



INTELLECTUAL PROPERTY UPDATES FROM INDIA

Intellectual Property Team

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INTRODUCTION

The close of 2022 witnessed some key developments in the field of Intellectual property rights. A remarkable change was the increasing number of judgements where Courts started awarding high damages in trademark infringement suits. Another significant development has been that the 12th edition of the NICE classification system for trademarks now includes blockchain goods and services. This edition of our newsletter also tracks

crucial jurisprudence with respect to design infringement, using a trademark in a descriptive manner, and the declaration of 'BUKHARA' as well-known trademark. Other intriguing snippets of this edition includes GI tags obtained for Nicobari Hodi Craft and Japanese Sake. We do hope you enjoy reading this edition and wish everyone a wonderful and joyous 2023.



CASE ANALYSIS

DELHI HIGH COURT AWARDS RS. 2 CRORE DAMAGES TO ADOBE IN A TRADE MARK INFRINGEMENT SUIT

Adobe, Inc. ("**Plaintiff**") had filed a suit for trade mark infringement against Namase Patel and others ("**Defendants**") before the High Court of Delhi ("**High Court**") alleging that they violated Adobe's trade mark by using the domain names www.addobe.com and www.adobee.com ("**contested domain names**").¹ As the Defendants were also utilizing a number of sub-domain names inside the contested domain names, which included the Plaintiff's marks "PHOTOSHOP" and "SPARK," the Plaintiff also claimed that these marks were infringed.

While noting that previously also, similar suits have been filed against the Defendants whereby the High Court observed that the Defendant is a "repeated cybersquatter, whose main sphere of activities involves infringing well-known domain names by using deceptively similar domain names and subsequently engaging in further misuse and infringing activities." The Court while upholding the Plaintiff's rights in its well-known mark "ADOBE", granted a permanent injunction restricting the Defendants from using the trade marks of the Plaintiff and further granted damages to the Plaintiff for an amount of INR 2,00,01,000/- (USD 2,42,498/-).

HIGH COURT OF DELHI PROHIBITS AQUALITE FROM COPYING THE DESIGN OF RELAXO'S FOOTWEAR

In an appeal filed by Relaxo Footwears ("**Relaxo**"), a Division Bench of the High Court of Delhi has set aside the decision of the Single Bench and restrained Aqualite Industries Pvt. Ltd. ("**Aqualite**") from manufacturing, selling, offering for sale, or in any manner dealing with products infringing the design of footwears of Relaxo.²

In the year 2018, Relaxo had filed a suit³ against the Respondent for infringement of its design bearing no. 294938 ("**Relaxo's Design**"). Vide judgment dated May 06, 2019, the Single Bench held that Relaxo's designs were not unique and that other products with the same patterns were easily accessible on the market. A market survey report and a letter from a sales manager of a chinese company attesting to the popularity of the strap over a lengthy period of time were also considered by the Single Bench in reaching this conclusion.

Relaxo's Design



Aqualite's Design



Thereafter, an appeal was preferred before a Division Bench of the Delhi High Court by Relaxo, which in turn ruled that it is crucial to first review the relevant design application of Relaxo and that it is relevant to compare the competing designs. The Division Bench noted that it is apparent from the above images that the design of Aqualite's products is almost identical to the Relaxo's Design. The only question to be considered is whether registration of Relaxo's Design is proscribed under Section 4(a) and 4(c) of the Designs Act, 2000 which prohibit the registration of designs that are not noticeably different from existing designs or combinations of existing designs. According to Aqualite, Relaxo's Design is not new or original and is also not distinguishable from known designs or a combination of known designs.

The Division Bench while comparing the design of Relaxo's product held that the conclusion of the learned Single Judge is not based on the findings that Relaxo's Design is indistinguishable from designs that were known at the time of the registration. It is based on prima facie, opinion that there are products with similar designs currently available in the market. Thus the 'prima facie' conclusion of the learned Single Judge is not well founded. The judgment of the Single Judge was therefore set aside by the Division Bench.

