



Adheesh Nargolkar

Partner

One Indiabulls Centre
13th Floor, Tower 1
841 Senapati Bapat Marg
Mumbai - 400 013
India

T: +91 22 6636 5000

F: +91 22 6636 5050

E: adheesh.nargolkar@khaitanco.com

Practices:

Intellectual Property

Education:

L.L.M., University of Mumbai
(2006)
Post Graduate Diploma in Patent
Law, NMIMS University, Mumbai
(Year)???
B.E. (Electronics & Telecom.),
University of Pune (2001)
Registered Patent Agent,
Mumbai

Professional Affiliations:

Bar Association of Maharashtra &
Goa
The Trademark Registry and the
Patent Office, India
International Trademark
Association (INTA)
Asian Patent Attorneys
Association (APAA)

Sectors:

Automobile
Chemicals
Electronics
FMCG / Consumer Goods
IT and IT Services
Pharmaceuticals and Healthcare

Adheesh is a Partner in the Intellectual Property (IP) team of the Firm. With more than 15 years of experience working in IP boutique firm and full service law firms, Adheesh's expertise extends to the entire gamut of IP laws which includes prosecution, patent drafting, enforcements, management, contentious matters, advisory and transactions. Being doubly qualified (as an engineer/patent agent and a lawyer), Adheesh plays a pivotal role in the full-service IP practice of the Firm.

Representative Matters:

In his areas of expertise, Adheesh has advised and represented the following clients:

Patent & Design Prosecution:

He has drafted patent specifications for clients in various industries including mechanical, electrical, electronics, software, consumer goods, chemical, medical devices, and automobile and advised the clients in the above industries on matters relating to patentability and validity. He has also contested opposition proceedings and drafted freedom to operate (FTO) opinions. Further, he has also advised several clients in relation to design registration. To cite few clients:

- **Mercedes-Benz Research and Development India Pvt Ltd, Gujarat Narmada Fertilizers Company Ltd, Gharda Chemicals Ltd, Godrej & Boyce, Godrej Consumers, Cipla Ltd, Mahindra & Mahindra Ltd, Gujarat Fluorochemicals Ltd, Indian Institute of Technology, Bombay, Ather Energy, Crompton & Greaves** on patent prosecution work; and
- **Ather Energy, Britvic, Greenlight Planet, Abbott Laboratories,** and **Godrej** on design registration work.

Trademark & Copyright Prosecution:

In this field, he has advised and represented, amongst others, the following clients:

- **Novartis AG, Lupin Ltd, Menarini, King.com (Candy Crush Saga), Tata Group Companies, Sopariwala Exports, Zespri, Mahindra Group, CK Birla Group, Indian Institute of**



Technologies (IIT), Geltec and Godrej on domestic trademark prosecution work.

- **Raymond Ltd, Piramal Enterprises, Sopariwala Exports, Geltec, VIP Industries, Lexi Pens, Trent Ltd, Greenlight Planet, ADF Foods** on international trademark prosecution work in more than 70 countries.
- **Novartis AG, Raymond Ltd and Punch Industries** on customs registration of trademarks with the customs office under the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007.
- **Cleartrip, Samruddhi Finstock, Sopariwala Exports, Ather Energy and Birla Lifesciences** on copyright registration.

IP Contentious:

Adheesh has handled litigation in the areas of patents, trademarks, trade dress, copyrights, designs, domain names and confidential information including in relation to the following:

- **CTP Environnement, Sopariwala Group, Nath Pulp & Paper Mills** on patent infringement matters.
- **Novartis, Zespri, King.com (Candy Crush Saga), Intas Pharmaceuticals, the Mahindra Group, Kalpataru Group, Pidilite Industries, Lupin Limited**, in numerous trademark contentious matters (potential or actual) to protect their marks and obtain anton piller orders.
- **Novartis, Mahindra Group** and **Sopariwala Exports** on domain name disputes.
- **Hindustan Unilever Limited** on the issue of disparagement and trademark infringement matters.
- **Godrej & Boyce** and **Greenlight Planet** on design infringement suits.

Transactional IP:

- Transactional aspects of intellectual property including drafting, negotiating and advising on technology transfers, licensing of intellectual property, franchising and acquisitions including in relation to the following:
- **Otsuka Pharmaceutical Factory, Inc. (Otsuka)** on a proposed investment by **Otsuka and Mitsui & Co., Limited** in **Claris Specialty Injectables Limited (JV)**, a subsidiary of **Claris Lifesciences Limited (Claris)**, to form a 3-way strategic joint venture between Otsuka, Mitsui and Claris.
- **Tata Motors Limited** in negotiating and drafting patent assignment and license agreements for acquiring the



engine technology using compressed air from a French Company and manufacturing and selling the said engine in India.

- **The Blackstone Group** in its private equity investment in India in Emcure Pharmaceuticals Limited, a leading generic pharmaceuticals manufacturer, which included conducting a detailed review of the patents of Emcure.
- **Allegra Therapeutics** on patent issues in a securitisation transaction.
- **Gujarat Fluorochemicals Limited** in a technology and patent license agreement on certain chemical products.
- **Glenmark Pharmaceuticals Limited** on their service agreements for contract manufacturing.
- **Sun Pharmaceuticals** on the peculiar trademark issues arising out of the conflict with competition law in a merger transaction with Ranbaxy.
- **The Blackstone Group** in acquiring a minority shareholding in NSL Seeds, a company engaged in the business of producing and distributing seeds, which involved conducting intellectual property due diligences.

Publications and Presentations:

- Adheesh is a faculty at the Institute of Intellectual Property Studies (IIPS), Mumbai and has been a speaker at several forums/events including at the Indian Patent Office, Embassy of India in Israel, FICCI Seminars and Global IP Convention.
- Adheesh is a contributor and has co-authored articles on the developments in the Indian IP law for several publications such as World Trademark Review, Lexology, Mondaq and World IP Review.

Recognitions and Accomplishments:

- Recognised as a Patent Star in IP Stars rankings and has also featured in several other rankings such as Legal 500, Leaders League, WTR 1000 and Asia IP.