

June 2021



Indian Copyright (Amendment Rules) 2021 notified on March 30, 2021

The Ministry of Commerce & Industry, Government of India recently notified the Copyright (Amendment) Rules, 2021 on March 30, 2021 (“**Amendment 2021**”¹) in order to further amend the Copyright Rules, 2013. (“**the 2013 Rules**”)

The key highlights and salient features of the Amendment are:

Electronic Communication/payments: The Copyright Office (“**CRO**”) is emphasizing and encouraging electronic means of communication. Registered post, which was the sole means of communication earlier, will still be accepted. With the amendments to Rule 55 of the 2013 Rules, the Copyright Society will also create a system of payment through electronic modes through which payments are traceable.

Appellate Board: Amendment 2021 has harmonised the 2013 Rules with the provisions of The Finance Act, 2017, whereby the Copyright Board has been merged with the Appellate Board. There is, however, certain ambiguity with respect to this provision on account of the Tribunals Reforms (Rationalisation and Conditions of Service) Bill, 2021 (“**the Bill**”), which abolished the Appellate Board and replaced the same with the Commercial Court or High Court, as the case may be.

Royalty: The ‘Distribution Scheme’ under Rule 58 of the 2013 Rules has been modified

under the Amendment 2021. The amended Rule 58 necessitates the Copyright Society to (i) keep separate royalties of those authors who could not be identified or located; (ii) take all necessary measures to locate the authors and owners; (iii) at the end of three years transfer undistributed royalty of such unidentified persons to the welfare fund of the Copyright Society.

Copyright Journal: A Copyrights Journal has been introduced by Amendment 2021 which would be made available on the official website. The Copyright Journal will replace the Official Gazette, and eliminate the requirement for a copyright-table work to be published through the Official Gazette.

Accountability and Transparency: After Rule 65 of the 2013 Rules, a new Rule 65A has been added by the Amendment 2021 which pertains to ‘Returns to be filed by the copyright societies with the Registrar of Copyrights’. The onus has been placed on Copyright Societies to make an annual transparency report. The said report under Rule 65A must contain the following: (i) number of refusals to grant license; (ii) financial information on total royalties collected; (iii) total royalties paid to author and other owners; (iv) total royalties collected but not yet attributed to author and other owners.

Copyright for Software: The compliance requirements for registration of copyrights in software applications have been largely reduced and relatively simplified

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by modifying Rule 70 'Application for Registration of Copyright' of the 2013 Rules. The Applicant is now given the liberty to file the first ten (10) and last ten (10) pages of the source code or the entire source code itself if the entire source code is less than twenty (20) pages and no parts are blocked or redacted.

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A Single Judge of the Delhi High Court recently refused² an application for interim injunction in a Suit filed by PhonePe Private Limited ("**PhonePe**") against Ezy Services ("**BharatPe**") for infringement of its trade mark and passing off of the mark PhonePe.

PhonePe and BharatPe are entities engaged in providing digital payment services. Both entities provide digital payment services *via* their respective applications. While BharatPe's services are only available to merchants, PhonePe can be accessed and used by anyone who downloads the application.

PhonePe filed the lawsuit against BharatPe in 2019, seeking to restrain use of the word 'Pe' or 'BharatPe' or any deceptive variant thereof in respect of payment services or in any other manner. PhonePe claimed to have coined and adopted its mark in the year 2015 and to be using the trade mark extensively and continuously since such adoption. It claimed to have amassed huge reputation and goodwill. PhonePe claimed that its adoption of 'Pe' was fanciful and innovative as it stemmed from the Devanagari "पे". PhonePe alleged that BharatPe adopted its trade mark in 2018, by which time PhonePe had already become famous. The use of the capital letter P in 'Pe', by BharatPe was alleged to be proof of deceptive intent. Most importantly, PhonePe contended that BharatPe had copied the essential and distinguishing 'Pe' suffix from the mark PhonePe.

BharatPe contended that PhonePe was not the registered proprietor of the word 'Pe' *per se* as a trade mark. The mark BharatPe was coined in 2016 as a quick response (QR) code for merchants. Services under the BharatPe mark are used by merchants to facilitate payments from all unified payments interface (UPI) applications such as Google Pay, Paytm, PhonePe, Amazon Pay, WhatsApp Pay etc. The BharatPe app has been downloaded over 50 lakh times till the end of December 2020 and remains one of the most popular services. In response to PhonePe's allegations, BharatPe contended that neither BharatPe nor PhonePe used the mark 'Pe' on a standalone basis. When viewed as a whole, the mark BharatPe was entirely different from the mark PhonePe.

