any delay, got disposed of at all stages from the Trial Court to the Supreme Court by February 2007. The Trial Court has also been directed to complete the trial of the suit by April 2007.

**Patent Cases**

One way to judge the prominence that patents have acquired in India is to look at the number of cases getting reported under this head. Though, still few and far in between as compared to trademarks and copyright cases, the increasing number of reported patent cases show that patents are slowly but steadily seeking to find their rightful place.

**Novelty and Mosaicing**

In *Bilcare Ltd v Amartara Pvt Ltd*, the plaintiff is the holder of patent no. 197823 granted by the Indian Patent office on 12 April 2006 based on their application dated 3 March 2004. The invention involved was used in packaging of medicines. The essentials of the patent claims are a film, which has a core PVC layer, a metallized layer and the third polymeric layer ranging from 0-250 microns. The film is thermoformable and translucent.

The plaintiff, Bilcare had also obtained a patent for this invention on 15 December 2006 with US Pat No 7,144,619. The only difference between the patent claims as granted in India and in US is the thickness of the polymeric layer which in India is specified between 0-250 microns while in US it is specified as 1-250 microns, a modification carried out during examination.

The plaintiff claimed that the defendant infringed its patent by supplying identical film to the pharmaceutical industry and filed a suit for permanent injunction, rendition of accounts and consequential relief. They were granted an *ad interim, ex parte* injunction, which was challenged by the defendants, which is the subject matter of this decision.

It was claimed by the plaintiffs that though use of metallized packaging was already known, the ingenuity of the invention was in the manufacture of the particular variety of packaging film. It had a metal base, the thickness of which prevented the metal from migrating to the capsule. The film on the top is translucent through which medicine can be seen. This acted as a barrier against moisture, which was claimed in the patent as advancement over the existing transparent blister films, which failed to provide moisture barrier. Since the film is thermoformable it acted as a barrier against pressure, which was an advancement over the existing films, apart from being cheaper. It is this combination, which is the subject matter of the patent.

The defendant claimed invalidity of the patent on the ground of lack of novelty as it claimed that such
films already existed in the market. They also contended that the plaintiff failed to disclose that it was not manufacturing the product but was sourcing it from a third party from whom the defendants were also sourcing their product.

The plaintiff objected to what they claimed as the defendant’s endeavor to object the patent by referring to different components of the claim lacking novelty and not the patent as a whole. They contended that one cannot create a mosaic of individual documents or prior use to defeat the claim of patent or establish prior use. The plaintiffs relied on Terrell’s authoritative text on Law of Patents which stated, ‘while dealing with novelty, the mosaicing of individual documents or prior uses are not permissible. While dealing with the question of obviousness, it is permissible to make a mosaic of the relevant documents, but it must be a mosaic which can be put together by an unimaginative man with no inventive capability’. The plaintiff thus, submitted that the novelty of the patent cannot be challenged on the ground that it is a combination of prior existing things. They pleaded that an invention would not be novel if all the elements of the invention are contained in a prior publication. Novelty will not be destroyed by mosaicing of different elements contained in different documents.

The Court observed that the object of grant of patent is to encourage scientific research, adoption of new technology and industrial progress. But merely because a patent has been granted does not guarantee the validity of the patent. It is open to challenge before a court and particularly, where a post grant opposition has been filed as in the present case. But the case being at the interim stage, only a prima facie view can be taken and final view would arise only after trial of the suit. The essential elements of a patent, namely, novelty and inventive step have to be satisfied and it would depend on the facts of each case.

The Court found that the use of PVC metallized films was in existence in drugs and pharmaceutical industry. Metallization of polymeric film was also known. The claim of the plaintiff was the manner of use of the components to produce metallization of PVC to maintain translucency, thermoformability and a thickness, which prevents moisture and migration of additives to the tablet. The Court found that not only the individual components of the invention, even the combination was also known in the industry.

The emphasis of the plaintiff was on the combination of thickness of different material and in the absence of any evidence being recorded, the Court held that at the prima facie stage it cannot be held that there is a newness in it that would give it a right to be patented. As to what thickness of each of the components would best combine to give an appropriate result is a mere matter of experimenting with different thickness. Prima facie, it does not appear to have an inventive quality. Thus, it is not a case of mosaicing by defendant but of the plaintiff using known factors and materials to make some adjustments and then claiming patent, which is not permissible. Thus, the Court held that the patent does not satisfy the test of a new invention and was already known to the trade.

