

MONTHLY INTELLECTUAL PROPERTY RIGHTS NEWSLETTER

JULY 2024

Dear Readers,

We bring you a concise analysis of important developments, recent publications and judgements and noteworthy regulatory amendments in the corporate and financial sectors on a monthly basis.

Our newsletter outlines various developments and significant legal and cultural milestones that highlights the importance of preserving and protecting Intellectual Property rights.

Perceiving the significance of these updates and the need to keep track of the same, we have prepared this newsletter providing a concise overview of the various changes brought in by our proactive regulatory authorities and the Courts!

Feedback and suggestions from our readers would be appreciated. Please feel free to write to us at mail@lexport.in.

Regards,
Team Lexport



ABOUT US

Lexport is a full-service Indian law firm offering consulting, litigation and representation services to a range of clients.

The core competencies of our firm's practice *inter alia* are Trade Laws (Customs, GST & Foreign Trade Policy), Corporate and Commercial Laws and Intellectual Property Rights.

The firm also provides Transaction, Regulatory and Compliance Services. Our detailed profile can be seen at our website www.lexport.in.

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PART A: COURT RULINGS

Issue 1: Delhi High Court Grants Ad-Interim Injunction to BVLGARI for Trademark and Copyright Infringement by Amaris Jewels

Ruling: The Plaintiff, BVLGARI, sought an ad-interim injunction against Amaris Jewels for trademark and copyright infringement involving their "SERPENTI" collection, particularly the "Serpenti Ocean

Plaintiff's said goods
under the said original
artistic work

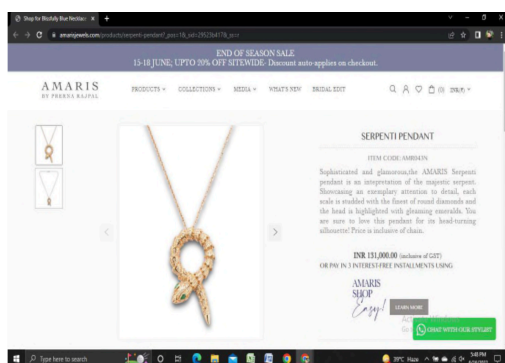


Treasure Necklace - ". BVLGARI is known for its brand and iconic Serpenti collection since the 1940s, the Plaintiff's claimed that the Defendant has substantially copied the artistic work and trade dress of their necklace, including its unique elements, arrangement, and overall appearance. The Plaintiff in August 2022 discovered on Amaris Jewels' website, that the Defendant's "Shield-It Necklace

Defendant's impugned
good under the impugned
artistic work



- " and found it to be visually and structurally similar to the Plaintiff's design. The Hon'ble Court took into consideration Plaintiff's existing copyright registration in Italy and India's ratification and adherence to the Berne Convention, the Hon'ble Court recognized BVLGARI's rights and agreed that the Defendant's use of the "SERPENTI" mark on their website and social media pages "



” constituted trademark infringement under the Trade Marks Act, 1999. The Court ruled in favour of BVLGARI, granting an ex-parte ad-interim injunction to prevent further use of the “SERPENTI” mark and the copying of the Plaintiff’s artistic elements, citing a strong prima facie case and potential irreparable loss to the Plaintiff.

Bulgari S.P.A vs Prerna Rajpal Trading As The Amaris Flagship Store, (CS(COMM) 341/2024)

Lexport Comments: The Hon’ble Court’s decision underscores the value of distinctive branding and design, and highlighting the importance of recognising international registrations and giving weightage to legal protections under the International and national laws. Notably, the Hon’ble Court highlighted that BVLGARI’s copyright in the said artistic work spills over to India by virtue of the Berne Convention for the Protection of Literary and Artistic Works.

Issue 2: Hon’ble Bombay High Court recognised Plaintiffs Prior Use of the mark “Metro” and Granted Ad-Interim Injunction

Ruling: The plaintiff, a leading retailer in footwear, bags, and accessories, and the registered proprietor of the ‘METRO’ trademark, sought an ad-interim injunction against the defendant, who registered a trademark ‘METRO KIDS COMPANY’ on a “proposed to be used” basis limited to the State of Tamil Nadu. The plaintiff contended that they are the prior user of the ‘METRO’ mark and their brand presence is all over India. The Plaintiff contended that the word ‘METRO’ is a prominent feature of the defendant’s trademark, and they are in the process of filing a rectification petition against the defendant’s registered trademark. The Hon’ble Court found that the defendant had dishonestly adopted the ‘METRO’ mark, and despite the defendant’s trademark registration, the Hon’ble Court granted the plaintiff an ad-interim injunction. The Hon’ble Court noted a strong prima facie case in Favor of the plaintiff, highlighting the balance of convenience and the potential irreparable harm to the plaintiff, who has used the ‘METRO’ mark since 1974 for the same class of goods. The defendant’s registration, limited to Tamil Nadu, did not preclude the injunction, as the hon’ble Court found the defendant’s adoption of the ‘METRO’ mark to be dishonest and the registration in Class 35 to be questionable.

Metro Brand Limited vs Mkce Master Franchise India Private (COMMERCIAL IPR SUIT (L) NO.21617 of 2023)

Lexport Comments: The ruling highlights the significance of established prior use and goodwill. The Hon’ble Court considered prior use and reputation of the Plaintiff and potential for irreparable harm in case the Defendant is allowed to use the mark incorporating ‘METRO’ for the same class of goods. The ruling also highlights that even with registration, dishonest adoption of a mark can lead to legal challenges and injunctions.

Issue 3: The Hon'ble Calcutta High Court's Determines When Critique Crosses the Line leads to Brand Disparagement

Ruling: The Plaintiff's, Dabur filed a suit alleging that the Defendant, a popular social media influencer Dhruv Rathee's video disparaged their trademark and infringed upon their copyright, potentially misleading viewers and impacting their brand negatively. The Hon'ble Calcutta High Court, through an interim injunction on 15th March, 2023, acknowledged that while the video's intent may not have been objectionable, its repeated references and criticism of Dabur's product crossed permissible limits. Further to subsequent hearings, The Defendant, Dhruv Rathee proposed an amicable resolution where he would blur or replace the specific packaging images with generic fruit juice packaging, maintaining his rights to freedom of speech and fair comment. Accordingly, both parties agreed to settle the dispute, leading the Hon'ble Calcutta High Court to issue a final order on 18th June, 2024 and disposing of the case.

Dabur India Limited V. Dhruv Rathee And Ors. (IA NO: GA/1/2023)

***Lexport Comments:** The resolution between Dabur and Dhruv Rathee marks a significant step in addressing the complex intersection of trademark rights and freedom of expression in digital media. The Hon'ble Calcutta High Court's interim injunction underscored the delicate balance required when criticizing branded products, emphasizing that while critique is permissible, it must not unfairly disparage or infringe upon established trademarks.*

PART B: ARTICLES

1. An unusual and challenging Journey of "HALDIARM'S" from Household Name to a Well-Known Trademark

In this article, our Partner Ms. Rajlatha Kotni, Associate Ms. Swagita Pandey, and Associate Ms. Ananya Singh are highlighting the critical importance of maintaining vigilance, proper documentation and strong trademark management practices for all trademark owners, regardless of the popularity of their trademarks.

Click on the below link to read the article:

<https://shorturl.at/QHs6M>

END OF THE NEWSLETTER
