



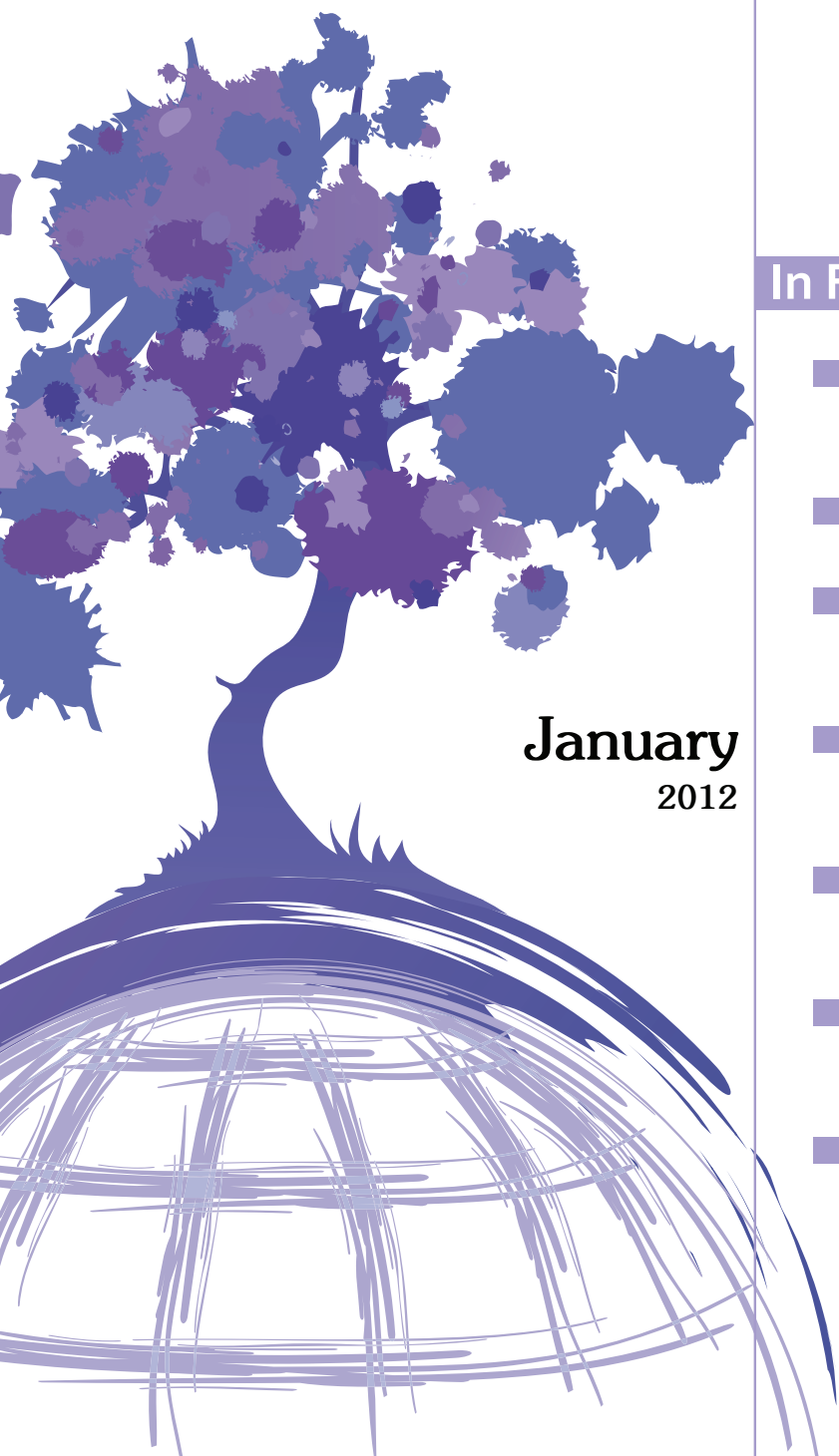
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Article

Applicability of ‘learned society’ exception to publications on the internet¹

By **Sudarshan S. Shekhawat**

Generally speaking, all enabling publications before the priority date of claims of patents shall be anticipatory. Section 13(2) of the Indian Patents Act, 1970² (hereinafter ‘the Act’), considers all such documents relevant for anticipation. However, there are exceptions to the above rule. Many jurisdictions provide that disclosures/publication without the consent of the inventor will not be considered anticipatory. In India, there are a few more exceptions, one being the description of the invention in a paper read by the true and first inventor before a learned society or published with his consent in the transactions of such a society vide Section 31(d) of the Act (see FN1).

