



**FOXMANDAL**

**INTELLECTUAL PROPERTY**



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## **FOXMANDAL**

FoxMandal (“FM”), one of India’s oldest and largest full service legal organisation, traces back its origin to Calcutta when in 1896 J K Fox and G C Mandal, joined in partnership to establish one of the first Indo-British law firms by the name of “FoxMandal”. Upto 1984, the firm grew in Calcutta and established itself as a leading law firm in India. In 1984, the management of the firm was persuaded to open an associate office in New Delhi under the name of FoxMandal with local partners based in New Delhi.

The immense success of the firm’s operations in New Delhi was instrumental in establishing other associate offices in India, UK and Bangladesh including Bangalore, Chennai, Dhaka, Hyderabad, Kolkata, Mumbai, Noida, New Delhi, London and Surat. FM is a well-reputed full service law firm presenting an appropriate mix of the necessary legal expertise, industry specialization and commercial acumen. This firm of advocates, solicitors and notaries, comprises of over 150 lawyers with 20 partners and 100 para-legal staff. Our offices situated in all the important regions in India ensure that our clients receive cost-effective, value added and fully integrated services.

Over the years, FoxMandal has been ranked as the top firm in India by various international journals. | **Mr. Som Mandal is recipient of Economic Times Excellence in Leadership Award in August 2022.** In the year 2020 “Legal Comprehensive” recognised **Mr. Som Mandal** amongst one of the best “**TOP 100 Lawyers in the world**”. In the year 2019 FoxMandal was awarded “**Times Power Icons**” award for exemplary contribution in the field of “**Global Legal Service**”. In 2018 AI (Acquisition International) awarded FoxMandal Global Excellence Award “**National Law firm of the year 2018-India**”. In 2018 ICFM (Inter Continental Finance & Law Magazine nominated FoxMandal as one of the top 100 leading firms in the world. FM was also acknowledged by “**ACQS Law Awards 2017**” for “**National Law Firm of the Year**” for work done across all areas. FM was also acknowledged by “**Who’s Who Legal (WWL) 2016**” and “**Mr. Som Mandal was featured as a top legal consultant in Energy and Mining sector in India**”. FM was recognized by “**Legal 500 magazine 2015 edition**” for work done across all areas. FM was awarded the “**India Law Firm Awards 2014**” for the best **Corporate Commercial Law Firm** by “**India Business Law Journal (IBLJ)**”. FM was featured in “**The lawyers- 2014 Asia**

**Pacific 150** amongst **“Top 10 Indian law firms”**. FM won **“Acquisition International M&A award 2014”**. FM was awarded the **“Disinvestment law firm of the year – India”** by **Intercontinental finance magazine (ICFM)**, 2014. FM won the **“Acquisition international Dispute Resolution Firm of the Year Award 2013”**. The firm won **“Intercontinental Finance 2012 Global Award”**. FM was awarded the best **“Dispute Resolution Law Firm 2012 Finance Monthly Law Awards”**. FM won **“The Best National Law Firm, 2008”** award by the **International Legal Alliance Summit & Awards, 2008** at Paris and distinguished during the International Legal Awards Ceremony amongst the leading law firms from 22 countries. We have been awarded the **“Employer of Choice, 2008**, a response among over 15,000 lawyers region-wide by **ALB (Asian Legal Business)**. FoxMandal has been recognized with **“Client Choice Award, 2007”** in India from more than 1,300 individual assessments received from corporate counsel worldwide by **ILO( International Law Office)**, the **Official Partner to the International Bar Association**, for FM stands apart for the excellent client care and the quality of service. It has been awarded for the law firms' ability to add real value to their clients' business above and beyond the other players in the market. Amongst others, we have been adjudged as **“The Best Law Firm of the Year”** for India in 2006 by **IFLR (International Financial Law Review)**, a Euromoney publication.

The firm's practice areas includes, banking and finance, (including project finance, capital markets and mutual funds), initial public offerings, insurance, commercial disputes, property law and conveyancing, corporate and commercial law, energy (including coal, oil and gas), mining, telecommunications, intellectual property, partnership, testamentary, air law (including aircraft leasing), shipping, taxation, direct and indirect, and dispute resolution by litigation and arbitration before international and domestic tribunals.

This firm's strength is its team of experienced and trained lawyers who treasure the value of diligence and knowledge as well as creativity and innovation in addressing their client's needs. FM aims to offer to its clients, legal advice that meets the clients' needs and expectations, and in this it has been hugely successful as is evidenced by the firm's ratings by various international journals.

