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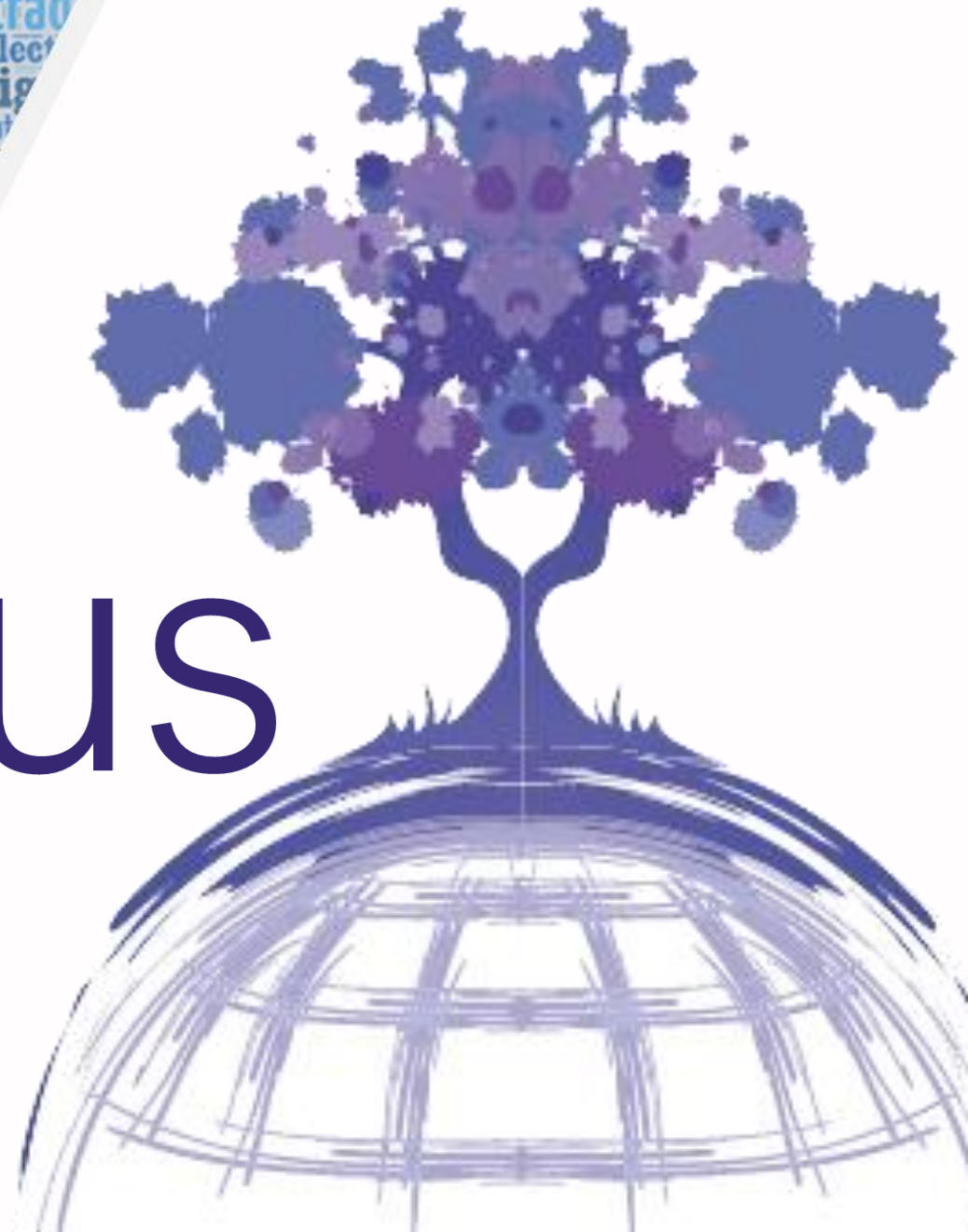
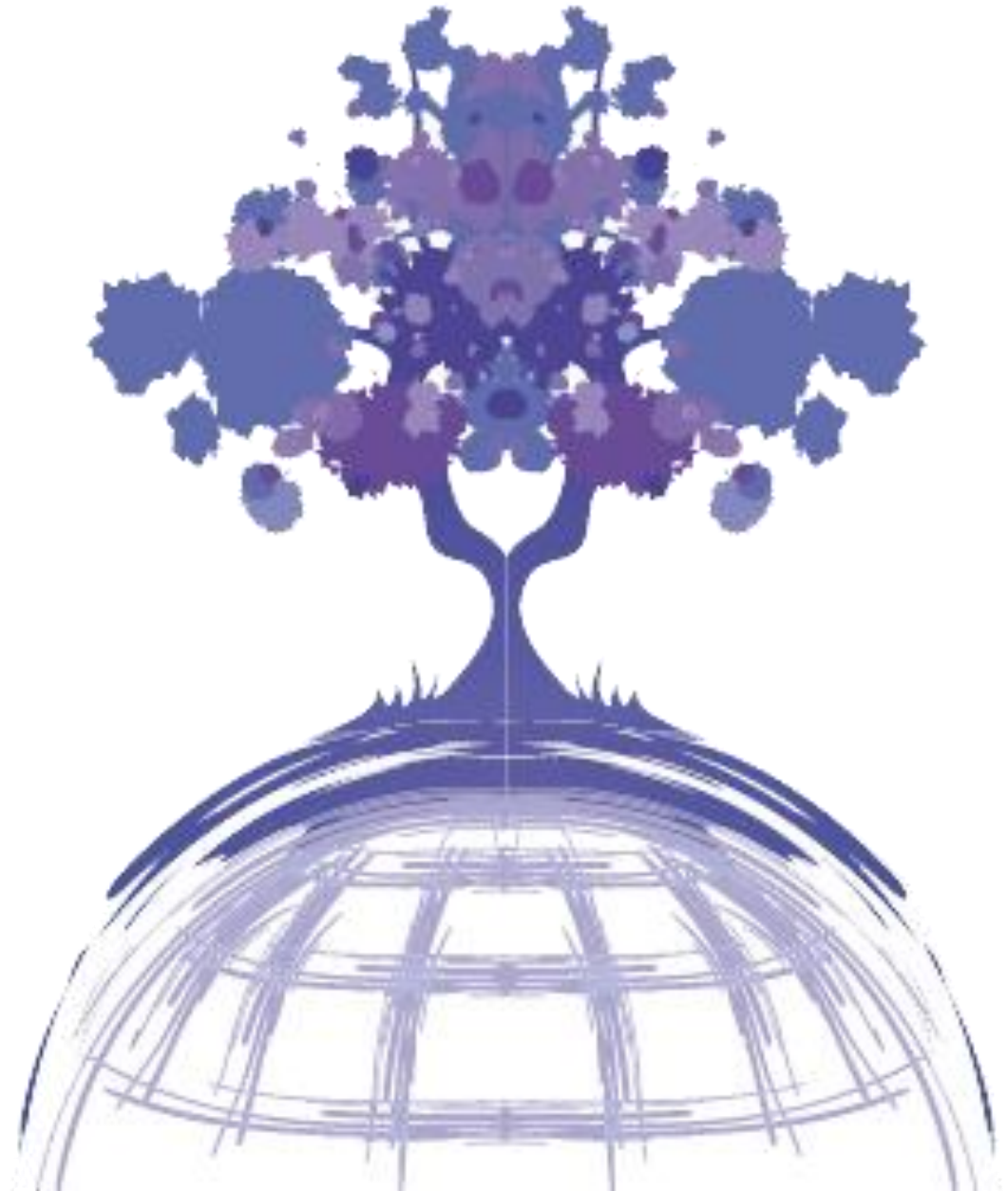


