IPR INSIGHTS

Your Monthly Digest to Stay Ahead in the Evolving Realm of IPR

NOV 2025

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Editor's Note

Navigating the Intellectual Property terrain, our Cover Story, **"Reputation Over Footprint,"** dissects the Delhi High Court's powerful ruling in the **Princeton University case,** which decisively affirms that "trans-border reputation is a tangible right, capable of protecting global marks from local dilution." This judgment reinforces the protective sweep of the law against local dilution and redefines the territoriality principle in the digital age. Further underscoring this commitment, the massive damages awarded in the **PUMA case** against a professional counterfeiting enterprise serves as a clear declaration that trademark infringement is a "commercial evil" that will not be tolerated, reinforcing the higher degree of protection afforded to well-known marks.

This edition also delves into the foundational debates shaping our jurisprudence, where the courts are meticulously drawing lines against overreach and confusion. In Patent Law, the Calcutta High Court's landmark ruling in **Oramed Ltd. v. Controller General** is a crucial corrective, clarifying the distinct applicability of Sections 3(d) (efficacy) and 3(e) (synergy) and rebuking the Patent Office for their interchangeable use. This stands alongside the Delhi High Court's ruling in **Saint-Gobain Glass France,** which validates the concept of **'mosaicing'** and demands scrutiny of technical data to affirm the test of **'inventive step.'** The ongoing legal struggle is further amplified by the **Risdiplam Ruling,** which has rekindled the long-standing debate over genus-species patents and the coverage-disclosure dichotomy, hinting at a significant re-evaluation of established precedents. Meanwhile, we explore India's **Academic Publishing Crisis,** examining how the largely untested mandatory royalty mandate (Section 19(3) and 19A) of the Copyright Act clashes with the zero-royalty academic publishing model, creating a profound paradox in the architecture of knowledge ownership.

The current IPR environment demands constant vigilance and informed strategy. We highlight significant developments challenging the administrative status quo, including the move by the **USPTO Director to Centralize IPR Decisions and curb parallel patent challenges,** a global regulatory update with serious implications. Domestically, our Case Law Highlights showcase the judiciary's vigilance: the Delhi High Court's injunction restraining a YouTuber from disparaging the **'BROCODE'** trademark demonstrates a proactive stance against instant, digital reputational harm. Crucially, the Telangana High Court's decision to set aside a blanket injunction in the **Venkateshwarlu Guduru trade secret matter** is a vital check, reaffirm ing that protection requires clearly identifiable and specific confidential information, thus guarding against vague, draconian restraints on a citizen's constitutional right to trade.

We've curated this digest to provide the essential insights and legal direction needed to stay ahead in this dynamic legal environment.

Let's dive in.

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COVER STORY

Reputation Over Footprint: How Trans-Border Reputation Rewrote the Rules on Trademark Territoriality

> *Trans-border reputation is a tangible right, capable of protecting global marks from local dilution*

The hallowed reputation of Princeton University, a global symbol of academic excellence, recently found strong judicial vindication in the Delhi High Court. In a ruling that reinforces the protective sweep of India's trademark law, the Division Bench delivered a powerful message: “trans-border reputation is a tangible right, capable of protecting global marks from local dilution.” The case of The Trustees of Princeton University v. The Vagdevi Educational Society presented a classic David vs. Goliath scenario, pitting the Ivy League giant against a local educational society in Telangana that had operated under the identical "Princeton" name since 1991. The Single Judge had initially denied an injunction, finding that the University failed to prove prior use in India and that consumer confusion was unlikely. The Division Bench, however, meticulously set aside this verdict, granting a partial injunction and addressing several contested questions in Indian trademark law.

The core of the High Court's judgment lies in its robust affirmation of key trademark doctrines, effectively holding that the well-known status of the Princeton mark transcended its lack of a physical campus in India. The Court decisively expanded the interpretation of "use of a mark" under Section 2(2)(c)(ii) of the Trade Marks Act. It ruled that publicity materials and articles mentioning Princeton University, even if published by third parties and dating back to 1911, constitute 'use' of the mark because they are "statements about the availability, provision or performance of such services. This crucial doctrinal move rescues protection for renowned marks whose proprietors do not engage in direct local advertising...