The terms “learned society” and “transaction” are not defined under the Act and their interpretation has not been dealt with by any court in India. This article deals with the question whether publication of an enabling disclosure by a learned society on the internet that is accessible to the public, would amount to anticipation.

In order to appreciate the above issue, three key terms must be considered i.e. ‘learned society’, ‘transaction’ and ‘application for patent’. An identical provision existed in the erstwhile UK Patents Act 1949 as Section 51(2) (d). The UK Act also did not define ‘learned society’ and ‘transaction’. The term ‘learned society’ was interpreted

by the UK Patent Office in *Ralph’s Application*³ which stated that the said expression is “*apt to be applied to any properly constituted society made up of persons seeking to promote and organise the study of specific subjects by the provision of a forum for discussion and a means of contact for those of common interest.*” Thus, without putting any boundaries as to who shall be ‘learned’, a general understanding of ‘learned society’ was provided. This can be safely applied in the Indian context as well.

The word ‘transaction’ was interpreted by the Appeal Tribunal in the case of *Ethyl Corporation’s Patent*⁴. The appeal was filed against the order of the Controller who held, that ‘transaction’ meant “*published record of the proceedings of the learned society*”. The tribunal upheld the Controller’s judgement. ‘Transaction’ also came up in *Ralph’s Application* before the Patent office where an opponent sought to rely upon four publications which were available in the UK before the priority date. The publications contained the subject matter of a paper read by the inventor at a meeting of the Canadian Natural Gas Processing Association. The reporters present at the meeting received a copy of the paper and published the same in their journals in the UK. The inventor challenged the admissibility of the publications and raised the ground that the publication

¹ Section 31- Anticipation by public display, etc.-An invention claimed in a complete specification shall not be deemed to have been anticipated by reason only of –

(d) the description of the invention in a paper read by the true and first inventor before a learned society or published with his consent in the transactions of such a society,...

...if the application for the patent is made by the true and first inventor or a person deriving title from him not later than 12 months after the...reading or publication of the paper, as the case may be.

² Section 13(2)- The examiner shall, in addition, make such investigation for the purpose of ascertaining whether the invention, so far as claimed in any claim of the complete specification, has been anticipated by the publication in India or elsewhere in any document other than those mentioned in sub-section (1) before the date of filing of the applicant’s complete specification.

³ [1978] FSR 226

⁴ [1963] RPC 155

took place by the reason of the reading of the paper before a learned society and that the four publications were in effect reporting the proceedings of that learned society. The patent office, dismissing the plea of the inventor, held that the circulation of the paper and publications were not made in the 'transactions' of the learned society.

The reasoning of the UK Patent Office was that the society had no control (approval/editorial) over the publications i.e. what was to be printed in the several journals. It was held that for publication to be regarded as a "transaction", it should be *published under the auspices of and finally be the responsibility of the Association-the learned society.*"⁵ This conclusion of the UK Patent Office is silent on the issue whether even such 'controlled' content would be considered anticipatory, if it is freely available to public via, say internet.

The case for consideration, from the Indian context, is where a learned society publishes an enabling disclosure, presented by an inventor, on its website. Although the contents of the publication are in the control of the society, the said contents are viewable by all. The question is whether such a publication would be considered to be made 'in the transaction' of the society.

One view could be that since the information is controlled (edited/approved) by the society, the publication may be termed as being made 'in the 'transaction' of the society. This could seem more relevant for many learned associations and societies which work towards the object of dissemination of knowledge through their websites.

Another, rather restricted, view is that such publication cannot be considered to be 'in the transaction of the society' and would be anticipatory. This is because, broadly speaking, the legislature considers all enabling publications before the priority date of the invention to be anticipatory, Section 31(d) being the exception must be

narrowly construed. Exceptions such as Section 31(d) have been provided so as to grant inventors the opportunity to disseminate knowledge amongst members of the society bound by common interest. The learned society cannot exist or be defined sans the members. Therefore, 'transactions' of such society are meant to cover the record of the proceedings, for the benefit of those members. One cannot claim the benefit of Section 31(d) while disclosing the invention to the public at large. Thus such a publication in the internet accessible to the public may not be considered to be 'in the transaction' of the society.

It would be interesting to see how the Indian courts interpret the word 'transaction', given the fact that several associations have operational website which publish their content online and such content is accessible to the public.