The Court dismissed PhonePe's application for interim injunction and affirmed BharatPe's defence based principally on comparison of the marks in entirety. Reiterating the principles laid down by the Supreme Court of India in Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharamceutical Laboratories, the Court held that the mark PhonePe cannot be considered similar to the mark BharatPe. The Court also reiterated that descriptive words could only be afforded statutory protection where they have been used for such a long period of time "of many many years" that "the mark is unmistakably and only and only relatable to one and only source".

Finally, in relation to the defence of 'Pe' being generic, the Court observed that the word 'Pe' cannot be seen as anything apart from a purposeful misspelling of the word 'Pay', which would be descriptive for payment services. The Court also observed that the evidence presented by PhonePe was insufficient for concluding that the word 'Pe' was exclusively associated with PhonePe.

The Appeal filed by PhonePe against the Order of the Single Judge was withdrawn. The Division Bench, however, directed an expeditious trial in the Suit.

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Dispute over 'Personality Rights' of Sushant Singh Rajput

Recently, Late Sushant Singh Rajput's father, Krishna Kishore Singh (**"Mr. K.K. Singh"**), asserting to be his legal heir, filed a suit before the Delhi High Court³ in order to protect the reputation, privacy and rights of his deceased son on the grounds that *"use of Sushant Singh Rajput's name/image/caricature/lifestyle without the consent of the legal heir amounts to a violation of his personality right."*

Sushant Singh Rajput had passed away under suspicious circumstances on June 14, 2020. His father had lodged an FIR on account of his unnatural death and the matter is under investigation.

The suit was filed against unknown and known persons comprising of film makers, producers, directors etc. (**"the known Defendants"**) of movies and other ventures depicting the late Bollywood actor's personal life, name, images, caricature, lifestyle, likeness in form of biopic or story. The known Defendants were making a movie which is a self-proclaimed "tribute to Sushant Singh Rajput", titled 'Nyay: The Justice'.

Mr. K.K. Singh contended that any such publication, production, or depiction of his deceased son's personal life, name, image, caricature, lifestyle, likeness in form of biopic or story, would be an infringement of personality rights and the right to privacy which includes the right to publicity. Further, it was alleged that such exploitation of Sushant Singh Rajput's celebrity rights would require the prior approval of his legal heir.

The known Defendants, while admitting the celebrity status of Sushant Singh Rajput, contended that the right to privacy of a celebrity extinguishes upon his demise. The known Defendants argued that the film simply draws inspiration from the Sushant Singh Rajput's death and does not in any manner uses his name, image, caricature,

photographs etc. It was further contended that the right to privacy of a celebrity or any person lives and dies with the person and, therefore, the same extinguishes upon a person's demise. Also, as per Section 306 of the Indian Succession Act, 1925, which enlists certain rights that cease to exist after the demise of a person, the cause of action of defamation would also cease to exist upon the demise of a celebrity.

The Single Judge of the Delhi High Court rejected Mr. K.K. Singh's claim⁴ and dismissed the application for grant of a temporary injunction. It was held that the right to privacy is implicit in the right to life and liberty guaranteed to the citizens of this country by Article 21. It is a "right to be left alone". However, publication of any material becomes unobjectionable once the matter becomes a public record except in case of a female who is victim of sexual assault, assault or kidnapping.

By claiming rights in the persona of Sushant Singh Rajput basis the events that occurred in his life, the Court stated that Mr. K.K. Singh is claiming to have exclusive rights over his life story as a commercial and intangible property, akin to claiming copyright over the life of Sushant Singh Rajput. However, as per the Copyright Act, 1957, facts which are historical, biographical or news of the day cannot be copyrighted as they are in public domain and hence, cannot be termed as 'original' in order to claim copyright protection.

On the question of whether the celebrity rights can be enforced even after the demise of the celebrity, the Court held that the right to publicity is inextricably interlinked to and birthed from the right to privacy and thus, cannot be enforced after the demise of the celebrity as *"the right to privacy of any individual is essentially a natural right...remains with the human being till he/she breathes last... it is born with the human being and extinguishes with human being."*

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Dispute between two States over 'KSRTC' trade mark

The unique brand war between Kerala State Road Transport Corporation ("Kerala SRTC") and Karnataka State Road Transport Corporation ("Karnataka SRTC") over exclusive rights in the acronym/abbreviation KSRTC which is pending before the Trade Marks Registry, has been refuelled by a press release wherein Kerala SRTC has claimed to have won the rights to the acronym KSRTC.