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PIVOTAL ISSUES

The Threshold of Innovation: Delhi High Court Validates 'Mosaicing' and Affirms Scrutiny of Technical Data

> *Alterations in the submitted data severely undermined the credibility of the evidence*

In a ruling that underscores the rigorous standards of Indian patent law, the Delhi High Court in Saint Gobain Glass France v. Assistant Controller of Patents and Designs decisively affirmed the Patent Office's rejection of a patent application filed by Saint-Gobain Glass France for a novel glass coating. This significant decision hinges on the invention's fundamental failure to meet the crucial test of "inventive step" under Section 2(1)(ja) of the Patents Act,1970. The judgment powerfully reinforces the principle that mere improvements or routine combinations of existing knowledge are insufficient for patentability, mandating a true technical advance that is non-obvious to a person skilled in the art. This case stands as a clear precedent, signaling the judiciary's commitment to upholding the strict requirements for genuine innovation in the face of what may be perceived as incremental enhancements.

The core of the dispute centered on Saint-Gobain's application for a patent on a glazing material comprising a stack of thin layers with a silver-based functional layer, aiming for high external reflection and neutral transmission colours. The Patent Office initially raised multiple objections, including a lack of novelty and inventive step, ultimately refusing the application because the claimed advantages were unsupported by credible experimental evidence, showed no significant progress over existing prior art, and could have been achieved through routine optimisation by an ordinary skilled professional. The Court's scrutiny, grounded in the Supreme Court's mandate in Novartis AG v. Union of India, first assessed whether the invention demonstrated the required technical advancement or economic...

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PIVOTAL ISSUES

India's Academic Publishing Crisis: The Unsettled Fault Line in Copyright Law

> *judicial intervention in this context is both inefficient and impractical.*

The controversy surrounding platforms like Sci-Hub and LibGen is more than a simple legal brawl over 'piracy'; it is the visible tremor of a far deeper structural fault line running beneath Indian academia. The real crisis is not the illicit downloading of papers, but the architecture of knowledge ownership itself: the virtually unquestioned legality of the zero-royalty copyright assignment agreements that underpin global scholarly publishing. This tension brings us to two critical, and largely dormant, provisions of the Copyright Act, 1957, as overhauled in 2012: Section 19(3), which makes the specification of royalties mandatory, and Section 19A, which empowers courts to intervene in harsh contracts. The application of these powerful, untested rules to the unique academic ecosystem where prestige, not pay, is the author's currency reveals a profound paradox: a law meticulously drafted to empower creators and secure fairness risks the unintended consequence of further restricting public access and deepening the chasm between research and the people who need it.

The most direct legal challenge to the status quo lies in Section 19(3): The Royalty Mandate. The 2012 amendments significantly tightened the requirements for a valid copyright assignment. Previously, the section required specifying royalties "if any." This was revised to a mandatory requirement: "The assignment of copyright in any work shall also specify the royalty and other consideration payable to the author..." This change was largely motivated by concerns over exploitative contracts in the film and music industries, where artists were often coerced into signing away all rights for a minimal, one-time fee. The courts, in cases...

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PIVOTAL ISSUES

Navigating India's Patent Labyrinth: The Critical Divide Between Efficacy and Synergy

> *The subject of inquiry is the effect of admixture*

The Indian Patents Act, 1970, employs a rigorous gatekeeping system, ensuring the coveted patent monopoly is reserved only for truly genuine innovation. At the heart of this system lie Sections 3(d) and 3(e): two statutory filters designed as bulwarks against 'evergreening' the art of making trivial modifications to extend a patent's life and the flood of frivolous applications. While they share the high objective of rewarding only genuine inventive steps, their paths to that goal, the required legal tests, are fundamentally different. Yet, in the day-to-day grind of the Patent Office, these distinct legal standards are frequently and erroneously collapsed into one, creating confusion that risks derailing the integrity of the patent system itself. The recent Calcutta High Court (CHC) judgment in Oramed Ltd. v Controller General of Patents and Designs and Another stands as a crucial corrective, clarifying the distinct applicability of these two provisions and rebuking the Patent Office for their interchangeable application.

