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Article

Demystifying the scope of amendments in patent claims – Indian jurisdiction

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Introduction

Amendments to a patent application form an essential element in demarcating the scope of inventions. In India, claim amendments are governed by Sections 57 to 59 of the Patents Act, 1970 (hereinafter referred to as the 'Act').

This article provides a comprehensive guide on the scope of claim amendments allowed in the Indian Patent regime. It focuses on the relevant aspects which must be kept in mind when applicants/patentees wish to file claim amendments. The article also highlights the trends at the Indian Patent Office (IPO) in examining the claim amendments.

Importance and requirements of amendments in claims

Claims form an important part of a patent specification as they determine the metes and bounds, or extent, of protection granted to an applicant/patentee. Section 10(4) of the Act states that '*Every complete specification shall: (c) end with a claim or claims defining the scope of the invention for which protection is claimed.*' Therefore, they are indispensable in laying out the scope of monopoly rights claimed.

An applicant/patentee can modify the scope of the protection being asserted by amending the claims. Claim amendments are widely acknowledged across several jurisdictions and have been part of the Indian patent system since 1911.¹

However, an applicant/patentee does not have an unbridled right of claim amendment. The assessment of whether an amended claim is allowable is done by comparing the proposed amendment with the claims before the amendment. The amendments must fall within the scope of the claims as they existed before the amendment and must not expand the scope of the invention. This proposition was laid down in the Ayyangar Committee Report, 1959², and has since been implemented in the current Patent regime in India.

Since amendments delineate the scope of protection of the invention, it is important to understand the legal provisions underlining claim amendments.



¹ Section 17, Patents and Designs Act, 1911. [‘An applicant or a patentee may at any time, by request in writing left at the Department of Patents, Designs and Trade Marks and accompanied by the prescribed fee, seek leave to amend his application or specification, including drawings forming part thereof, by way of disclaimer, correction or explanation, stating the nature of, and the reasons for, the proposed amendment.’]

² REPORT ON THE REVISION OF THE PATENTS LAW, Shri Justice N. Rajagopala Ayyangar (1959), [‘w]here the invention which emerges as a result of an amendment is different from that which was the subject matter of the specification as originally accepted, such an amendment should **not** be permitted’ [available at: [1959- Justice N R Ayyangar committee report.pdf](#)].

Amendment provisions in the Indian Patent Act: Sections 57 - 59

Section 57 of the Act lays down the procedure of filing an amendment. An applicant/patentee can file an application for amendment using Form-13. An application for amendment must state the nature and reasons of the proposed amendment and contain support of the amendment from the pending or as filed claims. Section 58 of the Act deals with the amendment of the specification before the High Court.

Section 59 (1) of the Act lays down the types of amendments that are permissible under the Act:

Ways of Amendment	Scope of Amendment
Disclaimer	Amendments that narrow down the invention by delimiting the claims. ³
Correction	Amendments made to correct clerical errors and mistakes
Explanation	Amendments that do not change the scope of the invention and make the claims clear and unambiguous. ⁴

A pre-requisite of allowable amendments expounded clearly by Section 59(1) of the Act, as well as several legal precedents, is that the amendments must not claim any new subject matter which was not disclosed in the specification before the amendment. Further, the amendment must fall within the scope of the claims before the amendment and be supported

in substance by the specification. These principles form the bedrock of allowable claim amendments and have been reiterated in several case laws.

Judgements to understand the trends of claim amendments

The Controller of Patents, Designs & Trademarks (hereinafter, 'Controller'), in assessing whether the amendments fall within the scope of the specification before the amendment, must analyse the specification as a whole. Support for the amended claim may be found in the drawings in the original specification as well. The position was echoed by the erstwhile Hon'ble Intellectual Property Appellate Board (IPAB) in *Prism Cement Ltd. v. The Controller of Patents and Designs*.⁵ In this case, the IPAB had to analyse whether changing the term 'channel' in the original claim to 'open channel' in an amendment broadened the scope of the claims. The IPAB held that perusal of the entire original specification shows that the amendment was already a '*part and parcel of the original disclosure*' and did not broaden the scope of the claim.