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Article

Disclaimers – A credible way of amendment in patent claims and specification

By Dr. P. Mahalakshmi and T. Srinivasan

One of the permissible ways of amendments to claims and/or specification is to incorporate suitable disclaimers during the patent prosecution and at the post grant stage. The article in this issue of IPR Amicus aims to bring down the perspectives of the use of disclaimers as a provision to amend claims and/or specification. It focusses on provisions available under Section 59 of the Patents Act, 1970 and a glimpse on such provisions in major jurisdictions such as US and EU that are of greater interest. According to the authors, disclaimers shall be allowed provided they comply with the requirements pertaining to patentability, clarity, conciseness, support and sufficiency as set forth in each of the jurisdiction. They also state that the use of disclaimers is not forbidden but the disclaimers need to be prudently used to satisfactorily protect the invention and to hold a valid patent.

Disclaimers – A credible way of amendment in patent claims and specification

By Dr. P. Mahalakshmi and T. Srinivasan

Introduction

One of the permissible ways of amendments to claims and/or specification is to incorporate suitable disclaimers during the patent prosecution and at the post grant stage. This article aims to bring down the perspectives of the use of disclaimers as a provision to amend claims and/or specification. For this purpose, the present article focusses on provisions available under Section 59 of the Patents Act, 1970 and a glimpse on such provisions in major jurisdictions such as US and EU that are of greater interest.

Indian position:

Section 59 of the Patents Act, 1970 ('Act') provides,

*“(1) No amendment of an application for a patent or a complete specification or any document relating thereto shall be made except by way of **disclaimer**, correction or explanation...”*

Disclaimers in patents serve to limit the scope of protection conferred by a patent. Disclaimers include both positive disclaiming and/or negative claiming. Disclaimers are used to

define the boundaries of the invention and to provide clarity to the scope of the claimed invention. Such disclaimers are included while amending the claims before the Controller during prosecution of the Application, or High Court in the post-grant stage, to overcome objections and to distinguish from the cited prior arts.

Ayyangar Committee report provides under 'Notes on the Clauses of the Patents Bill, 1953' - 'Clause 14 and 15 – Order of refusal or amendment of application in certain cases' in para 386, page 135 [SCC Online (2013)] under “14. *Refusal of application in certain cases,*

.....

(3) If it appears to the Controller that any invention in respect of which an application for a patent is made might be used in any manner contrary to law, he may refuse the application, unless the specification is amended by the insertion of such disclaimer in respect of that use of the invention or such other reference to the illegality thereof as the Controller thinks fit.”

Guidelines of the Ayyangar Committee report also mentions in Chapter VI

“34. Amendment of application or specification by Controller- An applicant or a patentee may at any time, by request in writing lodged at the Patent Office and accompanied by the prescribed fee, seek leave to amend his application, or specification, including drawings, if any, by way of disclaimer, correction or explanation, stating the nature of, and the reasons for, the proposed amendment”.

