



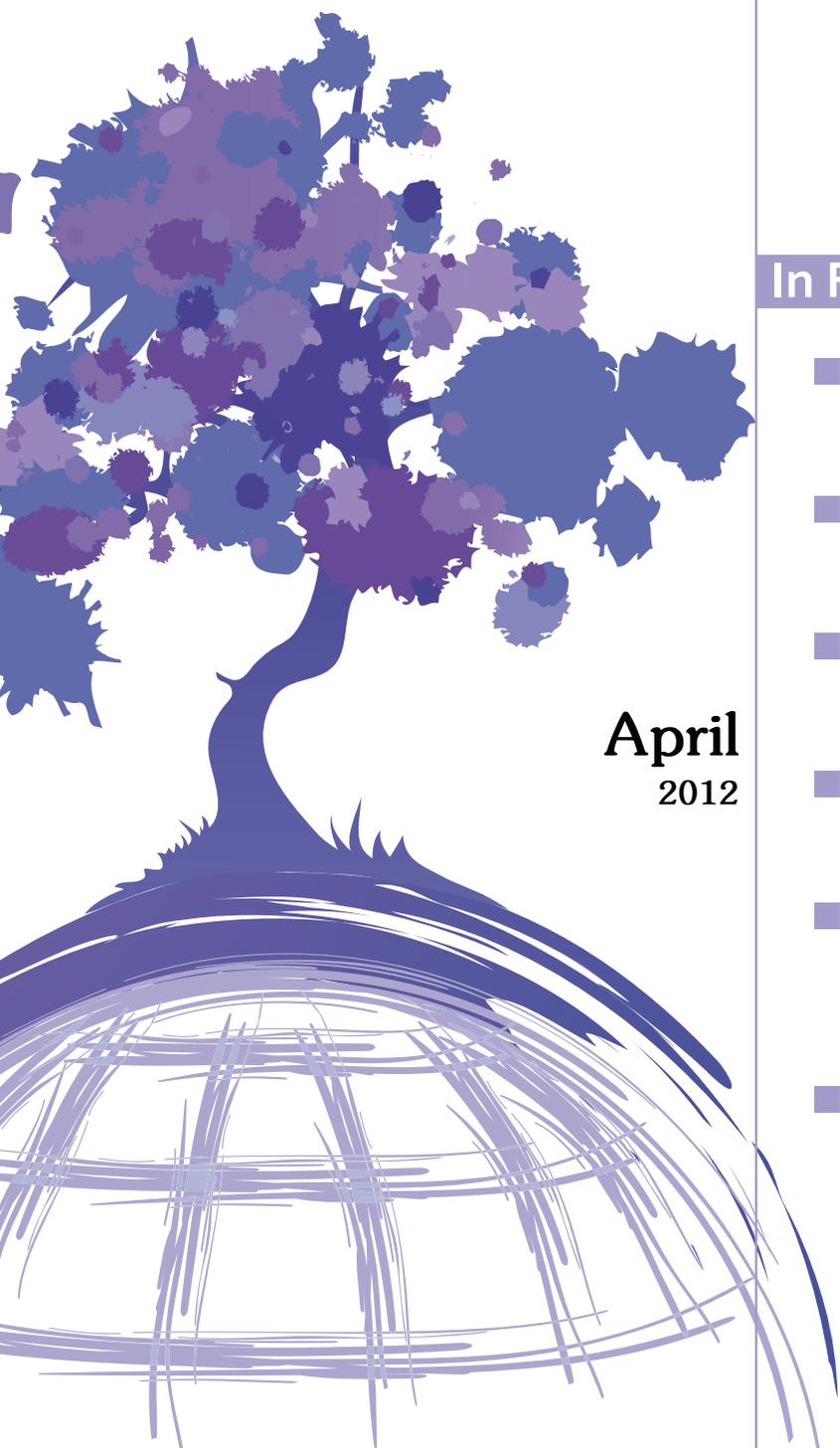
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## In Focus

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## Article

### Amendment of patent applications and patents in India

By **Amit Koshal**

The Indian Patents Act, 1970 (“the Act”) provides for amendment of an application for a patent or a complete specification or any related document, at any time either before or after grant of the patent, if the Controller so thinks fit and subject to certain conditions. In general, amendments to patents and applications are governed by Sections 57 and 59 of the Act, which stipulate that such amendments can be made only by way of disclaimer, correction or explanation without addition of new subject matter. Additionally, Section 78 empowers the Controller to correct any clerical error, either upon a request made by any person interested or even without such a request.