Amendments that involve the addition of claims are analysed cautiously by the Controllers to ensure no new claim is being added. Addition of 'independent' claims is examined strictly and only allowed if the same falls within the scope of the as filed claims. Addition of 'dependent' claims is allowed if they add some further statement or restriction to the matter in the independent claim. The IPAB, in *Tony Mon George – The Regents of the University of Michigan v. The Controller General of Patents, Designs & Trademarks & Anr*⁶, elucidated upon this aspect. In this case, the IPAB addressed whether the insertion of dependent claims in an amendment is allowable.

³ *AGC Flat Glass Europe SA v. Anand Mahajan and Ors.*, (2009) ILR 4 Delhi 256.

⁴ *Prism Cement Ltd. v. The Controller of Patents and Designs*, (IPAB) OA/7/2016/PT/MUM.

⁵ OA/7/2016/PT/MUM.

⁶ OA/48/2020/PT/DEL.

It accepted two out of three of such amendments by stating that if the dependent claims are not accepted, the principal claim would be left vague and non-definitive. Therefore, it cannot be said that the amendments were adding a 'new' subject matter, as they were defining the scope of the subject matter already present in the independent claim.

The issue of post-grant claim amendments was addressed by the Delhi High Court in *AGC Flat Glass Europe SA v. Anand Mahajan and Ors*⁷. The plaintiff, in this case, amended the claims during a patent infringement suit. The court allowed the addition of the phrase 'a sensitizing material, typically tin' in a claim listing the composition of an environment-friendly mirror, as it held that it was merely clarificatory in nature and did not extend the monopoly rights of the patentee. However, the Court noted that belated amendments may be a ground for refusal of the patent.⁸ Therefore, patentees must be prudent in filing claim amendments after the grant of the patents.

Different stages of amendments in the claims

The information relevant for filing claim amendments at various stages of patent prosecution in India is provided below.

• AMENDMENTS BEFORE THE GRANT OF PATENT APPLICATION

I. Amendments at the time of filing a patent application

Can claims be cancelled at the time of National Phase entry in India?

Yes. For the applications entering National Phase in India,

⁷ (2009) ILR 4 Delhi 256

⁸ 'Are Belated Claim Amendments of Granted Patents Permitted?', LAKSHMIKUMARAN & SRIDHARAN ATTORNEYS (available at [Are Belated Claim Amendments of Granted Patents Permitted? | Lakshmikumaran & Sridharan Attorneys \(lakshmisri.com\)](http://www.lakshmisri.com)).

deletion/cancellation of claims is the only amendment allowed, as per Rule 20(1) of the Patents Rules, 2003 (the 'Rules' hereinafter), to avail the benefit of reduction in claim fees. Such National Phase applications may include amendments which have already been filed under Article 19 or Article 34 of PCT. However, cancellation of claims must be considered carefully at this stage, since reinstating any cancelled subject matter at a later stage is difficult.

What type of claims can be cancelled at the time of National Phase entry in India?

Claims reciting statutorily non-patentable subject matter in India can be cancelled. If the claim recites a subject matter which falls under Sections 3 and 4 of the Act, they can be cancelled. A few examples of non-patentable subject matter in India are given below:

- (i) Claims reciting a **method of treatment of human beings or animals** are not allowed in India under Section 3(i) of the Act.⁹
- (ii) Claims reciting a **plant or an animal or any parts thereof and essentially biological processes for production or propagation of plants and animals** are not allowed in India under Section 3(j) of the Act.¹⁰ However, claims reciting microorganisms or microbial cells

⁹ Section 3(i), Patents Act, 1970 ['3. What are not inventions: ... (i) any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.'].]

¹⁰ Section 3(j), Patents Act, 1970 ['3. What are not inventions: ... (j) plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals.'].]

can be retained, if they have been prepared by substantial human intervention.

- (iii) Claims reciting a **method of agriculture or horticulture** are not allowed under Section 3(h) of the Act.¹¹
- (iv) Claims to **an invention relating to atomic energy** are not allowed under Section 4 of the Act, read with Section 20(1) of the Atomic Energy Act, 1962.¹²
- (v) Claims reciting **'use', application-type claims, and Swiss-type claims** are not allowed in India under Section 2(1)(j) of the Act, since Section 2(1)(j) of the Act only allows product claims or process claims.¹³

Can claims be merged/ added at the time of National Phase entry in India?