Section 3(d) excludes new forms of a known substance that do not demonstrate an enhancement of known efficacy. The discovery of a new property or use of a known substance also fails the test. The burden of proof here is stringent: the applicant must demonstrate a substantial increase in therapeutic efficacy, not merely improved bioavailability, as the latter reflects absorption but doesn't guarantee better patient outcomes. This provision incorporates a legal fiction that derivatives are the same as the parent substance until this higher standard is met, making it a powerful anti-evergreening...

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PIVOTAL ISSUES

The Roar of Justice: PUMA's Victory Amplifies India's IP Shield Against Commercial Evil

> *A mark that is well known needs a higher degree of protection as it is highly susceptible to piracy*

The roar of justice has sounded loud and clear in the Delhi High Court, delivering a powerful verdict that reinforces the judiciary's role as a staunch guardian of intellectual property (IP) rights and awarding a total of ₹11,00,000 in damages and costs to global sportswear powerhouse PUMA SE. This judgment, emerging from the case of PUMA SE vs. Mahesh Kumar, established an expensive precedent for those who attempt to profit from the goodwill of international brands, sending an unequivocal message that trademark infringement is a "commercial evil" that courts will not tolerate.

The dispute arose after PUMA, a company that has used its iconic word mark, logo, and Form strip logo since 1948 and has been registered in India since 1977, discovered a large-scale counterfeiting operation. Crucially, PUMA's trademark had been declared a "well-known trademark" in 2019, securing it heightened protection under the law. The violation involved the defendant, who was found to be engaged in the business of stocking, selling, and supplying counterfeit shoes bearing PUMA's marks without any authorisation, a blatant and dishonest copying of every essential feature that amounted to infringement and passing off. Upon discovery of the defendant's manufacturing unit in East Delhi, PUMA initiated legal proceedings and the Court took decisive steps, including an ex-parte ad-interim injunction and the appointment of a Local Commissioner. The inspection report was damning, revealing not only counterfeit PUMA goods but, crucially, a metal mould for logos and counterfeit products of other well-known brands, such as Adidas and Nike. This...

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SIGNIFICANT CASE LAWS

Risdiplam Ruling Reopens Genus-Species Patent Battle and Coverage-Disclosure Rift

The Delhi High Court's recent Risdiplam Division Bench judgement in **F. Hoffmann-La Roche Ag & Anr vs Natco Pharma Limited** upheld the rejection of Roche's interim injunction against Natco concerning the Risdiplam patent. This decision is significant as it facilitates access to a more affordable version of the orphan drug for Spinal Muscular Atrophy (SMA), which was reportedly priced at INR 6 lakhs per bottle. The ruling has rekindled the long-standing legal debate in Indian patent law regarding genus and species patents and the coverage-disclosure dichotomy. Since the 2013 Novartis v. Uol Supreme Court ruling, courts have grappled with whether a single compound can be protected under both a broad genus patent (often using Markush claims) and a subsequent, narrower species patent, and whether a compound can be "covered" by the genus patent's claims yet not be sufficiently "disclosed" (i.e., enabling) within its specification. Earlier DB orders, such as in Natco v. Novartis and Astrazeneca v. Intas, had generally established that there cannot be multiple patents over one compound and that significant gaps between coverage and disclosure should not exist.