35. Amendment of specification by the court.—In any suit for infringement of a patent or proceeding before a court for the revocation of a patent, the court may by order allow the patentee to amend his specification by way of disclaimer, correction or explanation in such manner, and subject to such terms as to costs, advertisement or otherwise, as the court may think fit”

Thus, the provisions in the Act as guided by the Ayyangar committee report allow the Applicant/ patentee to amend the claims to include disclaimer to clarify the scope of the claimed invention in view of objections and/or prior arts.

In an Order by Single Judge of the Delhi High Court (DHC) in the matter of *AGC Flat Glass Europe SA v. Anand Mahajan and*

Others, [2009 SCC OnLine Del 2826] (**‘AGC Order’**) it has been observed in para 22

“..... It is settled law that if an amendment is put forward to overcome a possible objection to validity based upon a prior publication it may be relevant to consider whether the amendment propounded meets the objection arising out of such prior publication..... in Baker Perkins Ltd.’s Application, (1958) RPC 267 and AMP Incorporated v. Hellerman Ltd., (1962) RPC 55 it has been observed that amendments which limit the scope of the specification to a sub-combination which was within the original claim would be a disclaimer (which can be allowed), and the absence of an appendant claim in the original document to such sub-combination cannot of itself be a reason for refusing the amendment.”

Therefore, the AGC Order clearly specifies that the amendment by way of disclaimer can be allowed, explicit recitation of disclaimer in the specification may not be required to be present, and further, absence of the same may not be used as a reason for refusal of the amendment.

The AGC Order also clarifies that the amendments should be in clarificatory or elaborative manner and shall not exceed the scope of the claimed invention before the amendment.

Thus, in use of such disclaimers the claims are narrowed or crystallized, delimits the scope of the invention, explains exact scope of invention and further may exclude the unclaimed invention explicitly.

The findings by the Single Judge in the AGC Order further confirmed that amending the claims by way of disclaimers is allowed, and the same is stated in para 35 of the order,

“.....the present amendment is merely a clarificatory/elaborative one and does not alter the scope of the invention. At best, even if the defendants’ objections are accepted, the said amendment appears to be a disclaimer which also cannot come in the way of permitting the amendment and in fact, the same rather support the amendment.”

Thus, the Single Judge in the AGC Order confirmed that the amendments made were clarificatory one and did not attract the proviso of Sections 58 and 59 of the Act.

The AGC Order under Para 26 provided ‘disclaimer doctrine’ which entitled a patent right holder to delimit the scope of the claims by narrowing down to its inconvenience, in a way which makes the amended claims not inconsistent with the claims in the original specification. This also recognized the

recourse of disclaimers by the right holders to clarify the scope of the patents when challenged with invalidity of the patents.

The another Single Judge Order of the Delhi High Court in the matter of *Nippon A and L Inc v. Controller of Patents*, [2022 SCC OnLine Del 1909] (**‘Nippon Order’**) at para 40 elaborates on Section 59(1) as follows:

“40. A perusal of Section 59(1) shows that an amendment of an application, specification or any document related thereto would be permissible only if the following conditions are satisfied:

- (i) the amendment has to be by way of disclaimer, correction or explanation;*
and
- (ii) the amendment has to be for the purpose of incorporation of actual facts;*
and
- (iii) (a) the effect of the amendment ought not be to amend the specification to claim or describe any matter which was not disclosed in substance or shown in the originally filed specification;*
and

(iv) (b) the amended claims have to fall within the scope of claims as originally filed.”

Therefore, the Single Judge in the Nippon Order para 41 summed up the above conditions and held that any amendment qualifying all above categories are appropriate and shall be allowed.

The Nippon Order also referred to *Konica* case (*Konica/Sensitising, 1994 EPOR 142*), wherein the Appellate Board categorically held that the conversion and the change in category of ‘product by process’ claims to ‘process’ claims was clearly admissible and the applicant had given up (disclaimed) the claim for absolute product protection and had limited the claims significantly. The Nippon Order further mentioned that, if the amended claims define any ‘new’ features, hitherto not defined in the body of the claims, then such amendments shall not be allowed but those that are clarificatory or disclaim earlier claimed features shall be allowed. Additionally the Nippon Order at para 58 also pointed out to the position of law in *Sulphur Mills Ltd. v. Dharamaj Crop Guard Ltd* (2021 SCC OnLine Del 3874) which made an observation

“.....It is usual for patent applicants to edit, amend, modify and vary the claims during the examination and opposition process. So long as the amendments sought are

within the scope of the claims originally filed, no adverse conclusion can be drawn on the basis of the said amendments”.

In the Nippon Order the Single Judge had to decide on the matter of whether the amendment made by the Appellant therein was by disclaiming the product portion of the claims, in view of the objections raised by the patent office, thus disclaiming a product was under question. However, the DHC in the Nippon Order held that the disclaiming a product from a product by process claim did not exceed the scope but delimited the scope and hence was allowed.