1. Adobe Inc. v. Namase Patel and Others, CS (COMM) 159/2022, November 29, 2022.

2. Relaxo Footwears Limited v. Aqualite Industries Pvt Limited, FAO (OS) (COMM) 145 of 2019, October 27, 2022

3. Relaxo Footwears Limited v. Aqualite Industries Pvt Limited, CS(COMM) No. 1288/2018]

WHETHER PROVIDING A LINK ON A WEB PAGE THAT ENABLES A CUSTOMER TO ACCESS THE SITE OR A WEB PAGE OF ANOTHER SELLER CONSTITUTES PASSING OFF: HIGH COURT OF DELHI TO EXAMINE

In August 2022 a Single Judge Bench of the High Court of Delhi ("**Single Bench**") had granted an ad-interim injunction in favour of Akash Aggarwal ("**Plaintiff**") restraining Flipkart Internet Pvt Ltd ("**Flipkart**") and other e-commerce entities ("**Defendants**") from allowing third parties to 'latch on' to the Plaintiff's trade name/mark "V-Tradition", on its e-commerce platform.

As per the Plaintiff, the Defendants are encouraging and allowing third party sellers to 'latch on' and use the Plaintiff's name/mark along with photographs of the Plaintiff's products, to sell their products on its platform. The Plaintiff submitted that when a third-party seller places a listing on the Defendants' respective platforms, it suggests the Plaintiff's products as one of the best sellers and allows them to add products under the Plaintiff's name/mark along with the Plaintiff's photographs into their listings. Flipkart by itself submitted that it would take down third party listings under the Plaintiff's name/mark.

The Single Bench noted that permitting a third-party seller to 'latch on' to the Plaintiff's name/mark and product listings on an e-commerce platform is nothing but 'riding piggyback' as is known in the traditional passing-off sense in the brick and mortar world and amounts to taking unfair advantage of the goodwill that resides in the Plaintiff's name/mark and business. The Single Bench granted injunction against the Defendants to prevent them from "latching on" to the Plaintiff's product listings in order to promote their products, which are in no way related to the Plaintiff. While granting injunction, the Single Bench held that such a feature cannot be allowed to be used to the detriment of the owner of a brand, and accordingly, granted an ad-interim injunction in favour of the Plaintiff.⁴

Later on, an appeal was filed by Flipkart before the Division Bench of Delhi High Court. The Division Bench while staying the observations made by the Single Judge Bench, held that it is necessary to examine the issue of whether providing a link on a web page that enables a customer to access the site or a web page of another seller constitutes passing off, whereby the observations made by the Single Bench were stayed till the next date of hearing.⁵

HIGH COURT OF DELHI DETERMINES THE CORRECT JURISDICTION FOR APPEALS AGAINST PATENT OFFICE ORDERS

Recently, the High Court of Delhi ("**High Court**") in the matter of *Dr. Reddys Laboratories Limited & Anr. v. The Controller of Patents & Ors.*⁶ has decided upon the question, of whether upon the abolishment of the Intellectual Property Appellate Board ("**IPAB**"), all High Courts can entertain revocation petitions and appeals. The High Court also deliberated upon the method to determine the jurisdiction concerning for filing of revocation application under Section 64 and appeals under Section 117A of the Patents Act, 1970 ("**Patents Act**") after enactment of the Tribunal Reforms Act 2021 ("**TRA**")

The High Court held that the term 'appropriate office' is of immense significance in the process of prosecution and grant of a patent application in India. The High Court noted that due to high volume of cases, the Controller of Patents has been allocating examination of applications across several Patent Offices across the country due to the enormous number of cases. As a result, problems occur when, for example, a Delhi Patent Office application was scheduled to be considered before the Controller at the Mumbai Patent Office. The appeal to such an order was not necessarily being filed before the High Court of Delhi, however, with this order, the High Court has interpreted that the 'appropriate office' in the case of a patent application shall be the Patent Office where all procedures and proceedings related to the patent application have to take place, regardless of the fact that a hearing may have been scheduled before another Patent Office. Consequently, the High Court held that '*The appropriate office is, thus, the situs of the patent application.*'