## **Intellectual Property**

Our intellectual property team has expertise in all areas of trade/service mark, trade secret, design, copyright and patent law. We advise our clients on the selection, availability, use and registration of all of the above. This practice area consists of several individuals with scientific backgrounds to facilitate patent prosecution. We have the expertise to negotiate on behalf of celebrities and draft relevant agreements. Additionally, we advise on worldwide domain name registration and disputes, on-line infringements other issues relating to Internet law mainly rooted from trade mark and copyright law. We also have attorneys who have extensive experience in the litigation of intellectual property conflicts. In addition, our team is also experienced in negotiating and drafting a variety of license agreements.

## **Patent**

FM has a full-service patent practice and we service our clients with our in-depth knowledge, resources and experience when handling their Patent Portfolios. Our services follow and support the life cycle of the patent including search, application drafting and prosecution, amendments, maintenance, licensing, assignment, opinions and litigation.

This group comprises of an effective amalgam of technical and legal professionals. The Firm provides a gamut of legal services in the patent field.

- The Firm has handled a variety of technology licences and technical assistance agreements for joint ventures.

Reproduced below is a non exhaustive list of our services in this field:

- Prior art searches;
- Applications and prosecution;
- Advice on patentability, infringement and validity of patents;
- Patent litigation;
- Licensing;
- Assignment; and
- Portfolio management



## **Trade Mark**

At FM we realize that Brands are crucial to the success of most modern business. Therefore, apart from undertaking conflict searches, filing and prosecution of the trade mark applications, FM also provides a watch service. We not only help our clients register their marks but also help police them. We promptly advise our clients of any attempts by third parties to use and/or register similar/same/confusingly similar trade marks and assist in putting an end to such use or registration.

We send out Cease and Desist letters to anyone found infringing our client's trade marks asking the infringers to cease and desist from the use of marks identical or similar to our client's marks.

We regularly send updated status reports of all the trade marks held by the clients to ensure that the clients stay regularly informed of the current status of their trade marks.

We also provide comprehensive anti counterfeiting options to our clients. We obtain court orders (search & seizure); liaise with the police or official receiver and even participate in the raids that are conducted, be it civil or criminal.

We conduct due diligence in connection with mergers, asset purchases and the assignment of trade mark rights.

Additionally, FM regularly advises, negotiates and prepare license, assignment, franchising and co-existence agreements on behalf of our clients.

Reproduced below is a non exhaustive list of our services in this field:

- Availability searches and opinions;
- Filing and prosecution;
- Settlement Agreements

- Oppositions;
- Domain name disputes and registration and maintenance;
- Anti – counterfeiting strategies;
- Infringement opinions;
- Licensing and permitted use agreements; and
- Portfolio management.

### **Copyright**

FM has broad experience in copyright and content protection. This practice group assists clients in a wide variety of copyright related transactions. Be it registration, negotiating terms and conditions of publishing, distribution, royalty, licensing and assignment agreements, we do it all. In addition, we advice clients on the international validity of copyright.

This has been an area of concern especially given the increase in Business Process Outsourcing to India. We regularly advice clients in relation to content developed by employees during the course of their employment, developing in-house policies for employees’ use of copyrighted works, e-mail and the Internet.

This group has extensive experience in infringement litigation, representing copyright owners as well as alleged infringers

Reproduced below is a non exhaustive list of our services in this field:

- Drafting copyright and internet-related contracts (such as website design/hosting agreements and electronic publishing agreements, etc);
- Registering and enforcing copyrights;
- Clearing copyrights in materials to be used on websites or other multimedia products;
- Drafting copyright notices;
- Litigation;
- Agreements related to music licensing;
- Assignments; and
- Portfolio Management

**An indicative list of FM clients in the Intellectual Property is as follows:**

- Acting on behalf of **Then Maschinen (B.V.I.) Limited** for patents filing, prosecution and maintenance of patent applications in India
- Acting on behalf of **Indian Institute of Technology (Delhi)** for patents searches, drafting, filing and prosecution in India and PCT Filing and Abroad.
- Acting on behalf of **NRDC, National Research Development Corporation** for patents searches, drafting, filing and prosecution in India and PCT Filing and Abroad.
- Acting on behalf of **Samsung Electronics. Co. Ltd. (Korea)** through **Selim Intellectual Property Law Firm, Century IP Law Firm, Prime Intellectual Property Law Firm** in relation to patent National phase/ Convention filing and prosecution in India;
- Acting on behalf of **NewBioMed PIKA Ltd and Yeshing Biopharma Pvt. Ltd.** in relation to national phase filing and prosecution of patent application;
- Acting on behalf of **Polymer Technologies International** for Trademark filing, infringement, opposition and prosecution in India and Abroad.
- Acting on behalf of **Borges India** for Design/Trademark searches, filing and prosecution in India and Abroad.
- Acting on behalf of **Pavit Worldwide** for Design/Trademark filing and prosecution in India and Abroad.
- Acting on behalf of **Cardiac Pacemakers Inc.** for Trademark filing and prosecution in India.
- Acting on behalf of **AGA Medical Corporation** in various law suits filed by against infringers of its patented product in India. Prosecution of various patent applications in India;
- Acting on behalf of **Tyco Electronics Pvt. Ltd** in relation to Patent searches, drafting, patent filing and prosecution of patent application;
- Acting on behalf of **Batelle Memorial Institute** in relation to national phase filing and prosecution of patent application;