In the case of *Press Metal Corporation Ltd. v. Noshir Sorabji Pochkannawalla* [AIR 1983 Bom 144], it was held that while Section 78 empowers the Controller to correct clerical errors, it does not empower the Controller to make an amendment *suo motu*. Thus, amendments have to be necessarily made under Section 57 only.

This position was reiterated in the case of *Aia Engineering Ltd. v. Controller of Patents* [2007 (34) PTC 457 Del], wherein the High Court of Delhi drew a distinction between Section 78 which deals with power of Controller to correct clerical errors and the powers to be exercised under Section 57 regarding request for amendment of an application made by a patentee. In this case, the learned judge held that while purporting to exercise powers under Section 78 of the Act, there cannot be any amendment of the

application for which the procedure of Section 57 must be followed.

The nature of amendments that are admissible was considered by the Intellectual Property Appellate Board (IPAB) in *Solvay Fluor GmbH v. E.I. Du Pont*. In this case, Du Pont sought to amend the specification after Solvay filed for revocation of Du Pont’s patent under Sections 3(d) and 3(e) as non-patentable subject matter. IPAB, in its order, mentioned that it is possible to make amendments to the specification for overcoming objections raised under Sections 3(d) and 3(e) if the amendments were related to showing technical advance due to the combination of elements and if the amendments complied with the requirements of Section 59, i.e., were either made as disclaimer, correction or explanation. According to the IPAB, the amendments made by Du Pont in this case fell under the purview of ‘explanation’ of the subject matter, and hence the amendments were allowed.

The extent to which amendment would be allowed by way of explanation remains to be seen. For example, if an element or process step is depicted in the drawings, but not described in the specification, would the applicant be allowed to amend the specification to include the corresponding description for explanation? Also, would incorporation of test results or details of prototypes in the specification be allowed at a later stage by way of amendment, especially after grant, considering that, under Section 59(2)(c), the right of a patentee or applicant to make an amendment after grant cannot be questioned

except on the ground of fraud. For answering such questions, courts will have to take into account the requirement of Section 59(1) that the amendments can be made only for the purpose of incorporation of actual facts without adding new subject matter. In particular, when the specification is amended, the subject matter added in the specification should already be disclosed in substance in the specification and nothing must be added which is beyond the scope of the subject matter disclosed. Similarly, when the claims are amended, the amended claims should fall wholly within the scope of a original claim. Hence, it would be noteworthy to see how the courts set out the boundary conditions for amendment of specification.

Interestingly, Section 57(5) specifically allows the amendment of a priority date of a claim. In essence, it provides an applicant with the opportunity to correct the priority date if the patent application had been

filed with a wrong priority date. However, in the case of *Nippon Steel v. Controller of Patents* [W.P (C) 801/2011] filed in Delhi High Court, the applicant tried to disown the first filing date as priority date and requested the Controller to change the priority of the application under Section 57(5) to the filing date of the subsequently filed PCT application. The High Court did not address the issue of whether such a change in priority date was admissible because the application was deemed to have been abandoned due to non-submission of request for examination in the prescribed time period. While the various provisions of Section 11 clearly point out that the priority date of a claim would have to be the earliest date, the question as to whether an applicant may be allowed to disclaim a first filing date and change the priority date to the filing date of a later application by way of amendment remains to be seen.

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## IPR LAW & PROCEDURES

### Canada to pass Copyright law amendments

Canada will soon pass the Bill C-11 - Copyright Modernization Act, after the third reading in the House of Commons and Senate review. The special legislative committee of the Canadian Parliament recently completed its review and introduced eight amendments.

The bill aims to bring in changes in the Copyright Act to ensure enhanced protection in the digital era including recognition of technological protection measures. Provisions relating to 'fair use' such as recording television, internet and radio programming for viewing/enjoying it later, import of and export of adapted material for those with perpetual disabilities, use of copyrighted material for education and

research, parody, creation of temporary reproduction for broadcasts also figure in the bill. Liabilities of ISPs and search engines in so far as they enable infringement or do not cooperate with right-holders are also part of the bill.

Canada has already changed its trade mark law recently by allowing sound to be registered. The practice notice issued on 28th March, 2012 states that the application for the same should also contain a graphic representation in the form of a drawing of the sound mark, a description and an electronic recording in MP-3 or WAVE format. This move comes after the Federal Court ordered CIPO to accept publication of a trade mark application filed by MGM for the sound of a roaring lion.

