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An e-newsletter from  
Lakshmikumaran & Sridharan, India

December 2022 / Issue-135

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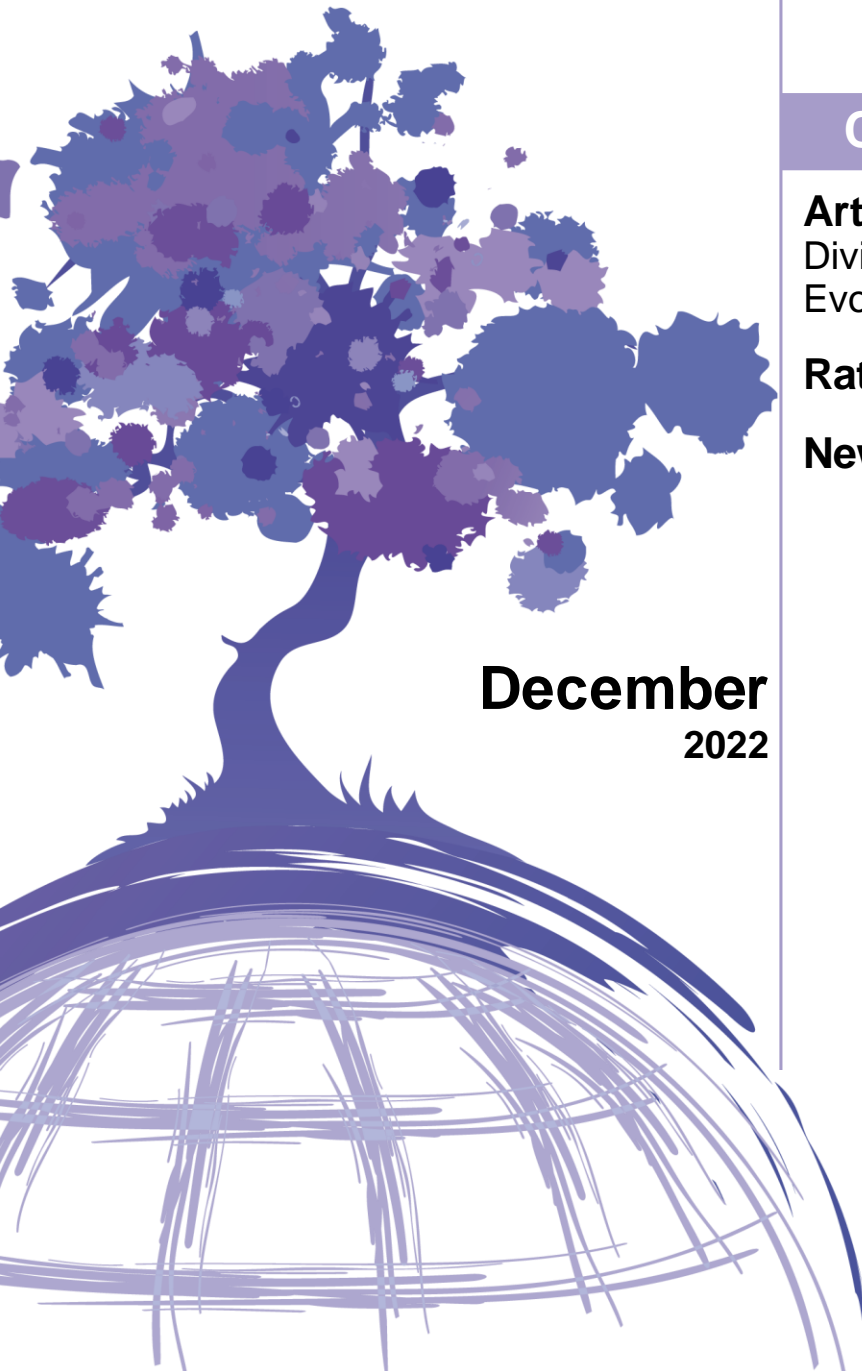
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**December**  
2022





## Article

### Divisional Applications in India: Evolving jurisprudence

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A statutory prerequisite for a divisional patent application to be valid is the presence of a plurality of inventions in the parent application. In India, the jurisprudence in this regard has evolved through decisions such as in *Esco Corporation v. Controller of Patents & Design* decided on October 27, 2020<sup>1</sup> by the erstwhile Intellectual Property Appellate Board (IPAB) and the recent decision of the Delhi High Court ('Court') in *Boehringer Ingelheim International GMBH v. The Controller of Patents & Anr.* decided on 12 July 2022<sup>2</sup>. The presence of plurality of invention is the legal basis for dividing a patent application in US<sup>3</sup> and EP<sup>4</sup> as well.