No. At the time of National Phase entry, any form of amendments other than deletion/cancellation of claims, is not allowed. These amendments can only be filed once the application has entered India. After the National Phase filing, a request for voluntary amendment of the claims can be made using Form-13 and submitting the prescribed fee for the same, in accordance with Rule 14 of the Rules.

¹¹ Section 3(h), Patents Act, 1970 ['3. What are not inventions: ... (h) a method of agriculture or horticulture'].
¹² Section 20(1), Atomic Energy Act, 1962 ['No patent shall be granted for inventions which, in the opinion of the Government of India, are useful for or relate to the production, control, use or disposal of atomic energy or the prospecting, mining, extraction, production, physical and chemical treatment, fabrication, enrichment, canning or use of any prescribed substance or radioactive substance or the ensuring of safety in atomic energy operations.']
¹³ Section 2(1)(j), Patents Act, 1970. ["invention' means a new product or process involving an inventive step and capable of industrial application"].

Should claims be cancelled in a parent application before or after filing a divisional application?

A divisional application is carved from the claims present in the parent application. The principle 'what is not claimed, stands disclaimed', noted in the Indian Patent Office's Manual of Practice and Procedures (hereinafter, 'Manual') is relevant in this regard.¹⁴ When an applicant cancels a claim in the parent application before filing a divisional application, it implies that they have recanted their right over the claim. If these cancelled claims are recited in the divisional application, some Controllers may raise objections to the same, as they treat the cancelled claims as having been renounced by the applicant. Therefore, to overcome such objections, it is advisable that claims in a parent application only be cancelled after the divisional application¹⁵ is filed.

II. Amendments at the time of request for examination

A request for examination can be filed either with amended claims made by way of voluntary amendment, or along with the as-filed claims.

If an applicant has retained the method of treatment claims or use claims at the time of National Phase

¹⁴ Clause 05.03.15, MANUAL OF PATENT OFFICE PRACTICE AND PROCEDURES, 2019, The Office of Controller General of Patents, Designs and Trademarks ['What is not claimed in the claims (including amended claims) stands disclaimed and is open to public use, even if the matter is disclosed in the description.'].
¹⁵ Divisional Applications in India – Evolving jurisprudence', Lakshmikumaran & Sridharan ATTORNEYS (available at <https://www.lakshmisri.com/insights/articles/divisional-applications-in-india-evolving-jurisprudence> | Lakshmikumaran & Sridharan Attorneys (lakshmisri.com))

entry and wishes to amend the said claims to recite a product claim to gain protection for their invention, would such an amendment be permissible?

An amendment that changes the scope of the claims from method of treatment claim or use claim to product claim is not allowed, even if the same has appropriate support in the specification. The rationale behind the same is that an amendment cannot change the scope of an invention that is essentially non-patentable under the Indian patent regime, to a patentable invention.

The Controller's decision in patent application 4807/CHENP/2006, filed by **Bristol-Myers Squibb** throws light on this matter. The PCT application recited method of treatment claims, which are non-patentable in India. These were amended to Swiss-type claims at the time of national phase filing, and finally amended to recite composition claims. The application was rejected by the Controller, as firstly, amendments of a substantive nature are not allowed at the time of national filing, and secondly, as the amendments changed the scope of the invention.

III. Amendment at the time of active prosecution of the application

Active prosecution begins once the request for examination has been filed. Once the patent application has been carefully examined, an examination report is generated, listing the objections raised by the Controller. To overcome these objections, an amended set of claims can be filed along with the response to the

examination report. If the Controller is not satisfied with the arguments, the IPO will offer a hearing to the applicant to address any pending objections. After the hearing, the applicant is required to submit the written response along with the amended claims, if any.

Can the applicant submit a main request along with auxiliary requests for claim amendments, similar to the European Patent Office (EPO)?

In the EPO, an applicant may submit a main request followed by one or more auxiliary requests with respect to claim amendments. This is done so that if the main requests are not allowed, alternatively, the auxiliary requests may be accepted.

In India, only one set of claims is submitted along with the response to the examination report, which is examined by the Controller. Subsequently, the Controller may grant the application or if there are any outstanding objections, the Controller may issue a Hearing Notice. After the hearing, the applicant can submit a final set of amended claims along with the written submission. There is no provision for submitting alternative, or auxiliary requests in India.