## NEWS NUGGETS

### Public access to documents relating to research funded by government

The spotlight in the United States has moved from discussions on SOPA to the 'Federal Research Public Access Act of 2012' (FRAA) introduced in February this year. FRAA seeks to provide a public access policy in respect of research funded by federal agencies. The FRAA bill, once enacted, will require specified federal agencies whose expenditure on research exceeds USD 100 million, to provide open access to original research papers which have been accepted for publication. Research progress reports presented in meetings, laboratory notes, research resulting in works that generate revenue or royalties for authors (such as books) or patentable discoveries subject to certain conditions are sought to be excluded. The bill is supported by educational institutions but opposed by journal publishers.

In a similar move, the World Bank released the Open Access Policy for Formal Publications on 2nd April, 2012. From July 2012, manuscripts and accompanying data sets pertaining to research, analysis, economic and sector work, or development practice performed either by staff or external research will be available in electronic form under Creative Commons license. A user may thus distribute or build upon the work provided he attributes the same as required by the licensor.

### Madras High Court joins league of John Doe Orders

The Madras High Court, on 29th March, 2012, passed its first 'John Doe' order on an application filed by one of the leading film distribution

companies of India, in the case of *R.K. Productions Pvt. Ltd. v. BSNL & Ors.* The order restrains unauthorized distribution of the movie "3" by both named and anonymous respondents. With this order, Madras High Court joins its counterparts in different States, including the Delhi High Court in the fight against ISPs in cases of copyright infringement. This order passed by the Madras High Court seeks to cover a wide array of infringement activities within its ambit, including media of CDs, DVDs, pen-drives etc. The movie "3" features the famous song "kolaveri D".

### Infringing content in You Tube – A pyrrhic victory for Viacom

Reversing the 2010 summary judgment of the District Court, the United States Court of Appeals for the Second Circuit, on 5th April, 2012, directed the Google owned YouTube, Inc. to defend itself again before the District Court on the specific issue of purposeful ignorance of infringing material on its website. However, the Appellate Court upheld that three of the four user upload software functions of YouTube, namely – transcoding, playback and related-video thumbnails fall within the 'safe harbour' provisions of the Digital Millennium Copyright Act. It remanded the issue relating to the fourth function, syndication, for further fact-finding.

### Madras High Court restricts scope of Sections 9 & 11 arguments

The Madras High Court has provided a new dimension to the ongoing litigation battle between the French liquor giant, Pernod Ricard and Real House Distillery Pvt. Ltd, a Goa based

liquor manufacturer and distributor. In a writ petition filed by the Goa-based entity against the IPAB's order for removal of their trade mark "Rhizome's IMPERIAL BLUE", the Madras High Court observed that – *"Where the trademark includes a generic component, the manufacturers are not precluded from using as part of their marks the said generic component. This is because the generic component will obviously not be the distinctive portion and the dominant portion would*

*be dissimilar or non-generic portion."* On this reasoning, the Court refused to grant monopoly over the common word 'IMPERIAL'.

The highlight of the judgment was restricting the scope of relevant provisions when the court held that the grounds embodied in Sections 9 and 11 can only be relied upon during the stage of publication of the trade mark for opposition purposes, and not post registration, in a rectification proceeding.

## RATIO DECIDENDI

### Hotel operator distributing broadcast signals in room liable to pay 'equitable remuneration' to producers – CJEU

In a judgment delivered on 15th March, 2012, the Court of Justice for European Union (CJEU) held that exemption provided by Ireland to hotel operators distributing broadcast signals in hotel rooms from payment of equitable remuneration to phonogram producers was in contravention of EU's directives. The first question before the court was whether a hotel operator providing televisions and/or radios in rooms and to which broadcast signal is distributed, is a 'user' making a 'communication to the public' of a broadcast phonogram. The Court relied on Article 8(2) of Directive 2006/115 and held that anyone who uses a phonogram for a broadcast or for communication to the public must be considered to be a 'user'. Guests of a hotel constitute a fairly large number of persons and they must be considered to be public and such broadcasting of phonograms by a hotel operator is of a profit-making nature making it a 'communication to the public'.

On the question as to whether such hotel operator is obliged to pay equitable remuneration in addition to that paid by the broadcaster, the CJEU held that since the hotel operators derived economic benefits from such transmission independent of those obtained by the broadcaster or the producer of the phonograms, they were liable to pay equitable remuneration. They were liable to pay such remuneration even in cases where television is not provided but other apparatus and phonograms in physical or digital format capable of being broadcast or heard by means of that apparatus, are provided. According to the court, Article 10(1)(a) of Directive 2006/115, which provides for a limitation to the right to equitable remuneration in the case of 'private use', does not allow Member States to exempt a hotel operator which makes a 'communication to the public' of a phonogram.

