

MONTHLY INTELLECTUAL PROPERTY RIGHTS NEWSLETTER AUGUST 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 Awards Adidas Rs 14.22 Lakh in Trademark Triumph

Ruling: Adidas AG secured a victory in a trademark infringement case in the Delhi High Court against a firm with a similar name. The court ordered the defendant to pay Rs 14.22 lakh in damages to Adidas. The defendant argued that he had always admired his elder sister, called "adi" in the Sindhi community, and was known as her devotee — 'Das' in Sindhi. Thus, the term "ADIDAS" — a devotee of elder sister, was created. Justice Narula acknowledged that 'Adidas' is a coined term without any inherent linguistic meaning, making it a unique word. Because of this distinctiveness, it is "granted a wide ambit of protection under trademark law." The defendants' claims of a personal connection to the name were dismissed due to a lack of evidence, with the court emphasizing the high distinctiveness of the 'Adidas' mark.

Adidas AG vs Keshav H Tulsiani & Ors, (CS(COMM) 582/2018

Lexport Comments: *The Delhi High Court's decision to award Rs 14.22 lakh in damages to Adidas underscores the importance of protecting well-established trademarks. The Defendants were required to demonstrate that their adoption of the identical mark was both honest and in good faith. However, they failed to provide credible justification or evidence to support this claim. Their submission of a summary of search results for the mark 'ADIDAS' to suggest due diligence was unsubstantiated. Furthermore, the explanation that the mark was chosen due to Defendant No.1's affection for his sister lacked evidentiary support, further undermining their claim of honest adoption.*

Issue 2: The Bombay High Court granted interim relief to singer Arijit Singh for violation of his personality rights by use of various AI platforms.

Ruling: The lawsuit was filed to seek protection against various unauthorized uses of the plaintiff's identity. These include AI models/tools creating artificial sound recordings of the plaintiff's voice, false claims of association by restaurants/pubs using the plaintiff's name and image for events, the sale of merchandise featuring the plaintiff's name, image, likeness, and caricature, platforms for creating, storing, searching, and sharing GIFs related to the plaintiff, and infringing domain names like arijitsingh.com and arijitsingh.in that contain the plaintiff's full name. The Court was alarmed by how celebrities, especially performers like the Plaintiff, are being exploited through unauthorized generative AI content created by some Defendants. These Defendants are using the Plaintiff's fame to attract visitors to their websites and

AI platforms, potentially abusing the Plaintiff's personality rights. Moreover, allowing the Defendants to continue using the Plaintiff's name, voice, and likeness in AI content without consent poses significant economic risks to the Plaintiff's career and opens the door for misuse by malicious actors. The Court ruled that while freedom of speech and expression permits critique and commentary, it does not authorize the commercial exploitation of a celebrity's persona.

Arijit Singh vs Codible Ventures LLP & Ors, COM IPR SUIT (L) NO.23443 OF 2024

Lexport Comments: *With the increasing prominence of AI tools, the threat of their misuse has also grown. Deepfakes, in particular, have become a convenient method to target popular celebrities. Therefore, court intervention was urgently needed.*

Issue 3: Delhi High Court reiterates that competing trade marks had to be examined as a whole and cannot be dissected.

Appellant is a wholly owned subsidiary of L'Oréal, engaged in beauty products. Cheryl's Cosmeceuticals Private Limited (CCPL) used the 'CLARI' formative mark since 2009 and was acquired by the appellant in 2013. Respondent 1 is the Registered proprietor of the trade mark 'CLARIWASH'. Respondent 1 filed application for registration of the mark for 'CLARIWASH' on 16-04-2010, with a claimed use since 16-11-2009. However, the examination report incorrectly referenced 'CHARIWASH' instead of 'CLARIWASH'. The error was later corrected, but the appellant filed for cancellation of the trade mark. The Single Judge dismissed the appellant's application for cancellation, ruling that the error made by the Registrar did not fault respondent 1. The Court held that there was no likelihood of confusion between the 'CLARIWASH' and the appellant's 'CLARI-FI' marks, following the anti-dissection rule from *Corn Products Refining Co. v. Shangrila Food Products Ltd.* The Division Bench upheld the Single Judge's decision.

Loreal India (P) Ltd. v. Rajesh Kumar Taneja Trading, 2024 SCC OnLine Del 4797

Lexport Comments: *The ruling underscores that procedural errors made by the Registrar do not automatically implicate the applicant if the applicant acted in good faith. The Court's consideration of the time elapsed and lack of opposition highlights the importance of timely objections and the challenges of revisiting long-standing registrations based on procedural errors.*

PART B: ARTICLES

1. Beauty And The Brand: Navigating Intellectual Property In The Cosmetic Industry

In this article, our Partner Ms. Rajlatha Kotni, Associate Ms. Swagita Pandey, Associate Ms. Ananya Singh and Anushka Tripathi (Intern) are highlighting the critical need for robust intellectual property protection and enforcement in the cosmetics industry to combat counterfeits, safeguard innovation and maintain consumer trust in a competitive market.

Click on the below link to read the article:

<https://shorturl.at/wYgm7>

END OF THE NEWSLETTER