The Court also found that the claim of the patent was for a multilayered film of at least three layers while the defendant is manufacturing a two layered film. The Court refused to be persuaded by the argument of the plaintiff that its claim included two layered films also, based on the wording of the claim. The Court also found that the plaintiff had not disclosed the full facts relating to manufacture of its product by a third party in its plaint. The Court vacated the ex-parte interim injunction but asked the defendants to keep account of the product in question. Stating that the ex-parte injunction has resulted in loss for the defendant, a cost of Rs 50,000 was awarded to the defendant.

Rules for Grant of Injunction in Patent Cases

In Bilcare Limited v Supreme Industries Ltd [2007 (34) PTC 444 (Del)] on the same invention as the above discussed case the Delhi High Court discussed in detail the principles to be followed in granting temporary injunction in patent cases. This case is a recommended reading for anyone interested in the legal principles governing grant of injunctions in patent disputes.

The Court observed that all patent holders would like to get an interim injunction in infringement disputes. But Court will have to look at the strength of the case in terms of ‘prima facie case’, ‘balance of convenience’, and ‘irreparable injury’. The issue arises how much of weightage courts should give to a patent which has been issued after an examination. Does a patent per se make out a prima facie case?

The basic common law principles governing the grant of temporary injunction in patent cases is drawn up in the decision of House of Lords in American
Cynamide Co v Ethicon Ltd. According to the principle laid out in that case there is no rule that a plaintiff patent holder must make out a prima facie case. All the court needs to do is to ascertain if there is a serious issue to be tried. The principle laid out in that case, is favourable to the patentee in the sense that if there is a prima facie case to go for trial then the plaintiff does not have to further substantiate the existence of prima facie case for the purposes of trial. It was also laid out in that case that if the patent is a new one, a mere challenge of its validity would be sufficient to refuse temporary injunction. But if the patent is sufficiently old and has been worked, the court would, for the purpose of temporary injunction, presume the patent to be a valid one.

This principle was followed by Indian courts in K Ramu v Adayar Ananda Bhavan and Muthulakshmi Bhavan (CS No. 495 of Madras High Court). In these cases, it was held that prima facie case was established by proving that plaintiffs are protected by the certificate of patents. In Metro Plastic Industries v Galaxy Footwear [2000 PTC (20) 1 Del (FB)] it was held that ‘merely because registration is recent by itself would not be a ground for refusal of injunction’, thereby extending the American Cynamide ratio.

In M/s National Research Development Corporation of India, New Delhi v The Delhi Cloth and General Mills Co Ltd &Ors (AIR 1980 Del 132), it was held that as a rule of practice, if the patent is new, a mere challenge at the bar would be sufficient for refusal of temporary injunction but if the patent is sufficiently old and has been worked, the court would presume the patent to be valid for the purposes of temporary injunction. If the patent is more than 6 years old and it has actually been worked, then the court will proceed with such presumption. However, the court observed a deviation from this approach in later cases.

In M/s Niky Tasha India Pvt Ltd v M/s Faridabad Gas Gadgets Pvt Ltd (AIR 1985 Del 136), it was held that an interlocutory injunction will not normally be granted where damages would provide an adequate remedy, should the claim succeed. It was also held that the court will not grant an interlocutory injunction unless satisfied that there is a real probability of the plaintiff succeeding at the trial.

Also, the Supreme Court in Biswanath Prasad Radhey Shyam v H M Industries (AIR 1989 SC 1444), held that the grant of a patent or the decision rendered by the Controller in the case of opposition does not guarantee the validity of patent which can be challenged before the High Court on various grounds in revocation or infringement proceedings.

In Dhanpat Seth and Ors v Nil Kamal Plastic Crates Ltd [2006 (33) PTC 330 (HP)], it was observed that the statutory law prevailing in India is contrary to the rules laid down in the American Cynamide case, on prima facie presumption of validity of patent, in view of the Section 13 (4) of the Patents Act, 1970.

Based on the principles laid out in these and other cases, the court found that the case is not fit for grant of interim injunction as the patent is only two years old, there are tangible grounds of suspicion about the validity of the patent and finally, it is not proper to upset the well reasoned judgment of the trial court.

Holding that the three essential conditions for grant of injunction, prima facie case, balance of convenience and irreparable loss favour the defendants, the court upheld the decision of the Trial Court in refusing the grant of injunction.