Observations made from the above matters clearly provides guidelines to the Indian Patent Applicants that the amendments can be made by way of disclaimer to not only provide clarity but also to overcome the objections raised, however the amendments should not exceed the scope of claimed invention. Further, the disclaimer could be in the form of negative limitation as well. However, the Indian Patent Office is hesitant to consider such negative limitations. The observations from said matters also allow the Patent Applicants to use words or phrases as disclaimers that may not be exactly present in the specification, however such disclaimers should not dilute or modify the technical

contribution of the invention and the original invention as disclosed should remain intact.

American position

In the United States of America (US) the use of disclaimers are described as negative limitations, and Section 2173.05(i) [R-07.2022] of The Manual of Patent Examination & Procedure (MPEP) provides the guidelines to use disclaimers. MPEP states that there is nothing inherently ambiguous or uncertain about a negative limitation, however the limitations shall comply with the requirements of 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA) in Appendix-L of MPEP. Negative limitations are added in claims to recite absence of a feature and often phrases such as 'excluding', 'without', 'absence of' and so forth are used to define such limitations. However, the disclaimers should be in such a way that the claims are clearly distinct as to what was invented and should not focus on what was not invented. The presence of support for use of such limitations must have basis in the specification, and determination of the sufficiency of presence of such support may not be straightforward.

United States Court of Appeals (Federal Circuit) (USFC) while deciding matters, insist on reading disclosures and disclaimers from the context and the knowledge of those skilled in the art. In *Santarus, Inc. v. Par Pharmaceutical, Inc.*, 694 F.3d

1344, 1350-51 (Fed. Cir. 2012) before the USFC, it was stated that negative claim limitations are adequately supported when the specification described a reason to exclude the relevant limitation but did not hold that a specification must describe a reason to exclude a negative limitation. The USFC in deciding the matter of *Inphi Corporation v. Netlist, Inc.*, 805 F.3d 1350, 1356-57, 116 USPQ2d 2006, 2010-11 (Fed. Cir. 2015), held that, the negative claim limitation that met the requirements of 35 U.S.C. 112 paragraph 1 MPEP, supported by substantial evidence, properly described, and alternative features were sufficient to satisfy the written description standard under 35 U.S.C. 112 for negative claim limitations. Thus, by way of the above Orders the USFC affirmed the practice of use of disclaimers to overcome objections and to distinguish from the prior art. Therefore, far by it could be observed that MPEP holds that any claim containing a negative limitation which does not have basis in the original disclosure ought to be rejected as failing to comply with the written description requirement yet embraces a stature "*that there is nothing inherently ambiguous or uncertain about a negative limitation*".

European Patent Office (EPO) position

While India and US provisions allow the Applicants to use negative limitations during prosecution, EPO admits the use of

disclaimers in the original claims/specification as well as during prosecution for the purpose of amendments.

The word 'disclaimer' is defined as an amendment to an already existing claim resulting in the incorporation of a 'negative' technical feature (Decision of Technical Board of Appeal 3.3.6 dated 17 September 2001 - T 323/97 - 3.3.6 [Oj EPO 2002, 476]).

Article 123(2), Rule 4, (4.1 & 4.2) of European Patent Convention (EPC) provides use of disclaimers in the application as originally filed and also those disclaimers not disclosed in the application as originally filed. EPO guidelines are amply clear which state that *"Negative features help to define the claimed invention in the same way as positive ones, and must be examined on the same basis. In other words, they may confer novelty and, like positive features, are assessed as to their relevance to inventive step"*. However, such limitations shall also confer to the requirements stated under Article 84 of EPC.

During prosecution, in order to restore novelty due to a prior art identified by patent office or by accidental anticipation, disclaimers to claims may be added to limit the scope of the invention and to exclude a technical feature not disclosed in the application. However, EPO also demarcates the unallowable disclaimers which were added to exclude non-

working embodiments, as a remedy to insufficient disclosure, to make a technical contribution, and to overcome inventive step rejection. The disclaimers shall not limit more than necessary to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.

PCT-EPO Guidelines Part-F Chapter IV, Rule 4.19 also defines that the limitations should be clear as to what is excluded by means of the disclaimer. Further the guidelines permit use of one or more disclaimers however must also fully comply with the clarity and conciseness requirements of Article 6 EPC.

In the Decision of the Board of Appeal of the EPO in the matter *PPG Industries Ohio v. Saint Gobain Glass France* [G 0001/03], it was decided that

"An amendment to a claim by the introduction of a disclaimer may not be refused under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed."

The order also reinstated that the disclaimers shall be allowable to restore novelty over known or accidental anticipation, and to exclude subject matter excluded from patentability non-technically.

Based on said Decision, Article 123(2) EPC, 1.7.3 (e), provides guidelines on clarity requirements in drafting disclaimers. This states that the disclaimers are also dealt in same manner as the claims, hence the disclaimers should meet the clarity and conciseness requirements set forth under Article. 84 EPC. Also, a plurality of disclaimers may put an unreasonable burden on the public to find out what was protected and what was not protected. Thus, the disclaimers should be clear from the specification for what was protected and why the disclaimers were introduced.