The last question is what is meant by 'application for patent' in Section 31 – the provision only grants a grace period of 12 months within which an 'application for patent' has to be filed. The issue is whether the term 'application for patent', as used in Section 31 includes, in addition to a usual application for patent in India, a base application of a convention application filed in India and an international application. In the *Ethyl Corporation's Patent*⁶ case the Appeal Tribunal in the UK held that the term 'application for patent' means an application for patent in the UK and not a convention application. The tribunal said that the other sections in the same chapter (other exceptions to anticipation) clearly used 'convention application' as being distinct from 'application for patent'. This was not done so in Section 51(2)(d) of the erstwhile UK Act. The tribunal observed that this would amount to increasing the grace period from six months to 18 months which meant that "*the embarrassment to trade and industry caused by the uncertainty would be gravely extended*".

⁵ *Supra 3, at p. 233*

⁶ *Supra 4*

If the above principle is applied to the Indian context, then the base convention application may not be considered to fall within the scope of the term 'application for patent', in determining the grace time-period under Section 31 (d). However, so far as international applications are concerned, the aforesaid reasoning of the tribunal may not directly apply due to Section 7(1A), read with Section 138(4), which clearly states that every Interna-

tional Application under the PCT shall be deemed to an application under the Act, if a corresponding application has also been filed before the Controller in India.

One would have to await a specific pronouncement on the issue by an Indian court.

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IPR LAW & PROCEDURES

Trade mark applications to indicate actual goods and services

The Office of Controller General of Patents, Designs and Trademark, India has issued guidelines on providing information in trade mark applications. Public Notice No. 81 dated 9th January 2012, seeks indication of actual goods and services in the application form. The notice suggests that terms such as "all goods/services", "etc", "all other goods/services included in class...", "goods/services not limited to..." shall not be entertained. While this guideline may provide some amount of certainty to third parties, it may also create hardship to applicants requiring sufficiently broad protection for certain allied goods within the same class. Another important point that flows from the notice is that in case of marks that indicate prior use, the actual date, month and year must be given and not just the year and/or month.

Fees for expedited certificates not payable by cheque

Controller General of Patents, Design and Trademark of India has directed that fees for getting expedited certificates shall be paid only through bank draft or by cash. The directions have been issued in respect of expedited legal certificate (TM-70) and for getting expedited certificate for copyright purposes (TM-72). The move, as per the latest Public Notice No. 82 of 2011, dated 9-1-2012, became necessary after cheques were dishonoured and

the information on the same was received from banks after the applications were processed.

Europe now closer to unified patent system

Europe is now closer to a unified patent system with Legal Affairs Committee agreeing on the proposal for unified patent, language regime and unified patent court. Spain and Italy have voiced objections on the language which would be adopted. Also the issue of the actual location of the unified court has not been resolved. The proposal is scheduled for vote in the European Parliament in February 2012. It is believed that a unified patent system would bring down costs of filing and reduce uncertainties due to different national legislations.

IP Court to be established in Russia

A specialised Intellectual Property Court will be functional in Russia from February, 2013. Two laws proposing to ensure better protection and enforcement of intellectual property rights received presidential assent last month. The court will hear cases concerning challenges to regulatory and non-regulatory acts in the intellectual property field, disputes on trademarks and trade names, appeals against the decisions of the Federal Service for Intellectual Property (Rospatent) and decision by the anti-monopoly body Federal Antimonopoly Service on use of exclusive rights. However, copyright and related rights will be kept out of purview of the new court.

NEWS NUGGETS

U.K. village fights to reclaim 'cheese rights'

The decision by Department for Environment, Food and Rural Affairs (DEFRA), U.K. to allow the village Stilton to make its cheese but not to use the name 'Stilton cheese' has left the villagers feeling blue. The famed blue-veined cheese is prepared by piercing the curds which have been processed for about 6 weeks to allow air in. After about three weeks the blue veins are formed. Under the Protected Designation of Origin (PDO) certificate Stilton cheese can be prepared by dairies in Derbyshire, Nottinghamshire and Leicestershire. The Stilton Cheesemakers Association is irate over the efforts of landlord of Bell Inn reputed to be the birthplace of Stilton cheese and a local historian to amend the PDO certificate. It is widely accepted that Stilton cheese was first made and marketed in the village. The Stiltonians claim their case is fortified by proof from literature and references in Gentleman and Farmer's Guide in 1732. The French Champagne has already seen designated areas expand after such requests were made.