Amendment of Patent Applications

Section 78 of the Patents Act, 1970 deals with the power of the Controller to correct clerical errors in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent. The correction may be made upon the request of any person interested in the patent or by Controller himself in which case he gives an opportunity to the patentee or the applicant. Section 78 may be seen in contradistinction with the Section 57 which deals amendment to the patent application and to the specification therein. Under this Section an application may be made by a patent applicant or a patentee to amend the application for the patent or the complete specification or any related document.

The issue of the extent of what can be corrected under Section 78 of the Act was dealt with in AIA Engineering Ltd v Controller of Patents & Anr [2007 (34) PTC 457 (Del)]. The Court observed that Section 78 only confers a power to correct clerical errors in any patent or in any specification or in any other document. Section 57 refers to an amendment of an application made by the patentee. While under Section 78, the Controller can make an amendment suo motu, under Section 57 an amendment can be made only by an application from the patent applicant or patentee. Amendments which have the effect of
changing the scope of the original disclosure cannot be made under Section 78.

The patent in dispute is the Indian Patent No. 197257. Certain amendments were carried out to the original published specification of the patent under Section 78. The petitioner in this case contended that such amendments were not clerical errors and the grant of such amendments amounted to fraud on the patent office and the public at large. The amendments in dispute were substitution of the words ‘homogenous phase’ instead of ‘homogeneous solid solution’ in claim 1; substitution of ‘pad’ in place of ‘roller’ in claim 1 and in other claims; and substitution of ‘by volume’ in place of ‘by weight’ in claim 4. The Assistant Controller of Patents had allowed these amendments as rectification of obvious and clerical errors after due consideration of records including corresponding PCT application and European and US patents.

However, before the High Court, the Controller of Patents filed an affidavit stating that on scrutiny he had found that the amendments could not be categorized as clerical errors. The amendments which have been made are technical in nature and appear to be beyond the scope of original disclosure. Holding that, ‘the order of the Assistant Controller in allowing the amendments under Section 78 suffers from a patent error and improper exercise of jurisdiction’, the High Court set aside the order.

Copyright

Copyright on Case laws?

The decision of the Kerala High Court in Infoseek Solutions & Anr v Kerala Law Times and Ors [2007 (34) PTC 231 (Ker)] is of interest to copyright scholars in more ways than one. The issue relates to the extent of copyright protection in case law reports.

The Lower Court in this case had passed an order permitting copyright on case laws, restraining the appellants, M/s Infoseek Solutions Ltd, from reproducing judgments which are identical or substantially similar to the text of judgments of the ‘Kerala Law Times’, its head notes, short notes, long notes, etc. It was argued on behalf of appellants before the High Court that judgments do not have copyright and in the case of head notes or short notes etc, the plaintiff cannot claim copyright unless it is demonstrated that sufficient originality is exhibited in them by assimilating the contents of the judgment and that if portions of the judgments are merely copied, the same does not create any copyright. The plaintiff respondents contended that the plaintiff has copyright in the layout, presentation and even unavoidable corrections of mistakes in the judgment and hence has copyright in plaintiff’s ‘version’ of the judgment.

The Court first examined whether the Copyright Act 1957 recognized copyright in judgments of courts. The Court observed that a judgment is the final decision of a court, intimated to the parties and to the world at large by formal pronouncement. A judgment so pronounced is the declaration of the mind of the court. The Supreme Court, in Surendra Singh’s case (AIR 1954 SC 194) has held that when a judgment is delivered, it is the judgment of the court and not of any judge. The judgments are the decisions of the court, which is an institution and not an individual. As per the constitutional scheme of India the court is an organ of the state. The judgments of the court could not be treated as documents over which there could be any copyright. The judgments are public documents; they belong to the state, to the people. They are in public domain and so there could not be any copyright over them.

Further, the judgments of the superior courts are an important source of law. Law is the expression of the sovereign, manifesting through the constitutional institutions, providing for the making and laying down of the laws. No one can have copyright over the law of the land.