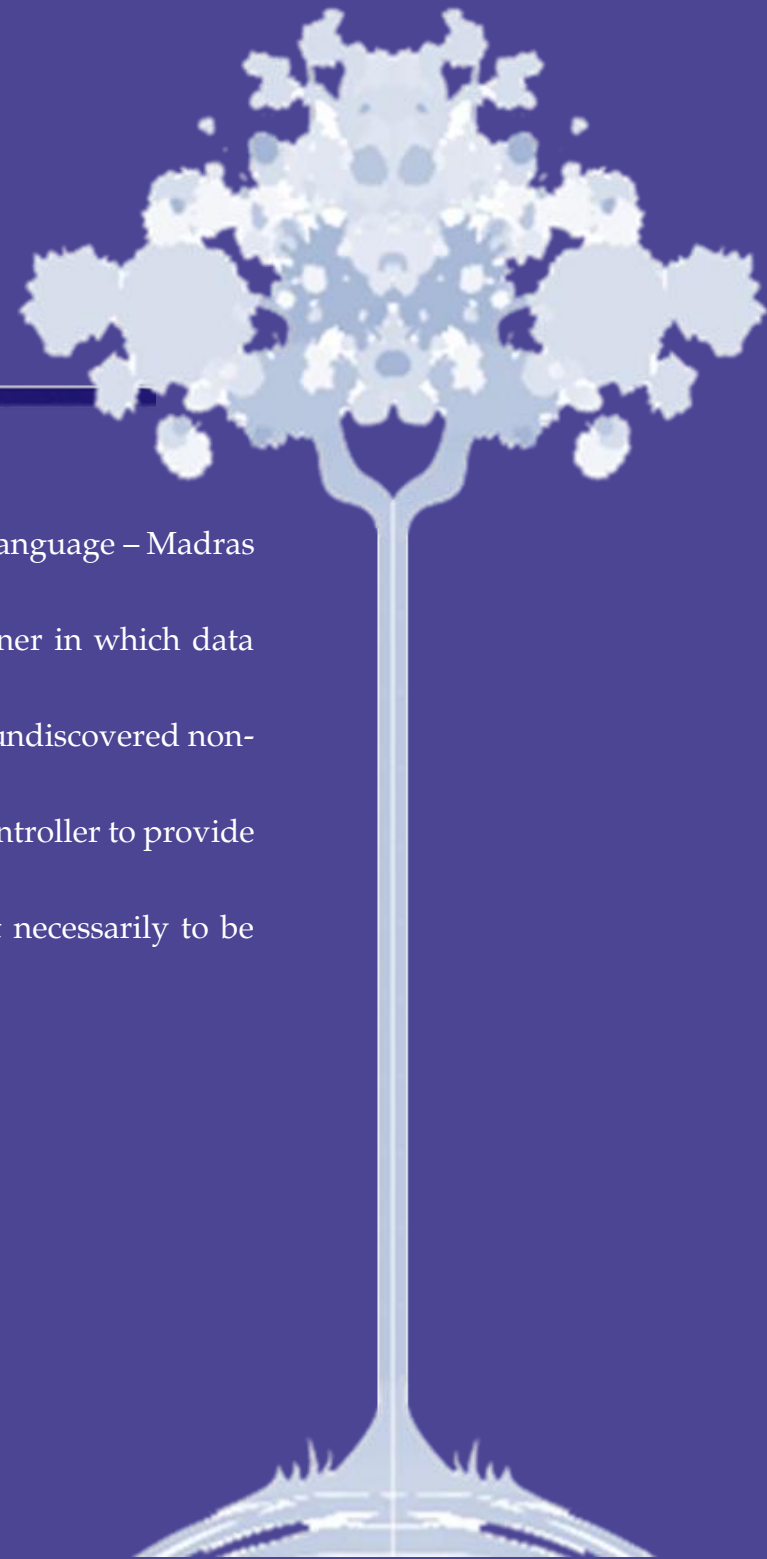
Conclusion

Overall, it could be understood that disclaimers shall be allowed provided the disclaimers comply with the requirements pertaining to patentability, clarity, conciseness,

support and sufficiency as set forth in each of the jurisdiction. It is also significant to maintain a balance to keep up the interest of the patent and the application in providing adequate protection as well as in determining the scope of protection when faced with invalidities at various stages. It is also the burden of the Applicant to sufficiently explain as to what was the invention at the time of filing the Application and provide clarity in the description so as to be used later as disclaimers as and when it becomes necessary. Thus, the use of disclaimers is not forbidden but the disclaimers need to be prudently used to satisfactorily protect the invention and to hold a valid patent.

[The authors are Associate and Director, respectively, in IPR practice at Lakshmikumaran & Sridharan Attorneys, Chennai]

Ratio Decidendi



- Patent – Amendment of claim – Section 59 is not to be used for wrong understanding of language – Madras High Court
- Patent – Similarity of transmission of sensor data in prior art – Difference in the manner in which data transmitted is relevant for claim – Madras High Court
- Patentability – Exclusion by Section 3(c) will only apply to process of finding a hitherto undiscovered non-living substance by identifying and isolating it from nature – Madras High Court
- Patent – Objections under Section 10(4) on incomplete specifications in patent claim – Controller to provide detailed exposition of non-compliance specifics – Delhi High Court
- Trademark – Defendant’s plea of invalidity of registration of plaintiff’s trademark not necessarily to be taken only in written statement – Madras High Court

Patent – Amendment of claim – Section 59 is not to be used for wrong understanding of language

The Madras High Court has held that Section 59 of the Patents Act, 1970 is not intended to be used for wrong understanding of the language employed by a patent applicant. According to the Court, beyond the choice of words which an applicant for patent may consider appropriate, the Controller must look into the substance of the claim. The High Court in this regard observed that the Controller, just like the patent applicant, is essentially a man of science and not of language.