Film song to cash on trademark

Sony Music has filed for trademark registration of "Why this kolaveri di" last month, as per reports. The application has been filed under classes 9 and 41 to allow the company to launch products such as compact disks, cassettes and SD cards. This makes "Why this kolaveri di" the first song in India to have its first line trademarked.

European Parliament to debate ACTA

The Council of European Union adopted the decision authorising the signing of the Anti-Counterfeiting Trade Agreement (ACTA) on 15-12-2011. The European Parliament will have to approve ACTA after the Member States sign. The ACTA provides for stricter enforcement of intellectual property rights, copyrights in particular and has been criticised as stifling freedom of expression and information, placing too much power in the hands of the right holder. These 'TRIPS-plus' measures include criminalising IP infringements, providing for surveillance of online data sharing, requiring service providers to give information of alleged violators and border measures to seize 'suspect' goods. Lack of transparency during negotiations and sparse public debate have led to opposition to ACTA's ratification in America.

R&D cost sought from patentee to justify drug price

The Controller General of Patents has asked the patentee Bayer to submit cost data, including research and development expenditure on Nexavar to justify the substantially high price. Bayer sought to justify the price citing investment costs. Natco filed a compulsory licensing application before Controller of Patents in 2011 when Bayer refused to grant voluntary license of the drug to Cipla. This is the first case where a patentee has to provide such data and one may see similar cases in the near future.

RATIO DECIDENDI

Patentability of process involving chemical reaction in a particular sequence

The Intellectual Property Appellate Board, India (IPAB) rejecting the challenge to the patent for the process of preparation of rodent repellent, held that the invention was not a mere admixture and involved chemical reactions in a particular sequence. The process comprised taking LDPE in a mixer at a temperature of 110-160°C, adding 5-50% of ethylene vinyl acetate by weight of LDPE, mixing homogeneously and then adding a specified quantity of rodent repellent, mixing for 5-10 minutes at temperature of 110-160°C and finally shredding the mixture at room temperature. The Appellant had argued lack of inventive step and prior knowledge and use. [*Newage Laminators v. SPL's Sidhartha Ltd*, IPAB Order No. 1/2012, dated 2-1-2012].

Copyright whether exists in football match fixture lists

The Court of Justice of the European Union (CJEU) has held that creation of football fixture lists detailing date, time and teams of matches was not original intellectual creation of the author and did not qualify for copyright protection. Answering a reference from the Court of Appeal (England & Wales) (Civil Division), United Kingdom, the CJEU observed that entry of data in a database should add further value or significance to those data to amount to 'selection or arrangement' in sufficient measure to ensure protection under Article 3 of the Directive 96/9/EC. It held that in the case of a database, the copyright essentially protects its 'external' aspect i.e. its structure and the defendants (Yahoo and Others) use the raw data developed by the companies which organise the leagues and not the form (structure) in which those companies make the data public. The Court observed that the very idea of using copyright to protect

football fixture lists seemed peculiar. [*Football Dataco Ltd. v. Yahoo! UK Limited* - Case C 604/10, ruling dated 15-12-2011]

Trademark registration- Conditions of grant binding

Words "Red label" were held by the Intellectual Property Appellate Board, India (IPAB) as not being distinctive so as to grant trademark registration to it. It observed that all the registrations granted to the appellant (Hindustan Lever Ltd.) for marks which had 'Red Label' on them were with the condition that they would not claim exclusivity for these words. The Board relied upon a memorandum at the Annual General Meeting of the tea traders to conclude that the words "red label" are common to the tea trade. IPAB also noted that there was no evidence of continuous use of the mark "Red Label" per se and that the mark used was 'Brooke Bond' and 'Red Label' together. [*Hindustan Unilever Ltd. v. Girnar Exports* – IPAB Order No. 5/2012, dated 2-1-2012].

Trademark not used may be removed from register

Trademark registered but not used for a long period with only an intention to use the same in future, deserves to be removed from the register. In its recent order dated 6-1-2012, India's Intellectual Property Appellate Board (IPAB) held that when there was no evidence of use of the particular trademark "Pops" for 22 years, it meant that there was no bonafide intention to use the same. The Board further stated that the submission by the defendant that they were registered in other countries was not relevant. Even though the product of the appellant i.e. bubble gums and that of the respondents i.e. breakfast cereals were not in the same class, they were sold in super markets and hence possibility of confusion cannot be ruled out. [*Pops Food Products (P) Ltd. v. Kellogg Company* – Order No. 8/2012, dated 6-1-2012].

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