Can the cancelled claims be reinstated during the prosecution of the application?

If an applicant cancels any claims in an application, the IPO considers that the monopoly rights over the same are relinquished. Such cancelled claims are therefore deemed to be open for

public use.¹⁶ Reinstating them at a later stage may invite objections from the Controller. Therefore, where there is a possibility that claim(s) may be reintroduced later, it is advisable not to cancel such claim(s) in the first place. The Controller, in rare cases with acute possibility, may permit the re-insertion of cancelled claims if they meet the requirements of Section 59 of the Act.

• AMENDMENTS AFTER THE GRANT OF THE APPLICATION

Amendments after the grant of the patent application are subject to various restrictions under Sections 57 and 59 of the Act.

Is there any provision to make amendments after the patent has been granted?

Yes. Section 57 of the Act allows a patentee to file an application for amendment after the grant of the patent. Further Rule 81(3) governs the procedure of post-grant claim amendments. The High Court of Delhi pronounced upon the maintainability of post-grant amendments in *AGC Flat Glass Europe SA v. Anand Mahajan and Ors.*¹⁷ It allowed a post-grant amendment in this case as it was merely clarificatory/elaborative in nature and did not alter the scope of the invention. However, the Court made a cautionary statement noting that delays in filing claim amendments where the patentee is aware of the objection may

lead to refusal of the patent. Therefore, it is advisable that amendments are filed either before the grant of the patent or promptly when the objection is become known to the patentee.

Will the doctrine of 'lis pendens' apply to the amendments in the claims?

Lis Pendens means 'pending suit' and is based on the maxim '*Pendente lite nihil innovetur*', i.e., nothing new must be introduced while litigation or suit is pending.

As per the proviso of Section 57 of the Act, if any suit for infringement is pending before any Court, or any proceeding for revocation of the patent is pending before the High Court, the Controller shall not pass any order allowing or refusing the application for amendment.

Does the Patents Act empower the Controller for correcting clerical errors that do not lead to the inclusion of substantive amendments?

Section 78 of the Act authorizes the Controller to correct any clerical error, upon the request of any person interested or *suo motu*. It is important to note that a Controller may not make any amendments to the application in lieu of making corrections. Such power is restricted to making corrections that are not substantive, and do not materially alter the scope of the document. This position was reiterated by the Delhi High Court in *Aia Engineering Ltd. v. Controller of Patents.*¹⁸

Where a correction is proposed *suo motu*, the Controller shall notify the

¹⁶ Clause 05.03.15, MANUAL OF PATENT OFFICE PRACTICE AND PROCEDURES, 2019, The Office of Controller General of Patents, Designs and Trademarks [What is not claimed in the claims (including amended claims) stands disclaimed and is open to public use, even if the matter is disclosed in the description.].

¹⁷ (2009) ILR 4 Delhi 256.

¹⁸ 2007 (34) PTC 457 Del.

applicant/patentee, and any other person he deems to be a concerned party. Further, to prevent the expansion of the scope of the claims, where a substantial correction is requested, the proposed correction shall be published.

If the IPO allows the amendments, can a third party invalidate the claims?

The above refers to a situation where the amendments are not made by way of disclaimer, correction, or explanation, but meet the other requirements, i.e., incorporation of actual fact, claiming any matter which is disclosed in substance in the specification, and falling wholly within the scope of pre-amendment claims.

In this case, after the grant, the third party cannot challenge the granted claims by virtue of Section 59 of the Act. Rather, the third party needs to invalidate the claims by initiating a revocation proceeding under Section 64 of the Act.

• AMENDMENTS AFTER REFUSAL OF THE APPLICATION

Is there any provision to amend the claims after the refusal of the patent application?

Upon refusal of a patent application, the applicant may file an appeal against the order at the High Court. Prior to the enactment of the Tribunals Reforms Act, 2021, such appeals were heard by the IPAB. The applicant should ideally file all their amendments before the Controller before the application is accepted or refused. In any appeal, it is not advisable

to include any new matter that was not argued/presented at the lower echelon. Filing an amendment at this stage before IPO independent of the appeal, calls into question the conduct of the applicant.