The Controller had understood the original claim as involving only the use of lubricated polyamide while understanding the amended claim as a method in using the same substance and had hence rejected the patent claim under Section 59, stating that the amended claim went beyond the original claim. The Court noted that according to the Controller, the word ‘method’ expanded the scope of whatever the word ‘use’ conveyed.

The original claim used the expression- “*the use of a lubricated polyamide for the preparation of articles by injection molding...*”, while the amended claim read “*A method of preparing an article, the method comprising injection molding the article using a lubricated polyamide....*”.

Allowing the appeal, the Court remanded the matter back to the Controller of Patents for a *de novo* consideration of the amended claim. *The appellant was represented by Lakshmikumaran & Sridharan Attorneys.* [*Techpolymers Industria E Comercio LTDA v. Deputy Controller of Patents and Designs – Judgement dated 8 February 2024 in (T)CMA(PT)/180/2023, Madras High Court*]

Patent – Similarity of transmission of sensor data in prior art – Difference in the manner in which data transmitted is relevant for claim

The Madras High Court has set aside the decision of the Assistant Controller rejecting the application of a patent titled ‘Message Communication of Sensor and other Data’. Allowing the application to proceed for grant, the Court observed that not only were the problems addressed by the prior art (as relied upon by the Controller to reject the claim) and the claimed invention different but even otherwise the recitals and disclosures in prior art did not suggest or motivate, much less teach, the person skilled in the art (PSITA) to arrive at the claimed invention.

The Court in this regard observed that the solution provided by the claimed invention was the conversion of raw sensor data into

messages that are transmitted to the subscribing application which may be easily read by such application, while by contrast, the cited prior art did not envisage the conversion of raw sensor data into easy-to-read messages, though provided for the subscription of sensor data and the publication thereof upon occurrence of an event.

According to the Court, though the Controller was correct in stating that both the cited prior art and the claimed invention provided for transmission of sensor data to a subscribing application, but the difference lies in the manner in which such data was transmitted.

Further in respect of motivation to lead the person skilled in the art, the Court noted that there was nothing in prior art that addressed the problem of complexity in the communication of data from sensors to subscribing applications, and consequently the claimed invention which addresses the problem, would not be obvious to the PSITA from the prior art.

Observing that the problem resolved by the claimed invention was the transmission of sensor data in a form which was easy to process by the subscribing application, the Court held that arriving at the claimed invention from the prior art would require ingenuity and not mere skill in the art. *The appellant was*

represented by Lakshmikumar & Sridharan Attorneys. [Microsoft Technology Licensing LLC v. Assistant Controller of Patents and Designs – Judgement dated 28 February 2024 in (T) CMA (PT) No.71 of 2023, Madras High Court]

Patentability – Exclusion by Section 3(c) will only apply to process of finding a hitherto undiscovered non-living substance by identifying and isolating it from nature

The Madras High Court has held that the use of the noun ‘discovery’, which implies finding something which already exists and not producing, engineering or making something, and the use of the present continuous form ‘occurring in nature’, indicate that the exclusion under Section 3(c) of the Patents Act, 1970 will only apply to the process of finding a *hitherto* undiscovered non-living substance by identifying and isolating it from nature.

Directing the claimed invention to proceed for grant, the High Court observed that in the claimed invention, antibody was generated by deleting murine genetic material from mice and replacing the same with human genetic material in the mice and, thereafter, injecting an engineered antigen into the mice. After doing so, material extracted from the spleen of the mice was

fused with myeloma cells by the hybridoma process which resulted in the antibody over which the patent claim was made.

The Assistant Controller had held that that the antibody claimed was the discovery of a naturally existing molecule/substance and, therefore, not patent eligible under Section 3(c).

The High Court however observed that contention of the Assistant Controller that the claims were in respect of the discovery of an antibody/non-living substance occurring in nature, cannot be countenanced merely because the organism specified in the sequence listing was *homo sapiens*. It also noted that the conclusion of the Assistant Controller that the antibodies claimed in the invention occurred in nature, was strongly refuted by the claimant-appellant on the basis that the antibody was engineered by an elaborate process.

It may be noted that the High Court, while allowing the appeal, also held that the qualifier 'mere' in Section 3(c) is confined to the nearest reasonable referent 'discovery of a scientific principle' and does not extend to 'the discovery of any living thing or non-living substance occurring in nature.' The Court in this regard deviated from the interpretation of the Delhi High Court in *Diamond Star* (2023 SCC OnLine Del 1879). It noted that the word 'mere' is not applicable to the second limb on 'formulation of an abstract theory' and concluded that it would

be a strained construction to say that the adjective 'mere' does not qualify for the second limb but qualifies the third – relating to 'discovery of any living thing or non-living substance occurring in nature'. It also took note of the Statement of Objects and Reasons in the Patents (Second Amendment) Bill, 1999, which did not use the qualifier 'mere', and clause (d) of Section 3, which uses the qualifier 'mere' in each limb of the provision.