4. Akash Aggarwal vs. Flipkart Entertainment Pvt Ltd & Ors, CS(COMM) 492/2022, order dated August 02, 2022

5. Flipkart Internet Pvt Ltd v Akash Aggarwal, FAO (OS) (COMM) 282/2022, order dated September 29, 2022.

6. Dr. Reddys Laboratories Limited & Anr. v. The Controller of Patents & Ors. C.O. (CONN.IPD-PAT) No. 3/2021, November 10, 2022.

SUPER CASSETTES INDUSTRIES PRIVATE LIMITED V. TATA MOTORS LIMITED (2022 SCC ONLINE DEL 3367).



A suit was filed on behalf of Super Cassettes Private Limited ("**Plaintiff**"), seeking permanent injunction to restrain Tata Motors Ltd. ("**Defendant**") for, inter alia, infringing and passing-off the Plaintiff's marks "Ultra T Series" or "Ultra Sleek T-Series Range" (Tata Motors Range of Trucks), before the Delhi High Court.

The Plaintiff had claimed that the mark 'T-series' is a registered mark under class 12 since October 1989. The Defendant had submitted that in March 2021 a new range of smaller cabins related to 'TATA Ultra' were introduced which included series of vehicles and its variants including T.6, T.7, T.9. The launch included a series of vehicle across Ultra range i.e., T.6 Cab, T.6 High Deck load body, T.6 Half Side load body, T.7 Cab, etc. These series of vehicles signifying a cluster and that 'series' was used as a descriptive word. It was submitted that in the automobile industry the term 'series' is used as a descriptive word signifying a cluster of vehicles.

The parties chose to settle their ongoing dispute and have since settled their dispute amicably. The Defendant has acknowledged the rights of the Plaintiff in the 'T-Series/T. Series' marks, and the Plaintiff has acknowledged the Defendant's rights in the mark 'T', 'Tata Motors' and the Tata logo. They have also agreed not to challenge each other's respective trade mark registrations. In addition, the Defendant has undertaken not to use the mark 'T-Series/T.Series', in respect of automobile products, and has also agreed to remove the content bearing the impugned marks on the website, and other online social media platforms.

The Delhi High Court vide order dated 26.09.2022 recorded the settlement between the Plaintiff and Defendant for not using 'T-series' marks on Tata automobiles.

FRANKFINN AVIATION SERVICES V. TATA SIA AIRLINES LTD (2022 SCC ONLINE DEL 3550).

The present suit has been filed on behalf of Frankfynn Aviation Services ("**Plaintiff**"), seeking permanent injunction against Tata Sia Airlines Ltd ("**Defendant**") for the use of the term "FLY HIGHER".

Plaintiff is a registered proprietor of the trade mark 'FLY HIGH' in India in its different forms and variants in multiple classes. Defendant, who operates its full-service airline, has been using the term 'FLY HIGHER' on various online platforms and social media websites for promoting its services under the mark. Grievance of the Plaintiff is that the Defendant has in a brazen and blatant manner copied the registered trade mark of the Plaintiff 'FLY HIGH' and is using the same for allied and cognate services.

On January 21, 2022, the Delhi High Court granted an ex parte ad interim injunction in favour of the Plaintiff. The Defendant filed an application seeking vacation of interim injunction. The Defendant argued that that the Plaintiff and Defendant operate in an entirely different



field and industry. Defendant is operating a full-service airline under its trade mark 'VISTARA', while the Plaintiff is engaged in running a training institute under the 'FRANKFINN' mark. Further, the Defendant argued that 'Fly Higher' is descriptive of the services provided by the Defendant and it is a common dictionary term. The Defendant stated that they have not used the phrase 'Fly

Higher' as a trade mark, but instead used along with their trade mark 'VISTARA' as a descriptor for the purposes of marketing and promotion.