Regardless, Section 58 of the Act authorises the High Court to allow amendments in claims or specification as it sees fit. If amendments proposed before the Patent Office were not considered, the same can be entertained by the High Court. Fresh amendments may be filed in a separate miscellaneous petition, filed along with the appeal. The Court has the discretion to accept the amendments, or to remand the matter to the Controller to consider it afresh.

Conclusion

Claim amendments form a crucial role in delineating the extent of monopoly rights that a patentee is granted in an invention. Sections 57 and 59 of the Act provide an important safeguard in reducing the scope of misuse and unjust expansion of claims. However, there must be a consistent interpretation of these provisions. Interpreting them restrictively and disallowing legitimate amendments shall unduly affect the interests of a genuine applicant/patentee, creating room for possible infringement of rights. With time and evolving jurisprudence, we hope that more decisions in the matter can help protect the rights of the applicant(s) effectively.

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Ratio decidendi

Territorial jurisdiction of court in trademark and copyright disputes – Situs of branch office not enough – Part of cause of action also required

The Madras High Court has reiterated that *situs* of the branch office *per se* will not confer territorial jurisdiction to a Court in the disputes involving trademark or copyright. Relying upon the Supreme Court decision in the case of *Indian Performance Rights Society v. Sanjay Dalia* [(2015) 10 SCC 161], the Court held that at least a part of the cause of action should have arisen in the place where the branch office is situated. It was of the view that if suits were to be allowed to be filed based only on the branch office and nothing more, it will lead to mischievous consequences. The suit was filed before the Madras High Court only on the basis of the location of one of the branch offices of the petitioner in Chennai.

The Court noted that in a suit instituted for trademark and copyright infringement, the territorial jurisdiction is determined only based on the privilege given to the plaintiff under Section 134(2) of the Trademarks Act, 1999 and Section 62(2) of the Copyright Act while the requirement of Section 20 of the Civil Procedure Code is not applicable. It also took note of the report of the Joint Committee and the Parliamentary debates during substitution of clause (2) to Section 62 of the Copyright Act, 1957.

Observing that the Supreme Court in the case of *Sanjay Dalia* gave a purposive interpretation of the provisions of Trademarks and Copyrights Acts, the single Judge Bench of the Madras High Court differed with its earlier decision in the case of *Hindustan Unilever Ltd. v. Andhra detergents* [2017 2 LW 507]. It however held that there is no

need for referring the issue to a division bench since, the judgement of the Supreme Court in *Sanjay Dalia* case was taken note of by the later division bench in *Hindustan Unilever Limited Ponds House v. S. Shanthi* [2021 SCC OnLine Mad 5428] and the law was reiterated.

Further, the Court refrained itself from considering the applicability of the principle of *forum conveniens* in since, it held it was not vested with the territorial jurisdiction to entertain the suit solely based on the situs of the branch office of the respondent/plaintiff. [*Asia match Company Private Limited v. P. Sundaram* – Order dated 22 November 2021 in Application No.3675 of 2021 in C.S. (Comm. Div.) No.14 of 2021, Madras High Court]

No breach of confidentiality when everything common is disclaimed as not proprietary, and what is left is different and not the same

In a suit for breach of confidentiality and for infringement in copyright, the Bombay High Court has set aside the ad-interim relief earlier granted to the plaintiff while also imposed a cost of INR 10 lakh on the plaintiff. The Court noted that the plaintiff, at the hearing, sought to project the argument that the defendant's product was ineffective and cannot deliver what it claims, though the suit had claimed infringement.

The dispute involved alleged copyright infringement by the defendant's product 'NOXGUARD' which claimed to produce nitric oxide releasing solutions. The plaintiff had claimed specific proprietary rights in the combination of the components of citric acid and sodium nitrite (used in production of nitric oxide) at a specific pressure and in a specific dosage

while also claiming uniqueness in the dual-chamber container, which combined the two components at the specific point and delivered an optimal concentration of nitric oxide.