The Risdiplam DB judgement, however, has nudged the debate toward a potential affirmative answer to the question of a coverage-disclosure gap, by suggesting that the Astrazeneca precedent requires reconsideration, though it did not formally overturn it. By refusing to let this "sleeping dog" lie, the DB's observations are now being scrutinized for their implications on the Indian Patent regime, particularly in light of Section 53(4) and Section 64(1)(e). Specifically, the DB made notable comments on the Single Judge's conclusion that Natco had raised a credible challenge to the validity of Roche's Risdiplam patent on the grounds of novelty. This new development moves the discussion beyond the initial focus on obviousness and the 'Person in the Know' yardstick, highlighting the judgment's wider impact on patentability standards for chemical compounds.

VIEW JUDGEMENT

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SIGNIFICANT CASE LAWS

Delhi High Court Restrains YouTuber from Disparaging 'BROCODE' Trademark

The Delhi High Court, in a matter concerning **Indospirit Beverages Private Limited versus Google LLC & Anr.**, granted a permanent injunction to protect Indospirit Beverages' trademark ' BROCODE' against disparagement. Indospirit Beverages, a leading manufacturer of alcoholic beverages, sued YouTuber Praveen Aminigadda, who operates the YouTube channel 'Sipp_Smart,' and Google LLC (owner of YouTube) for uploading a video titled ‘B Code Exposed!!’ that falsely asserted 'BROCODE' was 'poisonous,' 'deadly,' and 'not fit for consumption.' The Court found that Indospirit Beverages established a prima facie case, supported by regulatory clearances (FSSAI and BIS) confirming the product's safety and quality. Despite Aminigadda partially disguising the brand name, the video's comment section showed viewers easily recognizing 'BROCODE,' causing direct injury to the brand's goodwill and constituting trademark infringement through disparagement of a lawfully marketed product. Consequently, the Single Judge Bench of Tejas Karia, J., restrained Praveen Aminigadda and his agents from disseminating the impugned video on any social media platforms, including YouTube, and directed him to take it down. The Court further ordered Google LLC to remove the video and file the basic subscriber information of Aminigadda if he failed to comply, emphasizing that continued accessibility would cause irreparable injury to Indospirit Beverages' brand and consumer trust. The matter is listed for February 4, 2026.

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SIGNIFICANT CASE LAWS

Delhi High Court grants relief to Mattel over ‘BARBIE’ trade mark dispute...

The Delhi High Court, in the case of **Mattel Inc. versus Padum Borah and Ors.** (CS(COMM) 948/2025), granted an ad-interim injunction to protect the globally renowned 'BARBIE' trademark in an application under Order 39, Rules 1 and 2 of the CPC. The plaintiff, Mattel Inc., which has used and registered the 'BARBIE' mark since 1959, sought to restrain the defendant (Padum Borah) from using marks like 'BARBIE KITCHEN MART,' 'BARBIE HOSPITALITY,' and 'BARBIE CATERING' for commercial kitchen and catering services. The Single Judge Bench of Manmeet Pritam Singh Arora, J., held that the defendant’s marks were visually, phonetically, and conceptually identical to that of the plaintiff’s, and that the adoption of the famous, coined mark as a dominant prefix was an act of trade mark infringement and passing off, aimed at misleading consumers and riding on Mattel’s goodwill. The Court specifically applied the 'initial interest confusion' test and concluded that Mattel had made out a prima facie case and was likely to suffer grave and irreparable harm without protection. Consequently, the Court restrained the defendant from using the impugned marks or any deceptively similar variants, and directed the immediate removal and takedown of all infringing social media pages and websites.

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SIGNIFICANT CASE LAWS

Bombay High Court grants ad-interim relief to Reliance Industries in trade mark infringement case against ‘JIO’ cab services

In the matter of **Reliance Industries Limited versus Asif Ahmed and Ors.,** the Bombay High Court granted ad-interim relief to the plaintiff, Reliance Industries Limited (RIL), by restraining the defendants from infringing upon its 'JIO' trademark. The plaintiff, the registered proprietor of the 'JIO' mark since 2011 across multiple classes, initiated a commercial suit against the defendants who were operating an inter-state taxi service using the mark 'JIO' and the domain name www.jiocabs.com, alongside pirated artwork deceptively similar to RIL’s original logo. The Single Judge Bench of Somasekhar Sundaresan, J., recognizing that 'JIO' had already been established as a well-known trademark in prior judgments, held that RIL had made out a strong prima facie case of trademark infringement.