The Court agreed with the Defendant and stated that the Defendant was not using the phrase 'Fly Higher' as a trade mark. As regards the claim of passing off, the Court was of the view that the Plaintiff had failed to prove that their reputation was being sullied by the Defendant's alleged use of their mark. Thereafter, the court added that the Defendant on account of its acquired reputation was in no need to ride upon the goodwill of the Plaintiff.

For all the aforesaid reasons, the Court vacated the ex parte ad interim injunction order granted by the Court against the Defendant.

BOMBAY HIGH COURT NOTED THAT ACQUISITION OF A TRADE MARK DOES NOT CHANGE THE DATE OF ITS FIRST USE.

The Hon'ble Bombay High Court ("Court") granted interim protection to the trade mark, "M-Seal" by Pidilite Industries Limited ("Plaintiff") against the use of a deceptively similar trade mark, "R-Seal" by an individual, Riya Chemy ("Defendant").⁷

The Plaintiff contended that the trade mark, "M-SEAL" was adopted and conceived by its predecessor in 1968 and has been commercially used since then. In December 2020, the Plaintiff came across the Defendant's identical products being sold under the trade mark, 'R-Seal' and similar taglines to that of the Plaintiff. The Plaintiff contended that the Defendant maliciously tried to copy the minutest details of its trade mark and has been encashing upon on its acquired goodwill and reputation in the market.

In its defence, the Defendant argued that the Plaintiff's first use of the mark dating back to 1968 is untenable as the assignment agreement was signed in the year 2000. Moreover, the Defendant contended that the Plaintiff's use of the word 'Seal' comes with the disclaimer i.e., "registration of this trade mark shall give no right to the exclusive use of all other descriptive matters appearing on the label", whereas the use by the Defendant has no such disclaimers.

The Court noted the contentions and observed that the Plaintiff acquired the trade mark from its predecessors in 2000 along with the inherent goodwill from the time of its adoption, i.e., from the year 1968. The Court further laid down the ratio that an acquisition of a trade mark

does not change the date of its first use. Thus, even though the Plaintiff was assigned the trade mark in the year 2000, the date of use will inevitably go back to the time of its adoption. Further, the Court also held that the Defendant had fraudulently registered the trade mark "R-SEAL" without notifying the Trade Marks Registrar about the use of similar mark by the Plaintiff. On account of the same, the Court concluded that the rival marks were indeed similar and cannot be allowed to co-exist, as irreparable injury would be caused to the Plaintiff. Thus, the Defendant stands restrained from dealing in products bearing the mark, R-SEAL until the final disposal of the suit.

Plaintiff's mark, 'M-SEAL'



Usage of the term, 'PHATAPHAT'

Plaintiff's taglines

SEALS JOINS FIXES BUILDS

Defendant's mark, 'R-SEAL'



Usage of the term, 'JHAT-PAT'

Defendant's taglines

BUILDS FIXES JOINS SEALS

DELHI HIGH COURT ANALYZED THE SCOPE OF PROTECTION OF THE NUMERICAL TRADE MARKS

Recently, the Hon'ble High Court of Delhi ("Court"), in its order dated October 11, 2022, provided analysis on the scope of use of numerical trade marks.⁸

Alphavector India Private Limited ("Plaintiff") filed a suit against Sach Industries ("Defendant") arguing that they are the prior user of the mark, "NINETYONE/91" against the Defendant's mark, "NINETYNINE/99". The Plaintiff started the bicycle manufacturing business in the year 2015 and adopted the mark, 'NINETY ONE/91 in the year 2020. Thereafter, the Plaintiff acquired substantial reputation and goodwill within a short span of time. On the other hand, the Defendant was operating in the name of 'SACHIN BIKES', 'SACHIN CROCS' and 'SACHIN DUNALIZ'. Thereafter, the Defendant adopted the trade mark, 'NINETYNINE/99' in the year 2021.