In India, a divisional application under Section 16 of the Patents Act, 1970 ('Act'), may be pursued to overcome an objection by the Patent Office on the unity of invention or voluntarily by the Applicant if the claims of the parent Application are directed to more than one invention. In cases where the divisional application is voluntarily pursued in exercise of the Applicant's right under Section 16 of the Act, the requirement in India appears relatively more stringent in respect of the Applicant, especially in the light of recent decisions<sup>1,2,5</sup>. The burden to show that a plurality of inventions exists, in such cases, lies with the Applicant. Not only that, in India, such divisional applications, in practice, will

be considered valid only if (i) a plurality of invention exists in, not just the specification, but the claims of the parent (first mentioned) application; and (ii) the claims of the divisional are not the same as that of the first mentioned application, i.e., not already considered and examined during prosecution of the first mentioned application. Therefore, the plurality of invention must be gleaned from a reading of the claims of the parent application. In this regard, the laws in other jurisdictions are relatively different. In EP, for example, the claims of a divisional application need not be limited to subject-matter already claimed in claims of the parent application<sup>6</sup>. However, the subject-matter may not extend beyond the content of the parent application as filed<sup>7</sup>.

The rationale for such stringent interpretation was clarified in the decision of *Boehringer Ingelheim International GMBH v. The Controller of Patents & Anr.*<sup>2</sup>, where a divisional application, filed *suo moto*, was held invalid. The reason for invalidity, in this case, was the absence of a plurality of inventions in the as filed claims of the parent application, and that the claims of the divisional application did not find its root in the as filed claims of the parent application. The Court held that divisional applications cannot be allowed merely on the basis of disclosure in the complete specification, without such an invention being claimed in the parent application as it

<sup>1</sup> OA/66/2020PT/DEL /

<sup>2</sup> C.A. (COMM.IPD-PAT) 295/2022 & I.As.10369-70/2022

<sup>3</sup> 35 U.S.C. 121 Divisional applications

<sup>4</sup> Art. 82, Rule 36, The European Patent Convention; Ch. 5.8 Divisional applications, European Patent Guide.

<sup>5</sup> *Nippon A & L Inc. v. The Controller of Patents* decided on July 5, 2022; C.A.(COMM.IPD-PAT) 11/2022

<sup>6</sup> Ch. IX, 1.4. Examination of a divisional application, Guidelines for Examination

<sup>7</sup> Art. 76(1), The European Patent Convention

would defeat one of the fundamental rules of patent law, i.e., ‘*what is not claimed is disclaimed*’.

The Applicant, in this case, amended the claims in the parent application directed to method or use to products (medicaments or combinations) during prosecution, which were later pursued in the divisional application just before the refusal of the parent application. While the refusal of the parent application was mainly based on lack of novelty and inventive step of the invention, the claim amendments of ‘use’ claims to ‘product’ claims for a combination medicament of DPP-IV inhibitors along with other antidiabetics, later pursued in the divisional application, were held to be not permissible under Section 16 and under Section 59 of the Act. Here, since the product claims pursued in the divisional application were not at all present in the claims of the parent application, any claims that could have been made towards the product were considered as disclaimed by the Applicant. Therefore, the divisional application, thus filed was held to be invalid.

Based on this position in law, an Applicant for whatever reasons, for example: costs, decides to claim limited subject matter is understood to have relinquished all such subject matter, that is not claimed, to the public domain. Therefore, for an Applicant in strategizing on how to pursue, for instance, multiple inventions that may be arising out of a single inventive platform, it now, more than ever, becomes crucial to limit the disclosures in the specification only to subject matter that the Applicant wishes to pursue in claims.