Dismissing the plaintiff's Interlocutory application, the Court also noted that plaintiff had not shown either that the defendants used the dual-chamber release system, or the same ingredients as the Plaintiff. It noted that on the contrary, the plaintiff themselves claimed that the defendant's product cannot deliver nitric oxide and its own expert accepted that the two products were entirely different. It also noted that the disclosed information regarding the citric acid component was entirely redacted and it mentioned only an acid, while for the sodium nitrite component, the precise percentage amount was redacted, only the ingredient was mentioned. The High Court also observed that the plaintiff had not claimed any monopoly in the formation of nitric oxide and the claim to a proprietary dual chamber delivery system was also abandoned. [*SaNotize Research & Development Corp. v. Lupin Limited* – Judgement dated 21 October 2021 in Interim Application (L) No. 22810 of 2021 in Commercial Suit (L) No. 22803 of 2021, Bombay High Court]

Invisible use of trademark as keyword is also prima facie 'use' under Section 29 – Google cannot absolve itself from the liability of ensuring that the keyword is not an infringement of any trademark

The Delhi High Court has held that invisible use of trademark to divert the traffic from proprietors' website to the advertisers' / infringers' website shall *prima facie* amount to 'use' of the mark under Section 29 of the Trademarks Act, 1999, which includes Section 29(6) and 29(8) related to advertising. The Court noted that though as per Section 2(2) of the Trademarks Act, use of the mark shall be construed as use of printed or other visual representation in relation to the goods or services, but the legislature under

Sections 29(6), 29(7) and 29(8) expressly departed from the ordinary construction of the expression 'use' under the said Act to include instances to construe 'use' under Section 29. It was of the view that the invisible use of the mark can also infringe a trademark. It may however be noted that according to the Court, the fair use of trademark may not constitute infringement.

The plaintiff was aggrieved by the Ads Word program of the defendant (Google) under which an advertiser having Ads Word account could create, select, keywords based on which their advertisement showed up as a sponsored link thereby diverting the traffic from the plaintiff's website to the advertiser. It noted that keywords were selected by the advertiser on the basis of statistical information provided by Google and that the keyword was the registered mark of the plaintiff.

Relying upon its earlier decision the Court also observed that infringement is not merely visual representation of the product in bad light under the provision of Section 29(9) but can be caused by way of spoken use of the words. The Court also observed that various Courts in different decisions had held as wrong the use of trademarks as metatags without the consent of the proprietor. Further, drawing similarities and distinctions in the working of metatags and keywords, the Court noted that in case the Ads Word program was not there, same result could have been achieved by use of metatags which had already been held as infringement. It held that Google cannot absolve itself from the liability of ensuring that the keyword is not an infringement of trademark. The Court stated that *'once the search engine has been made aware of a registered trademark in a certain jurisdiction, it is incumbent upon the search engine to exercise a higher duty of care to ensure protection of the goodwill attached to such trademark'*.

The High Court in this regard also noted that Google restricts its investigation to Ad-text and Ad-title and not does it in respect of keywords in India, while carrying out investigations with respect to keywords also in various other jurisdictions including the European Union. [*DRS Logistics (P) Ltd. v. Google India Pvt. Ltd.* – Judgement dated 30 October 2021 in CS(COMM) 1/2017 & I.As. 21153/2011, 4474/2014, 2645/2020, 2646/2020, 7203/2020, Delhi High Court]

Copyrights – Assignee to copyright cannot grant license without being a copyright society

The Madras High Court has held that assignee of the copyright is not legally permitted to issue or grant license under the Copyright Act, 1957 without being a copyright society under the said Act as contemplated under its Section 33. Deliberating on the difference between the first and second proviso to Section 33(1), the Court held that the business of granting or issuing licenses in respect of any work in which the copyright subsists, can be undertaken only through a copyright society registered under Section 33(3).

The High Court was of the view that the right of an owner, in his individual capacity, to exploit a right by issuing a license remains untouched. However, in case of 'business' i.e., a commercial enterprise of issuing licenses, the law required it to be routed 'only' through a registered copyright society.

The Court also considered the background of the amendment made in the Copyright Act in 2012 which was to ensure that the business of issuing licenses in copyrights were routed only through copyright societies so that the royalties could be shared between the authors and composers and the owners of the copyright. Reliance was also placed, in this regard, on statement of the

Minister of Information and Broadcasting made on the floor of the Parliament while introducing the amendments to the Copyright Act in 2012.