The Court observed that numbers are often seen being used as trade marks, either as part of an alphanumeric combination, or spelled out in letters. However, such numbers are valid trade marks if they are arbitrary in nature and do not relate to a particular style or a grade of a product. The Court relied on an excerpt from the book, 'McCarthy on Trademarks' and noted that letter and number marks that have no inherent meaning (except as possible abbreviations) must usually be compared on the basis of visual similarity.

On the basis of the same, the Court perused the rival marks and noted that both the trade marks were indeed similar when their numeral and word form was considered on the whole. The Court further observed that since bicycles are also bought by a section of the population which is semi-literate, the chances of deception and confusion are certainly high. Thus, the Court granted an injunction in favor of the Plaintiff and restrained the Defendant from manufacturing bicycles in the name of 'NINETYNINE/99' until the pendency of the suit. The next date of hearing has been fixed for January 19, 2023.

TATA IS EMBEDDED IN THE SUB-CONSCIOUSNESS OF THE PUBLIC IN INDIA, SAYS DELHI HIGH COURT

The High Court of Delhi ("**Court**"), in the case, Tata Sons Private Limited v. Hakunamatata Tata Founder,⁹ barred a company based in UK from using the trade mark, 'TATA' in its course of trading cryptocurrency or digital tokens. It was alleged by Tata Sons Private Limited ("**Appellant**") that Hakunamatata Tata Founders ("**Respondents**") were using its trade mark through their websites, 'www.tatabonus.com' and 'www.hakunamatata.finance' to cater to Indian audience in availing its services, despite being seated in the United Kingdom. Even though the injunction was denied initially on the ground that no "purposeful availment" could be established, the Court later observed that in case of internet related trade mark infringement, the intent of foreign infringers luring Indian consumers must be carefully perused.

Accordingly, the Court directed the Respondents to take down their old domain name, www.tatabonus.com and delist the TATA Coin/\$TATA and/or any other crypto assets bearing the trade mark "TATA". Lastly, the Court refused to consider the mark 'Hakunamatata' to be causing any deception or confusion, and noted that 'Hakunamatata' is a generic word, and the word 'TATA' is fully coalesced in it, thus causing no deception or confusion.



9. CS(COMM) 316/2021

SNIPPETS

CEASE AND DESIST NOTICES WERE ISSUED BY NSE TO STOCK GAMING APPLICATIONS

In order to stop stock gaming applications from exploiting its data in their games that simulate real-time share trading, NSE Data and Analytics Ltd ("**NSE**") has recently issued cease-and-desist notices to various stock gaming applications. The cease-and-desist notices, which were addressed to about six stock gaming applications, also include financial demands for the infringement of NSE's intellectual property rights.

This development has essentially put an expanding industry on the line, leading at least some fantasy stock game platforms to examine plans to shut down their businesses completely.

In addition to entering into an agreement with NSE to retrospectively compensate it for "*illegal profits earned... and accruing to NSE during the time of wrongful use of the data,*" NSE has requested that the corporations provide the names of the entities through which they acquired the data.

THE 12TH EDITION OF THE NICE CLASSIFICATION FOR TRADE MARKS INCLUDES BLOCKCHAIN GOODS AND SERVICES.

The World Intellectual Property Organization (WIPO) had announced the 12th edition of the Nice Classification established by the Nice Agreement ('the Agreement'), the international system for classifying goods and services for registering trade marks, which has come into force on 1 January 2023 for the purpose of registration of trade marks. The new edition will affect all new trade mark applications filed in countries that are parties to the Nice Agreement and WIPO. The amendments and additions to the Nice Classification are to reflect the changes in the current state of affairs resulting from COVID-19, wars and conflicts, rise in non-fungible tokens (NFTs), online communities and global environmental concerns. Notable changes have been made to the standard goods or services under various classes. The introduction of new goods and services, particularly those connected to blockchain technologies, is most prominent and striking. Under class 9 of the Agreement, '*Downloadable digital files authenticated by non-fungible tokens [NFTs]*', '*computer network routers*', '*portable document scanners*' and '*cases for smartphones incorporating a keyboard*' have been added as new goods. In addition,

'downloadable computer software for managing cryptocurrency transactions using blockchain technology' has been amended to '*downloadable computer software for managing crypto asset transactions using blockchain technology*'. Furthermore, under class 42 of the Agreement, '*Information technology [IT] consultancy*' has been changed to '*information technology [IT] support services [troubleshooting of software]*' and '*cryptocurrency mining/crypto mining*' to '*mining of crypto assets/crypto mining*'.