Further, in order to bring uniformity of practices and in the best interest of justice, the erstwhile IPAB in adjudicating various cases, laid down certain principles that are to be adhered to while dealing with divisional applications, which include the following:

- (i) filing of divisional application can be done either by the Applicant (*suo-moto*) or to remedy the objection raised by the Controller on the ground of plurality of invention,
- (ii) existence of plurality of invention in the parent application is the *sine qua non* for filing a divisional application,
- (iii) the claims of divisional application shall have their root in the first mentioned (parent) application, and
- (iv) the application needs to be divided only on the ground of ‘plurality of invention’ as envisaged under Section 16 of the Act. If any claim is held to be non-patentable due to any other provisions of the law such as the requirements under Section 3 of the Act or otherwise, it would not be proper to file a divisional application for such claims.
- (v) for division of application, the parent application must exist. Therefore, no divisional application can be filed if the parent application has matured to a grant or is either “deemed to be abandoned” or “withdrawn” or “refused”.

In ascertaining plurality of invention, the IPAB pointed out that the mere existence of claims in respect of the various categories of claims towards the various embodiments should not be construed as absence of unity of invention, unless such categories are not linked by a single inventive concept. The IPAB, in *Esco*<sup>1</sup>, in addressing the question of how unity of invention can be defined, was of the view that determination of unity of invention is not affected in the manner of claiming and it shall be made without regard to whether the invention is claimed in separate claims or as alternatives within a single claim. Therefore, an application including

an invention or a group of inventions for eg: in various categories, that are not linked so as to form a single inventive concept is understood to constitute a plurality of invention.

## Conclusion

Therefore, as per the jurisprudence around divisional applications, in exercising the

Applicant's right to file a divisional application, the principles laid out by the Courts may be relied upon for guidance in strategizing national phase entries and divisional applications thereon.

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## Ratio decidendi

### Patents – Doctrine of Equivalents applicable for process/method patents as well

In an alleged infringement of process/method patent, the Delhi High Court has held that the essential elements of the given process; the necessary steps of that process and the manner in which the essential elements interact at each step must be substantially similar to the patented process or method to sustain a claim of infringement.

The Court in this regard also rejected the contention that the Doctrine of Equivalents is only relevant in case of a product patent and not a process patent. According to the Court, if an innovation – whether it is a product or a process – is pirated, an action to prevent such infringement cannot fail solely because the offending product or the process has certain minor and insubstantial variations, or differences as compared to the patent.

It was of the view that the triple test of substantially the same function, in substantially the same way and to yield the same result, as applicable in case of product patents, would have to be suitably adapted as achieving substantially the same result would clearly not be relevant in case of process patents. [*FMC Corporation v. Natco Pharma Limited* – Judgement dated 5 December 2022 in FAO(OS) (COMM) 301/2022, Delhi High Court]

### Trademarks – No passing off in use of word 'VOGUE' for an institute of fashion technology

In a case involving alleged passing-off of the word 'VOGUE' by the Defendant in respect of an Institute of Fashion Technology, the Karnataka High Court has allowed the appeal initiated by the Appellant, who is using the same with respect to fashion magazine. The decision was against the Trial Court's decision restraining the Defendant from using the mark/word.

The eCourt in this regard observed that the fashion magazine of the Appellant/Plaintiff was not subscribed or read by large section of the general public and that the kind of purchasers are likely to know that the Plaintiff's magazine is involved only in publishing and not running any institute.

Similarly, the Court also observed that the persons who would join the Defendant's institute would also have knowledge about the fashion world. The High Court was of the view that taking into consideration the degree of care that an average student is likely to exercise, it is highly unlikely that they would confuse the institute as one belonging to the Plaintiff. It noted that there was no evidence let in by the Plaintiff to show otherwise. [*M.M. Kariappa v. Advance Magazine Publishers, Inc.* – Judgement dated 10 November 2022 in Regular First Appeal No. 106 of 2015, Karnataka High Court]

### **Trademarks – Argument of 'family of marks' available only to a Plaintiff**

Quoting with approval the book *McCarthy on Trademarks and Unfair Competition*, the Delhi High Court has observed that the doctrine of 'family of marks' is an argument available only to a Plaintiff asserting its rights and not to a Defendant to prove its defence against a Plaintiff's intervening rights. The Court in this regard observed that where the Plaintiff has, in spite of the defendant having a 'family of marks', established goodwill in a mark that may even be forming a part of the 'family of the marks' of the Defendant, the Defendant cannot later adopt a mark deceptively similar to the that of the Plaintiff, relying upon its 'family of marks'.