Further, the Court was also of the view that the phrase 'occurring in nature' does not apply to the expression 'living thing' in Section 3(c). According to the Court, the extension of 'occurring in nature' to 'living thing' would create a redundancy that cannot ordinarily be imputed to the Parliament. [*Imclone LLC v. Assistant Controller of Patents and Designs* – Judgement dated 6 March 2024 in (T) CMA (PT) No.126 of 2023, Madras High Court] [Also see other decisions of same date in *Immunas Pharma, Inc. v. Assistant Controller of Patents and Designs* and *Genmab A/S v. Assistant Controller of Patents and Designs*]

Patent – Objections under Section 10(4) on incomplete specifications in patent claim – Controller to provide detailed exposition of non-compliance specifics

The Delhi High Court has opined that the conclusion that a specified claim of the presented invention fails to meet the

standards set forth in Section 10(4) of the Patents Act, 1970, without a detailed exposition of the non-compliance specifics, is not legally tenable. According to the Court, it is incumbent upon the Assistant Controller to provide, at the very least, a succinct, if not comprehensive explanation, detailing the manner in which the subject invention contravened the stipulations of Section 10(4).

Section 10(4) stipulates that specifications must fully and particularly describe the invention, its operation or use, and the method by which it is to be performed. It also requires the disclosure of the best method of performing the invention, which is known to the Applicant and for which they are entitled to claim protection.

The High Court though observed that compliance with the detailed requirements of Section 10(4) is indispensable for patent applications, it was of the view that if the Assistant Controller identifies certain deficiencies in the Appellant's complete specification, it is the Assistant Controller's obligation to pinpoint at least the specific sub-section(s) of the provision in question in the First Examination Report and/ or the Hearing Notice.

The Court in this regard stated that the objections concerning sufficiency of the invention's disclosure within a patent

application must be articulated with clarity, avoiding any ambiguity, etc., as this is crucial to ensure that the Applicant is provided a fair chance to address the deficiencies, or to present arguments countering the objections.

Remanding the dispute on the question of inventiveness, the Court also noted that in respect of objections under Section 10(4), the detailed explanation within the specification itself directly addressed the concerns expressed in the impugned order about the clarity and definitiveness. *The appellant was represented by Lakshmikumaran & Sridharan Attorneys.* [*Microsoft Technology Licensing LLC v. Assistant Controller of Patents and Designs – Order dated 21 February 2024 in C.A.(COMM.IPD-PAT) 26/2022, Delhi High Court*]

Trademark – Defendant's plea of invalidity of registration of plaintiff's trademark not necessarily to be taken only in written statement

The Madras High Court has held that it would be sufficient if a plea of validity of registration of plaintiff's trademark is taken by the defendant in the counter affidavit filed in the Interlocutory Applications filed by the plaintiff seeking interim injunction. Plaintiff's submission that to satisfy the requirement of Section 124 of the Trade Marks Act, 1999 the plea should necessarily be taken in the written statement, was thus rejected.

The defendant had forfeited its right to file the written statement as the maximum statutory period of 120 days for filing the same had expired.

The High Court in this regard observed that Section 124 does not stipulate that the plea will have to be taken only in the written statement and cannot be taken in a counter affidavit filed in the Interlocutory Applications filed by the plaintiff. Applying the literal rule of statutory interpretation, the Court also rejected the submission that the word 'plea' referred to in Section 124 must be a plea taken in the written statement only. According to the Court, the narrow interpretation of the meaning of word 'plea' would amount to depriving the defendant from exercising their statutory remedy available to them for rectification of the plaintiff's registered trademark.

Adjourning the suit to enable the defendant to apply to the IP Division of the Court and seek for rectification of the plaintiff's

registered trademark, the High Court also noted that Single Bench of the Court had already dismissed interim injunction application by plaintiff, observing *prime facie* that the defendant was a prior user of the subject trademark. The said decision was also upheld by the Division Bench.

It may be noted that the High Court also distinguished the Delhi High Court decisions in *Anubhav Jain v. Satish Kumar Jain* [2023 SCC Online Delhi 424], where written statement was filed without taking the plea of invalidity, and *Marico Ltd. v. Agro Tech Foods Ltd.* [2010 SCC Online Delhi 3806], which was decided prior to coming into force of the Commercial Courts Act, 2015. [[VARAMM Healthcare Private Limited v. MGM Healthcare Private Limited – Order dated 19 February 2024 in Application Nos.2028 & 2029 of 2023 in C.S.\(Comm.Div.\)No.2 of 2023, Madras High Court](#)]



News Nuggets

- Patent for invention to enhance appetite in animals is not deniable citing Section 3(i)
- Patent – Controller is required to scan through written submissions of inventor meticulously
- Trademark – Non-compliance of Rule 33 of Trademark Rules, 2002, relating to submission of translation, is not fatal
- Trademark – Word mark 'TAXTAM' is similar to 'TAXTIM'
- Trademark – Term 'KARAIKUDI AACHI BRIYANI MANDI' is similar to 'AACHI'
- Trademark – Word 'Jindal' cannot be monopolized – Registrant of mark lacking inherent distinctiveness is powerless to restrain others

Patent for invention to enhance appetite in animals is not deniable citing Section 3(i)

Observing that the patent applicant had not claimed its product to be any medicine for curing any ailments in animals permanently, the Madras High Court has set aside the Controller's order rejecting the appellant's invention under Section 3(i) of the Patents Act, 1970. The Court in this regard noted that the controller missed the all-critical limb of the statutory provision under Section 3(i). The invention was related to enhancing the appetite in cats with chronic renal diseases. The matter in the dispute *Aratana Therapeutics, Inc. v. Controller of Patents and Designs* [Judgement dated 20 February 2024] was remanded for *denovo* consideration *vis-a-vis* the objection raised under Section 3(i).