The dispute started in 2014, when the Karnataka SRTC obtained a trade mark registration with the Trade Marks Registry for the mark 'KSRTC', and issued a legal notice to the Kerala SRTC to cease and desist all use of the mark in respect of its public transport. This triggered protests in Kerala, where the public transport entity is also known as 'Aanavandi'.

Kerala SRTC approached the Trade Marks Registry, Chennai for relief and placed reliance on Section 34 of the Trade Marks Act, 1999 which deals with the 'first user' rule. The Kerala SRTC submitted several documents to show proof of use since 1965, including visuals from a 1969 Malayalam film 'Kannur Delux', shot in a Kerala SRTC deluxe bus plying between Kannur and Thiruvananthapuram. The Kerala SRTC also furnished photographs of old buses, bus depots, pages from memoirs of former Transport Ministers, write-ups and reports. However, Karnataka SRTC dismissed the "unverified" claims that the Trade Marks Registry has issued a verdict in favour of Kerala SRTC. In a statement released, the Karnataka SRTC has said that no final orders have been released, and "as on date, KSRTC's registration of the marks continue to be legally in force and the claim of Kerala SRTC in news-reports that Karnataka state cannot use the trade marks is factually incorrect and legally untenable."⁵⁷

Trade mark dispute between law firms "Singh and Singh" v. "Singh+Singh"

The Division Bench of the Delhi High Court has issued orders to temporarily restrain a Canada-based law firm 'Singh + Singh Lawyers LLP' ("S&S Canada") from infringing the trade mark of the Indian law firm 'Singh & Singh Law Firm LLP' ("S&S India")⁶.

S&S India, which has been using the name 'Singh & Singh' since 1997 obtained trade mark registration of the mark in 2005. In the suit filed before the Delhi High Court, S&S India claimed that S&S Canada operated through separate individual practices under the names of 'GSC Law' and 'KSK Law' in Canada, but had now adopted the name 'Singh + Singh'. It was pointed out that one of S&S Canada's partners is an ex-associate of S&S India and the wife of a partner at S&S Canada. S&S India accused S&S Canada of infringing their trade mark under Section 29(2)(c) of the Trade Marks Act, 1999, stating that their clientele extends beyond borders to US, Japan, Australia and Canada.

S&S Canada sought refuge under Section 35 of the Trade Marks Act, 1999, which restricts the rights of a registered trade mark holder, by preventing them from interfering with the *bona fide* use of their own name in the course of trade.

In its order, the Court stated that the facts conspicuously demonstrated that the infringing mark was identical and was being used for identical services and identical class of customers/clients. It was observed that although S&S Canada was currently practicing in Canada only, S&S India's reputation and goodwill was global and, in an internet-driven world, reputation could not be confined to geographical boundaries. S&S Canada's significant online presence, the similarity of the colour combination of the logos in addition to the

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identical marks pointed towards a strong possibility of confusion between the two marks. The Court held that there would be a “...strong likelihood that they would be led to believe that ‘Singh + Singh’ is another

branch or an associate office of ‘Singh & Singh’” The Court, therefore, granted an order of *interim* injunction in favour of S&S India.

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Endnotes

- 1 Copy of the Indian Copyright (Amendment) Rules, 2021 available at the URL https://copyright.gov.in/Documents/Notification/Copyright-Rules-Amendment_2021.pdf.
- 2 PhonePe (P) Ltd. v. Ezy Services ; IA No. 8084 of 2019 in CS (COMM) No. 292 of 2019 decided on April 15, 2021.
- 3 Krishna Kishore Singh v. Sarla A. Saraogi & Ors. CS(Comm) No. 187 of 2021.
- 4 Krishna Kishore Singh v. Sarla A. Saraogi & Ors. IA 5697/2021 in CS(Comm) No. 187 of 2021 ; judgement reserved on June 2, 2021 ; pronounced on June 10, 2021.
- 5 ‘Karnataka not prohibited from using KSRTC logo, says corporation MD’ by Hans News Service, published on June 5, 2021, accessed on June 16, 2021 at <https://www.thehansindia.com/karnataka/karnataka-not-prohibited-from-using-ksrtc-logo-says-corporation-md-689325?infinitescroll=1>.
- 6 Singh & Singh Law Firm LLP v. Singh + Singh Lawyers LLP, I.A. 7143/2021 in CS (Comm) No. 263 of 2021, decided on June 2, 2021.

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