Plaintiff's contention that by virtue of the assignment agreements executed in their favour by the owners of copyright, they have become the absolute owner of the copyright and has the right to issue licenses to any person, was thus not agreed with by the Court. According to the Court, Section 30 merely recognises the right of the owner to grant a license and does not make a distinction between individuals and business entities, a distinction which is at the heart of Section 33. Allowing the preliminary objections by the defendant, the Court also dismissed the suit and directed the plaintiff to pay costs to the defendants. [*Novex Communications Pvt. Ltd. v. DXC Technology Pvt. Ltd.* – Judgement dated 8 December 2021 in Civil Suit Nos. 407 and 413 of 2020, Madras High Court]

Patents – Enhanced solubility and bioavailability when can be taken as evidence of enhanced therapeutic efficiency

In a case where the defendant had sought to establish vulnerability of the suit patent to revocation on the ground of invalidity, the Delhi High Court has accepted enhanced solubility and bioavailability as evidence of enhanced therapeutic efficacy. The Court accepted the contention that the product 'Eltrombopag Olamine' ('EO') patented in IN 233161, by reason of its enhanced solubility and bioavailability, possessed enhanced therapeutic efficacy over the product 'Eltrombopag free acid' already patented in IN 213176 ('IN 176'). The High Court for this purpose distinguished the Supreme Court decision in the case of *Novartis AG v. U.O.I.* [(2013) 6 SCC 1] which had held that enhanced solubility and bioavailability can never be, by themselves, evidence of enhanced therapeutic efficacy. According to the High Court, they can,

but the onus to so establish would be on the person who so asserts.

The Court noted that the defendant had not denied the fact that the maximum plasma concentration of EO was thrice the plasma concentration of the Eltrombopag free acid which too enhanced the therapeutic efficacy of EO *vis-a-vis* the Eltrombopag free acid. Rejecting the challenge to the validity of a suit patent, the Court at the *prima facie* stage also noted that when combined with olamine, there is a much higher yield of Eltrombopag, insofar as bioavailability is concerned.

In respect of anticipation by prior claiming [Section 64(1)(a) of the Patents Act], the Court observed that the claim, whose validity is being challenged must be identical to the claim in the prior art, or of co-equal extent and amplitude. According to the Court, it is not permissible for the defendant to make out the case of vulnerability of the suit patent by cherry picking substituents from those suggested in the complete specifications in the prior art and substituting them at the appropriate sites in the Markush moiety as to arrive at the suit patent.

The Court observed that there is a difference between the broad coverage of a claim, based on its wording, and the coverage of the claim as would entitle it to patent protection under Section 48. It held that though the broad coverage of Claim 6 in IN 176 would also embrace EO, as a pharmaceutically acceptable salt of Eltrombopag, it could not be said that EO was claimed in Claim 6 of IN 176, as the wording of the claim read with the enabling disclosure contained in the complete specifications, did not lead one to EO.

The High Court also noted that the fact that, in the Form 27s which may have been filed in respect of the prior art, after the suit patent was granted, the product emerging from the suit patent was cited, cannot lead to a conclusion of anticipation by prior claiming. The claim that the suit patent IN 161 was vulnerable to revocation on the ground of obviousness, *vis-à-vis* Claim 6 in IN 176, as also the claim of anticipation by prior publication, were also rejected. [*Novartis AG v. Natco Pharma Limited* – Judgement dated 13 December 2021 in CS(COMM) 256/2021 & I.A. 6980/2021, Delhi High Court]



News Nuggets

No passing off by use of words 'Magical Masala' allegedly similar to 'Magic Masala', both used for same food product

The Supreme Court of India has on 29 November dismissed a Special Leave Petition

filed against the Madras High Court decision which had in turn dismissed a suit for alleged passing off by the defendant by use of the words 'Magical Masala' which were similar to the words 'Magic Masala' used by the plaintiff for the same product (instant noodles). It may be noted that the SLP was filed against the

decision of the Division Bench of the High Court [Decision dated 10 November 2020] which had upheld the Single-Judge Bench's decision [Decision dated 10 June 2020] holding that even though there was phonetic similarity between the word 'Magic' used by the plaintiff and the word 'Magical' used by the defendant, nevertheless they were incapable of being monopolised as they were not only laudatory but also common to the trade. The Appellate Bench had observed that both the words 'magic' and 'magical' are common to trade, more particularly, in the food industry. The dispute involved ITC Limited and Nestle India Ltd.