The Court went on to analyse the sections with regard to copyright in various works to examine whether the judgments of the court have copyright. Section 16 of the Copyright Act provides that there shall be no copyright except as provided in the Act. The term ‘author’ in relation to a literary work means the author of the work [Section 2 (d)]. A work which is made or published by or under the direction and control of any court, tribunal or other judicial authority in India is government work as per Section 2 (k). Section 17 (d) provides that government is the owner of copyright in all government works. Section 52 (1) (q) (iv) provides that the reproduction or publication of any judgment or order of a court, tribunal or other judicial authority in India is government work as per Section 2 (k). Section 17 (d) provides that government is the owner of copyright in all government works. Section 52 (1) (q) (iv) provides that the reproduction or publication of any judgment or order of a court, tribunal or other judicial authority shall not constitute an infringement of copyright. A combined reading of Section 17 (d) and Section 52 (1) (q) (iv) having regard to Section 16, shows that 17 (d) is subject to Section 52 (1) (q) (iv). This means that the reproduction or publication of any judgment of a court, a tribunal or other authority shall not constitute
an infringement of copyright and therefore the judgment and order of a court or tribunal cannot be treated a government work, even for the government to be first owner of copyright. The rationale behind this, according to the Court, is that the judgment or order ‘of’ a court is not a ‘work’, which is made or published by or under the direction or control of the court, tribunal or other judicial authority, to bring it within the meaning of government work as defined in Section 2(k) of the Act.

Laying down the above propositions, the Court proceeded to examine if the case law reporters reporting the judgments have any right in law to claim copyright on the reports. The Court observed that what the publisher of a law report does is to choose from public domain the relevant judgments and present them in the form of reports with head notes, essential information regarding the parties, further references, long notes, etc. The report may contain the full text of the judgment or so much of the judgment as bears on the point of which the case is reported. The Court observed that a compilation derived from a common source falls within the ambit of copyright based on the decision of Shayam Lal Paharia & Anr v Gaya Prasad Gupta (AIR 1950 Mad 391).

It was brought to the notice of the Court that the decisions so far treated the head notes, long notes etc, differently as having copyright while the judgment itself not having copyright. The High Court observed that the report of a judgment by a law reporter is a composite document and is not to be sliced into head notes on the one hand and the main text on the other for the purpose of appreciating it as a literary work to determine if the reporter has copyright in it. The Court held that there appears to be no other way of looking at it. The law reporter presents the judgments with attendant comments, head notes etc, which in itself is a literary exercise. A report is a whole document and copyright will have to rest on the report as a whole. A report of a judgment, which includes the entire text of the judgment along with head notes and editorial notes in any particular layout of a reporter and publisher, contains such originality as required to be treated as an original work within the meaning of Section 13(1)(a) of the Act. Hence, case law reporters have copyright over reports of judgments, which are reported in its publications.

The single judge of Kerala High Court in this decision differed from the view taken by the Division Bench of Delhi High Court in Eastern Book Co v Navin J Desai & Ors [(2001 PTC (21) 243 (Del) (DB))] which had held that the copyright in case law reporters are restricted to the head notes, editorial notes etc. This judgment is also at variance with other cases which restricted copyright protection to head notes like, Sweet v Bening (1955) 6 CB 459, Raghunathan v All India Reporter, AIR (1971), Bom 48 and Jogesh Chandra Choudhary v. Mohim Chandra Rai, AIR (1915) Cal 112.

Comment

This decision is a departure from the approach adopted in law report cases so far, all of which had uniformly held that copyright in law reports subsisted only in head notes, editorial notes etc. There are many implications of this judgment, some of which are listed below:

(i) Since it has been held that copyright in the cases reported in the law reports vests with the reporter, the lawyers or anyone using the case law reporter beyond the limited private personal use provided in Section 52 will be committing an infringement of copyright. Every time a copy of a reported case is produced before the court or any other forum, there will be an infringement of copyright.

(ii) The court reasoned that the judgments are in public domain and hence, no copyright subsist therein. When a reporter reports the same it gets copyright over it. This reasoning has implications over other public domain works; say, a work, which has come out of copyright protection and lies in public domain. A publisher of such a work may be able to claim copyright over the work, which is otherwise in the public domain.

(iii) This decision may restrict multiplicity of law reporters as the first one to report the case may be able to claim exclusivity and prevent others as it is difficult to prove common source in such cases.

The Indian Law Institute, Delhi, brings out an annual publication surveying case law developments in various fields of law. Those interested in intellectual property law are advised to read the survey of IP cases of 2006 by Prof N S Gopalakrishnan in the Annual Survey of Indian Law Institute wherein the above case has also been discussed.