



Round Up of Developments in Intellectual Property

Interim Injunction in favour of Delhivery Private Limited vacated on account of 'generic' nature of trade mark 'DELHIVERY'

The High Court of Delhi by way of its order dated October 13, 2020, vacated the interim injunction dated granted in favour of Delhivery Private Limited ("DPL") and against Treasure Vase Ventures Private Limited ("TVVPL") on the ground that DPL's mark 'DELHIVERY' was generic in nature and that it was not capable of being inherently distinctive¹.

DPL in its suit claimed that the use of the trade mark 'DELIVER-E' by TVVPL for similar services, i.e. delivery and logistics services was tantamount to infringement and passing of its statutory and proprietary rights in the mark 'DELHIVERY'. DPL claimed that its trade mark 'DELHIVERY' was adopted in the year 2008, and that it had by virtue of continuous and extensive of the mark in relation to logistics, transportation, management services, apart from other factors, accrued substantial reputation and goodwill in the mark 'DELHIVERY'. The use of the trade mark 'DELIVER-E' by the TVVPL, which was, admittedly, a former vendor of DPL, was *mala fide* and with an intent to ride upon the reputation and goodwill of DPL.

On the other hand, TVVPL in its defence contended that the mark 'DELHIVERY' was descriptive of the services being offered. TVVPL also alleged that the trade mark 'DELHIVERY' cannot be considered as coined trade mark given that the trade mark 'DELHIVERY' was merely a purposeful misspelling of the generic word 'Delivery'. In such circumstances, TVVPL stated that DPL could not claim monopoly over a dictionary word which was generic for the services offered by DPL.

The Single Judge agreed with the TVVPL's claims and vacated the injunction granted in favour of the DPL on the ground that the trade mark 'DELHIVERY' was a phonetically generic word and cannot be registered so as to seek statutory rights. The Court also held that the trade mark 'DELHIVERY' is immediately connectable to the delivery services and cannot be termed as a suggestive mark, but a generic mark. Based on these findings, the Court vacated the interim injunction against TVVPL and set the matter for trial.

DPL has filed an appeal against the Single Judge's Order with the Division Bench of the High Court of Delhi, which is pending consideration.

In this Issue

Interim Injunction in favour of Delhivery Private Limited vacated on account of 'generic' nature of trade mark 'DELHIVERY'

Plex Inc. refused Interim Injunction against ZEE based on inadequate reputation and goodwill established in India and belated action

Mattel USA's Copyright Registration upheld to meet high threshold in ex-parte Interim Injunction Orders

India and USA sign Mou on Intellectual Property Cooperation

¹ *Delhivery Private Limited vs Treasure Vase Ventures Private Limited* [order dated October 12, 2020 in CS(Comm) No. 217/2020]

Plex Inc. refused Interim Injunction against ZEE based on inadequate reputation and goodwill established in India and belated action

In a *quia timet* action filed by Plex, Inc. (“PI”), the High Court of Bombay refused to grant an interim injunction against Zee Entertainment Enterprises Limited (“ZEE”) in respect of its use of the mark ‘PLEX’ on its new pay-per-view channel, based on inadequate reputation and goodwill of PI in India².

PI’s suit for passing off was based on its proprietary rights in the trade mark ‘PLEX’. In the suit, PI sought an ad interim injunction against ZEE for its use of the trade mark ‘ZEEPLEX/ZEE PLEX’ for its online movie channel service. PI alleged that ZEE was trying to capitalize on its reputation and image already present in the country, and thus passing off of its media sharing services through a combination of software and hardware. The basis for such a claim was that PI was the prior user of the trade mark ‘PLEX’ in India since the year 2008, and that ZEE allegedly was attempting to ride upon the PI’s reputation and goodwill in India.

The Single Judge did not find merit in PI’s claims and held that PI was unable to present any evidence which would indicate the presence of any goodwill or reputation in India. Additionally, the Court also observed that the services offered by PI and ZEE were essentially different and were aimed at different consumers such that confusion amongst such consumers was not likely. Finally, the Court observed that the action brought by PI was one day before the launch of the ZEE’s services bearing the trade marks ‘ZEEPLEX/ZEE PLEX’ and, therefore, the balance of convenience was not in the favour of PI, rather, the Court observed that ZEE had invested a much larger sum of money for its services bearing the trade mark ‘ZEEPLEX/ZEE PLEX’. In light of the above reasons, the Court declined to grant any interim relief to PI.

Mattel USA’s Copyright Registration upheld to meet high threshold in ex-parte Interim Injunction Orders

The High Court of Delhi has granted an *ex-parte* interim injunction in favour of Mattel Inc. (“**Mattel**”) and against Present Enterprises and other entities, including Flipkart and John Doe parties, restraining the infringement of Mattel’s copyright in six characters of the ‘Rainforest Family’.