Patent – Controller is required to scan through written submissions of inventor meticulously

The Madras High Court has observed that it is important that while examining an application for patent, the Controller scans through the written submissions of the inventor as meticulously as possible rather than enjoying his own list of objections raised in the hearing notice. Remanding the matter back to the Controller of patents for *de novo* consideration, the Court in

Qualcomm Incorporated v. Controller of Patents [Judgement dated 1 March 2024] noted that that the objections raised by the Controller were addressed in the written submissions but the Controller did not find it necessary to examine the written submissions before arriving at its conclusion rejecting the patent application.

Trademark – Non-compliance of Rule 33 of Trademark Rules, 2002, relating to submission of translation, is not fatal

The Madras High Court has held that relief of rectification is not available to the petitioner merely on the basis that a translation of the impugned trademarks, which were registered in the Tamil and Telugu languages, was not provided. The Court hence rejected the contention that non-compliance with the requirement of Rule 33 of Trademarks Rules, 2002, prescribing that any trademark containing words in a script other than English or Hindi should be accompanied by a translation, was fatal.

The petitioner had submitted that such non-compliance by the respondent caused immense prejudice to the former because the petitioner was not in a position to oppose the registration of the trademarks in spite of the same being advertised.

Dismissing the rectification petitions, the Court in *Shambhunath & Bros. v. Jai Rajendra Impex Pvt. Ltd.* [Common Order dated 7 February 2024] noted that no consequences were specified for the contravention of Rule 33. It was also of the view that said contravention was not of sufficient gravity to warrant rectification entirely on that basis because, on that sole ground, it cannot be concluded that the entry relating to the impugned trademarks was either made without sufficient cause or that such entry wrongly remains on the register.

Trademark – Word mark ‘TAXTAM’ is similar to ‘TAXTIM’

The Madras High Court has held that the word mark ‘TAXTAM’ is similar to mark ‘TAXTIM’. Comparing both the marks for their phonetical and visual similarity, the Court observed that except one vowel i.e. ‘i’ being replaced with the consonants ‘ta’, the mark of the appellant (TAXTIM) is similar to the mark TAXTAM of the first respondent, both registered under Class 5 for pharmaceutical products. It also noted that respondent's mark did not display any features to distinguish it otherwise. Setting aside the rejection of the opposition filed by the appellant, by the Assistant Registrar, the Court in *Alkem Laboratories Limited v.*

Orchid Healthcare [Judgement dated 20 February 2024] also observed that even in its application, the first respondent has disclosed that it only proposes to use the said mark for its pharmaceutical products. The Assistant Registrar was directed to rectify the Trademark Register accordingly.

Trademark – Term ‘KARAIKUDI AACHI BRIYANI MANDI’ is similar to ‘AACHI’

The Madras High Court has held that the term ‘KARAIKUDI AACHI BRIYANI MANDI’ is visually and structurally similar to that of the plaintiffs’ trademark/name AACHI/AACHI CHETTINAD RESTAURANT/AACHI KITCHEN/AACHI NAMMA KITCHEN/AACHI BHAVAN. The Court in this regard observed that any person of average intelligence will be confused as to whether the defendants’ name ‘KARAIKUDI AACHI BRIYANI MANDI’ belongs to the plaintiffs. The plaintiff in *A.D.Padmasingh Isaac v. Karaikudi Aachi Biriyani Mandi* [Judgement dated 7 February 2024], was carrying on trade in spices by using the mark ‘AACHI’ since 1995 and was using the mark for its restaurant business since 2014. Granting permanent injunction against the ex-parte defendant, the Court also noted that the plaintiff had obtained registrations for the trademark

'AACHI' in 117 countries under Class 29, 30 and 43 which pertain to restaurants also while the defendant was using its mark 'KARAIKUDI AACHI BRIYANI MANDI' also in respect of its restaurant.

Trademark – Word 'Jindal' cannot be monopolized – Registrant of mark lacking inherent distinctiveness is powerless to restrain others

The Delhi High Court has held that a proprietor of a trademark cannot, by obtaining registration for 'JINDAL' as a word mark, monopolize the use of 'JINDAL' even as a part – and not a very significant one at that – of any and every mark, even in the context of steel, or SS pipes and tubes. The Court reiterated that

the Trade Marks Act, and the privileges it confers, cannot be extended to the point where one can monopolize the use of a common name for goods, and, by registering it, foreclose the rest of humanity from using it. The Court in this regard stated that if one registers a mark which lacks inherent distinctiveness, the possibility of others also using the same mark for their goods, and of the registrant being powerless to restrain such use, is a possibility that looms large, with which the registrant must live. The High Court in *Jindal Industries Private Limited v. Suncity Sheets Private Limited* [Judgement dated 7 March 2024] also observed that the right of a person to use his own name on his own goods, cannot be compromised. Infringement was thus held to have also failed on the anvil of Section 35 of the Trade Marks Act, 1999.

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