The Court emphasized that the continued, unauthorized usage of such a well-known and protected brand name, even for different services like a taxi cab network, would cause grave and irreparable injury to the plaintiff's goodwill and brand equity. Although the defendants had subsequently changed their business name, the domain name www.jiocabs.com remained active and under their control, a fact the Court noted justified the urgent intervention. Accordingly, the Court granted a temporary injunction, immediately restraining the defendants from using the domain name, the counterfeit mark 'JIO', any name or label deceptively similar to it, and any pirated artwork related to the brand. This decisive order reinforces the robust legal protection afforded to well-known trademarks across unrelated classes of goods and services.

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SIGNIFICANT CASE LAWS

Telangana High Court Sets Aside Blanket Injunction in Trade Secret Dispute

In the case of **Venkateshwarlu Guduru versus Siddhardha De Bathula** (2025 SCC OnLine TS 1394), the Division Bench of Justices Moushumi Bhattacharya and Gadi Praveen Kumar of the Telangana High Court set aside a temporary injunction granted by the Commercial Court for alleged trade secret infringement. The core issue was the vague and generalized nature of the information claimed to be a trade secret. The Court held that for any injunction to be granted in a trade secret dispute, the confidential information must be clearly identifiable, defined, and specific, rather than a broad body of details or plans. The trial court had merely relied on a finding that the appellant, a former employee, had gained experience and possessed certain business documents (like purchase orders and inventory lists) to conclude a prima facie case of infringement. The High Court criticized this approach, emphasizing that the lower court failed to discuss the exact nature or specificity of the trade secrets and did not ascertain whether the information was in the public domain or lacked independent economic value, which are essential legal prerequisites for trade secret protection.

The High Court further observed that the temporary injunction order was flawed due to its absolute and blanket nature, as it simply reproduced the prayers from the plaint, vaguely restraining the appellants from using "confidential information, trade secrets, and fiduciary duty" without linking these restraints to any specific, defined right of the defendant. The Division Bench elaborated that proving trade secret infringement requires the owner to first establish the existence of a valid trade secret and show that reasonable steps were taken to protect it, followed by proving unauthorized acquisition or use that caused damage. By failing to establish the specificity of the trade secret at the initial stage, the trial court passed an order that was not only legally unsound but also draconian and contrary to the appellant's constitutional right to carry on any trade or business. Consequently, the appeal was allowed, and the sweeping injunction was set aside.

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REGULATORY UPDATE:

USPTO Director Centralizes IPR Decisions, Proposes Rules to Curb Parallel Patent Challenges

On October 17, 2025, the United States Patent and Trademark Office **(PTO)** announced a **significant shift** in the administration of Inter Partes Review (IPR) proceedings, the administrative trials used to challenge the validity of issued patents. The move involved three major, interconnected actions: the withdrawal of prior proposed IPR rules from April 2024, the centralization of all IPR institution authority under the PTO Director, and the publication of a new set of proposed rules designed to focus IPRs away from cases already involved in litigation. These changes reflect an effort to promote efficiency, reduce duplicative challenges, and strengthen the finality of patent validity determinations.

The announcement by PTO Director John Squires fundamentally alters the process for instituting an IPR trial. The Director will now personally determine whether to institute a trial based on a comprehensive review of all factors—discretionary considerations, technical merits, and non-discretionary considerations. This replaces the prior interim, bifurcated process from March 2025, where the technical merits decision was delegated to a Board panel. By taking back this authority, the Director aims to streamline decision-making and remove the appearance of the Patent Trial and Appeal Board (PTAB) being responsible for both instituting and conducting the trial. The Director's decision will now be made without delegating any part of the institution decision to the Board that would ultimately conduct the trial proceeding...

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