The suit has been filed by Mattel on the basis of its copyright in the cartoon characters which was registered in USA in 2014, trade mark rights in the mark ‘KICK AND PLAY’, which was adopted in 2010 and pending trade mark registration in India, and the shape mark of the ‘KICK AND PLAY baby gym’. Mattel alleged that Present Enterprises was passing off their products as those of Mattel by using their trade mark ‘KICK AND PLAY’, and sought to restrain Present Enterprises and two other entities from dealing in products which violated their intellectual property rights, including copyright and trade mark.

The Court held Mattel’s Copyright in USA to be valid in India under the Indian Copyright Act, 1957, which accords protection to foreign works under Section 40. Thus the copyright registrations in USA act as a *prima facie* proof of author’s original work in India. The Court also acknowledged the unique style of the copyrighted works, and granted an *ex parte* ad interim injunction for the alleged copyright violations in favour of Mattel and against Present Enterprises and other entities.

However, with regard to the alleged trade mark violation of the mark ‘KICK AND PLAY’ and the

In this Issue

Interim Injunction in favour of Delhivery Private Limited vacated on account of ‘generic’ nature of trade mark ‘DELHIVERY’

Plex Inc. refused Interim Injunction against ZEE based on inadequate reputation and goodwill established in India and belated action

Mattel USA’s Copyright Registration upheld to meet high threshold in ex-parte Interim Injunction Orders

India and USA sign Mou on Intellectual Property Cooperation

² Plex Inc. vs Zee Entertainment Enterprises Ltd. [in Order dated October 1, 2020 in Interim Application (L) No. 3737 of 2020 and Commercial IP Suit (L) No. 3736 of 2020]



alleged shape mark violation, it was held by the Court that the Defendants should be given a chance to be heard. In view of this, no *ex parte* ad interim injunction was granted in favour of Mattel on this basis of its claim of trade mark and design violation³.

India and USA sign Mou on Intellectual Property Cooperation

A Memorandum of Understanding (“MoU”) on Intellectual Property Cooperation was signed between the Department for Promotion of Industry and Internal Trade, Ministry of Commerce and Industry (“DPIIT”) and the US Patent and Trademark Office, Department of Commerce of USA (“USPTO”) on December 2, 2020. The MOU seeks to foster and increase cooperation between India and USA, by describing a range of cooperative activities pertaining to securing, using and enforcing IP rights in the areas of patents, trade marks, copyrights, geographical indications and industrial designs.

The MoU was virtually signed by the DPIIT Secretary Dr. Guruprasad Mohapatra and USPTO Director Andrei Iancu, nearly 10 months after the Indian Cabinet approved the same. The MoU will facilitate the exchange and dissemination of best practices, experiences and knowledge on IP among the public as well as between and among the industry, universities, research and development (R&D) organisations and Small and Medium-sized Enterprises (SMEs). The MoU provides for the exchange of information and best practices on processes for registration and examination of applications for patents, trademarks, copyrights, geographical indications, and industrial designs, as well as the protection, enforcement and use of IP rights.

It also provides for the exchange of information on the development and implementation of automation and modernisation projects, new documentation and information systems in IP and procedures for management of IP office services. It is also expected to foster their cooperation to understand various issues related to traditional knowledge and the exchange of best practices, including those related to traditional knowledge databases and awareness raising on the use of existing IP systems to protect traditional knowledge⁴.

With respect to its implementation, the two sides will draw up a biennial work plan to implement the MoU, including detailed planning to carry out the cooperation activities like the scope of action.

³ *Mattel Inc. vs Present Enterprises & Ors.* in [Order dated October 13, 2020 in CS(Comm) No. 447/2020]

⁴ Press Release issued by the Press Information Bureau, Government of India dated December 3, 2020 [available at the URL <https://dipp.gov.in/sites/default/files/pressRelease-MoU-IP-03December2020.pdf>]

In this Issue

Interim Injunction in favour of Delhivery Private Limited vacated on account of ‘generic’ nature of trade mark ‘DELHIVERY’

Plex Inc. refused Interim Injunction against ZEE based on inadequate reputation and goodwill established in India and belated action

Mattel USA’s Copyright Registration upheld to meet high threshold in ex-parte Interim Injunction Orders

India and USA sign Mou on Intellectual Property Cooperation

Please feel free to address any further questions or request for advice to:

Dev Robinson

National Practice Head - IPR
+91 98100 10435
dev.robinson@AMSShardul.com

Muzammil Husain

Partner
+91 99104 98654
muzammil.husain@AMSShardul.com

Mukul Baveja

Partner
+91 91671 48334
mukul.baveja@amsshardul.com

J. V. Abhay

Partner
+91 85276 96030
j.abhay@amsshardul.com

Disclaimer

This is intended for general information purposes only. It is not a substitute for legal advice and is not the final opinion of the Firm. Readers should consult lawyers at the Firm for any specific legal or factual questions.