ITC MAURYA'S "BUKHARA" IS DECLARED A WELL-KNOWN BRAND BY THE DELHI HIGH COURT

In the recent case before the Delhi High Court ("**Court**"), *ITC Limited v. Central Park Estates Private Limited*,¹⁰ ITC Limited ("**Plaintiff**") alleged trade mark infringement of its famous mark concerning its restaurant name, ITC BUKHARA, which was started by it in the late 1970s and later gained trade mark rights. It was the case of the Plaintiff that the Central Park Estates ("**Defendant**") filed for the trade mark registration of the marks, "Balkh Bukhara" and "Balkh Bukhara Restaurants" only in October 2022 on a 'proposed to be used' basis. The Plaintiff immediately conducted enquiries and noted that the Defendants had imitated a lot of aspects of the Plaintiff's 'BUKHARA' restaurant. For instance, the name, logo and font, interiors of the restaurant, décor, seating style, staff uniform, bib/apron, utensils, wooden menu and the whole look and feel of the restaurant.

According to the Plaintiff, Bukhara has been a well-known restaurant in the city with a long-standing user date. The restaurant has also been featured in a lot of magazines and publications as one of the best restaurants. Thus, it was the case of the Plaintiff that any imitation of the style and feature of the same would inevitably cause loss to its business affair and unfair advantage to the Defendant. The Plaintiff placed on record evidence in support of "Bukhara" being given the status of a well-known trade mark. The Court noted that the enormous fame and goodwill evidenced from the documents stipulated that the mark 'BUKHARA' of the Plaintiff is qualified to be a well-known mark within the ambit of Section 2(zg) read with Section 11(2) of the Trade Marks Act, 1999 and subsequently ordered the Registrar of Trademarks to add 'Bukhara' on the list of well-known trade marks.

10. C.O. (COMM.IPD-TM) 763/2022 and I.A. 18332/2022, 18333/2022

GOVT. REVISES SCHEME FOR INTELLECTUAL PROPERTY PROTECTION TO UPGRADE PROFESSIONAL CHARGES OF FACILITATORS

The Government has revised the scheme for facilitating Start-Ups Intellectual Property Protection (“SIPP”) to upgrade the professional charges of the facilitators. Facilitation fees have been increased by at least 100%. The revised regime is in effect from December 2, 2022. The scheme was introduced in 2016 and its motive is to promote Intellectual Property Rights (“IPR”) of start-ups and to encourage innovation and creativity among them. Patent filings by start-ups increased from 179 in 2016-2017 to 1500 in 2021-2022. Similarly, trade mark applications rose to 8,649 in 2021-22 from only four in 2016-17. Overall, a total number of 7,430 patent applications and 28,749 trade mark applications have been filed by the start-ups from the year 2016-2017 to October 2022.

The application fee for the filing for a patent application has been from Rs. 10,000 to Rs. 15,000 whereas the trade mark filing fee is now Rs. 3,000 as opposed to Rs. 2,000, which was earlier. According to this scheme, start-ups are also entitled to fee rebates under the intellectual property legislations. For instance, 80% rebate in filing patent application whereas 50% rebate in filing trade mark application.

The revised scheme by the Government of India also stipulates that “as on September 30, Rs. 380.81 lakh have been disbursed as fees to the facilitators assisting the start-ups in IP filings. The revised fee structure will further augment the filing of IP applications by start-ups through the assistance of IP facilitators offering effective and quality service”.¹¹ The scheme has already shown positive trends.