### Trademark - Registration of descriptive word with logo

The Intellectual Property Appellate Board (IPAB), in its decision dated 9-3-2012, held that use cannot

equal distinctiveness and that a descriptive word even where it is accompanied by a logo cannot be registered as a trademark. The applicant in this case sought removal of the mark 'Wealth Advisors' accompanied by a logo WAI. It was argued that as regards services provided by the respondent- an investment advisory firm- the word was purely descriptive and the respondent had applied for registration claiming to have acquired distinctiveness, being a user for just a few months. The respondent pleaded that he had been using the logo and the words without any objection from other firms in the industry and that "Wealth Advisors" was a coined, arbitrary word. However, the IPAB held in favour of the applicant to remove the trademark registered also stating that the mark mainly consisted of descriptive words and granting monopoly over the same would be against public interest. [*Citibank, N.A./Citigroup Inc v. Wealth Advisors (India) Pvt. Ltd* - IPAB Order dated 9th March, 2012]

### **Copyright needs to be registered for enforcement – Bombay H.C.**

The Bombay High Court in its recent judgment has held that if the provisions of Copyright Act are sought to be invoked by owner for enforcing civil and criminal nature of remedies before the special forum, namely the District Judge rather than a normal civil Court, he must obtain registration of the said copyright under the provisions of Copyright Act, 1957. The court observed that unless the provisions relating to registration and publication of such registration have been complied with, the alleged infringer may not have the knowledge as to the existence of the copyright in a given work. The Bombay High Court, however, does not seem to have held that existence of copyright is predicated on registration; only enforcement, whether civil or criminal, requires registration. The court hence held that the word 'may'

used in Section 45 of the Copyright Act will have to be read as 'shall' and in the absence of registration by the owner of the copyright under the Copyright Act, it would be impossible to enforce the remedies under the said provisions against the infringer for any infringement under Section 51, *ibid*. The Bombay High Court was also concerned with issues concerning the initiation of a declaratory suit of non-infringement and held that lodging an FIR and setting the wheels of criminal law in motion is sufficient to constitute a 'threat' of legal proceedings / liability in respect of an alleged infringement, within the meaning of Section 60 of the Copyright Act, 1957. [*Dhiraj Dharamdas Dewani v. Sonal Info Systems Pvt. Ltd.* - First Appeal No.1076/2011 decided by Bombay High Court on 6-3-2012].

### **Word mark with descriptive indications devoid of distinctiveness – CJEU**

Answering two references by Bundespatentgericht (Germany) on grounds for refusal to register a trademark or its invalidity, the CJEU interpreted Article 3(1)(b) and (c) of Directive 2008/95/EC of the European Parliament and the national law to state that a word mark which is a combination of descriptive indications or abbreviations is devoid of distinctiveness. In the first case, the words 'Multi Markets Fund MMF' was sought to be registered denoting investment in various financial markets. In the second case registration granted to NAI – Der Natur-Aktien-Index' denoting a share index showing shares of ecologically-oriented undertakings. Both registrations pertained to class 36 of the Nice Agreement of 15 June 1957.

The CJEU stated that the sign MMF and NAI by themselves were not descriptive of the services offered. However, if by ' juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself', the relevant public perceives

that sequence as being an abbreviation of that word combination by reason of the fact that it reproduces the first letter of each word of that combination, and that the mark in question, considered as a whole, can thus be understood as a combination of descriptive indications or abbreviations, then the mark will not have a distinctive character. [*Alfred Strigl v. German Patent Office and Securvita and Oko-Invest*, CJEU ruling dated 15th March, 2012]

### Use of word occupying predominant part in trade mark whether amounts to infringement

Calcutta High Court in its recent order has held that use of the word 'Nasta' along with some words by another biscuit maker amounted to infringement of the trade mark of the appellant using the same word on the wrapper of the biscuits since 1991. The court observed that the disputed word was one of

the many words used on the label but it occupied predominant part of the label and was distinctive of petitioner's product. It was also held that Section 17 of the Trademarks Act 1999 was not applicable as the specified word was the predominant feature and was identified as such by the customers. However, the court while holding that the use of the word in English infringed the petitioner's trade mark even though the application of registration of the word was pending, further held that "Shakaler Nasta" written in Bengali and 'Raja' written in English with pictures of biscuits and sunrise in different colour settings, was not similar to the petitioner's packaging or infringed their trademark or name or label [*Calcutta Food Products Pvt. Ltd v. Raja Udyog Pvt. Ltd.* - GA No.598 of 2012 with CS No.88 of 2012, allowed on 4-4-2012 by Calcutta High Court].

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