- Acting on behalf of **Falmer Investment Pvt Ltd** in relation to national phase filing and prosecution and maintenance of patent applications in India;
- Acting on behalf of **Vicus Therapeutics** in relation to national phase filing and prosecution of patent application;
- Acting on behalf of **WFCP LLC** in relation to national phase filing and prosecution of patent applications in India;
- Representing **Alpha Pharma Healthcare Pvt. Ltd.** in relation to an IP infringement suit and settlement of the disputes;
- Acting on behalf of **MANCHES LLP** for Trademark filing and prosecution in India.
- Acting on behalf of **METALSA** for Trademark filing and prosecution in India.
- Acting on behalf of **TARRANT CAPITAL IP, LLC** for Trademark filing and prosecution in India.
- Regularly provide specialist IP advice to **Spice Mobile Communication**;
- Acting on behalf of **Spice Mobile** for Trademark filing and prosecution in India.
- Acting on behalf of **ZACCO NETHERLANDS** for Trademark filing and prosecution in India;
- Acting on behalf of **Continental Airlines** for Trademark filing and prosecution in India;
- Drafted Patent Validity Opinion and acting for **Daichi Sankyo Company Limited** in patent Opposition and Litigation in India;
- Acting on behalf of **Elcomponics** in relation to various trademarks filing and prosecution in India;
- Acting on behalf of **BEAM GLOBAL** for Trademark filing and prosecution in India.
- Acting on behalf of **Technology Information, Forecasting and Assessment Council (TIFAC)** for patents searches, drafting, filing and prosecution in India and PCT Filing;



- Drafted various contracts for **Eros International PLC** including contracts for engaging script writers, co-production of films, rights buy-out agreements;
- Rendered advice to **Barmy Army Cricket Supporters Club Ltd** in relation to availability, use and registration of trade marks in India;
- Drafted a memorandum of understanding and confidentiality agreement in relation to the co production of an animated film for **Canyon Industries Entertainment**. Rendered miscellaneous advice in relation to the above;
- Advised and represented **Barbara Taylor Bradford** in a litigation against Sahara T.V. with respect to the soap, 'Karisma- Miracles of Destiny';
- Acted on behalf of **Universal Studios** for production of the Film 'Guru' including location contracts, releases, production agreements etc;
- Acted on behalf of the esteemed polo player **Yuvraj Shivraj of Jodhpur**;
- Advised **Warner Bros** in relation to establishing a joint venture company in India for bringing out a sports magazine in India and reviewed various contracts and rendered advice in relation to the Indian shoot of the motion picture entitled Blood Diamond;
- Prepared a detailed memo for **Star T.V.** in relation to telemarketing;
- Advised **International Hotel Management Limited**;
- Advised **Electronic Arts** on investment issue in EA Games India Private Limited;
- Advised and acted on behalf of **Huawei Technology Pvt. Ltd** on software protection in India and domain name disputes arbitration before the National Internet Exchange of India (NIXI);
- Rendered advice to the Author **Mr. Ashok Banker** in relation to option agreements for literary property. Vetting of various contracts such as non-disclosure agreements, memorandum of understanding etc. Drafting and sending legal notices for recovery of royalties due to the author;
- Rendered advice to **Bulldog Entertainment and Media Limited** in relation to the option and exercise of option of formats including the format for the reality show 'Are you smarter than a fifth grader?' ('*kya aap panchvi pass se tez hain*'). Drafted various non-disclosure

agreements in relation to the above. Miscellaneous IP advice including selection, use and protection of IP;