Mark 'AC Milan' of a football club cannot be registered for stationery and office supplies

The General Court of the European Union has confirmed that the sign representing the crest of the football club AC Milan cannot be registered internationally as a trade mark for stationery and office supplies. The opposition to its registration was filed on the basis of the German word mark 'Milan', earlier registered, designating, *inter alia*, and in substance, goods identical and similar to those referred to in the application of AC Milan football club. The Court observed that the element 'ac milan' constituted the dominant element of the mark applied for as the attention of the relevant public will not be focused on figurative element of the mark only. The Court in *AC Milan v. EUIPO* [Judgement dated 10 November 2021] was also of the view that only the reputation of the earlier mark, and not that of the mark applied for, must be taken into account in order to assess whether the similarity of the goods designated by the two marks was sufficient to give rise to a risk of confusion. Earlier, on the basis of invoices and advertising material, the Court concluded that

the earlier mark had been put to genuine use in Germany.

Use of 'upGrad' as keyword in Google Ads Word Program by competitor is *prima facie* wrong

The Delhi High Court has granted *ad interim* relief against use of the word 'upGrad' by the defendant as a key word through the Google Ads Word Program or any other ad word/key word program. The plaintiff had alleged that the defendants had availed the Google Ads services provided by Google by bidding for the keyword 'upGrad' which was a clear infringement of the registered mark of the plaintiff within the meaning of Section 29(6) read with Sections 2(2)(b), 2(2)(c)(ii) and 29(9) of the Trademarks Act, 1999. As a result, on a person's typing the word 'upGrad' on the Google search engine, the defendants' advertisement would pop up, which would also lead to an inevitable impression of association between the activities of the defendants and the registered mark of the plaintiff. The High Court in its decision dated 29 November [Upgrad Education Private Limited v. Interviewbit Technologies Private Limited] issued notice, returnable before the Court on 23 February 2022.

Trademark registration of Agatha Christie title 'And Then There Were None' allowed in classes 9, 16 and 41

The Delhi High Court has on 8 December 2021 directed the Registrar of Trade Marks to register the mark 'And Then There Were None' under the classes 9, 16 and 41 of the Schedule to the Trademarks Rules, 2017. The Registrar had earlier rejected the registration of the mark finding that it lacked distinctiveness. The Court observed that the mark was not descriptive of the services in respect of which its registration was sought and

that it or any other deceptively similar mark was not registered or was in use in said classes. Setting aside the impugned order of the Registrar, the Court noted that the order impugned had no finding that the mark was not capable of being represented graphically or was incapable of distinguishing the services being provided.

The High Court in the case *Agatha Christie Limited v. Registrar of Trade Marks* also observed that absent any of the circumstances as listed out in Sections 9, 11 and 13 of the Trademarks Act, 1999, a request for registration of a trademark cannot be refused. It noted that name was the title of the most well-known work of fiction written by Agatha Christie, and was also capable, *prima facie*, of creating an association between the name and the appellant, which was a company established by Agatha Christie herself.

‘Cinzitas’ derived from ‘Cinzan’ and not from generic salt ‘Cinnarizine’

The Delhi High Court has restrained the defendants from using the mark ‘Cinzitas’ for

pharmaceutical and medical preparations, finding it to be violating the rights of the plaintiff in the mark ‘Cinzan’. The Court observed that ‘CINZ’ in the proposed name of defendant’s ‘Cinzitas’ was derived from the name of the plaintiff’s product ‘Cinzan’ and not from the salt ‘Cinnarizine’. It observed that the defendants did not explain as to how they had also used the same four letters i.e., ‘CINZ’, to name their product. The defendant had pleaded that ‘CINZI’ was derived from the generic salt ‘Cinnarizine’ and ‘TAS’ was taken from the name of the defendant No.1 ‘TAS Med India Pvt. Ltd.’. The Court also found it relevant to note that the defendant had known the plaintiff’s product for long and had earlier introduced its product in the name of ‘Cinzine’, which was deceptively similar in structure and in phonetics, with the plaintiff’s trademark ‘Cinzan’. Noting that the products were for the same illness, the High Court in *FDC Limited v. TAS Med (India) Private Limited* [Judgement dated 13 December 2021] held that deceptive similarity will lead to confusion.

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