GI TAG APPLIED FOR NICOBARI HODI CRAFT

The Tribal Development Council, Andaman & Nicobar Islands (“U.T.”), has applied to the Geographical Indications (“GI”) Registry in Guindy, Chennai, seeking a GI tag for the ‘Nicobari Hodi Craft’. This is the first time ever that the U.T. has applied for a GI tag for one of its goods. The ‘Nicobar Hodi Craft’ is a type of canoe that is used to transport people and goods from one island to the other. The ‘Hodi’ is built using either locally available trees or trees from nearby islands. The technical skills that are required to build the canoe are usually inherited by the Nicobarese from their forefathers as indigenous knowledge.

EMBASSY FOR JAPAN IS SEEKING A GI TAG FOR JAPANESE SAKE IN INDIA

The Embassy for Japan in New Delhi, for the first time ever, filed for obtaining a Geographical Indication (“GI”) Tag for “Nihonshu”, also known as the Japanese Sake, before the GI Registry, Chennai.¹² In the said application, the “Nihonshu” is described as a valuable alcoholic beverage being an integral part of the culture in Japan.

“Nihonshu” is a special and valuable beverage, which is made by fermenting rice. The beverage is a traditional drink and is enjoyed by people on occasions like weddings and festivals. Some Japanese people also consume it daily. Thus, it is an integral part of the lifestyle and culture in Japan. The popularity of “Nihonshu” can be garnered by the fact that the sake market is the second largest brewed liquor market in Japan.

CAN AN NFT INFRINGE ONE’S OWN TRADE MARK RIGHTS?

Juventus (“Plaintiff”), a football club based in Italy, is the proprietor of trade marks, ‘JUVE’ and ‘JUVENTUS’, as well as a figurative trade mark consisting of the signature black-and-white jersey with two stars. An unauthorized third-party, a blockchain-based platform, Blockeras (“Defendant”), had minted, advertised, and offered for sale NFTs and other digital content relating to images representing the Plaintiff’s trade marks, as well as the image of former footballer, Bobo Veera wearing his Juventus jersey. Simultaneously, the Plaintiff brought a claim contending that commercialization by the Defendant of its ‘Coin of Champions’ and NFT-based cards has infringed upon the Plaintiff’s trade mark rights. The Rome Court of First Instance (“Court”), agreeing in favor of the Plaintiff, observed that the Plaintiff is famous in Italy with its trade marks being well known internationally. The Court found that it is likely that people may confuse the NFTs minted by the Defendant to be coming from the Plaintiff since they were bearing the Plaintiff’s trade marks.¹³ Additionally, the Court also noted that the Defendant should have sought permission from the footballer, Bobo Veera before using the latter’s trade marks in commerce.

11. <https://pib.gov.in/PressReleasePage.aspx?PRID=1880465>

12. <https://search.ipindia.gov.in/GIRPublic/Application/Details/994>

13. <https://www.trevisancunzo.com/static/upload/juv/juventus-nft-order--en.pdf>

FORMULA ONE FILES NFT, CRYPTO & METaverse TRADE MARKS

The racing giant, Formula One (“**Applicant**”) filed eight trade mark applications at the United States Patent and Trademark Office (“**USPTO**”) related to crypto, non-fungible tokens (“**NFT**”), and metaverse for the famous “F1” abbreviation.¹⁴ The Applicant is planning to establish an online marketplace for cryptocurrency buyers and sellers. As per the filing, it would provide software for use with cryptocurrencies, digital collectibles, and NFTs. Additionally, this software will handle cryptocurrency

trading and payment activities. The Applicant aims to use blockchain technology to simplify the financial transactions and potentially engage in crypto mining thereafter. It is further interesting to note that one of the trade mark applications also mention ‘cryptocurrency-related intellectual property licensing services’. The Applicant is also eyeing on the possibility of providing entertainment services using products like NFTs in the virtual world.

¹⁴. Filed at the USPTO on October 15, 2022, bearing application nos. 97620234, 97620226, 97620223, 97620220, 97620218, 97620213, 97620210, 97620208.



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