- Advised **PVI Virtual Media Services, LLC** in relation to cross border technology transfer;
- Acted on behalf of **Ministry of Sound International Limited** in relation to infringement of copyright and passing off of trade marks;
- Acted on behalf of **Valentino** in relation to various trade marks filing and prosecution in India;
- Represented **Daimler Chrysler**, drafted criminal complaint for obtaining search and seizure orders against unknown persons with regard to trade mark and copyright violations. Assisted the police in conducting raids on various manufacturers of counterfeit auto parts;
- Advised **Stichting Green Peace Council** related to availability, use and registration of trade marks in India and prosecution of trade mark applications;
- Represented **Shanghai Belling** in relation to an IP infringement suit and settlement of the disputes;
- Represented **Scotch Whisky Association** in relation to Trade Mark Infringement in India;
- Acted and advised **Leading Indian actress Nandita Das** in relation to various documents ranging from distributorship agreements to actor engagement contracts;
- Represented **Sony Music Entertainment (India) Private Limited** in relation to litigation for compulsory licensing of a music album;
- Advised **Wisden Cricinfo** in relation to various IP related agreements and contracts.
- Acted for **Lexis Nexis** in conducting due diligence followed by drafting, negotiating and closing acquisition of IP assets of Wadhwa & Co.
- Acted for **Major League Baseball Inc.** in trade mark opposition proceedings.
- Advised **Pfizer Inc.** on data protection and data privacy laws of India.

- Advised **M Corp Global FZE** in various miscellaneous IP matters.
- Advised **Blackberry Research in Motion** in relation to the import of blackberry handhels and tie up with Bharti Telesonic (Airtel), including advise on corporate issues, import requirements, enforceability of click wrap/ shrink wrap agreements & vetting of master supply agreements etc.
- Rendered advice to **i2 Technologies Ltd** regarding software licensing.



**You Could Reach Us On:**

	<b>Email</b>	<b>Mobile</b>
<b>Bangalore</b>		
Rachitha Hiremath	<a href="mailto:rachitha.hiremath@foxmandal.com">rachitha.hiremath@foxmandal.com</a>	+91-99019 44550
Ashok Joshi	<a href="mailto:ashok.joshi@foxmandal.com">ashok.joshi@foxmandal.com</a>	+91-96634 05000
<b>Chennai</b>		
Sanjeev Kumar	<a href="mailto:sanjeev.kumar@foxmandal.com">sanjeev.kumar@foxmandal.com</a>	+91-98840 44022
Yathin Reddy	<a href="mailto:yathin.reddy@foxmandal.com">yathin.reddy@foxmandal.com</a>	+91-98846 56789
Srinath Iyengar	<a href="mailto:srinath.iyengar@foxmandal.com">srinath.iyengar@foxmandal.com</a>	+91-99400 45709
<b>Dhaka</b>		
Alamin Rahman	<a href="mailto:alamin.rahman@fma.com.bd">alamin.rahman@fma.com.bd</a>	+880-17130 61213
<b>Hyderabad</b>		
Swati Sinha	<a href="mailto:swati.sinha@foxmandal.com">swati.sinha@foxmandal.com</a>	+91-98109 70477
<b>Kolkata</b>		
Som Mandal	<a href="mailto:som.mandal@foxmandal.com">som.mandal@foxmandal.com</a>	+91-98308 01808
Indranil Rudra	<a href="mailto:indranil.rudra@foxmandal.com">indranil.rudra@foxmandal.com</a>	+91-90733 77516
Biswarup Mukherjee	<a href="mailto:biswarup.mukherjee@foxmandal.com">biswarup.mukherjee@foxmandal.com</a>	+91-78382 13753
<b>Mumbai</b>		
Subrata Sen	<a href="mailto:subrata.sen@foxmandal.com">subrata.sen@foxmandal.com</a>	+91-98201 55521
Vijay Kumar	<a href="mailto:vijay.kumar@foxmandal.com">vijay.kumar@foxmandal.com</a>	+91-98914 66518
Vandana Mishra	<a href="mailto:vandana.mishra@foxmandal.com">vandana.mishra@foxmandal.com</a>	+91-99200 88351
<b>New Delhi</b>		
Sangeeta Mandal	<a href="mailto:sangeeta.mandal@foxmandal.com">sangeeta.mandal@foxmandal.com</a>	+91-95999 45323
Mamta Tiwari	<a href="mailto:mamta.tiwari@foxmandal.com">mamta.tiwari@foxmandal.com</a>	+91-98100 79469
<b>London</b>		
Som Mandal	<a href="mailto:som.mandal@foxmandal.com">som.mandal@foxmandal.com</a>	+91-98308 01808 +44-79609 33497
<b>Surat</b>		
Srinath Iyengar	<a href="mailto:srinath.iyengar@foxmandal.com">srinath.iyengar@foxmandal.com</a>	+91-99400 45709