The High Court was adjudicating on a dispute involving use of word 'FOLZEST' by the Defendant when the Plaintiff was using the word 'FORZEST' – both for medicines though for different ailments.

The Defendant had argued that they had family of 'ZEST' marks as were using the word in number of other marks. However, its assertion that it was selling more than sixty-five different products and out of these, eighteen had 'ZEST' as a predominant feature of the mark/name of the medicinal goods, was dismissed by the Court while it stated that the defendant by an assertion alone cannot claim a right to adopt a deceptively similar mark to that of the plaintiff, especially where the mark of the plaintiff was in long use. It was of the view that the Defendant would have to prove exclusivity over the mark 'ZEST' in all its variants to succeed in its defence.

Further, while affirming its *ad interim* relief, the Court cited various precedents and reiterated that in medicinal goods, the right of not only the private litigants but also public interest has to be kept in mind, and, in fact, be given prominence. The marks were also found to be deceptively similar to each other. [*Sun Pharmaceutical Industries Ltd. v. DWD Pharmaceuticals Ltd.* – Decision dated 22 November 2022 in CS(COMM) 328/2022, Delhi High Court]

### **Mark 'Dhola Tharu' is deceptively similar to essential part of label mark using words 'Dhola Maaru'**

The Delhi High Court has restrained the Defendant from using the mark 'Dhola Tharu' observing that the essential part of the Plaintiff's label mark using the words 'Dhola Maaru' was *prima facie* deceptively similar. The Court noted that there was visual, structural and phonetic similarity, coupled with the fact that the goods were identical (country liquor), class of purchasers/consumers of the two products was also likely to be same/overlapping and trade channels were common. The Court also stated that there was likelihood of confusion in the mind of the purchaser with average intelligence and imperfect recollection that the product of the Defendant emanates from the Plaintiff.

Further, the Court rejected the Defendant's contention that Plaintiff cannot assert a right to exclusive use of the part of the word mark 'Dhola Maru' in Hindi, only because it has registration in the label mark, as a whole. It observed that looking at the label marks, and going by the colour contrast to the background, font size, stylized writing etc., the word 'Dhola Maru', *prima facie*, formed an essential, key and dominant part of the registered label mark of the Plaintiff. It also rejected the Defendant's plea that words 'Dhola Maaru' were commonly used in the State of Rajasthan as a part of its cultural heritage and were inherently incapable of serving as a trademark. The Court reiterated that when a common word is applied in a context where it has no co-relation to the product in question, it is termed an 'arbitrary' mark and that arbitrary marks enjoy a high degree of protection without proof of secondary meaning.

On the contention of territorial jurisdiction, the Court was of the view that since the case was in the nature of a *quia timet* action i.e., there was credible and imminent apprehension of the threat of Defendant selling the products in Delhi, it has territorial jurisdiction to decide. The High Court in this regard also noted that there was pan-India application by the Defendant for trademark registrations, the principal place of Plaintiff's business was Delhi and that there was absence of subordinate or branch office of the Plaintiff in Jodhpur, where the Defendant was located. [*Vintage Distillers Limited v. Ramesh Chand Parekh*, Judgement dated 16 November 2022 in CS(COMM) 292/2022, Delhi High Court]

### **Mark 'HAIR SPA' describes the characteristics of a product and is a common descriptive expression**

The Delhi High Court has allowed an appeal setting aside the order passed by the Trial Court restraining the Appellants from using the

trademark of the Respondents i.e., 'HAIR SPA'. The Court was of the *prima facie* opinion that the trademark 'HAIR SPA' is descriptive and the expression is commonly used in the trade for products that are used for the treatment and nourishment of hair. The Court added that 'HAIR SPA' was not a coined word and is merely a combination of two popular English words 'HAIR' and 'SPA' juxtaposed or placed side by side.

Applying the principles explicated in *Marico Limited v. Agro Tech Foods Limited* and *Cadila Health Care Ltd. v. Gujarat Co-operative Milk Marketing Federation*, the Court was of the view that the expression 'HAIR SPA', which only describes the characteristics of a product and is a common descriptive expression, is incapable of being distinctive. According to the Court, the use of the expression 'HAIR SPA' would immediately direct a person with average intelligence and prudent mind to a treatment pertaining to hair and hence the descriptive nature of the mark can hardly be disputed.

Accordingly, the Court opined that the term 'HAIR SPA' despite being registered in favor of the Respondent, is common to trade and was used by the Appellant as a descriptor and not as a trademark. The Court in this regard also noted that after comparing the use of expression 'HAIR SPA' as a descriptor with the registered trademark 'BERINA' along with the trade dress, colour combination, etc. which were completely different, it cannot be said that Appellants had an intent to misrepresent or that there was any likelihood of confusion as to the trade origin. [*Pornsricharoenpun Co. Ltd. v. L'Oreal India Private Limited* - Judgment dated 14 November 2022 in FAO IPD 43/2021, Delhi High Court]



## News Nuggets

### Trademarks 'SITARED' and 'SITARA-D' are not deceptively similar

The Delhi High Court has held that, *prima facie*, marks 'SITARED' and 'SITARA-D' cannot be held to be deceptively similar to each other, either phonetically or visually. The High Court in this case though took note of the Supreme Court decision in the case of *Cadila Health Care Ltd.*, it observed that since the two marks in question were not phonetically or visually similar; the subject-marks were based on their active ingredients, which were generic and cannot be appropriated by any party; and the packings of the medicines were different, *prima facie*, a case of passing off was not made out by the plaintiff. The application for an *ad-interim* order of injunction against the use of the mark 'SITARA-D' was hence dismissed by the Court in *Sun Pharma Laboratories Ltd. v. Intas Pharmaceuticals Limited* [Decision dated 22 November 2022].

### Trademark 'Shopibay' is phonetically similar to 'ebay'

Holding that the word 'SHOPIBAY' is phonetically similar to word 'ebay' used by the Plaintiff, the Delhi High Court has held that the use of the word 'SHOPIBAY' is likely to deceive unwary consumer of the association of these companies with the Plaintiff. The High Court also observed that 'SHOPIBAY' was clearly intended to ride on the goodwill and reputation of the marks of the plaintiff, and not only seem to take unfair advantage of the mark of the plaintiff's reputation and goodwill,

but also deceive unwary consumers of their association with the plaintiff. The Court in *Ebay Inc v. Mohd. Waseem T/AS Shopibay* [Order dated 17 November 2022] also noted that domain names [www.shopibay.com](http://www.shopibay.com) and [www.myshopibay.com](http://www.myshopibay.com) of the defendant were also deceptively similar to that of the plaintiff. It also noted that the plaintiff was able to show its goodwill and reputation in the 'eBay' not only in India but internationally.

### Trademark and automobile safety – High Court restrains use of mark 'M.G.' for automobile accessories

Observing that cars under the mark 'M.G.' were being sold by the Defendants in India on a large scale for the past 3-4 years, the Delhi High Court has restrained the Plaintiff from using the mark 'M.G.', 'M.G.I', 'M.G. (device)' or any other confusingly similar mark in word, logo or device form in respect of automotive parts or accessories. The High Court in this regard held that since the Plaintiff was selling automobile accessories which also concerned the safety of automobiles and passengers using those automobiles, even remote chances of confusion ought to be obviated between the products of the parties. According to the Court, as the marks in question are identical in nature and fall in an identical class, confusion is bound to occur. The Court in *H.S. Sahni v. Saic Motor Corporation Limited* [Decision dated 22 November 2022] also noted that there was serious doubt as to the user claimed by the Plaintiff.

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